

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3 BEFORE THE PATENT TRIAL AND APPEAL BOARD

4
5 RESMED LIMITED, RESMED, INC. and RESMED CORP.,

6 Petitioner,

7 v.

8 FISHER & PAYKEL HEALTHCARE LIMITED,

9 Patent Owner.

10
11 CASES

12 IPR2016-01719, IPR2016-01723, IPR2016-01724,

13 IPR2016-01735

14
15
16 TELEPHONIC PROCEEDINGS

17 San Diego, California

18 Wednesday, January 25, 2017

19
20
21 Reported by:

22 ANELA SHERADIN, CSR NO. 9128

23 JOB NO. 2528096

24
25 PAGES 1 - 14

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1 APPEARANCES (Telephonic appearances):

2

3 PANEL:

4

5 JUDGE CARL DeFRANCO

6 JUDGE THOMAS GIANNETTI

JUDGE RAMU ELLURU

7 JUDGE HYUN JUNG

8 JUDGE MICHAEL WOODS

9 JUDGE TINA HULSE

10

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Page 2

1 San Diego, California, Wednesday, January 25, 2017

2 11:32 a.m.

3 ooOOoo

4 JUDGE DeFRANCO: So, Mr. Schaefer, I received
5 your email requesting the call and identifying, I
6 believe, three issues to be discussed today. So let's
7 see if we can dispose of this first issue pretty
8 quickly.

9 So it appears to me from the explanation in the
10 email that Petitioner would like to change out Exhibit
11 1004, I believe, in the 1724 and 1735 cases, from a
12 patent that's currently of record to a published
13 application that corresponds to that patent. Is that
14 right?

15 MR. SCHAEFER: That's correct, although -- did
16 you say the 1724 and 1735?

17 JUDGE DeFRANCO: I did.

18 MR. SCHAEFER: I just want to confirm that's
19 what you said.

20 JUDGE DeFRANCO: I did.

21 MR. SCHAEFER: Okay. That's correct. Exhibit
22 1004 is an issued patent, and our ground in the petition
23 as described in the petition is actually based on the
24 published application 2003-0236015.

25 And so we want to swap that in as Exhibit 1004;

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1 and, in addition, file a corrected petition document
2 correcting two inadvertent references to the issued
3 patent, one being in the exhibit listing on page small
4 Roman numeral v and the other in the introduction
5 section on pages 2 of the two petitions.

6 JUDGE DeFRANCO: Now, I assume the petitions as
7 they currently stand both reference the published
8 application?

9 MR. SCHAEFER: That's correct. In the summary
10 of the grounds section, up front it identifies the
11 published application by number and explains why that
12 application document is the 102(b) reference.

13 And then in addition in the detailed discussion
14 of the grounds and, specifically, the published
15 application at issue, that all of the citations are to
16 paragraph numbers, hence the published application, and
17 not column and line numbers which would indicate the
18 issued patent.

19 JUDGE DeFRANCO: Okay. I assume this
20 correction line needs to be done to these two cases, the
21 1724 and the 1735? Because I think there's like 15
22 cases in this family. I just want to confirm that none
23 of those other petitions are implicated.

24 MR. SCHAEFER: Let me just correct that one
25 thing. There are actually three in the family.

1 Obviously, there are many petitions between the parties
2 involving other patent families; but one of the three
3 other petitions in this family, we correctly put in the
4 published application document.

5 JUDGE DeFRANCO: And which case is that?

6 MR. SCHAEFER: That's the 1723 case which is
7 also at issue here although on a different issue.

8 JUDGE DeFRANCO: And I understand Patent Owner
9 doesn't have any objection to you making those
10 corrections in the petition and swapping out the
11 exhibits? Is that correct, Mr. Babcock?

12 MR. BABCOCK: Yes, your Honor, with the caveat
13 that we -- given the confusion, we did at our POPRs cite
14 to the patent. And so if they are filing corrections to
15 their petitions, we would like authorization to file
16 corrected POPRs solely to correct the citations now to
17 the publication that's the exhibit as opposed to the
18 patent that is currently in the exhibit because we cited
19 to the patent, and the column and line numbers are
20 different than the paragraph numbers. So we would just
21 like authorization to make those administrative changes.

22 JUDGE DeFRANCO: Right. Obviously, that seems
23 like a reasonable request.

24 You don't have any problem with that,
25 Petitioner. Correct, Mr. Schaefer?

1 MR. SCHAEFER: No, we do not.

2 JUDGE DeFRANCO: So I don't really see a
3 problem here with making these corrections. But what I
4 would like to see is I would like to see it done quickly
5 because I think the judges are starting to pick up these
6 cases for consideration. So can you turn the
7 corrections around in a few days? I mean is that
8 reasonable?

9 MR. SCHAEFER: Certainly. We can do it by the
10 end of the day tomorrow at the latest.

11 JUDGE DeFRANCO: Okay, great. Before I
12 actually grant anything here, let's discuss this other
13 issue and then I'll confer with my colleagues and we'll
14 take it up all at once.

15 So let's turn to the second issue that you have
16 identified -- actually, it's issues two and three. I
17 think they kind of go together, Mr. Schaefer, from what
18 I can glean from your email.

19 So my understanding of these requests two and
20 three, and it's a citation to Rule 11, is that you
21 believe that the Patent Owner has made some sort of
22 misrepresentation or misstated some fact concerning
23 public availability of the manuals that you identify.

24 I think it's the manuals identified as Exhibit
25 1015 in the 1719 case and Exhibit 1006 in the 1723 and

1 1724 cases. Is that correct? Mr. Schaefer, is that the
2 essence of your request to strike?

3 MR. SCHAEFER: I can probably -- that's in
4 essence, although I could explain that in greater
5 detail, the basis for that; but those are the applicable
6 cases and the applicable exhibit numbers.

7 JUDGE DeFRANCO: So what exactly is your reason
8 for striking and -- actually, which portions of the
9 Patent Owner Preliminary Response do you want to strike?
10 Exactly where?

11 MR. SCHAEFER: So in the 1719 case, the
12 preliminary response which is Paper No. 10 is Part
13 IV(4)(b)(2) which appears on pages 26 through 28; and in
14 the 1723 preliminary response which is Paper No. 9 is
15 Part IV(4)(c) which appears on pages 25 through 30.

16 JUDGE DeFRANCO: So you are asking to strike
17 all of those pages? That whole section?

18 MR. SCHAEFER: The section, because there's
19 other content on those pages which is not -- the other
20 content on those pages I mentioned that are not part of
21 that section.

22 JUDGE DeFRANCO: What's your reason for asking
23 us to strike those sections? Is there some sort of
24 alleged misrepresentation?

25 MR. SCHAEFER: So, to be clear, these are

1 Patent Owner's own documents. They are documents that
2 are not marked confidential. They have a clear date on
3 them that is early enough to make them 102(b); and in
4 each case, we've laid out in the petition -- and I won't
5 go into the details of this -- but we lay out in the
6 petition in detail our supporting evidence that supports
7 our assertion that the dates on the document are, in
8 fact, accurate and reflect when the Patent Owner
9 published them, so, then, it's the nature of their
10 response to that that raises the problem in our view.

11 And if I might state -- quote specifically from
12 Rule 11.18(b)(2)(4) which is regarding the denial of
13 facts, that can only be done based upon the best of the
14 party's knowledge, information, and belief formed after
15 an inquiry reasonable under the circumstances.

16 And if you look at their response, the response
17 is in the nature of you haven't proven these to be prior
18 art printed publications. We haven't proven what the
19 date on the document specifically means. We haven't
20 proven what the word "issued" in the document actually
21 means, to give you just a couple of examples.

22 So what we submit is that given these are
23 Patent Owner documents, they are either prior art
24 printed publications and the Patent Owner after a
25 reasonable inquiry should know that and not deny their

1 prior art status or the Patent Owner has some argument
2 that it can make that it made an inquiry and that for
3 these reasons they are not prior art printed
4 publications.

5 JUDGE DeFRANCO: Let me stop you right there,
6 Mr. Schaefer. So I am looking at the Patent Owner
7 response here and all they are saying is that you,
8 meaning Petitioner, have not met your burden of showing
9 that these references are prior art because the burden
10 is initially on it, Petitioner, to show it.

11 And so they are just taking your evidence and
12 your facts, and that given those facts, they are arguing
13 that they don't add up to public availability as a
14 matter of law.

15 So they are not representing anything about
16 these references. They're just saying you have not met
17 your burden of showing public availability. So --

18 MR. SCHAEFER: Well, let me set aside --

19 JUDGE DeFRANCO: I'm not sure there's a Rule 11
20 violation, at least I am inclined not to think that
21 there is based on what you have said so far.

22 MR. SCHAEFER: Well, I guess here's what I
23 would say. I think while they -- they are denying the
24 fact that this is the prior art printed publication. It
25 is --

1 JUDGE DeFRANCO: No, they are --

2 MR. SCHAEFER: -- their own document.

3 JUDGE DeFRANCO: -- not making any denial here,
4 Mr. Schaefer. What they are saying is that you have not
5 met your burden. Maybe there is an implicit denial, but
6 expressly what they are saying is the burden is on you
7 to show public availability; the burden is on you to do
8 a reasonable investigation; and the burden is on you to
9 discuss the facts and show that there's public
10 availability.

11 All they are doing is arguing your facts and
12 then saying that those don't amount to meeting your
13 burden at this point. Now --

14 MR. SCHAEFER: I guess I hear what you are
15 saying, but I read into that argument implicit denial of
16 the prior art status.

17 Again, I'll go back to this is their own
18 document. I think it's very inappropriate for a Patent
19 Owner to contest this issue if they know the facts or if
20 they deliberately kept their eyes closed.

21 JUDGE DeFRANCO: I think at this point we can
22 look at these facts, and this doesn't seem that much
23 different than any other case where Petitioner is
24 relying on Patent Owner's own documents.

25 I think we can look at these facts ourselves

1 and make our own judgment whether we buy your version,
2 Petitioner's version or Patent Owner's arguments.

3 I don't think Patent Owner at this point is
4 putting forth any facts. They are just arguing the
5 facts as you have laid them out and saying that it's
6 insufficient.

7 So right now I don't see anything in need of
8 being stricken, but let me confer with my colleagues
9 first and then we can come to a decision.

10 Patent Owner, do you want to weigh in on this
11 at all? Mr. Babcock?

12 MR. BABCOCK: You said, your Honor, everything
13 that I would have said.

14 JUDGE DeFRANCO: So I am going to go offline
15 for a few minutes here and confer with my colleagues and
16 then we'll get back to you on both issues. So if you
17 all just hang on the line for a moment, we'll try to be
18 as quick as possible.

19 (Recess.)

20 JUDGE DeFRANCO: This is Judge DeFranco back on
21 the line. I have conferred with my colleagues.

22 Mr. Schaefer, are you still there?

23 MR. SCHAEFER: Yes, your Honor.

24 JUDGE DeFRANCO: And Mr. Babcock?

25 MR. BABCOCK: Yes, your Honor.

1 JUDGE DeFRANCO: So, obviously, on issue one,
2 you are fine -- I mean on request one you are fine with
3 changing out the exhibit and making the appropriate
4 corrections to the petition and the preliminary
5 response.

6 On issue two, at this point we don't see any
7 reason to strike any part of the patent or the
8 preliminary response based on some sort of Rule 11
9 violation.

10 However, what I would like to do is warn Patent
11 Owner that assuming we institute, if we institute, that
12 Petitioner may go down this road again depending on what
13 they find out about this prior art status of this
14 particular document. But it is your own document,
15 Patent Owner, it's in your possession. You may have the
16 best information. So we'll wait for another day to see
17 what happens with respect to that because you just need
18 to be candid with the Board as to whether or not this is
19 prior art and not make any misrepresentations if you
20 know, in fact, that it was publicly available.

21 So with that warning, we'll go ahead and we are
22 going to deny -- we're not going to grant Petitioner's
23 request at this point. Just keep that in mind,
24 Mr. Babcock. Okay?

25 MR. BABCOCK: Understood, your Honor.

1 JUDGE DeFRANCO: Mr. Schaefer, anything else?
2 MR. SCHAEFER: No, your Honor. Thank you.
3 JUDGE DeFRANCO: Mr. Babcock, anything else?
4 MR. BABCOCK: Nothing for us, your Honor.
5 JUDGE DeFRANCO: Okay, then. I believe we are
6 adjourned. Thank you all.
7 MR. BABCOCK: Thank you for your time.
8 MR. SCHAEFER: Thank you.
9 (TIME NOTED: 11:52 a.m.)
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1 STATE OF CALIFORNIA)
)
2 COUNTY OF SAN DIEGO)

3
4 I, Anela Sheradin, a Certified Shorthand
5 Reporter, do hereby certify:

6 That the foregoing proceedings were taken
7 before me at the time and place therein set forth and
8 were taken down by me in shorthand and thereafter
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10 supervision;

11 I further certify I am neither financially
12 interested in the action nor a relative or employee
13 of any attorney or party to this proceeding.

14 IN WITNESS WHEREOF, I have this date
15 subscribed my name.

16 Dated: 2/1/2017

17
18 
19 _____

20 ANELA SHERADIN

21 CSR NO. 9128

22
23
24
25

[& - corrections]

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