

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED LIMITED, RESMED INC., and RESMED CORP.,
Petitioner

v.

FISHER & PAYKEL HEALTHCARE LIMITED
Patent Owner

Case IPR2016-01719
Patent 6,398,197

**DECLARATION OF FRANK E. SCHERKENBACH IN SUPPORT OF
PETITIONER'S UNOPPOSED MOTION FOR *PRO HAC VICE*
ADMISSION**

RMD 1028
RESMED LIMITED V. FISHER & PAYKEL
IPR2016-01719

I, Frank E. Scherkenbach, hereby declare the following:

1. I am a Principal with the law firm of Fish & Richardson P.C. I represent Respondent ResMed Limited (“ResMed”) in connection with the above-captioned *inter partes* review proceeding and in connection with the underlying litigation in the Southern District of California (*Fisher & Paykel Healthcare Ltd. V. ResMed Corp.*, 3:16-cv-02068-DMS-WVG (S.D. Cal.)), which involves the patent at issue here, U.S. Patent No. 6,398,197 (“the ‘197 patent”).

2. I am a member in good standing of the State Bars of California and Massachusetts, as well as the United States Court of Appeals for the Federal Circuit. My California State Bar number is 142549, my Massachusetts State Bar number is 653819, and my United States Court of Appeals for the Federal Circuit is 1160944.

3. I am an experienced litigation attorney with more than 25 years of experience representing clients in patent cases involving medical devices, software, micro-electronics, and life sciences. I regularly litigate patent cases in federal district courts around the country and in the Court of Appeals for the Federal Circuit. Through my experience in patent litigation matters, I have represented clients in many phases of litigation including discovery, *Markman* hearings, trials, and appeals. My biography is attached hereto as Appendix A.

4. Since 2013, I have represented ResMed in connection with multiple patent litigations and *inter partes* review proceedings related to devices primarily

for use in the treatment of sleep disordered breathing, the technology generally at issue in the above-captioned *inter partes* review proceeding.

5. Through this work, I have developed in-depth knowledge of the issues and technology related to devices used for the treatment of sleep disordered breathing. This knowledge includes my analysis of a significant number of patents, articles, products, and other materials regarding devices for treatment of sleep disordered breathing. My experience in this area also includes knowledge gained from working closely with several experts in this technology in the context of litigation.

6. I am intimately familiar with the issues presented in this above-captioned *inter partes* review proceeding. Though not previously, formally admitted to appear in this proceeding, I have been actively involved in the above-captioned *inter partes* review proceeding. I have also been involved in related litigation proceedings on behalf of ResMed, which involve issues that overlap with the issues in these IPR proceedings. Through this work, I have extensively reviewed the '197 patent, its prosecution history and related materials. Moreover, not only have I reviewed and understand the '197 patent and its corresponding file history, but my work in the above-described litigation has also resulted in my detailed review of the Petition for *Inter Partes* Review (including the proposed invalidity grounds therein, the cited references, and exhibits), the accompanying Declaration of Mr. Eaton, the

Board's Decision instituting *inter partes* review, and other materials from the above-captioned *inter partes* review proceeding. Throughout my work on behalf of ResMed, I have gained familiarity with the claim construction issues (implicit and explicit) and the prior art references at issue in the above-captioned *inter partes* review proceeding.

7. In the past three years, I have previously applied to appear before the Board in the following proceedings and all were granted: IPR2013-00206, IPR2013-00208, IPR2013-00395, IPR2013-00396, IPR2014-00034, IPR2014-00073, IPR2014-00074, IPR2014-00075, IPR2014-00081, and IPR2014-00087. I am concurrently applying to appear pro hac vice in the following proceedings: IPR2016-01716, IPR2016-01717, IPR2016-01729, IPR2016-01730, IPR2016-01731, IPR2016-01725, and IPR2016-01727.

8. I have not been suspended or disbarred from practice before any court or administrative body.

9. I have never had an application for admission to practice before any court or administrative body denied, except that Motions for *Pro Hac Vice* Admission in two *inter partes* reexamination proceedings (95/001,888 and 95/001,889) were treated as petitions under 37 C.F.R. § 41.3 and denied for reasons specific to the circumstances of those reexamination proceedings.

10. No sanction or contempt citation has been imposed against me by any court or administrative body.

11. I have read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of the Code of Federal Regulations.

12. I will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.* and disciplinary jurisdiction under 37 C.F.R. § 11.19(a).

I hereby declare that all statements made herein of my own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 35 U.S.C. § 1001.

Respectfully submitted,

Date: October 27, 2017

/Frank E. Scherkenbach/

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APPENDIX A



Frank E. Scherkenbach

Principal

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scherkenbach@fr.com

Background

Frank Scherkenbach is a leading patent trial lawyer who specializes in complex high technology litigation, with particular expertise in computer software, semiconductors, and medical devices. To date, Mr. Scherkenbach has tried approximately three dozen patent cases to jury verdict, as well as many bench trials.

A few of Mr. Scherkenbach's jury trial wins have been selected by *The National Law Journal* as particularly significant: *Power Integrations, Inc. v. Motorola, Inc.*, in which Mr. Scherkenbach and his team achieved a jury award of \$32.3 million, was named as one of the "most significant intellectual property cases" of 1999; and both *Adobe Systems Inc. adv. Quantel Ltd.* and the *Microsoft adv. Arendi* verdicts were named as "Top 10 Defense Verdicts" of the year in 1997 and 2004, respectively.

More recently, Mr. Scherkenbach achieved a defense win for Adobe against EveryScape in Boston, where in 2015 a jury invalidated all asserted claims in the two patents at issue, and he obtained a \$105 million verdict for Power Integrations in 2014 against Fairchild Semiconductor – one of the largest patent jury verdicts of the year.

Mr. Scherkenbach also practices before the International Trade Commission (ITC), where he most recently tried a multi-patent medical device case for ResMed in 2014, and regularly handles appeals to the Federal Circuit.

Services

- Litigation
- Appellate
- ITC Litigation
- Patent Litigation

Industries

- Cleantech
- Electrical and Computer Technology
- Manufacturing
- Medical Devices
- Semiconductors
- Software
- Telecommunications

Education

J.D., Harvard Law School 1989

Co-Founder, Editor-in-Chief, *Harvard Journal of Law & Technology*

B.S., Stanford University 1986

Mechanical Engineering

with distinction, *Phi Beta Kappa, Tau Beta Pi*

A.B., Stanford University 1986

Classics

with distinction

Admissions

- California 1989
- Massachusetts 2003
- U.S. Court of Appeals for the Federal Circuit

Clerkships

United States Court of Appeals for the Federal Circuit, The Honorable Haldane Robert Mayer, 1989 - 1991

Memberships & Affiliations

Founder and Editor-in-Chief, *Harvard Journal of Law & Technology* (1988-1989). Member of the Federal Circuit Bar Association, the American Bar Association, and the American Intellectual Property Law Association.

Other Distinctions

Publications:

- *GCs Name Favorite IP Lawyers*, *Law360*, February 10, 2015
- *Changes Ahead for NPE Patent Litigation*, *The Metropolitan Corporate Counsel*, June 4, 2014
- *Protecting Clients' Assets: Fish & Richardson*, *The Best Lawyers: New England 2014*, April 28, 2014
- *Q&A With Fish & Richardson's Frank Scherkenbach*, *Law360*, April 30, 2013

Accolades:

- - "IP Star" by *Managing Intellectual Property*, 2013-2017
 - Leading practitioner in patent law by IAM Patent 1000: The World's Leading Patent Practitioners, 2012 – 2016
 - Named Trial Ace by *Law360*, 2015
 - Named Local Litigation Star for Massachusetts and California and National Litigation Star, *Benchmark Litigation*, 2013 – 2015
 - Recognized by Chambers USA as a notable practitioner in Intellectual Property, 2005 – 2015
 - Named a "Client Service All-Star" by BTI Consulting Group, 2015
 - The *Best Lawyers in America* in Patent Litigation, 2007 – 2018
 - Massachusetts Super Lawyer, 2009-2013
 - IAM 250, The World's Leading Patent Litigator, 2011

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