

EXHIBIT 3001

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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

FISHER & PAYKEL HEALTHCARE
LIMITED, a New Zealand corporation,

Plaintiff,

v.

RESMED CORP., a Minnesota
corporation,

Defendant.

CASE NO. 16cv2068 DMS (WVG)

**ORDER GRANTING RESMED'S
MOTION TO STAY PENDING
RESOLUTION OF *INTER PARTES*
REVIEW**

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This case comes before the Court on ResMed's motion to stay Fisher & Paykel's claims pending review by the Patent Trial and Appeal Board ("PTAB") of ResMed's petitions for *inter partes* review of the Fisher & Paykel patents-in-suit. Fisher & Paykel filed an opposition to the motion, and ResMed filed a reply. For the reasons discussed below, the motion is granted.

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I.

BACKGROUND

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This case is one of many currently pending between the parties. In addition to this case, RedMed currently has patent infringement actions against Fisher & Paykel pending in both Germany and New Zealand and before the United States International Trade Commission ("ITC"). Fisher & Paykel also recently filed an action in the High Court of Justice in the United Kingdom seeking a judgment that three ResMed European Patents are invalid and not infringed by the same products accused of

7 Corporation filed an Answer and Counterclaim. In the Counterclaim, ResMed asserts
8 claims for declaratory judgment of noninfringement and invalidity of Fisher & Paykel's
9 patents and seven additional claims for infringement of its own patents. On October 3,
10 2016, Fisher & Paykel Healthcare Limited, Fisher & Paykel Healthcare, Inc. and Fisher
11 & Paykel Healthcare Distribution Inc. filed an Answer to the Counterclaims and
12 Counterclaims for declaratory judgment of noninfringement and invalidity of ResMed's
13 patents.

14 On October 6, 2016, Fisher & Paykel Healthcare Limited, Fisher & Paykel
15 Healthcare, Inc. and Fisher & Paykel Healthcare Distribution Inc. filed a motion to stay
16 ResMed's counterclaims on two of its patents pending proceedings before the ITC on
17 those patents. ResMed did not oppose that motion, and the Court granted the request
18 to stay that portion of this case on November 17, 2016.¹

19 With respect to the present motion, on September 7, 2016, the same day it filed
20 its Answer in this case, ResMed filed fifteen petitions for *inter partes* review with the
21 PTAB challenging the validity of every asserted claim of the Fisher & Paykel patents-

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23 ¹ In a recent filing, ResMed informed the Court that Fisher & Paykel has
24 petitioned for *inter partes* review of four of the seven ResMed patents-in-suit. ResMed
25 indicated in the present motion that it would not oppose a stay on that portion of the
26 case if requested by Fisher & Paykel. Two of the patents at issue in Fisher & Paykel's
27 petition are already subject to the stay pending the ITC proceedings, therefore, there is
28 no need to request a stay as to those patents. If the parties wish to stay litigation on the
other two patents, the Court requests they do so by way of a joint motion. If the case
is stayed as to those two patents, this litigation will proceed on the three remaining
ResMed patents only. As to that portion of the case, Fisher & Paykel Healthcare
Corporation Limited has filed a motion to dismiss it from this case for lack of personal
jurisdiction and failure to state a claim, which motion is scheduled for hearing on
December 22, 2016.

DISCUSSION

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8 As stated above, ResMed moves to stay litigation on Fisher & Paykel's patents
9 pending resolution of its request for *inter partes* review. Fisher & Paykel asserts
10 ResMed's petitions for review are barred by 35 U.S.C. § 315(a)(1). It also argues the
11 relevant factors weigh against the imposition of a stay.

12 A. Statutory Bar

13 Fisher & Paykel's first argument in response to ResMed's motion to stay is that
14 the petitions for *inter partes* review are barred by 35 U.S.C. § 315(a)(1). This statute
15 provides: "An *inter partes* review may not be instituted if, before the date on which the
16 petition for such a review is filed, the petitioner or real party in interest filed a civil
17 action challenging the validity of a claim of the patent." 35 U.S.C. § 315(a)(1). On
18 August 16, 2016, three weeks before it filed the petitions for review, ResMed filed a
19 Complaint against Fisher & Paykel in this Court challenging the validity of Fisher &
20 Paykel's patents. *See ResMed Inc. v. Fisher & Paykel Healthcare Corporation Limited*,
21 Case No. 16cv2072.² Fisher & Paykel argue that filing falls within the plain language
22 of the statute and precludes the PTAB from granting ResMed's petitions for review, and
23 thus the motion for stay should be denied.

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26 ² ResMed's Complaint was not the first to be filed. On August 15, 2016, the day
27 before ResMed filed its Complaint, Fisher & Paykel filed a Complaint against ResMed
28 in the United States District Court for the Central District of California. *See Fisher &*
Paykel Healthcare Limited v. ResMed Corp., Case No. 16cv6099. The following day,
Fisher & Paykel filed the Complaint in this case, and dismissed the Complaint filed in
the Central District. Within an hour of Fisher & Paykel's filing in this case, ResMed
filed its Complaint.

7 *Networks Licensing, LLC*, Case IPR2015-00483, 2015 WL 4760575 (Patent Trial and
8 Appeal Bd. July 15, 2015); *Cyanotech Corp. v. Bd. of Trustees of the Univ. of Illinois*,
9 Case IPR2013-00401, 2013 WL 8563804 (Patent Trial and Appeal Bd. Dec. 19, 2013).
10 In those cases, the PTAB correctly notes that voluntary dismissal of an action leaves
11 “the parties as though the action had never been brought.” *Tristar Products*, 2015 WL
12 2865739, at * 4 (quoting *Macauto U.S.A. v. BOS GmbH & KG*, Case IPR2012-0004,
13 slip. op. at 15 (Patent Trial and Appeal Bd. Jan. 24, 2013)). See also Charles Alan
14 Wright & Arthur R. Miller, *Federal Practice and Procedure* § 2637, at 321 (2d ed. 1995)
15 (stating “as numerous federal courts have made clear, a voluntary dismissal without
16 prejudice under Rule 41(a) leaves the situation as if the action never had been filed”).
17 ResMed further argues that when § 315(a)(1) was enacted in 2011, at least eight
18 Circuits had already determined that a dismissal without prejudice makes the situation
19 as if the action never had been filed. Quoting *Astoria Federal Sav. and Loan Ass’n v.*
20 *Solimino*, 501 U.S. 104, 108 (1991), ResMed points out: “[W]here a common-law
21 principle is well established, ... ‘the courts may take it as given that Congress has
22 legislated with an expectation that the principle will apply[.]’” (Reply Br. at 4.) ResMed
23 argues that § 315(a)(1) uses the word “filed” consistently with the settled understanding
24 that a suit dismissed without prejudice is treated as if it was not “filed” at all, and thus
25 does not bar institution of an IPR. This Court agrees.

26 Accordingly, “[b]ecause the effect of a voluntary dismissal without prejudice is
27 to render the prior action a nullity, such actions cannot give rise to a statutory bar under
28 35 U.S.C. § 315(a)(1).” *Tristar Products*, 2015 WL 2865739, at * 4. The reasoning of

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