UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of	Inv. No. 337-TA-1266
CERTAIN WEARABLE ELECTRONIC DEVICES WITH ECG FUNCTIONALITY AND COMPONENTS THEREOF	

RESPONDENT APPLE INC.'S EMERGENCY MOTION TO SUSPEND ANY REMEDY OR EXTEND THE TARGET DATE AND STAY PROCEEDINGS PENDING RESOLUTION OF ANY APPEAL OF THE PATENT OFFICE'S DECISION THAT UNITED STATES PATENT NOS. 10,638,941, 10,595,731, AND 9,572,499 ARE UNPATENTABLE.

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INTRODUCTION

On December 6, 2022, the Patent Trial and Appeal Board ("PTAB") issued Final Written Decisions holding unpatentable all asserted claims of the three patents at issue in this Investigation: United States Patent Nos. 10,638,941 ("the '941 patent"), 10,595,731 ("the '731 patent), and 9,572,499 ("the '499 patent"). The PTAB's Final Written Decisions are appended to this Motion.

In light of the PTAB's recent orders, Respondent Apple Inc. ("Apple") respectfully petitions the Commission to suspend any remedial orders or, in the alternative, extend the December 12, 2022 Target Date of its Final Determination and stay all proceedings prior to issuance of any Final Determination pending final resolution of any appeal of the PTAB's decisions. A suspension is consistent with the Commission's routine past practice. A stay will simplify the issues and conserve agency and party resources—by avoiding issuance of a merits determination that is likely to be mooted by an affirmance of the PTAB's Final Written Decisions—without causing any harm to Complainant. And either a suspension or a stay accords due deference to the Patent Office's role as the lead agency in assessing patentability and honors Congress's intent that invalid patents should not be enforced.

Given the short time until the Commission's December 12, 2022 Target Date, Apple asks that the Commission consider this Motion on an emergency basis.[1]

FACTS

This Investigation concerns three heart-health monitoring features of Apple Watch: the ECG app, Irregular Rhythm Notification ("IRN"), and High Heart Rate Notification ("HHRN"). The ECG app enables users to take electrocardiograms to determine whether they are experiencing atrial fibrillation ("AFib"), a potentially life-threatening heart condition that afflicts millions in the United States. IRN monitors the regularity of users' heart rates to identify signs consistent with AFib. HHRN informs users

[1] Counsel for Apple contacted counsel for Complainant and for the Office of Unfair Import Investigations ("OUII") regarding this Motion. Complainant has not yet indicated its position on this Motion and will provide its position after it sees the Motion. Counsel for OUII support the motion to the extent that it asks the Commission to suspend enforcement of any remedial orders pending appeal of the PTAB's Final Written Decisions, but otherwise oppose the Motion. The Commission may wish to extend the Target Date for a Final Determination to allow sufficient time for full briefing and consideration of this Motion.

when their heart rates are elevated above a user-set threshold during periods of relative inactivity.

Complainant AliveCor, Inc. ("AliveCor") filed a § 337 Complaint against Apple, alleging that Apple Watches with these heart-health features infringe certain claims of three of its patents: the '941 patent, the '731 patent, and the '499 patent. The Commission thereafter instituted this Investigation. In June 2022, an Administrative Law Judge issued an Initial Determination finding § 337 violations with respect to the '941 and '731 patents and no violation with respect to the '499 patent. The Initial Determination recommended issuing a limited exclusion order and cease and desist order barring Apple from importing and selling the accused Apple Watches. The Commission determined to review the Initial Determination in part and requested submissions from the parties regarding certain merits questions as well as the issues of remedy, the public interest, and bonding.

In its submissions to the Commission, Apple explained that it had filed *inter partes* review ("IPR") petitions on the three patents with the PTAB, EDIS No. 745156, and that the PTAB had instituted IPRs for all asserted claims, EDIS No. 759993, Ex. A, at 48, Ex. B at 47, and Ex. C at 53. Apple also stated that Final Written Decisions on those claims were expected before the Commission's Target Date in this Investigation. Accordingly, Apple suggested that the Commission suspend any remedial orders pending resolution of the PTAB's Final Written Decisions. *See* Respondent's Initial Submission, EDIS No. 782052, at 69-70; *see also* Respondent's Reply Submission, EDIS No. 782552, at 44-45. Both Staff and AliveCor argued in their submissions that a suspension was unwarranted because the PTAB had not yet found any asserted claim unpatentable. *See* Staff's Reply Submission, EDIS No. 782587, at 20-21; Complainant's Reply Submission, EDIS No. 781827, at 38-39. Staff, however, agreed that "it may be appropriate to delay the effect of any remedial orders" "[s]hould … the PTAB issue a Final Written Decision that affects the asserted claims prior to the Commission's final determination on violation." Staff's Reply Submission, EDIS No. 782587, at 21.

As Apple anticipated, the PTAB has now issued its Final Written Decisions and has determined that the claims of the three patents asserted in this Investigation are unpatentable because they are obvious

under 35 U.S.C. § 103:[2]

- As to the '941 patent, the PTAB determined that claims 12, 19, 20, 22, and 23 are unpatentable as obvious over PCT Patent Pub. No. WO 2012/140559 ("Shmueli") in light of U.S. Patent Pub. No. 2014/0275840 ("Osorio"). Attached Ex. A: *Apple, Inc. v. AliveCor, Inc.*, IPR2021-00972, Paper 43 at 3-4, 29-47, 53 (P.T.A.B. Dec. 6, 2022) (Final Written Decision invalidating claims 1-23) ("'941 FWD"). It also determined that claim 13 is obvious over Shmueli in light of Osorio and Jinseok Lee et al., *Atrial Fibrillation Detection using a Smart Phone*, 15:1 Int'l. J. of Bioelectromagnetism 26–29 (2013), and that claim 21 is unpatentable as obvious over Shmueli in light of Osorio and U.S. Patent No. 7,894,888 ("Chan"). Attached Ex. A: '941 FWD at 3-4, 47-53.
- As to the '731 patent, the PTAB determined that claims 1, 12, and 16 are unpatentable as obvious over both Shmueli alone and Shmueli in light of Osorio. Attached Ex. B: *Apple, Inc. v. AliveCor, Inc.*, IPR2021-00971, Paper 42 at 2-4, 30-49, 58 (P.T.A.B. Dec. 6, 2022) (Final Written Decision invalidating claims 1-30) ("'731 FWD"). It also determined that claims 3 and 5 are unpatentable as obvious over Shmueli in light of Osorio and Li Q, Clifford GD, *Signal quality and data fusion for false alarm reduction in the intensive care unit*, 45(6) J. Electrocardiol. 596-603 (2012). Attached Ex. B: '731 FWD at 2-4, 49-56, 58. It further determined that claims 8-10 are unpatentable as obvious over Shmueli in light of Osorio and Kleiger RE, Stein PK, Bigger JT Jr., *Heart rate variability: measurement and clinical utility*, 10(1) Ann Noninvasive Electrocardiol. 88-101 (2005). Attached Ex. B: '731 FWD at 2-4, 56-58. Moreover, the PTAB determined that claim 15 is unpatentable as obvious over Shmueli in light of Osorio and Chan. *Id.*.
- As to the '499 patent, the PTAB determined that claim 16 is unpatentable as obvious over Shmueli in light of Osorio. Attached Ex. C: *Apple, Inc. v. AliveCor, Inc.*, IPR2021-00970, Paper 43 at 2-4, 28-42, 53 (P.T.A.B. Dec. 6, 2022) (Final Written Decision invalidating 1-20) ("'499 FWD"). It also determined that claim 17 is unpatentable as obvious over Shmueli in light of Osorio and Hu et al., 44(9) *A Patient-Adaptable ECG Beat Classifier Using a Mixture of Experts Approach*, IEEE Transactions

[2] The PTAB has actually held that all claims challenged in the IPRs—which are a superset of the claims asserted in this Investigation—are unpatentable for all three challenged patents.

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