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Paper 7
Date: March 2, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01520
Patent 10,258,265 B1

Before GEORGE R. HOSKINS, ROBERT L. KINDER, and AMANDA F. WIEKER, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314; 37 C.F.R. § 42.4

I. INTRODUCTION

Apple Inc. ("Petitioner") has filed a Petition (Paper 2, "Pet.") pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–4, 6–14, and 16–30 of U.S. Patent No. 10,258,265 B1 ("the '265 patent").

Masimo Corporation ("Patent Owner") elected to waive the filing of a Preliminary Response. *See* Paper 6; 37 C.F.R. § 42.107 (2019).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires the Petition to demonstrate a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we institute, on behalf of the Director (37 C.F.R. § 42.4(a)), an *inter partes* review to determine whether Petitioner demonstrates by a preponderance of the evidence that claims 1–4, 6–14, and 16–30 are unpatentable, considering all grounds asserted in the Petition.

II. BACKGROUND

A. Real Parties-in-Interest and Related Proceedings

Petitioner identifies itself as the sole real party-in-interest for Petitioner. Pet. 104. Patent Owner identifies itself as the sole real party-in-interest for Patent Owner. Paper 4, 1.

The parties identify one judicial matter as related to this proceeding: *Masimo Corporation et al. v. Apple Inc.*, Civil Action No. 8:20-cv-00048-JVS-JDE (C.D. Cal.) ("the parallel district court litigation"). Pet. 105; Paper 4, 1. We are also aware of several other IPR proceedings challenging other patents at issue in the parallel district court litigation. *See, e.g.*, Pet. 105; Paper 4, 3.

B. The '265 Patent

The '265 patent concerns noninvasive devices and methods for measuring blood analytes such as glucose, or other physiologically relevant characteristics such as pulse rate. *See* Ex. 1001, Abstract, 2:20–30. Figures 3C and 3E are reproduced below:

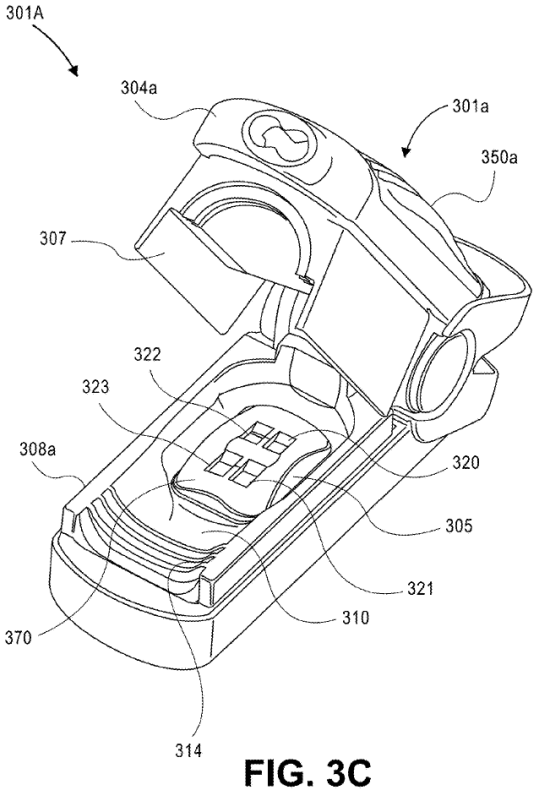

FIG. 3C

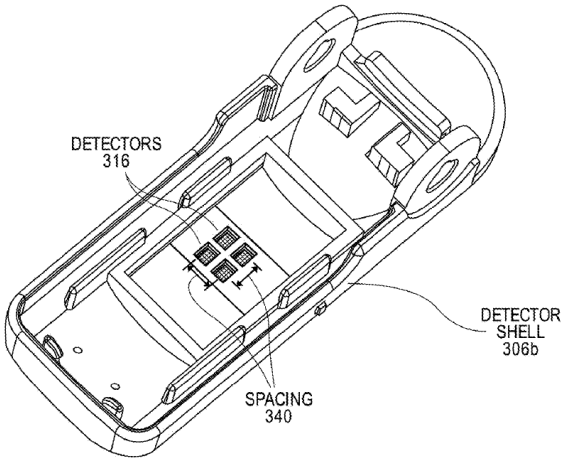

FIG. 3E

Figure 3C is a perspective view of sensor 301a, comprising upper emitter shell 304a pivotally connected to lower detector shell 306a, to sandwich a person's finger between the shells. *See id.* at 5:52–55, 18:39–51. Figure 3E is a perspective view of detector shell 306b of a different but similar sensor 301b, showing photodetectors 316 disposed therein. *See id.* at 5:59–61, 22:21–40 ("The features described with respect to the detector shell 306b can also be used with the detector shell 306a of the sensor 301a.").

Emitter shell 304a houses various emitter components (not shown in Figure 3C) such as LEDs, which emit light of different wavelengths, such as visible light, near infrared light, or infrared light. *See id.* at 5:3–7, 12:3–12, 13:8–15, 18:40–42, 18:62–63.

Detector shell 306a houses four photodetectors 316, one underneath each window 320–323 within finger bed 310 formed on top of shell 306a. *See id.* at 19:4–5, 19:13–16, 19:38–48. Finger bed 310 includes "a tissue thickness adjustor or protrusion 305," which may be interchanged to correspond to different finger shapes, characteristics, opacity, sizes, and the like. *Id.* at 19:29–37.

Sensor 301a operates in the following manner. A person places a finger on finger bed 310, and upper emitter shell 304a pivots toward lower detector shell 306a to hold the finger in place, and to shield the interior of sensor 301a from interference by ambient light. *See id.* at 16:52–64, 18:43–51, 18:66–19:20. Then, the emitters housed in emitter shell 304a emit light of different wavelengths, to pass through the person's finger and into windows 320–323 within finger bed 310, to reach photodetectors 316. *See id.* at 19:38–48. Photodetectors 316 capture and measure the light, which has been attenuated by the person's finger tissue, and output responsive signals to a processor that uses the signals to derive the concentration of a blood analyte such as glucose, or some other physiological parameter such as pulse rate. *See id.* at 2:20–30, 10:30–39, 10:62–11:1, 14:11–19, 15:31–35.

Another detector subassembly is shown in Figure 14D, reproduced below:

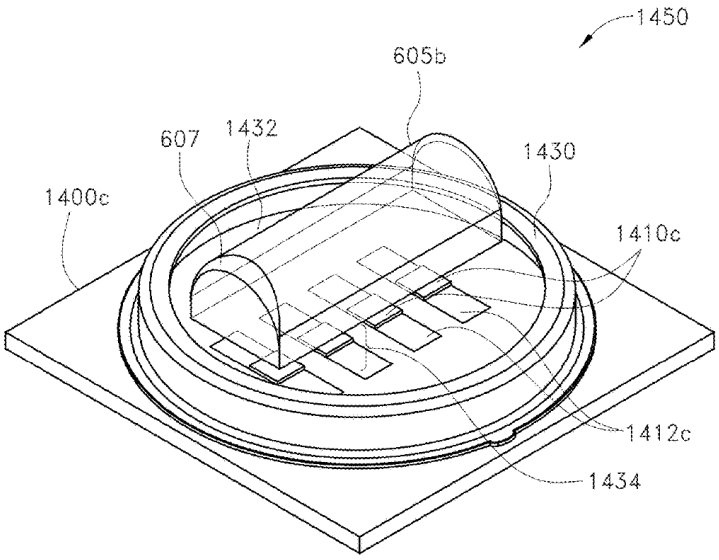

FIG. 14D

Figure 14D illustrates subassembly 1450 including submount 1400c, cylindrical housing 1430, transparent cover 1432 with protrusion 605b disposed on it, and four detectors 1410c. *See id.* at 6:54–55, 36:38–47. The light focusing properties provided by protrusion 605b advantageously reduce the number of detectors, or rows of detectors, that are required. *See id.* at 35:56–36:10; *see also id.* at Fig. 14B, 36:11–30 (illustrating and describing function of protrusion 605 to focus light on detector(s) 1410b).

C. The Claims of the '265 Patent

The '265 patent lists thirty claims, including two independent claims, claims 1 and 26. Ex. 1001, 44:65–47:20. Petitioner challenges all but claims 5 and 15. We reproduce illustrative claim 1 here:

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