

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01537
Patent 10,588,553 B2

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

KINDER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background*

Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–29 (“challenged claims”) of U.S. Patent No. 10,588,553 B2 (Ex. 1001, “the ’553 patent”). Paper 3 (“Pet.”). Masimo Corporation (“Patent Owner”) waived filing a preliminary response. Paper 8 (“PO Waiver”).

We have authority to determine whether to institute an *inter partes* review, under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314 (2018); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

For the reasons provided below and based on the record before us, we determine that Petitioner has demonstrated a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we institute an *inter partes* review on all grounds set forth in the Petition.

B. *Related Matters*

The parties identify the following matters related to the ’553 patent: *Masimo Corporation v. Apple Inc.*, Civil Action No. 8:20-cv-00048 (C.D. Cal.) (filed Jan. 9, 2020) (“the parallel district court litigation”);

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Apple Inc. v. Masimo Corporation, IPR2020-01536 (PTAB Aug. 31, 2020) (challenging claims 1–29 of the '553 patent);¹

Apple Inc. v. Masimo Corporation, IPR2020-01520 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,258,265 B1);

Apple Inc. v. Masimo Corporation, IPR2020-01521 (PTAB Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,292,628 B1);

Apple Inc. v. Masimo Corporation, IPR2020-01523 (PTAB Sept. 9, 2020) (challenging claims of U.S. Patent No. 8,457,703 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01524 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,433,776 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01526 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 6,771,994 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01538 (PTAB Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,588,554 B2); and

Apple Inc. v. Masimo Corporation, IPR2020-01539 (PTAB Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,588,554 B2).

Pet. 3; Paper 5, 3.

¹ Pursuant to the Board's November 2019, Consolidated Trial Practice Guide, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>, Petitioner filed a Notice ranking its two petitions that challenge the '553 patent, ranking second the instant proceeding and ranking first IPR2020-01536. Paper 2, 2. We decline to exercise discretion to deny institution in this case where (1) Patent Owner does not request that we exercise discretion to deny due to the presence of multiple petitions, (2) the two petitions challenge a large claim set, and (3) Petitioner represents that, at the time of the filing, Patent Owner had not yet narrowed the claims asserted in the parallel district court litigation. Paper 2, 2–3; Ex. 1033 (reduction in claims due after petitions were filed).

Patent Owner further identifies certain pending patent applications, as well as other issued and abandoned applications, that claim priority to, or share a priority claim with, the '553 patent. Paper 5, 1–2.

C. The '553 Patent

The '553 patent is titled “Multi-Stream Data Collection System for Noninvasive Measurement of Blood Constituents,” and issued on March 17, 2020, from U.S. Patent Application No. 16/534,949, filed August 7, 2019. Ex. 1001, codes (21), (22), (45), (54). The '553 patent claims priority through a series of continuation and continuation-in-part applications to Provisional Application Nos. 61/078,228 and 61/078,207, both filed July 3, 2008. *Id.* at codes (60), (63).

The '553 patent relates to noninvasive methods and devices for measuring various blood constituents or analytes. *Id.* at code (57). The '553 patent discloses a two-part data collection system including a noninvasive sensor that communicates with a patient monitor. *Id.* at 2:38–40. The sensor includes a sensor housing, an optical source, and several photodetectors, and is used to measure a blood constituent or analyte, e.g., oxygen or glucose. *Id.* at 2:29–35, 64–65. The patient monitor includes a display and a network interface for communicating with a handheld computing device. *Id.* at 2:45–48.

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