IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Jeroen Poeze et al.
U.S. Patent No.:	10,588,554
Issue Date:	March 17, 2020
Appl. Serial No.:	16/544,713
Filing Date:	August 19, 2019
Title:	MULTI-STREAM DATA COLLECTION SYSTEM FOR NONINVASIVE MEASUREMENT OF BLOOD CONSTITUENTS

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PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,588,554

Apple is filing two petitions (IPR2020-01538 and IPR2020-01539) challenging U.S. Patent No. 10,588,554 (the "'554 Patent"). Pursuant to the November 2019 Trial Practice Guide Update, this paper provides: "(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions." Trial Practice Guide, 59-61.

I. Ranking of Petitions

Although Apple believes that both petitions are meritorious and justified, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Reference
1	IPR2020-01538	Mendelson '799
2	IPR2020-01539	Aizawa

II. Considerations in Allowing Multiple Petitions Covering Different Grounds Where Patent Owner Has Asserted a Large Number of Claims

Apple is a defendant in a pending infringement suit involving the '554 Patent, in addition to eleven other patents that are presently asserted. Although the District Court recently ordered the parties to submit "a joint proposal for an initial reduction of infringement contentions" by September 21, 2020, Patent Owner has

not yet narrowed the asserted claims. APPLE-1033, 1. As such, any of the '554 Patent's 28 claims might potentially be asserted.

Given the uncertainty of which claims will ultimately be asserted, Petitioner is forced to address all claims of the '554 Patent in the present IPRs. If Petitioner were to leave some claims unaddressed, Patent Owner would be free to strategically tailor its final set of asserted claims in the Litigation to include claims left unaddressed in these IPRs. Petitioner attempted to fully address all 28 claims in a single petition, but was forced to split its arguments into two petitions due to word count constraints.

Thus, the need for two Petitions is driven by uncertainty regarding which claims will ultimately be asserted in the Litigation. Patent Owner should not be allowed to hamper Apple's ability to effectively use IPR as a defense by choosing to leave its assertion broad.

III. Material Differences Between the Petitions

Material differences exist. At bottom, the Petitions are non-redundant simply in their reliance on different combinations of references that address the claim elements in materially different ways. Although the combinations of references presented in each Petition render obvious the claims of the '554 Patent, they do so in different ways, using different description.

IPR2020-01538 relies on Mendelson '799 as its primary reference. Mendelson '799 describes a pulse oximeter featuring a sensor housing 17 that accommodates a "light source 12 composed of three closely spaced light emitting elements (e.g., LEDs or laser sources)" and an array of twelve "discrete detectors (e.g., photodiodes)." APPLE-1012, Title, Abstract, 9:22-40, 10:16-37, FIGS. 7, 8. In contrast, the primary reference in IPR2020-01539 is Aizawa, which describes a pulse wave sensor featuring "four photodetectors" disposed around a central light source and a "holder" that secures the light source and photodetectors. APPLE-1006, ¶[0023]; FIGS. 1(a), 1(b).

These distinct primary references, in combination with various secondary references, apply differently to the claims of the '554 Patent. Additionally, motivation to combine the distinct sets of references presented in the two Petitions materially differs.

In summary, the Petitions are not redundant, duplicative, or substantially similar. Each Petition provides a strong showing of unpatentability and/or obviousness, without repeating the same theory. Accordingly, Petitioner requests that the Board institute trial on both Petitions.

Respectfully submitted,

Dated: September 2, 2020

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