UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE PATENT TRIAL AND APPEAL BOARD APPLE INC., Petitioner, v. MASIMO CORPORATION, Patent Owner. IPR2020-01723

Patent 10,470,695 B2

Before JOSIAH C. COCKS, ROBERT L. KINDER, and AMANDA F. WIEKER, *Administrative Patent Judges*.

COCKS, Administrative Patent Judge.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Apple Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–6, 8, 9, 11–19, and 21–30 ("challenged claims") of U.S. Patent No. 10,470,695 B1 (Ex. 1001, "the '695 patent"). Paper 2 ("Pet."). Masimo Corporation ("Patent Owner") waived filing a preliminary response. Paper 7.

Petitioner concurrently filed another petition for *inter partes* review of claims of the '695 patent on additional grounds not asserted in this Petition. *Apple, Inc. v. Masimo Corporation*, IPR2020-01722, Paper 2 (PTAB October 2, 2020) ("the '1722 Petition"). As set forth in the Decision on Institution in IPR2020-01722, we institute an *inter partes* review of claims 1–6, 8, 9, 11–19, and 21–30. *See* IPR2020-01722, Paper 8. For the reasons provided below and based on the circumstances present here, we exercise the Director's discretion under 35 U.S.C. § 314(a) and deny institution of an *inter partes* review based on the present Petition.

B. Related Matters

Patent Owner identifies the following matters related to the '695 patent:

Masimo Corporation v. Apple Inc., Civil Action No. 8:20-cv-00048 (C.D. Cal.) (filed Jan. 9, 2020);

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

¹ The '1722 Petition and the present Petition, both filed October 2, 2020, are collectively referred to as the "Concurrent Petitions."



- 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
- Aug. 31, 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, IPR2020-01536 (PTAB
- Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,588,553 B2); Apple Inc. v. Masimo Corporation, IPR2020-01537 (PTAB
- Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,588,553 B2); Apple Inc. v. Masimo Corporation, IPR2020-01538 (PTAB
- Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,588,554 B2); Apple Inc. v. Masimo Corporation, IPR2020-01539 (PTAB
- Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,588,554 B2);

 Apple Inc. v. Masimo Corporation, IPR2020-01713 (PTAB Sept. 30,
- 2020) (challenging claims of U.S. Patent No. 10,624,564 B1);

 Apple Inc. v. Masimo Corporation, IPR2020-01714 (PTAB Sept. 30,
- 2020) (challenging claims of U.S. Patent No. 10,631,765 B1 patent);

 Apple Inc. v. Masimo Corporation, IPR2020-01715 (PTAB Sept. 30,
- 2020) (challenging claims of U.S. Patent No. 10,631,765 B1 patent);

 Apple Inc. v. Masimo Corporation, IPR2020-01716 (PTAB Sept. 30,
- 2020) (challenging claims of U.S. Patent No. 10,702,194 patent);



Apple Inc. v. Masimo Corporation, IPR2020-01722 (PTAB Oct. 2,

2020) (challenging claims of U.S. Patent No. 10,470,695 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01733 (PTAB Sept. 30,

2020) (challenging claims of U.S. Patent No. 10,702,195 B1); and

Apple Inc. v. Masimo Corporation, IPR2020-01737 (PTAB Sept. 30,

2020) (challenging claims of U.S. Patent No. 10,709,366 B1).

Paper 4, 2–3.

Patent Owner also identifies the following pending patent applications that claim priority to, or share a priority claim with, the '695 patent:

U.S. Patent Application No. 15/195,199;

U.S. Patent Application No. 16/532,061;

U.S. Patent Application No. 16/532,065;

U.S. Patent Application No. 16/791,955;

U.S. Patent Application No. 16/791,963;

U.S. Patent Application No. 16/835,712;

U.S. Patent Application No. 16/835,772;

U.S. Patent Application No. 16/791,955; and

U.S. Patent Application No. 16/871,874.

Id. at 1–2.

C. The '695 Patent

The '695 patent is titled "Advanced Pulse Oximetry Sensor," and issued on November 12, 2019, from U.S. Patent Application No. 16/226,249, filed December 19, 2018. Ex. 1001, codes (21), (22), (45), (54). The '695 patent summarizes its disclosure as follows:

This disclosure describes embodiments of non-invasive methods, devices, and systems for measuring blood constituents,



analytes, and/or substances such as, by way of non-limiting example, oxygen, carboxyhemoglobin, methemoglobin, total hemoglobin, glucose, proteins, lipids, a percentage therefor (e.g., saturation, pulse rate, perfusion index, oxygen content, total hemoglobin, Oxygen Reserve IndexTM (ORITM) or for measuring many other physiologically relevant patient characteristics. These characteristics can relate to, for example, pulse rate, hydration, trending information and analysis, and the like.

Id. at 2:36-46.

Figures 7A and 7B of the '695 patent are reproduced below:

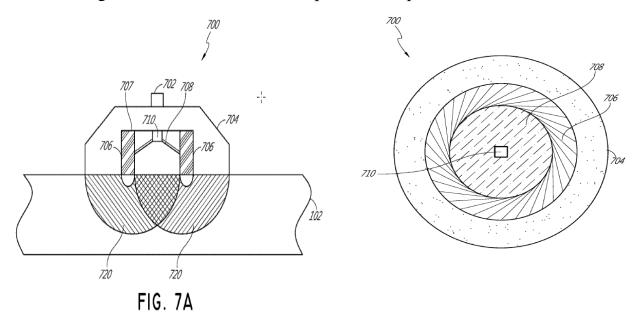


FIG. 7B

Figures 7A and 7B above depict side and top views, respectively, of a three-dimensional pulse oximetry sensor according to an embodiment of the '695 patent. *Id.* at 5:28–33. Sensor 700 includes emitter 702, light diffuser 704, light block (or blocker) 706, light concentrator 708, and detector 710. *Id.* at 10:49–51. The sensor functions to irradiate tissue measurement site 102, e.g., a patient's wrist, and detects emitted light that is reflected by the tissue



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

