

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Al-Ali
U.S. Patent No.: 10,470,695 Attorney Docket No.: 50095-0004IP1
Issue Date: November 12, 2019
Appl. Serial No.: 16/226,249
Filing Date: December 19, 2018
Title: ADVANCED PULSE OXIMETRY SENSOR

Mail Stop Patent Board

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 10,470,695

Apple is filing two petitions (IPR2020-01722 and IPR2020-01723) challenging U.S. Patent No. 10,470,695 (the “’695 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(s)
1	IPR2020-01722	Sarantos, Ackermans
2	IPR2020-01723	Mendelson ’799

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

The need for two Petitions in the present case is driven by the large number of claims (30) in the ’695 Patent. 30 claims is a larger than normal number of claims in a U.S. patent, as evidenced by the Patent Office charging additional fees to examine patent applications with more than 20 claims, and the PTAB charging additional fees to consider challenges of patents with more than 20 claims. *See*

USPTO Fee Schedule (Last Revised on September 1, 2020), available at <https://www.uspto.gov/learning-and-resources/fees-and-payment/uspto-fee-schedule>.

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 '695 Patent, they do so in different ways, using different description.

IPR2020-01722 relies on Sarantos and Ackermans as their primary reference. Sarantos describes a “wristband-type wearable fitness monitor” that measures “physiological parameters” of the wearer, such as the person’s “heart rate” and “blood oxygenation levels.” APPLE-1014, 2:5-14, 5:55-59, 7:12-14, 13:39-47. Ackermans describes an optical sensor specifically for measuring the blood oxygenation levels of a user. APPLE-1016, Abstract, 1, 2-5.

These distinct primary references, in combination with various secondary references, apply differently to the claims of the '695 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: October 2, 2020

/W. Karl Renner/
W. Karl Renner, Reg. No. 41,265
Dan Smith, Reg. No. 71,278
Fish & Richardson P.C.
3200 RBC Plaza, 60 South Sixth Street
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on October 2, 2020, a complete and entire copy of this Notice Ranking Petitions was provided via Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

KNOBBE, MARTENS, OLSON & BEAR, LLP
MASIMO CORPORATION (MASIMO)
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

/Diana Bradley/

Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(858) 678-5667