

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Poeze et al.
U.S. Patent No.: 10,912,502 Attorney Docket No. 50095-0043IP2
Issue Date: February 9, 2021
Appl. Serial No.: 17/031,407
Filing Date: September 24, 2020
Title: USER-WORN DEVICE FOR NONINVASIVELY MEASURING
A PHYSIOLOGICAL PARAMETER OF A USER

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**PETITIONER'S NOTICE RANKING PETITIONS FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 10,912,502**

Apple is filing two petitions (IPR2022-01273 and IPR2022-01274) challenging U.S. Patent No. 10,912,502 (the “502 Patent”). This paper provides “(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits,...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....” Trial Practice Guide, 59-61.

I. Ranking of Petitions

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

Rank	Petition	Primary Reference
1	IPR2022-01274	Lumidigm
2	IPR2022-01273	Mendelson-799

II. Factors Supporting Institution, Including Material Differences

Material differences exist between the petitions, which are non-redundant at least in their reliance on different combinations of references that demonstrate the obviousness of the Challenged Claims in materially different ways.

For example, IPR2022-01274 relies on Lumidigm as its primary reference, and asserts grounds presenting Lumidigm in combinations with each of Scharf, Kotanagi, and Tran. Lumidigm describes “electro-optical sensors for use in biometric analysis of optical spectra of tissue” that are “built into the case of a wristwatch 112 and operate[] based upon signals detected from the skin in the area

of the wrist.” Lumidigm, 11:61-64, Fig. 8B. Lumidigm’s wristwatch obtains data indicative of spectroscopic characteristics of a patient’s blood or skin, which are used to determine physiological parameters. *See id.*, 3:44-45, 19:16-40.

In contrast, IPR2022-01273 relies on Mendelson-799, and asserts grounds presenting Mendelson-799 in combinations with each of Aizawa, Ohsaki, Goldsmith, Scharf, Dalke, and Kotanagi. Mendelson-799 describes a pulse oximeter featuring a sensor housing 17 that accommodates “closely spaced light emitting elements” and an array of twelve “discrete detectors (e.g., photodiodes).” Mendelson-799, Abstract, 9:22-40, 10:16-37, FIGS. 7, 8.

These distinct primary references, in combination with various secondary references, apply differently to the claims of the ’502 Patent. Additionally, motivation to combine the distinct sets of references presented in the two petitions materially differs. The petitions are not redundant, duplicative, or substantially similar. Rather, each petition compellingly demonstrates the unpatentability of the Challenged Claims, without repeating the same theory.

Furthermore, Masimo sought through collateral prosecution new claims issued in the ’502 patent amidst its campaign against Apple involving serial assertion of, thus far, several hundred claims across twenty-two patents in district court and ITC proceedings. Despite IPR proceedings, and regardless of findings that may occur in the co-pending ITC proceeding in which the ’502 patent is

presently asserted, it is entirely conceivable that Masimo will extend its campaign of harassing serial litigation into the future through further district court actions.

Indeed, although Apple has every expectation that it will succeed in demonstrating the invalidity of the single '502 patent claim presently asserted at the ITC based on grounds involving Lumidigm, that outcome would not preclude Masimo from asserting the same claim (or any other claim of the '502 patent) in a future district court action. APPLE-1032, 6 (“an ITC determination cannot conclusively resolve an assertion of patent invalidity, which instead requires either district court litigation or a PTAB proceeding to obtain patent cancellation”). Given the uncertainty of which claims might ultimately be asserted in future district court actions, the first-ranked IPR2022-01274 petition challenges all thirty '501 claims on Lumidigm-based grounds, not just the single claim asserted in the ITC. Petitioner strongly desires substantive review of this petition by the Board, so as to conclusively resolve invalidity over the included grounds.

Moreover, the majority of the references applied in the second-ranked IPR2022-01273 petition are highly familiar to the Board and to Masimo, in view of the Board's invalidation of nearly all claims challenged across thirteen related patents, based on grounds involving various combinations of Mendelson-799, Aizawa, Ohsaki, and Goldsmith. *E.g.*, *Apple Inc. v. Masimo Corp.*, IPR2020-01538 Pap. 43, 2, 9 (PTAB Feb. 23, 2022)(finding “claims 1–7 and 20–28 of the

'554 patent...unpatentable” based on a ground including Mendelson-799 and Ohsaki); *Apple Inc. v. Masimo Corp.*, IPR2020-01538 Pap. 31, 2, 9-10 (PTAB May 2, 2022)(finding “claims 1–30 of the '564 patent...unpatentable” based on grounds including Aizawa, Ohsaki, and Goldsmith).

Indeed, given both the strong similarities between the '502 Patent claims and claims previously invalidated in IPR, and the triviality of features introduced by Masimo in the '502 Patent (e.g., “a protrusion comprising: a convex surface...a plurality of openings...extending through the protrusion and aligned with...four photodiodes...and a plurality of windows”), consideration of the IPR2022-01273 petition would present no undue burden to the Board or Masimo.

Due to word count constraints, two petitions were needed to address both Lumidigm-based and Mendelson-799-based grounds. Given the context of uncertainty created through Masimo’s serial litigation campaign, Apple respectfully submits that institution of both petitions is more than justified. Indeed, the Board’s institution of IPRs based on both petitions, which compellingly demonstrate invalidity of the Challenged Claims based on materially different grounds, would serve to efficiently address issues of invalidity for all parties, including Masimo.

For at least these reasons, Petitioner respectfully requests that the Board institute trial on both petitions.

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