

Filed: November 4, 2022

Filed on behalf of:

Patent Owner Masimo Corporation
By: Brian C. Claassen (Reg. No. 63,051)
Carol Pitzel Cruz (Reg. No. 61,224)
Jarom D. Kesler (Reg. No. 57,046)
Jacob L. Peterson (Reg. No. 65,096)
Daniel Kiang (Reg. No. 79,631)

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: AppleIPR745-1@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2022-01292
U.S. Patent 10,687,745

**PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICES
RANKING PETITION**

Patent Owner (“Masimo”) and Petitioner (“Apple”) already litigated the validity of U.S. Patent No. 10,687,745 (the “’745 Patent”) through an evidentiary hearing in ITC Investigation No. 337-TA-1276 (the “Investigation”). After that hearing concluded, and after Apple represented to the ITC that it was presenting its best evidence, Apple filed four petitions challenging the ’745 Patent: IPR2022-01291, 1292, 1465, and 1466. Apple staggered the petitions, filing the 1291 and 1292 Petitions on July 22, 2022, and then filing the 1465 and 1466 Petitions on August 26, 2022.

A. Apple Failed to Properly Rank Its Petitions

Apple filed four petitions against the ’745 Patent, separating its arguments across them. Where “a petitioner files two or more petitions *challenging the same patent*, then the petitioner should ... identify ... a ranking of the petitions in the order in which it wishes the Board to consider the merits.” Consolidated Trial Practice Guide (Nov. 2019) (“TPG”), 59-60. But Apple did not rank all four petitions. Instead, Apple ranks the petitions in two groups of two:

Rank	Petition	Primary References
1	IPR2022-01292	Iwamiya, Sarantos
2	IPR2022-01291	Ackermans, Mendelson-799
Rank	Petition	Primary References
1	IPR2022-01465	Iwamiya, Sarantos
2	IPR2022-01466	Ackermans

See 1291 Notice; 1465 Notice. Confusingly, Apple’s listing of primary references for the 1291 Petition actually lists the primary references for the 1292 Petition, and

vice versa. So, it is unclear which petition Apple meant to rank first between those two.

Apple attempts to excuse its failure to rank all four petitions by stating that they challenge “a different subset of claims.” 1465 Notice, 2 n.1. The Board has denied institution based on similar arguments. *See Fantasia Trading LLC v. CogniPower, LLC*, IPR2021-00068, Paper 22 at 6-13 (PTAB May 12, 2021).

In the later filed petitions, Apple explains it “strongly desires substantive review of the first-ranked IPR2022-01465 petition.” 1465 Notice, 4. That notice also describes the interrelationship between all four petitions. *Id.* 2 n.1. Thus, from that notice, Apple appears to rank the 1465 Petition above all the others.

B. Apple Fails to Establish the Necessity for Four Petitions

Notably, Apple could have asserted at least one ground against each challenged claim in a single petition. Apple provides no excuse for needlessly multiplying the burden on the Board and Masimo by filing four petitions.

Apple segregated its petitions both by claim and references. Its first two petitions, 1291 and 1292, challenged the three claims asserted in the Investigation (9, 18, and 27) and their corresponding independent claims (1, 15, and 20). In the 1465 and 1466 Petitions, Apple challenges *only* dependent claims not asserted in the Investigation. Apple also used the same references across these petitions—the

1291 and the 1465 Petitions present substantially identical arguments based on the same combinations of art. The same is also true of the 1292 and 1466 Petitions.

Apple ignores the Board's guidance that it is "unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate." TPG, 59. Multiple petitions may be appropriate: "when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references." *Id.* Neither situation is present here.

First, in the Investigation, Masimo asserted only three claims of the '745 Patent: Claims 9, 18, and 27. EX2011, 185. Moreover, the evidentiary hearing finished before Apple filed these Petitions. Masimo has not asserted the '745 Patent in any other litigation. Second, Apple also does not identify any dispute about the '745 Patent priority date necessitating an additional petition.

The TPG also directs petitioners to explain "the differences between the petitions" and why those differences are material. TPG, 60. Apple failed to identify, much less explain, any material differences amongst all four petitions. Instead, Apple described the primary references (Iwamiya, Sarantos, Ackermans, and Mendelson-799) at a high level without identifying any material differences between them. *See* Paper 2, 2-3. Thus, Apple failed to establish any need for four petitions.

C. The Petitions Are Needlessly Duplicative

Apple fails to show that “it was necessary to distribute its challenges across four petitions in order to present one ground of unpatentability for each challenged claim.” *Fantasia Trading*, IPR2021-00068, Paper 22 at 6-13. The 1465 and 1466 Petitions regurgitate the *same* invalidity arguments that Apple presented in the 1291 and 1292 Petitions for independent Claims 1, 15, and 20. *Compare* 1465 Petition at 7-18, 25-32, 39-44, 53-55, 59-62 *with* 1291 Petition at 8-19, 21-28, 30-43; *compare* 1466 Petition at 12-23, 30-38, 45-47 *with* 1292 Petition at 12-31, 35-37.

Apple’s duplication reveals that Apple could have addressed every challenged claim in a single petition. Apple filed the 1291 and 1465 Petitions based on substantially the same art. The only claims not addressed in the 1465 Petition are Claims 9, 18, and 27. Apple addressed Claim 9 in the 1291 Petition in roughly one page (at 19-20), Claim 18 in a one-line cross-reference to Claim 9 (at 27), and Claim 27 with the same argument Apple presented in the 1465 Petition for Claim 2 (*compare* 1291 Pet. at 29 *with* 1465 Pet. at 18). Thus, Apple could have addressed all challenged claims in a single petition with little effort, which would have resulted in a substantially simplified proceeding. Similar reasoning applies to the other segregated grounds and petitions.

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.