

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent of: Al-Ali et al.  
U.S. Patent No.: 7,761,127 Attorney Docket No.: 50095-0046IP1  
Issue Date: July 20, 2010  
Appl. Serial No.: 11/366,209  
Filing Date: March 1, 2006  
Title: MULTIPLE WAVELENGTH SENSOR SUBSTRATE

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**PETITIONER'S NOTICE RANKING PETITIONS FOR  
INTER PARTES REVIEW OF U.S. PATENT NO. 7,761,127**

Apple is filing two petitions (IPR2022-01299 and IPR2022-01300) challenging U.S. Patent No. 10,761,127 (the “127 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:

<b>Rank</b>	<b>Petition</b>	<b>Primary Reference</b>
<b>1</b>	IPR2022-01299	Yamada
<b>2</b>	IPR2022-01300	Dietiker

### **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, IPR2022-01299 relies on Yamada as a primary reference, and asserts grounds presenting Yamada in combinations with each of Chadwick, Leibowitz, Cheung, and Noguchi. Yamada describes an optical sensor that “detects light (reflected light) that has been directed toward the surface of the

human body, scattered inside the human body, and returned toward the exposed surface.” APPLE-1004, [0001]-[0002].

In contrast, IPR2022-01300 relies on Dietiker as a primary reference, and asserts grounds presenting Dietiker in combinations with each of Oldham, Leibowitz, Noguchi, and Yamada. Dietiker describes “a blood constituent monitoring system and/or a non-invasive oximeter that may be utilized to monitor arterial oxygen saturation.” APPLE-1009, [0005], [0033].

These distinct primary references, in combination with various secondary references, apply differently to the claims of the ’127 Patent. For example, among other things, the Yamada combinations describe temperature sensing for purposes such as monitoring overheating conditions and compensating for temperature fluctuations of LEDs, while the Dietiker combinations describe active temperature regulation for LEDs in an oximetry instrument. *Compare* APPLE-1004, [0109]-[0111], *with* APPLE-1010, [0024]-[0025]. Additionally, motivations to combine the distinct sets of references presented in the two petitions materially differ. 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 asserted the ’127 patent in the context of a larger litigation campaign against Apple involving serial assertion of, thus far, several

hundred claims across twenty-two patents in district court and ITC proceedings. More specifically, the '127 patent is one of five patents<sup>1</sup> presently asserted by Masimo against Apple in an ITC action initiated on June 29, 2021. Notably, Masimo filed the applications from which three of the ITC-asserted patents issued *after* filing a January 9, 2020 complaint asserting seventeen other patents against Apple in the U.S. District Court for the Central District of California (CDCA) (Case No. 8:20-cv-00048), and *after* Apple began filing IPRs challenging the CDCA-asserted patents. The CDCA litigation was stayed pending resolution of the IPRs,<sup>2</sup> which yielded invalidation of every asserted claim in fifteen of the seventeen CDCA-asserted patents.

Despite IPR proceedings, and regardless of findings that may occur in the co-pending ITC proceeding in which the '127 patent is presently asserted, it is

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<sup>1</sup> Masimo presently asserts U.S. Patent Nos. 7,761,127, 10,687,745, 10,912,501, 10,912,502, and 10,945,648 at the ITC.

<sup>2</sup> IPR2020-01520, IPR2020-01521, IPR2020-01722, IPR2020-01523, IPR2020-01524, IPR2020-01526, IPR2020-01536, IPR2020-01537, IPR2020-01538, IPR2020-01539, IPR2020-01713, IPR2020-01714, IPR2020-01715, IPR2020-01716, IPR2020-01722, IPR2020-01723, IPR2020-01737, IPR2020-01737, IPR2021-00195, IPR2021-00208, IPR2021-00209.

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 invalidity of the single '127 Patent claim presently asserted at the ITC, that outcome would not preclude Masimo from asserting the same claim (or any other claim of the '127 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 instant petitions challenge all thirty '127 claims, not just the single claim asserted in the ITC.

Due to word count constraints, two petitions were needed to address Apple’s arguments. Thus, the need for two petitions is driven by uncertainty regarding which claims might ultimately be asserted should Masimo continue its campaign of serial litigation. And yet, 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. Indeed, the Board’s institution of both petitions and subsequent resolution of the validity issues presented therein has the potential to play a significant role in bringing litigation between the parties to a close,

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