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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

Case IPR2022-01300
U.S. Patent 7,761,127

RESPONSE TO PETITIONER'S RANKING OF PETITIONS

Patent Owner ("Masimo") and Petitioner ("Apple") already litigated the validity of U.S. Patent No. 7,761,127 (the "'127 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 two petitions challenging the '127 Patent: IPR2022-01299 and IPR2022-01300.

In each IPR, Masimo is concurrently filing a POPR explaining why the Board should deny institution. For the reasons in its POPRs, Masimo submits that the Board should deny institution of both IPRs. In the alternative, if the Board exercises its discretion to institute either IPR, it should institute just one of them.

The Trial Practice Guide states: "Based on the Board's experience, one petition should be sufficient to challenge the claims of a patent in most situations. … In addition, multiple petitions by a petitioner are not necessary in the vast majority of cases." Trial Practice Guide, 59. While "the Board recognizes that there may be circumstances in which more than one petition may be necessary" (*id.*), this case presents none of those circumstances.

Masimo has not "asserted a large number of claims in litigation" of the '127 patent. *See id.* Indeed, Apple acknowledges that Masimo has asserted "just [a] single claim in the ITC." Notice, 5. Moreover, the evidentiary hearing finished before Apple filed these Petitions. Masimo has not asserted the '127 Patent in any

other litigation. Apple speculates that Masimo ***might*** assert more '127 patent claims in "***future*** district court actions." *Id.* (emphasis added). Such speculation does not justify two petitions. Further, Apple has not raised any "dispute about priority date[s] requiring arguments under multiple prior art references." *See* Trial Practice Guide, 59.

The Trial Practice Guide also directs petitioners to explain "the differences between the petitions" and why those differences are material. *Id.*, 60. Apple failed to identify, much less explain, any material differences between the two petitions. Instead, Apple described the primary references (Yamada and Dietiker) at a high level. *See* Notice, 2-3. Thus, Apple failed to establish any need for two petitions.

Apple admits the real reason it "needed" to file two petitions was to get around "word count constraints." Notice, 5. Evading word counts is not a valid reason to file multiple petitions. Further, Apple cannot credibly claim two IPR petitions "were needed to address Apple's arguments." Notice, 5. Apple already presented essentially the same Yamada grounds in the ITC as it now presents in IPR2022-01299. EX1012, 239-243 (asserting obviousness in view of Yamada, Noguchi, and Scarlett). Apple relied on Scarlett as allegedly disclosing a "thermal core," that allegedly could be combined with Yamada's circuit board. *Id.*, 240. In IPR2022-01299, Apple relies on essentially the same combination, but with

Chadwick allegedly disclosing the "thermal core." IPR2022-01299 Pet., 15. Giving Apple a second bite at its Yamada grounds does not justify the Board expending additional resources to institute two IPRs.

Accordingly, Apple's Notice fails to justify institution of two IPRs against the '127 patent.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 4, 2022

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CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **RESPONSE TO PETITIONER'S RANKING OF PETITIONS** is being served electronically on November 4, 2022, to the e-mail addresses shown below:

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