

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01722
Patent 10,470,695 B2

Before JOSIAH C. COCKS, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. Background

Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–6, 8, 9, 11–19, and 21–30 of U.S. Patent No. 10,470,695 B2 (Ex. 1001, “the ’695 patent”). Paper 2 (“Pet.”). We instituted the petitioned review. Paper 8 (“Institution Decision” or “Inst. Dec.”).

Masimo Corporation (“Patent Owner”) filed a Patent Owner Response (Paper 13, “PO Resp.”) to oppose the Petition. Petitioner filed a Reply (Paper 18, “Pet. Reply”) to the Patent Owner Response. Patent Owner filed a Sur-reply (Paper 19, “PO Sur-reply”) to the Reply. We conducted an oral hearing on February 9, 2022. A transcript has been entered in the record (Paper 28, “Tr.”).¹

We have jurisdiction under 35 U.S.C. § 6(b)(4) and § 318(a). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 6, 14, and 21 of the ’695 patent. We determine Petitioner has shown by a preponderance of the evidence that those claims are unpatentable.

¹ In the Patent Owner Response, Patent Owner indicates that claims 1–5, 8, 9, 11–13, 15–19, and 22–30 “have been statutorily disclaimed under 35 U.S.C. § 253(a),” and are “no longer at issue in this proceeding.” PO Resp. 15 (citing Ex. 2004). At oral argument, Patent Owner again acknowledged that claims 1–5, 8, 9, 11–13, 15–19, and 22–30 have been disclaimed. Tr. 13. In its Reply, Petitioner also notes that those claims have been disclaimed “leaving claims 6, 14, and 21 as the only remaining challenged claims.” Pet. Reply 1 n.1 (citing Ex. 2004). Exhibit 2004 is titled “Disclaimer in Patent Under 37 CFR 1.321(a)” and indicates that claims 1–5, 8, 9, 11–13, 15–19, and 22–30 have been disclaimed. Ex. 2004, 1. Accordingly, we regard claims 6, 14, and 21 as the only remaining challenged claims in this proceeding.

B. Related Matters

Patent Owner identifies the following matters related to the '695 patent:

Masimo Corporation v. Apple Inc., Civil Action No. 8:20-cv-00048 (C.D. Cal.) (filed Jan. 9, 2020);

Apple Inc. v. Masimo Corporation, IPR2020-01520 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,258,265 B1);

Apple Inc. v. Masimo Corporation, IPR2020-01521 (PTAB Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,292,628 B1);

Apple Inc. v. Masimo Corporation, IPR2020-01523 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 8,457,703 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01524 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,433,776 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01526 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 6,771,994 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01536 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,588,553 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01537 (PTAB Aug. 31, 2020) (challenging claims of U.S. Patent No. 10,588,553 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01538 (PTAB Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,588,554 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01539 (PTAB Sept. 2, 2020) (challenging claims of U.S. Patent No. 10,588,554 B2);

Apple Inc. v. Masimo Corporation, IPR2020-01713 (PTAB Sept. 30, 2020) (challenging claims of U.S. Patent No. 10,624,564 B1);

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Apple Inc. v. Masimo Corporation, IPR2020-01714 (PTAB Sept. 30, 2020) (challenging claims of U.S. Patent No. 10,631,765 B1 patent);

Apple Inc. v. Masimo Corporation, IPR2020-01715 (PTAB Sept. 30, 2020) (challenging claims of U.S. Patent No. 10,631,765 B1 patent);

Apple Inc. v. Masimo Corporation, IPR2020-01716 (PTAB Sept. 30, 2020) (challenging claims of U.S. Patent No. 10,702,194 patent);

Apple Inc. v. Masimo Corporation, IPR2020-01723 (PTAB Oct. 2, 2020) (challenging claims of U.S. Patent No. 10,470,695 B2);²

Apple Inc. v. Masimo Corporation, IPR2020-01733 (PTAB Sept. 30, 2020) (challenging claims of U.S. Patent No. 10,702,195 B1); and

Apple Inc. v. Masimo Corporation, IPR2020-01737 (PTAB Sept. 30, 2020) (challenging claims of U.S. Patent No. 10,709,366 B1).

Paper 4, 2–3.

Patent Owner also identifies the following pending patent applications that claim priority to, or share a priority claim with, the '695 patent:

U.S. Patent Application No. 15/195,199;

U.S. Patent Application No. 16/532,061;

U.S. Patent Application No. 16/532,065;

U.S. Patent Application No. 16/791,955;

U.S. Patent Application No. 16/791,963;

U.S. Patent Application No. 16/835,712;

² Pursuant to the Board's November 2019, Consolidated Trial Practice Guide, available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>, Petitioner filed a Notice ranking its two petitions that challenge the '695 patent, ranking first the instant proceeding and ranking second IPR2020-01723. Paper 3, 2. We exercised our discretion to deny institution of *inter partes* review in IPR2020-01723. See IPR2020-01723, Paper 8.

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U.S. Patent Application No. 16/835,772; and

U.S. Patent Application No. 16/871,874.

Id. at 1–2.

C. The '695 Patent

The '695 patent is titled “Advanced Pulse Oximetry Sensor,” and issued on November 12, 2019, from U.S. Patent Application No. 16/226,249, filed December 19, 2018. Ex. 1001, codes (21), (22), (45), (54). The '695 patent summarizes its disclosure as follows:

This disclosure describes embodiments of non-invasive methods, devices, and systems for measuring blood constituents, analytes, and/or substances such as, by way of non-limiting example, oxygen, carboxyhemoglobin, methemoglobin, total hemoglobin, glucose, proteins, lipids, a percentage therefor (e.g., saturation), pulse rate, perfusion index, oxygen content, total hemoglobin, Oxygen Reserve IndexTM (ORITM) or for measuring many other physiologically relevant patient characteristics. These characteristics can relate to, for example, pulse rate, hydration, trending information and analysis, and the like.

Id. at 2:36–46.

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