IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Ammar Al-Ali	
U.S. Patent No.:	10,687,745	Attorney Docket No.: 50095-0045IP3
Issue Date:	June 23, 2020	
Appl. Serial No.:	16/835,772	
Filing Date:	March 31, 2020	
Title:	PHYSIOLOGICAL MONITORING DEVICES, SYSTEMS, AND METHODS	

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PETITIONER'S NOTICE RANKING PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,687,745

Apple is concurrently filing two petitions (IPR2022-01465 and IPR2022-01466) challenging U.S. Patent No. 10,687,745 (the "'745 Patent").[1] 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 References
1	IPR2022-01465	Iwamiya, Sarantos
2	IPR2022-01466	Ackermans

[1] Apple also filed petitions in July 2022 (IPR2022-01291 and IPR2022-01292) challenging a different subset of claims of the '745 Patent. The six claims challenged in IPR2022-01291 and IPR2022-01292 included claims presently asserted in co-pending ITC litigation. The subset of claims challenged in the IPR2022-01465 and IPR2022-01466 petitions are not asserted in the ITC.

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, IPR2022-01465 relies on Iwamiya and Sarantos as primary references, and asserts grounds based on Iwamiya in combinations with each of Sarantos and Venkatraman, and Sarantos in combinations with Shie, Savant, and Venkatraman. Iwamiya describes an "optical biological information detecting apparatus" provided in "a central portion of the back cover" of "a wristwatch." APPLE-1004, Abstract, 5:54-66, FIGS. 1, 4. Sarantos describes a "wristband-type wearable fitness monitor" that measures "physiological parameters." APPLE-1005, 2:5-14, 5:55-59, 7:12-14, 13:39-47.

In contrast, IPR2022-01466 relies on Ackermans as the primary reference, and asserts grounds based on Ackermans in combinations with each of Savant, Venkatraman, and Sarantos. Ackermans describes an optical sensor for measuring the blood oxygenation levels of a user. APPLE-1011, Abstract, 1, 2-5.

These distinct primary references, in combination with various secondary references, apply differently to the claims of the '745 Patent. Additionally, the 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 sought through collateral prosecution new claims issued in the '745 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 '745 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 claims presently asserted at the ITC, that outcome would not preclude Masimo from asserting the additional claims challenged in the present petitions (which are not presently asserted at the ITC) 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 whether Masimo might attempt to assert additional claims in future district court actions, Petitioner strongly desires substantive review of the first-ranked IPR2022-01465 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 IPR2022-01466 petition are highly familiar to the Board and to Masimo, in view of the Board's invalidation of all challenged claims of the related '695 patent in IPR2020-01722 based on grounds involving Ackermans. *E.g.*, *Apple Inc. v. Masimo Corp*., IPR2020-01722, Paper 29, 2, 29 (PTAB May 5, 2022) (finding "claims 6, 14, and 21 of the '695 patent …unpatentable" based on a ground including Ackermans).

Indeed, given both the strong similarities between the '745 Patent claims and claims previously invalidated in IPR, and the triviality of features introduced by Masimo in the '745 Patent, consideration of the challenges raised in the IPR2022-01465 petition together with the IPR2022-01466 petition would present no undue burden to the Board or to Masimo.

Due to word count constraints, two petitions were needed to address grounds based on the asserted primary references. 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 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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