

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2021-00193
Patent 10,299,708 B1

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

KINDER, *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 (Paper 2, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–29 (“challenged claims”) of U.S. Patent No. 10,299,708 B1 (Ex. 1001, “the ’708 patent”). We instituted the petitioned review (Paper 7, “Institution Decision” or “Inst. Dec.”).

Masimo Corporation (“Patent Owner”) filed a Patent Owner Response (Paper 14, “PO Resp.”) to oppose the Petition. Petitioner filed a Reply (Paper 16, “Pet. Reply”) to the Patent Owner Response. Patent Owner filed a Sur-reply (Paper 19, “Sur-reply”) to the Reply. We conducted an oral hearing on March 15, 2022. A transcript has been entered into the record (Paper 29, “Tr.”).

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 1–29 of the ’708 patent. We determine Petitioner has shown by a preponderance of the evidence that those claims are unpatentable.

B. Related Matters

The parties identify the following matters related to the ’708 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);

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Apple Inc. v. Masimo Corporation, IPR2020-01523 (PTAB Sept. 9, 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);

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

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

Apple Inc. v. Masimo Corporation, IPR2020-01716 (PTAB Sept. 30, 2020) (challenging claims of U.S. Patent No. 10,702,194 B1);

Apple Inc. v. Masimo Corporation, IPR2020-01722 (PTAB Oct. 2, 2020) (challenging claims of U.S. Patent No. 10,470,695 B2);

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

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

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

Apple Inc. v. Masimo Corporation, IPR2021-00195 (PTAB Nov. 20, 2020) (challenging claims of U.S. Patent No. 10,376,190 B1);

Apple Inc. v. Masimo Corporation, IPR2021-00208 (PTAB Nov. 20, 2020) (challenging claims of U.S. Patent No. 10,258,266 B1); and

Apple Inc. v. Masimo Corporation, IPR2021-00209 (PTAB Nov. 20, 2020) (challenging claims of U.S. Patent No. 10,376,191 B1).

Pet. 97–98; Paper 3, 3–4.

Patent Owner further identifies the following pending patent applications, among other issued and abandoned applications, that claim priority to, or share a priority claim with, the '708 patent:

U.S. Patent Application No. 16/834,538;

U.S. Patent Application No. 17/031,407;

U.S. Patent Application No. 17/031,316;

U.S. Patent Application No. 17/031,356;

U.S. Patent Application No. 16/449,143; and

U.S. Patent Application No. 16/805,605.

Paper 3, 2–3.

C. The '708 Patent

The '708 patent is titled “Multi-Stream Data Collection System for Noninvasive Measurement of Blood Constituents,” and issued on May 28, 2019, from U.S. Patent Application No. 16/261,366, filed Jan. 29, 2019.

Ex. 1001, codes (21), (22), (45), (54). The '708 patent claims priority

through a series of continuation and continuation-in-part applications to Provisional Application Nos. 61/078,228 and 61/078,207, both filed July 3, 2008. *Id.* at codes (60), (63).

The '708 patent discloses a two-part data collection system including a noninvasive sensor that communicates with a patient monitor. *Id.* at 2:31–33. The sensor includes a sensor housing, an optical source, and several photodetectors, and is used to measure a blood constituent or analyte, e.g., oxygen or glucose. *Id.* at 2:22–28, 2:57–58. The patient monitor includes a display and a network interface for communicating with a handheld computing device. *Id.* at 2:38–40.

Figure 1 of the '708 patent is reproduced below.

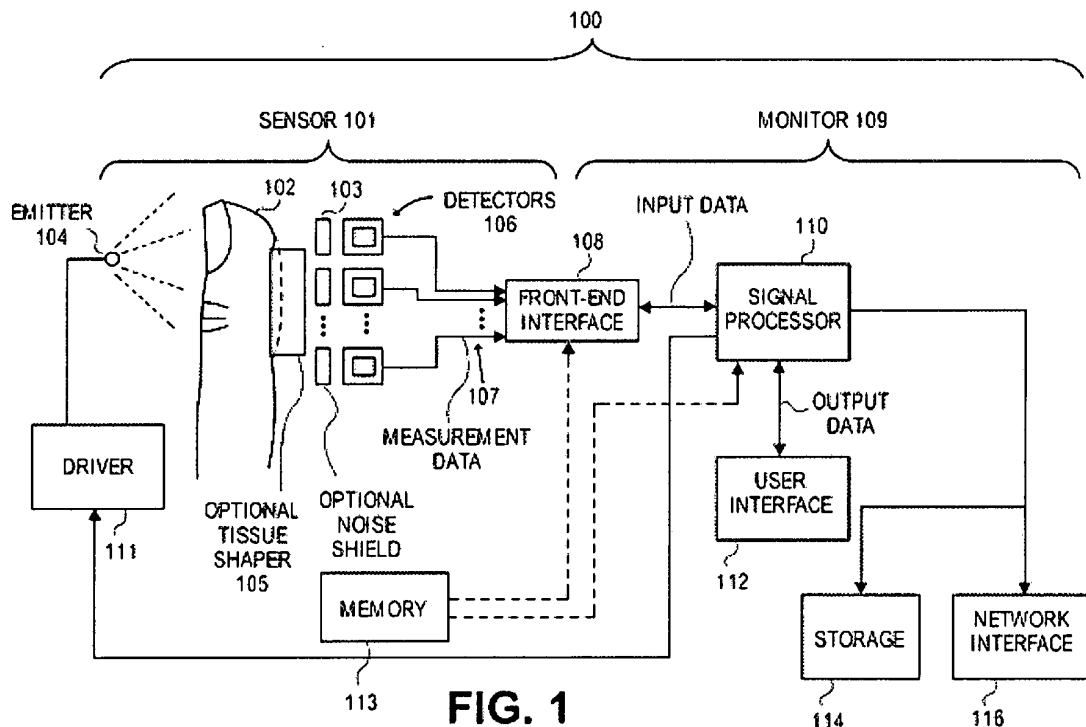


Figure 1 illustrates a block diagram of data collection system 100 including sensor 101 and monitor 109. *Id.* at 11:36–47. Sensor 101 includes optical emitter 104 and detectors 106. *Id.* at 11:48–52. Emitters 104 emit light that

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