

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-00954
Patent 9,788,735 B2

Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and
ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

Sotera Wireless, Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of U.S. Patent No. 9,788,735 B2 (“the ’735 patent,” Ex. 1001). Paper 1 (“Pet.”). The Petition challenges the patentability of claims 1–20 of the ’735 patent. Masimo Corporation (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). Pursuant to our authorization, Petitioner filed a reply to Patent Owner’s Preliminary Response (Paper 11, “Reply”) to address the discretionary factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv* Order”), to which Patent Owner filed a sur-reply (Paper 12, “Sur-reply”).

We have authority to determine whether to institute *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Having considered the arguments and evidence presented by Petitioner and Patent Owner, we determine, for the reasons set forth below, that Petitioner has demonstrated a reasonable likelihood that at least one challenged claim in the petition is unpatentable based on at least one of the grounds presented. As discussed below, we institute an *inter partes* review of all of the challenged claims on all grounds set forth in the Petition.

¹ Petitioner identifies Hon Hai Precision Industry Co., Ltd. as a real parties-in-interest “because Hon Hai agrees to be bound by the estoppel provisions of 35 U.S.C. § 315(e).” Pet. 1.

The following findings of fact and conclusions of law are not final, but are made for the sole purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision shall be based on the full trial record, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in a timely-filed response shall be deemed waived, even if they were presented in the Preliminary Response.

B. Related Proceedings

Petitioner identifies *Masimo Corp. v. Sotera Wireless, Inc.*, Case No. 3:19-cv-01100-BAS-NLS (S.D. Cal.), served on June 13, 2019, as a related proceeding involving the '735 patent. Pet. 2; Ex. 1029; Ex. 1030. Petitioner also identifies IPR2020-00912, involving the same parties and U.S. Patent No. 10,213,108, which is a parent to the '735 patent. Pet. 2.

C. The '735 Patent

The '735 patent is directed to a “Body Worn Mobile Medical Patient Monitor.” Ex. 1001, code (54). The '735 patent claims priority through a series of continuation applications to Provisional Application No. 60/367,428, filed on March 25, 2002. *Id.* at codes (63), (60). The invention relates to “[a] body worn mobile medical monitoring device configured to minimize cable wiring from a sensor by placement of one or more sensor communication ports.” *Id.* at code (57). Structurally, the “device includes a housing securable on a lower arm of a patient, a display, and a sensor communication port positioned on a side of the housing.” *Id.* The body worn medical monitoring device may have other input or output ports that download software or provide a wired connection to other measurement instruments. *Id.* at 5:56–61.

The Specification describes a drawback to “[c]onventional physiological measurement systems,” as requiring a “patient cable connection between sensor and monitor.” *Id.* at 2:22–24. The Specification also describes the problems related with “disconnection of monitoring equipment and a corresponding loss of measurements,” when needing to move patients. *Id.* at 2:25–28. A goal of the ’735 patent was to allow patient mobility by providing wireless communication links between sensors and monitors. *Id.* at 2:28–38; Fig. 3. The invention also sought “to provide a communications adapter that is plug-compatible both with existing sensors and monitors and that implements a wireless link replacement for the patient cable.” *Id.*

As depicted in Figure 4A below, sensor module 400 is plug-compatible with convention sensor 310. *Id.* at 4:58–59. Wrist-mounted module 410 has module connector 414 with auxiliary cable 420 running therefrom to mate with sensor connector 318. *Id.* at Fig. 4A, 5:27–61.

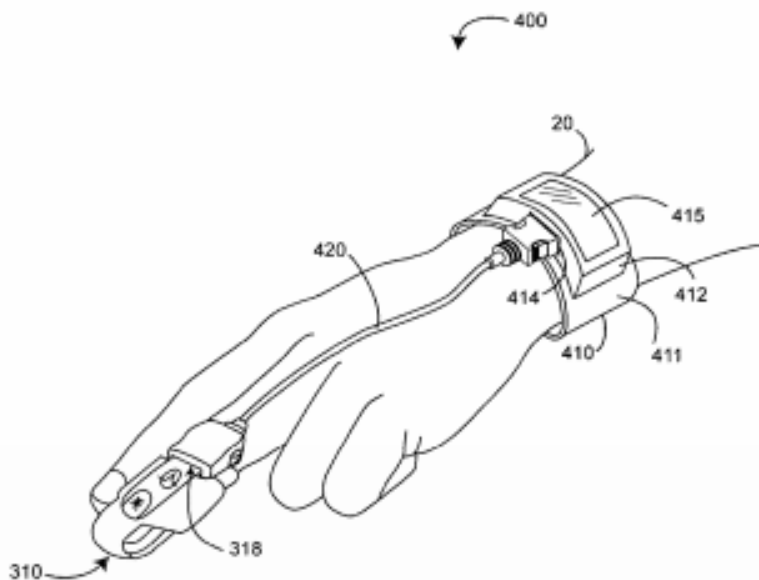


FIG. 4A

Figure 4A illustrates an embodiment of the “communications adapter sensor module.” *Id.* at 4:5–6. Wrist-mounted module 410 may have display 415 that shows sensor measurements, module status, and other visual indicators, such as monitor status. *Id.* at 5:39–42.

The Specification explains that in certain embodiments wrist-mounted module 410 may have other input or output ports that download software, configure the module, or provide a wired connection to other measurement instruments or computing devices. *Id.* at 5:54–61. In such embodiments, the wearable device can communicate with multiple sensors, and a multiple parameter sensor module with sensor interfaces and signal processors may be used as depicted in Figure 13. *Id.* at 11:56–66.

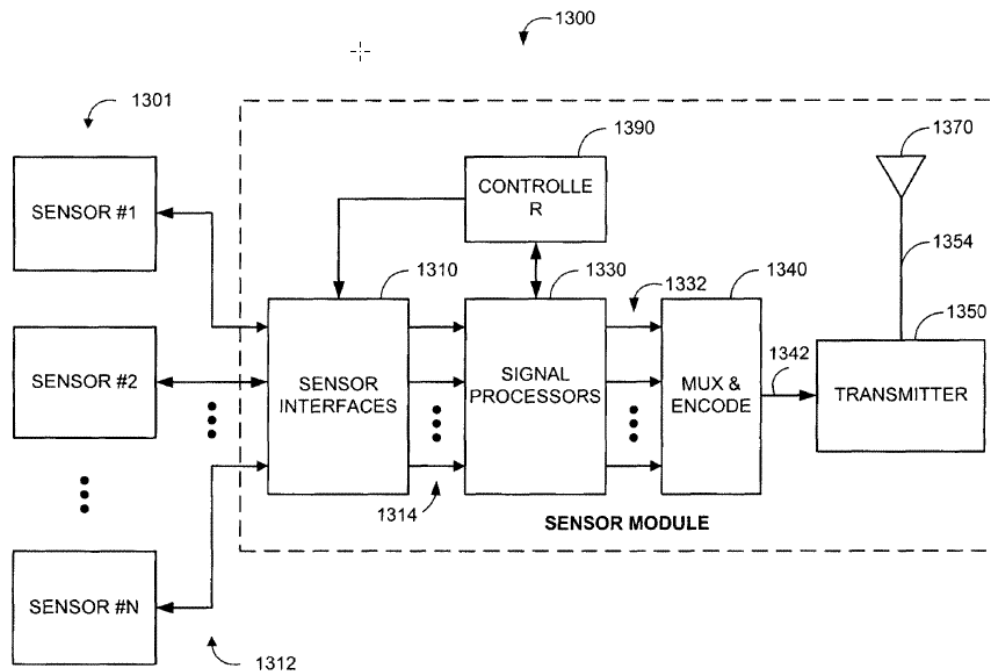


FIG. 13

Figure 13 depicts a functional block diagram of a sensor module configured for multiple sensors. *Id.* at 4:24–25. The Specification also notes that sensor signal conditioning may be performed in the analog domain or digital domain or both. *Id.* at 6:61–65.

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