

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*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Dismissing Petitioner's Motion to Exclude
37 C.F.R. §§ 42.155(c), 42.64

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” or “Masimo”) filed a Preliminary Response to the Petition. Paper 7.

On November 25, 2020, we instituted trial. Paper 13 (“Inst. Dec.” or “Decision to Institute”). Patent Owner filed a Response. Paper 21 (“PO Resp.”). Petitioner filed a Reply. Paper 25 (“Pet. Reply”). Patent Owner filed a Sur-Reply. Paper 30 (“Sur-Reply”). An oral argument was held on August 26, 2021, and a transcript was entered into the record. Paper 40 (“Tr.”).

We have jurisdiction to conduct this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, we determine that Petitioner has shown, by a preponderance of the evidence, that all challenged claims (claims 1–20) of the ’735 patent are unpatentable.

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

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

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 an “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 conventional 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.

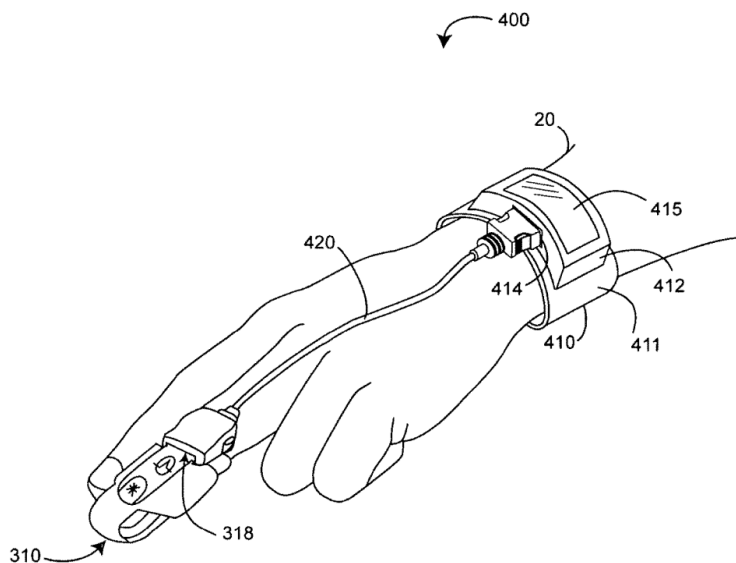


FIG. 4A

Figure 4A illustrates an embodiment of the “communications adapter sensor modules.” *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, below. *Id.* at 11:56–66.

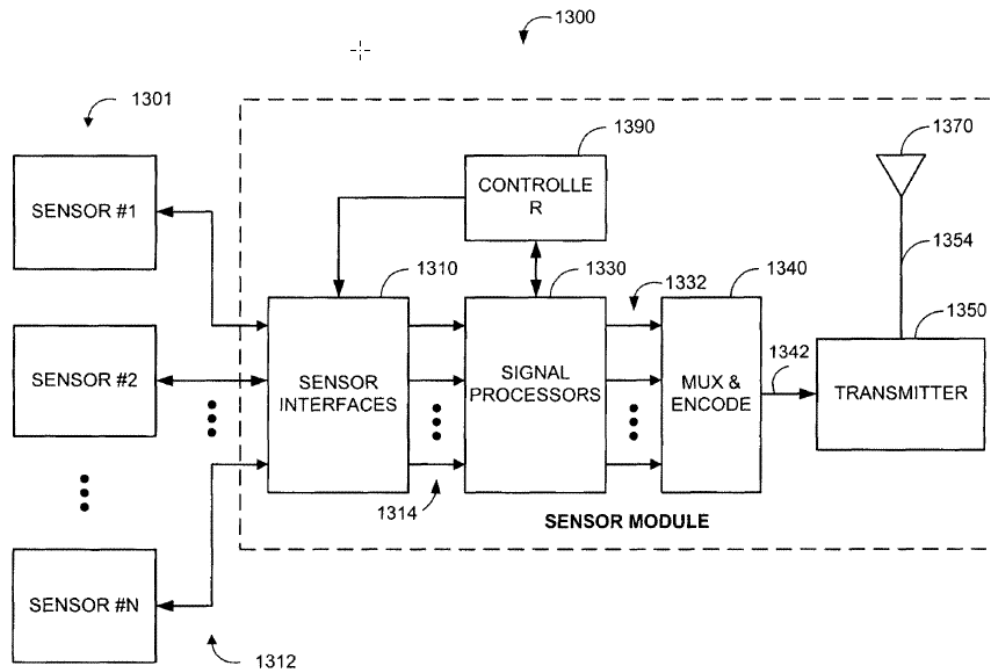


FIG. 13

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.

D. Illustrative Claim

Claim 1, reproduced below in chart form with Petitioner’s added designations to identify each limitation, is illustrative of the claims at issue:

Designation	Claim Language
Claim 1 (Preamble) 1(a)	A body worn mobile medical monitoring device configured to minimize cable wiring from a sensor by placement of one or more sensor communication ports, the mobile medical monitoring device comprising:

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.