

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-00967
Patent RE47,244 E

Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

CHAGNON, *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. § 42.64

I. INTRODUCTION

A. Background

Sotera Wireless, Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of claims 1–26 (“the challenged claims”) of U.S. Patent No. RE47,244 E (Ex. 1001, “the RE244 patent”). Paper 1 (“Pet.”). Masimo Corporation (“Patent Owner”) filed a Preliminary Response. Paper 7. We instituted an *inter partes* review of all challenged claims 1–26 on all grounds of unpatentability, pursuant to 35 U.S.C. § 314. Paper 13 (“Inst. Dec.”).²

After institution, Patent Owner filed a Response (Paper 24, “PO Resp.”) to the Petition, Petitioner filed a Reply (Paper 28, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 32, “PO Sur-reply”). Additionally, Petitioner filed a Motion to Exclude certain deposition testimony (Paper 37, “MTE”), Patent Owner filed an Opposition (Paper 38), and Petitioner filed a Reply (Paper 39). An oral hearing was held on September 8, 2021, and a transcript of the hearing is included in the record. Paper 42 (“Tr.”).

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, Petitioner has met its burden of showing, by a preponderance of the evidence, that challenged claims 1–26 of the RE244 patent are unpatentable.

¹ Petitioner identifies Sotera Wireless, Inc. and Hon Hai Precision Industry Co., Ltd. (“Hon Hai”) as real parties-in-interest to this proceeding. Pet. 1. Petitioner states that Hon Hai is named as a real party-in-interest due to its involvement in a related proceeding. *Id.*

² To address institution considerations under 35 U.S.C. § 314(a), and with our authorization, Petitioner filed a Preliminary Reply (Paper 11) and Patent Owner filed a Preliminary Sur-reply (Paper 12). We do not refer to either paper in this Final Written Decision.

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B. Related Proceedings

The parties identify *Masimo Corp. v. Sotera Wireless, Inc.*, Case No. 3:19-cv-01100-BAS-NLS (S.D. Cal.) as a related matter involving the RE244 patent. Pet. 2; Paper 5, 1.

Patent Owner identifies the following *inter partes* review proceedings, involving patents related to the RE244 patent and which are asserted in the related district court matter:

IPR2020-00912, challenging U.S. Patent No. 10,213,108 B2;
IPR2020-00954, challenging U.S. Patent No. 9,788,735 B2;
IPR2020-01015, challenging U.S. Patent No. 9,795,300 B2;
IPR2020-01019, challenging U.S. Patent No. RE47,353 E;
IPR2020-01033, challenging U.S. Patent No. RE47,249 E;
IPR2020-01054, challenging U.S. Patent No. 9,872,623 B2;
IPR2020-01078, challenging U.S. Patent No. RE47,218 E; and
IPR2020-01082, challenging U.S. Patent No. 10,255,994 (institution denied).
Paper 6, 2.

Patent Owner further identifies various applications that claim priority to, or share a priority claim with, the RE244 patent. *Id.* at 1.

C. The RE244 Patent

The RE244 patent, titled “Alarm Suspend System,” was filed May 1, 2017, and issued on February 19, 2019. Ex. 1001, codes (22), (45), (54).

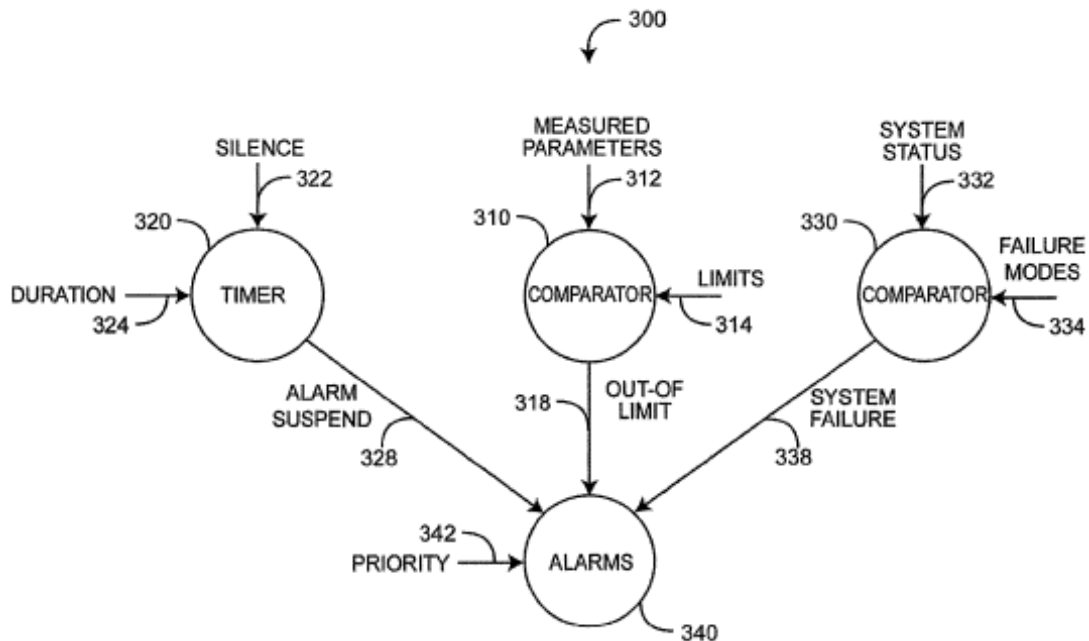
The RE244 patent was filed as a reissue application of U.S. Patent No. 9,153,121. *Id.* at code (64).³

The RE244 patent describes a physiological measurement system that utilizes an alarm suspend system. *Id.* at 4:25–26. The disclosed system includes physiological monitor 101 and noninvasive sensor 105, which measures, e.g., pulse oximetry parameters, carboxyhemoglobin, methemoglobin, and/or total hemoglobin. *Id.* at 4:25–36, Fig. 1. The monitor may include a display, touch keys, and controls including “an alarm silence button [] that is pressed to temporarily suspend out-of-limit parameter alarms and system alarms, such as low battery.” *Id.* at 4:37–48.

The alarm suspend system both prevents unnecessary disturbances to patients and distractions to caregivers. *Id.* at 2:33–36. “Advantageously, an alarm suspend system provides a parameter-dependent variation in the alarm suspend duration, as described below, utilizing a common silence button or other suspend initiator.” *Id.* at 4:60–63. “The alarm suspend period is typically long enough to give a caregiver sufficient time to intervene with appropriate patient treatment yet short enough to ensure that patient health is not endangered if intervention is ineffective.” *Id.* at 2:38–42.

³ The RE244 patent claims earliest priority through a series of continuation applications to Provisional application No. 61/084,615, filed on July 29, 2008. Ex. 1001, codes (60), (63). The specific priority date of the challenged claims is not at issue in this proceeding, and we need not make any determination in this regard for purposes of this Decision.

Figure 3 of the RE244 patent, reproduced below, illustrates a flow diagram of an alarm suspend system. *Id.* at 4:16–17.



As shown in Figure 3, above, “[a]larm triggers include system failures 338 and out-of-limit parameters 318.” *Id.* at 5:43–44. Out-of-limit parameters are identified by comparing measured parameters 312 to default or user-specified limits 314. *Id.* at 5:51–52. Out-of-limit condition 318 triggers alarm 340 that can be suspended 328 by user-initiated silence request 322. *Id.* at 5:52–56. Suspend durations may vary depending on the parameter. *Id.* at 6:23–28. For example, “relatively slow treatment parameters, such as [methemoglobin (‘HbMet’)], [carboxyhemoglobin (‘HbCO’)], [total haemoglobin (‘Hbt’) and [Pleth Variability Index (‘PVi’)], are assigned relatively long suspend durations. Similarly, relatively fast treatment parameters, such as [oxygen saturation (‘SpO₂’)] and [pulse rate (‘PR’)], are assigned relatively short suspend durations.” *Id.* at 6:28–33.

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