

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01015
Patent 9,795,300 B2

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

COCKS, *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 claims 1–20 (“the challenged claims”) of U.S. Patent No. 9,795,300 B2 (“the ’300 patent,” Ex. 1001). Paper 1 (“Pet.”). Masimo Corporation (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”). Pursuant to our authorization (Paper 7), Petitioner filed a reply to Patent Owner’s Preliminary Response (Paper 10, “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 11, “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. 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); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). 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

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.

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.

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

The parties identify *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 '300 patent. Pet. 2; Paper 4, 1. Patent Owner also identifies the following *inter partes* review proceedings involving patents asserted in the parallel proceeding:

IPR2020-00912, challenging U.S. Patent No. 10,213,108;
IPR2020-00954, challenging U.S. Patent No. 9,788,735;
IPR2020-00967, challenging U.S. Patent No. RE47,244;
IPR2020-01019, challenging U.S. Patent No. RE47,353;
IPR2020-01033, challenging U.S. Patent No. RE47,249;
IPR2020-01054, challenging U.S. Patent No. 9,872,623;
IPR2020-01078, challenging U.S. Patent No. RE47,218; and
IPR2020-01082, challenging U.S. Patent No. 10,255,994.

Paper 4, 2.

Patent Owner further identifies various applications that claim priority to, or share a priority claim with, the '300 patent. *Id.* at 1–2.

C. The '300 Patent

The '300 patent is titled “Wearable Portable Patient Monitor.” Ex. 1001, code (54). The '300 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 '300 patent is directed to “[a] wearable portable physiological monitor configured to wirelessly transmit real time information regarding a plurality [of] physiological parameters.” *Id.* at code (57). As is further described in the Abstract:

The portable monitor includes a plurality of sensor ports, where at least a first sensor port is positioned on a side of a housing of the portable monitor such that, when the portable monitor is attached to an arm of a patient, a wired connection extending from the first sensor port to a first physiological sensor positioned on a digit of the patient follows a path to the digit of the patient that avoids tangling of the wired connection. The portable monitor further includes one or more processing devices configured to cause display of parameter values, combine information indicative of the signals into a single word or bit stream, and encode and generate a baseband signal. Further includes a transmitter to modulate the baseband signal and wirelessly transmit.

Id.

The '300 patent additionally expresses that a drawback to “[c]onventional physiological measurement systems,” is the requirement of a “patient cable connection between sensor and monitor.” *Id.* at 2:23–24. And describes the problems related with “disconnection of monitoring equipment and a corresponding loss of measurements,” when needing to

move patients. *Id.* at 2:24–28. A goal of the '300 patent is to allow wireless pulse oximetry monitoring. *Id.* at 2:34–38; *compare* Fig 1², with Fig. 3.

Figure 3 of the '300 patent is reproduced below.

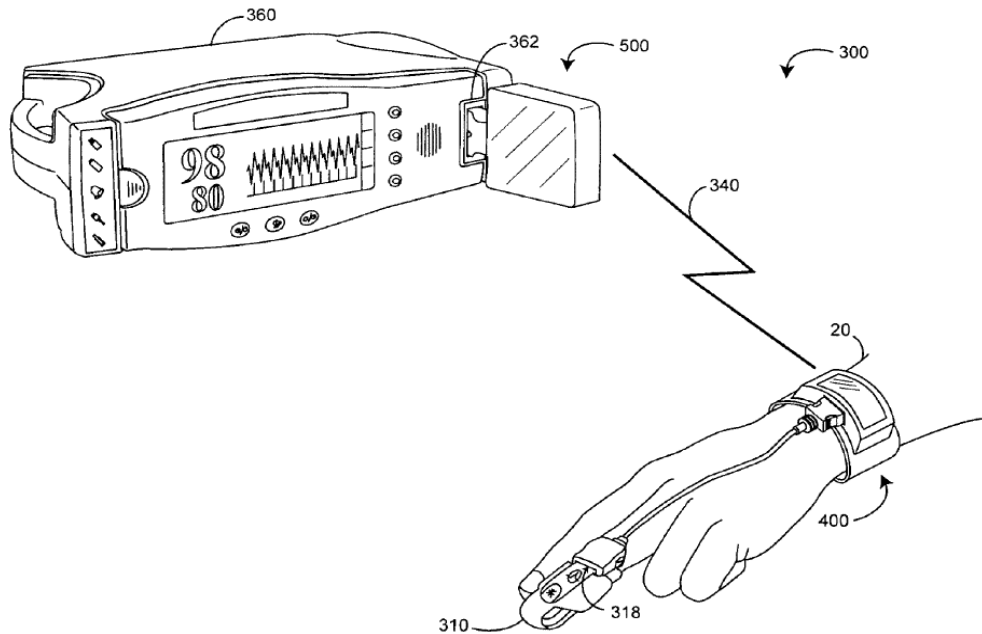


FIG. 3

Figure 3 above illustrates “a physiological measurement communications adapter.” *Id.* at 4:3–4. Communications adapter 300 includes sensor module 400 and monitor module 500. *Id.* at 4:49–50.

² Figure 1 is labeled “Prior Art” and is described as “an illustration of a prior art pulse oximetry system.” *Id.* at 3:66–67.

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