UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

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IPR2020-01015
Patent 9,795,300 B2

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

COCKS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Granting In Part and Dismissing In Part Petitioner's Motion to Correct
Typographical Errors in the Petition
37 C.F.R. § 42.104(c)
Dismissing Petitioner's Motion to Exclude
37 C.F.R. § 42.64

I. INTRODUCTION

A. Background and Summary

Sotera Wireless, Inc. ("Petitioner") 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.").[1] We instituted trial to determine whether the challenged claims were unpatentable as follows:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–20	103	Goldberg,[2] Kiani,[3] Money[4]
1–20	103	Money, Kiani, Akai[5]
1–5, 10–20	103	Goldberg, Kiani, Money, Taylor[6]
1–5, 10–20	103	Money, Kiani, Akai, Taylor
6–9	103	Goldberg, Kiani, Money Taylor, Hylton[7]

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[1] In support of its Petition, Petitioner relies on the Declaration of Dr. George Yanulis (Ex. 1003).

[2] US Patent No. 6,840,904 issued Jan. 11, 2005 ("Goldberg") (Ex. 1005).

[3] PCT Publication No. WO 00/42911, published on July 27, 2000 ("Kiani") (Ex. 1006).

[4] US Patent No. 5,919,141 issued on July 6, 1999 ("Money") (Ex. 1008).

[5] EP0880936A2 published on Dec. 2, 1998 ("Akai") (Ex. 1007).

[6] PCT Publication WO 96/15994, published on May 23, 1996 ("Taylor") (Ex. 1009).

[7] U.S. Patent No. 5,793,413 issued Aug. 11, 1998 ("Hylton") (Ex. 1010).

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
6–9	103	Money, Kiani, Akai, Taylor, Hylton

See Paper 12 ("Inst. Dec.").

Masimo Corporation ("Patent Owner" or "Masimo") timely filed a Patent Owner Response. Paper 23 ("PO Resp.").[8, 9] Petitioner filed a Reply to the Response. Paper 27 ("Pet. Reply").[10] Patent Owner filed a Sur-reply. Paper 32 ("PO Sur-reply"). Petitioner also filed a Motion to Exclude. Paper 36 ("MTE"). Patent Owner filed an Opposition to that Motion to Exclude (Paper 36, "PO Opp. MTE"), to which Petitioner replied (Paper 38, "Pet. Reply MTE"). We held an oral hearing on August 26, 2021.[11] A transcript of the oral argument appears in the record. Paper 42 ("Tr.").

For the reasons set forth below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–20 of the '300 patent are unpatentable. *See* 35 U.S.C. § 316(e).

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[8] Patent Owner provides a "Declaration of Alan L. Oslan In support of Patent Owner's Response" (Ex. 2010).

[9] As was authorized by the panel (Paper 15), and prior to the filing of the Patent Owner Response, Petitioner filed a "Petitioner's Motion to Correct Typographical Errors in the Petition Under 37 C.F.R. § 42.104(c)." Paper 16 ("MTC"). Patent Owner filed an Opposition to that Motion. Paper 17 ("Opp. MTC"). We address Petitioner's Motion to the extent necessary in this Final Written Decision.

[10] In support of the Reply, Petitioner provides a Declaration of Bryan Bergeron, MD. Ex. 1040.

[11] As was requested by both parties (Papers 33, 34), we held a consolidated oral argument that involved each of IPR2020-00912, IPR2020-00954, IPR2020-01015 (this proceeding), and IPR2020-01054.

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 related 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.[12]

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

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[12] With the exception of IPR2020-01082, trial was instituted in all of the noted proceedings.

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 it 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 1[13], *with* Fig. 3.

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[13] 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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