

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01019
Patent RE47,353 E

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

CHAGNON, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

Sotera Wireless, Inc. (“Petitioner”)¹ filed a Petition requesting *inter partes* review of claims 1–25 (“the challenged claims”) of U.S. Patent No. RE47,353 E (Ex. 1001, “the RE353 patent”). Paper 1 (“Pet.”). Masimo Corporation (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We authorized additional briefing for the parties to address the factors laid out in our precedential Order in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv* Order”) regarding the exercise of our discretion under 35 U.S.C. § 314(a). Paper 7. Petitioner filed a Reply (Paper 10) and Patent Owner, in turn, filed a Sur-reply (Paper 11).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314, which provides that an *inter partes* review may be instituted only upon a showing that “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) (2018). After considering the Petition, the Preliminary Response, and the evidence of record, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim challenged in the Petition. Accordingly, we institute an *inter partes* review of all challenged claims of the RE353 patent, based on all grounds identified in the Petition.

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.*

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 may be deemed waived, even if they were presented in the Preliminary Response.

A. Related Proceedings

The parties identify *Masimo Corp. v. Sotera Wireless, Inc.*, Case No. 3:19-cv-01100-BAS-NLS (S.D. Cal.) (the “parallel proceeding”) as a related matter involving the RE353 patent. Pet. 2; Paper 4, 1.

Patent Owner identifies the following *inter partes* proceedings involving patents related to the RE353 patent and asserted in the parallel proceeding:

IPR2020-00912, challenging U.S. Patent No. 10,213,108 B2;
IPR2020-00954, challenging U.S. Patent No. 9,788,735 B2;
IPR2020-00967, challenging U.S. Patent No. RE47,244 E;
IPR2020-01015, challenging U.S. Patent No. 9,795,300 B2;
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 B2.

Paper 4, 2. Patent Owner further identifies various applications that share a priority claim with the RE353 patent.

B. The RE353 Patent

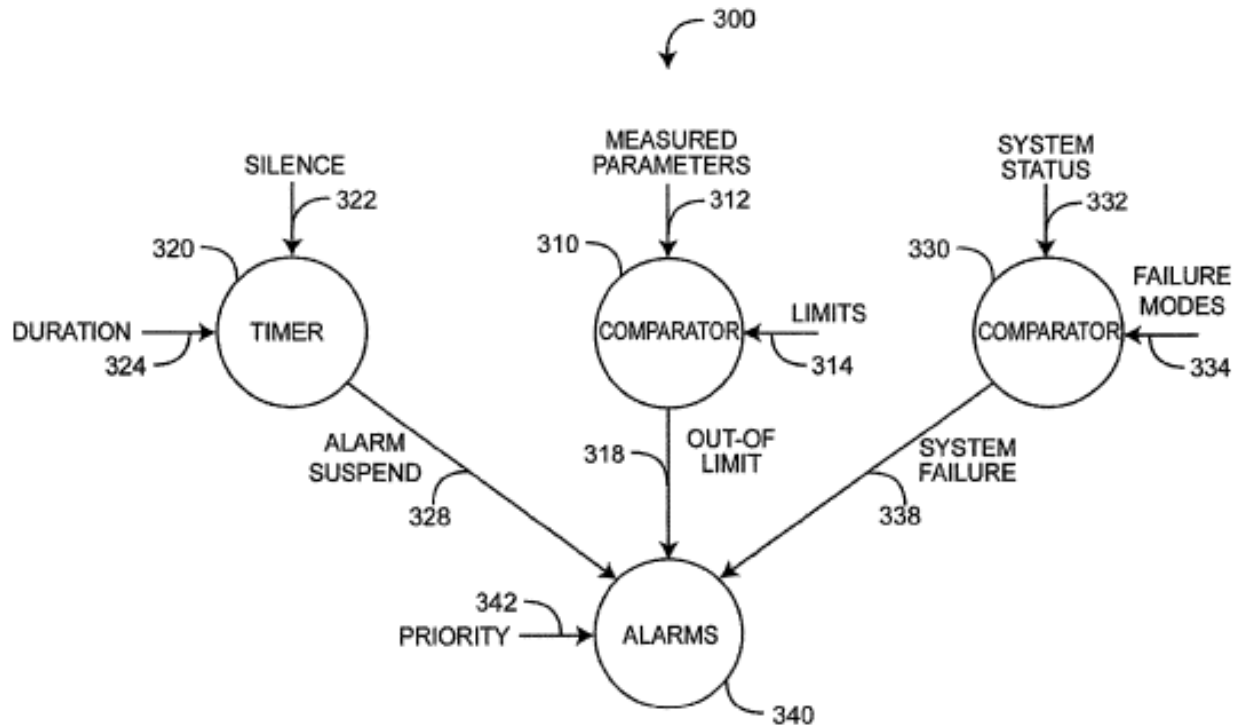
The RE353 patent, titled “Alarm Suspend System,” was filed May 1, 2017, and issued on April 16, 2019. Ex. 1001 codes (22), (45), (54). The RE353 patent was filed as a reissue application of U.S. Patent No. 9,153,121 (“the ’121 patent). *Id.* at code (64).² The RE353 patent describes a physiological measurement system that utilizes an alarm suspend system. *Id.* at 4:25–26. The alarm suspend system prevents unnecessary disturbances to patients and distractions to caregivers. *Id.* at 2:33–36. “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.

The physiological measurement system includes a noninvasive sensor connected to a physiological monitor. *Id.* at 4:25–30. The physiological measurement system incorporates “pulse oximetry in addition to advanced features, such as a multiple wavelength sensor and advanced processes for determining physiological parameters other than or in addition to those of pulse oximetry, such as carboxyhemoglobin, methemoglobin and total hemoglobin, as a few examples.” *Id.* at 4:30–36. The monitor includes controls, such as “an alarm silence button [] that is pressed to temporarily suspend out-of-limit parameter alarms and system alarms, such as low battery.” *Id.* at 4:46–48. “Advantageously, an alarm suspend system

² The RE353 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.

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.

Figure 3 of the RE353 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

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