

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SOTERA WIRELESS, INC.,  
Petitioner,

v.

MASIMO CORPORATION,  
Patent Owner.

---

IPR2020-01033  
Patent RE47,249 E

---

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

WIEKER, *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”)<sup>1</sup> filed a Petition requesting an *inter partes* review of claims 1–24 (“the challenged claims”) of U.S. Patent No. RE47,249 E (Ex. 1001, “the ’249 patent”). Paper 1 (“Pet.”). Masimo Corporation (“Patent Owner”) filed a Preliminary Response. Paper 5. We instituted an *inter partes* review of all challenged claims 1–24 on all grounds of unpatentability, pursuant to 35 U.S.C. § 314. Paper 1 (“Inst. Dec.”).<sup>2</sup>

After institution, Patent Owner filed a Response (Paper 23, “PO Resp.”) to the Petition, Petitioner filed a Reply (Paper 26, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 30, “PO Sur-reply”). Additionally, Petitioner filed a Motion to Exclude certain deposition testimony (Paper 34, “MTE”), Patent Owner filed an Opposition (Paper 35), and Petitioner filed a Reply (Paper 36). An oral hearing was held on September 8, 2021, and a transcript of the hearing is included in the record. Paper 39 (“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 1–24 of the ’249 patent are unpatentable.

---

<sup>1</sup> Petitioner states that Sotera Wireless, Inc. is the real party-in-interest in this petition. Pet. 1. Petitioner also names Hon Hai Precision Industry Co., Ltd. (“Hon Hai”) as a real party-in-interest in this Petition due to Hon Hai’s involvement in a related proceeding. *Id.*

<sup>2</sup> To address institution considerations under 35 U.S.C. § 314(a), and with our authorization, Petitioner filed a Preliminary Reply (Paper 9) and Patent Owner filed a Preliminary Sur-reply (Paper 10). We do not refer to either paper in this Final Written Decision.

*B. Related Proceedings*

The parties identify the following matter pending in district court and related to the '249 patent: *Masimo Corp. v. Sotera Wireless, Inc.*, Case 3:19-cv-01100 (S.D. Cal.). Pet. 2; Paper 4, 1; *see also* Inst. Dec. 17–27.

Patent Owner also identifies the following *inter partes* review proceedings involving patents asserted in the related district court matter:

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;  
IPR2020-01015, challenging U.S. Patent No. 9,795,300;  
IPR2020-01019, challenging U.S. Patent No. RE47,353;  
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 (institution denied).

Paper 4, 2.

Patent Owner further identifies various applications that claim priority to, or share a priority claim with, the '249 patent. *Id.* at 1.

*C. The '249 Patent*

The '249 patent is titled “Alarm Suspend System,” and issued on February 19, 2019 from U.S. Patent Application No. 15/583,948, filed May 1, 2017. Ex. 1001, codes (22), (45), (54). The '249 patent is a reissue of U.S. Patent No. 9,153,121, filed on August 26, 2014. *Id.* at code (64).<sup>3</sup>

---

<sup>3</sup> The '249 patent claims earliest priority through a series of continuation applications to Provisional application No. 61/084,615, filed on July 29,

The '249 patent discloses 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 prevents both 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.

---

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 '249 patent is reproduced below.

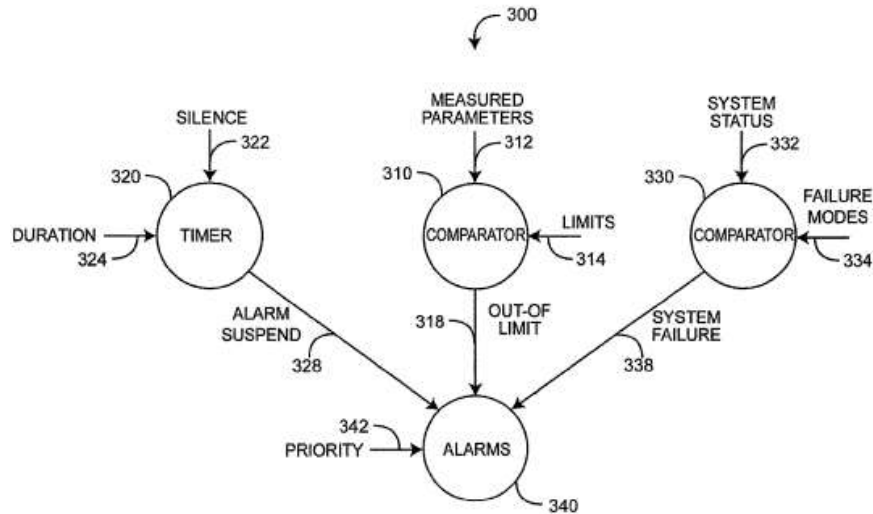


Figure 3 illustrates a flow diagram of the alarm suspend system. *Id.* at 4:16–17. “Alarm triggers include system failures 338 and out-of-limit parameters 318.” *Id.* at 5:43–44. Out-of-limit parameters are identified by comparing sensor-measured parameters 312 to default or user-specified limits 314. *Id.* at 5:51–52. Out-of-limit condition 318 triggers alarm 340 that can be suspended 328 temporarily 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 . . . are assigned relatively long suspend durations. Similarly, relatively fast treatment parameters, such as [oxygen saturation (‘SpO<sub>2</sub>’)] and [pulse rate (‘PR’)], are assigned relatively short suspend durations.” *Id.* at 6:28–33.

# 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.