

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01054
Patent 9,872,623 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. 9,872,623 B2 (“the ’623 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 '623 patent. Pet. 2; Paper 5, 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;
IPR2020-01015, challenging U.S. Patent No. 9,795,300;
IPR2020-01033, challenging U.S. Patent No. RE47,249;
IPR2020-01078, challenging U.S. Patent No. RE47,218; and
IPR2020-01082, challenging U.S. Patent No. 10,255,994.

Paper 5, 2.

Patent Owner further identifies various applications that claim priority to, or share a priority claim with, the '623 patent. *Id.* at 1–2.

C. The '623 Patent

The '623 patent is titled “Arm Mountable Portable Patient Monitor.” Ex. 1001, code (54). The '623 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 '623 patent is directed to “[a]n arm mountable portable monitoring device configured for both on patient monitoring of parameter measurements using one or more sensors operatively connected to the portable patient monitoring device and wireless transmission of parameter measurements.” *Id.* at code (57). As is further described in the Abstract:

The arm mountable portable patient monitoring device includes a pulse oximetry sensor configured to be wrapped around a digit of a patient, a housing having a size and shape configured for mounting to a lower arm of the patient, and a strap mountable to the back side of the housing and configured to secure the housing to the lower arm of the patient. The housing includes a display, a first sensor port positioned on the housing to face toward a hand of the patient, second and third sensor ports, a battery, signal processing arrangements to cause display of parameter measurements, and a transmitter to transmit information indicative of the measurements.

Id.

The '623 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 2:22–24. 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 '623 patent is to allow wireless pulse oximetry monitoring. *Id.* at 2:34–38; compare Fig 1², with Fig. 3.

Figure 3 of the '623 patent is reproduced below.

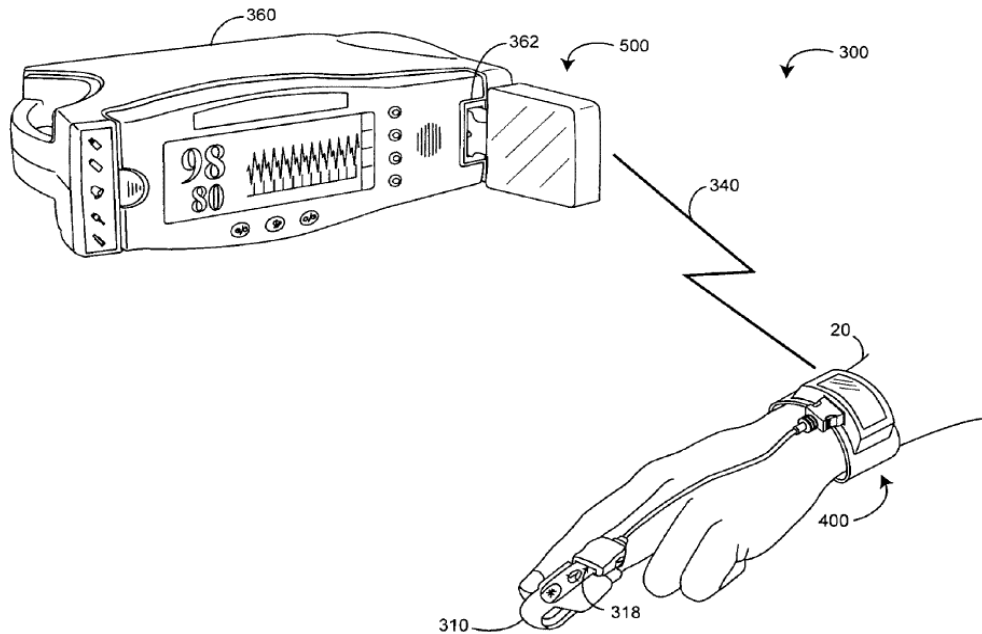


FIG. 3

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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