

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*.

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 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. 9,872,623 B2 (“the ’623 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, 2, 4, 5, 12, 14–17	103	Goldberg, ² Kiani, ³
3	103	Goldberg, Kiani, Fujisaki ⁴
6–11, 13, 18, 19	103	Goldberg, Kiani, Money ⁵
20	103	Goldberg, Kiani, Money, Fujisaki, Estep, ⁶ Taylor, ⁷ Hylton ⁸

¹ In support of its Petition, Petitioner relies on the Declaration of George E. Yanulis, D.Eng. (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. 4,425,921, issued on Jan. 17, 1984 (“Fujisaki”) (Ex. 1009).

⁵ US Patent No. 5,919,141 issued on July 6, 1999 (“Money”) (Ex. 1008).

⁶ PCT Publication No. WO 99/13698, published Mar. 18, 1999 (“Estep”) (Ex. 1010).

⁷ PCT Publication WO 96/15994, published on May 23, 1996 (“Taylor”) (Ex. 1011).

⁸ U.S. Patent No. 5,793,413 issued Aug. 11, 1998 (“Hylton”) (Ex. 1012).

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 4–19	103	Money, Kiani, Akai ⁹
3	103	Money, Kiani, Akai, Fujisaki
20	103	Money Kiani, Akai, Fujisaki, Estep, Taylor, Hylton

See Paper 12 (“Inst. Dec.”).

Masimo Corporation (“Patent Owner” or “Masimo”) timely filed a Patent Owner Response. Paper 20 (“PO Resp.”).¹⁰ Petitioner filed a Reply to the Response. Paper 24 (“Pet. Reply”).¹¹ Patent Owner filed a Sur-reply. Paper 29 (“PO Sur-reply”). Petitioner also filed a Motion to Exclude. Paper 33 (“MTE”). Patent Owner filed an Opposition to that Motion to Exclude (Paper 34), to which Petitioner replied (Paper 35). We held an oral hearing on August 26, 2021.¹² A transcript of the oral argument appears in the record. Paper 38 (“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 ’623 patent are unpatentable. See 35 U.S.C. § 316(e).

⁹ EP0880936A2 published on Dec. 2, 1998 (“Akai”) (Ex. 1007).

¹⁰ In support of the Patent Owner Response, Patent Owner relies on a Declaration of Alan L. Oslan. Ex. 2010.

¹¹ In support of the Reply, Petitioner provides a Declaration of Bryan Bergeron, MD. Ex. 1040.

¹² 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, and IPR2020-01054 (this proceeding).

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 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;
IPR2020-01015, 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, 2.¹³

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 directed to an “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 patient monitoring device

¹³ With the exception of IPR2020-01082, trial was instituted in all of the noted proceedings.

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 1,¹⁴ *with* Fig. 3.

¹⁴ 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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