NOTE: This disposition is nonprecedential.

United States Court of Appeals
for the Federal Circuit

MASIMO CORPORATION,
Appellant

v.

SOTERA WIRELESS, INC.,
Appellee

2022-1393

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2020-00967.

Decided: October 24, 2023

JEREMIAH HELM, Knobbe, Martens, Olson & Bear, LLP, Washington, DC, argued for appellant. Also represented by JAROM D. KESLER, STEPHEN W. LARSON, Irvine, CA.

RUDOLPH A. TELSCHER, JR., Husch Blackwell LLP, St. Louis, MO, argued for appellee. Also represented by JENNIFER E. HOEKEL, DAISY MANNING.

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2   MASIMO CORPORATION v. SOTERA WIRELESS, INC.

Before PROST, WALLACH, and CHEN, *Circuit Judges.*

PROST, *Circuit Judge.*

Masimo Corporation ("Masimo") appeals from an inter partes review final written decision determining all claims of U.S. Patent No. RE47,244 ("the '244 patent") are unpatentable. *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-00967, 2021 WL 6338280 (P.T.A.B. Nov. 19, 2021) ("*Board Decision*"). For the following reasons, we affirm.

BACKGROUND

The '244 patent, titled "Alarm Suspend System," is assigned to Masimo. It relates to an alarm suspension system for medical alarms where the duration of an alarm delay or suspension is responsive to the specific physiological parameter measured. '244 patent col. 2 l. 18–col. 4. l. 8. The '244 patent delays or suspends these alarms "so as to prevent unnecessary disturbance to the patient and distraction of the caregiver." *Id.* at col. 2 ll. 34–36.

Claims 1, 13, and 18 are independent. Claim 13 is illustrative and states:

> A method of electronically delaying or suspending an alarm while an electronically calculated measurement of a physiological parameter satisfies an alarm activation threshold, the measurement of the physiological parameter responsive to a signal from a noninvasive sensor positioned at a monitored patient, the method comprising:
>
> electronically processing a signal from a noninvasive sensor;
>
> responsive to processing the signal, electronically determining a first measurement of a first physiological parameter and a second measurement of a second physiological parameter using a patient monitoring device, the patient

> monitoring device including a processor and a memory device;
>
> electronically storing, using the patient monitoring device, a first *parameter-specific alarm delay or suspension period of time* corresponding to the first physiological parameter and a second *parameter-specific alarm delay or suspension period of time* corresponding to the second physiological parameter, the first *parameter-specific alarm delay or suspension period of time* being different from the second *parameter-specific alarm delay or suspension period of time*;
>
> electronically determining, using the patient monitoring device, that the first measurement of the first physiological parameter satisfies a first alarm activation threshold;
>
> electronically initiating, using the patient monitoring device, the first *parameter-specific alarm delay or suspension period of time*; and
>
> electronically activating, using the patient monitoring device, a first alarm for the first physiological parameter in response to expiration of a first amount of delay or suspension associated with the first *parameter-specific alarm delay or suspension period of time*.

'244 patent claim 13 (emphasis added).

Sotera Wireless, Inc. ("Sotera") petitioned for inter partes review of all claims of the '244 patent. Sotera argued obviousness on four grounds using U.S. Patent No. 5,865,736 ("Baker") as a reference and on two grounds using U.S. Patent Publication No. 2005/0038332 ("Saidara") as a reference. The Board determined all claims are unpatentable on the Saidara grounds. Masimo timely

appealed, and we have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

DISCUSSION

Masimo argues that the Board erred by incorrectly construing several claims and by improperly concluding that the prior art rendered the claims of the '244 patent obvious. Specifically, Masimo argues: (1) that claims 1 and 13 require the noninvasive measurement of two physiological parameters; (2) that the Board erred by not giving claim 18 a means-plus-function construction; and (3) that the Board erred by construing the "parameter-specific alarm delay or suspension period of time" limitation to encompass only pre-alarm delays. Masimo also independently argues that the Board's obviousness determinations cannot stand because several of its factual findings are unsupported by substantial evidence. We address each argument in turn.

I

We review the Board's ultimate claim construction and any determinations based on intrinsic evidence de novo and review subsidiary factual findings involving extrinsic evidence for substantial evidence. *Personalized Media Commc'ns, LLC v. Apple Inc.*, 952 F.3d 1336, 1339 (Fed. Cir. 2020). We address Masimo's claim construction arguments in the order discussed above.

A

Regarding the first claim-construction dispute, Masimo argues that the Board erred by determining all claims were obvious over Sotera's proposed combination consisting of one physiological parameter measured from a noninvasive sensor and another physiological parameter measured from an invasive sensor. Claim 13 recites "electronically processing a signal from a noninvasive sensor" and "responsive to processing the signal, electronically determining a first measurement of a first physiological parameter and a second measurement of a second

physiological parameter." '244 patent claim 13. Claim 1 similarly recites a "noninvasive physiological sensor" configured to output a signal, where "responsive to processing the signal," the system "determine[s] a measurement of a physiological parameter based at least in part upon the signal." *Id.* at claim 1. Claim 1 also recites "at least one other physiological parameter for which the one or more processors are configured to determine at least one measurement." *Id.* Claim 8, which depends from claim 1, further recites "determin[ing] a measurement of a second physiological parameter based at least in part upon the signal." *Id.* at claim 8.

Relying on this language, Masimo argues that claims 1 and 13 require the noninvasive measurement of two different physiological parameters. Appellant's Br. 23–28. Sotera responds that Masimo did not present this issue as a claim-construction dispute before the Board. We agree with Sotera. None of Masimo's arguments before the Board presented or implicated a construction for claims 1 or 13 requiring the noninvasive measurement of two physiological parameters. We therefore conclude that Masimo forfeited this argument.

In its petition, Sotera stated that "Saidara discloses a noninvasive sensor." J.A. 236 (claim 1); *see also* J.A. 248 (claim 13). In its preliminary response, Masimo presented proposed constructions for several terms, but it did not assert how many parameters must be measured noninvasively in claims 1 and 13. J.A. 303–07. And in its post-institution patent owner response, Masimo merely stated that "Saidara focuses on invasive sensors," J.A. 549, and that Sotera's expert "admitted Saidara does not teach a [skilled artisan] how to monitor blood glucose noninvasively," J.A. 562 n.7. Thus, the parties' initial dispute concerned the nature of Saidara's disclosure—not how many parameters must be measured noninvasively.

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