

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASIMO CORPORATION,
Petitioner,

v.

APPLE INC.,
Patent Owner.

IPR2023-00664
Patent 11,106,352 B2

Before KEN B. BARRETT, JOSIAH C. COCKS, and ROBERT L. KINDER,
Administrative Patent Judges.

KINDER, *Administrative Patent Judge.*

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On September 20, 2023, we instituted trial as to claims 1–24 of U.S. Patent No. 11,106,352 B2 (“the ’352 patent”). Paper 8. After institution, Patent Owner filed a Contingent Motion to Amend. Paper 14 (“Motion” or “Mot.”). Patent Owner stated “[i]n the event the Board finds at least one challenged MTA claim unpatentable, Apple respectfully requests that the Board grant this Motion to Amend (MTA) with respect to the corresponding proposed substitute claim(s).” Mot. 1. Petitioner filed an opposition on March 6, 2024. Paper 17 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1, 2; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend]”); *see also* 35 U.S.C. § 316(d) (statutory

requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes, Patent Owner proposes no more than 1 substitute claim for each challenged claim. Patent Owner proposes to substitute dependent claims 25–39 for original dependent claims 3-5, 7, 8, 11–13, 15, 16, 19–21, 23, and 24. Mot. 1, Claims App.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes. Patent Owner responds to the grounds of unpatentability at Motion 8–11. At least one amendment presented is responsive to a ground of unpatentability. Petitioner does not argue otherwise.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No. Each of the proposed substitute claims does not remove any limitations. Petitioner does not argue otherwise. The substitute claims add narrowing limitations and/or revise the claim numbers to be consistent with the claim numbering of the substitute claims. Mot. 2–8.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

Yes. On this record, despite Patent Owner’s contentions to the contrary, we find Patent Owner has not set forth sufficient written description support for proposed substitute claims 25–39 in the Motion at pages 12–17.

Claim 27 recites “calibrating one or more sensors of the wearable electronic watch.” Mot. Claims App. It appears Patent Owner contends paragraph 103 of Exhibit 2001 supports this claimed feature. Mot. 14.¹ This paragraph appears to disclose workout support module 142, which is part of device 100 (*see* Ex. 2001, Fig. 1A), and “includes executable instructions to . . . communicate with workout sensors (in sports devices

¹ The paragraphs identified in the column labelled “APPLE-2001” appear to be paragraphs from Exhibit APPLE-2002 and the paragraphs identified in the column labelled “APPLE-2002” appear to be paragraphs from Exhibit APPLE-2001. For example, under APPLE-2002 paragraph 464 is listed as support for claim 25. APPLE-2002 has no paragraph 464. Ex. 2002, 126. APPLE-2001 has a paragraph 464. Ex. 2001, 300.

and smart watches)”. The sports devices and smart watches appear to be external to device 100. The described sensors thus do not appear to be part of device 100, but instead external sensors. Ex. 2001 ¶ 103. The disclosure in ¶ 103 that the support module 142 may also “calibrate sensors used to monitor a workout” appears to be referring to these external sensors. Accordingly, paragraph 103 does not appear to describe “calibrating one or more sensors of the wearable electronic watch” but instead either (1) calibrating one or more sensors external to the wearable electronic watch or (2) calibrating one or more sensors whose location is not specified.

Claim 28 (and claim 29 by virtue of dependency thereon) recites “a wearable electronic watch that comprises an optical sensor located on a back side of the watch.” Mot. Claims App. Claim 32 contains a similar limitation. *Id.* It appears Patent Owner contends paragraph 61 of Exhibit 2001 provides written description support for this feature. Mot. 14. Petitioner contends the optical sensor described in this paragraph is a camera, placing a camera on the back of a smartwatch makes no sense, and “a POSITA would **not** understand from the patent application’s camera-sensor disclosure that the inventor possessed any optical sensor on the back of a watch.” Opp. 23–24. At this preliminary stage, we find Petitioner’s arguments more persuasive in this regard because Patent Owner has not identified description of a wearable electronic watch with an optical sensor located on a back side of the watch. Instead, Patent Owner relies (Mot. 14) on unassociated disclosure of a watch in paragraph 7 and an imaging optical sensor on the back of device 100 in paragraph 61. Ex. 2001 ¶¶ 7, 61.

Claim 36 recites “an interface provided in the power-saving state of the display generation component.” Mot. Claims App. It appears Patent Owner contends paragraph 376 of Exhibit 2001 supports this feature. Mot. 16. Petitioner argues this paragraph describes the display transitioning from a display-off state to a display-on state rather than an interface provided in the power-saving state. Opp. 25. Petitioner further contends both paragraph 376 and substitute claim 36 recite that the power-saving state is a display-off state and it is unclear how an interface could be provided when the display is off. *Id.* At this preliminary stage, we find Petitioner’s arguments persuasive in this regard because substitute claim 36 recites “the display-off state being a power-saving state” (Mot. Claims

App.) and Patent Owner has not identified description of an interface in a display-off state.

With respect to all of substitute claims 25–39, we identify the following deficiencies in connection with Patent Owner’s contentions regarding written description support.

First, the Motion is required to set forth the support “in the original disclosure of the patent.” 37 C.F.R. § 42.121(b)(1); *Lectrosonics* at 7–8. Patent Owner did not set forth the support in the original disclosure of the ’352 patent that was filed June 29, 2020 but instead set forth disclosure in a patent application publication produced approximately 4 months later in October 2020.

Second, the Motion did not set forth support in the parent and grandparent original disclosures. *See Lectrosonics* at 7–8 (motion to amend must “set forth support in an earlier filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought”); *cf.* MPEP § 211.05 I.B (“[i]f there is a continuous chain of copending nonprovisional applications, each copending application must disclose the claimed invention of the later-filed application in the manner provided by 35 U.S.C. 112(a) in order for the later-filed application to be entitled to the benefit of the earliest filing date”). Accordingly, Patent Owner has not, at this preliminary stage, satisfied its burden (*see* 37 C.F.R. § 42.121(d)(1)) of showing written description support.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record,² it appears that Petitioner (or the record) has shown a reasonable likelihood that proposed substitute claims 25, 26, 30, 31, 33–35, and 37–39 are unpatentable.

² We focus on limitations added to those claims in the Patent Owner’s Motion to Amend.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

Patent Eligibility

No, as to claims 25–39. On this record, it appears that Petitioner has not shown a reasonable likelihood that the proposed substitute claims are patent ineligible pursuant to 35 U.S.C. § 101.

We follow the Supreme Court two-step framework (*see Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 217–218 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012))) and additionally apply the USPTO current eligibility guidance (“Guidance”).³ Under the Guidance, to decide whether a claim is “directed to” an abstract idea, the PTO evaluates whether the claim: (1) recites an abstract idea falling within one of the groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activities, or mental processes) listed in the Guidance (Step 2A, Prong One), *and* (2) fails to integrate the judicial exception into a practical application (Step 2A, Prong Two). Guidance, 84 Fed. Reg. at 54–55; *see also* MPEP § 2106.04(d); § 2106.05(a)–(c), (e)–(h). If a claim is “directed to” an abstract idea, the PTO then determines whether the claim includes an “inventive concept” in Step 2B. Step 2B entails “evaluating th[e] additional elements individually and in combination to determine whether they contribute an inventive concept (i.e., amount to significantly more than the judicial exception(s)).” MPEP § 2106.05, subsection II (emphasis omitted).

³ We note the Guidance is found in the Ninth Edition, Revision 07.2022 (published February 2023) of the Manual of Patent Examining Procedure (“MPEP”), and particularly within Sections 2103 through 2106. Therefore, we refer to the MPEP for the eligibility Guidance originally published in the Federal Register. Although our analysis refers to the Guidance (*see, e.g.*, 2019 Revised Guidance 84 Fed. Reg. 50, 51 (Jan. 7, 2019) (“All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.”)), our determinations herein are based upon governing precedent of the United States Supreme Court and our reviewing court’s interpretation and application thereof (*see In re Rudy*, 956 F.3d 1379, 1382 (Fed. Cir. 2020) (stating that “the Office Guidance is not, itself, the law of patent eligibility” and “does not carry the force of law”)).

Petitioner contends “claims to organizing and displaying information are abstract.” Opp. 6 (bold and capitalization omitted).

We disagree with this statement as a general proposition because claims directed to organizing and displaying information have been found to be not abstract. *See, e.g., Data Engine Tech. LLC v. Google LLC*, 906 F.3d 999, 1007–11 (Fed. Cir. 2018) (concluding “a highly intuitive, user-friendly interface with familiar notebook tabs for navigating the three-dimensional worksheet environment” is not abstract); *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356, 1361–63 (Fed. Cir. 2018) (concluding “claims [] directed to a particular manner of summarizing and presenting information in electronic devices” is not abstract).

Moreover, the claims of the ’352 patent recite more than organizing and displaying information. Taking independent claim 1 as an example, the claim recites a computer system being in a particular condition or state (a power saving state), detecting an input that meets a display-waking criteria, and entering a wake condition or state in response thereto (displaying a wake screen user interface). Ex. 1001, 86:49–87:27. The claim further recites detection of different physical movements (movement directed to a portion of the wake screen user interface in a first direction and movement in a second, different direction) and transitioning to different interfaces in response thereto. *Id.*

Petitioner argues “[t]he information-organizing idea on which the ’352 patent’s independent claims are focused can be performed by a human with stacks of papers, folders in a filing cabinet, or sections in a binder.” Opp. 7. We disagree because a computer system being in a power saving state and entering a wake state in response to a detected input thereto are not activities that can be performed by a human. Further, detection of different physical movements directed to a portion of a wake screen user interface and transitioning to different screen interfaces in response thereto is not the same thing as reaching for different stacks of papers. Petitioner’s argument characterizing the invention as an information-organizing idea and reaching for different stacks of paper appear to be based on excerpts from the Specification without regard to the scope of the claimed subject matter.

At this preliminary stage, Petitioner has not satisfied its burden of persuasion (37 C.F.R. § 42.121(d)(2); *see Lectrosonics* at 3–4) that the proposed substitute claims are unpatentable under § 101 because Petitioner

has not established the '352 claims are directed to an abstract idea under the first step of the Supreme Court two-step framework.⁴ Because the first step is not satisfied, we need not reach the second step of the Supreme Court two-step framework. *See, e.g., Data Engine Technologies* at 1011 (when a claim is not directed to an abstract idea, *Alice* step two need not be reached); *Core Wireless* at 1363 (same).

Obviousness Based on Dascola (Ex. 1051)

Yes, as to claims 25, 26, 30, 31, 33–35, 38, and 39. On this record, it appears that Petitioner has shown a reasonable likelihood that at least Dascola teaches or suggests the added limitations of claims 25, 26, 30, 31, 33–35, 38, and 39.

No, as to claims 27, 28, 29, 32, and 36. On this record, it appears that Petitioner has not shown a reasonable likelihood that newly-cited Dascola teaches or suggests the added limitations of claims 27, 28, 29, 32, and 36. Ex. 1051, U.S. Patent Appl. Publication No. US 2017/0046024 A1, published February 16, 2017, and listing Apple Inc. as Applicant.⁵

Patent Owner states it believes that the proposed substitute claims are patentable “over all known prior art, alone or combined.” Mot. 18.

For narrowing limitations, Petitioner relies on Dascola. Opp. 12–22. Dascola describes a wearable electronic watch, touch-sensitive display, and graphical user interface in paragraph 8. Ex. 1051 ¶ 8. Dascola describes RF circuitry and various communication standards in paragraphs 93 and 99. Ex. 1051 ¶¶ 93, 99. Dascola further describes audio circuitry and associated communications in paragraph 100 (Ex. 1051 ¶ 100), an optical sensor in paragraph 108 (Ex. 1051 ¶ 108), tactile outputs in

⁴ Petitioner also did not follow the Guidance because Petitioner did not (1) identify each limitation Petitioner contends recites an abstract idea and indicate which one of the groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activities, or mental processes) applies under Step 2A, Prong One and (2) for each additional element (that is, each element in addition to elements reciting an abstract idea(s)) evaluate whether such additional element(s) integrate(s) the judicial exception(s) into a practical application under Step 2A, Prong Two. *See* MPEP §§ 2106.04.II, 2106.04(a).

⁵ The sole named inventor of the '352 patent is not listed as a named inventor on Dascola. Ex. 1001, code (72); Ex. 1051, code (72).

paragraph 123 (Ex. 1051 ¶ 123), workout sensors in paragraph 150 (Ex. 1051 ¶ 150), and a push button input in paragraph 164 (Ex. 1051 ¶ 164).

Petitioner contends “Dascola is in the same field of endeavor as, and presents the same alleged technical solution of, the ’352 patent and the prior art identified in the Petition.” Opp. 13 (citing Exhibits 1051 and 1054). Petitioner further contends “[a] POSITA would have been motivated to combine and would reasonably have expected success in combining Dascola with the prior art identified in the Petition.” Opp. 13 (citing Exhibit 1054).

We have reviewed Petitioner’s contentions on pages 12 to 14 of the Opposition and the evidence and arguments in support thereof. At this preliminary stage, it appears Petitioner has shown a reasonable likelihood that a POSITA would have been motivated to combine Dascola with the prior art identified in the Petition and would have had a reasonable expectation of success.

We have also reviewed the portions of Dascola cited in connection with claims 25, 26, 30, 31, 33–35, 38, and 39 and the evidence and arguments in connection therewith on pages 14 to 21 of the Opposition. At this preliminary stage, it appears Petitioner has shown a reasonable likelihood that Dascola discloses the added limitations of these claims.

Regarding substitute claim 27, Petitioner cites paragraph 150 of Dascola as disclosing the added subject matter of claim 27. Opp. 15–16. Paragraph 150 of Dascola is nearly identical to paragraph 103 of Exhibit 2001 (which, as discussed *supra*, Patent Owner contends supports the added subject matter of substitute claim 27). Like paragraph 103 of Exhibit 2001, paragraph 150 of Dascola does not appear to describe “calibrating one or more sensors of the wearable electronic watch” but instead either (1) calibrating one or more sensors external to the wearable electronic watch or (2) calibrating one or more sensors whose location is not specified. At this preliminary stage, it appears Petitioner has not shown a reasonable likelihood that Dascola discloses the added subject matter of substitute claim 27.

Regarding the added subject matter of substitute claims 28 and 32, Petitioner cites paragraph 108 of Dascola as disclosing “an optical sensor located on a back side of the watch.” Opp. 16. Paragraph 108 of Dascola is nearly identical to paragraph 61 of Exhibit 2001 (which, as discussed *supra*, Patent Owner contends supports this subject matter). Like

paragraph 61 of Exhibit 2001, paragraph 108 of Dascola does not appear to describe a wearable electronic watch with an optical sensor located on a back side of the watch. Paragraph 108 of Dascola does not mention a watch. Ex. 1051 ¶ 108. Substitute claim 29 contains the recitations of substitute claim 28 by virtue of dependency. At this preliminary stage, it appears Petitioner has not shown a reasonable likelihood that Dascola discloses the added subject matter of substitute claims 28, 29, and 32.

Claim 36 recites “an interface provided in the power-saving state of the display generation component.” Mot. Claims App. Petitioner does not appear to identify any portion of Dascola (or other prior art) that discloses an interface provided in the power-saving state. Opp. 18, 20–21; Ex. 1054 ¶¶ 84, 85. At this preliminary stage, it appears Petitioner has not shown a reasonable likelihood that Dascola discloses the added subject matter of substitute claim 36.

Obviousness Based on Bandyopadhyay (Ex. 1019) or Zanella (Ex. 1052)

Yes, as to claim 37 being obvious over Bandyopadhyay (Ex. 1019). No, as to claim 37 being obvious over Zanella (Ex. 1052).

Petitioner contends the added subject matter of substitute claim 37 would have been obvious based on Bandyopadhyay (Ex. 1019) or Zanella (Ex. 1052). Opp. 21–22.

At this preliminary stage, we find Petitioner’s contentions are sufficient to show a reasonable likelihood that the added subject matter of proposed substitute claim 37 is unpatentable as obvious over Bandyopadhyay, as Bandyopadhyay would have been understood by a POSITA (*see* Exhibit 1054 (Second Rosenberg Declaration) ¶¶ 88, 133). We observe Figure 5 of Bandyopadhyay describes an “*inactivity* timer expired” not an “*activity* timer expired” as stated in the Opposition (Opp. 22) and Exhibit 1054 (¶ 88).

At this preliminary stage, we are not persuaded that the disclosure of Zanella renders claim 37 obvious because Petitioner has not established the “modality of standby” (*see* Opp. 22) is the claimed screen-off state and has not established what “the time provided for passage from the modality of full function is expired” (*see* Ex. 1054 ¶ 90) means and entails.

Indefiniteness Under Section 112(b)

Yes, as to claims 33 and 37.

Substitute claim 33 appears to be indefinite because there does not appear to be antecedent basis for the language “wherein *the* radio frequency circuitry is configured to transmit *the* one or more wireless signals.” Mot. Claims App.

It is also unclear to us what “*the* device” in substitute claim 37 refers to. Mot. Claims App. Thus, claim 37 appears to be indefinite as well.

We acknowledge that Patent Owner has not yet had the opportunity to address Petitioner’s contentions in regard to proposed substitute claims 25–39. In particular Patent Owner has not had the opportunity to address Dascola and the other exhibits submitted in support of Petitioner’s Opposition. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised motion to amend) in this proceeding.

III.CONCLUSION

This concludes the Preliminary Guidance, which is Patent Owner’s first option under the Board’s pilot program. Notice, 84 Fed. Reg. at 9,497. Patent Owner has an additional option under the Board’s pilot program to file a revised Motion to Amend by DUE DATE 3. Paper 9.

In addition to those two options under the Board’s pilot program, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to

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notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

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