UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,

Petitioner

v.

APPLE INC.,

patent Owner

Case No. IPR2024-00169

U.S. patent No. 10,076,257 B2

PETITIONER'S CONDITIONAL MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2023-00745

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner AliveCor, Inc. ("Petitioner" or "AliveCor") hereby **conditionally moves** for joinder of AliveCor's contemporaneously filed petition for *inter partes* review of claims 1-4 and 8-22 of U.S. Patent No. 10,076,257 (the "'257 patent") with the instituted petition for review filed by Masimo Corporation, IPR2023-00745 ("Masimo Proceeding" and "Masimo," respectively).

The Masimo Proceeding was filed on March 22, 2023, on the same patent and the same claims as this Petition. This Petition and supporting declaration are substantively identical to the petition and declaration submitted in the Masimo Proceeding. More specifically, and for the purpose of joinder and maintaining an action before the PTAB, Petitioner hereby asserts that the same claims are anticipated and/or obvious over the same prior art based on the same arguments presented by the same expert as in the Masimo Proceeding.

AliveCor respectfully requests that the Board institute review in this proceeding and grant this joinder motion **if, and only if,** the Board has previously denied institution in *AliveCor, Inc. v. Apple Inc.*, IPR2023-00950 (the "AliveCor Proceeding").[1] Specifically, in the AliveCor Proceeding, Apple has advocated for

[1] Given the deadline for Joinder in the Masimo Proceeding, Petitioner must move for joinder now and cannot wait for the decision in the AliveCor Proceeding.

discretionary denial in view of the Masimo Proceeding. Should the Board deny institution at Apple's urging, the Board should institute this proceeding to preserve efficiency and fairness.

AliveCor submits that the circumstances and the necessity of this filing are unique due to Apple's litigation strategy. Apple chose to accuse Masimo of infringement months before AliveCor, putting AliveCor in the position of filing second at the PTAB. Now AliveCor is faced with the possibility of discretionary denial even though it acted expeditiously upon being served with a complaint for infringement. Institution of this copycat Petition, should AliveCor's Proceeding be discretionarily denied, best balances the Board's policy goals. Indeed, in cases like this one, the Board does not weigh the majority of the *General Plastic* factors against the Petitioner especially when an earlier petition is discretionarily denied and the second petition is a copycat thereby avoiding any road-mapping concerns. *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 5 (PTAB Aug. 23, 2022) (precedential) ("Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1−3 only weigh in favor of discretionary denial when there are 'road-mapping' concerns under factor 3 or other concerns under factor 2.").

Conversely, if the Board institutes review in the AliveCor proceeding, AliveCor withdraws this motion and the corresponding Petition. *See Apple Inc. v.*

Speir Techs. Ltd., IPR2023-00305, Paper 9 (PTAB May 15, 2023) (denying institution and denying petitioner's motion for conditional joinder because the Board concurrently instituted review in Apple's original petition). AliveCor makes this request to ensure that it is a named petitioner in one—**and only one**—instituted *inter partes* review proceeding. In this way, consistent with the Board's policy goals, AliveCor seeks a fair and efficient resolution to its dispute with Patent Owner while still affording itself the opportunity to pursue invalidity at the PTAB.

To be clear, AliveCor prefers and requests consideration of its original petition in the AliveCor Proceeding (the "AliveCor Petition"). The AliveCor Petition raises three distinct sets of grounds based on new prior art combinations: U.S. Patent Publication No. 2007/0021677 ("Markel") as a single-reference obviousness ground, Markel in view of U.S. Patent No. 6,775,566 ("Nissilä"), and Markel in view of U.S. Patent No. 5,191,891 ("Righter"). Each ground of the AliveCor Petition relies on a materially different disclosure in Markel—alone and in combination with Nissilä and Righter—to render obvious all claims of the '257 patent, whereas this copycat Petition leaves claims 5-7 unchallenged. Markel discloses an embodiment of its electronic device with an electrode molded into the audio output portion, which is not addressed at all in this Petition. Each ground of the AliveCor Petition provides a compelling case of obviousness that AliveCor believes should be instituted on the merits.

Because Apple has accused AliveCor of infringing the ’257 patent in district court and AliveCor believes the ’257 patent is unpatentable, AliveCor has a strong interest in pursuing a case of unpatentability at the PTAB.

II. STATEMENT OF MATERIAL FACTS

Apple Inc. (“Patent Owner”) purportedly owns the ’257 patent.

The following litigation or *inter partes* reviews related to the ’257 patent are pending:

- *Masimo Corp. v. Apple Inc.*, IPR2023-00745 (PTAB);
- *AliveCor, Inc. v. Apple Inc*, IPR2023-00950 (PTAB);
- *Masimo Corp. v. Apple Inc.*, IPR2024-00071 (PTAB);
- *Apple Inc. v. Masimo Corp. et al.*, Case No. 1:22-cv-01378-MN (D. Del.); and
- *Apple Inc. v. AliveCor, Inc.*, Case No. 4:22-cv-07608-HSG (N.D. Cal.).

Apple asserted the ’257 patent against AliveCor in *Apple Inc. v. AliveCor, Inc.*, Case No. 4:22-cv-07608-HSG (N.D. Cal.), two months after Apple asserted the ’257 patent in an unrelated case against Masimo in *Apple Inc. v. Masimo Corp. et al.*, Case No. 1:22-cv-01378-MN (D. Del.). Other than the ’257 patent, Apple asserted different patents against AliveCor and Masimo, accusing vastly different products of infringing in different jurisdictions months apart. There is no other overlap between the two litigations.

On March 22, 2023, Masimo petitioned for *inter partes* review of the '257 patent in the Masimo Proceeding (IPR2023-00745). On June 7, 2023, entirely independent of Masimo, AliveCor petitioned for *inter partes* review of the '257 patent in the AliveCor Proceeding based on new grounds and new prior art (IPR2023-00950). AliveCor now seeks to join the Masimo Proceeding **if, and only if,** the Board denies institution in the AliveCor Proceeding.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Board has discretion to, and should, join this proceeding with the Masimo Proceeding. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). The motion for joinder is timely because it is submitted within one month after the institution date of the Masimo Proceeding. *See* 37 C.F.R. § 42.122(b). In considering a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) new grounds of unpatentability asserted in the petition; (3) the impact (if any) joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Dell Inc. v Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper No. 17 at 4 (PTAB July 29, 2013). All of these factors weigh in favor of joinder.

A. Joinder is Appropriate

Joinder is appropriate here because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings. Any

additional cost to Patent Owner would be minimal. On the other hand, denial of joinder would prejudice AliveCor if, and only if, the AliveCor Petition is denied. This is particularly true if Masimo settles with Patent Owner. Just recently, the U.S. International Trade Commission issued an exclusion order against Patent Owner's watches found to infringe Masimo's patents. *See* Inv. No. 337-TA-1276. That order may yield a settlement.[2]

In the event the Board denies institution in the AliveCor Proceeding, this would be AliveCor's only petition challenging the patentability of the '257 patent. While the Board has previously applied the factors espoused by *General Plastic Indus. Co. v. Cannon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential) to a joinder petition of a petitioner that previously filed its own petition, the Board should not and need not do so in this case, especially given the conditional nature of this petition. *Apple Inc., v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential). This case is distinguishable over *Apple* given that if AliveCor's Proceeding is denied, it will be

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[2] This Petition and Motion for Joinder are being filed within one year of AliveCor being served with a complaint for infringement. As such, should Apple settle with Masimo and terminate the Masimo Proceeding, the Board should grant this proceeding for the reasons it instituted in the Masimo Proceeding.

because of discretionary denial. As instructed by the Director, *General Plastic* factors 1-3 do not weigh in favor of discretionary denial. *Code200, UAB v. Bright Data Ltd*., IPR2022-00861, Paper 18 at 5 (PTAB Aug. 23, 2022) (precedential) ("Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1−3 only weigh in favor of discretionary denial when there are 'road-mapping' concerns under factor 3 or other concerns under factor 2.").

Indeed, factors 4-7 weigh in favor of institution given that it would have been wasteful for Petitioner to pursue joinder any earlier, and the filing date of this Petition is within the one-month timeline set by the Board's rules. Moreover, both parties will benefit from confining adjudication on certain invalidity grounds to a single forum, and Petitioner is willing to serve as an "understudy" in the Masimo Proceeding, which is fully consistent with the Board's statutory goal.

B. No New Grounds of Unpatentability

This Petition and the petition in the Masimo proceeding are substantially the same, challenging the same claims based on the same prior art grounds and evidence, including an identical declaration from the same expert. Petitioner has copied the substance of the petition in the Masimo proceeding for the purpose of joinder and is filing its accompanying expert declaration.

Petitioner does not seek to introduce grounds or claims not currently in the Masimo Proceeding. In the event the Board denies institution in the AliveCor Proceeding, AliveCor agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Masimo Proceeding as instituted. Thus, joinder would be the most efficient and economical manner to proceed. *See, e.g., Dell Inc. v. Alacritech, Inc.*, IPR2018-01307, Paper No. 8 (PTAB Jan. 11, 2019) (granting motion for joinder where the petition challenged the same claims on the same grounds).

C. Joinder Will Not Impact Any Trial Schedule.

Petitioner consents to the current schedule in the Masimo Proceeding and will not request any alterations to any schedule that may issue in the Masimo Proceeding based on the requested joinder. Further, this Petition does not include any new grounds of unpatentability. As such, joinder of this case will not introduce any new prior art, experts, or grounds for unpatentability into the Masimo Proceeding.

D. Joinder Would Simplify Briefing and Discovery.

As the prior art and bases for unpatentability in the petitions in both this IPR and the Masimo Proceeding are the same, the same arguments will be made in both proceedings. Both Petitioner and Masimo rely on the same expert to support identical arguments.

Further, AliveCor agrees to take an "understudy" role in this joined proceeding, so long as Masimo remains an active party in the joined proceeding. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 5–8 (PTAB May 30, 2019) (granting IPR where petitioners requested an "understudy" role). Petitioner will assume a primary role only if Masimo ceases to participate in the IPR. This will avoid lengthy and duplicative briefing. And because this Petition relies on the same expert declaration, only a single deposition is needed for the proposed joined proceeding.

Specifically, AliveCor expressly agrees, upon joining the Masimo Proceeding, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as the current petitioner remains an active party:

a) all filings by AliveCor in the Masimo Proceeding shall be consolidated with the filings of the current petitioner, unless a filing concerns issues solely involving AliveCor;

b) AliveCor shall not be permitted to raise any new grounds in this proceeding not instituted by the Board in the Masimo Proceeding, or introduce any argument or discovery not introduced by the current petitioner;

c) AliveCor shall be bound by any agreement between Patent Owner and the current petitioner concerning discovery and/or depositions; and

d) AliveCor at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted under 37 C.F.R. § 42.53 or any agreement between Patent Owner and the current petitioner.

See Noven Pharmaceuticals, Inc. v. Novartis AG, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015). Unless and until the current petitioner ceases to participate, AliveCor will not assume an active role in the Masimo Proceeding.

Agreeing to an "understudy" role removes any potential "complication or delay" caused by joinder, while providing the parties an opportunity to address all issues that may arise and avoiding any undue burden on Patent Owner, Masimo, and the Board. *See, e.g., Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256, Paper 10 at 8–10 (PTAB June 20, 2013).

IV. PETITIONER'S RANKING OF PETITIONS

A. This Petition and the AliveCor Petition Are Materially Different

In materially different ways, the AliveCor Petition and this Petition each demonstrate that the '257 patent's claims are unpatentable albeit based on materially different embodiments of Markel.

The AliveCor Petition raises three distinct sets of grounds based on new prior art combinations: Markel as a single-reference obviousness ground, Markel in view of U.S. Patent No. 6,775,566 ("Nissilä"), and Markel in view of U.S. Patent No. 5,191,891 ("Righter"). Each ground of the AliveCor Petition relies on a materially

different disclosure in Markel—alone and in combination with Nissilä and Righter—to render obvious all claims of the '257 patent. Markel discloses an embodiment of its electronic device with an electrode molded into the audio output portion, which is not addressed at all in this Petition.

The AliveCor Petition and this Petition further diverge by applying materially different secondary references. The AliveCor Petition relies on Nissilä and Righter, whereas this Petition relies on Mills. The Petitions diverge even further by raising different arguments for why a POSITA would have been motivated to combine the prior art references.

Finally, this Petition leaves three claims left unchallenged, whereas the AliveCor Petition challenges all claims of the '257 patent.

In all these ways, the AliveCor Petition and this Petition offer non-redundant, non-duplicative, and substantially dissimilar challenges to the '257 patent.

B. Petitioner Ranks the AliveCor Petition Ahead of This Petition

Petitioner prefers and requests initial consideration of the AliveCor Petition before the Board considers this Petition and its accompanying conditional motion for joinder. As discussed above, each ground of the AliveCor Petition provides a compelling case of obviousness based on prior art combinations that the Board has not yet considered. Petitioner has a strong interest in prosecuting a case of unpatentability before the Board, and Petitioner would prefer to prosecute on the

Grounds that it set forth in the AliveCor Petition. AliveCor respectfully requests that the Board institute review in this proceeding and grant this joinder motion **if, and only if,** the Board has previously denied institution of the AliveCor Petition. That is, if the Board institutes review of the AliveCor Petition, AliveCor withdraws this motion and the petition. Conversely, if the Board were to decline to institute review on the AliveCor Petition, AliveCor request consideration and institution of this proceeding.

Furthermore, instituting review in the AliveCor Proceeding would promote efficiency for all parties involved. For example, institution could preclude or abridge a jury trial on invalidity by encouraging a stay. AliveCor already filed motion to stay the district court litigation. EX1022. Institution of review could also lead to a final written decision that estops Petitioner under 35 U.S.C. §315(e)(2) from asserting certain grounds of invalidity in the district court litigation. The scope of estoppel would be broader if the AliveCor Proceeding is instituted and proceeds to a final decision than if Petitioner is merely joined to the Masimo Proceeding. *See Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1026-28 (Fed. Cir. 2020) (finding scope of estoppel narrowed when petitioner was limited to joining instituted proceeding).

If the Board were to decline to institute review on the AliveCor Petition in the AliveCor Proceeding, the next best course of action would be to institute review on

this Petition and grant Petitioner's conditional motion for joinder. As with the AliveCor Proceeding (albeit to a lesser extent), institution and joinder would promote efficiency in the Litigation, at least with respect to the grounds of this Petition, and would do so at no expense or prejudice to Patent Owner.

V. CONCLUSION

For the foregoing reasons, Petitioner AliveCor, Inc. respectfully requests **if, and only if,** the Board has previously denied institution of the AliveCor Proceeding, that the Board institute this Petition for *inter partes* review of U.S. Patent No. 10,076,257 and join this proceeding with *Masimo Corp. v. Apple Inc.*, IPR2023-00745.

Dated: November 15, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §42.6(e) and §42.105 that on November 15, 2023, a true and correct copy of the **Conditional Motion for Joinder and Petition for *Inter Partes* Review of U.S. Patent No. 10,076,257** challenging claims 1-4 and 8-22 was served via UPS Next Day Air®:

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