

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,
Petitioner,

v.

APPLE INC.,
Patent Owner

Case IPR2024-00169
U.S. Patent 10,076,257

**PATENT OWNER'S RESPONSE TO
ALIVECOR'S MOTION FOR JOINDER**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	PROCEDURAL POSTURE.....	4
III.	CONCERNS OVER FAIRNESS AND EFFICIENCY URGE SATISFACTION OF ALIVECOR’S JOINDER CONDITION THROUGH INSTITUTION DENIAL OF THE ALIVECOR I PETITION	5
IV.	ALIVECOR’S REQUEST FOR JOINDER SERVES EFFICIENCIES OTHERWISE LOST THROUGH INSTITUTION OF ALIVECOR I	8
V.	CONCLUSION.....	14

LIST OF EXHIBITS

APPLE-2001 Apple's Stipulation Letter

I. INTRODUCTION

On November 15, 2023, AliveCor filed a Petition challenging claims of U.S. Patent No. 10,076,257 (“the ’257 patent”) that substantially copies a petition earlier-filed by Masimo Corp. (“Masimo”) along with a motion for joinder. Thus, AliveCor has filed two IPR petitions challenging the ’257 patent. And yet, by offering the joinder motion to which this Response is directed, AliveCor has signaled not only its willingness but its desire to be joined to an earlier-filed/instituted petition, IPR2023-00745, which is the first of four petitions targeting the ’257 patent.

Notably, AliveCor frames its joinder motion as “conditional,” stating that AliveCor “**conditionally moves** for joinder of AliveCor’s contemporaneously filed petition for *inter partes* review of claims 1-4 and 8-22 of [the ’257 patent] with the instituted petition for review filed by Masimo Corporation, IPR2023-00745 (“Masimo Proceeding” and “Masimo,” respectively).” Mot. Join., 1 (emphasis in original). AliveCor expresses its condition as follows: “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.” *Id.* (emphasis in original). Among other things, AliveCor’s condition requires Board determination of whether discretion should be applied to deny AliveCor’s first petition, an inquiry that is necessarily informed by whether fairness and efficiency

are better served through institution of the petition filed in the present proceeding, or the petition later filed by AliveCor in the IPR2023-00950 proceeding.

As explained by Patent Owner twice before,¹ in filing IPR2023-00950, AliveCor advanced grounds based on a primary reference (Markel) that was central to a petition filed nearly three months earlier by Masimo, IPR2023-00745.

Unsurprisingly, AliveCor indicates in its joinder motion a preference for institution of its Markel-based grounds (IPR2023-00950); this would yield a second and later proceeding on grounds that apply Markel as a primary reference. Indeed, because AliveCor decided to reassert Markel when filing after the earlier Masimo petition, institution of AliveCor's IPR2023-00950 petition triggers enhanced concerns over fairness and efficiency. On the contrary, the interests of fairness and efficiency would be well served through denial of AliveCor's IPR2023-00950 petition if AliveCor were granted its motion for joinder based on corresponding satisfaction of its condition. Indeed, joining AliveCor to Masimo's earlier IPR2023-00745 proceeding, as contemplated by AliveCor in the subject motion to join, would promote fairness by offering AliveCor an opportunity to ensure completion of a

¹ See IPR2023-00950, Paper 6 (Patent Owner's Preliminary Response) at 2-4, 9-10, 13-15 (PTAB Oct. 11, 2023); IPR2023-00950, Paper 11 (Patent Owner's Sur-Reply to Petitioner's Preliminary Reply) at 6-7 (PTAB Nov. 21, 2023).

PTAB investigation based on the primary reference (Markel) advanced in each of AliveCor's petitions while also promoting efficiency using a single resulting proceeding for that investigation. The merits of this approach become more apparent when considering that AliveCor has repeatedly failed to identify material distinctions between the Masimo and AliveCor petitions that each apply Markel as a primary reference, and, further, when considering that Patent Owner has signaled to Masimo its intent to pursue amendments to certain claims in the Masimo Proceeding.

For these and other reasons detailed below, Patent Owner submits that the interests of fairness and efficiency each compel the following: (1) denial of institution in the IPR2023-00950 proceeding initiated by AliveCor to later advance Markel as a primary reference after Masimo had earlier advanced the same Markel reference as primary in the now-instituted IPR2023-00745 proceeding, and (2) through the IPR2023-00940 institution denial, triggering satisfaction of AliveCor's joinder condition and thus joinder by AliveCor to the earlier IPR2023-00745 proceeding initiated by Masimo. Such an approach to AliveCor's staggered petitions, consistent with AliveCor's joinder condition, strikes an appropriate balance between the rights of the parties and the interests of the Board in fairness and efficiency. *See* Mot. Join., 2 ("Institution of this copycat Petition...best balances the Board's policy goals.").

II. PROCEDURAL POSTURE

The procedural posture of the first filed petition challenging claims of the '257 patent and AliveCor's two follow-on petitions is as follows:

- IPR2023-00745 filed by Masimo on March 22, 2023 (*Masimo Corp. v. Apple Inc.*, IPR2023-00745, Paper 1 (PTAB Mar. 22, 2023) ("Masimo 1") first advancing U.S. Patent Pub. No. 2007/0021677 ("Markel")
- IPR2023-00950 filed by AliveCor on June 7, 2023 (*AliveCor, Inc. v. Apple Inc.*, IPR2023-00950, Paper 2 (PTAB June 7, 2023) ("AliveCor 1") again advancing Markel
- IPR2024-00169 filed by AliveCor on November 15, 2023 (*AliveCor, Inc. v. Apple Inc.*, IPR2024-00169, Paper 1 (PTAB Nov. 15, 2023) ("AliveCor 2"; "this proceeding") yet again advancing Markel

As noted, the AliveCor 1 and AliveCor 2 petitions each seek consideration of the same primary reference (Markel), a reference earlier relied upon by Masimo in its first petition, which was granted institution and which has been targeted for joinder by the AliveCor joinder motion addressed in this Response. *See* IPR2023-00745, Paper 1 at 12-13; IPR2023-00950, Paper 2 at 1; IPR2024-00169, Paper 1 at 11-12. The AliveCor 1 petition relies on Markel as the primary reference for all

grounds (including a ground asserting anticipation by Markel) while the AliveCor 2 Petition relies on Markel as the primary reference for one of its two grounds. *Id.*

III. CONCERNS OVER FAIRNESS AND EFFICIENCY URGE SATISFACTION OF ALIVECOR'S JOINDER CONDITION THROUGH INSTITUTION DENIAL OF THE ALIVECOR I PETITION

As Patent Owner twice explained in the AliveCor 1 proceeding, fairness and efficiency concerns favor discretionary denial of that petition under both 35 U.S.C. § 314(a) and § 325(d). As identified above, the AliveCor 1 petition relies on the Markel reference as the primary reference for all Grounds. Markel is also the same primary reference in at least one ground in each of the Masimo 1 and AliveCor 2 petitions. Yet AliveCor waited nearly three months after the filing of the Masimo 1 petition relying on Markel to file the AliveCor 1 petition that reapplies Markel.

For reasons described in Patent Owner's briefs in the AliveCor 1 proceeding, by delaying submission of its petition re-applying Masimo's Markel primary reference, AliveCor positioned itself to use the Masimo 1 IPR proceeding as a roadmap throughout the AliveCor 1 proceeding for its selection of arguments and development of evidence, since institution of the AliveCor 1 proceeding would allow AliveCor to leverage insights gained from Patent Owner's Masimo 1 papers and development of Masimo 1 evidence when preparing its witness for deposition, its petitioner's reply, and its oral hearing arguments in AliveCor 1. *See* IPR2023-

00950, Paper 6 at 2-4, 9-10, 13-15 (PTAB Oct. 11, 2023); IPR2023-00950, Paper 11 at 6-7 (PTAB Nov. 21, 2023). Indeed, as discussed in those briefs, institution of the AliveCor 1 petition would yield inefficiencies for the Board and unfairness for Patent Owner across the Masimo and AliveCor IPR proceedings, as papers and exhibits filed within the staggered proceedings will provide the petitioners with an opportunity to continually adjust strategies and arguments pertaining to application of the same primary reference in each other's proceedings. *Id.*

By filing its first petition nearly three months after the petition in the Masimo 1 proceeding, AliveCor positioned itself to prepare its own witness for deposition with the benefit of undeserved access to arguments and evidence advanced by Patent Owner in the patent owner response filed in the Masimo 1 IPR proceeding, as well as the transcript of Patent Owner's deposition of Masimo's witness addressing the same Markel reference. Those materials and the Patent Owner positions revealed therein, which will of course address the common Markel primary reference advanced by both petitioners in substantially similar arguments, would unfairly offer AliveCor a roadmap informing not only the preparation of its own witness for deposition, but preparation by AliveCor of its petitioner's reply in the AliveCor 1 proceeding. Further, and along those same lines, because it staggered its petition filing, the AliveCor 1 petition is instituted, AliveCor would have the unfair advantage of preparing its petitioner's reply with

undeserved insights into Patent Owner's patent owner's sur-reply in the Masimo 1 IPR Proceeding – Patent Owner's final substantive paper setting forth its final arguments with respect to that reference and related arguments in that proceeding.

Seemingly aware that such fairness and efficiency concerns of its reapplication of the same Markel reference favors discretionary denial of the staggered AliveCor 1 petition, AliveCor has now expressed its willingness to be joined by filing a copycat petition of the Masimo 1 petition along with a conditional motion for joinder. Indeed, these concerns over fairness and efficiency urge satisfaction of the joinder condition, which triggers on discretionary denial of the IPR2023-00950 petition and is justified by AliveCor's expressed embrace and willingness to join the Masimo application of Markel grounds. Indeed, the functional impact of denying institution of the IPR2023-00950 petition triggering the motion for joinder is a more efficient and equitable vehicle for advancing substantially similar arguments based on the same primary reference over the more problematic, complex staggered AliveCor 1 petition.

For these and the numerous other reasons previously identified,² the fairness and efficiency concerns unique to this set of cases favors the joining of AliveCor to

² See fn.1.

Masimo 1 and, in satisfaction of AliveCor's condition, exercising discretion to deny the AliveCor 1 petition.

IV. ALIVECOR'S REQUEST FOR JOINDER SERVES EFFICIENCIES OTHERWISE LOST THROUGH INSTITUTION OF ALIVECOR I

As discussed above, Markel serves as the primary reference in Ground 2 of the first filed Masimo 1 petition. IPR2023-00745, Paper 1 at 12-13. Furthermore, all grounds in AliveCor's petition in the AliveCor 1 proceeding reapply Markel as the primary reference, including Ground 1 asserting that all 22 claims of the '257 patent are obvious under pre-AIA 35 U.S.C. §103 based on Markel alone.

IPR2023-00950, Paper 2 at 1. In its briefs in the AliveCor 1 proceeding, AliveCor repeatedly failed to identify a basis for finding material distinctions between its reliance on Markel in contrast to Masimo's use of Markel in the Masimo 1 petition. It instead identified only surface level differences between the two petitions, alleging that "AliveCor relies on a different / stronger embodiment in Markel" with reference to "Figure 6" without any analysis as to the alleged strengths of the AliveCor 1 Petition over the Masimo 1 Petition or how Markel's Figure 6 materially differs from other disclosures of Markel. *See e.g.* IPR2023-00950, Paper 8 at 7-8; IPR2023-00950, Paper 2 at 91.

Furthermore, AliveCor had multiple opportunities to identify material distinctions between the use of the Mills reference as a secondary reference to

Markel in the Masimo 1 petition and the use of the Nissilä reference as a secondary reference to Markel in the AliveCor 1 petition. AliveCor did not. It instead did not even acknowledge within the AliveCor 1 petition the existence of the earlier-filed Masimo 1 petition, and when granted supplemental briefing to address Petitioner's preliminary response, AliveCor responded with "AliveCor's secondary references are not cumulative" but offered nothing of substance on that particular point. *See* IPR2023-00950, Paper 2 at 91; IPR2023-00950, Paper 8 at 3, 7. More telling is AliveCor's reliance on Nissilä in combination with Markel, given the similarity to the approach earlier taken by Masimo in relying on Mills in combination with Markel in substantially the same manner. Indeed, AliveCor relies on Nissilä in combination with Markel for the exact same limitation that Masimo relied on Mills: "wherein the first pad is positioned underneath the exterior surface of the first portion." *Compare* IPR2023-00950, Paper 2 at 71-72 (relying on Nissilä as allegedly "having a pad that is positioned underneath the exterior surface of an enclosure"), 16 (Limitation 1.c.iii), *with* IPR2023-00745, Paper 1 at 46-47 (relying on Mills for disclosing that "[t]he pad is underneath the exterior surface.") 49 (referring back to discussion under Limitation 1[b(i)]).

Under the unique circumstances here, where AliveCor has asserted grounds reapplying the same primary reference and applied allegedly "new" secondary references in substantially the same manner as the Masimo 1 petition without

identifying any material distinctions between the application of these references in the serially filed petitions, rather than instituting the staggered second assertion of Markel as a primary reference by the AliveCor 1 petition, the interests of fairness and efficiency are best served through the discretionary denial of the AliveCor 1 petition, which, in turn, triggers the joinder of the AliveCor 2 petition with the Masimo 1 petition to yield a single proceeding in which Markel is advanced as a primary reference.

Where a later petitioner fails, as here, to identify material differences in the prior art that it relies upon and prior art of an earlier pending petition, the Board has indicated that joinder is the proper mechanism for petitioners to seek consideration of overlapping grounds based on the same prior art. *Google, LLC v. Uniloc 2017 LLC*, IPR2019-01584, Paper 7 at 13 (PTAB Oct. 16, 2020)(“Petitioner had opportunities to mitigate efficiency concerns relating to a [serial] challenge to this patent, for example, by filing a petition accompanied by a motion for joinder to join one of the earlier petitions.”); *see also Sony Mobile Comms. AB v. Ancora Tech., Inc.*, IPR2021-00663, Paper 17 at 23, 29-33 (PTAB Jun. 10, 2021). As explained by the panel that denied institution in that proceeding, filing a copycat petition along with a motion for joinder (as AliveCor has done here) “mitigate[s] efficiency concerns” relating to staggered petitions

relying on the same primary reference and substantially similar secondary references and arguments. *Google*, IPR2019-01584, Paper 7 at 13.

In addition to the above concerns regarding fairness/gamesmanship, efficiency concerns also favor granting of AliveCor's motion for joinder while denying its AliveCor 1 petition. *See e.g., Google LLC v. Uniloc Luxembourg S.A.*, IPR2017-02067 Pap. 10 at 8-11 (PTAB Mar. 29, 2018) (denying institution of a follow-on petition under § 325(d) in part because a subsequent petitioner's reliance on a primary reference earlier mapped by a different petitioner would unfairly advantage the subsequent petitioner, and in part because of efficiency concerns implicated by reconciling arguments, issues, and evidence across multiple independent trials).

For example, as was the case in *Google v. Uniloc*, Patent Owner here has requested authorization to file a motion to amend challenged claims of the '257 patent in the already instituted Masimo 1 proceeding. As the Board observed in *Google v. Uniloc*, a motion to amend filed in the first of several serial petitions based on the same prior art "raises concerns regarding the complexity and potential for inconsistency inherent in allowing this proceeding to occur in tandem with ongoing trials that arise in large part from the considerable role [the primary reference] plays [in] each proceeding." *Id.* When a motion to amend is filed in a first instituted petition, institution of later filed petitions relying on the same

primary reference on a staggered schedule raises concerns regarding “administrative efficiency because significant resources of the Board would be consumed reconciling arguments, issues, and evidence across multiple, independent trials.” *Id.* For this additional reason, fairness and efficiency compel granting of AliveCor’s motion for joinder in this proceeding and denial of institution of the staggered AliveCor 1 petition. Such a course of action would eliminate the concerns regarding “reconciling arguments, issues, and evidence across multiple, independent trials” identified by the Board in *Google v. Uniloc*.

Fairness and efficiency concerns raised above (and in Patent Owner’s briefs in the AliveCor 1 proceeding) strongly favor satisfaction of the joinder condition articulated by AliveCor, as its condition triggers on denial of institution of the AliveCor 1 petition, which is appropriate for reasons previously articulated. Indeed, joining AliveCor to the instituted Masimo proceeding achieves fairness because AliveCor is ensured consideration of the Markel prior art that AliveCor advances as a primary reference in each of its two petitions, while alleviating gamesmanship concerns that occur from the staggered timing of the Masimo 1 and

AliveCor 1 petitions.³ Furthermore, joining AliveCor promotes judicious efficiency because granting AliveCor's motion for joinder, while denying institution of the AliveCor 1 petition, would align AliveCor's timing with that of the first filed Masimo 1 petition in a single contemporaneous proceeding rather than in two asynchronous proceedings that would opine on the same Markel reference.

The Board has shown a preference for aligning the schedules of petitions filed by different petitioners challenging the same patent as a method for alleviating "road mapping" concerns. *Uber Tech., Inc. v. LBT IP II LLC*, IPR2022-00926, Paper 9 at 13 (Dec. 7, 2022). In *Uber Tech.*, the Board was able to align the schedules of two IPR proceedings initiated by different petitioners but relying on the same prior art reference by issuing the Institution Decisions in the two cases "contemporaneously." *Id.* This was possible due to the second filed petition relying on the same primary reference having been filed only three days

³ While the AliveCor 1 petition challenges an additional three claims (i.e., dependent claims 5-7) that are not challenged in the Masimo 1 and copycat AliveCor 2 petitions, in accordance with Apple's stipulation (Ex. 2001), Apple has not and will not assert any of claims 5-7 against AliveCor in the counterpart district court litigation.

after the first filed petition. *Id.* However, in contrast to the situation in *Uber Tech*, in the present case, AliveCor waited to file its AliveCor 1 petition until nearly three months after the first filed Masimo 1 petition, despite its reapplication of the same Markel reference. Through its delay, AliveCor leaves the Board just one option for aligning the schedules of petitions filed advancing Markel as a primary reference, joinder—which AliveCor endorses as one of just two acceptable options in its motion for joinder in this proceeding—and denial of institution of the AliveCor 1 petition filed by AliveCor after the to-be-joined Masimo I petition. Such aligning of the schedules for Masimo and AliveCor would resolve the fairness and efficiency concerns raised above while still ensuring that AliveCor receives full and uninterrupted consideration by the PTAB of Markel.

V. CONCLUSION

For the above discussed reasons, the fairness, timing, and efficiency concerns raised with respect to the multiple petitions filed by AliveCor all indicate that the proper vehicle for AliveCor to pursue grounds challenging the '257 patent based on Markel is the grant of AliveCor's copycat petition and motion for joinder filed in the present proceeding. To satisfy AliveCor's articulated condition, the denial of the AliveCor 1 petition filed in IPR2023-00950 in conjunction with granting the motion for joinder in the present petition is the proper outcome.

Respectfully submitted,

Date: December 15, 2023

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265
Jeremy Monaldo, Reg. No. 58,680
Grace J. Kim, Reg. No. 71,977
Andrew B. Patrick, Reg. No. 63,471
Patrick J. Bisenius, Reg. No. 63,893
Fish & Richardson P.C.
60 South Sixth Street
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on December 15, 2023, a complete and entire copy of this Patent Owner's Response to Petitioner's Motion for Joinder was provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

Christopher TL Douglas, Reg. No. 56,950
Scott M. Stevens, Reg. No. 54,762
Philip Ducker, *Pro Hac Vice*
J. Ravindra Fernando, Reg. No. 73,762
Thomas F. Finch, *Pro Hac Vice*
Erin Beaton, Reg. No. 79,218

ALSTON & BIRD LLP
Vantage South End
1120 South Tryon Street, Suite 300
Charlotte, NC 28203-6818
Phone: 704.444.1000
Fax: 704.444.1111

E-mail: apple-alivecor-ndcal@alston.com

/Crena Pacheco/
Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street
Minneapolis, MN 55402
pacheco@fr.com