IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Ammar Al-Ali	
U.S. Patent No.:	10,687,743	Attorney Docket No. 50095-0133IP2
Issue Date:	June 23, 2020	
Appl. Serial No.:	16/791,955	
Filing Date:	February 14, 2020	
Title:	PHYSIOLOGICAL MEASUREMENT DEVICES, SYSTEMS, AND METHODS	

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PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,687,743

Petitioner is filing two petitions challenging U.S. Patent No. 10,687,743 (the "'743 patent"), a first relying on Iwamiya as the primary reference ("Iwamiya Petition"; IPR2024-00241) and the second relying on Sarantos as the primary reference ("Sarantos Petition"; IPR2024-00242) challenging U.S. Patent No. 10,687,743 (the "'743 Patent"). Pursuant to the Board's July 2019 Trial Practice Guide Update, Petitioner submits this paper to "identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits…, and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions." Trial Practice Guide, 59-61.

I. Ranking of Petitions

Although Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary Reference	Claims
1	IPR2024-00241 ("Iwamiya Petition)	Iwamiya	1-25
2	IPR2023-00242 ("Sarantos Petition")	Sarantos	1, 3-14, 16-25

II. Factors Supporting Institution, Including Material Differences

Material differences exist between the petitions, which are non-redundant at least in their reliance on different combinations of references that demonstrate the obviousness of the Challenged Claims in materially different ways.

For example, IPR2024-00241 relies on Iwamiya, which expressly describes light shaping functionality, as its primary reference. The Iwamiya Petition further demonstrates that a POSITA would have modified Iwamiya to include both dark colored coating on its light shielding frame, and functionality for measuring blood oxygen saturation. In contrast, IPR2024-00242 relies on Sarantos, which expressly describes the dark colored coating and blood oxygen features, as its primary reference. The Sarantos Petition further demonstrates that a POSITA would have modified Sarantos to include one of multiple optical elements to provide "light diffusing and shaping advantages," such that a first shape of light is changed into a second shape. APPLE-1007, 6:61-7:7.

These distinct primary references, in combination with various secondary references, apply differently to the claims of the '743 Patent. Additionally, as demonstrated by Dr. Anthony's corroborated testimony, the motivations that a POSITA would have had for combining the distinct sets of references presented in the two petitions materially differs. The petitions are not redundant, duplicative, or substantially similar. Rather, each petition compellingly demonstrates the unpatentability of the Challenged Claims, without repeating the same theory.

Further, the two petitions approach the claims in different ways. For example, in the Iwamiya Petition, the primary reference (Iwamiya) discloses a configuration in which "the one or more emitters are positioned outside the light

block and the plurality of detectors are positioned inside the light block." APPLE-1001, claim 2. Such a configuration is not disclosed in Sarantos and thus claim 2 is not addressed in the Sarantos Petition.

Additionally, compelling merits justify institution of both IPR petitions. As explained in the petitions and evidenced by the progress of IPR proceedings addressing related patents, the prior art challenges presented in the petitions and the related evidence plainly demonstrate that each petition would yield unpatentability of the challenged claims by a preponderance of the evidence. Efficiencies and public policy concerns therefore warrant PTAB consideration of both petitions, which would prevent the unjust result of otherwise strong invalidity grounds being dismissed for procedural reasons. In addition, to simplify the complexity of the proceedings, Apple requests consolidation of the two proceedings, as permitted by 35 U.S.C. §§ 315(d) and 325(d).

III. Institution of Both Petitions Would not Unduly Burden the Board or Masimo, and is More Than Justified in View of Masimo's Prosecution Practices and Related Proceedings

The majority of the references applied in both the Iwamiya Petition and the Sarantos Petition are familiar to Masimo and the Board based on earlier PTAB proceedings that led to findings of unpatentability for every challenged claim of the related '695 Patent, and the Board's ongoing review of the related U.S. Pat. No. 10,687,745 (the "'745 patent") based on Iwamiya-based and Sarantos-based

grounds. *See Apple Inc. v. Masimo Corp.*, IPR2020-01722 Pap. 28, 26 (PTAB May 5, 2022); *Apple Inc. v. Masimo Corp.*, IPR2022-01291 Pap. 15, 23 (PTAB Feb.1, 2023).

Indeed, given the strong similarities between the ’743 Patent claims and the U.S. Pat. No. 10,470,695 (the “’695 patent”) claims previously invalidated in IPR, and between the ’743 Patent claims and the ’745 Patent claims that are currently subject to instituted/ongoing IPR proceedings, consideration of the challenges raised in the IPR2024-00241 and IPR2024-00242 petitions would present no undue burden to the Board or to Masimo. Further, to minimize any potential burden from instituting two petitions challenging the ’743 Patent, Petitioner has similarly applied the same secondary references (Han and Utter) in the same manner with respect to features of many of the challenged claims, including two of the independent claims (claims 14 and 22).

Far from representing a burden, institution of both petitions would allow the Board to efficiently address issues of invalidity arising from Masimo’s collateral prosecution of the application that issued as the ’743 Patent, which Masimo filed with a request for accelerated examination slightly more than one month after Masimo initiated its serial litigation campaign against Apple, and approximately six months after Apple filed the IPRs leading to the Board’s findings of unpatentability with respect to the related ’695 Patent.

Similar to IPR2022-01291 and IPR2022-01465, which address the related ’745 Patent on the basis of highly similar grounds, two petitions are needed to present the distinct and compelling grounds presented in the Iwamiya Petition and the Sarantos Petition, which due to word count constraints and the number of claims challenged (all 25 claims in the Iwamiya Petition and 23 out of 25 claims in the Sarantos Petition), could not have been presented together within a single petition.

Further, Apple’s presentation of two petitions in no way constitutes an “abuse”, and instead results from Masimo’s practice of forging forward, despite earlier IPR results, with prosecution of claims directed toward unpatentable subject matter, with the apparent aim of assertion. The present situation is the mirror image of situations in which a Petitioner attempts to take multiple bites at the apple by presenting duplicative prior art grounds relying on myriad references. Of course, this is not the present circumstance, as Apple presents two petitions relying on two different primary references that are well known to the Board and to Masimo, in a manner that should minimize the number of issues to be addressed, assuming institution of both petitions.

For at least these reasons, Petitioner respectfully submits that institution of both petitions is more than justified, and respectfully requests that the Board institute trial on both petitions.

Respectfully submitted,

Dated: December 12, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on December 12, 2023, a complete and entire copy of this Notice Ranking Petitions was provided via Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

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