

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Bilal Muhsin, et al.
U.S. Patent No.: 10,736,507 Attorney Docket No. 50095-0135IP1
Issue Date: August 11, 2020
Appl. Serial No.: 15/880,071
Filing Date: January 25, 2018
Title: PHYSIOLOGICAL MONITOR WITH MOBILE COMPUTING
DEVICE CONNECTIVITY

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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR POST-GRANT REVIEW OF
U.S. PATENT NO. 10,736,507**

Petitioner is filing two petitions challenging U.S. Patent No. 10,736,507 (the “’507 Patent”), one relying on Bailey as the primary reference (“Bailey Petition”; IPR2024-00293; 50095-0135IP1) and one relying on Mendelson as the primary reference (“Mendelson Petition”; IPR2024-00294; 50095-0135IP2).

I. Ranking of Petitions

Although each Petition is meritorious and justified, as required, Petitioner requests their consideration in the following order:

Rank	Petition	Primary Reference	Claims
1	IPR2024-00294	Mendelson	1-20
2	IPR2024-00293	Bailey	1-20

II. Material Differences that Compel Permitting Multiple Petitions

The primary references in each of the Petitions are non-patent literature (“NPL”s). That is, while Bailey and Mendelson both qualify as printed publications that were publicly available prior to the priority date of the ’507 patent (as discussed in the Petitions), they are not issued patents or patent publications. It is therefore necessary to establish that Bailey and Mendelson were publicly available prior to the priority date of the ’507 patent. While Petitioner believes that it has provided sufficient evidence to demonstrate that both Bailey and Mendelson qualify as prior art, the public availability of each reference rests on a different set of facts supported by different sets of evidence.

For example, Mendelson was published by IEEE, a well-known publisher of scientific papers in the relevant art that allowed its members to search for and identify such papers using, for example, keyword searching of the IEEE archives. Mendelson Petition, APPLE-1012, ¶¶8-11; APPLE-1011, 1; APPLE-1003, ¶¶39-40. Because Mendelson was published by a well-known, established publisher, Petitioner submits that the publication status of Mendelson is presumed, and yet, open to contest and debate. *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065-66 (Fed. Cir. 2020) (“When there is an established publisher there is a presumption of public accessibility as of the publication date.”)

By contrast, Bailey is an undergraduate student thesis submitted as part of the Inter disciplinary Engineering Design Program at the University of Arizona. While Petitioner believes that it has provided more than sufficient evidence to establish that Bailey was publicly available prior art, the fact that it was made available by a university rather than published by an established publisher in the industry (as is the case with Mendelson) changes the nature of challenges that may be made to the publication status and thus prior art qualification of Bailey.

Importantly, the Patent Owner is not limited to arguing against public availability prior to institution. If either of the Mendelson or Bailey Petition were to be denied institution under the Board’s discretion, Patent Owner thereafter first raise arguments that it reserves related to the public availability of Bailey or

Mendelson, and if successful on such arguments, this would leave Petitioner with no ability to have the publication status of the art advanced in the denied Petition considered, despite Petitioner having submitted two Petitions subject to different legal tests on public availability of corresponding/implicated primary references.

Further to this point, Mendelson qualifies as prior art under Pre-AIA §102(b) by several years and cannot be sworn behind. By contrast, despite the existence of evidence highlighted in the Petition, which establishes that Bailey is prior art under Pre-AIA §102(a), Bailey is not subject to Pre-AIA §102(b), rendering it subject to different legal standards and potential defenses (e.g., swear behind).

In light of these important legal differences and attendant options for Patent Owner defenses (which do not need to be employed until after institution), and, as a matter of policy, Petitioner should not be denied an opportunity to have considered by the PTAB the best available prior art on various applicable legal standards, when applicable, as here. Indeed, while Petitioner believes that both the Mendelson based grounds and the Bailey based grounds fully provide all elements of the challenged claims, based on reasoned and well-articulated support offered by the Petitions, it notes that Bailey offers additional details that may be helpful to inform an inquiry on patentability. For example, Bailey provides a detailed and comprehensive survey of the state of the art with respect to pulse oximetry during

the relevant time frame. More, Bailey provides significant detail and abundant examples of various aspects of the pulse oximetry systems described therein.

Petitioner should not be forced to forego the detailed disclosure of Bailey due to the above described concerns regarding public availability or the possibility of a swear-behind defense. Imposing such a requirement on petitioners would be contrary to Congressional intent, as it would prevent strong prior art references from being brought before the Patent Office for fear of petitions being denied due to non-merit issues, severely limiting the ability of the public to ensure that deficient patents are not allowed to remain enforceable.

III. Institution of Both Petitions Would Not Be an Undue Burden on the Board

In an effort to minimize the burden of institution of two petitions, Petitioner has purposefully used the same secondary references in the same manner with respect to the same claims in the two petitions. This similarity includes substantially similar motivations to combine these secondary references with the respective primary references. This overlap in secondary references and analysis greatly reduces the burden of instituting both petitions is in that both proceedings are likely to focus on the same arguments with respect to the secondary references.

These Petitions are far from the “abuse” or “repeated attacks” feared in the *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha* decision. IPR2016-01357,

Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential). The present situation is also unlike situations in which Petitioners take multiple bites at the apple by presenting duplicative prior art based grounds relying on myriad different primary and secondary references. In contrast to such scenarios, here, Petitioner frames in its two petitions grounds that rely on just two different primary references (for the above discussed reasons) in combination with the same secondary references across both petitions, to minimize the number of potential issues.

Additionally, the strong merits justify institution of both IPR Petitions. Efficiencies and public policy concerns warrant PTAB consideration of both Petitions. Institution of both IPR petitions would prevent the unjust result of otherwise strong invalidity grounds being dismissed for procedural reasons. In addition, Petitioner requests consolidation of the two proceedings, as permitted by 35 U.S.C. §§ 315(d) and 325(d) to simplify the complexity of the proceedings.

This is not a situation where Petitioner has filed many IPR petitions against one patent or is asserting dozens of independent grounds. Rather, Petitioner has filed only two petitions, with each relying on the same set of secondary references. Given the number of claims asserted in litigation by Patent Owner, instituting two petitions is reasonable.

For at least these reasons, Petitioner 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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