



What's Next for Masimo v Apple?

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After a series of twists and turns, the patent dispute between [Apple](#) and [Masimo](#) regarding certain Apple Watch models is still far from an eventual resolution.

On January 17, the Federal Circuit [lifted an interim stay](#) of the US International Trade Commission's (ITC) remedial orders prohibiting importation and sales of certain infringing Apple watches and refused to grant a broader stay pending Apple's appeal at the Federal Circuit.

This article reviews the procedural history up to this point and looks at what's next—for the parties and IP rights stakeholders more broadly.

Dispute recap

Masimo holds several patents relating to light-based pulse oximetry technology—measurement of the oxygen level in blood. Masimo sued Apple at the ITC, contending that certain Apple Watch models contain pulse oximetry features that infringe several Masimo's pulse oximetry patents.

The ITC found that two Apple Watch models—Series 9 and Ultra 2—infringe two Masimo patents. On [October 26, 2023](#), the ITC issued a limited exclusion order that bans Apple from importing its infringing products into the United States. The ITC also issued a cease-and-desist order preventing Apple from disseminating and selling its existing inventory of the infringing products.

These orders, collectively called remedial orders, are an example of the injunctive relief to patent owners typically available at the ITC, which has made the ITC an attractive forum for patent owners. That is unlike district courts, which in the past couple of decades have issued relatively few injunctions.

Before the ITC's remedial orders became final on December 26, Apple stopped selling the infringing products.

Apple appealed the remedial orders and asked the Federal Circuit to stay (put on hold) enforcement of them pending the appeal. Apple also filed an emergency motion for an interim stay while the Federal Circuit considered the motion for a stay pending appeal. On December 27, 2023, the Federal Circuit [granted](#) the interim stay. Apple then resumed sales of its Series 9 and Ultra 2 Watches.

Meanwhile, Apple redesigned its infringing products to remove pulse oximetry functionality. On January 12, US Customs and Border Protection [found](#) that Apple's redesigned products fall outside the scope of the remedial orders.

On January 17, the Federal Circuit [denied](#) Apple's request for a stay pending appeal, and lifted the interim stay. The court's denial of the stay request forced Apple to again stop importing and selling the Series 9 and Ultra 2 Watches.

What's next?

After all of this legal manoeuvring, Masimo and Apple have several options. The ITC's remedial orders are in effect, meaning that Apple cannot import Series 9 and Ultra 2 Watches or sell its existing inventory of those models.

On the other hand, Apple can import and sell its redesigned products—but they do not contain pulse oximetry functionality. Apple may wait to find out the outcome of the appeal. Or the parties may settle their dispute before the Federal Circuit issues a decision.

The appeal at the Federal Circuit will run its course—which typically takes 15-18 months—unless the parties reach a settlement. The Federal Circuit's order denying Apple's request for a stay pending appeal does not shed much light on the ultimate outcome of the appeal.

One of the four factors the court considered is whether Apple has made a strong showing of the likelihood of winning the appeal. In its order, the court mentioned that factor but stated it reached no conclusion on the merits of the appeal.

Apple's [motion for the interim stay](#) (which was granted and later lifted) mentions a few issues that the appeal will likely cover. In its motion, Apple argued that there are several grounds for reversing the ITC's remedial orders, including: 1) whether Masimo met the ITC's domestic industry requirement; 2) whether certain prior art invalidates Masimo's patents; and 3) whether Masimo waited too long to prosecute its patent applications. If the appeal runs its course, the parties will likely elaborate on these issues.

This dispute is a reminder to other IP rights stakeholders that the threat of remedial orders at the ITC can be a powerful tool for patent owners. After the 2006 case of [eBay v MercExchange](#), the number of injunctions granted by district courts dropped precipitously.

Remedial orders at the ITC can quickly force an infringer to halt the importation and sales of infringing products and redesign products to remove patented features.

For the time being, Apple can only import and sell redesigned products that lack the patented pulse oximetry features, and it remains to be seen exactly how much the parties really value that feature.

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