

Filed: July 28, 2021

Filed on behalf of:

Patent Owner Masimo Corporation
By: Joseph R. Re (Reg. No. 31,291)
Jarom D. Kesler (Reg. No. 57,046)
Joshua J. Stowell (Reg. No. 64,096)
Stephen W. Larson (Reg. No. 69,133)
Jacob L. Peterson (Reg. No. 65,096)
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: AppleIPR2020-1523-703@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

Case IPR2020-01523
U.S. Patent 8,457,703

PATENT OWNER RESPONSE

TABLE OF CONTENTS

	Page No.
I. INTRODUCTION	1
II. MASIMO’S PIONEERING TECHNOLOGY	5
A. The ’703 Patent	5
B. Introduction To The Independent Claims	12
C. Prosecution Of The ’703 Patent	14
III. PETITIONER’S REFERENCES	15
IV. LEVEL OF ORDINARY SKILL IN THE ART	16
V. LEGAL STANDARDS	17
VI. CLAIM CONSTRUCTION	19
A. “Reducing/Reduce Activation Of An Attached Sensor”	19
B. “Processing Characteristics”	21
1. Petitioner Failed To Construe “Processing Characteristics”	21
2. Construction Of “Processing Characteristics”	23
VII. GROUND 1A FAILS TO DEMONSTRATE OBVIOUSNESS	27
A. Overview Of Diab	27
B. Overview Of Amano	28
C. Petitioner Fails to Show That A POSITA Would Have Modified Diab To Operate At Lower And Higher Power Consumption Levels Based On Amano	29

TABLE OF CONTENTS
(cont'd)

	Page No.
1. Overview Of The Deficiencies In Petitioner’s Argument	30
2. A POSITA Would Not “Suspend And Not Execute” Diab’s Motion Artifact Suppression Module	33
3. A POSITA Would Not Have Been Motivated To Combine Diab And Amano	41
4. Petitioner Fails To Show That Suspension Of Diab’s Motion Artifact Suppression Module Would Result In Lower Power Consumption Levels	45
D. Diab And Amano Do Not Disclose Or Suggest Comparing “Processing Characteristics To A Predetermined Threshold”	48
E. Diab And Amano Do Not Disclose Or Suggest Reducing An Amount Of Processing By A Signal Processor	52
VIII. GROUND 1B FAILS TO DEMONSTRATE OBVIOUSNESS	55
IX. GROUND 1C FAILS TO DEMONSTRATE OBVIOUSNESS	56
A. Ground 1C Fails For The Same Reasons As Ground 1A	57
B. Overview Of Turcott	57
C. Petitioner Fails To Show That Turcott Discloses Or Suggests “Reducing/Reduce Activation Of An Attached Sensor” In Combination With The Other Claim Limitations.....	60

TABLE OF CONTENTS
(cont'd)

	Page No.
D. A POSITA Would Not Have Been Motivated To Combine Diab, Amano, And Turcott To Arrive At The Claimed Inventions.....	61
X. GROUNDS 2A-2C FAIL TO DEMONSTRATE OBVIOUSNESS.....	67
XI. GROUNDS 3A-3B FAIL TO SHOW OBVIOUSNESS	69
A. Petitioner Fails To Show That Amano Discloses Determining Measurement Values For One Or More Physiological Parameters	69
1. Petitioner Fails To Address All Elements In Limitation 9[c]	70
2. Amano Does Not Determine Measurement Values.....	71
B. Petitioner Admits That Amano Does Not Compare “Processing Characteristics” To A Predetermined Threshold.....	73
C. Petitioner Fails To Show That Turcott Discloses Or Suggests “Reducing/Reduce Activation Of An Attached Sensor” In Combination With The Other Claim Limitations.....	75
XII. CONCLUSION.....	79

TABLE OF AUTHORITIES

Page No(s).

<i>Eon Corp. IP Holdings v. Silver Spring Networks, Inc.</i> , 815 F.3d 1314 (Fed. Cir. 2016)	20
<i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984)	18
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016)	17, 18, 51, 71
<i>In re Kotzab</i> , 217 F.3d 1365 (Fed. Cir. 2000)	18
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	18
<i>In re Magnum Oil Tools, Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	17, 18
<i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011)	19
<i>Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.</i> , 520 F.3d 1358 (Fed. Cir. 2008)	18
<i>OrthoPediatrics Corp. v. K2M, Inc.</i> , Case IPR2018-01548, Paper 9 (March 1, 2019).....	21, 23
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	24
<i>Schering Corp. v. Geneva Pharms., Inc.</i> , 339 F.3d 1373 (Fed. Cir. 2003)	51
<i>Star Sci., Inc. v. R.J. Reynolds Tobacco Co.</i> , 655 F.3d 1364 (Fed. Cir. 2011)	18

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.