

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

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Case IPR2020-01526

U.S. Patent 6,771,994

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**PETITIONER'S REPLY TO PATENT OWNER RESPONSE**

## TABLE OF CONTENTS

I.	INTRODUCTION .....	1
II.	GROUND 1 ESTABLISHES OBVIOUSNESS .....	1
	A. Diab explicitly discloses removing the scattering medium from its photodetector, which is consistent with the proposed combination .....	1
	B. Adding the light control film over Diab’s photodetector would reduce the amount of ambient light reaching the photodetector .....	2
	C. Masimo’s argument regarding the results of the Diab-Benjamin-Melby combination lacking predictability fails .....	2
III.	GROUND 2 ESTABLISHES OBVIOUSNESS .....	4
	A. Masimo’s arguments mischaracterize Webster’s disclosure of placing a light filter over the photodetector to minimize the effects of ambient light .....	4
IV.	GROUND 3 ESTABLISHES OBVIOUSNESS .....	5
	A. Masimo’s arguments regarding the complexity and price of Fine’s design are irrelevant .....	5
	B. Fine’s bundles of optical fibers teach or suggest the claimed “plurality of louvers” .....	6
V.	GROUND 4 ESTABLISHES OBVIOUSNESS .....	8
	A. Masimo mischaracterizes the proposed combination .....	8
VI.	CONCLUSION.....	9

## EXHIBITS

APPLE-1001	U.S. Patent No. 6,771,994
APPLE-1002	File History for U.S. Patent No. 6,771,994
APPLE-1003	Declaration of Dr. Anthony
APPLE-1004	Reserved
APPLE-1005	Masimo Corporation, et al. v. Apple Inc., Complaint, Civil Action No. 8:20-cv-00048 (C.D. Cal.)
APPLE-1006	U.S. Patent No. 5,638,818 (“Diab”)
APPLE-1007	U.S. Patent No. 4,015,595 (“Benjamin”)
APPLE-1008	U.S. Patent No. 5,254,388 (“Melby”)
APPLE-1009	WO Pub. No. 1996/41566 (“Fine”)
APPLE-1010	Excerpts from Design of Pulse Oximeters, J.G. Webster; Institution of Physics Publishing, 1997 (“Webster”)
APPLE-1011	Tremper, Pulse Oximetry, Anesthesiology, The Journal of the American Society of Anesthesiologists, Inc., Vol. 70, No. 1 (January 1989) (“APPLE-1011”)
APPLE-1012	Mendelson, Skin Reflectance Pulse Oximetry: In Vivo Measurements from the Forearm and Calf, Journal of Clinical Monitoring, Vol. 7, No. 1 (January 1991) (“APPLE-1012”)
APPLE-1013	Excerpts from Bronzino, The Biomedical Engineering Handbook, CRC Press, Inc. (1995) (“APPLE-1013”)
APPLE-1014	Konig, Reflectance Pulse Oximetry – Principles and Obstetric Application in the Zurich System, Journal of Clinical Monitoring, Vol. 14, No. 6 (August 1998) (“APPLE-1014”)

APPLE-1015 Declaration of Jacob Munford

APPLE-1016 to 1030 Reserved

APPLE-1031 Scheduling Order, Masimo v. Apple et al., Case 8:20-cv-00048, Paper 37 (April 17, 2020)

APPLE-1032 Stipulation by Apple

APPLE-1033 Telephonic Status Conference, Masimo v. Apple et al., Case 8:20-cv-00048, Paper 78 (July 13, 2020)

APPLE-1034 Joseph Guzman, “Fauci says second wave of coronavirus is ‘inevitable’”, TheHill.com (Apr. 29, 2020), available at: <https://thehill.com/changing-america/resilience/natural-disasters/495211-fauci-says-second-wave-of-coronavirus-is>

APPLE-1035 “Tracking the coronavirus in Los Angeles County,” LATimes.com (Aug. 20, 2020), available at <https://www.latimes.com/projects/california-coronavirus-cases-tracking-outbreak/los-angeles-county/>

APPLE-1036 Reserved

APPLE-1037 Order Regarding Motion to Stay (Redacted) in Masimo Corporation et al. v. Apple Inc., Case 8:20-cv-00048, October 13, 2020

APPLE-1038 Deposition Transcript of Dr. Vijay Madiseti

## **I. Introduction**

Apple Inc. (“Petitioner” or “Apple”) submits this Reply to Patent Owner’s Response (“POR”) to the Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 6,771,994 (“the ’994 patent”) filed by Masimo Corporation (“Patent Owner” or “Masimo”). As demonstrated below with reference to evidence including Dr. Anthony’s testimony, the POR fails to address, much less rebut, positions advanced in the Petition. Accordingly, Apple respectfully submits that the Board should find claim 15 (“the Challenged Claim”) of the ’994 patent unpatentable.

## **II. Ground 1 Establishes Obviousness**

### **A. Diab explicitly discloses removing the scattering medium from its photodetector, which is consistent with the proposed combination**

Masimo argues that a POSITA would have had no reason to perform the combination of Diab, Benjamin, and Melby. *See* POR, 28-33. In particular, Masimo argues that “neither Apple nor the Board explains why a POSITA explicitly seeking to scatter light as the critical teaching of Diab would make modifications to eliminate this core feature and cause the light to be uniform in direction.” *See id.*, 30-31. Masimo argues that this purportedly “critical teaching” of Diab is its “scattering medium...interposed between the” user tissue “and the photodetector,” which the Petition proposes replacing in the combination. *See id.*, 29-31; APPLE-1006, 4:8-10. But Diab explicitly discloses examples in which the scattering medium is “interposed” only “between the light source and the” the user

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