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Filed on behalf of:

Patent Owner Masimo Corporation
By: Joseph R. Re (Reg. No. 31,291)
Stephen W. Larson (Reg. No. 69,133)
Jarom D. Kesler (Reg. No. 57,046)
Jacob L. Peterson (Reg. No. 65,096)
William R. Zimmerman (admitted *pro hac vice*)
Jeremiah S. Helm, Ph.D. (admitted *pro hac vice*)
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: AppleIPR2020-1538-554@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

Case IPR2020-01538
U.S. Patent 10,588,554

PATENT OWNER RESPONSE

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<i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011)	12
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<i>Pers. Web Techs. v. Apple, Inc.</i> , 848 F.3d 987,994 (Fed. Cir. 2017)	42, 43
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