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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

IPR2020-01713

Patent 10,624,564

PATENT OWNER RESPONSE



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TABLE OF AUTHORITIES

Page No(s).

OTHER AUTHORITIES	
Star Sci., Inc. v. R.J. Reynolds Tobacco Co., 655 F.3d 1364 (Fed. Cir. 2011)	
In re Royka, 490 F.2d 981 (C.C.P.A. 1974)	
Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	7
Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc., 520 F.3d 1358 (Fed. Cir. 2008)	9
In re NTP, Inc., 654 F.3d 1279 (Fed. Cir. 2011)	9
<i>In re Kotzab</i> , 217 F.3d 1365 (Fed. Cir. 2000)	8
In re Gordon, 733 F.2d 900 (Fed. Cir. 1984)	9
In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992)	46
DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 567 F.3d 1314 (Fed. Cir. 2009)	38
CFMT, Inc. v. YieldUp Int'l Corp., 349 F.3d 1333 (Fed. Cir. 2003)	8
ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc., 694 F.3d 1312 (Fed. Cir. 2012)	8



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