

Filed July 23, 2021

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)

KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 Main Street, 14th Floor

Irvine, CA 92614

Tel.: (949) 760-0404 Fax: (949) 760-9502

E-mail: AppleIPR2020-1714-765@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

IPR2020-01714

U.S. Patent 10,631,765

PATENT OWNER RESPONSE

TABLE OF CONTENTS

| | Page No. |
|--|----------|
| I. INTRODUCTION | 1 |
| II. MASIMO'S PIONEERING TECHNOLOGY | 5 |
| A. The '765 Patent Claims | 6 |
| B. Introduction To Independent Claims | 7 |
| C. The '765 Patent Prosecution | 9 |
| III. THE PETITION'S PROPOSED COMBINATIONS..... | 9 |
| IV. CLAIM CONSTRUCTION | 9 |
| V. LEVEL OF ORDINARY SKILL IN THE ART | 10 |
| VI. LEGAL STANDARD | 10 |
| VII. GROUND 1 FAILS TO DEMONSTRATE OBVIOUSNESS | 12 |
| A. Ground 1's Cited Art And Asserted Combination..... | 12 |
| 1. Petitioner's Combination Of Ohsaki And Mendelson '799..... | 12 |
| 2. Dr. Kenny's Erroneous Characterization Of Ohsaki | 17 |
| 3. Petitioner's Addition Of A Third Reference: Schulz | 19 |
| 4. Petitioner's Addition Of A Fourth Reference: Mendelson 2006..... | 21 |
| B. A POSITA Would Not Have Been Motivated To Combine Ohsaki's Board With Mendelson '799's Sensor..... | 22 |

TABLE OF CONTENTS
(Cont'd)

Page No.

| | | |
|----|--|----|
| 1. | A POSITA Would Have Understood That Ohsaki's Rectangular Board Is Incompatible With Mendelson '799's Radially Symmetric Sensor Arrangement..... | 23 |
| | a) Modifying Ohsaki's Rectangular Board Would Eliminate The Advantages Ohsaki Teaches | 23 |
| | b) A POSITA Would Not Have Been Motivated To Add A Rectangular Board To Mendelson '799's Circular Sensor | 29 |
| 2. | A POSITA Would Have Understood That Ohsaki's Required Measurement Location Would Result In Weak Signals For Mendelson '799's Oxygen Saturation Measurements..... | 32 |
| 3. | A POSITA Would Not Have Been Motivated To Reduce Optical Signal By Adding A Convex Lens To Mendelson '799's Sensor..... | 38 |
| | a) A POSITA Would Have Understood That A Convex Cover Directs Light To The Center Of The Sensor | 38 |
| | b) A POSITA Would Have Sought To Avoid The Air Gaps Introduced By Ohsaki's Rectangular Board..... | 43 |
| | c) A POSITA Would Not Have Selected A Convex Cover To Protect The Optical Elements | 45 |
| C. | A POSITA Would Not Have Been Motivated To Decrease Signal Strength From The Measurement Site With A Window Taught By Schulz | 47 |

TABLE OF CONTENTS
(Cont'd)

| | Page No. |
|---|-----------------|
| D. Petitioner’s Fourth Reference, Mendelson 2006, Further Undermines Petitioner’s Combination..... | 52 |
| E. The Petition Provides No Evidence Of An Expectation Of Success | 55 |
| F. The Challenged Dependent Claims Are Nonobvious Over Ground 1 | 56 |
| 1. The Challenged Dependent Claims Are Not Obvious For At Least The Same Reasons That The Independent Claims Are Not Obvious..... | 56 |
| 2. Claims 7 And 26, And Dependent Claims..... | 56 |
| 3. Claim 29..... | 59 |
| VIII. GROUND 2 FAILS TO DEMONSTRATE OBVIOUSNESS | 63 |
| IX. GROUND 3 FAILS TO DEMONSTRATE OBVIOUSNESS | 63 |
| X. GROUND 4 FAILS TO DEMONSTRATE OBVIOUSNESS | 63 |
| XI. CONCLUSION..... | 64 |

TABLE OF AUTHORITIES

Page No(s).

| | |
|---|--------|
| <i>ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012) | 11 |
| <i>CFMT, Inc. v. YieldUp Int'l Corp.</i> , 349 F.3d 1333 (Fed. Cir. 2003) | 10 |
| <i>In re Fritch</i> , 972 F.2d 1260 (Fed. Cir. 1992) | 56 |
| <i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984) | 11 |
| <i>InTouch Techs., Inc. v. VGO Commc'ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014) | 42 |
| <i>In re Kotzab</i> , 217 F.3d 1365 (Fed. Cir. 2000) | 11 |
| <i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011) | 12 |
| <i>Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.</i> , 520 F.3d 1358 (Fed. Cir. 2008) | 11 |
| <i>Pers. Web Techs. v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017) | 42, 43 |
| <i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (<i>en banc</i>) | 10 |
| <i>In re Royka</i> , 490 F.2d 981 (C.C.P.A. 1974) | 11 |
| <i>Star Sci., Inc. v. R.J. Reynolds Tobacco Co.</i> , 655 F.3d 1364 (Fed. Cir. 2011) | 11 |

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.