Filed September 8, 2021

On behalf of:
Patent Owner Masimo Corporation
By: Joseph R. Re (Reg. No. 31,291)
Jarom D. Kesler (Reg. No. 57,046)
Stephen W. Larson (Reg. No. 69,133)
Jacob L. Peterson (Reg. No. 65,096)
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel.: (949) 760-0404
E-mail: AppleIPR2021-0208-266@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

IPR2021-00208
Patent 10,258,266

PATENT OWNER RESPONSE

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

Page No.

I. INTRODUCTION 1

II. MASIMO'S PIONEERING TECHNOLOGY 4

A. The '266 Patent 4

B. Introduction To Independent Claims 6

C. The '266 Patent Prosecution 7

D. Petitioner's Challenge To Priority Date Of Claimed Subject Matter 8

III. THE PETITION'S PROPOSED COMBINATIONS 9

IV. CLAIM CONSTRUCTION 10

V. LEVEL OF ORDINARY SKILL IN THE ART 10

VI. LEGAL STANDARD 11

VII. GROUNDS 1A-1B DO NOT ESTABLISH OBVIOUSNESS 12

A. Introduction To Ground 1A 12

1. Aizawa Uses Peripheral Detectors Around A Single Centrally Located LED 12

2. Inokawa Uses Peripheral LEDs Around A Single Centrally Located Detector 14

3. Petitioner's Proposed Combination Of Aizawa And Inokawa 15

B. Ground 1A Does Not Establish Obviousness 16

1. A POSITA Would Not Have Been Motivated To Combine Inokawa's Lens With Aizawa's Sensor 16

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS
(*cont'd*)

Page No.

a) Petitioner Admits Inokawa's Lens Directs Light To The Center Of The Sensor 16

b) A POSITA Would Not Have Been Motivated To Direct Light Away From Aizawa's Detectors And Would Have No Reasonable Expectation Of Success When Doing So 20

c) Dr. Kenny's New Opinions Are Improper, Contradict His Declaration And Undermine Petitioner's Obviousness Challenge 24

d) Petitioner's Obviousness Challenge Also Improperly Relies On References Not Identified As Part Of Ground 1A Without An Articulated Motivation To Combine Or Expectation Of Success 34

2. Petitioner Identifies No Credible Basis To Add A Second LED To Aizawa 37

C. The Remaining Challenged Dependent Claims Are Nonobvious Over Ground 1A 43

D. Ground 1B Fails For The Same Reason As Ground 1A And For Additional Reasons 43

1. Ohsaki Does Not Fix The Problems With Petitioner's Proposed Combination 44

2. A POSITA Would Have Understood That Ohsaki's Board Would Not Prevent Slippage With Aizawa's Sensor 44

E. The Challenged Dependent Claims Are Nonobvious Over Ground 1B 46

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS
(*cont'd*)

Page No.

VIII. GROUND 2 DOES NOT ESTABLISH OBVIOUSNESS 47

A. Introduction To Ground 2 47

1. Mendelson-1988 Uses Detectors Around Centrally Located LEDs 47

2. Petitioner's Proposed Combination Of Mendelson-1988 And Inokawa 48

B. Ground 2 Does Not Establish Obviousness 49

1. There Would Have Been No Motivation To Combine And No Reasonable Expectation Of Success 49

2. Petitioner's Proposed Ground 2 Combination Does Not Include The Claimed Cover (Claim 9) 52

3. Mendelson-1988 And Inokawa Do Not Have A "Circular Housing" With A "Cover" (Claim 9) 53

4. The Petition Improperly Relies On References Not Identified As Part Of Ground 2 With No Analysis Of Any Motivation To Combine 55

C. The Challenged Dependent Claims Are Nonobvious Over Ground 2 57

IX. CONCLUSION 57

DOCKET ALARM

Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF AUTHORITIES

Page No(s).

ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.,
694 F.3d 1312 (Fed. Cir. 2012) 11

CFMT, Inc. v. YieldUp Int'l Corp.,
349 F.3d 1333 (Fed. Cir. 2003) 11

In re Fritch,
972 F.2d 1260 (Fed. Cir. 1992) 43, 46, 57

In re Gordon,
733 F.2d 900 (Fed. Cir. 1984) 12

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.,
821 F.3d 1359 (Fed. Cir. 2016) 9, 35

InTouch Techs., Inc. v. VGo Commc'ns, Inc.,
751 F.3d 1327 (Fed. Cir. 2014) 54

K/S HIMPP v. Hear-Wear Techs., LLC,
751 F.3d 1362 (Fed. Cir. 2014) 56

In re Kotzab,
217 F.3d 1365 (Fed. Cir. 2000) 11

In re NTP, Inc.,
654 F.3d 1279 (Fed. Cir. 2011) 12

Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.,
520 F.3d 1358 (Fed. Cir. 2008) 12

Personal Web Techs., LLC v. Apple, Inc.,
848 F.3d 987 (Fed. Cir. 2017) 29, 31

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) (*en banc*) 10

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.