

Filed: May 26, 2023

Filed on behalf of:

Patent Owner Masimo Corporation
By: Brian C. Claassen (Reg. No. 63,051)
Carol Pitzel Cruz (Reg. No. 61,224)
Daniel Kiang (Reg. No. 79,631)
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: AppleIPR745-1@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2022-01291
U.S. Patent 10,687,745

PATENT OWNER RESPONSE

TABLE OF CONTENTS

Page No.

I.	INTRODUCTION	1
II.	BACKGROUND	5
A.	Overview of the Technology.....	5
B.	The Industry Recognized Masimo’s Excellence in Physiological Monitoring.....	6
C.	The ’745 Patent	7
D.	Level of Ordinary Skill in the Art.....	10
III.	CLAIM CONSTRUCTION	11
IV.	FOUNDATIONS 1A AND 1B FAIL TO ESTABLISH OBVIOUSNESS.....	17
A.	Apple Fails to Demonstrate that Claims 9 and 18, Which Require Measuring Oxygen Saturation at the Wrist, Would Have Been Obvious.....	17
1.	Iwamiya and Sarantos Do Not Disclose Oxygen Saturation Measurements.....	18
2.	A POSITA Would Not Have Combined Iwamiya and Sarantos	21
3.	Apple Fails to Demonstrate a Reasonable Expectation of Success in Measuring Oxygen Saturation at the Wrist	28
4.	The Testimony of Apple’s Engineers and Its Development Documents Confirm that a POSITA	

TABLE OF CONTENTS
(cont'd)

	Page No.
Would Not Have Reasonably Expected Success in Measuring Oxygen Saturation at the Wrist.....	30
5. Apple “Supplemental Information” Cannot Demonstrate a Reasonable Expectation of Success.....	40
B. Apple Fails to Demonstrate Multiple Elements of Claims 20 and 27	42
C. A POSITA Would Not Have Been Motivated to Combine Iwamiya with Sarantos to Add a Second Wavelength (Claim 27).....	43
D. Apple Does Not Establish a Motivation for Adding a “surface comprising a dark-colored coating” to Iwamiya (Claims 1, 9, 20, 27).....	44
E. The Combination Does Not Disclose a Plurality of Photodiodes “arranged in an array having a spatial configuration corresponding to a shape of the portion of the tissue measurement site encircled by the light block” (Claims 15, 18).....	50
V. GROUND 2A AND 2B FAIL TO ESTABLISH OBVIOUSNESS.....	53
A. Apple Fails to Show a “First Shape” and a Different “Second Shape” (Claims 1, 9, 20, 27).....	54
B. Apple Fails to Demonstrate a Motivation to Combine Sarantos with Shie with a Reasonable Expectation of Success (All Challenged Claims).....	56
C. Apple Fails to Show that Measuring Oxygen Saturation at the Wrist Would Have Been Obvious (Claims 9, 18).....	64

TABLE OF CONTENTS
(cont'd)

	Page No.
D. Apple Failed to Identify a “light block having a circular shape” in the Proposed Combinations (Claims 15, 18)	64
E. Apple Did Not Address “wherein the plurality of photodiodes are arranged in an array having a spatial configuration ...” (Claims 15, 18)	66
VI. CONCLUSION.....	67

TABLE OF AUTHORITIES

Page No(s).

<i>Arendi S.A.R.L. v. Apple Inc.</i> , 832 F.3d 1355 (Fed. Cir. 2016)	53
<i>Bicon, Inc. v. Straumann Co.</i> , 441 F.3d 945 (Fed. Cir. 2006)	12
<i>Chemours Co. FC, LLC v. Daikin Indus.</i> , 4 F.4th 1370 (Fed. Cir. 2021)	28
<i>In re Gurley</i> , 27 F.3d 551 (Fed. Cir. 1994)	27
<i>Handi Quilter, Inc. v. Bernina Int’l AG</i> , IPR2013-00364, Paper 30 (PTAB June 12, 2014)	41
<i>Interconnect Planning Corp. v. Feil</i> , 774 F.2d 1132 (Fed. Cir. 1985)	31
<i>Kinetic Concepts, Inc. v. Smith & Nephew, Inc.</i> , 688 F.3d 1342 (Fed. Cir. 2012)	50
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	45, 65
<i>Laboratoire Francais Du Fractionnement et des Biotechnologies S.A.</i> <i>v. Novonordisk Healthcare AG</i> , IPR2017-000028, Paper 22 (PTAB June 13, 2017)	41
<i>Mallinckrodt, Inc. v. Masimo Corp.</i> , No. 2:00-cv-06506, 2004 U.S. Dist. LEXIS 28518 (C.D. Cal. 2004), <i>aff’d in part and rev’d in part, reh’g en banc denied</i> , 147 F. App’x 158 (Fed. Circ. 2005), <i>cert. dismissed</i> , 546 U.S. 1162 (2006).....	7

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.