UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

Case IPR2022-01299
U.S. Patent 7,761,127

DECLARATION OF JACK GOLDBERG

1. I, Jack Goldberg, am making this declaration at the request of Patent Owner Masimo Corporation ("Masimo") in the matters of the *Inter Partes* Review Nos. IPR2022-01299 and IPR2022-01300 of U.S. Patent No. 7,761,127 ("the '127 patent"). I understand that this declaration is being submitted in each of these proceedings as Exhibit 2051.

2. I am being compensated for my work in this matter at my standard hourly rate for consulting services. My compensation in no way depends on the outcome of this proceeding.

I. QUALIFICATIONS AND PROFESSIONAL BACKGROUND

3. I am an electrical engineer, and I have more than 45 years of experience working with various types of sensors, as well as the thermal management of electronic components, including sensors and components used in medical devices. Exhibit 2052 is a copy of my *curriculum vitae*.

4. I received my Bachelor of Science degree in Electrical Engineering and Computer Science from the Massachusetts Institute of Technology in 1973 and my Master of Science degree in the same field from MIT in 1978. From 1973 to 1984 I worked as an electrical engineer at various companies and on various technologies. From 1984 to 1995, when I was an engineer at a medical device company, IVAC Corporation, I worked extensively designing medical devices which incorporated

sensors, the processing of signals produced by sensors, and the calibration of such sensors. During that time, I also researched, and in some cases developed, other medical device technologies, including the non-invasive measurement of cardiac output, various technologies for non-contact determination of fluid flow rate, microwave sensing of fluid composition, non-invasive measurement of blood glucose, and both infrared and conventional clinical thermometers. In regard to projects at IVAC, heat flow and thermal management were of particular importance in the design and calibration of clinical thermometers and in the development of a unique technology for non-contact sensing of fluid flow. In 1995, I founded my present company, Metrionix, Inc., at which I have provided engineering and consulting services focusing on sensors, control, measurement, medical instrumentation, signal processing, RF technology, communications, audio, and acoustics. My consulting work has included research and development for medical instrument manufacturers and miniature human implantable devices and associated sensing means. As a result of my education and experience, I have expertise in the design of medical sensors and in the sensing, management, and control of thermal energy in various types of electromechanical systems, including medical devices.

II. RELEVANT LEGAL STANDARDS

5. I am an electrical engineer by training and profession. The opinions I express in this Declaration involve the application of my knowledge and experience

to the evaluation of the '127 patents and certain prior art to that patent. My knowledge of patent law is that of a lay person, albeit one who is an inventor on numerous issued U.S. patents and has consulted on patent infringement cases, and thus, has had some experience relevant to patent law. Therefore, counsel have provided me with guidance as to the applicable patent law in this matter. The paragraphs below express my understanding of the principles related to patentability that I must apply, and have applied, in conducting my analyses and reaching the opinions set forth in this Declaration.

6. I understand that, in assessing the patentability of a patent claim, the Patent Office generally construes claim terms by giving them their ordinary and customary meaning, as they would have been understood by a person of ordinary skill in the art ("POSITA") at the time of the invention in view of the intrinsic record (patent specification and file history). However, I understand that the inventors may, in the patent specification, expressly define a claim term to have a meaning that differs from the term's ordinary and customary meaning. I also understand that the inventors may disavow or disclaim certain claim scope, thereby departing from the ordinary and customary meaning, when the intrinsic record demonstrates that a clear and unambiguous disavowal or disclaimer has occurred. I understand that extrinsic evidence, such as relevant technical literature and dictionaries, may be useful in ascertaining how a POSITA would have understood a claim term, but the intrinsic

record is the primary source for determining the meaning of claim terms. For the purposes of this review, and to the extent necessary, I have interpreted each claim term in accordance with the principles set forth in this paragraph.

7. It is my understanding that a claim is unpatentable as "anticipated" under 35 U.S.C. § 102 if a single prior art reference discloses every limitation of the claim, arranged as in the claim. I understand that a prior art reference does not anticipate a claim, however, when it discloses multiple, distinct teachings that a person of ordinary skill in the art might somehow combine to achieve the claimed invention. I understand that anticipation has not been alleged in the Petition, and, thus, is not at issue in this proceeding.

8. I understand that a claim is unpatentable under 35 U.S.C. § 103 if the claimed subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time of the alleged invention. I also understand that an obviousness analysis takes into account the following factors, which are sometimes referred to as the *Graham* factors: (1) the scope and content of the prior art, (2) the differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art at the time of the invention, and (4) "objective indicia of non-obviousness," also referred to as secondary considerations of non-obviousness. Those objective indicia include considerations such as whether a product covered by the claims is commercially successful due to the merits of the claimed invention,

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