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: AppleIPR745-3@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_

BEFORE THE PATENT TRIAL AND APPEAL BOARD

\_\_\_\_

APPLE INC.,

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

Case IPR2022-01465

U.S. Patent 10,687,745

#### PATENT OWNER'S RESPONSE



### TABLE OF CONTENTS

## Page No.

I.	INTI	TRODUCTION			
II.	BACKGROUND4				
	A.	Overview of the Technology			
	B.	The Industry Recognized Masimo's Excellence in Physiological Monitoring			
	C.	The '745 Patent			
	D.	Level of Ordinary Skill in the Art			
III.	CLAIM CONSTRUCTION				
IV.	GROUNDS 1A AND 1B FAIL TO ESTABLISH OBVIOUSNESS				
	A.	Apple Does Not Establish a Motivation for Adding a "surface comprising a dark-colored coating" to Iwamiya (Claims 2-6, 8, 10-12, 14, 21-26)			
	В.	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 6, 17, 19, 26)			
	C.	Apple Fails to Demonstrate that Claim 2 Would Have Been Obvious			
		Iwamiya Teaches Away from Sarantos and the     Combination Would Be Inoperable			



## TABLE OF CONTENTS (cont'd)

Page No.

		2.	Sarantos Does Not Explain How to Successfully Use Red and Infrared Lights in Its Sensor	
		3.	A POSITA Would Not Have Reasonably Expected Success in Combining Iwamiya with Sarantos to Add Oxygen Saturation Measurements	
	D.	widtl	e Fails to Demonstrate "the second shape comprises a and a length, and wherein the width is different from ength" (Claim 25)	
V.	GRC	UNDS	S 2A-2C FAIL TO DEMONSTRATE OBVIOUSNESS 42	
	A.		e Fails to Show a "First Shape" and a Different ond Shape" (Claims 2-6, 8, 10-14, 19, 21-26)	
	B.	Sarai	e Fails to Demonstrate a Motivation to Combine ntos with Shie with a Reasonable Expectation of ess (All Challenged Claims)	
	C.	shap	e Fails to Identify a "light block having a circular e" in the Proposed Combinations (All Claims that end from 15)	
	D.		e Failed to Show that Claims 12 and 25 Would Have Obvious	
		1.	Apple Did Not Demonstrate that a Cylindrical Lens Would Result in a Second Shape with a Length and a Different Width (Claim 25)	
		2.	Apple Failed to Explain Why a POSITA Would Have Used a Cylindrical Lens (Claim 25)	



### TABLE OF CONTENTS (cont'd)

Page No.

		3. Apple Fails to Demonstrate a "Second Shape" Different than the "First Shape" for Claim 12	60
		4. Apple Failed to Explain a Motivation to Combine Sarantos, Shie, and Savant (Claim 12)	61
	Е.	Apple Failed to Demonstrate that the Plurality of Photodiodes Are in the Claimed Array (Claims 6, 17, 19, 26)	62
VI	CON	NCI LISION	64



### TABLE OF AUTHORITIES

Page No(s).

Arendi S.A.R.L. v. Apple Inc., 832 F.3d 1355 (Fed. Cir. 2016)
Bicon, Inc. v. Straumann Co., 441 F.3d 945 (Fed. Cir. 2006)
Chemours Co. FC, LLC v. Daikin Indus., 4 F.4th 1370 (Fed. Cir. 2021)
<i>In re Gurley</i> , 27 F.3d 551 (Fed. Cir. 1994)
Kinetic Concepts, Inc. v. Smith & Nephew, Inc., 688 F.3d 1342 (Fed. Cir. 2012)
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)
Mallinckrodt, Inc. v. Masimo Corp., No. 2:00-cv-06506, 2004 U.S. Dist. LEXIS 28518 (C.D. Cal. 2004), aff'd in part and rev'd in part, reh'g en banc denied, 147 F. App'x 158 (Fed. Circ. 2005), cert. dismissed, 546 U.S. 1162 (2006)
Masimo Corp v. Philips Elec. N. Am. Corp., No. 1:09-cv-00080, 2015 WL 2379485 (D. Del. May 18, 2015) 6, 7, 8
New Hampshire v. Maine, 532 U.S. 742 (2001)
O2 Micro Int'l v. Beyond Innovation Tech. Co. Ltd., 521 F.3d 1351 (Fed. Cir. 2008)
Personal Web Techs., LLC v. Apple, Inc., 848 F.3d 987 (Fed. Cir. 2017)



# DOCKET A L A R M

# 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.

