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Filed on behalf of:

Patent Owner Masimo Corporation
By: Brian C. Claassen (Reg. No. 63,051)
Carol Pitzel Cruz (Reg. No. 61,224)
Daniel C. 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 MOTION TO EXCLUDE

I. RELIEF REQUESTED

Pursuant to 37 C.F.R. §42.64(c) and the Board’s September 28, 2023 Order on Conduct of the Proceedings and Trial Hearing, Patent Owner Masimo Corporation (“Patent Owner” or “Masimo”) moves to exclude:

1. EX1009, EX1010, and EX1014-EX1016 as irrelevant;
2. Exhibits EX1039 and EX1041 as not authenticated;
3. EX1042, ¶31 for lack of foundation and/or as improper expert testimony;
4. EX1056 as not authenticated and/or irrelevant;
5. EX1042, ¶¶27, 31, 33-34, 40-50, and 61-64 as arguments that are improperly incorporated by reference into the Reply; and
6. EX1054, EX1058, and EX1063-1066 as irrelevant.

II. ARGUMENT

A. EX1009, EX1010, AND EX1014-EX1016 Are Irrelevant

EX1009, EX1010, and EX1014-EX1016 should be excluded as irrelevant (FRE 402). Patent Owner timely objected to these exhibits as irrelevant in its February 21, 2023 Objections to Evidence. Paper 19, 6. Apple submitted EX1009, EX1010, and EX1014-EX1016 with its Petition, but did not cite them for any purpose whatsoever in the Petition, Petitioner’s Reply, or in Petitioner’s expert’s declarations (EX1003, EX1042). Thus, they are irrelevant to any issue in this proceeding and are inadmissible. FRE 401; FRE 402.

B. Apple Did Not Authenticate EX1039 and EX1041

EX1039 and EX1041 are inadmissible because Petitioner failed to establish their authenticity under FRE 901. Patent Owner timely objected to EX1039 and EX1041 for lack of authenticity in its August 28, 2023 Objections to Evidence. Paper 42, 1-2. Petitioner's Reply cites these exhibits in a parenthetical citation to Anthony's supplemental declaration. *See* 1465 Reply, 14 (citing EX1042, ¶¶27-34 and referencing "APPLE-1039—APPLE-1041").

Under FRE 901(a), the proponent of an exhibit must "produce evidence sufficient to support a finding that the item is what the proponent claims it is." EX1039 and EX1041 are undated documents without any hallmarks of authenticity. The Reply lists these exhibits as "prior art references" that a "POSITA would have known of," but otherwise does not explain or discuss them. 1465 Reply, 13-14. Apple's expert, Anthony, incorrectly asserts in a footnote that these exhibits "describe systems that measured oxygen saturation at the wrist before the '745 Patent." EX1042, 47 n.5.

Apple has not produced evidence sufficient to establish EX1039 and EX1041 are what they are purported to be. EX1039 is an undated single-page document. There is no evidence sufficient to establish that the document included as EX1039 was created before the '745 Patent. There is also no evidence sufficient to establish that the document included as EX1039 was ever published or publicly available.

Finally, there is no evidence that EX1039 describes a device able to determine oxygen saturation at the wrist. EX1041 is an undated photograph, presented without any context or evidence for when the photograph was taken or what it shows. Thus, there is no evidence sufficient to establish that the document included as EX1039 and EX1041 were created before the '745 Patent, were ever published or publicly available, or involved a device able to determine oxygen saturation at the wrist. Neither Apple nor Anthony provided any context for these documents or any analysis of the content of these documents or their prior art status. 1465 Reply 13-14; EX1042 47 n.5.

In response to Masimo's objections, Apple served (not filed) a Declaration of Anne Koch Baland ("Baland Declaration") purporting to authenticate EX1039 and EX1041. Ms. Baland purports to be a librarian at Fish & Richardson. The Baland Declaration only compared EX1039 and EX1041 against their counterpart documents from the ITC investigation and deemed them "true and correct cop[ies]" of the corresponding ITC exhibits. However, neither Apple nor Ms. Baland points to anything suggesting that EX1039 and EX1041 were authenticated in the ITC, much less that the documents are what Apple now asserts them to be in this proceeding. Ms. Baland does not assert any personal knowledge of the documents, or their creation that might provide evidence of authenticity. Merely identifying the documents as correct copies of the corresponding document in the ITC investigation

does not establish they are what Apple purports them to be in this case, namely documents created before the '745 Patent, published or otherwise available, and disclosing systems or solutions for determining oxygen saturation at the wrist. Accordingly, the Board should exclude or otherwise disregard EX1039 and EX1041 for lack of authenticity under FRE 901.

C. Paragraph 31 of Anthony's Declaration (EX1042) and EX1056 Should Be Excluded

1. Paragraph 31 Lacks Foundation and/or Is Improper Expert Testimony

Patent Owner objects to the following statement in EX1042, ¶31 for lack of foundation and/or as improper expert testimony (FRE 602/702): “In April 2013, the Worcester Polytechnic Institute published an undergraduate project report titled ‘Reflectance-based Pulse Oximeter for the Chest and Wrist’ by Fontaine et al. APPLE-1056 (‘Fontaine’).” Patent Owner timely objected to this paragraph for lack of foundation and/or as improper expert testimony in its August 28, 2023 Objections to Evidence. Paper 42, 3. Petitioner cited this paragraph in its Reply. 1465 Reply, 14 (citing EX1042, ¶¶27-34).

As stated in Patent Owner's Sur-Reply, Apple failed to establish that EX1056 was prior art available to a POSITA. 1465 Sur-Reply, 26. EX1056 is an undated document. *See* EX1056. Apple introduced no evidence that it was published or otherwise available before the '745 Patent. The only statement in the record

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