

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MASIMO CORPORATION,  
Patent Owner.

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IPR2020-01521 (Patent 10,292,628 B1)  
IPR2020-01714 and IPR2020-01715 (Patent 10,631,765 B1)

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Record of Oral Hearing  
Held Virtually: January 19, 2022

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Before JOSIAH C. COCKS, ROBERT L. KINDER, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

IPR2020-01521 (Patent 10,292,628 B1)  
IPR2020-01714 and IPR2020-01715 (Patent 10,631,765 B1)

APPEARANCES:

ON BEHALF OF THE PETITIONER:

WALTER KARL RENNER, ESQUIRE  
ANDREW PATRICK, ESQUIRE  
HYUN JIN IN, ESQUIRE  
Fish & Richardson  
1000 Maine Avenue, S.W.  
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ON BEHALF OF PATENT OWNER:

STEPHEN JENSEN, ESQUIRE  
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Irvine, CA 92614

The above-entitled matter came on for hearing on Wednesday, January 19, 2022, commencing at 10:00 a.m., EDT, at the U.S. Patent and Trademark Office, by video/by telephone, before Chris Hofer, Notary Public.

P R O C E E D I N G S

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2 JUDGE COCKS: Good morning. I am Judge Cocks. I am joined by  
3 Judges Wieker and Kinder and we have something of a busy schedule today.  
4 We have scheduled oral argument in connection with six related *inter*  
5 *partes* review proceedings involving five separate patents. As we set  
6 forth in our order setting oral arguments, we have divided the hearings into  
7 four sessions. The first session beginning now involves IPR2020-01521,  
8 01714 and 01715 concerning patents 10,292,628 and 10,631,765. Let's  
9 begin with introduction of counsel who is arguing this first session. Let's  
10 begin with Petitioner. Would you please state your appearance today.

11 MR. RENNER: Good morning, Judge. This is Karl Renner from  
12 Fish & Richardson and I am joined by Andrew Patrick, Hyun Jin In who'll  
13 be presenting in the first stanza today. Grace Kim and Usman Khan are also  
14 with us.

15 JUDGE COCKS: All right. Thank you, Mr. Renner. And for Patent  
16 Owner, would you please state your appearance today.

17 MR. JENSEN: Yes. I'm Stephen Jensen on behalf of Patent Owner.  
18 I'll be arguing the first set that you mentioned. With me is Jeremiah Helm  
19 and Josh Stowell who will be handling later proceedings.

20 JUDGE COCKS: All right. Thank you, Mr. Jensen. All right. So,  
21 for this first session we have allotted 60 minutes of time per side. Petitioner  
22 bears the burden of showing unpatentability and will argue their case first  
23 and may reserve rebuttal time. Patent Owner will then argue their  
24 opposition to Petitioner's case and may reserve surrebuttal time. Petitioner

1 will then argue their rebuttal and Patent Owner will argue their surrebuttal.

2 A couple of logistics points is that there will be four separate  
3 transcripts for the four sessions. So, this first session involving the three  
4 cases will have a single transcript. As we have noted to the parties in our  
5 Order setting oral arguments, any argument the parties wish to appear in a  
6 given transcript per case must be stated in connection with that session or  
7 case. Also, we have electronic copies of the parties' demonstratives but if  
8 they would please try and identify the slide and slide deck as they go for  
9 both our benefit and the benefit of the transcript, we would appreciate it and  
10 that being said given that we have a full day, Mr. Renner, you may begin  
11 whenever you are ready.

12 MR. RENNER: Certainly. Thank you, Your Honor, and we'll reserve  
13 20 minutes in this first argument and I'll welcome Andrew Patrick to join  
14 me.

15 MR. PATRICK: Thank you. Thank you, Your Honors. May it  
16 please the Board. My name is Andrew Patrick and I represent Petitioner  
17 Apple. I am joined today by my colleagues Karl Renner and Hyun Jin In  
18 and we plan to divide our presentation on the '628 and '765 patents between  
19 us. I'd like to ask Your Honors if I could to turn to slide 2 of our  
20 presentation which provides an overview. From the record briefing it's no  
21 secret that the dispute between the parties in this proceeding (audio  
22 interference). Indeed, similar to the issues addressed last month during our  
23 hearing on related matters and as shown in the table of contents provided on  
24 this slide we've organized our presentation today to address the record  
25 evidence supporting the integration of features for which Masimo has

1 questioned combinability.

2 In that regard I will begin with issue 1A which addresses separate and  
3 distinct bases found within Ohsaki for integrating a cover with a protruding  
4 convex surface into each base reference. I will then turn to issue 1C which  
5 addresses an additional basis corroborated by Inokawa. My colleague today  
6 will speak today to issues 1B and 2 with issue 1B offering yet another  
7 separate and distinct basis found within Inokawa for integrating a cover with  
8 a protruding convex surface and with issue 2 addressing the multiple bases  
9 rooted within Inokawa for adding a second emitter to Aizawa. Finally, I will  
10 round out our direct by addressing issue 3 regarding the basis for integrating  
11 wireless communications with handheld computing devices into the primary  
12 references.

13 Before digging in I would like to call your attention to a rather  
14 unusual fact pattern presented by this case. In it the prior art not only  
15 teaches each of the features central to the dispute before us, it sets forth  
16 explicit motivations for integrating these specific features and it does so in a  
17 striking way, by acknowledging structures that exist in the base references  
18 and by describing how those structures would be improved by inclusion of  
19 the features for which combinability has been questioned. This happens  
20 over and over again. We see it with regard to issue 1 where the Ohsaki  
21 reference tells us that several benefits flow from changing the flat surface  
22 found in conventional covers like Aizawa's to a cover featuring a convex  
23 protruding portion.

24 Likewise, regarding issue 2, we see Inokawa acknowledge  
25 transmitters like those arguably described in the base reference Aizawa and

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