

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01520 (Patent 10,258,265 B1)
IPR2020-01536 (Patent 10,588,553 B2)
IPR2020-01537 (Patent 10,588,553 B2)
IPR2020-01538 (Patent 10,588,554 B2)
IPR2020-01539 (Patent 10,588,554 B2)

Record of Oral Hearing
Held: December 7, 2021

Before GEORGE R. HOSKINS, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

IPR2020-01520 (Patent 10,258,265 B1)
IPR2020-01536 (Patent 10,588,553 B2)
IPR2020-01537 (Patent 10,588,553 B2)
IPR2020-01538 (Patent 10,588,554 B2)
IPR2020-01539 (Patent 10,588,554 B2)

APPEARANCES:

ON BEHALF OF THE PETITIONER:

W. KARL RENNER, ESQUIRE
ROBERTO DEVOTO, ESQUIRE
ANDREW PATRICK, ESQUIRE
Fish & Richardson, PC
1000 Maine Avenue, S.W.
Washington, D.C. 20004

ON BEHALF OF PATENT OWNER:

STEPHEN JENSEN, ESQUIRE
Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
14th Floor
Irvine, CA 92614

The above-entitled matter came on for hearing on Tuesday,
December 7, 2021, commencing at 11:00 a.m., EDT, at the U.S. Patent and
Trademark Office, by video/by telephone, before Julie Souza, Notary Public.

IPR2020-01520 (Patent 10,258,265 B1)
IPR2020-01536 (Patent 10,588,553 B2)
IPR2020-01537 (Patent 10,588,553 B2)
IPR2020-01538 (Patent 10,588,554 B2)
IPR2020-01539 (Patent 10,588,554 B2)

PROCEEDINGS

1 JUDGE HOSKINS: Good morning. This is Administrative Patent
2 Judge George Hoskins. I'm joined on the panel today by my colleagues
3 Judge Amanda Wieker and Judge Robert Kinder. We're here today with the
4 parties for oral arguments in five related proceedings challenging three
5 different patents. The common Petitioner is Apple Inc., in these cases and
6 the common Patent Owner is Masimo Corporation. So with that
7 introduction let me ask counsel to introduce themselves and make a -- if you
8 want to introduce anybody else participating or listening in today that would
9 be great and also if you plan on splitting the argument among the
10 proceedings among different people give us an idea about how that's going
11 to look, if you would. So let me start with counsel for Petitioner, please.

12 MR. RENNER: Yes, Your Honor. This is Karl Renner from Apple's
13 bench. I'm joined today by Roberto Devoto and Andrew Patrick. They're
14 here with me in the room and we will be splitting the presentation between
15 the three of us in fact. (Indiscernible) you'll see there's a series of issues
16 there four strong. The first issue (indiscernible) --

17 JUDGE HOSKINS: Thank you.

18 MR. RENNER: -- you're welcome. The first, there's three sub parts
19 and I'll be handling 1A and 1C before turning it over to Mr. Devoto for 1B
20 and 2, and then Andrew Patrick will finish out with issues 3 and 4.

21 JUDGE HOSKINS: Okay. Thank you very much, and so how about
22 Patent Owner?

IPR2020-01520 (Patent 10,258,265 B1)
IPR2020-01536 (Patent 10,588,553 B2)
IPR2020-01537 (Patent 10,588,553 B2)
IPR2020-01538 (Patent 10,588,554 B2)
IPR2020-01539 (Patent 10,588,554 B2)

1 MR. JENSEN: For Patent Owner, this is Steve Jensen with Knobbe
2 Martens representing the Patent Owner and I'll be addressing all the issues.
3 Briefly with me in the room today is Joe Re who was designated lead
4 counsel. We did have something come up yesterday and he will not be able
5 to stay with us and so I will be handling the entirety of the hearing as we
6 informed the Board previously.

7 JUDGE HOSKINS: Okay. Thank you. So the order of arguments is
8 going to be as set forth in our Order so it's going to start with Petitioner
9 addressing Petitioner's case and then Patent Owner will have a chance to
10 make its argument, and then Petitioner will have the opportunity for rebuttal
11 and Patent Owner will have the opportunity for surrebuttal. We've granted
12 each party a total of 75 minutes across that entire spectrum of argument with
13 the opportunity to reserve time initially for the rebuttal or the surrebuttal. So
14 let me ask then, Mr. Renner, do you wish to reserve time in advance for your
15 rebuttal?

16 MR. RENNER: Yes, Your Honor. We want to reserve 30 minutes,
17 please.

18 JUDGE HOSKINS: Thank you. And Mr. Jensen, do you have any
19 reservations for surrebuttal that you want to make at this time?

20 MR. JENSEN: Yes, I would as well like to reserve some time and I'd
21 like to reserve 25 minutes.

22 JUDGE HOSKINS: Thank you. So the panel has the entirety of the
23 record before them on our computer screens as well as the parties'

IPR2020-01520 (Patent 10,258,265 B1)
IPR2020-01536 (Patent 10,588,553 B2)
IPR2020-01537 (Patent 10,588,553 B2)
IPR2020-01538 (Patent 10,588,554 B2)
IPR2020-01539 (Patent 10,588,554 B2)

1 demonstratives. I would encourage you to refer to your demonstratives by
2 number as you go through so that we can follow along easily and also so that
3 the record is clear, and so before I then turn it over to Mr. Renner to begin
4 let me just ask does anybody have any questions about the procedure today
5 before we start the argument?

6 MR. RENNER: None here, Your Honor.

7 MR. JENSEN: None from us, Your Honor.

8 JUDGE HOSKINS: Okay. So thank you very much. Then, Mr.
9 Renner, you can begin when you are ready and when you start we'll start a
10 clock and we'll let you know as you near the end of your initial I guess 45
11 minutes of time.

12 MR. RENNER: Thank you, Your Honor. Appreciate that. So let's
13 turn if we could please to slide 2 in our presentation deck and from the
14 record briefing I think it's clear the question of combinability is central to
15 the dispute between the parties in these proceedings and with this in mind,
16 and shown by our table as mentioned a moment ago, our presentation is
17 really organized to address the rationale offered on the record to justify
18 integration for features for which combinability was called into question
19 during the proceedings.

20 As noted I'll be handling 1A and 1C first but before digging into those
21 issues I wanted to call your attention to a rather unusual aspect of this case,
22 specifically the prior art not only teaches us the four features that in fact are
23 central to the dispute but it sets forth explicit motivations integrating these

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.