

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner

IPR2024-00290
Patent 8,190,223

**PETITIONER'S OBSERVATIONS REGARDING CROSS-EXAMINATION
TESTIMONY OF DR. JAMES DUCKWORTH**

LIST OF EXHIBITS

APPLE-1001	U.S. Patent No. 8,190,223 (“the ’223 Patent”)
APPLE-1002	U.S. Patent No. 8,190,223 File History
APPLE-1003	Declaration of Dr. Cockburn
APPLE-1004	U.S. Patent No. 6,707,476 (“Hochstedler”)
APPLE-1005	U.S. Patent Pub. No. 2002/0184055 (“Naghavi”)
APPLE-1006	U.S. Patent Pub. No. 2006/0064020 (“Burnes”)
APPLE-1007	U.S. Patent No. 6,151,518 (“Hayashi”)
APPLE-1008	U.S. Patent No. 5,842,979 (“Jarman”)
APPLE-1009	U.S. Patent No. 6,385,471 (“Mortz”)
APPLE-1010	U.S. Patent No. 6,584,336 (“Al-Ali-336”)
APPLE-1011	U.S. Patent Pub. No. 2003/0181798 (“Al-Ali-798”)
APPLE-1012	U.S. Patent Pub. No. 2003/0009119 (“Kamm”)
APPLE-1013	U.S. Patent Pub. No. 2003/0145852 (“Schmidt”)
APPLE-1014	U.S. Patent Pub. No. 2004/0204637 (“Diab-637”)
APPLE-1015	U.S. Patent No. 6,654,624 (“Diab”)
APPLE-1016	U.S. Patent No. 5,331,549 (“Crawford”)
APPLE-1017	U.S. Patent Pub. No. 2003/0092974 (“Santoso”)

APPLE-1018	U.S. Patent No. 6,912,413 (“Rantala”)
APPLE-1019	U.S. Patent No. 6,658,276 (“Kianl”)
APPLE-1020	U.S. Re-examination No. 90/012,559 File History
APPLE-1021	U.S. Patent Pub. No. 2002/0015034 (“Malmberg”)
APPLE-1022	Second Declaration of Dr. Cockburn
APPLE-1023	Excerpt from Wiley Electrical and Electronics Engineering Dictionary, John Wiley & Sons, Inc. (2004)
APPLE-1024	Excerpt from Merriam-Webster’s Collegiate Dictionary, Merriam-Webster, Incorporated (2005)
APPLE-1025	Transcript of Remote Deposition of R. James Duckworth, Ph.D.
APPLE-1026-1059	RESERVED
APPLE-1060	Combined Civil and Criminal Federal Court Management Statistics (Sep. 30, 2023) United States Courts (uscourts.gov), available at: https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0930.2023.pdf
APPLE-1061	Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“ <i>Director’s Guidance</i> ”)
APPLE-1062	Apple’s Complaint for Patent Infringement (Design), <i>Apple Inc., v Masimo Corporation, et al.</i> , Case No. 1-22-cv-01377 (D. Del. Oct. 20, 2022)
APPLE-1063	Apple’s Complaint for Patent Infringement (Utility), <i>Apple Inc., v Masimo Corporation, et al.</i> , Case No. 1-22-cv-01378 (D. Del. Oct. 20, 2022)

- APPLE-1064 Defendant Masimo Corporation's Answer to Complaint and Counterclaims, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (D. Del. Dec. 12, 2022)
- APPLE-1065 Order Granting Joint Motion to Amend the Case Schedule, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (D. Del. Sep. 21, 2023)
- APPLE-1066 Stipulation by Apple Inc.
- APPLE-1067 Email Identifying Masimo's District Court Invalidity Grounds (Nov. 16, 2023)
- APPLE-1068 Excerpt of Apple's District Court Expert Invalidity Report, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (Nov. 22, 2023)
- APPLE-1069 Order Granting Unopposed Motion to Stay Certain Patent Counterclaims, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (Jan. 10, 2023)
- APPLE-1070 – 1074 [RESERVED]
- APPLE-1075 Joint Letter for March 20, 2024 Case Management Conference, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (Mar. 16, 2024)
- APPLE-1076 Combined Civil and Criminal Federal Court Management Statistics (Dec. 31, 2023) | United States Courts (uscourts.gov), available at: https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf
- APPLE-1077 Median Time to Disposition in Cases Terminated After Hearing or Submission | United States Court of Appeals for the Federal Circuit (Sep. 30, 2023), available at: [MedDispTimeMERITS-Table-FY23.pdf \(uscourts.gov\)](#)
- APPLE-1078 *Sotera* Stipulation by Apple Inc.

APPLE-1079 Petitioner's Demonstratives

APPLE-1080 Transcript of Remote Deposition of Dr. R. James Duckworth
(April 25, 2025)

Pursuant to the Board's April 2, 2025, oral order, Petitioner Apple Inc. submits the following observations on the cross-examination testimony of Dr. James Duckworth taken by deposition on April 25, 2025. *See* APPLE-1080.

OBSERVATION 1:

In APPLE-1080 at 20:14-21:3, in response to questions relating to his understanding of the usage of the term “replace” in the context of the '223 Patent, Dr. Duckworth testified: “The term ‘replace,’ as generally used in the English language means to take the place of The '223 patent used the terms ‘replace’ and ‘replaced,’ consistent with the above understanding.” This testimony is relevant to ¶8 of Dr. Duckworth's declaration (EX2046) because it is inconsistent with his statement there that “A POSITA would have understood these claim limitations mean that when a measured value of a first parameter is ‘replaced’ or ‘changed’ by the measured value of a second parameter, ‘the measured value of the first parameter is removed from the display, and the measured value of the second parameter is displayed in place of the measured value of the first parameter.’”

OBSERVATION 2:

In APPLE-1080 at 24:8-12, when asked “where Claim 1 includes the phrase ‘space-limited display’?,” Dr. Duckworth testified: “So I believe that Claim 1 does

not use the words that you just used.” Dr. Duckworth also testified at 26:22-27:1 that “I don’t believe that Claim 13 includes the words ‘space-limited display.’” Furthermore, Dr. Duckworth testified at 29:6-7 that “I do not see the term ‘space-limited display’ in Claim 15,” and at 30:13-14 that “I do not see the term ‘space-limited display’ used in Claim 18.” Dr. Duckworth further testified at 38:17-18 that “I do not see the phrase ‘space-limited display’ in Claim 21,” at 41:15-16 that “I did not see the phrase ‘space-limited display’ in Claim 27,” and at 43:5-6 that “I do not see the phrase ‘space-limited display’ in Claim 28.” Additionally, when asked at 32:20-22 “Does the ’223 Patent anywhere in the claims or the specification use the phrase ‘space-limited display’?,” Dr. Duckworth stated that “I’m going to read my clean copy of the patent, then, to look for those terms” (33:18-20), and concluded that “I did not see those three words together like that, no” (35:22-36:1). This testimony is relevant to ¶14 of Dr. Duckworth’s declaration (EX2046) because it shows that his assertion there that the challenged claims relate to “space-limited displays that require replacing/changing to display measured values of parameters” is divorced from the actual language of the claims.

OBSERVATION 3:

At 103:13-104:1, Dr. Duckworth was asked in the context of Figs. 11B and 11C of the ’223 Patent:

And then in the last sentence of that section where it's using HbCO as the alarming measurement, it says, 'In an embodiment, a location of the display of an alarming value is changed to be displayed in a larger display area, such as 1102, so as to be readily noticeable and its display values readily ascertainable.' In that example, a person of ordinary skill in the art would understand that HbCO 1108 is being changed to be displayed at 1102; correct?

Dr. Duckworth responded "No, I disagree." *Id.* This testimony is relevant to Dr. Duckworth's assertion at ¶15 of his declaration (EX2046) that "[f]igures 11B and 11C do not show replacement within the meaning of the claims," because it shows that his related conclusions are based on a narrow reading of the '223 Patent's specification.

OBSERVATION 4:

At 109:10-14, when asked about the scope of claim 27, Dr. Duckworth stated that "It displays either the first measured value or the second measured value but not both." At 109:18-110:5, when asked about the scope of claim 28, Dr. Duckworth stated that "the display of Claim 27 displays either the first measured value or the second measured value but not both, and the same would be true for

Claim 28.” This testimony is relevant to Dr. Duckworth’s statements regarding the scope of claims 27 and 28 at ¶18 of his declaration (EX2046) because it provides confirmation of his narrow interpretation of these claims, and specifically his narrow interpretation of the term “or” in the phrase “displaying a measured value of a first blood parameter of body tissue of a monitored patient or displaying a measured value of a second parameter of the body tissue,” as recited in claim 27.

OBSERVATION 5:

At 128:10-15, when asked “And you would agree with me that a handheld device in 205 would have a space-limited display; correct?”, Dr. Duckworth answered “What do you mean by ‘a space-limited display’?”. This testimony is relevant because it demonstrates Dr. Duckworth’s lack of understanding of a term he himself used at ¶6 of his declaration (EX2046).

OBSERVATION 6:

At 122:11-18, when asked about the capabilities of Naghavi’s system, Dr. Duckworth stated that “I believe a POSITA would read paragraph 80, acquiring one or more of those data elements, ECG, heart and respiratory rate, et cetera, could be taken simultaneously or they could be taken serially.” At 133:22-134:3, when asked “And both [Naghavi and the ’223 Patent] describe handheld devices

that are capable of taking physiological metrics; correct?”, Dr. Duckworth stated “Yes, but – yes.” Additionally, at 135:6-10, when asked about his opinion that Naghavi displays all currently measured parameters simultaneously, Dr. Duckworth confirmed that “I do not mention a handheld device, no.” This testimony is relevant to Dr. Duckworth’s assertion at ¶30 of his declaration (EX2046) that “each reference teaches displaying all measured parameters” because it demonstrates that Dr. Duckworth did not consider the handheld device embodiment of Naghavi in reaching this conclusion.

Respectfully submitted,

Date: May 2, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on May 2, 2025, a complete and entire copy of this Petitioner's Observations was provided by email to Patent Owner by serving the email correspondence addresses of record as follows:

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