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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2024-00294
U.S. Patent 10,736,507

PATENT OWNER'S CONTINGENT MOTION TO AMEND

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EXHIBIT LIST

Exhibit No.	Description
2045	U.S. Patent App. No. 15/880,071
2046	U.S. Prov. Patent App. No. 61/703,729
2047	U.S. Patent App. No. 14/033,315

I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner Masimo Corporation (“Masimo”) submits this contingent motion to amend Claims 1-20 of the ’507 Patent (“original claims”) as set forth in the attached substitute Claims 21-36 (“substitute claims”). In the event the Board finds at least one original claim unpatentable, Masimo respectfully requests that the Board grant this Motion to Amend with respect to the corresponding proposed substitute claim(s). Accordingly, this Motion to Amend is contingent upon a determination of unpatentability of the original claim(s). Masimo also requests **Preliminary Guidance**.

As shown below, this Contingent Motion and the included substitute claims meet all requirements of 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. *See Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, -01130, Paper 15 at 4 (PTAB Feb. 25, 2019) (precedential). Specifically, the substitute claims are: (i) presented in a claim listing; (ii) reasonable in number; (iii) responsive to a ground of unpatentability involved in the trial; (iv) non-broadening; and (v) supported by the written description. *Id.* at 4-8. Moreover, Masimo hereby confirms and explains below its belief that the proposed substitute claims are patentable over all known prior art, whether alone or in combination, under the relevant standards of Title 35 of the United States Code.

Masimo respectfully submits that it is entitled to the contingent substitute claims unless Petitioner “prove[s] all propositions of unpatentability.” *Aqua Products v. Matal*, 872 F.3d 1290, 1310 (Fed. Cir. 2017) (*en banc*).

II. STATEMENT OF RELIEF REQUESTED

Pursuant to the Board’s Pilot Program, Masimo requests the Board’s **Preliminary Guidance** as to this Contingent Motion to Amend. To the extent the Board finds any of original Claims 1-20 unpatentable, Masimo respectfully requests that the Board grant this motion to amend by entering at least the proposed claim(s) presented herein in substitution for any of the corresponding claim(s) found unpatentable, or in the alternative, that the Board grant this motion to amend by entering each of the reasonable number of amended claims proposed herein.

III. THE SUBSTITUTE CLAIMS SATISFY 37 C.F.R. § 42.121(a)

A. The Substitute Claims Are Non-Broadening

The attached appendix of substitute claims lists the proposed substitute claims and shows that each retains all features of the corresponding original claims. The amendments add non-broadening limitations. The proposed substitute claims thus do not enlarge the scope of the corresponding original claims in any way. The following table further indicates how each proposed substitute claim does not broaden the corresponding original claim.

Original Cl. No.	Substitute Cl. No.	Amendments (no substitute claims have broadening amendments)
1	21	Specifies that : • the system is a “wristwatch” mobile pulse oximetry system • the processing board communicates with the optical sensor via “non-wireless” data communication • the mobile computing device comprises the wristwatch • the wristwatch includes a display and cellular communication capabilities • the processing board is configured to receive “unprocessed” signals “through a non-wireless connection” from the optical sensor • the processing board is configured to output the SpO2 measurement values “nonwirelessly” to the mobile computing device • the application is configured to execute commands to display “on a touch sensitive screen,” which is also configured to allow user interaction • “all” power for the processing board is drawn from the mobile computing device • “the wristwatch mobile pulse oximetry system” further comprises “a substantially water-tight enclosure for at least the processing board, the enclosure including impact resistant upper and

Original Cl. No.	Substitute Cl. No.	Amendments (no substitute claims have broadening amendments)
		lower shells”
2	22	Only edit is to specify new dependency
3	23	Only edit is to specify new dependency
4	24	Only edit is to specify new dependency
5	25	Only edit is to specify new dependency
6	26	Only edit is to specify new dependency
7	27	Only edit is to specify new dependency
8	28	Only edit is to specify new dependency
13	29	Specifies that: • the method uses “a wristwatch system” to inform a user of SpO₂ • signals responsive to the light and oxygen saturation are “unprocessed nonwireless” signals • a processing board: ○ communicates “nonwirelessly” with the optical sensor and with the wristwatch mobile computing device ○ is “powered by the wristwatch mobile computing device” ○ receives one or more “unprocessed nonwireless” signals from the optical sensor ○ processes “nonwireless signals” to generate the SPO₂ measurement values ○ outputs these values “nonwirelessly” to “one

Original Cl. No.	Substitute Cl. No.	Amendments (no substitute claims have broadening amendments)
		or more hardware processors” of the “wristwatch” mobile computing device • an application configured to execute commands on “one or more hardware processors” of the wristwatch mobile computing device: ○ generates a “wristwatch” graphical user interface “on a touch sensitive screen” ○ displays inputs configured to allow the user to interact “via the touch sensitive screen”
14	30	Only edit is to specify new dependency
15	31	Only edit is to specify new dependency
16	32	Only edits are to specify new dependency and correct typos
17	33	Only edit is to specify new dependency
18	34	Only edit is to specify new dependency
20	35	Only edit is to specify new dependency
13	36	Specifies further that “the wristwatch system” of Claim 13 “comprises impact resistant upper and lower shells that help enclose at least the processing board in a substantially water-tight manner.”

B. The Substitute Claims Are Responsive To A Ground Of Unpatentability Involved In The Trial

The proposed substitute claims are also responsive to at least one ground of unpatentability in the trial. *See* 37 C.F.R. § 42.121(a)(2)(i). Petitioner has alleged that Claims 1-20 of the '507 Patent—including independent Claims 1 and 13—are invalid under the following grounds.

GROUND LISTING

Ground	Claims	§102 Prior Art
1A1	13, 15, 18-19	Mendelson
Ground	Claims	§103 Prior Art
1A2	13, 15, 18-19	Mendelson
1B	16, 18, 20	Mendelson, Tran
1C	14, 17	Mendelson, Kianl
1D	1-2, 5, 7, 9, 12-15, 17-19	Mendelson, D'Angelo
1E	3	Mendelson, D'Angelo, Ording
1F	4-6, 8, 16, 18, 20	Mendelson, D'Angelo, Tran
1G	2, 7, 14, 17	Mendelson, D'Angelo, Kianl
1H	3	Mendelson, D'Angelo, Kianl, Ording
1I	10-11	Mendelson, D'Angelo, Goldsmith

Ground	Claims	§102 Prior Art
2A	13, 15, 18-19	Mendelson, Moon
2B	16, 18, 20	Mendelson, Moon, Tran
2C	14, 17	Mendelson, Moon, Kianl
2D	1-2, 5, 7, 9, 12-15, 17-19	Mendelson, Moon, D'Angelo
2E	3	Mendelson, Moon, D'Angelo, Ording
2F	4-6, 8, 16, 18, 20	Mendelson, Moon, D'Angelo, Tran
2G	2, 7, 14, 17	Mendelson, Moon, D'Angelo, Kianl
2H	3	Mendelson, Moon, D'Angelo, Kianl, Ording
2I	10-11	Mendelson, Moon, D'Angelo, Goldsmith

Pet. 1-2.

This Motion to Amend proposes contingent amendments to Claims 1-20 that are responsive to Petitioner's grounds in the instant IPR. For example, in response to the grounds based on Mendelson for Claim 1 and its dependents, (e.g., Grounds 1D-1I, 2D-2I), Masimo's proposed substitute system Claim 21 clarifies that the claimed system is specific to a "wristwatch" mobile pulse oximetry system, where:

- a processing board communicates with the optical sensor via "non-wireless" data communication;
- the mobile computing device comprises the wristwatch;
- the wristwatch includes a display and cellular communication capabilities;
- the processing board is configured to receive "unprocessed" signals "through a non-wireless connection" from the optical sensor;

- the processing board is configured to output the SpO₂ measurement values “nonwirelessly” to the mobile computing device;
- the application is configured to execute commands to display “on a touch sensitive screen,” which is also configured to allow user interaction;
- “all” power for the processing board is drawn from the mobile computing device; and
- “the wristwatch mobile pulse oximetry system” further comprises “a substantially water-tight enclosure for at least the processing board, the enclosure including impact resistant upper and lower shells.”

In another example, in response to the grounds based on Mendelson for Claim 13 and its dependents, (e.g., Grounds 1A1-1C, 1D, 1F, 1G, 2A-2D, 2F, 2G), Masimo’s proposed substitute method Claim 29 specifies that:

- the method uses “a wristwatch system” to inform a user of SpO₂;
- signals responsive to the light and oxygen saturation are “unprocessed nonwireless” signals;
- a processing board:
 - communicates “nonwirelessly” with the optical sensor and with the wristwatch mobile computing device;
 - is “powered by the wristwatch mobile computing device”;
 - receives one or more “unprocessed nonwireless” signals from the optical sensor;
 - processes “nonwireless signals” to generate the SPO₂ measurement values;
 - outputs these values “nonwirelessly” to “one or more hardware processors” of the “wristwatch” mobile computing device;

- an application configured to execute commands on “one or more hardware processors” of the wristwatch mobile computing device:
 - generates a “wristwatch” graphical user interface “on a touch sensitive screen”; and
 - displays inputs configured to allow the user to interact “via the touch sensitive screen.”

None of the asserted references, individually or in combination, disclose or render obvious the relevant combinations of limitations and features of the claims, including the above limitations. The additional clarifications noted above recite additional distinguishing features, thereby addressing the grounds advanced in the Petition, such that the asserted prior art references fail to render obvious the proposed substitute claims that are presented herein.¹

Moreover, it is not necessary “that every word added to or removed from a claim in a motion to amend must be solely for the purpose of overcoming an instituted ground.” *Veeam Software Corp. v. Veritas Techs., LLC*, IPR2014-00090, Paper 48 at 28 (Jul. 17, 2017). Rather, the question is whether “the proposed claim as a whole is ‘responsive to a ground of unpatentability involved in the trial.’”

¹ Masimo does not concede, and is not conceding, that the original claims of the ’507 Patent are rendered unpatentable by the prior art asserted in the Petition. Rather, the proposed amendments presented herein further amplify distinctions between the asserted references and the ’507 Patent.

Id., 29. Beyond that threshold, a patent owner may add other amendments that “serve[] the public interest by ensuring issuance of valid and clear patents.” *Id.* To the extent the Board finds that any other proposed amendments in a given substitute claim are not directly responsive to a ground of unpatentability here, those amendments are appropriate in view of the legal principles above.

C. The Substitute Claims Are Reasonable In Number

The total number of original claims is 20, and the total number of proposed substitute claims is 16. Masimo has selected a subset of the original claims in the IPR petition for amendment. For most of the original claims, Masimo proposes only one substitute claim or no substitute claim, fitting the “presumption ... that only one substitute claim would be needed to replace each challenged claim.” 37 C.F.R. § 42.121(a)(3). The only exception is Claim 13, for which Masimo has proposed substitute independent claim 29 and substitute dependent claim 36. Thus, the 16 substitute claims are reasonable in number when compared to the 20 original claims.

IV. THE SUBSTITUTE CLAIMS SATISFY 37 C.F.R. § 42.121(b)

A. The Substitute Claims Are Presented In A Claim Listing

Consistent with 37 C.F.R. § 42.121(b), this motion is accompanied by an appendix listing the proposed substitute claims and showing the proposed amendments to the claims as compared to the corresponding original claims.

B. The Substitute Claims Are Supported By The Original And Earlier Filed Disclosures For Each Claim

Pursuant to 37 C.F.R. §§ 42.121(b)(1)-(b)(2), the table below demonstrates that each proposed substitute claim is supported by each earlier-filed disclosure for which the benefit of the filing date is sought. In particular, the '507 Patent issued from U.S. Patent App. No. 15/880,071, which was filed on January 25, 2018 (EX2045). The '507 Patent is a continuation of, and claims priority to, U.S. Patent App. No. 14/033,315 (EX2047, the "'315 application"), which was filed on September 20, 2013. The '315 application (EX2047) claims priority to U.S. Provisional Patent App. No. 61/703,729 (EX2046), which was filed on September 20, 2012. The example written description support citations provided herein are not necessarily exhaustive, nor do they in any way limit the meaning of the corresponding limitations.

Written Description Support Examples			
Claim	<u>EX2045</u> Original Disclosure of '507 Patent	<u>EX2046</u> Provisional App. No. 61/703,729 (Filed Sept. 20, 2012)	<u>EX2047</u> Non-Provisional App. No. 14/033,315 (Filed Sept. 20, 2013)
21	Amended Features: [0006], [0023], [0027]-[0028], [0032], [0036], [0038], [0040], [0042], [0043], [0047], [0050]- [0052], [0079]-	Amended Features: Pages 1, 4-7, 12-13; FIGS 1-3	Amended Features: [0006], [0023], [0027]- [0028], [0032], [0036], [0038], [0040], [0042], [0043], [0047], [0050]- [0052], [0079]-[0080]; FIGS 1-2, 4A-4D

	[0080]; FIGS 1-2, 4A-4D		
22	N/A	N/A	N/A
23	N/A	N/A	N/A
24	N/A	N/A	N/A
25	N/A	N/A	N/A
26	N/A	N/A	N/A
27	N/A	N/A	N/A
28	N/A	N/A	N/A
29	Amended Features: [0006], [0023], [0027]-[0028], [0032], [0034], [0036], [0038], [0040], [0047], [0050]-[0052], [0079]-[0080]; FIGS 1-2, 4A-4D	Amended Features: Pages 1, 4-7, 10, 12-13; FIGS 1-3	Amended Features: [0006], [0023], [0027]-[0028], [0032], [0034], [0036], [0038], [0040], [0047], [0050]-[0052], [0079]-[0080]; FIGS 1-2, 4A-4D
30	N/A	N/A	N/A
31	N/A	N/A	N/A
32	N/A	N/A	N/A
33	N/A	N/A	N/A
34	N/A	N/A	N/A
35	N/A	N/A	N/A
36	Amended Features: [0042]-[0043]; FIGS 1-2	Amended Features: Page 6; FIGS 1-3	Amended Features: [0042]-[0043]; FIGS 1-2

V. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSITA”) at the time of the ’507 Patent would have been a person with a working knowledge of physiological monitoring technologies and/or optical sensors used in physiological monitoring technologies.

The person would have had a Bachelor of Science degree in an academic discipline emphasizing the design of electrical, computer, software, or optical technologies, in combination with training or at least one to two years of related work experience with capture and processing of data or information, or designing and using optical sensors or systems, including but not limited to physiological monitoring technologies. Alternatively, the person could have had a Master of Science degree in a relevant academic discipline with less than a year of related work experience in the same discipline.

VI. CLAIM CONSTRUCTION

For purposes of this Contingent Motion, Masimo does not propose any specific claim constructions as it is not Masimo's burden to demonstrate patentability of the proposed substitute claims over the prior art. Masimo believes that the new limitations proposed herein, under their plain and ordinary meanings, establish patentability of the proposed substitute claims. However, Masimo reserves the right to propose claim constructions as needed to respond to any allegations of unpatentability presented by Petitioner.

VII. PATENTABILITY OVER THE PRIOR ART

In light of the Federal Circuit's *en banc* decision in *Aqua Products* (872 F.3d at 1296, 1310), Masimo need not prove the patentability of the proposed substitute claims. Furthermore, the Federal Circuit has held that a patent owner satisfies its

duty of candor by simply confirming—as Masimo does here—its belief that the proposed substitute claims are patentable over all known prior art, alone or combined. *Nike Inc. v. Adidas AG*, 812 F.3d 1326, 1350 (Fed. Cir. 2016) (overruled *en banc* on other grounds).

VIII. CONCLUSION

For the foregoing reasons, Masimo respectfully requests the Board’s **Preliminary Guidance** as to this Motion, and further requests that, to the extent any original claim is deemed unpatentable, the Board enter and grant the corresponding proposed substitute claim(s).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 10, 2024

/Jarom Kesler/

Jarom D. Kesler (Reg. No. 57,046)

Customer No. 64,735

Attorney for Patent Owner
Masimo Corporation

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER'S CONTINGENT MOTION TO AMEND AND EXHIBITS 2045-2047** is being served electronically on October 10, 2024, to the e-mail addresses shown below:

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Dated: October 10, 2024

/Jarom Kesler/

Jarom D. Kesler (Reg. No. 57,046)

Attorney for Patent Owner
Masimo Corporation

APPENDIX OF SUBSTITUTE CLAIMS

In the claim listing below, **underlining** and strikethrough (~~strikethrough~~) are used to show modifications. The corresponding original claims are also noted in parentheses.

21. (Substitute for claim 1, if that claim is found unpatentable). A **wristwatch** mobile pulse oximetry system for informing a user of mobile measurement of oxygen saturation (“SpO₂”), the **wristwatch** mobile pulse oximetry system comprising:

an SpO₂ measurement system including:

an optical sensor configured to output one or more signals responsive to light from a light source attenuated by tissue of the user at a measurement site, said one or more signals responsive to an oxygen saturation of said tissue; and

a processing board in **non-wireless** data communication with the optical sensor and **non-wireless data communication with** a mobile computing device **comprising the wristwatch, which includes** ~~including~~ a display and cellular communication **capabilities**, wherein the processing board is configured to:

receive [[said]] one or more **unprocessed** signals **through a non-wireless connection** from the optical sensor;

process said one or more **unprocessed** signals to generate SpO₂ measurement values; and

output the SpO₂ measurement values **nonwirelessly** to the mobile computing device; and

one or more hardware processors of the mobile computing device configured to execute an application, the application configured to execute commands to:

generate a graphical user interface **of the wristwatch** having a plurality of display portions;

display **on a touch sensitive screen**, in at least one portion of the plurality of display portions, a representation of a physiological parameter of a plurality of physiological parameters comprising at least the SpO₂ measurement values; and

display **on the touch sensitive screen**, in a different portion of the plurality of display portions, a plurality of user inputs, **the touch sensitive screen** configured to allow the user to interact with at least one of the plurality of display portions or the application;

wherein the processing of the one or more signals to generate SpO₂ measurement values is performed only on the processing board, thereby freeing up memory available to the mobile computing device; and

wherein the processing board is configured to draw **all** power for operation from the mobile computing device;

the wristwatch mobile pulse oximetry system further comprising a substantially water-tight enclosure for at least the processing board, the enclosure including impact resistant upper and lower shells.

22. (Substitute for claim 2, if claim 1 is found unpatentable). The mobile pulse oximetry system of claim **21**, wherein the application is configured to execute commands to:

perform a trend analysis on received SpO₂ measurement values; and

display results of the trend analysis in at least one portion of the plurality of display portions.

23. (Substitute for claim 3, if claim 1 is found unpatentable). The mobile pulse oximetry system of claim **22**, ~~wherein the display is touch sensitive, and~~ wherein the application is configured to execute commands to narrow or expand the displayed results of the trend analysis in response to the user using a pinch gesture.

24. (Substitute for claim 4, if claim 1 is found unpatentable). The mobile pulse oximetry system of claim 21, wherein the application is configured to execute commands to set reminders to take future measurements.

25. (Substitute for claim 5, if claim 1 is found unpatentable). The mobile pulse oximetry system of claim 21, wherein the application is configured to execute commands to output one or more alarms associated with SpO₂ measurement values that are above or below threshold SpO₂ measurement values.

26. (Substitute for claim 6, if claim 1 is found unpatentable). The mobile pulse oximetry system of claim 21, wherein the application is configured to execute commands to output one or more reminders to use the optical sensor to take measurements of SpO₂ measurement values at predetermined times or cycles.

27. (Substitute for claim 7, if claim 1 is found unpatentable). The mobile pulse oximetry system of claim 21, wherein the application is configured to execute commands to update the representation of the physiological parameter to comprise one or more of a plurality of graphical representations of the SpO₂ measurement

values, the plurality of graphical representations comprising at least one of bar graphs or charts.

28. (Substitute for claim 8, if claim 1 is found unpatentable). The mobile pulse oximetry system of claim 21, wherein the application is configured to execute commands to output an alert, via a network to a designated physician or other care provider, regarding abnormal SpO₂ readings.

29. (Substitute for claim 13, if that claim is found unpatentable). A computer-implemented method of using a wristwatch system to inform~~informing~~ a user of mobile measurement of oxygen saturation (“SpO₂”), the computer-implemented method comprising:

outputting, from an optical sensor of an SpO₂ measurement system, one or more unprocessed nonwireless signals responsive to light from a light source attenuated by tissue of the user at a measurement site, said one or more unprocessed nonwireless signals responsive to an oxygen saturation of said tissue; and

via a processing board of the SpO₂ measurement system, the processing board in nonwireless data communication with the optical sensor and with a wristwatch mobile computing device including a display, the processing board powered by the wristwatch mobile computing device:

receiving said one or more **unprocessed nonwireless** signals from the optical sensor;

processing said one or more **unprocessed nonwireless** signals to generate [[the]] SpO₂ measurement values; and

nonwirelessly outputting the SpO₂ measurement values to **one or more hardware processors of the wristwatch** mobile computing device; and via an application configured to execute commands on the **one or more hardware processors of the wristwatch** mobile computing device:

generating a **wristwatch** graphical user interface **on a touch sensitive screen and** having a plurality of display portions;

displaying, in at least one portion of the plurality of display portions, a representation of a physiological parameter of a plurality of physiological parameters comprising at least the SpO₂ measurement values; and

displaying, in a different portion of the plurality of portions, a plurality of user inputs configured to allow the user to interact **via the touch sensitive screen** with at least one of the plurality of display portions or the application.

30. (Substitute for claim 14, if claim 13 is found unpatentable). The computer-implemented method of claim [[13]]**29**, further comprising, via the application:

performing a trend analysis on received SpO₂ measurement values; and

displaying results of the trend analysis in at least one portion of the plurality of display portions.

31. (Substitute for claim 15, if claim 13 is found unpatentable). The computer-implemented method of claim [[13]]**29**, further comprising, via the application, outputting one or more alarms associated with SpO₂ measurement values that are above or below threshold SpO₂ measurement values.

32. (Substitute for claim 16, if claim 13 is found unpatentable). The computer-implemented method of claim [[13]]**29**, further comprising, via the application, outputting one or more reminders to use the **optical sensor** ~~optical sensor~~ to take measurements of SpO₂ measurement values at predetermined times or cycles.

33. (Substitute for claim 17, if claim 13 is found unpatentable). The computer-implemented method of claim [[13]]**29**, further comprising, via the application, updating the representation of the physiological parameter to comprise one or more of a plurality of graphical representations of the SpO₂ measurement values, the plurality of graphical representations comprising at least one of bar graphs or charts.

34. (Substitute for claim 18, if claim 13 is found unpatentable). The computer-implemented method of claim [[13]]**29**, further comprising, via the application, outputting an alert, via a network to a designated physician or other care provider, regarding abnormal SpO₂ readings.

35. (Substitute for claim 20, if claim 13 is found unpatentable). The computer-implemented method of claim [[13]]**29**, further comprising, via the application, enabling the user to set reminders to take future measurements.

36. (Additional substitute for claim 13, if that is found unpatentable). **The computer-implemented method of claim 29, wherein wristwatch system comprises impact resistant upper and lower shells that help enclose at least the processing board in a substantially water-tight manner.**