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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.

IPR2020-01737
U.S. Patent 10,709,366

PATENT OWNER'S SUR-REPLY TO REPLY

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I. INTRODUCTION

Petitioner attempts to rewrite a flawed petition that misunderstood the cited references and basic optical principles. Petitioner’s new arguments are inconsistent with its prior positions, conflict with the cited references, and constitute a hindsight-driven reconstruction of Masimo’s claims.

Petitioner asserts that Masimo did not respond to Petitioner’s three purported motivations to modify Aizawa’s “flat cover...to include a lens/protrusion...similar to Ohsaki’s translucent board.” Reply 8; Pet. 28-29. That is incorrect.

Petitioner’s first motivation is to “improve adhesion.” *Id.* Masimo directly responded, pointing out that Aizawa discloses a palm-side sensor and that Petitioner’s proposed combination has a shape that would *increase slipping* at Aizawa’s measurement location. Patent Owner Response (“POR”) 22-32. Indeed, Aizawa teaches a *flat* surface improves adhesion on the wrist’s palm-side and Ohsaki teaches a *convex* surface tends to *slip* on the wrist’s palm-side. POR 33-45. Both references thus undermine Petitioner’s proposed motivation of improved adhesion. Rather than address these contrary teachings, Petitioner asserts that Ohsaki’s sensor has *no* particular shape and reduces slipping at *any* body location. Reply 13-20. That contradicts Ohsaki, which illustrates its sensor’s longitudinal shape and explains how even slightly changing the sensor’s orientation or

measurement location results in slipping. Ex. 1014 Figs. 1, 2, 3A-3B, ¶¶[0019], [0023]. Petitioner’s first motivation fails.

Masimo also responded to Petitioner’s second motivation, a purported “improve[d] detection efficiency.” Reply 8. As Masimo explained, Petitioner admitted that adding a convex cover to Aizawa’s sensor would direct light *away* from the sensor’s *peripherally located* detectors. POR 45-53. Thus, Petitioner’s proposed combination decreases optical signal strength and detection efficiency—the opposite of Petitioner’s motivation to “improve detection efficiency.” Petitioner’s second motivation fails.

Petitioner’s third motivation is to “protect the elements within the sensor housing.” Reply 8. As Masimo explained, a POSITA would have viewed a convex surface as inferior to a flat surface due to an increased risk of scratching. POR 53-54. Petitioner now argues “multiple advantages” would “outweigh any alleged possibility of scratching.” Reply 31. Petitioner establishes *no* advantages for a convex surface in the proposed combination, let alone multiple advantages. Regardless, Petitioner does not explain why a POSITA would have chosen a convex cover—the one alternative Petitioner admits suffers from scratching—from the many different alternatives for protection. Ex. 2009 394:18-396:17.

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