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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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IPR2021-00193  
Patent 10,299,708

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**PATENT OWNER MASIMO SUR-REPLY TO REPLY**

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## I. INTRODUCTION

Rather than substantively rebut Masimo’s arguments, Petitioner concocts arguments Masimo never made and then spends many pages of briefing attempting to disprove those arguments. Petitioner asserts numerous new optics theories in an attempt to show a convex surface does not direct “*all*” light to “a single point at the center.” Reply 3.<sup>1</sup> Masimo never made such an argument.

Rather, Masimo argued that a convex surface condenses relatively more light towards a more central location as compared to a flat surface. There should be no dispute on this issue. Petitioner and its declarant repeatedly admitted that a convex surface would direct light away from the periphery and towards a more central position. Yet, Petitioner proposed adding a convex surface above *peripherally located detectors*, arguing a POSITA would make the addition to *improve* optical signal strength. Masimo explained that, consistent with Petitioner’s admissions, a POSITA would *not* have been motivated to direct light *away* from peripherally located detectors. None of Petitioner’s new arguments persuasively rebut this. The Board should affirm the patentability of all challenged claims.

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<sup>1</sup> All emphasis is added unless otherwise noted

## II. ARGUMENT

### A. Grounds 1A-1F

#### 1. Petitioner’s New Evidence And Arguments Address An Argument Masimo Never Made

Petitioner mischaracterizes Masimo’s position as contending Inokawa’s lens would direct “*all*” light “only at a *single point* at the center...” Reply 3. However, Petitioner never quotes any such Masimo argument because *none* exists. Masimo clearly and repeatedly argued “that a POSITA would have understood that Inokawa’s protruding surface would direct incoming light *towards the center* of the sensor.” Patent Owner Response (“POR”) 19; *see also id.* 2, 13-15, 22-25, 27. Masimo’s declarant, Dr. Madisetti, likewise repeatedly testified that Inokawa’s lens directs light “to a *more central location* as a result of passing through the protruding surface.” Ex. 2004 ¶56; *see also id., e.g.* ¶¶34, 43, 51, 53, 54, 57.<sup>2</sup> Masimo and Dr. Madisetti explained that a convex surface condenses relatively more light *towards* a more central location as compared to a flat surface. *See, e.g.*, Ex. 2004 ¶67 (“Taken as a whole, a POSITA would have understood that a protruding surface results in an overall redirection of incoming light towards the

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<sup>2</sup> Indeed, when asked, Dr. Kenny could identify no testimony from Dr. Madisetti stating that *all* light was directed to center. *See, e.g.*, Ex. 2027 63:7-64:6, 94:20-96:1, 96:18-97:7.

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