

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MASIMO CORPORATION,  
Petitioner,

v.

APPLE, INC.,  
Patent Owner

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Case IPR2023-00634  
U.S. Patent 10,627,783

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**PATENT OWNER'S PRE-INSTITUTION SUR-REPLY**

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**I. Petitioner Should Not Be Allowed to Use Its Reply To Cure Its Failure to Meet Its Burden Under 325(d)**

Under *Advanced Bionics*, the Board may exercise discretion to deny a petition under §325(d) upon considering: (1) whether the same or substantially the same prior art or arguments were presented during prosecution and (2) if so, whether the Office erred in a manner material to patentability during prosecution. At a minimum then, the petition here should have scrutinized the prosecution record to address these inquiries when addressing §325(d). Petitioner failed to do so in the petition. And, its attempt to cure that failure in the reply—given that Petitioner now uses the POPR as a roadmap to cure deficiencies in its allegations of material error—amounts to improper burden shifting that should be rejected and/or given little to no weight.

In more detail, the Petition’s 325(d) analysis is a single, 104-word paragraph (Petition, 109-110), alleging that the Petition relies on “new” art that discloses certain features not taught by “references considered during examination.” Given that the first prong of *Advanced Bionics* requires determining whether the “same or ***substantially the same***” art was previously presented to the Office, it was not enough for the petition to simply state that it relies upon “new” art. Noticeably absent from the Petition’s 325(d) analysis is any assessment or comparison of the art considered during prosecution with the Petition’s art. Notwithstanding this deficiency, the POPR identified multiple record references—many that were applied in an office action—to show that substantially the same art was considered during prosecution.

Additionally, Petitioner failed to meet its burden of demonstrating an error material to patentability during prosecution. The only possible allegation of error in the Petition's 325(d) analysis (pp. 109-110) is the identification of features—wireless charging, ceramic cover, convex shapes—that were allegedly absent from the art of record. But, as the POPR explains, this identification of features does not demonstrate an error material to patentability because these features are not what led to allowance and therefore, are features that are necessarily disclosed by the art of record. POPR, 35-39. Specifically, the claims were allowed in view of a specific device configuration where the device's rear cover/opening enables transmission of optical signals to/from a biosensor module and wireless power signals to a wireless charging coil. *See id.* So, the ancillary features like wireless charging, ceramic cover, and convex shapes, did not lead to allowance here. And given that these ancillary features did not lead to allowance, it follows that the Examiner found them to be disclosed by the art of record. This was confirmed by the POPR (pp. 35-40), which provided multiple references from the prosecution record disclosing these features.

The POPR further explained lack of material error because the art of record, like the Petition's references, lacked the specific device configuration that was found to be allowable. Petitioner was on notice of what led to allowance, but failed to address this foreseeable issue in its 325(d) section. The Reply attempts to remedy that failure by referencing the reasons for allowance and offering a multi-page analysis

(Reply, 4-7) to argue that the Petition's combinations/motivations were not previously considered and thus constitute error. No such argument is in the Petition.

The current record presents a clear case of improper burden shifting, with Petitioner presenting a cursory and deficient 325(d) analysis in its Petition, and attempting to cure that deficiency after having the benefit of reviewing the POPR's detailed rebuttal arguments. Petitioner, however, had the burden to demonstrate material error during prosecution, and its Petition should have addressed the very issues/arguments it now presents in its Reply. Indeed, a regime where Petitioners are allowed to use replies to remedy terse and deficient 325(d) arguments in the petition is (1) ripe for abuse as it allows circumventing established word counts for the petition and (2) encourages gamesmanship by Petitioners who can use the POPR's arguments as a roadmap to address deficiencies on issues where they alone bear the burden. Both concerns are at issue here. Thus, Petitioner's attempt to cure its failure to meet its burden should be rejected and its reply should be given little or no weight.

Even if considered, the Reply confirms the cumulative nature of the Petition's references, and its new arguments regarding material error during prosecution fail to pass muster, as explained below.

## **II. Petitioner's Reply Confirms that the that the Art of Record Is Substantially the Same as the Petition's References**

As a starting point, the claims here were allowed because they recited a particular device configuration of a rear cover/opening facilitating transmission/receipt

of optical signals to/from the device's biosensor module and transmission of wireless power signals to the device's wireless charging coil. Ex. 1002, 1269-78. Petitioner incorrectly limits the allowability to the presence of wireless charging coil and the device's wireless charging capability (Reply, 2). With the proper framing of the features that led to allowance, there can be no dispute that the multiple record references identified in the POPR are cumulative of the Petition's references for two reasons.

*First*, like the art of record, the Petition's references do not disclose the above-described specific device configuration. Petitioner does not dispute this.

*Second*, like the art of record, the Petition's references individually disclose a device that (1) either facilitates optical signal transmission to/from an alleged biosensor module via the rear opening/cover of the device (Kotanagi), or facilitates wireless power transmission to a wireless charging receive coil via the rear opening/cover of the device (Honda), and (2) can facilitate both biosensing and wireless charging. For example, Petitioner concedes that, like Kotanagi, Yuen—a reference that was applied in a rejection—discloses a wrist-worn device with rear biosensors that facilitate transmission of optical signals via device's rear cover/opening. Reply, 2. Despite this similarity, Petitioner argues that Kotanagi is superior to Yuen because, unlike Yuen, Kotanagi allegedly discloses wireless charging. *Id.* Kotanagi, however, does not disclose a wireless charging coil or wireless signal transmission via the device's rear portion. At best, Kotanagi discloses a wrist-worn device that

facilitates both biometric sensing and wireless charging. However, multiple references, including Mistry which was applied in a rejection, disclosed devices with both these capabilities—which Petitioner does not dispute. POPR, 32; Reply, 3.

Similarly, Honda is also cumulative to the multiple references of record in that, while disclosing wrist-worn devices with a wireless charging coil and dual wireless charging and biometric sensing capabilities, Honda and these references do not disclose or suggest the features that led to allowance—namely, a wrist-mounted device that facilitates **both** wireless charging and optical signal transmission via the device’s rear cover/opening. Indeed, the Reply does not dispute that the Applicant-cited Mooring reference, like Honda, discloses a device-side wireless charging coil that receives wireless power signals via the device’s rear opening/cover. Reply, 2. Nor does the Reply dispute that Mooring additionally teaches watches with biometric sensing capabilities. POPR, 32. And, again, this teaching of a device with biometric sensing and wireless charging capabilities was not limited to Applicant-identified references like Mooring, but was also present in references, like Mistry, that were applied by the Examiner during prosecution.

As to claim 1’s recitation of a ceramic cover, which Petitioner interprets as including glass or sapphire, the Examiner did not identify this as a feature that led to allowance. Thus, it stands to reason that this feature was disclosed by the art of record, as confirmed by (1) the Examiner’s finding that “Burton teaches that sapphire

is a commonly employed material for watch crystals or covers” and (2) Yuen’s rear glass cover, which the Examiner expressly identified as part of his rejection. POPR, 33-35. The Examiner’s finding in view of Burton was not limited to front covers as Petitioner incorrectly argues, and the alleged absence from the record of the Petition’s identified “authorities” that allegedly “show glass is a subset of ceramics” does not make Yuen any less cumulative to the Petition’s references. Reply, 3-4.

### **III. The Reply Abandons the Petition’s Allegations of Material Error in Favor of Three New Arguments, Each of Which Should be Rejected**

*First*, the Reply states that error can be shown based on the Petition’s reliance on the Jabori and Fraser references that Apple has not argued as cumulative of the art of record. Reply, 7. Petitioner improperly imposes a burden of showing cumulativeness on Patent Owner, and omits that the Petition’s 325(d) analysis (pp. 109-110) was limited to independent claims and did not allege error based on these references as relied upon for dependent claims. This new argument should be rejected.

*Second*, the Reply incorrectly states that it was error to not consider Yuen’s glass cover a ceramic. The Examiner relied upon Yuen’s glass cover in forming claim rejections and subsequently, did not include ceramic cover as a feature that led to allowance. The record thus confirms that ceramics were considered as disclosed by the art of record and the Examiner did not err with respect to the “ceramic” feature. Similarly, arguing that an Applicant-cited reference, Mooring, was not “sufficiently evaluated” is a red herring. Reply, 7. Like the allegations in Honda, Mooring

teaches wireless charging signals transmitted to a charging coil via a device's rear cover. To argue error, Petitioner had to contend that Mooring does not have this teaching (which it can't do) or that the Office made another error material to patentability. The only allegation of error in the Petition is identification of certain features, which again were disclosed by the art of record.

*Third*, the Reply presents multiple pages of analysis (Reply, 4-6) to argue that the combinations and motivations presented in the Petition are not cumulative of the art of record, and "so examination was flawed." Reply, 7. At the outset, the POPR explained flaws in the Petition's combination and motivation arguments, which the Reply acknowledges and does not dispute. POPR, 42-51; Reply, 5. Thus, there was no error material to patentability based on the presented combinations. More importantly, the Reply's arguments—that error stems from the non-consideration of the presented combinations—could have been raised in the Petition. Petitioner's strategy of delaying until the Reply to advance these detailed allegations unduly prejudices Patent Owner and amplifies the above-described concerns of gamesmanship and abuse of process stemming from such belated presentation of arguments on an issue where Petitioner alone bears the burden.

These and the reasons in the POPR warrant denial of the Petition under 325(d).

Case No. IPR2023-00634  
Attorney Docket No: 50095-0144IP1  
Respectfully submitted,

Date: August 14, 2023

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on August 14, 2023, a complete and entire copy of this Patent Owner's Pre-Institution Sur-Reply was provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

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