

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASIMO CORPORATION,
Petitioner,

v.

APPLE INC.,
Patent Owner.

Case IPR2023-00664
Patent 11,106,352

PATENT OWNER'S SUR-REPLY

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EXHIBITS

APPLE-2001	U.S. Patent Publication No. 2020/0333935 (“Tyler”)
APPLE-2002	U.S. Provisional Application No. 62/507,181
APPLE-2003	Declaration and CV of Dr. Andy Cockburn
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APPLE-2005	Transcript of Second Deposition of Dr. Craig Rosenberg
APPLE-2006	U.S. Patent Application No. 15/715,005
APPLE-2007	U.S. Patent Application No. 16/915,971
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I. INTRODUCTION

Apple Inc. (“Patent Owner”) submits this Patent Owner’s Sur-reply to Petitioner’s Reply (“Reply”) for *Inter Partes* Review of U.S. Patent No. 11,106,352 (“the ’352 Patent”) filed by Masimo Corporation (“Petitioner”).

The Reply does not cure the failure of the prior art cited in the Petition to render the challenged claims obvious. As explained in more detail below, the Reply fails to cure the Petition’s failure to establish how Chae, alone or in combination with other asserted references, renders obvious independent claims 1, 9, and 17 and their dependent claims. *Supra* Section II. In addition, the Reply fails to cure the Petition’s failure to explain how the systems in the cited references render obvious several claim features, such as a “the computer system is in a power saving state” and “a widget screen user interface” limitations. *Supra* Section III.A. In light of these and other deficiencies in the Petition described below, the Board should uphold the challenged claims.

II. THE REPLY DOES NOT CURE THE SHORTCOMINGS IN PETITIONER’S ALLEGED MOTIVATION TO COMBINE CHAE WITH NARENDRA OR ANY OTHER SECONDARY REFERENCE

The Reply does not dispute that Chae and Narendra are directed to entirely different purposes and implementations, nor can it, because as previously explained in the Patent Owner Response, “*Narendra has nothing to do with navigating screens associated with SIM cards* [as in Chae]. Rather, Narendra is

focused on how gestures can be used to *navigate between non-password protected desktop screens and password-protected desktop screens.*” EX1006, [0024], FIGS. 3, 4; POR, 10; APPLE-2003, ¶31. Masimo attempts to diminish this fatal distinction by now abstracting its combination and contending that it relies on Narendra’s general teaching of navigating among screens in two dimensions using swipes and specifically navigating in two dimensions using left and right swipes to move horizontally and up and down swipes to move vertically. Reply, 3-4.

However, Chae already teaches navigating among screens in two dimensions using swipes. EX1005, [0103]-[0104], [0108]-[0111], [0142], [0144], [0148], [0150]-[0151], Figs. 4-7, 19-21. As Masimo’s expert Dr. Rosenberg acknowledges, Chae teaches using bottom-to-top, top-to-bottom, left-to-right, and right-to-left swipes to navigate between screens. EX1056, ¶40; APPLE-2005, 47:16-49:7. Further, Masimo admits that Chae discloses using swipes to access password-protected screens and non-password-protected screens, but nevertheless alleges that Chae would need to be modified based on Narendra’s teachings of navigating between password-protected and non-password-protected screens. Reply, 4-5.

Masimo has a burden to show “why” Chae would have been modified to include Narendra’s teachings, particularly in light of Chae’s provision of the same features and benefits Masimo relies upon for the alleged motivation to combine.

Microsoft Corp. v. Koninklijke Philips N.V., IPR2018-00026, Paper 7, 15 (PTAB April 27, 2018). But Masimo has failed to satisfy its burden by repeatedly failing to provide a sufficient explanation as to why a POSITA would have combined these vastly different references. Additionally, because Chae “already provides for” the features and benefits that is Masimo’s alleged motivation to combine, Masimo’s failure to establish a *prima facie* case of obviousness is reinforced by Masimo’s failure to also explain why the alleged modification to Chae “would have been an improvement on what [the primary system] already provides.” *Sony Corp. v. Fujifilm Corp.*, IPR2018-01751, Paper 14, 11 (PTAB April 12, 2019) (“Petitioner does not explain adequately why modifying [the primary reference] would have been an improvement on what [the primary reference] already provides”). Indeed, the law mandates an “especially strong” inference of “nonobviousness” where the primary reference’s original solution undermines the very reason being proffered as to why the primary reference should be modified. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326 (Fed. Cir. 2009).

Masimo further alleges that the implementation of Narendra’s teachings in “Chae’s multi-SIM-card device would advantageously allow direct navigation from one screen associated with a SIM card to another screen associated with a different SIM card.” Reply, 4. However, Narendra does not teach direct

navigation from a home screen of a first SIM to a home screen of a second SIM. Narendra has nothing to do with navigating screens associated with SIM cards. APPLE-2003, ¶32. Rather, Narendra is focused on how gestures can be used to navigate between non-password protected desktop screens and password-protected desktop screens. EX1006, [0024], FIGS. 3, 4. In fact, as Masimo acknowledged, Narendra's mobile device only includes a single SIM card. Petition, 6 ("Narendra specifically discloses a single SIM smartphone"), 63. Making the combination in the manner Masimo proposes requires Narendra be stripped of the primary purpose of its invention, which is to navigate between password protected and non-password protected screens. Accordingly, a POSITA would have no reason to turn to Narendra when using Chae's system at least because Narendra is entirely unrelated to navigational guidance for a multi-SIM device, which is the focus of Chae. APPLE-2003, ¶32.

This leap in Masimo's reasoning is "a bridge too far," especially because neither Chae nor Narendra mentions direct navigation from one home screen associated with a SIM card to another home screen associated with a different SIM card. *Cook Inc. v. Medtronic Vascular, Inc.*, IPR2018-01570, Paper 7, 17, (PTAB March 4, 2019) (denying institution and holding that Petitioner's reasoning is "a bridge too far" because it is premised on an unsupportable assertion never mentioned in the actual reference itself); *In re Benno*, 768 F.2d 1340, 1346-47

(Fed. Cir. 1985) (reversing the Board’s obviousness ground where “[n]either reference hints at [the claimed] solution”). Masimo demands that the Board should rely on unsupported conclusions that are rooted in error and virtually copied into Dr. Rosenberg’s declaration. *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352, 1359-1360 (Fed. Cir. 2019) (petitioner’s “*ipse dixit* declaration” was not enough). Masimo’s reasoning here invites legal error because the Patent Office cannot rely on “general conclusions” as a “replacement for documentary evidence for core factual findings in a determination of patentability.” *K/S HIMPP v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1366 (Fed. Cir. 2014); *Hulu, Inc. v. Sound View Innovations, LLC*, IPR2018-00582, Paper 34, 21-22 (PTAB “Informative” August 5, 2019) (stating the petitioner’s theory “strikes us as merely a bald statement about what could have been achieved at the time of the invention”).

Masimo further relies on Dr. Cockburn allegedly agreeing that “a two-reference combination need not incorporate every teaching from both references.” Reply, 4. Masimo’s reliance on Dr. Cockburn’s testimony is misplaced as “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only as much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *Application of Wesslau*, 353 F.2d 238, 241 (CCPA 1965). Here, Masimo impermissibly focuses on only Chae’s and

Narendra's general teachings of navigating among screens while ignoring that Chae and Narendra are focused on solving different problems; Chae focuses on how to navigate a multi-SIM-card architecture while Narendra focuses on how to navigate between password-protected and non-password-protected screens.

EX1005, [0003]; EX1006, [0024]; APPLE-2003, ¶¶27, 29. Masimo therefore failed to consider Chae and Narendra in their entirety and thereby ignored those portions of the references that would discourage a POSITA from combining the references. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983). Based on the differences, a POSITA would not have selected and combined Chae and Narendra in the normal course of research and development to yield the claimed invention. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed Cir. 2011); *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1337 (Fed. Cir. 2016).

Additionally, Masimo contends that “in combining Chae and Narendra, a POSITA would have resolved any trivial incompatibility.” Reply, 5-6. However, the incompatibilities are not trivial. In particular, by incorporating the teachings Narendra into the teachings of Chae, a user may navigate between password protected desktop screens and non-password protected desktop screens, but would not be able to navigate between the home screens of two different SIM cards—the primary purpose of Chae. APPLE-2003, ¶33. For instance, as shown in Chae and

Narendra's figures below, an upward swipe would lead to a password protected desktop screen in Narendra and a right swipe would lead to a non-password protected desktop screen. *Id.* But according to Chae's teachings, an upward swipe would lead to the display of a home screen associated with SIM1 and a right swipe would lead to a customized home screen common to both SIM1 and SIM2. *Id.*

As the Board recently stated, it is insufficient to simply show that the alleged modification "*could*" be done, "Petitioner also needs to sufficiently explain why a person skilled in the art *would* have done that, and why, when... so modified, the [device] would still perform the function [it was intended to perform]." *IBM Corp. v. Riegelt & Co., Inc.*, IPR2020-00496, Paper 10, 22 (PTAB Aug. 7, 2020); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) ("[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention." (emphasis in original)); *PersonalWeb Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017) (explaining that it is insufficient to allege the two references "could be combined" to achieve the claim element); *Olympia Tools International, Inc. v. JPW Industries, Inc.*, IPR2018-00388, Paper 8, 19 (PTAB June 20, 2018) (concluding it is "insufficient" to argue "the mere fact that a person having ordinary skill in the art could make such a change" (emphasis added)); *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1299, 1301 (Fed.

Cir. 2009). Modifying Chae in the manner proposed by Masimo would not have been obvious to a POSITA absent the application of extreme hindsight using the '352 Patent as a roadmap. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1337 (Fed. Cir. 2016). “Good ideas may well appear ‘obvious’ after they have been disclosed,” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 956 (Fed. Cir. 1997), but it is not enough to show merely that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011) (explaining that a showing of obviousness additionally requires that a person of ordinary skill at the time of the invention “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention”). Masimo has not provided the required analysis of explaining, based on facts and evidence, **why** a POSITA would have been motivated to make the suggested modification, **how** the asserted combination would have worked, and **why** it would have been an obvious combination to a POSITA—instead relying upon Masimo’s hindsight assumptions. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007); *PersonalWeb Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (vacating a finding of obviousness because “the Board nowhere clearly explained, or cited evidence showing, *how* the combination of the two references was supposed to work” (emphasis in original)); *TriVascular, Inc. v. Samuels*, 812

F.3d 1056, 1066 (Fed. Cir. 2016) (“how or why the references would be combined”). The Board should avoid such hindsight assumed by Masimo and Dr. Rosenberg.

The Petition’s general motivation-to-combine section alleges that convenience, efficiency, and ease of use would have provided a general motivation to combine, which is also repeated throughout the Petition as specific motivations to combine and again repeated for the Shuttleworth combinations. Pet., 33, 63, 74-77, 79-80, 87; Reply, 7-8. The Federal Circuit has found such general motivations to be insufficient. *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (rejecting the motivations “to build something better,” “more efficient, cheaper, or... had more features,” or “more attractive to customers”); *TQ Delta, LLC v. Cisco Systems Inc.*, 942 F.3d 1352, 1360 (Fed. Cir. 2019) (“We rejected this testimony because it ‘fail[ed] to explain why a person of ordinary skill in the art would have combined elements from specific references in the way the claimed invention does.’”).

Masimo advances many different grounds, some, like Grounds 5 and 6, involving a five reference combination. Apple explained in its Response that the Petition does not explain what these various combinations would look like. POR, 13-15; APPLE-2003, ¶37. Indeed, the petition does not even explain which reference modifies another reference, or how and why certain features of a

particular reference would have been combined with other features of another reference. *Id.* The Reply also fails to cure this deficiency of the Petition.

For the various foregoing reasons, the Reply fails to cure the deficiencies of the Petition to establish why the combination of any two or more of Chae, Narendra, Android, Shuttleworth, Hong, and Karunamuni would have been obvious.

III. THE REPLY FAILS TO CURE DEFECTS IN GROUNDS 1 AND 4

A. The Reply does not cure the failure of the cited prior art to render independent claims 1, 9, and 17 obvious

1. Chae alone and in combination with any other asserted reference do not render obvious “the computer system is in a power saving state” (limitations 1c, 9c, 17c)

The Reply still fails to cite to any disclosure in either Chae or Android that describes a power saving state or the operations of a mobile terminal when in a power saving state. Reply, 9. Chae’s disclosure of the mobile terminal “wak[ing] up” involves turning on the touch screen. EX1005, [0094]-[0095], [0140]. Chae does not disclose that the mobile terminal was in a power saving state prior to turning on the touch screen. APPLE-2003, ¶¶42-43. A display that is part of a computer system and consumes less power when off does not necessarily mean that the computer system as a whole (Chae’s mobile terminal) is in a power saving state. *Id.*; APPLE-2005, 28:1-6 (“one could have a program running on the computer that causes the phone to use more power when the display is off”), 31:2-

5 (“someone could program the system to purposely use more power when the display was off than when it was on”). It is Masimo’s burden to establish that Chae’s mobile terminal is in a “power saving state” when the mobile terminal’s display is turned off. But Masimo failed to satisfy its burden, and instead assumed that Chae’s mobile terminal would have operated in a power saving state when the mobile terminal’s display device is turned off.

Chae’s mobile terminal includes numerous components, e.g., wireless communication unit 110, an audio/video (A/V) input unit 120, a user input unit 130, a sensing unit 140, an output unit 150, a memory 160, interface unit 170, a controller 180, and power supply unit 190, any of which could be consuming more power than the reduction in power potentially achieved by turning the display off. EX1005, [0044]-[0062].

Masimo cites a portion of Bandyopadhyay, which does not support Masimo’s assertions that Chae’s mobile terminal is in a power saving state when the display is off. Reply, 9. The cited portion of Bandyopadhyay merely describes that “the display is locked and in a sleep state” where “the touch panel display is not illuminated and any sensor functionality is disabled” and thus is in “a low-power mode.” EX1019, 4:39-65. This disclosure does not indicate that the mobile device as a whole is in a power saving state and does not support Masimo’s assertion that smartphones routinely turn off their displays during periods of

inactivity to save power.

As such, the Reply fails to cure the deficiencies of the Petition to show that Chae alone or any combination of Chae, Narendra, Hong, and Android renders obvious “the computer system is in a power saving state,” as required by limitation 1c.

2. Chae, alone or in combination with any other asserted reference, does not render obvious “a widget screen user interface that is different from... the home screen user interface,” “a respective user interface object... contains application content” and “when selected, causes display of an application” (limitations 1g, 9g, 17g)

The Reply fails to cite to any disclosure in Chae that the icons (including the Lauren icon, Chris icon, and weather icon) in the center of FIG. 6(b) are the claimed “user interface objects” of the widget screen user interface. Reply, 10-13. In fact, Dr. Rosenberg admitted during deposition that Chae contains no such disclosure. APPLE-2005, 54:21-22 (“Chae doesn’t talk about the weather icon”), 56:9-14 (“they’re not spoken about specifically”). Dr. Cockburn also confirmed that “Chae does not disclose the requirements of this limitation.” EX1057, 100:19-101:8. Masimo also does not dispute that Narendra contains no details suggesting that widgets correspond to applications, contain application content, and cause display of applications. Reply, 10-13.

Masimo argues that Apple’s interpretation that Hong does not teach or

suggest displaying the application when the widget is selected is implausible.

Reply, 12. The only support for this assertion is Rosenberg's declaration parroting the Reply. EX1056, ¶32; *Cf. TQ Delta, LLC v. Cisco Systems Inc.*, 942 F.3d 1352, 1362-63 (Fed. Cir. 2019) (reversing a PTAB finding of obviousness that was based on an "*ipse dixit* declaration"). Masimo and Dr. Rosenberg fail to recognize that in Hong, there is no reason to execute the application because the widget provides all the functionality needed to interact with the application without executing the application. EX1010, [0066]-[0069], [0073]-[0077], [0088], FIGS. 5A-5C.

Specifically, Hong discloses that the "preview application screen displayed on display unit 160 via the widget may be identical to the application screen shown when the user actually executes the application" and the widget can display "the entirety of an application screen." EX1010, [0068]-[0069], [0088]. Hong also discloses that "the user may select a desired portion or object from the entire preview of the application screen" and

The object selected by the user may be an item that would be displayed on display unit 160 of electronic device 100, if the application were executed. The object may be an image or text, for example, a window, a menu, a function item (or a menu item), a document, a picture, a video, an e-mail, an SMS message, an MMS message, and/or the like. The object may be selected, executed, deleted, cancelled, stored, or changed by user input. The object may

be used as a meaning that includes a button, a short-cut icon, thumbnail image, or a folder that stores one or a plurality of objects in the electronic device 100.

EX1010, [0068]. As an example, Hong describes displaying a preview screen of a settings application with objects for configuring motion recognition, user accounts, etc. without executing the application. EX1010, [0073]-[0077], FIGS. 5A-5C.

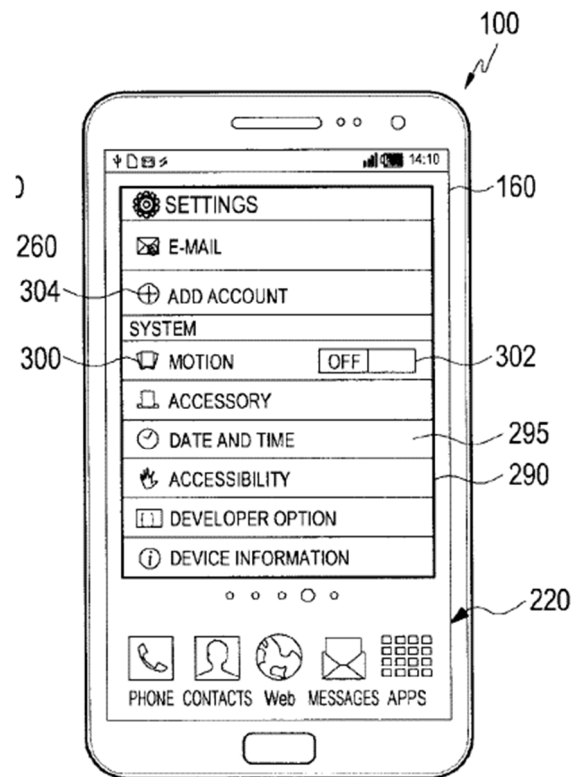


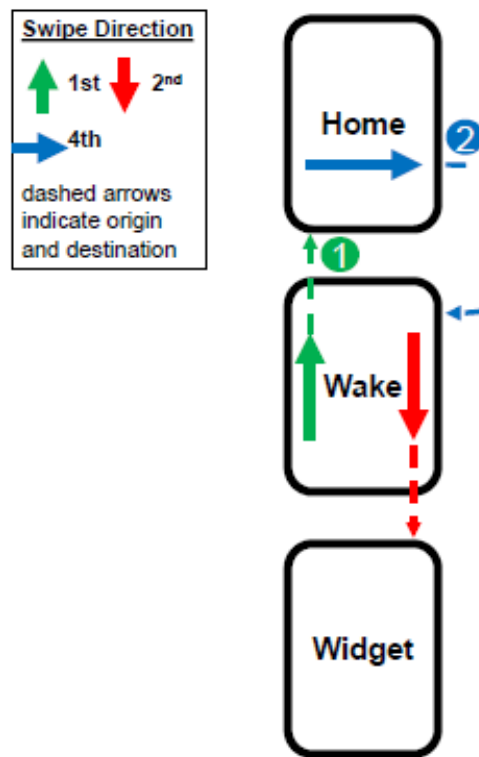
FIG.5C

With respect to Android, the Reply has not shown that Android displays the application when the widget is selected, rather than providing a preview of the selection within the widget without executing the application as similarly described in Hong. *See* EX1007.

Accordingly, the Reply fails to cure the deficiencies of the Petition to show that Chae alone or any combination of Chae, Narendra, Hong, and Android renders obvious “a respective user interface object... contains application content” and “when selected, causes display of an application,” as required by limitation 1g, 9g, and 17g.

B. The Reply does not cure the failure of the cited prior art to render claims 6, 14, and 22 obvious

Claim 6 depends on claim 1. Therefore, the navigational path for claim 6 must build on Chae’s navigational path that the Petition mapped to claim 1—that the first direction is a “bottom-to-top direction,” and the second direction is a “top-to-bottom direction.” Pet., 46, 51. As a result, Masimo’s asserted combinations for claim 6 must show a “fourth direction” that is perpendicular (left-to-right or right-to-left) to the “first direction” and the “second direction” in order to meet claim 6’s requirement of “a fourth direction that is different from the first direction and the second direction.” Masimo understood this by providing in the Petition the following graphical representation for claim 6:

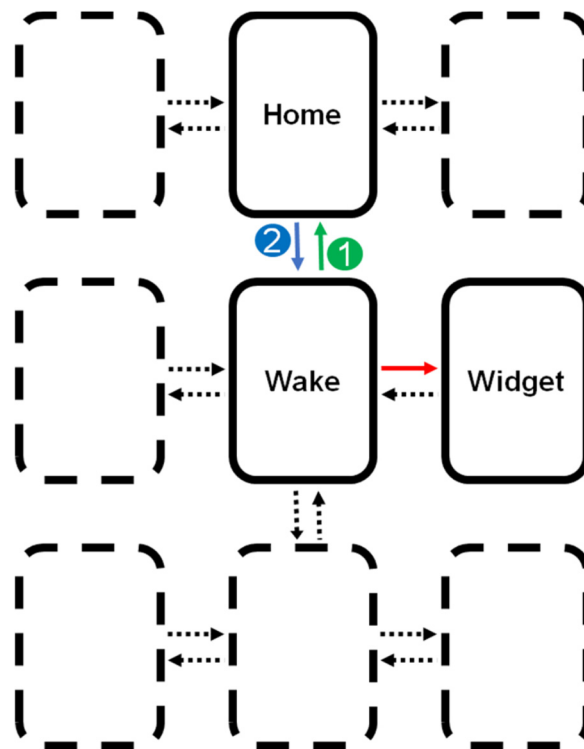


Pet., 68. Masimo and Dr. Rosenberg acknowledge that the “prior art does not explicitly disclose the exact navigational paths between certain screens of some dependent claims.” Reply, 1-2; EX1056, ¶10. But Masimo argues that the “obviousness of claim 6 does not rely on Chae itself,” but rather “it would have been obvious to modify Chae in view of Narendra’s teachings.” Reply, 18. As explained above in Section II, a POSITA would not have been motivated to modify Chae in view of Narendra’s teachings. Also, Narendra does not teach adding a swipe to “return to the wake screen to allow the user to lock the smartphone,” as Masimo alleges. *Id.*

Masimo does not explain why using a different swipe gesture for returning

to the wake screen would reduce the likelihood of user confusion or inadvertent access of the wake screen. Reply, 19-21; Pet., 69-70. Regardless of the direction of the swipe gestures, a user would still be required to determine when certain motions cause different actions. APPLE-2003, ¶51. A perpendicular swipe direction would not reduce the likelihood of user confusion or inadvertent access any more than a parallel and opposite direction.

Apparently recognizing the flaws in its Petition, Masimo's Reply presents a new theory relying on a different navigational path that also is not disclosed by the prior art:



Reply, 22; APPLE-2005, 59:8-20 (“it wasn’t in the first [declaration]”). Neither Chae nor Narendra disclose navigating to a home screen from the wake screen

using a **bottom-to-top** swipe and navigating to a widget screen from the wake screen using a **left-to-right** swipe. One embodiment of Chae uses a **bottom-to-top** swipe to unlock SIM1 and display its customized home screen, a **top-to-bottom** swipe to unlock SIM2 and display its customized home screen. EX1005, [0103]-[0104], [0108]-[0111]. A second embodiment uses a **right-to-left** swipe to unlock SIM1 and display its customized home screen and a **left-to-right** swipe to unlock SIM2 and display its customized home screen. EX1005, [0142], [0144], [0148], Fig. 19. Third and fourth embodiments use a **bottom-to-top** swipe to unlock SIM1 and display its customized home screen and a **top-to-bottom** swipe to unlock SIM2 and display its customized home screen. EX1005, [0142], [0144], [0150]-[0151], Figs. 20-21. There is no embodiment disclosed in Chae that uses a **bottom-to-top** swipe to unlock SIM1 and display its customized home screen (which Masimo maps to the claimed “home screen”), a **left-to-right** swipe to unlock SIM2 and display its customized home screen (which Masimo maps to the claimed “widget screen”).

The Reply’s flawed reliance on Chae’s and Narendra’s teachings assumes too much and plainly does not satisfy Masimo’s burden under §316(e), especially where petitioners cannot subsequently add theories/arguments that should have been part of the original Petition. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost

importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”); *In re Magnum Oil Tools Int’l*, 829 F.3d 1364, 1378-80 (Fed. Cir. 2016) (“could have been included in a properly-drafted petition, but was not”); *n re Nuvasive*, 841 F.3d 966, 977 (Fed. Cir. 2016) (“no notice”); *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2154 (2016) (Alito, J. concurring in part and dissenting in part) (“if the Patent Office institutes review on claims or grounds not raised in the petition—the patent owner is forced to shoot into the dark. The potential for unfairness is obvious.”).

Masimo contends that it is enough that Chae and Narendra teach an entire genus of directional swipes (“fundamental concept of navigating between... screens”), without any explicit reasoning why a POSITA would have selected a particular species of directional swipe from Chae and Narendra’s disclosures of this genus. The law requires more for Masimo to satisfy its burden here. *Knauf Insulation, Inc. v. Rockwool Int’l A/S*, 788 Fed. Appx. 728, 2019 U.S. App. LEXIS 30634, 2019 U.S.P.Q.2D (BNA) 392768, *10 (Fed. Cir. 2019). Indeed, the Federal Circuit recently explained:

It is not enough, even after *KSR*, to support a determination of obviousness that a reference includes a broad generic disclosure and a common utility to that in the claims and other prior art

references—there must be some reason to select a species from the genus.

Id. (emphasis added) (vacating the Board’s obviousness decision, and citing to *In re Jones*, 958 F.2d 347, 350-51 (Fed. Cir. 1992); *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-57 (Fed. Cir. 2007)); *see also Wasica Fin. GmbH v. Cont’l Auto. Sys.*, 853 F.3d 1272, 1278 (Fed. Cir. 2017) (“disclosure of a genus in the prior art is not necessarily a disclosure of every species that is a member of that genus” (citations omitted)).

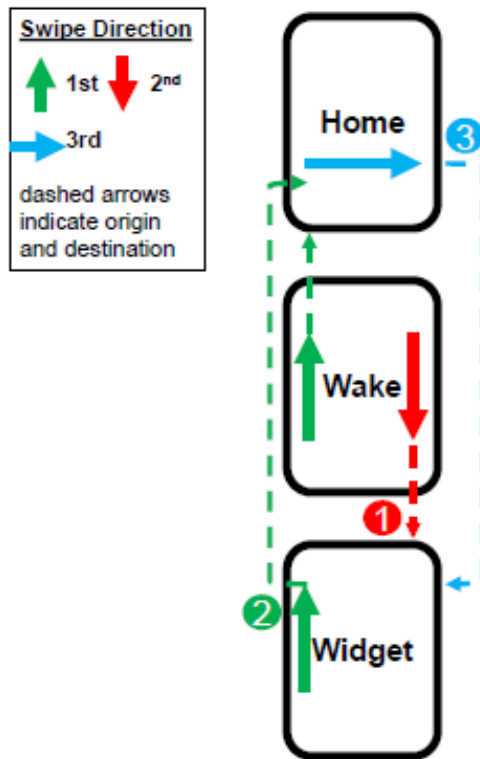
Even for this new theory, Masimo does not explain why it “would achieve the Petition-identified advantage of allowing a user to easily access commonly used screens from the home screen while reducing inadvertent wake-screen access.” Reply, 23. Regardless of the direction of the swipe gestures, a user would still be required to determine when certain motions cause different actions. APPLE-2003, ¶51. A particular swipe direction would not reduce the likelihood of user confusion or inadvertent access any more than a different swipe direction.

Accordingly, the Reply fails to cure the deficiencies of the Petition to show that Chae alone, or in combination with any other reference, renders obvious claim 6. As such, Petitioner has failed to carry its burden to show unpatentability of claim 6.

IV. THE REPLY FAILS TO CURE DEFECTS IN GROUNDS 2 AND 5

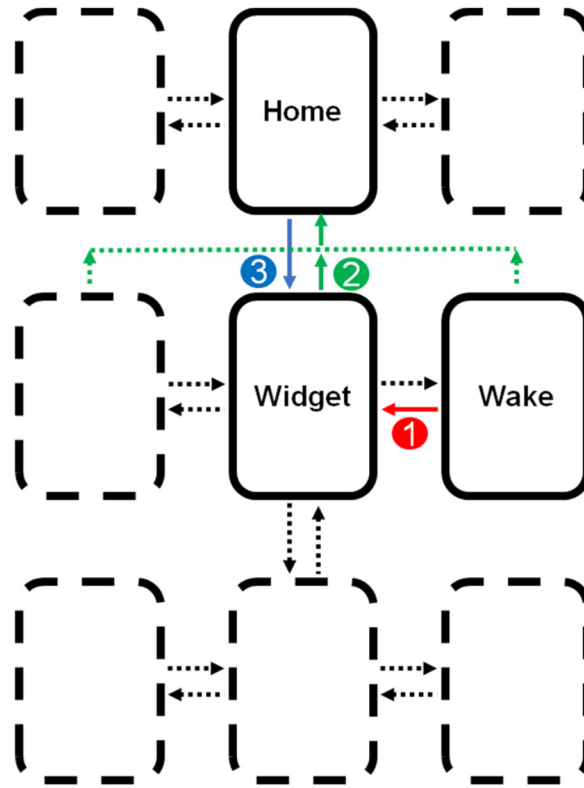
A. The Reply does not cure the failure of the cited prior art to render claims 4, 12, and 20 obvious

Claims 4, 12, and 20 each depend indirectly on claims 1, 9, and 17, respectively. Therefore, the navigational path for claims 4, 12, and 20 must build on Chae's navigational path that the Petition mapped to claims 1, 9, and 17—that the first direction is a “bottom-to-top direction,” and the second direction is a “top-to-bottom direction.” Pet., 46, 51. As a result, Masimo's asserted combinations for claims 4, 12, and 20 must show a “third direction” that is perpendicular (left-to-right or right-to-left) to the “first direction” and the “second direction” in order to meet the claims' requirement of “a third direction that is different from the first direction and the second direction.” Masimo understood this by providing in the Petition the following graphical representation for claims 4, 12, and 20:



Pet., 77. Masimo and Dr. Rosenberg acknowledge that the “prior art does not explicitly disclose the exact navigational paths between certain screens of some dependent claims.” Reply, 1-2; EX1056, ¶10. And for the reasons explained above in Section II, a POSITA would not have been motivated to modify Chae in view of Narendra’s and Shuttleworth’s teachings.

Apparently recognizing the flaws in its Petition, Masimo’s Reply presents a new theory relying on a different navigational path that also is not disclosed by the prior art:



Reply, 25. None of Chae, Narendra, or Shuttleworth disclose navigating to a home screen from the wake screen using a *bottom-to-top* swipe and navigating to a widget screen from the wake screen using a *right-to-left* swipe. For the reasons discussed in Section III.B, there is no embodiment disclosed in Chae that uses a *bottom-to-top* swipe to unlock SIM1 and display its customized home screen (which Masimo maps to the claimed “home screen”), a *right-to-left* swipe to unlock SIM2 and display its customized home screen (which Masimo maps to the claimed “widget screen”).

Here again, the Reply’s flawed reliance on Chae’s, Narendra’s, and Shuttleworth’s teachings assumes too much and plainly does not satisfy Masimo’s

burden under §316(e). Further, Masimo contends that it is enough that Chae, Narendra, and Shuttleworth teach an entire genus of directional swipes, without any explicit reasoning why a POSITA would have selected a particular species of directional swipe from Chae's, Narendra's, and Shuttleworth's disclosures of this genus. The law requires more for Masimo to satisfy its burden here.

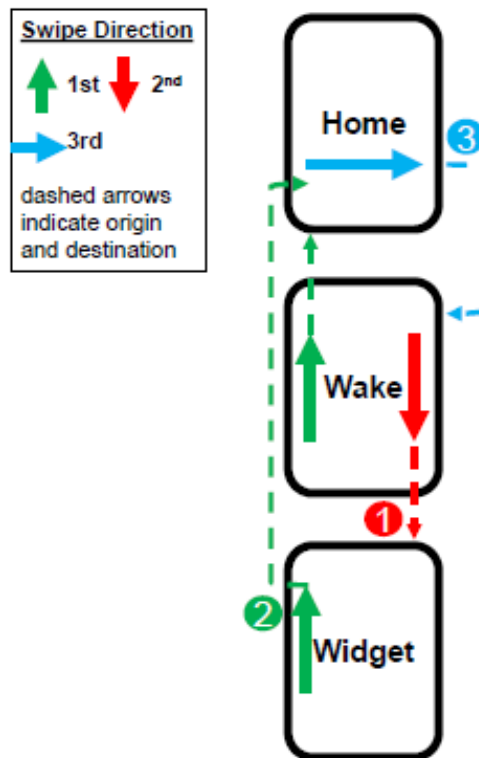
Even for this new theory, Masimo does not explain why it would achieve “the efficiency of direct home-screen access” and “scalability for non-home screens.” Reply, 25-26. A particular swipe direction would not provide more efficiency of direct home-screen access and scalability for non-home screens any more than a different swipe direction.

Accordingly, the Reply fails to cure the deficiencies of the Petition to show that Chae, in combination with any other reference, renders obvious claims 4, 12, and 20. As such, Petitioner has failed to carry its burden to show unpatentability of claims 4, 12, and 2.

B. The Reply does not cure the failure of the cited prior art to render claims 5, 13, and 21 obvious

Claims 5, 13, and 21 each depend indirectly on claims 1, 9, and 17, respectively. Therefore, the navigational path for claims 5, 13, and 21 must build on Chae's navigational path that the Petition mapped to claims 1, 9, and 17—that the first direction is a “bottom-to-top direction,” and the second direction is a “top-

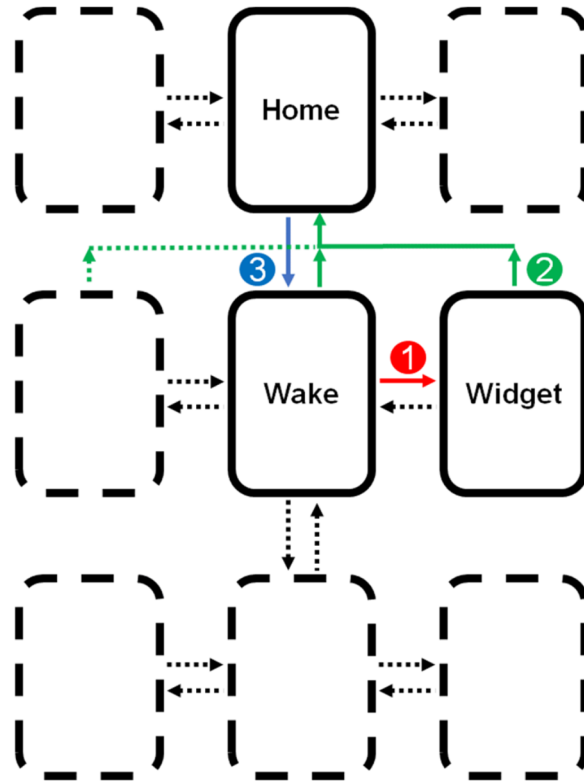
to-bottom direction.” Pet., 46, 51. As a result, Masimo’s asserted combinations for claims 5, 13, and 21 must show a “third direction” that is perpendicular (left-to-right or right-to-left) to the “first direction” and the “second direction” in order to meet the claims’ requirement of “a third direction that is different from the first direction and the second direction.” Masimo understood this by providing in the Petition the following graphical representation for claims 5, 13, and 21:



Pet., 81. Masimo and Dr. Rosenberg acknowledge that the “prior art does not explicitly disclose the exact navigational paths between certain screens of some dependent claims.” Reply, 1-2; EX1056, ¶10. And for the reasons explained above in Sections II and III.B, a POSITA would not have been motivated to

modify Chae in view of Narendra's teachings.

Apparently recognizing the flaws in its Petition, Masimo's Reply presents a new theory relying on a different navigational path that also is not disclosed by the prior art:



Reply, 27. Neither Chae nor Narendra discloses navigating to a home screen from the wake screen using a **bottom-to-top** swipe and navigating to a widget screen from the wake screen using a **left-to-right** swipe. For the reasons discussed in Section III.B, there is no embodiment disclosed in Chae that uses a **bottom-to-top** swipe to unlock SIM1 and display its customized home screen (which Masimo maps to the claimed “home screen”), a **left-to-right** swipe to unlock SIM2 and

display its customized home screen (which Masimo maps to the claimed “widget screen”).

Yet again, the Reply’s flawed reliance on Chae’s and Narendra’s teachings assumes too much and plainly does not satisfy Masimo’s burden under §316(e). Further, Masimo contends that it is enough that Chae and Narendra teach an entire genus of directional swipes, without any explicit reasoning why a POSITA would have selected a particular species of directional swipe from Chae and Narendra’s disclosures of this genus. The law requires more for Masimo to satisfy its burden here.

Accordingly, the Reply fails to cure the deficiencies of the Petition to show that Chae in combination with Narendra, Shuttleworth, Hong, and/or Android renders obvious claims 5, 13, and 21. As such, Petitioner has failed to carry its burden to show unpatentability of claims 5, 13, and 21.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board confirm the patentability of the challenged claims.

Respectfully submitted,

Date: May 1, 2024

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CERTIFICATION UNDER 37 C.F.R. §42.24(d)

Under the provisions of 37 C.F.R. §42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Sur-reply totals 5,252, which is less than the 5,600 allowed under C.F.R. §42.24(b)(2).

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on May 1, 2024, a complete and entire copy of this Patent Owner's Sur-reply and its exhibits were provided via email, to the Petitioners by serving the correspondence addresses of record as follows:

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