

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL
BOARD

MASIMO CORPORATION
Petitioner,

v.

APPLE INC.,
Patent Owner

Case IPR2023-00728
U.S. Patent D962,936

PATENT OWNER'S PRELIMINARY RESPONSE

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LIST OF EXHIBITS

Exhibit Number	Description
2001	Declaration of Lance Gordon Rake
2002	Replacement Drawings filed in U.S. Design Patent Application 29/816,024 on December 14, 2021
2003	<i>Aries Watches Watch AW80 – Unisex,</i> https://allegro.pl/oferta/smartwatch-zegarek-ekg-pulsoksymetrtermometr-pl-9927412179 .
2004	<i>P11 Plus 0.96 Inch Screen ECG+HRV Smart Health Bracelet, Support Body Temperature, Dynamic Heart,</i> Newegg.com, http://www.newegg.com/p/3EG-000R-000F7 .

I. INTRODUCTION

Masimo's Petition challenging U.S. Patent No. D962,936 ("the '936 patent") is deficient in multiple ways. The problems with Masimo's Petition begin with its claim construction, which focuses on design concepts that fail to accurately portray the actual claimed design, and which improperly "factors out" multiple ornamental features significant to the design's cohesive overall appearance. Rather than address the claimed aspects that contribute to its concentric circle overall appearance, and the differences from the prior art, Masimo's analysis obscures the design without the required analysis relative to the cited references, each of which have fundamental differences that contrast with the overall appearance of the '936 patent.

For at least the reasons explained below, Masimo fails to demonstrate a reasonable likelihood that the design claim is unpatentable. The Petition should be denied.

II. BACKGROUND

Apple is known as an innovator in consumer products and a leader in industrial design. Apple's innovative products are produced through its significant investment in research and development in technology and product design. Each product is meticulously created to be appealing and sleek, with numerous iterations to perfect the design of each product and to incorporate aesthetic themes that run through the Apple products.

The Apple Watch is no exception, and has been a best-seller and consumer favorite in part due to its innovative, stylish, and distinctive style. The design claimed in the '936 patent is the result of tremendous design efforts to produce a consumer-wearable product incorporating signature Apple design qualities such as elegant and simple designs that echo themes in other Apple products. As discussed in greater detail below, a Designer of Ordinary Skill (“DOSA”) would have recognized these qualities of the overall claimed design, and appreciated the efforts underlying the design that immediately distinguish its appearance from prior designs.

III. LEVEL OF ORDINARY SKILL

For the purposes of this case, a Designer of Ordinary Skill in the Art (“DOSA”) would have a degree in Industrial Design or Mechanical Engineering, and at least two years of professional experience creating Industrial Designs of consumer products. EX2001, ¶19.

IV. MASIMO CANNOT PREVAIL ON ANY CHALLENGED CLAIM

A. Masimo’s Proposed Claim Construction Ignores Features of the Claimed Design and Relies on General Design Concepts

Masimo’s proposed claim construction is deficient because it fails to address prominent features of the claimed design and, critically, the contributions of those features to the overall appearance. *See Skechers U.S.A., Inc. v. Nike, Inc.*, IPR 2017-00617, Paper 13 at 7-8 (PTAB July 6, 2017) (“While we recognize that the

illustration, rather than a verbal description, is the better representation of the claimed design ... Petitioner’s verbal description in these cases does not go far enough.”). While a verbal description may not always be necessary, any verbal description must identify readily observable features of the claimed design that impact its overall appearance. *See Skechers*, IPR2017-00617, Paper 13 at 8; *see also Vitro Packaging, LLC v. SaverGlass, Inc.*, IPR2015-00947, Paper 13 at 5 (PTAB Sept. 29, 2015) (“We are not persuaded that this is an accurate portrayal of the claimed bottle because it focuses on general dimensions, ratios, and elements common to many bottles.”). As described below, this error infects each of Masimo’s grounds, and therefore compels denial of the Petition. *See, id.* at 13 (denying institution, stating, “[w]e do not find Petitioner’s arguments persuasive because Petitioner focuses on design concepts rather than actual appearance and specific design characteristics.” (citation omitted)).

The ’936 patent claims a unique, elegant design for an “electronic device” that has an overall appearance of concentric circles. EX2001, ¶¶20-23; EX1001, Figs. 1-9; EX2002, Figs. 1-9.¹ As illustrated below, the claimed design includes a

¹ EX2002 is the supplemental drawings filed with the USPTO on December 14, 2021.

protruding circular element having a concentric circular arrangement contained within an outermost continuous circle (blue). *Id.* An outer circular shape is formed by thin, elongated arches positioned within the outermost continuous circle (red). *Id.*

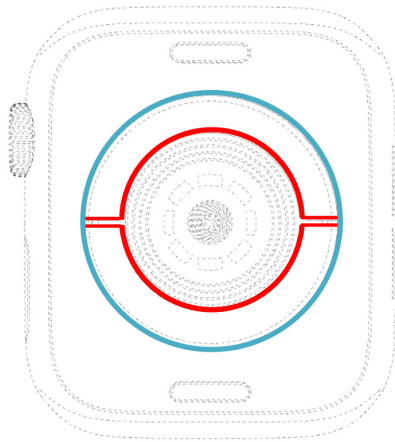


FIG. 4

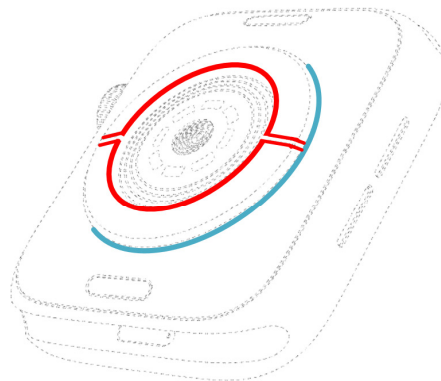


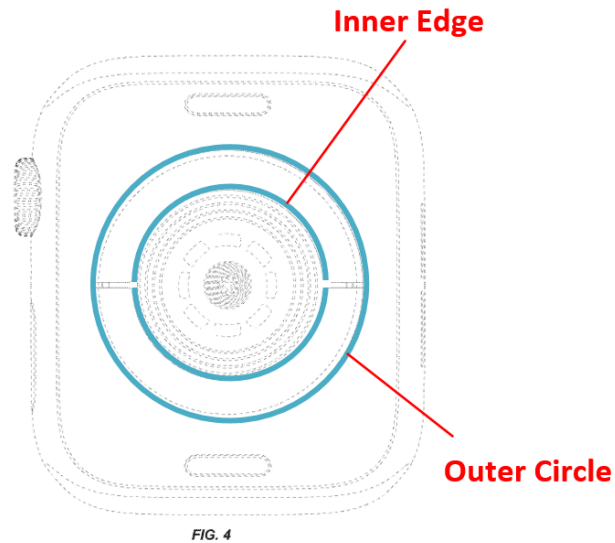
FIG. 2

EX2001, ¶20 ((EX1001, Figs. 2 and 4 (annotated))).

Each of these aspects are readily observable features that contribute to the overall appearance of the claimed design. *Id.*

The distance between the inner edge of the arches and the outermost continuous circle is small compared to the diameter of the outermost continuous circle, contributing to the appearance of an elegant, precise and streamlined shape.

EX2001, ¶21. The physical position of the arch shapes, and their elongate proportions compared to the outermost continuous circle, suggests a unified, continuous circle despite the arch shapes not touching each other. *Id.*



EX2001, ¶21 (EX1001, Fig. 4 (annotated)).

Masimo largely ignores these immediately observable features in its claim construction. *See* Pet., 11. For example, Masimo describes the '936 patent's design as "two arc-shaped portions (gray) protruding from the back of an electronic device." *Id.* But this construction ignores many of the prominent features noted above, including 1) the outermost continuous circle, 2) the unified circular appearance provided by the arches, and 3) the distance between the inner edges of the arches and the outermost continuous circle that is small and complementary to the proportions of other features. Each of these features contribute to the unique, concentric circular overall appearance, and are significant to the ordinary designer.

EX2001, ¶24.

Ultimately, Masimo's generic description of design concepts and omission of the appearance provided by the actual claimed shapes and their relationships fails to recognize the overall impression of the claimed design. These omissions taint each of the Petition's grounds, warranting denial of the petition. *Infra*, §§IV.C-E; *see also, Macsports, Inc., v. Idea Nuevo, Inc.*, IPR2018-01006, Paper 6 at 12 (PTAB Nov. 13, 2018) (denying institution); *Vitro Packaging*, IPR2015-00947, Paper 13 at 5 (denying institution); *Skechers*, IPR2017-00617, Paper 13 at 13 (denying institution).

B. Masimo's Proposed Construction Erroneously "Factored Out" Purportedly Functional Aspects of the Design

In an attempt to map the '936 patent's unique design to the prior art, Masimo relies on a construction that improperly "factored out" meaningful aspects of the design. Even if particular aspects of the design are associated with a functional purpose, they have ornamental contributions that cannot be excluded from the claimed design. Masimo's proposal is based on legal error. Additionally, Masimo improperly imports purported functionality from a commercial embodiment, ignoring that such functionality is not required or mentioned by the '936 patent, and ignoring the numerous alternative designs that can achieve the same or similar functionality.

1. Even if Particular Features are Associated with a Functional Purpose, They Contribute to the Overall Appearance of the Design and Cannot be “Factored Out”

As the Federal Circuit explained in *Sport Dimension*, “[w]hile we agreed that certain elements of the device were functional, their functionality did not preclude those elements from having protectable ornamentation.” *Sport Dimension, Inc. v. Coleman Co.*, 820 F.3d 1316, 1321 (Fed. Cir. 2016) (“in no case did we entirely eliminate a structural element from the claimed ornamental design, even though that element also served a functional purpose”). Masimo’s “construction in this case conflicts with that principle of design patent claim construction because it eliminates whole aspects of the claimed design.” *Id.*; Pet., 44 (“should be disregarded”); 45 (“should be disregarded”); 47 (“should be disregarded”); 57 (“should be disregarded”); 78; 80. Even if particular aspects of the claimed design can have a functional purpose (which Masimo fails to demonstrate), they are still significant to the overall ornamental appearance of the ’936 patent. Masimo’s assertions that these features be “factored out” is based on legal error and must be rejected.

The Petition conspicuously omits discussion of *Sport Dimension* and subsequent decisions highlighting that “in no case did [the Federal Circuit] entirely eliminate a structural element from the claimed ornamental design,” even if the element also served a functional purpose. *Sport Dimension*, 820 F.3d at 1321. Masimo engages in the same prohibited practice as the *Ethicon* District Court,

relying on a construction that “factored out” features from the claimed design. *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015) (reversing district court that “found that because each of the designs of the trigger, torque knob, and button must be ‘factored out’ under *Richardson v. Stanley Works*, . . . the Design Patents had no scope.”). It would be reversible error for the Board to do the same.

“[T]he claim construction in *Richardson* did not exclude those components in their entirety. Rather, the claim construction included the ornamental aspects of those components,” and “[a]s such, the language ‘dictated by their functional purpose’ in *Richardson* was only a description of the facts there; it did not establish a rule to eliminate entire elements from the claim scope.” *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 998 (Fed. Cir. 2105). Masimo’s legal error taints the entirety of its analysis, providing an independent reason that its construction is unsupportable. Each of the outermost continuous circle and outer circular shape provided by the arch-shaped portions has an ornamental contribution significant to the overall appearance of the claimed design. EX2001, ¶25.

Masimo’s claim construction is premised on a further legal error by asking the Board to consider each aspect of the claimed design separately. Contrary to Masimo’s assertions that particular aspects be “factored out,” the Federal Circuit has repeatedly explained that “design patents protect the *overall* ornamentation of a

design, not an aggregation of separable elements.” *Sport Dimension*, 820 F.3d at 1322. The features depicted by the ’936 patent’s claimed design must be considered together in view of the overall appearance achieved by the claimed features. EX2001, ¶¶20-23, 25. By “factoring out” structural elements from the claim, Masimo “improperly converted the claim scope of the design patent from one that covers the overall ornamentation to one that covers individual elements.” *Sport Dimension*, 820 F.3d at 1322. This is improper.

2. Masimo’s Focus on Functionalities of the Commercial Embodiment of the ’936 Patent Constitutes Legal Error

Masimo’s functionality discussion is based on yet another independent error. Masimo’s attempt to “factor out” aspects of the design is premised on purported functionality that is not required, or even mentioned, by the ’936 patent. Instead, Masimo’s functionality arguments improperly incorporate uses of an underlying commercial product into the design of ’936 patent. For example, Masimo’s functionality arguments are premised on the presence of wireless charging components located proximate the arch-shaped features. Pet., 26 (“the claimed arc-shaped portions’ design is also dictated by the need to ensure that the electrodes do not interfere with other Watch components.”); 18 (referring to “wireless charging” of a commercial product). But nothing in the ’936 patent tethers the claimed ornamental shapes to wireless charging components, or any other particular charging

component—the ’936 patent is directed to an “electronic device” without any requirement of wireless charging at all. *See Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452, 1455 (Fed. Cir. 1997) (vacating summary judgment of invalidity on functionality because district court erred in considering functional limitations of commercial embodiment rather than the claimed design). Indeed, “the court cannot use the limitations of the commercial embodiment of the underlying article of manufacture to impose limitations on the scope of the design patent.” *Id.* Masimo’s functionality arguments are premised on features extraneous to the claimed design, rather than the actual features shown and described by the ’936 patent. *See id.* This is yet a further independent reason that Masimo’s claim construction is erroneous and cannot be adopted.

3. A Multitude of Alternative Designs Highlight the Ornamental Contributions of Features of the Claimed Design

There is no dispute that “[w]hether suitable alternative designs are available is ‘an important – if not dispositive – factor in evaluating the legal functionality of a claimed design.’” *Ethicon*, 796 F.3d at 1329-30; Pet., 11. Here, multiple suitable alternative designs exist as described below that provide the same or similar functionality. The elements of the ’936 patent contribute to its overall appearance, and cannot be “factored out.”

For example, the Aries AW80 watch is described as enabling measurement of ECG, heart rate tracking, and blood oxygen tracking, and uses a magnetic charging cable. *See* EX2003, 1, 5-6, 11, 13-16. The AW80 accomplishes its functionalities with a design that includes opposed shapes on either side of a central band including square and rectangular sensors, and thus has a rear face having an appearance significantly different than the '936 claimed design. EX2001, ¶¶25-27. Additional circle-shaped elements are positioned at the end of the central band, outside of a region of the opposed shapes. The design features, and resulting overall appearance, are fundamentally different than the '936 patent design. *Id.*



EX2003, 6-7.

As another example, the P11 Plus watch is described as enabling measurement of ECG, heart rate tracking, and blood oxygen tracking. *See* EX2004, 1-3. The P11

Plus accomplishes its functionalities with a design that includes three rectangular electrodes, such that its rear face has a significantly different appearance than the '936 claimed design. EX2001, ¶¶28-30.



EX2004, 3.

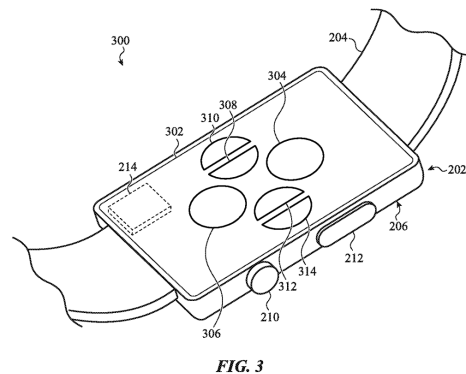
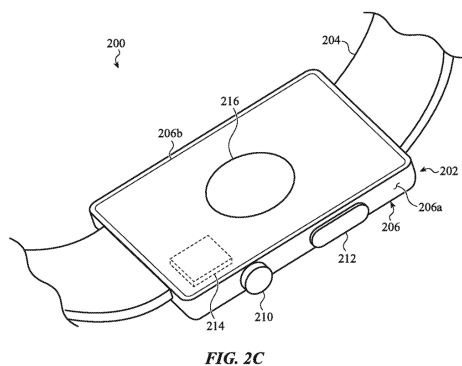
Simply put, there are alternative designs that accomplish the same or similar functions relied on by Masimo, while having a fundamentally different ornamental appearance. EX2001, ¶v25-30. The Petition is silent as to these alternative designs.

References cited by the Petition itself also confirm the existence of alternative designs as to each of the features identified by Masimo as purportedly functional, and confirm the features identified by Masimo contribute to the ornamental appearance of the claimed design. As discussed in further detail below, alternative

designs were known and available as to each of the elements of the '936 patent's design that Masimo contends should be factored out. EX2001, ¶¶30-35.

a) The Specific Arrangement of the Arch-Shaped Portions is Decorative and Contributes to the Unique Overall Appearance

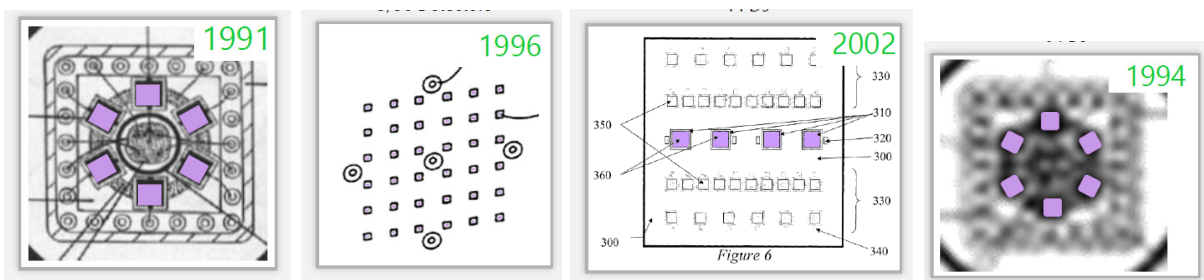
Masimo points to the '157 utility patent (U.S. 10,610,157) as explaining that the electrodes are “arc-shaped and positioned” and “sized” to achieve the functions of providing electrical contact between the electrodes and a wearer's skin. Pet., 24 (citing EX1024, 17:20-34; 13:54-59). The '157 patent itself, however, discloses multiple arrangements, shapes, and sizes of electrodes to achieve the stated purpose while having different appearances including a single rear-facing electrode (Fig. 2C), an arrangement of half-circle and circular electrodes (Fig. 3), or other arrangements. *See* EX1024, 17:24-34; EX2001, ¶¶31-33.



EX1024, Figs. 2C and 3.

b) The Overall Circular Shape is Decorative and Contributes to the Unique Overall Appearance

Masimo contends that the overall circular shape of the claimed sensor design is functional. Pet., 30-31. But, here again, Masimo's own citations demonstrate multiple suitable alternative designs having non-circular shapes. Regardless of whether or not circular shapes were "ubiquitous," the existence of alternative arrangements is a strong indicator that the circular design of the '936 patent contributes ornamentally to its overall appearance. EX2001, 34-35.



EX1038, 2-3 (figures excerpted).

C. Ground 1: Masimo Fails to Demonstrate that the Claimed Design is Obvious Based on Paulke

The Petition entirely overlooks multiple elements that contribute to the overall appearance of the claimed design that are lacking from Paulke. Even if Paulke were modified as proposed by the Petition, the Petition fails to demonstrate the claimed design would result. Additionally, given the significant differences between Paulke and the claimed design, the Petition fails to demonstrate that Paulke is a proper *Rosen* reference. Even if it were, the Petition relies on layers of modifications that

significantly change Paulke's appearance, and that are not depicted by Paulke, to recreate the claimed design. The Petition's Ground 1 obviousness theories are woefully deficient, and the gaps in its analysis highlight that Masimo cannot demonstrate unpatentability of the design claim based on the evidence set forth in the Petition.

1. Paulke is Not a Proper *Rosen* Reference

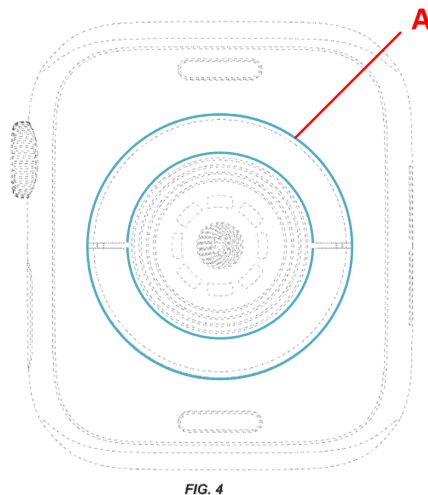
The Ground 1 obviousness theory is defective because the Petition fails to demonstrate that Paulke is a proper *Rosen* reference. Masimo's obviousness theory is based on the flawed premise that "any differences between Paulke and the D'936 patent do not change the overall visual similarity of the designs." Pet., 41. But in making this assumption, Masimo does not address multiple, prominent differences between the claimed design and Paulke, such as the claimed design's outermost continuous circle and its relationship to other features of the design, as noted above. The multiple, readily apparent differences between Paulke and the claimed design, and the layers of intermediate modifications proposed in an attempt to reach the claimed design, confirm that the Petition fails to demonstrate Paulke is a "single reference that creates basically the same visual impression." *Levitation Arts, Inc. v. Flyte LLC*, PGR2018-00073, Paper 14, 16-22 (PTAB, Jan. 17, 2019) (denying institution in part because "claimed design includes ornamental features that are entirely absent or significantly different in the [prior art] design"); *Dorman Products*

Inc. v. PACCAR Inc., IPR2014-00542, Paper 10 at 5 (PTAB Sept. 5, 2014) (denying institution); *In re Harvey*, 12 F.3d 1061, 1063 (Fed. Cir. 1993) (“Because major modifications would be required to make Harvey’s prior art vase look like the claimed designs, it cannot qualify as a basic design.”).

The obviousness analysis generally involves two steps: first, “one must find a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design”; second, “once this primary reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design.” *High Point Design, LLC v. Buyers Direct, Inc.*, 730 F.3d 1301, 1311 (Fed. Cir. 2013) (internal quotation and citations omitted). In performing the first step of the obviousness analysis, we must “(1) discern the correct visual impression created by the patented design as a whole; and (2) determine whether there is a single reference that creates basically the same visual impression.” *Id.* at 1312 (internal quotation omitted). The Petition fails to address multiple differences—and the significance of these differences to the overall appearance—and thus lacks any sufficient evidence that Paulke is “a single reference that creates basically the same visual impression” as the claimed design. *High Point Design*, 730 F.3d at 1314.

a) Masimo Fails to Properly Analyze the Outermost Continuous Circle

The Petition fails to address the outermost continuous circle of the claimed design, and its contribution to the overall appearance, in its Ground 1 analysis. *See*, Pet., Ground 1. The outermost continuous circle encompasses the other features of the claimed design and sets the tone of its concentric circular overall impression. EX2001, ¶¶36-38. For example, the outermost continuous circle of the claimed design (annotated “A” below) surrounds the outer circular shape formed by the arches. It encompasses the arches and provides a visual continuity that is mimicked by the inner edges of the arches, for example. EX2001, ¶38.



EX2001, ¶39 (EX1001, Fig. 4 (annotated)).

Masimo fails to address this aspect of the claimed design in its Ground 1 analysis. The Petition’s annotations of Paulke ignore this aspect, which does not

depict such an outermost continuous circle near its opposed shapes. EX2001, ¶¶40-41.

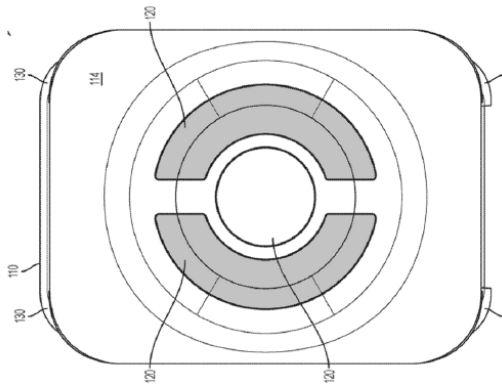


FIG. 1G (rotated)

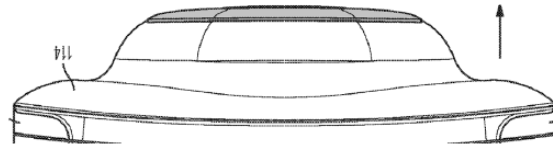


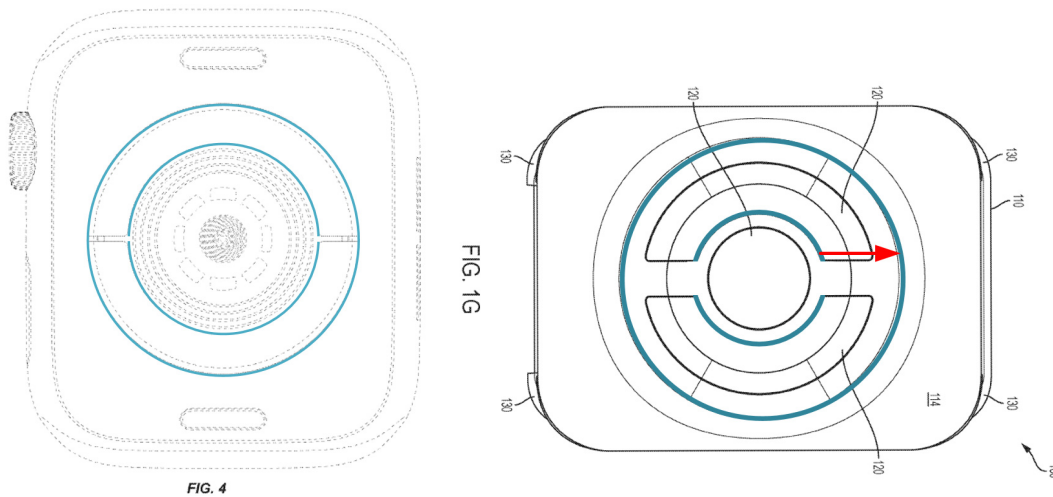
FIG. 1D (rotated)

Pet., 44, 48 (EX1006, FIGS. 1G, 1D).

Moreover, Masimo ignores the specific appearance provided by the relationship between the outermost continuous circle and the outer circular shapes provided by the arches. For example, by ignoring the outermost continuous circle altogether, Masimo fails to address the overall concentric circle impression of the claimed design. EX2001, ¶42. Additionally, Masimo neglects to address the position of the outermost continuous circle relative to the inner edge of the arch-shapes. Each of these is spaced from the other and highlights an elegant and well-proportioned appearance. *Id.*

**b) Masimo Fails to Properly Analyze the Arch Shapes
Relative to the Outermost Continuous Circle**

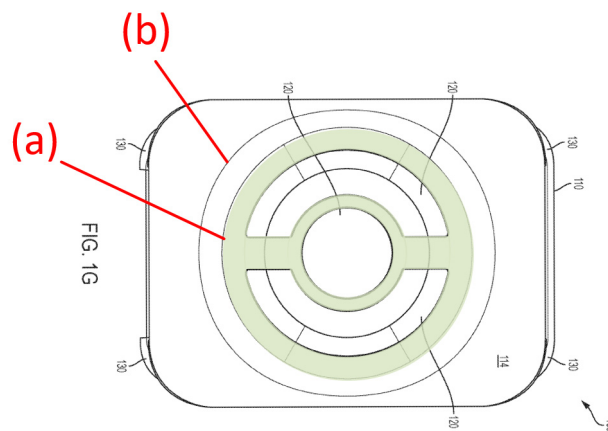
Masimo fails to address the relationship between the arch shapes and the size of the outermost continuous circle in the '936 patent, which depicts a readily apparent thickness of the arches that is relatively small compared to the diameter of the circle traced by the outermost continuous circle. EX2001, ¶43. The small thickness relative to the diameter contributes to the overall appearance of the claimed design as an elegant and streamlined concentric circle appearance, rather than a bulky assembly of shapes.



EX2001, ¶43(Left: EX2001, Fig. 4 (annotated); Right: EX1004, Fig. 1G (rotated, annotated)).

Masimo ignores this aspect of the claimed design and its contribution to the overall appearance. In contrast to the claimed design, Paulke's opposed shapes have a much thicker appearance.

Indeed, the Petition fails to demonstrate Paulke has an outermost continuous circle at all. To the extent Masimo relies on radius lines in Paulke's drawing (which the Petition never mentions), Paulke's opposed shapes are spaced inwardly significantly from both the intermediate (a) and outer (b) lines, here again conveying a different overall appearance that lacks the streamlined, well-proportioned appearance of the claimed design. Moreover, Paulke's outer line is not a circle at all, instead slightly depressed inwardly such that it has an elliptical or oval shape. EX2001, ¶44; EX1006, FIGS. 1D and 1G.



EX2001, ¶44 (EX1004, Fig. 1G (rotated, annotations and highlighting added)).

Given these omissions in Masimo's analysis, even if Paulke were altered as proposed in the Petition (Pet., 49-52), the Petition offers no reasoned analysis why the result would be substantially identical to the claimed design in view of the other prominent differences. Contrary to the Petition's assertion, the result would lack

readily apparent features that contribute to the overall appearance of the claimed design.

c) Masimo Fails to Properly Analyze the Arches of the Claimed Design in Comparison to Paulke

Masimo’s assertion that “the arc-shaped portions of Paulke and the D’936 Patent provide the same overall visual impression” fails to address readily visible differences that are significant to the overall appearance of the claimed design. Pet., 44. The ’936 patent includes an outer circular shape provided by unified arches. *Supra*, §IV.A. The ends of each arch are positioned so as to provide a unified circular appearance. *Id.* As discussed above, the thickness of the arches from the inner edge of the arch to the outermost continuous circle is relatively small, contributing to the appearance of an elegant and streamlined outer circular shape. *Id.*

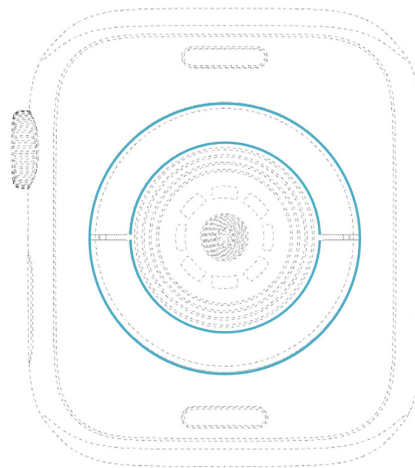


FIG. 4

EX2001, ¶48 (EX1001, Fig. 4 (annotated)).

In contrast to the '936 patent's design, Paulke depicts opposed shapes spaced apart from one another and having a relatively larger thickness. Paulke's features provide an appearance of two separate, opposed shapes that differs prominently from the '936 patent's arches that evoke an overall concentric circle appearance. EX2001, ¶¶46-50.

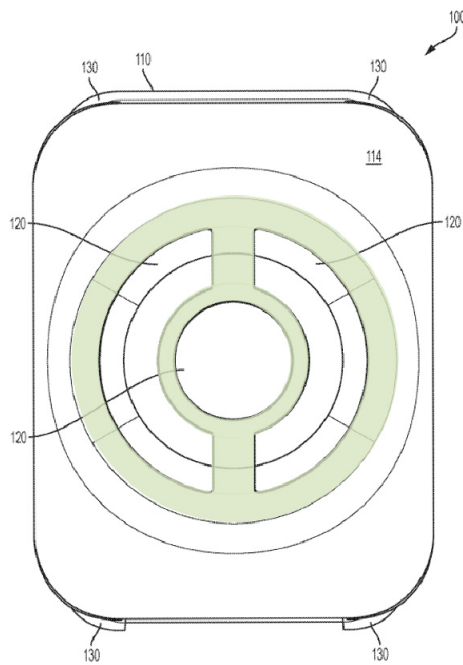


FIG. 1G

EX2001, ¶49 (EX1006, Fig. 1G (highlighted)).

As discussed above, Paulke's opposed shapes are meaningfully wider than the claimed arches of the '936 patent, with the inner edge of Paulke's opposed shapes spaced a substantial distance inwardly (e.g., relative to radius lines depicted in Fig. 1G), and the width of Paulke's curved shapes extend across a significant portion of the surface of Paulke's sensor body. These prominently visible features provide a

different overall appearance that is bulky and dominated by the opposed curved shapes, rather than the streamlined, elegant concentric circle appearance of the '936 patent. Masimo ignores this aspect of the claimed design, and its contribution to the overall appearance.

Masimo acknowledges that “Paulke’s arc-shaped portions are spaced slightly farther apart than the claimed design” but merely concludes “that difference, or any difference in the size, shape, or spacing of the arc-shaped portions of Paulke and the claimed design, does not alter the overall visual similarity of these designs.” Pet., 45. Here again, Masimo never addresses the contribution of these prominent features on the overall appearance of the claimed design, ignoring the visual appearance of the concentric circles of the claimed design that is lacking from the greater separation of the opposed arch-shaped components of Paulke. This is not a matter of degree—the Paulke arch-shaped components have the appearance of two separate features rather than the unified circular appearance of arches of the '936 patent. EX2001, ¶¶51-52.

The Petition cites paragraphs 60-61 of the Delman Declaration, but these paragraphs parrot the petition without any additional underlying explanation. *Compare* EX1003, 60-61 *with* Pet., 44-45. Such an “*ipse dixit* declaration” is insufficient and does nothing to remedy the Petition’s deficient analysis. *TQ Delta*,

LLC v. Cisco Sys., 942 F.3d 1352, 1362-64 (Fed. Cir. 2019) (refusing to give weight to petitioner’s “*ipse dixit* declaration”).

Here again, Masimo’s analysis is fatally deficient, ignoring meaningful features of the claimed design that differ in comparison to Paulke.

2. Masimo Fails to Demonstrate that it Would Have Been Obvious to a DOSA To Modify Paulke To Create the Claimed Design

Masimo acknowledges multiple additional modifications to provide features beyond that depicted by Paulke, tacitly acknowledging Paulke’s actual appearance fails to achieve the claimed design. Pet., 49-52. But these additional modifications are directed to features that are not depicted by Paulke and are not trivial or *de minimis*. *Supra*, §IV.A. The proposed modification fails for this additional reason.

The deficiencies discussed above are not remedied by Masimo’s reliance on purported utility motivations. A primary reference can properly be modified by a secondary reference in a design patent context if they are so related that the *appearance* of certain ornamental features in one reference would have *suggested application of those features to another*. *In re Rosen*, 673 F.2d 388, 213 U.S.P.Q. (BNA) 347 (CCPA 1982). Simply stated, when determining obviousness of a design patent claim, “the focus must be on appearances and not uses.” *See Harvey*, 12 F.3d at 1064 (reversing Board’s obviousness determination where “the Board improperly mixed principles of obviousness for utility patents with those for ornamental design

patents.”); *In re Sung Nam Cho*, 813 F.2d at 382 (reversing Board’s obviousness determination that analyzed design patent “as if it were the subject of an application for a utility patent”); *Termax*, IPR2022-00106, Paper 7 at 29 (rejecting Petitioner’s reliance on aspects other than ornamental appearance, and indicating “the Federal Circuit has made clear that the motivation to modify one design with another is limited to whether the articles are ‘so related’ (*i.e., so similar in appearance*)”).

Here, Masimo ignores this well-established principle of design patent law, embarking on a multi-layered series of modifications based on purported utility considerations. Pet., 49-52. For example, Masimo’s proposal to “extend the ends of the Paulke’s . . . arc-shaped electrodes closer together” or “shaped to avoid interference” is unsupported by any aspect related to the appearance. Pet., 50. This is improper and fails to satisfy Masimo’s burden. *See Termax*, IPR2022-00106, Paper 7 at 29; EX2001, ¶¶53-54.

D. Ground 2: Masimo Fails to Demonstrate that the Claimed Design is Obvious Based on Yuen in View of Mendelson and Bushnell

1. Yuen is Not a Proper *Rosen* Reference

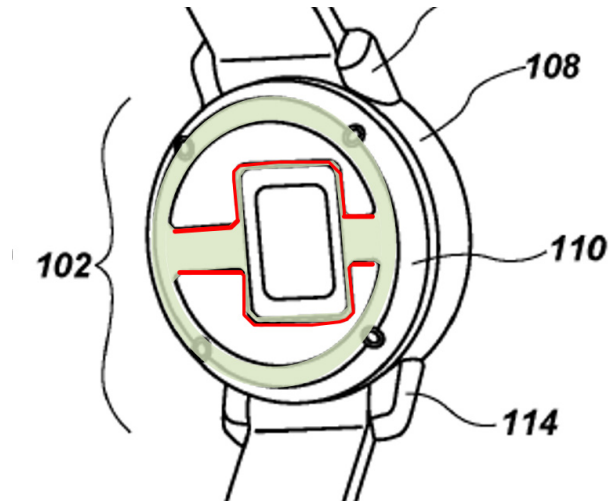
The Ground 2 obviousness theory is defective because the Petition fails to demonstrate that Yuen is a proper *Rosen* reference. Masimo’s obviousness theory is based on the flawed premise that “any differences between Yuen and the D’936 patent do not change the designs’ overall visual similarity.” Pet., 54. But in making this assumption, Masimo fails to specifically address the asymmetric and squarish

opposed shapes of Yuen that provide a markedly different overall appearance and that independently disqualify Yuen as a *Rosen* reference. Moreover, the Petition fails to address additional prominent differences between the claimed design and Yuen, such as the claimed design's arches that form an outer circular shape within an outermost continuous circle, contributing to a concentric circular appearance. The multiple, readily apparent differences between Yuen and the claimed design, some of which are wholly unaddressed by the Petition, confirm that the Petition fails to demonstrate Yuen is a "single reference that creates basically the same visual impression." *Dorman Products*, IPR2014-00542, Paper 10 at 5; *In re Harvey*, 12 F.3d at 1063.

a) Masimo Fails to Properly Analyze the Arches of the Claimed Design in Comparison to Yuen

In contrast to the '936 patent's design, Yuen depicts asymmetrical, squarish shapes that are spaced apart from one another in an opposed relationship. These features provide an immediately apparent overall appearance different from the appearance of concentric circles resulting from the arches of the claimed design. EX2001, ¶¶55-58. Yuen is plainly different than the claimed design, and not a *Rosen* reference, for this independent reason.

Yuen's opposed shapes are *asymmetrical*. For example, the left side of the shapes is notably wider than the right side of the shapes (e.g., as shown in FIG. 1B).

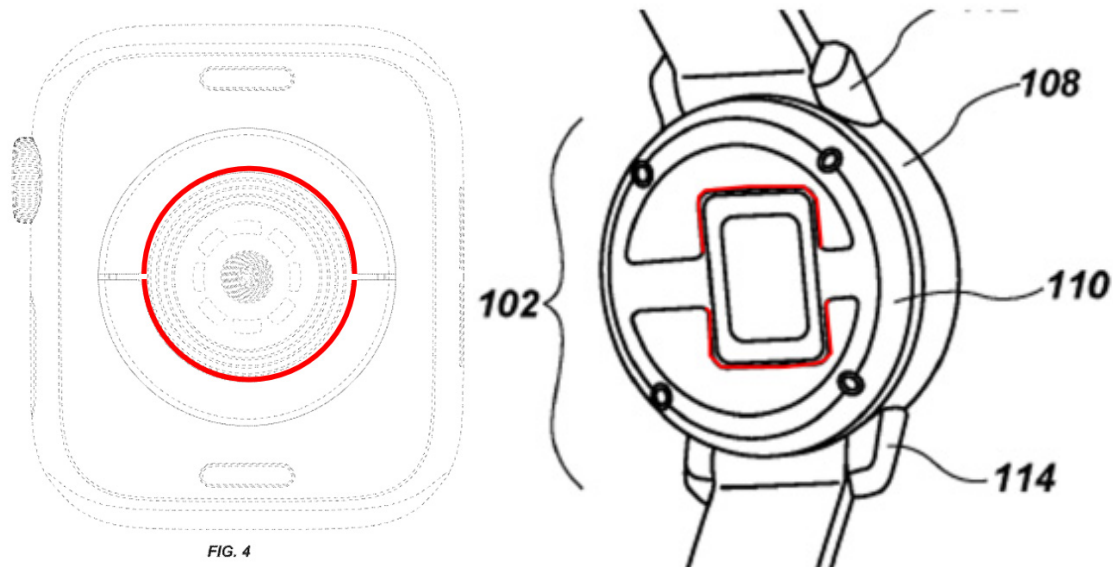


EX2001, ¶57 (EX1007, Fig. 1B (excerpted, annotated)).

The asymmetric appearance is not just a result of the perspective shown in Fig. 1B—Masimo admits elsewhere in the Petition that Yuen’s shapes are asymmetric. *See*, Pet., 66 (“Yuen’s asymmetrically located PPG sensor”). EX2001, ¶58.

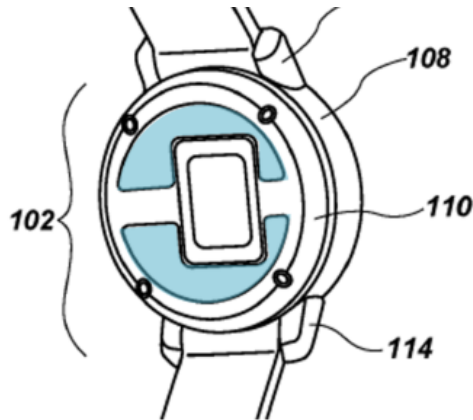
Additionally, Yuen’s opposed shapes are not arch-shaped but instead have a square, off-center cut-out. The inner edge of the opposed shapes are not curved or

circular at all, and certainly do not evoke an appearance of concentric circles.



EX2001, ¶59 (Left: EX1001, Fig. 4 (annotated); EX1007, Fig. 1B (excerpted, annotated)).

As yet a further prominent difference, Yuen's features provide an appearance of two separate, opposed shapes. Yuen's shapes are meaningfully wider than the arches of the claimed design, and the ends are separated by a relatively large gap. These prominently visible features provide a different overall appearance that is bulky and dominated by the opposed shapes, rather than the streamlined, elegant concentric circle appearance of the '936 patent. EX2001, ¶60. Masimo ignores these aspects of the claimed design, and the differing appearance of Yuen's shapes.



EX2001, ¶60 (EX1007, Fig. 1B (excerpted, annotated)).

The above deficiencies are not remedied by Masimo’s acknowledgement that “Yuen’s arc-shaped portions have a slightly different shape and spacing than in the claimed design.” Pet., 57-58. Masimo merely concludes “that difference, or any difference in the size, shape, or spacing of the arc-shaped portions of Yuen and the claimed design, does not alter the overall visual similarity of these designs,” without following this assertion with any analysis of these differences or why they purportedly do not alter the overall visual appearance. *Id.* Here again, Masimo never addresses the contribution of these prominent features on the overall appearance of the claimed design, ignoring the visual appearance of the concentric circles of the claimed design that is lacking from Yuen’s squarish shapes. To be clear, these differences are not a mere matter of degree—Yuen’s opposed shapes are asymmetric and squarish, immediately contrasting with the ’936 patent’s arches and its overall appearance. EX2001, ¶61.

Masimo's analysis is fatally deficient for this independent reason.

b) Masimo Fails to Properly Analyze the Outermost Continuous Circle and Its Relationship with the Arches of the Claimed Design in Comparison to Yuen

Masimo's obviousness theory ignores the different overall appearance flowing from the claimed design's outermost continuous circle and the relationship between the outermost continuous circle and outer circular shape within the outermost continuous circle formed by the arches. As described above, the outermost continuous circle encompasses the other features of the claimed design and sets the tone of the concentric circular overall impression. *See supra* §IV.A.

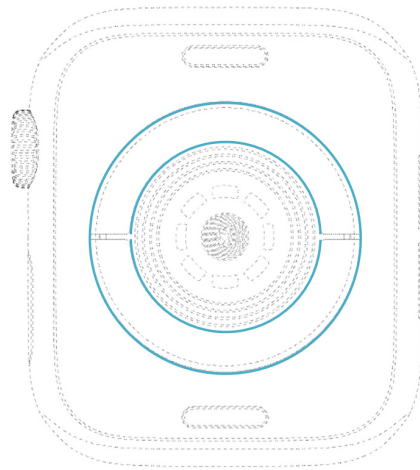
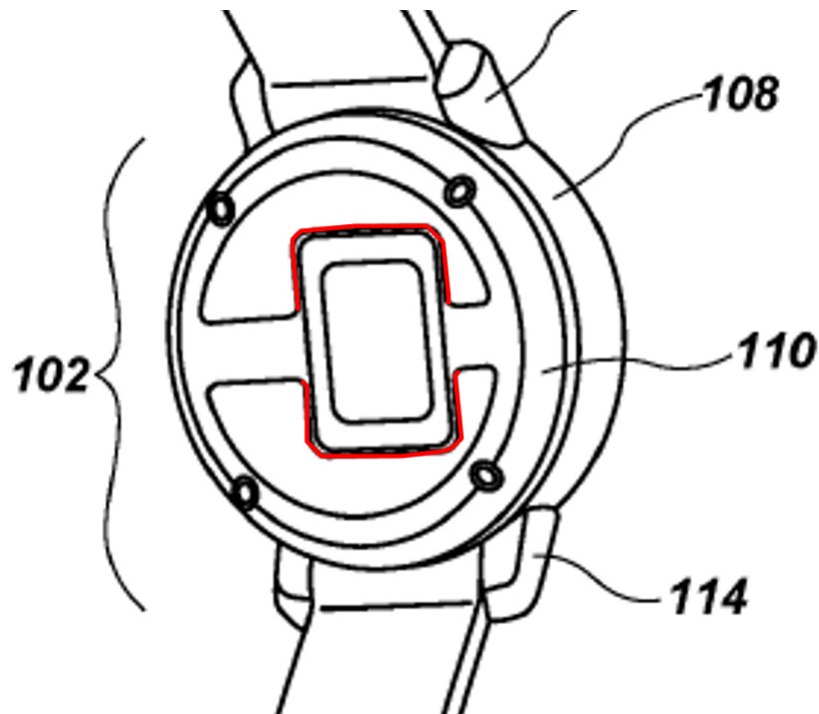


FIG. 4

EX2001, ¶62 (EX1001, Fig. 4).

The Petition's analysis of Ground 2 is silent as to this outermost continuous circle shape and its contribution to the overall appearance of the claimed design, and fails to address the outermost continuous circle in its comparison to Yuen. Masimo

neglects to address the position of the outermost continuous circle relative to the inner edges of the arches of the claimed design. While the outermost continuous circle and inner edge of the arches of the claimed design are spaced from the other to highlight an elegant and streamlined appearance associated with relatively thin, elongate arches, Yuen depicts thick, squarish, opposed shapes that entirely lack a ring-like appearance.

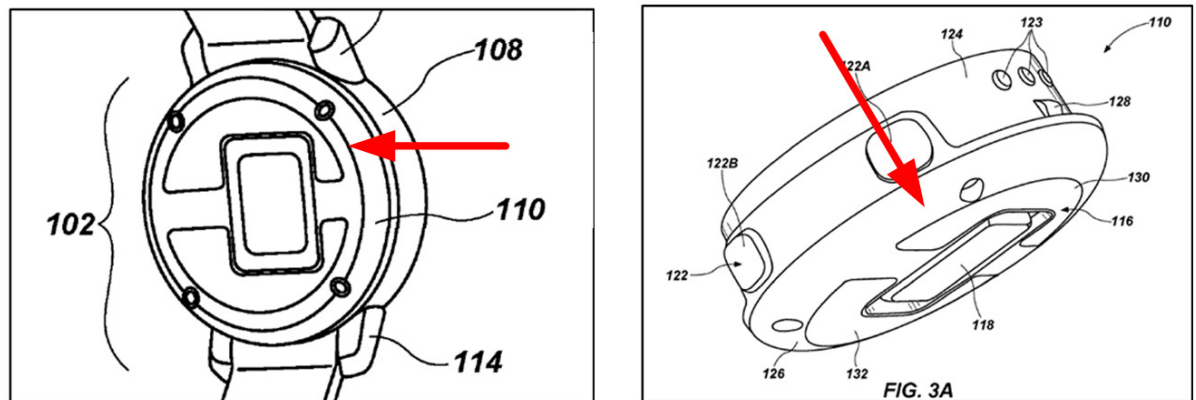


EX2001, ¶63 (EX1007, Fig. 4 (excerpted, annotated)).

Masimo also fails to address the relationship between the arches of the claimed design and the size of the outermost continuous circle (e.g., the “thickness” of the arches). EX2001, ¶64. The small thickness relative to the diameter of the outermost continuous circle contributes to the overall appearance of the claimed

design as an elegant and precise series of concentric circles, rather than a bulky assembly of shapes.

In contrast to the claimed design, Yuen's opposed shapes have a much thicker and imprecise appearance.



EX2001, ¶64 (EX1007, Figs. 1B and 3A (excerpted, annotated)).

To the extent Masimo relies on the line delineating the back face of the watch in Fig. 1B (which the Petition never mentions), Yuen's Fig. 3A confirms that this line merely represents curvature of the rear surface of the watch. Additionally, Yuen's opposed shapes are spaced inwardly significantly from this line, here again conveying a different overall appearance that lacks the streamlined, well-proportioned appearance of the claimed design. EX2001, ¶65.

Because the Petition has failed to provide any explanation that accounts for these visible differences, Masimo has not demonstrated that Yuen is "a single reference that creates basically the same visual impression" as the claimed design.

High Point Design, 730 F.3d at 1314; *Harvey*, 12 F.3d at 1063 (“Because major modifications would be required to make Harvey’s prior art vase look like the claimed designs, it cannot qualify as a basic design.”). The Petition is thus insufficient to establish that Yuen is an appropriate primary reference, and therefore fails to demonstrate a reasonable likelihood that it would prevail in showing that the design claim is rendered obvious under Ground 2 for this additional reason.

2. Masimo Fails to Demonstrate that it Would Have Been Obvious to a DOSA To Modify Yuen in View of Mendelson and Bushnell To Create the Claimed Design

a) Mendelson is Not a Proper Secondary Reference for Combination with Yuen

The Petition fails to demonstrate that Mendelson’s sensor design is “so related” to Yuen that “the appearance” of certain ornamental features in Mendelson would suggest the application of those features to Yuen. *Glavas*, 230 F.2d at 450.

Masimo relies on Yuen’s description that its device can include “any PPG sensor 118 known in the art” and Mendelson’s sensor as evidence that Mendelson is “so related” to Yuen’s design. Pet., 61 (“Mendelson is so related to Yuen because it discloses a suitable sensor for Yuen’s design”). In doing so, Masimo improperly focuses on Mendelson’s use as a sensor rather than the visual appearance of Mendelson and Yuen, which have virtually no overlap in appearance. *Termax*, IPR2022-00106, Paper 7 at 29 (rejecting Petitioner’s reliance on aspects other than

ornamental appearance, and indicating “the Federal Circuit has made clear that the motivation to modify one design with another is limited to whether the articles are ‘so related’ (*i.e., so similar in appearance*)”). In contrast to Mendelson’s arrangement of pairs of rectangles, Yuen lacks any corresponding rectangular shape. EX2001, ¶¶66-67. Likewise, while Mendelson has a circular perimeter shape and radially-symmetric arrangement of rectangles, Yuen has a squarish arrangement between opposed, asymmetric shapes. *Id.*

The appearance of Mendelson, having a radial arrangement of rectangles surrounding a central circular shape, lacks features similar to Yuen. EX2001, ¶¶67-68. In view of these prominent differences, and the lack of visually similar features, Masimo has failed to satisfy its burden of demonstrating the references are “so related that the appearance of certain ornamental features in one would suggest the application of those features to the other.” *Glavas*, 230 F.2d at 450. Instead, there is no suggestion to incorporate the features of Mendelson into Yuen’s device based on their appearances.

To be clear, Masimo’s reliance on the presence of a “PPG sensor” in Yuen and “suitable sensor” in Mendelson is alone insufficient to demonstrate Yuen and Mendelson are “so related” as to suggest application of Mendelson’s arrangement of rectangle shapes into Yuen. *Pet.*, 61. Nothing in Mendelson’s symmetrical radial arrangement suggests application to Yuen’s offset/asymmetrical sensor. The mere

presence of a space in Yuen's design described as providing the function/use of a sensor is insufficient to suggest application of the specific ornamental appearance of Mendelson, except for improper use of the claimed design as a roadmap. *Premier Gem*, IPR2016-00434, Paper 9 at 16; *L.A. Gear*, 988 F.2d at 1124 ("Not only the individual elements, but the ornamental quality of the combination must be suggested in the prior art. . . . A reconstruction of known elements does not invalidate a design patent, absent some basis whereby a designer of ordinary skill would be led to create this particular design.").

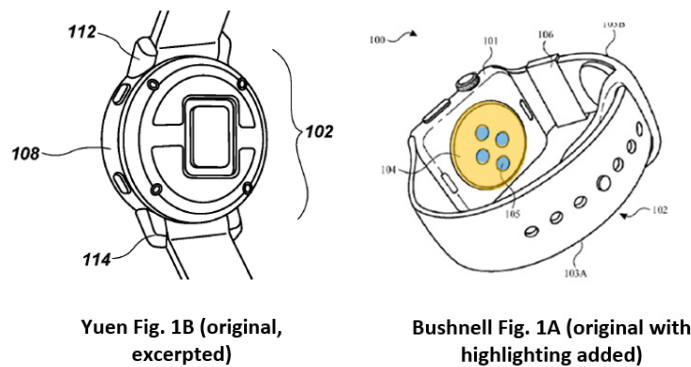
b) Bushnell is Not a Proper Secondary Reference for Combination with Yuen

Bushnell's rear face shape design is significantly different than Yuen, such that the references are not "so related that the appearance of certain ornamental features in one would suggest the application of those features to the other." *Glavas*, 230 F.2d at 450. Masimo fails to demonstrate any suggestion in the designs' appearances to incorporate the features of Bushnell into Yuen's design.

Bushnell's rear face has a circular feature protruding from the center of a generally squarish body. *See* EX1009, Figs. 1A, 2A. In contrast, Yuen's rear face is circular with a convex portion at the outer perimeter edge. *See* EX1007, Fig. 3A. Moreover, the positioning of any raised portion is also different, with Bushnell's raised circular feature being positioned on the relatively square, flat rear face and

Yuen's circular face including a curved perimeter edge with no raised feature positioned on the face surface. EX2001, ¶69.

Further, as illustrated below, Bushnell's rear face does not include visual elements similar to the opposed, asymmetrical shapes and offset rectangular portion of Yuen. EX2001, ¶70.



EX2001, ¶70 (EX1007, Fig. 1B (excerpted); EX1009, Fig. 1A (annotated)).

In view of these unaddressed differences between Yuen and Bushnell, Masimo fails to satisfy its burden of demonstrating the references are so related in appearance as to suggest the incorporation of features from Bushnell into Yuen's design. EX2001, ¶70.

The above deficiencies are not remedied by Masimo's assertion that "Bushnell is so related to Yuen because it discloses a suitable design for Yuen's device," and that "both references concern a circular, convex surface that protrudes from the back of the wrist-worn device and incorporates the device's sensors." Pet.,

63-64. Contrary to Masimo’s characterization, Yuen’s alleged “circular convex surface” *is* the back of the wrist-worn device—it does not protrude from the back surface. EX2001, ¶71. Masimo further asserts that “Bushnell and Yuen are further related because Yuen expressly suggests using any known PPG sensor ... which Bushnell discloses.” Pet., 64. As described above with regard to Mendelson, Masimo’s reliance on the presence of a PPG sensor, and any components of such a sensor, fail to demonstrate the *appearance* of Yuen and Bushnell are “so related” as to suggest application of Bushnell’s convex protruding surface to Yuen. *Termax*, IPR2022-00106, Paper 7 at 29. Here again, the prominent differences in appearance, with almost no visual similarity, confirm the improper hindsight nature of Masimo’s analysis. *L.A. Gear*, 988 F.2d at 1124.

c) Masimo Fails to Demonstrate the Proposed Series of Modifications Would Have Been Obvious to a DOSA

Masimo acknowledges multiple additional modifications to provide features beyond that depicted by Yuen, Mendelson, or Bushnell, tacitly acknowledging that the proposed combination fails to achieve the claimed design. Pet., 73 (citing Pet., §VI.B.2). But these additional modifications are directed to features that are not depicted by either reference and are not trivial or *de minimis*. EX2001, ¶72. The proposed modification fails for this additional reason, as described above (*supra*, Ground 1 Analysis, IV.C.1.d). *See Harvey*, 12 F.3d at 1065.

For example, Masimo fails to demonstrate a DOSA would have further modified the proposed Yuen/Mendelson/Bushnell combination to achieve the specific appearance of the claimed design such that the opposed shapes have curved inner edges. The Petition does not rely on illustrations of Yuen, Mendelson, or Bushnell, for this modification. Indeed, the Petition's analysis is undermined by the internal shape delineated by the inner edges of Yuen's opposed shapes, which do not form a curved or circular shape, but rather a rectangular shape. The Petition asserts that a DOSA would have modified Yuen "to achieve an overall symmetric sensor surface," ignoring that Yuen depicts an asymmetric appearance that would be fundamentally altered by this proposed modification. EX2001, ¶¶72-75.

The deficiencies discussed above are not remedied by Masimo's improper reliance on motivations based on purported functionality of underlying technologies rather than the actual appearances of the designs. Pet., 66-67, 69-70. The teachings of references can properly be combined in a design patent context if they are so related that the *appearance* of certain ornamental features in one reference would have suggested application of those features to another. *Rosen*, 673 F.2d 388. Masimo ignores this well-established principle of design patent law, embarking on a multi-layered series of modifications based on purported utility considerations. See Pet., 66-70. Masimo's analysis based on utility considerations does nothing to address the requisite standard of whether the appearance of certain

ornamental features in one reference would have suggested application of those features to another and does not address the specific ornamental contributions of the claimed design. Flouting the requisite analysis, Masimo alleges a motivation based on Yuen’s description regarding sensor utility, but even if true, such an analysis fails to demonstrate a DOSA would have modified Yuen to have a specific ornamental appearance, as described above. *See Termax*, IPR2022-00106, Paper 7 at 29.

E. Ground 3: Masimo Fails to Demonstrate that the Claimed Design is Obvious Based on Fong in View of Mendelson and Bushnell

1. Fong is Not a Proper *Rosen* Reference

The Petition fails to demonstrate that Fong is a proper *Rosen* reference, rendering Ground 3 fatally defective. Masimo’s obviousness theory is based on the flawed premise that “any differences between Fong and the D’936 patent do not change the overall visual similarity of the designs.” Pet., 75-76. But the Petition here again fails to specifically address significant aspects of Fong, such as the spacing between Fong’s opposed shapes that include interposed circular elements separating the shapes, which yield a markedly different overall appearance. Moreover, the Petition fails to address other prominent differences between the claimed design and Fong, such as the claimed design’s arches that form an outer circular shape within an outermost continuous circle and that provide a concentric circular appearance. The prominent differences between Fong and the claimed design, some of which are wholly unaddressed by the Petition, confirm that the

Petition fails to demonstrate Fong is a “single reference that creates basically the same visual impression.” *Levitation Arts*, PGR2018-00073, Paper 14, 16-22; *Dorman Products*, IPR2014-00542, Paper 10 at 5; *Harvey*, 12 F.3d at 1063.

a) Masimo Fails to Properly Analyze the Arches of the Claimed Design in Comparison to Fong

As discussed above, the claimed design includes unified arch shapes forming an outer circular shape that contribute to the '936 design's overall appearance of well-proportioned concentric circles. *Supra*, §IV.A; EX2001, ¶¶76-77.

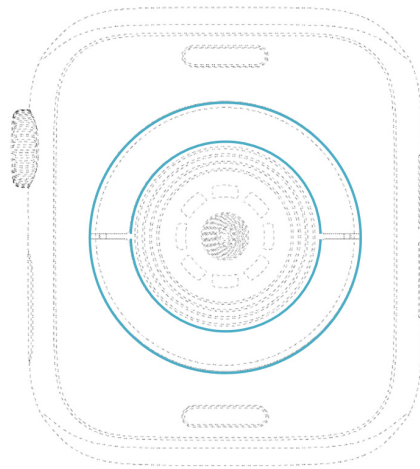


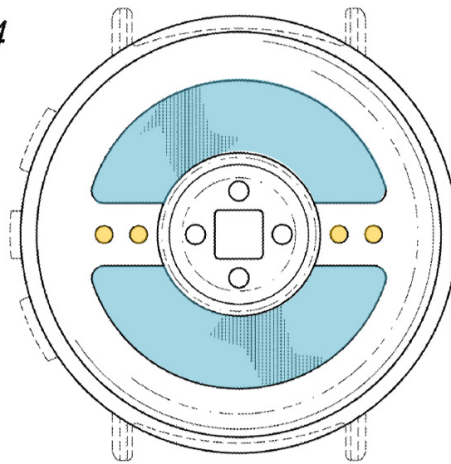
FIG. 4

EX2001, ¶78 (EX1001, Fig. 4 (annotated)).

In contrast to the '936 patent's design, Fong depicts wide, opposed shapes (blue) separated from one another at the ends by a significant gap that provides an appearance of opposed, divided shapes. EX2001, ¶77. Moreover, this separation is visually highlighted by the presence of multiple circular elements (yellow). In particular, two circular elements are positioned between each end of the opposed

shapes (e.g., as shown in Fig. 4). These circular elements are significant to Fong's appearance, aligned with two additional circular elements and the central square. Together, the circular elements and central square extend across the entire width of the opposed shapes and visually divides the design into upper and lower portions (blue) separated by a middle row of the circle and square elements. EX2001, ¶77.

FIG. 4



EX2001, ¶77 (EX1008, Fig. 4 (highlighting added)).

Far from the unified, outer circular shape of the claimed design, Fong's round elements separating ends of the two opposed shapes highlight the distinct and opposed appearance of Fong's shapes. EX2001, ¶78.

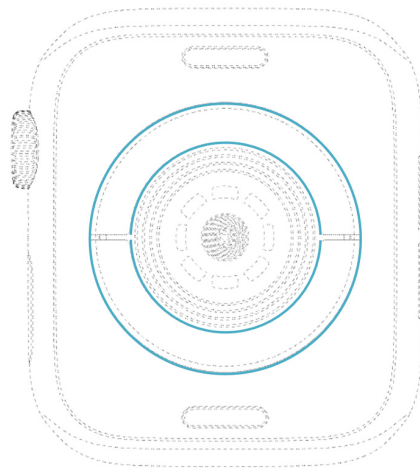
The differences in the visual appearance of Fong compared to the '936 patent are not a mere matter of degree. Fong's opposed shapes are spaced apart from one another not only by a large space, but by additional elements interposed in this space

that are significant to Fong's different appearance. EX2001, ¶¶78-81. Masimo fails to specifically address these aspects of Fong, which plainly lacks an appearance that is "basically the same" as the overall appearance of continuous concentric circles provided by the '936 patent.

Masimo's Ground 3 analysis is fatally deficient for this independent reason.

b) Masimo Fails to Properly Analyze the Outermost Continuous Circle and Its Relationship with the Arches of the Claimed Design in Comparison to Fong

The overall appearance of concentric circles of the claimed design is provided in part by the outermost continuous circle, and the relationship between the outermost continuous circle and the outer circular shape within the outermost continuous circle formed by the arches. *Supra*, §IV.4.

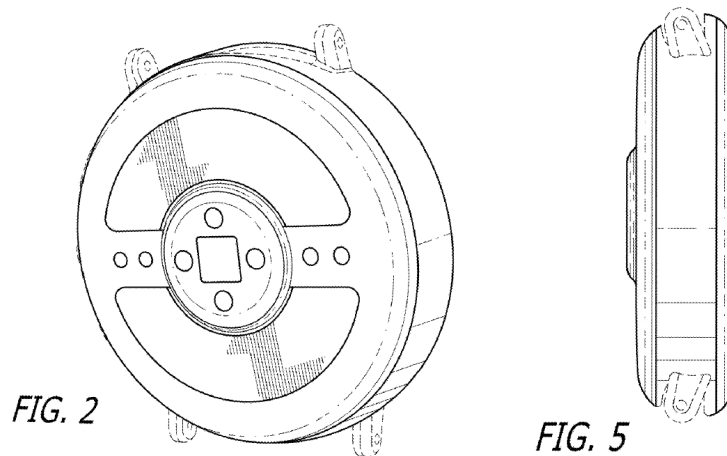


EX2001, ¶¶82 (EX1001, Fig. 4 (annotated)).

The Petition fails to address the outermost continuous circle in its comparison

to Fong, never identifying such a feature in Fong at all. Likewise, the Petition does not address the different overall appearance of Fong that lacks the series of continuous and concentric circles provided by the outermost continuous circle and arch shapes.

Fong's design includes opposed shapes surrounding a raised circular central portion, and lacks any continuous outer circle proximate Fong's opposed shapes.

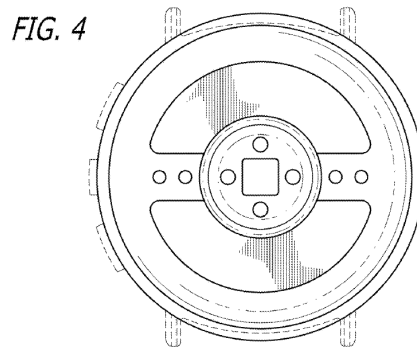


EX1008, Figs. 2 and 5.

The lack of outermost continuous circle in Fong's design is not trivial or *de minimis*—it goes to a fundamental aspect of Fong in which top and bottom portions are divided by a central portion that includes a row of small circles and a central square that extend across the back of the device. EX2001, ¶¶82-85. Unlike the claimed design, Fong's opposed features are visibly separated and not encompassed by a closely-proximate outermost continuous circle. *Id.*

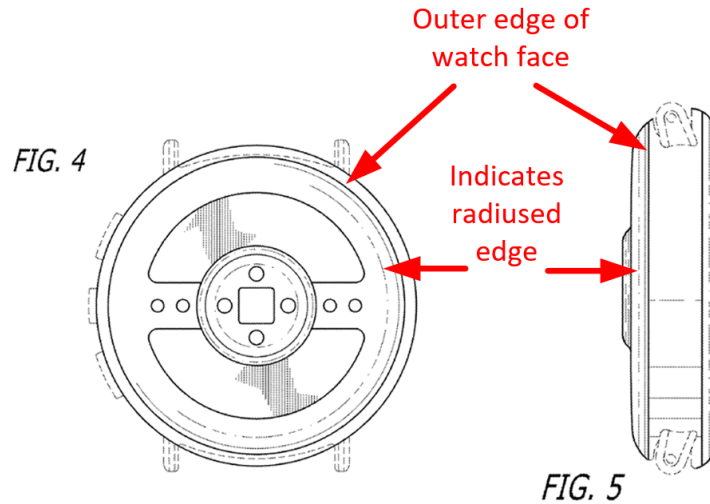
Additionally, the Petition ignores the claimed design's position of the outermost continuous circle relative to the inner edge of the arches. Each of these features are spaced from the other to highlight elegant circles of decreasing size.

In contrast, Fong's opposed shapes have a much thicker appearance, and Fong altogether lacks an outermost continuous circle in close proximity to the opposed shapes. EX2001, ¶86.



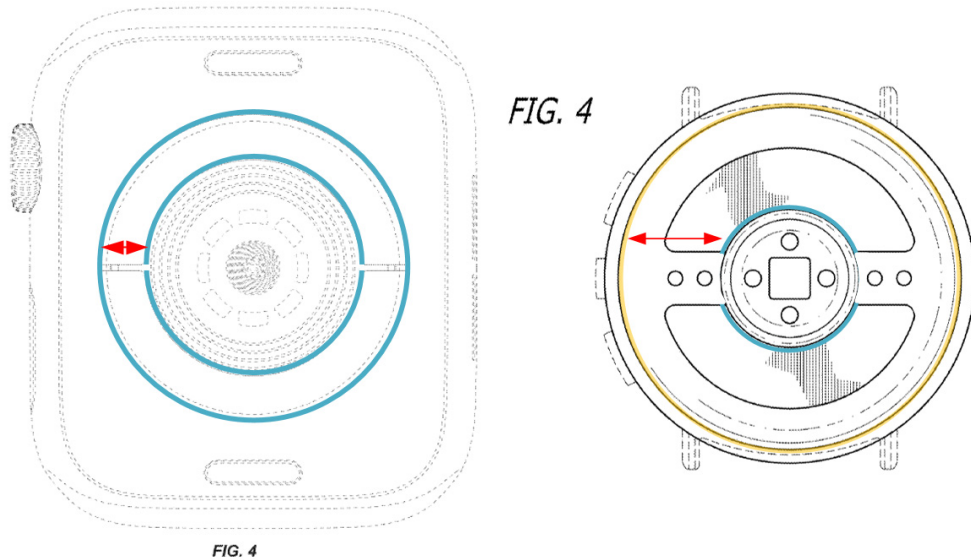
EX1008, Fig. 4.

To the extent Masimo relies on the circle delineating the back face of the watch in Fig. 4 (which the Petition never mentions), Fong's Fig. 2 makes clear that this line is included merely to show the edges of the curved rear surface of the watch.



EX2001, ¶87 (EX1008, Figs. 4 and 5 (annotated)).

Additionally, Fong's opposed shapes (inner edges in blue, below) are spaced significantly inwardly from the line included in Fig. 4 (yellow, below), here again conveying a different overall appearance that lacks the streamlined, well-proportioned appearance of the claimed design. EX2001, ¶89.



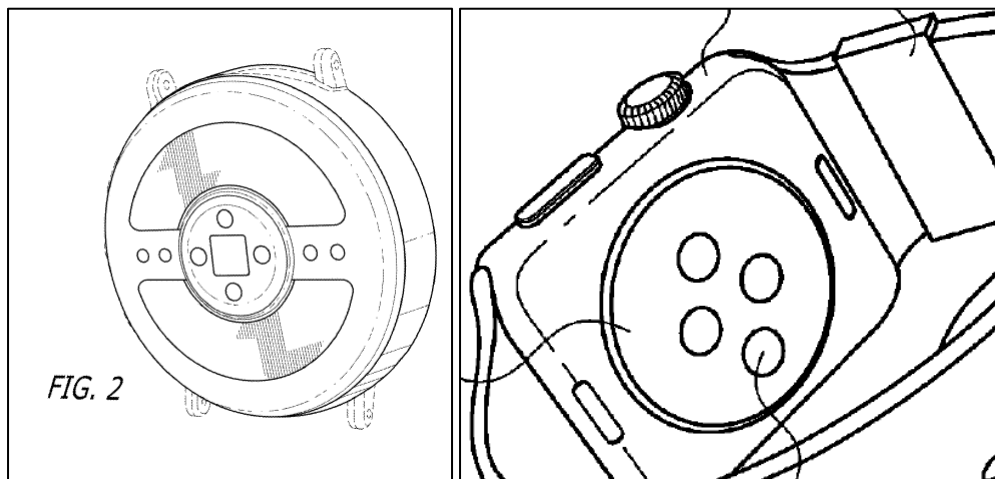
EX2001, ¶89 (Left: EX1001, Fig. 4 (annotated); Right: EX1008, Fig. 4 (annotated)).

Because the Petition has failed to provide any explanation that accounts for these visible differences, Masimo has not demonstrated that Fong is “a single reference that creates basically the same visual impression” as the claimed design. *High Point Design*, 730 F.3d at 1314; *Harvey*, 12 F.3d at 1063 (“Because major modifications would be required to make Harvey’s prior art vase look like the claimed designs, it cannot qualify as a basic design.”); EX2001, ¶90. The Petition is thus insufficient to establish that Fong is an appropriate primary reference, and therefore fails to demonstrate a reasonable likelihood that it would prevail in showing that the design claim is rendered obvious under Ground 3 for this independent reason.

2. Masimo Fails to Demonstrate that it Would Have Been Obvious to a DOSA To Modify Fong in View of Bushnell To Create the Claimed Design

a) Masimo Fails to Demonstrate that a DOSA Would Have Combined Bushnell with Fong

Masimo fails to demonstrate that a DOSA would have considered the proposed combination of Bushnell’s “convex housing component” with Fong’s design. Pet., 84. As described above, Bushnell’s rear face is square with a circular feature protruding from the center of the square. See EX1009, Figs. 1A, 2A. Bushnell includes four circular elements on the flat top surface of the protrusion. Fong also includes a protruding central portion, on which the square central element and configuration of four circles are positioned. See EX1008, Fig. 2; EX2001, ¶91.



Left: EX1008, Fig. 2; Right: EX1009, Fig. 1A (excerpted).

Moreover, Masimo’s proposed combination of Bushnell’s “convex housing” with Fong results in a fundamental change contrary to Fong’s original design. Fong

includes a protruding central circle that is on a different plane compared to the pair of opposed shapes above and below the central protruding circle. EX2001, ¶¶92-93. Petitioner ignores that its proposal would eliminate this arrangement in favor of a different arrangement that would cause the opposed shapes to protrude outwardly, and the inner circle to instead be recessed. *See, e.g.,* Pet., 85 (showing Petitioner’s proposed combined design). Masimo fails to demonstrate a DOSA would have considered such a modification to the detriment of Yuen and Mendelson’s original designs. *See Termax*, IPR2022-00106, Paper 7 at 30 (rejecting proposal that would result in fundamental change and indicating “the notably consistent symmetrical nature of both designs would not suggest that a skilled designer would destroy that symmetry by using a rounded platform with a rectangular platform”) (citing *Apple*, 678 F.3d at 1331).

Accordingly, Masimo fails to demonstrate that a DOSA would have made the proposed combination of Fong with Bushnell.

b) Masimo Fails to Demonstrate the Proposed Series of Modifications Would Have Been Obvious to a DOSA

Masimo acknowledges multiple additional modifications to provide features beyond that depicted by Fong or Bushnell, here again tacitly acknowledging that modifying Fong to use Bushnell’s “convex housing component 104” fails to achieve

the claimed design. These additional modifications are directed to features that are not depicted by either reference and are not trivial or *de minimis*. EX2001, ¶94.

The deficiencies discussed above are not remedied by Masimo's terse assertion that "any differences between the proposed combination (Fong and Bushnell) and the claimed design would have been changes that were taught by the prior art and a DOSA would have been motivated to make." As to Fong and Bushnell, the Petition fails to identify what those differences are, and certainly does not present any evidence that such changes "were taught by the prior art" or that a "DOSA would have been motivated to make" such changes. EX2001, ¶94. These bare assertions are woefully deficient in satisfying its burden.

V. CONCLUSION

For the foregoing reasons, Patent Owner requests that the Board deny institution on Grounds 1-3 of the Petition on the merits, and thus decline to institute *inter partes* review of the '936 patent.

Respectfully submitted,

Date: June 21, 2023

/Craig A. Deutsch/
W. Karl Renner, Reg. No. 41,265
Roberto J. Devoto, Reg. No. 55,108
Craig A. Deutsch, Reg. No. 69,264
Grace Kim, Reg. No. 71,977
Andrew Patrick, Reg. No. 63,471
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

CERTIFICATION UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response totals 8,371, which is less than the 14,000 allowed under 37 CFR § 42.24(b)(1).

Respectfully submitted,

Date: June 21, 2023

/Craig A. Deutsch/
W. Karl Renner, Reg. No. 41,265
Roberto J. Devoto, Reg. No. 55,108
Craig A. Deutsch, Reg. No. 69,264
Grace Kim, Reg. No. 71,977
Andrew Patrick, Reg. No. 63,471
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on June 21, 2023, a complete and entire copy of this Patent Owner's Preliminary Response and its supporting exhibits were provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

Douglas B. Wentzel (Reg. No. 74,897)
Jarom D. Kesler (Reg. No. 57,046)
Brian C. Claassen (Reg. No. 63,051)

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Telephone: (949) 760-0404
Facsimile: (949) 760-9502

E-mail: MasimoIPR936@knobbe.com

/Crena Pacheco/
Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
pacheco@fr.com