

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

MASIMO CORPORATION,
Patent Owner

Case IPR2024-00244
Patent No. 10,722,159

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO STRIKE**

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I. INTRODUCTION

Patent Owner's Motion to Strike (hereinafter "**Motion**" or Paper 32) is premised on blatant mischaracterizations of Petitioner's Reply (Paper 28) as purportedly including new arguments and combinations. Notably, Patent Owner ("**PO**") advanced similarly wrong allegations in IPR2022-01291 involving similar claims, evidence, and issues. In that instance, the Board held a conference call and determined that it was unnecessary to entertain a motion. Apple respectfully submits that the Board should similarly deny PO's Motion in the instant IPR.

II. THE BOARD PREVIOUSLY DENIED A SIMILAR REQUEST IN IPR2022-01291

PO's Motion is part of a failed playbook to remove relevant evidence from the record. In IPR2022-01291 challenging U.S. Patent No. 10,687,745, the same two parties addressed a similar set of references, and issues. *See generally*, IPR2022-01291, Papers 75, 76. As in this proceeding, PO attempted to strike evidence submitted with Petitioner's Reply. IPR2022-01291 Ex. 2096, 9:9-19. During a call, the Board denied PO's requested authorization for a motion to strike. *Id.*, 54:5-17 ("JUDGE HOSKINS: ... We've reviewed the Petitioner Reply. And by and large, we think it falls within the scope of the Petition. And the evidence and the arguments that are made are in response to arguments made in the Patent Owner Response, which the federal circuit has said need to be allowed ... the

Surreply is a sufficient vehicle ... for Patent Owner to raise whatever might be outside the scope of a permissible Reply.”) Here, PO again attempts to eliminate evidence that demonstrates flaws in the POR, and that should remain of record.

The Petition established a strong *prima facie* case of obviousness, and the evidence PO complains of was properly leveraged in the Reply to rebut points raised for the first time in the instant IPR within PO’s response. When PO chose to raise largely the same failed arguments in IPR2024-00241, -00243, and -00244 as it had previously attempted in IPR2022-01291, Petitioner properly responded with rebuttal evidence advanced in that proceeding.

III. THE PETITIONER REPLY EVIDENCE IS RESPONSIVE TO ARGUMENTS IN THE PATENT OWNER RESPONSE

PO’s allegations are incorrect for several reasons.

First, the Petitioner Reply remarks and evidence are properly responsive to arguments raised in the Patent Owner Response (POR). *See* 37 C.F.R. § 42.23(b); Consolidated Trial Practice Guide (Nov. 2019) at 73-75; *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015).

PO alleges that Apple “waived any arguments about” multiple prior art references that the Petitioner Reply leverages in support of rebuttal arguments, because Apple submitted those references into the record as exhibits EX1017, EX1036, EX1038, and EX1042–EX1048 at the time of petition filing, with related

testimony from Dr. Anthony at ¶¶94–113 of EX1003. Paper 32, 3-6.

PO's arguments are misplaced, at least insofar as the Petitioner Reply properly referenced these and other Exhibits in support of Petitioner's response to POR arguments. For example, the Reply referenced EX1017, EX1036, EX1038, and EX1042–EX1048 to address arguments on reasonable expectation of success that PO raised for the first time in the instant IPR within its POR. Pet. Reply, 20-27; APPLE-1079, ¶¶35-38.

More, PO cannot reasonably complain of being prejudiced by the Reply's presentation of rebuttal arguments addressing evidence of which PO was already aware at the time it filed the POR. For example, PO suggests that "the Reply newly argues that Fontaine (EX1042) shows a group of undergraduates measuring oxygen saturation," but adds in the immediately following sentence that "Apple's expert made that argument in his original expert declaration at paragraph 79." Paper 31, 5-6. In that regard, PO effectively admits that it could have, within the POR, attempted to address Fontaine and other references that corroborate reasonable expectation of success, but chose not to.

Far from introducing new arguments, the Reply properly leveraged those references to respond to and refute arguments on reasonable expectation of success that PO chose to present in defiance of evidence that was already of record.

Even in instances in which a petitioner's rebuttal arguments and evidence

were not so plainly responsive to issues raised in a POR as those in the instant IPR, the Federal Circuit has previously found new argument allegations unpersuasive. For example, in *Rembrandt Diagnostics, LP v. Alere, Inc.*, the petitioner presented arguments and evidence to supplement its reasons why a person skilled in the art would have been motivated to combine the applied references, and the Federal Circuit rejected the patent owner's argument that the petitioner had relied on “new theories asserted for the first time in its reply brief” to challenge the claims after institution. 76 F.4th 1376, 1379 (Fed. Cir. 2023).

The Federal Circuit held that the petitioner's arguments introduced in the reply were properly “responsive” because they “refute[]” Patent Owner’s arguments and are thus a “fair expansion of [Petitioner's] previously raised” arguments on motivation to combine. *Id.*, 1385. In doing so, the Federal Circuit explained that “[s]ince the need to rely on new evidence in response may not arise until a particular point has been raised in the patent owner response ... there is no blanket prohibition against the introduction of new evidence during an IPR.” *Id.*, 1384. Consistent with the Federal Circuit’s decision in *Rembrandt Diagnostics*, the Board should reject as improper PO’s allegations of new argument in this IPR.

Moreover, this is not a case of shifting arguments. Petitioner’s grounds and positions remain the same, e.g., that Sarantos renders the claims obvious under Ground 1A and that Sarantos in view of Shie renders the claims obvious under

Ground 1B. PO advanced arguments contesting that a POSITA would have reasonably expected success, and that a POSITA would have found it obvious to measure oxygen saturation at the wrist. *See e.g.*, POR, 40-66. Petitioner amply demonstrated these points in the Petition, and properly addressed PO's arguments in the Reply with rebuttal arguments and corroborating evidence that consistently reinforces the earlier showings.

Second, PO improperly alleges that Petitioner Reply evidence was submitted late and prejudices PO. *See* Paper 32, 6-7. Petitioner submitted an initial set of evidence with its Petition, and because several of the references and even claims in this IPR are similar to those in IPR2022-01291, Petitioner included many exhibits that were the same as in IPR2022-01291. The Petition did not include the entire record from IPR2022-01291, both because it was not necessary to do so to establish a *prima facie* case of obviousness, and because Petitioner could not have predicted that PO would raise substantially the same arguments as those found unpersuasive in IPR2022-01291, where all claims were found unpatentable.

“[A] Petitioner ... cannot be expected to anticipate every argument that may be raised by a patent owner,” nor does it have the burden to speculate as to the potential nature of those arguments and preempt them. *Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 11, 5 (PTAB Mar. 2003) Here, Petitioner

could not have predicted that PO would elect to essentially repeat its failed arguments on reasonable expectation of success from IPR2022-01291. Indeed, upon deciding to resubmit its previously unsuccessful arguments, PO should have reasonably predicted that Petitioner would submit the same *successful* rebuttal evidence provided in the earlier IPR2022-01291 proceeding. PO could have chosen to address that evidence in its POR, but failed to do so.

To be clear, the arguments and evidence relied upon in the Petition are, on their own, more than sufficient to demonstrate the unpatentability of the Challenged Claims, and the Reply properly rebutted the POR in a manner perfectly consistent with the Petition's original positions.

Third, there is no prejudice to PO here. The issues in the IPR2022-01291 proceeding and this IPR proceeding largely mirror each other. When PO chose to repeat its failed arguments in this proceeding instead of raising new ones, PO was fully aware that the same evidence used in the IPR2022-01291 proceeding could be used against it. Thus, use of evidence from IPR2022-01291 to address essentially the same issues in this IPR proceeding does not prejudice PO as PO has long been aware of this evidence.

IV. MASIMO'S COMPLAINTS ABOUT THE DUCKWORTH TESTIMONY HAVE NO BASIS

PO complains that Petitioner relies on Dr. Duckworth's testimony (EX1080)

from IPR2022-01291 in support of its arguments, and accuses Petitioner of “mix[ing] and match[ing] IPR records from different proceedings.” Paper 32, 6-7. As a preliminary matter, there is nothing wrong with citing publicly available documents from other IPR proceedings. Moreover, PO’s complaint is absurd given that PO itself has repeatedly cited to and relied upon evidence from IPR2022-01291 throughout the instant IPR. That PO submitted other exhibits from IPR2022-01291 when it was procedurally proper to do so, but not Dr. Duckworth’s declaration, was PO’s choice.

Ultimately, PO’s complaint amounts to nothing more than PO being unhappy with Reply evidence that refutes arguments entered with the POR. Yet, it is proper for a Petitioner to submit evidence that “fairly responds” to arguments and evidence entered for the first time in a POR, especially where, as here, the Reply evidence was not needed to establish a *prima facie* case of unpatentability. *See Belden Inc.* at 1077–79. Nor can PO reasonably complain of being prejudiced by entry of evidence of which PO was aware at the time of the POR filing.

To date, PO has made three emailed requests for waiver of the rules governing submission of sur-reply evidence in its favor, and the Board has in each instance properly rejected PO’s requests, as it instead granted PO the opportunity to air its concerns through the authorized motion to strike that is the subject of this opposition, and that PO initially requested as an alternative to new sur-reply

evidence. EX3003, 1-2; EX3004, 1-2. As PO's motion to strike again raised the issue of new sur-reply evidence, Apple respectfully submits that the Board's continued rejection of Masimo's repeated requests is proper, and that the Board should also reject new sur-reply evidence for at least the same reasons that Masimo's motion to strike should be denied.

V. CONCLUSION

Apple respectfully requests that the Board deny PO's Motion to Strike.

Respectfully submitted,

Date: March 17, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on March 17, 2025 a complete and entire copy of this Petitioner's Opposition to Patent Owner's Motion to Strike were provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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