

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner

Case IPR2024-00294
U.S. Patent 10,736,507

PETITIONER'S MOTION TO STRIKE

Petitioner, Apple Inc., respectfully requests that select portions of Masimo's Sur-Reply, as discussed below, be struck from the record for containing impermissible new arguments regarding the scope of the claim term "one or more signals responsive to light."

The Board has made clear that it is impermissible for a patent owner to raise "new claim construction arguments in its Sur-reply without any attempt to justify the failure to include them in the Patent Owner Response." *Caterpillar Inc. v. Wirtgen America, Inc.*, IPR2022-01278, Paper 34 at 43-44 (PTAB Feb. 6, 2024). Yet, Masimo attempts to do so here. For the first time, Masimo proposes a new scope for the claims in its Sur-Reply and, thus, prevents Petitioner from addressing its new arguments. The proper remedy here is to strike Masimo's "untimely argument[s]" from the record. *Ford Motor Company v. Safe Driving Technologies LLC*, IPR2022-00086, Paper 25 at 37 (PTAB May 15, 2023); *see also Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (any "new theory first raised in reply" should be disregarded).

Although Masimo appears to assert that the "plain and ordinary meaning" should be applied to the claim term "one or more signals responsive to light" in both its Patent Owner's Response ("POR") and Sur-Reply, Masimo impermissibly shifts its arguments between the two briefs, asserting for the first time in its Sur-

Reply that analog-to-digital conversion of a signal falls outside of the scope of this term. *Compare* POR, 18-23 with Sur-Reply, 1-10. Turning first to the POR, Masimo asserted that “[a] POSITA would have understood that the plain and ordinary meaning of ‘one or more signals responsive to light’ output by the optical sensor refers to ***data that is actually acquired*** with the optical sensor.” POR, 18 (emphasis original). Notably, the POR never asserts that the “one or more signals” are required to be analog signals. *Id.*, 18-23. The POR describes that as part of the pre-processing steps performed by Mendelson’s optical sensor, the signals are “converted from analog to digital by an ‘ADC,’” but Masimo never asserts that such analog-to-digital conversion falls outside the scope of the term “one or more signals responsive to light.” *Id.*, 20-21. Rather, in the very next paragraph, the POR asserts that it is the alleged “averag[ing] [of] red and infrared PPG samples” in Mendelson that falls outside the scope of this claim term.¹ *Id.*, 21.

In the Sur-Reply, Masimo asserts ***for the first time*** that the one or more signals are required to be “analog” and that “analog-to-digital conversion falls outside the scope of ‘one or more signals responsive to light.’” Sur-Reply, 1, 3.

¹ As addressed in the Petitioner’s Reply, there is no discussion of averaging of PPG samples in Mendelson. Pet. Rep., 11-14.

Masimo spends multiple pages advancing this improper new theory before finally reaching any discussion of its original theory based on alleged averaging of PPG samples on page 6. *Id.*, 6.

All arguments related to Masimo's new theory that analog-to-digital conversion of a signal falls outside the scope of the claimed "one or more signals" should be struck from the record for being raised for the first time in the Sur-Reply. Masimo's improper new arguments in the Sur-reply can be found on: (1) page 1 with reference to expert testimony regarding a "varying analog signal" and "analog-to-digital conversion," and (2) pages 3-10 with multiple references to "the ***analog*** signal actually acquired" and the "analog signal" output by Mendelson's photodiode; discussion of Mendelson's ADC and "analog-to-digital conversion"; and assertions that the "***analog*** signal is never transmitted by Mendelson's Sensor Module" and the output of Mendelson's "Sensor Module are not the ***analog*** signal actually acquired." *Id.*, 1, 3-10. Masimo's assertions on page 5 that the claims require that "all processing occur[s] ***after*** the data reaches the processing board" are also improperly new as such an assertion was never made in the POR. *Id.*, 5.

For the reasons above, all arguments based on Masimo's new assertion that analog-to-digital conversion falls outside of the claim scope should be struck.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on March 21, 2025, a complete and entire copy of this Petitioner's Motion to Strike was provided via email to Patent Owner by serving the correspondence email addresses of record as follows:

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