

Filed: May 28, 2024

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2024-00296
U.S. Patent 10,984,911

**PATENT OWNER MASIMO CORPORATION'S
PRELIMINARY SUR-REPLY**

EXHIBIT LIST

Exhibit	Description
2001	<i>Curriculum Vitae</i> of Vijay K. Madiseti, Ph.D.
2002	Declaration of Vijay K. Madiseti, Ph.D.
2003	Commission Opinion (Public), <i>Certain Light-Based Physiological Measurement Devices and Components Thereof</i> , Inv. No. 337-TA-1276, EDIS No. 808521 (ITC Oct. 26, 2023)
2004	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01271, Paper 15 (PTAB Jan. 24, 2023)
2005	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01272, Paper 16 (PTAB Jan. 24, 2023)
2006	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01273, Paper 15 (PTAB Jan. 24, 2023)
2007	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01274, Paper 15 (PTAB Jan. 24, 2023)
2008	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01275, Paper 15 (PTAB Jan. 30, 2023)
2009	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01276, Paper 15 (PTAB Jan. 30, 2023)
2010	Plaintiff Apple Inc.'s Opposition to Defendants' Motion for Stay Pending <i>Inter Partes</i> Review (Public), <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del. Jan. 10, 2024), D.I. 457
2011	Plaintiff Apple Inc.'s Opening Brief in Support of Its Motion for an Expedited Trial, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1377-MN-JLH (D. Del. Feb. 10, 2023), D.I. 50
2012	Transcript of May 5, 2023 Hearing, <i>Apple Inc. v. Masimo Corp.</i> , Nos. 22-1377-MN-JLH, 22-1378-MN-JLH (D. Del. May 5, 2023)
2013	Original Scheduling Order, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-

Exhibit	Description
	1378-MN-JLH (D. Del. May 25, 2023), D.I. 92
2014	Amended Scheduling Order, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del. Sept. 21, 2023), D.I. 359
2015	Lex Machina Patent Case Timeline Statistics for the District of Delaware between December 12, 2022 and December 12, 2023
2016	Lex Machina Case Statistics for Magistrate Judge Jennifer Hall
2017	Lex Machina Case Statistics for District Court Judges in the District of Delaware (Judges Connolly, Noreika, Andrews, Williams, and Hall)
2018	Transcript of September 14, 2023 Markman Hearing, <i>Apple Inc. v. Masimo Corp.</i> , Nos. 22-cv-1377-MN-JLH, 22-cv-1378-MN-JLH
2019	Aaron Tilley, <i>The Entrepreneur Who Bet His Company on a Fight With Apple</i> , Wall Street J., Dec. 30, 2023, https://www.wsj.com/tech/joe-kiani-entrepreneur-apple-warning-52eb09a9
2020	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1271, Paper 20 (PTAB June 20, 2023)
2021	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1272, Paper 20 (PTAB June 20, 2023)
2022	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1273, Paper 19 (PTAB June 20, 2023)
2023	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1274, Paper 19 (PTAB June 20, 2023)
2024	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1275, Paper 19 (PTAB June 26, 2023)
2025	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1276, Paper 20 (PTAB June 26, 2023)
2026	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1292,

Exhibit	Description
	Paper 17 (PTAB Mar. 7, 2023)
2027	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1466, Paper 17 (PTAB Apr. 5, 2023)
2028	Correspondence from counsel for Apple to counsel for Masimo regarding Apple's prior art grounds in the Delaware Litigation, dated November 16, 2023
2029	Revised and Corrected Transcript of June 6, 2022 Hearing Open Sessions in <i>In re Certain Light-Based Physiological Measurement Devices and Components Thereof</i> , Inv. No. 337-TA-1276 (ITC).
2030	Excerpts of November 8, 2023 Deposition of Mohamed Diab, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2031	Joint Claim Construction Brief Regarding Masimo Asserted Patents, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-01378-MN-JLH (D. Del. Aug. 31, 2023), D.I. 295
2032	Excerpts of December 15, 2023 Rebuttal Expert Report of Steven Warren (Public), <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2033	Exhibit E-5 to Apple's June 8, 2023 Initial Invalidity Contentions based on Abdul-Hafiz (U.S. Patent Appl. Pub. No. 2004/0039272, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2034	Exhibit E-10 to Apple's June 8, 2023 Initial Invalidity Contentions, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2035	Exhibit E-8 to Apple's June 8, 2023 Initial Invalidity Contentions based on Masimo SET System, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2036	Excerpts of Masimo's September 7, 2023 Responses to Apple Inc.'s Final Invalidity Contentions, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2037	Photographs produced by Apple as APL_DEL04011694-695,

Exhibit	Description
	APL_DEL04011703-704, APL_DEL04011718-719, APL_DEL04011721, APL_DEL04011734, APL_DEL04011827, APL_DEL04011833, APL_DEL04011842
2038	Masimo LNOP & NR SpO ₂ adhesive & reusable sensors brochure, dated 2003, produced by Apple as APL_DEL00037755-756
2039	Photograph produced by Apple as APL_DEL04011705
2040	Photograph produced by Apple as APL_DEL04011717
2041	Datex-Ohmeda 3800 Pulse Oximeter TruTrak [®] + User's Manual, Datex-Ohmeda (Oct. 2002)
2042	U.S. Patent No. 7,096,054 (previously published as Abdul-Hafiz – U.S. Patent Publ. No. 2004/0039272)
2043	Masimo Patent Information, https://professional.masimo.com/company/masimo/patents/ (last visited Mar. 22, 2024)
2044	Photograph produced by Apple as APL_DEL04011734
2045	Photograph produced by Apple as APL_DEL04011735
2046	<i>Masimo Corporation Announces Masimo Rainbow SET, the World's First Pulse CO-Oximeter</i> , Masimo (Mar. 1, 2005), https://professional.masimo.com/company/news/news-media/2005#news-90640ab1-c7ae-4b6f-903a-d1faabe003c6
2047	Steven J. Barker et al., <i>Measurement of Carboxyhemoglobin and Methemoglobin by Pulse Oximetry: A Human Volunteer Study</i> , 105 <i>Anesthesiology</i> 892 (2006)
2048	Mike McEvoy, <i>Non-invasive Screening for CO and MET</i> , EMS1 (Jan. 29, 2009), https://www.ems1.com/ems-products/co-screening/articles/non-invasive-screening-for-co-and-met-rW7fnwZeumUrE2P4/
2049	Selim Suner and John McMurdy, <i>Masimo Rad-57 Pulse CO-OximeterTM for noninvasive carboxyhemoglobin measurement</i> , 6

Exhibit	Description
	Expert Rev. Med. Devices 125 (2009)
2050	Recordation of Merger Conveying Patents (including EX1007) from Ohmeda, Inc. to Datex-Ohmeda, Inc.
2051	U.S. Patent No. 7,277,741
2052	U.S. Patent No. 9,341,565
2053	Datex-Ohmeda CardiCap™/5 Technical Reference Manual, Datex-Ohmeda (2d ed. May 9, 2007)
2054	Excerpts of Apple Watch photographs produced by Masimo as MASITC_01398584-621
2055	Excerpts of Apple Watch photographs produced by Masimo as MASITC_01402291-294
2056	Rimantas P. Buinevicius, <i>A Three-Wavelength Pulse Oximeter for Carboxyhemoglobin Determination</i> , University of Wisconsin-Madison Master of Science Thesis (1987)
2057	Jim Welch, 39 <i>The Fundamentals of Pulse Oximeters</i> , Biomedical Instrumentation & Tech. 125 (2005)
2058	Disposable Pulse Oximeter Sensors, Curbell Medical (2022)
2059	Rad-57 Operator's Manual, Masimo (2006)
2060	John Feiner et al., <i>Accuracy of Carboxyhemoglobin Detection by Pulse CO-Oximeter During Hypoxemia</i> , 117 <i>Anesthesia & Analgesia</i> 847 (2013)
2061	Masimo Signal Extraction Technology brochure, dated 2001, produced by Apple as APL_DEL00037764-771
2062	Masimo Signal Extraction Technology Technical Bulletin, dated 2001, produced by Apple as APL_DEL00037757-763
2063	Datex-Ohmeda S/5™ M-Modules Technical Reference Manual, Datex-Ohmeda (June 2005)

Exhibit	Description
2064	Excerpt of Defendant Masimo Corp.'s Letter Brief (Public) Regarding Cross-Use, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del. Mar. 13, 2024), D.I. 621
2065	Excerpt of Transcript of March 20, 2024 Hearing, <i>Apple Inc. v. Masimo Corp.</i> , Nos. 22-cv-1377-MN-JLH, 22-cv-1378-MN-JLH
2066	Excerpt of correspondence between counsel for Apple in Delaware Litigation and counsel for Masimo regarding cross-use of Apple information in IPRs, dated March 27, 2024
2067	U.S. Patent No. 7,272,425
2068	<i>Unimed Medical Disposable SpO2 Sensor, Your Priority Choice!</i> , Unimed (Sept. 18, 2021), https://www.unimed.cn/blogs/news/unimed-medical-disposable-spo2-sensor-your-priority-choice
2069	Patent Owner Preliminary Response, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01271, Paper 10 (PTAB Oct. 26, 2022)
2070	Patent Owner Preliminary Response, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01272, Paper 11 (PTAB Oct. 26, 2022)
2071	Patent Owner Preliminary Response, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01273, Paper 10 (PTAB Nov. 4, 2022)
2072	Patent Owner Preliminary Response, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01274, Paper 10 (PTAB Nov. 4, 2022)
2073	Patent Owner Preliminary Response, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01275, Paper 10 (PTAB Nov. 4, 2022)
2074	Patent Owner Preliminary Response, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01276, Paper 10 (PTAB Nov. 4, 2022)
2075	<i>Apple Watch Series 6</i> , Apple (last visited Dec. 28, 2020), produced by Masimo at MASITC_00918307-327
2076	<i>Apple Watch Series 6 delivers breakthrough wellness and fitness</i>

Exhibit	Description
	<i>capabilities</i> , Apple (Sept. 15, 2020), https://www.apple.com/newsroom/2020/09/apple-watch-series-6-delivers-breakthrough-wellness-and-fitness-capabilities/ , produced by Apple at APL_MAS_ITC_00310976-989
2077	Apple Watch Series 6 Video
2078	Apple Watch Series 6 “It Already Does That” Commercial

I. THE BOARD SHOULD DENY INSTITUTION

Apple again fails to explain why it delayed filing this Petition until after the Delaware Litigation progressed through all discovery and dispositive motions on the patent at issue here. Apple asks the Board not to deny institution because a “holistic analysis of the *Fintiv* factors favors institution.” Reply, 3. But Apple presents no such analysis. Instead, Apple attempts to trivialize its delay based on incomplete representations and speculation about a trial date in response to a single *Fintiv* factor.

Apple also fails to address any of the extensive discovery and motion practice for this patent set forth by Masimo. POPR, 18-22. And as Masimo correctly represented, the Delaware Litigation is ready for trial *with respect to the patent at issue here*. Apple does not even address the case status regarding this patent, but instead speculates about a trial date based upon “5 patents that were statutorily stayed at the Delaware Litigation’s outset.” Reply, 2. Apple also emphasizes Masimo’s suggestion about the most efficient path being a single trial before Judge Hall as if that shows some inconsistency. But Masimo advocates the same position here, urging the Board to avoid duplicative proceedings based on references and arguments that Apple previously dropped from the Delaware Litigation.

Apple suggests that additional discovery may be necessary for those five other patents but omits Masimo’s proposal to Judge Hall that “In the meantime, the parties should conduct discovery” and that doing so “*now* would position the case for a

more prompt trial once the Federal Circuit rules in the ITC Case.” EX1075, 8. Worse, in speculating here about an “after September, 2025” trial date, Apple ignores its own argument to Judge Hall that the trial on Masimo’s patents “could be held *later this year* or next year, as this Court’s schedule permits.” *Id.*, 5.

Apple’s new “*Sotera* stipulation” confirms the inadequacy of its prior stipulation. But the new stipulation does not address or cure the prejudice to Masimo from Apple unfairly resurrecting references and arguments that it previously dropped from the Delaware Litigation. Apple made that election only after the parties and the court conducted extensive and costly fact and expert discovery, and fully briefed and argued dispositive motions. This differs from *Sotera*, who filed its stipulation in the early stages of the parallel litigation. Apple belatedly attaching the label “*Sotera* stipulation” only after the Delaware Litigation is ready for trial does not protect against the concerns underlying the Director’s Guidance—gamesmanship and inefficiency. Under these circumstances, the Board should deny institution in the interest of fairness and to promote efficient use of resources.

Moreover, the Director’s Guidance provides that “even if the PTAB does not deny institution under *Fintiv*, it retains the right to deny institution for other reasons,” including under § 325(d). EX1060, 9. Apple ignores that the *Advanced Bionics* framework independently favors denial under § 325(d). Apple’s three Petition references were presented to and considered by the Patent Office during prosecution,

and Apple failed to meet its burden of demonstrating any material error during prosecution. POPR, 28-31. Thus, the Petition should also be denied under § 325(d).

Advanced Bionics LLC v. MED-EL Elektromedizinische Gerate GmbH, IPR2019-01469, Paper 6, 8-9 (PTAB Feb. 13, 2020). Apple has no response.

II. THE PETITION’S PRIOR ART DOES NOT SATISFY APPLE’S DISTRICT COURT CLAIM CONSTRUCTIONS

Apple concedes that its Petition applies only Masimo’s claim constructions, which “Apple does not agree” are correct. Reply, 3. Indeed, Apple argued in the Delaware Litigation that Masimo’s constructions are wrong and do not reflect the plain meaning of the disputed terms (“cavity,” “a light block...,” “top,” and “opening”). EX2031, 57-84. Apple’s grounds thus depend on interpretations of these terms that differ from Apple’s view of their plain meaning. Therefore, Apple needed to explain “[h]ow the challenged claim[s] [are] to be construed” and why the Board should adopt those proposed constructions. 37 C.F.R. § 42.104(b)(3); *OrthoPediatrics Corp. v. K2M, Inc.*, Case IPR2018-01548, Paper 9, 10 (March 1, 2019) (quoting same). But Apple never satisfied either requirement.

The Board has denied petitions for failing to satisfy 37 C.F.R. § 42.104(b)(3) where the petitioner argues “no construction necessary” despite knowing the parties disputed the meaning of the relevant terms. *See, e.g., 10X Genomics, Inc. v. President & Fellows of Harvard College*, IPR2023-01229, Paper 15 (Mar. 7, 2024); *Ebates Perf. Marketing, Inc. v. Int’l Business Machines Corp.*, IPR2022-00439,

Paper 11, 8-12 (Oct. 3, 2022). Here, Apple did just that by failing to set forth constructions (or supporting evidence) despite its pre-Petition knowledge that it disputed the meaning of “cavity,” “a light block...,” “top,” and “opening.” Apple’s failure renders the Petition facially deficient under § 42.104(b)(3).

Attempting to excuse its failure to set forth constructions or reasons to adopt them, Apple now argues its Petition is “consistent with” its Delaware constructions. Reply, 3. But Apple’s expert never considered, much less addressed, Apple’s Delaware constructions. *See* EX1003. Only Masimo’s expert did, and he explained the Petition’s references do not meet Apple’s Delaware constructions. EX2002 ¶¶61-62. Apple thus relies solely on attorney argument about its Delaware constructions, which fails show how a POSITA would have understood the art. Reply, 3-6.

Raley Has No “Cavity” Under Apple’s DE Construction: Apple concedes that Raley’s “LEDs 21-24 ‘are flush’ with (i.e., not protruding from) the window/opening 26.” Reply, 5. Because Raley’s LEDs are “flush with” the window/opening 26, they are not recessed and not in a hollowed-out space. EX1005, FIG. 3; EX2002 ¶¶61. Apple’s conclusory argument fails to show otherwise.

Apple also argues that when Raley’s connector-end 25 is “inserted into” the connector 17, “the LEDs 21-24 are recessed in the cavity surrounded by connector 17 and lip portions 17a-c.” Reply, 6. But because that alleged cavity is formed by separate components (Raley’s connector-end 25 and connector 17), Raley’s LEDs

are not recessed into a cavity “within *a solid body*.” EX1005, FIGS. 1-4, 5:15-23, 5:38-47, 5:57-62, 6:6-12; EX2002 ¶61. Further, in Delaware, Apple argued that the claims “require[] setting the LEDs back into a pre-existing cavity.” EX2032 ¶476. Here, Apple fails to argue, much less show, that Raley meets this additional requirement of Apple’s Delaware construction. Reply, 4-6.

Abdul-Hafiz Has No “Top” Under Apple’s DE Construction: Apple argues “the base 460 [of Abdul-Hafiz] is the uppermost structure that covers” the alleged light block 400, as its Delaware construction requires. Reply, 4. But in Delaware, Apple argued “*the claims distinguish the ‘top’ portion of the [light block] structure from its ‘base’* and ‘side walls’ and recite that the ‘top forms an enclosure.’” EX2031, 75; EX2032 ¶528 (“the claim term ‘top’ refers to an uppermost structure and an uppermost position relative to the base of the light block”). Thus, Abdul-Hafiz does not meet Apple’s Delaware construction because the alleged light block’s “base” cannot also be its “top.” POPR, 13; EX2002 ¶62.

Further, “petitioners have an *obligation* to inform the PTAB of all claim construction arguments in related district court litigation, regardless of their inconsistency with arguments advanced at the PTAB.” Stuart Nelson & Kim Leung, *The Importance of Candor in PTAB Practice*, Fish & Richardson P.C. (Dec. 17, 2019), <https://www.fr.com/insights/thought-leadership/blogs/the-importance-of-candor-in-ptab-practice-2/>. Apple fails to explain how it complied with that

obligation here. POPR, 10-11, 26-28. Masimo therefore respectfully requests that the Board deny institution.

III. APPLE’S FAILURE TO ADDRESS KNOWN OBJECTIVE INDICIA OF NONOBVIOUSNESS WARRANTS DENYING INSTITUTION

Apple attempts to excuse its failure to address known evidence of commercial success by arguing that evidence was not “fully developed” and not raised “specific to the ’911 patent in the district court” until after Apple filed the Petition. Reply, 6-8. But neither assertion is correct.

Long before the Petition, in ITC litigation involving different Masimo patents, Masimo set forth evidence that (1) Apple Watches’ commercial success is attributable to the blood oxygen feature, and (2) that feature infringes Masimo’s patents. *See, e.g.*, EX2003, 45-46. That evidence was developed fully during the litigation such that the Commission ultimately agreed “Apple Watch Series 6 was commercially successful and that ‘this may be due in some part to its blood oxygen monitoring features.’” *Id.*

And months before the Petition, Masimo presented nearly identical evidence for the ’911 Patent in the Delaware Litigation. For example, Masimo contended that Apple Watch Series 6 infringes the ’911 Patent in December 2022. EX1064 ¶¶369-377. And Masimo’s August 21, 2023 interrogatory response included the arguments and evidence from the ITC litigation that Apple Watches’ commercial success is

attributable to their infringing blood oxygen feature.¹ Apple responded a few days later, arguing that any commercial success of the Apple Watch Series 6 (and other Watches with the blood oxygen feature) is not attributable to the '911 Patent at least because those products do not infringe that patent and because any commercial success does not bear a nexus to the asserted '911 Patent claims.

Here, Apple chose not to address the specific commercial success arguments and evidence for the '911 Patent raised by Masimo despite having them well before filing the Petition. Apple's reliance on *Symantec* and similar decisions is misplaced because Masimo's evidence is not "mere speculation." Rather, the Commission's assessment of virtually the same commercial success evidence shows that, like in *Stryker*, *Bosch*, and *Gilead*, the evidence was developed and required a response.

Apple does not dispute that the accused Apple Watches' commercial success. Instead, in one sentence, Apple faults Masimo for not providing evidence "such as the relative sales volume of the Apple Watch Series 6 versus any other of Apple's products" (e.g., Watches without the blood oxygen feature). Reply, 8. But Apple omits that it refused to permit Masimo to present such sales data. EX2066. Apple also ignores the other evidence set forth by Masimo. For example, Masimo cites POPRs (*see, e.g.*, EX2070, 25-26) and a Commission opinion (EX2003, 45-46)

¹ Apple refuses to agree to submission of such materials here . EX2066. But Apple's refusal does not change that Apple was aware of Masimo's commercial success evidence for the '911 Patent well before filing the Petition.

discussing the commercial success of Apple Watch Series 6 and how its blood oxygen feature was the key differentiating feature over previous Watches. Similarly, Masimo’s economics expert showed that “sales of the Apple Watch Series 6 far exceeded sales of previous Apple Watches, and Apple advertised the blood oxygen feature as the key differentiator of the Series 6 over the Series 5.” *Certain Light-Based Physiological Monitoring Devices*, Inv. No. 337-TA-1276, EDIS Doc. ID 789795, Final Initial Determination, 154 (USITC Feb. 7, 2023). That advertising supports a nexus between commercial success and the claims. POPR, 73.

Moreover, because the Watches embody the claims, the nexus is presumed. POPR, 73; EX2002 ¶¶132-133. To rebut this presumption, Apple needed to show that the evidence of commercial success was ““due to extraneous factors other than the patented invention.”” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016). But Apple did not. Instead, it provides one sentence of attorney argument that Apple Watch Series 6 has features beyond blood oxygen. Reply, 8. But “a patent challenger cannot successfully rebut the presumption with argument alone—it must present evidence.” *WBIP*, 829 F.3d at 1329; *see Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1378 (Fed. Cir. 2000) (applying presumption even though commercial product had unclaimed feature). Apple’s failure to address this known evidence justifies denying institution. *See, e.g., Robert Bosch Tool Corp. v. SD3, LLC*, IPR2016-01751, Paper 15, 23-25 (PTAB Mar. 22, 2017).

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Apple Inc. v. Masimo Corp.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 28, 2024

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Attorney for Patent Owner

Masimo Corporation

CERTIFICATE OF PAGE LIMITATIONS

The undersigned certifies that foregoing **PATENT OWNER MASIMO CORPORATION'S PRELIMINARY SUR-REPLY** has 8 pages and therefore complies with the page limit authorized in the Board's email dated May 15, 2024.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 28, 2024

/Brian C. Claassen/

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Masimo Corporation

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Apple, a true and correct copy of the foregoing **PATENT OWNER MASIMO CORPORATION'S PRELIMINARY SUR-REPLY** is being served electronically on May 28, 2024, to the e-mail addresses shown below:

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Dated: May 28, 2024

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