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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 IPR2020-01520
U.S. Patent 10,258,265

**UNOPPOSED MOTION FOR WILLIAM R. ZIMMERMAN TO APPEAR
PRO HAC VICE ON BEHALF OF PATENT OWNER MASIMO
CORPORATION**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to the Board's September 17, 2020, Notice of Filing Date Accorded (Paper 3) and 37 C.F.R. §§ 42.10(c) and 42.22, Patent Owner Masimo Corporation ("Masimo") hereby moves for an Order allowing William R. Zimmerman of Knobbe, Martens, Olson & Bear, LLP to appear *pro hac vice* on behalf of Masimo in the above-captioned case. Masimo has conferred with counsel for Petitioner Apple, Inc. ("Apple"), and Apple's counsel indicated that Apple does not intend to oppose Masimo's motion to allow Mr. Zimmerman to appear *pro hac vice* in this matter.

II. LIST OF EXHIBITS RELIED UPON FOR THIS MOTION

Masimo Exhibit 2002 - Declaration of William R. Zimmerman in Support of Motion to Appear *Pro Hac Vice* on Behalf of Patent Owner Masimo Corporation.

III. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED

As set forth below in the Statement of Material Facts, Masimo has made all of the showings required under 37 C.F.R. § 42.10(c) for recognizing Mr. Zimmerman *pro hac vice*. In particular, Mr. Zimmerman is an experienced litigation attorney who has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit, including technically and legally complex matters such as will be present

in this proceeding. Accordingly, allowing Mr. Zimmerman to appear *pro hac vice* on behalf of Masimo is appropriate in this proceeding.

IV. STATEMENT OF MATERIAL FACTS

1. 37 C.F.R. § 42.10(c) provides that “[t]he Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.”

2. Lead counsel for Masimo in this *inter partes* review proceeding is Joseph R. Re. Mr. Re is registered to practice before the United States Patent and Trademark Office and holds Registration No. 31,291.

3. As set forth in Masimo Exhibit 2002 (the “Zimmerman Declaration”), Mr. Zimmerman is an experienced litigating attorney and has an established familiarity with the subject matter at issue in this proceeding. Zimmerman Decl.

¶ 4. In particular, Mr. Zimmerman has approximately 23 years of experience as a patent litigator and has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal

Circuit. *Id.* ¶ 2. In addition, Mr. Zimmerman has experience in *inter partes* review proceedings, for example, IPR2013-00024, IPR2013-00128, IPR2013-00266, IPR2013-00517, IPR2013-00518, IPR2014-00549, IPR2014-00550, IPR2014-01093, IPR2015-00265, IPR2015-00268, IPR2016-00397, IPR2016-00399, IPR2016-00549, IPR2016-00553, IPR2016-00557, IPR2016-00559, IPR2016-01198, IPR2016-01201, IPR2017-02172, IPR2017-02174, IPR2018-00291, IPR2018-00318, IPR2018-00322, IPR2018-00385, IPR2018-00795, IPR2018-00797, IPR2018-01317, IPR2019-01201, IPR2020-000988, IPR2020-01065, IPR2020-01125, IPR2020-01177, and IPR2020-01323. *Id.* ¶ 2.

4. Further, Mr. Zimmerman holds a Bachelor of Science degree in Chemical Engineering from the University of Notre Dame and served as a law clerk to the Honorable Alvin A. Schall, Circuit Judge of the United States Court of Appeals for the Federal Circuit. *Id.* ¶ 3. Moreover, Mr. Zimmerman is experienced with technically and legally complex matters in the field of chemistry and biotechnology. *Id.*

5. With regard to U.S. Patent 10,258,265 (“the ’265 patent”), the patent at issue in this proceeding, Mr. Zimmerman is familiar with the ’265 patent, and with the legal subject matter, technical subject matter, and cited art discussed in the petition for *inter partes* review of the ’265 patent and Apple’s petition for *inter partes* review. *Id.* ¶ 4. In view of his legal experience, technical background, and

familiarity with the issues in the present matter, Patent Owner Masimo has requested his services in the present matter. Denial of his appearance in this case would create an undue burden on Patent Owner. *Id.*

6. Mr. Zimmerman has read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in Part 42 of Title 37 of the Code of Federal Regulations. *Id.* ¶ 9. Mr. Zimmerman also agrees to be subject to the United States Patent and Trademark Office Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*, and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* ¶ 10.

7. Finally, Mr. Zimmerman has attested to the remaining elements of Paragraph 2(b) of the representative “Order – Authorizing Motion for *Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7. *Id.* ¶¶ 2-11; *see* Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 3) at 2.

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