

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MASIMO CORPORATION,  
Patent Owner.

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Case IPR2020-01520  
Patent 10,258,265

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**PETITIONER'S MOTION TO FILE SUPPLEMENTAL INFORMATION  
PURSUANT TO 37 C.F.R. § 42.123**

## I. INTRODUCTION

Pursuant to 37 C.F.R § 42.123(a), and under the authorization granted by the Board on April 6, 2021, Petitioner hereby moves to submit Exhibit 1038 (“Declaration of Jacob Munford”) as supplemental information.

Petitioner requested authorization to file this motion on April 2, 2021, within one month of the March 2, 2021 date of institution for IPR2020-01520. As explained in more detail below, Exhibit 1038 provides further testimony supporting the public accessibility and authenticity of prior art references relied upon in the challenges set forth in the IPR2020-01520 Petition. For at least that reason, Exhibit 1038 is relevant to a claim for which trial has been instituted. Accordingly, both requirements of 37 C.F.R § 42.123(a) have been met.

Further, counsel for Petitioner and Patent Owner conferred prior to Petitioner’s request for authorization to submit this motion, and Patent Owner does not oppose this motion. Petitioner now so moves.

## II. BACKGROUND

On August 31, 2020, Petitioner filed a Petition for *inter partes* review of claims 1–4, 6-14, and 16-30 of U.S. Pat. No. 10,258,265 (“the ’265 patent”), which was assigned case number IPR2020-01520. On March 2, 2021, the Board instituted a trial on all challenged claims of the ’265 patent, determining that

Petitioner had demonstrated a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one of the challenged claims.

On March 16, 2021, pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner served Petitioner with objections to evidence, which included assertions that various prior art references that had been relied upon in the Petition had not been established as prior art, in addition to objections to the previously-submitted declaration of librarian Jacob Robert Munford (Exhibit 1026). On March 30, 2021, pursuant to 37 C.F.R. § 42.64(b)(2), and in response to Patent Owner's objections, Petitioner served Patent Owner with supplemental evidence including an additional "Declaration of Jacob Munford" (Exhibit 1038).

Exhibit 1038 provides further testimony supporting the public accessibility and authenticity of the prior art references relied upon in the challenges set forth in the IPR2020-01520 Petition, with supporting appendices.

On April 2, 2021, Petitioner requested authorization from the Board to file a motion to submit a declaration of Jacob Robert Munford as supplemental information in each of IPR2020-01520, -01536, -01537, -01538, and -01539. On April 6, 2021, the Board authorized Petitioner to file a motion to submit supplemental information in each of the indicated proceedings. In accordance with the Board's authorization, Petitioner hereby moves to submit Exhibit 1038 as supplemental information in IPR2020-01520.

### III. ARGUMENTS

Under 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information in accordance with the following two requirements: (1) “A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted”; and (2) “The supplemental information must be relevant to a claim for which the trial has been instituted.”

The instant Motion meets both of these requirements. First, Petitioner requested authorization to file this motion on April 2, 2021, within one month of the March 2, 2021 date of institution for IPR2020-01520. Second, Exhibit 1038 provides further testimony supporting the public accessibility and authenticity of prior art references relied upon in the challenges set forth in the IPR2020-01520 Petition and, for at least that reason, Exhibit 1038 is relevant to a claim for which trial has been instituted. *See, e.g., Valeo v. Magna Elecs.*, IPR2014-01204 Pap. 26 at 5 (PTAB Apr. 10, 2015); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369 Pap. 37 at 3 (PTAB Feb. 5, 2014)(“[e]vidence that allegedly confirms the public accessibility of references that serve as the basis of the grounds of unpatentability authorized...is relevant to the claims of the...patent for which this trial was instituted”); *Motorola Solutions, Inc. v. Mobile Scanning Tech.*, IPR 2013-00093 Pap. 37 at 2-3 (PTAB Jun. 28, 2013).

Moreover, Like the supplemental information admitted in *Valeo, Palo Alto Networks*, and *Motorola Solutions, Inc.*, Exhibit 1038 does not change the grounds of unpatentability authorized in the proceeding, and instead merely confirms the public accessibility and authenticity of prior art references originally provided with the Petition. Further, because Patent Owner has been in possession of the supplemental information in the form of supplemental evidence since March 30, 2021, which is approximately two months prior to the May 28, 2021 due date of the Patent Owner's response, the Patent Owner has reasonable time to review Exhibit 1038 and is not prejudiced or otherwise burdened by entry of this supplemental evidence into the record as supplemental information. Similarly, the entry of Exhibit 1038 now, as supplemental information, would not limit the Board's ability to complete this proceeding in a timely fashion.

Accordingly, Petitioner respectfully submits that Exhibit 1038 should be submitted into evidence as supplemental information, and requests the same.

#### **IV. CONCLUSION**

Petitioner respectfully requests that the Board grant this motion to submit Exhibit 1038 as supplemental information in IPR2020-01520.

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