
From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, November 10, 2021 10:10 AM
To: Jacob.Peterson; Trials
Cc: Andrew Patrick; IPR50095-0006IP1@fr.com; IPR50095-0012IP1; IPR50095-0012IP2; IPR50095-0013IP1; IPR50095-0013IP2; PTAB Inbound; AXF-PTAB; Karl Renner; Roberto Devoto; Dan Smith; Hyun Jin In; Grace Kim; Usman Khan; AppleIPR2020-1520-265; AppleIPR2020-1536-553; AppleIPR2020-1537-553; AppleIPR2020-1538-554; AppleIPR2020-1539-554
Subject: RE: IPR2020-01520, -01536, -01537, -01538, and -01539: Request re Motions for Observations

[This email originated outside of F&R.]

Counsel: The Board has reviewed Petitioner's e-mail request for authorization to file a motion for observations, or alternatively a chart identifying cross-examination testimony that provides context, as well as Patent Owner's e-mail opposition, and the authorities cited by both parties. No conference call is necessary to discuss these issues.

Petitioner is authorized to file a Paper in each proceeding identifying Dr. Kenny's cross-examination testimony that provides the context Petitioner desires the Board to consider, in a concise fashion without argument that focuses on key portions of the testimony rather than every point of disagreement. Thus, the identifications should be a listing taking the form of: "In response to Patent Owner's citation to the transcript at ___, Petitioner cites the transcript at ___ for context." The entire listing in each proceeding may not exceed one page in length, and must comply with the Board's general format requirements of 37 C.F.R. 42.6(a). The Papers must be filed no later than November 22, 2021, to afford Patent Owner an adequate opportunity to address the Papers during oral argument on December 7, 2021. Each Paper shall be accompanied by a copy of this e-mail authorization, filed as an Exhibit in the proceeding record.

Thank you,

Maria King
Deputy Chief Clerk for Trials
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
703-756-1288

From: Jacob.Peterson <Jacob.Peterson@knobbe.com>
Sent: Monday, November 8, 2021 10:08 PM
To: Trials <Trials@USPTO.GOV>
Cc: Andrew Patrick <patrick@fr.com>; IPR50095-0006IP1@fr.com; IPR50095-0012IP1@fr.com; IPR50095-0012IP2@fr.com; IPR50095-0013IP1@fr.com; IPR50095-0013IP2@fr.com; PTABInbound@fr.com; axf-ptab@fr.com; Karl Renner <renner@fr.com>; Roberto Devoto <devoto@fr.com>; Dan Smith <dsmith@fr.com>; Hyun Jin In <in@fr.com>; Grace Kim <gkim@fr.com>; Usman Khan <khan@fr.com>; AppleIPR2020-1520-265 <AppleIPR2020-1520-265@knobbe.com>; AppleIPR2020-1536-553 <AppleIPR2020-1536-553@knobbe.com>; AppleIPR2020-1537-553 <AppleIPR2020-1537-553@knobbe.com>; AppleIPR2020-1538-554 <AppleIPR2020-1538-554@knobbe.com>;

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Subject: RE: IPR2020-01520, -01536, -01537, -01538, and -01539: Request re Motions for Observations

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Your Honors,

As Counsel for Petitioner Apple mentioned below, Patent Owner Masimo opposes Apple's requests to file a motion for observations or a chart identifying portions of Dr. Kenny's testimony. Masimo objects to Apple's citation to discontinued Board practice and asks the Board to disregard Apple's citations or, in the alternative, consider Masimo's citations. See, e.g., 2019 Consolidated Trial Practice Guide at 1, 74 (discontinuing motions for observations); *Schott Gemtron Corp. v. SSW Holding Co., Inc.*, IPR2013-00358, Paper 77 at 3 (PTAB 2014) (declining request to file a party's observations on its own witness); see also *Biodelivery Sciences Int'l, Inc. v. Monosol RX, LLC*, IPR2015-00165, Paper 41 at 3-4 (PTAB 2015) (declining to apply *Zhongshan*); *Seagate Technology Holdings, Inc. v. Enova Tech. Corp.*, IPR2014-01178, Paper 45 at 2-7 (PTAB 2015) (same). *Compare Zhongshan Broad Ocean Motor Co., Ltd. et al. v. Nidec Motor Corp.*, IPR2014-01121, Paper 34 at 2 (PTAB 2015) (granting request where full transcripts of the deponents were unavailable to the Board); *Micron Tech., Inc. v. Innovative Memory Sys., Inc.*, IPR2016-00330, Paper 40 at 2-3 (PTAB 2017) (motion was unopposed). Masimo further notes that Apple previously opposed a similar request to the Board, and the Board sided with Apple by not authorizing any additional briefing. See *Apple, Inc. v. Farstone Tech., Inc.*, IPR2015-00599, Paper 17 at 2-3 (PTAB 2016).

Counsel for Petitioner Apple is cc'd on this email.

Respectfully submitted,

Jacob

Counsel for Patent Owner Masimo

Jacob Peterson

Partner

206-405-2007 Direct

Knobbe Martens

From: Andrew Patrick <patrick@fr.com>

Sent: Monday, November 8, 2021 1:49 PM

To: Trials <Trials@USPTO.GOV>

Cc: Stephen.Larson <Stephen.Larson@knobbe.com>; Jacob.Peterson <Jacob.Peterson@knobbe.com>; AppleIPR2020-1520-265 <AppleIPR2020-1520-265@knobbe.com>; AppleIPR2020-1536-553 <AppleIPR2020-1536-553@knobbe.com>; AppleIPR2020-1537-553 <AppleIPR2020-1537-553@knobbe.com>; AppleIPR2020-1538-554 <AppleIPR2020-1538-554@knobbe.com>; AppleIPR2020-1539-554 <AppleIPR2020-1539-554@knobbe.com>; Karl Renner <renner@fr.com>; Roberto Devoto <devoto@fr.com>; Dan Smith <dsmith@fr.com>; Hyun Jin In <in@fr.com>; Grace Kim <gkim@fr.com>; Usman Khan <khan@fr.com>

Subject: IPR2020-01520, -01536, -01537, -01538, and -01539: Request re Motions for Observations

Your Honors,

Patent Owner Masimo's sur-replies in each of the IPR2020-01520, -01536, -01537, -01538, and -01539 proceedings cite to excerpts of Dr. Thomas Kenny's September 18, 2021 cross-examination testimony; Petitioner Apple believes that identification of uncited testimony that provides context for the relied-upon excerpts would be helpful in advance of oral hearing.

Accordingly, pursuant to 77 Fed. Reg. 48,756, 48,767-68 (Aug. 14, 2012), Apple requests authorization to file a motion for observations regarding Dr. Kenny's cross-examination testimony in each of the above-captioned proceedings.

Alternatively, Apple requests authorization to file, as an exhibit in each of the above-captioned proceedings, a chart that identifies cross-examination testimony that provides context for excerpts of testimony relied upon by Masimo. *See, e.g., Zhongshan Broad Ocean Motor Co., Ltd. et al. v. NIDEC Motor Corp.*, IPR2014-01122 Pap. 34 (PTAB Sept. 10, 2015); *Micron Technology, Inc. v. Innovative Memory Systems, Inc.*, IPR2016-00330 Pap. 33 (March 8, 2017).

Counsel for Apple and counsel for Masimo have met and conferred regarding these requests. Masimo opposes Apple's requests.

Should the Board desire a call to discuss Apple's requests, the parties are jointly available this Wednesday (11/10) and Friday (11/12) from 12:00 – 5:00 pm Eastern.

Respectfully submitted,

Andrew Patrick
Counsel for Petitioner Apple

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