

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

MASIMO CORPORATION,

Patent Owner.

IPR2020-01520 (Patent 10,258,265 B1)

IPR2020-01536 (Patent 10,588,553 B2)

IPR2020-01537 (Patent 10,588,553 B2)

IPR2020-01538 (Patent 10,588,554 B2)

IPR2020-01539 (Patent 10,588,554 B2)

Before GEORGE R. HOSKINS, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER
Setting Oral Argument
37 C.F.R. § 42.70

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ORAL ARGUMENT

Time and Format

Pursuant to Petitioner’s and Patent Owner’s requests (IPR2020-01520, “1520 IPR,” Papers 29 and 30),¹ oral arguments will commence at **11:00 am Eastern Time on December 7, 2021, by videoconference.**² USPTO facilities remain closed to the public due to the state of affairs relating to COVID-19. The Board will provide a court reporter for the hearing, and the reporter’s transcript will constitute the official record of the hearing.

Each of Petitioner’s requests seek “no more than one hour per side [for] oral argument time.” 1520 IPR, Paper 29. It is not clear whether Petitioner wants one hour per proceeding, therefore totaling five hours, or one hour to address all five proceedings together. *See id.* Patent Owner’s requests expressly seek a consolidated oral argument, with each party allotted 60 minutes to address all five proceedings together, due to “the extensive overlap in” the proceedings. 1520 IPR, Paper 30.

Upon considering these requests, we grant Petitioner a total of seventy-five (75) minutes to present argument addressing all five proceedings together, and we grant Patent Owner a total of seventy-five (75)

¹ The requests in the 1520 IPR proceeding are representative of requests filed in all five of these related proceedings. We cite only the 1520 IPR proceeding requests for convenience.

² If there are any concerns about disclosing confidential information, the parties must contact the Board at Trials@uspto.gov at least ten (10) business days before the hearing date.

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minutes to respond. Petitioner will open the hearing by presenting its case for unpatentability of the three challenged patents. Thereafter, Patent Owner will respond to Petitioner's argument. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner. In accordance with the Consolidated Trial Practice Guide³ ("CTPG"), issued in November 2019, Patent Owner may request to reserve time for a brief sur-rebuttal. *See* CTPG 83. Given the overlap in these proceedings, the panel expects that statements made during the hearing are applicable to all captioned proceedings, unless it is explicitly noted that a statement applies to a specific proceeding only.

The parties may request a pre-hearing conference in advance of the hearing. *See id.* at 82. "The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties." *Id.* If either party desires a pre-hearing conference, the parties should jointly contact the Board at Trials@uspto.gov at least seven (7) business days before the hearing date to request a conference call for that purpose.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstratives shall be served on opposing counsel at least seven (7) business days before the hearing date and filed on or before Friday, December 3, 2021.⁴

Demonstratives are not a mechanism for making new arguments. Demonstratives are also not evidence, and will not be relied upon as evidence. Rather, demonstratives are visual aids to a party's oral presentation regarding arguments and evidence previously presented and discussed in the papers. Accordingly, demonstratives shall be clearly marked with the words "DEMONSTRATIVE EXHIBIT – NOT EVIDENCE" in the footer. *See Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (holding that the Board is obligated under its own regulations to dismiss untimely argument "raised for the first time during oral argument"). "[N]o new evidence may be presented at the oral argument." CTPG 85–86; *see also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that "new" evidence includes evidence already of record but not previously discussed in any paper of record).

Furthermore, because of the strict prohibition against the presentation of new evidence or arguments at a hearing, it is strongly recommended that each demonstrative includes a citation to a paper in the record, which allows

⁴ The parties may stipulate to an alternative schedule for serving and filing demonstratives, and request the Board to modify the schedule for filing demonstratives, at least seven (7) business days before the hearing date.

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the Board to easily ascertain whether a given demonstrative contains “new” argument or evidence or, instead, contains only that which is developed in the existing record.

Due to the nature of the Board’s consideration of demonstratives and the opportunity afforded for the parties to reach an agreement without involving the Board, the Board does not anticipate that objections to demonstratives are likely to be sustained. Nevertheless, to the extent that a party objects to the propriety of any demonstrative, the parties shall meet and confer in good faith to resolve any objections to demonstratives prior to filing the objections with the Board. If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board no later than the time of the hearing. The objections shall identify with particularity which portions of the demonstratives are subject to objection and include a one (1) sentence statement of the reason for each objection. No argument or further explanation is permitted. The Board will consider any objections, and may reserve ruling on the objections.⁵ Any objection to demonstratives that is not timely presented will be considered waived.

Finally, the parties are reminded that each presenter should identify clearly and specifically each paper (e.g., by slide or screen number for a demonstrative) referenced during the hearing to ensure the clarity and

⁵ If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

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