

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2021-00208
Patent 10,258,266

**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 July 7, 2021, Petitioner hereby moves to submit Exhibit 1040 (“Declaration of Jacob Munford”) and Exhibit 1041 (“Declaration of Gordon MacPherson: Mendelson-2003”) as supplemental information.

Petitioner requested authorization to file this motion on July 2, 2021, within one month of the June 3, 2021 date of institution for IPR2021-00208. As explained in more detail below, Exhibits 1040 and 1041 provide further testimony supporting the public accessibility and authenticity of prior art references relied upon in the challenges set forth in the IPR2021-00208 Petition. For at least that reason, Exhibits 1040 and 1041 are 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 November 20, 2020, Petitioner filed a Petition for *inter partes* review of claims 1-6, 8-16, 18, and 19 of U.S. Pat. No. 10,258,266 (“the ’266 patent”), which was assigned case number IPR2021-00208. On May June 3, 2021, the Board instituted trial on all challenged claims of the ’266 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 June 17, 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 June 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: (1) an additional declaration from Mr. Munford ("Declaration of Jacob Munford"; Exhibit 1040); and (2) a declaration from IEEE's Director of Board Governance & IP Operations, Gordon MacPherson, regarding Mendelson-2003 ("Declaration of Gordon MacPherson: Mendelson-2003"; Exhibit 1041).

Exhibit 1040 provides further testimony supporting the public accessibility and authenticity of the prior art references relied upon in the challenges set forth in the IPR2021-00208 Petition, with supporting appendices.

Exhibit 1041 provides further testimony supporting the public accessibility and authenticity of Mendelson-2003 (Exhibit 1024), which was relied upon in the challenges set forth in the IPR2021-00208 Petition.

On July 2, 2021, Petitioner requested authorization from the Board to file a motion to submit the declarations of Jacob Robert Munford and Gordon MacPherson as supplemental information in each of IPR2021-00193, IPR2021-00195, IPR2021-00208, and IPR2021-00209. On July 7, 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 Exhibits 1040 and 1041 as supplemental information in IPR2021-00208.

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 July 2, 2021, within one month of the June 3, 2021 date of institution for IPR2021-00208. Second, Exhibits 1040 and 1041 provide further testimony supporting the public accessibility and authenticity

of prior art references relied upon in the challenges set forth in the IPR2021-00208 Petition and, for at least that reason, Exhibits 1040 and 1041 are 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.*, Exhibits 1040 and 1041 do not change the grounds of unpatentability authorized in the proceeding, and instead merely confirm 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 June 30, 2021, which is nearly two months prior to the August 27, 2021 due date of the Patent Owner’s response, the Patent Owner has reasonable time to review Exhibits 1040 and 1041 and is not prejudiced or otherwise burdened by entry of this supplemental evidence into the record as supplemental information. Similarly, the

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