

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2021-00193 (Patent 10,299,708 B1)
IPR2021-00195 (Patent 10,376,190 B1)
IPR2021-00208 (Patent 10,258,266 B1)
IPR2021-00209 (Patent 10,376,191 B1)

Before JOSIAH C. COCKS, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

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

IPR2021-00193 (Patent 10,299,708 B1)
IPR2021-00195 (Patent 10,376,190 B1)
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ORAL ARGUMENT

Time and Format

The Board has considered Petitioner's and Patent Owner's requests for oral argument in these proceedings.¹ Taking into consideration these requests, the oral arguments will commence at **1:00 pm Eastern Time on March 15, 2022, 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.

Petitioner requests, for each proceeding captioned above, "no more than one hour per side for oral argument time, i.e., four hours of total argument time per side across all four cases. *See, e.g.*, IPR2021-00195, Paper 24. Patent Owner requests a consolidated argument for IPR193, IPR195, IPR208, and IPR209, due to overlap across the four proceedings, with one hour per side of total oral argument time for all four cases. *See, e.g.*, IPR2021-00195, Paper 25.

Upon considering these requests, we grant oral argument according to the following procedure. The four captioned proceedings will be argued together and will share a single transcript. Given the overlap in these proceedings, statements made during the hearing are applicable to each of

¹ *See* IPR2021-00193 ("IPR193") (Papers 22, 23); IPR2021-00195 ("IPR193") (Papers 24, 25); IPR2021-00208 ("IPR208") (Papers 24, 25); IPR2021-00209 ("IPR209") (Papers 24, 25).

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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the four proceedings, unless it is explicitly noted that a statement applies to a specific proceeding only. Each party will have a total of ninety (90) minutes to present argument in these proceedings

Petitioner will open by presenting its case for unpatentability of the 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.

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. If no response is received within two (2) days from the Board, the party requesting the conference should call the Board directly to ensure the request is being processed.

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

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IPR2021-00209 (Patent 10,376,191 B1)

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, March 11, 2022.⁴

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 the Board to easily ascertain whether a given demonstrative contains "new"

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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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 accuracy of the court reporter's transcript and for the benefit of all participants appearing electronically.

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

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