

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2022-01291 (Patent 10,687,745 B1)
IPR2022-01465 (Patent 10,687,745 B1)¹

Before JOSIAH C. COCKS, GEORGE R. HOSKINS, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This order is being filed in each proceeding listed in the caption, due to the common issues addressed. The parties are not authorized to use a combined caption in these proceedings.

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On August 28, 2023, Patent Owner sent an e-mail communication to the Board concerning these two proceedings. A copy of the e-mail has been entered into the record of each proceeding as Exhibit 3002. Via the e-mail, Patent Owner requested authorization to file two motions in each proceeding: (1) a Motion to Strike portions of the Petitioner Reply, and evidence submitted with the Reply; and (2) a Motion to Submit New Evidence with Patent Owner’s Sur-reply. *See, e.g.*, 37 C.F.R. § 42.20(b) (“A motion will not be entered without Board authorization,” which may be “provided in an order of general applicability or during the proceeding.”); PTAB Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”)², 37–38.

On September 1, 2023, the Board held a telephone conference with counsel for both parties to discuss Patent Owner’s e-mail requests. Patent Owner’s counsel had arranged for a court reporter to transcribe the phone call. Accordingly, we instructed Patent Owner to file the resulting transcript as an Exhibit in each proceeding. That transcript, once filed, will constitute the official record of the telephone conference.

In this Order, we discuss the results of the telephone conference as to each of Patent Owner’s requests (1) and (2).

(1) REQUESTED MOTION TO STRIKE

We *denied* Patent Owner’s request for authorization to file a Motion to Strike portions of the Petitioner Reply, and evidence submitted with the Reply. Based on our review of the Reply and the evidence submitted with the Reply, and our consideration of the arguments presented during the telephone conference, we concluded that Patent Owner’s already-authorized

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>

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Sur-reply is a sufficient procedural vehicle for Patent Owner to press the issues underlying the requested Motion to Strike.

(2) REQUESTED MOTION TO SUBMIT NEW EVIDENCE WITH
PATENT OWNER SUR-REPLY

We also *denied* Patent Owner's request for authorization to file a Motion to Submit New Evidence with the Patent Owner Sur-reply.

However, we authorized Patent Owner to file a new expert witness declaration with the Sur-reply. As a default rule, a Sur-reply "may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b); *see* CTPG 73–74. However, we have authority to waive or suspend that limitation in specific cases and to place conditions on the waiver or suspension. *See, e.g.*, 37 C.F.R. § 42.5(b). We do so in this case, for the following reasons.

The parties hotly dispute whether a person of ordinary skill in the art would have been motivated to measure oxygen saturation at the subject's wrist (as opposed to the subject's finger or forehead), with a reasonable expectation of success, based on the state of the art at the effective filing date of the '745 patent. These are issues where expert testimony is critical to reaching a correct conclusion.

Petitioner submitted a substantial amount of evidence with each Reply to address these issues. Specifically, each Reply included Exhibit 1042 (the same document in both cases), a new Supplemental Declaration from Petitioner's proffered expert witness adding over 90 pages of expert testimony to the proceedings. Each Reply also included new Exhibits 1043–1058 and 1060–1080 (the same documents in both cases), to support various arguments concerning the state of the art prior to the '745 patent.

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We concluded that resolution of the motivation to combine and reasonable expectation of success disputes presented in these particular cases would benefit from further expert testimony on behalf of Patent Owner, to address the substantial amount of testimonial and documentary evidence added via the Petitioner Reply. To be clear, however, we did not place any restrictions on the scope of the new expert testimony, apart from the Board's default restriction that a "sur-reply may only respond to arguments raised in the corresponding reply." 37 C.F.R. § 42.23(b).

During the telephone conference, we did not authorize Patent Owner to submit new documentary evidence with the Sur-reply. When asked whether Patent Owner had any specific documents in mind for filing with the Sur-reply, counsel said no, and argued principally for leave to file a new expert declaration which we have granted as set forth above.

(3) BRIEFING AND CASE SCHEDULE CONSIDERATIONS

During the telephone conference, Patent Owner's counsel stated Patent Owner should be able to comply with the existing October 2, 2023 deadline for filing the Patent Owner Sur-reply, along with the new expert witness declaration we have authorized. *See* Paper 26 (Stipulation regarding Due Dates).

We instructed the parties to contact the Board to schedule a telephone conference to occur on or before September 27, 2023, to discuss a potential increase of the Board's default 5,600 word count limitation for Sur-replies. *See* 37 C.F.R. § 42.24(a)(2) (stating that waiver of word count limitation must be granted in advance of the filing of a sur-reply), § 42.24(c)(4) (providing default word count limitation for Patent Owner Sur-reply).

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Upon further consideration of the telephone conference, the Board hereby authorizes Petitioner to cross-examine Patent Owner's witness via deposition, regarding testimony proffered with the Patent Owner Sur-reply. Petitioner also is authorized to file a Response to Expert Testimony, not to exceed 10 pages, to address the testimony proffered with the Patent Owner Sur-reply. Petitioner will not be authorized to provide further expert witness testimony with the Response to Expert Testimony. The parties should be prepared to discuss, during the late September telephone conference discussed above: (i) dates when the deposition might take place; (ii) a filing deadline for the Response to Expert Testimony; and (iii) whether oral argument in these two cases might be delayed by a few weeks to accommodate the deposition date and the filing deadline.³

During the September 1, 2023, telephone conference, we tentatively set another telephone conference for Monday, October 9, 2023. In light of the foregoing, the October 9 telephone conference is canceled.

(4) ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's e-mail request for authorization to file a Motion to Strike in these proceedings is *denied*;

FURTHER ORDERED that Patent Owner's e-mail request for authorization to file a Motion to Submit New Evidence in these proceedings is *denied*;

FURTHER ORDERED that Patent Owner is authorized to file a new expert witness declaration with its Sur-reply in each proceeding;

³ At this time, we do not discern a need to delay oral argument in IPR2022-01299, even if oral argument in these two proceedings is delayed.

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