

Filed: September 22, 2023

Filed on behalf of:

Patent Owner Masimo Corporation
By: Brian C. Claassen (Reg. No. 63,051)
Carol Pitzel Cruz (Reg. No. 61,224)
Daniel C. Kiang (Reg. No. 79,631)
Jeremiah S. Helm, Ph.D. (admitted *pro hac vice*)

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: AppleIPR745-1@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2022-01291
U.S. Patent 10,687,745

PATENT OWNER REQUEST FOR ORAL ARGUMENT

IPR2022-01291

Apple Inc. v. Masimo Corporation

Pursuant to 37 C.F.R. § 42.70(a) and the Scheduling Order (Paper 16), Patent Owner Masimo Corporation respectfully requests that the Board hear oral argument in person on the instituted grounds in IPR2022-01291 regarding U.S. Patent No. 10,687,745 (“’745 Patent”). The Board has currently scheduled oral argument for November 1, 2023. (Paper 16).

The Board has also scheduled oral argument in IPR2022-01465 for November 1, 2023. *See* IPR2022-01465, Paper 16. IPR2022-01465 involves additional claims of the ’745 Patent and substantially the same obviousness grounds. Due to the overlap in issues between the two IPRs, Patent Owner respectfully requests that the oral argument for IPR2022-01291 and IPR2022-01465 be consolidated into one oral argument. Patent Owner requests that the Board allot each party sixty (60) minutes for a consolidated oral argument, or thirty (30) minutes if the arguments are not consolidated.

Patent Owner requests (without waiving consideration of any issue not listed below) to address the following issues with respect to IPR2022-01291:

- The proper construction of the challenged claims;
- Whether Claims 1 and 9 of the ’745 Patent would have been obvious over Iwamiya and Sarantos;
- Whether Claims 15, 18, 20, and 27 of the ’745 Patent would have been obvious over Iwamiya, Sarantos, and Venkatraman;

- Whether Claims 1, 9, 15, and 18 would have been obvious over Sarantos and Shie;
- Whether Claims 15, 18, 20, and 27 would have been obvious over Sarantos, Shie, and Venkatraman;
- Whether a POSITA would have had a reasonable expectation of success in combining the references asserted in the Petition to obtain the claimed inventions;
- Whether Petitioner's Reply improperly raises new arguments and new evidence that exceed the proper scope of reply;
- Whether Petitioner's Reply improperly exceeds the word limit for a Reply by incorporating by reference arguments from the supplemental expert declaration (EX1042);
- Any other issues in papers yet to be filed, such as Motions to Exclude and any Petitioner paper filed after Masimo's Sur-Reply;
- Any rebuttal to Petitioner's presentation on any issue; and
- Any other issues the Board deems necessary for issuing a final written decision.

Patent Owner currently anticipates that four (4) individuals will attend the oral argument on its behalf. Patent Owner requests permission to use audio/visual

IPR2022-01291

Apple Inc. v. Masimo Corporation

equipment to display demonstrative exhibits, including the projector and screens in the hearing room to project PowerPoint slides or other electronic materials.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 22, 2023

/Daniel C. Kiang/

Daniel C. Kiang (Reg. No. 79,631)

Customer No. 64,735

Attorney for Patent Owner

Masimo Corporation

IPR2022-01291

Apple Inc. v. Masimo Corporation

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER REQUEST FOR ORAL ARGUMENT** is being served electronically on September 22, 2023, to the e-mail addresses shown below:

W. Karl Renner Fish & Richardson P.C. 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402 Tel: 612-335-5070 Fax: 612-288-9696 Email: IPR50095-0045IP1@fr.com	Nicholas Stephens Andrew B. Patrick Kim Leung Patrick J. Bisenius Patrick J. King 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 Email: PTABInbound@fr.com
--	--

Dated: September 22, 2023

/Daniel C. Kiang/

Daniel C. Kiang (Reg. No. 79,631)

Attorney for Patent Owner
Masimo Corporation