

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 and Trial Hearing
37 C.F.R. §§ 42.5 & 42.70

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.

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

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

On September 27, 2023, the Board held a telephone conference with counsel for both parties. 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.

This Order: (1) memorializes the result of the telephone conference as to the briefs and exhibits to be filed in these two cases, and related deadlines; and (2) sets forth various procedures for preparing for and conducting a combined oral argument in these two cases.

(1) BRIEFING AND CASE SCHEDULE AMENDMENTS

We granted Petitioner leave to file a Corrected Petition in IPR2022-01291, pursuant to Petitioner's prior email request (IPR2022-01291, Ex. 3003).

Patent Owner indicated the Board's default 5,600 word count limitation on patent owner sur-replies (*see* 37 C.F.R. § 42.24(c)(4)) will suffice in this case, so Patent Owner does not seek an increase in that limitation. Petitioner similarly indicated the 10 page limitation imposed by our previous Order (Paper 43) on the Response to Expert Testimony will likely be sufficient, but reserved the right to seek an increase after Petitioner has had a chance to review the Patent Owner Sur-reply once it is filed.

Further, per the parties' joint proposal, the case schedule for these two cases is amended as set forth in the following table. The identified "DUE DATES" are explained more fully in Paper 16.

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

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

Item	Current Date	New Date
DUE DATE 3 -- Patent Owner Sur-reply -- Decl. of Dr. James Duckworth	Mon. Oct. 2	Mon. Oct. 2
Deposition of Dr. Duckworth by Petitioner	n/a	Wed. Oct. 18
Response to Expert Testimony by Petitioner	n/a	Fri. Oct. 27
DUE DATE 5 -- Motion(s) to Exclude	Fri. Oct. 13	Mon. Oct. 30
DUE DATE 6 -- Opp. to Motion(s) to Exclude	Fri. Oct. 20	Mon. Nov. 6
DUE DATE 7 -- Reply re Motion(s) to Exclude	Fri. Oct. 27	Mon. Nov. 13
Parties Exchange Demon. Exs. for Hearing	n/a	Mon. Nov. 13
Parties File Demon. Exs. for Hearing	n/a	Wed. Nov. 15
DUE DATE 8 -- Oral Argument	Wed. Nov. 1	Fri. Nov. 17

(2) ORAL ARGUMENT

A. Time and Format

Oral arguments will commence in these two proceedings, in a consolidated fashion as requested by both parties, beginning at **1:00 PM EASTERN TIME on November 17, 2023**. Petitioner requested that the

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

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

hearing be conducted virtually by videoconference (*see* IPR2022-01291, Paper 46, 1), whereas Patent Owner requested that the hearing be conducted in person (*see* IPR2022-01291, Paper 47, 1). Upon consideration, the Board will hold the hearing **by videoconference**. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

Petitioner requested that each party be given 75 minutes of argument time. *See* IPR2022-01291, Paper 46, 1. Patent Owner requested that each party be given 60 minutes of argument time. *See* IPR2022-01291, Paper 47, 1. Upon consideration of these requests, and the issues presented in these proceedings, we grant each party **75 minutes** of argument time to address the two proceedings together. As the party with the burden of proof and persuasion, Petitioner will proceed first to present its case with regard to the challenged claims and grounds set forth in the Petition. Patent Owner then may present its own case, and respond to Petitioner's argument. Petitioner and Patent Owner may reserve some, but no more than half, of the allotted time for rebuttal and sur-rebuttal, respectively. The parties are reminded that arguments made during rebuttal and sur-rebuttal periods must be responsive to arguments the opposing party made in its immediately preceding presentation. The parties are also reminded that during the hearing, the parties "may only present arguments relied upon in the papers previously submitted." PTAB Consolidated Trial Practice Guide (Nov. 2019) ("CTPG") 86.²

During the September 27 telephone conference, Petitioner indicated the parties may desire to discuss confidential information which we have

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

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

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

placed under seal, during the oral argument. Accordingly, the hearing will proceed in two phases. In a first phase that will be open to the public, each party will present its argument as to publicly available information, in the back-and-forth manner described in the previous paragraph of this Order. In a second phase that will be closed to any person not qualified to receive sealed information pursuant to the Board's Protective Order (*see* IPR2022-01291, Paper 24, Ex. 1035), in the same manner. The public line(s) will be terminated prior to the beginning of the second phase, to preserve confidentiality. Accordingly, at the beginning of the hearing, we will ask counsel for each party whether they wish to reserve some of their argument time for the second session. Any such reservation may be modified, either up or down, as the hearing progresses.

The parties may request a pre-hearing conference in advance of the hearing. *See* CTPG 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 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.

B. Demonstrative Exhibit(s)

Each party shall serve on the other party any demonstrative exhibit(s) it intends to use during the hearing on or before November 13, 2023. *See* 37 C.F.R. § 42.70(b). Each party shall file any demonstrative exhibits it intends to use during the hearing as an exhibit on or before November 15, 2023.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.