

From: [Trials](#)
To: [Nicholas Stephens](#)
Cc: [IPR50095-0046IP1](#); [Ted Cannon](#); [AppleIPR127-1](#); [Trials](#)
Subject: RE: IPR2022-01299 - Request for Clarification re Sealed Exhibits
Date: Thursday, February 9, 2023 12:22:02 PM

Counsel,

From the Board –

The parties are authorized to jointly file a copy of the agreement proposed in Petitioner’s February 8 email.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office
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From: Nicholas Stephens <nstephens@fr.com>
Sent: Wednesday, February 8, 2023 6:42 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR50095-0046IP1 <IPR50095-0046IP1@fr.com>; Ted Cannon <Ted.Cannon@knobbe.com>; AppleIPR127-1 <AppleIPR127-1@knobbe.com>
Subject: IPR2022-01299 - Request for Clarification re Sealed Exhibits

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Honorable Board,

Petitioner respectfully requests clarification as to the state of the record in the subject proceeding. The Board instituted trial on February 1, 2023, and pursuant to 37 CFR 42.64(b)(1), the parties are afforded ten business days from institution to file objections to evidence submitted during the pre-institution phase of the proceeding. Here, the deadline for filing objections to evidence submitted pre-institution would apparently fall on February 15, 2023.

Patent Owner filed a set of exhibits with its POPR under seal, which are said to contain confidential information, and which were made accessible only to the Patent Owner and the Board (“confidential exhibits”). Patent Owner also filed a Renewed Motion to Seal on November 22, 2022, and briefing on the Renewed Motion was completed in January. However, while the Renewed Motion is pending, Petitioner has not been served the sealed exhibits, nor has Petitioner been provided access to the sealed exhibits to assess whether they may have objectionable material in them.

In view of the present circumstances, Petitioner seeks clarification as to how Petitioner may fairly evaluate the sealed exhibits for objectionable material and file any objections in a timely manner.

The parties have conferred by email and Masimo offered the following proposal:

“With respect to the sealed exhibits, Masimo would agree (1) to waive the requirement to file objections to the sealed exhibits within 10 business days of institution and to allow Apple to file, within five business days of service of Masimo’s Patent Owner Response, objections to any sealed exhibits Masimo relies on in its POR and (2) that any sealed exhibits that Masimo does not rely on in its POR will be deemed to be withdrawn from the record.”

Apple believes Masimo’s proposal is reasonable and would agree to abide by the proposal if authorized by the Board. Alternatively, to the extent that entry of a protective order triggers a requirement for service of the confidential information upon Petitioner to gain entry of the same into the record, 37 CFR 42.64(b)(1) permits five business days for consideration and filing of objections by Petitioner.

To the extent the Board believes a call would be helpful, the parties will provide their availability.

Best Regards,
Nick

Counsel for Petitioner Apple Inc.

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