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Paper: 27
Date: February 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2022-01299 (US 7,761,127 B2)

Before JOSIAH C. COCKS, JAMES A. TARTAL, and ROBERT A. POLLOCK, *Administrative Patent Judges.*

POLLOCK, *Administrative Patent Judge*.

ORDER
Provisionally Granting Patent Owner's Renewed Motion to Seal and For Entry of a Modified Protective Order
37 C.F.R. §§ 42.5, 42.14, 42.54

I. INTRODUCTION

As authorized in Paper 13 and related communication (Exhibit 3001), Patent Owner ("Masimo") filed a Renewed Motion to Seal and For Entry of a [Modified] Protective Order (Paper 14, "Motion" or "Mot."). Petitioner ("Apple") opposed the motion (Paper 16, "Opposition" or (Opp."); Patent Owner submitted a Reply in support of its Motion (Paper 20).

II. Documents Subject to Motion to Seal

Patent Owner moves to seal the unredacted versions of its Preliminary Response (Paper 9) and Exhibits 2002, 2051, and 2082. Mot. 1. Petitioner further moves to seal the entirety of Exhibits 2003, 2004, 2006, 2007, 2009, 2010, 2012–2016, 2018–2021, 2027, 2028, 2031, 2032, 2033, 2057, 2058, and 2081. *Id.* As set forth in the Motion, the material sought to be sealed largely relates to Patent Owner's contentions of objective evidence of non-obviousness including its arguments of nexus between its commercial products and the challenged claims. *See id.* at 2–6. Petitioner does not oppose Patent Owner request to seal these documents, but does oppose our adoption of Patent Owner's proposed modified protective order. *See generally*, Opp.

Considering the argument and evidence of record, Patent Owner has shown good cause to seal the identified documents. We address, below, the terms under which the documents may be sealed.

III. Proposed Modified Protective Order ("PPO")

Under 37 C.F.R. § 42.54(a), "[a] party may file a motion to seal where the motion to seal contains a proposed protective order, such as the default protective order set forth in the Office Patent Trial Practice Guide." Under

Consolidated Trial Practice Guide (Nov. 2019) ("CTPG" or "Guidance")[1], no protective order shall apply to a proceeding until the Board enters one. CTPG, 91. "The Board encourages the parties to adopt the Board's default protective order." *Id.* However,

> [i]f the parties choose to propose a protective order deviating from the default protective order, they must submit the proposed protective order jointly along with a marked-up comparison of the proposed and default protective orders showing the differences between the two and explain why good cause exists to deviate from the default protective order.

Id. at 91.

Patent Owner requests entry of a PPO that modifies three aspects of the Board's Default Protective Order, specifically, altering the Default Protective Order's "Protective Order Material" section; the addition of a development bar; and the addition of a prosecution bar. *See* Mot. 1–2; Exs. 2086, 2087 (clean and redlined versions of proposed protective order). Patent Owner contends that the each of these modifications are similar to those of the protective order entered in the copending ITC Investigation (*Certain Light-Based Physiological Measurement Devices and Components Thereof*, Inv. No. 337-TA-1276 (ITC)), and that it merely "seeks a protective order here with the same level of protection that the parties already agreed to in the ITC Investigation." Mot. 2, 7–8. We address the three provisions in turn.

A. CBI Designation

As detailed on pages 6–9 of the Motion, Patent Owner's PPO generally replaces the Default Protective Order's "Protective Order

[1] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

Material" designation with a "Confidential Business Information" or "CBI" designation encompassing "confidential design, engineering, and financial information," and further limiting the persons authorized to access that information. *See* Mot. 7. Patent Owner contends that Petitioner did not object to the CBI provisions of its PPO, and we find that Apple's Opposition brief contains no particularized objections to any CBI provision. *See id.* at 8; *see generally*, Opp.

Considering the argument and evidence of record, Patent Owner shows good cause supporting the CBI provisions of its PPO. *See* Mot. 6–8.

B. Development Bar

Section 4 of the PPO, titled, "Prosecution and Development Bar," relates to CBI involving "Relevant Technology," i.e., "technology related to non-invasive monitoring of pulse oximetry, total hemoglobin, oxygen content, carboxyhemoglobin, and/or methemoglobin." *See* Ex. 2086, ¶ 4.A. Paragraph 4.C of that section limits an expert's use of this information "in creating, developing, or modifying, for commercial use . . . any Relevant Technology from the time of first receipt of such confidential material through one year after the date the expert formally withdraws from the Protective Order." *Id.* ¶ 4.C.

In its Motion, Patent Owner argues that "absent entry of the development bar, there is significant risk that [its] CBI would inadvertently inform [Patent Owner's] expert Anthony in developing commercial products for Masimo competitors . . . . because Anthony works with its competitors, including Apple and Philips" in related commercial fields. Mot. 11–12.

Considering the argument and evidence of record, and under the particular circumstances presented here, including the absence of any

argument or opposition from Petitioner directed specifically to the development bar,[2] Patent Owner shows good cause supporting the development bar as described in paragraph 4.C of the PPO. *See* Mot. 6–8.

C. Prosecution Bar

Paragraph 4.B of the PPO would subject individuals who receive CBI to a two-year prosecution bar. Ex. 2086 ¶ 2.B. As noted by Patent Owner, paragraph 4.B does not bar IPR and post-grant activities, "[e]xcept for amending claims." Mot. 9. Patent Owner argues that the use of a prosecution bar is a "well-accepted" means for "prevent[ing] the inadvertent use of a party's most confidential and detailed information to inform a competitor's patent prosecution strategy," and that the bar proposed here is, "similar to the one the parties agreed to in the ITC investigation." Mot 8–9 (citing *In re Deutsche Bank Tr. Co. Ams.*, 605 F.3d 1373, 1378 (Fed. Cir. 2010)).

The Board's Guidance, however, counsels against the wholesale adoption of protective orders from other fora, particularly with respect to provisions restricting practice before the Office. In particular, the CTPG states that we may enter a proposed protective order where "certain provisions commonly found in district court protective orders that are unnecessary or inappropriate in proceedings before the Board are removed." CTPG, 116. Addressing exemplary "unnecessary" provisions, our Guidance explains that "provisions protecting computer source code may be unnecessary because proceedings before the Board rarely, if ever, require

[2] Although Petitioner requests that we enter the Default Protective Order or "at a minimum strike" the Prosecution and Development Bar section of the PPO (Opp. 3, n.1), Petitioner's arguments do not otherwise implicate Section 4 as a whole or the development bar of paragraph 4.C, but are specific to the prosecution bar of paragraph 4.B. *See generally* Opp.

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