

From: [Trials](#)
To: [Daniel Kiang; Trials](#)
Cc: [IPR50095-0046IP1](#); [IPR50095-0045IP1](#); [IPR50095-0045IP3](#); [AppleIPR745-1](#); [AppleIPR745-3](#); [AppleIPR127-1](#)
Subject: RE: IPR2022-01291, -01465, -01299 | Preservation of record and extension of time to file motion to expunge confidential information
Date: Thursday, March 7, 2024 8:10:41 AM

Counsel,

From the Board –

As applied to each of IPR2022-01299, IPR2022-01291, and IPR2022-01465:

- (1) the record will be preserved with confidential information remaining under seal through the end of any appeals; and
- (2) the deadline to file a motion to expunge confidential information is extended to:
 - (a) if no Notice of Appeal to the Federal Circuit is filed, then 45 days after the deadline for filing such a Notice; or
 - (b) if a Notice of Appeal to the Federal Circuit is filed, then 45 days after the case is returned to the USPTO post-mandate.

The Board will add a copy of this e-mail communication to the record of each proceeding as an Exhibit.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Daniel Kiang <Daniel.Kiang@knobbe.com>
Sent: Wednesday, March 6, 2024 1:42 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR50095-0046IP1 <IPR50095-0046IP1@fr.com>; IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; IPR50095-0045IP3 <IPR50095-0045IP3@fr.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; AppleIPR745-3 <AppleIPR745-3@knobbe.com>; AppleIPR127-1 <AppleIPR127-1@knobbe.com>
Subject: RE: IPR2022-01291, -01465, -01299 | Preservation of record and extension of time to file motion to expunge confidential information

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Dear Board,

I write regarding clarification of the Board's February 15, 2024 email in IPR2022-01299 and the preservation of confidential information in IPR2022-01299, IPR2022-01291, and IPR2022-01465. The briefs and exhibits in these three IPRs contain Apple's and Masimo's confidential information. Confidential information that is subject to a protective order will ordinarily become public "45 days after final judgment in a trial" unless a motion to expunge is filed. Consolidated Trial Practice Guide (Nov. 2019) at 22. The deadline to file a notice of appeal after an IPR is 63 days after the date of the final Board decision. 37 C.F.R. § 90.3(a)(1). Masimo is currently evaluating its options regarding appeal.

In IPR2022-01299, the Board recently stated in an email that "confidential information will remain undisturbed pending any appeal, after which time, a party may file a motion to expunge the information from the record prior to the information becoming public." Could the Board please confirm our understanding of the Board's email to mean that in IPR2022-01299: (1) the record will be preserved with confidential information remaining under seal through the end of any appeals and (2) the deadline to file a motion to expunge confidential information will be extended until 45 days after all appeal rights have been exhausted and the case is returned to the USPTO post-mandate?

Assuming our understanding is correct, the parties have already conferred and would like to jointly request the same preservation of the record and extension to file a motion to expunge confidential information in IPR2022-01291 and IPR2022-01465. The parties do not believe that a formal motion is necessary, but if the Board desires, the parties are willing to file a joint motion requesting such relief. The parties can also provide their availability for a teleconference with the Board if requested.

Petitioner's counsel is copied on this email.

Best regards,
Daniel

Daniel Kiang

Partner

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From: Trials <Trials@USPTO.GOV>

Sent: Thursday, February 15, 2024 6:15 AM

To: Ted Cannon <Ted.Cannon@knobbe.com>; Trials <Trials@USPTO.GOV>; AXF-PTAB <AXF-PTAB@fr.com>

Cc: IPR50095-0046IP1 <IPR50095-0046IP1@fr.com>; AppleIPR127-1 <AppleIPR127-1@knobbe.com>; nstephens@fr.com; patrick@fr.com; dsmith@fr.com; pking@fr.com; 2ial@knobbe.com; 2Jzk@knobbe.com; 2Jup@knobbe.com; 2Jgh@knobbe.com

Subject: RE: IPR2022-01299 - Request for conference call. if necessary. regarding sealing of

documents

Counsel,

From the Board –

Public and Board and Parties Only versions of the oral hearing transcript have been entered as Papers 67 and 63, respectively. No formal motion to seal Paper 63 and Exhibit 1063 is required.

According to our Consolidated Trial Practice Guide (“CPTG”), “[c]onfidential information that is subject to a protective order ordinarily would become public 45 days after denial of a petition to institute a trial or 45 days after final judgment in a trial.” CPTG, 21–22. As such, confidential information will remain undisturbed pending any appeal, after which time, a party may file a motion to expunge the information from the record prior to the information becoming public. *Id.* at 22.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Ted Cannon <Ted.Cannon@knobbe.com>

Sent: Thursday, February 8, 2024 1:40 PM

To: Trials <Trials@USPTO.GOV>

Cc: IPR50095-0046IP1 <IPR50095-0046IP1@fr.com>; AppleIPR127-1 <AppleIPR127-1@knobbe.com>

Subject: IPR2022-01299 - Request for conference call, if necessary, regarding sealing of documents

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Dear Board:

I write to request a conference call, if necessary, to request the following: (1) that the portion of the oral hearing transcript for the closed session of the oral hearing (Paper 63 at 44-61) be sealed and immediately re-designated in P-TACTS as accessible to the Board and parties only and (2) that the confidential version of Apple’s demonstrative exhibits (Exhibit 1063) remain sealed and accessible to the Board and parties only. Further information about each request is provided below.

Oral Hearing Transcript. The oral hearing was divided into a non-confidential portion (*see* Paper 63 at 1-44) and a confidential portion (*see id.* at 44-61). The confidential portion refers to confidential exhibits that have been sealed. However, it appears the oral hearing transcript (Paper 63) was inadvertently issued as a single document accessible to the public. Masimo requests sealing of the confidential portion. If a formal motion to seal is required, Masimo

requests immediate re-designation of the confidential portion as accessible to the Board and parties only pending resolution of the motion.

Apple's Demonstrative Exhibits. Apple filed confidential and non-confidential versions of Exhibit 1063, Apple's demonstrative exhibits. The confidential version is currently accessible to the Board and parties only but was not expressly addressed in the granted motions to seal. Because the confidential version includes information contained in confidential exhibits that have been sealed, Masimo requests that the confidential version remain sealed.

Counsel for the parties have conferred and Apple does not oppose these requests. Should the Board desire a conference call, counsel for the parties are available between 1:00 pm and 5:00 pm ET on February 9, 12, or 13. If necessary, Masimo is willing to file a formal motion to seal.

Respectfully,

Ted Cannon
Counsel for Masimo

Ted M. Cannon

Partner

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