

From: [Ted Cannon](#)
To: [Trials](#)
Cc: [IPR50095-0046IP1](#); [AppleIPR127-1](#)
Subject: IPR2022-01299 - proposed procedures if Board authorizes sur-reply declaration
Date: Sunday, September 17, 2023 10:04:14 PM

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board:

Per the Board's request during the conference call on September 14, 2023, the parties have conferred regarding proposed procedures, scheduling, and page counts or word limits that should apply should the Board authorize Masimo to file an expert declaration with its sur-reply. The parties have not agreed on a joint proposal, and their separate proposals follow:

Masimo's position

Masimo proposes the following schedule and word limits:

Date	Paper/Event	Word Limit
10/11/2023	Sur-Reply	6,850 (5,600 + 1,250)
10/17/2023	Deposition of expert	N/A
10/23/2023	Observations on Cross-examination	1,250
10/25/2023	Service of oral hearing demonstratives	N/A
11/1/2023	Oral hearing	N/A

The intent of Masimo's proposal is to provide the parties equal opportunity to address, through briefing and expert testimony (in Apple's Reply and Masimo's Sur-Reply), the new references that Apple included in its Reply. Masimo agrees to make its expert available for cross examination and proposes that Apple be allowed to file observations on cross examination to highlight portions of the cross-examination testimony. Non-argumentative observations are more appropriate than an additional argumentative brief because Apple's Reply already addressed the new references.

Masimo proposes a 1,250-word limit for the observations on cross examination. This limit is proportionate to the about 400 words Apple devoted to the new references in its Reply. As a counterbalance to the proposed 1,250-word observations, Masimo proposes that it be given an additional 1,250 words for its Sur-Reply.

In view of the limited scope of the expert declaration it seeks, Masimo proposes a schedule

that would maintain the currently scheduled date for the oral hearing. However, Masimo would not oppose extending the proposed dates and rescheduling the oral hearing if the Board desires.

Apple's position

Apple opposes Masimo's request for a sur-reply declaration for the reasons expressed during the conference call on 9/14. To the extent the Board authorizes such a declaration, however, Apple respectfully requests that the Board adopt procedures similar to those recently authorized in IPR2022-01291 and IPR2022-01465. See IP2022-01291, Paper 43. Specifically, Apple would request authorization to cross-examine Masimo's sur-reply declarant and authorization to file the deposition transcript and a Response to Expert Testimony, not to exceed 10 pages.

Apple opposes Masimo's request for an increase in the word limit of the sur-reply. PTAB rules provide that replies and sur-replies should be of equal length (5,600 words), regardless of whether a declaration accompanies either paper. 37 CFR § 42.24(c). More, additional words are unnecessary here and should not be tied to any Response to Expert Testimony or Observations, should the Board authorize such a paper. Masimo's expert would already have an opportunity to address the disputed references without word count limitation in the declaration. Increasing the word limit in the sur-reply would also allow Masimo to expand its arguments on myriad other disputed issues that Apple did not have opportunity to address with additional words in its reply.

Should the Board authorize Apple to depose Masimo's sur-reply declarant and file a Response to Expert Testimony, Apple would work with haste to complete these procedures, but should still be afforded a reasonable amount of time to do so. Apple respectfully submits the deposition should be required to occur no sooner than two weeks after Masimo's sur-reply, Apple should have at least one week from the deposition to prepare and submit the Response to Expert Testimony, and the schedule should allow for at least 1-2 weeks from submission of the Response to Expert Testimony before the hearing to allow time for hearing preparation, demonstrative exchanges, evidentiary briefing, and the like. The schedule is already compressed with Masimo's sur-reply due just three weeks before the hearing, and as such, Apple respectfully submits that the hearing should be delayed if a sur-reply declaration and additional procedures related to the declaration are authorized.

The hearing in this case is currently scheduled to occur on the same day—November 1st—as the hearings in the -1291 and -1465 proceedings. The Board in the -1291 and -1465 proceedings has requested that the parties schedule a telephone conference in late September to discuss "(i) dates when the deposition might take place; (ii) a filing deadline for the Response to Expert Testimony; and (iii) whether oral argument in these two cases might

be delayed by a few weeks to accommodate the deposition date and the filing deadline.” Paper 43, p. 5. Should the Board authorize a sur-reply declaration, then given the similar issues that would arise in the present proceeding as the -1291 and -1465 proceedings, Apple proposes to address these issues for all three proceedings whose hearings are currently scheduled for November 1st (i.e., the -1291, -1299, and -1465 proceedings) during the teleconference anticipated to be scheduled later this month.

Respectfully,

Ted Cannon
Counsel for Masimo, with permission of counsel for Apple

Ted M. Cannon

Partner

Ted.Cannon@knobbe.com

949-721-2897 Direct

Knobbe Martens

2040 Main St., 14th Fl.

Irvine, CA 92614

www.knobbe.com/ted-cannon

NOTICE: This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized review, use, disclosure or distribution is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.