

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MASIMO CORPORATION,  
Patent Owner.

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IPR2022-01299  
PATENT 7,761,127 B2

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Before JOSIAH C. COCKS, GEORGE R. HOSKINS, and  
ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

On September 8, 2023, Patent Owner sent an e-mail to the Board requesting authorization to file (1) a motion to strike portions of the Petitioner Reply (Paper 45) and evidence submitted with the Reply specifically, Exhibits 1050–1054, and paragraphs 32–52 of Dr. Anthony’s Supplemental Declaration (Ex. 1055); and (2) a new expert witness declaration with its sur-reply responsive to those portions of the Petitioner Reply and evidence. Ex. 3004.

On September 14, 2023, the Board (Judges Cocks and Pollock) held a telephone conference with counsel for both parties to discuss Patent Owner’s requests. 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. Once filed, that transcript will constitute the official record of the telephone conference.

In this Order, we discuss the results of the telephone conference as to each of Patent Owner’s requests (1) and (2).

(1) REQUESTED MOTION TO STRIKE

We *denied* Patent Owner’s request for authorization to file a motion to strike portions of the Petitioner Reply, and evidence submitted with the Reply. Based on our review of the Reply and the evidence submitted with the Reply, and our consideration of the arguments presented during the telephone conference, we concluded that Patent Owner’s already-authorized sur-reply is a sufficient procedural vehicle for Patent Owner to discuss the issues underlying the requested motion to strike.

(2) REQUESTED SUBMISSION OF NEW EVIDENCE WITH  
PATENT OWNER SUR-REPLY

During the telephone conference, we took under advisement Patent Owner's request for authorization to file a new expert witness declaration with its sur-reply. We hereby authorize Patent Owner to file a new expert witness declaration with its sur-reply directed to the objected-to portions of the Petitioner Reply and evidence addressed therein. As a default rule, a sur-reply "may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b); *see* PTAB Consolidated Trial Practice Guide (Nov. 2019) ("CTPG")<sup>1</sup>, 73–74. However, we have authority to waive or suspend that limitation in specific cases and to place conditions on the waiver or suspension. *See, e.g.*, 37 C.F.R. § 42.5(b). We do so in this case, for the following reasons.

The parties dispute whether a person of ordinary skill in the art at the time of the invention would have been motivated to use a bulk temperature from a thermal mass to estimate LED operating wavelengths, based on the state of the art prior to the effective filing date of the US 7,761,127 B2 patent.

In its Response, Patent Owner relied on Dr. King's expert testimony to support its arguments. *See* Paper 37, 51–57 (citing Ex. 2151 ¶¶ 177–183). In addressing the state of the art prior to the '127 patent, Dr. King's testimony discussed additional references not cited by Petitioner. Ex. 2151 ¶¶ 40, 47–51.

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>

In its Reply, Petitioner submitted new evidence responding to Patent Owner's arguments in the Response and the evidence submitted with the Response concerning the state of the art prior to the '127 patent. Relevant here, the Reply included Exhibits 1050–1054, and paragraphs 32–52 of Dr. Anthony's Supplemental Declaration.

Although the objected-to Exhibits and testimony appear to be reasonably responsive to issues raised by Patent Owner and Dr. King, resolution of the dispute presented in this case would benefit from further expert testimony on behalf of Patent Owner. In addition to our default restriction that a “sur-reply may only respond to arguments raised in the corresponding reply,” any such additional testimony shall be limited to the subject matter identified in Patent Owner's email of September 8. *See* 37 C.F.R. § 42.23(b); Ex. 3004.

### (3) BRIEFING AND CASE SCHEDULE CONSIDERATIONS

During the September 14 telephone conference, we instructed the parties to submit by email a joint proposal with respect to briefing procedures and scheduling to accommodate Patent Owner's filing of a new expert witness declaration with its sur-reply. Unable to reach consensus, the parties provided separate proposals. Ex. 3005. Upon consideration of the parties' proposals, we generally adopt Patent Owner's proposal, with the caveat that no additional words or pages are authorized for the sur-reply.

Accordingly, Patent Owner will adhere to the existing October 11, 2023 deadline for filing its sur-reply, along with the new expert witness declaration we have authorized. *See* Paper 40. The sur-reply will comply with the Board's default 5,600-word count limitation. *See* 37 C.F.R. § 42.24(c)(4).

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Petitioner may cross-examine Patent Owner's declarant via deposition, regarding testimony proffered with Patent Owner's sur-reply. The deposition shall take place on or before October 17, 2023.

Petitioner also is authorized to file observations on cross-examination from that testimony, not to exceed 7 pages. Any such observations shall be filed on or before October 23, 2023.

At this time, we do not discern a need to delay oral argument, currently scheduled for November 1, 2023. Additionally, service of oral argument demonstratives will remain due on or before October 25, 2023.

(4) ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's e-mail request for authorization to file a motion to strike is *denied*;

FURTHER ORDERED that Patent Owner is authorized to file a new expert witness declaration with its sur-reply on or before October 11, 2023;

FURTHER ORDERED that Petitioner is authorized to cross-examine Patent Owner's witness via deposition regarding testimony proffered with the Patent Owner sur-reply on or before October 17, 2023; and

FURTHER ORDERED that Petitioner is authorized to file observations on the cross-examination of Patent Owner's declarant not to exceed 7 pages on or before October 23, 2023.

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