

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2022-01299
Patent 7,761,127 B2

Before GEORGE R. HOSKINS and ROBERT A. POLLOCK,
Administrative Patent Judges.

POLLOCK, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings and Trial Hearing
37 C.F.R. §§ 42.5 & 42.70

On September 27, 2023, the Board held a telephone conference with counsel for both parties to discuss scheduling for this case, as well as parallel cases IPR2022-01291 and IPR2022-01465. 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 in each proceeding. That transcript, once filed, will constitute the official record of the telephone conference.

This Order: (1) memorializes the result of the telephone conference as to Due Date 8 and certain elements of the briefing schedule and (2) sets forth various procedures for preparing for and conducting oral argument.

(1) DUE DATE 8 and BRIEFING SCHEDULE

In their joint email of September 27, the parties jointly proposed a change in DUE DATE 8 from Wednesday, November 1 to Friday, November 17, as indicated below, as well as certain changes in the proposed briefing schedule for this proceeding. *See Ex. 3006.* The parties' joint requests are granted.

(2) ORAL ARGUMENT

A. Time and Format

Consistent with the above, oral argument will begin at **10:00 AM EASTERN TIME on November 17, 2023**. Petitioner requested that the hearing be conducted virtually by videoconference (Paper 48, 1), whereas Patent Owner stated that an in-person oral hearing was preferred (Paper 50, 1). Both parties requested 60 minutes of argument time per side. Upon consideration, the Board will hold the hearing **by videoconference**. The

Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing. Each party shall have **60 minutes** to present its case.

As the party with the burden of proof and persuasion, Petitioner will proceed first to present its case with regard to the challenged claims and grounds set forth in the Petition. Patent Owner then may present its own case, and respond to Petitioner's argument. Petitioner and Patent Owner may reserve some, but no more than half, of the allotted time for rebuttal and sur-rebuttal, respectively. The parties are reminded that arguments made during rebuttal and sur-rebuttal periods must be responsive to arguments the opposing party made in its immediately preceding presentation. The parties are also reminded that during the hearing, the parties "may only present arguments relied upon in the papers previously submitted." PTAB Consolidated Trial Practice Guide (Nov. 2019) ("CTPG") 86.¹

During the September 27 telephone conference, Petitioner indicated the parties may desire to discuss confidential information which we have placed under seal, during the oral argument. Accordingly, the hearing will proceed in two phases. In a first phase that will be open to the public, each party will present its argument as to publicly available information, in the back-and-forth manner described in the previous paragraph of this Order. In a second phase the hearing will be closed to any person not qualified to receive sealed information pursuant to the Board's Protective Order. *See* Paper 30, Ex. 2094. The public line(s) will be terminated prior to the beginning of the second phase, to preserve confidentiality. Accordingly, at the beginning of the hearing, we will ask counsel for each party whether

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

they wish to reserve some of their argument time for the second session. Any such reservation may be modified, either up or down, as the hearing progresses.

The parties may request a pre-hearing conference in advance of the hearing. *See* CTPG 82. “The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the hearing, and to seek the Board’s guidance as to particular issues that the panel would like addressed by the parties.” *Id.* If either party desires a pre-hearing conference, the parties should jointly contact the Board at Trials@uspto.gov at least seven (7) business days before the hearing date to request a conference call for that purpose.

B. Demonstrative Exhibit(s)

Each party shall serve on the other party any demonstrative exhibit(s) it intends to use during the hearing on or before November 13, 2023. *See* 37 C.F.R. § 42.70(b); Ex. 3006. Each party shall file any demonstrative exhibits it intends to use during the hearing as an exhibit on or before November 15, 2023. Ex. 3006.

Demonstrative exhibits used at the oral hearing are aids to oral argument and are not evidence. Accordingly, demonstrative exhibits shall be clearly marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. Demonstrative exhibits cannot be used to advance arguments or introduce evidence not previously presented in the record. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (holding that the Board is obligated under its own regulations to dismiss untimely argument “raised for the first time during oral argument”). “[N]o new evidence may be presented at the oral argument.” CTPG 86; *see*

also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich., IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that “new” evidence includes evidence already of record but not previously discussed in any paper of record).

Furthermore, because of the strict prohibition against the presentation of new evidence or arguments at a hearing, it is strongly recommended that each demonstrative include a citation to a paper in the record, which allows the Board to easily ascertain whether a given demonstrative contains “new” argument or evidence or, instead, contains only that which is developed in the existing record.

Due to the nature of the Board’s consideration of demonstratives and the opportunity afforded for the parties to reach an agreement without involving the Board, the Board does not anticipate that objections to demonstratives are likely to be sustained. Nevertheless, to the extent that a party objects to the propriety of any demonstrative, the parties shall meet and confer in good faith to resolve any objections to demonstratives prior to filing the objections with the Board. If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board no later than the time of the hearing. The objections shall identify with particularity which portions of the demonstratives are subject to objection (and should include a copy of the objected-to portions) and include a one sentence statement of the reason for each objection. No argument or further explanation is permitted. The Board will consider any objections, and may reserve ruling on the objections.² Any objection to demonstratives that is not timely presented will be considered waived.

² If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

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