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Filed on behalf of:

Patent Owner Masimo Corporation
By: Irfan A. Lateef (Reg. No. 51,922)
Ted M. Cannon (Reg. No. 55,036)
Jarom D. Kesler (Reg. No. 57,046)
Jacob L. Peterson (Reg. No. 65,096)
Jeremiah S. Helm, Ph.D. (admitted *pro hac vice*)

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: AppleIPR127-2@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2022-01300
U.S. Patent 7,761,127

PATENT OWNER UNOPPOSED MOTION TO EXPUNGE

Pursuant to 37 C.F.R. § 42.56 and as authorized by the Board by a March 14, 2023 email, Patent Owner Masimo Corporation (“Masimo”) moves to expunge the confidential version of its Patent Owner Preliminary Response (Paper 9), the confidential versions of Exhibits 2002, 2051, 2081, and Exhibits 2003, 2004, 2006, 2007, 2009, 2010, 2012-2021, 2027, 2028, 2031-2033, 2057, 2058, and 2082.

Counsel for the parties conferred by email regarding Masimo’s request to expunge and Apple does not oppose.

I. DOCUMENTS REQUESTED TO BE EXPUNGED

Masimo filed Renewed Motions to Seal in IPR2022-01299 (Paper 14) and this IPR2022-01300 (Paper 15) on November 22, 2023 (the “Renewed Motions”). In the Renewed Motions, Masimo requested the sealing of the documents it now requests to expunge, and established the highly sensitive and confidential nature of those documents, as described below.

Exhibit 2002 is the Declaration of named inventor Mohamed Diab. The declaration tracks ITC Investigation testimony that Diab gave in deposition and at the evidentiary hearing. Paragraphs 19-27, 37-42, 47, 48, and 71-90 of Diab’s declaration contains information pertaining to Masimo’s research, development, and production work related to the subject matter of the ’127 patent and patented products.

Exhibit 2003 is a collection of plots from computer simulations that Diab

performed while researching and developing the invention of the '127 patent and rainbow® products.

Exhibits 2004 and 2017 are Masimo internal PowerPoint Presentations about research and development of the '127 invention and rainbow® products.

Exhibits 2006, 2007, 2009, 2010, 2012, 2013, 2014, 2015, 2020, 2027, 2032, and 2033 are engineering drawings and technical specifications detailing the design, structure, components, materials used, dimensions, and functionality of rainbow® sensors. These documents have internal corporate confidentiality designations.

Exhibit 2016 is an internal Masimo CAD drawing showing an expanded view of, and additional detail related to, the substrate of some rainbow® products.

Exhibit 2018 is a technical data sheet for adhesive used in rainbow® sensors.

Exhibits 2019 and 2021 are internally produced, non-public photographs of internal parts and structure of rainbow® sensors that are not publicly viewable.

Exhibit 2028 is a collection of testing data plots showing results of internal Masimo sensor characterization tests to verify that the rainbow® products work.

Exhibit 2031 is Diab's confidential research folder containing an internal Masimo technical report authored by the named inventors and having an internal corporate confidentiality designation. This exhibit contains information about Masimo's research and development of the '127 invention and rainbow® products.

Exhibit 2051 is a declaration of Masimo's technical expert, Jack Goldberg.

Paragraphs 28-32 of Goldberg’s declaration include information from the confidential testimony of Diab and Exhibit 2003. Exhibits 2057 and 2058 are Goldberg’s claim charts detailing analysis comparing the rainbow® products to the claims of the ’127 patent. The charts heavily rely on confidential exhibits.

Exhibit 2081 is a declaration of Micah Young, Masimo’s CFO. Paragraph 9 summarizes confidential financial data in Exhibit 2082. Exhibit 2082 is a spreadsheet showing confidential financial data from an internal Masimo database.

The confidential version of Masimo’s Patent Owner Preliminary Response (Paper 9) references portions of the confidential information contained in the exhibits listed above.

None of these exhibits or confidential information have been made public.

II. MASIMO ESTABLISHED GOOD CAUSE TO SEAL AND FOR ENTRY OF A PROTECTIVE ORDER WITH A CONFIDENTIAL BUSINESS INFORMATION DESIGNATION

In the Renewed Motions, Masimo established good cause to seal the documents under *Argentum Pharms. LLC v. Alcon Res., Ltd.*, IPR2017-01053, Paper 27 at 3–4 (PTAB Jan. 19, 2018) (informative). *See* IPR2022-01299 Paper 14 at 4-6; IPR2022-01300 Paper 15 at 4-6. Further, Masimo established good cause for entry of a protective order with a “confidential business information” (“CBI”) designation because the documents contain highly sensitive information about the development, design, structure, and functionality of Masimo’s rainbow® sensors. *See*

IPR2022-01299 Paper 14 at 6-8; IPR2022-01300 Paper 15 at 6-8. In IPR2022-01299, the Board found “Patent Owner has shown good cause to seal the identified documents” and “Patent Owner shows good cause supporting the CBI provisions.” IPR2022-01299 Paper 27 at 1, 3. Presumably because it denied institution, the Board did not decide the Renewed Motion in this IPR. *See* IPR2022-01300 Paper 22.

III. THE DOCUMENTS REQUESTED TO BE EXPUNGED ARE NOT NECESSARY TO UNDERSTANDING THE BOARD’S DECISION NOT TO INSTITUTE THIS IPR

By email to the Board dated February 24, 2023, Masimo requested withdrawal and expungement, in IPR2022-01299, of the same documents and exhibits it now moves to expunge in this IPR2022-01300. Ex. 3003. The Board considered “Patent Owner’s request as a motion to withdraw its prior motion to seal, and to withdraw and expunge an expanded list of cited documents.” IPR2022-01299 Paper 30 at 1. The Board granted the motion because it was unopposed “and the referenced documents are not necessary to understanding the reasons underlying our Decision to Institute.” *Id.*

Here, likewise, this Motion is unopposed and the documents Masimo requests to be expunged are not necessary to understanding the reasons underlying the Board’s decision not to institute this IPR. *See generally* IPR2022-01300 Paper 22. Specifically, the Board reviewed the Petitions in this IPR and IPR2022-01299 and

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