

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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IPR2022-01300  
(Patent 7,761,127 B2)

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Before JOSIAH C. COCKS, JAMES A. TARTAL, and  
ROBERT A. POLLOCK, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

DECISION

Granting Patent Owner's Unopposed Motion to Expunge  
*37 C.F.R. §§ 42.14, 42.56*

## I. INTRODUCTION

On February 1, 2023, the Board issued a Decision that denied institution of *inter partes* review under 35 U.S.C. § 314(a) because Petitioner, Apple Inc., did not adequately justify multiple *inter partes* reviews based on multiple petitions against U.S. Patent No. 7,761,127 B2 (Ex. 1001, “the ’127 Patent”). Paper 22 (“Dec.” or “Decision”).

Pursuant to 37 C.F.R. § 42.56, Patent Owner, Masimo Corporation, filed an Unopposed Motion to Expunge. Paper 25 (“Mot.”). The motion was previously authorized via email on March 14, 2023. Mot. 1.

Patent Owner moves to expunge their 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. *Id.* Patent Owner states that Petitioner does not oppose the Motion. *Id.*

For the reasons set forth below, we *grant* Patent Owner’s Motion.

## II. LEGAL STANDARD

Rule 42.56 provides that “[a]fter denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.” 37 C.F.R. § 42.56. The following commentary accompanying Rule 42.56 explains the purpose of the rule:

Confidential information that is subject to a protective order ordinarily will become public . . . 45 days after final judgment in a trial. Section 42.56 allows a party to file a motion to expunge from the record confidential information prior to the information becoming public. Section 42.56 reflects the considerations identified in 35 U.S.C. 316(b), as amended, and 35 U.S.C. 326(b), which state that the Office is to take into account the

integrity of the patent system in promulgating regulations. The rule balances the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history for public notice purposes. Specifically, there is an expectation that information be made public where the existence of the information is referred to in a decision to grant or deny a request to institute a review or identified in a final written decision.

Rules of Practice for Trials before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,623 (Aug. 14, 2012) (“Trial Rules”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>, 21–22 (similarly describing balancing “the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history for public notice purposes”).

### III. ANALYSIS

As stated above, there is an expectation that information will be made public when the existence of that information is referred to in a Board decision. *See* Trial Rules, 77 Fed. Reg. at 48,623. By filing its Motion, Patent Owner seeks to keep confidential certain exhibits and papers that ordinarily will be become public. *See* Motion 1–5.

As noted above, we denied institution of *inter partes* review for this proceeding under 35 U.S.C. § 314(a) because Petitioner did not adequately justify multiple petitions challenging the ’127 Patent. Therefore, the referenced documents are not necessary to understand the reasons underlying our Decision. Furthermore, the motion is unopposed. Mot. 1. For these reasons, Patent Owner’s motion is granted.

#### IV. CONCLUSION

It is:

ORDERED that Patent Owner's Motion to Expunge is *granted*; and  
FURTHER ORDERED that the Patent Owner's Preliminary Response  
(Paper 9); the unredacted versions of Exhibits 2002, 2051, 2081; and  
Exhibits 2003, 2004, 2006, 2007, 2009, 2010, 2012–2021, 2027, 2028,  
2031–2033, 2057, 2058, and 2082 will be expunged from the record.

IPR2022-01300  
Patent 7,761,127 B2

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