

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

**PETITIONER'S OPPOSITION TO PATENT OWNER'S RENEWED
MOTION TO SEAL AND FOR ENTRY OF A PROTECTIVE ORDER**

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LIST OF EXHIBITS

- APPLE-1001 U.S. Patent No. 7,761,127 to Al-Ali (“the ’127 Patent”)
- APPLE-1002 Excerpts from the Prosecution History of the ’127 Patent
- APPLE-1003 Expert Declaration of Brian Anthony, Ph.D.
- APPLE-1004 Certified English Translation of Japanese Patent Publication No. JP 2004-337605 A (“Yamada”)
- APPLE-1005 U.S. Patent No. 3,514,538 (“Chadwick”)
- APPLE-1006 U.S. Patent No. 4,591,659 (“Leibowitz”)
- APPLE-1007 U.S. Patent No. 5,259,381 (“Cheung”)
- APPLE-1008 U.S. Patent No. 5,334,916 (“Noguchi”)
- APPLE-1009 U.S. Patent Publication No. 2003/0033102 (“Dietiker”)
- APPLE-1010 U.S. Patent Publication No. 2005/0279949 (“Oldham”)
- APPLE-1011 Japanese Patent Publication No. JP 2004-337605 A
- APPLE-1012 Respondent Apple Inc.’s Post-Hearing Brief, *In the Matter of Certain Light-Based Physiological Measurement Devices and Components Thereof*, International Trade Commission Investigation No. 337-TA-1276 (June 27, 2022)
- APPLE-1013 *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*, issued June 21, 2022 (“Interim Guidance”)
- APPLE-1014 J.A. Scarlett, *The Multilayer Printed Circuit Board Handbook* (1985) (selected excerpts)
- APPLE-1015 Peltier Effect Heat Pumps Datasheet (March 1999)

APPLE-1016 Counsel's Email Exchange re "Motions to Seal and Protective Order" dated November 2, 2022 and November 3, 2022

Through its Renewed Motion to Seal and for Entry of a Protective Order (Paper 14, “Renewed Motion”), Masimo seeks to unilaterally foist on Apple a prosecution bar that runs contrary to the Board’s well-established guidelines and public policy. Masimo contends that a prosecution bar is necessary for protection of information that it voluntarily submitted with its Preliminary Response, and argues that a prosecution bar is appropriate given that one is already in place at the ITC. Not so. The Board has long recognized that prosecution bars are “*rarely appropriate*” in PTAB proceedings, especially since the detrimental impact that a prosecution bar is likely to have on parties in Office proceedings “in most cases outweighs the risk that confidential technical information ... will be revealed during a proceeding.” Consolidated Trial Practice Guide (“CTPG”), 116. Board guidelines specifically instruct parties to *remove* prosecution bars and similar provisions that are “commonly found” in protective orders in other forums, but which are nonetheless “unnecessary or inappropriate in proceedings before the Board.” *Id.*

Rather than comply with the Board’s guidelines, however, Masimo flouts them in an effort to subject Apple to a prosecution bar that risks prejudicing Apple in co-pending or future Office proceedings that may bear on Masimo’s litigation campaign and the broader dispute between the parties. The detrimental impact that Masimo’s prosecution bar poses to Apple in this case raise similar concerns to

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