

Nicholas Stephens

From: Daniel Kiang <Daniel.Kiang@knobbe.com>
Sent: Monday, February 13, 2023 4:46 PM
To: Nicholas Stephens
Cc: PTAB Inbound; AppleIPR745-1; IPR50095-0045IP1; Kim Leung
Subject: RE: Request for Discovery - IPR2022-01291

Counsel,

We disagree with your assertion that a conference call with the Board would be premature. As we noted below, the parties already met and conferred on this discovery months ago. We are simply renewing our request as the Board permitted.

Your original email on February 8 sought only an identification of the evidence, which we promptly provided. You did not request information about how that information would be useful until this morning. Again, we promptly provided that information by directing you to specific pages of briefing in the ITC and the ITC's Initial Determination showing how that evidence was already used. We discern no basis for Apple to demand further categorization of each piece of evidence by purpose (e.g., copying, commercial success, etc.) as a prerequisite to a conference call with the Board, nor do we see how an exhaustive categorization would even be possible given that the information remains under ITC protective order. Indeed, Apple did not previously request such an itemization when we last conferred with the Board regarding this discovery. The public briefing demonstrates that the evidence exists and that Masimo relied on it to show nonobviousness.

Contrary to your assertion, we have already completed a meet and confer process in good faith. Indeed, we have answered all your questions and are not aware of any additional pending questions. We also offered Apple a time to discuss any additional questions you may have, but Apple ignored that request and did not propose another time. Accordingly, we understand that the meet and confer process is complete. However, Apple has not responded to Masimo's question regarding whether Apple would object to evidence from the ITC as hearsay and whether it would make the identified Apple witnesses available for deposition if Apple were to so object. Please set forth your position on that issue before the call with the Board.

We also disagree with your changes to the final paragraph of the proposed email to the Board. We will be emailing the Board as follows:

Dear Board,

Pursuant to Paper 9 in IPR2022-01291, Patent Owner respectfully renews its request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) in IPR2022-01291 and IPR2022-01465 (and potentially IPR2022-01466, if instituted). Patent Owner seeks information relevant to objective indicia of nonobviousness and reasonable expectation of success that was previously produced and relied on in a related ITC proceeding between the parties. The requested information is covered by an ITC protective order and is not publicly available.

Patent Owner has conferred with Petitioner regarding this request. Petitioner has indicated opposition of the motion, pending receipt of clarifying details for items identified as targets for discovery, most notably an indication of the basis for Masimo's belief that the item will be "useful" with respect to Garmin factor 1, and specifically what contention each requested item is believed to be favorable to proving (e.g., alleged copying, commercial success, nexus, etc.). Petitioner contends that a call with the Board is premature. Patent Owner disagrees with Petitioner's contention. Patent Owner has already provided Petitioner with a specific list of

evidence sought and has already directed Petitioner to specific pages within the public ITC briefing and ITC Initial Determination citing the requested evidence to demonstrate nonobviousness of the '745 Patent claims.

The parties are available for a conference call between Tuesday and Friday this week, between 12pm-5pm Eastern.

Best regards,
Daniel

Daniel Kiang

Partner

949-721-5205 Direct

Knobbe Martens

From: Nicholas Stephens <nstephens@fr.com>

Sent: Monday, February 13, 2023 1:49 PM

To: Daniel Kiang <Daniel.Kiang@knobbe.com>

Cc: PTAB Inbound <PTABInbound@fr.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; Kim Leung <Leung@fr.com>

Subject: RE: Request for Discovery - IPR2022-01291

Counsel,

Your draft email to the Board mischaracterizes our interaction, as Masimo has not engaged in and completed a meet and confer process in good faith with Apple on this issue. Rather, Masimo offered an initial request that lacked even a list of items, which Masimo apparently possessed. And, in offering in response to a request for more information, detail regarding the target of its discovery, Masimo still omitted information necessary for Apple to make an informed decision on whether to oppose the solicited motion for discovery.

Most notably, at the close of business on Wednesday, February 8th, we received for the first time an itemized list of documents that Masimo would seek through discovery, each recognized by Masimo as covered by the ITC protective order and not publicly available. This morning, just two business days after receiving the list, we ask for an indication of the basis for Masimo's apparent belief that the item will be "useful" with respect to Garmin factor 1, and specifically what contention each requested item is believed to be favorable to proving (e.g., alleged copying, commercial success, nexus, etc.). To which, we receive your reply.

Apple remains without sufficient information to assess whether Masimo's discovery request is justified under the PTAB rules and jurisprudence governing motions to discover. To be clear, without more from Masimo, Apple must therefore oppose the request for authorization to file a discovery motion. A call with the Board would therefore be premature and a waste of Board resources at this time.

If reaching out to the Board, Apple asks Masimo to change the final paragraph as follows:

"Patent Owner and Petitioner are meeting and conferring regarding this request. Petitioner has indicated opposition of the motion, pending receipt of clarifying details for items identified as targets for discovery, most notably an indication of the basis for Masimo's belief that the item will be "useful" with respect to Garmin factor 1, and specifically what contention each requested item is believed to be favorable to proving (e.g., alleged

copying, commercial success, nexus, etc.). Petitioner believes a call is premature at this point, but Patent Owner and Petitioner are each available for a conference call between Tuesday and Friday this week.”

Best regards,
Nick

Nick Stephens :: Principal :: Fish & Richardson P.C.
612 766 2018 direct :: nstephens@fr.com :: fr.com

From: Daniel Kiang <Daniel.Kiang@knobbe.com>
Sent: Monday, February 13, 2023 12:29 PM
To: Nicholas Stephens <nstephens@fr.com>
Cc: PTAB Inbound <PTABInbound@fr.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; Kim Leung <Leung@fr.com>
Subject: RE: Request for Discovery - IPR2022-01291

Counsel,

We see no reason to further delay a conference call with the Board. We already met and conferred regarding this discovery prior to institution. The Board also stated in its September 28, 2022 order that “Patent Owner may renew its request [to file a motion for additional discovery] at a later time.” IPR2022-01291, Paper 9 at 3. The Institution Decision also noted that “the preliminary record [regarding objective indicia] before us does not appear complete on the matter” and that “[t]he parties may further address objective indicia of nonobviousness during trial.” IPR2022-01291, Institution Decision at 15 n.10. Thus, the Board is already anticipating Masimo will renew its request and is expecting the parties to further address objective indicia.

In your February 8 email, you requested that Masimo identify the information it is seeking before you would schedule a call between the parties. We responded to your email on the same day with a specific list of items we are seeking. Five days later, you are now asking for additional information about how that evidence would be “useful” before you will let us know of your availability for a call. As you know, Masimo already extensively briefed objective evidence of nonobviousness and reasonable expectation of success in the ITC. The ITC Initial Determination found the ’745 Patent claims valid. You may review the public ITC briefing and the ITC Initial Determination to see how that information was used. The relevant page numbers were already cited in our February 8 email. Masimo’s public opening and reply ITC briefs were provided as Exhibits 2011 and 2051, respectively. The public Initial Determination is too large to send by email, but you may download it from the ITC’s Electronic Document Information System (EDIS) at Doc. ID 789795. If you have any further questions, we are available for a call today between 2pm-6pm Eastern.

Please let us know of your availability for a call with the Board this week by no later than 5pm Eastern today. If you do not provide us with your availability by then, we will propose the times listed in the draft email below:

Dear Board,

Pursuant to Paper 9 in IPR2022-01291, Patent Owner respectfully renews its request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) in IPR2022-01291 and IPR2022-01465 (and potentially IPR2022-01466, if instituted). Patent Owner seeks information relevant to objective indicia of nonobviousness and reasonable expectation of success that was previously produced and relied on in a related ITC proceeding between the parties. The requested information is covered by an ITC protective order and is not publicly available.

Patent Owner has conferred with Petitioner regarding this request. Petitioner has not indicated whether it will consent or oppose the motion. Patent Owner is available for a conference call between Tuesday and Friday this

Best regards,
Daniel

Daniel Kiang

Partner

949-721-5205 Direct

Knobbe Martens

From: Nicholas Stephens <nstephens@fr.com>

Sent: Monday, February 13, 2023 6:41 AM

To: Daniel Kiang <Daniel.Kiang@knobbe.com>

Cc: PTAB Inbound <PTABInbound@fr.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; Kim Leung <Leung@fr.com>

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Daniel,

The Board's precedential decision in *Garmin Int'l v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB March 5, 2013) sets forth a set of factors that the Board considers when weighing a motion for additional discovery. The first factor requires "more than a possibility and mere allegation" that something "useful" will be obtained from additional discovery. *Id.*, at 6. Under *Garmin*, "[u]seful" ... does not mean merely 'relevant' and/or 'admissible'" but instead "means favorable in substantive value to a contention of the party moving for discovery." *Id.*, at 7 (emphasis added).

Beyond the broad assertion that Masimo's request relates to secondary considerations and reasonable expectation of success, the utility of the requested information identified in your email below remains unclear. We do not fully understand why Masimo believes each of the items listed below would allegedly be "useful" under *Garmin*. Accordingly, for each requested item, would you please let us know the basis for Masimo's apparent belief that the item will be "useful" with respect to *Garmin* factor 1, and specifically what contention each requested item is believed to be favorable to proving (e.g., alleged copying, commercial success, nexus, etc.)?

As indicated last week, we hope to quickly advance the conferral process, but we believe a Board call would be premature at the moment. Further explanation on the above items will help us to better consider the request and formulate a position on the same.

Best regards,
Nick

Nick Stephens :: Principal :: Fish & Richardson P.C.

612 766 2018 direct :: nstephens@fr.com :: fr.com

From: Nicholas Stephens

Sent: Friday, February 10, 2023 9:49 PM

To: 'Daniel Kiang' <Daniel.Kiang@knobbe.com>

Cc: PTAB Inbound <PTABInbound@fr.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; Kim Leung <leung@fr.com>

Subject: RE: Request for Discovery - IPR2022-01291

Daniel,

Thank you for your email. We have been considering the list that you provided on Wednesday, but as you know, the identified items appear to encompass a significant number of confidential documents from the ITC proceeding. We are in the process of conferring with our client and I expect to get back to you with further information on Monday.

Best regards,
Nick

Nick Stephens :: Principal :: Fish & Richardson P.C.
612 766 2018 direct :: nstephens@fr.com :: fr.com

From: Daniel Kiang <Daniel.Kiang@knobbe.com>
Sent: Friday, February 10, 2023 1:27 PM
To: Nicholas Stephens <nstephens@fr.com>
Cc: PTAB Inbound <PTABInbound@fr.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; Kim Leung <Leung@fr.com>
Subject: RE: Request for Discovery - IPR2022-01291

Counsel,

Please let us know your position on the issues below by the end of today. Please also let us know your availability for a conference call with the Board next week regarding Masimo's motion for additional discovery. We are generally available for a conference call with the Board Tuesday through Friday next week between 9am-2pm Pacific/12pm-5pm Eastern.

Best regards,
Daniel

Daniel Kiang
Partner
949-721-5205 Direct
Knobbe Martens

From: Daniel Kiang
Sent: Wednesday, February 8, 2023 4:11 PM
To: Nicholas Stephens <nstephens@fr.com>
Cc: PTAB Inbound <PTABInbound@fr.com>; AppleIPR745-1 <AppleIPR745-1@knobbe.com>; IPR50095-0045IP1 <IPR50095-0045IP1@fr.com>; Kim Leung <Leung@fr.com>
Subject: RE: Request for Discovery - IPR2022-01291

Nick,

Thank you for your email. Masimo is seeking the following documents:

- Unredacted versions of the parties' opening and reply ITC post-hearing briefs
- Unredacted version of the January 10, 2023 Final Initial Determination on Violation of Section 337
- ITC hearing testimony transcripts for Stephen Waydo, Paul Mannheimer, Vivek Venugopal, Brian Land, and Daniel McGavock
- ITC deposition testimony for Stephen Waydo (CX-0299C), Paul Mannheimer (CX-0289C), Tao Shui (CX-0295C), Mathieu Charbonneau-Lefort (CX-0283C), and Aditya Dua (CX-0285C)

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