

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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Case IPR2022-01465  
U.S. Patent 10,687,745

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
MOTION FOR ADDITIONAL DISCOVERY**

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**LIST OF EXHIBITS**

APPLE-1001	U.S. Pat. No. 10,687,745 to Al-Ali (“the ’745 patent”)
APPLE-1002	Prosecution History of the ’745 patent (Serial No. 16/835,772)
APPLE-1003	Declaration of Dr. Brian Anthony
APPLE-1004	U.S. Pat. No. 8,670,819 (“Iwamiya”)
APPLE-1005	U.S. Pat. No. 9,392,946 (“Sarantos”)
APPLE-1006	U.S. Pub. No. 2014/0275854 (“Venkatraman”)
APPLE-1007	U.S. Pat. No. 6,483,976 (“Shie”)
APPLE-1008	U.S. Pat. No. 6,801,799 (“Mendelson-799”)
APPLE-1009	U.S. Pub. No. 2015/0018647 (“Mandel”)
APPLE-1010	U.S. Pub. No. 2009/0275810 (“Ayers”)
APPLE-1011	Int’l Pub. No. WO 2011/051888 (“Ackermans”)
APPLE-1012	U.S. Pat. No. 6,158,245 (“Savant”)
APPLE-1013	Design of Pulse Oximeters, J.G. Webster; Institution of Physics Publishing, 1997 (“Webster”)
APPLE-1014	U.S. Pub. No. 2009/0054112 (“Cybart”)
APPLE-1015	U.S. Pat. No. 5,893,364 (“Haar”)
APPLE-1016	U.S. Pat. No. 5,952,084 (“Anderson”)

- APPLE-1017 U.S. Pat. No. 10,470,695 (the “695 patent”)
- APPLE-1018 *Apple v. Masimo*, Case No. IPR2020-01722, Paper 29 (Final Written Decision) (PTAB May 5, 2022) (the “695 FWD”)
- APPLE-1019 U.S. Pub. No. 2009/0097129 (“Naito”)
- APPLE-1020 U.S. Pub. No. 2006/0128869 (“Taima”)
- APPLE-1021 *Polymers and Plastic Resins Information*, Engineering360, printed from [https://www.globalspec.com/learnmore/materials\\_chemicals\\_adhesives/plastics\\_elastomers\\_polymers/plastics\\_polymers](https://www.globalspec.com/learnmore/materials_chemicals_adhesives/plastics_elastomers_polymers/plastics_polymers) on August 15, 2022
- APPLE-1022 *Methods and Approaches of Futures Studies*, printed from <http://crab.rutgers.edu/~goertzel/futuristmethods.html> on August 15, 2022
- APPLE-1023 – APPLE-1030 RESERVED
- APPLE-1031 *Masimo Corporation, et al. v. Apple Inc.*, Redacted Complaint, ITC Inv. No. 337-TA-1276
- APPLE-1032 *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation*, issued June 21, 2022 (“Interim Guidance”)
- APPLE-1033 Final Initial Determination on Violation of Section 337, Public Version, ITC Inv. No. 337-TA-1276, January 10, 2023
- APPLE-1034 Emails re Masimo’s Request for Authorization to Motion for Additional Discovery

## **I. Introduction**

Through its Motion, Masimo seeks production on issues of secondary considerations of non-obviousness and reasonable expectation of success, and it targets documents collected through discovery and under an agreed upon protective order in co-pending ITC investigation 337-TA-1276.

Masimo proclaims a desire to bring the Board a complete record on topics for which discovery is sought, but its actions speak loudly otherwise, as its requested discovery—if permitted—is woefully imbalanced and is calibrated only to tell Masimo’s story (and to avoid the substantial volume of contrary evidence). Indeed, the alleged bases for Masimo’s discovery requests include public versions of Masimo’s own ITC briefs, but none of Apple’s. Motion, 2. By selecting targets for requested discovery cited in its own briefs to the exclusion of Apple’s, Masimo seeks an incomplete and imbalanced representation of the ITC record. On this basis alone, Masimo’s intent is clear and the Motion should fail.

The breadth and scope of Masimo’s discovery request is also unjustifiable. If granted, it would implicate some 2,200 pages of documents and lead to “trials-within-trial” on whether Apple’s products practice the ’745 patent and whether Apple copied Masimo’s technology (contentions both rejected by the ITC). More granularly, its requests would yield production of testimony and documents covering topics ranging from domestic industry to infringement and validity, both

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