

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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IPR2022-01271 (Patent 10,912,501 B2)	IPR2022-01276 (Patent 10,945,648 B2)
IPR2022-01272 (Patent 10,912,501 B2)	IPR2022-01291 (Patent 10,687,745 B1)
IPR2022-01273 (Patent 10,912,502 B2)	IPR2022-01292 (Patent 10,687,745 B1)
IPR2022-01274 (Patent 10,912,502 B2)	IPR2022-01465 (Patent 10,687,745 B1)
IPR2022-01275 (Patent 10,945,648 B2)	IPR2022-01466 (Patent 10,687,745 B1) <sup>1</sup>

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Before JOSIAH C. COCKS, NEIL T. POWELL, JAMES A. TARTAL, and  
ROBERT A. POLLOCK, *Administrative Patent Judges*.<sup>2</sup>

COCKS, *Administrative Patent Judge*.

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<sup>1</sup> This Order applies to the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

<sup>2</sup> The panel has not been expanded for any of the noted proceedings. The listing of four judges accounts for variation in paneling as between the proceedings.

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ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

*1. Introduction*

A conference call was held on September 23, 2022, between counsel for the respective parties and Judges Cocks, Powell, and Tartal.<sup>3</sup> Petitioner, Apple Inc., was represented by Daniel Smith and Karl Renner. Patent Owner, Massimo Corporation, was represented by Jacob Peterson and Jeremiah Helm. The purpose of the call was to discuss Patent Owner's request to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) in each of the noted proceedings.

*2. Discussion*

During the call, Patent Owner expressed that it was seeking, as a part of its requested motion for additional discovery, to obtain information relevant to objective indicia of non-obviousness. Patent Owner explained that such information had been identified in publicly available materials as a part of a related, ongoing International Trade Commission (ITC) proceeding,

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<sup>3</sup> Judge Pollock is a panel member on two of the noted proceedings but was unavailable for the conference call.

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but that the material, itself, was not publicly available. Petitioner indicated that it opposed Patent Owner's request.

Generally, our rules contemplate that matters of discovery, if applicable, emerge in a proceeding once a panel has determined that institution of a trial is warranted. Here, a determination whether to institute a trial in any of the noted proceedings has not yet been made. During the call, we noted that Patent Owner's request, at this stage, appeared to be premature. Patent Owner acknowledged that its request likely was premature. Additionally, both parties indicated that the material sought by Patent Owner was presently the subject of a protective order in the relevant ITC proceeding. Patent Owner indicated that it had filed a motion in that ITC proceeding to amend the protective order to allow for submission of the pertinent material in these *inter partes* review (IPR) proceedings. Both parties acknowledged that the ITC's determination as to the request to amend the relevant protective order may have an impact on Patent Owner's request to file a motion for additional discovery.

Given the circumstances present here, we deny Patent Owner's request to file a motion for additional discovery in any of the noted IPR proceedings. In the event of a change in circumstances, Patent Owner may renew its request at a later time.

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### 3. Order

It is

ORDERED that Patent Owner's request to file a motion for additional discovery in any of the noted IPR proceedings is *denied* without prejudice.

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