

Filed: September 16, 2022

Filed on behalf of:

Patent Owner Masimo Corporation
By: Brian C. Claassen (Reg. No. 63,051)
Carol Pitzel Cruz (Reg. No. 61,224)
Jarom D. Kesler (Reg. No. 57,046)
Jacob L. Peterson (Reg. No. 65,096)
Daniel Kiang (Reg. No. 79,631)

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: AppleIPR745-4@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2022-01466
U.S. Patent 10,687,745

**PATENT OWNER SUBMISSION OF MANDATORY NOTICE
INFORMATION PURSUANT TO 37 C.F.R. § 42.8(a)**

Pursuant to 37 C.F.R. § 42.8, Patent Owner Masimo Corporation hereby submits the following mandatory notice information.

I. Real Party in Interest Pursuant to 37 C.F.R. § 42.8(b)(1)

The real party in interest is Masimo Corporation.

II. Related Matters Pursuant to 37 C.F.R. § 42.8(b)(2)

The matters listed below might affect, or be affected by, a decision in this proceeding pursuant to 37 C.F.R. § 42.8(b)(2).

A. Litigation Involving the Patent-at-Issue

U.S. Patent No. 10,687,745 (“the ’745 Patent”) in the following Investigation: *In the Matter of Certain Light-Based Physiological Measurement Devices and Components Thereof*, Inv. No. 337-TA-1276, pending in the U.S. International Trade Commission.

B. Patents and Patent Applications Claiming Priority to the Patent-at-Issue

At least the following patents and applications claim priority to, or share a priority claim with, the ’745 Patent:

Country Code (or Jurisdiction)	Patent No.	Application No.
US	10,448,871	15/195199
US	10,470,695	16/226249
US	10,638,961	16/532061
US	10,646,146	16/532065
US	10,687,743	16/791955

IPR2022-01466

Apple Inc. v. Masimo Corporation

Country Code (or Jurisdiction)	Patent No.	Application No.
US	10,722,159	16/791963
US	10,687,744	16/835712
US	Pending	16/871874

C. Related Proceedings Before the Board

Patent Owner also identifies the following additional *inter partes* review proceedings related to patents asserted by Patent Owner in the above-referenced International Trade Commission litigation:

Petitioner	Case Number	Patent Number
Apple Inc.	IPR2022-01271	10,912,501
Apple Inc.	IPR2022-01272	10,912,501
Apple Inc.	IPR2022-01273	10,912,502
Apple Inc.	IPR2022-01274	10,912,502
Apple Inc.	IPR2022-01275	10,945,648
Apple Inc.	IPR2022-01276	10,945,648
Apple Inc.	IPR2022-01291	10,687,745
Apple Inc.	IPR2022-01292	10,687,745
Apple Inc.	IPR2022-01465	10,687,745
Apple Inc.	IPR2022-01299	7,761,127
Apple Inc.	IPR2022-01300	7,761,127

D. Litigation Involving Related Patents

Patent Owner also identifies the following appeal from final written decision in an *inter partes* review proceeding involving a related patent:

- *Masimo Corporation v. Apple Inc.*, U.S. Court of Appeals for the Federal Circuit, Case No. 22-01895

III. Lead and Back-Up Counsel Pursuant to 37 C.F.R. § 42.8(b)(3)

Patent Owner hereby designates its lead and backup counsel as follows:

Lead Counsel	Back-up Counsel
Brian C. Claassen (Reg. No. 63,051) Knobbe, Martens, Olson, & Bear, LLP 2bcc@knobbe.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502	Carol Pitzel Cruz (Reg. No. 61,224) Knobbe, Martens, Olson, & Bear, LLP 2cmp@knobbe.com <u>Postal and Hand-Delivery Address:</u> 925 Fourth Avenue, Suite 2500 Seattle, WA 98104 (206) 405-2000 Telephone (206) 405-2001 Facsimile
Back-up Counsel	Back-up Counsel
Jarom D. Kesler (Reg. No. 57,046) Knobbe, Martens, Olson, & Bear, LLP 2jzk@knobbe.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502	Jacob L. Peterson (Reg. No. 65,096) Knobbe, Martens, Olson, & Bear, LLP 2jup@knobbe.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502
Back-up Counsel	
Daniel C. Kiang (Reg. No. 79,631) Knobbe, Martens, Olson, & Bear, LLP 2dck@knobbe.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502	

IPR2022-01466

Apple Inc. v. Masimo Corporation

IV. Service Information Pursuant to 37 C.F.R. § 42.8(b)(4)

Please address all correspondence to lead counsel at the address shown above. Patent Owner also consents to electronic service by email to: AppleIPR745-4@knobbe.com.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 16, 2022

/Jacob L. Peterson/

Jacob L. Peterson (Reg. No. 65,096)

Customer No. 64,735

Attorney for Patent Owner
Masimo Corporation

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.