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UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

CERTAIN LIGHT-BASED
PHYSIOLOGICAL MEASUREMENT
DEVICES AND COMPONENTS
THEREOF

Inv. No. 337-TA-1276

ORDER NO. 44: DENYING COMPLAINANTS' MOTION *IN LIMINE* NO. 4 TO EXCLUDE APPLE WATCH SERIES 0 AS PRIOR ART TO THE '745 PATENT

(June 3, 2022)

On May 17, 2022, Complainants Masimo Corporation and Cercacor Laboratories, Inc. (collectively, "Masimo") filed a motion *in limine* no. 4 (the "Motion," Docket No. 1276-040) to preclude any evidence or arguments that the claims of the '745 patent are invalid as anticipated or rendered obvious by the Apple Watch Series 0.¹ On May 24, 2022, Respondent Apple Inc. ("Apple") filed a response in opposition to the motion ("Opp.").

Masimo seeks to preclude Apple from asserting the Apple Watch Series 0 as prior art to the '745 patent, because Apple first identified this prior art in its final invalidity contentions served on February 11, 2022. *See* Motion Exhibit 2. Masimo further identifies several documents related to the Apple Watch Series 0 that were produced late in discovery and a physical Apple Watch Series 0 that was not produced until the last day of fact discovery. Motion at 3-5. Masimo submits that it was prejudiced by Apple's late identification of this prior art because there was insufficient time to take discovery and Apple did not identify fact witnesses with knowledge of the Apple Watch Series 0 in its Notice of Prior Art, EDIS Doc. ID 763304

¹ On May 31, 2022, Masimo filed a Supplement (EDIS Doc. ID 771856, "Supp."), attaching exhibits that were cited in the Motion.

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(Feb. 15, 2022). *Id.* at 5-7. Masimo further submits that Apple’s invalidity expert, Majid Sarrafzadeh, did not rely on a physical Apple Watch Series 0 and argues that he should be precluded from doing so at the hearing. *Id.* at 8.

In opposition, Apple submits that its invalidity contentions identifying the Apple Watch Series 0 were timely served in accordance with the Procedural Schedule. *Opp.* at 4-5. Apple explains that it did not identify the Apple Watch Series 0 earlier in the investigation because the invalidity contentions rely on an argument that was raised in *Markman* briefing with respect to the term “second shape.” *Id.* at 1-2. Apple submits that there has been no prejudice to Masimo because Masimo was able to depose Apple engineers involved in the Apple Watch Series 0 design. *Id.* at 5-6, 8-9. Apple argues that precluding evidence regarding the Apple Watch Series 0 would be prejudicial to Apple, because Apple relied on Masimo’s decision not to file a motion to strike Apple’s invalidity contention before agreeing to limit the number of prior art references it was asserting. *Id.* at 6-7. Apple submits that almost all of the exhibits regarding the Apple Watch Series 0 were produced before the close of fact discovery and that additional exhibits relied upon by Dr. Sarrafzadeh are publicly available documents. *Id.* at 7-9. Apple represents that Dr. Sarrafzadeh’s opinions regarding the Apple Watch Series 0 are not based on any physical exhibit but instead rely on documentation and photographs. *Id.* at 9-10.

In consideration of the parties’ arguments, the undersigned finds that Apple should not be precluded from presenting evidence of the Apple Watch Series 0 as prior art to the ’745 patent. Apple’s invalidity contentions were timely disclosed on the deadline for final contentions in accordance with the Procedural Schedule. There is no evidence that Apple delayed this contention to prevent Masimo from obtaining discovery regarding the Apple Watch Series 0—Apple states that its identification of the Apple Watch Series 0 as prior art was based on the

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position taken by Masimo in *Markman* briefing with respect to the term “second shape.” See Opp. at 1-2.² Moreover, the record shows that Masimo was able to pursue discovery regarding the Apple Watch Series 0 during the depositions of Apple witnesses Vivek Venugopal, Ueyn Block, and Brian Land after Apple’s final invalidity contentions were served. See, e.g., Opp. Exhibit B (Venugopal Dep. Tr.) at 236:15-239:19; Opp. Exhibit C (Land Dep. Tr.) at 39:15-40:19; Opp. Exhibit D (Block Dep. Tr.) at 31:1-32:7. All of the exhibits that Apple intends to rely on with respect to the Apple Watch Series 0 were produced during fact discovery, except for RX-0023, which is a public website cited by URL in one of Apple’s expert reports. See Opp. at 8.³ Apple has confirmed that Dr. Sarrafzadeh is not relying on an examination of the physical Apple Watch Series 0 for his opinions. See *id.* at 9. Accordingly, there is nothing identified in Masimo’s motion that warrants exclusion.

For the reasons discussed above, Masimo’s motion *in limine* no. 4 (1276-040) is hereby DENIED.

This order has been issued with a confidential designation. Within seven days of the date of this document, the parties shall submit a joint statement as to whether or not they seek to have any portion of this document deleted from the public version. If the parties do seek to have portions of this document deleted from the public version, they must submit a single proposed public version of this order with any proposed redactions in the manner specified by Ground Rule 1.9. To the extent possible, the proposed redacting should be made electronically, in a PDF

² Masimo argues that its claim construction position on “second shape” was disclosed earlier in discovery, Motion at 8-9, but the dispute identified by Apple with respect to the meaning of this term is not apparent from any of Masimo’s earlier disclosures. See Opp. Exhibit A (emails between counsel in February 2022 regarding claim construction).

³ Apple submits that RX-043 was cited by URL in Apple’s interrogatory responses with respect to prosecution laches, not for invalidity. Opp. at 8 n.2. Similarly, RX-431 and RX-432 were cited by URL in Apple’s non-infringement expert report. *Id.* Apple has confirmed that it will not rely on documents that were not on any exhibit list, and it has withdrawn RX-1235. *Id.* at 8 n.4.

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of the issued order, using the “Redact Tool” within Adobe Acrobat, wherein the proposed redactions are submitted as “marked” but not yet “applied.” The submission shall be made by email to Bhattacharyya337@usitc.gov and need not be filed with the Commission Secretary.

SO ORDERED.

A handwritten signature in black ink, appearing to read "Monica Bhattacharyya", is written over a horizontal line.

Monica Bhattacharyya
Administrative Law Judge