

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01520 (Patent 10,258,265 B1)
IPR2020-01536 (Patent 10,588,553 B2)
IPR2020-01537 (Patent 10,588,553 B2)
IPR2020-01538 (Patent 10,588,554 B2)
IPR2020-01539 (Patent 10,588,554 B2)

Before GEORGE R. HOSKINS, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123

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In each captioned proceeding, we entered a Decision to Institute the requested *inter partes* review. *See, e.g.*, IPR2020-01538, Paper 8.¹ On April 2, 2021, Petitioner requested authorization to file a motion to submit supplemental information in each proceeding, and we granted authorization by email.

On April 22, 2021, Petitioner filed a Motion to Submit Supplemental Information in each proceeding. *See, e.g.*, IPR2020-01538, Paper 20 (“Mot.” or “Motion”). In its Motion, Petitioner moves to submit a Declaration of Jacob Munford (“Declaration”) into the record as supplemental information, to be entered as, e.g., Exhibit 1038 in IPR2020-01538. Mot. 1. Petitioner contends that the Declaration “provides further testimony supporting the public accessibility and authenticity of the prior art references relied upon in the challenges set forth in [each] Petition,” and is offered in response to Patent Owner’s objections, which were served on Petitioner on March 16, 2021.² *Id.* at 2. Petitioner contends that its Motion

¹ In this Order, we provide citations to the record of IPR2020-01538. Similar papers appear in the record of each captioned proceeding.

² On March 16, 2021, Patent Owner entered into the record, as Paper 10, a document purporting to be “PO’s Objections to Evidence.” However, the actual document that was entered into the PTAB E2E system bears the title “Masimo Corporation Notice of Waiver of Patent Owner Preliminary Response,” and does not include objections. *See, e.g.*, IPR2020-01538, Paper 10. As it appears that Patent Owner’s Objections were properly served on Petitioner, *see* Mot. 2 (“On March 16, 2021 . . . Patent Owner served Petitioner with objections to evidence.”), Patent Owner is authorized to file a Motion for Late Entry to perfect entry of the objections into the record of each proceeding. *See infra* at 3 (“ORDER”); 37 C.F.R. §§ 42.5, 42.64(b)(1).

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meets the requirements for submission of supplemental information as set forth in 37 C.F.R. § 42.123(a) because the Motion is timely and the Declaration is relevant to a claim for which trial has been instituted. *Id.* at 3–4. Petitioner represents that Patent Owner does not oppose the Motion. *Id.* at 1.

As the Motion is unopposed and otherwise satisfies the requirements of § 42.123(a), we *grant* Petitioner’s Motion.³

ORDER

Accordingly, it is:

ORDERED that Petitioner’s Motion to Submit Supplemental Information is *granted* in each proceeding; and

FURTHER ORDERED that Patent Owner is authorized to file a Motion for Late Entry of Objections in each proceeding, within ten (10) business days of this Order, wherein the Motion must indicate whether it is opposed by Petitioner.

³ The Declaration responds to Patent Owner’s evidentiary objections and was served on Patent Owner in accordance with 37 C.F.R. § 42.64. Mot. 2. As such, the Declaration is supplemental evidence governed by 37 C.F.R. § 42.64(b)(2). *See id.* (“Petitioner served Patent Owner with supplemental evidence including [the Declaration].”). Because the parties agree to entry of the Declaration as supplemental information, governed by 37 C.F.R. § 42.123(a), we grant Petitioner’s Motion, regardless of the fact that the Declaration could instead be entered with Petitioner’s opposition to a motion to exclude, in the event such a motion is filed by Patent Owner. *See* 37 C.F.R. § 42.5.

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