

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-01521 (Patent 10,292,628)
IPR2020-01523 (Patent 8,457,703)
IPR2020-01524 (Patent 10,433,776)
IPR2020-01526 (Patent 6,771,994)
IPR2020-01714 (Patent 10,631,765)
IPR2020-01715 (Patent 10,631,765)

Before JOSIAH C. COCKS, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

ORDER
Setting Oral Argument
37 C.F.R. § 42.70

IPR2020-01521 (Patent 10,292,628); IPR2020-01523 (Patent 8,457,703)
IPR2020-01524 (Patent 10,433,776); IPR2020-01526 (Patent 6,771,994)
IPR2020-01714 (Patent 10,631,765); IPR2020-01715 (Patent 10,631,765)

ORAL ARGUMENT

Time and Format

The Board has considered Petitioner’s and Patent Owner’s requests for oral argument.¹ Taking into consideration these requests, and the time constraints for oral hearings on this day, the oral arguments will commence **at 10:00 am Eastern Time on January 19, 2022, by videoconference.**² USPTO facilities remain closed to the public due to the state of affairs relating to COVID-19. The Board will provide a court reporter for the hearings, and the reporter’s transcripts will constitute the official record of the hearing for each proceeding.

Petitioner has generally requested no more than one hour per side for oral argument time for each proceeding. Patent Owner’s requests suggest that three groupings of the six cases would be appropriate – combining IPR1521, IPR1714, and IPR1715 in one group, and IPR1523 and IPR1524 into a second group. Both parties agreed that IPR1526 should be heard separately. Petitioner was strongly opposed to arguing IPR1523 and IPR1524 together. Petitioner was hesitant to argue IPR1521, IPR1714, and

¹ IPR2020-01521 (“IPR1521”) (Papers 24 and 23); IPR2020-01523 (“IPR1523”) (Papers 21 and 22); IPR2020-01524 (“IPR1524”) (Papers 21 and 22); IPR2020-01526 (“IPR1526”) (Papers 18 and 20); IPR2020-01714 (“IPR1714”) (Papers 23 and 24); IPR2020-01715 (“IPR1715”) (Papers 23 and 24). On December 16, 2021, counsel for each party, and Judges Cocks, Wieker, and Kinder, also conducted a conference call to further discuss grouping of arguments and timing.

² If there are any concerns about disclosing confidential information, the parties must contact the Board at Trials@uspto.gov at least ten (10) business days before the hearing date.

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IPR1715 together, but did concede that there was overlap in these three proceedings.

Upon considering these requests, we grant oral argument according to the following schedule and groupings of proceedings to be argued together.

Proceeding(s)	Time Per Side	Start Time
IPR2020-01521 IPR2020-01714 IPR2020-01715	60 minutes	10:00 AM ET
IPR2020-01523	40 minutes	30 minutes after conclusion of prior argument
IPR2020-01524	40 minutes	5 minutes after conclusion of prior argument
IPR2020-01526	40 minutes	15 minutes after conclusion of prior argument

The first three proceedings (IPR2020-01521, IPR2020-01714, and IPR2020-01715) will be argued together and share a single transcript. Given the overlap in these first three proceedings, statements made during this first hearing are applicable to each of the three proceedings, unless it is explicitly noted that a statement applies to a specific proceeding only.

The remaining proceedings will be argued separately and each will have its own transcript. As a reminder, even if an argument was made during the hearing for a prior proceeding, the argument must also be made and put on record to be considered during the hearing for a later proceeding.

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For each respective hearing, Petitioner will open the hearing by presenting its case for unpatentability of the challenged patent(s). Thereafter, Patent Owner will respond to Petitioner's argument. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner. In accordance with the Consolidated Trial Practice Guide³ ("CTPG"), issued in November 2019, Patent Owner may request to reserve time for a brief sur-rebuttal. *See* CTPG 83.

The parties may request a pre-hearing conference in advance of the hearing. *See id.* at 82. "The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties." *Id.* If either party desires a pre-hearing conference, the parties should jointly contact the Board at Trials@uspto.gov at least seven (7) business days before the hearing date to request a conference call for that purpose. If no response is received within two (2) days from the Board, the party requesting the conference should call the Board directly to ensure the request is being processed.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstratives shall be served on opposing counsel at least seven (7) business days before the hearing date and filed on or before Friday, January 14, 2022.⁴

Demonstratives are not a mechanism for making new arguments. Demonstratives are also not evidence, and will not be relied upon as evidence. Rather, demonstratives are visual aids to a party's oral presentation regarding arguments and evidence previously presented and discussed in the papers. Accordingly, demonstratives shall be clearly marked with the words "DEMONSTRATIVE EXHIBIT – NOT EVIDENCE" in the footer. *See Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (holding that the Board is obligated under its own regulations to dismiss untimely argument "raised for the first time during oral argument"). "[N]o new evidence may be presented at the oral argument." CTPG 85–86; *see also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that "new" evidence includes evidence already of record but not previously discussed in any paper of record).

Furthermore, because of the strict prohibition against the presentation of new evidence or arguments at a hearing, it is strongly recommended that each demonstrative includes a citation to a paper in the record, which allows the Board to easily ascertain whether a given demonstrative contains "new"

⁴ The parties may stipulate to an alternative schedule for serving and filing demonstratives, and request the Board to modify the schedule for filing demonstratives, at least seven (7) business days before the hearing date.

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