

From: [Trials](#)
To: [Rick Bisenius](#); [Trials](#)
Cc: [IPR50095-0134IP1](#); [IPR50095-0134IP2](#); [IPR50095-0133IP1](#); [IPR50095-0133IP2](#); [AppleIPR159-1](#); [AppleIPR159-2](#); [AppleIPR743-1@knobbe.com](#); [AppleIPR743-2@knobbe.com](#); [Daniel Kiang](#)
Subject: RE: IPR2024-00241, -00242, -00243, -00244 - Request for Leave to File Motions to Correct and Corrected Petitions
Date: Monday, March 18, 2024 10:48:26 AM

Counsel,

From the Board –

Petitioner's request for leave under 37 CFR § 42.104(c) to file motions to correct inadvertent clerical errors in its Petitions and Notices Ranking Petitions is denied. We do not expect briefing on this issue to be helpful because the statements listed below go beyond the type of corrections contemplated by 37 CFR § 42.104. In addition, we do not expect any of the below-listed statements to have a material impact on our decision whether to institute review. That said, we note Petitioner's attempt to correct its Petitions and Notice Ranking Petitions.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Rick Bisenius <bisenius@fr.com>
Sent: Wednesday, March 13, 2024 5:44 PM
To: Trials <Trials@USPTO.GOV>
Cc: IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>; IPR50095-0134IP2 <IPR50095-0134IP2@fr.com>; IPR50095-0133IP1 <IPR50095-0133IP1@fr.com>; IPR50095-0133IP2 <IPR50095-0133IP2@fr.com>; AppleIPR159-1 <AppleIPR159-1@knobbe.com>; AppleIPR159-2 <AppleIPR159-2@knobbe.com>; AppleIPR743-1@knobbe.com; AppleIPR743-2@knobbe.com; Daniel Kiang <Daniel.Kiang@knobbe.com>
Subject: IPR2024-00241, -00242, -00243, -00244 - Request for Leave to File Motions to Correct and Corrected Petitions

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Honorable Board,

Petitioner respectfully requests leave under 37 CFR § 42.104(c) to file motions to correct inadvertent clerical errors within petitions and notices ranking petitions identified by the subject of this email, and to submit a corrected petition accompanying the respective motion in each proceeding. The

parties have conferred, and Patent Owner indicates that it opposes this request, stating “Masimo will oppose the request at least because these are not clerical errors that can be corrected via a § 42.104(c) motion.”

Specifically, Petitioner proposes to strike the following clauses from the respective petition and notice ranking petitions in each proceeding. These clauses incorrectly indicate that the ’743 patent and ’159 patent, respectively, issued after IPRs were filed on a parent patent in IPR2020-01722 and -01723 due to a clerical error in the date for these earlier petitions being propagated throughout drafts of Apple’s petitions.

- IPR2024-00241
 - Corrections to Petition
 - Strike: “Although the face of the ’743 Patent lists hundreds of other references cited by Masimo, Masimo failed to cite Sarantos and Utter references applied in this Petition to the examiner, despite being in possession of Apple’s earlier IPR petitions challenging claims of the related ’695 Patent based on those same references. See, generally, IPR2020-01722, -01723.” (Petition, p. 85)
 - Corrections to Notice Ranking Petitions
 - Strike: “, and approximately six months after Apple filed the IPRs leading to the Board’s findings of unpatentability with respect to the related ’695 Patent” (Notice Ranking Petitions, p. 4)
 - Strike: “Further, Apple’s presentation of two petitions in no way constitutes an “abuse”, and instead results from Masimo’s practice of forging forward, despite earlier IPR results, with prosecution of claims directed toward unpatentable subject matter, with the apparent aim of assertion.” (Notice Ranking Petitions, p. 5)
- IPR2024-00242
 - Corrections to Petition
 - Strike: “Although the face of the ’743 Patent lists hundreds of other references cited by Masimo, Masimo failed to cite the Sarantos, Shie, and Utter references applied in this Petition to the examiner, despite being in possession of Apple’s earlier IPR petitions challenging claims of the related ’695 Patent based on those same references. See, generally, IPR2020-01722, -01723.” (Petition, p. 76)
 - Corrections to Notice Ranking Petitions
 - Strike: “, and approximately six months after Apple filed the IPRs leading to the Board’s findings of unpatentability with respect to the related ’695 Patent” (Notice Ranking Petitions, p. 4)
 - Strike: “Further, Apple’s presentation of two petitions in no way constitutes an “abuse”, and instead results from Masimo’s practice of forging forward, despite earlier IPR results, with prosecution of claims directed toward unpatentable subject matter, with the apparent aim of assertion.” (Notice Ranking Petitions, p. 5)
- IPR2024-00243
 - Corrections to Petition
 - Strike: “, and approximately six months after Apple filed IPRs challenging claims

of genealogically related U.S. Patent No. 10,470,695 (“’695 Patent”).” (Petition, p. 3)

- Strike: “, notably omitting any discussion of art applied in Apple’s IPRs, including art (e.g., Sarantos) on which the present Petition’s grounds are premised. APPLE-1002, 44-52. Without bringing this omission to the attention of the examiner, Masimo paid the issue fee on April 21, 2020, over two months before it was due, in an apparent attempt to achieve issuance prior to the institution decision of the ’695 IPRs and allowed the patent to grant on July 28, 2020. Id., 35-37, 9” (Petition, p. 3)
- Strike: “Notably, on May 12, 2021, the Board endorsed the relevance of this prior art, finding a reasonable likelihood of unpatentability to exist. Still, Masimo said nothing.” (Petition, p. 3)
- Strike: “*See, generally*, IPR2020-01722, -01723. The ’963 Application claimed priority to the application from which the ’695 Patent issued (16/226,249), and incorporated that application by reference. APPLE-1001, 1:4-20” (Petition, p. 3 (note 1))
- Strike: “And, on May 5, 2022, the Board rendered its final written decision finding unpatentable every challenged claim of the ’695 Patent based on art applied in Apple’s IPRs. Apple Inc. v. Masimo Corp., IPR2020-01722 Pap. 29, 2 (PTAB May 5, 2022). The ’159 Patent’s file history is without any indication that Masimo brought the prior art applied in this Petition to the examiner’s attention prior to allowance or grant of claims in the ’963 Application. Rather, content with allowance,” (Petition, pp. 3-4)
- Strike: “Masimo failed to cite the Sarantos reference applied in this Petition to the examiner, despite being in possession of Apple’s earlier IPR petitions challenging claims of the related ’695 Patent based on Sarantos. *See, generally*, IPR2020-01722, -01723.” (Petition, pp. 87-88)

- Corrections to Notice Ranking Petitions

- Strike: “, and approximately six months after Apple filed the IPRs leading to the Board’s findings of unpatentability with respect to the related ’695 Patent.” (Notice Ranking Petitions, p. 4)
- Strike: “Further, Apple’s presentation of two petitions is not abusive, and instead results from Masimo’s practice of forging forward, despite earlier IPR results, with prosecution of claims directed to unpatentable subject matter, with the apparent aim of assertion.” (Notice Ranking Petitions, p. 5)

- IPR2024-00244

- Corrections to Petition

- Strike: “, and approximately six months after Apple filed IPRs challenging claims of genealogically related U.S. Patent No. 10,470,695 (“’695 Patent”).” (Petition, p. 3)
- Strike: “, notably omitting any discussion of art applied in Apple’s IPRs, including art (e.g., Sarantos) on which the present Petition’s grounds are premised. APPLE-1002, 44-52. Without bringing this omission to the attention of the examiner, Masimo paid the issue fee on April 21, 2020, over two months before it was due, in an apparent attempt to achieve issuance prior to the institution decision of

the '695 IPRs and allowed the patent to grant on July 28, 2020. Id., 35-37, 9" (Petition, p. 3)

- Strike: "See, generally, IPR2020-01722, -01723. The '963 Application claimed priority to the application from which the '695 Patent issued (16/226,249), and incorporated that application by reference. APPLE-1001, 1:4-20" (Petition, p. 3 (note 2))
- Strike: "Notably, on May 12, 2021, the Board endorsed the relevance of this prior art, finding a reasonable likelihood of unpatentability to exist. Still, Masimo said nothing." (Petition, p. 4)
- Strike: "And, on May 5, 2022, the Board rendered its final written decision finding unpatentable every challenged claim of the '695 Patent based on art applied in Apple's IPRs. Apple Inc. v. Masimo Corp., IPR2020-01722 Pap. 29, 2 (PTAB May 5, 2022)." (Petition, p. 4)
- Strike: "The '159 Patent's file history is without any indication that Masimo brought the prior art applied in this Petition to the examiner's attention prior to allowance or grant of claims in the '963 Application. Rather, content with allowance," (Petition, p. 4)
- Strike: "Masimo failed to cite the Sarantos reference applied in this Petition to the examiner, despite being in possession of Apple's earlier IPR petitions challenging claims of the related '695 Patent based on Sarantos. See, generally, IPR2020-01722, -01723." (Petition, pp. 83-84)
- Corrections to Notice Ranking Petitions
 - Strike: ", and approximately six months after Apple filed the IPRs leading to the Board's findings of unpatentability with respect to the related '695 Patent." (Notice Ranking Petitions, p. 4)
 - Strike: "Further, Apple's presentation of two petitions is not abusive, and instead results from Masimo's practice of forging forward, despite earlier IPR results, with prosecution of claims directed to unpatentable subject matter, with the apparent aim of assertion." (Notice Ranking Petitions, p. 5)

To the extent the Board would like to discuss the request on a call, the parties are available at the following times:

- Friday, March 15th between 10am-1pm PT (1pm-4pm ET)
- Monday, March 18th between 10am-1pm PT (1pm-4pm ET)

Respectfully submitted,
Patrick J. Bisenius

Counsel for Petitioner

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Admitted to practice in Minnesota, Illinois, and before the USPTO

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