Subject: RE: IPR2024-00243, -00244 |
Date: Wednesday, March 13, 2024 at 1:26:28 PM Pacific Daylight Time
From: Daniel Kiang
To: Rick Bisenius, Andrew Patrick, IPR50095-0134IP1, IPR50095-0134IP2
CC: AppleIPR159-1, AppleIPR159-2
Attachments: image001.png

Counsel,

Based on our review of the documents, it does not appear that the false statements were the result of "inadvertently copy-pasted" language from an "originally-filed version of a petition challenging the '745 Patent." The statements we identified are not identical to the statements in any prior IPR against the '745 Patent. Rather, for example, as following comparison shows the statements were at least edited to address the '159 Patent:

Masimo filed the application that issued as the '159 Patent (16/791,963) ("'963 Application") with a request for accelerated examination on February 14, 2020, a little over one month after Masimo initiated its serial litigation campaign against Apple through its January 9, 2020 complaint in the U.S. District Court for the Central District of California (CDCA) (Case No. 8:20-cv-00048), and approximately six months ***after*** Apple filed IPRs challenging claims of genealogically related U.S. Patent No. 10,470,695 ("'695 Patent"). IPR2024-00243 Pet. at 2-3.	Masimo filed the application that issued as the '745 Patent (16/835,772) ("'772 Application") with a request for accelerated examination on March 30, 2020, approximately three months after Masimo initiated its serial litigation campaign against Apple through its January 9, 2020 complaint in the U.S. District Court for the Central District of California (CDCA) (Case No. 8:20-cv-00048), and approximately seven months after Apple filed IPRs challenging claims of related U.S. Patent No. 10,470,695 ("'695 Patent"). IPR2022-01291 Pet. at 3.
Masimo failed to cite the Sarantos 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. IPR2024-00243 Pet. at 87.	Although the face of the '745 Patent lists hundreds of other references cited by Masimo, Masimo failed to cite either the Sarantos or Venkatraman 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. IPR2022-01465 Pet. at 77.

Moreover, as shown above, emphasis such as ***bold italics*** was added to emphasize the false suggestion that the '159 Patent was filed "***after***" Apple filed IPRs against the '695 Patent. No previous IPR petition against the '745 Patent used such emphasis. These revisions do not indicate the mere copy-and-paste of previous statements.

MASIMO 2031
Apple v. Masimo
IPR2024-00242

Moreover, the ’159 Patent petitions contain additional false statements that are ***not*** from any previous IPR petition against the ’159 Patent. For example, the ’243 Petition contains the following newly-added false statements:

- “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.” 243 Pet. at 3.
- “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.” 243 Pet. at 3.

Apple’s Notices Ranking Petitions also contain new false statements that were not in any previous Notices Ranking Petitions filed with the ’745 Patent IPRs:

- “Far from representing a burden, institution of both petitions would allow the Board to efficiently address issues of invalidity arising from Masimo’s collateral prosecution of the application that issued as the ’159 Patent, which Masimo filed with a request for accelerated examination slightly more than one month after Masimo initiated its serial litigation campaign against Apple, and approximately six months after Apple filed the IPRs leading to the Board’s findings of unpatentability with respect to the related ’695 Patent.” IPR2024-00243, Paper 3 at 4.

Thus, your explanation does not appear to address the scope of the false statements. For at least these reasons, Masimo does not believe that these false statements are “clerical” errors that can be corrected by a § 42.104(c) motion.

Finally, your email states that “Apple’s IPR counsel preemptively reached out to Masimo to propose corrections to petitions challenging Masimo’s related ’745 Patent.” However, Apple’s counsel did ***not*** originally identify the false statements or propose removing them. Rather, Apple’s original proposed correction sought to change the identification of prior art that Apple falsely suggested that Masimo withheld from the examiner. Apple’s originally-proposed correction is shown below.

Although the face of the ’745 Patent lists hundreds of other references cited by Masimo, Masimo failed to cite the ~~Ackermans,~~ Sarantos or Venkatraman~~, and Mendelson-799~~ 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. Indeed, there is no indication in the ’745 Patent’s file history that the examiner was even aware of, let alone substantively considered, ~~any of the prior art applied in this Petition~~ Sarantos, Venkatraman, or Shie prior to allowing the ’772 Application. *See*, *generally*, APPLE-1002. A related Iwamiya publication (U.S. Pub. 2011/0004106) is cited on the face of the ’745 Patent, but was not relied on by the Examiner.~~The Ackermans, Venkatraman, Mendelson-799, Savant, and Haar references applied in this Petition are new, noncumulative prior art.~~

Only after Masimo explained that these statements were false did Apple seek to file corrected petitions. Masimo’s previous non-opposition to correct those statements, however, does not indicate that Masimo would consent to Apple making the same type of statements in future petitions after being notified of the issue. Thus, Masimo opposes Apple’s proposed motion.

In the email to the Board, please insert Masimo's position as follows: "Masimo will oppose the request at least because these are not clerical errors that can be corrected via a § 42.104(c) motion."

We are available for a teleconference with the Board this Friday between 10am-1pm PT (1pm-4pm ET) or this coming Monday at the same times.

Regards,
Daniel

Daniel Kiang
Partner
949-721-5205 **Direct**
Knobbe Martens

From: Rick Bisenius <bisenius@fr.com>
Sent: Wednesday, March 13, 2024 12:29 PM
To: Andrew Patrick <patrick@fr.com>; Daniel Kiang <Daniel.Kiang@knobbe.com>; IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>; IPR50095-0134IP2 <IPR50095-0134IP2@fr.com>
Cc: AppleIPR159-1 <AppleIPR159-1@knobbe.com>; AppleIPR159-2 <AppleIPR159-2@knobbe.com>
Subject: RE: IPR2024-00243, -00244 |

Hello Daniel,

We still have not received a response from this correspondence on Sunday evening. To reiterate, we intend to bring these issues to the Board's attention with our request for leave to correct. Please let us know if Masimo still intends to oppose a request for leave to file motions to correct under § 42.104(c). On the other hand, if you would prefer to work together to address these issues, please let us know. To assist in your determination of whether you wish to oppose or not, I have attached a proposed email to the board identifying each of the corrections we intend to make throughout the various papers.

Either way, please also let us know your availability for a potential call with the Board this week or next, if desired by the Board.

Taker Care,
Rick

Rick Bisenius :: Principal :: Fish & Richardson P.C.
Direct: 612 766 2048 :: Mobile: 608 358 5857 :: bisenius@fr.com

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From: Andrew Patrick <patrick@fr.com>
Sent: Sunday, March 10, 2024 8:19 PM

MASIMO 2031
Apple v. Masimo
IPR2024-00242

To: Daniel Kiang <Daniel.Kiang@knobbe.com>; IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>; IPR50095-0134IP2 <IPR50095-0134IP2@fr.com>
Cc: AppleIPR159-1 <AppleIPR159-1@knobbe.com>; AppleIPR159-2 <AppleIPR159-2@knobbe.com>
Subject: RE: IPR2024-00243, -00244 |

Daniel,

Regarding your requests for additional explanation, it may be helpful to recall that Apple's IPR counsel preemptively reached out to Masimo to propose corrections to petitions challenging Masimo's related '745 Patent, and that during the related meet-and-confer process you signaled Masimo's non-opposition to Apple's request for leave to file motions to correct those petitions under 37 C.F.R. § 42.104(c).

The statements that you identified in your Wednesday email similarly appear to have resulted from a clerical mistake with respect to the date on which Masimo must have been aware of the applied prior art. Further, those statements include language that appears to have been inadvertently copy-pasted from an originally-filed version of a petition challenging the '745 Patent, again confirming the clerical nature of the mistakes. And, with respect to the '745 Patent petitions, the Board granted leave to file corrected petitions striking similar erroneous statements, and in doing so described those statements as "clerical errors." *See Apple Inc. v. Masimo Corp.*, IPR2022-01291 Ex. 3001 (PTAB Oct. 4, 2022). For at least these reasons, we believe that the identified statements are clerical mistakes appropriate for correction under § 42.104(c).

We again apologize for these unintentional clerical mistakes, and we plan to bring them to the Board's attention with a request for leave to file motions to correct the mistakes under § 42.104(c). Toward that end, we hope that this email provides you with the information that you need to assess that request, and we further invite your review of the corrections that we intend to make.

If Masimo still intends to oppose a request for leave to file motions to correct under § 42.104(c), please let us know. On the other hand, if you would prefer to work together to address these issues, please let us know. Either way, please also let us know your availability for a potential call with the Board this week or next, if desired by the Board.

If it would be helpful to meet and confer by phone, we remain available this Tuesday and Wednesday, and we are also available Thursday.

With best,
Andrew

From: Daniel Kiang <Daniel.Kiang@knobbe.com>
Sent: Thursday, March 07, 2024 6:38 PM
To: Andrew Patrick <patrick@fr.com>; IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>; IPR50095-0134IP2 <IPR50095-0134IP2@fr.com>
Cc: AppleIPR159-1 <AppleIPR159-1@knobbe.com>; AppleIPR159-2 <AppleIPR159-2@knobbe.com>
Subject: RE: IPR2024-00243, -00244 | False Representations of Fact in IPR Petitions

Counsel,

MASIMO 2031
Apple v. Masimo
IPR2024-00242

Please further explain why Apple believes these statements are the type of "clerical or typographical mistake" contemplated by 37 C.F.R. § 42.104(c). Please also explain what Apple means by "inadvertent replication of language from an earlier uncorrected petition."

It appears to Masimo that Apple relies on such statements to make substantive arguments in multiple documents and in multiple petitions. In the absence of further information, Masimo opposes such a motion to strike under 37 C.F.R. § 42.104(c).

Regards,
Daniel

Daniel Kiang
Partner
949-721-5205 **Direct**
Knobbe Martens

From: Andrew Patrick <patrick@fr.com>
Sent: Thursday, March 7, 2024 8:35 AM
To: Daniel Kiang <Daniel.Kiang@knobbe.com>; IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>; IPR50095-0134IP2 <IPR50095-0134IP2@fr.com>
Cc: AppleIPR159-1 <AppleIPR159-1@knobbe.com>; AppleIPR159-2 <AppleIPR159-2@knobbe.com>
Subject: RE: IPR2024-00243, -00244

Daniel,

Thank you for your email identifying unintentional clerical mistakes, apparently involving inadvertent replication of language from an earlier uncorrected petition challenging the related '745 Patent. We apologize for the oversight.

We will investigate further and develop a list of statements requiring correction for Patent Owner's review, in anticipation of a request from Petitioner to the Board for leave to strike those statements from the implicated papers pursuant to 37 CFR § 42.104(c).

We will provide that list within days, to facilitate mutual review and speedy correction of these unintentional clerical mistakes. Toward that end, please let us know if you plan to oppose a request for leave to correct, and if it would be helpful to discuss. If desired, we anticipate being available to meet and confer Monday, Tuesday, and Wednesday.

With best,
Andrew

MASIMO 2031
Apple v. Masimo
IPR2024-00242

From: Daniel Kiang <Daniel.Kiang@knobbe.com>
Sent: Wednesday, March 06, 2024 2:40 PM
To: IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>; IPR50095-0134IP2 <IPR50095-0134IP2@fr.com>
Cc: AppleIPR159-1 <AppleIPR159-1@knobbe.com>; AppleIPR159-2 <AppleIPR159-2@knobbe.com>
Subject: IPR2024-00243, -00244 | False Representations of Fact in IPR Petitions

[This email originated outside of F&R.]

Counsel,

I write regarding IPR2024-00243 and IPR2024-00244 challenging the '159 Patent. These petitions included misrepresentations regarding Masimo's prosecution of the '159 Patent that Apple's counsel knew were false. Specifically, the '243 Petition states:

- "Masimo filed the application that issued as the '159 Patent (16/791,963) … approximately six months ***after*** Apple filed IPRs challenging claims of genealogically related U.S. Patent No. 10,470,695 ("'695 Patent")." '243 Pet. at 3.
- "Just 7 weeks later, on April 2, 2020, a Notice of allowance was issued, 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. … 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. 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." '243 Pet. at 3.
- "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." '243 Pet. at 4.
- "Masimo failed to cite the Sarantos 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." '243 Pet. at 87.

On behalf of Apple, you included similar false statements in the IPR2022-01291, -01292, -01465, and -01466 petitions regarding the related '745 Patent. We previously informed you that Apple's IPRs against the '695 Patent were filed on October 2, 2020, whereas the '745 Patent was filed in March 2020 and issued in June 2020. Thus, in IPR2022-01291, -01292, -01465, and -01466, you withdrew those false statements. Likewise, the '159 Patent was filed on February 14, 2020 and issued on July 28, 2020, months before the '695 Patent IPRs.

Apple's decision to repeat these false statements in the '243 Petition is perplexing. The '244 Petition also contains similar misrepresentations. *See* '244 Pet. at 3-4, 83. Apple's Notices Ranking Petitions also repeat and rely on these false representations. *See, e.g.,* Petitioner's Notice Ranking and Explaining Material Differences (IPR2024-00243) at 4-5. Masimo reserves the right to seek all available relief for these repeated false statements in several petitions. Please explain how Apple intends to address its intentional and repeated submission to the USPTO of false information.

MASIMO 2031
Apple v. Masimo
IPR2024-00242

Regards,
Daniel

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MASIMO 2031
Apple v. Masimo
IPR2024-00242