

Filed: January 2, 2024

Filed on behalf of:

Patent Owner Masimo Corporation
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2024-00243
U.S. Patent 10,722,159

**PATENT OWNER SUBMISSION OF MANDATORY NOTICE
INFORMATION PURSUANT TO 37 C.F.R. § 42.8(a)**

Pursuant to 37 C.F.R. § 42.8, Patent Owner Masimo Corporation hereby submits the following mandatory notice information.

I. Real Party in Interest Pursuant to 37 C.F.R. § 42.8(b)(1)

The real party in interest is Masimo Corporation.

II. Related Matters Pursuant to 37 C.F.R. § 42.8(b)(2)

The matters listed below might affect, or be affected by, a decision in this proceeding pursuant to 37 C.F.R. § 42.8(b)(2).

A. Litigation Involving the Patent-at-Issue

U.S. Patent No. 10,722,159 (“the ’159 Patent”) has been asserted in the following lawsuit: *Apple Inc. v. Masimo Corporation et al.*, Civil Action No. 1:22-cv-01378-MN-JLH, pending in the District of Delaware.

B. Patents and Patent Applications Claiming Priority to the Patent-at-Issue

At least the following patents and applications claim priority to, or share a priority claim with, the ’159 Patent:

Country Code (or Jurisdiction)	Patent No.	Application No.
US	10,448,871	15/195199
US	10,470,695	16/226249
US	10,638,961	16/532061
US	10,646,146	16/532065
US	10,687,743	16/791955
US	10,687,744	16/835712
US	10,687,745	16/835772
US	Pending	16/871874

C. Related Proceedings Before the Board

Patent Owner also identifies the following additional *inter partes* review proceedings related to patents asserted by Patent Owner in the above-referenced district court litigation:

Petitioner	Case Number	Patent Number
Apple Inc.	IPR2024-00290	8,190,223
Apple Inc.	IPR2024-00296	10,984,911
Apple Inc.	IPR2024-00244	10,722,159
Apple Inc.	IPR2024-00293	10,736,507
Apple Inc.	IPR2024-00294	10,736,507
Apple Inc.	IPR2024-00241	10,687,743
Apple Inc.	IPR2024-00242	10,687,743

III. Lead and Back-Up Counsel Pursuant to 37 C.F.R. § 42.8(b)(3)

Patent Owner hereby designates its lead and backup counsel as follows:

Lead Counsel	Back-up Counsel
Brian C. Claassen (Reg. No. 63,051) Knobbe, Martens, Olson, & Bear, LLP 2bcc@knobbe.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502	Carol Pitzel Cruz (Reg. No. 61,224) Knobbe, Martens, Olson, & Bear, LLP 2cmp@knobbe.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502
Back-up Counsel	Back-up Counsel
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IV. Service Information Pursuant to 37 C.F.R. § 42.8(b)(4)

Please address all correspondence to lead counsel at the address shown above.

Patent Owner also consents to electronic service by email to:

AppleIPR159-1@knobbe.com.

IPR2024-00243

Apple Inc. v. Masimo Corporation

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 2, 2024

/ Brian C. Claassen /

Brian C. Claassen (Reg. No. 63,051)

Customer No. 64,735

Attorney for Patent Owner

Masimo Corporation

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER SUBMISSION OF MANDATORY NOTICE INFORMATION PURSUANT TO 37 C.F.R. § 42.8(a)** is being served electronically on January 2, 2024, to the e-mail addresses shown below:

W. Karl Renner, Reg. No. 41,265 Fish & Richardson P.C. 60 South Sixth Street Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 Email: IPR50095-0134IP1@fr.com	Patrick J. Bisenius, Reg. No. 63,893 Andrew B. Patrick, Reg. No. 63,471 Usman A. Khan, Reg. No. 70,439 Nicholas Stephens, Reg. No. 74,320 Fish & Richardson P.C. 60 South Sixth Street Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 IPR50095-0134IP1@fr.com
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Dated: January 2, 2024

/ Brian C. Claassen /

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Attorney for Patent Owner
Masimo Corporation