

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

MASIMO CORPORATION,
Patent Owner

Case IPR2024-00243
Patent 10,722,159

MOTION TO SEAL UNDER 37 CFR § 42.74(c)

UPDATED EXHIBIT LIST

APPLE-1001	U.S. Patent No. 10,722,159 to Al-Ali (“the ’159 patent”)
APPLE-1002	Prosecution History of the ’159 patent (Application No. 16/791,963)
APPLE-1003	Declaration of Dr. Brian Anthony
APPLE-1004	U.S. Patent No. 8,670,819 to Iwamiya
APPLE-1005	U.S. Patent No. 9,392,946 to Sarantos
APPLE-1006	U.S. Patent No. 8,446,275 to Utter
APPLE-1007	RESERVED
APPLE-1008	U.S. Patent Pub. No. 2016/0058312 (“Han”)
APPLE-1009	Design of Pulse Oximeters, J.G. Webster; Institution of Physics Publishing, 1997 (“Webster”)
APPLE-1010	U.S. Patent No. 10,470,695 (the “’695 patent”)
APPLE-1011	<i>Apple v. Masimo</i> , Case No. IPR2020-01722, Paper 29 (Final Written Decision) (PTAB May 5, 2022) (the “’695 FWD”)
APPLE-1012	<i>Masimo Corporation, et al. v. Apple Inc.</i> , Redacted Complaint, ITC Inv. No. 337-TA-1276
APPLE-1013	RESERVED
APPLE-1014	Pang et al., A Neo-Reflective Wrist Pulse Oximeter, IEEE Access, Volume 2 (January 12, 2015)
APPLE-1015	Li et al., A Wireless Reflectance Pulse Oximeter With Digital Baseline Control for Unfiltered Photoplethysmograms, IEEE Transactions on Biomedical Circuits and Systems, Vol. 6, No. 3 (June 2012)

- APPLE-1016 Cai et al., Implementation of a Wireless Pulse Oximeter Based on Wrist Band Sensor, 3rd International Conference on Biomedical Engineering and Informatics (BMEI 2010)
- APPLE-1017 International Publication No. WO 2001/17421 to Lindberg et al.
- APPLE-1018 Maattala et al., Optimum Place for Measuring Pulse Oximeter Signal in Wireless Sensor-Belt or Wrist-Band, 2007 International Conference on Convergence Information Technology
- APPLE-1019 U.S. Patent No. 5,663,264 to Kawai
- APPLE-1020 U.S. Patent No. 5,449,731 to Suzuki
- APPLE-1021 U.S. Patent No. 4,149,776 to Everett
- APPLE-1022 U.S. Patent No. 5,171,085 to Jaksich
- APPLE-1023 Definition of “resin” from Chambers Dictionary of Science and Technology, Chambers Harrap Publishers Ltd. (2007)
- APPLE-1024 Definition of “resin” from Concise Encyclopedia of Science & Technology, Sixth Edition, McGraw Hill (2009)
- APPLE-1025 Definition of “resin” from A Dictionary of Chemistry, Sixth Edition, Oxford University Press (2008)
- APPLE-1026 Definition of “resin” from Longman Dictionary of American English, Fifth Edition, Pearson Education Ltd. (2014)
- APPLE-1027 Definition of “resin” from Dictionary of Science and Technology, Second Edition, A&C Black Publishers Ltd. (2007)
- APPLE-1028 U.S. Patent Pub. No. 2006/0253010 (“Brady”)

- APPLE-1029 Excerpt of The American Heritage Dictionary of the English Language, Fifth Edition, Houghton Mifflin Harcourt Publishing Company (2011)
- APPLE-1030 Excerpt of Collins Dictionary, HarperCollins Publishers (2010)
- APPLE-1031 Excerpt of Merriam-Webster's Collegiate Dictionary, Eleventh Edition, Merriam-Webster, Incorporated (2014)
- APPLE-1032 U.S. Patent No. 6,580,086 to Schulz
- APPLE-1033 U.S. Patent No. 6,801,799 to Mendelson
- APPLE-1034 Mendelson et al., A Wearable Reflectance Pulse Oximeter for Remote Physiological Monitoring, Proceedings of the 28th IEEE EMBS Annual International Conference (Sept. 3, 2006)
- APPLE-1035 U.S. Patent Pub. No. 2013/0267854 ("Johnson")
- APPLE-1036 U.S. Patent Pub. No. 2005/0116820 ("Goldreich")
- APPLE-1037 U.S. Patent No. 5,164,858 to Aguilera
- APPLE-1038 U.S. Patent No. 5,830,137 to Scharf
- APPLE-1039 U.S. Patent Pub. No. 2005/0267346 ("Faber")
- APPLE-1040 ITC Inv. No. 337-TA-1276 Exhibit RX-0508 (Jianchu Yao and Steve Warren, Stimulating Student Learning with a Novel "In-House" Pulse Oximeter Design (2005))
- APPLE-1041 U.S. Patent Pub. No. 2014/0323829 ("LeBoeuf")
- APPLE-1042 Fontaine et al., Reflectance-Based Pulse Oximeter for the Chest and Wrist, Worcester Polytechnic Institute (April 2013) *available at* <https://digital.wpi.edu/show/6969z2326>

- APPLE-1043 U.S. Patent No. 7,468,036 to Rulkov
- APPLE-1044 International Publication No. WO 2011/051888 (“Ackermans”)
- APPLE-1045 International Publication No. WO 2012/140559 (“Shmueli”)
- APPLE-1046 U.S. Patent No. 7,650,176 to Sarussi
- APPLE-1047 U.S. Patent Pub. No. 2002/0095092 (“Kondo”)
- APPLE-1048 U.S. Patent Pub. No. 2015/0355604 (“Fraser”)
- APPLE-1049 U.S. Patent No. 6,398,727 to Bui
- APPLE-1050 – 1059 [RESERVED]
- APPLE-1060 Combined Civil and Criminal Federal Court Management Statistics (Sep. 30, 2023) | United States Courts (uscourts.gov), available at: https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0930.2023.pdf
- APPLE-1061 Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“*Director’s Guidance*”)
- APPLE-1062 Apple’s Complaint for Patent Infringement (Design), *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01377 (D. Del. Oct. 20, 2022)
- APPLE-1063 Apple’s Complaint for Patent Infringement (Utility), *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (D. Del. Oct. 20, 2022)
- APPLE-1064 Defendant Masimo Corporation’s Answer to Complaint and Counterclaims, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (D. Del. Dec. 12, 2022)

- APPLE-1065 Order Granting Joint Motion to Amend the Case Schedule, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (D. Del. Sep. 21, 2023)
- APPLE-1066 Stipulation by Apple Inc.
- APPLE-1067 Email Identifying Masimo’s District Court Invalidity Grounds (Nov. 16, 2023)
- APPLE-1068 Excerpt of Apple’s District Court Expert Invalidity Report, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (Nov. 22, 2023)
- APPLE-1069 Order Granting Unopposed Motion to Stay Certain Patent Counterclaims, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (Jan. 10, 2023)
- APPLE-1070 [RESERVED]
- APPLE-1071 U.S. Patent No. 10,687,745 to Al-Ali (“the ’745 patent”)
- APPLE-1072 Institution Decision, *Apple Inc. v. Masimo Corp.*, IPR2022-01291 Pap. 15 (PTAB Feb. 1, 2023)
- APPLE-1073 U.S. Patent No. 10,470,695 to Al-Ali (“the ’695 patent”)
- APPLE-1074 Final Written Decision, *Apple Inc. v. Masimo Corp.*, IPR2020-01722 Pap. 29 (PTAB May 5, 2022)
- APPLE-1075 Joint Letter for March 20, 2024 Case Management Conference, *Apple Inc., v Masimo Corporation, et al.*, Case No. 1-22-cv-01378 (Mar. 16, 2024)
- APPLE-1076 Combined Civil and Criminal Federal Court Management Statistics (Dec. 31, 2023) | United States Courts (uscourts.gov), available at:

https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf

- APPLE-1077 Median Time to Disposition in Cases Terminated After Hearing or Submission | United States Court of Appeals for the Federal Circuit (Sep. 30, 2023), available at: MedDispTimeMERITSTableFY23.pdf (uscourts.gov)
- APPLE-1078 Sotera Stipulation by Apple Inc.
- APPLE-1079 CONFIDENTIAL - Supplemental Declaration of Dr. Brian Anthony
- APPLE-1080 CONFIDENTIAL - Transcript of the Deposition of Dr. R. James Duckworth (August 9, 2023)
- APPLE-1081 U.S. Patent Application Pub. No. 2010/0324387 to Moon et al. (“Moon”)
- APPLE-1082 CONFIDENTIAL - ITC Inv. No. 337-TA-1276 Hearing Transcript of Dr. Saahil Mehra
- APPLE-1083 CONFIDENTIAL – Transcript of Testimony of Dr. Vivek Venugopal from June 6-10, 2022 Hearing Transcript, Masimo Corp. et al. v. Apple Inc., ITC Inv. No 337-TA-1276
- APPLE-1084 CONFIDENTIAL - ITC Inv. No. 337-TA-1276 Hearing Transcript of Dr. Ueyn Block
- APPLE-1085 ITC Inv. No. 337-TA-1276 Exhibit RX-0498 (Takatani et al., Optical Oximetry Sensors for Whole Blood and Tissue, IEEE Engineering in Medicine and Biology (June/July 1994))
- APPLE-1086 CONFIDENTIAL - Transcript of the first session of the Deposition of Dr. Vijay K. Madiseti (February 4, 2025)

- APPLE-1087 CONFIDENTIAL - Transcript of the second session of the
Deposition of Dr. Vijay K. Madisetti (February 7, 2025)
- APPLE-1088 U.S. Patent No. 6,580,086 to Schulz et al.
- APPLE-1089 Petitioner's Demonstratives (Confidential and Public Versions)

I. INTRODUCTION

Pursuant to the Protective Order (Papers 13, 16) in this proceeding and 37 C.F.R. § 42.14, Petitioner Apple Inc. (“Apple”) submits this Motion to Seal (“Motion”). Through this Motion, Apple respectfully requests that Apple’s Oral Hearing Demonstratives and Patent Owner’s Oral Hearing Demonstratives¹ (“Requested Documents”) be sealed. Each of these documents includes Apple’s confidential business information (“CBI”).

As described in further detail below, the documents that Apple moves to seal include Apple CBI related to, among other things, sensitive information related to Apple’s Watch products, including proprietary research and development (R&D) information, trade secrets, proprietary processes and apparatuses, and confidential business operations information. The information in these documents originated from related proceedings between the parties, including:²

¹ The Paper/Exhibit numbers of the confidential versions of the two demonstratives were not available at the time this motion was drafted and submitted.

² The ITC investigation, the -01291 IPR, and the -01465 IPR all involved validity challenges to U.S. Patent No. 10,687,745 (“the ’745 Patent”). The ’745 Patent is related to and has the same disclosure as the ’743 Patent at issue in the present IPR.

- ITC Inv. No. 337-TA-1276 (*Certain Light-Based Physiological Measurement Devices and Components Thereof*) (“the ITC investigation”);
- *Apple Inc. v. Masimo Corp.*, IPR2022-01291 (PTAB) (“the - 01291 IPR”)
- *Apple Inc. v. Masimo Corp.*, IPR2022-01465 (PTAB) (“the - 01465 IPR”)
- *Apple Inc. v. Masimo Corp.*, 1-22-cv-01378 (D. Del.) (“the Delaware litigation”)

This Motion comports with the Board’s “aim to strike a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.” PTAB Consolidated Trial Practice Guide 2019 (CTPG), p. 19.

The public versions of the documents that Apple seeks to seal in this proceeding, for example, will allow the public to fairly access any non-confidential information related to disputed issues in this IPR, while also maintaining Apple’s strong interest in maintaining its CBI in confidence. Apple respectfully submits that the Board should accordingly **grant** this Motion and seal and protect the documents identified below for each of the reasons described herein.

II. IDENTIFICATION OF DOCUMENTS THAT APPLE REQUESTS TO BE SEALED

Apple respectfully moves to partially seal the confidential (non-public) versions of Petitioner's Oral Hearing demonstratives and Patent Owner's Oral Hearing demonstratives. In particular, Apple requests that: 1) the entirety of slides 126-132 of Petitioner's demonstratives and 2) the entirety of slides 64-80 of Patent Owner's demonstratives, be sealed. The above-noted slides in the Requested Documents should be sealed because they contain Apple's CBI. *See* IPR2022-01291, Paper 41 at 4-5 (PTAB Aug. 28, 2023) ("[W]e agree ... that granting [the] Motions strikes the right balance 'between the public's interest in maintaining a complete and understandable file history and the parties' interest in protecting truly sensitive information.'"') (*citing* CTPG, p. 19). Non-confidential versions of the parties' demonstratives are also being submitted with redactions being applied to portions of the documents that contain Apple CBI while leaving non-confidential portions unredacted.

III. THE *ARGENTUM* FACTORS FAVOR SEALING THE REQUESTED DOCUMENTS

In an *inter partes* review ("IPR"), the Board will seal confidential information on a showing of "good cause." 37 C.F.R. § 42.20(c). The Board has explained that "a movant to seal must demonstrate adequately that (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result

upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.” *Argentum Pharmaceuticals LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 at 4 (PTAB Jan. 19, 2018) (informative).

Apple submits that the *Argentum* factors favor sealing the Requested Documents and that good cause exists for such relief under 37 C.F.R. § 42.20(c).

A. *Factor 1: The Information Sought to be Sealed is Truly Confidential*

Factor 1 favors sealing the Requested Documents because the Requested Documents contain information that is truly confidential. In particular, slides 126-132 of Petitioner’s demonstratives and slides 64-80 of Patent Owner’s demonstratives including questions and testimony that refer to various confidential exhibits that had been entered in the -01291 IPR from ITC Inv. No. 337-TA-1276. The noted slides also include discussion of CBI related to Apple’s Watch products, including sensitive, proprietary research and development (R&D) information, trade secrets, proprietary processes and apparatuses, and confidential business operations information.

B. *Factor 2: Apple Would Suffer Concrete Harm Upon Public Disclosure of the Confidential Information*

Factor 2 favors sealing the Requested Documents. The Requested Documents include sensitive, proprietary R&D information related to Apple’s Watch products, trade secrets, proprietary processes and apparatuses, and confidential business operations. The information includes testimony from engineers, and internal documents related to the design and development of capabilities of Apple’s Watch products. The testimony and internal documents contain sensitive and proprietary information regarding technical development of Apple’s Watch products and proprietary processes and information relating to the same.

Apple would suffer predictable financial harm through unauthorized release of proprietary, trade secret information to competitors who could leverage Apple’s substantial investment in research and development of the Watch to their own advantage. The parties agreed in the IPR2022-01291 proceeding that disclosure of such confidential information would “likely have the effect of ... causing substantial harm to the competitive position of the person, firm, partnership, corporation, or other organization from which the information was obtained.” IPR2022-01291, EX1035, p. 1.

C. *Factor 3: There Exists a Genuine Need to Rely in the Trial on the Specific Information Sought to be Sealed*

The information sought to be sealed relates to issues in this proceeding such as the reasonable expectation of success of performing pulse oximetry at the wrist and, relatedly, the obviousness of one of the asserted prior art combinations. Previously, Masimo offered the following statements in support of sealing similar information, which Apple reproduces for the Board’s consideration:

Regarding *Argentum* factor 3 concerning a “genuine need” to rely on the cited material: Masimo cited the material to demonstrate at least (1) the contemporaneous perspectives of Apple’s own engineers regarding measuring oxygen saturation at the wrist, which undermines Apple’s obviousness theories, and (2) Apple’s inconsistent positions on the same issues between these IPRs and related litigations.

See Paper 28 at 8. While Apple does not agree with the substance of Masimo’s arguments and reserves all rights to challenge the evidence cited in support of the arguments, Factor 3 nonetheless favors sealing the Requested Documents based both on Masimo’s statement, and a genuine need to reply to issues raised in this IPR proceeding.³ In that regard, the Requested Documents support Apple’s obviousness

³ To the extent that the Board determines that Apple has no need to rely upon the Requested Documents in this trial, Apple respectfully submits that, rather than denying this Motion to Seal and revealing the included Apple confidential

theories, and demonstrate the consistency of Apple's positions on similar issues across IPRs and related litigations.

D. *Factor 4: The Balance of Interests Favors Maintaining Confidentiality*

Factor 4 favors grant of this Motion because, on balance, Apple's interest in maintaining confidentiality outweighs the public interest with respect to the limited information sought to be sealed. *See Argentum* at 3-4. As noted above, the information that Apple seeks to seal is truly confidential and Apple would suffer concrete harm if the information were made available to the public.

Moreover, pursuant to the Protective Order entered in this proceeding (Papers, 13, 16), public versions of these documents will be filed following an exchange between the parties of proposed redactions. The public will have full access to arguments and evidence developed in these proceedings from the public versions of these documents sufficient for the public to understand the nature of the disputed issues. Such access will fulfill the public's interest in maintaining a complete file history, while still protecting Apple's confidential and proprietary information.

information to the public, an appropriate remedy would be to expunge the Requested Documents from the record. To the extent desired by the Board, Apple respectfully submits that this issue could be addressed upon issuance of the Board's final written decision.

Apple’s request thus “strike[s] a balance between the public’s interest in maintaining a complete and understandable file history and the parties’ interest in protecting truly sensitive information.” CTPG, p. 19. The Board previously agreed that an appropriate balance was struck when it agreed to seal similar content in the -01291 IPR, and in so doing, the Board recognized that the proposed public versions of documents that were not sealed in their entirety in that proceeding were “sufficient to notify the public of the general thrust” of Patent Owner’s arguments. IPR2022-01291, Paper 41 at 4, 6 (PTAB August 28, 2023) (“we agree” that the motions “strike[] the right balance ...”).

IV. CONCLUSION

For these reasons, Apple respectfully requests that the Board seal and protect the Requested Documents.

Respectfully submitted,

Date: April 11, 2025

/Usman Khan/

W. Karl Renner, Reg. No. 41,265
Andrew B. Patrick, Reg. No. 63,471
Usman A. Khan, Reg. No. 70,439
Patrick J. Bisenius, Reg. No. 63,89
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.6(e)(4)(iii), the undersigned certifies that on April 11, 2025 a complete and entire copy of this Motion to Seal provided via email to the Patent Owner by serving the correspondence email address of record as follows:

Brian C. Claassen (Reg. No. 63,051)
Carol Pitzel Cruz (Reg. No. 61,224)
Perry D. Oldham (Reg. No. 52,082)
Daniel C. Kiang (Reg. No. 79,631)
Irfan A. Lateef (Reg. No. 51,922)
Adam B. Powell (Reg. No. 70,367)

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502

E-mail: AppleIPR159-1@knobbe.com

/Anastasia Renard/
Anastasia Renard
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
renard@fr.com