UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

MASIMO CORPORATION,
Patent Owner

Case IPR2024-00244
Patent No. 10,722,159

PETITIONER'S MOTION TO SEAL
DOCUMENTS FILED WITH THE PATENT OWNER'S RESPONSE

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 Patent Owner Masimo Corp.'s ("Masimo") Patent Owner's Response, and certain exhibits filed with the Patent Owner's Response, 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 regarding Apple's Watch products, including proprietary research and development (R&D) information, trade secrets, proprietary processes, and confidential business operations information. To avoid burdening the Board and the parties with discovery motion practice, Apple voluntarily produced these documents in this IPR after extensive negotiations between the parties both

before and after institution. The produced documents originated from several related proceedings, including:[1]

- 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

[1] 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 a parent of the '743 Patent at issue in the present IPR.

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. 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 seal each of the documents filed by Masimo with its Patent Owner's Response (collectively, the "Requested Documents") identified in Appendix A.[2]

Apple specifically requests that Exhibits 2083, 2084, 2086, 2094, and 2102 be sealed in their entirety because Apple's CBI pervades the entirety of these documents. Notably, Exhibits 2083, 2084, and 2086 have been similarly sealed in their entirety in related proceedings between the parties, including in the -01291 and -01465 IPRs. *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

[2] Exhibits 2076, 2077, 2078, 2080, 2081, 2082, 2083, 2084, 2085, 2086, 2089, 2093, and 2096 are identical to documents that have been previously filed and ordered sealed in the -01291 IPR. *See* IPR2022-01291, Papers 41 and 70.

interest in maintaining a complete and understandable file history and the parties' interest in protecting truly sensitive information.'") (citing CTPG, p. 19). Exhibits 2093 and 2096 should also be sealed in their entireties; no new public versions of these exhibits are necessary because public versions have already been filed as Exhibits 2043 and 2035, respectively.

Apple further requests that the Patent Owner's Response and Exhibits 2076, 2077, 2078, 2080, 2081, 2082, 2085, 2089, 2098, 2100, and 2104 be partially sealed. These documents contain both confidential and non-confidential portions, and public versions of these documents are being filed concurrent with the filing of this Motion. The public versions of these documents include redactions to portions of the documents that contain Apple CBI while leaving non-confidential portions identified through negotiations with Masimo 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). Good cause for this Motion is underscored by the fact that Masimo itself moved to seal many of the Requested Documents that were previously submitted in the -01291 IPR, and Masimo expressly acknowledged in its motion that "good cause exists to seal the exhibits and the confidential version of Masimo's Patent Owner Response." IPR2022-01291, Paper 30 at 5 (May 26, 2023). The Board agreed. IPR2022-01291, Paper 41 (PTAB August 28, 2023).

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.

First, the Patent Owner's Response (Paper 19) and Exhibit 2100 (Dr. Madisetti's declaration) cite, discuss, and quote confidential information from various of the Requested Documents described below.

Second, Exhibits 2076-2088 and 2080-2082 are hearing and deposition transcripts of testimony elicited from Apple employees during the ITC proceeding. The portions of the hearing transcripts that Apple requests to seal were conducted in closed session at the ITC and include questioning and testimony 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. These exhibits were previously sealed in the -01291 IPR.

Third, Exhibit 2083 is a confidential exhibit produced from the ITC proceeding that was previously sealed in the -01291 IPR. Exhibit 2083 includes an Apple internal presentation and communications between Apple employees related to Apple's Watch products, including sensitive, proprietary R&D information, trade secrets, proprietary processes and apparatuses, and confidential business operations information.

Fourth, Exhibit 2084 is a confidential exhibit produced from the ITC proceeding that was previously sealed in the -01291 IPR. Exhibit 2084 includes a proprietary Apple organization chart and confidential business operation information.

Fifth, Exhibits 2085, 2086, and 2089 are Apple internal presentations produced from the ITC proceeding related to Apple's Watch products, including sensitive, proprietary R&D information, trade secrets, proprietary processes and apparatuses, and confidential business operations information. These exhibits were previously sealed in the -01291 IPR.

Sixth, Exhibit 2093 is a confidential version of the Final Initial Determination from the ITC proceeding. This document contains sensitive information related to Apple's Watch products, including proprietary R&D information, trade secrets, proprietary processes and apparatuses, and confidential business operations information. This document may further contain Masimo and third-party CBI. The parties previously negotiated redactions for a public version of this document at the ITC, which has been filed in this IPR as Exhibit 2043.

Seventh, Exhibit 2094 is a transcript of the deposition of Apple's employee, Dr. Paul Mannheimer, from the Delaware litigation. The transcript includes questions and responses relating to sensitive information about Apple's Watch products, including proprietary R&D information, trade secrets, proprietary processes and apparatuses, and confidential business operations information.

Eighth, Exhibit 2096 is a confidential version of the Final Written Decision from the -01291 IPR. This document contains sensitive information related to

Apple's Watch products, including proprietary R&D information, trade secrets, proprietary processes and apparatuses, and confidential business operations information. The parties previously negotiated redactions for a public version of this document during the course of the -01291 IPR, and the public version has been filed in the present IPR as Exhibit 2035.

Ninth, Exhibit 2098 is a confidential version of Dr. Majid Sarrafzadeh's expert report from the Delaware litigation. The report contains sensitive information related to Apple's Watch products, including proprietary technical and R&D information. Non-confidential excerpts from Dr. Sarrafzadeh's report were previously filed in this IPR as Exhibit 2037. A public version of Exhibit 2098 is also being filed that leaves unredacted additional non-confidential information from the portions of the report cited in Masimo's Patent Owner's Response.

Tenth, Exhibit 2102 is an engineering requirements specification related to pulse oximetry in Apple Watch products produced from the Delaware litigation. Exhibit 2102 includes Apple's proprietary R&D information, trade secrets, proprietary processes and apparatuses, and confidential business operations information.

Eleventh, Exhibit 2104 is an email between Apple employees written in a non-public context. Exhibit 2104 includes Apple 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 risks suffering competitive and financial harm through unauthorized release of proprietary, trade secret information to competitors and other entities who could leverage Apple's substantial investment in research and development of the Watch to their own advantage. 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*: Masimo's Purported Need to Rely on Apple's Confidential Information

The Requested Documents that Apple seeks to seal with this Motion consist of Masimo's Patent Owner's Response and certain exhibits cited within the Patent Owner's Response. Apple does not agree that the confidential information in the Requested Documents supports patentability of the claims challenged in this IPR, and consistent with Apple's objections, further reserves the right to argue that the confidential information is legally irrelevant to issues under consideration in this IPR.

Masimo nonetheless shared the following statement with Apple regarding its alleged need to rely in this trial on confidential information from the Requested Documents, 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.

While Apple does not agree with the substance of Masimo's arguments in the POR and reserves all rights to challenge the evidence cited in support of the arguments, Factor 3 nonetheless favors sealing the Requested Documents based on Masimo's statement.[3]

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

[3] To the extent the Board determines that Masimo has no need to rely upon the Requested Documents in this trial (for example, because the relied-upon information is irrelevant to the Board's determination of unpatentability over the instituted obviousness grounds), Apple respectfully submits that, rather than denying this Motion to Seal and revealing the included Apple confidential 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.

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, Apple is concurrently filing redacted versions of the Patent Owner's Response and Exhibits 2076, 2077, 2078, 2080, 2081, 2082, 2085, 2089, 2098, 2100, and 2104. 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. 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 found that an appropriate balance was struck when it agreed to seal many of the same documents 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. MASIMO CONFIRMED IT WILL NOT OPPOSE THIS MOTION

The Protective Order sets forth procedures by which Masimo could file a response in the form of an opposition to this Motion, but Masimo has confirmed that it does intend to do so. Masimo instead asked that Apple include the following statement reflecting Masimo's position in this Motion, which we have done at Masimo's request:

> Masimo does not agree with Apple's proposed redactions, and in many cases Apple overredacted information that already appeared publicly in the related ITC investigation, IPR2022-01291, and a related Federal Circuit appeal. To conserve judicial resources, Masimo does not intend to file a response to the motion to seal.

Apple acknowledges that Masimo does not intend to file an opposition, but Apple disagrees with the unsubstantiated assertion that Apple has improperly overredacted information in the public versions of the documents being filed concurrently with this Motion. The parties spent weeks negotiating redactions in the public versions of the documents, and Apple agreed to unredact any text that was shown to be publicly revealed in other documents. Apple in fact implemented many unredactions where appropriate, but in other instances, Masimo called on Apple to unredact confidential information that was not the same or equivalent to information

that Masimo cited from other public sources. Apple could not agree to unredactions in these instances.

Masimo's objections are also not credible because Apple is already unredacting significantly more information than was previously unredacted in the -01291 or -01465 IPRs. In a number of instances, Masimo itself previously proposed in the -01291 and -01465 IPRs redactions of the very same information to which it now objects. Masimo's position on the scope of redactions has been a shifting target for which Apple has made every effort to reasonably accommodate, but which Apple should not be required to chase ad nauseam. The Board previously agreed that the parties' redactions and treatment of many of the same documents in the -01291 and -01465 IPRs "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" and that the public filings in the -01291 and -01465 IPRs were "sufficient to notify the public of the general thrust" of the arguments and issues in those proceedings. IPR2022-01291, Paper 41 at 4-6 (PTAB Aug. 28, 2023). Considering that Apple has redacted no more information than was previously redacted in the -01291 and -01465 IPRs with respect to the common documents in these proceedings, and that Apple has further unredacted a range of additional information that has since been publicly revealed, the scope of this Motion to Seal

is appropriate for at least the same reasons previously determined in the -01291 and -01465 IPRs.

V. CONCLUSION

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

Respectfully submitted,

Date: December 19, 2024

/Nicholas W. Stephens/

Nicholas Stephens, Reg. No. 74,320
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 612-766-2018
F: 877-769-7945

Attorney for Petitioner Apple Inc.

Appendix A: Table of Requested Documents to be Sealed

Document	Description
Paper 20	Patent Owner's Response
EX2076	Transcript of Testimony of Brian Land from June 6-10, 2022 Hearing Transcript, *Certain Light-Based Physiological Measurement Devices and Components Thereof*, Inv. No. 337-TA-1276
EX2077	Transcript of Testimony of Dr. Paul Mannheimer from June 6-10, 2022 Hearing Transcript, *Certain Light-Based Physiological Measurement Devices and Components Thereof*, Inv. No. 337-TA-1276
EX2078	Transcript of Testimony of Dr. Stephen Waydo from June 6-10, 2022 Hearing Transcript, *Certain Light-Based Physiological Measurement Devices and Components Thereof*, Inv. No. 337-TA-1276
EX2080	ITC Exhibit CX-0289C – Designated Portions of February 10, 2022 Deposition of Dr. Paul Mannheimer
EX2081	ITC Exhibit CX-0299C – Designated Portions of February 18, 2022 Deposition of Dr. Stephen Waydo
EX2082	ITC Exhibit CX-0295C – Designated Portions of February 11, 2022 Deposition of Tao Shui
EX2083	ITC Exhibit CX-0007C – Email from Brian Land to Paul Mannheimer et al.
EX2084	ITC Exhibit CX-0175C – Apple Organization Chart
EX2085	ITC Exhibit CX-0177C – Apple Presentation
EX2086	ITC Exhibit CX-0185C – Apple Presentation
EX2089	ITC Exhibit CX-1793C – Apple Presentation

Document	**Description**
EX2093	ITC Final Initial Determination *Certain Light-Based Physiological Measurement Devices and Components Thereof*, Inv. No. 337-TA-1276 (Public version filed as Exhibit 2043)
EX2094	Transcript of November 7, 2023 Deposition of Dr. Paul Mannheimer, *Apple Inc. v. Masimo Corp. et al.*, Nos. 22-1377-MN-JLH, 22-1378-MN-JLH (D. Del.)
EX2096	Final Written Decision, *Apple Inc. v. Masimo Corp.*, IPR2022-01291 (Jan. 30, 2024) (Public version previously filed as EX2035)
EX2098	Excerpt of December 15, 2023 Expert Report of Majid Sarrafzadeh, Ph.D. Regarding Non-Infringement of U.S. Patent Nos. 10,687,743 & 10,722,159, *Apple Inc. v. Masimo Corp.*, C.A. Nos. 22-1377-MN-JLH, 22-1378-MN-JLH (D. Del.)
EX2100	Declaration of Vijay K. Madisetti, Ph.D. in Support of Patent Owner's Response
EX2102	Excerpt of document produced by Apple from the Delaware litigation bearing production numbers APL_DEL03985999-6078
EX2104	Document produced by Apple from the Delaware litigation bearing production numbers APL-MAS_01812072-78

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on December 19, 2024 a complete and entire copy of this Petitioner's Motion to Seal were provided via email, to the Patent Owner by serving the email correspondence addresses 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 Kiang (Reg. No. 79,631)
Irfan A. Lateef (Reg. No. 51,922)

KNOBBE, MARTENS, OLSON, & BEAR, LLP
2040 Main St., 14th Floor
Irvine, CA 92614

Telephone: (949) 760-0404
Facsimile: (949) 760-9502

AppleIPR159-2@knobbe.com

/Crena Pacheco/

Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
pacheco@fr.com