

**From:** [Daniel Kiang](#)  
**To:** [Trials](#)  
**Cc:** [IPR50095-0134IP1](#); [IPR50095-0134IP2](#); [IPR50095-0133IP1](#); [AppleIPR159-1](#); [AppleIPR159-2](#); [AppleIPR743-1](#); [Andrew Patrick](#)  
**Subject:** Re: IPR2024-00241, -00243, -00244 - Request for conference call  
**Date:** Monday, March 24, 2025 12:48:45 PM

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Dear Board,

Masimo thanks the Board for clarifying the denial of Masimo's request and for the opportunity to describe the evidence to preserve the issue for appeal.

If the Board had granted authorization for conditional evidence, the evidence would have been:

- Making Dr. Madisetti's declarations in the three related IPRs available in each IPR (e.g., EX2100 from IPR2024-00243 would be made available in IPR2024-00241).
  - Masimo would have relied on Madisetti's discussions regarding Pang and Brady in the 243 IPR declaration to address those exhibits introduced on reply in the 241 IPR.
  - Masimo also would have relied on Madisetti's discussions from the 243 IPR regarding Apple's alleged motivations to combine (e.g., measuring oxygen saturation while jogging) that Apple referenced in the 241 Reply.
- Dr. Duckworth's direct testimony (EX2070 and EX2100) from IPR2022-01291
  - Masimo would have relied on Duckworth's direct testimony to rebut Apple's reliance on his IPR2022-01291 cross-examination testimony (EX1080).
  - Duckworth's direct testimony discussed issues including:
    - Iwamiya's disclosure of suitable materials to achieve the light shielding function
    - Non-obviousness of adding a dark-colored coating to Iwamiya
    - Lack of reasonable expectation of success for determining oxygen saturation at the wrist
- A new expert declaration to address the new evidence and arguments presented in Apple's replies.

Best regards,  
Daniel

**Daniel Kiang**  
Partner  
[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)  
(949) 760-0404 Main  
**Knobbe Martens**

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**From:** Trials <Trials@USPTO.GOV>  
**Date:** Thursday, March 13, 2025 at 6:22 AM  
**To:** Andrew Patrick <patrick@fr.com>, Daniel Kiang <Daniel.Kiang@knobb.com>, Trials <Trials@USPTO.GOV>  
**Cc:** IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>, IPR50095-0134IP2 <IPR50095-0134IP2@fr.com>, IPR50095-0133IP1 <IPR50095-0133IP1@fr.com>, AppleIPR159-1 <AppleIPR159-1@knobb.com>, AppleIPR159-2 <AppleIPR159-2@knobb.com>, AppleIPR743-1 <AppleIPR743-1@knobb.com>  
**Subject:** RE: IPR2024-00241, -00243, -00244 - Request for conference call

Counsel,

The Board denies Patent Owner's request to conditionally file materials with its Sur-reply. Patent Owner sought permission to file motions to strike, or, alternatively, to submit evidence with its Sur-replies. The Board granted Patent Owner's request to file motions to strike, presumably rendering its request to file evidence with its Sur-replies moot at least in the event that Patent Owner's motions to strike are granted. Allowing the filing of conditional materials with the Sur-reply would unnecessarily confuse the scope of the record, particularly in the event that the Board grants the motions to strike.

To the extent Patent Owner wishes to preserve the issue of whether we should have allowed it to file conditional evidence for appeal, it may describe such evidence, without accompanying argument, in an email to the Board. If Patent Owner does so, we will enter the exhibit we receive as a 3000 series exhibit.

Regards,

Andrew Kellogg,  
Deputy Chief Clerk, Trials  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
(571) 272-5366

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**From:** Andrew Patrick <patrick@fr.com>  
**Sent:** Wednesday, March 12, 2025 3:06 PM  
**To:** Daniel Kiang <Daniel.Kiang@knobb.com>; Trials <Trials@USPTO.GOV>  
**Cc:** IPR50095-0134IP1 <IPR50095-0134IP1@fr.com>; IPR50095-0134IP2 <IPR50095-

0134IP2@fr.com>; IPR50095-0133IP1 <IPR50095-0133IP1@fr.com>; AppleIPR159-1 <AppleIPR159-1@knobbe.com>; AppleIPR159-2 <AppleIPR159-2@knobbe.com>; AppleIPR743-1 <AppleIPR743-1@knobbe.com>

**Subject:** RE: IPR2024-00241, -00243, -00244 - Request for conference call

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Your Honors,

Apple requested that Masimo include for your consideration the below non-argumentative statement of Apple's position with respect to Masimo's latest outreach:

Apple again respectfully submits that Masimo cannot show good cause for waiver of the rules governing submission of new evidence with sur-replies, that the introduction of new evidence at the sur-reply stage would both unfairly prejudice Apple and needlessly complicate the proceedings, and that a submission of new evidence by Masimo is especially unwarranted in the circumstances envisioned by Masimo as the condition for its latest request.

More, this third request by Masimo for waiver of the rules is unnecessary and unwarranted both in view of the Board's prior consideration and express rejection of Masimo's second request, and in view of the Board having already authorized Masimo's request to file motions to strike that Masimo expressly styled as an alternative to its original request.

Masimo only just minutes ago informed counsel for Apple that Masimo would not honor Apple's request for inclusion of Apple's statement, asserting in doing so that "Masimo will not include substantive arguments in favor of its position or Apple's proposed arguments in favor of its opposition," and that "Apple is welcome to explain its position to the Board during the conference call."

Apple does not believe that a conference call is necessary with respect to issues that the Board has already decided, and further believes that it is appropriate for the Board to have available for its consideration the above statement of Apple's position.

Respectfully,

Andrew Patrick  
Counsel for Petitioner Apple

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**From:** Daniel Kiang <[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)>

**Sent:** Wednesday, March 12, 2025 1:45 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

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**Subject:** Re: IPR2024-00241, -00243, -00244 - Request for conference call

Dear Board,

We have received the Board's March 6 email denying authorization to conditionally submit, with Masimo's sur-replies, the evidence identified in Masimo's February 28 email. Based on the Board's March 6 email, we believe the Board denied authorization because Apple asserted the parties did not meet and confer. Although Masimo believes that the parties' original conference covered this issue, the parties met and conferred again on March 11 and were unable to resolve their dispute.

Masimo respectfully requests a conference call to seek authorization to conditionally file, with Masimo's sur-replies, the evidence described in Masimo's February 28 email. Apple opposes the conditional filing of that evidence. Per the Board's scheduling order, Masimo has not included substantive argument in this email.

The parties are available for a teleconference this Thursday at 3:30-5pm ET. If this time does not work for the Board, the parties will provide alternate availability. Masimo requests advance notice of the conference call to arrange a court reporter.

Best regards,  
Daniel

**Daniel Kiang**

Partner

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Date:** Thursday, March 6, 2025 at 1:04 PM

**To:** Andrew Patrick <[patrick@fr.com](mailto:patrick@fr.com)>, Daniel Kiang <[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)>, Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

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**Subject:** RE: IPR2024-00241, -00243, -00244 - Request for authorization for motion to strike or to introduce evidence with sur-replies

Counsel,

Patent Owner's request for authorization to conditionally submit, with its sur-replies, the evidence identified in its February 28 email is denied. Patent Owner is reminded to meet and confer with opposing counsel before contacting the Board in the future.

Regards,

Andrew Kellogg,  
Deputy Chief Clerk, Trials  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
(571) 272-5366

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**From:** Andrew Patrick <[patrick@fr.com](mailto:patrick@fr.com)>

**Sent:** Wednesday, March 5, 2025 6:14 PM

**To:** Daniel Kiang <[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** IPR50095-0134IP1 <[IPR50095-0134IP1@fr.com](mailto:IPR50095-0134IP1@fr.com)>; IPR50095-0134IP2 <[IPR50095-0134IP2@fr.com](mailto:IPR50095-0134IP2@fr.com)>; IPR50095-0133IP1 <[IPR50095-0133IP1@fr.com](mailto:IPR50095-0133IP1@fr.com)>; AppleIPR159-1 <[AppleIPR159-1@knobbe.com](mailto:AppleIPR159-1@knobbe.com)>; AppleIPR159-2 <[AppleIPR159-2@knobbe.com](mailto:AppleIPR159-2@knobbe.com)>; AppleIPR743-1 <[AppleIPR743-1@knobbe.com](mailto:AppleIPR743-1@knobbe.com)>

**Subject:** RE: IPR2024-00241, -00243, -00244 - Request for authorization for motion to strike or to introduce evidence with sur-replies

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Your Honors,

Counsel for Masimo did not confer with counsel for Apple before sending Masimo's additional request to "conditionally submit" new evidence with Masimo's sur-replies, which is notably different from Masimo's earlier request for new sur-reply evidence at least insofar as Masimo expressly styled the earlier request as an alternative to an authorized motion to strike.

With respect to the additional request, Apple respectfully submits that Masimo cannot show good cause for waiver of the rules governing submission of new evidence with sur-replies. More, the introduction of new evidence at the sur-reply stage would both unfairly prejudice Apple and needlessly complicate the proceedings. Masimo has already been granted an opportunity to present arguments with respect to Apple's reply evidence in a motion to strike; a further submission of

evidence by Masimo is unwarranted in any event, and especially so in the circumstances envisioned by Masimo as the condition for its latest request.

Respectfully,

Andrew Patrick  
Counsel for Petitioner Apple

---

**From:** Daniel Kiang <[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)>

**Sent:** Wednesday, March 05, 2025 4:19 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** IPR50095-0134IP1 <[IPR50095-0134IP1@fr.com](mailto:IPR50095-0134IP1@fr.com)>; IPR50095-0134IP2 <[IPR50095-0134IP2@fr.com](mailto:IPR50095-0134IP2@fr.com)>; IPR50095-0133IP1 <[IPR50095-0133IP1@fr.com](mailto:IPR50095-0133IP1@fr.com)>; AppleIPR159-1 <[AppleIPR159-1@knobbe.com](mailto:AppleIPR159-1@knobbe.com)>; AppleIPR159-2 <[AppleIPR159-2@knobbe.com](mailto:AppleIPR159-2@knobbe.com)>; AppleIPR743-1 <[AppleIPR743-1@knobbe.com](mailto:AppleIPR743-1@knobbe.com)>

**Subject:** Re: IPR2024-00241, -00243, -00244 - Request for authorization for motion to strike or to introduce evidence with sur-replies

[This email originated outside of F&R.]

Dear Board,

Masimo thanks the Board for granting authorization to file motions to strike in the above-referenced IPRs. In view of the Board indicating it does not expect to decide Masimo's motion to strike before Masimo's sur-replies are due, Masimo also requests authorization to conditionally submit with its sur-replies the evidence identified in its February 28 email. The evidence would be available if the Board denies Masimo's primary request to strike Apple's new evidence but grants Masimo's alternative request to submit the new evidence. As previously indicated, the parties will provide their availability for a teleconference if the Board desires one.

Best regards,  
Daniel

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

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Date:** Monday, March 3, 2025 at 10:45 AM

**To:** Daniel Kiang <[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)>, Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** IPR50095-0134IP1 <[IPR50095-0134IP1@fr.com](mailto:IPR50095-0134IP1@fr.com)>, IPR50095-0134IP2 <[IPR50095-0134IP2@fr.com](mailto:IPR50095-0134IP2@fr.com)>, IPR50095-0133IP1 <[IPR50095-0133IP1@fr.com](mailto:IPR50095-0133IP1@fr.com)>, AppleIPR159-1 <[AppleIPR159-1@knobbe.com](mailto:AppleIPR159-1@knobbe.com)>, AppleIPR159-2 <[AppleIPR159-2@knobbe.com](mailto:AppleIPR159-2@knobbe.com)>, AppleIPR743-1 <[AppleIPR743-1@knobbe.com](mailto:AppleIPR743-1@knobbe.com)>  
**Subject:** RE: IPR2024-00241, -00243, -00244 - Request for authorization for motion to strike or to introduce evidence with sur-replies

Counsel,

Patent Owner's request for authorization to file a Motion to Strike in each proceeding is granted. Patent Owner may file a ten-page Motion to Strike. Patent Owner's motion shall be filed on or before March 10, 2025 and is limited to the subject matter of new arguments and new evidence allegedly raised in connection with Petitioner's Reply. Petitioner is authorized to file a ten-page Opposition to Patent Owner's Motion to Strike. Petitioner's Opposition shall be filed on or before March 17, 2025 and shall be limited to addressing the arguments presented in Patent Owner's Motion. The panel does not expect to decide Patent Owner's Motion before the deadline for filing Patent Owner's Sur-Reply.

Regards,

Andrew Kellogg,  
Deputy Chief Clerk, Trials  
Patent Trial and Appeal Board  
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**From:** Daniel Kiang <[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)>  
**Sent:** Friday, February 28, 2025 11:11 AM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** IPR50095-0134IP1 <[IPR50095-0134IP1@fr.com](mailto:IPR50095-0134IP1@fr.com)>; IPR50095-0134IP2 <[IPR50095-0134IP2@fr.com](mailto:IPR50095-0134IP2@fr.com)>; IPR50095-0133IP1 <[IPR50095-0133IP1@fr.com](mailto:IPR50095-0133IP1@fr.com)>; AppleIPR159-1 <[AppleIPR159-1@knobbe.com](mailto:AppleIPR159-1@knobbe.com)>; AppleIPR159-2 <[AppleIPR159-2@knobbe.com](mailto:AppleIPR159-2@knobbe.com)>; AppleIPR743-1 <[AppleIPR743-1@knobbe.com](mailto:AppleIPR743-1@knobbe.com)>  
**Subject:** Re: IPR2024-00241, -00243, -00244 - Request for authorization for motion to strike or to introduce evidence with sur-replies

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Dear Board,

Further to our February 21 email, Patent Owner Masimo Corporation respectfully requests the Board authorize Masimo in IPR2024-00241, -243, and -244 to file a motion to strike new references and arguments in Apple's reply. Alternatively, Masimo requests the Board waive 37 C.F.R. § 42.23(b) to permit Masimo to submit evidence with its sur-replies. Masimo met and conferred with Apple and Apple indicated it opposes both requests.

Masimo's requests concern the following new evidence and arguments:

**First**, in the 241 IPR, Apple submitted 29 new references on reply (Exhibits 1014, 1028, 1032, 1037-1042, 1044-1049, 1080-1085, 1088-1095) and introduced new arguments about them. In the 243 and 244 IPR, Apple submitted some of those references and made new arguments about them. These references and arguments were not part of the record previously and Masimo had no opportunity to present expert testimony regarding them. Several exhibits, such as EX1080, 1082, and 1084, were also subject to protective orders in IPR2022-01291 and not encompassed by the parties' cross-use agreement. Thus, they were not available to Masimo earlier.

**Second**, in the 241 and 244 IPRs, Apple's new expert declarations (241-EX1079, ¶36, 244-EX1079, ¶33) respond to an opinion in Dr. Madisetti's 243 declaration that was unique to the 243 IPR (243-EX2100, ¶86). Specifically, in the 243 IPR only, Apple presented a motivation to combine argument regarding measuring oxygen saturation at the wrist through motion. Masimo's expert responded only in the 243 IPR and did not have a chance to respond in the 241 and 244 IPRs.

**Third**, in all three proceedings, Apple submitted EX1080, which is the cross-examination deposition transcript of a different Masimo expert, Dr. Duckworth, from IPR2022-01291 and -1465. Apple's citations to Duckworth's cross-examination testimony, without providing his direct testimony for evaluation, is misleading and creates an incomplete record. At a minimum, the Board should allow Masimo to complete the record by submitting Dr. Duckworth's direct testimony declarations (EX2070 and EX2100 from IPR2022-01291). See Fed. R. Evid. 106 ("If a party introduces all or part of a statement, an adverse party may require the introduction, at that time, of any other part — or any other statement — that in fairness ought to be considered at the same time.").

Apple requested that the following be included:

Apple opposes Masimo's requests for at least the following reasons:

- 1) Masimo's Request for Authorization to file Motions to Strike – Apple disagrees with Masimo's characterizations of Apple's Petitioner Reply arguments and accompanying evidence, which were properly responsive to arguments and evidence submitted in Masimo's Patent Owner Responses. Apple respectfully submits that Masimo has not and cannot show good cause for motions to strike, and further that the Board is in good position to assess the parties' respective arguments and evidence and to accord them the proper weight.

- 2) Masimo's Request for Waiver of 37 C.F.R. § 42.23(b) to Allow Submission of New Evidence with Sur-Replies – Apple respectfully submits that Masimo has not and cannot show good cause for waiver of the rules governing submission of new evidence with Sur-Replies, at least because Masimo had opportunity to present sought-after evidence with its Responses and failed to do so, and because Masimo is no way prejudiced by Apple's presentation of responsive arguments and evidence of which Masimo was already aware at the time of its Response filings.

The parties are available for a teleconference at the following times:

- Monday, March 3 at 12:30-2:30pm and 3:30-5pm ET
- Tuesday, March 4 at 4-5pm ET

If possible, Masimo would appreciate at least one business day notice of the teleconference to arrange a court reporter. If these times do not work for the Board, the parties will provide alternate availability.

Best regards,  
Daniel

**Daniel Kiang**

Partner

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**From:** Daniel Kiang <[Daniel.Kiang@knobbe.com](mailto:Daniel.Kiang@knobbe.com)>

**Date:** Friday, February 21, 2025 at 6:06 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

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**Subject:** IPR2024-00241, -00243, -00244 - Request for authorization for motion to strike or to introduce evidence with sur-replies

Dear Board,

Patent Owner Masimo Corporation respectfully requests the Board authorize Masimo in IPR2024-00241, -243, and -244 to file a motion to strike new references and arguments in Apple's replies or requests authorization to waive 37 C.F.R. § 42.23(b) to permit Masimo to submit evidence with its sur-replies. Masimo is sending this email today because the Consolidated Trial Practice Guide indicates that parties should request authorization within one week of receiving the objectionable

material. CTPG at 81. Masimo contacted Apple to meet and confer and Apple indicated that its first availability is on Tuesday, February 25. After the meet and confer, we will respond to this email and let the Board know the parties' respective positions and availability for a conference call.

Best regards,  
Daniel

**Daniel Kiang**

Partner

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