

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Petitioner

Case IPR2024-00290
U.S. Patent 8,190,223

**PETITIONER'S NOTICE OF INTENT TO DESIGNATE MICHAEL
AMON, A PROVISIONALLY RECOGNIZED PTAB ATTORNEY, AS
BACK-UP COUNSEL UNDER 37 C.F.R. § 42.10(c)**

EXHIBIT LIST

APPLE-1001	U.S. Patent No. 8,190,223 (“the ’223 Patent”)
APPLE-1002	U.S. Patent No. 8,190,223 File History
APPLE-1003	Declaration of Dr. Cockburn
APPLE-1004	U.S. Patent No. 6,707,476 (“Hochstedler”)
APPLE-1005	U.S. Patent Pub. No. 2002/0184055 (“Naghavi”)
APPLE-1006	U.S. Patent Pub. No. 2006/0064020 (“Burnes”)
APPLE-1007	U.S. Patent No. 6,151,518 (“Hayashi”)
APPLE-1008	U.S. Patent No. 5,842,979 (“Jarman”)
APPLE-1009	U.S. Patent No. 6,385,471 (“Mortz”)
APPLE-1010	U.S. Patent No. 6,584,336 (“Al-Ali-336”)
APPLE-1011	U.S. Patent Pub. No. 2003/0181798 (“Al-Ali-798”)
APPLE-1012	U.S. Patent Pub. No. 2003/0009119 (“Kamm”)
APPLE-1013	U.S. Patent Pub. No. 2003/0145852 (“Schmidt”)
APPLE-1014	U.S. Patent Pub. No. 2004/0204637 (“Diab-637”)
APPLE-1015	U.S. Patent No. 6,654,624 (“Diab”)
APPLE-1016	U.S. Patent No. 5,331,549 (“Crawford”)
APPLE-1017	U.S. Patent Pub. No. 2003/0092974 (“Santoso”)

APPLE-1018	U.S. Patent No. 6,912,413 (“Rantala”)
APPLE-1019	U.S. Patent No. 6,658,276 (“Kianl”)
APPLE-1020	U.S. Re-examination No. 90/012,559 File History
APPLE-1021	U.S. Patent Pub. No. 2002/0015034 (“Malmberg”)
APPLE-1022	Second Declaration of Dr. Cockburn
APPLE-1023	Excerpt from Wiley Electrical and Electronics Engineering Dictionary, John Wiley & Sons, Inc. (2004)
APPLE-1024	Excerpt from Merriam-Webster’s Collegiate Dictionary, Merriam-Webster, Incorporated (2005)
APPLE-1025	Transcript of Remote Deposition of R. James Duckworth, Ph.D.
APPLE-1026-1059	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) (“ <i>Director’s Guidance</i> ”)
APPLE-1062	Apple’s Complaint for Patent Infringement (Design), <i>Apple Inc., v Masimo Corporation, et al.</i> , Case No. 1-22-cv-01377 (D. Del. Oct. 20, 2022)
APPLE-1063	Apple’s Complaint for Patent Infringement (Utility), <i>Apple Inc., v Masimo Corporation, et al.</i> , 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 – 1074 [RESERVED]
- 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: [MedDispTimeMERITS-Table-FY23.pdf \(uscourts.gov\)](#)
- APPLE-1078 *Sotera* Stipulation by Apple Inc.

- APPLE-1079 Petitioner's Demonstratives
- APPLE-1080 Transcript of Remote Deposition of Dr. R. James Duckworth
(April 25, 2025)
- APPLE-1081 Declaration of Michael Amon in Support of Notice of Intent to
Designate a Provisionally Recognized PTAB Attorney

Pursuant to the email of April 22, 2025, authorizing filing of this notice, Petitioner, Apple Inc., respectfully notifies the Board of its intent to designate Michael Amon, a provisionally recognized PTAB attorney, as back-up counsel in this proceeding. Petitioner seeks the counsel of Michael Amon due to his experience in representing Petitioner in other patent-related matters and particularly due to his familiarity with the substantive and technical issues involved in this proceeding. The Board previously granted *pro hac vice* admission of Michael Amon in IPR2023-00948, IPR2023-00949, IPR2022-00872, IPR2022-01186, and IPR2022-00651.

1. Lead Counsel

W. Karl Renner, Reg. No. 41,265 serves as lead counsel in this proceeding.

2. Accompanying Certification

Michael Amon satisfies all requirements set forth by the Board for *pro hac vice* recognition of a provisionally recognized PTAB attorney and agrees to be subject to the USPTO Rules of Professional Conduct set forth in §§ 37 C.F.R. § 11.101 *et seq.* and disciplinary jurisdiction under § 11.19(a). This Notice of Intent To Designate a Provisionally Recognized PTAB Attorney as Back-Up Counsel is accompanied by a Declaration of Michael Amon.

Petitioner submits that Michael Amon has satisfied all requirements to be deemed admitted *pro hac vice* in this proceeding.

Respectfully submitted,

Dated: June 3, 2025

/Grace J. Kim/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.8(b), the undersigned certifies that on June 3, 2025, a complete and entire copy of this Petitioner's Notice of Intent to Designate Michael Amon were provided via email to the Patent Owner by serving the correspondence email addresses of record as follows:

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