

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner

Case IPR2024-00294
U.S. Patent 10,736,507

**PETITIONER'S MOTION FOR AUTHORIZATION
TO SEEK A SUBPOENA UNDER 37 C.F.R. § 42.52(a)
TO COMPEL TESTIMONY OF GORDON MACPHERSON**

Pursuant to the Board’s February 4, 2025 email, Petitioner Apple Inc. (“Apple”) hereby moves under 37 C.F.R. § 42.52(a) for authorization to seek a subpoena to compel the testimony of Mr. Gordon MacPherson.

I. BACKGROUND

Mr. MacPherson¹ is a third-party fact witness not under Apple’s control, whose declaration² Apple submitted to further demonstrate public availability of a ground reference: L. D’Angelo, et al., “A Sensor Network to iPhone Interface Separating Continuous and Sporadic Processes in Mobile Telemedicine.”³

On January 17, 2025, Apple received a request from Patent Owner Masimo Corporation (“Masimo”) to cross-examine Mr. MacPherson. Upon receiving Masimo’s request, Apple promptly asked Mr. MacPherson for his availability, but learned that Mr. MacPherson’s employer, IEEE, requires a subpoena for any deposition testimony.

¹ Mr. MacPherson is a Director, Board Governance & Policy Development of the Institute of Electrical and Electronics Engineers, Incorporated (“IEEE”), a third party. *See* APPLE-1082, 1.

² *See* APPLE-1082.

³ *See* APPLE-1007.

On January 21, upon learning that IEEE would not make Mr. MacPherson available for deposition, Apple informed Masimo of IEEE's position and asked whether Masimo would agree to approach the Board to request a joint motion for a subpoena to compel the testimony of Mr. MacPherson. On January 27, Masimo responded by stating: "Masimo requested to depose Mr. MacPherson and it is Apple's obligation to secure its declarant for a deposition. Accordingly, Masimo will not oppose Apple moving for authorization to subpoena Mr. MacPherson to be deposed in this proceeding."

On January 28, Apple emailed the Board, indicating that although it does not agree with Masimo that a deposition is necessary, Apple would nevertheless be willing to satisfy its related duty to secure the declarant by filing a motion for the Board's consideration.

On February 4, the Board granted authorization via email, and to fulfil its obligation of providing Masimo with an opportunity for the cross-examination of Mr. MacPherson, Petitioner now files this motion.

Based on the limited scope of Mr. MacPherson's declaration, Apple respectfully requests that his deposition be limited to sixty minutes of cross-examination and 30 minutes of redirect. *See* APPLE-1082.

II. LEGAL PRINCIPLES

Cross-examination of the opposing party's declarants is typically provided under routine discovery. 37 C.F.R. § 42.51(b)(1)(ii). If the declarant is unwilling to appear voluntarily, a party in a contested case before the Patent and Trademark Office may apply to a United States District Court for a subpoena to compel testimony. 35 U.S.C. § 24. A party seeking a subpoena to compel testimony must first obtain authorization from the Board. 37 C.F.R. §42.52(a).

III. ARGUMENT

Masimo has requested to cross-examine Mr. MacPherson regarding his declaration as part of routine discovery under 37 C.F.R. § 42.51(b)(1)(ii). Because IEEE requires a subpoena for deposition testimony, the parties' only option to facilitate deposition is to seek a subpoena. 35 U.S.C. § 24; 37 C.F.R. §42.52(a). Masimo opted against joining this motion, but in fulfillment of its duty Apple nevertheless requests that the Board authorize the parties (singly or jointly) to apply for a subpoena for at least the following reasons.

First, authorizing the parties to apply for a subpoena would also be consistent with the mandate that the Board "secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). Authorizing the subpoena would provide Masimo with the opportunity to cross-examine the

declarant it has requested and also obviate the need for any motion practice as to why Petitioner may be permitted to rely on the declaration in this proceeding if Mr. MacPherson cannot be cross-examined in the present IPR proceeding.

Second, Petitioner proposes limiting the deposition to sixty minutes of cross-examination and 30 minutes of redirect to minimize any burden on Mr. MacPherson and IEEE. Such a time-limited deposition would strike the appropriate balance of limiting the burden on a third party while also providing for the cross examination of affiant testimony set forth at 37 C.F.R. § 42.51(b)(1)(ii). *See, e.g., Chicago Mercantile Exchange, Inc. v. 5th Market, Inc.*, CBM2015-00061, Paper 25 at 5-6 (PTAB Nov. 17, 2015).

Third, although the Board has in some cases required a party wishing to depose a third-party fact witness to identify what information they are hoping to receive from the witness during their deposition and how such information would potentially affect the IPR proceeding, and Masimo has not done so in the instant case, the Board has granted authorization to seek a subpoena under similar circumstances. *See Johns Manville v. Knauf Insulation*, IPR2015-01453 Paper 16 at 3 (PTAB Mar. 14 2016) (“Mr. Butler is an uninterested third-party witness, and a cross examination is a significant inconvenience in time and energy where he has already submitted what appears to be an appropriate attestation to his knowledge

and actions with respect to the evidence at issue”), Paper 36 at 1-2 (granting patent owner its sought-after authorization to seek a subpoena); *Chicago Mercantile*, CBM2015-00061, Paper 25 at 6; *Marvell Semiconductor, Inc. v. Intellectual Ventures LLC*, IPR2014-00553, Paper 28 at 3 (PTAB Apr. 8, 2015).

IV. CONCLUSION

For the reasons provided above, Apple respectfully requests that the Board authorize the parties (singly or jointly) to seek a subpoena to compel the deposition of Mr. MacPherson, limited to sixty minutes of cross-examination and 30 minutes of redirect. In that regard, Apple respectfully submits that, as the party seeking Mr. MacPherson’s deposition, Masimo should join Apple in seeking the subpoena.

Respectfully submitted,

Date: February 11, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on February 11, 2025, a complete and entire copy of this Petitioner's Motion for Authorization to Seek a Subpoena Under 37 C.F.R. § 42.52(a) to Compel Testimony of Gordon MacPherson was provided via email to Patent Owner by serving the correspondence email addresses of record as follows:

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