

**From:** [Douglas Wentzel](#)  
**To:** [Trials](#); [Grace Kim](#); [AppleIPR507-2](#); [IPR50095-0135IP2](#)  
**Subject:** Re: IPR2024-00294 - Requesting an Unopposed Motion for Authorization to Seek a Subpoena  
**Date:** Wednesday, February 12, 2025 6:29:12 PM

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Dear Board,

While Masimo agrees that 60 minutes is reasonable for its cross-examination of the declarant, 30 minutes for Apple's redirect is disproportionate. Given the narrow scope of this deposition, and to ensure any redirect is within the scope of Masimo's cross-examination, Masimo submits that Apple should be limited to 15 minutes of redirect. Masimo should also be granted 15 minutes of re-cross. To the extent the Board grants more than 15 minutes for Apple's redirect, Masimo should be granted a corresponding increase in re-cross examination time.

Masimo also disagrees with Apple's assertion that "Masimo should join Apple in seeking the subpoena." Mot. at 5. As the Board previously explained, Masimo is entitled to cross-examine Mr. MacPherson because Apple relies on his declaration in this proceeding. Accordingly, Apple alone should seek the subpoena and secure Mr. MacPherson's deposition so that Masimo can cross-examine this Apple declarant.

Masimo further requests its Sur-Reply deadline be moved by one week to February 28 to provide time for Apple to secure Mr. MacPherson's deposition and Masimo to depose this declarant before submitting its Sur-Reply. Then, if Mr. MacPherson is not made available for deposition by February 21, the parties can jointly request another extension to Masimo's Sur-Reply date to ensure adequate time to complete the deposition before Masimo's Sur-Reply is due.

Sincerely,

Doug

**Douglas Wentzel**  
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**From:** Trials <Trials@USPTO.GOV>  
**Date:** Wednesday, February 12, 2025 at 12:59 PM  
**To:** Trials <Trials@USPTO.GOV>, Grace Kim <gkim@fr.com>, AppleIPR507-2 <AppleIPR507-2@knobbe.com>, IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>

**Subject:** RE: IPR2024-00294 - Requesting an Unopposed Motion for Authorization to Seek a Subpoena

Good afternoon counsel,

From the Board –

Petitioner's Motion for Authorization to Seek a Subpoena under 37 C.F.R. § 42.52(a) requests that the deposition be limited to 60 minutes of cross-examination and 30 minutes of redirect. Although this time limit seems reasonable given the nature of the testimony and given that the witness is an uncompensated 3<sup>rd</sup> party, we request that Patent Owner promptly advise, by a return email, cc'ing Petitioner, whether it has any concerns regarding its ability to effectively cross-examine the witness in this time frame and/or whether it has any other concerns regarding Petitioner's Motion. We authorize Patent Owner to include substantive argument in the email response if necessary. This authorization does not extend to any other email correspondence with the Board.

Regards,

Esther Goldschlager  
Supervisory Paralegal Specialist  
Patent Trial & Appeal Board  
U.S. Patent & Trademark Office

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**From:** Trials <Trials@USPTO.GOV>

**Sent:** Tuesday, February 4, 2025 7:31 AM

**To:** Grace Kim <gkim@fr.com>; AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>

**Cc:** Trials <Trials@USPTO.GOV>

**Subject:** RE: IPR2024-00294 - Requesting an Unopposed Motion for Authorization to Seek a Subpoena

Counsel,

Apple's unopposed request to file a Motion for Authorization to Seek a Subpoena under 37 C.F.R. § 42.52(a) is granted. We will not require Masimo to provide justification for the subpoena. Such justification stems from Masimo's entitlement to cross-examine witnesses whose testimony has been proffered in this proceeding.

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:** Grace Kim <[gkim@fr.com](mailto:gkim@fr.com)>

**Sent:** Tuesday, January 28, 2025 5:59 PM

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

**Cc:** AppleIPR507-2 <[AppleIPR507-2@knobbe.com](mailto:AppleIPR507-2@knobbe.com)>; IPR50095-0135IP2 <[IPR50095-0135IP2@fr.com](mailto:IPR50095-0135IP2@fr.com)>

**Subject:** IPR2024-00294 - Requesting an Unopposed Motion for Authorization to Seek a Subpoena

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Your Honors,

In support of Masimo's desire to depose a third-party fact witness whose declaration Apple submitted, Petitioner Apple respectfully requests the Board's permission to file an unopposed Motion for Authorization to Seek a Subpoena under 37 C.F.R. § 42.52(a). Briefly, the facts relevant to this request are as follows:

- On January 17, Petitioner Apple received a request from Patent Owner Masimo for a deposition of Gordon MacPherson, a third-party fact witness not under Apple's control, whose declaration (Ex. 1082) Apple submitted to demonstrate public availability of a ground reference (Ex.1007). Upon receiving Masimo's request, Apple promptly asked Mr. MacPherson for his availability
- On January 21, after learning that IEEE would not make Mr. MacPherson available for deposition, Apple informed Masimo of IEEE's position, and asked if Masimo would agree to request Board permission to file a Joint Motion for Authorization to Seek a Subpoena under 37 C.F.R. § 42.52(a).
- In its January 27 response, Masimo did not agree to file a joint motion, and instead stated:
  - "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."

Apple does not agree with Masimo that a deposition is necessary, but would nevertheless be willing to satisfy its related duty to secure the declarant by filing a motion for the Board's consideration. However, Apple respectfully submits that attempted justification for the subpoena must come from Masimo, and that Masimo should be the party seeking the subpoena.

Should the Board desire a call to discuss this request, the parties are jointly available at the following days and times this week:

- Wednesday (1/29) from 12:00 – 2:00 pm Eastern;

- Thursday (1/30) from 12:00 – 2:00 pm Eastern; and
- Friday (1/31) from 12:00 – 2:00 pm Eastern.

Respectfully,

Grace Kim  
Counsel for Petitioner Apple

**Grace Kim :: Principal :: Fish & Richardson P.C.**  
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[fr.com](http://fr.com) :: [Bio](#) :: [LinkedIn](#)

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