

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2024-00294
Patent 10,736,507 B2

Before RICHARD H. MARSCHALL, DAVID COTTA, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

ORDER

Authorization to Apply for Subpoena from Federal District Court
35 U.S.C. § 24 and 37 C.F.R. § 42.52(a)

On February 11, 2025, with our prior authorization, Petitioner moved under 37 C.F.R. § 42.52(a) for authorization to seek a subpoena to compel the testimony of Mr. Gordon MacPherson. Paper 38. Mr. MacPherson is a third-party fact witness, not under Petitioner's control, whose declaration Petitioner submitted to support the public availability of an alleged prior art reference. *Id.* at 1; *see also*, Ex. 1082 (Declaration of Gordon MacPherson). Petitioner asserts that a subpoena is necessary in order to secure Mr. MacPherson's cross-examination testimony. *Id.* Patent Owner does not oppose Petitioner's request. Ex. 3003.

Having reviewed Mr. MacPherson's testimony, and having determined that Patent Owner is entitled to cross-examine Mr. MacPherson under 37 C.F.R. § 42.51(b)(1)(ii), we hereby grant Petitioner authorization under 37 C.F.R. § 42.52(a) to compel the deposition of Mr. MacPherson.

Patent Owner requests that, in view of the time necessary to arrange for and take Mr. MacPherson's deposition, we move its Sur-reply deadline from February 21 to February 28. We modified the schedule for this case just two days ago. Paper 39. At present, we lack information regarding when Mr. MacPherson is available for deposition. Accordingly, we will not, at this time, step in again to modify the case schedule. The parties are, of course, free to stipulate to a different date for Patent Owner's Sur-reply. *See* Paper 12.

It is hereby,

ORDERED that Petitioner is permitted under 35 U.S.C. § 24 to apply for a subpoena from the Clerk of the United States Court for the district where testimony of Gordon MacPherson is to be taken;

FURTHER ORDERED that Patent Owner shall be permitted to attend the deposition and to conduct cross-examination of Mr. MacPhearson; and

FURTHER ORDERED that the deposition shall be limited to one hour of cross-examination by Patent Owner on the subject matter of Mr. MacPherson's declaration (Exhibit 1082), twenty minutes of re-direct examination by Petitioner, and ten minutes of re-cross examination by Patent Owner.

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