

From: [Trials](#)
To: [Grace Kim](#); [Trials](#)
Cc: [AppleIPR507-2](#); [IPR50095-0135IP2](#)
Subject: RE: IPR2024-00294: Authorization to File a Motion to Strike and Observations Relating to Mr. MacPherson's Cross-Examination Testimony
Date: Friday, March 14, 2025 3:42:07 PM

Counsel,

Petitioner's request for authorization to file a Motion to Strike is granted. Petitioner may file a three-page Motion to Strike. Petitioner's motion shall be filed on or before March 21, 2025 and is limited to the subject matter of new argument allegedly raised in Patent Owner's Sur-reply. Patent Owner is authorized to file a three-page Opposition to Petitioner's Motion to Strike. Patent Owner's Opposition shall be filed on or before March 28, 2025 and shall be limited to addressing the arguments presented in Petitioner's Motion.

Petitioner's request to file observations identifying Mr. MacPherson's cross-examination testimony is also granted. Petitioner's observations shall be a list in the form: "In response to Patent Owner's citation to the transcript at ___, Petitioner cites the transcript at ___ for context." Petitioner's observations shall not include any further argument or commentary.

Regards,

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

From: Grace Kim <gkim@fr.com>
Sent: Thursday, March 13, 2025 10:21 PM
To: Trials <Trials@USPTO.GOV>
Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>
Subject: IPR2024-00294: Authorization to File a Motion to Strike and Observations Relating to Mr. MacPherson's Cross-Examination Testimony

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Your Honors,

Petitioner Apple inc. respectfully requests the Board's authorization to file in the above-captioned proceeding:

1. a motion to strike an impermissible new argument presented in Masimo's Patent Owner's Sur-Reply; and
2. a paper (observations) identifying Mr. MacPherson's cross-examination testimony that provides the context Petitioner desires the Board to consider, in a concise fashion without argument that focuses on key portions of the testimony.

Motion to Strike

Patent Owner Masimo's recently-filed Sur-Reply presents a new argument in which Masimo attempts to distinguish the applied prior art based on a new interpretation of "one or more signals responsive to light". See Paper 47 (Sur-Reply) at 1-7.

Masimo did not raise this argument regarding its new interpretation of "one or more signals responsive to light" in its Patent Owner's Response, which instead presents a different interpretation of the same claim terms. Paper 17 (POR) at 2, 18-25. Accordingly, Apple respectfully requests authorization to file a motion to strike.

Authorization to File Observations

Masimo's Sur-Reply in this proceeding cites to excerpts of Mr. MacPherson's February 27, 2025 deposition testimony.

Apple believes that identification of uncited testimony would provide context for the relied-upon excerpts that would be helpful in advance of oral hearing.

Accordingly, Apple requests authorization to file a paper (observations) in this proceeding identifying Mr. MacPherson's cross-examination testimony that provides the context Petitioner desires the Board to consider, in a concise fashion without argument that focuses on key portions of the testimony, like the paper previously authorized in IPR2020-01536. See *Apple Inc. v. Masimo Corporation*, IPR2020-01536, Ex. 1052 (PTAB November 22, 2021) ("Petitioner is authorized to file a Paper in each proceeding identifying Dr. Kenny's cross-examination testimony that provides the context Petitioner desires the Board to consider, in a concise fashion without argument that focuses on key portions of the testimony"); see also, *id.*, Pap. 38 (Petitioner's Identification of Testimony); *Zhongshan Broad Ocean Motor Co., Ltd. et al. v. NIDEC Motor Corp.*, IPR2014-01122 Pap. 34 (PTAB Sept. 10, 2015); *Micron Technology, Inc. v. Innovative Memory Systems, Inc.*, IPR2016-00330 Pap. 33 (March 8, 2017).

Counsel for Apple and counsel for Masimo have met and conferred regarding the above requests and Masimo opposes as explained below.

Motion to Strike

Apple does not specify above the allegedly new claim interpretation. Masimo disagrees that it changed its claim interpretation. Masimo's Sur-Reply and POR used the same bases to

distinguish the claims from the prior art. Masimo explained its interpretation of “one or more signals responsive to light” in its POR at pages 18–25, and responded to Apple’s resulting arguments (e.g., Reply at 14–15) based on the same interpretation of this same phrase in Masimo’s Sur-Reply (e.g., pages 1–12).

Observations

Apple’s request for “observations” that are “like the paper previously authorized in IPR2020-01536” is imprecise about their format and content. Masimo opposes Apple’s request if it seeks observations of the form that were discontinued and replaced by sur-reply practice. See Consolidated Trial Practice Guide at 74. Masimo would not oppose Apple filing a paper under the same constraints authorized in IPR2020-01536, including that the paper is a one-page “listing ... taking the form of: ‘In response to Patent Owner’s citation to the transcript at ___, Petitioner cites the transcript at ___ for context.’” See *Apple Inc. v. Masimo Corporation*, IPR2020-01536, Ex. 1052 (PTAB November 22, 2021).

Should the Board desire a call to address these requests, the parties are mutually available on Tuesday, March 18, starting at 2 p.m. Eastern Time.

Respectfully submitted,

Grace Kim
Counsel for Petitioner Apple

Grace Kim :: Principal :: Fish & Richardson P.C.
612 337 2510 direct :: gkim@fr.com
fr.com :: [Bio](#) :: [LinkedIn](#)

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