

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 TO STRIKE
PATENT OWNER'S MOTION TO AMEND**

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LIST OF EXHIBITS

APPLE-1001	U.S. Patent No. 10,736,507 (“the ’507 patent”)
APPLE-1002	U.S. Patent No. 10,736,507 File History
APPLE-1003	Declaration of Dr. Thomas Kenny
APPLE-1004	RESERVED
APPLE-1005	U.S. Patent Application Pub. No. 2008/0004904 to Tran (“Tran”)
APPLE-1006	U.S. Patent No. 6,658,276 to Kianl et al. (“Kianl”)
APPLE-1007	Lorenzo T. D’Angelo, et al., A Sensor Network to iPhone Interface Separating Continuous and Sporadic Processes in Mobile Telemedicine, 33rd Annual International Conference of the IEEE EMBS Boston, Massachusetts USA, August 30 - September 3, 2011 (“D’Angelo”)
APPLE-1008	U.S. Patent No. 7,812,826 to Ording et al. (“Ording”)
APPLE-1009	U.S. Patent Application Pub. No. 2007/0093786 to Goldsmith et al. (“Goldsmith”)
APPLE-1010	U.S. Patent Application Pub. No. 2010/0324387 to Moon et al. (“Moon”)
APPLE-1011	Y. Mendelson, et al., A Wearable Reflectance Pulse Oximeter for Remote Physiological Monitoring, Proceedings of the 28th IEEE EMBS Annual International Conference New York City, USA, Aug 30-Sept 3, 2006 APPLE-1012 Declaration of June Munford APPLE-1013 U.S. Patent No. 8,195,848 to Jones (“Jones”)

APPLE-1014	Exemplary Infringement Claim Chart for the '507 patent from Apple Inc. v. PO Corporation et al., Case No. 1-22-cv-01378 (D. Del. Oct. 20, 2022)
APPLE-1015	Exemplary Infringement Claim Chart for the '911 patent from Apple Inc. v. PO Corporation et al., Case No. 1-22-cv-01378 (D. Del. Oct. 20, 2022)
APPLE-1016 – 1059	[RESERVED]
APPLE-1060	U.S. District Courts—Combined Civil and Criminal Federal Court Management Statistics (Sep. 30, 2023) United States Courts (uscourts.gov), https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2023.pdf
APPLE-1061	Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Director’s Guidance”)
APPLE-1062	Apple’s Complaint for Patent Infringement (Design), Apple Inc., v PO Corporation, et al., Case No. 1-22-cv-01377 (D. Del. Oct. 20, 2022)
APPLE-1063	Apple’s Complaint for Patent Infringement (Utility), Apple Inc., v PO Corporation, et al., Case No. 1-22-cv-01378 (D. Del. Oct. 20, 2022)
APPLE-1064	Defendant PO Corporation’s Answer to Complaint and Counterclaims, Apple Inc., v PO 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 PO Corporation, et al., Case No. 1-22-cv01378 (D. Del. Sep. 21, 2023)

APPLE-1066 Stipulation by Apple Inc.

APPLE-1067 Email Identifying PO's District Court Invalidity Grounds (Nov. 16, 2023)

APPLE-1068 Excerpt of Apple's District Court Expert Invalidity Report, *Apple Inc., v PO 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 PO 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 \(uscourts.gov\)](https://www.uscourts.gov/sites/default/files/MedDispTimeMERITS-Table-FY23.pdf)

APPLE-1078 *Sotera* Stipulation by Apple Inc.

APPLE-1079 Board Email Authorizing Motion to Strike and Evidence

APPLE-1080 Email Record of Meet-and-Confer Regarding Patent Owner Response, Petitioner Reply, and Patent Owner Sur-Reply Deadline Extensions

APPLE-1081 Email Record of Meet-and-Confer Regarding Motion to Strike

Petitioner, Apple Inc., respectfully asks the Board to strike Patent Owner Masimo's untimely Motion to Amend (MTA).

I. Patent Owner Missed the Board's Express Deadline for Filing the MTA, which the Parties' Stipulations did not Modify

Patent Owner cannot reasonably dispute that it missed the MTA's filing deadline by over 3 weeks. The Board's Scheduling Order specifies that two distinct papers were due September 16, 2024: (1) "Patent Owner's response to the petition", and (2) "Patent Owner's motion to amend the patent (MTA)." Pap. 12, 11. The parties' subsequent stipulation specifically modified due dates for just one of these papers – the "Patent Owner's Response to the petition," and correspondingly, the "Petitioner's Reply to Patent Owner's Response to Petition," and the "Patent Owner's Sur-reply to Reply," without addressing the MTA's September 16 deadline. Pap. 14, 1; *see also* Pap. 16, 1.

Paper 14 captures the parties' agreement within its four corners, and deviation from the stipulation's plain language is neither justified nor supported by extrinsic evidence. The parties conducted the meet-and-confer that produced the stipulation exclusively by email, and APPLE-1080 captures the entirety of that email exchange. Notably, the parties reached agreement after Apple specifically proposed "moving the due date for the POR to October 10," and Patent Owner edited and approved the draft stipulation capturing that proposal prior to filing.

APPLE-1080, 5, 2 (“With those edits, you have Masimo’s approval to file the joint stipulations”). Accordingly, neither the stipulation nor extrinsic evidence justify Masimo’s untimely filing.

II. Patent Owner Should Not be Excused from Missing its Deadline

Patent Owner could not reasonably have misunderstood that the parties had agreed to change deadlines beyond those expressly modified by stipulation.

First, the Paper 14 stipulation that Patent Owner edited and approved unambiguously modifies due dates associated only with a specific set of papers, not including the MTA. *See* Pap. 14, 1. And, even if it were necessary to look to extrinsic evidence to determine that stipulation’s meaning (it is not), the extrinsic evidence further supports that the parties left the MTA deadline unchanged. *See* APPLE-1080, 5 (Apple email proposing modifications only to Response, Reply, and Sur-Reply dates), 4 (“Masimo agrees to stipulate to moving the IPR2024-00294 and IPR2024-00296 due dates as proposed in your email”). Patent Owner’s new suggestion that Paper 14 “does not reflect the full scope of the parties’ agreement” is simply unreasonable. *See* APPLE-1081, 4.

Second, the parties *could not* have agreed to have moved each of the portions Due Dates 1, 2, and 3 associated with a potential MTA and subsequent papers, as Patent Owner now contends. *See* APPLE-1081, 4. The Scheduling Order

plainly states that “[t]he parties may not stipulate to a different date” for the portions of Due Dates 2 and 3 related to a MTA “without prior authorization from the Board.” Pap. 12, 8.

Third, Apple *would not* have agreed to have moved each of the portions Due Dates 1, 2, and 3 associated with a potential MTA and subsequent papers, even if Patent Owner had specifically proposed such modifications during the meet-and-confer. More, Patent Owner and its counsel were well-aware that stipulated modifications to Response, Reply, and Sur-Reply dates do not change MTA-related deadlines, because that precise distinction was expressly made in an earlier IPR between the same parties and involving at least one of the same attorneys for Patent Owner. Specifically, in IPR2023-00745, Apple and Masimo negotiated a stipulation that similarly changed only the Response date and not the MTA date, and Apple as Patent Owner abided by the unchanged MTA deadline. *See* IPR2023-00745 Paps. 11, 13 (Response filed 1/22/24), 15 (MTA filed 1/8/24). Masimo could and should have similarly complied with its deadlines in this case.

III. Apple Would be Unfairly Prejudiced if Patent Owner’s Untimely MTA Remains in Effect

Insufficient time remains for Apple to have fair opportunity to respond to Patent Owner’s late MTA.

To Apple's detriment, Patent Owner effectively asks to be retroactively awarded for its non-compliance with 24 days of additional MTA preparation time.

Rightly believing that Patent Owner's September 16 MTA deadline had already passed, Apple allocated resources accordingly. But Apple has since October 10 needed to review the MTA and to develop new evidence and arguments on an accelerated basis (accounting for the limited amount of time available prior to a potential December 6 opposition deadline), while at the same time expending resources on the present motion addressing Patent Owner's late filing.

If the Board were to allow Patent Owner's untimely MTA, it would be manifestly unfair for Apple to lose weeks of opposition preparation time based on Patent Owner's missed deadline. Yet, whether it would even be possible to accommodate Patent Owner's untimely MTA while otherwise allowing Apple adequate opportunity to oppose, all while concluding the instituted IPR within one year, is unclear. This is particularly the case as Patent Owner has requested preliminary guidance.

Customarily, Apple would have as much time to prepare its opposition as Patent Owner enjoyed when preparing its MTA. In this instance, Patent Owner by missing its deadline took 105 days after institution to prepare its MTA.

Yet, if the Board were to deny Apple's motion to strike and instead excuse Patent Owner's missed deadline while allowing Apple the same 105 days for preparation of its opposition, that opposition would be due February 28. This would leave only 120 days for completion of all filings related to the MTA (including those associated with Patent Owner's request for preliminary guidance) prior to the Board's June 27 deadline for Final Written Decision. Whether such a schedule would allow the parties and the Board sufficient time to address the issues raised by Patent Owner's MTA is presently unclear, but doubtful.

For at least this additional reason, the appropriate response to Patent Owner's missed deadline is to strike the MTA.

IV. Striking the MTA would Not Unfairly Prejudice Patent Owner

If the Board were to grant the instant motion, Patent Owner would not be unfairly prejudiced. Beyond that outcome being the natural consequence of Patent Owner missing its deadline by over 3 weeks, the '507 patent family is still pending. *See* U.S. Patent Application No. 18/600,430. As such, Patent Owner has ample opportunity to pursue its proposed amendments within pending or new applications, without the complications or unfairness that would flow from Patent Owner's actions in this proceeding. For at least this additional reason, the appropriate response to PO's missed deadline is to strike the MTA.

Respectfully submitted,

Date: 10/29/2024

/Grace J. Kim/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on October 29, 2024, a complete and entire copy of this Petitioner's Motion to Strike Patent Owner's Motion to Amend was provided via email to Patent Owner by serving the correspondence email addresses of record as follows:

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