

From: Trials <Trials@USPTO.GOV>

Sent: Thursday, October 24, 2024 1:06 PM

To: Grace Kim <gkim@fr.com>; Rick Bisenius <bisenius@fr.com>; Douglas Wentzel <Douglas.Wentzel@knobbe.com>; AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: IPR2024-00294 – Request for October 9 Conference re Contingent Motion to Amend - Petitioner's Motion to Strike PO's MTA

Counsel,

Petitioner's request for permission to file a Motion to Strike Patent Owner's Motion to Amend is granted. Briefing in connection with Petitioner's Motion shall proceed as follows:

- Petitioner is authorized to file a brief of up to five (5) pages in support of its Motion, due on or before October 29, 2024. Petitioner is authorized to file declaratory or other evidence, if necessary, together with its brief in support of its Motion.
- Patent Owner is authorized to file an Opposition of up to five pages (5) in opposition to Petitioner's motion, due on or before November 1, 2024. Patent Owner is authorized to file declaratory or other evidence, if necessary, together with its Opposition to Petitioner's motion.
- Petitioner is authorized to file a Reply of up to two (2) pages in response to Patent Owner's opposition, due on or before November 5, 2024. Petitioner's Reply shall be limited to addressing issues raised in Patent Owner's opposition.
- Patent Owner is authorized to file a Sur-reply of up to two (2) pages in response to Petitioner's Reply, due November 8, 2024. Patent Owner's Sur-reply shall be limited to addressing issues raised in Petitioner's Reply.

Regards,

Tina

From: Grace Kim <gkim@fr.com>

Sent: Wednesday, October 23, 2024 9:02 PM

To: Trials <Trials@USPTO.GOV>; Rick Bisenius <bisenius@fr.com>; Douglas Wentzel <Douglas.Wentzel@knobbe.com>; AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>

Subject: RE: IPR2024-00294 – Request for October 9 Conference re Contingent Motion to Amend - Petitioner's Motion to Strike PO's MTA

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Your Honors,

Petitioner Apple respectfully requests permission to file a motion to strike Patent Owner Masimo's IPR2024-00294 Motion to Amend ("MTA"), which Patent Owner filed on October 10, 2024, more than 3 weeks late.

The Board's scheduling order set a September 16, 2024 deadline for the MTA, and the parties' stipulations to extend due dates in IPR2024-00294 specifically addressed the "Patent Owner's Response to the petition," the "Petitioner's Reply to Patent Owner's Response to Petition," and the "Patent Owner's Sur-reply to Reply," without modifying dates associated with a potential MTA. Petitioner therefore requests the Board's permission to file a motion to strike Patent Owner's untimely MTA.

The parties have conferred regarding this request, and Patent Owner opposes Petitioner's request.

Apple respectfully requests a conference call with the Board to discuss Petitioner's request. The parties are available at the following dates/times:

- Monday (10/28): 1-3pm, 4-5pm EST
- Tuesday (10/29): 1-3pm EST
- Wednesday (10/30): 2-4pm EST

Respectfully,

Grace Kim
Counsel for Petitioner Apple

Grace Kim :: Principal :: Fish & Richardson P.C.

612 337 2510 direct :: gkim@fr.com
fr.com :: [Bio](#) :: [LinkedIn](#)

From: Trials <Trials@USPTO.GOV>

Sent: Wednesday, October 9, 2024 11:35 AM

To: Rick Bisenius <bisenius@fr.com>; Douglas Wentzel <Douglas.Wentzel@knobbe.com>; AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>

Cc: Trials <Trials@USPTO.GOV>

Subject: RE: IPR2024-00294 – Request for October 9 Conference re Contingent Motion to Amend

Counsel,

Thank you for your email. We understand that Patent Owner proposes to file a contingent motion to amend. To the extent our Scheduling Order requires a conference, we hereby deem such requirement satisfied. Either party may contact the Board if they believe such a conference call would be beneficial.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Rick Bisenius <bisenius@fr.com>
Sent: Tuesday, October 8, 2024 5:20 PM
To: Douglas Wentzel <Douglas.Wentzel@knobbe.com>; Trials <Trials@USPTO.GOV>
Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>
Subject: RE: IPR2024-00294 – Request for October 9 Conference re Contingent Motion to Amend

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before responding, clicking on links, or opening attachments.

Hello Board,

Petitioner's representatives are available at 10:00am-11:00am and 12:00pm-5:30pm central time tomorrow, October 9, for this call regarding Patent Owner's request to file a contingent motion to amend.

Thank you,
Patrick (Rick) Bisenius

Rick Bisenius :: Principal :: Fish & Richardson P.C.
Direct: 612 766 2048 :: Mobile: 608 358 5857 :: bisenius@fr.com

From: Douglas Wentzel <Douglas.Wentzel@knobbe.com>
Sent: Tuesday, October 8, 2024 3:26 PM
To: trials@uspto.gov
Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>
Subject: IPR2024-00294 – Request for October 9 Conference re Contingent Motion to Amend

[This email originated outside of F&R.]

Dear PTAB,

Patent Owner intends to file a contingent motion to amend in IPR2024-00294 on October 10. Accordingly, Patent Owner respectfully requests a call with the Board anytime tomorrow, October 9, regarding Patent Owner's contemplated motion. Petitioner's counsel has been copied on this email to provide Petitioner's availability for the call.

Best regards,

Doug

Douglas Wentzel
Partner
Douglas.Wentzel@knobbe.com
949-721-6352 Direct
Knobbe Martens
2040 Main St., 14th Fl.
Irvine, CA 92614
www.knobbe.com/douglas-wentzel

NOTICE: This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized review, use, disclosure or distribution is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

This email message is for the sole use of the intended recipient(s) and may contain confidential and privileged information. Any unauthorized use or disclosure is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message.

