

From: Douglas Wentzel <Douglas.Wentzel@knobbe.com>
Sent: Wednesday, October 23, 2024 9:21 PM
To: Grace Kim <gkim@fr.com>
Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>
Subject: Re: Apple v. Masimo, IPR2024-00294 | Motion to Strike Patent Owner's Motion to Amend

Grace,

To the extent the Board itself does not raise this issue, we will note Apple's violation of the Board's rule against email arguments on the upcoming call.

-Doug

Douglas Wentzel
Partner
949-721-6352 Direct
Knobbe Martens

From: Grace Kim <gkim@fr.com>
Date: Wednesday, October 23, 2024 at 5:59 PM
To: Douglas Wentzel <Douglas.Wentzel@knobbe.com>
Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>, IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>
Subject: RE: Apple v. Masimo, IPR2024-00294 | Motion to Strike Patent Owner's Motion to Amend

Hi Doug,

Thank you for getting back to us. Your concern is noted, but we believe that the second paragraph provides necessary context for this request to the Board.

Also, thanks for providing your available times for a call with the Board. We will go ahead and provide these times for the Board's consideration.

Best,
Grace

From: Douglas Wentzel <Douglas.Wentzel@knobbe.com>
Sent: Wednesday, October 23, 2024 7:28 PM
To: Grace Kim <gkim@fr.com>
Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>
Subject: Re: Apple v. Masimo, IPR2024-00294 | Motion to Strike Patent Owner's Motion to Amend

Hi Grace,

The second paragraph of your proposed email would violate the rule that emails to the Board “may not contain substantive argument.” We therefore agree you may send the following email to the Board, which includes the times Masimo is available for the call:

DRAFT EMAIL:

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 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): 1-4pm EST
- Wednesday (10/30): 2-4pm EST

Respectfully,

Grace Kim
Counsel for Petitioner Apple

Douglas Wentzel

Partner

949-721-6352 Direct

Knobbe Martens

From: Grace Kim <gkim@fr.com>

Date: Wednesday, October 23, 2024 at 12:20 PM

To: Douglas Wentzel <Douglas.Wentzel@knobbe.com>

Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>, IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>

Subject: RE: Apple v. Masimo, IPR2024-00294 | Motion to Strike Patent Owner's Motion to Amend

Hi Doug,

Thanks for speaking with us today. Below is the updated email to the Board. Please adjust the available dates/times based on your team’s feedback.

We would like to send this email to the Board as soon as possible.

Best regards,
Grace

***** DRAFT EMAIL TO BOARD *****

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:

- Thursday (10/24): 9am-1pm, 3-4pm EST
- Friday (10/25): 12-1pm EST
- Monday (10/28): 9am-12pm, 1-5pm EST
- Tuesday (10/29): 9am-3pm, 4-5pm EST
- Wed (10/30): 9am-11:30am, 1-4pm EST

Respectfully,

Grace Kim
Counsel for Petitioner Apple

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

From: Douglas Wentzel <Douglas.Wentzel@knobbe.com>
Sent: Friday, October 18, 2024 6:26 PM
To: Grace Kim <gkim@fr.com>
Cc: AppleIPR507-2 <AppleIPR507-2@knobbe.com>; IPR50095-0135IP2 <IPR50095-0135IP2@fr.com>
Subject: Re: Apple v. Masimo, IPR2024-00294 | Motion to Strike Patent Owner's Motion to Amend

[This email originated outside of F&R.]

Grace,

Masimo's motion to amend was timely filed. Contrary to Apple's new position, the parties' correspondence shows their agreement to extensions of entire "due dates." To that end, the stipulation to modify due dates that you filed (Paper 14) does not reflect the full scope of the parties' agreement to move "due dates." Masimo would thus oppose Apple's motion on this basis. Further, we will explain the full extent of the agreement reached in the parties' correspondence during any call with the Board.

Masimo is available to discuss this motion with Apple on Wednesday (10/23) at 10am PT. Please send call in information. On our Wednesday call, if needed, we can discuss the parties' availability for a conference call with the Board.

Best regards,

Doug

Douglas Wentzel

Partner

949-721-6352 Direct

Knobbe Martens

On Oct 18, 2024, at 2:57 PM, Grace Kim <gkim@fr.com> wrote:

Counsel,

Apple intends to seek permission from the Board to file a motion to strike Masimo's IPR2024-00294 Motion to Amend ("MTA"), which Masimo filed on October 10, 2024.

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. More, Masimo never specifically requested an extension to its MTA deadline as part of the negotiations that led to the stipulation filings, and the Board's scheduling order separately treats portions of "DUE DATE 1" associated with the "response to the petition" and the "motion to amend the patent." Accordingly, Apple had no reason to believe that Masimo would misconstrue Apple's consent for extension of Masimo's deadline for its response to the petition as encompassing the separate deadline for filing of the motion to amend. And, given the already limited time afforded to preparation of an opposition by the scheduling order, Apple would be severely prejudiced by Masimo's weeks-long delay in filing its MTA, were the MTA to remain in effect. Accordingly, Masimo's untimely MTA should be struck from the record.

We have included a draft of our proposed email to the Board below. Please let us know if Masimo opposes Apple's request for permission to file a motion to strike and, if so, Masimo's basis for opposition.

We intend to respond to the Board as soon as possible. If it would be helpful to discuss, we are available to confer at the following dates/times:

1. Monday (10/21): 11am-1pm EST
2. Tuesday (10/22): 9am-5pm EST
3. Wed (10/23): 9am-5pm EST

With best,
Grace

***** DRAFT EMAIL TO BOARD *****

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 6 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/does not oppose] Petitioner's request.

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

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](#)

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