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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

PATENT OWNER OPPOSITION TO MOTION TO STRIKE

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<i>Pfizer Inc. v. Unique Biopharma B.V.</i> , IPR2020-00388, Paper 22 (PTAB Oct. 2, 2020).....	1
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EXHIBIT LIST

Exhibit No.	Description
2001	R. James Duckworth, Ph.D. Curriculum Vitae
2002	March 27, 2024 Expert Declaration of R. James Duckworth, Ph.D.
2003	Commission Opinion (Public), <i>Certain Light-Based Physiological Measurement Devices and Components Thereof</i> , Inv. No. 337-TA-1276, EDIS No. 808521 (ITC Oct. 26, 2023)
2004	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01271, Paper 15 (PTAB Jan. 24, 2023)
2005	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01272, Paper 16 (PTAB Jan. 24, 2023)
2006	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01273, Paper 15 (PTAB Jan. 24, 2023)
2007	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01274, Paper 15 (PTAB Jan. 24, 2023)
2008	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01275, Paper 15 (PTAB Jan. 30, 2023)
2009	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-01276, Paper 15 (PTAB Jan. 30, 2023)
2010	Plaintiff Apple Inc.'s Opposition to Defendants' Motion for Stay Pending <i>Inter Partes</i> Review (Public), <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del. Jan. 10, 2024), D.I. 457
2011	Plaintiff Apple Inc.'s Opening Brief in Support of Its Motion for an Expedited Trial, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1377-MN-JLH (D. Del. Feb. 10, 2023), D.I. 50
2012	Transcript of May 5, 2023 Hearing in <i>Apple Inc. v. Masimo Corp.</i> , Nos. 22-1377-MN-JLH, 22-1378-MN-JLH (D. Del. May 5, 2023)

Exhibit No.	Description
2013	Original Scheduling Order, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del. May 25, 2023), D.I. 92
2014	Amended Scheduling Order, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del. Sept. 21, 2023), D.I. 359
2015	Lex Machina Patent Case Timeline Statistics for the District of Delaware between December 12, 2022 and December 12, 2023
2016	Lex Machina Case Statistics for Magistrate Judge Jennifer Hall
2017	Lex Machina Case Statistics for Judge Colm Connolly, Judge Maryellen Noreika, Judge Richard Andrews, Judge Gregory Williams, and Magistrate Judge Jennifer Hall
2018	Transcript of September 14, 2023 Markman Hearing, <i>Apple Inc. v. Masimo Corp.</i> , Nos. 22-cv-1377-MN-JLH, 22-cv-1378-MN-JLH
2019	Aaron Tilley, <i>The Entrepreneur Who Bet His Company on a Fight With Apple</i> , Wall Street J., Dec. 30, 2023, https://www.wsj.com/tech/joe-kiani-entrepreneur-apple-warning-52eb09a9
2020	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1271, Paper 20 (PTAB June 20, 2023)
2021	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1272, Paper 20 (PTAB June 20, 2023)
2022	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1273, Paper 19 (PTAB June 20, 2023)
2023	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1274, Paper 19 (PTAB June 20, 2023)
2024	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1275, Paper 19 (PTAB June 26, 2023)

Exhibit No.	Description
2025	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1276, Paper 20 (PTAB June 26, 2023)
2026	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1292, Paper 17 (PTAB Mar. 7, 2023)
2027	Notice of Refund, <i>Apple Inc. v. Masimo Corp.</i> , IPR2022-1466, Paper 17 (PTAB Apr. 5, 2023)
2028	Correspondence from counsel for Apple to counsel for Masimo regarding Apple's prior art grounds in the Delaware Litigation, dated November 16, 2023
2029	Joint Claim Construction Briefing (August 31, 2023) in <i>Apple Inc. v. Masimo Corp et al.</i> , C.A. 22-1378-MN-JLH
2030	Excerpts of the Transcript of the Deposition of Steven Warren in <i>Apple Inc. v. Masimo Corp et al.</i> , C.A. 22-1378-MN-JLH
2031	Excerpts of the Rebuttal Expert Report of Steven Warren in <i>Apple Inc. v. Masimo Corp et al.</i> , C.A. 22-1378-MN-JLH
2032	Blood Oxygen App On Apple Watch, Apple (retrieved March 12, 2024)
2033	CC1100 Single Chip Low Cost Low Power RF Transceiver, Texas Instruments (June 20, 2006)
2034	Exhibit D-1 to Apple's June 8, 2023 Initial Invalidity Contentions, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2035	Exhibit D-3 to Apple's June 8, 2023 Initial Invalidity Contentions, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)
2036	Excerpts of Masimo's June 22, 2023 Responses to Apple Inc.'s Initial Invalidity Contentions, <i>Apple Inc. v. Masimo Corp.</i> , No. 22-1378-MN-JLH (D. Del.)

Exhibit No.	Description
2037	October 10, 2024 Expert Declaration of R. James Duckworth, Ph.D.
2038	Declaration of Bilal Muhsin
2039	Prototype Video (last modified August 31, 2011)
2040	User Interface Summary (last modified August 31, 2011)
2041	<i>Masimo iSpO2™ Pulse Oximeter for iOS Platform (iPhone, iPad & iPod touch) for Consumers to Debut at CES, Jan. 3, 2013,</i> https://investor.masimo.com/news/news-details/2013/Masimo-iSpO2supsup-Pulse-Oximeter-for-iOS-Platform-iPhone-iPad--iPod-touch-for-Consumers-to-Debut-at-CES/default.aspx
2042	iSpO2 Image cited in Exhibit 2041, available at http://photos.prnewswire.com/prnh/20130103/LA36252
2043	IEEE Xplore Webpage for D'Angelo, available at https://ieeexplore.ieee.org/document/6090368/citations?tabFilter=papers#citations
2044	Deposition Transcript of Thomas Kenny, Ph.D.
2045	U.S. Patent App. No. 15/880,071
2046	U.S. Prov. Patent App. No. 61/703,729
2047	U.S. Patent App. No. 14/033,315
2048	Email Record of Parties' Correspondence with the Board Prior to Filing Motion to Amend
2049	Patent Trial and Appeal Board Consolidated Trial Practice Guide, November 2019

Patent Owner, Masimo Corporation, respectfully requests that the Board deny Petitioner's Motion to Strike. To the extent necessary, Masimo also requests that the Board extend the MTA deadlines, as set forth below.

I. Introduction

When Apple requested extensions to accommodate its expert's schedule and Apple's desire to avoid deadlines near the holidays, Masimo agreed. Masimo believed the extensions applied to its motion to amend ("MTA"), and did not intend to waive its right to file an MTA. Moreover, Masimo herein proposes a schedule that will allow all MTA due dates to be met without prejudice to Apple or to the Board's ability to issue a final written decision by the statutory date. For this and the reasons set forth below, it is fair and reasonable to permit an MTA in this case.

II. Legal Background and Extension Request

Under similar circumstances, the Board has found it appropriate to "extend due dates for any motion to amend to coincide with the due dates relating to Patent Owner's response to the petition as stipulated by the parties." *Pfizer v. Uniqure Biopharma*, IPR2020-00388, Paper 22 at 2 (PTAB, Oct. 2, 2020). To the extent the Board determines the stipulation did not extend MTA due dates, Masimo requests that the Board extend all deadlines associated with DUE DATE 1 to October 10, all those associated with DUE DATE 2 to January 13, 2025, and all those associated with DUE DATE 3 to February 14. Masimo understands the Board generally desires

four weeks to issue Preliminary Guidance. If the Board issues such guidance on the four-week date (February 10), this proposal would give Masimo four days to file a reply or revised MTA.

III. Masimo Intended to Extend the MTA Deadline and Thought Apple Agreed

On August 2, to accommodate the schedule of its expert, Dr. Kenny, Apple proposed extending “DUE DATE 1” and “DUE DATE 2” by the “same number of days.” APPLE-1080 at 8. In response, Masimo proposed extending “DUE DATE 1” to October 10. *Id.* at 5–6. When Apple requested more time for its Reply due to the holidays, Masimo agreed to Apple’s proposed dates. *Id.* at 4–5.

Dr. Kenny’s difficult schedule required significant negotiation. The following chart shows the dates discussed by the parties from August 2 through August 7.

	Aug. 2		Aug. 4		Aug. 5		Aug. 7
Deposition Dates Proposed by Masimo		8/16, 8/17, 8/18		8/13, 8/14, 8/15, 8/20, 8/21, 8/22		9/26, 9/27	
Deposition Dates Proposed by Apple	9/5, 9/6, 9/12, 9/13		9/16, 9/17, 9/18, 9/23, 9/24, 9/25		8/28		9/27

See APPLE-1080 at 5–8. Importantly, almost all Apple’s proposed dates for the deposition fell *after* September 9, the end of the cross-examination period for a September 16 “DUE DATE 1.” *See* EX2049 at 92. When discussing alternative dates, Masimo always intended to extend all deadlines relevant to the deposition to accommodate Apple’s expert, without waiving rights to an MTA.

After the parties agreed to a deposition date, Apple drafted the due-date-extension stipulation to refer descriptively to the “Patent Owner’s Response” due date rather than to the generic label “DUE DATE 1.” Paper 14 at 1. Masimo did not interpret this shift to more descriptive language as excluding the MTA deadline that is also part of the same DUE DATE 1. The parties focused on extending due dates to accommodate Apple’s expert, not on excluding parts of DUE DATE 1 from the extension. *See* APPLE-1080 at 5–8. Accordingly, Masimo first learned through this motion that Apple considered the MTA deadline to have passed *before* Dr. Kenny’s September 26 deposition. Such a timeline would have greatly prejudiced Masimo by requiring it to file its MTA before deposing Apple’s expert. Masimo did not intend to accept, and undoubtedly Apple did not intend to impose, such prejudice.

IV. The Board’s Email Gave Apple An Opportunity to Raise the Timing Issue

Masimo emailed the Board regarding its contingent MTA and the Board responded on October 9. EX2048 at 1. The Board’s email referenced its Scheduling Order and encouraged “either party” to contact the Board if they believed a conference call would be beneficial. *Id.* at 1. This provided an opportunity, on October 9, for Apple to raise concerns about allegedly missed deadlines.

Apple now alleges that between September 16 and October 10, it “allocated resources” based on a belief that Masimo’s “September 16 MTA deadline had

already passed.” Paper 21 at 4. If that were so, Apple would have promptly asked for a conference call in response to the Board’s October 9 email to raise the allegedly missed deadline. Apple instead waited until it had reviewed the substance of Masimo’s MTA before it raised its timing objection on October 18. APPLE-1081 at 4–5. This delay suggests that as of October 10, Apple believed Masimo’s MTA had been timely filed under the stipulated extension.

V. Masimo’s Proposed Schedule Would Eliminate Any Possible Prejudice

Apple argues “insufficient time remains” for a “fair opportunity” to address Masimo’s MTA. Paper 21 at 3. But Apple exaggerates the time it allegedly needs. Apple now argues it deserves 105 days to oppose the MTA, suggesting its opposition should be due February 28. *Id.* at 4–5. However, Apple was the party that requested extensions to accommodate its expert, and it never requested a 105-day response period between DUE DATE 1 and DUE DATE 2. APPLE-1080 at 5–6, 8. Further, 105 days from October 10 is January 23, more than a month earlier than February 28, so all Apple’s subsequent date calculations are wrong.

In any case, Masimo proposes a schedule that would give Apple 95 days for its opposition to the MTA, which is longer than the 81 days allotted under the original schedule. Moreover, even assuming Masimo files a revised MTA and the Board issues a revised scheduling order, Masimo proposes below a feasible schedule:

Due Date:	2	3	4	5	6	7	8
Original	Dec. 6	Jan. 16	Feb. 6	Feb. 27	Mar. 6	Mar. 13	Mar. 20
Proposed	Jan. 13	Feb. 14	Feb. 6	Mar. 28	Apr. 4	Apr. 11	Apr. 25
	RMTA:	Guidance	RMTA		RMTA1	RMTA2	RMTA3
		Feb. 10	Feb. 14		Mar. 28	Apr. 4	Apr. 18

This proposal maintains the Board’s standard working periods, keeps Apple’s working periods largely intact, and compresses Masimo’s working periods.

VI. Apple’s Arguments Do Not Justify Striking the MTA

Apple’s argument that Paper 14 “captures the parties’ agreement within its four corners” and does not extend the MTA deadline ignores important context. Paper 21 at 1–2. Masimo agreed to Apple’s request to extend DUE DATE 1 to accommodate Apple’s expert, and Masimo never intended to exclude the MTA. Alignment of the MTA deadlines with DUE DATES 1–3 would not prejudice Apple and would not prevent the Board from issuing a final written decision by the statutory date. Thus, Masimo requests that the Board deny Apple’s motion and avoid the draconian measure of striking Masimo’s MTA.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 1, 2024

/ Philip M. Nelson /
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IPR2024-00294

Apple Inc. v. Masimo Corp.

Customer No. 64,735

Attorney for Patent Owner
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CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER OPPOSITION TO MOTION TO STRIKE AND EXHIBITS 2048–2049** is being served electronically on November 1, 2024, to the e-mail addresses shown below:

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Dated: November 1, 2024

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