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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'S SUR-REPLY IN SUPPORT OF ITS OPPOSITION TO
PETITIONER'S MOTION TO STRIKE**

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I. Masimo's Proposed Solution Is Reasonable, and Apple's Is Extreme

Apple is seizing on what is at most a procedural miscommunication to avoid substantive review of Masimo's MTA, but Apple has not presented a legal basis for this severe result. In contrast, Masimo's solution is to work out a reasonable schedule, shortening its own working periods to accommodate Apple and the Board.

II. PTAB Practice Favors Masimo's Proposal

Masimo showed that when a stipulation did not explicitly refer to MTA dates, the Board "extend[ed] 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). Apple fails to identify any contrary law or precedent.

III. Striking The MTA Would Be An Extreme Remedy To A Schedule Dispute

Apple does not dispute that: (1) Apple was the party initially requesting an extension; (2) Apple's reason was to accommodate Apple's own expert, Dr. Kenny; and (3) Apple's August 2 email referenced "DUE DATE 1" and "DUE DATE 2." Accordingly, this dispute arises from, at most, a miscommunication. Apple does not dispute Masimo's assertion that Apple "undoubtedly did not intend to impose" the prejudice of Masimo waiving the right to file an MTA. Paper 22 at 3. Thus, at the time, neither party believed Masimo was waiving that right. Indeed, Apple admits it needed to conduct diligence "subsequent" to October 8 to lodge this objection.

Paper 23 at 2. If, as Apple claims, it knew on September 16 the MTA date had passed and “allocated resources accordingly” (Paper 21 at 4), it would have objected when the Board offered an MTA-related phone call on October 9 (EX2048 at 1).

Thus, Masimo’s belief that its MTA was timely filed was reasonable. The parties did not expressly negotiate the MTA deadline, and Masimo did not intend to separate it out. The Board should not allow Apple to exploit miscommunication to deprive Masimo of its statutory right to an MTA. *See* 35 U.S.C. § 316(d)(1).

IV. Apple Will Not Be Prejudiced By Masimo’s Motion to Amend

Masimo has proposed a feasible schedule and is open to reasonable adjustments. In contrast, Apple argues that *no* schedule is feasible. Apple opportunistically insists only 105 days would be fair, manufacturing prejudice to justify its request to strike. That Apple was content with 95 days (October 10 to January 13) in the filed stipulation—two weeks longer than the original schedule’s 81 days—exposes its opportunism. More unreasonably, Apple seeks to extend its working period to 141 days, ending February 28, by counting 105 days from when it predicts the Board will decide this Motion. Paper 23 at 2. But Apple admitted it reviewed the MTA and began developing a response on October 10. Paper 21 at 4.

Finally, Apple’s suggestion that Masimo simply pursue the claims in a continuation would abrogate Masimo’s statutory right to an MTA in the IPR itself. That is unreasonable when a feasible schedule, such as Masimo’s, is available.

IPR2024-00294

Apple Inc. v. Masimo Corp.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 8, 2024

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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'S SUR-REPLY IN SUPPORT OF ITS OPPOSITION TO PETITIONER'S MOTION TO STRIKE** is being served electronically on November 8, 2024, to the e-mail addresses shown below:

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