

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2024-00294
Patent 10,736,507 B2

Before RICHARD H. MARSCHALL and DAVID COTTA,
Administrative Patent Judges.

COTTA, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5 and 42.121(a)

On October 10, 2024, Patent Owner filed a Contingent Motion to Amend. Paper 18. With our prior authorization, Petitioner filed Motion to Strike the Motion to Amend. Paper 21 (“Mot.”) Patent Owner filed an Opposition to Petitioner’s Motion to Strike (Paper 22, “Opp.”) to which Petitioner filed a Reply (Paper 23, “Reply”) and Patent Owner filed a Sur-reply (Paper 24, “Sur-reply”).

Our Scheduling Order set September 16, 2024 as the due date for filing “Patent Owner’s response to the petition” and “Patent Owner’s motion to amend the patent (MTA).” Paper 12, 11. Patent Owner did not file its MTA until October 10, 2024. Paper 18. The dispute here centers on whether the parties’ August 9, 2024 Notice of Stipulation to Modify Due Dates, which moved the due date for filing Patent Owner’s Response to the Petition to October 10, 2024 (Paper 16, 1), also extended the deadline for filing a motion to amend.

Petitioner argues that on its face, the Notice of Stipulation “modifies due dates associated only with a specific set of papers, not including the MTA.” Mot. 2. Petitioner further argues that the email correspondence between the parties relating to the Notice of Stipulation likewise reflects the parties’ intent only to modify the due dates of pleadings other than a MTA. *Id.* Indeed, Petitioner points out, the parties “**could not** have agreed to move each of the portions of Due Dates 1, 2, and 3 associated with the MTA,” because our Scheduling Order prohibits the parties from stipulating to different dates for the portions of Due Dates 2 and 3 relating to an MTA without prior authorization from the Board. *Id.* at 2–3 (citing Paper 12, 8). Finally, Petitioner argues, without further explanation, it “**would not** have

agreed to have moved each of the portions of Due Dates 1, 2, and 3 associated with a potential MTA and subsequent papers, even if Patent Owner had specifically proposed such modifications.” *Id.* at 3.

Patent Owner argues that it agreed to Petitioner’s request for an extension to “accommodate [Petitioner’s] expert’s schedule and [Petitioner’s] desire to avoid deadlines near the holidays.” *Opp.* 1. According to Patent Owner, “[a]fter the parties agreed to a deposition date, [Petitioner] 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.’” *Id.* at 3. Patent Owner asserts that it “did not interpret this shift to more descriptive language as excluding the MTA deadline that is also part of the same DUE DATE 1.” *Id.* In addition, Patent Owner argues that Petitioner remained silent in response to the Board’s email deeming the conference requirement set forth in the Scheduling Order satisfied by email correspondence with the Board, and stating “[e]ither party may contact the Board if they believe such a conference call would be beneficial.” *Id.* Finally, Patent Owner argues that the delay between when Petitioner learned of Patent Owner’s MTA (October 8, 2004; *see* Ex. 2048, 2) and when it objected to Patent Owner’s MTA as untimely (October 18, 2004; *see* 1081, 4) “suggests that as of October 10, [Petitioner] believed [Patent Owner’s] MTA had been timely filed under the stipulated extension” (*Opp.* 4).

Both parties present reasonable arguments in support of their positions. On the one hand, Petitioner is correct that the Notice of Stipulation does not address a potential MTA and that our Scheduling Order precludes the parties from modifying the MTA portion of Due Dates 2 and

3.¹ Paper 12, 11; Paper 16, 1. On the other hand, we agree with Patent Owner that Petitioner's conduct suggests that it believed the MTA had been timely filed.² However, we need not determine here whether the Notice of Stipulation applies to Patent Owner's MTA in order to resolve this dispute because we grant Patent Owner's request that we extend the applicable deadlines.

Patent Owner 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." Opp. 1. We find that granting an extension to allow consideration of Patent Owner's MTA on the merits would be in the interests of justice, particularly where the alleged missed deadline appears to have resulted from a simple miscommunication between the parties. 37 C.F.R. § 42.5. Patent Owner also proposes revised dates for Due Dates 5–8 to track the new due dates it proposes for Due Dates 1–3, which we find reasonable. *See* Opp. 5. Patent Owner does not propose moving Due Date 4, the deadline for filing a request for oral argument, and we see no need to move that deadline.

Petitioner complains that moving the deadline for its Opposition "would unfairly prejudice [Petitioner] since it would not receive equal time for its preparation of its opposition as compared to [Patent Owner]" (105

¹ Our Scheduling Order does not preclude the parties from modifying Due Date 1, which includes the deadline for filing a MTA. Paper 12, 8 ("The parties may stipulate different dates for DUE DATES 1, 5, and 6.").

² We find the email correspondence between the parties inconclusive because neither party expressly addressed the applicability of the extensions to a MTA. *See generally* Ex. 1080.

days).” Reply, 2. To the extent Petitioner has less time to prepare its opposition than Patent Owner had to prepare its motion, such inequality is the reasonable byproduct of the parties’ efforts to find mutually agreeable times to conduct depositions. *See* Ex. 1080 (reflecting efforts by the parties to accommodate witness travel schedules and holidays). Moreover, extending DUE DATE 2 to January 13, 2025 leaves reasonable time (95 days from the date the MTA was filed and 60 days from the date of this decision) for Petitioner to prepare its Opposition. Petitioner argues that this “condensed schedule . . . limit[s] the Board’s consideration of [Petitioner’s] argument/evidence and, thus, unfairly prejudice[s Petitioner].” Reply, 2. This is not persuasive because the schedule provides us sufficient time to fully consider all of the arguments and evidence before us.

Consistent with our usual practice, in the event Patent Owner files a revised MTA, we will issue a new scheduling order. Patent Owner provides what it describes as a “feasible schedule” with proposed deadlines following the filing of a revised MTA. Petitioner complains that Patent Owner’s proposed MTA schedule “shortchanges Apple’s time” to file a sur-reply. Reply, 2. But we agree that Patent Owner’s proposed schedule looks feasible. And we note Patent Owner’s openness to “reasonable adjustments.” Sur-reply, 2. In the event that Patent Owner files a revised MTA, we expect to issue a new scheduling order generally in accord with that proposed by Patent Owner, making allowances, to the extent practical, for Petitioner’s concern that it have sufficient time to prepare its responsive pleadings.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Strike is denied.

FURTHER ORDERED that the Scheduling Order is amended to extend: all deadlines associated with DUE DATE 1 to October 10; all deadlines associated with DUE DATE 2 to January 13, 2025; all deadlines associated with DUE DATE 3 to February 14; all deadlines associated with DUE DATE 5 to March 28; all deadlines associated with DUE DATE 6 to April 4; all deadlines associated with DUE DATE 7 to April 11; and all deadlines associated with DUE DATE 8 to April 25.

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