

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 December 13, 2024, Petitioner emailed the Board to request that we increase the number of pages allotted for Petitioner's Opposition to Patent Owner's Contingent Motion to Amend from 25 to 75. Ex. 3001. Patent Owner objected to Petitioner's request. *Id.* A conference call was held on December 17, 2024 between the parties and Judges Cotta and Marschall to address Petitioner's request.

During the conference call, Petitioner asserted that its Opposition would address whether the amended claims: 1) comply with the written description requirement, 2) enlarge the scope of the original claims, and 3) properly claim priority from the provisional application. In addition, Petitioner asserted that its Opposition would address claim construction and would assert obviousness based on combinations of prior art that include two new primary references. Petitioner then argued that it could not adequately address all of these issues in the 25 pages allotted under our rules.

Patent Owner responded to the points Petitioner raised during the conference call by arguing that Petitioner was seeking to "redo the Petition." Patent Owner asserted that Petitioner's proposed Opposition was not "typical" of oppositions to motions to amend because it involved new prior art and suggested that it was not practical to expand the scope of the proceeding given the limited time allotted by our schedule.

In the course of the parties' arguments, we tried to ascertain whether there were any issues that were duplicative of issues we would need to address in issuing our decision on the Petition. We determined that there was little overlap, with the possible exception that Petitioner's proof with respect to certain of the unamended dependent claims in the Petition may

overlap with the proof Petitioner expects to present for corresponding claims in its Opposition to Patent Owner's Contingent Motion to Amend.

At the conclusion of the call, we ordered the parties to meet and confer to try to agree upon a reasonable increase in the page length for Petitioner's Opposition and to report back to us by email with the results of their meet and confer. We also ordered the parties to report on whether they considered it necessary to address unamended dependent claims in the Opposition. On December 19, 2025, the parties reported back that they were not able to agree on the number of pages for Petitioner's Opposition and that they considered it necessary to address unamended dependent claims. In view of the number and complexity of the issues Petitioner expects to raise in its Opposition, including asserting obviousness based on two primary prior art references that were not addressed in the Petition, we agree with Petitioner that an extension of the pages allotted for Petitioner's Opposition is warranted. We recognize that the addressing all of the issues Petitioner expects to raise may present scheduling challenges. However, we are not aware of any authority precluding Petitioner from raising any of the issues that it intends to raise, and, in this case, we determine that addressing all of those issues requires more than 25 pages. Accordingly, we extend the page limit for Petitioner's Opposition to Patent Owner's Contingent Motion to Amend to 50 pages. We also extend the page limit for Patent Owner's Reply and for Petitioner's Sur-Reply to 50 and 15 pages respectively.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request that we increase the number of pages allotted for Petitioner's Opposition to Patent Owner's Contingent

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Motion to Amend is Granted. Petitioner shall have 50 pages for its
Opposition to Patent Owner's Motion to Amend.

FURTHER ORDERED that the page limit for Patent Owner's Reply
to Petitioner's Opposition is extended to 50 pages.

FURTHER ORDERED that the page limit for Petitioner's Sur-reply is
extended to 15 pages.

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