

From: [Douglas Wentzel](#)
To: [Trials](#)
Cc: [AppleIPR507-2](#); [IPR50095-0135IP2](#); [Grace Kim](#)
Subject: Re: IPR2024-00294 | Authorization of Additional Pages for Petitioner's Opposition to PO's MTA
Date: Thursday, December 19, 2024 11:22:28 PM

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Your Honors,

Apple did not include Masimo's position on the issues. Masimo thus provides its position below.

Summary

-

At the meet and confer, the parties addressed the following topics and reached the following conclusions:

1. Arguing dependent claims
 - a. Masimo explained it could not stipulate that the proposed amended dependent claims would rise or fall with the independent claims without knowing Apple's arguments or references.
2. Page limits for the briefing related to Masimo's contingent motion to amend
 - a. The parties could not reach agreement but:
 - i. Masimo proposed 45 pages for the opposition, 45 for the reply, and 12 for the sur-reply.
 - ii. Apple now proposes 55 pages for the opposition, 55 for the reply, and 12 for the sur-reply.
3. Possible extension
 - a. The parties discussed the possibility of extending the briefing schedule. If the Board finds good cause to extend dates into the 6-month period referenced in 35 U.S.C. § 326(a)(11), the parties intend to discuss reasonable extensions within the constraints provided by the Board.

Masimo's Position

The Board's rules include page limits to require the parties to select their strongest arguments and to present them concisely, thereby easing the burden on the Board. The substantial 25-page limit for oppositions to motion to amend already assumes petitioners would challenge amended claims under multiple statutory bases. Apple is not unique in wishing it could present every possible argument in extensive detail. But almost all other parties choose their best arguments and present them concisely to ensure compliance with the 25-page limit. Indeed, in IPRs involving the same parties, Masimo raised most of ***the same issues*** Apple desires to raise within the 25-page limit. *See, e.g.*, IPR2023-00745, papers 18 and 32; IPR2023-00664, papers 19 and 32. Apple can and should do the same.

Ex. 3001
IPR2024-00294

Apple is asking the Board for a petition-length opposition that would be three times longer than the rules permit. Any page-limit extension is rare, and the 50-page extension Apple requested is unprecedented. Indeed, Masimo is not aware of the Board ever granting more than a 20-page extension (45 pages total) for an opposition to a motion to amend.

Apple should have provided the Board and Masimo a detailed summary of its arguments (including identifying its allegedly new prior art) to allow assessment of whether 50 (or any) extra pages are necessary. Instead, Apple has only vaguely stated it will “essentially start over” and referenced the statutory bases for its intended arguments. On the meet and confer, Apple refused to identify any arguments or art it is relying on, thereby preventing the parties from meaningfully discussing the propriety of any extension. Thus, Apple has deprived the Board and Masimo of sufficient underlying facts to assess the reasonableness of Apple’s extension request. And Apple has further deprived Masimo of the ability to preemptively decide whether Masimo would argue the validity of the proposed amended dependent claims. Apple has thus not presented sufficient information to justify the lengthy extension it seeks.

Regardless, in the interests of compromise, Masimo offered Apple the following proposal at the meet and confer: 45 pages for Apple’s opposition, 45 pages for Masimo’s reply, and 12 pages for Apple’s sur-reply. Apple flatly rejected Masimo’s proposal. But to Masimo’s knowledge, its compromise proposal would have matched the longest page-limit extension the Board has ever granted for an opposition to a motion to amend. And Masimo’s compromise was particularly generous given Apple’s failure to present information justifying such a lengthy extension. Accordingly, while Apple fails to show that an extension of 20 (or more) pages is warranted, Masimo’s proposed page limits are the maximum the Board should permit.

Best regards,

Doug

Douglas Wentzel

Partner

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From: Grace Kim <gkim@fr.com>

Date: Thursday, December 19, 2024 at 7:49 PM

To: Trials <Trials@USPTO.GOV>

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Subject: RE: IPR2024-00294 | Authorization of Additional Pages for Petitioner's
Opposition to PO's MTA

Your Honors,

During the December 17 conference call on IPR2024-00294, the parties were asked by your Honors to meet and confer on two issues (below) and to report the resulting status of the same with a joint email by today:

1. Whether the opposition can be abbreviated in length based on a concession by Masimo that a determination on patentability of substitute dependent claims 22-28, 30-35 rises or falls with that of amended substitute independent base claims 21 and 29 and based on theories advanced against those claims in the petition that are unchallenged in the POR.
2. Whether the parties can work together to resolve a mutually acceptable number of pages for the opposition briefing.

As ordered by the Board, the parties subsequently met and conferred on December 18, 2024. Below are the results of the same.

Issue (1)

Masimo indicated that no substitute dependent claims rise or fall with the substitute independent claims. As such, Apple is left to address each and every substitute claim advanced by Masimo in its Opposition to Motion to Amend.

Issue (2)

No agreement was reached for the additional number of pages for the Opposition to Motion Amend.

In meeting and conferring, Apple offered to reduce its requested total number of pages for the Opposition to Motion to Amend from 75 to 55 pages, along with a corresponding increase to Patent Owner's Reply to the Opposition to Motion to Amend to a total of 55 pages. Masimo rejected this offer.

Apple believes that its requested additional pages are necessary to address the complex and highly unique issues. Specifically, in its Opposition, Apple intends to address at least the following issues:

1. the substitute claims are unsupported by the '507 patent's earliest priority documents, and are therefore not entitled to the '507 patent's earliest priority date;
2. the substitute claims do not meet the written description requirements of 35 USC § 112(a);
3. the substitute claims improperly broaden the scope of the claimed invention;
4. the substitute claims incorporate claimed terms that require claim constructions; and
5. the substitute claims are obvious over at least two different prior art combinations, the application of both being necessary to address alternative possible constructions of claim language introduced by the amendments. As each combination differs from those presented in challenges to the original claims, each of these grounds require altogether new treatment

of motivation and reasonable expectation of success.

As Apple explained during the call, in order to avoid prejudice in addressing the claims advanced by Masimo in its MTA, Apple would need to essentially start over by presenting new grounds, based on new primary references to account for Masimo's allegation that its amendments distinguish the primary reference of the original Petition that was earlier advanced for which the amendments were designed to distinguish. More, because the claim language advanced by Masimo is subject to construction, to avoid prejudice, Apple would need to advance each of two new grounds, each based on a distinct new primary reference. To this point, the new primary references are required to address ambiguity introduced by Masimo's MTA amendments, which contain language not recited in the specification of the '507 patent, and thus prompts Apple to analyze different claim construction interpretations. Because Apple has the burden to show that Masimo's substitute claims are unpatentable, Apple would be unduly prejudiced if prevented from being given adequate pages to present "a full and true disclosure of the facts" with respect to these issues. *Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256, 1262 (Fed. Cir. 2021).

As the Petition dedicated 76 pages to demonstrating obviousness of the original claims, a total of 75 Opposition pages are warranted to ensure that this extensive and significant evidence is put in proper context for the Board to render a fully informed final written decision. *See Cisco Systems, Inc. v. C-Cation Techs., LLC*, IPR201400454, Paper 12 at 9 (PTAB Aug. 29, 2014) (informative). And, to maintain and promote fairness and efficiency in the spirit of the rules, Apple offered to the Board granting an equivalent proportional increase of the page limit in the Patent Owner's Reply to Petitioner's Opposition. This would eliminate any potential prejudice to Masimo, while ensuring a full and fair record for the Board's consideration.

Miscellaneous - Parties' Request for Extension

At the meet and confer call, Masimo requested two additional weeks for its Patent Owner's Reply to the Opposition to Motion to Amend. Apple indicated that it is not opposed to such an extension but asks that if such an extension is granted, Apple also receive a two-week extension for the due date for the Opposition to Motion to Amend and the Sur-Reply to Patent Owner's Reply to the Opposition to the Motion to Amend. Apple believes that good cause exists to extend the proceedings, as deemed necessary by the Board, into the 6-month extension period contemplated by Congress. 35 U.S.C. § 316(a)(11). Moreover, as discussed during the conference call, Masimo indicated that it was also amenable to such an extension.

Lastly, following the meet-and-confer call, Apple shared the above language in a draft email and requested feedback from Masimo by EOB today to enable the parties to send a joint email to the Board today. Masimo did not respond to Apple's request. Consequently, this email reflects Petitioner's account of the meet-and-confer events.

Respectfully,

Grace Kim
Counsel for Apple

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

Sent: Friday, December 13, 2024 8:55 PM

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[This email originated outside of F&R.]

Your Honors,

Masimo submits that Apple's request should be denied outright because Apple seeks such a significant departure from the governing rules. Apple seeks to triple its page limit, essentially turning its opposition to Masimo's contingent motion to amend into a petition-length filing. In any event, if the Board does not outright deny Apple's request, Masimo believes a call with the Board will be necessary and will explain on that call why Apple's request should be denied.

Sincerely,

Doug

Douglas Wentzel

Partner

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From: Grace Kim <gkim@fr.com>

Date: Friday, December 13, 2024 at 3:14 PM

To: Trials <Trials@USPTO.GOV>

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Subject: IPR2024-00294 | Authorization of Additional Pages for Petitioner's Opposition to PO's MTA

Your Honors,

Petitioner Apple seeks the Board's authorization under 37 C.F.R. § 42.5(b) to increase the number of

pages for Petitioner’s Opposition to Patent Owner’s Motion to Amend (MTA) to 75. If this request is granted, Apple would not oppose a proportional page limit increase to Patent Owner’s Reply to Petitioner’s Opposition.

Apple respectfully submits that the additional pages are necessary to address numerous deficiencies in the proposed substitute claims, including lack of written description support, lack of entitlement to the claimed priority date, and obviousness of those claims over prior art combinations involving a new primary reference that was not advance by the Petition in challenges to Masimo’s original claims. For example, Apple's Opposition will demonstrate disclosure by a new primary reference of proposed substitute claim features including substitute claim 21’s recited “wristwatch mobile pulse oximetry system comprising ... a processing board in non-wireless data communication with the optical sensor and non-wireless data communication with a mobile computing device”. Just as the Petition dedicated 76 pages to demonstrating obviousness of the original claims, Apple respectfully submits that a total of 75 Opposition pages are warranted to ensure a full and fair record for the Board’s consideration, and that a proportional increase to Patent Owner’s Reply to Petitioner’s Opposition would eliminate any potential prejudice to Masimo.

Counsel for Petitioner and Patent Owner have met and conferred. Patent Owner opposes this request.

Should the Board desire a call to discuss this request, the parties are available on Wednesday, between 1pm-2pm and 3-5pm ET.

Respectfully,

Grace Kim
Counsel for Petitioner Apple

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