

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, DAVID COTTA, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

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

On March 4, 2025, Petitioner emailed the Board to request that we increase the number of pages allotted for Petitioner's Opposition to Patent Owner's Revised Contingent Motion to Amend from 25 to at least 50, with an equivalent increase in pages for Patent Owner's Reply to the Opposition. Petitioner also requested a six-week extension for the deadline for Petitioner's Opposition, with a corresponding extension for Patent Owner's Reply to the Opposition. Ex. 3005. Patent Owner objected to Petitioner's requests. *Id.* A conference call was held on March 10, 2025 with the parties and Judges Cotta, Marschall, and Finamore to address Petitioner's requests. A transcript of the call has been entered into the record. Ex. 3004.

During the conference call, Petitioner asserted that its request for additional pages was necessitated by the length and complexity of the revised amended claims as well as the number of issues presented. *See, e.g., id.* at 6:9–10:2, 13:10–15:17. More specifically, Petitioner asserted that the revised amended claims include two pages of new limitations, many of which are complex and present issues not addressed in the Petition or the original Motion to Amend. *Id.* at 6:9–10:19. Petitioner represented that presenting its obviousness argument in its Opposition may require discussion of at least five new prior art references for independent claim 21, with “possibly one or two or maybe even three more additional references to hit the dependent claims.” *Id.* at 15:18–16:8. Petitioner further represented that it expected its Opposition to address three separate instances where it contends the revised amended claims lack written description support, three separate instances where it contends the new claim language is indefinite,

and one instance where Petitioner contests whether a dependent claim is entitled to claim priority from a provisional application. *Id.* at 10:3–19.

As to additional time, Petitioner asserted that additional time is required because the Revised Contingent Motion to Amend presents additional subject matter not present in the previous Contingent Motion to Amend, requiring additional searching for prior art that has not yet been completed. *Id.* at 29:10–15 (“The main issue with the request for additional time would just be time for prior art searching. As I said, we need to find a new primary reference and we believe we need to find new secondary references for a number of these elements.”). Petitioner also noted that the time period for briefing the Revised Contingent Motion to Amend had been compressed by three weeks as a result of an extension granted to Patent Owner for the Contingent Motion to Amend. *Id.* at 25:22–28:20; *see also*, Paper 25 (Order extending deadlines). The extensions of time Petitioner seeks would require an extension of time to issue our Final Written Decision in this matter.

Patent Owner disputed Petitioner’s positions, explaining that it reduced the number of proposed substitute claims in its Revised Contingent Motion to Amend from 16 to only 4 in order to limit the need for additional time and extended briefing. Ex. 3004, 18:8–11 (“We limited the number of claims we presented here specifically so that we could avoid additional pages and additional time extensions.”). Patent Owner pointed out that in its Opposition to Petitioner’s original Motion to Amend, Petitioner used 40 pages to address obviousness and 10 pages to address other issues and in its initial Petition, Petitioner “never uses 50 pages for a set of four claims.” *Id.*

at 16:9–19:4. Projecting from this, Patent Owner asserted that 25 pages is adequate to address the issues at hand. *Id.* Patent Owner further argued that additional time for responding to the Revised Contingent Motion to Amend was not warranted. *Id.* at 30:5–31:3.

At the conclusion of the call, we informed the parties that that we would take their arguments under advisement but cautioned that “because the time schedule is compressed,” they should “operate under the assumption that the final written decision deadline will not be extended.” *Id.* at 34:2–11.

In view of Petitioner’s representations about the length and complexity of the claims, the number of prior art references required to address obviousness, and the multiple issues presented under 35 U.S.C. § 112, we agree with Petitioner that an extension of the pages allotted for Petitioner’s Opposition is warranted. However, Patent Owner’s comparison to the number of pages required to address issues in Petitioner’s original Opposition convinces us that Petitioner does not require the full 50 pages it requested to present its arguments. Accordingly, we increase the page limit for Petitioner’s Opposition to the Revised Contingent Motion to Amend to 40 pages. We further increase the page limit for Patent Owner’s Reply to the Opposition to 40 pages and increase the page limit for Petitioner’s Sur-reply for their Opposition to the Revised Contingent Motion to Amend to 20 pages.

As to Petitioner’s request that we extend the current deadlines, the hearing for this proceeding is currently scheduled for May 22, 2025, and the statutory due date for the Final Written Decision is June 27, 2025. There is

no latitude in this proceeding's schedule to accommodate Petitioner's request to extend deadlines for the Revised Contingent Motion to Amend while maintaining the current deadline for the Final Written Decision, and we do not view the circumstances as sufficient to justify extending that deadline.

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 Revised Contingent Motion to Amend is *granted*. Petitioner shall have up to 40 pages for its Opposition to Patent Owner's Revised Contingent Motion to Amend.

FURTHER ORDERED that the page limit for Patent Owner's Reply to Petitioner's Opposition is increased to 40 pages.

FURTHER ORDERED that the page limit for Petitioner's Sur-reply is increased to 20 pages.

FURTHER ORDERED that Petitioner's request that we extend the deadlines for Petitioner's Opposition to Patent Owner's Contingent Revised Motion to Amend and for Patent Owner's Reply to Petitioner's Opposition is *denied*.

IPR2024-00294
Patent 10,736,507 B2

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