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*Attorneys for Defendant
 Sotera Wireless, Inc.*

**UNITED STATES DISTRICT COURT
 SOUTHERN DISTRICT OF CALIFORNIA**

MASIMO CORPORATION, a
 California corporation,

Plaintiff,

v.

SOTERA WIRELESS, INC., a
 California corporation,

HON HAI PRECISION INDUSTRY
 CO., LTD., a Taiwan corporation,

Defendants.

Case No.: 3:19-cv-01100-BAS-NLS

**DEFENDANTS' STIPULATION OF
 INVALIDITY CONTENTIONS**

1 Defendants Sotera Wireless, Inc. (“Sotera”) and Hon Hai Precision Industry
2 Co., Ltd. (“Hon Hai”) (collectively, “Defendants”) submit this stipulation of
3 invalidity contentions.

4 On May 7, 2020, Sotera filed petition number IPR2020-00912 with the
5 Patent Trial and Appeal Board requesting *inter parties* review of U.S. Patent No.
6 10,213,108 (the “’108 Patent”); on May 18, 2020, Sotera filed with the Patent Trial
7 and Appeal Board petition number IPR2020-00954 requesting *inter parties* review
8 of U.S. Patent No. 9,788,735 (the “’735 Patent”); on May 21, 2020, Sotera filed
9 with the Patent Trial and Appeal Board petition number IPR2020-00967 requesting
10 *inter parties* review of U.S. Patent No. RE47,244 (the “RE244 Patent”); on May
11 29, 2020, Sotera filed with the Patent Trial and Appeal Board petition number
12 IPR2020-01015 requesting *inter parties* review of U.S. Patent No. 9,795,300 (the
13 “’300 Patent”) and petition number IPR2020-01019 requesting *inter parties* review
14 of U.S. Reissue Patent No. RE47,353 (the “RE353 Patent”); on June 3, 2020,
15 Sotera filed with the Patent Trial and Appeal Board petition number IPR2020-
16 01033 requesting *inter parties* review of U.S. Reissue Patent No. RE,47,249 (the
17 “RE249 Patent”); on June 5, 2020, Sotera filed with the Patent Trial and Appeal
18 Board petition number IPR2020-01054 requesting *inter parties* review of U.S.
19 Patent No. 9,872,623 (the “’623 Patent”); and on June 11, 2020, Sotera filed with
20 the Patent Trial and Appeal Board petition number IPR2020-01078 requesting
21 *inter parties* review of U.S. Reissue Patent No. RE47,218 (the “RE218 Patent”)
22 and petition number IPR 2020-01082 requesting *inter parties* review of U.S. Patent
23 No. 10,255,944 (the “’994 Patent”). In each petition, Sotera identified Defendant
24 Hon Hai as a real party in interest subject to 37 C.F.R. § 42.8(b)(1).

25 The Petitions assert the following grounds of invalidity:
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IPR Petition No.	Patent No.	IPR Ground	Claims	Grounds of Unpatentability
IPR2020 -00912	10,213,108	1	1-5, 9-18	Obvious under 35 U.S.C. § 103 over U.S. Patent No. 6,840,904 to Goldberg (“Goldberg”) and PCT Publication No. WO 00/42911 to Kiani (“Kiani”)
		2	1-5, 9-18	Obvious under 35 U.S.C. § 103 over European Publication No. EP0880936A2 to Akai (“Akai”) and Kiani
		3	6-8	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and U.S. Patent No. 4,425,921 to Fujisaki (“Fujisaki”)
		4	6-8	Obvious under 35 U.S.C. § 103 over Akai, Kiani, and Fujisaki
		5	19-22	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and U.S. Patent No. 5,919,141 to Money (“Money”)
		6	19-22	Obvious under 35 U.S.C. § 103 over Akai, Kiani, and Money
IPR2020 -00954	9,788,735	1	1, 2, 7- 9	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and Money
		2	3-6, 13-19	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, Money and Fujisaki
		3	10-12	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, Money, and PCT Publication No. WO 99/13698 to Estep (“Estep”)
		4	20	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, Money, Fujisaki, and Estep
		5	1, 2, 7- 9	Obvious under 35 U.S.C. § 103 over Money, Akai, and Kiani
		6	3-6, 13-19	Obvious under 35 U.S.C. § 103 over Money, Akai, Kiani, and Fujisaki
		7	10-12	Obvious under 35 U.S.C. § 103 over Money, Akai, Kiani, and Estep
		8	20	Obvious under 35 U.S.C. § 103 over Money, Akai, Kiani, Fujisaki, and Estep

IPR Petition No.	Patent No.	IPR Ground	Claims	Grounds of Unpatentability
IPR2020 -00967	RE47,244	1	1,6-8, 13,14, 18,19, 23-26	Obvious under 35 U.S.C. § 103 over U.S. Patent No. 5,865,736 to Baker, Jr. (“Baker-1”)
		2	1,2, 6- 9,13- 15,18- 26	Obvious under 35 U.S.C. § 103 over Baker-1 and U.S. Publication No. 2009/0247851 to Batchelder (“Batchelder”)
		3	1,2, 6- 9,13- 15,18- 26	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, and U.S. Patent No. 8,792,949 to Baker, Jr. (“Baker-2”)
		4	3-5, 10-12, 16,17	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, Baker-2, and U.S. Publication No. 2003/0135087 to Hickie (“Hickie”)
		5	1,2, 6- 9,13- 15,18- 26	Obvious under 35 U.S.C. § 103 over U.S. Publication No. 2005/0038332 to Saidara (“Saidara”) and Malangi, S., “Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm” (“Malangi”)
		6	3- 5,10- 12,16, 17,26	Obvious under 35 U.S.C. § 103 over Saidara, Malangi, and Hickie
IPR2020 -01015	9,795,300	1	1-20	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and Money
		2	1-20	Obvious under 35 U.S.C. § 103 over Money, Kiani, and Akai
		3	1-5, 10-20	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, Money, and PCT Publication No. WO96/15594 to Taylor (“Taylor”)
		4	1-5, 10-20	Obvious under 35 U.S.C. § 103 over Money, Kiani, Akai, and Taylor

IPR Petition No.	Patent No.	IPR Ground	Claims	Grounds of Unpatentability
		5	6-9	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, Money, Taylor, and U.S. Patent No. 5,793,413 to Hylton (“Hylton”)
		6	6-9	Obvious under 35 U.S.C. § 103 over Money, Kiani, Akai, Taylor, and Hylton
IPR2020 -01019	RE47,353	1	1, 6-8, 13,14, 18,19, 23-25	Obvious under 35 U.S.C. § 103 over Baker-1
		2	1,2, 6- 9,13- 15,18- 25	Obvious under 35 U.S.C. § 103 over Baker-1 and Batchelder
		3	1,2, 6- 9,13- 15,18- 25	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, and Baker-2
		4	3-5, 10-12, 16, 17	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, Baker-2, and Hickie
		5	1,2, 6- 9,13- 15,18- 25	Obvious under 35 U.S.C. § 103 over Saidara and Malangi
		6	3- 5,10- 12,16, 17,24	Obvious under 35 U.S.C. § 103 over Saidara, Malangi, and Hickie
IPR2020 -01033	RE47,249	1	1,6-8, 13,14, 18,19, 23,24	Obvious under 35 U.S.C. § 103 over Baker-1
		2	1,2, 6- 9,13- 15,18-	Obvious under 35 U.S.C. § 103 over Baker-1 and Batchelder

IPR Petition No.	Patent No.	IPR Ground	Claims	Grounds of Unpatentability
			24	
		3	1,2, 6- 9,13- 15,18- 24	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, and Baker-2
		4	3-5, 10-12, 16,17	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, Baker-2, and Hickie
		5	1,2, 6- 9,13- 15,18- 24	Obvious under 35 U.S.C. § 103 over Saidara and Malangi
		6	3- 5,10- 12,14, 16,17, 23,24	Obvious under 35 U.S.C. § 103 over Saidara, Malangi, and Hickie
IPR2020 -01054	9,872,623	1	1,2,4,5 ,12,14- 17	Obvious under 35 U.S.C. § 103 over Goldberg and Kiani
		2	3	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and Fujisaki
		3	6-11, 13,18, 19	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and Money
		4	20	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, Money, Fujisaki, Estep, Taylor, and Hylton
		5	1,2, 4-19	Obvious under 35 U.S.C. § 103 over Money, Kiani, and Akai
		6	3	Obvious under 35 U.S.C. § 103 over Money, Kiani, Akai, and Fujisaki
		7	20	Obvious under 35 U.S.C. § 103 over Money, Kiani, Akai, Fujisaki, Estep, Taylor, and Hylton

IPR Petition No.	Patent No.	IPR Ground	Claims	Grounds of Unpatentability
IPR2020-01078	RE47,218	1	1-4,7, 12-15	U.S. Patent No. 7,079,035 to Bock and U.S. Patent No. 6,597,933 to Kiani
		2	5,6, 8-10, 16-18	U.S. Patent No. 7,079,035 to Bock, PCT Publication No. WO2009/093159 to Woehrle, and U.S. Patent No. 6,597,933 to Kiani
IPR2020-01082	10,255,994	1	1-3, 5-7	U.S. Patent Publication No. 2008/0287756 to Lynn and Influence of Pulse Oximeter Lower Alarm Limit on the Incidence of Hypoxaemia in the Recovery Room, British Journal of Anaesthesia, 1997 (Kalkman)
		2	3, 4, 7, 8	U.S. Patent Publication No. 2008/0287756 to Lynn, Influence of Pulse Oximeter Lower Alarm Limit on the Incidence of Hypoxaemia in the Recovery Room, British Journal of Anaesthesia, 1997 (Kalkman), and U.S. Patent Publication No. 2009/0326340 to Wang
		3	1-8	U.S. Patent Publication No. 2009/0326340 to Wang, U.S. Patent Publication No. 2009/0247851 to Batchelder, and Influence of Pulse Oximeter Lower Alarm Limit on the Incidence of Hypoxaemia in the Recovery Room, British Journal of Anaesthesia, 1997 (Kalkman)

Defendants hereby stipulate that if the Patent Trial and Appeal Board institutes IPR on IPR2020-00912, IPR2020-00954, IPR2020-00967, IPR2020-01015, IPR2020-01019, IPR2020-01033, IPR2020-01054, IPR2020-01078, and/or IPR 2020-01082, then Defendants will not pursue in this case the specific grounds identified above in connection with the referenced patent(s) and claim(s) as originally issued on the instituted *inter parties* review petition, or on any other ground for a given patent for which the Board institutes, that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under

1 §§ 102 or 103 on the basis of prior art patents or printed publications).

2 This stipulation is not intended, and should be construed, to limit
3 Defendants' ability to assert invalidity of the asserted claims of the '108 Patent,
4 '735 Patent, RE244 Patent, '300 Patent, RE353 Patent, RE249 Patent, '623 Patent,
5 RE218 Patent, and '994 Patent in this case on any other ground (i.e., invalidity
6 under 35 §§ 101, 112), regardless of whether *inter parties* review is instituted.

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1 Dated: October 15, 2020

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CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of October 2020, I caused the foregoing to be filed electronically with the Clerk of Court and to be served via the Court's Electronic Filing System upon all counsel of record.

/s/ Rudolph A. Telscher, Jr.

Rudolph A. Telscher, Jr