Case 3	19-cv-01100-BAS-NLS Document 86	Filed 10/15/20	PageID.17030	Page 1 of 10			
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18	Attorneys for Defendant Sotera Wireless, Inc.						
10	UNITED STATES	S DISTRICT (COURT				
20	SOUTHERN DISTR						
20							
	MASIMO CORPORATION, a	Case No.: 3:	19-cv-01100-B	AS-NLS			
22	California corporation,		NTS' STIPUL				
23	<i>Plaintiff</i> , v.	INVALIDI	FY CONTEN	TONS			
24	SOTERA WIRELESS, INC., a						
25	California corporation,						
26	HON HAI PRECISION INDUSTRY CO., LTD., a Taiwan corporation,	r					
27	Defendants.						
28	Dejenuunis.						
			EX103				
			Petition	ner Sotera			

IPR2020-00954

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 and Appeal Board petition number IPR2020-00954 requesting *inter parties* review 7 of U.S. Patent No. 9,788,735 (the "'735 Patent"); on May 21, 2020, Sotera filed 8 9 with the Patent Trial and Appeal Board petition number IPR2020-00967 requesting inter parties review of U.S. Patent No. RE47,244 (the "RE244 Patent"); on May 10 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 "300 Patent") and petition number IPR2020-01019 requesting inter parties review 13 of U.S. Reissue Patent No. RE47,353 (the "RE353 Patent"); on June 3, 2020, 14 Sotera filed with the Patent Trial and Appeal Board petition number IPR2020-15 16 01033 requesting *inter parties* review of U.S. Reissue Patent No. RE,47,249 (the "RE249 Patent"); on June 5, 2020, Sotera filed with the Patent Trial and Appeal 17 Board petition number IPR2020-01054 requesting *inter parties* review of U.S. 18 Patent No. 9,872,623 (the "623 Patent"); and on June 11, 2020, Sotera filed with 19 20 the Patent Trial and Appeal Board petition number IPR2020-01078 requesting *inter parties* review of U.S. Reissue Patent No. RE47,218 (the "RE218 Patent") 21 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: 26 27 28 1

Case 3;19-cv-01100-BAS-NLS Document 86 Filed 10/15/20 PageID.17032 Page 3 of 10

1	IPR				
2	Petition		IPR		
	No.	Patent No.	Ground	Claims	Grounds of Unpatentability
3					Obvious under 35 U.S.C. § 103 over U.S.
4				15	Patent No. 6,840,904 to Goldberg
5			1	1-5, 9-18	("Goldberg") and PCT Publication No. WO 00/42911 to Kiani ("Kiani")
			1	9-10	Obvious under 35 U.S.C. § 103 over
6				1-5,	European Publication No. EP0880936A2
7			2	9-18	to Akai ("Akai") and Kiani
0					Obvious under 35 U.S.C. § 103 over
8	IPR2020 -00912	10,213,108			Goldberg, Kiani, and U.S. Patent No.
9	-00912		3	6-8	4,425,921 to Fujisaki ("Fujisaki")
10					Obvious under 35 U.S.C. § 103 over Akai,
			4	6-8	Kiani, and Fujisaki
11					Obvious under 35 U.S.C. § 103 over
12			5	19-22	Goldberg, Kiani, and U.S. Patent No. 5,919,141 to Money ("Money")
13			5	17 22	Obvious under 35 U.S.C. § 103 over Akai,
			6	19-22	Kiani, and Money
14				1, 2, 7-	Obvious under 35 U.S.C. § 103 over
15			1	9	Goldberg, Kiani, and Money
16				3-6,	Obvious under 35 U.S.C. § 103 over
16			2	13-19	Goldberg, Kiani, Money and Fujisaki
17					Obvious under 35 U.S.C. § 103 over
18					Goldberg, Kiani, Money, and PCT Publication No. WO 99/13698 to Estep
			3	10-12	("Estep")
19			5	10 12	Obvious under 35 U.S.C. § 103 over
20	IPR2020	9,788,735			Goldberg, Kiani, Money, Fujisaki, and
21	-00954		4	20	Estep
				1, 2, 7-	Obvious under 35 U.S.C. § 103 over
22			5	9	Money, Akai, and Kiani
23			<i>(</i>	3-6,	Obvious under 35 U.S.C. § 103 over
24			6	13-19	Money, Akai, Kiani, and Fujisaki
			7	10-12	Obvious under 35 U.S.C. § 103 over Money, Akai, Kiani, and Estep
25			/	10-12	Obvious under 35 U.S.C. § 103 over
26			8	20	Money, Akai, Kiani, Fujisaki, and Estep
	L	1	-	-	
27					
28					
				2	Case No. 3:19-CV-01100-BAS-NLS
				2	Case 110. 3.17-C v-01100-DAS-11LS

Case 3;19-cv-01100-BAS-NLS Document 86 Filed 10/15/20 PageID.17033 Page 4 of 10

1 2 3 4 5 6 7 8	IPR Petition No.	Patent No.	IPR Ground 1	Claims 1,6-8, 13,14, 18,19, 23-26 1,2, 6- 9,13-	Grounds of Unpatentability Obvious under 35 U.S.C. § 103 over U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1") Obvious under 35 U.S.C. § 103 over
3 4 5 6 7 8		Patent No.	Ground	1,6-8, 13,14, 18,19, 23-26 1,2, 6- 9,13-	Obvious under 35 U.S.C. § 103 over U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1")
4 5 6 7 8	No.	Patent No.	1	1,6-8, 13,14, 18,19, 23-26 1,2, 6- 9,13-	Obvious under 35 U.S.C. § 103 over U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1")
4 5 6 7 8				13,14, 18,19, 23-26 1,2, 6- 9,13-	Patent No. 5,865,736 to Baker, Jr. ("Baker-1")
5 6 7 8				18,19, 23-26 1,2, 6- 9,13-	Patent No. 5,865,736 to Baker, Jr. ("Baker-1")
6 7 8				23-26 1,2, 6- 9,13-	("Baker-1")
7 8			2	6- 9,13-	Obvious under 35 U.S.C. § 103 over
7 8			2	9,13-	Obvious under 35 U.S.C. § 103 over
8			2	-	-
			2	1 7 10	Baker-1 and U.S. Publication No.
				15,18- 26	2009/0247851 to Batchelder ("Batchelder")
9			Δ.	1,2,	
				6-	
10				9,13-	Obvious under 35 U.S.C. § 103 over
11				15,18-	Baker-1, Batchelder, and U.S. Patent No.
12	IPR2020	RE47,244	3	26	8,792,949 to Baker, Jr. ("Baker-2")
	-00967			3-5,	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, Baker-2, and U.S.
13				10-12,	Publication No. 2003/0135087 to Hickle
14			4	16,17	("Hickle")
15					Obvious under 35 U.S.C. § 103 over U.S.
16				1,2,	Publication No. 2005/0038332 to Saidara
				6-	("Saidara") and Malangi, S., "Simulation and mathematical notation of alarms unit
17				9,13- 15,18-	for computer assisted resuscitation
18			5	26	algorithm" ("Malangi")
19				3-	
				5,10-	
20				12,16,	Obvious under 35 U.S.C. § 103 over
21			6	17,26	Saidaira, Malangi, and Hickle
22			1	1-20	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and Money
			1	1 20	Obvious under 35 U.S.C. § 103 over
23			2	1-20	Money, Kiani, and Akai
24	IPR2020	9,795,300			Obvious under 35 U.S.C. § 103 over
25	-01015			1.5	Goldberg, Kiani, Money, and PCT
			3	1-5, 10-20	Publication No. WO96/15594 to Taylor ("Taylor")
26			5	10-20	Obvious under 35 U.S.C. § 103 over
27			4	10-20	Money, Kiani, Akai, and Taylor
28			-		· · · · · · · · · · · · · · · · · · ·
				3	Case No. 2:10 CV 01100 DAG NUS
				3	Case No. 3:19-CV-01100-BAS-NLS

Case 3;19-cv-01100-BAS-NLS Document 86 Filed 10/15/20 PageID.17034 Page 5 of 10

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1	IPR				
2	Petition		IPR		
	No.	Patent No.	Ground	Claims	Grounds of Unpatentability
3					Obvious under 35 U.S.C. § 103 over
4			_	C 0	Goldberg, Kiani, Money, Taylor, and U.S.
5			5	6-9	Patent No. 5,793,413 to Hylton ("Hylton")
3			6	6-9	Obvious under 35 U.S.C. § 103 over Money, Kiani, Akai, Taylor, and Hylton
6			0	1, 6-8,	Money, Klain, Akai, Taylor, and Hynon
7				1, 0 0, 13,14,	
-				18,19,	Obvious under 35 U.S.C. § 103 over
8			1	23-25	Baker-1
9				1,2,	
10				6-	
				9,13-	
11			2	15,18-	Obvious under 35 U.S.C. § 103 over Baker-1 and Batchelder
12			Z	25 1,2,	Baker-1 and Batchelder
13				1,2, 6-	
15				9,13-	
14	IPR2020	RE47,353		15,18-	Obvious under 35 U.S.C. § 103 over
15	-01019		3	25	Baker-1, Batchelder, and Baker-2
				3-5,	
16				10-12,	Obvious under 35 U.S.C. § 103 over
17			4	16, 17	Baker-1, Batchelder, Baker-2, and Hickle
18				1,2, 6-	
				9,13-	
19				15,18-	Obvious under 35 U.S.C. § 103 over
20			5	25	Saidara and Malangi
21				3-	
				5,10-	
22				12,16,	Obvious under 35 U.S.C. § 103 over
23			6	17,24	Saidara, Malangi, and Hickle
				1,6-8, 13,14,	
24				13,14, 18,19,	Obvious under 35 U.S.C. § 103 over
25	IPR2020 -01033		1	23,24	Baker-1
26		RE47,249		1,2,	
				6-	
27				9,13-	Obvious under 35 U.S.C. § 103 over
28			2	15,18-	Baker-1 and Batchelder
				4	Case No. 3:19-CV-01100-BAS-NLS
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Case 3;19-cv-01100-BAS-NLS Document 86 Filed 10/15/20 PageID.17035 Page 6 of 10

IPR Petition		IPR		
No.	Patent No.	Ground	Claims	Grounds of Unpatentability
1.00		0100110	24	
			1,2,	
			6-	
			9,13-	
		_	15,18-	Obvious under 35 U.S.C. § 103 over
		3	24	Baker-1, Batchelder, and Baker-2
			3-5,	Obvious under 25 U.S.C. § 102 over
		4	10-12, 16,17	Obvious under 35 U.S.C. § 103 over Baker-1, Batchelder, Baker-2, and Hick
			1,2,	Darci-1, Datchelder, Darci-2, and Ther
			6-	
			9,13-	
			15,18-	Obvious under 35 U.S.C. § 103 over
		5	24	Saidara and Malangi
			3-	
			5,10-	
			12,14, 16,17,	Obvious under 35 U.S.C. § 103 over
		6	23,24	Saidara, Malangi, and Hickle
			1,2,4,5	
			,12,14-	Obvious under 35 U.S.C. § 103 over
		1	17	Goldberg and Kiani
				Obvious under 35 U.S.C. § 103 over
		2	3	Goldberg, Kiani, and Fujisaki
			6-11,	Obvious under 25 U.S.C. § 102 over
		3	13,18, 19	Obvious under 35 U.S.C. § 103 over Goldberg, Kiani, and Money
IPR2020	9877673		17	Obvious under 35 U.S.C. § 103 over
-01054				Goldberg, Kiani, Money, Fujisaki, Este
		4	20	Taylor, and Hylton
			1,2,	Obvious under 35 U.S.C. § 103 over
		5	4-19	Money, Kiani, and Akai
				Obvious under 35 U.S.C. § 103 over
		6	3	Money, Kiani, Akai, and Fujisaki
				Obvious under 35 U.S.C. § 103 over Money, Kiani, Akai, Fujisaki, Estep,
		7	20	Taylor, and Hylton
L	<u> </u>	,	20	
			5	Case No. 3:19-CV-01100-BAS-N

1	IPR					
2	Petition	Dotont No	IPR Crown d	Claima	Crounds of Ungstantshility	
3	No.	Patent No.	Ground	Claims 1-4,7,	Grounds of Unpatentability U.S. Patent No. 7,079,035 to Bock and	
4			1	12-15	U.S. Patent No. 6,597,933 to Kiani	
	IPR2020	RE47,218			U.S. Patent No. 7,079,035 to Bock, PCT	
5	-01078	10217,210		5,6,	Publication No. WO2009/093159 to	
6			2	8-10, 16-18	Woehrle, and U.S. Patent No. 6,597,933 to Kiani	
7				10 10	U.S. Patent Publication No. 2008/0287756	
8					to Lynn and Influence of Pulse Oximeter	
					Lower Alarm Limit on the Incidence of	
9				1.2	Hypoxaemia in the Recovery Room,	
10			1	1-3, 5-7	British Journal of Anaesthesia, 1997 (Kalkman)	
11					U.S. Patent Publication No. 2008/0287756	
12					to Lynn, Influence of Pulse Oximeter	
	IPR2020	10,255,994			Lower Alarm Limit on the Incidence of	
13	-01082				Hypoxaemia in the Recovery Room, British Journal of Anaesthesia, 1997	
14	01002			3, 4,	(Kalkman), and U.S. Patent Publication	
15			2	7, 8	No. 2009/0326340 to Wang	
16					U.S. Patent Publication No. 2009/0326340	
					to Wang, U.S. Patent Publication No. 2009/0247851 to Batchelder, and	
17					Influence of Pulse Oximeter Lower Alarm	
18					Limit on the Incidence of Hypoxaemia in	
19					the Recovery Room, British Journal of	
			3	1-8	Anaesthesia, 1997 (Kalkman)	
20 21	Defendants hereby stipulate that if the Patent Trial and Appeal Board					
22	institutes IPR on IPR2020-00912, IPR2020-00954, IPR2020-00967, IPR2020-					
22	01015, IPR2020-01019, IPR2020-01033, IPR2020-01054, IPR2020-01078, and/or					
24	IPR 2020-01082, then Defendants will not pursue in this case the specific grounds					
25	identified	above in com	nection w	ith the re	ferenced patent(s) and claim(s) as	
26	originally	issued on the	instituted	l inter pa	rties review petition, or on any other	
27	ground for	a given pate	nt for whi	ich the B	oard institutes, that was raised or could	
28	have been	reasonably ra	aised in a	n IPR (i.e	e., any ground that could be raised under	

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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 <i>inter parties</i> review is instituted.
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	7 Case No. 3:19-CV-01100-BAS-NLS
I	

1	Dated: October 15, 2020	
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27	Attorneys for Defendant	
27	Sotera Wireless, Inc.	
20		
	5	Case No. 3:19-CV-01100-BAS-

1	CERTIFICATE OF SERVICE			
2	I hereby certify that on this 15th day of October 2020, I caused the			
3	foregoing to be filed electronically with the Clerk of Court and to be served via the			
4	Court's Electronic Filing System upon all counsel of record.			
5				
6	/s/ Rudolph A. Telscher, Jr.			
7	Rudolph A. Telscher, Jr			
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	9 Case No. 3:19-CV-01100-BAS-NLS			