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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 SOTERA WIRELESS, INC. AND HON HAI PRECISION INDUSTRY CO. LTD.'S LPR 3.3 INVALIDITY CONTENTIONS

I. INTRODUCTION

Pursuant to the Case Management Order Regulating Discovery and Other Pretrial Proceedings in a Patent Case (ECF No. 41), and Local Patent Rules 3.3 and 3.4, Defendants Sotera Wireless, Inc. ("Sotera") and Hon Hai Precision Industry Co., Ltd. ("Hon Hai") (collectively, "Defendants") provide the following Invalidity Contentions.

The claims currently asserted by Plaintiff Masimo Corporation ("Masimo") are as follows:

Claim 20 of U.S. Patent No. 9,788,735 ("the '735 patent");

Claims 16-20 of U.S. Patent No. 9,795,300 ("the '300 patent");

Claims 1-19 of U.S. Patent No. 9,872,623 ("the '623 patent");

Claims 1-22 of U.S. Patent No. 10,213,108 ("the '108 patent");

Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, and 26 of U.S. Patent No. RE47,244 ("the RE244 patent");

Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, and 25 of U.S. Patent No. RE47,353 ("the RE353 patent");

Claims 1, 6, 7, 8, 13, 14, 18, 19, and 24 of U.S. Patent No. RE47,249 ("the RE249 patent");

Claims 1, 2, 3, 4, 7, 12, 13, 14, 15, and 18 of U.S. Patent No. RE47,218 ("the RE218 patent"); and

Claims 1-8 of U.S. Patent No. 10,255,994 ("the '994 patent").

These are collectively referred to as the "Asserted Claims" of the "Asserted Patents." The Invalidity Contentions are limited to these Asserted Claims. Should Masimo be permitted to alter the Asserted Claims, Defendants reserve its right to supplement and amend its Invalidity Contentions.

Discovery and Defendants' investigation is far from complete at this stage. It is possible that Defendants will hereafter discover additional prior art pertinent to the Asserted Claims of the Asserted Patents, and/or learn of earlier priority dates of

art, and Defendants reserve their right to seek to amend and/or supplement these contentions within a reasonable time after becoming aware of additional prior art. Prior art not included in these Invalidity Contentions, whether known or unknown to Defendants, may become relevant based on subsequent events. In particular, Defendants are currently unaware of the extent, if any, to which Masimo will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Defendants. To the extent that such an issue arises, Defendants reserve the right to identify other references, including in the file histories of the Asserted Patents, that would anticipate or render obvious the allegedly missing limitation(s) of the Asserted Claims.

Defendants also reserve their right to supplement and/or amend these Invalidity Contentions after the Court has construed disputed claim terms. Defendants' ultimate contentions concerning the validity of the claims of the Asserted Patents may change based upon the Court's construction of the claims or positions that Masimo may take concerning infringement or validity issues after such construction. Nothing contained in these Invalidity Contentions or any accompanying exhibits or claim charts, however, should be understood or deemed to be an express or implied admission or contention with respect to the proper construction or scope of any terms in the Asserted Claims, nor should they be understood to adopt Masimo's stated claim construction or its proposed scope of the Asserted Claims.

II. INVALIDITY

A. Invalidity Under 35 U.S.C. §§ 102 and/or 103

Below Defendants provide specific portions of prior art references that disclose the elements of the Asserted Claims and render the claims anticipated and/or obvious under 35 U.S.C. §§ 102 and/or 103. Although Defendants have identified at least one citation per element for each reference, each and every disclosure of the same element in the reference is not necessarily identified. The

lack of a citation for an element should not be deemed an admission that the element is not disclosed or is not inherent in the reference. In an effort to focus the issues, Defendants identify only exemplary portions of cited references. It should be recognized that persons of ordinary skill in the art will generally read a prior art reference as a whole and in the context of other publications and literature and in light of the knowledge of one of ordinary skill in the art. To understand and interpret any specific statement or disclosure within a prior art reference, such persons would rely on other information within the reference, along with other publications and their scientific or engineering knowledge. Defendants consequently reserve the right to rely upon other unidentified portions of the prior art references and on other publications and expert testimony as to the knowledge of a person of ordinary skill to provide context, and as aids to understanding and interpreting the portions that art identified. Defendants also reserve the right to rely on other portions of the prior art references, other publications, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain cited references so as to render the claims obvious. Further, where Defendants identify a particular figure in a prior art reference, the identification should be understood to encompass the caption and description of the figure and any text relating to the figure in addition to the figure itself. Similarly, where an identified portion of text refers to a figure, the identification should be understood to include the figure as well.

1. Identification of Patents and Printed Publications (Patent L.R. 3.3a.)

Defendants identify the following prior art patents and printed publications that render the Asserted Claims invalid under 35 U.S.C. §§ 102(a), (b), (e), and/or 35 U.S.C. § 103:

- U.S. Patent No. 3,608,545 to Novack ("Novack") was filed on November 25, 1968 and issued September 28, 1971.

- U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki") was filed on September 11, 1981 and issued January 17, 1984.
- U.S. Patent No. 5,539,706 to Takenaka ("Takenaka") was filed on February 2, 1995 and issued July 23, 1996.
- U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker") was filed on September 30, 1997 and issued February 2, 1999.
- U.S. Patent No. 5,919,141 to Money ("Money") was filed on September 13, 1996 and issued July 6, 1999.
- U.S. Patent No. 6,241,684 to Amano ("Amano") was filed on February 2, 1998 and issued June 5, 2001.
- U.S. Patent No. 6,510,344 to Halpern ("Halpern") was filed on March 22, 2000 and issued January 21, 2003.
- U.S. Patent No. 6,816,266 to Varshneya ("Varshneya") was filed on November 19, 2002, published May 22, 2003, and issued November 9, 2004.
- U.S. Patent No. 6,840,904 to Goldberg ("Goldberg") was filed on October 11, 2001, published April 17, 2003, and issued January 11, 2005.
- U.S. Patent No. 6,897,788 to Khair ("Khair") was filed on April 17, 2002, published August 15, 2002, and issued May 24, 2005.
- U.S. Patent No. 7,079,035 to Bock ("Bock") was filed on May 19, 2003, published November 24, 2004, and issued July 18, 2006.
- U.S. Patent No. 7,399,277 to Saidara ("Saidara") was filed on June 3, 2004, published February 17, 2005, and issued July 15, 2008.
- U.S. Patent No. 7,769,436 to Boileau ("Boileau") was filed on June 4, 2007 and issued August 3, 2010.
- U.S. Patent No. 8,597,274 to Sloan ("Sloan") was filed on May 21, 2010, published November 25, 2010, and issued December 3, 2013.

- U.S. Patent No. 8,622,902 to Woehrle ("Woehrle") was filed on January 19, 2009, claiming priority to an application filed January 21, 2008, published December 23, 2010, and issued January 7, 2014.
- U.S. Patent No. 8,961,416 to Siddiqui ("Siddiqui") was filed on May 30, 2007, published October 4, 2007, and issued February 24, 2015.
- U.S. Patent Publication No. 2002/0098807 to Saarnimo ("Saarnimo") was filed on January 25, 2001 and published July 25, 2002.
- U.S. Patent Publication No. 2006/0220881 to Al-Ali ("Al-Ali") was filed on March 1, 2006 and published October 5, 2006.
- U.S. Patent Publication No. 2008/0183054 A1 to Kroeger ("Kroeger") was filed on January 25, 2008, published July 31, 2008, and identifies Provisional Application No. 60/887,168, filed on January 30, 2007, as a related U.S. application.
- U.S. Patent Publication No. 2008/0287756 to Lynn ("Lynn") was filed on May 16, 2008 and published November 20, 2008.
- U.S. Patent Publication No. 2009/0275807 to Sitzman ("Sitzman") was filed on May 2, 2008 and published November 5, 2009.
- U.S. Patent Publication No. 2009/0326340 to Wang ("Wang") was filed June 30, 2008 and published December 31, 2009.
- European Patent No. EP 0 920 729 B1 to Zuckerman ("Zuckerman") was filed August 18, 1997, published June 9, 1999, and issued April 5, 2000.
- European Patent Publication No. EP 0 880 936 A2 to Akai ("Akai") was filed on October 30, 1997 and published December 2, 1998.
- PCT Publication No. WO00/42911 A1 to Kiani ("Kiani") was filed on January 25, 2000 and published July 27, 2000.
- PCT Publication No. WO00/44274 to Pougatchev ("Pougatchev") was filed on January 28, 2000 and published August 3, 2000.

- Malangi, Swaroop, *Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm* (2003), Theses 526, New Jersey Institute of Technology, https://digitalcommons.njit.edu/theses/526, was published no later than Fall 2003 ("Malangi").
- Rheineck-Leyssius, A.T. and Kalkman, C.J., *Influence of Pulse Oximeter Lower Alarm Limit on the Incidence of Hypoxaemia in the Recovery Room*, 79 British Journal of Anesthesia 460-464 (1997) ("Kalkman").
- Tsien, Christine L., *TrendFinder: Automated Detection of Alarmable Trends*, Massachusetts Institute of Technology (June 2000) ("Tsien").
- Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications: High-speed Physical Layer in the 5 GHZ Band, IEEE Std 802.11(a)-1999, Supplement to IEEE Std 802.11-1999, Institute of Electrical and Electronics Engineers (1999) ("IEEE 802.11a").

2. Representative Claim Charts (Patent L.R. 3.3b–c.)

Defendants contend that each of the Asserted Claims is anticipated by and/or is rendered obvious in view of one or more of the items or prior art identified above, either alone or in combination. Although Defendants reserve the right to rely on other prior art disclosed or incorporated by reference herein, Defendants identify below representative prior art that renders invalid one or more of the Asserted Claims and includes accompanying claim charts that identify where specifically in each item of prior art each element of each Asserted Claim is found.

Exhibit	Patent	Claim(s) and Reference(s)
A-01	the '735 patent	Obviousness of Claim 20 under § 103 in view of EP0880936A2 (Akai), US Patent No. 6,840,904 (Goldberg), US2002/0098807 (Saarnimo), US Patent No. 4,425,921 (Fujisaki), and WO2000/042911 (Kiani)

Exhibit	Patent	Claim(s) and Reference(s)
A-02	the ’735 patent	Obviousness of Claim 20 under § 103 in view of US Patent No. 6,840,904 (Goldberg), US2002/0098807 (Saarnimo), US Patent No. 4,425,921 (Fujisaki), and WO2000/042911 (Kiani)
A-03	the ’735 patent	Obviousness of Claim 20 under § 103 in view of WO2000/042911A1 (Kiani), US Patent No. 6,241,684 (Amano), US2002/0098807 (Saarnimo), and US Patent No. 6,897,788 (Khair)
A-04	the ’735 patent	Obviousness of Claim 20 under § 103 in view of US Patent No. 5,919,141 (Money) and WO00/44274 (Pougatchev)
A-05	the ’735 patent	Obviousness of Claim 20 under § 103 in view of US Patent No. 5,919,141 (Money), WO00/44274 (Pougatchev), US2002/0098807 (Saarnimo), and WO2000/042911A1 (Kiani)
A-06	the ’735 patent	Obviousness of Claim 20 under § 103 in view of WO00/44274 (Pougatchev), US Patent No. 6,840,904 (Goldberg), US2002/0098807 (Saarnimo), US Patent No. 4,425,921 (Fujisaki), and WO2000/042911A1 (Kiani)
B-01	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of EP0880936A2 (Akai)
B-02	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of EP0880936A2 (Akai) and EP0920729 (Zuckerman)
B-03	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 6,840,904 (Goldberg)
B-04	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 6,840,904 (Goldberg), WO2000/042911A1 (Kiani), and EP0920729 (Zuckerman)
B-05	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of WO2000/042911A1 (Kiani) and EP0920729 (Zuckerman)
B-06	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of WO2000/042911A1 (Kiani) and US Patent No. 6,897,788 (Khair)
B-07	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of WO2000/042911A1 (Kiani) and IEEE 802.11(a)-1999

Exhibit	Patent	Claim(s) and Reference(s)
B-08	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of WO00/44274 (Pougatchev)
B-09	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of WO00/44274 (Pougatchev) and EP0920729 (Zuckerman)
B-10	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 5,919,141 (Money) and WO00/44274 (Pougatchev)
B-11	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 5,919,141 (Money), WO00/44274 (Pougatchev), and EP0920729 (Zuckerman)
B-12	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 5,919,141 (Money), WO00/44274 (Pougatchev), and IEEE 802.11(a)-1999
B-13	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 5,919,141 (Money) and US Patent No. 5,539,706 (Takenaka)
B-14	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 5,919,141 (Money), US Patent No. 5,539,706 (Takenaka),and EP0920729B1 (Zuckerman)
B-15	the ’300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 5,919,141 (Money), US Patent No. 5,539,706 (Takenaka), and IEEE 802.11(a)-1999
C-01	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of EP0880936A2 (Akai) and US 5,919,141 (Money)
C-02	the ’623 patent	Obviousness of Claim 1-19 under § 103 in view of EP0880936A2 (Akai) and WO2000/42911 (Kiani)
C-03	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of US 6,840,904 (Goldberg) and WO2000/042911 (Kiani)
C-04	the ’623 patent	Obviousness of Claim 1-19 under § 103 in view of US 6,840,904 (Goldberg), WO2000/042911 (Kiani), and US 5,919,141 (Money)
C-05	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of US 5,919,141 (Money) and EP0880936A2 (Akai)
C-06	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of US 5,919,141 (Money) and WO00/44274 (Pougatchev)

Exhibit	Patent	Claim(s) and Reference(s)
C-07	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of WO00/44274 (Pougatchev) and WO2000/42911 (Kiani)
C-08	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of WO00/44274 (Pougatchev) and US 5,919,141 (Money)
C-09	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of WO2000/42911 (Kiani) and EP0880936A2 (Akai)
C-10	the ’623 patent	Obviousness of Claims 1-19 under § 103 in view of WO2000/42911 (Kiani) and WO00/44274 (Pougatchev)
D-01	the ’108 patent	Anticipation of Claims 1-5 and 7-18 under § 102 by EP0880936 (Akai)
D-02	the ’108 patent	Obviousness of Claims 1-22 under § 103 in view of EP0880936 (Akai)
D-03	the ’108 patent	Obviousness of Claims 1-22 under § 103 in view of EP0880936 (Akai), US Patent No. 4,425,921 (Fujisaki), and WO2000/042911 (Kiani)
D-04	the ’108 patent	Anticipation of Claims 1-22 under § 102 by US Patent No. 6,480,904 (Goldberg)
D-05	the ’108 patent	Obviousness of Claim 20 under § 103 in view of US Patent No. 6,840,904 (Goldberg)
D-06	the ’108 patent	Obviousness of Claim 20 under § 103 in view of US Patent No. 6,840,904 (Goldberg), US Patent No. 4,425,921 (Fujisaki), and WO2000/042911 (Kiani)
D-07	the ’108 patent	Obviousness of Claims 1-22 under § 103 in view of WO2000/042911A1 (Kiani)
D-08	the ’108 patent	Obviousness of Claims 1-22 under § 103 in view of WO2000/042911A1 (Kiani), US Patent No. 6,897,788 (Khair), and US Patent No. 6,840,904 (Goldberg)
D-09	the ’108 patent	Obviousness of Claims 1-22 under § 103 in view of US Patent No. 5,919,141 (Money) and WO00/44274 (Pougatchev)
D-10	the ’108 patent	Anticipation of Claims 1-5 and 7-18 under § 102 by WO00/44274 (Pougatchev)
D-11	the ’108 patent	Obviousness of Claims 1-22 under § 103 in view of WO00/44274 (Pougatchev)
D-12	the ’108 patent	Obviousness of Claims 1-22 under § 103 in view of

Exhibit	Patent	Claim(s) and Reference(s)
		WO00/44274 (Pougatchev), US Patent No. 4,425,921 (Fujisaki), and WO2000/042911 (Kiani)
E-01	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25, 26 under § 102 in view of Baker; Obviousness of Claim 14 in view of Baker under § 103
E-02	the RE244 patent	Obviousness of Claim 14 under § 103 over U.S. Patent No. 5,865,736 (Baker) in view of U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
E-03	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 by U.S. Patent No. 3,608,545 (Novack); Alternatively, obviousness of claims 1, 6-8, 13, 14, 18, 19, 23, 25 and 26 under § 103 in view of Novack
E-04	the RE244 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
E-05	the RE244 patent	Obviousness of claims 1, 6-8, 13, 14, 18, 19, 23, 25 and 26 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 5,865,736 (Baker)
E-06	the RE244 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 5,865,736 (Baker) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
E-07	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of U.S. Patent No. 8,961,416 (Siddiqui); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of Siddiqui
E-08	the RE244 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of U.S. Patent No. 8,961,416 (Siddiqui), U.S. Patent Publication No. 2009/0326340 (Wang), and *Simulation and mathematical notation…* (Malangi)

Exhibit	Patent	Claim(s) and Reference(s)
E-09	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of U.S. Patent No. 7,399,277 (Saidara); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of Saidara
E-10	the RE244 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of U.S. Patent No. 7,399,277 (Saidara), U.S. Patent Publication No. 2009/0326340 (Wang), and *Simulation and mathematical notation*… (Malangi)
E-11	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of U.S. Patent No. 6,816,266 (Varshneya); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of Varshneya.
E-12	the RE244 patent	Obviousness of Claim 14 under § 103 in view of Varshneya and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang).
E-13	the RE244 patent	Obviousness of Claim 26 under § 103 in view of Varshneya and U.S. Patent No. 5,865,736 (Baker).
E-14	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 102 by U.S. Patent Publication No. 2009/0326340 (Wang); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of Wang
E-15	the RE244 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of U.S. Patent Publication No. 2009/0326340 (Wang), U.S. Patent No. 7,399,277 (Saidara) and *Simulation and mathematical notation…* (Malangi)
E-16	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25, 26 under § 102 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman); Alternatively, obviousness of Claims 1, 6-8, 13, 14 18, 19, 23, 25, 26 under § 103 in view of Sitzman
E-17	the RE244 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No.

Exhibit	Patent	Claim(s) and Reference(s)
		5,865,736 (Baker)
E-18	the RE244 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
E-19	the RE244 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 5,865,736 (Baker) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
E-20	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 25, 26 under § 102 to U.S. Patent No. 8,622,902 (Woehrle); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 to Woehrle
E-21	the RE244 patent	Obviousness of Claim 14 under § 102 to U.S. Patent No. 8,622,902 (Woehrle) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
F-01	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of Baker; Obviousness of Claim 14 in view of Baker under § 103
F-02	the RE353 patent	Obviousness of Claim 14 under § 103 over U.S. Patent No. 5,865,736 (Baker) in view of U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
F-03	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 by U.S. Patent No. 3,608,545 (Novack); Alternatively, obviousness of claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of Novack.
F-04	the RE353 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
F-05	the RE353 patent	Obviousness of claims 1, 6-8, 13, 14, 18, 19, 23, 25

Exhibit	Patent	Claim(s) and Reference(s)
		under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 5,865,736 (Baker).
F-06	the RE353 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 5,865,736 (Baker) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
F-07	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of U.S. Patent No. 8,961,416 (Siddiqui); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of Siddiqui
F-08	the RE353 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of U.S. Patent No. 8,961,416 (Siddiqui), U.S. Patent Publication No. 2009/0326340 (Wang), and *Simulation and mathematical notation…* (Malangi)
F-09	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of U.S. Patent No. 7,399,277 (Saidara); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of Saidara
F-10	the RE353 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of U.S. Patent No. 7,399,277 (Saidara), U.S. Patent Publication No. 2009/0326340 (Wang), and *Simulation and mathematical notation…* (Malangi)
F-11	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of U.S. Patent No. 6,816,266 (Varshneya); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of Varshneya
F-12	the RE353 patent	Obviousness of Claim 14 under § 103 in view of Varshneya and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
F-13	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 102 by U.S. Patent Publication No.

Exhibit	Patent	Claim(s) and Reference(s)
		2009/0326340 (Wang); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of Wang
F-14	the RE353 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of U.S. Patent Publication No. 2009/0326340 (Wang), U.S. Patent No. 7,399,277 (Saidara) and *Simulation and mathematical notation*… (Malangi)
F-15	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25 under § 102 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of Sitzman
F-16	the RE353 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 5,865,736 (Baker)
F-17	the RE353 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
F-18	the RE353 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 5,865,736 (Baker) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
F-19	the RE353 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 25 under § 102 to U.S. Patent No. 8,622,902 (Woehrle); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25 under § 103 to Woehrle
F-20	the RE353 patent	Obviousness of Claim 14 under § 103 to U.S. Patent No. 8,622,902 (Woehrle) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
G-01	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 24 under § 102 in view of Baker; Alternatively, obviousness of

Exhibit	Patent	Claim(s) and Reference(s)
		Claim 14 in view of Baker under § 103
G-02	the RE249 patent	Obviousness of Claim 14 under § 103 over U.S. Patent No. 5,865,736 (Baker) in view of U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
G-03	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 24 under § 102 by U.S. Patent No. 3,608,545 (Novack); Alternatively, obviousness of claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of Novack.
G-04	the RE249 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
G-05	the RE249 patent	Obviousness of claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 5,865,736 (Baker).
G-06	the RE249 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 3,608,545 (Novack) and U.S. Patent No. 5,865,736 (Baker) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
G-07	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 24 under § 102 in view of U.S. Patent No. 8,961,416 (Siddiqui); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of Siddiqui
G-08	the RE249 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of U.S. Patent No. 8,961,416 (Siddiqui), U.S. Patent Publication No. 2009/0326340 (Wang), and *Simulation and mathematical notation...* (Malangi)
G-09	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 24 under § 102 in view of U.S. Patent No. 7,399,277 (Saidara); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of Saidara
G-10	the RE249 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of U.S. Patent No. 7,399,277

Exhibit	Patent	Claim(s) and Reference(s)
		(Saidara), U.S. Patent Publication No. 2009/0326340 (Wang), and *Simulation and mathematical notation…* (Malangi)
G-11	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 24 under § 102 in view of U.S. Patent No. 6,816,266 (Varshneya); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 24 under § 103 in view of Varshneya
G-12	the RE249 patent	Obviousness of Claim 14 under § 103 in view of Varshneya and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
G-13	the RE249 patent	Obviousness of Claim 24 under § 103 in view of Varshneya and U.S. Patent No. 5,865,736 (Baker)
G-14	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 102 by U.S. Patent Publication No. 2009/0326340 (Wang); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of Wang
G-15	the RE249 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of U.S. Patent Publication No. 2009/0326340 (Wang), U.S. Patent No. 7,399,277 (Saidara) and Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm (Malangi)
G-16	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 24 under § 102 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman); Alternatively, obviousness of Claims 1, 6-8, 13, 14 18, 19, 24 under § 103 in view of Sitzman
G-17	the RE249 patent	Obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 5,865,736 (Baker)
G-18	the RE249 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)

Exhibit	Patent	Claim(s) and Reference(s)
G-19	the RE249 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent Publication No. 2009/0275807 (Sitzman) and U.S. Patent No. 5,865,736 (Baker) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
G-20	the RE249 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 24 under § 102 to U.S. Patent No. 8,622,902 (Woehrle); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 24 under § 103 to Woehrle
G-21	the RE249 patent	Obviousness of Claim 14 under § 103 to U.S. Patent No. 8,622,902 (Woehrle) and U.S. Patent No. 6,510,344 (Halpern) or U.S. Patent Publication No. 2006/0220881 (Al-Ali) or U.S. Patent Publication No. 2009/0326340 (Wang)
H-01	the RE218 patent	Anticipation of Claims 1-4, 7, 12-15, and 18 under § 102 by Bock
H-02	the RE218 patent	Anticipation of Claims 1-4, 7, 12-15, and 18 under § 102 by Boileau
H-03	the RE218 patent	Anticipation of Claims 1-4, 7, 12-15, and 18 under § 102 by Sloan
I-01	the ’994 patent	Anticipation of Claims 1, 2, 5, and 6 under § 102 by Tsien
I-02	the ’994 patent	Obviousness of Claims 2-4 and 6-8 under § 103 by Tsien in view of US2008/0183054 (Kroeger)
I-03	the ’994 patent	Obviousness of Claims 1-8 under § 103 by Kalkman in view of US2008/0183054 (Kroeger)
I-04	the ’994 patent	Anticipation of Claims 1-8 under § 102 by US2008/0287756 (Lynn)

3. Motivations to Combine

A person of ordinary skill in the art would have been motivated to combine the references identified above and in the attached exhibits for numerous reasons at the relevant time. In general, the reason, motivation, or suggestion to modify or combine the references in the manner claimed can be found in the explicit and/or implicit teachings and the prior art as a whole, the general knowledge of those

skilled in the art, including knowledge of trends in the field and knowledge that the art is of special interest or importance in the field, and from the fact that the references are in the same field of endeavor and/or seek to solve a common problem.

One of ordinary skill in the art would have been motivated to investigate the various existing solutions, systems, publications, and/or patents describing the field to address his particular needs. A person of ordinary skill would have been motivated to combine the identified prior art based on the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. These combinations and modifications of the prior art which render obvious the asserted claims of the patents-in-suit arise from ordinary innovation, ordinary skill, common sense, or would have been obvious to try or otherwise predictable. Design improvements and other market forces would have prompted those combinations and modifications. Additional detail regarding the motivation to combine particular prior art references is provided in the above identified exhibits.

B. Other Invalidity Grounds (Patent L.R. 3.3d–e)

One or more of the Asserted Claims of the Asserted Patents are invalid for lack of written description and/or enablement under 35 U.S.C. § 112 ¶ 1, and for failing to comply with the definiteness requirements of 35 U.S.C. § 112 ¶ 2. Below, Defendants set forth exemplary limitations that are invalid for failing to comply with one or more these requirements. Defendants contend that each dependent claim that depends from an independent claim that is invalid, as identified below, is also invalid for the same reasons. Defendants further expressly reserve the right to raise and address, once the parties have exchanged claim terms and constructions, any indefiniteness issues arising out of those exchanges.

1. Grounds of Invalidity for Indefiniteness Under 35 U.S.C. §112(2) (Patent L.R. 3.1d)

One or more of the Asserted Claims are also invalid as indefinite because they contain at least one term or limitation that fails to inform those skilled in the art "with reasonable certainty . . . about the scope of the inventions." *Nautilus, Inc. v. Biosig Instr., Inc.*, 134 S. Ct. 2120, 2124 (2014). Although the question of whether a given claim term is indefinite may turn on claim construction positions (including claim construction positions advocated by Masimo), Defendants allege that the Asserted Claims identified above are invalid because they include limitations and/or claim terms that fail to satisfy the definiteness requirement of 35 U.S.C. § 112 ¶ 2.

At least certain of the Asserted Claims of the '735 Patent violates 35 U.S.C. §112, ¶ 2. For example, Claim 20 is indefinite because the term "the housing having a size and shape configured to be secured to the lower arm of the patent" does not inform a person having ordinary skill in the art ("PHOSITA"), with reasonable certainty, of the invention's scope. Neither claim 20 nor the specification provides any limits as to how large or small the housing could be in order to meet this limitation. The specification provides no guidance for what housings are improperly sized or not shaped to fit on a lower arm of a patient. A PHOSITA would have no idea whether the housing they developed meets this limitation. Furthermore, each patient's arm will have a different size. The specification further provides no guidance for whether a size and shape will fit some but not all patients. Claim 20 is further indefinite because the term "a top of the first sensor port is located below the front of the housing" does not inform a PHOSITA, with reasonable certainty, of the invention's scope. A front of the housing is undefined. For example, a PHOSITA would not understand, with reasonable certainty, how, if at all, the "front of the housing" is different from the claimed "front side," or whether the "front of the housing" is it the face of the first side.

At least certain of the '300 Patent Asserted Claims are indefinite for failure to meet the requirements of 35 U.S.C. § 112, ¶ 2. For example, Claims 16–20 do not inform a PHOSITA, with reasonable certainty, as to the scope of the claims because the term "wherein the first sensor port is positioned on the device such that a wire extending from the first sensor communication port to the first type of physiological sensor arrangement extends from the device along an axis perpendicular to a face of the device upon which the first sensor port is positioned" is indefinite. It is unclear how the position of a port has any impact on the extending direction of a wire. Wires can include bends or will move with gravity. The port has no impact on the extending direction of the wire.

At least certain of the '623 Patent Asserted Claims are indefinite for failure to meet the requirements of 35 U.S.C. § 112, ¶ 2. For example, Claims 1–16 do not inform a PHOSITA, with reasonable certainty, as to the scope of those claims. A PHOSITA would not understand the meaning of the term "tail," which is not a term of art, nor what is the difference, if any, between a "tail" and a "cable." Moreover, these claims independently fail to meet the requirements of paragraph two because the term "wherein the first sensor port is positioned on the first side of the housing such that, when the tail is physically coupled to the first sensor port, the tail extends from the first sensor port along an axis perpendicular to a face of the first side of the housing on which the first sensor port is positioned" is indefinite. It is unclear how the position of a port has any impact on the extending direction of a wire. Wires can include bends or will move with gravity. The port has no impact on the extending direction of the wire. Thirdly, Claims 1–16 fail to meet the requirements of paragraph two because the term "a housing configured for, and having a size and shape configured for, mounting to a lower arm of the patient" is indefinite. Neither Claim 1 nor the specification provides any limits as to how large or small the housing could be in order to meet the limitation "having a size and shape configured to be secured to the lower arm of a patient". The

specification provides no guidance for what housing are improperly sized or shaped to not fit on a lower arm of a patient, which will necessarily be of various sizes. Claim 3 of the '623 Patent is further independently indefinite because the term "wherein the digit of the patient is the thumb" is indefinite. The specification explains that the pulse oximeter attaches to a finger, and FIG. 4A illustrates that the finger is the patient's middle finger. However, if the pulse oximeter were connected to the thumb, the wire could not extend perpendicularly to a front face of the housing because the wire would extend at an angle towards the patient's thumb. In order for the wire to extend perpendicularly, the pulse oximeter must attach to the middle finger. A PHOSITA would not understand how the wire could extend both perpendicularly and toward a patient's thumb.

At least certain of the '108 Patent Asserted Claims are indefinite for failure to meet the requirements of 35 U.S.C. § 112, ¶ 2. For example, Claims 1–18 fail to inform a PHOSITA, with reasonable certainty, as to the scope of the claims because the term "wherein the first sensor port is positioned on the first side of the housing such that, when the tail is physically coupled to the first sensor port, the tail extends from the first sensor port along an axis perpendicular to a face of the first side of the housing on which the first sensor port is positioned" is indefinite. It is unclear how the position of a port has any impact on the extending direction of a wire. Wires can include bends or will move with gravity. The port has no impact on the extending direction of the wire. Claim 2 also fails to inform a PHOSITA, with reasonable certainty, as to the scope of the claim because the term "a tail configured to electrically convey the signal" is indefinite. A PHOSITA would not understand the meaning of the term "tail," which is not a term of art, nor the difference, if any, between a "tail" and a "cable." Claims 4 and 8 also fail to inform a PHOSITA, with reasonable certainty, as to the scope of those claims because the term "wherein the digit of the patient is the thumb" is indefinite. The specification explains that the pulse oximeter attaches to a finger, and FIG. 4A

illustrates that the finger is the patient's middle finger. However, if the pulse oximeter were connected to the thumb, the wire could not extend perpendicularly to a front face of the housing because the wire would extend at an angle towards the patient's thumb. In order for the wire to extend perpendicularly, the pulse oximeter must attach to the middle finger. A PHOSITA would not understand how the wire could extend both perpendicularly and toward a patient's thumb.

All Asserted Claims of the RE244 patent are invalid as indefinite under 35 U.S.C. § 112, ¶ 2. The claim term "determine that the measurement of the physiological parameter satisfies an alarm activation threshold" (claim 1), and minor variations of that claim term in claims 8, 13, 18, and 19, does not inform a PHOSITA, with reasonable certainty, as to the scope of the claims because a PHOSITA would not understand whether the alarm has been activated or not before initiation of the parameter-specific alarm "delay" or "suspension" period of time.

All Asserted Claims of the RE353 patent are invalid as indefinite under 35 U.S.C. § 112, ¶ 2. The claim term "determine that an alarm should be activated in response to the measurement of the physiological parameter satisfying an alarm activation threshold" (claim 1), and minor variations of that claim term in claims 8, 13, 18, and 19, does not inform a PHOSITA, with reasonable certainty, as to the scope of the claims because a PHOSITA would not understand whether the alarm has been activated or not before initiation of the parameter-specific alarm "suspension" period of time.

All Asserted Claims of the RE249 patent are invalid as indefinite under 35 U.S.C. § 112, ¶ 2 because the claim terms "hold," "holding," "hold initiator," and "parameter-specific alarm *hold* period of time" do not inform a PHOSITA, with reasonable certainty, as to the scope of the claims. These claim terms are not referenced in the specification, nor were they found in the original claims of the original '121 patent. These claim terms are not terms of art and a person of ordinary skill in the art would not know whether these claim terms are used

interchangeably with, or whether they differ in scope from, the "suspend" and "suspension" claim terms found in the original '121 patent.

All Asserted Claims of the RE249 patent are invalid as indefinite under 35 U.S.C. § 112, ¶ 2. The claim term "determine whether an alarm condition exists by determining whether an activation threshold has been satisfied by the measurement of the physiological parameter" (claim 1), and minor variations of that claim term in claims 8, 13, 18, and 19, does not inform a PHOSITA, with reasonable certainty, as to the scope of the claims because a PHOSITA would not understand whether the alarm has been activated or not before initiation of the parameter-specific alarm "hold" period of time.

At least certain of the RE218 Patent Asserted Claims are indefinite for failure to meet the requirements of 35 U.S.C. § 112, ¶ 2. The claims of the RE218 Patent do not inform, with reasonable specificity, a PHOSITA as to the scope of the claims because a PHOSITA would not understand the terms "offset" and "diminishing" in view of the specification. Moreover, the term "when at least one oxygen saturation value obtained over the first period of time exceeds a first alarm threshold, determine whether a first alarm should be triggered" does not inform a PHOSITA, with reasonable certainty, as to the scope of Claim 1 because a PHOSITA, reading the specification, would not understand when the alarm should be triggered and when it should not.

Discovery is early, and Defendants may well become aware of additional information relevant to these and possibly other invalidity defenses. Discovery, including expert discovery, may also reveal additional claim limitations that do not meet the requirements of § 112, ¶ 2. Defendants reserve their right to supplement or amend these grounds or to assert other grounds of invalidity consistent with the evidence. In addition, Defendants reserve the right to supplement or amend these contentions in view of claim construction positions and/or arguments made by Masimo.

2. Grounds of Invalidity for Lack of Written Description, Enabling Disclosure, or Failure to Describe the Best Mode Under 35 U.S.C. §112(1) (Patent L.R. 3.1e)

One or more Asserted Claims of the Asserted Patents are invalid under § 112 ¶ 1 for failing to particularly point out and distinctly claim the subject matter which the patentee regards as its alleged invention such that one skilled in the relevant art would be reasonably apprised of the bounds of the asserted claims when read in light of the specification. To satisfy the written description requirement, the patent "must clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed." *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*); *see Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 967–68 (Fed. Cir. 2006). The specifications of the Asserted Patents fail to meet the written description requirement of § 112 ¶ 1 with respect to the Asserted Claims because, among other reasons, one skilled in the art could not clearly conclude from the patent that the inventor possessed an invention that includes all of the claimed limitations.

Section 112 ¶ 1 also requires a patent to describe "the manner and process of making and using [the claimed invention], in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." A patent must disclose enough to permit a person of skill in the art, after reading the specification, to "practice the claimed invention without undue experimentation." *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008). Moreover, "[t]he full scope of the claimed invention must be enabled." *Id.* at 999–1000 ("Because the asserted claims are broad enough to cover both movies and video games, the patents must enable both embodiments."). "Enabling the full scope of each claim is 'part of the quid pro quo of the patent bargain.'" *Id.*

Certain of the Asserted Claims of the '735 Patent fail to meet the requirements of § 112, ¶ 1. For example, Claim 20 of the '735 Patent violates the

written description requirement under 35 U.S.C. §112, ¶ 1 because the specification does not describe or unequivocally show that a strap is specifically mounted to the back side of a housing. The specification merely mentions that the "case 412" is "mounted to the wrist strap 411". Furthermore, it is unclear from FIG. 3 and 4A where the strap mount to the case 412 (e.g. rear, sides, somewhere else). Without specific support, this limitation lacks written description support. Moreover, the term "wherein the front side of the housing comprises a… bezel" of claim 20 of the '735 Patent also violates the written description requirement because the specification never mentions, describes or illustrates a bezel. Furthermore, the term "first… second… third… ports" of Claim 20 of the '735 Patent violates the written description and/or enablement requirement(s) under 35 U.S.C. §112, ¶ 1 because the specification never describes or illustrates a wearable unit having three ports. The only wrist-mounted module described and illustrated by the specification only has one port (shown in FIG. 4A). Although the specification states that the wrist-mounted module 410 can include input ports, a PHOSITA would be unable to practice the claimed invention, without undue experimentation, because the PHOSITA would be unable to create a device that is "sized and shaped to fit on a wrist" that also has at least three ports. In addition, term "wirelessly transmit a transmit signal . . . to a separate computing device configured to display, on a remote display, the measurement…" of Claim 20 of the '735 Patent violates the written description requirement because the specification only describes the wearable device as transmitting wireless data to a bedside monitor. A bedside monitor is not simply a separate computing device but a very specific device for bedside monitoring of a patient, which is not described in the '735 Patent.

Certain of the Asserted Claims of the '300 Patent fail to meet the requirements of § 112, ¶ 1. For example, Claims 16–20 do not meet the written description requirements and/or enablement requirements because the specification never describes or illustrates a wearable unit having three ports. The only wrist-

mounted module described and illustrated by the specification only has one port (shown in FIG. 4A). Although the specification states that the wrist-mounted module 410 can include input ports, a PHOSITA would be unable to practice the claimed invention, without undue experimentation, because the PHOSITA would be unable to create a device that is "sized and shaped to fit on a wrist" that also has at least three ports. Moreover, these claims also fail to meet the written description requirements because, although these claims include the limitation "wirelessly transmit the transmit signal to a receiving patient monitoring device that is not wired to the wearable physiological monitoring device," the specification only describes the wearable device as transmitting wireless data to a bedside monitor. A bedside monitor is not simply a separate computing device but a very specific device for bedside monitoring of a patient, which is not described in the '300 Patent.

Certain of the Asserted Claims of the '623 Patent fail to meet the requirements of § 112, ¶ 1. For example, Claims 1–19 do not meet the written description requirements and/or enablement requirements because the specification never describes or illustrates a wearable unit having three ports. The only wrist-mounted module described and illustrated by the specification only has one port (shown in FIG. 4A). Although the specification states that the wrist-mounted module 410 can include input ports, a PHOSITA would be unable to practice the claimed invention, without undue experimentation, because the PHOSITA would be unable to create a device that is "sized and shaped to fit on a wrist" that also has at least three ports. Moreover, these claims also fail to meet the written description requirements because, although these claims include the limitation "wirelessly transmit the transmit signal to a receiving patient monitoring device that is not wired to the wearable physiological monitoring device", the specification only describes the wearable device as transmitting wireless data to a bedside monitor. A bedside monitor is not simply a separate computing device but a very specific

device for bedside monitoring of a patient, which is not described in the '623 Patent. Claims 1-19 of the '623 Patent also independently do not meet the written description requirement because the specification does not describe or unequivocally show that a strap is specifically mounted to the back side of a housing.

Certain of the Asserted Claims of the '108 Patent fail to meet the requirements of § 112, ¶ 1. For example, Claims 1–22 do not meet the written description requirements and/or enablement requirements because the specification never describes or illustrates a wearable unit having three ports. The only wrist-mounted module described and illustrated by the specification only has one port (shown in FIG. 4A). Although the specification states that the wrist-mounted module 410 can include input ports, a PHOSITA would be unable to practice the claimed invention, without undue experimentation, because the PHOSITA would be unable to create a device that is "sized and shaped to fit on a wrist" that also has at least three ports. Moreover, these claims also fail to meet the written description requirements because, although these claims include the limitation "wirelessly transmit the transmit signal to a receiving patient monitoring device that is not wired to the wearable physiological monitoring device", the specification only describes the wearable device as transmitting wireless data to a bedside monitor. A bedside monitor is not simply a separate computing device but a very specific device for bedside monitoring of a patient, which is not described in the '623 Patent. Claims 1-22 of the '108 Patent also independently do not meet the written description requirement because the specification does not describe or unequivocally show that a strap is specifically mounted to the back side of a housing.

All Asserted Claims of the RE244 patent are invalid for failing to meet the written description requirement of 35 U.S.C. § 112, ¶ 1. To the extent that Masimo contends the parameter-specific alarm "delay" period of time as used in all

Asserted Claims of the RE244 patent encompasses the ViSi System's alarm delays that are used to delay *activation* of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time (i.e., the time delay is *part of* the alarm threshold), the specification of the RE244 patent does not provide written description for such a broad claim scope under 35 U.S.C. § 112, ¶ 1. The specification makes clear that "delay" and "suspension" are not synonymous. Alarm "suspensions" are only described in the specification as the silencing of an alarm *after* it has been activated, with such "suspension" periods of time correspond with the amount of time required to *treat* an alarm condition, and the alarm *resumes* after the suspension period of time expires. For example, the RE244 patent describes:

> An audible alarm may be temporarily suspended by pressing an alarm silence button so as to prevent unnecessary disturbance to the patient and distraction of the caregiver. During alarm suspension, visual alarms remain active if an alarm condition persists after a predetermined alarm suspend period, the audible alarm resumes. The alarm suspend period is typically long enough to give a caregiver sufficient time to intervene with appropriate patient treatment yet short enough to ensure that patient health is not endangered if intervention is not effective.

RE244 patent, 2:33-42; *see also* Abstract.

In contrast, the specification only references alarm "delay" in a single sentence as an example of "other alarm features," distinct from "suspensions," and the referenced "delay" is explicitly described as applying to *all* enabled parameters (i.e., *not* parameter-specific): "Other alarm features apply to both slow treatment and fast treatment parameters. For example, an alarm delay of 0, 5, 10 or 15 seconds applies to all enabled parameters." RE244, 6:38-40. Accordingly, all Asserted Claims of the RE244 patent are invalid for lack of written description because there is no written description support for a parameter-specific "delay," nor is there written description support for a "delay" that is part of an alarm

threshold and is used to delay activation of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time.

To the extent that Masimo contends the parameter-specific alarm "suspension" period of time as used in all Asserted Claims of the RE244 patent encompasses the ViSi System's alarm delays that are used to delay *activation* of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time (i.e., the time delay is *part of* the alarm threshold), the specification of the RE244 patent does not provide written description for such a broad claim scope under 35 U.S.C. § 112, ¶ 1. Alarm "suspensions" are only described in the specification as the silencing of an alarm *after* it has been activated, with such "suspension" periods of time correspond with the amount of time required to *treat* an alarm condition, and the alarm *resumes* after the suspension period of time expires. For example, the RE244 patent describes:

> An audible alarm may be temporarily suspended by pressing an alarm silence button so as to prevent unnecessary disturbance to the patient and distraction of the caregiver. During alarm suspension, visual alarms remain active if an alarm condition persists after a predetermined alarm suspend period, the audible alarm resumes. The alarm suspend period is typically long enough to give a caregiver sufficient time to intervene with appropriate patient treatment yet short enough to ensure that patient health is not endangered if intervention is not effective.

RE244 patent, 2:33-42; *see also* RE244 patent, Abstract.

Accordingly, all Asserted Claims of the RE244 patent are invalid for lack of written description because there is no written description support for a parameter-specific alarm "suspension" that is part of an alarm threshold and is used to delay activation of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time.

Similarly, all Asserted Claims of the RE244 patent fail to meet the written description requirement under § 112, ¶ 1 because the specification does not describe, suggest or illustrate "delaying" or "suspending" an alarm before it has

been activated. Accordingly, to the extent that Masimo contends that the limitation "determine that the measurement of the physiological parameter satisfies an alarm activation threshold" (claim 1), and minor variations of that claim term in claims 8, 13, 18, and 19, does not require activation of the alarm prior to initiation of the parameter-specific alarm "delays" and "suspensions", the claims are invalid for lacking written description.

All Asserted Claims of the RE244 patent are invalid under 35 U.S.C. § 112, ¶ 1 because there is no written description support for "delaying," or "suspending," visual alarms, but that is encompassed by each independent claim. "Delaying" or "suspending" visual alarms was also not included in the original claims of the original '121 patent. The specification of the RE244 patent only describes silencing audible alarms for a predetermined amount of time after an alarm is activated, but do not suggest, describe or illustrate suspension of visual alarms.

All Asserted Claims of the RE244 patent are invalid under 35 U.S.C. § 112, ¶ 1 because there is no written description support for initiating a "delay" or "suspension" of an alarm automatically. The specification of the RE244 patent only describes a *user* initiating an alarm "delay" or "suspension" by, for example, pressing an alarm silence button. To the extent that the claims of the RE244 patent are broad enough to encompass automatic initiation of an alarm "delay" or "suspension," by the claimed system or method, the claims lack written support.

All Asserted Claims of the RE353 patent are invalid for failing to meet the written description requirement of 35 U.S.C. § 112, ¶ 1. To the extent that Masimo contends the parameter-specific alarm "suspension" period of time as used in all Asserted Claims of the RE353 patent encompasses the ViSi System's alarm delays that are used to delay *activation* of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time (i.e., the time delay is *part of* the alarm threshold), the specification of the RE353 patent does not provide written description for such a broad claim scope under 35 U.S.C. § 112, ¶ 1. Alarm

"suspensions" are only described in the specification as the silencing of an alarm *after* it has been activated, with such "suspension" periods of time correspond with the amount of time required to *treat* an alarm condition, and the alarm *resumes* after the suspension period of time expires. For example, the RE353 patent describes:

> An audible alarm may be temporarily suspended by pressing an alarm silence button so as to prevent unnecessary disturbance to the patient and distraction of the caregiver. During alarm suspension, visual alarms remain active if an alarm condition persists after a predetermined alarm suspend period, the audible alarm resumes. The alarm suspend period is typically long enough to give a caregiver sufficient time to intervene with appropriate patient treatment yet short enough to ensure that patient health is not endangered if intervention is not effective.

RE353 patent, 2:33-42; *see also* RE353 patent, Abstract.

Accordingly, all Asserted Claims of the RE353 patent are invalid for lack of written description because there is no written description support for a parameter-specific alarm "suspension" that is part of an alarm threshold and is used to delay activation of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time.

Similarly, none of the Asserted Claims of the RE353 patent meet the written description requirement under § 112, ¶ 1 because the specification does not describe, suggest or illustrate "suspending" an alarm before it has been activated. Accordingly, to the extent that Masimo contends that the limitation "determine that an alarm should be activated in response to the measurement of the physiological parameter satisfying an alarm activation threshold" (claim 1), in addition to minor variations of that claim term in claims 8, 13, 18, and 19, does not require activation of the alarm prior to initiation of the parameter-specific alarm "suspension", the claims are invalid for lacking written description.

All Asserted Claims of the RE353 patent are invalid under 35 U.S.C. § 112, ¶ 1 because there is no written description support for "suspending" visual alarms,

but that is encompassed by each independent claim. "Suspending" visual alarms was also not included in the original claims of the original '121 patent. The specification of the RE353 patent only describes silencing audible alarms for a predetermined amount of time after an alarm is activated, but do not suggest, describe or illustrate suspension of visual alarms.

All Asserted Claims of the RE353 patent are invalid under 35 U.S.C. § 112, ¶ 1 because there is no written description support for initiating a "suspension" of an alarm automatically. The specification of the RE353 patents only describe a *user* initiating an alarm "suspension" by, for example, pressing an alarm silence button. To the extent that the claims of the RE353 patent are broad enough to encompass automatic initiation of an alarm "suspension" by the claimed system or method, the claims lack written support.

All claims of the RE249 patent are invalid for lack of written description under 35 U.S.C. § 112, ¶ 1. The terms "hold," "holding," "hold initiator," and "parameter-specific alarm *hold* period of time" do not appear in the specification, and did not appear in the claims of the original patent, U.S. Patent No. 9,153,121 (the "'121 patent"). Accordingly, these claim terms lack written description support under 35 U.S.C. § 112, ¶ 1.

To the extent that Masimo contends the parameter-specific alarm "hold" period of time as used in all Asserted Claims of the RE249 patent encompasses the ViSi System's alarm delays that are used to delay *activation* of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time (i.e., the time delay is *part of* the alarm threshold), the specification of the RE249 patent does not provide written description for such a broad claim scope under 35 U.S.C. § 112, ¶ 1.

The RE249 patent specification only describes alarm "suspension" periods of time, which is taught in the specification as the silencing of an alarm *after* it has been activated, with such "suspension" periods of time correspond with the

amount of time required to *treat* an alarm condition, and the alarm *resumes* after the suspension period of time expires. For example, the RE244 patent describes:

> An audible alarm may be temporarily suspended by pressing an alarm silence button so as to prevent unnecessary disturbance to the patient and distraction of the caregiver. During alarm suspension, visual alarms remain active if an alarm condition persists after a predetermined alarm suspend period, the audible alarm resumes. The alarm suspend period is typically long enough to give a caregiver sufficient time to intervene with appropriate patient treatment yet short enough to ensure that patient health is not endangered if intervention is not effective.

RE244 patent, 2:33-42; *see also* Abstract.

To the extent "hold" is used interchangeably with "suspension," all Asserted Claims of the RE249 patent are invalid for lack of written description because there is no written description support for a parameter-specific alarm "hold" period of time that is part of an alarm threshold and is used to delay activation of an alarm until a physiological parameter exceeds a threshold for a predetermined amount of time.

Similarly, none of the Asserted Claims of the RE249 patent meet the written description requirement under § 112, ¶ 1 because the specification does not describe, suggest or illustrate "holding" an alarm before it has been activated. Accordingly, to the extent that Masimo contends that the limitation "determine whether an alarm condition exists by determining whether an activation threshold has been satisfied by the measurement of the physiological parameter" (claim 1), in addition to minor variations of that claim term in claims 8, 13, 18, and 19, does not require activation of the alarm prior to initiation of the parameter-specific alarm "suspension", the claims are invalid for lacking written description.

All Asserted Claims of the RE249 patent are invalid under 35 U.S.C. § 112, ¶ 1 because there is no written description support for "holding" visual alarms, but that is encompassed by each independent claim. "Holding" visual alarms was also not included in the original claims of the original '121 patent. The specification for

the RE249 patent only describes silencing audible alarms for a predetermined amount of time after an alarm is activated, but do not suggest, describe or illustrate suspension of visual alarms.

All Asserted Claims of the RE249 patent are invalid under 35 U.S.C. § 112, ¶ 1 because there is no written description support for initiating a "hold" of an alarm automatically. The specification of the RE249 patent only describes a *user* initiating an alarm "suspension" by, for example, pressing an alarm silence button. To the extent that the claims of the RE249 patent are broad enough to encompass automatic initiation of an alarm "hold" periods of time by the claimed system or method, the claims lack written support.

Certain of the Asserted Claims of the RE218 Patent fail to meet the requirements of § 112, ¶ 1. For example, the specification fails to enable or provide sufficient written description support for the claim limitation "and at an offset from the at least one oxygen saturation value, wherein the offset is diminished as a difference between the at least one first oxygen saturation value and the lower limit diminishes", as recited in Claims 1, 12, and incorporated in the dependent Asserted Claims. The specification never describes an offset or a diminishing of a difference or diminishing of a lower limit.

C. Additional Grounds of Invalidity

The Asserted Claims of the Asserted Patents are further invalid for additional reasons. For example, the RE218, RE244, RE249, RE353 patents are also invalid under the original patent rule, recapture doctrine, and overlooked aspects doctrine. In addition, Claims 1–8 of the 218 patent are directed toward an abstract idea and are invalid under section 101. *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014).

These additional grounds of invalidity are merely illustrative of additional reasons why the Asserted Claims of the Asserted Patents are invalid. Because Local Patent Rule 3.3 only requires the disclosure of invalidity ground under 35

U.S.C. §§ 102, 103 and 112, the foregoing theories of invalidity are not provided with this disclosure. Defendants' investigation is on-going and Defendants reserve the right to supplement and/or amend the above-identified grounds of invalidity.

D. Document Production

Sotera has produced copies of the prior art references identified herein pursuant to Patent L.R. 3.3.a that do not appear in the file history of the patents at issue. These documents include, but are not limited to, Bates numbers SOTERA00000001 – SOTERA00001034.

Sotera has produced documents sufficient to show the operation of any aspects or elements of the Accused Instrumentalities identified by the patent claimant in its Patent L.R. 3.1.a chart. These documents include, but are not limited, to Bates numbers SOTERA00003595 – SOTERA00009046.

Sotera has made source code for the Accused Instrumentalities available for inspection at the offices of local counsel, Procopio, Cory, Hargreaves & Savitch LLP in San Diego, CA. Review will take place pursuant to the Protective Order for this matter, and on dates agreed to by the parties.

Date: March 20, 2020

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CERTIFICATE OF SERVICE

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