

1 Rudolph A. Telscher, Jr.\* (MO Bar No. 41072)  
rudytelscher@huschblackwell.com  
2 Daisy Manning\* (MO Bar No. 62134)  
daisy.manning@huschblackwell.com  
3 Jennifer E. Hoekel\* (MO Bar No. 45880)  
jennifer.hoekel@huschblackwell.com  
4 HUSCH BLACKWELL LLP  
190 Carondelet Plaza, Suite 600  
5 St. Louis, MO 63105  
314-480-1500 Telephone

6 Nathan Sportel\* (IL Bar No. 6304061)  
nathan.sportel@huschblackwell.com  
7 HUSCH BLACKWELL LLP  
120 South Riverside Plaza Suite 2200  
8 Chicago, IL 60606  
312-655-1500 Telephone  
9

10 Dustin Taylor\* (CO Bar No. 54463)  
dustin.taylor@huschblackwell.com  
11 HUSCH BLACKWELL LLP  
1801 Wewatta St., Suite 1000  
12 Denver, CO 80205  
\*admitted *pro hac vice*

13 J. Christopher Jaczko (Bar No. 149317)  
chris.jaczko@procopio.com  
14 PROCOPIO, CORY, HARGREAVES  
& SAVITCH LLP  
15 12544 High Bluff Drive, Suite 400  
16 San Diego, CA 92130  
619-238-1900 Telephone

17 *Attorneys for Defendant*  
18 *Sotera Wireless, Inc.*

19 UNITED STATES DISTRICT COURT  
20 SOUTHERN DISTRICT OF CALIFORNIA

21 MASIMO CORPORATION, a  
22 California corporation,

23 *Plaintiff,*

24 v.

25 SOTERA WIRELESS, INC., a  
26 California corporation,

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

28 *Defendants.*

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

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

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

Defendants' Amended  
Invalidity Contentions

1    **I.    INTRODUCTION**

2           Pursuant to the Case Management Order Regulating Discovery and Other  
3    Pretrial Proceedings in a Patent Case (ECF No. 41), and Local Patent Rules 3.3 and  
4    3.6, Defendants Sotera Wireless, Inc. (“Sotera”) and Hon Hai Precision Industry  
5    Co., Ltd. (“Hon Hai”) (collectively, “Defendants”) provide the following Amended  
6    Invalidity Contentions.

7           The claims currently asserted by Plaintiff Masimo Corporation (“Masimo”)   
8    are as follows:

9           Claim 20 of U.S. Patent No. 9,788,735 (“the ’735 patent”);

10          Claims 16-20 of U.S. Patent No. 9,795,300 (“the ’300 patent”);

11          Claims 1-19 of U.S. Patent No. 9,872,623 (“the ’623 patent”);

12          Claims 1-22 of U.S. Patent No. 10,213,108 (“the ’108 patent”);

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

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

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

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

21          Claims 1-8 of U.S. Patent No. 10,255,994 (“the ’994 patent”).

22          These are collectively referred to as the “Asserted Claims” of the “Asserted  
23    Patents.” The Amended Invalidity Contentions are limited to these Asserted  
24    Claims. Should Masimo be permitted to alter the Asserted Claims, Defendants  
25    reserve its right to supplement and amend its Amended Invalidity Contentions.

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

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

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

## 22 **II. INVALIDITY**

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

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

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

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

24 Defendants identify the following prior art patents and printed publications  
25 that render the Asserted Claims invalid under 35 U.S.C. §§ 102(a), (b), (e), and/or  
26 35 U.S.C. § 103:

- 27 • U.S. Patent No. 4,425,921 to Fujisaki (“Fujisaki”) was filed on September  
28 11, 1981 and issued January 17, 1984.

- 1 • U.S. Patent No. 5,539,706 to Takenaka (“Takenaka”) was filed on
- 2 February 2, 1995 and issued July 23, 1996.
- 3 • U.S. Patent No. 5,865,736 to Baker, Jr. (“Baker-1”) was filed on
- 4 September 30, 1997 and issued February 2, 1999.
- 5 • U.S. Patent No. 5,919,141 to Money (“Money”) was filed on September
- 6 13, 1996 and issued July 6, 1999.
- 7 • U.S. Patent No. 6,241,684 to Amano (“Amano”) was filed on February 2,
- 8 1998 and issued June 5, 2001.
- 9 • U.S. Patent No. 6,597,933 to Kiani (“Kiani”) was filed on October 17,
- 10 2001 and issued July 22, 2003.
- 11 • U.S. Patent No. 6,816,266 to Varshneya (“Varshneya”) was filed on
- 12 November 19, 2002, published May 22, 2003, and issued November 9,
- 13 2004.
- 14 • U.S. Patent No. 6,840,904 to Goldberg (“Goldberg”) was filed on October
- 15 11, 2001, published April 17, 2003, and issued January 11, 2005.
- 16 • U.S. Patent No. 6,897,788 to Khair (“Khair”) was filed on April 17, 2002,
- 17 published August 15, 2002, and issued May 24, 2005.
- 18 • U.S. Patent No. 7,079,035 to Bock (“Bock”) was filed on May 19, 2003,
- 19 published November 24, 2004, and issued July 18, 2006.
- 20 • U.S. Patent No. 7,399,277 to Saidara (“Saidara”) was filed on June 3,
- 21 2004, published February 17, 2005 as U.S. Patent Publication No.
- 22 2005/0038332, and issued July 15, 2008.
- 23 • U.S. Patent No. 7,769,436 to Boileau (“Boileau”) was filed on June 4,
- 24 2007 and issued August 3, 2010.
- 25 • U.S. Patent No. 8,792,949 to Baker, Jr. (“Baker-2”) was filed on March 6,
- 26 2009 and issued July 29, 2014.
- 27 • U.S. Patent Publication No. 2002/0098807 to Saarnimo (“Saarnimo”) was
- 28 filed on January 25, 2001 and published July 25, 2002.

- 1 • U.S. Patent Publication No. 2006/0220881 to Al-Ali (“Al-Ali”) was filed  
2 on March 1, 2006 and published October 5, 2006.
- 3 • U.S. Patent Publication No. 2008/0183054 A1 to Kroeger (“Kroeger”)  
4 was filed on January 25, 2008, published July 31, 2008, and identifies  
5 Provisional Application No. 60/887,168, filed on January 30, 2007, as a  
6 related U.S. application.
- 7 • U.S. Patent Publication No. 2008/0287756 to Lynn (“Lynn”) was filed on  
8 May 16, 2008 and published November 20, 2008.
- 9 • U.S. Patent Publication No. 2009/0247851 to Batchelder (“Batchelder”)  
10 was filed on March 24, 2009 and published October 1, 2009.
- 11 • U.S. Patent Publication No. 2009/0326340 to Wang (“Wang”) was filed  
12 June 30, 2008 and published December 31, 2009.
- 13 • European Patent No. EP 0 920 729 B1 to Zuckerman (“Zuckerman”) was  
14 filed August 18, 1997, published June 9, 1999, and issued April 5, 2000.
- 15 • European Patent Publication No. EP 0 880 936 A2 to Akai (“Akai”) was  
16 filed on October 30, 1997 and published December 2, 1998.
- 17 • PCT Publication No. WO96/15594 to Taylor (“Taylor”) was filed on  
18 November 14, 1995 and published May 23, 1996.
- 19 • PCT Publication No. WO99/13698 to Estep (“Estep”) was filed on August  
20 28, 1998 and published March 18, 1999.
- 21 • PCT Publication No. WO00/42911 A1 to Kiani (“Kiani-WO”) was filed  
22 on January 25, 2000 and published July 27, 2000.
- 23 • PCT Publication No. WO00/44274 to Pougatchev (“Pougatchev”) was  
24 filed on January 28, 2000 and published August 3, 2000.
- 25 • Malangi, Swaroop, *Simulation and mathematical notation of alarms unit*  
26 *for computer assisted resuscitation algorithm* (2003), Theses 526, New  
27 Jersey Institute of Technology, <https://digitalcommons.njit.edu/theses/526>,  
28 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), US Patent No. 4,425,921 (Fujisaki), and WO2000/042911 (Kiani)
A-02	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)
A-03	the '735 patent	Obviousness of Claim 20 under § 103 in view of US Patent No. 6,840,904 (Goldberg) and WO2000/042911A1 (Kiani)

<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
A-04	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 WO2000/042911A1 (Kiani)
A-05	the '735 patent	Obviousness of Claim 20 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg"), PCT Publication No. WO 00/42911 to Kiani et al. ("Kiani"), U.S. Patent No. 5,919,141 to Money ("Money"), U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki"), and PCT Publication No. WO 99/13698 to Estep ("Estep")
A-06	the '735 patent	Obviousness of Claim 20 under § 103 in view of WO2000/042911A1 (Kiani) and US Patent No. 6,897,788 (Khair)
A-07	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-08	the '735 patent	Obviousness of Claim 20 under § 103 in view of US Patent No. 5,919,141 (Money) and WO00/44274 (Pougatchev)
A-09	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-10	the '735 patent	Obviousness of Claim 20 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money") and EP0880936A2 to Akai ("Akai") and PCT Publication No. WO 00/42911 to Kiani et al. ("Kiani") and U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki") and PCT Publication No. WO 99/13698 to Estep ("Estep")
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 EP0880936A2 (Akai), WO2000/042911 (Kiani), and EP0920729 (Zuckerman)



<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
B-04	the '300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 6,840,904 (Goldberg)
B-05	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-06	the '300 patent	Obviousness of Claims 16-20 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg"), PCT Publication No. WO 00/42911 to Kiani et al. ("Kiani"), and U.S. Patent No. 5,919,141 to Money ("Money")
B-07	the '300 patent	Obviousness of Claims 16-20 under § 103 in view of US Patent No. 6,840,904 (Goldberg), WO2000/042911A1 (Kiani), and IEEE 802.11(a)-1999
B-08	the '300 patent	Obviousness of Claims 16-20 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg"), PCT Publication No. WO 00/42911 to Kiani et al. ("Kiani"), U.S. Patent No. 5,919,141 to Money ("Money"), and PCT Publication No. WO96/15594 to Taylor ("Taylor")
B-09	the '300 patent	Obviousness of Claims 16-20 under § 103 in view of WO2000/042911A1 (Kiani) and EP0920729 (Zuckerman)
B-10	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-11	the '300 patent	Obviousness of Claims 16-20 under § 103 WO2000/042911A1 (Kiani) and IEEE 802.11(a)-1999
B-12	the '300 patent	Obviousness of Claims 16-20 under § 103 in view of WO2000/042911A1 (Kiani) and US Patent No. 6,840,904 (Goldberg)
B-13	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-14	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>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
B-15	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-16	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-17	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-18	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 IEEE802.11(a)-1999
B-19	the '300 patent	Obviousness of Claims 16-20 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money"), PCT Publication No. WO 00/42911 to Kiani et al. ("Kiani"), and EP0880936A2 to Akai ("Akai")
B-20	the '300 patent	Obviousness of Claims 16-20 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg"), PCT Publication No. WO 00/42911 to Kiani et al. ("Kiani"), EP0880936A2 to Akai ("Akai"), and PCT Publication No. WO96/15594 to Taylor ("Taylor")
C-01	the '623 patent	Obviousness of Claims 1-19 under § 103(a) in view of EP0880936A2 to Akai ("Akai") and U.S. Patent No. 5,919,141 to Money ("Money")
C-02	the '623 patent	Obviousness of Claim 1-19 under § 103(a) in view of EP0880936A2 to Akai ("Akai") and PCT Publication No. WO2000/42911 to Kiani ("Kiani-WO")
C-03	the '623 patent	Obviousness of Claims 1, 2, 4, 5, 12, 14, 15, 16, and 17 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg") and PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO")

<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
C-04	the '623 patent	Obviousness of Claims 6-11, 13, 18-19 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg") and PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO") and U.S. Patent No. 5,919,141 to Money ("Money")
C-05	the '623 patent	Obviousness of Claim 3 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg") and PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO") and U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki")
C-06	the '623 patent	Obviousness of Claims 1-19 under § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money") and EP0880936A2 to Akai ("Akai")
C-07	the '623 patent	Obviousness of Claims 1-2 and 4-19 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money"), PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO"), and EP0880936A2 to Akai ("Akai")
C-08	the '623 patent	Obviousness of Claim 3 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money"), PCT Publication No. WO 00/42911 to Kiani-WO ("Kiani-WO"), EP0880936A2 to Akai ("Akai"), and U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki")
C-09	the '623 patent	Obviousness of Claims 1-19 under § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money") and PCT Publication No. WO00/44274 to Pougatchev ("Pougatchev")
C-10	the '623 patent	Obviousness of Claims 1-19 under § 103(a) in view of PCT Publication No. WO2000/42911 to Kiani ("Kiani-WO") and EP0880936A2 to Akai ("Akai")
C-11	the '623 patent	Obviousness of Claims 1-19 under § 103(a) in view of PCT Publication No. WO2000/42911 to Kiani ("Kiani-WO") and PCT Publication No. WO00/44274 to Pougatchev ("Pougatchev")
C-12	the '623 patent	Obviousness of Claims 1-19 under § 103 in view of PCT Publication No. WO2000/42911 to Kiani ("Kiani-WO") and U.S. Patent No. 6,840,904 to Goldberg ("Goldberg")

<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
D-01	the '108 patent	Obviousness of Claims 1-22 under § 103(a) in view of EP0880936 to Akai ("Akai")
D-02	the '108 patent	Obviousness of Claims 1-22 under § 103(a) in view of EP0880936 to Akai ("Akai"), US Patent No. 4,425,921 to Fujisaki ("Fujisaki"), and PCT Publication No. WO2000/042911 to Kiani ("Kiani-WO")
D-03	the '108 patent	Obviousness of Claims 1-5 and 9-18 under 35 U.S.C. § 103(a) in view of EP0880936A2 to Akai ("Akai") and PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO")
D-04	the '108 patent	Obviousness of Claims 6-8 under 35 U.S.C. § 103(a) in view of EP0880936A2 to Akai ("Akai"), PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO"), and U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki")
D-05	the '108 patent	Obviousness of Claims 19-22 under 35 U.S.C. § 103(a) in view of EP0880936A2 to Akai ("Akai"), PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO"), and U.S. Patent No. 5,919,141 to Money ("Money")
D-06	the '108 patent	Obviousness of Claims 1-22 under § 103(a) in view of US Patent No. 6,840,904 to Goldberg ("Goldberg")
D-07	the '108 patent	Obviousness of Claim 1-22 under § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg"), U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki"), and PCT Publication No. WO2000/042911 to Kiani ("Kiani-WO")
D-08	the '108 patent	Obviousness of Claims 1-5 and 9-18 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg") and PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO")
D-09	the '108 patent	Obviousness of Claims 6-8 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg"), PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO"), and U.S. Patent No. 4,425,921 to Fujisaki ("Fujisaki")

<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
D-10	the '108 patent	Obviousness of Claims 19-22 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,840,904 to Goldberg ("Goldberg"), PCT Publication No. WO 00/42911 to Kiani ("Kiani-WO"), and U.S. Patent No. 5,919,141 to Money ("Money")
D-11	the '108 patent	Obviousness of Claims 1-22 under § 103(a) in view of PCT Publication No. WO2000/042911A1 to Kiani ("Kiani-WO")
D-12	the '108 patent	Obviousness of Claims 1-22 under § 103(a) in view of PCT Publication No. WO2000/042911A1 to Kiani (Kiani-WO) and U.S. Patent No. 6,840,904 to Goldberg ("Goldberg")
D-13	the '108 patent	Obviousness of Claims 1-22 under § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money") and PCT Publication No. WO00/44274 to Pougatchev ("Pougatchev")
D-14	the '108 patent	Obviousness of Claims 1-22 under § 103(a) in view of U.S. Patent No. 5,919,141 to Money ("Money") and U.S. Patent No. 6,840,904 to Goldberg ("Goldberg")
E-01	the RE244 patent	Anticipation of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 102 in view of Baker-1 U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1"); Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of Baker-1
E-02	the RE244 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1") and U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder")
E-03	the RE244 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1") and U.S. Patent No. 8,792,949 to Baker, Jr. ("Baker-2")

Exhibit	Patent	Claim(s) and Reference(s)
E-04	the RE244 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1"), U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder"), and U.S. Patent No. 8,792,949 to Baker, Jr. ("Baker-2")
E-05	the RE244 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara")
E-06	the RE244 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara") and Malangi, Swaroop, <i>Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm</i> (2003), Theses 526, New Jersey Institute of Technology ("Malangi")
E-07	the RE244 patent	Obviousness of Claims 14 and 26 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara"), Malangi, Swaroop, <i>Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm</i> (2003), Theses 526, New Jersey Institute of Technology ("Malangi"), and U.S. Patent Publication No. 2006/0220881 ("Al-Ali")
E-08	the RE244 patent	Obviousness of Claims 14 and 26 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara") and U.S. Patent Publication No. 2006/0220881 ("Al-Ali")
E-09	the RE244 patent	Anticipation of Claims 1, 6-8, 13, 18, 19, 23, 25, 26 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-10	the RE244 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 6,816,266 (Varshneya) and U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder")

<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
E-11	the RE244 patent	Obviousness of Claim 26 under § 103 in view of Varshneya and U.S. Patent No. 5,865,736 (Baker)
F-01	the RE353 patent	Anticipation of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25 under 35 U.S.C. § 102 in view of Baker-1 U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1"); Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of Baker-1
F-02	the RE353 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1") and U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder")
F-03	the RE353 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1") and U.S. Patent No. 8,792,949 to Baker, Jr. ("Baker-2")
F-04	the RE353 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1"), U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder"), and U.S. Patent No. 8,792,949 to Baker, Jr. ("Baker-2")
F-05	the RE353 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara")
F-06	the RE353 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara") and Malangi, Swaroop, <i>Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm</i> (2003), Theses 526, New Jersey Institute of Technology ("Malangi")

Exhibit	Patent	Claim(s) and Reference(s)
F-07	the RE353 patent	Obviousness of Claim 14 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara"), Malangi, Swaroop, <i>Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm</i> (2003), Theses 526, New Jersey Institute of Technology ("Malangi"), and U.S. Patent Publication No. 2006/0220881 ("Al-Ali")
F-08	the RE353 patent	Obviousness of Claim 14 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara") and U.S. Patent Publication No. 2006/0220881 ("Al-Ali")
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. 6,816,266 (Varshneya); Alternatively, obviousness of Claims 1, 6-8, 13, 14, 18, 19, 23, 25, 26 under § 103 in view of Varshneya
F-10	the RE353 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 6,816,266 (Varshneya) and U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder")
G-01	the RE249 patent	Anticipation of Claims 1, 6, 7, 8, 13, 14, 18, 19, 24 under 35 U.S.C. § 102 in view of Baker-1 U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1"); Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 23, 25, 26 under 35 U.S.C. § 103(a) in view of Baker-1
G-02	the RE249 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 24 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1") and U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder")
G-03	the RE249 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 24 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1") and U.S. Patent No. 8,792,949 to Baker, Jr. ("Baker-2")



<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
G-04	the RE249 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 24 under 35 U.S.C. § 103(a) in view of U.S. Patent No. 5,865,736 to Baker, Jr. ("Baker-1"), U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder"), and U.S. Patent No. 8,792,949 to Baker, Jr. ("Baker-2")
G-05	the RE249 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 24 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara")
G-06	the RE249 patent	Obviousness of Claims 1, 6, 7, 8, 13, 14, 18, 19, 24 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara") and Malangi, Swaroop, <i>Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm</i> (2003), Theses 526, New Jersey Institute of Technology ("Malangi")
G-07	the RE249 patent	Obviousness of Claims 14 and 24 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara"), Malangi, Swaroop, <i>Simulation and mathematical notation of alarms unit for computer assisted resuscitation algorithm</i> (2003), Theses 526, New Jersey Institute of Technology ("Malangi"), and U.S. Patent Publication No. 2006/0220881 ("Al-Ali")
G-08	the RE249 patent	Obviousness of Claims 14 and 24 under 35 U.S.C. § 103(a) in view of U.S. Patent Publication No. 2005/0038332 to Saidara ("Saidara") and U.S. Patent Publication No. 2006/0220881 ("Al-Ali")
G-09	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, 25, 26 under § 103 in view of Varshneya
G-10	the RE249 patent	Obviousness of Claim 14 under § 103 in view of U.S. Patent No. 6,816,266 (Varshneya) and U.S. Patent Publication No. 2009/0247851 to Batchelder ("Batchelder")

<b>Exhibit</b>	<b>Patent</b>	<b>Claim(s) and Reference(s)</b>
G-11	the RE249 patent	Obviousness of Claim 24 under § 103 in view of U.S. Patent No. 6,816,266 (Varshneya) and U.S. Patent No. 5,865,736 (Baker)
H-01	the RE218 patent	Obviousness of Claims 1-4, 7, 12-15, and 18 under 35 U.S.C. § 103(a) by United States Patent No. 7,079,035 to Bock (“Bock”) in view of United States Patent No. 6,597,933 to Kiani (“Kiani”)
H-02	the RE218 patent	Obviousness of claims 1-4, 7, 12-15 and 18 under § 103 by United States Patent No. 7,769,436 to Boileau (“Boileau”) in view of United States Patent No. 5,676,141 to Hollub (“Hollub”) or United States Patent No. 6,597,933 to Kiani (“Kiani”)
I-01	the ‘994 patent	Anticipation of Claims 1, 2, 5, and 6 under § 102 by Tsien; Alternatively, obviousness of Claims 1, 2, 5, and 6 under § 103 in view of 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 United States Publication No. 2008/0183054 to Kroeger (“Kroeger”)
I-04	the ‘994 patent	Anticipation of Claims 1-3 and 5-7 under § 102 in view of United States Publication No. 2008/0287756 to Lynn (“Lynn”); Alternatively, obviousness of Claims 1-3 and 5-7 under § 103(a) in view of Lynn
I-05	the ‘994 patent	Obviousness of Claims 1-3 and 5-7 under § 103(a) in view of United States Publication No. 2008/0287756 to Lynn (“Lynn”) and Kalkman
I-06	the ‘994 patent	Obviousness of Claims 3-4 and 7-8 under § 103(a) in view of United States Publication No. 2008/0287756 to Lynn (“Lynn”), Kalkman and United States Publication No. 2009/0326340 to Wang (“Wang”)
I-07	the ‘994 patent	Obviousness of Claims 1-8 under § 103(a) in view of United States Publication No. 2009/0326340 to Wang (“Wang”), United States Publication No. 2009/02477851 to Batchelder (“Batchelder”), and Kalkman

### 3. Motivations to Combine

1 A person of ordinary skill in the art would have been motivated to combine  
2 the references identified above and in the attached exhibits for numerous reasons at  
3 the relevant time. In general, the reason, motivation, or suggestion to modify or  
4 combine the references in the manner claimed can be found in the explicit and/or  
5 implicit teachings and the prior art as a whole, the general knowledge of those  
6 skilled in the art, including knowledge of trends in the field and knowledge that the  
7 art is of special interest or importance in the field, and from the fact that the  
8 references are in the same field of endeavor and/or seek to solve a common  
9 problem.

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

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

23 One or more of the Asserted Claims of the Asserted Patents are invalid for  
24 lack of written description and/or enablement under 35 U.S.C. § 112 ¶ 1, and for  
25 failing to comply with the definiteness requirements of 35 U.S.C. § 112 ¶ 2.  
26 Below, Defendants set forth exemplary limitations that are invalid for failing to  
27 comply with one or more these requirements. Defendants contend that each  
28 dependent claim that depends from an independent claim that is invalid, as

1 identified below, is also invalid for the same reasons. Defendants further expressly  
2 reserve the right to raise and address, once the parties have exchanged claim terms  
3 and constructions, any indefiniteness issues arising out of those exchanges.

4 **1. Grounds of Invalidity for Indefiniteness Under 35 U.S.C.**  
5 **§112(2) (Patent L.R. 3.1d)**

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

15 At least certain of the ’623 Patent Asserted Claims are indefinite for failure  
16 to meet the requirements of 35 U.S.C. § 112, ¶ 2. For example, Claims 1–16 do not  
17 inform a PHOSITA, with reasonable certainty, as to the scope of those claims. A  
18 PHOSITA would not understand the meaning of the term “tail,” which is not a  
19 term of art, nor what is the difference, if any, between a “tail” and a “cable.”

20 At least certain of the ’108 Patent Asserted Claims are indefinite for failure  
21 to meet the requirements of 35 U.S.C. § 112, ¶ 2. For example, Claim 2 fails to  
22 inform a PHOSITA, with reasonable certainty, as to the scope of the claim because  
23 the term “a tail configured to electrically convey the signal” is indefinite. A  
24 PHOSITA would not understand the meaning of the term “tail,” which is not a  
25 term of art, nor the difference, if any, between a “tail” and a “cable.”

26 All Asserted Claims of the RE244 patent are invalid as indefinite under 35  
27 U.S.C. § 112, ¶ 2. The claim term “one or more processors configured to  
28 electronically . . . initiate a parameter-specific alarm delay or suspension period of

1 time” (claim 1), and minor variations of that claim term in claims 8, 13, 18, 19, and  
2 25 does not inform a PHOSITA, with reasonable certainty, as to the scope of the  
3 claims because this claim term is governed by 35 U.S.C. § 112 ¶ 6, but no  
4 corresponding structure is disclosed that performs the claimed function without a  
5 user initiating the parameter-specific alarm delay or suspension period of time.

6 All Asserted Claims of the RE353 patent are invalid as indefinite under 35  
7 U.S.C. § 112, ¶ 2. The claim term “the one or more processors configured to  
8 electronically ... determine that an alarm suspension should be initiated for a  
9 parameter-specific alarm suspension period of time corresponding to the  
10 physiological parameter” (claim 1), and minor variations of that claim term in  
11 claims 8, 13, 18, and 19, does not inform a PHOSITA, with reasonable certainty,  
12 as to the scope of the claims because this claim term is governed by 35 U.S.C. §  
13 112 ¶ 6, but no corresponding structure is disclosed that performs the claimed  
14 function without a user initiating the parameter-specific alarm suspension period of  
15 time.

16 All Asserted Claims of the RE249 patent are invalid as indefinite under 35  
17 U.S.C. § 112, ¶ 2 because the claim term “alarm hold initiator” does not inform a  
18 PHOSITA, with reasonable certainty, as to the scope of the claims. This claim  
19 term is not referenced in the specification, nor is it found in the original claims of  
20 the original ‘121 patent.

21 All Asserted Claims of the RE249 patent are invalid as indefinite under 35  
22 U.S.C. § 112, ¶ 2. The claim term “one or more processors configured to  
23 electronically ... determine that the alarm hold initiator indicates to hold an  
24 indication of an alarm for the alarm condition” (claim 1), and minor variations of  
25 that claim term in claims 8, 13, 18, and 19, does not inform a PHOSITA, with  
26 reasonable certainty, as to the scope of the claims because this claim term is  
27 governed by 35 U.S.C. § 112 ¶ 6, but no corresponding structure is disclosed that  
28

1 performs the claimed function without a user initiating the parameter-specific  
2 alarm hold period of time.

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

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

13       One or more Asserted Claims of the Asserted Patents are invalid under  
14 § 112 ¶ 1 for failing to particularly point out and distinctly claim the subject matter  
15 which the patentee regards as its alleged invention such that one skilled in the  
16 relevant art would be reasonably apprised of the bounds of the asserted claims  
17 when read in light of the specification. To satisfy the written description  
18 requirement, the patent “must clearly allow persons of ordinary skill in the art to  
19 recognize that the inventor invented what is claimed.” *Ariad Pharm., Inc. v. Eli*  
20 *Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*); *see Kao Corp. v.*  
21 *Unilever U.S., Inc.*, 441 F.3d 963, 967–68 (Fed. Cir. 2006). The specifications of  
22 the Asserted Patents fail to meet the written description requirement of § 112 ¶ 1  
23 with respect to the Asserted Claims because, among other reasons, one skilled in  
24 the art could not clearly conclude from the patent that the inventor possessed an  
25 invention that includes all of the claimed limitations.

26       Section 112 ¶ 1 also requires a patent to describe “the manner and process of  
27 making and using [the claimed invention], in such full, clear, concise, and exact  
28 terms as to enable any person skilled in the art to which it pertains, or with which it

1 is most nearly connected, to make and use the same.” A patent must disclose  
2 enough to permit a person of skill in the art, after reading the specification, to  
3 “practice the claimed invention without undue experimentation.” *Sitrick v.*  
4 *Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008). Moreover, “[t]he full  
5 scope of the claimed invention must be enabled.” *Id.* at 999–1000 (“Because the  
6 asserted claims are broad enough to cover both movies and video games, the  
7 patents must enable both embodiments.”). “Enabling the full scope of each claim is  
8 ‘part of the quid pro quo of the patent bargain.’” *Id.*

9       Certain of the Asserted Claims of the ’735 Patent fail to meet the  
10 requirements of § 112, ¶ 1. For example, Claim 20 of the ’735 Patent violates the  
11 written description requirement under 35 U.S.C. §112, ¶ 1 because the specification  
12 does not describe or unequivocally show that a strap is specifically mounted to the  
13 back side of a housing. The specification merely mentions that the “case 412” is  
14 “mounted to the wrist strap 411”. Furthermore, it is unclear from FIG. 3 and 4A  
15 where the strap mount to the case 412 (e.g. rear, sides, somewhere else). Without  
16 specific support, this limitation lacks written description support. Moreover, the  
17 term “wherein the front side of the housing comprises a... bezel” of claim 20 of the  
18 ’735 Patent also violates the written description requirement because the  
19 specification never mentions, describes or illustrates a bezel. In addition, term  
20 “wirelessly transmit a transmit signal . . . to a separate computing device configured  
21 to display, on a remote display, the measurement...” of Claim 20 of the ’735 Patent  
22 violates the written description requirement because the specification only describes  
23 the wearable device as transmitting wireless data to a bedside monitor. A bedside  
24 monitor is not simply a separate computing device but a very specific device for  
25 bedside monitoring of a patient. The connection to the bedside monitor is only  
26 possible using a dedicated communications adapter, which plugs into a port on the  
27 bedside monitor and enables the wearable device to communicate wirelessly with  
28 the conventional bedside monitor. As such, the specification does not support the

1 broader notion that the wearable device can communicate with any separate  
2 computing device but only the specific communication adapter that plugs into the  
3 conventional bedside monitor. The specification describes the problem as  
4 eliminating the wire between the pulse oximetry sensor and the conventional  
5 bedside monitor. '735 Patent, 2:22-38. Thus, the specification supports only a  
6 narrow embodiment of wireless patient monitoring.

7 Certain of the Asserted Claims of the '300 Patent fail to meet the  
8 requirements of § 112, ¶ 1. For example, Claims 16–20 fail to meet the written  
9 description requirements because, although these claims include the limitation  
10 “wirelessly transmit the transmit signal to a receiving patient monitoring device that  
11 is not wired to the wearable physiological monitoring device,” the specification  
12 only describes the wearable device as transmitting wireless data to a bedside  
13 monitor. A bedside monitor is not simply a separate computing device but a very  
14 specific device for bedside monitoring of a patient. The connection to the bedside  
15 monitor is only possible using a dedicated communications adapter, which plugs  
16 into a port on the bedside monitor and enables the wearable device to communicate  
17 wirelessly with the conventional bedside monitor. As such, the specification does  
18 not support the broader notion that the wearable device can communicate with any  
19 separate computing device but only the specific communication adapter that plugs  
20 into the conventional bedside monitor. The specification describes the problem as  
21 eliminating the wire between the pulse oximetry sensor and the conventional  
22 bedside monitor. '300 Patent, 2:22-38. Thus, the specification supports only a  
23 narrow embodiment of wireless patient monitoring.

24 Certain of the Asserted Claims of the '623 Patent fail to meet the  
25 requirements of § 112, ¶ 1. For example, Claims 1–19 fail to meet the written  
26 description requirements because, although these claims include the limitation  
27 “wirelessly transmit the transmit signal to a receiving patient monitoring device  
28 that is not wired to the wearable physiological monitoring device”, the



1 specification only describes the wearable device as transmitting wireless data to a  
2 bedside monitor. A bedside monitor is not simply a separate computing device but  
3 a very specific device for bedside monitoring of a patient. The connection to the  
4 bedside monitor is only possible using a dedicated communications adapter, which  
5 plugs into a port on the bedside monitor and enables the wearable device to  
6 communicate wirelessly with the conventional bedside monitor. As such, the  
7 specification does not support the broader notion that the wearable device can  
8 communicate with any separate computing device but only the specific  
9 communication adapter that plugs into the conventional bedside monitor. The  
10 specification describes the problem as eliminating the wire between the pulse  
11 oximetry sensor and the conventional bedside monitor. '623 Patent, 2:22-38. Thus,  
12 the specification supports only a narrow embodiment of wireless patient  
13 monitoring. Claims 1-19 of the '623 Patent also independently do not meet the  
14 written description requirement because the specification does not describe or  
15 unequivocally show that a strap is specifically mounted to the back side of a  
16 housing.

17 Certain of the Asserted Claims of the '108 Patent fail to meet the  
18 requirements of § 112, ¶ 1. For example, Claims 1–22 fail to meet the written  
19 description requirements because, although these claims include the limitation  
20 “wirelessly transmit the transmit signal to a receiving patient monitoring device  
21 that is not wired to the wearable physiological monitoring device”, the  
22 specification only describes the wearable device as transmitting wireless data to a  
23 bedside monitor. A bedside monitor is not simply a separate computing device but  
24 a very specific device for bedside monitoring of a patient. The connection to the  
25 bedside monitor is only possible using a dedicated communications adapter, which  
26 plugs into a port on the bedside monitor and enables the wearable device to  
27 communicate wirelessly with the conventional bedside monitor. As such, the  
28 specification does not support the broader notion that the wearable device can

1 communicate with any separate computing device but only the specific  
2 communication adapter that plugs into the conventional bedside monitor. The  
3 specification describes the problem as eliminating the wire between the pulse  
4 oximetry sensor and the conventional bedside monitor. '108 Patent, 2:19-35. Thus,  
5 the specification supports only a narrow embodiment of wireless patient  
6 monitoring. Claims 1-22 of the '108 Patent also independently do not meet the  
7 written description requirement because the specification does not describe or  
8 unequivocally show that a strap is specifically mounted to the back side of a  
9 housing.

10 All Asserted Claims of the RE244 patent are invalid for failing to meet the  
11 written description requirement of 35 U.S.C. § 112, ¶ 1. To the extent that Masimo  
12 contends the parameter-specific alarm “delay” period of time as used in all  
13 Asserted Claims of the RE244 patent encompasses the ViSi System’s alarm delays  
14 that are used to delay *activation* of an alarm until a physiological parameter  
15 exceeds a threshold for a predetermined amount of time (i.e., the time delay is *part*  
16 *of* the alarm threshold), the specification of the RE244 patent does not provide  
17 written description for such a broad claim scope under 35 U.S.C. § 112, ¶ 1. The  
18 specification makes clear that “delay” and “suspension” are not synonymous.  
19 Alarm “suspensions” are only described in the specification as the silencing of an  
20 alarm *after* it has been activated, with such “suspension” periods of time  
21 correspond with the amount of time required to *treat* an alarm condition, and the  
22 alarm *resumes* after the suspension period of time expires. For example, the RE244  
23 patent describes:

24 An audible alarm may be temporarily suspended by  
25 pressing an alarm silence button so as to prevent  
26 unnecessary disturbance to the patient and distraction of  
27 the caregiver. During alarm suspension, visual alarms  
28 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

1 ensure that patient health is not endangered if  
2 intervention is not effective.

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

4 In contrast, the specification only references alarm “delay” in a single  
5 sentence as an example of “other alarm features,” distinct from “suspensions,” and  
6 the referenced “delay” is explicitly described as applying to *all* enabled parameters  
7 (i.e., *not* parameter-specific): “Other alarm features apply to both slow treatment  
8 and fast treatment parameters. For example, an alarm delay of 0, 5, 10 or 15  
9 seconds applies to all enabled parameters.” RE244, 6:38-40. Accordingly, all  
10 Asserted Claims of the RE244 patent are invalid for lack of written description  
11 because there is no written description support for a parameter-specific “delay,”  
12 nor is there written description support for a “delay” that is part of an alarm  
13 threshold and is used to delay activation of an alarm until a physiological  
14 parameter exceeds a threshold for a predetermined amount of time.

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

26 An audible alarm may be temporarily suspended by  
27 pressing an alarm silence button so as to prevent  
28 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

1 resumes. The alarm suspend period is typically long  
2 enough to give a caregiver sufficient time to intervene  
3 with appropriate patient treatment yet short enough to  
ensure that patient health is not endangered if  
intervention is not effective.

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

5 Accordingly, to the extent the claims are construed as Masimo proposes, all  
6 Asserted Claims of the RE244 patent are invalid for lack of written description  
7 because there is no written description support for a parameter-specific alarm  
8 “suspension” that is part of an alarm threshold and is used to delay activation of an  
9 alarm until a physiological parameter exceeds a threshold for a predetermined  
10 amount of time.

11 Similarly, all Asserted Claims of the RE244 patent fail to meet the written  
12 description requirement under § 112, ¶ 1 because the specification does not  
13 describe, suggest or illustrate “delaying” or “suspending” an alarm before it has  
14 been activated. Accordingly, to the extent that Masimo contends that the limitation  
15 “determine that the measurement of the physiological parameter satisfies an alarm  
16 activation threshold” (claim 1), and minor variations of that claim term in claims 8,  
17 13, 18, 19, and 25 does not require activation of the alarm prior to initiation of the  
18 parameter-specific alarm “delays” and “suspensions”, the claims are invalid for  
19 lacking written description.

20 All Asserted Claims of the RE244 patent are invalid under 35 U.S.C. § 112,  
21 ¶ 1 because there is no written description support for “delaying,” or “suspending,”  
22 visual alarms, but that is encompassed by each independent claim. “Delaying” or  
23 “suspending” visual alarms was also not included in the original claims of the  
24 original ‘121 patent. The specification of the RE244 patent only describes  
25 silencing audible alarms for a predetermined amount of time after an alarm is  
26 activated, but do not suggest, describe or illustrate suspension of visual alarms.

27 All Asserted Claims of the RE244 patent are invalid under 35 U.S.C. § 112,  
28 ¶ 1 because there is no written description support for initiating a “delay” or

1 “suspension” of an alarm automatically. The specification of the RE244 patent  
2 only describes a *user* initiating an alarm “delay” or “suspension” by, for example,  
3 pressing an alarm silence button. To the extent that the claims of the RE244 patent  
4 are broad enough to encompass automatic initiation of an alarm “delay” or  
5 “suspension,” by the claimed system or method, the claims lack written support.  
6 Similarly, all Asserted Claims of the RE244 patent are invalid under 35 U.S.C.  
7 § 112 ¶ 1 for lack of enablement because the specification does not enable a  
8 PHOSITA to make and use a medical monitoring system in which a processor  
9 initiates an alarm delay or suspension of an active alarm without a user initiating  
10 the alarm delay or suspension.

11 All Asserted Claims of the RE353 patent are invalid for failing to meet the  
12 written description requirement of 35 U.S.C. § 112, ¶ 1. To the extent that Masimo  
13 contends the parameter-specific alarm “suspension” period of time as used in all  
14 Asserted Claims of the RE353 patent encompasses the ViSi System’s alarm delays  
15 that are used to delay *activation* of an alarm until a physiological parameter  
16 exceeds a threshold for a predetermined amount of time (i.e., the time delay is *part*  
17 *of* the alarm threshold), the specification of the RE353 patent does not provide  
18 written description for such a broad claim scope under 35 U.S.C. § 112, ¶ 1. Alarm  
19 “suspensions” are only described in the specification as the silencing of an alarm  
20 *after* it has been activated, with such “suspension” periods of time correspond with  
21 the amount of time required to *treat* an alarm condition, and the alarm *resumes*  
22 after the suspension period of time expires. For example, the RE353 patent  
23 describes:

24 An audible alarm may be temporarily suspended by  
25 pressing an alarm silence button so as to prevent  
26 unnecessary disturbance to the patient and distraction of  
27 the caregiver. During alarm suspension, visual alarms  
28 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

1 ensure that patient health is not endangered if  
2 intervention is not effective.

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

4 Accordingly, to the extent the claims are construed as Masimo proposes, all  
5 Asserted Claims of the RE353 patent are invalid for lack of written description  
6 because there is no written description support for a parameter-specific alarm  
7 “suspension” that is part of an alarm threshold and is used to delay activation of an  
8 alarm until a physiological parameter exceeds a threshold for a predetermined  
9 amount of time.

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

19 All Asserted Claims of the RE353 patent are invalid under 35 U.S.C. § 112,  
20 ¶ 1 because there is no written description support for “suspending” visual alarms,  
21 but that is encompassed by each independent claim. “Suspending” visual alarms  
22 was also not included in the original claims of the original ‘121 patent. The  
23 specification of the RE353 patent only describes silencing audible alarms for a  
24 predetermined amount of time after an alarm is activated, but do not suggest,  
25 describe or illustrate suspension of visual alarms.

26 All Asserted Claims of the RE353 patent are invalid under 35 U.S.C. § 112,  
27 ¶ 1 because there is no written description support for initiating a “suspension” of  
28 an alarm automatically. The specification of the RE353 patents only describe a

1 *user* initiating an alarm “suspension” by, for example, pressing an alarm silence  
2 button. To the extent that the claims of the RE353 patent are broad enough to  
3 encompass automatic initiation of an alarm “suspension” by the claimed system or  
4 method, the claims lack written support. Similarly, all Asserted Claims of the  
5 RE353 patent are invalid under 35 U.S.C. § 112 ¶ 1 for lack of enablement because  
6 the specification does not enable a PHOSITA to make and use a medical  
7 monitoring system in which a processor initiates a suspension of an active alarm  
8 without a user initiating the alarm suspension.

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

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

22 The RE249 patent specification only describes alarm “suspension” periods  
23 of time, which is taught in the specification as the silencing of an alarm *after* it has  
24 been activated, with such “suspension” periods of time correspond with the  
25 amount of time required to *treat* an alarm condition, and the alarm *resumes* after  
26 the suspension period of time expires. For example, the RE244 patent describes:

27 An audible alarm may be temporarily suspended by  
28 pressing an alarm silence button so as to prevent  
unnecessary disturbance to the patient and distraction of

1 the caregiver. During alarm suspension, visual alarms  
2 remain active if an alarm condition persists after a  
3 predetermined alarm suspend period, the audible alarm  
4 resumes. The alarm suspend period is typically long  
5 enough to give a caregiver sufficient time to intervene  
6 with appropriate patient treatment yet short enough to  
7 ensure that patient health is not endangered if  
8 intervention is not effective.

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

10 To the extent “hold” is used interchangeably with “suspension,” and to the  
11 extent the claims are construed as Masimo proposes, all Asserted Claims of the  
12 RE249 patent are invalid for lack of written description because there is no written  
13 description support for a parameter-specific alarm “hold” period of time that is part  
14 of an alarm threshold and is used to delay activation of an alarm until a  
15 physiological parameter exceeds a threshold for a predetermined amount of time.

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

25 All Asserted Claims of the RE249 patent are invalid under 35 U.S.C. § 112,  
26 ¶ 1 because there is no written description support for “holding” visual alarms, but  
27 that is encompassed by each independent claim. “Holding” visual alarms was also  
28 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.



1 All Asserted Claims of the RE249 patent are invalid under 35 U.S.C. § 112,  
2 ¶ 1 because there is no written description support for initiating a “hold” of an  
3 alarm automatically. The specification of the RE249 patent only describes a *user*  
4 initiating an alarm “suspension” by, for example, pressing an alarm silence button.  
5 To the extent that the claims of the RE249 patent are broad enough to encompass  
6 automatic initiation of an alarm “hold” periods of time by the claimed system or  
7 method, the claims lack written support. Similarly, all Asserted Claims of the  
8 RE249 patent are invalid under 35 U.S.C. § 112 ¶ 1 for lack of enablement because  
9 the specification does not enable a PHOSITA to make and use a medical  
10 monitoring system in which a processor initiates a hold of an active alarm without  
11 a user initiating the alarm hold.

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

### 20 C. Essential Element

21 Claim 20 of the ’735 Patent fails to meet the requirements of § 112, ¶ 1 for  
22 failing to claim an essential element of the invention. *Gentry Gallery, Inc. v.*  
23 *Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998). Specifically, the  
24 specification explains that the purpose of the invention is to replace a patient cable  
25 between a pulse oximetry sensor and a conventional bedside monitor with a  
26 wireless connection. ’735 Patent, 2:23-38. The wireless connection with a  
27 conventional bedside monitor is only possible with a plug-compatible adapter that  
28 plugs into the conventional bedside monitor. *Id.* As such, the plug-compatible

1 adapter facilitating half of the wireless connection to the conventional bedside  
2 monitor is an essential element of the invention described by the specification of  
3 the '735 Patent. However, the claims omit any mention of a plug-compatible  
4 adapter for either a conventional bedside monitor or the claimed "separate  
5 computing device" as part of the claimed wireless transmission. Due to this  
6 omission, claim 20 fails the essential element test, and thereby violates § 112, ¶ 1.  
7 *Gentry*, 134 F.3d at 1479.

8 Claims 16-20 of the '300 Patent fail to meet the requirements of § 112, ¶ 1  
9 for failing to claim an essential element of the invention. *Gentry*, 134 F.3d at 1479.  
10 Specifically, the specification explains that the purpose of the invention is to  
11 replace a patient cable between a pulse oximetry sensor and a conventional bedside  
12 monitor with a wireless connection. '300 Patent, 2:23-38. The wireless connection  
13 with a conventional bedside monitor is only possible with a plug-compatible  
14 adapter that plugs into the conventional bedside monitor. *Id.* As such, the plug-  
15 compatible adapter facilitating half of the wireless connection to the conventional  
16 bedside monitor is an essential element of the invention described by the  
17 specification of the '300 Patent. However, the claims omit any mention of a plug-  
18 compatible adapter for either a conventional bedside monitor or the claimed  
19 "patient monitoring device" as part of the claimed wireless transmission. Due to  
20 this omission, claims 16-20 fail the essential element test, and thereby violate  
21 § 112, ¶ 1. *Gentry*, 134 F.3d at 1479.

22 Claims 1-19 of the '623 Patent fail to meet the requirements of § 112, ¶ 1 for  
23 failing to claim an essential element of the invention. *Gentry*, 134 F.3d at 1479.  
24 Specifically, the specification explains that the purpose of the invention is to  
25 replace a patient cable between a pulse oximetry sensor and a conventional bedside  
26 monitor with a wireless connection. '623 Patent, 2:23-38. The wireless connection  
27 with a conventional bedside monitor is only possible with a plug-compatible  
28 adapter that plugs into the conventional bedside monitor. *Id.* As such, the plug-

1 compatible adapter facilitating half of the wireless connection to the conventional  
2 bedside monitor is an essential element of the invention described by the  
3 specification of the '623 Patent. However, the claims omit any mention of a plug-  
4 compatible adapter for either a conventional bedside monitor or the claimed  
5 "separate computing device" as part of the claimed wireless transmission. Due to  
6 this omission, claims 1-19 fail the essential element test, and thereby violate § 112,  
7 ¶ 1. *Gentry*, 134 F.3d at 1479

8 Claims 1-22 of the '108 Patent fail to meet the requirements of § 112, ¶ 1 for  
9 failing to claim an essential element of the invention. *Gentry*, 134 F.3d at 1479.  
10 Specifically, the specification explains that the purpose of the invention is to  
11 replace a patient cable between a pulse oximetry sensor and a conventional bedside  
12 monitor with a wireless connection. '108 Patent, 2:19-35. The wireless connection  
13 with a conventional bedside monitor is only possible with a plug-compatible  
14 adapter that plugs into the conventional bedside monitor. *Id.* As such, the plug-  
15 compatible adapter facilitating half of the wireless connection to the conventional  
16 bedside monitor is an essential element of the invention described by the  
17 specification of the '108 Patent. However, the claims omit any mention of a plug-  
18 compatible adapter for either a conventional bedside monitor or the claimed  
19 "patient monitoring device" as part of the claimed wireless transmission. Due to  
20 this omission, claims 1-22 fail the essential element test, and thereby violate § 112,  
21 ¶ 1. *Gentry*, 134 F.3d at 1479.

22 All Asserted Claims of the RE244 Patent fails to meet the requirements of  
23 § 112, ¶ 1 for failing to claim an essential element of the invention. *Gentry*  
24 *Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998). Specifically,  
25 the specification explains that the purpose of the invention is to enable a user to  
26 silence active alarms for a period of time corresponding to the length of time it  
27 takes for a person to respond to medical treatment for a particular out-of-limit  
28 parameter measurement. RE244 Patent, Abstract; 2:18-4:8. However, the claims,

1 as construed by Masimo, omit any mention of (1) an alarm being activated when a  
2 physiological parameter measurement satisfies an alarm activation threshold; and  
3 (2) a user initiating the alarm delay or suspension period of time. Due to this  
4 omission, all Asserted Claims of the RE244 Patent fail the essential element test,  
5 and thereby violate § 112, ¶ 1. *Gentry*, 134 F.3d at 1479.

6 All Asserted Claims of the RE353 Patent fails to meet the requirements of  
7 § 112, ¶ 1 for failing to claim an essential element of the invention. *Gentry*  
8 *Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998). Specifically,  
9 the specification explains that the purpose of the invention is to enable a user to  
10 silence active alarms for a period of time corresponding to the length of time it  
11 takes for a person to respond to medical treatment for a particular out-of-limit  
12 parameter measurement. RE353 Patent, Abstract; 2:18-4:8. However, the claims,  
13 as construed by Masimo, omit any mention of (1) an alarm being activated when a  
14 physiological parameter measurement satisfies an alarm activation threshold; and  
15 (2) a user initiating the alarm suspension period of time. Due to this omission, all  
16 Asserted Claims of the RE249 Patent fail the essential element test, and thereby  
17 violate § 112, ¶ 1. *Gentry*, 134 F.3d at 1479.

18 All Asserted Claims of the RE249 Patent fails to meet the requirements of  
19 § 112, ¶ 1 for failing to claim an essential element of the invention. *Gentry*  
20 *Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998). Specifically,  
21 the specification explains that the purpose of the invention is to enable a user to  
22 silence active alarms for a period of time corresponding to the length of time it  
23 takes for a person to respond to medical treatment for a particular out-of-limit  
24 parameter measurement. RE249 Patent, Abstract; 2:18-4:8. However, the claims,  
25 as construed by Masimo, omit any mention of (1) an alarm being activated when a  
26 physiological parameter measurement satisfies an alarm activation threshold; and  
27 (2) a user initiating the alarm hold period of time. Due to this omission, all  
28

1 Asserted Claims of the RE249 Patent fail the essential element test, and thereby  
2 violate § 112, ¶ 1. *Gentry*, 134 F.3d at 1479.

3 **D. Recapture Doctrine**

4 All Asserted Claims of the RE244 Patent are invalid for violation of the  
5 Recapture Doctrine. Specifically, during prosecution of the original ‘121 patent,  
6 the applicant was required to amend the claims to include the limitation “*receive,*  
7 *from a user,* an indication of a parameter-specific alarm suspension period of time  
8 corresponding to the physiological parameter, the parameter-specific alarm  
9 suspension period of time being selected from a plurality of parameter-specific  
10 alarm suspension periods of time” in order to overcome the prior art. All Asserted  
11 Claims of the RE244 patent as construed by Masimo, however, removed the  
12 requirement that a user provides an indication of a parameter-specific alarm  
13 suspension period of time, thus broadening the scope of the claims to encompass  
14 subject matter surrendered during prosecution and are thus invalid under the  
15 Recapture Doctrine.

16 All Asserted Claims of the RE353 Patent are invalid for violation of the  
17 Recapture Doctrine. Specifically, during prosecution of the original ‘121 patent,  
18 the applicant was required to amend the claims to include the limitation “*receive,*  
19 *from a user,* an indication of a parameter-specific alarm suspension period of time  
20 corresponding to the physiological parameter, the parameter-specific alarm  
21 suspension period of time being selected from a plurality of parameter-specific  
22 alarm suspension periods of time” in order to overcome the prior art. All Asserted  
23 Claims of the RE353 patent as construed by Masimo, however, removed the  
24 requirement that a user provides an indication of a parameter-specific alarm  
25 suspension period of time, thus broadening the scope of the claims to encompass  
26 subject matter surrendered during prosecution and are thus invalid under the  
27 Recapture Doctrine.  
28

1 All Asserted Claims of the RE249 Patent are invalid for violation of the  
2 Recapture Doctrine. Specifically, during prosecution of the original ‘121 patent,  
3 the applicant was required to amend the claims to include the limitation “*receive,*  
4 *from a user,* an indication of a parameter-specific alarm suspension period of time  
5 corresponding to the physiological parameter, the parameter-specific alarm  
6 suspension period of time being selected from a plurality of parameter-specific  
7 alarm suspension periods of time” in order to overcome the prior art. All Asserted  
8 Claims of the RE249 patent as construed by Masimo, however, removed the  
9 requirement that a user provides an indication of a parameter-specific alarm  
10 suspension period of time, thus broadening the scope of the claims to encompass  
11 subject matter surrendered during prosecution and are thus invalid under the  
12 Recapture Doctrine.

13 **E. Original Patent Rule**

14 To the extent Masimo claims the Asserted claims of the RE244 Patent  
15 encompass parameter-specific *pre-alarm* delays that prevent activation of an alarm  
16 until a parameter measurement exceeds an alarm activation threshold for a period  
17 of time, all Asserted Claims of the RE244 Patent are invalid for violation of the  
18 Original Patent Rule. Specifically, the original ‘121 patent did not clearly and  
19 unequivocally disclose parameter-specific pre-alarm delays. Moreover, to the  
20 extent the Asserted Claims of the RE244 Patent encompass silencing of an active  
21 alarm without user initiation, the original ‘121 patent did not clearly and  
22 unequivocally disclose a system in which the processor automatically suspends an  
23 active alarm for a parameter-specific period of time.

24 To the extent Masimo claims the Asserted claims of the RE353 Patent  
25 encompass parameter-specific *pre-alarm* delays that prevent activation of an alarm  
26 until a parameter measurement exceeds an alarm activation threshold for a period  
27 of time, all Asserted Claims of the RE353 Patent are invalid for violation of the  
28 Original Patent Rule. Specifically, the original ‘121 patent did not clearly and

1 unequivocally disclose parameter-specific pre-alarm delays. Moreover, to the  
2 extent the Asserted Claims of the RE353 Patent encompass silencing of an active  
3 alarm without user initiation, the original '121 patent did not clearly and  
4 unequivocally disclose a system in which the processor automatically suspends an  
5 active alarm for a parameter-specific period of time.

6 To the extent Masimo claims the Asserted claims of the RE249 Patent  
7 encompass parameter-specific *pre-alarm* delays that prevent activation of an alarm  
8 until a parameter measurement exceeds an alarm activation threshold for a period  
9 of time, all Asserted Claims of the RE249 Patent are invalid for violation of the  
10 Original Patent Rule. Specifically, the original '121 patent did not clearly and  
11 unequivocally disclose parameter-specific pre-alarm delays. Moreover, to the  
12 extent the Asserted Claims of the RE249 Patent encompass silencing of an active  
13 alarm without user initiation, the original '121 patent did not clearly and  
14 unequivocally disclose a system in which the processor automatically suspends an  
15 active alarm for a parameter-specific period of time.

16 **F. Failure to Submit Supplemental Reissue Oath or Declaration**

17 All Asserted Claims of the RE244 Patent are invalid for failure to submit a  
18 supplemental reissue declaration under 37 C.F.R. § 1.175 particularly and  
19 distinctly specifying every departure from the original '121 patent. Specifically,  
20 despite several amendments to the Asserted Claims of the RE244 Patent during  
21 prosecution, the applicant only identified in its reissue declaration that it sought to  
22 broaden claim 1 by amending it to recite a noninvasive physiological sensor that  
23 does not necessarily include a plurality of light emitting diodes and at least one  
24 detector.

25 All Asserted Claims of the RE353 Patent are invalid for failure to submit a  
26 supplemental reissue declaration under 37 C.F.R. § 1.175 particularly and  
27 distinctly specifying every departure from the original '121 patent. Specifically,  
28 despite several amendments to the Asserted Claims of the RE353 Patent during

1 prosecution, the applicant only identified in its reissue declaration that it sought to  
2 broaden claim 1 by amending it to recite a noninvasive physiological sensor that  
3 does not necessarily include a plurality of light emitting diodes and at least one  
4 detector.

5 All Asserted Claims of the RE249 Patent are invalid for failure to submit a  
6 supplemental reissue declaration under 37 C.F.R. § 1.175 particularly and  
7 distinctly specifying every departure from the original '121 patent. Specifically,  
8 despite several amendments to the Asserted Claims of the RE249 Patent during  
9 prosecution, the applicant only identified in its reissue declaration that it sought to  
10 broaden claim 1 by amending it to recite a noninvasive physiological sensor that  
11 does not necessarily include a plurality of light emitting diodes and at least one  
12 detector.

### 13 **G. Additional Grounds of Invalidity**

14 The Asserted Claims of the Asserted Patents are further invalid for  
15 additional reasons. For example, the RE218, RE244, RE249, RE353 patents are  
16 directed toward an abstract idea and are invalid under section 101. *Alice Corp. v.*  
17 *CLS Bank International*, 573 U.S. 208 (2014). Defendants' investigation is on-  
18 going and Defendants reserve the right to supplement and/or amend the above-  
19 identified grounds of invalidity.

### 20 **H. Document Production**

21 Sotera has produced copies of the prior art references identified herein  
22 pursuant to Patent L.R. 3.3.a that do not appear in the file history of the patents at  
23 issue. These documents include, but are not limited to, Bates numbers  
24 SOTERA00000001 – SOTERA00001034. Sotera is further producing documents  
25 pursuant to Patent L.R. 3.3a herewith as Bates numbers SOTERA 00075694 –  
26 SOTERA 00075961 and SOTERA 00075962 – SOTERA 75974.

27 Sotera has produced documents sufficient to show the operation of any  
28 aspects or elements of the Accused Instrumentalities identified by the patent



1 claimant in its Patent L.R. 3.1.a chart. These documents include, but are not  
2 limited, to Bates numbers SOTERA00003595 – SOTERA00009046.

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

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1 Date: September 8, 2020

Respectfully submitted,

2 By: /s/ Daisy Manning

By: /s/ Hua Chen

3  
4 Rudolph A. Telscher, Jr.\*  
rudytelscher@huschblackwell.com  
5 Daisy Manning\*  
6 daisy.manning@huschblackwell.com  
Jennifer E. Hoekel\*  
7 jennifer.hoekel@huschblackwell.com  
8 HUSCH BLACKWELL LLP  
190 Carondelet Plaza, Suite 600  
9 St. Louis, MO 63105  
10 314-480-1500 Telephone

Hua Chen (SBN 241831)  
huachen@scienbizippc.com  
Calvin Chai (SBN 253389)  
calvinchai@scienbizippc.com  
Ying Lu (SBN 323384)  
winglu@scienbizippc.com  
SCIENBIZIP, P.C.  
550 South Hope Street, Ste. 2825  
Los Angeles, CA 90071  
Tel: 213.426.1771  
Fax: 213.426.1788

11 Nathan Sportel\*  
12 nathan.sportel@huschblackwell.com  
HUSCH BLACKWELL LLP  
13 120 S. Riverside Plaza, Suite 2200  
14 Chicago, IL 60606  
15 312-655-1500 Telephone

***Attorneys for Defendant Hon Hai  
Precision Industry Co., Ltd.***

16 Dustin Taylor\*  
17 dustin.taylor@huschblackwell.com  
HUSCH BLACKWELL LLP  
18 1801 Wewatta St., Suite 1000  
Denver, CO 80205  
19 303-749-7247 Telephone  
20 \*admitted *pro hac vice*

21 J. Christopher Jaczko (Bar No.  
22 149317)  
PROCOPIO, CORY,  
23 HARGREAVES & SAVITCH LLP  
24 12544 High Bluff Drive, Suite 400  
San Diego, CA 92130  
25 chris.jaczko@procopio.com  
26 619-238-1900 Telephone

27 ***Attorneys for Defendant***  
28 ***Sotera Wireless, Inc.***

1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on this 8th day of September 2020, I caused the  
3 foregoing to be served via email on all counsel of record at the following:

4 Joseph R. Re (SBN 134,479)  
5 joseph.re@knobbe.com  
6 Stephen C. Jensen (SBN 149,894)  
7 steve.jensen@knobbe.com  
8 Irfan A. Lateef (SBN 204,004)  
9 irfan.lateef@knobbe.com  
10 Brian C. Claassen (SBN 253627)  
11 brian.claassen@knobbe.com  
12 **Knobbe, Martens,  
Olson & Bear, LLP**  
2040 Main Street, 14<sup>th</sup> Floor  
Irvine, CA 92614  
Tel: (949) 760-0404  
Fax: (949) 760-9502

Hua Chen (SBN 241831)  
huachen@scienbizippc.com  
Calvin Chai (SBN 253389)  
calvinchai@scienbizippc.com  
Ying Lu (SBN 323384)  
winglu@scienbizippc.com  
**ScienBiziP, P.C.**  
550 South Hope Street, Ste. 2825  
Los Angeles, CA 90071  
Tel: 213.426.1771  
Fax: 213.426.1788

13 ***Attorneys for Plaintiff***  
14 ***Masimo Corporation***

***Attorneys for Defendant Hon Hai***  
***Precision Industry Co., Ltd.***

15 /s/ Daisy Manning  
16  
17  
18  
19  
20  
21  
22  
23  
24  
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26  
27  
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