IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF CALIFORNIA
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MASIMO CORPORATION, a California Corporation,
Plaintiff,
v.
SOTERA WIRELESS, INC., a California corporation and HON HAI PRECISION INDUSTRY CO., LTD., a Taiwan corporation,
Defendants.
----------x
Case No. 3:19-cv-01100-BAS-NLS
----------x
September 10, 2020
12:30 p.m.

Remote video deposition of GEORGE EMANUEL YANULIS, PH.D., taken by Plaintiff, before Brandon Rainoff, a Federal Certified Realtime Reporter and Notary Public of the State of New York.

DIGITAL EVIDENCE GROUP
1730 M Street, NW, Suite 812
Washington, D.C. 20036
(202) 232-0646

APPEARANCES:

KNOBBE, MARTENS, OLSON & BEAR, LLP
Attorneys for Plaintiff Masimo Corporation
2040 Main Street
14th Floor
Irvine, California 92614
949.760.0404
BY: BRIAN C. CLAASSEN, ESQ.
brian.claassen@knobbe.com

HUSCH BLACKWELL LLP
Attorneys for Defendant Sotera Wireless, Inc. and the Witness
190 Carondelet Plaza
Suite 600
St. Louis, Missouri 63105
314.480.1500
BY: JENNIFER E. HOEKEL, ESQ.
314.345.6123
jennifer.hoekel@huschblackwell.com
- and -
1801 Wewatta Street
Suite 1000
Denver, Colorado 80202
303.749.7200
BY: DUSTIN TAYLOR, ESQ.
202.749.7247
dustin.taylor@huschblackwell.com

APPEARANCES (continued):

SCIENBIZIP, P.C.
Attorneys for Defendant Hon Hai Precision Industry Co., Ltd.
550 South Hope Street
Suite 2825
Los Angeles, California 90071
213.426.1771
BY: HUA CHEN, ESQ.
213.426.1778
huachen@scienbizippc.com
Ying Lu, Esq.
yinglu@scienbizippc.com

ALSO PRESENT:
HENRY MARTE, Videographer

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George Emanuel Yanulis, Ph.D.

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* * *

PROCEEDING

Thursday, September 10, 2020

Remote Deposition

12:30 p.m. Eastern Standard Time

* * *

THE VIDEOGRAPHER: We are now on the record. My name is Henry Marte. I'm a videographer on behalf of Digital Evidence Group.

Today's date is September 10, 2020, and the time is 12:30 p.m., Eastern Time.

This videotaped deposition is being held via remote Zoom in the matter of Masimo Corporation versus Sotero Wireless, Inc., et al.

The deponent today is Dr. George Yanulis.

All parties to this deposition are appearing remotely.

Also, can all counsel introduce themselves for the record? -- which after the court reporter is going to administer the oath.

MR. CLAASSEN: This is Brian Claassen for plaintiff Masimo.

MS. HOEKEL: Jennifer Hoekel for defendant Sotero and the witness.

THE WITNESS: Dr. George Yanulis for the defendant.

MR. CHEN: Hua Chen, counsel for co-defendant Hon Hai Precision Industry Co., Ltd.

THE COURT REPORTER: Counsel, before swearing in the witness, I have a short statement to put on the record.

The attorneys participating in this deposition acknowledge that, due to the severity of COVID-19 and following the practice of social distancing, I am not physically present in the deposition room, and that I will be swearing in the witness and reporting this deposition remotely.

Do all parties stipulate to the validity of this remote swearing and remote reporting via video conference, and that it will

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be admissible in the courtroom as if it had been taken pursuant to the applicable rules of civil procedure?

MR. CLAASSEN: So stipulated.

MS. HOEKEL: Yes.

MR. CHEN: Yes, so stipulated.

GEORGE EMANUEL YANULIS, Ph.D.,

having been duly sworn, was examined and testified as follows:

EXAMINATION

BY MR. CLAASSEN:

Q. Good afternoon, Dr. Yanulis.

Did I pronounce your name the right way?

A. You did, sir, thank you.

Q. How are you today?

A. I'm fine. How are you, sir?

Q. Doing well, thank you.

Have you ever been deposed before?

A. Yes.

Q. Approximately how many times?

A. Six times, sir.

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Q. How many of those six depositions were in patent cases?

A. None.

Q. Have you ever been deposed via Zoom before?

A. No, sir.

Q. Have you been using Zoom during the COVID crisis?

A. Quite a lot.

Q. So you are familiar with how Zoom works?

A. Yes, sir.

Q. And if you have questions about how Zoom works during the deposition, you'll let us know?

A. Yes, sir. Thank you.

Q. I'm going to assume that you can hear me. I know sometimes Zoom has difficulty with that.

If at any point during the deposition, you cannot hear me, will you let me know?

A. Yes, sir, thank you.

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Q. And can you see me right now?

A. Yes, I can.

Q. Are you having any difficulty hearing me right now?

A. No, sir, I do not.

Q. Is there any reason why you can't give truthful testimony today?

A. No, there is not.

Q. Are you on any medication?

A. No, I am not.

Q. Are you in good health?

A. Yes, I am.

Q. How did you prepare for this deposition?

A. I reviewed all patents, all IPRs that are written. I did read Exhibit 1 and 2, the claim construction, the file histories.

To the best of my knowledge, that's everything. If I forgot something --

Q. I want to break that down a little.

You said you reviewed all patents. Are those the nine patents started --

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A. I'm sorry. I reviewed all nine patents, sir.

And I reviewed the claim construction, focusing on the terms being discussed in Exhibit 1.

I also reviewed my IPR declarations.

I reviewed all file histories.

And I think that covers everything.

Q. You have been referring to something called Exhibit 1.

Is that the document that I gave you printed called Exhibit 1?

A. Yes, sir. That's the joint hearing statement, dated November 3rd, 2020.

Q. So you have seen that document before.

Is that right?

A. Yes.

Q. I want to come back to that Exhibit 1 in just a few minutes. I still want to go through a few background questions with you.

Did you speak to anyone about the deposition?

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A. Only --
MS. HOEKEL: And I just want to remind the witness not to reveal the contents of any privilege.
And also to wait until Mr. Claassen has finished his question before you start your answer.
BY MR. CLAASSEN:
Q. Do you understand the question, Dr. Yanulis?
A. Yes.
Q. Did you speak to anyone about this deposition?
A. Yes.
Q. Who did you speak with?
A. Jennifer Hoekel and Dustin Taylor.
Q. Did you speak with anyone from Hon Hai?
A. No, I did not.
Q. Did you speak with anyone other than counsel about this deposition?
A. No, I did not.

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(Pause)
Q. So you mentioned earlier reviewing IPR declarations.
Is that correct?
A. Yes, sir.
Q. Those declarations are your declarations submitted in the IPRs related to the nine patents in this litigation.
Is that correct?
A. Yes, sir.
Q. Those declarations set forth your opinions regarding claim construction, right?
A. Yes, they do.
Q. Are the declarations complete?
A. Yes, they are.
Q. Are you aware of any changes that need to be made to them?
A. No. I am not.
(Pause)
Q. So from time to time, you may see me looking sideways. That's because the feed for real time -- which is the transcript -- is to my

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left. So if I'm looking away, I'm looking toward the transcript. I'm not trying to ignore you.
Do you understand?
A. No problem. Thank you for explaining.
Q. And I have the stack of documents that we sent you as physical exhibits here, so that if we have any questions I can refer to those hard copies as well.
Do you understand that?
A. Thank you.
Q. Who engaged you in this case?
A. Husch Blackwell law firm.
Q. What is your rate for the case?
(Pause)
Q. If you don't recall off the top of your head, I'm not asking for a memory test. We can go back.
A. I believe it's $550; $655 for depo/trial.
(Pause)
Q. Approximately how many hours have you

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spent on this matter?
A. Well over 100, sir. It's probably close to 200. I don't have the exact calculation.
Q. In that 200 hours, you are including both the IPRs and the district court case.
Is that right?
A. Yes, sir.
Q. What's your understanding of the difference between the IPR and the district court?
A. The IPR declarations that I wrote were for the Patent Office to review patent invalidity.
The construction claims, which are handled by district court, are -- deal with what we are discussing today; discussing the terms of dispute, the claims terms that has been construed by both parties.
Q. You understand that today we are going to be focusing on the now top eight terms for construction, right?

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A. Yes, I do.
Q. And my understanding is that there are additional disputes about construction beyond those eight terms.
Is that your understanding?
A. Yes, it is.
Q. I want to talk a little bit now about your understanding of the claim construction process.
Is that okay with you?
A. Yes, it is.
Q. You are not a lawyer, right?
A. Correct.
Q. Sotero's attorneys explained how to perform claim construction -- or at least the analysis for claim construction -- to you, right?
A. Yes, they did.
Q. What is your understanding of the process for claim construction?
A. I look at the claims being -- the eight claims being discussed -- being disputed

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in view of the specifications for the nine patents, as well as the file histories for all nine patents; and my expertise as a POSA on these particular matters and claims of interest.
(Pause)
Q. You said POSA?
Is that right?
A. Yes, sir, for one skilled in the art.
Q. So by that, did you mean a person of ordinary skill in the art?
A. Yes, sir.
(Pause)
Q. Did you develop any opinion about the level of ordinary skill in the art?
A. Yes, I did.
Q. Did that level of skill change based upon which patent you were considering?
A. No, it did not.
Q. Why is that?
A. All patents should be given their plain and ordinary meaning. And I relied on that premise to review all the materials that I

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just discussed in terms of the claim construction, or the way the claims have been constructed by the district court.
Q. Okay. I think maybe you didn't understand my question fully.
I was asking about the level of ordinary skill in the art.
Do you understand that?
A. Yes.
Q. My question was: Why does the same level of ordinary skill in the art apply to all nine patents?
A. I'm not sure I understand the question, other than what I answered.
Would you rephrase it or repeat it, sir?
Q. I'm going to ask that you allow your attorney to make the types of objections you are speaking about -- so the rephrasing, or asked and answered.
You can go ahead and answer the question unless you get some sort of instruction

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from your attorney not to answer, or for me to rephrase the question.
Do you understand that?
A. Yes, sir.
MS. HOEKEL: I think he was just telling you he didn't understand the question. I don't think the question was objectionable. I don't think he understood it.
MR. CLAASSEN: Okay. So let's start over with the premise again.
BY MR. CLAASSEN:
Q. You provided an opinion about the level of ordinary skill in the art.
Is that right?
A. Yes, I did.
Q. And you did that for all nine patents.
Is that right?
A. Yes, I did.
Q. And in your opinion, the level of ordinary skill in the art is the same for all nine patents, right?
A. To some degree. Some are more complex

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in terms of technology.
Q. But you did not -- the change in complexity and technology -- does that change the level of ordinary skill in the art?
A. No, it does not.
Q. Which patents had more complexity?
A. In my opinion, some of the alarm-related patents. But that's only my opinion.
Q. What made them more complex?
A. Some of them were longer. The '994 was a little bit longer.
I'm not sure how else to answer that question.
Q. So the specification was longer.
That's what made it more complex?
A. Yes, sir. It was one of the longer patents.
Q. Was there anything about the subject matter itself that made it more complex?
A. No, it was not.
(Pause)

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Q. Did you help counsel determine which terms to construe?
A. No, I did not.
(Pause)
Q. Were you given a list of disputed terms before you prepared your IPR declarations?
A. No, I was not.
Q. How did you know the parties' positions on claim construction if you were not given the disputed terms?
A. I was given Exhibit 1 and 2 by co-counsel prior to the deposition.
Q. Okay. So I understand that, prior to the deposition, you were given Exhibit 1.
Is that correct?
A. And 2, sir.
Q. So you were given Exhibit 1 and 2 before the deposition.
Is that correct?
A. Could you repeat the question, sir?
Q. You were given Exhibits 1 and 2 before the deposition?

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A. Yes, sir.
MS. HOEKEL: Can I ask: For the record, what Exhibit 2 is, please?
THE WITNESS: It's the other remaining terms being disputed.
MR. CLAASSEN: Let's talk about that for just a minute.
BY MR. CLAASSEN:
Q. So you are referring now to the way the joint hearing statement marks exhibits.
Is that correct?
A. Yes.
Q. Okay.
I'd like to do something slightly different with you today if that's possible to avoid confusion with the rest of the group here.
I sent you a printed folder called Exhibit 1.
Do you have that?
A. Yes, I do.
MR. CLAASSEN: Can I ask the court reporter to please bring up Exhibit 1?

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(Pause)
MR. CLAASSEN: So the court reporter has just put on the screen a document that I've sent to you that's been labeled as Exhibit 1.
BY MR. CLAASSEN:
Q. Do you see the cover of this document?
A. Yes, I do.
Q. I'm going to represent to you that this Exhibit 1 that I've sent to you contains the joint hearing statement and then the claim chart for the top nine disputed terms.
Do you want to flip through that and verify that's what you have?
A. Yes, I do.
Q. So what you were talking about with respect to Exhibit 2 earlier is an additional exhibit that I didn't send you with this printed Exhibit 1.
Is that correct?
A. You are absolutely correct.
Q. Okay. So I sent you -- what I'm going to call Exhibit 1 today is this document, the

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joint hearing statement with its Exhibit 1.
Do you understand that?
MR. CLAASSEN: I'm going to ask the court reporter to mark now this document Exhibit 1 for the record.
(Exhibit 1, Multipage document entitled: Joint Hearing Statement, dated August 10, 2020 (no Bates Nos.), marked for identification)
BY MR. CLAASSEN:
Q. So, Dr. Yanulis, when we talk about Exhibit 1 today, we are going to be talking about this document that I have now marked as Exhibit 1.
Do you understand that?
A. Yes, I do.
Q. So I asked you earlier if you had been given a list of disputed terms before you prepared your IPR declarations.
Do you understand that?
A. Yes, I do.
Q. Had you been given that list before

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you prepared your IPR declarations?
A. No, I had not been.
Q. So how did you know which terms were in dispute for purposes of preparing your IPR declarations?
A. I did not use them to prepare my IPR declarations.
Q. In your IPR declarations, you say that certain terms are disputed.
Is that correct?
A. Yes, I did.
Q. How did you identify those terms?
A. I'm not sure I understand the question.
Could you repeat it?
Q. Yes.
MR. CLAASSEN: I'll ask the court reporter now to take down Exhibit 1 for now.
BY MR. CLAASSEN:
Q. So we talked about your IPR declarations.
You understand that, right?

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A. Correct.
Q. You understand that those declarations were prepared before what I showed you is Exhibit 1.
Is that right?
A. Correct.
Q. In those declarations, you set forth some disputes on claim construction.
Is that correct?
A. Yes, I did.
Q. So my question is: How did you know which terms were disputed for purposes of preparing your IPR declaration?
A. The terms that were noted in the IPRs, terms that were based on file histories, the specifications, the patents, the parent patents. So I did have -- I did have an idea of the terms being disputed.
I just didn't realize which nine would be disputed -- or eight.
I apologize for the confusion.
Q. You didn't understand which top terms

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would be disputed.
Is that correct?
A. Correct.
Q. But counsel gave you some sort of list of disputed terms.
Is that correct?
A. They did, and there was also -- yes, they did.
Q. So I want to come back to that. We'll talk about that when we get to your declaration.
But I want to finish up talking about the general process for claim construction purposes.
So do you understand that we are going to shift topics back to the general process for claim construction?
A. Yes, I do.
Q. Where do you start the claim construction process?
A. The first step is to review the patents -- parent patents -- that were also disclosed related to those patents, nine

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patents. The file histories, the -- those are the main essential tools I used.

Q. When you did your claim construction, did you start by reading the claims?

Or did you read the specification first?

A. I read both, sir.

Q. In which order?

A. I read the specs in their entirety.

Then I read the claims.

And I read both in their entirety again.

Q. When you were trying to interpret the meaning of words in the claim, what was your process for doing that?

A. The specifications; and I was also utilizing my skill as one skilled in the art for those specifications.

Q. And at what point did --

(Pause)

THE VIDEOGRAPHER: The time is 12:55 p.m. Off the record.

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(Recess from 12:55 p.m. to 1:03 p.m.)

THE VIDEOGRAPHER: The time is 1:03 p.m. Back on the record.

BY MR. CLAASSEN:

Q. Hello, Dr. Yanulis. Can you hear me now?

A. Yes, I can.

Q. I apologize for our connectivity issue, but I want to pick up where we left off.

We were talking about the general process for claim construction?

A. Yes, we were.

Q. And we were talking about the fact that you looked at the specification and then the claims.

And I was asking you: At what point did you consider the list of claim terms that counsel provided for you?

Do you understand that question?

A. Yes, I do.

Q. So at what point did you consider the list of questions that counsel -- or list of terms that counsel provided for you?

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A. After they informed me.

Q. When you say "they informed you," are you talking about counsel?

A. Yes. Prior --

Q. I want to make sure I understand the process fully.

You read the patents. You read the claims. You went back and read the specification and claims again --

A. And file histories.

Q. And the file histories.

And then counsel provided you with a list of disputed terms?

Is that correct?

A. Yes.

Q. What did you do next?

A. The next process was to develop my IPR declarations for the Patent Office.

Q. Did you look at prior art before you developed your claim construction positions?

A. Yes, I did.

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Q. So your process was to look at the prior art first, and then go back and look at the claim constructions?

A. I switched back and forth, to be honest with you. It was a multiple -- multi-task process.

Q. Did you break it up by patent or patent family?

A. Patent family.

Q. What is your understanding of the patent families involved in this case?

A. I can't remember all the parent patents.

But anything that I knew was a parent patent, I looked at that.

And I also reviewed the patent histories, and, of course, the specifications for those parent patents.

And they were listed in my IPRs as well.

Q. Do you have an understanding of how the patents are broken up by subject matter?

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A. Yes, I do.
Q. What is that understanding?
(Pause)
Q. Are you looking at a document or the computer screen?
A. No, I'm relying on my own knowledge, sir.
Q. I'm sorry. Can you repeat?
A. I'm -- what I was getting at -- I'm relying on my own knowledge as well.
And I did work for the U.S. Patent Office, so I am familiar with the art -- arts that they developed for the different medical device, and they also list the arts on the patents itself.
(Pause)
THE VIDEOGRAPHER: The time is 1:07 p.m. Off the record.
(Recess from 1:07 p.m. to 1:09 p.m.)
THE VIDEOGRAPHER: We are back on the record. The time is 1:09 p.m.
BY MR. CLAASSEN:

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Q. Dr. Yanulis, we were talking about the patent families.
Do you remember that?
A. Yes, sir.
Q. You understand that there are different subject matters for each of these families, right?
A. Yes, I do.
Q. What is your understanding of the different subject matters for these families?
MS. HOEKEL: Objection, form.
BY MR. CLAASSEN:
Q. Do you understand the question, Dr. Yanulis?
A. Yes, I do.
Q. You can go ahead and answer.
A. As I articulated, I looked at the classes that were reviewed in each art and just insured I understood from the U.S. Patent's office determination of those particular classifications.
Q. Does that have something to do with

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the particular families that are at issue in this case?
A. There was a lot of similarities, a lot of classifications and arts used. I can't remember all the different classifications.
Q. So when you are referring to "families," are you referring to the specific patents that are at issue in this case?
A. If I'm understanding your question, yes.
Q. What are the families at issue in this case?
A. I'd have to look at the patent.
If you don't mind, can I look at one patent?
Q. Sure.
Is there a particular patent that would be helpful for you?
A. Any one.
MR. CLAASSEN: I'll ask the court reporter to pull up Exhibit 2.
And Dr. Yanulis, if you look at

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Exhibit 2 in your printed materials --
(Pause)
THE WITNESS: Okay.
BY MR. CLAASSEN:
Q. This is the '735 patent.
Have you seen it before?
A. Yes, I have.
Q. So would this help you understand the patent families that are at issue in this case?
A. Yes, it would.
Q. What is your understanding of the patent families that are at issue in this case?
A. They have the international classification; and the classes which they were -- the patent application was categorized. Then they also had the U.S. classification scheme. They have the field of classification search -- what I also reviewed -- on the patent of the second page -- excuse me -- the cover page.
And I looked at references cited as well, and any other publications, as well as

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foreign patent documents as well.
MR. CLAASSEN: I'll ask the court reporter then to mark this Exhibit 2 for the record.
(Exhibit 2, Document Bates stamped MAS0000020 thorough 60, multipage document entitled: United States Patent No.: 9,788,735 B2, dated October 17, 2017, with cover page dated June 18, 2019, marked for identification)
BY MR. CLAASSEN:
Q. So, Dr. Yanulis, if I'm understanding you right, when you are talking about patent families, you are talking about the classification details that are listed on the cover page of the '735 patent that's shown on the screen now with the Bates label MAS0000021.
Is that correct?
A. Correct.
Q. That would be the U.S. classification in the field of classification shown in the bottom-left of this page.
Is that right?

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A. I believe it says 52 U.S. classifications.
Q. So when you talk about families in this case, you are not talking about anything about how the different specifications are related to one another, are you?
A. The specifications for some patents may be related, but that's not always the case -- as far as my understanding.
Q. I'm just trying to understand.
When you say "family," are you referring, then, to classifications?
A. To be honest with you, I know the U.S. Patent Office has changed the terminology. So to the best of my knowledge, I'm referring to it as U.S. classifications of various arts -- excuse me -- various classifications.
Q. But you are not talking about how the patents at issue in this case are related to one another.
Is that correct?
A. No. No. Unless it's a parent patent.

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(Pause)
Q. What do you mean by "a parent patent"?
A. Some of these patents had parent patents, which I disclosed in my IPRs.
Q. If two patents had the same parent, would they be family members?
A. I don't know the absolute correct answer. It would be a guess.
My answer as a guess would be: Yes.
Q. Do you recall whether any of the asserted patents are family members sharing the same parent application?
A. There may be, but I'd have to look at all the patents.
Q. And you don't know off the top of your head as you are sitting here?
A. A lot of them have to do with ambulatory monitoring systems. I'm aware of that.
And a lot of them have to do with pulse oximetry monitoring, etc. To that extent, I'm familiar.

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Q. I want to return now to your claim construction process. And we were talking about you looking at the claims.
Do you remember that?
A. Yes.
Q. And we were talking about you were provided a list of claim terms that were disputed from counsel.
Do you remember that?
A. Yes, I do.
Q. What was the next step in your process after you received that list of terms?
A. The first process that I utilized is looking at the file history for that particular patent.
The next step was to utilize my skill in the art to evaluate this in view of the specs on the claims.
Q. Did you look at the disputed terms in the context of the claims they are used in?
A. Yes, I did.
Q. When did you do that?

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A. In my development of my IPRs -- declarations.
Q. When in the development of your IPR declarations did you do that?
A. It was an ongoing process, counselor, while I was writing them and after, making sure had I completed everything accurately.
Q. Did you do any word searches for use of the terms in the specification?
A. I always do a patent search based on words.
Q. What do you mean by "a patent search"?
A. What I do is I have a couple of techniques.
What I usually do is I'll look at, for example, with these patents -- trying to formulate the best answer, so give me a second.
I'm looking at the terms as used in the patents, as discussed.
And I'm also looking at any prior art, if there is any kind of, you know, discrepancy in terms of the way they define the terms as

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well, and any prior art that they have supplied.
Q. I'd like now to turn in Exhibit 2 to the claims. Those are in column 13 -- or beginning in column 13, MAS0000056.
Do you see that, Dr. Yanulis?
A. Yes, I do.
Q. Do you see there is a claim 1 there?
A. Yes, I do.
Q. Do you see that one of the claim terms there is "a display"?
A. Yes, I do.
Q. If you were going about the process for determining the construction of "display," what would you do?
A. I'd look at the entire claim or claims in view of the specs, as well as the figures.
Q. So you would read this claim 1.
Is that correct?
A. Yes.
Q. Then you would go back and look at the specification, right?
A. Yes, sir --

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Q. And that includes --
A. -- as well as --
Q. -- and you are saying the figures also --
I'm going to refer to the figures as part of the specification today.
Do you understand that?
A. Yes, now I do. Thank you.
Q. If there is a conflict between the words of the claim and the specification, what do you do?
A. I have to go by what's disclosed in the specs.
Q. So if there is a conflict between the claims and the specification, is it your understanding that the specification controls?
A. Yes.
Q. What is your understanding for when the specification limits the meaning of a claim term?
MS. HOEKEL: I'm going to object.
A. I don't have an answer for that, sir.

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I'd have to think about it.
Q. Have you thought about it in this case?
A. Yes, I did.
Q. When did you do that?
A. When I looked at each claim and it wasn't what's claimed disclosed in the specs.
And I also looked at my skill in the art -- evaluated with my skill in the art as well.
Q. Did you consider any extrinsic evidence?
A. I didn't hear you, counselor.
Q. Did you consider any extrinsic evidence?
A. Yes, I did.
Q. Do you know what extrinsic evidence is?
A. Extrinsic evidence is anything that's not in the patent. Extrinsic evidence is all based on the patents in the entirety --
MS. HOEKEL: I don't think we can hear

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you, Dr. Yanulis. You are too close to the microphone.

(Pause)

A. The best tool that I would have is to -- trying to remember the question. Bear with me.

Could you repeat the question again, just so --

Q. Sure.

What is your understanding of extrinsic evidence?

A. Extrinsic, as an example, could be a dictionary definition. It could be an article. It could be an article that I found or it could be an article that was found by the plaintiff; or anything else that I, based on my skill, found.

Q. Did you rely on any extrinsic evidence in your analysis of the claims for this case?

A. Yes, I did.

Q. Is that extrinsic evidence listed in the joint hearing statement that we were talking about earlier?

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A. Can you give me a moment?

The best answer is basically -- if you give me a moment, sir?

Q. Sure.

MR. CLAASSEN: Can you go ahead and take down Exhibit 2, court reporter?

A. Basically I looked at the intrinsic evidence for the claim construction.

Q. Okay. I'm asking now about the extrinsic evidence.

And you said earlier, I believe, that you considered some.

Is that right?

A. I considered them in the IPRs, sir.

Q. Is the extrinsic evidence that you considered cited in your IPR declarations?

A. It is.

Q. Is the extrinsic evidence that you considered also cited in the joint hearing statement -- that's the Exhibit 1 -- that we were talking about earlier?

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(Pause)

A. If it was relevant, I would include it.

And I can't remember. I'd have to look at all -- it's kind of cut off in some of the exhibits you have given me, sir.

But to the best of my recollection, if it was relevant, yes, but I would identify it as extrinsic evidence, as opposed to intrinsic.

But my primary focus was the intrinsic, which is the patents.

Q. What I would like to know now: Is there any extrinsic evidence that you relied upon in forming your opinions that is not set forth in the joint hearing statement?

A. To the best of my knowledge, no.

(Pause)

Q. Is it your understanding that indefiniteness is a claim construction issue?

A. Yes, it is.

But I'm not an attorney, so I can't say much more than that.

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Q. So what is your understanding of the legal test for indefiniteness?

(Pause)

A. Has the term been properly explained in the specifications to be understood adequately by one skilled in the art?

Q. You understand that there are separate tests for something called written description, right?

A. Correct.

Q. And there is something else called enablement, right?

A. Yes.

Q. You understand that indefiniteness, written description, and enablement are all separate, right?

A. Yes, I do.

Q. So what is your understanding for what makes a claim term indefinite?

MS. HOEKEL: I'm going to object to the extent it calls for a legal conclusion.

But you can answer to the best of your

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ability, Dr. Yanulis.
A. To the best of my ability, when there is a 112 issue, it's in reference to the claims or a claim term.
(Pause)
Q. Do I understand correctly that your opinion is certain claim terms are indefinite in this case?
A. Yes, sir.
Q. How did you make that determination?
A. Again, I would first look at the specs; and then go -- excuse me.
I'd look at the specs; then go to the claims; then go back again and make sure there was no discrepancy or any indefiniteness based on my understanding.
Again, I'm not an attorney, but I'm using my own previous skills.
Q. What would lead a claim term to be indefinite in your understanding?
MS. HOEKEL: Same objection.
A. If it's not properly explained, again,

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for one skilled in the art, then it's an issue of indefiniteness, 112.
Q. I know you keep saying "112."
Are you now saying something more than indefiniteness?
A. I'm going to have to defer. That's my best answer, because I'm not an attorney.
Q. So when you say that a claim term is indefinite, what do you mean?
A. Do you want me to give you an example?
Q. Yes.
A. If you say "processor" without describing what the processor can do adequately in the claim, you just list "processor."
Q. So a claim that just says "processor" and nothing more would be indefinite.
Is that correct?
A. If there was no proper antecedental basis or any follow-up statements to make me understand: Is it a processor, or what kind of processor it is, or what it's capable of doing.
Q. And when you are performing that

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analysis, are you looking at the claim itself?
A. I'm looking at the claim, specs, and my expertise as a one skilled in the art.
Q. When you were provided your list of claim term disputes by counsel, did it identify terms that were indefinite?
(Pause)
A. Some of that was in the file histories, as far as the office actions.
I would look at, you know, the way the examiner would regard some of them as being indefinite and not giving a proper disclosure of what's being said in the claims.
Q. You understand that these were issued patents that you were analyzing, right?
A. I understand that.
But I was also looking at the file histories as the patent process approval was continuing. So it was not looked in isolation.
Q. So what I'm trying to determine now is who came up with the claim construction position the terms were indefinite.

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Was it you?
Or was it counsel?
A. Both.
Q. What terms did you determine were indefinite?
MS. HOEKEL: Object to the form.
A. One example is the processor that I already gave.
Another example would be the delay -- the alarm delays.
Q. Are there any other examples?
A. Counselor, there is probably several. Another one could be the term "a separate computing device."
Q. That's indefinite in your opinion?
A. The way it may have been claimed.
(Pause)
Q. Do you set forth an opinion that "separate computing device" is indefinite anywhere?
A. I do in my -- I'm not sure I understand the question.

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All I did was I evaluated the claims being disputed.

So other than that, I haven't formally written any kind of opinions.

But I did discuss in the IPRs my opinions as to a term that may have been indefinite in my opinion.

Q. So in your opinion, "separate computing device" is indefinite?

MS. HOEKEL: Object to the form.

A. If it's missing certain antecedental basis to understand what the processor is capable of doing, or performing said function.

Q. I'd like to come back to that in a little bit. We'll discuss it in more detail.

Do you understand that?

A. Yes, sir.

Q. Are there differences between the claim construction standard for IPRs and for the district court?

A. No, there is not.

Q. What is the claim construction

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standard?

A. Plain and ordinary meaning, as given by the expert -- in this case, myself.

Q. So plain and ordinary meaning, as given by the expert? --

A. No.

Q. -- that's your understanding?

A. I apply the standard of plain and ordinary meaning. And I base that evaluation of the disputed term based on what the term is, and what my expertise is, and the specifications, and the claims.

Q. So was it your job to help determine the plain and ordinary meaning for the claim terms?

A. As an expert, yes.

Q. Do all the claim terms in this case have plain and ordinary meanings?

MS. HOEKEL: Object to the form.

A. I'm going to say I'm not sure how to answer that question.

But what I will say: I applied the

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plain and ordinary standard.

Other than that -- and my expertise.

That's basically the best answer I can give.

Q. You applied the plain and ordinary meaning and your expertise.

Is that correct?

A. In view of the specification and claims, yes, sir.

Q. That was your process for construing the claims in this case.

Is that right?

A. Yes.

Well, I didn't come up with these terms. The district court did. I didn't know what terms were being disputed until I saw this exhibit. I had an idea what the claims were, but I didn't know the terms.

Q. So is it your understanding that the court came up with these terms?

MS. HOEKEL: Object to the form.

A. It's my understanding, counselor, that

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both sides developed their position on what the terms of dispute.

And it was my job -- and again, I've not written any full report of the claims being disputed in the construction as set forth by the district court.

Q. Is it your understanding that all the words of the claim need to appear in the specification?

A. Could you repeat the question, sir?

Q. Yes.

Is it your understanding that all the words in the claim need to appear in the specification?

A. It's my understanding, yes, that they have to be properly disclosed. Everything has to be disclosed related to what their function and structure is.

Q. My question is a little different.

I'm asking: Does each word in the claim need to appear in the specification?

A. The answer is: Yes.

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Q. If the word does not appear in the specification, how do you interpret the claim?
A. I use my expertise as one skilled in the art.
Q. So you recognize that there may be terms that are known to a person of ordinary skill in the art.
Is that right?
A. Yes, sir.
Q. And those words would not need to appear in the specification.
Is that correct?
A. Based on that, yes.
Q. Does that apply to everything claimed?
MS. HOEKEL: Object to the form.
A. I'm not an attorney, so I can't really give a real legal opinion of that question.
Q. Did Sotero's attorneys explain "means-plus-function claiming" to you?
A. Yes, they did.
Q. What is your understanding of when a claim recites a means-plus-function term?

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A. In the claims as stated, there is usually a means, which to me implies structure.
And then there is the function or method that that particular structural element can perform -- or potentially perform -- as claimed.
Q. So I want to make sure that I understand your answer correctly.
I believe you said that: Means implies structure.
Is that what you meant?
MS. HOEKEL: Object to the form.
A. Again, I may be -- again, not an attorney, so I can't give the most accurate answer.
Q. Are you familiar with a presumption?
A. Yes.
Q. And you understand that there is a presumption when the words "means for" appear in the claims?
A. Yes.
Q. How do you determine when a claim

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recites a means-plus-function term when there are no means for recited in the claim?
MS. HOEKEL: Object to the form.
A. Could you repeat the question?
I need to think about that.
Q. Yes.
We talked about the presumption with means for.
Is that right?
A. Yes.
Q. And sometimes claims can be interpreted as means-plus-function without the words "means for."
Is that right?
A. Yes, sir.
Q. When do claims result in a means-plus-function construction when they don't use the words "means for"?
MS. HOEKEL: Object to the form.
A. I'm not sure how to answer the question other than the way that I've answered it, counselor.

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Q. How did you determine in this case when a means for construction was appropriate?
A. As an example, for the processor, you can't just have a process of isolation. You have to understand how the function is performed -- for example, by an algorithm.
Q. So if a claim recites a function, is that when means-plus-function applies?
MS. HOEKEL: Object to the form.
A. You are asking me the same question over and over again, counselor.
I'm not really sure if I may be misinterpreting.
But as, again, means-plus-function in the claims as recited is evaluated based on my skill in the art and the specifications as disclosed.
Q. So a person of ordinary skill in the art would understand when a claim recites a means-plus-function term.
Is that right?
A. They should have a good understanding

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of it.
Q. And what would that understanding be based on?
A. Now, do you want me to define what I consider someone skilled in the art?
Q. Sure.
A. Sure. That might help -- rather than repeating the same thing.
For one skilled in the art for this particular set of patents and disputed claims, you should have at least a Bachelor's degree in either electrical and biomedical; as well as work experience in that particular type of device or said system; or have additional work experience in those areas would also be helpful.
And have experience working with, for example, pulse oximetry devices or other types of ambulatory devices, monitoring, for example, a heart rate, pulse rate.
Q. And that person --
A. -- or --
Q. -- go ahead.

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A. I'm sorry. I didn't mean to interrupt.
Q. Did you finish your answer?
A. I was also going to say, of course, pulse oximetry.
Q. That person of ordinary skill in the art would understand when a claim recites a means-plus-function term.
Is that right?
MS. HOEKEL: Object to the form.
A. I would say yes, from a -- yes.
Q. Wouldn't that person need some sort of instruction from an attorney?
A. If I had a question, I would refer to counsel if I didn't understand something. Again, I'm not an attorney.
Q. So when you were performing your claim construction analysis, how did you determine when a claim in this case recited a means-plus-function term?
A. I was evaluating the specifications focusing on that in view of the claims, as well

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as my expertise as having a skill in that art for that particular system.
Q. But you only identified a couple means-plus-function constructions.
Is that right?
A. For the sake of time, yes.
Q. If you had more time, would you have identified more?
A. I could add some more examples.
The issue of suspension buttons and the function of suspension buttons.
Another couple examples would be the wireless technology involved in measuring, for example, pulse oximetry.
Another issue would be: How would the parameters measured be transmitted? -- or whatever.
I mean, I could go through an entire list.
Does that help?
Q. And those would all be means-plus-function terms.

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Is that right?
A. They should.
For example, a transmitter should have means-plus-function. They should have the structure and how that function is performed, for example, by a pause button or suspension button.
Q. So how do you determine when a claim recites structure?
A. I know you don't want me to use the word "figure."
But I look at the figure, in combination with what's disclosed in the specifications, and the detailed description of the invention, and looking at all the elements.
Q. So is it your understanding that a claim reciting something that's not shown in the figures would not have structure?
MS. HOEKEL: Object to the form.
A. If it's not been properly disclosed, yes.
Q. What do you mean by "properly

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disclosed"?
A. There had been proper support for, you know, for that structure -- in other words, a detailed discussion of how the subsystem was assembled in the entire system, and how that system -- or excuse me -- how that subsystem performed that function.
It should be adequately disclosed, again, for one skilled in the art, which I am.
Q. So how do you distinguish between when a claim recites structure versus function?
MS. HOEKEL: Object to the form.
A. Structure to me means the physical description of the system, whereas function means what function or process is being -- or method is being performed by said structure.
Q. Is that the process you followed in this case?
A. Yes, it is.
Q. Did you follow any other process?
A. No.
MS. HOEKEL: Object.

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BY MR. CLAASSEN:
Q. Would a person of ordinary skill in the art understand what a computer is without looking at a patent specification?
MS. HOEKEL: Objection.
A. It depends on that person's level of education. There is a lot of people that use computers and have trouble turning them on and off.
Q. Okay. My question is a little different.
I'm not asking if a person of ordinary skill in the art would know how to use a computer.
My question is: Would a person of ordinary skill in the art understand what a computer is without looking at a patent specification?
MS. HOEKEL: Object to the form.
A. Same answer: Depends on his level of education and how much instruction he's given how to use said computer.

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Q. So you are telling me someone with an engineering degree and two years of work experience might not know what a computer is?
A. Sir, you didn't say that.
You asked an ordinary person, differentiating from one that's not skilled in the art, if I understand you correctly.
Q. Okay. You misunderstood my question.
I'm asking about a person of ordinary skill in the art.
Do you understand that?
A. Yes.
Q. Would a person of ordinary skill in the art understand what a computer is?
A. Yes.
Q. Without looking at a patent specification?
A. Yes, sir.
Q. Would a person of ordinary skill in the art understand what a monitoring device is without looking at a patent specification?
A. Yes, they would.

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Q. What is a monitoring device?
MS. HOEKEL: Object to the form.
A. A monitoring device allows the physiological parameters being measured to display --
Q. -- does a computer --
A. -- after they have been processed.
Q. I'm sorry. I interrupted you.
A. It's my understanding as an expert in this field, a display of physiological parameters as it relates to these nine patents gives you a physical -- excuse me -- a visible display of the measurements obtained after being processed.
Q. What is a computer?
MS. HOEKEL: Object to the form.
A. A computer is a device that does nothing unless you program an algorithm to do something. A computer will do nothing unless you tell it to do something.
Q. Is it any more than that?
MS. HOEKEL: Object to the form.

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A. In these patents, it may be, depending on what's disclosed in the specification.
Q. Would person of ordinary skill in the art understand "conventional bedside monitor"?
MS. HOEKEL: Object to the form.
A. As an expert, I understand.
I can't say other experts would.
Q. Now what I'm asking you is: Would a person of ordinary skill in the art understand "conventional bedside monitor"?
A. He should or she should.
Q. Would a person of ordinary skill in the art understand "initiator"?
MS. HOEKEL: Object to the form.
A. He should, and I understand.
(Pause)
MR. CLAASSEN: We have been going now for a little bit. Do you want to take about a five-minute break?
MS. HOEKEL: Sure.
THE WITNESS: That would being fantastic. Thanks, counselor.

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THE VIDEOGRAPHER: The time is 1:47 p.m. Off the record.
(Recess from 1:47 p.m. to 2:01 p.m.)
THE VIDEOGRAPHER: We are back on the record. The time is 2:01 p.m.
BY MR. CLAASSEN:
Q. Dr. Yanulis, we just took a little break.
Is that right?
A. Yes, sir.
Q. Did you talk about the substance of your testimony with counsel?
MS. HOEKEL: Object to the form, and objection that it calls for privileged testimony.
BY MR. CLAASSEN:
Q. You can answer the question.
A. No, I did not.
(Pause)
Q. I want to turn now to what I introduced as Exhibit 1 earlier. That's the joint hearing statement.

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Do you remember that?
A. Yes.
MR. CLAASSEN: I'll ask the videographer to bring it up on the screen now.
BY MR. CLAASSEN:
Q. And I'd like to turn back now to what is page 15 of the PDF. And that's the beginning of the chart, Dr. Yanulis.
Do you see that?
A. Yes, I have it on my screen. Thank you.
Q. What is your understanding of this chart?
A. In the first column is the claim language and the terms -- these are the claim language as determined -- as articulated in the claims and for the patents.
But the important thing is your construction and evidence, and my opinions of the constructions as you proposed them, and my evidence -- how I viewed it.
Q. So the right column -- that shows your

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opinions?
Is that correct?
A. To elaborate, what I -- for example, I gave what I thought "a separate computing device" meant, as an example.
Q. Let's start with that example.
What is your understanding of the construction for "separate computing device"?
A. My understanding, in view of the specification, and the claims, and my expertise for one skilled in the art, and the way this separate computing device has been disclosed in the specs, reads on "a conventional bedside monitor."
Q. When you say "reads on," what do you mean?
A. I meant to say it is the same thing, as it's been disclosed.
Q. So "separate computing device" means "conventional bedside monitor."
Is that right?
A. In this case, the way the specs have

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been disclosed.
Q. Al I'm talking about right now is the '735 patent, claim 20.
Do you understand that?
A. Yes, sir.
Q. And then also the '623 patent, claims 1, 6 -- see that list of claims?
A. Yes.
Q. So I'd like to have this discussion in the context of those claims.
Do you understand that?
A. Yes.
Q. So you understand that third column sets forth the defendants' proposed construction, right?
A. Yes, I do.
Q. What's your understanding of the defendants in the case?
MS. HOEKEL: Have object to the form.
BY MR. CLAASSEN:
Q. Who are the defendants in the case, Dr. Yanulis?

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A. The defendants are Sotero -- Sotero Wireless, I believe, is the full name.
Q. Is it anyone else?
A. There was initially. But that -- I believe that party no longer is involved.
Q. What's your understanding of that party?
MS. HOEKEL: Object to the form.
A. I don't know that much about it.
But they, obviously, are not part of the case from my understanding.
Q. Who informed you they are not part of case?
MS. HOEKEL: Object to the form.
A. Counsel.
MS. HOEKEL: Let me get my objection on the record please.
Object to the form, beyond the scope, and relevance.
BY MR. CLAASSEN:
Q. Did you help prepare this chart, Dr. Yanulis?

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A. Yes, I did.
Q. When did you help prepare the chart?
A. I'm going to have to rephrase that.
No, I didn't.
This was the defendants' proposed construction and evidence. I just provided my evaluation.
I apologize.
Q. Okay.
What is your understanding of Masimo's proposed construction?
A. As I have done, they are giving plain and ordinary meaning to these terms.
Q. So they did what you have done?
MS. HOEKEL: Objection.
A. Up to --
Q. You were answering. Go ahead.
A. Up to a point.
I may not agree with the way they have construed it.
Q. What is your understanding of the construction that Masimo proposes?

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A. For the term "a separate computing device"?
Q. Yes.
A. And they are implying, as the chart says, plain and ordinary meaning, no construction necessary.
Q. At what point do you disagree with Masimo's construction?
A. The fact, for one skilled in the art looking at the specifications, it is nothing more -- it is equivalent to a conventional bedside monitor, as disclosed in the specs.
Q. Can it be anything other than a conventional bedside monitor?
A. Sure, if it was disclosed in a different way.
Q. What do you mean by that?
A. I'm basing the fact that I have said it's a conventional bedside monitor, based on reading the specs as disclosed in the patents, and my skill in the art.
Q. I'd like to scroll down now about five

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pages to where it mentions your potential testimony.

Are you familiar with that?

So it's going to be --

A. Yes.

Q. -- 5 to 6, starting there.

So you see where it says: Defendants may rely on Dr. Yanulis?

A. Give me a moment to read it, counselor.

Q. Sure.

A. For all disputed claim terms, Defendants have identified Dr. George Yanulis -- myself -- as the expert who will provide testimony --

Q. Doctor, I don't want you to read that.

What I'd like to you focus on now is -- do you see what's been highlighted in yellow on the screen?

A. Yes.

Q. Then that continues on.

You understand that this is describing

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what the defendants may rely on you to do.

Is that right?

A. Correct.

Q. Let's scroll down to the next page then.

You understand that this column on the right continues that statement.

Is that correct?

A. Yes, I do.

Q. I'd like now to focus on where it says: Limited to a wearable transmitter.

Do you see that?

A. Yes, I do.

Q. And you say, in introducing that: The invention scope to be limited.

Is that the right way to read this -- "the invention scope to be limited"?

It's two lines out from what's highlighted in yellow -- "invention scope"?

A. Yes, sir. I was about to say I wouldn't read this. I would read the passage: The invention scope of the '735 and '623 Patents

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to be limited to wearable transmitter wirelessly transmitting data to the conventional bedside monitor using a specific receiver unit configured to function with a conventional bedside monitor, that the spec --

Q. I'd like to focus on the words "invention scope."

Do you see those?

A. Yes.

Q. They are highlighted in yellow on the screen in Exhibit 1?

A. Yes, sir.

Q. What's your understanding of the invention scope within this statement?

A. I'm not reading it just that in isolation. I'm reading the whole paragraph.

Q. What does the whole paragraph mean?

A. The whole paragraph is describing the function and why -- the means-plus-function why -- how I propose evaluating why the defendants' proposed construction of evidence is.

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I mean, that's the purpose of our discussion today is getting my opinions and why it was proposed this way.

Q. I want to make sure I heard you right.

You said: Means-plus-function.

Is that right?

A. No, I misspoke. It's not means-plus-function.

Q. So what does this paragraph mean to you?

A. It's telling me the limitations of the device or system that's been disclosed in the specifications.

Q. You understand that you are giving an opinion on the meaning of "separate computing device," right?

A. I'm giving my opinion that this so-called separate computing device is equivalent to a conventional bedside monitor.

Q. What I'm trying to figure out now is: Are you saying it's equivalent to?

Or it is a conventional bedside

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monitor?
A. Based on the way the specifications -- yes.
MS. HOEKEL: Dr. Yanulis, we can't hear you when you lean in.
THE WITNESS: I apologize. Can you hear me now?
MS. HOEKEL: Now we can.
A. My opinions -- and they have not changed -- is, after evaluating the claims and in view of the specification which includes the figures, I'm saying that my opinions, as one skilled in the art, is this particular so-called separate computing device is exactly a so-called conventional bedside monitor which has been used for several years now.
That's all I'm saying.
Q. Okay.
So "separate computing device" means "conventional bedside monitor," right?
A. As it's been disclosed in the specifications.

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Q. Why did you also then include the "using a specific receiver unit"?
Do you see that?
A. Because I was limiting -- I was providing what the device as claimed should have read.
Q. So it should have read: Conventional bedside monitor using a specific receiver unit.
Is that correct?
MS. HOEKEL: Object to the form.
THE WITNESS: Could you repeat the question again, counselor?
MR. CLAASSEN: Yeah.
BY MR. CLAASSEN:
Q. What I'm trying to figure out here is it says: Using a specific receiver unit.
Do you see that?
A. Yes, I do.
Q. What is the purpose for including "using a specific receiver unit" in this paragraph?
A. The system has to receive the

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physiological parameters being measured in some way.
Q. Okay.
Does it have to have a specific receiver unit to do that?
A. Not necessarily. But the way it's been disclosed, this is the way I understand it.
Q. What I'm trying to understand is: Is your understanding of separate computing device also include a specific receiver unit?
(Pause)
A. That it includes a transmitting or a means to wirelessly transmit the data -- it's been written -- into the conventional bedside monitor -- or to the conventional bedside monitor.
Q. Okay.
You said "transmitting," I believe.
Does the separate computing device transmit in this claim?
A. No, not directly. But it has to have -- the parameters being measured has to be

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transmitted to the conventional bedside monitor to be visible to the clinician.
Q. So they have to be received by the separate computing device.
Is that right?
A. Yes.
Q. And where are they received in the separate computing device?
(Pause)
A. They are received by -- by the so-called conventional bedside monitor. It allows you to do that.
Q. Does the conventional bedside monitor have to have a specific receiver unit in order to do that?
A. No. But based on the way the specs are written, this is my understanding.
Q. So how did you draw the line between what the separate computing device had to have?
It had to be a separate -- or it had to be a conventional bedside monitor.
Is that right?

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A. I never used the word: Had.
And if I had, I apologize.
What I meant to say: This is what the spec says. And that's all I'm going by.
Q. The spec says that the separate computing device has to be a conventional bedside monitor.
Is that your understanding?
A. The way I'm understanding the way the specs are written.
Q. So it must be a conventional bedside monitor.
Is that right?
A. The way they have disclosed it, it is exactly the way a conventional bedside monitor operates and functions, having worked with these devices.
Q. What about the specific receiver unit?
MS. HOEKEL: Object to the form.
A. I'd have to go back to the specifications to show you the exact line.
But working from memory, the way this

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device -- as disclosed by Masimo in their patent or these two patents -- it is functioning as a conventional bedside monitor.
Q. Is it your understanding that a specific receiver unit is part of the claims of the '735 patent?
A. The claims are -- I'm not looking at the claims in isolation. I'm looking at the claims in terms of the specs as well.
Maybe I'm not making that clear.
Q. Okay.
So when you are looking at the claims of the '735 patent, and you see the "separate computing device," your understanding is that that is a conventional bedside monitor, right?
A. Yes, I do.
Q. Does that conventional bedside monitor also need to include a specific receiver unit?
A. Again, that's what the specs of the patent says.
Q. So it must include the specific receiver unit.

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Is that right?
A. Yes.
Q. I want to scroll back now to page 1 of this Exhibit 1. The PDF page is 15.
A. Okay.
Q. You see the construction that Sotero proposed there in the third column?
A. Counselor, are you referring to page 1?
Q. It's shown on the screen right now, if that would be helpful to you.
A. Okay, I see where you have highlighted it.
Q. You see where it says: Conventional bedside monitor?
A. Yes.
Q. That's your understanding of the meaning of separate computing device, right?
A. The way Masimo has disclosed it in their patent specs, yes.
Q. But it doesn't say anything about a specific receiver unit, does it?

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A. No, it does not.
Q. Does "specific receiver unit" appear in the claims itself?
A. Can I look at the claim again?
Q. Yes, it's shown in column 1, for example.
A. I can flip back, counselor. You don't have to share.
Q. No, it's shown on the screen right now, Dr. Yanulis, in column 1.
A. Okay.
Q. Can you read that?
A. I didn't hear the question. I heard what you said about reading the top line.
Q. Are you able to read that claim in the left column, claim 20 from the '735 patent?
A. As how is Masimo a separate computing device?
Q. No.
My question is: Does it mention anything about a specific receiver unit?
A. No, it does not.

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Q. So I'd like to scroll then back down to page 5 and 6 that we were looking at before. I guess it's page 6.

(Pause)

Q. You see the words "using a specific receiver unit," right? -- in the right-hand column?

(Pause)

A. I'm not sure I'm -- I'm looking at the page. But -- can you highlight the section that you are referring to?

Q. Sure.

It is -- it begins six lines down: Using a specific receiver unit.

MR. CLAASSEN: On page 6, videographer. Right column, please.

Using -- at the end of that line where your cursor is.

THE WITNESS: I have that, sir -- "bedside monitor using a specific receiver."

BY MR. CLAASSEN:

Q. So you see that -- "using a specific

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receiver unit"?

A. Yes.

Q. Is that part of the claims of the '735 patent?

A. No, that's the defendants' proposed construction.

Q. So defendants' proposed construction includes a specific receiver unit.

Is that correct?

A. Correct.

Q. Is it your understanding that a specific receiver unit is also part of the claims of the '623 patent?

A. To the best of my knowledge, yes.

(Pause)

Q. And the claims as you understand them are limited to using a specific receiver unit.

Is that correct?

A. No. I'm not saying that.

What I'm saying -- this is the way they should be construed, the claims. This is the position I'm taking and agreeing to.

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Q. If the court adopts your construction, does it include using a specific receiver unit?

A. That's if they agree. This is just a proposed construction by the district court.

Q. So if the district court agrees with your construction, it includes using a specific receiver unit, right?

A. To the best of my knowledge, yes.

Q. That specific receiver unit is not part of Sotero's construction, right?

A. Correct.

Q. So you propose a different construction, right?

A. No, sir, I'm not. I'm looking at the disputed eight terms as proposed by the court's listing the way Masimo would like the claims to be constructed, or using plain and ordinary meaning, versus Sotero's position on why they don't agree with that term or the way it's evaluated or used.

Q. Have you provided any other opinions on the construction of the terms in the '735

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patent?

MS. HOEKEL: Object to the form.

A. Could you repeat the question again, counselor?

Q. Sure.

Have you provided any other opinions on the construction of terms in the '735 patent?

A. No.

Q. Did you provide any opinion on the construction of terms for your IPR declaration for the '735 patent?

MS. HOEKEL: Object to the form.

I don't think it's fair to have this being be a memory test; plus the IPR declaration is not an issue in this particular proceeding.

(Pause)

A. To the best of my memory, I did provide opinions on some of the terms as I discussed earlier in my IPRs, but as a separate exercise.

I don't really want to discuss -- I'm not really able to answer other than the fact is

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I'd have to look at the specific IPRs to answer accurately.
Q. Did you consider the evidence cited by Masimo in support of its proposed constructions?
A. That, I did do.
Q. I want to scroll up, then, to page 2.
MS. HOEKEL: Page 2 of what? I'm sorry.
MR. CLAASSEN: Page 2 of this Exhibit 1, which is -- what I want to look at is page 2 of the joint claim construction chart. It's up on the screen now.
Do you see that, Dr. Yanulis?
A. Yes, I do.
But could you highlight exactly what section you want me to --
Q. Okay -- I'm just making sure you can see it on the screen so far.
A. Yes, I do. I'm sorry.
Q. And you considered the extrinsic evidence that Masimo cited in support of its construction, right?

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A. Yes, I did.
Q. And you see that there is a petition cited there for the '735 patent?
A. I didn't hear you, sir.
Q. You see that there is a petition listed there for the '735 patent.
Is that correct?
A. Yes.
Q. And you see that further down on the page, there is a declaration from you in support of that IPR?
A. Yes, I do, sir.
Q. So you understand that that's part of the evidence that Masimo is relying on, right?
MS. HOEKEL: Object to the form.
A. As Masimo relies on it for their proposed constructions.
Doesn't mean I rely on it.
Q. You considered it, right?
A. Yes.
Q. You reviewed that in preparing for the deposition today.

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Is that right?
A. Yes, sir, I did.
MR. CLAASSEN: I'd like you to pull out now what's been labeled as Exhibit No. 3. And that's your declaration. That's the declaration we were just talking about.
THE WITNESS: Give me a second, counselor.
MR. CLAASSEN: Yes.
THE WITNESS: Let me make sure you are asking me about Exhibit 3, sir?
MR. CLAASSEN: Yes.
THE WITNESS: Give me a moment.
Yes, sir, I have it.
BY MR. CLAASSEN:
Q. That's your declaration regarding the '735 patent.
Is that right?
A. Yes, sir, it is.
Q. Does this Exhibit 3 appear to be complete to you?
A. Yes, it does.

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MR. CLAASSEN: I'd like the court reporter to mark Exhibit 3 for the record.
(Exhibit 3, Document Bates stamped MAS0020688 through 20850, multipage document entitled: Declaration of George E. Yanulis in Support of Petition for Inter Partes Review of U.S. Patent No. 9,788,735, dated May 18, 2020, marked for identification)
BY MR. CLAASSEN:
Q. Did you write this declaration, Dr. Yanulis?
A. Yes, I did.
Q. In it, you provide an overview of the '735 patent, right?
A. Yes, I did, as well as any other information relevant to the declaration.
Q. There is a section in this declaration on claim construction, right?
A. Yes, there is. I'd have to look and see what that is -- but, yes.
Q. Okay. We'll talk about that in just a couple minutes.

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(Pause)
Q. I'd like to start with paragraph 21.
A. I didn't hear what you said, counselor.
Q. I'd like to start with paragraph 21. That's on page 8, and it's also Bates marked MAS0020715.
A. Yes, I'm at that page now.
MS. HOEKEL: I would like just a continuing objection so I don't have to keep interrupting -- that it is defendants' position that the IPR declaration, even though cited by Masimo in its claim construction chart, is not relevant to the current dispute.
MR. CLAASSEN: Understood. We respectfully disagree.
(Pause)
BY MR. CLAASSEN:
Q. So you see paragraph 21 there, Dr. Yanulis?
A. Yes, I do.
Q. The first sentence there describes

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wirelessly transferring sensor data to another device, right?
A. Yes, it does.
Q. So you understood that to be part of the '735 patent, right?
A. Yes, sir, I did.
Q. When you wrote this overview of the patent, were you writing that from the perspective of a person of ordinary skill in the art?
A. Yes, I did.
(Pause)
Q. Paragraph 21 continues with a next sentence.
Do you see that?
It describes the general idea of untethering patient sensors from a conventional bedside monitor?
A. Yes, I see that, sir.
Q. So you understood that the general idea was to untether the patient from that conventional bedside monitor, right?

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MS. HOEKEL: Object to the form, incomplete.
Q. Do you understand the question?
A. I did understand the question.
Q. You can answer it?
A. The answer is: Yes.
Q. What's your understanding of "untethering" in this paragraph?
A. Untethering, from my experience, as an example, would apply if you are transferring a patient, for example, to a critical care unit, or to a step down unit, or to another facility, such as the operating room, etc.
(Pause)
A. "Untethering" means just to "remove."
(Pause)
A. Are you there?
Q. Yes, thank you.
A. Can I continue on with it?
Q. If you have more to add, go ahead.
A. Not at this point, no, I don't.
(Pause)

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Q. Turning now down to paragraph 22?
A. Okay, I'm there, thanks, counselor.
Q. About the fifth line -- you see the fifth line there?
It begins: The '735 specification focuses on this transmitter/receiver system?
Do you see that?
A. Yes, I do.
Q. Is that stated somewhere in the patent itself, as far as you are aware?
A. Yes.
Q. Where is that?
A. Let me think about that for a second, counselor --
Q. Okay.
A. -- before I answer.
The statement, the way I had written it, implies that it's directed. It may not be claimed as such. There is a difference -- the way I understood the specs to read.
Q. So the specification is focused on that transmitter receiver system.

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Is that right?
A. Yes, it is, sir.
Q. How does that focus impact the construction of the terms in the '735 patent?
A. Can we -- again, based on my memory of the claims as written, it doesn't provide this limitation, if I remember correctly.
(Pause)
THE WITNESS: Can you hear me okay, counselor?
MR. CLAASSEN: I can, thank you.
I'm taking a look at the transcript to make sure I understood your response correctly. So I can hear you. There is just a little bit of delay on my end.
THE WITNESS: Please let me know at any time if you don't hear me. Sometimes I bend back in the chair.
MR. CLAASSEN: I think the only time we haven't really been able to hear you is when you lean forward and to the right a little.
THE WITNESS: Oh, okay.

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(Pause)
BY MR. CLAASSEN:
Q. Continuing with that paragraph 22 that we were just looking at, do you see the nine figure sentence that starts right after the sentence we just highlighted: Indeed, nine figures?
Do you see that?
A. If I may, I want to read it in the whole context.
Q. Yeah, go ahead. I just want to direct your attention to it.
A. Yes, I'm there.
May I read the statement?
Q. Please do.
A. Indeed, the nine figures of the '735 Patent focus solely on the unclaimed receiver module that plugs into a conventional bedside monitor. Exhibit 1001, Figures 3, 5A through C, 7, 9, 11, 12, and lines 14 -- excuse me -- column 14, lines 1 through 16 -- in the statement as written. Also, I note --

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Q. Okay, you can stop there. I want to ask you just about that sentence right now.
A. Okay.
Q. So you see the sentence you just read?
A. Yes.
Q. You mentioned: The nine figures focus solely on the unclaimed receiver module.
Do you see that -- "unclaimed receiver module"?
A. Yes.
Q. What do you mean by "unclaimed receiver module"?
A. They haven't claimed it. They haven't listed it as part of the claim.
Q. Is that different than the specific receiver unit we were talking about just a few minutes ago?
A. Based on the specifications as written, they are the same thing.
Q. Here you recognize that it's not claimed, right?
A. Yes.

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Q. Does the specification have an embodiment without the unclaimed receiver module?
A. I'd have to look at all the specs, but I'm sure it does. I don't know them by memory.
(Pause)
Q. You understand that Masimo has other patents that claim this receiver module, right?
A. Yes, sir, I do.
(Pause)
Q. Now I want to move to paragraph -- page 12, beginning at paragraph 27. That's your opinion on the level of ordinary skill in the art.
Do you see that?
MR. CLAASSEN: Videographer, can you take down that highlighted section for now? You can highlight the B section for Dr. Yanulis so he can see what we are talking about.
A. Reading that statement so it's in the court record: I have knowledge relevant to what a person having ordinary skill in the art at the

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time of invention would understand and do. In 2002, at the priority date of the '735, I had 20 years of experience in the field and was a person of ordinary skill in the art.

Q. How did that level of ordinary skill in the art that you opined on impact your analysis?

A. I was using it as a basis of forming my opinions.

Q. In what way?

A. In terms of what was being disclosed in the '735 and what my experience in the field related to the '735 patent had disclosed.

Q. So were you relying on what a person of ordinary skill in the art would see?

Or your 20 years of experience?

A. I've had 20 years experience in designing monitoring systems. I've been in the operating room as a clinical engineer. I have been in other clinical care environments. And I have been involved in design and develop of these types of systems.

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Q. So you are beyond a person of ordinary skill in the art, right?

A. Yes.

Q. Well beyond?

A. Yes.

Q. You have a degree, right?

A. Yes.

Q. And you have 20 years of experience?

A. Yes.

Q. So you are well beyond your definition of a person of ordinary skill in the art, right?

A. What I'm saying in this is the minimal requirement would have to have this ordinary skill to understand it.

I may have additional work experiences, but I'm just basing it on what my experience was in research and design and being involved in seeing these monitoring systems used in different critical care environments.

Q. Did you do anything to put yourself in the shoes of a person of ordinary skill in the art versus your 20 years experience?

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A. The answer is: Yes.

Q. What did you do?

A. I realize that everybody doesn't have a Ph.D. in biomedical engineering, number one. And everybody doesn't have at least 10 years of clinical engineering design and having experience to do that.

But, again, if the person, again, has the B.S. in biomedical engineering and has some additional work experience in design and development of these systems, I can agree that these opinions were properly formed.

Q. When was the last time you worked with a person of ordinary skill in the art?

A. I've had two other -- excuse me -- I have had three other patent cases, one that just finished and I have another patent case where I am involved with -- I can't discuss what it is.

And I am looking at what their expert -- who has ordinary skill in the art -- so at least four or five times.

Q. So my question is slightly different.

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When was the last time you had experience with someone who had graduated from engineering school and had two years of work experience?

A. The last -- the patent I'm involved with.

Q. Outside the patent context now, what I want to talk about is: Do you have any experience working with a person of ordinary skill in the art?

A. The answer is: Yes.

Q. When was the last time you worked with that type of person?

A. As a faculty member at Temple where I had to work with graduate students in biomedical engineering to understand research and design. And that was 2016.

Q. So you are very familiar with what a person of ordinary skill in the art would understand, right?

A. Yes, sir, I am -- I believe I am.

Q. I want to direct your attention now

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down to paragraph 29.
Do you see that paragraph?
A. Yes, sir.
Q. The second sentence in that paragraph -- do you see that? -- that the claims' scope focuses on the housing configuration?
Do you see that?
A. Yes, I do.
Q. Then it continues: Not on the electrical technology that facilitates communication with medical sensors or wireless data transmission.
Right?
A. Yes, I do.
(Pause)
Q. Do you agree with that statement as you sit here today?
A. I agree with that statement, but I'd like to read the rest of the statement for the court reporter.
Q. We have the exhibit in the record. I

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don't think you need to read it.
A. Yes, I agree with everything that's written.
Q. Down near the bottom of the paragraph, the second-to-last sentence says: Thus, the claims are directed mostly to wire management.
Do you see that?
A. Yes, I do.
Q. How did that impact your analysis of claims for construction?
A. Because my experiences with these types of devices, patient comfort is not always considered. And a patient needs to be -- you need to be concerned with patient comfort.
Q. So patient comfort is important, right?
A. Yes, the patient is very scared to begin with and you are trying to minimize anxiety.
Q. Did that impact your analysis of claims -- the construction of any of the claims?
A. No.

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(Pause)
Q. You understood that the claims also included other features, right?
A. Yes, sir, I did.
Q. Does that include the wireless transmission?
A. I'm not sure I understand the context in which you are asking me that question.
Q. Did the claims include wireless transmission?
A. I'm saying what they should have been directed. And a lot of the claims did discuss wire management.
Q. I'm asking a different question now.
Did the claims also include wireless transmission?
A. Some of them do.
Q. Was wireless transmission conventional at the time of the invention?
A. Yes, it was.
Q. Was a computing device conventional at the time of the invention?

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A. Yes, it was.
Q. How much disclosure in the specification is needed for something that's conventional?
MS. HOEKEL: Object to the form.
A. Can you repeat the question, counselor?
Q. What is your understanding of how much disclosure is needed in the specification for something conventional?
A. Enough to understand that it's being used as I believe it's being used. And I understand it as an expert as a conventional bedside manner.
(Pause)
Q. If the claims recited a light emitting diode, does the specification need to describe a light emitting diode?
A. No, because one skilled in the art like myself knows what an LED is and how it's --
Q. Does one skilled in the art also know what a computing device is?

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A. He or she should. And I do.
Q. And does a person of ordinary skill in the art understand what wireless transmission is?
A. They should.
Q. I want to move now to claim 14 of your declaration. And that's the section that starts: Claim construction.
Do you see that?
A. Yes.
MS. HOEKEL: Just continue my objection that this is irrelevant to the disputed issue and seems to be being used as a deposition for the IPR, not for the claim construction exercise.
MR. CLAASSEN: Okay.
BY MR. CLAASSEN:
Q. I'm going to direct your attention now to paragraph 34.
Do you see that?
A. Yes, I do, sir.
Q. You say there that: I believe that

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all claim terms, for purposes of the inter partes review can be given their plain and ordinary meaning.
Right?
A. And I agree with that statement.
Q. You do?
A. Which is why I put it in there.
Q. For separate computing device, how is that different from Masimo's construction in the district court?
MS. HOEKEL: Object to the form.
A. This is the IPR. It's not the disputed terms. The IPR is not the same exercise as evaluation of construction of disputed terms.
Q. What's different about it for purposes of claim construction?
A. In terms of claim construction, in the IPRs were concerned only with invalidating based on the prior art. The claims, as such, by both parties are invalid.
What we are looking at in the IPRs is

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the support of the prior art, which I have identified, which invalidates the claims as written in these particular patents.
Whereas the construction terms -- construed by the court and agreed to be discussed by both parties -- is a different exercise because it implies additional.
Other than invalidity, you are also concerned with infringement and more precise definitions of the terms disputed.
So there are two distinct exercises.
Q. So the claims should be construed differently in the different venues.
Is that right?
A. I never said that.
You are still using plain ordinary meaning. Maybe I'm not articulating correctly.
What I'm trying to say is, for the purposes of the discussion of the eight disputed term, you are looking for the most precise terminology as it's discussed, construed by both sides.

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This is not what's being discussed in the IPR.
Q. So is it your understanding that "conventional bedside monitor" is the plain and ordinary meaning of "separate computing device"?
A. Yes, it is.
Q. So you think the parties agree that the plain and ordinary meaning applies.
Is that right?
MS. HOEKEL: Object to the form.
In what context are we talking about?
BY MR. CLAASSEN:
Q. Let's talk about the district court.
MR. CHEN: If I may interject, I am curious because I'm on the west coast. When do you plan to take a lunch break?
MR. CLAASSEN: 15 minutes or so.
MR. CHEN: Okay. Thanks.
THE WITNESS: Could you repeat your question, counselor?
MR. CLAASSEN: Yes.

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BY MR. CLAASSEN:
Q. Is it your understanding that Sotero's construction in the district court is the plain and ordinary meaning?
A. It's both sides -- for the purpose of looking -- excuse me -- giving plain and ordinary meaning. Doesn't matter if we are talking about IPRs.
But for the this purpose, again, we are talking about IPRs.
Q. I understand.
A. And if we were talking about the so-called construction of claims as developed by district court, you go a little bit further.
As I said, it's not just invalidity in this case. And that's why the terms are much more important.
The only thing we are looking at the IPRs -- as I have said a couple of times -- is the IPR -- the claims are invalid for both sides. They haven't been construed by the court yet. We are looking at the invalidity based on

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the prior art, which I disclosed in all of the IPRs -- nothing more, nothing less.
Q. You understand that Sotero's construction in the District Court of "separate computing device" is "conventional bedside monitor," right?
A. Yes.
Q. Is that construction set forth anywhere in your IPR declaration?
A. Not -- no, it's not.
Q. Is a conventional bedside monitor different than the plain and ordinary meaning?
A. No, it's not. Still given plain and ordinary meaning in the IPRs and in the so-called disputed claims.
But we are going a little further with the claims disputed. It's not the same thing.
Q. So it's appropriate to apply a different claim construction for an IPR than it is for the district court.
Is that right?
A. No, sir.

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I keep repeating: You still give it plain and ordinary meaning.
But, again, the claims are invalid on both sides. It doesn't come into play until we discuss the district court's construction of claims and the two sides -- the way they -- the claims.
This has not been discussed --
MR. CLAASSEN: Dr. Yanulis, you need to lean back.
THE WITNESS: Can you hear me okay now?
MR. CLAASSEN: Yes.
A. So we are not talking about whether -- other than the fact -- I'm looking at all the IPRs written is to see, using plain and ordinary meaning -- nothing more -- which is the standard for both.
But in this case I'm looking to see if the patents are invalidated by the prior art.
And I have showed that.
Q. Okay.

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So you showed where the prior art teaches that a separate computing device is a conventional bedside monitor.
Is that right?
MS. HOEKEL: Object to the form.
MR. CLAASSEN: Let me ask it differently.
BY MR. CLAASSEN:
Q. Which prior art that you relied on in this IPR shows that a device -- that a separate computing device is a conventional bedside monitor?
MS. HOEKEL: Object to the form.
This is way beyond the scope of what the deposition is supposed to be, which is claim construction of the district court.
And we are now continuing even further down the line of prior art and the IPR.
BY MR. CLAASSEN:
Q. Dr. Yanulis, you just told me your opinion is that you applied the claim constructions from both sides, right?

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A. No.
Q. Okay.
What did you do?
A. What I had done is applied a standard of plain and ordinary meaning for all the claim terms being disagreed upon by both sides.
But I'm telling the correct way, as an expert, how I would apply those terms.
And it's not the same thing in the IPR.
All I've discussed in the IPR is invalidity based on prior art.
Q. But this section says: Claim construction.
Right?
A. Yes, it does.
Q. And you gave an opinion on claim construction, right?
A. Yes, I did.
Q. And it's different from the opinion in the district court.
Isn't that right?

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MS. HOEKEL: Object to the form.
A. I don't agree with you interpreting my statement.
I know what I said in it. And this is -- I'm sticking to my -- how should I say it? -- what I said. I agree that it says --
Q. Where did you inform the PTAB --
MS. HOEKEL: The witness hasn't finished.
BY MR. CLAASSEN:
Q. -- that the separate computing device means a conventional bedside monitor?
MS. HOEKEL: I would like to remind counsel to let the witness finish his answer. I think you cut him off.
BY MR. CLAASSEN:
Q. Where did you inform the PTAB that "separate computing device" means a "conventional bedside monitor"?
A. I don't remember my exact section.
And, again, the terms so-called "separate computing device" are not relevant in the IPR.
What's relevant is I have been properly supported why this patent is invalid based on the prior art, which I disclosed in the IPR.
Q. And the prior art has to disclose each and every claim limitation.
Isn't that right?
MS. HOEKEL: Object to the form, beyond the scope of the deposition.
A. I believe I've answered your question, counselor. I don't know how to answer it differently.
(Pause)
MR. CLAASSEN: All right. Let's take our short lunch break. How long would you like, Hua?
MR. CHEN: Twenty-five minutes to an hour.
MS. HOEKEL: Why don't we do 45 minutes and come back at -- I can't do the math -- 2:00 o'clock --

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MR. CLAASSEN: Yeah, 45 after the hour?
MS. HOEKEL: Yeah, that's fine.
THE WITNESS: Sounds good to me.
MR. CHEN: Sounds good. Thank you.
THE VIDEOGRAPHER: The time is 2:56 p.m. Off the record.
* * *
L U N C H R E C E S S
Time noted 2:56 p.m. Eastern Standard Time
* * *

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* * *

AFTERNOON SESSION

Time noted 3:49 p.m. Eastern Standard Time

* * *

THE VIDEOGRAPHER: The time is 3:49 p.m. Back on the record.

BY MR. CLAASSEN:

Q. Okay. Dr. Yanulis, can you hear me well?

A. Yes, I can, thank you. Thanks for the lunch break.

Q. Of course.

We have been talking about separate computing device.

Do you remember that?

A. Yes, sir.

Q. Let break down that term -- "separate computing device."

Would a person of ordinary skill in the art understand the word "separate"?

A. Yes, they would.

Q. Would a person of ordinary skill in

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the art understand "computing"?

A. Yes, they would.

Q. Would a person of ordinary skill in the art understand "device"?

A. Yes, they would.

(Pause)

Q. So we have also talking about the plain and ordinary meaning.

Do you remember that?

A. Yes, sir.

Q. Is the plain and ordinary meaning broader or narrower than "conventional bedside monitor"?

A. Can you repeat the question?

Q. Yes.

Is the plain and ordinary meaning of "separate computing device" broader or narrower than "conventional bedside monitor"?

A. It's broader.

Q. How?

A. The term the way you have just articulated could apply to a lot of different

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things.

Q. What different things could it apply to?

A. Well, it doesn't have to be a conventional monitor. But that's not the way it's discussed in the patents in all respects.

It's discussed as a conventional bedside monitor.

But it could have different uses in other applications.

Q. Can you think of any examples of uses in other applications?

A. I -- surveillance system, in other words program to turn on and off when one leaves the home; turning your lights on and off; again, turning the alarm system or surveillance system.

I'm trying to think of nonmedical applications.

It could also apply to your heating system, how it's controlled.

Q. How would a surveillance system be a separate computing device?

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A. Just the system alone -- but it could incorporate a separate computing device, in other words, to control the functioning of your surveillance system. It depends on the complexity of your surveillance systems. And I'm not really an expert on surveillance systems.

But it's the same type of electronic technology to some degree.

Q. Are you done with your response?

A. Yes, sir.

Q. Could a separate computing device include a phone?

MS. HOEKEL: Object to the form.

A. It could, but that's not what we are talking about here -- these patents.

Q. Would a person of ordinary skill in the art understand the plain and ordinary meaning of "separate computing device" to include a phone?

MS. HOEKEL: Object to the form.

A. It should be able to, but you'd have

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to describe the application which it's used in.
Q. Would a person of ordinary skill in the art understand a "separate computing device" to include a laptop computer?
MS. HOEKEL: Object to the form.
A. Same answer, counselor: It could.
That's not what's being disclosed here.
Q. Is there a distinction between what's disclosed and what's claimed?
A. The specs, as I have been saying, basically articulate a conventional bedside monitor. That's not in agreement with the claims and the terms that are used, which is why we are having the discussion.
(Pause)
Q. Do you still have the '735 patent that's been marked as Exhibit 2?
A. Yes, sir, I do. I have it if front of me.
MR. CLAASSEN: I'll ask the videographer to put that up on the screen for

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us.
So Exhibit 2. And let's look at Figure 1.
BY MR. CLAASSEN:
Q. Do you see Figure 1, Dr. Yanulis?
A. Yes, I do.
Q. What's shown in Figure 1?
A. Without looking at the specs, I could identify main monitoring unit and the device that's attached to the hand.
But I'd have to look at the figure in combination with the specs as it applies to this figure.
Q. Is anything on this Figure 1 a separate computing device?
A. Again, I have to look at the specs the way they have been defined. Just looking at this, I can't tell.
Q. Is anything on here a conventional bedside monitor?
A. The whole system, 160, is the conventional bedside monitor. And I've seen

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hundreds --
Q. Do you --
A. -- go ahead.
Q. I'll let you finish.
A. The unit, if I'm understanding the element 160, is the conventional bedside monitor. And it looks like you are just showing one parameter being monitored or showing on the display.
Q. Do you see two different numbers on there? -- 98 and an 80?
A. Yes.
Q. Are those one parameter?
A. I would say -- now looking at this, I would say the top number is the pulse oximetry. The bottom number is more than likely -- I would say that's the pulse rate, heart rate.
I'll just say pulse rate.
Q. Would this conventional bedside monitor satisfy the separate computing device limitation?
A. Again, I have to look at the specs in

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combination with this figure.
Q. Did you do that?
A. Yes, I can do that right now.
Q. I'm not asking if you could do it.
I'm asking: Did you do that?
A. Yes, I did.
Q. Do you remember what you concluded?
A. I concluded that this is a separate -- excuse me -- that this -- this is a conventional bedside monitor as disclosed, which is well known in the art.
Q. Did you find a separate computing device within your understanding of the term in the '735 patent?
MS. HOEKEL: Object to the form.
A. I don't really understand the question you are asking me.
Because I have already said a separate computing device is, as I made opinions on, a conventional bedside monitor.
So I don't really understand your question.

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Q. So does this Figure 1 show a separate computing device within your understanding of the claim?
A. Again, I'll repeat myself: This is showing a separate computing device which is equivalent to a conventional bedside monitor, as disclosed in the specs.
Q. Did you also consider Figure 5A?
A. Yes, I did, sir.
MR. CLAASSEN: I'll ask the court reporter, then, to put up figure 5A.
(Pause)
THE WITNESS: Okay.
BY MR. CLAASSEN:
Q. See that?
A. Yes, I do.
Q. What is shown in Figure 5A?
A. From remembering the specs without looking at it, it is clear this is the conventional bedside monitor.
And the unit -- I'll call it 510-K -- excuse me -- 510 is the element described as the

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plug-in compatible device as they referred to in the specs.
Q. So is Figure 5A showing a conventional bedside monitor?
A. Right, with a 510 element, which is basically -- without elaborating much more -- is the so-called plug in unit, communication unit, that's been disclosed in the patent.
Q. You are calling that 510, right?
A. Without going to the specs directly. I mean, I would want to see the specs. I'm guessing from memory.
But just based on my expertise, I would say that's the plug-in module that's being claimed.
Q. If you removed the receiver unit that we have been calling 510 from the monitor, is it a separate computing device?
MS. HOEKEL: Object to the form --
A. Yes, if you -- go ahead.
MS. HOEKEL: I object to the form.
Go ahead, Dr. Yanulis.

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A. Again, this separate computing device, which I have been saying right along, is a conventional bedside monitor as disclosed.
Q. My question is slightly different.
If you took away the receiver unit 510, would that still be a conventional bedside monitor?
MS. HOEKEL: Same objection.
A. I'm going to say I have to look at the specs before I make that opinion.
Q. Have you done that before?
A. Yes, I have.
Q. Do you remember what you concluded?
A. I concluded, again, the main 360 -- whether you have this plug-in unit -- is still a conventional bedside monitor.
Q. Would that also be a separate computing device?
A. Yes.
(Pause)
Q. We talked about earlier that the separate computing device needs to receive data,

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right?
A. Yes, it does.
Q. Does a conventional bedside monitor have an apparatus for receiving data?
A. There is usually something connected or within that system that allows you to do that. You have to receive the signals in order to show the visible display of the monitor of the physiological parameters being monitored.
(Pause)
Q. Let's talk about the next claim term -- the "separate monitoring device."
Do you remember that claim term?
A. Yes, I do.
Q. Let's go back, then, to Exhibit 1.
A. Okay.
Q. We'll move on to page -- well, it's page 7 of the chart.
A. Okay.
MR. CLAASSEN: I'll ask the videographer to do the same thing there.
THE WITNESS: Okay.

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BY MR. CLAASSEN:
Q. Do you see that page 7 is listed up on the video screen there?
A. Yes, I do.
Q. What's your understanding of Sotero's construction for "a separate monitoring device"?
A. That it's a conventional bedside monitor.
Q. Is that the same construction for "separate computing device" that we just talked about?
A. A conventional bedside monitor as disclosed and listed on this chart is the exact same thing as has been disclosed in the specs -- separate monitoring device, yes.
But it's a conventional bedside monitor. I'm sticking with that position, and that's my opinion.
Q. The same construction for "separate computing device" and "separate monitoring device."
Is that right?

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A. I didn't hear the question, sir.
Q. I want to make sure that I'm understanding your previous response correctly.
In your opinion, "separate computing device" and "separate monitoring device" have the same construction, right?
A. Not what I said, sir.
What I said was: The way the specs have been written and disclosed, it is, in my expert opinion, a conventional bedside monitor.
What you call it -- the way the term I understand it and the way it's been articulated in the specs, conventional bedside monitor -- is a separate computer device.
Q. So it's a separate computing device.
Is that right?
A. As it's been disclosed in the patent.
Q. Is a conventional bedside monitor also a separate monitoring device?
A. Could you repeat the question?
Q. Is a conventional bedside monitor also a separate monitoring device?

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A. As disclosed in the specs, in my opinion and expertise with working with the spec device.
(Pause)
Q. Let's focus on the difference, then, between computing and monitoring.
Is there a difference?
A. The way this spec has been disclosed, no.
Q. Does that difference in claim language impact your analysis?
A. Can I repeat the question in my own words?
Could you repeat the question, counselor?
Q. Is the difference in claim language -- can that have any difference -- let me just start all over again.
We were talking about separate computing device, right?
And you understand that that term is different from separate monitoring device,

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right?
A. No, that's not what I said, counselor.
What I said was: The way it's been disclosed, separate monitoring device as it's been disclosed in the specs is a separate computing device.
Q. Okay.
Now you are talking about the meaning.
What I want to talk about is the claim terms themselves.
So you understand the words "separate computing device" and "separate monitoring device" are different, right?
A. Yes.
Q. How did that difference impact your claim construction analysis?
A. It impacted it in the sense that the way the specs have been disclosed -- is a separate monitoring device. The opinion has not changed.
Q. So the ultimate opinion did not change. I understand that.

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Did it change anything about your analysis?

A. No, it did not.

(Pause)

Q. Does the conventional bedside monitor need to include a specific receiver unit?

A. Not necessarily.

Q. What do you mean by that?

A. I'm going to rephrase this and say: The way it's been disclosed, I would say that it does include a transmitter, receiver, or some means for attaching it to.

Q. My question, though, is: Does it require using a specific receiver unit?

A. No, it does not. Can use any receiver unit.

Q. How did you make that determination?

A. My skill in the art. You have to receive the data somehow. You have to receive it in some manner.

(Pause)

Q. Is it your opinion that a conventional

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bedside monitor included a receiver?

MS. HOEKEL: Object to the form.

A. I'm going to reply: I'm not sure how you are asking and how it's different than the opinions and comments I've already made in the record.

Q. Let's take a look, then, at page 11 of this Exhibit 1. This is similar to what we talked about before.

You see on the third line there it says: Specific receiver unit?

A. Yes.

Q. What is your understanding of the reason for including the words "specific receiver unit" in this paragraph?

A. Because the patent as disclosed has to include some type of receiver unit which can be configured to function with a conventional bedside monitor.

Q. So my question for you -- and I want to make sure I'm understanding you -- is: Can it be any receiver?

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Or does it need to be the specific receiver unit?

A. It could be any receiver, but the receiver has been disclosed in a certain manner.

So I'm basing it on the way they have discussed in the specs the receiver unit.

You could use a different receiver unit, to answer your question.

Q. But you couldn't use any different monitoring device.

Is that correct?

A. No, sir, that's not what I'm saying.

I'm saying that the specs read on a conventional bedside monitor -- period.

Q. That will not include a central station, right?

MS. HOEKEL: Object to the form.

A. For my answer, it could be.

Q. How would a central unit be bedside?

A. You could have a central nurse's station, which is -- has its -- and it's not the patient monitor. It's their display of the

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individual patient monitoring systems.

And that's the state -- that's the usual, well-known use.

So I want to make sure it's clear in the record.

A central -- call it -- display unit for all the patient monitors is not the same thing as one individual conventional bedside monitor the way it's been disclosed.

Q. So is a nurse's station -- a central nurse's station -- a separate monitoring device?

A. It could be.

Q. Under what conditions could it be?

MS. HOEKEL: Object to the form, beyond the scope of the deposition, beyond the scope of claim construction.

BY MR. CLAASSEN:

Q. What's your understanding of the word "bedside," Dr. Yanulis?

A. Adjacent to the patient or in close proximity to the patient being monitored.

Q. Is a nurse's station in close

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proximity to a patient?
A. If you are talking about an IC unit, from my expertise, it could be visible but it could be a separate unit. And that particular monitor for that patient could be visible on their central conventional monitor.
Q. But would that be bedside?
A. No.
(Pause)
MR. CLAASSEN: Let take a look now at Exhibit 6, which is your IPR declaration regarding the '108 patent.
THE WITNESS: Okay. And I appreciate your sharing the screen with me, counselor.
MR. CLAASSEN: Of course. Is it helpful?
THE WITNESS: Very helpful.
MR. CLAASSEN: I need Exhibit 7.
MS. HOEKEL: I'm just going to put on the record an objection, again, to questioning about the IPR declaration as irrelevant and beyond the scope of this deposition.

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What exhibit are we looking at, Brian?
MR. CLAASSEN: Exhibit 7.
MS. HOEKEL: And it is the IPR declaration for '108?
MR. CLAASSEN: That's correct.
BY MR. CLAASSEN:
Q. Dr. Yanulis, have you seen this Exhibit 7 before?
A. Yes, counselor.
I want to make sure that we are -- you are referring to Exhibit 1003? I mean, I am looking at the declaration that I made for the '108 patent.
Q. I just want to make sure what we're talking about here when you say Exhibit 1003 is for the '108 patent, right?
A. Yes.
Q. The reason I'm being particular there is because I understand -- or at least it's my observation -- that Exhibit 1003 is the number for your declaration for each of the IPRs?
A. And I apologize about that. I don't

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remember.
Q. That's okay. I just want to make sure that we are talking about the same thing.
So up on the screen, we are going to call this exhibit Exhibit 7.
Do you understand that?
A. Yes, sir, I appreciate that.
MR. CLAASSEN: So I'd like the court reporter to mark this exhibit as Exhibit 7.
(Exhibit 7, Document Bates stamped MAS0021189 through 21315, multipage document entitled: Declaration of George E. Yanulis in Support of Petition for Inter Partes Review of U.S. Patent No. 10,213,108, dated May 6, 2020, marked for identification)
BY MR. CLAASSEN:
Q. So what is this document, Dr. Yanulis?
A. This is the inter partes review that I wrote for U.S. Patent '108 as part of our petition to the patent review board.
Q. And as part of this petition -- or, sorry -- part of this declaration, you set forth

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an opinion on claim construction for the '108 patent, right?
A. Yes, I did.
Q. I want to turn now to page 13 of that declaration.
(Pause)
A. Okay. I'm seeing it now.
Q. You see there is a heading there that says: Claim Construction?
A. Yes, I do.
You want me to read it?
Or --
Q. No, I don't. At least not aloud. You can read it to yourself if that would help you.
A. Do you mind if I read it very quickly myself?
Q. Go ahead. Let me know when you are finished.
A. I have read what's on page 13 at the bottom.
Q. That continues on to page 14, right?
A. I'm assuming it does, yes.

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Q. The bottom of the page 13 sets forth the legal principles for claim construction, right?
A. Correct.
Q. Then there is a heading -- gives: Opinion of Claim Construction.
Right?
A. I'm not seeing B.
Could you repeat that, sir?
Q. Sure.
On the next page, 14, which has also got Bates Nos. MAS0021218 -- do you see that? --
A. Yes.
Q. -- there is a heading B that says: Opinion of Claim Construction.
Do you see that?
A. Yeah. I thought I heard 8, counselor. I'm sorry.
Q. That's no problem.
So you see that section B, as in boy?
A. Yes, I do.
Q. That's an opinion of claim

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construction, right?
A. Indeed -- yes, it is. It's my opinion.
Q. Do you see that paragraph 34 there?
A. Yes.
Q. And it says you believe that all claim terms for purposes of inter partes review can be given their plain and ordinary meaning.
Do you see that?
A. Yes.
Q. Did that include "separate monitoring device"?
MS. HOEKEL: Object to the form.
A. I'm not sure how to answer that, sir, in the context of this page.
Q. Do "all claim terms" of the '108 patent include "separate monitoring device"?
(Pause)
A. Looking in the context of what's written on this page, I don't know. I'd have to go through the rest of the IPR.
Q. You see there are two paragraphs below

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where it starts with: Summary of the Prior Art.
Right?
A. I don't see where you are talking about, sir.
Q. Up on the screen now you see on the right side, there is page 14 of what we have been calling Exhibit 7, which is your declaration, right?
A. Correct.
Q. And there is a heading B that says: Opinion of Claim Construction.
Do you see that?
A. I see that.
Q. And there are three paragraphs below that, right?
A. Yes, there are.
Q. Then there is a new heading, right?
A. Yes.
Q. Did those three paragraphs address "separate computing device"?
MS. HOEKEL: Objection.
A. No, they did not.

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Q. Did they address "separate monitoring device"?
MS. HOEKEL: Object to the form.
A. Again, looking at this page, no, they do not.
Q. You set forth a construction of "separate monitoring device" that is different than the plain and ordinary meaning in these three paragraphs?
A. I didn't hear your question, counselor.
Q. Sorry. I think we had two people speaking.
MR. CLAASSEN: Jennifer, were you objecting?
MS. HOEKEL: I was.
MR. CLAASSEN: I don't think that objection made it on to the record.
MS. HOEKEL: Because everyone keeps talking over each other.
So I'm objecting to the form.
I think if you reask the question,

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we'll start over.
MR. CLAASSEN: Great.
BY MR. CLAASSEN:
Q. So, Doctor, you notice -- you see these three paragraphs, right?
A. I do.
Q. Do you set forth a construction of "separate monitoring device" that is different than the plain and ordinary meaning in these three paragraphs?
(Pause)
A. I'm not still understanding the question.
Are you asking me: Is it a separate monitoring device being discussed in these paragraphs?
The answer is: No.
Q. You cut out when you leaned forward.
A. I'm sorry.
Q. So what was your response there?
A. The answer is: No.
Q. So if I were reading this petition, I

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would understand -- or a person of ordinary skill in the art -- would understand that your construction is plain and ordinary meaning, right?
A. Yes.
Q. Is your understanding of "separate monitoring device" different today?
A. No, it's not.
MS. HOEKEL: Object to the form.
(Pause)
BY MR. CLAASSEN:
Q. Would a person of ordinary skill in the art understand the word "monitoring"?
MS. HOEKEL: Object to the form.
A. The answer is: Yes.
Q. How would it be understood?
MS. HOEKEL: Object to the form.
A. Taken in the context of the specs, and the claims, and the file history for this particular patent, "monitoring" in this case implies physiological monitoring of a specific patient for different physiological parameters.

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Q. Does the '108 patent provide a definition of the word "monitoring"?
A. I'd have to look at the entire patent.
I believe they used a term "patient monitoring."
Q. My question is a little different.
Did the '108 patent define the word "monitoring"?
A. I believe it did.
Q. How did it do that?
A. In the context of patient monitoring.
(Pause)
Q. Let's take a look, then, at Exhibit 6, which was the '108 patent.
Do you see that that's been put up on the screen?
A. I see the certificate -- oh, here it is.
Q. Do you have a printed copy of that '108 patent that's Exhibit 1six?
A. Yes, I do.
Q. Where in the '108 patent does it

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define the term "monitoring"?
A. I'd have to take a moment and see if it did.
Q. Why don't you take a moment and do that?
You have a printed copy with you, right?
A. I have '735 out; get the '108.
Q. It's in a folder labeled: Exhibit 6.
(Pause)
A. Yes.
Q. Do you have Exhibit 6 in front of you?
A. Yes, I do.
MR. CLAASSEN: I'd like the court reporter to mark this Exhibit 6 for the record.
(Exhibit 6, Document Bates stamped MAS0000140 through 179, multipage document entitled: United States Patent No.: US 10, 213,108 B2, dated February 26, 2019, with cover page dated June 17, 2019, marked for identification)
MR. CLAASSEN: You are going to review

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that Exhibit 6 right now.
Is that right, Dr. Yanulis?
THE WITNESS: Yes, I would like to take a couple of minutes, if I can.
MR. CLAASSEN: Okay. Let's take a short break, and you can review that, and we'll come back.
THE VIDEOGRAPHER: The time is 4:24 p.m. Off the record.
(Recess from 4:24 p.m. to 4:30 p.m.)
THE VIDEOGRAPHER: The time is 4:30 p.m. Back on the record.
BY MR. CLAASSEN:
Q. Dr. Yanulis, we were talking about Exhibit 6, which is the '108 patent.
Right?
A. Yes, sir.
Q. You were looking for where it defines "monitoring."
Is that right?
A. Yes.
Q. What did you find?

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A. I did not find it actually defined.
What I found in the Background of the Invention -- column 1, line 37 -- referring to patient vital sign monitoring, which is same thing as physiological monitoring of different parameters, such as hemoglobin, SpO2, pulse rate, heart rate.
Then I'm looking on.
This patent spends more time discussing the communications adapter.
And I don't see an accurate -- I shouldn't say -- I couldn't find in the time that I had an actual definition of what they called "monitoring."
But they used the term "physiological -- vital sign monitoring" which, to one skilled in the art, would be physiological monitoring.
Most of the figures that I noticed refer to this so-called communications plug-in system.
Can you hear me okay?

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Q. I can.
Just don't want to speak over you. Just want to make sure you are finished with your response.
A. Yes, I am.
(Pause)
Q. Is it your opinion that, if the specification disclosed only the conventional bedside monitor, the claims cannot include anything more as a separate monitoring device?
MS. HOEKEL: Objection.
A. Could you repeat the question?
Q. Sure.
Is it your opinion that, if the specification disclosed only the conventional bedside monitor, the claims cannot include anything more as a separate monitoring device?
MS. HOEKEL: Same objection.
MR. CLAASSEN: What is the objection?
MS. HOEKEL: That it is as to form, and it is incomplete.
BY MR. CLAASSEN:

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Q. You can answer the question.
A. My response is: I'm going to answer this question as a biomedical engineer and not an attorney.
And I'm going to say the claims, as directed to the specs -- if the specs have been written any differently, I would have had different opinions.
But my opinions do not change based on what's been disclosed.
Q. What do you mean when you say "if the specs had been written any differently"?
A. I only have the patents. I have to go by what the spec says. I can't create specifications.
Q. So the claims limited to the specifications?
A. It has to be directed to the specifications in some way.
Q. What is your understanding of when a specification limits the claim?
A. Specification should include all the

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limitations of their system, what they are trying to do with the system, what they are hoping to accomplish with the system.

I'm not sure I understand your question, counselor.

Q. Does that include disclosing something a person of ordinary skill in the art would find conventional?

MS. HOEKEL: Object to the form.

A. Again, one skilled in the art would call this a conventional bedside monitor.

(Pause)

Q. Does the specification disclose that the conventional bedside monitor is a separate monitoring device?

(Pause)

A. My understanding and the way I viewed this is -- is they may be -- the only thing I see is this is a conventional bedside monitor.

I'm not going to add anything more than that.

Q. But does the specification say that

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the conventional bedside monitor is a separate monitoring device?

A. I'd have to look at the entire specs to answer that question.

Q. Did you do that?

A. Figure 1 is prior art.

(Pause)

Q. I asked a yes-or-no question.

Did you do that?

A. No.

Q. No, you did not do that?

A. I'm sorry. I didn't -- repeat the question?

Q. Let's go back to my question.

I had asked: Does the specification say that the conventional bedside monitor is a separate monitoring device?

A. No, it does not.

Q. How did you reach that conclusion?

A. Because the specs; and for one skilled in the art as I am, it is a conventional bedside monitor based on the specs.

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That's all I have is the specs that are available for me in this patent.

Q. You also have knowledge of ordinary person skilled in the art, right?

A. Again, that's why I said: For one skilled in the art, based on the way they have disclosed it, this is a conventional bedside monitor.

Q. I want to move on now and talk about the '994 patent and alarm condition. That's the next in the exhibit line.

A. Do want me to get that out, counselor?

Q. Sure.

Let's go back to Exhibit 1.

(Pause)

Q. We are going back now to that joint claim construction chart.

A. I apologize. It's going to take me a minute. I'm sorry.

Q. That's okay.

A. I have now got the joint hearing statement, which I believe is Exhibit 1,

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correct.

Q. That's correct.

Then if you move down into the chart in the back, the third term on -- beginning on page 11 -- the very bottom of page 11 --

A. Let me turn to page 11 first.

Q. Sure.

(Pause)

A. Yes, I see it. And I have got it in front of me.

Q. And you see that the disputed term is "alarm condition," right?

(Pause)

A. Give me a moment. I'm looking at the hard copy. I can discuss it from the chart here, save time.

Q. So you understand the third disputed term here is "alarm condition," right?

A. Correct.

Q. What is your understanding of Masimo's proposed construction of that term?

A. Masimo's -- I apologize.

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Masimo's construction implies "alarm condition," which is based on one criterion.

And Sotero's is based on multiple criterion.

Q. Okay. So let's scroll down now to page 12.

A. Okay.

Q. So you understand Masimo's construction is plain and ordinary meaning, right?

A. Correct.

Q. There is an alternate definition there, right?

A. -- yes --

Q. Dr. Yanulis, if you are speaking, you are not --

A. I'm sorry. Can you hear me now, counsel?

Q. Yes.

THE VIDEOGRAPHER: I'm sorry to interject, but any time you lean forward assume we may have issues hearing you.

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THE WITNESS: All right.

A. The alternate is Masimo's position. This term should be construed as a measurement of a physiological parameter that's outside certain limits.

Q. Do you disagree with that construction?

A. Yes. Well, no, I don't. I'm sorry. No, I don't.

Q. So you agree with Masimo's alternate construction?

A. Yes.

Q. You disagree with the plain and ordinary meaning construction?

A. Can I reanswer that question?

Q. Sure.

A. I disagree with the way it's written. It implies it's based on one criterion; whereas our position is that it's more than one alarm criterion.

Q. Okay, does the word "criteria" appear in Masimo's construction?

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A. No, it does not.

Q. So where are you getting criteria from?

A. My interpretation for one skilled in the art and looking at the specs as articulated --

MR. CLAASSEN: You are dropping off again --

THE WITNESS: All right. Let me bring it to my face. It is a lot easier.

A. The alarm criteria has to be satisfied before you have any kind of triggered alert.

And Masimo -- just that statement. I'm not changing my opinion on that.

Q. So I haven't gotten to your opinion yet, as far as I understand it.

I was asking if you agreed with Masimo's construction.

And at first, you said: Yes.

Then you said: Let me clarify.

A. The answer is: Yes.

Q. So you do agree?

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A. Yes.

Q. Okay.

Let's talk about Sotero's construction.

A. Okay.

Q. You see that in the right column there?

A. Yes.

Q. We're talking about Exhibit 1 on page 12 of the joint chart?

A. Right.

Q. That's: A patient condition that satisfies all alarm criteria resulting in a triggered alert.

Right?

A. Correct.

Q. What does "all" in "all alarm criteria" mean?

A. More than one criterion.

Q. Is two criteria "all"?

MS. HOEKEL: Objection.

A. "Criteria" implies plural of

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criterion, as far as my expertise.
Q. So what I'm trying to figure out now is what "all" means within the construction itself.
A. It could be the treatment times, as an example. It could be the type of patient who you are monitoring. It could also -- and I don't want to get into terms we haven't talked about here -- but it could talk about in terms of what's meant by -- for example, you can't just have something outside the limits. There also has to be other criterion applied before you have an alert triggered.
Q. What does "criteria" mean?
A. "Criterion" is one single element or one single variable or parameter.
You have to have more than one parameter with "criteria" in terms of what you are actually defining as; "all the criteria."
Q. You understand that "criteria" is not part of the claim, right?
MS. HOEKEL: Object to the form.

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BY MR. CLAASSEN:
Q. The words of the claim do not include "criteria," right?
A. Correct.
Q. They include "condition," right?
A. Right.
Q. Is "condition" singular or plural?
A. "Alarm condition" is singular in the claim -- in the claim.
Q. Understood.
So the introduction of the word "criteria" makes it plural, right?
A. Correct.
Q. Where does "criteria" come from in your analysis?
A. It comes from what parameters. It may be two, three -- but it's more than one criterion.
Q. Okay.
But you understand the claim language itself doesn't use the word "criteria," right?
A. Yes, I do, sir.

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Q. Masimo's construction doesn't include "criteria" either, does it?
MS. HOEKEL: Object to the form.
BY MR. CLAASSEN:
Q. It doesn't include the word "criteria," does it?
A. As far as Sotero, they satisfy all alarm criteria.
Q. So both the "all" and the "criteria" come from Sotero's construction, right?
MS. HOEKEL: Object to the form.
A. They come from the construction.
But I'm giving you -- if I could finish my statement -- as to the way the patent specs have been disclosed in combination with the figures, it's directed, to me, you have to satisfy all alarm criteria before you have a triggered alert.
Q. What are "all alarm criteria"?
A. Depends on how they are defined.
Q. Okay.
So you understand the purpose of claim

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construction, right?
A. Yes, I do.
Q. What is it?
A. The purpose of claim construction is to evaluate whether Masimo or defendant Sotero's claim construction are precise for purposes of such things as infringement, or moving other factors other than just invalidity.
Q. You understand that a jury has to understand the constructions, right?
A. But I do as well as an expert. I have to understand the difference in the terms as they have been agreed on by the two different parties -- or in other words, what's been stipulated.
Q. So if a juror is evaluating "all alarm criteria," what are they looking at?
A. Multiple parameters. Multiple parameters.
Q. Why didn't you say "multiple alarm criteria"?
MS. HOEKEL: Object to the form.

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A. Because I'm answering these questions from the perspective of someone skilled in the art. I may not have the same level of knowledge as the attorneys.
Q. So would "multiple alarm criteria" be a correct construction to a person of ordinary skill in the art?
A. You say "multiple alarm criteria," and my answer is: Yes.
(Pause)
Q. You see the claim language in the left column of page 12 of Exhibit 1?
It on the screen right now.
No?
A. Can you highlight -- I see on the left.
Can you highlight the claim language?
Okay. I see.
Q. You see that, right?
A. Yes, sir.
Q. And you see that the word "alarm condition" is -- or the phrase "alarm condition"

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is bold, right?
A. Yes.
Q. That's the term that's being construed, right?
A. Yes.
Q. And so "alarm condition" is for the physiological parameter, right?
MS. HOEKEL: Object to the form.
BY MR. CLAASSEN:
Q. Is that right?
Or wrong?
A. Correct.
Q. The physiological parameter refers to one parameter, right?
A. Yes.
Q. Did you consider that when you were evaluating Sotero's claim construction?
A. Yes, I did.
Q. How did it impact your analysis?
A. It did not change my opinions, as I discussed.
Q. So to satisfy alarm condition,

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multiple parameters need to be satisfied.
Is that right?
A. Let me rephrase that, because I think -- I'm saying one thing, and it's being implied in a different way.
What I'm saying is different criteria for that particular parameter have to be satisfied -- is what I'm saying.
I apologize if I'm confusing parameter with what kind of limits that you set for the alarm condition.
MS. HOEKEL: Dr. Yanulis, you have to back up or we can't hear you.
THE WITNESS: Oh, I'm sorry.
A. What I'm saying, counselor, is that -- and I want this in the record -- I'm saying the one parameter may be monitored, and you have an alarm condition for that one parameter.
Whether it be SpO2, or pulse rate, or whatever, you have to have certain criteria -- for example, what type of -- and I don't want to get into some of the terms, but -- lack of a

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better term -- what are all the criterion?, for example, treatment times as opposed to how you set those.
And until all those criterion are set, for example, for instance, what's your -- let's say you are monitoring pulse oximetry. You have to, first of all, set what your upper limit, lower limit. You also have to sort of set what -- what's the timing of when the alarm condition is triggered.
Does that make sense?
Q. No, but we'll talk about it some more.
A. Okay.
Q. So the SpO2 is an example, right?
A. The SpO2 is an example, yes.
I'm sorry. I interrupted.
Q. And that's a physiological parameter?
A. Correct.
Q. What would "all alarm criteria" be in the context of SpO2?
A. The threshold values before the alarm is triggered, the time in which they are

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triggered, based on your high and low.
I'm just going to leave that answer as is.
Q. Is that all of the alarm criteria for SpO2?
A. Other alarm criteria could be in terms of: Do you have a patient in heart failure? Or do you have a patient just going to the operating room for a normal elective procedure?
Obviously, the criteria are going to be set differently by the user clinician.
Q. That's all part of your understanding of "alarm condition," right?
A. It's giving an example of SpO2 based on how you would set the criterion before they are all satisfied, or how they should be satisfied before an alarm is triggered.
(Pause)
Q. Did the '994 patent specification define "alarm condition"?
A. Yes, it does.
Q. Where does it define "alarm

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condition"?
A. Give me a moment. I have to look at the patent.
Q. Okay. I think I provided that to you as an exhibit.
A. Yes, you did.
Q. It's Exhibit No. 8.
MR. CLAASSEN: We haven't pulled it out yet, but we'll take it out now.
THE WITNESS: And that's Exhibit 8, sir?
MR. CLAASSEN: Yes.
(Pause)
MR. CLAASSEN: The last three of the patents should be '994.
THE VIDEOGRAPHER: You want me to bring that up?
MR. CLAASSEN: Sure.
THE WITNESS: If you want -- it's just easier if I have it in my face.
MR. CLAASSEN: I agree.
THE WITNESS: I need to be able to

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answer, not waste time.
MR. CLAASSEN: So what's being shown on the screen now is Exhibit 8. We're going to mark that as Exhibit 8. It's a copy of the '994 patent.
(Exhibit 8, Document Bates stamped MAS0000180 through 284, multipage document entitled: United States Patent No.: US 10,255,994 B2, dated April 9, 2019, with cover page dated June 17, 2019, marked for identification)
BY MR. CLAASSEN:
Q. Do you see that?
A. Correct.
Q. I provided you a printed copy of that, right?
A. Yes, you did.
Q. Does that appear to be complete?
A. Yes.
Q. And you mentioned that "alarm condition" is defined in the '994 patent, right?
A. I'm trying to refresh my memory. Give

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me a couple of minutes, sir.
Q. Okay.
(Pause)
A. I'm referring -- on column 2, they are talking about: In some embodiments, a medical monitoring device or system capable of collecting physiological parameter data, and using the data to simulate a variety of alarm condition detection criteria and/or alarm notification delay times. This simulated alarm condition detection criteria and/or alarm notification delay times can be analyzed to alter the actual alarm condition.
Q. So you are now reading from the summary of the invention in column 2, right?
A. Yes, I'm reading -- but I'm looking very quickly to see if the term "alarm condition" is defined.
Q. In what you just read, is "alarm condition" defined?
A. Based on that, yes.
Q. Where?

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A. The term "alarm condition" is not defined explicitly, but I understand --
Q. Please lean back when you are responding so we can hear you.
A. It's not explicitly stated.
But as one is an expert, you have to set aside certain alarm criteria.
(Pause)
Q. Does it say "all alarm criteria"?
A. No.
Q. Does it say "multiple alarm criteria"?
A. It uses the term "detection criteria," and that to me implies plural, sir.
Q. Because it uses the word "criteria," it's plural.
Is that right?
A. Yes.
Q. And that impacted your understanding of the words "alarm condition," right?
A. I'm going to say that it doesn't define "alarm condition," period.
(Pause)

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Q. Does the '994 patent use the phrase "all alarm criteria"?
A. No, it does not.
Q. Does it use the phrase "all alarm conditions"?
A. No, it does not.
Q. Did you look for that?
A. Yes, I did.
But I also used my expertise to understand this invention to include multiple -- call it criterion, if you will.
Q. The specification does not use the phrase "all alarm conditions," right?
A. Correct. It just talks in terms of "alarm condition."
Q. I'd like to direct your attention now to column 39, about line 29.
A. Column 39 of the same patent, right?
Q. Yeah.
A. Give me a moment.
MS. HOEKEL: Did you say line 29?
MR. CLAASSEN: Yes.

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(Pause)
BY MR. CLAASSEN:
Q. So are you looking at column 39, line 29?
A. Yes, I am.
Q. Do you see the words "all alarm conditions"?
A. Not in this particular line, no.
But I am reading these can include alarm limits, alarm silence --
THE WITNESS: Yeah, thank you. I couldn't see --
MR. CLAASSEN: Keep zooming in, line 29, it's the left.
THE WITNESS: Yes.
(Pause)
BY MR. CLAASSEN:
Q. Do you see the words "all alarm conditions"?
A. Yes.
Q. Had you seen that before?
A. Yes.

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Q. What did you take that to mean?
A. All the conditions for that particular --
Q. Each and every condition, right?
A. Yes, yes.
Q. So there must be something less than "all alarm conditions," right?
MS. HOEKEL: Object to the form.
A. Counselor, I'm not sure how to answer that question. Could you repeat the question?
Q. Yeah.
There is a statement here that says "all alarm conditions," right?
A. Yes.
Q. Doesn't that imply there might be less than all alarm conditions?
A. Yes, it does.
Q. So the inventors knew how to use the word "all" when they meant "all," right?
MS. HOEKEL: Object to the form.
(Pause)
A. I'm not sure if the inventors had the

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same meaning or reading it the same way I did.
You are asking me how they used the word "all."
And I've told you -- maybe I have not expressed myself -- how I would interpret "all."
Q. So am I to understand you right that the inventors may have understood the claims to be different from how you understand the claims?
A. And that is my response, yes. That's where my skill in the art comes.
Q. Had you seen this use of "all conditions" before?
A. Yes, I have.
Q. Didn't you tell me earlier that the specification didn't use "all alarm conditions"?
A. Again, I did not remember the entire specification, sir. That's why I said I want to refer to the sections.
Q. But this isn't some kind of a strange memory test, right?
MS. HOEKEL: Objection to form.
BY MR. CLAASSEN:

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Q. This is actually cited by Sotero in support of its construction, right?
A. I'm not sure what you are asking me, sir.
Q. I'm asking you: Is this section cited in support of Sotero's construction?
A. No, they used the word "all" right there.
Q. Okay.
So this section of the specification is not cited in support of Sotero's construction, right?
A. No.
Q. Let's go back to Exhibit 1.
A. Give me a minute.
Which page, counselor?
Q. Page 12, the one we were just talking about.
(Pause)
A. Page 12.
Q. Can you see there is intrinsic evidence that's identified below Sotero's

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proposed construction?
A. Could you read that line again?
I'm looking at page 12, and I'm looking at: Defendants' Proposed Construction.
Q. Okay. So defendants' proposed construction -- you understand the defendants include Sotero, right?
A. Yes, sir.
Q. So the proposed construction is listed.
Then there is a list of intrinsic evidence, right?
A. Correct.
Q. And there is a citation there to column 39, lines 23 to 31, right?
A. Yes.
Q. What we were just talking about, right?
A. Yes.
Q. That used the phrase "all alarm conditions," right?
A. Remembering what the spec said, yes.

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Q. Does the claim recite "all alarm conditions"?
(Pause)
A. I'm going to say "all," but I may need to go to the claim itself.
Q. Let's take a look at the claim itself. It's on the left there.
Go to the claim itself.
A. It's saying "an alarm condition."
Q. Is that "all alarm conditions"?
A. No.
Q. It's just one, right?
A. Yes.
(Pause)
Q. Earlier we were talking about Masimo's construction, right?
A. Correct.
Q. What is your understanding of Masimo's construction?
A. We are talking about one physiological parameter -- for example, pulse rate -- that -- in terms of being outside set limits.

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Q. So you are talking about the alternate construction, right?
A. Yes.
Counselor, I don't see the word "alternate."
I just see to the extent this term should be construed.
Q. Okay.
Do you not understand that that's a construction in addition to the plain and ordinary meaning?
A. Yes.
Q. So it's an alternate, right?
A. Yes, I apologize. I'm not an attorney.
Q. That's okay. I just want to make sure we are speaking the same language.
So what do you disagree with in this construction?
A. I don't agree with the preciseness. I think it lacks preciseness and not directing to all the alarm criteria the way I have read the

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specs and my expertise in the area. That's where I disagree.
Q. "All alarm criteria" is precise enough for you?
A. I think the defendant has precised it -- has defined -- has made it more precise. And that's what we are talking about, the preciseness of the terms.
Q. But we also talked about multiple, right?
A. Yes.
Q. The multiple would probably be more precise than "all," right?
A. Yes, I will agree to that.
Q. What's the difference between "alarm criteria" and "alarm condition"?
A. The way the courts have defined "alarm condition" are just calling it one alarm. An alarm going -- I'm not sure I understand the question. I can look --
Q. You are saying the courts have defined "alarm condition"?

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What are you talking about?
A. I'm saying the courts have said: When an alarm condition is detected for a parameter and it delays a notification of alarm condition until the alarm condition persists for a predetermined alarm notification delay.
Q. I'm really confused here.
What courts are you talking about?
A. I'm reading the claim language on the left.
Q. Okay.
So you are talking about the -- there is nothing to do with the courts having construed anything, right?
A. Yes.
Q. So what you are talking about is the column on the left, the claim language?
A. Yes.
Q. Okay.
What about the claim language are you talking about?
A. I'm just reading the claim language as

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the courts have articulated.
Q. What are you talking about when you say "the courts"?
A. I don't know. I don't know because I'm not sure -- let me finish, sir -- I don't know if you are talking about Masimo's proposed construction, or the defendants', or you are asking me the claim language.
The term is "alarm condition" -- period.
Q. Okay.
So my question is: What is the difference between an alarm condition and alarm criteria?
A. There is no difference.
But the way the specs have been written, it's directed for satisfying all the alarm criteria, in my expert opinion.
That's all I'm saying.
Q. There is no difference between alarm criteria and alarm condition, right?
A. No --

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Q. And we talked about earlier that "criteria" --
MS. HOEKEL: Object to the form, mischaracterizes.
BY MR. CLAASSEN:
Q. -- is a plural word, right?
We talked about earlier that "criteria" is a plural word, right?
A. Yes.
Q. "Condition" is a singular word, right?
A. Yes.
Q. So there is at least one difference between the two terms -- right? -- two words, right?
A. Yes.
Q. Are there any other differences?
A. The alarm condition has to be based on something --
Q. Does the criteria --
A. -- either one --
Q. -- also have to be based on something?
MS. HOEKEL: Objection.

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You may --
A. Yes --
MS. HOEKEL: -- answer.
You guys are talking over each other again.
And Dr. Yanulis, make sure you finish your answer and please wait until Mr. Claassen has finished his question.
THE WITNESS: I need to shut off my phone. Just a second.
MR. CLAASSEN: Let's take a five-minute break.
THE VIDEOGRAPHER: The time is 5:09 p.m. Off the record.
(Recess from 5:09 p.m. to 5:18 p.m.)
THE VIDEOGRAPHER: The time is 5:18 p.m. Back on the record.
BY MR. CLAASSEN:
Q. Before the break, we were talking about "alarm criteria" and "alarm condition," right?
A. Correct.

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Q. We were talking about one of the differences being that "alarm criteria" is plural and "alarm condition" is singular, right?
A. Correct.
Q. Are there any other differences between "alarm criteria" and "alarm condition"?
A. No.
Q. You submitted an IPR declaration in support of a petition on this patent as well, right?
A. Yes, I did.
MR. CLAASSEN: What I sent you is Exhibit 9. And I'll ask the videographer to pull that up for us now.
THE WITNESS: Thank you.
BY MR. CLAASSEN:
Q. Do you see that document?
A. Yes, I'm looking at the IPR document, which I submitted, April 9, 2019.
Q. This is your declaration, right?
A. Yes, it is.
Q. It is for the '994 patent?

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A. Yes.
MR. CLAASSEN: I'd like the court reporter to mark this as Exhibit No. 9.
(Exhibit 9, Multipage document entitled: Declaration of George E. Yanulis in Support of Petition for Inter Partes Review of U.S. Patent No. 10,255,994, dated June 11, 2020 (no Bates Nos.), marked for identification)
MS. HOEKEL: I'd just like to have the same objection to this declaration that I had to the previous ones -- that it is beyond the scope of the deposition testimony that Dr. Yanulis is here to give today.
BY MR. CLAASSEN:
Q. Okay. On page 23, there is a section that starts "Claim Construction" that's now up on the screen.
Can you see that?
A. Yes, sir, I can.
Q. The next page, there is a section that says "alarm condition."
Do you see that?

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A. Yes, I do.
Q. So you provided an opinion on the construction for "alarm," right? -- sorry -- "alarm condition," right?
A. If I'm reading it correctly, counselor, I provided the meaning of the two terms "alarm condition" and "alarm notification" --
Q. Are you reading ahead in Exhibit 9?
MS. HOEKEL: Object to the form.
BY MR. CLAASSEN:
Q. So what I'm looking at right now on the screen is Exhibit 9, page 24.
Do you see that?
A. Yes.
Q. I'm not asking if you provided any construction on other terms.
But did you provide an opinion on the construction for "alarm condition"?
A. I did.
(Pause)
Q. This section goes on for a couple

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pages.
Is that right?
A. Correct.
Q. I'd like to focus on paragraph 48. That's on the next page and continues now on to page 26. So that's all of paragraph 48 is now up on the screen on two pages.
Can you read it this way, when it's two pages?
A. I'll be happy to. The line starts out: I understand that in co-pending --
Q. Sorry. I don't want you to read it aloud.
I'm just asking if you can read it.
A. Oh, I apologize. I'm sorry.
Q. So it's legible to you?
You can read what's on the screen?
A. Yes.
Q. So in this paragraph 48, you describe Sotero's system, right?
A. Yes, I did.
Q. What is the relevance of Sotero's

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system to claim construction?
MS. HOEKEL: Object to the question -- to the form of the question.
BY MR. CLAASSEN:
Q. You can answer the question.
A. Would you repeat your question? Because I was looking at the line.
Q. Yeah.
So you are looking at paragraph 48, right?
It talks about Sotero's system, right?
A. Correct.
Q. And this is in your claim construction section, right?
A. Correct.
Q. And it's in your claim construction section for "alarm condition," right?
A. Correct.
Q. That's the term we are talking about for the district court also, right?
A. Yes.
Q. So my question to you is: What is the

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relevance of Sotero's system in the construction of alarm condition?
MS. HOEKEL: Object to the form.
A. It was relevant that I was defining no alarm exists until all alarm criteria are satisfied, including expiration of the pre-alarm delay period of time.
Q. What does have that to do with construing the claim?
MS. HOEKEL: Same objection.
A. We are not talking about construed claim.
Q. We are not talking about construction for "alarm condition"?
A. We are talking about the construed terms.
But in the IPR, all I'm discussing is whether this patent was invalid based on the prior art.
Terms really mean nothing in terms of other than making sure that I am looking at using the standard for looking at claim terms.

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Q. Did you construe "alarm condition" based upon how Sotero's device operates?
A. No.
I construed it on the way that I read the specs in this particular patent to read.
Q. The spec mentioned Sotero's system?
MS. HOEKEL: Object to the form.
A. No, it does not.
Q. So what are you referring to in this paragraph 48?
A. I was referring to an example. For one skilled in the art this: Is this way this alarm condition -- function?, based on what I --
Q. Go ahead.
A. -- based on what I saw in the specs for this particular patent.
Q. When you are talking about "this alarm condition," you are talking about the claimed alarm condition, right?
A. Correct.
Q. What are you talking about when you mentioned Sotero's system?

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(Pause)
A. I'm, sort of, augmenting why I took the opinion as being divergent, and as it pertains to the Sotero system, as it applies to alarm condition, and what my understanding of that means in view of the specs and the prior art.
Q. What software are you talking about in Sotero's system?
A. Referring to the software that is proprietary to Sotero for their particular alarm condition analysis, if you will.
Q. Where does that software run?
MS. HOEKEL: Object -- again I'm going to object to this line of questioning as irrelevant.
Q. You can answer the question.
A. I'm not sure how to answer it, counselor, because I'm basically discussing it in terms of what I saw in the specs for this particular patent, and the prior art, and my skill in the art. Not sure how else to answer.

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Q. But you were looking at Sotero's system when you did that, right?
A. Yes, I did look at Sotero's system, only from the sense of understanding what -- to my suspicion was that their alarm -- or their system is basically the same as what is known in the art.
Q. What software were you looking at?
MS. HOEKEL: Same objection.
A. I was not looking at the specific software because I didn't need to. I knew what software needed to do, which is analyze the physiological data obtained and determine whether an alarm condition had occurred or had exceeded a threshold -- nothing more, nothing less.
Q. You made conclusions about Sotero's system here, right?
A. I'm not making conclusions.
I'm commenting on my understanding of how Sotero's device works as far as satisfying all alarm criteria before you have the three

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alarm and, like, period of time expiring.
Q. And you put that under claim construction for "alarm condition," right?
MS. HOEKEL: Excuse me. I didn't hear the question.
BY MR. CLAASSEN:
Q. You put that analysis under the section for claim construction of "alarm condition," right?
A. In the IPR, I did.
Did you put up the exhibit for the terms?
Q. Wait. Are you now asking to go back to Exhibit 1?
A. Yes, I'm asking to go to Exhibit 1.
Q. What are you looking for in Exhibit 1?
A. Articulating what my opinions were in the so-called construed understanding of this particular term -- "alarm condition."
I mean, it's not necessary. But --
Q. In performing the claim construction for the IPR purposes, you referenced Sotero's

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system, right?
A. Yes, I did.
Q. And you can't tell me what software you looked at, right?
A. I did not look at the specific software --
Q. But you --
A. -- I said --
Q. -- say "software analyzes."
Right?
A. May I finish my response, sir?
Q. Go ahead.
A. What I said -- I did not look at the specific software because it's proprietary and I didn't need to.
I understand as an expert that it's analyzing the physiological data obtained -- or the measurements obtained -- is what I said.
Q. Was that based upon a representation of counsel?
A. That's on my expertise.
Q. Okay.

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So did you look at software that Sotero provided to you?
A. No, I did not.
Q. So how can you say that software analyzes the physiological data?
A. For this type of system, you as an expert, would know that's what the software is doing.
Q. Is that relevant to the construction of "alarm condition"?
A. No.
(Pause)
Q. Let's go back to Exhibit 1 like we were talking about, and we'll move on to the next term.
A. Okay. Page 13, right, counsel?
(Pause)
Q. We were on page 13. I would like to move forward, then, to page 14.
So you see there is another term starting there -- "alarm delay or suspension period of time"? --

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A. Yes.
Q. -- right?
A. Yes.
Q. You do not offer an opinion that this term is indefinite, right?
A. No.
Now, wait a minute. I do.
Q. Okay.
Where is that?
(Pause)
A. The statement that I made under either proposed constructions: Plaintiff's proposed construction gives rise to additional bases of invalidity.
Q. Are you reading above the line now?
You see there is a line at the bottom of page 14 that -- so this is a chart, right?
A. Right.
Q. And there is "alarm delay or suspension period of time."
Do you see that?
A. Oh, I'm sorry. You are talking about

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the two -- my apologies.
Q. Now we are moving on to this term, right?
You understand that?
A. Yes.
Q. So we are talking about "alarm delay or suspension period of time," right?
A. I'm with you.
Q. Okay.
You don't offer any opinion that this term is indefinite, right?
A. No, no opinions. I don't think it's -- go ahead.
Q. Is there something more you needed add to that response?
A. I would like to see the rest of page 15, if I can.
Q. Sure, go ahead.
It continues on to 16 --
A. And as I expected, no, I had no problems calling this term indefinite.
I just wanted to see the rest.

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Q. That response was -- I think I understood it, but I want to make sure -- you do not offer any opinion that this term is indefinite.
Right?
A. For the court record, the term is not indefinite -- in my opinion.
(Pause)
Q. Sotero's construction is listed in the right-hand column, top of page 14?
MR. CLAASSEN: I'll ask the videographer to go back up.
BY MR. CLAASSEN:
Q. Do you see that?
A. I do.
Q. What is that construction?
A. Without reading it aloud, I have read it.
Q. Okay.
So it's a period of time in which an active alarm is paused, right?
A. Yes.

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Q. Did you apply that construction in your IPR declaration?
MS. HOEKEL: Object to the form, object to relevance.
BY MR. CLAASSEN:
Q. Did you apply that construction in your IPR declaration?
MS. HOEKEL: Same objections.
(Pause)
A. I'm not ignoring you, counselor. I'm thinking about my answers --
Q. Would you like to --
A. -- give me a moment --
Q. -- the IPR declaration?
A. Right.
Q. Would you? --
MS. HOEKEL: He asked if you would like to see your IPR declaration.
THE WITNESS: Yes.
MR. CLAASSEN: Okay.
BY MR. CLAASSEN:
Q. Exhibit 11 is the declaration for --

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your declaration for the '244 patent.
Is that right?
Do you see it on the screen?
A. Correct.
Q. In this declaration, you set forth opinions on claim construction for the patent, right?
A. Yes, I did.
Q. So if we go to page 22 of that declaration --
MR. CLAASSEN: And I'd like that marked as Exhibit 11, please.
(Exhibit 11, Document Bates stamped MAS0021498 through 21678, multipage document entitled: Declaration of George E. Yanulis in Support of Petition for Inter Partes Review of U.S. Patent No. RE47,244, dated May 21, 2020, marked for identification)
BY MR. CLAASSEN:
Q. Do you see this section labeled: Claim Construction?
A. Yes, I do.

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Q. Did you set forth any opinion on claim construction with respect to "alarm delay or suspension period of time"?
MS. HOEKEL: Object to the form.
(Pause)
A. Yes, I did.
And what I also added on line 45: The "alarm delay or suspension" must be limited to what is taught in the specifications.
So I was relying on the specification.
Can I read -- can I see page 23?
Q. Sure.
A. The important term here is "active alarm." The alarm has to be occurring.
And that's what I was trying to point out in this particular section.
(Pause)
Q. So what is your understanding of the correct construction for "alarm delay or suspension period of time"?
A. Before you can have either, you have to have an active alarm occurring.

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(Pause)
Q. And that's from the phrase "active alarm delay or suspension period of time."
Is that right?
A. No.
But -- what I'm trying to say -- this is why I wrote it -- that the alarm has to be occurring before you have either of those conditions occurring.
Q. Why do you say that?
A. Because that's what the spec tells me.
Q. Is that what the claim tells you?
A. No, that's what the spec tells me, and my understanding of one skilled in the art for this particular aspect. You have to have an active alarm occurring.
Q. You understand that there is a separate claim element for "activates an alarm," right?
A. Yes.
Q. What is the difference between that "activate an alarm" and the active alarm in

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"alarm delay or suspension period of time"?
A. There is no difference.
Q. Then why does the claim say "activate an alarm"?
A. I'm implying or stating there has to be some user input. And that user input occurs after the alarm is already occurring.
Q. Where is the user input in this claim?
A. It's not in this section, sir.
Q. Do you want to go back to the claim itself?
A. Yes, I'd like to see the claim.
Q. Would it be most helpful for you to see it in the context of patent specification?
Or do you want to go back to Exhibit 1?
A. Probably be best to see it in Exhibit 1.
Q. Let's go back to Exhibit 1, then.
(Pause)
Q. Now, this is the end of the claim that we were talking about, and I was just talking

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about this "activate an alarm."
Do you see that?
A. Yes.
Q. So just to be clear now, we are talking about the '244 patent claim 1, right?
A. Correct.
Q. And you mentioned: User input.
Right?
A. No, I misspoke when I said it.
All I was saying is the alarm has to be occurring.
I misspoke.
Q. But you said it, but you misspoke?
A. I misspoke based on the way the question was asked, because you -- I'm having trouble understanding you switching from the IPR to what the purpose of me discussing the claims terms being disputed.
They are two different things.
Q. Same claim, right?
A. What's in the claim?
Q. The same claims are involved in the

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patent lawsuit in the district court and in the IPR, right?
A. Yes.
Q. So what's confusing you about switching?
A. I'm just rearticulating my focus and purpose for writing the IPRs versus my understanding of explaining why I believe Sotero's construction is correct.
I'm not confused --
Q. If Sotero's construction is correct, didn't you have a duty to disclose that to the Patent Office?
MS. HOEKEL: Object to the form.
A. I believe I said early in the record that the claim terms are invalid for both parties in the IPR.
What's important in the IPR and what my goal and task -- and I believe accomplish that -- is saying: This particular patent was invalid based on the prior art and my expertise in the art.

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I did not -- again, the claims are invalid for both parties in the IPR.
Q. "For both parties" -- you mean under either construction?
A. Correct.
Q. Did you explain that to the Patent Office?
MS. HOEKEL: Object to the form.
A. No, not directly.
(Pause)
A. May I add to that?
Q. Go ahead.
A. In this declaration, I discussed whether this patent was invalid.
Q. When you say "this declaration," now, you are talking about Exhibit 11, which is your declaration regarding the '244 patent IPR, right?
A. Yes, sir. That's all.
(Pause)
Q. So you were construing the claims for purposes of evaluating invalidity in the IPR,

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right?
A. Correct.
Q. Are you construing them for a different purpose in the district court?
A. In the district court, I'm also concerned not just with invalidity; I'm also concerned with infringement.
Q. Shouldn't the same claim construction apply in both the IPR and the district court?
MS. HOEKEL: Object to the form.
(Pause)
A. My purpose for writing the IPR declaration was to support my contention that the patent is invalid based on prior art -- nothing more, nothing less.
Q. In the district court, your contention is something slightly different.
Is that what you are implying?
MS. HOEKEL: Object to the form.
A. I didn't say that, sir.
I said: My purpose for the IPR declaration is different than my -- our

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discussion today to discuss the disputed terms.
They are not the same exercise.
Q. The claim construction process is not the same exercise in the IPR and the district court?
MS. HOEKEL: Object to the form.
A. I don't know how else to say it than to repeat it -- that the claim construction as discussed in the IPR for both parties has not really been my focus.
The focus was to prove that the patent for the purposes of the patent board was invalid based on the prior art, my expertise, file histories, and nothing else -- and the file histories and nothing else.
Q. But you need the claim construction to perform that analysis, right?
A. Yes.
(Pause)
Q. Further down in Exhibit 1, there is a little more discussion about how defendants may rely on you.

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Are you familiar with that?
A. Yes, sir.
Q. I'd like to move, then, down to page 21 of Exhibit 1.
You see there, it begins: Defendants may rely on Dr. Yanulis?
A. Yes, I do.
Q. And that continues on to the next page, right?
A. Yes, sir.
MR. CLAASSEN: So let's move down to page 21. We can just -- page 22 is sufficient.
That was more for the videographer than it was for you.
THE WITNESS: No, I understand.
BY MR. CLAASSEN:
Q. You see there where it says: Understand -- and I'm assuming this is the person of ordinary skill in the art would understand?
Is that right?
Or do I need to go back up --

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A. Correct.
Q. You mention: Scope of the '244 to be limited to pausing an active alarm.
Do you see that?
A. Yes, sir, I do.
Q. Then you say: E.g. silence or pausing the active alarm?
A. For example.
Q. Okay. For example.
And is that for example describing the entire pausing an active alarm?
A. I'm just saying that, in order to pause an alarm which is already occurring, it requires user input to actually cause the alarm to be paused.
Q. Does it say anything about user input here?
A. No. But for one skilled in the art, he should understand that, for the alarms that are already active, you have to apply some type of user input --
Q. Why does it have to be a user input?

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I'm sorry. I stepped on your answer there.
Do you have more to add?
A. There has to be some kind of user input to pause or silence this alarm.
Q. That's all from "alarm delay suspension or period of time."
Is that right?
A. Yes.
Q. For example, silence or pausing the active alarm -- you see that?
A. Yes.
Q. Does that add any more than "silence" to "pausing an active alarm"?
A. It's still user input. You are either silencing it or pausing it. But it's for active --
Q. -- though, does it? --
A. Would you repeat your question?
Q. This doesn't say anything about user input, does it?
A. No.

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Q. It not here on this page anywhere, right?
A. No.
Q. So why would this disclose that this step required some sort of user input?
A. How else would you pause it, sir?
Q. Automatically.
Is that possible?
A. It's possible, but that's not the way the specs read --
Q. Isn't --
A. -- it's not the way --
Q. -- does it --
A. You could have another user input, like Alexa's, or something like that.
Q. What I'm trying to understand, Dr. Yanulis, is why you are so literal when you are reading the patent specification, but I'm supposed to be not so literal when I'm reading your analysis on this page?
MS. HOEKEL: Object to the form.
Q. Do you understand my concern here?

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It doesn't say anything about a user here.
A. That's the purpose of our discussion, to agree on the preciseness of these terms.
And I don't agree with Masimo's preciseness. I agree with my preciseness based on my skill.
Q. You continue on: The specification does not support alarm pre-alarm delays.
Do you see that?
A. Yes.
Q. What did you mean by that?
A. I'm saying the claims, to be more precise, should include alarm delay or suspension time based on the specification that I've read.
Q. Wait a minute.
Doesn't it say the specification does not support alarm pre-alarm delays?
Right?
A. That's why I don't agree with Masimo's position.

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Q. This is Sotero's position, right?
A. All I'm referring to in this section is, in order to understand the scope of the invention, it has to be limited to pausing an active alarm.
Q. That's in part because the specification does not support alarm pre-alarm delays, right?
A. Correct.
Q. Is that a lack of written description argument?
MS. HOEKEL: Object to the form, calls for a legal conclusion.
BY MR. CLAASSEN:
Q. How is it relevant to claim construction?
A. Other than the way I answered it, I'm referring to my expertise as a medical device engineer, not an attorney.
So I'm not sure how to answer that question other than the way I have.
Q. Where do you get the phrase "alarm

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pre-alarm delays"?
A. Because in the specs, it recites the use of pre-alarm delays. And it's not supported by what that is in the specs.
Q. I have a very basic question for you.
Does the specification support alarm pre-alarm delay?
MS. HOEKEL: Object to the form.
A. No, it does not.
Q. Your answer just before this last question was: Because the specs it recites the use of pre-alarm delays.
Right?
MS. HOEKEL: That's not his complete answer. Please read his complete answer if you are going to quote his answer back.
Q. It continues: And it's not supported by what is in the specs.
So I'm trying to understand which way you are arguing here.
A. I'm arguing that you have an active alarm, and there has to be some input to delay

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it or suspend it.
Q. It doesn't say anything about an input in this --
A. No, it does not, sir.
But as an expert, I'm adding what one skilled in the art would mean this to be, or what it should be supported by.
Q. Are there limits to what a person of ordinary skill in the art can add to a claim?
A. I didn't hear your question. I'm sorry.
Q. Are there limits to what a person of ordinary skill in the art can add to a claim?
MS. HOEKEL: Objection, calls for a legal conclusion.
A. I'm not sure I understand the question. And I'm not sure I can answer it, other than what I've given.
Q. It continues on here saying: Does not support parameter-specific pre-alarm delays.
Do you see that in Exhibit 1?
A. Yes, sir.

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Q. What are you referring to there?
A. Now you are talking about the fact that I said the specs not support parameter-specific pre-alarm delays.
That's all I'm saying.
Q. Do you remember what construction you applied for this term in your IPR declaration?
A. Plain and ordinary meaning.
Q. Is that similar to Masimo's construction?
A. Yes.
Q. Is it the same?
A. Is it the same for what?
Q. Is the plain and ordinary meaning the same construction that Masimo applies to this term?
A. I don't agree with Masimo's proposed construction.
Q. That's what you proposed in the IPR declaration, right?
MS. HOEKEL: Object to the form.
(Pause)

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Q. Do you understand the question?
A. Yes.
Q. Can you answer it?
A. I believe I've answered it, sir. I'm saying that the specs do not support parameter-specific pre-alarm delays.
Q. That's not my question.
My question is: Did you apply the same construction that Masimo proposes now in your IPR declaration?
A. Yes, I did.
Q. Let's move on, then, to the next term, the "one or more processors" term. And that begins on page 23 of Exhibit 1, the joint claim construction chart.
Do you see that?
A. Yes.
Q. Is it your opinion that this term is a means-plus-function term?
A. Yes -- well, function and structure.
Q. What was your response, again, Dr. Yanulis?

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Is it your understanding that this term is a means-plus-function term?
(Pause)
A. I'm saying this term are -- I am using function and structure for the way the processors are configured.
Q. Do you know what a means-plus-function term is?
A. Not to the same extent as an attorney would.
Q. Do you have any understanding of what a means-plus-function term is?
A. Means-plus-function is the -- the means is the method -- they are kind of the same thing.
Q. Kind of the same thing as what?
A. They are the same thing in my understanding.
Q. What are the same thing?
A. Means-plus-function describes the process that's occurring.
(Pause)

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Q. Do you understand that there is a difference between a structural claim element and a means-plus-function claim element?
A. Yes, I do, sir.
Q. What is the difference?
A. The function is basically a method that accomplishes what that structure does, or it describes what the process is accomplished by that structure or element.
Q. What about this limitation makes it a means-plus-function limitation?
(Pause)
A. If I'm reading this -- the one or more processors configured to electronically ... determine that the measurement of the parameter satisfy an alarm activation threshold.
Q. What about that makes it means-plus-function?
A. Describing the means by how it's done.
Q. What's "the means" here?
A. The processor.
Q. Can a processor ever be sufficient to

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denote structure by itself?
MS. HOEKEL: Object to the form.
A. No.
Q. Never?
A. I didn't say never.
Q. I'm asking: Never.
A. No -- repeat the question.
Q. Can a processor ever be sufficient to denote structure?
A. It can be.
Q. When does it denote structure?
A. I didn't hear the last part, sir.
Q. When is a processor structure?
MS. HOEKEL: Object to the form.
A. When it's defined in a specific unit, subunit, or whatever, from the figures and specs.
Q. Let me ask this question a little more simply.
When a patent uses the word "processor" -- you are familiar with that concept? --

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A. Yes.
Q. -- does that mean that whatever function the processor performs is going to make that claim limitation means-plus-function?
MS. HOEKEL: Object to the form.
A. From my understanding, I would say: Yes.
(Pause)
Q. Could a processor be sufficient structure to compare a value to a limit?
MS. HOEKEL: Object to the form.
A. It depends on how it's disclosed in the specs.
Q. You'd have to read the specification to tell?
A. Which is what I did while reading this chart.
Q. So how did you determine that this processor claim limitation recited a means-plus-function term?
A. I guess I don't understand your definition of "means-plus-function," sir.

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Q. So you don't know what a means-plus-function term is?
MS. HOEKEL: Object to the form.
A. The way you are asking me, sir, I don't understand.
Q. Let me use a different term and see if you understand that.
Do you know what 112(6) is?
A. Yes.
Q. What is it?
A. From my limited understanding and background, it pertains to the function.
Q. When does 112(6) apply?
A. I'm not privy to all the conditions.
Q. Are you privy to the conditions that apply to this particular term?
A. Yes.
Q. What makes this term 112(6)?
(Pause)
MS. HOEKEL: Going to have the same objection, calls for a legal conclusion.
A. I'm not sure how to answer it, sir.

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Q. Do you have an answer?
A. I'm not sure how to answer because I'm not an attorney. I'm looking at this from an expert evaluation. I'm not privy to all the facets of 112(6).
Q. So did the attorneys tell you that this term was 112(6)?
A. Yes, they did.
Q. Did you rely on that representation from the attorneys?
A. I relied on that.
But I also relied as to what has been disclosed in specs, as far as function and structure.
So I relied on both.
(Pause)
Q. Do you think that 112(6) is the correct construction for this term?
A. In my understanding and limited understanding, yes.
Q. Did you use that construction in your IPR declaration?

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A. Yes.
Q. You did?
A. No.
Q. Did you?
Or didn't you?
A. Did not.
Q. Did not.
So you did not use that construction for your IPR declaration, right?
MS. HOEKEL: Same objections to relevance, and this is not being a memory test.
A. I don't remember.
MR. CLAASSEN: Let's pull up what was previously marked as Exhibit 11.
BY MR. CLAASSEN:
Q. Do you remember looking at this Exhibit 11?
A. Yes, I do.
Q. And this is the declaration that you wrote for the IPR for the '244 patent, right?
A. Correct.
Q. And you set forth positions on claim

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construction in this declaration, right?
A. Yes, I did.
MR. CLAASSEN: Let's go to page 22 through 23.
BY MR. CLAASSEN:
Q. Do you see that section labeled: Claim Construction?
A. Are you referring to opinions of claim construction starting on 43?
Q. Or the heading "Claim Construction" above that, yes, also --
A. Yes.
Q. Okay.
Do you see that?
A. Yes.
Q. So we are talking about Exhibit 11 on page 22, Claim Construction.
You see that, right?
A. Yes.
Q. Do you set forth any opinion about means-plus-function terms on these two pages?
MS. HOEKEL: Objection.

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MR. CLAASSEN: What's the objection? Are you continuing? --
MS. HOEKEL: My objection is partially the continuing objection, and also that it is vague and incomplete.
BY MR. CLAASSEN:
Q. Do the words "means-plus-function" appear on these two pages of your declaration?
A. I'm taking a moment just to read the entire page.
Q. Go ahead.
(Pause)
A. Okay. I've read it.
Q. Do the words "means-plus-function" appear in this section?
A. No.
Q. Does "112(6)" appear anywhere in this section?
A. No, it does not.
Q. So there is no opinion in your IPR declaration under a means-plus-function construction, right?

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A. Other than I've given the terms plain and ordinary meaning.
Q. Okay.
So you gave the terms plain and ordinary meaning, right?
A. Correct.
Q. Isn't that Masimo's construction for the "one or more processors" term?
MS. HOEKEL: In the lawsuit?
MR. CLAASSEN: I won't limit it to that.
A. That was going to be my answer, by the way: In the lawsuit.
Q. So your response is: In the lawsuit?
A. Yes.
Q. So you understand that Masimo's construction of this term is plain and ordinary meaning, right?
A. Correct.
Q. And that's the same construction you set forth in your IPR declaration, right?
A. Yes.

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Q. Going back to your Exhibit 1, Sotero also proposed an alternative construction, right?
A. Can we go back to that?
Q. Yeah.
Actually, before we go down to the alternative construction, I have a couple of questions for you to follow up on the structure that you opine on.
So on page 23 of Exhibit 1 -- Exhibit 1, the joint chart?
(Pause)
Q. So you see the bottom of page 23 there where there is some structure identified?
A. Yes.
Q. Did you help identify that structure?
A. No. I just gave opinions.
No. The answer is: No.
Q. What opinions did you give about that structure?
A. I didn't give any opinions in this particular district court construed. I haven't

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written any opinions yet on it, other than understanding and explaining why I agreed with the proposed construction and evidence.

Q. But you've looked at this structure, right?

A. Yes.

Q. Is this the minimum structure required to perform the function?

A. Yes.

Q. Does it need all of what's disclosed in Figure 3?

A. Yes.

Q. Does it need all of what's disclosed in Figure 4?

A. I don't know Figure 4. I have to look at Figure 4.

Q. There is Figures 3-4 in the --

A. Oh, okay.

Q. You got it?

A. Yes.

Q. So does it require all of Figure 3?

A. No.

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Q. No?

A. No, it does not.

But I'm trying to finish my answer for what you had asked me, sir.

Q. Go ahead.

A. What I was also saying that -- why I take the position, agree with the position, you are satisfying a program to activate an alarm upon determination. And you are waiting until you have satisfied an alarm activation threshold.

Q. What is your understanding of what structure has to be disclosed for a 112(6) claim element?

MS. HOEKEL: Object to the form.

A. The term "active alarm" -- alarm already has to be occurring -- before you can --

Q. Do you need any other structure, other than the active alarm?

A. No.

Q. Just an active alarm?

A. When I say "active alarm," I'm

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implying it's already occurring -- either visually or auditory.

Q. That's for determining that the measurement of the physiological parameter satisfies an alarm activation threshold, right?

A. Yes.

Q. Now, in the next page -- page 24 -- there is an alternative construction.

Do you see that?

A. Yes.

Q. Do you agree with that construction?

A. As far as defendants? Yes.

Q. As far as defendants.

Is that what you said?

A. Yes, sir.

(Pause)

Q. So this claim limitation requires "resulting in the activation of an alarm," right?

A. Correct.

Q. And you understand that there is a separate claim limitation for "activate an

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alarm," right?

A. Yes, I do.

Q. But this alternative definition is precise enough for you, right?

A. Yes.

(Pause)

Q. Let's move on to the next claim limitation. That's on page 33 of Exhibit 1, the joint claim construction chart.

MS. HOEKEL: We have been going about an hour again, so whenever you get to a good breaking point.

MR. CLAASSEN: This is a very good breaking spot. We are starting a new term.

How much time would you like?

MS. HOEKEL: Ten minutes just to stretch legs, get a drink.

MR. CLAASSEN: That sounds good.

THE VIDEOGRAPHER: The time is 6:15 p.m. We are off the record.

(Recess from 6:15 p.m. to 6:22 p.m.)

THE VIDEOGRAPHER: The time is 6:22

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p.m. Back on the record.
BY MR. CLAASSEN:
Q. Dr. Yanulis, we are moving on to this next claim element. We are now talking about "electronically initiating."
Do you see that on your screen, Exhibit 1, page 33, of the joint claim construction chart?
A. Yes, I do.
Q. What's your understanding of Sotero's construction for this claim limitation?
A. My understanding is that you are pausing this first alarm for a period of time or particular parameter in response to user input from a user, or request from a user.
Q. Did you use that construction in your IPR declaration?
MS. HOEKEL: Objection.
Q. This is the same patent we have been talk about -- right -- the '244 patent?
A. I'm not trying to hedge the answer.
I think the best answer was: To some

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extent.
But, again, the IPR was more of an exercise to look at invalidity. This is looking at potential infringement.
Q. So a different claim construction should apply.
Is that right?
A. No, same claim -- I'm sorry -- same claim construction.
It's just I'm trying to identify and support why defendants' construction is correct, why I don't agree with Masimo.
Q. So you don't agree with Masimo's, right?
A. Not in this proposed construction of this claim, no.
Q. And Masimo's construction is plain and ordinary meaning, right?
A. It is.
But then you mention: The first parameter-specific alarm delay.
And my contention is I don't agree

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with that the way they proposed this construction of this term.
Q. What are you talking about right now?
A. Talking about the: Electronically initiating, using the patient monitoring device, the first parameter-specific alarm delay or suspension period of time.
Q. So that entire phrase, Masimo proposes plain and ordinary meaning, right?
A. Up to the point that they haven't included in my opinion pausing --
Q. That's not my question.
My question is: Masimo proposes plain and ordinary meaning, right?
A. I don't agree with the term "initiating."
Q. I'm not asking if you agree with it.
I'm asking if Masimo proposes the plain and ordinary meaning.
A. Yes, they do.
Q. Isn't that what you proposed in your IPR declaration?

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MS. HOEKEL: Same objection.
A. In the IPR, yes.
Q. So you proposed the same construction that Masimo proposes in the district court, right?
MS. HOEKEL: Same objection.
A. Not to the extent that they have construed the claim --
Q. Now you are talking about to the extent the court concludes the construction of "initiating is necessary," right?
A. Yeah. I have problems the way they say: Of "initiating" is necessary.
I think that's --
Q. What does "initiating" mean to you?
A. To begin.
Q. Isn't that what this says -- the term should be construed as "beginning"?
A. It should also incorporate having some kind of user input.
Q. "Initiating" should have user input?
A. Yes, to be more precise.

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Q. How does a user electronically initiate?
A. He -- why I have set up and why I agree with the proposed construction of Sotero, I say you have to have an actual action where you are actually pausing or holding some button.
(Pause)
Q. Where does it say anything about a button in this construction from Sotero?
A. I'm implying as an expert.
It would have to be some kind of button, or it could be something else, so long as you have user input.
I should just limit to that.
Q. What would the "something else" be?
A. You could have an electric system.
Q. Explain what you mean by that.
A. You could set up an electric system to cause pausing or suspend particular actions.
Q. Could a user do that with a mouse?
A. Yeah.
Q. Could a user do that with a keyboard?

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A. Yes.
Q. Would that be a button?
A. I'm sorry?
Q. Would that be a button?
A. Yeah -- I mean, you could -- any type of -- I'll just say any device.
Q. So if a user input a parameter, would that satisfy your "something else"?
MS. HOEKEL: Object to the form.
A. The user input would have to be some kind of physical act, whether it be user pressing a button, keyboard, or whatever, or an Alexa system doing it. They all would do the same thing. They pause their first alarm for a period of time.
Q. This is the second claim term that uses the construction pause, right?
A. In Sotero's position.
Q. Right.
So Sotero proposes pause for multiple claim terms, now, right?
A. Correct.

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Q. Does the '244 patent use the word "pause"?
A. No, it does not use that particular word.
Q. You've tried to incorporate it into two different constructions now, right?
MS. HOEKEL: Object to the form.
A. I think there is a difference -- I don't agree with the way Masimo proposes to initiate this action.
Q. We are talking about pause now.
A. Yes.
Q. So you are trying to insert the word "pause" into the claims, right?
A. I guess I am.
Q. Trying to do that in two places, right?
A. Yes.
Q. That word "pause" doesn't appear in the specification at all, right?
(Pause)
A. Not the direct word "pausing," no.

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But there is some action that causes this response of stopping the alarm. There is something. And there are several ways of doing it.
Q. I asked you earlier, but I'm not sure I understood your answer.
Did you apply Sotero's construction in your IPR declaration?
MS. HOEKEL: Same objection.
Q. Do you understand the question?
A. I do. I'm just thinking about the appropriate answer and the correct answer.
As an expert, I did consider that.
But, again, the IPR, I was looking more at the prior art as far as invalidating, not to the level of this terminology that's being construed.
So, no.
But I did concern myself with understanding what it means.
Q. You construed a different conclusion in the IPR, right?

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MS. HOEKEL: Object to the form.
A. Yeah -- the IPR was written for a different -- call it -- goal or reason. And it was primarily directed for invalidity.
Here we are talking about terms that are being disagreed -- we are trying to find the best precise terminology, trying to get some agreement. That's the purpose of this exercise.
Q. And that's not the purpose of claim construction in the IPR process, right?
MS. HOEKEL: Objection.
A. I wasn't concerned with claim construction, other than applying the standard of plain and ordinary meaning. It was a much broader -- whereas I was -- my intent, as I said before, was to support my evidence that the prior art, in my expertise, invalidates the patents.
Q. But you didn't perform that analysis using Sotero's construction, right?
MS. HOEKEL: Object to the form.
A. What I looked at is the specs, file

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history, and my knowledge of these particular systems in supporting my claim -- or supporting my contention -- that the prior art basically invalidated the patent.
Q. In performing that analysis, you did not use Sotero's proposed construction, right?
MS. HOEKEL: Object to the form.
A. No, not directly.
I was relying on prior art, and the specifications in the patent, and my knowledge of that particular device.
(Pause)
THE WITNESS: Are you guys hearing me okay?
MR. CLAASSEN: Yes, thank you.
(Pause)
MR. CLAASSEN: On this Exhibit 1, let's turn now to page 40.
(Pause)
BY MR. CLAASSEN:
Q. Do you see there is some description of your proposed testimony in this district

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court case at the top of the right-hand column on page 40?
A. Are you referring to parameter-specific alarm delay?
Q. That's the top of that column, yes.
But you see the first full sentence there that says: Dr. Yanulis may explain?
A. Yes.
Q. And it says: That the '244 Patent only supports pausing of an already activated alarms in response to user input.
Right?
A. Correct.
Q. How does that relate to claim construction?
A. Well, the patent does not support the parameter-specific pre-alarm delay. So that's what I'm having some concern about -- parameter-specific pre-alarm delay.
Q. How is that relevant to claim construction?
A. Because the parameters specific are

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not -- they are not parameter-specific the way that the specs have been written, as far as understanding the scope of the invention.
Q. I want you to focus now on that one sentence.
I don't see anything about "parameter-specific" in that sentence.
Dr. Yanulis may explain that the '244 patent only supports pausing of already activated alarms in response to user input.
Do you see that?
A. Yes.
Q. That doesn't say anything about "parameter-specific," right?
A. No, but it does in the next line.
Q. Okay, we'll get to the next line in just a minute. I want to talk about this first sentence first to make sure I understand it --
A. Okay.
Q. -- okay?
How is that sentence -- only supports -- the specification only supports

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pausing of already activated alarms in response to user input -- relevant to claim construction?

A. Based on the way the specifications have been disclosed, it's only supporting an already active alarm or, in other words, alarm that's already going off.

Q. Do you understand the phrase "written description"?

A. Yes.

Q. What does that mean to you?

A. Written description --

MS. HOEKEL: Object to the form.

A. -- implies a discussion in view of specs, the figures, explaining what their invention is -- in other words, what are they trying to do.

Q. Is this sentence talking about written description?

Or is it talking about claim construction?

MS. HOEKEL: Object to the form, calls for legal conclusion.

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A. Well, I can't speak about from a legal perspective.

But from an expert in this case, I can discuss the fact that I'm looking at the scope of the invention in view of the way the specifications are written, in combination with the claims and my expertise for one skilled in the art.

(Pause)

Q. Does the '244 patent only support pausing of already activated alarms -- and forget the rest of the sentence?

So I want you to break up the sentence now.

Does the '244 patent support pausing already activated alarms?

A. In my opinion, yes.

Q. So the focus of this sentence is really on "in response to user input," right?

A. As it's written, yes.

Q. Where did you get that from the specification?

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A. Well, without reiterating the whole specification, in order to have the proper construction in terms of the way the specification has been disclosed, it has to, in my opinion, require pausing an already activated alarm, or an alarm that's already occurring.

Q. But we have talked about the specification discloses that part.

A. Right.

Q. Now let's talk about that user input.

A. In response to the user input, that was the last part.

Q. Right.

And those are in conjunction with one another, right?

A. Yes.

Q. So where did you get the "in response to user input" portion of your opinion?

A. I was looking at the inventive scope of the device, of this particular patent in terms of how they defined or disclosed the alarm systems.

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Q. So "the inventive scope of the device"?

Is that right?

A. No -- the scope of the invention, as disclosed in the patent.

MR. CLAASSEN: Sorry. You are leaning forward, so we can't hear.

THE WITNESS: I'm sorry.

A. The invention as disclosed in the specs.

And my contention is that it only supports -- the way it is written -- pausing an already existing alarm.

Q. And a person of ordinary skill in the art wouldn't understand any other sort of electronically initiating, right?

MS. HOEKEL: Object to the form.

A. I didn't say that.

Q. I'm asking you now.

A. Finish your question, counselor. I want to make sure I understand it completely.

Q. How would a person of ordinary skill

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in the art understand "electronically initiating"?

A. It would articulate to me that the alarm is already occurring, and that requires some kind of response to stop it, if necessary.

Q. Why does that response have to be from a user?

A. It doesn't have to be. That's why I alluded to -- it could be terminal, could be a mouse pad, or button.

Q. Then moving down to that last sentence in Exhibit 1, page 40.

And now we are talking about: Dr. Yanulis may explain that the '244 Patent does not support parameter-specific pre-alarm delays.

Do you see that?

A. Yes, sir.

Q. Does that mean anything more than it says?

A. Yes, it does. The scope of the patent -- the so-called parameter-specific pre-alarm delays are not parameter-specific as

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far as being pre-alarm delays.

Q. Can you explain what you mean by that?

A. The pre-alarm delays, from my skill in the art reading the specs, does not convince me that these -- these pre-alarm delays are parameter-specific.

Q. What is a pre-alarm delay?

A. Something that occurs before you have the alarm actually actively occurring. There is a period of time that you set for delaying.

Q. When does the pre-alarm delay start?

MS. HOEKEL: Object to the form.

BY MR. CLAASSEN:

Q. You said it's a period of time, right?

A. Yes.

Q. When does the period of time start?

MS. HOEKEL: Object to the form.

A. After the alarm has started or is occurring.

Q. What does it mean for the alarm to start?

A. You actually see some kind of visible

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or auditory signal going off that the clinician can view.

Q. And that's a pre-alarm delay, right?

A. No, sir.

Q. What is that?

A. I'm saying: There is no such -- in my understanding, I don't agree with the term "parameter-specific pre-alarm delay."

I don't think that's a proper construction, and it's not supported in the specs.

Q. Where are you getting pre-alarm delay from the claims?

A. Not getting it from the claim per se.

I'm saying that the patent has not properly supported the fact that you have to have an actively occurring alarm. I'm saying that's what's lacking.

And to claim it as such is not proper.

Q. Where does Masimo claim the pre-alarm delay?

MS. HOEKEL: Object to the form.

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BY MR. CLAASSEN:

Q. At the end of your response was: And to claim it as such is not proper.

Right?

A. No.

I'm saying without -- actually providing discussion of some kind of pause in the claim would make it complete and precise. It's not precise as the claims are written.

Q. Okay.

We have talked about our disagreement as to "pausing," right?

A. Right.

Q. So now I want to talk to you about pre-alarm delays.

A. Again, I'm not viewing it as just pre-alarm delays.

I'm viewing it parameter-specific pre-alarm delays.

Q. Before we even get to parameter-specific, I want to know where pre-alarm delays comes in.

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Where does pre-alarm delay enter your analysis in this claim?
A. I'm saying the patent in its entirety does not support it. Again, I'm referring to the --
Q. Is that relevant to the construction of this claim term?
A. Yes, it is.
Q. How?
A. It's relative to the way the claims are written, based on what's been disclosed in specs --
Q. And where --
A. -- what is not --
Q. Go ahead.
A. What I was starting to say: It matters as far as what's in there or not in there as far as supporting the specs as written.
You can write claims, but it may not be a proper discussion for purposes of our discussion here in terms of what's written in the specs.

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That's all I have is the specs and the claims. I have nothing else -- and my skill, of course.
Q. Okay, the patent doesn't say anything about blue moons either, right?
A. Correct.
Q. And blue moons aren't recited anywhere in the claims, right?
A. The patent itself only supports the pausing of already existing alarms.
Q. Okay. So we've talked about pausing. I understand our disagreement on pausing --
A. Right.
Q. -- okay?
Now I want to talk to you about pre-alarm delays.
A. And I'm saying it's not supportive. There is not enough information of being parameter-specific.
Q. How is that any different than blue moons?
MS. HOEKEL: Object to the form.

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A. It does have some importance when you are discussing the claim terms that's used and written -- so, yes.
Q. Which term in this claim -- the '244 patent claim 13 -- which claim term references "pre-alarm delay"?
A. I'm doing this from memory.
The claims, as discussed, articulate parameter-specific pre-alarm delays.
And I'm not -- I'm saying that's not supported in the specs.
Q. The words "parameter-specific alarm-delay" -- I see that.
Now what I'm focusing on is "pre-alarm delay."
Where are you reading in the claim limitation to include "pre-alarm delay"?
MS. HOEKEL: Objection, asked and answered.
MR. CLAASSEN: It hasn't been answered.
BY MR. CLAASSEN:

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Q. Go ahead.
A. The pre-alarm delays are not parameter-specific. And I have not been convinced that they are parameter-specific.
Q. Are the alarm delays parameter-specific?
MS. HOEKEL: Object to the form.
A. The alarm delays may be, but the pre-alarm delays are not.
Q. Did the claim require pre-alarm delays?
MS. HOEKEL: Object to the form.
A. I'm not sure how else to answer the question.
Q. It's a yes-or-no question.
Does the claim require pre-alarm delays?
MS. HOEKEL: Under whose construction? It's not a yes-or-no question.
MR. CLAASSEN: Under either construction.
A. Again, the patent does not support

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parameter-specific pre-alarm delays.
Q. I'm looking at Sotero's construction.
It doesn't say: Pre-alarm delay.
MS. HOEKEL: Can we go back to page 33, so he can see the term in the constructions? Because we are not on the right page.
THE WITNESS: Thank you.
MR. CLAASSEN: Okay.
BY MR. CLAASSEN:
Q. The third column in Exhibit 1, page 33 -- does it say anything about pre-alarm delay?
A. No, it does not.
Q. So the middle column with Masimo's construction -- does it say anything about pre-alarm delay?
A. No, all it talks about is parameter-specific alarm delays.
Q. So what is the relevance of pre-alarm delay to the construction of this term?
A. Including the whole term, not just alarm delays, but pre-alarm delays are not

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parameter-specific.
You want me to explain what I mean by that?
Q. Yes.
A. Parameter-specific, in my understanding, is just that particular parameter.
But when you add the term -- parameter-specific is -- I have no problem with that.
I have a problem with parameter-specific reading later, as far as parameter-specific alarm delays.
It is pre-alarm, that's where I'm having a problem. The phrase "pre" is bothering me.
Q. Where are you getting the phrase "pre"?
That's what I'm asking.
A. I'm not getting it in this. I'm getting it in the following section.
Q. What section is that?

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A. We just read it.
We talked about pre-alarm delay, didn't we?
Or did I miss something?
Q. Okay. You have a copy of Exhibit 1 in front of you?
A. Right.
Q. Somewhere, right?
A. Yes.
Q. Do you have the hard copy of it?
A. Yes.
Q. Okay. So will you turn to page 33?
A. Be glad to.
Q. The joint claim construction chart?
A. I have that right now. So you want me to refer to page 33 on here.
Q. I want you to start on page 33.
And I want you to tell me where you are seeing pre-alarm delay.
A. I am not seeing it.
Q. It's not in the claim, is it?
A. No.

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Q. It's not in either construction, is it?
A. Correct.
Q. So what does it have to do with the construction of "electronically initiating"?
A. It has to do with applying some kind of user response.
Q. Okay.
You have a separate sentence on user input, right?
A. Yes.
Q. And that's on page 40 that we were talking about earlier?
A. Let me go back to page 40.
(Pause)
A. You want me to start with: Alternatively, a common silence button? --
Q. No, page 40 of the chart --
A. I'm sorry. I was looking at 41. I'm sorry.
Q. Okay. So page 40 of the chart --
A. Right.

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Q. -- right?
A. Correct.
Q. You see there is a sentence that we have been talking about, about: Dr. Yanulis may explain that the '244 patent does not support parameter-specific pre-alarm delays.
Right?
A. Correct.
Q. And that is different sentence from user input, right?
A. Correct.
Q. So pre-alarm delays is not talking about user input, right?
A. Correct.
Q. What is it talking about?
A. Could you repeat the question? I'm not sure I'm following what you are saying.
Q. I don't understand your last sentence in this chart --
A. What I'm saying --
Q. -- does not support parameter-specific pre-alarm delays.

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What I don't understand is: Where does "pre-alarm" come from?
(Pause)
A. Because the way this patent is defined and disclosed, it talks about parameter-specific pre-alarm delays.
Q. This sentence says: This specification does not support.
A. Right. I'm saying it doesn't. It lacks that.
Q. It lacks that, right?
A. Yes.
Q. What about pre-alarm delays is relevant to the claim?
A. The fact that pre-alarm delays and my expertise are not parameter-specific.
Q. Does the claim require pre-alarm delays?
A. If you are writing the claims in view of the patent specs, yes.
Q. So if you re-imagine what the claims say, it would say: Pre-alarm delays.

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Is that right?
MS. HOEKEL: Object to the form.
A. I would be more comfortable if there was more discussion to convince me that the pre-alarm delays are parameter-specific.
Q. Again, my basic question is: What pre-alarm delays are you talking about?
A. The period of time you are actually delaying the -- doing any kind of actions to the alarm -- it's already occurred.
Q. When does that period of time begin?
A. Once the alarm has been -- gone off, whether it be auditory or visual.
Q. So the alarm has to be active.
Is that right?
A. Well, I'm not sure how to answer this.
My understanding that you have to have a pre-alarm delay to -- once you have a pre-alarm delay, then that could -- that causes a -- what you call -- the term is an "alarm alert," or whatever you want to call it.
Q. That refers to some period of time

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before the alarm is activated.
Is that right?
A. Correct, before you have some actual active alarm.
Q. Is that concept recited in this claim?
(Pause)
A. Go back to the previous page. Let me read that, please.
Q. Go back to page 39, please, on Exhibit 1?
MS. HOEKEL: I think he means the claim language.
MR. CLAASSEN: Do you want to go up to the top, Dr. Yanulis?
THE WITNESS: Yes, if I can.
MR. CLAASSEN: All right. Let's go back then to page 33.
BY MR. CLAASSEN:
Q. We are there.
Do you see that?
A. Yes, sir.
Q. Is this what you were looking for?

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A. Yes.
Q. And we are looking at claim 13 of the '244 patent, right?
Okay.
And where is the concept of pre-alarm delay claimed inside claim 13?
A. It's not.
Q. So why is it relevant to the construction of "electronically initiated"?
A. Because there has to be some kind of user input -- cause --
Q. Because user input -- that also satisfies the pre-alarm delay.
Is that right?
A. Yes.
Q. Okay. Let's move on then to the next term, which is "alarm hold initiator."
(Pause)
THE WITNESS: Do we want 41?
MR. CLAASSEN: I believe. So hold on just one second.
Actually, yeah, let's start at page

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40, just to be very clear.
MS. HOEKEL: There are page breaks throughout this document.
BY MR. CLAASSEN:
Q. So there is a page break here at the bottom of page 40.
Do you see that?
And we are talking about the term "alarm hold initiator"? --
A. Correct.
Q. -- right?
Sotero's construction of that term is indefinite, right?
A. Correct.
Q. What's your understanding of indefiniteness?
A. It's not clear as to what the alarm hold initiator is doing.
Q. Not clear?
A. It's not clear to someone skilled in the art.
I know what an alarm hold initiator.

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But the way it's been disclosed and claimed, it's indefinite and there is not enough information to understand what this alarm hold initiator is doing.
That's why it's indefinite -- why I agree with that.
Q. Would a person of ordinary skill in the art know what an alarm hold initiator is?
MS. HOEKEL: Object to the form.
A. They would.
But they would also want to know: How does that alarm hold initiator function in terms of the claim, looking in view of the specs?
They want both aspects.
Q. But they would understand the words "alarm hold initiator," right?
A. Yes, sir, they would.
Q. Sotero has an alternative construction here, right?
A. Are you looking now at 41?
Q. Let's go down to page 41 of Exhibit 1.
Do you see the alternative

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construction?
A. Yes.
Q. You see that the construction is a common silence button, right?
And it continues down from there?
A. Correct.
Q. What does "other suspend initiator" mean?
A. It doesn't have to be a silence button. It could be some other device for actually silencing the alarm.
I don't mean to repeat the word "silencing."
But you want to stop the alarm, so there has to be some user input, whether it be a button, terminal, mouse pad -- has to be something.
Q. So my confusion here is that the common silence button seems to refer to the initiator, right?
A. As far as the alternate position that Sotero is taking.

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Q. And the "other suspend initiator" -- that uses the word "initiator" in it, right?
A. Yes.
Q. So what you have done is replace "alarm hold" with "other suspend," right?
A. Right.
Q. Would a person of ordinary skill in the art understand that substitution?
A. Yes, they would.
Q. So if the specification said "other suspend initiator," that would let a person of ordinary skill in the art know what an alarm hold initiator is, right?
A. Correct.
(Pause)
Q. Is there a difference between pausing and holding?
A. "Pausing" to me as an expert would imply that you are just momentarily stopping an alarm from continuing.
Whereas a "hold," you may want to see if the condition rectifies. A clinician would

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understand that you want to see if the condition worsens or doesn't worsen.
Q. Is there any difference in terms of length of time with respect to pausing and holding?
A. Yes. Pausing is just you do it on and off.
Whereas hold, you could have different time frames -- for example, treatment periods.
(Pause)
THE WITNESS: Did you hear me okay?
MR. CLAASSEN: I did.
BY MR. CLAASSEN:
Q. So if the term were "alarm pause initiator," would a person of ordinary skill in the art understand that?
MS. HOEKEL: Object to the form.
A. They should.
But, again, it has to be viewed in the context of the way the specs are written.
Q. So in view of the specification for the '249 patent, would a person of ordinary

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skill in the art understand "alarm pause initiator"?
MS. HOEKEL: Object to the form.
A. Could you zero in a little bit more about the question?
Are you asking me: If I was skilled in the art, would I understand what an alarm hold initiator is?
Q. No.
Would you -- would a person of ordinary skill in the art understand what an alarm pause initiator is?
A. He should. You are initiating a pause, so you should understand that. Or you are commencing a pause, you are hitting something, you are hitting some device or system to stop the alarm.
Q. Is it triggering a time?
A. When you pause it? No.
Q. When you hold it?
A. If you hold it, you are sort of waiting to see if the condition, as I said,

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worsens or gets -- it improves.
(Pause)
MR. CLAASSEN: Dr. Yanulis, would you like to take another short break, maybe five minutes or so?
THE WITNESS: No, I'm good.
MR. CLAASSEN: Okay.
THE WITNESS: I appreciate you asking, though.
MR. CLAASSEN: If you would like to take any more breaks, just let me know. I understand it's later for you than it is for me.
(Pause)
MR. CLAASSEN: Let's turn now to page 45 of Exhibit 1.
(Pause)
BY MR. CLAASSEN:
Q. Do you see the second-to-last sentence there describing your potential testimony in this case?
A. When you say "I may testify" -- that a person of ordinary skill would understand the

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concept of suspending an active alarm --
Q. Correct.
A. -- using a common silence button?
Q. You say "a common silence button," right?
A. But would not understand how a common silence button is more specific than an alarm hold initiator would be "accessed," as claimed.
Q. Right.
But you skipped over something there.
There is a parenthetical, right?
A. I'm sorry.
Saying that is -- wouldn't understand how a common silence button, based on the way the specs are written, could be accessed or -- you want me to --
Q. "I.e." -- what's your understanding of what "i.e." means?
A. Oh, I'm sorry.
That is.
Q. That is.
Right?

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A. Yes.
Q. So an alarm hold initiator is a common silence button, right?
A. Yes.
Q. You understood that from the specification, right?
A. Yes.
But I did not understand how it could be accessed from the specification -- is what I'm saying -- as claimed.
Q. But you understand that the term that we are asking the court to construe is "alarm hold initiator," right?
A. Yes, I do.
Q. And that's the very phrase that you used in this i.e., right?
A. Yes.
Q. And it's a common silence button, right?
A. Correct.
Q. So how is the term indefinite?
A. From the specs, I don't understand how

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this is achieved, or how it could be initiated -- or whatever term you want to use -- the way the specs have been written.
Q. But the words "alarm hold initiator" are understandable, right?
A. Yes, sir.
Q. You didn't rely on an indefinite construction for the IPR, right?
A. No, I did not.
Q. Is that because you can't present an indefiniteness argument in an IPR?
MS. HOEKEL: Object to the form.
A. Other than to say that I'm only applying the standard of plain and ordinary meaning, and the prior art -- whether it invalidates or doesn't invalidate.
Q. You applied the construction that Masimo proposes, right?
A. I'm sorry?
Q. You proposed the construction in your IPR that Masimo proposes in the district court, right?

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A. Am I accepting it?
Q. Did you accept it?
A. No. That's the purpose of our discussion.
Q. Okay.
So in your IPR declaration, what did you propose as the construction for "alarm hold initiator"?
MS. HOEKEL: Same objection.
A. Are you talking about the extrinsic?
Or intrinsic?
Q. I'm talking about the IPR declaration.
A. Yes.
Q. Did you apply the plain and ordinary meaning for "alarm hold initiator"?
A. To the extent that the IPR related to discussing the invalidity of the entire patent, yes.
Again, I want to repeat that, in the IPR, I wasn't concerned about the way the claims were construed by either party --
(Pause)

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A. Again, maybe I haven't made myself clear.

The exercise of the IPR being written was to discuss the potential invalidity of the patent based on prior art and my knowledge for one skilled in the art.

I wasn't concerned about the construed claims because I regarded them as being invalid for both sides.

Q. Did you start with the position that the claims were invalid?

MS. HOEKEL: Object to the form.

A. No, I would never make that statement.

I would base it on the art that was used to support my arguments in the IPR.

Q. But presumably somewhere in the prior art, you found an alarm hold initiator, right?

A. Something very similar that functioned like that.

But, again, I wasn't really concerned with that term in isolation.

I was concerned about what the patent

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was disclosing, and the claims, and was that invalid in view of prior art that I had discussed.

(Pause)

Q. Do you consider Sotero's alternative construction in preparing your IPR declaration?

MS. HOEKEL: Object to the form.

A. Could you repeat the question, counselor?

Q. Yeah.

So we talked earlier about Sotero's alternative construction, right?

A. Okay.

Q. Is that correct?

A. Yes.

Q. You remember us talking about that?

A. Yes.

Q. Did you consider that construction in preparing your IPR declaration?

A. As far as it applies to plain and ordinary meaning, nothing more.

Q. So is your view that Sotero's

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alternative construction -- the plain and ordinary meaning -- of the term "alarm hold initiator"?

A. It's more precise in this proceeding than it was required in the IPR.

They weren't concerned with the preciseness of different construed terms, other than plain and ordinary meaning, or using that standard.

Q. Plain and ordinary meaning was enough for you to understand what an alarm hold initiator was, right?

A. Yes --

MS. HOEKEL: Object to the form.

A. -- to the level of detail that I was concerned in the IPR.

This is different.

Q. Is it your opinion that it is different?

Or were you informed that it was different by counsel?

MS. HOEKEL: Object to the form.

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A. I was informed by counsel.

But I also understand from an expert's perspective for one skilled in the art what would be more accurate, based on the specs as written and as claimed.

Q. The more accurate constructions are set forth in the district court.

Is that right?

A. Yes. More precise use of the term.

(Pause)

Q. Let's move on to the last term, then. That's "tail." That's on page 53 of Exhibit 1.

Does a person of ordinary skill in the art understand what "tail" means?

MS. HOEKEL: Object to the form.

A. I would have to answer: I was viewing the way "tail" was discussed in the specs and how it was claimed.

Q. Have you overheard the word "tail" outside the context of the patents?

A. No, and I don't --

Q. No --

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A. -- not in this context, I have never heard the word "tail" used.
Q. When you say "not in this context," what do you mean some?
A. In the context the way they discussed the tail.
And part of the problem with the term "tail" -- in the patent specs, I can specifically articulate it stated the following -- and this is in reference to the "tail" being substituted for the cable.
You didn't show it to me. You didn't tell me. You told me what it wasn't. And I didn't see tail in the figures.
I meant in that context.
Q. Does the claim system require electricity?
A. For this particular patent, yes.
Q. Is electricity disclosed in the specification?
A. You are turning some circuit on, so in that regard, yes.

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Q. Is the word "electricity" used in the specification?
A. You are -- I'm using it in the context you are turning something on, so electricity is flowing, electrons are flowing.
I'm not sure what else you are asking.
Q. Would a person of ordinary skill in the art understand "electricity"?
MS. HOEKEL: Object to the form.
A. He should understand it's the flow of electrons to create circuit activation, yes.
Q. But a person of ordinary skill in the art would not understand the word "tail," right?
A. No, I didn't say that, sir.
I said: I've never seen the word "tail" used in this type of art -- what I said.
Q. Let me ask the reverse then.
Would a person of ordinary skill in the art understand the word "tail"?
MS. HOEKEL: Object to the form.
A. In the context that this "tail" was written in the specs.

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And I don't know what it is, because you haven't shown me. You haven't told me what it is.
Q. So a person of ordinary skill in the art would not understand the word "tail."
Is that right?
A. That's not what I said, sir.
I said, to repeat myself: The term "tail" is not a recognizable term that I'm familiar with.
I understand the word "cable."
You told me that it's not a cable, so why is it not a cable? I don't know.
I know what a cable is and I know what a tail is.
But in the context of the patent specs, I do not understand what they mean by "tail."
Q. Okay.
What does a "tail" mean outside of this context?
MS. HOEKEL: Object to the form.

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A. If you are talking about a tail, it could be very broad. You could be talking about the tail of a dog, tail of a cat.
Q. How about the tail of a mouse?
A. All right, tail of a mouse.
Q. What about the tail of a computer mouse?
A. Never heard it in this context.
Q. If someone referred to the tail of a computer mouse, would you understand what that meant?
A. I would.
But I'm skilled in the art and a little more -- than a lot of people, as you have articulated.
The way it's been disclosed, I don't understand why -- what the tail is.
I can't emphasize enough. I don't know what it is.
You have told me what it's not. You have told me it's not a cable. But you haven't shown it to me, so I have no idea.

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Q. Presumably you found a tail somewhere in the prior art in your IPR declaration, right?
A. In some of the prior art, yes, I did. That term was used.
But you I asked me, if I am understanding your question: Is this a term I've seen in the art, and that I've used?
And the answer is: No, I've used -- not used this term.
Q. My question is a little bit different.
In the IPRs, were you able to find prior art that satisfied the "tail" limitation of this claim?
A. For the purposes of the IPR, yes.
Q. What did you find?
A. I'm sorry?
Q. What did you find?
MS. HOEKEL: Object to the form, beyond the scope of the deposition, relevance.
A. I'm not sure how to answer, other than I've already answered it, sir.
Q. You found something in prior art that

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you contend is a tail, right?
A. Yes.
Q. How did you make that determination?
A. Based on the way the specs were disclosed, I understood what the function of the tail was, as written in the context of plain and ordinary meaning for the IPR from the broadest sense, using the construct of standard -- or plain and ordinary meaning -- but no further --
Q. Okay, wait a minute --
A. -- it's not --
Q. -- go ahead.
A. It's not a precise term, sir, that I have seen used in the art.
But I did see it in prior art that I discussed in the IPRs.
Q. When you are talking about "the broadest sense," what do you mean?
A. Talking about a tail to me would be some kind of attachment, some kind of connection.
That I do understand, in terms of the

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IPR declaration.
Q. So you understood tail to refer to some sort of attachment or connection, right?
A. As it applies to invalidating the patent, as written, supported by the prior art, yes.
Q. Was it your understanding that a tail is any different from a wire?
MS. HOEKEL: Object to the form.
A. In the context of the IPR --
MR. CLAASSEN: Lean back, Dr. Yanulis. We can't hear you any more.
THE WITNESS: Oh, I am sorry.
A. In the context of the IPR, yes.
But in the context of this district court proceeding, I don't agree. And I contend that it's indefinite the way it's been disclosed in this particular patent -- or patents -- excuse me -- '623 and '108.
Q. You considered the figures when you were looking at the construction of the term "tail"?

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A. Yes, I did.
Q. How did the figures impact your analysis?
A. Well, when the statement is made that it's not a cable, and they say "we are not showing it," I have to base it on what I've seen in the specs. The specs are all I have to use.
Q. Okay.
MR. CLAASSEN: Let's take a look at that '623 patent. That is Exhibit No. 5 -- sorry -- that is Exhibit No. 4.
BY MR. CLAASSEN:
Q. The court reporter has just placed on the screen the '623 patent.
Do you see that?
A. Yes, sir, I do.
Q. Are you familiar with this patent?
A. Yes.
MR. CLAASSEN: I'm going to mark it as Exhibit 4 for purposes of this deposition.
Do you understand that?
THE WITNESS: Yes.

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(Exhibit 4, Document Bates stamped MAS0000099 through 139, multipage document entitled: United States Patent No.: US 9,872,623 B2, dated January 23, 2018, with cover page dated June 18, 2019, marked for identification)
BY MR. CLAASSEN:
Q. So you looked at the figures, right?
A. All the figures, yes.
MR. CLAASSEN: Do you have the printed copy of Exhibit No. 4?
THE WITNESS: Yes.
Do you mind if I take it out?
MR. CLAASSEN: No, go ahead.
THE WITNESS: Help me out and tell me what Exhibit it is?
MR. CLAASSEN: Exhibit No. 4, the '623 patent.
(Pause)
THE WITNESS: All right. Here is Exhibit 1, and I'm taking that out now.
MR. CLAASSEN: Okay, you are going to flip back to the figures?

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THE WITNESS: Yes.
BY MR. CLAASSEN:
Q. Which figures did you consider when you were considering the construction of "tail"?
A. I was looking at the figures and the way they were disclosed in the specs in combination.
Q. Okay.
Were there any figures that were more instructive than others?
A. Well, when the statement is made that "the tail is not a cable," there is not much more I can opinionate.
Q. I want -- in Exhibit 1 -- we don't need to pull it back up -- but the intrinsic evidence that was cited -- I'm just going to kind of refine our look at the figures, based upon our intrinsic evidence.
It mentions Figures 4A and 4B.
So can we take a look at those?
A. Yes, sir. I got 4B in front of me.
Q. Let's start with 4A.

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A. Oh, 4A?
Q. Yeah.
A. Looking at 4A now.
Q. How does Figure 4A inform your construction of "tail"?
A. First of all, the 420 is articulated as being the cable.
And to repeat myself, the specs said the tail is not shown and the tail is not a cable.
Q. So if you were to remove 420, what would you be left with?
A. What would I be -- without seeing where the tail is, I can't render an opinion.
I can have an idea from an expert perspective based on the figures and the way it's disclosed.
I can't make any kind of opinion.
Q. So if 420 was removed from figure 4A --
A. Correct.
Q. -- would you still have a sensor?

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A. Yes.
Q. Would you still have a wrist-borne device?
A. You are referring to figure 4B now?
Q. 4A.
A. Okay. Look at 4A. Sorry.
Q. So if you remove 420 --
A. Okay.
Q. -- would you still have a sensor?
A. You have a sensor, but something has got to connect to the sensor --
Q. Okay.
Have you seen other types of sensors?
A. I've seen thousands of sensors.
Q. Thousands.
Would a person of ordinary skill in the art have seen different types of sensors?
A. He would assume that, but he would want to know how the sensor is connected.
Q. So the sensor has to be connected somehow, right?
A. Yes.

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Q. What are some of the ways that you've seen a sensor connected to a device?
A. I'm sorry, sir?
Q. What are some of the ways that you have seen a sensor connected to a device?
A. As applies to pulse oximetry, I've seen hundreds of devices where the cable is -- is utilized in the same way it's used in this particular system.
Q. This cable 420 has removable connectors at both ends, right?
A. Correct.
Q. Is that the only configuration of a cable you've seen?
A. No -- some of the -- you could have different configurations.
Q. What are those configurations as you've seen?
A. It could be that -- I made some point, I think, earlier where, for patient comfort, you want to be able to disconnect them without going through a lot of rigamarole, and not creating

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anxiety in the patient.
Q. So is one example you've seen on a sensor that's directly wired to a device without connecting?
A. Yes.
Q. Have you seen a sensor with a cable with only one connector?
A. Yes.
Q. How does that connect to a patient monitor?
A. By means of some kind of cable attachment.
Q. How would you refer to that type of cable?
A. I'd call it cable or wire.
Q. Would it be different from a cable or wire with two connectors?
A. Depending on the way it was configured, it more than likely would be different. I'd have to look at the drawing and specs.
Q. Did you look at any of the other

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claims when you were coming up with the construction of "tail"?
A. I looked at all the claims that incorporated that term.
(Pause)
MR. CLAASSEN: I'd like to take a break, maybe 15 minutes. Then hopefully, we can wrap up relatively soon.
THE WITNESS: Sounds good. Thank you, counselor.
THE VIDEOGRAPHER: The time is 7:28 p.m. Off the record.
(Recess from 7:28 p.m. to 7:49 p.m.)
THE VIDEOGRAPHER: The time is 7:49 p.m. Back on the record.
BY MR. CLAASSEN:
MR. CLAASSEN: Thank you, Dr. Yanulis. You were just on a break.
Is that right?
THE WITNESS: Yes, sir.
MR. CLAASSEN: As I mentioned before the break, we were hoping to wrap up relatively

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soon. I'll pass the witness now.
MS. HOEKEL: Okay. Great. Well, I got my exhibits ready, so I think I'm ready to do that.
If the videographer can pull up Exhibit 1 at pages 11 and 12.
(Pause)
THE VIDEOGRAPHER: You want 11 and 12 from the --
MS. HOEKEL: The joint claim construction part of the --
(Pause)
THE VIDEOGRAPHER: Okay.
EXAMINATION
BY MS. HOEKEL:
Q. Dr. Yanulis, I just have a couple of questions about a couple of terms.
You were asked questions this morning about "alarm condition," which is the third term in the joint claim construction statement.
And I believe your testimony may have gone back and forth. And I just want to make

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sure we are clear as to whether or not you agree with Masimo -- with plaintiff's proposed alternative construction?

A. The answer is: No, I did not agree.

Q. And I think you clarified this later in the record, but just to avoid any ambiguity: What is it that you believe is the dispute between the parties as to these constructions?

Or why is it that you don't agree with Masimo's proposed alternate construction?

A. Based on the specifications and the claims as written, I don't support the claim terms as proposed by Masimo unless certain things were added, as I have articulated in our proposed construction and evidence.

Q. So to be more specific: What is it that you don't agree with with Masimo's proposed alternate construction of "a measurement of a physiological parameter that is outside set limits"?

A. The issue is that a patient condition that satisfies all the alarm criteria resulting

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in a triggered alert.

And that's not articulated in Masimo's proposed construction.

Q. Are there any other reasons that you disagree -- there is a disagreement between Sotero's position and Masimo's proposed alternate construction?

A. For this term, I'm fine with what I defined.

But the important thing is you have to satisfy a patient condition that satisfies all alarm criteria, ending up with some kind of triggered alert.

You really need to have "all alarm criteria."

Q. If we go to page 23 of the -- of the same exhibit, please, which is the means-plus-function -- the -- sorry -- the claim term 5, which is "the one or more processors configured to electronically determine" -- do you see that claim term?

A. Yes.

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Q. It's -- hold on one second.

Is it -- it's Sotero's position that this is a means-plus-function claim, correct?

A. Correct.

(Pause)

MS. HOEKEL: If we go to -- I'm sorry.

Let's go actually to Exhibit -- sorry, I don't have my list.

What exhibit is the '244 patent?

THE WITNESS: I'd have to look at my folders again.

MR. CLAASSEN: It would be Exhibit 10.

(Exhibit 10, Document Bates stamped MAS0000315 through 333, multipage document entitled: United States Patent No.: US RE47,244 E, dated February 19, 2019, with cover page dated June 17, 2019, marked for identification)

THE WITNESS: Thank you.

I have them off to the side. I do appreciate you sending them to me, counsel.

(Pause)

MS. HOEKEL: I apologize. Let's maybe

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look at the claim itself. I think it's easier.

If you look at the '244 patent, claim 1 -- and that's at column 7 -- at the bottom of column 7, if the court reporter can blow it up for us. Great.

BY MS. HOEKEL:

Q. So it is Sotero's construction that this is a means -- this should be construed as a means-plus-function term, correct?

A. Correct.

Q. And the term is: One or more processors ... configured to electronically.

Correct?

A. Yes.

Q. It's: One or more processors ... configured to electronically determine that the measurement of the physiological parameter satisfies an alarm activation threshold.

Do you see that?

A. Yes.

Q. If someone gave you this list of features in the claim and asked you to program

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the processor to perform these tasks, could you do that from this claim?
A. Not the way it's written.
Q. Why is that?
A. Because there is a lot of antecedental, kind of, description that should have been included as to how this function is performed the way the claims are written.
Q. Are there steps missing in the way this claim is written?
A. Yes, there are.
Q. And so does that -- one of skill in the art who is programming these steps -- would they be able to program them directly using the claims of the term -- the terms of the claim --
A. Not as it is written.
Q. Now I'm going to ask you to look at page 33 of Exhibit 1.
(Pause)
Q. Claim term 6 that's in dispute between the parties as to the '244 patent is "electronically initiating, using the patient

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monitoring device, the first parameter-specific alarm delay or suspension period of time."
Do you see that?
A. Yes, I do.
Q. And if Masimo's proposed construction was adopted by the court, could that construction capture pre-alarm delays?
A. If it was accepted by the courts.
Q. And you spent a lot of time with counsel talking about why pre -- why you were talking about pre-alarm delays.
Is it your -- is it your testimony that, if a pre-alarm delay was captured in the scope of this patent term, that would be improper?
A. Could you repeat the question?
Q. Sure.
If Masimo's construction prevailed, I believe you said that a pre-alarm delay could be included in the scope of that term.
Correct?
A. If the court adopted their position.

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Q. Okay.
MS. HOEKEL: Can you sit back again for me?
THE WITNESS: I'm sorry?
A. If the court adopted -- accepted their position, not ours.
Q. Why is it that you believe that would be an incorrect construction?
A. Because you have to go beyond plain and ordinary meaning and you have to talk about pausing the so-called alarm for a period of time based on a response from the user, just as written.
Q. Does the specification disclose something other than a user-initiated delay or suspension?
A. It discusses -- it begins it, but it doesn't do a complete job, in my estimation.
Q. Go ahead.
A. No, it doesn't disclose adequately so I could understand it as an expert in the field.
Q. Does the patent specification in the

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'244 patent disclose the concept of pre-alarm delays?
A. It discusses them, but it doesn't really -- it doesn't convince me.
And, again, I'm using the term "pre-alarm delay," which is what I had a problem with.
Q. So would it be proper for a pre-alarm delay to be encompassed by the scope of this claim term of the '244 patent?
A. You'd have to take out "parameter-specific alarm delay or suspension period." That's not proper.
Q. The last thing I wanted to ask you about is we talked a lot today about the claim construction positions offered in the IPR versus the claim construction positions offered in the district court litigation, correct?
A. Correct.
Q. Some of those do differ, correct?
A. Correct.
Q. There are some terms for which Sotero

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says plain and ordinary meaning may be applied by the Patent Office in the IPR.

Is that correct?

A. Yes.

Q. You want me to ask that again?

A. Yes, that's correct. For the purposes --

Q. Go ahead.

A. -- if I'm understanding your question, counselor, in the context of the IPR, not for this exercise.

Q. So there are some terms in the IPR for which Sotero has offered -- said that plain and ordinary meaning may be applied to the terms and in which in a district court litigation they have given a different construction, correct?

A. Correct.

Q. And I think at one point, you said something like you weren't worried about being quite as precise in the construction of the terms in the IPR.

Do you recall saying that?

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A. Yes. And I misspoke.

Q. What did you mean when you said that?

A. I was just applying the plain and ordinary meaning.

That doesn't mean I wasn't concerned with the initial terms -- the way they were disclosed. That's not what I was implying.

And I apologize if I conveyed the wrong --

Q. Well, what is the purpose of the -- what is the purpose of the inter partes review, as you generally understand it?

A. To the best of my knowledge, it only pertains to proving the invalidity or non-invalidity, depending on which side.

Obviously, I was proving the invalidity of the patents based on support of the prior art, the patents, and my knowledge in the field.

Q. Is it your testimony that using the plain and ordinary meaning in the IPR petitions would still result in the invalidity of the

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claims in those petitions?

A. Yes, it would.

MS. HOEKEL: I don't have any further questions. I'll pass the witness back to Mr. Claassen if he has any questions.

MR. CLAASSEN: I do have just a couple of questions about what you talked about.

EXAMINATION

BY MR. CLAASSEN:

Q. Let's go back to Exhibit 1, page 12.

You were asked about Masimo's proposed construction, right?

A. Correct.

Q. What do you disagree with in Masimo's proposed alternative construction?

A. I think that the terms should have included a patient condition that satisfies all the alarm criteria resulting in triggered alert. So that I would want it to include -- satisfy "all alarm criteria."

Q. But you would want the construction to be Sotero's proposed construction, right?

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A. Yes.

Q. That's the reason you disagree with Masimo's proposed construction, right?

A. Well, the way it's written, I think it needs to be more precise in defining how this alarm criteria triggers an alert or an alarm.

And it's not acceptable in my opinion -- expert opinion -- the way Masimo has proposed it.

Q. Okay.

I heard your response slightly differently, I guess.

When you were asked why you didn't agree with Masimo's proposed construction, you read Sotero's proposed construction, right?

A. Yes, I did.

Q. So you don't agree with it because it's not Sotero's proposed construction, right?

MS. HOEKEL: Objection --

A. I disagreed with it in the preciseness of the terms based on the specification in view of the claims at hand.

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Q. Okay.
Why?
A. Because I think it -- it's too broad, not precise enough.
Q. And it lacks the words that are in Sotero's construction, right?
A. No, it lacks the words that I would use as an expert in the field.
And my expertise and the devices I've seen and worked with requires in this scenario that all the alarm criteria are satisfied when an alarm is triggered.
That's really what I was basing it on.
Q. But earlier, we talked about "all" not being quite right, right?
MS. HOEKEL: Objection.
A. I was saying it in the context. And I may not expressed it as well as I could have.
But I want to make sure on the record I wanted to reflect: As an expert, I would want to have a limitation "all alarm criteria" need to be satisfied.

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Q. I thought had you told me earlier that "multiple alarm criteria" would be sufficient?
A. And I misspoke at that point. That was an error on my part.
Q. Okay.
What's the difference between "all alarm criteria" and "multiple alarm criteria"?
A. "All alarm criteria" is a more precise term, based on the specs that have been written.
Q. What would be included in "all alarm criteria" that is not in "multiple alarm criteria"?
A. If the term "all alarm criteria" was in the particular claims.
Q. What's the difference between "all alarm criteria" and "multiple alarm criteria"?
A. I just think it's more precise to say: All alarm criteria.
Q. Give me one criteria in "all" that's not in "multiple."
MS. HOEKEL: Object to the form.
A. The -- the specific alarm delays and

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what exactly is incorporating alarm criteria.
It's not really defined as clear as I liked [.
And it's definitely not discussed as far as what exactly is being claimed based on the specs.
Maybe I'm not saying that right.
Q. Would "all alarm criteria" depend on which particular parameter is being evaluated?
A. Yes, it would.
Q. How would it depend on that?
A. As the example, you could talk about the -- give an example of something I'm a little bit more familiar with.
As I alluded to, a pulse oximetry device being used to monitor a patient in heart failure, as opposed to a patient going for a tonsillectomy that is basically in good shape. You wouldn't have the same alarm criteria for that.
Or if you take another example, pulse oximetry, a patient in a critical care

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environment, you would be more concerned with sudden changes in the oximetry levels or oxygenation levels, more so than you would be for, you know, you or I that's in very good shape.
I like to think I'm in good shape.
Q. So what are all the alarm criteria for SpO2?
A. The limits as far as lower and higher, the delay times in terms of if you don't have a critical patient, you obviously are going to set your alarm delays longer.
It's more critical that when you have a critical patient. You want to set the alarm delays tighter.
But by the same token, you want to see in either case if the condition resolves itself in an appropriate period of time based on the clinician's expertise.
Q. What are all the alarm criteria for pulse rate?
A. For pulse rate, again, lower and

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higher limits. Would be a lot tighter for someone that's -- for example, in heart failure as opposed to the patient that just comes in the hospital for a normal physical exam.

Q. So the criteria themselves are the same?

It's just the actual values are different, based upon the parameters --

A. No, it's the way they are set up by the clinician.

The clinician is the one who has the expertise that can set those alarm criteria.

I don't have that expertise. Or I should -- I know what some of them are, as I have articulated.

It's the expertise and experience of the clinician how he sets those criteria.

Q. But your understanding of this claim term is that there are different "all alarm criteria" for different parameters.

Is that right?

A. There is different alarm criteria for

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each parameter being monitored based on the needs of the patient.

Q. And all those criteria would have to be satisfied?

A. Yes.

Q. So then let's move down to page 23.

We were talking about "the one or more processors."

Do you remember that?

A. Yes, sir.

Q. And you looked at claim 10 itself, right?

Exhibit 10, I'm sorry.

I didn't mean claim 10.

Exhibit 10?

MS. HOEKEL: The patent?

MR. CLAASSEN: The patent.

THE WITNESS: We were looking at claim 10 --

BY MS. HOEKEL:

Q. We were talking about the means-plus-function for this claim term, right?

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A. Right.

Q. You told us that there were some steps missing from the claimed processor, right?

A. Yes, I did.

Q. What steps are missing?

A. The steps are what exactly is going to be in the algorithm for accomplishing this.

I don't mean the specific software, but the steps for going -- first of all, determining what the alarm criteria is, how you set the alarm delays based on what the clinician provides, and so forth.

Q. So the settings -- is that what you are talking about?

A. A lack of a better term, you have to program the processors to do what you want them to do. The processes are dumb brains. They don't know what to do. You have to provide all the steps to accomplish all the tasks -- which are basically set the alarm criteria, determine how long the alarm delays are, determine how the -- you respond to a particular alarm or

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particular parameter.

Q. So you'd call those steps.

Is that right?

A. Yes. Steps, sequences, sequential order of sub-processes, or whatever term. I'm using engineering terms.

(Pause)

A. Can I expand on that?

Q. Go ahead.

A. I had a lot of experience with programming. And before I do anything, I have to develop an algorithm: What do I want to do? I have to go to step A, step B, step C. And I can't skip from A to Z because the computer processor will not know what to do. I have to tell the processor what to do so and the steps required.

Doesn't matter what software I use. I have to provide the steps.

Q. So let's talk about this claim 1 that's shown in the left column.

Do you see that?

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A. Yes.
Q. Do you see those: One or more processors configured to electronically? --
A. Yes.
Q. Process the signal -- is that a step?
A. Yes.
Q. Is that the first step?
A. Well, you have to first determine what kind of threshold you want for that particular parameter that you are measuring, what kind of limits you set.
Q. That's before you process the signal, you have to know what the limits are going to be?
A. You have to have an understanding of what the -- again, I'm speaking as a clinician -- you have to understand what type of threshold limits, how tight you want to make them, and what the time frame is if you want to see if the condition revolves itself, depending on, again, the clinical needs of the patient.
Q. You need to do all of that before you

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determine the measurement of a physiological parameter.
Is that right?
A. Well, first of all, you have to determine which physiological parameters.
Obviously, there is several different parameters. There is hemoglobin, pulse ox, pulse rate, EKG, glucose levels.
You have to determine in your algorithm -- that should be the first step: What parameters do I want to measure?
Q. So if this claim recited SpO2 as a parameter, would the recited claim provide enough information for you to program a processor?
A. I'd have to know what the threshold limits are. It's not clear as to how they are setting -- what they mean by "alarm activation thresholds."
Q. So which of these steps after "configured to electronically" are means-plus-function limitations?

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MS. HOEKEL: Object to the form.
A. I'm not sure I understand how to answer the question other than the way I have answered it.
You are providing a sequence of steps. And the steps have to be clearly articulated. And the claims as claimed have to reflect what's being discussed in the user's specs.
Q. I just want to make sure I'm understanding you correctly.
You are saying, in order to program the system, you would need to know what the limits are.
Is that correct?
A. No. I'm giving you a very -- call it -- brief synopsis of what an algorithm entails.
An algorithm is defined from an engineering perspective and one skilled in the art: What sequence of steps needs to be set forth so the processor or computer knows what to do, and how to process the information -- in

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this case the physiological parameters; and what the limits that are going to be acceptable as far as the threshold limits.
I'm giving you, sort of, an abbreviated what an algorithm does.
We haven't talked about the specific software used.
I'm just saying: The sequence of steps that you have to utilize to get these processors to use the best means for determining the physiological parameter that you are monitoring.
Q. So I'll ask you again: This claim recites: One or more processors configured to electronically.
Do you see that?
A. Yes.
Q. Then there are steps, right?
A. Yes.
Q. What steps are missing?
A. You haven't really included a step: How is the physiological parameter being

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monitored to satisfy an alarm activation threshold holding?

Haven't really defined how you do that.

Q. Defining a threshold is important to determining that the measurement satisfies a threshold, right?

A. You have to understand what's acceptable; outside thresholds that are not acceptable. In other words, your predetermined threshold or limits should be understood.

And that's why I thought -- now that's why I'm of the opinion that my terminology for structure is more precise and more correct -- as far as for one skilled in the art -- to understand this device.

Q. Does "predetermine" mean "preprogrammed"?

A. It can be.

Q. Must it be?

A. Based on the context of these specs, I would say: Yes.

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Q. So a user could not input any sort of limits into --

A. No, I didn't say that.

That's why I made mention and I emphasized that the clinician has to provide the required acceptable threshold limits.

I as an engineer can't do that.

I can program based on what he provides to me -- or she.

Q. But those are provided by the clinician, right?

A. The clinician, healthcare worker -- whoever is directly responsible for the patient. Could be a nurse; could be a physician; P A.

MR. CLAASSEN: Let's move, then, to page 33 of Exhibit 1.

MS. HOEKEL: Thirty-three?

MR. CLAASSEN: Please.

THE WITNESS: Where are we, counselor?

MR. CLAASSEN: Let's go to page 33 on Exhibit 1.

THE WITNESS: Right.

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BY MR. CLAASSEN:

Q. Counsel was talking with you about the "electronically initiating."

Do you remember that?

A. Yes.

Q. You were talking about Masimo's construction, right?

A. Correct.

Q. Why does Masimo's construction include "pre-alarm delays"?

MS. HOEKEL: I'm going to object to the form.

BY MR. CLAASSEN:

Q. Do you understand the question?

A. Yes.

Q. You can answer it.

A. I can, but I need to think about what you are asking me.

So could you repeat the question?

Q. You testified when counsel asked you that Masimo's construction includes pre-alarm delays, right?

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A. And I answered: I don't agree with the way they disclosed the pre-alarm delays because they used the term I didn't agree with.

Q. My question is a little different.

My understanding from what you said is that Masimo's construction would include pre-alarm delays.

Is that right?

A. In response to a user.

Once the pre-alarm delay has been -- you are talking about pausing the first alarm?

Q. I'm talking about Masimo's construction here.

And when opposing counsel asked -- or, I guess, your attorney asked you -- does Masimo's construction include pre-alarm delays?, I thought you responded that it does.

A. And my answer again is: Yes.

Q. Okay, why?

A. Because that's what the specs say.

Q. What about Masimo's construction includes pre-alarm delays?

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A. You are asking me in the claims?
Or the specs?
Q. I'm asking you in Masimo's construction.
A. And I don't agree with the way they proposed it.
Q. And that's because it includes pre-alarm delays, in part, right?
A. Somewhat.
Q. Okay.
Does Masimo's construction include pre-alarm delays?
MS. HOEKEL: Object to the form.
A. I don't believe that the scope -- properly discussed it. And I think, no, they didn't discuss pre-alarm delays in a way that I understand what they meant.
Q. Are you talking about the specification now?
Or are you talking about Masimo's proposed construction?
A. I'm talking about the proposed claim

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construction in view of what they disclosed in their specs.
Q. So does the proposed construction -- the Masimo proposed construction -- include pre-alarm delays?
A. I'd have to look at the claims again.
Q. I'm asking you to do that right now.
A. Okay. I have to get out my patent.
Q. Okay.
A. Which exhibit is this, by the way, for '244?
Q. I believe it's going to be Exhibit 10 again.
A. Give me a second.
(Pause)
A. So we are looking at the claims, if they actually articulate that.
Give me a moment to read it, counselor.
Q. I'll direct your attention to claim 13.
A. Okay.

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Q. You see the "electronically initiating" limitation?
A. If I'm reading correctly, are you starting from line 34.
MR. CLAASSEN: Would you mind putting up Exhibit 10 on the screen, and then claim --
THE WITNESS: Yeah, I'm looking at the claim.
MR. CLAASSEN: I want to make sure we are all looking at the same thing.
THE WITNESS: Okay. Thank you.
BY MR. CLAASSEN:
Q. So what were you directing us to, Dr. Yanulis?
A. The use of the term "parameter-specific alarm delay."
And I don't think the term "parameter-specific alarm delay" has been properly disclosed and supported in the patent specs.
Q. Okay.
We were talking about the construction

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of the term "electronically initiating."
You understood that, right?
A. Correct.
Q. And you understood Masimo's proposed construction to be plain and ordinary meaning, right?
A. I didn't hear the last part, counselor.
Q. You understood Masimo's construction to be plain and ordinary meaning, right?
A. Yes.
Q. What about the plain and ordinary meaning includes pre-alarm delays?
A. It doesn't say it, but it says "parameter-specific alarm delay."
Q. So "parameter-specific alarm delay" means "pre-alarm delays."
Is that right?
MS. HOEKEL: Object to the form.
A. I don't -- how do I phrase this?
In the way the term has been construed or adopted by Masimo -- and, again, the claim --

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this part of the claim -- as far as the parameter-specific alarm delay, I don't really see how that parameter-specific alarm delay has been properly disclosed for me to understand it in the claim.

Q. So is that your complete description of why Masimo's construction includes pre-alarm delays?

A. I would have liked to also have included a little bit more description of how the user responds to a set parameter-specific alarm delay.

And, again, I was focusing on the term in the terminology -- "pre-alarm parameter-specific."

Q. So now we are talking about what you would hope to see in the specification.

Is that right?

A. Well, what I would hope to see more clearly, precisely defined in this claim.

(Pause)

Q. Do you have anything else to add on

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why Masimo's construction includes pre-alarm delays?

A. I am sorry?

Q. Do you have anything else to add on why Masimo's construction includes pre-alarm delays?

A. Because they haven't really discussed it in terms of -- no, I don't, at this point.

I may have an opinion later on, but I need to think about it. Give me a moment.

(Pause)

A. The way it's claimed is not adequately disclosed to my understanding as an expert skilled in the art the way it's claimed.

I don't know what else to say.

Q. Do you have anything else to add on why Masimo's construction does not -- or would include pre-alarm delays?

A. Because of the term "parameter-specific alarm." I'm not -- I'm not agreeing with it -- proper use, I think that's an improper, less-precise terminology.

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Q. That would include "pre-alarm delays," right?

A. Again, I'm putting the phrase "parameter-specific alarm delays."

There is a difference.

I'm saying they are not defined why they are parameter-specific for a particular physiological parameter.

Q. So I'll ask you one more time: Why does Masimo's construction include pre-alarm delays?

A. Because it's a period of time before some action is taken by the user.

(Pause)

Q. Your attorney then asked you at the end of your redirect on -- about the plain and ordinary meaning used in the IPR petitions.

Do you remember that?

A. Yes.

Q. You testified that using the plain and ordinary meaning would result in the invalidity of the claim term for the claims at issue,

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right?

A. In the context of the IPR declaration, I was saying plain and ordinary meaning is sufficient for the IPR presented to the patent board.

Q. But you expressed no opinion under Sotero's proposed constructions, right?

A. I didn't agree with Masimo's.

I thought I expressed that.

Q. In the IPR declarations, you presented no position based upon Sotero's narrower constructions that we discussed today, right?

A. Because today's discussion does not require -- or today's discussion requires a more precise understanding and agreement of terms.

The IPR does not.

I was using the standard very correctly. Obviously, the so-called plain and ordinary meaning applied to both.

But, again, I was not concerned with the terms per se, because I did not have an idea what the courts would determine as the top eight

or nine or 20 claims of disagreement.

What I was basing the IPR -- as I have said a couple of times now -- is the IPR exercise was proving the invalidity of the patent being discussed based on prior art.

Q. Based upon the broader construction that Masimo proposed, right?

A. No, I didn't say that.

Again, I think I have said a couple times on the record: The claims are invalid in the IPR. They have no meaning. You are only looking at the invalidity of the patent -- its entirety.

I am not looking as how precise or how correct because the court hasn't decided.

I only have what's been discussed in the IPR. And that's -- as I have been saying right along -- you are looking at invalidity issues.

You are not looking in a limited context, if you will, of the so-called claims that may or may not be construed.

The claims have no -- the claims are invalid for both parties in the IPR.

I have said that a few times now.

Q. I don't know what that means.

A. It means they could be right or not right. That's not the purpose of the IPR.

The IPR is to provide evidence that the patents are invalid -- nothing more, nothing less.

This district court in the next phase requires an accurate preciseness of all the terms in the claims in view of the specifications.

Q. So in your view, the claims can be construed differently for the IPR than they can for the district court, right?

A. I didn't say that.

I said you are looking more broadly at the terms. You are not concerned with the terms as much as you are in this exercise.

You are still using the standard plain and ordinary meaning.

You are misinterpreting what I'm saying.

The IPR is a separate exercise. It looks at the invalidity. You don't care about the so-called potential terms.

This is the purpose of the district court acting in this stage.

Q. I understand that that's your view.

MR. CLAASSEN: I have no further questions.

THE WITNESS: And I appreciate the time, sir.

MS. HOEKEL: No redirect.

THE VIDEOGRAPHER: Okay. This marks the end of today's deposition. The time is 8:33 p.m.

* * *

E N D O F P R O C E E D I N G

Time noted 8:33 p.m. Eastern Standard Time

* * *

C E R T I F I C A T E

I, BRANDON RAINOFF, a Federal Certified Realtime Reporter and Notary Public within and for the State of New York, do hereby certify:

That GEORGE EMANUEL YANULIS,, the witness whose deposition is hereinbefore set forth, was duly sworn by me and that such deposition is a true record of the testimony given by the witness.

I further certify that I am not related to any of the parties to this action by blood or marriage, and that I am in no way interested in the outcome of this matter.

IN WITNESS WHEREOF, I have hereunto set my hand this 10th day of September, 2020.

_____

BRANDON R. RAINOFF, RMR, CRR, RPR, FCRR

George Emanuel Yanulis, Ph.D., c/o
HUSCH BLACKWELL LLP
190 Carondelet Plaza, Suite 600
St. Louis, Missouri 63105

Case: Masimo Corporation v. Sotera Wireless, et al.
Date of deposition: September 10, 2020
Deponent Name: George Emanuel Yanulis, Ph.D.

Please be advised that the transcript in the above referenced matter is now complete and ready for signature. The deponent may come to this office to sign the transcript, a copy may be purchased for the witness to review and sign, or the deponent and/or counsel may waive the option of signing. Please advise us of the option selected. Please forward the errata sheet and the original signed signature page to counsel noticing the deposition, noting the applicable time period allowed for such by the governing Rules of Procedure. If you have any questions, please do not hesitate to call our office at (202)-232-0646.

Sincerely,
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Deposition Date: September 10, 2020

I do hereby acknowledge that I have read and examined the foregoing pages of the transcript of my deposition and that:

(Check appropriate box):
( ) The same is a true, correct and complete transcription of the answers given by me to the questions therein recorded.
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ERRATA SHEET

Case: Masimo Corporation v. Sotera Wireless, et al.
Witness Name: George Emanuel Yanulis, Ph.D.
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