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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

Case IPR2020-00954
U.S. Patent 9,788,735

PATENT OWNER REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70(a), and the Scheduling Order (Paper 14), Patent Owner Masimo Corporation (“Patent Owner”) respectfully requests that the Board hear oral argument on the instituted grounds of unpatentability for U.S. Patent No. 9,788,735, including but not limited to the following issues:

1. the proper construction of the challenged claims;
2. whether Claims 1-2 and 7-9 of the '735 Patent would have been obvious over Goldberg, Kiani, and Money under 35 U.S.C. § 103;
3. whether Claims 3-6 and 13-19 of the '735 Patent would have been obvious over Goldberg, Kiani, Money, and Fujisaki under 35 U.S.C. § 103;
4. whether Claims 10-12 of the '735 Patent would have been obvious over Goldberg, Kiani, Money, and Estep under 35 U.S.C. § 103;
5. whether Claim 20 of the '735 Patent would have been obvious over Goldberg, Kiani, Money, Fujisaki, and Estep;
6. whether Claims 1-2 and 7-9 of the '735 Patent would have been obvious over Money, Akai, and Kiani under 35 U.S.C. § 103;
7. whether Claims 3-6 and 13-19 of the '735 Patent would have been obvious over Money, Akai, Kiani, and Fujisaki under 35 U.S.C. § 103;
8. whether Claims 10-12 of the '735 Patent would have been obvious over Money, Akai, Kiani, and Estep under 35 U.S.C. § 103;

9. whether Claim 20 of the '735 Patent would have been obvious over Money, Akai, Kiani, Fujisaki, and Estep under 35 U.S.C. § 103;
10. whether Estep qualifies as analogous art to the '735 Patent;
11. whether Petitioner's Reply improperly raises new arguments and new evidence that exceed the proper scope of a reply;
12. responses to any issues raised by Petitioner in its Request for Oral Argument, or any issues raised at the oral argument; and
13. any other issues the Board deems necessary for issuing a final written decision.

The Board has previously scheduled oral argument for August 26, 2021. The Board has also scheduled oral argument for August 26, 2021 in IPR2020-00912 involving U.S. Patent No. 10,213,108, IPR2020-01015 involving U.S. Patent No. 9,795,300, and IPR2020-01054 involving U.S. Patent No. 9,872,623. Additionally, pursuant to the June 21, 2021 teleconference between the Board and the parties, and the Board's June 25, 2021 email to the parties, the parties have met and conferred regarding consolidation of oral argument for the four above-listed IPRs. Due to the overlap in issues between the four IPRs, the parties agree that oral argument for the four above-listed IPRs should be consolidated into one oral argument. The parties further believe one hour of argument time for each party

(two hours total), including any rebuttal or sur-rebuttal by the parties, should be sufficient to address the issues in all four IPRs.

Additionally, the Board and the parties have agreed to include the oral argument for the above-listed IPRs as part of the PTAB virtual town hall event on August 26, 2021. Accordingly, Patent Owner requests a pre-hearing conference with the Board to discuss any potential logistical issues relating to holding the oral argument as part of the virtual town hall event.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 16, 2021

/Sheila N. Swaroop/

Sheila N. Swaroop (Reg. No. 53,658)

Customer No. 64,735

Attorneys for Patent Owner
Masimo Corporation

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER REQUEST FOR ORAL ARGUMENT** is being served electronically on July 16, 2021, to the e-mail addresses shown below:

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