

Got UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.
Petitioner

v.

MASIMO CORPORATION
Patent Owner

Case No. IPR2020-00954
Patent No. 9,788,735

Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and
ROBERT L. KINDER, Administrative Patent Judges.

**PETITIONER'S MOTION TO EXCLUDE
PURSUANT TO 37 C.F.R. §§ 42.155(c) AND 42.64**

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MOTION AND INTRODUCTION

Pursuant to 37 C.F.R. §§ 41.155(c) and 42.64(c), Petitioner Sotera Wireless, Inc. (“Sotera”) moves to exclude the following:

- EX2010** Declaration of Alan L. Oslan (¶¶ 78, 80, 94-96, 98, 100, and 103);
- EX2016** Transcript of Deposition of George Yanulis, conducted on September 10, 2020, in Masimo Corp. v. Sotera Wireless, Inc., Case No. 3:19-cv-01100-BAS-NLS (S.D. Cal.);
- EX2024** Allison Rhodes Westover et al., *Human Factors Analysis of an ICU*, 23 J Clin Eng 110 (1998);
- EX2025** Gianfranco Parati et al., *Self blood pressure monitoring at home by wrist devices: a reliable approach?*, 20 J Hypertension 573 (2002);
- EX2027** Japanese Publication JP4777640B2 to Junichi and English machine translation available from Espacenet;
- EX2028** Photographs of Omron Gold Wrist Blood Pressure Monitor (Model No. BP4350) taken by Alan Oslan; and
- EX2036** Japanese Publication JP4777640B2 to Junichi – Certified English translation (Served only on 3/15/2021).

Set forth below is the identification of where in the record the above-listed exhibits were relied upon by Patent Owner Masimo Corporation (“Masimo”), where in the record Sotera objected to each exhibit, and Sotera’s explanation of each objection.

ARGUMENT

A. Exhibit 2016 Should Be Excluded in Whole or in Part Under F.R.E. 401 or F.R.E. 402 Because it is Irrelevant to this Proceeding.

Masimo relied upon the deposition transcript of Sotera's expert witness, Dr. George Yanulis, taken in the corresponding District Court litigation (EX2016), as evidence of an alleged contradiction. Paper 21, pp. 19-21. Sotera objected to this exhibit as irrelevant under F.R.E. 401/402. Paper 22, p. 1. Regardless of the meritless contradiction argument, this transcript is irrelevant to the current proceeding because Dr. Yanulis' testimony in EX2016 concerned claim terms that neither Sotera nor Masimo seek to construe before the Board.

The Board has excluded, as irrelevant, briefs and other documents stemming from corresponding District Court litigation when the District Court document is associated with an issue unrelated to *inter partes* review ("IPR"). *Samsung Electronics Co., Ltd. v. Huawei Technologies Co., Ltd.* IPR2017-01487, Paper 45, p. 25 (P.T.A.B. Dec. 10, 2018). EX2016 relates to construction of the term "separate computing device," but construction of this term is not related to any issue in this IPR¹. Hence, EX2016 is irrelevant and should be excluded like

¹ Because invalidity under 35 U.S.C. § 112, first paragraph is not within the scope of an *inter partes* review. 35 U.S.C. § 311(b).

similarly excluded, irrelevant documents from corresponding District Court litigation. *Id.*

Petitioner made clear in the Petition that it disagreed with Masimo's construction of some claim terms. Paper 1, p. 14, n.1. Nevertheless, for the sake of efficiency in this proceeding before the PTAB, Petitioner applied the plain and ordinary meaning of the term "separate computing device," not because it agrees that this construction is correct, but because the '735 Patent is invalid even under Masimo's construction.² Dr. Yanulis disagrees with Masimo's construction of this claim term (EX1003, ¶¶ 35-36), but he applied the plain and ordinary meaning *only in this IPR* because the '735 Patent is invalid under Masimo's construction. EX1003, ¶¶ 34, 36. Such an assertion is not contradictory, it simply exposes the weakness of the '735 Patent. Paper 25, p. 2, n.1.

Dr. Yanulis' District Court testimony is only relevant to the issue of what the term "separate computing device" means within the context of the '735 Patent, but that is not an issue before the Board because 35 U.S.C. § 112 invalidity is not within the scope of an *inter partes* review. 35 U.S.C. § 311(b). The construction of

² The '735 Patent is equally invalid under Petitioner's proposed construction in District Court. There is nothing non-obvious about transmitting a wireless signal to a conventional bedside monitor rather than a generic computer.

this term has no bearing on *obviousness* here because the Board does not need to construe this term to decide whether the '735 Patent is invalid under 35 U.S.C. § 103. In other words, EX2016 should be excluded because the Board gains nothing from considering it. Thus, EX2016 should be excluded under F.R.E. 401 or 402.

B. Exhibits 2027 and 2028 Should Be Excluded as Irrelevant Because These Exhibits Are Not from the Correct Time Frame.

Masimo filed EX2027 and EX2028 with the Patent Owner Response (Paper 21), even though the Patent Owner Response cited to none of these references. Sotera timely objected to EX2027 and EX2028 as irrelevant under F.R.E. 402 because the publication date (or priority date) of each of these exhibits occurred substantially *after* the priority date of the '735 Patent. Paper 22, p. 2.

The priority date of the '735 Patent is March 25, 2002. EX1001, (60). Despite this priority date, Masimo introduced evidence of a modern medical product and a patent application *filed* over two years after the '735 Patent priority date and published nine years after the '735 Patent priority date. The Board should exclude these exhibits under F.R.E. 402.

In an obviousness inquiry, it is the available knowledge of a person of ordinary skill ("PHOSITA") in the art *as of the priority date* that is relevant. *See Graham v. John Deere Co.*, 383 U.S. 1, 3 (1996) ("This is the test of obviousness,

i.e., whether the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made..."); *id.* at 14-15 ("Section 103...refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before...") (emphasis added). Patent Owner acknowledges that the exhibits discussed in this section were not available to a PHOSITA on or before the priority date of the '735 Patent. Paper 30, "Exhibit List, Page 3." Hence, these exhibits would not have been known to a PHOSITA on or before the priority date of the '735 Patent. These two exhibits cannot, therefore, represent the knowledge of a PHOSITA as of the priority date of the '735 Patent. Therefore, the Board should exclude and not consider these exhibits (and the cited testimony that relies on them).

More specifically, EX2027 is a Japanese Patent Application filed on December 3, 2004, but EX2027 was not *published* until September 21, 2011. EX2027, p. 11. Even though EX2027 bears this publication date, Masimo introduces EX2027 as supposed evidence about why Goldberg (EX1005) cannot be modified as proposed in the Petition. EX2010, ¶ 100. EX2027 is irrelevant the proposed modifications of Goldberg because it was invented after Goldberg, and a PHOSITA would not have known of EX2027 at the priority date of the '735 Patent. It's equally unreasonable to suggest, as Patent Owner's expert does, that

Goldberg's device operated like EX2027, especially considering that EX2027 was invented after Goldberg and published *long* after Goldberg was filed. *Id.*; EX2027, p. 11; EX1005, (22). Despite these clear differences in time frame, Masimo's expert, Mr. Oslan, relied on this reference in forming his opinions about Goldberg and the proposed modifications to Goldberg. EX2010, ¶ 100. Because EX2027 is not prior art to the '735 Patent (or Goldberg for that matter), EX2027 is irrelevant to the knowledge of a PHOSITA at the priority date of the '735 Patent, and Masimo improperly relies on this exhibit. Thus, the Board should exclude EX2027 and not rely upon it.³

³ Although never filed with the Board, the supplemental evidence labeled "EX2036" should be equally excluded for the same reasons as EX2027. Masimo served "EX2036" as supplemental evidence on March 15, 2021 to address Sotera's authenticity objection under F.R.E. 901 to the machine translation included in EX2027. However, the certified nature of the translation does not change *when* Japanese Publication No. JP4777640B2 was filed and published, nor does it change the irrelevancy of JP4777640B2. Thus, to the extent Masimo attempts to include "EX2036" in this proceeding, EX2036 should be excluded for the same reasons as EX2027.

Additionally, EX2028 represents and relates to a product that was unavailable for purchase *until 2019*. EX2010, ¶ 94. Even though EX2028 bears this first sold date, Masimo introduces EX2028 as supposed evidence about why Goldberg cannot be modified as proposed in the Petition. EX2010, ¶¶ 94-96, 98. EX2028 is irrelevant the proposed modifications of Goldberg because it was created and first sold long after Goldberg, and a PHOSITA would not have known of EX2028 at the priority date of the '735 Patent. It's equally unreasonable to suggest that Goldberg's device operated like EX2028, especially considering that the Omron device represented in EX2028 was created and first sold long after Goldberg was filed. EX2010, ¶ 94; EX1005, (22). Despite these clear differences in time frame, Masimo's expert, Mr. Oslan, relied on this reference in forming his opinions (EX2010, ¶¶ 94-96, 98). Because EX2028 is not prior art to the '735 Patent (or Goldberg for that matter), EX2028 is irrelevant to the knowledge of a PHOSITA at the priority date of the '735 Patent, and Masimo improperly relies on this exhibit. Thus, the Board should exclude EX2028 and not rely upon it.

C. Paragraphs 94-96, 98, and 100 of Exhibit 2010 Should Be Excluded Because these Paragraphs Rely on Exhibits 2027 and 2028, Which Are Not Relevant Because They Are Not From the Correct Time Frame.

Masimo filed EX2010 with the Patent Owner Response (Paper 21). Sotera timely objected to paragraphs 94-96, 98, and 100 of EX2010 as irrelevant under F.R.E. 402. Paper 22, p. 1.

As discussed above in Section B, Exhibits 2027 and 2028 are irrelevant and not prior art, and paragraphs 94-96, 98, and 100 rely upon these exhibits. For the same reasons discussed above, reliance on these exhibits is improper. Thus, Mr. Oslan's analysis relying on these references is equally improper. Thus, the Board should exclude in whole or in part paragraphs 94-96, 98, and 100 of EX2010.

D. Exhibits 2024 and 2025 Should Be Excluded Because These Exhibits are Inadmissible Hearsay.

Masimo filed EX2024 with the Patent Owner Response (Paper 21), even though the Patent Owner Response failed to cite to EX2024. EX2024 is a publication entitled *Human Factors Analysis of an ICU*. Mr. Oslan cited to EX2024 for the proposition that connectors using ports are allegedly a source of annoyance and connector degradation. EX2010, ¶¶ 80, 103. Sotera objected on the basis of hearsay under F.R.E. 802/803. Paper 22, p. 2.

Exhibit 2024 should be excluded because out-of-court statements such as this, relied upon for the truth of the matter asserted, are inadmissible hearsay. F.R.E. 802. Masimo is relying on this out-of-court statement in a publication to prove the truth of the matter asserted in the publication—this is clearly inadmissible hearsay that does not fall within any of the hearsay objections.

Masimo filed EX2025 with the Patent Owner Response (Paper 21), even though the Patent Owner Response failed to cite to this reference. EX2025 is a

publication entitled *Self blood pressure monitoring at home by wrist devices: a reliable approach?*. Mr. Oslan cited to EX2025 for the proposition that at home blood pressure monitors were allegedly inaccurate and unreliable. EX2010, ¶ 78. Sotera objected on the basis of hearsay under F.R.E. 802/803. Paper 22, p. 2.

Exhibit 2025 should be excluded because out-of-court statements such as this, relied upon for the truth of the matter asserted, are inadmissible hearsay. F.R.E. 802. Masimo is relying on this out-of-court statement in a publication to prove the truth of the matter asserted in the publication—this is clearly inadmissible hearsay that does not fall within any of the hearsay objections.

E. Paragraphs 78, 80, and 103 of Exhibit 2010 Should Be Excluded Because these Paragraphs Rely on Exhibits 2024 and 2025, Which Are Inadmissible Hearsay.

Masimo filed EX2010 with the Patent Owner Response (Paper 21). Sotera timely objected to paragraphs 78, 80, and 103 of EX2010 as reliant on hearsay under F.R.E. 802/803. Paper 22, p. 1.

As discussed above in Section D, Exhibits 2024 and 2025 are inadmissible hearsay that do not fall within any of the hearsay objections. Paragraphs 78, 80, and 103 solely rely upon the inadmissible hearsay included in EX2024 and EX2025 to support the conclusions contained within paragraphs 78, 80, and 103. Thus, Mr. Oslan’s analysis and opinions rely on inadmissible hearsay, and the

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Board should exclude in whole or in part paragraphs 78, 80, and 103 of EX2010 for the same reasons the Board should exclude EX2024 and EX2025.

CONCLUSION

For the reasons stated herein, Petitioner Sotera Wireless, Inc. respectfully requests that the above-referenced Exhibits be excluded.

Respectfully submitted,

Dated: August 6, 2021

By: /Rudolph A. Telscher, Jr./
Rudolph A. Telscher, Jr., Reg. No. 36,032
Daisy Manning, Reg. No. 66,369
Nathan P. Sportel, Reg. No. 67,980
Jennifer E. Hoekel, Reg. No. 48,330
HUSCH BLACKWELL LLP
190 Carondelet Plaza, Suite 600
St. Louis, MO 63105
(314) 480-1500 Telephone
(314) 480-1505 Facsimile
PTAB-RTelscher@huschblackwell.com
PTAB-DManning@huschblackwell.com
Nathan.Sportel@huschblackwell.com
PTAB-JHoekel@huschblackwell.com

***Attorneys for Petitioner
Sotera Wireless, Inc.***

CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of August 2021, I caused the foregoing to be served via electronic email to the attorneys of record for the '735 patent at the following address:

Sheila N. Swaroop (Reg. No. 53,658) 2sns@kmob.com
Ben J. Everton (Reg. No. 60,659) 2bje@knobbe.com
Irfan A. Lateef (Reg. No. 51,922), 2ial@knobbe.com
Brian C. Claassen (Reg. No. 63,051), 2bcc@knobbe.com
Shannon Lam (Reg. No. 65,614), 2sxl@kmob.com
SOTERAIPR735@knobbe.com
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614

By: /Rudolph A. Telscher, Jr./
Rudolph A. Telscher, Jr.
Reg. No. 36,032
Lead Counsel for Petitioner