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Filed on behalf of:

Patent Owner Masimo Corporation
By: Sheila N. Swaroop (Reg. No. 53,658)
Irfan A. Lateef (Reg. No. 51,922)
Ben J. Everton (Reg. No. 60,659)
Brian C. Claassen (Reg. No. 63,051)
Shannon Lam (Reg. No. 65,614)
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: SoteraIPR735@knobbe.com

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'S OPPOSITION TO
PETITIONER'S MOTION TO EXCLUDE**

THE BOARD SHOULD DENY THE MOTION TO EXCLUDE

The Board should fully consider the exhibits and the portions of Masimo's expert declaration that Sotera seeks to exclude. Sotera objects to certain exhibits as irrelevant. But those exhibits are relevant because they relate to the credibility of Sotera's original expert or provide evidence undermining Sotera's motivations to modify the prior art. Sotera also objects to other exhibits and the testimony of Masimo's expert relying on those exhibits on hearsay grounds. But those objections are improper because a hearsay exception applies and because experts can rely on hearsay. For example:

- Ex. 2016 is deposition testimony from Sotera's original expert Yanulis. Masimo used that testimony to demonstrate his inconsistent opinions on claim construction. Therefore, Ex. 2016 is relevant, at least, to Yanulis' claim construction opinions and his credibility.
- Exs. 2027 and 2028 provide relevant evidence of wrist-worn blood pressure monitoring devices after the 2002 priority date. Oslan relied on these exhibits, which were cited in his declaration, to support his opinions regarding a lack of any motivation to combine and lack of expectation of success.

- Exs. 2024 and 2025 are not hearsay because they meet the hearsay exception of FRE 803(18). In addition, FRE 703 allows experts to rely upon hearsay. Mr. Oslan relied on these exhibits and cited them in his declaration to support his opinions as to why a person of ordinary skill would not have been motivated to add sensor ports to a monitoring device.

Because Sotera cannot meet its burden on this Motion, the Board should deny the requested relief. *See* 37 C.F.R. § 42.20(c).

A. Exhibit 2016 Shows Yanulis’ Inconsistent Testimony on Claim Construction and Should Be Weighed With His Other Testimony

Exhibit 2016 contains testimony by Sotera’s original expert, George Yanulis, which is inconsistent with his testimony on an identical claim construction issue in this IPR. Such evidence is so critical to evaluating an expert’s credibility as a whole that the Federal Circuit has instructed it would be an abuse of discretion to exclude it. *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272-75 (Fed. Cir. 2017).

For this IPR, Yanulis opined that all terms, including “separate computing device,” should be given their plain and ordinary meaning under the *Phillips* claim construction standard. *See* Patent Owner Response, Paper 21 (“POR”) at 19-20; EX1003 ¶ 34. Yet, in the related district court action between the same parties and involving the same patents, he testified that “separate computing device” should *not* be given its plain and ordinary meaning and instead should be construed narrowly only to cover “a conventional bedside monitor.” *See* EX2015 ¶¶ 48, 65-69; EX2016

114:8-118:2. Masimo's POR relied on that testimony to argue that Sotera could not meet its burden under that narrower construction. POR 20-22; EX2015 ¶¶ 48, 65.

Sotera's arguments challenging the relevance of Exhibit 2016 have no merit. First, Exhibit 2016 is relevant, and in fact, *critical* for the Board to consider in evaluating Yanulis' overall credibility. Sotera and Masimo have offered competing expert testimony on claim construction and invalidity issues in this proceeding. The Board will evaluate and weigh the credibility of these experts in reaching its decision. Thus, an expert's prior, inconsistent testimony is pertinent to that credibility evaluation.

Second, Exhibit 2016 contains Yanulis' cross-examination testimony, which should be considered in combination with his direct declaration testimony in Exhibit 2015. Yanulis set forth his district court construction of "separate computing device" in Exhibit 2015. Sotera did not object to or move to exclude Yanulis' district court declaration (Exhibit 2015). *See* Paper 22. On cross-examination, Yanulis attempted to explain his inconsistent claim construction positions in the district court and in this IPR. EX2016 at 114:8-118:2. Sotera does not reconcile why the Board should exclude Yanulis' cross-examination testimony in Exhibit 2016 yet consider his direct testimony in Exhibit 2015.

Third, Sotera mischaracterized Yanulis' district court opinion. Sotera argued that Yanulis' district court claim construction opinion of "separate computing

device” is “not an issue before the Board because 35 U.S.C. § 112 invalidity is not within the scope of an *inter partes* review.” Sotera’s Motion to Exclude, Paper 35 (“Mot.”) at 3. But, Yanulis did not argue that the term is invalid under § 112. *See* EX2015 ¶¶ 48, 65-69. Rather, he opined in district court that the term should be narrowly limited to only “a conventional bedside monitor.” *Id.*

Finally, Sotera is incorrect in suggesting that “[t]he ’735 Patent is equally invalid under Petitioner’s proposed construction in District Court.” Mot. 3 n.2. Masimo explained that if Sotera had applied Yanulis’ narrow district court construction of “separate computing device” in this IPR, that would have excluded the prior art in this IPR. *See* POR 20-22. Yanulis’ inconsistent testimony is critical for the Board to consider in evaluating his credibility. The testimony demonstrates that Yanulis proposed a claim construction to benefit Sotera’s noninfringement arguments in district court while offering a different opinion to benefit Sotera’s invalidity arguments here. Thus, the Board should not exclude it.

B. Exhibits 2027 and 2028 and Oslan’s Opinions Regarding Them Are Relevant to Whether a PHOSITA Would Have Been Motivated to Modify Goldberg with a Reasonable Expectation of Success

Exhibit 2027 is a Japanese Publication directed to a wrist-worn blood pressure monitor. Its filing date is approximately two years after the priority date of

Masimo's '735 Patent.¹ Exhibit 2028 are photographs of a modern-day wrist-worn blood pressure monitor that Masimo's expert, Oslan, purchased and examined. Sotera argues these exhibits and portions of Oslan's declaration relying on these exhibits should be excluded because they are not from the relevant time frame. The exhibits and Oslan's testimony are relevant to evaluate Sotera's proposed modifications to Goldberg and the Board should admit them.

Sotera argued that Goldberg's device had a sensor port between its blood pressure cuff sensor 104b and its housing 112. Pet. 26-29. Sotera also argued that that it would be obvious to add one there, if not already present. *Id.* Masimo disputed both arguments. *See* POR 37-40; EX2010 ¶¶ 78-97. As to the second argument, Oslan opined that a PHOSITA would not have been motivated to or have a reasonable expectation of success in achieving Sotera's proposed modification of a sensor port between Goldberg's cuff and housing. *See* EX2010 ¶ 97. Oslan arrived

¹ Sotera mentions in a footnote that it objected to Exhibit 2027 as allegedly lacking authentication and recognizes that Masimo served supplemental Exhibit 2036 to address that objection. Mot. 6 n.3. Exhibit 2036 was served, not filed, in accordance with 37 C.F.R. § 42.64(b)(2). Sotera's motion to exclude does not appear to argue that Exhibit 2027 should be excluded as lacking authentication. Accordingly, Masimo does not address the authentication objection further.

at that conclusion by searching for and examining wrist-worn blood pressure monitors, from both before and after the 2002 critical date, including the monitors shown in Exhibits 2027 and 2028. He analyzed how the pressure sensors, cuffs, and any connection mechanisms were implemented. *Id.* ¶¶ 88-97. Based on his research and analysis, Oslan concluded that a PHOSITA would not have been motivated to perform Sotera's proposed modification of adding a sensor port between Goldberg's cuff and housing and would not have expected success in doing so. He explained that wrist-worn blood pressure cuffs both before and after the critical date (1) were not designed with user-removable cuffs and (2) did not place the electrical pressure sensor within the cuff in such a way that would necessitate a sensor port. *Id.*

The Federal Circuit has held that the Board may consider non-prior art evidence in considering "the knowledge, motivations, and expectations of a POSITA regarding the prior art." *Yeda Research v. Mylan Pharms. Inc.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018); *cf. Nestlé Healthcare Nutrition, Inc. v. Steuben Foods, Inc.*, IPR2015-00249, Paper 76 at 12 (PTAB June 2, 2016) ("[A]n assertion that the underlying technology remained unpredictable even after the critical date of the [patent at issue] has some tendency to demonstrate that the underlying technology was unpredictable up to that time."). Here, Oslan's opinions based on Exhibits 2027 and 2028 demonstrate that a PHOSITA **would not** have been motivated to perform Sotera's proposed modifications and **would not** have had any reasonable expectation

of success because that motivation and expectation of success still would not have materialized even *after* the 2002 critical date.

Sotera also objected to Exhibits 2027 and 2028 because they were not cited in the Patent Owner Response. Mot. 4. But that fact “is not, in and of itself, dispositive as to whether an exhibit should be excluded.” *Pfizer Inc. v. Sanofi-Aventis Deutschland GmbH*, IPR2019-00979, Paper 38 at 98 (PTAB Aug. 11, 2020); *see also Apple Inc. v. Smartflash LLC*, CBM2014-00106, Paper 52 at 25 (PTAB Sept. 25, 2015) (denying motion to exclude exhibits not cited in party’s principal brief but were reviewed and relied upon by expert witness). Those exhibits form the bases of Oslan’s opinions and were disclosed in accordance with FRE 703 and 37 C.F.R. § 42.65(a). Moreover, Masimo discussed Exhibits 2027 and 2028 in its Sur-Reply. Patent Owner Sur-Reply, Paper 30, 10. Accordingly, Exhibits 2027 and 2028, and paragraphs 94-96, 98, and 100 of Exhibit 2010 are relevant and admissible.

Furthermore, Oslan’s opinions in paragraphs 94-96, 98, and 100 of EX2010 are independently admissible, regardless of the admissibility of Exhibits 2027 and 2028. Under FRE 703, “[i]f experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion on the subject, they need not be admissible for the opinion to be admitted.” An expert opining on the feasibility of a modification to a wrist-worn blood pressure cuff would reasonably rely on patents describing wrist-worn blood pressure cuffs and physical examples to fully

understand the mechanisms involved and to provide an informed opinion. These references show that the proposed modification was still not feasible well after the applicable priority date. Accordingly, Oslan's opinions in Exhibit 2010 regarding these exhibits are admissible.

C. Oslan Is Entitled to Rely on Exhibits 2024 and 2025 in Forming His Opinions, Regardless of Whether the Underlying Exhibits Are Hearsay

Sotera argues that Exhibits 2024 and 2025 are hearsay and that portions of Oslan's declaration relying on those exhibits is hearsay. Mot. 8-10. But FRE 703 expressly permits an expert to base his opinion on facts or data that would otherwise be inadmissible. Fed. R. Evid. 703; *see also Fox Factory, Inc. v. SRAM, LLC*, IPR2017-01440, Paper 62 at 76-77 (PTAB Dec. 6, 2018) (explaining that under FRE 703 "experts may rely on hearsay in forming their opinions"). Sotera provides no explanation why it omitted any citation or discussion of FRE 703 from this Motion.

Exhibit 2024 is an article titled *Human Factors Analysis of an ICU* published in 1998 in the *Journal of Clinical Engineering*. That article relates to at least two issues that Oslan opined on. First, Masimo and Oslan disputed Sotera's arguments that it would have been obvious to add multiple sensor ports to Goldberg's housing. POR 35-37; EX2010 ¶ 80. Based in part on Exhibit 2024, which explained that even nurses struggled with the problem of too many cables, Oslan opined that it would have been undesirable to add numerous sensor ports, sensors, and wires to a device meant for personal use. EX2010 ¶ 80.

Second, Masimo and Oslan also disputed Sotera's argument that additional sensor ports would have been a mere duplication of parts. POR 40-41; EX2010 ¶¶ 102-105. Again, Oslan reasonably relied on Exhibit 2024, which evidenced the types of connectors available for medical monitors shortly before the 2002 priority date, to arrive at his conclusion that sensor ports for different sensors would not have been duplicates of each other. EX2010 ¶¶ 103.

Exhibit 2025 is an article titled *Self blood pressure monitoring at home by wrist devices: a reliable approach?* published in 2002 in the *Journal of Hypertension*. Sotera and Yanulis assumed that the end-users of Goldberg's device would be clinicians in arguing a motivation to modify Goldberg with multiple sensor ports. Pet. 22-23. Masimo and Oslan disputed that underlying assumption. POR 33-34; EX2010 ¶¶ 76-78. Oslan reviewed Exhibit 2025, which explained that, in 2002, wrist blood pressure measuring devices were not recommended for clinical use. EX2010 ¶ 78; EX2025 at 575-77. Based on Exhibit 2025 and other portions of Goldberg's specification, Oslan concluded that clinicians would *not* be the intended end-users for Goldberg's device. EX2010 ¶¶ 76-78.

Exhibits 2024 and 2025 are articles from established medical and engineering journals that directly undermine the motivations and assumptions in Sotera's arguments. Under FRE 703, Masimo's expert is expressly permitted to rely on

hearsay in forming his opinions. Accordingly, paragraphs 78, 80, and 103 of Exhibit 2010 are admissible, regardless of whether Exhibits 2024 and 2025 are hearsay.

Masimo properly disclosed the entirety of Exhibits 2024 and 2025 to allow the Board and Sotera to fully assess the bases for Oslan's opinions and to allow Sotera a full and fair opportunity to challenge Oslan's opinions. *See* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."); *see also Nestlé Healthcare*, IPR2015-00249, Paper 76 at 11 ("The implication [of § 42.65(a)] is that ordinarily the underlying facts that form the basis of an expert opinion should be considered.").

Additionally, Exhibits 2024 and 2025 met the hearsay exception under FRE 803(18) as a "statement contained in a treatise, periodical, or pamphlet" that is "relied on by the expert on direct examination." Fed. R. Evid. 803(18). As explained above, Masimo's expert reasonably relied on those exhibits in forming his opinions set forth in his direct testimony declaration. Accordingly, Exhibits 2024 and 2025, and paragraphs 78, 80, and 103 of Exhibit 2010 are admissible and should not be excluded.

CONCLUSION

Sotera cannot sustain its relevance and hearsay objections for the reasons set forth above, and the Board should deny Sotera's Motion in its entirety.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 13, 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'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE** is being served electronically on August 13, 2021, to the e-mail addresses shown below:

Rudolph A. Telscher, Jr.
Nathan P. Sportel
Daisy Manning
Jennifer E. Hoekel
Husch Blackwell LLP
190 Carondelet Plaza, Suite 600
St. Louis, MO 63105
(314) 480-1500 Tel
(314) 480-1505 Fax
PTAB-RTelscher@huschblackwell.com
Nathan.sportel@huschblackwell.com
PTAB-DManning@huschblackwell.com
Jennifer.Hoekel@ huschblackwell.com

Dated: August 13, 2021

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

Attorneys for Patent Owner
Masimo Corporation

53938867