

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 REPLY IN SUPPORT OF ITS
MOTION TO EXCLUDE EVIDENCE**

TABLE OF CONTENTS

| | <u>Page</u> |
|---|--------------------|
| A. Masimo’s Attempt to Discredit Dr. Yanulis Should Be Excluded. | 1 |
| B. Exhibits 2027 and 2028 Should Be Excluded as Irrelevant Because These Exhibits Are Not from the Correct Time Frame..... | 2 |
| C. Exhibits 2024 and 2025 Should Be Excluded Because These Exhibits are Inadmissible Hearsay..... | 4 |

TABLE OF AUTHORITIES

Page(s)

Cases

Samsung Electronics Co., Ltd. v. Huawei Technologies Co., Ltd.,
Case No. IPR2017-01487, Paper 45 (P.T.A.B. Dec. 10, 2018)1

Yeda Research v. Mylan Pharms. Inc.,
906 F.3d 1031 (Fed. Cir. 2018)3

Statutes

35 U.S.C. § 1121

Rules

F.R.E. 4012

F.R.E. 4022, 3

Masimo's opposition to Petitioner's motion is without merit, as explained below:

A. Masimo's Attempt to Discredit Dr. Yanulis Should Be Excluded.

In its opposition, Masimo argued that EX2016 was critical for the Board to evaluate Dr. Yanulis' credibility. Masimo seeks to discredit Dr. Yanulis using EX2016 as alleged evidence of a supposed claim construction contradiction. Paper 36, p. 2. However, Dr. Yanulis' District Court opinion regarding the construction of the term "separate computing device" is not evidence of a contradiction, for the reasons discussed below. Because no such contradiction occurred, EX2016 is irrelevant and should be excluded under F.R.E. 401/402. *Samsung Electronics Co., Ltd. v. Huawei Technologies Co., Ltd.*, Case No. IPR2017-01487, Paper 45 at 25 (P.T.A.B. Dec. 10, 2018).

While it is true that the '735 Patent never contemplated or described an embodiment where a medical monitoring device wirelessly transmitted information to a generic computer system, Sotera is not challenging, in this proceeding, that the claims, when given their plain and ordinary meaning, lack written support under 35 U.S.C. § 112 (nor could Sotera given the limited scope of an *inter partes* review). EX1003, ¶¶ 20-24, 29-32. Instead, for the sake of efficiency in determining obviousness, Dr. Yanulis applied Masimo's construction from the District Court in this proceeding to demonstrate that Masimo's construction results in an obvious

patent. EX1003, ¶ 36. Applying Masimo's proposed construction isn't a contradiction; Dr. Yanulis simply exposed Masimo's overly broad claim language and claim construction for the invalid subject matter that it is. Indeed, the public has a right to know whether the '735 Patent is invalid under Masimo's construction of their own patent.

Masimo would like to have their cake and eat it too. Masimo asserts that the term "separate computing device" should be given its plain and ordinary meaning while also contending the '735 Patent should survive without consideration as to whether the prior art teaches that broader construction. Paper 21, p. 20. Moreover, it strains credulity for Masimo to attempt to discredit Dr. Yanulis for applying a construction they contend is the correct construction.

Because EX2016 is not evidence of a contradiction and has no bearing on expert credibility, Masimo has failed to provide any actual reason that EX2016 is relevant to this proceeding. Without even a shred of probative value, EX2016 should be excluded under F.R.E. 401/402.

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

As stated before, EX2027 and EX2028 are not prior art, were published long after the '735 Patent's priority date, and have no relevancy to Goldberg or any

proposed combinations provided in the Petition. Hence, EX2027 and EX2028 are irrelevant under F.R.E. 402.

Masimo argues that “Oslan [made his patentability opinions] 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.” Paper 36, p. 6. However, EX2028 is *not* a wrist-worn monitor; it is a stand-alone blood pressure sensor. It is unlike Goldberg in several ways – most notably, its sensor is internal while Goldberg clearly teaches an external blood pressure sensor. Masimo mischaracterizes its own evidence to salvage relevancy.

Masimo further argues that the Board can admit non-prior art evidence to considering the knowledge, motivation, and expectations of a PHOSITA regarding the prior art, citing *Yeda Research v. Mylan Pharms. Inc.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018). However, in *Yeda*, the non-prior art publication related to a study that *began before* the critical date of the challenged patent. *Id.* Thus, the non-prior art evidence in *Yeda* was actually contemporaneous evidence, whereas EX2027 and EX2028 demonstrate only *post factum* evidence. Masimo has made no contentions that EX2027 or EX2028 are contemporaneous to the priority date of the '735 Patent, nor could they because EX2027 and EX2028 do not support such a theory.

Even if the Board considers EX2027 and EX2028 for limited purposes, the Federal Circuit did not say that a *post factum* reference necessarily informs the teachings of a prior art reference, which is exactly the argument Masimo's expert made. Mr. Oslan suggested that because the blood pressure sensors of EX2027 and EX2028 are structured the way they are structured, then Goldberg must be structured identically, which is an illogical argument. EX2010, ¶¶ 94-96, 98, and 100.

Masimo doesn't use EX2027 or EX2028 for motivation purposes, they use it as evidence of what Goldberg supposedly taught, which is not a permissible usage for a *post factum* reference. Hence EX2027 and EX2028 are irrelevant.

The same reasoning applies to paragraphs 94-96, 98, and 100 of EX2010.

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

Masimo argues that EX2024 and EX2025 can be relied upon by an expert witness regardless of whether they contain hearsay. Paper 36, p. 8. However, EX2024 and EX2025 do not represent an out of court statement offered to prove the truth of its assertions; EX2024 and EX2025 are hearsay reporting hearsay.

For example, Mr. Oslan puts forward EX2024 to support his theory that ports are somehow annoying. However, EX2024 represents an author making an out of court statement reporting the feelings and reactions of users (more out of

court statements). EX2025 is similar in that it reports supposed “popularity” of some blood pressure devices. The reliability of these two documents is in question because the authors of these documents rely on hearsay for their writings.

Masimo further asserts that EX2024 and EX2025 qualify for a hearsay exception because they are allegedly one of a “treatise, periodical, or pamphlet.” However, Petitioner objected to the *statements within the references* that were reported by EX2024 and EX2025. Paper 35, pp. 8, 9. How did the author of EX2025 know that blood pressure sensors were popular? EX2024 reported statements and feelings of users, but not the statements of the speakers themselves. Without specificity, these hearsay statements lack credibility.

Because these statements within the references constitute hearsay that does not fall within an exception, the Board should exclude EX2024 and EX2025 or give these references no weight. The same reasoning applies to paragraphs 78, 80, and 103 of EX2010.

Respectfully submitted,

Dated: August 20, 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

Case No. IPR2020-00954

Patent No. 9,788,735

(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 20th 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