

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-00912 (Patent 10,213,108 B2)
IPR2020-00954 (Patent 9,788,735 B2)
IPR2020-01015 (Patent 9,795,300 B2)
IPR2020-01054 (Patent 9,872,623 B2)

Record of Oral Hearing
Held: August 26, 2021

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

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APPEARANCES:

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The above-entitled matter came on for hearing on Thursday, August 26, 2021, commencing at 1:00 p.m., EDT, by video/telephone.

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PROCEEDINGS

1 - - - - -

2 JUDGE KINDER: Good afternoon. This is Judge Kinder.
3 Good afternoon everyone and with me on the panel today are
4 Judges Cocks and Chagnon, and today we have four IPR
5 proceedings that we're going to hear oral argument in. Each IPR
6 is captioned Sotera Wireless as Petitioner versus Masimo
7 Corporation, Patent Owner and just for the record the IPR
8 numbers are IPR 2020 and the cases are 912, 954, 1015 and
9 1054. If we could real quick get a roll call. I want to see who's
10 on the line for Petitioner.

11 MR. TELSCHER: On the line for Petitioner is Rudy
12 Telscher of the law firm of Husch Blackwell.

13 JUDGE KINDER: All right. Mr. Telscher, did I say that
14 correctly?

15 MR. TELSCHER: It's Telscher but close enough.

16 JUDGE KINDER: Telscher, I apologize. Are you going to
17 be arguing today?

18 MR. TELSCHER: I will be arguing, Your Honor.

19 JUDGE KINDER: Great. Anybody else with your firm
20 today participating?

21 MR. TELSCHER: Well, with me is Nathan Sportel. If
22 there are going to be arguments over the Motions to Exclude he
23 would handle those. I guess there's a possibility he might say

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1 something but we're planning on me doing most or all of the
2 talking.

3 JUDGE KINDER: All right. Thank you. And Masimo for
4 Patent Owner, who's representing today?

5 MS. SWAROOP: Good afternoon, Your Honor. This is
6 Sheila Swaroop of Knobbe, Martens, Olson & Bear for Patent
7 Owner Masimo.

8 JUDGE KINDER: All right. Ms. Swaroop, did I say that
9 correctly?

10 MS. SWAROOP: You did, Your Honor.

11 JUDGE KINDER: Okay. Thank you very much. All right.
12 Anybody else with you today or is it going to be you arguing all
13 day?

14 MS. SWAROOP: I will be presenting today, Your Honor.

15 JUDGE KINDER: All right. Great. And I do apologize.
16 I'm -- I think ragweed right now so my allergies are acting up so
17 I do apologize if my throat's a little scratchy. First I want to let
18 you all know that the hearing is open to the public. We did have
19 a request so I think we may have one or more people here from
20 the public actually watching in or listening to the hearing.
21 Today the parties are going to each be allotted 60 minutes. If at
22 any time during the proceeding you have technical issues let us
23 know. Obviously if you drop off you probably won't be able to
24 let us know but we will hopefully realize that as quickly as

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1 possible and will pause the proceeding. When we pause the
2 proceeding we won't count that against your time, obviously.
3 Hopefully, our team is really good and they usually get people
4 back up within three or four minutes so don't panic if we happen
5 to lose connection. It's not a big deal, it does happen and if for
6 some reason the video just isn't working we also have backup
7 telephone numbers for call in that you can use. So that will
8 hopefully not happen, but just to let you know sometimes it does.

9 So one thing that we try to do is everyone mute themselves
10 until they go to talk and then we have the inevitable where we
11 always forget to unmute ourselves when we actually do start
12 talking. But for courtesy the judges and all the staff will try to
13 stay muted until we ask a question and then counsel, please mute
14 yourself if the other counsel is speaking. We have
15 demonstratives. Both sides did a good job of getting us those
16 demonstratives ahead of time and we appreciate that. When you
17 refer to those, please give the slide number that you're referring
18 to in your deck and give us maybe a second or two to pull it up.
19 We're going to be pulling things up on our work stations and we
20 want to follow you as closely as possible so a brief pause helps
21 to do that and this is probably more for us, the judges. We'll try
22 to identify ourselves each time we speak so our court reporter
23 can know who's talking and when.

24 So the Petitioner bears the ultimate burden of proof in this

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1 case and the Petitioner will go first to present their case and they
2 may also reserve some time for rebuttal arguments. So out of the
3 60 minutes looking at your time, Mr. Telscher, how much time
4 would you like to reserve for your rebuttal?

5 MR. TELSCHER: Fifteen minutes, Your Honor.

6 JUDGE KINDER: All right. So you have 45 and 15. And
7 then after Petitioner's initial presentation the Patent Owner will
8 argue its opposition and then present issue for which you might
9 bear the burden of proof. Patent Owner, Ms. Swaroop, how
10 much time would you like to allot for your rebuttal reply time?

11 MS. SWAROOP: I would like to reserve 15 minutes of
12 rebuttal for Patent Owner.

13 JUDGE KINDER: All right. So that's pretty easy for us to
14 remember. We will try to keep time ourselves. If you can keep
15 your own time as well, you know, we're going to be obviously
16 liberal with the time just because we don't have an official clock
17 behind us so we are all going to be kind of tracking that. We'll
18 let you know when there's about three to five minutes left in your
19 opening time just so you have an idea.

20 Important for these four IPR proceedings, the parties have
21 agreed to a single transcript and a single hearing so that's
22 important. The transcript will be used in all four IPR
23 proceedings. If there's any specific issue that only applies to one
24 IPR, try to let us know the IPR number that you're arguing the

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1 specific issue for. It makes things just easier at the end when we
2 have to go back and look at the transcripts and review your
3 arguments if you can.

4 All right. I think that concludes most of the formalities.
5 After the case is submitted and I say "off the record," I'd ask the
6 parties to stay on the line for just a few minutes so our court
7 reporter, Julie Souza, can ask you any questions about spellings
8 or any other things to make sure the transcript is as clear as
9 possible, and with that are there any questions at this time before
10 we begin? All right.

11 MR. TELSCHER: None from Petitioner.

12 MS. SWAROOP: And from Patent Owner.

13 JUDGE KINDER: All right. Thank you. All right. Mr.
14 Telscher, I'll go ahead and let you begin and your time will start
15 whenever you're ready to begin. Thank you.

16 MR. TELSCHER: Thank you, Your Honors and good
17 afternoon. Because the IPRs have so many issues in common
18 most of my arguments will be germane to also when I'm speaking
19 without referencing an IPR it would signal that I'm talking about
20 all of them. If there's a particular issue germane to one of the
21 particular IPRs I will mention the number.

22 I'd like to start with the patents themselves. So I have, you
23 know, one part which is kind of an introduction that I think
24 frames the issues. I'd like to start at slide 10 of our deck and

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1 then of course we will turn to the actual grounds in the petition
2 and why we believe each of the claims are obvious. So I'll give
3 you a moment to turn to slide 10 but that's where I'm starting
4 with the patents themselves and just by way of nomenclature I
5 might say '735 patent. Because all of these patents have a
6 common disclosure I'm referring to all of them for the most part
7 unless I specify otherwise, and let me know when you're ready.

8 JUDGE KINDER: I think we're there now. Thank you for
9 the pause.

10 MR. TELSCHER: So the first slide I think is a critical
11 slide. It shows you what the inventor thinks he invented. So if
12 you look to the left hand of the slide, they call it prior art and
13 you'll see that there's an SP02 sensor attached to the finger, that
14 was conventional. You'll see that there was a wire with a port
15 plugging into unit 160 around, you know, a receptacle I think it's
16 162 but you see plug 144. So there's been a lot of discussion in
17 this case about whether it would have been obvious to use a
18 sensor ported to an electronic device in a medical context.

19 The '735 patent and all of the patents here admit that ports
20 are prior art. In fact when you read these patents there are pages
21 of discussion from Mr. Oslan, their expert, talking about why
22 you wouldn't use ports in a medical device context, noise, cost,
23 things of that nature but right here in figure 1 the '735 patent
24 refers to a porting connection from a sensor to the electronic

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1 device as the prior art.

2 When you look to the right hand side of your screen you'll
3 see what the invention really was and the patent admits that
4 around this timeframe the idea of transmitting vital signs from
5 some kind of a remote monitor -- what we see here is a wrist
6 monitor but it could be something that straps to your belt -- the
7 idea of transmitting wirelessly from the patient in a monitor
8 there to the remote monitor 360 was no. The patent doesn't
9 debate that they came up with the idea of wireless transmission
10 for medical sensors and vital signs. What did they say they
11 invented, and it's the adaptor and you'll hear me throughout this
12 proceeding talking about an adaptor and that's what this patent
13 was all about. Go back and look. There were seven patents that
14 predate the patents we're talking about and for fifteen years, the
15 patents were filed in 2002, for fifteen years the patents were
16 directed to the adaptor interface. The abstract, the spec, all of it
17 was directed to the adaptor interface and you'll see that the idea
18 was instead of plugging the remote sensor, the sensor the SP02
19 sensor into the remote monitor you would then -- if you look to
20 the right side of slide 10 -- you would plug it into the wrist
21 monitor. The wrist monitor could display the vitals and then it
22 could wirelessly transmit to the adaptor and if you read this
23 patent I mean most of the figures, by far most of the discussion,
24 has to do with how do you transmit from that wrist monitor to

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1 the adaptor and that was the invention and if you're reading what
2 they were talking about and this probably was a good idea. What
3 Masimo said is look, we don't want hospitals to have to change
4 up all their equipment so instead of having the SP02 sensor
5 plugged directly into that piece of equipment, the remote
6 monitor, we're going to use an adaptor and by using that adaptor
7 now, in this wireless system, we'll work with all the hospital's
8 existing equipment and again for fifteen years their claims were
9 directed to an adaptor interface. There were no claims directed
10 to ports for combination of analog and digital sensors. So that's
11 what went on for 15 years and now we've got -- and look, all of
12 us that are on this feed right now are aware that patent owners
13 change their claims, they broaden them, they narrow them,
14 there's nuances to them.

15 What happened in this case is 15 years later the claims
16 went in a completely different direction. They were not directed
17 to this adaptor interface and what happened during those 15
18 years is that our client entered the scene in around 2013 or 2014.
19 There was a trade secret lawsuit that didn't work out as Masimo
20 wanted and in 2017 when that trade secret lawsuit ended they
21 prepared nine new patents, four of which are in this IPR. We
22 have another IPR proceeding coming up in a couple of weeks on
23 other patents. But these four were four of the ones brought in
24 2017 and so that's kind of the context for where we're at.

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1 Now, turning to slide 11. Slide 11, and as we all know
2 when you get to the new patents you can change the abstract, but
3 in continuation patents they couldn't change anything else. So
4 the spec's all the same, the summaries all the same, you know,
5 they can try to change the claims according to patent law but the
6 abstract is something they could change without creating new
7 matter and so when you look at the abstract it's different from
8 the abstract of the prior seven patents and what does it talk
9 about? It talks about wire management. So in 2017 the new
10 direction, they never tried to patent this before but this was the
11 new direction, was to have the wrist monitor 400, you've got
12 411, connecting to the SP02 sensor which is 310 and what they
13 said is by running that wire 420 perpendicularly down to the
14 SP02 sensor it prevented tangling, it was wire management and
15 this was the smarter better way of doing it.

16 Now again, for 15 years they never tried to patent anything
17 like this, but they did and I'm not saying they weren't entitled to
18 do that one way or the other, but flip to page 12. And, by the
19 way, on 11 there's no discussion about some signals are analog
20 and some are digital or ports are the big invention, it was about
21 that wire management concept we just discussed. And when you
22 switch to slide 12, Goldberg shows the exact wire management
23 concept of running a wire from the front face down to an SPO2
24 sensor that's on the finger and the new concept was blown out of

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1 the water. Akai shows the same exact thing, they're clearly prior
2 art.

3 Now again, one of the things that I mentioned is these
4 patents were never about combinations of A and D signals or
5 ports and I'm not asking the panel to take my word for it. Look
6 at the summary of the invention. I'm on slide 13, thank you.
7 Turning the page my colleague reminded me I did not signal a
8 QT, so I'll give you a moment for slide 13. Are you at slide 13?
9 Thank you. And so for slide 13, again, they describe this
10 problem. And the problem was wireless transmission of these
11 vitals was known, but boy, the hospitals would have to change
12 all of the equipment. So the idea was an adaptor and if you
13 switch to page 14, it's just more exemplary. I would invite the
14 panel to read the entire summary. I'm not going to go through it.
15 There is nothing in the summary of the invention that talks about
16 even wire management, analog and digital combinations, much
17 less specific sensors that have analog and specific sensors that
18 have digital. There's no discussion of any of that. It's all about
19 this adaptor transfer. And as I said, for 15 years seven patents
20 were all directed to that, that receiver interface. And our expert
21 goes into all of that in his expert report.

22 If you switch to slide 15. All that we're fighting about now
23 are ports, analog and digital signals, single or multi-sensor
24 embodiments, wrist monitor clipped on. When you read the

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1 patent, I mean we have got four IPRs and more briefing that we
2 can count, and if you read the patent the sum total of the
3 disclosure is minimal on these points. Why? Because that was
4 not the focus of the invention. But I want to point something
5 else out when you read this. It's what I call the "this or that"
6 patent approach. When you start to get into details that don't
7 matter, well the signals can be analog or digital. It can be ports
8 or it can be hard wire. It could be wrist monitor or it could be
9 clipped on. It could be a single sensor or it could be multi-
10 sensor. So it's what I call "it could be this or that" and when I
11 see patent owners doing the "this or that" it's because those are
12 details that don't matter; right? One skilled in the art would
13 know that you can hard wire or you could port it. One skilled in
14 the art would know you could use analog or digital signals. One
15 skilled in the art knows that if you want to measure one vital
16 sign use one sensor and one port. If you want to use multiple
17 vital signs which I think call it (audio interference) in the
18 medical context when you're monitoring certain conditions you
19 might need three to five vital signs being monitored.

20 The experts all talk about it, the prior art talks about it. So
21 the patents, and I'll give you an example. Say our client's device
22 in 2014 was hard wire. They could have delivered the same
23 claims to you and called them hard wire versus ported and they
24 would claim that was their invention because their patent talks

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1 about it being either ports or hard wire. Just poll (phonetic) the
2 options. Make it a list and it is all digital signals and they would
3 have pointed to the snippet here that says it could be analog,
4 digital or both and if our client's device was all digital they
5 would have drafted claims to all digital and then we would have
6 been on this chase to try to find prior art that specifically shows
7 these what I would consider basic design details and that's what
8 our expert testified to.

9 Slide 16. There's been a lot of discussion in these IPRs
10 about an analog SP02 sensor connecting into a monitoring
11 device, a wrist monitoring device by a port. This patent on slide
12 16 says figures 1 and 2 illustrate a conventional post-oximetry
13 system used for the measurement of blood oxygen and it shows a
14 conventional sensor plugging into a port. The sensor is typically
15 attached to the finger. If you read that first block on the left
16 hand side the sensor has a plug that inserts into a patient cable
17 socket. In this case Mr. Oslan has gone on for pages of
18 Declaration telling us why ports have noise, ports are costly,
19 they're too big but there is nothing in the '735 patent that talks
20 about any of those problems. In fact, the '735 patent says that
21 the use of ports on a medical device was known and if you look
22 to the right hand side of slide 16 from the patent again it says the
23 sensor's conventional and now here we are in an IPR arguing
24 about whether an analog SP02 sensor connecting to a port is

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1 somehow a point of novelty when the patent itself describes that
2 it is conventional activity.

3 You know, maybe Masimo's response to that would be our
4 claims are more detailed. When you look at claim 20 it requires
5 an analog SP02 sensor but it requires maybe a digital
6 temperature sensor and a digital EKG sensor. I would ask the
7 Board to read this patent. There is no disclosure of any
8 embodiment that it talks about an analog, digital or, excuse me,
9 SP02 analog sensor with a digital temperature sensor with a
10 digital EKG sensor. There's no disclosure of that anywhere and
11 I'm not making a 112 argument. I know this panel is not here to
12 consider 112. But the point is all the patent says about analog
13 and digital is that the conventional sensors can be analog, digital
14 or a combination of analog and digital. All of the experts that
15 are before you agree that conventional sensors could be analog or
16 digital or both. We all know that one skilled in the art when
17 they're monitoring patients they're going to choose do I want an
18 analog sensor, do I want a digital sensor and again I don't want
19 you to take my word for it. Look at their expert report at
20 paragraphs 110 to 115. He goes into a long description of how
21 one skilled in the art would know about analog sensors, digital
22 sensors, the benefits to one or the other and of course that's
23 right. I mean let's think about it for a second. We have analog
24 signals and digital signals. If we thought analog signals were the

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1 end-all-be-all there would be no digital signals and if we thought
2 digital signals were by far the best there would be no analog
3 signals. But we live in a world where there are analog and
4 digital signals. You have two choices. One skilled in the art
5 would know about these choices.

6 When we turn to the concept of multi-parameter monitoring
7 and I'm on slide 18 now. I'll give you a moment.

8 JUDGE KINDER: Hi, this is Judge Kinder. You can just
9 pause for a brief second or two, you don't have to give us too
10 much time. We can catch up pretty quick.

11 MR. TELSCHER: Okay. Thank you. So I want you to
12 compare the disclosure of multi-parameter monitoring in the '735
13 patent with that of Goldberg. There's the same limited
14 disclosure in both. It's uncanny. When you look at the '735
15 patent figure 4A on the left, figure 4A shows an SP02 sensor
16 ported into a wrist monitor and you can see the wrist monitor
17 411. Might be (indiscernible) 450, 410 excuse me. So it's
18 ported in. There is no figure in the '735 patent that talks about
19 how you would make three ports on the device shown in figure
20 4A. Goldberg is the same. Goldberg says exactly what the '735
21 patent says, that we can work -- and they describe seven
22 different vital sign sensors in Goldberg and they say at the top of
23 column 5, lines 3 to 8, "Our device will work with one, all or
24 some combination of that."

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1 Goldberg has the same general description as the '735
2 patent does and why is that? It's because one skilled in the art
3 would know how to build a device that has a display that fits on
4 your wrist that has at least three -- that's what the claims require
5 at least three ports. But we've got page after page after page of
6 Mr. Oslan telling this panel why one skilled in the art would not
7 think to use ports on a wrist monitor device because it would be
8 too costly. There would be noise. There would be size
9 problems. The only problem with Mr. Oslan's arguments is he
10 ignores the '735 patent. It doesn't have any disclosure at all,
11 none about how you would build something with three ports.
12 The only thing it shows is what's in figure 4A.

13 So again, I'm not here to argue Section 112 to this panel.
14 That's for District Court, but I would submit to the panel that the
15 reason why '735 and Goldberg don't get into that level of detail
16 is because by 2002 one skilled in the art knew that they could
17 build a wrist monitor that would wirelessly transmit vitals to a
18 remote computer and you could put at least three sensors ported
19 to it and probably more. But they knew it, but let's say that it
20 was going to be the problem that Mr. Oslan says. Well, where
21 does the '735 patent explain the size, noise and cost issues with
22 this three port wrist monitor? And by the way when you look at
23 the left hand side of figure 4A on slide 18, I mean you can look
24 at that. I mean it's hard to image that you wouldn't have to make

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1 that bigger if you were going to put three ports on it. One
2 skilled in the art is going to understand if you want to put three
3 ports that it's going to get bigger and you're still going to put it
4 to the wrist just as the '735 patent says. It doesn't show a three
5 port embodiment, it just says in passing you can monitor more
6 than one vital sign. I don't even think that it says three. I think
7 that the claims talking about three is not something the patent is
8 even talking about, it's some magic number.

9 JUDGE KINDER: This is Judge Kinder. Really quick
10 question.

11 MR. TELSCHER: Yes, sir.

12 JUDGE KINDER: So I, and I'm thinking of the column in
13 Goldberg that talked about using multiple types of sensors and
14 one was I think pulse ox and then it said it could at least be used
15 with others. Does it contemplate using two at once? At least two
16 different types of sensors at once?

17 MR. TELCHER: Yes, it does. So column 5, lines 3 to 8,
18 very short passage. It says, and by the way this is column 5. If
19 you read the previous three to four paragraphs of Goldberg
20 starting on column 4 it describes EKG sensors, SP02 sensors,
21 respiratory sensors, all the common vital signs that doctors need
22 to monitor and then when it gets to the top of column 5 it says,

23 "Our invention will work with one, all or any combination
24 of them."

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1 And that's exactly what really the '735 patent says. The
2 '735 patent gives no more detail than that. Why is it? Because
3 doctors think, let's be clear Masimo and Sotera are not telling
4 doctors what vital signs to monitor. You're a doctor and my
5 patient's got diabetes, I know the signals I've got to monitor. If
6 they've got a heart condition I know the signals they've got to
7 monitor. All that Goldberg, Masimo and even our client Sotera
8 are doing is delivering a device that allows them to plug in
9 sensors that allow them to monitor the vital signs they need. But
10 Goldberg is explicit that it could be all of them and he lists at
11 least seven and says others, and again this is what doctors need.
12 I mean the invention of the '735 patent wasn't directed to new
13 sensors, it wasn't directed to combinations of sensors. There's
14 no disclosure of any of that. What was the '735 patent directed
15 to? An adaptor that allowed you to wirelessly connect to an
16 adaptor on a remote station so that the existing hospital
17 equipment could be used. Just one second. I'm getting a cite
18 here. And also from the '904 patent, Goldberg and it's column 4
19 there's another citation to what he's given. In column 4, line 50,

20 "The sensors 104 are positioned as to sense physiological
21 characteristics of the monitored person. In the preferred
22 embodiment the sensor 104 an be associated with one or more of
23 the monitored person's blood pressure, pulse, oxygen hemoglobin
24 saturation, glucose, body temperature, respiration and

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1 electrolyte."

2 So clearly Goldberg in at least two places now
3 contemplates monitoring multiple signals and again, Your Honor,
4 any system that would be usable in a hospital would have to
5 monitor more than one system in a lot of applications. Does that
6 answer the question?

7 JUDGE KINDER: Yes, thank you. I know you'll probably
8 get into more of the size and configuration argument but you
9 would at least have to admit if it's going to be a wearable device
10 there probably is a limit though in the number of ports it could
11 have in the size; right?

12 MR. TELCHER: Of course there would be, Your Honor.
13 You know, and one skilled in the art is going to know what are
14 the size of ports, what are the electronics that it takes to
15 interface and they're going to be able to figure that out. But I
16 want to point something out to you. When you look at figures 13
17 and 14 of the '735 patent which is their multi-port embodiment,
18 Masimo says sensor one, sensor two and then it's got sensor to
19 the nth degree. So Masimo in the '735 patent doesn't try to place
20 a limit on it. They says there could be the nth degree of sensors
21 in figures 13 to 14 and again the reason for it, it goes right to
22 your question. One skilled in the art is going to know that if you
23 get to a certain number of ports that it's going to be too many.
24 But certainly that number of ports is not three which is what the

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1 claims require. Maybe we would have an interesting question if
2 we got to eight or nine ports but let's turn to slide 31 when you
3 get a chance. I'm going to skip a little bit here to answer your
4 question with something different, and I'll assume that you're
5 there.

6 So on the right hand side of slide 31 to the very far right is
7 Money. It's labelled at the bottom, it says "Money Exhibit
8 1008." Money was 1994. So remember that Money is 1994 and
9 as of 1994, and we all know electronics get smaller and faster
10 over time, as of 1994 we had this unit. It doesn't say whether it's
11 monitored to a wrist or monitored to the patient some other way,
12 but it's 1994 and it's one inch thick and six inches long and three
13 inches wide, and they say roughly that and not more than that
14 and not more than a pound and that's 1994.

15 Now on that same slide go over to Kiani which is the
16 second one. So this is a medical monitoring device in 1999, just
17 five years later, and in 1999 Kiani shows three ports and
18 admittedly they're not all sensor ports. But it doesn't matter.
19 The point that you're asking is how many ports can you have on a
20 device and still have it be portable? Have it be small enough?
21 So as of 1999 Kiani shows a device with three ports and when
22 you look at Kiani there's plenty of room for more ports. It's not
23 like Kiani ran out of ports. That's all the ports they needed for
24 that invention because it was some kind of an adaptor type patent

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1 in the medical field for vital sign monitoring of SP02.

2 But now look to your right, 1997. By 1997 Akai clearly
3 shows a device that can monitor multiple signals with a housing
4 that fits on the wrist by 1997 and then if you look to the far left
5 you've got Goldberg. This is 2001 and by 2001, and all of the
6 experts in this case agree that electronics were getting smaller
7 and faster over time. I can cite you to Oslan's declaration which
8 is paragraph 98 of Oslan specifically talks about how electronics
9 have gotten smaller over time. Our expert, Yanulis, also talked
10 about how electronics have gotten smaller over time and when
11 you look at what I have on slide 31 we see this kind of
12 progression of miniaturization and one of the things that Masimo
13 said that they tried to claim that we didn't argue that, for
14 example, Money could have been made smaller by 2002, that one
15 skilled in the art wouldn't appreciate it. But I would like to tell
16 the Court that at page 96 of our petition at least we specifically
17 say that alternatively Akai teaches a housing size and shape to
18 secure to the wrist and so when you look at paragraph 294 of
19 Yanulis's declaration a POSITA would have been motivated to
20 modify Money's housing in view of Akai so that the housing
21 would secure to a patient's wrist. Paragraph 54 and 190 of
22 Yanulis's declaration, he talks about describing the natural
23 miniaturization of electronic devices over time.

24 So you asked a great question. By 2002 which is the filing

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1 date of this patent we see Money 1994, we see Akai 1997 which
2 is already showing wrist mounted with multiple signals. We've
3 got three points on Kiani by 1999 and by 2001 you've got
4 Goldberg saying seven. So as electronics get smaller and faster,
5 we're able to put more ports on. But to answer your question,
6 one skilled in the art is readily going to know how big are the
7 ports, how big must my device be, taking in signals I need
8 processing circuitry, I need a controller and I need to wirelessly
9 transmit. I've got to put all of that in a housing, how big can it
10 be? What cannot be disputed is by 2002, the filing date of these
11 patents, three ports would have been simple. Kiani shows three
12 ports in 1999.

13 Just switching back to where I was. And again the one
14 point that I think is really critical here. There is no disclosure in
15 the '735 patent of an embodiment that has three sensors and three
16 ports on a wrist watch. What they say is our wrist watch could
17 accommodate more sensors. You could have as many sensors as
18 you need is what they basically say. Obviously there are limits
19 but we all know that. But I mean the gist of it was, and as I said
20 figures 13 and 14 show sensor to the nth degree. The disclosure
21 in '735 is no different than the disclosure in Goldberg and yet
22 Mr. Oslan says that one skilled in the art would think that you
23 couldn't build one of these with three ports in 2002. Even
24 though there's no disclosure in the '735 patent of that and the

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1 reason I would submit to Your Honors it's not a 112 issue, it's
2 because one skilled in the art as of 2002 would have had almost
3 no difficulty designing a wrist monitor device that fits on the
4 wrist comfortably that would monitor at least three, and as
5 Goldberg says up to seven.

6 I think the prosecution history here is also important at
7 page 22. At page 22 the primary reference that was being used
8 by the examiner to reject the claims of the '735 and the others
9 was Amano and Amano was an exercise watch. So it was a
10 watch, wasn't a healthcare device and it had a SP02 sensor that
11 would go from the side of the watch -- I'll get you a figure in a
12 second, you don't have to use your imagination here. I will get
13 to the figure -- but it had a sensor connecting into the watch and
14 what's important is the examiner, one of the big arguments on
15 Goldberg which we disagree with, they say Goldberg's limited to
16 household use. Let me be clear. The Patent Office relied on
17 Amano which is not even a medical monitoring device of sorts,
18 it's more of an exercise watch to check your pulse rate or oxygen
19 rate. I think it's pulse rate actually. But Amano was an exercise
20 watch.

21 So when you turn to slide 23 and slide 23, and it goes kind
22 of to your question, Your Honor, Masimo tried to argue that
23 Amano only shows one port and we're talking about multiple
24 ports and it wouldn't be obvious to add more ports to Amano, and

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1 the examiner said no. Of course it would be obvious. If you
2 want to monitor more signals you would just make more
3 connections to Amano. So he rejected the multi-parameter
4 argument and if you turn to slide 24.

5 So the examiner's rejecting the notion that multi-parameter
6 could be patentable. The examiner's rejecting the notion that
7 Amano is for exercising and Masimo's for hospitals. It all
8 related to monitoring a vital sign. Monitoring vital signs is
9 monitoring vital signs. So how did they get the patent allowed
10 over the Amano rejection? Well, in slide 24 what they said is,
11 and it's underlined at the bottom, they had the language the wired
12 connection on figured to extend from the first sensor port along a
13 path substantially perpendicular to the first side of the housing
14 and if you remember from slide 10 which is the figure, all it is it
15 means that when you have the Masimo monitor on your hand
16 you've got a wire that extends down your wrist and essentially
17 hooks to your finger. It was the wire management concept and if
18 you remember when we looked back to the abstract to these new
19 patents that were again, patented 15 years later, they shift their
20 focus to wire management. If you run a wire perpendicularly
21 down your wrist it uses less wire and that's how they got it done
22 and it's because the wire connection configured to extend from
23 the first sensor port along a path substantially perpendicular.
24 First sensor port along a path of the first side, so look at the

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1 language first side. If you look to the left you've got Amano.
2 Amano's wire did not extend from the first side. It extended
3 from not the side facing the hand but the side that faces away
4 from the hand if you can see that. Now it seems -- that seems
5 like a very thin way to get a patent allowed but it doesn't matter
6 because the prior art shows that in Goldberg and Akai. But that's
7 the language they used to get this patent allowed.

8 When you turn to slide 25, the same types of arguments
9 they're trying to make here were rejected by the Patent Office.
10 So if you look at slide 25, the first reason they said Amano didn't
11 matter is because -- and you're going to hear this, I've already
12 seen it in their slide deck -- you're going to hear it today from
13 Masimo. We're a hospital and hospitals have all these stringent
14 requirements and the equipment that would be used in a hospital
15 you couldn't take guidance from Amano's wrist monitor or wrist
16 watch that senses the vitals. Patent Office said no. It's
17 measuring a vital sign. You're going to hear the same arguments
18 about Goldberg. They're going to argue long and hard that
19 Goldberg is limited to the home environment. Now I will
20 disagree that it's limited to the home environment because even
21 as their expert cites, column 2 of Goldberg says it's to be used
22 also by medical care professionals, healthcare professionals. But
23 even if it were true that Goldberg was limited to the house some
24 way and that medical professionals would not be involved at all,

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1 the Patent Office has already rejected the notion that because it
2 was for vital signs measured in the household it wouldn't be
3 relevant to the design of a system for a hospital and that's not to
4 say the hospital might not get into more complicated electronics
5 but these patents have nothing to do with more complicated
6 electronics. They have to do with basic design features.

7 So if you turn to slide 26. The examiner ultimately allowed
8 -- oh, here's where he rejects it. I'm going to skip that. I want to
9 go to slide 27, excuse me, because my time is running low. If
10 you turn to slide 27 he says two things. The prior art does not
11 teach a port in conjunction with two additional ports and he says,
12 and it has to do with that wire configuration, so he allows it
13 under wire configuration and the wire that runs perpendicularly
14 down and then he also allows it because the prior art he said does
15 not show one device that has both an analog and a digital vital
16 sign thing which I don't even understand why having one sensor
17 that's digital and one that's analog would make any difference. A
18 sensor can be analog or digital. It's what the '735 patent says. It
19 could be analog, digital or both. But that's what the examiner
20 found, but the prior art of record refutes both of the examiner's
21 reasons for allowance.

22 Goldberg, and now I'm on slide 28, Goldberg expressly
23 shows a wire running perpendicularly down to the cuff. If you
24 look to the right Money undeniably shows a device that has both

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1 analog and digital signals. So the examiner's reasons for
2 allowance have been completely rebuffed. What is Masimo's
3 response going to be on the Money one? I know exactly what it's
4 going to be. They're going to say that Money shows an SP02
5 sensor that's digital and the rest are analog and their idea is to
6 have an SP02 sensor that's analog and the rest digital, and I'm
7 simplifying and the claims get more specific but that's -- there is
8 no disclosure in the '735 patent at all of the combination that is
9 an SP02 sensor that is analog and a thermometer and an EKG or
10 something like that that are digital. None. There's no disclosure
11 of that at all.

12 You might say well, where did they get that combination
13 for these claims from? Our client's product. They drafted claims
14 in 2017 that were intended to read on our client's product and
15 they're now claiming that this combination of analog and digital
16 is patentable. You know, the patent doesn't say anything --

17 JUDGE KINDER: This is Judge Kinder.

18 MR. TELSCHER: Yes, sir.

19 JUDGE KINDER: A real quick question. For the priority
20 date time in 2002 what was most -- is it in the record? Do you
21 have any evidence? What was most common for an SP02 sensor
22 in that time frame?

23 MR. TELSCHER: Well first of all, Your Honor, the '735
24 patent itself says that the SP02 sensor was conventional. So the

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1 analog sensor would have been conventional by their own
2 admission. Both experts, all experts, three experts of record
3 agree that analog and digital sensors were common and that's the
4 whole point. One skilled in the art is going to say do I want an
5 analog or a digital? I told you their own expert, Oslan, at
6 paragraphs 110 to 115 says specifically that the difference
7 between analog and digital sensors predating this patent were
8 well known in the art and they were. I mean we're talking about
9 analog and digital and Akai and Kiani show analog SP02 sensors.
10 There is no debate that there were both analog and digital
11 sensors and I can give you more cites on that too. It's in both
12 expert reports. There is no debate on this record that prior to the
13 date of this invention there were both analog and digital sensors
14 for any sensor type and our expert expressly says that in his
15 declaration and there's no debate about that. I don't think there's
16 any debate on this record about that.

17 But to be clear again, the '735 patent never discusses that
18 there was this, for example, let's say that Masimo really thought
19 this was inventive. Here's how the patent would read. The patent
20 would say look, heretofore the art had used digital SP02 sensors
21 and the analog thermometer and EKG sensors. We have realized
22 that there's some synergy if you reverse that. Our idea is to
23 reverse it and we're going to now use an analog SP92 with digital
24 temperature and EKG and that's our invention and then they

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1 would explain to you why that produces a synergistic result.

2 But I want to back up just to a point of common sense here.

3 When I'm measuring SP02 I can use an analog or a digital. The
4 '735 describes an analog SP02 as conventional. I can use analog
5 or digital, it's my choice. Money shows a digital SP02. The '735
6 talks about a conventional SP02. But I'm measuring oxygen
7 saturation with an SP02 and I'm a doctor. I want to measure
8 temperature. There is no interrelationship between whether I use
9 an analog or digital sensor to measure temperature. It's -- they're
10 independent. There's no relationship. If you read their expert
11 report they keep talking about this unique combination of analog
12 and digital. They don't even explain why it would matter. There
13 is no interrelationship between measuring SP02 and measuring
14 temperature. They're completely different vital sign measuring
15 points. So, and again there's no disclosure of this. They do not
16 explain how this combination could be patentable. They just say
17 that it's not shown in the prior art. Their patent doesn't disclose
18 it and all the experts agree, including their expert, that analog
19 and digital sensors were known.

20 I would turn you to slide 29. This goes to your point, kind
21 of at least. Their expert admits that even as a grad student he
22 was teaching both analog and digital circuits which would have
23 been back in the 80s. My background's electrical engineering. I
24 was taught the same thing in the 80s. This is the most basic of

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1 basic and the MPEP actually, and I don't know if I have that cite,
2 the MPEP actually has a section directed to the fact that
3 switching between these signal types is not patentable. It's in
4 our slide deck somewhere. Slide 49.

5 JUDGE KINDER: While you're looking at that, this is
6 Judge Kinder. You have about, in your opening you have about
7 five minutes or so, so you're welcome to cut into your rebuttal
8 time but I just wanted to let you know.

9 MR. TELSCHER: Thank you, Your Honor. So on slide 49
10 it says modification of the signal type is a mere reversal of parts
11 and that's what were talking about here. One skilled in the art
12 certainly by 2002 and well before, if they wanted to use an
13 analog sensor they'd know how to do it. If they wanted to use a
14 digital sensor, they'd know how to do it. You know, you've seen
15 arguments in the record from Masimo about Akai's got a fiber
16 optic cable and you couldn't use a fiber optic cable with a wire.
17 The bottom line there are fiber optic cables. There are analog
18 cables that are digital cables. One skilled in the art if they want
19 to use a fiber optic knows how to interface a fiber optic into
20 their monitoring system and if they want to use an analog system
21 they can interface or analog in. One skilled in the art is not
22 going to have any problem with the sensors. The '735 patent
23 describes the sensor as conventional. There is no disclosure in
24 the '735 patent about a particular sensor type being patentable or

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1 a sensor type being analog or digital and that's patentable.

2 That's not in there.

3 If you look at slide 50 and that answers your specific
4 question. It's a cite to the record where, you know, our expert
5 says that analog and digital sensors were well known. Our other
6 expert, Bergeron, also says the same thing. Oslan does not

7 disagree that analog and digital sensors were both known. Both
8 Goldberg and the '735 patent describe sensors of all types,

9 analog and digital and as we pointed out there's only two types
10 of electrical signals, analog and digital. So if we were to grant

11 patent protection on, you know, somebody has an analog for

12 SP02 or they've got a combination, Masimo could come up with

13 five more patents that have different combinations of analog and

14 digital. None of these combinations are described in the '735.

15 The only support for any of these claims would be one statement,

16 the sensors could be analog, digital or mixed and from that one

17 statement they're not creating combinations. So if that's the

18 basis for the combination that's in SP02 that is analog and then a

19 digital that's digital, and a EKG that's digital well they can make

20 up any combination they want off of that one sentence and they

21 could have a patent that's directed to these are analog and those

22 are digital or they're all digital or they're all analog and that's,

23 you know, everybody else in the industry has got to try to design

24 around these specific combinations and you might go why

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1 wouldn't the prior art talk about it. It's the same reason they
2 didn't talk about it. The '735 patent doesn't talk about it.
3 Goldberg doesn't talk about it because it's a basic design detail.
4 None of these patents were directed to whether you're using
5 analog or digital signals. What was it directed to? An adaptor
6 system so that you could connect into existing hospital
7 equipment. How much time do I have left? I'm going to rest
8 unless you have further questions for me.

9 JUDGE COCKS: Mr. Telscher, this is Judge Cocks. I do
10 have a question. You mentioned both sides' experts quite a bit
11 today and you haven't mentioned, I believe Patent Owner had
12 expressed that Dr. Yanulis was -- doctor or mister, I don't recall
13 -- had taken some inconsistent positions between District Court
14 and the proceeding here. I'd like to get -- I don't see that you
15 had necessarily addressed that assertion in a reply so I'd like to
16 get your take on that and specifically with respect to the claim
17 feature of a tail.

18 MR. TELSCHER: I'm not aware of any inconsistency on
19 that. I was aware of an inconsistency, Your Honor, that related
20 to claim construction and we did address that by saying we had
21 different claim construction in the Federal Court and we were
22 saying claim construction didn't matter here. So we disagree that
23 there was an inconsistency on that. As to the tail, the only thing
24 I can say about a tail is we did not know what a tail meant and I

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1 don't know that I've seen Masimo explain what tail means. We
2 think a tail just means a wire. So if there's a specific
3 inconsistency I'm happy to address it but on any of the material
4 points I'm not aware of an inconsistency. But if Masimo reminds
5 us all of what that is I'm happy to address it in my rebuttal.

6 JUDGE COCKS: Okay. Thank you. So just to be clear,
7 there is no -- in your view there's no inconsistency. Tail can
8 mean a wire. I think I just heard you say that and I believe you
9 expressed that in your petition.

10 MR. TELSCHER: That's our position. We think a tail's a
11 wire and I don't really know how that would compare because all
12 we're talking about -- so the tail is the part, so imagine the SP02
13 sensor that's on your finger and that wire, that's the tail that
14 comes and connects it to the wrist monitor. It's a wire so I don't
15 know that there's a big debate on whether a tail or a wire going
16 from that SP02 sensor to the wrist monitor is a patentable
17 distinction. So I'm not aware of that being a big issue but if
18 Masimo corrects me on that, I'll be happy to address it in my
19 rebuttal.

20 JUDGE COCKS: All right. Thank you.

21 JUDGE KINDER: This is Judge Kinder.

22 MR. TELSCHER: Thank you.

23 JUDGE KINDER: I guess I have one question and it's the
24 construction of "sensor port" or "sensor communications port"

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1 and I believe we invited the parties to address this, and I
2 appreciate that they did. It was your position that really no
3 construction was needed and I'm trying to figure out essentially
4 why under the proposed combinations we would need to construe
5 "sensor port" because whether or not Goldberg is hard-wired or
6 it could be a port, don't your secondary references specifically
7 go to the port being removable?

8 MR. TELSCHER: Your Honor, that's been our position all
9 along. The only reason claim construction got opened up as best
10 I can tell is in the Institution decision you said if either party's
11 saying there's a special meaning to the sensor port you should
12 define it. Then Masimo in their Patent Owner response
13 following Institution said we don't think there's special meaning.
14 It's plain and ordinary meaning but then they went on to define it
15 and then I don't even know that we should have done it, but then
16 we started talking with them about -- I mean if you go look at
17 slide 13 of their expert's report where they cite the dictionary
18 definitions technically a port does not have to be removed. I
19 think in the more normal sense of a port it's removable but even
20 if you look at slide 15 of their deck, the dictionary definitions
21 don't require removable. It does not matter. We've got prior art
22 all over the place here that shows ports that are removable so
23 you do not need to reach that issue.

24 JUDGE KINDER: This is Judge Kinder. The issue would

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1 be relevant if you only had Goldberg alone though. right?

2 MR. TELSCHER: No, I do not agree with that respectfully.
3 Our position has been Goldberg specifically says that the means
4 for connecting the sensor to the wrist monitor are known to those
5 skilled in the art and there's really only two to do it, hard wire or
6 ports.

7 JUDGE KINDER: Okay.

8 MR. TELSCHER: So we believe that Goldberg does teach
9 it but Kiani clearly shows it and again I'll remind the Court that
10 the '735 patent itself in figure 1 lends support to the prior art.
11 So I don't know that there could be anything more basic than the
12 use of ports to connect sensors to monitoring equipment in
13 hospitals.

14 JUDGE KINDER: Okay. So but your position is Goldberg
15 is not used alone. You always use it with Kiani and Kiani, I
16 believe its element 550 shows an actual sensor port under either
17 party's definition?

18 MR. TELSCHER: It does three ports, not just one: three.
19 One sensor port, excuse me, and then two other ports which we
20 could debate on what they are but they're ports.

21 JUDGE KINDER: Okay. Thank you.

22 MR. TELSCHER: So not only does Kiani show a sensor
23 port but it shows that from a size perspective you could have
24 three ports.

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1 JUDGE KINDER: Thank you.

2 MR. TELSCHER: Thank you, Your Honor.

3 JUDGE KINDER: All right. I think that's it. You have
4 about ten minutes or so for rebuttal, and we'll go ahead and
5 transition to the Patent Owner's opening case and Mr. Swaroop,
6 as soon as you're ready you can go ahead and we'll start your
7 time whenever you're ready. Thank you.

8 MS. SWAROOP: Thank you, Your Honor. This is Sheila
9 Swaroop, counsel for Patent Owner Masimo Corporation. As
10 Your Honors may know, Masimo is an innovator in patient
11 monitoring and in fact has been innovating for many years and
12 that's really important because the patents here claim priority
13 back to 2002 during a time in which hospital grade monitoring of
14 patients was done with large bedside monitors, not the wearable
15 devices claimed in the patents at issue or what you may all be
16 familiar with today.

17 Now we heard a lot from Petitioner's counsel about the
18 disclosure of the Masimo patents but that's not what this
19 proceeding is about. The deficiency of the disclosure of
20 Masimo's patents is not at issue. What is at issue is whether
21 Petitioner can show by a preponderance of the evidence that the
22 prior art that it has set forth in this proceeding demonstrates
23 obviousness of the challenged claims. In an attempt to support
24 that obviousness challenge we believe that Petitioner Sotera has

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1 greatly oversimplified the claim language and uses hindsight to
2 combine the prior art.

3 The record is also clear that Sotera has made numerous
4 shifts in its arguments from what they had originally presented in
5 the Petition and I do have a couple of comments on Sotera's
6 slides that I wanted to address before I go to my slide deck. I
7 also wanted to answer Judge Cock's question about the tail
8 limitation and Your Honor is correct. Dr. Yanulis did take
9 inconsistent positions with regard to the tail limitation that is in
10 our Patent Owner response, I believe it's around page 22 and the
11 inconsistency was that in District Court Dr. Yanulis had opined
12 that he had no idea what a tail meant. But in this proceeding he
13 did offer opinions about what a tail meant and in his mind he
14 differentiated it from a cable or a wire. So from a auxiliary
15 cable, I believe was the distinction here.

16 JUDGE KINDER: This is Judge Kinder. Let me ask you a
17 question I guess point blank then. What is a tail if not a wire?

18 MS. SWAROOP: So, Your Honor, the specification of the
19 patents describe the tail as coming from the sensor directly and
20 so I think the patent specifically, and I can find this the cite in
21 the specification.

22 JUDGE KINDER: I think I've read that part of the spec and
23 it just says, you know, how it's directed out of the sensor --

24 MS. SWAROOP: Yes.

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1 JUDGE KINDER: -- so it sounds like it could just be a
2 normal wire, right?

3 MS. SWAROOP: It's differentiated from the auxiliary
4 cable 420 at column 5, lines 43 through 45 of the specification
5 and it explains that the sensor 310 can have a tail that connects
6 directly to the wrist worn module instead of the auxiliary cable
7 connector which would have a connector to the wrist worn
8 module (indiscernible) direct connection.

9 JUDGE KINDER: Okay. Thank you.

10 MS. SWAROOP: Your Honor, if we could go to slide 18 of
11 Sotera's presentation. This is where Petitioner's counsel had a
12 side-by-side comparison of the Masimo patent and Goldberg.
13 Let me know when you're there.

14 JUDGE KINDER: This is Judge Kinder. You can presume
15 after a quick pause, you can go ahead and go on. We'll find it.

16 MS. SWAROOP: Okay. Thank you. And what we heard
17 from Petitioner was that the disclosure in the Masimo patent and
18 the disclosure in Goldberg was virtually identical. I think we
19 heard him say over and over again the disclosures are the same.
20 But there's a huge difference between the Masimo patents and the
21 Goldberg disclosure and the issue is that Goldberg does not
22 disclose a port and that is undisputed. Their own expert, Dr.
23 Yanulis in Exhibit 1003 paragraph 72 stated that, "Goldberg does
24 not expressly teach a port."

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1 But I think that's a pretty big difference between Goldberg
2 and the Masimo patents here.

3 JUDGE KINDER: This is Judge Kinder. Why is that
4 relevant? Presume we agree with you that Goldberg is hard-
5 wired or as their expert talked about it, you know, presume that's
6 relevant. They explicitly rely upon Kiani to teach a port, so why
7 is it relevant, unless for some reason the hard-wire connection
8 wouldn't be compatible with a port of Kiani?

9 MS. SWAROOP: It's relevant, Your Honor, because their
10 first argument was that Goldberg somehow implicitly teaches a
11 port and we disagree with that, and if they can't show that
12 Goldberg teaches a port then they do need to go to Kiani and
13 show that there's a motivation to combine Goldberg which is a
14 device that a user wears, and we'll go into the context of
15 Goldberg, with Kiani which is not a wearable device. Kiani is a
16 handheld embodiment and their motivation for combining
17 Goldberg with Kiani falls apart and we have explained that --

18 JUDGE KINDER: Okay.

19 MS. SWAROOP: -- and with Mr. Oslan.

20 JUDGE KINDER: So, this is Judge Kinder again and I
21 think, you know, based upon what the Supreme Court said we
22 limit petitions pretty strictly to what they claim. There's no
23 grounds with Goldberg alone, absent Kiani, so that's kind of the
24 point I'm making. I don't think we're going to look at Goldberg

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1 alone, we're going to look at the combination because that is the
2 grounds they put forth. I know they did make arguments that
3 Goldberg alone would be sufficient but their actual grounds have
4 Kiani so I think that is where we're at.

5 MS. SWAROOP: And certainly we believe that they have
6 not established sufficient motivation to combine Goldberg with
7 Kiani and again we heard a lot of arguments about ports and
8 (indiscernible) and ports were known, but this obviousness
9 combination was very specific with regard to the ports and in
10 particular the second sensor port allegedly in Goldberg being the
11 blood pressure sensor and whether that in fact is a port -- there is
12 a port there whether there'd be a motivation to include a port
13 there. That's a very specific argument that we didn't hear
14 anything from Petitioner's counsel about, but that is a critical
15 part of their obviousness case which we think they have failed on
16 as well. And I will address that as well.

17 I did want to also briefly address Petitioner's counsel's
18 comments on the prosecution history and we heard a lot again
19 about the prosecution history and if we go to slide 27 of
20 Petitioner's deck they have excerpted and selectively highlighted
21 the examiner's statements for allowance and you heard from
22 Petitioner's counsel that it was the positioning of the port and the
23 combination of signals that the examiner relied on. But if you
24 look at the unhighlighted portion and you look at what the

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1 examiner actually said it was clear that the examiner was talking
2 about the lack of teaching in the prior art, not only with regard to
3 positioning of the port and in conjunction with these other
4 features but also expressly relied on the fact that it was that in
5 combination with the other claim features and that's the third line
6 that was unhighlighted from Petitioner's slide deck. So I think
7 it's important to understand that the statements for allowance did
8 not rely on one point of novelty or one particular feature, it was
9 a combination of features recited in the claim and it's a
10 combination of features that needs to be analyzed here in
11 assessing whether Sotera has met its burden.

12 And then finally if Your Honors could turn to slide 31 of
13 Petitioner's deck, this is where Petitioner has included images of
14 some of the key pieces of prior art across the four IPRs and I
15 think this is a good slide because it allows us to really
16 understand the deficiencies in Petitioner's obviousness
17 challenges here. So on the left we have Goldberg and as we have
18 discussed and I think we all agree now, there is no showing of
19 ports in Goldberg. We certainly have put evidence forth from
20 our expert, Mr. Oslan, that there is no port shown at all for the
21 blood pressure cuff. The context for Goldberg is home use, not
22 by clinicians and Petitioner's counsel has relied very heavily on
23 its figure 2 schematic of Goldberg to imply port and to imply
24 that there is a port even in the blood pressure sensor cuff

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1 configuration, when in the briefing themselves in their reply at
2 page 7 they admitted that Goldberg lacks details. Then we turn
3 to Kiani which is shown here in figure 5 which is --

4 JUDGE KINDER: I'm sorry to interrupt. This is Judge
5 Kinder again. I think your expert addressed this a little bit, but
6 what if not a port or not hard-wired, what other options would
7 there be for that connection in Goldberg?

8 MS. SWAROOP: Well, it's not clear that there would be a -
9 - Your Honor is asking about the blood pressure sensor?

10 JUDGE KINDER: Not necessarily 104 but all of the port,
11 all of the SP02 sensors in Goldberg, the wire running in, what
12 would it be if not a port or not hard wired? Are there any other
13 options?

14 MS. SWAROOP: So, Your Honor, with regard to that
15 sensor that's running from the monitor to the sensor, I believe
16 one expert talked about it, the hard-wired versus the ported
17 connection. I think you're right on that. But 104B which is the
18 blood pressure cuff sensor is the one that Sotera also needs to
19 show a port for and we don't believe there's any port shown in
20 104B or any motivation to add a port there and that is the second
21 sensor port that they relied on for their obviousness combination
22 here.

23 JUDGE KINDER: Okay. I think I understand you have
24 separate arguments for 104B because of the positioning on the

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1 rear and the structure would be somewhat impacted. But I guess
2 my question was broader and, you know, looking at the Supreme
3 Court and the case law it looks like we have one of two options
4 here essentially, is that right? It's either a hard-wired connection
5 or a ported connection.

6 MS. SWAROOP: Well --

7 JUDGE KINDER: It's part of their argument, right?

8 MS. SWAROOP: Well, I think if you look at it and I think
9 it's in their slides Goldberg also discloses a wireless connection
10 as well. So it's not necessarily just hard-wire or ported,
11 Goldberg itself describes wireless and I can point you to the cite
12 and that I actually believe it's in Petitioner's slides here.

13 JUDGE KINDER: I agree with you and I think I remember
14 that part but, you know, looking at the SP02 sensor that has the
15 wire running into the device, that particular connection is either
16 going to be hard-wired or ported. is that right?

17 MS. SWAROOP: Well again, I think that there's also -- it's
18 contemplated a wireless as well. There's a disclosure I think it's
19 column 4, lines 27 to 29 of a wireless configuration.

20 JUDGE KINDER: But as we --

21 MS. SWAROOP: So I think that's another option.

22 JUDGE KINDER: Yes, I agree with you. But in figure 2 it
23 actually shows a wire so I don't think that would be wireless
24 showing a wire.

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1 MS. SWAROOP: That's correct, Your Honor, and --

2 JUDGE KINDER: Okay. Thank you.

3 MS. SWAROOP: -- so it would be, and I think if I, and as I
4 think our expert explained, it would be hard wired or ported in
5 that particular sensor, but again I think it's important to
6 remember that all of the claims here require multiple sensor
7 ports and that Sotera has explicitly relied upon the blood
8 pressure cuff sensor 104B to be the second sensor port
9 configuration and there is no port in that 104B and our expert
10 explained that we would not be motivated to include a port there.

11 JUDGE KINDER: Understood.

12 MS. SWAROOP: So I think that's an important part --
13 thank you, Your Honor. So we're at Sotera's slide 31 and we're
14 looking at Kiani and as we explained, again I think we heard
15 Sotera tried to combine the Money reference on the port on the
16 left and somehow with Kiani and indicate well, Kiani shows, you
17 know, three ports. So again I think it's important to remember
18 Kiani only shows a single sensor in per port and Kiani is not a
19 wearable, Kiani is a handheld universal pulse oximeter and Kiani
20 is replete with references to the fact that it's handheld throughout
21 that disclosure.

22 Then we turn to Akai which is the third figure here on slide
23 31 and this reference is primarily being used for the '108 patent
24 IPR which is the 912 proceeding and here Sotera has excerpted

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1 just a single figure from Akai but is relying upon multiple
2 embodiments for its obviousness challenge and I think what's
3 important to remember about Akai is that the structure that's
4 shown between the finger sensor 111 and the wrist portion 113 is
5 actually an optical fiber here, not an electrical wire and Sotera
6 has to combine this embodiment with other embodiments that
7 have internal sensors, take the internal sensors and make them
8 external sensors, add a strap and then somehow make an
9 argument that there is some sort of electrical receiving the
10 signal. So we certainly think the Akai grounds are deficient for
11 missing elements and for deficient motivations to combine.

12 And then finally we get to the Money reference which is
13 the fourth figure here and as we argued in our Patent Owner
14 response and with our expert, Money is a very large device. The
15 dimension I think we mentioned three inches by six inches by
16 one inch which, if Your Honors have your smart phones with
17 you, if you can imagine three of those on your arm and you can
18 imagine why that would not be wrist worn. I think some of
19 Petitioner's slides suggest that it would be wrist worn but I
20 believe we heard from Petitioner's counsel expressly that Money
21 is not mounted to the wrist and we certainly agree with that.

22 JUDGE KINDER: This is Judge Kinder. Really quick. Do
23 all the claims actually require wrist-worn? I think some of the
24 claims were body-worn.

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1 MS. SWAROOP: They're either wrist-worn or mounted to
2 the lower arm of the patient but I can confirm that. I believe
3 that's correct.

4 JUDGE KINDER: Okay.

5 MS. SWAROOP: I don't think it's body-worn, but I can
6 check that, Your Honor, yes.

7 JUDGE KINDER: So obviously we're going to give weight
8 to every limitation in the claim, but I guess I'm kind of
9 struggling with this. I look at the dimensions and I kind of
10 mapped it out on a piece of paper how long it would be, six
11 inches is pretty big, but it does say in the abstract of Money it's
12 wearable, right, on the body? So that's where I'm kind of hung
13 up is --

14 MS. SWAROOP: I think it --

15 JUDGE KINDER: -- is there anything, you know, as of
16 2002 that says a big bulky device couldn't be worn on the body
17 or is it just pragmatics that somebody wouldn't do it because the
18 cost benefit kind of analysis that it just doesn't make sense?

19 MS. SWAROOP: Yes. I'm not sure if there's anything
20 specific saying a product of that size couldn't be worn. I think
21 our expert, Mr. Oslan, explained that those dimensions would be
22 very difficult for patients particularly in a clinical setting to bear
23 the weight of something like that up to a pound and again, if
24 Your Honors have a smart phone imagine three of those, you

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1 know, being strapped to your wrist or lower arm and kind of the
2 difficulties associated with that. But I think we also again just
3 heard from Petitioner's counsel that Money is not mounted on the
4 wrist.

5 JUDGE KINDER: So to clarify --

6 MS. SWAROOP: There's no disclosure.

7 JUDGE KINDER: This is Judge Kinder again. So the
8 abstract of Money where it talks about being wearable, is it your
9 position that that only refers to a belt-type of wearing?

10 MS. SWAROOP: It says it's wearable but it doesn't specify
11 where. So it could be a belt and I think in fact Petitioner
12 introduced a new exhibit on Reply. I believe it's the Hutcheson
13 reference, Exhibit 1043, showing a blood pressure monitor that's
14 worn using a belt by a patient. So certainly the use of belts or
15 patient monitors was disclosed and is part of the record based on
16 the new exhibits Petitioner submitted in reply.

17 JUDGE KINDER: And I think Petitioner also argued that it
18 also wouldn't make a lot of sense for patients that wear hospital
19 gowns to wear a belt wearable device in most circumstances. So
20 what's your response to that?

21 MS. SWAROOP: Again, I think -- sure, and I think again
22 the Hutcheson reference, again that's Exhibit 1043 I believe is in
23 the patient context and there's a belt that's disclosed in
24 Hutcheson for the blood pressure monitor there. So that's

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1 certainly an example in the patient context of the belt being
2 used.

3 JUDGE KINDER: All right. Thank you. We'll take a look
4 at that.

5 MS. SWAROOP: And then the last point I wanted to make
6 with regard to Money is that Money does have a different signal
7 configuration from what's recited in the claims, namely that the
8 Money pulse oximeter pump transducer has a digital signal as
9 opposed to the analog signal that's recited in the challenged
10 claims and for the Money combination, Sotera engages in some
11 very significant hindsight modification to try to justify a
12 modification of the Money reference and again we don't think it's
13 supported by the record.

14 JUDGE KINDER: This is Judge Kinder again, and I
15 understand that, you know, looking at your claims and they're
16 very specific and I believe that it's the pulse-ox has to be digital,
17 is that correct?

18 MS. SWAROOP: No. The pulse-ox has to be analog.

19 JUDGE KINDER: Okay. I apologize. And then Money is
20 the opposite though, I apologize. So Money is actually digital.
21 So is it just the limitation you're relying upon or is there any
22 other significance of this particular configuration that provides
23 an advantage or any kind of benefit that you have on the record?

24 MS. SWAROOP: The configuration of having the pulse

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1 oximeter be analog and the other sensors to be digital?

2 JUDGE KINDER: Correct. Is there anything in the record
3 that would show a particular advantage or, you know, Petitioner's
4 position? Is this is just a random-pick kind of a generic or
5 claimed basically to cover their product? And I'm just wondering
6 if there's anything you have besides that to support that
7 particular configuration? But it's not necessarily in the patent
8 itself of what the advantages would be, but it does say you can
9 use analog or digital for every sensor. So I'm just wondering is
10 there anything in the record from your expert that kind of opines
11 on this particular configuration and, you know, why it would
12 have a particular advantage?

13 MS. SWAROOP: I'll try and track that down for you in
14 maybe during my rebuttal section but I do believe there was
15 deposition testimony as to why analog data may be appropriate
16 for certain sensors and digital data appropriate for other sensors.
17 I believe that Dr. Yanulis, Petitioner's expert, would have asked
18 about that and I can track down that specific cite for you. But I
19 believe that was at his deposition testimony talked about maybe
20 some considerations as to when analog data might be appropriate
21 and when digital data may be more desirable.

22 JUDGE KINDER: Okay. And this is Judge Kinder again.
23 If my question is off base, I mean if you legally think it's an
24 irrelevant question I mean feel free to tell me that as well

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1 because it is claimed as it's claimed and, you know, if your
2 position is that well, that's just how it's claimed and they have
3 the burden I understand that as well. But, you know, I think if
4 there was a particular configuration and it showed some
5 particular advantage, I think that might help you, but maybe not
6 legally.

7 MS. SWAROOP: Certainly, Your Honor, and we can track
8 that down. But as I mentioned when I started, you know, we are
9 looking at the claims here as issued. The deficiency of the
10 disclosure is not at issue. What Sotera needs to show here is that
11 prior art would render our claims obvious so, you know, the fact
12 that they think it's a "this or that" limitation or, you know, or
13 criticizing how we have chosen to claim these is somewhat
14 irrelevant to the issues that we are expecting today.

15 JUDGE KINDER: This is Judge Kinder again. I guess in
16 line with that last question I just want to clarify I guess for the
17 record that there were no -- there was no evidence of objective
18 indicia for nonobviousness in the record from Patent Owner?

19 MS. SWAROOP: That's correct, Your Honor. We did not
20 present any objective indicia.

21 JUDGE KINDER: Okay. Thank you.

22 MS. SWAROOP: All right. And I know we have
23 (indiscernible) clarified quite a bit. I'd like to switch to our
24 slides and if we could start with slide 4, and on slide 4 really

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1 what we have here is an explanation of the conventional patient
2 monitoring that was in place at the time of the priority date here
3 of these challenged patents and with conventional patient
4 monitoring you have a large bedside monitor. The patient had to
5 be tethered to that monitor and there were again wires for the
6 separate physiological parameters that were being monitored. So
7 SP02 blood oxygen saturation, blood pressure, EKG, and so
8 when a patient needed to get up to move to use the restroom, to
9 walk around, that required again connection and disconnection of
10 cables and was very awkward and difficult for the patient.

11 And so as you can see on slide 5, the claim solution which I
12 talked about at the beginning was to really address the challenge
13 of providing hospital grade portable patient monitoring and the
14 claim solution is what we have set forth here at slide 5 which
15 again is the arm or wrist wearable portable patient monitor,
16 multiple sensor port strap and then again a wireless transmitter
17 and some of our slides kind of recite these key features across
18 the independent claims and then at slide 8 we have some of the
19 additional claim features here.

20 So one of them again is that the sensor port must
21 electrically receive or electrically convey a signal from a pulse
22 oximetry sensor and you can see at slide 8 where that limitation
23 is recited in across the four IPRs. We do have the analog digital
24 signal configuration limitations that Petitioner's counsel talked

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1 about and then there are some of the claims that specify
2 particular signals from particular sensors. So the first sensor
3 being the pulse ox sensor, for example, or that one sensor
4 expressly being a blood pressure sensor.

5 JUDGE KINDER: This is Judge Kinder. I just want to
6 thank your team for these slides. They're very helpful in
7 showing how all the issues overlap so we appreciate that.

8 MS. SWAROOP: Thanks. Your Honor, if we could go to
9 slide 11 I wanted to also address claim construction and the term
10 sensor port or sensor communication port and at slide 11 you can
11 see what the two competing proposals are. So we have more of a
12 connector based construction so it's a connector that mates with a
13 compatible connector from a sensor. Sotera differs from ours,
14 most significantly on including the concept of permanency, a
15 permanent floor movable input-output interface for a sensor.

16 JUDGE KINDER: This is Judge Kinder again. Under your
17 proposed construction, does Kiani have at least one sensor port?

18 MS. SWAROOP: Kiani would have a single sensor input
19 port under our construction, yes, Your Honor.

20 JUDGE KINDER: Okay. Thank you.

21 MS. SWAROOP: And, you know, we do believe that our
22 construction, our connector based construction, is consistent with
23 how the patents describe a sensor port. So if you look at slide
24 12, we have figure 3 here, and we have highlighted in yellow

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1 what the specification is calling out as item 362. Again, I'm
2 showing a connector that's mating with a compatible connector
3 from a sensor.

4 At slide 13 we have figure 4A which again is showing the
5 wrist worn module showing the finger sensor and then it's
6 showing the auxiliary cable with its own connector at the end
7 near the wrist worn part and that connector from the sensor is
8 then mating with the module connector on the wrist worn
9 portion. So again, another example of the sort of connector
10 based construction and the mating of the two parts.

11 JUDGE KINDER: This is Judge Kinder. I believe
12 Petitioner had one counter argument about claim differentiation
13 and I think it was in the '912 IPR claim 6 of that proceeding had
14 a claim limitation that actually said the sensor port was
15 removable or similar type of limitation and their point was well,
16 you have to infer then that the independent claim would be
17 broader than that and cover both removable and hard wired.
18 What was your response on that?

19 MS. SWAROOP: Yes, Your Honor, and I said that we have
20 slide 27. I think looking at both slide 27 and perhaps also slide
21 13, I think would help address that point. And so at slide 27, we
22 have dependent claims 5 and 6 that Sotera is relying on for their
23 claim differentiation argument. And we don't think that that's
24 quite the right way to look at this and that's because claims 5 and

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1 6 don't simply add the concept of removability. They have an
2 additional feature of the cable. So, in claim 1 you have the idea
3 that sensor port and then a connection to the housing on the wrist
4 worn portion. But what claim 5 additionally adds is that there is
5 a cable that's providing that wired connection and then claim 6 is
6 explaining that that cable is removably coupled to the housing
7 via the sensor port. And I think this goes back to the tail
8 discussion that we had earlier. So Your Honors might be
9 wondering well, if it's not a cable what else could it be and the
10 spec actually contemplates an alternative structure to the cable,
11 which is the tail concept. And again that's at, I believe it's
12 column 5, lines 43 to 45, which explains that the sensor could
13 have a tail that connects directly to the wrist-worn module
14 instead of the auxiliary cable. And I think maybe that that's the
15 way to understand that is if you go back to our slide 13 where we
16 have that figure from the patent.

17 So here in slide 13 you can see the sensor on the finger and
18 then you can see the cable 420 that's going up and it's got it's
19 own little connector that's plugging into the wrist worn module.
20 But that's the auxiliary cable configuration, but the alternative is
21 that the sensor itself, the portion down by the finger could just
22 have its own tail that's connecting directly to the wrist worn
23 module. So that's the distinction that claims 5 and 6 are drawing
24 is that they are claiming the cable and then later step that the

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1 cable is removable as opposed to a different sort of removable
2 connection.

3 JUDGE KINDER: This is Judge Kinder. Then would a tail
4 be hard-wired into the module essentially connector?

5 MS. SWAROOP: I don't think the tail would still connect
6 to the wrist worn module. It may be hard-wired at the sensor-
7 end potentially.

8 JUDGE KINDER: I guess I'm just trying to figure out what
9 the difference is of a tail then as far as the connections?

10 MS. SWAROOP: That it doesn't have a separate connector,
11 but you see the connector piece on figure 4A, the kind of
12 hourglass shaped piece there that's we called it out connector
13 from sensor?

14 JUDGE KINDER: Yes, I do. Thank you.

15 MS. SWAROOP: And that's plugging into the wrist-worn
16 module. So in the alternative, the tail configuration, you
17 wouldn't have that connector piece, the tail would just be
18 directly -- connected directly to the wrist worn module instead of
19 having the auxiliary cable 420 (audio interference) connector.

20 JUDGE KINDER: So the tail embodiment would be hard-
21 wired?

22 MS. SWAROOP: I'm not sure the spec says that it would
23 be hard wired on that point. So no, it would not be hard wired.
24 It would also -- it would connect into the module connector. It

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1 just wouldn't have the sensor connector piece there, the piece
2 that we've called out as connector from sensor.

3 JUDGE KINDER: Yes, I understand. I guess I'm having a
4 hard time envisioning how it would actually connect it.

5 MS. SWAROOP: Well, it would have its own connector
6 that would attach.

7 JUDGE KINDER: Okay. Thank you.

8 MS. SWAROOP: And I think maybe we're focusing on the
9 wrong end here in that the -- in what we're seeing in figure 4A is
10 that you've got a connector on your finger area and then with the
11 cable; right? And with the tail configuration, the tail would
12 come directly from the sensor and then be plugged into the wrist
13 worn module. Does that make sense?

14 JUDGE KINDER: Yes. Thank you.

15 MS. SWAROOP: Great. Unless Your Honors have any
16 other questions on claim construction I was going to move to the
17 Goldberg ground. Right. Okay. So the Goldberg grounds start
18 at slide 47 of our presentation and if we go actually to slide 49
19 we kind of have our overview of our challenges to Goldberg. So
20 as we've discussed many times now, you know, it is our position
21 I think we're now maybe all in agreement that Goldberg did not
22 disclose any sensor port. We also believe that a person of skill
23 would not have been motivated to modify Goldberg in view of
24 Kiani to add three sensor ports and then specifically with regard

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1 to the blood pressure cuff and housing which is the second
2 sensor port limitation, we don't think that Sotera has
3 demonstrated either a motivation to add a port there or any kind
4 of reasonable expectation of success.

5 And if we go to slide 52, this is where we have our
6 arguments with regard to the lack of motivation to combine
7 Goldberg and Kiani and again the petition really focused on
8 clinician's demands and expectations to have an adaptable patient
9 monitor and the problem with that motivation is that it's the
10 wrong context. The motivation in Sotera's petition was that
11 clinicians were demanding something but we think it's clear from
12 the record that Goldberg's device is really intended for personal
13 use by the patient or maybe the monitor person and also we had
14 pointed in our Patent Owner response to an express opinion from
15 Sotera's original expert, Dr. Yanulis, who explained that the best
16 way to improve patient comfort would be minimize the size of
17 the wearable device and the number of sensors attached to the
18 patient and that was at his declaration, Exhibit 1003, paragraph
19 29.

20 And so on slide 53, we've included some figures from
21 Goldberg, which we believe really show the context for Goldberg
22 and that it's meant for personal use, not for monitoring or use by
23 a clinician as the end user and that's based on the displays, the
24 reassurances to the end user everything is just fine followed by

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1 explanation points. The spec explains that it's carried by the
2 monitor person. The spec talks about the display having news,
3 sports or entertainment, again suggesting that this is for personal
4 use, not for a clinician.

5 We also heard from Sotera, and they have briefed that well,
6 even if the context for Goldberg is somehow an end user rather
7 than a clinician that, you know, the individual users would be
8 very familiar with ports and that wouldn't have been an issue for
9 them to navigate multiple ports with multiple parameters back in
10 the 2002 time frame and we don't think that that opinion is really
11 supported by any evidence. I think their new expert, Dr.
12 Bergeron, didn't cite any evidence for that and we put for the
13 evidence and in particular Exhibit 2024 is one of the opinions
14 from our expert, Mr. Oslan, and we included that in our slide 54
15 here where we had specific evidence of the difficulties that
16 nurses and the ICU have with navigating and numerous cables on
17 a monitor of a patient and so we think the record then has
18 specific evidence claiming the complexity of monitoring multiple
19 parameters of cables over a patient's body and so we do think
20 that also goes against the motivations here.

21 And then I also wanted to address at slide 55 we have a
22 diagram, and really slide 56 is our -- we set forth our arguments,
23 and we think this is really important for the Goldberg grounds in
24 the failure to show any kind of sensor port in the blood pressure

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1 cuff or any motivation to add a port there and and again, the
2 generic arguments about ports are known, you can add a port
3 here you can add a port there, we need to look at the specific
4 arguments in the petition and what did Sotera argue here? And
5 what they argued here was the blood pressure cuff sensor of
6 Goldberg and that is either somehow implicitly add a port or it
7 would be obvious to add a port and our expert gave a lot of detail
8 as to why that simply is not the case.

9 First of all, there again no port shown in the blood pressure
10 cuff sensor 104B of Goldberg. Our expert explained in great
11 detail that the pressure sensor is normally located in the housing
12 of Goldberg, not in the cuff around the side and so that would
13 mean there wouldn't even need to be a port.

14 JUDGE KINDER: This is Judge Kinder. Real quick. I
15 mean the patent itself, and I think Petitioner cited this, says that
16 104B is the sensor itself. So I understand the box diagram that
17 your expert was relying upon shows it internal, but the
18 configuration of figure 2 shows it essentially as part of the wrap
19 around. Did your expert present anything that counters that
20 particular position that it couldn't be in the cuff that's external?

21 MS. SWAROOP: So our expert looked for and tried to find
22 situations with a sensor, a sensor port being in the cuff and was
23 not able to locate any such sensor port and again I think the
24 important thing to remember is not, "where is the sensor?", but

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1 “is there a sensor port here?” and so again the port, sensor port is
2 the claim limitation and as we pointed out there is no port
3 shown. Sotera's expert was unable to really identify any, our
4 expert couldn't find any and explained that if there were to be a
5 sensor port there would have to be a number of kind of particular
6 structural requirements for that sensor port and he said that at, I
7 believe it was paragraph 89 of his declaration Exhibit 2010.
8 That was Mr. Oslan's declaration discussing that issue. So and
9 that's in the '735 proceeding the 954 IPR and I believe at our
10 slide 56. And we have a citation from his paragraph 88 where
11 Mr. Oslan again confirmed that the combination that Sotera's
12 proposing would require a person of skill to design and develop
13 and new sensor port not shown anywhere in Petitioner's
14 references to address these issues.

15 If we go to slide 57. Dr. Yanulis had indicated well, and I
16 don't see a sensor port there but, you know, I think it would
17 make sense to add one that would allow for removal and
18 replacement of the sensor and provide a secure connection. So
19 again, that's removable replacement, the general generic sort of
20 motivation but there's again our expert looked for this and there's
21 no evidence of any wrist worn blood pressure monitors either
22 before or after the 2002 priority date that are designed to be user
23 removable from the housing. So this idea that it would be
24 obvious to add a port to allow for easy removal is not something

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1 that exists or was part of the record here, and we set forth those
2 arguments and our expert's response to that at our slide 57. I
3 have just a few minutes left here of my 45 so if Your Honors
4 have no further questions on the Goldberg grounds, I was going
5 to move to the Money reference.

6 JUDGE KINDER: That'd be great. Thank you. And I
7 think you're right, I think you have about five minutes left of
8 your opening time.

9 MS. SWAROOP: Okay. Great. So if we can go to slide
10 65. This is where we have set forth all of the different grounds
11 with Money as the primary reference across all of the different
12 IPRs and we have done this for the Goldberg grounds and the
13 Akai grounds as well so Your Honors have a reference here to
14 consult. But what's important to understand here is that all of
15 the Money grounds require a combination with Akai and we
16 think that combination is fundamentally flawed and based on
17 hindsight reconstruction, and really what Petitioner is saying to
18 justify to motivate the combination of Money with Akai is that
19 Money supposedly had a pulse oximetry cuff transducer that was
20 bulky and uncomfortable and that needed to be replaced with
21 something that was not invasive and light based and that was the
22 fundamental premise motivating the motivation to combine
23 Money with Akai.

24 But there's some serious problems with that and if we go to

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1 slide 68 we asked Dr. Yanulis, their first expert, can you tell us
2 what does the pulse oximetry cuff transducer look like? And
3 we've got his deposition excerpts here at slide 68 and we said,
4 "Q. What is your understanding of what a pulse oximetry
5 cuff looks like?"

6 And he said,

7 "A. I'll be honest with you, counsel, I've not seen any and I
8 can't recall when I've seen one."

9 And he goes on to say,

10 "So I'll be honest with you, I haven't seen any."

11 So he hasn't seen them, that's okay. Then we asked him at
12 least tell us some features, can you describe for us the features
13 so we can understand why is it bulky and uncomfortable. So we
14 asked him,

15 "Q. Can you describe for me any features of the pulse
16 oximetry cuff transducer?"

17 And we've highlighted there at the bottom there,

18 "A. So the answer -- simple answer, no, I don't know any
19 specifics."

20 So how can the expert opine and opine that one would be
21 motivated to substitute out the pulse oximetry cuff transducer of
22 Money as bulky and uncomfortable but he's never seen it and
23 doesn't know any features of it. So it really calls into question
24 Petitioner's motivation to modify Money and really what it

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1 appears to be is like a hindsight driven combination because
2 Akai has a light based sensor, Akai has an analog sensor and to
3 try to match the claims Petitioner created a combination of
4 Money with Akai and we think it's undisputed that, you know,
5 pulse oximetry is performed non-invasively using light. There's
6 no dispute about that. So again, this idea that Money would have
7 to be modified to have a pulse oximeter that was non-invasive
8 and light based again we don't think is really supported here.

9 We also pointed out again, the Money device is too large
10 and too heavy to be wrist worn. We had gone through that
11 earlier during our session and we do have some slides on that as
12 well and then if we go to slide 73 we think this really illustrates
13 how extensive the hindsight modification is here and at slide 73
14 we explain, we have the diagram of Money with this, again, it's
15 got the digital-based pulse oximeter sensor and then everything
16 else is analog and those were working fine, working SP02 sensor,
17 working temperature sensor, so what Sotera has to do is swap in
18 Akai's analog-based sensor for Money's digital sensor. Now
19 Money's SP02 sensor, that digital port, is now open but then
20 Sotera says okay, well then we have to swap in a temperature
21 sensor and switch that and, you know, make all of these
22 adjustments again to try to match the claims but no real reason
23 that would motivate that modification. So again, we think that
24 the way Sotera is trying to change the references without really

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1 any motivation again demonstrates hindsight and is just simply
2 an effort to try to match the claims in an attempt to support
3 obviousness.

4 And the last point I wanted to make very briefly is with
5 regard to the electrically received limitation and I think that
6 affects all of the claims of the '108 patent which is in the 912
7 IPR and the Akai based grounds is the electrically received
8 limitation and we pointed out that Akai has an optical fiber and
9 so therefore it does not teach the electrically received limitation
10 that's a missing element from all of the Akai based grounds in
11 the '108 patent, that's the 912 IPR and Sotera again attempts to
12 shift on reply to suggest that Akai can have an electrical wire but
13 it's a light-based system and simply would not work if the optical
14 fiber was swapped out electrical wire, and unless Your Honors
15 have any questions I will stop here and reserve my remaining
16 time for rebuttal.

17 JUDGE KINDER: It looks like the panel does not have any
18 other questions and I think you have about your full 15 minutes
19 left I think, so again we'll be pretty liberal with time if folks go
20 over a couple of minutes, that's fine. There's a lot to unpack in
21 these cases. Thank you.

22 MS. SWAROOP: Thank you, Your Honor.

23 JUDGE KINDER: All right. We'll transition back to the
24 Petitioner's reply. Mr. Telscher, whenever you're ready. I think

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1 you had about ten or so minutes but again if you go over a
2 couple we're not going to scream at you, okay.

3 MR. TELSCHER: Thank you, Your Honor. So I think as
4 you said a couple of times in your comments throughout this case
5 really the Supreme Court law governs and KSR is the decision
6 that really governs here. Whenever you have only one of a few
7 ways that you can do something and all you're doing is
8 substituting one known way for another that produces predictable
9 results it's just not patentable.

10 In this case, you know, the two primary issues especially
11 under Goldberg are, the first one is going to be analog and
12 digital, you know, so there's only two ways of doing it. So if
13 you have sensors there's only analog and digital. It's undisputed
14 on this record that they were all conventional. The '735 patent
15 simply says that you could use an analog or digital. Goldberg
16 just says any signal. So you only have one or two ways of doing
17 it and what they're really asking for is in the area of medical
18 monitoring that they can own specific analog and digital
19 configurations where anybody of skill in the art would know that
20 they can use analog or digital for SP02. They could use analog
21 or digital for a thermometer and those skilled in the art can pick
22 between them. We cite specifically the evidence from their own
23 expert Oslan at paragraphs 110 to 115 where he said experts
24 would know all the pros and cons of digital versus analog. So

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1 KSR in our view governs the analog versus digital dispute and
2 certainly on the ports there's only hard wired for ports, so those
3 are the two big issues before you and according to them in the
4 medical field they can own the concept of ports.

5 Now if you're in a hospital setting and, for example,
6 Goldberg teaches up to seven ports or, excuse me, up to seven
7 sensors. So Goldberg teaches up to seven sensors. So imagine,
8 if you will, you have a piece of equipment can you image seven
9 hard wired sensors? So I hook up to the patient or even if it's at
10 home, they say it's at home, whether it's at home or hospital
11 doesn't change it. There's a patient being hooked up to be
12 monitored. So if Goldberg had seven sensors that were hard
13 wired, you would have say two sensors being used and five just
14 dangling around, moving around, it wouldn't work. So we know
15 there are disposable sensors that would need to be ported. We
16 know that for adaptability reasons they would need to be
17 unplugged and a new one put in. We know for a sensor breaking
18 down it would need to be ported. So the experts all agree ports
19 were known. The '735 patent admits there's ports.

20 So, what is the petition grounds? How do we carry our
21 burden? The Goldberg patent talks about one, all or a
22 combination of seven sensors. So that's more than three ports.
23 Kiani shows ports. One skilled in the art is going to know to use
24 the ports of Kiani or Goldberg and that would get you to more

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1 than three ports and again, under KSR there's only one of two
2 ways of doing it, either hard wired or ports. So Goldberg in
3 combination, and I don't even know that you should need to
4 reach Kiani. I mean ports were so well known that you shouldn't
5 even need a reference for it. We do not agree that Goldberg does
6 not disclose ports which is what Masimo suggests in their
7 argument. What we have admitted is the word ports is not used
8 in there. Specifically we have cited the Court to the area in
9 column 4 of Goldberg that says, "My sensors connect to the
10 monitor by wire by known means."

11 And these are exactly the types of details that you would
12 not expect someone to have to explain, and when you go look at
13 their own Kiani reference we've -- in our brief we've shown you
14 the figure where they show a wire going in to their device and
15 yet it was ported. So what they're trying to do is take a simple
16 block figure and turn that into the teachings when Goldberg
17 expressly says that my sensors are connected to the monitor by --
18 you know the words, I've cited it in there -- but it's by no means
19 or means well known to those in the art and do we really think
20 that one skilled in the art as of 2002 in a hospital environment
21 wouldn't think to connect sensors via ports by Goldberg itself but
22 certainly in view of Kiani and I would note that even Amano, the
23 reference that the Patent Office rejected under was showing
24 ports. Ports are ubiquitous and the experts, nobody's disagreeing

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1 that ports were ubiquitous and there's only one of two ways.

2 You know, there was some mention about the sufficiency
3 and as I made clear, we're not arguing Section 112. The reason
4 the lack of disclosure in the '735 patent is important is because
5 it's exactly like Goldberg in that you don't disclose detail for the
6 basics. They didn't try to claim analog and digital and ports for
7 15 years because those are basic electronics. We've shown them
8 our combination holds it. As far as Goldberg being household,
9 the Patent Office already rejected that. They made the same
10 argument with Amano. They said it's an exercise watch. The
11 Patent Office said it doesn't matter. You're monitoring vital
12 signs. So whether Goldberg is in a household or not, and I'll tell
13 you column 2 specifically states at the top that the device of
14 Goldberg is intended to be used with medical care professionals,
15 and think about it. We're not talking about sitting in your house
16 measuring your blood pressure. We're talking about measuring
17 seven vital signs. There's no consumer that's going to know how
18 to measure three or four vital signs on their own, it would be
19 their doctor telling them what to do.

20 As for A and D, as I said there's only two options. Oslan at
21 paragraphs 110 to 115 makes clear that skilled artisans know the
22 pros and cons of analog versus digital. Page 74 of our petition
23 we talk about, you asked her about the motivation for using
24 analog or digital, no. Their expert never explains how it could

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1 be inventive to have an analog versus digital and you'd say well,
2 Mr. Telscher, it's your burden and I agree. But analog and
3 digital are so ubiquitous under KSR that our burden is carried
4 right there.

5 But I would go further that we explained at page 74 that
6 those skilled in the art -- just by way of example if you have a
7 continuous wave form, so say on your pulse oximeter you want
8 to look at the wave form, analog's better. You can do it digital
9 but analog's better. If you have something discreet like a
10 temperature reading, digital's just fine. None of that matters
11 because whether it's the blood pressure cuff that they're making a
12 lot of, there are a lots of different sensors that measure blood
13 pressure. It could be a cuff, it could be other ones. If one
14 skilled in the art wants to measure blood pressure, they could use
15 the cuff of Goldberg or they could use any other blood pressure
16 sensor and monitor it in.

17 They talk about Kiani showing fiber optics and it wouldn't
18 be obvious to combine. They didn't cite you to 4-1019 of Akai
19 where Akai specifically says such as fiber optics and then it goes
20 on to say that all you need to connect the sensors of flexible
21 material which is a wire. So our grounds with Akai make
22 absolute sense. Akai shows multiple sensors that are set into a
23 display on the wrist, displays those on the wrist and then
24 wirelessly transmits them to a remote sensor.

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1 We talk about the Kiani single sensor port. The only use of
2 Kiani is to show that the use of ports in medical monitoring was
3 well know. As I have mentioned Goldberg in combination with
4 Kiani, Goldberg says seven sensors. That means there are at
5 least seven ports. Their claims only require three ports. So
6 Goldberg in combination with Kiani meets our burden and I
7 think, I mean come on, we're a medical device technology. How
8 could people in the medical world not have a monitor that allows
9 you to connect and disconnect your sensors. They're suggesting
10 that the rest of the world should hard wire their sensors and that
11 they're the ones that invented ports when they clearly did not
12 invent ports. Amano had them. Kiani had them. Lots of
13 references had them. Our experts all agree ports were very
14 common.

15 They criticized our expert for saying that people would
16 know how to use ports at home. But our expert at paragraph 80,
17 Exhibit 1048, explains if you're a person sitting at home you
18 plug your cable box into a port. You have ethernet ports. You
19 have phone jacks that plug into ports. The notion that people
20 sitting at home don't know how to use ports, if they're right that
21 Goldberg was somehow limited to the house, is just wrong.
22 There's abundant evidence from our expert that people are
23 inundated with ports around their home. As for claim
24 construction, there's nothing I want to address there. I mean

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1 again I don't think it matters.

2 JUDGE KINDER: This is Judge --

3 MR. TELSCHER: The only thing I would say -- yes.

4 JUDGE KINDER: This is Judge Kinder. If I could --
5 Patent Owner, they hit the combination arguments and
6 motivation to combine Money and Akai pretty good. If you
7 could address that for a couple of minutes. I know you only
8 have a couple of minutes left so if you go over we'll add a few.

9 MR. TELSCHER: Absolutely, Your Honor. Thank you.
10 So Money, again, is a device from 1994, size was in 1994.
11 We've already in my argument told you that by 2002 electronics
12 had been miniaturized and I've cited you our expert testimony,
13 I've said it to you in the petition where we argued it. But by
14 2002 whatever the size of Money was was irrelevant. One
15 skilled in the art could do it.

16 So let's talk about Money. What does Money show? At
17 least five vital signs with ports on a display remoted into a
18 remote monitor. So the only thing we're talking about Money,
19 and if you turn to slide 31 of ours just so it's visual for you, so if
20 you turn to slide 31. So on slide 31 Money is on the right and
21 you can see right on Money it's a device that's worn on the body
22 as you've already noted, and the figure displaying five monitored
23 vital signs which are ported and from there you display them and
24 you wirelessly transmit them. So Money shows everything that

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1 the patent is about except what does it not show? The particular
2 housing of the '735 patent. So Money shows everything except
3 for the housing of the '735 patent. We've combined that with
4 Akai which by '97 already was small enough to be on a wrist
5 monitor as you can see on slide 31.

6 So the combination, and it shows the SP02 sensor with the
7 wire management, the wire going perpendicular up to the end.
8 Akai shows that. So Money in combination with Akai would
9 certainly show that Money shows -- well, Money and Kiani
10 (phonetic) show the ports. So the only combination necessary
11 for Money is take all of the vital sign monitoring, the display,
12 the wireless transmission and repackage it in the Akai wrist
13 monitor. If there's any debate about whether it was a wrist
14 monitor, and by the way we submitted evidence to show that
15 even the size by '94 was the same as there were watches that
16 weigh a pound. There were devices worn by people on their
17 arms that were the size of Money. So by 2002 that would have
18 been even smaller. So the notion that when you think about it,
19 Money shows all of the features of this device including analog
20 and digital, not the specific analog and digital. You can say
21 well, Money's reversed. Our simple point on reversal is that one
22 skilled in the art under KSR only has two options for each of
23 these sensors and as you've already noted, their expert hasn't
24 even explained why does it matter if you monitor SP02 and

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1 analog that the temperature would be digital. Those two are
2 completely unrelated. You're going to monitor SP02 as you
3 want. You're going to monitor temperature as you want. Where
4 did they come up with that combination? Our client's product.
5 It's not in their patents and so that's not a novel combination.
6 KSR, one of two ways. Analog versus digital. Those skilled in
7 the art should be able to pick all day long and none of these
8 sensors operate any differently because they are analog versus
9 digital. Under KSR it's substitution of a component to get
10 predictable results all day long.

11 And so I don't know if that answers your question but I
12 think the combination of Money and Akai could not be any more
13 basic when you take all of the (audio interference) transmission
14 and display of Money and you combine it with the housing of
15 Akai, you get what you need including a sensor that goes up the
16 finger. Does that answer the question?

17 JUDGE KINDER: Yes. I appreciate it. I think your time
18 is a couple of minutes over so if you want to conclude in the next
19 minute or so, then we'll transition.

20 MR. TELSCHER: No. I think -- my conclusion would be
21 what we're talking about is monitoring vital signs with something
22 that mounts on your wrist. All of that was shown. Wirelessly
23 transmitting that to a remote station. All of that was shown.
24 Wrist watch with a wire extending down the finger. All of that

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1 was shown and so what this one boils down to is something these
2 patents never claim, not even in 2017 patents in the abstract
3 talked about analog and digital signals or ports. So it comes
4 down to whether after we've shown through Akai and Goldberg
5 the exact configurations and all of the things, whether they can
6 get patents on analog and digital signals and ports. I have
7 nothing further, Thank you.

8 JUDGE KINDER: All right. Thank you, and we'll go
9 ahead and transition to the Patent Owner's reply and Ms.
10 Swaroop, I think you have at least 15 minutes and you know
11 what? Petitioner went over a couple so if you need to go over a
12 couple we'll certainly entertain that.

13 MS. SWAROOP: Thank you, Your Honor. This is Sheila
14 Swaroop for Patent Owner. First off, Your Honor had asked me
15 during the main presentation whether all the claims recite either
16 wrist worn or a device to be worn on the lower arm and all of
17 them do other than the '300 patent which is in the 1015
18 proceeding and so claim 1 of the '300 patent recites that the
19 device is on the arm and then claim 16 does not specify any
20 particular location. But all of the other independent claims
21 across the three IPRs do specify either wrist worn or worn on the
22 lower arm.

23 Petitioner's counsel talked about Goldberg having seven
24 sensors and how that would just be, you know, cumbersome if

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1 there were seven wires coming out of the Goldberg device if it
2 in fact had seven sensors. But what he omitted is that Goldberg
3 again also discloses that the sensors can be connected wirelessly.
4 So I don't think that that argument about whether the tall box
5 sensor of Goldberg itself is hard wired or not, I don't think that
6 really answers the question because there is the option for
7 wireless if other sensors were to be incorporated and again, that
8 cite from Goldberg I believe it was at Petitioner's slides but it is
9 Exhibit 1005 and it is column 4, lines 50 to 56 of Goldberg.

10 We also heard a lot from Petitioner's counsel about the
11 combination of Goldberg with Kiani and again it was very high
12 level. Ports, ports, Goldberg has ports, we think they have ports,
13 Kiani has a port, combine them, combine them. But we have to
14 look again at the petition and what I didn't hear at all in
15 Petitioner's rebuttal was our argument about the blood pressure
16 cuff sensor of Goldberg which was what the petition expressly
17 relied on for the second sensor port limitation and any argument
18 as to how there is a port there and if there's not, why would any
19 person of ordinary skill be motivated to add a port to that blood
20 pressure cuff sensor of Goldberg. They're just saying oh, go to
21 Kiani. That doesn't tell us anything about the specific
22 modification or the specific argument that the Petitioner relied
23 on in their petition.

24 Petitioner's counsel talked about Akai, and if we go to our

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1 slide 45 of Akai Petitioner mentioned that, you know, oh, it
2 doesn't have to be optical, it can just be an electrical wire
3 because the Akai spec talks about that. But again, and we have
4 the configuration here from figure 2 that shows that this needs to
5 be an optical fiber in order to transmit light. So this idea that
6 oh, you can just swap it in, an electrical signal that Akai also
7 contemplated. Akai would not work in that situation so we just
8 don't think that that argument is correct and again, we do think
9 that that renders deficient all of the Akai grounds in the 912 IPR
10 proceeding on the '108 patent due to the failure to have that, the
11 missing element there is the electrically received signal in the
12 Akai-based grounds.

13 And then we heard from Petitioner's counsel about Money,
14 the Money-Akai combination and I think we heard that all that
15 Money is missing is the housing and that's what Akai supplies.
16 But again, you know, as we've talked about Money does not have
17 an analog pulse oximetry sensor. Petitioner has to rely on Akai
18 for that, and the reasoning, the -- well, we didn't hear them
19 address at all the motivation, the reason for modifying Money.
20 The reason that was given is that this pulse oximetry cuff
21 transducer was somehow bulky and uncomfortable. We didn't
22 hear anything from Petitioner's counsel explaining how that's a
23 credible supportable reason in view of the fact that their expert
24 was unable to describe that cuff transducer and they have simply

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1 given no credible reason to modify Money to replace it with Akai
2 and I think what I heard him say was well, you could put Money
3 on the wrist because it hides a finger-based sensor. But that
4 assumes that you're going to do the modification to begin with.
5 Once you've done the modification then he's saying you have a
6 wrist worn device. But what motivates that modification to
7 begin with? Why would a person of ordinary skill starting with
8 Money be motivated, have any reason to modify Money? And
9 that's what's missing from their petition.

10 Unless Your Honors have anything further, I think I've
11 completed my rebuttal points for today.

12 JUDGE COCKS: I have no further questions. Thank you.

13 MS. SWAROOP: Thank you, Your Honor.

14 JUDGE KINDER: This is Judge Kinder. I have no further
15 questions as well. All right. Well, we'd like to -- this is Judge
16 Kinder. We'd like to thank both parties for your time today. I
17 think I speak for the panel that your briefing and your
18 presentations were both incredible. We're definitely impressed.
19 I'm not seeing you're making our job easier because you both did
20 so well. The issues here are going to be closely looked at. We
21 thank our staff for putting on another great hearing with no
22 interruptions. A lot of people do a lot of work in the background
23 to make sure these things go smooth. Hopefully some day soon
24 we can all get back in person but until then, we appreciate the

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1 work our staff has done. With that, the case is submitted. We
2 can go off the record.

3 (Whereupon, at 3:08 p.m., the oral hearing was
4 concluded.)

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