

Filed: June 8, 2020

Filed on behalf of:

Patent Owner Masimo Corporation  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SOTERA WIRELESS,  
Petitioner,

v.

MASIMO CORPORATION,  
Patent Owner.

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

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**PATENT OWNER SUBMISSION OF MANDATORY NOTICE  
INFORMATION PURSUANT TO 37 C.F.R. § 42.8(a)**

Pursuant to 37 C.F.R. § 42.8, Patent Owner Masimo Corporation hereby submits the following mandatory notice information.

**I. Real Party in Interest Pursuant to 37 C.F.R. § 42.8(b)(1)**

The real party in interest is Masimo Corporation.

**II. Related Matters Pursuant to 37 C.F.R. § 42.8(b)(2)**

The matters listed below might affect, or be affected by, a decision in this proceeding pursuant to 37 C.F.R. § 42.8(b)(2).

**A. Litigation Involving the Patent-at-Issue**

U.S. Patent No. 9,788,735 (“the ’735 patent”) has been asserted in the following lawsuit: *Masimo Corp. v. Sotera Wireless et al.*, Civil Action No. 3:19-cv-01100-BAS-NLS, pending in the Southern District of California.

**B. Patents and Patent Applications Claiming Priority to the Patent-at-Issue**

At least the following patents and applications claim priority to, or share a priority claim with, the ’735 patent:

Country Code (or Jurisdiction)	Patent No.	Application No.
US	9,795,300	15/499,716
US	Pending	15/878,172
US	10,219,706	16/157,643
US	10,335,033	16/198,057
US	Pending	16/411,689
US	6,850,788	10/377,933
US	7,844,314	11/048,330
US	7,844,315	11/417,006
US	8,548,548	12/955,826

Country Code (or Jurisdiction)	Patent No.	Application No.
US	9,113,831	14/037,137
US	9,113,832	14/217,788
US	Abandoned	14/815,232
US	10,213,108	15/448,989
US	9,872,623	15/494,967

### C. Related Proceedings Before the Board

Patent Owner also identifies the following additional *inter partes* review proceedings related to patents asserted by Patent Owner in the above-referenced District Court litigation:

Petitioner	Case Number	Patent Number
Sotera Wireless	IPR2020-00912	10,213,108
Sotera Wireless	IPR2020-00967	RE47,244
Sotera Wireless	IPR2020-01015	9,795,300
Sotera Wireless	IPR2020-01019	RE47,353
Sotera Wireless	IPR2020-01033	RE47,249
Sotera Wireless	IPR2020-01054	9,872,623

### III. Lead and Back-Up Counsel Pursuant to 37 C.F.R. § 42.8(b)(3)

Patent Owner hereby designates its lead and backup counsel as follows:

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<b>Lead Counsel</b>	<b>Back-up Counsel</b>
Sheila N. Swaroop (Reg. No. 53,658) Knobbe, Martens, Olson, & Bear, LLP 2sns@kmob.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502	Ben J. Everton (Reg. No. 60,659) Knobbe, Martens, Olson, & Bear, LLP 2bje@knobbe.com <u>Postal and Hand-Delivery Address:</u> 2040 Main St., 14th Floor Irvine, CA 92614 Telephone: (949) 760-0404 Facsimile: (949) 760-9502
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#### IV. Service Information Pursuant to 37 C.F.R. § 42.8(b)(4)

Please address all correspondence to lead counsel at the address shown above. Patent Owner also consents to electronic service by email to: SoteraIPR735@knobbe.com.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 8, 2020

/Sheila N. Swaroop/

Sheila N. Swaroop (Reg. No. 53,658)  
Customer No. 64,735

Attorneys for Patent Owner  
Masimo Corporation

**CERTIFICATE OF SERVICE**

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER SUBMISSION OF MANDATORY NOTICE INFORMATION PURSUANT TO 37 C.F.R. § 42.8(a)** is being served electronically on June 8, 2020, to the e-mail addresses shown below:

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Dated: June 8, 2020

/Sheila N. Swaroop/  
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