

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SOTERA WIRELESS, INC.,  
Petitioner,

v.

MASIMO CORPORATION,  
Patent Owner.

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IPR2020-00912 (Patent 10,213,108)  
IPR2020-00954 (Patent 9,788,735)  
IPR2020-01015 (Patent 9,975,300)  
IPR2020-01054 (Patent 9,872,623)<sup>1</sup>

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

CHAGNON, *Administrative Patent Judge*.

ORDER  
Conduct of Proceeding  
37 C.F.R. § 42.5

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<sup>1</sup> We exercise our discretion to issue one order to be entered in each case. The parties are not authorized to use this style heading for subsequent papers without prior Board approval.

IPR2020-00912 (Patent 10,213,108)  
IPR2020-00954 (Patent 9,788,735)  
IPR2020-01015 (Patent 9,975,300)  
IPR2020-01054 (Patent 9,872,623)

Sotera Wireless, Inc. (“Petitioner”) has filed Petitions pursuant to 35 U.S.C. §§ 311–319 to institute *inter partes* reviews of claims 1–22 of U.S. Patent No. 10,213,108 (IPR2020-00912, Paper 1); claims 1–20 of U.S. Patent No. 9,788,735 (IPR2020-00954, Paper 1); claims 1–20 of U.S. Patent No. 9,975,300 (IPR2020-01015, Paper 1); and claims 1–20 of U.S. Patent No. 9,872,623 (IPR2020-01054, Paper 1).

Masimo Corporation (“Patent Owner”) has filed a Preliminary Response in each proceeding. IPR2020-00912, Paper 8; IPR2020-00954, Paper 7; IPR2020-01015, Paper 6; IPR2020-01054, Paper 6. Patent Owner, in part, urges us to exercise our discretion to deny institution, because a trial here would be an inefficient use of Board resources, in view of the related, parallel district court action, *Masimo Corp. v. Sotera Wireless, Inc.*, Civil Action No. 3:19-cv-01100-BAS-NLS (S.D. Cal.) (“the District Court Litigation”). *See* IPR2020-00912, Paper 8, 15–21; IPR2020-00954, Paper 7, 15–21; IPR2020-01015, Paper 6, 13–19; IPR2020-01054, Paper 6, 14–21.

Upon review of the foregoing, we have concluded further briefing is warranted concerning the factual and legal issues presented as to Patent Owner’s foregoing argument, in particular to address the factors laid out in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). We, therefore, authorize the parties to file further evidence and argument, as follows.

It is hereby:

ORDERED that Petitioner may file in each of the captioned proceedings, on or before Friday, October 16, 2020, a Reply to the Preliminary Response, of no more than seven (7) pages in length, addressing

IPR2020-00912 (Patent 10,213,108)  
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IPR2020-01054 (Patent 9,872,623)

the *Fintiv* factors, and including, if desired, new evidence concerning the status of the District Court Litigation and the relevance thereof to the present proceedings; and

FURTHER ORDERED that Patent Owner may file in each of the captioned proceedings, on or before Friday, October 23, 2020, a Sur-reply to any Reply filed by Petitioner, of no more than seven (7) pages in length, and including, if desired, new evidence concerning the status of the District Court Litigation and the relevance thereof to the present proceedings.

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