

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOTERA WIRELESS, INC.,
Petitioner,

v.

MASIMO CORPORATION,
Patent Owner.

IPR2020-00967 (Patent RE47,244 E)
IPR2020-01019 (Patent RE47,353 E)
IPR2020-01033 (Patent RE47,249 E)¹

Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

ORDER
Granting Requests for Oral Argument
37 C.F.R. § 42.70

¹ This Order addresses issues that are the same in all three cases. The parties are not authorized to use this style heading for subsequent papers without prior Board approval.

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I. ORAL ARGUMENT

A. *Time and Format*

Petitioner Sotera Wireless, Inc. and Patent Owner Masimo Corporation each requested oral argument in these *inter partes* review proceedings pursuant to 37 C.F.R. § 42.70. *See* Papers 34, 35.² Upon consideration, the parties' requests are *granted* as specified and set forth in this Order.

Both parties requested a single consolidated hearing for all three proceedings. Paper 34, 1; Paper 35, 2. As such, we will hold a single consolidated hearing. Each party will have sixty (60) minutes of total oral argument time. The transcript will be entered into each proceeding; however, any argument or evidence presented by a party at the consolidated hearing will be applicable only in the proceeding in which the record provides a proper foundation for such argument or evidence.

Oral argument will commence at 1:00 PM Eastern Time on September 8, 2021, by videoconference. The parties are directed to contact the Board at least 5 business days in advance of the hearing if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing. The parties shall not make, or permit others to make, audio or visual recordings of the proceeding.

² All citations are to IPR2020-00967. Similar requests were filed in IPR2020-01019 (Papers 32, 33), and IPR2020-01033 (Papers 31, 32).

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If at any time during the proceeding, you encounter technical or other difficulties that fundamentally undermine your ability to adequately represent your client, please let the panel know immediately, and adjustments will be made.³

To facilitate planning, each party must contact PTAB Hearings at PTABHearings@uspto.gov five business days prior to the oral hearing date to receive videoconference set-up information. As a reminder, all arrangements and expenses related to a party's appearance by video, such as the selection of the facility to be used from which a party will attend by video, are the responsibility of that party. If a video connection cannot be established, the parties will be provided with dial-in connection information, and the oral hearing will be conducted telephonically.

If one or both parties would prefer to participate in the oral hearing telephonically, they should notify PTAB Hearings at the above email address five business days prior to the hearing to receive dial-in connection information.

Please unmute yourself only when speaking. The panel will have access to all papers filed with the Board, including demonstratives. During the oral hearing, the parties are advised to identify clearly and specifically each demonstrative referenced (e.g., by slide or screen number and where the demonstratives are located in the record, such as by paper number and page) to ensure the clarity and accuracy of the court reporter's transcript. In addition, the parties are advised to identify themselves each time they speak. Furthermore, the remote nature of the oral hearing may result in an audio lag, and so the parties are advised to observe a pause prior to speaking, so as to avoid speaking over others.

³ For example, if a party is experiencing poor video quality, the Board may provide alternate dial-in information.

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Petitioner bears the ultimate burden of proof that the claims at issue in this review are unpatentable. 35 U.S.C. § 316(e). Therefore, at oral hearing, Petitioner will proceed first to present its arguments with regard to the challenged claims and grounds on which we instituted trial in the above-captioned proceedings.

Petitioner may reserve some, but not more than half, of its allotted argument time for rebuttal to respond to Patent Owner's arguments.

After Petitioner's initial presentation, Patent Owner will argue its opposition to Petitioner's case and present the issues for which it bears the ultimate burden, including argument on any of Patent Owner's pending motions, if any. Thereafter, Petitioner may use any reserved time to respond to Patent Owner's presentation. Patent Owner may reserve some of its allotted argument time for sur-rebuttal to respond to Petitioner's arguments. *See Patent Trial and Appeal Board Consolidated Trial Practice Guide ("CTPG"), November 2019 Update, p. 83.*⁴ The parties are reminded that arguments made during rebuttal and sur-rebuttal periods must be responsive to arguments the opposing party made in its immediately preceding presentation. The parties are also reminded that during the hearing, the parties "may only present arguments relied upon in the papers previously submitted." *Id.* at 86.

The parties may request a pre-hearing conference in advance of the hearing. *See id.* at 82. "The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties." *Id.* If either party desires a pre-hearing conference, the

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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parties should jointly contact the Board at Trials@uspto.gov at least seven (7) business days before the hearing date to request a conference call for that purpose.

B. Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstratives shall be served on opposing counsel at least seven (7) business days before the hearing date and filed no later than the time of the oral argument. The panel requests that the **parties file demonstratives three (3) business days** before the hearing date to allow the panel time to review the demonstratives and to also allow the sharing of the demonstratives with the court reporter prior to the hearing.

Demonstratives are not a mechanism for making new arguments. Demonstratives also are not evidence, and will not be relied upon as evidence. Rather, demonstratives are visual aids to a party's oral presentation regarding arguments and evidence previously presented and discussed in the papers. Accordingly, demonstratives shall be clearly marked with the words "DEMONSTRATIVE EXHIBIT – NOT EVIDENCE" in the footer. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (holding that the Board is obligated under its own regulations to dismiss untimely argument "raised for the first time during oral argument"). "[N]o new evidence may be presented at the oral argument." CTPG 85; *see also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that "new" evidence includes evidence already of record but not previously discussed in any paper of record).

Furthermore, because of the strict prohibition against the presentation of new evidence or arguments at a hearing, it is strongly recommended that each demonstrative include a citation to a paper in the record, which allows the Board to

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