

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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IPR2020-01015  
Patent 9,795,300 B2

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

COCKS, *Administrative Patent Judge*.

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

### *1. Introduction*

On January 7, 2021, a conference call was held between counsel for the respective parties and Judges Cocks and Kinder.<sup>1</sup> Petitioner, Sotera Wireless, Inc., was represented by Nathan Sportel and Daisy Manning. Patent Owner, Masimo Corporation, was represented by Sheila Swaroop. Petitioner had requested the call to discuss authorization to file a motion to correct what Petitioner characterized as typographical errors in the Petition.

### *2. Discussion*

During the call, Petitioner expressed that it was seeking to correct certain typographical errors, numbering around a dozen, directed to such matters as cross-referencing mistakes and misnumbered reference characters appearing in the Petition. In e-mail correspondence to Board personnel, Petitioner had initially requested a conference call to discuss authorization to file a motion to submit supplemental information, but had subsequently contacted the Board to also discuss authorization to file a motion pursuant to 37 C.F.R. § 104(c).<sup>2</sup> The panel members noted that a motion to submit supplemental information arising under 37 C.F.R. § 123 did not appear to be the correct vehicle for the relief that Petitioner seeks and that a motion under 37 C.F.R. § 104(c) appeared to more appropriate. Patent Owner objected to any such motion on several grounds including that it is not clear as to the types of alleged mistakes that Petitioner is seeking to identify or change, and

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<sup>1</sup> Judge Chagnon was unavailable for the call. In connection with this Order, reference to “the panel members” is to Judges Cocks and Kinder.

<sup>2</sup> 37 C.F.R. § 104(c) reads “A motion may be filed that seeks to correct a clerical or typographical mistake in the petition. The grant of such a motion does not change the filing date of the petition.”

Petitioner waited more than three and a half months before making its request. Patent Owner expressed that it may be prejudiced if the motion is authorized.

The panel members noted that the purpose of a motion under § 104(c) would be to provide clarity to both the panel and Patent Owner as to the specific nature of the typographical errors that Petitioner was seeking to identify and correct. The panel members noted that were they to authorize Petitioner's motion, the panel members would also authorize an Opposition which would provide Patent Owner the opportunity to express what prejudice, if any, it may face should the motion be granted.

After conferring, the panel members authorized Petitioner to file a motion under 37 C.F.R. § 104(c) of no more than five pages and due no later than January 14, 2021. The panel members also authorized Patent Owner to file an opposition to the motion of no more than five pages and due no later than one week from the filing of any motion.<sup>3</sup>

It is so ORDERED.

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<sup>3</sup> On the call, both parties expressed that the noted briefing schedule and page limits were adequate.

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