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*

Case IPR2020-01033
US Patent No. RE47,249

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

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**PETITIONER'S MOTION TO EXCLUDE
PURSUANT TO 37 C.F.R. §§ 41.155(c) AND 42.64**

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## MOTION AND INTRODUCTION

Pursuant to 37 C.F.R. §§ 41.155(c) and 42.64(c), Petitioner Sotera Wireless, Inc. ("Sotera") moves to exclude certain portions of the following:

**EX2017**     Deposition transcript of George Yanulis, Vol. 1

**EX2022**     Deposition transcript of Bryan Bergeron

Set forth below is the identification of where in the record the above-listed exhibits were relied upon by Patent Owner Masimo Corporation ("Masimo"), where in the record Sotera objected to each exhibit, and Sotera's explanation of each objection.

## ARGUMENT

**A.     Certain Portions of Exhibit 2017 Should Be Excluded Under F.R.E. 402 Because They are Irrelevant**

The following portions of Dr. Yanulis' deposition transcript (Vol. 1) should be excluded because they are inadmissible under F.R.E. 402.

| EX2017 Excerpt | Masimo reliance on excerpt |
|---|---|
| 100:8-15 | Paper 23 at 3, 6, 13, and 66<br>Paper 30 at 6-7 and 9 |
| 123:18-124:5 | Paper 23 at 7 and 21<br>Paper 30 at 7-9 |
| 145:16-146:7 | Paper 23 at 8 |

Masimo relied upon the deposition transcript of Sotera's expert witness, Dr. George Yanulis, in portions of its Patent Owner's Response (Paper 23) and its Sur-

Reply (Paper 30) at the cited portions in the chart above. Sotera timely objected to this testimony during the deposition as having improper form. EX2017 at 100:14, 123:19, 145:20, and 146:4.

When asking the objectionable questions, Patent Owner used the word "defined" to modify the claim language "period of time." However, the claims do not require a *defined* period of time. Patent Owner thus asked a question having no basis in the claim language. Because "defined" in the context of Patent Owner's questions is not relevant to the current proceedings, the testimony should be stricken.

Patent Owner argued that the phrase "parameter specific alarm delay or suspension period of time" should be construed to require that the claimed period of time must be "predetermined," or occasionally "fixed." *See, e.g.*, Paper 5 at 1, 3, 7, 10, 11, 12, and 24. Until the time of Dr. Yanulis' deposition, Patent Owner had repeatedly argued that the RE249 patent discloses and claims "predetermined" amounts of time. *Id.* Nowhere in the Patent Owner's Preliminary Response, however, did Patent Owner take the position that the claims required a "defined" amount of time.

Only after the Board rejected Patent Owner's proposed claim construction of "predetermined" did Masimo adopt the term "defined" in connection with the claimed alarm delay or suspension periods of time. Paper 11 at 11-13. Instead,

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