

Filed on Behalf of Valencell, Inc.

By: Sanford E. Warren Jr. (SWarren@wriplaw.com)

R. Scott Rhoades (SRhoades@wriplaw.com)

Warren Rhoades LLP

1212 Corporate Drive, Suite 250

Irving, Texas 75038

Tel: 972-550-2955

Fax: 469-442-0091

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

VALENCELL, INC.

Patent Owner

Case IPR2017-00317

U.S. Patent No. 8,989,830

**PATENT OWNER'S CONDITIONAL
MOTION TO AMEND UNDER 37 C.F.R. § 42.121**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

TABLE OF CONTENTS

I. STATEMENT OF RELIEF REQUESTED1

II. THE SUBSTITUTE CLAIMS DO NOT EXPAND THE SCOPE OF THE CLAIMS2

III. THE SPECIFICATION SUPPORTS THE NEW LIMITATIONS OF THE SUBSTITUTE CLAIMS7

IV. THE SUBSTITUTE CLAIMS ARE PATENTABLE OVER THE PRIOR ART 14

 A. Summary of the Invention..... 14

 B. Claim Construction..... 16

 C. Level of Ordinary Skill in the Art..... 16

 D. The Claim Amendments Overcome the Asserted Grounds of Patentability..... 17

 1. Closest Prior Art..... 17

 a. Hong - 2008/0132798 (Ex. 2128) 18

 b. Amano - 6,081,742 (Ex. 2129) 19

 c. Vetter - 2003/0065269 (Ex. 2130)..... 20

 d. Verjus - 2003/0233051 (Ex. 2131) 20

 e. Asada - Mobile Monitoring with Wearable Photoplethysmographic Biosensors (Ex. 2132)..... 21

 f. Han - Development of a wearable health monitoring device with motion artifact reduced algorithm (Ex. 2133) 22

 g. Comtois - A Comparative Evaluation of Adaptive Noise Cancellation Algorithms for Minimizing Motion Artifacts in a Forehead-Mounted Wearable Pulse Oximeter (Ex. 2134) 23

 3. Other Art 23

V. CONCLUSION 24

APPENDIX A: CLAIM LISTING 27

TABLE OF AUTHORITIES

Cases

Cuozzo Speed Techs. LLC v. Lee, 136 S. Ct. 2131, 2144–46 (2016) 16
Idle Free Sys. Inc. v. Bergstrom, Inc., IPR2012-00027 Decision Motion to
Amend Claims, Paper 26, June 11, 2013.....2
MasterImage 3D, Inc. v. RealD, Inc., Case No. IPR 2015-00040 (Paper No.
42) 18
Nike, Inc. v. Adidas AG, 812 F.3d 1326, 1350-51 (Fed. Cir. 2016)2
Paulsen, 30 F.3d 1475, 1480 (Fed. Cir. 1994) 16
Translogic Tech., Inc., 504 F.3d 1249, 1257 (Fed. Cir. 2007)..... 16

Statutes

35 U.S.C. § 316(d)1

Rules

37 C.F.R. § 42.100(b) 16
37 C.F.R. § 42.121
37 C.F.R. § 42.121 1, 24
37 C.F.R. § 42.121(a)(2)(i)2
37 C.F.R. § 42.121(a)-(b)2
37 C.F.R. § 42.22(a)(2).....1

TABLE OF EXHIBITS

Exhibit No.	Description
2105	U.S. Patent No. 8,989,830 to LeBoeuf <i>et al.</i> , issued March 24, 2015
2106	U.S. Patent Application No. 14/484,585, now U.S. Patent No. 8,989,830, original specification, claims, and figures.
2107	U.S. Patent Application No. 14/184,364, now U.S. Patent No. 8,886,269, original specification, claims, and figures.
2108	U.S. Patent Application No. 12/691,388, now U.S. Patent No. 8,700,111, original specification, claims, and figures.
2109	Provisional Application No. 61/274,191, filed on August 14, 2009, original specification, claims, and figures.
2110	Declaration of Dr. Albert H. Titus
2128	U.S. Patent Application Publication No. 2008/0132798 to Hong <i>et al.</i> , published June 5, 2008
2129	U.S. Patent Number 6,081,742 to Amano <i>et al.</i> , issued June 27, 2000
2130	U.S. Patent Application Publication No. 2003/0065269 to Vetter <i>et al.</i> , published April 3, 2003
2131	U.S. Patent Application Publication No. 2003/0233051 to Verjus <i>et al.</i> , published December 18, 2003
2133	Hyonyoung Han <i>et al.</i> , <i>Development of a wearable health monitoring device with motion artifact reduced algorithm</i> , International Conference on Control, Automation and Systems, IEEE (2007)

2134	G. Comtois & Y. Mendelson, <i>A Comparative Evaluation of Adaptive Noise Cancellation Algorithms for Minimizing Motion Artifacts in a Forehead-Mounted Wearable Pulse Oximeter</i> , IEEE (2007)
------	--

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.