

Filed on behalf of Valencell, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,
v.
VALENCELL, INC.,
Patent Owner.

Case IPR2017-00317¹
U.S. Patent No. 8,989,830

**PATENT OWNER'S MOTION FOR OBSERVATION ON CROSS-
EXAMINATION OF REPLY DECLARANT BRIAN W. ANTHONY**

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¹ IPR2017-01553 has been joined to this current proceeding.

I. OBSERVATIONS

Patent Owner submits the following observations on the December 20, 2017, cross-examination of Petitioner's reply declarant, Dr. Brian W. Anthony. The transcript of Dr. Anthony's December 20, 2017, deposition filed as Ex. 2150 ("Dec. 20 Tr."), which includes testimony for both IPR2017-00317 and IPR2017-00318.

Observation 1:

In Dec. 20 Tr., on page 115, line 8 through page 118, line 5, Dr. Anthony testified as follows:

Q. And Doctor Asada is in the same department with you at MIT; correct?

A. Correct. He's in the department of mechanical engineering, which is one of the departments I'm appointed in.

Q. Did you walk down to Doctor Asada's office and ask him why a tethered version of prototype B was required?

A. I did not, and I believe you asked that in my earlier deposition. I didn't feel a person skilled in the art would need to go talk to Doctor Asada to understand his paper here.

Q. Well, you're -- you're just guessing at a reason why, and the actual source of the information is a colleague of -- of yours, and you just decided not to go ask him for that information?

A. I was asked to form my own opinion. I didn't feel it was necessary. My -- what a person skilled in the art would have understood from this was as covered in here.

Q. So after your deposition – since September you didn't take the opportunity to go speak to Doctor Asada about this reference in figuring out.

A. I -- I have not.

Q. And why is that?

A. Didn't feel it was necessary.

Q. And -- and you testified in your prior depositions that you introduced Apple's counsel to Doctor Asada via email; correct?

A. That was correct.²

This testimony is relevant to Petitioner's attempt to discredit Patent Owner's argument that the wireless device of Asada was prohibited from use in a hospital environment at page 27 of the -317 Reply and page 28 of the -318 Reply.³ This testimony is relevant because it shows Dr. Anthony's willful blindness to the actual facts of Asada, and because it shows that Petitioner's counsel had access to the facts of Asada and chose not to supply those facts in this proceeding and instead relied on assumptions from Dr. Anthony.

² For brevity and clarity, objections from counsel have been omitted, without notation, from the deposition excerpts in this paper.

³ For ease of cross-referencing between the IPR2017-00317 and -00318, Patent Owner has included citations to both matters, where applicable.

Observation 2:

In the Dec. 20 Tr., on page 49, line 9 through page 51, line 5, Dr. Anthony testified as follows:

Q. Have you ever seen "guiding" defined as allowing to pass?

A. (Witness reviews document.) So as I – as I do highlight here, I mean, a person skilled in the art reading these claims would have understood that a -- what is being described as a window that is serving as a light-guiding interface to the body, that it's allowing light to come from -- through -- pass through the cladding material into the body. And that's -- window is serving as that light-guiding interface to the body.

Q. (Reviews screen.) So I asked you: "Have you ever seen "guiding" defined as allowing to pass?" Then you cited to the claim claims. So are the claims here the only situation where you've seen the term "guiding" defined as "allowing to pass"?

A. So I was not forming a broad general opinion of what "guiding" means. I was making a statement in my declaration about what guiding means -- the light-guiding interface means in the contexts of these -- of this patent. If you want me to formulate a global definition of "guiding" under all its possible uses, I did not do that before this deposition -- or before my declaration.

This testimony is relevant to Petitioner's arguments on the construction of the term "light guiding interface" at pages 5-8 of the -317 and -318 Replies. This testimony is relevant because it shows the lack of basis for Petitioner's interpretation that "light guiding" can mean allowing light to pass.

Observation 3:

In the Dec. 20 Tr., on page 55, lines 1-10, Dr. Anthony testified as follows:

Q. Do you know if all the layers of Goodman are adhered together in Figure 2C?

A. (Witness reviews document.) Without re -- rereading or looking at the -- Goodman's -- the Goodman reference, I don't recall explicitly whether that's stated, but a person skilled in the art would understand that they would likely be adhered together in some way to form a tight construction with adhesive between the layers to hold them together.

This testimony is relevant to pages 9-11 of the -317 and -318 Replies, where Petitioner relies on Dr. Anthony to make its argument that the elements of Goodman's Figure 2C are not adhered together as shown in the modified figure in Patent Owner's Responses. This testimony is relevant because, prior to this deposition, Dr. Anthony was not aware of whether the elements in Goodman's Figure 2C were adhered together, and thus Dr. Anthony lacked the required knowledge necessary to interpret Figure 2C.

Observation 4:

In the Dec. 20 Tr., on page 70, line 1 through page 71, line 7, Dr. Anthony testified as follows:

Q. We know that light emitter 24 is adhered to element 30; correct?

A. Through adhesive surface 32, yup, as described on line 21 or 22.

Q. And we know that by "detector 14 is adhered to element 30"; correct?

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