

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. and FITBIT, INC.
Petitioner

v.

VALENCELL, INC.
Patent Owner

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

**PETITIONER APPLE INC.'S RESPONSE TO
PATENT OWNER'S MOTION FOR OBSERVATIONS
ON CROSS EXAMINATION**

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¹ Case IPR2017-01553 has been joined with this proceeding.

Petitioner Apple Inc. (“Apple”) submits the following Response to Patent Owner Valencell, Inc.’s (“Valencell”) Motion for Observation on Cross-Examination (“Mot. Obs.”) of Apple’s expert, Dr. Brian Anthony.

Response to Observation #1

Valencell refers to Dr. Anthony’s testimony in Exhibit 2150, 115:8–118:5, as being relevant because it allegedly “shows Dr. Anthony’s willful blindness to the actual facts of Asada....” (Mot. Obs., p. 3.)

Valencell’s allegation introduces new argument and is without legal or factual merit. As Dr. Anthony testified, he was asked to provide his opinions as to how a person of ordinary skill in the art would understand the Asada reference (Ex. 2150, 116:23-25, 117:13-15), which comports with long established case law, which provides “[w]e evaluate and apply the teachings of all relevant references on the basis of *what they reasonably disclose and suggest to one skilled in the art....*” *In re Aslanian*, 590 F.2d 911, 914 (CCPA 1979) (emphasis added).

Valencell also alleges this testimony is relevant “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.” (Mot. Obs., p. 3.)

Valencell’s allegation introduces new argument and is without legal or factual merit. Contrary to Valencell’s implication, an introduction to Dr. Asada via

email does not mean that Apple “had access” to Dr. Asada’s opinions. Furthermore, Valencell’s allegation is irrelevant to how the reference would be understood by a person of ordinary skill in the art.

Response to Observation #2

Valencell refers to Dr. Anthony’s testimony in Exhibit 2150, 49:9–51:5, as being relevant because it allegedly “shows the lack of basis for Petitioner’s interpretation that ‘light guiding’ can mean allowing light to pass.” (Mot. Obs., p. 4.) But this testimony fully supports Apple’s interpretation because, as Dr. Anthony testified, “*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.” (Ex. 2150, 49:12-18 (emphasis added).) This is consistent with the testimony of Valencell’s declarant, Dr. Titus:*

Q Do you see the part of Claim 1, the top of Line 40 where it states:
At least one window formed in the cladding material that serves as a light-guiding interface to the body of the subject?

A Yes.

Q So is it your understanding that for that claim limitation, the window is serving a light-guiding function?

A The win- -- *I don't believe the window serves a light-guiding function.*

(APL1100, 186:16-24 (emphasis added); *see also* APL1100, 88:2-11, 94:23-95:5, 179:4-12.)

Response to Observation #3

Valencell refers to Dr. Anthony's testimony in Exhibit 2150, 55:1–10, as being relevant because it allegedly shows that “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.” (Mot. Obs., p. 5.)

This mischaracterizes Dr. Anthony's testimony, which is simply that he did not “recall explicitly whether that's stated...” (Ex. 2150, 55:5-6) because he had not been provided a copy of the Goodman Exhibit (Ex. 2150, 56:17-19 (“So I'm paraphrasing from the memory of the Goodman. I could look at it in more detail, if provided a copy of it.”)). Dr. Anthony also affirmatively testified that he understood how Goodman's device was assembled. (Ex. 2150, 54:17-20 (“**Q.** When you were reading Goodman, did you come to an understanding of how the device in Figure 2C is assembled? **A.** Yes. Yes.”); *see also* Ex. 2150, 55:19-22.)

Response to Observation #4

Valencell refers to Dr. Anthony's testimony in Exhibit 2150, 70:1–71:7, as being relevant because it allegedly “discredits Petitioner's argument that the

elements of Goodman’s Figure 2C are not adhered together such that elements 24 and 14 are pushed through apertures 40 and 41.” (Mot. Obs., p. 6.)

Valencell’s observation mischaracterizes the testimony as it is disingenuous because, after explaining how Valencell’s annotated Figure 2C of Goodman is “misleading, because it’s incomplete,” it is clear from the context that Dr. Anthony misspoke, leaving out the word “not”: “A person skilled in the art *would not* -- from both the description, from the figure, from the arrows -- *would [not] understand* that the emitter detector may extend all the way through the windows. They’re sitting *close to it, but not all the way through.*” (Ex. 2150, 70:18-71:3 (emphasis added).) This is apparent from the last sentence of his testimony, which is consistent with Dr. Anthony’s other testimony describing Valencell’s annotated Figure 2C of Goodman. (*See e.g.*, Ex. 2150, 62:17-23 (“So it’s not recognizing that the layers above it, which is layer 46 -- or layer 45, with adhesive coatings 46 and 47, *would be preventing that -- the emitter and detector -- the light source and the photo sensor to be pushed through, as they are shown here.*”) (emphasis added)); APL1102, ¶¶12-17.)

Response to Observation #5

Valencell refers to Dr. Anthony’s testimony in Exhibit 2150, 77:20–23, as being relevant because it allegedly “shows that Petitioner’s inclusion of the phrase ‘allows the light to pass through’ in its construction of window that serves as

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