

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 IPR2017-00318¹
U.S. Patent No. 8,886,269

**PETITIONER APPLE INC.'S SUR-REPLY TO
PATENT OWNER'S CONDITIONAL MOTION TO AMEND**

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U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

¹ Case IPR2017-01554 has been joined with this proceeding.

I. Introduction

Petitioner Apple Inc. opposed Valencell's ("PO") Conditional Motion to Amend ("MTA") because substitute claims 12-21 are unpatentable under 35 U.S.C. § 112 and 35 U.S.C. § 103. PO's Reply in Support of its Conditional MTA ("PO MTA Reply") provides unpersuasive arguments that misrepresent Asada, Swedlow, Goodman, and Gupta's teachings to argue that a POSA would not be motivated to combine these references. Thus, as demonstrated in Petitioner's Opposition ("Pet'r Oppo."), the Board should deny the MTA.

II. Substitute Claims 12-21 Lack Written Description Support

Petitioner demonstrated in its Opposition that there was no written description support in the '269 patent for a band-pass filter that, itself, reduces motion artifacts by removing frequency bands from signals produced by a motion sensor, as recited in substitute claim 12. (Pet'r Oppo., 1-2.) PO argues that Petitioner and its expert misunderstood the claim, and that the claim as properly understood is supported by the specification. (PO MTA Reply, 1.) However, PO's arguments further muddy the waters, as PO states that "reduction of motion artifacts is done, in part, by the processor producing pre-conditioned signals through the removal of frequency bands outside the range of interest." (*Id.*, 2.) PO goes on to state that "[p]re-conditioned signals are utilized by the processor to reduce motion artifacts and those pre-conditioned signals are configured by using

band-pass filters on the signals.” (*Id.*) Thus, it is unclear whether PO is arguing that the processor is removing frequency bands outside the range of interest, the band-pass filters are removing frequency bands outside the range of interest, or both are removing frequency bands. In any case, PO’s argument fails because the claim is clear that the band-pass filter is removing frequency bands from a signal, and that signal must be produced by a motion sensor. As Petitioner demonstrated in its Opposition, this is not supported by the ’269 patent and therefore claim 12 and all of its dependent claims are unpatentable under 35 U.S.C. § 112.

Furthermore, to the extent that PO now explains how a portion of the ’269 patent allegedly provides written description support, this is too little, too late. PO had the burden to demonstrate written description support in its MTA. Indeed, PO’s expert testified that for his declaration supporting PO’s MTA, he was not asked to provide an opinion as to whether this feature—or any feature for that matter—had written description support. (APL1100, 183:17-24 (“I don’t believe I was asked to do that.”).)

III. Substitute Claims 12-21 are Indefinite

PO contends that substitute claim 12 states that the goal of the processor is to extract physiological and motion-related information and that the same information is parsed into the output data. PO therefore alleges that there is no ambiguity as to the meaning of physiological and motion-related information in

step (iii) of claim 12. (PO MTA Reply, 2-3.)

However, claim 12 does not state that the “same” physiological and motion-related information is used in step (i) and step (iii). The phrase “motion-related and physiological information” in step (iii) is not preceded by any indication, such as “the” or “the same,” that would indicate that the “motion-related and physiological information” of step (iii) is the same as that of step (i). Rather, the “motion-related and physiological information” of step (iii) could be the same as in step (i), or it could be different. For example, the claim includes other types of “motion-related and physiological information,” such as the “signals” of step (i), the “pre-conditioned signals” of step (ii), the “motion artifacts” of step (ii), and “information” of step (iii). Thus, “motion-related and physiological information” in step (iii) could be referring to any of these, or some other form of motion-related and physiological information not even mentioned in the claim. Accordingly, a POSA would not understand the scope of the claim and so the claim is indefinite.

IV. A POSA Would Be Motivated to Combine Asada and Swedlow

PO alleges that there would be no motivation to combine Asada and Swedlow. (PO MTA Reply, 5-7.) PO is wrong. PO’s flawed position is premised on the allegation that “**NO WHERE** in Asada is a problem with disconnection or comfort discussed.” (PO MTA Reply, 6 (emphasis original).) Yet Asada recognizes that comfort of its ring sensor is an important design consideration.

(Pet'r Oppo., 4 (citing APL1005, pp. 29-30, 36).) Given this recognition of comfort as a design consideration, a POSA would have been motivated to look for approaches to improve comfort and would have been motivated to combine Asada and Swedlow, as explained in Petitioner's Opposition. (Pet'r Oppo., 4.) Petitioner also identified that a POSA would combine Asada and Swedlow to increase reliability and decrease cost—motivations that PO's reply did not address. (*Id.*)

PO also alleges that “**NEITHER** Asada or Swedlow discuss ‘etched wires’ nor use this phrase” to support its view that a POSA would not be motivated to combine Asada and Swedlow. (PO MTA Reply, 6 (emphasis original).) However, the Opposition demonstrated that Swedlow uses a flexible substrate and explained the simplicity of using etched wires to carry electrical signals for the photodetector and LEDs. (Pet'r Oppo., 4.) Whether the specific phrase “etched wires” occurs within Asada or Swedlow is of no import. A POSA would understand that “etched wires” are compatible with the flexible substrate of Swedlow, as corroborated by Awazu. (*Id.*)

V. A POSA Would Be Motivated to Combine Asada and Gupta

PO argues that a POSA would not combine Asada and Gupta because “Asada **expressly** teaches away from a device such as Gupta and teaches away from the specific Gupta impact sensor.” (PO MTA Reply, 9 (emphasis original).)

PO has the burden of production to prove a teaching away. *See RICOH Co. v.*

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