

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC. and FITBIT, INC.  
Petitioner

v.

VALENCELL, INC.  
Patent Owner

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Case IPR2017-00318<sup>1</sup>  
U.S. Patent No. 8,886,269

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

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<sup>1</sup> Case IPR2017-01554 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, 173:6–174:20, as being relevant because it allegedly “shows Dr. Asada’s [*sic*] inconsistent identification of the elements of Fig. 11” in Asada. (Mot. Obs., p. 3.)

First, Valencell omits—without any indication—Dr. Anthony’s testimony at 173:21-174:14, which states that he was responding “on the fly here....” (Ex. 2150, 174:9-10.) Second, a “biocompatible elastic material” and an “adhesive” are not mutually exclusive as Valencell suggests, and is consistent with Asada, which describes using “*bio-compatible elastic materials to better hold the LED’s and PD’s.*” (APL1005, p. 35 (emphasis added).)

### **Response to Observation #2**

Valencell refers to Dr. Anthony’s testimony in Exhibit 2150, 163:9–19, as being relevant because it allegedly “shows Dr. Anthony’s willful blindness to the facts of Asada’s Fig. 11, despite having those facts readily available to him.” (Mot. Obs., p. 4.)

Valencell’s observation mischaracterizes Dr. Anthony’s testimony, which states that he did not need to consult Dr. Asada regarding the disclosure of the

Asada reference because “I felt I knew what the components were as I had labeled them here.” (Ex. 2150, 163:18-19.) This is consistent with Dr. Anthony’s testimony that “I was also asked to form my own opinions, not go ask Doctor Asada his opinions,” and “I don’t want phone calls from the people that are reading my papers. I’d never get any work done.” (Ex. 2150, 116:23-25, 117:13-15.) Dr. Anthony’s testimony is also consistent with the law, which provides that “[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).

### **Response to Observation #3**

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. 5.)

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. 5.)

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 #4**

Valencell refers to Dr. Anthony’s testimony in Exhibit 2150, 164:6–22, as being relevant because it allegedly “shows that Petitioner ignores that the relational information is already conveyed via the vertical lines, which are used for layer 3 and the other components of Figure 11.” (Mot. Obs., p. 6.) But Dr. Anthony’s testimony cited by Valencell—that “[t]he entire box is showing how they would be assembled and projected down”—directly addresses the “relational information” provided by the dashed rectangles. This testimony is also consistent with Dr. Anthony’s testimony that “[i]t would be unusual, actually, as a -- for a drawing, it would be very weird to have just those four pillars showing the -- the relationship without having the -- the projection of it onto the material itself” and that “I would

expect if those were something other than the projections, for those to be solid lines -- if they were intended to be a cutout, for example, of the -- the light transmissive material.” (Ex. 2150, 165:12-16, 166:21-24.)

### **Response to Observation #5**

Valencell refers to Dr. Anthony’s testimony in Exhibit 2150, 168:3–169:12, as being relevant because it allegedly “shows that elements 1 and 2 of Figure 11 of Asada would nonetheless protect the optical components from direct contact with the skin.” (Mot. Obs., p. 7.) Dr. Anthony’s testimony that “[o]ther layers *could also help to protect*” or “could serve to *help further* isolate the optical components” is entirely consistent with light transmissive Layer 3 of Asada *not* having apertures. (Ex. 2150, 169:6-12 (emphasis added).)

### **Response to Observation #6**

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. 8.) 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 --

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