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UNITED STATES PATENT AND TRADEMARK OFFICE  

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,<sup>1</sup>  
Petitioner,

v.

VALENCELL, INC.,  
Patent Owner.

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Case IPR2017-00319<sup>2</sup>  
U.S. Patent No. 8,923,941  

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**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

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

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<sup>1</sup> Petitioner Apple Inc. (“Apple”) is no longer a party in this proceeding.

<sup>2</sup> Case IPR2017-01555 has been joined with this proceeding.

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## I. INTRODUCTION

Pursuant to the Federal Circuit’s Order granting limited remand in light of *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021),<sup>3</sup> and 37 C.F.R. § 42.71(d), Patent Owner Valencell, Inc. (“Valencell”) submits this Request for Director Review of the Board’s Final Written Decision on Remand, which found that claims 3–5 (the “challenged claims”) of U.S. Patent No. 8,923,941 (the “’941 patent”) are unpatentable as obvious over Luo and Craw, alone or in combination with Wolf. *See* Paper 73 at 18–34, 46–47. Review by the Director is warranted because the Board’s Final Written Decision on Remand is premised on new arguments about the prior art that were not made in the Petition and that conflict with the arguments actually made in the Petition and the testimony of Petitioner’s own expert witness. Further, the Board’s findings also rest on fundamental misunderstandings of the disclosures in the prior art. Because Drew Hirshfeld has not been appointed by the President and confirmed by the Senate as the Director of the Patent and Trademark Office (“PTO”)

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<sup>3</sup> Following Valencell’s Notice of Appeal, the Supreme Court issued its decision in *Arthrex*. Valencell thereafter filed a motion for stay and limited remand with the Federal Circuit, which the Court granted on November 10, 2021. *See Valencell, Inc. v. Fitbit, Inc.*, No. 21-2041 (Fed. Cir. Nov. 10, 2021), Doc. No. 26. This request is timely as it comes within 30 days of the Federal Circuit’s order. *See id.* at 2.

as required by *Arthrex*, Valencell respectfully requests that the PTO defer consideration of this Request until a new Director is confirmed.

## II. FACTUAL BACKGROUND

### A. Overview of the Challenged Claims

The '941 patent, entitled “Methods and Apparatus for Generating Data Output Containing Physiological and Motion-related Information,” discloses wearable monitors used to measure multiple types of physiological and motion-related information about a person. Ex. 1001, Abstract. One type of sensor used by the monitors is a photoplethysmography (“PPG”) sensor, which can be used to measure a person’s heart rate. *Id.* at 4:3–5. Another type of sensor used by the monitors is a motion sensor for sensing physical activity. *Id.* at 30:41.

Of particular relevance, the '941 patent discloses generating a “serial data output” that “is parsed out such that an *application-specific* interface can utilize the physiological information and motion-related information for an application” to assess the person’s fitness or health. *Id.*, Abstract (emphasis added). Figure 17 illustrates the generation of such a serial data string 604 from sensor input, and the serial data string 700 is also illustrated in Figure 18, where the different types of information are parsed out for use by a particular application. *Id.* at 25:65–26:33. In discussing Figures 17 and 18, the patent further explains that:

The multiplexed data outputs 604 may be a serial data string of activity and physiological information 700 (FIG. 18) parsed out *specifically*

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