UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VALENCELL, INC.
Patent Owner

Case IPR2017-00319[1]
Patent 8,923,941

PETITIONER APPLE INC.'S
ADDITIONAL BRIEFING REGARDING CLAIMS
PREVIOUSLY DENIED INSTITUTION

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[1] Case IPR2017-01555 has been joined with this proceeding.

The Board authorized in its May 23, 2018 Order Petitioner (Apple, Inc.) to submit this briefing to address recently instituted claims 3-5.[2] (Paper 39, 6-7.)

I. Claim 3 would have been obvious over (1) Luo in view of Craw and (2) Mault in view of Al-Ali in further view of Lee.

Apple proved in the Petition that claim 3 would have been obvious over two independent grounds despite an apparent typographical error in claim 3's term "application specific interface (API)." (Paper 2, ("Pet."), 8, 27, 55-59.) Apple addresses the typographical error first, followed by the merits of claim 3.

A. Claim 3's term "application specific interface (API)" appears to contain a typographical error.

The term "application specific interface (API)" appears to have a typographical error because "API" was the well-known acronym for "application programming interface." (Pet., 14-15; Ex. 1003, ¶62-63.) The term "application specific interface," however, was not common in the art. (*Id*.) Apple's position is supported by noted expert, Dr. Majid Sarrafzadeh, who opined that a person of ordinary skill in the art ("POSA") would have assessed that claim 3 and the specification contained a typographical error. (Ex. 1003, ¶62). Dr. Sarrafzadeh evaluated the speci-

[2] Petitioner was denied the relief requested in its May 8, 2018 email, particularly the right to conduct discovery on the newly instituted claims or present additional evidence, and thus hereby preserves its rights to challenge this lack of due process in any appeal that may be filed from a final written decision on claims 3-5.

fication, finding that the specification was not helpful in construing the term. (*Id.*, ¶63.) Indeed, the specification merely repeats verbatim the claim language.

Contrary to the Board's assertion that "the Specification explains that the 'application-specific interface (API)' is directed to a 'particular application,' rather than *broadly* to different applications" (Paper 10 ("DI"), 12), the specification merely indicates that ***the data*** is parsed such that an API can ***use*** the data ***for*** a particular application. (Ex. 1001, 26:15-23.) It does not say that the API itself is "directed to" a particular application. This is evidenced by the specification itself, and Dr. Sarrafzadeh's analysis based on his reading of the specification from the perspective of a POSA. Patent Owner ("Valencell") did not dispute that this term had a typographical error, instead arguing that the term did not need to be construed.

Further, claim construction determinations made in the Institution Decision are preliminary.[3] Had claim 3 been instituted, as the *SAS* decision now tells us it should have been, then discovery would have shown that Apple's original analysis was correct. Valencell's expert testified that the disputed term contains an error:

> [M]y interpretation of this section essentially refers to an API, even if it's used as application-specific interface…***there is kind of a mismatch*** between the spelled-out, like, terminology and – and the acro-

[3] While the Board did not provide an explicit construction, the decision that Apple's proposed construction was incorrect was a claim construction determination.

> nym for it. It – I cannot – ***I don't know how exactly why the P or the programming word has been left out specifically***, but it is – in my interpretation ***it is definitely reasonable to assume*** they offer here, ***the inventor is referring to the API*** as I described above.

(Ex. 1069, 127:13-24 (emphasis added).) He further testified that the "API as I described above" is the well-understood "application programming interface" that "in general is a software method, not necessarily implemented, it can just be a description like in a user manual form that allows programmers that have a specific, you know, application in mind to interface their own implementation …with another source of data." (*Id*., 126:6-16.) And when asked whether the term "application-specific interface" as used in the specification "is the same as the commonly-understood application programming interface that's used in the art," Valencell's expert said, "[i]t could be application-specific programming interface, if you want to, you know, match those two, but, yes, it's basically the same." (*Id*., 128:4-12.)

Accordingly, Valencell's own expert agreed and confirmed that the phrasing as written in the specification (and thus the claim) appeared to be in error, and would have been understood instead to refer to the well-known "application programming interface." Apple submits that this answers in the positive the Board's threshold question regarding whether the claim term includes a typographical error.

B. Even if not a typographical error, the claim term is ambiguous, warranting construction; Valencell's own expert corroborates Petitioner's proposed construction.

The Board said that when the intrinsic evidence is clear, there is no need to look to extrinsic evidence. (DI, 10-11.) But the intrinsic evidence is not clear. While the specification gave a use case, it did not *define* the term any more clearly. Again, the intrinsic evidence indicates that an API is "utilize[d]" for a particular application, not that the API itself is "directed to" a particular application. Apple did not choose extrinsic evidence *over* the intrinsic evidence, as alleged. (*Id.*, 11.) Apple consulted extrinsic evidence because the intrinsic evidence was just as ambiguous – indeed, verbatim – as the claim language in question. (Pet., 14.) Thus, the use of extrinsic evidence (Dr. Sarrafzadeh's declaration) was appropriate, and should not be discredited. *Teva Pharma. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 840 (2015). Likewise, Valencell's expert's testimony should be considered.

C. The grounds presented provide an API that is "utilized" for a particular application.

Even if the Board maintains – contrary to the opinions of both Apple's and Valencell's respective experts – that no typographical error existed in the claims, the Board should still consider the merits of Apple's grounds using the Board's determined construction. Or, in the absence of a specific construction (as the Board maintains is the case here), the Board should evaluate the grounds using what the Board considers to be the plain and ordinary meaning of the term.

If it had done so, the Board would have seen that the Petition includes a sufficient challenge to claim 3, even if the Board disagreed with Apple's claim con-

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