

Filed on behalf of Valencell, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-00319¹
U.S. Patent No. 8,923,941

**PATENT OWNER'S RESPONSE TO APPLE'S ADDITIONAL BRIEFING
REGARDING CLAIMS PREVIOUSLY DENIED INSTITUTION**

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

Patent Owner Valencell, Inc. submits this responsive brief under the Board's Order of May 23, 2018 (Paper 39) regarding previously non-instituted claims 3-5.²

I. “Application-Specific Interface” in Claim 3 Is Not a Typographical Error and Petitioner’s Proposed Construction Is Incorrect.

Three times³ the Board correctly rejected Petitioner’s argument—which underpins its entire case against claim 3—that “application-specific interface (API)” is a typographical error. Paper 10 (“DI”) at 9-12; Paper 15 (“Dec.”), *passim*. Petitioner’s argument is contradicted by the unwavering use of the term “specific” in the claim language, specification, and prosecution history of U.S. Patent No. 8,923,941 (“the ’941 patent”). *See* Ex. 1001 at Abstract, 26:15-19, and 30:62-65; *see also* Ex. 1002 at 47-48, 55, 95, 132, and 157. Petitioner disregards this intrinsic evidence and relies only on speculation and extrinsic evidence; but it is well settled that extrinsic evidence contrary to the meaning mandated by the intrinsic record is discounted. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (citing *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 716 (Fed. Cir. 1998)).

² For the reasons set forth in its May 8, 2018 email to the Board, Patent Owner respectfully preserves the right to challenge this post-SAS procedure.

³ The Board re-confirmed this decision in IPR2017-00321, Paper 44 at 61-62.

Further, the Board rightly concluded that the context of the use of “application-specific interface (API)” in the specification of the ’941 patent demonstrates that Petitioner is wrong to conclude that the term should be read as being equivalent to an “application programming interface.” DI at 11. The specification teaches that “[t]he multiplexed data outputs 604 may be a serial data string of activity and physiological information 700 (FIG. 18) parsed out specifically such that an *application-specific* interface (API) can utilize the data *as required for a particular application.*” Ex. 1001 at 26:15-18 (emphasis added). This explicit teaching from the ’941 patent contradicts Petitioner’s argument that “application-specific interface (API)” is equivalent to an “application programming interface” and can include any “application interface that specifies how some software components should interact with each other.” Paper 2 (“Pet.”) at 14-15. Instead, this teaching further supports the Board’s rejection of Petitioner’s unsupported construction, because it shows that the “serial data output” is created to be used with a specific, not merely a generic, application.

Petitioner invites the Board to err by blatantly reading the term *specific* out of the claimed “application-specific interface.” Petitioner demands that the Board deviate from established claim construction standards, assume that “application-specific interface (API)” contains a typographical error, and then jump directly to extrinsic evidence. Petitioner is explicit in asking the Board to read the limitation

“application-*specific* interface” out of the claim, overlook the consistent use of the term in the ’941 patent and file history, and the contextual explanation of the term, and to instead accept Petitioner’s expert’s opinion about what the term allegedly means. *See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1582 (Fed. Cir. 1996) (“Ethicon . . . invites us to read its . . . limitation out of the claim. *This we cannot do.*”) (emphasis added). Such a backwards analysis is precisely what the Federal Circuit rejected in *Phillips*. Further, even assuming an error, the Board correctly noted that it could not speculate as to whether the error is in the words of the phrase, or in the letters of the abbreviation. DI at 9-10. Given the use of the word “specific” throughout the intrinsic record, and the explanation that it is “as required for a particular application,” it is much more plausible that any error is in the abbreviation, not in the explicit words of the preceding phrase.

Having failed to convince the Board to adopt its construction of “application-specific interface (API),” Petitioner suggests that *additional* extrinsic evidence, in the form of deposition testimony from Patent Owner’s expert Dr. Pollonini, should overcome all of the intrinsic evidence that the Board has rightly relied upon. But Dr. Pollonini never construed the term “application-specific interface (API),” nor did Dr. Pollonini agree that there is a typographical error in claim 3. And contrary to Petitioner’s argument, Dr. Pollonini confirmed the importance of the term “specific” in the phrase, saying “[i]t could be application-*specific* programming interface, if

you want to, you know match those two . . .” Ex. 1069 at 128:9-11 (emphasis added). He also testified that “the serial data output allows clearly the respiration rate to be extracted, for instance, as cited in claim 3 by an application-*specific* interface.” *Id.* at 64:23-65:3 (emphasis added). Thus, the testimony on which Petitioner now hangs its hat is, at best, taken out of context. More importantly, Dr. Pollonini’s testimony is no more than the same type of extrinsic evidence that the Board has already rejected.

II. Claim 3 Is Patentable Even Under Petitioner’s Incorrect Construction.

While Petitioner’s attempt to subvert the intrinsic record and read the phrase “application-*specific* interface” out of the ’941 patent is legally incorrect, the prior art does not invalidate claim 3 even under that improper construction. Patent Owner has already demonstrated that Ground 1 fails at least because the proposed combination of Luo and Craw does not disclose a PPG sensor that captures signals that are processed into a serial data output from which a respiration rate can be extracted, or a serial data output created from the signals obtained by the sensors. *See* Paper 22 (“POR”) at 1-2 and 13-26. Similarly, Patent Owner has already shown that Ground 6 (claim 1), and therefore Ground 7 (claim 3), fail at least because neither Mault nor Al-Ali disclose a single monitoring device capable of sensing physiological information comprising both heart rate and respiration rate, a PPG sensor from which respiration rate can be extracted after processing the PPG sensor’s

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