UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

VALENCELL, INC.
Patent Owner

Case IPR2017-00319
U.S. Patent No. 8,923,941

PETITIONER'S REQUEST FOR REHEARING OF INSTITUTION DECISION

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Petitioner Apple Inc. ("Apple") requests partial rehearing under 37 C.F.R. § 42.71(d)(1) of the Board's Institution Decision (Paper 10) with respect to claim 3 of U.S. Patent No. 8,923,941 ("the '941 Patent"), entered on June 6, 2017.

I. Standard of Review

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

> A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

II. The Board overlooked Petitioner's previously-submitted arguments and material facts showing the prior art still discloses an "application-specific interface (API)" under the Board's revised construction.

While the Board disagreed with Petitioner's proposed claim construction, it does not necessarily follow that Petitioner could not prevail under the Board's revised claim construction. While Petitioner originally proposed a claim construction it believed commensurate with the "broadest reasonable construction," the applied art also satisfies the Board's construction. Indeed, as shown below, Petitioner provided ample support in the Petition for finding claim 3

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unpatentable even under the Board's construction.

While the Board did not provide an actual definition for "application-specific interface (API)" in the Institution Decision (*see* Paper 10, pp. 11-12), the Board did state that, "the Specification explains that the 'application-specific interface (API)' is directed to a 'particular application,' rather than broadly to different applications." Paper 10, p. 12 (emphasis omitted). In declining to institute *inter partes* review of claim 3, the Board overlooked Petitioner's explanation of why the art is also directed to a particular application.

The Petition stated that the referenced data dictionary of Craw "acts as an API." Petition, p. 27. But the Petition also stated that "Craw teaches that a device receiving such a serial output string would have been able to extract the parameters from the serial data string (*e.g.*, for appropriate display of the health information)." *Id.* Here, the Petition cites to Craw, ¶0048, which states, "[a]cting on the received information may ***depend on the goal of the application***." The Petition also cites to Craw, ¶0202, which states, "[t]he dictionary table may be used to ***recognize what to extract by specifying the data segments*** that encompass the structure of any wire line message received by the computer platform."

These statements in Craw indicate that, when implemented, the data dictionary is directed to a particular application. The Petition further supports this, by explaining that "[o]nce the data is received, the parameter values are extracted

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based on the pre-defined protocols and specifications. . . . Once extracted, the data is further processed for display by using the dictionary." Petition, p. 21. So while the data dictionary provides a generic interface when considered in the abstract, when actually ***implemented,*** the data dictionary's use is tailored to the specific application it is intended to complement. And as described in the Petition, the proposed ground was not based on Craw alone or in the abstract; rather, the proposed ground of unpatentability applies Luo in view of Craw. Petition, p. 27. The health monitoring device of Luo is the specific application, and implementing the data dictionary of Craw allows the data for Luo's specific application to be serialized "such that Luo's subject heart rate and subject respiration rate parameters could be extracted from the physiological information and such that a plurality of subject physical activity parameters could be extracted from the motion-related information." Petition, p. 26. That is, when considering Craw's dictionary as incorporated into Luo's health monitoring device, the data dictionary (*i.e.*, the claimed application-specific device (API)) "can utilize" the data as required for a particular application, namely the pre-defined protocols and specifications from the specific health monitoring device of Luo. Petition, pp. 25-27.

For these reasons, the proposed ground as described in the Petition describes how, in implementation, Luo in view of Craw describes an application-specific

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