UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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FITBIT, INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner

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

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PETITIONER'S OPENING BRIEF ON REMAND

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I.   Introduction

This IPR is the last one remaining from a series of IPRs filed by Apple Inc. ("Apple") and joined by Petitioner Fitbit, Inc. ("Fitbit"). In every other IPR, this Board found the claims of Patent Owner Valencell, Inc. ("Valencell") unpatentable, and the Federal Circuit has since affirmed the Board's decisions. Even in this IPR, the Board issued a final written decision finding claims 1-2 and 6-13 of U.S. Patent No. 8,923,941 ("'941 patent") unpatentable. Valencell did not appeal that decision.

Dependent claims 3-5 add little to the subject matter already found obvious and invalid in claim 1. Indeed, Valencell never previously argued these claims were patentable for any reason other than their dependency on claim 1, and the Board concluded that Fitbit's prior art discloses the limitations recited in claim 3 in a separate IPR on claims 14-21 of the '941 patent. In view of the petitioned grounds, the Board should find claims 3-5 invalid.

II.   Technical Background

The '941 patent is directed to processing signals from a PPG sensor and a motion sensor into serial data output containing physiological and motion information. '941 patent at Abstract. This physiological information may include heart rate, and the motion information may include current running speed. *Id.* at 23:49-54, 23:63-66. Claim 1 of the '941 patent, which has already been invalidated, is directed to this core concept. Dependent claims 3-5 recite further

limitations related to the organization and use of the serial data output:

> 3. The method of claim 1, wherein the serial data output is parsed out such that an application-specific interface (API) can utilize the physiological information and motion-related information for an application.

> 4. The method of claim [3], wherein the application is configured to generate statistical relationships between subject physiological parameters and subject physical activity parameters in the physiological information and motion-related information.

> 5. The method of claim 4, wherein the application is configured to generate statistical relationships between subject physiological parameters and subject physical activity parameters via at least one of the following: principal component analysis, multiple linear regression, machine learning, and Bland-Altman plots.

III.   Procedural Background

Apple Inc. ("Apple") challenged claims 1-13 of the '941 patent in its original IPR petition.   Paper 2. The Board instituted this IPR on claims 1-2 and 6-13 after disagreeing with Apple's proposed construction for "application-specific interface (API)" in claim 3 and its attempt to resolve the dependency of claims 4-5. Paper 10. Fitbit later joined the instituted IPR. IPR2017-01555, Paper 9.

After oral arguments were already held for this IPR, the Supreme Court issued its decision in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1358 (2018). In response, the Board added dependent claims 3-5 to the IPR and authorized additional briefing on this subject. Paper 39. Petitioners explained in this briefing

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