

Filed on behalf of Valencell, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,¹
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-00319²
U.S. Patent No. 8,923,941

**PATENT OWNER'S RESPONSE BRIEF TO
PETITIONER'S OPENING BRIEF ON REMAND**

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Patent Trial and Appeal Board
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¹ Petitioner Apple Inc. is no longer a party in this proceeding.

² Case IPR2017-01555 has been joined with this proceeding.

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Pursuant to the Board's September 14 Order, Patent Owner Valencell, Inc. submits this Response Brief to Petitioner Fitbit, Inc.'s Opening Brief on Remand.

I. Apple's Petition Fails to Demonstrate that Claims 3-5 Are Obvious.

The Federal Circuit remanded this proceeding because the Board "did not review the patentability of claim 3, as construed, on the *asserted grounds* of obviousness." *Fitbit, Inc. v. Valencell, Inc.*, 964 F.3d 1112, 1117-18 (Fed. Cir. 2020) (emphasis added). Similarly, with respect to claims 4 and 5, the Federal Circuit remanded for the Board to "determine patentability of corrected claims 4 and 5 on the *asserted grounds* of obviousness." *Id.* at 1120 (emphasis added). Thus, the Board is tasked with evaluating whether Fitbit has met its burden of demonstrating that claims 3-5, properly construed, are obvious based on the arguments made and the evidence cited in Apple's Petition. It has not.

In the Petition, Apple asserted that *Craw* discloses an application-specific interface of claim 3: "*Craw* teaches that a data dictionary used with data classes acts as *an API* for managing, extracting, and displaying information from information streams." Paper 2 at 27 (citing Ex. 1056 ¶ 256) (emphasis added). But neither Apple nor Fitbit demonstrate that *Craw* discloses "an interface which enables *a particular application* to utilize data obtained from hardware, such as the at least one motion sensor and the at least one PPG [photoplethysmography] sensor." *See Fitbit*, 964 F.3d at 1116-17 (emphasis added). As Apple conceded in the Petition, an API has

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