

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner

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

**PETITIONER'S REQUEST FOR
BRIEF ORAL ARGUMENT ON REMAND**

Pursuant to the Board's Order on Conduct of the Proceeding on Remand (Paper No. 57) dated September 14, 2020, Petitioner Fitbit, Inc. ("Petitioner") hereby respectfully requests "a brief oral argument not to exceed twenty (20) minutes per party."

The Board has not set a date for oral argument on remand. Petitioner requests that the Board not schedule the oral arguments for the following dates, when counsel for Petitioner will be unavailable:

- December 1, 2020; and
- December 11, 2020.

Unless the March 13 Order requiring all oral arguments to occur telephonically is still in effect, Petitioner respectfully requests that oral argument take place in person at the Alexandria, VA, USPTO Headquarters. Likewise, should arguments take place in person, Petitioner also respectfully requests that both a projector with a laptop connector and an Elmo be available for use at oral argument to display possible demonstratives and/or exhibits.

Petitioner requests **twenty (20) minutes per side** for oral argument in IPR2017-00319.

The issues to be argued include:

1. The patentability of dependent claims 3-5 of U.S. Patent No. 8,923,941 on the grounds presented in the IPR petition, namely:

- Whether claim 3 is obvious in light of Luo and Crow;
 - Whether claims 4-5 are obvious in light of Luo, Crow, and Wolf; and
 - Whether claim 3 is obvious in light of Mault, Al-Ali, and Lee;
2. Whether the Board’s construction of the term “application-specific interface (API)” has no significance, where the claimed “application-specific interface” performs the same function as an application programming interface, i.e., “enabl[ing] a particular application to utilize data obtained from hardware”;
 3. The patentability of claims 4 and 5, assuming their dependence from claim 3, as rendered obvious over the combined teachings of Lou, Crow, and Wolf;
 4. Any other issues Patent Owner raised in their Responsive Brief on Remand or any Sur-Reply Brief on Remand (to the extent Patent Owner is authorized to file such a brief); and
 5. Any other issues that the Board deems necessary for issuing a final written decision.

Date: November 16, 2020

By: /Jim Glass/
James M. Glass (Reg. No. 46,729)
QUINN EMANUEL URQUHART &
SULLIVAN LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
Email: jimglass@quinnemanuel.com
Phone: 212-849-7219
Fax: 212-849-7100

Counsel for Petitioner Fitbit, Inc.

CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(E), 42.105(A))

The undersigned hereby certifies that the foregoing document was served in its entirety on November 16, 2020 upon the following parties via Electronic Mail.

Justin B. Kimble
Jeffrey R. Bragalone
Daniel F. Olejko
T. William Kennedy
Jonathan H. Rastegar
Marcus Benavides
R. Scott Rhoades
Sanford E. Warren, Jr

BRAGALONE CONROY PC

2200 Ross Ave.

Suite 4500 – West

Dallas, TX 75201

JKimble-IPR@bcpc-law.com

jbragalone@bcpc-law.com

dolejko@bcpc-law.com

bkennedy@bcpc-law.com

jrastegar@bcpc-law.com

mbenavides@bcpc-law.com

srhoades@wriplaw.com

swarren@wriplaw.com

Date: November 16, 2020

By: /Jim Glass/

James M. Glass (Reg. No. 46,729)
QUINN EMANUEL URQUHART &
SULLIVAN LLP

51 Madison Avenue, 22nd Floor

New York, NY 10010

Email: jimglass@quinnemanuel.com

Phone: 212-849-7142

Fax: 212-849-7100

Counsel for Petitioner Fitbit, Inc.