

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 IN OPPOSITION TO PETITIONER'S
REQUEST FOR ORAL ARGUMENT ON REMAND**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

¹ Petitioner Apple Inc. (“Apple”) is no longer a party in this proceeding.

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

Patent Owner Valencell, Inc. submits this Response in Opposition to Petitioner's Request for Oral Argument on Remand and to address the Board's November 17 email.

Patent Owner opposes Petitioner's request for oral argument because this case does not present circumstances that justify additional oral argument on remand. The Board's Standard Operating Procedures ("SOP") state that "[i]n most cases, an additional oral hearing will not be authorized" because "the existing record and previous oral argument will be sufficient." SOP 9, App'x 2, at 7. The panel may authorize additional oral argument "in those situations where new evidence is permitted." *Id.* Further, oral argument may be warranted "if necessary to afford due process" where the Federal Circuit's remand is based on a lack of due process or denial of Administrative Procedure Act ("APA") rights. *Id.* at 8. Neither of these circumstances is present.

The Board denied Petitioner's request to submit new evidence on remand. Paper 57 at 7-8. Further, the Federal Circuit's remand is not based on a denial of Petitioner's due process or APA rights. Indeed, Petitioner did not request oral argument on claims 3-5 in the original proceeding, and Petitioner did not argue on appeal that the Board's failure to hold an additional oral argument regarding claims 3-5 in the original proceeding deprived Petitioner of its due process or APA rights. Rather, the Federal Circuit remanded this case because (1) the Board did not

adequately explain why Apple’s Petition failed to demonstrate that claim 3 is unpatentable under the proper construction of “application-specific interface (API)” and (2) the Board did not consider whether Apple’s Petition demonstrated that corrected claims 4-5 are unpatentable. *See Fitbit Inc. v. Valencell, Inc.*, 964 F.3d 1112, 1118-20 (Fed. Cir. 2020). In these circumstances, oral argument is not necessary. SOP 9, App’x 2, at 8 (oral argument is not necessary where the Board failed to consider evidence or provided an inadequate explanation).

While the Board suggested in its September 14 Order that it may be appropriate to hear directly from Petitioner and that oral argument may assist the Board in resolving the remanded issues, Petitioner does not explain why oral argument is necessary. As noted, the Board properly denied Petitioner’s request to submit new evidence on remand, and Petitioner never argued on appeal that an additional hearing on claims 3-5 would be necessary to preserve Petitioner’s due process and APA rights. In addition, Petitioner does not explain why the parties’ briefing fails to sufficiently apprise the Board of the issues on remand. Notably, the Federal Circuit’s remand is directed to whether *Apple’s Petition* sufficiently demonstrates that claims 3-5 are obvious—not whether *Fitbit’s new arguments* on remand might demonstrate obviousness of the claims.

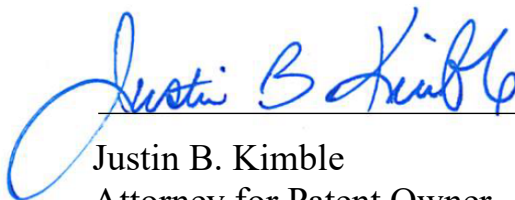
Petitioner suggests that oral argument is necessary to provide Petitioner with an opportunity to respond to “new issues” that might be raised in Patent Owner’s

surreply. But Patent Owner recognizes that any surreply should be strictly limited to responding to arguments raised by Petitioner in its reply brief and that its surreply cannot raise new issues.

Nevertheless, in the event that the Board determines that oral argument is necessary, Patent Owner respectfully requests that the Board grant Patent Owner's request for a surreply, which would be unopposed by Petitioner. Further, Patent Owner requests that the Board limit the hearing to no more than 10 minutes per side, which should be sufficient time for the parties to argue their positions and respond to any questions from the Board. Though Petitioner failed to meet and confer with Patent Owner concerning the proposed dates for oral argument or its request that the hearing be conducted in person, Patent Owner is available on December 11, 2020 for a telephonic hearing. In light of travel difficulties due to the current pandemic, Patent Owner opposes Petitioner's request for an in-person hearing.

Dated: November 17, 2020

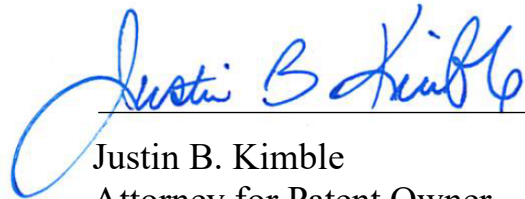
Respectfully submitted,



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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this document was served via electronic mail on November 17, 2020, to Petitioner via counsel, James M. Glass, Sam Stake, and Ogi Zivojnovic at the email addresses: jimglass@quinnemanuel.com, samstake@quinnemanuel.com, ogizivojnovic@quinnemanuel.com, pursuant to Petitioner's consent in its Updated Mandatory Notices at page 2.



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