

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.
Petitioner

v.

VALENCELL, INC.
Patent Owner

Case IPR2017-00319¹
Patent 8,923,941 B2

Before BRIAN J. McNAMARA, JAMES B. ARPIN, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

ORDER
Granting Hearing and Sur-Reply
37 C.F.R. §§ 42.23 and 42.70

¹ Case IPR2017-01555 has been joined with this proceeding.

I. HEARING AND ATTENDANCE

Fitbit, Inc. (“Petitioner”) requests a hearing for the above-captioned proceeding, pursuant to 37 C.F.R. § 42.70. Paper 66. Valencell, Inc. (“Patent Owner”) opposes Petitioner’s request. Paper 67. After reviewing Petitioner’s request and Patent Owner’s opposition, the panel *grants* a hearing in this proceeding. *See* Paper 57, 8–9, 11.

The hearing shall occur on Friday, December 11, 2020, at 11:00am ET/10:00am CT/9:00am MT/8:00am PT, by telephone. In our Order regarding the conduct of this proceeding on Remand, we authorized Petitioner to file a request for a brief oral argument not to exceed twenty (20) minutes per party. Paper 57, 11. Petitioner requested a brief oral argument of twenty (20) minutes per party. Paper 66, 2. In Patent Owner’s opposition to Petitioner’s request, Patent Owner proposed that if a hearing is granted, oral argument should be limited to ten (10) minutes per party. Paper 67, 3. **Given that a hearing previously occurred in this proceeding and in view of the limited scope of this remand, each party shall have fifteen (15) minutes to present its arguments and to respond to the panel’s questions, limited to the briefed issues in this remand.** Paper 57, 10–11; *see* Paper 66, 2–3. The parties are directed to contact the Board at least ten (10) days in advance of the hearing if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the hearing, and the reporter’s transcript will constitute the official record of the hearing.

Unless such information is previously received, each party must contact PTAB Hearings at PTABHearingsTrials@uspto.gov no later than five (5) business days prior to the hearing date to receive dial-in connection

information. If at any time during the hearing, either party encounters technical or other difficulties that fundamentally undermine your ability to adequately represent that party, the party should let the panel or PTAB Trials know immediately, so that adjustments may be made.²

As noted above, each side will have fifteen (15) minutes total time to present arguments. Petitioner bears the ultimate burden of proof that the claims remaining at issue in this proceeding are unpatentable. Petitioner will open the hearing by presenting its case regarding the remaining challenged claims, upon which the Board instituted trial and which the Federal Circuit remanded for further review. Paper 57, 10–11; *see* Paper 66, 2–3. Patent Owner then will respond to Petitioner’s arguments. Next, Petitioner may use any time it has reserved for rebuttal to respond to Patent Owner’s arguments. Lastly, Patent Owner may use any time it has reserved for sur-rebuttal to respond to Petitioner’s arguments. No other arguments will be heard.

Per the Office Patent Trial Practice Guide, either party may request a pre-hearing conference. *See* Consolidated Trial Practice Guide (“Trial Practice Guide”), 84 Fed. Reg. 64,280 (Nov. 21, 2019).³ To request such a conference, after conferring, a joint email should be sent to Trials@uspto.gov including alternative dates and times of availability for both parties, as appropriate, that are generally no later than three (3) business days prior to the hearing date. Please refer to the Guide for more information on the pre-hearing conference.

² For example, if a party is experiencing poor audio quality, the Board may provide alternate dial-in information.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

II. DEMONSTRATIVES

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least seven (7) business days before the hearing. However, in view of the deadline for filing Patent Owner’s sur-reply, discussed below, demonstrative exhibits shall be served at least five (5) business days before the hearing. Thus, the parties shall serve on opposing counsel demonstrative exhibits no later than Friday, December 4, 2020. Notwithstanding 37 C.F.R. § 42.70(b), demonstratives should be filed as an exhibit, and contemporaneously emailed to PTABHearingsTrials@uspto.gov, no later than Monday, December 7, 2020, to facilitate the panel’s preparation. The parties should consider the information regarding demonstrative materials discussed in the Trial Practice Guide.

Demonstrative exhibits used at the hearing are aids to oral argument and not evidence, and should be clearly marked as such. For example, each slide of a demonstrative exhibit may be marked with the words “DEMONSTRATIVE EXHIBIT – NOT EVIDENCE” in the footer. Demonstrative exhibits cannot be used to advance arguments or introduce evidence not previously presented in the record. *See Dell Inc. v. Accelaron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (noting that the “Board was obligated to dismiss [the petitioner’s] untimely argument . . . raised for the first time during oral argument”).

The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), regarding the appropriate content of demonstrative exhibits. The Board expects that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits, but

if such objections cannot be resolved the parties may file any objections to demonstratives with the Board *at least two (2) business days* before the hearing. The objections should identify with particularity which portions of the demonstrative exhibits are subject to objection, include a copy of the objected-to portions, and include a one-sentence statement of the reason for each objection. **No argument or further explanation is permitted.** The panel will consider any objections and schedule a conference call if deemed necessary. Otherwise, the panel will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

The Board generally expects lead counsel for each party to be present by telephone at the hearing. Any counsel of record may present the party's argument as long as that counsel is present by telephone.

Any special requests for hearing equipment should be directed to PTABHearings@uspto.gov. A party may also indicate any special requests related to appearing at a telephonic hearing, such as a request to accommodate hearing impairments, and indicate how the Board may accommodate the special request. Any special requests must be presented in a separate communication not less than five (5) business days before the hearing, i.e., by December 4, 2020.

Each party shall unmute itself only when speaking. During the hearing, the parties should identify clearly and specifically each paper, exhibit, and/or demonstrative referenced (e.g., by paper number and/or page, slide, or screen number) to ensure the clarity and accuracy of the court reporter's transcript. The panel will have access to all papers and exhibits filed with the Board, including demonstratives. In addition, for clarity of the

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