

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., and FITBIT, INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner

Case IPR2017-00321¹
U.S. Patent No. 8,923,941

**PETITIONER APPLE INC.'S SURREPLY TO
PATENT OWNER'S CONDITIONAL MOTION TO AMEND**

Mail Stop "Patent Board"

Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

¹ 1 Case IPR2017-01556 has been joined with this proceeding.

TABLE OF CONTENTS

I. Introduction.....1

II. Valencell Failed To Respond To The Grounds Of Unpatentability.....1

III. Addressing Claim Features Individually Was Not Sufficient To Establish
Written Description Support For The Substitute Claims2

IV. Substitute Claims 22 And 26 Are Unpatentable4

V. Conclusion6

I. Introduction

In its Reply to Petitioner’s Opposition to Motion to Amend, Valencell (“PO”) does not dispute that it did not address the instituted grounds—instead arguing that *narrowing* the claims in any way should meet the rules. PO also does not dispute that it merely provided a string cite to purportedly illustrate support for the substitute claims—instead erroneously contending that it nonetheless *individually* addressed all limitations. As discussed in detail below, PO’s arguments are misplaced and, accordingly, PO’s MTA should be denied.

II. Valencell Failed To Respond To The Instituted Grounds

PO does not deny that it never substantively addressed the instituted grounds based on Kosuda or Aceti. PO instead asserts that § 42.121(a)(2) only requires that the substitute claims narrow the original claims in some manner. *See* Reply, p. 12 (relying on the Board’s decision in *Idle Free*). But PO’s reliance on *Idle Free* is misplaced. The *Idle Free* decision merely noted that a proposed substitute claim that does *not* include or narrow each feature of the challenged claim being replaced is *not* responsive. *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Decision on Motion to Amend Claims, Paper 26 (June 11, 2013) (informative). That does not mean that any narrowing—even one that makes no difference with respect to the instituted grounds—satisfies § 42.121(a)(2). *See Blackberry Corp. v. MobileMedia Ideas LLC*, IPR2013-00016, Paper 32 at pp. 15-18 (Feb. 25, 2014).

Aside from narrowing the claims, PO was required to include “a *detailed explanation* of the *significance* of the amended claims (e.g., a statement that clearly points out the patentably distinct features for the proposed new or amended claims).” *Aqua Prod., Inc. v. Matal*, 872 F.3d 1290, 1341 (Fed. Cir. 2017) (en banc) (Reyna concurring) (quoting 77 Fed. Reg. at 48,626). That is, PO needed to show why the alleged narrowing overcomes the instituted ground. Yet PO’s MTA only contains a token statement that the prior art does not disclose the added limitations. Paper 24, p. 12. This is not sufficient.

III. Addressing Claim Features Individually Was Not Sufficient To Establish Written Description Support For The Substitute Claims

Patent Owner contends that it met its burden of identifying written description support under § 42.121(b) by listing citations to the specification for each individual claim limitation. Yet the Board has instructed that “the motion should account for the claimed subject matter as a whole, i.e., the *entire* proposed substitute claim, when showing where there is sufficient written description support for each claim feature.” *Facebook, Inc. v. B.E. Tech., LLC.*, No. IPR2014-00052, Paper 45, p. 27, (Mar. 31, 2015); *aff’d*, *B.E. Tech., L.L.C. v. Google, Inc.*, No. 2015-1827, 2016 WL 6803057, at *7 (Fed. Cir. Nov. 17, 2016), *citing* *Respironics, Inc. v. Zoll Med. Corp.*, No. IPR2013-00322, 2014 WL 4715644, at *13 (P.T.A.B. Sept. 17, 2014) (“Zoll’s string citations amount to little more than an invitation to us (and to Respironics, and to the public) to peruse the cited evidence and piece together a

coherent argument for them. This we will not do.”), *vacated and remanded on other grounds*, No. 2015-1485, 2016 WL 4056094, at *1 (Fed. Cir. July 29, 2016). PO has not shown where each substitute claim as a whole is supported by the original written description, and its string citations offer no guidance to the same.

PO also argues that the Board previously allowed a patent owner to support a motion to amend using a string citation in *Int’l Flavors & Fragrances Inc. v. United States*, No. IPR2013–00124, 2014 WL 2120542 (May 20, 2014). But as discussed by the Federal Circuit, *Int’l Flavors* “is not controlling, and other Board decisions have found that such a bare string citation is insufficient to establish written description support.” *B.E. Tech., L.L.C. v. Google, Inc.*, No. 2015-1827, 2016 WL 6803057, at *7 (Fed. Cir. Nov. 17, 2016). The problem with PO’s list of citations is that the citations point to excerpts from more than forty pages of disclosure describing many different embodiments having disparate features. *See* Paper 24, pp. 4-7 (encompassing descriptions of at least FIGs. 1, 5, 13, 15, 17, 18, and 20). Without explanation, there is no way to *readily discern* that the original specification provides support for the substitute claims. *See Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998); *see also Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (“It is not sufficient ... that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.”).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.