

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 REQUEST FOR ORAL ARGUMENT

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

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

Pursuant to 37 C.F.R. § 42.70 and the Board's November 28, 2017 Amended Scheduling Order (Paper 29), Petitioner Apple Inc. respectfully requests oral argument, which is currently scheduled for February 27, 2018.

The IPR2017-00321² (U.S. Patent No. 8,923,941) proceeding is one of five proceedings—including IPR2017-00315³ (U.S. Patent No. 8,929,965), IPR2017-00317⁴ (U.S. Patent No. 8,989,830), IPR2017-00318⁵ (U.S. Patent No. 8,886,269), and IPR2017-00319⁶ (U.S. Patent No. 8,923,941)—between Petitioner and Patent Owner that are scheduled for oral argument on the same day and before the same panel, Judges Brian J. McNamara, James B. Arpin, and Sheila F. McShane.

Petitioner believes judicial economy would be served by the Board conducting three separate oral hearings for the five *Inter Partes* Review proceedings as outlined below. While all five proceedings involve a family of related patents, only certain proceedings share arguments, asserted prior art, declarants, and other evidence. Specifically, the -00317 and -00318 proceedings

² IPR2017-01556 has been joined with this proceeding.

³ IPR2017-01552 has been joined with this proceeding.

⁴ IPR2017-01553 has been joined with this proceeding.

⁵ IPR2017-01554 has been joined with this proceeding.

⁶ IPR2017-01555 has been joined with this proceeding.

share many prior art references and issues for the instituted grounds. The -00319 and -00321 proceedings also share some prior art and issues, particularly with respect to Patent Owner's Contingent Motion to Amend in the -00321 case and instituted grounds of the -00319 case.

Accordingly, Petitioner respectfully requests that the Board schedule oral hearings across IPR2017-00315 (U.S. Patent No. 8,929,965), IPR2017-00317 (U.S. Patent No. 8,989,830), IPR2017-00318 (U.S. Patent No. 8,886,269), and IPR2017-00319 and IPR2017-00321 (U.S. Patent No. 8,923,941) as follows:

- Argument of the proceedings in order:
 1. IPR2017-00315 (9 AM to 9:50 AM)
 2. IPR2017-00317 and IPR2017-00318 (10 AM to 11:30 AM)

Break for lunch
 3. IPR2017-00319 and IPR2017-00321 (1 PM to 2:30 PM)
- 20 minutes (total) per side for the oral argument per proceeding—to address the instituted grounds and the contingent Motion to Amend (if applicable)—with Petitioner presenting first, Patent Owner responding, and Petitioner rebutting, with approximately a 5-minute break between each side's presentation (e.g., to set up projector for presentation);

- A single oral hearing transcript for each of the shared arguments (3 transcripts);
- The parties may assign different attorneys to argue different cases and different issues during the allotted time; and
- The argument take place in Conference Room A, as assigned, due to the expected number of attendees (e.g., Petitioner expects to bring 6-7 attendees).

Petitioner specifies the following issues to be argued:

1. [IPR2017-00315]: Whether Claims 1-12 of U.S. Patent No. 8,929,965 ('965 Patent) are unpatentable under 35 U.S.C. § 103(a) and 35 U.S.C. § 102(b) over the applied references (alone or in combination as instituted) *Numaga, Vetter, Dekker, Debreczeny, Rafert, Negley, Miao, Fraden, Verjus, and Fricke*;
2. [IPR2017-00317]: Whether Claims 1-6, 8-16, and 18-20 of U.S. Patent No. 8,989,830 ('830 Patent) are unpatentable under 35 U.S.C. § 103(a) over the applied combinations of *Goodman, Hicks, Hannula, Asada, and Delonzor*;
3. [IPR2017-00318]: Whether Claims 1–10 of U.S. Patent No. 8,886,269 ('269 Patent) are unpatentable under 35 U.S.C. § 103(a) over the

applied combinations of *Asada, Hicks, Hannula, Delonzor, Al-Ali, and Goodman*;

4. [IPR2017-00319]: Whether Claims 1, 2, and 6-13 of U.S. Patent No. 8,923,941 ('941 Patent) are unpatentable under 35 U.S.C. § 103(a) over the applied combinations of *Luo, Craw, Fricke, Comtois, Aceti, Mault, Al-Ali, Han, Numaga, and Ali*;
5. [IPR2017-00321]: Whether Claims 14-21 of the '941 Patent are unpatentable under 35 U.S.C. § 103(a) over the applied combinations of *Kosuda, Maekawa, Han, Aceti, Fricke, and Comtois*;
6. Any issues relating to Patent Owner's Contingent Motion to Amend, as applicable, for the respective proceedings;
7. Any issues relating to Motions to Exclude, as applicable, for the respective proceedings;
8. Any other outstanding motions, pleadings, and other issues that the Board deems necessary for issuing a Final Written Decision.

Petitioner also requests the ability to use audio visual equipment to display possible demonstratives and exhibits, including the use of a computer, projector, and screen.

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