

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-00315 Patent 8,929,965 B2
Case IPR2017-00319 Patent 8,923,941 B2
Case IPR2017-00321 Patent 8,923,941 B2¹

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

ARPIN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties are not authorized to use a multiple case caption.

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DISCUSSION

On April 3, 2017, Apple Inc. (“Petitioner”) contacted the Board by e-mail requesting a conference call to discuss (1) several alleged misrepresentations of fact contained in Valencell, Inc.’s (“Patent Owner’s”) Preliminary Responses filed in the above-captioned cases and (2) statements allegedly inconsistent with other statements appearing in certain of those Preliminary Responses. Specifically, Petitioner requested authorization, pursuant to 37 C.F.R. § 42.108(c), to file a Reply to Patent Owner’s Preliminary Responses. Petitioner stated that it had conferred with Patent Owner and that Patent Owner opposed Petitioner’s request.

On April 5, 2017, the parties and the panel participated in a conference call to discuss Petitioner’s request. Petitioner has filed a transcript of that conference call in each of the above-captioned cases. IPR2017-00315, Ex. 1067; IPR2017-00319, Ex. 1067; IPR2017-00321, Ex. 1067. During the conference call, Petitioner explained that “there are seven total misstatements. Some of those are inconsistent statements, but the others are misrepresentations of fact.” *E.g.*, IPR2017-00315, Ex. 1067, 24:14–17.² Further, Petitioner explained that the sole misstatement alleged in IPR2017-00315 involved the imprecise identification of images associated with the Numega reference (IPR2017-00315, Ex. 1009). *See* IPR2017-00315, Ex. 1067, 25:14–19, 26:13–17. The remaining alleged misstatements involve IPR2017-00319 and IPR2017-00321. *See* IPR2017-00315, Ex. 1067, 24:14–25:6.

² Because the transcripts filed in the above-captioned cases are identical, we cite only to the transcript (Ex. 1067) filed in IPR2017-00315.

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1. *IPR2017-00315*

With respect to IPR2017-00315, Petitioner identifies only a single, alleged misstatement, namely, that Patent Owner states incorrectly that certain images, which do not appear in the Numega reference, are images from that reference. *See* IPR2017-00315, Ex. 1067, 25:14–19, 26:13–17. As we indicated during the conference call, the panel can determine whether or not images are part of a reference that has been filed as an exhibit in a proceeding. *See id.* at 26:3–27:1. Therefore, with respect to the sole alleged misstatement in IPR2017-00315, we do not authorize any submission.

2. *IPR2017-00319 and IPR2017-00321*

With respect to IPR2017-00319 and IPR2017-00321, there are a total of six remaining, allegedly inconsistent statements and alleged misrepresentations of fact. *See id.* at 24:14–17. As we indicated during the conference call, Petitioner may bring these to the attention of the panel adequately by the submission of a listing of the allegedly inconsistent statements and alleged misrepresentations of fact. *See id.* at 25:7–13; *see also Activision Blizzard, Inc. v. Acceleration Bay, LLC*, Case IPR2015-01951, slip op. at 2 (PTAB October 25, 2016) (Paper 60) (authorizing Patent Owner to file a list identifying arguments believed to go beyond the scope of a proper Reply). In particular, Petitioner may (1) provide a simple listing of citations (i.e., page and line numbers) to the alleged misstatements of fact from each Preliminary Response and (2) identify allegedly inconsistent statements by providing a two column table listing citations (i.e., page and line numbers) to the statements from the Preliminary Response in IPR2017-00319 in one column and citations to the corresponding, allegedly

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inconsistent statements from the Preliminary Response in IPR2017-00321 in the adjacent column. No argument is to be included in the contents of the submission.

Petitioner also requests that, with respect to the alleged misstatements of fact, we authorize Petitioner (1) to provide citations to the existing record or (2) to file new exhibits *correctly* identifying the technology in dispute. *Id.* at 13:3–14:1, 31:15–22. We *deny* this request. To the extent that Petitioner already has submitted exhibits identifying the technology in dispute, no further citations are necessary. To the extent that Petitioner seeks to submit new exhibits identifying technology not previously argued in its Petition, no further exhibits supplementing the arguments or evidence presented in the Petition are authorized.

ORDER

It is:

ORDERED that Petitioner is authorized to file on or by April 14, 2017, submissions listing the alleged inconsistent statements and alleged misrepresentations of fact in IPR2017-00319 and IPR2017-00321, in the manner described above;

FURTHER ORDERED that Petitioner is not authorized to file any submission containing a listing of the alleged misrepresentation of fact in IPR2017-00315;

FURTHER ORDERED that submission of arguments, explanation, additional supporting evidence, citations to evidence of record, and any other statements beyond the above-described listings is not authorized; and

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FURTHER ORDERED that the authorized submissions shall not exceed two pages and shall be filed in IPR2017-00319 and IPR2017-00321.

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