

Filed on Behalf of Valencell, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

VALENCELL, INC.

Patent Owner

Case IPR2017-00321

U.S. Patent No. 8,923,941

**PATENT OWNER'S CONDITIONAL
MOTION TO AMEND UNDER 37 C.F.R. § 42.121**

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TABLE OF EXHIBITS

Exhibit No.	Description
2108	U.S. Patent Application No. 12/691,388, now U.S. Patent No. 8,700,111, original specification, claims, and figures.
2109	Provisional Application No. 61/274,191, filed on August 14, 2009, original specification, claims, and figures.
2115	U.S. Patent No. 8,923,941 to LeBoeuf et al., issued December 30, 2014
2116	U.S. Patent Application No. 14/184,396, now U.S. Patent No. 8,923,941, original specification, claims, and figures.
2126	U.S. Patent Application Publication No. 2008/0200774 to Luo, published August 21, 2008
2127	U.S. Patent Application Publication No. 2008/0133699 to Craw et al., published June 5, 2008
2136	U.S. Patent No. 6,513,532 to Mault <i>et al.</i> , issued February 4, 2003
2137	U.S. Patent Application Publication No. 2003/0181798 to Al-Ali, published September 25, 2003
2138	R.G. Lee <i>et al.</i> "A Mobile Care System With Alert Mechanism" IEEE Transactions on Information Technology in Biomedicine, Vol. 11, Issue 5, September 2007

I. STATEMENT OF RELIEF REQUESTED

Patent Owner, Valencell, Inc. (“Valencell” or “Patent Owner”), moves under 37 C.F.R. § 42.12, to amend the claims of U.S. Patent No. 8,923,941 (the “941 Patent”) (Ex. 2115) contingent on the outcome of the trial. If original claims 14-21 are found unpatentable, the Patent Trial and Appeal Board (“the Board”) is requested to cancel claims 14-21 and replace them with proposed substitute claims 22-29. *See* 37 C.F.R. § 42.22(a)(2); 35 U.S.C. § 316(d). The proposed substitute claims do not broaden the scope of the claims, and the disclosure supports each proposed amendment. 37 C.F.R. § 42.121. Moreover, Substitute Claim 22, which is proposed to replace original Independent Claim 14, incorporates specific limitations that distinguish the substitute claim over the prior art. Similarly, Substitute Claim 26, which is proposed to replace Dependent claim 18, also incorporates specific limitations. Substitute claims 23-25 and 27-29, which are proposed to replace Dependent Claims 15-17 and 19-21, merely change dependency from original Claim 14 to Substitute Claim 22, and correct for antecedent basis. Patent Owner’s proposed amendments are responsive to a ground of unpatentability because trial was instituted on claims 14–21, and the proposed amendments are to claims 14 and 18 with changes to dependency for claims 15-17 and 19-21. *See* 37 C.F.R. § 42.121(a)(2)(i).

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