

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. and FITBIT, INC.

Petitioners

v.

VALENCELL, INC.

Patent Owner

Case IPR2017-00321¹

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

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

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Alexandria, Virginia 22313-1450

¹ IPR2017-01556 has been joined to this current proceeding.

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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. INTRODUCTION

Petitioners Apple, Inc. (“Apple”) and FitBit, Inc. (“FitBit”) (collectively, “Petitioners”) have chosen to ignore the claim construction of the Patent Trial and Appeal Board (“the Board”) in their opposition to Patent Owner’s, Valencell, Inc. (“Valencell” or “Patent Owner”) Conditional Motion to Amend. Instead, the Petitioners developed their own construction and applied that construction to the prior art. Petitioners make no attempt and do not apply the Board’s construction for the claim term “application-specific interface (API)” in its opposition; instead Petitioners repeatedly disregarded or attempted to modify the construction set forth by the Board. Accordingly the references asserted in Petitioners’ opposition fail to anticipate or render the substitute claims obvious. *See Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1350-51 (Fed. Cir. 2016).

II. PETITIONERS DESPERATE ATTEMPT TO CHANGE THE CLAIM CONSTRUCTION FOR APPLICATION-SPECIFIC INTERFACE (API).

Petitioners set forth a variety of arguments in their desperate attempt to change the construction for the claim term “application-specific interface (API).” Specifically, Petitioners set forth **EACH** of the following arguments:

1. “PO did not present any specific construction for the term “application-specific interface (API).” *See* Petitioner’s Opposition (“Opp.”) at pgs. 2-3. Patent Owner discussed the Board’s construction of this term for the ‘941 patent at length in the Motion to Amend (*see* pgs. 7-10). As the Board has already construed this

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