

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.
Petitioner

v.

VALENCELL, INC.
Patent Owner

Patent No. 8,989,830
Issued: March 24, 2015
Filed: September 12, 2014
Title: Wearable Light-Guiding
Devices for Physiological Monitoring

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c),
37 C.F.R. § 42.122(b) TO RELATED
INTER PARTES REVIEW IPR2017-00317**

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OTHER AUTHORITIES

37 C.F.R. § 42.537

37 C.F.R. § 42.122(b)3, 4

I. Statement of Precise Relief Requested

Fitbit, Inc. (“Petitioner”) respectfully submits this Motion for Joinder together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,989,830 (“Fitbit Petition”) filed contemporaneously herewith. The Board instituted *inter partes* review of claims 1–6, 8–16, and 18–20 of the ’830 Patent in *Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00317 on June 5, 2017 (“Apple IPR”). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Fitbit requests institution of *inter partes* review for claims 1–6, 8–16, and 18–20 of the ’830 Patent and requests joinder with IPR2017-00317.

Fitbit’s request for joinder is timely because it is made no later than one month after the June 5, 2017 institution date of the Apple IPR. The Fitbit Petition is substantively identical to the petition in the Apple IPR, and Fitbit only seeks institution on the same claims, prior art, and grounds for unpatentability that were instituted in the Apple IPR. Therefore, the Fitbit Petition warrants institution for at least the same reasons that the Board instituted the Apple IPR. In addition, Fitbit proposes to streamline discovery and briefing by taking an “understudy role.” Fitbit submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Apple IPR while efficiently resolving the question of the ’830 Patent’s validity in a single proceeding.

II. Statement of Material Facts and Related Proceedings

1. On January 4, 2016, Valencell, Inc. (“Patent Owner”) filed a civil action alleging that Apple Inc. infringes the ’830 Patent, U.S. Patent No. 8,886,269, and two other patents. *Valencell, Inc. v. Apple Inc.*, Case No. 5:16-cv-00001 (E.D.N.C.).

2. Apple filed a petition for *inter partes* review of the ’830 Patent (“Apple Petition”) on November 23, 2016. *Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00317 (Paper 2).

3. On June 5, 2017, the Board instituted a trial on all challenged claims (claims 1–6, 8–16, and 18–20) of the Apple Petition. *See* Case No. IPR2017-00317 (Paper 7).

4. Apple filed a second petition for *inter partes* review of the ’830 Patent, which was denied institution on June 5, 2017. *Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00316 (Paper 7).

5. The ’830 Patent is a continuation of the ’269 Patent.

6. Apple filed a petition for *inter partes* review of the ’269 Patent on November 23, 2016. *Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00318.

7. On June 5, 2017, the Board instituted a trial on all challenged claims of the ’269 Patent. Case No. IPR2017-00318 (Paper 7).

8. On January 4, 2016, Valencell filed a separate civil action in the same

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