

Filed on behalf of Valencell, Inc.

By: Justin B. Kimble (JKimble-IPR@bcpc-law.com)
Nicholas C. Kliever (nkliwer@bcpc-law.com)
Jonathan H. Rastegar (jrastegar@bcpc-law.com)
Bragalone Conroy PC
2200 Ross Ave.
Suite 4500 – West
Dallas, TX 75201
Tel: 214.785.6670
Fax: 214.786.6680

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-01554
U.S. Patent No. 8,886,269

**PATENT OWNER PRELIMINARY RESPONSE PURSUANT TO
35 U.S.C. § 313 and 37 C.F.R. § 42.107**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	S. LeBoeuf, et al., Earbud-Based Sensor for the Assessment of Energy Expenditure, HR, and VO2max, OFFICIAL J. AM. C. SPORTS M., 2014, 1046–1052
2002	Biometrics Lab: Performance of Leading Optical Heart Rate Monitors During Interval Exercise Conditions
2003	Valencell website (http://valencell.com/customers/)
2004	CTA - It Is Innovation (i3) Magazine 2016 Innovation-Entrepreneur Awards

I. INTRODUCTION

Patent Owner Valencell Inc. (“Valencell” or “Patent Owner”) respectfully submits this Preliminary Response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, responding to the Petition for *Inter Partes* Review (the “Petition”) (Paper 2) of U.S. Patent No. 8,886,269 (the “’269 Patent”) (Ex. 1001) filed by Fitbit, Inc. (“Fitbit” or “Petitioner”). Valencell requests that the Board deny institution of *inter partes* review for several reasons summarized below.

While it is not required to file a Preliminary Response (37 C.F.R. § 42.107(a)), Valencell takes this limited opportunity to point out certain substantive and procedural reasons the Board should not institute trial. For purposes of this Preliminary Response, Patent Owner has limited its identification of deficiencies in the Petition and does not intend to waive any arguments not addressed in this Preliminary Response. Valencell submits this Preliminary Response subject and without prejudice to its opposition to Petitioner’s Motion for Joinder (Paper 7).

A. Summary of Patent Owner Valencell’s Argument

Petitioner fails to demonstrate that there is a reasonable likelihood of proving the unpatentability of any challenged claim. **First**, Petitioner fails to show sufficient rationales to combine or modify the prior art references, picks and chooses elements from disparate embodiments, and does not undertake a proper analysis of the *Graham* factors – indicating the failure to treat the claims as a whole and use of

impermissible hindsight analysis to purportedly arrive at what the claimed invention is. ***Second***, Petitioner fails to show that elements are disclosed by the prior art. ***Third***, Petitioner proposes redundant grounds for the unpatentability of claims 3-4 and 8-10.

B. Background

Valencell was founded in 2006 by three Ph.D. electrical engineers with more than 50 years of combined experience in research and development. Since its founding, Valencell has steadily grown to roughly 30 employees and has become a leading innovator in biometric wearables. Valencell's technology is used to power the most accurate wearable biometric heart rate sensors on the market. For example, when benchmarked against a chest strap, Valencell's sensors were far more accurate than the leading industry competitors' products:

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