

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. 8,923,941

Issued: December 30, 2014

Filed: February 19, 2014

Title: Methods and Apparatus for Generating Data Output
Containing Physiological and Motion-Related Information

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c),
37 C.F.R. § 42.122(b) TO RELATED
INTER PARTES REVIEW IPR2017-00319**

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35 U.S.C. § 315(c)1, 3

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. 8,923,941 (“Fitbit Petition”) filed contemporaneously herewith. The Board instituted *inter partes* review of claims 1, 2, and 6–13 of the ’941 Patent in *Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00319 on June 6, 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, 2, and 6–13 of the ’941 Patent and requests joinder with IPR2017-00319.

Fitbit’s request for joinder is timely because it is made no later than one month after the June 6, 2017 institution date of the Apple IPR. The Fitbit Petition is substantively identical to the Apple Petition, 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 determining the validity of claims 1, 2, and 6–13 of the ’941 Patent 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 ’941 Patent, as well as three other patents. *Valencell, Inc. v. Apple Inc.*, Case No. 5:16-cv-00001 (E.D.N.C.).

2. Apple filed a first petition for *inter partes* review of the ’941 Patent (“Apple Petition”) on November 23, 2016 that challenged claims 1–13. *Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00319 (Paper 2).

3. On June 6, 2017, the Board instituted a trial on claims 1, 2, and 6–13. *See* Case No. IPR2017-00319 (Paper 10).

4. Apple filed a second petition for *inter partes* review of the ’941 Patent on November 23, 2016 that challenged claims 14–21. *Apple Inc. v. Valencell, Inc.*, Case No. IPR2017-00321 (Paper 2).

5. On June 6, 2017, the Board instituted a trial on claims 14–21. Case No. IPR2017-00321 (Paper 11).

6. On January 4, 2016, Valencell filed a separate civil action in the same district court alleging that Fitbit infringes the ’941 Patent, and the other three patents asserted against Apple. *Valencell, Inc. v. Fitbit, Inc.*, Case No. 5:16-cv-00002 (E.D.N.C.).

7. On November 11, 2016, Valencell filed another civil action alleging that three other defendants infringe the ’941 Patent, as well as other patents.

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