

Filed on behalf of Valencell, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FITBIT, INC.,  
Petitioner,

v.

VALENCELL, INC.,  
Patent Owner.

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Case IPR2017-01556  
U.S. Patent No. 8,923,941

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**PATENT OWNER MANDATORY NOTICES PURSUANT TO  
37 C.F.R. §§ 42.8(a)(2) and 42.8(b)**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Patent Owner Valencell, Inc. (“Valencell”) hereby files its mandatory notices pursuant to 37 C.F.R. §§ 42.8(a)(2) and 42.8(b):

**A. Section 42.8(b)(1) – Real Party-In-Interest**

Patent Owner identifies Valencell, Inc., as its real party-in-interest.

**B. Section 42.8(b)(2) – Related Matters**

Patent Owner asserts the patent at issue in the following lawsuits *Valencell, Inc. v. Apple Inc.*, Case No. 5:16-cv-00001 (E.D.N.C); *Valencell, Inc. v. Fitbit, Inc.*, Case No. 5:16-cv-00002 (E.D.N.C); and *Valencell, Inc. v. Bragi Store, LLC, et al.*, Case No. 5:16-cv-00895 (E.D.N.C.). The patent at issue is the subject of two instituted *inter partes* reviews, *Apple Inc. v. Valencell, Inc.*, Case IPR2017-00319 (instituted June 6, 2017) and *Apple Inc. v. Valencell, Inc.*, Case IPR2017-00321 (instituted June 6, 2017). Petitioner has also filed a second *inter partes* review petition for the patent at issue: *Fitbit, Inc. v. Valencell, Inc.*, Case IPR2017-01555. The patent at issue claims the benefit of U.S. Patent No. 8,700,111. Finally, U.S. Patent No. 9,314,167 and pending U.S. Patent Application No. 14/996,332 claim priority to the patent at issue.

**C. Section 42.8(b)(3) – Lead and Back-Up Counsel**

Patent Owner identifies the following lead and back-up counsel:

Lead Counsel:

Justin B. Kimble (Reg. No. 58,591)  
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**D. Section 42.8(b)(4) – Service Information**

- (i) electronic mailing addresses: JKimble-IPR@bcpc-law.com;  
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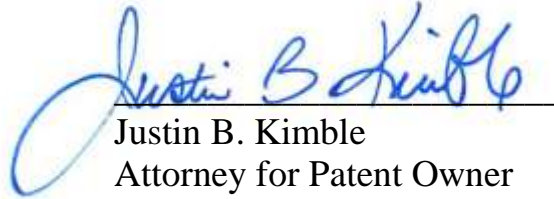
Patent Owner consents to service by e-mail at the address(s) identified in Section (i) above.

Case IPR2017-01556

Patent 8,923,941

Dated: June 30, 2017

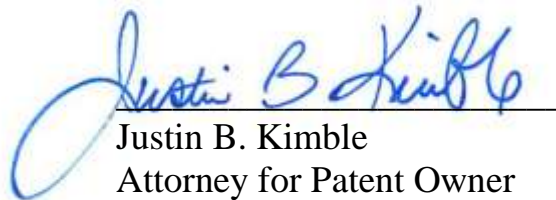
Respectfully submitted,



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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that document has been served via electronic mail on June 30, 2017, to Petitioner at following email addresses pursuant to its consent in its Petition at p. 54: harper.batts@bakerbotts.com, jeremy.taylor@bakerbotts.com; and dlfitbit-valencell@bakerbotts.com.



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