

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON U.S.A., INC.
Petitioner

vs.

CELLSPIN SOFT, INC.,
Patent Owner

CASE: IPR2019-00127¹
Patent No. 9,258,698

**PATENT OWNER CELLSPIN'S CORRECTED² NOTICE OF BASIS FOR RELIEF
REQUESTED UNDER 37 C.F.R. § 42.21 PURSUANT TO THE
DECEMBER 13, 2019 ORDER**

¹ GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. were joined as parties to this proceeding.
Paper 27

I. Specific Relief Requested in Motion to Strike

Cellspin requests authorization to file a motion to strike Canon's Reply in its entirety and its accompanying Exhibits 1036-1045.² In the alternative, the motion will request that the Board strike those ten Exhibits along with any arguments in the Reply based on those Exhibits. In the alternative, the motion will request that the Board strike those ten exhibits and accord no weight to arguments in the Reply based on said Exhibits. In the alternative, the Motion will request the Board to strike, or alternatively give no weight to, at a minimum the matters listed and set forth in detail in Cellspin's previously filed Objections of October 28, 2019, at Paper 25.

II. Bases for the Requested Relief

The Reply and the ten exhibits: (1) violate the PTAB's Consolidated Trial Practice Guide, November 2019's ("Consolidated Guide") proscription against submitting new evidence with a reply; and (2) thus, unfairly prejudice Cellspin.

Cellspin appreciates that the Board generally disfavors motions to strike, including because striking matters may inhibit their inclusion in the public and appellate records, and because the Board has the ability to sort through what is improperly new in a reply filing without needing to address a motion to strike. *See, e.g., Silicon Laboratories, Inc. v. Cresta Technology Corp.*, IPR2015-00615, 00626, Paper 26 (PTAB Feb. 29, 2016) (Denying authorization for Motion to Strike and instead permitting submission of a list of portions in Reply that were improperly new). To this end, the Board's Practice Guide states that:

In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply. As such, striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely. Thus, in most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply.

Consolidated Guide, p. 80.

Nonetheless, *nine* days after Cellspin filed its Sur-Reply, Canon saw fit to request leave for a motion to strike what it alleges to be improper new matters within and cited by Cellspin’s Sur-Reply.³ Setting aside the lack of merit in whole or part of such a motion by Canon, should the Board entertain Canon’s motion, then it should also grant Cellspin leave for a motion to strike indisputably, improperly new matters within and cited by Cellspin’s Sur-Reply. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (Board did not abuse its discretion in refusing to consider reply brief arguments advocating a “new theory” of unpatentability under 37 C.F.R. §42.23(b)); *Apple Inc. v. e-Watch, Inc.*, Case IPR2015-00412, slip op. at 44 (Paper 50) (PTAB May 6, 2016) (“‘Respond,’ in the context of 37 C.F.R. §42.23(b), does not mean embark in a new direction with a new approach as compared to the position originally taken in the Petition. Accepting such belatedly presented new arguments would be unjust to the Patent Owner and we decline to do so.”). As noted in the Board’s Practice Guide,

Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability. A party also may submit rebuttal evidence in support of its reply. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1077–78 (Fed. Cir. 2015). If a party submits a new expert declaration with its reply, the opposing party may ... move to exclude the declaration. *Id.* at 1081–82.⁴

Consolidated Guide, p. 73. Canon’s Reply constitutes a clear and egregious violation of this rule, because everything, or at a minimum substantially everything of substance or consequence, in the Reply or cited by the Reply constitutes new, non-rebuttal matters in reply that Canon could have presented earlier, e.g. to make out a prima facie case of unpatentability. Thus, *everything of substance* in and cited

³ The Practice Guide’s statement that ordinarily leave for motions to strike should be requested within seven days of the offending paper does not constitute an absolute seven-day deadline for motions to strike. If it did, then the Board would presumably refuse leave for both Canon and Cellspin, both of which requested leave after such a seven-day window had passed.

⁴ The Board’s deadline for filing motions to exclude, i.e., January 9, 2020, has not passed. Paper 12, p.

by Cellspin's Sur-reply was submitted in rebuttal to Canon's improper Reply and improper Reply evidence.

At a minimum, due process and fundamental fairness would require striking all, or at least substantially all, of Canon's Reply and the evidences it relied upon, including the wholly improper Madisetti Declaration at Ex. 1043. Alternatively, at a minimum, due process and fundamental fairness would require denying any motion to strike brought by Canon, including for the foregoing reasons. Thus, the motions to strike sought to be filed by Canon and Cellspin are intertwined, including logically and factually, and the Board should consider both sides Motions to Strike if it considers either of them.

It would constitute a grave injustice if the Board does not strike or, at a minimum, disregard the new theories asserted in and with Canon's Reply, which include improperly new obviousness theories, which are beyond dispute new and outside the scope of Canon's Petition and Cellspin's Response, including at least the following: (1) that paired wireless connections are obvious in view of Bluetooth and/or the Bluetooth Specification for various reasons, including encouragement, design choice, expectedness, routineness and/or due to predictable results; (2) that it would have been obvious to pair and/or that a POSITA would have been motivated to pair the Hiroishi and/or Hollstrom wireless connections for various reasons, including encouragement, design choice, expectedness, routineness and/or due to predictable results; (3) new theories, including obviousness theories, based in whole or part upon the Bluetooth Basic Imaging Profile (BIP); (4) that pared wireless connection should now be construed to require an "association" instead of merely requiring two-way communications; (5) that Hiroishi meets Canon's new "association" theory of pairing; (6) that fields which receive text inputs via a keypad fall within the scope of graphical user interface; (7) that cryptographic authentication was obvious based upon matters and language set forth in the Bluetooth standard or other new Exhibits relied upon by Canon, for various reasons, including encouragement, design choice, expectedness, routineness and/or due to predictable results; (8) that if a POTISA wanted to establish a connection, he or she would

necessarily use or “have to use” cryptographic authentication, including based upon analysis of contents of the Bluetooth Standard or other new Exhibits relied upon by Canon; (9) that cryptographic authentication was a “mandatory” feature, including under Security Mode 3 of the Bluetooth Standard; (10) that cryptographic authentication was a feature of Bluetooth association models and/or obviousness theories based thereon; (11) new theories for combining and motivations to combine Hiroishi with Nozaki and/or Ando for using a the mobile device GUI for image deletion on the camera; (12) that the method claims are rendered obvious by pairing being obvious and/or by the Hiroishi and/or Hollstrom devices being obvious to use for paired connections; and/or (13) new theory of obviousness for using HTTP to upload received medias file along with user information;

The improper new matters throughout Canon’s Reply and Exhibits are not proper for rebuttal, such matters could have been presented in Canon’s Petition, *e.g.* to make out a prima facie case of unpatentability, and such matters were naturally not addressed or acknowledged in the Board’s Institution Decision.

Cellspin’s Sur-Reply and its cited evidence were primarily and substantially devoted to attempting to address improper new evidence and arguments in Canon’s Reply that were not proper rebuttal and that Canon could have presented earlier, even though Cellspin had *inadequate* time and briefing space to address them, and even though Cellspin would be grievously unfairly prejudiced if the Board erroneously considered such improperly new matters in and supporting Canon’s improper Reply.

Thus, it would be a grievous and fundamentally unfair move by the Board to improperly strike Cellspin’s responsive matters in and cited by its Sur-Reply, including if the Board declined to strike the improperly new assertions in Canon’s Reply to which Cellspin was responding. Further, in order to fairly consider any motion to strike brought by Canon directed to Cellspin’s Sur-Reply, the Board must give considerable weight to the fact that Cellspin had to include such matters in its Sur-Reply to

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