

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Panasonic Corporation of North America *et al.*

Petitioners

v.

Cellspin Soft, Inc.

Patent Owner

CASE: IPR2019-00131

Patent No. 9,258,698

**PETITIONERS' REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

Case No. IPR2019-00131

Patent No. 9,258,698

PETITIONER'S EXHIBIT LIST

- Ex. 1001 Declaration of Dr. John Strawn
- Ex. 1002 Curriculum Vitae of Dr. John Strawn
- Ex. 1003 United States Patent No. 9,258,698 to Gurvinder Singh, et al. (“the ’698 Patent”)
- Ex. 1004 Patent File History for the ’698 Patent
- Ex. 1005 Japanese Patent Application Publication No. 2003-51772, identifying Hiroshi Mashita as inventor (“Mashita”)
- Ex. 1006 Certified translation of Mashita
- Ex. 1007 Japanese Patent Application Publication No. 2003-299014, identifying Jiro Onishi et al. as inventors (“Onishi”)
- Ex. 1008 Certified translation of Onishi
- Ex. 1009 Japanese Patent Application Publication No. 2004-102810, identifying Tomonobu Hiraishi as inventor (“Hiraishi”)
- Ex. 1010 Certified translation of Hiraishi
- Ex. 1011 United States Patent No. 8,738,794 to Gurvinder Singh, et al. (“the ’794 Patent”)
- Ex. 1012 Excerpts from *Mc-Graw Hill Dictionary of Computing & Communications*, Copyright 2003
- Ex. 1013 Excerpts from *Wiley Electrical and Electronics Engineering Dictionary*, Copyright 2004
- Ex. 1014 User guide for *Sony Ericsson Z520a*, Copyright 2005
- Ex. 1015 Cingular Wireless Service Agreement of 22 March, 2006
- Ex. 1016 User’s Guide for *Nokia N73*, Copyright 2006

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- Ex. 1017 Excerpts from *Specification of the Bluetooth System*, Dated 4 November 2004
- Ex. 1018 Receipt for purchase of *Sony Ericsson Z520a*, dated December 20, 2005
- Ex. 1019 Amended Complaint dated March 2, 2018, *Cellspin Soft, Inc. v. Panasonic Corporation of North America*, Case No. 4:17-cv-05941, United States District Court for the Northern District of California
- Ex. 1020 *Bluetooth Basic Imaging Profile, Interoperability Specification*, Dated July 30, 2003
- Ex. 1021 “IMT-2000,” published by the National Telecommunications and Information Administration, United States Department of Commerce, August 2000
- Ex. 1022 Transcript of Oral Argument held February 25, 2019 in IPR2019-00131

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As authorized by the Board (Paper 8), Petitioners submit this Reply to address Patent Owner's argument that the Petition "fails to show sufficient grounds or standing for institution." Prelim. Resp. (Paper 7) at 42. Patent Owner's argument is legally incorrect, and the Petition does show standing, for four reasons.

First, according to the Board's regulations a petition has standing on its face when it certifies compliance with 37 C.F.R. § 42.104(a). The Petition here does (Pet. at 6) and Patent Owner has not challenged this certification.

Second, nothing in the statutes governing the IPR process, 35 U.S.C. §§ 311-319, nor the Board's regulations, 37 C.F.R. §§ 42.100-123, states or suggests that rulings in active co-pending litigation could deprive the petitioner of standing.

Third, none of Patent Owner's cited authorities support its lack of standing argument. The five decisions Patent Owner cites all share one salient characteristic: they involved *patent claims that could never be asserted again*, because either the patent owner had cancelled the claims or there had been a final ruling of invalidity *through all appeals*. In contrast, the pending litigation involving the Challenged Claims here remains on appeal.

In *Unified Patent v. Digital Audio Encoding Sys.*, IPR2017-00208 (March 13, 2017), the patent owner filed a statutory disclaimer of all claims of the patent at issue, which "effectively eliminated those claims." 2017 WL 1014400, *1-2. The Board thus denied the IPR petition "as moot." *Id. Pfizer, Inc. v. Genentech, Inc.*,

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IPR2017-01726 (Jan. 23, 2018) and *Luxottica Retail N. Am. Inc. v. Lennon Image Techs., LLC*, IPR2014-00593 (Oct. 10, 2014) are similar: the patent owners had cancelled claims in a co-pending IPR or *ex parte* reexamination, thus the Board found the petitions “moot” as to those claims. 2018 WL 539352, *2-3 (noting that the “challenged claims no longer exist”); 2014 WL 5221330, *2.

Semiconductor Components Indus. v. Power Integrations, Inc., IPR2016-01600 (Feb. 14, 2018) involved co-pending federal court litigation. The Federal Circuit had held that two claims of the patent at issue were invalid, and the patent owner did not seek Supreme Court review. 2018 WL 930833, *2. The Board agreed that “a final judgment of invalidity by the Federal Circuit is binding on the USPTO” (*Id.*, *4), quoting Manual of Patent Examining Procedure § 2286 (“A final holding of claim invalidity or unenforceability (after all appeals) ... is controlling on the Office.”)

Finally, Patent Owner cites in bulk five pages from a dissent from a denial of rehearing *en banc*; the relevance of this citation is unclear. *See Fresenius USA, Inc. v. Baxter Intern., Inc.*, 733 F.3d 1369, 1373-77 (Fed. Cir. 2013). In any event, in *Fresenius* too there was a Federal Circuit ruling upholding the Patent Office’s cancellation of claims; *Fresenius* concerned the preclusive effect of that ruling on pending district court litigation. *See id.* at 1373-75.

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