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Paper 11
Entered: April 29, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PANASONIC CORPORATION AND
PANASONIC CORPORATION OF NORTH AMERICA,
Petitioner
v.

CELLSPIN SOFT, INC.,
Patent Owner.

Case IPR2019-00131
Patent 9,258,698 B2

Before GREGG I. ANDERSON, DANIEL J. GALLIGAN, and STACY B. MARGOLIES, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Panasonic Corporation and Panasonic Corporation of North America (collectively "Petitioner") filed a Petition (Paper 1, "Pet.") pursuant to 35 U.S.C. §§ 311–19 to institute an *inter partes* review of claims 1, 3–5, 7, 8, 10–13, and 15–20 ("challenged claims") of U.S. Patent No. 9,258,698 ("'698 patent"), which was filed on November 5, 2014.[1] Ex. 1003, [22]. The Petition is supported by the Declaration of Dr. John Strawn ("Strawn Declaration," Ex. 1001). Cellspin Soft, Inc. ("Patent Owner") filed a Preliminary Response (Paper 7, "Prelim. Resp.").

After considering the evidence and arguments presented in the Petition and Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the '698 patent is unpatentable. *See* 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). We therefore institute an *inter partes* review of all of the challenged claims on the grounds articulated in the Petition as set forth below. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018); Guidance on the Impact of SAS on AIA Trial Proceedings (Apr. 26, 2018), https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial.

[1] Petitioner states that the '698 patent claims priority to Provisional Application No. 61/017,202, filed December 28, 2007. Pet. 6; Ex. 1003, [60], 1:26–29. The parties' papers do not raise an issue relating to the effective filing date of the challenged claims of the '698 patent.

II. BACKGROUND

A. Related Proceedings

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 3–5; Paper 5, 2. Patent Owner further identifies an appeal to the U.S. Court of Appeals for the Federal Circuit, Appeal No. 2018-1823. Paper 5, 2. Federal Circuit Appeal No. 2018-1817, referenced below, is the lead case. Paper 5, 2.[2]

B. Technology and the '698 Patent

The '698 patent is directed to "distribution of multimedia content." Ex. 1003, 1:40–41. The system described includes using a digital data capture device in conjunction with a cellular phone to automatically publish "data and multimedia content on one or more websites simultaneously." *Id.* at 1:41–45.

1. Technology

According to the '698 patent, in the prior art,

> the user would capture an image using a digital camera or a video camera, store the image on a memory device of the digital camera, and transfer the image to a computing device such as a personal computer (PC). In order to transfer the image to the PC, the user would transfer the image off-line to the PC, use a cable such as a universal serial bus (USB) or a memory stick and plug the cable into the PC. The user would then manually upload the

[2] A different Petitioner filed a petition for *inter partes* review of all of the claims of the '698 patent in *Canon U.S.A., Inc. v. Cellspin Soft, Inc.*, IPR2019-00127 ("'127 IPR"). The '127 IPR alleges different grounds for unpatentability.

> image onto a website which takes time and may be inconvenient for the user.

Ex. 1003, 1:46–55.

2. The '698 Patent (Ex. 1003)

The '698 patent describes a digital data capture device, which may be "a digital camera, a video camera, digital modular camera systems, or other digital data capturing systems." Ex. 1003, 3:34–38, 3:41–44. The digital data capture device works with a Bluetooth enabled mobile device, e.g., a cell phone, "for publishing data and multimedia content on one or more websites automatically or with minimal user intervention." *Id.* at 3:35–38.

Figure 2 of the '698 patent is reproduced below.

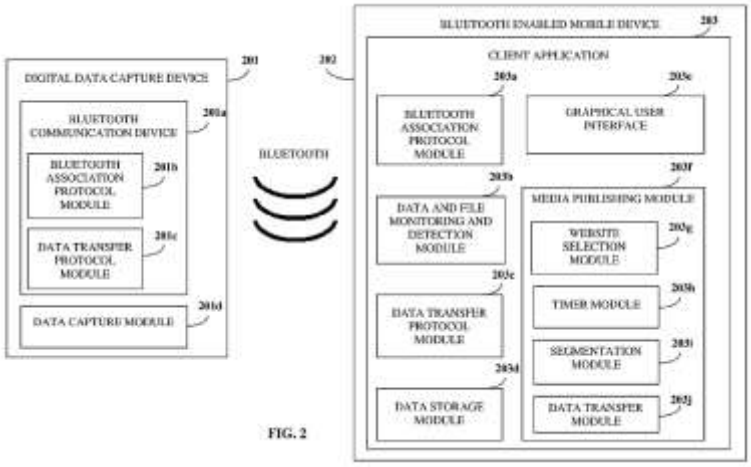

Figure 2 "illustrates a system for utilizing a digital data capture device in conjunction with a Bluetooth enabled mobile device." Ex. 1003, 3:14–18. Referring to Figure 2, "[t]he BT [(Bluetooth)] communication device 201a on the digital data capture device 201 is paired 103 with the mobile device 202 to establish a connection between the digital data capture device 201 and the mobile device 202." *Id.* at 3:60–63. According to the '698 patent, Bluetooth pairing involves establishing a connection between two Bluetooth

devices that "mutually agree to communicate with each other." *Id.* at 3:63–65. The communication is authenticated cryptographically by using a "common password known as a passkey," which is exchanged between the BT communication device 201a and the mobile device 202. *Id.* at 3:65–4:8.

Still referring to Figure 2, a user captures data and multimedia content using digital data capture device 201. *Id.* at 4:26–27. Client application 203 on mobile device 202 detects the captured data, the multimedia content, and "files associated with the captured data and the multimedia content." *Id.* at 4:29–32.. The client application initiates a transfer of the captured data and the digital data capture device automatically transfers the captured data from the mobile device using one or a combination of file transfer protocols. *Id.* at 4:32–42. The transfer protocols include "one or a combination of BT profile protocols such as the object exchange (OBEX) protocol, the generic object exchange profile (GOEP) protocol" or the "media transfer protocol (MTP), the picture transfer protocol (PTP), and the PictBridge protocol implemented using a USB." *Id.* at 4:42–48.

The user may set preferences regarding timing of the publication of the captured data and the destination website. Ex. 1003, 5:23–38. "The client application 203 on the mobile device 202 then automatically publishes 107 the transferred data and multi-media content on one or more websites." *Id.* at 5:39–41.

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