

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Panasonic Corporation and Panasonic Corporation of North America, GoPro, Inc.  
Garmin International, Inc., and Garmin USA, Inc.  
Petitioners,

v.

Cellspin Soft, Inc.  
Patent Owner.

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CASE: IPR2019-00131<sup>1</sup>  
Patent No. 9,258,698

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**PATENT OWNER CELLSPIN'S SUBMISSION ON TIMING AND  
NOTICE OF BASIS FOR RELIEF REQUESTED UNDER 37 C.F.R. §  
42.21 PURSUANT TO THE DECEMBER 4, 2019 ORDER**

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<sup>1</sup> GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. were joined as parties to this proceeding. Paper 29.

**I. The Timing of Cellspin’s Request to File a Motion to Strike.**

The Board’s December 4, 2019 Order required Patent Owner Cellspin Soft, Inc. (Cellspin”) to explain the timing of its request to file a motion to strike, in view of the statement in the Consolidated Practice Guide that, “[g]enerally, authorization to file a motion to strike should be requested within one week of the allegedly improper submission.” Consolidated Trial Practice Guide, 81 (November 2019) (“Consolidated Guide”).

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, *eight* days after Cellspin filed its Sur-Reply, Panasonic 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.<sup>2</sup> Setting aside the lack of merit in whole or part of such a motion by Panasonic, should the Board entertain Panasonic’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.<sup>3</sup>

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<sup>2</sup> 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 Panasonic and Cellspin, both of which requested leave after such a seven-day window had passed.

<sup>3</sup> The Board’s deadline for filing motions to exclude is January 9, 2020, has not passed. Paper 12, p.

Consolidated Guide, p. 73. Panasonic'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 Panasonic could have presented earlier, *e.g.* to make out a prima facie case of unpatentability. Thus, *everything of substance* in and cited by Cellspin's Sur-reply was submitted in rebuttal to Panasonic'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 Panasonic's Reply and the evidences it relied upon, including the wholly improper Strawn Declaration at Ex. 1024. Alternatively, at a minimum, due process and fundamental fairness would require denying any motion to strike brought by Panasonic, including for the foregoing reasons. Thus, the motions to strike sought to be filed by Panasonic 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 Panasonic's Reply, which include improperly new obviousness theories, which are beyond dispute new and outside the scope of Cellspin's Response, including at least the following: (1) that paired wireless connections are obvious in view of Bluetooth; and (2) that a client application composed of multiple modules renders obvious a single client application; and which further includes

improperly new theories of claim limitations being met, namely that (3) Mashita's references to a PIN are actually references to a passkey; (4) that Mashita's use of a PIN actually results in actual Bluetooth pairing occurring; that cryptographic authentication is inherent in Bluetooth pairing; (5) that combining Mashita's Bluetooth connection with the disclosure of the Bluetooth specification meets cryptographic authentication because the Bluetooth specification includes cryptographic algorithms; and (6) Mashita discloses Limitation J, *i.e.*, "wherein the cellular phone is configured to use HTTP to upload the received new-media file along with user information to a user media publishing website."

The improper new matters throughout Panasonic's Reply and Exhibits are not proper for rebuttal, such matters could have been presented in Panasonic'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 Panasonic's Reply that were not proper rebuttal and that Panasonic 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 Panasonic'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

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