

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOPRO, INC., GARMIN INTERNATIONAL, INC., AND GARMIN USA, INC.,  
Petitioners,

v.

CELLSPIN SOFT, INC.,  
Patent Owner.

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IPR2019-01107  
Patent 9,258,698 B2

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

ANDERSON, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
*35 U.S.C. § 314*  
Granting Motion for Joinder  
*35 U.S.C. § 315(c); 37 C.F.R. 42.122*

## I. INTRODUCTION

Petitioners, GoPro, Inc., Garmin International, Inc., and Garmin USA, Inc. (collectively “’1107 Petitioners” or “Petitioner”) filed a Petition (“Pet.”) on May 28, 2019 (Paper 1) requesting *inter partes* review of claims 1–22 of U.S. Patent No. 9,258,698 B2 (“the ’698 patent,” Ex. 1001). Pet. 5. Cellspin Soft, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 16, “Prelim. Resp.”).

Concurrently with the Petition, the ’1107 Petitioners filed a Motion for Joinder (“Motion,” “Mot.,” Paper 4) with *Canon U.S.A. v. Cellspin Soft, Inc.*, IPR2019-00127 (“’127 IPR”), a pending *inter partes* review also challenging claims 1–22 of the ’698 patent. Mot. 1. We instituted *inter partes* review on the ’127 IPR on April 29, 2019. ’127 IPR, Paper 7. In our June 12, 2019, Order in this proceeding,<sup>1</sup> we authorized briefing on the Motion by the ’1107 IPR Petitioner, Canon U.S.A. (“Canon”), and Patent Owner in both proceedings. ’127 IPR, Paper 14; Paper 8.<sup>2</sup> On June 28, 2019, Patent Owner filed in both cases a notice of non-opposition to the motion for joinder. ’127 IPR, Paper 16; Paper 11. Canon opposes the Motion (“Opposition,” “Opp.,” Paper 13; *see also* ’127 IPR, Paper 15 (same filing)). Also pursuant to our Order, the ’1107 Petitioners filed a Reply (“Reply”) (’127 IPR, Exhibit 1035; Paper 14), and with email authorization Canon filed a Sur-reply (“Sur-Reply,” ’127 IPR, Paper 19; Paper 15).

*An inter partes* review may not be instituted unless the information presented in the petition and any preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of

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<sup>1</sup> Our June 11, 2019, Order required the briefing of the Motion in the ’1107 IPR to be filed in the ’127 IPR. ’127 IPR, Paper 14, 3; ’1107 IPR, Paper 8, 3. The Motion is filed in the ’127 IPR as Exhibit 1033 and the Reply as Exhibit 1035.

<sup>2</sup> For purposes of this Decision, hereinafter and unless otherwise indicated, references to Papers (for example “Paper 8” or “Pet.”) are to this ’1107 IPR.

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the claims challenged in the petition.” 35 U.S.C. § 314(a). Having considered the arguments and evidence presented by the ’1107 Petitioners and Patent Owner, we determine ’1107 Petitioners have demonstrated a reasonable likelihood of prevailing in showing that at least one of the challenged claims of the ’698 patent is unpatentable.

## II. BACKGROUND

### A. *Related Proceedings*

In addition to the ’127 IPR, two other *inter partes* reviews have been filed challenging claims 1, 3–5, 7, 8, 10–13, and 15–20 of the ’698 patent: *Panasonic Corp. of North America v. Cellspin Soft, Inc.*, IPR2019-00131 and *GoPro, Inc. v. Cellspin Soft, Inc.*, IPR2019-01108. Paper 5, 2.

The parties advise us that Patent Owner has asserted the ’698 patent against the ’1107 Petitioners in *Cellspin Soft, Inc. v. GoPro, Inc.*, No. 4:17-cv-005939 and *Cellspin Soft, Inc. v. Garmin International*, No. 4:17-cv-05934 in the U.S. District Court for the Northern District of California. Pet. 2; Paper 5, 2. Other lawsuits alleging infringement of the ’698 patent are pending. Pet. 3; Paper 5, 2.

### B. *Technology and the ’698 Patent*

The ’698 patent is directed to “distribution of multimedia content.” Ex. 1001, 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 image onto a website which takes time and may be inconvenient for the user.

Ex. 1001, 1:46–55.

## 2. The '698 Patent (Ex. 1001)

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. 1001, 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 3:34–38.

Figure 2 of the '698 patent is reproduced below.

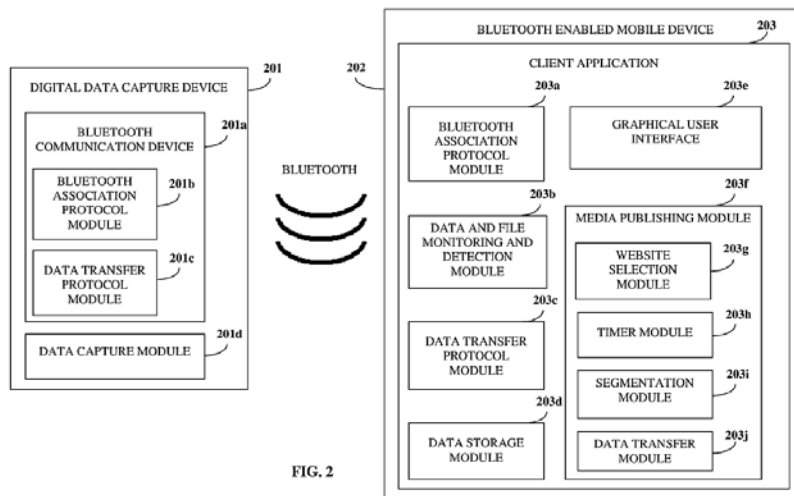


Figure 2 “illustrates a system for utilizing a digital data capture device in conjunction with a Bluetooth enabled mobile device.” Ex. 1001, 3:14–18.

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 3:60–65. The communication is authenticated cryptographically using a “common password known as a passkey,” which “is exchanged between the BT communication device 201a and the mobile device 202.” *Id.* at 3:65–4:7.

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) protocols,” such as the generic object exchange profile (GOEP) protocol; 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. 1001, 5:23–38. “The client application 203 on the mobile device 202 then automatically publishes 107 the transferred data and multimedia content on one or more websites.” *Id.* at 5:39–41.

### *C. Illustrative Claim*

Claims 1 (method), 5 (device), 8 (system), and 13 (computer readable-medium) are independent claims. Claims 2–4 depend directly from claim 1. Claims 6, 7, 17, 19, and 21 depend directly or indirectly from claim 5. Claims 9–12, 20, and 22 depend directly or indirectly from claim 8. Claims 14–16 and 18 depend directly from claim 13.

Claim 1 is reproduced below as illustrative.

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