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Paper 7
Entered: April 29, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CANON U.S.A., INC.,
Petitioner,

v.

CELLSPIN SOFT, INC.,
Patent Owner.

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Case IPR2019-00127
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
Institution of *Inter Partes* Review
*35 U.S.C. § 314*

## I. INTRODUCTION

Canon U.S.A., Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") pursuant to 35 U.S.C. §§ 311–19 to institute an *inter partes* review of claims 1–22 ("challenged claims") of U.S. Patent No. 9,258,698 ("'698 patent"), which was filed on November 5, 2014.[1] Ex. 1001, [22]. The Petition is supported by the Declaration of Dr. Vijay Madisetti, Ph.D. ("Madisetti Declaration," Ex. 1003). Cellspin Soft, Inc. ("Patent Owner") filed a Preliminary Response (Paper 6, "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; 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.

## II. BACKGROUND

### *A. Related Proceedings*

Petitioner advises us that Patent Owner has asserted the '698 patent against Petitioner in *Cellspin Soft, Inc. v. Canon USA, Inc.*, No. 4:17-cv-

[1] Petitioner states that the '698 patent claims priority to Provisional Application No. 61/017,202, filed December 28, 2007. Pet. 6; Ex. 1001, [60], 1:26–29. The parties do not raise an issue relating to the effective filing date of the challenged claims of the '698 patent.

05938 (N.D. Cal.) ("District Court lawsuit"). The District Court lawsuit was dismissed, the court finding the claims of the '698 patent unpatentable under 35 U.S.C. § 101. Pet. 2 (citing Ex. 1021 (Order Re: Omnibus Motion to Dismiss; Motion for Judgment on the Pleadings, dated April 3, 2018)). Patent Owner has appealed to the U.S. Court of Appeals for the Federal Circuit, Appeal No. 2018-1823. *Id.* Federal Circuit Appeal No. 2018-1817, referenced below, is the lead case. Pet. 2; Paper 4, 2.[2]

Patent Owner has also asserted the '698 patent against other parties in the U.S. District Court for the Northern District of California, including the following: JK Imaging, Ltd. (Case No. 4:17-cv-06881); Garmin International, *et al.* (Case No. 4:17-cv-05934); Nikon Americas Inc., et al. (Case No. 4:17-cv-05936); TomTom Inc., et al. (Case No. 4:17-cv-05937); GoPro, Inc. (Case No. 4:17-cv-005939); Eastman Kodak Co. (Case No. 4:17-cv-05940); and Panasonic Corporation of America (Case No. 4:17-cv-05941). Pet. 3; Paper 4, 2. Petitioner asserts the following:

> The cases against JK Imaging, GoPro, and Panasonic were dismissed on the grounds that the claims of the '698 Patent are directed to non-patentable subject matter, and are currently on appeal as part of lead case Appeal No. 2018-1817. The cases against TomTom and Eastman Kodak were dismissed. The case against Nikon remains pending.

Pet. 3.

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[2] Panasonic Corporation and Panasonic Corporation of North America have also filed a petition for *inter partes* review of some of the claims of the '698 patent in *Panasonic Corporation of North America v. Cellspin Soft, Inc.*, IPR2019-00131 ("'131 IPR"). The '131 IPR alleges different grounds of unpatentability.

*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.

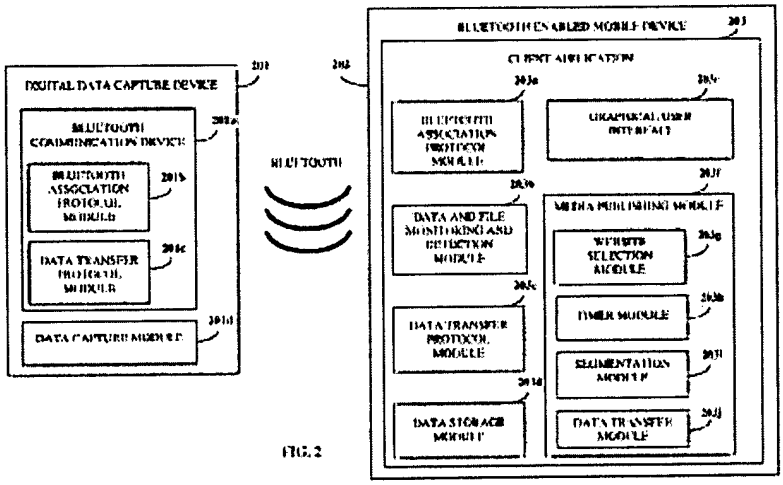


FIG. 2

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 3:65–4:8.

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

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