

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON U.S.A., INC., GOPRO, INC.,
GARMIN INTERNATIONAL, INC., AND GARMIN USA, INC.,
Petitioners,

v.

CELLSPIN SOFT, INC.,
Patent Owner.

IPR2019-00127¹
Patent 9,258,698 B2

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

ANDERSON, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining All Challenged Claims Unpatentable

Denying Petitioner's Motion to Strike

Denying Patent Owner's Motion to Strike/Exclude

35 U.S.C. § 318(a)

¹ GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. ('1107 Petitioners) were joined to this proceeding. *See* Paper 27, 30 (ordering that "the '1107 Petitioners are joined with IPR2019-00127").

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, 2014.² Ex. 1001, code(22). Cellspin Soft, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). We instituted an *inter partes* review of all challenged claims (Paper 7, “Inst. Dec.”).

After institution, Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”), Petitioner filed a Reply (Paper 24, “Reply”), and Patent Owner filed a Sur-Reply (Paper 29, “Sur-reply”). The Petition is supported by the Declaration of Dr. Vijay Madisetti, Ph.D. (Ex. 1003, “Madisetti Declaration”). The Reply is supported by the Reply Declaration of Dr. Vijay Madisetti, Ph.D. (Ex. 1043, “Madisetti Reply Declaration”). The deposition of Dr. Madisetti was taken by Patent Owner after the Madisetti Declaration was filed (Ex. 1042, “Madsetti Deposition”).³ The Response is supported by the Declaration of Dr. Michael Foley (Ex. 2009, “Foley Declaration”). The Sur-reply is supported by the Declaration of Dr. Michael Foley Concerning Patent Owner’s Sur-reply to Petitioner’s Reply (Ex.

² Petitioner states that the ’698 patent claims priority to Provisional Application No. 61/017,202, filed December 28, 2007. Pet. 6; Ex. 1001, code(60), 1:26–29. All of the prior art references were published or issued more than one year prior to December 11, 2008—the filing date of the earliest application in the chain of related continuation applications. *See* Ex. 1001, code(63). We therefore do not reach the issue of whether any of the challenged claims are entitled to the filing date of the provisional application.

³ Panasonic Corporation and Panasonic Corporation of North America also filed a petition for *inter partes* review of some of the claims of the ’698 patent in *Panasonic Corporation of North America et al., v. Cellspin Soft, Inc.*, IPR2019-00131 (“’131 IPR”). The ’131 IPR alleges different grounds of unpatentability.

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2026, “Foley Sur-reply Declaration”). The deposition of Dr. Foley was taken by Petitioner after the Foley Declaration was filed (Ex. 1040, “Foley Deposition”). An oral hearing was held on January 28, 2020, and a transcript made of record (Paper 50, “Tr.”).

We authorized each party to file a motion to strike (Paper 36, “Order”). Pursuant to our Order, Petitioner filed a Motion to Strike New Arguments and Evidence Submitted in Patent Owner’s Sur-Reply (Paper 44, “Pet. Mot.”), to which Patent Owner filed a Response (Paper 40, “PO Opp.”). Also as authorized in the Order, Patent Owner filed its separate Motion to Strike and, Alternatively, Exclude Improper Reply and Reply Evidence (Paper 43, “PO Mot.”), to which Petitioner filed an Opposition (Paper 45, “Pet. Opp.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that claims 1–22 of the ’698 patent are unpatentable.

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-05938 (N.D. Cal.) (“District Court lawsuit”). Pet. 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); GoPro, Inc. (Case No. 4:17-cv-005939); and Panasonic Corporation of America (Case No. 4:17-cv-05941). Pet. 3; Paper 4, 2.

In each of these district court cases, the District Court granted a motion to dismiss, finding the claims of the ’698 patent ineligible for patent protection under

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35 U.S.C. § 101. *See Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1309 (Fed. Cir. 2019); *see also* Ex. 1021 (Order Re: Omnibus Motion to Dismiss; Motion for Judgment on the Pleadings, dated April 3, 2018)). On June 25, 2019, the Federal Circuit vacated the district court's dismissal and remanded for further proceedings. *Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1309, 1320 (Fed. Cir. 2019).

The '698 patent is also challenged in the '131 IPR. Petitioners in *GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. v. Cellspin Soft, Inc.*, IPR2019-01108 (" '1108 IPR") were joined as parties to the '131 IPR. *See* '131 IPR, Paper 27 (joining '1108 petitioners to the '131 IPR).

B. Real Parties in Interest

Petitioner Canon U.S.A., Inc. alleges it is a real-party-in-interest, as is its parent corporation Canon, Inc. Pet. 2. GoPro, Inc., Garmin Int'l, Inc., Garmin USA, Inc., Garmin Switzerland GmbH are also identified as real parties in interest. IPR2019-01107, Paper 1, 2. Patent Owner Cellspin Soft, Inc. alleges it is the real-party-in-interest. Paper 4, 2.

C. 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.

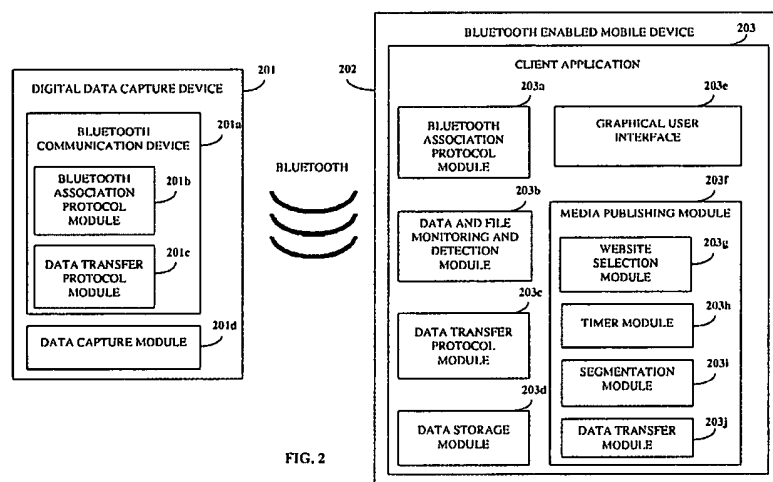


Figure 2 “illustrates a system for utilizing a digital data capture device in conjunction with a Bluetooth enabled mobile device.” Ex. 1001, 3:14–18. Referring to Figure 2, “[t]he BT [(‘Bluetooth’)] communication device 201a on the digital data capture device 201 is paired 103 with the mobile device 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

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