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Paper No. 59
Date: April 28, 2020

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.

IPR2019-00131[1]
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)

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[1] GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. ('1108 Petitioners) were joined to this proceeding. *See* Paper 29, 30 (ordering that "the '1108 Petitioners are joined with IPR2019-00131").

I. INTRODUCTION

Panasonic Corporation and Panasonic Corporation of North America (collectively "Petitioner") filed a Petition (Paper 1, "Pet.") pursuant to 35 U.S.C. §§ 311–319 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.[2] Ex. 1003, code (22). Cellspin Soft, Inc. ("Patent Owner") filed a Preliminary Response (Paper 7, "Prelim. Resp."). We instituted an *inter partes* review of all challenged claims (Paper 11, "Inst. Dec.").[3]

After institution, Patent Owner filed a Patent Owner Response (Paper 19, "PO Resp."), Petitioner filed a Reply (Paper 23, "Reply"), and Patent Owner filed a Sur-reply (Paper 30, "Sur-Reply"). The Petition is supported by the Declaration of Dr. John Strawn (Ex. 1001, "Strawn Declaration"). The Reply is supported by the Second Declaration of Dr. John Strawn (Ex. 1024, "Strawn Reply Declaration"). The deposition of Dr. Strawn was taken by Patent Owner after the Strawn Reply Declaration was filed (Ex. 2030). 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

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[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 prior to December 28, 2007.

[3] Canon U.S.A., Inc. also filed a petition for *inter partes* review of some 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 of unpatentability.

Reply (Ex. 2026, "Foley Sur-reply Declaration"). The deposition of Dr. Foley was taken by Petitioner after the Foley Declaration was filed (Ex. 1023). An oral hearing was held on January 28, 2020, and a transcript made of record (Paper 58, "Tr.").

We authorized each party to file a motion to strike (Paper 40, "Order"). Pursuant to our Order, Petitioner filed a Motion to Strike (Paper 44, "Pet. Mot."), to which Patent Owner filed a Response (Paper 48, "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 45, "PO Mot.), to which Petitioner filed an Opposition (Paper 46, "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, 3–5, 7, 8, 10–13, and 15–20 of the '698 patent are unpatentable.

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. 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 35 U.S.C. § 101. *See Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1309 (Fed. Cir. 2019); *see also* Ex. 2007 (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*, 927 F.3d at 1309, 1320 (Fed. Cir. 2019).

The '698 patent is also challenged in the '127 IPR. Petitioners in *GoPro, Inc., Garmin International, Inc. and Garmin USA, Inc. v. Cellspin Soft, Inc.*, IPR2019-01107 ("'1107 IPR") were joined as parties to the '127 IPR. *See* '127 IPR, Paper 27 (joining '1107 petitioners to the '127 IPR).

B. Real Parties in Interest

Panasonic Corporation of North America and Panasonic Corporation are alleged to be real parties-in-interest. Pet. 2. GoPro, Inc., Garmin Int'l, Inc., Garmin USA, Inc., Garmin Switzerland GmbH are also identified as real parties in interest. IPR2019-01108, Paper 1, 3. Patent Owner Cellspin Soft, Inc. alleges it is the real-party-in-interest. Paper 5, 2.

C. 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 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 3:34–38.

Figure 2 of the '698 patent is reproduced below.

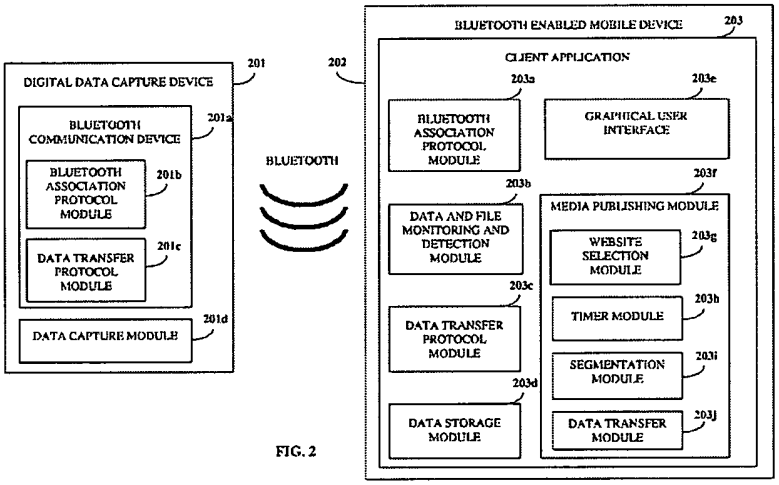

Figure 2 "illustrates a system for utilizing a digital data capture device in conjunction with a Bluetooth enabled mobile device." Ex. 1003, 3:14–18. Referring to Figure 2, "[t]he BT [("Bluetooth")] communication device 201*a* on the digital data capture device 201 is paired 103 with the mobile device 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. A communication may be authenticated

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