

PATENT OWNER EXHIBIT 2004

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

CELLSPIN SOFT, INC.

Plaintiff,

v.

BYTEDANCE LTD., et al.,

Defendants.

Civil Action No. 2:23-cv-496-JRG-RSP

JURY TRIAL DEMANDED

DEFENDANTS' INVALIDITY CONTENTIONS

Pursuant to Docket Control Order (Dkt No. 35 and Local Patent Rules 3-3 and 3-4, Defendants Bytedance Ltd., Bytedance Pte. Ltd., and Tiktok Pte. Ltd. (collectively, "Defendants") hereby provide their Invalidity Contentions and accompanying document production with respect to the claims identified by Plaintiff Cellspin Soft, Inc. ("Cellspin" or "Plaintiff") in its Patent Rule 3-1 Disclosures served on March 11, 2024.

Defendants' Invalidity Contentions include the accompanying claim charts with respect to the asserted claims of U.S. Patent Nos. 8,756,336 (the "'336 Patent"), 8,862,757 (the "'757 Patent"), 8,898,260 (the "'260 Patent"), 8,904,030 (the "'030 Patent"), 9,900,766 (the "'766 Patent"), 11,234,121 (the "'121 Patent"), and 11,659,381 (the "'381 Patent") (collectively, the "Asserted Patents")

I. INTRODUCTION

As disclosed in its respective P.R. 3-1 Infringement Contentions served on Defendants, Cellspin currently asserts the following claims against Defendants (the "Asserted Claims"):

- '336 Patent: claims 1-5

- '757 Patent: claims 1-26
- '260 Patent: claims 1-18
- '030 Patent: claims 1-2, 4-7, 9-18
- '766 Patent: claims 1-15
- '121 Patent: claims 1-10
- '381 Patent: claims 1-16

With respect to each asserted claim and based on their investigation to date, Defendants hereby: (a) identify each prior art reference that anticipates each asserted claim or renders it obvious, (b) specify whether each such prior art reference anticipates each asserted claim or renders it obvious, and, if it renders it obvious, explain why the prior art renders the asserted claim obvious and identify any combinations of prior art showing obviousness; (c) submit a chart identifying where specifically in each prior art reference each limitation of each asserted claim is found, including, for each limitation that is governed by 35 U.S.C. § 112(6), identifies the structure(s), act(s), or material(s) in each prior art reference that performs the claimed function; and (d) identify the grounds of invalidity based indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims.

In addition, pursuant to L.R. 3-4, and based on their investigation to date, Defendants produce concurrently with these Invalidity Contentions documents within their possession, custody, and control required to accompany the Invalidity Contentions.

II. RESERVATIONS

Consistent with local rules, Defendants reserve the right to amend these Invalidity Contentions. The information and documents that Defendants produce are provisional and subject to further revision. Defendants expressly reserve the right to amend these disclosures and the

accompanying document production should Cellspin provide any information that it failed to provide in its L.R. 3-1 and 3-2 disclosures, or should Cellspin amend its L.R. 3-1 or 3-2 disclosures in any way. Further, as discovery is only beginning, Defendants reserve the right to revise, amend, and/or supplement the information provided herein, including identifying and relying on additional references, should Defendants' further search and analysis yield additional information or references, consistent with the Local Rules and the Federal Rules of Civil Procedure. Moreover, Defendants reserve the right to revise their ultimate contentions concerning the invalidity of the asserted claims, which may change depending upon the Court's construction of the asserted claims, any findings as to the priority or invention date of the asserted claims, and/or positions that Cellspin or its expert witness(es) may take concerning claim construction, infringement, and/or invalidity issues.

Prior art not included in this disclosure, whether known or unknown to Defendants, may become relevant. In particular, Defendants are currently unaware of the extent, if any, to which Cellspin will contend that limitations of the asserted claims are not disclosed in the prior art identified by Defendants, or will contend that any of the identified references do qualify as prior art. The identification of any patent or patent publication shall be deemed to include any counterpart patent or application filed, published, or issued anywhere in the world. To the extent that such issues arise, Defendants reserve the right to identify additional teachings in the same references or in other references that anticipate or would have made the addition of the allegedly missing limitation to the device or method obvious. In providing these contentions, Defendants have relied on the contents of the infringement contentions Cellspin served in connection with L.R. 3-1 and 3-2 as of March 11, 2024.

Defendants' claim charts in Exhibits A-01 to G-11 cite to particular teachings and disclosures of the prior art as applied to features of the asserted claims. However, persons having ordinary skill in the art may view an item of prior art generally in the context of other publications, literature, products, and understanding of those skilled in the art. Accordingly, the cited portions are only examples, and Defendants reserve the right to rely on uncited portions of the prior art references and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that a claim limitation is known or disclosed. Citations to figures are inclusive of all discussion of those figures. Defendants further reserve the right to rely on uncited portions of the prior art references, other publications, documents explicitly or implicitly incorporated by reference, and testimony to establish bases for combinations of certain cited references that render the asserted claims obvious. If a contention that a prior use, sale, offer for sale, or invention is invalidating prior art under 102(a), 102(b), or 102(g) relies upon documents set forth in these contentions, Defendants also contend that those documents anticipate or render obvious the asserted claims, whether alone or in combination with other references, even if not explicitly listed in this document. Further, for any combination, Defendants reserve the right to rely additionally on information generally known to those skilled in the art and/or common sense.

The references discussed herein and in the claim charts in Exhibits A-01 to G-11, or elsewhere identified, may disclose the elements of the asserted claims explicitly and/or inherently, and/or they may be relied upon to show the state of the art in the relevant timeframe. The suggested obviousness combinations are provided in the alternative to Defendants' anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not itself anticipatory. Furthermore, an explicit contention in the charts that a claim limitation would be

obvious to a person of ordinary skill in the art, alone or in combination with other references, should not be construed as a suggestion or concession that other limitations without such an explicit contention would not be obvious to a person of ordinary skill in the art, alone or in combination with other references.

Furthermore, nothing stated herein shall be treated as an admission or suggestion that Defendants agree with Cellspin regarding either the scope of any asserted claim or the claim constructions Cellspin advances in its Infringement Contentions or anywhere else. To the extent that Defendants' Invalidity Contentions reflect or suggest constructions of claim limitations consistent with or suggested by Cellspin's Infringement Contentions, no inference is intended nor should any be drawn that Defendants agree with Cellspin's claim constructions or Cellspin's views concerning the scope of the claims. To be clear, the charts below do not necessarily indicate all instances where claim elements are discussed based on Cellspin's apparent interpretation of the claims as evidenced by Cellspin's Infringement Contentions. However, the omission or addition of indications based on Cellspin's apparent interpretation is not to be construed as an admission as to the proper construction or scope of the claims. Defendants reserve the right to challenge Cellspin's current, future, apparent, implicit, or explicit construction of all claim terms.

In addition, nothing in these Invalidity Contentions shall be treated as an admission that Defendants' accused technologies meet any limitation of any asserted claim. Defendants deny that they infringe any claim of the patents-in-suit. To the extent that any prior art reference identified by Defendants contains a claim element that is the same as or similar to an element in an accused product, based on a claim construction inferred from Cellspin's Infringement Contentions, inclusion of that reference in Defendants' Invalidity Contentions shall not be deemed a waiver by Defendants of any claim construction or noninfringement position. Defendants expressly reserve

the right to contest any claim constructions asserted by Cellspin and expressly reserve all noninfringement arguments.

Depending on the Court's construction of the asserted claims of the patents-in-suit, and/or positions that Cellspin or its expert witness(es) may take concerning claim interpretation, infringement, and/or invalidity issues, different ones of the charted prior art references in Exhibits A-01 to G-11, or otherwise identified herein, may be of greater or lesser relevance and different combinations of these references may be implicated. Given this uncertainty, the charts may reflect alternative applications of the prior art against the asserted claims. Nothing stated herein shall be construed as an admission or a waiver of any particular construction of any claim term. Defendants also reserve all of their rights to challenge any of the claim terms herein under 35 U.S.C. § 112, including by arguing that they are indefinite, not supported by the written description, and/or not enabled. Accordingly, nothing stated herein shall be construed as a waiver of any argument available under 35 U.S.C. § 112. Defendants also reserve the right to challenge the patentability of any of the asserted claims under 35 U.S.C. § 101.

III. IDENTIFICATION OF PRIOR ART PURSUANT TO L.R. 3-3(A)

In addition to the disclosures provided below, Defendants attach separate charts detailing their invalidity contentions on a claim-by-claim basis. *See* Exs. A-01 to G-11. Moreover, Defendants hereby disclose and reserve the right to rely upon all references incorporated by reference into the references disclosed below and in the accompanying charts.¹ Further, Defendants reserve the right to rely on other references reflecting the state of the art and/or knowledge of a person of ordinary skill in the art.

¹ To the extent any of the cited references is found not to predate the patent-in-suit for which it is cited, it remains relevant, for example, to show the technological background and/or to secondary considerations of obviousness and/or obviousness based on simultaneous/contemporaneous invention by others.

A. The Segmenting Patents (U.S. Patent Nos. 8,756,336; 8,862,757; and 8,898,260)

1. Prior Art References

The following prior art patent references anticipate and/or render obvious the asserted claims of the Segmenting Patents.

	Patent No. / Application No.	Country of Origin	Date Issued / Published
1.	U.S. App. No. 2006/0129631A1 (“Na”)	US	06/15/2006
2.	JP 2006309595A (“Shigee”)	JP	11/09/2006
3.	U.S. App. No. 2002/0196125A1 (“Yu”)	US	12/26/2002
4.	U.S. Pat. No. 7,590,133B2 (“Hatae”)	US	09/15/2009
5.	U.S. App. No. 2007/0174393A1 (“Bosschaert”)	US	05/04/2010
6.	WO 2007082167A2 (“Dudas”)	US	07/19/2007
7.	U.S. App. No. 2005/0235019A1 (“Yang”)	US	10/20/2005
8.	U.S. App. No. 2005/0187959A1 (“Jung”)	US	08/25/2005
9.	U.S. App. No. 2008/0320075A1 (“Livshits”)	US	04/26/2011
10.	U.S. Pat. No. 8,464,066B1 (“Price”)	US	06/11/2013
11.	U.S. App. No. 2008/0172392A1 (“Crichton”)	US	07/17/2008
12.	U.S. Pat. No. 8,385,950 (“Wagner”)	US	02/26/2013
13.	U.S. App. No. 2004/0249905 (“Wilcock”)	US	12/09/2004
14.	U.S. App. No. 2003/0163580 (“Lee”)	US	08/28/2003
15.	U.S. App. No. 2009/0111375A1 (“Burns”)	US	04/30/2009
16.	KR Pub. No. 20040022364A (“Lee ’364”)	KR	03/12/2004
17.	U.S. App. No. 2004/0192312A1 (“Li”)	US	09/30/2004
18.	JP 2005/303511A (“Takahashi”)	JP	10/27/2005
19.	WO 2008/028508 A1 (“Drescher”)	GB	03/13/2008
20.	U.S. App. No. 2005/0209927A1 (“Aaltonen”)	US	09/22/2005
21.	WO 2005/109781A1 (“WO Lind”)	EP	11/17/2005
22.	U.S. Pat. No. 8,364,963 (“Lind”)	US	01/29/2013
23.	U.S. Pat. Pub. No. 2002/0184318 A1 (“Pineau 2002”)	US	12/05/2002
24.	U.S. Pat. No. 7,206,806 (“Pineau”)	US	04/17/2007

2. Prior Art Publications

The following prior art publications anticipate and/or render obvious the asserted claims of the Segmenting Patents.

	Title	Date of Publication	Author or Publisher
1.	A mobile phone-based context-aware video management application	2006	Lahti

	Title	Date of Publication	Author or Publisher
2.	A Session-Based Architecture for Internet Mobility	2002	Snoeren
3.	Architectural Considerations for a New Generation of Protocols	1990	Clark
4.	HTTP: The Definitive Guide	2002	Gourley
5.	RFC 2046, Multipurpose Internet Mail Extensions (MIME) Part Two: Media Types	1996	Freed
6.	RFC draft-ietf-httpbis-p5-range-00, HTTP/1.1, part 5: Range Requests and Partial Responses	2008 or earlier	Fielding
7.	RFC draft-ietf-httpbis-p5-range-01, HTTP/1.1, part 5: Range Requests and Partial Responses	2012 or earlier	Fielding
8.	RFC 959, File Transfer Protocol (FTP)	1985	Postel
9.	RFC 2616, Hypertext Transfer Protocol – HTTP/1.1	1999	Fielding
10.	RFC 3659, Extensions to FTP	2007	Hethmon
11.	RFC 791, Internet Protocol – DARPA Internet Program Protocol Specification	1981	Information Sciences Institute

3. **Prior Art Devices and/or 102(g) Prior Art**

The following devices or inventions were known, publicly used, sold, or offered for sale prior to the Segmenting Patents and thus anticipate and/or render obvious each asserted claim.

	Device/System	Date of Availability	Seller or Manufacturer
1.	Facebook	2006 or earlier	Facebook
2.	Google Drive	2012	Google
3.	ShoZu	2007 or earlier	ShoZu
4.	Bulletin Board System/ZMODEM	1986	Various
5.	Dropbox	2009 or earlier	Dropbox
6.	Twitch	2011	Twitch
7.	Flickr	2004	Flickr

4. Other References

All documents cited on the face of the Asserted Patents and related patents, patent publications, file histories and applications, and all other documents cited herein and otherwise produced pursuant to L.R. 3-4.

B. The Publishing Patents (U.S. Patent Nos. 8,904,030; 9,900,766; 11,234,121; 11,659,381)

1. Prior Art References

The following prior art patent references anticipate and/or render obvious the asserted claims of the Publishing Patents.

	Patent No. / Application No.	Country of Origin	Date Issued / Published
1.	JP 2003-60953 (“Hiroishi”)	JP	02/28/2003
2.	JP 2003-51772 (“Mashita”)	JP	02/21/2003
3.	JP 2003-299014 (“Onishi”)	JP	10/17/2003
4.	JP 2005-303511 (“Takahashi”)	JP	10/27/2005
5.	JP 2003-46841A (“Ando”)	JP	02/13/2003
6.	JP 2004-96166 (“Nozaki”)	JP	03/25/2004
7.	JP 2004-102810 (“Hiraishi”)	JP	04/02/2004
8.	U.S. Pat. No. 8,385,950 (“Wagner”)	US	02/26/2013
9.	U.S. Pat. No. 7,382,405 (“Kusaka”)	US	06/03/2008
10.	U.S. Pat. No. 6,957,040 (“Tanaka”)	US	10/18/2005
11.	U.S. Pat. No. 8,162,804 (“Tagliabue”)	US	08/21/2008
12.	U.S. Pat. No. 6,763,247 (“Hollstrom”)	US	07/13/2004
13.	U.S. Pat. No. 7,607,243 (“Berner Jr.”)	US	10/27/2009
14.	U.S. Pat. No. 8,774,072 (“Morris”)	US	07/08/2014
15.	U.S. App. No. 2004/0004737 (“Kahn”)	US	01/08/2004
16.	U.S. App. No. 2004/0109063 (“Kusaka 2004”)	US	06/10/2004
17.	U.S. App. No. 2005/0001924A1 (“Honda”)	US	01/06/2005
18.	U.S. App. No. 2009/0172129 (“Singh129”)	US	07/02/2009
19.	U.S. App. No. 2008/0103906 (“Singh906”)	US	05/01/2008
20.	U.S. App. No. 2008/0085682 (“Rao”)	US	04/10/2008
21.	U.S. App. No. 2007/0276270 (“Tran”)	US	11/29/2007
23.	U.S. App. No. 2002/0012048 (“Yamagishi”)	US	01/31/2002
24.	U.S. App. No. 2006/0271977 (“Lerman”)	US	11/30/2006
25.	U.S. App. No. 2006/0189348 (“Montulli”)	US	08/24/2006

	Patent No. / Application No.	Country of Origin	Date Issued / Published
26.	U.S. App. No. 2003/0103144 (“Sesek”)	US	06/05/2003
27.	U.S. App. No. 2008/0052348 (“Adler”)	US	02/28/2008
28.	U.S. App. No. 2008/0032627 (“Kang”)	US	02/07/2008
29.	U.S. App. No. 2004/005915A1 (“Hunter”)	US	01/08/2004
30.	U.S. App. No. 2006/0139474 (“Endsley”)	US	06/29/2006
31.	U.S. App. No. 2007/0226778 (“Pietruska”)	US	09/27/2007
32.	KR10-2005-0014972 (“Yoo”)	KR	02/21/2005
33.	WO 2005/109781 (“WO Lind”)	EP	11/17/2005
34.	U.S. Pat. No. 8,364,963 (“Lind”)	US	01/29/2013
35.	U.S. Pub. No. 2007/0199076A1 (“Rensin 2007”)	US	08/23/2007
36.	U.S. Pat. No. 7,860,994 (“Rensin”)	US	12/28/2010
37.	U.S. Pub. No. 2004/0221044A1 (“Rosenbloom 2004”)	US	11/04/2004
38.	U.S. Pat. No. 7,673,020 (“Rosenbloom”)	US	03/02/2010
39.	U.S. Pub. No. 2007/0229678A1 (“Barrus”)	US	10/04/2007
40.	U.S. Pub. No. 2007/0198632A1 (“Peart”)	US	08/23/2007
41.	U.S. Pub. No. 2002/0046084A1 (“Steele”)	US	04/18/2002
42.	U.S. Prov. App. No. 60/967063 (“Johnson”)	US	08/31/2007
43.	WO 2007/048124A2 (“Mears”)	US	04/26/2007
44.	U.S. Pub. No. 2008/0013601A1 (“Lind 2008”)	US	01/17/2008
45.	U.S. Pat. No. 5,806,005 (“Hull”)	US	09/08/1998
46.	U.S. Pub. No. 2003/0030839A1 (“Walters”)	US	02/13/2003
47.	JP 2002-009879A (“Tsukamoto”)	JP	01/11/2002
48.	U.S. Pub. No. 2007/0198632A1 (“Peart”)	US	08/23/2007
49.	U.S. Pub. No. 2006/0098900A1 (“King”)	US	05/11/2006
50.	WO 2004/112379A1 (“Park”)	KR	12/23/2004
51.	U.S. Pub. No. 2006/0050155A1 (“Ing”)	US	03/09/2006
52.	U.S. Pub. No. 2007/0238411A1 (“House”)	US	10/11/2007
53.	U.S. Pub. No. 2008/0165982 (“Hankey”)	US	07/10/2008
54.	U.S. Pub. No. 2008/0320190 (“Lydon”)	US	12/25/2008
55.	U.S. Pub. No. 2008/0220746 (“Ekberg”)	US	09/11/2008
56.	JP 2006-140890A (“Yoichi”)	JP	06/01/2006
57.	U.S. Pub. No. 2008/0201451A1 (“Yu”)	US	08/21/2008
58.	U.S. Pat. No. 10,567,909B2 (“Singh”)	US	02/18/2020
59.	U.S. Pat. No. 8,305,422B2 (“Toya”)	US	11/06/2012
60.	U.S. Pat. No. 7,650,110 (Kawamura)	US	01/19/2010

2. Prior Art Publications

The following prior art publications anticipate and/or render obvious the asserted claims of the Publishing Patents.

	Title	Date of Publication	Author or Publisher
1.	Bluetooth Specifications	1999-2007	Bluetooth
2.	Bluetooth Profiles	1999-2007	Bluetooth
3.	Bluetooth System Specification, version 1.0 B (“BT v1.0”)	1999	Bluetooth
4.	Bluetooth System Specification, version 2.1 + EDR (“BT v2.1”)	2007	Bluetooth
5.	Wibree Articles	2006	Wibree
6.	Wireless Application Protocol, Wireless Application Specifications, available at http://www.wapforum.org/what/technical.htm	1997	WAP Forum
7.	Portable Network Graphics Specifications	October 1996	PNG Development Group
8.	Windows Bitmap Specifications	1985	Microsoft
9.	JPEG2000 specifications ISO/IEC 15444 Specifications	2003	Joint Photographic Experts Group
10.	“ANT AN02 – Device Pairing” (“AN02”)	January 2006	Dynastream Innovations Inc.
11.	ANT Materials	2006-2007	ANT
12.	Gizmodo’s Long-Ass Nokia N95 Review: Why It Rocks, Why it Sucks, available at https://gizmodo.com/gizmodos-long-ass-nokia-n95-review-why-it-rocks-why-i-250902 (“N95 Review”)	April 2007	Gizmodo
13.	Nokia Mobile Dominance Increases, available at https://www.techradar.com/news/phone-and-communications/mobile-phones/nokia-mobile-dominance-increases-155064 (“Nokia Mobile”)	May 2007	Tech Radar
14.	“‘Mosh’ Mobile Social Networking from Nokia,” available at https://news.softpedia.com/news/Mosh-Mobile-Social-Networking-from-Nokia-62442.shtml (“Softpedia Mosh”)	August 2007	Softpedia
15.	“Nokia’s Mosh Marries Mobile with Social Networking,” available at https://www.reuters.com/article/us-mobile-networking/nokia-smosh-marries-mobile-with-social-networking-idUSL0539896020071024 (“Reuters Mosh”)“	October 2007	Reuters

	Title	Date of Publication	Author or Publisher
16.	http://mosh.nokia.com/ , available at https://web.archive.org/web/20070829101717/http://mosh.nokia.com ("Nokia Mosh")	August 2007	Nokia
17.	Mobic.com, "Ericsson Unveils the First Bluetooth Phone," available at http://www.mobic.com/oldnews/2000/06/ericsson_unveils_the_first_bluet.htm ("T36")	2000	Mobic
18.	TR-007 Bluetooth Audio Technical Reference	2005-2006	Mobile Computing Promotion Consortium
19.	Basic Image Profile Interoperability Specification 1.0	July 2003	Bluetooth SIG
20.	Digital Camera Connectivity Solutions Using the PTP	August 2002	Bigioi, et. al.
21.	Sony DSC-F77 / DSC-FX77 Specification, available at https://www.dpreview.com/articles/8424984568/sonyds_cf77	September 2002	Digital Photography Review
22.	TS 101 369 (GSM 07.10) version 6.3.0: Digital cellular telecommunications system (Phase 2+) (GSM); Terminal Equipment to Mobile Station (TE-MS) multiplexer protocol	1999	European Telecommunications Standards Institute
23.	IrOBEX Specification, Version 1.2, Infrared Data Association	March 1999	Megowan, et. al.
24.	Extensible Markup Language (XML) 1.0 (Second Edition) W3C Recommendation	October 2000	
25.	ISO/IEC 10918-1 (JPEG) International Standard – Information Technology – Digital Compression and Coding of Continuous-tone Still Images: Requirements and Guidelines		International Organization for Standardization
26.	JEIDA Standard Digital Still Camera Image File Format Standard, Version 2.1	December 1998	Japan Electronic Industry Development Association
27.	Graphics Interchange Format, Version 89a	July 1990	CompuServe Inc.

3. Prior Art Devices and/or 102(g) Prior Art

The following devices or inventions were known, publicly used, sold, or offered for sale prior to the Publishing Patents and thus anticipate and/or render obvious each asserted claim.

	Device/System	Date of Availability	Seller or Manufacturer
1.	Bluetooth	1999	Bluetooth
2.	Wibree	2007	Wibree
3.	ANT	2006	Dynastream, Garmin
4.	Wireless Application Protocol	1997	WAP Forum
5.	Z-Wave	2007	Zensys
6.	Sony Cybershot Cameras, including, e.g., DSC-F77 / DSC-FX77	2002	Sony
7.	Forerunner 50, 101, 201, 205, 301, 305, and 401, plus accessories (e.g., Heart Rate Monitor, Cadence Sensor, Foot Pod, ANT stick), ANT and ANT+, and websites (Motion Based and Garmin Connect) (“Forerunner”)	2007 and earlier	Garmin
8.	Edge 205, 305, 500, 605, and 705 plus accessories (e.g., Heart Rate Monitor, Cadence Sensor, Foot Pod, ANT stick), ANT and ANT+, and websites (Motion Based and Garmin Connect) (“Edge”)	2006 and earlier	Garmin
9.	Ericsson T36 (“T36”)	2000	Ericsson
10.	MOSH – Mobile and Share (“Mosh”)	2007	Nokia
11.	N95	2006	Nokia

4. Other References

All documents cited on the face of the Asserted Patents and related patents, patent publications, file histories and applications, and all other documents cited herein and otherwise produced pursuant to L.R. 3-4. Defendants specifically identify the prior art cited in

IV. INVALIDITY GROUNDS PURSUANT TO L.R. 3-3(B)

As stated above, Defendants incorporate by reference all other invalidity contentions related to the Asserted Patents served on or otherwise provided to Plaintiff, whether past or future.

In accordance with P.R. 3-3(a), prior art references anticipating the Asserted Claims are provided below. The prior art listed below anticipates the Asserted Claims under the proper construction of the claims and/or under Plaintiff's apparent interpretation of the claims reflected by Plaintiff's Complaint and Infringement Contentions.

A. Segmenting Patents

The Asserted Claims of the Segmenting Patents are anticipated and/or rendered obvious by prior art. Pursuant to P.R. 3-3(a), Defendants identify the prior art references that anticipate or render obvious the Segmenting Patents Asserted Claims in the claim charts of Exhibits A-01 through C-34 (collectively the "Segmenting Patent Charts") which are hereby incorporated by reference as if fully set forth herein. The Segmenting Patent Charts show how these prior art references teach or suggest each and every element of the Segmenting Patent Asserted Claims. For each reference or combination of references suggested by each chart and/or herein, Defendants indicate whether the prior art renders the claim anticipated and/or obvious pursuant to P.R. 3-3(b).

In addition to contending that the Segmenting Patents Asserted Claims are invalid in view of the prior art references cited in the Segmenting Patent Charts, Defendants further contend that the Segmenting Patents Asserted Claims are invalid as anticipated and/or obvious under U.S.C. §§ 102(a), 102(b), and/or 103 in view of public knowledge and uses and/or offers for sale of products and services related to the subject matter of the cited references. As discovery is ongoing, Defendants continue to investigate these items and to reserve the right to amend or supplement these contentions to include additional information or documents regarding such products and/or systems. In addition to contending that the '336 Patent Asserted Claims are invalid in view of the explicit disclosures of the prior art references cited in Segmenting Patent Charts, Defendants further contend that the knowledge of skill evidenced by those references render those claims invalid. Defendants further contend that, even if a prior art reference does not expressly disclose

all limitations as arranged or combined in the same manner as an asserted claim, a skilled artisan reading the reference would at once envisage the claimed arrangement or combination. *See, e.g., Kennametal Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376 (Fed. Cir. 2015).

Defendants' reference to a particular file transfer system, content publisher, software program, device, or product in Segmenting Patent Charts should be interpreted alternatively as both as a reference to the product itself and to any corresponding patents, publications, or product literature cited herein, including the Segmenting Patent Charts, that relate to the cited file transfer system, content publisher, software program, device, or product. In addition, Defendants may rely on other documents or things that have not yet been located to support its contentions regarding such prior art file transfer system(s), content publisher(s), software program(s), device(s) or product(s) that are referenced in the charts.

Defendants incorporate by reference, as if set forth fully herein, all prior art cited during the prosecution of the Segmenting Patents, all prior art cited during reexamination proceedings of the Segmenting Patents, all prior art as described in any future *inter partes* review proceedings of the Segmenting Patents, and all prior art disclosed during previous litigation proceedings. *See, e.g., TikTok Inc. v. Cellspin Soft, Inc.*, No. IPR2024-00757 (P.T.A.B. Apr. 01, 2024); *TikTok Inc. v. Cellspin Soft, Inc.*, No. IPR2024-00759 (P.T.A.B. Apr. 01, 2024); *TikTok Inc. v. Cellspin Soft, Inc.*, No. IPR2024-00760 (P.T.A.B. Apr. 01, 2024).

Defendants further identify and hereby incorporate by reference as if set forth fully herein the prior art references and invalidity contentions as described in any other Cellspin proceedings wherein invalidity contentions have been, or will be, provided regarding the Segmenting Patents, its foreign counterparts, or any parent or child patent of the Segmenting Patents. Defendants reserve the right to use any and all portions of the publication, related publications, commercial

embodiments of the publication, and other evidence that is discovered in these lawsuits to demonstrate and/or evidence the components, functionality, and capabilities of the devices and systems disclosed in the references charted.

Where Defendants identify a particular figure in a prior art reference, the identification should be understood to encompass the caption and description of the figure, as well as any text relating to the figure in addition to the figure itself. Similarly, where an identified portion of text refers to a figure, embodiment, or other material, the identification should be understood to include the referenced figure, embodiment, or other material as well. Consistent with P.R. 3-3(c), Defendants' citations to specific statements, figures, or disclosures in a prior art reference are sufficient to put Plaintiff on notice where each element of each asserted claim is found in the prior art. However, it should be recognized that a person of ordinary skill in the art would generally read a prior art reference as a whole and in the context of other publications, literature, and general knowledge in the field. To understand and interpret any specific statement or disclosure in a prior art reference, a person of ordinary skill in the art would rely upon other information including other publications and general scientific or engineering knowledge. Defendants therefore reserve the right to rely upon other unidentified portions of the prior art references and on other publications and expert testimony to provide context and to aid understanding and interpretation of the identified portions.

Defendants also reserve the right to rely upon other portions of the prior art references, other publications, and the testimony of experts to establish that the alleged inventions would have been obvious to a person of ordinary skill in the art, including the basis of modifying or combining certain cited references. To the extent any limitation is deemed not to be exactly met by an item of prior art, then any purported differences are such that the claimed subject matter as a whole

would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. To the extent that an element of an Asserted Claim is not anticipated, the claim is rendered obvious by combination with one or more other prior art references identified in the Segmenting Patent Charts.

B. Publishing Patents

The Asserted Claims of the Publishing Patents are anticipated and/or rendered obvious by prior art. Pursuant to P.R. 3-3(a), Defendants identify the prior art references that anticipate or render obvious the Publishing Patent Asserted Claims in the claim charts of Exhibits D-01 through G-11 (collectively the “Publishing Patent Charts”) which are hereby incorporated by reference as if fully set forth herein. The Publishing Patent Charts show how these prior art references teach or suggest each and every element of the Publishing Patent Asserted Claims. For each reference or combination of references suggested by each chart and/or herein, Defendants indicate whether the prior art renders the claim anticipated and/or obvious pursuant to P.R. 3-3(b).

In addition to contending that the Publishing Patent Asserted Claims are invalid in view of the prior art references cited in the Publishing Patent Charts, Defendants further contend that the Publishing Patent Asserted Claims are invalid as anticipated and/or obvious under U.S.C. §§ 102(a), 102(b), and/or 103 in view of public knowledge and uses and/or offers for sale of products and services related to the subject matter of the cited references. As discovery is ongoing, Defendants continue to investigate these items and to reserve the right to amend or supplement these contentions to include additional information or documents regarding such products and/or systems. In addition to contending that the Publishing Patent Asserted Claims are invalid in view of the explicit disclosures of the prior art references cited in the claim charts of Publishing Patent Charts, Defendants further contend that the knowledge of skill evidenced by those references render those claims invalid. Defendants further contend that, even if a prior art reference does not

expressly disclose all limitations as arranged or combined in the same manner as an asserted claim, a skilled artisan reading the reference would at once envisage the claimed arrangement or combination. *See, e.g., Kennametal Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376 (Fed. Cir. 2015).

Defendants' reference to a software program, standard, device, file transfer system, content publisher, or product herein, including the claim charts of Publishing Patent Charts, should be interpreted alternatively as both as a reference to the product itself and to any corresponding patents, publications, or product literature cited in Publishing Patent Charts that relates to the cited software program, standard/specification, device, or product. In addition, Defendants may rely on other documents or things that have not yet been located to support its contentions regarding such prior art software program(s), device(s), standard(s), file transfer system(s), content publisher(s), or product(s) that are referenced in the charts.

Defendants incorporate by reference, as if set forth fully herein, all prior art cited during the prosecution of the Publishing Patents, all prior art cited during reexamination proceedings of the Publishing Patents, all prior art as described in any future *inter partes* review proceedings of the Publishing Patent, and all prior art disclosed during previous litigation proceedings. *See, e.g., TikTok Inc. v. Cellspin Soft, Inc.*, No. IPR2024-00767 (P.T.A.B. Apr. 5, 2024); *TikTok Inc. v. CellSpin Soft, Inc.*, No. IPR2024-00768 (P.T.A.B. Apr. 5, 2024); *TikTok Inc. v. Singh*, No. IPR2024-00769 (P.T.A.B. Apr. 5, 2024); *TikTok Inc. v. Cellspin Soft, Inc.*, No. IPR2024-00770 (P.T.A.B. Apr. 5, 2024); *GoPro, Inc. et al v. Cellspin Soft, Inc.*, No. IPR2019-01107 (P.T.A.B. May. 28, 2019); *GoPro, Inc. et al v. Cellspin Soft, Inc.*, No. IPR2019-01108 (P.T.A.B. May. 24, 2019); *Canon USA, Inc. et al v. Cellspin Soft, Inc.*, No. IPR2019-00127 (P.T.A.B. Oct. 30, 2018); *Panasonic Corporation*

Defendants further identify and hereby incorporate by reference as if set forth fully herein the prior art references and invalidity contentions as described in any other Cellspin proceedings wherein invalidity contentions have been, or will be, provided regarding the Publishing Patents, its foreign counterparts, or any parent or child patent of the Publishing Patents. Defendants reserve the right to use any and all portions of the publication, related publications, commercial embodiments of the publication, and other evidence that is discovered in these lawsuits to demonstrate and/or evidence the components, functionality, and capabilities of the devices and systems disclosed in the references charted.

Where Defendants identify a particular figure in a prior art reference, the identification should be understood to encompass the caption and description of the figure, as well as any text relating to the figure in addition to the figure itself. Similarly, where an identified portion of text refers to a figure, embodiment, or other material, the identification should be understood to include the referenced figure, embodiment, or other material as well. Consistent with P.R. 3-3(c), Defendants' citations to specific statements, figures, or disclosures in a prior art reference are sufficient to put Plaintiff on notice where each element of each asserted claim is found in the prior art. However, it should be recognized that a person of ordinary skill in the art would generally read a prior art reference as a whole and in the context of other publications, literature, and general knowledge in the field. To understand and interpret any specific statement or disclosure in a prior art reference, a person of ordinary skill in the art would rely upon other information including other publications and general scientific or engineering knowledge. Defendants therefore reserve the right to rely upon other unidentified portions of the prior art references and on other publications and expert testimony to provide context and to aid understanding and interpretation of the identified portions.

Defendants also reserve the right to rely upon other portions of the prior art references, other publications, and the testimony of experts to establish that the alleged inventions would have been obvious to a person of ordinary skill in the art, including the basis of modifying or combining certain cited references. To the extent any limitation is deemed not to be exactly met by an item of prior art, then any purported differences are such that the claimed subject matter as a whole would have been obvious to one skilled in the art at the time of the alleged invention, in view of the state of the art and knowledge of those skilled in the art. To the extent that an element of an Asserted Claim is not anticipated, the claim is rendered obvious by combination with one or more other prior art references identified in the Publishing Patent Charts.

C. Obviousness

1. Segmenting Patents

Pursuant to P.R. 3-3(a) and (b), Defendants identify in the Segmenting Patent Charts the prior art references that render obvious the Asserted Claims of the Segmenting Patents and include below exemplary combinations showing the obviousness of the Segmenting Patents Asserted Claims in view of the prior art. To the extent Plaintiff contends that an element is not disclosed in any one of the anticipatory references described in the Segmenting Patent Charts , the limitation would have been obvious in light of the disclosures within the reference and the knowledge of one of ordinary skill in the art at the time of the Segmenting Patents. Moreover, to the extent Plaintiff contends that an element is not disclosed in any one of the anticipatory references described in the Segmenting Patent Charts , such reference may be combined with any other references listed in the Segmenting Patent Charts for such element, thereby rendering the claims invalid for obviousness. To the extent a finder of fact determines that a limitation of any of the Segmenting Patents Asserted Claims is not disclosed by one of the references identified above pursuant to P.R. 3-3(a), the claim is nevertheless unpatentable as obvious because they contain nothing that

constitutes a patentable innovation. To the extent a finder of fact determines that a limitation of the Segmenting Patents Asserted Claims is not anticipated, it does not go beyond combining familiar elements according to known methods to achieve predictable results or does more than choose between clear alternatives known to those of ordinary skill in the art.

(a) **Obviousness Rationale and Motivations to Combine**

Obviousness: For at least the reasons described in these contentions, it would have been obvious to one of ordinary skill in the art to combine any of a number of prior art references, including any combination of those prior art references identified in these contentions along with the knowledge of one of ordinary skill in the art to meet the limitations of the Segmenting Patents Asserted Claims. As a result, the references identified herein render one or more Asserted Claims of the Segmenting Patents obvious when the references are read in combination with each other, and/or when read in view of the state of the art and knowledge of those skilled in the art. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined with one another to render obvious (and therefore invalid) each of Cellspin's Asserted Claims. Defendants may rely upon a subset of the identified references or all of the references identified herein, including all references in Segmenting Patent Charts, for purposes of obviousness depending on the Court's claim construction, positions taken by Cellspin during this litigation, and further investigation and discovery.

No More Than Ordinary Variations of Prior Art; No Unexpected Results: To the extent not anticipated, the Segmenting Patents Asserted Claims represent no more than the result of ordinary variations of the prior art. Defendants further believe that no showing of a specific motivation to combine prior art is required to combine the references disclosed above and in the attached charts, as each combination of art would have no unexpected results, and at most would

simply represent a known alternative to one of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415-16 (2007) (rejecting the Federal Circuit's "rigid" application of the teaching, suggestion, or motivation to combine test, instead espousing an "expansive and flexible" approach); *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1058 (Fed. Cir. 2016); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1344 (Fed. Cir. 2017). Indeed, the Supreme Court held that a person of ordinary skill in the art is "a person of ordinary creativity, not an automaton" and "in many cases a person of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420-21. Nevertheless, in addition to the information contained elsewhere in these contentions, Defendants identify motivation and reason to combine the cited art.

Predictable Results; Obvious to Try: One or more combinations of the prior art references identified in these contentions would have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art references identified above because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. Further, the combinations of the prior art references identified in these contentions would have been obvious because the combinations represent known potential options with a reasonable expectation of success.

Interrelated Teachings: Additional evidence that there would have been a motivation to combine the prior art references identified above includes the interrelated teachings of multiple

prior art references; common authorship; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the Segmenting Patents Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art.

Summary of Motivations to Combine: Thus, the motivation to combine the teachings of the prior art references disclosed in these contentions is found in the references themselves and also in: (1) the nature of the problem being solved; (2) the express, implied and inherent teachings of the prior art; (3) the knowledge of persons of ordinary skill in the art; (4) the predictable results obtained in combining the different elements of the prior art; (5) the predictable results obtained in simple substitution of one known element for another; (6) the use of a known technique to improve similar devices, methods, or products in the same way; (7) the predictable results obtained in applying a known technique to a known device, method, or product ready for improvement; (8) the finite number of identified predictable solutions that had a reasonable expectation of success; and (9) known work in various technological fields that could be applied to the same or different technological fields based on design incentives or other market forces.

Same Area of Technology: Additionally, it would be obvious to one of ordinary skill in the art to consult and/or combine any of the prior art identified above (Section III.A), including those charted in the Segmenting Patent Charts, because all of these references relate to the same area of technology and/or are from analogous art. The Segmenting Patents Asserted Claims are directed to data transfer and data resumption using a segmented data transfer protocol. *See, e.g., '336 Patent at Abstract; 2:39-44.* The Segmenting Patents Asserted Claims merely unite old elements, well known in the field, with no change in their respective function or result. Given the

interrelated teachings of the prior art, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, it would have been obvious for one of ordinary skill in the art to combine these familiar elements, disclosed and/or embodied in the prior art listed above to practice the Segmenting Patents Asserted Claims.

Same Technical Issues: A person of ordinary skill would have been motivated to combine the above prior art based on his/her knowledge, the nature of the problem to be solved, and the teachings of the prior art. The identified prior art addresses the same or similar technical issues and suggests the same or similar solutions to those issues. Moreover, some of the prior art refer to or discuss other prior art, illustrating the close technical relationship among the prior art. For the Segmenting Patents, one of ordinary skill in the art would have been motivated to combine known prior art solutions described in these references relating to segmented data transfer and data resumption techniques and systems and known features related thereto.

Demand and Market Forces: For example, market forces suggested a demand for efficient techniques for encoding and decoding media, and thus one of skill in the art would have thought to combine or modify references that described known methods that one of skill in the art would have recognized as offering improvements to solutions of that time.

Known Elements; Obvious to Try: Moreover, many of the claim elements were already known as admitted by the applicants in the patent specification. These elements represented design choices available to a person of ordinary skill. When there is a design need or market pressure to solve a problem, such as identified previously and/or described in the Segmenting Patents, and there are a finite number of identified, predictable solutions, a person of ordinary skill would be motivated to combine the known options that are within his or her technical grasp. For the

Segmenting Patents, there are a finite number of approaches for transferring data using a segmented data transfer protocol. For example, as of the priority date of the Segmenting Patents, a POSITA would have been very familiar with basic elements of the Segmenting Patents' claims such as determining the size of data, dividing or chunking data, applying identifiers to data segments or chunks, transferring data, data resumption, etc. Such elements were within the knowledge of a POSITA, whether or not disclosed in any particular reference, and the inclusion of such elements in the Segmenting Patents' claims does not render them novel or non-obvious.

In addition to the specific examples provided above, Defendants reserve the right to rely on the disclosures of the references listed in these contentions for additional motivation to combine. These examples of combinations are given merely to illustrate various motivations to combine and are not intended to provide an exhaustive list of every possible combination to which the motivation may apply. Defendants reserve the right to contend that the motivations to combine provided herein apply to other combinations at the appropriate time, e.g., in expert reports regarding invalidity. To the extent one or more of identified combinations is posed as a combination of only two references, it does not indicate that the two references that are being combined for one purpose could not be joined by a third reference (or more additional references) whose combination serves the same or a different purpose. Indeed, many of the features recited in the asserted claims are componentized features/functions whereby the feature could be implemented using teachings from another source while not interfering with additional features. For that reason, a POSITA may have reasonably looked to and been motivated to combine three or more references in order to achieve a specific outcome.

(b) Combinations

- (i) Segmented Data Transfer References Combined with Data Resumption References: Hatae, Na, Price, Bosschaert, Yu, Dudas, Li, Wagner, Crichton, Wilcock, Burns Lee,

Aaltonen, Takahashi, Drescher in combination with Yang,
Jung, Snoeren, and Shigee.

A POSITA would have had reason to combine Hatae, Na, Price, Bosschaert, Yu, Dudas, Li, Wagner, Crichton, Wilcock, Burns Lee, Aaltonen, Takahashi, Drescher with any one of Yang, Jung, Snoeren, and Shigee all of which relate to systems and methods for transferring multimedia content or data. Each of Hatae, Na, Price, Bosschaert, Yu, Dudas, Li, Wagner, Crichton, Wilcock, Burns Lee, Aaltonen, Takahashi, Drescher concern to transferring data using a certain segmented data transfer protocol. Indeed, such processes were conventional as of the time these references were known. Each of Hatae, Na, Price, Bosschaert, Yu, Dudas, Li, Wagner, Crichton, Wilcock, Burns Lee, Aaltonen, Takahashi, Drescher provide means—not necessarily expressly present in all other references—for determining the size, dividing or chunking data, applying identifiers, and transferring segmented data. A POSITA would have understood that the systems and methods for transferring data using a segmented file transfer protocol (such as those taught in Hatae, Na, Price, Bosschaert, Yu, Dudas, Li, Wagner, Crichton, Wilcock, Burns Lee, Aaltonen, Takahashi, Drescher) were intended to be used in conjunction with publishing data to a platform, such as web service. A POSITA would understand that systems and methods for applying different data resumption methods in response to data transfer errors provide an improvement that can be used to improve the continuity and automation of segmented data transfer, and that improvements to that aspect of the process could be used in numerous segmented data transfer protocols that perform the common steps of capturing, segmenting, and transferring data. A POSITA would further understand that in order to implement a robust segmented data transfer protocol, the systems and methods for applying different data resumption methods would commonly be combined with other traditional data transfer steps such as, but not limited to, client-server communication and data segment identification. Given that Yang, Jung, Snoeren, and Shigee are

used for resuming the data transfer after an interruption or error during the upload process, a POSITA would have been motivated to combine the teachings of these references. The combination would apply known techniques to apply data resumption methods, to systems using a segmented data transfer protocol that were ready for improvement, in order to yield predictable results. The combination would further be “obvious to try,” because it would involve simple design choices from a finite number of identified, predictable solutions, with a reasonable expectation of success.

(ii) Prior Art References in combination with User Identifier References

A POSITA would have had reason to combine the cited prior art references with any one of Burns, Na, Lee, Takahashi, and Wagner. A person of ordinary skill in the art would have been motivated to combine these references with any of the references included in Defendants’ Invalidity Contentions because it was well known to detect the existence of new data. Any of these combinations would thus have rendered at least these elements obvious.

For example, each of Burns, Na, Lee, Takahashi, and Wagner concern capturing and uploading data to a web service by transferring data with a user identifier applied to the data and/or segments of the data. Indeed, such processes were conventional as of the time these references were known. Each of the User Identifier References provide means—not necessarily expressly present in all other references—for applying a user identifier to each segment of data. A POSITA would understand that systems and methods for transferring segmented data online can be improved by means of applying a user identifier to each data segment. A POSITA would further understand that in order to transfer data to a web service, systems and methods for applying user identifiers to the data segments can be combined with known segmented data transfer protocols. A POSITA would have been motivated to combine the teachings of these references.

2. Publishing Patents

Pursuant to P.R. 3-3(a) and (b), Defendants identify in Section III.B the prior art references that render obvious the Asserted Claims of the Publishing Patents and include below exemplary combinations showing the obviousness of the Publishing Patents Asserted Claims in view of the prior art. To the extent Plaintiff contends that an element is not disclosed in any one of the anticipatory references described in these contentions, including the Publishing Patent Charts, the limitation would have been obvious in light of the disclosures within the reference and the knowledge of one of ordinary skill in the art at the time of the Publishing Patents. Moreover, to the extent Plaintiff contends that an element is not disclosed in any one of the anticipatory references described in these contentions, such reference may be combined with any other references listed above (Section III.B) for such element, thereby rendering the claims invalid for obviousness. To the extent a finder of fact determines that a limitation of any of the Publishing Patents Asserted Claims is not disclosed by one of the references identified above pursuant to P.R. 3-3(a), the claim is nevertheless unpatentable as obvious because they contain nothing that constitutes a patentable innovation. To the extent a finder of fact determines that a limitation of the Publishing Patents Asserted Claims is not anticipated, it does not go beyond combining familiar elements according to known methods to achieve predictable results or does more than choose between clear alternatives known to those of ordinary skill in the art.

(a) Obviousness Rationale and Motivations to Combine

Obviousness: For at least the reasons described in these contentions, it would have been obvious to one of ordinary skill in the art to combine any of a number of prior art references, including any combination of those prior art references identified in these contentions along with the knowledge of one of ordinary skill in the art to meet the limitations of the Publishing Patents

Asserted Claims. As a result, the references identified herein render one or more Asserted Claims of the Publishing Patents obvious when the references are read in combination with each other, and/or when read in view of the state of the art and knowledge of those skilled in the art. Each and every reference identified is also relevant to the state of the art at the time of the alleged invention. Any of the references disclosed above may be combined with one another to render obvious (and therefore invalid) each of the Publishing Patents Asserted Claims. Defendants may rely upon a subset of the identified references, or all of the references identified herein, including all references listed in Section III.B, for purposes of obviousness depending on the Court's claim construction, positions taken by Cellspin during this litigation, and further investigation and discovery.

No More Than Ordinary Variations of Prior Art; No Unexpected Results: To the extent not anticipated, the Publishing Patents Asserted Claims represent no more than the result of ordinary variations of the prior art. Defendants further believe that no showing of a specific motivation to combine prior art is required to combine the references disclosed above and in the attached charts, as each combination of art would have no unexpected results, and at most would simply represent a known alternative to one of ordinary skill in the art. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415-16 (2007) (rejecting the Federal Circuit's "rigid" application of the teaching, suggestion, or motivation to combine test, instead espousing an "expansive and flexible" approach); *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1058 (Fed. Cir. 2016); *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1344 (Fed. Cir. 2017). Indeed, the Supreme Court held that a person of ordinary skill in the art is "a person of ordinary creativity, not an automaton" and "in many cases a person of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* at 420-21.

Nevertheless, in addition to the information contained elsewhere in these contentions, Defendants identify motivation and reason to combine the cited art.

Predictable Results; Obvious to Try: One or more combinations of the prior art references identified in these contentions would have been obvious because these references would have been combined using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or a teaching, suggestion, or motivation in the prior art generally. In addition, it would have been obvious to try combining the prior art references identified above because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. Further, the combinations of the prior art references identified in these contentions would have been obvious because the combinations represent known potential options with a reasonable expectation of success.

Interrelated Teachings: Additional evidence that there would have been a motivation to combine the prior art references identified above includes the interrelated teachings of multiple prior art references; common authorship; the effects of demands known to the design community or present in the marketplace; the existence of a known problem for which there was an obvious solution encompassed by the '757 Patent Asserted Claims; the existence of a known need or problem in the field of the endeavor at the time of the alleged invention(s); and the background knowledge that would have been possessed by a person having ordinary skill in the art.

Summary of Motivations to Combine: Thus, the motivation to combine the teachings of the prior art references disclosed in these contentions is found in the references themselves and also in: (1) the nature of the problem being solved; (2) the express, implied and inherent teachings

of the prior art; (3) the knowledge of persons of ordinary skill in the art; (4) the predictable results obtained in combining the different elements of the prior art; (5) the predictable results obtained in simple substitution of one known element for another; (6) the use of a known technique to improve similar devices, methods, or products in the same way; (7) the predictable results obtained in applying a known technique to a known device, method, or product ready for improvement; (8) the finite number of identified predictable solutions that had a reasonable expectation of success; and (9) known work in various technological fields that could be applied to the same or different technological fields based on design incentives or other market forces.

Same Area of Technology: Additionally, it would be obvious to one of ordinary skill in the art to consult and/or combine any of the prior art listed in these contentions (*see* Section III.B) because all of these references relate to the same area of technology and/or are from analogous art. The Publishing Patents Asserted Claims are directed to publishing captured data to a web service. *See, e.g.,* '030 Patent at Abstract; 1:35-59, 6:46-7:22. The Publishing Patents Asserted Claims merely unite old elements, well known in the field, with no change in their respective function or result. Given the interrelated teachings of the prior art, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, it would have been obvious for one of ordinary skill in the art to combine these familiar elements, disclosed and/or embodied in the prior art listed above to practice the '757 Patent Asserted Claims.

Same Technical Issues: A person of ordinary skill would have been motivated to combine the above prior art based on his/her knowledge, the nature of the problem to be solved, and the teachings of the prior art. The identified prior art addresses the same or similar technical issues and suggests the same or similar solutions to those issues. Moreover, some of the prior art refer

to or discuss other prior art, illustrating the close technical relationship among the prior art. For the Publishing Patents, one of ordinary skill in the art would have been motivated to combine known prior art solutions described in these references relating to data publishing techniques and systems and known features related thereto.

Demand and Market Forces: For example, market forces suggested a demand for efficient techniques for encoding and decoding media, and thus one of skill in the art would have thought to combine or modify references that described known methods that one of skill in the art would have recognized as offering improvements to solutions of that time.

Known Elements; Obvious to Try: Moreover, many of the claim elements were already known as admitted by the applicants in the patent specification. See, e.g., '030 Patent at 9:37-60. These elements represented design choices available to a person of ordinary skill. When there is a design need or market pressure to solve a problem, such as identified previously and/or described in the Publishing Patents, and there are a finite number of identified, predictable solutions, a person of ordinary skill would be motivated to combine the known options that are within his or her technical grasp. For the Publishing Patents, there are a finite number of approaches for publishing data to the web. For example, as of the priority date of the Publishing Patents, a POSITA would have been very familiar with basic elements of the Publishing Patents' claims such as the disclosed network technologies, data transfer capabilities, and publishing data to the web. Such elements were within the knowledge of a POSITA, whether or not disclosed in any particular reference, and the inclusion of such elements in the Publishing Patents' claims does not render them novel or non-obvious.

A POSITA would be motivated any of the cited above (Section III.B) with any other reference, and/or the admitted prior art, because the references describe systems involving a data

capture device (like a wearable device) connected via a short range wireless connection (such as Bluetooth), to a mobile device (such as a mobile phone) connected over a long range network (such as the Internet) to a server (such as a web server) or substantially similar systems. Someone of skill in the art would have been motivated to combine such references with references that disclose similar configurations. Moreover, the prior art references explicitly contemplate using Bluetooth or other technologies cited or used in these contentions to implement their solutions, which would have motivated someone of skill in the art to look to those other references.

In addition to the specific examples provided above, Defendants reserve the right to rely on the disclosures of the references listed in Section III.B for additional motivation to combine. These examples of combinations are given merely to illustrate various motivations to combine and are not intended to provide an exhaustive list of every possible combination to which the motivation may apply. Defendants reserve the right to contend that the motivations to combine provided herein apply to other combinations at the appropriate time, e.g., in expert reports regarding invalidity. To the extent one or more of identified combinations is posed as a combination of only two references, it does not indicate that the two references that are being combined for one purpose could not be joined by a third reference (or more additional references) whose combination serves the same or a different purpose. Indeed, many of the features recited in the asserted claims are componentized features/functions whereby the feature could be implemented using teachings from another source while not interfering with additional features. For that reason, a POSITA may have reasonably looked to and been motivated to combine three or more references in order to achieve a specific outcome.

(b) Combinations

- (i) Publishing References Combined with Bluetooth
References: Endsley, Tanaka, Kusaka 2004, Kusaka 2005.

Kahn in combination with Bluetooth, T36, N95, Seseek,
Wagner, Hollstrom

A POSITA would have had reason to combine Endsley, Tanaka, Kusaka 2004, Kusaka 2005, and Kahn with any one of Bluetooth, T36, N95, Seseek, Wagner, and Hollstrom. For example, each of Endsley, Tanaka, Kusaka 2004, Kusaka 2005, and Kahn concern to publishing data. Indeed, such processes were conventional as of the time these references were known. Each of the Bluetooth References provide means—not necessarily expressly present in all other references—for using Bluetooth as the transfer mechanism. A POSITA would have understood that the systems and methods for publishing data may use Bluetooth to perform the necessary connection in order to transfer data. A POSITA would understand that systems and methods for publishing data online can be improved by using Bluetooth devices to perform certain transfer of data, and that improvements to that transfer capabilities may be beneficial to publishing data to a web service. A POSITA would further understand that in order to automatically publish data to a web service, systems and methods for transferring data between devices would commonly be combined with traditional transferring methodology such as, but not limited to, using Bluetooth.

A POSITA would have been motivated to combine the teachings of these references. The combination would apply known techniques to publish data to a web service, using transfer methodologies such as Bluetooth, in order to yield predictable results. The combination would further be “obvious to try,” because it would involve simple design choices from a finite number of identified, predictable solutions, with a reasonable expectation of success.

(ii) Prior Art References in combination with Detecting New
Data References

A POSITA would have had reason to combine the cited prior art references with any one of Kusaka, Rao, Tran, Yoo, and Adler. A person of ordinary skill in the art would have been motivated to combine these references with any of the references included in Defendants’

Invalidity Contentions because it was well known to detect the existence of new data. Any of these combinations would thus have rendered at least these elements obvious.

For example, each of Endsley, Kusaka, Rao, Tran, Yoo, and Adler concern detecting the existence of new data in order to perform some function, such as publishing, the new data. Indeed, such processes were conventional as of the time these references were known. Each of the Detecting New Data References provide means—not necessarily expressly present in all other references—for detecting the presence of new data. A POSITA would understand that systems and methods for publishing data online can be improved by means of detecting new data to be published. A POSITA would further understand that in order to automatically publish data to a web service, systems and methods for detecting new data can be combined with known publishing methodology. A POSITA would have been motivated to combine the teachings of these references.

V. CLAIM CHARTS PURSUANT TO L.R. 3-3(C)

Individual claim charts that identify where each element of each asserted claim can be found in each item of prior art are attached hereto. A listing of these claim charts is provided below:

Exhibits A-01 through A-34: Claim charts for the '336 Patent.

Exhibit B-01 through B-34: Claim charts for the '757 Patent.

Exhibit C-01 through C-34: Claim charts for the '260 Patent.

Exhibit D-01 through D-11: Claim charts for the '030 Patent.

Exhibit E-01 through E-11: Claim charts for the '766 Patent.

Exhibit F-01 through F-11: Claim charts for the '121 Patent.

Exhibit G-01 through G-11: Claim charts for the '381 Patent.

VI. OTHER GROUNDS FOR INVALIDITY PURSUANT TO L.R. 3-3(D)

A. U.S. Patent No. 8,756,336

Pursuant to Rule 3-3(d), Defendants hereby identify grounds of invalidity for the '336

Patent based on lack of written description under 35 U.S.C. § 112, first paragraph; lack of enablement under 35 U.S.C. § 112, first paragraph; indefiniteness under 35 U.S.C. § 112, second paragraph; and indefiniteness under 35 U.S.C. § 112, sixth paragraph. These contentions shall not be construed as an admission that any claim construction advanced by Defendants in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Defendants from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or acquiescence to Plaintiff's purported construction of the claim language or of other positions advanced by Plaintiff during the course of this litigation. Defendants' invalidity contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Plaintiff's alleged scope of the '336 Patent Asserted Claims. Consequently, Defendants only identify the issues under 35 U.S.C. § 112 of which they are presently aware.

1. Lack of Written Description and/or Enablement Under 35 U.S.C. § 112, ¶ 1

The '336 Patent does not provide sufficient written description to establish that the inventors were in possession of the alleged inventions recited in the '336 Patent Asserted Claims at the time the '336 Patent was filed, at least as plaintiff appears to be asserting those limitations. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). In other words, the applicants did not describe their purported inventions in a manner that "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* One of ordinary skill in the art would not have understood that the inventors were in possession of the full scope of the claimed apparatus and methods, at least as plaintiff appears to be asserting the claims. For example, the claims of the '336 Patent do not provide sufficient written description of the limitations listed below. One of ordinary skill in the art would not understand

the specification to provide a written description of transferring data using a segmented data transfer protocol based on present data size and data transfer capabilities. As another example, one of ordinary skill in the art would not understand the specification to provide a written description of the claimed synchronization message, requests, and replies following a data transfer error, including following a disruption or disconnect during the data transfer process.

The specification of the '336 Patent also does not enable one of ordinary skill in the art to make and/or use certain recited elements of the '336 Patent Asserted Claims without undue experimentation, at least as plaintiff appears to be asserting those limitations. For example, the claims of the '336 Patent fail to sufficiently enable the limitations listed below. One of ordinary skill in the art would not understand the specification to enable transferring data using a segmented data transfer protocol due in part to present data size and data transfer capabilities and sending and/or receiving synchronization requests, messages, or replies following a data transfer error, including following a disruption or disconnect that occurs during the data transfer process. To the extent the following limitations are definite (under 35 U.S.C. § 112, ¶ 2), the application that became the '336 Patent fails to sufficiently describe or enable them as required by 35 U.S.C. § 112, ¶ 1:²

Term	Relevant Claim(s)
determining size of a file to be transferred;	1
transferring the data by the Bluetooth enabled mobile device to the one or more web services using a segmented data transfer protocol due in part to present data size and data transfer capabilities of the Bluetooth enabled mobile device, wherein transferring data using the segmented data transfer protocol comprises, the Bluetooth enabled mobile device, performing:	1
receiving a synchronization message from the web service, corresponding to successful completion of said data segment transfer;	1

² Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
repeating the step of data segment transfer and the step of receiving the synchronization message, until all the data segments have been transferred to the web service successfully, wherein if segmented data transfer is interrupted, the step of data segment transfer further comprises, the Bluetooth enabled mobile device, performing:	1
sending, a synchronization request to the web service, for said user identifier, after a network connection to the web service is restored	1
receiving, a synchronization reply back from the web service, corresponding to the successfully received segmented data, for said user identifier; and	1
transferring a data segment along with said user identifier and said segment identifier to the web service;	1

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

“[T]he second paragraph of § 112 contains two requirements: first, the claim must set forth what the applicant regards as his invention, and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently definite.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002) (internal quotation marks and alteration omitted). “Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention,” the claim is “invalid under § 112, paragraph 2.” *Id.* at 1349. Several of the ’336 Patent Asserted Claims are invalid because it would be apparent to one of skill in the art, based on the specification, that the invention set forth in these claims are not what the patentee regarded as his invention, at least as the claims are being asserted by the Plaintiff. *Id.* These claims are invalid under the “applicant regards” prong of § 112 at least because they contain elements that differ from and/or conflict with the ’336 Patent’s written description of the invention, at least as the claim elements are being asserted by Plaintiff, or because they omit elements that one of skill in the art would understand as part of the ’336 Patent’s invention based on the specification: claims 1 and 4.

Independently, under § 112, ¶ 2, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with

reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Several of the ’336 Patent Asserted Claims are also invalid as indefinite under § 112, ¶ 2 because they fail to inform those skilled in the art about the scope of the invention with reasonable certainty and are indefinite.

The following limitations recited in the ’336 Patent Asserted Claims are indefinite in whole, in part or in combination:³

Term	Relevant Claim(s)
transferring the data by the Bluetooth enabled mobile device to the one or more web services using a segmented data transfer protocol due in part to present data size and data transfer capabilities of the Bluetooth enabled mobile device, wherein transferring data using the segmented data transfer protocol comprises, the Bluetooth enabled mobile device, performing:	1
wherein transferring data using the segmented data transfer protocol comprises, the Bluetooth enabled mobile device, performing: segmenting data into data segments at an application layer level;	1
determining size of a file to be transferred;	1
applying a segment identifier to each data segment at the application layer level;	1
applying a user identifier to each data segment for each destination web service at the application layer level, wherein each user identifier uniquely identifies a particular user of the web service;	1
transferring a data segment along with said user identifier and said segment identifier to the web service;	1
receiving a synchronization message from the web service, corresponding to successful completion of said data segment transfer;	1
repeating the step of data segment transfer and the step of receiving the synchronization message, until all the data segments have been transferred to the web service successfully,	1
wherein if segmented data transfer is interrupted, the step of data segment transfer further comprises, the Bluetooth enabled mobile device, performing: sending, a synchronization request to the web service, for said user identifier, after a network connection to the web service is restored;	1
receiving, a synchronization reply back from the web service, corresponding to the successfully received segmented data, for said user identifier; and	1
resuming, the segmented data transfer from the point immediately following the last successful receipt of the segmented data by the web service, for said user identifier.	1

³ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

B. U.S. Patent No. 8,862,757

Pursuant to Rule 3-3(d), Defendants hereby identify grounds of invalidity for the '757 Patent based on lack of written description under 35 U.S.C. § 112, first paragraph; lack of enablement under 35 U.S.C. § 112, first paragraph; indefiniteness under 35 U.S.C. § 112, second paragraph; and indefiniteness under 35 U.S.C. § 112, sixth paragraph. These contentions shall not be construed as an admission that any claim construction advanced by Defendants in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Defendants from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or acquiescence to Plaintiff's purported construction of the claim language or of other positions advanced by Plaintiff during the course of this litigation. Defendants' invalidity contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Plaintiff's alleged scope of the '757 Patent Asserted Claims. Consequently, Defendants only identify the issues under 35 U.S.C. § 112 of which they are presently aware.

1. Lack of Written Description and/or Enablement Under 35 U.S.C. § 112, ¶ 1

The '757 Patent does not provide sufficient written description to establish that the inventors were in possession of the alleged inventions recited in the '757 Patent Asserted Claims at the time the '757 Patent was filed, at least as plaintiff appears to be asserting those limitations. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1757, 1351 (Fed. Cir. 2010). In other words, the applicants did not describe their purported inventions in a manner that "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* One of ordinary skill in the art would not have understood that the inventors were in possession of the full scope of the claimed apparatus and methods, at least as plaintiff appears to

be asserting the claims. For example, the claims of the '757 Patent do not provide sufficient written description of the limitations listed below. One of ordinary skill in the art would not understand the specification to provide a written description of transferring data using a segmented data transfer protocol based on present data size and data transfer capabilities. As another example, one of ordinary skill in the art would not understand the specification to provide a written description of the claimed synchronization message, requests, and replies following a data transfer error, including following a disruption or disconnect during the data transfer process.

The specification of the '757 Patent also does not enable one of ordinary skill in the art to make and/or use certain recited elements of the '757 Patent Asserted Claims without undue experimentation, at least as plaintiff appears to be asserting those limitations. For example, the claims of the '757 Patent fail to sufficiently enable the limitations listed below. One of ordinary skill in the art would not understand the specification to enable transferring data using a segmented data transfer protocol due in part to present data size and data transfer capabilities and sending and/or receiving synchronization requests, messages, or replies following a data transfer error, including following a disruption or disconnect that occurs during the data transfer process. To the extent the following limitations are definite (under 35 U.S.C. § 112, ¶ 2), the application that became the '757 Patent fails to sufficiently describe or enable them as required by 35 U.S.C. § 112, ¶ 1:⁴

Term	Relevant Claim(s)
segmenting said file into data segments at an application layer level, wherein said file is segmented in part due to size of said file and data transfer capabilities of said Bluetooth enabled mobile device, wherein data in said data segments comprises one or more of said file data and data associated with said file data;	1,8, 15, 21

⁴ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
sending, a synchronization request to the web service from the application layer level, corresponding to asking the web service about the segmented file data the web service has successfully received, for said user identifier, after a network connection to the web service is restored;	1,8, 15, 21
receiving, a synchronization reply back from the web service at the application layer level, corresponding to indicate segmented file data said web service has successfully received, for said user identifier; and	1,8, 15, 21
resuming, the segmented file transfer based on the synchronization reply received, for said user identifier.	1,8, 15, 21
determining size of a file to be transferred;	1,8, 15, 21
wherein transferring the data segment further comprises one or more of: configuring the data segment so that the data segment can be received by the web service; and	1,8, 15, 21

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

“[T]he second paragraph of § 112 contains two requirements: first, the claim must set forth what the applicant regards as his invention, and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently definite.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1757, 1348 (Fed. Cir. 2002) (internal quotation marks and alteration omitted). “Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention,” the claim is “invalid under § 112, paragraph 2.” *Id.* at 1349. Several of the ’757 Patent Asserted Claims are invalid because it would be apparent to one of skill in the art, based on the specification, that the invention set forth in these claims are not what the patentee regarded as his invention, at least as the claims are being asserted by the Plaintiff. *Id.* These claims are invalid under the “applicant regards” prong of § 112 at least because they contain elements that differ from and/or conflict with the ’757 Patent’s written description of the invention, at least as the claim elements are being asserted by Plaintiff, or because they omit elements that one of skill in the art would understand as part of the ’757 Patent’s invention based on the specification: claims 1 and 4.

Independently, under § 112, ¶ 2, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Several of the ’757 Patent Asserted Claims are also invalid as indefinite under § 112, ¶ 2 because they fail to inform those skilled in the art about the scope of the invention with reasonable certainty and are indefinite.

The following limitations recited in the ’757 Patent Asserted Claims are indefinite in whole, in part or in combination:⁵

Term	Relevant Claim(s)
determining size of a file to be transferred;	1, 8, 15, 21
segmenting said file into data segments at an application layer level, wherein said file is segmented in part due to size of said file and data transfer capabilities of said Bluetooth enabled mobile device, wherein data in said data segments comprises one or more of said file data and data associated with said file data;	1,8, 15, 21
wherein data in said data segments comprises one or more of said file data and data associated with said file data;	1,8, 15, 21
applying a segment identifier to each of said data segments at the application layer level;	1,8, 15, 21
applying a user identifier to each of said data segments for the destination web service at the application layer level, wherein said user identifier uniquely identifies a particular user of the web service;	1,8, 15, 21
transferring a data segment along with said user identifier and said segment identifier to the web service,	1,8, 15, 21
wherein transferring the data segment further comprises one or more of: configuring the data segment so that the data segment can be received by the web service; and	1,8, 15, 21
receiving a reply message from the web service, corresponding to successful completion of said data segment transfer;	1,8, 15, 21
repeating the step of data segment transfer and the step of receiving the reply message, until all the data segments have been transferred to the web service successfully,	1,8, 15, 21

⁵ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
wherein if segmented file transfer is interrupted, the software module further performs: sending, a synchronization request to the web service from the application layer level, corresponding to asking the web service about the segmented file data the web service has successfully received, for said user identifier, after a network connection to the web service is restored;	1,8, 15, 21
receiving, a synchronization reply back from the web service at the application layer level, corresponding to indicate segmented file data said web service has successfully received, for said user identifier; and	1,8, 15, 21
resuming, the segmented file transfer based on the synchronization reply received, for said user identifier.	1,8, 15, 21

C. U.S. Patent No. 8,898,260

Pursuant to Rule 3-3(d), Defendants hereby identify grounds of invalidity for the '260 Patent based on lack of written description under 35 U.S.C. § 112, first paragraph; lack of enablement under 35 U.S.C. § 112, first paragraph; indefiniteness under 35 U.S.C. § 112, second paragraph; and indefiniteness under 35 U.S.C. § 112, sixth paragraph. These contentions shall not be construed as an admission that any claim construction advanced by Defendants in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Defendants from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or acquiescence to Plaintiff's purported construction of the claim language or of other positions advanced by Plaintiff during the course of this litigation. Defendants' invalidity contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Plaintiff's alleged scope of the '260 Patent Asserted Claims. Consequently, Defendants only identify the issues under 35 U.S.C. § 112 of which they are presently aware.

1. Lack of Written Description and/or Enablement Under 35 U.S.C. § 112, ¶ 1

The '260 Patent does not provide sufficient written description to establish that the inventors were in possession of the alleged inventions recited in the '260 Patent Asserted Claims

at the time the '260 Patent was filed, at least as plaintiff appears to be asserting those limitations. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1260, 1351 (Fed. Cir. 2010). In other words, the applicants did not describe their purported inventions in a manner that “reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* One of ordinary skill in the art would not have understood that the inventors were in possession of the full scope of the claimed apparatus and methods, at least as plaintiff appears to be asserting the claims. For example, the claims of the '260 Patent do not provide sufficient written description of the limitations listed below. One of ordinary skill in the art would not understand the specification to provide a written description of claimed synchronization message, requests, and replies following a data transfer error, including following a disruption or disconnect during the data transfer process.

The specification of the '260 Patent also does not enable one of ordinary skill in the art to make and/or use certain recited elements of the '260 Patent Asserted Claims without undue experimentation, at least as plaintiff appears to be asserting those limitations. For example, the claims of the '260 Patent fail to sufficiently enable the limitations listed below. One of ordinary skill in the art would not understand the specification to enable sending and/or receiving synchronization requests, messages, or replies following a data transfer error, including following a disruption or disconnect that occurs during the data transfer process. To the extent the following limitations are definite (under 35 U.S.C. § 112, ¶ 2), the application that became the '260 Patent fails to sufficiently describe or enable them as required by 35 U.S.C. § 112, ¶ 1:⁶

Term	Relevant Claim(s)
determining size of a file to be transferred;	1, 6, 10, 15

⁶ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
applying a user identifier to each of said data segments for the destination web service at the application layer level, wherein said user identifier uniquely identifies a particular user of the web service;	1, 6, 10, 15
sending, a synchronization request to the web service from the application layer level, corresponding to asking the web service about the segmented file data the web service has successfully received, for said user identifier, after a network connection to the web service is restored;	1, 6, 10, 15
receiving, a synchronization reply back from the web service at the application layer level, corresponding to indicate segmented file data said web service has successfully received, for said user identifier; and	1, 6, 10, 15
resuming, the segmented file transfer based on the synchronization reply received, for said user identifier;	1, 6, 10, 15
receiving, at the web service, all the data segments along with said user identifier and segment identifiers for said file transfer;	1, 6, 10, 15
storing, at the web service, the received file data segments and segment identifiers for said user identifier; and	1, 6
making available, at the web service, the segmented data received from the Bluetooth enabled mobile device for public or private consumption over the internet.	1, 6, 10, 15

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

“[T]he second paragraph of § 112 contains two requirements: first, the claim must set forth what the applicant regards as his invention, and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently definite.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1260, 1348 (Fed. Cir. 2002) (internal quotation marks and alteration omitted). “Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention,” the claim is “invalid under § 112, paragraph 2.” *Id.* at 1349. Several of the ’260 Patent Asserted Claims are invalid because it would be apparent to one of skill in the art, based on the specification, that the invention set forth in these claims are not what the patentee regarded as his invention, at least as the claims are being asserted by the Plaintiff. *Id.* These claims are invalid under the “applicant regards” prong of § 112 at least because they contain elements that differ from and/or conflict with the ’260 Patent’s written

description of the invention, at least as the claim elements are being asserted by Plaintiff, or because they omit elements that one of skill in the art would understand as part of the '260 Patent's invention based on the specification: claims 1 and 4.

Independently, under § 112, ¶ 2, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Several of the '260 Patent Asserted Claims are also invalid as indefinite under § 112, ¶ 2 because they fail to inform those skilled in the art about the scope of the invention with reasonable certainty and are indefinite.

The following limitations recited in the '260 Patent Asserted Claims are indefinite in whole, in part or in combination:⁷

Term	Relevant Claim(s)
determining size of a file to be transferred;	1, 6, 10, 15
segmenting said file into data segments at an application layer level, wherein data in said data segments comprises one or more of said file data and data associated with said file data;	1, 6, 10, 15
applying a segment identifier to each of said data segments at the application layer level, wherein the segment identifier corresponds to the content range of said file data that is being transferred in a given data segment;	1, 6, 10, 15
applying a user identifier to each of said data segments for the destination web service at the application layer level, wherein said user identifier uniquely identifies a particular user of the web service;	1, 6, 10, 15
transferring a data segment along with said user identifier and said segment identifier to the web service;	1, 6, 10, 15
receiving a reply message from the web service, corresponding to successful completion of said data segment transfer;	1, 6, 10, 15
repeating the step of data segment transfer and the step of receiving the reply message, until all the data segments have been transferred to the web service successfully, wherein if segmented file transfer is interrupted, the software module further performs:	1, 6, 10, 15

⁷ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
sending, a synchronization request to the web service from the application layer level, corresponding to asking the web service about the segmented file data the web service has successfully received, for said user identifier, after a network connection to the web service is restored;	1, 6, 10, 15
receiving, a synchronization reply back from the web service at the application layer level, corresponding to indicate segmented file data said web service has successfully received, for said user identifier; and	1, 6, 10, 15
resuming, the segmented file transfer based on the synchronization reply received, for said user identifier;	1, 6, 10, 15
receiving, at the web service, all the data segments along with said user identifier and segment identifiers for said file transfer;	1, 6, 10, 15
storing, at the web service, the received file data segments and segment identifiers for said user identifier; and	1, 6
making available, at the web service, the segmented data received from the Bluetooth enabled mobile device for public or private consumption over the internet.	1, 6, 10, 15

D. U.S. Patent No. 8,904,030

Pursuant to Rule 3-3(d), Defendants hereby identify grounds of invalidity for the '030 Patent based on lack of written description under 35 U.S.C. § 112, first paragraph; lack of enablement under 35 U.S.C. § 112, first paragraph; indefiniteness under 35 U.S.C. § 112, second paragraph; and indefiniteness under 35 U.S.C. § 112, sixth paragraph. These contentions shall not be construed as an admission that any claim construction advanced by Defendants in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Defendants from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or acquiescence to Plaintiff's purported construction of the claim language or of other positions advanced by Plaintiff during the course of this litigation. Defendants' invalidity contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Plaintiff's alleged scope of the '030 Patent Asserted Claims. Consequently, Defendants only identify the issues under 35 U.S.C. § 112 of which they are presently aware.

1. **Lack of Written Description and/or Enablement Under 35 U.S.C. § 112, ¶ 1**

The '030 Patent does not provide sufficient written description to establish that the inventors were in possession of the alleged inventions recited in the '030 Patent Asserted Claims at the time the '030 Patent was filed, at least as plaintiff appears to be asserting those limitations. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1030, 1351 (Fed. Cir. 2010). In other words, the applicants did not describe their purported inventions in a manner that “reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* One of ordinary skill in the art would not have understood that the inventors were in possession of the full scope of the claimed apparatus and methods, at least as plaintiff appears to be asserting the claims. For example, the claims of the '030 Patent do not provide sufficient written description of the limitations listed below. One of ordinary skill in the art would not understand the specification to provide a written description of providing the Bluetooth functionality claimed by the '030 Patent. As another example, one of ordinary skill in the art would not understand the specification to provide a written description of the transferring of data and making new data available on the internet as claimed by the '030 Patent.

The specification of the '030 Patent also does not enable one of ordinary skill in the art to make and/or use certain recited elements of the '030 Patent Asserted Claims without undue experimentation, at least as plaintiff appears to be asserting those limitations. For example, the claims of the '030 Patent fail to sufficiently enable the limitations listed below. One of ordinary skill in the art would not understand the specification to enable, for example, methods and systems of establishing and using Bluetooth functionality as claimed by the '030 Patent. By way of further example, the specification does not enable the claimed HTTP and RPC functionality that is claimed without any explanation in the specification. To the extent the following limitations are definite

(under 35 U.S.C. § 112, ¶ 2), the application that became the '030 Patent fails to sufficiently describe or enable them as required by 35 U.S.C. § 112, ¶ 1:⁸

Term	Relevant Claim(s)
determining existence of the new data for transfer	1, 6
wherein the Bluetooth enabled mobile device is configured to apply action setting and destination web address of a remote internet server to the obtained new data	1, 6
establishing a paired secure Bluetooth connection	1, 6, 12
the paired secure Bluetooth connection uses cryptographic encryption key	1, 6, 12
supported data capability of the Bluetooth enabled data capture device	1, 12
encrypting, using cryptographic encryption key	1, 6
action setting comprises one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method	1, 12, 6, 15
enabling/enable event notification(s)	1, 12
event notification corresponds to creation of new data for transfer or change in status of new data for transfer	5, 10
Bluetooth capability is provided internally in the Bluetooth enabled data capture device	2, 7
data associated with new data and a data signal notification	6
enabling event notification listening on Bluetooth enabled mobile device	12

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

“[T]he second paragraph of § 112 contains two requirements: first, the claim must set forth what the applicant regards as his invention, and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently definite.” *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1030, 1348 (Fed. Cir. 2002) (internal quotation marks and alteration omitted). “Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention,” the claim is “invalid under § 112, paragraph 2.” *Id.* at 1349. Several of the '030 Patent Asserted Claims are invalid because

⁸ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

it would be apparent to one of skill in the art, based on the specification, that the invention set forth in these claims are not what the patentee regarded as his invention, at least as the claims are being asserted by the Plaintiff. *Id.* These claims are invalid under the “applicant regards” prong of § 112 at least because they contain elements that differ from and/or conflict with the ’030 Patent’s written description of the invention, at least as the claim elements are being asserted by Plaintiff, or because they omit elements that one of skill in the art would understand as part of the ’030 Patent’s invention based on the specification: claims 1 and 4.

Independently, under § 112, ¶ 2, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Several of the ’030 Patent Asserted Claims are also invalid as indefinite under § 112, ¶ 2 because they fail to inform those skilled in the art about the scope of the invention with reasonable certainty and are indefinite.

The following limitations recited in the ’030 Patent Asserted Claims are indefinite in whole, in part or in combination:⁹

Term	Relevant Claim(s)
determining existence of the new data for transfer	1, 6
wherein the Bluetooth enabled mobile device is configured to apply action setting and destination web address of a remote internet server to the obtained new data	1, 6
encrypting, using cryptographic encryption key	1, 6
action setting comprises one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method	1, 12, 6, 15
enabling/enable event notification(s)	1, 12
event notification corresponds to creation of new data for transfer or change in status of new data for transfer	5, 10
data associated with new data and a data signal notification	6

⁹ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

E. U.S. Patent No. 9,900,766

Pursuant to Rule 3-3(d), Defendants hereby identify grounds of invalidity for the '766 Patent based on lack of written description under 35 U.S.C. § 112, first paragraph; lack of enablement under 35 U.S.C. § 112, first paragraph; indefiniteness under 35 U.S.C. § 112, second paragraph; and indefiniteness under 35 U.S.C. § 112, sixth paragraph. These contentions shall not be construed as an admission that any claim construction advanced by Defendants in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Defendants from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or acquiescence to Plaintiff's purported construction of the claim language or of other positions advanced by Plaintiff during the course of this litigation. Defendants' invalidity contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Plaintiff's alleged scope of the '766 Patent Asserted Claims. Consequently, Defendants only identify the issues under 35 U.S.C. § 112 of which they are presently aware.

1. Lack of Written Description and/or Enablement Under 35 U.S.C. § 112, ¶ 1

The '766 Patent does not provide sufficient written description to establish that the inventors were in possession of the alleged inventions recited in the '766 Patent Asserted Claims at the time the '766 Patent was filed, at least as plaintiff appears to be asserting those limitations. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1766, 1351 (Fed. Cir. 2010). In other words, the applicants did not describe their purported inventions in a manner that "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* One of ordinary skill in the art would not have understood that the inventors were in possession of the full scope of the claimed apparatus and methods, at least as plaintiff appears to

be asserting the claims. For example, the claims of the '766 Patent do not provide sufficient written description of the limitations listed below. One of ordinary skill in the art would not understand the specification to provide a written description of the claimed Bluetooth and HTTP functionality as claimed by the '766 Patent. As another example, one of ordinary skill in the art would not understand the specification to provide a written description of the the transferring of data and making new data available on the internet.

The specification of the '766 Patent also does not enable one of ordinary skill in the art to make and/or use certain recited elements of the '766 Patent Asserted Claims without undue experimentation, at least as plaintiff appears to be asserting those limitations. For example, the claims of the '766 Patent fail to sufficiently enable the limitations listed below. One of ordinary skill in the art would not understand the specification to enable, for example, methods and systems of establishing and using Bluetooth functionality as claimed by the '030 Patent. By way of further example, the specification does not enable the claimed HTTP and RPC functionality that is claimed without any explanation in the specification. To the extent the following limitations are definite (under 35 U.S.C. § 112, ¶ 2), the application that became the '766 Patent fails to sufficiently describe or enable them as required by 35 U.S.C. § 112, ¶ 1:¹⁰

Term	Relevant Claim(s)
establishing the short-range paired wireless connection comprises cryptographically authenticating identity of the short-range wireless enabled cellular phone	1, 13
acquire new-data in the short-range wireless enabled data capture device using the data capture circuitry	1, 4, 9, 13
configured to create a new-data object	1, 4, 13
signal to notify	1, 4, 5, 9, 13
the signal to notify corresponds to the acquiring of the new-data for transfer to the cryptographically authenticated short-range wireless enabled cellular phone	1, 9, 13

¹⁰ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
associated new-data, wherein the associated new-data corresponds to data associated with the new-data	1, 4, 9, 13
said processor further configured to transfer automatically the new-data object to the cryptographically authenticated short-range wireless enabled cellular phone	1, 4
the mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to use HTTP to upload the received new-data along with user information to a user data publishing website over a cellular data network,	1
the user information corresponds to a user identifier that uniquely identifies a particular user of the user data publishing website and is used by the user data publishing website to publish the new-data for private consumption.	1, 4, 9, 13

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

“[T]he second paragraph of § 112 contains two requirements: first, the claim must set forth what the applicant regards as his invention, and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently definite.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1766, 1348 (Fed. Cir. 2002) (internal quotation marks and alteration omitted). “Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention,” the claim is “invalid under § 112, paragraph 2.” *Id.* at 1349. Several of the ’766 Patent Asserted Claims are invalid because it would be apparent to one of skill in the art, based on the specification, that the invention set forth in these claims are not what the patentee regarded as his invention, at least as the claims are being asserted by the Plaintiff. *Id.* These claims are invalid under the “applicant regards” prong of § 112 at least because they contain elements that differ from and/or conflict with the ’766 Patent’s written description of the invention, at least as the claim elements are being asserted by Plaintiff, or because they omit elements that one of skill in the art would understand as part of the ’766 Patent’s invention based on the specification: claims 1 and 4.

Independently, under § 112, ¶ 2, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Several of the ’766 Patent Asserted Claims are also invalid as indefinite under § 112, ¶ 2 because they fail to inform those skilled in the art about the scope of the invention with reasonable certainty and are indefinite.

The following limitations recited in the ’766 Patent Asserted Claims are indefinite in whole, in part or in combination:¹¹

Term	Relevant Claim(s)
acquire new-data in the short-range wireless enabled data capture device using the data capture circuitry	1, 4, 9, 13
configured to create a new-data object	1, 4, 13
signal to notify	1, 4, 5, 9, 13
the signal to notify corresponds to the acquiring of the new-data for transfer to the cryptographically authenticated short-range wireless enabled cellular phone	1, 9, 13
associated new-data, wherein the associated new-data corresponds to data associated with the new-data	1, 4, 9, 13
said processor further configured to transfer automatically the new-data object to the cryptographically authenticated short-range wireless enabled cellular phone	1, 4
the user information corresponds to a user identifier that uniquely identifies a particular user of the user data publishing website and is used by the user data publishing website to publish the new-data for private consumption.	1, 4, 9, 13

F. U.S. Patent No. 11,234,121

Pursuant to Rule 3-3(d), Defendants hereby identify grounds of invalidity for the ’121 Patent based on lack of written description under 35 U.S.C. § 112, first paragraph; lack of enablement under 35 U.S.C. § 112, first paragraph; indefiniteness under 35 U.S.C. § 112, second

¹¹ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

paragraph; and indefiniteness under 35 U.S.C. § 112, sixth paragraph. These contentions shall not be construed as an admission that any claim construction advanced by Defendants in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Defendants from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or acquiescence to Plaintiff's purported construction of the claim language or of other positions advanced by Plaintiff during the course of this litigation. Defendants' invalidity contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Plaintiff's alleged scope of the '121 Patent Asserted Claims. Consequently, Defendants only identify the issues under 35 U.S.C. § 112 of which they are presently aware.

1. **Lack of Written Description and/or Enablement Under 35 U.S.C. § 112, ¶ 1**

The '121 Patent does not provide sufficient written description to establish that the inventors were in possession of the alleged inventions recited in the '121 Patent Asserted Claims at the time the '121 Patent was filed, at least as plaintiff appears to be asserting those limitations. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1121, 1351 (Fed. Cir. 2010). In other words, the applicants did not describe their purported inventions in a manner that "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* One of ordinary skill in the art would not have understood that the inventors were in possession of the full scope of the claimed apparatus and methods, at least as plaintiff appears to be asserting the claims. For example, the claims of the '121 Patent do not provide sufficient written description of the limitations listed below. One of ordinary skill in the art would not understand the specification to provide a written description of providing the Bluetooth functionality claimed by the '121 Patent. As another example, one of ordinary skill in the art would not understand the

specification to provide a written description of the transferring of data and making new data available on the internet as claimed by the '121 Patent.

The specification of the '121 Patent also does not enable one of ordinary skill in the art to make and/or use certain recited elements of the '121 Patent Asserted Claims without undue experimentation, at least as plaintiff appears to be asserting those limitations. For example, the claims of the '121 Patent fail to sufficiently enable the limitations listed below. One of ordinary skill in the art would not understand the specification to enable, for example, methods and systems of establishing and using Bluetooth functionality as claimed by the '030 Patent. By way of further example, the specification does not enable the claimed HTTP and RPC functionality that is claimed without any explanation in the specification. To the extent the following limitations are definite (under 35 U.S.C. § 112, ¶ 2), the application that became the '121 Patent fails to sufficiently describe or enable them as required by 35 U.S.C. § 112, ¶ 1:¹²

Term	Relevant Claim(s)
establishing the short-range paired wireless connection comprises the short-range wireless enabled data capture device cryptographically authenticating identity of the short-range wireless enabled cellular phone	1, 4, 9
new-data is data acquired after establishing the short-range paired wireless connection between the short-range wireless enabled data capture device and the short-range wireless enabled cellular phone	1, 4, 5, 7, 8, 9, 10
event notification corresponds to the acquired new-data and comprises sending a signal to the cryptographically authenticated short-range wireless enabled cellular phone	1, 4, 7
cryptographically authenticated short-range wireless enabled cellular phone is configured to listen to the event notification and receive the new-data over the established short-range paired wireless connection	1
a single mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to process the event notification and store the received	1, 4, 7

¹² Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
new-data in a memory device of the cryptographically authenticated short-range wireless enabled cellular phone	
mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to use HTTP to upload the received new-data and the user authentication credential to a user data publishing website over a cellular data network	1, 4, 7, 9
the user preference comprises global positioning system information	1, 4, 7, 9

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

“[T]he second paragraph of § 112 contains two requirements: first, the claim must set forth what the applicant regards as his invention, and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently definite.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1121, 1348 (Fed. Cir. 2002) (internal quotation marks and alteration omitted). “Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention,” the claim is “invalid under § 112, paragraph 2.” *Id.* at 1349. Several of the ’121 Patent Asserted Claims are invalid because it would be apparent to one of skill in the art, based on the specification, that the invention set forth in these claims are not what the patentee regarded as his invention, at least as the claims are being asserted by the Plaintiff. *Id.* These claims are invalid under the “applicant regards” prong of § 112 at least because they contain elements that differ from and/or conflict with the ’121 Patent’s written description of the invention, at least as the claim elements are being asserted by Plaintiff, or because they omit elements that one of skill in the art would understand as part of the ’121 Patent’s invention based on the specification: claims 1 and 4.

Independently, under § 112, ¶ 2, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v.*

Biosig Instruments, Inc., 572 U.S. 898, 901 (2014). Several of the '121 Patent Asserted Claims are also invalid as indefinite under § 112, ¶ 2 because they fail to inform those skilled in the art about the scope of the invention with reasonable certainty and are indefinite.

The following limitations recited in the '121 Patent Asserted Claims are indefinite in whole, in part or in combination:¹³

Term	Relevant Claim(s)
establishing the short-range paired wireless connection comprises the short-range wireless enabled data capture device cryptographically authenticating identity of the short-range wireless enabled cellular phone	1, 4, 9
cryptographically authenticated short-range wireless enabled cellular phone is configured to listen to the event notification and receive the new-data over the established short-range paired wireless connection	1
mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to use HTTP to upload the received new-data and the user authentication credential to a user data publishing website over a cellular data network	1, 4, 7, 9

G. U.S. Patent No. 11,659,381

Pursuant to Rule 3-3(d), Defendants hereby identify grounds of invalidity for the '381 Patent based on lack of written description under 35 U.S.C. § 112, first paragraph; lack of enablement under 35 U.S.C. § 112, first paragraph; indefiniteness under 35 U.S.C. § 112, second paragraph; and indefiniteness under 35 U.S.C. § 112, sixth paragraph. These contentions shall not be construed as an admission that any claim construction advanced by Defendants in this case is in any way inconsistent, flawed, or erroneous. Nor should these contentions prevent Defendants from advancing claim construction and/or non-infringement positions in lieu of, or in addition to, invalidity positions. Further, these contentions shall not be construed as an admission of or

¹³ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

acquiescence to Plaintiff's purported construction of the claim language or of other positions advanced by Plaintiff during the course of this litigation. Defendants' invalidity contentions under 35 U.S.C. § 112 may depend, in part, on the Court's claim construction, as well as Plaintiff's alleged scope of the '381 Patent Asserted Claims. Consequently, Defendants only identify the issues under 35 U.S.C. § 112 of which they are presently aware.

1. **Lack of Written Description and/or Enablement Under 35 U.S.C. § 112, ¶ 1**

The '381 Patent does not provide sufficient written description to establish that the inventors were in possession of the alleged inventions recited in the '381 Patent Asserted Claims at the time the '381 Patent was filed, at least as plaintiff appears to be asserting those limitations. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1381, 1351 (Fed. Cir. 2010). In other words, the applicants did not describe their purported inventions in a manner that "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* One of ordinary skill in the art would not have understood that the inventors were in possession of the full scope of the claimed apparatus and methods, at least as plaintiff appears to be asserting the claims. For example, the claims of the '381 Patent do not provide sufficient written description of the limitations listed below. One of ordinary skill in the art would not understand the specification to provide a written description of providing the Bluetooth functionality claimed by the '381 Patent. As another example, one of ordinary skill in the art would not understand the specification to provide a written description of the transferring of data and making new data available on the internet as claimed by the '381 Patent.

The specification of the '381 Patent also does not enable one of ordinary skill in the art to make and/or use certain recited elements of the '381 Patent Asserted Claims without undue experimentation, at least as plaintiff appears to be asserting those limitations. For example, the

claims of the '381 Patent fail to sufficiently enable the limitations listed below. One of ordinary skill in the art would not understand the specification to enable, for example, methods and systems of establishing and using Bluetooth functionality as claimed by the '030 Patent. By way of further example, the specification does not enable the claimed HTTP and RPC functionality that is claimed without any explanation in the specification. To the extent the following limitations are definite (under 35 U.S.C. § 112, ¶ 2), the application that became the '381 Patent fails to sufficiently describe or enable them as required by 35 U.S.C. § 112, ¶ 1:¹⁴

Term	Relevant Claim(s)
cryptographically authenticating an identity of the Bluetooth enabled cellular phone	1, 7, 12
detecting and receiving new-data	1, 7, 12, 14
listen for an event notification and the acquired new-data	1, 7
Hypertext Transfer Protocol to transfer the received new-data along with a user authentication credential to a remote server	1, 7, 12
user preference comprises global positioning system information	1, 7, 12
database stores a user profile	1
mobile software application advertising software module selects advertisements based on the user profile and sends the selected advertisements to the mobile software application	1
receive the new-data and the user authentication credential from the Bluetooth enabled cellular phone via the Hypertext Transfer Protocol	1, 7, 8, 12, 13

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

“[T]he second paragraph of § 112 contains two requirements: first, the claim must set forth what the applicant regards as his invention, and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently definite.” *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1381, 1348 (Fed. Cir. 2002) (internal quotation marks and alteration omitted). “Where it would be apparent to one of skill in the art, based on the specification, that the invention

¹⁴ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

set forth in a claim is not what the patentee regarded as his invention,” the claim is “invalid under § 112, paragraph 2.” *Id.* at 1349. Several of the ’381 Patent Asserted Claims are invalid because it would be apparent to one of skill in the art, based on the specification, that the invention set forth in these claims are not what the patentee regarded as his invention, at least as the claims are being asserted by the Plaintiff. *Id.* These claims are invalid under the “applicant regards” prong of § 112 at least because they contain elements that differ from and/or conflict with the ’381 Patent’s written description of the invention, at least as the claim elements are being asserted by Plaintiff, or because they omit elements that one of skill in the art would understand as part of the ’381 Patent’s invention based on the specification: claims 1 and 4.

Independently, under § 112, ¶ 2, “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). Several of the ’381 Patent Asserted Claims are also invalid as indefinite under § 112, ¶ 2 because they fail to inform those skilled in the art about the scope of the invention with reasonable certainty and are indefinite.

The following limitations recited in the ’381 Patent Asserted Claims are indefinite in whole, in part or in combination:¹⁵

Term	Relevant Claim(s)
listen for an event notification and the acquired new-data	1, 7
Hypertext Transfer Protocol to transfer the received new-data along with a user authentication credential to a remote server	1, 7, 12
user preference comprises global positioning system information	1, 7, 12
database stores a user profile	1
mobile software application advertising software module selects advertisements based on the user profile and sends the selected advertisements to the mobile software application	1

¹⁵ Listed claims also include all Asserted Claims dependent thereon, even if those claims are not individually listed.

Term	Relevant Claim(s)
receive the new-data and the user authentication credential from the Bluetooth enabled cellular phone via the Hypertext Transfer Protocol	1, 7, 8, 12, 13

VII. PRIORITY DATE

The earliest claimed priority date of the Asserted Patents is December 28, 2007, which Defendants do not concede. Defendants contend that the earliest claimed priority date is the filing date of each application for the Asserted Patents. The priority documents each fail to disclose the written description of the subject matter as arranged in the claims. Nevertheless, these contentions apply the earliest relevant framework for analyzing whether Cellspin's asserted claims include an inventive concept as the state of the art as of December 28, 2007, viewed through the lens of a POSITA. Defendants reserve the right to apply a later relevant framework as discovery proceeds.

Dated: June 6, 2024

Respectfully submitted,

By: /s/ Ricardo J. Bonilla

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing document has been served via electronic mail on June 6, 2024, to all counsel of record who are deemed to have consented to electronic service.

/s/ Ricardo J. Bonilla
Ricardo J. Bonilla