

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK INC.,
Petitioner,

v.

CELLSPINSOFT, INC.,
Patent Owner.

IPR2024-00759
Patent 8,862,757 B2

Before GREGG I. ANDERSON, CYNTHIA M. HARDMAN, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

TikTok Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”), seeking *inter partes* review of claims 1–26 of U.S. Patent No. 8,862,757 B2 (Ex. 1001, “the ’757 patent”). Cellspin Soft, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 7, “Prelim. Reply”). Although authorized to do so, Patent Owner did not file a preliminary sur-reply.

Considering the arguments and evidence currently of record, we determine the Petition demonstrates “a reasonable likelihood that [P]etitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Accordingly, *inter partes* review is instituted.

II. BACKGROUND

A. Real Parties-in-Interest

Petitioner identifies TikTok Inc., ByteDance Inc., ByteDance, Ltd., ByteDance PTE, Ltd., and TikTok PTE, Ltd. as its real parties-in-interest. Pet. 95. Patent Owner identifies itself as its real party-in-interest. Paper 4, 2.

B. Related Matters

The parties identify *Cellspin Soft, Inc. v. ByteDance, Ltd., et al.*, No. 2:23-cv-496 (E.D. Tex.), referred to herein as “the Texas litigation,” as a related matter involving the ’757 patent. Pet. 95; Paper 4, 2. Petitioner also notes that “[t]he ’757 patent is in the same family” as six other patents for which it has concurrently sought *inter partes* review. Pet. 95. These related patents are the subject of IPR2024-00757, IPR2024-00760, IPR2024-00767, IPR2024-00768, IPR2024-00769, and IPR2024-00770.

C. The '757 Patent

The '757 patent issued on October 14, 2014, and claims priority to a series of applications, the earliest of which was filed on December 28, 2007. Ex. 1001, codes (45), (60).

The '757 patent generally describes “a method and system for utilizing a digital data capture device in conjunction with a Bluetooth (BT) enabled mobile device for publishing data and multimedia content on one or more websites automatically or with minimal user intervention.” Ex. 1001, Abstr. In this method, a “client application” on the BT enabled mobile device “detects capture of data and multimedia content on the digital data capture device and initiates transfer of the captured data, multimedia content, and associated files” and “automatically publishes” it by transferring that data to a website. *See id.*

Figure 4 of the '757 patent, reproduced below, depicts an exemplary embodiment.

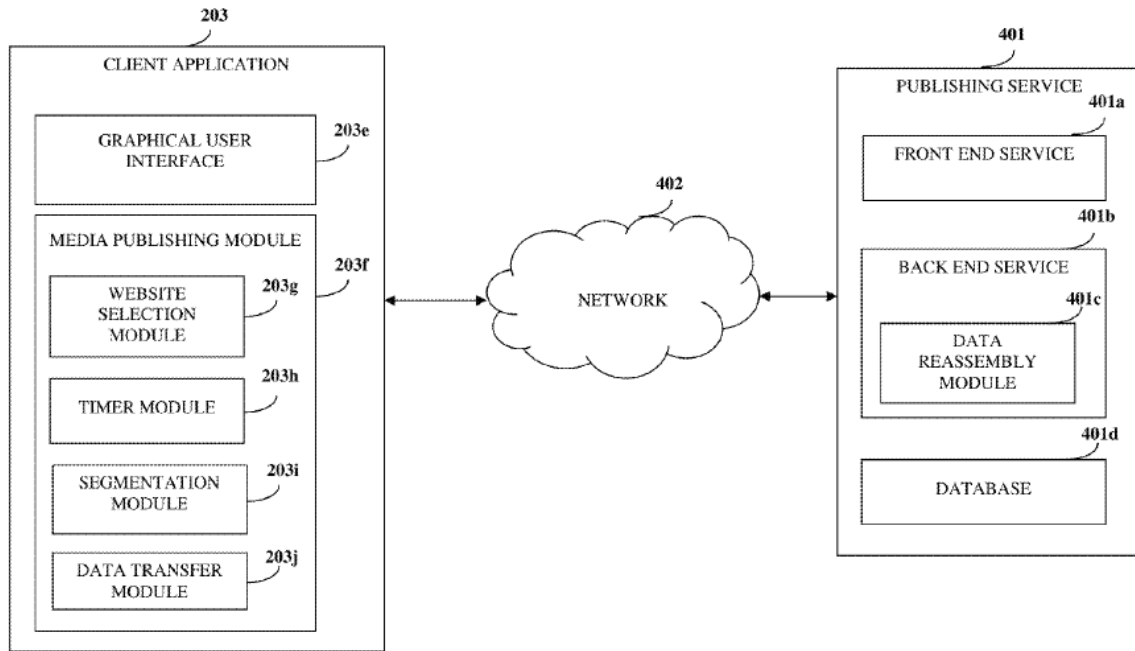


FIG. 4

Figure 4 above shows client application 203 on the left connected though network 402 to publishing service 401 on the right. The client application comprises several modules including segmentation module 203i and data transfer module 203j. The Specification explains:

In the case of limited memory and processing capabilities of the mobile device . . . the segmentation module 203i of the client application 203 partitions the multimedia content of large files into multiple data segments. The segmentation module 203i generates segment identifiers and tags the data segments with the segment identifiers. . . . The segment identifiers are used later by a back end service 401b of the publishing service 401 to reassemble the data segments in a predetermined sequence to create a multimedia object. The data transfer module 203j transfers the data, the tagged data segments, and the multimedia content from the client application 203 to the publishing service 401 via network 402.

Ex. 1001, 7:52–65. According to the Specification, the “transport protocol that is used between the client application 203 and the publishing service 401 may be hypertext transfer protocol (HTTP).” *Id.* at 10:4–7.

D. Challenged Claims

The Petition challenges claims 1–26. Claim 1 is illustrative and reproduced below with the bracketed annotations Petitioner uses to identify different limitations.

1[pre] A method of segmented file transfer from a Bluetooth enabled mobile device to a web service, the method comprising:
1[a] providing a software module on the Bluetooth enabled mobile device, the software module, performing;
1[b] determining size of a file to be transferred:
1[c1] segmenting said file into data segments at an application layer level;
1[c2] wherein said file is segmented in part due to size of said file and data transfer capabilities of said Bluetooth enabled mobile device;
1[c3] wherein data in said data segments comprises one or more of said file data and data associated with said file data;
1[d] applying a segment identifier to each of said data segments at the application layer level;
1[e] 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[f1] transferring a data segment along with said user identifier and said segment identifier to the web service,
1[f2] 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 configuring the data segment so that the data segments can be reassembled using segment identifiers by the web service;
1[g] receiving a reply message from the web service, corresponding to successful completion of said data segment transfer;

1[h] 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[i] wherein if segmented file transfer is interrupted, the software module further performs:

1[j] 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[k] 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[l] resuming, the segmented file transfer based on the synchronization reply received, for said user identifier.

Ex. 1001, 11:50–12:31. Claims 8, 15, and 21 are also independent and recite limitations similar to those above. *See id.* at 11:50–16:28.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–26	103(a)	Aaltonen, ² Drescher ³
1–26	103(a)	Takahashi, ⁴ Na ⁵

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. § 103 that became effective after the filing of the applications to which the ’757 patent claims priority. Therefore, we apply the pre-AIA version of § 103.

² US 2005/0209927 A1, published Sept. 22, 2005 (Ex. 1005) (“Aaltonen”).

³ WO 2008/028508 A1, published Mar. 13, 2008 (Ex. 1010) (“Drescher”).

⁴ JP 2005-303511, published Oct. 27, 2005 (Ex. 1016) (“Takahashi”).

Petitioner relies on a certified translation of this Japanese language reference included, along with the original reference, in Exhibit 1016. *See* Ex. 1016, 23–45.

⁵ US 2006/0129631 A1, published June 15, 2006 (Ex. 1006) (“Na”).

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1–26	103(a)	Takahashi, Na, Lind ⁶

As does Petitioner, we refer to the first ground above as Ground 1 and the two grounds based on Takahashi as Grounds 2A and 2B. In addition to the cited references, Petitioner relies on the declaration of Dr. Patrick Traynor (Ex. 1003, “Traynor Declaration”).

Before turning to our analysis of these grounds, we address Patent Owner’s arguments that we should exercise discretion to deny institution under 35 U.S.C. §§ 314(a) and 316(b). *See* Prelim. Resp. 2–29.

III. DISCRETION UNDER 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise discretion to deny institution in view of the *Fintiv*⁷ factors. *See* Prelim. Resp. 2–19. In particular, Patent Owner contends the Texas litigation “is already well-developed” and scheduled for trial beginning “on August 4, 2025, two months before the Board would issue a final written decision, if any, in this proceeding.” *Id.* at 2–3.

Petitioner does not address each of the *Fintiv* factors, but instead asserts that “institution ***should not*** be discretionarily denied” because it has provided a *Sotera*⁸ stipulation, i.e., Petitioner stipulates “not to pursue in the parallel district court proceeding the same grounds as in the Petition or any grounds that could have reasonably been raised in the Petition upon institution.” Pet. 94 (citing Ex. 1026 (stipulation)); *see also* Prelim. Reply 1

⁶ WO 2005/109781 A1, published Nov. 17, 2005 (Ex. 1017) (“Lind”).

⁷ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”).

⁸ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 18–19 (Dec. 1, 2020) (“*Sotera*”).

(urging that its *Sotera* stipulation is dispositive and obviates the *Fintiv* analysis here).

In view of Petitioner’s *Sotera* stipulation, we will not exercise discretion to deny institution under 35 U.S.C. § 314(a). The Director has issued guidance stating that, when such a stipulation is presented, the PTAB will not discretionarily deny institution in view of the parallel litigation. Ex. 1025, 3. That guidance is unequivocal and dispositive of the *Fintiv* analysis here.

Nevertheless, Patent Owner attempts to avoid the Director’s guidance, urging that “a *Sotera* Stipulation will never include art which is ineligible for this IPR, such as product prior art, evidence of a prior sale, or public use.” Prelim. Resp. 10. Patent Owner further contends that Petitioner is “the Real Party in Interest” behind four *ex parte* reexamination requests filed by Unified Patents, challenging the ’757 patent and some of Patent Owner’s related patents. *See id.* at 11–15. According to Patent Owner, Petitioner has “already run afoul of its *Sotera* Stipulation by evidently driving” these filings. *See id.* at 14–15.

Patent Owner’s arguments are unavailing. It is always the case that IPR is limited to certain types of grounds and prior art. *See* 35 U.S.C. § 311(b) (limiting the scope of IPR to grounds “under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications”). If anything, this demonstrates a lack of overlap between this proceeding and the Texas litigation—it certainly does not distinguish the Director’s guidance. We also disagree that Petitioner’s alleged involvement in the filing of the reexamination requests Patent Owner identifies runs afoul of its obligations under the *Sotera* stipulation. Petitioner’s obligation not to

pursue grounds in parallel proceedings is conditioned on the institution of *inter partes* review. Ex. 1026, 1. Thus, even assuming *arguendo* Petitioner is a real party in interest behind these reexamination requests, Petitioner’s *Sotera* stipulation did not prevent it from participating in the filing of those petitions prior to our decision to institute *inter partes* review here. For these reasons, Patent Owner’s *Fintiv* arguments are unavailing and we do not exercise discretion to deny the petition under 35 U.S.C. § 314(a).

IV. PATENT OWNER’S ARGUMENT UNDER 35 U.S.C. 316(b)

In addition to its *Fintiv* arguments, Patent Owner advances a separate theory for discretionary denial under 35 U.S.C. § 316(b). That is, Patent Owner contends discretionary denial is warranted to “deter certain types of Petitions” like the one here, which “undermine both the economy and the integrity of the patent system.” Prelim. Resp. 19–20. According to Patent Owner, “[t]he Government is presently executing a preexisting and dynamic policy initiative against the Petitioner and Real Party in Interest (TikTok)” that “implicates foreign policy, national security, and national competitiveness in connection with the technology the Patent Owner accuses of infringement (namely, TikTok’s Data Upload Algorithms)” and instituting *inter partes* review “would transform [the Board] into an instrument that might serve the interests of a company and nation state that [other parts of the government] have openly condemned as acting against the interests of the United States and its citizens.” *Id.* at 20. For this reason, Patent Owner contends “the enumerated § 316(b) factors weigh strongly against institution, regardless of the merits of the Petition” and “should lead to discretionary denial.” *See id.* at 19–29.

In reply, Petitioner points out that § 316(b) “concerns the Director’s prescribing of regulations,” whereas the Petition concerns a Cellspin patent and does not “implicate[] TikTok’s intellectual property, nor . . . ask the Board to take any action concerning TikTok.” Prelim. Reply 2–3. In addition, Petitioner contends that Patent Owner’s argument improperly extends § 316(b) to “considerations of foreign policy and national security” and “would involve an evidentiary review that is not provided for in the IPR procedures.” *Id.* at 3 (internal quotations omitted). According to Petitioner, “[i]t would be improper for the Board to embrace such theories outside of rulemaking after public notice and a comment period have been provided.” *Id.* at 4.

Patent Owner’s argument for discretionary denial under § 316(b) is unavailing. The statute provides that “[i]n prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.” 35 U.S.C. § 316(b). However, Patent Owner identifies no regulation, rule, or Office guidance that supports its argument here. In the absence of such, we decline to apply any discretion the Director may have under § 316(b) to deny the Petition based on the policy considerations and concerns alleged by Patent Owner.

V. ANALYSIS OF THE ASSERTED GROUNDS

A. Legal Standards

Under the pre-AIA version of § 103(a), a claim is unpatentable for obviousness if, to one of ordinary skill in the pertinent art, “the differences between the subject matter sought to be patented and the prior art are such

that the subject matter as a whole would have been obvious at the time the invention was made.” 35 U.S.C. § 103(a) (2006); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner contends a person of ordinary skill in the art (“POSITA”) as of December 28, 2007 would have “had at least a Bachelor of Science in electrical engineering, computer engineering, computer science, or a related field, with at least two years of relevant work experience in wireless communications and/or networking systems, or equivalents thereof.” Pet. 3 (citing Ex. 1003 ¶ 21). Patent Owner does not dispute or otherwise respond to Petitioner’s description of a POSITA in its Preliminary Response.

At this stage, we find Petitioner’s description of the level of ordinary skill in the art to be sufficiently supported by the record and apply it for purposes of this decision.

C. Claim Construction

In an *inter partes* review, claim terms “shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b).

Petitioner contends that “no express constructions are required to institute review and find the Challenged Claims unpatentable.” Pet. 4.

At this stage, Patent Owner identifies one term, “user identifier,” for construction. Prelim. Resp. 31. According to Patent Owner, a POSITA “would have understood the term ‘user identifier,’ in view of the intrinsic record, to mean: ‘a text string that identifies uniquely a user of a web service and contains sufficient information to authenticate a user of the web service.’” *Id.* at 32. As support for that construction, Patent Owner cites Figures 2 and 4 and related disclosure in “Non-Provisional Application No. 11/901,802” (the “’802 application”), “which is incorporated by reference into the disclosure of the ’757 Patent.” *Id.* at 32–34.

On the current record, Patent Owner’s claim construction arguments are unpersuasive for several reasons. First, in addition to reciting a “user identifier,” claim 1 separately recites “wherein said user identifier uniquely identifies a particular user of the web service.” Ex. 1001, 11:66–67. The fact that the surrounding claim language specifies that the “user identifier” must uniquely identify a user “strongly implies” that such a requirement is not required by the term itself. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc) (explaining that the context in which a claim term is used “can be highly instructive” and that the fact that “the claim in this case refers to ‘steel baffles’ . . . strongly implies that the term ‘baffles’ does not inherently mean objects made of steel”); *Digital-Vending Servs. Int’l, LLC v. Univ. of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012) (“the reference in some claims to a ‘registration server being further characterized in that it is free of content managed by the architecture’ strongly implies that the term ‘registration server,’ standing alone, does not inherently mean a

server that is free of managed content”). Moreover, there is no need to construe “user identifier” to include a requirement that it identify uniquely a user of a web service, as in Patent Owner’s proposed construction, because that requirement is apparent from the surrounding claim language.

Second, Patent Owner has not shown that the authentication requirement in its construction, i.e., that the user identifier be a “text string” that “contains sufficient information to authenticate a user of the web service,” is supported by the intrinsic record. Patent Owner’s authentication requirement is not apparent from the claim language, nor has Patent Owner attempted to show that a POSITA would have understood the ordinary meaning of “user identifier” to require such. The only intrinsic support Patent Owner cites are figures and related disclosure describing a preferred embodiment in the ’802 application.⁹ This disclosure uses different terms, e.g., “user preferences” and “login information,” which on this record Patent Owner has not sufficiently connected to the “user identifier” in claim 1. *See* Ex. 2009 ¶¶ 18, 23, 25–26. Even if that connection had been shown, the disclosure Patent Owner cites is permissive in nature, stating, e.g., that “user preferences *may* comprise authentication credentials,” and not that authentication credentials are required. *Id.* ¶ 23. Thus, on the current record, we decline Patent Owner’s invitation to import an authentication requirement into the claims through the construction of “user identifier.”

⁹ Petitioner argues that the ’802 application is not properly incorporated by reference because the ’757 patent incorporates the ’802 application as opposed to the publication of that application. Prelim. Reply 6 (citing 37 C.F.R. § 1.57 (d)(1)–(3)). We do not reach this argument and assume for purposes of this decision that the disclosure Patent Owner cites is properly incorporated into the ’757 patent.

Third, even if there were support for Patent Owner’s authentication requirement, it is unclear how construing “user identifier” to require such might distinguish the challenged claims from the asserted prior art. For example, for element 1[e] in Ground 1 Petitioner cites Drescher’s teachings of HTTP requests that include names “particularising the . . . party, involved in the request” and the use of such information to determine whether that user has sufficient “permission” to access the alleged web service. *See* Pet. 19 (citing Ex. 1010, 25:4–24, 25:32–26:21, 34:13–25:4, 35:26–36:21).¹⁰ On the preliminary record, this showing appears to teach or suggest a “user identifier” even under Patent Owner’s construction. Indeed, Patent Owner does not argue otherwise. *See* Prelim. Resp. 40–44 (offering no argument that Patent Owner’s proposed construction distinguishes the combination in Ground 1). Accordingly, even if we were to adopt Patent Owner’s construction, it would make no difference for our decision to institute.

For these reasons, we do not adopt Patent Owner’s proposed construction of “user identifier.” We also determine that no further claim construction is necessary to resolve the issues presented at this stage of the proceeding. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

¹⁰ We understand the page number in Petitioner’s pinpoint cites to refer to the page number at the bottom of the page in Exhibit 1010. We do the same for our citations herein.

D. Asserted References

i. Aaltonen

Aaltonen is a United States patent application published September 22, 2005. Ex. 1005, code (43). Petitioner asserts, and Patent Owner does not dispute, that Aaltonen qualifies as prior art under 35 U.S.C. § 102(b). Pet. 1.

Aaltonen discloses a system and method for uploading content from a sender, e.g., a blue-tooth enabled mobile station, to a recipient, e.g., a server or digital broadcaster, through the internet. *See* Ex. 1005, Abstr., Fig. 1 (showing terminal 12 connected to origin server 22 and digital broadcaster 32), ¶ 56 (“mobile station can include a Bluetooth (BT) transceiver” and “share and/or obtain data in accordance with Bluetooth transfer techniques”).

Figure 6 of Aaltonen, reproduced below, is a functional block diagram of a sender uploading content to a recipient. *Id.* ¶ 24.

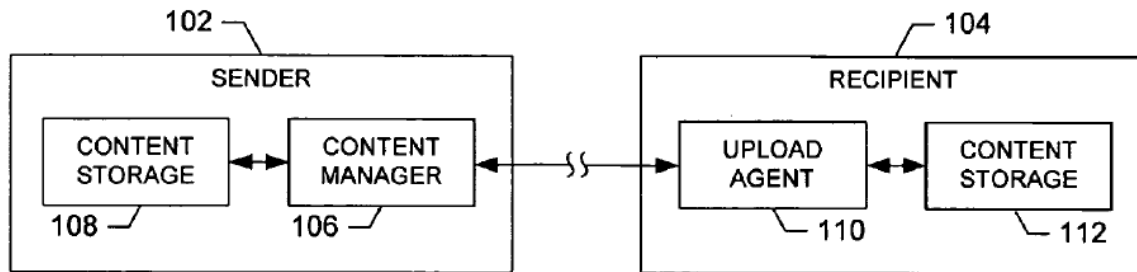


Figure 6 above depicts sender 102 operating a software application, i.e., “content manager 106, which is capable of uploading one or more piece(s) of content” to an upload agent operated by recipient 104. *Id.* ¶¶ 60, 62. According to Aaltonen, the content manager can select pieces of content for upload based on various criteria such as “type, size and/or quality” and generate an upload request with information describing “the content (e.g., size, quality, etc.)” that is transmitted to recipient 104. *Id.* ¶¶ 84–86. An

upload schedule is then determined and transmitted back to sender 102, which then uploads the content per that schedule. *See id.* at Fig. 7 (control flow diagram depicting method for uploading content); ¶¶ 89–91. After receiving the content, “the upload agent can acknowledge the upload” indicating that “the content manager successfully uploaded content to the recipient.” *Id.* at Fig. 7, ¶ 93.

Aaltonen teaches that the upload agent receives content in accordance with hypertext transfer protocol (HTTP) and that the sender can upload content in accordance with an HTTP POST or HTTP PUT technique. Ex. 1005 ¶¶ 16, 98, 101, 111. “In this regard, the content can be uploaded in a number of content data packets.” *Id.* ¶ 101. Figure 10 of Aaltonen, reproduced below, depicts these packets.

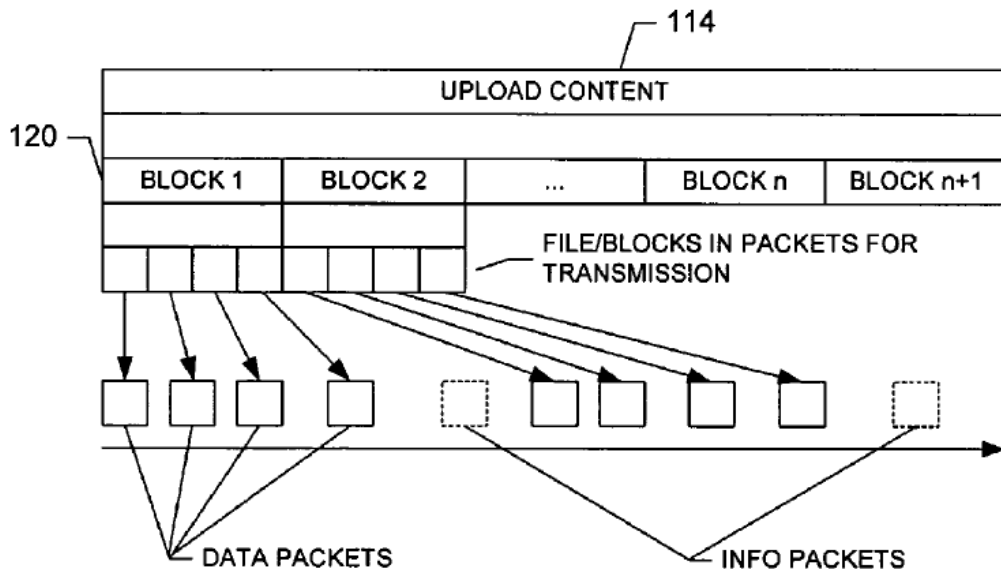


Figure 10 above “illustrates upload content [114] broken down into a number of groups or blocks of one or more data packets with one or more information packets added to the packet stream.” *Id.* ¶ 28. According to Aaltonen, the information packets include “information as to the number of packets in a block of packets,” “information . . . uniquely describing the

packets before or after the information packet,” and “one or more identifiers identifying the sender 102, the information packet, requested content and/or the upload session.” *Id.* ¶ 102.

Aaltonen also describes a “method of upload recovery” when an interruption occurs during an upload. Ex. 1005, Fig. 11, ¶¶ 111–114. According to this method, “[a]fter re-establishing communication with the recipient 104, . . . the sender 102 can request the bit-length or size of the portion of the upload content 114 received by the upload agent” and “upon receiving the length of the received portion of the upload content, the sender can continue uploading the content to the recipient 104 to complete the uploading session.” *Id.* ¶¶ 112–113. Aaltonen teaches that “in accordance with a partial HTTP POST/PUT technique . . . the sender can include header information specifying only the remaining portion of the content, such as a ‘range’ header” in order “to permit the sender to upload, and the upload agent 110 to receive and store only the remaining portion of the content.” *Id.* at 113.

ii. Drescher

Drescher is an international patent application publication published on March 13, 2008 in English from a Patent Cooperation Treaty (PCT) application designating the United States and having an international filing date of September 7, 2006. Ex. 1010, codes (12), (21), (22), (26), (81). Petitioner asserts that Drescher qualifies as prior art under 35 U.S.C. § 102(e). Pet. 1.

Drescher discloses “a protocol for sending large files or resources over the internet.” Ex. 1010, Abstr. In one aspect, Drescher describes dividing a resource into a plurality of chunks and transmitting those chunks

between a client and server using HTTP requests, e.g., HTTP PUT requests. *See id.* at 4:5–5:25, 11:26–32. Drescher teaches that the HTTP “PUT Request includes an instruction to the server to supply in the body of its Response the server’s log of progress in processing the PUT Request” so that “[t]he sever then sends back items of the PUT Response indicating progress as that is made.” *Id.* at 15:23–16:16.

In another aspect, Drescher describes “providing the HTTP request with one or more additional headers containing information identifying one or more entities” that are used to check “whether that entity or combination of entities has permission to access the resource or execute a requested action.” Ex. 1010, 5:26–34. More specifically, Drescher teaches that an “identity provider 220” at the client “adds to each HTTP request 802 sent to the server (i.e. for each chunk, and for PUT and GET) a header for each identity to be transferred” that includes “a name particularizing the role of the . . . party[] involved in the request.” *Id.* at 25:31–26:21. According to Drescher, the identity information in the header can be used by a security system at the server to determine “if those identities have the relevant permissions.” *See id.* at 25:32–26:21.

iii. Takahashi

Takahashi is a Japanese unexamined patent application published October 27, 2005. Ex. 1016, 23 codes (12), (43). Petitioner asserts, and Patent Owner does not dispute, that Takahashi qualifies as prior art under 35 U.S.C. § 102(b). Pet. 1.

Takahashi describes an image storage system and transmission program in which “[i]mmmediately after capturing an image, a mobile telephone 1 divides the captured image data into predetermined size [data]

and sequentially sends the data to an image storage server 4 as an HTTP request.” Ex. 1016, 23 (Abstr.), ¶ 30 (brackets in original); *see also id.* ¶¶ 49, 57–58 (describing dividing and transmitting image data in pieces “[i]f the size of the image data is larger than a predetermined size”).

According to Takahashi, a “division number (Ex. 5/10, or the like)” need not be included in the HTTP request because the mobile phone “adopts a sequential transmission rule for transmitting a divided file one at a time and transmitting the next divided file after waiting for the response of the reception completion on the image storage server [] side.” Ex. 1016 ¶ 58. However, Takahashi also explains that it is not limited to such and a “division number may be attached and sent, if needed.” *Id.* In addition, Takahashi teaches that “a user ID specific to a user” is included in the file name for the captured image data such that after the image is transmitted to the server “a user can be identified by the file name of the image data, without having to authenticate the user with a password, or the like.” *Id.* ¶¶ 32, 35, 56 (explaining that the file name includes the user ID and system date).

iv. Na

Na is a United States patent application published June 15, 2006. Ex. 1006, code (43). Petitioner asserts, and Patent Owner does not dispute, that Na qualifies as prior art under 35 U.S.C. § 102(b). Pet. 1.

Na discloses “controlling a media message upload” by exchanging “requests and responses... between a communication terminal and a server.” Ex. 1006, Abs., ¶ 1. Na teaches that HTTP protocol is used for the media data uploading. *Id.* ¶¶ 52, 62. Na explains that, per the HTTP 1.1 protocol, the media data is segmented; data segments are transmitted in request

messages; and “response messages are repeatedly issued . . . for verification of the upload.” *Id.* ¶¶ 3–5.

Na also discloses steps for recovering from an “interruption” such as “an upload error” or “a closed connection” during an upload. Ex. 1006 ¶¶ 54, 70, 84–87, 91–94, 113–115, 139–157, Figs. 11–12, 24–25. Figures 12 and 25 of Na illustrate procedures for resuming an upload of media when a connection is reestablished following an interruption. *Id.* ¶¶ 36, 91–97 (Fig. 12); 49, 148–157 (Fig. 25). For example, Figure 25 is reproduced below.

FIG. 25

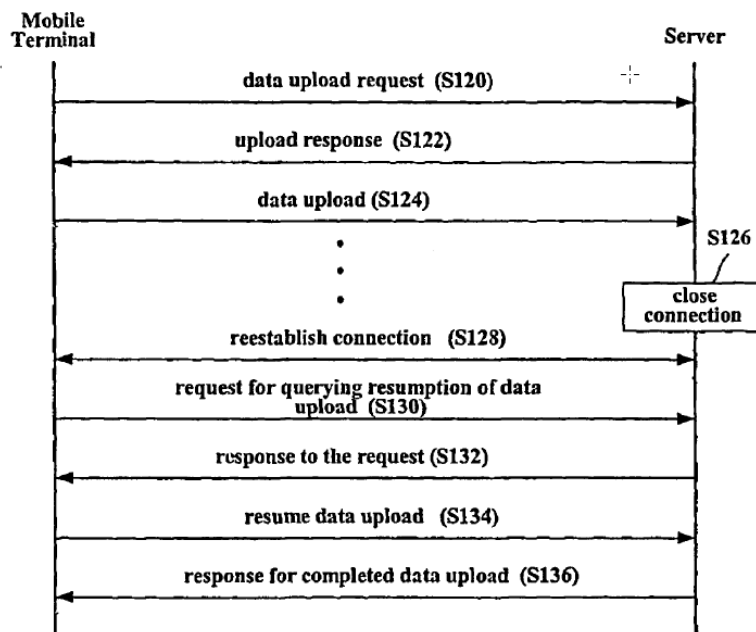


Figure 25 above is a “flowchart of the procedure for resuming an upload of media data stopped by a user.” *Id.* ¶ 49. According to this procedure, after the connection is reestablished (S128), the mobile terminal “issues a request for querying where to resume the upload” (S130), the server responds to that request with a “header including the range of data that has been uploaded

already” (S132), and then the mobile terminal “begins uploading a portion of the media data that needs to be uploaded additionally” (S134). *Id.* ¶¶ 152–156.

v. *Lind*

Lind is an international patent application published November 17, 2005. Ex. 1017 code (43). Petitioner asserts, and Patent Owner does not dispute, that Lind qualifies as prior art under 35 U.S.C. § 102(b). Pet. 1.

Lind describes “electronic devices which are capable of being interconnected . . . by means of Bluetooth.” Ex. 1017, 7:27–29.¹¹ “Such devices include . . . mobile telephones.” *Id.* at 7:31–8:1.

E. Petitioner’s Ground 1

Petitioner contends claims 1–26 would have been obvious over Aaltonen and Drescher. *See* Pet. 4–39. Patent Owner asserts that Ground 1 fails because Drescher does not qualify as prior art. Prelim. Resp. 40-44.

Beginning with claim 1, Petitioner contends that Aaltonen teaches or suggests a method comprising the limitations of claim 1. *See* Pet. 8–30 (mapping Aaltonen’s disclosure to each limitation in claim 1 and citing supporting testimony from Dr. Traynor). Petitioner relies on Drescher as additional support for certain aspects of limitations 1[e] and 1[g]. *See id.* at 19, 23–24 (mapping Drescher’s disclosure and citing supporting testimony). More specifically, Petitioner asserts that a POSITA would have

found it obvious to combine the teachings of Aaltonen and Drescher such that (1) HTTP responses are used to acknowledge data blocks that are successfully received by the recipient via Aaltonen’s HTTP PUT/POST techniques, based

¹¹ Citations refer to the page numbers at the bottom of each page in Exhibit 1017.

on Drescher, and (2) party-identifying information are added to Aaltonen's HTTP PUT/POST messages, based on Drescher.

Id. at 6. Regarding the first point above, Petitioner contends it would have been obvious to send an acknowledgement “for each block” both to indicate that the “successfully received data could be deleted from the sender's content storage,” and because it “would have acted as another means for the sender to expediently detect service interruptions.” *Id.* at 7. Regarding the second point, Petitioner contends “that adding party-identifying information to data transfer messages improves the security of Aaltonen's data transfer techniques, as the recipient can identify when a message is received from a source that does not have ‘permission’ to upload data to the recipient.” *Id.* at 7–8. Petitioner supports these contentions with testimony from Dr. Traynor and other evidence. *See id.* (citing exhibits).

At this stage, Patent Owner does not dispute any aspect of Petitioner's mapping of the references' disclosures to the limitations in claim 1, nor does it dispute Petitioner's rationale explaining why it would have been obvious to combine them as articulated in Ground 1. Prelim. Resp. 40–44 (arguing only that Drescher does not qualify as prior art). Having reviewed Petitioner's showing on the current record, we find it sufficient to meet the burden for institution.

We also agree with Petitioner that Drescher qualifies as prior art under 35 U.S.C. § 102(e). Pet. 1. Under the version of section 102(e) applicable here an invention described in a published patent application filed in the United States qualifies as prior art. 35 U.S.C. § 102(e) (2012). However, as Patent Owner acknowledges, that statute further provides that:

an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Prelim. Resp. 41–42 (citing “pre-AIA § 102(e)”).

Drescher meets these requirements. It is an international application designating the United States that was published in English under the PCT by the World Intellectual Property Organization (WIPO). Ex. 1010, codes (12), (21), (22), (26), (81). Accordingly, Drescher is available as prior art as of its international filing date (i.e., September 7, 2006). MPEP § 901.03 (“[A] WIPO publication of an international application under PCT Article 21(2) [is] considered to be prior art under pre-AIA 35 U.S.C. 102(e) as of the international filing date . . . if the international application was filed on or after November 29, 2000, designated the United States, and was published under PCT Article 21(2) in English.”); *see also EnOcean GmbH v. Face Int’l Corp.*, 742 F.2d 955, 957 n. 3 (Fed. Cir. 2014) (“The Burrow reference is a published PCT application Since the Burrow reference was filed on or after November 29, 2000, designated the United States, and was published in English it is available as prior art as of its PCT filing date.”).¹² Because Drescher’s international filing date predates the filing date of the earliest application to which the ’757 patent claims priority (i.e.,

¹² Patent Owner cites “United States’ Declaration under PCT Article 64(4)(a)” in support of its argument that Drescher is not prior art. *See* Prelim. Resp. 42–43. That declaration dates back to 1978. *Id.* at 43 (stating the declaration “will take effect on May 10, 1978”). It does not reflect the version of § 102(e) applicable here, which includes amendments made effective for international applications filed after November 29, 2000. *See* Pub. L. No. 107–273, §§ 4505, 4508, 116 Stat. 1758.

December 28, 2007), Petitioner has established on the current record that Drescher is prior art to the challenged claims.

For these reasons, Petitioner has established a reasonable likelihood that it will prevail in demonstrating that claim 1 is unpatentable as obvious over Aaltonen and Drescher.

Petitioner's showing for claims 2–26 is also sufficient for institution. The Petition presents evidence and argument sufficient to support Petitioner's assertion that the cited references teach or suggest the limitations recited in each of these claims. Pet. 30–39 (addressing claims 2–26). At this stage, Patent Owner does not make any additional arguments against Petitioner's showing for these claims and its argument that Drescher is not prior art is unavailing as explained above.

F. Petitioner's Grounds 2A–B

In Ground 2A, Petitioner contends claims 1–26 would have been obvious over Takahashi and Na. *See* Pet. 40–93. For Ground 2B, Petitioner adds teachings in Lind to its combination of Takahashi and Na, urging that claims 1–26 would have been obvious over the same. *Id.*

Petitioner contends that “Takahashi discloses transmitting divided media data using HTTP requests.” Pet. 43. According to Petitioner, this disclosure teaches or suggests most of the claim limitations. *See id.* at 47–71. However, Petitioner notes that “Takahashi does not appear to disclose details regarding the HTTP protocol and HTTP requests.” *Id.* at 43. Accordingly, Petitioner argues that a POSITA would have been motivated “to complement Takahashi with Na's detailed disclosure of the HTTP protocol and the HTTP requests used for media data uploading.” *Id.* Petitioner further contends a POSITA would have been motivated “to incorporate Na's

teachings in Takahashi’s system to beneficially allow ‘an upload of media data stopped by an upload error to be resumed from the point where the error occurred,’ as taught by Na,” including the use of a segment identifier so that “media data is ‘easily identified [by the server] when the data upload is stopped and resumed afterwards.’” *Id.* at 33–34 (quoting Ex. 1006 ¶¶ 8, 10, 12). According to Petitioner, the combination of these concepts from Na with Takahashi’s methodology teaches or suggests all of the limitations of claim 1, rendering it obvious.¹³ *Id.* at 47–82 (mapping the combination of Takahashi and Na to various limitations).

Because the burden for institution has been met for Ground 1, we need not determine whether Petitioner has also shown a reasonable likelihood of prevailing on its challenges in Grounds 2A–B. However, to provide guidance for developing these issues at trial, we note some initial skepticism regarding Patent Owner’s preliminary arguments. *See* Prelim. Resp. 44–61.

Patent Owner’s arguments fall into three general categories. First, Patent Owner identifies limitations it contends Takahashi fails to disclose. *See* Prelim. Resp. 44–47. For example, Patent Owner contends that Takahashi does not disclose “synchronization messages” or a “segment identifier” because it “teaches the full termination of an upload if the connection is in any way interrupted.” *Id.* at 44–46. On the current record, such arguments are unavailing because they do not sufficiently address the asserted combination of references. *See, e.g., Soft Gel Techs., Inc. v. Jarrow*

¹³ For Ground 2B, Petitioner relies on Lind as additional evidence that a POSITA would have understood that the mobile phones disclosed in Takahashi and Na were BT enabled. *See* Pet. 45–47.

Formulas, Inc., 864 F.3d 1334, 1341 (Fed. Cir. 2017) (“[N]on-obviousness cannot be established by attacking references individually.”). As explained above, the Petition relies on Na’s teachings regarding recovery from an interruption in combination with Takahashi to address these limitations.

Second, Patent Owner argues the combination of Takahashi and Na is inoperable because of security issues. *See* Prelim. Resp. 47–51. According to Patent Owner, “HTTP 1.1 advised *against* sending filenames via HTTP” and the “*only* way to send uploaded file names via HTTP messages was by using ‘Content Disposition,’” which “is a response-type header field” that was “plainly disfavored . . . because of its security risks.” *Id.* at 48 (quoting Ex. 2012, 154). For this reason, Patent Owner contends a POSITA “would not have been inclined to combine the known insecurity of embedding the user-name within the file name” as taught by Takahashi with the teachings in Na. *See id.* at 48–51.

On the current record, Patent Owner’s argument is not well-founded because it is insufficiently explained and seemingly contradicted by the same HTTP protocol document Patent Owner relies upon. *See* Ex. 2012, 154 (explaining that despite security concerns, the Content-Disposition header in HTTP “is widely implemented”). Moreover, claim 1 does not appear to recite security as a limitation. Thus, the fact that the asserted combination may present security concerns does not, in and of itself, demonstrate that the combination is inoperable. *See Axonics, Inc. v. Medtronic, Inc.*, 73 F.4th 950, 957 (Fed. Cir. 2023) (“The inquiry [for obviousness] is not whether a relevant artisan would combine a first reference’s feature with a second reference’s feature to meet requirements of the first reference *that are not requirements of the claims at issue.*”) (emphasis added).

Third, Patent Owner contends the teachings of Takahashi and Na are incompatible because Na is “plainly directed to phone MMS (Multimedia Messaging Service) technologies for the uploading of messages that are different from phone SMS messages.” Prelim. Resp. 51–52. To this end, Patent Owner argues there are differences in the relevant architectures such that the “proposed combination of Takahashi and Na would not have performed properly.” *Id.* at 52–55 (urging that in MMS “there is no available field for ‘Filename,’” and “Petitioner fails to expand upon precisely *how* a POSITA would combine the two disparate message (MMS versus Web) formats when their respective header and message bodies are incompatible”). Relatedly, Patent Owner contends “there is no ‘User ID’ or even a ‘File name’ in Na” and the attributes Petitioner cites in Na (i.e., X-msg-id, terminal number, and user agent information) do not uniquely identify a particular user. *See id.* at 55–61.

On the current record, Patent Owner’s arguments are unavailing to the extent they misapprehend the asserted combination of Takahashi and Na. The Petition relies on Takahashi’s disclosure of a user ID as the unique identifier recited in element 1[e]. Pet. 58–59. Petitioner asserts that it would have been obvious to “apply Takahashi’s file name including the user ID (*‘user identifier’*) to each divided image data (*‘data segment’*)” based on Na. *Id.* at 59. Thus, even assuming Na is primarily directed to MMS and MMS lacks a file name, the combination in Grounds 2A–B is not premised on the incorporation of Takahashi’s file name into the MMS format, but rather modifying Takahashi based on concepts taught in Na. Moreover, the Federal Circuit has explained that the test for obviousness is not whether teachings can be bodily incorporated from one reference to the other. *See*

Axionics, 73 F.4th at 957 (“[A] skilled artisan may be motivated to combine particular features of different references, e.g., to secure some benefits at the expense of others, even when bodily incorporation would be impossible or inadvisable.”); *Intel Corp. v. PACT XPP Schweiz AG*, 2023 WL 2198649, *3 (Fed. Cir. Feb. 24, 2023) (explaining the Board erred by requiring evidence that a mechanism in one reference could be “bodily incorporated” into the system in the other reference).

This is not to say that Patent Owner’s arguments are entirely unfounded. As Patent Owner points out, Petitioner seemingly shifts its mapping for the “user identifier” from Takahashi’s file name in element 1[e] to other attributes in Na for “said user identifier” in elements 1[j]. *See* Pet. 72–75 (referring to Na’s “X-Msg-id,” “terminal number,” and “user agent information”). It may be, as Patent Owner asserts, that these other attributes do not uniquely identify a particular user and therefore are not themselves a “user identifier” as recited in claim 1. *See* Prelim. Resp. 58–61. Similarly, it may be that, despite Petitioner’s showing on the current record, there are persuasive reasons why a POSITA would not have had a reasonable expectation of successfully combining Na’s teachings with Takahashi’s methodology. However, these are complex, fact-intensive issues that would benefit from expert testimony and further development at trial.

VI. CONCLUSION

Based on the current record, we determine Petitioner has shown a reasonable likelihood that it will prevail in establishing that at least one claim of the ’757 patent is unpatentable. Accordingly, we institute review of all claims challenged on all of the grounds in the Petition. *See* Consolidated

Trial Practice Guide (Nov. 2019), 64, available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim. Our view with regard to any finding or conclusion reached in the foregoing analysis could change upon completion of the record.

VII. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 1–26 of the '757 patent based on the unpatentability challenges presented in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this decision.

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Patent 8,862,757 B2

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