

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK INC.,
Petitioner,

v.

CELLSPINSOFT, INC.,
Patent Owner.

IPR2024-00760
U.S. Patent No. 8,898,260

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. § 42.107**

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Order dated June 11, 2024 [Dkt. No. 47]
2002	Minute Entry dated June 25, 2024 [Dkt. No. 51]
2003	Docket Control Order [Dkt. No. 35]
2004	TikTok Invalidity Contentions dated June 6, 2024
2005	TikTok Answer and Counterclaims [Dkt. No. 11]
2006	Cohen Declaration (as filed in IPR2021-00476 at Exh. 2004)
2007	Harrison Declaration (as filed in IPR2021-00476 at Exh. 2005)
2008	TikTok Complaint in USCA Case No. 24-1113
2009	Published Application No. 11/901,802
2010	Open Mobile Appliance MMS Client Transactions, Version 1.1 (October 31, 2002)
2011	Open Mobile Appliance MMS Encapsulation Protocol, Version 1.1 (July 15, 2004)
2012	HTTP 1.1

Patent Owner CellspinSoft, Inc. (“Cellspin”) respectfully opposes Petitioner TikTok Inc.’s (“TikTok” or “Petitioner”) Petition for *Inter Partes* Review of U.S. Patent No. 8,898,260 (Exh. 1001, “the ’260 Patent”).

As a threshold matter, this Board should exercise its discretion and decline to institute in view of the well-established *Fintiv* framework. As set forth herein, all *Fintiv* factors weigh *against* institution, and the existing District Court schedule is well ahead of the target date for a Final Written Decision (should institution be granted). Moreover, a number of unique circumstances exist which merit strong discretionary consideration by this Board. Broadly, and as explained more fully below, the ongoing geopolitical situation involving Petitioner TikTok and the Chinese and American governments renders institution here contrary to the wider interests of the United States.

Even beyond these extraneous factors, the Board should alternatively deny institution in view of the fact that Petitioner has not established a reasonable likelihood of proving the challenged claims unpatentable by a preponderance of the evidence. Not only is Petitioner’s primary reference unavailable for use as prior art,

the cited references themselves are not combinable and otherwise fail to teach key features of the Challenged Claims.

I. THE BOARD SHOULD DENY INSTITUTION IN VIEW OF *FINTIV*

The Petition seeks to review a patent asserted in the pending district court litigation between the same parties: Plaintiff CellspinSoft, Inc., and Defendants Bytedance Ltd., Bytedance Pte. Ltd., and TikTok Pte. Ltd. [Case No. 2:23-cv-496-JRG-RSP (E.D. Tex., filed Oct. 23, 2023)]. Critically, the ongoing district court litigation between these parties is set for trial on August 4, 2025, which is two months before a Final Written Decision would be due (if instituted at all) here. This fact alone is dispositive. Under *Apple Inc. v. Fintiv, Inc.*, “a parallel proceeding in an advanced state implicates considerations of efficiency and fairness, which can serve as an independent reason to apply discretion to deny institution.” See IPR2020-00019 (hereafter as “*Fintiv*”), Paper 15 at 11 (P.T.A.B. May 13, 2020).

Here, the ongoing district court case is already well-developed. The parties have spent significant resources on discovery and related motion practice directly impacting the issue of validity, including challenges to the sufficiency of party discovery. See Exh. 2001 and Exh. 2002. Given the advanced stage of the district

court case, by the time a decision even on institution will be due, fact discovery will have been ongoing for approximately six months, and the parties are already exchanging deposition notices for the intervening timeframe. *See* Exh. 2003 (Docket Control Order) (Order entered on April 19, 2024; Substantial Production Deadline of January 14, 2025; Trial Date Set for August 4, 2025). Moreover, as mentioned above, the jury trial involving the challenged patent is scheduled to begin on August 4, 2025, two months before the Board would issue a final written decision, if any, in this proceeding. Thus, given the advanced stage of the district court case relative to the Petition, the Petition should be denied institution under 35 U.S.C. § 314(a) to avoid needless expenditure of the Board's scarce and valuable resources. *See NHK Spring Co. v. IntrIPlex Techs., Inc.*, IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018) (denying institution where the district court proceeding had progressed beyond the close of fact discovery and trial would take place before issuance of the Board's final written decision); *see also Fintiv*, Paper 15 at 13. Indeed, the Board has identified six specific factors relating to the question of "whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding," in line with

NHK Spring – each of which supports denial here (the “*Fintiv* Factors”). *Fintiv*, Paper 11 at 6.

As set forth below, a fair balancing of the *Fintiv* Factors demonstrates that both the efficiency and integrity of the America Invents Act are best served by denying institution of this Petition.

A. *Fintiv* Factor 1: Whether the court granted a stay or whether evidence exists that one may be granted if a proceeding is instituted.

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts,” and thus “weigh[s] against exercising the authority to deny institution under *NHK*.” *See Fintiv*, Paper 11 at 6. The Defendant in the district court has not moved for a stay in view of this Petition and there is no reason to believe it will do so. Likewise, Patent Owner has no plan to move for a stay, and prefers to move forward with all efficiency on the current district court schedule. Moreover, it is unlikely that Judge Gilstrap, the presiding judge in the district court case, would grant a stay at this late stage, especially in view of his established three-factor test as follows:

1. Whether the stay will unduly prejudice the nonmoving party;
2. Whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set; and
3. Whether the stay will likely result in simplifying the case before the court.

See Solas OLED Ltd. v. Samsung Display Co., 2020 WL 4040716 at *1 (E.D. Tex. July 17, 2020) (quoting *NFC Techs. LLC v. HTC Am., Inc.*, Case No. 2:13-cv-1058-WCB, 2015 1069111, at *2 (E.D. Tex. Mar. 11, 2015) (Bryson, J.).

As a threshold issue, Judge Gilstrap “has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.” *See System Stormseal PYT Ltd. v. SRS Dist., Inc.*, 2024 WL 1995432 at n.9 (E.D. Tex. May 6, 2024) (characterizing defendant’s arguments to the contrary as “irrelevant”). Accordingly, any motion to stay related to this Petition would be considered premature in the district court until *after* an institution decision (if any) is made in this case. By that time, the first prong of the district court’s three-factor test (*e.g.*, “Whether the stay will unduly prejudice the nonmoving party”) would weigh strongly against a stay for multiple independent reasons. First, at that time, the

rapidly-approaching TikTok Ban H.R. 815 and its impacts on the national security of the United States (as discussed below) would be looming. Second, the district court would be in the claim construction phase, with its trial date moving ever closer. Moreover, it is well established that Plaintiffs' timely enforcement of their patent rights is entitled to some weight, even if that factor is not dispositive. Plaintiffs have also already incurred substantial expenses with this litigation, which would be further exacerbated by additional delay.

Similarly, the second prong of the district court's three-factor test (*e.g.*, "Whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set") weighs against a stay for similar reasons. Again, the district court will be in the advanced stages, and a trial date has been long-established.

Finally, the third prong of the district court's three-factor test (*e.g.*, "Whether the stay will likely result in simplifying the case before the court") is, at best, neutral. The consolidated district court litigation involves seven patents and the scope of the district court litigation is much broader than the instant Petition. Thus, the Board would have to institute all seven petitions, but even then there would remain

substantial non-addressed invalidity issues for the district court to resolve, including eligibility under § 101, as well as art which is ineligible here (such as product prior art, evidence of a prior sale, and public use). Moreover, Petitioner has put forward a sizeable prior art products defense in which it has identified a number of prior art products for the asserted patents. *See* Exh. 2004 at pages 8 and 12-13. Petitioner has also integrated technical information from these prior art products into its invalidity defenses. As a result, removing the printed publication prior art from Petitioner's invalidity case would have only a minor impact, if any, on the scope of work for the district court. As such, it is extremely unlikely that Judge Gilstrap would grant a stay, even if Petitioner were to request one.

For these reasons, *Fintiv* Factor One weighs in favor of the Board exercising its discretion to deny institution pursuant to § 314(a).

B. *Fintiv* Factor 2: The proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.

As explained in *Fintiv*, "[i]f the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under NHK." *Fintiv*, Paper 11 at 9. Such is clearly the

case here. As discussed above, the district court trial date is set for August 4, 2025, and the Board's final written decision will be due *two months later* on October 5, 2025. Just as in *Fintiv*, the difference between the dates was two months and the Board found that this factor weighed "somewhat in favor" of discretionary denial. *Fintiv*, Paper 15 at 13. Moreover, in this case, the fast-approaching *shutdown of TikTok* by January 19, 2025 (H.R. 815) causes this factor to weigh even more heavily towards a discretionary denial of institution. To reiterate, this Board takes the district court's current schedule at "face value, absent some strong evidence to the contrary." *See Fintiv*, Paper 15 at 13. Petitioner offers no credible evidence demonstrating that the August 4, 2025 trial setting will be moved, nor can it. As such, this factor weighs heavily in favor of discretionary denial.

C. *Fintiv* Factor 3: The investment in the parallel proceeding by the court and the parties.

This factor is largely subsumed within Factors 1 and 2, insofar as it is used to assess the likelihood of a stay by the district court, with the corresponding avoidance of duplicative cost or effort. *Fintiv*, Paper 11 at 10. Given the substantial activity conducted in the district court to date, this factor again strongly weighs in favor of

discretionary denial. The parties have exchanged infringement contentions and invalidity contentions, as well as subject-matter eligibility contentions. Moreover, a number of depositions have already been taken. *See, e.g., Intel Corp. v. VLSI Tech. LLC*, IPR2020-00498, Paper 16 at 7-8 (P.T.A.B. August 19, 2021) (finding that issuance of a claim construction order and service of final infringement and invalidity contentions was sufficient investment to warrant discretionary denial).

Still further, the Court has invested time conducting multiple hearings between the parties to resolve various discovery disputes, motions to compel, and Petitioner's Motion to Transfer.

Yet still further, given the national security concerns and the fast-approaching shutdown of TikTok by January 19, 2025 (H.R. 815) it is extremely unlikely that Judge Gilstrap, the presiding judge in the district court case, would grant a stay in this case.

The district court case has advanced such that both the parties and the Court have invested significant resources. Because the exact issues presented by the Petition will almost certainly be tried to at least one jury well before any Final Written Decision would issue on the Petition, and Patent Owner will have invested

enormous resources into the parallel litigations. On these facts, *Fintiv* Factor Three weighs heavily in favor of discretionary denial.

D. *Fintiv* Factor 4: The overlap between issues raised in the petition and in the parallel proceeding.

As a threshold matter, it is emphasized here 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. *Philip Morris Products SA v. RAI Strategic Holdings, Inc.*, IPR2020-01094, Paper 9 at 21-23 (PTAB January 25, 2021); *see also* 35 U.S.C. § 311(b). This point becomes critical in this case, given the fact that the Petitioner TikTok (in its Invalidity Contentions as served in the District Court) raised purported prior art devices and/or 102(g) prior art defenses *for all 7 patents*. *See* Exh. 2004 at pages 8 and 12-13. Further, any TikTok *Sotera* Stipulation will never include eligibility issues under § 101, which have also been identified and raised by Petitioner in the district court with respect to all 7 patents. *See* Exh. 2005 at Counterclaim Count II.

In view of the foregoing, *Fintiv* Factor Four weighs in favor of discretionary denial because least one jury would have resolved these issues well before any Final

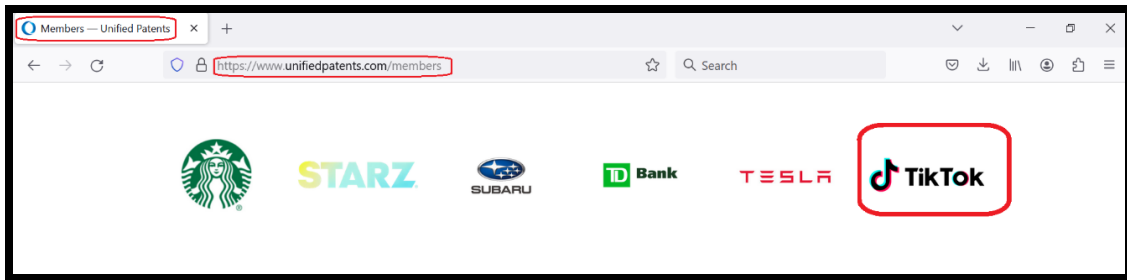
Written Decision would issue on the Petition. These issues will *only* be resolved by the district court, and Patent Owner will have to invest enormous resources into the parallel litigations for such additional invalidity arguments.

Patent Owner further notes that the existing *Sotera* Stipulation executed by Petitioner TikTok states as follows: “TikTok agrees not to pursue any grounds raised in the petition, or any grounds TikTok could have reasonably raised in the petition, in this district court litigation *or any parallel proceeding*.” See Exh. 1026 (emphasis added). Nevertheless, of course, Petitioner filed the instant Petition as one of seven total against Patent Owner, which were all filed within a five-day period. Those Petitions are the following:

- (i) IPR2024-00757 (Patent No. 8,756,336) (Petition filed April 1, 2024)
- (ii) IPR2024-00759 (Patent No. 8,862,757) (Petition filed April 1, 2024)
- (iii) IPR2024-00760 (Patent No. 8,898,260) (Petition filed April 1, 2024)
- (iv) IPR2024-00767 (Patent No. 11,659,381) (Petition filed April 5, 2024)
- (v) IPR2024-00768 (Patent No. 11,234,121) (Petition filed April 5, 2024)
- (vi) IPR2024-00769 (Patent No. 9,900,766) (Petition filed April 5, 2024)
- (vii) IPR2024-00770 (Patent No. 8,904,030) (Petition filed April 5, 2024)

Two weeks later, on April 17, 2024, Unified Patents filed *ex parte* reexamination proceedings against the same Patent Nos. 8,862,757 and 8,898,260. Then, on April 30, 2024, United Patents filed yet a third *ex parte* reexamination

proceeding, this time against Patent No. 8,904,030. Not finished, Unified Patents filed a fourth *ex parte* reexamination proceeding on May 6, 2024 against Patent No. 11,659,381. At the same time, Unified Patents publicized its actions, taking full credit:



See <https://www.unifiedpatents.com/members> (as captured June 20, 2024).

 Unified Patents[®]

NETWORK ZONES ANALYTICS

May 16, 2024

Four separate CellSpinsoft data transfer patents challenged

On April 17, 2024, Unified Patents filed ex parte reexamination proceedings against [U.S. Patent 8,862,757](#) and [U.S. Patent 8,898,260](#), owned and asserted by [Cellspinsoft, Inc.](#), an NPE. The claims of the '757 and '260 patents are directed to uploading multimedia content from a mobile device as segmented data packets and addressing how to handle transmission errors during the uploads.

On April 30, 2024, Unified filed a third ex parte reexamination proceeding against [U.S. Patent 8,904,030](#). The '030 patent is generally directed to uploading data to a remote server, where the data comes from a device that does not have network connectivity. The data is transferred from the capturing device to a mobile device via Bluetooth and then the mobile device uploads the data. The system is set up so that the capturing device can notify the mobile device when new data is available to upload.

On May 6, 2024, Unified filed a fourth ex parte reexamination proceeding against [U.S. Patent 11,659,381](#). The '381 patent, similar to the '030 patent, is directed to uploading data to a remote server using a mobile device as an intermediary, where the data comes from a device that does not have network connectivity.

View [district court litigations by Cellspinsoft](#). Unified is represented by in-house counsel, [Alyssa Holtslander](#), [Jessica L.A. Marks](#), and [Roshan Mansinghani](#), in these proceedings. [Raghav Bajaj](#), of [Haynes Boone](#), drafted the '030 and '381 reexamination requests.

Tagged: Reexaminations, NPE, Ex Parte

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See <https://www.unifiedpatents.com/insights/2024/05/15/cellspinsoft-data-transfer-patents-challenged> (as captured June 20, 2024).

On June 6, 2024, Petitioner TikTok submitted its Invalidity contentions in the ongoing district court action, which included the following statements (in two separate instances) which “incorporate by reference ... all prior art cited during reexamination proceedings” for the challenged patents (including even unknown future proceedings):

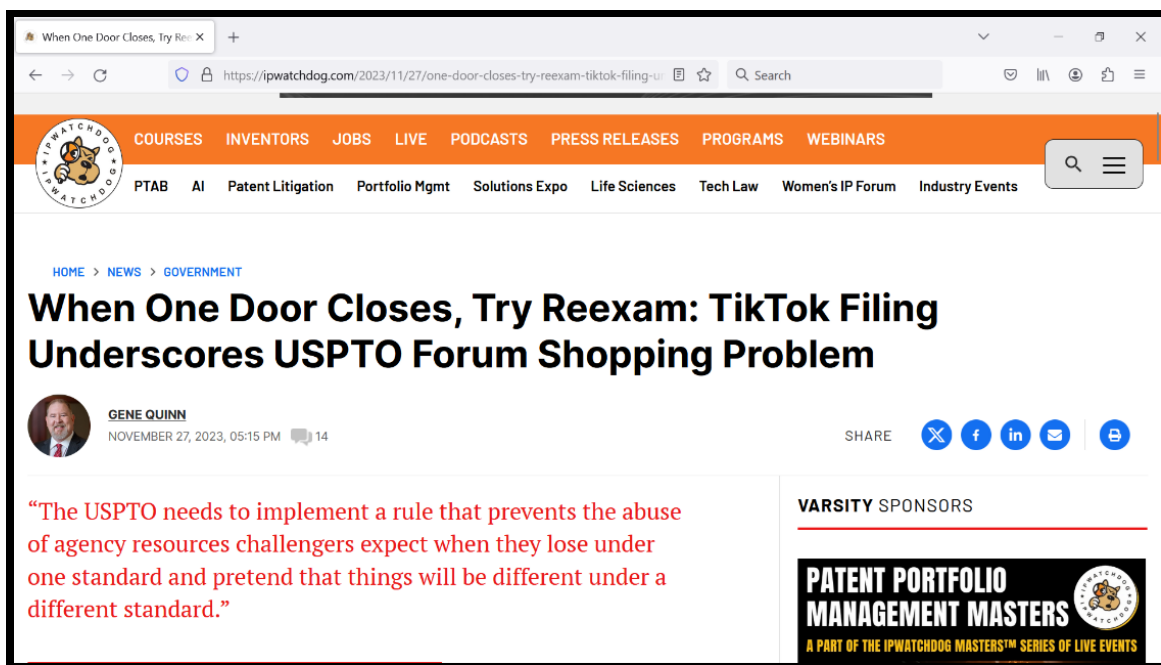
Defendants incorporate by reference, as if set forth fully herein, all prior art cited during the prosecution of the Segmenting Patents, all prior art cited during reexamination proceedings of the Segmenting Patents, all prior art as described in any future *inter partes* review proceedings of the Segmenting Patents, and all prior art disclosed during previous litigation proceedings. *See, e.g.,*

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.,*

See Exh. 2004 (Invalidity Contentions) at 15 and 18.

The problem here is that all circumstantial evidence plainly demonstrates the fact that TikTok is the Real Party in Interest behind the Unified Petitions, inasmuch as TikTok is a known member, and TikTok has a history of similar gamesmanship. Such abuse of the system should not be encouraged or rewarded, and TikTok has

already run afoul of its *Sotera* Stipulation by evidently driving the curious timely filing of the four Unified Patent *ex parte* proceedings. In essence, TikTok seeks to use different parts of the USPTO to invalidate the same patents by circumventing the RPI requirements designed to prohibit such conduct. Again, this is not the first time TikTok has taken this “forum shopping” approach:



See <https://ipwatchdog.com/2023/11/27/one-door-closes-try-reexam-tiktok-filing-underscores-uspto-forum-shopping-problem/id=170003/#> (as captured June 20, 2024).

But this time, rather than directly filing under its own name, TikTok is using Unified Patents as its proxy. Together with Unified, Petitioner TikTok coordinated and filed four *ex parte* actions within a month of filing the instant IPR Petitions. These indirect actions are exactly what two recognized Intellectual Property, National Security, and National Competitiveness Policy experts have opined about; namely, the practice of so-called “lawfare,” in which China’s IP-related industrial policy favors the use of legal tools to advance national technology interests. These issues are discussed in more detail herein below, but typically, such interests have the goal of creating an unbalanced playing field with foreigners. *See* Exh. 2006 (Cohen) and Exh. 2007 (Harrison). To the extent TikTok disputes its involvement in the Unified Patent *ex parte* filings, Patent Owner intends to seek discovery concerning same. Plainly, TikTok cannot be allowed to have three unique “bites at the apple” of invalidating the challenged patents (*i.e.*, district court, IPR, *ex-parte*). Therefore, this factor weighs in favor of discretionary denial.

Again, the exact same art is asserted by Petitioner in the district court, as illustrated in the table below:

Patents	District Court - Invalidity Contentions : Prior Art	PTAB – IPR : Prior Art
8,756,336 8,862,757 8,898,260	("Yang"), ("Jung"), (" <u>Livshits</u> "), ("Price"), ("Crichton"), ("Wagner"), (" <u>Wilcock</u> "), ("Lee"), ("Burns"), ("Li"), (" <u>Takahashi</u> "), (" <u>Drescher</u> "), (" <u>Aaltonen</u> "), (" <u>Lind</u> "), (" <u>Pineau</u> "), (" <u>Na</u> ")	("Takahashi"), (" <u>Drescher</u> "), (" <u>Aaltonen</u> "), (" <u>Lind</u> "), (" <u>Na</u> ")
9,900,766 8,904,030 11,234,121 11,659,381	("Hiroishi"), (" <u>Mashita</u> "), (" <u>Onishi</u> "), ("Takahashi"), ("Ando"), ("Nozaki"), (" <u>Hiraishi</u> "), ("Wagner"), (" <u>Kusaka</u> "), ("Tanaka"), ("Tagliabue"), (" <u>Hollstrom</u> "), ("Berner"), ("Morris"), (" <u>Kahn</u> "), (" <u>Kusaka</u> "), ("Honda"), ("Singh129"), ("Singh906"), ("Rao"), ("Tran"), ("Yamagishi"), (" <u>Lerman</u> "), (" <u>Montulli</u> "), (" <u>Sesek</u> "), ("Adler"), ("Kang"), ("Hunter"), (" <u>Endsley</u> "), (" <u>Pietruska</u> "), ("Yoo"), ("WO Lind"), (" <u>Lind</u> "), (" <u>Rensin 2007</u> "), (" <u>Rensin</u> "), (" <u>Rosenbloom</u> "), (" <u>Barrus</u> "), (" <u>Peart</u> "), (" <u>Steele</u> "), ("Johnson"), ("Mears"), ("Lind"), ("Hull"), ("Walters"), ("Tsukamoto"), ("Peart"), ("King"), ("Park"), ("Ing"), ("House"), ("Hankey"), ("Lydon"), ("Ekberg"), ("Yoichi"), ("Yu"), ("Singh"), ("Toya"), ("Kawamura"), (" <u>Feinberg</u> "), (" <u>BT Specifications</u> ")	("Kahn"), (" <u>Hiroishi</u> "), (" <u>Feinberg</u> "), (" <u>Endsley</u> "), (" <u>Lind</u> "), (" <u>BT Specification</u> ")

As illustrated, all of Petitioners grounds here are equally at issue in the district court litigation. Further, the district court allegations (as made by TikTok) also include an alleged prior art product in combination with the same references asserted in the Petition. As a result, the invalidity case in the district court will completely overlap with the grounds raised in this Petition. Because there is overlap of issues raised in the Petition and the district court case, *Fintiv* Factor Four weighs heavily in favor of denial.

E. *Fintiv* Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party.

This Factor plainly favors denial, as the Petitioner here (TikTok) is the same defendant as in the district court.

F. *Fintiv* Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.

The final *Fintiv* Factor takes into account, *inter alia*, the merits of the Petition in considering whether the discretionary denial should be granted. *Fintiv*, Paper 11 at 14-15. As explained in the *Fintiv* Order, a full analysis is not necessary under this prong; rather, “the parties may point out, as part of the factor-based analysis, particular ‘strengths or weaknesses’ to aid the Board in deciding whether the merits tip the balance one way or another.” *Fintiv*, Paper 15 at 15. Contrary to Petitioner’s assertion, the merits of this Petition are *not* strong. As explained in further detail below, Petitioner has failed to show that the Challenged Patent is not entitled to the priority benefit of its Parent Application under 35 U.S.C. § 112 because of a purported lack of written description.

Each limitation that Petitioner identifies as purportedly lacking support is in fact disclosed by the original Parent Application, together with the references

incorporated therein. Such disclosures cumulatively reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter. As such, the Parent Application satisfies the written description requirement, and Petitioner presents no “other circumstances” that would sway the balance of *Fintiv* Factor Six.

Taken together, the six *Fintiv* Factors weigh in favor of denying institution. Therefore, the Board should exercise its discretion to deny institution of the Petition based on its § 314(a) discretion.

Still further and as detailed below, the Petition does not disclose or suggest key limitations of each of the challenged claims, and therefore does not establish a reasonable likelihood that the Petitioner would prevail with respect to at least one of the claims challenged in the Petition.

II. THE BOARD SHOULD OTHERWISE EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 316(B)

Notwithstanding the clear weight of the *Fintiv* Factors, as discussed in detail above, discretionary denial is important and appropriate in instances such as this, in order to deter certain types of Petitions that undermine both the economy and the

integrity of the patent system. Such extrinsic factors fall within the Board's authority under at least 35 U.S.C. § 316(b). Indeed, these may be the most important reasons for denial in this specific case.

Here, each of the enumerated § 316(b) factors weigh strongly against institution, regardless of the merits of the Petition or other discretionary factors. This is because an IPR (if instituted) would cause the Board to interfere with preexisting high level policy matters playing out in real time in the courts and in other parts of the Executive Branch. The Government is presently executing a preexisting and dynamic policy initiative against the Petitioner and Real Party in Interest (TikTok), one which 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). Institution of a trial, in contrast, would transform a branch of the Department of Commerce (this Board) into an instrument that might serve the interests of a company and nation state that all of Congress, the President, the Department of Justice, and the Office of Intelligence and Security, have openly condemned as acting against the interests of the United States and its citizens.

On April 24 2024, President Biden signed into law a foreign aid package (H.R. 815) containing provisions that would require ByteDance, a China-based company, to *divest* its ownership of the social media platform TikTok *or be banned* from distributing its application in any domestic marketplace. Both houses of Congress and the President have made it clear that H.R. 815 impacts the national security of the United States. See <https://www.congress.gov/bill/118th-congress/house-bill/815/text>. Indeed, before signing the bill into law, President Biden had issued multiple executive actions with a related goal to the TikTok ban: Protecting Americans' sensitive data from being exploited by adversarial "countries of concern." Most recently, the President signed Executive Order (EO) 14117 on February 28, 2024, which seeks to restrain data brokers from selling Americans' data to entities with ties to hostile nations.

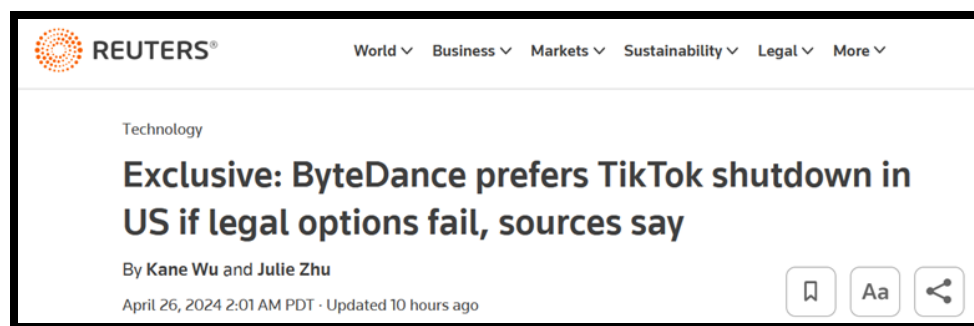
The New York Times

Congress Passed a Bill That Could Ban TikTok. Now Comes the Hard Part.

President Biden has signed the bill to force a sale of the video app or ban it. Now the law faces court challenges, a shortage of qualified buyers and Beijing's hostility.

In raising these issues, Cellspin does not intend to malign Petitioner or its parent company, nor any of its officers or employees. Rather, Cellspin merely raises the obvious point that highly unusual policy factors are impacted by this matter, and the Department of Commerce has already spoken, as the imminent implementation of H.R. 815 will effectively ban TikTok from doing business in the United States.

The best summary of the current state of affairs is that, driven by national security concerns among U.S. lawmakers, H.R. 815 has been overwhelmingly supported in bipartisan fashion, and was promptly signed into law by President Biden. Now, TikTok openly states that the Chinese Communist Party will not allow TikTok to be sold, and it will effectively be shut down on January 19, 2025.



See <https://www.reuters.com/technology/bytedance-prefers-tiktok-shutdown-us-if-legal-options-fail-sources-say-2024-04-25/>.



See <https://www.reuters.com/legal/tiktok-bytedance-sue-block-us-law-seeking-sale-or-ban-app-2024-05-07/>.

Further, in a pleading filed by TikTok in the U.S. Court of Appeals for the District of Columbia, it is alleged that divestiture “is simply not possible: not commercially, not technologically, not legally. ... There is no question: the Act (law) will force a shutdown of TikTok by January 19, 2025, silencing the 170 million Americans who use the platform to communicate in ways that cannot be replicated elsewhere.” See Exh. 2008 at ¶ 3.

Because the national security and related policy issues are unfamiliar in the Board’s day-to-day activities, Patent Owner asks the Board to strongly consider all pertinent § 316(b) factors and exercise its discretion to deny institution. The nature of the parties involved and the nature of the underlying technology, coupled with past United States government recognition of economic, national security and

national competitiveness risks, are relevant here. Further, United States foreign policy relevant to this case is dynamic and is being directed from the highest levels of government. These factors, if nothing else, should lead to discretionary denial of institution for this IPR.

In another IPR (2021-00476), the Patent Owner assisted the Board through its submission of the testimony of two recognized Intellectual Property, National Security, and National Competitiveness policy experts: Mark Cohen (*see* Exh. 2006), and Suzanne Harrison (*see* Exh. 2007). Mr. Cohen explained that instituting the subject IPR would support Chinese industrial policies that target United States technology companies, and would adversely affect the integrity of the patent system. Exh. 2006 at ¶¶ 8-22. This includes specific Chinese government initiatives involving technologies within the international Cooperative Patent Classification (“CPC”). Exh. 2006 at ¶¶ 9-11. Moreover, as explained, China’s IP-related industrial policy favors “lawfare”: the use of legal tools to advance national technology interests, typically with a goal of creating an unbalanced playing field with foreigners. Exh. 2006 at ¶ 14. In Mr. Cohen’s detailed discussion of the many branches of Chinese industrial policy deployed for this effect, he lays out the

extensive nature of Chinese industrial targeting against the technologies and how it undermines the integrity of the market-based United States system. Exh. 2006 at ¶ 21. Factors include non-market interventions that imbalance the playing field: subsidies for Chinese national patent prosecution, IP courts biased against foreigners, export controls designed to prevent corporate sales, and implementation of the “Made in China 2025” plan in a manner adverse to United States interests. Exh. 2006 at ¶¶ 12-17, and 20. On this point, Mr. Cohen concludes that an IPR should not be instituted absent adequate analysis of the potential impact on the domestic economy and the integrity of the patent system due to Chinese industrial policy non-market interventions in the data technology areas. Patent Owner respectfully submits that such analysis is impossible to achieve at the case-by-case adjudication level, and should rather occur through formal rulemaking to involve the expertise of policy experts on all sides of the debate and the USPTO’s own Chief Economist. Mr. Cohen also cogently explains the impact of national security sanctions, and those concerns are further emphasized by the Presidential signing of H.R. 815 and Executive Order (EO) 14117 in 2024. Using the real-world examples of the lengthy dispute (now at the World Trade Organization) brought by Cuba on

United States treatment of the “Havana Club” trademark, plus the current Huawei ban, Mr. Cohen further discusses the nature of the President’s power to prohibit “transactions” involving intellectual property. Exh. 2006 at ¶¶ 23-27. These economic sanctions raise concerns over the timely completion of this IPR (if instituted), and economic impact related to the privacy rights of United States citizens.

Further, instituting this IPR would condone TikTok’s recognized privacy and national security risks, such that past breaches of privacy rights and their close connection with the technology area of the Patent “do not, in my opinion, merit the privilege of initiating an IPR.” Exh. 2006 at ¶¶ 28-31.

Ms. Harrison’s expert policy opinion, meanwhile, approaches these complex issues from a different direction, but largely corroborates Mr. Cohen’s opinion. Naming China as an “Innovation Warfare” adversary, Ms. Harrison explains the negative impact of allowing an instrumentality of such an adversary (*i.e.*, Petitioner) to use an administrative agency of the United States government to potentially destabilize the United States. Exh. 2007 at 24. Ms. Harrison explains what “national competitiveness” is, and how it includes aspects of economics and national security.

Exh. 2007 at 8-9. National competitiveness must address our history of nation states attempting to acquire or misappropriate technology from the United States to enable their own industrial base and/or achieve their own geopolitical goals. Exh. 2007 at 11. She observes that the White House has labeled China's technology transfer activities as "aggression." Exh. 2007 at 12. Ms. Harrison further notes that there is a current government list that names critical and emerging technologies, which includes "Data Science and Storage" – a field encompassing the Cellspin Patent. Exh. 2007 at 13-16. Ms. Harrison also notes that there are current government lists (of various types) that name economic "bad actors." Exh. 2007 at 21. Applying her "Innovation Warfare" counterstrategy expertise, Ms. Harrison explains that these two types of lists lend themselves to the Board's exercise of discretion in appropriate cases; namely, it should be one of our country's "counterstrategies" to an aggressor nation's anti-United States "Innovation Warfare" to foreclose access (under certain circumstances) to the use of a United States federal agency as a tool against a United States patent holder. In this regard, Ms. Harrison proposes a three-part test that should apply to discretionary institution decisions:

- (i) Is the patent at issue related to the Critical and Emerging Technologies list?
- (ii) Is there a likelihood that one or more of the Petitioner real parties in interest are acting as an agent of a nation state?
- (iii) Is there any other relevant information that is deemed pertinent to the case?

See Exh. 2007 at 23-24.

In application, Ms. Harrison explains that a “yes” answer to the first two questions should normally yield an institution denial. Exh. 2007 at 24. Otherwise, a risk exists that the federal agency might become an adversary’s tool against the innovation interests of the nation’s citizens. Exh. 2007 at 26. As a federal agency, of course, the USPTO is expected to comply with and uphold efforts that ensure the safety and security of United States citizens and companies, whether through economic, technological, or national security efforts. Exh. 2007 at 24. Here, Ms. Harrison finds that the answers to questions 1 and 2 are “yes,” and there are no other factors that would merit departing from the default counterstrategy. Exh. 2007 at 25-26. Consequently, Ms. Harrison corroborates Mr. Cohen, and §316(b) factors counsel exercising discretion to deny institution.

Policy experts agree that the nature of the parties involved and the nature of the underlying technology, coupled with past United States Government recognition of economic, national security and national competitiveness risks, are relevant here. Further, United States foreign policy relevant to this case is dynamic and right now being directed from levels far higher than this Honorable Board. These factors, if nothing else, should lead to discretionary denial of institution for this IPR.

III. Argument

As established herein below, the Board should alternatively deny institution in view of the fact that Petitioner has not established a reasonable likelihood of proving the challenged claims unpatentable by a preponderance of the evidence. Not only is Petitioner's primary reference unavailable for use as prior art, the cited references themselves are not combinable and otherwise fail to teach key features of the Challenged Claims.

A. The '260 Patent

The application issuing as the '260 Patent claims priority to December 28, 2007. As of the priority date, the state of the art was deficient in many respects, primarily because there were no viable means of uploading large multimedia files

from mobile devices to websites, particularly due to the limited memory and processing capabilities of such mobile devices at the time. *See* '260 Patent (Exh. 1001) at 5:4-11. Against this backdrop, the Challenged Claims provide a novel methodology for delivering large multimedia files from mobile devices to websites by using synchronization protocol using unique user identifiers and partitioning the content into data segments and using segment identifiers and unique user identifiers for each segmented data at the application layer level. *See id.* As claimed, the novel approach comprises, *inter alia*, a technically superior protocol which partitions multimedia files into data segments at an application layer level, applies a segment identifier and a user identifier to each such data segment (again at the application layer level), and provides for the synchronization of the data during segmented transfer errors to websites using unique user identifiers. *See id.* at Claims 1, 6, 10, and 15.

As the Petition itself makes clear, there is *zero* prior art which even arguably anticipates any Challenged Claim. *See* Paper 2 ("Petition") at 1 (identifying three purported grounds under § 103). This is unsurprising, given the fact that the inventions as claimed recite a number of independently novel aspects (*e.g.*,

synchronization using unique user identifiers, applying segment identifiers, and applying user identifiers to each data segment at the mobile device at the application layer level, and transferring data segments with both user and segment identifiers), not to mention the fact that the state of the art (including Petitioner's expert) had no concept or appreciation of the manner in which to perform such for upload and synchronization from mobile devices in 2007. Beyond this, Petitioner's obviousness arguments fare no better, and aside from a threshold failure to disclose all elements as claimed, such references would never have been collectively considered by one of ordinary skill in 2007 in the first place.

Petitioner's arguments fail. The Challenged Claims should be affirmed as patentable over the cited art.

B. Claim Construction

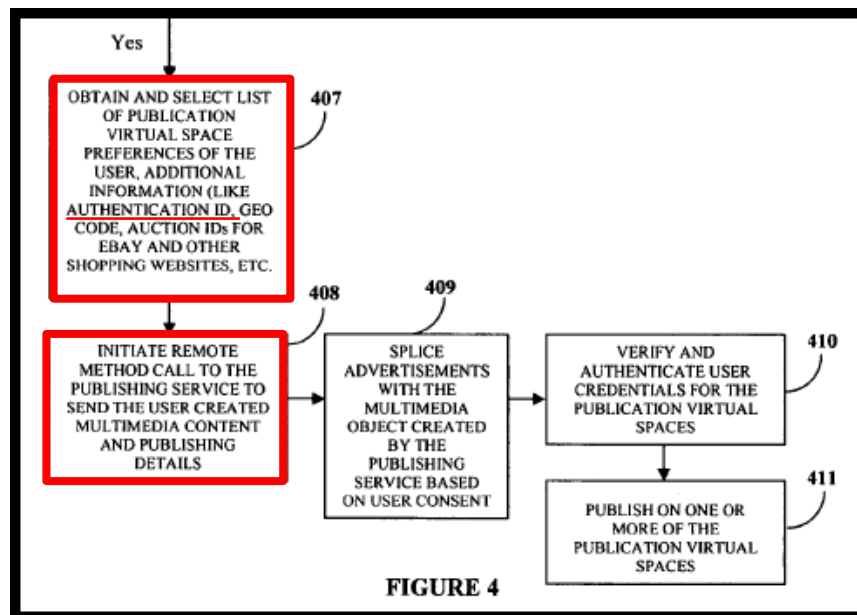
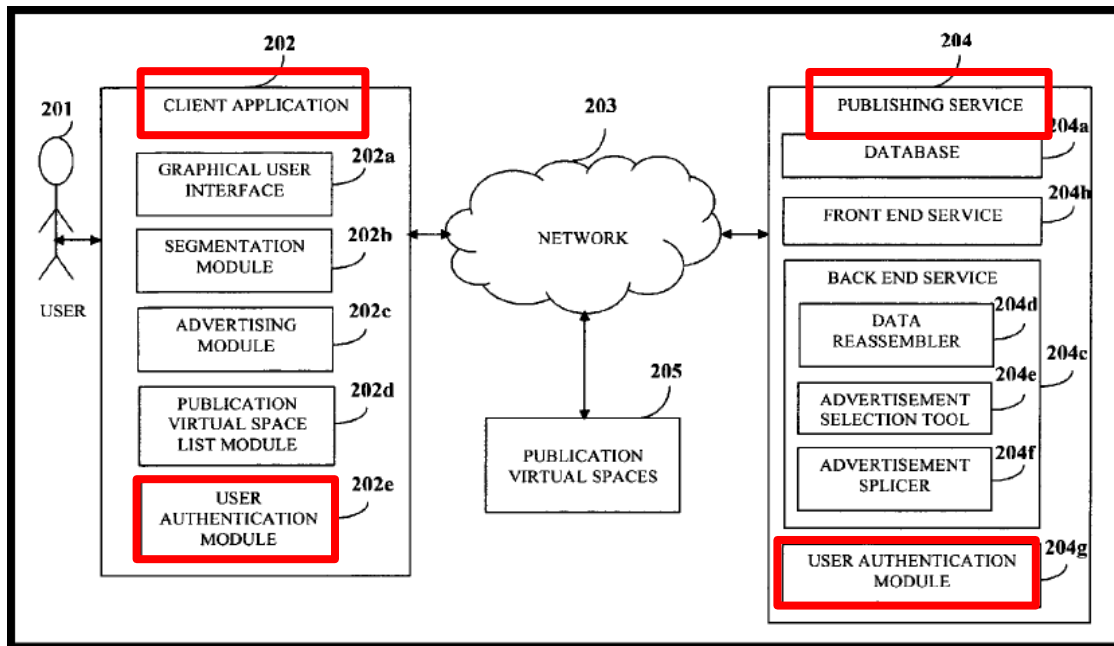
The following claim construction issue is addressed at the outset.

1. user identifier

Patent Owner submits that the Board must construe the term "user identifier" in order to properly assess Petitioner's arguments. The term is used in the Challenged Claims, in context, variably as: "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.*” See ’260 Patent (Exh. 1001) at Claims 1, 6, 10, and 15. Patent Owner suggests that a person of ordinary skill 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.”

By way of support, Patent Owner cites to the disclosure of Non-Provisional Application No. 11/901,802, which is incorporated by reference into the disclosure of the ’260 Patent (*see* ’260 Patent (Exh. 1001) at 1:28-32) and, more specifically, Figures 2 and 4 thereof:



See Application No: 11/901,802 (Exh. 2009) at Figs. 2 and 4.

As taught in the '802 Application: “The client application 202 communicates the user publishing information including the *user preferences* of the publication virtual spaces 205 to the front end service 204b.” *See id.* at [0018] (emphasis added). Further: “The *user preferences may comprise authentication credentials*, transaction identification, a list of publication virtual spaces 205, global positioning system geographical codes, area code for the phone number of the mobile device, file format of the user created multimedia content, and a compression rate of the multimedia content.” *See id.* at [0023] (emphasis added). The '802 Application further teaches: “The user 201 may create an account comprising the *user profile and login information* of the publication virtual spaces 205 configured on the mobile device of the user 201. The client application 202 comprises a graphical user interface 202a (GUI), a segmentation module 202b, an advertising module 202c, a publication virtual space list module 202d, and a *user authentication module* 202e. When the user 201 starts the client application 202 on the mobile device, the user 201 may be authenticated by the *user authentication module* 202e.” *See id.* at [0025-0026]. Still further, the '802 Application teaches that the *authentication credentials* are used for *user authentication*. *See id.* at [0028] and [0035]. As taught: “The multimedia object

is transferred with the user *authentication credentials* to the publication virtual spaces 205. The user 201 provides *login information comprising a username and a password.*” *See id.* at [0037-0038] (emphasis added).

In view of the foregoing, one of ordinary skill would have readily appreciated the fact that the recited “user identifier” meant: “a text string that identifies uniquely a user of a web service and contains sufficient information to authenticate a user of the web service.”

C. Legal Framework

While Patent Owner recognizes the Board’s knowledge and familiarity with the pertinent law as it relates to obviousness, certain principles are emphasized here.

A claimed invention is unpatentable for obviousness under 35 U.S.C. § 103 “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious” to one of ordinary skill in the relevant art. *Intercontinental Great Brands LLC v. Kellogg N. Am. Co.*, 869 F.3d 1336, 1343–44 (Fed. Cir. 2017) (quoting 35 U.S.C. § 103). Under that provision, the challenger must establish by clear and convincing evidence that “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 to a person having ordinary skill in the art to which said subject matter pertains.” *Id.*

When several prior art references are considered, a patent may not be found invalid as obvious unless the party challenging the validity of the patent has provided evidence showing that: (i) “a skilled artisan would have had reason to combine the teaching of prior art references to achieve the claimed invention,” and (ii) “that the skilled artisan would have had a reasonable expectation of success from doing so.” *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1193 (Fed. Cir. 2014); *see also In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful”).

When determining the question of obviousness, the Board must consider the underlying facts, including the scope and content of the prior art, differences

between the claims and the prior art, the level of ordinary skill, and other secondary considerations, if any. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The question of obviousness must be in the context of the claimed subject matter, as a whole. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *see also W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540 (1983) (It is legal error to “consider claims in less than their entirety” and “consider the references in less than their entirety, *i.e.*, disregard disclosures in the references that diverge from and teach away from the invention at hand”); *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014); *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017).

Of course, “[o]bviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). “Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*; *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016) (“Although the

KSR test is flexible, the Board ‘must still be careful not to allow hindsight reconstruction of references . . . without any explanation as to how or why the references would be combined to produce the claimed invention’”). Indeed, the Federal Circuit stated that “it is improper to combine references like separate pieces of a simple jigsaw puzzle without explaining what reason or motivation one of ordinary skill in the art at the time of the invention would have had to place these pieces together.” *Merck Sharp & Dohme B.V. v. Warner Chilcott Co., LLC*, 711 F. App’x 633, 636 (Fed. Cir. 2017) (internal quotations and brackets omitted). “The inventor’s own path itself never leads to a conclusion of obviousness; that is hindsight.” *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012). Specifically, “[i]t is inappropriate to use the template provided by the inventor, to render the inventor’s contribution obvious.” *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018).

When a Petitioner does not articulate a reason to combine references, other than a generic statement of anticipated success in doing so, there is an insufficient showing that an ordinarily skilled artisan would have been motivated to do so. *Hulu, LLC v Soundview Innovations LLC*, IPR2018-01039, Paper 34, 22 (August 5, 2019)

(informative) (discussing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015)) (“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations ... of prior art to arrive at the claimed invention.”); *see also TQ Delta v. Cisco Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (“Rejections on obviousness grounds, in particular, cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” citing *KSR*, 550 U.S. at 418 and *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1068 (Fed. Cir. 2018); *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-94 (Fed. Cir. 2017) (vacating Board’s motivation-to-combine finding because the Board’s “reasoning seem[ed] to say no more than that a skilled artisan, once presented with the two references, would have understood that they could be combined. And that is not enough: it does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention”). Likewise, failure to adequately support a contention that there are a limited number of finite solutions to choose from yields an unsupported petition. *Current Lighting Solutions*

v. Jiaxing Super Lighting Electric Appliance Co., Ltd., 2023 WL 5319763 at *11 (PTAB August 16, 2023).

Prior art combinations which employ differing approaches for different purposes do not support a finding of obviousness. *See, e.g., Ericsson Inc. v. Koninklijke*, IPR2023-00524 at Paper 13 at 34 (FN. 11).

D. Ground One Fails

Petitioner argues that the combination of Aaltonen and Drescher renders each of Challenged Claims 1-18 obvious. *See* Petition at 1. As shown below, Petitioner's arguments with respect to the four independent Challenged Claims (1, 6, 10, and 15) each fail and, as such, all of Petitioner's Ground 1 arguments necessarily fail.

1. Drescher is Not Citable as Prior Art

Petitioner further improperly relies upon Drescher (Exh. 1010) as prior art for combination with Aaltonen. Drescher, however, fails to qualify as prior art, given the fact that (as illustrated below) Drescher is a PCT application with an International Publication Date of March 13, 2008, and a recorded PCT Filing Date of September 7, 2006.

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)	
(19) World Intellectual Property Organization International Bureau (43) International Publication Date 13 March 2008 (13.03.2008)	 PCT
	
(10) International Publication Number WO 2008/028508 A1	
(51) International Patent Classification: <i>H04L 29/08</i> (2006.01) <i>G06F 21/00</i> (2006.01) <i>H04L 29/06</i> (2006.01)	(74) Agents: LEGG, Cyrus, James, Grahame et al.; Abel & Imray, 20 Red Lion Street, London WC1R 4PQ (GB).
(21) International Application Number: PCT/EP2006/008710	(81) <u>Designated States</u> (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, HN, HR, HU, ID, IL, IN, IS, JP, KE, KG, KM, KN, KP, KR, KZ, LA, LC, LK, LR, LS, LT, LU, LV, LY, MA, MD, MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PG, PH, PL, PT, RO, RS, RU, SC, SD, SE, SG, SK, SL, SM, SV, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, <u>US</u> , UZ, VC, VN, ZA, ZM, ZW.
(22) <u>International Filing Date:</u> 7 September 2006 (07.09.2006)	(84) <u>Designated States</u> (unless otherwise indicated, for every kind of regional protection available): ARIPO (BW, GH, GM, KE, LS, MW, MZ, NA, SD, SL, SZ, TZ, UG, ZM, ZW), Eurasian (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IS, IT, LT, LU, LV, MC, NL, PL, PT, RO, SE, SI, SK, TR), OAPI (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).
(25) Filing Language: English (26) Publication Language: English	Published: — with international search report
(71) Applicant (for all designated States except US): FUJITSU LABORATORIES OF EUROPE LIMITED [GB/GB]; Hayes Park Central, Hayes End Road, Hayes, Middlesex UB4 8FE (GB). (72) Inventor; and (75) Inventor/Applicant (for US only): DRESCHER, Michel [DE/GB]; 8 Barnsley Close, Ash Vale, Aldershot, Hampshire GU12 5RH (GB).	
(54) Title: DISTRIBUTED COMPUTING AND COMMUNICATIONS PROTOCOL	

Of course, a reference qualifies under 35 U.S.C. § 102(e) if it satisfies one of the following: (i) an application for patent, published under § 122(b), by another filed in the United States before the invention by the applicant for patent; or (ii) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in § 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. *See* pre-AIA § 102(e).

In a recent review (namely, *Samsung Elecs. Co., Ltd. v. Lynk Labs, Inc.*, No. IPR2022-00149, Paper 33 (P.T.A.B. Jun. 26, 2023) *now pending as* CAFC Appeal No. 23-2346), the Board had instituted trials and found claims unpatentable based on § 102(e) prior art as cited by Petitioner. There, and because the cited (Martin) reference was filed in the United States before the challenged patent's filing date, the Board found that Martin was available as a prior art reference in that IPR proceeding.

PCT Applications such as Drescher, however, which *were not filed in the United States, cannot be considered prior art references in IPR proceedings such as this* merely on account of an international filing date. Such treatment is expressly precluded in view of the United States' Declaration under PCT Article 64(4)(a), which is reproduced in full below:

PCT Notification No. 21
Patent Cooperation Treaty (PCT)

Declaration by the United States of America under Article 64(4)(a)

The Director General of the World Intellectual Property Organization (WIPO) presents his compliments to the Minister for Foreign Affairs and has the honor to notify him of the receipt of a notification by the Government of the United States of America which draws attention to its declaration made under Article 64(4)(a) of the Patent Cooperation Treaty (PCT) done at Washington on June 19, 1970, at the time of the deposit, on November 26, 1975, of its instrument of ratification of the said Treaty, and informs the Director General, pursuant to Article 64(4)(a) of the said Treaty, of the following:

"As the National Law of the United States of America does not equate, for prior art purposes, the priority date claimed under the Paris Convention for the protection of industrial property to the actual filing date in the United States of America, this country declares under Article 64(4)(a) of the Patent Cooperation Treaty, that the filing outside of the United States of America of an international application designating the United States of America, is not equated to an actual filing in the United States of America for prior art purposes.

If an international application designating the United States of America has been internationally published under Article 21 of the Patent Cooperation Treaty, the prior art effect of the international application shall attach as of that date. If such international application was not internationally published, the prior art effect shall attach to it from the date on which a copy of such international application in the English language, together with the national filing fee and an oath or declaration of the inventor, was received by the United States Patent and Trademark Office."

The declaration of the Government of the United States of America will take effect on May 10, 1978.

See www.wipo.int/treaties/en/notifications/pct/treaty_pct_21.html. Patent Owner specifically directs the Board to the following statement: "[T]he filing outside of the United States of America of an international application designating the United States of America, is **not** equated to an actual filing in the United States of America for prior art purposes." The Declaration continues: "If an international application designating the United States of America has been internationally published under Article 21 of the Patent Cooperation Treaty, the prior art effect of the international application shall attach as of that date." *See id.*

As recognized by Petitioner, Drescher was "filed" internationally on September 7, 2006, but was not published until March 13, 2008. As such, Drescher

fails to qualify as prior art under 35 U.S.C. § 102(e). *See also* www.uspto.gov/web/offices/pac/mpep/s901.html (MPEP § 901.05: “In general, a foreign patent, the contents of its application, or segments of its content should **not** be cited as a reference until its date of patenting or its public availability date (*e.g.*, publication date) can be confirmed by an examiner’s review of a copy of the document”).

E. Ground Two Fails

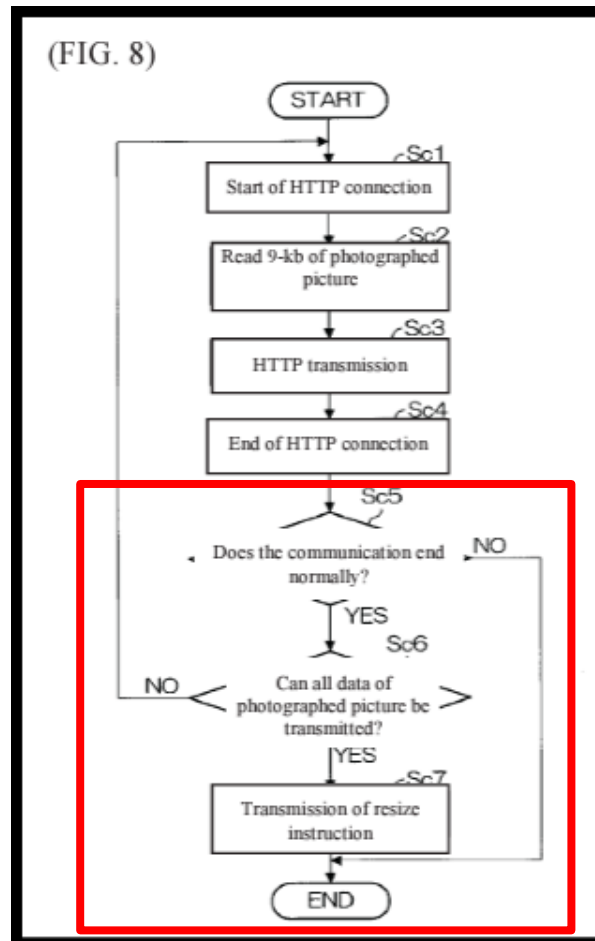
Petitioner further argues that the combination of Takahashi and Na (alternatively also with Lind) renders each of Challenged Claims 1-15 obvious. *See* Petition at 1 (Lind is merely cited in support of Bluetooth capability of the mobile device). As shown below, Petitioner’s arguments with respect to the four independent Challenged Claims (1, 6, 10, and 15) each fail and, as such, all of Petitioner’s Ground 2 arguments necessarily fail.

1. Takahashi Fails

Contrary to Petitioner’s arguments, Takashi fails to disclose certain key elements, including: (i) no synchronization messages (termination of upload process if there is a network error); (ii) no segment identifier; (iii) no User ID for each

synchronization message; and (iv) the User ID is part of the uploaded file name. Each of these are discussed in more detail below.

More specifically, as illustrated below, Takashi teaches the full termination of an upload if the connection is in any way interrupted. *See* Takahashi [Exh. 1016] at Fig. 8 (ending HTTP transmission in the event of abnormal termination of connection and recognizing necessity of an “all data” single transmission). As such, there is no “synchronization” of messages taught in Takahashi and, in fact, the opposite is expressly required.



Further, Takashi fails to disclose any “segment identifier,” given the fact that Takashi transmits full 9kb images sequentially and, if upload is interrupted, the entire process ENDS in Takashi. Further to this point, there is no disclosure of any “User ID” for each synchronization message. First, as explained above, there is no such synchronization message. Second, to the extent Takahashi discloses the use of

an identifier, such are integrated as part of the upload file name and are not separately associated with individual synchronized data messages.

2. Combination of Takahashi and Na is Inoperable

Petitioner erroneously suggests that a person of ordinary skill would have been motivated to assemble Takahashi with Na in a manner taught by the Challenged Claims, in view of Na's disclosure of HTTP protocols. *See* Petition at 48. This argument fails, inasmuch as the Petitioner *repeatedly* emphasizes that such combination would purportedly comply with the provisions of HTTP 1.1. *See, e.g.,* Petition at 11, 18, 25, 48, 53, 56, 58, 60, 72, 75-76, 83, and 88 (focusing on Na disclosure of uploading "in accordance with HTTP 1.1 protocol"). In fact, such combination is entirely *contrary* to the provisions of HTTP 1.1 (especially the teaching of Takahashi), and such proposed combination would have been highly disfavored and rejected as of the Date of Invention.

First, the disclosures of Takahashi concerning HTTP would have posed a grave security concern to persons of ordinary skill. As taught in Takahashi: "The file name is "in the format of user ID + YYYYMMDDHHMISS (year, month, day, hour, minute, and second)." *See* Petition at 57 (citing Traynor and Takahashi).

Per the governing standard, namely, HTTP 1.1 RFC 2616 (valid from 1999-2014), persons of ordinary skill were expressly advised *not* to implement the teaching of Takahashi. More specifically, HTTP 1.1 advised *against* sending filenames via HTTP. Indeed, the *only* way to send uploaded file names via HTTP messages was by using “Content Disposition,” which is a response-type header field (as rejected by HTTP). Again, the governing HTTP 1.1 protocol at that time (namely, HTTP 1.1 RFC 2616), plainly disfavored the so-called “Content-Disposition” header field because of its security risks. As recognized at the time, such Content-Disposition headers were highly disfavored, and were expressly rejected by the HTTP standard:

15.5 Content-Disposition Issues

RFC 1806 [35], from which the often implemented Content-Disposition (see section 19.5.1) header in HTTP is derived, has a number of very serious security considerations. Content-Disposition is not part of the HTTP standard,

See Exh. 2012 (<https://datatracker.ietf.org/doc/html/rfc2616#section-15.5>).

Again, as of the date of invention, the *only* way uploaded filenames were delivered using HTTP messaging was via the disfavored “Content-Disposition” approach, and this fact is confirmed by Petitioner’s own cited document at TTI1007

(*HTTP: The Definitive Guide* (“Gourley”)). At 370, Gourley correlates “Content-Disposition” with “filename” as “imagefile.gif.” Indeed, to confirm the fact that disfavored “Content-Disposition” was the *only* way to send a filename as of the date of invention, one need only search the entirety of Gourley for “filename” or “file name” to find it *only* mentioned in conjunction with disfavored “Content-Disposition.” A person of ordinary skill would not have been inclined to combine the known insecurity of embedding the user-name within the file name, especially when the HTTP protocol itself clearly disavowed such practice.

Even beyond the security concerns which would preclude any combination of Takahashi with Na, one of ordinary skill would have readily understood Takahashi to teach away from the use of passwords or authentication. More specifically, Takahashi expressly teaches that “the captured image can be transmitted easily, and on the server side, *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.*” See Takahashi, TTI-1016 at ¶¶ (0032) and (0035). Such teaching of Takahashi would permit outside actors to flood a server without having to comply with a password security measure. Such is an obvious security issue.

In view of the foregoing, those of ordinary skill *would not* have been motivated to combine the insecure HTTP sending file naming convention of Takahashi with anything, let alone the solution taught in Na. Indeed, there are numerous reasons why the Takahashi filename and non-password-authentication approach was never implemented in practice. In sum, any purported combination including the HTTP filename embedded User ID teaching of Takahashi would have been a security nightmare, and no person of ordinary skill would have implemented Takahashi (with, or without the teachings of Na).

Moreover, the purported combination of Takahashi with Na would have been inoperable and, as such, cannot form the basis of an obviousness-type rejection. Even assuming a person of ordinary skill would desire to send a plain User ID inside the filename in HTTP, Petitioner fails to establish why a filename would need to be sent with every segment when combined with the teaching of Na. This is especially dispositive in view of the fact that Na does not send either the filename or the User ID with any of the segments, yet Na is still able to perform MMS-based media transfer.

Yet still further, Petitioner *repeatedly* emphasizes that such combination would purportedly be “in accordance with HTTP 1.1 protocol.” But the purported combination of Takahashi with Na *would not* have been in compliance with HTTP 1.1, inasmuch as the “Content-Disposition” approach of Takahashi *was not* part of the HTTP standard, and further because such approach raised a number of very serious security considerations. Indeed, and as discussed above, HTTP 1.1 RFC expressly disclaimed the use of “Content-Disposition,” and identified “risks for implementors” associated with such approach. These risks are exacerbated further by Takahashi’s lack of reliance on authentication or password security mechanisms. In sum, Petitioner fails to establish any reasonable explanation or justification why any person of skill would proceed against the HTTP-based teaching of Na by associating it with the non-HTTP 1.1 approach of Takahashi.

3. Teachings of Takahashi and Na are Incompatible

As a threshold matter, the disclosures of Na are plainly directed to phone MMS (Multimedia Messaging Service) technologies for the uploading of messages that are different from phone SMS messages. It is understood that MMS is a system application by which a Wireless Application Protocol (WAP) client is able to

provide a messaging operation with a variety of media types. The WAP Forum defines a set of protocols in transport, security, transaction, session, and application layers. Still further, the Open Mobile Alliance (OMA) defines the WAP architecture, in: “Wireless Application Protocol Architecture Specification” (WAPARCH). The phone MMS server application architecture and requirements are completely different from a regular web-based application architecture. Petitioner cannot escape or overcome the fact that the MMS Application Server and MMS Open Mobile Alliance *do not* send filenames of the MMS media. *See generally* Exh. 2010 and 2011. By way of confirmation of the fact that neither “filename” or “file name” is not sent in any MMS HTTP header or message, one need only search the OMA documents (Exhs. 2010 and 2011) to confirm no such usage. Likewise, a search of Na confirms that Na also does not send “filename” or “file name.” Indeed, as of the date of invention, and even today, it is extremely inefficient, from a licensing cost perspective, to use an MMS application server. Nevertheless, all of the messages contemplated in Na are subject to MMS 1.0 Specification requirements for message command, message header, and message body. However, a person of ordinary skill in the art as of 2007 would know not to

use MMS-based HTTP messages for an Open Web application because the combination of the two (MMS and Open Web) *would not work*. Still further, the proposed combination of Takahashi and Na would not have performed properly, primarily because both architectures, specifications, messages and formats are completely different.

More specifically, Petitioner contends that: “A POSITA would have been motivated and found it obvious and *straightforward to implement* Takahashi’s mobile phone to *send* to the server a synchronization request querying “the sequence number ...,” *as taught by Na.*” See Petition (Paper 2) at 72 (emphasis added). Later, Petitioner contends that: “A POSITA would have been motivated and found it obvious and *straightforward to implement* Takahashi’s mobile phone to receive from the server a synchronization *reply* corresponding to “the sequence number of the segment from which the upload should be resumed” or “the range of the message body that has been successfully uploaded” ..., *as taught by Na.*” See *id.* at 76.

The problem for Petitioner is that the proposed combination of Takahashi with Na *would not work* because every message in Na for *both Header Information and Message Body* contains MMS 1.0 specification *information* and MMS 1.0

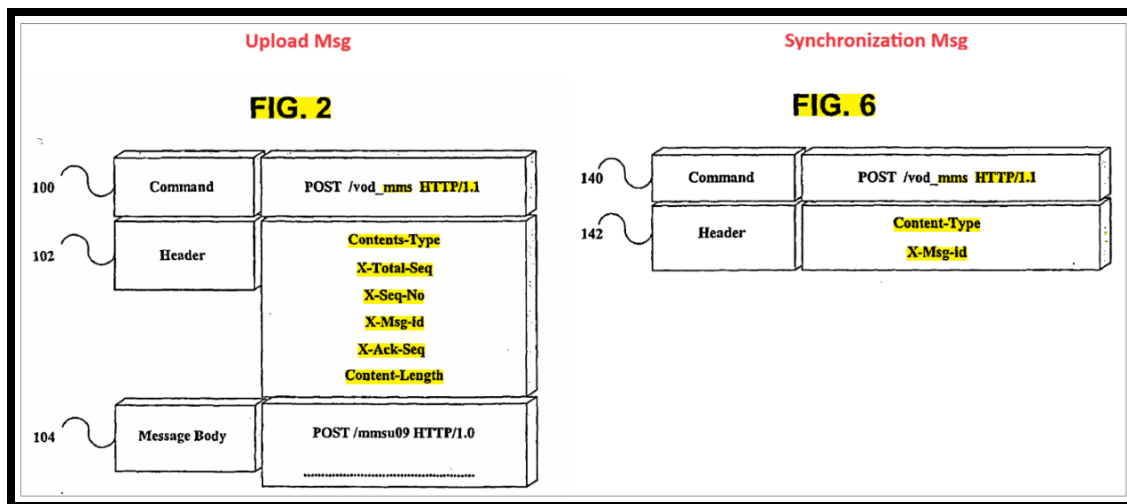
specification *data*. See Na (Exh. 1006) at [0062], [0065], [0116], [0118], [0121], and [0123]. Absent from the petition is any explanation of what a POSITA would do with MMS Specification Information and Data, or how the website/webservice would ultimately react to the MMS Data in all the messages. By way of example, as taught in Na, there is no available field for “Filename,” and petitioner cannot explain how such would be incorporated into the hypothetical header. Further, Petitioner cannot escape the fact that the MMS Application Server and MMS Open Mobile Alliance *do not* send filenames of the MMS media. Even further, as proposed by Petitioner, each segment message body in Na would have extra MMS 1.0 Specification data and header information, yet Petitioner cannot explain how that would be operable with the Web Server as opposed to an MMS Server (as contemplated in Na at [0051]). Again, all segmenting and messaging is in accordance with the MMS Application Server, not a Web Standard Server.

In sum, it would plainly *not* be obvious or straightforward to implement Takahashi’s mobile phone to receive from the server a synchronization reply, as taught by Na. In any event, such combination would be inoperable, given the fact that MMS Server Messages would not have been understood by the Web Server, and

vice versa. Nevertheless, Petitioner broadly concludes that the proposed combination of Takahashi and Na would be operable, yet 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.

4. No “User Identifier”

Still further, and as illustrated below, none of the MMS upload or synchronization messages disclosed in Na contain any “User ID” or even a “File name.”



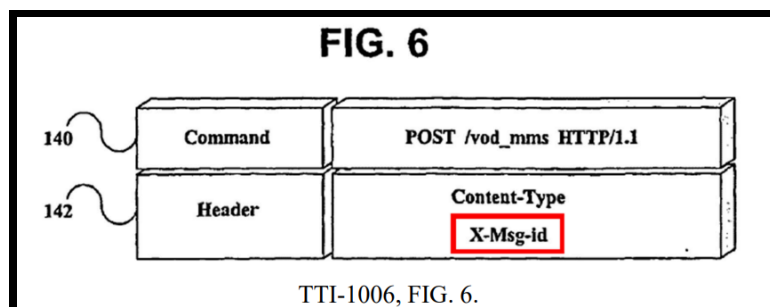
See Na (Exh. 1006) at Figs. 2 and 6. More specifically, Na Figure 2 (above) illustrates the structure of an initial request message for a media data upload, while Figure 6 illustrates the structure of a request message querying the sequence number of the segment from which the upload should be resumed when the connection is closed. As taught, and because there is no “User ID” or even a “File name” in Na, Petitioner’s Ground 2 fails.

Still further, the Petition fails on the related basis of Petitioner’s *inconsistent* purported disclosures of the recited “user identifier” throughout the Petition.

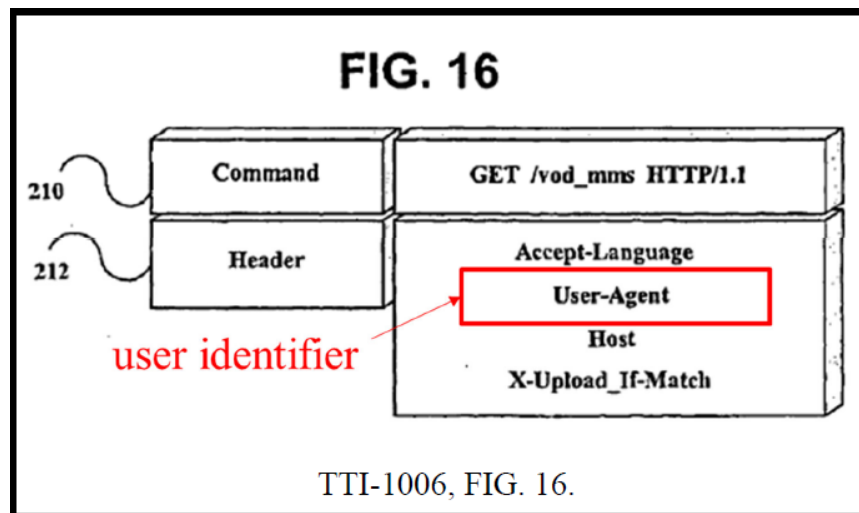
With respect to Element 1[e], Petitioner relies upon Takahashi and its disclosure of a “file name” in support of its arguments relating to the claimed “applying a user identifier” limitation. *See* Petition (Paper 2) at 57 (arguing that the file name is “in the format of user ID + YYYYMMDDHHMISS (year, month, day, hour, minute, and second)”). Of course, Takahashi teaches that in “transmitting the divided image using HTTP, the generated file name” including the User ID “is also transmitted together.” *See* Petition (Paper 2) at 57-58 (“There were multiple different ways to apply Takahashi’s file name including the user ID (*‘user identifier’*) to each divided image data (*‘data segment’*)”).

Later, and with respect to Element 1[f], Petitioner relies upon Takahashi's "file name" with "user ID" for the "user identifier" in support of its arguments relating to the claimed "for said user identifier" limitation. *See* Petition (Paper 2) at 59 ("...together with the *file name* including the user ID ('along with said user identifier')").

Later, and with respect to Element 1[j], Petitioner relies upon Na's "terminal number" and the HTTP "User Agent" for the "user identifier" in support of its arguments relating to the claimed "for said user identifier" limitation. *See* Petition (Paper 2) at 70-72. Petitioner cites to the "terminal number" of Na as a purported disclosure of the "user identifier" as recited in the Challenged Claims. *See* Petition (Paper 2) at 70 ("The request message is 'for said user identifier' because the request message is used to query the data previously uploaded that are associated with the 'terminal number'") (further citing TTI-1006 at Fig. 6, as illustrated below:)



Again, Petitioner also variously relies upon the “user agent” to purportedly satisfy the claimed “user identifier.” *See* Petition (Paper 2) at 71-72 (“[U]ser agent information (User-Agent, *e.g.*, SKT/XXX200)’ (another example of ‘said user identifier’)) (further citing TTI-1006 at Fig. 16, as illustrated below:)



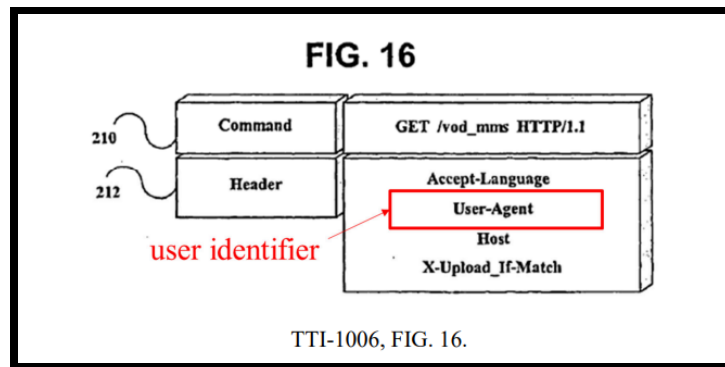
Petitioner’s argument misses the mark, given the fact that the phone MMS video request messages in Na are based on X-Msg-ID and *not* on any unique user identifier of the website/web service as required by the claim. Still further, the phone MMS-based “terminal number” inside the X-Msg-ID is not a *unique user identifier of the web service*.

Regarding the HTTP “User Agent” reliance for unique user identifier, as of the date of invention and even today, it was well-known in the art that the “User Agents” as defined by the HTTP protocol were/are *not* unique per user. Rather, due to the governing HTTP syntax, literally thousands of individuals at any given point in time could have the exact same HTTP User Agent. More specifically, as defined by the HTTP protocol, the “User Agent” simply identified the browser name and/or version and the PC or Mac version being utilized by the user (see image below). Such “User Agent” identifiers were not unique in any sense of the word, and cannot be understood as satisfying the “User Identifier” as recited in the Challenged Claims.



See <https://developer.mozilla.org/en-US/docs/Web/HTTP/Headers/User-Agent>.

Finally, and with respect to Element 1[k], Petitioner identifies the HTTP “User Agent” of Na in support of its arguments relating to the claimed “for said identifier” limitation. See Petition (Paper 2) at 75 (“[T]he response message itself identifies ... ‘the range of data that has been uploaded already’ that are associated with the ‘user agent information’ or user ID (*said user identifier*) so as to inform the mobile communication terminal ‘where to resume the upload’ for the user identifier”).



Here, Petitioner *does not* rely upon the “terminal number” or “X-Msg-id” for user identifier or even Takahashi’s user-ID inside the file name. As such, Element 1[k] cannot be satisfied by Petitioner if the Board properly considers the fact that the *HTTP User Agent* is not a unique “user identifier” as required by the Challenged Claims. Again, at any given point in time, thousands of people on a website can have the exact same (non-unique) HTTP User Agent. Again, for multiple reasons, Petitioner’s arguments fail.

V. CONCLUSION

For the reasons set forth above, the Board should deny institution under *Fintiv* and in view of the secondary considerations relating to Petitioner. Further, and in the alternative, Petitioner TikTok fails to demonstrate a reasonable likelihood that any Challenged Claim is unpatentable over the cited art combinations. Indeed, there

exist multiple independent grounds upon which the Board should deny TikTok's Petition, inasmuch as the cited art collectively fails to teach every limitation of the invention as claimed. Accordingly, Patent Owner requests that the Board reject TikTok's Petition and deny institution.

//

Date: July 1, 2024

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the foregoing complies with the type-volume limitations of 37 C.F.R. § 42.24 and contains 10,080 words, excluding those portions exempted under 37 C.F.R. § 42.24(a)(1).

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on July 1, 2024, a copy of the foregoing document was served by electronic mail on the following:

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