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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

August 2, 2024

HAYNES AND BOONE, LLP IP SECTION
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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90019507
PATENT NO. : 11659381
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,507	Patent Under Reexamination 11659381	
	Examiner MARK A SAGER	Art Unit 3992	AIA (FITF) Status No

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 05/06/2024 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

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cc:Requester (if third party requester)

Order Determination

This is an Order Grant regarding *ex parte* request for reexamination with a filing date of May 06, 2024, requesting reexamination of claims 1-16 of U.S. Patent No. 11,659,381 (hereinafter also referred to as '381). A substantial new question of patentability affecting claims 1-16 of U.S. Patent No. 11,659,381 in effect at this time is raised by the request for *ex parte* reexamination. Accordingly, claims 1-16 will be reexamined.

Waiver of Right to File Patent Owner Statement

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

References Asserted as Raising a Substantial New Question

The asserted substantial new question of patentability (SNQP) regarding claims 1-16 of '381 Patent alleged in Request by Requester is based upon the following reference:

"J2ME and smart phones as platform for a Bluetooth Body Area Network for Patient-telemonitoring" by M. J. Moron et al. (hereafter "Moron"), published in the Proceedings of the 29th Annual International Conference of the IEEE EMBS August 26, 2007.	Exhibit 1003
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Availability of Asserted References as Prior Art

Each of the references in the Request regards a patent or printed publication published and is available as prior art before critical date of '381. Moron is a printed publication consistent with precedent and MPEP 2128. Precedent states that “[w]hen there is an established publisher there is a presumption of public accessibility as of the publication date.” *VidStream LLC v. Twitter, Inc.*, 981 F.3d 1060, 1065 (Fed. Cir. 2020). Moron was included in the Proceedings of the 29 Annual International Conference of the IEEE Engineering and Biology Society, which took place between August 23-26, 2007. The PTAB has recognized IEEE, the Institute of Electrical and Electronics Engineers, as an “established publisher” (*Intel Corp. v. FG SRC LLC*, Case IPR2020-01449, Paper 53, p. 34 (PTAB Mar. 1, 2022) and a POSITA (an artisan) would have recognized IEEE as an established publisher. Accordingly, there is a presumption of public accessibility of Moron at least as of August 26, 2007.

Further, MPEP 2128 states “[p]rior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted.” MPEP 2128.11.B. Moron was added to IEEEExplore, an online database, on October 22, 2007. *See* EX1015 (<https://ieeexplore.ieee.org/document/4352008>). IEEEExplore “is the flagship digital platform for discovery and access to scientific and technical content published by the IEEE.” *See* EX1016 (<https://ieeexplore.ieee.org/Xplorehelp/overview-of-ieee-xplore/about-ieee-xplore>). Thus, Moron is also a printed publication at least as early as October 22, 2007 based on its availability on IEEEExplore.

Summary of Prosecution History

U.S. Application 17/542,373 (hereinafter also referred to as ‘373 application) was filed on Dec. 4, 2021. The ‘373 Application is a continuation of U.S. Patent Application No. 16/532,507, now U.S. Pat. No. 11,234,121, filed Aug. 6, 2019, which is a continuation application of U.S. Patent Application No. 15/659,637, now U.S. Pat. No. 10,425,806, filed Jul. 26, 2017, which is a continuation application of U.S. Patent Application No. 14/576,202, now U.S. Pat. No. 9,749,847, filed Dec. 19, 2014, which is a

continuation application of U.S. Patent Application No. 14/503,401, now abandoned, filed Oct. 1, 2014, which is a continuation application of U.S. Patent Application No. 14/273,546, now U.S. Pat. No. 8,862,757, filed May 9, 2014 in the United States Patent and Trademark Office, which is a continuation application of U.S. Patent Application No. 14/172,913, now U.S. Pat. No. 8,798,539, filed on Feb. 5, 2014, which is a continuation application of U.S. Patent Application No. 13/740,214, now U.S. Pat. No. 8,700,790, filed on Jan. 13, 2013 in the United States Patent and Trademark Office, which is a continuation application of U.S. Patent Application No. 12/333,303, now U.S. Pat. No. 8,392,591, filed on Dec. 11, 2008 which claims the benefit of US provisional patent application Ser. No. 61/017,202, titled “Automatic multimedia upload for publishing multimedia content”, filed on Dec. 28, 2007. Below is summary of the file history of ‘373 application.

‘373 Application

The ‘381 Patent matured from 17/542,373 that was filed on Dec. 4, 2021. The ‘373 Application was filed with 19 claims. A non-final Office Action was mailed on Oct. 13, 2022, rejecting claims 1-19 under provisional double patenting of each related patent application, rejecting claims 1-19 as lacking written description regarding the new claim language “display a mobile advertisement inside the mobile software application” and “touch-based advertisement targeted to a user”, rejecting claims 1-19 as indefinite regarding same limitations, objecting to specification for lack of antecedent basis, and rejecting claims 1-19 as obvious over U.S. Pub. No. 2004005915 (Hunter) in view of U.S. Pub. No. 20070226778 (Pietruszka) and 20070111748 (Risbood).

On January 09, 2023, Applicant filed a response, in summary, providing a terminal disclaimer of each of the related applications while also asserting the noted limitations of “display a mobile advertisement inside the mobile software application” and “touch-based advertisement targeted to a user” are disclosed in the U.S. application 11/901802 (that is incorporated by reference into the ‘373). The applicant presented multiple arguments against the teachings of Hunter and Pietruszka, which included a reproduced state machine diagram (see page 22 of Jan. 2023 Reply). A telephonic interview was initiated

on January 20, 2023 with the examiner suggesting adding the limitation “*wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information.*” In their supplemental response, filed on February 9, 2023, the applicant states “[i]n response to the suggestion received from the examiner via phone call on January 20, 2023, applicant accepts the suggestion and submits an amended claim set as advised during the phone call.”

The USPTO issued a Notice of Allowability with an examiner’s amendment on February 21, 2023 including the limitation agreed by Applicant during telephonic interview, allowing claims 1-3, 5-10, 12-16 and 18-19 of the ‘373 Application with claims 4, 11 and 17 cancelled. A Certificate of Correction was approved on July 4, 2023 and the ‘373 Application issued as the ‘381 Patent on May 23, 2011.

IPR2024-00767 (hereafter ‘767)

A petition for *inter partes* review of the ‘381 Patent was filed on April 05, 2024. The petition challenges claims 1-16 based on two proposed grounds: (1) claims 1-16 are obvious over JP 2003-60953 (“Hiroishi”) in view of U.S. Patent App. Pub. No. 2004/0004737 to Kahn (“Kahn”) and Bluetooth™ Core Specification 2.1 + EDR (“Bluetooth Core Specification” and (2) claims 1-16 are obvious over U.S. Patent App. Pub. No. 2009/0172129 to Singh et al. (“Singh129”) in view of U.S. Patent App. Pub. No. 2008/0103906 to Singh (“Singh906”). As discussed below in the 325(d) analysis, the Patent Trial and Appeal Board (PTAB) has yet to decide (pending) whether to institute an *inter partes* review. But the art relied on herein is not present in noted IPR and the art in noted IPR is not proposed against claims herein.

Co-Pending Litigation

The following litigation listed in Request remains pending:

Cellspin Soft, Inc. v. ByteDance Ltd. et al., Case No. 2:23-cv-00496 (E.D. Tex.).

TikTok Inc. v. Cellspin Soft, Inc., Case No. IPR2024-00767 (PTAB).

Also, regarding related litigation matters, the '381 patent is in the same family as U.S. Patent Nos. 11,234,121 ("the '121 patent"), 9,900,766 ("the '766 patent"), 8,756,336 ("the '336 patent"), 8,862,757 ("the '757 patent"), 8,898,260 ("the '260 patent"), and 8,904,030 ("the '030 patent"). The '381 patent is also in the same family as U.S. Pat. No. 9,258,698, which was the subject of IPR2019-00127, IPR2019-00131, IPR2019-01107, and IPR2019-01108. Notably, in IPR2019-00127 and IPR2019-00131, similar claims of related U.S. Patent No. 9,258,698 ("the '698 patent") were found unpatentable over the prior art, including the Hiroishi reference presented in IPR2024-000767. But the art proposed in this Request is not present in IPR2019-00127 and IPR2019-00131 and the art in IPR2019-00127 and IPR2019-00131 is not proposed against claims in this Request.

Declaration by Philip Greenspun, Ph.D. Under 37 C.E.R. § 1.132

The Declaration (signed 05/03/2024), filed 05/06/2024, was reviewed and considered for this decision. Dr. Philip Greenspun declares "I have been retained as a technical expert witness in this matter by Counsel for the Requester, Unified Patents, LLC ("Requester") to provide my independent opinions on certain issues requested by Counsel for Requester relating to the accompanying Ex Parte Reexamination of U.S. Patent No. 11,659,381 ("the '381 Patent"), challenging Claims 1-16 (the "Challenged Claims"). My compensation in this matter is not based on the substance of my opinions or on the outcome of this matter. I have been informed that CellSpinSoft, Inc. ("Patent Owner") is the purported owner of the '381 Patent. I note that I have no financial interest in Requester or Patent Owner, and I have no other interest in the outcome of this matter." (PA-DEC @ 2). Also, based on declared background/experience (*Id* @ 4-23 and Curriculum Vitae), Dr. Philip Greenspun is deemed an expert and his opinion testimony is relied on herein to extent stated herein. This expert testimony is relied on only to extent specifically stated herein.

Claim Construction

The '381 Patent has not yet expired. Under MPEP §2240, patent claims are to be given their broadest reasonable interpretation consistent with the specifications during Ex Parte Reexaminations. See *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Claims should only be construed to the extent

necessary to resolve a controversy. See *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (only claim terms “that are in controversy” must be construed and “only to the extent necessary to resolve the controversy”).

In summary, since ‘381 has not yet expired, the claims must be given their “broadest reasonable interpretation consistent with the specification.” See MPEP § 2258; *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984). Thus, in this case, the claim terms are given their broadest reasonable interpretation consistent with ‘381 Patent without reading limitations from ‘381 into the claims.

The SNQ Requirement

A printed publication raises a SNQ where there is a substantial likelihood that a reasonable examiner would consider the printed publication important in deciding whether or not the claim is patentable, unless the same SNQ has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. MPEP § 2242.

It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. MPEP § 2216.

The substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination. MPEP § 2216.

Claim Limitations Important to Patentability

In view of the prosecution history, summarized above where a limitation was suggested by examiner and added by applicant during original prosecution in 17/542373 to obtain allowance to become ‘381, any reference or combination of references that describes or suggests the then added limitation of *wherein the*

mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information as recited in claims 1-16 of '381 raises a substantial question of patentability (SNQP) herein.

SNQP/Reference Analysis

Attention is directed to MPEP 2216, i.e.:

Under 35 U.S.C. 304, the Office must determine whether “a substantial new question of patentability” affecting any claim of the patent has been raised. 37 CFR 1.510(b)(1) requires that a request for ex parte reexamination include “a statement pointing out each substantial new question of patentability based on prior patents and printed publications.” If such a new question is found, an order for ex parte reexamination of the patent is issued. **It is therefore important that the request clearly set forth in detail what the requester considers the “substantial new question of patentability” to be in view of prior patents and printed publications. The request must point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office.**

It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested. See also MPEP § 2242.

The legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C.303(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination.

....

After the enactment of the Patent and Trademark Office Authorization Act of 2002 (“the 2002 Act”), a substantial new question of patentability can be raised by patents and printed publications “previously cited by or to the Office or considered by the Office” (“old art”). The 2002 Act did not negate the statutory requirement for a substantial new question of patentability that requires raising new questions about pre-existing technology. In the implementation of the 2002 Act, MPEP § 2242, subsection II.A. was revised. The revision permits raising a substantial new question of patentability based solely on old art, but only if the old art is “presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.” Thus, a

request may properly raise a substantial new question of patentability by raising a material new analysis of previously considered reference(s) under the rationales authorized by KSR.

Questions relating to grounds of rejection other than those based on prior art patents or printed publications should not be included in the request and will not be considered by the examiner if included. Examples of such questions that will not be considered are public use, on sale, and conduct by parties.

(Emphasis added.)

Attention is also invited to MPEP 2242, I., i.e.:

The presence or absence of “a substantial new question of patentability” determines whether or not reexamination is ordered. The meaning and scope of the term “a substantial new question of patentability” is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability is present, unless the same question of patentability has already been decided by (A) a final holding of invalidity, after all appeals, or (B) by the Office in a previous examination or pending reexamination of the patent. A “previous examination” of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; or (C) the examination of the patent in an earlier pending or concluded reexamination.

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find “a substantial new question of patentability” unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in a previous examination of the claim.

For “a substantial new question of patentability” to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; **and** (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim. It is not necessary that a “prima facie” case of unpatentability exist as to the claim in order for “a substantial new question of patentability” to be present as to the claim....

(Emphasis added.)

Attention is also invited to 2258.01:

...For purposes of reexamination, a cumulative reference that is repetitive is one that substantially reiterates verbatim the teachings of a reference that was either previously relied upon or discussed in a prior Office proceeding even though the title or the citation of the reference may be different....

Finally, see also MPEP 2247.

SNQP(s) Raised in this Request

Requester notes, in their Request at page 60, the co-pending litigation listed above. Requester also summarizes, at page 61 of their Request, the IPR Petition 2024-00767 for *inter partes* review of claims 1-16 of ‘381 by stating “While a different version of the Bluetooth Specification is applied in IPR2024-00767, the combinations applied in IPR2024-00767 against the challenged claims are distinct from the combinations applied in this reexamination request. Indeed, IPR2024-00767 relies upon Hiroishi, Kahn, Singh129 and Singh906, while this Request relies on Moron, Husemann, and Sands. Further, IPR2024-00767 is at an early stage, and thus, there is no Office consideration of any references applied in this reexamination request.” Related proceedings are listed above under **Co-Pending Litigation** and below under **325(d)**. Further, the examiner does not find any other litigation involving ‘381 patent than litigation listed above and the examiner does not find any previous and/or co-pending ex parte reexaminations or supplemental examinations for the ‘381 patent. On numbered pages 11-16, Requester provides a summary of the proposed references. A complete analysis of examiner’s findings and determination is provided below. In summary, new art is relied on herein that show the limitation that was added during prosecution to becoming ‘381 to raise an SNQP herein. For instance, this reexam cites new art (Moron) such that the reference in this Request differs from reference(s) relied on in the examination of 17/542373 to becoming 11659381 where facts noted herein in the cited art describes at least “*wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information,*” as recited in challenge claims 1-16.

SNQP Based on Moron

“wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information”

Lacking evidence to the contrary, the examiner determines herein that Moron raises a SNQP with respect to challenge claims 1-16 of ‘381 based on the facts noted below. Based on facts noted herein, a reasonable patent examiner would consider the teachings of Moron to be important at least regarding

“wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information.”

e.g. Moron (Exhibit 1003)

Moron describes a “system based on a Bluetooth Body Area Network (BAN) for continuous and wireless telemonitoring of patients’ biosignals.” Moron (EX1003), p. 2791. Moron describes an “architecture that defines a monitoring network of Bluetooth biosensors connected to a commercial 3G cell phone with a WLAN interface.” *Id.*

Moron explains a desire to “reduce[] the development cost” of medical wireless personal area networks by using standardized technologies, including Bluetooth. *Id.* Moron states that the “main advantages of BT are the small size, reduced cost and low power consumption of the BT radio modules” and it details “BT sensors ... for different biosignals” including pulse-oximeters which connect to “general purpose devices (PDAs, embedded PCs, Mobile Phones, etc).” *Id.*

Moron’s system thus includes “three basic parts or components” including an “intelligent BAN” or iBAN that is “worn by the patient to be remotely monitored.” *Id.* at 2792. The iBAN includes “a commercial [] pulsioximeter, a GPS device, and an Intelligent Node (IN).” *Id.* The IN “integrates two wireless communications interfaces, 802.11 and Bluetooth, as well as a connection to the cellular network.” *Id.* Moron teaches that an example platform for the IN is a “smart phone.” *Id.* at 2793.

In Moron, the IN performs “connection establishment with the pulsioximeter and GPS device” and thereafter, the “IN receives data from iBAN nodes” and “stores” the data. *Id.* at 2792-2793. Subsequently, the “IN sends the data to the server” through either 802.11 or GPRS/UMTS. *Id.* at 2793. Moron further teaches that “as soon as an event occurs” in a sensor, the “IN can notify it to the server.” *Id.*

In Moron, “SPO2” (i.e., pulsioximeter) signals and “GPS information” are received over Bluetooth by the IN and “delivered to the CCS,” also referred to as the central control server. *Id.* That is, the IN, or smart phone, serves as a conduit to transmit data from a Bluetooth device to a server over a cellular network. Moron explicitly teaches sending data to a remote server in an HTTP request, and that the data sent to the remote server includes GPS information. *See Moron (EX1003)*, p. 2793. For example, Moron describes use of Hypertext Transfer Protocol to transfer the received new-data to a remote server:

“Regardless of the patient’s environment, there are three basic parts or components in the system: 1) An iBAN (intelligent BAN) worn by the patient to be remotely monitored, 2) A Central Control Server (CCS), located in the controlled environment, 3) A Mobile Control Monitoring Unit (MCMU) carried by the physicians.”

Moron (EX1003), p. 2793.

“The Bluetooth connections are kept active as long as the devices are in the coverage area of the IN. Thus, as soon as **an event occurs, the IN can notify it to the server**. This is performed at the cost of an increase in power consumption.”

Moron (EX1003), p. 2793, emphasis added.

Since Moron describes that event data is sent to a server, and that the data is sent in an HTTP request,

Moron performs “use Hypertext Transfer Protocol to transfer the received new-data to a remote server.”

As would be interpreted by an artisan, Moron describes “along with a user authentication credential”

since Moron describes that a Mobile Control Monitoring Unit (MCMU) carried by a physician may receive an alert that includes “a patient identifier.”

“The generated MMS contains a text with **the patient identifier** and the values of the sensed health parameter, a patient’s photograph and a sound clip with a message from the patient (to describe a sensation or any indication of disease).”

Moron (EX1003), p. 2793, emphasis added.

Further, Moron states:

“When a MCMU receives a SMS alert from a patient, the physicians should start the J2ME monitoring application, which allows to **select a patient** and the sensor data to display.”

Moron (EX1003), p. 2793, emphasis added.

Moron also teaches providing data to *a remote server over a cellular data network*:

“As the IN receives data from iBAN nodes, it stores them during a period which can be remotely configured. Then, the **IN sends the data to the server** through the 802.11 interface in case that the user is in a controlled environment and there is an available Wifi access point. In other case, **the data will be transmitted through GPRS/UMTS.**”

Moron (EX1003), p. 2793, emphasis added.

An artisan would have understood GPRS/UMTS as a cellular data network because GPRS is a “third-generation enhancement to the Global System for Mobile Communications (GSM)” providing for “transfer of data packets” and “GSM” is a “digital cellular phone technology.” See Microsoft Computer Dictionary (EX1010). Thus, Moron’s transmission of data through GPRS teaches sending data *over the cellular data network*. Additionally, because Moron teaches that the IN “integrates two wireless communications interfaces, 802.11 and Bluetooth, as well as **a connection to the cellular network,**” an artisan would have understood Moron to provide data over *a cellular network* as recited. Moron (EX1003), p. 2792, emphasis added.

Moron further describes use Hypertext Transfer Protocol to transfer the received new-data to a remote server:

“The communication between the CSS and patient iBAN can be established with two protocols:
(a) **HTTP: data are sent in a HTTP request.**”

Moron (EX1003), p. 2793, emphasis added.

Moron further describes the mobile software application is further configured to *use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information* (essentially, GPS data, as user preference data, is delivered to the CCS server):

“The data rate depends on the mode operation of the BAN: 1. Default Mode (mode 1): The pulsioximeter sends 3 bytes/s. The information from GPS is also received and stored in the IN, but it is not retransmitted to the CCS.”

“Verbose Mode (mode2): This operation mode has to be remotely enabled from the CCS server or the MCMU. In this case the pulsioximeter sends a rate of 375 bytes/s (75 samples/second).

Both the SPO2 signals and **the GPS information is delivered to the CCS.**”

Moron (EX1003), p. 2793, emphasis added.

Since the “GPS information is delivered to the CCS” and since data is sent in an HTTP request, as detailed above, Moron teaches the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information as recited. Thus, Moron describes “*wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information*” to raise an SNQP for facts above. Based on noted facts above, the examiner determines Moron is a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the ‘381 patent and there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not these claims are patentable for describing “*wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information*” as recited in claims 1, 7 and 12. Claims 2-6, 8-11 and 13-16 include these limitations based on their dependency and thus similar determination applies equally to those claims. A reasonable examiner would consider Moron to be important in deciding whether or not the claim is patentable regarding the claimed “*wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information*”, as recited in challenged claims 1-16 of ‘381 based on the noted facts above. Moron was not cited or applied during examination to becoming ‘381 Patent, and the claims at issue are not the subject of a final holding by a Federal Court. There is an open court proceeding (*Cellspin Soft, Inc. v. ByteDance Ltd. et al.*, Case No. 2:23-cv-00496 (E.D. Tex.)) and a petition for *Inter partes* reexamination (*TikTok Inc. v. Cellspin Soft, Inc.*, Case No. IPR2024-00767 (PTAB)) regarding ‘381 but there is no evidence that art in either of those proceedings is relied on herein and there is no evidence that art herein is relied on in either of those proceedings and further there is no final decision in those proceedings.

Moron is non-cumulative to art of record in '373 application at least due to describing the “*wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information*” limitation recited in claims 1-16 of '381. Thus, in this case, facts above show Moron raises an SNQP for “*wherein the mobile software application is further configured to use the Hypertext Transfer Protocol to send a user preference to the remote server over the cellular data network, and wherein the user preference comprises global positioning system information*”, as recited in challenged claims 1-16 of '381. For this reason at least, reexamination of claims 1-16 is **granted**.

Thus, since the findings above show that a substantial new question of patentability is present, reexamination is granted, see MPEP 2242. Claims 1-16 are **ordered** to be reexamined.

Notification of Concurrent Proceedings

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,995,091 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Amendment in Reexamination Proceedings

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

Submissions

In order to ensure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability, such documents must be submitted in response to the first Office

action on the merits (which does not result in a close of prosecution). Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and by 37 CFR 41.33 after appeal, which will be strictly enforced.

35 USC 325(d)

35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Thus, pursuant to the statute, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments previously were presented to the Office.¹

A review of the post grant history of ‘381 patent indicates that the patent is the subject of a single prior Office post grant challenge. On April 5, 2024, Petitioner TikTok, Inc., filed a petition (IPR2024-00767) seeking *inter partes* review of the ‘381 patent asserting the following grounds as raising a reasonable likelihood in prevailing (RLP) in showing the unpatentability of claims 1-16.

RLP #	Claims Challenged	35 USC §	References
1	1-16	103(a)	Hiroishi, Kahn, Bluetooth
2	1-16	103(a)	Singh129, Singh906

As of the mailing date of this Order, the Patent Trial and Appeal Board (PTAB) has yet to make a decision on institution for the petition in IPR2024-00767.

¹ It is noted that on July 20, 2024, Patent Owner filed a petition under 37 CFR 1.182 seeking to have the Director reject this Request under her discretionary authority pursuant to 35 USC § 325(d). However, this petition was filed over 2 ½ months after the reexamination request was served on Patent Owner and just 10 days before the statutory deadline for making a decision on the reexamination request. This petition was not received in sufficient time for entry and consideration by the Central Reexamination Unit (CRU) in making the determination on the request. Accordingly, this petition will be treated by the Office after the issuance of this Order.

A comparison of the prior art and arguments presented in the current request for reexamination of the '381 patent, indicate that the art and arguments are not the same or substantially the same as those presented by petitioner in the IPR2024-00767 petition. As set forth in the Request, third party requester asserts the following grounds as raising a substantial new question of patentability (SNQ) to the claims of the '381.

SNQ #	Claims Challenged	35 USC §	References
1	1-4 and 6-10	103(a)	Morón, Bluetooth Specification, Husemann, Sands
2	5 and 11	103(a)	Morón, Bluetooth Specification, Husemann, Sands, Jiang
3	12-15	103(a)	Morón, Bluetooth Specification, Sands
4	16	103(a)	Morón, Bluetooth Specification, Sands, Jiang

As an initial matter, none of the grounds asserted as raising an SNQ in the current *ex parte* reexamination Request (90/019,507) are based on identical grounds asserted in the prior IPR petition and the arguments in the Request relate to these prior art combinations. Thus, the Request is not based on the same prior art or arguments previously presented to the Office.

In addition, the Request is also not based on substantially the same prior art or arguments as were previously presented to the Office. The prior art references of Morón, Bluetooth Specification, Otto and RFC 2616 are materially different references than presented in the IPR petition, as noted above, and thus present different disclosures than the Hiroishi, Takahashi, Bluetooth, Kahn and Singh¹²⁹ references presented in the prior IPR petition (IPR2024-00767). It is also noted that a review of the Bluetooth reference presented in the prior IPR petition (IPR2024-00767) and the Bluetooth Specification reference presented in the current *ex parte* reexamination Request (90/019,507) indicates that they are two distinct references that are materially different with different disclosures.

Accordingly, because the Request is not based on the same or substantially the same art or arguments as were previously presented to the Office, the statutory threshold for the Director to exercise discretion to reject this request is not met.

However, to the extent that the references of Morón, Bluetooth Specification, Husemann, Sands and Jiang presented in the current *ex parte* reexamination Request (90/019,507) are considered to be substantially similar to the references of Hiroishi, Kahn, Bluetooth, Singh129 and Singh 906 presented in the prior IPR petition (IPR2024-0767), such the statutory threshold under 35 USC 325(d) would be met, the Examiner as delegated by the Director declines to exercise discretion to reject this request in view of the following facts:

- 1.) The fact that there has been only one prior post grant challenge to the ‘381 patent and there has been no finding of serial abusive Office challenges to the ‘381 patent by Third Party Requester;
- 2.) The fact that the PTAB has not yet issued a decision on the institution of *inter partes* review in the IPR2024-00767 petition and therefore has not yet considered the merits of the references presented in the IPR petition;
- 3.) The fact that there is minimal additional burden on the Office in examining the claims of the ‘381 patent in view of the grounds determined to raise an SNQ; and
- 4.) The fact that there is a strong public interest that the prior art references of Morón, Bluetooth Specification, Husemann, Sands and Jiang, which are determined to raise an SNQ over claims 1-16 of the ‘381 patent, be fully considered by the Office to fully address the patentability of the challenged claims.

Accordingly, *Ex Parte* Reexamination is Ordered based on the determination that cited Morón, Bluetooth Specification, Husemann, Sands and Jiang references raise an SNQ to the ‘381 patent for the reasons set forth above.

Conclusion

Accordingly, as the findings above show that a substantial new question of patentability is present, reexamination is granted, see MPEP 2242. Claims 1-16 **will be** reexamined.

Correspondence

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to:

Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand:

Customer Service Window
Knox Building
501 Dulany Street, Rom 1D80
Alexandria, VA 22314

Via Patent Center:

<https://patentcenter.uspto.gov/>

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

Other useful telephone numbers:
Reexamination Practice (571) 272-7703
Reexamination Facsimile Transmission No. (571) 273-9900

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