

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIKTOK INC., BYEDANCE INC., BYTEDANCE, LTD.,
BYTEDANCE PTE, LTD. and TIKTOK PTE, LTD
Petitioner,

v.

CELLSPINSOFT, INC.,
Patent Owner.

IPR2024-00769
Patent 9,900,766 B2

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

ANDERSON, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. Background

TikTok, Inc., Bytedance Inc., Bytedance Ltd., Bytedance Pte Ltd., and TikTok Pte Ltd. (collectively “Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–15 (“the challenged claims”) of U.S. Patent No. 9,900,766 B2 (Ex. 1003, “the ’766 patent”). Petitioner also filed a Declaration of David B. Lett with the Petition (Ex. 1030, “Lett Declaration”). CellspinSoft, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 7, “Prelim. Reply”). Although authorized to do so, Patent Owner did not file a preliminary sur-reply.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2022). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition, the Preliminary Response, and the evidence of record, for the reasons given below we determine there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the ’766 patent. Accordingly, we institute an *inter partes* review of claims 1–15 of the ’766 patent based upon the asserted grounds of unpatentability set forth in the Petition. Pet. 1.

B. Real Parties-in-Interest

Petitioner identifies TikTok Inc., ByteDance Inc., ByteDance, Ltd., ByteDance PTE, Ltd., and TikTok PTE, Ltd. as its real parties-in-interest. Pet. 121. Patent Owner identifies itself as its real party-in-interest. Paper 4 (“Patent Owner’s Mandatory Notices Pursuant to 37 C.F.R. § 42.8”), 2.

C. Related Proceedings

The parties identify the following related district court case involving the ’766 patent: *CellSpin Soft, Inc. v. ByteDance, Ltd. et al.*, Case No. 2:23-cv-496 (E.D. Tex.) (“Texas Litigation”) Pet. 121; Paper 4, 2.

Petitions for *inter partes* review have also been filed by Petitioner challenging other patents owned by Patent Owner including: IPR2024-00767 (U.S. Patent No. 11,659,381), IPR2024-00768 (U.S. Patent No. 11,234,121); IPR2024-00760 (U.S. Patent No. 8,898,260); IPR2024-00757 (U.S. Patent No. 8,756,336); IPR2024-00759 (U.S. Patent No. 8,862,757 (“’757 patent”¹)); and IPR2024-00770 (U.S. Patent No. 8,904,030). *See* Pet. 121; Prelim. Resp. 11.

D. The ’766 Patent

The ’766 patent was filed July 3, 2017, as US 15/640,594 (“’594 application”). Ex. 1003 at codes [21], [22]. The ’594 application is a continuation of US 14/576,202 (Ex. 1010,² “’202 application”), which is a continuation of five other applications, the earliest of which is US

¹ The ’766 patent is a continuation of the US application 14/273,546 for the ’757 patent. Ex. 1003 at code [63].

² Exhibits 1010 and 2009 are the same. Unless otherwise stated, we refer to only to Exhibit 1010, understanding that Patent Owner’s papers may cite Exhibit 2009.

application 12/333,303 (“’303 application”), filed December 11, 2008. *Id.* at code [63]. US application 11/901,802, filed September 19, 2007, (published as Exhibit 1010, “’802 application”) was incorporated by reference in the ’594 application. *Id.* at 1:44–49. Provisional application No. 61/017,202 (Ex. 2020, “Provisional application”), was filed on December 28, 2007. *Id.* at code [60].

1. Technical Background

The ’766 patent relates generally to distribution of multi-media content and specifically to “pairing a digital data capture device in conjunction with a mobile device for automatically publishing data and multi-media content on one or more websites simultaneously.” Ex. 1003, 1:52–56. The ’766 patent explains that prior methods require the user to capture an image using a digital camera or a video camera, store the image on a memory device of the digital, and transfer the image off-line to a computing device, such as a personal computer (PC) using a cable such as a universal serial bus (USB) or a memory stick and plug the cable into the PC. *Id.* at 1:59–65. This process is time consuming and inconvenient. *Id.* at 1:65–67.

2. Method for Automatic Upload of Multimedia Content of the ’766 Patent

The ’766 patent generally describes “a method and system for utilizing a digital data capture device in conjunction with a Bluetooth (BT) enabled mobile device for publishing data and multimedia content on one or more websites automatically or with minimal user intervention.” Ex. 1003, Abs. In this method, upon detecting data on the digital capture device, a

“client application” on the BT enabled mobile device “initiates transfer of the captured data, multimedia content, and associated files” and “automatically publishes” it by transferring that data to a website. *See id.*

Figure 1 of the '766 patent, reproduced below

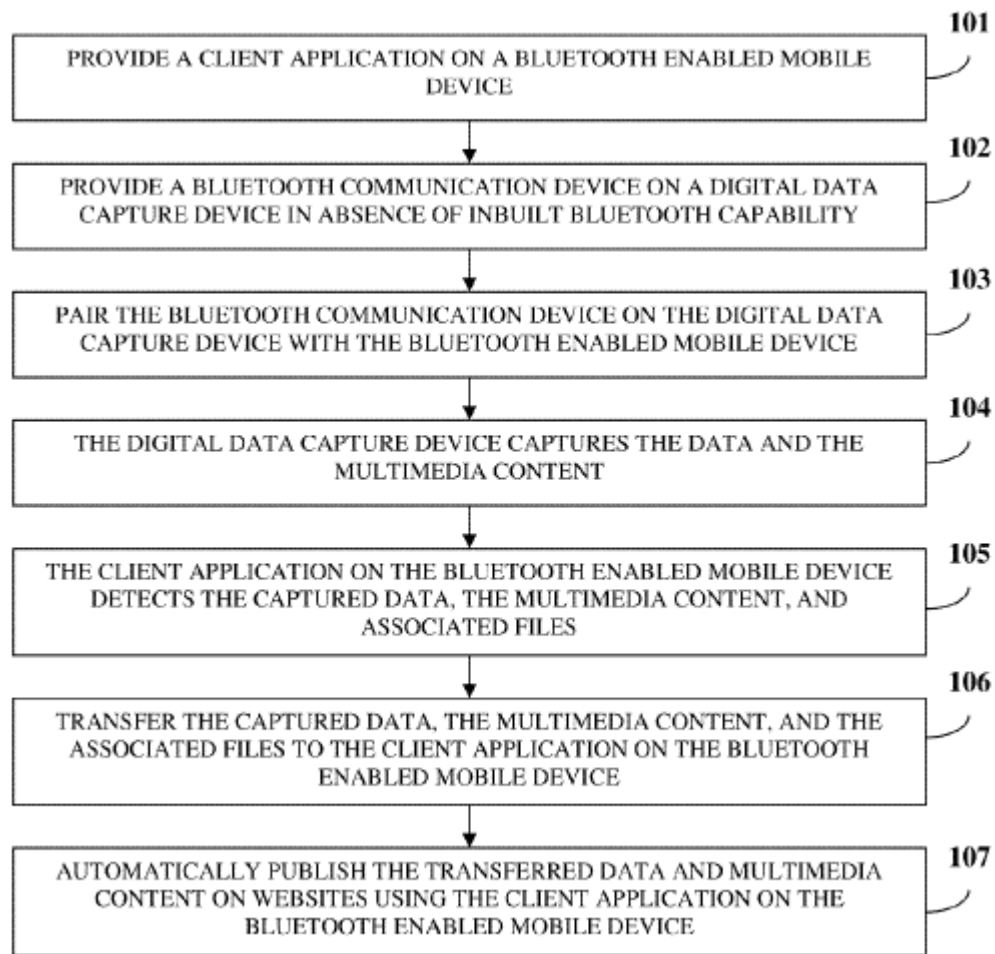


Figure 1 is a flowchart illustrating the method of the '766 patent. *See Ex. 1003, 3:26–30.* Figure 1 depicts steps 101–107. Steps 101 and 102 respectively provide a client application on the mobile device and a BT communication device on the capture device. *Id.* at 3:63–67. At step 103, the BT communication device on the capture device is paired with the mobile device “to establish a connection between” the two. *Id.* at 4:13–16. Thereafter, data is captured (step 104), detected by the client application on

the mobile device (step 105), and transferred to the client application on the mobile device (step 106) “using one or a combination of file transfer protocols.” *Id.* at 4:47–67. The client application then “automatically publishes” the transferred data on one or more websites (step 107). *Id.* at 5:62–64. According to the Specification, the “transport protocol that is used between the client application . . . and the publishing service [on the website] may be hypertext transfer protocol (HTTP).” *Id.* at 10:40–42.

E. Illustrative Claim

The Petition challenges claims 1–15, of which claims 1, 4, 9, and 13 are independent claims respectively to a “short-range wireless enabled data capture device,” “a system,” a “short-range wireless enabled cellular phone,” and a “system.” Claim 1 is illustrative of the claimed subject matter and reproduced below:

1[P]³ A short-range wireless enabled data capture device, comprising:

[1.1] a memory device;

[1.2] a processor coupled to said memory device;

[1.3] a short-range wireless communication device configured to establish a short-range paired wireless connection between the

³ The brackets identify limitations of the claim as presented in the Petition. *See* Pet. v–vi (claim 1). To the extent Patent Owner argues certain claim limitations are not present, it does not use the format. *See* Prelim. Resp. 74–75 (table listing limitations arguably not shown by Kahn and BT combination). Nonetheless, we adopt the format for purposes of this Decision.

short-range wireless enabled data capture device and a short-range wireless enabled cellular phone,

[1.4] wherein establishing the short-range paired wireless connection comprises cryptographically authenticating identity of the short-range wireless enabled cellular phone, and

[1.5] wherein establishing the short-range paired wireless connection further comprises the short-range wireless enabled data capture device using an association protocol;

[1.6] a data capture circuitry;

[1.7] said processor configured to acquire new-data in the short-range wireless enabled data capture device using the data capture circuitry,

[1.8] wherein the new-data is data acquired after establishing the short-range paired wireless connection between the short-range wireless enabled data capture device and the short-range wireless enabled cellular phone;

[1.9] said processor further configured to store the new-data in the memory device;

[1.10] said processor further configured to create a new-data object, wherein the new-data object comprises:

[1.11] signal to notify, wherein the signal to notify corresponds to the acquiring of the new-data for transfer to the cryptographically authenticated short-range wireless enabled cellular phone;

[1.12] the acquired new-data; and

[1.13] associated new-data, wherein the associated new-data corresponds to data associated with the new-data; and

[1.14] said processor further configured to transfer automatically the new-data object to the cryptographically authenticated short-range wireless enabled cellular phone, over the established short-range paired wireless connection,

[1.15] wherein the cryptographically authenticated short-range wireless enabled cellular phone is configured to listen to the signal to notify and receive the new-data object over the established short-range paired wireless connection,

[1.16.1] wherein a mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to process the signal to notify and

[1.16.2] store the received new-data in a memory device of the cryptographically authenticated short-range wireless enabled cellular phone,

[1.17] wherein the mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to use HTTP to upload the received new-data along with user information to a user data publishing website over a cellular data network, and

[1.18] wherein the user information corresponds to a user identifier that uniquely identifies a particular user of the user data publishing website and is used by the user data publishing website to publish the new-data for private consumption.

Pet. v–vi; Ex. 1003, 12:19–13:7.

F. References and Other Evidence

The Petition relies on the following references and declaration:

Singh, et al., US 2009/0172129 A1, published July 2, 2009 (Ex. 1009, “Singh129”⁴);

Singh, US 2008/0103906 A1, published May 1, 2008 (Ex. 1010, “Singh906”);

Kahn, et al., US 2004/0004737, published Jan. 8, 2004 (Ex. 1017, “Kahn”).

Bluetooth SIG, Inc., *Specification of the Bluetooth System*, (July 26, 2007) (Ex. 1019, “Bluetooth Specification”); C. Bisdikian, IEEE Communications Magazine, vol. 39, no. 12, pp. 86–94, *An Overview of the Bluetooth Wireless Technology* (Dec. 2001) (Ex. 1032, “Bluetooth Overview”), collectively “Bluetooth”; and

Feinberg, et al., US 2007/0073937, published Mar. 29, 2007 (Ex. 1025, “Feinberg”).

G. Asserted Grounds of Unpatentability

Petitioner asserts the challenged claims are unpatentable on the following grounds:

Grounds	Claims Challenged	35 U.S.C. § ⁵	References/Basis
1	1–15	103	Singh129, Singh906

⁴ Patent Owner references Singh129 and Singh906 as Singh ’129 and Singh ’906 respectively. Unless otherwise stated, we use Petitioner’s designations of Singh129 and Singh906.

⁵ The Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) (“AIA”), amended several provisions of 35 U.S.C., including §§ 102, 103. Consistent with our analysis in Ground 1 below which applies a

Grounds	Claims Challenged	35 U.S.C. § ⁵	References/Basis
2a	1–15	103	Kahn, Bluetooth
2b	1–15	103	Kahn, Bluetooth, Feinberg

Pet. 1.

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

Patent Owner argues that we should exercise discretion to deny institution in view of the *Fintiv*⁶ factors. *See* Prelim. Resp. 2–21. In particular, Patent Owner contends the Texas litigation “is already well-developed” and “set for trial on August 4, 2025, which is two months before a Final Written Decision would be due . . . here.” *Id.* at 2–3.

Petitioner does not address each of the *Fintiv* factors, but instead asserts that institution “***should not*** be discretionarily denied” because it has provided a *Sotera*⁷ stipulation, i.e., Petitioner stipulates “not to pursue in the parallel district court proceeding the same grounds as in the Petition or any grounds that could have reasonably been raised in the Petition” upon institution. Pet. 120 (citing Ex. 1035 (stipulation)); *see also* Pet. Prelim. Reply 1 (urging that its *Sotera* stipulation is dispositive and obviates the *Fintiv* analysis here).

priority date of July 3, 2017, we apply the AIA version of § 103. Our Decision, however, does not depend on which version of § 103 is applied.

⁶ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”).

⁷ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 18–19 (Dec. 1, 2020) (“*Sotera*”).

In view of Petitioner’s *Sotera* stipulation, we will not exercise discretion to deny institution under 35 U.S.C. § 314(a). The Director has issued guidance stating that, when such a stipulation is presented, the PTAB will not discretionarily deny institution in view of the parallel litigation. Ex. 1034,⁸ 3. That guidance is unequivocal and dispositive of the *Fintiv* analysis here.

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

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

⁸ USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022), *available at* https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

filing of the reexamination petitions Patent Owner identifies runs afoul of its obligations under the *Sotera* stipulation. Petitioner’s obligation not to pursue grounds in parallel proceedings is conditioned on the institution of *inter partes* review. Ex. 1035, 1. Thus, even assuming Petitioner is a real party in interest behind these reexamination petitions, Petitioner’s *Sotera* stipulation did not prevent it from participating in the filing of those petitions prior to our decision to institute *inter partes* review here. For these reasons, Patent Owner’s *Fintiv* arguments are unavailing and we do not exercise discretion to deny the petition in view of the same.

III. DISCRETION UNDER 35 U.S.C. § 325(d)

The parties dispute whether the Board should discretionarily deny the Petition under 35 U.S.C. § 325(d), with Petitioner arguing that the *Advanced Bionics*⁹ framework favors institution, while Patent Owner arguing that it favors discretionary denial. *See* Pet. 118–119; Prelim. Resp. 19–21.

Section 325(d) provides discretion to “reject the petition” if “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). We analyze this issue under the following two-part framework set forth in *Advanced Bionics*:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office;
- and (2) if either condition of [the] first part of the framework is

⁹ *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential).

satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, IPR2019-01469, Paper 6, 8.

Petitioner asserts that “substantially the same grounds” as those in the Petition have “not been previously presented to the office.” Pet. 118. Patent Owner limits its § 325(d) arguments to one of the references (Singh129) in Ground 1. Prelim. Resp. 19–20. We discern no reason to exercise discretion under § 325(d) to deny institution of the challenges in Grounds 2a or 2b.

Regarding Ground 1, Patent Owner argues “the Examiners were plainly aware of the ‘original specification’ and the ‘incorporated reference’ (Singh ’129 and Singh ’906, respectively) for nearly two decades, all of which were spent examining the 19 eventual Cellspin patents.” Prelim. Resp. 20. This does not resolve the first step of the *Advanced Bionics* framework because, in addition to Singh129, Grounds 2a and 2b rely on Kahn, Bluetooth, and Feinberg. Patent Owner does not contend that either of these references were previously considered by the Examiner, nor does Patent Owner assert that Petitioner’s reliance on those references is cumulative of other art or arguments the Examiner considered. Thus, we do not agree that the same or substantially the same art and arguments in Grounds 2a or 2b were previously considered by the Office.

For the above reasons, we do not exercise discretion to deny *inter partes* review under § 325(d).

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

In addition to its *Fintiv* arguments, Patent Owner advances a separate theory for discretionary denial under 35 U.S.C. § 316(b). Prelim. Resp. 19–

31. That is, Patent Owner contends discretionary denial is warranted to “deter certain types of Petitions” like the one here, which “undermine both the economy and the integrity of the patent system.” *Id.* at 19–20.

According to Patent Owner, “[t]he Government is presently executing a preexisting and dynamic policy initiative against the Petitioner and Real Party in Interest (TikTok)” that “implicates foreign policy, national security, and national competitiveness in connection with the technology the Patent Owner accuses of infringement (namely, TikTok’s Data Upload Algorithms)” and instituting *inter partes* review “would transform [the Board] into an instrument that might serve the interests of a company and nation state that [other parts of the government] have openly condemned as acting against the interests of the United States and its citizens.” *Id.* at 20. For this reason, Patent Owner contends “the enumerated § 316(b) factors weigh strongly against institution, regardless of the merits of the Petition” and “should lead to discretionary denial.” *See id.* at 19–31.

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

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

V. ANALYSIS OF THE CHALLENGED CLAIMS

A. *Level of Ordinary Skill in the Art*

Petitioner alleges a person of ordinary skill in the art would have had at least a bachelor’s degree in electrical engineering, computer engineering, or computer science, and two years of experience in the field of consumer electronics, with exposure to digital camera technology and wireless communications. . . . Superior education could compensate for a deficiency in work experience, and vice-versa.

Pet. 6 (citing Ex. 1030 ¶¶ 94–95).

Patent Owner does not propose a level of ordinary skill. *See* Prelim. Resp. Petitioner’s proposal is supported by the Lett Declaration and is consistent with the ’766 patent. Accordingly, we apply Petitioner’s articulation.

B. Claim Construction

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). In this context, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (citations omitted) (en banc). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317 (citations omitted).

Any special definition for a claim term must be set forth in the specification “with reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We construe only those claim terms that require analysis to determine whether to institute *inter partes* review. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Petitioner does not propose any term for claim construction. Pet. 6. Petitioner notes that a prior institution decision involving “related U.S. Pat.

No. 9,258,698” (“’698 patent”)¹⁰ owned by Patent Owner, we construed the term “cryptographically authenticating identity of the cellular phone” to include “authenticating the identity of the cellular phone using some form of security or encryption, including by use of a shared passkey on the digital camera device and the cellular phone.” *Id.* at 6–7 (citing *Canon U.S.A., Inc. v. Cellspin Soft, Inc.*, IPR2019-00127, Paper 7, 11 (PTAB April 29, 2019) (“’127 IPR”)). In the Final Decision in the ’127 IPR we determined the term was not at issue and did not make a final construction. *Id.* (citing ’127 IPR, Paper 51, 17–18 (PTAB April 28, 2020)¹¹).

Patent Owner contends that “there are numerous distinct terms of art” that involve “claim construction issues to be resolved.” Prelim. Resp. 53. The “terms of art” identified by Patent Owner include:

- (i) pairing; (ii) cryptographically authenticating; (iii) association protocol; (iv) signal to notify; (v) new-data object; (vi) user information; (vii) along with; (viii) supported data capability (of the Bluetooth enabled data capture device); and (ix) the recited order of operations.

Id. Other than (vii) “along with” and (ix) “the recited order of operations,” Patent Owner does not propose constructions for these terms. We address these terms below, together with two additional terms Patent Owner proposes for construction (i.e., “after establishing the short-range paired

¹⁰ The ’766 patent and the ’698 patent cite to provisional application No. 61/017,202 as “Related U.S. Application Data.” *Compare* ’766 patent at code [60] *and* ’698 patent at code [60].

¹¹ The Final Decision in the ’127 IPR cancelling all challenged claims was affirmed on appeal. *Cellspin Soft, Inc. v. Cannon U.S.A., Inc., et al.*, Case 2020-1947 (Fed. Cir. Oct. 14, 2022).

wireless connection” and “object”). As for the other “terms of art” identified by Patent Owner, because Patent Owner does not seek construction of these terms, we proceed on their plain and ordinary meaning unless otherwise stated.

Patent Owner proposes the following terms for construction.

1. The order of certain recited operations

Patent Owner argues that “the order of certain recited operation is key and limiting.” Prelim. Resp. 54. Patent Owner specifically argues that

- (i) new-data is necessarily limited to data acquired *after* establishing the short-range paired wireless connection; (ii) storage of the new data necessarily follows the initial acquisition of the said new data; and (iii) creation of the new data object necessarily follows the initial acquisition of the said new data.

Id. To support this argument, Patent Owner argues that “the order of certain operations was viewed as limiting as to the specific claims at issue” in a related matter in the United States District Court for the Northern District of California. *See id.* at 53–54 (citing Ex. 2014 (“Claim Construction Order,” case nos. 17-cv-05928, 05929, 05931, 05932, 05933, 05934, 05936 (N.D. Cal.)), 9–13).

Patent Owner’s argument is unavailing. Despite Patent Owner’s acknowledgement that “the claims at issue in [the Northern District of California] litigation are materially different from those being challenged here,” it makes no substantive argument as to why the California court’s analysis is applicable to the claims here. Prelim. Resp. 54. Patent Owner also fails to discuss the California court’s analysis. Patent Owner is reminded that 37 C.F.R. § 42.6(a)(3) prohibits incorporating arguments by

reference from one document into another. To the extent Patent Owner wishes us to consider or adopt another court’s analysis, Patent Owner must explain that analysis and the reasons why we should consider or adopt it in its brief. Patent Owner’s claim construction analysis should also follow the principles articulated in *Phillips*, 415 F.3d at 1303, as well as the Federal Circuit’s precedent regarding construction of the order of claim steps. *See, e.g., Mformation Techs., Inc. v. Rsch. in Motion Ltd.*, 764 F.3d 1392, 1398–99 (Fed. Cir. 2014) (explaining that unless an order is expressly recited “steps are not ordinarily construed to require” an order, but that “a claim requires an ordering of steps when the claim language, as a matter of logic or grammar, requires that the steps be performed in the order written, or the specification directly or implicitly requires an order of steps”) (internal quotations omitted).

2. “*along with*” (*claims 1, 4, 9, 13*)

Claim 1 recites “wherein the mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to use HTTP to upload the received new-data *along with* user information to a user data publishing website over a cellular data network.” Ex. 1003, 12:65–13:3 (emphasis added). Claims 4, 9, and 13 have similar limitations.

Patent Owner argues “along with” means “additional information” to the “user created multimedia content to the publishing service.” Prelim. Resp. 56 (quoting Ex. 1010 ¶ 47 (“Additional information such as the list of the user preferences of the publication virtual spaces **205**, authentication identification, user preferences . . . to transfer the user created multimedia

content along with the additional information to the publishing service 204.”)). The term “along with” is a plain English term that according to Patent Owner’s dictionary definition can mean “in addition to.” *Id.* at 55.

Patent Owner argues the intrinsic evidence describes a variety of information was contemplated as being sent “along with” the multimedia file, including for example user preferences and authentication information. Prelim. Resp. 56. Patent Owner concludes that “such complex settings could not possibly have been incorporated into a media file’s name, and because Petitioner makes no showing establishing this practice as of 2007, Petitioner’s arguments fail.” *Id.* at 56–57. Petitioner’s Preliminary Reply does not address construction of this term.

On the present record, we see no reason to depart from the term’s ordinary meaning. The ’766 patent does not use “along with” outside the claims. Those claims refer to transferring new data “along with user information.” Ex. 1003, 13:1–2 (limitation 1.17). The passage Patent Owner cites from the ’802 application, i.e., Ex. 2009 ¶ 47, refers to sending other types of information and does not appear to be relevant to the usage of “along with” in the challenged claims. In any event, that passage does not suggest any reason to depart from the term’s ordinary meaning.

The term “along with” is a plain English term that does not require clarification. We determine that “along with” does not require express construction.¹²

¹² We reached the same result in the ’127 IPR, which considered similar claim language in another patent owned by Patent Owner where the same construction of “along with” was proposed. *See* ’127 IPR, Paper 51 at 18–19.

3. *“after establishing the short range paired wireless connection between the short-range wireless enabled data capture device and the short-range wireless enabled cellular phone” (claims 1, 4, 9, 13)*

Claim 1 recites, in pertinent part, “after establishing the short-range paired wireless connection between the short-range wireless enabled data capture device and the short-range wireless enabled cellular phone.”¹³

Patent Owner argues for the adoption of the construction of a similar term, “after the paired connection is established,” by the Northern District of California in a set of cases brought by Patent Owner. Prelim. Resp. 57. In those cases the Northern District construed the similar term to mean “after the paired connection is established and maintained on a continuous basis.” *Id.* (citing Ex. 2014, 13, 15, and 23). The cases before the Northern District did not involve Petitioner or the ’766 patent, rather three different patents were at issue there. *See* Ex. 2014.

The Northern District relied on prosecution disclaimer evidenced in the prosecution history of one the patents, which it found “related to the other asserted patents,” to reach its construction. *See, e.g.,* Ex. 2014, 14–15. The excerpts from the prosecution history of record here include only amendments proposed by the Examiner to the pending claims. Ex. 1004, 69 (“Amendment under 37 C.F.R. 1.312”); Ex. 1030 ¶ 86 (summary of prosecution history); *see also* Ex. 2013 (Patent Owner’s excerpts from file history of ’766 patent). Patent Owner does not identify any issue of prosecution disclaimer that is presented here.

¹³ The term appears with minor variations in claims 4, 9, and 13. *See* Prelim. Resp. 57 (“the term appears in the Challenged Claims, in context, variously . . .”).

Patent Owner makes no substantive argument describing the Northern District’s analysis as to why the construction is applicable to the claims here. Patent Owner does not present a construction analysis consistent with the principles articulated in *Phillips*, 415 F.3d 1303. We do not adopt Patent Owner’s proposed construction and on this record do not include “maintained on a continuous basis.”

4. “object” (claims 1, 4, 9, 13)

The word “object” is recited in claims 1, 4, 9, and 13 as part of the phrase “new data object.” Patent Owner argues an “object” is not a “file,” which Patent Owner contends is Petitioner’s position. Prelim. Resp. 58. Patent Owner contends an “object” is “known in the art to comprise a variable, a data structure, a function, or a method.” *Id.* Patent Owner argues its proposed construction is “widely acknowledged,” citing various excerpts from Wikipedia. *Id.* at 59.

Petitioner notes the term at issue is “new-data object.” Prelim. Reply 4 (citing Ex. 1003, claim 1). Petitioner contends that Patent Owner’s construction is “not supported by evidence” because “the processor creates a new-data object, which is defined to include”: 1) signal to notify; 2) the acquired new data; and 3) associated new-data. *Id.* at 4–5. This “new-data object” is then transferred to the cellular phone. *Id.*

Petitioner argues “new-data object” does not appear in the specification of the ’766 patent, but only in the claims. Prelim. Reply 5. Petitioner argues is instructive because it “discusses transferring files between the data capture device and the cellular phone, including using specific ‘file transfer protocols,’ including OBJect EXchange (OBEX).” *Id.*

(citing Ex. 1003, 4:47–5:29). Petitioner concludes “the specification seems to conflate a ‘new-data object’ with a file created by the data capture device that includes ‘captured data, the multimedia content, and files associated with the captured data and the multimedia content.’” *Id.* (citing Ex. 1003, 4:47–5:44).

On the current record, we agree with Petitioner. Patent Owner does not identify any other basis in the intrinsic record to interpret the term “data object” to exclude a file. In view of express disclosure of file transfer in the intrinsic record, we do not find Patent Owner’s extrinsic sources (i.e., its two screenshots of Wikipedia excerpts) persuasive to support its narrower claim construction. We also agree with Petitioner that at least for purposes of this decision the ordinary meaning and surrounding claim language provide sufficient context so that no express construction is necessary.

We determine that the term “new-data object” or “object” includes “files.”

5. Remaining Terms

On this record, none of the remaining “state of the art” terms identified by Patent Owner are in dispute. Unless otherwise indicated in this Decision, we do not need to construe any remaining claim term and apply the plain and ordinary meaning to a person of ordinary skill in the art.

If disputed during trial, the parties should develop the construction of the above terms or any other term that may require construction. Failure to do so may result in waiver of the issue for purposes of a final decision.

C. Obviousness

Under AIA 35 U.S.C. § 103, a claim is unpatentable as obvious “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103; *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called “secondary considerations,” including commercial success, long-felt but unsolved needs, failure of others, and unexpected results. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). At this stage, neither party has presented any evidence on the fourth *Graham* factor.

D. Overview of the Prior Art

The references relied on by Petitioner are described below.

1. Singh129 (Ex. 1009)

Singh129 has the same disclosure as the ’766 patent. Pet. 15 (*compare* Ex. 1003 *and* Ex. 1009); *see* Section I.D (describing ’766 patent).

2. Singh906 (Ex. 1010)

Singh906 is the published version of the incorporated ’802

application. Pet. 15. *See* Exs. 1010, 2009.¹⁴

Singh906 is directed to a method and system for publishing “user created multimedia content including voice, video, text, pictures, and a combination thereof on one or more publication virtual spaces, simultaneously.” Ex. 1010, Abs.

Figure 2 of Singh906 is reproduced below.

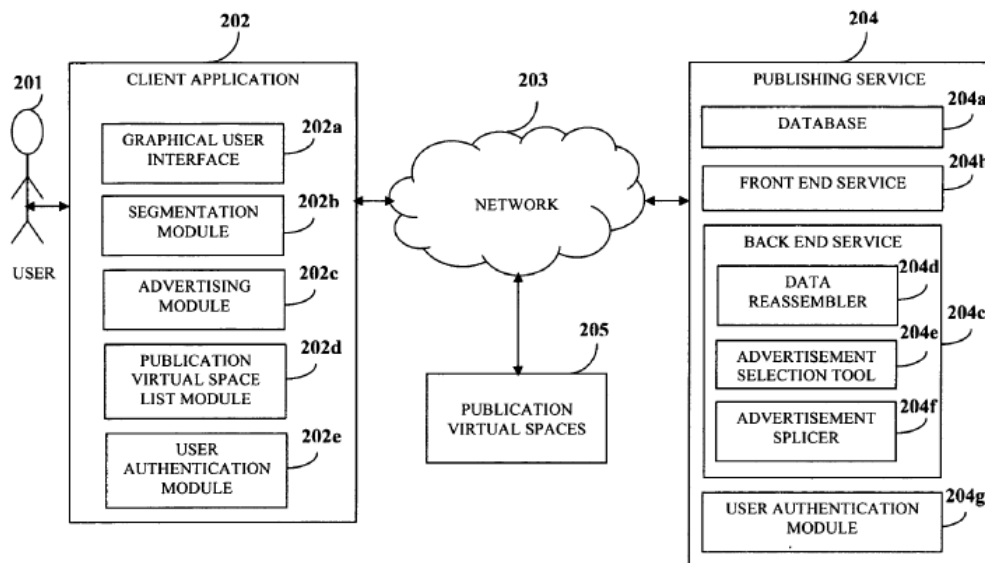


FIGURE 2

Figure 2 illustrates Singh906’s system for publishing user created content.

Ex. 1010 ¶ 13. Singh906 describes websites of publishing service 204 and virtual spaces 205. *Id.* ¶ 17. As shown in Figure 2, Singh906 includes a

¹⁴ Exhibits 1010 and 2009 are the same. Unless otherwise stated, we use Exhibit 1010, Petitioner’s exhibit number.

user authentication module 202e on a mobile device. *Id.* ¶ 26. Singh906 transfers user preferences including authentication information to the publishing service 204. *Id.* ¶ 28.

If the website requires an account, the user “provides login information comprising a username and a password” to create an account. Ex. 1010 ¶ 38. “The login information enables the publishing service 204 to access the multiple publication virtual spaces 205 configured by the user 201 on the mobile device.” *Id.* “The publishing service 204 logs on to the publication virtual space of choice on the user’s 201 behalf and publishes the user created multimedia content.” *Id.*

3. Kahn (Ex. 1017)

Kahn describes an imagining system that “automates fulfillment of image photofinishing based on location.” Ex. 1017, Abs. Figure 3 of Kahn is reproduced below.

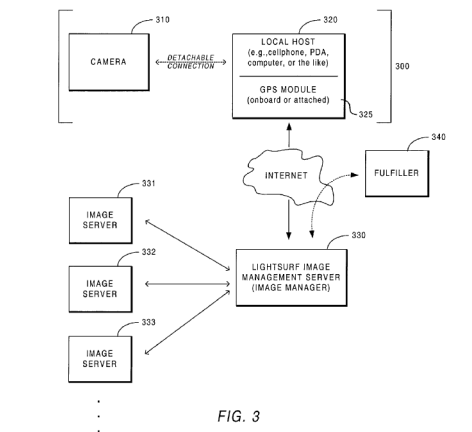


Figure 3 is a block diagram illustrating the basic components of the system.

Ex. 1017 ¶ 55. As shown in Figure 3, Kahn teaches an imaging system that includes a camera 310, which may be a wireless camera, coupled to a host

device 320, like a cellular phone, by a wireless connection. *Id.* Kahn teaches that the “camera device 310 is preferably a wireless camera device, such as camera device 100 (shown in FIG. 1A).” *Id.* The host device 320 communicates with an online Web-based image management server 330 via the Internet, utilizing protocols like HTTP. *Id.* ¶ 56.

4. *Bluetooth (Exs. 1019, 1032)*

In addition to the Bluetooth Specification (Ex. 1019), Petitioner also references the Bluetooth Overview.¹⁵ Pet. 40–42. We describe Bluetooth or the Bluetooth Specification as Petitioner has done. *Id.* On this record, Bluetooth is accurately described in the Bluetooth Overview and Patent Owner does not argue anything to the contrary.

Bluetooth wireless technology (BT) wirelessly interconnects personal devices within a localized “communications bubble.” Ex. 1032, 1–2. Bluetooth’s aim was to provide a universal, user-friendly interface for data services, enabling ad hoc connectivity and serving as a personal gateway for accessing remote services while maintaining convenience and privacy. Ex. 1032, 1–2; Ex. 1019, 1, 46–47. “Connecting to data services through one’s

¹⁵ Petitioner’s citations at pages 40–42 of the Petition to Bluetooth Specification (Ex. 1019), from which this description is derived, do not clearly teach what Petitioner says they do. *See* Pet. 40–42. Nevertheless, we use those citations in this section, because we decline to search Exhibit 1019 for the correct citations. We note that the Petition’s later citations to the Bluetooth Specification (Ex. 1019) appear to be correct, and we use them in our analysis. *See* Section IV.F below.

cellular phone gives rise to the concept of a *personal gateway*. People will carry their personal gateways wherever they go.” Ex. 1032, 1. The BT specification details security implementation at both link and application layers, with cryptographic authentication through LMP Pairing and Secure Simple Pairing methods. Ex. 1019, 48–50. Cryptographic authentication is implemented. *Id.* at 51. Bluetooth’s packet format allows flexible payload transportation, enabling image transfer. *Id.* at 52. Event listening/notification mechanisms like polling and sniff mode are defined in the Bluetooth specification. *Id.* at 53–55.

5. *Feinberg (Ex. 1025)*

Feinberg teaches “storage media for digital media devices such as cameras [and] audio/video recorders/players and the like” and more particularly peripheral devices for transferring stored digital media wirelessly. Ex. 1025 ¶ 2. Feinberg describes wireless network connectivity for digital cameras compatible with IEEE 802.11 standards, enabling image data transfer to computers or printers. *Id.* ¶ 5.

Feinberg discloses uploading images to internet-based storage via a host, like a “camera host.” Ex. 1025 ¶ 49. Feinberg also details “tagging” digital images with associated metadata, including capture date, location, image management. *Id.* ¶ 51. “[T]humbnail images (e.g., having 160x120 pixel resolution) are typically embedded into the full resolution image file header.” *Id.* ¶ 91.

E. Claims 1–15 as Obvious Over Singh129, Singh906 (Ground 1)

Petitioner provides a limitation-by-limitation analysis that claims 1–15 would have been obvious over Singh129 and Singh906. Pet. 1, 15–38. Petitioner relies on the Lett Declaration. Ex. 1030 ¶¶ 454–514.

1. Priority date for '766 patent

This record shows there is an issue about whether the '766 patent is entitled to the benefit of the filing date of any of the continuation applications. Pet. 9–15. Petitioner alleges the priority date for the '766 patent is no earlier than its filing date of July 3, 2017. *Id.* at 15 (citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1344 (Fed. Cir. 2022) (confirming the Board's statutory authority to decide priority)). Patent Owner asserts that Ground 1 fails because Singh129 and Singh906 do not qualify as prior art based on the earlier filing date of the Provisional application.¹⁶ Prelim. Resp. 65–66.

Singh129 is the publication of the '303 application (i.e., the first non-provisional application in the series of continuation applications that led to the '766 patent), and has the same disclosure as the '766 patent. *See* Pet. 15; Prelim. Resp. 42 (asserting that Singh129 is “the parent application” and cannot be “prior art against its own continuation child,” the '594 application for the '766 patent). Because Singh129 is within the priority chain of the

¹⁶ The '766 patent was filed on July 3, 2017. Ex. 1003 at code [22]. The '802 application, published as Singh906, was filed on September 19, 2007. Ex. 1010 at code [22]. Singh129 was filed on December 11, 2008. Ex. 1009 at code [22].

'766 patent, a threshold question is whether it qualifies as prior art to the challenged claims.

Whether Singh129 qualifies as prior art to the challenged claims depends on whether the challenged claims have adequate written description support in the priority applications. This question, in turn, implicates two issues: (i) whether Patent Owner's attempt to incorporate the disclosure of Singh906 into the '766 patent specification by reference was effective; and (ii) even if the incorporation was effective, whether the challenged claims find adequate written description support in the '766 patent specification (including Singh906).

We address these two subsidiary questions first, then turn to whether Petitioner has demonstrated a reasonable likelihood of demonstrating that the challenged claims are unpatentable as obvious over Singh129 in view of Singh906.

a. Whether Singh129 Qualifies as Prior Art

To rely on the filing date of an earlier application, the earlier application must include a disclosure that complies with the written description requirement of 35 U.S.C. § 112. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997); 35 U.S.C. § 120. The written description requirement requires that a patent's specification “contain a written description of the invention . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1343 (Fed. Cir. 2010) (en banc). This provision ensures that “the inventor actually invented the invention claimed” and “had possession of the claimed subject matter as of the filing date.” *Id.* at 1350–51.

The test for adequate written description support “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Id.* at 1351. “[T]he disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). However, “one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims.” *Id.* “[A] description that merely renders the invention obvious does not satisfy the [written description] requirement”; “it is the specification itself that must demonstrate possession.” *Ariad Pharms.*, 598 F.3d at 1352.

The parties dispute whether Patent Owner effectively incorporated the disclosures of Singh906 into the ’766 patent, such that these disclosures are available to provide written description support for the challenged claims. *See, e.g.*, Pet. 13–14; Prelim. Resp. 42–47. We begin our analysis with this issue.

i. Whether the Incorporation by Reference of Singh906 was Effective

As noted above, Singh906 is the publication of the ’802 application. *See* Section V.D.2 above. The ’766 patent incorporates the ’802 application by reference, stating: “The following patent application is incorporated herein in its entirety: US Non-provisional patent application Ser. No. 11/901,802, titled ‘Online Publishing of Multimedia Content’, filed on Sep. 19, 2007 in the United States Patent and Trademark Office.” Ex. 1003, 1:44–48.

Material incorporated by reference into a patent application “is effectively part of the host document as if it were explicitly contained

therein.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). Rule 57(d) of the Code of Federal Regulations (37 C.F.R. § 1.57(d)¹⁷) places certain requirements on material that is incorporated by reference.

Rule 57(d) defines “[e]ssential material” as material incorporated by reference that is necessary to provide a written description of the claimed invention. 37 C.F.R. § 1.57(d). Rule 57(d) further states, in relevant part, that essential material can be incorporated by reference into a patent application “only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication.” *Id.* Rule 57(c) states that “an incorporation by reference must be set forth in the specification.” 37 C.F.R. § 1.57(c). Finally, Rule 57(h) states: “An incorporation of material by reference that does not comply with paragraphs (c), (d), or (e) of this section is not effective to incorporate such material unless corrected within any time period set by the Office, but in no case later than the close of prosecution.” 37 C.F.R. § 1.57(h).

Petitioner asserts that because the patent applicant directed the Examiner to disclosures in the ’802 application as support for certain limitations of the challenged claims, those disclosures are “essential material” under Rule 57(d). Pet. 14–15 (citing Ex. 1006 (’766 patent prosecution history), 193–203, 270–273). As such, Petitioner argues that Patent Owner needed to have incorporated by reference “a *U.S. patent or*

¹⁷ Citations herein are to the current version of 37 C.F.R. § 1.57. Should any party contend that a different version of Rule 57 applies in this case, they should promptly state as much in their next brief.

U.S. patent application publication,’ not . . . an unpublished application like the ’802 application.” *Id.* at 14. Petitioner contends that “if Patent Owner desired to rely on the disclosure of Singh906 to support the challenged claims, it was Patent Owner’s obligation to amend the specification of the ’766 patent to cite Singh906 during prosecution,” which it did not do. *Id.* at 15. According to Petitioner, the public understands that nothing in the ’802 application “could be or would be used to support the claims of the ’766 patent.” *Id.* Petitioner argues that without an effective incorporation by reference of Singh906, the challenged claims cannot claim priority to any date earlier than July 3, 2017, filing date of ’594 application. *Id.*; see Section I.D above; see also 35 U.S.C. § 100(i) (defining the “effective filing date” for a claim as either the application’s actual filing date or the filing date of the earliest application that supports the claim).

Patent Owner responds that its incorporation by reference of the ’802 application “fully complied with” Rule 57, and asserts that during prosecution of other applications, the applicant indicated that Singh906 is the published version of the ’802 application. Prelim. Resp. 42–46 (citing Ex. 2013 (“Combined Excerpts from Prosecution Histories of ’121 and ’381 Patents”¹⁸), 30–36 (’121 Patent), 40–47 (’381 Patent)).

In its Preliminary Response, Patent Owner appears to rely solely on Singh906 as providing written description support for certain limitations of the challenged claims, e.g., “use HTTP to send user preferences to the user data publishing website over the cellular data network, wherein the user

¹⁸ U.S. Patent Nos. 11,234,121 and 11,659,381 respectively. See Section I.C above.

preferences comprise global positioning system information.” *See, e.g.*, Prelim. Resp. 44. This is consistent with the applicant’s citation of Singh906 during prosecution of other presumably related applications, in response to the Examiner’s written description rejection. *Id.* at 46 (citing Ex. 2013, 30–36, 40–47). Accordingly, for purposes of institution, we consider Singh906 to be “essential material” under Rule 57.

On the present record, it is not clear that Patent Owner “fully complied with” Rule 57 by citing the ’802 application in its incorporation-by-reference statement. *See* Prelim. Resp. 42–47. Rule 57 expressly states that “an incorporation by reference ***must be set forth in the specification,***” and that reference to essential material can be “only by way of an incorporation by reference to a U.S. patent or ***U.S. patent application publication.***” 37 C.F.R. § 1.57(c), (d) (emphasis added). Here, Patent Owner’s incorporation-by-reference statement in the ’766 specification references the ’802 application, which is an unpublished application, not a U.S. patent application publication. *See* Ex. 1003, 1:44–48. Moreover, the record does not show that arguments made during prosecution of the ’121 and ’381 patents citing Singh906 were made during prosecution of the ’766 patent. *See* Ex. 1004 (’766 patent prosecution history). Further, Patent Owner does not show how the ’121 or ’381 patents are related to the application for the ’766 patent.

Nevertheless, on the current record and in view of the facts of this case, we find that deeming the incorporation by reference to be ineffective would exalt form over substance. Although the incorporation-by-reference statement in the ’766 specification refers to the unpublished ’802 application, the corresponding U.S. patent application publication

(Singh906) was available as of May 1, 2008 (which is before the December 11, 2008, filing date of the '303 application, i.e., the earliest utility application in the chain that led to the '766 patent), and was thus available to a person looking to find a copy of the '802 application.

For the above reasons, for purposes of institution, we find that the entirety of the '802 application/Singh906 was effectively incorporated by reference into the '766 patent.

ii. Whether Patent Owner Demonstrates Adequate Written Description Support for the Claimed Subject Matter

Petitioner argues that even if Singh906 were effectively incorporated by reference, the challenged claims still lack adequate written description support. *See* Pet. 9. This is because, Petitioner argues, “client application 203” of Singh129 interacts with digital data capture device 201. *Id.* at 9–10 (citing Ex. 1009). Petitioner contrasts this with Singh906, which has a different and distinct “client application 202” that does not interact with a digital capture device. *Id.* (citing Ex. 1010). Petitioner notes several differences between Singh129 and Singh906, including, for example, that

unlike Singh906’s client application 202, Singh129’s client application 203 does **not**: . . . (ii) provide to a remote server authentication credentials, transaction identifications, a list of publication virtual spaces, global positioning system geographical codes, area codes for the phone numbers of the mobile device, file formats of the user created multimedia content or compression rates of multimedia content.

Id. at 10–11 (citing Ex. 1009 ¶ 45; Ex. 1030 ¶ 104).

In addition, Petitioner points out that the challenged claims in the '766 patent all recite that a mobile client application

(a) obtains data from a “short-range wireless enabled data capture device,” and (b) “use[s] HTTP” to upload/transfer “new-data along with user information” to a user data publishing website, and wherein “the user information corresponds to a user identifier.”

Id. at 12. Petitioner alleges this combination is missing from the priority applications. *Id.* Specifically, Petitioner alleges Singh129 only discloses “the first piece” ((a) above) and the ’802 application (published as Singh906) only discloses “the second” piece ((b) above). *Id.*

Furthermore, Petitioner contends that the initial incorporation of the ’802 application, published as Singh906, is insufficient notice to the public and there is no suggestion of how the two applications might be combined or any suggestion that they be combined. Pet. 14.

Patent Owner responds with citations purporting to show that the terms “mobile device” and “client application” are used “dozens of times” in the Provisional application “to disclose precisely that which Petitioner complains is missing.”¹⁹ Prelim. Resp. 49–50. Patent Owner’s presentation of these citations is confusing because Patent Owner makes no effort to identify the cited material as providing written description support for any particular claim limitation in the challenged claims. Nevertheless, we see no citations to the Provisional application that relate to a “mobile client

¹⁹ Although “[o]riginal claims are part of the original specification and in many cases will satisfy the written description requirement,” here neither party cites any original claim language in any of the priority applications that may provide written description support for the challenged claims. *Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275, 1297 (Fed. Cir. 2017).

application” that obtains data from a “short-range wireless enabled data capture device” or “use[s] HTTP” to upload/transfer “new-data along with user information” to a user data publishing website, and wherein “the user information corresponds to a user identifier.” *See* Pet. 12; *see also id.* at vi (limitation [1.17]), viii (limitations [4.23], [4.25]), ix–x (limitations [9.8], [9.16]), xii (limitations [13.20], [13.22]).

The problem with Patent Owner’s approach is that, on the current record, we are not directed to any disclosure that links the relevant features in Singh906 to the Singh129 system, or otherwise indicates that the inventors had possession of a system as disclosed in Singh129, with the additional relevant features taught in Singh906 (e.g., Singh906’s teachings regarding using HTTP to transfer data between client application 202 and the publishing service 204 (Ex. 1010 ¶ 61)). “A patent owner cannot show written description support by picking and choosing claim elements from different embodiments that are never linked together in the specification.” *Flash-Control, LLC v. Intel Corp.*, No. 2020-2141, 2021 WL 2944592, at *4 (Fed. Cir. July 14, 2021) (nonprecedential); *Purdue Pharma L.P. v. Recro Tech., LLC*, 694 F. App’x 794, 797 (Fed. Cir. 2017) (nonprecedential) (finding inadequate written description support where specification disclosed two types of drug-loaded beads, but did not suggest combining those beads into a single dosage form).

Patent Owner asserts that “the ‘client application 202’ as described in Singh906 and the ‘client application 203’ as described in Singh129 are iterations of the exact same mobile application.” Prelim. Resp. 52–53. Patent Owner does not support this argument with citations to the patent disclosures (e.g., Singh906 or any of the alleged priority applications).

Rather, Patent Owner argues that the evolution of its patent applications tracked the evolution of its commercial mobile application, and a person of ordinary skill in the art “would readily understand and appreciate this evolution of the mobile application feature set because mobile applications naturally expand in this manner.” Prelim. Resp. 20–21. Patent Owner argues, for example, that in recognition of this fact, the addition of “Bluetooth feature to the existing mobile application is the reason for ‘incorporated reference’ in Cellspin’s disclosure.” *Id.* at 21.

This argument is unavailing. “[T]he hallmark of written description is disclosure”; “it is the specification itself that must demonstrate possession.” *Ariad Pharms.*, 598 F.3d at 1351, 1352. The evolution of the feature set in Patent Owner’s commercial product is irrelevant. *See, e.g., Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) (“[P]roof of a reduction to practice, absent an adequate description in the specification of what is reduced to practice, does not serve to describe or identify the invention for purposes of § 112, ¶ 1.”). And although adding new features to Singh129’s system may have been the industry norm and obvious to do, “a description that merely renders the invention obvious does not satisfy the [written description] requirement.” *Ariad Pharms.*, 598 F.3d at 1351, 1352; *see also Flash-Control, LLC*, 2021 WL 2944592, at *4 (“The written description requirement is not met when . . . the specification provides at best disparate disclosures that an artisan might have been able to combine in order to make the claimed invention.”).

On the present record, we are not directed to adequate written description support for the limitations reciting receiving data from a “short-range wireless enabled data capture device” or “use[s] HTTP” to

upload/transfer “new-data along with user information” to a user data publishing website, and wherein “the user information corresponds to a user identifier.” *See* Pet. 12. Even if support for these limitations is found in Singh906, beyond the initial incorporation by reference, “Singh906 is not mentioned or otherwise referenced in the specification” of the ’766 patent, and on the current record, we are not otherwise apprised of disclosure within the four corners of the specification that demonstrates possession of the system or mobile application as claimed.

For the above reasons, we determine that Petitioner has demonstrated a reasonable likelihood that the challenged claims lack adequate written description support, and thus that Singh129 qualifies as prior art to the challenged claims.

We next analyze whether Petitioner has demonstrated a reasonable likelihood that the challenged claims are unpatentable as obvious over Singh129 and Singh906.

2. Patentability Over Singh129 and Singh906

The ’766 patent is a continuation of the ’303 application that published as Singh129, and thus the ’766 patent and Singh129 share a specification. *See* Pet. 15; Prelim. Resp. 66; *compare* Ex. 1003 and Ex. 1009; Ex. 1003, code [63]. For purposes of this overview of Petitioner’s arguments, we treat Petitioner’s arguments on independent claim 1 as representative. Petitioner cites Singh129 for most limitations of claim 1. *See* Pet. 19–27. Petitioner turns to Singh906 for two discrete limitations set forth below.

Limitation [1.17] recites: “wherein the mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to use HTTP to upload the received new-data along with user information to a user data publishing website over a cellular data network.” Pet. vi. Petitioner relies on Singh906’s teaching a user authentication module 202e on the mobile device. *Id.* at 26 (citing Ex. 1010 ¶ 26). In addition, Petitioner points to Singh906’s discussion of transferring user preferences, including authentication information, to the publishing service 204 as well as a discussion of virtual spaces. *Id.* (citing Ex. 1010 ¶¶ 17, 28).

Limitation [1.18] recites “wherein the user information corresponds to a user identifier that uniquely identifies a particular user of the user data publishing website and is used by the user data publishing website to publish the new-data for private consumption.” Pet. vi. Petitioner cites Singh906’s disclosure of a “user identifier” that “uniquely identifies a particular user of the user data publishing website (e.g., a user that ‘creates an account on a desired publication virtual space’) and is used by the website (e.g., to log on) to publish the new-data for private consumption.” Pet. 27 (citing Ex. 1010 ¶ 38). Petitioner cites Singh906’s disclosure that “[t]he login information enables the publishing service 204 to access the multiple publication virtual spaces 205 configured by the user 201 on the mobile device.” *Id.* (citing Ex. 1010 ¶ 38). Then Petitioner quotes from Singh906 and its teaching that “[t]he publishing service 204 logs on to the publication virtual space of choice on the user’s 201 behalf and publishes the user created multimedia content.” *Id.* (citing Ex. 1010 ¶ 38).

Petitioner argues that a person of ordinary skill in the art would have been motivated to look to the features of both Singh129 and Singh906 when considering an improved publishing system. Pet. 16. Further, Petitioner points out that Singh129 incorporates by reference the '802 application, published as Singh906. Pet. 16. According to Petitioner, a person of ordinary skill in the art would have been motivated to modify Singh129's system to add Singh906's user authentication credentials to Singh129's user preferences to give the "user more control over the publishing of their multimedia content." *Id.* at 17 (citing Ex. 1030 ¶ 456). Petitioner cites four additional reasons for a person of ordinary skill in the art to modify Singh129 with Singh906 including solving a known problem, avoiding sending authentication credentials to publish content, virtual spaces provided for clients in Singh906, and that authentication credentials would have been an obvious design choice. *Id.* at 17–18 (citing Ex. 1009 ¶ 47, Figs. 2, 5; Ex. 1010 ¶¶ 17, 18, 27; Ex. 1030 ¶¶ 457–461).

Petitioner also asserts a person of ordinary skill in the art would have had a reasonable expectation of success for the modification of Singh129 with Singh906. Pet. 18. Petitioner argues "the proposed combination would have required no more than the application of known techniques (using authentication credentials and HTTP in accordance with Singh906) to a known system (Singh129's system) in the same field of endeavor (media publishing) and from the same assignee (CellSpinSoft) to obtain the benefits described above." *Id.* (citing Ex. 1030 ¶ 461).

Based on the record before us, we find that the combination of Singh129 and Singh906 teaches or suggests all of the limitations of claim 1, and that a person of ordinary skill in the art would have had reason to

combine features from Singh906 into Singh129 with a reasonable expectation of success, for the reasons discussed in the Petition.²⁰ *See* Pet. 16–19. We have also reviewed Petitioner’s contentions with respect to dependent claims 2–15, and find the same for these claims. *See id.* at 28–38.

At this stage, Patent Owner does not dispute that if Singh129 is prior art, the combination of Singh129 and Singh906 would have rendered the challenged claims obvious. *See generally* Prelim. Resp.

For the foregoing reasons, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that claims 1–15 would have been obvious over Singh129 and Singh906.

F. Claims 1–15 as Obvious Over Kahn, Bluetooth (Ground 2a)

Petitioner provides a limitation-by-limitation analysis that claims 1–15 would have been obvious over Kahn and Bluetooth. Pet. 1, 38–109. Petitioner relies on the Lett Declaration. Ex. 1030 ¶¶ 515–665. After considering the arguments and cited evidence of record (including Patent Owner’s arguments addressed below), for the reasons set forth in the Petition, Petitioner has sufficiently shown that Kahn and Bluetooth disclose all the limitations of claims 1–15.

²⁰ We recognize that the disclosures Petitioner relies on to show obviousness over Singh129 and Singh906 may be the same as those Patent Owner urges provide written description for the challenged claims. However, these are distinct inquiries because it is well-settled that “a description that merely renders the invention obvious does not satisfy the [written description] requirement.” *Ariad Pharms.*, 598 F.3d at 1352. Here, Petitioner offers reasoning and evidence, which is unrebutted on the current record, to show that one of ordinary skill in the art would have found it obvious to combine these disclosures as recited in the challenged claims.

A decision to institute under § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). In addition, per Board practice, if the Board institutes trial, it will institute “on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” *See* 37 C.F.R. § 42.108(a) (2023). Accordingly, as to this and all remaining grounds we institute *inter partes* review. *See* Section V.E above.

In accordance with the Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 we provide the following as guidance for the upcoming trial. Ex. 1034, 64.

1. Bluetooth Pairing and Cryptographic Authentication

Patent Owner does not distinguish its arguments as between independent claims 1, 4, 9, and 13, addressing them collectively. *See* Prelim. Resp. 67. As above, we do not differentiate the independent claims for purposes of this Decision and consider claim 1 as illustrative. *See* Section I.E above. Patent Owner should consider focusing on any claim language differences between the independent claims during trial.

Patent Owner contends specifically that “there is zero evidence upon which to conclude that a [person of ordinary skill in the art] would have *elected to use* pairing and cryptographic authentication from among the countless possible combinations available under the Bluetooth standard.” Prelim. Resp. 67 (emphasis added). Patent Owner seems to concede cryptographic authentication is taught by Bluetooth as an option but, because there are so many optional features, the feature would not have been obvious. *Id.* at 68 (citing Ex. 1019, 19, 861).

Patent Owner also notes that pairing is not required but is also a “purely optional” feature. Prelim. Resp. 70 (citing Ex. 1019, 15–16). Instead, Patent Owner argues in 2007 a person of ordinary skill in the art “would have naturally designed in accordance with the Bluetooth Basic Image Profile (‘BIP’) for image pull or push, which at the time specified an unpaired and unauthenticated connection.” *Id.* (emphasis omitted). Further, Patent Owner alleges a person of ordinary skill “in 2007 would have used the default options and would have naturally followed the Basic Image Profile (BIP) guidelines for image transfer.” *Id.* at 71 (citing Ex. 2015, “BIP Specification,” 15–17).

Claim 1 recites “wherein establishing the short-range paired wireless connection comprises cryptographically authenticating identity of the short-range wireless enabled cellular phone.” *See* Pet. v–vi (limitation [1.4]). Limitation [1.4] is the first appearance of “paired” and “cryptographically authenticating” in claim 1. Petitioner relies primarily on the Bluetooth Specification to “render obvious” limitation [1.4]. Pet. 56–59 (citing Ex. 1030 ¶¶ 539–547).

Petitioner argues Bluetooth provides the option of encryption, to prevent hacking or eavesdropping, for paired devices. Pet. 56 (citing Ex. 1019, 412–425 (“discussing pairing using a link key and discussing encryption of transmitted data”), 1031–1038 (generating link keys and encryption keys); Ex. 1017 (Kahn) ¶¶ 45, 96; Ex. 1030 ¶ 539). Relying on the Lett Declaration, Petitioner concludes a person of ordinary skill in the art “would have used the cryptographic authentication and would further have used Bluetooth encryption features when pairing the camera to the host mobile phone.” *Id.* (citing Ex. 1030 ¶ 539). One example of cryptographic

authentication cited is pairing between Bluetooth devices that “includes the generation and exchange of initialization keys created from a PIN, a random number, and a Bluetooth Device Address (BD_ADDR).” *Id.* at 57 (citing Ex. 1019, 540–541). Petitioner further states that “the pairing processes uses the BD_ADDR to form the initialization key (K_{init}) which relies on a cryptographic function.” *Id.* (citing Ex. 1019, 412 (“4.2.2 Pairing”)). Citing the Lett Declaration, Petitioner states “[t]he BD_ADDR is a unique identifier that uses cryptographic authentication to authenticate the identity of the connected device (for example authenticating between camera and cell phone while Bluetooth connection is being established).” *Id.* at 58 (citing Ex. 1030 ¶ 542).

We do not agree with Patent Owner’s suggestion that because they are described as “optional” features, the Bluetooth Specification does not teach the combination of pairing and “cryptographic authentication” recited in the challenged claims. Patent Owner does not cite any authority, beyond unsupported argument, that we should do so. On the current record, we determine Petitioner has sufficiently shown both pairing and cryptographic authentication as recited in limitation [1.4] are taught by Bluetooth and articulated rationale to explain why one of skill in the art would have been motivated to implement those features. Pet. 43–44 (citing Ex. 1011²¹ ¶¶ 66–67; Ex. 1030 ¶¶ 522–524; Ex. 1019).

²¹ Hiroishi, JP 2003-60953A, published February 28, 2003 (Ex. 1011 (English translation), 1012 (certificate of translation), 1013 (original Japanese language publication)).

2. Combination of Kahn and Bluetooth

Separate from V.F.1 above, Patent Owner contends that even if a person of ordinary skill in the art “would have been inclined to implement Bluetooth on top of Kahn, the combination still fails to disclose a number of elements.” Prelim. Resp. 73. Despite Patent Owner’s arguments below, we determine Petitioner’s showing is sufficient to support the alleged combination.

Patent Owner includes a table of alleged limitations not taught by either Kahn or Bluetooth, which is reproduced below.

Claim Limitation	Kahn	Bluetooth Spec.
Short Range or Bluetooth	NO	
Pairing	NO	Optional / NOT Camera use case
Cryptographically authenticating identity of the cellular phone	NO	Optional / NOT Camera use case
Association Protocol	NO	Optional / NOT Camera use case
Timing of Pairing before data capture	NO	Opposite for Camera use case
Signal to Notify new-data	NO	NO
Create New-Data Object wherein the new-data object comprises: 1. signal to notify, 2. the acquired new-data; and 3. associated new-data	NO	NO
Phone to “listen to signal to notify”	NO (Even assuming Petitioner’s argument that timestamp in the image file is a signal (which it is not)). The mobile application in Kahn is NOT teaching to listen to the Time Stamp	NO
Mobile application “processing the signal to notify”	NO (passive pass thru of all data) Even assuming Petitioner’s timestamp in the image file is a signal (which it is not).	NO

“listen and process the signal to notify;”	The mobile application in Kahn is NOT teaching to process/action/change/update the Timestamp.	
HTTP for New Data “Media Transfer”	NO for Media Transfer Kahn uses WMTP (a Transport layer protocol).	NO

Patent Owner’s table of alleged missing limitations.

Prelim. Resp. 74–75.

Patent Owner raises pairing and cryptographic authentication, which were addressed above. Prelim. Resp. 75; *see* Section V.F.1. Patent Owner makes several additional arguments as to why Bluetooth would not have been used by a person of ordinary skill in the art. Those arguments include: poor user experience or the availability of “more[] appropriate” protocols; mobile phones did not have Bluetooth and the default would have been the BIP specification (Ex. 2015); “pairing tak[es] place prior to data capture;” and “the camera use case as taught by the BIP that uses pairing (archive feature) actually required the *opposite* in terms of timing and order of operations.” Prelim. Resp. 75.

The additional arguments regarding Bluetooth do not change our preliminary determination. Fundamentally, Patent Owner’s arguments are unsupported by evidence.

Further, as currently understood, even if ultimately supported, none of the arguments made are shown to be relevant to our preliminary determination on obviousness. Specifically, a “poor user experience” or availability of other “more appropriate” protocols do not preclude a person of ordinary skill from looking to Bluetooth or combining Bluetooth with Kahn. Even if mobile phones at the time of the invention did not have

Bluetooth,²² as of 2001 Bluetooth was a known “short-range connectivity solution” between “personal, portable, and handheld electronic devices.” Ex. 1032,1 (Abstract). Relying on Kahn, not Bluetooth, Petitioner has shown the timing of acquiring new data is after pairing. Pet. 65–70; Ex. 1030 ¶¶ 551–552 (citing Ex. 1017 ¶ 46, 86). Patent Owner needs to develop these arguments as trial proceeds.

Patent Owner further argues that Kahn does not teach a “signal to notify,” which is language from limitation [1.11]. Prelim. Resp. 76. Limitation [1.11] recites the “new-data object comprises: signal to notify, wherein the signal to notify corresponds to the acquiring of the new-data for transfer to the cryptographically authenticated short-range wireless enabled cellular phone.” Pet. v. Petitioner argues a person of ordinary skill in the art “would have recognized that leveraging such data as a notification signal for new image availability aligns with established practices in digital communication systems. . . . For instance, Kahn illustrates the inclusion of a timestamp in the image data sent from the camera to the mobile phone.” *Id.* at 75–76 (citing Ex. 1017 ¶¶ 8, 60, 98; Ex. 1030 ¶ 570). Petitioner further argues that timestamps on “capture photos . . . would naturally serve as a signal to notify the cell phone regarding new-image data on the camera.” *Id.* at 76 (citing Ex. 1017 ¶¶ 8, 60, 98; Ex. 1030 ¶¶ 571–574).

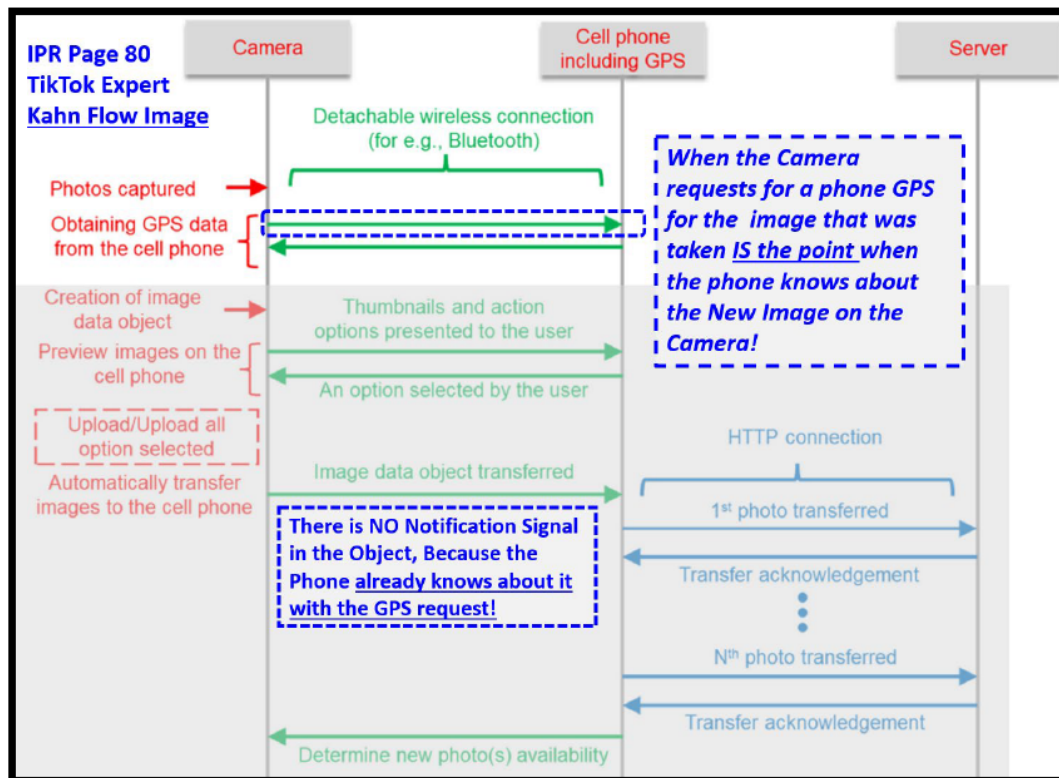
²² This assumption is contrary to the evidence currently of record because Mr. Lett testifies that mobile phones at the time “typically had Bluetooth technology installed,” whereas Patent Owner’s argument to the contrary is merely attorney argument. *See* Ex. 1030 ¶ 523 (citing the original iPhone as an example).

Patent Owner responds that “there is no disclosure in Kahn of any ‘signal to notify,’ because the mobile application of Kahn does *not* listen for the timestamp.” Prelim. Resp. 76. Regardless, Patent Owner alleges there is no “processing” in response to receipt of the signal. *Id.*

Patent Owner argues that the approach of Kahn is “fundamentally opposed to the approach taken in the Challenged Claims.” Prelim. Resp. 76. The argument is that

the Challenged Claims recite a sequence which includes, *inter alia*, the acquisition and storage of new data after establishing the paired connection, as well as the subsequent creation of a new-data object. Following receipt of such new-data object by the mobile phone, the phone transmits using HTTP.

Id. at 78. Patent Owner illustrates the argument with three diagrams. *Id.* at 77–79. Patent Owner’s argument as to “fundamental problems and shortcomings of Kahn can be identified with reference to Patent Owner’s annotated version” of a diagram created by Petitioner’s declarant Mr. Lett. *Id.* at 79. The diagram is reproduced below.



Annotation of dataflow that would be implemented between a camera, a local host (e.g., cell phone) and an online Web-based image management as annotated by Patent Owner.

Prelim. Resp. 79 (annotated²³ from Ex. 1030, 80). According to Patent Owner the above diagram illustrates that “Kahn relies upon a request (from the camera) for the GPS data associated with an image from the mobile phone.” *Id.* at 79–80. Patent Owner contends that only at the time of the request is the mobile phone aware of an image on the camera. *Id.* at 80. Thus, Patent Owner argues “there can be no ‘notification signal’ in the

²³ Patent Owner annotations in dark blue. Prelim. Resp. 79.

object, because the mobile phone has *already* been advised of the existence of the image (by virtue of the GPS request).” *Id.*

Patent Owner does not explain adequately how the above results in a failure of Kahn to meet limitation [1.11]. We understand the argument to be directed to the following part of limitation [1.11]: “the signal to notify corresponds to the acquiring of the new-data for transfer to the cryptographically authenticated short-range wireless enabled cellular phone.” Absent specifics tying these arguments about Kahn to the claim language we are not persuaded that Kahn fails to show limitation [1.11]. If Patent Owner pursues this argument during trial, it needs to develop the argument and supporting evidence.

The remaining limitations allegedly missing from Patent Owner’s Table above, are devoid of argument or supporting evidence. Until supported with argument and evidence, the bare allegations resulting in a “NO” do not alter our preliminary determination that Petitioner’s showing is sufficient.

3. *WMTP not the same as HTTP*

Patent Owner argues that Kahn discloses “Wireless Modular Transport Protocol (‘WMTP’) is a Transport Layer protocol, whereas Hypertext Transfer Protocol (‘HTTP’) is an Application Layer protocol.” Prelim. Resp. 80–81 (citing <https://ieeexplore.ieee.org/document/4689157>).

Kahn also discloses HTTP and is relied on by Petitioner for HTTP in limitation [1.17]. *See* Pet. 87 (citing Ex. 1017 ¶ 56 (the image management server 330 communicates with the host device by establishing “an Internet connection to the server, for example, using HTTP protocol.”)). Any other

argument based on WMTF precluding a person of ordinary skill in the art from combining Bluetooth with Kahn should be developed during trial.

4. No “new-data object”

Patent Owner argues that all of the independent claims “recite the creation of a ‘new-data object’ by the processor.” Prelim. Resp. 85 (citing Ex. 1004, claims 1, 4, 9, and 13 (“said processor further configured to create a new-data object, wherein the new-data object comprises . . . ”)). Patent Owner argues “Kahn fails to disclose any such ‘new-data object,’ [and therefore] Petitioner’s Ground Two necessarily fails.” *Id.*

Limitation [1.10] recites “said processor further configured to create a *new-data object*, wherein the new-data object comprises . . . ” Pet. v (emphasis added). Petitioner cites to Kahn to teach capturing photos as “acquiring new-data.” Pet. 74 (citing Pet. 66 (showing for limitation [1.8]²⁴); Ex. 1017 ¶ 46). Patent Owner proceeds with other arguments without responding to the one Petitioner makes. *See, e.g.*, Prelim. Resp. 85 (arguing Petitioner’s showing for a “new-data object” is Kahn’s header information). Patent Owner argues the header information in Kahn’s image file is not a new data object, but rather just part of the file. *Id.* This argument unpersuasive because it is premised on Patent Owner’s “object” construction, which we preliminarily rejected above. *See* Section V.B.4 above.

²⁴ Limitation [1.8] recites “wherein the new-data is data acquired after establishing the short-range paired wireless connection between the short-range wireless enabled data capture device and the short-range wireless enabled cellular phone.” Pet. v.

Patent Owner's argues the time stamp in Kahn is part of the image data/file and therefore is not sent "along with," i.e., in "*addition* to the acquired new data." Prelim. Resp. 87. (This argument is premised on their construction of "along with," which we found unpersuasive for the reasons explained above. *See* Section IV.B.2 above.

On this record, we determine Petitioner's showing is sufficient.

*G. Claims 1–15 as Obvious Over Kahn, Feinberg, Bluetooth
(Ground 2b)*

Petitioner provides a limitation-by-limitation analysis that claims 1–15 would have been obvious over Kahn, Feinberg, and Bluetooth. Pet. 1, 109–119. Petitioner relies on the Lett Declaration. Ex. 1030 ¶¶ 666–825. Patent Owner views this ground as filling in Kahn's alleged failure to disclose a "signal to notify." Prelim. Resp. 88.

Petitioner alleges a person of ordinary skill in the art would have been motivated to use the thumbnails in the header of Feinberg "as a signal to the mobile phone software that photos have been retrieved from the camera." Pet. 113–118 (citing Ex. 1025 ¶ 91; Ex. 1030 ¶¶ 678–685). Petitioner alleges a person of ordinary skill in the art "would have understood that creating a new-data object would include creating preview images (*i.e.*, thumbnails) as disclosed in Kahn." *Id.* at 116 (citing Ex. 1017 ¶ 79, Figs. 5E, 6; Ex. 1030 ¶ 685).

Patent Owner argues Feinberg "does not disclose the transfer of thumbnails to the mobile phone, inasmuch as it prefers the use of a media card on the camera, which communicates with a Home Network Access Point, which, in turn, communicates with a third-party website." Prelim. Resp. 88–89 (citing Ex. 1025, Fig. 3 (annotated)). Patent Owner argues

there is no teaching in Feinberg of uploading images from the mobile phone. *Id.* at 90 (citing Ex. 1025 ¶ 49 (annotated)).

On this record, Patent Owner’s arguments are not persuasive. As previously noted, the claim language at issue is not pointed out. For the “signal to notify” limitation (limitation [1.11]). On this record, Petitioner’s arguments based on Feinberg are sufficient.

VI. CONCLUSION

For the foregoing reasons, we have determined that there is a reasonable likelihood that the Petitioner would prevail with respect to at least one of the claims challenged in the Petition. We therefore institute trial as to all challenged claims on all grounds stated in the Petition.

VII. NOTICES

At this stage of the proceeding, we have not made a final determination regarding the patentability of any challenged claim or any underlying factual and legal issues. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”). Any final decision in this proceeding will be based on the full trial record.

The Board will deem forfeited any issue not raised by Patent Owner in a timely response to the Petition, or as permitted in another manner during trial, even if asserted in the Preliminary Response or discussed in this decision.

Nothing in this decision authorizes Petitioner, in a manner not otherwise permitted by the Board's rules, to supplement the information pertaining to any ground of unpatentability advanced in the Petition.

In addition, the panel notes the following preferences and expectations:

All papers and exhibits submitted in PDF format should be searchable. Exhibits should be labeled with the exhibit number and page numbers should be added to the extent not present in the original document.

To the extent a party incorporates substantive arguments into a figure, (*see, e.g.*, Prelim. Resp. 68, 69, 77, 78, 79, 82, 83, 89, 90, 91, 92 (adding arguments via annotations to various figures)), those arguments should not appear solely in the figure; they must also be located within the text portions of a brief. Adding lengthy annotations to figures should not be used as a means to circumvent the word limits on the parties' papers. *See* 37 C.F.R. § 42.24.

When citing a website (*see, e.g.*, Prelim. Resp. 12, 13, 23, 24, 32, 34, 55), a party shall file as an exhibit a PDF copy of the cited website page(s).

VIII. ORDER

For the foregoing reasons, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of the '766 patent is hereby instituted for all of the challenged claims on all of the asserted grounds; and

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

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