

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC., SENSEONICS HOLDINGS, INC., and
ASCENSIA DIABETES CARE HOLDINGS AG,
Petitioners,

v.

CELLSPIN SOFT, INC.,
Patent Owner.

IPR2025-00102
Patent 11,234,121 B2

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

HARDMAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

LifeScan, Inc., Senseonics Holdings, Inc., and Ascensia Diabetes Care Holdings AG (collectively, “Petitioners”) request *inter partes* review of claims 1–10 of U.S. Patent No. 11,234,121 B2 (“the ’121 patent,” Ex. 1005). Paper 1 (“Pet.”). Patent Owner Cellspin Soft, Inc. did not file a Preliminary Response.¹

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons explained below, we institute an *inter partes* review of claims 1–10 of the ’121 patent on all challenges in the Petition.

II. BACKGROUND

A. Real Parties in Interest

Petitioners identify LifeScan, Inc., LifeScan Global Corporation, Senseonics Holdings, Inc., Senseonics, Incorporated, Ascensia Diabetes Care Holdings AG, and Ascensia Diabetes Care, Inc. as real parties in

¹ Petitioners originally filed the Petition together with a motion for joinder to IPR2024-00768. See Paper 5. Although Patent Owner filed a preliminary response in response to the original petition in IPR2024-00768 (filed by TikTok, Inc.), it did not file a preliminary response in response in this proceeding. Accordingly, on the record in this proceeding, Patent Owner presents no arguments against institution. Nevertheless, even if we considered the arguments Patent Owner raised in its preliminary response in IPR2024-00768 in connection with the instant Petition, our decision here would be the same. See, e.g., Paper 8 in IPR2024-00768 (instituting trial after due consideration of all of the arguments advanced by Patent Owner at the institution stage).

interest. Pet. 86. Patent Owner identifies itself (Cellspin Soft, Inc.) as the real party in interest. Paper 15 (Patent Owner’s Updated Mandatory Notices) 2.

B. Related Matters

Petitioners and Patent Owner identify the following district court actions involving the ’121 patent: *Cellspin Soft, Inc. v. ByteDance, Ltd. et al.*, 2:23-cv-496 (E.D. Tex.); *Cellspin Soft, Inc. v. LifeScan, Inc.*, 2:24-cv-286 (E.D. Tex.); *Cellspin Soft, Inc. v. Senseonics Holdings, Inc. et al.*, 2:24-cv-263 (E.D. Tex.).² Pet. 86; Paper 15, 2. Petitioners additionally identify *Cellspin Soft, Inc. v. Panasonic Corporation et al.*, 2:23-cv-227 (E.D. Tex.), which is now dismissed. Pet. 86. Patent Owner additionally identifies *Cellspin Soft, Inc. v. Autel Robotics Co., Ltd. et al.*, No. 2:26-cv-00226 (E.D. Tex.) and *Cellspin Soft, Inc. v. SZ DJI Technology Co., Ltd. et al.*, No. 2:25-cv-00949 (E.D. Tex.). Paper 15, 2–3.

Petitioners and Patent Owner both identify *TikTok Inc. v. Cellspin Soft, Inc.*, IPR2024-00768, which involves the ’121 patent. Pet. 86; Paper 8, 2. IPR2024-00768 was instituted on October 1, 2024. This proceeding was subsequently filed and joined with IPR2024-00768, with the

² During an April 8, 2026 teleconference with the parties, Petitioners represented that the related district court litigation in which they are parties is currently stayed and has not progressed beyond the initial pleading stage. The case involving ByteDance has progressed further, but has been stayed since January 26, 2025, “pending final written decision by the PTAB” in IPR2024-00770 and IPRs involving the six related patents noted below. IPR2024-00770, Ex. 1047, 5 (stay order). Patent Owner represented that, as of the date of the teleconference, there had been no discussion with, or update from, the district court regarding a trial schedule in view of the Director’s March 30, 2026 decision reversing institution of those IPRs.

present Petitioners agreeing to participate in an understudy capacity. *See* Paper 9, 11–13. Upon review by the Director, the decision instituting review in IPR2024-00768 was reversed, the order joining Petitioners as petitioners in IPR2024-00768 was vacated, and the Board was instructed to “determine whether the Petition[] in IPR2025-00102 . . . should be instituted on [its] own.” IPR2024-00768, Paper 41, 7; *see also* Paper 14, 2–3 (explaining procedural history). The same instruction was given for the two related cases—IPR2025-00103 and IPR2025-00104. *Id.*

Petitioners additionally identify *inter partes* review proceedings concerning related patents, stating:

The ’121 patent is in the same family as U.S. Patent Nos. 11,659,381 (“the ’381 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”). TikTok Inc. petitioned for *Inter Partes* Review of the ’381, ’121, ’766, ’336, ’757, ’260, and ’030 patents, and Petitioners are concurrently petitioning for *Inter Partes* Review of the ’030 and ’766 patents.

Pet. 86. Petitioners also state that the ’121 patent is “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.” *Id.* Patent Owner additionally identifies IPR2025-00103 and IPR2025-00104. Paper 15, 3.

C. The ’121 Patent (Ex. 1005)

The ’121 patent, titled “Automatic Multimedia Upload for Publishing Data and Multimedia Content,” issued on January 25, 2022, from U.S. Application 16/532,507, filed on August 6, 2019, and claims priority through a series of continuation applications, the earliest of which (U.S. Application 12/333,303) was filed on December 11, 2008. Ex. 1005,

codes (21), (22), (45), (54), (63). The '121 patent also claims priority to a provisional application filed on December 28, 2007. *Id.* at code (60).

The '121 patent “relates to pairing a digital data capture device in conjunction with a mobile device for automatically publishing data and multimedia content on one or more websites simultaneously.” *Id.* at 1:56–60. Figure 2 of the '121 patent, reproduced below, illustrates a system for using a digital data capture device (such as a camera) with a Bluetooth enabled mobile device (such as a mobile phone) for publishing data and multimedia content on one or more websites automatically or with minimal user intervention. *Id.* at 3:36–40.

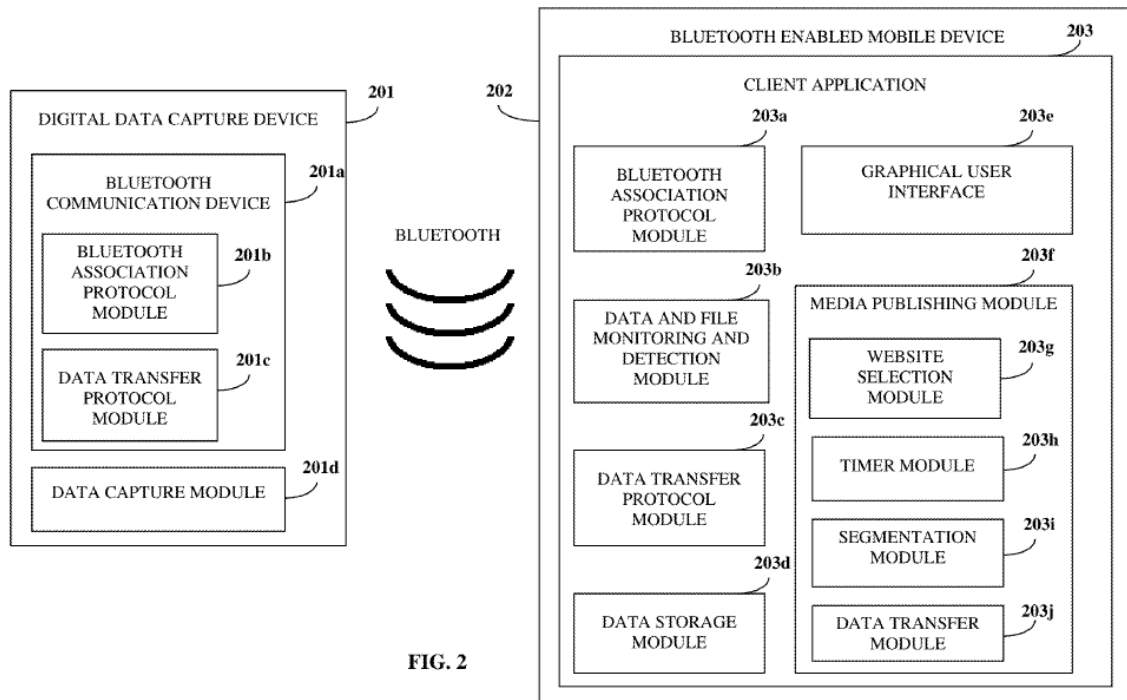


FIG. 2

Figure 2 above illustrates a system including digital data capture device 201, Bluetooth enabled mobile device 202, and client application 203 provided on Bluetooth-enabled mobile device 202. *Id.* at 3:65–67, 6:30–48, 10:15–16.

A Bluetooth connection is established between digital data capture device 201 and mobile device 202. *Id.*

Figure 1, reproduced below, illustrates a method of using digital data capture device 201 in conjunction with mobile device 202 for publishing data and multimedia content on one or more websites automatically or with minimal user intervention. *Id.* at 3:31–35.

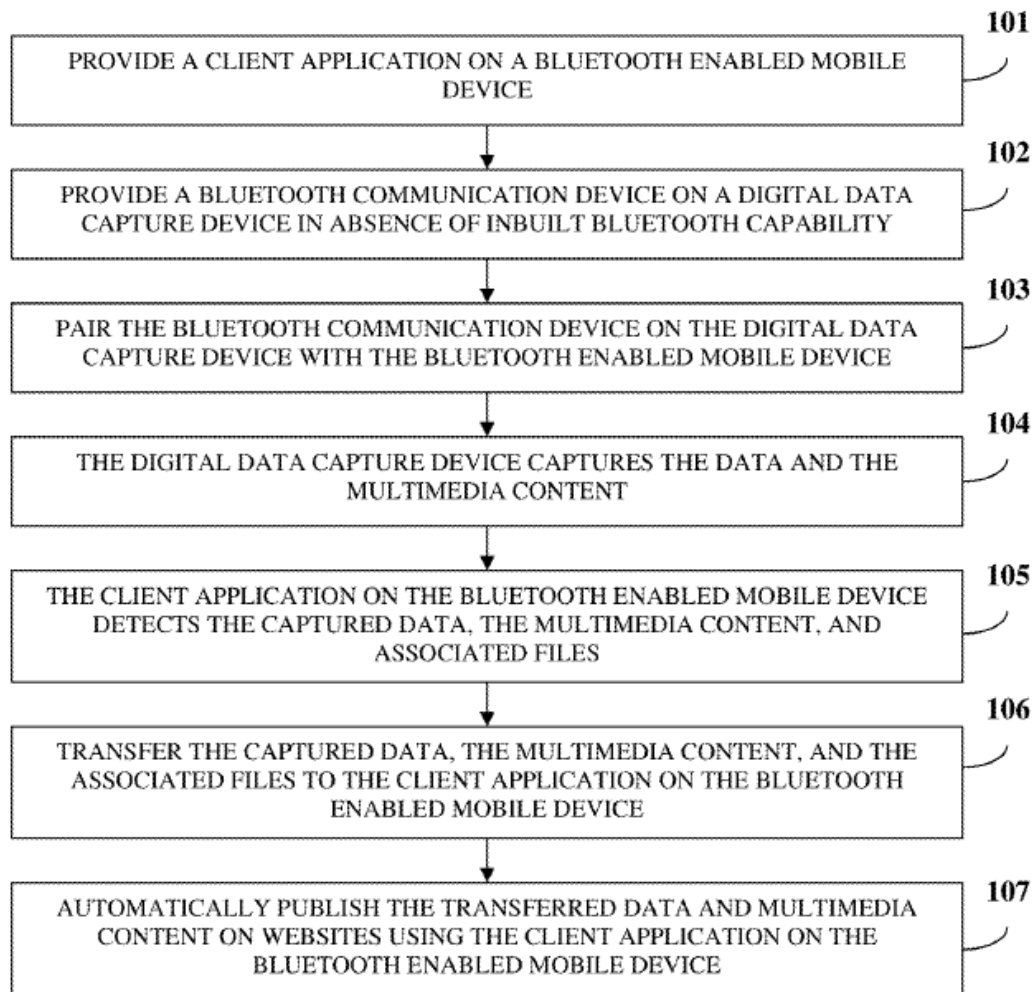


Figure 1 above illustrates a method wherein data capture device 201 is paired with mobile device 202 in step 103. *Id.* at 3:57–6:29. In step 104, data capture device 201 captures data and multimedia content. *Id.* Client

application 203 on mobile device 202 detects the captured data and multimedia content in step 105 and the data and multimedia content are transferred to the client application on the Bluetooth enabled mobile device in step 106. *Id.* In step 107, client application 203 on mobile device 202 automatically publishes the transferred data and multimedia content on one or more websites. *Id.*

Figure 4, reproduced below, illustrates a system for publishing data and the multimedia content using client application 203 on a mobile device on one or more websites simultaneously. *Id.* at 3:45–47.

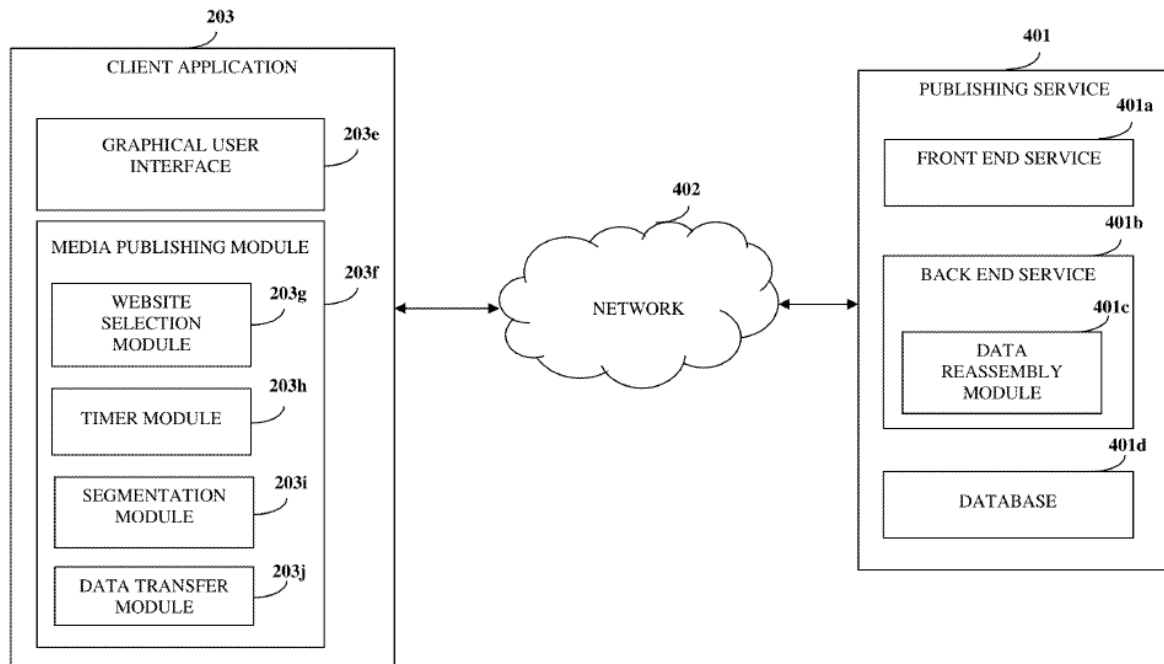


Figure 4 above illustrates the system, including client application 203, publishing service 401, and network 402. *Id.* at 7:66–8:56. Network 402 may be, for example, a wireless network, a cellular network, or the internet. *Id.*

D. The Challenged Claims

Petitioners challenge all claims (1–10) of the '121 patent. Claims 1, 4, 7, and 9 are independent. Claim 1 is reproduced below, with bracketed numbering added:³

1. [1P] A short-range wireless enabled data capture device, comprising:
 - [1.1] a memory device;
 - [1.2] a processor coupled to the memory device;
 - [1.3.1] a short-range wireless communication device configured to establish a short-range paired wireless connection between the short-range wireless enabled data capture device and a short-range wireless enabled cellular phone,
 - [1.3.2] wherein establishing the short-range paired wireless connection comprises the short-range wireless enabled data capture device cryptographically authenticating identity of the short-range wireless enabled cellular phone;
 - [1.4] a data capture circuitry;
 - [1.5.1] said processor configured to acquire new-data in the short-range wireless enabled data capture device using the data capture circuitry, [1.5.2] 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;
 - [1.6] said processor further configured to store the new-data in the memory device;
 - [1.7.1] said processor further configured to send an event notification and the acquired new-data to the cryptographically authenticated short-range wireless enabled cellular phone over the established short-range paired wireless connection automatically, [1.7.2] wherein the

³ For ease of reference, we use the same numbering Petitioners use in the Petition. *See, e.g.*, Pet. vi–vii.

event notification corresponds to the acquired new-data and comprises sending a signal to the cryptographically authenticated short-range wireless enabled cellular phone, [1.8] wherein the cryptographically authenticated short-range wireless enabled cellular phone is configured to listen to the event notification and receive the new-data over the established short-range paired wireless connection, [1.9.1] wherein a single mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to process the event notification and [1.9.2] store the received new-data in a memory device of the cryptographically authenticated short-range wireless enabled cellular phone, [1.10] wherein the single mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone stores a user authentication credential in the memory device of the cryptographically authenticated short-range wireless enabled cellular phone, [1.11] wherein the single mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone is configured to use HTTP to upload the received new-data and the user authentication credential to a user data publishing website over a cellular data network, [1.12] wherein the upload is based on a timer setting on the single mobile client application, wherein the timer setting is no wait automatic or wait X minutes automatic, [1.13] wherein the single mobile client application for the short-range wireless enabled cellular phone is further configured to use the HTTP to send a user preference to the user data publishing website over the cellular data network, wherein the user preference comprises global positioning system information, and [1.14] wherein the single mobile client application for the cryptographically authenticated short-range wireless enabled cellular phone provides a touch based GUI for the received new-data.

Ex. 1005, 12:22–13:15.

E. Asserted Grounds of Unpatentability

Petitioners assert that claims 1–10 are unpatentable on the following two grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1–10	103	Hiroishi, ⁴ Kahn, ⁵ Endsley, ⁶ Bluetooth ⁷
2	1–10	103	Singh129, ⁸ Singh906 ⁹

Pet. 1. Petitioners support their contentions with the Declaration of David B. Lett (Ex. 1030), among other evidence.

⁴ Hiroishi, Japanese Unexamined Patent Application Publication 2003-60953, published February 28, 2003 (“Hiroishi”). The record includes the original Japanese language publication (Exhibit 1013), a translation (Exhibit 1011), and a certificate of translation (Exhibit 1012). For purposes of this Decision we use the certified translation (Exhibit 1011).

⁵ Kahn et al., U.S. Patent App. Pub. US 2004/0004737 A1, published January 8, 2004 (“Kahn,” Ex. 1017).

⁶ Endsley et al., U.S. Patent App. Pub. US 2006/0139474 A1, published June 29, 2006 (“Endsley,” Ex. 1024).

⁷ Petitioners cite two separate documents for “Bluetooth.” Pet. 18–20. The first document is Bluetooth Specification Version 2.1 + EDR, dated July 26, 2007 (“Bluetooth Core Specification,” Exhibit 1019). The second document is C. Bisdikian, “An Overview of the Bluetooth Wireless Technology,” IEEE Communications Magazine, vol. 39, no. 12, pp. 86–94, December 2001 (“Bluetooth Overview,” Exhibit 1032).

⁸ Singh et al., U.S. Patent App. Pub. US 2009/0172129 A1, published July 2, 2009 (“Singh129,” Ex. 1009).

⁹ Singh, U.S. Patent App. Pub. US 2008/0103906 A1, published May 1, 2008 (“Singh906,” Ex. 1010).

III. ANALYSIS

A. Principles of Law

In an *inter partes* review, “the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Petitioners ultimately bear the burden of persuasion to prove unpatentability of each challenged claim by a preponderance of the evidence. 35 U.S.C. § 316(e). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Board may authorize an *inter partes* review if we determine that the information presented in the Petition and any response shows a reasonable likelihood that Petitioners will prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a).

Under 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; *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved based on underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any objective indicia of obviousness or

nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). An obviousness determination requires finding a reason to combine accompanied by a reasonable expectation of achieving what is claimed in the challenged patent. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 550 U.S. at 419–20.

B. Level of Ordinary Skill in the Art

We consider the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time the invention was made. *See Graham*, 383 U.S. at 17–18. Petitioners contend that a person of ordinary skill in the art (sometimes abbreviated herein as “POSITA”) 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 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 (citations omitted) (citing Ex. 1030 (Lett Decl.) ¶¶ 94–95).

Because Petitioners’ proposed level of ordinary skill in the art appears to be consistent with the cited prior art and is undisputed on this record, we adopt it for purposes of this Decision. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (indicating that the prior art itself may reflect an appropriate skill level).

C. Claim Construction

In AIA proceedings we interpret a claim “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). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.* “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention,” “after reading the entire patent” and its prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1321 (Fed. Cir. 2005) (en banc). “There are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of the claim term either in the specification or during prosecution.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Although extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises can be consulted to understand the meaning of a claim term, extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Petitioners assert that no express constructions are required to institute review and find the challenged claims unpatentable. *See* Pet. 7.

We find it unnecessary to construe any claim term to decide whether Petitioners satisfy the “reasonable likelihood” standard for instituting trial. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d

1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe 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))).

Any final written decision entered in this case may include express claim constructions, or may include discussion of claim scope that differs from that provided in our analysis in this Decision. Any final claim constructions will be based on the full trial record.

D. Overview of Asserted Prior Art

1. Hiroishi (Exhibit 1011)

Hiroishi, titled “Photographing System, Photographing Method, Camera, Recording Medium, and Program,” relates to “a photographing system, a photographing method, a camera, a recording medium and a program that allows a photographer him/herself to reliably take a self-portrait.” Ex. 1011, codes (54), (57).

Figure 1 of Hiroishi is reproduced below.

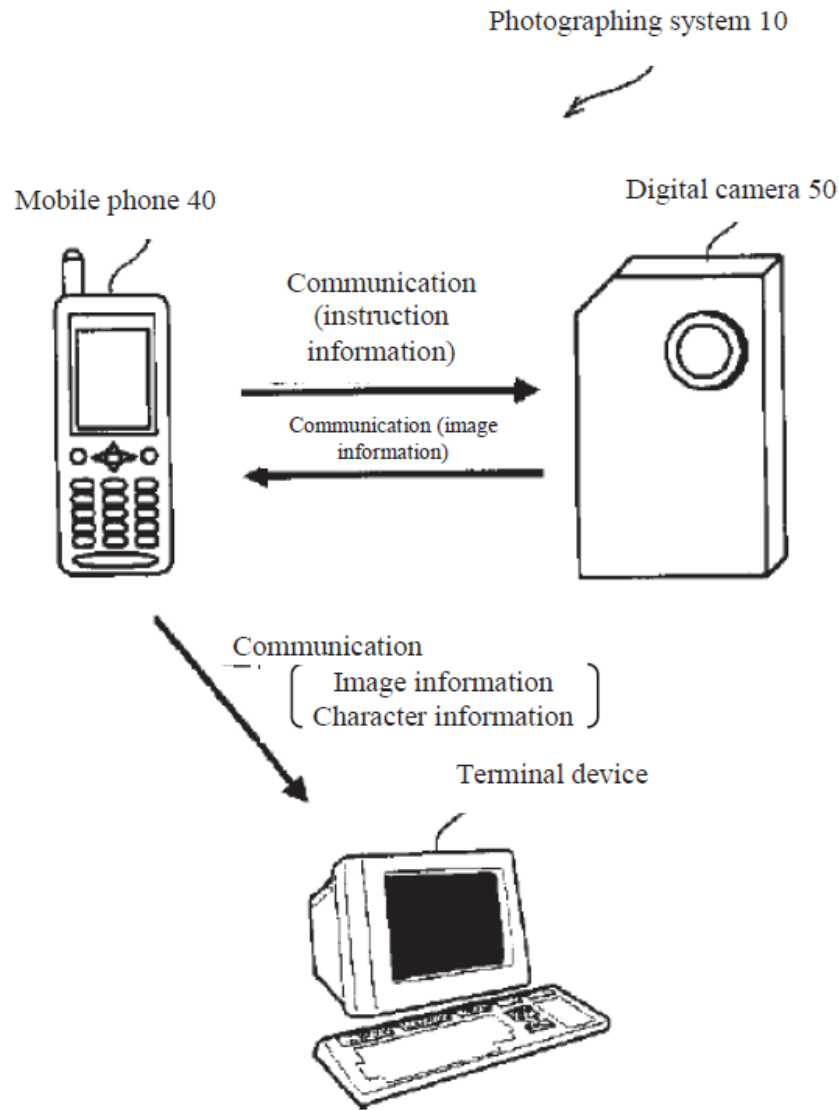


Figure 1 depicts photographing system 10 having mobile phone 40, digital camera 50, and a terminal device. *Id.* ¶ 42. Digital camera 50 acquires image information showing an object image, and sequentially transmits the acquired image information to mobile phone 40. *Id.* at code (57).

Photographing system 10 is configured for two-way wireless Bluetooth communication between mobile phone 40 and digital camera 50. *Id.* ¶¶ 66, 67. Mobile phone 40 transfers to a terminal device the image information

received from digital camera 50 together with character information. *Id.* at code (57), ¶ 44. Keys provided to mobile phone 40 are used to remotely operate digital camera 50 by transmitting various instruction information from mobile phone 40 to digital camera 50. *Id.* ¶ 43.

2. Kahn (Exhibit 1017)

Kahn, titled “Imaging System Providing Automated Fulfillment of Image Photofinishing Based on Location,” relates to “improved techniques for the organization and processing (e.g., photofinishing) of digital images based on information indicating where the images were captured and/or where the user is presently located.” Ex. 1017, codes (54), (43), (21), (22), ¶ 4.

Figure 3, reproduced below, is a high-level block diagram illustrating basic components of the system. *Id.* ¶ 23.

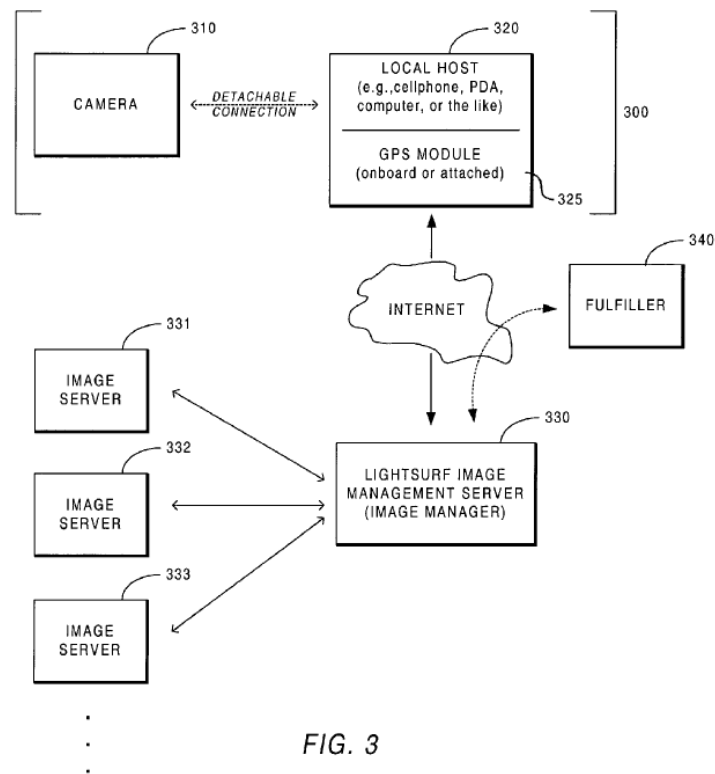


Figure 3 above depicts camera 310 (which is preferably a wireless camera), local host 320 (such as a cellular phone), and GPS module 325, which provides real-time GPS information to the host 320. *Id.* ¶ 55.

Host device 320 establishes an internet connection to online Web-based image management server 330, using, e.g., HTTP protocol. *Id.* ¶ 56. Location ID information (e.g., GPS information) from GPS module 325 is associated with the captured images. *Id.* ¶¶ 57, 58. The location information may be used to offer location-dependent promotions to the user. *Id.* ¶ 51.

3. Endsley (Exhibit 1024)

Endsley, titled “System and Camera for Transferring Digital Images to a Service Provider,” published on June 29, 2006. Ex. 1024, codes (54), (43). Endsley “is directed to an apparatus and system for transferring images captured by a digital camera to a service provider over a communication network.” *Id.* ¶ 2.

Figure 1, reproduced below, illustrates a system and apparatus in accordance with Endsley. *Id.* ¶ 19.

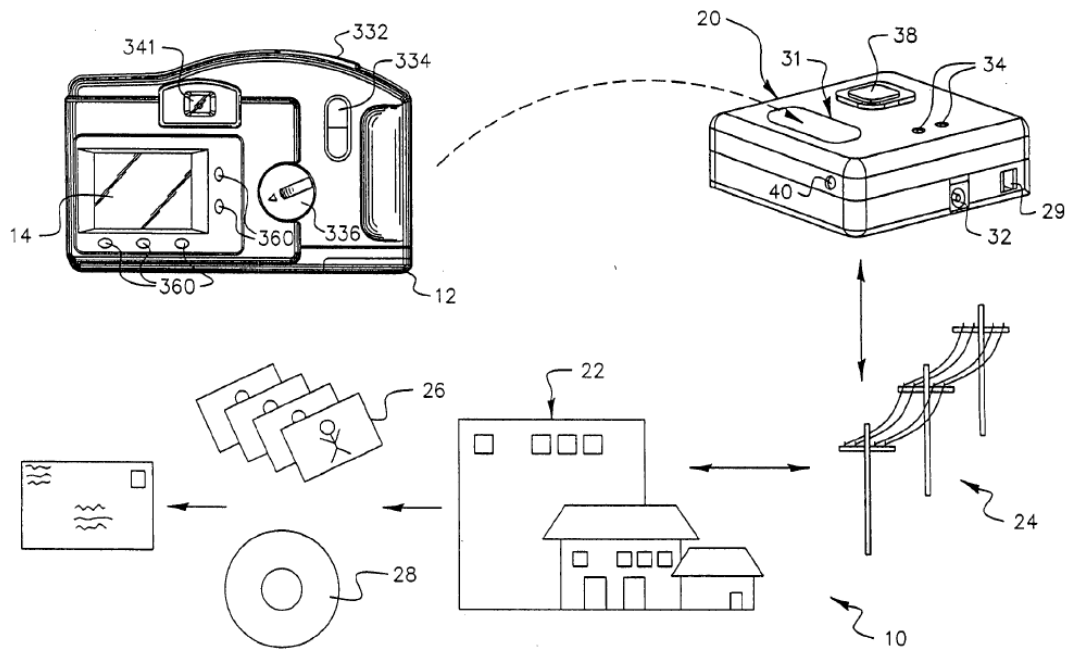


Figure 1 above illustrates system 10, with digital camera 12 and communication device 20. *Id.* ¶¶ 27, 43, 44. Communication device 20 is designed to dock with digital camera 12. *Id.* When docked, the devices cooperate to transfer images captured by the camera to service provider 22 over communication network 24. *Id.* ¶¶ 27–29, 32–33, 43–44. Service provider 22 produces prints 26 and picture CDs 28. *Id.* ¶ 44.

Communication device 20 includes an internal clock (not shown) that is regulated in accordance with a standard time clock such that the transmission of digital data occurs at certain designated time periods. *Id.* ¶ 48. Communication device 20 may wait to initiate data transfer until a predetermined time when transmission rates are low. *Id.* ¶ 55.

4. *Bluetooth (Exhibits 1019 and 1032)*

As discussed above (*see supra* footnote 6), Petitioners cite two separate documents for “Bluetooth,” i.e., the Bluetooth Core Specification (Ex. 1019) and Bluetooth Overview (Ex. 1032).¹⁰

The Bluetooth Core Specification is a specification of the Bluetooth System, Covered Core Package version 2.1 + EDR [Enhanced Data Rate]. Ex. 1019, 1, 45.¹¹ The Bluetooth Core Specification is an extensive document comprising over 1400 pages. Among other things, the Bluetooth Core Specification describes Secure Simple Pairing (*id.* at 131–36), LMP [link manager protocol]-pairing (*id.* at 88, 1260, 1269–70), payload format and packets and their characteristics (*id.* at 291–98), sniff mode and polling mode (*id.* at 128–29, 332, 345–48), and poll packets (*id.* at 283).

Bluetooth Overview provides an overview of Bluetooth technology. Ex. 1032, 1. It states, “Bluetooth wireless technology will serve primarily as a replacement of the interconnect cables between a variety of personal devices, including notebook computers, cellular phones, personal digital assistants (PDAs), digital cameras, etc.” *Id.* (footnote omitted). It further states, “[c]onnecting to data services through one’s cellular phone gives rise to the concept of a *personal gateway*. People will carry their personal gateways wherever they go.” *Id.*

¹⁰ Bluetooth Overview is dated 2001 and notes that at that time the Bluetooth specification was “at version 1.1.” Ex. 1032, 2. Neither party identifies any pertinent distinction between the version of Bluetooth described in Bluetooth Overview (Ex. 1032) and the 2.1 + EDR version in the Bluetooth Core Specification (Ex. 1019).

¹¹ For Exhibits 1019 and 1032 we use the page numbering applied to the bottom middle of each page.

5. Singh129 (Exhibit 1009)

Singh129, titled “Automatic Multimedia Upload for Publishing Data and Multimedia Content,” is the July 2, 2009 publication of the ’303 application (i.e., the first non-provisional application in the series of continuation applications that led to the ’121 patent). Ex. 1009, codes (54), (43), (21), (22). Singh129 has the same disclosure as the specification of the ’121 patent. *Compare* Ex. 1005, with Ex. 1009.

6. Singh906 (Exhibit 1010)

Singh906, titled “Online Publishing of Multimedia Content,” is the May 1, 2008 publication of the ’802 application. Ex. 1010, codes (54), (43), (21), (22). The ’121 patent incorporates the ’802 application by reference. *See* Ex. 1007, 1:50–54.

Figure 2, reproduced below, illustrates a system for publishing user-created multimedia content on publication virtual spaces. Ex. 1010 ¶¶ 13, 25.

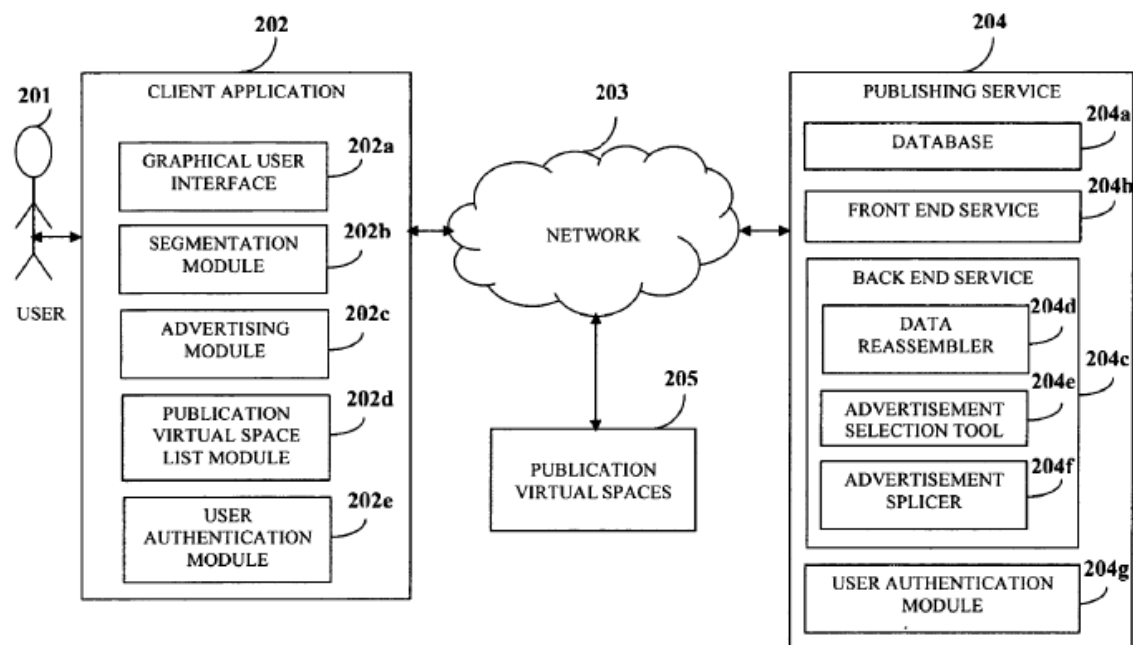


Figure 2 above illustrates user 201, client application 202 on a mobile device of the user, network 203, publishing service 204, and publication virtual spaces 205. *Id.* ¶¶ 17, 20. Client application 202 provides a graphical user interface 202a for user 201 to record content and transfer user-created multimedia content to publishing service 204. *Id.* Front end service 204b of publishing service 204 publishes the media content according to user preferences on one or more publication virtual spaces 205 via network 203. *Id.* ¶ 23; *see also* Fig. 4 (steps 407–411).

User 201 may set preferences on the mobile device including authentication credentials and global positioning system geographical codes. *Id.* ¶ 28; *see also* Fig. 2 (user authentication modules 202e and 204g), ¶ 23 (user preferences may comprise authentication credentials and global positioning system geographical codes; user 201 stores preferences during registration with publishing service 204), ¶ 34. The user preferences are transferred to publishing service 204. *Id.* ¶¶ 28, 34 (database 204a of publishing service 204 comprises user profiles). Advertisements may be displayed to user 201 on the mobile device while user 201 is using client application 202 for recording and publishing the multimedia content. *Id.* ¶¶ 21, 22, Fig. 2 (advertising module 202c, advertisement selection tool 204e, advertisement splicer 204f), Fig. 3 (advertisement), ¶¶ 32, 36 (targeted advertisements based on the user profile may be selected by advertisement selection tool 204e), ¶ 42.

E. Ground 1 – Alleged Obviousness Over Hiroishi, Kahn, Endsley, and Bluetooth

Petitioners assert that claims 1–10 are unpatentable as obvious over the combination of Hiroishi, Kahn, Endsley, and Bluetooth. Pet. 16–65.

After considering Petitioners’ arguments and cited evidence, we find that for purposes of institution, Petitioners have shown a reasonable likelihood of establishing that claims 1–10 are unpatentable as obvious over the combination of Hiroishi, Kahn, Endsley, and Bluetooth.

We begin with a brief summary of Petitioners’ arguments.

1. Brief Overview of Petitioners’ Arguments

Petitioners cite Hiroishi’s teachings of a photograph system that includes a mobile phone¹² paired via a short-range wireless (Bluetooth) connection to a camera, and a program that allows the photographer to remotely control the camera via the mobile phone to take self-portraits. *See, e.g.,* Pet. 21, 30–54.¹³ “In the combination, Hiroishi’s camera includes a short-range wireless communication device (‘communication unit 59’) configured to establish a short-range paired wireless connection (a Bluetooth connection) between the short-range wireless enabled data capture device (camera 50) and a short-range wireless enabled cellular phone (‘mobile phone 40’).” *Id.* at 33 (citing Ex. 1011 (Hiroishi), Figs. 1–4, ¶¶ 43–49, 51–52, 58, 66–67; Ex. 1019 (Bluetooth Core Specification) 87).

Regarding limitations [1.3.1] and [1.3.2] which are directed to a paired wireless connection between the data capture device and the cellular phone, where the pairing comprises cryptographically authenticating the identity of the phone, Petitioners argue that Hiroishi teaches a Bluetooth connection between the camera and the phone, and “cryptographically

¹² We use the terms “mobile phone” and “cellular phone” interchangeably herein.

¹³ For purposes of this overview of Petitioners’ arguments, we treat Petitioners’ arguments for independent claim 1 as representative.

authenticating the identity of phone 40 was [] required to pair Hiroishi's Bluetooth camera 50 and phone 40." Pet. 35 (citing Ex. 1019 (Bluetooth Core Specification) 410–12); *see also id.* at 33–36. This is because, Petitioners argue, "the pairing process includes the exchange of BD_ADDR, which is a Bluetooth device identifier, along with an initialization key and PIN." *Id.* at 36 (citing Ex. 1019 (Bluetooth Core Specification) 89, 410–12; Ex. 1030 (Lett Decl.) ¶¶ 925–26). Petitioners also argue that cryptographic authentication between Bluetooth devices, e.g., Hiroishi's camera and mobile phone, was routine at the time of the alleged invention. Pet. 19.

Regarding the cellular phone being configured to listen for an event notification from the camera (limitation [1.8]), Petitioners assert that "[i]n the combination, Hiroishi's phone 40 is configured to listen for the event notification (Hiroishi's thumbnail and/or Kahn's timestamp)," and "for responses to Bluetooth polling requests." Pet. 44 (citing Ex. 1011 (Hiroishi) ¶¶ 66–67, 93, 104, 107; Ex. 1030 (Lett Decl.) 957; Ex. 1019 (Bluetooth Core Specification) 332).

Regarding the use of hypertext transfer protocol ("HTTP") by the mobile client application on the cellular phone to upload the received new-data and a user authentication credential to a publishing website (limitation [1.11]), Petitioners argue that a person of ordinary skill in the art would have been motivated to use HTTP because "Hiroishi already teaches the desire to transfer image data from a digital camera to a mobile device and to a terminal device," and Kahn "teaches an efficient and predictable technique [i.e., HTTP] for uploading image data (captured by a camera) from a mobile device to a publishing website." Pet. 23 (citing Ex. 1011 (Hiroishi) ¶¶ 44, 82, 107; Ex. 1017 (Kahn) ¶¶ 57–63; Ex. 1030 (Lett Decl.) ¶¶ 828–45).

Petitioners argue that use of HTTP for packet data transfer was well known at the time of the alleged invention. *Id.* at 24.

Regarding the use of a timer setting for the upload of to the data publishing website (limitation [1.12]), Petitioners argue that a person of ordinary skill in the art would have been motivated to implement Endsley's teaching that "the communication device 20 may wait to initiate data transfer until a predetermined time" in Hiroishi's system because it advantageously permitted "choosing a transmission time that would result in lower transmission rates and higher likelihood of success." Pet. 51 (citing Ex. 1024 (Endsley) ¶¶ 55, 48), 28 (citing Ex. 1030 (Lett Decl.) ¶ 843).

Regarding the portions of limitations [1.10], [1.11], and [1.13] directed to transferring a user authentication credential and GPS information to a user data publishing website, Petitioners cite Kahn's teachings of using user authentication credentials (network access identifier or NAI, such as a user's cell phone number and password) to allow access to photos, and sending GPS location information to the user data publishing website, either attached to the image data and/or as a separate data item. Pet. 49–52; Ex. 1017 (Kahn) ¶¶ 51, 56–58, 62, 64, 71–72, 74, 82, 84, 94, 98, Figs. 5A–F, claim 12; Ex. 1030 (Lett Decl.) ¶¶ 966–67. Petitioners argue that a person of ordinary skill in the art would have implemented Kahn's use of user authentication credentials and GPS information in Hiroishi's system because they would have recognized "the advantage of being able to uniquely identify the owner of the images" via the credentials (for example when printing photos at Hiroishi's print shop), while the GPS information would allow for identification of local print shops/fulfillment centers and "would

add to the later viewing enjoyment of the pictures by [providing] the location reminder of each photograph.” *Id.* at 25–26.

2. Conclusion – Ground 1

After considering the arguments and cited evidence of record, we determine that for purposes of institution, Petitioners sufficiently show that the combination of Hiroishi, Kahn, Endsley, and Bluetooth teaches or suggests each limitation of claims 1–10, and that a person of ordinary skill in the art would have had a reason to combine the teachings of these references with a reasonable expectation of success. *See, e.g.*, Pet. 16–64.

Accordingly, on this record, Petitioners show a reasonable likelihood of prevailing on Ground 1, and on this basis, we institute an *inter partes* review of all challenged claims. *See* 37 C.F.R. § 42.208(a).

F. Ground 2 – Alleged Obviousness Over Singh129 in View of Singh906

For Ground 2, Petitioners assert that claims 1–10 are unpatentable as obvious over Singh129 in view of Singh906. Pet. 65–83. As discussed above (*see supra* Section III.D.5), 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 ’121 patent), and has the same disclosure as the specification of the ’121 patent. *See* Pet. 65; *compare* Ex. 1005, *with* Ex. 1009. Because Singh129 is within the priority chain of the ’121 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 ’121 Specification by reference was effective; and (ii) even if it were effective, whether the challenged claims find adequate written description support in the asserted priority applications (including the disclosure of Singh906).

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

1. 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, 1351 (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.

Petitioners dispute that Patent Owner effectively incorporated the disclosures of Singh906 into the ’121 patent and thus that these disclosures are unavailable to provide written description support for the challenged claims. *See, e.g.*, Pet. 14–15. We begin our analysis with this issue.

a. Whether the Incorporation by Reference of Singh906 was Effective

As noted above, Singh906 is the publication of the ’802 application. *See supra* Section III.D.6. The ’121 patent incorporates the ’802 application by reference, stating: “The following patent application is incorporated herein in its entirety: U.S. 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. 1005, 1:48–52.

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)) places certain requirements on material that is incorporated by reference.

Rule 57(d) defines “essential 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).

Petitioners assert 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 (’121 patent prosecution history) 310, 241, 257, 179). As such, Petitioners argue that Patent Owner needed to have incorporated by reference “a U.S. patent or U.S. patent application publication, not . . . an unpublished application like the ’802 application.” *Id.* at 14. Petitioners contend 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 ’121 patent to cite Singh906 during prosecution,” but “[i]t did not do so.” *Id.* at 15.

Petitioners argue that without an effective incorporation by reference of Singh906, the challenged claims cannot claim priority to any date earlier

than the August 6, 2019, filing date of U.S. Application No. 16/532,507, i.e., the application that led directly to the '121 patent. *See* Pet. 16; Ex. 1005, codes (21), (22); *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).

Petitioners contend that “there is no description in the priority applications of the claimed client application using HTTP to upload . . . user information or global positioning information to a user data publishing website or using user information to publish the new data for private consumption.” Pet. 13–14; *see also, e.g.*, Pet. vi, ix, x, xiii (limitations [1.11], [1.13], [4.18], [4.19], [7.10], [7.11.1], [9.13], [9.14], all reciting use of HTTP to upload user and GPS information); Ex. 1005, 13:21–25 (claim 3 reciting “publish the new-data for private use”). Petitioners assert that during prosecution when the Examiner rejected the claims because the Specification failed to sufficiently describe (i) the user preferences comprising authentication credentials and GPS information, and (ii) the use of HTTP to upload such information to the user data publishing website, the applicant cited only disclosures in the '802 application/Singh906, thus making the cited disclosures “essential material” under Rule 57. Pet. 14–15 (citing Ex. 1006 ('121 patent prosecution history) 241, 257, 179).

On the current record and in view of the facts of this case, deeming the incorporation by reference to be ineffective would exalt form over substance. Although the incorporation-by-reference statement in the '121 Specification refers to the unpublished '802 application, the corresponding U.S. patent application publication (Singh906) was published on 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 '121 patent), and was thus available to a person looking to find a copy of the '802 application. Additionally, during prosecution of the '121 patent, Patent Owner (as the patent applicant) cited both the '802 application and Singh906 when indicating written description support for certain claim limitations. *See, e.g.*, 1006 ('121 patent prosecution history) 199–216, 270–75, 278–83. Despite the language of the incorporation by reference statement, the Examiner allowed the claims, and the '121 patent issued.

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 '121 patent.

b. Whether There is Adequate Written Description Support for the Claimed Subject Matter

Petitioners argue that even if Singh906 were effectively incorporated by reference, the challenged claims still lack adequate written description support. *See* Pet. 15. This is because, Petitioners argue, “there is no disclosure in any priority application directing a skilled artisan to use any of Singh906’s features in Singh129’s client application 203, much less use the specific features recited in the Challenged Claims.” *Id.*

Although Singh906 may provide written description support for some or all of these limitations as Patent Owner asserted during prosecution, on the current record we are not directed to any disclosure that links the relevant features in Singh906 to the system described in the asserted priority applications, or otherwise indicates that the inventors had possession of a system as disclosed in the asserted priority applications, with the additional relevant features taught in Singh906 (e.g., Singh906’s teachings regarding

the use of HTTP or global positioning information). “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).

On the present record, we are not directed to adequate written description support for the claimed client application using HTTP to upload user information or global positioning information to a user data publishing website, or using user information to publish the new data for private consumption. Even if support for certain of these limitations could be found in Singh906, we are not otherwise apprised on the current record 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 Petitioners have demonstrated a reasonable likelihood that the challenged claims lack adequate written description support, and thus that the applicable priority date for the challenged claims is August 6, 2019. *See* 35 U.S.C. § 100(i). Accordingly, Singh129, which published on July 2, 2009, qualifies as prior art to the challenged claims. *See* Ex. 1009, code (43).

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

2. Whether the Challenged Claims are Unpatentable as Obvious Over Singh129 and Singh906

Petitioners contend that the challenged claims are unpatentable over Singh129 and Singh906. Pet. 65–83. As a reminder, the ’121 patent is a continuation of the ’303 application that published as Singh129, and thus the ’121 patent and Singh129 share a specification. *See* Pet. 65; *compare* Ex. 1005, *with* Ex. 1009; Ex. 1005, code (63).

For purposes of this overview of Petitioners’ arguments, we treat Petitioners’ arguments on independent claim 1 as representative. Petitioners cite Singh129 for most limitations of claim 1. *See* Pet. 68–76. Petitioners turn to Singh906 for discrete information, as follows.

Petitioners argue that a person of ordinary skill in the art would have modified Singh129’s client application 203 “to include user preferences comprising user authentication and GPS information as taught by Singh906.” Pet. 73–75 (analysis for claim limitations [1.9.1], [1.9.2], [1.10], [1.11], citing, *e.g.*, Ex. 1010 (Singh906) Figs. 2, 4, ¶¶ 23, 25–26, 28). “[I]n the combination, the media is transferred with the user authentication credentials to the website by the client application.” *Id.* at 75. Petitioners argue that “[a]s confirmed in Singh906, the user authentication credential is a user preference,” and “the user preferences also include global positioning information as taught by Singh906.” *Id.* at 76 (analysis for claim limitation [1.13], citing, *e.g.*, Ex. 1010 (Singh906) ¶ 23; Ex. 1030 (Lett Decl.) ¶ 1035).

Petitioners argue that a person of ordinary skill in the art would have been motivated to modify Singh129’s system to add Singh906’s user authentication credentials, user preferences, and GPS information because (i) doing so “would have given the user more control over the publishing of

their multimedia content;” (ii) there was a known problem of associating multimedia objects with user preferences that was solved by Singh906’s user preferences; and (iii) modifying Singh129’s client application to upload user preferences (e.g., authentication credentials and GPS information) to websites “would increase the speed at which content could be uploaded because it would reduce the number of data transmissions.” Pet. 66–67; Ex. 1030 (Lett Decl.) ¶¶ 1014–16.

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. *See* Pet. 65–76. We have also reviewed Petitioners’ contentions with respect to claims 2–10, and find the same for these claims. *See id.* at 76–83.

For the foregoing reasons, we determine that Petitioners have established a reasonable likelihood that it would prevail in showing that claims 1–10 would have been obvious over Singh129 and Singh906.

IV. CONCLUSION

We determine that the information presented establishes a reasonable likelihood that Petitioners would prevail in showing that at least one of the challenged claims of the ’121 patent is unpatentable.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted based on all grounds asserted in the Petition; and

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

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