

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.

CELLSPINSOFT, INC.,
Patent Owner.

IPR2025-00103
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

LifeScan, Inc., Senseonics Holdings, Inc., and Ascensia Diabetes Care Holdings AG (“Petitioner”) request inter partes review of claims 1–15 of U.S. Patent No. 9,900,766 B2 (“the ’766 patent,” Ex. 1003). Paper 1 (“Pet.”). Cellspin Soft, Inc. (“Patent Owner”) did not file a Preliminary Response.

Based on the current record and for the reasons explained below, we institute an inter partes review of claims 1–15 of the ’766 patent on all challenges in the Petition. Upon consideration of the Petition 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 LifeScan, Inc., LifeScan Global Corporation, Senseonics Holdings, Inc., Senseonics, Incorporated, Ascensia Diabetes Care Holdings AG, and Ascensia Diabetes Care, Inc. as real parties in interest. Pet. 114. Patent Owner identifies itself (Cellspin Soft, Inc.) as the real party in interest. Paper 8 (Patent Owner Mandatory Notices) 2.

C. Related Proceedings

Petitioner and Patent Owner identify the following district court actions involving the ’766 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.). Pet. 114; Paper 8, 2. Patent Owner further identifies *Cellspin Soft, Inc. v. Autel Robotics Co., Ltd. et al.*, No. 2:26-cv-00226 (E.D. Tex.); *Cellspin Soft, Inc. v. SZ DJI Technology Co., Ltd. et al.*, No. 2:25-cv-00949 (E.D. Tex.); *Cellspin Soft, Inc. v. Senseonics Holdings, Inc.*, No. 2:24-cv-00263 (E.D. Tex.); *LifeScan, Inc. et al. v. Cellspin Soft, Inc.*, IPR2025-00103¹ (PTAB); and *LifeScan, Inc. et al. v. Cellspin Soft, Inc.*, IPR2025-00104 (PTAB). Paper 15 (Patent Owner’s Updated Mandatory Notices) 2–3.

Petitioner additionally identifies related patents, stating: the ’766 patent is in the same family as U.S. Patent Nos. 11,659,381 (the ’381 patent), 11,234,121 (“the ’121 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”). Pet. 114–115.

Petitioners and Patent Owner both identify *TikTok Inc. v. Cellspin Soft, Inc.*, IPR2024-00769 (“’769 IPR”), which involves the ’766 patent. Pet. 114; Paper 8, 2. The ’769 IPR was instituted on September 30, 2024. This proceeding was subsequently filed and joined with IPR2024-00769, with the present Petitioners agreeing to participate in an understudy capacity. See Paper 9, 11–14. Upon review by the Director, the decision instituting review in IPR2024-00769 was reversed, the order joining Petitioners as petitioners in IPR2024-00769 was vacated, and the Board was

¹ There is another *inter partes* review proceeding between these same parties, IPR2025-00102, that may have been intended.

instructed to “determine whether the Petition[] in IPR2025-00103 . . . should be instituted on [its] own.” ’769 IPR, Paper 41, 7; *see also* Paper 12, 2–3 (explaining procedural history). The same instruction was given for the two related cases—IPR2025-00102 and IPR2025-00104. *Id.*

TikTok Inc., petitioner in the ’769 IPR, also petitioned for *inter partes* review of the ’381, ’121, ’336, ’757, ’260, and ’030 patents. Pet. 114–115. The inter partes review petitions, are listed as follows: IPR2024-00757 (’336 patent); IPR2024-00759 (’757 patent); IPR2024-00760 (’260 patent); IPR2024-00767 (’381 patent); IPR2024-00768 (’121 patent); and IPR2024-00770 (’030 patent). ’769 IPR, Paper 41, 7 (vacating institution in all cases and denying the petitions).

Petitioner also states that the ’766 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.” Pet. 115.

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 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

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. *Id.* at 1:44–49. Provisional application No. 61/017, 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 is reproduced below.

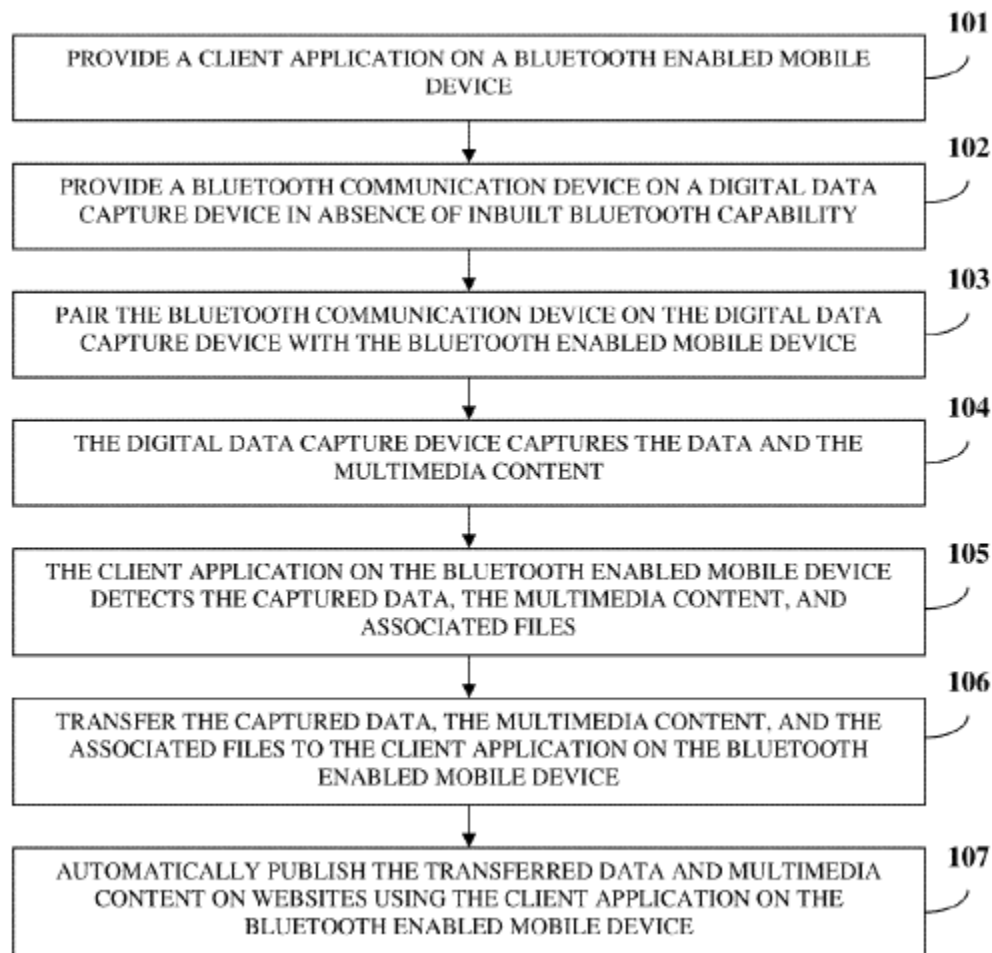


Figure 1 is a flowchart illustrating the method of the '766 patent. See Ex. 1003, 3:26–30. Figure 1 depicts steps 101–107. Steps 101 and 102 respectively provide a client application on the mobile device and a BT communication device on the capture device. *Id.* at 3:63–67. At step 103, the BT communication 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 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;

³ The brackets define limitations of the claim as presented in the Petition. *See* Pet. v–vi (claim 1). We adopt the format for purposes of this Decision.

[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 shortrange 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”);

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”), IEEE Communications

Magazine, *An Overview of the Bluetooth Wireless Technology* (Dec. 2001)
(Ex. 1032, “Bluetooth Overview”), collectively “Bluetooth”;

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

“Declaration of David B. Lett” (Ex. 1030, “Lett Declaration”).

G. Asserted Grounds of Unpatentability

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

Grounds	Claims Challenged	35 U.S.C. § ⁴	References
1	1–15	103	Singh129, Singh906
2a	1–15	103	Kahn, Bluetooth
2b	1–15	103	Kahn, Bluetooth, Feinberg

Pet. 1.

II. 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

⁴ 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 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.

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).

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

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. 6.

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, including arguments made at the oral hearing.

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* Ex. 1010.

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

Figure 2 of Singh906 is reproduced below.

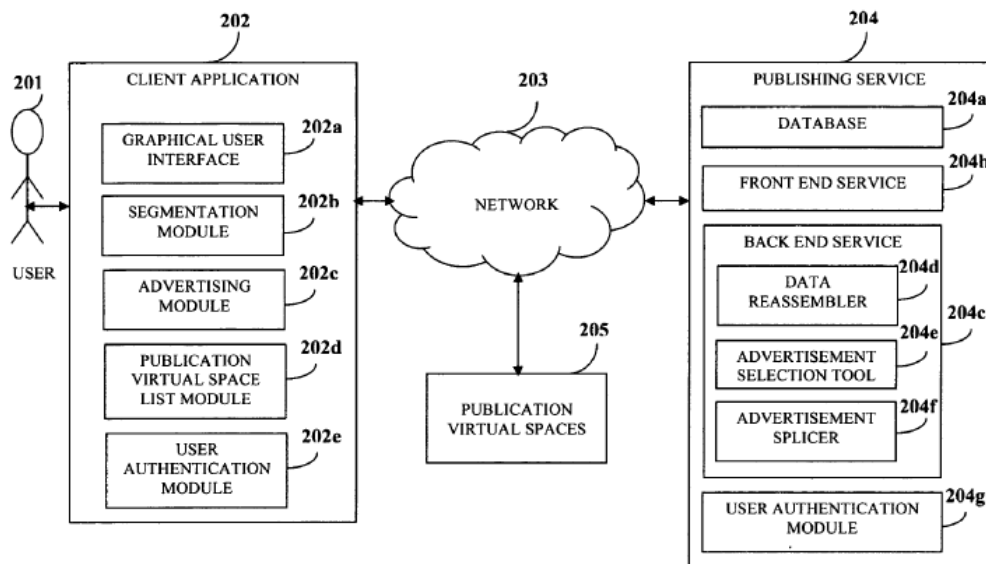


FIGURE 2

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

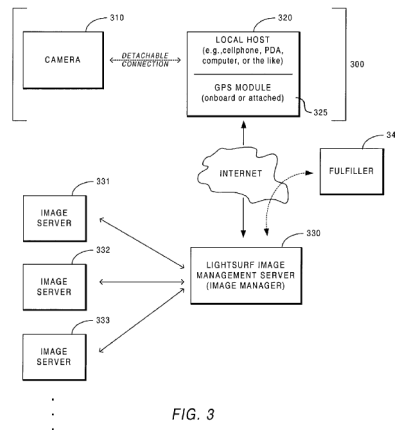


Figure 3 is a block diagram illustrating the basic components of the system.

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.⁵ 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.

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 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

⁵ Petitioner’s citations at pages 40–42 of the Petition to Bluetooth Specification (Ex. 1019) 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 below. *See* Section II.F below.

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 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. Thumbnail 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.

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)).

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. Because Singh129 is within the priority chain of the '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.

1. Whether the Incorporation by Reference of Singh906 was Effective

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. Singh906 is the publication of the '802 application. *See* Section II.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, 1:44–49.

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).

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*

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 would “rely on the incorporation as written and would understand that nothing in the ’802 application could 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).

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.

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.

2. *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.

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.” Pet. 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.*

If Petitioner succeeds in establishing these limitations lack written description support in the priority applications, then the challenged claims will not receive the benefit of the priority applications' earlier filing dates and Singh129 will qualify as prior art.

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.

3. Patentability Over Singh129 and Singh906

We next analyze whether Petitioner has demonstrated a reasonable likelihood that the challenged claims are unpatentable as obvious 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; *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. *Id.* at 25–27.

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. vii. 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. vii. 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.” *Id.* at 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. *Id.* 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 sufficient the argument and evidence 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. 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.

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, 38–102. Petitioner relies on the Lett Declaration. Ex. 1030 ¶¶ 515–665.

Based on the record before us, we find sufficient the argument and evidence that the combination of Kahn and Bluetooth 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 the identified features from Kahn and Bluetooth with a reasonable expectation of success, for the reasons discussed in the Petition. *See* Pet. 43. We have also reviewed Petitioner’s contentions with respect to dependent claims 2–15 and find the same for these claims. *See id.* at 85–102.

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 Kahn and Bluetooth.

*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. 2, 102–111. Petitioner relies on the Lett Declaration. Ex. 1030 ¶¶ 666–825.

Based on the record before us, we find sufficient the argument and evidence that the combination of Kahn, Feinberg, and Bluetooth 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 the identified features from Kahn, Feinberg, and Bluetooth with a reasonable expectation of success, for the reasons discussed in the Petition. *See* Pet. 105. We have also reviewed Petitioner’s contentions with respect to dependent claims 2–15, and find the same for these claims. *See id.* at 105. Petitioner alleges “the ‘signal to notify and that “Feinberg teaches that thumbnails may be included in the header of an object containing photos and thus in this combination, the thumbnails are sent twice Petitioner applies the “entirety of the analysis in Ground 2A applies to Ground 2B.” *Id.* at 106.

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 Kahn, Feinberg, and Bluetooth.

III. 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.

IV. 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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