

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

<p>CELLSPIN SOFT, INC.,</p> <p style="text-align: center;">Plaintiff,</p> <p>v.</p> <p>FITBIT, INC.,</p> <p style="text-align: center;">Defendant.</p>	<p style="text-align: center;">SUMMARY JUDGMENT ORDER</p> <p>Case No. 17-cv-05928-YGR</p> <p>Dkt. No. 148</p>
<p>v.</p> <p>MOOV, INC.,</p> <p style="text-align: center;">Defendant.</p>	<p>Case No. 17-cv-05929-YGR</p> <p>Dkt. No. 130</p>
<p>v.</p> <p>NIKE, INC.,</p> <p style="text-align: center;">Defendant.</p>	<p>Case No. 17-cv-05931-YGR</p> <p>Dkt. No. 128</p>
<p>v.</p> <p>UNDER ARMOUR, INC.,</p> <p style="text-align: center;">Defendant.</p>	<p>Case No. 17-cv-05932-YGR</p> <p>Dkt. No. 110</p>
<p>v.</p> <p>FOSSIL GROUP, INC., ET AL.,</p> <p style="text-align: center;">Defendants.</p>	<p>Case No. 17-cv-05933-YGR</p> <p>Dkt. No. 193</p>
<p>v.</p> <p>GARMIN INTERNATIONAL, INC., ET AL.,</p> <p style="text-align: center;">Defendants.</p>	<p>Case No. 17-cv-05934-YGR</p> <p>Dkt. No. 130</p>
<p>v.</p> <p>NIKON AMERICAS, INC., ET AL.,</p> <p style="text-align: center;">Defendants.</p>	<p>Case No. 17-cv-05936-YGR</p> <p>Dkt. No. 135</p>

United States District Court
Northern District of California

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1 Plaintiff Cellspin Soft, Inc. (“Cellspin”) brings these seven patent infringement actions¹
2 against defendants Fitbit, Inc., Moov, Inc., Nike, Inc., Under Armour, Inc., Fossil Group, Inc.,
3 Misfit Inc., Garmin International, Inc., Garmin USA Inc., Nikon Inc., and Nikon Americas, Inc.
4 (collectively, “Defendants”) for infringement of U.S. Patent Nos. 8,738,794 (the “’794 Patent”),
5 8,892,752 (the “’792 Patent”), and 9,749,847 (the “’847 Patent”).

6 Now before the Court is Defendants’ motion for summary judgment. (Dkt. No. 193
7 (“MSJ”).) Defendants argue that the asserted patents are invalid as claiming patent ineligible
8 subject matter under 35 U.S.C. § 101. Having considered the papers, the parties’ arguments made
9 at the hearing held on February 16, 2021, and the admissible evidence, the Court **GRANTS IN PART**
10 and **DENIES IN PART** Defendants’ motion for summary judgment.

11 **I. BACKGROUND**

12 **A. Patents At Issue**

13 The asserted patents, each titled “Automatic Multimedia Upload for Publishing Data and
14 Multimedia Content,” share the same specification. The patents are directed to the distribution of
15 multimedia content. (See ’794 Patent at 1:32-33.) As explained by the specification, prior art²
16 methods of capturing and publishing multimedia content to the Internet were cumbersome. (*Id.* at
17 1:37-54.) A user would capture content using a separate “data capture device,” such as a digital
18 camera. (*Id.* at 1:38-42.) The user would then manually transfer the content to another device,
19 such as a personal computer, using a universal serial bus (USB) or memory stick. (*Id.* at 1:43-45.)
20 Last, the user would “manually upload” the content unto a website, which “takes time and may be
21 inconvenient for the user.” (*Id.* at 1:45-47.)

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24 ¹ Seven other patent infringement actions were initially filed and subsequently dismissed
25 or stayed pending *inter partes* review. See Case Nos. 17-cv-5930, 17-cv-5937, 17-cv-4938, 17-
26 cv-5939, 17-cv-5941, 17-cv-6881, 20-cv-3673. As ordered by the Court, the parties filed the
27 motion for summary judgment in case number 17-cv-5933 only, with notice of joinder in each
28 other case at docket numbers listed in the caption of this Order. Unless otherwise noted, all docket
citations refer to case number 17-cv-5933 (*Cellspin Soft, Inc. v. Fossil Group Inc.*).

² Cellspin claims a priority date of December 28, 2007, which Defendants do not dispute
for purposes of this motion. Accordingly, Defendants’ motion is evaluated against the background
state of the art that existed in December 2007.

1 To reduce inconvenience and enable real-time publishing, the Asserted Patents automate
2 the process. (*See id.* at 1:33-36, 1:48-54, 1:64-2:3.) While maintaining the two-device structure,
3 the patents require each device to be “Bluetooth enabled” to communicate wirelessly. (*Id.* at 2:4-
4 14.) The devices are “paired,” which involves “establishing a connection between two . . . devices
5 that mutually agree to communicate with each other.” (*Id.* at 3:56-61.) The intermediary device is
6 a mobile device, not a personal computer, and it has an application that detects and transfers data
7 from the data capture device. (*Id.* at 2:15-25.) The mobile device then automatically publishes the
8 captured data to websites based on pre-selected configurations, such as time of day. (*Id.* at 2:35-
9 54.) As the result, in an illustrative example, a reporter working on a story can automatically
10 publish photos on her private blog as she moves around the city. (*Id.* at 9:12-36.)

11 For purposes of this motion, the parties agree that the following claims are representative:
12 claims 1 and 16 of the ’794 Patent; claim 1 of the ’752 Patent; and claim 1 of the ’847 Patent.
13 (Dkt. No. 206 (“Joint Supplemental Submission”) at 2.) Claim 1 of the ’794 Patent recites:

14
15 *A method for acquiring and transferring data from a Bluetooth enabled data*
16 *capture device to one or more web services via a Bluetooth enabled mobile*
device, the method comprising:

17 *providing a software module on the Bluetooth enabled data capture*
18 *device;*

19 *providing a software module on the Bluetooth enabled mobile*
20 *device;*

21 *establishing a paired connection between the Bluetooth enabled*
22 *data capture device and the Bluetooth enabled mobile device;*

23 *acquiring new data in the Bluetooth enabled data capture device,*
24 *wherein new data is data acquired after the paired connection is*
25 *established;*

26 *detecting and signaling the new data for transfer to the Bluetooth*
27 *enabled mobile device, wherein detecting and signaling the new data*
28 *for transfer comprises:*

determining the existence of new data for transfer, by the
software module on the Bluetooth enabled data capture
device; and

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sending a data signal to the Bluetooth enabled mobile device, corresponding to existence of new data, by the software module on the Bluetooth enabled data capture device automatically, over the established paired Bluetooth connection, wherein the software module on the Bluetooth enabled mobile device listens for the data signal sent from the Bluetooth enabled data capture device, wherein if permitted by the software module on the Bluetooth enabled data capture device, the data signal sent to the Bluetooth enabled mobile device comprises a data signal and one or more portions of the new data;

transferring the new data from the Bluetooth enabled data capture device to the Bluetooth enabled mobile device automatically over the paired Bluetooth connection by the software module on the Bluetooth enabled data capture device;

receiving, at the Bluetooth enabled mobile device, *the new data* from the Bluetooth enabled data capture device;

applying, using the software module on the Bluetooth enabled mobile device, *a user identifier* to the new data for each destination web service, wherein each user identifier uniquely identifies a particular user of the web service;

transferring the new data received by the Bluetooth enabled mobile device along with a user identifier to the one or more web services, using the software module on the Bluetooth enabled mobile device;

receiving, at the one or more web services, *the new data* and user identifier from the Bluetooth enabled mobile device, wherein the one or more web services receive the transferred new data corresponding to a user identifier; and

making available, at the one or more web services, *the new data* received from the Bluetooth enabled mobile device for public or private consumption over the internet, wherein one or more portions of the new data correspond to a particular user identifier.

Claim 16 of the '794 Patent is identical, but requires “polling” instead of “signaling” to detect newly captured data. ('794 Patent at 14:27-39.) As the specification explains, in the “pull” mode, the application on the mobile device “periodically polls” the data capture device to detect new files for transfer. (*Id.* at 4:28-38.) By contrast, in the “push” mode, the data capture device itself detects new data and sends a signal to the mobile device to initiate transfer. (*Id.* at 4:55-66.)

1 Thus, claim 1 covers the “push” mode, while claim 16 covers the “pull” mode. The detection step
2 of claim 16 accordingly recites:

3 *detecting the new data* for transfer to the Bluetooth enabled mobile device, wherein
4 detecting the new data for transfer comprises:

5 *polling the Bluetooth enabled data capture device* using the software module on the
6 Bluetooth enabled mobile device over the established paired Bluetooth connection,
7 wherein the Bluetooth enabled data capture device listens for the polling request
8 sent from the Bluetooth enabled mobile device; and

9 *determining the existence of new data for transfer*, by the software module on the
10 Bluetooth enabled data capture device;

11 Claim 1 of the '752 Patent has similar limitations, but adds encryption and transfer
12 protocols. Although the specification does not describe these features in detail, it notes that “[t]he
13 transport protocol . . . between the [mobile device] and the [publishing website] may be hypertext
14 transfer protocol (HTTP) or extensible markup language-remote procedure calls (XML-RPC).”
15 ('752 Patent at 10:4-7.) For encryption, it states only that the system “will use various security,
16 encryption and compression techniques to enhance the overall user experience.” (*Id.* at 10:54-56.)
17 The claim also describes event notifications, which is a variation on the “push” mode where the
18 mobile device first enables event notifications on the data capture device before the latter signals
19 the presence of new data. (*See generally id.* at claim 1.) Claim 1 recites:

20 *A method for transferring data* from a Bluetooth enabled data capture device to a remote
21 internet server via a Bluetooth enabled mobile device comprising:

22 *performing* at the Bluetooth enabled data capture device:

23 *establishing a secure paired Bluetooth connection* between the Bluetooth
24 enabled data capture device and the Bluetooth enabled mobile device,
25 wherein the secure paired Bluetooth connection uses a cryptographic
26 encryption key;

27 *acquiring new data* in the Bluetooth enabled data capture device, wherein
28 new data is data acquired after the secure paired Bluetooth connection is
established;

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detecting and signaling the new data for transfer, to the Bluetooth enabled mobile device, wherein detecting and signaling the new data for transfer comprises:

receiving a message from the Bluetooth enabled mobile device, over the established secure paired Bluetooth connection, *to enable event notifications*, corresponding to new data for transfer, on the Bluetooth enabled data capture device;

enabling event notification on Bluetooth enabled data capture device, corresponding to new data for transfer;

determining existence of the new data for transfer; and

sending an event notification to the Bluetooth enabled mobile device, corresponding to existence of new data for transfer, over the established secure paired Bluetooth connection, wherein the Bluetooth enabled mobile device is configured to listen for the event notification sent from the Bluetooth enabled data capture device;

encrypting, using the cryptographic encryption key, *the new data* acquired in the Bluetooth enabled data capture device; and

transferring the encrypted data from the Bluetooth enabled data capture device to the Bluetooth enabled mobile device, over the established secure paired Bluetooth connection, wherein the Bluetooth enabled mobile device has access to the internet, wherein the Bluetooth enabled mobile device is configured to receive the encrypted data and obtain the new data from the encrypted data using the cryptographic encryption key, wherein the Bluetooth enabled mobile device is configured to *attach a user identifier, an action setting and a destination web address of a remote internet server to the obtained new data*, wherein the user identifier uniquely identifies a particular user of internet service provided by the remote internet server, wherein *action setting comprises one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method*, and wherein the Bluetooth enabled mobile device is configured to send the obtained new data with the attached user identifier, an action setting and a destination web address to a remote internet server.

Last, claim 1 of the '847 Patent recites a system to perform the above methods. It recites:

A *system* comprising:

a Bluetooth enabled *data capture device*, comprising:

a first *memory* device;

a first *processor* coupled to the first memory device;

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a first Bluetooth *communication device* configured to establish a paired Bluetooth wireless connection between the Bluetooth enabled data capture device and a Bluetooth enabled cellular phone, wherein the Bluetooth enabled data capture device is configured to cryptographically authenticate identity of the Bluetooth enabled cellular phone when the first Bluetooth communication device establishes the paired Bluetooth wireless connection;

a data capture circuitry;

said first processor *configured to acquire new-data* using the data capture circuitry after the paired Bluetooth wireless connection between the Bluetooth enabled data capture device and the Bluetooth enabled cellular phone is established;

said first processor *configured to store the acquired new-data* in the first memory device; and said first processor configured to send an event notification and the acquired new-data to the cryptographically authenticated Bluetooth enabled cellular phone over the established paired Bluetooth wireless connection, wherein the event notification corresponds to the acquired new-data and comprises sending a signal to the cryptographically authenticated Bluetooth enabled cellular phone;

a mobile application in the Bluetooth enabled cellular phone comprising executable instructions that, when executed by a second processor inside the Bluetooth enabled cellular phone controls the second processor to:

detect and receive the acquired new-data, comprising:

listen for the event notification, sent from the Bluetooth enabled data capture device, over the established paired Bluetooth wireless connection, wherein the event notification corresponds to the acquired new-data; and

receive the event notification and the acquired new-data, from the Bluetooth enabled data capture device, over the established paired Bluetooth wireless connection, wherein receiving the event notification comprises receiving the signal sent by the Bluetooth enabled data capture device corresponding to the acquired new-data;

store the new-data received over the established paired Bluetooth wireless connection, in a second memory device of the Bluetooth enabled cellular phone before transfer to a website; and

use HTTP to transfer the new-data received over the established paired Bluetooth wireless connection, along with user information stored in the second memory device of the cryptographically authenticated Bluetooth enabled cellular phone, to the website, over the cellular data network;

wherein the mobile application further comprises executable instructions to control the processor to *provide a graphical user interface (GUI) for the new-data*.

1 **B. Procedural History**

2 The Court has previously found the above-recited claims invalid under 35 U.S.C. § 101 for
3 claiming patent ineligible subject matter. (Dkt. No. 85 (“MTD Order”).) Specifically, the Court
4 found that the claims are directed to a patent ineligible abstract idea of “acquiring, transferring,
5 and publishing data and multimedia content on one or more websites.” (*Id.* at 11:19-20.) The
6 Court also found that the claims lack an inventive concept because they “merely provide a generic
7 [computer] environment in which to carry out the abstract idea.” (*Id.* at 15:9-22.) In so finding,
8 the Court discounted Cellspin’s allegations of inventiveness because those were found nowhere in
9 the specification. (*See id.* at 16:12-18:7.)

10 Cellspin appealed. (Dkt. No. 88.) The Federal Circuit affirmed the Court’s finding that
11 the claims were directed to an abstract idea of “capturing and transmitting data from one device to
12 another.” *Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1315 (Fed. Cir. 2019). In particular,
13 the court confirmed that the claims merely automate an existing manual process of transferring
14 and publishing data. *Id.* at 1316. However, the Federal Circuit reversed the Court’s finding of
15 lack of an inventive concept because at the motion to dismiss stage, a plaintiff’s allegations must
16 be assumed to be true. *Id.* at 1316-18.

17 Cellspin had alleged that the claims recited unconventional elements, including (1)
18 separating the steps of capturing and publishing data between two devices linked via a wireless,
19 paired connection (referred to as “two-step, two-device structure”), (2) establishing a paired
20 connection before forwarding the data, and (3) using HTTP by an intermediary device while the
21 data is “in transit.” *Id.* Because “patentees who adequately allege their claims contain inventive
22 concepts survive a § 101 eligibility analysis under Rule 12(b)(6),” the Federal Circuit vacated the
23 dismissal and remanded. *Id.* at 1318 (quoting *Aatrix Software, Inc. v. Green Shades Software,*
24 *Inc.*, 882 F.3d 1121,1126 (Fed. Cir. 2018)), 1320; (*see* Dkt. No. 110.)

25 On remand, this Court entered a schedule setting early summary judgment briefing for
26 Section 101 eligibility. (Dkt. No. 164.) Cellspin filed its eligibility contentions, identifying each
27 alleged inventive concept, on June 19, 2020. (Dkt. No. 165.) Defendants filed the instant motion
28 on October 6, 2020. (Dkt. No. 193.) Cellspin filed its opposition on October 30, 2020 (Dkt. No.

1 198 (“Opp.”)), and Defendants their reply on November 13, 2020. (Dkt. No. 200 (“Reply”).) The
2 Court held a hearing on this motion on February 16, 2021. (Dkt. No. 215.)

3 **II. LEGAL STANDARD**

4 Summary judgment is appropriate if “there is no genuine issue as to any material fact and
5 that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c). Factual
6 disputes are only “genuine” if the evidence could cause a reasonable jury to reach a verdict for the
7 other party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 252 (1986). The movant can meet its
8 burden by “showing . . . there is an absence of evidence to support the nonmoving party’s case.”
9 *Fairbank v. Wunderman Cato Johnson*, 212 F.3d 528, 531 (9th Cir. 2000) (citation and quotation
10 omitted). Once the movant meets its burden of showing the absence of genuine issues of material
11 fact that burden shifts to the nonmoving party, who must demonstrate the existence of a material
12 issue of fact. *Mahdavi v. C.I.A.*, 898 F.2d 156 (9th Cir. 1990) (citations omitted).

13 A party opposing summary judgment must “go beyond the pleadings and by [its] own
14 affidavits, or by the depositions, answers to interrogatories, and admissions on file, designate
15 specific facts showing that there is a genuine issue for trial.” *Turner v. Brown*, 961 F.2d 217 (9th
16 Cir. 1992) (citations omitted). The opposition party “cannot rest on the allegations in his
17 pleadings to overcome a motion for summary judgment.” *Id.* Defendants “must do more than
18 simply show that there is some metaphysical doubt as to the material facts.” *Matsushita Elec.*
19 *Inudus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986).

20 **III. ANALYSIS**

21 The Federal Circuit affirmed this Court’s holding that the claims are directed to a patent
22 ineligible idea of collecting, transmitting, and publishing data. Accordingly, that is the law of the
23 case, and the only remaining question lies with the “inventive concept.” Cellspin proposes fifty
24 inventive concepts, but the parties focus on five main “categories” in their briefs. The Court first
25 reviews the legal requirements for the inventive concept and then addresses each category, before
26 turning to the remainder of the concepts.

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1 **A. Section 101 “Inventive Concept” Requirement**

2 The Patent Act permits obtaining a patent on “any new and useful process, machine,
3 manufacture, or composition of matter.” 35. U.S.C. § 101. For over a century, courts have
4 interpreted this and previous provisions to exclude patenting laws of nature, natural phenomena,
5 and abstract ideas. *See Diamond v. Chakrabarty*, 447 U.S. 303, 308-09 (1980). Where patent
6 claims are “directed” to such subject matter—meaning, where the claimed advance over prior art
7 focuses on such subject matter³—the patents are not necessarily invalid. *See Alice Corp. Pty. Ltd.*
8 *v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). However, courts must then ask, “What else is there
9 in the claims?” *Id.* This second-stage analysis has been described as a “search for an ‘inventive
10 concept’” intended to ensure that the patent amounts to “significantly more” than the patent
11 ineligible subject matter. *Id.* at 217-18.

12 The Federal Circuit has not clearly defined an “inventive concept.” The inquiry generally
13 rests on whether “the elements of each claim both individually and ‘as an ordered combination’
14 . . . ‘transform the nature of the claim’ into a patent eligible application.” *Id.* The concept must
15 therefore be, at minimum, inventive, concrete (an “application”), and patent eligible. It must also
16 exist in the claim elements, individually or in combination, beyond the patent ineligible subject
17 matter. *See Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1293 (Fed. Cir. 2020)
18 (unclaimed inventive concepts are irrelevant). Within this framework, courts have more explicitly
19 articulated what *fails* to provide an inventive concept, rather than what succeeds. Accordingly, the
20 following provide examples of what is *not* an inventive concept:

21 First, and foremost, an inventive concept cannot rest on “performance of ‘well-understood,
22 routine, and conventional activities’ previously known in the industry.” *In re TLI Comm’n’s LLC*
23 *Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016) (quoting *Alice*, 573 U.S. at 225). The prohibition
24 against “conventional” activities supplying an inventive concept is one of the best-established
25

26 ³ *C R Bard Inc. v. AngioDynamics, Inc.*, 979 F.3d 1372, 1382 (Fed. Cir. 2020); *see also*
27 *Elecs. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (looking at claims’
28 “character as a whole”); *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d
1341 at 1348 (Fed. Cir. 2016) (considering the “basic thrust” of the claims).

1 rules in Section 101 analysis. *See, e.g., Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566
 2 U.S. 66, 79 (2012) (“Simply appending conventional steps, specified at a high level of generality
 3 . . . cannot make [the subject matter] patentable.”); *Diamond v. Diehr*, 450 U.S. 175, 180 (1981)
 4 (rejecting additional steps that were “conventional and necessary to the [abstract] process”); *Alice*,
 5 573 U.S. at 223-24 (explaining that conventional activity is “not enough” because it provides no
 6 “practical assurance that the process is more than a drafting effort designed to monopolize the
 7 abstract idea itself” (brackets and citation omitted)).

8 In the computer context, “the mere recitation of a generic computer cannot transform a
 9 patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 221; *see, e.g.,*
 10 *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1348
 11 (Fed. Cir. 2014). Indeed, “invocations of computers that are not even arguably inventive are
 12 insufficient to pass the test of an inventive concept.” *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d
 13 1161, 1170 (Fed. Cir. 2018); (noting that the rule has been affirmed “many times”); *Electric*
 14 *Power*, 830 F.3d at 1355 (citing cases). However, even when each computer element is generic, a
 15 novel arrangement of those elements may supply an inventive concept. *See, e.g., Bascom*, 827
 16 F.3d at 1349-50 (finding that installing a filter at a specific location was inventive even if the
 17 concept of filtering itself was conventional).

18 Second, the inventive concept cannot be overgeneralized. “Stating an abstract idea while
 19 adding the words ‘apply it’ is not enough for patent eligibility.” *Alice*, 573 U.S. at 217. Similarly,
 20 where the patent purports to claim an improvement but is “wholly devoid of details which describe
 21 how this [result] is accomplished,” the claims are not transformed. *Interval Licensing LLC v.*
 22 *AOL, Inc.*, 896 F.3d 1335, 1346 (Fed. Cir. 2018) (emphasis in original); *see also Am. Axle*, 967
 23 F.3d at 1296 (“[T]o avoid ineligibility, a claim must have the specificity required to transform the
 24 claim from one claiming only a result to one claiming a way of achieving it.” (brackets, citation,
 25 and quotation marks omitted)). For this reason, lack of specificity alone may prevent an inventive
 26 concept from transforming the claim. *See SAP*, 898 F.3d at 1167 (Fed. Cir. 2018); *Am. Axle*, 967
 27 F.3d at 1299. Moreover, “result-focused, functional character of claim language” can separately
 28 confirm patent ineligibility. *Electric Power*, 830 F.3d at 1356.

1 Third, an inventive concept cannot rest on limiting an abstract idea to a technological field
2 or application. *See Bilski v. Kappos*, 561 U.S. 593, 610-11 (2010). For example, the Pythagorean
3 theorem would not be patentable simply because a patent stated it could “be usefully applied to
4 existing surveying techniques.” *Parker v. Flook*, 437 U.S. 584, 590 (1978). Similarly, limiting
5 claims to a particular field of information, such as investment information, cannot make them non-
6 abstract. *SAP*, 898 F.3d at 1169. Nor can limiting an abstract idea, such as using advertising as
7 currency, to the Internet. *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014).
8 The Supreme Court has previously described this as “post-solution activity” that has no effect on
9 patent eligibility. *See Flook*, 437 U.S. at 590 & n.11 (noting that “it is not . . . clear why a process
10 claim is any more or less patentable because [of] the specified end use contemplated”).

11 Fourth, the inventive concept cannot itself be patent ineligible. For instance, an abstract
12 idea for an algorithm cannot be transformed into patent eligibility using more algorithms. *See*
13 *SAP*, 898 F.3d at 1169. Relatedly, “a claimed invention’s use of the ineligible concept to which it
14 is directed cannot supply an inventive concept.” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d
15 1281, 1290 (Fed. Cir. 2018); *see Chargepoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 774 (Fed.
16 Cir. 2019) (finding that “network control” cannot supply an inventive concept because it is itself
17 abstract); *cf. Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (“A
18 claim for a *new* abstract idea is still an abstract idea.” (emphasis in original)).

19 Fifth, an inventive concept is not novelty. Novelty requires analyzing the claim as a
20 whole. *BSG*, 899 F.3d at 1291. The inventive concept analysis focuses on the patent eligible
21 elements.⁴ *See Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1348 (Fed. Cir.
22 2019).

23 Thus, an inventive concept analysis presents two distinct inquiries: first, whether each
24 claim element *apart from the patent ineligible subject matter* was “well-understood, routine, or
25 conventional,” and second, whether those elements “as an ordered combination . . . add nothing
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27 ⁴ That does not mean that the patent ineligible or conventional elements are ignored. *See*
28 *Diehr*, 450 U.S. at 188. But it does mean that those elements cannot supply the required novelty.
See Simio, LLC v. FlexSim Software Prods., Inc., 893 F.3d 1353, 1364 (Fed. Cir. 2020).

1 . . . that is not already present” when the elements are considered separately. *Id.* at 1348-49. For
 2 this reason, the novelty of the invention as a whole—e.g., a “groundbreaking” abstract idea or law
 3 of nature—cannot make the claims patent eligible. *cxLoyalty, Inc. v. Martiz Holdings Inc.*, 986
 4 F.3d 1367, 1378 (Fed. Cir. 2021). At the same time, “[t]he mere fact that something is disclosed
 5 in a piece of prior art . . . does not mean it was well-understood, routine, and conventional.”
 6 *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018).

7 Whether a combination of claim elements supplies an “inventive concept” is a question of
 8 law. *BSG*, 899 F.3d at 1290. In *Berkheimer*, the Federal Circuit held that the issue of whether a
 9 claim element or combination is “well-understood, routine and conventional to a skilled artisan in
 10 the relevant field” is a question of fact that must be “proven by clear and convincing evidence.”
 11 881 F.3d at 1368. However, as *BSG* clarified, such factual disputes prevent summary judgment
 12 where “*the only issue* at step two is whether claim limitations are well-understood, routine, and
 13 conventional.” 899 F.3d at 1290 (emphasis supplied). By contrast, where other issues—such as
 14 those listed above—preclude an inventive concept, summary judgment may be granted as a matter
 15 of law. *See, e.g., Am. Axle*, 967 F.3d at 1298-99 (finding post-*Berkheimer* no genuine dispute over
 16 patent ineligibility irrespective of non-conventionality); *BSG*, 899 F.3d at 1291 (same).⁵

17 **B. Category One: Two-Step, Two-Device Structure**

18 The parties begin where the Federal Circuit left off: the “two-step, two-device structure.”
 19 Cellspin claims that as of December 28, 2007, “it was unconventional to separate the steps of
 20 capturing and publishing data so that each step would be performed by a different device linked
 21 via a wireless, paired connection.” (Opp. at 11:1-3; *see also* Dkt. No. 206-1 (“Inventive Concept
 22 Chart”) # 2).⁶ Defendants argue that such separation was conventional because the specification
 23 itself describes prior art having this feature. Specifically, the specification states that prior to the
 24

25 ⁵ In denying rehearing in *Berkheimer*, five judges clarified that the decision does not
 26 “cast[] doubt on the propriety” of earlier decisions finding patent eligibility without considering
 27 evidence and that it merely “narrow[ly]” holds that “to the extent it is at issue in the case,” an
 element’s conventionality is a question of fact. 890 F.3d 1369, 1373-74 (Fed. Cir. 2018) (Moore,
 Dyk, O’Malley, Taranto, & Stoll, JJ, concurring).

28 ⁶ *See also* Inventive Concept Chart # 1, 3-7, 39, 42, 43 (describing benefits of two-device
 structure), 23(a), 24, 25, 27-28, 38, 45, 50, 53, (describing benefits of automating that structure).

1 purported invention of the asserted patents:

2 Typically, the user would capture an image using a digital camera or
3 a video camera, store the image on a memory device of the digital
4 camera, and transfer the image to a computing device such as a
5 personal computer (PC). In order to transfer the image to the PC, the
6 user would transfer the image off-line to the PC, use a cable such as
7 a universal serial bus (USB) or a memory stick and plug the cable into
8 the PC. The user would then manually upload the image onto a
9 website which takes time and may be inconvenient for the user.

7 (*E.g.*, '794 Patent at 1:38-47.)⁷

8 Defendants argue that this describes a “two-step, two-device” structure. The Court agrees.
9 Like the asserted patents, the prior art had two devices—a digital camera and a personal computer.
10 Like the asserted patents, the prior art separated the data capture and publication steps, with the
11 digital camera performing the capture and the personal computer performing the publication. And
12 like the asserted patents, the prior art inherently enabled certain benefits, such as allowing each
13 device to be smaller and only serve one function. The only difference with the asserted patents
14 lies in the use of a “wireless, paired” Bluetooth connection and a mobile intermediary device,
15 instead of a cable connection and personal computer.⁸ The record stands undisputed that those
16 elements cannot supply an inventive concept.

17 As an initial matter, wireless communication is an abstract concept. *See Chamberlain*, 935
18 F.3d at 1347 (“[T]he broad concept of communicating information wirelessly, without more, is an
19 abstract idea.”). In *Chamberlain*, the claims recited wirelessly communicating information about
20 a barrier (such as a garage door). *Id.* at 1345. The court found that the claims were directed to an
21 abstract idea—wirelessly communicating status information about a system. *Id.* at 1346. It then
22 held that under the stage-two analysis, “[w]ireless communication cannot be an inventive concept
23 here, because it is the abstract idea that the claims are directed to.” *Id.* at 1349. As described in

25 ⁷ Cellspin’s experts admit that the above-described process was conventional. (*See* Dkt.
26 No. 198-3 (“Foley Report”) ¶¶ 60-62, 66; Dkt. No. 198-4 (“Singh Report”) ¶¶ 58, 60, 62; Dkt. No.
27 198-5 (“Garlick Report”) ¶¶ 60-67.) Moreover, the Federal Circuit routinely considers prior art
described in the specification to be routine. *See, e.g., Athena Diagnostics, Inc. v. Mayo*
Collaborative Servs., LLC, 915 F.3d 743, 754 (Fed. Cir. 2019).

28 ⁸ At the hearing for this motion, Cellspin admitted that the only inventive feature of its
two-device system, despite its allegations, was the use of a “wireless, paired connection.”

1 the next section, pairing is also an abstract idea. Thus, these elements cannot supply an inventive
 2 concept as a matter of law—“a new abstract idea is still an abstract idea.” *Synopsis*, 839 F.3d at
 3 1151. Moreover, even if the Court were to consider these elements, a “wireless, paired
 4 connection” is not even arguably inventive.⁹ *SAP*, 898 F.3d at 1170.

5 Defendants proffer evidence that Bluetooth launched in 1999 and included pairing in its
 6 very first specification that year. (*See* Dkt. No. 193-4 (“Madisetti Report”) ¶¶ 75; Dkt. No. 193-5
 7 (“1999 Bluetooth Specification”) at 53.) Cellspin’s expert, Dr. Foley, who worked at the CEO of
 8 the Bluetooth Special Interest Group in 2007, admits that there were over one billion Bluetooth
 9 devices by December 2007. (Foley Report ¶¶ 5, 116; Dkt. No. 193-7 (“Foley Depo.”) at 99:20-
 10 101:1.) Dr. Foley does not dispute that pairing, as described by the Bluetooth specification, was
 11 conventional: he opines that “the conventional approach as of December 2007 was to pair devices
 12 as required.” (*See* Foley Report ¶ 140; *see also id.* ¶ 114 (“Since its onset in 1998, the Bluetooth
 13 specifications have contained a clear definition of what ‘pairing’ was and the steps required to pair
 14 two devices.”), ¶ 42 (opining that the “conventional definition” of pairing comes from the 2007
 15 specification).) Notably, none of Cellspin’s experts contend that the asserted patents invented
 16 pairing or wireless communication. Thus, Defendants meet their initial burden to show that a
 17 wireless, paired connection was conventional.

18 Against this background, Cellspin’s cited evidence, despite its volume, does not create a
 19 genuine dispute of fact. As an initial matter, each of the three experts relied on by Cellspin admit
 20 that the two-step, two-device structure described in the specification was conventional. (Foley
 21 Report ¶¶ 60-62, 66; Singh Report ¶¶ 58, 60, 62; Garlick Report ¶¶ 60-67.) In the face of these
 22 admissions, “it [is] difficult, if not impossible, for a patentee to show a genuine dispute” over its
 23 conventionality. *See Berkheimer*, 890 F.3d at 1371 (Moore, Dyk, O’Malley, Taranto, & Stoll, JJ,
 24 concurring). And, indeed, none of the experts actually provide an opinion that supports Cellspin’s
 25 claims for this inventive concept. For example, the experts state that:

26
 27
 28

⁹ Mobile devices are conventional at least because the specification calls them “ubiquitous”
 and “widespread.” (*See* ’794 Patent at 9:46-49.)

- 1 • Smartphones were relatively new in 2007, and “apps” were rudimentary. (Foley
2 Report ¶ 62; Singh Report ¶ 60.) Merely using a software on a mobile phone
3 device, however, is not claimed to be inventive, and, in any case, the claims
4 provide no implementation details for the “app” or software module sufficient to
5 make this anything more than claiming a result. *Am. Axle*, 967 F.3d at 1296.
- 6 • Pairing was not “required” by Bluetooth. (Foley Report ¶¶ 94-95, 212-13; Singh
7 Report ¶¶ 103-14.) Whether something is required, however, says nothing about its
8 conventionality. By analogy, using a computer to create electronic records is not
9 required, but it is certainly conventional. *See Alice*, 573 U.S. at 225. Dr. Foley
10 confirms that Bluetooth specifications contained a “clear definition” of pairing
11 since 1998, which shows that it was conventional. (Foley Report ¶¶ 111-18.)
- 12 • Commercial embodiments of the claims did not arise until 2012. (*Id.* ¶ 75; Singh
13 Report ¶¶ 84-86.) Mere novelty, however, does not show that paired, wireless
14 connections were non-conventional. *cxLoyalty*, 986 F.3d at 1378.
- 15 • Automating manual processes was inventive. (Garlick Report ¶¶ 66-67.) That, by
16 itself, cannot supply an inventive concept. *See, e.g., Chamberlain*, 935 F.3d at
17 1347 (automating garage door openers).

18 Cellspin cites these expert opinions to show that the claimed “Bluetooth implementation”
19 was not conventional (Opp. at 6, 12),¹⁰ but as shown above, none of the experts actually support
20 that conclusion. Because the cited evidence does not create a dispute of fact, neither does the non-
21 cited evidence. *See Keenan v. Allan*, 91 F.3d 1275, 1279 (9th Cir. 1996) (requiring a nonmoving
22 party to “identify with reasonable particularity the evidence that precludes summary judgment”; a
23 district court need not “scour the record in search of a genuine issue of triable fact”).

24 At its core, the record here shows that the “two-step, two-device structure” was well-
25 known, and, indeed, formed the background art that the asserted patents sought to improve.¹¹ The
26 only new element comes from using a “wireless, paired” connection between the devices, in place

27 ¹⁰ Cellspin also cites its patent eligibility contentions. (Dkt. No. 198-2 (“Contentions”).) Contentions are a form of pleading—not evidence—and cannot create a dispute of fact. To the extent that Cellspin relies on the evidence cited in those contentions, the exhibit numbering does not correspond to that in the briefing, and Cellspin fails to identify them with particularity.

28 ¹¹ Cellspin alleges, as it did at the pleading stage, that the “two-device” structure improved upon prior art that required the data capture device to have built-in internet. Although the Federal Circuit found this argument persuasive at the pleading stage, *Cellspin*, 927 F.3d at 1316, the Court fails to see how Cellspin has shown inventiveness at this stage by reference to improving one conventional structure using another conventional structure.

1 of a manual connection. Because those elements are both abstract and wholly generic, they cannot
 2 supply an inventive concept sufficient to transform the claims into patent eligibility.¹² *See Credit*
 3 *Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1056 (Fed. Cir. 2017) (automating a manual
 4 process “is precisely the sort of invention that the *Alice* Court deemed ineligible for patenting”);
 5 *OIP Techs., Inc. v. Amazon, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (similar); *cf. McRO, Inc. v.*
 6 *Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1316 (Fed. Cir. 2016) (finding patent eligibility
 7 where the claims described a *specific* method for automation).

8 Accordingly, the Court grants summary judgment that the “two-step, two-device” structure
 9 does not provide an inventive concept under 35 U.S.C. § 101.

10 **C. Category Two: Pairing Before Sending Data**

11 The next category of inventive concepts takes pairing a step further: instead of generic
 12 pairing, Cellspin claims that “establishing a paired connection *before* sending data” was inventive.
 13 (Opp. at 12:26-28 (emphasis supplied); Inventive Concept Chart # 9, 29.)¹³ The common
 14 specification defines pairing as “establishing a connection between [Bluetooth] devices that
 15 mutually agree to communicate with each other.” (’794 Patent 3:57-59.) That, of course, is an
 16 abstract concept. Humans have “established a connection” by agreeing to communicate for
 17 thousands of years before the patents, including by building embassies, sending scouts to
 18 neighboring tribes, and exchanging telephone numbers at a bar. *See Intellectual Ventures I LLC v.*
 19 *Symantec Corp.*, 838 F.3d 1307, 1313, 1318 (Fed. Cir. 2016) (activities performed by humans are
 20 abstract); *cf. Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (fundamental economic practices that
 21 have long prevailed in human systems are not patent eligible).

22 In claim construction, however, both parties have agreed to limit the term “pairing” to
 23 Bluetooth pairing, as defined in the 2007 specification. (*See* Dkt. No. 153 (“Claim Construction
 24 Statement”) at 16.) The Bluetooth specification defines “paired device” as “A Bluetooth device in
 25

26 ¹² The Court further notes that the claims’ recitation of a “wireless, paired” connection is
 27 entirely results-oriented. The claims do not describe any way to create the connection, only the
 28 result that the devices are so connected. *See Am. Axle*, 967 F.3d at 1296.

¹³ *See also* Inventive Concept Chart # 10, 12, 27, 30 (describing benefits of pairing before
 data transfer).

1 which a link key has been exchanged (either before connection establishment was requested or
 2 during [the] connection phase.” (Dkt. No. 193-25 (“2007 Bluetooth Specification”) at 18; *see also*
 3 1999 Bluetooth Specification at 53 (same definition).) Cellspin’s experts therefore opine that the
 4 “conventional definition” of “pairing” is “[a] connection among Bluetooth devices in which a link
 5 key has been exchanged (either before connection establishment was requested or during [the]
 6 connection phase.” (Foley Report ¶ 42; Garlick Report ¶ 43.) That definition is less abstract
 7 because it involves a concrete implementation: exchanging a key. However, the reliance on the
 8 Bluetooth specification completely defeats any claim to non-conventionality. While mere mention
 9 of a feature in prior art may not be sufficient, a feature recited in the *definitions* of a well-known
 10 technology must necessarily be conventional.

11 Cellspin claims that even if pairing was conventional, establishing a paired connection
 12 before data transfer is not. That claim defies logic. Conventional pairing, according to Cellspin’s
 13 experts, exchanges a key “*either before connection establishment*¹⁴ was requested *or during* the
 14 connection phase.” (Foley Report ¶ 42 (emphasis supplied); Garlick Report ¶ 43.) The definition
 15 is disjunctive: if exchanging a key before *or* during the connection required to transfer data was
 16 conventional, then the former is necessarily conventional. In any case, none of Cellspin’s experts
 17 actually opine that this feature was non-conventional.¹⁵ They simply state that pairing before data
 18 transfer was not required by Bluetooth and then rebut Defendants’ cited references. (*See* Foley
 19 Report ¶¶ 138-39; Garlick Report ¶¶ 143-150.) Because pairing before data transfer was part of
 20 the very definitions and nomenclature of Bluetooth, and Cellspin’s experts admit that Bluetooth
 21 was conventional, that cannot create a genuine dispute of fact. (*See* Foley Report ¶ 155; Singh
 22 Report ¶ 107; Garlick Report ¶ 124.)

23 _____
 24 ¹⁴ The specification explains that a connection is required before sending data packets.
 25 (2007 Bluetooth Specification at 160.) This clause thus necessarily involves pairing before data
 transfer.

26 ¹⁵ Cellspin’s experts discuss the inventiveness of pairing before data is *captured*, but
 27 provide no non-conclusory opinion that pairing before data *transfer* was non-conventional. (*See,*
 28 *e.g.*, Foley Report ¶ 284; Singh Report ¶ 236.) The claims do not require pairing before data
 capture: they define “new data” as data captured after pairing, but the open-ended “comprising”
 claims permit capturing other types of data. (*See* ’752 Patent at claim 1.)

1 Accordingly, the Court grants summary judgment that establishing a paired connection
2 before data transfer does not provide an inventive concept under 35 U.S.C. § 101.¹⁶

3 **D. Category Three: HTTP at an Intermediary Device**

4 Cellspin claims that the use of HTTP by an intermediary device and while the data was in
5 transit was nonconventional. (Inventive Concept Chart # 11; *see also id.* # 13 (“Using HTTP at a
6 specific location (i.e.,[] at the intermediary device”), 21 (“Using HTTP to transfer data received
7 over a paired wireless connection to web services”), 21 (duplicate) (“Applying HTTP to data in
8 transit and on intermediary mobile device”), 22 (HTTP request), 44 (“converting data for HTTP”),
9 48 (using HTTP in transit at an intermediary device), 52 (applying HTTP).)

10 Defendants come nowhere close to meeting their burden to show that this element was
11 conventional. In their opening brief, Defendants focus on the conventionality of HTTP itself.
12 They argue, for instance, that Dr. Foley admitted that HTTP was a pervasive technology by 2007.
13 (Foley Depo. at 94:19-95:22.) They also point out that the specification mentions HTTP only
14 once, even though that the Federal Circuit rejected that exact argument in this very case. *See*
15 *Cellspin*, 927 F.3d at 1317 (“[T]he specification need not expressly list all the reasons why this
16 claimed structure is unconventional.”). Last, Defendants cite their expert, Dr. Madisetti, who
17 opines that HTTP was known and describes several references that describe using HTTP to
18 connect to the Internet as “conventional.”¹⁷ (Madisetti Report ¶ 85.)

19 All this shows is that HTTP was known individually, not that its use at an intermediary
20 device was known. *See BASCOM*, 827 F.3d at 1350 (finding that although filtering content was
21 well-known, doing so at the ISP server provided an inventive concept). With regard to that aspect,
22

23 ¹⁶ Cellspin cites the same expert testimony as for the first category, which does not show a
24 genuine dispute of fact. (*See* Foley Report ¶¶ 111-12 (conclusory disagreement with Defendants’
25 expert), 116 (same), 200 (calling Bluetooth pairing “rudimentary” despite its inclusion in the 1998
26 specification), 212 (pairing was optional); Singh Report ¶¶ 103, 107, 121, 166 (identical opinions);
27 Garlick Report ¶¶ 119-20, 124-25, 174 (identical opinions)). Such conclusory expert opinion does
28 not defeat summary judgment. *See cxLoyalty*, 986 F.3d at 1378.

¹⁷ The one-off prior art references generally do not establish conventionality. *See*
Berkheimer, 881 F.3d at 1369 (mere disclosure in prior art insufficient). Although the references
here go further by describing HTTP use over the Internet as “conventional,” the alleged inventive
concept focuses on using HTTP at an intermediary device specifically.

1 Defendants’ sole evidence lies with Dr. Foley, who testified that HTTP *could* be used by a mobile
 2 phone to upload data—not that it *was* conventionally used that way when the mobile phone acted
 3 as an intermediary device. (Dkt. No. 193-28 (“Foley Depo. II”) at 78:19-79:8.) Cellspin, on the
 4 other hand, cites detailed expert reports that in December 2007, the conventional process involved
 5 “end-to-end” HTTP that began with the data capture device, while mobile phones used the DUN
 6 protocol to relay data as a passive modem. (*See* Foley Report ¶¶ 64, 74, 156.) Indeed, according
 7 to several experts, companies like Facebook and Google did not release HTTP APIs until 2009,
 8 and even then, HTTP was used for “native” data only. (*Id.* ¶ 254; Singh Report ¶ 148; Garlick
 9 Report ¶¶ 81-86.) Cellspin also proffers evidence that using HTTP at an intermediary device
 10 provided technical benefits. (*E.g.*, Foley Report ¶ 302.)

11 Defendants do not meaningfully address Cellspin’s expert testimony and fail to provide
 12 their own evidence regarding the conventionality of applying HTTP at an intermediary device.
 13 They focus, instead, on legal arguments that the patents appear to be agnostic about using HTTP
 14 compared to other protocols. For instance, Defendants point out that claim 1 of the ’794 Patent
 15 permits either HTTP or a remote call procedure and that the specification similarly describes
 16 HTTP as an alternative to XML-RPC. (’794 Patent at claim 1, 10:5-8.) The Court broadly agrees
 17 that nothing in the asserted patents suggested that use of HTTP was the “invention” of the patents.
 18 However, because the patentee need not recite every inventive concept in the specification, this
 19 absence of evidence alone is not dispositive. *See Cellspin*, 927 F.3d at 1317.

20 Accordingly, the Court denies summary judgment on this issue.¹⁸

21 **E. Category Four: Attaching User Information at the Intermediary Device**

22 The same result follows for the next category. Cellspin claims that it was nonconventional
 23 to attach user information at the intermediary mobile device before sending the data to a website.
 24 (Inventive Concept Chart # 36, 44, 51.) This inventive concept follows the general theme that the
 25

26 ¹⁸ Contrary to Cellspin’s assertion, none of the claims require the data to be “in transit,”
 27 and claim 1 of the ’847 Patent expressly requires storing the data at the mobile device. Thus, the
 28 Court denies summary judgment based on using HTTP at an intermediary device only (i.e., on the
 device between the data capture device and publishing website server).

1 asserted patents offload the work of the data capture device unto the mobile device. (*Id.* # 22.)

2 Defendants cite *no evidence* in any form to show that attaching user information at an
3 intermediary device was conventional.¹⁹ Instead, Defendants point to the complaint, which alleges
4 that prior art computers attached HTTP headers and user data to “native” data—i.e., data that was
5 generated by the computer itself.²⁰ (*See* Dkt. No. 68 (“Compl.”) ¶ 16; *see also* Foley Report ¶ 255
6 (discussing same).) Defendants’ reference does not show that attaching user information at an
7 intermediary device was conventional or well-understood, even if it suggests that doing so was an
8 obvious variation. If computers already acted as intermediary devices and already attached user
9 data before publication, it may be obvious to combine the two functions at a mobile device.
10 However, obviousness under 35 U.S.C. § 103 presents a different question than patent eligibility,
11 and Defendants have not shown this to be “token post-solution activity” as a matter of law. *See*
12 *Diehr*, 450 U.S. at 191. Whatever the merits of the alleged invention here, applying user data at a
13 specific location to achieve a specific technical benefit is not an abstract idea, law of nature, or
14 natural phenomenon, and Defendants have not shown it to be well-known, routine, or
15 conventional.²¹

16 Accordingly, because Defendants fail to meet their burden to show that applying user data
17 at intermediary device was conventional, the Court denies summary judgment on this issue.

18
19 _____
20 ¹⁹ Defendants belatedly cite their expert, Dr. Madisetti, in their reply. Dr. Madisetti
21 discusses only attaching metadata to photos before publication, while citing prior art references.
(Madisetti Report ¶¶ 184-85.) That does not show that attaching metadata at an intermediary
device, as opposed to the data capture device, was conventional.

22 ²⁰ Defendants argue that the claims do not recite native or non-native data. However, each
23 claim requires publishing data by a different device than the one that acquired it, which is all that
24 non-native data involves. (*See* ’752 Patent at claim 1; Foley Report ¶ 255.) That said, Cellspin
does not apparently contend that applying HTTP to non-native data by a *computer* was non-
conventional, which may eviscerate this distinction. (*See* Dkt. No. 222 (“Tr.”) at 37.)

25 ²¹ In their motion, Defendants focus on the phrase “significantly more” to argue that an
26 inventive concept must have some magnitude or significance before it can create patent eligibility.
27 However, Defendants cite no case where the standard was used in this manner. Although some
28 judges on the Federal Circuit have suggested before *Alice* that “trivial” activity may not confer
patent eligibility, *see, e.g., CLS Bank Int’l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1283-84 (Fed.
Cir. 2013) (divided en banc), the Court has found no decision post-*Alice* where that phrase was
used to refer to the “significance” of the invention. To the extent that this remains the standard,
the Court sees no operational way to apply it as a matter of law and leaves it for the jury to decide.

1 **F. Category Five: Polling and Event Notification**

2 Cellspin claims that “event notification” and “polling” of the data capture device by the
3 mobile device provide an inventive concept. (Inventive Concept Chart # 26, 30, 35, 41.) The
4 parties’ experts disagree about the date when polling and event notification became routine in
5 Bluetooth. Defendants’ expert opines that these features were well-known years before December
6 2007 but cites only prior art patents for the proposition, which may not be sufficient. (Madisetti
7 Decl. ¶¶ 179-82); *see Berkheimer*, 881 F.3d at 1369. Cellspin’s experts—including Dr. Foley,
8 who acted as Bluetooth standards’ group CEO in the relevant period—opines that native event
9 notifications were only introduced into Bluetooth specifications in 2010.²² (Foley Report ¶ 259;
10 Singh Report ¶ 69; Garlick Report ¶ 76.)

11 Notwithstanding the dispute between the experts, this question is close. The claims do not
12 recite any particular method of polling or event notifications, and the Court construed this term
13 broadly as “checking status on a predetermined basis.” Notably, the construction was based in
14 part on Dr. Foley’s testimony regarding how a person of ordinary skill would understand polling
15 to work at the time of the invention. (*See* Dkt. No. 228 at 45-46.) This definition did not derive
16 from the specification or any method of polling unique to the asserted claims. Indeed, Dr. Foley
17 opined that a person of ordinary skill in the art would know how to implement pulling using a
18 paired connection by reading the Bluetooth specification.²³ (*See* Dkt. No. 193-27 (“Foley Depo
19 III”) at 48:14-21.) Thus, the claims here appear to “simply instruct[] the reader” to use polling or
20 event notifications “without limitation to particular ways to do so.” *Am. Axle*, 967 F.3d at 1298.

22 ²² The Federal Circuit may want to consider whether an inventive concept must refer to the
23 *patentee’s* own invention. Cellspin does not contend that it invented polling or event notifications.
24 Under *Berkheimer*, however, it may evade patent ineligibility simply by reciting someone else’s
25 unconventional invention. This result appears to contradict the Supreme Court’s instruction that
patent eligibility should not “depend simply on the draftsman’s art.” *Alice*, 573 U.S. at 224
(quoting *Flook*, 437 U.S. at 593).

26 ²³ Dr. Foley did not specify the year of the specification (e.g., 2007 or 2010). Defendants
27 cite several portions of the 2007 Bluetooth specification, but fail to provide expert testimony to
28 explain the rather obscure parameters cited. (*See, e.g.*, 2007 Bluetooth Specification at 661 (“user
passkey notification event” for “simple pairing”), 662 (“keypress notification event”).) Notably,
the claims require event notification and polling for new data specifically, not generic polling.

1 Nevertheless, because disputes of fact remain over whether polling and event notifications
2 were used to detect the presence of new data (which, Dr. Foley opines, provides technical benefits,
3 such as power savings) and after pairing, a reasonable jury may find that this feature provides an
4 inventive concept. Accordingly, the Court denies summary judgment on this issue.

5 **G. Remaining Categories**

6 At the end of its brief, Cellspin cites nine additional inventive concepts, while attaching an
7 exhibit having 55 other inventive concepts. As Cellspin effectively admits, these allegations
8 amount to little more than “the whole claim is inventive.” (*See, e.g.*, Opp. at 20:27-28 (the “novel
9 architecture” is “the entirety of the inventions as claimed”).) These concepts fall into three general
10 categories: (1) inherent benefits of the features described above, (2) combinations of various
11 inventive concepts as an “ordered combination,” and (3) additional inventive concepts related to
12 encryption and cryptography. Of these, only the last category may supply an inventive concept.

13 1. *Inherent Benefits*

14 Cellspin first lists a number of “inherent” benefits of the inventive concepts previously
15 described. A benefit is “inherent” if it is necessarily present when the other limitations are met.
16 *See In re Huai-Hung Kao*, 639 F.3d 1057, 1070 (Fed. Cir. 2011); *see also In re Kubin*, 561 F.3d
17 1351, 1357 (Fed. Cir. 2009) (finding patent invalid where an inherent benefit “is not an additional
18 requirement imposed by the claims . . . but rather a property necessarily present” when the other
19 limitations are satisfied).

20 Here, Cellspin claims that the invention allows, for example, the data capture device to be
21 less bulky and expensive. (Inventive Concept Chart # 1; *see also id.* # 3-7 (similar).) This benefit
22 is inherent to the two-step, two-device structure: where the mobile device performs the functions
23 of a data capture device, the latter device can necessarily be smaller and less functional. Similarly,
24 Cellspin claims benefits related to using a wireless, paired connection and a mobile application,
25 such as minimal user intervention (*id.* # 23) and real-time publishing (*id.* # 24). Again, these
26 benefits are a necessary consequence of automation and inherently present when such automation
27 is used in the two-step, two-device structure. Last, Cellspin claims the benefits of transferring
28 data after pairing has been established, such as avoiding data transfers when the devices are out of

1 range (*id.* # 30). This, too, is inherent in the concept of pairing before transferring data.

2 These alleged benefits cannot supply an inventive concept for two reasons. First, for the
3 reasons described above, many of the features that create the benefits are themselves well-known,
4 routine, and conventional and thus cannot supply an inventive concept. Where the feature itself
5 does not transform the claims, neither does recognizing a benefit of the feature. *Cf. Kao*, 639 F.3d
6 at 1070 (in the section 103 context, merely recognizing a previously unknown benefit does not
7 prevent invalidity). Second, even if recognizing a previously unknown benefit was enough, the
8 patents here do not claim such benefits. For example, the claims do not *require* the data capture
9 device to be smaller and less functional; they merely *allow* it.²⁴ Similarly, the claims do not
10 *require* the device to avoid transmitting data out of range; they merely define “new data” to
11 include data captured after the devices are in range to establish pairing. As such, the unclaimed
12 benefits cannot supply an inventive concept. *See Am. Axle*, 967 F.3d at 1293.

13 Accordingly, the Court finds that the concepts based on the benefits of other features
14 cannot supply an inventive concept: to the extent that the feature is conventional or abstract, the
15 alleged benefit does not change the equation, and to the extent that the feature may supply an
16 inventive concept, the benefits inquiry collapses into that determination. The Court therefore
17 grants summary judgment on inventive concepts 1, 3-7,10, 12, 27, 30, 39, 42, 43, 23(a), 24, 25,
18 27-28, 38, 45, 50, 53.

19 2. *Ordered Combinations*

20 Cellspin next claims combinations of the inventive concepts alleged above, as well as the
21 ordered combination of virtually every limitation recited in the claims. For instance, Cellspin
22 claims an inventive concept based on polling over an established paired connection, which is a
23 combination of polling and capturing data after pairing, discussed above. (*See* Inventive Concept
24 Chart # 35; *see also id.* # 23 (attaching HTTP and user information at the mobile device).)
25 Cellspin also claims that the “overall ordered combination of elements recited” in the claims was

26
27 ²⁴ The only claimed benefit involves using the GUI of the mobile device. (*See* Inventive
28 Concept Chart # 43.) A GUI is not even arguably inventive, however, and purely generic
 limitations related to executing “instructions” to “provide a graphical user interface (GUI) for the
 new-data” cannot supply an inventive concept. (*Id.*)

1 inventive. (*Id.* # 17-20.) Last, Cellspin claims generic statements regarding combinations. (*See*
2 *id.* # 14 (describing “implementing even a well-known technique” with “particular devices in a
3 specific combination”), 15 (“The combined and cumulative application of the claimed
4 elements”).)

5 As an initial matter, the Court finds it appropriate to place the burden of production (but
6 not the burden of persuasion) on Cellspin for these allegations. Courts routinely place the burden
7 of production on the patentee where it has greater knowledge and the party challenging validity
8 would otherwise have the burden to prove a negative. For example, where an accused infringer
9 establishes a prima facie case of invalidity based on anticipation, the patentee has the burden to
10 “go[] forward with evidence” and “persuasive argument” that they are entitled to an earlier priority
11 date. *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327-28 (Fed. Cir. 2008). Similarly,
12 where a party challenging validity demonstrates that the prior art discloses an overlapping range,
13 the patentee has the burden to come forward with evidence that the range claimed in the patent is
14 non-obvious. *See E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1008 (Fed. Cir.
15 2018). This rule makes sense because proving a negative—e.g., that a patentee is not entitled to
16 every possible priority date—is disfavored and inferring facts about a whole based on its parts,
17 and vice versa, is reasonable. *See id.*

18 With respect to inventive concepts, the Federal Circuit has explained that the analysis
19 involves two “distinct” inquiries: first, whether the individual and patent-eligible claim elements
20 are “well-understood, routine, or conventional,” and second, whether an analysis of those elements
21 “as an ordered combination” “add[s] nothing” beyond the individual concepts. *Chamberlain*, 935
22 F.3d at 1348-49. While the first inquiry undoubtedly rests with the party challenging validity, *see*
23 *Berkheimer*, 890 F.3d at 1371, the second inquiry necessarily depends on the patentee’s arguments
24 for “additional” inventiveness based on a combination of otherwise conventional elements. Thus,
25 where the defendants have established a prima facie case that individual elements or concepts are
26 conventional in the first instance, the Court finds it appropriate to place the burden of production
27 on the patentee to come forward with evidence and argument that the “ordered combination”
28 requires additional or different analysis.

1 Accordingly, the Court ordered Cellspin to provide supplemental briefing to identify *each*
 2 inventive concept based on an ordered combination, as well as what the combination “adds” to the
 3 analysis beyond the individual concepts. (*See* Dkt. No. 175.) Cellspin’s supplemental submission
 4 confirms that the combinations add nothing. Cellspin’s arguments for these alleged inventive
 5 concepts wholly overlap with its arguments for the individual inventive concepts analyzed above.
 6 (*See* Dkt. No. 220 (“Suppl. Brief”).) For instance, Cellspin claims the ordered combination of the
 7 elements permits efficient transfers of data and real-time publishing, which is exactly the same
 8 argument as for a two-step, two-device structure connected using a wireless, paired connection.
 9 (*Id.* at 2.) Although Cellspin claims that all of the limitations are needed to achieve real-time
 10 publishing,²⁵ it provides no supporting evidence or argument for that proposition. For instance, it
 11 does not explain why event notifications or pairing are necessary to achieve that result. Cellspin’s
 12 evidentiary citations are also the same, other than conclusory expert opinion that the asserted
 13 claims “as a whole” were non-conventional. (*See* Foley Report ¶¶ 249-53.)

14 Absent concrete evidence that the ordered combination adds something beyond the
 15 individual inventive concepts described in this Order, Cellspin is left to argue that each of those
 16 concepts “does not confer the totality of the benefits and the complete solution.” (Suppl. Brief at
 17 2-3.) This does not show, however, that the combination adds any inventiveness beyond the
 18 cumulative inventiveness of the individual concepts. Because Cellspin has not shown that
 19 analyzing the combination requires a different analysis than analyzing the individual concepts
 20 separately, Cellspin’s arguments for these inventive concepts fail.²⁶

21 Accordingly, the Court grants summary judgment on inventive concepts 16-20, 23-24, 31.

23 ²⁵ Cellspin’s argument for this concept appears to hinge on the software module in the
 24 mobile device performing the claimed functions. (*See* Inventive Concept Chart # 38.) Cellspin
 25 does not claim, however, to have invented smartphones or smartphone apps. To the extent that
 these functions could have been performed by an intermediary computer, merely leveraging the
 ability of a mobile phone to act as one is insufficient.

26 ²⁶ Notably, although Cellspin claims seven inventive concepts based on combinations, its
 27 evidence and arguments are identical for each and cross-reference each other. (*See* Suppl. Brief at
 28 4 (concept 17 cross-referencing analysis for concept 16 and citing the same evidence), 5 (same for
 18), 6 (same for 19), 7 (same for 20), 9 (same for 24, but relating it to “real time” situations), 10
 (same for 31, but calling it an “unconventional architecture”).)

1 3. *Cryptography*

2 Last, Cellspin claims an inventive concept based on using cryptographic authentication,
3 either individually for physically separate devices or when combined with pairing. (*See* Inventive
4 Concept # 33, 49.) Defendants correctly point that courts have found cryptographic encryption
5 and authentication to be conventional. *See Intellectual Ventures II LLC v. JPMorgan Chase &*
6 *Co.*, No. 13-CV-3777 AKH, 2015 WL 1941331, at *14 (S.D.N.Y. Apr. 28, 2015). Defendants
7 introduce evidence that the 2007 Bluetooth specification described authentication and encryption,
8 which confirms as much. (Madisetti Decl. ¶ 187.) Moreover, the construction of the term
9 “cryptographically authenticated” in this case is wholly generic: the Court construed the term as
10 “authenticated using a cryptographic algorithm” based on the parties’ apparent agreement on this
11 interpretation.²⁷ The claims thus do not require any particular inventive method of encryption or
12 authentication—they claim only a functional result. The Court therefore agrees that cryptographic
13 authentication (for either the same or a different device) cannot supply an inventive concept.²⁸

14 With respect to using cryptographic authentication together with pairing, however,
15 Defendants introduce no evidence that such secured pairing were conventional. Cellspin’s experts
16 provide conclusory opinions that using encryption keys in pairing was “unknown.” (Foley Report
17 ¶¶ 266; Singh Report ¶ 222.) Cellspin further proposed to construe a “secured paired Bluetooth
18 connection” as “a connection in which one or more optional Bluetooth security methods are
19 implemented” during claim construction, which appears to confirm that such “optional” methods
20 were routine. (*See* Claim Construction Statement at 11.) Defendants do not address the expert
21 opinions or provide their own evidence or argument that cryptography was commonly used with
22 pairing. Defendants thus fail to meet their burden to show that this concept was well-understood,
23 routine, and conventional.

24 _____
25 ²⁷ Although the Court construed “cryptographically authenticated” as used in the ’847
26 Patent, Cellspin expressly argued for similar constructions in the ’752 Patent. (*See* Dkt. No. 153
at 19 (relying on claim language in ’752 Patent).)

27 ²⁸ As with the previous concepts, Cellspin’s conclusory expert opinion does not create a
28 genuine dispute of fact. (*See* Foley Report ¶¶ 266-67, 287; Singh Report ¶ 239.) Nor does the
claim that cryptographic authentication was “optional” in Bluetooth (because one conventional
option among others is still conventional). (Foley Report ¶¶ 212-13.)

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Accordingly, the Court grants summary judgment on inventive concept 49, but denies it for inventive concept 33.²⁹

IV. CONCLUSION

In summary, and for the foregoing reasons, the Court **DENIES** Defendants’ motion for summary judgment of Section 101 invalidity based on the following inventive concepts only:


- Applying HTTP and user information at an intermediary device;
- Polling and event notifications to detect the presence of new data after pairing;
- Using cryptographic methods together with pairing.

The Court **GRANTS** Defendants’ motion on the remaining alleged inventive concepts.

This terminates docket No. 193 in case number 4:17-cv-5933.

IT IS SO ORDERED.

Dated: April 14, 2021


YVONNE GONZALEZ ROGERS
UNITED STATES DISTRICT COURT JUDGE

²⁹ Summary judgment is further granted as to legal conclusions claimed as inventive concepts (*see* Inventive Concept Chart # 8, 14-15) and inventive claims based on combinations not raised in Cellspin’s supplemental brief. (*E.g., id.* # 47.)