

Cellspin Soft Inc, (Cellspin) filed U.S. Patent 9,258,698 (the “‘698 Patent”) in 2007 at a time when transferring an image from a camera to a mobile phone and then to a website was a clunky process often requiring file transfers via email, a removable memory card, or a physical cable.

In 2018, Cellspin ‘698 patent was challenged by multiple multibillion-dollar companies with staggered parallel petitions challenging the same patent and same claims. The ‘698 Patent was challenged by, Panasonic Corporation of North America, Canon U.S.A, Garmin International Inc, GoPro Inc, and JK Imaging Ltd.

Currently all the PTAB cases are on CAFC Appeal.

In 2007, before the ‘698 Patent, transferring photos required multiple applications such as browsers, email clients, and file transfer programs. These inefficient photo-transferring techniques would eventually be addressed by the who’s who of technology companies—but not until many years after Cellspin’s ‘698 Patent was filed. Indeed, in or around 2009, Google’s YouTube and Yahoo’s Flickr platforms broke convention by implementing HTTP as a means of uploading photos from the mobile phone without requiring a separate browser—a technique disclosed two years prior in Cellspin’s ‘698 Patent. And after 2013, companies such as GoPro, Panasonic, Canon implemented a single mobile application image to transfer images only after incorporating what the ‘698 Patent taught nearly five years prior. In 2009, Mr. Singh (named inventor) was featured on the cover of Silicon India Magazine. Cellspin won Silicon India’s Top Mobile Application Award for 2008. Yet, despite having solved problems that billion-dollar companies like Yahoo and Google had yet to address, the ‘698 Patent’s claims were discounted by the Board as obvious.

I urge adoption of regulations to govern the discretion to institute PTAB trials consistent with the following principles.

I: PREDICTABILITY

Regulations must provide predictability. Stakeholders must be able to know in advance whether a petition is to be permitted or denied for policy reasons. To this end regulations should favor

objective analysis and eschew subjectivity, balancing, weighing, holistic viewing, and individual discretion. The decision-making should be procedural based on clear rules. Presence or absence of discrete factors should be determinative, at least in ordinary circumstances. If compounded or weighted factors are absolutely necessary, the number of possible combinations must be minimized and the rubric must be published in the Code of Federal Regulations.

II: MULTIPLE PETITIONS

- a) A petitioner, real party in interest, and privy of the petitioner should be jointly limited to one petition per patent.
- b) Each patent should be subject to no more than one instituted AIA trial.
- c) A petitioner seeking to challenge a patent under the AIA should be required to file their petition within 90 days of an earlier petition against that patent (i.e., prior to a preliminary response). Petitions filed more than 90 days after an earlier petition should be denied.
- d) Petitioners filing within 90 days of a first petition against the same patent should be permitted to join an instituted trial.
- e) These provisions should govern all petitions absent a showing of extraordinary circumstances approved by the Director, Commissioner, and Chief Judge.

III: PROCEEDINGS IN OTHER TRIBUNALS

- a) The PTAB should not institute duplicative proceedings.
- b) A petition should be denied when the challenged patent is concurrently asserted in a district court against the petitioner, real party in interest, or privy of the petitioner and the court has neither stayed the case nor issued any order that is contingent on institution of review.
- c) A petition should be denied when the challenged patent is concurrently asserted in a district court against the petitioner, real party in interest, or privy of the petitioner with a trial is scheduled to occur within 18 months of the filing date of the petition.
- d) A petition should be denied when the challenged patent has been held not invalid in a final determination of the ITC involving the petitioner, real party in interest, or privy of the petitioner.

IV: PRIVY

a) An entity who benefits from invalidation of a patent and pays money to a petitioner challenging that patent should be considered a privy subject to the estoppel provisions of the AIA.

b) Privy should be interpreted to include a party to an agreement with the petitioner or real party of interest related to the validity or infringement of the patent where at least one of the parties to the agreement would benefit from a finding of unpatentability.

V: ECONOMIC IMPACT

Regulations should account for the proportionally greater harm to independent inventors and small businesses posed by institution of an AIA trial, to the extent it harms the economy and integrity of the patent system, including their financial resources and access to effective legal representation.