

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITEK SYSTEMS, INC.,
Petitioner,

v.

ROTHSCHILD MOBILE IMAGING INNOVATIONS, LLC,
Patent Owner.

Case IPR2015-00623
Patent 7,995,118 B2

Before JAMESON LEE, DAVID C. McKONE, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Mitek Systems, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute *inter partes* review of claims 1–21 of U.S. Patent No. 7,995,118 B2 (Ex. 1001, “the ’118 patent”). Rothschild Mobile Imaging Innovations, LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, in our Decision to Institute (Paper 8, “Dec.”), we instituted this proceeding as to each of the challenged claims.

After institution of trial, Patent Owner filed a Patent Owner’s Response (Paper 20, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner’s Response (Paper 23, “Reply”). An oral argument was held on April 19, 2016. Paper 35 (“Tr.”).

Petitioner relies on the testimony of Irfan Essa, Ph.D. Ex. 1013 (“Essa Decl.”). Patent Owner did not submit testimony in support of its Response.

We have jurisdiction under 35 U.S.C. § 6(c). This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims. Based on the record before us, Petitioner has demonstrated, by a preponderance of the evidence, that each of the challenged claims is unpatentable.

B. Related Matters

The ’118 patent has been asserted in several lawsuits in the United States District Court for the District of Delaware. Pet. 1–2; Paper 4, 2–3. IPR2015-00621 and IPR2015-00622 involve patents related to the ’118

patent. The oral argument for IPR2015-00622 was consolidated with the oral argument for this proceeding.

C. References Relied Upon

Petitioner relies on the following references:

Ex. 1003	Safai	US 6,167,469	Dec. 26, 2000
Ex. 1004	Terp	WO 01/31546 A2	May 3, 2001
Ex. 1005	Cazier	US 6,657,661 B1	Dec. 2, 2003
Ex. 1006	Arai	US 6,642,959 B1	Nov. 4, 2003
Ex. 1007	Lin	US 8,271,489 B2	Sept. 18, 2012
Ex. 1008	Mattes	US 6,038,295	Mar. 14, 2000
Ex. 1009	Knowles	US 7,173,651 B1	Feb. 6, 2007
Ex. 1010	Steinberg	US 6,750,902 B1	June 15, 2004
Ex. 1011	Shih	US 7,123,782 B2	Oct. 17, 2006
Ex. 1012	Mortimore	US 5,950,207	Sept. 7, 1999

D. The Asserted Grounds

We instituted a trial on the following grounds (Dec. 23–24):

References	Basis	Claim(s)
Safai and Terp	§ 103(a)	1, 2, 4–7, 9, 10, and 19–21
Safai, Terp, and Mortimore	§ 103(a)	3
Safai, Terp, and Cazier	§ 103(a)	8
Safai, Terp, and Arai	§ 103(a)	11

References	Basis	Claim(s)
Safai, Terp, and Lin	§ 103(a)	12
Safai, Terp, and Mattes	§ 103(a)	13 and 14
Safai, Terp, Mattes, and Knowles	§ 103(a)	15
Safai, Terp, and Steinberg	§ 103(a)	16 and 18
Safai, Terp, and Shih	§ 103(a)	17

II. ANALYSIS

A. The '118 Patent

The '118 patent describes a digital imaging device, such as a digital camera, personal digital assistant (PDA), or mobile telephone, that allows embedding information into and retrieving information from digital images. Ex. 1001, Abstract. Figures 1A and 1B, reproduced below, illustrate an example:

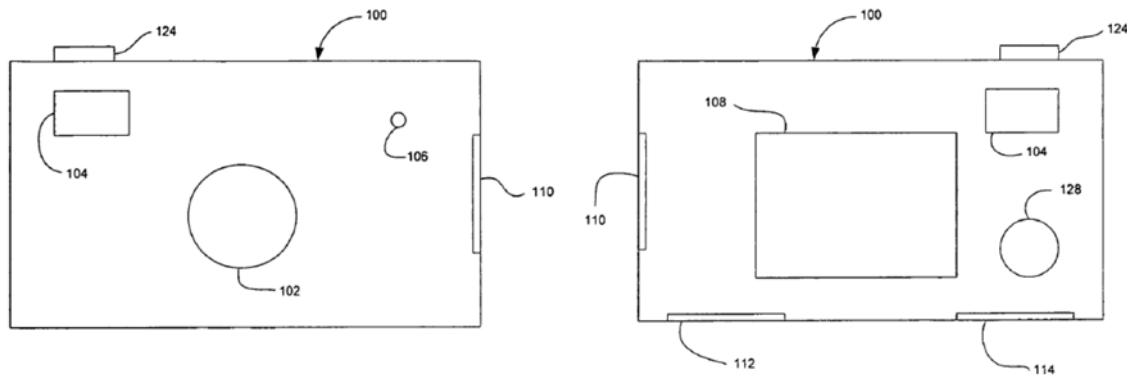


FIG. 1A

FIG. 1B

Figures 1A and 1B are front and back views, respectively, of a device for capturing digital images and embedding information in the captured images. *Id.* at 3:3–6.

As shown in Figure 1A, the front side of device 100 includes lens 102 for capturing an image and microphone 106 for capturing audio information. *Id.* at 3:33–39. As shown in Figure 1B, the rear side of device 100 includes display module 108 (e.g., a touch screen display) for displaying captured images, storage module 110 (e.g., random access memory (“RAM”) or a removable memory stick) for storing captured images, transmission module 112 (e.g., Bluetooth, Wi-Fi, or parallel or serial cables) for transmitting digital images to another device, and scanning module 114 for scanning and inputting information to be associated with an image and for reading information from printed images. *Id.* at 3:40–51, 4:32–37, 5:49–61.

The ’118 patent describes the functions of the device in terms of modules, depicted in Figure 2, reproduced below:

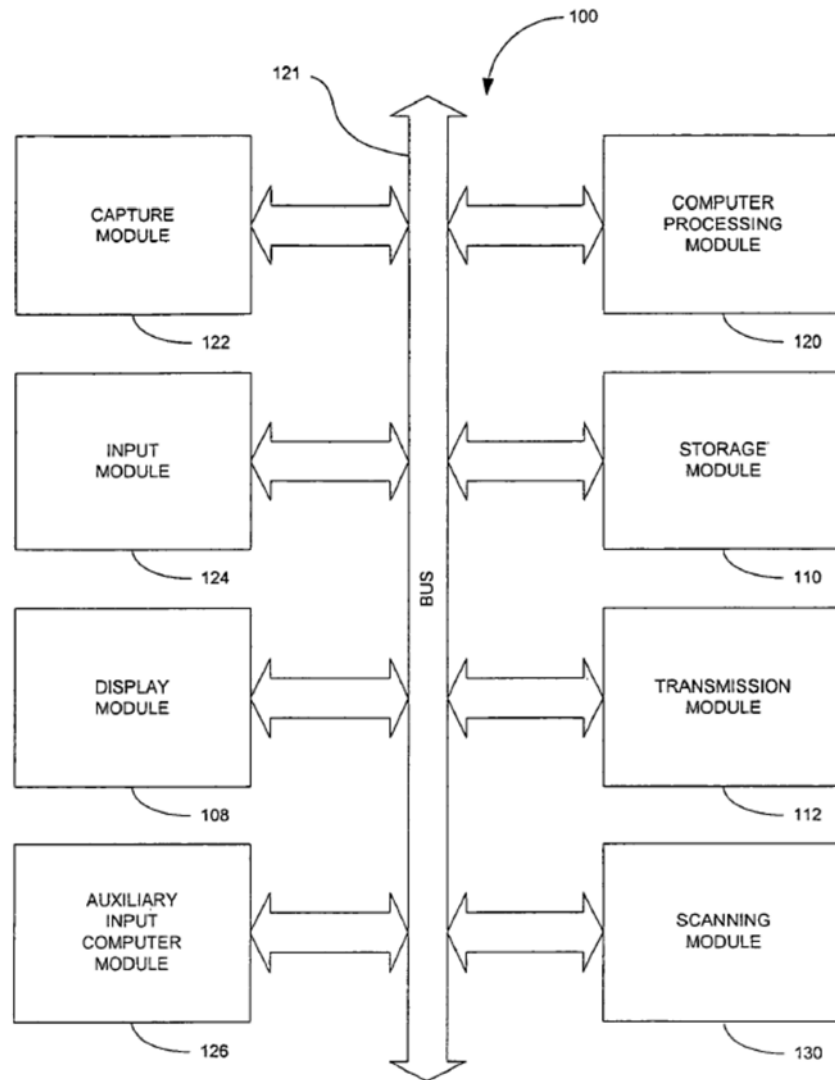


FIG. 2

Figure 2 is a block diagram of the modules of a device for capturing digital images and embedding information in the captured images. *Id.* at 3:7–9.

Display module 108, storage module 110, and transmission module 112 correspond to those depicted in Figures 1A and 1B, above. Capture module 122 works in conjunction with lens 102 to create a digital image,

which is stored in storage module 110. *Id.* at 4:15–32. User input module 124 receives text input, for example from a standard keyboard or a touch screen that overlays display module 108. *Id.* at 4:56–63. Auxiliary input module 126 collects data from other devices, such as a Global Positioning System (“GPS”) chip (to determine the location where an image was taken), a date chip (to determine the date and time an image was taken), and a voice capture device. *Id.* at 5:24–44.

Using input module 124, a user inputs data that will be associated with the digital image. *Id.* at 5:4–7. The data can be stored in a separate file or in the header of the image file. *Id.* at 5:7–23. The data can include a file location on a local computer or server on the Internet at which to store the image file. *Id.* at 7:54–60. Audio information (e.g., collected using auxiliary input module 126) also can be associated with the digital image. *Id.* at 7:61–8:4. After the digital image is captured and data is associated with it, the digital image file, along with any associated files, is transmitted (using transmission module 112) to the local computer or a server on the Internet, where it is stored in a relational database according to the location information. *Id.* at 5:45–6:6, 8:27–34.

When the digital image is printed out, it prints with symbology (e.g., a bar code) that encodes the file name of the image or other information that provides access to the file name and file location. *Id.* at 6:7–25. This symbology can be scanned by integrated scanning module 130 (e.g., a light-emitting diode (“LED”) light source and photocell) of the device to extract the name and location of the digital image and pull up the image file and any

associated files (assuming the device is connected through transmission module 112 to the local computer or Internet server). *Id.* at 6:26–55.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A digital imaging device comprising:
 - a first capture module for capturing an image and creating a digital image file, the digital image file comprising data representing the captured image;
 - a display module disposed on the digital imaging device for displaying the captured image and configured to prompt a user to input information regarding the captured image;
 - an input module disposed on the digital imaging device for enabling the user to input subject information related to a subject of each captured image and to input storage location information indicative of a storage location on a separate external computing device for storing each digital image file after transfer from the digital imaging device;
 - a second capture module configured to scan coded information to be associated with the captured image;
 - a processing module for associating the subject information, storage location information, and the coded information to the digital image file; and
 - a transmission module for transmitting the digital image file and the associated information to the external computing device for storage or data lookup.

B. Claim Construction

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*,

793 F.3d 1268, 1278 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). In applying a broadest reasonable construction, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. Terms Construed in the Decision to Institute

In the Decision to Institute, we gave the following constructions:

Term	Construction
“symbology information” (claim 21)	“a machine-readable symbol encoding information about a digital image”
“storage location” (claims 1, 19, 20)	“a location where data may be stored”
“storage location information” (claims 1, 19, 20)	“information identifying where data may be stored”

The parties do not challenge these constructions in the Response or Reply. We maintain these constructions on the full record.

2. “prompt” (claim 1)/“prompting” (claim 19)

Claim 1 recites “a display module . . . configured to *prompt* a user to input information regarding the captured image” (emphasis added).

Similarly, claim 19 recites “*prompting* a user of the digital imaging mobile device for information regarding the captured image” (emphasis added).

Patent Owner contends that “prompt” or “prompting” means “inciting or providing a cue, to input or for information regarding a captured image.” PO Resp. 13. As an initial matter, claim 1 already recites “to input information regarding the captured image” and claim 19 recites “for information regarding the captured image.” Accordingly, we will not read those phrases into the construction of “prompt.”

As to whether “prompt” means to incite or provide a cue, Patent Owner argues that its proposed construction is consistent with certain dictionary definitions. PO Resp. 14 (citing MERRIAM-WEBSTER ONLINE DICTIONARY, 2015, available at, <http://www.merriam-webster.com/dictionary/prompt>).

Petitioner contends that “prompt” refers to “a visual or audible indication that [a] device is ready to receive input.” Reply 2. Petitioner argues that we should discount Patent Owner’s dictionary, as its 2015 date is not contemporaneous with the 2004 priority date of the ’118 patent. *Id.* The definition of “prompt,” however, has not changed meaningfully during that time. See AMERICAN HERITAGE COLLEGE DICTIONARY 1115 (4th ed. 2004) (Ex. 3001). In any case, we are unable to discern a meaningful difference between the parties’ respective proposals. Indeed, at the oral argument, Petitioner was unable to identify a difference. Tr. 17:6–18:11.

We conclude that “incite or provide a cue” is consistent with the Specification. For example, the Specification states that the “prompting step includes displaying information regarding the captured image.” Ex. 1001, 2:45–48. In another example, “the display module may include an audio output device for audibly prompting a user to input information regarding

the captured image.” *Id.* at 2:12–14. Thus, “prompt” means “to incite or provide a cue,” and “prompting” means “inciting or providing a cue.”

We note, however, that the parties’ respective proposals do not capture the actual dispute as to the meaning of “prompt.” Rather, Patent Owner, in distinguishing Safai (discussed below), argues that Safai describes a user navigating through multiple menus before arriving at the display that Petitioner contends prompts the user to input information. PO Resp. 16–18. At the oral argument, although Patent Owner would not commit to precise language it would use to make this distinction, Patent Owner essentially argued that the prompting must be automatic, or without any action on the part of the user between capturing an image and prompting the user to input information. Tr. 36:4–37:25.

We find no such requirement in the ordinary meaning of “prompt,” as evidenced by Patent Owner’s dictionary definition. Patent Owner also does not point to evidence in the Specification that would support its position. In its most detailed example, describing a user taking pictures of his wife and child during a trip to Las Vegas, the Specification explains that

[a]t end of taking pictures or alternatively, immediately after taking each individual picture, the user goes back to the device 100, 200 and using either keystroke input via input module 124 or voice recognition software via a microphone, or any other input means the user is prompted to provide . . . information regarding the pictures, i.e., the images taken (step 304)[,]

including a file location to store the pictures. Ex. 1001, 7:46–53. This suggests that, in one embodiment, the user is not prompted to input storage location information until he returns to the device after taking several

pictures. After inputting location information, “[t]he user is then asked via the speaker, or prompted on the display module 108, 208, if he wants to attach any audio or video to the images.” *Id.* at 7:61–63. The Specification does not require such prompting to be automatic or without any intervening action on the part of the user to elicit the “prompt,” and, indeed, it is described as occurring in response to the user inputting other information.

In sum, on the complete record and under the rule of broadest reasonable interpretation, “prompt” means “to incite or provide a cue.” Similarly, “prompting” means “inciting or providing a cue.” We note that this evidence, the dictionary definitions and consistent description in the Specification evidencing ordinary meaning, also would support the same constructions under the different standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

3. “*a second capture module configured to scan coded information to be associated with the captured image*” (claim 1)/“*scanning coded information to be associated with the captured image*” (claim 19)/“*receiving coded information to be associated with the captured image*” (claim 20)

Claim 1 recites “a first capture module for capturing an image and creating a digital image file” and “a second capture module configured to scan coded information to be associated with the captured image.” Claims 19 and 20 include similar recitations. Patent Owner argues that the claims each specify an order as to the functions performed by the first and second capture modules of claim 1, the functions performed by the capture module

and input module of claim 20, and the capturing and scanning steps of claim 19. Specifically, regarding claim 1, Patent Owner argues that “the claim requires an image to be captured by a first capture module and then a second capture module scans coded information to be associated with ‘the’ captured image.” PO Resp. 19 n.1. Patent Owner argues that the claim language itself requires this order because “*the* captured image” refers to an image that already has been captured. *Id.*

In response, Petitioner argues that the “second capture module” of claim 1 (or the scanning coded information step of claim 19) does not perform an association between the captured image and the coded information. Reply 7–8. Rather, the second capture module scans information “to be associated with” the image by the “processing module for associating . . . the coded information to the digital image file.” *Id.* Thus, Petitioner argues, it is not logically necessary that the coded information is scanned after the image is captured so long as both the image and the coded information are available when the processing module performs its function (or available at the time of claim 19’s “associating the . . . coded information to the digital image file” step). *Id.* at 8–9. Petitioner further argues that the use of “first” and “second” in claim 1 is to distinguish repeated instances of “capture module” rather than to specify an order. *Id.* at 10.

“[A]lthough a method claim necessarily recites the steps of the method in a particular order, as a general rule the claim is not limited to performance of the steps in the order recited, unless the claim explicitly or implicitly requires a specific order.” *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1345 (Fed. Cir. 2008). We agree with Petitioner that,

logically, coded information “to be associated” with an image need not be scanned subsequent to the capture of the image, so long as the image has been captured and the coded information has been scanned prior to the association of those two pieces of information.

“The specification or prosecution history may also require a narrower, order-specific construction of a method claim in some cases.” *Baldwin Graphic Sys.*, 512 F.3d at 1345. Here, however, the intrinsic evidence does not suggest that the functions or steps must occur in a specific order. According to Petitioner, the Specification does not discuss in detail the scanning of coded information to be associated with an image. Reply 9. Patent Owner does not cite to evidence of any ordering in the Specification or prosecution history and, at the oral argument, was unable to identify any description in the Specification of scanning coded information to be associated with an image. Tr. 42:24–44:12.

On the complete record and under the rule of broadest reasonable interpretation, we are not persuaded that claims 1, 19, and 20 should be construed to include an order in which an image must be captured prior to scanning or receiving coded information to be associated with that image. We note that this evidence—the claim language itself and the description in the Specification—also would support the same constructions under the different standard set forth in *Phillips*.

C. Obviousness over Safai and Terp

Petitioner contends that claims 1, 2, 4–7, 9, 10, and 19–21 would have been obvious over Safai and Terp. Pet. 8–37.

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” We resolve the question of obviousness 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) objective evidence of nonobviousness, i.e., secondary considerations.¹ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In an obviousness analysis, some reason must be shown as to why a person of ordinary skill would have combined or modified the prior art to achieve the patented invention. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008). A reason to combine or modify the prior art may be found explicitly or implicitly in market forces, design incentives, the “interrelated teachings of multiple patents,” “any need or problem known in the field of endeavor at the time of invention and addressed by the patent,” or the background knowledge, creativity, and common sense of the person of ordinary skill. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–29 (Fed. Cir. 2009) (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–21 (2007)).

¹ The record does not contain any evidence of secondary considerations.

1. *Scope and Content of the Prior Art*

a. *Overview of Safai*

Safai describes a digital camera that associates additional information (e.g., text describing a subject) to a digital image and transports the image and information (e.g., by email) to a destination. Ex. 1003, Abstract.

Figure 1, reproduced below, illustrates an example:

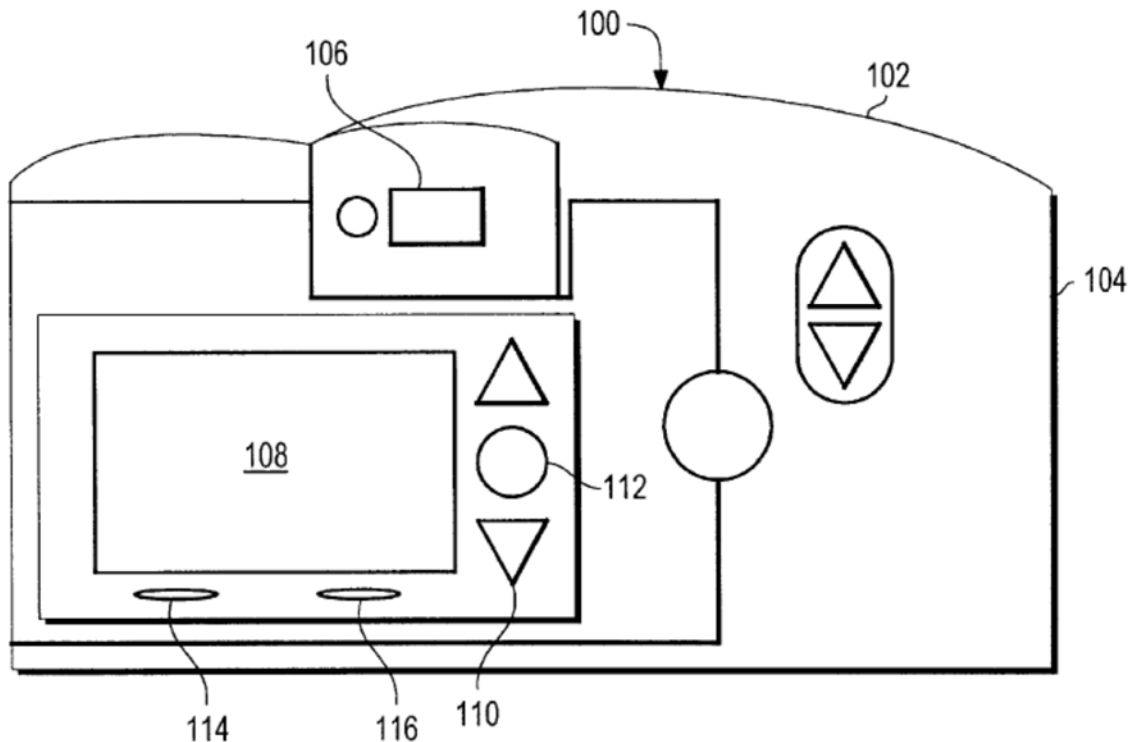


Fig. 1

Figure 1 is a rear view of a personal handheld digital camera. *Id.* at 4:33–34.

Camera 100 includes display device 108 (e.g., a touchscreen LCD display) for displaying stored digital images. *Id.* at 5:17–21, 6:37–50.

Through a series of software menus, a user can use the display device to

enter text describing a subject of a digital image and an email address to which to transmit the image and subject text (or, alternatively, a URL of a designated server or web site to which to upload the photos). *Id.* at 8:48–9:5, 14:59–64. Examples of successive menus for entering address and subject information are shown in Figures 3, 4A, and 4B. Specifically, a user (through the touch screen), selects “Mail” button 302 from the Photo Access menu shown in Figure 3; the user is presented with the Photo Mail menu shown in Figure 4A; the user selects “Address” button 402 from the Photo Mail menu; and the user then is presented with an address entry display 412, shown in Figure 4B (reproduced below). *Id.* at 7:66–8:12, 8:21–52.

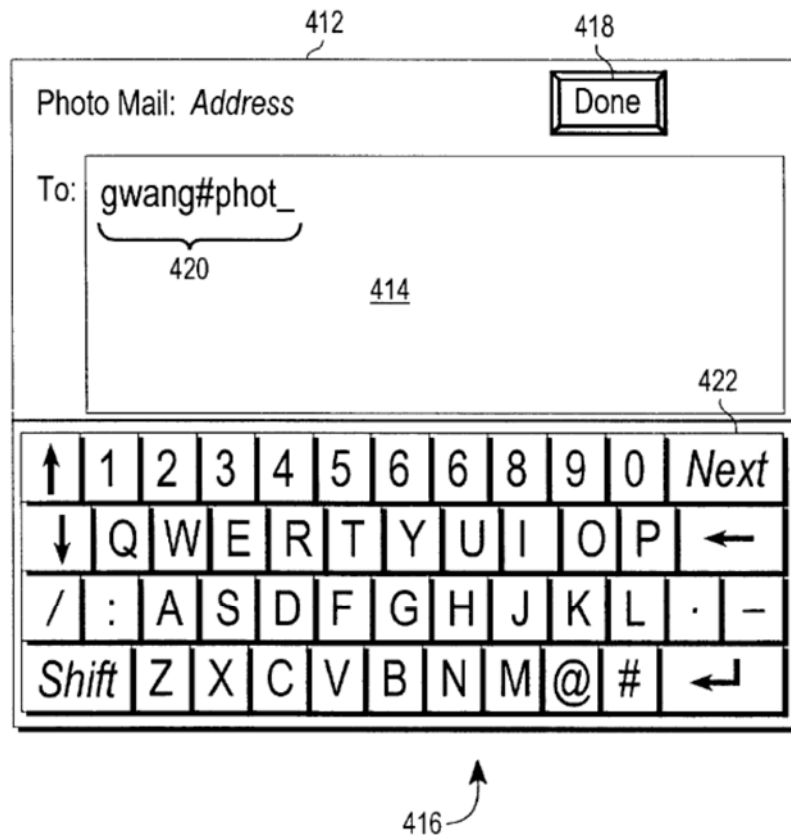


Fig. 4B

Figure 4B is a block diagram of a display generated during an addressing step of an image transport application. *Id.* at 4:44–45. Display 412 includes address entry field 414 and virtual keyboard 416, through which the user enters address 420, such as an email address. *Id.* at 8:52–65. Display 412 also can include a subject data entry field (not shown) next to address entry field 414, into which the user may enter text for a subject. *Id.* at 9:1–8. The subject text is stored in a variable associated with the address. *Id.* at 9:10–13.

The user then selects one or more stored images to be sent to the address. *Id.* at 10:24–59. The selected images are associated with the address and stored in a data structure maintained in a storage device of the camera. *Id.* at 11:21–26.

Camera 100 also can include a microphone for receiving voice commands or recording sound to be associated with the digital images. *Id.* at 6:19–36. For example, digitized voice information can be stored in a file and associated with the selected digital images, address information, and subject information. *Id.* at 11:49–54.

The camera also includes input/output devices, such as a communications port for transmitting data to and receiving data from another computer via, for example, modems and an Ethernet interface. *Id.* at 6:5–18. The user initiates transmission of the email by pressing a send button. *Id.* at 13:10–12. The camera transmits the digital images and associated information to a server, which parses the email address and forwards the images using electronic mail. *Id.* at 13:54–14:24. Alternatively, if the user specified a web site to which to upload the photos,

the server creates a HyperText Markup Language (“HTML”) file with the images and transmits it using a protocol, such as File Transfer Protocol (“FTP”), to the identified web server. *Id.* at 14:61–15:11.

b. Overview of Terp

Terp describes a portable device, such as a pen tablet, including a processor, an image scanner, a digital camera, and memory, for gathering inventory profile information. Ex. 1004, 4:11–17, 6:27–35. A user uses the device’s image scanner to capture an image of an inventory item identifier (e.g., a bar code or vehicle identification number (“VIN”)), which is processed to generate an alphanumeric representation. *Id.* at 4:18–20, 4:32–34, 6:15–26. With the representation, the device retrieves an inventory item profile file from the portable device’s memory and displays it on a screen. *Id.* at 4:35–38.

To create an inventory file, a user captures the bar code or VIN using the image scanner. If the VIN is not on record, a vehicle record is created on the device’s memory. *Id.* at 8:33–38. The device then prompts the user for information about the vehicle to include in the inventory file, such as features and asking price, which can be entered using the pen tablet. *Id.* at 9:3–18. The device then prompts the user to take a picture of the vehicle using the digital camera. *Id.* at 9:29–33. The device then generates and stores a profile for the vehicle, the profile including the information, pricing, and pictures. *Id.* at 9:34–36.

The user also can update the inventory item profile file, for example by capturing a digital image of the inventory item with the device’s camera

and attaching the image to the file. *Id.* at 5:1–7. The inventory item profile file can be transmitted to a server of a web site when the portable device is docked in a docking station. *Id.* at 5:11–13.

2. Level of Ordinary Skill in the Art

The Petition does not take a position on the level of ordinary skill in the art, although Dr. Essa states his opinion in his Declaration. *See* Ex. 1013 ¶ 11. Patent Owner does not take a position on the level of ordinary skill. With regard to the level of ordinary skill in the art, we determine that no express finding is necessary, on this record, and that the level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

3. Differences Between the Prior Art and Claims 1, 2, 4–7, 9, 10, and 19–21; Reasons to Combine

a. Uncontested claim limitations

The features of Safai are summarized above. Regarding claim 1, we have considered Petitioner’s evidence, including Dr. Essa’s testimony (Ex. 1013 ¶¶ 31–33, 36–39, 46, 50), presented at pages 8–9, 11–12, 16, and 18–19 of the Petition, and make the following findings:

Safai’s digital camera 100 is a “digital imaging device”;

The structure described by Safai as acquiring digital images (e.g., a lens, shutter, charge-coupled device (CCD)), Ex. 1003, 5:21–27, teaches “a first capture module for capturing an image and

creating a digital image file, the digital image file comprising data representing the captured image”;

Safai’s display device 108, *id.* at 6:17–21, 6:38–50, is “a display module disposed on the digital imaging device for displaying the captured image”;

Safai’s touch screen 412, used to enter text describing a subject of a digital image and for entry of an email address or a URL, *id.* at 6:45–50, 9:1–8, teaches “an input module disposed on the digital imaging device for enabling the user to input subject information related to a subject of each captured image and to input storage location information indicative of a storage location on a separate external computing device for storing each digital image file after transfer from the digital imaging device.” Consistent with the constructions in Section II.B.1 above, we find that email addresses (*id.* at 8:48–67) and URLs (*id.* at 14:59–15:11) are examples of information indicative of storage locations and that information entered in a “subject data entry field” (*id.* at 9:1–8) is subject information related to a subject of a captured image;

Safai’s CPU 210 executing software modules (*id.* at 5:63–6:1, 6:66–7:56), which associates images with addresses and stores them in a data structure that conceptually serves as an “out-box” (*id.* at 11:21–26), teaches “a processing module for associating the subject information, [and] storage location information . . . to the digital image file”; and

Safai’s communications port 214 and CPU 210 executing a transport application 230 (*id.* at 6:5–18) teach “a transmission module for transmitting the digital image file and the associated information to the external computing device for storage or data lookup.” We find that the designated server or web site (indicated by email address or URL) is an external computing device.

Patent Owner does not dispute that Safai teaches each of these limitations or offer evidence to the contrary.

b. “prompt a user to input information regarding the captured image”

The parties dispute whether Safai teaches “a display module . . . configured to *prompt a user to input information regarding the captured image*,” as recited in claim 1 (emphasis added). As explained above, after capturing an image, a user of Safai’s device has the option of navigating menus (e.g., shown in Figs. 3, 4A) using touch screen display 108 to reach address entry screen 412 (shown in Fig. 4B). Ex. 1003, 7:60–8:7, 8:21–52. Figure 4B shows an address entered into address entry field 414. Although not shown in Figure 4B, Safai states that “display 412 further includes a subject data entry field next to the address entry field 414,” that “[a] user may select the subject data entry field by tapping on it with a finger or stylus,” and that “[t]he user may enter text for the subject line using the virtual keyboard 416.” *Id.* at 9:3–8. Safai also describes a feature in which, if the user has entered an email address that is not valid, “the transport

application generates a prompt to the user that asks whether the user wishes to correct the address or discard it.” *Id.* at 10:12–16. Petitioner contends that these two examples, a display of a subject data entry field and a prompt to the user to correct an invalid address, both prompt the user to input information regarding the captured image. Pet. 10.

Patent Owner responds that Safai does not teach prompting a user for information regarding a captured image because the user must first select a transport application (shown in Fig. 4A), and then select the address button 402 among five options to reach the display that includes the address and subject data entry fields. PO Resp. 16–18. According to Patent Owner, “[t]hese selections are made by the user without any prompt by the device described in Safai.” *Id.* at 18; *see also id.* at 5 (“[I]n Safai, the user reaches the display that includes the address entry field and subject data entry field by selecting the Address button 402 among four other options 404–410 displayed in the menu 400, without any prompt. In fact the transport application that provides the menu is also launched by the user without any prompting.”), 10 (“Safai cannot prompt a user to input information regarding the captured image by merely providing the address entry screen or the subject data entry field after those screens are actually launched based on a decision by the user.”).

Petitioner replies that the visual and audio indicators to provide information described by Safai are similar to the indicators shown in the ’118 patent as prompting a user for input. Reply 5–6. According to Petitioner, “[t]hat a user must first select Address button 402 or Voice Message button 406 before any of the above prompting steps occur is

irrelevant” because “[t]he claims only require a prompt to enter information regarding an image.” *Id.* at 6.

We agree with Petitioner. As explained in Section II.B.2 above, “prompt” means “to incite or provide a cue,” and need not be automatic or without any action on the part of the user between capturing an image and prompting the user to input information. We find that in both examples described in Safai, the subject entry field and the prompt to the user to correct an invalid address are cues, provided by Safai’s system, to incite the user to enter information about a captured image. A subject, for example, is information regarding the captured image because it may explain the subject matter of the image. Likewise, an email address is information regarding the captured image because it identifies a destination for that image. Thus, we find that Safai teaches “a display module . . . configured to prompt a user to input information regarding the captured image,” as recited in claim 1.

c. “a second capture module configured to scan coded information to be associated with the captured image”

Petitioner concedes that Safai does not teach “a second capture module configured to scan coded information to be associated with the captured image,” as recited in claim 1. Pet. 13. Nevertheless, Petitioner contends that Terp’s disclosure of an image scanner, digital camera, receiver, and processor for scanning coded information (e.g., bar codes and VINs) and associating the coded information, along with digital images, with inventory item profile files, teaches this feature. *Id.* at 13–14.

According to Petitioner, in reliance on Dr. Essa's testimony, a skilled artisan would have added a second capture module to Safai's digital camera to achieve the advantage of gathering and retrieving information associated with a digital image more easily, quickly, and accurately. *Id.* at 14–15 (citing Ex. 1013 ¶¶ 43–44). Petitioner cites, in particular, Terp's disclosure that manual entry of information can be cumbersome, inefficient, and prone to error. *Id.* (citing Ex. 1004, 1:33–37).

Regarding “a processing module for associating . . . the coded information to the digital image file,” Petitioner argues that Terp describes a CPU that associates coded information (e.g., a bar code or VIN) with digital images. Pet. 17. According to Petitioner, in reliance on Dr. Essa's testimony, it would have been predictable to associate such coded information with Safai's digital images given that Safai teaches associating various other data with the digital images. *Id.* at 17–18 (citing Ex. 1013 ¶¶ 47–49).

Patent Owner makes two arguments as to why Terp does not teach “a second capture module configured to scan coded information to be associated with the captured image.” First, Patent Owner argues that “in Terp, [the] captured image does not even exist when the VIN is scanned to create a vehicle record.” PO Resp. 10. According to Patent Owner, claim 1 requires a specific order such that an image is captured by the first capture module prior to coded information being scanned by the second capture module. *Id.* at 19 n.1. Because Terp describes scanning a VIN number and creating a vehicle record before an image of the vehicle is captured, Patent Owner argues, “Terp's capture is out of order” with claim 1 and “therefore

teaches away from the claimed invention.” *Id.* at 18–19. As explained in Section II.B.3 above, however, the claim language imposes no such order on the functions performed by the components of claim 1’s device.

Accordingly, we are not persuaded by Patent Owner’s argument.

Second, Patent Owner argues that the coded information, e.g., the VIN, described in Terp is associated with a vehicle record rather than a captured image. PO Resp. 8 (“[T]he VIN is associated with the vehicle record. . . . It shall be noted that, even though the image in the vehicle record is changed, the VIN for the vehicle record remains the same, thereby proving that the VIN is associated with the vehicle record and not image.”), 10 (“VIN is associated with a vehicle record and not with a captured image.”).

In the Petition (at 16), Petitioner cites to Safai’s description that “selected images are associated with the addresses entered by the user and stored in a data structure, conceptually serving as an ‘out-box’ or output queue, that is maintained in the storage device.” Ex. 1003, 11:23–27; *see also id.* at 11:50–55 (“[T]he name of [a digitized voice information] file is stored in an object that associates the name, the names of the selected photos, and the address.”), 9:10–13 (“[T]he transport application stores the characters that were entered, for example, in a subject string variable associated with the address.”). According to Petitioner and Dr. Essa, because the addresses are associated with the images, the subject information associated with the addresses also is associated with the images. Pet. 16 (citing Ex. 1013 ¶ 46). Petitioner argues that coded information, per the teachings of Terp, would have been associated with Safai’s addresses

and, hence, the images, in the same manner as the other information described in Safai. *Id.* at 17–18.

We are persuaded by Petitioner’s argument. Patent Owner does not present any evidence or explanation to support its contention that two pieces of information (e.g., a photo and a VIN number) associated with the same record are nevertheless not associated with one another. If the association were so limited, it would exclude a preferred embodiment of the ’118 patent. *See* Ex. 1001, 5:7–16 (“[B]y example, if the digital image is recorded by the hardware device as jpg101 or tif101 or bmp101 where these descriptions indicate the name of the captured digital image, then another file will be created for each captured digital image. This file would be the information associated file. In the above example, the image jpg101 would now have an additional file called info101 (or any other name that the hardware device selects). This digital file would receive and contain the user inputted information.”), 5:67–6:6 (“The file name of each digital image file and/or associated file will be recorded in a relational database either on the user’s local computer or the Global computer network. This database will contain information on any file(s) related to each digital image including audio and video files, or other associated image files.”). In these examples, information about a digital image file and the digital image file itself are associated with one another by storing the association in a separate file or database record.

Both Safai and Terp store associations similarly to the devices and methods described in the ’118 patent. Safai teaches associating various pieces of information with each other and storing those associations in an

object or file, such that the pieces of information can be used together (e.g., emailing a photo to an address and including in the message subject information). Ex. 1003, 11:21–26, 11:49–54; *see also* Ex. 1001, 5:7–16, 5:67–6:6. Similarly, as Petitioner points out (Pet. 17), Terp teaches storing various pieces of information (e.g., images, VIN number, and vehicle price) together such that the information can be retrieved together. Ex. 1004, 4:11–17, 4:25–30, 5:1–7, 8:14–34; *see also* Ex. 1001, 5:7–16, 5:67–6:6. We find that it would have been predictable to associate coded information, as taught in Terp, to Safai’s image files in the same manner Safai describes associating other information such as addresses and subjects.

d. “a transmission module for transmitting the digital image file and the associated information to the external computing device for storage or data lookup”

Regarding “a transmission module for transmitting the digital image file and the associated information to the external computing device for storage or data lookup,” as recited in claim 1, as that language applies to the coded information as associated information, Petitioner contends that Terp teaches transmitting an image, together with coded information, to an external computing device. Pet. 19–20. According to Petitioner, Terp’s coded information, when associated with Safai’s digital images, subject information, and storage location information, would have been transmitted to the external computing device for storage and lookup along with the other information described in Safai. *Id.* at 20–21. Citing Dr. Essa’s testimony, Petitioner argues that this is a predictable combination of features that a

skilled artisan would have made to ensure that identifier data relating to digital images can be used for accessing and retrieving the associated image files. *Id.* at 20–21 (citing Ex. 1013 ¶ 52). Upon consideration of this evidence, we find that it would have been predictable to transmit coded information, as taught by Terp, along with the digital image file and any other associated information, to an external computing device for storage or data lookup.

e. The references do not teach away from the claimed invention

Patent Owner contends that Safai teaches away from a combination with Terp. Patent Owner argues that “Safai . . . indicates that one of the types of subjects being photographed as part of the ‘enjoy[able] photography’ that is distributed to ‘friends, relatives, and neighbours’ is people,” as well as “pets, sceneries, mountains, rivers, treks and gatherings.” PO Resp. 6. According to Patent Owner, in such instances of “enjoy[able] photography,” using a second capture module to scan coded information and associate it with images would be impractical and contrary to common sense, and would teach away from the claims. *Id.*; *see also id.* at 21 (“Requiring the use of a second capture module to code to scan and associate the photograph with additional information is impractical as it relates to Safai and actually teaches away from the purposes of Safai. Using the example provided in Safai, in which photos of grandchildren are being sent to the grandparent, it is hard to imagine any practical value of including a

second capture module to scan coded information about the captured image to send to friends and relatives.”).

Petitioner replies that Patent Owner is improperly attempting to limit Safai’s teachings to its examples. Reply 12–13.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant” or “if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be productive of the result sought by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Aside from attorney argument, Patent Owner has not presented any evidence that Safai’s description of using a digital camera for “enjoyable photography” (as opposed to commercial photography) would have discouraged the incorporation of coded information or that it would not have been productive of the applicant’s desired result. We note that the ’118 patent states that, in the prior art, photographs were taken for both personal and business reasons and that manual entry and organization of information was problematic in either situation. Ex. 1001, 1:21–37. The Specification then describes the invention in terms of what Patent Owner presumably would characterize as enjoyable photography. *See id.* at 7:43–8:4 (use of the invention in photography of a user’s wife and child during a trip to Las Vegas). Using Patent Owner’s logic, it would have been impractical to use the invention for the type of photography specifically described in the

preferred embodiment of the '118 patent. We are not persuaded by Patent Owner's argument.

Both Safai and Terp describe techniques for associating data with captured digital images. As Petitioner argues, Terp's associated bar code information and techniques for accessing such digital images using the bar code information made it quicker and easier to gather digital images while reducing potential inaccuracy caused by manual entry of information. Pet. 14. We find that these features of Terp would have improved Safai's device in the same manner and, thus, the combination would have been the predictable use of prior art elements according to their established functions. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

f. Patent Owner's remaining challenges to Petitioner's reasons to combine Safai and Terp

Patent Owner argues that Dr. Essa did not, in his Declaration, analyze the underlying factual determinations outlined in *Graham v. John Deere* and did not articulate reasons, with rational underpinning, for combining Safai and Terp. PO Resp. 24. According to Patent Owner, “Dr. Essa, in his deposition, was unable to articulate any factors one would need to consider

in making an obviousness determination.” *Id.* (citing Ex. 2002, 106–07).² Dr. Essa, however, was offered as a technical expert, rather than a legal expert. *Graham v. John Deere* outlines “factual inquiries” that we, as the trier of fact, must make. 383 U.S. at 17–18; *accord In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006) (“[T]o establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, *the Board* must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. In practice, this requires that *the Board* explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”) (emphasis added, internal citation and quotation marks omitted). A technical expert need not articulate the *Graham* factors to offer testimony on obviousness so long as our findings are guided by those factors. As we explain above, we have considered the evidence, including Dr. Essa’s testimony, and make our findings in the context of the *Graham* factors.

Patent Owner, citing the Board decision in *Ariosa Diagnostics v. Verinata Health, Inc.*, argues that the Petition and Dr. Essa’s Declaration are missing an analysis of the differences between the claimed subject matter and the prior art beyond singular statements that one reference is missing a

² The deposition testimony Patent Owner cites does not appear to be addressing the ’118 patent or the prior art combination at issue in this case. Nor does Dr. Essa appear to be asked to articulate factors to consider in an obviousness determination. Patent Owner may have intended to cite testimony beginning at page 88 of Exhibit 2002.

particular element of the claims. PO Resp. 25 (citing *Ariosa Diagnostics v. Verinata Health, Inc.*, Case IPR2013-00276, 2014 WL 5454541, at *7 (PTAB Oct. 23, 2014) (Paper 43), *vacated and remanded*, 805 F.3d 1359 (Fed. Cir. 2015)). As explained above, Petitioner presents detailed argument and evidence as to how Safai differs from the claimed invention, what features from Terp would have remedied those deficiencies, and why a skilled artisan would have looked to Terp to combine with Safai. Thus, we are not persuaded by Patent Owner's argument.

Patent Owner, further citing *Ariosa Diagnostics*, argues that the Petition and Dr. Essa's Declaration do not explain how a skilled artisan would have combined disparate elements of Safai and Terp or explain what modifications would have been necessary to do so. PO Resp. 26. We detail above the reasons Petitioner gives for combining Safai and Terp, as well as the testimony from Dr. Essa on which Petitioner relies. For the reasons given above, we agree with Petitioner's arguments and evidence and find that a skilled artisan would have had reason to combine Safai and Terp. Accordingly, Patent Owner's argument is unpersuasive.

Finally, Patent Owner argues that Dr. Essa, in his Declaration and deposition testimony, engaged in hindsight, using the '118 patent's disclosure to guide reconstruction of the invention from Safai and Terp. PO Resp. 26–27 (citing Ex. 1013 ¶ 43; Ex. 2002, 216–17). We agree with Petitioner (Reply 16–18), however, that Dr. Essa referenced the '118 patent only as context explaining the purpose of his testimony regarding the combination of Safai and Terp rather than as a guide to combine Safai and Terp. Accordingly, we are not persuaded by Patent Owner's argument.

In sum, we find that Safai and Terp teach each limitation of claim 1. We also find that a skilled artisan would have had reason to combine Safai and Terp.

4. Conclusion of Obviousness

a. Claim 1

As explained above, we find, based on Petitioner's evidence, that Safai and Terp teach each limitation of claim 1. We also find, based on Petitioner's evidence, that a skilled artisan would have had reasons, with rational underpinning, to combine these teachings to arrive at the invention of claim 1. We have considered Patent Owner's arguments to the contrary and find them unpersuasive. The parties do not introduce or rely on objective indicia of nonobviousness. After weighing the evidence, we conclude that Petitioner has shown, by a preponderance of the evidence, that claim 1 would have been obvious over Safai and Terp.

b. Claims 19 and 20

Independent claim 19 is a method claim in which the steps essentially track the functions of the modules recited in claim 1. Petitioner contends that claim 19 would have been obvious for the same reasons given for claim 1. Pet. 29–31. Claim 20 is similar to claim 1, except that where claim 1 recites “a second capture module configured to scan coded information to be associated with the captured image,” claim 20 recites the input module as “receiving coded information to be associated with the captured image.” Petitioner contends that this limitation of claim 20 would have been obvious

for essentially the same reason as the similar limitation of claim 1. Pet. 32–33. Patent Owner does not present separate arguments for claims 19 and 20. Rather, Patent Owner refers to its arguments regarding claim 1. PO Resp. 28–29.

For the reasons given for claim 1, on the complete record, we conclude that Petitioner has shown, by a preponderance of the evidence, that claims 19 and 20 would have been obvious over Safai and Terp.

c. Claims 2, 4–7, 9, 10, and 21

Claims 2, 4–7, 9, and 10 depend from claim 1. Claim 21 depends from claim 20. Petitioner introduces evidence and argument as to the obviousness of each of these claims. Pet. 21–29, 34–37. Patent Owner does not present separate arguments for claims 2, 4–7, 9, 10, and 21. Rather, Patent Owner argues that these claims are patentable for the reasons given for claim 1. PO Resp. 27–28. As explained above, these reasons are not persuasive. By not raising them in its Response, Patent Owner has waived any additional arguments regarding claims 2, 4–7, 9, 10, and 21. Paper 9, 3 (“The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.”). Patent Owner confirmed at the oral argument that it is Patent Owner’s position that the dependent claims stand or fall with independent claims 1 and 20. Tr. 27:23–28:3. In any case, we have considered the evidence in the Petition and are persuaded that Petitioner has shown, by a preponderance of the evidence, that claims 2, 4–7, 9, 10, and 21 would have been obvious over Safai and Terp.

D. Remaining Obviousness Grounds

Claims 3, 8, and 11–18 depend from claim 1. Petitioner has introduced evidence and argument to show the following:

claim 3 would have been obvious over Safai, Terp, and Mortimore.

Pet. 37–39;

claim 8 would have been obvious over Safai, Terp, and Cazier. *Id.* at 39–42;

claim 11 would have been obvious over Safai, Terp, and Arai. *Id.* at 42–44;

claim 12 would have been obvious over Safai, Terp, and Lin. *Id.* at 44–46;

claims 13 and 14 would have been obvious over Safai, Terp, and Mattes. *Id.* at 46–50;

claim 15 would have been obvious over Safai, Terp, Mattes, and Knowles. *Id.* at 50–52;

claims 16 and 18 would have been obvious over Safai, Terp, and Steinberg. *Id.* at 52–56; and

claim 17 would have been obvious over Safai, Terp, and Shih. *Id.* at 56–60.

Patent Owner does not present separate arguments for claims 3, 8, and 11–18. Rather, Patent Owner argues that these claims are patentable for the reasons given for claim 1. PO Resp. 27. As explained above, these reasons are not persuasive. By not raising them in its Response, Patent Owner has waived any additional arguments regarding claims 3, 8, and 11–18. Paper 9, 3. Patent Owner confirmed at the oral argument that it is Patent Owner's

position that the dependent claims stand or fall with independent claim 1. Tr. 27:23–28:3. In any case, we have considered the evidence in the Petition and are persuaded that Petitioner has shown, by a preponderance of the evidence, that claims 3, 8, and 11–18 are unpatentable on the respective obviousness grounds of unpatentability asserted by Petitioner for those claims.

III.CONCLUSION

Petitioner has demonstrated by a preponderance of the evidence that claims 1–21 would have been obvious.

IV. ORDER

For the reasons given, it is

ORDERED, based on a preponderance of the evidence, that claims 1–21 of U.S. Patent No. 7,995,118 B2 are held unpatentable; and

FURTHER ORDERED, because this is a final written decision, the parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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