

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MEMORYWEB, LLC,  
Patent Owner.

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IPR2022-00032  
Patent 9,552,376 B2

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Before LYNNE H. BROWNE, NORMAN H. BEAMER, and  
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a petition requesting *inter partes* review of claims 1–12 of U.S. Patent No. 9,552,376 B2 (Ex. 1001, “the ’376 patent”). Paper 1 (“Pet.”). MemoryWeb, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). With the Board’s authorization, Petitioner filed a Preliminary Reply (“Prelim. Reply,” Paper 10), and Patent Owner filed a Preliminary Sur-reply (“Prelim. Sur-Reply,” Paper 11).

To institute an *inter partes* review, we must determine “that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons discussed below, Petitioner has made such a showing. Thus, we institute an *inter partes* review.

### A. Related Matters

Patent Owner identifies the following related matters: *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 6-21-cv-00411 (W.D. Tex.); *MemoryWeb, LLC v. Apple Inc.*, No. 6-21-cv-00531 (W.D. Tex.); *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, No. 1-21-cv-02666 (N.D. Ill.); IPR2022-00111; PGR2022-00006; IPR2022-00033; IPR2022-00031; IPR2022-00222; and IPR2021-01413. Paper 6, 2–3 (“Patent Owner’s Updated Mandatory Notice”).

### B. The ’376 patent

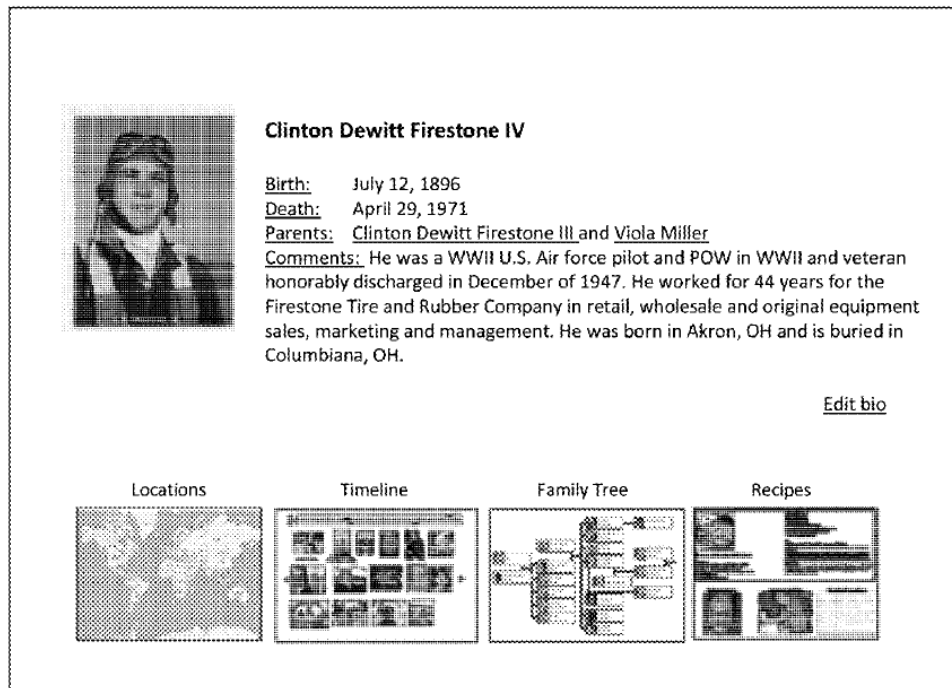
The ’376 patent relates to a platform for managing and using digital files, such as digital photographs. *See* Ex. 1001, 1:14–17. Through the platform’s interface, a user can tag and select files to create views. *See id.* at 5:26–35. For example, the “people view” is shown below. *Id.* at 6:20–26, Fig. 6.

**FIG. 6**



The people view, above, shows thumbnail photos of all the people in the system. *Id.* Clicking on the thumbnail causes a “profile view,” shown below, to be displayed. *See id.*

**FIG. 7**



The profile view, above, displays a person's image, date of birth, date of death, parents' names, and other biographical information. *Id.* The profile view also displays links to other views containing information about the person: Locations, Timeline, Family Tree, and Recipes. *Id.* at 6:27–49. The Locations view, for example, has an interactive map showing where the digital files were taken. *Id.* at 6:14–19.

### *C. Claims*

Of the challenged claims, claims 1, 5, and 12 are independent. Claim 5 is reproduced below.

5. A computer-implemented method, comprising:

storing, on one or more non-transitory computer-readable storage media, a plurality of digital files, each of the digital files having a content data portion and a metadata portion including tags, the content data including a digital photograph or image or video;

displaying, on a video display device associated with a client device, the digital photograph or image or video of a first of the digital files and overlaying thereon:

- (i) a first user selectable element, all of the digital files associated with a person tag being members of a first set of digital files, the first user selectable element having a first boundary with alphanumeric text therein indicating (i) a name of a person corresponding to the person tag and (ii) the number of digital files in the first set of digital files, and
- (ii) a second user selectable element, all of the digital files associated with a geotag being members of a second set of digital files, the second user selectable element having a second boundary with alphanumeric text therein indicating (i) a location name corresponding to the geotag and (ii) the number of digital files in the second set of digital files;

responsive to a click or tap of the first user selectable element via a user interface device of the client device, displaying a people view on the video display device, the displaying the people view including displaying (i) the name of the person corresponding to the person tag and (ii) all of the digital photographs or images or videos in the first set of digital files; and

responsive to a click or tap of the second user selectable element via the user interface device of the client device, displaying a location view on the video display device, the displaying the location view including displaying (i) the location name corresponding to the geotag, (ii) all of the digital photographs or images or videos in the second set of digital files, and (iii) a map image indicating geographic coordinates of the geotag.

Ex. 1001, 36:43–37–14.

*D. References*

| <b>Name</b> | <b>Reference</b>                          | <b>Exhibit No.</b> |
|-------------|-------------------------------------------|--------------------|
| A3UM        | Aperture 3 User Manual, Apple Inc. (2010) | 1005               |
| Belitz      | US 2010/0058212 A1                        | 1006               |
| Rasmussen   | US 7,620,496 B2                           | 1025               |

*E. Asserted Ground*

Petitioner asserts that claims 1–12 would have been unpatentable on the following ground. Pet. 4.

| <b>Claims Challenged</b> | <b>35 U.S.C. §</b> | <b>Reference(s)/Basis</b>   |
|--------------------------|--------------------|-----------------------------|
| 1–12                     | 103                | A3UM, Belitz, and Rasmussen |

II. ANALYSIS

*A. 35 U.S.C. § 325(d)*

Under 35 U.S.C. § 325(d), the Board may exercise discretion to deny a petition that presents the same or substantially the same art or arguments as were previously presented to the Office. To evaluate arguments for discretionary denial under § 325(d), the Board uses a two-part framework that considers:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.

*Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8–9 (PTAB Feb. 13, 2020) (precedential).

In applying this framework, the Board considers the following non-exclusive factors:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). Specifically, under part one of the framework in *Advanced Bionics*, the Board determines whether the same or substantially the same art or arguments previously were presented to the Office by reviewing factors (a), (b), and (d) from *Becton, Dickinson. Advanced Bionics*, Paper 6 at 10. Factor (d) relates to similar arguments being presented to the Office. *Becton, Dickinson*, Paper 8, 17–18.

A3UM, Belitz, and Rasmussen are the basis for Petitioner’s challenges. *See* Pet. These references were not the basis for any rejection made by the Examiner. *Id.* at 85. Nor were they cited to the Examiner in an Information Disclosure Statement (IDS). *Id.* Patent Owner does not dispute this. *See, e.g.*, Prelim. Resp. 13.

Patent Owner, though, asserts that the Examiner considered substantially the same art and arguments during prosecution of the application that led to the challenged patent. *Id.* at 13–26. According to

Patent Owner, the Places feature in A3UM is substantially the same as disclosures in the Kang reference that was cited in an IDS and considered during prosecution of the ‘376 patent, because “Kang describes grouping images based on location similar to the Places feature in A3UM.” *Id.* at 14 (citing Ex. 1002, 358–385, Ex. 2002, 13–14; Ex. 2001 ¶¶ 78–82).

Patent Owner makes similar arguments about Belitz and Rasmussen. *Id.* at 16–22. Patent Owner compares the features in Belitz and Rasmussen to the high-level functionality described in other references that were considered by the Examiner. *Id.* Similarly, Patent Owner argues that “[a]t a *high level*, the Petition is relying on A3UM as disclosing storing digital images including metadata including location information and displaying pins on an interactive map, and Belitz as disclosing an interactive map including thumbnails.” *Id.* at 22 (emphasis added). Patent Owner argues that this is substantially the same argument that was made by the Examiner during prosecution. *Id.* at 22–23. For example, Patent Owner argues that Petitioner combines A3UM with Belitz in the same way that the Examiner combined Kang and Jaffe:

In the April 2016 Office Action, the examiner alleged that Kang disclosed storing “a plurality of digital files . . . each of the digital files having embedded therein content data and metadata. . . the metadata including a geotag indicative of geographic coordinates where the digital photograph or image or video was taken” and that Jaffe disclosed “a representative of an interactive map . . . a first thumbnail image at a first location on the interactive map . . . [and] a second thumbnail image at a second location on the interactive map.”

*Id.* at 23 (citing Ex. 1002, 367–370); *see also id.* (discussing Jaffe and Van der Meulen).

It is undisputed that the Examiner's rejection was not based on A3UM, Belitz, and Rasmussen. Pet. 85. We disagree with Patent Owner's arguments because they primarily focus on the high-level similarities between the references in the Petition (A3UM, Belitz, and Rasmussen) and the references that were used in the Examiner's rejection. Prelim. Resp. 16–22. Patent Owner's arguments do not fully account for the specific limitations that were added to the claim in an amendment to overcome the Examiner's prior-art rejection. *See id.* Nor do the arguments fully address the specific technical features found in the combination proposed by Petitioner that are not otherwise found in the references used in the Examiner's rejection. *Id.*

After reviewing the prosecution history of the '376 patent, we agree with Petitioner that the claims were allowed after “adding requirements regarding how specific information was displayed” in the claimed user-interface elements. Pet. 85. For example, the Examiner discussed the high-level features described by Patent Owner, stating that “many systems are well known to the prior art that enable organizing, tagging, navigating, and searching collections of pictures, including pictures which have been geotagged and which may be displayed on an interactive map.” Ex. 1002, 516. Those high-level functions were clearly not the reason why the Examiner indicated that the claims contained allowable subject matter. *Id.*

So, although Kang discusses displaying photos at each location (*see, e.g.,* Ex. 2002, Fig. 5(b)), it is clear that the Examiner did not consider Kang to disclose the specific map view recited in the claim. *See* Ex. 1002, 516. Rather, an amendment directed to the map-view feature was made during prosecution, and the Examiner determined that the rejection based on Kang was overcome. *Id.* at 494–516. Petitioner, though, asserts that A3UM's

Places view discloses the claimed map view. *See, e.g.*, Pet. 38. Unlike A3UM, Kang’s “map” in Figure 9(b) consists of a collection of small icons. *See* Ex. 2002, 18–19, *cited in* Prelim. Resp. 15. And Kang’s Figure 5(b) groups photos by location but does not show a map at all. *See* Prelim. Resp. 15 (discussing and reproducing Figure 5(b)). The map in Places view and other specific teachings from A3UM cited in the Petition were not before the Examiner when the amendments to the map view were reviewed.

Thus, we find that the Petition does not present the same or substantially the same art or arguments that were previously presented to the Office. *See Becton, Dickinson*, Paper 8 at 17–18 (factors (a), (b), and (d)). Because the first part of the *Advanced Bionics* framework is not satisfied, we do not proceed to the second, and we decline to exercise discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

*B. Level of Ordinary Skill in the Art*

According to Petitioner,

A person of ordinary skill in the art in 2011 (or 2014) would have had (1) at least a bachelor’s degree in computer science, computer engineering, or electrical engineering, and (2) at least one year of experience designing graphical user interfaces for applications such as photo management systems.

Pet. 9 (citing Ex. 1003 ¶¶ 41–43).

At this stage, Patent Owner does not rebut Petitioner’s proposed skill level. *See* Prelim. Resp. 26.

For the purpose of this decision, we apply Petitioner’s proposed definition, which appears to be consistent with the level of skill reflected in the asserted reference. If Patent Owner proposes a different level of ordinary

skill in the art in its Response, the parties are encouraged to explain how the differences affect the obviousness analysis.

*C. Claim Construction*

We need only construe terms that are in controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner asserts that “[b]ecause a skilled artisan would find the challenged claims unpatentable under any interpretation consistent with their plain and ordinary meaning in the context of the ’376 patent, the Board need not expressly construe the claims.” Pet. 13.

Patent Owner does not propose constructions for any terms at this stage of the proceeding. *See* Prelim. Resp.

On the current record, no terms are in controversy. So we agree with the parties that no claim term needs to be construed here.

*D. Obviousness over A3UM, Belitz, and Rasmussen*

*1. The A3UM File Set*

All Petitioner’s challenges rely on A3UM. *See* Pet. 4. According to Petitioner, A3UM is a user manual for Apple’s Aperture 3 product that was published in two forms: an HTML file set and a PDF file. *Id.* at 14. The challenges in the Petition are based on the HTML file set. *Id.* (citing Ex. 1005). In this Decision, we refer to those files as the “A3UM file set.”

*a) Status of A3UM as a Printed Publication*

According to the testimony of Matthew Birdsell, an Apple employee, the A3UM file set “was included on the installation DVD in retail packages of Aperture 3 that were sold and distributed within the United States in early

2010 and was copied to local storage of a computer during installation of Aperture 3 ([Ex. 1020 ¶¶ 12–16]), and . . . was also published on the www.apple.com website ([*id.* ¶¶ 17–20]).” *Id.* According to Petitioner, Dr. Terveen testifies that Exhibit 1005 “is a true and correct copy of the HTML file set both on the Aperture 3 installation DVDs and as copied to computers during Aperture 3’s installation.” *Id.* at 16 (citing Ex. 1003 ¶¶ 73, 90, 97, 98). In Petitioner’s view, the Aperture 3 User Manual, Exhibit 1005, is a “printed publication that was publicly disseminated in February 2010.” *Id.* at 14.

Patent Owner argues that neither the files from the DVD nor those on Apple’s website qualify as printed publications. *See* Prelim. Resp. 29–46; Prelim. Sur-reply.

For the reasons that follow, Petitioner sufficiently shows, at this stage and on this record, a reasonable likelihood that the A3UM file set from Apple’s website qualifies as a printed publication. *See Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039, Paper 29, at 16 (PTAB Dec. 20, 2019) (precedential). Thus, at this stage of the proceeding, we need not resolve whether the A3UM file set on the DVD or installed on a computer is a printed publication.

The Board has found, at institution, that a collection of related electronic documents, such as a website with multiple webpages, could qualify as a printed publication. *Halliburton Energy Servs., Inc., v. Dynamic 3d Geosolutions LLC*, IPR2014-01186, IPR2014-01189, IPR2014-01190, Paper 13, at 15–21 (PTAB Jan. 12, 2015). In that case, the Board contrasted a single website with the collection of distinct documents at issue in *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1351–52 (Fed. Cir. 2008). *See id.*

*Kyocera* held that the GSM<sup>1</sup> technical standard at issue, which comprised a collection of standards, was not a single prior art reference. 545 F.3d at 1351. The standards included “hundreds of individual specifications drafted by approximately ten different subgroups,” and the Federal Circuit noted that “one of the most knowledgeable people in the world . . . had not read the entire [GSM] standard and did not know of any person who had read the entire standard.” *Id.* The Board in *Halliburton*, though, found that the website at issue constituted a printed publication because the website’s collection of pages described a single product from a single source, and a person of ordinary skill in the art would have readily combined the multiple pages and considered them as a whole. *Halliburton*, Paper 13 at 15–21.

For reasons similar to those in *Halliburton*, we preliminarily disagree with Patent Owner’s argument that A3UM is a compilation of “seven hundred individual HTML files,” which cannot collectively be considered a printed publication. Prelim. Resp. 29. Unlike the GSM standard in *Kyocera*, Petitioner sufficiently shows, at this stage and on this record, that the HTML files that comprise A3UM are linked by their content, source, and organization. Prelim. Reply 1–2. In particular, the manual’s files have a coherent organization and collectively function as a single document: the Aperture 3 User Manual. *See* Ex. 1005. Indeed, the text “Aperture 3 User Manual” appears in the header of each page, and “/aperture/usermanual/” appears in the URLs in the footers. *See id.* Also, the manual’s index page contains embedded hyperlinks to help the user navigate the sections. *See, e.g.,* Ex. 1003 ¶¶ 102.f, 103; Ex. 1020 ¶ 19.f; Ex. 1021, 8. Thus, at this stage

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<sup>1</sup> GSM stands for “Global System for Mobile Communications.” *Kyocera*, 545 F.3d at 1350. “The GSM standard is a comprehensive set of specifications for a second generation (‘2G’) mobile network.” *Id.*

and on this record, we determine that the A3UM file set could qualify as a single printed publication, even though it is a collection of files, provided that it is publicly accessible.

“A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). At this stage and on the current record, we also disagree with Patent Owner’s argument that the manual was not publicly accessible. *See* Prelim. Resp. 40–46; Prelim. Sur-reply 4–5. Rather, we preliminarily determine for institution that the declaration of Matthew Birdsell (Ex. 1020) sufficiently supports Petitioner’s assertions on this issue.

In particular, according to his declaration, Mr. Birdsell is currently a Content Manager at Apple. *Id.* ¶ 2. Mr. Birdsell testifies that he worked for Apple since 2002 and has been a full-time Apple employee since June 2010. *Id.* ¶ 1. Mr. Birdsell testifies that he “personally worked on Apple documentation and publications regarding each version of Aperture throughout its lifespan, including Aperture 3.” *Id.* ¶ 2. Mr. Birdsell testifies that his “professional responsibilities between January and June of 2010 included involvement with the team responsible for producing and distributing Aperture 3 documentation, including the Aperture 3 User Manual” and that he has “personal knowledge of how the Aperture 3 User Manual was prepared and distributed by Apple during this time frame.” *Id.* ¶ 3. With respect to the A3UM file set on the website, Mr. Birdsell testifies that: “Any interested member of the public could locate and view the contents of the Aperture 3 User Manual HTML file set by retrieving it from

Apple’s publicly accessible documentation site:

<http://documentation.apple.com/en/aperture/usermanual/>.” *Id.* ¶ 12.c (citing Ex. 1021, 6).

Patent Owner argues that “there is no evidence of meaningful indexing such that a skilled artisan could reasonably locate A3UM (Ex. 1005) from the Apple website.” Prelim. Resp. 44. Patent Owner argues that “[w]ithout means to search by subject matter, one would have to take several actions to locate the HTML file set on the Apple website,” and that “they would still have to ‘[c]lick links to individual sections of the Aperture 3 User Manual.’” *Id.* at 44–45. According to Patent Owner, “there would be over 700 individual webpages to navigate through.” *Id.* at 45.

Having considered the evidence of record, we preliminarily determine that the Birdsell Declaration sufficiently shows how the manual could be located through customary navigation of the website, including searching for it. Mr. Birdsell testifies that the Aperture 3 User Manual “could be located using Aperture links on the apple.com website or by searching for ‘Aperture’ or ‘Aperture 3’ in the search box at the top right corner of the apple.com landing page.” Ex. 1020 ¶ 18. Mr. Birdsell also testifies that “[t]he Aperture 3 support page on the apple.com website contained an embedded URL pointing to the Aperture 3 User Manual HTML file set (i.e., <http://documentation.apple.com/en/aperture/usermanual/>),” and that the User Manual on the Apple website had “links to individual sections of the Aperture 3 User Manual that were available on the side bar.” *Id.* ¶¶ 18, 19.f.

To be sure, “‘public accessibility’ requires more than technical accessibility.” *Acceleration Bay, LLC v. Activision Blizzard, Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018), *discussed in* Prelim. Resp. 42–43. For example, “a work is not publicly accessible if the only people who know how to find it

are the ones who created it.” *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1372 (Fed. Cir. 2019), *discussed in* Prelim. Resp. 43. On this issue, Patent Owner argues that there is “no evidence that someone interested in photo management systems would know about Aperture.” Prelim. Resp. 44. In Patent Owner’s view, the A3UM file set was not sufficiently indexed on the website, and a person could not find the file set based on its subject matter. *Id.* at 44–45.

We preliminarily determine that Petitioner provides sufficient evidence at this stage showing that others interested in photo management could have reasonably found Apple’s website and the A3UM file set. For example, Petitioner shows that there were links to purchase Aperture 3 software through Apple’s website. Pet. 14–15 (citing Ex. 1021, 2). Petitioner provides a press release for Aperture 3. Ex. 1048, *cited in* Pet. 15. Dr. Terveen testifies that “a skilled artisan interested in locating A3UM or learning about Apple’s Aperture 3 software would have been able to locate A3UM via [www.apple.com](http://www.apple.com) by simply visiting the dedicated Aperture 3 support page on Apple.com.” Ex. 1003 ¶ 101. According to Dr. Terveen, “A skilled artisan would have been provided with a straightforward path to access the web-hosted version of A3UM from the [www.apple.com](http://www.apple.com) homepage.” *Id.* ¶ 102.

Thus, from the current record, we determine that Petitioner’s position is based on more than mere technical accessibility. Rather, Petitioner has provided sufficient evidence, at this stage and for institution, that people interested in photo management systems would have been independently aware of the A3UM file set on Apple’s website (*see, e.g.*, Pet. 14–15; Ex. 1021, 2; Ex. 1048), and an interested researcher, applying reasonable diligence, would have found the A3UM file set using the search function and

the links to the support page, as described by Dr. Terveen (*see, e.g.*, Ex. 1003 ¶¶ 101–102). *See Samsung Elecs.*, 929 F.3d at 1369 (citing *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1381 (Fed. Cir. 2012)).

Patent Owner also argues that “Petitioner fails to establish that Ex. 1005 is a true and correct copy of the HTML file set allegedly accessible through Petitioner’s website” and that “there is at least one inconsistency between Ex. 1005 and Petitioner’s limited Internet Archive printouts.” Prelim. Resp. 40–41. According to Patent Owner, “Petitioner has not (and cannot) show that the hundreds of web pages allegedly comprising A3UM correspond to Ex. 1005.” Prelim. Sur-reply 5.

We note that the A3UM file set and the printout from the Internet Archive’s Wayback Machine are not identical. *Compare* Ex. 1021, *with* Ex. 1005. And Petitioner has provided only some of the pages from the Internet Archive’s Wayback Machine. *See* Ex. 1021. Mr. Birdsell, however, testifies that Exhibit 1005 “is an accurate copy of the Aperture 3 User Manual that was distributed with the initial version of the Aperture 3 product (i.e., version 3.0),” and that the Aperture 3 User Manual also existed as an interlinked set of HTML files made publicly accessible on Apple servers “where it could be retrieved and viewed by any member of the public.” Ex. 1020 ¶¶ 4, 9–10. At this stage, Mr. Birdsell’s testimony sufficiently supports Petitioner’s position.

Our decision on this issue is preliminary. We invite the parties to further address how the identified differences between the printout from Internet Archive’s Wayback Machine (Exhibit 1021) and Exhibit 1005 might affect our final decision on the patentability of the challenged claims.

We conclude that, from the current record and for the purpose of institution, Petitioner has submitted evidence sufficient to establish a reasonable likelihood that the A3UM file set on Apple’s website was publicly accessible before the critical date of the challenged patent and that the A3UM reference qualifies as a printed publication.

## 2. *Belitz*

*Belitz* is a U.S. Patent Publication that relates to a user interface that displays a map with marked locations. Ex. 1006, code (57). *Belitz* explains “[i]f many locations are located close to one another they overlap and the view of the associated images become cluttered and it is difficult to discern between the various objects and the user is not provided with a good view of what location is associated with what.” *Id.* ¶ 2. According to *Belitz*, the disclosed user interface addresses those concerns. *Id.* ¶ 5. Figures 4a and 4b, below, show screenshots of the user interface. *Id.* ¶ 51, 55.

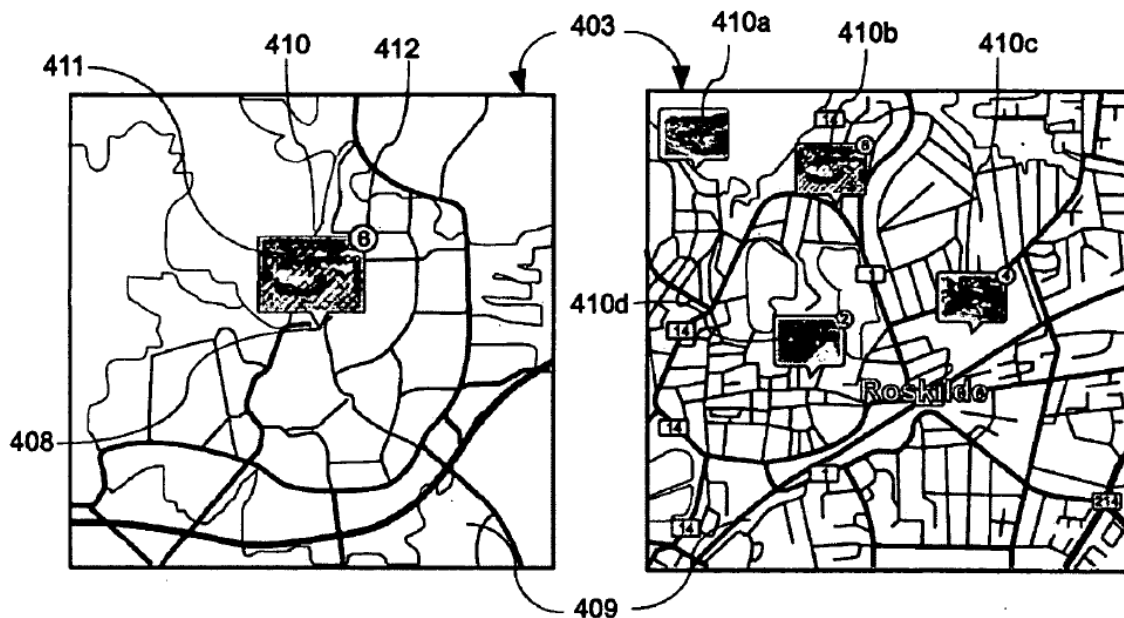


**Fig. 4a**

**Fig. 4b**

Figure 4a, above, shows map 409. *Id.* ¶ 51. On the map, location 408 is marked by a graphical object 410. *Id.* Graphical object 410 contains visual

representation 411. *Id.* ¶ 52. Visual representation 411 can be a photograph that is associated with the location. *Id.* Number indicator 412 shows how many graphical objects 410 are “stacked” at that location. *Id.* ¶ 54.

Specifically, graphical objects stacked in the displayed graphical object or graphical group object 410 can be associated with other locations that are near marked location 408. *Id.*

### 3. *Rasmussen*

Rasmussen is a U.S. Patent that describes a digital map and tools for interacting with it. Ex. 1025, 9:35–49. In one example, a user creates a measuring tool on the map by positioning endpoints at various locations. *Id.* at 9:61–65. The user clicks the endpoints or the line between them to open an information window. *Id.* at 10:17–27. The window can display “latitude/longitude and/or geocode information.” *Id.*

### 4. *Independent Claim 1*

Petitioner asserts that the subject matter recited in claim 1 is obvious over A3UM, Belitz, and Rasmussen. Pet. 26–79. Petitioner relies on A3UM’s teachings for all the limitations of claim 1 except for the thumbnail images and a “map image indicating geographical coordinates.” *See, e.g., id.* at 26. For the recited thumbnail images and coordinates, Petitioner relies on Belitz and Rasmussen in its obviousness rationale. *Id.*

Patent Owner argues that Petitioner has not shown that it would have been obvious to modify A3UM with Belitz and Rasmussen. Prelim. Resp. 48–59. For the reasons that follow, we disagree with Patent Owner at this stage and on this record.

#### a) “*thumbnail image*”

Claim 1 recites, in part, “a first user selectable thumbnail image at a first location on the interactive map corresponding to the geographic

coordinates of a first geotag.” Ex. 1001, 35:29–33. Claim 1 recites similar limitations about a second thumbnail image at a second location.

*Id.* at 35:40–44.

Petitioner asserts that, in a related proceeding, the meaning of “thumbnail image” is disputed. Pet. 26. Here, Petitioner gives “thumbnail image” its ordinary and customary meaning. *Id.* at 13. Patent Owner does not provide a construction for this term. *See* Prelim. Resp. 26–27.

According to the ’376 patent, a thumbnail image is “for previewing the picture on the camera’s LCD Screen, in file managers, or in photo manipulation software.” Ex. 1001, 11:29–31. For example, in the “Location Application View,” the thumbnails are indicators 0874 and 0875. *Id.* at 29:33–37. Figure 41, below, shows that view.

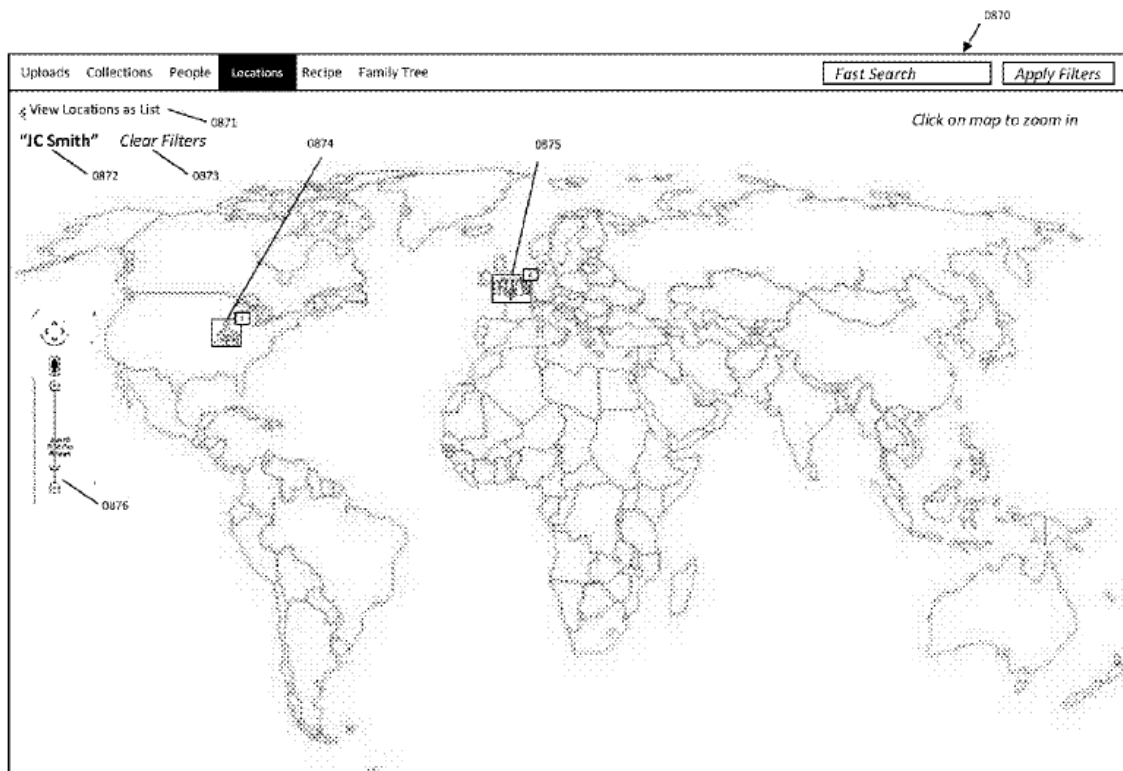


Figure 41 above shows indicators 0874 and 0875 at locations on a world map. *Id.* at 29:34–35. These indicators have a “photo thumbnail” and a

number overlaid on the upper right corner. *Id.*, Fig. 41. The user can select the “photo thumbnail” to see all the digital files with the same location. *Id.* at 29:35–36. In other views, the user selects the thumbnail images to initiate actions corresponding to the related digital files. *See, e.g.*, *id.* at 22:45–64, 24:24–41; 24:54–25:11; 27:29–53.

As part of its obviousness rationale addressing the recited “thumbnail image,” Petitioner relies on A3UM’s interactive map. Pet. 19–20. Petitioner asserts that selecting a pin on A3UM’s map displays the photos in the “Browser” shown below. *Id.* (citing Ex. 1005, 436–437).



The figure above is a screenshot of the interface described in A3UM. Ex. 1005, 437. The interface contains a map. *Id.* The map is annotated with a line identifying a “Location pin.” *Id.* A single pin might represent a group of

images “shot in close proximity.” *Id.* The bottom of the interface displays five images. *Id.* The annotation below the images says, “Images shot in the selected location.” *Id.*

According to Petitioner, Belitz suggests modifying A3UM to use photo thumbnails instead of pins in A3UM’s interactive map. Pet. 27–32. Petitioner illustrates this proposed modification in the figure below. *Id.* at 29.



Petitioner’s figure, above, is a map view from A3UM (left) with red pin markers next to a map view (right) representing the proposed combination of A3UM and Belitz. *Id.* In the figure on the right, labeled A3UM-Belitz, A3UM’s red pin markers are replaced by Belitz’s thumbnails. *Id.*

Petitioner asserts that “[a] skilled artisan would have been motivated to make this modification” because “Belitz expressly teaches that ‘it would be useful to be able to present a user with an overview of associated images to special locations which enables [a] user to clearly see the associations’” and “A3UM suggests the desirability of displaying such information in its Places interface.” *Id.* at 29–30 (quoting Ex. 1006 ¶ 4; citing *id.* ¶ 15; Ex. 1005, 81–83, 435). Petitioner asserts that “[a] skilled artisan would also have considered Belitz’s thumbnail technique to be a known and predictable

alternative to the A3UM pins,” and thumbnail images would have appealed to and potentially improved usability for some users. *Id.* (citing Ex. 1003 ¶ 130).

Patent Owner argues that “Belitz does not provide a motivation to modify A3UM,” because “Belitz is designed to only mark ‘special locations’ on a map, not an entire photo library,” and “A3UM *already* achieves Belitz’s objective of providing associations between images and locations without any modification.” Prelim. Resp. 50–51 (citing Ex. 1006, Title, ¶¶ 2, 4, 10, 19, 71; Ex. 2001 ¶¶ 119, 127; Pet. 19). In Patent Owner’s view, Petitioner acknowledges that Belitz’s thumbnails and A3UM’s push pins serve the same purpose. *Id.* at 45. Patent Owner argues that this functional overlap indicates that there is no reason to combine Belitz and A3UM. *Id.* (citing *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1369 (Fed. Cir. 2012)).

We disagree with Patent Owner’s argument on this record. To be sure, Petitioner asserts that A3UM and Belitz are similar in some ways—i.e., “both describe a scalable interactive map with user-selectable markers (pins or thumbnail images) specifying the locations of photo(s) or other digital files, and use of those markers to retrieve digital files (e.g., photos) linked to those locations.” Pet. 27 (citing Ex. 1003 ¶ 123; Ex. 1005, 30, 81–83, 429–466; Ex. 1006 ¶¶ 39, 50, 51–55, 62). But Petitioner asserts that, unlike A3UM, Belitz does not require user interaction to display the number of images at a location. *Id.* at 28. Based on Dr. Terveen’s testimony, Petitioner asserts that the proposed combination would result in an interactive map with the additional picture counts. *Id.* at 28–29 (citing Ex. 1003 ¶ 128). Thus, in at least this way, the Petition shows that Belitz’s thumbnail images provide useful functionality that A3UM’s push pins lack. *Id.*

To further support its obviousness rationale, Petitioner asserts that certain users prefer thumbnails instead of pins to identify the locations of photos on a map. *Id.* at 30 (citing Ex. 1003 ¶ 131; Ex. 1033, 4). Petitioner cites a blog post: “What’s the best Web site for geotagged photos?” *Id.* Petitioner asserts that the post’s author favors “showing thumbnails of each image on the map, not just a dot or pushpin.” *Id.* (quoting Ex. 1033, 4).

Patent Owner disagrees with Petitioner’s arguments about user preferences. Prelim. Resp. 52. In Patent Owner’s view, “other evidence submitted by Petitioner suggests that there was no demand for location-based organization at all, let alone the specific combination Petitioner is proposing.” *Id.* (citing Ex. 1045, 7; Ex. 1044, 1). Patent Owner selects quotes from Petitioner’s evidence to support its argument. *See id.* (quoting Ex. 1045, 7 (“the Faces and Places functionality are of no interest to me”); Ex. 1044, 1 (“if you just consider Faces and Places . . . [a]s flagship features, though, they’re duds”)).

We preliminarily determine that the quotes identified by Patent Owner, at most, show that some reviewers were unimpressed by the features offered by Faces and Places. *See id.* But the selected quotes are insufficient to support Patent Owner’s broad conclusion about demand generally—i.e., the evidence suggests that “there was *no demand* for location-based organization at all” *Id.* (emphasis added); Ex. 1045, 7; Ex. 1044, 1.

Nor do those quotes appear to undermine the Petition’s reasoning, at this stage and on this record, because Petitioner’s position is not that the features appeal to *every* user. Pet. 30. Rather, the Petition states “that *certain* users preferred interactive maps using thumbnails instead of pins to identify the locations of photos.” *Id.* (emphasis added). To support this assertion, Petitioner relies on Dr. Terveen’s testimony. Ex. 1003 ¶¶ 130–132, *cited in*

Pet. 30. We preliminarily determine that Dr. Terveen’s testimony on this issue (*id.*) is sufficiently supported at this stage. For example, the blog post about photo-sharing sites explains that the Picasa software has an edge over other sites because it uses “thumbnails of each image on a map” instead of a dot or pushpin. Ex. 1033, 4. Thus, we credit Dr. Terveen on this issue in reaching our decision here. *Id.*

According to Patent Owner, “the proposed combination displays the same number twice for a selected location.” Prelim. Resp. 55 (citing Ex. 2001 ¶ 125). In Patent Owner’s view, a person of ordinary skill in the art would not modify A3UM to include these duplicate numbers “because this would consume real estate on the screen and obscure more of the map.” *Id.* Patent Owner also asserts that the thumbnail images are identical for all five locations. *Id.* at 56. In Patent Owner’s view, Petitioner’s proposed modification would only obscure the map and hide information. *Id.*

At this stage, we see no reason why the images and numbers for all locations must be identical in Petitioner’s proposed combination, as Patent Owner argues. *Id.* The thumbnails in Petitioner’s diagram clearly appear to be placeholders to illustrate where the icons taught by Belitz would be. Pet. 59. For example, Dr. Terveen explains that modifying A3UM with Belitz “would result in an interactive map displaying thumbnails with picture counts at locations where digital images are located, while allowing a user to interact with the thumbnail to display the name of the location and view pictures with that location.” Ex. 1003 ¶ 128.

Also, Patent Owner’s argument here appears to assume that Petitioner’s combination requires substituting Belitz’s teachings into A3UM without further modification. Prelim. Resp. 55–56. But it is well settled that “a determination of obviousness based on teachings from multiple references

does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (citations omitted). Nor is the test for obviousness whether a secondary reference’s features can be bodily incorporated into the structure of the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Also, the record at this stage does not indicate that incorporating Belitz into A3UM without duplicating numbers and thumbnail images would have been uniquely challenging or beyond the capabilities of one of ordinary skill in the art. Rather, the preliminary record favors Petitioner’s assertion that “[a] skilled artisan thus would have considered the use of thumbnails as Belitz teaches in the A3UM interactive map to be nothing more than the predictable substitution of a known and equivalent interface element.” Pet. 32 (citing Ex. 1003 ¶ 136).

Petitioner also asserts that “[a] skilled artisan would have had a reasonable expectation of success in” modifying A3UM with Belitz because “Belitz’s thumbnail-plus picture-count location marker would serve the same functional purpose as the user-selectable pins in the A3UM interface—both identify the quantity and location of photos to the user and enable retrieval of photos at those locations” and “Belitz and A3UM also teach analogous techniques for adjusting the number of thumbnail images based on the zoom level of the interactive map.” *Id.* at 30 (citing Ex. 1003 ¶ 132; Ex. 1006 ¶¶ 54–56, 59–60, 62).

Patent Owner does not provide arguments that specifically rebut these assertions about the reasonable expectation of success. *See* Prelim. Resp. At this stage and on this record, we determine that Petitioner’s reasoning is adequately supported (Pet. 30), and we credit Dr. Terveen’s testimony on this issue (Ex. 1003 ¶ 132).

*b) Google Maps API*

Petitioner further explains that Google Maps API supports its obviousness rationale:

Further, a skilled artisan could have readily implemented Belitz's technique within A3UM because A3UM uses the Google Maps API ("GM-API") for its interactive map. EX1003, ¶133; EX1005, 434 ("Places view uses Google Maps"), 436 ("Powered by Google"), 1115. Before 2011, the GM-API enabled skilled artisans to easily implement custom map markers—particularly thumbnails of photos—and overlays on embedded Google maps with routine effort. EX1003, ¶134. EX1040, 2-11, 42-46, 51-52; EX1035, 239, 243, 276-277. A 2009 textbook, for example, provided a step-by-step guide for integrating Google Maps into websites that enable using selectable markers to retrieve and display photos from Flickr matching those locations. EX1035, 203-207, 277; EX1003, ¶135.

Pet. 31. Here, Petitioner relies on the textbook called "PHP Web 2.0 Mashup Projects" (Ex. 1035) and an Internet Archive printout about the Google Maps API (Ex. 1040). *Id.*

Patent Owner refers to these exhibits, collectively, as the Google Maps documentation. *See* Prelim. Resp. 46–47. Patent Owner argues that Petitioner has not shown that the Google Maps documentation is prior art. *Id.* According to Patent Owner, "[t]here is no evidence that either of these references was publicly accessible as of the critical date so as to qualify as a printed publication." *Id.* at 47. Patent Owner argues that "[t]he Federal Circuit has strongly suggested that it is impermissible to rely on non-prior art to demonstrate a reasonable likelihood of success in an obviousness combination." *Id.* (citing *Yeda Research & Dev. Co. v. Mylan Pharm. Inc.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018)).

The Petition, however, does not discuss “reasonable likelihood of success” in connection with the Google Maps documentation. *See* Pet. 30–31. Rather, the Petition relies on the Google Maps documentation to show that, before 2011, the Google Maps API allowed custom map markers. *Id.* at 31. And Petitioner has provided other evidence that is sufficient to support its conclusion about reasonable expectation of success at this stage. *See id.* at 30 (citing Ex. 1003 ¶ 132; Ex. 1006 ¶¶ 54–56, 59–60, 62).

Our determination is preliminary. During trial, the parties are invited to further discuss whether Petitioner relies upon the Google Maps documentation for a proper supporting role in the obviousness analysis.

Patent Owner argues that specifying an icon is complex and would have discouraged one of ordinary skill in the art from making the proposed combination. Prelim. Resp. 53–54. Patent Owner argues that the Google Maps API documentation teaches away and contradicts Petitioner’s assertion that the combination would only involve “routine effort.” *Id.* at 54.

At this stage, we disagree with Patent Owner’s characterization of the Google Maps documentation. *See id.* The cited part of Exhibit 1040 discusses browser compatibility is the reason for the complexity:

An icon specifies the images used to display a GMarker on the map. For browser compatibility reasons, specifying an icon is actually quite complex. Note that you can use the default Maps icon G\_DEFAULT\_ICON if you don't want to specify your own. *See* Ex. 1040, 40. After noting the browser-compatibility issue, the Google Maps documentation provides teachings on how to implement custom map markers. *Id.* at 42–46, 51–52, *cited in* Pet. 31. The G\_DEFAULT\_ICON is only one option. *Id.*

Patent Owner, in its Preliminary Response (53–54), does not give sufficient weight to the other parts of the Google Maps documentation that

describe the icon images (Ex. 1040, 42–46, 51–52). We do not see sufficient evidence on the record at this stage to conclude that the “browser compatibility reasons” mentioned here would have discouraged one of ordinary skill in the art from using the teachings that immediately follow the purportedly disparaging statement. *Id.* Thus, on this record and at this stage, we disagree with Patent Owner’s teaching-away argument.

Prelim. Resp. 53–54.

In sum, based on this preliminary record, we determine that Petitioner has shown that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of A3UM and Belitz as proposed in the Petition. Pet. 30.

*c) “geographic coordinates”*

Claim 1 recites, in part, “a geotag indicative of geographic coordinates” and a first and second map images “indicating the geographic coordinates of” the first and second geotag. Ex. 1001, 35:20, 35:59–60, 36:8–9.

Petitioner asserts that “indicating” means “displaying.” Pet. 33 (“The challenged claims recite ‘*indicating the geographic coordinates*,’ i.e., displaying them.”).

According to Petitioner, A3UM uses latitude-and-longitude metadata from images. *Id.* (citing Ex. 1003 ¶¶ 138–139; Ex. 1040, 42). In particular, Petitioner asserts that A3UM’s “Metadata Inspector can be configured to display customizable metadata views including (i) GPS coordinates of an image (e.g., the standardized EXIF values for GPS coordinates) and (ii) a small map below those values identifying the location of the image on the map, along with additional metadata associated with the image (e.g., location name).” *Id.* (citing Ex. 1005, 397–98). Petitioner, though, asserts

that A3UM's map pane, which corresponds to the "map image," does not itself indicate the geographic coordinates of the first and second geotag. *Id.*

Petitioner offers two distinct reasons why this would have been obvious: "First, a skilled person would consider placement of the same 'geographic coordinates' values on the Metadata Inspector pane in a different layout (i.e., overlaid on the small map) to have been a routine design choice." *Id.* at 34 (emphasis omitted). "Second, Rasmussen (EX1025) suggests such a display, and teaches displaying 'geographic coordinate' values in a callout window (215) linked to the location of a map marker on a Google Map." *Id.* (emphasis omitted).

As for the second reason, Petitioner points to Rasmussen's Figure 2, below. *Id.* at 35.

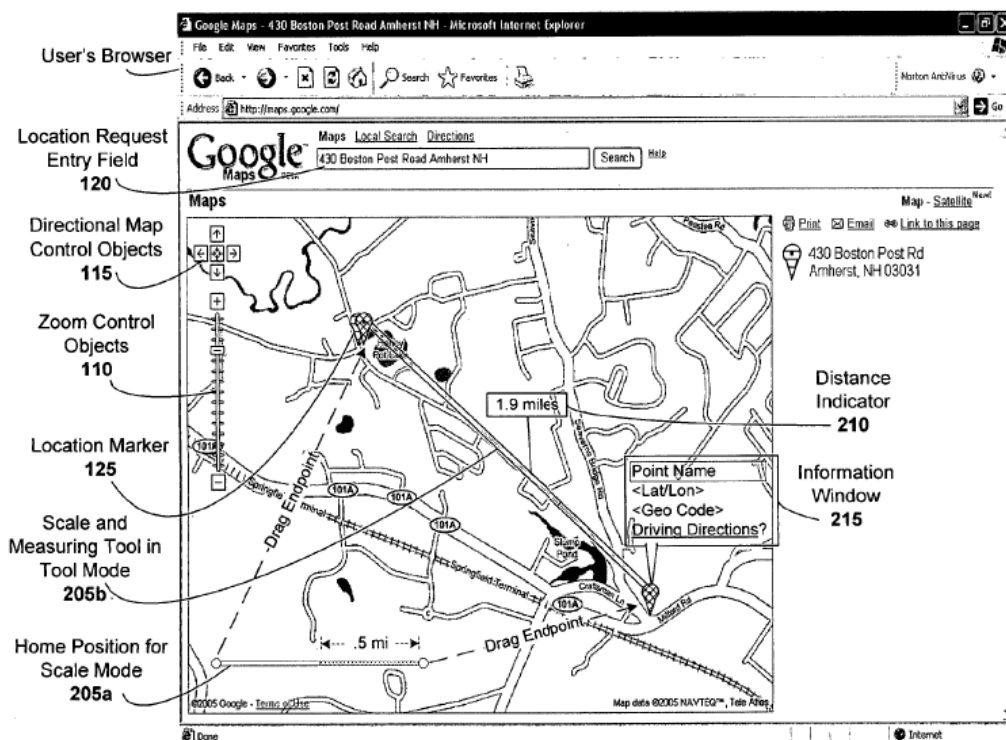


Fig. 2

Figure 2, above, shows a user-positioned measuring tool 205b between the endpoints. Ex. 1025, 9:61–65. The user clicks the endpoints or the line

between them to open an information window. *Id.* at 10:17–23. The window shows information about the map locations marked by the endpoints. *Id.* For example, this information may include “latitude/longitude and/or geocode information.” *Id.* at 10:25–27.

Petitioner proposes modifying A3UM’s Map pane to display the coordinates:

A skilled artisan would have been motivated to modify A3UM’s Map Pane marker to additionally display GPS coordinates because doing so would address known user preferences for displaying GPS data with other image metadata when using an interactive Google Map. EX1003, ¶143. A3UM suggests that certain users wish to display GPS coordinates when inspecting an image, EX1005, 397-398, and Rasmussen suggests GPS coordinates are beneficially displayed on a map marker popup window, EX1025, 10:25-29.

Pet. 35–36.

Patent Owner argues that A3UM and Rasmussen are not from the same field of endeavor. Prelim. Resp. 57. According to Petitioner, Rasmussen does not discuss digital files, such as photographs or videos, and is “wholly unrelated to digital content.” *Id.* at 57–58. In Patent Owner’s view, Rasmussen is directed to a digital map, and its purpose is to “provide more accurate and useful map scales.” *Id.* at 58 (citing Ex. 1025, 4:44–45, 1:19–20). Patent Owner views the problem addressed by A3UM as management and use of digital files and photographs. *Id.* at 59. Patent Owner argues that Rasmussen is not reasonably pertinent to this problem because it is silent about digital media. *Id.* Thus, Patent Owner argues that Rasmussen is non-analogous art under the pertinent test because (1) “Rasmussen is not from the same field of endeavor as *A3UM and Belitz*” and (2) “Rasmussen is not reasonably pertinent to the same problem that is

addressed by *A3UM and Belitz*.” *Id.* (citing *In re Clay*, 966 F.2d 656, 658-659 (Fed. Cir. 1992)) (emphasis added).

“References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to *the claimed invention*.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (citing *Clay*, 966 F.2d at 658) (emphasis added). “Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of *the inventor’s* endeavor, whether the reference still is reasonably pertinent to the particular problem with which *the inventor* is involved.” *Id.* (emphasis added). That is, cited analogous-art test asks whether the references are analogous to the claimed invention. *See id.*

Even so, on this record and at this stage, we disagree with Patent Owner that Rasmussen is from a different field of endeavor from A3UM or the claimed invention. *Id.* Instead, the preliminary record indicates that A3UM uses Google Maps, and Petitioner has shown that Rasmussen’s teachings are pertinent to map markers for Google Maps. *See* Pet. 34–35 (citing Ex. 1005, 434, 436, 1115; Ex. 1025, Fig. 2, 10:25–29). Also, the record at this stage favors Petitioner’s assertion that “Rasmussen and the ’376 patent come from the common field of displaying information via interactive digital maps . . . Rasmussen’s particular pertinence to the ’376 patent’s goal of providing ‘significant information’ to users.” *Id.* at 35 (citing Ex. 1001, 6:14-19; Ex. 1025, 1:18–19, 2:51–55, 6:14–16, 29:27–29; Ex. 1003 ¶ 142).

Thus, based on this record, we determine that Petitioner has shown that a person of ordinary skill in the art would have had sufficient reason to

combine the teachings of A3UM and Rasmussen as proposed in the Petition. *Id.* at 33–35.

*d) The Remaining Limitations*

Apart from the arguments discussed above, Patent Owner does not otherwise present substantive arguments about the remaining assertions in Petitioner’s challenge to claim 1 based on the A3UM-Belitz-Rasmussen combination. *See* Prelim. Resp. We have considered Petitioner’s evidence and arguments about the remaining limitations, as well as Dr. Terveen’s testimony. From the current record, we determine that Petitioner has sufficiently shown, for institution, that the combined teachings of A3UM, Belitz, and Rasmussen teach or suggest claimed subject matter. *See* Pet. 36–57.

Thus, Petitioner has shown a reasonable likelihood that it would prevail in its challenge to claim 1.

*5. Independent Claim 5*

The part of claim 5 that is relevant to Patent Owner’s arguments at this stage recites “the digital photograph or image or video of a first of the digital files and overlaying thereon: . . . a second user selectable element.” Ex. 1001, 36:50–65. As for the “second user selectable element,” claim 5 further recites,

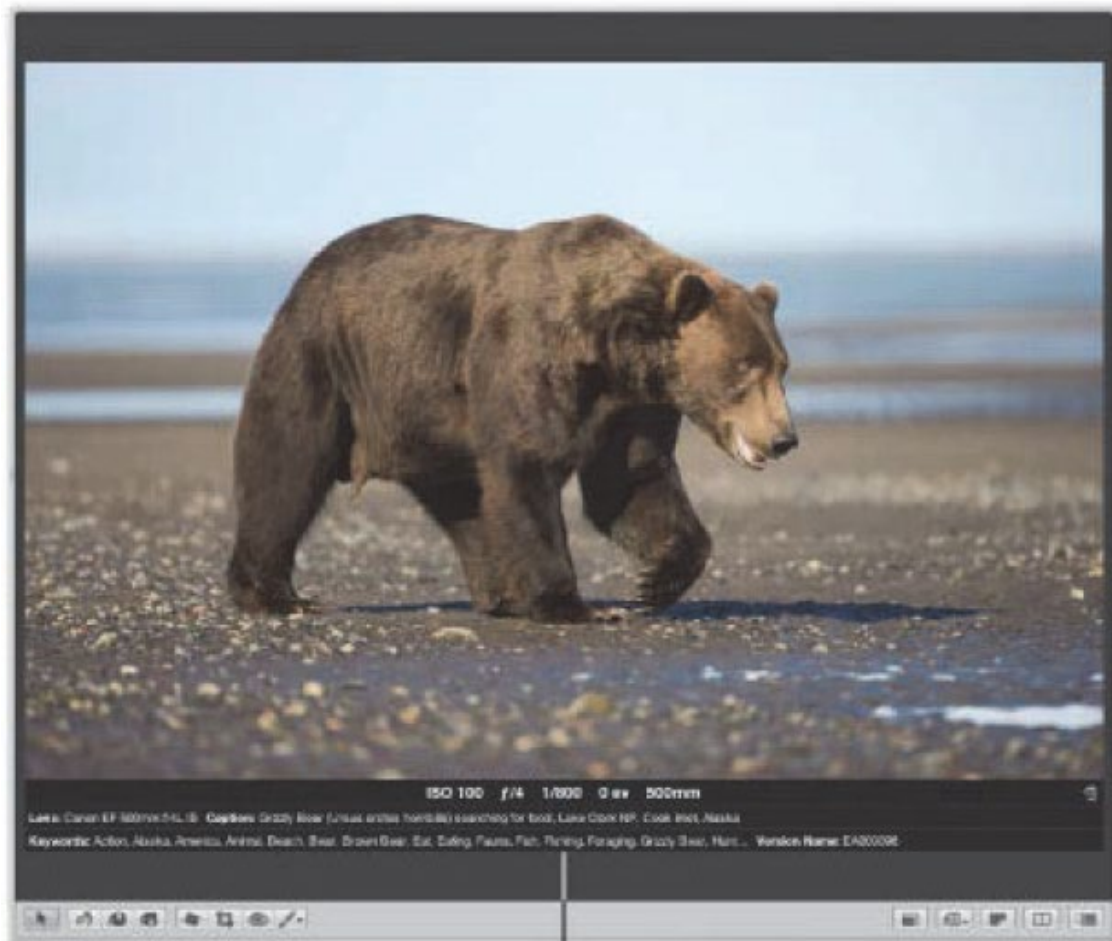
all of the digital files associated with a geotag being members of a second set of digital files, the second user selectable element having a second boundary with alphanumeric text therein indicating (i) a location name corresponding to the geotag and (ii) the number of digital files in the second set of digital files

*Id.* at 36:59–65.

Petitioner asserts that the A3UM-Belitz-Rasmussen combination teaches claim 5’s *second* user selectable element for the same reasons as

claim 3's *first* user selectable element, which recites similar limitations. Pet. 64. In its analysis of claim 3, Petitioner combines two parts of A3UM: Viewer and Places. *Id.* at 59–60.

Petitioner asserts that, A3UM's Viewer discloses a metadata overlay that include GPS coordinates and arbitrary labels. *Id.* at 59. A screenshot from the Viewer is reproduced below. Ex. 1005, 379.



An image in the Viewer  
with metadata shown in  
the expanded metadata  
overlay view

The figure above shows a photograph displayed in A3UM's Viewer. *Id.* Metadata is shown at the bottom of the viewer. *Id.* The border is labeled

with the text “An image in the Viewer with metadata shown in the expanded metadata overlay view.” *Id.* Petitioner asserts that the Viewer’s overlaid metadata label does not satisfy all the limitations to claim 3’s first selectable element. Pet. 59.

Petitioner turns to the Places map for “displaying a location label above the selected location pin” that ““indicates the name of the location and number of images’ captured there.” *Id.* at 59–60 (citing Ex. 1005, 430, 438, 443. This label is reproduced below. Ex. 1005, 430.



The figure above shows the location label with the text “Whistler Blackcomb Ski Area” and “8 photos” in A3UM’s Places. *Id.* The location label is overlaid on the map. *Id.*

Petitioner asserts that “[i]t would have been obvious to modify A3UM to display the location label on top of A3UM’s images that have location information when displayed in the Viewer.” Pet. 60. According to the Petition, “[a] skilled artisan would have been motivated to incorporate A3UM’s Places location label as an optional metadata image overlay because it was a known UI element and A3UM’s discloses supporting a wide variety of configurations.” *Id.* Petitioner asserts that the proposed

modification provides additional information and similar functionality across different parts of the product:

The location label provides additional information and functionality such as image counts and the ability to select the label and view associated pictures, which would have been desirable to a skilled artisan. . . . Moreover, it would have been obvious to provide similar functionality (the location label) when selecting a UI element representing location in one place (Viewer) compared to another (Places map).

*Id.*

Patent Owner argues that the Petition does not show how the combination teaches overlaying both a first user-selectable element and a second user-selectable element on a single digital photograph, as recited in claim 5. Prelim. Resp. 60–62 (citing Ex. 1001, 36:49–59). Patent Owner argues that the alleged “second user selectable element” is overlaid on a map, not a “digital photograph or image or video” as in the claim. *Id.* at 61 (citing Ex. 2001 ¶ 143; Ex. 1001 36:51, 36:59).

We disagree because Patent Owner’s argument does not squarely address Petitioner’s combination. *Id.* That is, Petitioner relies on a combination of teachings from both A3UM’s Viewer and Places to address the “second user selectable element.” Pet. 59–60. Under the proposed combination, the location label is displayed “on top of A3UM’s images that have location information when displayed in the Viewer.” *Id.* at 60. Patent Owner’s argument, though, focuses only on the location label shown in the Places view. *See* Prelim. Resp. 61.

Patent Owner also argues that “the alleged ‘second user selectable element’ is not overlaid on the same image, let alone in the same view, as the alleged ‘first user selectable element.’” *Id.* at 61–62 (citing Ex. 2001 ¶ 144). In Patent Owner’s view, “Petitioner is relying on different

views (i.e., a ‘Faces view’ and a ‘Places map’) to show both of the alleged user selectable elements.” *Id.* at 62.

We disagree with Patent Owner’s argument, at this stage and on this record, because it is directed to the individual teachings of A3UM’s separate views, instead of considering how those teachings work together in Petitioner’s proposed combination. *See id.* To an extent, Patent Owner acknowledges that Petitioner is relying on different views, but Patent Owner does not provide arguments or evidence specifically directed to why it would not have been obvious to combine them, for example. *See id.*

Petitioner also relies on A3UM’s Faces in the obviousness rationale. Pet. 60. In particular, the Petition states that A3UM suggests the proposed modification “through disclosure of displaying other metadata labels (e.g., Faces label) on images and allowing users to select those labels to view matching images.” *Id.* (citing Ex. 1005, 421; Ex. 1003 ¶ 214). Petitioner explains that A3UM’s Faces demonstrates the benefits of displaying metadata labels on an image:

Each Face label assigned a name will include the person’s name and a “Show Faces View” button which, when selected, will cause the “Faces browser” to appear “showing all the confirmed images of the person.” . . . A3UM thus teaches benefits from displaying labels with metadata on an image and shows that modifying A3UM to do so would require only routine skill. . . . This modification would have improved the usability of A3UM and would have been the combination of known techniques to obtain the predictable and expected benefits.

*Id.* at 61 (citations omitted). Patent Owner does not specifically rebut these assertions. *See Prelim. Resp.*

We have considered Petitioner’s evidence and arguments about claim 5, including those not specifically discussed above, as well as Dr. Terveen’s

corresponding testimony. *See* Pet. 63–66; Ex. 1003 ¶¶ 221–238. From the current record, Petitioner has sufficiently shown that the A3UM-Belitz-Rasmussen combination teaches or suggests the subject matter recited in claim 5. Pet. 63–66. We also preliminarily determine that Petitioner has shown that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of A3UM, Belitz, and Rasmussen as described in the Petition’s analysis of claim 5. *See id.*

Thus, Petitioner has shown a reasonable likelihood that it would prevail in its challenge to claim 5.

#### 6. *Independent Claim 12*

Apart from the arguments discussed above in connection with claim 1, Patent Owner does not otherwise present substantive arguments about Petitioner’s challenge to claim 12 based on A3UM, Belitz, and Rasmussen. *See* Prelim. Resp. Rather, Patent Owner refers to the arguments directed to claim 1. *See id.* at 63 (“As previously discussed, Petitioner has failed to meet its burden to show that a POSITA would combine Belitz and/or Rasmussen with A3UM.”).

We have considered Petitioner’s evidence and arguments about claim 12, and Dr. Terveen’s corresponding testimony. Pet. 73–80; Ex. 1003 ¶¶ 268–304. From the current record, Petitioner has sufficiently shown, for institution, that that the A3UM-Belitz-Rasmussen combination teaches or suggests the subject matter recited in claim 12. *See* Pet. 73–80. We also preliminarily determine that Petitioner has shown that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of A3UM, Belitz, and Rasmussen as described in the Petition’s analysis of claim 12. *See id.*

Thus, Petitioner has shown a reasonable likelihood that it would prevail in its challenge to claim 12.

7. *Dependent Claims 2–4 and 6–11*

Petitioner argues that the combination of A3UM, Belitz, and Rasmussen discloses and teaches the recited limitations of dependent claims 2–4 and 6–11. *See* Pet. 57–63, 66–73. Petitioner provides Dr. Terveen’s testimony in support of its position. *See* Ex. 1003 ¶¶ 205–220, 239–267.

Patent Owner does not separately address Petitioner’s evidence or arguments directed to dependent claims 2–4 and 6–11. *See* Prelim. Resp. Rather, Patent Owner argues that “[b]ecause Petitioner has failed to show that A3UM, Belitz and Rasmussen render obvious independent claim 1 or 5, it also fails to meet its burden for the dependent claims.” *Id.* at 63 (citing *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009)).

We have considered Petitioner’s evidence and arguments about claims 2–4 and 6–11, and Dr. Terveen’s corresponding testimony. Pet. 57–63, 66–73; Ex. 1003 ¶¶ 205–220, 239–267. From the current record before us, Petitioner has sufficiently shown, for institution, that that the A3UM-Belitz-Rasmussen combination teaches or suggests the subject matter recited in claims 2–4 and 6–11. *See* Pet. 57–63, 66–80. We also preliminarily determine that Petitioner has shown that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of A3UM, Belitz, and Rasmussen as described in the Petition’s analysis of these claims. *See id.*

### III. ORDER

It is

ORDERED that, under 35 U.S.C. § 314(a), an *inter partes* review of claims 1–12 of the '376 patent is instituted for all grounds in the Petition; and

FURTHER ORDERED that, under 35 U.S.C. § 314(a), *inter partes* review of the '376 patent is instituted on this Decision's entry date, and under 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the trial's institution.

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