

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00033
Patent 10,423,658 B2

Before LYNNE H. BROWNE, NORMAN H. BEAMER, and
KEVIN C. TROCK, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 1 (“Pet.” or “Petition”)) requesting institution of an *inter partes* review of claims 1–15 of U.S. Patent No. 10,423,658 B2 (Ex. 1001, “the ’658 Patent”). MemoryWeb, LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Additionally, on April 4, 2022, we authorized Petitioner to file a preliminary reply, limited solely to addressing whether the Aperture 3 User Manual (A3UM) (Ex. 1005) qualifies as a printed publication; we further authorized Patent Owner to file a preliminary sur-reply, limited solely to addressing Petitioner’s arguments and evidence presented in the reply brief. Paper 9, 2–3. Petitioner timely filed a Preliminary Reply (Paper 10, “Prelim. Reply”) and Patent Owner timely filed a Sur-reply to Petitioner’s Reply (Paper 11, “Prelim. Sur-reply”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition and any response thereto shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition and the evidence of record, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in challenging at least one of claims 1–15 of the ’658 Patent as unpatentable under the grounds presented in the Petition. Pursuant to § 314, we hereby institute an *inter partes* review as to the challenged claims of the ’658 Patent.

A. *Real Parties in Interest*

In its Petition and most recently updated Mandatory Notices, Petitioner identifies itself, Apple Inc., as the only real party-in-interest. Pet. 2; Paper 6, 1. In its original and most recently updated Mandatory

Notices, Patent Owner identifies itself, MemoryWeb, LLC, as the only real party in interest. Paper 3, 2; Paper 7, 2.

B. Related Matters

The parties state that the '658 Patent is related to the following U.S. Patents: 9,098,531 ("the '531 Patent"); 9,552,376 ("the '376 Patent"); 10,621,228 ("the '228 Patent"); 11,017,020 ("the '020 Patent"); 11,163,823 ("the '823 Patent"), and 11,170,042 ("the '042 Patent"). Paper 6, 1; Paper 7, 2. The parties further state that the '658 Patent is related to pending U.S. Patent Application 17/459,933. Paper 6, 1; Paper 7, 3.

The parties identify the following as related district court matters:

- *MemoryWeb, LLC v. Apple Inc.*, No. 6:21-cv-00531 (W.D. Tex.);
- *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 6:21-cv-00411 (W.D. Tex.); and
- *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, No. 1:21-cv-02666 (N.D. Ill.).

Paper 6, 1–2; Paper 7, 2.

Further, the parties identify the following petitions that the related patents are the subject of:

- *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413 ('228 Patent);
 - *Samsung Electronics Co., Ltd., v. MemoryWeb, LLC*, IPR2022-00222 ('228 Patent);
 - *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 ('228 Patent);
 - *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 ('376 patent);
 - *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00111 ('020 patent);
- and

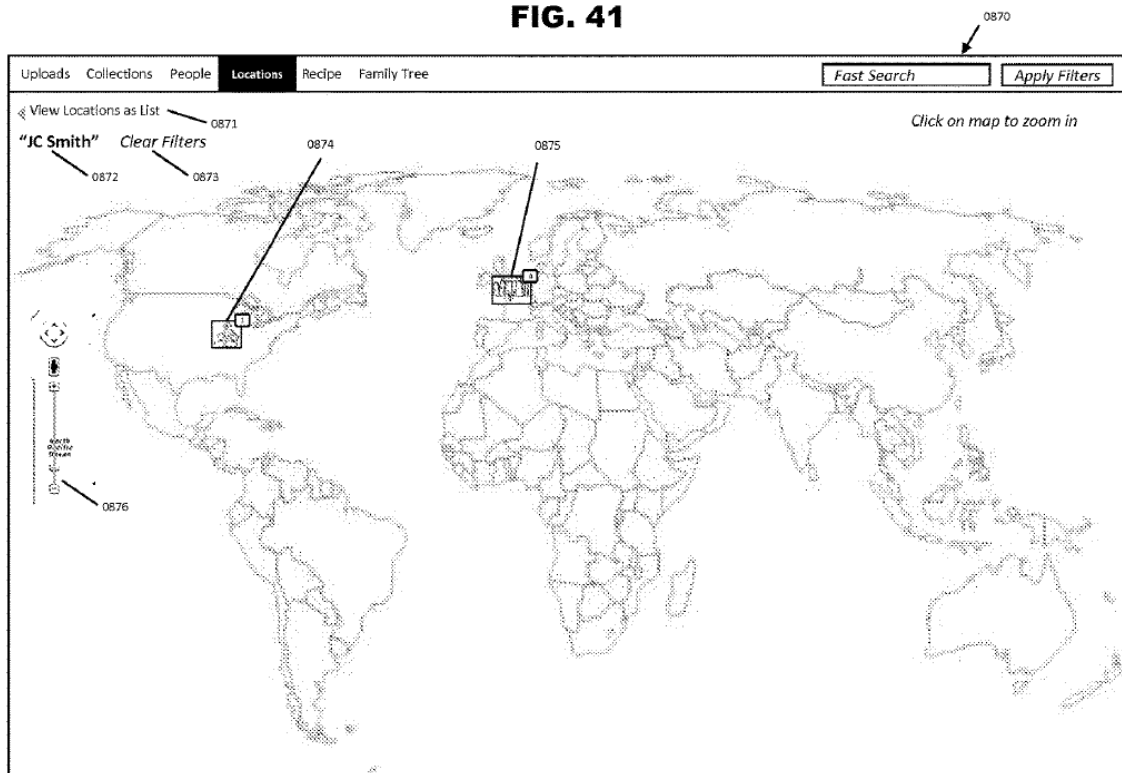
- *Apple Inc. v. MemoryWeb, LLC*, PGR2022-00006 (‘020 patent).

Paper 6, 1; Paper 7, 2–3.

C. The ‘658 Patent

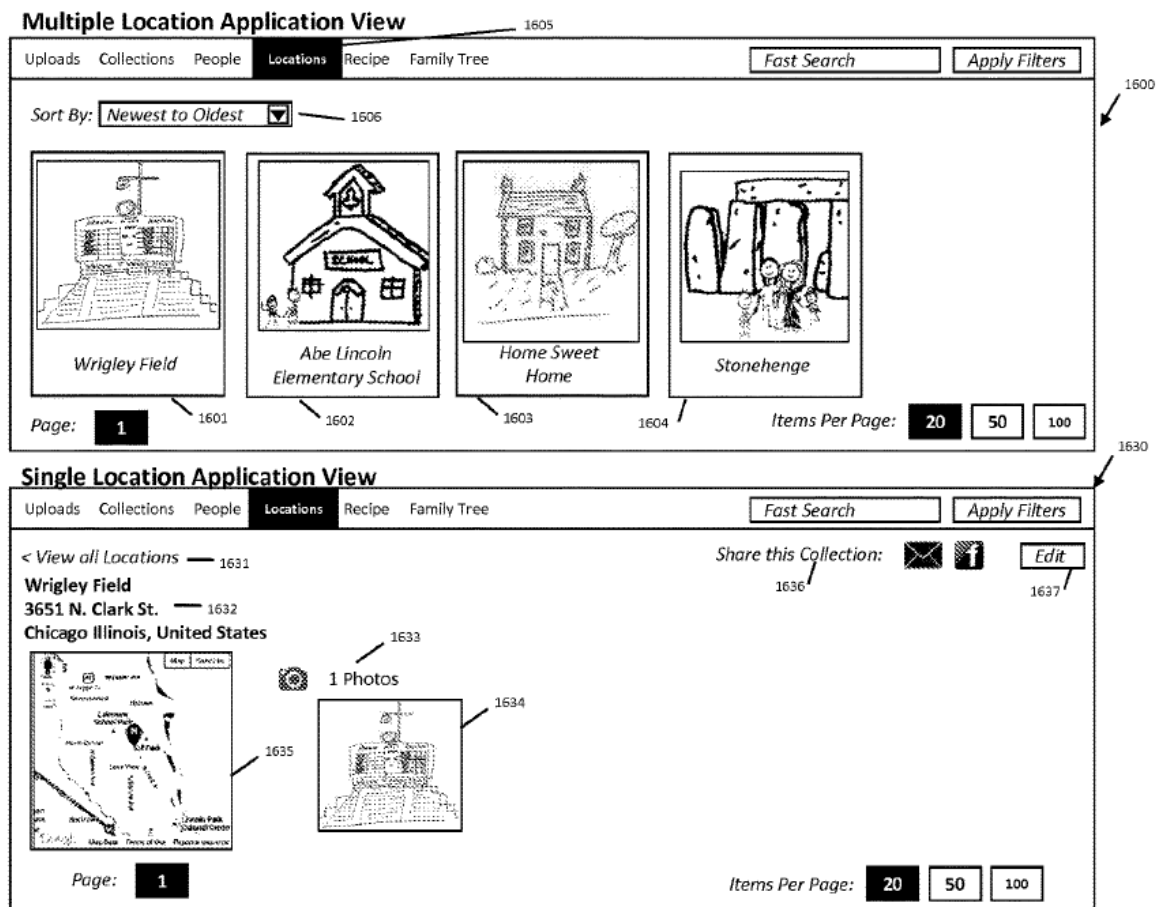
The ‘658 Patent relates to a computer-implemented system and method for managing and using digital files such as digital photographs. Ex. 1001, 1:16–19. In particular, the ‘658 Patent aims to provide an “interactive platform” for users to gather, organize, view, navigate, search, share and archive Digital Files, e.g., digital photographs and videos. *Id.* at 13:12–18, 13:56–59. The interactive platform may be provided via an “Application” having various “Application Views” for interaction with and organization of Digital Files. *Id.* at 8:59–9:7. A screenshot of an exemplary type of Application View, a “Location Application View,” is shown in Figure 41, reproduced below. *Id.* at 4:3–4.

FIG. 41



As shown in the Location Application View interface of Figure 41, “Digital Files are displayed within an interactive map (Google map shown as an example).” *Id.* at 29:25–29. Further, “[i]n this view, individual or groups of Digital Files are illustrated as photo thumbnails (see indicators 0874 and 0875) on the map and the user can select the thumbnail to see all the Digital Files with the same location.” *Id.* at 29:32–36. In the case that the user selects either one of the thumbnails, a “Single Location Application View” interface corresponding to the location is presented to the user, as shown in the bottom portion of Figure 34, a screenshot reproduced below. *Id.*

FIG. 34

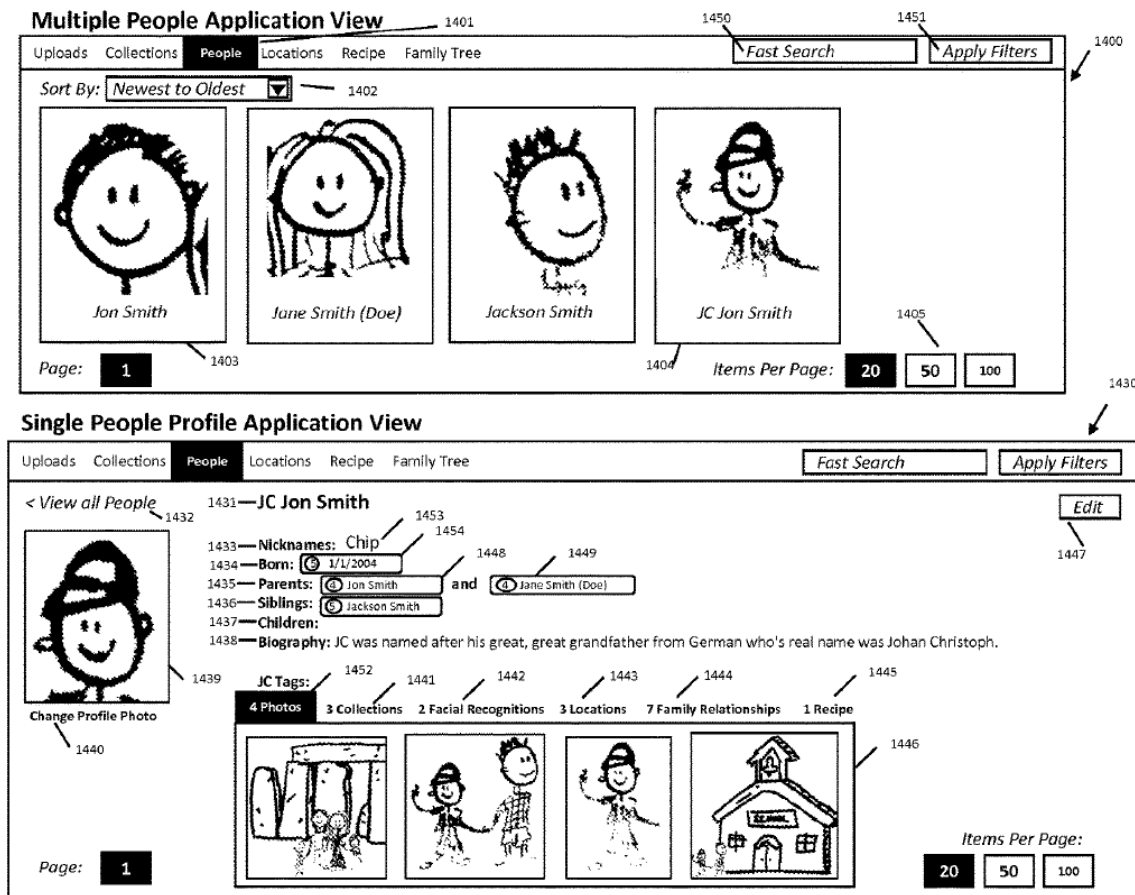


Focusing on the single location (1630) Locations Application View, an “individual location name is displayed at the top of the page (1632).” *Id.*

at 24:22–24. The single location Locations Application View further displays “[t]humbnails of each Digital File within the specific collections” of digital files. *Id.* at 24:25–26; *see id.* at 23:56–59, Fig. 33. In the example shown in Figure 34, “one photo (1633) taken at Wrigley Field (1634) that is associated with the location called Wrigley Field” is displayed. *Id.* at 24:26–28.

Turning to another Application View described by the ’658 Patent, a “Multiple People Application View” is shown in Figure 32, a screenshot, reproduced below. *Id.* at 3:58.

FIG. 32



The Multiple People Application View “can be seen by selecting ‘People’ (1401) from any of the Application Views within the Application.” *Id.* at 22:46–48. As shown in Figure 32, “Multiple People Application

View” 1400 “display[s] all the people that were created within the user's Application.” *Id.* at 22:44–46. “For each person, a thumbnail of their face along with their name is depicted. In this figure, Jon Smith (1403) and JC Jon Smith (1404) along with some other people are illustrated.” *Id.* at 22:52–55.

Further, “[f]or each person,” there are “tags that are associated to [that] person.” *Id.* at 23:4–6. In “Single People Profile Application View” 1430, associated tags are used show that there are, e.g., “four photos (1452) associated with that person.” *Id.* at 23:6–9. In another example, the person “grandma” has been tagged in, and so, is associated with, 100 photos. *Id.* at 24:56–59. Put another way, Digital Files have tags, e.g., in a “Tag Block of the Relationship Table for the Digital File,” which associate a particular digital file with a particular person or otherwise characterizes and documents the digital file. *See id.* at 20:1–6; 24:42–52.

D. Illustrative Claims

Petitioner challenges claims 1–15. Claim 1 is the only independent claim. Claim 1 is reproduced below.

1. A computer-implemented method of displaying at least a portion of a plurality of (i) digital photographs, (ii) videos, or (iii) a combination of (i) and (ii), each of the digital photographs and videos being associated with a geotag indicative of geographic coordinates where the respective digital photograph or video was taken, the method comprising:

displaying an application view on a video display device including displaying a plurality of selectable elements, the plurality of selectable elements including a location selectable element;

responsive to a click or tap of the location selectable element, displaying a map view on a video display device, the displaying the map view including displaying:

- (i) a representation of an interactive map;
 - (ii) a first location selectable thumbnail image at a first location on the interactive map, the first location being associated with the geographic coordinates of a first geotag, a first set of digital photographs and videos including all of the digital photographs and videos associated with the first geotag;
 - (iii) a first count value image partially overlapping the first location selectable thumbnail image, the first count value image including a first number that corresponds to the number of digital photographs and videos in the first set of digital photographs and videos;
 - (iv) a second location selectable thumbnail image at a second location on the interactive map, the second location being associated with the geographic coordinates of a second geotag, a second set of digital photographs and videos including all of the digital photographs and videos associated with the second geotag; and
 - (v) a second count value image partially overlapping the second location selectable thumbnail image, the second count value image including a second number that corresponds to the number of digital photographs and videos in the second set of digital photographs and videos;
- responsive to a click or tap of the first location selectable thumbnail image, displaying a first location view on the video display device, the displaying the first location view including displaying (i) a first location name associated with the first geotag and (ii) a scaled replica of each of the digital photographs and videos in the first set of digital photographs and videos, the displayed scaled replicas of each of the digital photographs and videos in the first set of digital photographs and videos not being overlaid on the interactive map; and
- responsive to a click or tap of the second location selectable thumbnail image, displaying a second location view on the video display device, the displaying the second location view including displaying (i) a second location name corresponding to the second geotag and (ii) a scaled replica of each of the digital

photographs and videos in the second set of digital photographs and videos, the displayed scaled replicas of each of the digital photographs and videos in the second set of digital photographs and videos not being overlaid on the interactive map.

Ex. 1001, 35:13–36:7.

E. Evidence

Petitioner relies upon the following evidence:

- (1) Aperture 3 User Manual, Apple Inc. (2009) (“A3UM”) (Ex. 1005);
- (2) U.S. Publication No. 2010/0058212 A1, published Mar. 4, 2010 (“Belitz”) (Ex. 1006);
- (3) U.S. Patent. No. 7,620,496 B2, issued November 17, 2009 (“Rasmussen”) (Ex. 1025); and
- (4) Declaration of Dr. Loren Terveen (Ex. 1003).

Patent Owner relies upon the following evidence:

- (1) Declaration of Rajeev Surati, Ph.D. (Ex. 2001);
- (2) Hyunmo Kang, et al., *Capture, Annotate, Browse, Find, Share: Novel Interfaces for Personal Photo Management*, 23(3) International Journal of Human-Computer Interaction, 315–337 (2007) (“Kang”) (Ex. 2002);
- (3) Alexandar Jaffe et al., *Generating Summaries and Visualization for Large Collections of Geo-Referenced Photographs*, MIR’06 (2006) (“Jaffe”) (Ex. 2003).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–15 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5–15	103	A3UM, Belitz

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
3, 4	103	A3UM, Belitz, Rasmussen

II. ANALYSIS

A. Discretionary Denial of Institution under 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. “[T]he art and arguments must have been previously presented to the Office during proceedings pertaining to the challenged patent.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). *Advanced Bionics* provides examples of “proceedings pertaining to the challenged patent.” “The proceedings in which the art was previously presented include, for example: examination of the underlying patent application, reexamination of the challenged patent, a reissue application for the challenged patent, and AIA post-grant proceedings involving the challenged patent.” *Id.* at 8.

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, Paper 6 at 8–9 (footnote omitted).

1. Part One of the Advanced Bionics Framework

Patent Owner asserts that “the references in the Petition are substantially the same as references that were considered during prosecution of the ‘658 patent.” Prelim. Resp. 10. According to Patent Owner, “[t]he 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 ‘658 patent and during prosecution of the parent ‘426 application,” because “Kang describes grouping images based on location similar to the Places feature in A3UM.” *Id.* at 12 (citing Ex. 1002 ¶ 186, Ex. 1016, 358–386; Ex. 2002, 13–14; Ex. 2001 ¶¶ 82–84).

Petitioner contends that A3UM pertains to videos in addition to photos and that this is the feature Patent Owner relied upon to obtain allowance of the ‘658 patent. Pet. 89. We have reviewed the prosecution history on the ‘658 patent and agree with Petitioner that the ‘658 patent was allowed after entry of an examiner’s amendment amending the independent claims to require videos as well as photographs. Ex. 1002, 167–173. Although Kang discusses video collections as presenting additional challenges (Ex. 2002, 335), it is clear that the Examiner did not consider Kang to disclose photographs and videos as claimed in the ‘658 patent in that the Examiner proposed adding limitations requiring both photographs and videos to distinguish over the prior art. Ex. 1002, 173–174. A3UM, as will be discussed in further detail in Section II.D.2.a below, does disclose these features. Thus, A3UM is not substantially the same as Kang.

Patent Owner asserts further that “Jaffe is substantially the same as Belitz,” because both references show an interactive map with first and second thumbnail images. Prelim. Resp. 15. Even if, however, we accept Patent Owner’s assertion that Belitz is substantially the same as Jaffe, that

does not mean that the Petition relies on substantially the same prior art that was previously presented to the Office because Belitz is presented in combination with A3UM which discloses the feature relied upon to obtain allowance of the '658 patent. Patent Owner also asserts that “the combination of Jaffe, Hibino, and Tanaka is substantially the same as Belitz as applied in the Petition.” *Id.* at 16–17 (citing Ex. 2001 ¶¶ 104–105). This argument is unconvincing for the same reason.

To the extent that Patent Owner asserts that the Petition relies on substantially the same arguments as previously presented, we disagree as no arguments pertaining to videos, the feature relied upon to obtain allowance of the '658 patent, were made.

For these reasons, we find that the Petition does not present the same or substantially the same art or arguments that previously were presented to the Office. Because we find that neither of the conditions of Part One of the *Advanced Bionics* framework is satisfied, we do not proceed to Part Two of the framework. Accordingly, 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

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends that 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 in the proceeding, Patent Owner does not contest Petitioner’s contention. *See* Prelim. Resp. 18.

Based on the record presented, including our review of the ’658 patent and the types of problems and solutions described in the patent and the cited prior art, we adopt Petitioner’s assessment of the level of ordinary skill in the art and apply it for purposes of this Decision.

C. Claim Construction

For petitions filed on or after November 13, 2018, the “broadest reasonable interpretation” standard has been replaced with the federal court claim construction standard that is used to construe a claim in a civil action under 35 U.S.C. § 282(b). This is the same claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny.

Under *Phillips*, claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir.

2017) (in the context of an *inter partes* review, applying *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner states that “the Board need not expressly construe the claims.” Pet. 12–13. Patent owner “agrees that the claims can be afforded their plain and ordinary meaning and that no construction is necessary.” Prelim. Resp. 18.

For purposes of this Decision, we determine that no claim terms require express construction. *See Vivid Techs.*, 200 F.3d at 803 (holding that only terms that are in controversy need to be construed, and “only to the extent necessary to resolve the controversy”).

D. Patentability Challenges

As indicated above, Petitioner presents a first ground challenging the patentability of claims 1, 2, and 5–15 of the '658 Patent under 35 U.S.C. § 103(a) as obvious over the combination of A3UM and Belitz. Pet. 3. Petitioner's second ground challenges the patentability of claims 3 and 4 of the '658 Patent under 35 U.S.C. § 103(a) as obvious over the combination of A3UM, Belitz, and Rasmussen.

1. Principles of Law: Obviousness

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented 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.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness,

i.e., secondary considerations.¹ *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

The Supreme Court has made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. Reaching this conclusion, however, requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Id.*

2. *Relevant Prior Art*

a) *A3UM (Ex. 1005)*

A3UM is a user manual for Apple’s Aperture software product, showing a copyright date of 2009. Ex. 1005, 3. Petitioner asserts that A3UM is prior art under pre-AIA 35 U.S.C. § 102(b). Pet. 12.

A3UM explains that the Aperture software product (“Aperture”) is a “digital image management system that can track thousands of digital images and provides . . . image management and adjustment tools” and allows the user to “work with high-quality JPEG, TIFF, and RAW image

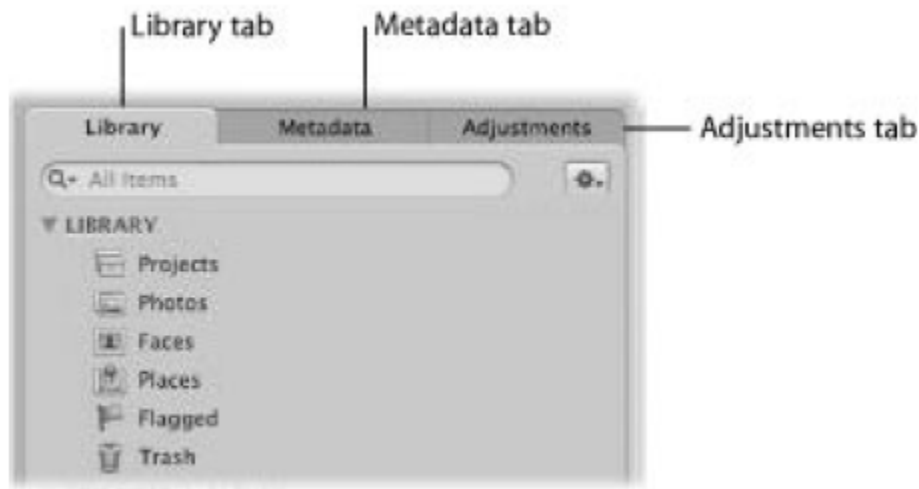
¹ The current record does not present or address any evidence of nonobviousness.

files-and even HD video files.” Ex. 1005, 1–2. A3UM states that Aperture organizes “photos, audio clips, and video clips.” *Id.* at 21. A3UM “describes the Aperture interface, commands, and menus and gives step-by-step instructions for creating Aperture libraries and for accomplishing specific tasks.” *Id.* at 3. One particular Aperture interface is the Aperture main window, reproduced below in an Aperture main window screenshot. *Id.* at 46.



The Aperture main window shows various interface features including an “Inspector pane,” a “Toolbar,” a “Viewer,” a “Browser,” and a “Vault pane.” *Id.* The Browser displays “thumbnail images contained in a folder, project, or album.” *Id.* at 47. In this example, a “single row of thumbnails” is displayed. *Id.* at 47–48. The Browser also displays “video files [imported] into Aperture.” *Id.* at 271. Next, the Viewer shows selected

thumbnails from the Browser at full size, or allows side-by-side image comparison. *Id.* at 51. If video items were selected from the Browser, the Viewer can display those videos. *Id.* at 271. Further, the Inspector pane provides access to a Library inspector, via its Library tab, reproduced in an Inspector Pane screenshot below. *Id.* at 54.



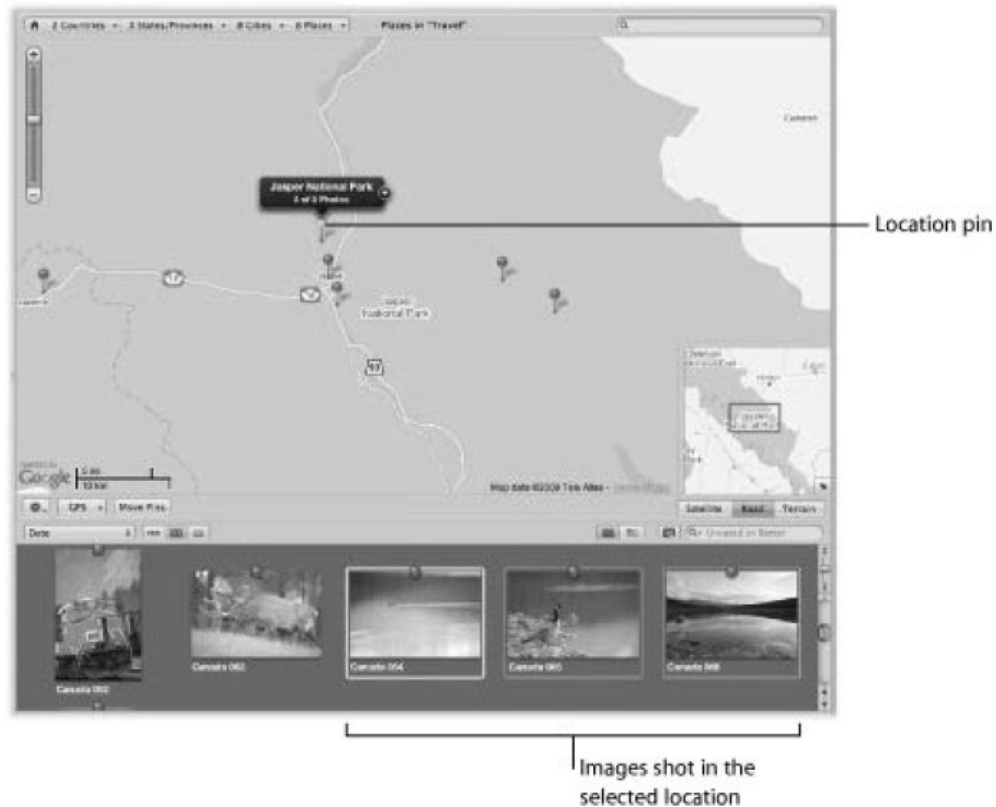
“The Library inspector holds containers—projects, folders, and albums—” which are used to organize images. *Id.* at 55. When a particular “project, folder, or album in the Library inspector” is selected, “the images are displayed in the Browser and Viewer.” *Id.* Further, the “Library inspector also provides a number of ways to view items in the library” and provides access to additional Aperture interface views, such as a Places view and a Faces view. *Id.* Those additional views are accessed by selecting the Places or Faces item in the Library inspector (as shown in the Inspector Pane screenshot) or by selecting the Places or Faces button in the toolbar (as shown in the Aperture main window screenshot). *Id.* at 81, 424.

The Places view “automatically plots the location of each image on [a] map” and provides “images associated with a location.” *Id.* at 435–436. That is, the Places view organizes “images by the locations where they were

taken” and “categorizes the images by location and coverts” the location to “place names, such as Vancouver, Canada.” *Id.* at 30. A screenshot of one exemplary Places view, within the overall Aperture main window, is reproduced below. *Id.*



Another exemplary screenshot of the Places view showing “location pins [to] mark the locations where images or groups of images were shot” is reproduced below. *Id.* at 436–437.

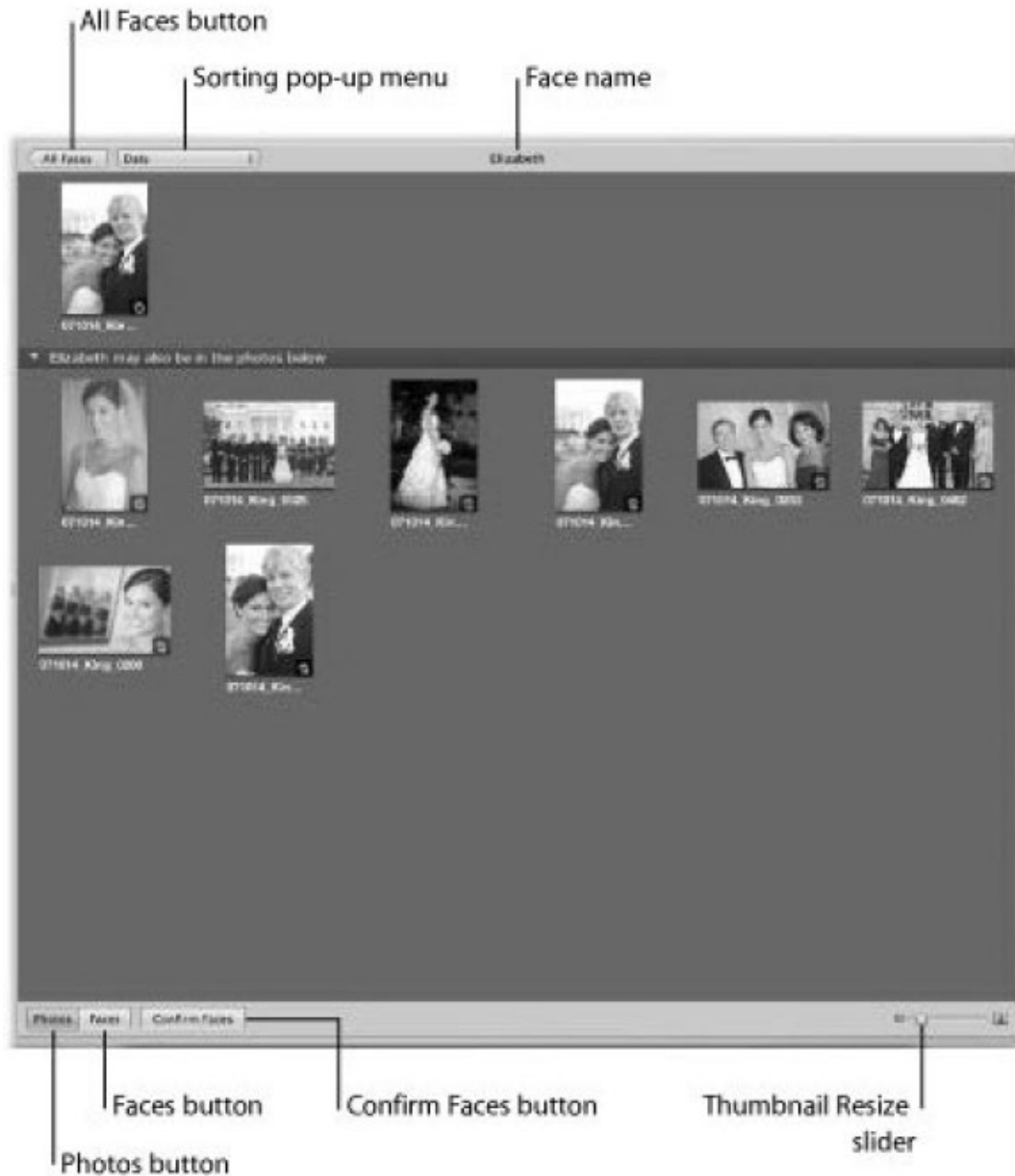


As shown above, “location pins mark the locations where images or groups of images were shot.” *Id.* at 436–437. In particular, the screenshot shows a location pin having a text callout indicating that number of photos were taken at a national park. When a pin is selected, “the image or images associated with the location marked by the [selected] pin are selected in the Browser.” *Id.* at 436.

Turning to the Faces view, the Faces view “show[s] all the photos of people with assigned names in the Aperture library.” *Id.* at 78. A screenshot of the Faces view, within the overall Aperture main window, showing images of people with assigned names, is reproduced below. *Id.* at 29, 78.



By selecting a “person’s snapshot in Faces view,” Aperture displays “all of the images in [the] library in which a person appears.” *Id.* at 29, 79. A screenshot of all the images of a selected person is reproduced below. *Id.* at 79–80; *see id.* at 29.



As shown above, “all the confirmed images of that person appear at the top of the Faces browser, and all the suggested images of the person appear in a separate section below the confirmed images.” *Id.* at 79–80. The suggested images of the person are determined in an automated process which uses “face detection and face recognition technology” to suggest images corresponding to a named person. *Id.* at 417–419. Those suggested images

can be confirmed as matches for the named person by selecting the “Confirm Faces” button. *Id.* at 80, 419. Alternatively, an image can have a name manually assigned to it. *Id.* at 421–422.

b) *Prior Art Status of A3UM*

Patent Owner asserts that Petitioner “has not meet its burden to demonstrate that the hundreds of HTML files that make up A3UM were a publicly available printed publication.” Prelim. Resp. 19. Petitioner disagrees, and argues that “[e]xtensive evidence establishes that A3UM (EX1005) was a printed publication that was publicly disseminated in February 2010,” and thus qualifies as prior art to the ’658 patent. Pet. 12.

“[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent, and therefore that there is a reasonable likelihood that it qualifies as printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). “Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *Id.* at 10 (quoting *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016)). “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.” *Hulu* at 10–11 (quoting *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)).

Here, Petitioner submits evidence that A3UM, Apple's Aperture 3 User Manual (Ex. 1005) was publicly available and publicly disseminated as early as February 2010.² Petitioner provides the declaration of Mr. Matthew Birdsell (Ex. 1020), a Content Manager at Apple, who testifies that he worked for Apple since 2002 and has been a full-time Apple employee since June 2010. Ex. 1020 ¶ 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." Ex. 1020 ¶ 3. Mr. Birdsell also testifies that "[i]n connection with the release of the Aperture 3 product, Apple produced and publicly distributed a comprehensive user manual describing the features and operation of the Aperture 3 product, which was called the Aperture 3 User Manual. Apple distributed the Aperture 3 User Manual on the physical media in the Aperture 3 retail product and through the Apple.com website."

² The '658 patent has a filing date of December 12, 2016, but also indicates that it is related to application No. 13/157,214 filed on June 9, 2011. Ex. 1001, codes 22, 63. Petitioner acknowledges that the earliest filing date claimed by the '658 patent is June 9, 2011, but advises that "Patent Owner has represented in related litigation that claims 1–5, and 7–15 are only entitled to a priority date of February 28, 2014." Pet. 8 (citing Ex. 1027, 2). Petitioner asserts that "[u]nder either date, the references at issue are prior art." *Id.* Patent Owner does not appear to contest Petitioner's assertions or address the '658 patent's critical date for prior art purposes. *See generally*, Prelim. Resp.

Id. ¶ 8. Mr. Birdsell testifies that “[s]tarting in early February 2010, Apple sold the Aperture 3 product in its retail stores, on the Apple web store, and distributed it in retail channels in the United States.” *Id.* ¶ 5.

Mr. Birdsell further testifies that “I am personally familiar with the Aperture 3 User Manual that was distributed with the Aperture 3 product. I have reviewed Exhibit 1005, and can confirm it 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).” Ex. 1020 ¶ 4. According to Mr. Birdsell, “the Aperture 3 User Manual was available to the public via www.apple.com starting on the launch date of the Aperture 3 product in February 2010 and continuing past June 2010.” *Id.* ¶ 11. Mr. Birdsell testifies that “[a]ny 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.³

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” and that “[t]he Aperture 3 support page on the apple.com website contained an embedded URL pointing to the Aperture 3

³ Mr. Birdsell also provides testimony that starting in February 2010 Apple’s Aperture 3 User Manual was publicly distributed on installation DVDs along with the sale of Apple’s Aperture 3 product in Apple’s retail stores, on the Apple web store, and through other retail channels in the United States. *See* Ex. 1020 ¶¶ 4–8, 13–16. Because we find Petitioner’s evidence of public accessibility of the Aperture 3 User Manual on Apple’s website sufficient for purposes of institution, we do not reach Petitioner’s evidence of the Aperture 3 User Manual’s distribution on installation DVDs along with the sales of Apple’s Aperture 3 retail product. *See* Ex. 1020 ¶¶ 5–7, 13–16.

User Manual HTML file set (*i.e.*,
<http://documentation.apple.com/en/aperture/usermanual/>).” *Id.* ¶ 18.

In its Preliminary Response, Patent Owner asserts that A3UM “is a compilation of over seven hundred individual HTML files, rather than a single document or file.” Prelim. Resp. 20–21. Patent Owner argues that “Petitioner proffers no authority for the proposition that hundreds of HTML files can collectively be considered a single printed publication.” *Id.* at 21.⁴

Petitioner argues, however, that “the HTML files that comprise A3UM are linked by not only their content (*i.e.*, they together comprise the content of a single publication, the Aperture 3 User Manual), but by their source and organization.” Pet. Reply, 1–2. With respect to the User Manual’s organization, we note that the text “Aperture 3 User Manual:” appears in the header of each page of the manual, and “/aperture/usermanual/” appears in the URLs in the footers, supporting Petitioner’s position that the files of the manual have a coherent organization and are collectively a unitary electronic document. *See* Ex. 1005. Petitioner’s position on the organization of the manual is further supported by evidence showing that manual’s index page contains embedded hyperlinks assisting a user to navigate to the different sections of the manual. *See, e.g.*, Ex. 1003 ¶¶ 102.f; Ex. 1020 ¶ 19.f; Ex. 1021, 6.

Petitioner’s position is further supported the Board’s finding that a website with multiple webpages constitutes a printed publication because it

⁴ Although Petitioner bears the burden of establishing that A3UM qualifies as prior art to the ’228 patent, we note that Patent Owner provides no authority for its assertion that A3UM must be “a single printed publication” in a Section 103 obviousness challenge to the ’658 patent, as is the case here.

describes a single product from a single source or where a person of ordinary skill in the art readily would have combined such multiple prior art documents and considered them together as a whole. *See, e.g., Haliburton Energy Servs., Inc., v. Dynamic 3d Geosolutions LLC*, IPR2014-01186, IPR2014-1189, IPR2014-01190, 2015 WL 5565065, at *10 (PTAB Jan. 12, 2015).

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. 32–34. Mr. Birdsell, however, confirms 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.

Patent Owner next argues that “there is no evidence of meaningful indexing such that a skilled artisan could reasonably locate” A3UM from the Apple website. Prelim. Resp. 36. 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’” and that “there would be over 700 individual webpages to navigate through.” *Id.* at 36–37.

Mr. Birdsell, however, 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.* ¶ 19.f.

The question to be answered at this stage of the proceeding is whether Petitioner has established a reasonable likelihood that A3UM was publicly accessible before the critical date of the ’658 patent, *i.e.* has Petitioner made a satisfactory showing that A3UM was publicly disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter exercising reasonable diligence could have located it. *Hulu* at 10–11.

In our view, Petitioner provides credible testimonial evidence in the form of Mr. Birdsell’s declaration that Apple made the Aperture 3 User Manual (A3UM) available to the public through the Apple website as early as February 2010 in connection with the release of Apple’s Aperture 3 product. Mr. Birdsell testifies that he worked for Apple since 2002 and has been a full-time employee at Apple since June 2010. Ex. 1020 ¶ 1. Mr. Birdsell testifies that he has “personally worked on Apple documentation and publications regarding each version of Aperture throughout its lifespan, including Aperture 3,” and that he is “personally familiar with the Aperture 3 User Manual that was distributed with the Aperture 3 product,” confirming 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).” *Id.* ¶¶ 2, 4.

Mr. Birdsell also testifies that “starting in February of 2010 and continuing to at least June of 2010, Apple disseminated the Aperture 3 User Manual HTML file set” such that “[a]ny 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. Mr. Birdsell goes on to testify that

[a]s of February 2010, the Aperture 3 User Manual HTML file set could be accessed by any member of the public who visited the dedicated support page for the Aperture 3 product at: www.apple.com/support/aperture. The Aperture 3 support page 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. The Aperture 3 support page on the apple.com website contained an embedded URL pointing to the Aperture 3 User Manual HTML file set.”

Id. ¶ 18.

Dr. Terveen also 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 by simply visiting the dedicated Aperture 3 support page on Apple.com. Ex. 1003 ¶ 101. Dr. Terveen testifies that “[a] skilled artisan would have been provided with a straightforward path to access the web-hosted version of A3UM from the www.apple.com homepage,” and provides an explanation of the navigational steps as skilled artisan would have followed to access the manual on Apple’s website. *Id.* ¶ 102.

We are persuaded, for purposes of institution, that Petitioner provides sufficient evidence that A3UM was made available to the public on Apple’s website prior to the critical date of the ’658 patent and that A3UM was

presented and organized in a meaningful way such that persons interested and ordinarily skilled in the subject matter exercising reasonable diligence would have been able to locate it.

We conclude that, based on the totality of the evidence currently of record, Petitioner has submitted evidence sufficient to establish a reasonable likelihood that the A3UM reference was publicly accessible before the critical date of the challenged patent, and, thus Petitioner has established a reasonable likelihood that the A3UM reference qualifies as a printed prior art publication.⁵

c) Belitz (Ex. 1006)

Belitz is a U.S. Patent Publication that published on March 4, 2010, more than one year before the earliest priority date of the '658 Patent. Ex. 1001, code (22), (60); Ex. 1006, code (43). Petitioner asserts that Belitz is prior art under pre-AIA 35 U.S.C. § 102(b). Pet. 21.

Belitz relates to a “user interface . . . configured to display a map and to display at least one marked location on said map.” Ex. 1006, code (57). By way of background, Belitz explains that “[i]t is common to mark special locations on a map by associating a graphical object with that location. Examples of such locations are service points, restaurants, tourist attractions, visited places etc[.] and examples of graphical objects are photographs taken at such a location.” *Id.* ¶ 2. Belitz further explains “[i]f many locations are

⁵ We remind the parties that the evidentiary standard used at institution, a reasonable likelihood, for finding that a reference qualifies as a printed publication, is different from the evidentiary standard, a preponderance of the evidence, used for making that determination in a final written decision. *See Hulu* at 11 (“To prevail in a final written decision in an *inter partes* review, the petitioner bears the burden of establishing by a preponderance of the evidence that a particular document is a printed publication.”).

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.* Belitz presents a user interface attempting to address those concerns. *Id.* ¶ 5. Figures 4a and 4b, reproduced below, show screenshots of the user interface. *Id.* ¶ 51, 55.

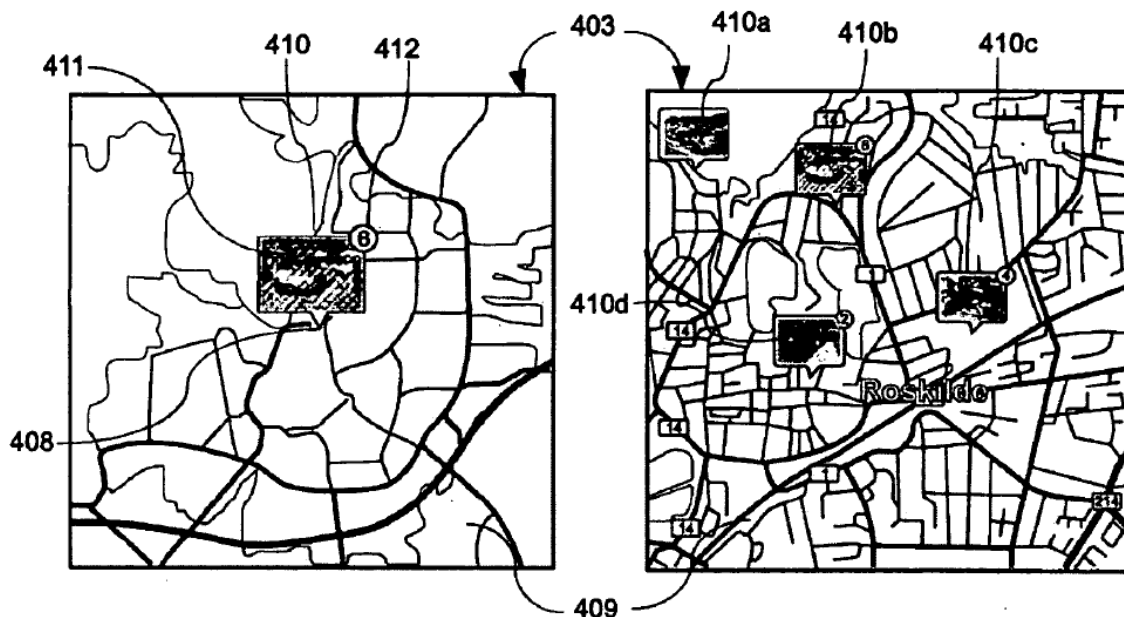


Fig. 4a

Fig. 4b

As shown in Figure 4a, a “map 409 is displayed of a town called Roskilde. A location 408 is marked by a graphical object 410.” *Id.* ¶ 51. “[G]raphical object 410 has a visual representation 411 which in this embodiment is a photograph that is associated with the location.” *Id.* ¶ 52. Furthermore, “graphical object 410 carries a number indicator 412 which presents a viewer with a number. The number indicates how many graphical objects 410 are associated with that location and are stacked into one graphical object 410.” *Id.* ¶ 54. Furthermore, “graphical objects stacked in the displayed graphical object or graphical group object 410 . . . can be associated with other locations that are in close proximity to the marked

location 408” because “if the graphical objects associated with each location were to be displayed separately they would overlap which would clutter the view and be confusing to a user.” *Id.*

Figure 4b shows map 408 having been “zoomed in showing the area in greater detail.” *Id.* ¶ 55. At this zoom level, graphical object 410 is “split up into 4 graphical objects 410a, 410b, 410c and 410d” because the display of those graphical objects would not overlap. *Id.* Those graphical objects themselves also consist of some number of graphical objects. *Id.*

When a graphical object, e.g., graphical object 410, 410a, 410b, 410c, or 410d, is selected, a popup window is displayed over the graphical object. *Id.* ¶ 60. Figure 4c, reproduced below, is a screenshot showing the user interface after the selection of graphical object 410c. *Id.*

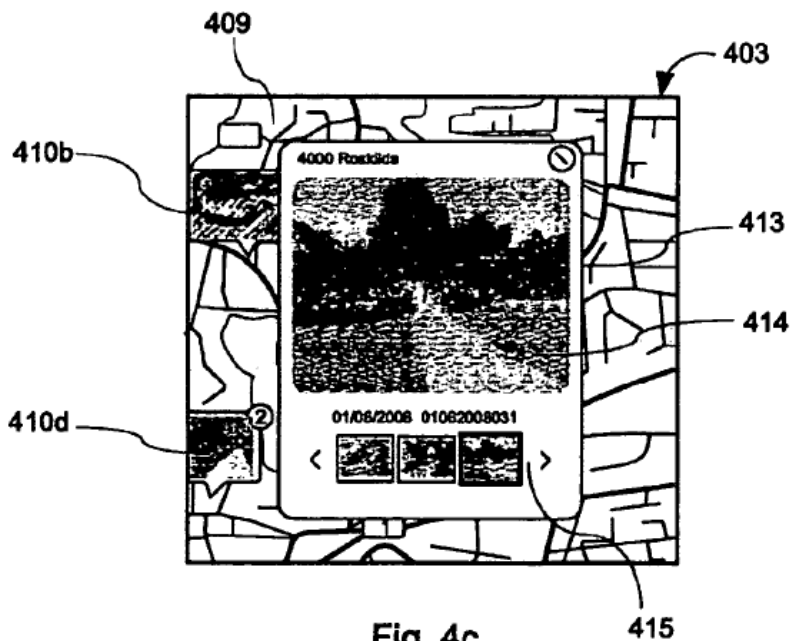


Fig. 4c

As shown in Figure 4c, the “popup window shows at least some of the visual representations 411 of the graphical object 410c.” One 414 of the visual representations 411 or images as they are in this embodiment is shown in a larger size than the others which are shown in a list 415.” *Id.* In some embodiments, “graphical objects are photographs that are associated with

the location where they were taken. The visual representations are thumbnails of the photographs.” *Id.* ¶ 62.

d) Rasmussen (Ex. 1025)

Rasmussen is a U.S. Patent that issued on November 17, 2009, more than one year before the earliest priority date of the ’658 Patent. Ex. 1001, code (22), (60); Ex. 1025, code (45). Petitioner asserts that Rasmussen is prior art under pre-AIA 35 U.S.C. § 102(b). Pet. 23.

Rasmussen “relates to digital mapping systems, and more particularly, to techniques that provide more accurate and useful map scales.” Ex. 1025, 1:18–20. In particular, Rasmussen describes digital map tools and user interface options for a digital map. *Id.* at 9:35–49, 48. Figure 2, reproduced below, shows exemplary tools and interface options. *Id.*

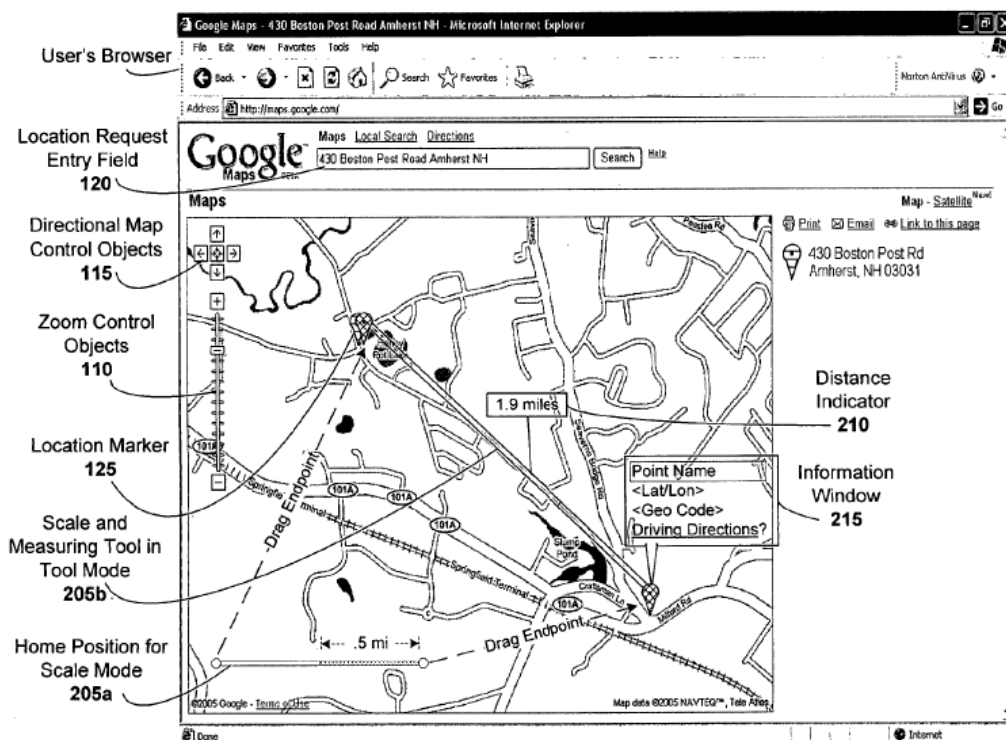


Fig. 2

As shown in Figure 2, a user may position endpoints at various locations on the map, creating measuring tool 205b between the endpoints.

Id. at 9:61–65. “If the user clicks the tool 205*b* endpoints or the line between them, an information window . . . opens to show information about the map locations marked by the tool 205*b* endpoints.” *Id.* at 10:17–23. For example, “information window 215 is shown, and includes latitude/longitude and/or geocode information.” *Id.* at 10:25–27.

E. Obviousness over A3UM and Belitz

Petitioner asserts claims 1, 2, and 5–15 are obvious over the combination of A3UM and Belitz under 35 U.S.C. § 103(a). Pet. 23–75.

1. Independent Claim 1

For each limitation of claim 1, Petitioner asserts that A3UM alone or in combination with Belitz meets that limitation. Pet. 23–50. Petitioner also provides the testimony of Dr. Terveen in support of its position with respect to the limitations of claim 1. *See* Ex. 1003 ¶¶ 138-189. As Patent Owner does not contest Petitioner’s findings for each limitation, we do not reproduce those findings here. We have considered Petitioner’s evidence and arguments with respect to the limitations of claim 1, including the relevant testimony of Dr. Terveen and find it to be sufficient to show that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that A3UM and Belitz, either alone or in combination, disclose each limitation of claim 1. Accordingly, we focus our discussion on Patent Owner’s sole argument that “Petitioner fails to demonstrate that a [person of ordinary skill in the art] would have been motivated to combine A3UM and Belitz, or have a reasonable expectation of success in doing so.” Prelim. Resp. 40.

Petitioner asserts that “[a] skilled artisan would have considered the teachings of A3UM and Belitz together, as both references (and the ’658 patent) come from the same field of endeavor: ‘managing and using digital

files such as photographs.” Pet. 24 (citing Ex. 1003 ¶ 121; Ex. 1001, 1:16–19; Ex. 1005, 1–2; Ex. 1006 ¶¶ 1, 62). Petitioner also asserts that “A3UM and Belitz address the same problems (also purportedly solved by the ’658 patent): allowing ‘people to organize, view, preserve and share’ their digital photographs.” *Id.* (citing Ex. 1003 ¶ 122; Ex. 1001, 1:56–62; Ex. 1005, 1–2; Ex. 1006 ¶¶ 2–5). In addition, Petitioner asserts that A3UM and Belitz “describe analogous techniques—both describe use of 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.” *Id.* at 24–25 (citing Ex. 1003 ¶ 123; Ex. 1005, 30, 81–83, 429–466; Ex. 1006 ¶¶ 39, 50, 51–55, 62; Pet. 12–22).

Petitioner asserts that “[a] skilled artisan would have recognized that Belitz’s thumbnail map markers are a functional equivalent of and could be used as an alternative to the pins used in the A3UM interactive map.” Pet. 25 (citing Ex. 1003 ¶ 125). Based on this reasoning, Petitioner asserts that “[i]t would have been obvious to a skilled artisan before June of 2010 to modify A3UM’s Places view to incorporate Belitz’s graphical object functionality, including, *inter alia*, its thumbnails and counts.” *Id.* at 26 (citing Ex. 1003 ¶ 128). Petitioner illustrates the result of this combination with the map displays shown below:



Petitioner’s map displays, above, show a map view from A3UM (left) with red pin markers and an annotated map view (right) showing the proposed combination of A3UM and Belitz, where A3UM’s red pin markers have been replaced by Belitz’s thumbnails on the map. Dr. Terveen explains that such a “modification 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.

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 to user to clearly see the associations’” and “A3UM suggests the desirability of displaying such information in its Places interface.” Pet. 27 (quoting Ex. 1006 ¶ 4; citing *id.* ¶ 15; Ex. 1005, 81–83, 435). Petitioner asserts further that “[a] skilled artisan also would have considered Belitz’s thumbnail technique to be a known and predictable alternative to the A3UM pins, and that using thumbnails could appeal to certain users, thereby potentially improving usability for such users.” *Id.* (citing Ex. 1003 ¶ 130).

Petitioner also asserts that “[a] skilled artisan would have had a reasonable expectation of success in making this modification” 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.” Pet. 27–28 (citing Ex. 1003 ¶ 132; Ex. 1006 ¶¶ 54–56, 59–60, 62). In addition, Petitioner asserts 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.” *Id.* at 29 (citing Ex. 1003 ¶ 136).

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. 42 (citing Ex. 1006, Title, ¶¶ 2, 4, 10, 19, 71; Ex. 2001 ¶ 156; Pet. 18). Patent Owner also argues that “[t]he Petition does not explain *why* thumbnails could appeal to certain users or *how* they would potentially improve usability.” *Id.* at 43 (citing Pet. 27).

Patent Owner further argues that “Google Maps API documentation,” which A3UM purportedly uses for its interactive map, “would further discourage [a person of ordinary skill in the art] from making Petitioner’s proposed combination of A3UM and Belitz,” because of its stated complexity. Prelim. Resp. 46. Lastly, Patent Owner argues that a person of ordinary skill in the art “would not modify A3UM to include duplicative

number features,” such as displaying the same number twice for a selected location, “because this would consume real estate on the screen and obscure more of the map.” Prelim. Resp. 47 (citing Ex. 2001 ¶ 154).

In our view, Petitioner has sufficiently articulated a rational basis for combining the teachings of A3UM and Belitz to provide particular benefits from the combination. We credit Dr. Terveen’s testimony that such a modification would improve the ease of use of A3UM and result in an interactive map displaying thumbnails with picture counts at locations where digital images are located, thereby allowing a user to more quickly identify which map marker they would like to select and display, including to display the name of the location and view pictures at that location, thus improving usability. *See* Ex. 1003 ¶¶ 126, 129.

Based on this preliminary record, we determine that Petitioner has demonstrated that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of A3UM and Belitz in the manner proposed in the Petition.

2. Dependent Claims 2 and 5–15

Petitioner argues that the combination of A3UM and Belitz discloses and teaches the recited limitations of dependent claims 2 and 5–15. *See* Pet. 50–75. Petitioner provides the testimony of Dr. Terveen in support of its position. *See* Ex. 1003 ¶¶ 190–192, 214–283.

Patent Owner does not separately address Petitioner’s evidence or arguments directed to dependent claims 2 and 5–15. *See generally*, Prelim. Resp. Rather, Patent Owner argues that “[b]ecause Petitioner has failed to show that A3UM and Belitz render obvious independent claim 1, it also fails to meet its burden for the dependent claims in the ‘658 patent.” *Id.* at 48

(citing *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009)).

We have considered Petitioner’s evidence and arguments with respect to dependent claims 2 and 5–15, as well as the testimonial evidence of Dr. Terveen. Based on the current record before us, we are persuaded that Petitioner has demonstrated sufficiently, for purposes of institution, that the combined teachings of A3UM and Belitz meet the recited limitations of these claims. We are also persuaded that Petitioner has demonstrated that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of A3UM and Belitz in the manner described in the Petition.

3. Conclusion on Obviousness by A3UM and Belitz

Based on the current record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in its challenge to claims 1, 2, and 5–15 under 35 U.S.C. § 103(a) as obvious over the combination of A3UM and Belitz.

F. Obviousness over A3UM, Belitz, and Rasmussen

Petitioner asserts claims 3 and 4 are obvious over the combination of A3UM, Belitz, and Rasmussen under 35 U.S.C. § 103(a). Pet. 75–84. Petitioner provides the testimony of Dr. Terveen in support of its position. *See* Ex. 1003 ¶¶ 193–213.

Patent Owner does not separately address Petitioner’s evidence or arguments directed to dependent claims 3 and 4. *See generally*, Prelim. Resp. Rather, Patent Owner argues that “[b]ecause Petitioner has failed to show that A3UM and Belitz render obvious independent claim 1, it also fails to meet its burden for the dependent claims in the ‘658 patent.” *Id.* at 48

(citing *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009)).

We have considered Petitioner’s evidence and arguments with respect to dependent claims 3 and 4, as well as the testimonial evidence of Dr. Terveen. Based on the current record before us, we are persuaded that Petitioner has demonstrated sufficiently, for purposes of institution, that the combined teachings of A3UM, Belitz, and Rasmussen meet the recited limitations of these claims. We are also persuaded that Petitioner has demonstrated that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of A3UM, Belitz, and Rasmussen in the manner described in the Petition.

Based on the current record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in its challenge to claims 3 and 4 under 35 U.S.C. § 103(a) as obvious over the combination of A3UM, Belitz, and Rasmussen.

III. CONCLUSION

For the foregoing reasons, we are persuaded that the Petition demonstrates a reasonable likelihood of prevailing in showing the unpatentability of at least one of the challenged claims of the ’658 Patent. Because Petitioner has satisfied the threshold for institution as to at least one claim, we institute *inter partes* review on all claims and all grounds raised in the Petition. See *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018) (holding that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–15 of the '658 Patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '658 Patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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Patent 10,423,658 B2

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