

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

ANGEL TECHNOLOGIES GROUP LLC,
Patent Owner.

IPR2023-00057
Patent 8,954,432 B2

Before MIRIAM L. QUINN, SHARON FENICK, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background and Summary*

Meta Platforms, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–8 (“challenged claims”) of U.S. Patent No. 8,954,432 B2 (Ex. 1001, “the ’432 patent”). Angel Technologies Group LLC (“Patent Owner”) filed a Preliminary Response (Paper 9). Petitioner filed a Preliminary Reply (Paper 14) and Patent Owner filed a Preliminary Sur-reply (Paper 15). We determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims, and therefore we instituted this proceeding on May 11, 2023, as to all challenged claims and all grounds of unpatentability. Paper 16 (“Dec. on Inst.”).

Patent Owner filed a Patent Owner’s Response (Paper 24, “PO Resp.”), Petitioner filed a Reply (Paper 29, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 30, “PO Sur-reply”). The parties presented oral arguments on February 13, 2024 and the Board entered a transcript into the record. Paper 39 (“Tr.”).

For the reasons set forth in this Final Written Decision pursuant to 35 U.S.C. § 318(a), we determine that Petitioner demonstrates by a preponderance of evidence that claims 1–8 are unpatentable.

B. *Real Parties in Interest*

Petitioner identifies itself and Instagram, LLC as the real parties in interest, and notes that it was formerly known as Facebook, Inc. Pet. 2.

Patent Owner identifies only itself as a real party in interest. Paper 4 (Patent Owner’s Mandatory Notices), 2.

C. Related Matters

Petitioner and Patent Owner identify *Angel Technologies Group LLC v. Facebook, Inc. and Instagram LLC*, No. 2:21-cv-08459 (C.D. Cal.) as a related case. Pet. 2; Paper 4, 2. Petitioner notes that an appeal of that case was filed with the Federal Circuit. Pet. 2–3. The parties identify that appeal as *Angel Technologies Group LLC v. Meta Platforms, Inc.*, Case No. 22-2100, filed with the Federal Circuit on August 3, 2022. *Id.*; Paper 25 (Patent Owner’s Fourth Amended Mandatory Notices), 1.

Petitioner and Patent Owner additionally identify IPR2023-00058 (challenging claims of U.S. Patent 9,959,291 B2); IPR2023-00059 (challenging claims of U.S. Patent 10,417,275 B2); and IPR2023-00060 (challenging claims of U.S. Patent 10,628,480 B2) as related *inter partes* review requests. *Id.* at 3; Paper 4, 2.

D. The ’432 Patent

The ’432 patent is titled “Users Tagging Users in Photos Online” and relates to using computer(s) and a communication network for storing and sharing images such as photographs and permitting the identification of objects such as persons within the photos. Ex. 1001, codes (54), (57), 1:11–17. The ’432 patent issued from an application filed November 15, 2001, and claims priority to a provisional application, No. 60/248,994, filed on November 15, 2000. *Id.* at codes (22), (60), 1:4–6; Ex. 2017.

The ’432 patent describes, as part of the prior art, websites that allow users to organize digital photographs into online photo albums that can be accessed by other users. Ex. 1001, 1:25–61. However, the ’432 patent describes disadvantages or limitations to these prior art albums, among others these include: (1) no ability for users to identify individuals or objects in photos; (2) text captions or descriptions cumbersome and possibly vague;

(3) no search capabilities for searching for photos of specific individuals; and (4) no ability to associate descriptive terms identifying an object or individual in a photo with a specific area of the photo. *Id.* at 1:62–2:23, 2:37–63, 3:8–12; 3:17–26.

The '432 patent describes a system in which databases are used to store information to provide users access to upload, view, and access images, information about objects or people, and information about relationships between users and images. *Id.* at 5:26–41, 6:59–7:37. The '432 patent specification describes that the information can be stored in one or more databases. *Id.* at 6:61–63. “For instance, the system may utilize a Users database 230, Identifications database 240, and Images database 250 as depicted in FIG. 2.” *Id.* at 6:63–65. Figure 2, reproduced below, is a schematic diagram of the databases according to one embodiment of the invention. *Id.* at 4:31–32.

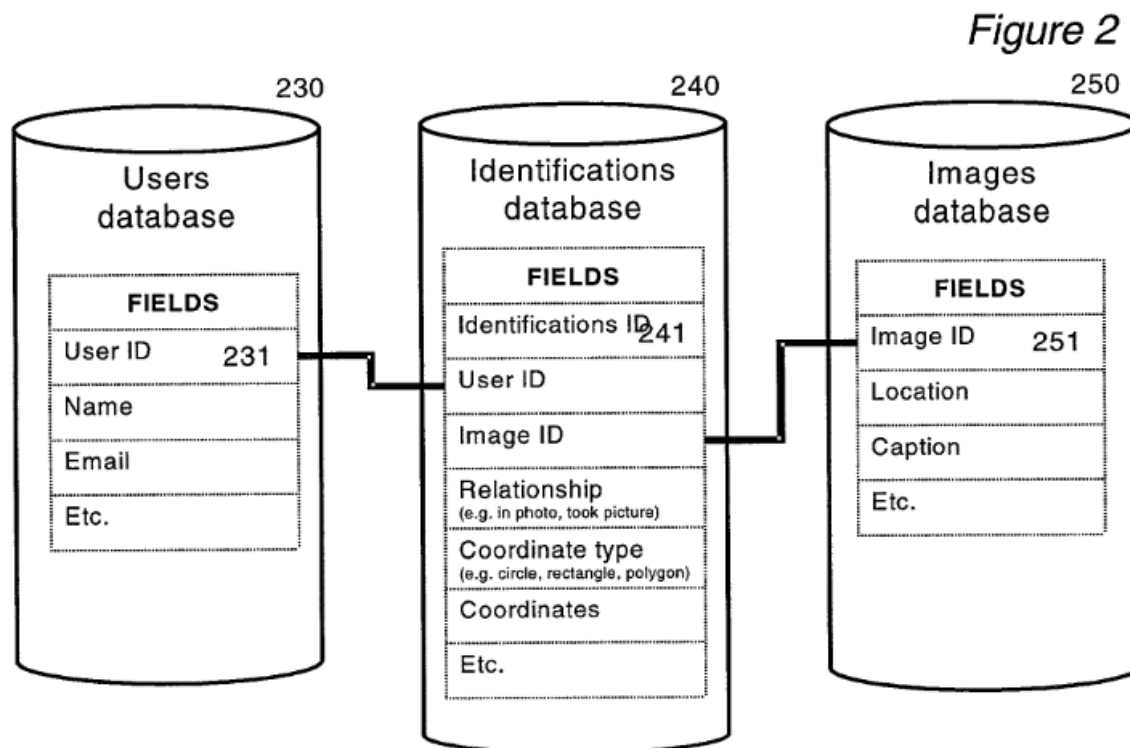


Figure 2 depicts users database 230, identifications database 240, and images database 250, with the fields used in each database, and shows that identifications database 240 links information in users database 230 with information in images database 250. *Id.* at 6:63–7:36.

Users database 230 stores information about people or other objects identified within images. *Id.* at 6:66–7:1. The information can relate to users who access the system, and may include a user identifier unique to a user or the user’s client computer system and other information relating to the user, including name, e-mail address, home page address, and a list of contacts. *Id.* at 6:66–7:5, 9:12–18. Users may enter other users as contacts. *Id.* at 9:18–28.

Images database 250 receives and stores image data, and may include a photo identifier and the location of the image file on the network, in addition to descriptive information such as a caption or date taken. *Id.* at 7:8–25, 9:29–41.

Identifications database 240 receives, stores, and provides information about relationships between users and photos, for example by linking information in users database 230 with information in images database 250. *Id.* at 7:25–36, 7:58–8:10, 8:34–44, 9:41–44. The location of the person in the photo may also be specified in the identifications database. *Id.* at 7:62–8:10. Web pages that permit users to identify people or other objects within photos are presented to obtain identifying information. *Id.* at 9:60–67, 11:38–41. The location of a user in an image may also be captured in such a page. *Id.* at 11:46–12:3. Figure 4, reproduced below, is an example of such an “identifying page.” *Id.* at 10:1–2.

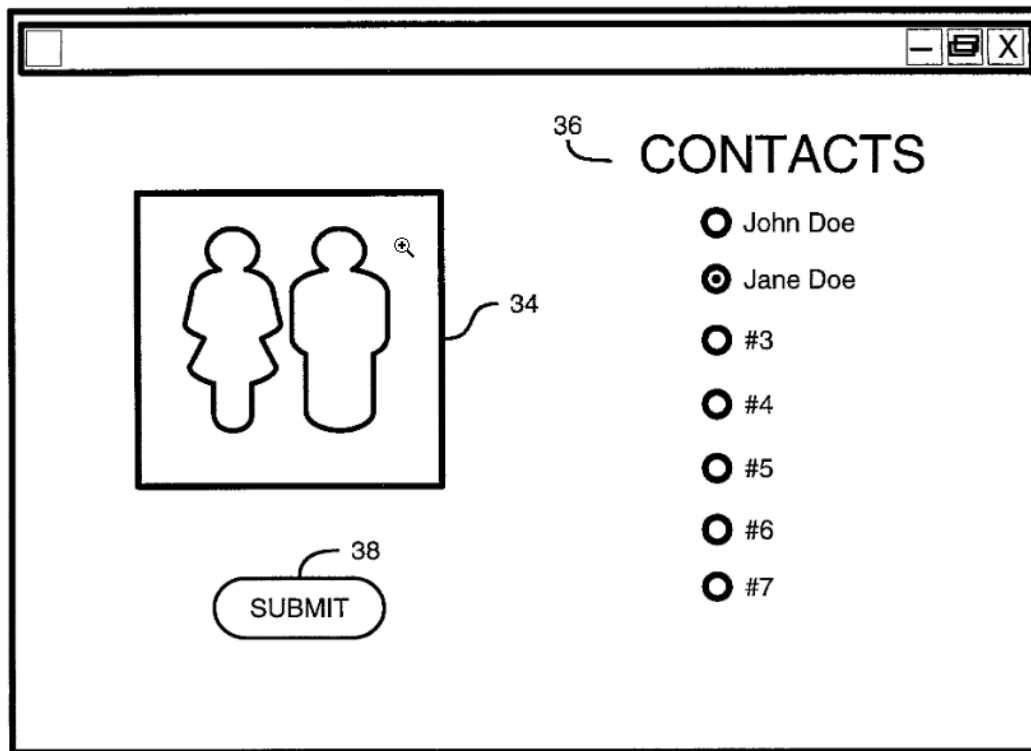


Figure 4 is a web page that presents photo 34, list of contacts 36 labelled “CONTACTS” and including seven options and radio buttons, and submit button 38. *Id.* at 10:2–4. The list of contacts may be selected from among the objects and users listed in users database 230 or may optionally be a filtered list from user database 230, for example, a list of user contacts. *Id.* at 10:62–65. The information identifying people within the image displayed, obtained from a user interaction with an identifying page, is stored in the identifications database. *Id.* at 9:60–64, 10:28–33, 12:18–61.

Information in identifications database 240 may be used to find all the people identified in a given photo or to find all the photos a given person has been identified in. *Id.* at 8:45–9:5, 13:24–16:4.

E. Illustrative Claim

Claims 1 and 6 are independent, and claims 2–5, 7, and 8 are dependent. Independent claim 6 is illustrative, and is reproduced below with limitation identifiers in brackets.

6. [6pre] In a multi-user computer network, a method for obtaining and displaying information relating to existence of at least one user of a computer network in an image comprising:

- [6a] identifying users of said computer network and assigning a unique user identification to a user of said computer network;
- [6b] storing said unique user identifier in an users database wherein said database is accessible by other computers of said computer network;
- [6c] obtaining image data from at least one uploading user of said computer network and assigning a unique image identifier to said image data;
- [6d] storing said unique image identifier in an images database wherein said database is accessible by other computers of said computer network;
- [6e] obtaining identification data from a first tagging user of said computer network, wherein said identification data comprises said unique image identifier and a pictured user unique identifier of a user of said computer network pictured in said image data;
- [6f] storing said identification data from said first tagging user in an identifications database accessible by other computers of said network whereby a user identifier may be associated with one or more image identifiers and an image identifier may be associated with one or more users identifiers.

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–8 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1, 3, 6–8	103	Sharpe ²
1–8	103	Sharpe, Eintracht ³
3	103	Sharpe, Carey ⁴
3	103	Sharpe, Eintracht, Carey

Petitioner additionally relies on declarations of Dr. Benjamin B. Bederson (Ex. 1003, Ex. 1039). Patent Owner relies on a declaration of Dr. Eli Saber (Ex. 2021).

II. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring [*inter partes*] review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek*,

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102, 103. Because the ’432 patent was filed before the effective date of the applicable AIA amendment, we refer to the pre-AIA version of the relevant statutes. *See* Ex. 1001, code (22).

² Sharpe et al., US Patent 7,451,099 B1 (iss. Dec. 2, 2008) (Ex. 1005).

³ Eintracht et al., US Patent 6,687,878 B1 (iss. Feb. 3, 2004) (Ex. 1006).

⁴ Carey et al., US Patent 6,714,793 B1 (iss. Mar. 30, 2004) (Ex. 1007).

Inc., 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”).

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.⁵ See *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner argues that one of ordinary skill in the art would “have had at least a bachelor’s degree in computer science, electrical engineering, computer engineering, or a similar technical field, with at least two years of experience in the field of networked and Web-based media applications” and that “[a]dditional experience could substitute for less education, and

⁵ The record contains no evidence or argument regarding objective evidence of nonobviousness.

additional education could likewise substitute for less experience.” Pet. 12 (citing Ex. 1003 ¶¶ 36–42).

In the Decision on Institution, we removed the open-ended term “at least” from Petitioner’s proposed definition and adopted that amended definition. Dec. on Inst. 9. Consistently, Patent Owner contends that a person of ordinary skill in the art “would have a bachelor’s degree in computer science, electrical engineering, computer engineering, or a similar technical field, with two years of experience in the field of networked and Web-based media applications” and that “[a]dditional experience could substitute for less education, and additional education could likewise substitute for less experience.” PO Resp. 16 (citing Ex. 2021 ¶ 44).

We adopt Patent Owner’s definition, which is consistent with the specification of the ’432 patent and the prior art and supported by the testimony of both experts.

C. Claim Construction

1. “user identifier,” “user identification,” and “contacts”

Petitioner discusses the construction of the following claim terms: “user identifier” (claims 6–8); “user identification” (claims 1–5); and “contacts” (in claim 3). Pet. 13–14. Petitioner argues that each should be given their ordinary meaning in the context of the ’432 patent. For “user identifier” and “user identification,” Petitioner argues that the ordinary meaning is “a series of characters identifying a user.” *Id.* (citing Ex. 1001, 7:37–39, 7:47–49; Ex. 1003 ¶¶ 73–75). For “contacts,” Petitioner argues that the ordinary meaning is “people known to the user.” *Id.* at 14 (citing Ex. 1001, 9:18–19, 9:21–28; Ex. 1003 ¶¶ 76–78).

In response, with respect to these claim terms, Patent Owner argues that no claims require express construction and that each term should be

given its ordinary and customary meaning. PO Resp. 17 (citing Ex. 2021 ¶ 63).

“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (alteration in original) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Petitioner does not appear to use the claim constructions it discusses in the Petition in its unpatentability arguments and Patent Owner does not raise the proper construction of these terms in its Response or Sur-reply.

In this case, with respect to “user identifier,” “user identification,” and “contacts,” these terms do not require construction to reach our decision with respect to patentability, and therefore we do not provide any constructions for these terms. *See Realtime Data*, 912 F.3d at 1375.

2. “a request for said image data”

Additionally, Petitioner and Patent Owner each raise issues with respect to the claim language “a request for said image data” (in claims 1 and 8). Patent Owner argues that this requires a request for a single specific image. PO Resp. 28–32; PO Sur-reply 6–8. Petitioner argues that the requirement is that an image retrieval process retrieves images responsive to a request. Pet. 39–40, 57 (assuming this construction); Pet. Reply 6–8 (arguing for this construction in response to Patent Owner’s arguments).

Patent Owner contends that Petitioner does not properly interpret the claim term, which Patent Owner argues must be interpreted to comprise “particularly requesting the said image data associated with the unique image identification,” citing the antecedent basis of “image data” in claim 1 (for claim 1’s recitation of “a request for said image data”) or in claim 6 (for

claim 8, due to dependency). PO Sur-reply 8; PO Resp. 28, 31. Patent Owner contends that this would not be taught or suggested by a search that retrieves multiple images. PO Resp. 32. In response to Petitioner's arguments in Reply (discussed below) regarding a client request for image, Patent Owner argues that "a request for said image data" relates to the '432 patent specification's discussion of creating a tag rather than the functionality describing searching tagged photos. PO Sur-reply 8–9 & nn. 2, 3 (citing Ex. 1001, 10:2–36 (discussing the acquisition of identifying information regarding a photo from a user)). Patent Owner cites to Dr. Saber's declaration, but the declaration does not provide support for the proposed construction; rather, Dr. Saber assumes that "a request for said image data" should be interpreted to require a request for a single specific digital media item, without discussing the construction further. Ex. 2021 ¶¶ 89, 92.

Petitioner argues that "a request for said image data" does not require a request limited to a specific or particular image, but encompasses requests that would return multiple images. Pet. Reply 6–7. In part, Petitioner bases this on the '432 patent specification's description of multiple images being returned in response to a client request for images. *Id.* at 6–8 (citing Ex. 1001, 15:46–16:4, Fig. 10; Ex. 1039 ¶¶ 13–16).

We conclude that the proper construction for "a request for said image data" is not limited to a request for a specific single image, but rather encompasses searches with parameters that would return "said image data" – e.g., an image as previously obtained from an uploading user (see limitation 1b of claim 1 and 6c of claim 6) – either on its own or among a number of images. We do not see a reason, as Patent Owner argues, to limit our understanding of this limitation as directed to the "tagging functionality"

described in the '432 patent specification rather than to the “search functionality.” *See* PO Sur-reply 8. Indeed, in each case, the “request for said image data” is “receiv[ed] . . . from a *viewing user* of said computer network.” (Ex. 1001, 17:11–12, 18:37–38) (emphasis added). On the other hand, the tagging process described in the '432 patent specification appears to correspond to the steps in claim 1 and in claims 6 and 7 (from which claim 8 depends) relating to the “*first tagging user*” and “*second tagging user*.” Ex. 1001, 16:38–17:10 (claim 1), 18:12–35 (claims 6 and 7) (emphasis added).

Because of this, we understand the “request for said image data” to at least not be limited to the tagging functionality as argued by Patent Owner. Instead, we agree with Petitioner that the proper construction encompasses situations in which multiple images may be retrieved as a response to a request by a viewing user. Ex. 1001, 15:46–16:4, Fig. 10 (cited at Pet. Reply 6–8); *see id.* at 13:58–62, Fig. 7 (describing an embodiment in which “one or more requested images” are included in a display page along with “a list of identification information for all persons displayed within the image” for each image). Thus, we conclude that the claim term “a request for said image data” encompasses requests directed to retrieval of a larger group of image data (e.g., images) that includes the specific “said image data” that other steps refer to.

3. *Other Terms*

No other terms require construction to reach our decision.

D. *Challenge to Claims 1, 3, and 6–8 as Obvious Over Sharpe*

Petitioner argues that claims 1, 3, and 6–8 would have been obvious over Sharpe. Pet. 22–59. Patent Owner presents contentions countering

certain aspects of Petitioner's showing. PO Resp. 18–51; PO Sur-reply 4–14.

1. Sharpe – Overview

Sharpe is titled “Method and System for Archiving and Retrieving Items Based on Episodic Memory of Groups of People” and describes archiving and retrieving digital media items. Ex. 1005, codes (54), (57), 1:33–37.

Sharpe describes that a user archives digital media items by identifying a group to which the user belongs and archiving the digital media item for the group. *Id.* at 1:37–45. To archive the digital media item, the user can select parameters to index the digital media item; these parameters may include identifying as associated with the item: a group event type, persons, or a time period. *Id.* at 1:47–58, 1:66–2:02, 8:15–25. These parameters can then be used to retrieve digital media items. *Id.* at 1:58–63, 2:2–9.

“The index information may be stored together with the digital media item for example as a ‘header’. Alternatively, the digital media items may be stored separately with unique identifiers such as a file name or index.” *Id.* at 3:64–67, 5:43–45. In such cases, the index information, stored separately from the digital media items in a faster storage medium, includes a reference to this unique identifier. *Id.* at 3:67–4:3. “This allows the digital mediabase to be searched quickly but does not use the expensive, fast access storage for space consuming digital media files.” *Id.* at 4:3–6.

Figure 1 of Sharpe, reproduced below, is a block diagram of an embodiment of Sharpe. *Id.* at 5:4–6.

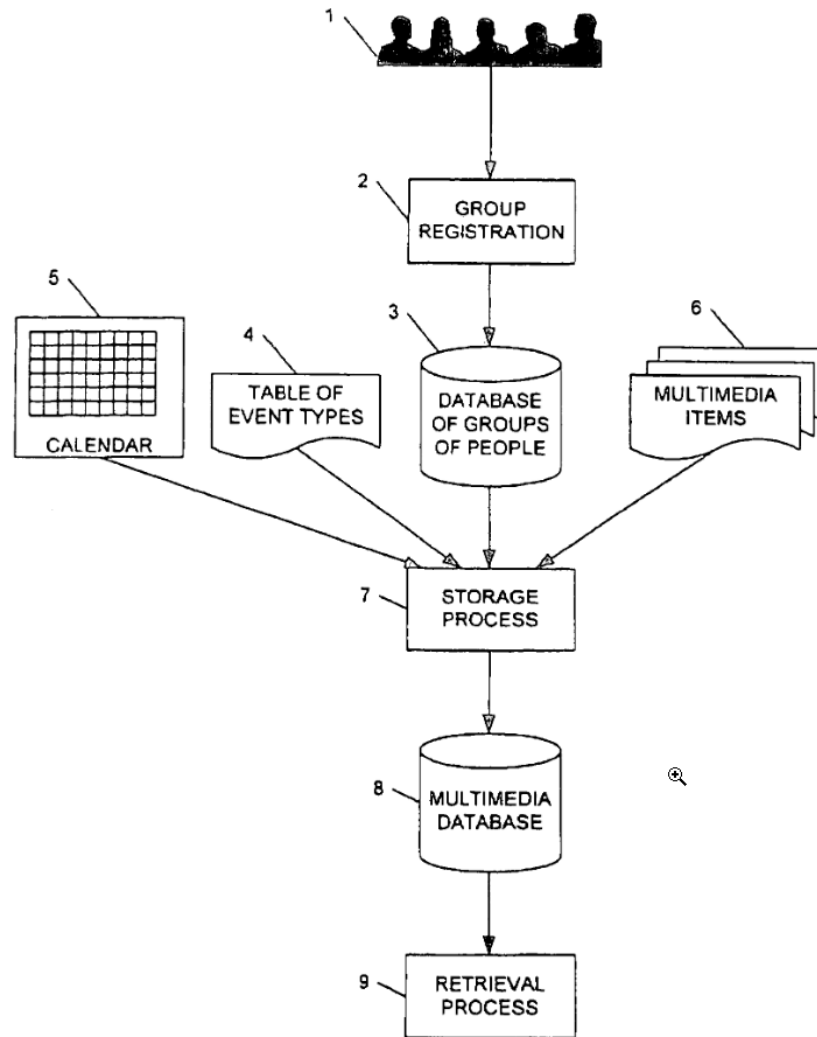


Fig 1

Figure 1 includes processes, information, databases, and their relationships. Groups of users 1 are registered by group registration process 2 as stored in database of groups of people 3, including information identifying the people in the group and identifying a group. *Id.* at 5:4–6, 7:35–38. A user of the system may identify themselves as a member of the group using a user name and password. *Id.* at 7:39–41. This allows them to

associate stored multimedia items with the group to which the user belongs.
Id. at 7:47–48.

Information from database of groups of people 3 is used, along with multimedia items to be archived 6, information from table of event types 4 and calendar 5, resulting in the indexing of a multimedia item in accordance with the group, members of the group, event type, and date. *Id.* at 5:24–37, 5:41–43.

Figure 4 of Sharpe, reproduced below, depicts a graphical user interface according to the Sharpe system. *Id.* at 6:58–59.

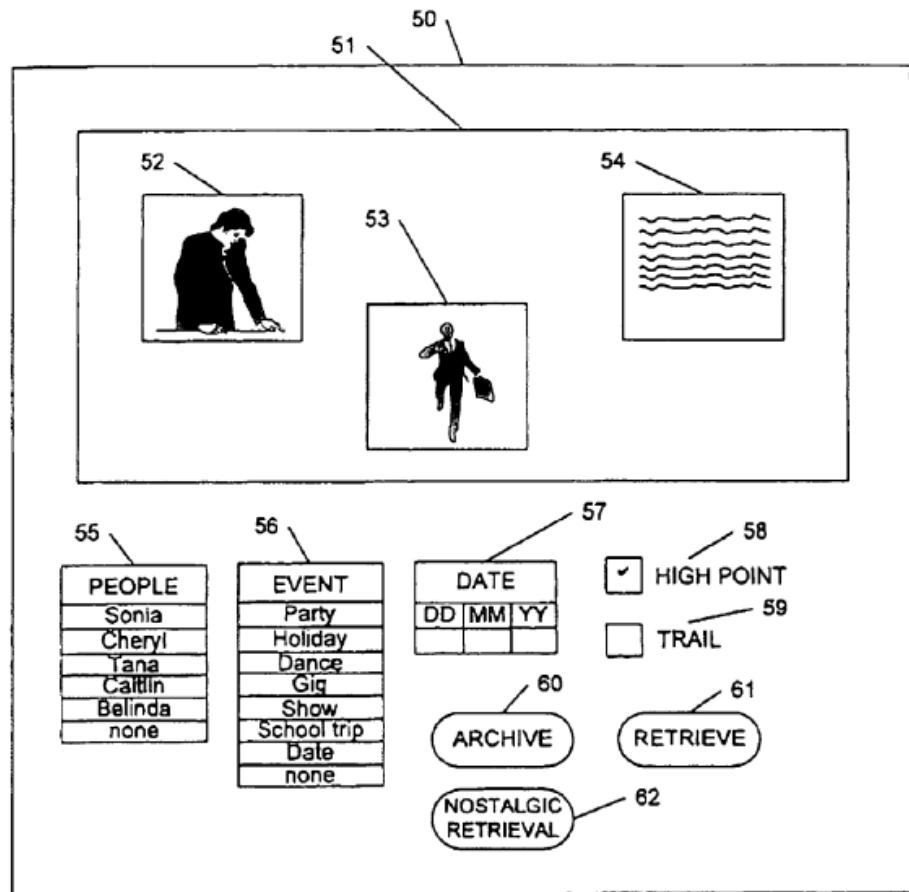


Fig 4

Figure 4 includes work space 51 that displays media items (images 52 and 53 and text 54) and user controls for generating index information. *Id.* at 6:59–67, 7:42–44. Drop down box 55 allows selection of any of a number of people from within a group. *Id.* at 6:67–7:1. The database of groups of people 79 is used to provide the list of people. *Id.* at 8:26–27. Drop down box 56 allows the identification of one of a number of event types. *Id.* at 7:1–2. Date entry 57 allows a user to enter a date. *Id.* at 7:3. Archive button 60 is used to enter this index information for the archiving process. *Id.* at 7:14–24, 7:44–47, 8:30–31, 8:37. This allows group members to view the contents of the group archive, for example, with a focus on a specific person or people, date or time period, or event type. *Id.* at 8:45–67, 9:12–32, Fig. 7.

2. *Arguments Regarding Sufficiency of the Obviousness Ground Presented*

Before we address specific assertions regarding unpatentability, we address arguments Patent Owner raises regarding this single-reference obviousness ground.

Patent Owner argues that while the Petition styles arguments relating to unpatentability in view of Sharpe alone as an obviousness ground, the Petition “contains no actual obviousness analysis” and rather only contends that Sharpe actually discloses the elements of the challenged claims. PO Resp. 46–48. Patent Owner asserts that, “[b]y not addressing what is missing from Sharpe such that an obviousness modification would be hypothetically made, the Petition’s analysis is flawed at least with respect to” the second *Graham* factor, relating to differences between the claimed subject matter and the prior art. *Id.* at 46–47 (referencing the four factors set forth in *Graham v. John Deere Co.*, 383 U.S. at 17–18). Additionally,

Patent Owner argues that no analysis was presented regarding the reasonable expectation of success regarding any such modification. *Id.* at 47 (citing *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017)). Patent Owner argues that Petitioner has created a “legal limbo” in which it would be impossible to determine whether Petitioner has sufficiently shown obviousness because the Petition is fatally ambiguous regarding obviousness and does not provide Patent Owner proper notice of the theory of unpatentability under the Administrative Procedure Act (APA). *Id.* at 48–51.

We do not agree that the obviousness ground is deficient.

Patent Owner cites *M & K Holdings* (PO Resp. 49–51) to argue that the Board cannot deviate from the invalidity theory set forth in a petition in a final determination, and we begin by examining what is present in the Petition in this proceeding. *See M & K Holdings, Inc. v. Samsung Elecs. Co.*, 985 F.3d 1376, 1385 (Fed. Cir. 2021). We agree with Petitioner that it was clear from the Petition that an obviousness ground over Sharpe was presented, and that the Petition describes the “knowledge and skills that [a person of ordinary skill in the art] would have applied to implement Sharpe.” *See* Pet. Reply 12–13. The Petition describes the ground as relating to obviousness over 35 U.S.C. § 103 and specifically describes one of ordinary skill in the art making certain implementation decisions with respect to employing teachings of Sharpe. Pet. 5 (identification of challenges), 22 (heading), 29–37 (claim 6); *see id.* at 53–58 (claim 1). The Petition presents an argument, related to limitation 6e of claim 6, for using the Sharpe username as a primary key to archive a digital media item (image) with selected people identified as being in the image, arguing that one of ordinary skill would have found it “suitable” for that use, that it would have been a

“known design choice,” and that another option (the personal name of a user) would not have been a suitable primary key. *Id.* at 29–32; 53 (claim 1, referring back to arguments for limitation 6e). Petitioner indicates a difference between the prior art and the claimed subject matter – that Sharpe does not detail the use of the Sharpe username as a primary key – and addresses that difference. *Id.*

Patent Owner’s Response shows that Patent Owner had notice that Petitioner’s arguments were based on obviousness. PO Resp. 18, 22–23. Our Decision on Institution (at 7, 24–27) indicated the Board’s understanding of the Petition as presenting an obviousness ground over Sharpe, Petitioner’s Reply (at 2–3) clarified this further, and Patent Owner has had an opportunity to respond to the obviousness theories throughout the proceeding. Thus, we perceive no APA issue; Patent Owner has had notice and a fair opportunity to be heard on these matters. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (in an IPR, “the Administrative Procedure Act requires the PTO to timely inform a patent owner of the matters of fact and law asserted in an inter partes review of its patent, to give all interested parties opportunity for . . . the submission and consideration of facts and arguments . . . and hearing and decision on notice, and to permit a party to submit rebuttal evidence, and to conduct such cross-examination as may be required for a full and true disclosure of the facts” (internal quotations and citations elided)).

With respect to the argument that the Petition was deficient as lacking a showing of a reasonable expectation of success, we agree with Petitioner that *Stepan* stands for the proposition that such a showing must be made when there is a combination of teachings, including from the same reference. Pet. Reply 15–16; *Stepan*, 868 F.3d at 1346 n.1 (“Whether a rejection is

based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”). We note that Petitioner – in describing the use of Sharpe’s username as a “known design choice” and “the most obvious design choice;” in contrasting the use of personal names, which might be duplicated, with the use of usernames that would be unique; and in citing Dr. Bederson’s testimony to this effect – provides argument and evidence regarding an expectation of success in using the username. Pet. 32 (citing Ex. 1003 ¶¶ 307–309); *see Sisvel S.p.A. v. TCT Mobile Int’l Ltd.*, No. 2023-1123, 2024 WL 1173047 at *3 (Fed. Cir. March 19, 2024) (nonprecedential) (finding a reasonable expectation of success where an expert testified regarding a “simple design choice” and the prior art reference noted a solution as “a good candidate”).

For these reasons, we do not find the ground of obviousness over Sharpe deficient as Patent Owner argues. We reserve for later portions of this Decision specific determinations regarding substantive arguments of the parties with respect to the ground presented and regarding the ultimate question of whether the Petitioner has met its burden of proof.

3. *Independent Claim 6*

Petitioner begins by addressing the obviousness of claim 6, and we follow this ordering in our analysis.

a) *Petitioner’s Contentions in the Petition*

Without arguing that the preamble of claim 6 is limiting, Petitioner argues that Sharpe renders the preamble of claim 6 obvious by teaching a

method for obtaining and displaying information relating to an image, including information regarding users in the image. Pet. 22–23 (citing, *inter alia*, Ex. 1005, 1:6–9, 6:58–7:24, 8:45–9:27; Ex. 1003 ¶¶ 274, 278).

Petitioner further argues that Sharpe describes that the information relates to a user of a multi-user computer network. *Id.* (citing Ex. 1005, 4:21–30, 5:50–63, Fig. 2; Ex. 1003 ¶ 277).

With respect to limitation 6a, the method step of “identifying users of said computer network and assigning a unique user identification to a user of said computer network,” Petitioner argues that this is taught in Sharpe’s disclosure of groups of users registered by a group registration process, with a user entering a username and password to use the system. *Id.* at 23–24 (citing Ex. 1005, 5:4–18, 7:39–41; Ex. 1003 ¶¶ 280–281). Petitioner further argues that one of ordinary skill in the art would have understood that the usernames of Sharpe are unique usernames because such a login process would typically be implemented with a unique username, and because Sharpe’s archiving and retrieving of images based on associated users would require a unique user identifier. *Id.* at 24–25 (citing Ex. 1005, 7:35–48, 8:60–9:11; Ex. 1003 ¶¶ 284–285).

For limitation 6b, the method step of “storing said unique user identifier in an users database wherein said database is accessible by other computers of said computer network,” Petitioner argues that Sharpe discloses a users database in which users are registered, citing database 3 from Figure 1 and associated disclosure. *Id.* at 25–26 (citing, *inter alia*, Ex. 1005, 5:4–6, Fig. 1; Ex. 1003 ¶¶ 292–293). With respect to the accessibility by other computers, Petitioner cites Dr. Bederson’s testimony that one of ordinary skill would have needed to be accessible in order to

allow users to access the server using, e.g., web browsers. *Id.* at 26–27 (citing, *inter alia*, Ex. 1005, 4:28–30; Ex. 1003 ¶ 295).

With respect to limitation 6c, “obtaining image data from at least one uploading user of said computer network and assigning a unique image identifier to said image data,” Petitioner cites Sharpe’s item identifier generated when the user imports the media item. *Id.* at 27 (citing Ex. 1005, 4:35–37, 8:30–36; Ex. 1003 ¶¶ 297–298). For the storing of the unique image identifier in an images database, as in limitation 6d (“storing said unique image identifier in an images database wherein said database is accessible by other computers of said computer network”), Patent Owner cites the multimedia database 8 of Figure 1 and Sharpe’s disclosure that the item identifiers are stored in that database. *Id.* at 27–29 (citing Ex. 1005, 5:27–40, 7:35–48, 8:30–36, Fig. 1; Ex. 1003 ¶¶ 300–302). Patent Owner additionally argues that one of ordinary skill in the art would have understood that a database would require a primary key for reference, and that such a primary key would constitute a unique image identifier. *Id.* at 29 (citing Ex. 1005, Figs. 6B–6E; Ex. 1003 ¶ 303).

Limitation 6e recites the step of “obtaining identification data from a first tagging user of said computer network, wherein said identification data comprises said unique image identifier and a pictured user unique identifier of a user of said computer network pictured in said image data.” Petitioner argues that this is taught or suggested by Sharpe’s user who identifies other users in a group in a digital media item to associate with that digital media item. *Id.* at 29–30 (citing Ex. 1005, code (57), 3:57–63, 5:24–37, 6:58–7:24, 8:15–29, Fig. 4; Ex. 1003 ¶¶ 305–306). Petitioner further argues that one of ordinary skill in the art would have used a person’s username as the unique identifier for a pictured user. *Id.* at 31–32 (citing Ex. 1003 ¶¶ 307–309).

Petitioner argues that the final step (limitation 6f) of claim 6, “storing said identification data from said first tagging user in an identifications database accessible by other computers of said network whereby a user identifier may be associated with one or more image identifiers and an image identifier may be associated with one or more users identifiers,” is taught or suggested in Sharpe via the storage of index data (item identifiers and associated user identifications) in an index information database that is stored separately from the multimedia images database. *Id.* at 33–34, 37 (citing Ex. 1005, 3:64–4:6, 4:21–28, 5:24–45, Fig. 6e; Ex. 1003 ¶¶ 311–315, 317–320). Petitioner argues that one of ordinary skill would have understood that the index information database would have been accessible to other user devices. *Id.* at 35 (citing Ex. 1005, 4:21–28; Ex. 1003 ¶¶ 317–318).

b) Patent Owner’s Arguments

Patent Owner contends that “Sharpe’s thin disclosure regarding a user name” amounts to a “limited and solitary reference” that “indicates Sharpe’s lack of concern with further utilization of the user name for functionalities claimed in limitation 6[e].” PO Resp. 18–19. Patent Owner argues, regarding anticipation, that the use of the Sharpe username as “pictured user unique identifier for a user . . . pictured in [the] image data” is not inherent or disclosed in Sharpe. *Id.* at 18–22; PO Sur-reply 4–5. With respect to obviousness, Patent Owner generally argues that the analysis presented in the Petition is not sufficiently clear or supported by the cited testimonial evidence. PO Resp. 22–23; PO Sur-reply 5–6. Patent Owner argues that Dr. Bederson’s testimony that one of ordinary skill in the art would have understood that a username is a unique identifier that could have been used

as the “pictured user unique identifier” was not sufficiently presented in the Petition. PO Sur-reply 2–3, 5–6.

c) Our Analysis and Conclusion

We determine that Petitioner has shown by a preponderance of the evidence that claim 6 would have been obvious in view of Sharpe.⁶ Petitioner shows how Sharpe discloses a method for obtaining and displaying information relating to images and users in images in a multi-user computer network. *See* Pet. 22–23 (citing, *inter alia*, Ex. 1005, 1:6–9, 4:21–30, 5:50–63, 6:58–7:24, 8:45–9:27, Fig. 2; Ex. 1003 ¶¶ 274, 277, 278).

Sharpe’s disclosure describing user registration / usernames, a users database, and accessibility by other computer in a network, sufficiently teaches limitations 6a and 6b. *See id.* at 23–27 (citing Ex. 1005, 4:28–30, 5:4–18, 7:35–48, 8:60–9:11, Fig. 1; Ex. 1003 ¶¶ 280–281, 284–285, 292–293, 295).

Sharpe’s user importation of a digital media item for a group, for storage in a multimedia database with a primary key for reference, in concert with storage of index information, teaches or suggests the subject matter of limitations 6c and 6d. *See id.* at 27–29 (citing Ex. 1005, 4:34–37, 5:27–40, 7:45–48, 8:30–36, Fig. 1; Ex. 1003 ¶¶ 297–298, 300–302). that the item identifiers are stored in that database. *Id.* at 27–29 (citing Ex. 1005, 5:27–40, 7:45–48, 8:30–36, Fig. 1; Ex. 1003 ¶¶ 300–302).

Sharpe’s teachings regarding a user using the Sharpe work space to display a digital media item and to select people from a group in order to create index information associating a person with the digital media item,

⁶ We do not reach a determination regarding whether the preamble of claim 6 is limiting because we determine that Petitioner’s showing is sufficient if it were to be construed as limiting.

and the storage of this association as index information teach or suggest much of the limitations 6e and 6f. *See id.* at 29–30, 33–34, 37 (citing Ex. 1005, code (57), 3:57–4:6, 4:21–28, 5:24–45, 6:58–7:24, 8:15–29, Fig. 4, Fig. 6e; Ex. 1003 ¶¶ 305–306, 311–315). With respect to the use of Sharpe’s username as the “pictured user unique identifier” of limitation 6e, we find persuasive Petitioner’s showing that one of ordinary skill in the art would have found it an obvious design choice to use Sharpe’s unique username as the identifier, because it was a known design choice, because users already would have had a username, and because each username would have been unique. *See id.* at 31–32 (citing Ex. 1003 ¶¶ 307–309). While Patent Owner argues that Petitioner did not sufficiently present an argument that the username would have been an obvious design choice until Petitioner’s Reply (PO Sur-reply 2 (citing Reply 3)) we find that this argument was presented in substantially the same form in the Petition (Pet. 31–32), and on the evidence before us, we find it to be persuasive. Dr. Bederson’s testimony, which we credit, reveals that selecting the username as a primary key is the most obvious design choice because it is a unique identifier already required by Sharpe and would be suitable for specifying a relationship between a particular user and a particular image in Sharpe’s database. Ex. 1003 ¶¶ 307–308; Ex. 1039 ¶¶ 7–8.

Accordingly, we determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claim 6 has been taught or suggested by Sharpe. Further, that Petitioner has shown by a preponderance of the evidence that it would have been an obvious design choice for a person having ordinary skill in the art to select Sharpe’s username as the “pictured unique identifier” as argued by Petitioner. Thus,

Petitioner has demonstrated by a preponderance of the evidence that claim 6 is unpatentable under § 103 as being obvious over Sharpe.

4. *Claim 7*

Claim 7 depends from claim 6, and adds additional limitations regarding obtaining and storing identification data from a second tagging user. Ex. 1001, 18:13–35. With respect to Claim 7, Petitioner argues that “a second user could . . . identify additional users in an image as part of the associated index information used for archival and retrieval of images in Sharpe’s system, as discussed” for limitations 6e and 6f of claim 6. Pet. 39 (citing Ex. 1003 ¶¶ 327, 331). Petitioner cites Sharpe’s discussion of the use of its system by “strong social groups” and that the groups would “work together” on the digital media item collections. *Id.* at 38 (citing Ex. 1005, 1:22–27, 2:27–41, 4:21–37, 5:4–18, 5:50–67; Ex. 1003 ¶¶ 325–326).

Patent Owner refers to its arguments with respect to limitation 6e of claim 6, addressed above. PO Resp. 24. Patent Owner additionally argues that “Sharpe’s mere disclosure of members working together does not equate to Sharpe disclosing or suggesting obtaining identification data from a second tagging user, where the identification data comprises the *same* unique image identifier . . . and an *additional* pictured user unique identifier of a user pictured in the *same* image data.” *Id.* at 25.

We agree, however, with Petitioner’s argument that additional users in an image could be identified by a second tagging user. *See* Pet. Reply 4–5; Pet. 38–39. We find persuasive Dr. Bederson’s uncontroverted testimony that one of ordinary skill in the art would have understood that two members of the same group would perform the same user identification tasks, such as identifying additional users in an image as part of the associated index information used for retrieval in view of Sharpe’s teaching that “members of

the private group work together” on a group of digital media items to “collectively represent the culture of the group.” Ex. 1001, 5:6–14; Ex. 1003 ¶ 327. And, as discussed above, we agree with Petitioner’s showing with respect to the acts of obtaining and storing identification data generally. *See supra* § II.D.3.

Accordingly, we determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claim 7 has been taught or suggested by Sharpe and that claim 7 is unpatentable under § 103 as being obvious over Sharpe.

5. *Claims 1, 3, and 8*

We determine dependent claims 1, 3, and 8 to be unpatentable under the ground of obviousness over Sharpe and Eintracht, *see infra* Section II.E, and we do not address the question of obviousness over Sharpe alone. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding that petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Boston Scientific Scimed, Inc. v. Cook Grp. Inc.*, 809 F. Appx. 984, 990 (Fed. Cir. 2020) (non-precedential) (recognizing that the “Board need not address issues that are not necessary to the resolution of the proceeding” and, thus, has “discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”).

E. *Challenge to Claims 1–8 as Obvious Over Sharpe and Eintracht*

1. *Eintracht – Overview*

Eintracht is titled “Synchronizing/Updating Local Client Notes With Annotations Previously Made by Other Clients in a Notes Database.” Ex. 1006, code (54). Eintracht describes a system for collaborative document annotation based on the exchange of notes (i.e., annotations)

attached to web-based documents such as an images or text documents, whereby multiple notes clients may annotate a document asynchronously with respect to each other. *Id.* at code (57), 1:8–13. “In order to differentiate between notes generated by various users, each user chooses a unique user ID that forms a Note Owner identifier.” *Id.* at 8:8–11.

2. *Motivation to Combine Sharpe and Eintracht*

Petitioner argues that one of ordinary skill in the art would have combined “Eintracht’s asynchronous annotation capability and groupware features” to “improve[] the collaborative archival system of Sharpe.” Pet. 59–63. Petitioner contends that one of ordinary skill in the art would have “understood that, as a web-based, multi-user application, Sharpe’s system would need to address the situation where two or more users from the same group seek to index the same image simultaneously from different devices,” and would have found Eintracht to provide a solution. *Id.* at 60–61 (citing Ex. 1003 ¶¶ 144–146). Additionally, Petitioner contends that Eintracht would have disclosed features of groupware applications not described in Sharpe, which described “[s]torage and archiving techniques for digital media and corresponding retrieval techniques” as being “well known.” *Id.* at 61–62 (quoting Ex. 1005, 1:10–11; citing Ex. 1003 ¶ 147). Petitioner additionally argues that one of ordinary skill would have had a reasonable expectation of success in combining Sharpe and Eintracht, based on the similarities between the systems. *Id.* at 62–63 (citing Ex. 1003 ¶¶ 148–149).

Patent Owner argues that Eintracht is related to collaborative document annotation, and Sharpe to archiving and retrieving digital media items, and that the references “are aimed at solving different problems.” PO Resp. 52–54 (citing Ex. 2021 ¶¶ 108–110); PO Sur-reply 14–15. Patent Owner additionally argues that there is no explanation presented of how the

combination would operate. PO Resp. 54–55; PO Sur-reply 15–18. However, we are persuaded by Petitioner’s contentions that each is a collaborative system that allows archiving and retrieval of digital documents. *See* Pet. 61–62; Pet. Reply 18; Ex. 1006, 6:55–7:23; Ex. 1005, 3:45–56. Additionally, we note that a determination of obviousness does not require that each reference address the same problem or goal. Rather, “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 550 U.S. at 420.

With respect to the operation of the combination, we credit Dr. Bederson’s testimony that the combination could have been successfully achieved due to the similarities in the systems, and regarding the specific modifications proposed. Ex. 1003 ¶¶ 143, 148–149 (illustrating structural similarities between Sharpe and Eintracht, discussing the client experience and functional similarities), 174–175, 252–254, 258, 272, 348–350.

3. Claims 6 and 7

With respect to claims 6 and 7, Petitioner’s arguments regarding unpatentability over Sharpe and Eintracht are presented to provide additional teachings from Eintracht to further support unpatentability, with respect to several limitations of these claims. Pet. 63–65. As we have found Sharpe teaches or suggests these limitations, we do not address the teachings found in the proposed combination for claims 6 or 7.

4. Claim 8

Claim 8 is dependent from claim 7 and adds the following limitations: “receiving a request for said image data from a viewing user of said computer network,” and “displaying list of pictured users of said network

that have been identified by said first tagging user and said second tagging user in said image data.” Ex. 1001, 18:36–41.

With respect to the first additional limitation of claim 8, Petitioner argues that Sharpe discloses an image retrieval process as depicted in Figure 4 and described in Figure 7. Pet. 39–42 (citing Ex. 1005, 5:46–48, 6:58–65, 7:25–31, 8:45–67, 9:4–9, 9:12–32, Fig. 4, Fig. 7; Ex. 1003 ¶¶ 334–345), 66 (referring back to the argument over Sharpe alone for the first limitation of claim 8 in the Sharpe/Eintracht ground). Figure 7 of Sharpe describes that a user sets retrieval parameters and the system identifies and displays a predetermined number of items. Ex. 1005, 9:12–20, Fig. 7; Ex. 1003 ¶¶ 335–337.

For the second limitation, regarding the associations between photos retrieved as a result of the request and pictured users, Petitioner relies on its arguments with respect to Sharpe’s teaching of the entry of information associating users to media items. Pet. 40–41. Petitioner argues that, in Sharpe, a user can select group members as retrieval parameters and the system will display pictures based on these parameters. *Id.* (citing Ex. 1005, 6:28–32, 6:63–7:1, 7:25–31, 8:12–27, 9:4–9, 9:12–32, Fig. 4, Fig. 7; Ex. 1003 ¶ 339).

Regarding the disclosure of “displaying [a] list of pictured users,” Petitioner argues that Eintracht’s user interface provides a list of annotations alongside and overlaid on an image, along with a “Note List window” that displays a list of the annotations associated with a displayed image. *Id.* at 66–68 (citing Ex. 1006, 7:5–23, Fig. 1C, Fig. 2; Ex. 1003 ¶¶ 346–350). The annotations, Petitioner argues, would have include the archived descriptive information, such as Sharpe’s associations created between an image and the pictured users, in a combination with Sharpe. *Id.* at 71–72 (citing Ex. 1003

¶¶ 346–348). Petitioner argues that this would have improved Sharpe’s interface by providing a list of pictured users in context with the images displayed in the work space of Sharpe, and would have added clarity to the interface. *Id.* at 71 (citing Ex. 1003 ¶ 349). Petitioner argues that one of ordinary skill in the art would have had a reasonable expectation of success in combining these UI elements. *Id.* at 71 (citing Ex. 1003 ¶ 350).

For claim 8’s first limitation, Patent Owner refers to arguments related to its claim construction for “a request for said image data,” which we did not adopt (as discussed in Section II.C.2) and on other arguments addressed above. PO Resp. 28–32. Patent Owner presents no additional argument, other than arguments previously addressed herein, regarding the obviousness of claim 8’s second limitation over Sharpe and Eintracht. *Id.* at 51–61.

We find Petitioner’s contentions to be supported by the record evidence and sufficiently articulated in the Petition. The evidence shows that Sharpe teaches image retrieval processes which allow a viewing user to make a request for images. Ex. 1005, 5:46–48, 6:58–65, 7:25–31, 8:45–67, 9:4–9, 9:12–32, Fig. 4, Fig. 7; Ex. 1003 ¶¶ 334–345. As previously discussed, we agree that Sharpe stores associations between images and pictured users. *See supra* § II.D.3.c. We find persuasive Petitioner’s argument that claim 8’s display of a list of pictured users would have been obvious over a combination of Sharpe and Eintracht, as Eintracht’s annotations and Note List window would display annotation information regarding pictured users in the retrieved images. Ex. 1006, 7:5–23, Fig. 1C, Fig. 2; Ex. 1003 ¶¶ 346–350

Accordingly, we determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claim 8 has been taught

or suggested by Sharpe and that claim 8 is unpatentable under § 103 as being obvious over Sharpe.

5. *Independent Claim 1*

Claim 1 contains limitations similar to those in claims 6–8, and for certain elements of claim 1, the Petition refers to and/or restates the arguments with respect to these claims. Pet. 42–58, 68–71. With the exception of the last two limitations of claim 1, we refer to the arguments of the parties regarding obviousness over Sharpe, as we find Sharpe to teach each of those limitations. With respect to the last two limitations of claim 1, these are materially similar to those limitations added in claim 8, and we rely on Petitioner’s arguments regarding Sharpe and Eintracht.

In addition to limitations similar to those in claims 6–8, claim 1 additionally recites the step of “receiving from a first tagging user a request to identify users of said computer network in said image data wherein said request contains said image identification and the user identification of said first tagging user.” Ex. 1001, 16:38–41 (“limitation 1d”). Petitioner argues that Sharpe teaches this limitation in its teaching that a user identified with a group can retrieve images “to be archived” for that group, including by submitting a request to retrieve the images, in order to identify users. Pet. 45 (citing Ex. 1005, 1:42–47, 2:39–50, 3:57–63, 5:4–6, 5:46–48, 6:58–7:31, 7:35–44, 8:45–67, 9:4–32, Fig. 4, Fig. 7; Ex. 1003 ¶¶ 186–187). Petitioner argues that one of ordinary skill in the art would have understood that Sharpe’s work space would initially be empty, and that the user would use controls including a “retrieve” button in the workspace in order to load images into the work space. *Id.* at 45–48 (citing Ex. 1003 ¶¶ 187–191). Petitioner contends that one of ordinary skill would have understood that when images were requested as a result of the retrieve button, a request

would include the username of the requesting user. *Id.* at 49 (citing Ex. 1003 ¶ 193). Petitioner additionally argues that Sharpe teaches archiving media items in a trail and requesting media items in the trail, and that when a user had selected a media item and requested items in the trail, the request would additionally include an item identifier (that of the selected media item). *Id.* at 49–51 (citing Ex. 1005, 3:15–20, 7:19–27, Fig. 4; Ex. 1003 ¶¶ 194–195).

Claim 1 additionally recites the step, “responsive to said request,” in which the method further comprises “presenting a client interface to said first tagging user configured to provide identifying information, wherein said identifying information comprises a user identification of a first pictured user of said computer network and said image identification.” Ex. 1001, 16:42–46 (“limitation 1e”). Petitioner argues that the presentation of media responsive to the request discussed with respect to limitation 1d of claim 1 would be presented to the user of Sharpe in the work space, and that the user can then enter information regarding media items selected for retrieval. Pet. 51–53 (citing Ex. 1005, 1:66–2:9, 6:58–7:24, 8:15–27, 8:30–36, Fig. 4, Fig. 6e; Ex. 1003 ¶¶ 202–205). Petitioner specifically argues that the list of people in drop down box 55 is sourced from database 3 of Sharpe, which includes the usernames of Sharpe, and these are used in the archived associated information when the user makes an identification using the client interface in Sharpe. *Id.* at 52–53 (citing Ex. 1005, 6:68–7:24, 8:15–27, 8:30–36, Fig. 6e; Ex. 1003 ¶¶ 204–205).

In addition to arguments reiterating or referencing arguments regarding to similar recitations in claims 6, 7, or 8 and addressed above, Patent Owner argues that the request in limitation 1d of claim 1 is not taught by Sharpe because “Sharpe’s user is not described as requesting a specific

image, nor does the user supply an image identifier as required by limitation 1[d].” PO Resp. 37. Patent Owner additionally argues that Sharpe does not teach the use of a username of the requesting user, as the usernames would not be shown in the drop down box 55 of the Sharpe work space. *Id.* at 41. Addressing Petitioner’s argument that a request for a trail is a request including an image identifier, Patent Owner argues that this does not constitute a “request to identify users . . . in said image data” but rather a request for a trail. *Id.* at 40–41; PO Sur-reply 9–10.

We find Petitioner’s contentions to be supported by the record evidence. With respect to the limitations of claim 1 that are not substantially similar to those in claims 6–8, Petitioner has shown that the request for a trail in Sharpe would be based on an image identifier in Sharpe, and thus that a request for a trail would teach or suggest the request of limitation 1d. Pet. 49–51 (citing Ex. 1005, 3:15–20, 7:19–27, Fig. 4; Ex. 1003 ¶¶ 194–195). Additionally, while Patent Owner argues that “Sharpe only teaches the user name for the purpose of a user identifying himself/herself as a member of a group,” (PO Resp. 41) we find persuasive Petitioner’s showing regarding the use of the username in the request for a trail, as Sharpe describes retrieval by “members” of “the contents of the group archive” including following predefined trails, and thus the user’s identity as a member of the group would be identified. Pet. 49; Ex. 1005, 8:45–67; Ex. 1003 ¶ 193. With respect to the purpose of the request, while other reasons for a trail request may be taught by Sharpe, Petitioner has shown that a user may, upon requesting images, associate information with the images (including the image used to retrieve the trail) by adding information in the workspace. Pet. 51–53; Ex. 1005, 6:58–7:24; Ex. 1003 ¶¶ 194, 202–205.

Accordingly, we determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claim 1 has been taught or suggested by Sharpe and Eintracht, and that claim 1 is unpatentable under § 103 as being obvious over Sharpe and Eintracht.

6. *Claim 2*

Claim 2 depends from claim 1, and further provides that the method of claim 1 comprises “receiving location information that identifies coordinates of where the pictured users associated with said pictured user identifications appear within said image data.” Ex. 1001, 17:17–20.

Petitioner contends that, in the proposed combination of Sharpe and Eintracht, a note anchor, expressed in terms of coordinates in the annotated page of the document would be created using the annotation tool, and that such an annotation could be used to identify pictured users in an image. Pet. 72–73 (citing Ex. 1006, *inter alia*, 2:53–55, 6:55–7:23, 7:55–64, 15:10–16; Ex. 1003 ¶¶ 255–258).

Patent Owner contends that Eintracht discloses annotations displayed over the image, which “provides the specific location in a document associated with the note” but “does not disclose coordinates corresponding to a location of a named user in the image.” PO Resp. 57–58 (citing Ex. 2021 ¶¶ 114–117); PO Sur-reply 19. Additionally, Patent Owner argues that the proposed combination has a “detrimental result of potentially obscuring the user from view and cutting against Sharpe’s focus on identifying users within images. PO Resp. 57–58; PO Sur-reply 19.

While we agree with Patent Owner that Eintracht does not disclose storing coordinates corresponding to a location of a named user in an image, this conclusion addresses only Eintracht’s disclosures and not the teaching of the proposed combination, in which Sharpe’s identification of users in

images is combined with Eintracht's annotation tool that includes coordinates for annotations. And, with respect to Patent Owner's arguments regarding annotations obscuring the user and Dr. Saber's testimony that "[i]mplementing coordinate-related functionality from Eintracht in Sharpe's system would not be predictable or desirable" we credit Dr. Bederson's uncontroverted testimony that one of ordinary skill in the art could have implemented Eintracht's annotations without obscuring users, including by using tool tip annotations or transparency. Pet. Reply 22 (citing Ex. 1039 ¶¶ 40–42).

Accordingly, after considering the record, we find Petitioner has shown by a preponderance of the evidence that Eintracht's note anchor / coordinates could have been used with the Sharpe image annotation system, and that claim 2 would have been obvious over this combination.

7. *Claim 3*

Dependent claim 3 depends from claim 1 and further limits the method of claim 1 to include, responsive to a recited request to identify users, "presenting a client interface enabling said [tagging user] to select said pictured user's identification from a list of contacts associated with said [tagging user's] identification." Ex. 1001, 17:20–29.

Petitioner asserts that Sharpe teaches "presenting [an] interface enabling tagging user to select said pictured user's identification from list of contacts" in the disclosure of UI allowing a user to select from a drop down box with individuals in a group of people to associate with an image. Pet. 58–59 (citing Ex. 1005, 6:58–7:1, 8:26–27, Fig. 4; Ex. 1003 ¶¶ 262–264). Patent Owner presents no additional arguments with respect to Claim 3.

We are persuaded by Petitioner's arguments and cited evidence that Sharpe's drop down box in its work space teaches or suggests this additional

limitation. Accordingly, we determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claim 3 has been taught or suggested by Sharpe and Eintracht and that claim 3 is unpatentable under § 103 as being obvious over Sharpe and Eintracht.

8. *Claim 4*

Claim 4 depends from claim 2, and provides that the step of “displaying list of pictured users of said network that have been identified . . . in said image data” further comprises “display[ing] said coordinates of said pictured users in said image data.” Ex. 1001, 17:29–33.

Petitioner argues, and we agree, that the display of the annotation at the stored coordinates in the proposed combination discussed with respect to claim 2 teaches or suggests the display of the coordinates of the pictured user in an image. Pet. 73–74 (citing Ex. 1006, 2:53–55, 7:1–5, 15:10–18, Fig. 1B; Ex. 1003 ¶¶ 268–269). Patent Owner presents no additional arguments with respect to Claim 4. PO Resp. 60; PO Sur-reply 19.

Accordingly, we determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that claim 4 would have been obvious over the proposed combination of Sharpe and Eintracht.

9. *Claim 5*

Claim 4 depends from claim 1, and provides that “upon obtaining said pictured user identification associated with said image identification from a first tagging user or a second tagging user, an email is sent to any email address associated with said pictured users identifications, said email notifying said pictured users that their user identification has been associated with said image data.” Ex. 1001, 17:34–40.

Petitioner contends that the combination of Sharpe with Eintracht teaches the additional limitation of claim 5, because Eintracht teaches that

new or changed annotations can trigger email annotations to specific users. Pet. 74–75 (citing Ex. 1006, 2:59–3:4, 8:63–66, 10:5–16; 11:7–11; Ex. 1003 ¶¶ 271–272). Petitioner cites Dr. Bederson’s testimony that one of ordinary skill would have understood that Eintracht’s notifications can be triggered by an annotation identifying a user, and could be filtered to the identified users. *Id.* at 75 (citing Ex. 1003 ¶ 272). Petitioner argues that only a person of ordinary skill’s ordinary creativity would be necessary to reach this limitation in view of these teachings. Pet. Reply 23.

Patent Owner argues that Eintracht’s notifications do not relate to information sent to a user with information about an association of a user with an image, but rather relate to database changes or note events. PO Resp. 60–61 (citing Ex. 1006, 2:65–68, 10:5–11; Ex. 2021 ¶ 120); PO Sur-reply 19–21. Patent Owner argues that in Eintracht, no association exists between an annotation and a user, even if the user was described in the annotation. PO Sur-reply 20. However, we credit Dr. Bederson’s testimony regarding the combination of Sharpe and Eintracht as teaching an email identification to an identified user triggered by an annotation identifying the user in the image. Ex. 1003 ¶ 272. Dr. Saber’s declaration does not relate to the combination but discusses the teachings of Eintracht alone. Ex. 2021 ¶ 120. We determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that claim 5 would have been obvious over the proposed combination of Sharpe and Eintracht.

F. Challenges to Claim 3 as Obvious Over Sharpe and Carey or as Obvious over Sharpe, Eintracht, and Carey

The Petitioner additionally includes challenges to claim 3 as obvious over the combination of Sharpe and Carey or over the combination of Sharpe, Eintracht, and Carey. Pet. 75–79. However, as we have found the

proposed combination of Sharpe and Eintracht teaches or suggests the subject matter of claim 3, we do not address Petitioner's assertions regarding these proposed combinations.

III. CONCLUSION

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 3, 6–8	103 ⁷	Sharpe	6, 7	
1–8	103 ⁸	Sharpe, Eintracht	1–5, 8	
3	103 ⁹	Sharpe, Carey		
3	103 ¹⁰	Sharpe, Eintracht, Carey		
Overall Outcome			1–8	

IV. ORDER

For the foregoing reasons, it is:

ORDERED that, Petitioner has shown by a preponderance of the evidence that claims 1–8 of U.S. Patent No. 8,954,432 B2 are unpatentable; and

⁷ Because we determine claims 1, 3, and 8 unpatentable over Sharpe and Eintracht, we do not reach it in this asserted obviousness contention.

⁸ Because claims 6 and 7 have been determined to be unpatentable over Sharpe, we do not reach them in this asserted obviousness contention.

⁹ Because this claim has been determined to be unpatentable over Sharpe, we need not reach this asserted obviousness contention.

¹⁰ Because this claim has been determined to be unpatentable over Sharpe, we need not reach this asserted obviousness contention.

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

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