

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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META PLATFORMS, INC.,  
Petitioner,

v.

ANGEL TECHNOLOGIES GROUP LLC,  
Patent Owner.

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IPR2023-00058  
Patent 9,959,291 B2

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

FENICK, *Administrative Patent Judge*.

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

## I. INTRODUCTION

### A. *Background and Summary*

Meta Platforms, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–26 (“challenged claims”) of U.S. Patent No. 9,959,291 B2 (Ex. 1001, “the ’291 patent”). Angel Technologies Group LLC (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). With our prior authorization (Ex. 1036), Petitioner filed a Preliminary Reply (Paper 14, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 15, “Prelim. Sur-reply”).

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). For the reasons below, Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we institute an *inter partes* review of the challenged claims on all grounds raised in the Petition.

### 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 this case has been filed with the Federal Circuit. Pet. 2–3.

Petitioner and Patent Owner additionally identify IPR2023-00057 (challenging claims of U.S. Patent 8,954,432 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 pending related *inter partes* review requests. *Id.* at 3; Paper 4, 2.

#### *D. The '291 Patent*

The '291 patent is titled “Users Tagging Users in Media 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), 1:19–25. The '291 patent issued from an application filed October 15, 2013, and claims priority to an application filed November 15, 2001, and to a provisional application, No. 60/248,994 (Ex. 2017) (“the '994 provisional”), filed on November 15, 2000. *Id.* at codes (22), (60), (63), 1:6–15; Ex. 2017.

The '291 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, 1:35–2:6. However, the '291 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 2:7–35, 2:49–3:9, 3:17–25; 3:31–40.

The '291 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 5:41–55, 7:10–57. The '291 patent specification describes that the information can be stored in one or more databases. *Id.* at 7:12–14. “For instance, the system may utilize a users database 230, Identifications database 240, and Images database 250 as depicted in FIG. 2.” *Id.* at 7:14–16. Figure 2, reproduced below, is a schematic diagram of the databases according to one embodiment of the invention. *Id.* at 4:47–48.

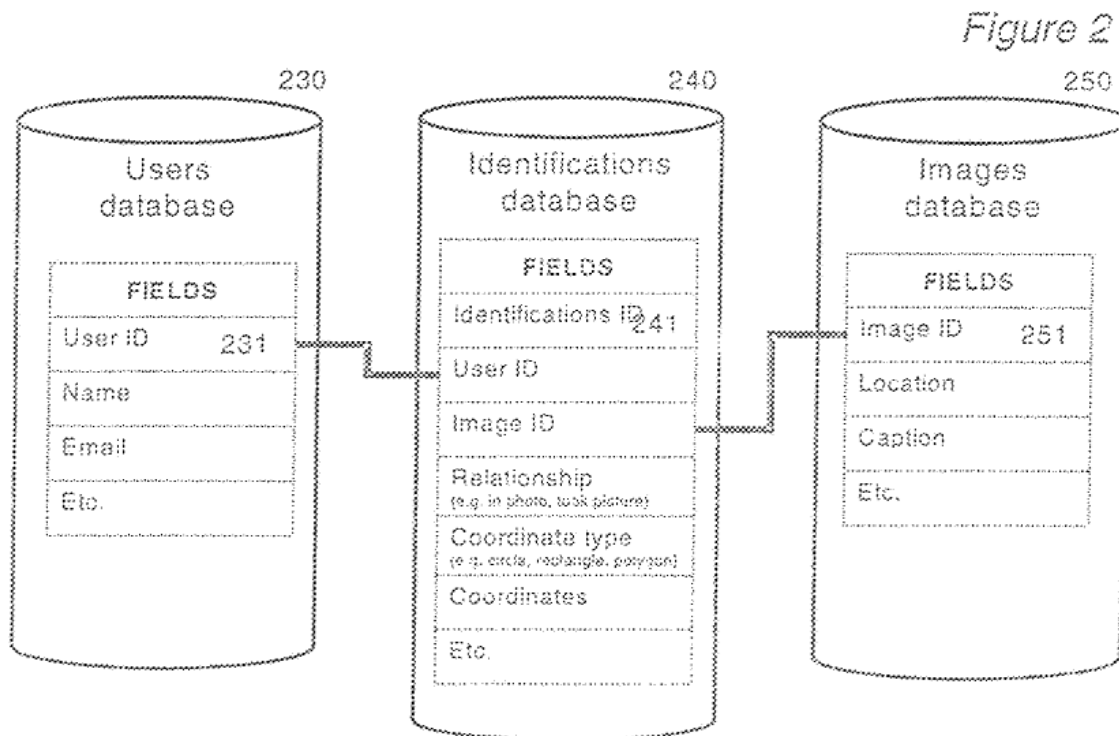


Figure 2 depicts users database 230, identifications database 240, and images database 250, with the fields used in each database, and shows that identifications database 240 links information in users database 230 with information in images database 250. *Id.* at 7:14–57.

Users database 230 stores information about people or other objects identified within images. *Id.* at 7:18–21. 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 7:18–25, 9:29–36. Users may enter other users as contacts. *Id.* at 9:36–46.

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 7:27–44, 9:47–59.

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 7:45–57, 8:11–30, 8:51–61, 9:59–62. The location of the person in the photo may also be specified in the identifications database. *Id.* at 8:15–30. Web pages that permit users to identify people or other objects within photos are presented to obtain identifying information. *Id.* at 10:10–18, 11:56–59. The location of a user in an image may also be captured in such a page. *Id.* at 11:64–12:20. Figure 4, reproduced below, is an example of such an “identifying page.” *Id.* at 10:19–20.

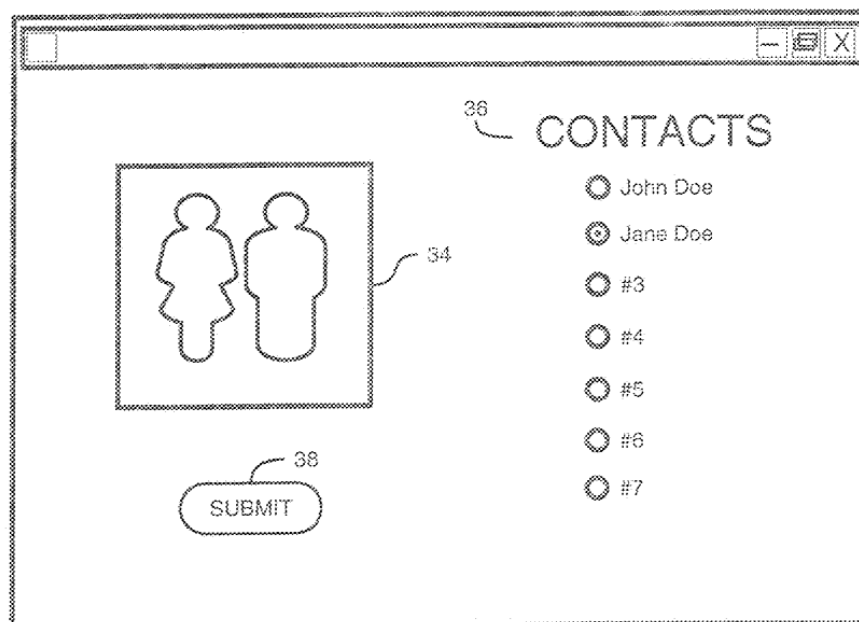


Figure 4 is a web page that presents photo 34, list of contacts 36 labelled “CONTACTS” and including seven options and radio buttons, and submit button 38. *Id.* at 10:20–22. The list of contacts may be selected from among the objects and users listed in users database 230 or may optionally be a filtered list from user database 230, for example, a list of user contacts. *Id.* at 11:13–17. 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 10:11–16, 10:46–52, 12:36–13:13.

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 8:62–9:22, 13:44–16:30.

*E. Illustrative Claim*

Claims 1, 24, 25, and 26 are independent, claims 2–23 are dependent. Independent claim 26 is illustrative, and is reproduced below with limitation identifiers in brackets.

26. [26pre] A method implemented within a computer system including a plurality of computing devices connected via a communications network, the method associating users of the computer system with digital media accessible to the computer system, the method comprising:

[26a] distinguishing between users of the computer system via one or more unique user identifiers stored in a computer-readable medium accessible to the computer system, the users including a named user and an identifying user, the named user being different from the identifying user, the named user having naming information associated with a unique user identifier of the named user;

[26b] in response to an input from the identifying user indicating a selection of an item of digital media,

determining a unique digital media identifier corresponding to the digital media selected;

[26c] receiving, from the identifying user, an input indicating a selection of the named user from a list of other network users, the list of other users including naming information previously provided by other users, the list of other users including one or more users in a contact list associated with the identifying user, the identifying user's contact list including the named user;

[26d] in response to receiving from the identifying user the input indicating the selection of the named user from the list of other users, determining a unique user identifier of the named user; and

[26e] storing an association between a unique user identifier of the named user and a unique digital media identifier corresponding to the digital media selected.

Ex. 1001, 26:30-60; Cert. of Corr.

*F. Prior Art and Asserted Grounds*

Petitioner asserts that claims 1–26 would have been unpatentable on the following grounds:

| <b>Claim(s) Challenged</b> | <b>35 U.S.C. §<sup>1</sup></b> | <b>Reference(s)/Basis</b>      |
|----------------------------|--------------------------------|--------------------------------|
| 1, 5, 10-26                | 103                            | Sharpe <sup>2</sup>            |
| 1–26                       | 103                            | Sharpe, Eintracht <sup>3</sup> |
| 18, 19, 26                 | 103                            | Sharpe, Carey <sup>4</sup>     |
| 18, 19, 26                 | 103                            | Sharpe, Eintracht, Carey       |

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<sup>1</sup> 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 ’291 patent claims priority to an application 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); *see* Pet. 5 nn.1–3 (applying pre-AIA statutes).

<sup>2</sup> Sharpe et al., US Patent 7,461,099 B1 (iss. Dec. 2, 2008) (Ex. 1005).

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

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

Petitioner additionally relies on a declaration of Dr. Benjamin B. Bederson (Ex. 1003).

## 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, 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.<sup>5</sup> *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 additional education could likewise substitute for less experience.” Pet. 13–14 (citing Ex. 1003 ¶¶ 37–43).

Patent Owner contends that a person of ordinary skill in the art “would have a bachelor’s degree in computer science, electrical engineering, or computer engineering, and at least two years of experience designing Web-based media applications.” Prelim. Resp. 15.

We note that the two proposed definitions are similar, with Patent Owner’s slightly more narrowly drawn, limiting the subject of the bachelor’s degree and not providing that more experience might substitute for less education or more education for less experience. For the purpose of institution, we adopt Petitioner’s provided definition for the level of skill of a person of ordinary skill in the art, modified to remove the open-ended term “at least” in two places, to avoid providing no upper bound to the level of skill considered. *See Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 697 (Fed. Cir. 1983) (Considering obviousness to an ordinarily skilled person rather than “to the judge, or to a layman, or to those skilled in remote

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<sup>5</sup> On the current record, no party has raised any arguments relating to objective evidence of nonobviousness. *See* Pet. 77.

arts, or to geniuses in the art at hand”). We view this definition as reasonable and consistent with the prior art, and it is supported by the testimony of Dr. Bederson.

*C. Claim Construction*

Petitioner discusses the construction of the following claim terms: “user identifier” (all claims) and “contact” (in claim 26). Pet. 14–16. Petitioner argues that each should be given their ordinary meaning in the context of the ’291 patent. *Id.* For “user identifier,” Petitioner argues that the ordinary meaning is “a series of characters identifying a user.” *Id.* at 14–16 (citing Ex. 1001, 7:58–60, 8:1–3; Ex. 1003 ¶¶ 62–64). For “contacts,” Petitioner argues that the ordinary meaning is “people known to the user.” *Id.* at 15–16 (citing Ex. 1001, 9:36–37, 9:39–42; Ex. 1003 ¶¶ 65–67).

Patent Owner argues that no claims require express construction. Prelim. Resp. 15. Patent Owner additionally argues that the claims should be construed according to their broadest reasonable interpretation. *Id.* at 31. However, 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). 37 C.F.R. § 42.100(b) (2019). We use this claim construction standard, as articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny.

Patent Owner additionally argues that the Petition should be denied because the Petitioner did not provide evidence to support its claim construction. *Id.* at 29–31. Patent Owner asserts that “Dr. Bederson did not opine on this topic.” *Id.* at 30. However, as Patent Owner acknowledges, Petitioner does cite evidence, including in the form of Dr. Bederson’s declaration, regarding the claim construction. *See id.* at 31 (discussing Dr.

Bederson’s declaration opinions relating to the construction of “user identifier”); Pet. 13–14 (citing Ex. 1001, 77:58–60, 8:1–3, 9:36–37, 9:39–46; Ex. 1003 ¶¶ 62–67). Patent Owner further asserts that Petitioner does not “explain *why* . . . the claim construction is necessary in the first place.” Prelim. Resp. 31. We agree that Petitioner does not appear to use the claim constructions it discusses in its unpatentability arguments, and thus that they appear to be superfluous to the arguments in the Petition. However, we do not agree with Patent Owner’s statement (without further explanation) that “[t]he Petition’s failure to provide a proper claim construction resulted in numerous deficiencies in the presented grounds of unpatentability.” *Id.* at 31.

“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)). In this case, no claim terms require construction to reach our decision to institute, and therefore we do not provide any constructions here.

*D. Challenge to Claims 1, 5, and 10–26 as Obvious over Sharpe*

Petitioner argues that claims 1, 5, and 10–26 would have been obvious over Sharpe. Pet. 22–59. Patent Owner argues that Sharpe does not qualify as prior art. Prelim. Resp. 16–29. Patent Owner additionally generally argues that Petitioner does not provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, and offers at best a conclusory comparison between the cited portions of the references and the claimed limitations. *Id.* at 32–34.

*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.

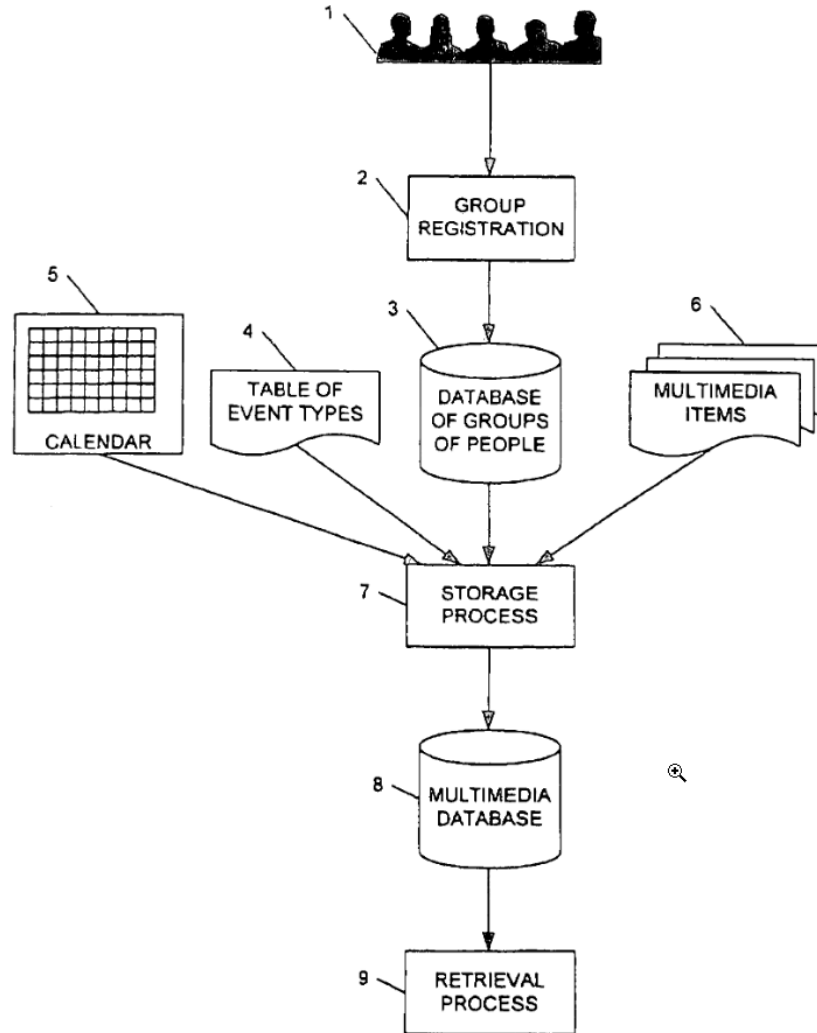


Fig 1

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.

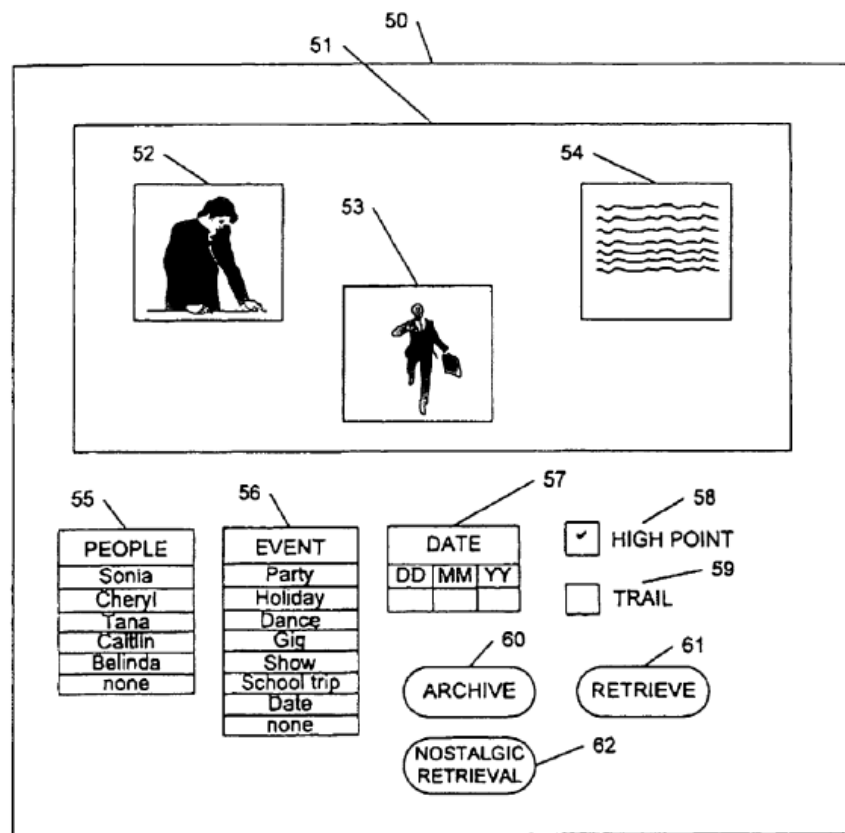


Fig 4

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. *Availability of Sharpe as Prior Art*

### a) *Legal Standards*

As reviewed above, in an *inter partes* review, the burden of persuasion is on the petitioner to prove unpatentability by a preponderance of the evidence, and that burden never shifts to the patent owner. *Dynamic Drinkware*, 800 F.3d at 1378. The petitioner has the initial burden of production to show that an asserted reference qualifies as prior art under 35 U.S.C. § 102. *Id.* at 1378–79. Once the petitioner meets the initial burden, a burden of production shifts to the patent owner to argue or produce evidence that either the asserted reference does not render the challenged claims unpatentable, or the reference is not prior art. *Id.* at 1379–80 (citing *Tech. Licensing Corp.*, 545 F.3d at 1327).

“Pre-AIA section 102(g) allows a patent owner to antedate a reference by proving earlier conception and reasonable diligence in reducing to practice.” *Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d

1004, 1007 (Fed. Cir. 2016). This can be done by showing that the invention was conceived before the effective date of the reference, with diligence to actual or constructive reduction to practice. *Id.*; *In re Steed*, 802 F.3d 1311, 1320 (Fed. Cir. 2015) (citing 37 C.F.R. § 1.131). In an *inter partes* review, “a patent challenger has the burden of producing evidence to support a conclusion of unpatentability under § 102 or § 103,” but a patentee that “affirmatively seeks to establish a proposition not relied on by the patent challenger and not a necessary predicate for the unpatentability claim asserted,” such as establishing the benefit of an earlier priority date for the challenged claims, bears the burden with respect to establishing that proposition. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375–76 (Fed. Cir. 2016) (citing *Dynamic Drinkware*, 800 F.3d at 1379).

“To antedate (or establish priority) of an invention, a party must show either an earlier reduction to practice, or an earlier conception followed by a diligent reduction to practice.” *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 237 F.3d 1359, 1365 (Fed. Cir. 2001). “The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application.” *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998); *Frazer v. Schlegel*, 498 F.3d 1283, 1288 (Fed. Cir. 2007).

When evaluating diligence, we are mindful of the guidance of our reviewing court that we must not apply a standard that is “too exacting” or “too rigid.” *Perfect Surgical*, 841 F.3d at 1008; *Arctic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1331 (Fed. Cir. 2019). Though “periods of inactivity within the critical period do not automatically vanquish a patent owner’s claim of reasonable diligence,” *Arctic Cat*, 919 F.3d at 1331, “[m]erely asserting diligence is not enough” and a party must “account for

the entire period during which diligence is required.” *In re Meyer Mfg. Corp.*, 411 F. App’x 316, 319 (Fed. Cir. 2010). “[D]iligence need not be perfectly continuous—only reasonably continuous.” *Arctic Cat*, 919 F.3d at 1331 (emphasis omitted). The key question for diligence is whether, “in light of the evidence as a whole, the invention was not abandoned or unreasonably delayed.” *Id.* (internal quotations omitted).

“Priority of invention and its constituent issues of conception and reduction to practice are questions of law predicated on subsidiary factual findings.” *Singh v. Brake*, 317 F.3d 1334, 1340 (Fed. Cir. 2003). “[C]onception must encompass all limitations of the claimed invention . . . and ‘is complete only when the idea is so clearly defined in the inventor’s mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.’” *Id.* (quoting *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994)). To establish an actual reduction to practice, Patent Owner must prove that: (1) an embodiment of the invention was performed that met all the limitations of the claims at issue; and (2) the inventor determined that the invention would work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998).

In addition, a showing of prior invention requires corroboration. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996). “Sufficiency of corroboration is determined . . . using a ‘rule of reason’ analysis, under which all pertinent evidence is examined when determining the credibility of an inventor’s testimony.” *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1170 (Fed. Cir. 2006) (citing *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993)).

*b) Parties' Positions*

Petitioner argues that Sharpe qualifies as prior art due to its filing date of September 26, 2000. Pet. 5 n.1; Prelim. Reply 5; Ex. 1005, code (22). Petitioner's contention is based on its assertion that the challenged claims are entitled to an effective date of no earlier than November 15, 2000, which is the filing date of the '994 provisional, to which the '291 patent claims priority. Pet. 10; Ex. 1001, codes (60), (63), 1:6–15.

Patent Owner argues that Sharpe is not prior art because the challenged claims relate to an invention that was conceived of and reduced to practice before the September 26, 2000 filing date of Sharpe. Prelim. Resp. 16–28; PO Sur-reply 1–6.

Patent Owner submits a declaration by Marc Frigon, the named inventor of the '291 patent, in support of its position. Prelim. Resp. 20–21; Ex. 2005 ¶ 2. Patent Owner asserts that the '994 provisional had been prepared by August 15, 2000, and that this is shown in the file history of the provisional and via Mr. Frigon's declaration. Prelim. Resp. 20–21 (citing Ex. 2005<sup>6</sup> and Ex. 2017<sup>7</sup>). Specifically, Patent Owner states that Mr. Frigon "had signed the provisional application, fee transmittal, and small entity declaration by August 15, 2000." *Id.* at 20. "That August 15, 2000 signature in and of itself demonstrates that Sharpe is not prior art." Prelim. Sur-reply 1. Patent Owner additionally submits a declaration of Lisa Larson

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<sup>6</sup> While no specific reference is provided, this appears to relate to paragraph 3 of Mr. Frigon's declaration. *See* Ex. 2005 ¶ 3. Patent Owner should ensure that, going forward, specific citations are made to portions of any documents cited.

<sup>7</sup> While no specific reference is provided, this appears to relate to pages 2–4 of Ex. 2017 (cover page, fee transmittal, and small entity declaration for the '994 provisional) which include this date. *See* Ex. 2017, 2–4.

(Ex. 2018), which it cites as corroborating the August 15, 2000 date. Prelim. Resp. at 27 (citing Ex. 2018<sup>8</sup>). Patent Owner argues that the '994 provisional describes the invention, including “contact list” described in claim 26. Prelim Sur-reply 3.

In addition to constructive reduction to practice, Patent Owner argues actual reduction to practice prior to September 26, 2000. Prelim. Resp. 21–28. Patent Owner presents a table relating to the elements of claim 1 “through citations to Patent Owner’s software code,” which was “developed and was in-use on Patent Owner’s platform, cmalone.com, prior to Sharpe’s earliest priority date.” *Id.* at 21–26.

The citations in the support table provided describe what Patent Owner calls “April 2000 Program Code” in Exhibits 2006 through 2013. *Id.* Patent Owner also cites Mr. Frigon’s declaration that Patent Owner contends “shows that this code was integrated into a website for user access in August 2000, and was up and running in September 2000.” *Id.* at 26 (citing Ex. 2005<sup>9</sup>).

Patent Owner specifically cites Exhibit 2013 as a log file that demonstrates users using the system and being identified by client IP address and username. *Id.* at 22. Patent Owner cites Exhibit 2010<sup>10</sup> as demonstrating the presence of assigned unique identifier “Person\_ID” in a

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<sup>8</sup> While no specific reference is provided, this appears to relate to paragraph 6 of Ms. Larson’s declaration, in which she relates that she recalls Mr. Frigon drafting the application “in the August and September 2000 timeframe.” *See* Ex. 2018 ¶ 5.

<sup>9</sup> While no specific reference is provided, this appears to relate to paragraphs 16 and 17 of Mr. Frigon’s declaration, which describe “sacko.com” as operative before September 26, 2000. *See* Ex. 2005 ¶¶ 16, 17.

<sup>10</sup> We assume Patent Owner’s citations to Exhibit 2011 for this are an error; the citations to specific lines appear to relate to Exhibit 2010.

table to identify a user in a picture. *Id.* at 22. Patent Owner includes what appear to be a screenshots of a portion of a table that Patent Owner describes as “Picts” table in “pictures.mdb” database and cites Exhibit 2007, but Exhibit 2007 does not contain the depicted information. *Compare* Prelim. Resp. 24, *with* Ex. 2007. Patent Owner argues that “pict\_upd.asp.asp” contains code that updates an image record to store user identifiers. Prelim. Resp. 25–26.

Patent Owner argues that claim 24 is an apparatus corollary of the method of claim 1 and that claim 25 is a similar corollary to claim 1, and refers to its showing with respect to claim 1 as proving conception of claims 24 and 25. Prelim. Resp. 28–29. Additionally, Patent Owner contends that claims 2–23<sup>11</sup> “are patentable for the same reasons” as claim 1. Prelim. Resp. 29. Patent Owner does not address claim 26. *Id.* at 21–29; *see* Prelim. Sur-reply 7 (listing but not discussing support for claim 26).

Patent Owner cites, in support of its arguments of actual reduction to practice, a declaration of Chris Malone, who declares that he continuously was working on the photo-tagging technology beginning in 1998 or 1999 through 2000. Prelim. Resp. 26–27 (citing Ex. 2016); Ex. 2016 ¶¶ 3, 6. Mr. Malone testifies that by August of 2000, Mr. Frigon “had demonstrated to me his invention and its functionality.” Ex. 2016 ¶ 7. Patent Owner additionally cites Ms. Larson’s declaration, which describes Mr. Frigon as having “demonstrated the functionality of the invention and his website to me, including by having me register on his functional website as referenced

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<sup>11</sup> We assume that the inclusion of claim 24 in this argument is a typographical error. Prelim. Resp. 29.

in the emails submitted as Exhibit 2015 from September 28, 2000.”

Ex. 2018 ¶ 6; *see* Prelim. Resp. 27 (citing Ex. 2018).

Petitioner argues that Patent Owner has failed to antedate Sharpe. Prelim. Reply. With respect to conception and actual reduction to practice, Petitioner contends that Patent Owner’s evidence is insufficient. *Id.* at 2–5. Petitioner argues that “Mr. Frigon concedes that the conception evidence does not include the filtering of an input list of users to a contact list.” *Id.* at 3 (citing Ex. 2005 ¶ 12) (emphasis omitted). Petitioner additionally notes that the exhibit provided does not include data and shows only a single table. *Id.* at 4 (citing Ex. 2007). Petitioner further argues that the supporting evidence provided to corroborate the reduction to practice is “insufficiently specific” and describes only the purchase of web-authoring software as well as Ms. Larson and Ms. Malone’s user-facing experience with Mr. Frigon’s websites rather than the details of the claimed features. *Id.* (citing Ex. 2005 ¶ 16; Ex. 2014; Ex. 2016 ¶ 4; Ex. 2018 ¶ 6).

With respect to constructive reduction to practice, Petitioner argues that, given the assertion that the provisional application was complete and ready for mailing by August 15, 2000, Patent Owner provides no reasonable explanation for the delay in the critical period. *Id.* at 5–6. Petitioner contends that Patent Owner’s antedating argument must fail, because we “the Board has no basis to presume” that the ’291 patent is entitled to the priority date of the ’994 provisional, but Petitioner does not argue that the ’291 patent is not entitled to that priority date. *Id.* at 6–7.

Petitioner additionally faults Patent Owner’s antedating showing for being directed only to claim 1 and for not addressing claim 26, and argues that claims 2–25 include elements not included in claim 1, and that therefore

Patent Owner has not shown that any claim is entitled to an earlier priority date. *Id.* at 7.

*c) Analysis*

With respect to actual reduction to practice, on the present record, we determine that Patent Owner’s evidence does not establish a date of actual reduction to practice prior to the effective date of Sharpe. Patent Owner’s support chart with reference to claim 1 and Mr. Frigon’s work on websites and Mr. Frigon’s declaration do not clearly explain the interrelationships between the exhibits referenced. Ex. 2005 ¶¶ 5–12. Additionally, screenshots purporting to be the “Picts” table of “pictures.mdb” show data that does not appear to be present in Exhibit 2007. *Id.* ¶ 12. While Mr. Frigon argues that each of Exhibits 2006–2012 “provide code that was last modified on April 16, 2000,” this is corroborated only by a screenshot possibly relating to one of these exhibits. *Compare* Ex. 2005 ¶ 5 (metadata relating to a file “pictures.asp” (underlining added)), *with id.* ¶ 8 (describing “picture.asp”), Prelim. Resp. v (Patent Owner’s exhibit list identifying Ex. 2009 as “Picture.asp”). While we acknowledge that Patent Owner supplies evidence that may corroborate the inventor’s declaration, this evidence does not identify what was demonstrated to Mr. Sacko or Ms. Larson. *See* Ex. 2015; Ex. 2016 ¶¶ 4, 6, 7; Ex. 2018 ¶¶ 2, 6, 7. Additionally, as Petitioner points out, it is unclear in certain cases whether “cmalone.com” (*see* Prelim. Resp. 21; Ex. 2005 ¶¶ 5, 13; Ex. 2016 ¶ 3) or “sacko.com” (*see* Ex. 2005 ¶¶ 4, 17), is being referred to and it is unexplained what, if any, the distinctions are between these sites or changes (if any) which may have been made between the purported April 2000 date of the code and supporting materials provided and the implementation in these sites. Prelim. Reply 5–6. Because of these issues with support in the

relied-upon portions of the exhibits, the evidence does not show that an embodiment of the invention was performed that met all the limitations of claim 6, or of the other challenged claims.

Additionally, even assuming that the disclosure in the provisional application adequately provides the necessary disclosure of the subject matter of the challenged claims, we still do not find the current record sufficiently supports antedating via constructive reduction to practice. Patent Owner argues that “[p]er the prosecution history, the inventors [sic] signed Declarations and had completed the provisional patent application as early as August 15, 2000.” Prelim. Resp. 2. But constructive reduction to practice is shown through the filing of (rather than the preparation of) such a priority application, and thus Patent Owner does not show constructive reduction to practice of any invention in that application until the ’994 provisional filing date of November 15, 2000. Prelim. Sur-reply 1. Further, under a rule of reason analysis on this record, the evidence does not show reasonably continuous diligence during the time period from just before Sharpe’s September 26, 2000 filing date (by which time Patent Owner asserts the provisional application had been completed) and November 15, 2000, the filing date of the ’994 provisional.

For these reasons, on the present record, Sharpe has not been antedated and we analyze Petitioner’s obviousness challenges based on Sharpe. To be clear, we are not suggesting that Patent Owner will not prevail ultimately on the priority issue. To the extent that Patent Owner continues to argue that one or more of the ’291 patent claims are entitled to an earlier conception or reduction to practice date that would antedate Sharpe, the parties will have the opportunity to more fully develop the record through trial.

3. *Obviousness of Claim 26 Over Sharpe*

Petitioner begins by addressing the obviousness of claim 26, and we follow this ordering in our analysis.

Without arguing that the preamble of claim 26 is limiting, Petitioner argues that Sharpe renders the preamble of claim 26 obvious by teaching a method for associating users with digital media. Pet. 22–24 (citing, *inter alia*, Ex. 1005, 4:21–26, 5:4–13, 5:27–35, 5:50–63, 7:35–48; Ex. 1003 ¶¶ 129–135).

With respect to limitation 26a, the method step of “distinguishing between users of the computer system via one or more unique user identifiers stored in a computer-readable medium accessible to the computer system, the users including a named user and an identifying user, the named user being different from the identifying user, the named user having naming information associated with a unique user identifier of the named user,” Petitioner describes Sharpe’s disclosure of groups of users registered in a database. Pet. 25 (citing Ex. 1005, 2:29–30, 7:35–41; Ex. 1003 ¶¶ 138–140). Petitioner further argues that one of ordinary skill in the art would have understood that the usernames of Sharpe are unique user names 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 25–26 (citing Ex. 1005, 7:35–48, 8:60–9:11; Ex. 1003 ¶¶ 142–143). Petitioner further argues that the recitations relating to a “named user” and an “identifying user” is taught in Sharpe’s discussion of a first user identifying a second user as present in a digital media item. *Id.* at 27–28 (citing Ex. 1005, 3:57–63, 5:6–13; Ex. 1003 ¶¶ 148–151). With respect to the named user having named information associated with a unique user identifier, Petitioner argues

that Sharpe teaches this in the personal name of a user displayed in a drop down menu in the GUI of Figure 4. *Id.* at 28–29 (citing Ex. 1005 6:67–7:1, 8:26–29; Ex. 1003 ¶¶ 152–157).

For limitation 26b, the method step of “in response to an input from the identifying user indicating a selection of an item of digital media, determining a unique digital media identifier corresponding to the digital media selected,” Petitioner argues that Sharpe discloses determining an identifier for each item to be stored. *Id.* at 30–31 (citing Ex. 1005, 3:64–4:6, 5:24–40, 7:42–44, 8:30–36; Ex. 1003 ¶¶ 158–160).

With respect to limitation 26c, “receiving, from the identifying user, an input indicating a selection of the named user from a list of other network users, the list of other users including naming information previously provided by other users, the list of other users including one or more users in a contact list associated with the identifying user, the identifying user’s contact list including the named user,” *Id.* at 31–36 (citing Ex. 1005, 2:27–38, 5:6–13, 6:58–7:24, 8:15–29, 9:29–32, Fig. 4 (item 55); Ex. 1003 ¶¶ 163–171).

Limitation 26d recites “in response to receiving from the identifying user the input indicating the selection of the named user from the list of other users, determining a unique user identifier of the named user,” and Petitioner argues that Sharpe describes creating associations between users and media items, and that in order to create such relationships in the database tables described in Sharpe, one of ordinary skill in the art would have understood a unique identifier / primary key would be used. *Id.* at 36–37 (citing Ex. 1005, 4:63–65, 7:32–34, 8:15–36; Ex. 1003 ¶¶ 173–176).

Lastly, with respect to the final step of claim 26 (limitation 26e), “storing an association between a unique user identifier of the named user

and a unique digital media identifier corresponding to the digital media selected,” Petitioner contends that the “associated information” stored for a multimedia item when a user had been identified as associated with that item would have included a username for the named user. *Id.* at 37–38 (citing Ex. 1005, 2:32–35, 4:63–65, 7:32–34, 8:30–36; Ex. 1003 ¶¶ 177–179).

Patent Owner does not comment on these assertions.<sup>12</sup>

With respect to claim 26, on the current record and for the purposes of institution, we determine that Petitioner has shown a reasonable likelihood of prevailing with respect to its assertions of obviousness over Sharpe. Accordingly, we institute an *inter partes* review of all challenged claims under all grounds set forth in the Petition.

#### 4. *Obviousness of Claims 1, 5, and 10–25*

With respect to the additional claims challenged as obvious over Sharpe, we have reviewed Petitioner’s assertions. *See* Pet. 39–59. Claims 1, 24, and 25 are independent and describe, inter alia, the receipt from a second user of a selection of a first user as associated with a digital media selection and the storage of the association, which is addressed by Petitioner with reference to similar portions of Sharpe as those which are cited with respect to claim 26. *Id.* at 39–47, 57–59.

Patent Owner does not provide any additional arguments with respect to these claims.

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<sup>12</sup> Patent Owner’s arguments asserting deficiencies in the merits of the Petitioner’s obviousness assertions refers to “Grounds 1–4” but does not appear to address any issues other than the motivation to combine references, which does not apply to this single-reference obviousness ground. *See* Prelim. Resp. 32–34.

With respect to claims 1, 5, and 10–25, on the current record and for the purposes of institution, we determine that Petitioner has shown a reasonable likelihood of prevailing with respect to its assertions of obviousness of these claims over Sharpe.

*E. Additional Grounds*

Petitioner additionally presents argument that claims 1–26 would have been obvious over a combination of Sharpe and Eintracht and that claims 18, 19, and 26 would have been obvious over a combination of Sharpe and Carey or over a combination of Sharpe, Eintracht, and Carey. Pet. 59–77. Patent Owner argues Petitioner presents no basis for combining Sharpe and Eintracht other than that “Eintracht’s asynchronous annotation capability and groupware features would have improved the collaborat[iv]e archival system of Sharpe.” Prelim. Resp. 32–34 (quoting Pet. 59). Patent Owner describes Petitioner’s arguments as “bare” and “conclusory” and argues that there is no articulated reasoning with rational underpinning presented by Petitioner. *Id.* Patent Owner makes the same argument with respect to the combination of Sharpe with Eintracht and Carey. *Id.* at 34.

Petitioner, however, presents a discussion of an issue present in the disclosure of Sharpe and the solution provided by Eintracht, and, as discussed, provides citations and expert testimony relating to the motivation for the combination. Pet. 59–64. As we institute, Patent Owner will have the opportunity to address these arguments, however, we note that, on the present record and for the purposes of institution, Petitioner’s arguments with respect to the combination appear to be more than conclusory and to provide articulated reasoning with rational underpinning and to show a likelihood of success in showing a proper motivation to combine Sharpe and Eintracht.

### III. CONCLUSION

For the reasons discussed above, we conclude Petitioner has shown a reasonable likelihood of prevailing with respect to at least one claim of the '291 patent. We determine that the record supports institution. Accordingly, we institute an *inter partes* review of all challenged claims under all grounds set forth in the Petition.

### IV. ORDER

For the foregoing reasons, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–26 of the '291 patent on all grounds set forth in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this Decision.

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FOR PETITIONER:

Lisa K. Nguyen  
David M. Tennant  
Alan M. Billharz  
Chitrajit Chandrashekar  
ALLEN & OVERY LLP  
lisa.nguyen@allenovery.com  
david.tennant@allenovery.com  
alan.billharz@allenovery.com  
chitrajit.chandrashekar@allenovery.com

FOR PATENT OWNER:

Scott W. Hejny  
Eliza Beeney  
Kaylee Hoffner  
MCKOOL SMITH, P.C.  
shejny@mckoolsmith.com  
ebeeney@mckoolsmith.com  
khoffner@mckoolsmith.com