

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC. ET AL.,
Petitioner,

v.

ANGEL TECHNOLOGIES GROUP LLC,
Patent Owner.

IPR2023-00059
Patent 10,417,275 B2

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

CYGAN, *Administrative Patent Judge*.

DECISION
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 institution of *inter partes* review of claims 1–12 of U.S. Patent No. 10,417,275 B2 (Ex. 1001, the “’275 patent”). The Petition was accompanied by a Declaration from Dr. Benjamin Bederson. Ex. 1003 (“Bederson Decl.”). Angel Technologies LLC (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”). Paper 9. We authorized additional briefing on certain matters. Ex. 1036. Petitioner filed a Reply, and Patent Owner filed a Sur-reply. Papers 14, 15. We instituted *inter partes* review as to all claims and all grounds raised in the Petition. Paper 16 (Dec. on Inst.).

Patent Owner filed a Response (Paper 25, “PO Resp.”), accompanied by a Declaration by Dr. Eli Saber (Ex. 2021, “Saber Decl.”) and by a transcript of a deposition of Dr. Bederson (Ex. 2019). Petitioner filed a Reply (Paper 30, “Pet. Reply”) accompanied by a transcript of a deposition of Dr. Saber (Exs. 1040, 1041). Patent Owner filed a Sur-Reply. (Paper 31, “PO Sur-Reply”). The parties requested an oral hearing, and we held such a hearing on February 13, 2024. A transcript of the oral hearing has been entered into the record. Paper 40.

B. *Real Parties in Interest*

Petitioner identifies Meta Platforms, Inc. (formerly Facebook, Inc.) and Instagram, LLC as the real parties in interest. Pet. 2. Patent Owner identifies Angel Technologies Group LLC as the real party in interest. Paper 4, 2.

C. Related Matters

Petitioner represents that the '275 patent is involved in *Angel Techs. Group LLC v. Facebook, Inc. and Instagram LLC*, No. 2:21-cv-08459-CBM-JPR (C.D. Cal.), and that

On June 30, 2022, the district court found the asserted patents, including the '275 Patent, invalid under 35 U.S.C. § 101 and dismissed the case. On July 29, 2022, PO filed a Notice of Appeal. The case has been docketed as the following: *Angel Techs. Group, LLC v. Meta Platforms, Inc.*, No. 2022-2100 (Fed. Cir.). The opening appeal brief is currently due on November 2, 2022.

Pet. 3. The parties represent that Petitioner has filed, at substantially the same time that this Petition was filed, petitions for *inter partes* review against related family members U.S. Patent No. 8,954,432 (IPR2023-00057), U.S. Patent No. 9,959,291 (IPR2023-00058), and U.S. Patent No. 10,628,480 (IPR2023-00060). Pet. 3; Paper 4, 2.

D. The '275 Patent

The '275 patent is titled “Artificial Intelligence Assisted Tagging of Users in Digital Media Online.” Ex. 1001, code (54). The '275 patent issued from Application Serial No 15/933,531, filed on March 23, 2018, and claims priority, via continuation applications, to Provisional Application No. 60/248,949, filed on November 15, 2000. *Id.* at codes (21), (22), (60), (63).

The '275 patent relates to storing and sharing images through a communications network, and supplying and receiving information about the existence of objects within images. Ex. 1001, 1:20–25. A users database (230) receives, stores, and provides information about people, who access the host computer, and may include information for each user such as a user identifier, the user’s name, and user’s email address. *Id.* at 7:18–25. An image database (250) receives and stores information about photos. *Id.* at

7:27–34. An identifications database (240) receives, stores, and provides information about relationships between users and photos, such as whether the user is in the photo, including the coordinates of the user or other person within the photo. *Id.* at 7:45–56. The following is an example of the three databases:

User database			
User I.D.	Name	Email	Contacts
007	John Doe	jdoe@doe.com	John, Jane, Lisa
008	Jane Doe	janedoe@doe.com	Jane, John, Fuzzie

Images database			
Image I.D.	Location	Caption	Uploaded by
ABCD	C:\dir\my_image.jpg	John and Jane at the beach	007

Identifications database			
User I.D.	Image I.D.	Shared by	Coordinates
007	ABCD	007	50, 50, 25
008	ABCD	007	25, 75, 10

Id. at 8:45–66. Through uploading of user data by John Doe and Jane Doe to the user database, and creation of an image record in the Image database when a user uploads a photo to the host computer, a relationship is created between the user and the image that is stored in the Identifications database. *Id.* at 7:58–9:3, 12:52–55.

Following identification of an object within an image, artificial intelligence algorithms (e.g., an image recognition system) may be applied

to the images. *Id.* at 13:31–36. Such algorithms may be purposed to further define characteristics of images, obtain identifying information, and/or search a database for other possible matches to a named object. *Id.* at 13:36–39.

E. Illustrative Claim

Claim 1 is illustrative, and recites as follows:

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:

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 of the computer system 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;

in response to an input from the identifying user indicating a selection of an image, determining a unique image identifier corresponding to the image selected;

receiving, from the identifying user, an input indicating a selection of the named user from a list of other users of the computer system, 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;

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;

receiving, from the identifying user, one or more inputs indicating a set of coordinates corresponding to a location of the named user within the image; and

applying artificial intelligence algorithms to image data of other images accessible to said computer system to locate images matching characteristics of a subset of image data bound by the set of coordinates corresponding to the location of the named user within the image, wherein the set of coordinates corresponding to the location of the named user within the image is associated with the unique user identifier of the named user and the unique image identifier.

F. Evidence

Petitioner relies on the following patent evidence.

Name	Patent Document	Exhibit
Sharpe	U.S. 7,461,099 B1	1005
Eintracht	U.S. 6,687,878 B1	1006
Carey	U.S. 6,714,793 B1	1007

Petitioner further relies upon Kuchinsky et al., “FotoFile: A consumer Multimedia Organization and Retrieval System,” CHI ’99: Proceedings of the SIGCHI Conference on Human Factors in Computing Systems, 496–503 (May 1999) (Ex. 1011, “FotoFile”).

G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–12 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–12	103(a) ¹	Sharpe, Eintracht, FotoFile
1–12	103(a)	Sharpe, Eintracht, FotoFile, Carey

¹ Petitioner asserts, and we agree for purposes of institution, that the pre-AIA patentability statutes apply to the ’275 patent. *See* Pet. 5.

II. ANALYSIS

A. *Legal Standards*

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, “would have been obvious at the time the invention was made to a person having ordinary skill in the art [to which said subject matter pertains].” *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 ordinary skill in the art; and (4) objective evidence of non-obviousness.² *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. *Level of Ordinary Skill in the Art*

Petitioner asserts that a person of ordinary skill in the art in 2001 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. Additional experience could substitute for less education, and additional education could likewise substitute for less experience.

Pet. 13–14 (citing Ex. 1003 ¶ 39). Patent Owner submits an essentially identical description of this hypothetical person. PO Resp. 17. We do not determine any meaningful significance to the differences between the parties’ representations. For purposes of this Decision, we adopt Petitioner’s

² Neither party presents evidence or arguments regarding objective evidence of non-obviousness.

proposed level of ordinary skill, as it appears to be consistent with the specification of the '275 patent and the prior art of record.

C. Claim Construction

In an *inter partes* review, we construe a patent claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b).” 37 C.F.R. § 42.100(b) (2019). Under this standard, the words of a claim generally are given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Here, Petitioner asserts that the term “user identifier” should be construed as “a series of characters identifying a user.” Pet. 14. Petitioner also asserts that the term “contact list” should be construed as a “list of people known to the user.” *Id.* at 16. Patent Owner asserts that no term requires express construction. PO Resp. 17–18.

We note that there is no controversy regarding any term that is necessary to resolve to resolve the matter before us, and therefore, we do not need to construe any term. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). Consequently, each claim term is given its ordinary and customary meaning.

D. Obviousness over Sharpe, Eintracht, and FotoFile

Petitioner asserts that claims 1–12 are unpatentable under § 103(a) as obvious over Sharpe, Eintracht, and FotoFile. Patent Owner provides arguments and evidence against these assertions.

Upon consideration of Petitioner’s explanations and the totality of evidence in this current record, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that claim 1 is unpatentable under § 103(a) as obvious over the combination of Sharpe, Eintracht, and FotoFile.

1. Sharpe

Sharpe is titled “Method and System for Archiving and Retrieving Items Based on Episodic Memory of Groups of People.” Ex. 1005, code (54). Sharpe relates to “the archiving and retrieval of digital media items wherein the archiving and retrieval process is performed based on episodic memory of predefined groups of people.” *Id.* at 1:6–9. Sharpe describes that work in the storage and archiving techniques for digital media are concentrated on “facilitating the retrieval of a particular digital media item; i.e., one which matches the user’s requirements exactly.” *Id.* at 1:11–14. Sharpe contrasts prior work relying on semantic memory with the described invention, “based on the common episodic memory of a strong social group,” which relies upon and enhances “group ‘memory’” and “group nostalgia.” *Id.* at 1:14–32.

To archive digital media items, a user identifies a group to which the user belongs, and then digital media items to be archived for the group are identified. *Id.* at 1:37–45. Using a pull-down menu on a graphical user interface [“GUI”], the user may associate each media item with one of three parameters: persons, an event, and time. *Id.* at 1:47–2:11. Later, other users

may search and retrieve desired photos by searching using one or more of those parameters. *Id.* at 2:12–24. Patent Owner does not dispute that Sharpe is available as prior art. *See* PO Resp. In our decision instituting trial, based upon the evidence of record, we determined that Sharpe is available as prior art. *See* Dec. on Inst. 10–21.

2. *Eintracht*

Eintracht is titled “Synchronizing/Updating Local Client Notes With Annotations Previously Made by Other Clients in a Notes Database.” Ex. 1006, code (54). Eintracht relates to an Internet-based “system for collaborative document annotation based on the exchange of notes attached to web based documents.” *Id.* at 1:9–11. Eintracht states that a common need at the time was “to be able to view the [web] document, i.e., images etc., on the client computer and be able to add one or more annotations to the document.” *Id.* at 1:26–28. The documents and their associated annotations are stored in separated data structures, permitting their data to be managed independently. *Id.* at 2:11–15. Users, via a plug-in module in their web browser, may display documents and create annotations. *Id.* at 2:16–40. The annotations are transmitted to a server to be stored in asynchronous fashion, permitting multiple users to simultaneously annotate a document. *Id.* at 2:50–58.

3. *FotoFile*

FotoFile is titled “FotoFile: A Consumer Multimedia Organization and Retrieval System.” Ex. 1011. FotoFile relates to a system for multimedia organization and retrieval, blending human and automatic annotation methods. *Id.* at 1. FotoFile describes automatic feature extraction for automating annotations that would otherwise require manual entry. *Id.* at 4. FotoFile describes a face detection and recognition system

that attempts to match the face to an identity. *Id.* That identity will be assigned as an annotation to all subsequently seen photos containing a matching face. *Id.*

4. *Analysis of Claim 1*

We begin our analysis of Petitioner’s obviousness contentions with Petitioner’s assertions as to claim 1.

a) 1[pre]: 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,

Petitioner asserts that this limitation, to the extent limiting, is described by Sharpe’s “digital media items based on episodic memory of predefined associated groups of one or more people,” implemented “over the Internet.” Pet. 30–31 (citing Ex. 1005, code (57), 4:21–33). Patent Owner does not explicitly argue against this assertion. *See* PO Resp. In view of the foregoing, we determine that the combination of Sharpe and Eintracht teaches limitation 1[pre].³

b) 1[a]: 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 of the computer system 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 points to the user archiving the media item as an “identifying user,” and the user identified in the image during archive is a “named user” that is “different from the identifying user,” because Sharpe describes that an individual can identify “digital media items related to *other*

³ Because we find 1[pre] to be taught, we need not determine whether it is limiting.

users.” *Id.* at 37–38 (citing Ex. 1005, 5:6–13; Ex. 1003 ¶¶ 166–169).

Petitioner further points to Sharpe’s description of a GUI [Graphical User Interface] having a “drop down box . . . provided for selecting any of a number of people within the group,” wherein the box is illustrated as a list of first names of people. *Id.* at 38–39 (citing Ex. 1005, 6:67–7:1, 8:26–29, Fig. 4, Ex. 1003 ¶ 172). We are persuaded by Petitioner’s arguments.

Petitioner asserts that this limitation is described by Sharpe’s use of a user name, recorded in a database, and password for users to identify themselves as a member of a group. *Id.* at 33–34 (citing Ex. 1005, 5:4–6, 7:35–48). Petitioner points to the user name as a unique user identifier. *Id.* at 34 (citing Ex. 1003 ¶ 152). Petitioner further points to unique user identifiers being taught through Sharpe’s process by which images are associated with specific users in the database. *Id.* (citing Ex. 1003 ¶ 153). We are persuaded by Petitioner’s arguments.

Alternately, Petitioner asserts that the unique user identifier limitation is taught by the combination of Sharpe and Eintracht, through incorporation of Eintracht’s unique user IDs associated with a user name into the invention of Sharpe. *Id.* at 34 (citing Ex. 1006, 8, 8–13, 10:40–63). Petitioner asserts that a person having ordinary skill in the art would be motivated to make such a combination to benefit from the flexibility in accessing and changing user name data from the identifier at a single location. *Id.* at 36 (citing Ex. 1003 ¶ 57). Petitioner asserts that this provides an easier and more efficient way to change annotation on multiple images by changing one data field rather than editing each individual image. *Id.* at 26 (citing Ex. 1003 ¶ 133; Ex. 1006, 1:47–50). Petitioner asserts that a person having ordinary skill in the art would have recognized that Eintracht’s asynchronous annotation

capability and groupware features would have thereby improved the collaborative digital media archival system of Sharpe. *Id.* at 25.

Patent Owner argues that Petitioner has not established that a person of ordinary skill in the art would have combined Sharpe with Eintracht. Patent Owner argues that Sharpe and Eintracht are “directed to fundamentally different systems with different goals.” PO Resp. 18. Patent Owner argues that Sharpe’s goal is for image retrieval based on “episodic memory” whereas Eintracht’s goal is collaborative documentation annotation. *Id.* at 18–19 (citing Ex. 1003 ¶¶ 71, 75). Patent Owner argues that Petitioner’s proposed reason for combining the reference “pertains to solving a problem (asynchronous annotation) not present in the primary reference Sharpe.” *Id.* at 19 (citing Ex. 2021 ¶ 80). Patent Owner further argues that Petitioner has not explained how the proposed combination of Sharpe and Eintracht would work. *Id.* at 20–21 (citing Ex. 2021 ¶ 81).

We do not agree with Patent Owner’s arguments because, as indicated above, Petitioner sufficiently details how the combination would work;

Using Eintracht’s unique user ID could be accomplished by replacing the username with the unique user ID while keeping the username with an association to the unique user ID. *Id.* Another approach would have been to add Eintracht’s unique user ID to Sharpe’s user database as an additional column. *Id.* That unique user ID could then be a primary key used to identify Sharpe’s users.

Petitioner asserts, and we agree, that this combination would have had a reasonable expectation of success because both are implemented over a network via a server, and over the Internet via the World Wide Web. *Id.* at 28–29 (citing Ex. 1005, 4:21–28, 5:50–63, Fig. 2; Ex. 1006, 1:7–12, 1:26–35, 2:16–27, Fig. 3; Ex. 1003 ¶ 135). Petitioner relies upon a statement from Dr. Bederson, which we credit, that a person of ordinary skill in the art

would have recognized the systems as structurally similar, and that in view of the similarities, that person would expect to be able to combine the features of Sharpe and Eintracht. *Id.* (citing Ex. 1003 ¶ 137). We determine this showing to sufficiently explain how the references would have been combined such that it would have been obvious to one having ordinary skill in the art to do so.

With respect to the different problems being addressed by Sharpe and Eintracht, 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 Intern. v. Teleflex*, 550 U.S. 398, 420 (2007).

Consequently, we determine that Petitioner has sufficiently shown adequate reason to combine the references. In view of the foregoing, we determine that the combination of Sharpe and Eintracht teaches limitation 1[a].

c) 1[b]: in response to an input from the identifying user indicating a selection of an image, determining a unique image identifier corresponding to the image selected;

Petitioner points to Sharpe’s description of the user identifying a group to which the user belongs, permitting one or more digital media items to be identified to be archived by the user’s selection of an item to be imported onto the work space. *Id.* at 40 (citing Ex. 1005, 1:42–47, 2:39–41, 7:42–44; Ex. 1003 ¶¶ 176–178). Petitioner highlights Sharpe’s use of an identifier responsible for associating each item to be stored, and that “digital media items may be stored separately with unique identifiers such as a file name or index.” *Id.* at 40–41 (citing Ex. 1005, 3:64–4:6, 5:24–40). We are

persuaded by Petitioner's arguments and evidence and Patent Owner does not provide arguments addressing limitation 1[b]. *See* PO Resp. In view of the foregoing, we determine that the combination of Sharpe and Eintracht teaches limitation 1[b].

d) 1[c]: receiving, from the identifying user, an input indicating a selection of the named user from a list of other users of the computer system, 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

Petitioner points to Sharpe's description of a graphical user interface ["GUI"] from which a user selects a name from a list of names. *Id.* at 42 (citing Ex. 1005, Fig. 4, 8:15–25). The selection associates that name with a media item, which is then archived with the selected people. *Id.* (citing Ex. 1005, 6:58–7:24, 8:15–25). The list of people is taken from a database of groups of people, and the names have been previously provided by the users when the users database is populated. *Id.* at 42–44 (citing Ex. 1005, Fig. 4, 5:4–6, 7:35–38, 8:26–29; Ex. 1003 ¶ 185). Petitioner characterizes Sharpe's list of people in its drop-down box both as a list of other users and a contact list for group members. *Id.* at 45.

Petitioner further asserts that the use of a contact list for Sharpe's archiving user would have been a simple design choice as it was a known feature. *Id.* at 46 (citing Ex. 1007, 1:20–43; Ex. 1028, 14:7–9; Ex. 1013 ¶ 31; Ex. 1012, 8:53–61; Ex. 1003 ¶ 190). Petitioner further asserts that such a combination would have improved group collaboration by allowing users to leverage their contacts, and would have facilitated Sharpe's aim of increased participation in the events being archived. *Id.* at 45–46 (citing Ex. 1003 ¶ 190). We are persuaded by Petitioner's arguments and evidence and

Patent Owner does not provide arguments addressing limitation 1[c]. *See* PO Resp. In view of the foregoing, we determine that the combination of Sharpe and Eintracht teaches limitation 1[c].

e) 1[d]: 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;

Petitioner points to Sharpe’s description of a user selecting a name from the drop-down box, the name being a personal name uniquely identifying the named user. *Id.* at 46 (citing Ex. 1003 ¶ 192).

Patent Owner argues that Sharpe only teaches the user name for identifying the user as a member of a group, not for determining a user name in response to selection of a user in an image. PO Resp. 22–23 (citing Ex. 1005, 7:37–41; Ex. 2021 ¶ 83). Patent Owner argues that Petitioner relies upon argument regarding what one of ordinary skill would have understood Sharpe to teach, rather than actual disclosures in Sharpe, as to how the user name in Sharpe would have been used in Sharpe’s system. *Id.* (citing Pet. 46–47). Patent Owner argues that it is not necessary for Sharpe’s user name to perform the claimed function, pointing to Dr. Saber’s testimony that a separate, internal unique user identifier could have been used in Sharpe for keeping track of each user, instead of the user name. *Id.* at 23–25 (citing Ex. 2021 ¶¶ 85–86).

In its Reply, Petitioner responds by arguing that Patent Owner mischaracterizes the Petition as presenting an inherency argument. Pet. Reply 4–5. Petitioner argues the Petition “establishes that the username would have been an **obvious** design choice for a primary key in view of Sharpe’s teachings and the knowledge of a POSA [person of ordinary skill in the art.]” *Id.* at 5 (citing Pet. 33–34, 46–47; Ex. 1003 ¶¶ 152–153, 191–

194). Petitioner points to Dr. Bederson’s testimony that “a POSA would have further understood that a username is *one such unique identifier*.” *Id.* at 6 (citing Ex. 1039 ¶ 11). Petitioner argues that Patent Owner and Dr. Saber both appear to agree that a username would have been recognized as a potential user unique identifier by a person having ordinary skill in the art. *Id.* (citing Ex. 2021 ¶¶ 85–86; PO Resp. 23–26). Accordingly, Petitioner argues, there is no material dispute that a person having ordinary skill in the art would have understood Sharpe’s username as an available design option for implementing Sharpe’s databases. *Id.* at 7.

Petitioner further argues that the Petition alternatively asserts that it would have been obvious to modify Sharpe to use non-username unique IDs as taught by Eintracht. *Id.* (citing Pet. 34–36). Petitioner argues that Patent Owner did not address this in its Response. *Id.*

In its Sur-reply, Patent Owner argues that Petitioner did not develop either such assertion in its Petition that relates to limitation 1[d]. PO Sur-reply 3–7. Patent Owner argues that the Petition states that “Sharpe’s system *must* use the username as a unique identifier.” *Id.* at 3. Patent Owner argues that limitation 1[d] was addressed in the Petition as being taught by Sharpe – not by Eintracht.

We start with Petitioner’s assertion in its Reply that the Petition addressed limitation 1[d] as being taught by Eintracht. We acknowledge that the Petition’s discussion of limitation 1[d] states that “Sharpe alone or in view of the knowledge of a POSA discloses this limitation.” Pet. 46. Yet we also acknowledge that the Petition addressed the term at issue, the “unique identifier,” in its discussion of limitation 1[a]. As detailed in our analysis of limitation 1[a], the Petition provided an assertion of obviousness of the unique identifier over a combination of Sharpe and Eintracht. *Supra*

§ II(D)(4)(b). The Petition further provided an explanation of how that combination would be achieved, the motivation for such a combination, and an explanation of why such a combination would have a reasonable expectation of success. *Id.* We have determined such explanation to be sufficiently explained and supported by the record. *Id.* Therefore, we cannot agree that the Petition did not advance a sufficient assertion that the “unique identifier” of limitation 1[d] was taught by a combination of Sharpe and Eintracht. For the same reasons set forth in our discussion of limitation 1[a], we determine that the combination of Sharpe and Eintracht teaches limitation 1[d]. Consequently, we need not reach the issue of whether Sharpe alone teaches this limitation.

f) 1[e]: receiving, from the identifying user, one or more inputs indicating a set of coordinates corresponding to a location of the named user within the image;

Petitioner points to Sharpe, as described above, for its teaching of the labeling of images with the names of the people therein. *Id.* at 47–49. Petitioner also points to Eintracht’s description of its user identifying coordinates corresponding to a location within the image. *Id.* at 49 (citing Ex. 1006, 7:55–64, 15:10–16). Petitioner asserts that a person having ordinary skill in the art would have been motivated to apply Eintracht’s coordinate-specific identification to Sharpe’s identification of users in an image, to “improve the user experience and the ability to automatically identify faces within the image,” as well as improve the user’s ability to recall certain individuals. *Id.* at 50 (citing Ex. 1003 ¶ 201).

Patent Owner argues that Eintracht’s coordinate identification of notes in a document (its “note anchor”) refers to the coordinates of notes and not the coordinates of a named user in an image. PO Resp. 28 (citing Ex. 2021

¶ 92). Patent Owner argues that the user decides where the notes are placed, and that combination with Sharpe would result in the notes being placed over the image, potentially obscuring the user from view contrary to the purpose of Sharpe. *Id.* at 28–29 (citing Ex. 2019, 63:12–64:3; Ex. 2021 ¶ 93); Sur-reply 7–8. Patent Owner argues that a person having ordinary skill in the art “would not have sought to modify Sharpe—which discloses people depicted in images—in light of the teachings of Eintracht to arrive at limitation 1[e], which requires coordinates “corresponding to a location of the named user within the image.” PO Resp. 30. Patent Owner argues that the Petition does not explain how and where such coordinates would be stored, or how the location of the named user within the image would be determined. *Id.* at 31. Patent Owner further argues that Eintracht relates to non-person images. *Id.* at 28–29 (citing Ex. 1006, Fig. 1B).

We do not agree with Patent Owner’s argument that the potential for obscuring a face in an image would dissuade a person having ordinary skill in the art from applying Eintracht’s teachings to identifying the coordinates of users in photos per Sharpe. Limitation 1[d] requires the user to indicate coordinates corresponding to a person in the image. The disclosure of the ’275 patent indicates that the correspondence between the shape of the figure and the stored coordinates need not be exact. *See* Ex. 1001, 8:23–35 (“John Doe appears in the circular area bound by the coordinates 50, 50, 25 x-axis location, y-axis location, radius of circle)). Eintracht illustrates how annotations may be placed over the images in Figure 1B, which depicts a car having multiple annotations on and near the car. Eintracht teaches that a user can annotate an image with text, and that the coordinates of such text is retained. *See* Ex. 1006 7:65–8:1. Eintracht further teaches that users can modify notes, including moving notes to a desired location. *Id.* at 15:5–26.

Dr. Bederson testifies that “it was well within the skill of a POSA to implement Eintracht’s annotations without obscuring the users depicted in the image,” pointing to features such as “tool tips” and transparency as techniques known in the art to annotate images without obscuring the content. Ex. 1039 ¶¶ 17–19.

In looking to whether a combination would have been obvious to a person of ordinary skill, we take account that such a person is “of ordinary creativity, not an automaton.” *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398, 421 (2007). Because Eintracht teaches user control of the annotation placement, and Dr. Bederson points to well-known options for preventing annotations from obscuring parts of the image, the record demonstrates that a user would recognize the advantage of location-identifying annotations despite the potential for obscuration. In view of the foregoing, we determine that the combination of Sharpe and Eintracht teaches limitation 1[e].

g) *1[f]: applying artificial intelligence algorithms to image data of other images accessible to said computer system to locate images matching characteristics of a subset of image data bound by the set of coordinates corresponding to the location of the named user within the image, wherein the set of coordinates corresponding to the location of the named user within the image is associated with the unique user identifier of the named user and the unique image identifier.*

In addition to the previously discussed assertions, Petitioner points to FotoFile’s face detection and recognition system as teaching the claimed artificial intelligence algorithm. *Id.* at 53 (citing Ex. 1011, 2, 4–5). FotoFile’s algorithm, “[w]hen given photos that contain faces of new people . . . attempts to match the identity of the face,” and such identity “will be assigned as an annotation to ***all subsequently seen photos that contain faces that match the original.***” *Id.* (citing Ex. 1011, 4–5). Petitioner highlights that during prosecution of the ’275 patent, the Examiner considered FotoFile

and characterized it as teaching an “artificial intelligence algorithm.” *Id.* at 54 (citing Ex. 1002, 283-84).

Petitioner further points to Eintracht’s description of a “shape field 226” that, combined with a set of coordinates, are used to identify the location of areas in the image. *Id.* at 56 (citing Ex. 1006, 17:42–53; Ex. 1003 ¶ 218).

Petitioner points to the automatic nature of FotoFile’s detection and annotation as motivating the combination with Sharpe and Eintracht. *Id.* at 54–55. Petitioner points to the known nature of the individual components as providing a reasonable expectation of success for such a modification. *Id.* at 55 (citing Ex. 1003 ¶ 215).

Patent Owner argues that, in addition to arguments against Petitioner’s assertions against limitation 1[e], a person having ordinary skill in the art would not have been motivated to modify Petitioner’s proposed Sharpe-Eintracht system so that the coordinates are associated with the user name and the unique image identifier. PO Resp. 32–33 (citing *Id.* at 18–20, 27–31); Sur-reply 7–8. Patent Owner argues that Petitioner’s proposed modification “requires attaching considerable functionality to that user name, which is an unsupported, improper leap.” PO Resp. 33. Patent Owner argues that Petitioner has not provided any expected benefits for modifying Sharpe’s table to include an additional column for the set of coordinates, or for creating an additional table with the required data. *Id.* at 34–35; Sur-reply 9. Patent Owner further argues that Petitioner has not explained how or why this could be accomplished with a reasonable expectation of success. PO Resp. 34–35; Sur-reply 9. Patent Owner further argues that Sharpe teaches retrieval of “any” relevant media items, and does

not “uniquely identify digital media items.” *Id.* at 35 (citing Ex. 1005, 2:17–21; Ex. 2021 ¶ 100).

Petitioner’s assertion for limitation 1[f] is supported by the record evidence. We find that Petitioner’s asserted advantage of providing automatic recognition and annotation of faces would provide a reason to combine the teachings of FotoFile with Eintracht and Sharpe. Dr. Bederson attests as to the nature of FotoFile, Eintracht, and Sharpe, and that a person having ordinary skill in the art would have recognized that FotoFile’s automated feature extraction tools would have enabled the system of Sharpe and Eintracht to be improved by its automatic location of images. Ex. 1003 ¶¶ 133–134. Dr. Bederson attests that FotoFile’s automatic extraction of features in such a combination would prevent the otherwise “enjoyable activity” of creating photo albums from becoming a “tedious one.” *Id.* ¶¶ 137–138. Dr. Bederson also attests to the similarity of Sharpe and Eintracht’s server- or web- based systems as “structurally similar, if not identical,” in the view of a person of ordinary skill in the art. *Id.* ¶ 136. Dr. Bederson further attests that “FotoFile algorithms were specifically designed to be applied to consumer multimedia archival and retrieval like Sharpe and Eintracht,” in which systems a person having ordinary skill “would have expected FotoFile’s artificial intelligence algorithms could have been successfully implemented.” *Id.* ¶ 137. We credit Dr. Bederson’s testimony in this regard.

With respect to Patent Owner’s argument that Sharpe does not “uniquely identify” digital media items, we have determined with respect to limitation 1[b] that Sharpe teaches an identifier responsible for associating each item to be stored, and that “digital media items may be stored separately with unique identifiers such as a file name or index.” Pet. 40–41

(citing Ex. 1005, 3:64–4:6, 5:24–40). Limitation 1[f] requires additionally that the algorithms “locate images” matching certain characteristics bound by the corresponding coordinates. We determine that Sharpe’s teaching of retrieving photographs by searching for a person, in combination with Eintracht as discussed with respect to limitation 1[e], meets this limitation. Pet. 51 (citing Ex. 1005, 2:23–24); Ex. 1040 (Saber Deposition) 174:11–20 (attesting that in Sharpe, the “user may select Sonia as the people parameter via drop down box 55. The user may then press ‘select,’ press the retrieve button 61 and all images matching Sonia will be retrieved and displayed.”). In view of the foregoing, we determine that the combination of Sharpe, Eintracht, and FotoFile teaches limitation 1[f].

h) Determination

In view of the foregoing, 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 the combined references. Further, that Petitioner has shown by a preponderance of the evidence that a person having ordinary skill in the art would have had reason to combine the references as argued by Petitioner, and would have had a reasonable expectation of success in doing so.

5. Analysis of Claim 2

Claim 2 recites, “the artificial intelligence algorithms include an image recognition algorithm.” Petitioner asserts that dependent claim 2 is obvious over the combination of Sharpe, Eintracht, and FotoFile because FotoFile’s face detection and recognition system teaches this limitation. Pet. 58. Dr. Bederson attests that a person having ordinary skill in the art “would have understood that a face detection algorithm is a type of image detection algorithm because it detects a type of image— specifically, a face.” Ex.

1003 ¶ 222. We are persuaded by Petitioner’s argument and evidence and Patent Owner does not provide arguments separate from those with respect to claim 1. PO Resp. 35.

We determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claim 2 has been taught or suggested by the combined references. Further, we determine that Petitioner has shown by a preponderance of the evidence that a person having ordinary skill in the art would have reason to combine the references as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

6. *Analysis of Claims 3 and 4*

Claim 3 recites,

in response to locating an image matching image characteristics of a subset of image data bound by the set of coordinates corresponding to the location of the named user within the image, providing information about the stored association to a computing device of the named user, the information indicating that the named user has been associated with one or more images.

Claim 4 further recites, “wherein the information about the stored association is provided via an email.” Petitioner asserts that dependent claims 3 and 4 are obvious over the combination of Sharpe, Eintracht, and FotoFile because FotoFile describes sending an e-mail when an annotation is added including part of the annotation when a new annotation is received, and because Eintracht describes notifying clients by e-mail each time a new annotation is received by the server including any portion of the notes themselves. Pet. 59–60 (citing Ex. 1003 ¶ 225; Ex. 1006, 10:5–11, 11:11–14). Petitioner asserts that a person having ordinary skill in the art “would have been motivated to modify the archiving system of Sharpe to include

email notification as taught by Eintracht because it would facilitate Sharpe's objective to have "individuals in the group or the group as a whole [] reminisce and review the contents of the archive." *Id.* at 60 (citing Ex.1005, 5:15-17; Ex. 1003 ¶¶ 226-227).

Patent Owner argues that none of the references disclose or suggest providing information about the stored association to a computing device of a named user. PO Resp. 35–36. Patent Owner argues that Eintracht does not disclose emailing the specific user that has been associated with, or identified in, one or more images. *Id.* at 36. Patent Owner argues that Eintracht's notifications are related to an event, not an association. *Id.* (citing Ex. 1006, 2:65–68, 10:5–11; Ex. 2021 ¶ 104). Patent Owner further argues that FotoFile does not describe any such description regarding email notification. *Id.*

We find Petitioner's assertions to be supported by the record evidence. Dr. Bederson attests that a person having ordinary skill in the art would have recognized that the association of a user with a photo is an event, and that such an event would trigger an email alert in the system as proposed to be combined by Petitioner. Ex. 1039 ¶ 23. Dr. Bederson further attests that Eintracht's email may contain "additional information," such as information about the image annotation that triggered the notification. *Id.* I; Ex. 2019 (Bederson Deposition) 38:4–8 (citing Ex. 1005, 8:30–36). Dr. Bederson further attests that such would have been an exercise of "ordinary creativity." *Id.* Because Dr. Saber agrees that Eintracht generates email alerts related to database changes and note events (Ex. 2021 ¶ 104), we agree that Eintracht in Petitioner's proposed combination teaches email notifications that a user has been associated with an image. We credit and are persuaded by the testimony of Dr. Bederson in this regard.

We determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claims 3 and 4 have been taught or suggested by the combined references. Further, we determine that Petitioner has shown by a preponderance of the evidence that a person having ordinary skill in the art would have reason to combine the references as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

7. *Analysis of Claims 5 and 6*

Claim 5 recites, “the set of coordinates defines a polygonal area.” Claim 6 recites, “the set of coordinates defines a circular area.” Petitioner asserts that dependent claims 5 and 6 are obvious over the combination of Sharpe, Eintracht, and FotoFile because Eintracht teaches a “shape” field for its note shape field in which the shape may form a polygon or an ellipse. Pet. 61–62. Dr. Bederson attests that a person having ordinary skill in the art would understand that a circular area is a type of ellipse. Ex. 1003 ¶ 229. Dr. Bederson further attests that a person having ordinary skill in the art would have recognized that such location-based shapes would have improved Sharpe’s system by more accurately identifying where people are in an image. *Id.* We are persuaded by Petitioner’s arguments and evidence and Patent Owner does not provide arguments separate from those with respect to claim 1. PO Resp. 35.

We determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claims 5 and 6 has been taught or suggested by the combined references. Further, we determine that Petitioner has shown by a preponderance of the evidence that a person having ordinary skill in the art would have reason to combine the references

as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

8. *Analysis of Claim 7*

Claim 7 recites, “providing, via one or more of the plurality of computing devices, a graphical user interface for presentation to a user of the computer system, the graphical user interface configured to display a representation of the set of coordinates, thereby indicating the location of the named user within the image.”

Petitioner asserts that dependent claim 7 is obvious over the combination of Sharpe, Eintracht, and FotoFile because Sharpe teaches a graphical user interface displaying images and Eintracht teaches showing a representation of a set of coordinates on an image window. Pet. 62–63 (citing Ex. 1005, 6:63–65, Fig. 4; Ex. 1006, 2:53–55; Ex. 1003 ¶¶ 231–232). Dr. Bederson attests that person having ordinary skill in the art “would have recognized that Eintracht’s ability to overlay annotations is a configuration that allows for . . . the location of the annotation as overlaid on the image” that “would improve Sharpe’s archival and retrieval system by visually identifying where people are in an image to enhance the user experience.” Ex. 1003 ¶ 232.

Patent Owner argues that Petitioner “provides no explanation nor rationale for how, in the proposed combination, the displayed representation of the set of coordinates indicates the location of a named user within the image.” PO Resp. 37 (citing Ex. 2021 ¶ 106).

We find Petitioner’s assertions to be supported by the record evidence. We credit Petitioner’s explanation as to how, in the proposed combination, a set of coordinates corresponds to the location of a named user within the image. *Supra* § II(D)(4)(f). Eintracht supports this

explanation, describing that “the client application layers the annotations over the image (or document) in accordance with the coordinates of each.” Ex. 1006, 2:53–55. Further, Dr. Bederson attests as to the manner by which Eintracht uses a note anchor, expressed in terms of coordinates, to create an annotation. Ex. 1003 ¶ 231 (citing Ex. 1006, Fig. 1C, 15:10–16, 2:53–55).

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 the combined references. Further, we determine that Petitioner has shown by a preponderance of the evidence that a person having ordinary skill in the art would have reason to combine the references as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

9. Analysis of Claim 8

Claim 8 recites,

in response to locating an image matching image characteristics of a subset of image data bound by the coordinates corresponding to the location of the named user within the image, providing to a computing device of the named user an interface configured for the named user to select or deselect users of the computer system for which to store an association with the unique image identifier.

Petitioner asserts that dependent claim 8 is obvious over the combination of Sharpe, Eintracht, and FotoFile because Sharpe teaches a graphical user interface displayed to the user and designed to receive input from any group member, and Eintracht teaches locating an image in the claimed manner as per its assertions for limitation 1[f]. Pet. 63–64 (citing Ex. 1005, 1:58–65, 2:5–9, 6:58–59, 9:4–7, Fig. 4). Dr. Bederson attests that a person having ordinary skill in the art “would have recognized that

Eintracht’s ability to overlay annotations is a configuration that allows for . . . the location of the annotation as overlaid on the image” that “would improve Sharpe’s archival and retrieval system by visually identifying where people are in an image to enhance the user experience.” Ex. 1003 ¶ 232.

Patent Owner argues that Petitioner “provides no explanation nor rationale for how, in the proposed combination, the displayed representation of the set of coordinates indicates the location of a named user within the image.” PO Resp. 37 (citing Ex. 2021 ¶ 106). Patent Owner further argues that Petitioner’s assertions for claim 8 are incorrect for the same reasons as argued with respect to limitation 1[e]. *Id.* at. 38–39. Dr. Saber attests that Petitioner applies a description of importing any image that does not teach claim 8’s requirement that such importing be “in response to” locating an image. Ex. 2021 ¶ 108.

We find Petitioner’s assertions to be supported by the record evidence. Dr. Bederson attests that Sharpe’s graphical user interface includes a drop down box with the names of other people in the group that any user, including the named user, can select to associate with the image. Ex. 1003 ¶ 236. Dr. Bederson further attests that the drop down box will be provided any time an image is imported, including when locating an image as per limitation 1[f]. *Id.* This testimony further comports with Sharpe’s description of the drop down box being provided in relation to work space area that is used “for displaying retrieved media items.” Ex. 1005, 6:58–7:2). We credit Dr. Bederson’s testimony in this regard.

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 the combined references. Further, we determine that Petitioner has shown by a preponderance of the evidence that a person

having ordinary skill in the art would have reason to combine the references as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

10. Analysis of Claims 9 and 10

Claim 9 recites,

determining a digital photo album associated with the named user, the digital photo album including a collection of images; and in response to locating an image matching image characteristics of a subset of image data bound by the coordinates corresponding to the location of the named user within the image, adding the image to the digital photo album associated with the named user.

Claim 10 recites, “the naming information includes one or more of a name, e-mail address, other naming information, or a home page address.”

Petitioner asserts that dependent claims 9 and 10 are obvious over the combination of Sharpe, Eintracht, and FotoFile. With respect to claim 9, Petitioner points to Sharpe’s description of adding a photo to a collection of digital images; i.e., a photo album. Pet. 66 (citing Ex. 1005, 2:12–16; 2:21–24, 3:57–63, 6:65–7:1, Fig. 4; Ex. 1003 ¶¶ 241–242). Dr. Bederson attests that a person having ordinary skill in the art “would have recognized the logical step after identifying images associated with a user is to add the images to a photo album.” Ex. 1003 ¶ 242. With respect to claim 10, Petitioner points to Sharpe’s disclosure of names; e.g., Sonia, in the drop down box 55. Pet. 67 (citing Ex. 1003 ¶ 244).

Patent Owner argues that claim 9 requires adding the image in response to locating an image, not in response to selection of the named user. PO Resp. 40. Patent Owner further argues that Petitioner fails to explain how and why the teachings of Sharpe, Eintracht, and FotoFile would

be modified to arrive at the features of claim 9; in particular, by referring to its allegedly flawed analysis of limitation 1[f]. *Id.* at 41. Patent Owner does not provide arguments with respect to claim 10 separate from those with respect to claim 1. PO Resp. 35.

We find Petitioner's assertions to be supported by the record evidence. Claim 9 's recitation of "in response to locating an image" refers back to claim 1, limitation 1[f], which recites "to locate images." We have determined that claim 1, including limitation 1[f], is met by Petitioner's proposed combination of prior art. *Supra* II(D)(4). As part of its proposed combination for limitation 1[f], Petitioner relies on FotoFile's algorithm that assigns an annotation "to ***all subsequently seen photos that contain faces that match the original.***" Pet. 53 (citing Ex. 1011, 4–5). Because the algorithm assigns names in response to subsequently "seen," i.e., located photos, Dr. Bederson's attestation that a person having ordinary skill in the art would add images having identified users to a photo album indicates that it would have been obvious to add users to a photo album in response to locating an image.

In view of the foregoing analysis for claims 9 and 10, and for independent claim 1 from which they depend, we determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claims 9 and 10 has been taught or suggested by the combined references. Further, we determine that Petitioner has shown by a preponderance of the evidence that a person having ordinary skill in the art would have reason to combine the references as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

11. Analysis of Claims 11 and 12

Claim 11 recites, “wherein naming information includes a screen name.” Claim 12 recites, “wherein a located image matching characteristics of the subset of image data does not have a prior stored association with the named user.”

With respect to claim 11, Petitioner points to Dr. Bederson’s statement that a person having ordinary skill in the art would understand that Sharpe’s username is also a screen name. *Id.* (citing Ex. 1003 ¶ 245). Patent Owner argues that the Petition maps the personal name to the claimed “naming information.” PO Resp. 41 (citing Pet. 38). Patent Owner argues that the Petition does not clearly explain how claim 11 is taught by the applied references. *Id.*; PO Sur-reply 13–14. Petitioner responds by pointing to its 1[a] assertions, arguing that because a “username and screen name are synonymous in many systems, it *also* would have been obvious to a [person of ordinary skill] in the art to include screen name in the naming information.” Pet. Reply 14 (citing Pet. 67).

With respect to claim 12, Petitioner points to FotoFile’s description, “[w]hen given photos that contain faces of new people, the face recognition system attempts to match the identity to the face,” so as to be able to match faces to correct identities in subsequently seen photos. Pet. 68 (citing Ex. 1011, 499–500). Patent Owner does not provide arguments separate from those with respect to claim 1. PO Resp. 35.

We determine that the record evidence supports Petitioner’s assertions. In its limitation 1[a] assertions, Petitioner equated the naming information to “a personal name” that “must be *associated* with the *named* user’s *username*.” Pet. 38 (citing Ex. 1003 ¶¶ 170–175; Ex. 1005, 8:26–29, cl. 29). Patent Owner did not contest this teaching for limitation 1[a]. Nor

does Patent Owner contest that a person having ordinary skill in the art would recognize that a screen name may be a personal name. Although the Petition requires the personal name to be “*associated* with” the screen name, it does not exclude both being the same. In light of Sharpe’s teaching that “names of group members” may be identified, and Dr. Bederson’s attestation that a personal name would be understood to be a possibility for a screen name, we are persuaded by Petitioner’s assertions.

We determine that Petitioner has sufficiently shown, by a preponderance of the evidence, that each element of claims 11 and 12 has been taught or suggested by the combined references. Further, we determine that Petitioner has shown by a preponderance of the evidence that a person having ordinary skill in the art would have reason to combine the references as suggested by Petitioner, and would have a reasonable expectation of success in doing so.

E. Obviousness over Sharpe, Eintracht, FotoFile, and Carey

Petitioner asserts that claims 1–12 are unpatentable over Sharpe, Eintracht, FotoFile, and Carey, in combination. Maintaining that the combination of Sharpe, Eintracht, and FotoFile teach each and every limitation of the claims, Petitioner proposes Carey “to the extent that the ‘contact’ list of claim 1 is construed to exclude Sharpe’s private groups.” Pet. 71.

Patent Owner argues against the Carey combination only in that “Carey does not cure the deficiencies discussed . . . regarding Sharpe-Eintracht-FotoFile.” PO Resp. 42 (citing Ex. 2021 ¶ 111); *see* PO Sur-reply 14 (“[f]or the same reasons as Ground 1, Petitioner’s analysis for Ground 2 is deficient”). Patent Owner argues that there is no dispute with regard to the “contact” list relevant to Petitioner’s use of Carey. PO Sur-reply 14.

Petitioner argues that Patent Owner “does not dispute motivation to combine Carey, nor Carey’s disclosures. Pet. Reply 15. Petitioner further argues that Patent Owner does not dispute Petitioner’s assertions for claim 11 with respect to Carey’s teaching of a screen name. *Id.*

Thus, the Carey ground relies upon Petitioner’s assertions for the Sharpe-Eintracht-FotoFile ground except for an uncontested issue. Because the Carey ground is subsumed by the Sharpe-Eintracht-FotoFile ground for all contested issues, and because we have found that all claims are unpatentable as obvious over the Sharpe-Eintracht-FotoFile combination, we do not reach Petitioner’s obviousness assertion over the Sharpe-Eintracht-FotoFile-Carey combination.

III. CONCLUSION⁴

Based on the fully developed record, Petitioner has demonstrated by a preponderance of the evidence that claims 1–12 are unpatentable under § 103 as being obvious over the combination of Sharpe, Eintracht, and FotoFile. A summary of our conclusions is set forth in the table below.

⁴ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
1–12	103(a)	Sharpe, Eintracht, FotoFile	1–12	
1–12	103(a) ⁵	Sharpe, Eintracht, FotoFile, Carey		
Overall Outcome			1–12	

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Petitioner has shown by a preponderance of the evidence that claims 1–12 of the '275 patent are unpatentable;

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.

⁵ Because these claims have been determined to be unpatentable over the combination of Sharpe, Eintracht, and FotoFile, we need not reach this asserted obviousness contention.

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