

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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META PLATFORMS, INC. ET AL.,  
Petitioner,

v.

ANGEL TECHNOLOGIES GROUP LLC,  
Patent Owner.

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IPR2023-00060  
Patent 10,628,480

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

CYGAN, *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 institution of *inter partes* review of claims 1–30 of U.S. Patent No. 10,628,480 (Ex. 1001, the “’480 patent”). 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 (Paper 14, “Pet. Reply”) and Patent Owner filed a Sur-reply (Paper 15, “PO Sur-reply”).

Pursuant to 35 U.S.C. § 314(a), 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.”

For the reasons given below, on this record Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of claim 3 of the ’480 patent. Accordingly, we institute an *inter partes* review as to claims 1–30 of the ’480 patent and the sole asserted ground of unpatentability.

### 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 '480 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 '480 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. 2–3. 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. 10,417,275 (IPR2023-00059). Pet. 2; Paper 4, 2.

*D. The '480 Patent*

The '480 patent is titled “Linking Tags to User Profiles.” Ex. 1001, code (54). The '480 patent issued from Application Serial No 16/537,227, filed on August 9, 2019, and claims priority, via continuation applications, to Provisional Application No. 60/248,994, filed on November 15, 2000. *Id.* at codes (21), (22), (60), (63).

The '480 patent relates to storing and sharing images through a communications network, and for 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 8:34–60. 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 appears in the Identifications database. *Id.* at 7:58–8:63, 9:49–50.

*E. Illustrative Claim*

Claim 3 is illustrative, and recites as follows:

A method implemented on one or more computing devices connected via a communications network, the method comprising:

by one or more computing devices, storing in memory accessible to the one or more computing devices descriptive naming information about a first user of the communications network, the descriptive naming information determined from a naming input received from a computing device of the first user;

by the one or more computing devices, storing in memory accessible to the one or more computing devices information determined from an associating input received from a computing device of a user of the communications network, the associating input indicating an association between the first user and an item of digital media, the associating input received separately from the naming input;

by the one or more computing devices, transmitting display data for presentation in a graphical user interface on a computing device of a viewing user, the display data indicating the association between the first user and the item of digital media such that a graphical display of the display data in the graphical user interface includes:

- i) information determined from the associating input,
- ii) descriptive naming information determined from the naming input, the descriptive naming information in the display data being information other than information received from the associating input, and
- iii) an element configured to provide a prompt to the viewing user to add an association between the first user and the viewing user;

by the one or more computing devices, receiving an input initiated by the viewing user indicating a request to add the association between the first user and the viewing user; and

responsive to receiving the input initiated by the viewing user, storing the association between the first user and the viewing user in memory accessible to the one or more computing devices.

*F. Evidence*

Petitioner relies on the following patent evidence.

| <b>Name</b> | <b>Patent Document</b> | <b>Exhibit</b> |
|-------------|------------------------|----------------|
| Robertson   | US 7,739,139 B2        | 1012           |
| Lloyd-Jones | US2002/0055955 A1      | 1013           |

Petitioner relies upon a declaration by Dr. Benjamin Bederson.

Ex. 1003.

*G. Prior Art and Asserted Grounds*

Petitioner asserts that claims 1–30 would have been unpatentable on the following grounds:

| <b>Claim(s) Challenged</b> | <b>35 U.S.C. §</b>  | <b>Reference(s)/Basis</b> |
|----------------------------|---------------------|---------------------------|
| 1–30                       | 103(a) <sup>1</sup> | Robertson, Lloyd-Jones    |

**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

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<sup>1</sup> Petitioner asserts, and we agree, that the pre-AIA patentability scheme applies to the ’480 patent. *See* Pet. 5 nn. 1–2.

of non-obviousness.<sup>2</sup> *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. 23 (citing Ex. 1003 ¶¶ 38–44). Patent Owner submits an essentially identical description of this hypothetical person. Preliminary Resp. 13–14. We do not determine any meaningful significance to the differences between the parties’ representations. For purposes of this Decision, we adopt Petitioner’s proposed level of ordinary skill as to its described lower limit, because it appears to be consistent with the specification of the ’480 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

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<sup>2</sup> Neither party presents evidence or arguments regarding objective evidence of non-obviousness at this stage.

entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Here, both parties assert that no term requires express construction. Pet. 24; Prelim. Resp. 14. We note that no term is in controversy, 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 Robertson and Lloyd-Jones*

Petitioner asserts that claims 1–30 are unpatentable under § 103(a) as obvious over Robertson and Lloyd-Jones. 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 3 is unpatentable under § 103(a) as obvious over the combination of Robertson and Lloyd-Jones.

*1. Robertson*

Robertson is titled “Social Network System.” Ex. 1012, code (54). Robertson relates to “multi-user computer systems, such as contact management systems, that provide services for users to locate and share personal information with other users.” *Id.* at 1:16–20. Robertson describes a multitude of tables to enable a variety of user services. *Id.* at 6:54–55. For example, Robertson may use a relational database containing a customer table, a friend table, a group table, an affinity table, an address table, a phone

table, and a travel event table. *Id.* at 4:35–43. Information in these tables may be gathered through user inputs on graphical user interfaces displayed on the user’s computer. *Id.* at 6:11–64.

2. *Lloyd-Jones*

a) *Summary*

Lloyd-Jones is titled “Method of Annotating an Image.” Ex. 1013, code (54). Lloyd-Jones relates to “a method and apparatus for generating metadata based on multi-media content.” *Id.* ¶ 1. Lloyd-Jones describes methods for annotating digital images, contemplating further applications to documents, video clips, or other computer-generated pages. *Id.* ¶ 23. In the described method, the user provides data through a user interface, and the computer software annotates an image using metadata. *Id.* ¶ 24. For example, a list of people’s names (metadata labels) may be extracted from an existing database or manual user input, and a user may annotate a feature in an image by selecting an icon, such as the name of a user appearing in the image. *Id.* ¶¶ 29–30.

b) *Status as Prior Art*

The burden of proving unpatentability in an *inter partes* review, including that a reference qualifies as prior art, rests solely with the Petitioner. 35 U.S.C. § 316(e); *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378–1379 (Fed. Cir. 2015). Patent Owner bears no countervailing burden except that it, not Petitioner, need provide evidence to support its assertions that Lloyd-Jones is not actually prior art (the “burden of production”) once Petitioner has satisfied its initial burden of going forward. *Id.* at 1378, 1381.

(1) *Priority to '994 provisional application*

A reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112, ¶ 1. *Id.* at 1381.

Petitioner asserts that Lloyd-Jones is prior art under 35 U.S.C. § 102(e) because Lloyd-Jones's filing date of April 6, 2001, is prior to the earliest effective filing date of the '480 patent. Pet. 5 n. 2, 15. Petitioner asserts that the invention claimed in the '480 patent is not supported by the written description of the provisional application to which it claims the benefit, U.S. Provisional Patent Application No. 60/248,994 ("the '994 application"), and therefore, is not entitled to its priority date of November 15, 2000. *Id.* at 15–16. Petitioner asserts that the earliest benefit date of the '480 patent is November 15, 2001, the filing date of the first utility application of a chain of continuations for which benefit is claimed. *Id.* at 15.

Petitioner asserts that the '994 application lacks four features claimed in the '480 patent: (1) a viewing user adding an association between themselves and a pictured user, (2) a first user providing naming input, (3) digital media, and (4) storage in memory. Pet. 14–19. We evaluate Petitioner's assertions, and Patent Owner's arguments and evidence to the contrary. Because we determine that the record supports Petitioner's assertion that its first-listed claim limitation is not supported in the written description of the '994 application, we need not further analyze Petitioner's remaining assertions.

Petitioner asserts that claim 3 requires that a viewing user adds an association between that viewing user and a pictured user (or "first user").

Pet. 14. Petitioner asserts that the '994 application describes that a viewing user clicks on the image and identifies a person in the image. *Id.* (citing Ex. 1014, 5). Petitioner asserts that this is an association between the image and the person in the image, not between the viewing user and the pictured user. *Id.* at 14–15 (citing Ex. 1003 ¶ 59).

Patent Owner argues that the '994 application describes a mapping database that stores information about users and images. Prelim. Resp. 16 (citing Ex. 2017, 2). Patent Owner argues that this describes associations between users in the images, including multiple users in the same photo, which are stored in tables. *Id.* at 16–17 (citing Ex. 2017, 2–3); PO Sur-Reply 2.

We turn to the language of illustrative claim 3, which neither party has attempted to construe. Claim 3 requires a request “initiated by the viewing user.” Ex. 1001, 18:42. That request is to “add the association between the first user” and the viewing user. *Id.* at 18:42–43. The request is prompted by an element of the graphical user interface to the viewing user. *Id.* at 18:38–40. The prompt and request are separate from the information provided by the naming input and from the input associating the first user and an item of digital media. *Id.* at 18:30–40.

Based upon the evidence presented at this juncture, we determine that the '994 application lacks description of a viewing user adding an association between themselves and a pictured user. The '994 application explicitly provides for only a single type of input from the viewing user – identifying a person in an image. Ex. 2017, 4 (“a client identifies a person appearing in an image and sends the appropriate information to a server for

storage”).<sup>3</sup> Following that identification, the server creates a record of the association between the image and the identified person in that image in a “Mappings database.” *Id.* at 6 (“The server receives the information and inserts a record with the user identifier, the image identifier, and the corresponding coordinates into the Mappings database”).

As argued by Patent Owner, the Mappings database will reflect the existence of multiple users in the same image:

| Mappings database |         |          |              |               |
|-------------------|---------|----------|--------------|---------------|
| Mappings ID       | User ID | Image ID | Relationship | Coordinates   |
| 060786            | 007     | ABCD     | In photo     | 50,50,100,100 |
| 060787            | 008     | ABCD     | In photo     | 0,50,75,100   |

Ex. 2017, 3 (showing a Mappings ID, User ID, Image ID, Relationship, and Coordinates for two users in the same image). However, it is the server, not the viewing user, that relates the two users together:

When the server retrieves information from the Mappings database, it will look for all mappings with an Image ID equal to a supplied ID (e.g., “ABCD”). In this example it will look for occurrences of “ABCD” in the Image ID field. This will result in finding two records (060786 & 060787). Each record links a user to an area within the image.

*Id.* at 3–4.

The involvement of the user is limited to identifying the name and location of the persons in an image, which is recited in limitation 3[b] as “an associating input received from a user . . . indicating an association between the first user and an item of digital media.” There is no description in the ’994 application of limitation 3[c3]’s “prompt to the viewing user to add an association between the first user and the viewing user,” or limitation 3[d]’s

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<sup>3</sup> For clarity, we follow Patent Owner’s convention of using the page number of the ’994 application, rather than the page numbers of the (unpaginated) Exhibit 2017.

“receiving an input initiated by the viewing user indicating a request to add the association between the first user and the viewing user.”

Consequently, we determine on the current record for purposes of institution that the invention claimed in the ’480 patent is not supported by the written description of the ’994 application. Accordingly, the effective filing date of the ’480 patent is no earlier than the November 15, 2001, the filing date of the first in the chain of continuations for which benefit is claimed. Because Lloyd-Jones’s filing date of April 6, 2001, predates the effective filing date of the ’480 patent, Lloyd-Jones is available as prior art.

(2) *Earlier date of invention*

Patent Owner argues that even if the ’480 patent may not benefit from the filing date of the ’994 application, the inventor of the ’480 patent was the first to invent the claimed invention, and that the evidence of record shows that the ’480 patent antedates the Lloyd-Jones reference. Prelim. Resp. 19.

Patent Owner further argues that Petitioner did not challenge that the ’480 patent is entitled to priority based on the filing date of the provisional application. Prelim. Resp. 23. However, this is incorrect. Petitioner did challenge the entitlement to the earlier filing date. Pet. 10–12.

(a) *Legal Standards*

For a patent in which at least one claim has an effective filing date prior to the American Invents Act’s revisions to 35 U.S.C. § 102, patentability reflects “the principle that the patent right is granted to the first inventor rather than the first to file a patent application.” *Paulik v. Rizkalla*, 760 F.2d 1270, 1272 (Fed. Cir. 1985). The applicable version of § 102 requires that a prior art reference be “before the invention thereof by the applicant for patent,” unless the reference qualifies under the statutory bar provisions of §§ 102(b),(d). 35 U.S.C. § 102 (Nov. 2, 2002). Lloyd-Jones’s

filing date of April 6, 2001, is less than one year before the November 15, 2001, effective filing date of the '480 patent, as we have determined in the prior section of this decision, and therefore neither statutory bar provision is applicable.

Thus, Patent Owner may produce evidence to show that the filing date of Lloyd-Jones was not available as prior art before the date of invention of the '480 patent. *Mahukar v. C. R. Bard*, 79 F.3d 1572, 1576 (Fed. Cir. 1996). If an earlier date of invention is shown, Lloyd-Jones is no longer prior art. *Id.*

To show an earlier date of invention, the inventor of the '480 patent must be the first to conceive and the first to reduce to practice, because “the person who first reduces an invention to practice is ‘prima facie the first and true inventor.’” *Id.* at 1577 (quoting *Christie v. Seybold*, 55 F. 69, 76 (6th Cir. 1893) (Taft, J.)). Alternately, the inventor must be “the first to conceive the invention and [have] exercised reasonable diligence in later reducing that invention to practice.” *Id.* (citing *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993)).

Patent Owner does not clearly state whether its theory of antedating is based upon an actual reduction to practice prior to the filing date of Lloyd-Jones, or conception prior to the filing date of Lloyd-Jones coupled with reasonably continuous diligence from just prior to the filing date of Lloyd-Jones until the date of the invention’s reduction to practice. We consider both possibilities.

*(b) Actual Reduction to Practice*

With respect to actual reduction to practice, Patent Owner states that “the invention was conceived prior to the effective date of Lloyd-Jones coupled with Patent Owner’s diligence to actual reduction to practice.”

Prelim. Resp. 24. Patent Owner argues that the “concept of photo-tagging, in accordance with the Challenged Claims,” was conceived “at least as early as April 2000,” based upon a declaration by the inventor, Mr. Frigon, and other supporting evidence. *Id.* at 23–24. Patent Owner points to Mr. Frigon’s Declaration as establishing that code for this purpose was developed starting in April 2000. *Id.* at 24 (citing Ex. 2005). Patent Owner also asserts that “the code . . . was up and running” in September 2000. *Id.* at 23–24. Patent Owner asserts that Mr. Frigon’s Declaration, corroborated by Chris Malone’s Declaration, “permits the Patent Owner to swear behind the Lloyd-Jones reference.” *Id.* (citing Exs. 2005, 2016).<sup>4</sup>

We determine that the current record lacks sufficient evidence to show an actual reduction to practice. For actual reduction to practice, no showing of diligence is required, but as recognized by Patent Owner, “an inventor must prove that he constructed his claimed invention and that it would work for its intended purpose.” *Mazzari v. Rogan*, 323 F.3d 1000, 1005 (Fed. Cir. 2003) (cited at Prelim. Resp. 20–21). Mr. Frigon states that evidence of the reduction to practice of “elements of the invention claimed” is shown in attached copies of the code last modified on April 16, 2000. Ex. 2005 ¶¶ 4–5. We have reviewed Mr. Frigon’s Declaration, which provides claim mapping for other related patents, but not for the ’480 patent. Ex. 2005. Mr. Frigon does not provide any testimony pertaining to the claim requirements of providing a prompt to a viewing user to add an association to a first user, or receiving an input initiated by a viewing user indicating a request to add an association to a first user. *Id.* At best, Mr. Frigon testifies that “the ‘pictures.mdb’ database and the ‘links.asp’ code demonstrate a

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<sup>4</sup> Mr. Malone is a former roommate of Mr. Frigon. Prelim. Resp. 24.

stored association between users who appear in the same photo.” *Id.* ¶ 14. Because of the lack of evidence for the indicated claim requirements, there is insufficient evidence at this time to show that Mr. Frigon “constructed his claimed invention” as per *Mazzari*.

(c) *Constructive Reduction to Practice  
and Reasonably Continuous Diligence*

Conception requires “a definite and permanent idea of the complete and operative invention.” *Mahukar*, 17 F.3d at 1577 (citing *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994)). In establishing that such an idea existed at the relevant time, an inventor’s testimony requires corroboration, and “[a]n evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the inventor’s story may be reached.” *Id.* (quoting *Price*, 988 F.2d at 1195) (explaining that “[t]his requirement arose out of a concern that inventors testifying in patent infringement cases would be tempted to remember facts favorable to their case by the lure of protecting their patent”).

Patent Owner relies upon Mr. Frigon’s Declaration, “subsequent corroborating evidence and additional third party declarations,” and the content of the ’994 provisional patent application to show conception. Prelim. Resp. 21; PO Sur-Reply 2.

Patent Owner argues that Mr. Frigon’s Declaration shows that Mr. Frigon “was in possession of at least as much of the subject matter as relied upon . . . from the Lloyd-Jones reference.” Prelim. Resp. 23. Patent Owner points to the code exhibits as demonstrating that Mr. Frigon had conceived of the “concept of photo-tagging.” *Id.* at 24. However, as discussed *supra*, Mr. Frigon does not provide any testimony pertaining to the claim requirements of providing a prompt to a viewing user to add an

association to a first user, or receiving an input initiated by a viewing user indicating a request to add an association to a first user. Ex. 2005.

Patent Owner further points to the alleged August 15, 2000 completion date of the document filed later as the '994 provisional application as providing written description support for the disputed claim elements. Prelim. Resp. 23; PO Sur-reply 2. However, as discussed *supra*, the '994 provisional application does not provide support for providing a prompt to a viewing user to add an association to a first user, or receiving an input initiated by a viewing user indicating a request to add an association to a first user. Ex. 2017.

Patent Owner cites *In re Scheiber* for the proposition that a reference may be antedated by showing prior invention “with respect to only so much of the claimed invention as the references disclose, . . . or only so much as to render the claimed invention obvious.” Prelim. Resp. 22 (citing *In re Scheiber*, 587 F.2d 59 (CCPA 1978)); *see also* Prelim. Resp. 20 (citing *In re Stempel*, 241 F.2d 755, 759 (CCPA 1957) (discussing the extent of a generic claim needing to be shown for anticipation)). However, Patent Owner’s interpretation of *Scheiber* and *Stempel* has been expressly foreclosed, as an unwarranted expansion of the limited genus-species situation in *Stempel* and *Scheiber*. *In re Tanczyn*, 347 F.2d 830 (CCPA 1965). As stated therein,

We never intended by the language used in *Stempel* to authorize the overcoming of references by affidavits showing that the applicant had invented, prior to the reference date, a part, some parts, or even a combination of parts, used to create an embodiment of his claimed invention, where the part or parts are not within the scope of the claims being sought, as the species of *Stempel* shown by the reference was within his generic claims.

*Tanczyn*, 347 F.2d at 833. The *Tanczyn* court further explained,

It does not appear to us logical that one should be permitted to dissect the invention, in this instance the claimed combination, into several parts and then say because he has invented one such part prior to a reference disclosing that part that he has also invented the entire combination prior to that reference, even though other references combined therewith to meet 'the invention' bear an earlier date.

*Id.* at 832.

The Federal Circuit later reinforced this holding, stating, "The claims at issue in *Janin* were not completely supported by the disclosure of any one parent application, and, thus, could not meet the § 112, ¶ 1 requirement." *Studiengesellschaft Kohle, M.B.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564–65 (Fed. Cir. 1997) (finding erroneous the Board's determination that parent applications may be combined to support a later claim, as presented in *Ex parte Janin*, 1919 WL 25149 (Bd. App. 1979)). In that case, *Scheiber* was cited for the proposition that "[a]n applicant cannot show possession of an invention based upon a combination of several distinct previous applications unless he shows that one of the applications discloses the invention." *Id.* at 1654 (citing *Scheiber*, 587 F.2d at 59 (Baldwin, J., concurring)). *Studiengesellschaft Kohle* clearly states, "a claim that relies upon a combination of previously-filed applications is not to be entitled to an earlier filing date because the applicant has not demonstrated possession of the complete invention at the time of an earlier application," *Id.* Patent Owner's suggested approach to antedating Lloyd-Jones by showing prior conception of only those elements described by Lloyd-Jones is, therefore, not an acceptable method of showing prior invention.

For the above reasons, the evidence in the record at the present time does not show prior conception of the claimed invention.

Reasonable diligence “must be shown throughout the entire critical period, which begins just prior to the competing reference’s effective date, and ends on the date of the invention’s reduction to practice.” *Perfect Surgical Techniques, Inc. v. Olympus America, Inc.*, 841 F. 3d 1004, 1007 (Fed. Cir. 2016). The diligence need only be “reasonably continuous,” permitting periods of inactivity within the critical period. *Id.* at 1010–1011. However, the showing of diligence must be sufficient “to assure that, in light of the evidence as a whole, ‘the invention was not abandoned or unreasonably delayed.’” *Id.* at 1009 (quoting *Brown v. Barbacid*, 436 F.3d 1376, 1379 (Fed. Cir. 2006)).

Thus, with respect to diligence, the critical period here begins just prior to Lloyd-Jones’s filing date of April 6, 2001, and ends on the date of the invention’s reduction to practice. As discussed, there is insufficient evidence to show actual reduction to practice of the claimed invention. The date of constructive reduction to practice is the date of the earliest filing of an application in the chain of priority that sufficiently describes the claimed invention. As discussed above, on the present record, we do not agree that Patent Owner shows constructive reduction to practice as of the date of the ’944 provisional application. Petitioner proceeds under the assumption that the earliest non-provisional application in the chain of priority to which the ’480 claims benefit provides sufficient written description support. Pet. 10–12. The effective filing date of that application is November 15, 2001. Ex. 1001, code (63).

Patent Owner has not provided any explanation of diligence to that date, nor is such evident from the record. Consequently, the evidence in the record at the present time does not show reasonably continuous diligence to the invention’s reduction of practice.

(d) *Summary*

For the reasons given above, we determine that Lloyd-Jones is available as prior art.

3. *Analysis of Claim 3*

We begin our analysis of Petitioner's obviousness contentions with Petitioner's assertions as to claim 3.

*a) 3[pre]: method implemented on one or more computing devices connected via communications network*

Petitioner asserts that this limitation, to the extent limiting, is described by Robertson, pointing to Robertson's description of client computers connected via the World Wide Web to each other and a server. Pet. 27–28 (citing Ex. 1012, 3:65–41; Ex. 1003 ¶¶ 146–147).

*b) 3[a]: storing in memory descriptive naming information about first user determined from naming input received from first user*

Petitioner asserts that this limitation is described by Robertson, pointing to Robertson's description of storing descriptive naming information about a first user of the communications network, such as user's first and last name, which is entered by the user through a pseudo graphical user interface on the user's computer, and stored on a server computer in a "Customer Table." Pet. 28–30 (citing Ex. 1012, 4:48–54; 6:29–34, 6:57–64; Ex. 1003 ¶ 150).

*c) 3[b]: storing in memory information determined from an associating input received from a user, the associating input indicating an association between the*

*first user and an item of digital media, the associating input received separately from the naming input*

Petitioner points to Robertson's description of storing information associating a user to other information, such as schools, groups or other organizations, specified by the user. Pet. 31–32 (citing Ex. 1012, 2:60–62, 6:39–56; Ex. 1003 ¶¶ 153–155). Petitioner points to this information as being stored in an “Affinity Table.” *Id.* at 32 (citing Ex. 1012, 5:14–15, Fig. 6). Petitioner characterizes the different data fields through which the user submits this information as describing that the user's associations are received separately from the user's name. *Id.* at 33 (citing Ex. 1012, Fig. 7; Ex. 1003 ¶ 156). Additionally, Petitioner asserts that Robertson's description that the user can later update their personal record is a description of information from different data fields being submitted and received separately from each other. *Id.* at 33–34 (citing Ex. 1012, 6:19–23, 11:15–17; Ex. 1003 ¶ 157).

With respect to the other associated information being an item of digital media, Petitioner points to Lloyd-Jones's description of an association list, in a storage device, indicating an association between a person's name and an image. *Id.* at 34–35 (citing Ex. 1013 ¶¶ 30–31).

Petitioner asserts that a person of ordinary skill in the art would have modified Robertson's social networking system to include an association between a user and an image in an association list, as an Image Affinity Table, including the image ID and the user's Customer ID. *Id.* at 35–36 (citing Ex. 1003 ¶ 160). Petitioner asserts that such a combination would further Robertson's objective of providing “services or assisting users in locating, and establishing contact relationships, with other users.” *Id.* at 36 (citing Ex. 1012, 2:60–62). Petitioner asserts that the additional associations

provided between users and images would assist users to connect with other users appearing in the same images. *Id.* (citing Ex. 1003 ¶ 161).

Dr. Bederson states that a person having ordinary skill in the art would have recognized the importance of images to establishing relationships and connections. *Id.* at 25 (citing Ex. 1003 ¶ 139). Dr. Bederson further states that such image associations “would have been a natural extension of Robertson’s Travel Event feature . . . [in which] the user may be notified that he will be crossing paths with another user. *Id.* at 24–25 (citing Ex. 1003 ¶ 140). Dr. Bederson also states that the use of photo management was a known design option in a social networking system. *Id.* at 25 (citing Ex. 1003 ¶141). Dr. Bederson further states that Robertson and Lloyd-Jones share a web-based, multi-user collaborative design having the capability of searching for user information, such that a person having ordinary skill in the art would have expected success in combining the relied-upon teachings. *Id.* at 25–27 (citing Ex. 1003 ¶¶ 142–144).

Patent Owner argues that Petitioner “simply picks and chooses among citations in the references, and then offers no or only a conclusory comparison between these citations and the claimed limitations.” Prelim. Resp. 25–27. Patent Owner argues that Petitioner provides only the statement that “it would have been well within the skill of a POSA to add the image annotations and affiliations taught by Lloyd-Jones as additional relational tables in Robertson’s database.” *Id.* at 26–27. Patent Owner argues that this is conclusory because Petitioner does not provide any reasoning for why image annotations would be necessary or relevant to a relational table.

We disagree with Patent Owner on this point. Patent Owner focuses on a single statement of Petitioner, yet Petitioner provides significantly more

analysis than that statement. As summarized above, Petitioner points to improvement in associating contacts, extending the capabilities of Robertson’s Travel Event feature, and the known use of images in social networking at the relevant time. We determine that Petitioner has sufficiently shown reason to combine the teachings of Robertson and Lloyd-Jones.

We further determine that Petitioner has shown a reasonable expectation of success in the combination. Supported by its declarant, Petitioner asserts that both Robertson and Lloyd-Jones are “web-based, multi-user collaborative systems with the express capability of searching for user information,” and can be implemented “over the Internet via the World Wide Web” through the use of graphical interfaces to interact with users and to import information from a database. Pet. 26 (citing Ex. 1003 ¶¶ 142–144). We determine in view of Dr. Bederson’s testimony that the record presents sufficient evidence of a reasonable expectation of success in the combination.

*d) 3[c]: transmitting display data for presentation in a graphical user interface on a computing device of a viewing user, the display data indicating the association between the first user and the item of digital media*

Petitioner points to Robertson’s description of transmitting pseudo graphical user interfaces for display on the user’s computer. Pet. 36–37 (citing Ex 1012, 6:12–15, 6:65–67). Petitioner further points to Lloyd-Jones’s description that a user hovering a mouse cursor over the image of a tagged person will cause that person’s name to appear at the position of the person in the image; i.e., an association between the user and the image. *Id.* at 37 (citing Ex. 1013 ¶¶ 30–31, 36, 40; Ex. 1003 ¶ 164). As detailed for limitation 3[b], Petitioner asserts that the combination of Lloyd-Jones’s

image association features with Robertson “would have advanced Robertson’s objective to establish contact relationships by sharing information about shared contacts. *Id.* at 38 (citing Ex. 1012, 2:60-62; Ex. 1003 ¶165).

*e) 3[c1]: display includes information determined from the associating input*

Petitioner points, in the combination to Lloyd-Jones’s display of the user’s name on the corresponding person in an image as teaching this limitation. Pet. 38–39 (citing Ex. 1013 ¶¶ 30–31).

*f) 3[c2]: display descriptive naming information determined from naming input, that is information other than information received from the associating input*

Petitioner points, in the combination, to the user’s name being received from a user entering information into a graphical user interface in Robertson, and to the image association being received by the user creating an affiliation between the user’s Customer ID and the image ID 1; i.e., different information. Pet. 40–41 (citing Ex. 1012, 4:44–48, f:12–22; Ex. 1013 ¶¶ 30, 31, 36; Ex. 1003 ¶¶ 174). Petitioner asserts that the displayed user’s name (e.g., “Liza Hayward”) is different than the non-displayed associating input (“CustomerID”). *Id.* at 41.

*g) 3[c3]: display element configured to provide prompt to viewing user to add an association between first user and viewing user; 3[d]: receiving input initiated by viewing user indicating request to add association between first user and viewing user; 3[e]: responsive to receiving the input, storing association between first user and viewing user in memory.*

Petitioner points, in the combination, to the text in the graphical user interface of Robertson’s Figure 8, which states, “Click on the boxes next to the names of people you’d like to add to your address book,” in which the

boxes indicate the names of “other members who went to your college at about the same time.” *Id.* at 41–43 (citing Ex. 1012, Fig. 8). Petitioner further points to Lloyd-Jones’s tagging functionality, and reasons to combine such with Robertson’s system, as previously discussed. *Id.* at 44–48. Petitioner asserts that submitting such input adds information to the viewing user’s personal address book, where it is stored in the appropriate tables of the database 340 on server computer 330, such as “Friend Table 460 [that] relates users to each other.” *Id.* at 48–49 (citing Ex. 1012, 4:49–62, 7:28–36, Figs. 6, 8; Ex. 1003 ¶ 182).

### III. CONCLUSION

For the reasons discussed above, we conclude Petitioner has shown a reasonable likelihood of prevailing with respect to claim 3 of the ’480 patent. We determine that the record supports institution. Accordingly, we institute an *inter partes* review of all challenged claims under the sole ground set forth in the Petition.

Our determination at this stage of the proceeding is based on the evidentiary record currently before us. This decision to institute trial is not a final decision as to patentability of any claim for which *inter partes* review has been instituted. Our final decision will be based on the full record developed during trial.

### 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 for the following asserted ground:

| Claims Challenged | 35 U.S.C. § | Reference(s)/Basis     |
|-------------------|-------------|------------------------|
| 1–30              | 103(a)      | Robertson, Lloyd-Jones |

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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Patent 10,628,480

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