Trials@uspto.gov
571-272-7822

Paper 12
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

PGR2022-00006
Patent 11,017,020 B2

Before LYNNE H. BROWNE, KEVIN C. TROCK, and
JASON M. REPKO, *Administrative Patent Judges.*

REPKO, *Administrative Patent Judge.*

DECISION
Granting Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a petition to institute a post-grant review of claims 1–59 of U.S. Patent No. 11,017,020 (Ex. 1001, "the '020 patent"). Paper 1 ("Pet."). MemoryWeb, LLC ("Patent Owner") filed a Preliminary Response. Paper 8 ("Prelim. Resp."). With the Board's authorization, Petitioner filed a Reply (Paper 10) and Patent Owner filed a Sur-reply (Paper 11).

Institution of post-grant review requires that the petition, if not rebutted, demonstrate that it is more likely than not that at least one challenged claim is unpatentable. 35 U.S.C. § 324(a). Applying that standard, we institute a post-grant review.

A. Related Matters

According to the parties, the '020 patent is, or has been, involved in the following proceedings: *MemoryWeb, LLC v. Apple Inc.*, No. 6-21-cv-00531 (W.D. Tex.); *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 6-21-cv-00411 (W.D. Tex.); *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, No. 1-21-cv-02666 (N.D. Ill.); IPR2022-00111; IPR2022-00033; IPR2022-00032; IPR2022-00031; and IPR2021-01413. Pet. 3; Paper 6, 2–3 (Mandatory Notices).

Patent Owner also identifies the following proceedings as related: IPR2022-00222; IPR2022-00221. Paper 6, 2.

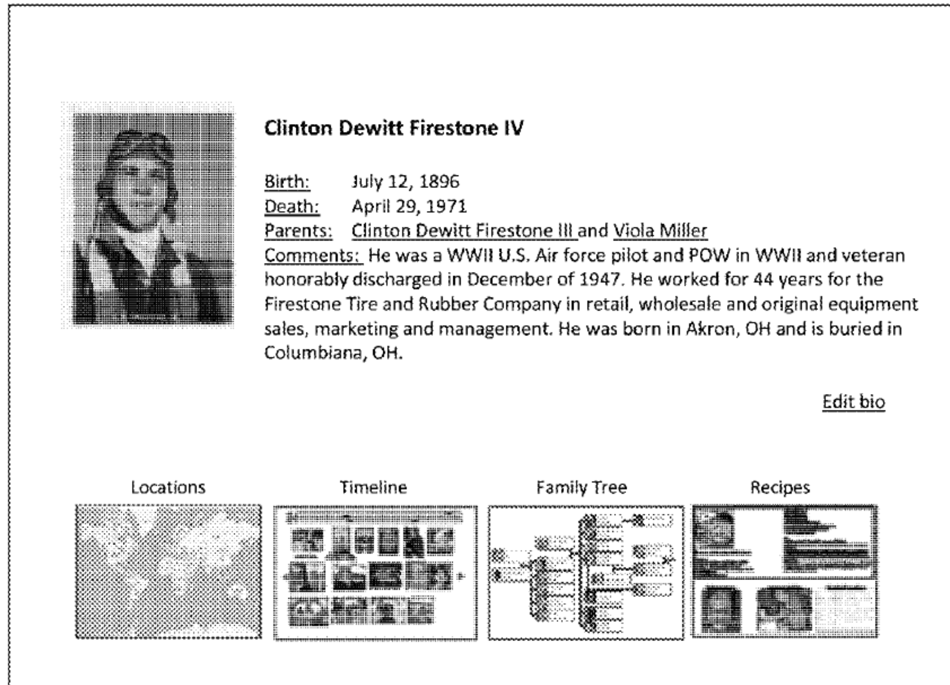
B. The '020 Patent

The '020 patent relates to a platform for managing and using digital files, such as digital photographs. *See* Ex. 1001, 1:22–24. Through the platform's interface, a user can tag and select files to create views. *See id.* at 5:40–45. For example, the "people view" is shown below. *Id.* at 6:24–26, Fig. 6.

FIG. 6

The people view, above, shows thumbnail photos of all the people in the system. *Id.* Clicking on the thumbnail causes a "profile view," shown below, to be displayed. *See id.* at 6:24–30.

FIG. 7



The profile view, above, displays a person's image, date of birth, date of death, parents' names, and other biographical information. *Id.* at 6:26–30. The profile view also displays links to other views containing information about the person: Locations, Timeline, Family Tree, and Recipes. *Id.* The Locations view, for example, has an interactive map showing where the digital files were taken. *Id.* at 6:18–23.

C. Claims

Of the challenged claims, claims 1 and 31 are independent. Claim 1 is reproduced below.

> 1. A method comprising:
>
> causing an interface to display a people view, the people view including:
>
> a first thumbnail image associated with a first person,
>
> a first name associated with the first person,

a second thumbnail image associated with a second person, and

a second name associated with the second person;

responsive to an input that is indicative of a selection associated with the first person, causing a first person view to be displayed on the interface, the first person view including:

a first digital file associated with the first person,

the first name associated with the first person, and

a first map image;

responsive to an input that is indicative of a selection of the first map image in the first person view, causing a first location view to be displayed on the interface, the first location view including:

an interactive geographic map,

a first indication positioned at a first location on the interactive geographic map, and

a second indication positioned at a second location on the interactive geographic map; and

responsive to an input that is indicative of a selection of the first digital file in the first person view, causing a slideshow to be displayed on the interface, the slideshow including a plurality of images associated with the first person.

Ex. 1001, 35:17–45.

D. Evidence

Name	Reference	Exhibit No.
A3UM	Aperture 3 User Manual, Apple Inc. (2010)	1005

E. Asserted Grounds

Petitioner asserts that claims 1–59 are unpatentable on the following grounds. Pet. 3.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–59	103	A3UM
6, 7, 38, 39	112(a)	Written Description

II. ELIGIBILITY FOR POST-GRANT REVIEW

As a threshold matter, we must determine whether Petitioner has shown that the '020 patent is eligible for post-grant review. *See Commonwealth Sci. & Indus. Res. Org. v. BASF Plant Sci. GmbH*, PGR2020-00033, Paper 11, 7 (PTAB Sept. 10, 2020); *Mylan Pharms. Inc. v. Yeda Res. & Dev. Co.*, PGR2016-00010, Paper 9, 10 (PTAB Aug. 15, 2016); *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 17, 9–12 (PTAB Jan. 29, 2016).

The post-grant review provisions in section 6(d) of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (September 16, 2011) ("AIA") apply only to patents subject to the first-inventor-to-file provisions of the AIA. *See* AIA § 6(f)(2)(A) (stating that the provisions of section 6(d) "shall apply only to patents described in section 3(n)(1)"). Patents subject to the first-inventor-to-file provisions are those that issue from applications that contain or contained at any time—

> (A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after [March 16, 2013]; or
>
> (B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

AIA § 3(n)(1).

A "transition application" is an application filed on or after March 16, 2013 that claims the benefit of an earlier filing date. MPEP § 2159.04 (9th ed. Rev. 10.2019, June 2020). For these applications, entitlement to the benefit of an earlier date under 35 U.S.C. §§ 119, 120, 121, or 365 is based on the disclosure of the claimed invention "in the manner provided by § 112(a) (other than the requirement to disclose the best mode)" in the

earlier application. 35 U.S.C. §§ 119(e), 120. So, for a patent issuing from a transition application, eligibility for post-grant review depends on whether the patent contains or contained at any time a claim that lacks written description and enabling support in a priority application filed before March 16, 2013, or a priority application contains or contained such a claim at any time.

Petitioner asserts that the ’020 patent is eligible for post-grant review for two reasons: First, Petitioner asserts that the ’020 patent claims the benefit of applications that issued as the U.S. Patent No. 9,552,376 (“the ’376 patent”) and U.S. Patent No. 10,423,658 (“the ’658 patent)”), and “[e]ach contains claims that Patent Owner has represented in related litigation are entitled to a priority date of February 28, 2014,” which is after the AIA’s effective date. Pet. 9. Second, Petitioner asserts that, while the application that issued as the challenged patent was pending, “it contained original claims 15 to 17, which recite features with no written description support in [U.S. Application No. 13/157,214] filed [on June 9, 2011].” *Id.* at 10. Thus, Petitioner asserts that, during prosecution, the challenged patent’s application “‘contained . . . a claim to a claimed invention that has an effective filing date . . . that is on or after the effective date’ of the AIA.” *Id.* at 12 (citing AIA § 3(n)(1)).

Patent Owner agrees with Petitioner that the ’020 patent is eligible for post-grant review because it “claims the benefit of the ’376 patent and ’658 patent, each of which includes claims entitled to a priority date after the March 16, 2013 ‘effective date’ of the AIA.” Prelim. Resp. 6; *see also* Ex. 1027, 2.

We agree that the claims are eligible for at least this reason. The application that matured into the ’020 patent claims priority to two

applications filed after March 16, 2013: U.S. Application No. 15/375,927, filed on December 12, 2016 and issued as the ’658 patent”, which is a continuation of U.S. Application No. 14/193,426, filed on February 28, 2014 and issued as the ’376 patent. Ex. 1001, code (63). The parties agree that the ’658 patent and the ’376 patent include claims entitled to a priority date after March 16, 2013. Pet. 9; Prelim Resp. 6. In at least this way, the challenged patent “contains a specific reference under 35 U.S.C. § 120 to a patent or application that ‘contains or contained at any time’ a claim with an effective filing date ‘after the effective date’ of the AIA.” AIA § 3(n)(1)

Thus, the ’020 patent is eligible for post-grant review. *See* Pet. 9; Prelim. Resp. 6.

III. ANALYSIS

A. Level of Ordinary Skill in the Art

According to Petitioner,

> A person of ordinary skill in the art in 2011 would have had (1) at least a bachelor’s degree in computer science, computer engineering, or electrical engineering, and (2) at least one year of experience designing graphical user interfaces for applications such as photo management systems.

Pet. 12 (citing Ex. 1003 ¶¶ 44–46). At this stage, Patent Owner does not rebut Petitioner’s proposed skill level. *See* Prelim. Resp. 8.

For the purpose of this decision, we apply Petitioner’s proposed definition, which appears to be consistent with the level of skill reflected in the asserted reference. If Patent Owner proposes a different level of ordinary skill in the art in its Response, the parties are encouraged to explain how the differences affect the obviousness analysis.

B. Claim Construction

We need only construe terms that are in controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner asserts that "[b]ecause a skilled artisan would find the challenged claims unpatentable under any interpretation consistent with their plain and ordinary meaning in the context of the '020 patent, the Board need not expressly construe the claims." Pet. 15.

Patent Owner does not propose constructions for any terms at this stage of the proceeding. *See* Prelim. Resp.

On the current record, no terms are in controversy. So we agree with the parties that no claim term needs to be construed here.

C. Status of A3UM as a Printed Publication

1. The A3UM File Set

All Petitioner's challenges rely on A3UM. *See* Pet. According to Petitioner, the A3UM is a user manual for Apple's Aperture 3 product that was published in two forms: an HTML file set and a PDF file. *Id.* at 16. The challenges in the Petition are based on the HTML file set. *Id.* (citing Ex. 1005). In this Decision, we refer to those files as the "A3UM file set."

According to the testimony of Matthew Birdsell, an Apple employee, the A3UM file set "was included on the installation DVD in retail packages of Aperture 3 that were sold and distributed within the United States in early 2010 and was copied to local storage of a computer during installation of Aperture 3 ([Ex. 1020 ¶¶ 12–16]), and . . . was also published on the www.apple.com website ([*id.* ¶¶ 17–20])." *Id.* According to Petitioner, Dr. Terveen testifies that Exhibit 1005 "is a true and correct copy of the HTML

file set both on the Aperture 3 installation DVDs and as copied to computers during Aperture 3's installation." *Id.* at 17–18 (citing Ex. 1003 ¶¶ 72, 89, 96–97). In Petitioner's view, the Aperture 3 User Manual, Exhibit 1005, is a "printed publication that was publicly disseminated in February 2010." *Id.* at 15.

Patent Owner argues that neither the files from the DVD nor those on Apple's website qualify as printed publications. *See* Prelim. Resp. 10–19; Sur-reply.

For the reasons that follow, Petitioner sufficiently shows, at this stage and on this record, that the A3UM file set from Apple's website qualifies as a printed publication. Thus, at this stage of the proceeding, we need not resolve whether the A3UM file set on the DVD or installed on a computer is a printed publication.

2. Analysis

The Board has found, at institution, that a collection of related electronic documents, such as a website with multiple webpages, could qualify as a printed publication. *Halliburton Energy Servs., Inc., v. Dynamic 3d Geosolutions LLC*, IPR2014-01186, IPR2014-01189, IPR2014-01190, Paper 13, at 15–21 (PTAB Jan. 12, 2015). In that case, the Board contrasted a single website with the collection of distinct documents at issue in *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1351–52 (Fed. Cir. 2008). *See id.* *Kyocera* held that the GSM[1] technical standard at issue, which comprised a collection of standards, was not a single prior art reference. 545 F.3d at 1351. The standards included "hundreds of individual specifications drafted

[1] GSM stands for "Global System for Mobile Communications." *Kyocera*,545 F.3d at 1350. "The GSM standard is a comprehensive set of specifications for a second generation ('2G') mobile network." *Id.*

by approximately ten different subgroups," and the Federal Circuit noted that "one of the most knowledgeable people in the world . . . had not read the entire [GSM] standard and did not know of any person who had read the entire standard." *Id.* The Board in *Halliburton*, though, found that the website at issue constituted a printed publication because the website's collection of pages described a single product from a single source, and a person of ordinary skill in the art would have readily combined the multiple pages and considered them as a whole. *Halliburton*, Paper 13 at 15–21.

For reasons similar to those in *Halliburton*, we preliminarily disagree with Patent Owner's argument that A3UM is a compilation of "seven hundred individual HTML files," which cannot collectively be considered a printed publication. Prelim. Resp. 10. Unlike the GSM standard in *Kyocera*, Petitioner sufficiently shows, at this stage and on this record, that the HTML files that comprise A3UM are linked by their content, source, and organization. Pet. Reply 1–2. In particular, the manual's files have a coherent organization and collectively function as a single document: the Aperture 3 User Manual. *See* Ex. 1005. Indeed, the text "Aperture 3 User Manual" appears in the header of each page, and "/aperture/usermanual/" appears in the URLs in the footers. *See id.* Also, the manual's index page contains embedded hyperlinks to help the user navigate the sections. *See, e.g.*, Ex. 1003 ¶¶ 101.f, 102; Ex. 1020 ¶ 19.f; Ex. 1021, 8. Thus, at this stage and on this record, we determine that the A3UM file set could qualify as a single printed publication, even though it is a collection of files, provided that it is publicly accessible.

"A given reference is 'publicly accessible' upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the

subject matter or art exercising reasonable diligence, can locate it." *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). At this stage and on the current record, we also disagree with Patent Owner's argument that the manual was not publicly accessible. *See* Prelim. Resp. 20–25; Sur-reply 4–5. Rather, we preliminarily determine for institution that the declaration of Matthew Birdsell (Ex. 1020) sufficiently supports Petitioner's assertions on this issue.

In particular, according to the declaration, Mr. Birdsell is currently a Content Manager at Apple. *Id.* ¶ 2. Mr. Birdsell testifies that he worked for Apple since 2002 and has been a full-time Apple employee since June 2010. *Id.* ¶ 1. Mr. Birdsell testifies that he "personally worked on Apple documentation and publications regarding each version of Aperture throughout its lifespan, including Aperture 3." *Id.* ¶ 2. Mr. Birdsell testifies that his "professional responsibilities between January and June of 2010 included involvement with the team responsible for producing and distributing Aperture 3 documentation, including the Aperture 3 User Manual" and that he has "personal knowledge of how the Aperture 3 User Manual was prepared and distributed by Apple during this time frame." *Id.* ¶ 3. With respect to the A3UM file set on the website, Mr. Birdsell testifies that: "Any interested member of the public could locate and view the contents of the Aperture 3 User Manual HTML file set by retrieving it from Apple's publicly accessible documentation site: http://documentation.apple.com/en/aperture/usermanual/." *Id.* ¶ 12.c (citing Ex. 1021, 6).

Patent Owner argues that "there is no evidence of meaningful indexing such that a skilled artisan could reasonably locate A3UM (Ex. 1005) from the Apple website." Prelim. Resp. 24. Patent Owner argues that

"[w]ithout means to search by subject matter, one would have to take several actions to locate the HTML file set on the Apple website," and that "they would still have to '[c]lick links to individual sections of the Aperture 3 User Manual.'" *Id.* at 24–25. According to Patent Owner, "there would be over 700 individual webpages to navigate through." *Id.* at 25.

Having considered the evidence of record, we preliminarily determine that the Birdsell Declaration sufficiently shows how the manual could be located through customary navigation of the website, including searching for it: Mr. Birdsell testifies that the Aperture 3 User Manual "could be located using Aperture links on the apple.com website or by searching for 'Aperture' or 'Aperture 3' in the search box at the top right corner of the apple.com landing page." Ex. 1020 ¶ 18. Mr. Birdsell also testifies that "[t]he Aperture 3 support page on the apple.com website contained an embedded URL pointing to the Aperture 3 User Manual HTML file set (i.e., http://documentation.apple.com/en/aperture/usermanual/)," and that the User Manual on the Apple website had "links to individual sections of the Aperture 3 User Manual that were available on the side bar." *Id.* ¶¶ 18, 19.f.

To be sure, "'public accessibility' requires more than technical accessibility." *Acceleration Bay, LLC v. Activision Blizzard, Inc.*, 908 F.3d 765, 773 (Fed. Cir. 2018), *discussed in* Prelim. Resp. 22–23. For example, "a work is not publicly accessible if the only people who know how to find it are the ones who created it." *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1372 (Fed. Cir. 2019), *discussed in* Prelim. Resp. 23. On this issue, Patent Owner argues that there is "no evidence that someone interested in photo management systems would know about Aperture." Prelim. Resp. 24. In Patent Owner's view, the A3UM file set was not

sufficiently indexed on the website, and a person could not find the file set based on its subject matter. *Id.* at 24–25.

We preliminarily determine that Petitioner provides sufficient evidence at this stage showing that others interested in photo management could have reasonably found Apple's website and the A3UM file set. For example, Petitioner shows that there were links to purchase Aperture 3 software through Apple's website. Pet. 16 (citing Ex. 1021, 2). Petitioner provides a press release for Aperture 3. Ex. 1048. Dr. Terveen testifies that "a skilled artisan interested in locating A3UM or learning about Apple's Aperture 3 software would have been able to locate A3UM via www.apple.com by simply visiting the dedicated Aperture 3 support page on Apple.com." Ex. 1003 ¶ 100. According to Dr. Terveen, "A skilled artisan would have been provided with a straightforward path to access the web-hosted version of A3UM from the www.apple.com homepage." *Id.* ¶ 101.

Thus, from the current record, we determine that Petitioner's position is based on more than mere technical accessibility. Rather, Petitioner has provided sufficient evidence, at this stage and for institution, that people interested in photo management systems would have been independently aware of the A3UM file set on Apple's website (*see, e.g.*, Pet. 16; Ex. 1021, 2; Ex. 1048), and an interested researcher, applying reasonable diligence, would have found the A3UM file set using the search function and the links to the support page, as described by Dr. Terveen (*see, e.g.*, Ex. 1003 ¶¶ 100–101). *See Samsung Elecs.*, 929 F.3d. at 1369 (citing *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1381 (Fed. Cir. 2012)).

Patent Owner also argues that "Petitioner fails to establish that Ex. 1005 is a true and correct copy of the HTML file set allegedly accessible through Petitioner's website" and that "there is at least one inconsistency

between Ex. 1005 and Petitioner's limited Internet Archive printouts." Prelim. Resp. 20–21. According to Patent Owner, "Petitioner has not (and cannot) show that the hundreds of web pages allegedly comprising A3UM correspond to Ex. 1005." Sur-reply 5.

We note that the A3UM file set and the printout from the Internet Archive's Wayback Machine are not identical. *Compare* Ex. 1021, *with* Ex. 1005. And Petitioner has provided only some of the pages from the Internet Archive's Wayback Machine. *See* Ex. 1021. Mr. Birdsell, however, testifies that Exhibit 1005 "is an accurate copy of the Aperture 3 User Manual that was distributed with the initial version of the Aperture 3 product (i.e., version 3.0)," and that the Aperture 3 User Manual also existed as an interlinked set of HTML files made publicly accessible on Apple servers "where it could be retrieved and viewed by any member of the public." Ex. 1020 ¶¶ 4, 9–10. At this stage, Mr. Birdsell's testimony sufficiently supports Petitioner's position.

Our decision on this issue is preliminary. We invite the parties to further address how the identified differences between the printout from Internet Archive's Wayback Machine (Exhibit 1021) and Exhibit 1005 might affect our final decision on the patentability of the challenged claims.

We conclude that, from the current record and for the purpose of institution, Petitioner has submitted evidence sufficient to establish that the A3UM file set on Apple's website was publicly accessible before the critical date of the challenged patent and that the A3UM reference qualifies as a printed publication.

D. Obviousness over A3UM

Petitioner asserts that the subject matter recited in claims 1–59 would have been obvious over A3UM. Pet. 24–91.

Apart from challenging A3UM's status as a printed publication, Patent Owner does not present arguments specifically directed to Petitioner's evidence and assertions about the obviousness of the challenged claims over A3UM. *See* Prelim. Resp.

From the current record, Petitioner has established that claim 1 is more likely than not unpatentable as obvious. Our reasoning follows.

1. A3UM

A3UM is a user manual for Aperture. Ex. 1005. Aperture is "a digital image management system that can track thousands of digital images and provides the avid photographer with high-quality image management and adjustment tools." *Id.* at 1. For example, *Faces* is a face-detection and face-recognition tool in Aperture. *Id.* at 28. *Faces* can identify and track people through all the images in a library. *Id. Places* is a tool that organizes images by location. *Id.* at 81. In *Places*, a user can search for image locations on a map and zoom to view those locations in detail. *Id.* The *Slideshow Editor* allows the user to create slideshows. *Id.* at 84. These slideshows may include images, video, and audio clips. *Id.*

2. Claim 1

a. Preamble and People View

Claim 1 recites, in part,

1. A method comprising:

causing an interface to display a people view, the people view including:

a first thumbnail image associated with a first person,

a first name associated with the first person,

a second thumbnail image associated with a second person, and

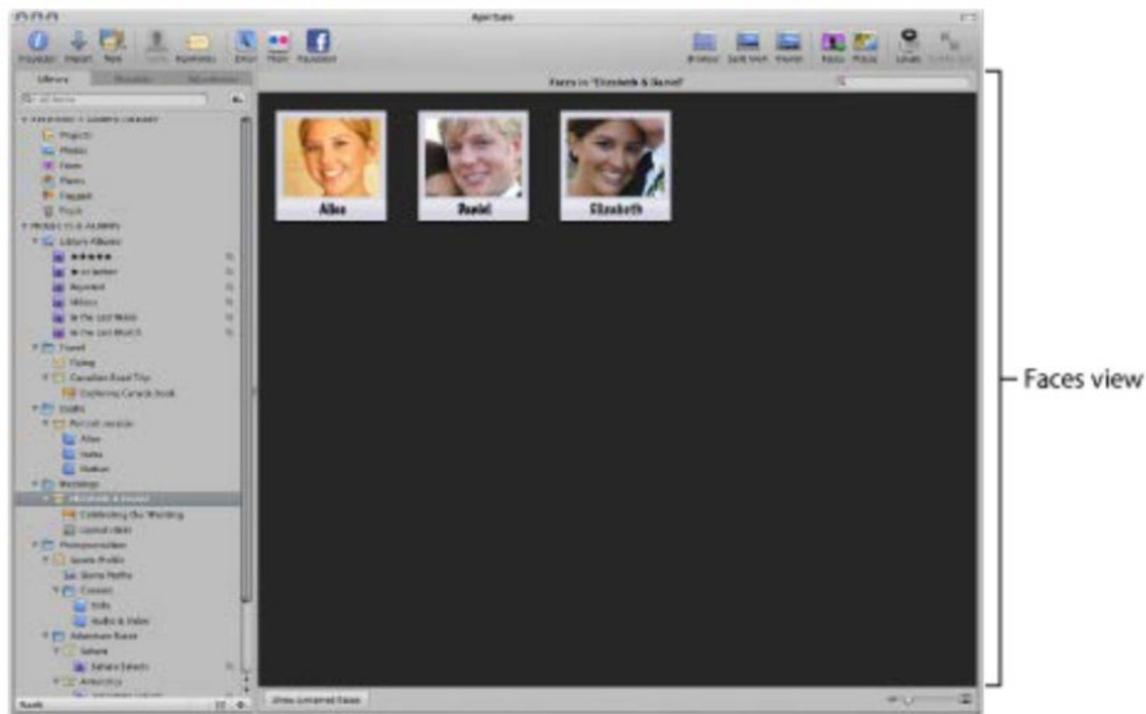
a second name associated with the second person . . . .

Ex. 1001, 35:17–24.

Petitioner asserts that A3UM teaches a “people view” because the application window in A3UM displays a *Faces* view. Pet. 25 (citing Ex. 1005, 28–29, 78–80, 417–428; Ex. 1003 ¶ 11).

Patent Owner does not present evidence or arguments specifically directed to Petitioner’s assertions about the preamble and people-view limitations. *See* Prelim. Resp.

At this stage and on this record, we preliminarily determine that Petitioner has shown that A3UM teaches or suggests the preamble and the people view. *See* Pet. 24–27. In particular, the Petition reproduces an image of the A3UM interface, which is shown below. *Id.* at 25.



The figure above shows an interface displaying three images in a window. *Id.* Each image shows a person’s face. *Id.* A name appears underneath each image. *Id.* According to Petitioner, these images are thumbnails, and the names “Alice” and “Daniel” are associated with a first and a second person.

Id. at 26. In this way, Petitioner sufficiently shows that A3UM teaches or suggests the recited thumbnail images and names, at this stage and on the current record.

Petitioner also explains that, to the extent that the recited "thumbnail image" must be a "reduced-size version of the original photo (*i.e.*, uncropped)," it would have been obvious to modify A3UM to have this feature. *Id.* at 25–26. We preliminarily determine that Petitioner's obviousness rationale is adequately supported by the current record, including the relevant parts of the Terveen Declaration. *See id.* According to the Terveen Declaration, using a scaled and cropped version of a photo was known, and modifying A3UM to use a version like this would be an arrangement of old elements performing their known function with expected results: A3UM displaying uncropped thumbnails of people in the *Places* view. Ex. 1003 ¶¶ 113–115, *cited in* Pet. 25–26.

Thus, at this stage and for the purposes of institution, we preliminarily determine that Petitioner has sufficiently shown that A3UM teaches or suggests the preamble and the people-view limitations of claim 1, and that the recited subject matter would have been obvious over A3UM alone. *See* Pet. 24–27.

b. First Person View

Claim 1 recites, in part,

> responsive to an input that is indicative of a selection associated with the first person, causing a first person view to be displayed on the interface, the first person view including:
>
> a first digital file associated with the first person,
>
> the first name associated with the first person, and
>
> a first map image . . . .

Ex. 1001, 35:25–31.

Petitioner asserts that A3UM's interface will display confirmed and unconfirmed images containing a person's face responsive to a user selecting a snapshot. Pet. 28–29 (citing Ex. 1005, 79, 418–419; Ex. 1003 ¶¶ 120–121). Here, Petitioner asserts that A3UM's interface includes the *Viewer*, the toolbar, and inspector panes, which are collectively the recited "first person view" for a given person. *Id.* at 28.

Petitioner asserts that "A3UM does not expressly teach to a skilled artisan [the recited step of] 'causing a first person view to be displayed on the interface, the first person view including: a first digital file associated with the first person.'" *Id.* at 31 (emphasis omitted). Rather, in Petitioner's view, A3UM displays "thumbnails or scaled versions of underlying digital files containing the selected person's face," not "the digital files themselves." *Id.*

According to the Petition, it would have been obvious "to modify A3UM to display at least one of the images containing the selected person's face at its full-size when displaying the Faces browser." *Id.* (citing Ex. 1003 ¶¶ 126–134). Petitioner asserts that, in A3UM, "images *may* be displayed at a reduced size to fit in the Viewer." *Id.* at 32 (citing Ex. 1005, 252; Ex. 1005, 268) (emphasis in original). That is, Petitioner asserts that the images are not required to be displayed in this way. *Id.* (Ex. 1003 ¶ 128; Ex. 1005, 51).

Petitioner concludes that it would have been obvious "to modify A3UM's Faces browser to display confirmed images of a person using A3UM's Viewer and Browser interfaces." *Id.* (citing Ex. 1003 ¶ 129). Petitioner provides multiple reasons why one of ordinary skill in the art would have made this modification. *See, e.g.*, *id.* at 33–35.

Alternatively, Petitioner asserts that, if the causing limitation is interpreted to cover displaying a reduced-size version of a digital file, A3UM meets this limitation because the Faces browser displays all "confirmed and unconfirmed images in reduced-size form." *Id.* at 35–36 (citing Ex. 1005, 79; Ex. 1003 ¶ 135).

As for the recited first map images, Petitioner asserts, "A3UM's interface includes two selectable links with miniature map icons . . . , the Places link in the Library inspector and the Places button in the toolbar, that can be selected to display the Places view." *Id.* at 30 (citing Ex. 1005, 81, 435).

Patent Owner does not present evidence or arguments specifically directed to Petitioner's assertions about the person-view limitations. *See* Prelim. Resp.

At this stage, Petitioner's assertions are sufficiently supported by the current record. To determine whether to institute, we need not decide whether "causing a first person view to be displayed on the interface, the first person view including: a first digital file associated with the first person" is correctly interpreted as "displaying a reduced-size version of a digital file" because Petitioner's analysis is sufficient, at this stage, under either interpretation. *See* Pet. 35–36.

For example, we preliminarily agree that "A3UM's Viewer and Browser interfaces also both use a gallery design, where a row of items is displayed above a larger viewer interface displaying one item in greater detail." *Id.* at 33 (citing Ex. 1003 ¶ 129). Also, like the Browser's Grid view, the *Faces* browser displays a grid of thumbnail images. *See id.* at 34 (citing Ex. 1005, 80, 216). Considering these teachings, we preliminarily agree that "A3UM's disclosure of both Grid and Filmstrip (+Viewer) options for the

Browser demonstrates that both designs were known alternatives with their own benefits, and implementing an interface using one or the other would have involved only routine skill." *Id.* at 34–35 (citing Ex. 1003 ¶ 131).

At this stage and on this record, Petitioner also sufficiently shows that one of ordinary skill in the art "would have been motivated to modify the Faces browser to adopt a Viewer/Browser arrangement that displays selected images 'at full size.'" *Id.* at 35. For example, Petitioner asserts that the proposed modification would benefit users of the Viewer, allowing them to "(1) 'examine an image at its full size'; (2) 'apply adjustments, keywords, and metadata to an image in the Viewer'; (3) customize how images are displayed, such as 'at full resolution' and with 'metadata,' and (4) use the Loupe tool, i.e., a magnifying glass." *Id.* (citing Ex. 1005, 51, 260, 266; Ex. 1003 ¶ 132). According to the Petition, "Doing so could improve the usability of A3UM's face confirmation process for detected yet unconfirmed faces by allowing the user to review unconfirmed images 'at full size' before confirming them." *Id.* (citing Ex. 1003 ¶ 133; Ex. 1005, 419–420, 424–425).

Thus, at this stage and for institution, we preliminarily determine that Petitioner has sufficiently shown that the subject matter recited in the person-view limitations would have been obvious.

c. *First Location View*

Claim 1 recites,

> responsive to an input that is indicative of a selection of the first map image in the first person view, causing a first location view to be displayed on the interface, the first location view including:
>
> an interactive geographic map,
>
> a first indication positioned at a first location on the interactive geographic map, and

> a second indication positioned at a second location on the interactive geographic map . . . .

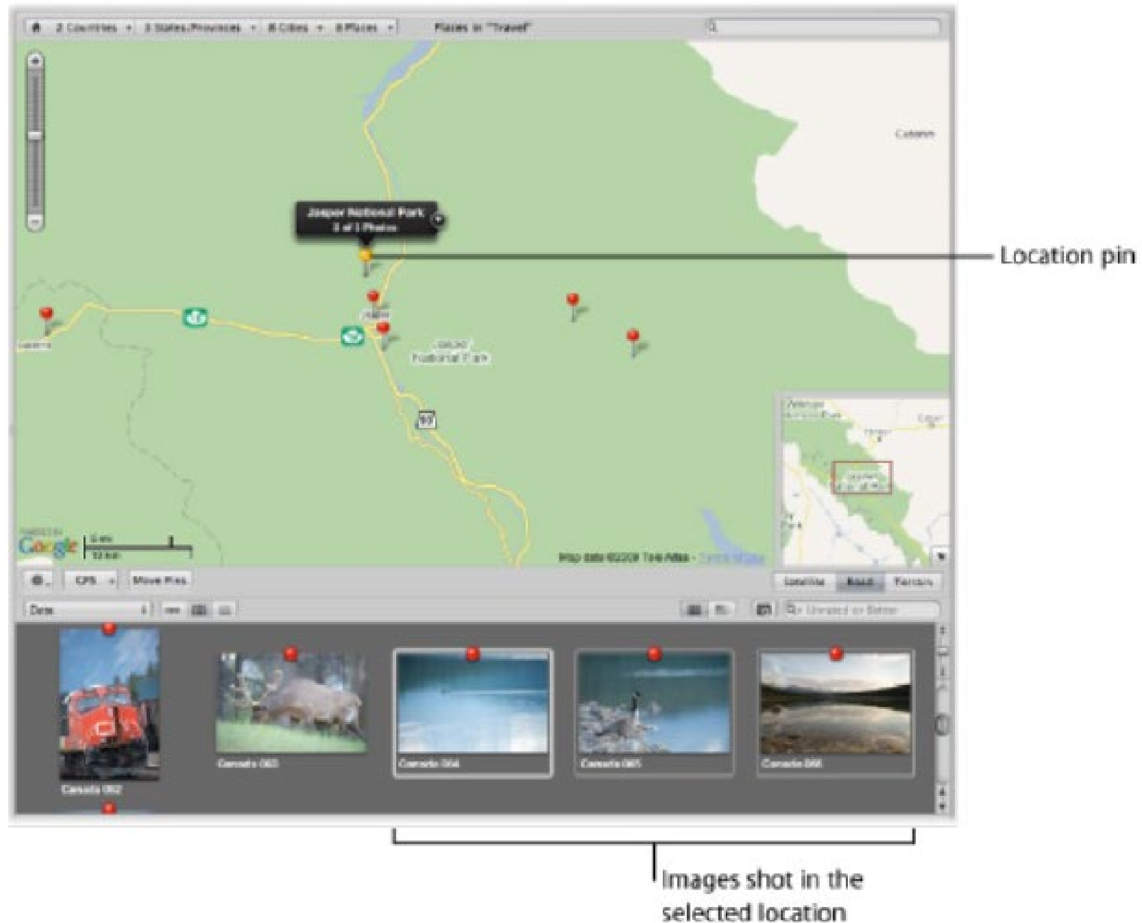
Ex. 1001, 35:32–40.

Petitioner asserts that A3UM's *Places* view is displayed within the Aperture user interface as a whole, which is collectively a "first location view." Pet. 38. According to the Petition, "A3UM describes a Places view comprising an embedded Google Map ('interactive geographic map') that is displayed when a user clicks or taps ('responsive to an input that is indicative of a selection of the first map image in the first person view') on either (1) the 'Places' item in the Library Inspector ('first map image') or (2) the Places button in the toolbar (another 'first map image')." *Id.* at 36 (citing Ex. 1003 ¶¶ 138–140; Ex. 1005, 81, 435).

As for the first and second indications, Petitioner asserts that the *Places* view displays pins at locations on an interactive map where the photos were taken. *Id.* at 37–38 (citing Ex. 1005, 30, 65, 81–83, 429–466, 1115; Ex. 1003 ¶ 138).

Patent Owner does not present evidence or arguments specifically directed to Petitioner's assertions about the first location-view limitations. *See* Prelim. Resp.

At this stage and on the current record, Petitioner's assertions are sufficiently supported. For example, we preliminarily agree with Petitioner's characterization of the A3UM's *Places* view (Pet. 36–38), which is displayed below.



The figure above is a screenshot of the interface described in A3UM. Ex. 1005, 437. The interface contains a map. *Id.* In the figure, the interface is annotated with a line identifying a "location pin" within the map. *Id.* According to A3UM,

> Depending on the zoom setting in Places view, Aperture might use a single pin to represent a group of images shot in close proximity. However, you can view the precise location where each image in the group was shot.

Id. The bottom of the interface displays five images. *Id.* The annotation below the images says, "Images shot in the selected location." *Id.*

At this stage and for the purposes of institution, we preliminarily determine that Petitioner has sufficiently shown that A3UM teaches or suggests the first location-view limitations of claim 1.

d. Slideshow

Claim 1 recites,

> responsive to an input that is indicative of a selection of the first digital file in the first person view, causing a slideshow to be displayed on the interface, the slideshow including a plurality of images associated with the first person.

Ex. 1001, 35:41–45.

In the analysis of this limitation, Petitioner refers to the combination discussed in connection with the person-view limitation. Pet. 38–39 (referring to § VII.B.1.b. of the Petition); *see supra* § III.D.2.b. Petitioner asserts that, under that combination, "A3UM's Faces browser would use A3UM's Viewer functionality." *Id.* at 38 (emphasis omitted). In Petitioner's view, this means that the combination includes a "Viewer above a Browser of images that can be selected to display the image in full resolution," which "would allow a user to view the set of images containing the selected person's face, such as by selecting one of the images in the Browser to display it in the Viewer." *Id.* at 38–39 (citing Ex. 1005, 251; Ex. 1003 ¶ 143). Petitioner explains, under this proposed combination, how the digital images are displayed, and how the user can view the images using the *Filmstrip* view and *Shuttling* mode. *Id.* at 39–40 (citing Ex. 1005, 47, 51, 214, 251, 299–300; Ex. 1003 ¶¶ 144, 145).

Petitioner asserts that A3UM also discloses that users can play a slideshow. *Id.* at 40 (citing Ex. 1003 ¶ 146; Ex. 1005, 36, 828–831).

Patent Owner does not present evidence or arguments specifically directed to Petitioner's assertions about the slideshow limitations. *See* Prelim. Resp.

At this stage and on the current record, Petitioner's assertions and obviousness rationale are sufficiently supported. In particular, we analyzed Petitioner's combination of the browser and viewer functions in Section III.D.2.b. *supra*. In addition to the features of that combination, we preliminarily determine that A3UM's description of creating a slideshow sufficiently supports Petitioner's assertion that A3UM teaches or suggests "an input that is indicative of a selection of the first digital file in the first person view," as recited. Pet. 40. For example, A3UM teaches that a user "can also create a slideshow by selecting the images that you want to show in the Browser and then choosing File > Play Slideshow." Ex. 1005, 36, *cited in* Pet. 40.

We also preliminarily determine that Petitioner has shown that A3UM teaches "causing a slideshow to be displayed on the interface, the slideshow including a plurality of images associated with the first person," as recited in claim 1, because A3UM describes including the selected images in a slideshow when the user selects a preset and clicks start. Pet. 40 (citing Ex. 1003 ¶ 146; Ex. 1005, 830–831). For example, A3UM instructs the user as follows:

> To create and play a slideshow . . . 1. Select a set of images by doing one of the following: . . . Select an item in the Library inspector. . . . Select individual images or image stacks in the Browser. . . .

Ex. 1005, 830. A3UM then instructs the user to "[c]hoose a preset from the Slideshow Preset pop-up menu." *Id.* A3UM lists various effects including "Dissolve," which displays each image for three seconds, with a two-second

cross fade over a black background. *Id.* The user is instructed to "Click Start" to conclude the process of creating and playing a slideshow. *Id.* at 831.

Thus, at this stage and for institution, we preliminarily determine that Petitioner has sufficiently shown that the subject matter recited in the slideshow limitations would have been obvious.

e. Conclusion

Thus, we conclude that Petitioner has shown that it is more likely than not that the subject matter recited in claim 1 is unpatentable.

E. Remaining Claims and Grounds

Because Petitioner has shown that it is more likely than not that at least one claim is unpatentable, we will institute on all grounds and all claims challenged in the Petition. At this preliminary stage of the proceeding, we need not discuss every ground raised by Petitioner in detail. Our guidance concerning the Petition's remaining grounds follows.

1. Remaining Grounds based on A3UM

Petitioner argues that A3UM teaches the subject matter recited in claims 2–59. *See* Pet. 47–91. Petitioner provides the testimony of Dr. Terveen in support of its position. *See* Ex. 1003 ¶¶ 91–155.

In its Preliminary Response, Patent Owner does not separately address Petitioner's evidence or arguments directed to claims 2–59, apart from those issues discussed above. *See* Prelim. Resp.

We have considered Petitioner's evidence and arguments for claims 2–59, as well as the testimonial evidence of Dr. Terveen. Based on the current record, we are persuaded that Petitioner has demonstrated sufficiently, for institution, that A3UM teaches or suggests the subject matter recited in claims 2–59.

2. Written Description

Petitioner asserts that claims 6, 7, 38, and 39 are unpatentable as lacking adequate written-description support. Pet. 91–93.

Claim 6 recites, in part, "The method of claim 4, wherein, in the people view, the first name is displayed adjacent to the first digital file associated with the first thumbnail image and the second name is displayed adjacent to the second thumbnail image." Ex. 1001, 35:59–62. Claim 38 recites similar limitations. *See id.* at 38:47–50. Claim 7 depends from claim 6, and claim 39 depends from claim 38. *Id.* at 35:63–65 (claim 7), 38:51–53 (claim 39).

Petitioner asserts that claims 6 and 38 require that

> the "people view" includes at least the following: (i) "a first thumbnail image associated with a first person," (ii) "a first name associated with the first person," (iii) "a second thumbnail image associated with a second person," (iv) "a second name associated with the second person," and (v) a "first digital file associated with the first person."

Pet. 91. Petitioner argues that the '020 patent lacks written-description support for a people view with these features. *Id.* at 92 (citing Ex. 1003 ¶ 315).

Under Petitioner's interpretation, the digital files are "plainly distinct" from the thumbnails because claims 6 and 38 recite that "'the first digital file" is 'associated with the first thumbnail image.'" *Id.* (emphasis omitted). Petitioner argues that Figures 6 and 32 of the '020 patent show people views. *Id.* But neither figure shows a view that displays a thumbnail and a first digital file associated with both the first person and the first thumbnail image. *Id.* (citing Ex. 1003 ¶ 316). Petitioner argues that, "while Figure 6

discloses duplicate thumbnails in the people view, it does not show any 'digital files' being displayed in the people view with those thumbnails." *Id.* According to Petitioner, "The absence of any illustration or description of a 'people view' as including a 'digital file' associated with both a 'first person' and the 'first thumbnail image' demonstrates a lack of possession of the process as it is defined by claims 6-7 and 38-39." *Id.* at 92–93 (citing Ex. 1003 ¶ 317).

Patent Owner disagrees and argues that the Petition lacks any discussion about the perspective of a person having ordinary skill in the art, which is critical to the written-description inquiry. Prelim. Resp. 26 (citing Pet. 91–92; *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir 2010)). At this stage and on this record, we disagree that the Petition is deficient in this way.

The test for written-description sufficiency "is whether the specification 'reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of [the relevant time].'" *In re Glob. IP Holdings LLC*, 927 F.3d 1373, 1377 (Fed. Cir. 2019) (quoting *Ariad*, 598 F.3d at 1351). Here, the Petition relies on Dr. Terveen's analysis of how a skilled artisan would have viewed Figure 6. Pet. 92 (citing Ex. 1003 ¶ 316). Dr. Terveen explains that Figure 6 contains multiple copies of the same person-name combination. Ex. 1003 ¶ 316. In Dr. Terveen's view, these repeated thumbnails would not be simultaneously the claimed first thumbnail and first digital file, "which a skilled artisan would understand to mean they are not the same." *Id.* Dr. Terveen asserts that there is no association between the duplicated thumbnails. *Id.* In at least this way, we preliminarily determine that the Petition's written-description challenge

includes an analysis of what the specification would have reasonably conveyed to those skilled in the art.

Patent Owner further argues that Petitioner merely notes the absence of "specific examples." Prelim. Resp. 26 (citing *Falkner v. Inglis*, 448 F.3d 1357, 1365 (Fed. Cir. 2006)). Patent Owner argues that "Petitioner's discussion is confined to two figures and descriptions of items visible in those two figures," which "effectively applies an explicit disclosure standard" as the test for written-description sufficiency. *Id.* at 27 (citing Pet. 91–92). Patent Owner argues that "the Petition declines to address any other figures or descriptions within the specification." *Id.* (citing Pet. 91–92; *Union Oil Co. of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 997–98 (Fed. Cir. 2000)). In Patent Owner's view, the Terveen Declaration is limited for the same reasons. *Id.* (Ex. 1003 ¶¶ 312–317). At this stage and on this record, we disagree.

The Petition states that "neither Figure 6 nor Figure 32 *nor any other portion of the '020 patent disclosure* describes a 'people view'" with the recited features. Pet. 92 (citing Ex. 1003 ¶ 316) (emphasis added). In at least this way, the Petition addresses the remainder of the disclosure. *See id.*

Also, we preliminarily determine that it is reasonable for Petitioner to focus on Figures 6 and 32 of the '020 patent because those figures describe the people view. *Id.* Indeed, Dr. Terveen explains that Figures 6 and 32 are the most relevant to that view. Ex. 1003 ¶¶ 316–317. The preliminary record supports Dr. Terveen's testimony (*id.*): According to the '020 Patent, "A people view, as shown in FIG. 6, shows thumbnail photos of all the people in the system that can be clicked in for a people profile view." Ex. 1001, 6:24–26. Likewise, the '020 patent explains that "both of the People Application Views are illustrated" in Figure 32. *Id.* at 22:51–54.

Thus, at this stage and on this record, we disagree with Patent Owner's arguments concerning the Petition's challenges based on the written-description requirement of § 112. *See* Prelim. Resp. 25–27.

IV. CONCLUSION

We determine that Petitioner has shown that it is more likely than not that at least one of claims 1–59 is unpatentable. Thus, we institute a post-grant review of claims 1–59 on all grounds. 35 U.S.C. § 324(a).

V. ORDER

It is

ORDERED that, under 35 U.S.C. § 324(a), a post-grant review of claims 1–59 of the '020 patent is instituted for all grounds in the Petition; and

FURTHER ORDERED that, under 35 U.S.C. § 324(d) and 37 C.F.R. § 42.4, notice is given of the institution of a trial that commences on this decision's entry date.

FOR PETITIONER:

Jeffrey P. Kushan
Samuel A. Dillon
Kyle S. Smith
SIDLEY AUSTIN LLP
jkushan@sidley.com
samuel.dillon@sidley.com
kyle.smith@sidley.com

FOR PATENT OWNER:

Jennifer Hayes
George Dandalides
NIXON PEABODY LLP
jenhayes@nixonpeabody.com
gdandalides@nixonpeabody.com