UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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GOOGLE INC.,
Petitioner

v.

SUMMIT 6 LLC,
Patent Owner

_____

CASE: IPR2015-00807
Patent No. 8,612,515

Title: System, Method and Apparatus for Media Submission

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PATENT OWNER'S NOTICE OF APPEAL

Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Patent Owner Summit 6 hereby gives notice pursuant to 35 U.S.C. §§ 141-142 and 319 and 37 C.F.R. § 90.2(a) that it appeals to the United States Court of Appeals for the Federal Circuit from the Board's Final Written Decision in IPR2015-00807, entered on September 6, 2016 (Paper No. 56), and from all orders, decisions, rulings, and opinions underlying the Final Written Decision. A copy of the Final Written Decision is attached to this Notice.

In accordance with 37 C.F.R. 90.2(a)(3)(ii), Patent Owner further notes that the issues on appeal will likely include, but are not limited to:

1) The Board's determination of unpatentability of claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of U.S. Patent 8,612,515 (the "'515 patent"), under 35 U.S.C. § 103, and any finding or determination (factual or legal) supporting that determination; and

2) Whether the Board erred in any finding or determination supporting or relating to the above-referenced issues and any other issues decided adversely to Patent Owner in any orders, decisions, rulings, or opinoins of the Board.

Copies of this Notice of Appeal are being filed simultaneously with the Patent

Trial and Appeal Board. In addition, three copies of this Notice of Appeal, along

with the required docketing fees, are being filed with the Clerk of the United States

Court of Appeals for the Federal Circuit.

Dated: November 7, 2016.

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Certificate of Filing in Compliance with 37 C.F.R. § 90.2(a)(1)

I hereby certify that, in addition to being filed electronically through the

Board's E2E System, the original version of this PATENT OWNER'S NOTICE

OF APPEAL was filed by hand on November 7, 2016, with the Director of the

United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
United States Patent and Trademark Office
Madison Building East, Room 10B20
600 Dulany Street
Alexandria, VA 22314

Certificate of Filing in Compliance with 37 C.F.R. § 90.2(a)(2)

I hereby certify that on November 7, 2016, the foregoing, PATENT

OWNER'S NOTICE OF APPEAL, was filed with the Clerk's Office of the United

States Court of Appeals for the Federal Circuit, using the Court's CM/ECF system.

Certificate of Service in Compliance with 37 CFR § 42.6(e)(4)

The undersigned certifies that a complete copy of this PATENT OWNER'S

NOTICE OF APPEAL was served by email and overnight mail on November 7,

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,
Petitioner,

v.

SUMMIT 6 LLC,
Patent Owner.

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Case IPR2015-00807
Patent 8,612,515 B2

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Before HOWARD B. BLANKENSHIP, GEORGIANNA W. BRADEN, and
KERRY BEGLEY, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318 and 37 C.F.R. § 42.73

I.   INTRODUCTION

We have jurisdiction to hear this *inter partes* review under 35 U.S.C. § 6(c), and this Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of U.S. Patent No. 8,612,515 B2 (Ex. 1001, "the '515 patent") are unpatentable.

A. *Procedural History*

Google Inc., HTC Corporation, and HTC America, Inc.[1] (collectively "Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent. Summit 6 LLC ("Patent Owner") filed a Preliminary Response (Paper 11, "Prelim. Resp."). Pursuant to 35 U.S.C. § 314(a), we instituted an *inter partes* review of claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 as (1) unpatentable under 35 U.S.C. § 103 in view of Creamer[2] and Aihara[3] and (2) unpatentable under 35 U.S.C. § 103 in view of Mayle[4] and Narayen[5]. *See* Paper 18 ("Dec. to Inst."), 34.

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[1] Subsequent to filing the Petition, HTC Corporation and HTC America, Inc. settled with Patent Owner and sought to terminate their participation in this proceeding. *See* Paper 8. The request was granted, and HTC Corporation and HTC America, Inc. are no longer a party. *See* Paper 10.

[2] U.S. Patent No. 6,930,709 B1 (issued Aug. 16, 2005, filed Dec. 3, 1998) ("Creamer," Ex. 1004).

[3] U.S. Patent No. 6,223,190 B1 (issued April 24, 2001, filed Apr. 13, 1998) ("Aihara," Ex. 1005).

[4] U.S. Patent No. 6,018,774 (issued Jan. 25, 2000, filed July 3, 1997) ("Mayle," Ex. 1006).

[5] U.S. Patent No. 6,035,323 (issued Mar. 7, 2000, filed Oct. 24, 1997) ("Narayen," Ex. 1007).

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 23, "PO Resp."), to which Petitioner filed a Corrected Reply (Paper 40, "Reply"). In addition, Patent Owner filed Observations on the Cross-Examination of Petitioner's declarant (Paper 45), to which Petitioner filed a response (Paper 51). Petitioner filed a Motion to Exclude Evidence (Paper 44), to which Patent Owner filed an Opposition (Paper 50), and Petitioner filed a Reply in support of its motion (Paper 54).

An oral argument was held on May 18, 2016. A transcript of the oral argument is included in the record. Paper 55 ("Tr.").

B. Related Proceedings

Petitioner informs us that the '515 patent and related U.S. Patent No. 7,765,482 B2 ("'482 patent") are the subject of district court case *Summit 6 LLC v. HTC Corp.*, Case No. 7:14-cv-00014-O (N.D. Tex.). Pet. 3. Petitioner also informs us that the related '482 patent is the subject of *ex parte* reexamination no. 90/012,987, and one concurrently-filed petition for *inter partes* review (IPR2015-00806). Pet. 3–4.

C. The '515 Patent

The '515 patent is directed to an improved web-based media submission tool. Ex. 1001, Abstract. One embodiment of the '515 patent is illustrated in Figure 1, reproduced below.
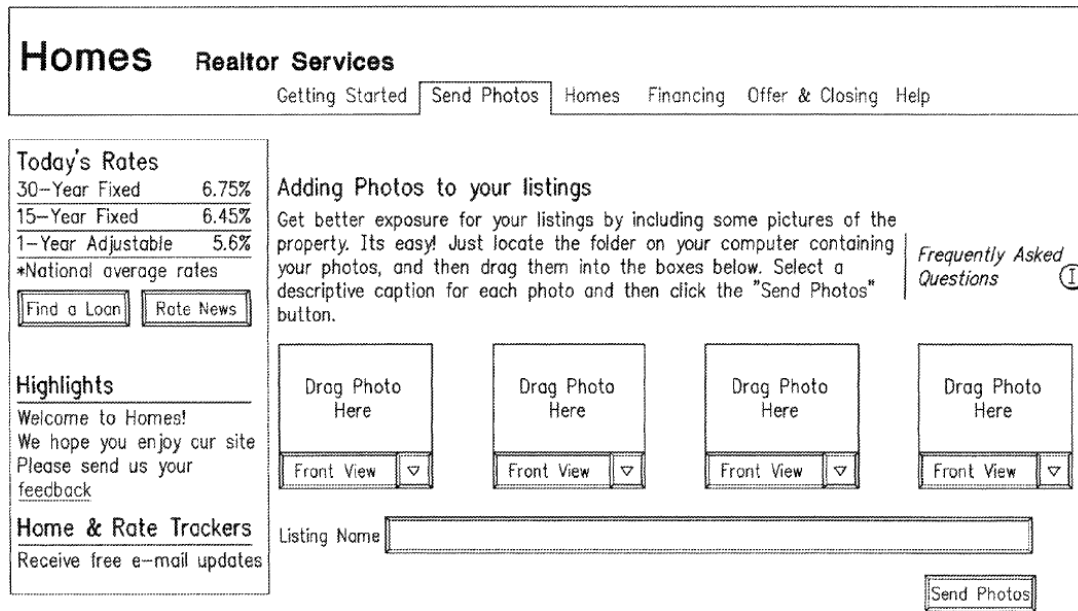
As shown in Figure 1, a user selects a media object (e.g., a digital image) stored at a first location (e.g., a "local device") to upload to a server (e.g., a "server device" or "remote device") (*id*. at 2:50–58) using a "drag and drop" functionality (*id*. at 3:26–30) or a file browse functionality (*id*. at 3:29–33). In certain instances, in order for a media object to be uploaded properly to a server or remote device, the media object must be in a format acceptable to the server or remote device. *Id*. at 5:7–10. Configuration parameters are received by the local device from either a server or remote device, and such parameters are used to determine how the media object(s) should be processed at the local device before being uploaded to the server or remote device. *Id*. at 5:6–12, 6:66–67, 9:9–12. Following processing at the local device, the media object(s) can be transmitted from the local device to a remote server or other device. *Id*. at 6:23–28. According to the '515 patent, the media object(s) can be pre-processed in a number of ways, including resizing the object, compressing the object using a compression algorithm

like the JPEG standard, changing the file format, and cropping, scaling, or changing the aspect ratio of the images. *Id.* at 4:52–5:12.

D. Illustrative Claims

As noted above, an *inter partes* review was instituted as to claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent, of which claims 1, 20, 23, and 39 are independent claims. Claim 1 is illustrative of the challenged claims and is reproduced below.

1. A method for pre-processing in a client device, comprising the following computer implemented steps:

    transmitting information that enables access to an account that is associated with a user, said access to said account conditioned on a receipt of an identifier at a host server;

    receiving an identification of one or more image files, video files or audio files to associate with said account;

    receiving, by said client device, a confirmation of an intent to associate said one or more image files, video files or audio files with said account;

    pre-processing said identified one or more image files, video files or audio files using pre-processing parameters received from a remote server, said received pre-processing parameters enabling said client device to preprocess said identified one or more image files, video files or audio files in a manner specified by a distributing party for transfer of content, which is based on said pre-processed one or more image files, video files or audio files, to one or more devices separate from said client device; and

    transmitting said pre-processed one or more image files, video files or audio files.

Ex. 1001, 6:55–7:9.

II. DISCUSSION

A. *Claim Construction*

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) ("We conclude that the regulation represents a reasonable exercise of the rulemaking authority that Congress delegated to the Patent Office."). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes construction for the claim term "distributing," which is recited at least in independent claims 1, 20, 23, and 39. Pet. 18–19. Patent Owner disputes Petitioner's proposed construction for "distributing." PO Resp. 7. Patent Owner also proposes construction for the term "pre-processing" recited in all the challenged independent claims. *Id.* After analyzing the claims and supporting specification of the '515 patent, we determined that we need not provide express constructions for any claim terms.

B. *Principles of Law*

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406

(2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of non-obviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

"In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner cannot satisfy its burden of proving obviousness by employing "mere conclusory statements." *In re Magnum Oil Tools Int'l, Ltd.*, No. 2015-1300, slip op. at 25 (Fed. Cir. July 25, 2016).

Thus, to prevail in an *inter partes* review, Petitioner must explain how the proposed combinations of prior art would have rendered the challenged claims unpatentable. At this final stage, we determine whether evidence of record shows by a preponderance of the evidence that the challenged claims would have been obvious over the proposed combinations of prior art.

We analyze the instituted grounds of unpatentability in accordance with the above-stated principles.

C. Level of Ordinary Skill in the Art

According to Petitioner's declarant, Paul Clark, D.Sc. ("Dr. Clark"), a person of ordinary skill in the art relevant to the '515 patent would have been "someone with either an undergraduate, graduate, or doctoral degree in computer science (or similar field, e.g., electrical engineering, etc.), or three to five years' industry experience in the general field of software engineering and web implementation." Ex. 1003 ¶ 8.

Patent Owner disputes Dr. Clark's opinion regarding the level of skill in the art at the time of the '515 patent, arguing that "requiring 3 to 5 years of industry experience in 'web implementation' by July 1999 is unreasonable" and "[i]t is unreasonable to suggest that a [person of ordinary skill in the art] would have an advanced degree in computer science." PO Resp. 6–7. Patent Owner's declarant, Martin Kaliski, Ph.D. ("Dr. Kaliski"), testifies that a person of ordinary skill in the art relevant to the '515 patent would have been a person with "at least a Bachelor of Science degree in computer science or electrical engineering or with 2–3 years of experience in software engineering." Ex. 2058 ¶ 15.

Based on our review of the '515 patent, the types of problems and solutions described in the '515 patent and cited prior art, the testimony of Petitioner's declarant, and the testimony of Patent Owner's declarant, we find that a person of skill in the art relevant to the '515 patent would have had (i) at least Bachelor of Science degree in Computer Science or Electrical Engineering or a closely related field, or (ii) at least three years of experience in software engineering. We note that the applied prior art

reflects the appropriate level of skill at the time of the claimed invention.
See Okajima v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

> *D. Asserted Obviousness of Claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 in View of Creamer and Aihara*

Petitioner contends claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent are unpatentable under 35 U.S.C. § 103 in view of Creamer and Aihara. Pet. 14–60. Patent Owner disputes Petitioner's contentions. PO Resp. 19–34. We have reviewed the Petition, Patent Owner's Response, and Petitioner's Reply, as well as the relevant evidence discussed in those papers. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that the challenged claims of the '515 patent would have been obvious in view of Creamer and Aihara. Additionally, as discussed below, we determine that Patent Owner's evidence of secondary considerations of non-obviousness do not overcome Petitioner's showing that the claims would have been obvious to one of ordinary skill in the art at the time of the invention.

> *1. Overview of Creamer*

Creamer discloses a camera that can transmit real-time and stored digital images over a wireless network to a server without requiring the use of a personal computer. Ex. 1004, Title, 2:48–65; 10:24–26. One embodiment in Creamer discloses an integrated camera connected to the internet and is illustrated in Figure 4A, reproduced below.
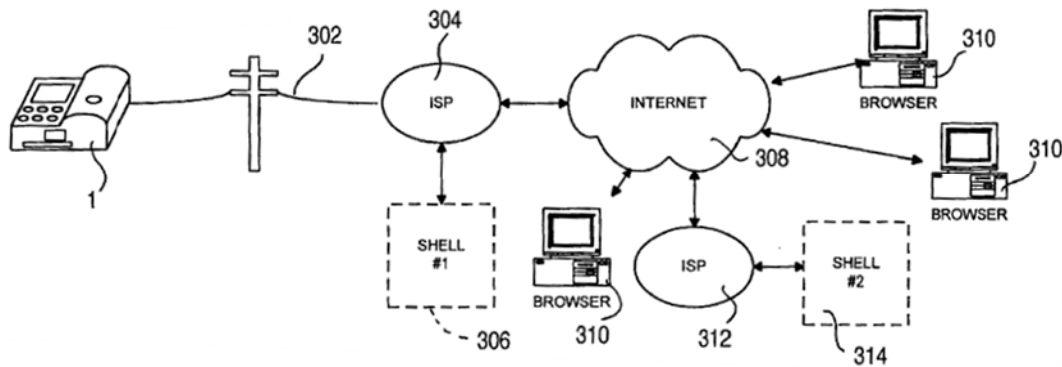
Figure 4A shows camera 1 connected to ISP 304. *Id.* at 11:56. Once a user ID and password are supplied by camera 1, camera 1 is given access to shell account 306, where a user may store compressed image files. *Id.* at 11:56–67. Camera 1 may upload and store image files into local shell account 306 according to controlling file attributes and destination information to the local user directory via a provided file transfer application. *Id.* at 12:9–25. Creamer discloses that once camera 1 is connected locally to the internet at a first location, it may store images at a second location anywhere in the world. *Id.* at 12:30–32. According to Creamer, camera 1 can store numerous variables and parameters that control the operation of the camera, and which may be adjusted by the user via a menu structure or via direct commands. *Id.* at 12:48–60. A "user may place a setup or configuration file in [a] destination directory . . . and the camera may download a new or modified full or partial set of operational parameters." *Id.* at 24:10–14.

Another embodiment in Creamer discloses a capture routine for capturing, compressing, and storing one or more images. *Id.* at 18:18–20. The capture routine disclosed by Creamer is illustrated in Figure 8, reproduced below.
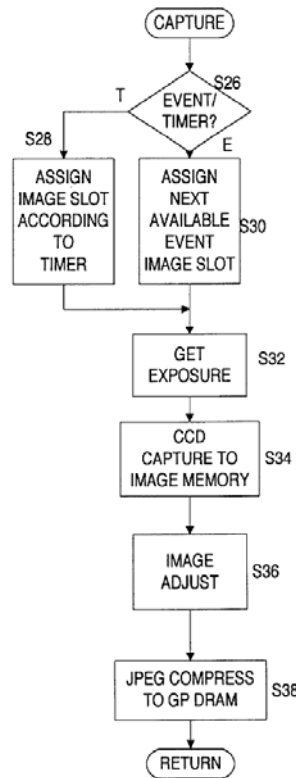
Figure 8 shows a capture routine where: (i) the camera checks if the capture is based on an event (e.g., a trigger) or a timer at step S26, (ii) an empty image slot is identified in step S30, (iii) an image capture is initiated at step S32, (iv) the image is stored into image memory (at this point without compression) at step S34, (v) the image is adjusted at step S36 according to stored parameters and settings, and (vi) the image is compressed at step S38. *Id.* at 18:20–19:13, Fig. 8. Image slots may be designated for batch operations where all images in the identified slots are transmitted as a group (*id.* at 19:23–37) or an image slot may be designated for immediate upload so that the single image is uploaded to a designated shell account (*id.* at 19:38–46, Fig. 9).

2. *Overview of Aihara*

Aihara discloses a method and system for capturing images using a digital camera with an internet connection and generating a formatted

electronic document that includes the images. Ex. 1005, 2:59–61. The camera preferably includes a LCD screen that provides for various modes, including a "play mode." *Id.* at 6:39–59, Fig. 5A. In play mode, the user can review previously captured images on the LCD screen. *Id.* at 1:34–36, 6:65–7:10. Aihara further discloses using a script to provide configuration and setup information to the camera. *Id.* at 3:4–15. The script can also provide instructions to a user to capture specific images (*id.* at 8:10–18) or can prompt a user to select pictures from a set stored in the memory of the camera or elsewhere (*id.* at 8:25–28). The camera can be configured to process images and convert them into a single HTML file that may be uploaded to the internet, "wherein the HTML file is formatted in accordance with the script's predefined model." *Id.* at 3:16–25.

3. Analysis

a. Independent Claims 1 and 23

Claims 1 and 23 generally require (i) the receipt of an identifier at a host server, (ii) identifying one or more media files that will be associated with a user account, (iii) a client device that receives a confirmation of an intent to associate the identified media file with the user account, (iv) pre-processing the identified media file in accordance with pre-processing parameters that are received from a remote server, and (v) transmitting the pre-processed media file from the client device. Ex. 1001, 6:55–7:9, 8:66–22. Claim 1 specifically requires that the pre-processing parameters are received from the remote server, while claim 23 requires that the pre-processing parameters are loaded onto the client device by a device separate from the client device. *Id.* at 6:66–67, 9:10–12.

> *(1)* "*receiving an identification of one or more image files, video files or audio files to associate with said account*"

Petitioner contends Creamer and Aihara teach "receiving an identification of one or more image files, video files or audio files to associate with said account," as recited by challenged claims 1 and 23. Pet. 21–22. According to Petitioner, Creamer discloses receiving an identification of one or more images to associate with the account on the host server through an "image pickup . . . to store an image," whereupon the image is converted into digital format and stored in "the image memory (at this point, without compression)." *Id.* at 22 (citing Ex. 1004, 18:46–56). Petitioner explains that the shell account is where "JPEG image files may be stored." *Id.* (citing Ex. 1004, 12:27–28). Petitioner then cites to Aihara for the disclosure of a user identifying media files for transmission where "the user could be prompted to select pictures from a set stored in the memory of the camera." *Id.* (citing Ex. 1005, 8:26–27).

Petitioner relies on the testimony of Dr. Clark to support its position. *Id.* at 21–22 (citing Exhibit 1003 ¶¶ 34–35, 38). Dr. Clark testifies that the combination of Creamer and Aihara renders obvious receiving an identification of a group of digital content and confirming an intent to associate the digital content with an account because Creamer discloses a camera that captures digital images and categorizes them for processing and subsequently transmits them according to settings stored within the camera. Exhibit 1003 ¶ 38. Dr. Clark further testified that "[b]ased on my knowledge and years of experience, I know that one of skill in the art would understand that the group of digital content is limited by the pre-processing

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parameters because the parameters define the level of compression performed on the digital content." *Id.*

Patent Owner contests Petitioner's position, contending Creamer and Aihara fail to teach the limitation "receiving an identification of one or more image files, video files or audio files to associate with said account." PO Resp. 25–27. According to Patent Owner, in Creamer, each picture taken by the camera is collected and stored in an image slot in general purpose memory, but no identification of any image occurs before image transmission because every image is transmitted either immediately or at a future time. *Id.* at 25–26 (citing Ex. 2058 ¶ 146). Dr. Kaliski testifies that before image data is stored as an addressable file in general purpose memory, the data is merely raw data indicative of photons captured by the CCD sensor, and because no digital image files exists until after the image pickup unit captures light photons and the raw data is processed and stored as an image file in S38 of the capture routine, functions performed by the image pickup unit and the resultant storage of the digital image as a file cannot meet the disputed claim limitation. Ex. 2058 ¶ 146 (citing Ex. 1004, 18:49–54, Fig. 8). Dr. Kaliski further testifies that Petitioner's argument regarding JPEG image files stored in a "shell account" does not work because the shell account does not identify any images to associate with an account. *Id.*

Patent Owner then argues that, although Aihara discloses that a user can identify media objects where "the user could be prompted to select pictures from a set stored in the memory of the camera," a person of skill in the art would not have been motivated to combine the identifications of digital content disclosed in Creamer and Aihara, because Creamer provides

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no mechanism for a user to preview an image file saved in an image slot in general purpose (GP) memory but not yet uploaded. PO Resp. 22–23. Patent Owner concludes that Creamer only provides a preview of an image that will be captured; thus, a person of skill in the art would not have been motived to combine Creamer with the function of previewing a stored image from Aihara. *Id.* at 23.

We do not agree with Patent Owner. To the contrary, we agree with Petitioner's position and we find that Creamer discloses storing a digital image in image memory, and we find that even though the digital image is uncompressed, it nonetheless constitutes an image file stored in image memory. *See* Ex. 1004, 12:27–28, 18:53–56; Ex. 1003 ¶ 38; *see also* Ex. 1017, 16:9–11 (deposition testimony of Dr. Kaliski stating that a captured image in image memory is a digital captured image).

We specifically credit the testimony of Dr. Clark, who testifies:

> Q. And encoded image in image file for general purpose memory is uploaded; is that correct?
> A. That is correct.
> Q. And an encoded image file does not exist in image memory, does it?
> A. I mean, for some definition of encoding, there's a representation of the image that is in image memory. So there is an encoding actually.
> Q. Is an image stored in image memory addressable?
> A. Yes.
> Q. If there are two images stored in image memory at different times, they have the same or different addresses?
> A. Depends on the implementation.

Ex. 2057, 58:12–59:1.

Additionally, we find Aihara's disclosure that "the user could be prompted to select pictures from a set stored in the memory of the camera"

is a teaching of the claim limitation "receiving an identification of one or more image files, video files or audio files to associate with said account." *See* Ex. 1005, 8:4–41.

> (2) *"receiving, by said client device, a confirmation of an intent to associate said one or more image files, video files or audio files with said account"*

Petitioner contends Creamer and Aihara teach "receiving, by said client device, a confirmation of an intent to associate said one or more image files, video files or audio files with said account," as recited by challenged claims 1 and 23. Pet. 22–23. Petitioner explains that Creamer discloses receiving confirmation of an intent to associate images with the account on the host server when (1) the image is converted into digital format and stored in "the image memory (at this point, without compression)" (Ex. 1004, 18:46–56), (2) the "settings stored in the IMAGE FILES: UPLOAD variable group indicate that the image . . . is to be uploaded immediately (e.g., following capture)," (*id.* at 19:27–30), (3) the camera's compression engine compresses the captured images "according to settings stored in the IMAGE FILES: IMAGE ADJUST, … [and] compress the image in the image memory" (*id.* at 19:9–15), and (4) the JPEG (compressed) image is stored in the shell account (*id.* at 12:27–28). *See* Pet. 22–23. Petitioner then cites to Aihara for the disclosure of receiving confirmation of an intent to associate images with an account in that "the user could be prompted to select pictures from a set stored in the memory of the camera." *Id.* at 23 (citing Ex. 1005, 8:26–27). According to Petitioner, the selected images are limited by the parameters in the camera, which confirms an intent to associate the images with an account when it "generates an HTML file including the resulting

images, wherein the HTML file is formatted in accordance with the script's predefined model." *Id.* (citing Ex. 1005, 8:5–7).

Contrary to Petitioner's arguments, Patent Owner contends that Creamer and Aihara fail to teach "receiving, by said client device, a confirmation of an intent to associate said one or more image files, video files or audio files with said account." PO Resp. 27–29. Patent Owner argues that Creamer does not teach this limitation because all image files in Creamer are uploaded automatically to a destination server—no intent or confirmation step is performed or required. *Id.* at 27. Moreover, according to Patent Owner, Petitioner fails to identify any steps in Creamer that relate to a client device receiving an intent to associate an image file with an account. *Id.* at 28. Patent Owner also argues that Aihara does not teach this limitation because selecting images for an HTML page does not evidence a confirmation of an intent to associate image files with an account. *Id.* at 28–29.

We do not agree with Patent Owner. To the contrary, we agree with Petitioner's position and we find that a user being prompted to select pictures from a set stored in the memory of the camera, as disclosed in Aihara, constitutes receiving confirmation of an intent to associate images with an account. *See* Pet. 23; Ex. 1005, 8:26–27. Such "user selection" confirms the association of an image with a disclosed account.

(3) "pre-processing parameters enabling said client device to pre-process . . . one or more . . . files"

Petitioner contends the combination of Creamer and Aihara teaches or at least suggests "pre-processing parameters enabling said client device to pre-process . . . one or more . . . files in a manner specified by a distributing party," as recited in challenged claims 1 and 23. Pet. 24–25. Petitioner

explains that Creamer discloses a camera comprising a "compression engine" to pre-process, or "compress the image in the image memory," according to settings stored in the camera operating parameters that are received from a remote server separate from the camera (client device). *Id.* at 25 (citing Ex. 1004, 19:9–15). Petitioner specifically argues that in Creamer, "[t]he user may place a setup or configuration file in his destination directory in a predetermined format recognizable by the camera" at the remote device, "and the camera may download a new or modified full or partial set of operational parameters (e.g., those shown in FIG. 5) permitting remote control of camera operation." *Id.* (citing Ex. 1004, 24:10–15; Fig. 5). Petitioner further argues that in Creamer, the camera can be configured "to retrieve a setup/configuration file via the file transfer application" upon connecting to the remote server. *Id.* (citing Ex. 1004, 24:1–5).

Petitioner also relies on Aihara for this claim element, because Aihara discloses "[a] script, comprised of computer readable instructions, is provided to the digital camera." Pet. 26 (citing Ex. 1005, 3:4–6). According to Petitioner, the script constitutes pre-processing parameters because "[t]he script also includes a set of predefined instructions and formatting commands which are adapted to create a formatted web page (e.g., HTML file) in accordance with a certain desired appearance." *Id.* (citing Ex. 1005, 3:10–13). Moreover, Petitioner argues that the parameters are received or loaded from a remote server separate from the client device in that "[t]he script for directed image capture sequence may be loaded into the digital camera from the removable memory (FIG. 3), a host computer, or a network, and stored in DRAM." *Id.* (citing Ex. 1005, 10:17–20).

Patent Owner disputes Petitioner's position and contends Creamer and Aihara fail to teach "pre-processing parameters enabling said client device to pre-process one or more . . . files in a manner specified by a distributing party," as recited in challenged claims 1 and 23. PO Resp. 29–30. According to Patent Owner, Creamer's image adjustment and compression parameters control how a raw image is manipulated and saved during an image capture process, rather than modifying an existing image that has already been saved in a storage media. *Id.* at 29 (citing Ex. 1004, Fig. 8). Patent Owner argues that the configuration parameters in Creamer relate to image generation, not image processing, because Creamer compresses raw image data, not identified image files. *Id.* at 30. Thus, according to Patent Owner, Creamer does not teach or disclose pre-processing identified files. *Id.*

Patent Owner supports its position with the testimony of Dr. Kaliski. Dr. Kaliski testifies that Creamer's variables and parameters define how raw image data is manipulated before initially being saved in general purpose memory—the variables of Creamer tell the camera how to package the raw pixel data collected by a camera's lens and sensor into a digital image file saved in general purpose memory, but *not* how to process an existing image file prior to or in preparation for transfer. Ex. 2058 ¶ 154. Dr. Kaliski further testifies that Figure 8 of Creamer defines the image adjustment step (S36) and JPEG compression step (S38) as part of the *image capture* routine and the parameters are applicable only to a particular image slot, which does not identify any unique image. *Id.*

Patent Owner further argues Aihara does not disclose this element because reference to a captured image by a formatted HTML file is not pre-processing identified files. PO Resp. 31.

We do not agree with Patent Owner's position. The '515 patent discloses that pre-processing can include resizing an image (i.e., increase or decrease its size as defined by either physical dimensions, pixel count, or kilobytes), and compression is a type of sizing. Ex. 1001, 4:58–66. Thus, we do not agree with Patent Owner that Creamer's processing is performed only during an image capture process and merely controls how a digital image is saved (*see* PO Resp. 29–31), because Creamer teaches adjusting a saved image file, including compressing the image (*see* Ex. 1004, 18:61–19:13, Fig. 8). Specifically, Creamer teaches that in step S34 the YCrCb (i.e., a luminance and two color difference signals) are converted to a digital image single, which is passed by compression engine 224 and memory controller 226 to the image memory (at this point, without compression). *Id.* at 18:46–56. At that point, according to Creamer, microcontroller 200 controls compression engine 226 to adjust the image per parameters and settings stored in the camera. *Id.* at 18:61–19:13. Creamer goes on to teach that in step S38, compression engine 226 compresses the image in image memory 22 to the appropriate slot in GP memory. *Id.* at 19:9–13. Additionally, Creamer discloses changing the size of a stored image via cropping. *Id.* at 8:43–48 ("a scaling module for interpolating or resampling the stored image to increase or decrease the size of the stored image, including adjustment of an aspect ratio of the image and cropping of any portion of the image") (emphasis added).

Accordingly, we are satisfied the combination of Creamer and Aihara teaches or at least suggests "pre-processing parameters enabling said client device to pre-process . . . one or more . . . files in a manner specified by a distributing party," as recited in challenged claims 1 and 23.

> *(4) "pre-process . . . one or more . . . files in a manner specified by a distributing party for transfer of content"*

Petitioner contends the combination of Creamer and Aihara teaches or at least suggests "pre-processing parameters enabling said client device to pre-process . . . one or more . . . files in a manner specified by a distributing party," as recited in challenged claims 1 and 23. Pet. 24–25. Petitioner argues that a person of skill in the art would have understood that the claim element regarding the "manner specified by a distributing party for transfer of content" would have been a form which depends on the nature of the distribution. *Id.* at 27 (citing Exhibit 1003 ¶ 41). According to Petitioner, the '515 patent relates to the field of "handling, manipulation and processing of digital content and more particularly to the transportation and Internet publishing of digital content." *Id.* (citing Ex. 1001, 1:15–19). Consequently, Petitioner explains that one of skill in the art would have known that the "manner specified" by the parameters would have been a well-known form of digital content suitable for Internet distribution, such as HTML, JPEG, and other similar encoding. *Id.* (citing Ex. 1003 ¶ 41).

Patent Owner disputes Petitioner's position and contends Creamer and Aihara fail to teach "pre-processing parameters enabling said client device to pre-process . . . one or more . . . files in a manner specified by a distributing party," as recited in challenged claims 1 and 23. PO Resp. 31–33. According to Patent Owner, Petitioner fails to identify any distributing party

that meets the recited limitation, because Petitioner focuses "on the nature of the distribution" rather than identifying a distributing party that provides the pre-processing parameters. *Id.* at 31–32. Patent Owner argues that neither [Creamer][6] nor Aihara teaches or suggests the "pre-processing said identified . . . files using pre-processing parameters," because "[t]he JPEG settings in Creamer are not pre-processing parameters," and "[t]he script file . . . in Aihara determines how (*e.g.*, where) an image file appears on a web page, and does not modify or preprocess the image." *Id.* at 32 (citing Pet. 26–27; Ex. 2058 ¶ 158.).

We do not agree with Patent Owner's position. First, as explained above, we find that the JPEG settings in Creamer do qualify as pre-processing parameters. Second, the claims do not require that a specific distributing party be identified. Rather, the claims require that the manner in which a file is pre-processed be specified by a distributing party. Creamer teaches that a camera can be configured "to retrieve a setup/configuration file via the file transfer application" upon connecting to the remote server. Ex. 1004, 24:1–5. Similarly, Aihara teaches that a script, comprised of computer readable instructions, is provided to the digital camera from the removable memory (Figure 3), a host computer, or a network, and stored in DRAM. Pet. 26 (citing Ex. 1005, 3:4–6, 10:17–20, Fig. 3). Therefore, we find that a distributing party can use the teachings in both Creamer and Aihara to specify the manner in which a file is to be pre-processed by

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[6] In its PO Response, Patent Owner states that "neither Mayle nor Aihara teach or suggest" the recited claim limitation. Based on the section heading, and all other arguments, we take Patent Owner's reference to Mayle to be an unintentional error and the statement should have referenced Creamer. *See* PO Resp. 32.

sending a setup/configuration file (i.e., pre-processing instructions) to the camera when it is connected to a remote server, as required by the challenged claims.

(5) *Obvious to Combine the Teachings of Creamer and Aihara*

Petitioner contends it would have been obvious to a person of skill in the art to combine the teachings of Creamer and Aihara, because such a combination merely would have used a known technique to improve similar devices and methods in the same way. Pet. 11–12 (citing Ex. 1003 ¶ 31). According to Petitioner, Creamer and Aihara would have been combined because both references describe: (1) internet-connected digital cameras that process captured images prior to transmitting those images over a network connection, (2) the benefits associated with processing digital images on a network connected camera, including faster transmission speeds for compressed digital images and the ease of uploading images onto a server so they may be viewed by other users, and (3) digital cameras having LCD display screens for previewing and reviewing images captured by the camera. Pet. 11–13 (citing Exhibit 1003 ¶¶ 30–31; Ex. 1004, 29:43–53). Petitioner specifically argues that a person of skill in the art would have had reason to combine the use of thumbnail images in Aihara for previewing and reviewing images captured by the camera in Creamer so as to improve the ability of a relatively small LCD display to show multiple images. *Id.* at 12 (citing Ex. 1005, 1:28–36), 22; Tr. 15:13–19.

Petitioner supports its position with the Declaration of Dr. Clark, who testifies that a person of skill in the art would have understood that Creamer and Aihara relate to processing images stored on those cameras before subsequently transmitting those images to the Internet through a network

connection, and that combining the technique of displaying preview images, as disclosed by Aihara, on a camera display of limited size, as disclosed by Creamer, would improve the ability of the screen to display multiple images. Ex. 1003 ¶¶ 30–31. Dr. Clark also testified that a skilled artisan would have applied the improvement of Aihara to the camera system in Creamer to achieve the predictable result of displaying an array of thumbnail preview images representing the digital images stored on the camera. *Id.*

Patent Owner contends that Petitioner's obviousness challenges fail because a person of ordinary skill in the art would not have combined Creamer and Aihara. PO Resp. 12–19. According to Patent Owner, the LCD screen on the camera in Creamer is used solely to preview an image that will be captured, not "viewing of captured images." *Id.* at 13. Patent Owner argues that displaying multiple images on a display screen having a "relatively small LCD display" would not improve the ability of the screen to display images, nor improve the ability of a user to review such images faster and more accurately. *Id.* at 14.

Patent Owner relies on the Declaration of Dr. Kaliski to support its position. Dr. Kaliski testifies that reviewing arrays of captured images would reduce the resolution of each image by an amount related to the number of images concurrently displayed, further degrading the quality of displayed images leading to a slower and less accurate review. Ex. 2058 ¶ 43. Dr. Kaliski further testifies that the resulting image degradation undermines, rather than supports, a motivation to combine these references. *Id.*

Patent Owner argues that a person of ordinary skill in the art would not have had a reasonable expectation of success in combining Aihara and

Creamer to "improve the ability of the screen to display multiple images," because the accuracy of the image display is subjective based on numerous unknown factors, and therefore, a person of ordinary skill in the art would not have combined Aihara and Creamer. PO Resp. 16 (citing Ex. 2058 ¶ 45). Patent Owner further argues that a person of ordinary skill in the art would not have been motivated to "writ[e] code executed by the microcontroller disclosed in Creamer to enable it to display arrays of preview images on the display screen like the processor and LCD screen disclosed in Aihara," because the LCD display in Creamer can preview only a single image—the current scene. *Id.* at 16 (citing Pet. 13–14; Ex. 1004, 29:50–53; Ex. 2058 ¶ 46). According to Patent Owner, a person of ordinary skill in the art would not have been motivated to modify Creamer to display multiple stored images in memory on the LCD screen and Creamer does not suggest to a person of ordinary skill in the art that "captured images could be accessed and displayed on the LCD screen without adversely affecting the pictur[e] captur[ing] and uploading functionality of Creamer." *Id.* at 17–18 (citing Ex. 2058 ¶¶ 48–49).

Patent Owner specifically argues that "[r]eviewing captured images is not relevant or even permitted by Creamer." *Id.* at 15. Patent Owner further argues that the preview function of Creamer teaches away from reviewing multiple images on its LCD screen because the display is constantly updated with a representation of the current screen with no ability to capture and display stored images. *Id.* at 16 (citing Ex. 1004, 29:50–51).

Patent Owner concludes that the mere ability to simultaneously display multiple images on a screen and review images uploaded to a web server would not have motivated a person of skill in the art to combine

Creamer with Aihara. *Id.* at 19. Rather, according to Patent Owner, a person of skill in the art would have recognized that image review and analysis is performed faster and more efficiently using the images uploaded from the camera, instead of reviewing captured images directly on the LCD screen of the camera, and therefore there would have been no motivation to combine the cited references. *Id.*

We have considered all of Patent Owner's arguments that the Petition fails to provide a proper reason to combine the teachings of Creamer and Aihara for claims 1 and 23. We are unpersuaded by Patent Owner on this point. For example, Patent Owner's argument that "displaying multiple images on a display screen having a 'relatively small LCD display' would not improve the ability of the screen to display images, nor improve the ability of a user to review such images faster and more accurately" (PO Resp. 14) is not persuasive, because Aihara specifically teaches that thumbnail images can be previewed on the LCD display of a camera in arrays of four, nine, or sixteen images so that a user can quickly see multiple miniature images at one time, rather than being forced to view each image individually. *See* Ex. 1005, 1:33–36. Such a teaching by Aihara supports Petitioner's position. Furthermore, Creamer appears to suggest modifying its structure with the type of display image preview taught in Aihara, because Creamer specifically discloses an architecture where the LCD 218 is connected to GP DRAM 228 via Integrated Microcontroller 200. Ex. 1004, Fig. 17; *see* Ex. 2057, 30:17–31:2.

Additionally, Patent Owner's argument that "a [person of ordinary skill in the art] would not [have been] motivated to 'writ[e] code executed by the microcontroller disclosed in Creamer to enable it to display arrays of

preview images on the display screen like the processor and LCD screen disclosed in Aihara," because "[t]he LCD display in Creamer can preview only a single image—the current scene," is misplaced. *See* PO Resp. 16. Petitioner's position is premised on modifying Creamer in view of the teachings of Aihara in order to use thumbnail images to improve the ability of a relatively small LCD display to display multiple images. *See* Ex. 1003 ¶¶ 30–31. The test for obviousness is what the combined teachings of the references would have suggested to a person of ordinary skill in the art, not whether one reference may be bodily incorporated into the structure of another reference. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

We are satisfied that a person of skill in the art would have combined Aihara's teachings regarding review of captured images with the camera in Creamer. We specifically credit the testimony of Dr. Clark, which explains that the combination of Creamer and Aihara would constitute the use of a known technique to improve a similar device thereby yielding predictable results. Ex. 1003 ¶ 31 (citing Ex. 1005, 12:64–13:30). We give Dr. Clark's testimony substantial weight in that regard because it is supported by Creamer and Aihara's disclosures and what both Creamer and Aihara would have conveyed to a person of ordinary skill in the art at the time of the invention.

b. *Independent Claims 20 and 39*

Claims 20 and 39 require: (i) a transmitter, (ii) a computer, and (iii) a pre-processor. Ex. 1001, 8:1–22, 10:4–25. Claims 20 and 39 also require the identification of one or more media files and pre-processing of the identified media file or files. *Id.* at 8:6–14, 10:9–16. Claim 20 specifically

requires that the pre-processing parameters are received from a remote server, while claim 39 requires that the pre-processing parameters are loaded onto the client device by a device separate from the client device. *Id.* at 8:15–16, 10:17–19.

Petitioner contends that Creamer and Aihara, as summarized above, teach or suggest each limitation of the devices recited in independent claims 20 and 39. Pet. 29–30. Patent Owner does not provide separate contentions regarding claims 20 and 39. PO Resp. 33–34.

We have reviewed the Petition and the supporting evidence, and determine Petitioner has identified sufficient reasoning for the proposed combination of Creamer and Aihara to reach the devices recited in claims 20 and 39. We determine the record supports Petitioner's contentions as summarized above and adopt the supported contentions as our own.

> c. *Dependent Claims 2, 6, 10, 11, 18, 19, 26, 28–30, and 38*

Claims 2, 6, 10, 11, 18, and 19 depend from claim 1, while claims 26, 28–30, and 38 depend from claim 23. Ex. 1001, 7:10–10:3. Petitioner contends that Creamer and Aihara, as summarized above, teach or suggest the limitations of each dependent claim. Pet. 31–35. Patent Owner does not provide separate contentions regarding the additional limitations recited in the dependent claims. PO Resp. 34–35.

We have reviewed the Petition and the supporting evidence, and determine Petitioner has identified sufficient reasoning for the proposed combination of Creamer and Aihara to reach the methods recited in dependent claims 2, 6, 10, 11, 18, 19, 26, 28–30, and 38. We determine the

record supports Petitioner's contentions as summarized above and adopt the
supported contentions as our own.

d. Secondary Indicia of Non-Obviousness

Factual inquiries for an obviousness determination include secondary
considerations based on evaluation and crediting of objective evidence of
non-obviousness. *See Graham*, 383 U.S. at 17. Notwithstanding what the
teachings of the prior art would have suggested to one of ordinary skill in the
art at the time of the invention, the totality of the evidence submitted,
including objective evidence of non-obviousness, may lead to a conclusion
that the challenged claims would not have been obvious to one of ordinary
skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984).
Secondary considerations may include any of the following: long-felt but
unsolved needs, failure of others, unexpected results, commercial success,
copying, licensing, and praise. *See Graham*, 383 U.S. at 17; *Leapfrog
Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

To be relevant, evidence of non-obviousness must be commensurate
in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed.
Cir. 2011) (citing *In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971)); *In re
Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998). In that regard, in order
to be accorded substantial weight, there must be a nexus between the merits
of the claimed invention and the evidence of secondary considerations. *In re
GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). "Nexus" is a legally and
factually sufficient connection between the objective evidence and the
claimed invention, such that the objective evidence should be considered in
determining non-obviousness. *Demaco Corp. v. F. Von Langsdorff
Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). "The burden of proof

as to . . . nexus resides with the patent[owner]." *Id.*; *see Paulsen*, 30 F.3d
at 1482. "In meeting its burden of proof, the patent[owner] in the first
instance bears the burden of coming forward with evidence sufficient to
constitute a prima facie case of the requisite nexus." *Demaco*, 851 F.2d at
1392; *see Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294, 1310–11 (Fed.
Cir. 2010). "When the patent[owner] has presented a prima facie case of
nexus, the burden of coming forward with evidence in rebuttal shifts to the
[patent] challenger," i.e., the petitioner. *Demaco*, 851 F.2d at 1393; *Crocs*,
598 F.3d at 1311.

Here, Patent Owner argues that commercial success, licensing, long-
felt but unresolved need, and industry praise indicates that the claims would
not have been obvious to a person of ordinary skill in the art. PO Resp. 44–
60.

(1) Alleged Nexus Between Rimfire with Prepare & Post Tools and the Claimed Invention

Patent Owner contends its commercial product "Rimfire,"
incorporating the Prepare & Post tools, embodies the claimed invention.[7]
PO Resp. 45 (citing Ex. 2058 ¶¶ 260–271, 284–295, 307–310), 49 (citing
Ex. 2050 ¶ 40; Exs. 2010; 2014). According to Patent Owner, Rimfire,
including the Prepare & Post Tools, contains each component of the
challenged claims and therefore is at least "reasonably commensurate with
the scope" of the challenged claims. *Id.* at 46 (citing *Rambus Inc. v. Rea,*
731 F.3d 1248, 1257 (Fed. Cir. 2013)). Patent Owner concludes that
because "Rimfire" embodies the claimed features, the secondary

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[7] Patent Owner identifies "the claimed invention" in its discussion of
secondary considerations as independent claims 1, 20, 23, and 39. PO Resp.
45–46 (citing Ex. 2058 ¶¶ 260–271, 284–295, 307–310).

considerations of non-obviousness are presumed to be attributable to the patented invention. *Id.* at 46–47 (citing *Muniauction, Inc. v. Thomson Corp.,* 532 F.3d 1318, 1328 (Fed. Cir. 2008); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)).

We are not persuaded by Patent Owner's arguments. "Evidence of commercial success, or other secondary considerations, is only significant if there is a nexus between the claimed invention and the commercial success." *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006). As Petitioner argues, Patent Owner's evidence to support the allegation that its allegedly commercially successful product has the requisite nexus with the claimed invention is inadequate. *See* Reply 13–16.

Patent Owner relies on the testimony of Dr. Kaliski to support its argument of nexus. PO Resp. 45–46 (citing Ex. 2058). Dr. Kaliski relies on three exhibits to form his opinions regarding Rimfire: Exhibits 2010, 2014, and 2030. *See* Ex. 2058 ¶ 14. Dr. Kaliski did not review the source code for Rimfire, nor was he aware of what language was used to code the Prepare & Post Tools. *See* Ex. 1017, 44:22–24; 90:4–7. During his deposition, Dr. Kaliski testified that he could not identify (1) which version of Rimfire the exhibits he reviewed describe, (2) how many versions of Rimfire were ultimately released, (3) what versions of Rimfire were physically implemented for any particular customers, (4) how the Prepare & Post Tools were integrated into Rimfire, or (5) what algorithms were built into those tools. *Id.* at 81:4–88:9. Mr. Kaliski's testimony is insufficient evidence to establish a nexus between the Rimfire product and Patent Owner's proffered objective indicia of non-obviousness.

Additionally, the three exhibits relied upon by Mr. Kaliski (e.g., Exhibits 2010, 2014, and 2030) are insufficient evidence to establish a nexus between the Rimfire product and Patent Owner's proffered objective indicia of non-obviousness. Patent Owner and Dr. Kaliski heavily rely on Exhibit 2010, which purports to be the "Rimfire Functional Specification, Version 1.0 Core Feature Set." *See* PO Resp. 45–46; Ex. 2010, Title; Ex. 2058 ¶¶ 260–273, 275, 283–298, 300, 305–310. Patent Owner's declarant Sarah Pate testifies, however, that the exhibit is incomplete and contains placeholders for content yet to be added. Ex. 1019, 73:1–77:9; *see also* Ex. 2010, 17 ("In the near future, we will be adding support for formats we cannot display on the browser side but which are supported on the server side. When this happens, we will have to add a more dynamic way of specifying and checking allowable types on the browser side."), 32 ("Current [sic] no versions of IE handle minimal browser file sends from the Macintosh. We are currently working with 3 file upload utility developers to resolve this issue."), 34 ("For details on Pre-production and development servers, see the document [TBD]."), 71 ("*Modifying the Schema TBD [ORACLE DESIGNER DISCUSSION]* At the time of this writing, we are using Oracle Designer as our primary database schema modeling tool. A master Rimfire model has been set up and a target database configuration created."), 76 (Web Servers, TBD). Moreover, Patent Owner provides insufficient evidence that the version of Rimfire described in Exhibit 2010 (Version 1.0, Revision 4) was implemented in a commercial product. Although the incomplete nature of Exhibit 2010 is not wholly determinative, it affords the document less weight. Moreover, Patent Owner has not shown that this incomplete document describes an actual commercial product.

Similarly, Exhibit 2014 lacks any indication as to the version of Rimfire it describes, and Patent Owner provides insufficient evidence that this exhibit discloses each limitations in the challenged claims. *See, e.g.,* Ex. 2058 ¶¶ 261, 273, 277, 283, 297–298, (relying on Ex. 2010 for several limitations for the challenged claims of the '515 patent with no citations to Ex. 2014 for those limitations).

Exhibit 2030 is a claim construction order issued by the District Court in the Northern District of Texas, Wichita Falls Division, and is relied on by Dr. Kaliski only for his opinions on claim construction, which are not relevant to our patentability analysis or to the question of nexus. *See* Ex. 2058 ¶ 313. Patent Owner provides insufficient evidence that this exhibit discloses each limitations in the challenged claims.

Based on the foregoing, we do not agree with Patent Owner's arguments that "Rimfire" embodies the claimed features and is coextensive with them. Accordingly, we find Patent Owner has not established a nexus, and the evidence of record before us does not support a nexus, between the Rimfire product, with the Prepare & Post Tools, and the challenged claims of the '515 patent.

(2) Commercial Success: Rimfire with the Prepare & Post Tools

As evidence of commercial success, Patent Owner first relies on Picturebay.com, also known as "pBay," which was originally owned by PictureWorks. PO Resp. 52. Patent Owner explains that PictureWorks's pBay was an image-hosting website that relied on Rimfire and allowed users to upload images and insert them into online auctions such as eBay.com. *Id.* at 52–53 (citing Ex. 2011, Ex. 2012; Ex. 2050 ¶¶ 36–37; Ex. 2051 ¶¶ 22–24). According to Patent Owner, pBay achieved immediate commercial

success as shown by the fact that pBay reached one million image views by July 6, 1999, exceeded two million views by August of that year, became the largest image hosting and distributing site for eBay users, and after one year, Rimfire processed "over 250 million image views" for businesses and grew rapidly as its image views increased by over 3.5 million each week. *Id.* at 53 (Ex. 2012, 3; Ex. 2013; Ex. 2014, 3; Ex. 2050 ¶ 37; Ex. 2051 ¶ 24).

Patent Owner further argues that dramatic growth iPIX, a company that acquired PictureWorks, achieved in market share among online newspapers demonstrates the commercial success of the Rimfire product. *Id.* at 50, 54 (citing Ex. 2020, 12, 24–26; Ex. 2051 ¶¶ 41–42). One example cited by Patent Owner is the fact that the L.A. Times used Rimfire and achieved 225% growth in photo revenue year-over-year and its profits increased 36%. *Id.* (citing Ex. 2019, 7, 10).

As Petitioner argues, Patent Owner's arguments for commercial success are insufficient, because the evidence proffered by Patent Owner is limited to its own sales data, and does not include evidence of market share or growth in market share. *See* Reply 18. "An important component of the commercial success inquiry in the present case is determining whether [Patent Applicant] had a significant market share relative to *all* competing [product and companies] based on the merits of the claimed invention, which [Patent Applicant] did not show." *See In re Applied Materials, Inc.*, 692 F.3d 1289, 1300 (Fed. Cir. 2012); *see also In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) ("The more probative evidence of commercial success relates to whether the sales represent a substantial quantity in th[e] market."). Without evidence of market share, we have no way to determine

the impact that the Rimfire product had on a specific market, and hence, its commercial success.

Accordingly, we give little weight to Patent Owner's allegations of commercial success of the Rimfire product with the Post & Prep Tools.

(3) Commercial Success: Licensing

Patent Owner further argues that the commercial success of the patented technology behind the Rimfire product used by pBay led to the sale of PictureWorks to iPIX. *Id.* at 55 (citing Ex. 2050 ¶ 41; Ex. 2051 ¶ 26), 57 (citing Ex. 2050 ¶ 41). According to Patent Owner, eBay's subsequent licensing of the Rimfire technology from iPIX "represents a clear example of Rimfire's success." *Id.* at 54 (citing Ex. 2021 ¶ 5.9; Ex. 2020, 12; Ex. 2051 ¶ 39). Patent Owner notes that "as demonstrated in the Future Image Report's market research study, the '[r]eason for [eBay's] image server purchase' was 'the drag and drop picture submission feature of Rimfire.'" *Id.* at 57 (citing Ex. 2015, 10).

We are not persuaded. In cases in which the proffered evidence of commercial success is licenses, the nexus between the commercial success and the patent cannot be inferred; rather, "affirmative evidence of nexus" is required. *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1324 (Fed. Cir. 2004). In other words, a patent owner must demonstrate "a nexus between the *merits of the invention* and the licenses of record"; otherwise the licenses are to be accorded little weight. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (citation omitted). Moreover, our reviewing court has held that "without a showing of a nexus, 'the mere existence of . . . licenses is insufficient to overcome the conclusion of obviousness.'" *In re Antor*

Media Corp., 689 F.3d 1282, 1293 (Fed. Cir. 2012) (quoting *Iron Grip Barbell Co.*, 392 F.3d at 1324).

The cited testimony of Mr. Lewis only details the existence of a contract to eBay and does not establish that a license was negotiated because of the merits of the claimed invention, the merits of other patented inventions, the merits of unpatented technology, or for other economic reasons, such as hosting services or prior business relationships. *See* Ex. 2050 ¶¶ 41–43; *see also Antor Media*, 689 F.3d at 1294 (affirming Board's finding that evidence of existence of licenses was insufficient to overcome prima facie case of obviousness). Additionally, Mr. Lewis's testimony appears to indicate that the license was negotiated successfully because eBay desired the "the drag and drop picture submission feature of Rimfire," which is not a claimed limitation in the '515 patent. *See* Ex. 2050 ¶¶ 37, 40–42. In fact, Patent Owner specifically states that "eBay ultimately chose Rimfire because of its 'killer . . . drag and drop picture submission feature' and executed an agreement in April, 2000 for Rimfire services." PO Resp. 50 (citing Ex 2015, 10; Ex. 2033; Ex. 2050 ¶ 42; Ex. 2051 ¶¶ 29, 30).

Patent Owner's position is further undermined by Ms. Pate's testimony, which reveals that the license to eBay may not have been based on invention in the '515 patent at all. Ms. Pate specifically testifies that:

> Although iPIX desired a royalty-based license, its bargaining position was severely weakened without an issued patent, so we accepted eBay's offer. iPIX also agreed to continue providing its hosting service while converting the system to eBay's control. iPIX received an additional $6.3 million for that work. To ensure that iPIX continued to provide adequate services, eBay paid the $8 million in three separate payments.

Ex. 2051 ¶ 39. We, therefore, find that the evidence provided by Patent Owner does not establish a sufficient link between the merits of the invention claimed in the '515 patent and the taking of the noted license.

Furthermore, evidence of $8M in licensing revenue alone is not enough to show commercial success, because there must be evidence relating that figure to the overall market. *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) ("Information solely on numbers of units sold is insufficient to establish commercial success."); *see also In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) ("Declining to find evidence of commercial success because '[a]though [the inventor's] affidavit certainly indicates that many units have been sold, it provides no indication of whether this represents a substantial quantity in this market.'"). We, therefore, cannot determine whether the license reflects the commercial value of the invention claimed in the '515 patent, or whether it reflects other market conditions. Absent a persuasive showing of nexus, Patent Owner's evidence of licensing fails to establish commercial success. Accordingly, we give little weight to Patent Owner's argument that its licensing to eBay is evidence that the claims are not obvious.

(4) Long-Felt but Unsolved Need

Patent Owner argues that the inventors of the '515 patent recognized that there was a long-felt need "for a web-based media submission tool that pre-processes media prior to submission for both online real estate listing websites and major online auction websites." PO Resp. 47 (citing Ex. 2050 ¶¶ 11–13; Ex. 2014, 6). According to Patent Owner, "[t]here was no tool to help Realtors process images prior to uploading them to the Internet to meet

various websites' requirements for file format, resolution, compression, file size, etc." *Id.* (citing Ex. 2050 ¶ 11).

We are not persuaded. Evidence of long-felt need is "particularly probative . . . when it demonstrates both that a demand existed for the patented invention, and that others tried but failed to satisfy that demand." *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1082 (Fed. Cir. 2012). Additionally, to establish a long-felt but unresolved need, the evidence must show that there was a persistent problem recognized by those of ordinary skill in the art and the problem could not be solved by another. *See In re Gershon*, 372 F.2d 535, 533–39 (CCPA 1967); *Tandus Flooring, Inc. v. Interface, Inc.*, IPR2013-00527, slip op. at 47 (PTAB Feb. 12, 2015) (Paper 48).

First, Patent Owner's argument fails to identify where there was a demand for the patented invention or where others tried but failed to satisfy that demand. Second, Patent Owner's arguments that realtors "lacked the knowledge and patience to complete th[e claimed] process and often hired digital imaging professionals to scan and manipulate photos to meet the websites' requirements" undermines Patent Owner's position for two reasons: (i) realtors were not considered a person of ordinary skill in the art at the time of the invention; and (ii) Patent Owner's evidence demonstrates that those of ordinary skill in the art could accomplish the claimed process. *See* Ex. 2050 ¶¶ 11–13, 16–17.

Accordingly, we give little weight to Patent Owner's argument that there was a long-felt but unmet need that overcomes Petitioner's showing of obviousness in this case.

(5)Industry Praise

Patent Owner argues that the '515 patent has generated industry praise, because several articles have been written about the Rimfire product and because the company that owns Rimfire, iPIX, received the "Gold Award in Marketing Innovation" from the Yellow Pages Association. PO Resp. 58–59 (citing Ex. 2007; Ex. 2011; Ex. 2013; Ex. 2015; Ex. 2016, 10–11, 255; Ex. 2023; Ex. 2024; Ex. 2025; Ex. 2026, 1, 6; Ex. 2027 ¶ 54; Ex. 2052; Ex. 2053). According to Patent Owner, this recognition by others is strong objective indicia of the significance of the patent that weighs against obviousness. *Id.* at 59–60.

Industry praise for an invention may provide evidence of non-obviousness where the industry praise is linked to the claimed invention. *See Geo. M. Martin Co. v. Alliance Mach. Sys. Int'l LLC*, 618 F.3d 1294, 1305 (Fed. Cir. 2010); *Asyst Techs., Inc. v. Emtrak, Inc.*, 544 F.3d 1310, 1316 (Fed. Cir. 2008). As Petitioner argues, Patent Owner does not provide sufficient, if any, analysis explaining how the cited articles and award praise the invention recited in the challenged claims. *See* Reply 19. Nor does Patent Owner show relevant praise by the industry that includes those of ordinary skill in the art. *See Bayer Healthcare Pharms., Inc. v. Watson Pharms., Inc.*, 713 F.3d 1369, 1377 (Fed. Cir. 2013) (finding that brief discussions of Patent Owner's product in journal articles "fall well short of demonstrating true industry praise" and reasoning that "industry praise of what was clearly rendered obvious by published references is not a persuasive secondary consideration"). Accordingly, in this case, Patent Owner has not established a nexus, and the record evidence is insufficient to

support a nexus, between the merits of the claimed invention of the challenged claims and the alleged industry praise.

> ### e. *Summary of Analysis Regarding Creamer and Aihara*

We have considered the entirety of the evidence, including the evidence of obviousness and the evidence submitted by Patent Owner to show secondary considerations of non-obviousness. For the foregoing reasons, and weighing the evidence as a whole, we find Petitioner has proven by a preponderance of the evidence that the combination of Creamer and Aihara teaches or suggests all elements of challenged claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent. We determine the record supports Petitioner's contentions as summarized above and adopt the supported contentions as our own. We further find that understanding Creamer and Aihara's teachings as they apply to the challenged claims would have been within the level of ordinary skill in the art, as evidenced by the prior art of record. Additionally, we determine that Patent Owner's arguments and evidence of objective indicia of non-obviousness are insufficient to overcome the evidence of obviousness over Creamer and Aihara. We, therefore, conclude that claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 would have been obvious at the time of the invention, and thus, are unpatentable under 35 U.S.C. § 103.

> ### E. *Asserted Obviousness of Claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 in View of Mayle and Narayen*

Petitioner contends claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent are unpatentable under 35 U.S.C. § 103 in view of Mayle and Narayen. Pet. 36–53. Patent Owner disputes Petitioner's contention. PO Resp. 35–44. We have reviewed the Petition, Patent

Owner's Response, and Petitioner's Reply, as well as the relevant evidence
discussed in those papers. For reasons that follow, we determine that
Petitioner has shown by a preponderance of the evidence that the challenged
claims of the '515 patent would have been obvious in view of Mayle and
Narayen. Additionally, as discussed below, we determine that Patent
Owner's evidence of secondary considerations of non-obviousness does not
overcome Petitioner's showing that the claims would have been obvious to
one of ordinary skill in the art at the time of the invention.

1. Overview of Mayle

Mayle describes a "system for the creation of an image display such
as an electronic postcard." Ex. 1006, Abstract. An example of such a
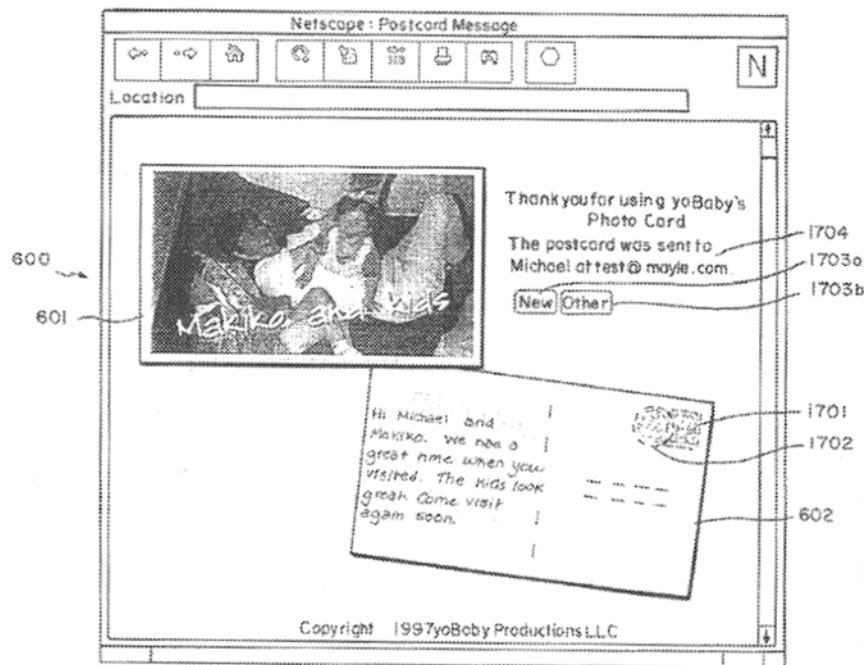display is the electronic postcard illustrated in Figure 17, reproduced below.

Figure 17 shows postcard 600 with front 601 that contains an image and
back 602 that contains postmark 1702 and a message. Ex. 1006, 9:9–22.

The system in Mayle includes a server connected to a network, where
the server receives image data from a second computer connected to the

network. *Id.* at 2:48–52. The server processes the electronic image data and creates a display containing at least a portion of the processed electronic image data. *Id.* at 2:52–54.

One embodiment in Mayle is illustrated in Figure 3A, reproduced below. According to Mayle, image files located in photo file 351 can be specified by a user as an image to be used on the electronic postcard. *Id.* at 10:36–39.
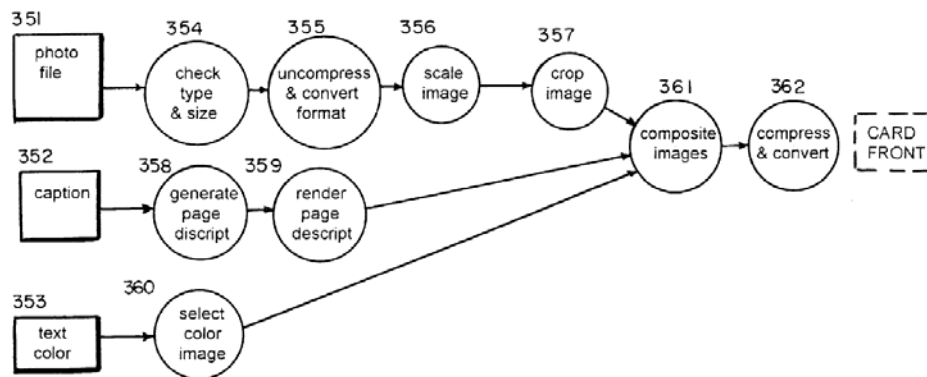
As shown in Figure 3a, form data is sent with the image file in file 351 from the user to a server (*id.* at 10:44–45), so that when an image file is received on the server, the "[e]lectronic postcard server software processes the photo using several steps as illustrated in Fig. 3a" (*id.* at 10:63–65). Such processing includes checking the image size, cropping, flipping, compressing, and scaling an image file. *Id.* at 10:66–11:48.

Another embodiment in Mayle discloses that the electronic postcard functionality is implemented as a component of a web site. *Id.* at 4:37–38. A web site is essentially a server computer providing public access to one or more files containing hypertext documents. *Id.* at 4:39–40. A user uses a web browser running on a client computer to access the hypertext documents stored on one or more server computers located on the network. *Id.* at 4:41–43. The server, running hypertext transfer protocol (HTTP) web server

software, transfers the hypertext document to the user computer for display on the browser. *Id.* at 4:44–46.

In another embodiment, Mayle contemplates that its system could be used to create a family album. *Id.* at 13:28–46. Specifically, Mayle discloses that a user could upload electronic images to a server, and the server could impose a structure for displaying and segregating the images into a viewable album. *Id.* at 13:28–37. According to Mayle, the user could specify one or more recipients to receive notice of the album or to allow visitors to comment on the images. *Id.* at 13:37–46.

Mayle further contemplates that its system and disclosed embodiments could "be adapted to provide additional processing by the client computer of the electronic image data and/or the display." *Id.* at 13:51–53. Mayle states that:

> [s]oftware running on the client computer can also preview the result of the various other types of image data processing e.g. scaling, filtering, color correcting, compositing text, etc. The result produced as result of this processing on the client computer could be at the same resolution as created by the server computer or it could be a lower quality so as to minimize processing time for the preview, thus allowing the server to actually produce the final processed information. The client computer software can be implemented in the Java language so as to run within a Java enabled browser.

Id. at 13:59–14:9.

2. *Overview of Narayen*

Narayen discloses a method for generating a collection of digital media and transmitting the collection to a server system. Ex. 1007, Abstract. The method of Narayen allows "a user on a client computer system 121 to create a media container which contains digital media and publish this media

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container with its digital media onto the Internet for other client computer systems to be able to view the media container with its digital media." Ex. 1007, 7:29–34. Prior to uploading images to the Internet, the client device creates "a lower resolution version of a digital image, such as a 'thumbnail' version [that] is stored in the database along with a link to the original image stored on the file storage device." *Id.* at 6:56–59. In addition, "the album authoring software scales each picture if necessary to cause it to fit into the corresponding slot on the album page." *Id.* at 9:45–47.

Figure 4, reproduced below, illustrates one embodiment of a digital media collection method taught in Narayen.
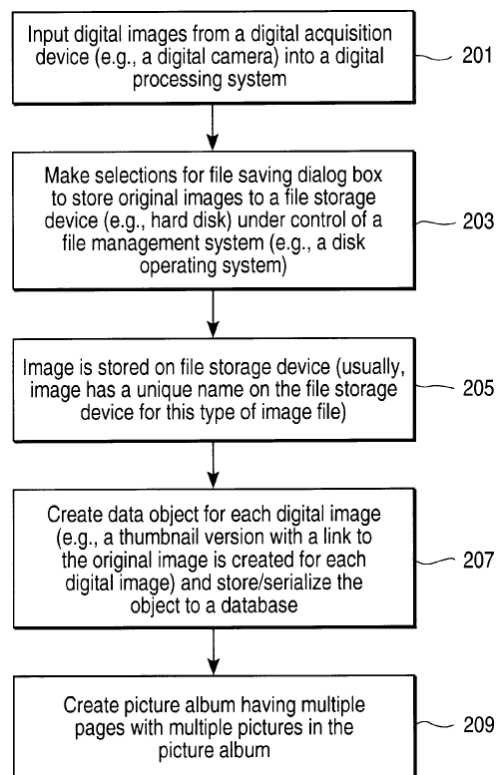

Figure 4 shows the steps for acquiring a digital image for use in a digital processing system. *Id.* at 6:28–31. In step 201, a user inputs digital images from a digital camera into a digital processing system, such as a computer.

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Id. at 6:31–34. In step 203, the user makes selections in a file saving dialog box presented to the user on a display of the computer system and stores an original image to the file storage device, such as a hard disk. *Id.* at 6:40–43. In step 205, the image is stored and typically the image has a unique name on the file storage device or at least a unique full path name for this type of image file. *Id.* at 6:45–48. Then in step 207, a data object is created for each digital image stored in a database. *Id.* at 6:48–50. According to Narayen, a lower resolution version of a digital image, such as a "thumbnail" version, can be stored in the database along with a link to the original image stored on the file storage device. *Id.* at 6:56–60. Narayen discloses that the link, which is stored in association with the thumbnail version, refers back to the original image by identifying the picture title or caption as well as the full path name of the original image stored on the file storage device in step 203. *Id.* at 6:61–64.

Narayen further discloses that the album authoring software on the client system can scale each picture if necessary to cause it to fit into a corresponding slot on the album page. *Id.* at 9:45–47, Fig. 13. Another embodiment of Narayen, shown in Figure 2 reproduced below, details how album data created and formatted on a client system is sent to a server system.
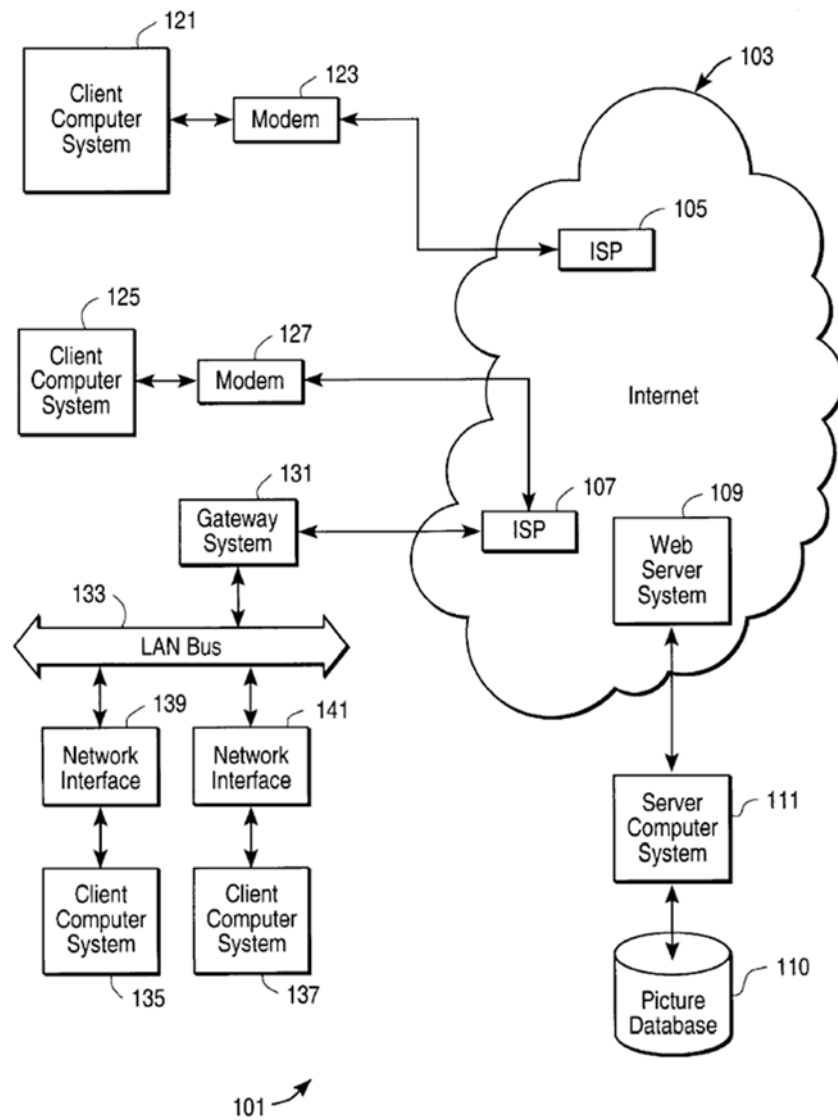
As illustrated in Figure 2, above, a client system, such as system 121,

communicates to server computer system 111 through the web server 109.

Id. at 10:8–10. The client system from which publication is to occur sends

the log-in message, such as user ID and user password to the server system.

Id. at 10:10–13. The server system responds to a log-in request and

confirms acceptance, then the user at the client system selects an album

name. *Id.* at 10:13–15. This selection may occur by typing in a name or by

selecting a name from a list. *Id.* at 10:15–17. The client system then

transmits the album name to the server system. *Id.* at 10:17–18. The client

system, which is publishing the album, transmits the album format data to

the server and also transmits a signature of each picture in the picture album

to the server. *Id.* at 10:36–39. According to Narayen, additional processing

can be performed by the server system after receiving the album format data

and the images from the client system. *Id.* at 10:51–53, Fig. 8.

3. *Analysis*

a. *Independent Claims 1 and 23*

(1) *"receiving an identification of one or more image files, video files or audio files to associate with said account"*

Petitioner contends Mayle and Narayen, as summarized above, teach

or suggest "receiving an identification of one or more image files, video files

or audio files to associate with said account," as recited by challenged

claims 1 and 23. Pet. 38–39. According to Petitioner, Mayle discloses a

system that receives an identification of images to associate with an account

wherein "the user specifies a file on the local client computer that holds the

image data he or she wants to use on their card." *Id.* at 38 (citing Ex. 1006,

10:38–39). Petitioner explains that the media objects are limited by

pre-processing parameters, for example a photo would have been in JPEG or

GIF format. *Id.* (citing Ex. 1006, 10:39–40). According to Petitioner, the

parameters in Mayle specify the amount of media data received and are

implemented by the local device such that "[t]he resulting image is finally

compressed and converted into an image format viewable in a web browser

(such as GIF or JPEG)." *Id.* at 39 (citing Ex. 1006, 12:30–33). Petitioner

then cites to Narayen for the disclosure of a user identifying media files for

transmission because the user makes "selections on a graphical user

interface presented by the picture management software on the client computer system" that can "cause a media container with its associated digital media to be published to the Internet for others to view with conventional web browsers." *Id.* (citing Ex. 1007, 7:49–55).

Patent Owner contests Petitioner's position, contending that Mayle and Narayen fail to teach the limitation "receiving an identification of one or more image files, video files or audio files to associate with said account," as recited in claims 1 and 23. PO Resp. 35–36. According to Patent Owner, Mayle does not associate any image files with an account, because contrary to Petitioner's arguments "'[s]pecif[ying] a file on the local client computer that holds the image data he or she wants to use on their card' . . . does not . . . relate to any 'account' to which files are to be associated." *Id.* at 35–36 (citing Pet. 38; Ex. 2058 ¶ 169). Patent Owner then argues that user selection of a media container in Narayen does not constitute identification of image data, because selection of a media container does not identify the files referenced by that container. *Id.* at 36 (citing Ex. 2058 ¶ 170). Patent Owner concludes that neither Mayle nor Narayen teaches the limitation "receiving an identification of one or more image files, video files or audio files to associate with said account"; thus, a combination of the references does not teach the disputed limitation. *Id.*

Despite Patent Owner's arguments, we agree with Petitioner that Mayle and Narayen teach or suggest the limitation "receiving an identification of one or more image files, video files or audio files to associate with said account." *See* Pet. 38–39. Mayle specifically discloses that a "user specifies a file on the local client computer that holds the image data he or she wants to use on their card," thereby sending an identification

of an image to associate with an account. Ex. 1006, 10:38–39. Therefore,
on the record before us, we are satisfied that one of ordinary skill in the art
would have understood that the disclosure in Mayle teaches the disputed
claim limitation.

> *(2) "pre-processing said identified one or more . . . files
> using pre-processing parameters . . . enabling said
> client device to pre-process . . . one or more . . . files"*

Petitioner contends the combination of Mayle and Narayen teaches or
at least suggests "pre-processing said identified one or more . . . files using
pre-processing parameters . . . enabling said client device to pre-process . . .
one or more . . . files," as recited in challenged claims 1 and 23. Pet. 41–45.
Petitioner argues that Mayle discloses pre-processing parameters received
from a server at a client device because "[t]he image data that is POSTed to
the server must be in a size and format that the electronic postcard software
can handle." *Id.* at 38–39. According to Petitioner, Mayle teaches that
"[t]he first step is to check the byte count of the data sent to the server. If
the byte count exceeds some limit then the image is ignored and the user is
redirected to an error page." Pet. 42 (citing Ex. 1006, 10:66–11:4).
Petitioner reasons that it would have been obvious to one of skill in the art:
(i) to send the parameters specifying maximum byte count, maximum scale,
and compression format from the server hosting the web site comprising the
system to the client device, (ii) that a client device accessing this website
could receive parameters (*e.g.*, maximum byte count, maximum scale, and
compression format) from the server, and (iii) that these parameters may be
sent from the server to the client device. Pet. 43 (citing Ex. 1003 ¶ 55).

Petitioner further argues that although Mayle's preferred embodiment
contemplates the server performing the image pre-processing, "[t]he result

produced as result of this processing on the client computer could be at the same resolution as created by the server computer." *Id.* at 44 (citing Ex. 1006, 14:2–5). Petitioner relies on testimony from Patent Owner's Declarant, Dr. Kaliski, to support its position.

> Q: So this section of Mayle discusses the client computer processing image data?

> A: Electronic image data, yes.

Reply 5 (citing Ex. 1017, 40:5–8). Petitioner also relies on the testimony of its Declarant, Dr. Clark, to support its position. *Id.* at 6. Dr. Clark testifies that it would have been obvious to a person of ordinary skill to send processing parameters from the server hosting the website to a client device executing a browser-based system to perform image processing locally. Ex. 1003 ¶ 55. Dr. Clark further opines that it also would have been obvious, once client-side processing was completed, to transmit the processed image from the client to the server as Mayle teaches. *Id.* ¶ 59.

Patent Owner disputes Petitioner's position and contends Mayle and Narayen fail to teach or suggest "pre-processing said identified one or more . . . files using pre-processing parameters . . . enabling said client device to pre-process . . . one or more . . . files," as recited in challenged claims 1 and 23. PO Resp. 36–39. Patent Owner first argues that Mayle is based on server-side processing and not client-side processing as portrayed by Petitioner. *Id.* at 37–38 (citing Ex. 2058 ¶ 172). According to Patent Owner, Mayle does not describe pre-processing but rather, describes a "web browser running on a client computer 10 to access the hypertext documents stored on one or more server computers." *Id.* at 38 (citing Ex. 1006, 4:41–43, 6:66–7:6).

Patent Owner further argues that Petitioner cannot rely on Narayen, because Petitioner merely cites two excerpts of Narayen without analysis regarding how Narayen allegedly meets this claim limitation. *Id.* Patent Owner then characterizes Narayen as processing a picture album only at the server. *Id.* (citing Ex. 1007, 10:51–11:6, 8:40–45). According to Patent Owner, Narayen's discussion relating to the "album authoring software scal[ing] each picture if necessary to cause it to fit into the corresponding slot on the album page" is not an example of "preprocessing." *Id.* at 38–39 (Ex. 1007, 9:45–47; Ex. 2058 ¶ 174). Patent Owner concludes that Narayen scales an image for *preview* on the client display and does not modify the underlying data for that identified image as required by pre-processing. *Id.* at 39.

Despite Patent Owner's arguments, we agree with Petitioner that Mayle at least suggests that the processing parameters would have been used to enable a client device to pre-process one or more files in a manner specified by a distributing party. Mayle specifically discloses: (i) "the client may be augmented to perform a portion of the processing during interactions with the servers" (Ex. 1006, 3:2–4), (ii) "[t]he browser may be further augmented for supporting the Java language . . . to enable the browser to support processing local to the client" (*id.* at 6:62–65), (iii) "[t]he embodiments can further be adapted to provide additional processing by the client computer of the electronic image data and/or the display" (*id.* at 13:51–54), (iv) "[t]he result produced as [a] result of this processing on the client computer could be at the same resolution as created by the server computer" (*id.* at 14:2–7), and (v) "[t]he client computer software can be

implemented in the Java language so as to run within a Java enabled browser" (*id.* at 14:7–9).

We credit the testimony of Petitioner's declarant, Dr. Clark, who testified that given the disclosure in Mayle of augmenting its browser to support programs written in the Java programming language, "one of skill in the art would have writen a Java program accessible by Mayle's browser-based system that would implement Narayen's digital album authoring tools." Ex. 1003 ¶ 52 (citing Ex. 1006, 6:62–65). Thus, based on the explicit teaching in Mayle and testimony of Dr. Clark, we are satisfied that one of skill in the art would have been familiar with the Java programming language and would have been implemented processes using that language.

Accordingly, on the record before us, we are satisfied the combination of Mayle and Narayen teaches or at least suggests "pre-processing said identified one or more . . . files using pre-processing parameters . . . enabling said client device to pre-process . . . one or more . . . files," as recited in challenged claims 1 and 23.

> *(3) "pre-processing said identified one or more . . . files using pre-processing parameters received from a remote server"*

Petitioner contends the combination of Mayle and Narayen teaches or at least suggests "pre-processing said identified one or more . . . files using pre-processing parameters received from a remote server," as recited in challenged claims 1 and 23. Pet. 41–45. Petitioner argues that Mayle discloses pre-processing parameters received from a server at a client device because "[t]he image data that is POSTed to the server must be in a size and format that the electronic postcard software can handle." *Id.* at 41. According to Petitioner, Mayle teaches that "[t]he first step is to check the

byte count of the data sent to the server. If the byte count exceeds some limit then the image is ignored and the user is redirected to an error page." *Id.* at 42 (citing Ex. 1006, 10:66–11:4). Petitioner reasons that it would have been obvious to one of skill in the art: (i) to send the parameters specifying maximum byte count, maximum scale, and compression format from the server hosting the web site comprising the system to the client device, (ii) that a client device accessing this website could receive parameters (*e.g.*, maximum byte count, maximum scale, and compression format) from the server, and (iii) that these parameters may be sent from the server to the client. *Id.* at 43 (citing Ex. 1003 ¶ 55). Petitioner further argues that although Mayle's preferred embodiment contemplates the server performing the image pre-processing, "[t]he result produced as result of this processing on the client computer could be at the same resolution as created by the server computer." *Id.* at 44 (citing Ex. 1006, 14:2–5).

Patent Owner disputes Petitioner's position and contends Mayle and Narayen fail to teach or suggest "pre-processing said identified one or more . . . files using pre-processing parameters received from a remote server," as recited in challenged claims 1 and 23. PO Resp. 40–41. Patent Owner argues that Mayle does not receive pre-processing parameters from a remote server because the remote server, not the local client, performs the processing steps on the image data. *Id.* at 39. According to Patent Owner, Petitioner's arguments are incorrect because the file-size checking functionality in Mayle does not process the image, but is merely an error check to prevent the server from processing large image files and it is not used to process an image in a different size. *Id.* at 40 (citing Ex. 2058

¶ 178). Patent Owner further argues that the server in Mayle performs file size functionality and the client device does not receive any file size parameter. *Id.* (citing Ex. 1006, 10:63–67; Ex. 2058 ¶ 176).

As discussed above, we agree with Petitioner that Mayle at least suggests "using pre-processing parameters received from a remote server," because Mayle specifically discloses: (i) "the client may be augmented to perform a portion of the processing during interactions with the servers" (Ex. 1006, 3:2–4), (ii) "[t]he browser may be further augmented for supporting the Java language . . . to enable the browser to support processing local to the client" (*id.* at 6:62–65), (iii) "[t]he embodiments can further be adapted to provide additional processing by the client computer of the electronic image data and/or the display" (*id.* at 13:51–54), (iv) "[t]he result produced as [a] result of this processing on the client computer could be at the same resolution as created by the server computer" (*id.* at 14:2–7), and (v) "[t]he client computer software can be implemented in the Java language so as to run within a Java enabled browser" (*id.* at 14:7–9).

Again, we credit the testimony of Petitioner's declarant, Dr. Clark, who testified that given the disclosure in Mayle of augmenting its browser to support programs written in the Java programming language, "one of skill in the art would be able to write a Java program accessible by Mayle's browser-based system that would implement Narayen's digital album authoring tools." Ex. 1003 ¶ 52 (citing Ex. 1006, 6:62–65). Therefore, based on the explicit teaching in Mayle and testimony of Dr. Clark, we are satisfied that one of skill in the art would have been familiar with the Java programming language and would have been able to implement processes using that language.

Patent Owner's arguments also are not persuasive, because "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.' *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Consequently, we 'can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.' *Id.* at 418. Furthermore, 'we do not ignore the modifications that one skilled in the art would make to a device borrowed from the prior art.' *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (citing *Optivus Tech., Inc. v. Ion Beam Applications, S.A.,* 469 F.3d 978, 989–90 (Fed. Cir 2006)). Patent Owner's arguments that Petitioner's challenge is based solely on hindsight analysis also is not persuasive, because:

> [a]ny judgment on obviousness is . . . necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.

In re McLaughlin, 443 F.2d 1392, 1395 (CCPA 1971); *see also Radix Corp. v. Samuels*, 13 USPQ2d 1689, 1693 (D.D.C. 1989) ("[A]ny obviousness inquiry necessarily involves some hindsight."). Here, Petitioner's reason for modifying the server-based system of Mayle to a client-based device is based on an explicit suggestion in Mayle itself. This reason does not include knowledge gleaned only from the '515 patent. Accordingly, we do not agree with Patent Owner's assertions that one having ordinary skill in the art would not have been motivated to modify Mayle.

Accordingly, on the record before us, we are satisfied the combination of Mayle and Narayen teaches or at least suggests "pre-processing said

identified one or more . . . files using pre-processing parameters received

from a remote server," as recited in challenged claims 1 and 23.

>*(4) "pre-processing . . . files in a manner specified by a
>distributing party"*

Petitioner contends the combination of Mayle and Narayen teaches or

at least suggests "pre-processing. . . files in a manner specified by a

distributing party," as recited in challenged claims 1 and 23. Pet. 41–45.

Petitioner argues that a person of skill in the art would have understood that

the claim limitation regarding a "manner specified by a distributing party for

transfer of content" is a form that depends on the nature of the distribution.

Id. at 45 (citing Ex. 1003 ¶ 57.) According to Petitioner, the '515 patent

relates to the field of "handling, manipulation and processing of digital

content and more particularly to the transportation and Internet publishing of

digital content." *Id.* (citing Ex. 1001, 1:15–19). Consequently, Petitioner

explains that one of skill in the art would have known that the "manner

specified" by the parameters would have been a well-known form of digital

content suitable for Internet distribution, such as HTML, JPEG, and other

similar encoding. *Id.* (citing 1003 ¶ 57).

Patent Owner disputes Petitioner's position and contends Mayle and

Narayen fail to teach or suggest "pre-processing . . . files in a manner

specified by a distributing party," as recited in challenged claims 1 and 23.

PO Resp. 41–42. Patent Owner specifically argues that Petitioner fails to

identify a distributing party in Mayle or Narayen, but relies only on the

alleged knowledge of one of ordinary skill in the art. *Id.* at 41. According to

Patent Owner, the preview images discussed in Mayle (*see* Ex. 1006, 13:59–

14:8) and the scaled images discussed in Narayen (*see* Ex. 1007, 9:45–47)

are for viewing by the user on the client, not for distribution to others, and

therefore, this limitation is not met by Mayle and Narayen. *Id.* at 42 (citing Ex. 2058 ¶ 178). Patent Owner concludes that Petitioner makes wholly conclusory statements and fails to articulate what aspects of the alleged "received parameters" in Mayle and Narayen would have been selected, and how to modify Mayle in view of Narayen to render this limitation obvious. *Id.*

We do not agree with Patent Owner's position. First, Narayen specifically discloses that after a user creates a picture album with associated pictures, the user can publish or distribute the picture album by making it available for viewing to web browsers over the Internet. *See* Ex. 1007, 7:49–56, 9:65–10:1. Second, the claims do not require that a specific distributing party be identified. Rather, the claims require that the manner in which a file is pre-processed be specified by a distributing party. Therefore, we find that a distributing party can use the teachings in both Mayle and Narayen to specify the manner in which a file is to be pre-processed by sending a setup/configuration file (i.e., pre-processing instructions) to the client device when it is connected to a remote server as required by the challenged claims.

(5) *Obvious to Combine the Teachings of Mayle and Narayen*

Petitioner argues that a person of skill in the art would have had reason to combine Mayle and Narayen because "Mayle expressly teaches that its 'invention can be modified to create . . . an album . . . holding a variety of images in a structured album'" (Ex. 1006, 13:6–43) and can "be adapted to provide additional processing by the client computer of the electronic image data and/or the display" (*id.* at 13:51–53), while "Narayen discloses a system that produces digital photo albums" (Ex. 1007, 6:66–

7:13). *See* Pet. 14. According to Petitioner, Mayle teaches that its system can be modified to create a structured album for storing and displaying digital images via the Internet (*see, e.g.*, Ex. 1006, 13:29–46), and Narayen describes a system for creating and uploading albums of digital images via the Internet (*see, e.g.*, Ex. 1007, 6:67–7:2). Pet. 14–15.

Petitioner supports its position with the Declaration of Dr. Clark, who testifies that a person of skill in the art would have been motivated to combine these references because Mayle expressly teaches that it can be modified to incorporate a digital album, as disclosed by Narayen, and such a modification would have been accomplished using known techniques, for example, a program written in the Java programming language, as disclosed in Mayle. *Id.*; Ex. 1003 ¶¶ 51–52 (citing Ex. 1006, 6:62–65). Petitioner further argues that the testimony of Patent Owner's Declarant, Dr. Kaliski, supports the conclusion that client side processing could be accomplished using a Java-enabled web browser:

> Q: So a person could consider whether processing would be done on the server or on the client with such a Java application?
>
> A: Sure.

Ex. 1017, 73:5–8. Petitioner then cites to Patent Owner's commercial product, Rimfire, which is accessed with a Java-enabled web browser and performs image pre-processing on a client device. Reply 12.

Patent Owner contends that Petitioner's obviousness challenges fail, because a person of ordinary skill in the art would not have combined Mayle and Narayen. PO Resp. 19–25. Specifically, Patent Owner argues that (1) the differences between the server-based architecture of Mayle and the client-based architecture of Narayen counsels against Petitioner's proposed

combination and (2) Mayle and Narayen are directed toward different types
of albums that solve different problems. *Id.* at 20 (citing Ex. 2058 ¶¶ 77–
79). According to Patent Owner, Mayle's family album allows related users
to upload images to a server that imposes a structure and creates an album,
and once uploaded, users specify a limited number of recipients to receive
notice of the album (Ex. 1006, 13:29–46), while Narayen allows a user to
select the format of a web page having one or more images and places the
images into a media container, which is sent to a server for processing into
an HTML page (Ex. 1007, 6:67–7:2). PO Resp. 20 (citing Ex. 2058 ¶ 77).
Patent Owner, therefore, contends that Petitioner's assumption that Mayle
and Narayen are "similar devices" is incorrect. *Id.* (citing Pet. 15). Patent
Owner concludes that because Narayen and Mayle are based on
fundamentally different architectures, a person of ordinary skill in the art
would not have been motivated to combine these references. *Id.* at 21 (citing
Ex. 2058 ¶ 79).

Patent Owner further contends that Petitioner fails to articulate how
any alleged "improved features" or "improvements" from Narayen would
have been combined with Mayle; instead, according to Patent Owner,
Petitioner merely concludes that a "skilled artisan *could have* applied the
improvement of Narayen to the system of Mayle to achieve the predictable
result of publishing processed digital images to the Internet in a photo
album." *Id.* at 22 (citing Pet. 15). Patent Owner relies on testimony from
Petitioner's Declarant, Dr. Clark, to support its position. *Id.* Dr. Clark
testifies as follows:

Q. What improvements are described from Narayen, in your opinion?

A. I don't know from memory.

Ex. 2057, 7:6–8.

> Q. But -- so it's your testimony that the improvements that you
> identified in Paragraph 52, are not described in Paragraph 52 of
> your expert report?
>
> A. No, it's--they are not explicitly listed.

Id. at 7:22–25.

> Q. But just to be clear, so in your declaration, you didn't identify any
> improvements described in Narayen in your expert – in your
> declaration?
>
> A. I did not list them.
>
> Q. Okay. Can you identify any improvements described in Narayen,
> as you sit here today?
>
> A. I'm not prepared to do that from memory, no.

Id. at 8:8–16.

Patent Owner argues that Petitioner cannot meet its obviousness burden without articulating the teachings of Narayen and Mayle that are to be combined. PO Resp. 22. According to Patent Owner, unknown "improvements" and "additional image processing tools" would not have motivated a person of ordinary skill in the art to combine these references, especially considering that Narayen does not improve or provide additional image processing tools beyond the image processing functions of the server in Mayle. *Id.* (citing Ex. 2058 ¶¶ 80–81).

Patent Owner then argues that it is improper hindsight to assume that a person of ordinary skill in the art would have redesigned the server-based system of Mayle into a client-based one to implement the album authoring software of Narayen through Java functionality. *Id.* at 23. Patent Owner

reasons that because Mayle does not teach a Java-enabled browser for creating the structure for an album, perform all image processing for an album, and create an album as alleged by Petitioner, Mayle is not an enabling disclosure permitting one of ordinary skill in the art to implement the Mayle authoring tools in a Java enabled browser. *Id*. at 23–24 (citing Ex. 2058 ¶ 82). Patent Owner further argues that a person of ordinary skill in the art would not have been motivated to redesign Mayle by incorporating the album authoring tools of Narayen in light of the state of browser functionalities and network limitations in 1999. *Id*. at 24–25 (citing Ex. 2058 ¶ 85). Patent Owner, thus, concludes that a person of skill in the art would not have modified Mayle according to the teachings of Narayen. *Id*.

We have considered all of Patent Owner's arguments that the Petition fails to provide a proper reason to combine the teaching of Mayle and Narayen for claims 1 and 23. We do not agree with Patent Owner because Mayle discloses that "the client may be augmented to perform a portion of the processing during interactions with the servers" (Ex. 1006, 3:2–4, *see also id.* at 6:62–65, 13:51–54, 14:2–9 (similar supporting statement regarding augmenting a client device to process files) and Mayle specifically contemplates using its system to create a family picture album (*see id.* at 13:28–45), which is exactly what is taught by Narayen. Additionally, we find Mayle's explicit instruction that "client computer software can be implemented in the Java language so as to run within a Java enabled browser" to weigh in favor of a person of ordinary skill in the art following this instruction to use the Java language to create a client device system for producing a family picture album.

b. *Independent Claims 20 and 39*

Claims 20 and 39 require: (i) a transmitter, (ii) a computer, and (iii) a pre-processor. *Id.* at 8:1–22, 10:4–25. Claims 20 and 39 also require the identification of one or more media files and pre-processing of the identified media file or files. *Id.* at 8:6–14, 10:9–16. Claim 20 specifically requires that the pre-processing parameters are received from a remote server, while claim 39 requires that the pre-processing parameters are loaded onto the client device by a device separate from the client device. *Id.* at 8:15–16, 10:17–19.

Petitioner contends that Mayle and Narayen, as summarized above, teach or suggest each limitation of the devices recited in independent claims 20 and 39. Pet. 47–48. Patent Owner does not provide separate contentions regarding claims 20 and 39. PO Resp. 43–44.

We have reviewed the Petition and the supporting evidence, and determine Petitioner has identified sufficient reasoning for the proposed combination of Mayle and Narayen to reach the devices recited in claims 20 and 39. We determine the record supports Petitioner's contentions as summarized above and adopt the supported contentions as our own.

c. *Dependent Claims 2, 6, 10, 11, 18, 19, 26, 28–30, and 38*

Claims 2, 6, 10, 11, 18, and 19 depend from claim 1, while claims 26, 28–30, and 38 depend from claim 23. Ex. 1001, 7:10–10:3. Petitioner contends that Mayle and Narayen, as summarized above, teach or suggest the limitations of each dependent claim. Pet. 49–53. Patent Owner does not provide separate contentions regarding the additional limitations recited in the dependent claims. PO Resp. 44.

We have reviewed the Petition and the supporting evidence, and determine Petitioner has identified sufficient reasoning for the proposed combination of Mayle and Narayen with respect to dependent claims 2, 6, 10, 11, 18, 19, 26, 28–30, and 38. We determine the record supports Petitioner's contentions as summarized above and adopt the supported contentions as our own.

d. Analysis of Secondary Considerations of Non-Obviousness

As discussed above in Section II.D.3.d., Patent Owner failed to demonstrate a prima facie case of, and the record evidence does not support, a nexus between the claimed invention and any commercial success or industry praise. Patent Owner's evidence also does not demonstrate a long-felt but unmet need for the claimed invention. We, thus, find that the evidence of objective indicia of non-obviousness is insufficient to overcome the evidence of obviousness over Mayle and Narayen.

e. Conclusion of Analysis Regarding Mayle and Narayen

For the foregoing reasons, and weighing the evidence as a whole, Petitioner has proven by a preponderance of the evidence that Mayle and Narayen teach or at least suggest all elements of challenged claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent. We determine the record supports Petitioner's contentions as summarized above and adopt the supported contentions as our own. Furthermore, we find that understanding Mayle and Narayen's teachings as it applies to claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 would have been within the level of ordinary skill in the art, as evidenced by the prior art of record. We,

therefore, determine that the challenged claims would have been obvious at the time of the invention, and thus, are unpatentable under 35 U.S.C. § 103 in view of Mayle and Narayen.

III.   MOTIONS FOR OBSERVATIONS REGARDING DEPOSITION TESTIMONY

Patent Owner's observations are directed to the cross-examination testimony of Mr. Gary L. Frazier. Paper 45. Mr. Frazier was deposed after Patent Owner filed its Preliminary Response. *See* Ex. 2075. We have considered Patent Owner's observations and Petitioner's responses (Paper 51) in rendering our decision, and have accorded the testimony the appropriate weight. *See* Obs. 1–15; Obs. Resp. 1–15.

IV.   MOTION TO EXCLUDE EVIDENCE

Petitioner filed a Motion to Exclude Evidence seeking to exclude all or part of Exhibits 2015, 2044, 2045, 2050, 2051, 2058, 2073, and 2074 submitted by Patent Owner. Paper 44. The party moving to exclude evidence bears the burden of proving that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence. *See* 37 C.F.R. §§ 42.20(c), 42.62(a). Even without excluding this evidence, we have determined that Petitioner has established, based on a preponderance of the evidence, the unpatentability of claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent. Furthermore, Petitioner's arguments on these items go to the weight to be accorded to the evidence. The Board is capable of determining and assigning the appropriate weight to the evidence. For these reasons, we *deny* Petitioner's motion.

V.   CONCLUSION

For the foregoing reasons, we determine Petitioner has shown by a preponderance of the evidence that claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent would have been obvious in view of either (i) Creamer and Aihara or (ii) Mayle and Narayen.

VI.   ORDER

For the reasons given, it is

ORDERED that, by a preponderance of the evidence, claims 1, 2, 6, 10, 11, 18–20, 23, 26, 28–30, 38, and 39 of the '515 patent are unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude Evidence (Paper 44) is *denied*; and

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

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