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Paper No. 8
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., INSTAGRAM, LLC, and WHATSAPP INC.,
Petitioner,

v.

BLACKBERRY LIMITED,
Patent Owner.

Case IPR2019-00528
Patent 8,279,173 B2

Before MIRIAM L. QUINN, JACQUELINE T. HARLOW, and AARON W. MOORE, *Administrative Patent Judges.*

HARLOW, *Administrative Patent Judge.*

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

I. INTRODUCTION

Facebook, Inc., Instagram, LLC, and WhatsApp Inc. (collectively, "Petitioner"), filed a Petition (Paper 2, "Pet."), requesting *inter partes* review of claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18 of U.S. Patent No. 8,279,173 B2 (Ex. 1001, "the '173 patent"). Blackberry Limited ("Patent Owner") timely filed a Preliminary Response (Paper 7, "Prelim. Resp.").

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons stated below, we determine that there is a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim. We hereby institute *inter partes* review of the challenged claims on all the grounds of unpatentability asserted in the Petition.

A. Related Matters

The '173 patent is the subject of a district court proceeding in the Central District of California, captioned *BlackBerry Ltd. v. Facebook, Inc.*, Case No. 2:18-cv-01844-GW-KS (C.D. Cal.). Pet. 2; Paper 5, 2. In addition, four days prior to filing this Petition, Petitioner filed a petition seeking *inter partes* review of the '173 patent in IPR2019-00516 ("the '516 IPR"). '516 IPR, Paper 5, 1. Our decision instituting *inter partes* review in the '516 IPR issued concurrently with this Decision.

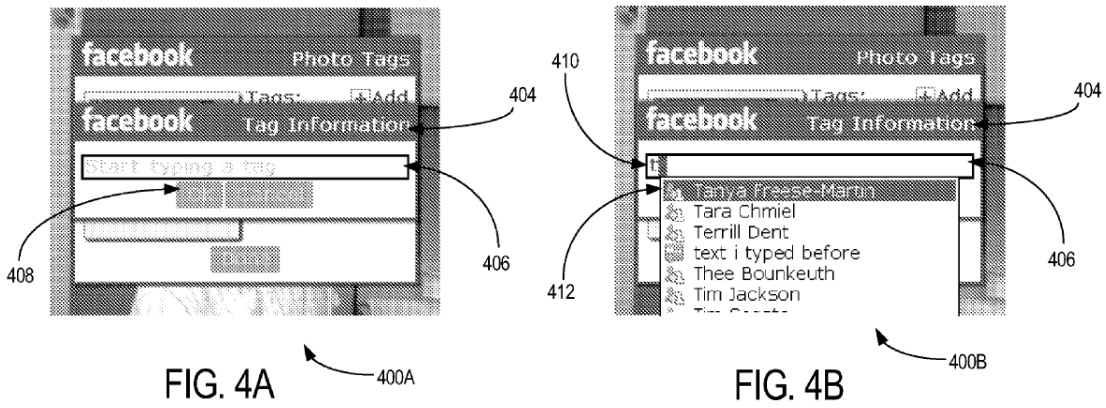
B. The '173 Patent

The '173 patent relates to a "user interface for selecting a photo tag" to associate with a digital photograph, for example, in a social networking or photo sharing application. Ex. 1001, 1:15–23. The patent recognizes the existence of prior art methods for tagging digital photographs, but explains that an improved user interface is needed because "[s]electing a 'tag' to associate with an identified point in a photograph can be a complicated task if there are many potential tags to choose from," and "common techniques used on desktops and laptops with full sized screens do not work as well" on smaller wireless mobile devices. *Id.* at 1:23–32. To this end, the '173 patent discloses a

> user interface [that] embodies a method of selecting a photo tag for a tagged photo, comprising: providing a tag entry field for entering a photo tag; in dependence upon a string entered by a user, displaying in a matching tag list any tags from one or more selected tag sources matching the entered string. The method may further comprise displaying a tag type for each tag appearing in the matching tag list. The method may further comprise allowing user selection of a tag in the matching tag list to complete the tag entry field.

Id. at Abstract.

Figures 4A and 4B of the '173 patent, reproduced below, depict an exemplary user interface in accordance with the claimed invention. Ex. 1001, 1:43–44.



Referring to Figure 4A, the '173 patent explains that the tag selection user interface presents the user "with a tag entry field 406 indicating that he should start typing a tag." *Id.* at 5:32–37.

> [A]s the user begins to type, photo tag selection module 148B may be configured to search one or more selected "tag sources" for tags that match the currently entered text. As shown by way of illustration in screen 400B of FIG. 4B, these tag sources could include, for example, a list of friends from an online service like Facebook™, a list of contacts from the user's address book 142, a list of the user's browser bookmarks (in Internet browser 138), a cache of recent free-form text entries, etc.

Id. at 5:39–47. The '173 patent further explains that

> photo tag selection module 148B may be configured to display any matching tags . . . from one of the tag sources to the tag being typed by the user in the tag entry field 406 in a matching tag list 412. Each tag may have an icon or some other visual identifier associated with it that clearly indicates its type, and allows the user to quickly distinguish between different types of tags.

Id. at 5:49–55. According to the patent, similar to "tag sources," "tag types could include a free-form alphanumeric string, Facebook™ friends, address book entries (in address book 142), browser bookmarks (in Internet browser module 138), etc." *Id.* at 4:46–50.

C. Challenged Claims

Petitioner challenges claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18 of the '173 patent. Claims 1, 7, and 13 are independent. Claim 1 is representative, and is reproduced below:

> 1. A method of selecting a photo tag for a tagged photo, comprising:
>
> displaying a tag list including tags from one or more tag sources matching a search string;
>
> displaying a tag type indicator for each tag appearing in the tag list, said tag type being indicative of a tag source associated with the tag.

Ex. 1001, 9:14–21. Independent claims 7 and 13 respectively recite a "system" and "computer readable medium" for performing the method of claim 1. *Id.* at 9:34–41, 10:13–21.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 4–5):

Ground	Claims	Basis	References
1	1, 2, 4, 6–8, 10, 12–14, 16, 18	§ 103	MacLaurin[1]
2	2, 8, 10, 14, 16	§ 103	MacLaurin and Ortega[2]
3	1, 2, 4, 6–8, 10, 12–14, 16, 18	§ 103	MacLaurin and Rothmuller[3]
4	2, 8, 10, 14, 16	§ 103	MacLaurin, Rothmuller, and Ortega

[1] MacLaurin, US 7,831,913 B2, issued Nov. 9, 2010 (Ex. 1006).

[2] Ortega, US 6,564,213 B1, issued May 13, 2003 (Ex. 1007).

[3] Rothmuller, US 7,415,662 B2, issued Aug. 19, 2008 (Ex. 1004).

Ground	Claims	Basis	References
5	1, 2, 4, 6–8, 10, 12–14, 16, 18	§ 103	MacLaurin and Plotkin[4]
6	2, 8, 10, 14, 16	§ 103	MacLaurin, Plotkin, and Ortega

Petitioner relies on the Declaration of Dr. Sandeep Chatterjee, Ph.D. (Ex. 1002) to support its patentability challenge.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art at the time of invention of the '173 patent "would have possessed at least a bachelor's degree in software engineering, computer science, computer engineering, or electrical engineering with at least two years of experience in software application development, including graphical user interface development (or equivalent degree or experience)." Pet. 9 (citing Ex. 1002 ¶¶ 12–15). Patent Owner does not address the requisite level of skill in its Preliminary Response.

For purposes of this decision, we adopt Petitioner's presently undisputed definition of the level of ordinary skill in the art, as it is consistent with the level of skill in the art reflected in the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

[4] Plotkin, *How to Do Everything with Photoshop Elements 4.0* (Ex. 1008).

B. Claim Construction

In this *inter partes* review proceeding, the claims of the patent are construed using the same standard used in federal district court, including construing the claim in accordance with the ordinary and customary meaning of the claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b); 83 Fed. Reg. 51358 (Oct. 11, 2018) (amending the claim construction standard for trial proceedings before the Board). At this stage in the proceeding, although Petitioner presents alternative grounds of unpatentability to account for various claim interpretations Patent Owner might advance, neither party seeks express construction of any claim term. *See* Pet. 12 ("For purposes of the prior art cited herein, Petitioner does not, at this time, contend that any term requires express construction."); *id.* at 13 ("As noted, the other grounds are presented primarily in the event of narrow claim construction positions the Patent Owner may raise during these proceedings, or strained readings of the MacLa[u]r[i]n reference the Patent Owner may advance."); *see generally* Prelim. Resp.

For purposes of this decision, we interpret the challenged claims in accord with their ordinary meaning to one skilled in the art at the time of invention, in light of the teachings of the specification and the prosecution history, and do not find it necessary to provide any express claim constructions. In reaching this conclusion we observe that the parties do not dispute the meaning of the challenged claims, and our decision to institute trial does not turn on the adoption of any particular claim construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d

1013, 1017 (Fed. Cir. 2017) (noting that "we need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy'") (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

C. Obviousness Grounds Based on MacLaurin

Petitioner contends that claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18 are rendered obvious by MacLaurin alone, or in combination with Rothmuller or Plotkin, and/or Ortega. Pet. 24–67. To support its contentions, Petitioner cites to Dr. Chatterjee's declaration testimony (Ex. 1002).

Patent Owner disagrees and asserts that the MacLaurin grounds fail to teach or suggest "displaying a tag type indicator . . . indicative of a tag source." Prelim. Resp. 28–36. Patent Owner additionally argues that the MacLaurin grounds fail to teach or suggest "displaying a tag list including tags." *Id.* at 36–43.

1. Overview of the Asserted References

a. MacLaurin

MacLaurin describes "systems and methods for tagging items"—including digital pictures—"based on user selections of items." Ex. 1006, 2:40–41, 2:2–7. Of particular relevance here, MacLaurin discloses a "light 'tagging mode'" having the following characteristics:

> display a special icon and/or text message indicating that tagging is active
>
> accumulate each key a user types into a "tag buffer"
>
> use this tag buffer to guess at likely tags

> display the current "best guess" tag in a textual readout associated with the window
>
> allow a user to choose between "tag guesses" using cursor arrows
>
> allow a user to choose whether to accept guesses or simply use the buffer as is
>
> if a user hits the escape key (or similar), exit tagging mode
>
> if the user hits the enter/return key (or similar), apply the items to the tag

Ex. 1006, 8:4–18.

MacLaurin teaches that "[t]he tagging system can contain both automatic tags generated by the tagging system and explicit tags from a user. By distinguishing between the two types of tags easily, a user can be alerted to their confidence level with regard to the tags." Ex. 1006, 7:48–51. More specifically, MacLaurin discloses that "if an automated tag and an explicit tag (one entered by a user) are both presented to the user, each type of tag can be distinguished utilizing different sizes, fonts, colors, and/or symbols and the like." *Id.* at 8:19–25.

b. Ortega

Ortega describes "methods for assisting users in efficiently entering search queries." Ex. 1007, 1:5–6. In particular, Ortega teaches a method for "suggesting autocompletion strings (terms and/or phrases) to users during the query entry process, wherein the suggested strings are based on specific attributes of the particular database access system being searched." *Id.* at 1:66–2:3. Figure 2A of Ortega, depicting an exemplary user interface for use by an autocompletion client, is reproduced below. *Id.* at 5:23–25.

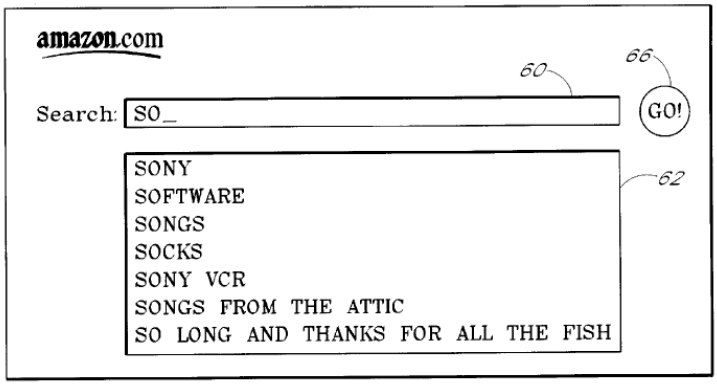


FIG. 2A

As illustrated in Figure 2A, "as the user enters a search query into a search field 60 of the Amazon.com web site (by voice, stylus, etc.), the autocompletion client displays suggested autocompletion terms and phrases in a drop-down box 62." *Id.* at 5:25–29. Ortega additionally explains that "once the user has completed a term, the autocompletion client may only display suggested phrases." *Id.* at 5:34–36.

c. Rothmuller

Rothmuller describes an apparatus and methods for managing digital media using tags. Ex. 1004, Abstract. More specifically, Rothmuller discloses "methods for associating ('tagging') fields of text and numeric data ('metadata') with individual objects such as images or photos, storing the objects and associated metadata as records in a relational database, and selecting, sorting, organizing and finding the objects based on their tagged metadata content." *Id.* at 1:57–62. Rothmuller further explains that

> [d]efault metadata tags can be specified, and new metadata tags can be defined and created through a tag editor by naming the tag, selecting its tag type, optionally selecting a graphical icon that represents the tag, and filling in any remaining fields or attributes that are unique to and define the tag type.

Id. at 1:63–67.

Figure 1 of Rothmuller, depicting an exemplary user interface for the disclosed photo tagging system, is reproduced below. Ex. 1004, 3:3–5.

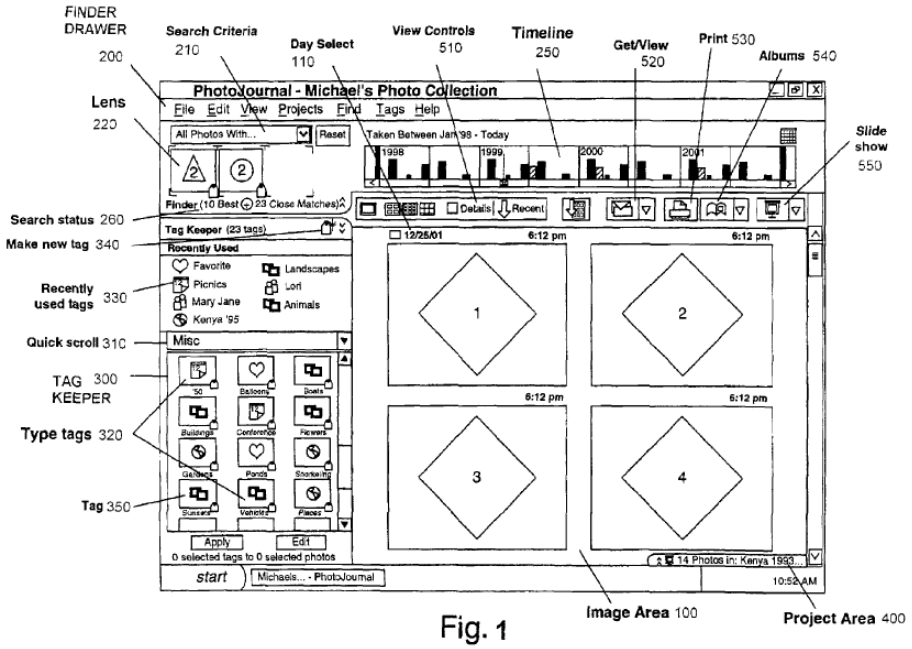


Fig. 1

As illustrated in Figure 1, Rothmuller explains that "tags 350 can be applied to photos by dragging and dropping graphical icons representing the tags onto one or more photos 1–4 that are displayed in an image area 100." *Id.* at 3:36–39.

Rothmuller discloses also that tags can be created and modified using a "tag editor." Ex. 1004, 3:51–52.

> The tag editor allows a user to specify a tag name and tag type, and to enter metadata in the form of tag attributes that can be stored in tags of the specified tag type. For convenience, tags can be divided into one or more tag categories. For example, in one embodiment tags are divided into people, events, places and miscellaneous tag categories. Tags in the different tag categories generally have different tag attributes to distinguish between themselves and tags in other tag categories.

Id. at 3:52–60.

Rothmuller incorporates by reference U.S. Provisional Patent Application No. 60/334,516, filed October 31, 2001 (Ex. 1005; "Rothmuller Provisional"). Ex. 1004, 1:14–17. Rothmuller Provisional explains that

> [t]he recent tag area keeps a set of recently used tags. In a preferred embodiment, the Favorite Tag is always maintained in this area at the top. The state of this area is preserved between Photo Journal sessions. Tags are displayed using small tag type icons and the tag name.

Ex. 1005, 68. The description of the recent tag area in Rothmuller Provisional is consistent with the "recently used tags 330" list depicted in Figure 1 of Rothmuller. As seen in Figure 1, Rothmuller discloses associating icons with tags. Ex. 1004, Fig. 1. For example, icons depicting block figures resembling people are associated with the tags for "Mary Jane" and "Lori." *Id.*

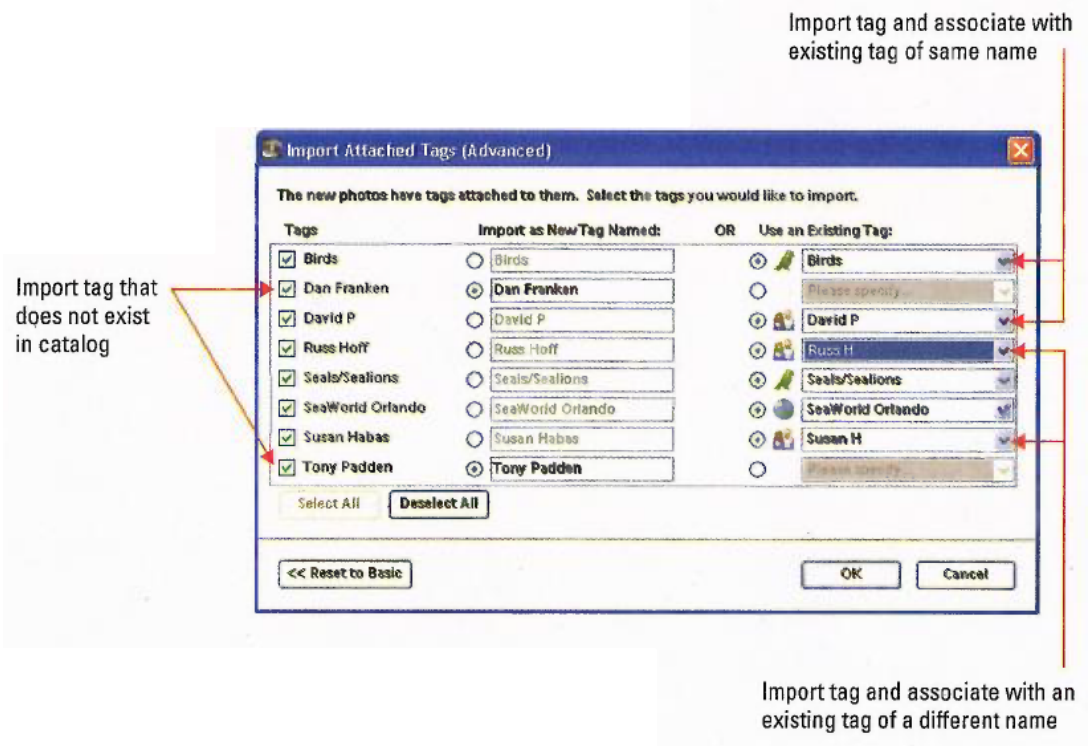
d. Plotkin

Plotkin describes the photo tagging features of Adobe Photoshop Elements, version 4, a commercial software program. Ex. 1008, xix, 321–346. Plotkin explains that in Adobe Photoshop Elements "[t]ags and collections give you ways to assign keywords to images and to group them together in virtual folders. You can also search for images by tag, collection, and other criteria." *Id.* at 322.

Plotkin discloses that "[c]ategories, subcategories, and tags form a hierarchy [in Adobe Photoshop Elements]. At the top of the heap is the category. . . . Subcategories are the-next layer. . . . Tags are at the lowest (most atomic) level, and are typically used for keywords or phrases."

Ex. 1008, 323. Plotkin further explains that although the software automatically provides several base categories, including favorites, people, places, and events, a user can create additional categories, and specify particular subcategories and tags. *Id.* at 322–323.

Plotkin discloses that each tag category has an associated icon, and that the category icon may be displayed alongside the category, as well as alongside tags falling within that category. Ex. 1008, 323, 325. For example, Plotkin includes a screenshot from Adobe Photoshop Elements, version 4, reproduced below, in which category icons are displayed next to tag.



Id. at 328. As depicted in the Adobe Photoshop Elements screenshot shown in Plotkin, the icon for the "people" category appears next to the tags for

various people, including, for example, "Russ H," and the icon for the "places" category appears next to the tag for "SeaWorld Orlando." *Id.*

2. Analysis

Petitioner asserts that independent claims 1, 7, and 13 are rendered obvious by MacLaurin alone, or in combination with Rothmuller or Plotkin.[5] Pet. 24–40, 46, 49, 55–67. Because claims 7 and 13 respectively recite a "system" and "computer readable medium" for performing the method of claim 1, we, like the parties, focus our discussion on claim 1.[6]

Petitioner contends that MacLaurin teaches "[a] method of selecting a photo tag for a tagged photo" (Ex. 1001, 9:14–15), as recited in the preamble of claim 1. Pet. 24–28. Specifically, Petitioner asserts that MacLaurin discloses a user interface for tagging computer files, including digital photographs, with multiple tags, and suggests reasons for applying additional tags to a photograph that has already been tagged. *Id.* (citing, *inter alia*, Ex. 1002 ¶¶ 63, 65–67; Ex. 1006, 2:1–5, 6:42–44, 6:53–58, 6:62–67, 7:66–8:18, Fig. 8).

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[5] Petitioner also details how each limitation of dependent claims 2, 4, 6, 8, 10, 12, 14, 16, and 18 is met by the disclosures of MacLaurin alone, or in combination with Rothmuller or Plotkin, and/or Ortega. *See* Pet. 40–67. At this stage of the proceeding, Patent Owner has not addressed claims 2, 4, 6, 8, 10, 12, 14, 16, and 18 individually for any of the asserted grounds. *See generally* Prelim. Resp. Accordingly, we focus our analysis on the independent claims.

[6] Because the relevant elements of claims 1, 7, and 13 are identical, and the parties argue the claims together, for readability, we provide citations only to claim 1.

Petitioner also contends that MacLaurin teaches the claim 1 requirement for "displaying a tag list including tags from one or more tag sources matching a search string" (Ex. 1001, 9:16–17). Pet. 28–34. For example, Petitioner points to MacLaurin's disclosure that the tagging component can use the user interface to detect when a user is typing and "attempt guesses for possible tag suggestions for the user" that "mimic the characters disclosed up to that point" as teaching that "MacLaurin can receive partially-entered tag input (a 'search string') from the user and provide a list of possible tag suggestions ('tag list')." Pet. 28–29 (quoting Ex. 1006, 5:25–37) (emphasis omitted). Petitioner also identifies MacLaurin's teaching that "the selection-based tagging component 102 can respond with tag suggestions that utilize each character that the user 104 types into a keyboard, providing a list of tag suggestions that utilize at least some of the typed characters" as supporting its position. *Id.* (quoting Ex. 1006, 4:42–48) (emphasis omitted). Relying on Dr. Chatterjee, Petitioner further contends that an ordinarily skilled artisan would have recognized MacLaurin's "light 'tagging mode,'" described in Part II.C.1.a., above, as suggesting the presentation of tag suggestions in a tag list in response to a search string entered by a user. *Id.* at 30 (citing Ex. 1002 ¶ 70; Ex. 1006, 7:66–8:26). In this regard, Petitioner points out that MacLaurin expressly discloses that its "light 'tagging mode'" "allow[s] a user to choose between 'tag guesses' using cursor arrows," and explains that the ability to move between tag guesses using cursor arrows "would have clearly suggested the existence of a list." *Id.* (quoting Ex. 1006, 7:66–8:22; citing Ex. 1002 ¶ 70).

As to the requirement that the tag list must include "tags from one or more tag sources" (Ex. 1001, 9:16–17), Petitioner provides two distinct explanations regarding how MacLaurin discloses this claim element. Petitioner first contends that MacLaurin teaches two "tag sources" in the form of: "(1) a stored collection of 'automatic' tags; and (2) a stored collection of 'explicit' tags." Pet. 31. Petitioner identifies the following passage from MacLaurin as supporting its position:

> The tagging system can contain both automatic tags generated by the tagging system and explicit tags from a user. By distinguishing between the two types of tags easily, a user can be alerted to their confidence level with regard to the tags. A user may have high confidence in their explicit tags and lesser confidence in system generated tags.

Id. (quoting Ex. 1006, 7:48–53). Relying on Dr. Chatterjee, Petitioner reasons that "[a] person of ordinary skill would therefore have understood and found it obvious that 'automatic tags' refer to a collection of tags automatically generated by the system (and subsequently stored), and 'explicit tags' refer to a collection of tags defined and stored by the user." *Id.* at 32 (citing Ex. 1002 ¶ 74). Petitioner additionally asserts that MacLaurin teaches including tags from one or more tag sources in the tag list because

> MacLaurin discloses, in the context of a "light 'tagging mode'" (MacLaurin, 7:66–8:3), that "if an automated tag and an explicit tag (one entered by a user) are both presented to the user, each type of tag can be distinguished utilizing different sizes, fonts, colors, and/or symbols and the like." (MacLaurin, 8:19–23.)

Id. at 33.

Petitioner also argues that MacLaurin's disclosure of "internal" and "external" tag sources satisfies the requirement that the tag list must include "tags from one or more tag sources" (Ex. 1001, 9:16–17). Pet. 33–34. According to Petitioner,

> MacLaurin discloses use of "external tag sources," e.g., an "attorney tag list" obtained from the Internet and a "medical profession tag set" retrieved from an online service. These external tag sources thus provide a separate basis from the internal "automatic" and "explicit" tag sources for meeting the "tag source" limitation. (Chatterjee, ¶¶77–78.)

Pet. 34 (emphasis omitted).

Claim 1 further calls for "displaying a tag type indicator for each tag appearing in the tag list, said tag type being indicative of a tag source associated with the tag." Ex. 1001, 9:18–20. Petitioner asserts that MacLaurin alone, or in combination with either of Rothmuller or Plotkin, meets this claim requirement. Pet. 35–40, 55–67.

Petitioner first points to MacLaurin's teaching "that 'if an automated tag and an explicit tag (one entered by a user) are both presented to the user, each type of tag can be distinguished utilizing different sizes, fonts, colors, and/or symbols and the like'" as suggesting this claim element. Pet. 37 (quoting Ex. 1006, 8:19–23). According to Petitioner, in view of this and related teachings, an ordinarily skilled artisan would have understood that "MacLaurin would have involved the display of a tag type indicator for each tag presented to the user; otherwise the system could not visually convey to the user whether each suggested tag was an explicit or automatic tag." *Id.* (citing Ex. 1002 ¶ 82) (emphasis omitted). Petitioner further reasons that, as explained above, that each "tag type" disclosed by MacLaurin corresponds

to a particular "tag source," and, thus, "[e]ach tag type in MacLaurin [] serves as an indication and is suggestive of the source from which tags of that tag type originated." *Id.* at 38.

Petitioner separately asserts that

> Although MacLaurin discloses a tag type indicator in the context of "automatic" and "explicit" tags, MacLaurin's stated motivation – to allow the user to visually distinguish one type of tag from another (MacLaurin, 7:49-51, 8:20-23) – would have been understood by persons of ordinary skill to apply to other types of tags as well. (Chatterjee, ¶¶85, 100.) That same rationale would therefore have motivated a person of ordinary skill to provide tag type indicators for different "external" tag types. (*Id.*)

Pet. 40.

Petitioner also asserts that the combination of MacLaurin and Rothmuller teaches "displaying a tag type indicator for each tag appearing in the tag list, said tag type being indicative of a tag source associated with the tag" (Ex. 1001, 9:18–20). Pet. 55–60. Relying on the aspects of MacLaurin discussed above, Petitioner identifies Rothmuller as teaching displaying a tag type indicator with each tag appearing in the tag list. *Id.* In particular, Petitioner points to Rothmuller's teaching that "[t]ags are displayed using small tag type icons and the tag name." *Id.* at 56 (quoting Ex. 1005, 68) (emphasis omitted). Petitioner further asserts that an ordinarily skilled artisan would have sought to combine MacLaurin and Rothmuller based on MacLaurin's teachings that "each type of tag can be distinguished utilizing different sizes, fonts, colors, and/or symbols and the like" and "[b]y distinguishing between the two types of tags easily, a user can be alerted to their confidence level with regard to the tags." *Id.* at 59–60 (quoting

Ex. 1006, 8:19–23, 7:48–51). According to Petitioner, MacLaurin "expressly provides a motivation a person of ordinary skill would have had to adapt its tag list to show a separate tag type indicator for each tag – to allow the user to easily distinguish each tag in the tag list from the other tags based on its tag type." *Id.* at 60 (citing Ex. 1002 ¶ 99). In this regard, Petitioner points to MacLaurin's disclosure that "automatic" and "explicit" tags may not have equal weight to a user as further supporting the proposed combination. *Id.* (citing Ex. 1002 ¶ 99). Petitioner additionally reasons that "[t]his motivation is not limited to distinguishing between 'automatic' and 'explicit' tags – it applies equally to distinguishing between tags from different 'external' tag sources." *Id.* (citing Ex. 1002 ¶¶ 85, 100).

Petitioner's arguments concerning the combination of MacLaurin and Plotkin closely mirror those asserted as to the aforementioned combination of MacLaurin and Rothmuller. *Compare* Pet. 61–67 *with id.* at 55–61. Specifically, Petitioner asserts that Plotkin discloses an embodiment in which a tag category icon is shown next to each tag in a tag list. *Id.* at 63–64 (citing Ex. 1008, 328). Petitioner contends that the same "motivations for adapting MacLaurin's tag list to include tag type indicators" discussed above concerning the combination of MacLaurin and Rothmuller apply to the combination of MacLaurin and Plotkin. *Id.* at 66. Petitioner further contends that "[g]iven the popularity of the Adobe product [described by Plotkin], market forces, in addition to the motivations already discussed, would have further encouraged a person of ordinary skill to adapt Plotkin's tag type indicators to the tag list in MacLaurin." *Id.* (citing Ex. 1002 ¶ 110). Petitioner also argues that Plotkin's disclosure of using tag type indicators

"in the context of importing tags into the system . . . confirms that the advantages of using tag type indicators in a tag list (*e.g.*, the ability to quickly distinguish tags based on their tag type) are applicable to a broad range of user interfaces." *Id.* at 67 (citing Ex. 1002 ¶ 111).

Based on our review of the current record, we agree at this juncture with Petitioner's characterization of the teachings of MacLaurin, Rothmuller, and Plotkin, as well as with Petitioner's assertions as to the reasonable inferences an ordinary artisan would have made from those references. We address Patent Owner's arguments below.

Patent Owner asserts that Petitioner's obviousness arguments fail because MacLaurin does not teach or suggest displaying "a tag list including tags from one or more tag sources matching a search string" (*see, e.g.*, Ex. 1001, 9:16–17), as required by the challenged claims. Prelim. Resp. 36–43. At this stage of the proceeding, based on the limited record before us, we do not agree with Patent Owner's narrow reading of MacLaurin, or its characterization of Petitioner's obviousness arguments.

Although Patent Owner is correct that Figure 8 of MacLaurin depicts only one "best-guess" tag, rather than a list of several such tags (Prelim. Resp. 38), Petitioner's reliance on MacLaurin is not so limited. Rather, Petitioner identifies several other disclosures in MacLaurin as teaching or suggesting displaying tags matching a search string in a tag list. Pet. 28–31. For example, Petitioner points to MacLaurin's disclosure that "the selection-based tagging component 102 can respond with tag suggestions that utilize each character that the user 104 types into a keyboard, providing a list of tag suggestions that utilize at least some of the typed characters" as supporting

its obviousness argument. *Id.* at 29 (quoting Ex. 1006, 4:42–48). Petitioner additionally identifies MacLaurin's "light 'tagging mode'" as teaching or suggesting display of the recited list. *Id.* at 29–30 (quoting Ex. 1006, 7:66–8:22; citing Ex. 1002 ¶ 70).

Based on the current record, we find Petitioner's arguments persuasive. First, Petitioner's explanation that MacLaurin's "light 'tagging mode'" accumulates user key strokes in a "tag buffer" that is used to "guess at likely tags," and "allow[s] a user to choose between 'tag guesses' using cursor arrows" is based directly on MacLaurin's express teachings, and is, therefore, credible. Pet. 30 (quoting Ex. 1006, 8:2–12) (emphasis omitted). In addition, relying on Dr. Chatterjee's testimony, Petitioner persuasively argues that the above teaching of MacLaurin, and in particular the statement "that the user can choose between 'tag guesses' using cursor arrows," "would have clearly suggested the existence of a list." *Id.* (quoting Ex. 1006, 8:11–12; citing Ex. 1002 ¶ 70) (citations omitted). We are likewise persuaded, for purposes of this Decision, by Petitioner's argument that MacLaurin's disclosure of a tagging component that, based on user input, can provide a list of possible tag suggestions, buttresses the contention that an ordinarily skilled artisan would have recognized MacLaurin's "light 'tagging mode'" to teach or suggest displaying the disclosed "tag guesses" in a list. *Id.* at 30–31 (quoting Ex. 1006, 4:44–47, 5:31–33). In making this determination, we note our disagreement with Patent Owner's characterization of Petitioner's analysis as "conclusory." Prelim. Resp. 42. To the contrary, as outlined above, Petitioner, relying on Dr. Chatterjee, provides persuasive reasons why an ordinarily skilled artisan would have

recognized MacLaurin's "light 'tagging mode'" to suggest displaying "a tag list including tags from one or more tag sources matching a search string" (*see, e.g.*, Ex. 1001, 9:16–17), as required by the challenged claims.

Second, Patent Owner's assertion that "MacLaurin's 'tagging component' does not provide any 'tag suggestion(s)' to the user—only the 'user interface' presents information to a 'user'" (Prelim. Resp. 40), is inapposite. Even were Patent Owner correct that an ordinarily skilled artisan would have understood MacLaurin to teach that the "tagging component" merely provides "tag suggestions" to the "user interface" for further processing, Patent Owner's argument ignores Petitioner's reliance on MacLaurin's teachings concerning the "selection-based tagging component," of which, as Patent Owner acknowledges, the "tagging component" and "user interface" are each a part. *Id.* at 39 ("MacLaurin's 'selection-based tagging component' consists of two components: 'user interface 208' and 'tagging component 210.'"). As Petitioner explains, MacLaurin discloses that

> the selection-based tagging component 102 can respond dynamically to the user's input and relay tag suggestions as the user 104 provides inputs. For example, the selection-based tagging component 102 can respond with tag suggestions that utilize each character that the user 104 types into a keyboard, providing a list of tag suggestions that utilize at least some of the typed characters.

Pet. 29 (quoting Ex. 1006, 4:42–48). In view of this disclosure, we agree, for purposes of this Decision, with Petitioner's assertion that "[t]he system in MacLaurin can receive partially-entered tag input . . . from the user and provide a list of possible tag suggestions." *Id.* at 28.

We likewise find unavailing Patent Owner's contention that Petitioner has "overlooked that MacLaurin's tagging mode displays only a single 'best guess' tag" (Prelim. Resp. 42), as it is inconsistent with MacLaurin's express disclosure that the "light 'tagging mode'" "allow[s] a user to choose between 'tag guesses' using cursor arrows." Pet. 30 (quoting Ex. 1006, 8:2–12). Similarly, we are unconvinced by Patent Owner's argument that Petitioner fails to explain why "one of ordinary skill would deviate from MacLaurin's express teaching of a single 'best guess' tag in order to enforce consistent tag use." Prelim. Resp. 42. First, as explained above, we are persuaded by Petitioner's showing that MacLaurin explicitly discloses allowing a user to select among several "tag guesses" in the "light 'tagging mode,'" and, thus, conclude, based on the limited record before us, that Patent Owner's premise is mistaken. Pet. 30 (quoting Ex. 1006, 8:2–12). Second, Patent Owner does not identify, and we do not discern any teaching by MacLaurin that a single best guess tag should be presented to "enforce" consistent usage. Indeed, as discussed in greater detail, below, MacLaurin expressly contemplates that in the "light 'tagging mode,'" a situation may arise in which "an automated tag and an explicit tag (one entered by a user) are both presented to the user." Ex. 1006, 8:2–23; *see also* Pet. 29–30 (quoting the same). In this scenario, MacLaurin explains, "each type of tag can be distinguished utilizing different sizes, fonts, colors, and/or symbols and the like." Ex. 1006, 8:20–23; *see also* Pet. 30 (quoting the same). Accordingly, based on the current record, we determine that Petitioner has adequately shown, for purposes of this Decision, that MacLaurin teaches or suggests displaying "a tag list including tags from one or more tag sources matching a

search string" (*see, e.g.*, Ex. 1001, 9:16–17) as required by the challenged claims.

Patent Owner additionally argues that MacLaurin fails to disclose displaying "a tag type indicator . . . indicative of a tag source" as required by the challenged claims.[7] Prelim. Resp. 29–36. In particular, Patent Owner asserts that Petitioner improperly conflates two different "modes" purportedly taught by MacLaurin, a "tagging mode" and a "browsing mode," in making its obviousness argument. *Id.* at 29–30. According to Patent Owner,

> Petitioner relies on MacLaurin's tagging mode for the "matching a search string" limitation, while relying on MacLaurin's browsing mode for parts of the "displaying a tag type indicator . . . indicative of a tag source" limitation. Therefore, Petitioners' entire contention that MacLaurin discloses or renders obvious "displaying a tag type indicator . . . indicative of a tag source" rests on an incorrect interpretation of MacLaurin. Moreover, Petitioner cannot inadvertently combine two different modes in this manner without performing the required obviousness analysis.

Id. at 33.

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[7] As Petitioner points out, it is unclear whether the challenged claims intend to refer to "said tag type" indicating a tag source, as written, or "said tag type indicator" indicating a tag source, as the claims include an antecedent basis for "said tag type indicator" but not for "said tag type." Pet. 38, n. 10. Nevertheless, we also agree with Petitioner that, for purposes of this Decision, in view of Petitioner's mapping of the asserted art to the challenged claims, either understanding of the claims leads to the same result. *Id.* To the extent Patent Owner contends that the interpretation of "said tag type indicating" bears on our patentability analysis, Patent Owner is requested to further brief the issue during trial.

Based on the current record, we do not agree with Patent Owner's characterization of Petitioner's arguments or MacLaurin's teachings. Patent Owner's contention that Petitioner improperly conflates different embodiments disclosed by MacLaurin is predicated on a narrow reading of MacLaurin that does not adequately account for MacLaurin's disclosures of a "tagging system" in general, and a "light 'tagging mode'" in particular. As set forth by Petitioner, MacLaurin expressly discloses a "tagging system" that "can contain both automatic tags generated by the tagging system and explicit tags from a user." Pet. 31 (quoting Ex. 1006, 7:48–49) (emphasis omitted). In addition, as Petitioner explains (Pet. 29–30), MacLaurin describes its "light 'tagging mode'" as follows:

> if the user has selected one or more items utilizing the user interface and begins to type, a light "tagging mode" can be entered with the following characteristics:
>
> display a special icon and/or text message indicating that tagging is active
>
> accumulate each key a user types into a "tag buffer"
>
> use this tag buffer to guess at likely tags
>
> display the current "best guess" tag in a textual readout associated with the window
>
> allow a user to choose between "tag guesses" using cursor arrows
>
> allow a user to choose whether to accept guesses or simply use the buffer as is if a user hits the escape key (or similar), exit tagging mode if the user hits the enter/return key (or similar), apply the items to the tag
>
> In addition, if an automated tag and an explicit tag (one entered by a user) are both presented to the user, each type of tag

> can be distinguished utilizing different sizes, fonts, colors, and/or symbols and the like.

Ex. 1006, 7:67–8:23. In view of the above disclosures by MacLaurin, we are persuaded, based on the current record, by Petitioner's contention that MacLaurin teaches, "in the context of a 'light 'tagging mode,'' that 'if an automated tag and an explicit tag (one entered by a user) are both presented to the user, each type of tag can be distinguished utilizing different sizes, fonts, colors, and/or symbols and the like.'" Pet. 33 (citing Ex. 1006, 7:66–8:3; quoting *id.* at 8:19–23) (internal citations omitted).

Patent Owner's arguments based on the embodiment of MacLaurin depicted in Figure 8 of that reference do not dictate a different result. Although Patent Owner's assessment that Figure 8 of MacLaurin depicts only "a single 'best guess' suggested tag in plain, bracketed font" (Prelim. Resp. 32), appears to be correct based on the black and white rendering of that figure provided by MacLaurin, Figure 8 is not dispositive of our analysis, because, as detailed above, Petitioner relies on other aspects of MacLaurin to support its unpatentability arguments. Furthermore, contrary to Patent Owner's implication, MacLaurin does not identify Figure 8 as the only embodiment of the disclosed tagging system. Rather, subsequent to describing the aforementioned "light 'tagging mode,'" MacLaurin explains that "[a]dditional examples of user interfaces are shown in in FIGS. 4–8" (Ex. 1006, 8:30–31), indicating that Figure 8 represents but one exemplary embodiment of MacLaurin's tagging system.

Because they are likewise predicated on the contention that Petitioner improperly conflates different "modes" purportedly described by

MacLaurin, we similarly find Patent Owner's remaining arguments concerning the adequacy of Petitioner's showing that the asserted grounds of unpatentability teach or suggest displaying a tag type indicator indicative of a tag source unavailing. *See* Prelim. Resp. 34–36.

Based on the foregoing, therefore, we conclude that Petitioner has established a reasonable likelihood that it would prevail on its assertion that claim 1 of the '173 patent is unpatentable based on MacLaurin alone, or in combination with Rothmuller or Plotkin.

D. Patent Owner's Request for Discretionary Denial

Patent Owner argues that the Petition should be denied under either 35 U.S.C. § 325(d) or 35 U.S.C. § 314(a) because it "is redundant of" the petition in the '516 IPR. Prelim. Resp. 22–23. In particular, Patent Owner asserts that the instant Petition "challenges the same claims of the same patent using the same arguments largely based on the same alleged prior art" as the petition in the '516 IPR. *Id.*

We do not agree that the referenced petitions are redundant or that discretionary denial is warranted. Although there is overlap between the individual references asserted, the two petitions concern different prior art combinations and advance persuasive—and distinct—unpatentability arguments. For example, Zuckerberg[8] is central to Petitioner's arguments as to five out of the seven grounds of unpatentability asserted in the '516 IPR, including the sole single reference obviousness ground, but is not asserted,

[8] Zuckerberg, US 7,945,653 B2, issued May 17, 2011.

even as a secondary reference, in the instant proceeding. *Compare* Pet. 4–5 *with* '516 IPR, Paper 2, 4–5. Similarly, Matthews,[9] which is asserted in each of the two remaining grounds at issue in the '516 IPR is excluded from this proceeding. *Compare* Pet. 4–5 *with* '516 IPR, Paper 2, 4–5. In addition, even though both petitions assert MacLaurin, each petition utilizes MacLaurin for a different purpose. For example, MacLaurin is identified only as supplying a reason to combine Zuckerberg with each of Rothmuller and Plotkin in the '516 IPR, but features as the primary reference in this proceeding, and is the basis for the lone single-reference obviousness ground presented in this case. *Compare* Pet. 4–5 *with* '516 IPR, Paper 2, 4–5. Moreover, contrary to Patent Owner's characterization, Petitioner does not "treat Zuckerberg and MacLaurin interchangeably." Prelim. Resp. 25. Quite the opposite, in the '516 IPR, Petitioner relies on MacLaurin to supply the motivation to combine Zuckerberg with each of Rothmuller and Plotkin, and explains that MacLaurin teaches what Zuckerberg does not: using "sizes, fonts, colors, and/or symbols" to distinguish "each type of tag" presented to a user. '516 IPR, Paper 2, 42–43; *see also* Pet. 2, 35–40. Thus, although MacLaurin is asserted in both petitions, we do not consider the petitions redundant.

Given the distinct combinations presented and arguments made in two petitions, the fact that they were filed just four days apart (Paper 6, 1; '516 IPR, Paper 5, 1), and the absence of any assertion that any of the cited

[9] Matthews, US 2006/0218503 A1, published. Sept. 28, 2006.

references were substantively addressed during prosecution (*see generally* Prelim. Resp.), we cannot agree with Patent Owner that "the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). Nor do we discern reason to deny institution based on the *General Plastic* factors. *See General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 15–16 (PTAB Sept. 6, 2017) (Paper 19) (precedential). The timing of the two petitions and the substantive differences between them allay any concerns relating to improper delay, improper reliance on Patent Owner's filings or the Board's decisions, or unnecessary strain on the Board's resources that are the focus of the *General Plastic* analysis. *See id.*

Although it issued subsequent to the parties' filings here, and less than one month prior to the deadline for issuance of this Decision, we are mindful of the guidance concerning parallel petitions challenging the same patent provided in recently issued Office Trial Practice Guide, July 2019 Update. Office Patent Trial Practice Guide, July 2019 Update, 84 Fed. Reg. 33,925 (July 16, 2019) ("Trial Practice Guide Update"), https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf. Even though it explains that parallel petitions challenging the same patent are generally disfavored, the Trial Practice Guide Update nevertheless recognizes that there may be circumstances in which more than one petition may be necessary, and that the panel has discretion to review whether fairness warrants allowing parallel petitions by a single petitioner. Trial Practice Guide Update, 26. Here, Patent Owner has asserted claims of the '173 patent against Petitioner in related district court litigation (Pet. 2;

Paper 5, 2), and Petitioner provides alternative unpatentability arguments to account for different claim interpretations that may be advanced by Patent Owner or adopted by the Board. *See, e.g.*, Pet. 13 ("Because IPR proceedings are governed by the same claim construction standard as district courts (and the district court has provided no claim construction rulings), uncertainty exists as to how certain limitations may be interpreted."); *id.* ("the other grounds are presented primarily in the event of narrow claim construction positions the Patent Owner may raise during these proceedings"). Accordingly, because insufficient time remains in this proceeding to request, receive, and evaluate additional briefing as prescribed by the new guidance concerning parallel petitions, and in view of the strength of the arguments made in each petition, the substantive differences between them, the circumstances in the related district court litigation, and the fact that Petitioner provides different unpatentability arguments to account for different claim interpretations, we decline Patent Owner's request for discretionary denial of the Petition.

III. CONCLUSION

For the foregoing reasons, we determine that the Petition and evidence in this record at this stage establish that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. We therefore grant the Petition and institute trial as to all challenged claims on all grounds stated in the Petition. At this juncture, we have not made a final determination with respect to the patentability of the challenged claims, nor with respect to claim construction.

IV. ORDER

Accordingly, it is hereby:

ORDERED that *inter partes* review of claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18 of the ’173 patent is instituted on all grounds in the Petition; and

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

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