UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Facebook, Inc.,
Petitioner

v.

Silver State Intellectual Technologies, Inc.,
Patent Owner

U.S. Patent No. 7,343,165 B2
Issue Date: March 11, 2008

Title: GPS PUBLICATION APPLICATION SERVER

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,343,165 B2

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This is a petition for *Inter Partes* Review of claim 1 of U.S. Patent No. 7,343,165 B2 **[Ex. 1001]** ("'165 patent").

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8(A)(1)

A. Real Party-In-Interest under 37 C.F.R. § 42.8(b)(1)

Facebook, Inc. ("Petitioner") is the real party-in-interest to this *inter partes* review petition.

B. Related Matters under 37 C.F.R. § 42.8(b)(2)

The '165 patent, and related U.S. Patent No. 8,892,117 ("'117 patent"), are the subject of currently-pending litigation involving Petitioner: *Silver State Intellectual Technologies, Inc. v. Facebook Inc.*, 4:17-cv-03349-JSW (N.D. Cal.). On March 23, 2018, the court in that case granted Petitioner's motion for judgment on the pleadings, finding that the asserted claims of the '117 and '165 patents are invalid under 35 U.S.C. § 101 for lack of patent-eligible subject matter.

On November 18, 2013, Foursquare Labs, Inc. filed a petition for *inter partes* review of claims 1-5 and 7-9 of the '165 patent. *See* Paper 1, *Foursquare Labs, Inc. v. Silver State Intellectual Technologies, Inc.*, No. IPR2014-00159 (PTAB Nov. 13, 2013). IPR was instituted as to claim 1 only. *See* Paper 6, IPR2014-00159. On May 26, 2015, a Final Written Decision issued finding that FourSquare had failed to show that claim 1 was unpatentable. *See* Paper 28, IPR2014-00159.

The prior art asserted in this petition, along with the motivations to combine them, is entirely different from the prior art and motivations asserted in IPR2014-00159, and therefore warrants a new *inter partes* review proceeding for claim 1.

In addition, the '165 patent has been the subject of the following litigation in the District Court for the District of Nevada:

- *Silver State Intellectual Technologies, Inc. v. Foursquare Labs, Inc.*, 2:12-cv-01308-GMN-PAL (D. Nev.)
- *Silver State Intellectual Technologies, Inc. v. Garmin International, Inc.*, 2:11-cv-01578-GMN-PAL (D. Nev.)
- *Silver State Intellectual Technologies, Inc. v. TomTom, Inc.*, 2:11-cv-01581-PMP-PAL (D. Nev.)

Petitioner is concurrently filing a petition for *inter partes* review of the '117 patent.

C. Lead and Back-Up Counsel under 37 C.F.R. § 42.8(b)(3)

Petitioner provides the following designation of counsel.

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D. Service Information

This Petition is being served to the current correspondence address for the '165 patent, Klein, O'Neill & Singh, LLP, 16755 Von Karman Avenue, Suite 275, Irvine CA 92606. Petitioner consents to electronic service at the addresses provided above for lead and back-up counsel.

E. Power of Attorney

Filed concurrently in accordance with 37 C.F.R. § 42.10(b).

II. FEE PAYMENT - 37 C.F.R. § 42.103

This Petition requests review of one claim. A payment of $30,500 is submitted herewith, based on a $15,500 request and a post-institution fee of $15,000. This Petition meets the fee requirements of 35 U.S.C. § 312(a)(1). If additional fees are due at any time during this proceeding, the Director is hereby authorized to charge such fees to Cooley LLP's deposit account number 50-1283.

III. REQUIREMENTS FOR *INTER PARTES* REVIEW UNDER 37 C.F.R. §§ 42.104 AND 42.108

A. Grounds for Standing under 37 C.F.R. § 42.104(a)

Petitioner certifies that the '165 patent is available for *inter partes* review and that Petitioner is not barred or otherwise estopped from requesting *inter partes* review on the grounds identified herein.

B. Identification of Challenge under 37 C.F.R. § 42.104(b) and Statement of Precise Relief Requested

Petitioner respectfully requests that the Board initiate *inter partes* review of claim 1 on the following grounds:

Ground	Claims	Basis for Challenge
1	1	Unpatentable over Knowles **[Ex. 1003]** in view of Narayanaswami **[Ex. 1004]** and Falkenhainer **[Ex. 1005]** under 35 U.S.C. § 103(a)
2	1	Unpatentable over Knowles **[Ex. 1003]** in view of Narayanaswami **[Ex. 1004]**, Falkenhainer **[Ex. 1005]**, and Clapper **[Ex. 1006]** under 35 U.S.C. § 103(a)

Part VI below explains why the challenged claim is unpatentable based on these grounds. Submitted with the Petition is a Declaration of Stephen Gray **[Ex. 1002]** ("Gray"), a technical expert with decades of relevant technical experience. (Gray ¶¶1-9, Ex. A.)

IV. THE '165 PATENT

A. The Specification

The '165 patent, entitled "GPS Publication Application Server," states that it "relates generally to user mobile information systems, and more specifically to location identifiable user mobile communications systems." ('165, 1:13-15.)

The '165 patent acknowledges that mobile device use was "increasingly common" and that techniques (such as GPS) for a mobile devices to obtain its location were known. ('165, 1:16-17, 2:8-11.) It further treats server systems accessible over the internet as firmly in the prior art. ('165, 1:56-59.)

Using these known technologies and techniques, the specification of the '165 patent describes a system involving a "personal communication device (PCD) **11** [that] provides GPS receiver and wireless communication capability" that is connected to a server that stores "personalized information regarding points of interest and other matters provided by users of PCDs." ('165, 3:3-10, 3:20-21, 3:31-33, 3:37-40.) The server also receives GPS location information from the PCD.

('165, 3:16-19, 3:43-47, 3:62-4:1.) The information at the server is accessible to the PCD user and other individuals. ('165, 4:12-17, 5:53-61.)

B. Claim 1

Claim 1 is an independent claim and is listed below:

1. A method of providing contact information regarding a user, the method comprising:

[a] allocating a user-specific space in memory accessible over a computer network to a specific user;

[b] associating a mobile communication device with the user;

[c] determining a geographic location of the user by receiving location information provided by a mobile communication device;

[d] storing data indicative of the location of the user in the user-specific space;

[e] receiving, from the user, additional data regarding the user, the additional data being related to the geographic location of the user;

[f] storing the additional data regarding the user in the user-specific space;

[g] receiving from the user an access list of possible requesters of the data and the additional data;

[h] storing the access list of possible requesters of the data and the additional data in the user-specific space; and

[i] providing the data indicative of the location of the user and the additional data regarding the user to possible requesters on the access list.

('165, claim 1 (bracketed notation added).)

V. CLAIM CONSTRUCTION UNDER 37 C.F.R. § 42.104(B)(3)

Petitioner does not contend that any term from the '165 patent requires an explicit construction to understand how the claims apply to the prior art cited below. In the related district court litigation, Patent Owner has also taken the position that explicit claim construction is not necessary. (Ex. 1007.) Petitioner respectfully requests that the Board adopt the broadest reasonable construction consistent with

the ordinary and customary meaning of the challenged claims.[1,2] *See, e.g., Facebook, Inc. v. EveryMD LLC*, IPR2014-00242, Paper 15 (May 21, 2014) ("[W]e cannot discern how the constructions proffered by Petitioner add any clarity to the claim terms, which, though broad, are relatively simple. Therefore, for purposes of this

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[1] One of ordinary skill in the art as of April 2000 (the earliest application filing date for the '165 patent) would have possessed a Bachelor of Science Degree in Electrical/Computer Engineering or Computer Science (or related subjects), plus two years of related technical experience with distributed computer systems, or alternatively could have possessed both Bachelor and Master Degrees in Electrical/Computer Engineering or Computer Science (or related subjects) and have somewhat less experience in the technical areas mentioned above. Relevant professional or practical experience in these areas may also substitute for formal education. (Gray ¶¶ 13-14.)

[2] In IPR2014-00159, the Board construed the phrase "an access list of possible requesters of the data and the additional data" in claim 1 of the '165 patent as "'a series of possible requesters who have the right to access, or make use of,' the data and the additional data." (IPR2014-00159, Paper 28 at 5 (PTAB May 26, 2015).) While no explicit construction is necessary, as this Petition shows, the cited prior art regarding an access list fully discloses an "access list" under this construction.

Decision, we conclude that no explicit construction is necessary…."); *see also Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

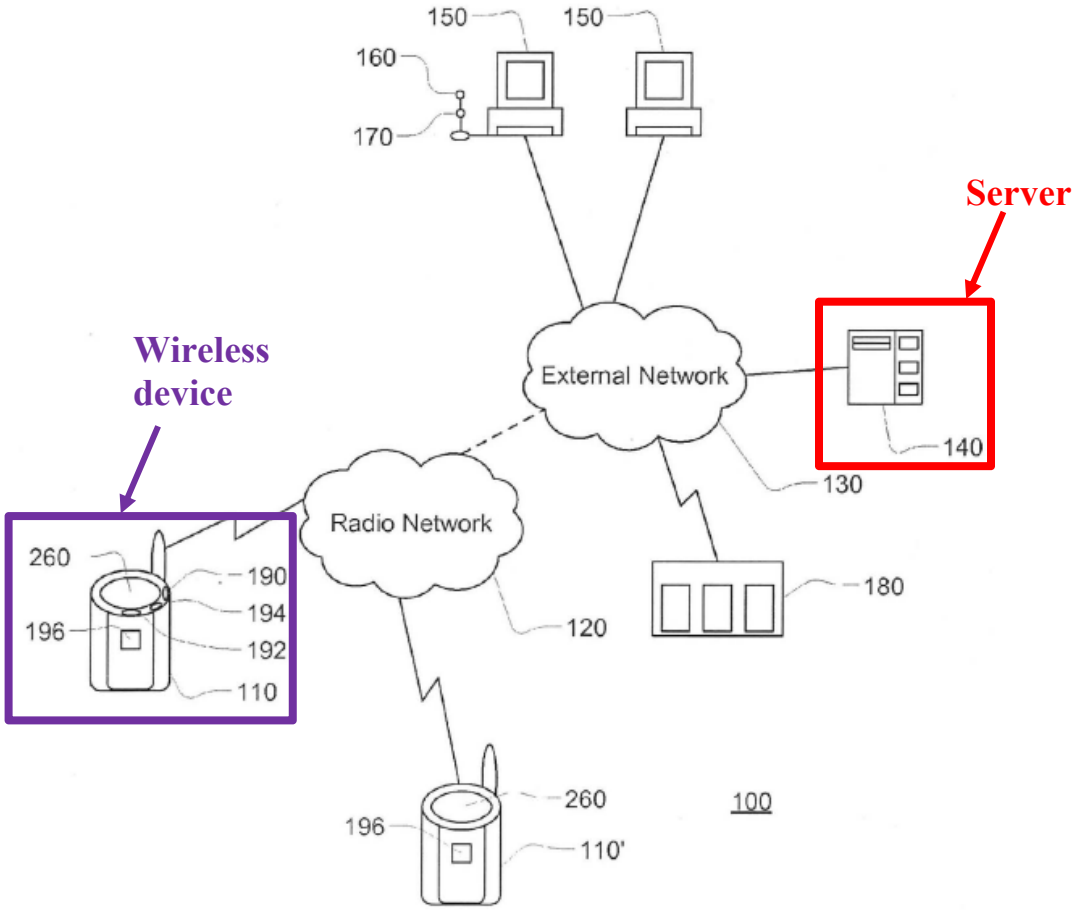
VI. CLAIM 1 IS UNPATENTABLE

A. Brief Summary and Date Qualification of the Prior Art

1. Knowles [Ex. 1003]

Knowles, U.S Patent No. 7,173,651, entitled "Apparatus and System for Prompt Digital Photo Delivery and Archival," describes a digital photo delivery system for uploading digital photos from a wireless device to a server for storage and sharing with specified individuals and groups. Knowles is the primary reference relied on in the invalidity analysis below. Knowles is prior art to the '165 patent under at least 35 U.S.C. § 102(e) because it issued from an application filed June 2, 1999.

Figure 1 provides a high level diagram of the system:



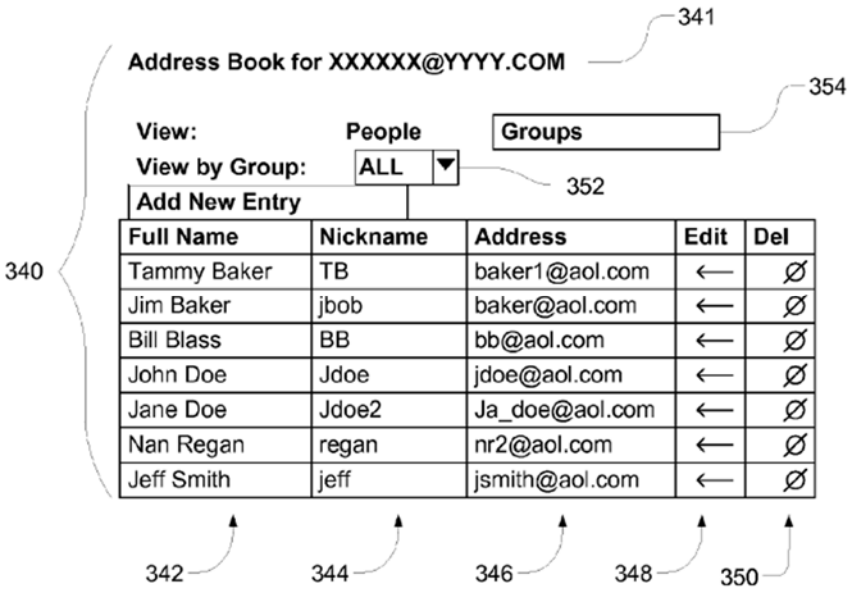
(Knowles, Fig. 1 (annotated).)

The system includes a wireless camera apparatus **110** (highlighted in purple box above), which can be a stand-alone wireless camera, "an enhanced digital phone that includes a digital camera," or other device with a camera. (Knowles, 5:29-30, 6:61-7:13.) The device **110** transmits and receives messages via a radio network **120**. (Knowles, 6:34-37.) The radio network **120** is connected to an external network **130**, such as the Internet, that is connected to a wireless camera service server **140** (highlighted in the red box above). (Knowles, 6:46-47.) A digital photo and related

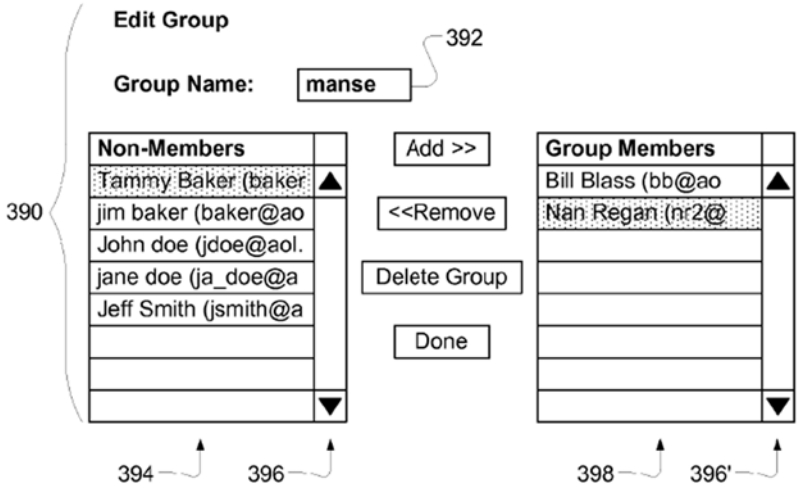
information are transmitted as a message from wireless device **110** to server **140** for storage and sharing with others. (Knowles, 4:60-67, 13:36-44, 13:57-62.)

To use the system, a user account is established at server **140** that corresponds to a wireless device **110**. (Knowles, 3:63-65, 4:2-14.) A user can access the account via "commonly available world wide web browsers" by providing an account ID and password in order to update account parameters and access messages stored on the server. (Knowles, 3:65-4:2, 6:29-34.) An account has an associated account configuration record that includes an account ID **321**, password **322**, account name **323**, contact name **324**, billing address **325**, camera id **326** that corresponds to the wireless device's RF modem **240** network equipment identifier or IP address, and data fields **328** and **329** corresponding to the dates for which account service has been established. (Knowles, 8:43-56, Fig. 7.)

A user also has an associated address book stored at the server for specifying information about individuals and groups who can be selected as recipients of the user's messages. (Knowles, 8:63-10:5, Figs. 8-11.) Figure 8, for example, depicts an interface for a user to view and edit information about individuals in the user's address book:



(Knowles, Fig. 8.) Figure 11 depicts an interface for a user to define a list of individuals to be included in a group, here one named "manse":



(Knowles, Fig. 11.)

The wireless device **110** captures a digital photo and related information, such as the device's location and an accompanying audio message. (Knowles, 5:15-17, 5:29-33.) The user can then specify recipients (such as the "manse" group members)

of the digital photo and related information. (Knowles, 7:32-35, 8:1-12.) The device **110** then transmits a message to the server **140** that includes the digital photo, related information, and recipient information. Figure 19 illustrates an embodiment of the message, where header **534** "includes such data as account ID, Classification, date, time, and location coordinates if available":

(Knowles, Fig. 19; *see also* Knowles, 11:51-53, 6:11-13.)

The server **140** receives the message and "parses out information such as account number, image, audio data, date, time, classification, location, and recipient code which is included in the message, saves this in a server memory for future access and in a holding area designated for this account." (Knowles, 13:38-44.) Then, if the message is to a group, "then a list of recipient addresses is retrieved . . . [and] the message is formatted as a standard e-mail message and transmitted to each recipient. Some embodiments may only send out a thumbnail version of images and/or a hyperlink to the server path or URL where the message has been saved." (Knowles, 13:57-62.)

Knowles identifies several potential real-world uses for the system, including vacationers for sharing trip events with a list of friends/relatives. (Knowles, 4:26-50; Gray ¶¶ 23-30.)

2. Narayanaswami [Ex. 1004]

Narayanaswami, U.S. Patent No. 6,504,571, entitled "System and Methods for Querying Digital Image Archives Using Recorded Parameters," describes a server-based system for a searchable archive of digital images. (Narayanaswami, 1:17-35, 3:56-4:6.) Narayanaswami is prior art to the '165 patent under at least 35 U.S.C. § 102(e) because it issued from an application filed May 18, 1998.

Narayanaswami explains that digital images and associated parameters (such as geographic location information, and voice annotation) captured by a digital camera can be uploaded to a server database. (Narayanaswami, 3:56-65, 7:17-8:5.) A user can subsequently search for and retrieve an image from the database using the parameters. (Narayanaswami, 3:66-4:13.) Narayanaswami identifies various motivations and advantages of the system. (Narayanaswami, 1:56-2:6.)

Narayanaswami further discloses that the server can determine the location associated with an image's geographic location information. Narayanaswami describes a "region of interest" (ROI) query module **208** in which a user may search for images taken in a particular location, such as "Yellowstone National Park." (Narayanaswami, 11:22-31, 9:14-22.) The ROI module compares the location data

associated with the particular location and the location data for the images stored in the database and retrieves matching images to display to the user. (Narayanaswami, 11:31-44.) Narayanaswami explains that "[i]t is to be appreciated that this type of query can be used for retrieving pictures that were taken, e.g., in particular cities or tourist spots." (Narayanaswami, 11:40-44; Gray ¶¶ 31-34.)

3. Falkenhainer [Ex. 1005]

Falkenhainer, U.S. Patent No. 5,930,801, entitled "Shared-Data Environment in which Each File has Independent Security Properties," generally discloses a web-based system for users to store data (e.g., files) on a server and control access to that data by specifying lists of users who can access the data on a file-by-file basis. (Falkenhainer, 1:20-32, 2:12-28, 3:5-17, 9:23-32, 9:67-10:8, 13:56-57.) Falkenhainer is cited primarily for limitations regarding an "access list" that allows different people different access to information stored on the server. Falkenhainer is prior art to the '165 patent under at least 35 U.S.C. §§ 102(a) and 102(e) because it issued July 27, 1999 from an application filed October 30, 1997.

As noted, Knowles discloses that a wireless device user may store messages on a server and those messages may be shared with specified recipients by sending an email with a hyperlinked URL pointing to the message on the server. While Knowles states that "there is a need for a networked image storage and archival service which provides secure, reliable, and universally accessible image storage

services" that "would allow shared access to and transfer of images by family and business groups" (Knowles, 1:57-67), Knowles does not describe in great detail how access to a message shared with specified recipients via a hyperlinked URL is controlled and secured.

However, Falkenhainer, which discloses an analogous server-based system for users to share files and other data, provides a detailed description of a web server that executes a command utility **18** in order to control access to a requested file based on a list of users specified by the file owner who have permission to access the file (see Figure 2 below). (Falkenhainer, 7:6-16, 7:42-47, 9:23-32, 9:66-10:8, 11:40-51, Fig. 2.)

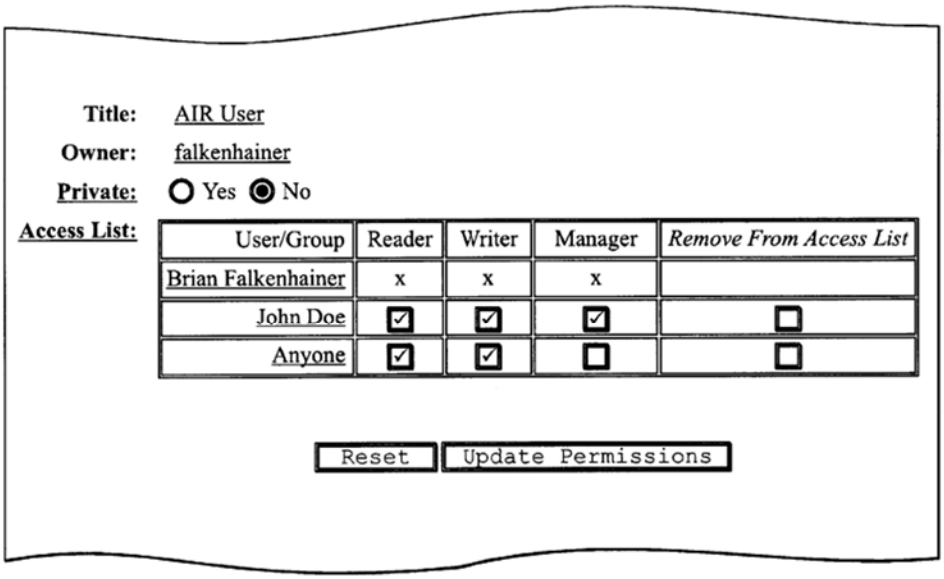


FIG. 2

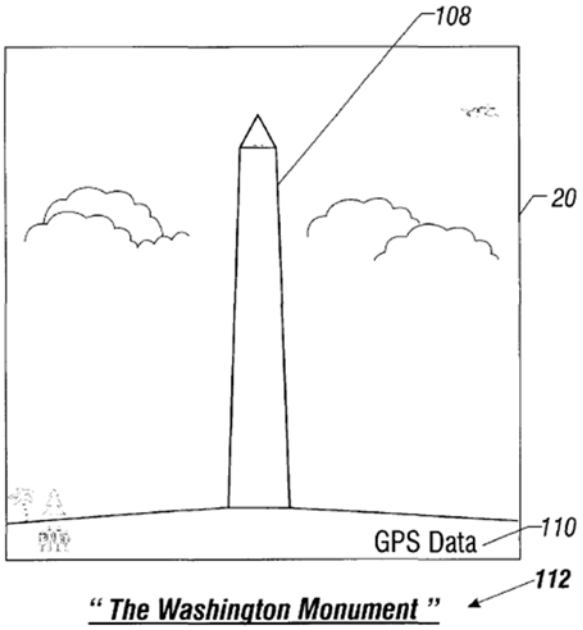
The command utility **18** can be implemented using the Common Gateway Interface ("CGI") (Falkenhainer, 11:40-51), a technique commonly used at the time to enable

a web server to execute a separate program. Falkenhainer further discloses that the system assigns URLs to files in a way that advantageously avoids the problems of broken or "stale" links that could arise as a result of web site or file reorganization. (Falkenhainer, 12:30-13:44; Gray ¶¶ 36-38.)

4. Clapper [Ex. 1006]

Clapper, U.S. Patent No. 6,023,241, entitled "Digital Multimedia Navigation Player/Recorder," describes a wireless handheld device similar to wireless device **110** of Knowles that includes a camera, GPS receiver, and microphone. (Clapper, 2:2-51.) Clapper is prior art to the '165 patent under at least 35 U.S.C. §§ 102(a) and 102(e) because it issued February 8, 2000 from an application filed November 13, 1998.

Clapper explains that the wireless device is useful to tourists who want to document their travels to landmarks and other points of interest. (Clapper, 1:8-22.) Clapper provides a specific example of a user taking a photo of the Washington Monument in Washington, D.C., and recording a voice annotation regarding that point of interest, as shown below:



(Clapper, Fig. 7, 3:61-67 ("[A] digital image of a particular landmark may be stored in association with an audio description of that landmark and GPS coordinates which locate the landmark, for example."), 5:40-46.)[3]

Independent claim 1 of the '165 patent recites storing "additional data regarding the user, the additional data being related to the geographic location of the user." This Petition points to Clapper to confirm the common-sense notion that the Knowles device **110** could similarly be used to record a user's voice annotation regarding a particular geographic location, such as a point of interest.

[3] All underlining added unless noted.

B. Grounds 1 & 2: Claim 1 Is Obvious Over Knowles, Narayanaswami, Falkenhainer, Alone (Ground 1) or in Further View of Clapper (Ground 2)

1. Claim 1 (Independent)

(a) "A method of providing contact information regarding a user:" (Preamble)

Assuming the preamble provides a limitation, Knowles discloses it. As explained below, Knowles discloses that the system provides an account ID and associated email address for contacting a user.

Knowles discloses that "[e]ach user of [its] system has an assigned server account ID and password which is required in order to update account parameters and access messages stored on the server [**140**]." (Knowles, 6:29-32.) Knowles explains that each message sent from the user's wireless device **110** includes the account ID so that the server **140**, upon receipt of the message, can associate the received message with the correct user account. (*See e.g.,* Knowles, 4:60-62 ("The message includes an account ID, a recipient code (nickname), and at least one digital image created by the digital camera"), 13:38-44 ("the server receives a message, parses out information such as account number, … [and] saves this in a server memory for future access and in a holding area designated for this account").)

Knowles further explains that each wireless device **110** is assigned an account email address **341**, in the form of XXXXXX@YYYY.com, which is comprised of the user's account ID (represented as XXXXXX) and a server domain name

(represented as YYYY.com). (Knowles, 9:4-19, FIG. 8.) "[A]ny e-mail messages which are received by the server for this e-mail address in an acceptable format from authorized e-mail addresses … will be forwarded to the associated wireless device." (Knowles, 9:15-19; *see also* Knowles, 14:26-39.) The account email address **341** (and the user's account ID) is thus "**contact information**" **provided** by the system that enables recipients to communicate with the user via email exchange through the server **140**. Moreover, the account email address **341** (including user's account ID) is also "**provided**" because it is included in the exchanged email messages that are sent to and from the server **140**. A user's account ID is further "**provided**" because it is included in messages that a user shares with specified recipients. (Knowles, 13:38-44, 13:57-62.) Thus, Knowles fully discloses the preamble of claim 1. (Gray ¶¶ 42-44.)

(b) "allocating a user-specific space in memory accessible over a computer network to a specific user;" (Claim 1[a])

This limitation is disclosed by Knowles. Knowles discloses that its server **140** includes a memory that includes user-specific space for a user to store messages and other user account data.

The server **140** in Knowles includes the claimed "**memory**." Knowles explains that "the server [**140**] receives a message, parses out information … [and] saves this in a server memory for future access." (Knowles, 13:38-44; *see also*

Knowles., 15:42-43 ("server memory storing account configuration data"), 6:29-34 ("Each user of such system has an assigned server account ID and password which is required in order to … access messages stored on the server"), 7:23-27 ("FIG. 3 shows a representative configuration table **310** for the wireless device which… [is] stored in server memory"), 8:44-56 ("each wireless device user will have an account configuration record on the server"), 8:63-67 ("stored in server database tables").)

Knowles further discloses "**a user-specific space in memory**," as recited in the claim. For example, Knowles discloses that its memory stores password-protected user account information (Knowles, 6:29-34, 4:2-14), including an account configuration record (Knowles, 8:43-47) and configuration table **310** (Knowles, 7:23-26), and messages (Knowles, 13:38-44) for each registered user. Knowles further expressly states that messages are saved in a "holding area designated for this account." (Knowles, 13:38-44.) By providing password-protected access to user account information, as well as a holding area designated for the user, Knowles discloses **a user-specific space in memory** of server **140**.

The user-specific space in memory is **allocated to a specific user** as part of the registration process and as the user uses the system. Knowles explains that, once a wireless device **110** is registered with a network service provider, that provider will "arrange for initialization of the account information **320** (FIG. 7) on the server **140**." (Knowles, 14:48-56; *see also* Knowles, 14:57-15:14, 3:63-65 ("an account is

established on the server").) Only then is the user able to logon to the server **140** and use the server interfaces to enter recipient information and manage their account. (Knowles, 14:48-56; Gray ¶ 48.) As the user uses the system, messages from the user are stored in a holding area designated for the user. (Knowles, 13:38-44.)

The user-specific space in memory is "**accessible over a computer network**." As explained in Knowles:

> Th[e] server may be a private system accessible only via a private network, or may be connected to the Internet and be configured to allow wireless device users to access the server by using commonly available world wide web browsers. In either case the server is preferably remotely accessible in order to establish or update account parameters, or to access previously transmitted digital images and or responses thereto.

(Knowles, 3:65-4:5 (underlining added); *see also* Knowles, 6:29-34 ("Each user of such system has an assigned server account ID and password which is required in order to update account parameters and access messages stored on the server"), 4:2-14.) Thus, each user in Knowles can access information stored in their user-specific space in memory over the Internet.

Knowles therefore discloses "**allocating a user-specific space in memory accessible over a computer network to a specific user**," as recited in the claim. (*See* Gray ¶¶ 45-50.)

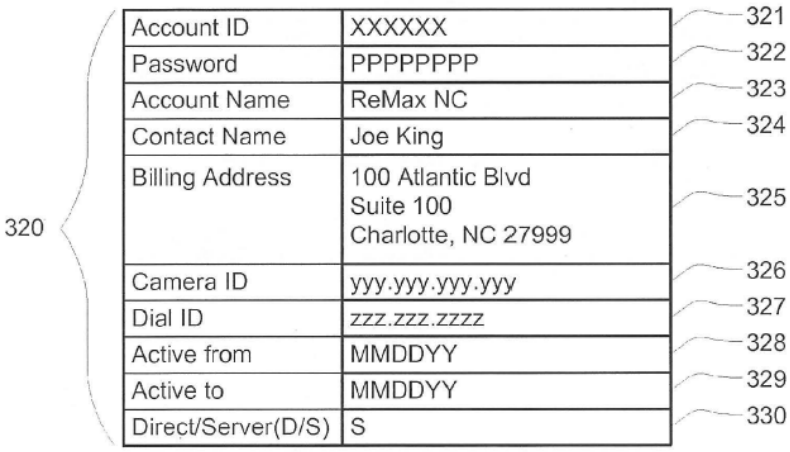
(c) "associating a mobile communication device with the user;" (Claim 1[b])

Knowles discloses this limitation. As noted, each user of Knowles' system is assigned an account ID. (Knowles, 6:29-34.) "[A]n account … corresponds to at least one wireless camera device." (Knowles, 3:63-65.) Thus, each wireless device **110** in Knowles' system is associated with a user.

Moreover, Knowles explains that each account has an associated account configuration record, which includes details about the user and the user's device **110**:

> FIG. 7 shows a representative account configuration record on the server **140** of the present invention. In the preferred embodiment wireless photo delivery system each wireless device user will have an account configuration record on the server which includes an account ID **321**, a password **322**, an account name **323**, a contact name **324**, a billing address **325**, a camera id **326** which corresponds to the RF modem **240** network equipment identifier or IP address (for those devices with a packet data modem), a wireless device dial ID number **327** corresponding to the phone number associated with the RF modem **240** (for those devices with a standard circuit switched cellular modem), and data fields **328** and **329** corresponding to the dates for which account service has been established.

(Knowles, 8:43-62; *see also* Knowles, Fig. 7.) Figure 7 of Knowles is shown below for reference:



As this figure shows, the device **110** identified by the camera ID **326** / IP address in the above record is associated with the user "Joe King." Thus, Knowles discloses that a particular device **110** is associated with a particular user via the account configuration record stored within the system's server **140**.

Knowles further discloses that a wireless device **110** is associated with a user as part of the device's registration process:

> [I]n cases where the user does no [*sic*] own a wireless device but only rents one on occasion, the user may establish an account and initialize address book details at his or her convenience prior to obtaining a wireless device, and the wireless device provider will associate a particular device with this account information when the user picks up the device.

(Knowles, 14:59-65 (underlining added); *see also* Knowles, 14:66-15:14, 3:63-65.) Thus, Knowles discloses "**associating a mobile communication device with the user**," as recited in the claim.

Further, the passage excerpted above only discusses the registration of rental devices. As Mr. Gray explains in his Declaration, however, a person of ordinary skill in the art would have understood, and it would have been obvious, that this device-to-account association occurs as part of every device registration, regardless of whether or not the device is a rental. (Gray ¶ 54.) This is again evidenced by the account configuration record in Figure 7, which is created for every account (rental or otherwise), and which lists both user information and specific device **110** information. (Gray ¶¶ 51-54.)

(d) "determining a geographic location of the user by receiving location information provided by a mobile communication device;" (Claim 1[c]))

This limitation is rendered obvious by Knowles in view of Narayanaswami. Knowles discloses that the wireless device **110** includes a "global positioning system (GPS) unit for capturing location data that may then be included in [a] message." (Knowles, 5:30-33; *see also* Knowles, 13:28-44.) This location data is "**location information**."

The server **140** in Knowles **receives** the location data from the wireless device **110**. For example, Knowles explains that the wireless device **110** sends a message with location data to the server **140** for forwarding and/or storage. (*See, e.g.*, Knowles, 5:30-33, 13:30-55, 11:51-55 ("the message header **534** … includes such data as … location coordinates if available"), FIG. 19, 4:60-67 ("the message may

include … location coordinates").) "[T]he server **140** receives [this] message, parses out information such as account number, image, audio data, date, time, classification, location, and recipient code which is included in the message, [and] saves this in a server memory for future access." (Knowles, 13:30-44; *see also* Knowles, 6:29-34 ("access messages stored on the server").) Thus, the server **140** in Knowles "**receiv[es] location information provided by a mobile communication device**," as recited in the claim. (Gray ¶¶ 55-56.)

Knowles does not appear to disclose "**determining a geographic location of the user**" after the location data is received by the server **140** but this would have been obvious in view of **Narayanaswami**. (Gray ¶ 57.) Narayanaswami similarly describes a digital image archive system that includes a camera **100** having a GPS receiver **114** "for recording the geographical position (e.g., latitude, longitude, and altitude) of the camera **100** … when an image is taken." (Narayanaswami, 5:54-60; *see also* Narayanaswami, 5:1-44.) Narayanaswami also similarly explains that this location data is recorded onto the image and then sent from the camera **100** to an image database **216** for archiving. (Narayanaswami, 6:49-54, 7:17-8:1, 8:40-52.) The location data in Narayanaswami is "used by the system **200** to index and retrieve certain images in response to a user query." (Narayanaswami, 8:47-52.)

Narayanaswami further discloses that its system includes a **region of interest (ROI) query module 208** that determines a geographic location associated with a digital image:

> A region of interest (ROI) query module **208** is utilized in response to a user query that seeks to retrieve images corresponding to the region designated by the user. In particular, in response to a user query (as discussed further below), the ROI query module **208** will access the region boundary database **218** to determine the geographic boundaries of the designated region, and then retrieve all images within the image database **216** having parameters [i.e., location data] which fall within the determined region boundary.

(Narayanaswami, 9:14-22.) Narayanaswami provides a real-world example of how the module **208** functions during a user query:

> [I]f it is determined that a region of interest query was designated … the ROI query module **208** will access the region boundary database **218** (such as the Geographic Information System (GIS) database discussed above) (step 312) and retrieve geographic boundary data for the particular region specified in the query (step 314). For example the query may designate "Yellowstone National Park" as a region of interest. The geographic boundary data (e.g., latitude and longitude) of "Yellowstone National Park" will be output from the database. The ROI query module **208** will then compare the retrieved boundary data with the location data (e.g., latitude and longitude data) associated with

> each of the images stored in the image database **216** (step 316). The ROI query module **208** will then retrieve every image having latitude and longitude parameters recorded thereon which fall within the string of latitude/longitude pairs of the designated boundary.

(Narayanaswami, 11:22-44.) This passage indicates that Narayanaswami's system can determine the geographic location of the camera **100** (and thus the user operating the camera **100**) based on the location data recorded in the image, which was previously received by the image database **216**. Specifically, in the example above, the system determines that all of the images having recorded location data within the designated geographic boundary are images taken at Yellowstone National Park. Narayanaswami also notes that the system is useful for determining whether images where taken in particular cities or tourist spots. (Narayanaswami, 11:40-44.) Thus, Narayanaswami discloses "**determining a geographic location of the user by receiving location information provided by a mobile communication device**," as recited in the claim.

Rationale and Motivation to Combine: It would have been obvious to combine the photo delivery system in Knowles with Narayanaswami so that Knowles' system included functionality similar to the region of interest (ROI) query module **208** described in Narayanaswami. (Gray ¶ 60.) This would have predictably resulted in a photo delivery system that allowed users to query the server **140** to

determine images taken at a particular geographic location. For example, utilizing the functionality described in Narayanaswami, a user could log into Knowles' system and retrieve all of the images they took at Yellowstone National Park while on vacation (or that were shared with them). (*See e.g.,* Knowles, 4:46-50; Gray ¶ 60.)

A person of ordinary skill in the art would have found that Knowles and Narayanaswami are readily combinable. First, Knowles and Narayanaswami are analogous references in the same field of art. (Gray ¶ 61.) As previously discussed, both Knowles and Narayanaswami disclose cameras that take photographs and record data, such as GPS coordinates. (Knowles, e.g., 11:51-55, 13:38-44, Fig. 19; Narayanaswami, 6:49-54, 7:16-46.) And, the cameras in both references link the recorded GPS data to their photographs and then send those photographs (and their linked GPS data) to a remote server for storage. (Knowles, e.g., 13:30-62; Narayanaswami, 7:61-8:5.) Narayanaswami provides an example of how Knowles' system could use the stored GPS coordinates.

Second, Narayanaswami provides express motivation to combine. (Gray ¶ 62.) Knowles states that "there is a need for a networked image storage and archival service . . . [with] the ability to categorize and sort each image by time, date, and occasion." (Knowles, 1:57-67.) Narayanaswami similarly recognizes that "[t]here is a need, therefore, in the industry to provide a digital image database query system

which can search for digital images based on parameters such as geographic location, time and date." (Narayanaswami, 1:58-61.) Narayanaswami also identifies various situations where such a system would be of "significant value," including a number of situations also identified by Knowles. (Narayanaswami, 1:61-2:6; Knowles, 4:26-50.) As an example of how the system could be used, Narayanaswami explains that a person wanting to "relive the experience of escaping a cold winter in the northeast USA … may retrieve every picture and/or video clip that was taken during their trip to Daytona Beach" using location data recorded on those pictures / video clips. (Narayanaswami, 1:27-35.) Narayanaswami therefore expressly recognizes, and a person of ordinary skill would have appreciated, the benefits of recording location data for categorizing, sorting, and searching for digital images and its ready applicability to the Knowles system. (Gray ¶ 62.)

Third, a person of ordinary skill in the art would have had a reasonable expectation that the combination would be successful. (Gray ¶ 63.) Adding the functionality described in Narayanaswami would be an add-on feature or improvement to Knowles' system and would not result in any other changes to the functionality of Knowles' system.

Lastly, there is no temporal limitation for this claim so there is no requirement that a "geographic location of the user" is the *current* location of the user. (Gray ¶ 64.) However, even if there were such an interpretation, a geographic location

determined as discussed above would still qualify as a "geographic location of the user." A person of ordinary skill in the art would have understood that a user could take a picture with the device **110**, add the location data discussed above, and immediately transmit a message with the image and location data to the server **140** for storage. (*See e.g.,* Knowles, 1:43-52 (explaining that it is desirable to "view or share access to a digital photo quickly"); Gray ¶ 64.) While in the same location, the user or a recipient could access the server for the message that the user just uploaded. In this scenario, the message and its image and location data would include data indicative of the current location of the user and the geographic location determined using that data would similarly indicate the current location of the user.

Thus, for the foregoing reasons, it would have been obvious to combine Knowles with Narayanaswami to disclose and render obvious this claim limitation. (Gray ¶¶ 55-65.)

(e) "storing data indicative of the location of the user in the user-specific space;" (Claim 1[d])

Knowles discloses this limitation in at least two separate ways: (1) location data associated with digital images taken by the user; and (2) the digital images themselves.

First, as noted, Knowles discloses that its wireless device **110** includes a "global positioning system (GPS) unit for capturing location data that may then be included in [a] message." (Knowles, 5:30-33; *see also* Knowles, 13:28-44.) Because

the user is co-located with the wireless device **110** that includes the GPS unit, the location data captured by the GPS unit is "**data indicative of the location of the user**." The location data provides the exact location of the wireless device **110** (and thus the user) in the form of longitudinal and latitudinal coordinates. (*See e.g.,* Knowles, 4:64-67, 11:51-53; Gray ¶ 67.)

Knowles also discloses this limitation in a second way. The digital images taken by the wireless device **110** in Knowles are also "**data indicative of the location of the user**." To begin with, a person of ordinary skill in the art would have understood that a digital image is data. (Gray ¶ 68.) Knowles also expressly discloses that "image files" are "data files." (Knowles, 2:58-60.)

Knowles' digital images are photographs (or videos) of the location or area surrounding the wireless device **110** and thus the user. For example, Knowles describes using the wireless camera **110** to take photos of a home office for insurance adjusters, photos of a crime scene for the police, and vacation photos. (Knowles, 4:37-50.) These examples suggest photos of subject matter near the wireless device **110**—i.e., in a proximity of device's location—which is suggestive of the user's location. Therefore, the digital images in Knowles are "**data indicative of the location of the user**." (Gray ¶¶ 68-69.)

As discussed for the previous limitation, there is no temporal limitation for this claim so there is no requirement that the "location of the user" is the *current*

location of the user. (Gray ¶ 70.) However, even if there were such an interpretation, the location data and images would still qualify as "data indicative of the location of the user" for the reasons explained above.

Knowles explains that the message with an image and location data is sent to the server **140** where it is **stored** for future use:

> FIG. 20 shows a process flow chart of how the server processes messages received from a wireless camera device. At block **544** the server receives a message, parses out information such as account number, image, audio data, date, time, classification, location, and recipient code which is included in the message, [and] saves this in a server memory for future access and in a holding area designated for this account.

(Knowles, 13:36-62; *see also* Knowles, Figs. 18 & 19, 4:60-67 ("[t]he message includes … at least one digital image created by the digital camera … and/or location coordinates"), 12:6-15.)[4] For the reasons discussed with respect to claim element

[4] A person of ordinary skill in the art would have understood the "location" mentioned in the above passage to refer to the "location data" captured by the GPS unit in the wireless device **110**. Knowles also refers to "location" as "location coordinates". (Knowles, 4:60-67, 11:51-55 ("message header **534** … includes such data as … location coordinates if available"); Gray ¶ 71 n.2.)

1**[a]**, the messages with digital images and location data are stored within the user-specific space in server memory. (Gray ¶ 71.)

Therefore, the server **140** in Knowles **stores data indicative of the location of the user in the user-specific space**. (Gray ¶¶ 66-72.)

(f) "receiving, from the user, additional data regarding the user, the additional data being related to the geographic location of the user;" (Claim 1[e])

This limitation is disclosed and obvious over Knowles, alone (**Ground 1**) or in view of Clapper (**Ground 2**).

Knowles discloses that its "wireless camera includes a microphone interface for recording audio messages to be transmitted in a digital format with messages." (Knowles, 5:15-17; *see also* Knowles, 8:13-28, 11:27-42, 12:12-15, Fig. 19 (illustrating an "audio" component of a message).) As noted, messages that include image data and audio data are transmitted from the wireless device **110** in Knowles to the server **140** where they are stored in memory. (Knowles, 3:43-4:14, 6:23-34, 13:30-62 ("At block **544** the server receives a message, parses out information such as . . . image, audio data . . . [and] saves this in a server memory for future access").) Thus, Knowles generally discloses that its server **140** receives audio messages / voice annotations from users' wireless devices.

It would have been obvious to a person of ordinary skill in the art that a voice annotation in Knowles could be related to a geographic location, such as a point of

interest. (Gray ¶ 75.) For example, Knowles explains that the wireless device **110** could be used while on a vacation to "share trip events." (Knowles, 4:47-50.) A well-known common practice while vacationing is to go sightseeing, i.e., to visit points of interest. (Gray ¶ 75.) A person of ordinary skill in the art would have readily appreciated that the voice annotation feature described in Knowles could be used to record information about a point of interest being visited. (*Id.*) For example, on vacation to Washington, D.C., a user could make a voice annotation to accompany of photo of the user's visit to the Washington Monument, a well-known point of interest in the city. (*Id.*) The voice annotation could state, for example, "Here is a photo of my brother and me next to the Washington Monument." The voice annotation therefore qualifies as "**additional data regarding the user**" and "**related to the geographic location of the user**." (Gray ¶¶ 74-75.)

To the extent that there is any question that it would have been obvious to a person of ordinary skill in the art that a voice annotation in the Knowles system could qualify as the claimed "additional data," such a voice annotation is expressly disclosed by **Clapper**. (Gray ¶ 76.)

Like Knowles, Clapper discloses a mobile device ("recorder **10**") capable of taking photos and making voice annotations. (Clapper, 2:2-25, 3:61-67, 5:8-16, 5:40-45.) Thus, "[f]or example, a digital image of a particular landmark may be stored in association with an audio description of that landmark and GPS coordinates

which locate the landmark." (Clapper, 3:64-67.) Clapper expressly discloses an example in which a photo of the Washington Monument is associated with a voice annotation regarding that point of interest. As shown below, in annotated Figure 7 of Clapper, a digital image **108** is linked to audio information **112** that describes the photographed object as "The Washington Monument." (Clapper, 1:61-62, 5:40-45.)

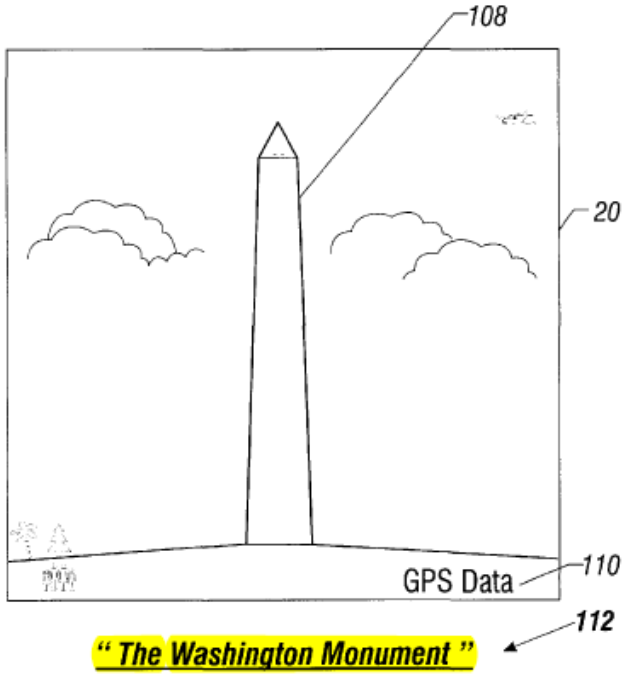


FIG. 7

Rationale and Motivation to Combine: It would have been obvious to a person of ordinary skill in the art to combine the relevant teachings from Knowles and Clapper. (Gray ¶ 78.) The combination would have predictably resulted in voice annotations of Knowles that described the geographic location of the user of the mobile device **110**. (*Id.*) A person of ordinary skill in the art would have reasonably expected that the combination would have been successful. (*Id.*) Clapper identifies

a common-sense way in which the voice annotation feature already present in the device **110** of Knowles could be used. (*Id.*) There would have been no technological obstacle to this combination. (*Id.*) Clapper and Knowles are analogous references disclosing similar systems for using mobile devices to record image and audio information for storage in a server system. (*Id.*) Moreover, as noted, both references disclose using the systems for vacationing/sightseeing. (Clapper, e.g., 1:10-14 ("For example, on a vacation, a tourist may travel to a variety of landmarks and at each landmark there may be particulars sites which may be of note."); Knowles, 4:47-50.) A person of ordinary skill in the art would have therefore readily appreciated the combination of Knowles and Clapper. (Gray ¶ 78.)

(g) "storing the additional data regarding the user in the user-specific space;" (Claim 1[f])

As discussed above with respect to claim element 1**[e]**, the server **140** in Knowles receives messages that include images, voice data/annotations (and other data), and then stores those messages for future retrieval and use. (*See e.g.*, Knowles, 13:36-44.) As further discussed with respect to claim element 1**[a]**, the messages are stored within the user-specific space in server memory, in a "holding area designated for [the] account." (Knowles, 13:38-44; Gray ¶ 79.)

(h) "receiving from the user an access list of possible requesters of the data and the additional data;" (Claim 1[g])

This limitation is obvious over Knowles in view of Falkenhainer. As discussed with respect to claim elements 1**[d]** through 1**[f],** the claimed "data" is satisfied by the images and location data in Knowles, and the claimed "additional data" is satisfied by the audio data disclosed in Knowles or Knowles in view of Clapper. As noted for those claim elements, the messages stored within the server **140** in Knowles include this "data" and "additional data."

Knowles further discloses "**possible requesters of the data and the additional data**." Knowles discloses that its server **140** has access to the memory where the messages are stored and can retrieve the messages from the memory upon query from a user or recipient. For example, Knowles describes an embodiment where the server **140** sends out an email message to one or more recipients with "a hyperlink to the server path or URL where [a] message has been saved." (Knowles, 13:57-62.) Knowles does not disclose in detail how a recipient would subsequently access the message, but a person of ordinary skill in the art at the time would have understood that clicking a hyperlink for the URL would cause a request to be sent to the server **140** to retrieve the message from memory and provide it to the recipient. (*See e.g.*, Knowles, Abstract, 4:46-50, 9:20-41, 13:30-62; Gray ¶ 81.)

Knowles also discloses that the server "**receiv[es] from the user an access list**" of possible requesters. Knowles explains that each user creates an address book, which is a list of potential recipients that may receive messages from the user's wireless device **110**. (*See e.g.,* Knowles, 7:23-57, Fig. 3, Figs. 8-9, 9:4-26, 14:46-65.) Knowles further explains that the user can also create groups of recipients in the address book by specifying list of individuals for each group. (Knowles, Figs. 10-11, 9:42-10:5.) The server receives this address book information from the user and stores it in memory. (Knowles, 8:62-9:4.) Knowles explains that the address book information allows the user "to control distribution of messages transmitted from the wireless device [**110**]." (Knowles, 7:32-35; *see also* Knowles, 13:57-62 ("If the message is to a group, then a list of recipient addresses is retrieved at block **556**").) In other words, this allows the user to control who has access to specific messages and their content. The only people that have access to a specific stored message are the people that the user identified to receive the email with a hyperlink/URL. (Gray ¶ 82.) Thus, Knowles discloses "**receiving from the user an access list of possible requesters of the data and the additional data**."

Knowles acknowledges the "need for a networked image storage and archival service which provides secure, reliable, and universally accessible image storage services." (Knowles, 1:53-67.) To the extent there is any question as to whether

Knowles discloses an "access list" as claimed, **Falkenhainer** provides those details. (Gray ¶ 83.)

Similar to Knowles, Falkenhainer discloses allowing different people different access to information (e.g., files) on a server. In particular, Falkenhainer discloses that a user who "owns" a file can invoke an "edit properties" command in order to specify others who have permission to access the file. (Falkenhainer, 7:42-58, 8:24-44, Fig. 2; *see also* Falkenhainer, 3:32-40.) This produces an "**access list**" for a file. (Falkenhainer, Fig. 2 (reproduced below), 9:66-10:8 ("A matrix is displayed, with a list of potential users and/or persons currently with at least read access . . . including an option of removing a previously-listed person from the access list").) The permissions are specified on a file-by-file basis. (Falkenhainer, 13:64-67.)

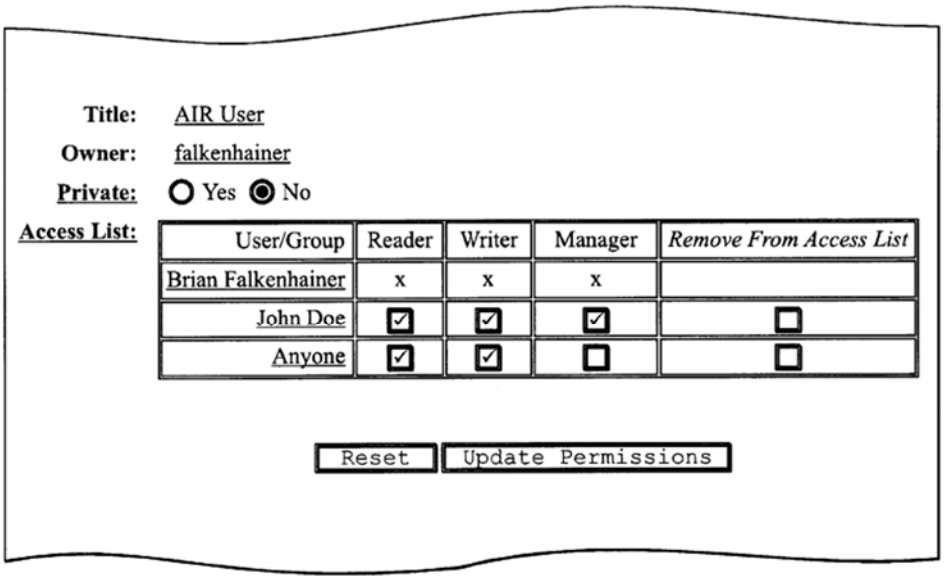


FIG. 2

Falkenhainer discloses that the access list is used to control access by possible requesters. Falkenhainer discloses a command utility **18** that is executed in order for a user to access a requested file. (Falkenhainer, e.g., 3:13-22, 7:6-16 (describing "get" command to access file and send to requesting user), 11:40-51.) When a command is received to access a particular file, the command utility **18** checks the access permissions of the requesting user. (Falkenhainer, 2:24-29 ("When a user enters a URL of a desired file, the identification number of the desired file is determined, the identification number of the user is determined, and the object associated with the desired file is consulted to determine if the user has access to the file."), 9:23-32 ("Prefatory to the activation of any of the above commands such as add, view, etc., the command utility **18** does a permission check on the user initiating the command.").)

Rationale and Motivation to Combine: It would have been obvious to a person of ordinary skill in the art to combine the relevant teachings of Knowles and Falkenhainer, which would have predictably resulted in the server **140** of Knowles providing an access to user images and messages based on an access list received by the user. (Gray ¶ 86.) For example, the command utility **18** could ensure that only people in a user's "manse" group could access messages shared only with the "manse

group" while only people in the user's "family" group could access messages shared only with the "family" group. (*See e.g.*, Knowles, Figs. 4, 10; Gray ¶ 86.)

To begin with, Knowles and Falkenhainer are analogous references related to sharing files over the Internet with specified recipients. (Gray ¶ 87.) For example, Knowles discloses sharing images and account information by transmitting an associated URL to specified recipients. (Knowles, 13:57-62.) Falkenhainer similarly describes sharing files (such as graphics) with specific users by associating a URL with a list of authorized users. (Falkenhainer, 2:23-28, 2:44-51, 9:23-32, 9:66-10:8.)

Knowles and Falkenhainer are further similar because they both disclose sharing information with specified others on a message-by-message or file-by-file basis. To the extent not disclosed or suggested in Knowles, a person of ordinary skill in the art would have appreciated that limiting message access to the specified individuals and/or groups would advantageously avoid inadvertent or unwanted disclosure of the messages to others not specified by the user. (Gray ¶ 88.) Falkenhainer expressly teaches that "it is desirable, in shared-files systems, to have some mechanism for security with respect to publicly-available documents, so that there can be some order and control over the contents of the documents." (Falkenhainer, 1:28-32.)

A person of ordinary skill in the art would have reasonably expected that the combination would be successful and would have perceived no technological obstacle to the combination. (Gray ¶ 89.) Both references describe using conventional computer and Internet technologies and techniques, such as web servers, databases and CGI in a conventional way. (Falkenhainer, 11:40-51; Knowles, 8:63-9:4.)

Moreover, as noted above, Knowles does not provide particular detail regarding how the server manages access to information. A person of ordinary skill in the art implementing the system of Knowles would have readily appreciated that Falkenhainer picks up where Knowles leaves off by disclosing that access permissions of the requesting user are checked against an access list provided by the user. (Gray ¶ 90.)

Thus, the prior art discloses and renders obvious the step of "**receiving from the user an access list of possible requesters of the data and the additional data**," as recited in the claim.

(i) "storing the access list of possible requesters of the data and the additional data in the user-specific space; and" (Claim 1[h])

As discussed with respect to claim element 1**[a]**, a user's account information and configuration table are stored in a user-specific space for the user. Knowles explains that the account information and configuration table include a user's address book information (i.e. "**access list of possible requesters**"). For example, Knowles explains that "each server account is password protected for access only by authorized users" who "may update their server accounts to establish recipient codes, or nicknames, … thereby creating nicknames for the purpose of controlling how messages will be archived and/or distributed to individuals or groups." (Knowles, 4:5-14.) Knowles also discloses that the address book information is stored on the server **140** as part of a configuration table **310** for the user's account. (Knowles, 7:23-32.) An exemplary configuration table **310** is illustrated in Figure 3 of Knowles, reproduced at right. As shown, the table **310** lists the names of the groups defined by the user. (Knowles, 7:32-38 (explaining that "G" designates a group nickname).)

310

312	314	316
3BR2BA	G	
ALL	G	
FAMILY	G	
MANSE	G	
BB	N	XXX.XXX.XXX.XXX
JBOB	N	XXX.XXX.XXX.XXX
JDOE	N	XXX.XXX.XXX.XXX
JDOE2	N	XXX.XXX.XXX.XXX
JEFF	N	XXX.XXX.XXX.XXX
REGAN	N	XXX.XXX.XXX.XXX
TB	N	XXX.XXX.XXX.XXX
CUSTOM	S	
HOLD	S	

As discussed above for claim 1**[g]**, the "access list" is obvious over Knowles and Falkenhainer. For the reasons explained above, it would have been obvious to a

person of ordinary skill in the art that the address book information stored in the user-specific space could be used to control access to requested data, as described in Falkenhainer. (Gray ¶ 93.) The rationale and motivation to combine Knowles and Falkenhainer explained for claim 1**[g]** applies equally here. (*Id.*)

Thus, the prior art discloses and renders obvious the step of "**storing the access list of possible requesters of the data and the additional data in the user-specific space**." (Gray ¶¶ 92-94.)

(j) "providing the data indicative of the location of the user and the additional data regarding the user to possible requesters on the access list." (Claim 1[i])

This limitation is disclosed by Knowles in view of Falkenhainer for the reasons discussed with respect to claim element 1**[g]**. Specifically, as discussed in that section, when Knowles is combined with Falkenhainer, the system provides specific messages to only those recipients that are authorized to view the message per the access list. The recipients are "requestors" because a person of ordinary skill in the art would have understood that clicking the hyperlink would send a request to the server **140**, which prompts the server **140** to access its memory and retrieve the specific archived message associated with the hyperlink. (Gray ¶ 95.)

As discussed with respect to claim elements 1**[d]** and 1**[e]**, the messages in Knowles include digital images, location data, and voice data, which are the claimed "**data indicative of the location of the user**" and the claimed "**additional data**

regarding the user." When a group recipient clicks on the hyperlink for the URL such that the message is retrieved from memory and provided to the recipient, that recipient is provided with the "data" and "additional data." (Gray ¶ 96.)

For these reasons, the prior art renders claim 1 obvious.

VII. CONCLUSION

Petitioner respectfully requests institution of *inter partes* review of claim 1 and a finding that it is unpatentable.

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CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this petition complies with the type-volume limits of 37 C.F.R. § 42.24(a)(1)(i) because it contains 8,282 words, according to the word-processing system used to prepare this petition, excluding the parts of this petition that are exempted by 37 C.F.R. § 42.24(a) (including the table of contents, a table of authorities, mandatory notices, a certificate of service or this certificate word count, appendix of exhibits, and claim listings).

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Sections 42.6 and 42.105, that a complete copy of the attached **PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 7,343,165 B2**, including all exhibits (**Nos. 1001-1007**) and related documents, are being served via Federal Express on the 3rd day of April, 2018, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon the Patent Owner by serving the correspondence address of record with the USPTO as follows:

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and upon counsel of record for the Patent Owner in the currently-pending litigation *Silver State Intellectual Technologies, Inc. v. Facebook Inc.*, 4:17-cv-03349-JSW (N.D. Cal.) as follows:

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