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Paper 10
Date: August 1, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00221
Patent 10,423,658 B2

Before LYNNE H. BROWNE, NORMAN H. BEAMER, and KEVIN C. TROCK, *Administrative Patent Judges.*

BROWNE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Samsung Electronics Co., Ltd., filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 1–15 of U.S. Patent No. 10,423,658 B2 (Ex. 1001, "the '658 patent"). Patent Owner, MemoryWeb, LLC, filed a Preliminary Response (Paper 6, "Prelim. Resp."). With our authorization, Petitioner filed a Preliminary Reply to Patent Owner's Preliminary Response (Paper 8, "Prelim. Reply") and Patent Owner filed a Preliminary Sur-reply (Paper 9, "Prelim. Sur-reply").

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition and any response thereto shows "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." Considering the Petition, the arguments presented in the Preliminary Response, as well as all supporting evidence, we determine that Petitioner shows a reasonable likelihood that at least one of the challenged claims is unpatentable. Accordingly, we institute *inter partes* review.

A. *Real Parties in Interest*

Petitioner states that "Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. are the real parties in interest." Pet. 108. Patent Owner states that it, MemoryWeb, LLC, is the real party in interest. Paper 3, 2.

B. Related Matters

The parties state that the '658 patent is the subject of the following civil actions: *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, 6:21-cv-00411 (W.D. Tex.), Pending; *MemoryWeb, LLC v. Apple, Inc.*, No. 6-21-cv-00531 (W.D. Tex.), Pending; and *MyHeritage (USA), Inc. et al. v.*

MemoryWeb, LLC, No. 1-21-cv-02666 (N.D. Il.), Dismissed. Pet. 109; Paper 3, 2.

Petitioner states that "[t]he '658 patent is also the subject of an IPR proceeding filed by Apple Inc. (IPR2022-00033)" but that "Samsung is not a real party-in-interest to this IPR proceeding." Pet. 109.

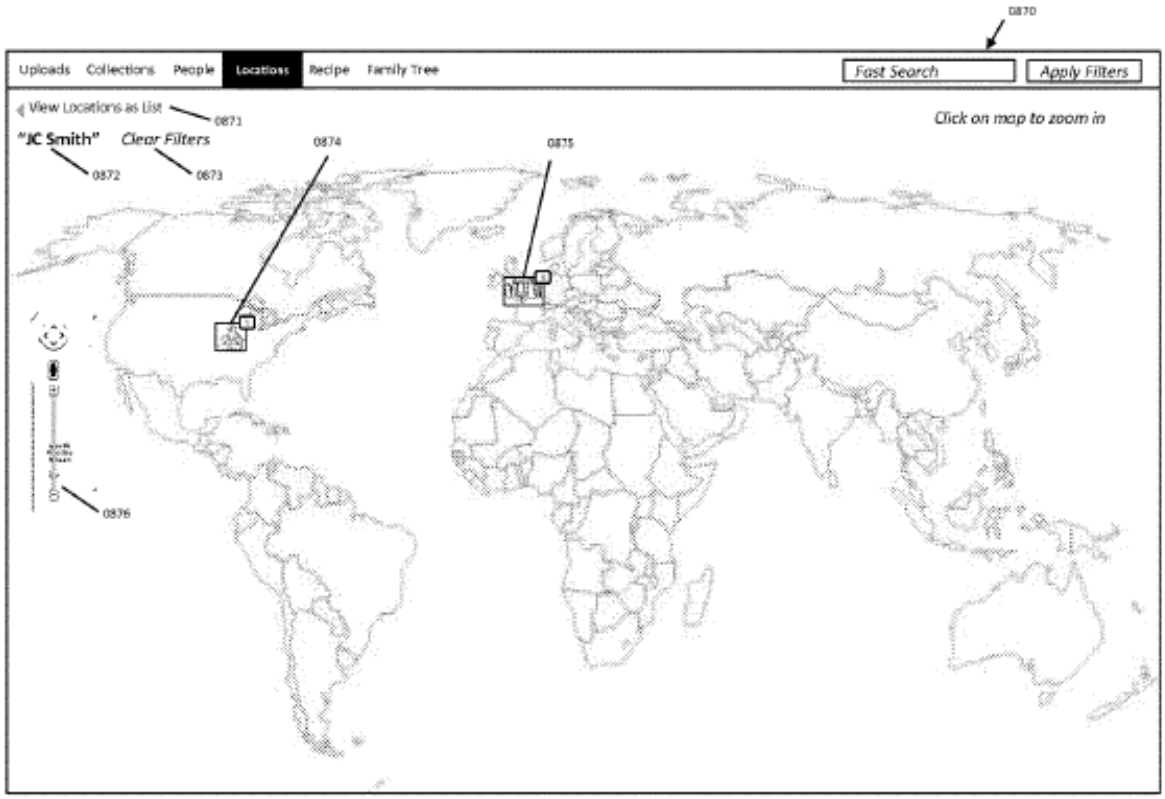
Patent Owner states that "[t]he '658 patent is related to the following U.S. Patents: 9,098,531 ("the '531 patent"); 9,552,376 ("the '376 patent"); 10,621,228 ("the '228 patent"); 11,017,020 ("the '020 patent"); 11,163,823 ("the '823 patent"), and 11,170,042 ("the '042 patent")." Paper 3, 2. Patent Owner additionally identifies the following IPR proceedings as related matters: *Samsung Electronics Co., LTD. v. MemoryWeb LLC,* IPR2022-00221 ('658 patent); *Apple Inc. v. MemoryWeb, LLC,* IPR2022-00111 ('020 patent); *Apple Inc. v. MemoryWeb, LLC*, PGR2022-00006 ('020 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00033 ('658 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 ('376 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 ('658 patent); *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413, ('658 patent); and U.S. Patent Application No. 17/459,933. *Id.* at 2–3.

C. The '658 patent

The '658 patent relates to a computer-implemented system and method for managing and using digital files such as digital photographs. Ex. 1001, 1:16–19. In particular, the '658 patent aims to provide an "interactive platform" for users to gather, organize, view, navigate, search, share and archive Digital Files, e.g., digital photographs and videos. *Id.* at 13:12–18, 13:56–59. The interactive platform may be provided via an "Application" having various "Application Views" for interaction with and organization of Digital Files. *Id.* at 8:59–9:7. A screenshot of an exemplary

type of Application View, a "Location Application View," is shown in Figure 41, reproduced below. *Id.* at 4:3–4.

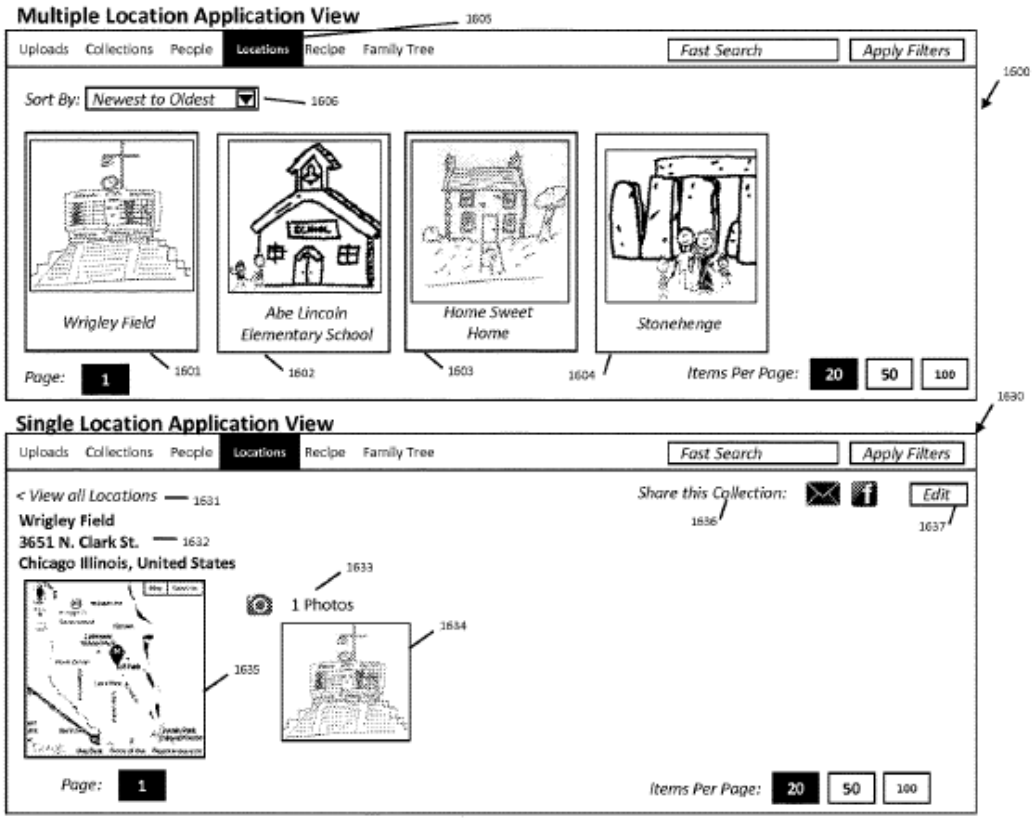
FIG. 41



As shown in the Location Application View interface of Figure 41, "Digital Files are displayed within an interactive map (Google map shown as an example)." *Id.* at 29:25–29. Further, "[i]n this view, individual or groups of Digital Files are illustrated as photo thumbnails (see indicators 0874 and 0875) on the map and the user can select the thumbnail to see all the Digital Files with the same location." *Id.* at 29:32–36. In the case that the user selects either one of the thumbnails, a "Single Location Application View" interface corresponding to the location is presented to the user, as shown in

the bottom portion of Figure 34, a screenshot reproduced below. *Id.*

FIG. 34

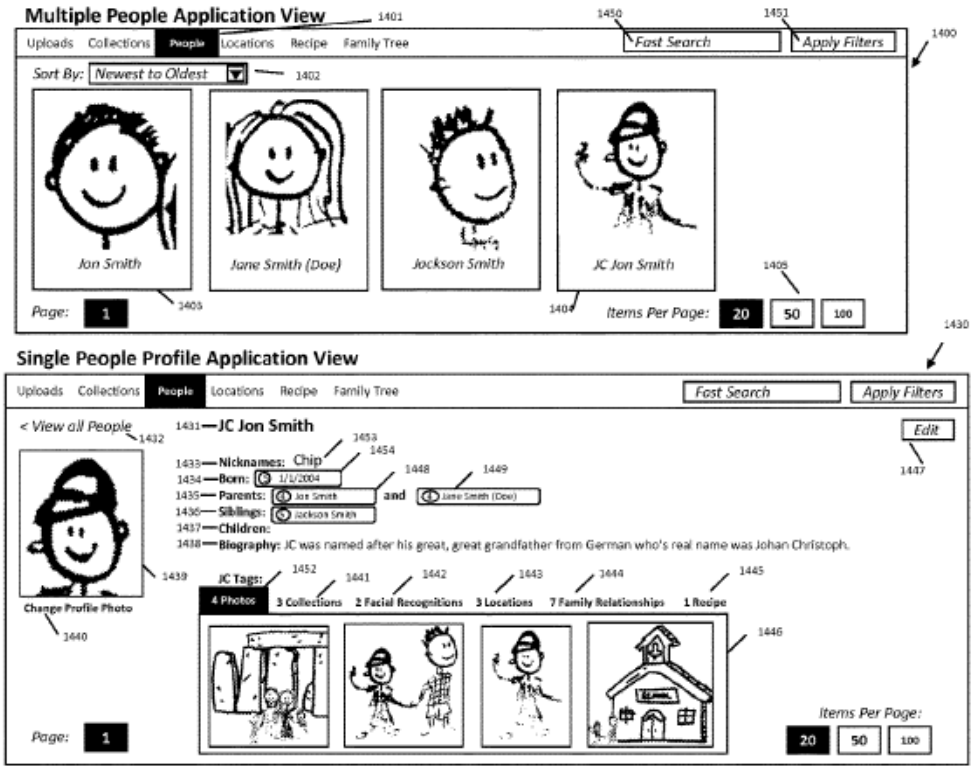


Focusing on the single location (1630) Locations Application View, an "individual location name is displayed at the top of the page (1632)." *Id.* at 24:22–24. The single location Locations Application View further displays "[t]humbnails of each Digital File within the specific collections" of digital files. *Id.* at 24:25–26; *see id.* at 23:56–59, Fig. 33. In the example shown in Figure 34, "one photo (1633) taken at Wrigley Field (1634) that is associated with the location called Wrigley Field" is displayed. *Id.* at 24:26–28.

Turning to another Application View described by the '658 Patent, a "Multiple People Application View" is shown in Figure 32, a screenshot,

reproduced below. *Id.* at 3:58.

FIG. 32



The Multiple People Application View "can be seen by selecting 'People' (1401) from any of the Application Views within the Application." *Id.* at 22:46–48. As shown in Figure 32, "Multiple People Application View" 1400 "display[s] all the people that were created within the user's Application." *Id.* at 22:44–46. "For each person, a thumbnail of their face along with their name is depicted. In this figure, Jon Smith (1403) and JC Jon Smith (1404) along with some other people are illustrated." *Id.* at 22:52–55.

Further, "[f]or each person," there are "tags that are associated to [that] person." *Id.* at 23:4–6. In "Single People Profile Application View" 1430, associated tags are used show that there are, e.g., "four photos (1452) associated with that person." *Id.* at 23:6–9. In another example, the person

"grandma" has been tagged in, and so, is associated with, 100 photos. *Id.* at 24:56–59. Put another way, Digital Files have tags, e.g., in a "Tag Block of the Relationship Table for the Digital File," which associate a particular digital file with a particular person or otherwise characterizes and documents the digital file. *See id.* at 20:1–6; 24:42–52.

D. Illustrative Claims

Petitioner challenges claims 1–15. Pet. 11. Claim 1 is the sole independent claim. Ex. 1001, 35:32–36:11.

Claim 1, with Petitioner's limitation numbering included, is reproduced below.

> [1pre] 1. A computer-implemented method of displaying at least a portion of a plurality of (i) digital photographs, (ii) videos, or (iii) a combination of (i) and (ii), each of the digital photographs and videos being associated with a geotag indicative of geographic coordinates where the respective digital photograph or video was taken, the method comprising:
>
> [1a] displaying an application view on a video display device including displaying a plurality of selectable elements, the plurality of selectable elements including a location selectable element;
>
> [1b] responsive to a click or tap of the location selectable element, displaying a map view on a video display device, the displaying the map view including displaying:
>
> > [1c] (i) a representation of an interactive map;
> >
> > [1d] (ii) a first location selectable thumbnail image at a first location on the interactive map, the first location being associated with the geographic coordinates of a first geotag, a first set of digital photographs and videos including all of the digital photographs and videos associated with the first geotag;
> >
> > [1e] (iii) a first count value image partially overlapping the first location selectable thumbnail image, the first count

value image including a first number that corresponds to the number of digital photographs and videos in the first set of digital photographs and videos;

[1f] (iv) a second location selectable thumbnail image at a second location on the interactive map, the second location being associated with the geographic coordinates of a second geotag, a second set of digital photographs and videos including all of the digital photographs and videos associated with the second geotag; and

[1g] (v) a second count value image partially overlapping the second location selectable thumbnail image, the second count value image including a second number that corresponds to the number of digital photographs and videos in the second set of digital photographs and videos;

[1h] responsive to a click or tap of the first location selectable thumbnail image, displaying a first location view on the video display device, the displaying the first location view including displaying (i) a first location name associated with the first geotag and (ii) a scaled replica of each of the digital photographs and videos in the first set of digital photographs and videos, the displayed scaled replicas of each of the digital photographs and videos in the first set of digital photographs and videos not being overlaid on the interactive map; and

[1i] responsive to a click or tap of the second location selectable thumbnail image, displaying a second location view on the video display device, the displaying the second location view including displaying (i) a second location name corresponding to the second geotag and (ii) a scaled replica of each of the digital photographs and videos in the second set of digital photographs and videos, the displayed scaled replicas of each of the digital photographs and videos in the second set of digital photographs and videos not being overlaid on the interactive map.

Ex. 1001, 35:13–36:7.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–15	103	Okamura,[1] Belitz[2]
3–4	103	Okamura, Belitz, Rasmussen[3]
6–12	103	Okamura, Belitz, Gossweiler[4]
8–9, 11–12	103	Okamura, Belitz, Yee[5]
8–9, 11–12	103	Okamura, Belitz, Gossweiler Yee

Pet. 11. In addition to the references listed above, Petitioner relies on the Declaration of Philip Greenspun, Ph.D. (Ex. 1003). Patent Owner submits a Declaration of Glenn Reinman, Ph.D. (Ex. 2001).

II. ANALYSIS

A. Discretionary Denial Under 35 U.S.C. § 314(a) in Based on Parallel Proceeding

Patent Owner requests that we exercise discretion under 35 U.S.C. § 314(a) to deny institution in view of parallel litigation. Prelim. Resp. 27–34 (citing, *e.g.*, *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*")); Prelim. Sur-reply 1–5.

In accordance with the Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, issued June 21, 2022, we will not deny institution of an IPR under *Fintiv* when the

[1] Okamura et al., U.S. Patent Publication No. 2011/0122153 A1, published May 26, 2011 (Ex. 1005) ("Okamura").
[2] Belitz et al., U.S. Patent Publication No. 2010/0058212 A1, published March 4, 2010 (Ex. 1006) ("Belitz").
[3] Rasmussen, U.S. Patent Publication No. 2006/0206264 A1, published September 14, 2006 (Ex. 1007) ("Rasmussen).
[4] Gossweiler et al., U.S. Patent Publication No. 2008/0276279 A1, published November 6, 2008 (Ex. 1038) ("Gossweiler").
[5] Yee et al., U.S. Patent Publication No. 2009/0210793 A1, published August 20, 2009 (Ex. 1041) ("Yee").

petition presents compelling evidence of unpatentability.[6] "Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence." *Id*. at 4.

For the reasons discussed in Section F below, the instant Petition presents compelling evidence of unpatentability. Accordingly, we decline to exercise our discretion under § 314(a) to deny institution.

B. Level of Ordinary Skill in the Art

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends that a person of ordinary skill in the art at the time of the invention of the '658 patent would have had the following education and experience:

> (1) a bachelor's degree in computer science, computer engineering, electrical engineering, or a related field, and (2) at least one year of experience designing graphical user interfaces for applications such as photo organization systems. []Additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.

[6] Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation at 4–5 (Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

Pet. 12 (citing Ex. 1003 ¶ 27). Patent Owner does not challenge this definition of the level of skill at this time. Prelim. Resp. 45.

For purposes of this Decision, we also adopt Petitioner's proposal as reasonable and consistent with the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art).

C. Claim Construction

For petitions filed on or after November 13, 2018, the "broadest reasonable interpretation" standard has been replaced with the federal court claim construction standard that is used to construe a claim in a civil action under 35 U.S.C. § 282(b). This is the same claim construction standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny.

Neither Petitioner nor Patent Owner provide any explicit construction of any claim terms. Pet. 11–12, Prelim. Resp. 45–46. At this stage of this proceeding we determine that no claim terms require express construction in order to determine whether or not to institute *inter partes* review because doing so would have no effect on the analysis below. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) ("[W]e need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy.'") (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

D. Overview of the Asserted Prior art

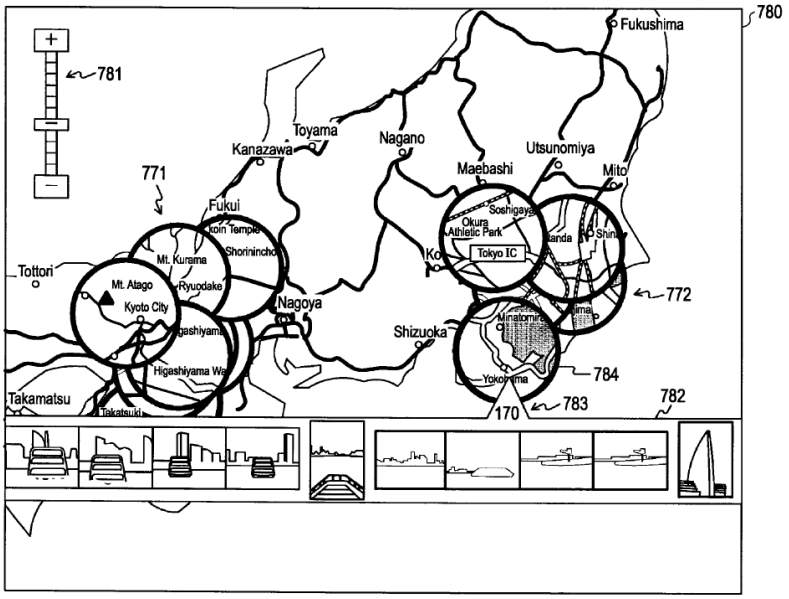
1. Okamura

Okamura is a U.S. Patent Publication titled, "Information Processing Apparatus, Information Processing Method, and Program," published May 26, 2011. Ex. 1005, codes (43), (54). Okamura describes an information

processing apparatus which displays contents such as image files. Ex. 1005 ¶ 2. Okamura's information processing apparatus also allows managing of contents such as recorded image files. *Id.* ¶ 91.

Figure 41, reproduced below, shows an embodiment of a display of Okamura that includes a map view screen.

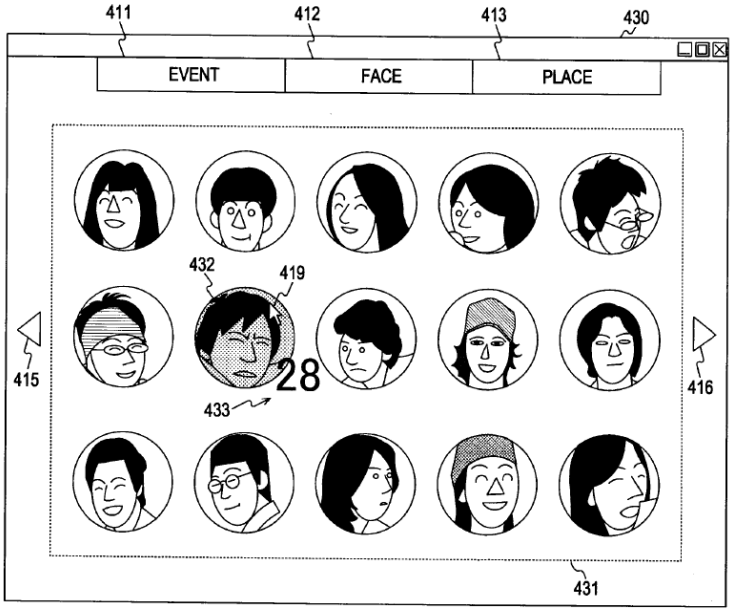
FIG. 41



Id. Fig. 41, ¶ 61. As shown in Figure 41, map view screen 780 displays a map including cluster map groups 771, 772. *Id.* A user can change the scale of map view screen 780 and can select a desired cluster map such that a listing of its contents is displayed in content listing display area 782. *Id.* Fig. 41, ¶¶ 355–56. For example, cluster map 784 within cluster map group 772 is selected to show it has 170 contents that can be displayed in content listing display area 782. *Id.* Fig. 41, ¶ 356. Overlapping cluster maps are spread out in accordance with a predetermined condition such that "graphical correspondence between contents may be intuitively grasped." *Id.* Fig. 41, ¶ 358.

Figure 21, reproduced below, shows another embodiment of a display of Okamura that includes an index screen.

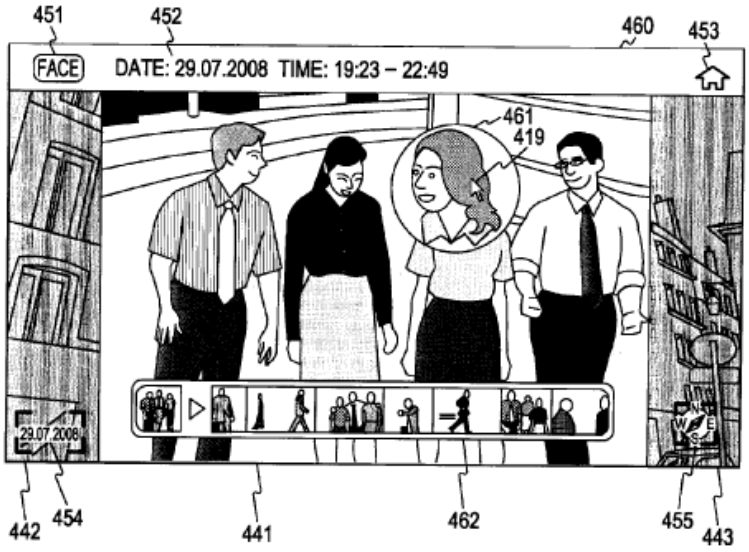
FIG. 21



Id. Fig. 21, ¶ 41. As shown in Figure 21, an index screen displays indexed images generated on the basis of face information. *Id.* Fig. 21, ¶ 234. The index screen includes cursor 419 for pointing to an object of instruction or operation on the screen. *Id.* Fig. 21, ¶ 234. The index screen includes "EVENT" tab 411, "FACE" tab 412, and "PLACE" tab 413 that are used for displaying a different index screen. *Id.* Fig. 21, ¶¶ 235–36. Okamura discloses that in the face cluster image display area 431 shown in Figure 21, images representing face clusters are displayed such that "an image representing a face cluster, for example, a thumbnail image of each of faces included in contents belonging to the face cluster can be used" by extracting faces and contents belonging to the face cluster. *Id.* Fig. 21, ¶ 246. For example, thumbnail image 432 in face cluster image display area 431 has 28 contents indicated for its pieces of information 433, that can be accessed by a user. *Id.* Fig. 21, ¶ 247.

Figure 24, reproduced below, shows another embodiment of a display of Okamura that includes a content playback screen.

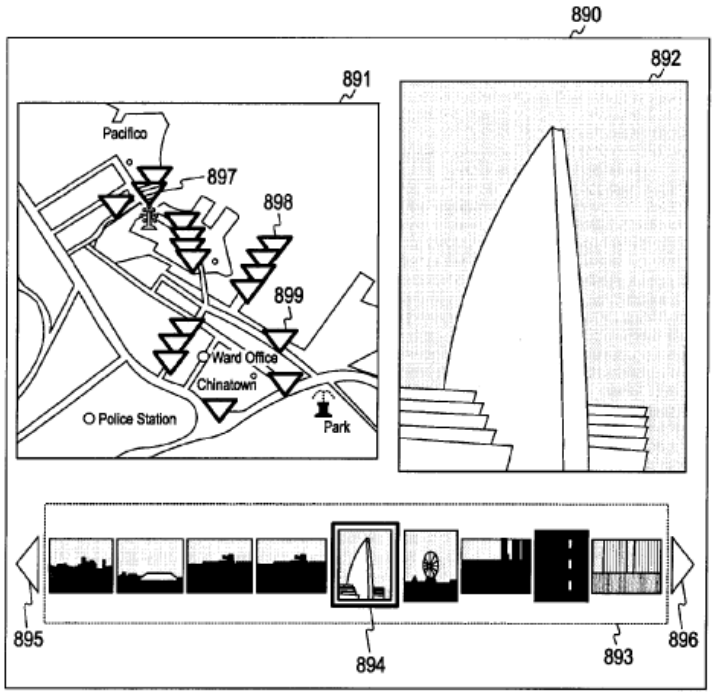
FIG. 24



Id. Fig. 24, ¶ 44. As shown in Figure 24, content playback screen 460 can be displayed "when the mouse is placed over the face portion" in another content playback screen. *Id.* Fig. 24, ¶ 261. Content playback screen 460 includes image 461 of the vicinity of the face displayed in magnified form and content listing display area 462 in content display area 411. *Id.* Fig. 24, ¶ 261. Content listing display area 462 shows a listing of contents included in the face cluster (from Figure 21 for example) and also thumbnail images of the content. *Id.* Fig. 24, ¶ 261.

Figure 50, reproduced below, shows another embodiment of a display of Okamura that includes a play view screen.

FIG. 50



Id. Fig. 50, ¶ 70. As shown in Figure 50, play view screen 890 shows "images related to a cluster corresponding to the cluster map on which a determining operation has been made are displayed," including "a listing of contents belonging to the cluster, a content's magnified image, and the like." *Id.* Fig. 50, ¶ 440. Play view screen 890 includes map display area 891, magnified image display area 892, and content listing display area 893. *Id.* Fig. 50, ¶ 441. Map display area 891 includes a map related to the corresponding cluster with marks indicating the generated positions of contents belonging to the corresponding cluster. *Id.* Fig. 50, ¶ 442. Content listing display area 893 shows a listing of contents belonging to the corresponding cluster which are displayed as thumbnails. *Id.* Fig. 50, ¶ 444. Magnified image display area 892 includes an image corresponding to the content selected from box 894 of the content listing display area 893, which is displayed in magnified form. *Id.* Fig. 50, ¶ 443.

2. Belitz

Belitz is a U.S. Patent Publication titled, "User Interface, Device and Method for Displaying Special Locations on a Map," published March 4, 2010. Ex. 1006, codes (43), (54). Belitz describes clustered locations on a map for a user to overview associated images to special locations so that the user can "clearly see the associations." Ex. 1006 ¶¶ 1, 4.

Belitz relates to a "user interface . . . configured to display a map and to display at least one marked location on said map." Ex. 1006, code (57). By way of background, Belitz explains that "[i]t is common to mark special locations on a map by associating a graphical object with that location. Examples of such locations are service points, restaurants, tourist attractions, visited places etc[.] and examples of graphical objects are photographs taken at such a location." *Id.* ¶ 2. Belitz further explains "[i]f many locations are located close to one another they overlap and the view of the associated images become cluttered and it is difficult to discern between the various objects and the user is not provided with a good view of what location is associated with what." *Id.* Belitz presents a user interface attempting to address those concerns. *Id.* ¶ 5. Figures 4a and 4b, reproduced below, show screenshots of the user interface. *Id.* ¶¶ 51, 55.

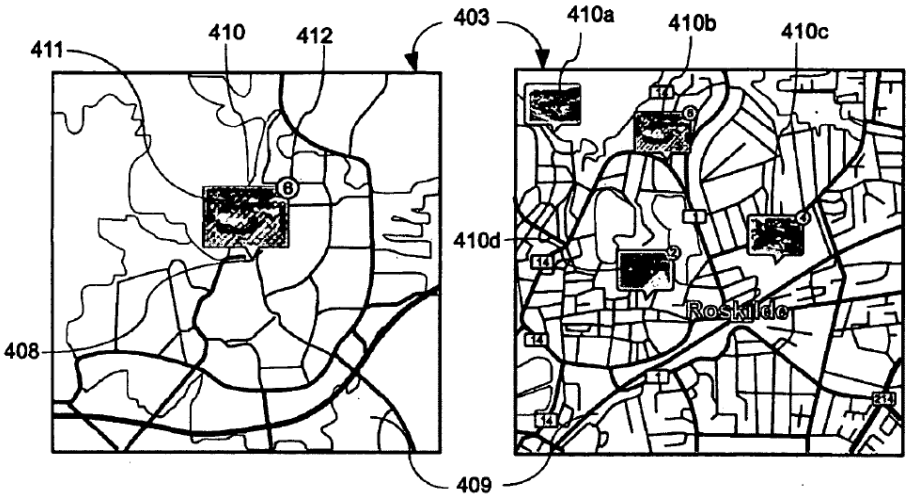


Fig. 4a Fig. 4b

As shown in Figure 4a, a "map 409 is displayed of a town called Roskilde. A location 408 is marked by a graphical object 410." *Id.* ¶ 51. "[G]raphical object 410 has a visual representation 411 which in this embodiment is a photograph that is associated with the location." *Id.* ¶ 52. Furthermore, "graphical object 410 carries a number indicator 412 which presents a viewer with a number. The number indicates how many graphical objects 410 are associated with that location and are stacked into one graphical object 410." *Id.* ¶ 54. Furthermore, "graphical objects stacked in the displayed graphical object or graphical group object 410 . . . can be associated with other locations that are in close proximity to the marked location 408" because "if the graphical objects associated with each location were to be displayed separately they would overlap which would clutter the view and be confusing to a user." *Id.*

Figure 4b shows map 408 having been "zoomed in showing the area in greater detail." *Id.* ¶ 55. At this zoom level, graphical object 410 is "split up into 4 graphical objects 410*a*, 410*b*, 410*c* and 410*d*" because the display of those graphical objects would not overlap. *Id.* Those graphical objects themselves also consist of some number of graphical objects. *Id.*

When a graphical object, e.g., graphical object 410, 410a, 410b, 410c, or 410d, is selected, a popup window is displayed over the graphical object. *Id.* ¶ 60. Figure 4c, reproduced below, is a screenshot showing the user interface after the selection of graphical object 410c. *Id.*

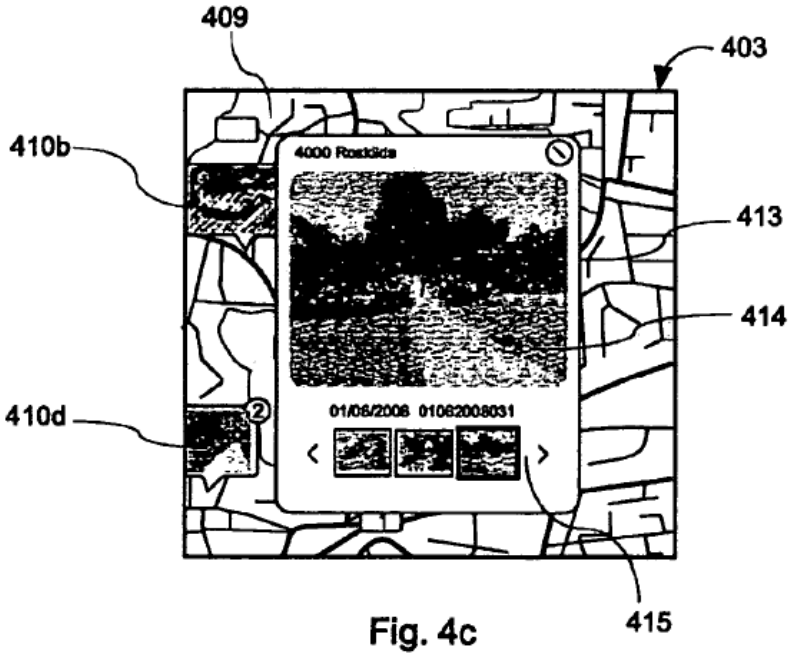


Fig. 4c

As shown in Figure 4c, the "popup window shows at least some of the visual representations 411 of the graphical object 410*c*." Ex. 1006 ¶ 60. "One 414 of the visual representations 411 or images as they are in this embodiment is shown in a larger size than the others which are shown in a list 415." *Id.* In some embodiments, "graphical objects are photographs that are associated with the location where they were taken. The visual representations are thumbnails of the photographs." *Id.* ¶ 62.

E. *Principles of Law*

A petition must show how the construed claims are unpatentable under the statutory grounds it identifies. 37 C.F.R. § 42.104(b)(4). Petitioner bears the burden of demonstrating a reasonable likelihood that it

would prevail with respect to at least one challenged claim for a petition to be granted. 35 U.S.C. § 314(a).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Secondary considerations may include long-felt but unsolved need, failure of others, unexpected results, commercial success, copying, licensing, and praise. *See Graham*, 383 U.S. at 17–18; *Leapfrog Enters., Inc. v. Fisher–Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). We analyze the asserted grounds with these principles in mind.

F. Obviousness under 35 U.S.C. § 103

Petitioner contends that claims 1–15 are unpatentable over combination of Okamura and Belitz. Pet. 21–103. Patent Owner disputes Petitioner's contentions. Prelim. Resp. 35–53.

1. Independent Claim 1

For each limitation of claim 1, Petitioner asserts that Okamura alone or in combination with Belitz meets that limitation. Pet. 34–64. Petitioner also provides the testimony of Dr. Greenspun, in support of its position with respect to the limitations of claim 1. Ex. 1003 ¶¶ 99–148. Patent Owner does not contest Petitioner's findings for every limitation. For the

uncontested limitations, we have considered Petitioner's evidence and arguments with respect to these limitations, including the relevant testimony of Dr. Greenspun and find it to be sufficient to show that Petitioner has demonstrated a reasonable likelihood of prevailing in showing that Okamura, either alone or in combination with Belitz, discloses them. Accordingly, we focus our discussion on the contested limitations and Patent Owner's argument that "Petitioner has not shown that it would have been obvious to modify Okamura with Belitz in any of the ways suggested in the Petition." Prelim. Resp. 34.

a. Displaying of the "Map View" As Required by Limitations [1b]–[1d]and [1f][7]

Petitioner asserts that "Okamura discloses a map view that displays cluster maps on a map for a user 'to intuitively grasp the geographical correspondence between the cluster maps.'" Pet. 38 (citing Ex. 1005 ¶ 312). Petitioner asserts that "Okamura's map view screen is 'a display screen that displays cluster maps in an overlaid manner on a map, and corresponds to the map view screen 780 shown in FIG. 41.'" *Id.* (citing Ex. 1005 ¶ 431; Ex. 1003 ¶ 107). In addition, Petitioner asserts that Okamura's "*clusters* a[re] 'thumbnail' images of a portion of a map" and "to the extent that the location-based *clusters* in Okamura's map view are not 'thumbnail image[s]' as claimed, a POSITA[8] would have been motivated to combine Okamura and Belitz such that Okamura's map view displays selectable thumbnail images as disclosed in Belitz to obtain additional benefits." *Id.* at 22–23

[7] As labeled by Patent Owner in its Preliminary Response.
[8] Person of ordinary skill in the art.

(citing Ex. 1005 ¶¶ 135, 221–223, 229–231; Ex. 1003 ¶ 86) (emphasis added).

b. First Combination of Okamura and Belitz

Petitioner asserts that a person of ordinary skill in the art "would have understood that selectable graphical clusters would have been obvious to replace with 'smaller versions of the captured images (e.g., thumbnail images).'" Pet 25 (citing Ex. 1021 ¶ 30). According to Petitioner, "[o]rganizing digital files using location selectable thumbnails would achieve Okamura's objective of 'managing contents.'" *Id.* at 24 (citing Ex. 1005 ¶ 91. In addition, Petitioner contends that a person of ordinary skill in the art

> would have understood that Belitz's thumbnail images displayed on the interactive map are functionally equivalent to Okamura's location-based clusters ((1) both Belitz's thumbnail images and Okamura's clusters are associated with a given location, (2) both are displayed on the interactive map, and (3) both are dynamically generated/modified based on user interaction including zooming in/out on the map) and could be used as an alternative to the clusters on Okamura's map view screen.

Id. (citing Ex. 1003 ¶ 88). Thus, according to Petitioner a person of ordinary skill in the art would have found it obvious "to incorporate Belitz's thumbnail images (including a count indicator) to provide added functionality that allows a user to preview pictures associated with a given location." *Id.* at 24–25 (citing Ex. 1006 ¶ 25).

Petitioner provides further reasoning in support of the proposed combination on pages 38–39 of the Petition.

Patent Owner contends that Petitioner "has not met its burden" for limitations [1b]–[1d] and [1f]. Prelim. Resp. 36. Specifically, Patent Owner contends that "the intended purpose of the cluster maps in Okamura are to allow 'the position corresponding to each cluster' to 'be grasped from a map corresponding to each cluster.'" *Id.* at 37 (citing Ex. 1005 ¶ 215; Ex. 2001 ¶ 96). According to Patent Owner, "[e]ach cluster map's scale is selected so that 'the shooting area or the like of each of [the] contents belonging to each cluster can also be easily grasped by the user.'" *Id.* at 37–38. Patent Owner contends further that "[u]nlike the cluster maps in Okamura, the graphical objects 410a-410d from Belitz in and of themselves do not convey geographical information." *Id.* at 38 (citing Ex. 2001 ¶ 97). Thus, according to Patent Owner, "[i]f the cluster maps in FIG. 41 of Okamura were replaced with graphical objects 410a-410d from Belitz, this both entirely eliminates the cluster map information and also covers the underlying map." *Id.* (citing Pet. 23; Ex. 2001 ¶ 97). Patent Owner argues that "[t]his is contrary to Okamura's objectives of using cluster maps so that (1) 'the position corresponding to each cluster can be grasped from a map corresponding to each cluster' and (2) 'the shooting area or the like of each of [the] contents belonging to each cluster can also be easily grasped by the user.'" *Id.* (citing Ex. 1005 ¶ 215; Ex. 2001 ¶ 97).

In addition, Patent Owner contends that in the combination proposed by Petitioner, at least some of the graphical objects would overlap on the map and this is contrary to Belitz's teachings. Prelim. Resp. 38–39. Patent Owner argues that "Belitz teaches that [the] graphical objects should not touch or even be close to one another because otherwise this 'would clutter the view and be confusing to a user'" and, thus, a person of ordinary skill in the art would be discouraged from combining Okamura and Belitz in the

manner proposed in the Petition. *Id.* at 39 (citing Ex. 1006 ¶¶ 54–58; Ex. 2001 ¶¶ 94–95).

We do not understand Petitioner's proposed combination to replace Okamura's cluster maps with Belitz's graphical objects. Rather, we understand Petitioner's challenge to replace Okamura's location-based clusters with Belitz's thumbnails. On the record before us, we agree with Petitioner that such modification "involves the simple substitution of one known user interface element (Okamura's clusters) with another known user interface element (Belitz's thumbnails), which would have been routine" for a person of ordinary skill in the art." Pet. 29. Thus, Petitioner has sufficiently demonstrated, for purposes of institution, that a person of ordinary skill in the art would have combined Okamura and Belitz in the manner proposed in its first combination.

c. Second Combination of Okamura and Belitz

Petitioner asserts that a person of ordinary skill in the art "would have found it obvious to substitute Okamura's map-related views with Belitz's interactive map for the same reasons described above including the user's increased awareness of digital files associated with various locations." Pet. 26 (citing Ex. 1005 ¶¶ 354–356, 430, Fig. 49; Ex. 1006 ¶¶ 51–53, 62, Fig. 4). As we find that Petitioner has sufficiently demonstrated, for purposes of institution, that a person of ordinary skill in the art would have combined Okamura and Belitz in the manner proposed in its first combination, we need not address Petitioner's proposed second combination.

2. Dependent Claims 2–15

We have reviewed Petitioner's contentions regarding the limitations of claims 2–15 as set forth in the Petition and determine that for purposes of institution they are adequately supported by the evidence. Pet. 65–103.

Patent Owner does not present separate arguments for these claims. Prelim. Resp. 52. Thus, we find on this record that Petitioner has made a sufficient showing for purposes of institution that Okamura and Belitz disclose or suggest each limitation of claims 2–15.

3. Conclusion

For the foregoing reasons, and on the record presently before us, we determine that the Petition presents compelling evidence of unpatentability, such that Petitioner has demonstrated a reasonable likelihood of prevailing in demonstrating that claims 1–15 of the '658 patent would have been obvious over Okamura and Belitz.

G. Compliance with 37 C.F.R. § 42.8(b)(2)

Patent Owner contends that the Petition does not comply with 37 C.F.R. § 42.8(b)(2). Prelim. Resp.52–53.

Patent Owner asserts that "[w]hile the Petition identifies certain related judicial matters (Petition, 109), it fails to identify several related administrative matters, including related U.S. Patent Nos. 9,098,531, 9,552,376, 10,6213,228 ("the '228 patent"), 11,017,020, 11,163,823 ("the '823 patent"), and 11,170,042." Prelim. Resp. 53

As noted by Patent Owner, Petitioner identifies the related district court proceedings in which these patents are asserted. Patent Owner has not explained how Petitioner's failure to identify these patents prejudices its position in this proceeding. Accordingly, we do not find Petitioner's failure to identify these patents to be sufficient grounds to deny the instant petition.

III. CONCLUSION

After considering the evidence and arguments presented in the Petition and the Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least

one of the challenged claims, and thus, we institute an *inter partes* review of all challenged claims on all presented challenges. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to require "a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition").

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–15 of U.S. Patent No. 10,621,658 B2 is instituted with respect to all the grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 10,423,658 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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