

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00222
Patent 10,621,228 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 1–19 of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 patent”). Patent Owner, MemoryWeb, LLC, filed a Preliminary Response (Paper 8, “Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply to Patent Owner’s Preliminary Response (Paper 9, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 10, “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. 92. Patent Owner states that it, MemoryWeb, LLC, is the real party in interest. Paper 4, 2.

B. *Related Matters*

The parties state that the ’228 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. 92; Paper 4, 2.

Petitioner states that “[t]he ’228 patent is also the subject of two IPR proceedings, one filed by Unified Patents LLC (IPR2021-01413) and another filed by Apple Inc. (IPR2022-00031)” but that “Samsung is not a real party-in-interest to [these] IPR proceedings.” Pet. 92.

Patent Owner states that “[t]he ’228 patent is related to the following U.S. Patents: 9,098,531 (“the ’531 patent”); 9,552,376 (“the ’376 patent”); 10,423,658 (“the ’658 patent”); 11,017,020 (“the ’020 patent”); 11,163,823 (“the ’823 patent”), and 11,170,042 (“the ’042 patent”).” Paper 4, 2.

Subsequently, Patent Owner identifies the following IPR proceedings as related matters: *Samsung Electronics Co., LTD. v. MemoryWeb LLC*, IPR 2022-00221 (’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 (’228 patent); *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413, (’228 patent); and U.S. Patent Application No. 17/459,933. *Id.* at 2–3.

C. The ’228 patent

The ’228 patent, titled “Method and Apparatus for Managing Digital Files,” issued April 14, 2020. Ex. 1001, codes (45), (54). It “relates generally to the management of digital files and, more particularly, to a computer-implemented system and method for managing and using digital files such as digital photographs.” *Id.* at 1:21–24. The ’228 patent purports to resolve a need for complementing “the widespread availability of digital files” by providing “a medium that allows people to organize, view, preserve

and share these files with all the memory details captured, connected and vivified via an interactive interface.” *Id.* at 1:61–65.

Figure 41 of the '228 patent is reproduced below.

FIG. 41

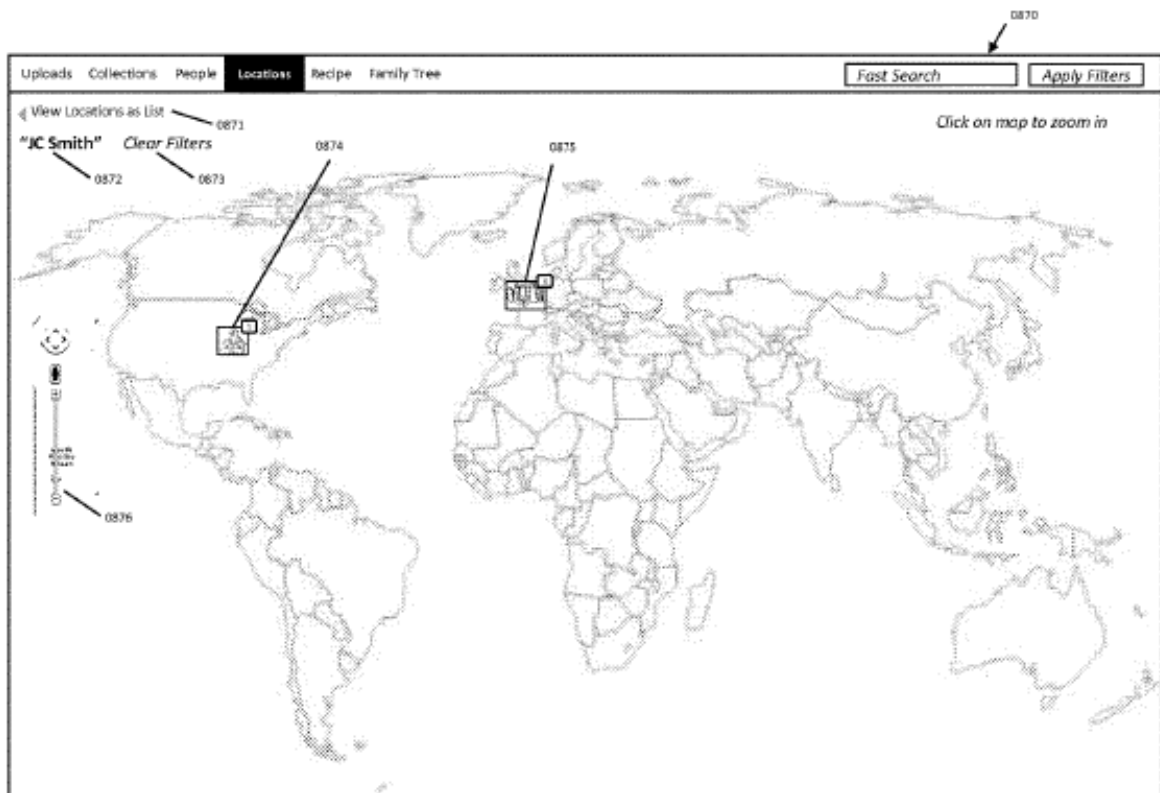


Figure 41 shows a screenshot of a Single Application Dot-Tag Filter in Location Application View that allows a user's access to digital files associated with a particular location. *Id.* at 4:7–8, 29:41–57. As shown in Figure 41, Location Application View 0870 displays Digital Files within an interactive map. *Id.* at Fig. 41, 29:41–44. Individual or groups of Digital Files are illustrated as photo thumbnails 0874, 0875 on the map and a user can zoom in and out or select the thumbnail to see all the Digital Files with the same location as depicted in Figure 34 below. *Id.* at Fig. 41, 29:48–55.

Figure 34 of the '228 patent is reproduced below.

FIG. 34

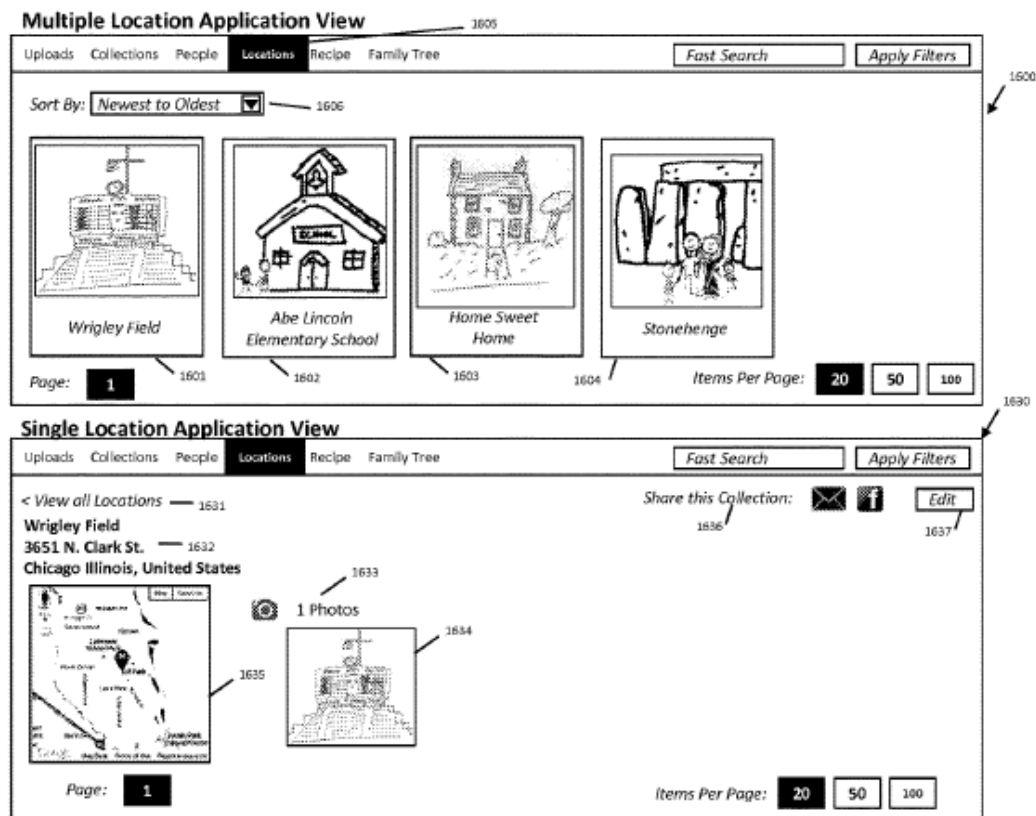


Figure 34 shows a screenshot of Location Application Views. *Id.* at 3:64. As shown in Figure 34, Location Application Views include a first Multiple Location Application View 1600 for displaying all the locations that were created within a user's Application. *Id.* at Fig. 34, 24:16–19. A second Single Location Application View 1630 is displayed when one of the thumbnails, for example, photo thumbnail 0874 from the Location Application View 0870 in Figure 41 is selected. *Id.* at Fig. 34, 29:48–52. In this example, displayed in the Single Location Application View 1630 are the individual location name 1632, thumbnails of each Digital File within specific collections such as one photo 1633 taken at Wrigley Field 1634 that is associated with the location called Wrigley Field. *Id.* at Fig. 34, 24:37–43.

Figure 32 of the '228 patent is reproduced below.

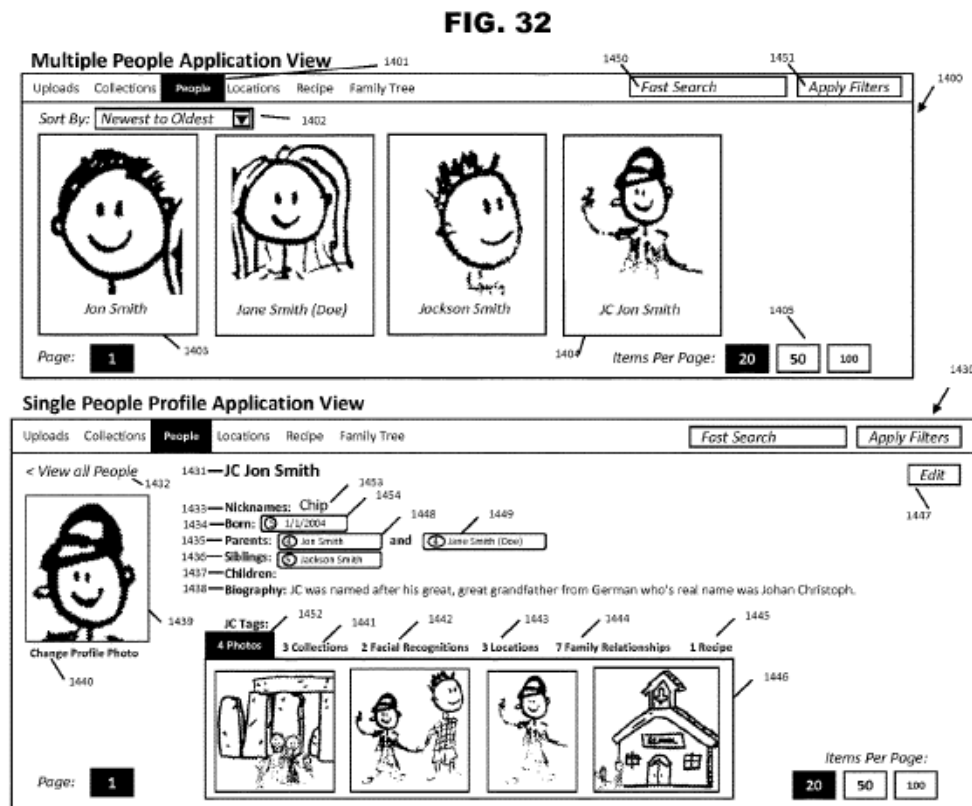


Figure 32 shows a screenshot of People Application Views. *Id.* at 3:62. As shown in Figure 32, People Application Views include a first Multiple People Application View 1400 for displaying all the people that were created within a user's Application, and can be selected by a user "from any Application Views within the Application." *Id.* at Fig. 32, 22:59–64. For each person, such as for Jon Smith as an example, a thumbnail 1403 for that person is shown. *Id.* at Fig. 32, 23:1–5. A second Single People Profile Application View 1430 can be displayed. *Id.* at Fig. 32, 23:12–13. This example shows individual JC Jon Smith with the following information depicted: individual's name 1431, profile photo 1440 that can be changed, and a number of photos 1452 associated with that person along with thumbnail 1446 of each photo. *Id.* at Fig. 32, 23:13–25.

D. Challenged Claims

Petitioner challenges claims 1–19. Pet. 1. Claim 1 is the sole independent claim. Ex. 1001, 35:32–36:11.

Claim 1 is reproduced below.

1. A method comprising:

responsive to a first input, causing a map view to be displayed on an interface, the map view including:

- (i) an interactive map;
- (ii) a first location selectable thumbnail image at a first location on the interactive map; and
- (iii) a second location selectable thumbnail image at a second location on the interactive map;

responsive to an input that is indicative of a selection of the first location selectable thumbnail image, causing a first location view to be displayed on the interface, the first location view including (i) a first location name associated with the first location and (ii) a representation of at least a portion of one digital file in a first set of digital files, each of the digital files in the first set of digital files being produced from outputs of one or more digital imaging devices, the first set of digital files including digital files associated with the first location;

responsive to an input that is indicative of a selection of the second location selectable thumbnail image, causing a second location view to be displayed on the interface, the second location view including (i) a second location name associated with the second location and (ii) a representation of at least a portion of one digital file in a second set of digital files, each of the digital files in the second set of digital files being produced from outputs of the one or more digital imaging devices, the second set of digital files including digital files associated with the second location; and

responsive to a second input that is subsequent to the first input, causing a people view to be displayed on the interface, the people view including:

- (i) a first person selectable thumbnail image including a representation of a face of a first person, the first person being associated with a third set of digital files including digital photographs and videos;

- (ii) a first name associated with the first person, the first name being displayed adjacent to the first person selectable thumbnail image;
- (iii) a second person selectable thumbnail image including a representation of a face of a second person, the second person being associated with a fourth set of digital files including digital photographs and videos; and
- (iv) a second name associated with the second person, the second name being displayed adjacent to the second person selectable thumbnail image.

Ex. 1001, 35:32–36:11.

E. Asserted Ground of Unpatentability

Petitioner asserts the following ground of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–19	103	Okamura, ¹ Belitz ²

Pet. 1. In addition to the references listed above, Petitioner relies on the Declaration of Philip Greenspun, PhD (Ex. 1003). Patent Owner submits a declaration of Glenn Reinman, PhD (Ex. 2001).

II. ANALYSIS

A. Discretionary Denial Under 35 U.S.C. § 314(a) Based on Other IPR Petitions

Patent Owner requests that we exercise discretion under 35 U.S.C. § 314(a) to deny institution in light of other IPR petitions filed against the '228 patent. Prelim. Resp. 27–38 (citing, *e.g.*, *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential) (“*General Plastic*”)); Prelim. Sur-reply 1–2.

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”).

Under 35 U.S.C. § 314(a), the Director has discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). As with other non-dispositive factors considered for institution under § 314(a), the Board weighs factors as part of a “balanced assessment of all relevant circumstances in the case, including the merits.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 58 & n.2 (Nov. 2019), <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“CTPG”) (discussing follow-on petitions and parallel proceedings).

In *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board articulated a non-exhaustive list of factors to be considered in determining whether to exercise discretion under § 314(a) to deny a petition that challenges the same patent as a previous petition. IPR2016-01357 (PTAB Sept. 6, 2017) (precedential), slip op. 9–10. The *General Plastic* factors follow:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and

7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Id.

General Plastic involved a series of petitions challenging the same patent as a previous series of petitions filed by the same petitioner. IPR2016-01357, Paper 19 at 2–3 (PTAB Sept. 6, 2017) (precedential). As noted by Patent Owner, “[t]he Board has extended the first [*General Plastics*] factor to different but related petitioners as well as unrelated petitioners” when the second petitioner is related to the first petitioner and when the second petitioner used the first petition as a roadmap for its petition. Prelim. Resp. 29 (citing *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00062, Paper 11 (Apr. 2, 2019) (precedential) (“*Valve I*”); *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00064, Paper 10 (May 1, 2019) (“*Valve II*”); *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 at 12 (Mar. 17, 2020)).

Patent Owner asserts that Petitioner is related to the prior petitioners, Unified Patents and Apple, because “[b]oth Apple and Samsung are members of Unified Patents.” Prelim. Resp. 30 (citing Ex. 2005 ¶¶ 15, 19–21, 23). Patent Owner also asserts “that Samsung used at least the Apple petition as roadmap for its own petition, as evidenced by the fact that arguments and exhibits in the Samsung petition are identical or nearly identical to arguments and exhibits in the Apple petition.” *Id.* at 33.

Petitioner argues that it “is separate and unrelated to prior petitioners Unified and Apple.” Prelim. Reply 1. (citing Pet. 82–83). Petitioner contends that it is “unable to direct or control Unified and Apple, the parties are differently situated and have divergent interests” and that “a settlement between any one of the petitioners and MemoryWeb would not extinguish

the disputes for the other non-settling petitioners, and as a result, each non-settling party would still need to protect its own interests.” *Id.* at 1–2.

Petitioner also argues that it did not use the earlier petitions as a roadmap. *Id.* at 2. In support, Petitioner contends that “any suggestion of an unfair tactical advantage is illusory” and that “it is not surprising that similar arguments may arise when mapping excellent prior art (*e.g.*, Okamura for Samsung and A3UM for Apple) to identical claim limitations.” *Id.*

On the record before us, we agree with Petitioner that it is not related to Unified Patents or Apple because there is no evidence that it controls Unified Patents or Apple and its interests differ from Unified Patents and Apple. Pet. 82–83. Further, we agree with Petitioner that there is no evidence that it used the prior petitions as a roadmap because the instant Petition relies upon a different combination of prior art references than the prior petitions and because, in the case of Unified Patents’ petition, it challenges a different set of claims.

The facts of this case are distinguishable from the facts of *Valve I*, *Valve II*, and *Ericson*. We decline to extend *General Plastic* to cover the facts of this case and need not consider the *General Plastic* factors further. According, we do not exercise discretion under 35 U.S.C. § 314(a) to deny institution of the instant Petition based on the filing of other IPR petitions challenging the ’228 patent.

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

Patent Owner also requests that we exercise discretion under 35 U.S.C. § 314(a) to deny institution in view of parallel litigation. Prelim. Resp. 39–45 (citing, *e.g.*, *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019,

Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”)); Prelim. Sur-reply 2–4.

Fintiv sets forth the factors that we weigh in determining whether to exercise our discretion to deny institution of the *inter partes* review proceeding here under 35 U.S.C. § 314(a). *See Fintiv*, Paper 11 at 5–6.

These factors are:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. “[T]he Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

For the reasons discussed below, we decline to exercise our discretion to deny institution under 35 U.S.C. § 314(a).

1. *Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.*

Fintiv Factor 1 recognizes that a stay of litigation pending resolution of a PTAB trial allays concerns about inefficiency and duplication of efforts,

which strongly weighs against exercising the authority to deny institution. *Fintiv*, Paper 11 at 6.

No motion for stay has been filed in the co-pending district court case. Pet. 88; Prelim. Resp. 40. Both parties assert that this factor is neutral. *Id.* We agree that this factor does not weigh for or against denying institution.

2. *Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision.*

Fintiv Factor 2 looks to the “proximity of the court’s trial date to the Board’s projected statutory deadline.” *Fintiv*, Paper 11 at 9. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Id.*

Petitioner asserts that the earliest trial date is June 3, 2022. Pet. 88. Patent Owner admits that “[t]he statutory deadline for the final written decision will be approximately the same time as the trial (June 30, 2023)” and submits that this factor is neutral. Prelim. Resp. 41 (citing Ex. 1030, 5). Given the proximity between the earliest trial date and the statutory deadline for our final written decision, we agree with Patent Owner that this factor does not weigh for or against denying institution.

3. *Investment in the parallel proceeding by the court and the parties.*

Fintiv Factor 3 considers the “investment in the parallel proceeding by the court and parties,” including “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9.

Patent Owner asserts that “there will be significant investment in the parallel proceedings by the Court and [itself] before the institution decision

deadline,” because “the court has scheduled its *Markman* hearing for June 3, 2023, which is prior to the Board’s deadline for issuing the institution decision concerning this petition.” Prelim. Resp. 42 (citing Ex. 1030). Petitioner disagrees noting that as of the time of filing of the instant Petition, “[n]o substantive orders have been issued by the court, no depositions have been taken, and fact and expert discovery have not begun.” Pet. 89.

Although, the Markman hearing is scheduled to be held before we issue this decision, much work —such as fact and expert discovery— still remains to be done in the district court case. Ex. 1030, 3–5. Thus, we conclude that this factor weighs against exercising discretion to deny institution.

4. *Overlap between issues raised in the petition and in the parallel proceeding.*

Fintiv Factor 4 considers whether “the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 12. If the issues in the Petition overlap substantially with those raised in the parallel proceeding, “this fact has favored denial.” *Id.* “Conversely, if the petition includes materially different grounds, arguments, and/or evidence . . . this fact has tended to weigh against exercising discretion to deny institution.” *Id.* at 12–13.

Concerns about the degree of overlap may be mitigated where a petitioner agrees not to pursue in the parallel district court litigation the grounds advanced in the petition. *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 11–12, 12 n.5 (PTAB June 16, 2020) (informative). A petitioner stipulating not to pursue “any ground raised or that could have been reasonably raised” weighs

strongly in favor of not exercising discretionary denial. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”).

Petitioner asserts that it “has eliminated risk of duplicated effort by voluntarily stipulating to counsel for [Patent Owner] that, if the Board institutes an IPR based on this petition, Samsung will not pursue district court invalidity challenges based on the primary reference asserted in this petition.” Pet. 90 (citing Ex. 1037; *Tide v. UPL* (IPR2020-01113)).

Patent Owner asserts that “the arguments and references in the Petition substantially overlap with those at issue in the parallel district court litigation.” Prelim. Resp. 43. Patent Owner also asserts that because Petitioner’s stipulation “is narrowly drawn to only the grounds in the petition” it “does not cover any of the other grounds that Samsung raised or could have raised” and therefore, “does not ensure that this *inter partes* review is a “true alternative” to the district court proceeding.” *Id.* at 44 (citing Ex. 1037; Ex. 2014; *Sotera*, IPR2020-01019, Paper 12 at 19). Patent Owner also points out that Petitioner “presents eleven additional grounds for invalidity in its invalidity contentions which are not covered by the stipulation.” Prelim. Sur-reply 3 (citing Ex. 2014, p. 30).

The question before us for this factor, however, is not whether the stipulation covers all grounds in the district court proceeding, but whether it covers all grounds in the Petition which overlap with grounds raised in the district court. We find Petitioner’s proposed stipulation to be broader than the stipulation in *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative), because Petitioner’s stipulation includes any grounds involving Okamura, and not just the grounds asserted in the Petition.

Ex. 1037. This stipulation mitigates concerns regarding duplicative efforts and potentially conflicting decisions. Thus, this factor weighs in favor of not exercising discretion to deny institution.

5. *Whether the petitioner and the defendant in the parallel proceeding are the same party.*

Fintiv Factor 5 looks to “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 14. “If a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution.” *Id.* at 13–14.

The parties in the district court litigation and this proceeding are the same. Pet. 90; Prelim. Resp. 44. Thus, this factor weighs in favor of not exercising discretion to deny institution.

6. *Other circumstances that impact the Board’s exercise of discretion, including the merits.*

Fintiv Factor 6 looks to whether “other circumstances” exist that might “impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 14.

Patent Owner asserts that “Petitioner has failed to meet its burden to demonstrate a likelihood of success on the merits for any ground.” Prelim. Resp. 44 (citing *id.* at 46–68³). Petitioner contends that “[t]he merits of this petition are particularly strong.” Pet. 91.

We do not express a view on the strength of Petitioner’s substantive case other than our determination that, at this stage, Petitioner has demonstrated a reasonable likelihood of succeeding with respect to the

³ Patent Owner cites § VII of its Preliminary Response, however, it discusses the alleged flaws in Petitioner’s challenges in § VIII (i.e. pp. 46–83).

patentability of at least one claim. This factor does not weigh for or against exercising discretion to institute in this case.

7. *Conclusion on Discretionary Denial under 35 U.S.C. § 314(a)*

We consider the above factors and take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6. Although there has been some investment in the district court litigation, and no stay has been granted, other factors weigh more heavily against exercising discretion to deny institution. In particular, the fact that the final written decision in this proceeding is due at approximately the same time as the earliest trial date in the district court proceeding, and that Petitioner has demonstrated a reasonable likelihood of succeeding with respect to at least one claim, persuade us not to exercise discretion under § 314(a) to deny institution.

Based on a holistic review of the *Fintiv* factors, we decline to exercise our discretion under § 314(a) to deny institution.

C. *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 '228 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.

Pet. 2 (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).

D. 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. 1–2, 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)).

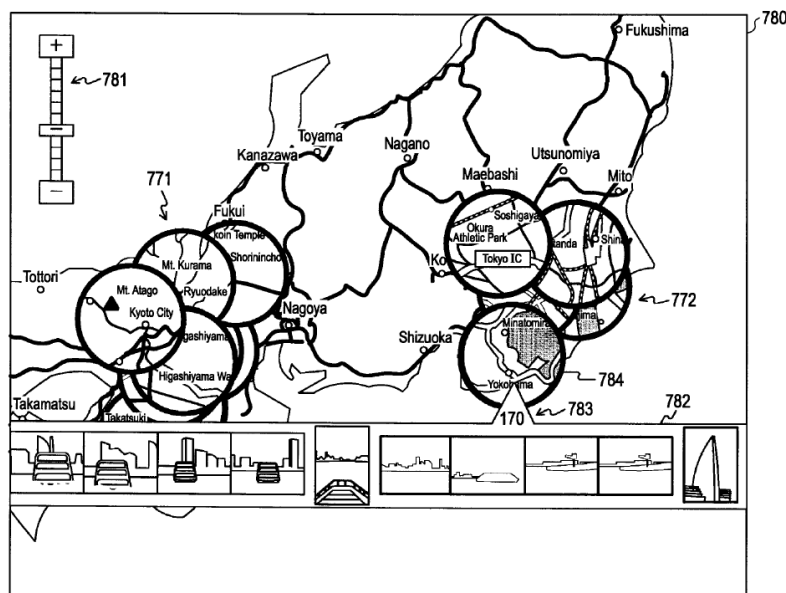
E. Overview of the Asserted Prior art

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 (45), (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.

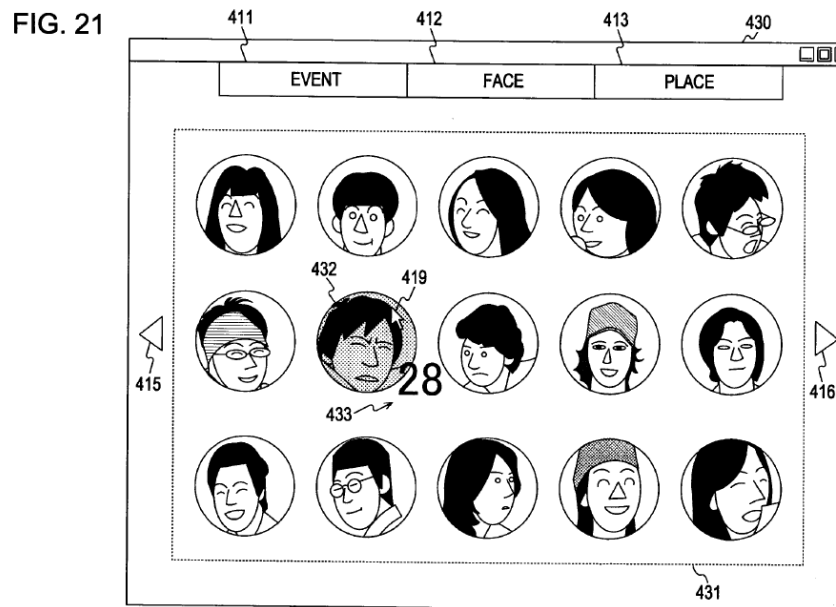
FIG. 41



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.

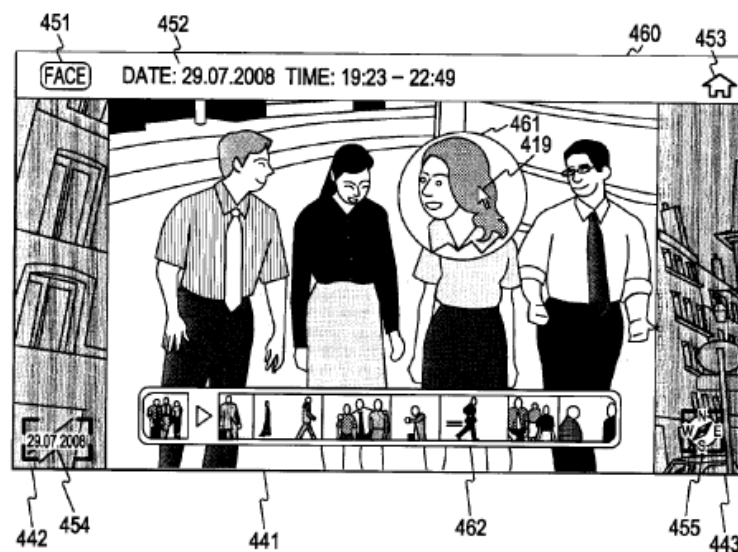


Id. Fig. 21, ¶ 41. As shown in Figure 21, an index screen displays indexed images generated on the basis of face information. *Id.* Fig. 21, ¶ 234. The index screen includes cursor 419 for pointing to an object of instruction or operation on the screen. *Id.* Fig. 21, ¶ 234. The index screen includes “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.

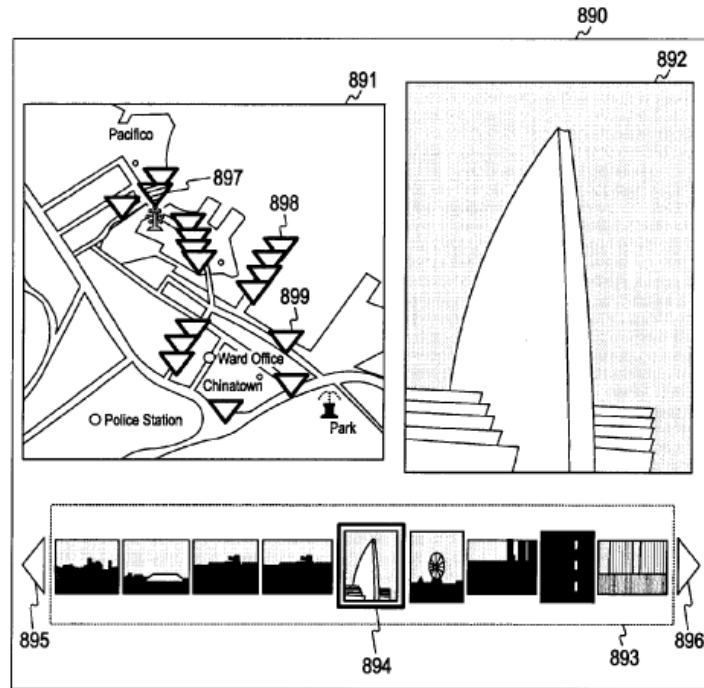
FIG. 24



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 (45), (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.

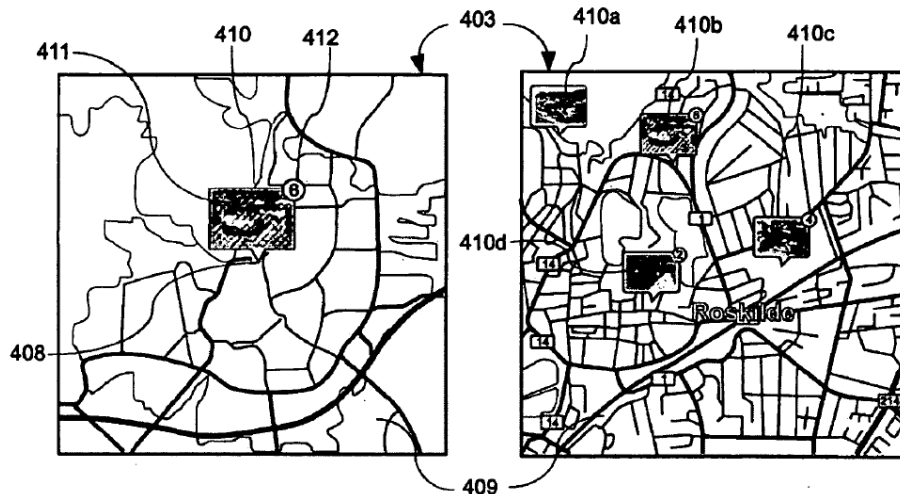


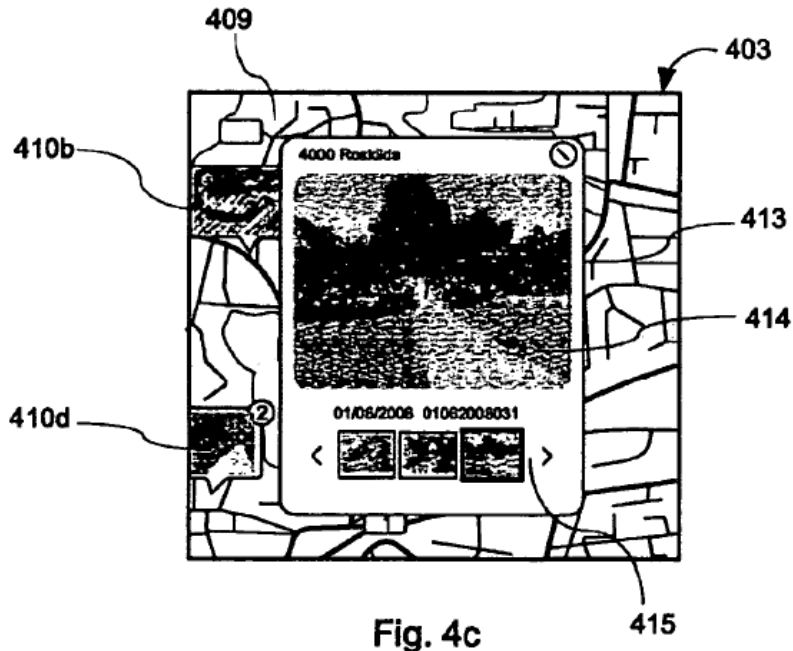
Fig. 4a

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 410a, 410b, 410c and 410d" 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.*



As shown in Figure 4c, the “popup window shows at least some of the visual representations 411 of the graphical object 410c.” 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.

F. *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.

G. Obviousness under 35 U.S.C. § 103

Petitioner contends that claims 1–19 are unpatentable over combination of Okamura and Belitz. Pet. 7–81. Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 46–66.

1. Independent Claim 1

For each limitation of claim 1, Petitioner asserts that Okamura alone or in combination with Belitz meets that limitation. Pet. 26–55. Petitioner also provides the testimony of Dr. Greenspun, in support of its position with respect to the limitations of claim 1. *See Ex. 1003 ¶¶ 102–145*. 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 failed to demonstrate that a [person of ordinary skill in the art] would modify Okamura with Berlitz in any of the ways suggested in the Petition.” Prelim. Resp. 64.

*a. “People View” As Required By Limitations [lg]–
[lk]⁴*

Petitioner asserts that “Okamura discloses displaying a people view (‘index images generated on the basis of face information’) in response to a **user operation** (‘when the ‘FACE’ tab 412 is depressed using the cursor 419’).” Pet. 46 (citing Ex. 1005 ¶¶ 234, 236; Fig. 21; Ex. 1003 ¶ 133). Petitioner asserts that Okamura’s “people view” includes “multiple person selectable thumbnail images.” *Id.* at 53 (citing Ex. 1005 ¶¶ 234, 246–260, 267, Fig. 21; Ex. 1003 ¶ 144). Petitioner asserts that any one of these thumbnail images corresponds to the claimed first person selectable thumbnail image and that “any one of the person selectable thumbnail images (e.g., as annotated below) displayed on the index screen is a second person selectable thumbnail image, as long as it is different from a first person selectable thumbnail image.” *Id.* (citing Ex. 1005 ¶¶ 234, 246–250, Fig. 21; Ex. 1003 ¶ 144).

⁴ As labeled by Patent Owner in its Preliminary Response.

Petitioner asserts that for each of Okamura's thumbnail images "when the mouse is placed over a thumbnail image 432 by a user operation on the index screen 430 shown in FIG. 21, the color of the thumbnail image 432 changes, and pieces of information 433 related to the thumbnail image 432 are displayed." Pet. 52 (citing Ex. 1005 ¶ 247). Petitioner asserts further that the pieces of information displayed include the name of the person displayed adjacent to the thumbnail image. *Id.*

Patent Owner argues that "Okamura does not disclose all aspects of the claimed 'people view.'" Prelim. Resp. 46. Specifically, Patent Owner contends that Okamura fails to disclose a people view including "(i) a first person selectable thumbnail image . . . (ii) a first name . . . displayed adjacent to the first person selectable thumbnail image . . . (iii) a second person selectable thumbnail image . . . **and** (iv) a second name . . . displayed adjacent to the second person selectable thumbnail image" because Okamura does not display the first and second names at the same time. *Id.* at 46, 49 (citing Ex. 1001, 35:63–36:11; Ex. 1005 ¶ 247; Ex. 2001 ¶ 115).

On the record before us, we do not find that claim 1 requires simultaneous display of the first and second names. Ex. 1001, 35:61–36:11. Rather, claim 1 requires that the first name be displayed at some unspecified time and that the second name be displayed at some unspecified time. As discussed above, Okamura displays the name associated with each thumbnail when the mouse is placed over that thumbnail. Thus, Petitioner has sufficiently demonstrated, for purposes of institution, that Okamura discloses this contested feature of the claimed "people view."

b. First Combination of Okamura and Belitz

Petitioner asserts that a person of ordinary skill in the art "would have found it obvious to replace the location-based clusters used in Okamura's

map view (shown in FIG. 41) with the thumbnail images used in Belitz's map view." Pet 12 (citing Ex. 1003 ¶ 87). According to Petitioner, "[w]ith this replacement, Okamura's map view would function as described in Okamura, except that it would display, on the map view, thumbnail images as described by Belitz, instead of Okamura's location-based clusters." *Id.* In addition, Petitioner contends that Okamura's location-based clusters are thumbnails as claimed. *Id.* at 13.

Petitioner asserts that Okamura and Belitz "describe analogous methods of displaying an interactive map with user-selectable elements (e.g., Belitz's thumbnail images and Okamura's clusters) and retrieving digital files (e.g., photos and videos) associated with a given location." Pet. 15 (citing Ex. 1003 ¶ 89). Petitioner reasons that Belitz's thumbnails "enhances a user's experience of 'discern[ing] between the various objects' by providing 'a good view of what location is associated with what.'" *Id.* at 14–15 (citing Ex. 1006 ¶ 2). According to Petitioner,

Belitz's thumbnail images displayed on the interactive map are functionally equivalent to Okamura's location-based clusters (at least because (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 ¶ 90). Petitioner provides further reasoning in support of the proposed combination on pages 15–25 on the Petition. Petitioner provides the following summary of this reasoning stating that

to achieve Okamura's and Belitz's shared goal of conveniently presenting and managing digital files, a POSITA [person of ordinary skill in the art] would have been motivated to modify Okamura's user interface to include additional features as

discussed in Belitz with a high expectation of success. SAMSUNG-1003, [97]. Because both references relate to organizing content according to the location associated with the content, a POSITA would have seen the combination as predictable and involve relatively simple software modifications to implement. *Id.* Specifically, a POSITA would have considered (1) the use of the Belitz thumbnails in the Okamura interactive map or (2) the use of Belitz’s map view in place of Okamura’s map views to be nothing more than the predictable substitution of known and equivalent interface elements. *Id.* Such implementations would have been the product of ordinary skill and common sense—as explained above, the use of maps with photo thumbnails was conventional by early 2010—and would have been obvious to try because a POSITA would have had good reason to pursue the known options within his or her technical grasp. *Id.* (citing SAMSUNG-1022; SAMSUNG-1023).

Id. at 22.

Patent Owner contends that Petitioner’s first proposed combination of Okamura and Belitz lacks rational underpinning. Prelim. Resp. 51–59. 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.’” Prelim. Resp. 52 (citing Ex. 1005 ¶ 215; Ex. 2001 ¶ 121). 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.’” Prelim. Resp. 52–53). 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 53 (citing Ex. 2001 ¶ 122). 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. 14; Ex. 2001 ¶ 122). 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. 1003 ¶ 122).

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. 53–54. 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 54 (citing Ex. 1006 ¶¶ 54–58; Ex. 2001 ¶¶ 119–120).

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 POSITA.” Pet. 21. 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 replace Okamura’s map-related views (e.g., cluster map view shown in FIG. 18 or map view shown in FIG. 41) with Belitz’s map view.” Pet. 12 (citing Ex. 1003 ¶ 87). 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 2–19

We have reviewed Petitioner’s contentions regarding the limitations of claims 2–19 as set forth in the Petition and determine that for purposes of institution they are adequately supported by the evidence. Pet. 55–81. Patent Owner does not present separate arguments for these claims. Prelim. Resp. 67. 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 2–19.

3. Conclusion

For the foregoing reasons, and on the record presently before us, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in demonstrating that claims 1–19 of the ’228 patent would have been obvious over Okamura and Belitz.

H. 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. 67–68.

Patent Owner asserts that “[w]hile the Petition identifies certain related judicial matters (Petition, 92), it fails to identify several related

administrative matters, including related U.S. Patent Nos. 9,098,531, 9,552,376, 10,423,658 (“the ‘658 patent”), 11,017,020, 11,163,823 (“the ‘823 patent”), and 11,170,042.” Prelim. Resp. 68. Patent Owner contends that “the Petition can be denied for failing to comply with 37 C.F.R. § 42.8(b)(2),” because of “Petitioner’s failure to identify multiple related matters, including for related patents that are asserted against Petitioner in co-pending litigation.” *Id.*

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 1–19 of U.S. Patent No. 10,621,228 B2 is instituted with respect to the ground 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. 10,621,228 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2022-00222
Patent 10,621,228 B2

FOR PETITIONER:

Walter K. Renner
Jeremy J. Monaldo
Hyun Jin In
FISH & RICHARDSON P.C.
axf-ptab@fr.com
jjm@fr.com
in@fr.com

FOR PATENT OWNER:

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