

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00111
Patent 11,017,020 B2

Before LYNNE H. BROWNE, KEVIN C. TROCK, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a petition requesting *inter partes* review of claims 1–59 of U.S. Patent No. 11,017,020 B2 (Ex. 1001, “the ’020 patent”). Paper 1 (“Pet.”). MemoryWeb, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With the Board’s authorization, Petitioner filed a Reply (Paper 10) and Patent Owner filed a Sur-reply (Paper 11). For the reasons discussed below, we do not institute an *inter partes* review.

A. Related Matters

According to the parties, the ’020 patent is, or has been, involved in the following proceedings: *MemoryWeb, LLC v. Apple Inc.*, No. 6-21-cv-00531 (W.D. Tex.); *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 6-21-cv-00411 (W.D. Tex.); *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, No. 1-21-cv-02666 (N.D. Ill.); PGR2022-00006; IPR2022-00033; IPR2022-00032; IPR2022-00031; and IPR2021-01413. Pet. 3; Paper 6, 2–3 (Mandatory Notices).

Patent Owner also identifies the following proceedings as related: IPR2022-00222 and IPR2022-00221. Paper 6, 2.

B. The ’020 Patent

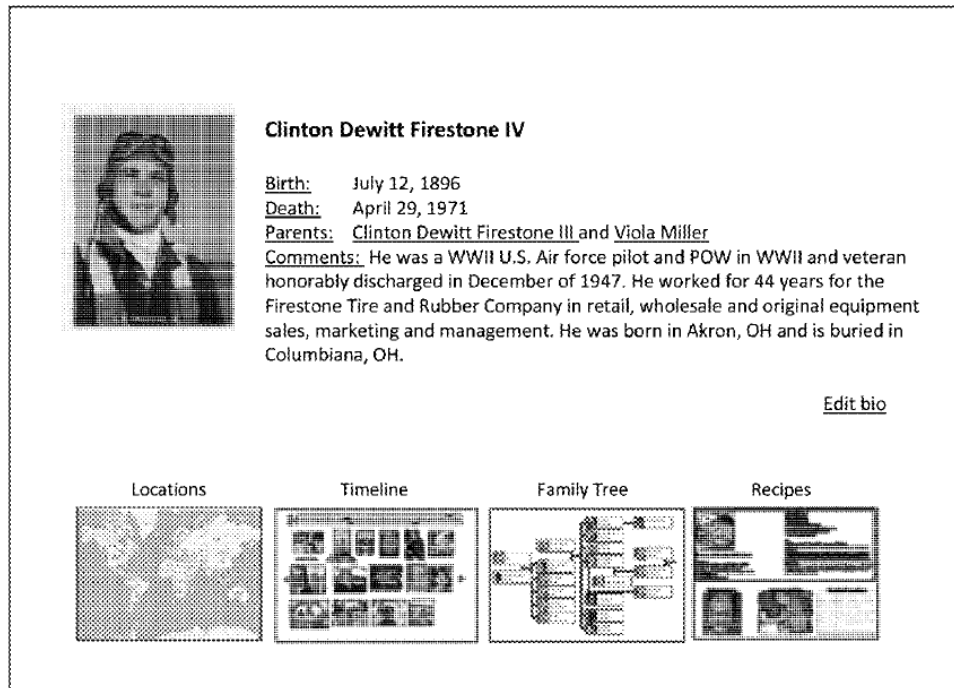
The ’020 patent relates to a platform for managing and using digital files, such as digital photographs. *See* Ex. 1001, 1:22–24. Through the platform’s interface, a user can tag and select files to create views. *See id.* at 5:40–45. For example, the “people view” is shown below. *Id.* at 6:24–26, Fig. 6.

FIG. 6



The people view, above, shows thumbnail photos of all the people in the system. *Id.* Clicking on the thumbnail causes a “profile view,” shown below, to be displayed. *See id.* at 6:24–30.

FIG. 7



The profile view, above, displays a person's image, date of birth, date of death, parents' names, and other biographical information. *Id.* at 6:26–30. The profile view also displays links to other views containing information about the person: Locations, Timeline, Family Tree, and Recipes. *Id.* The Locations view, for example, has an interactive map showing where the digital files were taken. *Id.* at 6:18–23.

C. Claims

Of the challenged claims, claims 1 and 31 are independent. Claim 1 is reproduced below.

1. A method comprising:

causing an interface to display a people view, the people view including:

- a first thumbnail image associated with a first person,
- a first name associated with the first person,

a second thumbnail image associated with a second person, and

a second name associated with the second person;

responsive to an input that is indicative of a selection associated with the first person, causing a first person view to be displayed on the interface, the first person view including:

a first digital file associated with the first person,

the first name associated with the first person, and

a first map image;

responsive to an input that is indicative of a selection of the first map image in the first person view, causing a first location view to be displayed on the interface, the first location view including:

an interactive geographic map,

a first indication positioned at a first location on the interactive geographic map, and

a second indication positioned at a second location on the interactive geographic map; and

responsive to an input that is indicative of a selection of the first digital file in the first person view, causing a slideshow to be displayed on the interface, the slideshow including a plurality of images associated with the first person.

Ex. 1001, 35:17–45.

D. Evidence

Name	Reference	Exhibit No.
A3UM	Aperture 3 User Manual, Apple Inc. (2010)	1005

E. Asserted Ground

Petitioner asserts that claims 1–59 would have been unpatentable on the following ground. Pet. 3.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–59	103	A3UM

II. ANALYSIS

“A petition for inter partes review shall be filed after the later of either—(1) the date that is 9 months after the grant of a patent; or (2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.” 35 U.S.C. § 311(c). Similarly, our rules require that, for patents described in section 3(n)(1) of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011) (“AIA”), a petition for *inter partes* review must be filed no earlier than nine months after the date of the grant of the patent. 37 C.F.R. § 42.102(a)(1). Patents subject to the AIA first-inventor-to file provisions are those that issue from applications “that contain or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after [March 16, 2013]; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

AIA § 3(n)(1).

Petitioner filed both a petition for *inter partes* review and a petition for post-grant review. Pet. 9. Petitioner calls the petition for *inter partes* review “conditional,” explaining that “[i]f the Board determines the ’020 patent is not an AIA patent, however, the ’020 patent is available for IPR.” *Id.* at 1, 9; *see also* Paper 3 (Petitioner’s Statement Regarding Multiple Petitions) (“[I]f the Board determines that the ’020 patent is not an AIA patent and thus denies the petition in PGR2022-00006 on the ground that the ’020 patent is ineligible for post grant review, Petitioner requests that the Board institute *inter partes* review in IPR2022-00111.”).

“Patent Owner does not dispute that the ‘020 patent is an AIA patent” and notes that “both parties agree the ‘020 patent is PGR eligible.”

Prelim. Resp. 7.

Based on the evidence presented to date in PGR2022-00006, there is a more likely than not basis to conclude that the ‘020 patent is a section 3(n)(1) patent for which no *inter partes* review may be filed until nine months after the issuance of the patent, or until after the date of termination of the post-grant review. This petition for *inter partes* review was filed on November 20, 2021, which is less than six months after the ‘020 patent was granted on May 25, 2021, and thus, is not eligible for review. 35 U.S.C. § 311(c), 37 C.F.R. § 42.102(a)(1).

III. ORDER

It is ORDERED that the Petition is *denied*.

IPR2022-00111
Patent 11,017,020 B2

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