

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00885
Patent 11,163,823 B2

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

TROCK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314, 311(c)

I. INTRODUCTION

A. *Background*

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Petitioner”) filed a Petition, Paper 3 (“Pet.” or “Petition”) to institute an *inter partes* review of claims 1–34 (the “challenged claims”) of U.S. Patent No. 11,163,823 B2 (Ex. 1001, “the ’823 patent”).

MemoryWeb, LLC (“Patent Owner”) timely filed a Preliminary Response, Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply, Paper 9 (“Reply”), and Patent Owner filed a Sur-Reply, Paper 10 (“Sur-Reply”).

“The Director may not authorize an *inter partes* review to be instituted unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). However, a petition for *inter partes* review may not be filed until 9 months after the grant of a patent, or if a post-grant review is instituted, not until termination of the post-grant review, whichever date is later. 35 U.S.C. § 311(c) (emphasis added).

Because the filing of this Petition does not comply with 35 U.S.C. § 311(c), we *deny* the Petition as discussed below.

B. *Real Party in Interest*

Petitioner identifies itself as the only real parties in interest. Pet. 91. Patent Owner identifies itself as the only real party in interest. Paper 4, 2.

C. *Related Proceedings*

The parties identify that the ’823 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”); 10,621,228 (“the ’228 patent”); 11,017,020

IPR2022-00085
Patent 11,163,823 B2

(“the ’020 patent”); and 11,170,042 (“the ’042 patent”) (collectively “the related patents”). Paper 4, 2; Paper 7, 1.

According to the parties, the ’823 patent and the related patents are the subject of the following actions: *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 6:21-cv-00411 (W.D. Tex.) (pending); *MemoryWeb, LLC v. Apple, Inc.*, No. 6:21-cv-00531 (W.D. Tex.) (pending); *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, No. 1:21-cv-02666 (N.D. Ill.) (dismissed); *Samsung Electronics Co., Ltd. v. MemoryWeb, LLC*, IPR2022-00222 (pending); *Samsung Electronics Co., Ltd. v. MemoryWeb, LLC*, IPR2022-00221 (pending); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00111 (pending); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00033 (pending); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 (pending); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 (pending); *United Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413; and U.S. Patent Application No. 17/459,933 (pending). Pet. 91–92; Paper 4, 2–3; Paper 7, 1–2.

Petitioner further identifies a concurrent post-grant review proceeding involving the ’823 patent: *Samsung Electronics Co. Ltd. et al. v. MemoryWeb, LLC*, PGR2022-00034 (pending). Pet. 91. Petitioner also identifies the following action involving the ’020 patent: *Apple Inc. v. MemoryWeb, LLC*, PGR2022-00006 (pending). *Id.* at 92; Paper 7, 2.

D. Challenged Claims

Petitioner challenges claims 1–34 of the ’823 patent. Pet. 1. Claims 1 and 29 are independent. Claim 1 is generally illustrative.

[1pre] 1. A method comprising:

[1a] causing an interface to display a search-filter view, the search-filter view permitting a user to filter a plurality of digital files based on one or more criteria;

[1b] responsive to a first input within the search-filter view, causing the interface to display a people view including a first image associated with a first person and a second image associated with a second person;

[1c] 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;

[1d] responsive to an input that is indicative of a selection associated with the first digital file, causing a first detail view to be displayed on the interface, the first detail view including (i) the first digital file, (ii) first information associated with the first digital file and (iii) a first map image associated with the first digital file, the first digital file having a first size in the first person view and a second size in the first detail view, wherein the second size is greater than the first size;

[1e] responsive to an input that is indicative of a selection associated with the second person, causing a second person view to be displayed on the interface, the second person view including a second digital file associated with the second person;

[1f] responsive to an input that is indicative of a selection associated with the second digital file, causing a second detail view to be displayed on the interface, the second detail view including (i) the second digital file, (ii) second information associated

with the second digital file and (iii) a second map image associated with the second digital file; and

[1g] responsive to a second input within the search-filter view, causing the interface to display a locations view including a first name associated with a first location, and a second name associated with a second location;

[1h] responsive to an input that is indicative of a selection associated with the first location, causing a first set of digital files to be displayed on the interface, each digital file in the first set of digital files being associated with the first location; and

[1i] responsive to an input that is indicative of a selection associated with the second location, causing a second set of digital files to be displayed on the interface, each digital file in the second set of digital files being associated with the second location.

Ex. 1001, 35:1–54 (numbering and formatting designated by Petitioner; *see* Pet. 13–37).

E. Evidence

Petitioner relies upon the following evidence: David Pogue and J.D. Biersdorfer, *iPhoto '09 The Missing Manual* (2009) (“Pogue”) (Ex. 1005); Adam C. Engst, *Visual QuickStart Guide iPhoto '09* (2009) (“Engst”) (Ex. 1007); U.S. Patent App. Pub. No. 2010/0058212 A1 (“Belitz”) (Ex. 1008); and U.S. Patent App. Pub. No. 2005/0116954 A1 (“Ripps”) (Ex. 1009).

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability in the Petition.

Claim(s) Challenged	35 U.S.C. §	References
1–25, 27–34	103	Pogue, Engst
26	103	Pogue, Engst, Belitz
12–14	103	Pogue, Engst, Ripps

Pet. 1–2.

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) (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 this Petition for *inter partes* review (IPR2022-00885) and a petition for post-grant review (PGR2022-00034). Paper 2, 1. The two petitions challenge the same claims of the ’823 Patent under the same prior art grounds. *Id.* Petitioner ranks the petition in PGR2022-00034 as its preferred petition. *Id.* Petitioner contends that “[b]oth petitions are

meritorious and justified” and “Petitioner seeks institution of both petitions.” *Id.* Petitioner thus “requests institution of both [*inter partes* review] and [post-grant review] petitions if the Board finds that the threshold requirements for institution of both [*inter partes* review] and [post-grant review] are met,” and “Petitioner [additionally] requests consolidation of the two proceedings, as permitted by 35 U.S.C. §§ 315(d) and 325(d), and a briefing schedule that matches the briefing schedule of a [post-grant review] alone. *Id.* at 4.

“Patent Owner does not dispute for the purposes of this proceeding that the ’823 patent is an AIA patent, and stipulates that the ’823 patent is PGR eligible.” Prelim. Resp. 10. Based on the evidence presented to date in PGR2022-00034, there is a more likely than not basis to conclude that the ’823 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 a post-grant review. This petition for *inter partes* review was filed on April 20, 2022, which is less than six months after the ’823 patent issued on November 2, 2021, and thus, is not eligible for *inter partes* review. 35 U.S.C. § 311(c), 37 C.F.R. § 42.102(a)(1).

III. CONCLUSION

For the foregoing reasons, we find that the Petition does not comply with 35 U.S.C. § 311(c), and therefore *deny* the Petition.

IV. ORDER

In consideration of the foregoing, it is hereby
ORDERED that the Petition is *denied*.

IPR2022-00085
Patent 11,163,823 B2

FOR PETITIONER:

Walter Renner
Jeremy 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
Matthew Werber
NIXON PEABODY LLP
jenhayes@nixonpeabody.com
gdandalides@nixonpeabody.com
mwerber@nixonpeabody.com