

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC,  
Petitioner,

v.

MEMORYWEB, LLC,  
Patent Owner.

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IPR2021-01413  
Patent 10,621,228 B2

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

TROCK, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

*35 U.S.C. § 314*

## I. INTRODUCTION

### A. Background

Unified Patents, LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.” or “Petition”) to institute an *inter partes* review of claims 1–7 (“the challenged claims”) of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 patent”). MemoryWeb, LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply (Paper 11, “Pet. Reply” or “Reply”) and Patent Owner filed a redacted version of its Sur-Reply available to the public (Paper 12, “PO Sur-Reply” or “Sur-Reply”).<sup>1</sup>

An *inter partes* review may not be instituted “unless . . . 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). Upon consideration of the entirety of the current record, we determine that Petitioner has shown a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we institute an *inter partes* review.

### B. Real Party-in-Interest

Petitioner identifies itself as the only real party-in-interest. Pet. 1. Patent Owner identifies itself as the only real party-in-interest. Paper 4, 2.

### C. Related Matters

According to the parties, the ’228 patent was asserted in the following district court proceedings: *MemoryWeb, LLC v. Samsung Electronics Co.*,

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<sup>1</sup> Patent Owner also filed an unredacted version of its Sur-Reply available only to the Board and the parties. Paper 13.

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*Ltd. et al.*, Case No. 6:21-cv-00411 (W.D. Tex.); *MemoryWeb, LLC v. Apple Inc.*, Case No. 6:21-cv-00531 (W.D. Tex.); and *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, Case No. 1:21-cv-02666 (N.D. Ill.). Pet. 1–2; Paper 4, 2; Paper 7, 2; Paper 9, 2–3.

Patent Owner also identifies U.S. Patent No. 9,098,531 (“the ’531 patent”), U.S. Patent No. 10,423,658 (“the ’658 patent”), U.S. Patent No. 9,552,376 (“the ’376 patent”), U.S. Patent No. 11,017,020 (“the ’020 patent”), U.S. Patent No. 11,163,823 (“the ’823 patent”), pending U.S. Patent Application 17/381,047, and pending U.S. Patent Application 17/459,933 as related to the ’228 patent. Paper 7, 2; Paper 9, 2–3.

Patent Owner additionally indicates the following *inter partes* proceedings as related matters: *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413 (PTAB) challenging the ’228 patent; *Samsung Electronics Co., Ltd., v. MemoryWeb, LLC*, IPR2022-00222 (PTAB) challenging the ’228 patent; *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 (PTAB) challenging the ’228 patent; *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00111 (PTAB) challenging the ’020 patent; *Apple Inc. v. MemoryWeb, LLC*, PGR2022-00006 (PTAB) challenging the ’020 patent; *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00033 (PTAB) challenging the ’658 patent; and *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 (PTAB) challenging the ’376 patent. Paper 7, 2; Paper 9, 2–3.

#### D. *The ’228 Patent (Ex. 1001)*

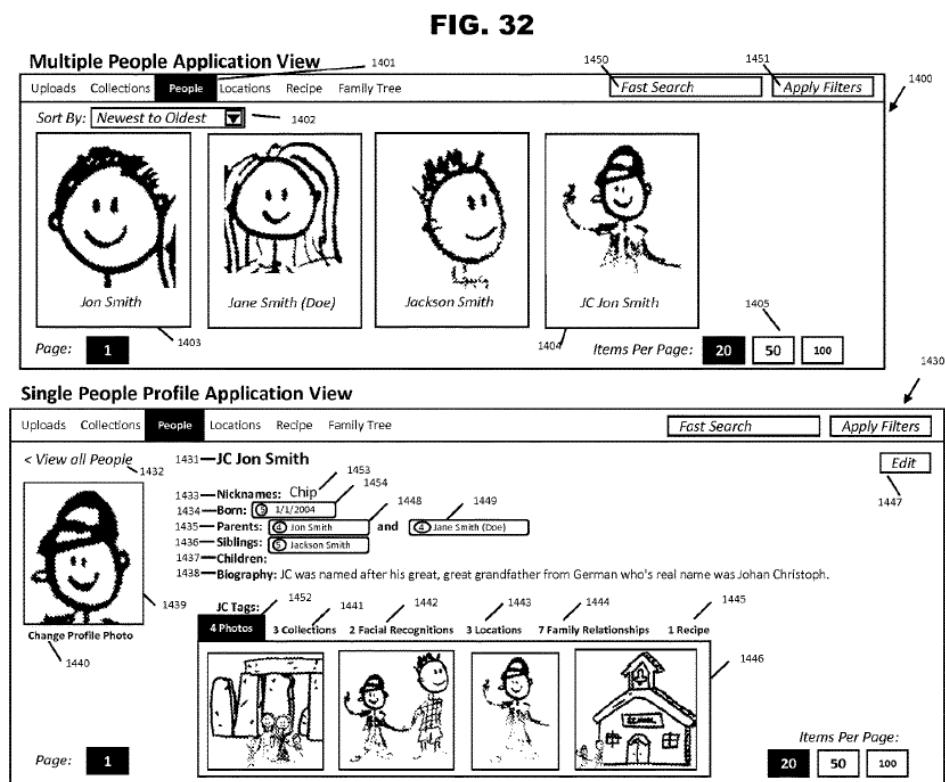
The ’228 patent is titled “Method and Apparatus for Managing Digital Files” and “relates generally to the management of digital files and, more particularly, to a computer-implemented system and method for managing and using digital files such as digital photographs.” Ex. 1001, code (54),

1:21–24. The ’228 patent describes a need for “a medium that allows people to organize, view, preserve and share [digital] files with all the memory details captured, connected and vivified via an interactive interface” and “allow digital files, including documents, photos, videos and audio, to tell a full story now, and for generations to come.” *Id.* at 1:60–67. The ’228 patent provides a solution in the form of “a computer-implemented method of associating digital tags with digital files” and “a web-based digital file storage system [that] comprises a digital file repository for storing and retrieving digital files.” *Id.* at 2:3–6, 2:21–25, 2:40–45.

The ’228 patent describes details of an “Application” (also called the “MemoryWeb Application”), which is an online program that can (i) import, associate and embed digital tags to digital files, (ii) view, sort, annotate, and share digital files from various Application Views, and (iii) store the digital files through an interactive storage system through a user relationship table. *Id.* at 8:63–9:16. The ’228 patent explains that the Application may be accessible “over various user interfaces” including those of “smart phones (e.g., iPhones), Personal Digital Assistants (PDAs) and Tablets (e.g., iPads).” *Id.* at 9:18–22. The Application provides views (i.e., “Application Views”) that utilize the Application’s ability to associate digital tags to digital files and display them in customized views such as Uploads, Collections, Slideshow, Location, Timeline, Family Tree, People Profile, and Recipes. *Id.* at 9:23–28. The views enable a user to display the user’s digital media files and their tagged attributes. *Id.* at 5:57–60. The views include, *inter alia*: a location view that “identifies within an interactive map ([e.g.,] Google map . . .), where digital files were taken or originated . . . [and] can also provide additional outputs such as a journey route that

identifies the specific locations for an event or trip that can be customized by users”; a people view that “shows thumbnail photos of all the people in the system that can be clicked in for a people profile view”; and a people profile view that “shows a profile picture of an individual, their birth/death information, family relationships, overview (comments) on the person, as well as links to other views that contain that individual in the system.” *Id.* at 6:13–30. Some views provided by the '228 patent's Application are shown in Figures 32 and 34, reproduced below. *Id.* at 3:61–66, 28:22–24.

Figure 32 illustrates a People Application Family Relationships View (at indicator 1400) and a People Profile Application View (at indicator 1430). *Id.* at 18:37–40, 22:59–61.



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