UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

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IPR2022-00033
Patent 10,423,658 B2

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

BROWNE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have authority to hear this inter partes review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner, Apple, Inc. ("Apple"), has shown by a preponderance of the evidence that claims 1–15 (the "challenged claims") of U.S. Patent No. 10,423,658 B2 (Ex. 1001, "the '658 Patent") are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

A. *Procedural History*

The Petition (Paper 1, "Pet." or "Petition") requested *inter partes* review of the challenged claims of the '658 Patent. Patent Owner, MemoryWeb, LLC, filed a Preliminary Response. Paper 8 ("Prelim. Resp."). With our authorization, Petitioner filed a Preliminary Reply (Paper 10), and Patent Owner filed a Preliminary Sur-reply (Paper 11). Based upon the record at that time, we instituted *inter partes* review on all challenged claims on the grounds presented in the Petition. Paper 12 ("Institution Decision" or "Dec.").

After institution, Patent Owner filed a Response (Paper 20, "PO Resp."), Petitioner filed a Reply (Paper 26, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 31, "PO Sur-reply").

Patent Owner filed a Motion to Exclude certain evidence (Paper 34). Petitioner opposed the Motion (Paper 35). Patent Owner filed a Reply to Petitioner's Opposition to the Motion (Paper 38).

On March 14, 2023, an oral hearing was held.

B. Real Party-in-Interest

Petitioner states that it "is the real party-in-interest for this petition." Pet. 2. Patent Owner states that it is the real party-in-interest. *See* Paper 3, 2. *See also* Paper 7, 2; Paper 19, 2.
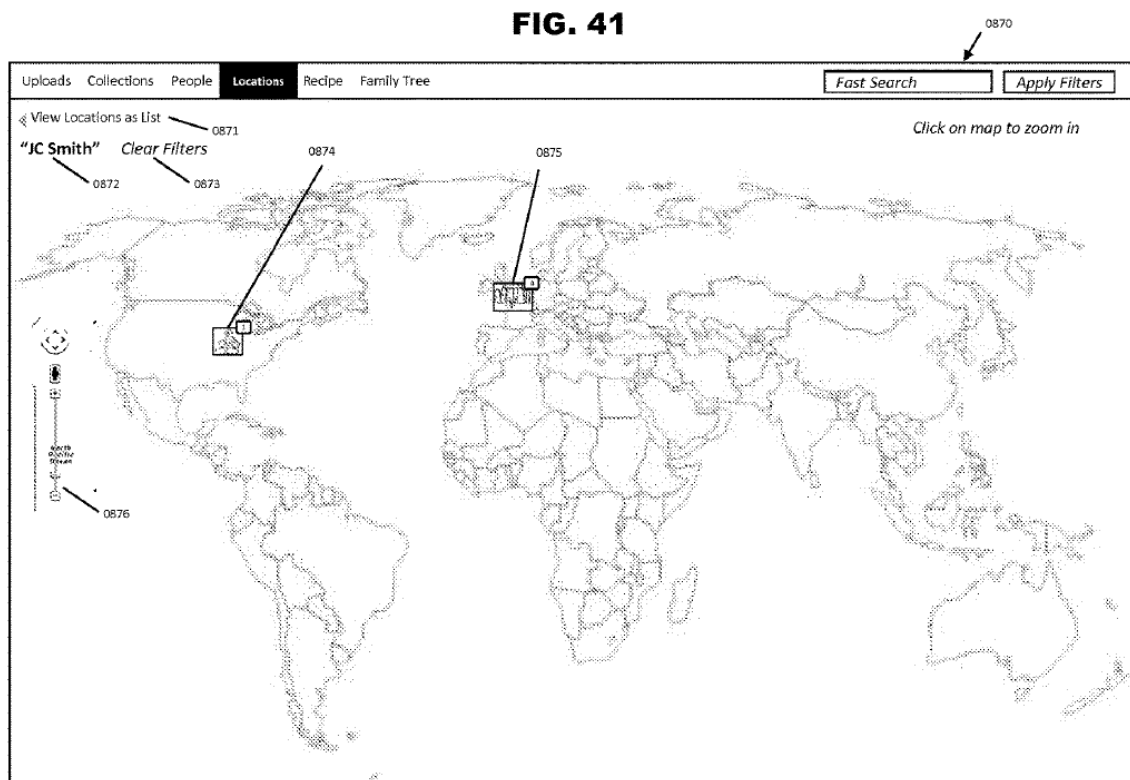
C. Related Matters

According to the parties, the '658 Patent was asserted in the following district court proceedings: *MemoryWeb, LLC v. Apple Inc.*, Case No. 6:21-cv-00531 (W.D. Tex.); *MyHeritage (USA), Inc. et. al. v. MemoryWeb, LLC*, Case No. 1:21-cv-02666 (N.D. Ill.) (dismissed); and *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 6:21-cv-00411 (W.D. Tex.). Pet. 3; Paper 3, 2; Paper 7, 2; Paper 19, 2.

Patent Owner also identifies U.S. Patent No. 9,098,531 ("the '531 patent"), U.S. Patent No. 9,552,376 ("the '376 patent"), U.S. Patent No. 10,621,228 ("the '228 patent"), U.S. Patent No. 11,017,020 ("the '020 patent"), U.S. Patent No. 11,163,823 ("the '823 patent"), and pending U.S. Patent Application 17/459,933 as related to the '658 Patent. Paper 7, 2–3.

Patent Owner additionally indicates the following *inter partes* proceedings are related matters: *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, IPR2022-00031 (PTAB) challenging the '228 patent; *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 (PTAB) challenging the '370 patent; and *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413 (PTAB), (challenging the '228 patent.
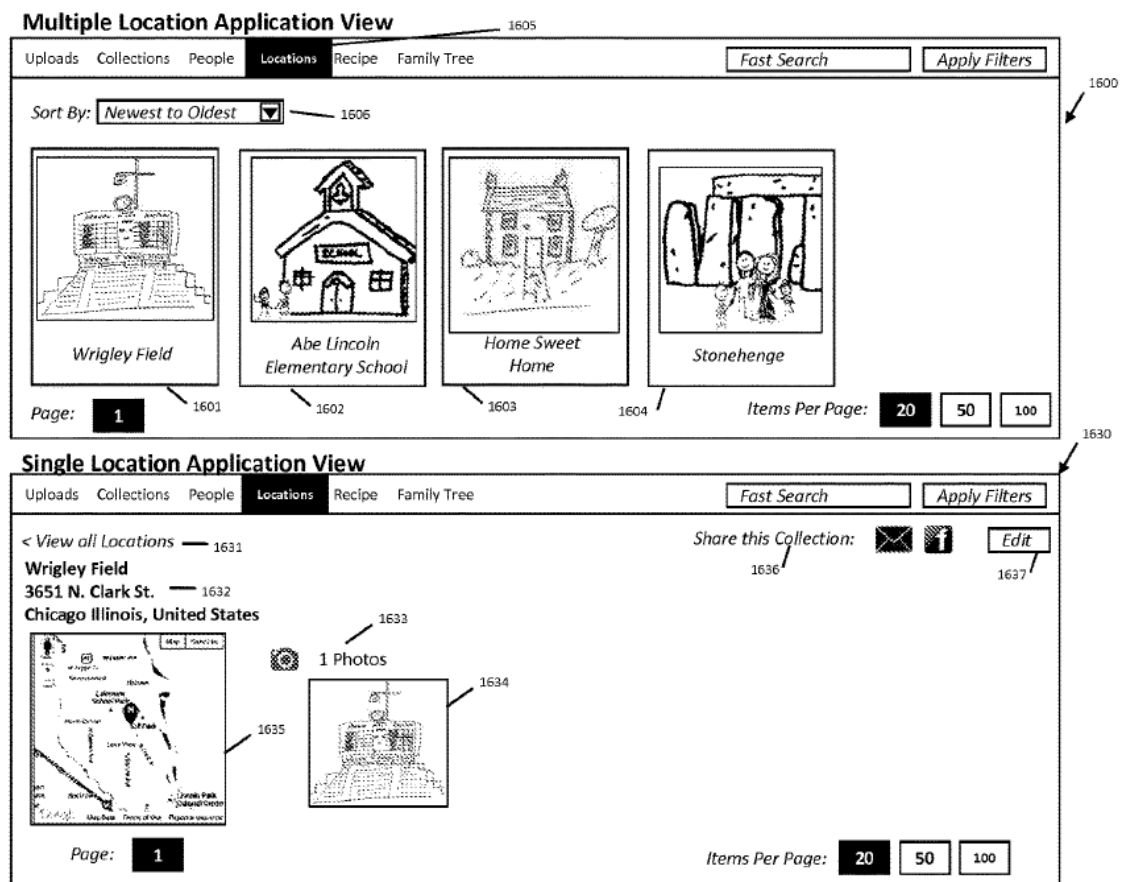
D. The '658 Patent (Ex. 1001)

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)." Ex. 1001, 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 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)." Ex. 1001, 24:22–24. The single location Locations Application View further displays "[t]humbnails of each Digital File within the specific collections" of

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