

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. et al,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

Case IPR2022-00221
Patent 10,423,658

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

EXHIBITS

- SAMSUNG-1001 U.S. Patent No. 10,423,658 to Christopher J. Desmond, et al. (“the ’658 patent”)
- SAMSUNG-1002 Excerpts from the Prosecution History of the ’658 Patent (“the Prosecution History”)
- SAMSUNG-1003 Declaration of Dr. Philip Greenspun
- SAMSUNG-1004 Curriculum Vitae of Dr. Philip Greenspun
- SAMSUNG-1005 U.S. Patent App. Pub. No. 2011/0122153 A1 (“Okamura”)
- SAMSUNG-1006 U.S. Patent App. Pub. No. 2010/0058212 A1 (“Belitz”)
- SAMSUNG-1007 U.S. Patent App. Pub. No. 2006/0206264 A1 (“Rasmussen”)
- SAMSUNG 1008-SAMSUNG 1019 RESERVED
- SAMSUNG-1020 Tim Grey, Adobe Photoshop Lightroom Workflow: The Digital Photographer's Guide (2007)
- SAMSUNG-1021 U.S. Patent App. Pub. No. 2011/0074811 A1 (“Hanson”)
- SAMSUNG-1022 Stephen Shankland, “What’s the best Web site for geotagged photos?,” CNET (Mar. 18, 2009), available at <https://www.cnet.com/tech/computing/whats-the-best-web-site-for-geotagged-photos/>
- SAMSUNG-1023 Panoramio, “Embedding a Panoramio map into your web page” (Archive.org: Mar. 28, 2010), available at <https://web.archive.org/web/20100328215828/http://www.panoramio.com/help/embedding>
- SAMSUNG-1024 Shu-Wai Chow, PHP Web 2.0 Mashup Projects, Packt Publishing (2007)

- SAMSUNG-1025 Complaint for Declaratory Judgment, *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, Case No. 1:21-cv-02666, Dkt. 1 (N.D. Ill. May 17, 2021)
- SAMSUNG-1026 U.S. Patent App. Pub. No. 2009/0113350 A1 (“Hibino”)
- SAMSUNG-1027 U.S. Patent App. Pub. No. 2006/0165380 A1 (“Tanaka”)
- SAMSUNG-1028 Complaint for Infringement, *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, Case No. 21-cv-411 (W.D. Tex.)
- SAMSUNG-1029 Plaintiff MemoryWeb, LLC’s First Supplemental Initial Infringement Contentions, *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, Case No. 21-cv-411-ADA (W.D. Tex. Nov. 24, 2021)
- SAMSUNG-1030 Agreed Scheduling Order, *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, Case No. 21-cv-411-ADA (W.D. Tex. Nov. 23, 2021)
- SAMSUNG-1031 U.S. Patent No. 6,215,523 (“Anderson”)
- SAMSUNG-1032 U.S. Patent App. Pub. No. 2008/0133526 (“Haitani”)
- SAMSUNG-1033 U.S. Patent App. Pub. No. 2008/0306921 (“Rothmuller”)
- SAMSUNG-1034 U.S. Patent App. Pub. No. 2013/0198602 (“Kokemohr”)
- SAMSUNG-1035 U.S. Patent App. Pub. No. 2013/0326338 (“Secord”)
- SAMSUNG-1036 U.S. Patent App. Pub. No. 2007/0016575 (“Hurst-Hiller”)
- SAMSUNG-1037 Stipulation Letter
- SAMSUNG-1038 U.S. Patent App. Pub. No. 2008/0276279 (“Gossweiler”)
- SAMSUNG-1039 U.S. Patent App. Pub. No. 2008/0263103 (“McGregor”)

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Attorney Docket: 39843-0116IP1

SAMSUNG-1040 U.S. Patent App. Pub. No. 2006/0080342 (“Takaki”)

SAMSUNG-1041 U.S. Patent App. Pub. No. 2009/0210793 (“Yee”)

SAMSUNG-1042 Woody Leonhard, Windows Vista All-in-One Desk Reference
for Dummies (2007)

SAMSUNG-1043 Andy Rathbone, Windows Vista for Dummies (2007)

SAMSUNG-1044 Email from Board Authorizing Petitioner’s Reply

On June 2, 2022, the Board issued an email authorizing Petitioner (Samsung) to file a five-page reply to Patent Owner’s Preliminary Response (“POPR”). SAMSUNG-1044. The Board should decline to exercise its discretion to deny Samsung’s petition. In fact, the *Fintiv* factors favor institution because the final written decision (“FWD”) is likely to precede trial and would, at worst, shortly follow trial. In addition, Samsung’s strong stipulation minimizes overlap between the parallel proceedings. Further, because the petition advances prior art already endorsed by the Board, the exceptionally strong merits favor institution.

I. *FINTIV* FAVORS INSTITUTION ON THE MERITS

A holistic view of the *Fintiv* factors overwhelmingly supports institution, with only *Fintiv* Factors 1 and 5 being, at worst, neutral.

As to Factor 2, MemoryWeb contends that “the final written decision will be more than a month after the trial.” POPR, 30. However, on June 7, 2022, Judge Albright entered an order re-scheduling the *Markman* hearing to June 30, 2022, and the parties agreed to an extended case schedule with a new trial date of July 27, 2023 (Joint Motion to Modify Schedule filed today with dates herein referring to the agreed schedule). The FWD deadline is now less than two weeks after trial.

MemoryWeb also assumes that the Board will take the entire statutory period for institution and FWD. However, the FWD could easily precede trial, if either or both decisions issue before statutory deadlines, which is common.

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