

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

Case IPR2022-00222
Patent 10,621,228

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

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- SAMSUNG-1001 U.S. Patent No. 10,621,228 to Christopher J. Desmond, et al. (“the ’228 patent”)
- SAMSUNG-1002 Excerpts from the Prosecution History of the ’228 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-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:80/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 Email from Board Authorizing Petitioner’s Reply

On April 12, 2022, the Board issued an email authorizing Petitioner (Samsung) to file a five-page reply to Patent Owner’s Preliminary Response (“POPR”). *See* SAMSUNG-1038. For the reasons explained below, the Board should not exercise its discretion to deny Samsung’s request for IPR of U.S. Patent No. 10,621,228 (“the ’228 Patent”). The *General Plastic* factors favor institution because Samsung gained no advantage from the earlier petitions filed by Unified and Apple, which are completely separate and unrelated parties over which Samsung has no control. The *Fintiv* factors likewise favor institution because the final written decision is scheduled to precede trial and Samsung’s stipulation minimizes overlap between the petition and the district court proceeding. In addition, the exceptionally strong merits of the advanced grounds, which rely on the same primary reference (Okamura) previously found to establish a reasonable likelihood of success in justifying institution of Unified’s petition, favor institution.

I. GENERAL PLASTIC FAVORS INSTITUTION ON THE MERITS

The *General Plastic* Factors overwhelmingly favor institution. Specifically, Factor 1 favors institution because Samsung is separate and unrelated to prior petitioners Unified and Apple. *See* Petition, 82-83. Indeed, not only is Samsung unable to direct or control Unified and Apple, the parties are differently situated and have divergent interests. For example, Unified’s petition only covers a small subset of claims asserted against Samsung and thus does not adequately advance

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