UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MEMORYWEB, LLC,
Patent Owner.

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Case IPR2022-00222
Patent 10,621,228

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PETITIONER'S REPLY TO PATENT OWNER'S

MOTION TO TERMINATE

UPDATED EXHIBIT LIST

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 to 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

SAMSUNG-1039   RESERVED

SAMSUNG-1040   Transcript of the deposition of Dr. Glenn Reinman dated November 16, 2022

SAMSUNG-1041   Second Declaration of Dr. Philip Greenspun

SAMSUNG-1042   Adam C. Engst, Visual Quickstart Guide iPhoto '09 (2009)("Engst")

SAMSUNG-1043   U.S. Patent App. Pub. No. 2009/0196510 ("Gokturk")

SAMSUNG-1044   Petitioner's Demonstratives

SAMSUNG-1045   "Behest." *Merriam-Webster.com Dictionary*, Merriam-Webster, https://www.merriam-webster.com/dictionary/behest. Accessed 13 Oct. 2023.

I. INTRODUCTION

MemoryWeb's Motion to Terminate ("Motion") should be rejected, and the Board should issue a final written decision ("FWD") addressing all challenged claims of the '228 patent.

The Motion must be rejected because, first and foremost, Samsung is not a real party-in-interest ("RPI") of Unified Patents ("Unified"). As detailed below, there is no evidence to even remotely suggest that Unified's IPR petition in IPR2021-01413 ("Unified IPR") was filed at Samsung's behest or with Samsung's control. No substantive communications occurred between Samsung and Unified, and Samsung did not direct the filing of the Unified IPR. Rather than attempting to rebut the additional evidence relevant to the RPI determination that Samsung provided in this proceeding, MemoryWeb largely (and improperly) just points to the vacated RPI Order from the Unified IPR—where Samsung was not allowed to participate—and demands that the Board just reinstate the same. But the evidence in this proceeding fails to establish an RPI relationship between Samsung and Unified, much less meet MemoryWeb's burden to prove the same.

A second critical failure of MemoryWeb's motion is that MemoryWeb has not met its burden to demonstrate that the decision in the Unified IPR is final. As discussed below, MemoryWeb itself filed a request for rehearing of the Board's decision in the Unified IPR, thereby continuing the proceeding and delaying the

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