

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00222
Patent 10,621,228 B2

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

BROWNE, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining Some Challenged Claims Unpatentable

Denying Motion to Terminate

Granting Motion for Protective Order

Granting Motions to Seal

35 U.S.C. § 318(a); 37 C.F.R. § 42.14

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, Samsung Electronics Co., Ltd., has shown by a preponderance of the evidence that claims 1–17 of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 patent”) are unpatentable, but has not shown by a preponderance of the evidence that claims 18 and 19 are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

A. *Procedural History*

Petitioner, Samsung Electronics Co., Ltd., filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 patent”).¹ MemoryWeb, LLC (“Patent Owner” or “MemoryWeb”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply (Paper 9) and Patent Owner filed a Preliminary Sur-Reply (Paper 10). 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.”).

¹ We refer to the present proceeding, *Samsung Electronics Co. Ltd. v. MemoryWeb, LLC*, IPR2022-00222, as “the *Samsung* proceeding,” “this proceeding,” or “the instant proceeding” to distinguish it from two other related proceedings challenging the ’228 patent. Those other proceedings are *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413 (“the *Unified* proceeding” or “*Unified*”) and *Apple, Inc. v. MemoryWeb, LLC*, IPR2022-00031 (“the *Apple* proceeding”).

After institution, Patent Owner filed a Response (Paper 19, “PO Resp.”), Petitioner filed a Reply (Paper 24, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 30, “PO Sur-reply”).

On March 16, 2023, an oral hearing was held. A transcript of the hearing was made a part of this record. Paper 34.

In the *Unified* proceeding, which challenged claims 1–7 of the ’228 patent, the Board entered an Order (Paper 56 (confidential)) on March 8, 2023, identifying Samsung as an unnamed Real Party in Interest (the “RPI Order”), and on March 14, 2023, entered a Final Written Decision (Paper 58 (confidential)) finding claims 1–7 of the ’228 Patent unpatentable.

In an email to the Board dated March 15, 2023, counsel for Patent Owner requested authorization to file a motion to terminate the *Samsung* proceeding in light of the Board’s Final Written Decision in the *Unified* proceeding. Ex. 3006; *see also* Ex. 3002, 24:18–25:7, 38:16–41:6.

On March 31, 2023, a joint conference call was held with counsel from the *Unified*, *Samsung*, and *Apple* proceedings to discuss the impact of the Board’s Final Written Decision in the *Unified* proceeding. Ex. 3002. The topics discussed on the conference call included the Board’s RPI Order in the *Unified* proceeding, Patent Owner’s request to file a motion to terminate the *Samsung* proceeding, as well as issues related to real party in interest, waiver, estoppel and discovery, among others. *See id.*

On May 4, 2023, the Chief Administrative Patent Judge determined that good cause existed to extend the one-year period for issuing a Final Written Decision in this case in view of the limited time remaining before

expiration of the one-year period for issuing a Final Written Decision and under the unique circumstances of this case. Paper 35.

On May 18, 2023, we issued an Order extending the one-year pendency of this proceeding by up to six months. Paper 36.

On May 22, 2023, the Director issued a public version² of a Decision Granting Director Review (Paper 76, “Director’s Decision”) in the *Unified* proceeding, vacating-in-part the Final Written Decision (Section I.B) (Paper 58 (confidential) and Paper 67 (public)) and the Board’s Order identifying Samsung as an RPI (Paper 56 (confidential)) in that proceeding.

On June 1, 2023, we issued an Order directing the parties to confer and submit a proposed joint briefing schedule and discovery plan to address the waiver, RPI, and estoppel issues. Paper 37. The parties submitted their joint proposal by email on June 9, 2023. Ex. 3005.

On June 15, 2023, we issued an Order setting a briefing schedule for the parties to submit their arguments on the issues outlined in Exhibit 3005 (First Phase). Paper 45.³

On June 30, 2023, Patent Owner filed its opening brief on the issues of good cause, supplemental information, and additional discovery (Paper 40), and Petitioner filed its opening brief on the issues of waiver and estoppel (Paper 39).

² On May 16, 2023, a confidential version of the Director’s Decision Granting Director Review (Paper 74) was issued, but made available only to the parties and the Board.

³ Paper 45 is the corrected version of the Conduct of Proceeding Order (Paper 38).

On July 14, 2023, Patent Owner filed its response brief on the issues of waiver and estoppel (Paper 43), and Petitioner filed its response brief on the issues of good cause, supplemental information, and additional discovery (Paper 42).

On August 22, 2023, we issued an Order setting a schedule for the parties to conduct discovery on the RPI issue, to brief Patent Owner's requested motion to terminate, to file motions to exclude, and for a second oral hearing (Paper 44).

With respect to Patent Owner's motion to terminate, Patent Owner filed its opening brief (Paper 52, "PO Mot. Term."), Petitioner filed an opposition (Paper 53, "Pet. Mot. Reply"), Patent Owner filed a reply (Paper 57, "PO Mot. Reply").

On November 20, 2023, a second oral hearing was held to permit the parties to address the issues of waiver, real party in interest, estoppel, and termination, among others Related Matters

The parties state that the '228 patent is related to the following U.S. Patents: 9,098,531 ("the '531 Patent"); 9,552,376 ("the '376 Patent"); 10,423,658 ("the '658 Patent"); 11,017,020 ("the '020 Patent"); 11,163,823 ("the '823 Patent"), and 11,170,042 ("the '042 Patent"). Paper 4, 2; Paper 11, 1. The parties further state that the '228 patent is related to pending U.S. Patent Application 17/459,933. Paper 4, 3; Paper 11, 2.

The parties identify the following as related district court matters:
MemoryWeb, LLC v. Apple Inc., No. 6:21-cv-00531 (W.D. Tex.);
MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al., No. 6:21-cv-0411

(W.D. Tex.); and *MyHeritage (USA), Inc. et. al. v. MemoryWeb, LLC*, No. 1:21-cv-02666 (N.D. Ill.). Paper 4, 2; Paper 11, 1.

As noted in the prior section of this decision, the parties identify the '228 patent as the subject the *Unified* proceeding and the *Apple* proceeding. The parties also identify the following related patents as the subjects of the following petitions: *Samsung Electronics Co., LTD. v. MemoryWeb LLC*, IPR 2022-00221 ('658 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 ('376 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00111 ('020 patent); *Apple Inc. v. MemoryWeb, LLC*, PGR2022-00006 ('020 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00033 ('658 patent); and *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 ('376 patent). Paper 4, 2–3; Paper 11, 1–2. Petitioner also identifies *Samsung Electronics Co., LTD. v. MemoryWeb LLC*, IPR2022-00885 ('823 patent); and *Samsung Electronics Co., LTD. v. MemoryWeb LLC*, PGR2022-00034 ('823 patent) as proceedings involving related patents. Paper 11, 1–2.

B. *The '228 patent*

The '228 patent for a “Method and Apparatus for Managing Digital Files” issued April 14, 2020. Ex. 1001, codes (45), (54). It “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.” *Id.* at 1:21–24. The '228 patent purports to resolve a need for complementing “the widespread availability of digital files” by providing “a medium that allows people to organize, view, preserve and share these files with all the memory details captured, connected and vivified via an interactive interface.” *Id.* at 1:61–65.

Figure 41 of the '228 patent is reproduced below.

FIG. 41

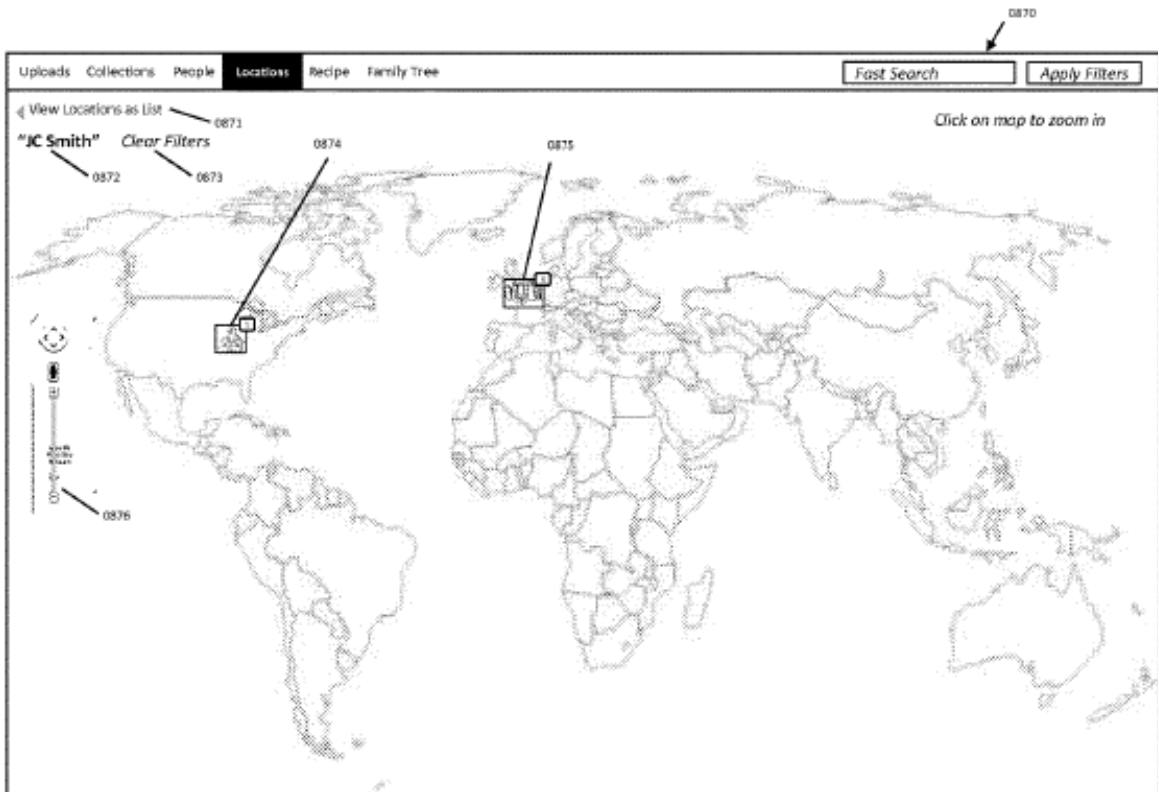


Figure 41 shows a screenshot of a Single Application Dot-Tag Filter in Location Application View that allows a user's access to digital files associated with a particular location. *Id.* at 4:7–8, 29:41–57. As shown in Figure 41, Location Application View 0870 displays Digital Files within an interactive map. *Id.* at Fig. 41, 29:41–44. Individual or groups of Digital Files are illustrated as photo thumbnails 0874, 0875 on the map and a user can zoom in and out or select the thumbnail to see all the Digital Files with the same location as depicted in Figure 34 below. *Id.* at Fig. 41, 29:48–55.

Figure 34 of the '228 patent is reproduced below.

FIG. 34

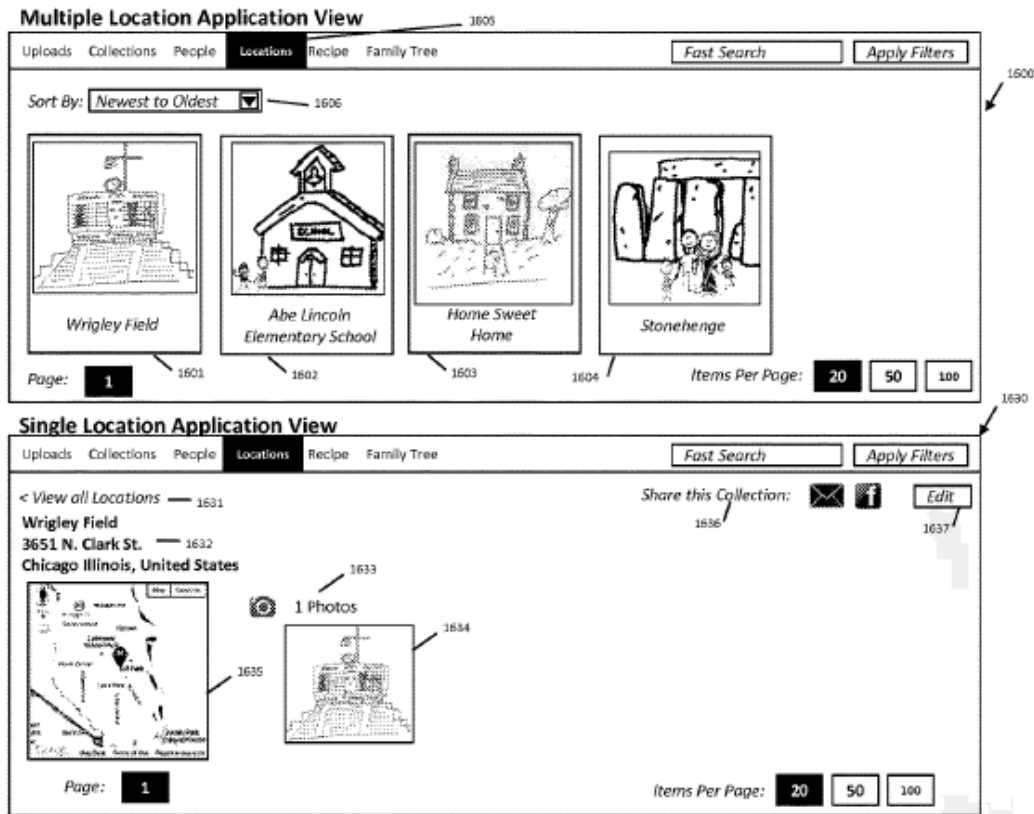


Figure 34 shows a screenshot of Location Application Views. *Id.* at 3:64. As shown in Figure 34, Location Application Views include a first Multiple Location Application View 1600 for displaying all the locations that were created within a user's Application. *Id.* at Fig. 34, 24:16–19. A second Single Location Application View 1630 is displayed when one of the thumbnails, for example, photo thumbnail 0874 from the Location Application View 0870 in Figure 41 is selected. *Id.* at Fig. 34, 29:48–52. In this example, displayed in the Single Location Application View 1630 are the individual location name 1632, thumbnails of each Digital File within specific collections such as one photo 1633 taken at Wrigley Field 1634 that

is associated with the location called Wrigley Field. *Id.* at Fig. 34, 24:37–43.

Figure 32 of the '228 patent is reproduced below.

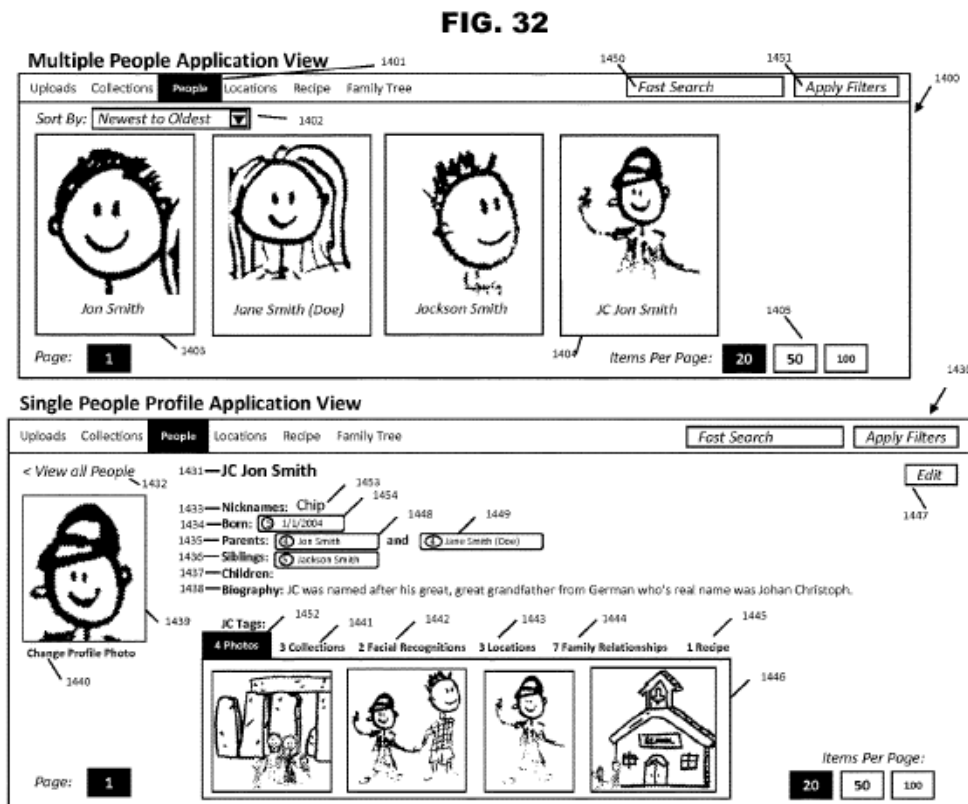


Figure 32 shows a screenshot of People Application Views. *Id.* at 3:62. As shown in Figure 32, People Application Views include a first Multiple People Application View 1400 for displaying all the people that were created within a user's Application, and can be selected by a user "from any Application Views within the Application." *Id.* at Fig. 32, 22:59–64. For each person, such as for Jon Smith as an example, a thumbnail 1403 for that person is shown. *Id.* at Fig. 32, 23:1–5. A second Single People Profile Application View 1430 can be displayed. *Id.* at Fig. 32, 23:12–13. This

example shows individual JC Jon Smith with the following information depicted: individual's name 1431, profile photo 1440 that can be changed, and a number of photos 1452 associated with that person along with thumbnail 1446 of each photo. *Id.* at Fig. 32, 23:13–25.

C. *Challenged Claims*

Petitioner challenges claims 1–19. Pet. 1. Claim 1 is the sole independent claim. Ex. 1001, 35:32–36:11.

Claim 1 is reproduced below with Petitioner's limitation numbering⁴ included for ease of reference.

[1pre] 1. A method comprising:
[1a] responsive to a first input, causing a map view to be displayed on an interface, the map view including:
[1b] (i) an interactive map;
[1c] (ii) a first location selectable thumbnail image at a first location on the interactive map; and
[1d] (iii) a second location selectable thumbnail image at a second location on the interactive map;
[1e] responsive to an input that is indicative of a selection of the first location selectable thumbnail image, causing a first location view to be displayed on the interface, the first location view including (i) a first location name associated with the first location and (ii) a representation of at least a portion of one digital file in a first set of digital files, each of the digital files in the first set of digital files being produced from outputs of one or more digital imaging devices, the first set of digital files including digital files associated with the first location;
[1f] responsive to an input that is indicative of a selection of the second location selectable thumbnail image, causing a second location view to be displayed on the interface, the second location view including (i) a second location name associated with the second location and (ii) a representation of at least a

⁴ From Petitioner's Listing of Challenged Claims. Pet. v.

portion of one digital file in a second set of digital files, each of the digital files in the second set of digital files being produced from outputs of the one or more digital imaging devices, the second set of digital files including digital files associated with the second location; and

[1g] responsive to a second input that is subsequent to the first input, causing a people view to be displayed on the interface, the people view including:

[1h] (i) a first person selectable thumbnail image including a representation of a face of a first person, the first person being associated with a third set of digital files including digital photographs and videos;

[1i] (ii) a first name associated with the first person, the first name being displayed adjacent to the first person selectable thumbnail image;

[1j] (iii) a second person selectable thumbnail image including a representation of a face of a second person, the second person being associated with a fourth set of digital files including digital photographs and videos; and

[1k] (iv) a second name associated with the second person, the second name being displayed adjacent to the second person selectable thumbnail image.

Ex. 1001, 35:32–36:11.

NON-PUBLIC VERSION—PROTECTIVE ORDER MATERIAL

IPR2022-00222

Patent 10,621,228 B2

D. *Asserted Ground of Unpatentability*

Petitioner asserts the following ground of unpatentability:

Claim(s) Challenged	35 U.S.C. §⁵	Reference(s)/Basis
1–19	103(a)	Okamura, ⁶ Belitz ⁷

Pet. 1.

E. *Other Evidence*

Declaration or Deposition	Date	Exhibit No.
Declaration of Philip Greenspun, Ph.D.	December 3, 2021	Ex. 1003
Deposition of Glenn Reinman, Ph.D	November 16, 2022	Ex. 1040
Declaration of Philip Greenspun, Ph.D.	December 13, 2022	Ex. 1041
Declaration of Glenn Reinman, Ph. D.	March 16, 2021	Ex. 2001
Deposition of Philip Greenspun, Ph.D.	August 26, 2022	Ex. 2022
Declaration of Glenn Reinman, Ph.D.	September 6, 2021	Ex. 2023
Deposition of Kevin Jakel	May 26, 2022	Ex. 2062
Declaration of Kevin Jakel	December 30, 2021	Ex. 2071
Deposition of Kevin Jakel	September 7, 2023	Ex. 2085
Declaration of Youngmo Koo	September 17, 2023	Ex. 2099

⁵ The Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. The ’228 patent claims priority to Patent Application No. 13/157,214, providing an effective filing date of June 9, 2011. *See* Ex. 1001, code (63). Because this priority date is before the effective date of the applicable AIA amendments (March 16, 2013), we use the pre-AIA version of 35 U.S.C. §103 in this proceeding.

⁶ Okamura et al., U.S. Patent Publication No. 2011/0122153 A1, published May 26, 2011 (Ex. 1005) (“Okamura”).

⁷ Belitz et al., U.S. Patent Publication No. 2010/0058212 A1, published March 4, 2010 (Ex. 1006) (“Belitz”).

II. ANALYSIS

A. *Forfeiture/Waiver*⁸

1. *Petitioner's Arguments*

Petitioner contends that Patent Owner has waived its ability to raise a real party in interest (“RPI”) issue in this proceeding. Paper 39.

Specifically, Petitioner contends that Patent Owner knowingly waived the RPI Issue (*id.* at 4–11), ignored PTAB Precedent (*id.* at 11–13), and should not be rescued from a predicament of its own making (*id.* at 13–15).

In support of these contentions, Petitioner asserts that following institution, Patent Owner had the opportunity to rebut the Board’s initial RPI determination by properly and timely addressing the RPI issue in its Patent Owner Response. Paper 39, 6. Petitioner asserts that instead of rebutting the Board’s initial determination, Patent Owner “chose to not say anything at all, providing *zero* evidence/argument to rebut the RPI identification as provided in this proceeding by [Petitioner] and as endorsed by the Board in the institution decision. *Id.* According to Petitioner, “[t]here can be no clearer case of forfeiture/waiver.” *Id.* (citing *Unified Patents, LLC, v. Gesture Technology Partners, LLC*, IPR2021-00917, Paper 32, 5 (PTAB Dec. 16, 2022) (emphasis omitted); *Google LLC v. Uniloc 2017 LLC*, IPR2020-00447, Paper 24, 9-10 n. 6 (PTAB May 11, 2021); Consolidated

⁸ Petitioner observes that the Federal Circuit and the Board “often use the terms ‘waiver’ and ‘forfeiture’ interchangeably” when discussing these principles.” Paper 39, 4 (citing *In re Google Tech. Holdings LLC*, 980 F.3d 858, 862–863, n.8 (Fed. Cir. 2020)). For purposes of this decision, we use the terminology “waiver” or “waived.”

Trial Practice Guide (“CTPG”)⁹ at 94). Petitioner also asserts that Patent Owner even more clearly manifested its unmistakable intent to forfeit/waive the RPI issue because in its Sur-reply Patent Owner simply chose to proclaim that estoppel would apply if the Board determined that Petitioner is an unnamed RPI in the *Unified* proceeding without addressing much less acknowledging Petitioner’s argument that RPI had not been brought into dispute in this proceeding. *Id.* at 7 (citing Paper 30, 33).

Petitioner notes that in the *Unified* proceeding, the initial institution decision (denying institution) was issued six months prior to Patent Owner’s filing of its Response in this proceeding. Paper 39, 7. Petitioner notes further that in the initial institution decision in the *Unified* proceeding, “the Board had declined to address the RPI issue because an RPI analysis was deemed to be not warranted in that proceeding as per ‘the Board’s precedential decision in *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (PTAB Oct. 6, 2020) (precedential).” *Id.* (citing *Unified*, Paper 15, 13). Petitioner also notes that “Director Vidal, in the Decision Granting Director Review, later confirmed the applicability of *SharkNinja*’s reasoning to the *Unified* proceeding. *Id.* at 8 (citing *Unified*, Paper 76, 5).

In view of these noted circumstances, Petitioner asserts that Patent Owner “knowingly and repeatedly refused to address the RPI issue in this proceeding” and that Petitioner’s “contention that it was not an RPI in the Unified IPR therefore stands unchallenged.” Paper 39, 9. In view of these

⁹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

circumstances, Petitioner asserts further that its “only recourse appears to have been taking some sort of third party action in the Unified IPR—this assuming knowledge of papers and evidence under seal in that proceeding.” *Id.* at 10. In addition, Petitioner asserts that the party seeking to avail itself of relief must create a record and establish a baseline of evidence and create a reasonable opportunity for the party targeted by such relief to understand the allegation, and respond to it. *Id.* at 10.

In addition, Petitioner asserts that Patent Owner should have known by the institution date of the *Unified* proceeding that it was the wrong proceeding to challenge any alleged RPI issue involving Unified because even if Petitioner and Apple were unnamed RPI’s it would not create a time bar or estoppel under 35 U.S.C. § 315. Paper 38, 11–12 (citing *Unified*, Paper 15, 13). Petitioner asserts that Patent Owner repeatedly ignored the Board’s guidance and PTAB precedent and should not be excused from the plain notice and diligence requirements in PTAB proceedings. *Id.* at 14.

2. *Patent Owner’s Response*

Patent Owner responds that prior to the Director’s Decision in the *Unified* proceeding, nothing suggested that it would have to re-prove in this proceeding that Unified failed to name Petitioner as an RPI. Paper 43, 1. Patent Owner contends that Petitioner “cites no authority, prior to the Director Decision, dictating that [it] should have raised Unified’s incorrect RPI identification in *Unified* in this proceeding prior to issuance of the Unified FWD.”¹⁰ *Id.* at 3 (citing *id.* at 6–11). Patent Owner contends

¹⁰ Final written decision.

further that Petitioner’s complaint that Patent Owner’s arguments and evidence in the *Unified* proceeding were cloaked by seal and could not even be reviewed by Petitioner is disingenuous because Petitioner “is fully aware of its business and financial arrangements with Unified, including the terms and benefits of its membership agreement.” *Id.* at 4. Patent Owner also contends that Petitioner was also fully aware that Patent Owner challenged Unified’s failure to name Petitioner as an RPI in *Unified*. *Id.* In addition, Patent Owner contends that Petitioner’s claim that it prejudiced Petitioner “by ‘frustrating the efficiency and speed of IPR’ and adding ‘unanticipated costs and delay’ is also disingenuous” because Petitioner “fails to explain how any perceived delay actually prejudices it — especially as the Board has already found cause to extend the statutory deadline to December 13, 2023, and any delay allows [Petitioner] to maintain the stay of the district court litigation.” *Id.* at 4–5 (citing Paper 39, 2–3; Paper 35).

Patent Owner responds further that nothing in its Response or Sur-reply reflects an intentional waiver of its right to seek termination of this proceeding based on the final written decision in the *Unified* proceeding and Petitioner’s status as an unnamed RPI in that proceeding. Paper 43, 6 (citing *United States v. Olano*, 507 U.S. 725, 733 (1993)). Patent Owner asserts further that its Response and Sur-Reply “could not have intentionally relinquished or abandoned that right because the right did not exist until the Unified FWD issued on March 14, 2023.” *Id.* (citing *id.* at 2). In addition, Patent Owner asserts that it has timely requested authorization to seek relief based on the final written decision in the *Unified* proceeding. *Id.* (citing *Olano*, 507 U.S. at 733).

Patent Owner also responds that Petitioner mischaracterizes *SharkNinja*. Paper 43, 12. According to Patent Owner, “[i]n *SharkNinja*, the Board declined to address the patent owner’s RPI arguments *at the institution stage*, in part, because there was ‘no allegation or evidence that’ the unnamed RPI was ‘barred or estopped’ or ‘purposely omitted . . . to gain some advantage.’” *Id.* (citing *SharkNinja*, Paper 11, 19). Petitioner asserts further that “*SharkNinja* did not hold that the Board must decline to address the petitioner’s failure to identify all RPIs in the final written decision” and that “the Director Decision represents a significant expansion of the reasoning in *SharkNinja* and constitutes new guidance or an intervening change in the law, which supplies good cause to excuse any untimeliness on” Patent Owner’s part. *Id.* (Paper 40, 7–10).

In addition, Patent Owner responds that Petitioner mischaracterizes the Institution Decision in the *Unified* proceeding. Paper 43, 13. According to Patent Owner, “[t]he *Unified* Institution Decision merely explained that ‘an RPI analysis is not required *at institution*’ – it did not indicate that the Board would not perform an RPI analysis in its final written decision.” *Id.* (citing *Unified*, Paper 15 as 13–14). Patent Owner responds further that Petitioner’s mischaracterization of the Institution Decision in the *Unified* proceeding is also belied by the RPI Order in that proceeding, where the Board discussed *SharkNinja* yet decided the RPI issue. *Id.* (citing Ex. 2038, 3, 5–6). Patent Owner asserts that the Board’s RPI Order refutes Petitioner’s spurious claim that Patent Owner ignored clear PTAB precedent. *Id.* (citing Paper 39, 13). Moreover, according to Patent Owner, “if *SharkNinja* was

such ‘clear’ precedent, then Unified surely would have cited it in *Unified*.”
Id.

3. Discussion

After considering the evidence and the arguments of the parties, we determine that the weight of the evidence establishes that Patent Owner has not waived any right it may have to raise the RPI issue or assert estoppel under 35 U.S.C. § 315(e)(1) in this proceeding.

a) Notice

35 U.S.C. § 312 (a)(2) states that “[a] petition filed under section 311 may be considered only if . . . the petition identifies all real parties in interest.” 37 C.F.R. § 42.8 (b)(1) of the Board’s rules regarding mandatory notices also requires that the petition “[i]dentify each real party-in-interest for the party.”

Citing 35 U.S.C. § 312, Patent Owner first alleged in its Patent Owner Preliminary Response in the *Unified* proceeding filed on December 12, 2021, that “the Petition fails to name all real parties-in-interest (“RPIs”), including at least Samsung and Apple, and should therefore be denied.” *See Unified*, Paper 8, 22. Patent Owner repeated this same allegation in the *Unified* proceeding approximately six months later in its Response filed on June 6, 2022. *See Unified*, Paper 23, 14 (“the Board should terminate this proceeding because Petitioner has failed to name all real parties-in-interest (“RPIs”), including at least Samsung and Apple”). The question thus becomes whether Patent Owner properly noticed Petitioner it was alleging that Petitioner was an unnamed RPI in the *Unified* case, so that Petitioner would have fair notice and an opportunity to respond.

In this proceeding, Patent Owner stated in its Response that it had “asked the Board to determine that Petitioner is an unnamed RPI” in the *Unified* proceeding. PO Resp. 64 (citing Ex. 2021, 18–26). Patent Owner further requested that Petitioner be estopped from maintaining this proceeding if the final written decision in the *Unified* proceeding determined that Petitioner was an unnamed RPI in that proceeding. *Id.* Patent Owner maintained its position that Petitioner was an unnamed RPI in the *Unified* proceeding in its Sur-reply where it reiterated its position that if Petitioner is found to be an unnamed RPI in the *Unified* proceeding it should be estopped from maintaining this proceeding. PO Sur-reply 33. Thus, Petitioner was clearly on notice that its RPI status in the *Unified* proceed was at issue in this proceeding.

b) Estoppel

Our rules provide that “[a] party should seek relief promptly after the need for relief is identified.” 37 C.F.R. § 42.25(b) (2023). As outlined above, Patent Owner clearly indicated its intent to request estoppel if Petitioner was found to be an RPI in the *Unified* proceeding in its Response and Sur-reply. Thus, Patent Owner did not waive its right to request that Petitioner be estopped in this proceeding. Moreover, we agree with Patent Owner that the issue in this proceeding is not whether Petitioner is an RPI in this proceeding (as it surely must be), but whether Petitioner should be estopped from maintaining this proceeding because it is an unnamed RPI in the *Unified* proceeding.

c) *Timing*

The circumstances of this proceeding are unique in that neither the parties nor the Board could have known, prior to the Director's Decision, that the Director would vacate the Board's RPI order in the *Unified* proceeding. Petitioner asserts that Patent Owner should have submitted its evidence that Petitioner was an unnamed RPI in the *Unified* proceeding when it noticed Petitioner that RPI was at issue in that proceeding. We disagree. At the time Patent Owner filed its Response and Sur-reply it appeared that the question of whether or not Petitioner was an RPI in the *Unified* proceeding would be resolved in that proceeding. We do not agree with Petitioner that Patent Owner should have known at the time that it filed its Response and Sur-reply in this case that the precedent set forth in *SharkNinja* would be extended to preclude the Board's consideration of the RPI issue in its final written decision in the *Unified* proceeding.

For these reasons, we determine that Patent Owner has not waived its right to raise a real party in interest issue in this proceeding.

B. *Real Party in Interest*

Petitioner states that "Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. are the real parties in interest." Pet. 92. Patent Owner states that it, MemoryWeb, LLC, is the real party in interest. Paper 4, 2.

Whether Petitioner is a RPI in this proceeding is not at issue. At issue is whether Petitioner is an unnamed RPI in the *Unified* proceeding.

a) *Legal Principles*

We authorized discovery and briefing to allow the parties to address this issue. Paper 44; Paper 45. Our regulations require that parties “[i]dentify each real party-in-interest for the party” as part of its mandatory notices, and to timely update any change in the information provided in those notices. 37 C.F.R. §§ 42.8(a), (b)(1) (2023). The parties have a duty of candor and good faith when they comply with the requirements set forth in Section 42.8. *See* 37 C.F.R. § 42.11(a) (2023) (stating that parties have a duty of candor and good faith in proceedings).

The mandatory notice provision requiring the identification of all real parties in interest serves important notice functions to patent owners, to identify whether the petitioner is barred from filing a petition because of a real party in interest that is time-barred or otherwise estopped, and to the Board, to identify conflicts of interests that are not readily apparent from the identity of the petitioner. *See NOF Corp. v. Nektar Therapeutics*, IPR2019-01397, Paper 24 at 6 (PTAB Feb. 10, 2020) (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide 12 (Nov. 2019) (“*TPG*”)).¹¹

Whether a non-party is an RPI is a “highly fact-dependent question” and must be considered on a case-by-case basis. *Ventex Co. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152 at 6 (PTAB Jan. 24, 2019) (precedential). With respect to a petition’s identification of real parties in interest, the Federal Circuit has stated that

¹¹ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>

[a] petition is presumed to identify accurately all RPIs. *See Zerto, Inc. v. EMC Corp.*, Case IPR2014-01295, slip op. at 6–7 (PTAB Mar. 3, 2015) (Paper 34). When a patent owner provides sufficient evidence prior to institution that reasonably brings into question the accuracy of a petitioner’s identification of RPIs, the overall burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all RPIs.

Applications in Internet Time, LLC v. RPX Corp., 897 F.3d 1336, 1343 (Fed. Cir. 2018) (“*AIT*”). In a slightly later case, the Federal Circuit also stated that

[a] “petitioner’s initial identification of the real parties in interest should be accepted unless and until disputed by a patent owner.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1243 (Fed. Cir. 2018). To dispute it, the patent owner “must produce *some* evidence that tends to show that a particular third party should be named a real party in interest.” *Id.* at 1244.

VirnetX Inc. v. Mangrove Partners Master Fund, Ltd., 778 Fed. Appx. 897, 902 (Fed. Cir. 2019) (“*VirnetX*”).

b) Threshold Question

Given this direction, we must first consider the threshold question of whether Patent Owner has produced “some evidence that tends to show that a particular third party should be named a real party in interest” and whether that evidence “reasonably brings into question the accuracy of a petitioner’s identification of RPIs” in the Petition at issue. *AIT*, 897 F.3d at 1343. We also keep in mind that “the overall burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all RPIs.” *Id.*

In the *Unified* proceeding, Unified, as part of its mandatory notice obligations, identified itself as the only real party in interest. *Unified*,

Paper 2, 1. After filing its Petition in the *Unified* proceeding, Unified updated its mandatory notices four times, but on each occasion indicated that “[n]o updates to the real party-in-interest . . . are made at this time.” See *Unified*, Papers 6, 14, 17, 39. Patent Owner disputes Unified’s identification of itself as the only real party in interest, and requests that the Board determine that Petitioner is an unnamed RPI in the *Unified* proceeding. PO Resp. 64. To support this contention, Patent Owner points to evidence (summarized in Section II.B.c.1 below) regarding Unified’s business model, suggesting that the *Unified* proceeding was filed at Petitioner’s request, suggesting that Unified operates for the benefit of its members, suggesting that Petitioner desired *inter partes* review of the ’228 patent and benefited from this review, regarding Unified’s interest in the *Unified* proceeding, and suggesting communications and coordination between Petitioner and Unified. PO Mot. Term. 10–27. Taken together this evidence reasonably calls into question the accuracy of Unified’s identification of itself as the sole RPI in the *Unified* proceeding.

c) *Identification of Real Parties in Interest in the Unified Proceeding*

Having resolved the threshold question, we now consider the question of whether Unified complied with its obligation to “[i]dentify each real party-in-interest.” 37 C.F.R. §§ 42.8 (2023); *AIT*, 897 F.3d at 1343 (“the overall burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all RPIs”). As stated by the Federal Circuit, “[d]etermining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable

and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *AIT*, 897 F.3d at 1351.

In *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128, 24–25 (PTAB Oct. 2, 2020) (“*AIT II*”), the Board considered a number of factors to determine whether an unnamed third-party should have been named as an RPI in a proceeding. The factors¹² relevant to the inquiry here would include: (a) Unified’s business model, including the nature of Unified as an entity; (b) Unified’s interests in the *Unified* proceeding; (c) whether, and under what circumstances, Unified takes a particular member’s interests into account when determining whether to file IPR petitions; (d) Petitioner’s relationship with Unified; (e) Petitioner’s interest in and potential benefit from the IPR and whether Unified can be said to be representing that interest; (f) whether Petitioner actually desired review of the ’228 patent;¹³ (g) any communications or coordination between Unified and Petitioner;¹⁴ and (h) whether Petitioner funded, directed, influenced, or

¹² We recognize that some of the factors we consider, such as “control,” are not among the enumerated factors listed in the “Factual Findings” section of the *AIT II* decision. See *AIT II*, Paper 128 at 10. However, the issue of “control” is discussed in the “Analysis” section of that case and these factors are relevant to the RPI inquiry here. See *id.* at 32–33; see also *TPG* at 15–17.

¹³ In Section II.B.5.e below we discuss Petitioner’s desire for review of the ’228 patent as part of our discussion of Petitioner’s interest in and potential benefit from the *Unified* proceeding.

¹⁴ In Section II.B.5.d below we discuss communications and coordination between Unified and Petitioner as part of our discussion of Petitioner’s relationship with Unified.

exercised control over Unified's participation in the *Unified* proceeding. *See AIT II*, Paper 128 at 10 (citing *AIT*, 897 F.3d at 1358)5; *TPG* at 12–18.

(1) *Patent Owner's Contentions*

Patent Owner contends that in return for the payment of large sums of money to fund challenges, Unified monitors court filings and selectively challenges patents to benefit its members. PO Mot. Term 27. Patent Owner contends that although Unified picks the targets, its IPR petitions are filed to benefit its financiers like Petitioner. *Id.* Patent Owner contends further that Petitioner should have been named an RPI in the *Unified* proceeding, because it [REDACTED]

[REDACTED]. *Id.* Patent Owner makes six arguments in support of these contentions, which we summarize below.

(a) *Unified's Business Model*

Patent Owner contends that Unified's Business Model shows that Petitioner is an unnamed RPI in the *Unified* proceeding. PO Mot. Term. 10. To support this contention, Patent Owner points to evidence indicating that Unified uses a business model that gives the appearance of independence from its member, while enabling Unified to file requests for *inter partes* reviews that directly benefits its members without having to name the benefited members as RPIs. *Id.* Specifically, Petitioner points to Unified's agreement with Patent Owner to file validity challenges, fees paid by Patent Owner and others to fund these challenges, and the amount of its budget that Unified spends on validity challenges. *Id.* at 10–15.

(i) *Alleged Agreement to File
Validity Challenges*

According to Patent Owner, “Unified operates as a membership organization wherein member companies, such as Samsung, enter into Unified’s ‘Membership Agreements’ and pay Unified ‘annual, non-refundable, membership fees’ in exchange for Unified’s services.” PO Mot. Term. 10 (citing Ex. 2067, 4; Ex. 2074, 20). Patent Owner contends that “Unified’s Membership agreements provide, in relevant part, that Unified

[REDACTED]
[REDACTED]
[REDACTED]” with
the result that “[REDACTED]

[REDACTED]” Patent Owner. *Id.* at 11 (citing Ex. 2067,¹⁶ 4). Patent Owner contends further that “Unified has advertised that its operating structure ‘provides *complete alignment* between Unified Patents and its member companies.’” *Id.* at 11–12 (citing Ex. 2057, 1; 2088, 5).

(ii) *Fees Paid by Samsung and
Others to Fund Validity Challenges*

Patent Owner contends that membership fees, such as those paid by Samsung, fund validity challenges, such as the *Unified* proceeding. PO Mot. Term. 12 (citing Ex. 2085. 33:11–34:5). Patent Owner points to Mr. Jakel’s¹⁷ testimony that, [REDACTED]
[REDACTED]

¹⁵ Non-practicing entities.

¹⁶ Patent Owner cites Ex. 2073, which is the exhibit number for this exhibit in the *Apple* proceeding. In this proceeding the exhibit number is 2067.

¹⁷ Mr. Jakel is the CEO of Unified Patents, LLC.

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[REDACTED]
Id. (citing Ex. 2085, 29:21–30:8, 31:18–32:17; Ex. 2062, 35:10–23). Patent Owner further contends that Patent Owner “became a Unified member in

[REDACTED]
[REDACTED]”
Id. at 13 (citing Ex. 2085, 57:2–21; E. 2067, 14; E. 2071 ¶ 20).

(iii) *Unified’s Spending on Member-Funded Validity Challenges*

Patent Owner contends that less than two months after Unified filed the *Unified* proceeding, as part of enticing Petitioner to renew its subscription, Unified [REDACTED] [REDACTED]” PO Mot. Term. 13 (citing Ex. 2078¹⁸; Ex. 2077, 19). Patent Owner asserts that Unified’s “[REDACTED] [REDACTED] [REDACTED]” *Id.* at 13–14 (citing Ex. 2077, 19). Patent Owner asserts further that [REDACTED] [REDACTED] [REDACTED]” *Id.* at 14 (citing Ex. 2085, 110:11–18). In addition, according to Patent Owner, [REDACTED] [REDACTED] corresponds to [REDACTED] on Unified’s ‘in-house’ legal team.” *Id.* (citing Ex. 2085, 11:15–12:4). Noting that “Mr. Jakel estimated

¹⁸ Patent Owner refers to page 49 of Ex. 2078, however, Ex. 2078 is a one-page email. Thus, it appears that the reference to page 49 of this exhibit is in error.

that Unified's in-house legal team [REDACTED]
[REDACTED] Patent Owner contends that "[REDACTED]
[REDACTED]
[REDACTED]" *Id.* at 14–15 (citing Ex. 2085, 112:23–113:9).

*(b) Allegation That Unified Files Petitions at
Petitioner's Behest*

Noting that "a 'non party to an IPR can be a real party in interest, even without entering into an express or implied agreement with the petitioner to file an IPR petition,'" Patent Owner contends that "Unified cannot credibly deny that its business model [REDACTED]
[REDACTED] on validity challenges benefiting its members." PO Mot. Term. 15–16 (citing *AIT*, 897 F.3d at 1354).

Patent Owner contends [REDACTED] validity challenges are the primary value proposition Unified offers and refers to actions Unified took before and after filing its petition in the *Unified* proceeding as an example. *Id.* at 16–17. Patent Owner then explains how [REDACTED]
[REDACTED] membership renewal date approaches [REDACTED]. at 17. According to Patent Owner, [REDACTED]
[REDACTED]. Patent Owner admits that [REDACTED] Unified's monitoring of technology sectors and data analytics, but asserts that these actions are merely ancillary to its purpose and "are not what members pay for." *Id.* at 18. Patent Owner points to Mr. Jakel's testimony

that “Unified engages in these activities ‘on behalf of’ a zone (including members such as [Petitioner]), and hopes Unified’s ‘members appreciate that work’ and will “continue to remain members” in support of these contentions. *Id.* at 18–19 (citing Ex. 2085, 89:9–12; Exs. 2083–2084).

(c) Allegation that Petitioner Desired Review of the '228 Patent and Has Benefited From this Review

Patent Owner contends that Petitioner desired review of the '228 patent as evidenced by the fact that it filed the instant Petitioner not long after the *Unified* proceeding was filed. PO Mot. Term. 19. Patent Owner also contends that Unified’s argument that it does not and cannot know if Petitioner benefits from the *Unified* proceeding is not credible because Petitioner benefits if Unified prevails in canceling claims of the '228 patent asserted against Petitioner in district court. *Id.* (citing; *AIT*, 897 F.3d at 1363).

Patent Owner contends further that Unified must have expected to derive some benefit from directly challenging the '228 patent itself based on the benefit conferred on Petitioner because [REDACTED]. PO Mot. Term. 19. Patent Owner contends further that “Unified’s documents acknowledge the alignment of interests and benefits between Unified and its member companies,” and its “website touts [that] its strategic operational structure ‘provide[s] complete alignment between Unified Patents and its member companies.’” *Id.* at 20 (citing Ex. 2057, 1).

(d) Allegation That Unified Operates for the Benefit of its Members

Patent Owner contends that “Unified has claimed it filed the Unified IPR ‘to deter the use of invalid patents in its Content Zone, not to protect the interests of any one member,’” but “Unified has not explained why, among the countless other patents being enforced in Unified’s ‘Content Zone,’ Unified chose to challenge *this* ’228 patent or only claims 1–7.” PO Mot. Term. 20 (citing Ex. 2071 ¶ 18). Patent Owner contends that “Unified’s rationale makes no sense when viewed in the greater context required in an RPI/privy determination. If it succeeds in that challenge, the public who it professes to protect (including its members) would still face potential liability for claims 8–19” whereas if Petitioner succeeds “all claims will be invalid and no entity (Unified member or not) will face potential liability.” *Id.* at 20–21. According to Patent Owner, “[t]he only logical conclusion is that Unified orchestrated campaigns challenging only a subset of claims, while allowing its members to challenge every claim, to harass patent owners it deems unworthy of patent protection. *Id.* at 21 (citing Trial Practice Guide, 77 Fed. Reg. 48756, 48759 (Aug. 14, 2012)).

Patent Owner further contends that “simply because Unified may have filed [its Petition in the *Unified* proceeding] to ‘deter the use of invalid patents in its Content Zone,’ does not mean that Unified did not recognize, understand, and fully appreciate that it was choosing to challenge a patent that was already being enforced against” Petitioner. PO Mot. Term. 21 (citing Ex. 2071 ¶ 18). Patent Owner asserts that “Mr. Jakel acknowledged that Unified first learned about the ’228 patent precisely because it was

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being enforced against Samsung . . . in district court.” *Id.* (citing Ex. 2085, 63:20–64:17).

In addition, Patent Owner contends that “Unified’s settlement strategy further confirms that it acts on behalf of its members rather than deterring the use of invalid patents against all members and nonmembers alike practicing in a technology zone” as evidenced by the fact that “[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]” *Id.* at 21–22 (citing Ex. 2085, 226:25–228:8). According to Patent Owner,

[REDACTED]

Id. at 22.

(e) *Unified’s Interest in the Unified Proceeding*

According to Patent Owner, “[t]he Federal Circuit has instructed that a petitioner’s “own interest” in an IPR is relevant to the RPI inquiry” and “[t]he Board has found that when a petitioner (1) ‘selects patents to challenge, at least in part, to reduce risk to existing clients’ and (2) has no ‘risk of liability for infringement of the patents at issue,’ these facts support a conclusion that their client is an RPI.” PO Mot. Term. 22 (citing *AIT*, 897 F.3d at 1354; *AIT II*, Paper 128, 16–17). Patent Owner contends “[t]hat is precisely the case here: Unified faces no risk of liability and it selected

the ‘228 patent based at least in part on the . . . Samsung litigation[.]” and its “interest in this IPR is to attempt to sell its current members on renewing their membership or to attract new paying members.” *Id.* (citing *id.* at 15–19;¹⁹ Ex. 2077, 28).

*(f) Alleged Communications or Coordination
With Petitioner*

Patent Owner contends that it is clear that Unified carefully devised its operations in view of the *AIT II* case law to avoid communications about a forthcoming IPR challenging a patent asserted against one of its members for the sole purpose of avoiding having to name the member as an RPI. PO Mot. Term. 23–24 (citing *AIT II*, Paper 128, 17–20). In support of this contention, Patent Owner asserts that “Mr. Jakel has stated [that] ‘Unified Patents is well-aware of these issues, and has carefully structured [its] solution to comply with all of the existing legal requirements to file administrative challenges as the sole RPI.’” *Id.* at 24 (citing Ex. 2052, 1).

Patent Owner contends further that although “Mr. Jakel claims Unified acts ‘to benefit the zone and the technology area,’ that it is ‘not about the individual members’ and that he has ‘no knowledge about whether or not’ his paying members wish to avoid estoppel,” “Unified’s filing habits since the time of the RPI order [in the *Unified* proceeding] suggest otherwise.” *Id.* at 24–25 (citing Ex. 2085, 90:14–23, 177: 1–5) (footnote omitted). According to Patent Owner, “Docketnavigator.com reveals that

¹⁹ Patent Owner cites section 5.IV.A.2; however, there is not such section in this Motion. We assume that the leading “5” in the citation is a typographical error.

Unified filed one or more IPR petitions each calendar month since March 2021, but this practice immediately stopped the moment the RPI Order issued March 8, 2023 and has not resumed for the past six months.” *Id.* at 25 (citing Ex. 2089).

In addition, Patent Owner contends that [REDACTED]
[REDACTED]
[REDACTED], Unified still promotes the success of its patent validity challenges [REDACTED]
[REDACTED]” PO Mot. Term. 25 (citing Ex. 2059, 1; Ex. 2019, 11). Patent Owner asserts that “[s]uch conduct suggests that Unified acts for the financial benefit of its members [REDACTED]
[REDACTED]
[REDACTED]” and that “[t]his indicates that Unified has crafted its membership agreements and its communication protocols with an eye to avoid naming members as RPIs.” *Id.* at 25–26. According to Patent Owner, “[t]his creates an obvious advantage for Unified’s members because it allows Unified to act as a proxy for its members interests while attempting to avoid naming its members as an RPI, thus insulating Unified’s members from being subjected to the statutory estoppel provisions of 35 U.S.C. § 315(e).” *Id.*

Turning back to its consideration of Unified’s interest in the *Unified* proceeding, Patent Owner contends that “[w]hether they are called ‘clients’ or ‘members,’ Unified challenges patents to reduce or eliminate risk to members like [Petitioner]. Indeed, reducing members’ litigation risk by challenging patents is the ‘sole purpose’ of Unified’s primary business,

weighing in favor of finding [Petitioner] to be an RPI” in the *Unified* proceeding. *Id.* at 26 (citing Ex. 2071 ¶ 5).

(2) *Petitioner’s Reply to Patent Owner’s Motion to Terminate*

Petitioner asserts that it is not a real party in interest in the *Unified* proceeding. Pet. Mot. Reply 1. According to Petitioner, there is no evidence to suggest that the *Unified* proceeding was filed at Petitioner’s behest or with its control, that no communications occurred between Petitioner and Unified, and that Petitioner did not direct the filing of the *Unified* proceeding. *Id.*

(a) *Unified’s Business Model*

Petitioner asserts that “Unified’s business model, which the PTAB has consistently viewed as failing to create an RPI relationship with its members, endeavored to ‘comply with the real party-in-interest rules from day one’ and allow Unified to conduct its ‘own independent business which is deterrence[.]’” Pet. Mot. Reply 13 (citing Ex. 2085, 86:14–87:12, 212:18–215: 23; *Unified Pats., LLC v. Cellular Commc’ns Equip. LLC*, IPR2018-00091, Paper 33, 11–12 (PTAB May 22, 2019) (“*CCE*”); *Unified Patents Inc. v. Bradium Techs. LLC*, IPR2018-00952, Paper 31, 8-9 (PTAB Dec. 20, 2018)) (“*Bradium*”). Petitioner asserts that nothing has changed in how Unified goes about its business and its business model remains focused on deterrence of NPE activity. Pet. Mot. Reply 13–14. In support, Petitioner points to Mr. Jakel’s testimony “

[REDACTED]

_____.” Pet. Mot. Reply 14 (citing Ex. 2085, 2241:25–242:9). Thus, according to Petitioner “Unified’s view toward settlements are aligned with its general objective of deterring NPE activity.” *Id.*

In addition, Petitioner asserts that contrary to Patent Owner’s contentions, filing invalidity challenges is just one of various different deterrence activities that Unified regularly engages in. Pet. Mot. Reply. 14 (citing Ex. 2085, 185:12–187:18; Ex, 2057, 1; Ex. 2088, 5).

(b) Response to Allegations That Unified Files Petitions at Petitioner’s Behest, That Petitioner Has Benefited From the Unified Proceeding, and That Unified Operates for the Benefit of its Members

Petitioner asserts that Patent Owner has not established that the *Unified* proceeding was filed at its behest. Pet. Mot. Reply 5–6, Pet. Sur-reply 5–6. Petitioner asserts that the testimony of Mr. Koo “did not equivocate in clarifying that [it] ‘did not have any interactions with Unified regarding its decision to file the Unified IPR or its choice of particular claims to challenge’” and that it “‘did not give any input to Unified concerning its decision to challenge the ’228 Patent’ and further ‘did not give any input to Unified in its preparation of the Unified IPR.’” Pet. Mot. Reply 6 (citing Ex. 2099 ¶¶ 4–5). Petitioner asserts further that this “testimony is wholly consistent with that given by Unified’s Mr. Kevin Jakel, who confirmed that _____ and that it’s strictly ‘Unified’s decision to use challenges as a deterrence tool or not.’” *Id.* (citing Ex. 2085,

158:20–159:2). In addition, Petitioner asserts that “in the now vacated RPI Order, this panel acknowledged that ‘Unified’s members do not exercise direction or control over Unified’s decisions to contest patents and its filings’ and that ‘[t]here is no evidence of overt direction or control by Unified’s members in the record.’” Pet. Mot. Reply at 6–7 (citing Ex. 2074, 26).

Petitioner also asserts that “[t]he Board has repeatedly considered similar facts in previous cases involving Unified and consistently came to the logical conclusion that Unified did not act on its members’ behest and further that it was not in an RPI relationship with its members.” Pet. Mot. Reply 7 (citing *Unified Patents, LLC v. American Patents, LLC*, IPR2019-00482, Paper 115, 46–47 (PTAB Aug. 6, 2019) (“*American Patents*”); *Charles Alan Wright, Arthur R. Miller & Edward H. Cooper, Federal Practice & Procedure* § 4449). Petitioner asserts further that it did not benefit from Unified’s actions any more than others in the zone. *Id.* Petitioner asserts that in a case like this, where Petitioner

was not subject to any time-bar preventing them from filing its own petition, “a benefit to a member from an IPR filed by [Unified] must be weighed against the benefit that member receives from filing its own IPR in which that member can control the prior art references chosen, the counsel used, the amount of money spent, and whether or not to settle the case.”

Id. at 8 (citing *Unified Patents Inc. v. Bradium Techs. LLC*, IPR2018-00952, Paper 31, 10-11 (PTAB Dec. 20, 2018)).

Concerning the benefits to itself, Petitioner asserts that it sees limited benefit because it decided to independently challenge a different claim set than that challenged in the *Unified* proceeding to protect its own interests.

Pet. Mot. Reply 8 (citing Ex. 2099 ¶ 5). Petitioner asserts that in the co-pending district court case Patent Owner could simply choose to drop claims 1–7 (the claims challenged in the *Unified* proceeding) from its contentions and Petitioner would be left to defend itself against claims 8–19 (which were not challenged in the *Unified* proceeding). *Id.* at 9. According to Petitioner, not only would Unified’s success in invalidating claims 1–7 have very little positive impact, the potential of Unified’s departure from its desired claim construction as well as other strategic considerations could in reality end up hurting Petitioner in the district court litigation. *Id.* Petitioner asserts that if the *Unified* proceeding was designed to benefit it, “as opposed to merely creating a general deterrence effect against NPEs in the zone, Unified would have challenged all asserted claims 1-19” and that Unified’s “failure to do so reflects true independence in Unified’s actions and not some attempt at gaming the system.” *Id.*

In support of these assertions, Petitioner points to Mr. Jakel’s testimony that “Unified regularly challenges patents that are not asserted against any of its member companies” and that “non-members often derive more benefit from Unified’s challenges than do its paying members.” Pet. Mot. Reply 9 (citing Ex. 2085, 210:7–212:8). Petitioner also points to Mr. Jakel’s testimony that “the only ‘alignment’ between Unified and its members . . . lies in the common goal of deterring NPEs from improperly asserting low-quality and overbroad patents and providing an alternative to ‘litigation against NPEs.’” *Id.* at 10 (citing Ex. 2085, 197:6–199:10; Ex. 2088, 5).

*(c) Response to Allegation That Unified
Communicates and Coordinates With Petitioner*

Petitioner asserts that Patent Owner has not established the factual predicate to support a finding that any relevant communication/coordination occurred between it and Unified. Pet. Mot. Reply 10. According to Petitioner, undisputed evidence shows that there was no communication or coordination between it and Unified during the time period leading up to the filing of *Unified* proceeding (or the instant proceeding). *Id.* (citing PO Mot. Term. 23–24; Ex. 2099 ¶ 4). Petitioner asserts further that there was no communication at all between it and Unified concerning any topic related to Patent Owner or the '228 patent except for a general inquiry that it made after the RPI finding in the *Unified* proceeding was made known publicly. *Id.* at 10–11.

Turning to Patent Owner's proffered evidence of communication and coordination, Petitioner asserts that the email Unified sent to Petitioner and all other paying members to notify them that Unified had challenged a patent asserted against it and Apple was a press release as clarified by Mr. Jakel who testified that "such press releases were nothing more than mass emails that were sent to everyone on Unified's email distribution list, including both members and non-members alike." Pet. Mot. Reply 11 (citing PO Mot. Term. 16–17, Ex. 2085, 61:8–23, 163:14–19, 168:11–14, 169:14–21, 171:6–14). Petitioner also asserts that [REDACTED]

[REDACTED]

[REDACTED]

██████████. *Id.* at 11–12 (citing PO Mot. Term. 17; Ex. 2085, 95:8–96:18, 206:4–208, 9; Ex. 2067, 4).

In response to Patent Owner’s contention that “Unified employs a ‘willful blindness’ strategy in intentionally avoiding discussions with its members,” Petitioner asserts that “[f]ar from being part of some nefarious scheme to skirt PTAB rules, Unified’s business model and deterrence strategy were specifically designed ‘to comply with all of the laws,’ including with regard to RPI.” Pet. Mot. Reply 12 (citing Ex. 2085, 188:5–189:9, 212:18–215:23). Petitioner agrees that “Unified’s avoidance of substantive communication with its members was intentional; but [asserts that] it was intentionally done so as to comply with all laws in Unified’s genuine efforts at deterring NPE activity in a truly independent manner.” *Id.* citing Ex. 2085, 188:5–189:9, 194:5–23; 212:18–215:23). Petitioner asserts that “Unified cannot be faulted for intentionally seeking to follow the law and disallowing company control over multiple challenges to a patent. That is, Unified’s following of the law cannot serve as evidence that it is somehow not following the law here.” *Id.* at 12–13.

(3) *Patent Owner’s Reply in Support of its Motion to Terminate*

Patent Owner contends that Petitioner, in its Reply to Patent Owner’s Motion to Terminate, fails to rebut the following material facts: 1) “Unified monitors district court filings and learned of the ’228 patent from MemoryWeb’s complaint against Samsung,” 2) “Unified subsequently challenged the ’228 patent,” 3) “Unified reported the petition filing and institution to members, such as [Petitioner],” 4) “Unified ██████████

██████████ encouraging renewal that ██████████ ██████████
██████████” and 5) “Membership
fees, such as those paid by [Petitioner], ██████████
██████████” PO Mot. Reply 1–2 (citing Ex. 2074, 22–23; PO Mot. Term.,
4, 15–17; Ex. 2085, 63:20–64:17).

*(a) Allegation That Patent Owner Benefits from
the Unified Proceeding*

Patent Owner maintains its contention that Petitioner benefits from the *Unified* proceeding. PO Mot. Reply 2. Patent Owner contends that Petitioner “does not deny it would benefit from the Unified IPR invalidating claims asserted in district court.” *Id.* (citing PO Mot. Term. 19, 32–33; Pet. Mot. Reply 8–9). Patent Owner contends further that Unified’s practice of challenging fewer than all the claims “demonstrates Unified seeks to allow its members the further benefit of follow-on IPRs challenging every claim” and that “has been too consistent to be anything other than strategic and deliberate.” *Id.* (citing Pet. Mot. Reply 9; PO Mot. Term. 32–33). Thus, according to Patent Owner, “[i]t is not credible to allege that each such example merely relates to Unified’s ‘independent’ invalidity assessment as to some, but not all, claims.” *Id.* at 3.

*(b) Allegation That Petitioner’s Avoidance of
Direct Communications is Irrelevant*

Patent Owner contends that even assuming that Petitioner avoids communications with Unified so as to maintain Unified’s independence, this does not negate that this independence primarily benefits its members by circumventing RPI and estoppel rules. PO Mot. Reply 3. Patent Owner asserts that “[t]he Board’s RPI Order [in the *Unified* proceeding]

[REDACTED], and directly contradict Samsung’s claim that Unified’s activities are exclusively aimed toward the goal of deterring NPEs for the benefit of the public.

Id. at 5–6 (citing Pet. Mot. Reply 10).

In addition, Patent Owner contends that “Unified’s recent decision to stop filing IPRs was made exclusively for the benefit of members and to the detriment of non-members.” PO Mot. Reply 6 (citing PO Mot. Term. 24–25). Patent Owner contends further that “[i]t is impossible to square this decision with Unified’s goal of eliminating NPE patents – the only logical conclusion is that those IPRs were filed for the direct benefit of its members.” *Id.*

*(e) Allegation that Petitioner’s Reliance on
Prior Board Determinations Misses the Mark*

Patent Owner distinguishes the cases cited by Petitioner and notes that despite Unified’s reliance on a similar narrative in the *Unified* proceeding, “the Board issued the RPI Order based on the unique factual record of these cases.” PO Mot. Reply 6 (citing Ex. 2074, 15–16). Specifically, Patent Owner contends that “[u]nlike the present case, *Bradium* involved a patent that had not been asserted in a lawsuit ‘against any of Petitioner’s members’ so the patent owner relied on Unified’s ‘business model alone’” and that in *CCE* the petitioner “failed to adduce any evidence its member ‘directly financed’ the proceeding initiated by Unified.” *Id.* at 6–7 (citing *Bradium*, 9; Ex. 2074, n.6; *CCE*, Paper 33 at 17; Pet. Mot. Reply 12). Turning to *American Patents*, Patent Owner contends that “it involved a different set of facts, an underlying district court case that had settled, and no related

follow-on IPR.” *Id.* at 7 (citing Pet. Mot. Reply 4, 7; *American Patents*, Paper 115 at 46–47).

(4) *Discussion*

(a) *Unified’s Business Model and the Nature of Unified*

The evidence shows that Unified operates as a membership organization wherein member companies, such as Petitioner, enter into annual “Membership Agreements” with Unified and pay Unified “annual, non-refundable, membership fees” in exchange for Unified’s services. Ex. 2057, 1; Ex. 2058, 1; Ex. 2067, 1, 5.

The evidence also shows that Unified seeks to “[d]eter Non-Practicing Entities (NPEs) who assert bad patents (aka Patent Trolls)” and “protect against frivolous patent litigation.” Ex. 2058, 1. Unified “[m]onitor[s] companies in the protected technology (Micro-Pool) to identify NPE activity.” Ex. 2057, 1. Unified provides “benefits” to its member companies by “work[ing] to reduce NPE activity through monitoring . . . and USPTO challenges.” Ex. 2058, 1. Unified’s operating structure “provides complete alignment between Unified Patents and its member companies.” Ex. 2057, 1.

Unified’s Membership Agreements provide that Unified [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]. Ex. 2067, 4.

The evidence shows that Unified [REDACTED]
[REDACTED]. Ex. 2062, 36:3–13. [REDACTED]
[REDACTED]
[REDACTED] *Id.* at 74:5–21,
75:4–6. Petitioner’s [REDACTED]. *Id.*
at 89:5–23. In 2021, Unified had [REDACTED]
[REDACTED]. *Id.* at 36:3–13.

Mr. Jakel testified that Unified’s [REDACTED]
[REDACTED]. Ex. 2062, 131:23–132:2.
According to Patent Owner’s analysis, [REDACTED]
[REDACTED]” PO Resp. 23 (citing Ex. 2033, 11–12;
Ex. 2062, 131:23–132:2, 133:4–15). Unified’s website indicates that
Unified has filed “185 IPR petitions since 2012” and claims a “95% Success
Rate in 2020”. Ex. 2059, 1–2. Unified claims to have “filed more patent
challenges than all other third-party petitioners combined,” and that it has
“successfully neutralized more patents than any other third-party.” *Id.* at 1.

Taken together, this evidence indicates that Unified’s business model,
finances, and operations are structured to support Unified’s patent validity
challenges, including patent reexamination and the filing of petitions for
inter partes review. These activities act to protect Unified’s members,
including Petitioner, from the threat of patent litigation and are important
components of Unified’s core subscription business. This is substantial
evidence that Unified has a strong financial incentive to serve its members’
needs— expressed or not—and those of its other current and potential future
clients.

asserting patents in the technology space that we are working in.” Ex. 2085, 186:2–6. Mr. Jakel testified further that “[w]e also have what we call PATROLL contests, which we put out contests on patents that we believe are invalid and ask the world to kind of submit prior art on them. Then we publish that prior art to the world.” *Id.* at 186:10–14. Mr. Jakel testified that

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]” *Id.* at 186:15–21.

This evidence leads to the inference that Unified filed the petition in the *Unified* case in accordance with its business model to maintain its independence from its members, including Petitioner, supporting a conclusion that Petitioner is not a RPI in the *Unified* proceeding.

Considering all of the evidence before us in this record, including the testimony and evidence pertaining to Petitioner’s business model that was not before us in the *Unified* proceeding, the evidence indicates that although Unified has a strong financial incentive to serve its members needs by filing actions which may benefit its members, Unified structured its business model to avoid its members being named real parties in interest in Unified’s *inter partes* review proceedings. This evidence leads to the inference that Petitioner is not a RPI in the *Unified* proceeding.

(b) *Unified’s Interest in the Unified Proceeding*

The evidence shows that for the technology sectors of its zones Unified is [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED] Ex. 2067, 4.

The evidence shows that Unified was aware that Patent Owner had sued Petitioner for infringement of the '228 patent in district court at the time that it filed the *Unified* proceeding. Ex. 2077, 28. The evidence further shows that Unified has no risk of liability for infringement of the '228 patent in that Unified does not practice the invention covered by this patent. *See e.g.* Ex. 2060 (“Unified is a deterrence entity that seeks to deter the assertion of poor quality patents . . . Unified is not a law firm, and does not have an attorney-client relationship with members. Unified’s activities are not based on the interests of any particular member or members.”); *see also* Ex. 2057.

These facts are similar to the facts in *AIT II* which leads to the inference that Petitioner is an RPI in the *Unified Proceeding*. *AIT II*, Paper 128, 16–17).

(c) Extent to Which Unified Took Petitioner’s Interest into Account in Filing the Unified Proceeding

The evidence shows that Unified advertises that its business model “provides complete alignment between Unified Patents and its member companies.” Ex. 2057. 1. Mr. Jakel testified that “what Unified is talking about is the fact that we are not going to pay NPEs to try and buy licenses and incentivize more litigation.” Ex. 2085, 198:1–3. Mr. Jakel testified further that

It does not refer and it never was meant to refer to the kind of complete alignment that has been . . . referred to . . . in PTAB

board decisions related to [AIT] and other[] [cases] where complete alignment is referring to their representation, [in] an in-house [counsel] kind of work where [the company in question has] an attorney-client privilege relationship with [their members] and they are attempting to kind of settle out litigation, specifically on behalf of their . . . members.

Id. at 198:8–17. The evidence also shows that Unified learned about the ’228 patent from a litigation reporting service when it was asserted for the first time. *Id.* at 64:4–6.

The evidence shows, as discussed in further detail in Section II.B.5.h below, that at the time of the filing of the *Unified* proceeding, Petitioner’s

[REDACTED]
[REDACTED]. Ex. 2077, 19; Ex. 2085, 29:21–24. The evidence further shows that [REDACTED]
[REDACTED] such as the filing of *inter partes* review proceedings. Ex. 2077, 19.

The evidence further shows that in 2021, Unified filed 220 *inter partes* reviews of which [REDACTED]

[REDACTED]. Ex. 2077, 10, 21–22. Of the [REDACTED]
[REDACTED].

Id. at 26–28. Regarding these challenges and in response to questions as to whether Unified wants to keep its members happy, Mr. Jakel testified that “what we want to do is deliver deterrence for the zone. We think we do that. And we think our members . . . appreciate the work we do for the zone for the technology area. And . . . that’s what they participate for.”

Ex. 2085, 87:19–88:4. Mr. Jake testified further that “we do deterrence and if our members appreciate the deterrence, they get to choose whether or not

they participate” and that “when it comes to doing something on behalf of a technology area . . . we work on behalf of a zone, honestly, we don’t know if in any single action we take or even in all of them, if members are happy.” *Id.* at 88:10–13, 88:19–25. In addition, Mr. Jakel testified that Petitioner is one of the most highly litigated companies in the world, so it is going to show up in lots of NPE activity and that its purely coincidence that Unified chose to “go after” a patent asserted against Petitioner. *See id.* at 185:1–7.

This evidence supports the inference that Unified takes its membership’s interest in the deterrence of NPE activity into account when filing for *inter partes* review. It further supports the inference that Unified took Petitioner’s interest into account when it decided to file its challenge to the ’228 patent. If Unified’s decisions as to which patents to challenge were

[REDACTED]
[REDACTED]
[REDACTED]. Considering all of the evidence regarding the extent to which Unified took Petitioner’s interest into account in filing the *Unified* proceeding, the evidence leads to the inference that Petitioner is not a RPI in the *Unified* proceeding.

*(d) Petitioners Relationship, Including
Communications and Coordination, With Unified*

The evidence shows that Petitioner is a dues-paying member of Unified and has been since November 1, 2015. Ex. 2067, 1. The evidence further shows that Petitioner belongs to Unified’s [REDACTED]
[REDACTED]. Ex. 2067, 14–15.

The evidence shows that Unified sends its members annual membership reports. *See e.g.* Ex. 2085, 92:2–6. Exhibit 2077 is the [REDACTED]. Mr. Jakel testified that “[REDACTED] [REDACTED] [REDACTED].” Ex. 2085, 96:5–9. Mr. Jakel testified further that “[REDACTED] [REDACTED] [REDACTED]” *Id.* at 9–12.

The evidence further shows that Unified periodically sends Petitioner emails. *See e.g.* Exhibits 2010, 2055, 2068. Exhibit 2068²⁰ is an example of such an email. Mr. Jakel testified that Ex. 2068 is a press release and that Exhibit 2069 is an [REDACTED]. Ex. 2085, 58:10–12, 60:17–61:3. [REDACTED] [REDACTED] [REDACTED]

In addition, the evidence shows that Petitioner did not communicate or coordinate with Unified regarding the instant proceeding or the *Unified* proceeding. Mr. Koo testified that “[a]side from general newsletters that Unified sends out periodically as mass email, Samsung has never had any communications with Unified about the Unified IPR or the Samsung IPR, or

²⁰ In the September 2023 Deposition of Kevin Jakel (Ex. 2085) Exhibit 2068 is also referred to as Exhibit 2074 (its exhibit number in the *Apple* proceeding). Similarly, Ex. 2069 is referred to in Mr. Jakel’s testimony by its exhibit number in the *Apple* proceeding (Ex. 2075).

about the '228 Patent described in those petitions, [REDACTED]
[REDACTED].” Ex. 2099 ¶ 4. Specifically, Mr. Koo testified that Petitioner “did not ask for or receive any input from Unified in preparing or filing” this proceeding, that Petitioner “did not give any input to Unified concerning its decision to challenge the '228 Patent,” and that Petitioner “did not give any input to Unified in its preparation of the Unified IPR.” *Id.*

Considering all of the evidence before us in this record, including the lack of evidence of direct communication or coordination between Petitioner and Unified, the evidence indicates that there was no relationship between Petitioner and Unified that would give rise to the implication that Petitioner is a RPI in the *Unified* proceeding. Rather, this evidence leads to the inference that Petitioner is not a RPI in the *Unified* proceeding.

(e) Petitioner’s Interest in and Potential Benefit From the Unified Proceeding and Whether Unified Represents That Interest, as Well as, Petitioner’s Desire for Review of the '228 Patent

The evidence shows that Petitioner has an interest in the *Unified* Proceeding and desired review of the '228 patent by virtue of the fact that Petitioner filed the instant proceeding to challenge the '228 patent and that this same patent is at issue in the *Unified* proceeding.

The evidence further shows that Petitioner would benefit from the cancellation of claims 1–7 of the '228 patent in the *Unified* proceeding, by virtue of the fact that it will no longer have to pursue those claims in district court.

The evidence also shows that even if claims 1–7 are cancelled in the *Unified* proceeding, Petitioner will still have to defend itself against claims 8–19 of the '228 patent.

This evidence demonstrates that Petitioner will benefit should Unified prevail in the *Unified* proceeding, but that Unified has not represented all of Petitioner's interest by not challenging all of the claims of the '228 patent. Accordingly, this evidence does not lead to the inference that Petitioner is a RPI in the *Unified* proceeding.

(f) *Whether Petitioner Funded, Directed, Influenced or Exercised Control Over the Unified Proceeding*

The evidence shows that as of 2021, Petitioner paid [REDACTED] [REDACTED] for membership [REDACTED]. *See e.g.* Ex. 2077, p. 19. The evidence further shows that Unified had [REDACTED]

[REDACTED] *Id.* The evidence shows that the [REDACTED]

[REDACTED]. *Id.* In addition, the evidence shows that in 2021, Unified's total revenue was [REDACTED]. Ex. 2085, 29:21–30:24. Thus, [REDACTED]

[REDACTED]. This evidence does not show that Petitioner directly funded the *Unified* proceeding.

As discussed in Section II.B.5.d above, the evidence shows that Petitioner did not communicate or coordinate with Unified with regards to the *Unified* proceeding “[REDACTED]” Ex. 2099 ¶ 4.

Given the absence of evidence of communication or control, the evidence does not show that Petitioner directed or influenced Unified’s actions in the *Unified* proceeding either.

This evidence does not support the inference that Petitioner is a RPI in the *Unified* proceeding.

(g) *Conclusion re Real Party in Interest*

Having considered all of the evidence of record and the parties’ arguments, we find that the evidence that Petitioner is not a RPI to the *Unified* proceeding outweighs the evidence that it is.

C. *Estoppel*

As we have determined that Petitioner is not an RPI in the *Unified* proceeding, the estoppel provisions of 35 U.S.C. § 315(e)(1) do not apply to this proceeding.

D. *Motion to Terminate*

Patent Owner has moved to terminate this proceeding pursuant to 35 U.S.C. § 315(e)(1), 37 C.F.R. § 42.73(d), and 35 U.S.C. § 315(d). Paper 52, 1. Patent Owner’s motion to terminate these proceedings is denied given our determination that Petitioner is not an RPI in the *Unified* proceeding. However, even we had determined that Petitioner is an RPI in the *Unified* proceeding and that Petitioner is estopped as to claims 1–7, we would not terminate this proceeding as to those claims, nor would we terminate the

proceeding as to the remaining claims, because it is in the interest of the public as well as the integrity of the patent system that the panel issue a final written decision on the merits of this case. *See, e.g., Intuitive Surgical, Inc v. Ethicon LLC*, IPR2018-01248, Paper 34, 18.

E. *Principles of Law: Obviousness*

A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations.²¹ *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

The Supreme Court has made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. Reaching this conclusion, however, requires more than a mere showing that the prior art includes separate references covering each

²¹ The record does not present or address any evidence of nonobviousness.

separate limitation in a claim under examination. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of ordinary skill would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Id.*

F. *Level of Ordinary Skill in the Art*

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

In determining the level of skill in the art, we consider the type of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus. Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Orthopedic Equip. Co. v. U.S.*, 702 F.2d 1005, 1011 (Fed. Cir. 1983).

Petitioner contends that a person of ordinary skill in the art at the time of the invention of the '228 patent would have had the following education and experience:

- (1) a bachelor's degree in computer science, computer engineering, electrical engineering, or a related field, and (2) at least one year of experience designing graphical user interfaces for applications such as photo organization systems.
- []Additional graduate education could substitute for professional

experience, or significant experience in the field could substitute for formal education.

Pet. 2 (citing Ex. 1003 ¶ 27). Patent Owner does not challenge this definition of the level of skill. PO Resp. 10.

Based on the record, including our review of the '228 patent and the types of problems and solutions described in the patent and the cited prior art, we adopt Petitioner's assessment of the level of ordinary skill in the art and apply it for purposes of this Decision.

G. *Claim Construction*

Pursuant to 37 C.F.R. § 42.100(b), we apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Under *Phillips*, claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Id.* at 1312–17.

Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (in the context of an *inter partes* review, applying *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner asserts that “no formal claim constructions are necessary in this proceeding.” Pet. 1–2 (citing *Wellman, Inc. v. Eastman Chem. Co.*, 642

F.3d 1355, 1361 (Fed. Cir. 2011) (footnote omitted). Patent Owner states that it “does not believe claim construction is required,” then goes on to proffer definitions of portions of limitations [1g], [1i], 1[k]²² and claim 18. PO Resp. 11–19. We discuss these limitations below.

1. *Limitations [1g] and [1i]: “Responsive to a Second Input . . . Causing a People View to be Displayed . . . the People View Including . . . a First Name”*

Claim 1 recites “responsive to a second input that is subsequent to the first input, causing a people view to be displayed on the interface, the people view including” (limitation [1g]) and “(ii) a first name associated with the first person, the first name being displayed adjacent to the first person selectable thumbnail image” (limitation [1i]). Ex. 1001, 35:61–36:3.

a) *Patent Owner’s Response*

Patent Owner contends that “[t]he plain and ordinary meaning of limitations [1g] and [1i] require that the ‘people view’ displayed in response to the ‘second input’ must ‘includ[e]’ a ‘first name.’” PO Resp. 11 (citing Ex. 2023 ¶¶ 67–70). Patent Owner asserts that in his deposition Dr. Greenspun agreed that this definition means that “a user does something maybe with a mouse or a finger gesture on a touch screen and that subsequent to that you know the software within the application displays the people view.” *Id.* at 11; Ex. 2022, 43:23–44:3. Patent Owner asserts further that Dr. Greenspun acknowledged that “nothing in the ‘228 [patent’s] specification contemplates requiring any user input beyond the ‘second input’ to cause the display of the ‘people view’ and ‘first name’ caption.”

²² As labeled by Patent Owner in its Response.

PO Resp. 12 (citing Ex. 2022, 49:9–50:15; *Am. Calcar, Inc. v. Am. Honda Motor Co.*, 651 F.3d 1318, 1340 (Fed. Cir. 2011)).

Patent Owner contends further that “courts construe the phrase ‘responsive to’ as imparting a ‘cause-and-effect’ relationship, whereby a second event occurs ‘automatically’ in relation to a first event without ‘requiring further user interaction.’” *Id.* at 11–12 (citing *Am. Calcar*, 651 F.3d at 1340; *Fujitsu Ltd. v. Belkin Int’l, Inc.*, 2012 U.S. Dist. LEXIS 142102, at *88 (N.D. Cal. Sep. 28, 2012); *Microsoft Corp. v. FG SRC, LLC*, 860 F. App’x 708, 714 (Fed. Cir. 2021)).

In addition, Patent Owner contends that “the ’228 patent discloses an exemplary embodiment consistent with the express words recited in the claim. In particular, the specification states that ‘selecting “People” (1401)’ (*second input*) causes the People Application View of FIG 32 (*people view*) to be displayed.” PO Resp. 13 (citing Ex. 1001 Fig. 32, 22:59–23:42; Ex. 2023 ¶¶ 68–70). Patent Owner contends further that “[t]he specification discloses that the People Application View of FIG 32 displayed in response to selecting “‘People’ 1401 (*second input*) includes the text ‘Jon Smith’ (*first name*) and does not disclose that any further ‘user interaction’ is needed.” *Id.* (citing *Am. Calcar*, 651 F.3d at 1340).

b) Petitioner’s Reply

Petitioner replies that Patent Owner’s claim construction is overly narrow. Pet. Reply 2. Petitioner replies further that “as Dr. Greenspun explained during his deposition, a POSITA²³ would have recognized that the

²³ Person of ordinary skill in the art.

term ‘responsive to’ merely requires the second event to happen ‘subsequent to’ the first event based on a combination of user interaction and software implementation.” *Id.* at 3 (citing Ex. 2002, 42:21–44:22, 51:9–52:13; Ex. 1041, 3–8).

Turning to the embodiment discussed by Patent Owner, Petitioner replies that “the people view that is ultimately shown to the user entails not only the initial pressing of ‘People’ (1401) . . . but further the additional selection of a desired display order via a drop-down list (1402).” Pet. Reply 3 (citing Ex. 1001, Fig. 32, 33:59–67; Ex. 1041, 5). In other words, according to Petitioner, “even the ’228 patent itself contemplates having intermediate user actions between the first event (*i.e.*, ‘cause’) and the second event (*i.e.*, ‘effect’).” *Id.* (citing Ex. 1041, 6).

c) Patent Owner’s Sur-reply

After reiterating its arguments from its Response, Patent Owner contends that Petitioner’s arguments are erroneous and irrelevant. PO Sur-reply. 1–4. Specifically, Patent Owner contends that “Petitioner mischaracterizes the specification[‘s]” description of Figure 32. *Id.* at 4–5. According to Patent Owner, the fact that the specification of the ’228 patent “discloses optionally ‘adjust[ing]’ the people view’s display settings **after** its initial display is irrelevant to the meaning of ‘responsive to.’” *Id.* at 5.

d) Discussion

The plain language of claim 1 does not require display of a first name associated with a first person responsive to a second input. Rather, claim 1 requires “responsive to a second input” display of a people view. Ex. 1001, 35:61–63. Claim 1 further requires that the people view *include* a first name

associated with a first person. *Id.* at 35:63, 36:1–3. Claim 1, however, does not require that the first name be displayed “responsive to” the second input.

Even if we were to accept Patent Owner’s narrow definition of “responsive to” as requiring a cause-and-effect relationship (which we do not), claim 1 would not require display of a first name associated with a first person. Although Patent Owner is correct that nothing in the specification of the ’228 patent requires any user input beyond the second input to display the first name, nothing in the specification precludes it either.

Patent Owner’s definition of this limitation is based on an exemplary embodiment disclosed in the ’228 patent. PO Resp. 13. The claims however, are not limited to this embodiment. *See, e.g., WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1323–24 (Fed. Cir. 2018) (“It is well established that claims are not limited to preferred embodiments, unless the specification clearly indicates otherwise.”).

For these reasons, we determine that limitations [1g] and [1i] do not require display of a first name associated with the first person when the second input is executed.

2. *Limitations [1g], [1i], and [1k]: “The People View Including . . . a First Name . . . [and] a Second Name.”*

Claim 1 recites “responsive to a second input that is subsequent to the first input, causing a people view to be displayed on the interface, the people view including” (limitation [1g]), “(ii) a first name associated with the first person, the first name being displayed adjacent to the first person selectable thumbnail image” (limitation [1i]), and “a second name associated with the

second person, the second name being displayed adjacent to the second person selectable thumbnail image.” Ex. 1001, 35:61–36:11.

Patent Owner contends that “[t]he plain and ordinary meaning of limitations [1g], [1i] and [1k] require that the ‘people view’ must ‘includ[e]’ both a ‘first name’ *and* a ‘second name’ displayed in the same view. PO Resp. 14. Patent Owner’s arguments for this claim construction are similar to its arguments discussed in the preceding Section in that they are premised on the assumption that claim 1 requires displaying of features of the people view responsive to the second input. *See* PO Resp. 14–17; *see also* PO Sur-reply 9–15. As discussed above, however, claim 1 does not specify display of features of the people view. Rather, it merely specifies what the features of the people view must include. Ex. 1001, 35:61–36:11. We recognize that “understanding the claim language may be aided by the explanations contained in the written description,” but “it is important not to import into a claim limitations that are not a part of the claim.” *SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). Thus, “a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.” *Id.*

For these reasons, we determine that limitations [1g], [1i], and [1k] do not require that the first name and second name be displayed in the same view.

3. *Claim 18: “First Person View . . . Including a Representation of Each Digital File in the Third Set of Digital Files”*

Claim 18 recites

The method of claim 1, further comprising responsive to an input that is indicative of a selection of the first person

selectable thumbnail image, causing a first person view to be displayed on the interface, the first person view including (i) the first name and (ii) a representation of each digital file in the third set of digital files.

Ex. 1001, 38:8–13. Limitation [1h] recites “(i) a first person selectable thumbnail image including a representation of a face of a first person, the first person being associated with a third set of digital files including digital photographs and videos.” *Id.* at 35:64–67.

Patent Owner contends that [t]he plain and ordinary meaning of claim 18 requires (i) receiving an ‘input’ from the ‘people view’ of limitation [1h]; and (ii) in response to that input, displaying a ‘first person view’ that ‘includ[es] . . . a representation of each digital file in the third set of digital files.’” PO Resp. 17–18 (citing Ex. 2023 ¶¶ 80–85). Patent Owner’s arguments for this claim construction are similar to its arguments discussed in Section II.G.1. above, in that they are premised on the assumption that claim 1 requires displaying of all of the features of the people view responsive to the display of the first person view. *See* PO Resp. 17–19; *see also* PO Sur-reply 15–16. Claim 18, however, does not specify displaying the first name and a representation of each digital file in the third set of digital files when the first person view is displayed. Rather, it specifies what the features of the people view must include. Ex. 1001, 38:8–13.

Thus, for reasons similar to those discussed in Section II.G.1.d above, we determine that claim 18 does not require display of a representation of each digital file in the third set of digital files when the first person view is displayed.

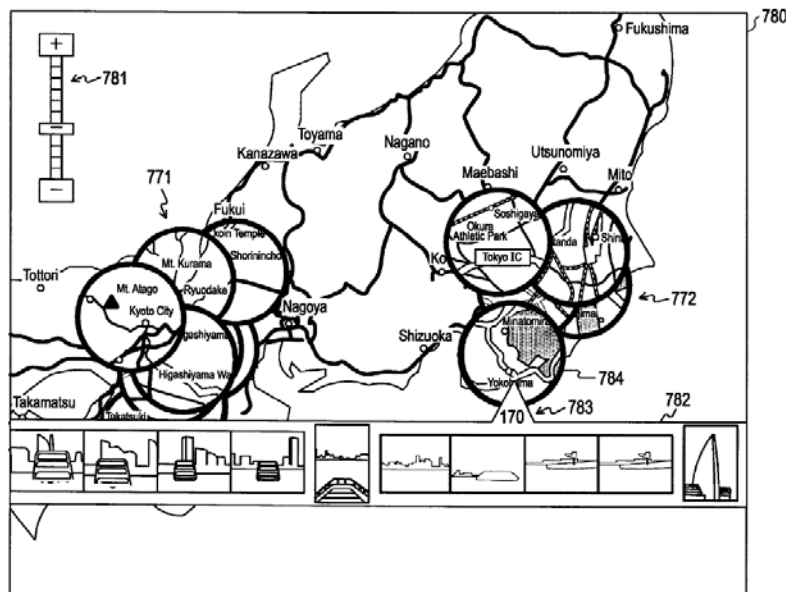
H. Overview of the Asserted Prior art

1. Okamura

Okamura is a U.S. Patent Publication titled, “Information Processing Apparatus, Information Processing Method, and Program,” published May 26, 2011. Ex. 1005, codes (45), (54). Okamura describes an information processing apparatus which displays contents such as image files. Ex. 1005 ¶ 2. Okamura’s information processing apparatus also allows managing of contents such as recorded image files. *Id.* ¶ 91.

Figure 41, reproduced below, shows an embodiment of a display of Okamura that includes a map view screen.

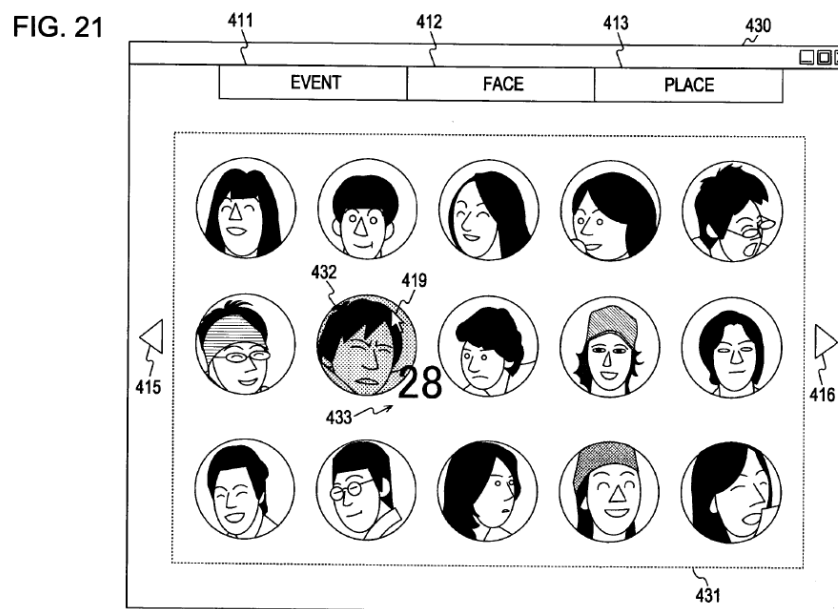
FIG. 41



Id. Fig. 41, ¶ 61. As shown in Figure 41, map view screen 780 displays a map including cluster map groups 771, 772. *Id.* A user can change the scale of map view screen 780 and can select a desired cluster map such that a listing of its contents is displayed in content listing display area 782. *Id.* Fig. 41, ¶¶ 355–56. For example, cluster map 784 within cluster map group 772

is selected to show it has contents that can be displayed in content listing display area 782. *Id.* Fig. 41, ¶ 356. Overlapping cluster maps are spread out in accordance with a predetermined condition such that “graphical correspondence between contents may be intuitively grasped.” *Id.* Fig. 41, ¶ 358.

Figure 21, reproduced below, shows another embodiment of a display of Okamura that includes an index screen.

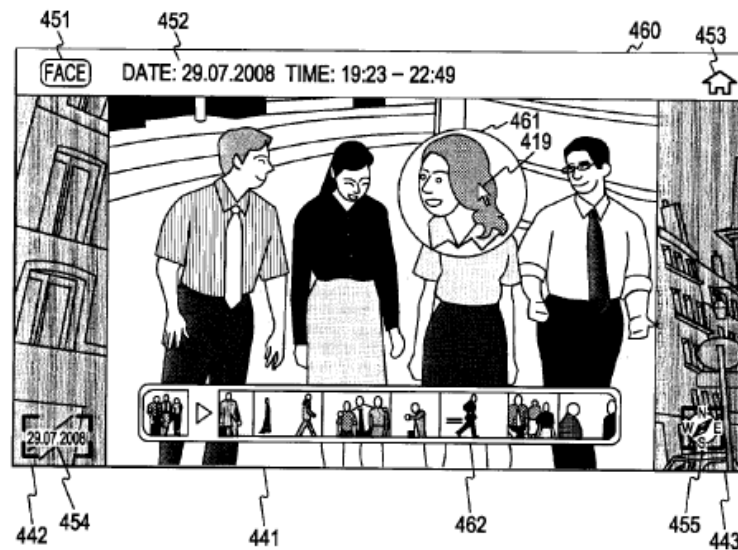


Id. Fig. 21, ¶ 41. As shown in Figure 21, an index screen displays indexed images generated on the basis of face information. *Id.* Fig. 21, ¶ 234. The index screen includes cursor 419 for pointing to an object of instruction or operation on the screen. *Id.* Fig. 21, ¶ 234. The index screen includes “EVENT” tab 411, “FACE” tab 412, and “PLACE” tab 413 that are used for displaying a different index screen. *Id.* Fig. 21, ¶¶ 235–36. Okamura discloses that in the face cluster image display area 431 shown in Figure 21, images representing face clusters are displayed such that “an image

representing a face cluster, for example, a thumbnail image of each of faces included in contents belonging to the face cluster can be used” by extracting faces and contents belonging to the face cluster. *Id.* Fig. 21, ¶ 246. For example, thumbnail image 432 in face cluster image display area 431 has 28 contents indicated for its pieces of information 433, that can be accessed by a user. *Id.* Fig. 21, ¶ 247.

Figure 24, reproduced below, shows another embodiment of a display of Okamura that includes a content playback screen.

FIG. 24

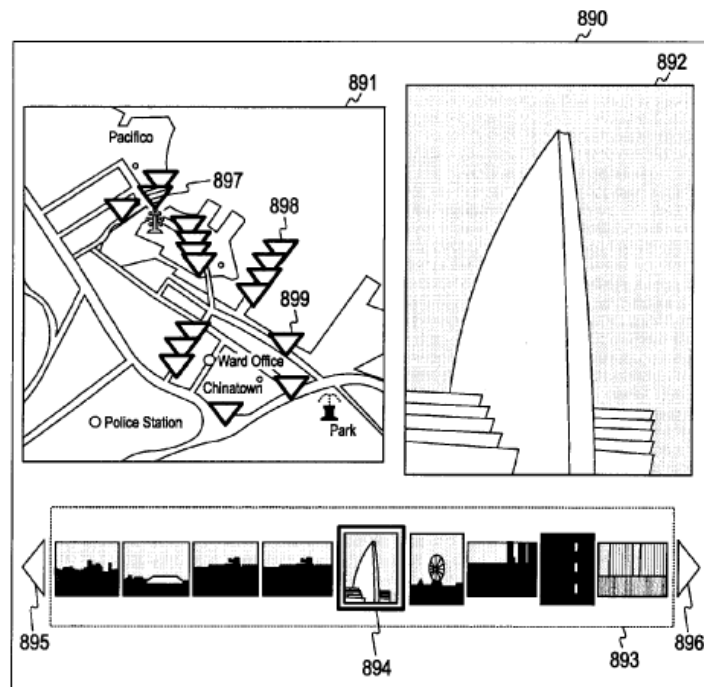


Id. Fig. 24, ¶ 44. As shown in Figure 24, content playback screen 460 can be displayed “when the mouse is placed over the face portion” in another content playback screen. *Id.* Fig. 24, ¶ 261. Content playback screen 460 includes image 461 of the vicinity of the face displayed in magnified form and content listing display area 462 in content display area 411. *Id.* Fig. 24, ¶ 261. Content listing display area 462 shows a listing of contents included

in the face cluster (from Figure 21 for example) and also thumbnail images of the content. *Id.* Fig. 24, ¶ 261.

Figure 50, reproduced below, shows another embodiment of a display of Okamura that includes a play view screen.

FIG. 50



Id. Fig. 50, ¶ 70. As shown in Figure 50, play view screen 890 shows “images related to a cluster corresponding to the cluster map on which a determining operation has been made are displayed,” including “a listing of contents belonging to the cluster, a content’s magnified image, and the like.”

Id. Fig. 50, ¶ 440. Play view screen 890 includes map display area 891, magnified image display area 892, and content listing display area 893. *Id.*

Fig. 50, ¶ 441. Map display area 891 includes a map related to the corresponding cluster with marks indicating the generated positions of

contents belonging to the corresponding cluster. *Id.* Fig. 50, ¶ 442. Content listing display area 893 shows a listing of contents belonging to the corresponding cluster which are displayed as thumbnails. *Id.* Fig. 50, ¶ 444. Magnified image display area 892 includes an image corresponding to the content selected from box 894 of the content listing display area 893, which is displayed in magnified form. *Id.* Fig. 50, ¶ 443.

2. *Belitz*

Belitz is a U.S. Patent Publication titled, “User Interface, Device and Method for Displaying Special Locations on a Map,” published March 4, 2010. Ex. 1006, codes (45), (54). *Belitz* describes clustered locations on a map for a user to overview associated images to special locations so that the user can “clearly see the associations.” Ex. 1006 ¶¶ 1, 4.

Belitz relates to a “user interface . . . configured to display a map and to display at least one marked location on said map.” Ex. 1006, code (57). By way of background, *Belitz* explains that “[i]t is common to mark special locations on a map by associating a graphical object with that location. Examples of such locations are service points, restaurants, tourist attractions, visited places etc[.] and examples of graphical objects are photographs taken at such a location.” *Id.* ¶ 2. *Belitz* further explains “[i]f many locations are located close to one another they overlap and the view of the associated images become cluttered and it is difficult to discern between the various objects and the user is not provided with a good view of what location is associated with what.” *Id.* *Belitz* presents a user interface attempting to address those concerns. *Id.* ¶ 5. Figures 4a and 4b, reproduced below, show screenshots of the user interface. *Id.* ¶¶ 51, 55.

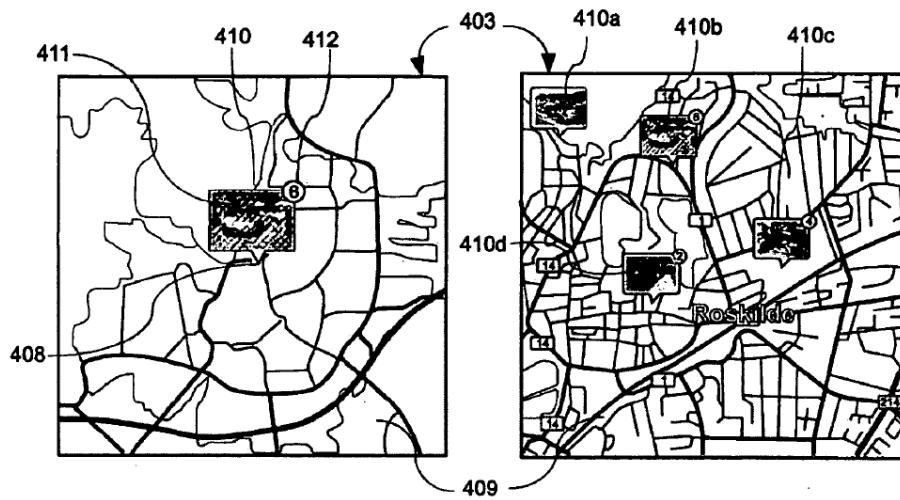


Fig. 4a

Fig. 4b

As shown in Figure 4a, a “map 409 is displayed of a town called Roskilde. A location 408 is marked by a graphical object 410.” *Id.* ¶ 51. “[G]raphical object 410 has a visual representation 411 which in this embodiment is a photograph that is associated with the location.” *Id.* ¶ 52. Furthermore, “graphical object 410 carries a number indicator 412 which presents a viewer with a number. The number indicates how many graphical objects 410 are associated with that location and are stacked into one graphical object 410.” *Id.* ¶ 54. Furthermore, “graphical objects stacked in the displayed graphical object or graphical group object 410 . . . can be associated with other locations that are in close proximity to the marked location 408” because “if the graphical objects associated with each location were to be displayed separately they would overlap which would clutter the view and be confusing to a user.” *Id.*

Figure 4b shows map 408 having been “zoomed in showing the area in greater detail.” *Id.* ¶ 55. At this zoom level, graphical object 410 is “split up into 4 graphical objects 410a, 410b, 410c and 410d” because the display

of those graphical objects would not overlap. *Id.* Those graphical objects themselves also consist of some number of graphical objects. *Id.*

When a graphical object, e.g., graphical object 410, 410a, 410b, 410c, or 410d, is selected, a popup window is displayed over the graphical object. *Id.* ¶ 60. Figure 4c, reproduced below, is a screenshot showing the user interface after the selection of graphical object 410c. *Id.*

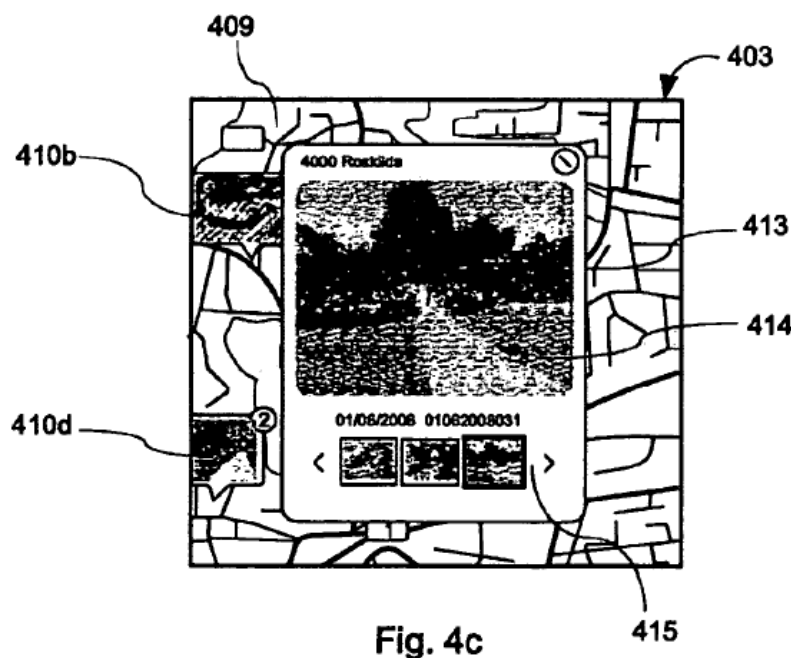


Fig. 4c

As shown in Figure 4c, the “popup window shows at least some of the visual representations 411 of the graphical object 410c.” Ex. 1006 ¶ 60. “One 414 of the visual representations 411 or images as they are in this embodiment is shown in a larger size than the others which are shown in a list 415.” *Id.* In some embodiments, “graphical objects are photographs that are associated with the location where they were taken. The visual representations are thumbnails of the photographs.” *Id.* ¶ 62.

I. *Obviousness under 35 U.S.C. § 103*

Petitioner contends that claims 1–19 are unpatentable over combination of Okamura and Belitz. Pet. 7–81. Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 46–66.

1. *Independent Claim 1*

For each limitation of claim 1, Petitioner asserts that Okamura alone or in combination with Belitz meets that limitation. Pet. 26–55. Petitioner also provides the testimony of Dr. Greenspun, in support of its position with respect to the limitations of claim 1. *See* Ex. 1003 ¶¶ 102–145. Patent Owner does not contest Petitioner’s findings for every limitation. For the uncontested limitations, we have considered Petitioner’s evidence and arguments with respect to these limitations, including the relevant testimony of Dr. Greenspun and find it to be sufficient to show, by a preponderance of the evidence, that Okamura, either alone or in combination with Belitz, discloses them. Accordingly, we focus our discussion on the contested limitations and Patent Owner’s argument that Petitioner has not carried its burden on obviousness. PO Resp. 19.

a) *Limitations [1g] and [1i]: “Responsive to a Second Input . . . Causing a People View to be Displayed . . . the People View Including . . . a First Name”*

Petitioner asserts that “Okamura discloses displaying a people view (‘index images generated on the basis of face information’) in response to a **user operation** (‘when the ‘FACE’ tab 412 is depressed using the cursor 419’).” Pet. 46 (citing Ex. 1005 ¶¶ 234, 236; Fig. 21; Ex. 1003 ¶ 133). Petitioner asserts that Okamura’s “people view” includes “multiple person selectable thumbnail images.” *Id.* at 53 (citing Ex. 1005 ¶¶ 234, 246–260,

267, Fig. 21; Ex. 1003 ¶ 144). Petitioner asserts that any one of these thumbnail images corresponds to the claimed first person selectable thumbnail image and that “any one of the person selectable thumbnail images (e.g., as annotated below) displayed on the index screen is a second person selectable thumbnail image, as long as it is different from a first person selectable thumbnail image.” *Id.* (citing Ex. 1005 ¶¶ 234, 246–250, Fig. 21; Ex. 1003 ¶ 144).

Petitioner asserts that for each of Okamura’s thumbnail images “when the mouse is placed over a thumbnail image 432 by a user operation on the index screen 430 shown in FIG. 21, the color of the thumbnail image 432 changes, and pieces of information 433 related to the thumbnail image 432 are displayed.” Pet. 52 (citing Ex. 1005 ¶ 247). Petitioner asserts further that the pieces of information displayed include the name of the person displayed adjacent to the thumbnail image. *Id.*

Patent Owner contends that “Okamura does not disclose all aspects of the claimed ‘people view’” and “Petitioner has not shown that it would have been obvious to modify Okamura with Belitz in any of the ways suggested in the Petition.” PO Resp. 19–20 (citing Ex. 2023 ¶¶ 86–200). Specifically, Patent Owner contends that claim 1 requires that the claimed people view displayed in response to the second input must include a first name and Okamura does not teach this. *Id.* at 20–21. Patent Owner asserts that [t]his [alleged] deficiency is dispositive of Ground 1” because “[t]he Petition does not offer any obviousness modification, or evidence to support an obviousness modification, for the Board to consider relating to displaying the people view ‘responsive to [the] second input.’” *Id.* at 22.

Patent Owner’s arguments are premised on our adoption of its construction of limitations [1g] and [1i]. As we have not adopted Patent Owner’s construction of these limitations, Patent Owner’s arguments are unavailing.

On the complete record before us, we determine that Petitioner has shown, by a preponderance of the evidence, that Okamura discloses limitations [1g] and [1i].

b) *Limitations [1g], [1i], and [1k]: “The People View Including . . . a First Name . . . [and] a Second Name.”*

Petitioner’s assertions for limitations [1g] and [1i] are summarized in the prior Section. For limitation [1k], Petitioner asserts that “any one of the person selectable thumbnail images . . . displayed on [Okamura’s] index screen is a second person selectable thumbnail image, as long as it is different from a first person selectable thumbnail image.” Pet. 54–55 (citing Ex. 1005 ¶¶ 234, 246–250, Fig. 211 Ex. 1003 ¶145).

Patent Owner contends that claim requires that displaying of the people view in response to the second input must include the display of a first name and second name at the same time and that Okamura does not disclose this. PO Resp. 25–27. Patent Owner asserts that “[t]his deficiency is also dispositive of Ground 1” because “[t]he Petition does not offer any obviousness modification, or evidence to support an obviousness modification, for the Board to consider relating to including both a ‘first name’ and ‘second name’ in the claimed people view.” *Id.* at 27 (citing *Intelligent Bio-Sys.*, 821 F.3d at 1369; *Qualcomm Inc.*, 24 F.4th at 1377; *Koninklijke Philips N.V.*, 948 F.3d at 1336).

Patent Owner’s arguments are premised on our adoption of its construction of limitations [1g], [1i], and [1k]. As we have not adopted Patent Owner’s construction of these limitations, Patent Owner’s arguments are unavailing.

On the complete record before us, we determine that Petitioner has shown, by a preponderance of the evidence, that Okamura discloses limitations [1g], [1i], and [1k].

c) Limitations [1c] and [1d]: “a [First/Second] Location Selectable Thumbnail Image at a [First/Second] Location on the Interactive Map

For limitation [1c] Petitioner asserts that “[w]hile Okamura’s clusters are not thumbnails of images within the clusters, Belitz discloses displaying location selectable thumbnail images (e.g., thumbnails 410a–d) at different locations of an interactive map as shown in FIGS. 4a and 4b.” Pet. 32. Petitioner asserts further that “Belitz discloses a thumbnail image that is associated with the location: ‘The *graphical object 410* has a visual representation 411 which in this embodiment is a photograph that is *associated with the location* . . . Examples of associations are photographs that have been taken at those coordinates.’” *Id.* at 33 (citing Ex. 1006 ¶52; Ex. 1003 ¶¶113–114). In addition, Petitioner asserts that “Belitz describes its thumbnail image as being location selectable: “. . . a graphical object 410c has been *selected by a user*, possibly by tapping on it with a stylus if the display 403 is a touch screen or by placing a cursor above it and clicking it.” *Id.* (citing Ex. 1006 ¶ 60).

For limitation [1d], Petitioner refers to its discussion of limitation [1c]. Pet. 36. Petitioner further asserts that “because Belitz’s thumbnails are

displayed at different locations on the interactive map, any one of Belitz’s selectable thumbnail images 410a–d displayed on the interactive map . . . is a second location selectable thumbnail image (e.g., 410b), as long as it is different from a first location selectable thumbnail image (e.g., 410c).” *Id.* at 37 (citing Ex. 1006, Fig 4d; Ex. 1003 ¶ 121).

(1) *First Combination of Okamura and Belitz*

(a) *Petitioner’s Assertions*

Petitioner asserts that a person of ordinary skill in the art “would have found it obvious to replace the location-based clusters used in Okamura’s map view (shown in FIG. 41) with the thumbnail images used in Belitz’s map view.” Pet. 12 (citing Ex. 1003 ¶ 87). According to Petitioner, “[w]ith this replacement, Okamura’s map view would function as described in Okamura, except that it would display, on the map view, thumbnail images as described by Belitz, instead of Okamura’s location-based clusters.” *Id.* In addition, Petitioner contends that Okamura’s location-based clusters are thumbnails as claimed. *Id.* at 13.

Petitioner asserts that Okamura and Belitz “describe analogous methods of displaying an interactive map with user-selectable elements (e.g., Belitz’s thumbnail images and Okamura’s clusters) and retrieving digital files (e.g., photos and videos) associated with a given location.” Pet. 15 (citing Ex. 1003 ¶ 89). Petitioner reasons that Belitz’s thumbnails “enhances a user’s experience of ‘discern[ing] between the various objects’ by providing ‘a good view of what location is associated with what.’” *Id.* at 14–15 (citing Ex. 1006 ¶ 2). According to Petitioner,

Belitz's thumbnail images displayed on the interactive map are functionally equivalent to Okamura's location-based clusters (at least because (1) both Belitz's thumbnail images and Okamura's clusters are associated with a given location, (2) both are displayed on the interactive map, and (3) both are dynamically generated/modified based on user interaction including zooming in/out on the map) and could be used as an alternative to the clusters on Okamura's map view screen.

Id. at 15 (citing Ex. 1003 ¶ 90). Petitioner provides further reasoning in support of the proposed combination on pages 15–25 on the Petition.

Petitioner provides the following summary of this reasoning stating that

to achieve Okamura's and Belitz's shared goal of conveniently presenting and managing digital files, a POSITA [person of ordinary skill in the art] would have been motivated to modify Okamura's user interface to include additional features as discussed in Belitz with a high expectation of success. SAMSUNG-1003, [97]. Because both references relate to organizing content according to the location associated with the content, a POSITA would have seen the combination as predictable and involve relatively simple software modifications to implement. *Id.* Specifically, a POSITA would have considered (1) the use of the Belitz thumbnails in the Okamura interactive map or (2) the use of Belitz's map view in place of Okamura's map views to be nothing more than the predictable substitution of known and equivalent interface elements. *Id.* Such implementations would have been the product of ordinary skill and common sense—as explained above, the use of maps with photo thumbnails was conventional by early 2010—and would have been obvious to try because a POSITA would have had good reason to pursue the known options within his or her technical grasp. *Id.* (citing SAMSUNG-1022; SAMSUNG-1023).

Id. at 22.

Petitioner asserts that in this way of combining Okamura and Belitz, a person of ordinary skill in the art “would have found it obvious to modify Okamura’s user interface, such as the map view screen 780, to display selectable thumbnail images (e.g., thumbnails 410a-d) taught by Belitz.” Pet. 33–34 (citing Ex. 1003 ¶ 116). Petitioner asserts further that “[a]dopting the location selectable thumbnail images of Belitz in Okamura’s interactive map would have resulted in an interactive map that includes selectable thumbnail images instead of selectable cluster groups (e.g., cluster map group 771) on the map.” *Id.* at 34–35 (citing Ex. 1003 ¶ 117).

(b) Patent Owner’s Response²⁴

Patent Owner contends that “[n]owhere does Okamura suggest or provide any motivation to replace its cluster maps with image elements that are not maps. Indeed, doing so would entirely defeat Okamura’s stated purpose of using cluster maps.” PO Resp. 31 (citing Ex. 2023 ¶ 115; *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016); *Google LLC f/k/a Google Inc. v. Singular Computing LLC*, IPR2021-00155 (PTAB) May. 23, 2022). In support of this contention, Patent Owner contends that “Okamura provides dozens of paragraphs and numerous figures dedicated to selecting cluster map contents, choosing zoom settings and ensuring cluster map “contents . . . can be . . . easily grasped.” *Id.* at 32–33 (Ex. 2023 ¶ 119;

²⁴ Before turning to the its arguments regarding Petitioner’s first proposed combination of Okamura and Belitz, Patent Owner contests our characterization of this combination in our Institution Decision. PO Resp. 29–31. These arguments are unavailing at this point in this proceeding. Accordingly, we do not discuss them.

Ex. 1005, Figs. 6a–9, 14, 44a, 44b, ¶¶ 19, 138–157, 215–233, 231, 325, 407–411).

Patent Owner contends further that “Petitioner’s first proposed combination would eliminate all of these objectives by replacing cluster maps with images that are not maps.” PO Resp. 33 (citing Ex. 2023 ¶ 120). According to Patent Owner, “none of Belitz’s thumbnails 410a–410d convey geographical information to enable it to be used as a map.” *Id.* at 34 (citing Ex. 2022, 74:15–75:6, 80:9–81:19; Ex. 2023 ¶¶125).

In addition, Patent Owner contends that Belitz “carries the same noted disadvantages as the ‘related art’ references (Fujiwara and Takakura) associated with presenting a single map using the same scale everywhere on the map” such that a person of ordinary skill in the art would not have been motivated to combine Okamura with Belitz. PO Resp. 35–36 (citing Ex. 1005 ¶¶ 4–10). Patent Owner discusses the disadvantages of single maps that Okamura solves and contends that Okamura teaches away from the proposed combination. *Id.* at 36–42; *see also* PO Sur-reply 24–26.

Patent Owner also contends that the proposed combination conflicts with Belitz’s objective of preventing overlap on the map. PO Resp. 42; *see also* PO Sur-reply 26–27. According to Patent Owner, “Belitz teaches that graphical objects should not touch or even be close to one another because otherwise this ‘would clutter the view and be confusing to a user.’” *Id.* (citing Ex. 1006 ¶¶ 54–58; Ex. 2023 ¶ 145).

Patent Owner further contends that Belitz’s thumbnails reduce the availability to provide a view of what location is associated with what. PO Resp. 43. According to Patent Owner, a person of ordinary skill in the art

“reviewing Okamura would have understood that replacing cluster maps with Belitz’s thumbnails would have undermined” the goal of improving the user experience because “the cluster maps themselves convey far more information regarding what is associated with a particular location.” *Id.* (citing Ex. 2023 ¶¶ 147–153; Ex. 1005, Fig. 41; Ex. 1006, Fig. 4b; Pet. 14, 34; Ex. 2019; Ex. 2022, 80:9–81:19, 106:9–108:24). In addition, Patent Owner argues there is no need to add preview functionality to Okamura because it already has it. *Id.* at 46.

In addition, Patent Owner contends that Belitz’s thumbnails are not functionally equivalent to or known predictable alternatives to cluster maps because “Belitz’s thumbnail images cannot be used as a map.” PO Resp. 46–47; *see also* PO Sur-reply. 22–23.²⁵

Finally, Patent Owner contends that Petitioner has failed to establish that the first combination could be used with Okamura’s FACE index screen. PO Resp. 50. Specifically, Patent Owner asserts that “Okamura, however, does not establish that a POSITA would have combined the view of Fig. 41 (corresponding to Okamura’s second embodiment) with the FACE index screen 410 (Okamura’s first embodiment) into a single method” and that Petitioner fails to articulate why a person of ordinary skill in the art would have combined these embodiments. *Id.* at 51 (citing Ex. 2023 ¶ 166).

²⁵ We do not separately summarize Patent Owner’s arguments in its Sur-reply because for the arguments that it maintains, it essentially reiterates Patent Owner’s position in its Response.

(c) *Petitioner's Reply*

Petitioner asserts that Patent Owner's arguments are without merit. Pet. Reply 15. In response to Patent Owner's argument that a person of ordinary skill in the art "would not have been motivated to modify Okamura with Belitz because 'none of Belitz's thumbnails . . . convey geographical information,'" Petitioner replies that Belitz's thumbnails do convey geographical information and the Dr. Reinman agrees. *Id.* at 16 (quoting Dr. Reinman's testimony that Belitz "shows the association of at least some pictures with the geographic location on the map depending on how many thumbnails it's currently presenting." Ex. 1040, 107:10–22). According to Petitioner, Dr. Reinman "further acknowledged that replacing cluster maps with thumbnails would not result in the loss of 'all geographic context.'" *Id.* at 17 (citing Ex. 1040, 114:6–15).

In addition, Petitioner replies to this argument by asserting that even if it were true that none of Belitz's thumbnails convey geographical information, a person of ordinary skill in the art "would have been motivated to combine Okamura and Belitz to obtain 'additional benefits.'" Pet. Reply 15 (citing Ex. 1003 ¶¶ 88–92). According to Petitioner, "in furtherance of Okamura's stated objective of better managing digital contents, the proposed combination 'enhances a user experience of "discern[ing] between the various objects" by providing "a good view of what location is associated with what.'" *Id.* at 15–16 (citing Ex. 1003 ¶ 89; Ex. 1006 ¶ 2). Petitioner replies further that

Even if the benefits obtained by incorporating Belitz's thumbnails into Okamura were to come at the expense of some other benefit offered by Okamura, a POSITA pursuing the

combination would have nevertheless been capable of weighing potential benefits associated with each, for instance recognizing that the benefits of viewing location-specific thumbnail images may be achieved in one instance and those of viewing location-specific cluster maps may be achieved in another.

Id. at 16 (citing *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000)).

In reply to Patent Owner’s argument that “Belitz ‘carries the same noted disadvantages as the “related art” references (Fujiwara and Takakura)” mentioned in Okamura,[’]” Petitioner replies that although “in both Fujiwara and Takakura, it can be difficult to grasp the geographical correspondence between digital files because their thumbnails are not placed directly on the map,” “it is *not* difficult to grasp the geographical correspondence between digital files in Belitz because, for example, a user looking at Belitz’s FIG. 4b can easily understand which location the thumbnail 410b is associated with and which location the thumbnail 410c is associated with.” Pet. Reply 17 (citing PO Resp. 35–36; Ex. 1041 ¶ 24).

In reply to Patent Owner’s argument that the proposed combination “violates Belitz’s stated objectives of reducing overlap because, in the proposed combination, ‘at least some of graphical objects from Belitz overlaps on the map,’” Petitioner replies that “a portion of Dr. Greenspun’s illustration that was *not* shown by Patent Owner clearly shows that the combination can be achieved without any overlap.” Pet. Reply 17–18 (Citing Ex. 1003 ¶ 88; Ex. 1041 ¶¶ 25–26).

Petitioner replies further that Patent Owner’s contention “that ‘Belitz’s thumbnails reduce the ability to provide a view of “what location is associated with what,”’” ignores “the careful explanation previously

provided by Dr. Greenspun” “that incorporating the thumbnails of Belitz into Okamura would have resulted in the ‘added functionality that allows a user to preview pictures associated with a given location’ and do so in a manner that allows the user to more ‘clearly see the associations.’” Pet. Reply 19 (citing PO Resp. 43–46; Ex. 1003 ¶ 90–91).

In reply to Patent Owner’s contention that “Okamura already allows a user to ‘preview pictures,’” Petitioner replies that “the incorporation of Belitz’s thumbnails allows the user to quickly associate multiple preview pictures with multiple locations on the map without having to individually navigate through each of the clusters” such that “the combination of Okamura and Belitz helps improve user experience and overall content awareness by providing the user with a preview of the digital files associated with multiple corresponding locations.” Pet. Reply 19–20 (citing Ex. 1041 ¶ 28). Petitioner asserts that “instead of changing the ‘hallmark aspects of either of these references’ as Patent Owner contends, the proposed combination of Okamura and Belitz provides a known and predictable alternative to displaying and managing digital content in a manner that can help improve user experience.” *Id.* at 20 (citing Ex. 1003 ¶ 89; Ex. 1041 ¶ 28).

Finally, in reply to Patent Owner’s contention that “Petitioner has ‘failed to demonstrate that the first combination (based on Okamura’s second embodiment) would have been used with Okamura’s FACE index screen 410,’” Petitioner asserts that Dr. Greenspun explained in great detail how “Okamura discloses or renders obvious that the second input of displaying the face-based index screen is subsequent to the first input of

displaying a map view screen.” Pet. Reply 20 (citing Ex. 1003 ¶¶ 133–138). Petitioner replies further that “[t]o the extent Okamura does not explicitly disclose this transition, a POSITA certainly would have found it to be obvious.” *Id.* (citing Ex. 1003 ¶ 138; Ex. 1041 ¶ 29).

(d) Discussion

We have considered both parties evidence and arguments with regards to Petitioner’s reasoning in support of its first proposed combination. We agree with Petitioner that even if we assume that none of Belitz’s images are maps, the proposed combination has other advantages that a person of ordinary skill in the art would have been capable of weighing against any benefits lost. Pet. Reply 15–17; *Winner Int’l*, 202 F.3d at 1349 n.8.

We further agree with Petitioner that Belitz does not suffer from the same geographical deficiencies as the references discredited by Okamura in and that the proposed combination can be achieved without overlap. Pet. Reply 17–18. We also agree with Petitioner that Patent Owner’s argument the proposed combination would reduce the ability to provide a view of “what location is associated with what,” ignores Dr. Greenspun’s testimony. *Id.* at 19.

In addition, we agree with Petitioner that the proposed combination provides more than just previewing pictures, as argued by Patent Owner, and that Dr. Greenspun’s testimony adequately explains why a person of ordinary skill in the art would have found it obvious to combine Okamura’s second embodiment with its FACE index screen. Pet. Reply 20.

Furthermore, Patent Owner’s argument that Belitz’s thumbnails are not functionally equivalent or known predictable alternatives is unavailing

because Petitioner's rational in support of the proposed combination is not based on the substitution of these components.

For these reasons, we determine that Petitioner has shown, by a preponderance of the evidence, that a person of ordinary skill in the art would have been motivated to combine the teachings of Okamura and Belitz in the manner proposed in its first proposed combination of these references.

(2) *Second Combination of Okamura and Belitz*

Petitioner asserts that a person of ordinary skill in the art “would have found it obvious to replace Okamura’s map-related views (e.g., cluster map view shown in FIG. 18 or map view shown in FIG. 41) with Belitz’s map view.” Pet. 12 (citing Ex. 1003 ¶ 87). As we have determined that Petitioner has shown, by a preponderance of the evidence, that a person of ordinary skill in the art would have been motivated to combine the teachings of Okamura and Belitz in the manner proposed in its first proposed combination of these references, we do not address Petitioner’s proposed second combination.

d) *Conclusion re Claim 1*

For the reasons discussed above, and based on our review of the entire record of this proceeding, we determine that Petitioner has shown, by a preponderance of the evidence, that claim 1 is unpatentable over the combined teachings of Okamura and Belitz.

2. *Dependent Claims 2–17*

Patent Owner contends that “[b]ecause Petitioner has failed to show that any of the references identified in Ground 1 render obvious the

independent claims²⁶ on which they depend, it also fails to meet its burden for the dependent claims.” PO Resp. 60 (citing *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009)).

As we have determined that Petitioner has shown that the combined teachings of Okamura and Belitz render claim 1 unpatentable, Patent Owner’s argument is unavailing. We have reviewed Petitioner’s contentions regarding the limitations of claims 2–17 as set forth in the Petition and determine that Petitioner, has shown by a preponderance of the evidence, that these claims are unpatentable over the combined teachings of Okamura and Belitz. Pet. 55–81.

3. *Claims 18 and 19*

For claim 18, Petitioner asserts that “Okamura describes that selecting a face-based thumbnail image (‘when a desired cluster is determined **by a user operation**’) causes the user interface to display ‘contents included in the face cluster [].’” Pet. 78 (citing Ex. 1005 ¶ 261, Figs. 21, 24; Ex. 1003 ¶ 187). Petitioner asserts further that “the content display area 441 includes a representation of each digital file in the third set of digital files.” *Id.* at 79 (citing Ex. 1005 ¶ 261; Ex. 1003 ¶ 188). Petitioner reasons that

To the extent that Okamura does not expressly teach displaying the first name in the first person view, a POSITA would have found it obvious to display the **first name** (e.g., as part of the content information 452 or next to the image 461 adjacent to the face) to improve recognition of the first person (as similarly done in the people view where “pieces of information 433 related to the thumbnail image 432 are

²⁶ We note that claim 1 is the only independent claim in this proceeding.

displayed” including “the name of the person corresponding to the face”; *see* [1i].

Pet. 79–80 (citing Ex. 1005 ¶ 247; Ex. 1003 ¶ 189). Petitioner asserts that “Okamura describes ‘content information 452 . . . as information related to a content, for example, the time of generation of the content, the time range of the contents of a cluster to which the content belongs, *and the like*’” and that “[f]rom this description and Okamura’s earlier disclosure of displaying a name of a person corresponding to a face cluster, a POSITA would have found it obvious to display, in the person view as part of the content information, the name of the person associated with the cluster.” *Id.* at 80 (citing Ex. 1005 ¶ 255; 1003 ¶ 189).

For claim 19, Petitioner refers to its discussion of claim 18 and states that “Okamura describes the second person view responsive to a selection of the second person selectable thumbnail image.” Pet. 80 (citing Ex. 1003 ¶ 190).

Patent Owner contends that “claim 18 requires (i) displaying a ‘first person’ view in response to an ‘input’ from the people view and (ii) that the first person view displayed in response to that ‘input’ must ‘includ[e] . . . (i) the first name and (ii) a representation of each digital file in the third set of digital files.’” PO Resp. 61. Patent Owner asserts further that “Okamura does not teach that selecting a thumbnail image in Fig. 21 (*people view*) causes the view of Okamura Fig. 24 (*first person view*) to be displayed.” *Id.* at 62 (citing Ex. 2023 ¶ 197). According to Patent Owner, “[i]nstead, “Okamura specifically teaches that the view of ‘FIG. 24 . . . is displayed when the mouse is placed over [a] face portion . . . ‘on the content playback screen 450 shown in FIG. 23.’” *Id.* (citing Ex. 1005 ¶ 261; Ex. 2023 ¶ 198).

Petitioner replies that “Patent Owner appears to be arguing that only a single initial user “input” and no other additional actions must cause both the first name and the representation of digital files to appear.” Pet. Reply 23–24 (citing PO Resp. 61). Patent Owner responds that “[t]he Reply does not dispute that the Petition misread Okamura’s disclosure . . . or otherwise address th[e] deficiency” pointed out in its Response. PO Sur-reply 30–31.

We agree with Patent Owner that the Petition does not adequately address how selecting a thumbnail in Figure 21 (identified by Petitioner as Okamura’s people view) would result in the display of Figure 24 (identified by Petitioner as Okamura’s first person view). PO Resp. 62; Pet. 79. As noted by Patent Owner, Figure 24 is displayed when the mouse is hovered over a face portion in Figure 23, not Figure 21. Thus, even if we credit Dr. Greenspun’s testimony that “whether to show certain text all the time or only just part of the time is simply a matter of ‘design choice and maybe a function of user preference’” (Ex. 2022, 132:6–12), the Petition does not adequately explain how the combined teachings of Okamura and Belitz render claim 18 obvious.

For these reasons, we determine that Petitioner does not show, by a preponderance of the evidence, that claim 18 is unpatentable over the combined teachings of Okamura and Belitz.²⁷

²⁷ Our determination that the challenge to claim 18 in this proceeding fails because of a deficiency in the Petition should not be taken as a determination as to whether Okamura and Belitz render claim 18 unpatentable.

4. *Claim 19*

For claim 19, Petitioner refers to its discussion of claim 18 and adds that “Okamura describes the second person view responsive to a selection of the second person selectable thumbnail image.” Pet. 80 (citing Ex. 1003 ¶ 190).

The deficiencies in the Petition discussed in the preceding section apply to claim 19 as well. For the reasons discussed above we determine that Petitioner does not show, by a preponderance of the evidence, that claim 19 is unpatentable over the combined teachings of Okamura and Belitz.²⁸

5. *Conclusion*

For the foregoing reasons, and on the record presently before us, we determine that Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–17 of the ’228 patent are unpatentable over Okamura and Belitz, but has not demonstrated, by a preponderance of the evidence, that claims 18 and 19 are unpatentable over Okamura and Belitz.

J. *Outstanding Motions*

On August 31, 2023, Patent Owner filed a Motion for Entry of Protective Order. Paper 47 (First Motion”). In the First Motion, Patent Owner moved for entry of a Protective Order similar to the Protective Orders entered in the *Unified* proceeding and the *Apple* proceeding. *Id.* at 1–2, Appendix. Patent Owner indicated that Petitioner does not oppose the First Motion or entry of the Protective Order. *Id.* at 1.

²⁸ See n. 25.

On September 29, 2023, Patent Owner filed a Motion to Seal. Paper 51 (“Second Motion”). In the Second Motion, Patent Owner moved to seal Patent Owner’s Motion to Terminate (Paper 52) and Exhibits 2062, 2063, 2067, 2068, 2069, 2071, 2072, 2073, 2074, 2077, 2078, 2083, 2084, 2085, 2090 and 2099. *Id.* at 2. Patent Owner indicated that Petitioner does not oppose the Second Motion. *Id.* at 2.

On October 13, 2023, Petitioner filed a Motion to Seal. Paper 54 (“Third Motion”). In the Third Motion, Petitioner moved to seal its Reply to Patent Owner’s Motion to Terminate (Paper 53).

On October 31, 2023, Patent Owner filed a Motion to Seal. Paper 56 (“Fourth Motion”). In the Fourth Motion, Patent Owner moved to seal its Reply in Support of its Motion to Terminate (Paper 57). *Id.* at 1. Patent Owner indicated that Petitioner does not oppose the Fourth Motion.

On November 17, 2023, both parties filed a Joint Motion to Seal. Paper 60 (“Fifth Motion”). In the Fifth Motion, both parties moved to seal their respective demonstrative exhibits. Exs. 2116 and 1047.

As provided under Rule 42.54(a), “[t]he Board may, for good cause, issue an order to protect a party from disclosing confidential information,” including forbidding the disclosure of protected information or specifying the terms under which such information may be disclosed. 37 C.F.R. § 42.54(a). The Board also observes a strong policy in favor of making all information filed in *inter partes* review proceedings open to the public. *See Argentum Pharms. LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27 at 3–4 (PTAB Jan. 19, 2018) (informative).

Under 37 C.F.R. § 42.14, the default rule is that all papers filed in such proceedings are available to the public. Only “confidential information” is subject to protection against public disclosure. 35 U.S.C. § 326(a)(7) (2018); 37 C.F.R. § 42.55. The Board also observes a strong policy in favor of making all information filed in *inter partes* review proceedings open to the public. *See Argentum Pharms. LLC v. Alcon Research, Ltd.*, IPR2017-01053, Paper 27, 3–4 (PTAB Jan. 19, 2018) (informative). The moving parties bear the burden of showing the requested relief should be granted. 37 C.F.R. § 42.20(c). To establish “good cause” for the requested relief, the Parties must make a sufficient showing that:

- (1) the information sought to be sealed is truly confidential, (2) a concrete harm would result upon public disclosure, (3) there exists a genuine need to rely in the trial on the specific information sought to be sealed, and (4), on balance, an interest in maintaining confidentiality outweighs the strong public interest in having an open record.

Argentum, Paper 27 at 3–4; *see also Corning Optical Commc’ns RF, LLC, v. PPC Broadband, Inc.*, IPR2014-00440, Paper 46 at 2 (PTAB April 6, 2015) (requiring a showing that information has not been “excessively redacted”); *see also* 37 C.F.R. § 42.54(a).

Regarding the First Motion, Patent Owner states that “[t]he proposed Protective Order is similar to the protective order the Board entered in the *Unified* Proceeding to address Unified’s concerns over the handling of documents and testimony containing Unified’s confidential business information relating to Unified’s members and business operations.” *Id.* at 1 (citing Ex. 2028 (Motion for Entry of Protective Order in *Unified* Proceeding); Ex. 2039 (Order granting motion in *Unified* Proceeding)).

Patent Owner further states that “[t]he proposed Protective Order is identical (with the exception of a correction of a minor typo) to the protective order the Board entered in the Apple proceeding.” *Id.* at 1–2 (citing Ex. 2040 (Motion for Entry of Protective Order in *Apple* Proceeding); Ex. 2041 (Order granting motion in *Apple* Proceeding)). Patent Owner asserts that it “seeks discovery of similar Unified materials in the present proceeding” and that “[t]he proposed Protective order will also govern the handling of confidential materials produced by Petitioner.” *Id.* at 2.

In addition, Patent Owner states that “[t]he proposed Protective Order differs from the Board’s Default Protective Order . . . in that the proposed Protective Order includes a “HIGHLY CONFIDENTIAL – ATTORNEY’S EYES ONLY” designation at Unified’s and [Petitioner’s] request.” Paper 47, 2. Patent Owner further states that “the proposed Protective Order identifies the persons to which access to confidential information is limited and clarifies the treatment of confidential materials unless the Board determines that information does not qualify for confidential treatment.” *Id.*

Regarding the Second Motion, Patent Owner states that

(1) the forthcoming unredacted portions of the Motion to Terminate and Exhibit 2085, (2) the entirety of Exhibits 2063, 2067, 2068, 2069, 2072, 2073, 2077, 2078, 2083, 2084, and 2099; and (3) portions of Exhibits 2062, 2071, 2074, and 2090 (the redacted versions of these exhibits are Exhibits 2049, 2045, 2086, and 2091, respectively) contain non-public, highly confidential proprietary business information about Unified’s members (e.g., Apple and Samsung) and/or information regarding Unified’s business operations that Unified maintains as confidential.

Paper 53, 3–4. Patent Owner states that “[d]ue to the nature of Exhibits 2063, 2067, 2068, 2069, 2072, 2073, 2077, 2078, 2083, 2084, and 2099, Patent Owner and the relevant parties cannot meaningfully provide redacted versions of these documents, and Patent Owner requests that they remain under seal in their entirety. *Id.* at 4.

Patent Owner states further that “public disclosure of this information ‘would expose Unified’s business model and confidential business activities’” and “Unified represents that it has a contractual obligation with third parties, including Samsung and Apple, to maintain the confidentiality of the information contained within the relevant exhibits,” such that “[i]f such information were publicly disclosed, ‘Unified’s members wishing to remain confidential would be adversely affected.’” *Id.*; *Unified Patents*, IPR2021-01413, Paper 26 at 3. In addition, Patent Owner states that Unified “represents that the public will not be harmed by sealing its confidential business information.” *Id.* 4–5.

Patent Owner also states that “the exhibits at issue are directly relevant to whether Petitioner is a real party in interest (‘RPI) to Unified’s IPR” and that it “must rely on confidential information to prove that Petitioner is an RPI to Unified’s IPR.” Paper 51, 5. Patent Owner asserts that “on balance, the interest in maintaining confidentiality outweighs the public interest in having an open record.” *Id.*

Patent Owner makes similar statements with respect to its Reply in Support of its Motion to Terminate in the Fourth Motion. *See* Paper 56, 2–4.

Regarding the Third Motion, Petitioner states that its “Reply to Patent Owner’s Motion to Terminate includes confidential information designated

as Protective Order Material pursuant to the Protective Order.” Paper 54, 2. Petitioner asserts that “failing to seal the confidential version of the Petitioner’s Reply to Patent Owner’s Motion to Terminate would frustrate the purpose of sealing the confidential evidence.” *Id.* Petitioner asserts further that “the public would still have full access to the nature of the information and the conclusions reached using the publicly available information. Such access should adequately fulfill the needs of the public to maintain a complete and understandable file history, while still protecting confidential and proprietary information.” *Id.*

Regarding the Fifth Motion, the parties state that “the Demonstratives rely on and discuss the confidential information disclosed in exhibits previously filed under seal.” Paper 60, 1. In addition, the parties make statements similar to the statements made by Patent Owner in the Second and Fourth Motions. *Id.* at 2–5.

Upon reviewing the proposed Protective Order (Paper 47, Appendix), we conclude that the differences from the Board’s Default Protective Order address the parties’ obligations and do not limit the Board’s authority in this proceeding.

Upon considering the parties representations and arguments in all of the Motions, the contents of the exhibits sought to be sealed in their entirety and the contents of the information sought to be redacted, we conclude that the parties have established good cause for sealing the request documents.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–17 of U.S.

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Patent 10,621,228 B2

Patent No. 10,621,228 B2 are unpatentable, but has not demonstrated, by a preponderance of the evidence that claims 18 and 19 are unpatentable on the bases set forth in the following table.²⁹

Claims	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–19	103(a)	Okamura, Belitz	1–17	18, 19
Overall Outcome			1–17	18, 19

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner’s motion to enter the proposed Protective order (Paper 47, Appendix) is *granted* and the Protective Order is entered;

FURTHER ORDERED that Patent Owner’s request to seal Exhibits 2062, 2063, 2067, 2068, 2069, 2071, 2072, 2073, 2074, 2077, 2078, 2083, 2084, 2085, 2090 and 2099 is *granted*;

²⁹ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Final Decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

FURTHER ORDERED that Patent Owner's requests to seal redacted portions of Patent Owner's Motion to Terminate and Patent Owner's Reply in Support of its Motion to Terminate is *granted*;

FURTHER ORDERED that Petitioner's request to seal redacted portions of Petitioner's Reply to Patent Owner's Motion to Terminate is *granted*;

FURTHER ORDERED that the parties request to seal their respective Demonstrative Exhibits is *granted*;

FURTHER ORDERED that Petitioner has demonstrated by a preponderance of the evidence that claims 1–17 of U.S. Patent No. Patent 10,621,288 B2 are unpatentable;

FURTHER ORDERED that Petitioner has not demonstrated by a preponderance of the evidence that claims 18 and 19 are unpatentable;

FURTHER ORDERED that, no later than ten business days after the issuance of this Final Written Decision, the parties may file a joint motion to seal portions of this Final Written Decision, explaining why portions of it should remain under seal, and including as an attachment a redacted version of the Final Written Decision that can be made publicly available;

FURTHER ORDERED that the present decision shall remain under seal until any joint motion to seal the Final Written Decision is resolved;

FURTHER ORDERED that the present decision shall be made public if, after the expiration of the time for the parties to file a joint motion to seal, no such motion has been filed; and

FURTHER ORDERED that because this is a Final Written Decision, any party to the proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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