

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

PGR2022-00006
Patent 11,017,020 B2

Before GEORGIANNA W. BRADEN, KEVIN C. TROCK, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision on Remand
Determining All Challenged Claims Unpatentable
35 U.S.C. § 328(a)

I. INTRODUCTION

A. *History*

Apple Inc. (“Petitioner”) filed a petition to institute a post-grant review of claims 1–59 of U.S. Patent No. 11,017,020 (Ex. 1001, “the ’020 patent”). Paper 1 (“Pet.”). MemoryWeb, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8. With the Board’s authorization, Petitioner filed a Reply (Paper 10) and Patent Owner filed a Sur-reply (Paper 11).

On May 17, 2022, we instituted a post-grant review of all challenged claims based on all grounds in the Petition. Paper 12 (“Inst. Dec.”). Patent Owner filed a Response. Paper 20 (“PO Resp.”). Petitioner filed a Reply. Paper 26 (“Reply”). Patent Owner filed a Sur-reply. Paper 31 (“Sur-reply”). An oral hearing was held on March 14, 2023. A transcript of that hearing has been entered into the record. Paper 40 (“Tr.”). We issued a Final Written Decision determining that Petitioner had shown by a preponderance of the evidence that claims 1–12, 17–44, and 49–59 are unpatentable but had not shown that claims 13–16 and 45–48 are unpatentable. Paper 41 (“FWD”).

Petitioner filed an appeal with respect to claims 13–16 and 45–48 to the Court of Appeals for the Federal Circuit. Paper 44. Patent Owner filed a cross-appeal with respect to claims 1–12, 17–44, and 49–59. Paper 45. The Federal Circuit affirmed the Board’s determination with respect to all claims except for 13–16 and 45–48. Paper 47 (“CAFC Dec.”), 2–3. For claims 13–16 and 45–48, the Federal Circuit vacated the Board’s decision and remanded for further proceedings. *Id.* at 3.

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision on remand is issued under 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has shown all challenged claims to be unpatentable.

B. The '020 Patent

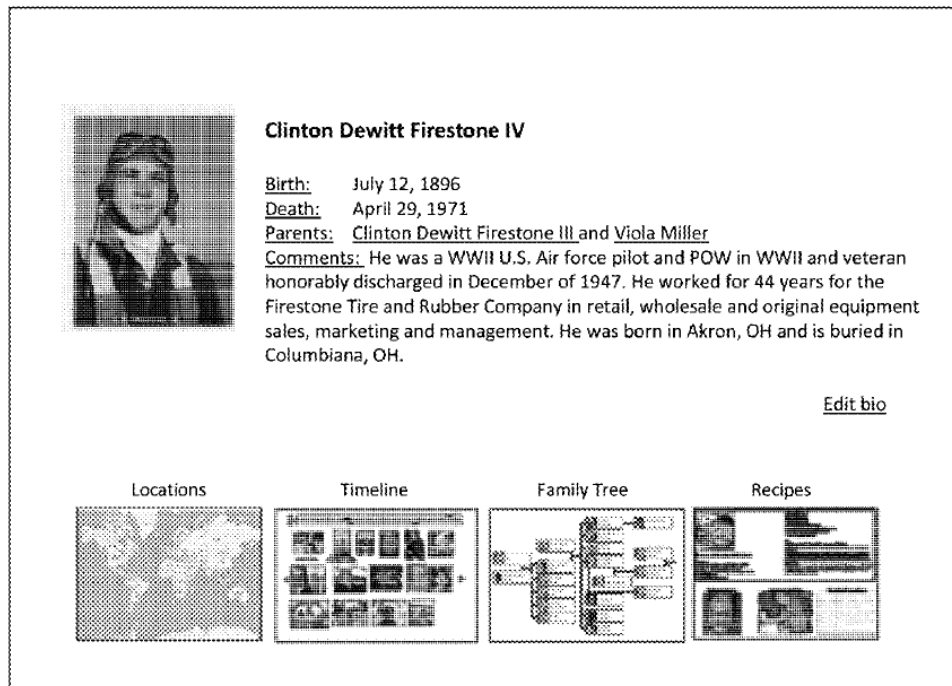
The '020 patent relates to a platform for managing and using digital files, such as digital photographs. *See* Ex. 1001, 1:22–24. Through the platform’s interface, a user can tag and select files to create views. *See id.* at 5:40–45. For example, the “people view” is shown below. *Id.* at 6:24–26, Fig. 6.

FIG. 6



The people view, above, is a table showing thumbnail photos of all the people in the system. *Id.* Clicking on a thumbnail causes a “profile view,” shown below, to be displayed. *See id.* at 6:24–30.

FIG. 7



The profile view, above, is a table displaying a person's image, date of birth, date of death, parents' names, and other biographical information. *Id.* at 6:26–30. The profile view also displays links to other views containing information about the person: Locations, Timeline, Family Tree, and Recipes. *Id.* The Locations view, for example, has an interactive map showing where the digital files were taken. *Id.* at 6:18–23.

C. Claims

Of the challenged claims, claims 1 and 31 are independent. Claims 1 and 13 are reproduced below.

1. A method comprising:

causing an interface to display a people view, the people view including:

- a first thumbnail image associated with a first person,
- a first name associated with the first person,

a second thumbnail image associated with a second person, and
a second name associated with the second person;
responsive to an input that is indicative of a selection associated with the first person, causing a first person view to be displayed on the interface, the first person view including:
a first digital file associated with the first person,
the first name associated with the first person, and
a first map image;
responsive to an input that is indicative of a selection of the first map image in the first person view, causing a first location view to be displayed on the interface, the first location view including:
an interactive geographic map,
a first indication positioned at a first location on the interactive geographic map, and
a second indication positioned at a second location on the interactive geographic map; and
responsive to an input that is indicative of a selection of the first digital file in the first person view, causing a slideshow to be displayed on the interface, the slideshow including a plurality of images associated with the first person.

Ex. 1001, 35:17–45.

13. The method of claim 3, further comprising responsive to an input that is indicative of a selection associated with the second person, causing a second person view to be displayed on the interface, the second person view including the second digital file associated with the second person, the second name associated with the second person, and a second map image.

Id. at 36:22–28.

D. Evidence

Name	Reference	Exhibit No.
A3UM	Aperture 3 User Manual, Apple Inc. (2010)	1005

II. ANALYSIS

A. Level of Ordinary Skill in the Art

According to Petitioner,

A person of ordinary skill in the art in 2011 would have had (1) at least a bachelor's degree in computer science, computer engineering, or electrical engineering, and (2) at least one year of experience designing graphical user interfaces for applications such as photo management systems.

Pet. 12 (citing Ex. 1003 ¶¶ 44–46).

In the Institution Decision and Final Written Decision, we applied Petitioner's proposed definition. Inst. Dec. 12; FWD 30–31. Patent Owner does not dispute Petitioner's proposed level of ordinary skill in the art. PO Resp. 7. We continue to find that the skill level identified by Petitioner (Pet. 12) is consistent with the record. Thus, we use the same definition here that we used in the Institution Decision and Final Written Decision.

B. Alleged Obviousness over A3UM

1. A3UM

Petitioner's challenges to claims 13–16 and 45–48 under 35 U.S.C. § 103 are at issue. *See* Section I.A *supra*. Petitioner asserts that claims 13–16 and 45–48 are unpatentable as obvious in view of A3UM. Pet. 62–64.

A3UM is a user manual for Apple's Aperture 3 digital-image management software. Ex. 1005. Aperture provides photographers with image management and adjustment tools. *Id.* at 1. For example, Faces is a face-detection and face-recognition tool provided in Aperture. *Id.* at 28.

Faces can identify and track people through all the images in a digital library. *Id.* Places is also a tool provided in Aperture that organizes images by location. *Id.* at 81. In Places, a user can search for image locations on a map and zoom to view those locations in detail. *Id.* The Slideshow Editor allows the user to create slideshows. *Id.* at 84. These slideshows may include images, video, and audio clips. *Id.*

2. *Claims 13 and 45*

Petitioner’s challenges to claims 13 and 45 depend on the meaning of “second map image.”

Claim 1 recites, in part, “responsive to an input . . . causing a first person view to be displayed on the interface, first person view including . . . *a first map image.*” Ex. 1001, 35:25–31 (emphasis added). Claim 13 depends from claim 1 indirectly via claims 2 and 3 and recites, in part, “ responsive to an input that is indicative of a selection associated with the second person, causing a second person view to be displayed on the interface, the second person view including the second digital file associated with the second person, the second name associated with the second person, and *a second map image.*” *Id.* at 36:22–28 (emphasis added). Claim 45 recites a similar limitation (*see id.* at 39:9–15) and depends from independent claim 31 via claims 35 and 34.¹

C. *Claim Construction*

“In a post-grant review proceeding, a claim of a patent, or a claim proposed in a motion to amend under § 42.221, shall be construed using the same claim construction standard that would be used to construe the claim in

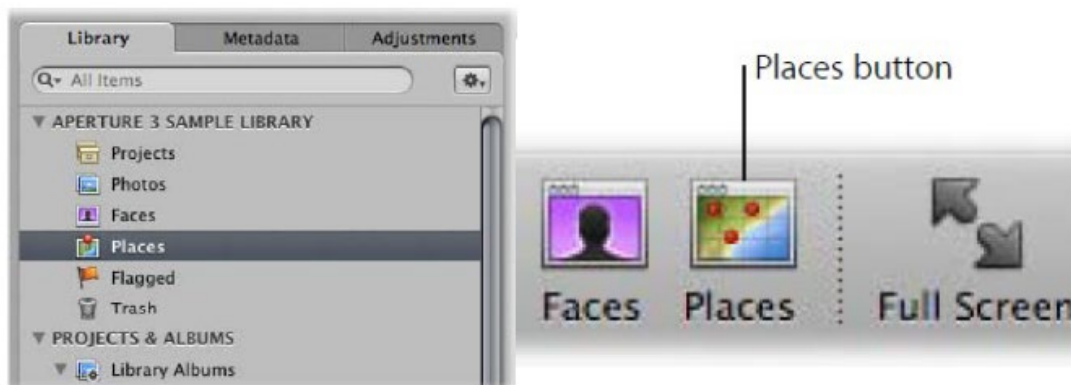
¹ The Certificate of Correction issued on May 25, 2021 changed the dependency from claim 30 to 31. Ex. 1002, 578.

a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.200(b). Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

1. The Petition

Claim 1 recites a first person view and map image (Ex. 1001, 35:25–31), and claims 13 and 45 recite a second person view and map image (*id.* at 36:22–28, 39:9–15). The reasoning in Petitioner’s challenge to claims 13 and 45 is based on its challenge to claim 1. Pet. 62–63.

As for the “first map image” recited in claim 1, Petitioner asserts, “A3UM’s interface includes two selectable links with miniature map icons . . . , the Places link in the Library inspector and the Places button in the toolbar, that can be selected to display the Places view.” Pet. 30 (citing Ex. 1005, 81, 435). The icons from A3UM are reproduced below, as shown in the Petition. *Id.*



The screenshot above shows the Library inspector pane on the left, and the “Places” button on the tool bar on the right. *Id.* In the Library inspector pane, the “Places” option is highlighted to distinguish it from the other options in the “APERTURE 3 SAMPLE LIBRARY”: “Projects,” “Photos,” “Faces,” “Flagged,” and “Trash.” *Id.* Beside each option is an icon. *Id.* The “Places” option has an icon representing a map. *Id.* The right-hand side of the screenshot shows the “Places” button on a toolbar between the “Faces” button and the “Full Screen” button. *Id.* The buttons have icons above their name. *Id.* The icon associated with the “Places” button is a miniature map. *Id.*

Petitioner argues that the Places icons in each view “represent maps and a skilled artisan would consider them to be ‘*map images[s]*.’” Pet. 30. Petitioner asserts that “these icons can be selected as part of the Places link and Places button.” *Id.* at 30–31 (citing Ex. 1005, 81, 435; Ex. 1003 ¶ 123).

Petitioner argues that the features discussed in its challenge to claim 1 are relevant the challenge to claims 13 and 45:

A3UM discloses providing the same functionality for each face identified by the system, including showing that person in Faces view, displaying their name within A3UM’s overall user interface. EX1003, ¶215; EX1005, 418-420. Because A3UM discloses or renders obvious these features with respect to a “*first person*” (claims 1 and 31), A3UM discloses or renders obvious these features with respect to a “*second person*.” See § VII.B.1.b; EX1003, ¶215.

Pet. 62–63.

2. The CAFC Decision

The Federal Circuit stated that “Apple’s petition presented the both-Places-buttons mapping that, in reply, it later made more explicit.” CAFC Dec. 14. The Federal Circuit further stated that Petitioner “identified both

Places buttons, not just one or just the other, as each meeting the ‘first map image’ limitation of ’020 claim 1,” and “[t]he petition’s theory for claim 13 is duplicative of its claim 1 argument.” *Id.* That is, the Federal Circuit viewed the Petition as “identifying each Places button as meeting the limitation” to the “second map image.” *Id.*

On remand, the Board is to determine “[w]hether the alleged inconsistency in [Petitioner’s] treatment of map images compared to other first/second versions of claim elements supports rejecting [Petitioner’s] theory on claim-construction or other merits grounds is a matter for the Board to consider in the first instance on remand, constrained by any relevantly similar now-final findings of fact and conclusions of law in the ’020 PGR and related proceedings” (CAFC Dec. 16).

Thus, the two issues on remand are (1) the construction of the second map image and (2) whether A3UM teaches or suggests the claimed “second map image” under that construction.

3. *The claimed “second map image”*

a. *Petitioner’s Arguments*

Petitioner argues that the first and second “map image” should be construed as “the map image . . . in the [first/second] person view.” Reply 5. According to Petitioner, “the claim language clearly identifies display of the ‘first/second person view’ (not the ‘first/second map image’) to be the result of the input.” *Id.* at 4.

Petitioner argues that, under this reasoning, the labels “first” and “second” are not superfluous because “each identifies *which* person view (first or second) it is within, which supports clause 1[c].” Reply 5. According to Petitioner, “An identical map image can be used for both

because the entire set of items in each view distinguishes one view from the other.” *Id.*

b. Patent Owner’s Arguments

Patent Owner argues that “second map image” should be given its plain and ordinary meaning: a “second map image that is different than the first map image.” PO Resp. 12. In Patent Owner’s view, “Courts have routinely held that numerical descriptors like ‘first’ and ‘second’ distinguish different elements in a patent claim.” *Id.* at 13 (citing *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1373 (Fed. Cir. 2005); *Intel Corp. v. VLSI Tech. LLC*, IPR2018-01040, 2020 WL 719058, at *8–12 (PTAB Feb. 12, 2020); *Uniloc 2017 LLC v. Google LLC*, Case No. 2:18-cv-00503-JRG-RSP, 2020 WL 512605, at *9 (E.D. Tex. Jan. 30, 2020); *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010)).

According to Patent Owner, “[t]he claims consistently use the terms ‘first’ and ‘second’ to refer to separate and distinct elements.” Sur-reply 11. In Patent Owner’s view, Dr. Terveen agreed that the first and second map images have different meanings and that the terms “first” and “second” require that the prior art disclose multiple elements. *Id.* (citing Ex. 1003 ¶ 54; Ex. 2024, 287:20–288:15, 291:16–19; Ex. 2025 ¶¶ 140–141).

Patent Owner argues that Petitioner’s view renders the terms “first” and “second” superfluous, as shown by claims 14 and 46. Sur-reply 12. Specifically, according to Patent Owner, “[c]laims 14 and 46 further demonstrate that the terms ‘first’ and ‘second’ denote separate and distinct elements by reciting ‘the interactive geographic map’ in the ‘second location view,’” and “[t]his is a clear example of claiming the exact same element in different views, which reinforces that ‘first’ and ‘second’ have no meaning

in relation to ‘map image’ if they do not delineate distinct map images in distinct views.” *Id.* (citing *Power Mosfet Techs., L.L.C. v. Siemens AG*, 378 F.3d 1396, 1410 (Fed. Cir. 2004)).

c. Analysis

We agree with Petitioner that the “second map image” should be construed as the map image in the second person view. Reply 5. Under Petitioner’s proposed construction, the terms “first” and “second” identify which person view that the map image is within. *Id.* The map image’s connection to the person view is important to how the user interacts with the interface because selecting the map image in one view does something different than selecting the map image in another, as recited in claims 14 and 46.

Claims 14 and 46 depend from claims 13 and 45 and recite what happens in response to the selection of the second map image in the second person view. Specifically, when the user selects the map image, as recited in claims 14 and 46, different information is displayed. Petitioner explains that A3UM’s map images work in the same way:

Because A3UM discloses or renders obvious these features with respect to a “*first person*” and “*first location view*” (claims 1 and 31), A3UM discloses or renders obvious these features with respect to a “*second person*” and “*second location view*.”

Pet. 63 (emphasis in original). Under this reasoning, the first and second map images are functionally distinguishable from each other. So, although A3UM’s first and second map images have the same appearance (i.e., a picture of a map), the image’s appearance need not be the only way that the

claimed map images are distinct.² Contrary to Patent Owner’s arguments (Sur-reply 12), claims 14 and 46 actually support the argument that the first and second map images are different for the reasons that Petitioner provides (Pet. 63; Reply 5).

This is consistent with our Final Written Decision because, there, we noted that A3UM’s static map icons fall within the scope of the “first map image” in claim 1. FWD 53–56. There is nothing in claim 13 that provides a basis for deviating from our analysis of claim 1 in the Final Written Decision when analyzing the “second map image” in claim 13. For example, claim 13 does not require causing a map image with a different appearance to be displayed on the interface in response to an input.

Thus, we construe the second map image as the map image in the second person view. Reply 5.

4. A3UM’s “second map image”

We agree with Petitioner that A3UM teaches the claimed “second map image” under the proper construction. Our reasoning follows.

Patent Owner argues that A3UM’s “Places link is a static element that is always displayed by default and always causes the same result when selected,” and its “Places toolbar button is continuously displayed by default.” PO Resp. 88 (citing Ex. 2025 ¶ 262; Ex. 1005, 6, 64–65, 81). In

² Petitioner questions whether the content of the map images or visual elements, generally, has “patentable significance.” See Reply 35; see also *id.* at 6 (citing *In re Yeager*, 527 F. App’x 859, 861 (Fed. Cir. 2013)). We need not resolve that issue here. See, e.g., *In re Distefano*, 808 F.3d 845 (Fed. Cir. 2015) (setting forth a two-step test for determining whether a limitation should be given patentable weight under the printed-matter doctrine). Rather, even if appearance is one way to differentiate the first and second map images, Petitioner has sufficiently shown that the map images can be different in other ways. See Reply 5.

Patent Owner’s view, “Neither of these elements can logically be both the first map image and the second map image.” *Id.* (Ex. 2025 ¶¶ 263–265); *see also* Sur-reply 23–24 (arguing that Petitioner’s challenge fails because it does not show a “‘second map image’ distinct from what Petitioner already identified as the first map image”).

Here, we disagree with Patent Owner’s argument because it is based on the premise that the second map image is different from the first in a way that is not reflected in the claims. *See* Section II.C.3 *supra*. Even if “the claims consistently use the terms ‘first’ and ‘second’ to refer to separate and distinct elements,” A3UM’s first and second map images are separate and distinct elements for at least the reason they are included in separate and distinct views in the interface. *See* Pet. 63; Reply 5.

As discussed in Section II.C.3, the second map image is the map image in the second person view. Here, Petitioner sufficiently shows that A3UM provides the same functionality for each person, including displaying the person in the Faces view with their name within A3UM’s overall user interface. *See* Pet. 62 (citing Ex. 1003, ¶215; Ex. 1005, 418–420). Patent Owner does not dispute this. *See* PO Resp.; Sur-reply. For the same reasons why A3UM teaches the “first map image” with respect to a first person view recited in claims 1 and 31, Petitioner has shown that A3UM also teaches the “second map image” in the second person view. *See* FWD 53–56.

In sum, Patent Owner’s arguments are unpersuasive because they are based on an incorrect claim construction, and Petitioner has shown that claims 13 and 45 are unpatentable.

5. *Claims 14–16 and 46–48*

Apart from the arguments analyzed above, Patent Owner does not present separate arguments directed to the subject matter of claims 14–16

and 46–48. *See* PO Resp. 87–90;³ Sur-reply. Even so, Petitioner has the burden to show that the challenged claims are unpatentable. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). We have reviewed Petitioner’s arguments and evidence submitted in connection with the remaining limitations and find them persuasive as they are consistent with and supported by the evidence of record. *See* Pet. 63–64.

Thus, Petitioner has shown that claims 14–16 and 46–48 are unpatentable over A3UM.

III. CONCLUSION

Petitioner has shown by a preponderance of the evidence that all challenged claims are unpatentable.

Overall Outcome on Federal Circuit Remand

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–59	103	A3UM	1–6, 8–37, 40–44, 49–59	
6, 7, 38, 39	112	Written Description	6, 7, 38, 39	
Overall Outcome			1–59	

³ Patent Owner makes an argument in connection with claims 16 and 48 that is based on an alternative view of the challenge that is not at issue here. *See* PO Resp. 89.

IV. ORDER

It is

ORDERED that Petitioner has shown that claims 1–59 of U.S. Patent No. 11,017,020 B2 are unpatentable; and

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

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