

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00031
Patent 10,621,228 B2

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

TROCK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Petitioner, Apple, Inc. (“Apple” or “Petitioner”), filed a petition requesting *inter partes* review of claims 1–19 of U.S. Patent No. 10,621,228 B2 (“the ’228 patent”). Paper 1. On May 20, 2022, the Board instituted trial. Paper 12.

In a related proceeding challenging claims 1–7 of the ’228 patent, *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413 (the “*Unified* proceeding”), the Board entered an Order (Paper 56 (confidential)) on March 8, 2023, identifying Apple as an unnamed Real Party in Interest (“RPI”), and on March 14, 2023, entered a Final Written Decision (Paper 58 (confidential)) finding claims 1–7 unpatentable.

On March 31, 2023, the Board held a conference call with counsel for the parties in this proceeding, as well as counsel for the parties in the *Unified* proceeding and counsel for the parties in *Samsung Electronics Co. Ltd. v. MemoryWeb, LLC*, IPR2022-00222 (the “*Samsung* proceeding”). Ex. 3003. On April 7, 2023, pursuant to the Board’s request, counsel for the parties provided their respective positions on how to move forward in these proceedings. Ex. 3002. On May 12, 2023, counsel provided the Board with additional information on their respective positions. Ex. 3004.

Patent Owner, MemoryWeb, LLC (“MemoryWeb” or “Patent Owner”) seeks leave to file a motion to terminate this proceeding in view of the Board’s Final Written Decision in the *Unified* proceeding. Ex. 3002, 1. Apple opposes Patent Owner’s request, and asserts that MemoryWeb has waived its right to raise the RPI issue in this proceeding. *Id.* at 2. Apple believes it would be appropriate to permit its outside counsel to inspect the record in the *Unified* proceeding that bears on the RPI issue, but opposes additional discovery in this proceeding on that issue. *Id.* MemoryWeb

asserts that to the extent Apple wishes to argue waiver, that Apple should do so in its opposition to MemoryWeb’s requested motion to terminate. *Id.* at 1.

On May 4, 2023, in accordance with 37 C.F.R. § 42.100(c), the Chief Administrative Patent Judge determined that good cause exists to extend the one-year period for issuing a Final Written Decision in this proceeding in light of the Board’s Final Written Decision in the *Unified* proceeding. Paper 41. On May 16, 2023, we issued an Order extending the one-year pendency of this proceeding for up to six months. Paper 42.

On May 22, 2023, the Director issued a public version¹ 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 Apple as an RPI (Paper 56 (confidential)) in that proceeding. The Director’s Decision states that “[t]he Board can and should make a determination of the real parties in interest or privity in any proceeding in which that determination may impact the underlying proceeding, for example, but not limited to, a time bar under 35 U.S.C. § 315(b) or an estoppel under 35 U.S.C. § 315(e) that might apply.” Paper 76, 5.

After considering the parties’ positions and the procedural history of this case and the related proceedings, the parties are directed to prepare and submit for consideration a detailed discovery plan and briefing schedule

¹ 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.

designed to address the RPI, estoppel, and waiver issues. The discovery plan and briefing schedule should be designed to address the following issues: 1) whether Apple should have been named as an RPI in the *Unified* proceeding; 2) whether Apple is estopped from maintaining this proceeding, or a portion of this proceeding, pursuant to 35 U.S.C. § 315(e)(1); and 3) whether MemoryWeb has waived any right to assert estoppel under 35 U.S.C. § 315(e)(1) in this proceeding. In preparing the discovery plan and briefing schedule, the parties should consider the burdens of proof for the RPI, estoppel, and waiver issues to the extent they are addressed in *Ironburg Inventions Ltd. v. Valve Corp.*, No. 21-2296 (Fed. Cir. Apr. 3, 2023) and *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018).

Accordingly, it is

ORDERED that the parties shall confer and develop a proposed joint discovery plan and briefing schedule in accordance with this Order; and

FURTHER ORDERED that the parties shall report back to the Board via e-mail no later than June 9, 2023, providing the proposed joint discovery plan and briefing schedule, indicating any items on which the parties disagree.

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