

PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

UNIFIED PATENTS, LLC,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2021-01413
Patent 10,621,228 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

DECISION
Granting Director Review,
Vacating-in-part the Final Written Decision and Vacating Board Order

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I. INTRODUCTION

The Office received a request for Director Review of the Final Written Decision (Paper 58 (confidential) and Paper 67 (public) (“Decision” or “Final Written Decision”)) for the above-captioned case. *See* Paper 70 (confidential); Ex. 3100. Petitioner Unified Patents, LLC (“Unified”) requests Director Review of the Board’s real party in interest (“RPI”) determination in Section I.B. of the Decision that incorporates the Board’s Order Identifying Real Party in Interest (Paper 56 (confidential) (“RPI Order”)). Ex. 3100.

I have reviewed the request, the Board’s Decision, the RPI Order, and the relevant filed papers and exhibits in the above-listed proceeding. I determine that Director Review of the Board’s Decision is appropriate. *See* Interim process for Director Review § 8 (setting forth scope of Director Review) and § 10 (issues that may warrant Director Review). Concurrent with this Decision, the Precedential Opinion Panel (“POP”) dismissed Petitioner’s additional requests for rehearing and POP review of the RPI Order. *See* Paper 62, Ex. 3001.

For the reasons set forth below, I vacate the Board’s RPI discussion in the Final Written Decision (Section I.B.), and the RPI Order (Paper 56) underlying that discussion.

II. BACKGROUND

Unified filed a Petition requesting *inter partes* review of claims 1–7 of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 Patent”), certifying that it “is the real party-in-interest.” Paper 2 (“Petition” or “Pet.”), 1. Although Unified and Patent Owner MemoryWeb LLC (“MemoryWeb”) briefed and argued, pre-institution, whether Unified should have named third parties

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Apple and Samsung as RPIs under 35 U.S.C. § 312(a)(2), the Board “decline[d] to determine whether Apple and Samsung are real parties in interest” in its Institution Decision because the Board found that “there is no allegation in *this* proceeding of a time bar or estoppel based on an unnamed RPI.” Paper 15, 13–14 (“Institution Decision”) (citing Paper 11, 1) (emphasis added). Accordingly, the Board did “not address whether Apple and Samsung are unnamed RPIs because, even if either were, it would not create a time bar or estoppel under 35 U.S.C. § 315.” *Id.* at 13 (citing *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11, 18 (PTAB Oct. 6, 2020) (precedential)). The Board instituted *inter partes* review as to all challenged claims on all grounds raised in the Petition.

Following institution, MemoryWeb again argued that the Board should terminate this proceeding because of Unified’s alleged failure to name Apple and Samsung as RPIs. *See* Decision 4 (citing Paper 23, 14–26 (“Patent Owner’s Response” or “PO Resp.”) (confidential)). MemoryWeb argued that, “[a]lternatively, the Board should find that Apple and Samsung are estopped from challenging the validity of claims 1–7 of the ’228 patent in” IPR2022-00031 (as to Apple) and IPR2022-00222 (as to Samsung). *Id.* (quoting PO Resp. 14–15). Unified and MemoryWeb submitted briefing on the RPI issue, and provided additional evidence as Exhibits 1030–1043 and 2027–2047. *See* Paper 29, 22–34 (Petitioner’s Reply) (confidential); Paper 30 (public); Paper 35, 23–27 (Patent Owner’s Sur-Reply) (confidential). The Board held a confidential hearing on the RPI issue. *See* Paper 52 (confidential transcript); Paper 53 (public transcript).

Following the post-institution briefing, submission of additional evidence, and confidential hearing, the Board issued an Order identifying

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Apple and Samsung as RPIs. *See* Decision 5 (incorporating RPI Order). The Board determined that it was appropriate to decide whether Apple and Samsung are RPIs in this proceeding “[b]ecause the issue of Section 315(e) estoppel has been put before us [as relevant to the subsequent IPR challenges filed by Apple and Samsung], and we now have a complete factual record available to fully address the RPI question, and to avoid unnecessary prejudice to Patent Owner.” RPI Order 6.

III. DISCUSSION

In the RPI Order, the Board held “if we do not decide the RPI issue now, as Patent Owner urges, then the underlying purpose of Section 315(e) would potentially be frustrated. Determining whether Apple or Samsung are RPIs in this case is a necessary precursor to determining whether they would be estopped in [] subsequent proceeding[s].” RPI Order 6. Absent an RPI determination, “Patent Owner may have to continue to unnecessarily defend against two subsequent IPR challenges filed by Apple and Samsung should they have been named as RPIs in this case.” *Id.*

The precedential *SharkNinja* decision held that it best serves the Office’s interests in cost and efficiency to not resolve an RPI issue when “it would not create a time bar or estoppel under 35 U.S.C. § 315” in that proceeding. *SharkNinja*, Paper 11, 18. *SharkNinja* further acknowledged that patent owners “should not be forced to defend against later judicial or administrative attacks on the same or related grounds by a party that is so closely related to the original petitioner as to qualify as a real party in interest,” but held that was not the case before the Board. *Id.* at 20 (quoting *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1350 (Fed. Cir. 2018)).

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Petitioner contends that *SharkNinja*'s reasoning should apply here, where neither a time bar nor estoppel applies in this proceeding. *See* Paper 70, 3. Accordingly, Petitioner contends "the panel erred by issuing a non-binding advisory opinion" on RPI, which prejudices Apple and Samsung by "prejudg[ing] the RPI issue without their participation," where that determination could bind Apple and Samsung in their subsequently-filed proceedings. *See id.*

The 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. That is not the situation here. The Board should not have determined whether Apple and Samsung are RPIs in this proceeding given that determination was not necessary to resolve the proceeding.

Accordingly, I vacate the Board's RPI determination in the Final Written Decision (pages 3–5, Section I.B.) and the Board's RPI Order, Paper 56, on which the Final Written Decision's RPI determination is based.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Board's real party in interest determination in the Final Written Decision (Section I.B.) is vacated; and

FURTHER ORDERED that the Board's Order Identifying Real Party in Interest (Paper 56) is vacated.

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