UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC
Petitioner

v.

MEMORYWEB, LLC
Patent Owner

IPR2021-01413
U.S. Patent 10,621,228

PETITIONER'S REPLY IN SUPPORT OF ITS MOTION TO EXPUNGE

I. Introduction

The Board should grant Petitioner's motion to expunge once all rehearings and appeals are exhausted in this case.

The parties agree that the Board should expunge the documents identified in Petitioner's motion (Paper 73) for the reasons set forth therein. *See also* Paper 78 (PO's Opposition, not contesting the merits). The parties also agree that the Board should not expunge those documents until all rehearings and appeals are exhausted in ***this*** case. Paper 73 at 1; Paper 78 at 1.

Patent Owner, however, asks the Board to wait until two other cases are also completed—effectively contending that Patent Owner should be able to use Petitioner's confidential information in those other cases in contravention of the agreed-upon Protective Order. Paper 78 at 1-2. Patent Owner does not point to any authority supporting its position.[1]

The Board should not grant Patent Owner's request and timely grant Petitioner's Motion to Expunge.

[1] Patent Owner did not ask to modify the Protective Order, but if it had, the Board should deny the request. Petitioner willingly disclosed its confidential information in reliance on the agreed-upon Protective Order entered by the Board, and Patent Owner should be held to its agreed-upon obligations.

II. The Board Should Expunge Once All Rehearings and Appeals In *This* Case Are Exhausted

The Board should not delay expungement to allow Patent Owner to use Petitioner's material in other cases. The Protective Order expressly forbids Patent Owner's "use" of Petitioner's protected information in any other cases. Paper 10, Appendix at 1, Exhibit A ("Protective Order"). In particular, Patent Owner's counsel have affirmed that they "have read the Protective Order" and "will abide by its terms," and "will ***use*** [Petitioner's] confidential information ***only in connection with this proceeding and for no other purpose***." Protective Order at 1, Exhibit A.

To be sure, Patent Owner and its outside counsel are forbidden from ***using*** Petitioner's confidential information in any other case, including the Apple and Samsung IPRs (IPR2022-00031, IPR2022-00222), even if they do not disclose any of the information. *See*, *e.g.*, *Jazz Pharms., Inc. v. Amneal Pharms*., LLC, No. 13-cv-391, 2016 U.S. Dist. LEXIS 61373, *5-*7 (D.N.J. Jan. 22, 2016) (finding violations of a protective order which required that confidential information be "used. . . solely for the purposes of this litigation" where a party used the knowledge of the contents from confidential documents to argue for discovery production in a different case); *Errant Gene Therapeutics, LLC v. Sloan-Kettering Inst. for Cancer Research*, No. 15-CV-2044, 2017 U.S. Dist. LEXIS 85962, *7-*9 (S.D.N.Y. June 5,

2017) (finding a similar provision violated when party used confidential information, without disclosing it, to draft a complaint in a different case).

Now having obtained Petitioner's confidential information by agreeing to the Protective Order (Paper 10 at 1), Patent Owner's counsel seeks to shed its agreed-upon obligations with the apparent intent to use and disclose Petitioner's information in two other proceedings. Paper 78 at 1-2. Doing so would contravene the Protective Order and its purpose, i.e., assuring parties that their confidential information will not be misused. And here, Petitioner willingly disclosed its highly sensitive information in reliance on the parties' agreed-upon order. Allowing Patent Owner to vitiate the parties' agreement memorialized in the Protective Order would be unjust and would discourage future parties from voluntarily disclosing their confidential information.

Patent Owner does not cite any authority supporting its request. Patent Owner cites *Unified Patents Inc. v. Cellular Communications Equipment LLC et al.* (IPR2018-00091, Paper 37) ("CCE"), but that case did not allow one party to use the other's confidential information in other proceedings despite a provision forbidding such use. And unlike here, the information preserved indefinitely (but not made public) in *CCE* "relate[d] to a decision made by the Board." *CCE* at 9. In contrast, Petitioner's confidential information in this case is not related to any Board decision or Order. The Director vacated the RPI Order (Paper 56) and the portion of the final

written decision referring to the Order. *See* Paper 74. Petitioner's confidential information is now unrelated to the merits and all other findings in this proceeding.

Patent Owner also argues that "this proceeding's confidential record may be the only source" of relevant information in two other proceedings. Paper 78 at 2. Not so. The Board's rules provide for timely discovery between parties, and when justified, third-party discovery via a motion to compel and application for a court-issued subpoena. 35 U.S.C. § 24; 37 C.F.R. § 42.52; *CQV Co., Ltd. v. Merck Patent GMBH*, PGR2021-00054, Paper 36 at 6 (Mar. 2, 2022) ("determine[ing] that any additional discovery sought from a real party-in-interest that is not a named party in the proceeding must be pursued in the same manner provided for seeking discovery from any other nonparty, i.e., by compelling such discovery pursuant to a subpoena issued by a United States District Court."). Indeed, the Board has recognized as much in the two cases where Patent Owner seeks to use Petitioner's confidential information—ordering MemoryWeb to request additional discovery. *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031, Paper 45 (June 15, 2023) and *Samsung Elecs. Co., Ltd. v. MemoryWeb, LLC*, IPR2022-00222, Paper 38 (June 15, 2023).

At bottom, Patent Owner seeks to delay expungement for purposes that contravene the Protective Order. Patent Owner did not provide any viable basis for its requested delay. The Board should deny Patent Owner's request.

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