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Subject: IPR2021-01413; IPR2022-00031; IPR2022-00222 -- Proposal on further proceedings

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Your Honors,

Petitioner Apple Inc. requests a conference call to discuss the conduct of the proceedings in IPR2022-00031 in light of the Board's order finding good cause to extend the deadline for providing the final written decision in this proceeding. Apple has consulted with counsel for MemoryWeb, Samsung and Unified Patents, and includes the positions of those parties on Apple's proposals below. The parties are available for a call next week on Wednesday (5/17) between 3-5 eastern, Thursday (5/18) between 2 and 4 pm eastern, and Friday (5/19) between 9:30 and 10:30 am.

Sincerely,

Jeff Kushan
Counsel for Petitioner Apple Inc. (IPR2022-00031)

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Apple Proposals and Position:

Initially, paper 41 in IPR2022-00031 does not accurately represent Apple's position. Apple's position has been that MemoryWeb has waived its ability to raise an RPI issue in the -00031 proceeding, and that it would be improper for the Board to consider a new RPI issue (which would, *inter alia*, require related discovery) at this stage of the -00031 proceeding. Apple does, however, agree that good cause exists for extending the deadline to issue the final written decision in the -00031 proceeding.

In view of the Board's May 4, 2023 order and after further consideration, Apple submits there are only two appropriate options for proceeding in IPR2022-00031.

Option A: The Board should issue an order in the -00031 proceeding requiring MemoryWeb to show good cause why, at this phase of the proceeding, MemoryWeb has not waived or forfeited its ability to present an argument based on its assertion that a real-party-in-interest relationship exists between Apple and Unified Patents. This briefing can be conducted pending disposition of the rehearing and Director review requests in IPR2021-01413. If the Board proceeds on this course, Apple proposes that MemoryWeb be given a 6,500 word brief to respond to the order, and that Apple be given a 6,500 word response to MemoryWeb's brief.

Option B: Pursuant to either the Board's authority under, *inter alia*, 35 U.S.C. § 315(c) and (d), 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.122(a), or pursuant to the Director's review authority, the Board should *sua sponte* join IPR2022-00031 and IPR2021-01413,

provided the FWD and the RPI Order (Paper 56) in IPR2021-01413 are first vacated. To be clear, Apple submits that joinder would be appropriate only if the FWD and RPI Order in the -1413 proceeding (for which rehearing/review requests are pending) are vacated. Joining the proceedings would render it unnecessary for the Board to resolve any potential 35 U.S.C. § 315(e)(1) estoppel or RPI issue concerning Apple because one FWD would issue in a joined proceeding that addresses both proceedings, thereby rendering both issues moot.

Apple also does not oppose Samsung's alternative to Apple's Option B, provided that the Board vacate the FWD and RPI orders in IPR2021-01413 and then simultaneously issue final written decisions in at least IPR2022-00031 (Apple v. MemoryWeb) and IPR2021-01413 (Unified v. MemoryWeb).

Finally, Apple opposes Samsung's Option C (below). Apple believes that Options A and B provide the most appropriate vehicles for addressing the issue raised by MemoryWeb's original request, and avoids the Board having to resolve the disagreements among the parties about whether and how access to the confidential portions of the Unified record may be made accessible to entities that are not party to the Unified v. MemoryWeb proceeding.

Unified Patents position:

Unified does not have an alternative proposal, and takes no position regarding "Option A."

Unified does not oppose Apple's originally proposed "Option B." Unified, like Apple, considers joinder acceptable only if the FWD and the RPI Order Paper 56 are first vacated. Unified maintains that the RPI Order and the portion of the FWD discussing the RPI Order should be vacated for the reasons it explained in its requests for rehearing, POP Review (of the Order), and Director Review (of the FWD).

As for Samsung's alternative Option B, Unified agrees that the RPI Order and the portion of the FWD discussing the RPI Order should be vacated. Unified does not see any need for an extension even if its FWD is vacated for the same reasons the Board does not need to extend the time for a FWD when any other FWD is vacated on rehearing, POP Review, or Director Review. Unified otherwise agrees, however, that this option avoids complications associated with merging three proceedings with records that were fully developed independently.

Unified opposes Samsung's Option C for the reasons explained in the Joint Email to the Board (Ex. 3003 in Unified's IPR2021-01413). In short, such an inspection is unprecedented and impermissible under the Trial Practice Guide and the Protective Order. Further, such an inspection is by definition, discovery—it is a document production. There is no mechanism in the Board's rules for non-parties to take such discovery. Permitting such an inspection would threaten the fundamental safeguards inherent in the Board's discovery rules.

Samsung Position:

As to Option A, Samsung endorses the procedure set forth in Apple's proposal and submits that a similar briefing schedule on waiver should be entered in IPR2022-00222.

As to Option B, Samsung agrees that the FWD and the RPI Order (Paper 56) in IPR2021-01413 should be vacated. However, as an alternative to joinder, Samsung would prefer for Unified's IPR to be extended for good cause and placed on the same schedule as the recently extended Samsung and Apple IPRs. With that extension, the schedules of the three proceedings against MemoryWeb's '228 Patent can be aligned and final written decisions can be entered concurrently in each of the three proceedings, thereby allowing all issues on the prior art and RPI to be resolved at the same time based on insights gained through discovery and briefing that accounts for Samsung/Apple evidence/positions, in contrast to the earlier decision rendered in -01413 that was devoid of the same. This approach is similar to proposed Option B, but through it, separate proceedings would be maintained to avoid complications related to merging three separate proceedings with separate records and separate petitions.

Also, as an additional Option C, Samsung renews its previously communicated proposal that would allow Samsung and Apple to inspect the record in the -01413 proceeding prior to endorsing a proposal for additional procedures. As previously communicated, Samsung believes that "inspection" of the record of the Unified IPR proceeding is necessary to allow Samsung to offer fully informed thoughts on the extent (e.g., scope, timing, cadence) of process needed to ensure that Samsung is provided a full and fair opportunity to address implicated issues.

MemoryWeb position:

MemoryWeb asserts that this email submission is untimely and unnecessary, as the parties previously submitted their positions in the April 7, 2023, email requested by the Board. In that email, Apple and Samsung made similar requests to those made again here, including raising issues of waiver and vacatur. None of the Petitioners in these proceedings have provided any basis for this new submission (Apple's purported basis is the recent finding of good cause existing to extend the FWD deadlines without explaining how that requires simply re-submitting previous positions set forth for the Board). With Apple and Samsung making the same requests again, MemoryWeb maintains its requests for authorization to file motions to terminate in the Apple and Samsung proceedings as indicated in the parties' April 7 email.

With respect to the Petitioners' "Options" discussed above, MemoryWeb provides the following positions:

Consistent with its positions set forth in the April 7, 2023, email, MemoryWeb opposes the waiver issues and vacatur issues and therefore opposes Option A, Option B, and Samsung's Modified Option B.

Option A: MemoryWeb has previously explained that Apple's assertion of waiver lacks merit for various reasons, including but not limited to, the following: (i) waiver is only properly raised as a defense to a claim and, accordingly, to the extent Apple raises a waiver argument, it is only appropriate to do so in response to MemoryWeb's motion to terminate; and (ii) Apple cites no authority for the proposition that waiver has occurred here especially in light of Apple's knowledge of the co-pending Unified Patents proceeding.

Option B and Samsung's Modified Option B: MemoryWeb similarly opposes Option B as at least untimely and procedurally unfounded (to the extent the Board grants certain briefing on these issues).

Option C: As previously indicated to the Board, MemoryWeb does not oppose allowing Apple and Samsung to inspect the record in the Unified Patents proceeding prior to endorsing a proposal for additional proceedings.

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