

PUBLIC VERSION

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571-272-7822

Paper 67
Entered: April 5, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2021-01413
Patent 10,621,228 B2

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

TROCK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner, Unified Patents, LLC (“Unified”), has shown by a preponderance of the evidence that claims 1–7 (the “challenged claims”) of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 Patent”) are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

A. Procedural History

The Petition (Paper 2, “Pet.” or “Petition”) requested *inter partes* review of the challenged claims of the ’228 Patent. Patent Owner, MemoryWeb, LLC, filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply (Paper 11), and Patent Owner filed a Preliminary Sur-reply (Paper 12). Based upon the record at that time, we instituted *inter partes* review on all challenged claims on the grounds presented in the Petition. Paper 15 (“Institution Decision” or “Dec.”).

After institution, Patent Owner filed a Response (Paper 23, “PO Resp.”), Petitioner filed a Reply (Paper 29, “Pet. Reply”), Patent Owner filed a Sur-reply (Paper 35, “PO Sur-reply”), and with our authorization, Petitioner filed a Sur-sur-reply (Paper 42, “Pet. Sur-sur-reply”).

Petitioner filed a Motion to Exclude certain evidence (Paper 44). Patent Owner opposed the motion (Paper 45).

On December 16, 2022, an oral hearing was held. The hearing comprised a confidential session and a public session. A transcript of the

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hearing was made a part of this record. Paper 52 (confidential session), Paper 53 (public session).

B. Real Party-in-Interest

In the Petition, Petitioner stated that “[p]ursuant to 37 C.F.R. § 42.8(b)(1), Unified Patents, LLC . . . certifies that Unified is the real party-in-interest and certifies that no other party exercised control or could exercise control over Unified’s participation in this proceeding, filing this petition, or conduct in any ensuing trial.” Pet. 1.

In its Preliminary Response, Patent Owner argued that “Apple and Samsung¹ should have been [named] as RPIs [(real parties in interest)] in this proceeding, and the failure to identify Apple and Samsung is a basis for the Board to deny institution.” Prelim. Resp. 28; *see also id.* at 22–28.

As noted above, we authorized additional preliminary briefing to allow the parties to address RPI issue, as well as other issues. Ex. 1020. In its Preliminary Reply, Petitioner argued that “Patent Owner’s (PO’s) RPI arguments should be rejected as inappropriate or, at best, premature. As is the case here, the Board need not address whether a party is an unnamed RPI where no time bar or estoppel provisions under 35 U.S.C. § 315 are implicated.” Paper 11, 1 (citing *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (PTAB, Oct. 6, 2020) (precedential)

¹ We infer from the record that Patent Owner is referring to Samsung Electronics Co., Ltd. (“Samsung”) and Apple, Inc. (“Apple”) based on the petitions filed by these companies challenging the ’228 patent. *See* Sec. C, below.

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(“*SharkNinja*”); *Unified Patents, LLC v. Fat Statz, LLC*, IPR2020-01665, Paper 19 at 2–3 (PTAB, Apr. 16, 2021).

Based upon the preliminary record at that time, we instituted *inter partes* review on all the challenged claims on the grounds presented in the Petition, but declined to determine whether Apple and Samsung were real parties in interest. Dec. 15. We declined to decide the real party in interest question at that time partly because determining whether a non-party is an RPI is a highly fact-dependent question and the case was still in its preliminary stage without a fully developed factual record. Moreover, we determined that we need not address the RPI issue at that time because there was no allegation that Apple or Samsung were subject to a time bar or estoppel that would preclude *this* proceeding. Accordingly, under the Board’s precedential decision in *SharkNinja*, IPR2020-00734, Paper 11 at 18, we declined to decide the RPI issue at that time. *See* Paper 15, 11–14.

After institution, Patent Owner raised the RPI issue again, arguing in its Response that

the Board should terminate this proceeding because Petitioner has failed to name all real parties-in-interest (“RPIs”), including at least Samsung and Apple. Alternatively, the Board should find that Apple and Samsung are estopped from challenging the validity of claims 1–7 of the ‘228 patent in related proceedings: *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 (the “Apple IPR”) and *Samsung Electronics Co., Ltd., v. MemoryWeb, LLC*, IPR2022-00222 (the “Samsung IPR”) (collectively, the “Related IPRs”).

PO Resp. 14–15.

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Given that we now had a fully-developed factual record before us, including probative evidence on the RPI issue that was not available to us at the institution phase of this case,² and the parties have been able to argue this issue before the Board during a confidential session of the hearing in this proceeding (*see* Paper 52), we were able to fully address the real party in interest issue raised by Patent Owner in its Response. Accordingly, based upon the complete evidentiary record and the parties' arguments, we issued an Order on March 8, 2023, (Paper 56) identifying Apple and Samsung as RPIs in this proceeding and instructing Petitioner to "update its Mandatory Notices by March 10, 2023, identifying all Real Parties in Interest consistent with this Order pursuant to its obligations under 37 C.F.R. § 42.8(b)(1)." *See* Paper 56, 34.

C. Related Matters

According to the parties, the '228 patent was asserted in the following district court proceedings: *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 6:21-cv-00411 (W.D. Tex.); *MemoryWeb, LLC v. Apple Inc.*, Case No. 6:21-cv-00531 (W.D. Tex.); and *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, Case No. 1:21-cv-02666 (N.D. Ill.). Pet. 1–2; Paper 4, 2; Paper 7, 2; Paper 9, 2–3.

Patent Owner also identifies U.S. Patent No. 9,098,531 ("the '531 patent"), U.S. Patent No. 10,423,658 ("the '658 patent"), U.S. Patent No. 9,552,376 ("the '376 patent"), U.S. Patent No. 11,017,020 ("the '020

² Since institution, the parties supplemented the record with Exhibits 1030–1043 and 2027–2047, which included the deposition transcript of the CEO of Unified (Ex. 2036), as well as other relevant evidence on this issue.

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