

From: [Hayes, Jennifer](#)
To: [Kushan, Jeffrey P.](#); [Schwartz, Daniel](#)
Cc: [Werber, Matthew](#); [Girgis, Diana](#); [Mahoney, Matthew](#); "steve.baughman@groombridgewu.com"; [Christopher, Angelo](#); [Fougere, Josh](#)
Subject: RE: IPR2022-00031 - Meet and Confer
Date: Thursday, June 08, 2023 4:13:48 PM
Attachments: [image001.png](#)

Jeff,

As Dan indicated, we are available at 2:30pm PT/5:30 pm ET for the proposed meet and confer.

We strongly disagree that MemoryWeb has engaged in any dilatory conduct. We promptly raised the issue of estoppel with Apple as soon as the issue arose. The RPI issues are only relevant to the estoppel/termination; accordingly, the RPI discovery issue only arose when estoppel arose. MemoryWeb was not “unquestionably late.” Rather, it timely raised these issues with you and the Board. The Board has further acknowledged the unprecedented circumstances of these proceedings, which required clarification from the Director on the Board’s procedures on the RPI issue.

First, your email raises the issue of forfeiture; the Board’s Order only contemplated waiver – not forfeiture. Second, we don’t understand the basis of your forfeiture argument. Please identify any cases that support your position that forfeiture is relevant to these proceedings or that MemoryWeb has the burden of proof on that issue. Third, your email refers to rules governing the belated raising of issues but failed to identify what those rules. Please identify the referenced rules.

Please let us know your position on the Protective Order as we would like to include that Protective Order with the subpoena to Unified; the Protective Order is the same Protective Order entered in the Unified IPR.

While we believe our initial proposal is appropriate and reserve all rights to raise that proposal in its original form to the Board, below we provide an alternative proposal in the interest of compromise and for our discussion:

- First Phase of Briefing
 - Due Date 1: Two weeks from Board’s Order following joint proposal
 - MemoryWeb’s Brief on Additional Discovery and Document and Testimony Subpoena to Unified Patents
 - Apple’s Brief on Forfeiture
 - Due Date 2: Two weeks after Due Date 1
 - Apple’s Response to MemoryWeb’s Brief on Additional Discovery and Subpoena to Unified Patents (to the extent Apple intends to oppose the Motions)
 - MemoryWeb’s Response to Apple’s Brief on Forfeiture
- Second Phase of Briefing
 - Due Date 3: Within 7 days of Board Order on the First Phase of Briefing or by August 9, whichever is earlier
 - MemoryWeb will file as exhibits in this proceeding the non-confidential exhibits in IPR2021-01413 pertaining to RPI
 - If a deposition of a Unified witness is conducted, Apple shall be entitled to participate and separately examine the witness after MemoryWeb has completed its examination; the parties agree to negotiate with Unified in good faith regarding the production of documents and deposition scheduling and scope
 - Apple will produce to MemoryWeb responsive non-privileged documents as follows: (i) all communications with Unified relating to MemoryWeb, the ‘228 patent, the Unified IPR, or this IPR (IPR2022-00031); and (ii) all agreements or contracts between Apple and Unified, including Apple’s membership agreement and any amendments or add-ons
 - Apple may provide a declaration from a witness familiar with the documents it is producing. MemoryWeb would be allowed a 4 hour deposition of that witness
 - Due Date 4: Within 14 days of completion of authorized discovery from Apple and Unified Patents
 - MemoryWeb’s Motion to Terminate
 - MemoryWeb serves its motion for relief will address at least: (1) estoppel under 35 U.S.C. § 315(e) (1) as to claims 1-7, including addressing Apple’s RPI status in the Unified IPR, and (2) discretionary estoppel based on at least 35 U.S.C. § 315(d), 37 CFR § 42.72, and 37 CFR § 42.5 as to claims 8-19. The brief will be limited to 30 pages
 - Due Date 5: Within 14 days of MemoryWeb’s Motion to Terminate
 - Apple Response to Motion to Terminate
 - Apple’s brief will also be limited to 30 pages and cannot raise waiver or forfeiture

- If Apple submits declaration, Apple will make declarant available within 7 days
- Due Date 6: Within 14 days of Apple's Response to MemoryWeb's Motion to Terminate
 - MemoryWeb Reply in Support of Motion to Terminate
 - MemoryWeb's brief will be limited to 12 pages
- Motions to Exclude
 - Due Date 7: Two weeks before oral hearing
 - Motions to Exclude (if any)
 - Due Date 8: One week before Oral Hearing
 - Opposition to Motions to Exclude (if any)
- Oral Hearing
 - Due Date 9: At the Board's convenience prior to the statutory deadline

Jennifer



Jennifer Hayes

Partner

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From: Kushan, Jeffrey P. <jkushan@sidley.com>

Sent: Thursday, June 8, 2023 11:34 AM

To: Hayes, Jennifer <jenhayes@nixonpeabody.com>; Schwartz, Daniel <djschwartz@nixonpeabody.com>

Cc: Werber, Matthew <mwerber@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>; Mahoney, Matthew <mmahoney@sidley.com>; 'steve.baughman@groombridgewu.com' <steve.baughman@groombridgewu.com>; Christopher, Angelo <achristopher@nixonpeabody.com>; Fougere, Josh <jfougere@sidley.com>

Subject: RE: IPR2022-00031 - Meet and Confer

Hi Jennifer and Dan,

Could you please respond to my email from this morning regarding a conference to discuss what we provide to the Board tomorrow? I am still available between 3 and 6 pm eastern.

Thanks,

Jeff

JEFFREY P. KUSHAN

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From: Kushan, Jeffrey P.

Sent: Thursday, June 8, 2023 8:43 AM

To: 'Hayes, Jennifer' <jenhayes@nixonpeabody.com>; 'Schwartz, Daniel' <djschwartz@nixonpeabody.com>

Cc: 'Werber, Matthew' <mwerber@nixonpeabody.com>; 'Girgis, Diana' <dgirgis@nixonpeabody.com>; Mahoney, Matthew <mmahoney@sidley.com>; 'steve.baughman@groombridgewu.com'

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Subject: RE: IPR2022-00031 - Meet and Confer

Jennifer and Dan,

In view of the panel's mandate for us to provide a joint submission on further conduct of the proceedings by tomorrow, I suggest we set up a call today. I am available other than 1-3 eastern. Maybe sometime between 3 and 6 pm eastern? Let me know if a time in that window would work for you.

Jeff

JEFFREY P. KUSHAN

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From: Kushan, Jeffrey P.
Sent: Wednesday, June 7, 2023 8:30 PM
To: 'Hayes, Jennifer' <jenhayes@nixonpeabody.com>; Schwartz, Daniel <djschwartz@nixonpeabody.com>
Cc: Werber, Matthew <mwerber@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>; Mahoney, Matthew <mmahoney@sidley.com>; 'steve.baughman@groombridgewu.com' <steve.baughman@groombridgewu.com>; Christopher, Angelo <achristopher@nixonpeabody.com>; Fougere, Josh <jfougere@sidley.com>
Subject: RE: IPR2022-00031 - Meet and Confer

Counsel,

In its order, the panel did not endorse any particular course of conduct in this proceeding, nor did it suggest that MemoryWeb need not comply with the rules governing the belated raising of issues or requests for additional discovery. Moreover, and contrary to your assertions, the issue that MemoryWeb is belatedly attempting to raise in this proceeding and prove via additional discovery is that Apple is an RPI of Unified in IPR2021-01413. Without that predicate, the earlier issuance of a final written decision in the Unified Proceeding is legally irrelevant.

MemoryWeb is unquestionably late in raising the RPI issue, in seeking to introduce new evidence and in seeking authorization for additional discovery. For example, by January of 2022, MemoryWeb possessed much of the evidence that it now seeks to introduce in this proceeding. In May of 2022 (the same month trial was instituted in this proceeding), MemoryWeb took the deposition of Mr. Jakel. Under the Board's rules and practices, MemoryWeb must establish that good cause exists for it to belatedly seek the relief it is pursuing, and must establish its attempt to provide supplemental information and to obtain additional discovery now (after final argument and submission of the case to the Board for decision) serves the interests of justice. See, e.g., 37 CFR 42.5(c)(3), 42.12(a), 42.25(b), 42.123(b). These are burdens MemoryWeb must satisfy as a condition precedent of being authorized to move for relief, introduce additional evidence or seek additional discovery. If MemoryWeb fails to meet its burdens, the additional discovery and briefing it is proposing would be moot.

We do not agree with your proposed schedule. In it, you allocate unrealistically short deadlines for Apple to respond and provide MemoryWeb with an unwarranted final brief in each phase. Apple has already been materially prejudiced by MemoryWeb's dilatory conduct in this proceeding. MemoryWeb also has an unfair advantage by its familiarity with numerous exhibits containing confidential information as well as the unredacted vacated RPI order in the Unified Proceeding. MemoryWeb's self-serving schedule ignores both points, causes additional prejudice to Apple and is entirely unacceptable.

We also oppose entry and use in this proceeding of the deposition transcript of Kevin Jakel. Apple was not

able to participate in that deposition or examine the witness independently, and even to this date has no knowledge of Mr. Jakel's testimony or its putative significance to the RPI issue in IPR2021-01413. Apple would suffer additional prejudice if that testimonial evidence were used in this proceeding. If MemoryWeb wishes to introduce testimony from a Unified witness, it may only do that through a deposition of that witness in Apple's presence and which provides Apple the ability to independently examine the witness. Apple also does not waive, and indeed expressly reserves, the right to pursue all other rights and objections -- including, by way of example only, that the transcript taken in IPR2021-01413 would be inadmissible hearsay in this proceeding.

Nonetheless, if Memory agrees to the structure of the proposed schedule below (which includes a threshold issue briefing phase), and if the Board subsequently decides that additional discovery and briefing is warranted, Apple will (subject to its objections) voluntarily produce responsive non-privileged documents MemoryWeb is seeking from Apple and will not oppose third party discovery of a Unified witness and documents. Apple also would not oppose MemoryWeb initiating attempts to secure authorization for a deposition of a Unified witness independent of the briefing schedule set forth below, with the understanding that any such deposition would only proceed if the Board finds discovery warranted and occurs during the period authorized for discovery (e.g., August).

Proposed Schedule:

June 30: MemoryWeb files a brief not exceeding 7500 words that sets forth (i) why good cause exists for it to raise the RPI issue at this stage of the proceeding pursuant to 37 CFR 42.5(c)(3) and 42.25(b), (ii) why the late consideration of supplemental information MemoryWeb possessed before this proceeding was instituted serves the interests of justice pursuant to 37 CFR 42.123(b), (iii) why MemoryWeb's request for additional discovery serves the interests of justice pursuant to 37 CFR 42.51(b)(2)(i), and (iv) why MemoryWeb has not otherwise forfeited its ability to raise the RPI issue at this stage in the proceeding.

July 21: Apple files a response not to exceed 7500 words.

August 4 (estimate): If the Board finds that MemoryWeb has met its burdens, then the following briefing schedule would apply after such a finding, with the assumption that the Board will set a deadline for completion of discovery of August 21)

- Within 3 days of the Board's order (approximately August 7)
 - o MemoryWeb will file as exhibits in this proceeding the non-confidential exhibits in IPR2021-01413 pertaining to RPI.
 - o MemoryWeb may pursue a third party deposition of a Unified employee. If a deposition is conducted, Apple shall be entitled to participate and separately examine the witness after MemoryWeb has completed its examination.
 - o MemoryWeb may pursue third party discovery of confidential documents in IPR2021-01413.
 - o Apple will produce to MemoryWeb responsive non-privileged documents as follows: (i) all communications with Unified relating to MemoryWeb, the '228 patent, the Unified IPR, or this IPR (IPR2022-00031); and (ii) all agreements or contracts between Apple and Unified, including Apple's membership agreement and any amendments or add-ons.
 - o Apple may provide a declaration from a witness familiar with the documents it is producing. MemoryWeb would be allowed a 4 hour deposition of that witness.
- Within 4 days of the deadline set for completion of discovery (e.g., August 25), MemoryWeb serves its motion for relief addressing (i) why it believes Apple is an RPI of Unified in IPR2021-01413, and (ii) why Apple should be estopped from participating in this proceeding. The brief will be limited to 7500 words.
- Within 28 days of service of MemoryWeb's motion for relief (e.g., Sept 22), Apple serves its opposition. Apple's brief will also be limited to 7500 words.

- Within 30 days of completion of briefing, the Board conducts an oral hearing on the issues raised in the briefing (e.g., [October 20](#)).

[November 20, 2023](#): FWD deadline.

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From: Hayes, Jennifer <jenhayes@nixonpeabody.com>
Sent: Tuesday, June 6, 2023 1:38 PM
To: Kushan, Jeffrey P. <jkushan@sidley.com>; Schwartz, Daniel <djschwartz@nixonpeabody.com>
Cc: Werber, Matthew <mwerber@nixonpeabody.com>; Girgis, Diana <dgirgis@nixonpeabody.com>; Mahoney, Matthew <mmahoney@sidley.com>; 'steve.baughman@groombridgewu.com' <steve.baughman@groombridgewu.com>; Christopher, Angelo <achristopher@nixonpeabody.com>; Fougere, Josh <jfougere@sidley.com>
Subject: RE: IPR2022-00031 - Meet and Confer

Jeff:

We confirm MemoryWeb still intends to file a motion to terminate IPR2022-00031 as set forth in our March 14, 2023 and April 7, 2023 emails. We also confirm that MemoryWeb intends to seek discovery from Unified and Apple as contemplated in the Board's May 30, 2023 Order and requested in our April 7, 2023 email.

Pursuant to the Board's Order, MemoryWeb proposes the following discovery plan and briefing schedule:

MemoryWeb's Proposed Discovery Plan

First, MemoryWeb seeks an order from the Board permitting MemoryWeb to apply for a subpoena to Unified Patents, LLC ("Unified") pursuant to 35 U.S.C. § 24 seeking documents and testimony from IPR2021-01413 ("the Unified IPR") relating to the real-party-in-interest ("RPI") issue. Specifically, the subpoena would seek the following documents and testimony from Unified:

1. Unified documents that MemoryWeb and/or the Board cited in the Unified IPR, including Exs. 2011, 2015, 2016, 2017, 2018, 2027, 2028, 2029, 2032, 2033, 1024, 1025, 1027, and 1029 in the Unified IPR;
2. The Declaration of Kevin Jakel dated Sept. 2, 2021 (Ex. 1017 in the Unified IPR). If Apple

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