Filed: July 14, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

Case No. IPR2022-00031
U.S. Patent No. 10,621,228

PETITIONER'S RESPONSE TO PATENT OWNER'S OPENING BRIEF ON GOOD CAUSE, SUPPLEMENTAL INFORMATION, AND ADDITIONAL DISCOVERY

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I. INTRODUCTION

MemoryWeb's opening brief largely ignores the two requirements that it must satisfy here. It does not show that good cause exists to excuse its intentional delay in raising real-party-in-interest ("RPI") and estoppel arguments, nor does it show that the late submission of evidence—possessed more than a year before this proceeding was instituted—serves the interests of justice. The Board should deny MemoryWeb's improper attempt to raise new arguments and introduce new evidence at this late stage of the proceeding.

II. ARGUMENT

A. MemoryWeb Has Not Met Its Burden to Show Good Cause For Its Late Action and Delay.

To excuse its intentional delay in raising RPI and estoppel arguments in this proceeding, MemoryWeb must establish "good cause or that consideration on the merits would be in the interests of justice." 37 C.F.R. § 42.5(c)(3). Its opening brief does not come close to doing so.

1. MemoryWeb Did Not Timely Raise RPI or Estoppel.

MemoryWeb claims it complied with 37 C.F.R. § 42.25(b) because it sought relief "promptly" after the Final Written Decision ("FWD") issued in IPR2021-01413 ("*Unified*"). Paper 47, 10 ("MW Br."). MemoryWeb, however, misunderstands what issues it was required to raise "promptly" (RPI and estoppel)

and when it was required to do so (before filing its Patent Owner Response ("POR")).

Issuance of the *Unified* FWD, standing alone, cannot create estoppel under 35 U.S.C. § 315(e)(1)—it requires a predicate finding that an RPI relationship exists between a petitioner (Apple) and the petitioner in an earlier proceeding (Unified Patents). Without that predicate finding—which does not exist in light of the Director's Decision in *Unified* (EX2038)—the FWD in *Unified* is irrelevant to this proceeding. *See* Paper 46 ("Apple Br."), § III.B.1.

MemoryWeb knows this—it said as much in *Unified* and IPR2022-00222 ("*Samsung*"):

- In *Unified*, MemoryWeb stated on June 6, 2022, that "***[i]f*** (1) this IPR results in a final written decision ***and (2) Apple and Samsung are RPIs*** (which they are), Apple and Samsung would be estopped from maintaining their IPRs against claims 1-7 of the '228 patent. 35 U.S.C. § 315(e)(1)." *Unified*, POR, Paper 23, 16 (emphases added).
- In *Samsung*, MemoryWeb stated on September 6, 2022, that "***[s]hould*** the Board determine in a final written decision that ***Samsung is an unnamed RPI*** in the Unified IPR, Samsung should be estopped from maintaining the present IPR challenge under Section 315[e](1). *Samsung*, POR, Paper 19, 64 (emphases added).

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