

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00031
Patent 10,621,228 B2

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

TROCK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

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Petitioner, Apple, Inc. (“Apple” or “Petitioner”), filed a petition requesting *inter partes* review of claims 1–19 of U.S. Patent No. 10,621,228 B2 (“the ’228 patent”). Paper 1. On May 20, 2022, the Board instituted trial. Paper 12.

In a related proceeding challenging claims 1–7 of the ’228 patent, *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413 (the “*Unified* proceeding”), the Board entered an Order (Paper 56 (confidential)) on March 8, 2023, identifying Apple as an unnamed Real Party in Interest (“RPI”), and on March 14, 2023, entered a Final Written Decision (Paper 58 (confidential)) finding claims 1–7 unpatentable.

Patent Owner, MemoryWeb, LLC (“MemoryWeb” or “Patent Owner”) seeks leave to file a motion to terminate this proceeding in view of the Board’s Final Written Decision in the *Unified* proceeding. Ex. 3002, 1. Apple opposes Patent Owner’s request, and asserts that MemoryWeb has waived the RPI and estoppel issues in this proceeding. *Id.* at 2.

On May 22, 2023, the Director issued a public version¹ of a Decision Granting Director Review (Paper 76, “Director’s Decision”) in the *Unified* proceeding, vacating-in-part the Final Written Decision (Section I.B) (Paper 58 (confidential) and Paper 67 (public)) and the Board’s Order identifying Apple as an RPI (Paper 56 (confidential)) in that proceeding.

On May 30, 2023, the Board issued an Order directing the parties to confer and submit a proposed joint briefing schedule and discovery plan to address the RPI, estoppel, and waiver issues in this proceeding. Paper 43.

¹ On May 16, 2023, a confidential version of the Director’s Decision Granting Director Review (Paper 74) was issued, but made available only to the parties and the Board.

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The parties submitted their joint proposal to the Board by email on June 9, 2023. Ex. 3005.

On June 15, 2023, the Board entered an Order setting a briefing schedule for the parties to file briefs addressing the topics set forth in Exhibit 3005, First Phase. Paper 45.

After considering the parties' arguments in their briefs (Papers 46–49), we determine that good cause exists to grant Patent Owner's request for discovery on the RPI issue in this case. The reasons for this determination include, but are not limited to, the nature of the issues in this case, the procedural history of this case, the Director's Decision (Papers 74, 76) vacating-in-part the Final Written Decision (Section I.B) (Paper 58 (confidential) and Paper 67 (public)) and the Board's Order identifying Apple as an RPI (Paper 56 (confidential)) in the *Unified* proceeding, the statement in the Director's Decision that "[t]he Board can and should make a determination of the real parties in interest or privity in any proceeding in which that determination may impact the underlying proceeding, for example, but not limited to, a time bar under 35 U.S.C. § 315(b) or an estoppel under 35 U.S.C. § 315(e) that might apply," and the grant of a good cause extension of time in this proceeding by the Chief Administrative Patent Judge (Paper 41) to allow time for additional discovery and to consider a motion to dismiss this proceeding prior to issuing a Final Written Decision.

Moreover, given that a determination of the real parties in interest issue may impact this proceeding pursuant to at least 35 U.S.C. § 315(e), it is hereby ORDERED that

- (1) by August 21, 2023 (Due Date 3)**, MemoryWeb will file as exhibits in this proceeding the non-confidential exhibits filed in the *Unified* proceeding (IPR2021-01413) relevant to the RPI issue. Apple will produce to MemoryWeb responsive non-privileged documents as follows: (i) all communications with Unified Patents relating to MemoryWeb, the '228 patent, the *Unified* proceeding, or this IPR (IPR2022-00031); and (ii) all agreements or contracts between Apple and Unified Patents, 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 is allowed a 4-hour deposition of that witness. If a deposition of a Unified Patents' witness is conducted, Apple shall be entitled to participate and examine the witness after MemoryWeb has completed its examination. The parties will negotiate with Unified Patents in good faith regarding the production of documents, deposition scheduling and scope. Any deposition of a witness shall be conducted on a date acceptable to the parties and the witness, notwithstanding Due Date 3.

- (2) by August 31, 2023 (Due Date 4)**, MemoryWeb may file a Motion to Terminate (“Motion”) of up to 7000 words. MemoryWeb’s Motion may 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* proceeding, 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.
- (3) by September 14, 2023 (Due Date 5)**, Apple may file a response to MemoryWeb’s Motion of up to 7,000 words. If Apple submits a declaration after Due Date 4, Apple will make the declarant available for a deposition within 7 days of Due Date 5. MemoryWeb may file a Motion for Observations on the cross examination of the witness (not to exceed 1,000 words) within 7 days of the deposition.
- (4) by September 28, 2023 (Due Date 6)**, MemoryWeb may file a reply to Apple’s response brief not to exceed 3,500 words. Each party may also file a Motion to Exclude.
- (5) by October 6, 2023 (Due Date 7)**, each party may file an opposition to the other party’s Motion to Exclude (if any).
- (6) an Oral Hearing** on the subject matter addressed by the parties’ briefing and any attendant motions shall be held by video-conference on **October 13, 2023 (Due Date 8), at 1:00 pm Eastern time**. Each party shall have 1 hour (60 minutes) to address the relevant issues and may reserve an appropriate amount of time for rebuttal.

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