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Paper 56
Entered: March 8, 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*.

ORDER
Identifying Real Party in Interest
37 C.F.R. §§ 42.5, 42.8

A. Background

Petitioner, Unified Patents, LLC, filed a Petition (Paper 2, "Pet." or "Petition") to institute *inter partes* review of claims 1–7 ("the challenged claims") of U.S. Patent No. 10,621,228 B2 (Ex. 1001, "the '228 patent"). The Petition states that "[p]ursuant to 37 C.F.R. § 42.8(b)(1), Unified Patents, LLC ("Unified" or "Petitioner") 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.

Patent Owner, MemoryWeb, LLC, filed a Preliminary Response. Paper 8 ("Prelim. Resp."). In its Preliminary Response, Patent Owner argued that "Apple and Samsung[1] 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 pursuant to 35 U.S.C. § 312." Prelim. Resp. 28; *see also id.* at 22–28.

We authorized additional preliminary briefing to allow the parties to address this issue, as well as other issues. Ex. 1020. Petitioner subsequently filed a Preliminary Reply (Paper 11), and Patent Owner filed a Preliminary Sur-reply (Paper 13), further addressing the RPI issue. *See* Paper 11, 1–8; Paper 13, 6–7.

In its Preliminary Reply, Petitioner argued that "Patent Owner's (PO's) RPI arguments should be rejected as inappropriate or, at best,

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[1] We infer from the record that Patent Owner is referring to Samsung Electronics Co., Ltd. ("Samsung") and Apple, Inc. ("Apple"). *See* Section B, below.

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) (*"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. *See* Paper 15 ("Dec." or "Decision"). 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 of 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 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").

In its Response, Patent Owner raises the RPI issue again, asserting that "Petitioner has failed to name all real parties-in-interest ("RPIs"), including at least Samsung and Apple," but this time implicating estoppel

under 35 U.S.C. § 315. *See* PO Resp. 14–26. Patent Owner now argues that "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"); *Samsung Electronics Co., Ltd., v. MemoryWeb, LLC*, IPR2022-00222 (the "Samsung IPR") (collectively, the "Related IPRs")." *Id.* at 14–15.

Patent Owner argues that "a petitioner—and any RPIs—are estopped from maintaining a follow-on IPR challenging the same claims when the first IPR results in a final written decision." PO Resp. 16 (citing *Intuitive Surgical, Inc. v. Ethicon LLC*, No. IPR2018-01248, Paper 34, 10-18 (PTAB Feb. 6, 2020) (terminating petitioner from IPR based on final written decision in earlier IPR challenging same claims). *Id.* at 16.

Patent Owner asserts that

> Apple and Samsung filed their own follow-on IPRs challenging all claims of the '228 patent. Paper 15, 12 n.2. If (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.

PO Resp. 16 (citing 35 U.S.C. § 315(e)(1)).

In its Reply, Petitioner asserts that "Unified is the sole RPI, making questions of estoppel under §315(e) irrelevant." Pet. Reply 33. Petitioner argues that

> prospectively finding that RPIs would be hypothetically estopped from maintaining their proceedings under §315(e)(1) . . . would both apply to and be considered in those proceedings—not here—and only after a final written decision, if any, issues. That would presuppose future events that may

> never come to pass, making it an inappropriate advisory inquiry at this stage.

Id. at 33–34 (citing 35 U.S.C. § 315(e)(1); PO Resp. 14–17).

We agree with Patent Owner that it is appropriate to now address the question of whether Unified should have named Apple and Samsung RPIs in this proceeding, for several reasons. We also agree with Petitioner that determining whether Apple or Samsung should be estopped in a subsequent proceeding would be premature. That is a decision best left to those presiding over any subsequent proceeding who would have Apple or Samsung in front of them, which we do not. Moreover, no such estoppel would attach until after a final written decision in this case. *See* 35 U.S.C. § 315(e)(1).

It is appropriate for us to decide the RPI question now because we have a more fully-developed factual record before us, providing us with probative evidence that was not available at the institution phase of this case. For example, during discovery the parties have supplemented the record with Exhibits 1030–1043 and 2027–2047, which includes the deposition transcript of the CEO of Unified (Ex. 2036), as well as other probative evidence on the RPI issue. In addition, on December 16, 2022, an oral hearing was held during which the parties were able to argue the RPI issue before the Board during a confidential session A transcript of the hearing was made a part of this record. Paper 52 (confidential session), Paper 53 (public session).

Second, Patent Owner now squarely puts the issue before us that "Apple and Samsung's follow-on IPRs challenging the '228 patent *do*

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