

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MEMORYWEB, LLC,
Patent Owner.

IPR2022-00222
Patent 10,621,228 B2

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

PER CURIAM.

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

IPR2022-00222
Patent 10,621,228 B2

Petitioner, Samsung Electronics Co., Ltd. (“Samsung” 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 2. On June 13, 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 Samsung 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. 3001, 1. Samsung opposes Patent Owner’s request, and asserts that MemoryWeb has waived the RPI and estoppel issues in this proceeding. *See id.* at 2–3.

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 Samsung as an RPI (Paper 56 (confidential)) in that proceeding.

On June 1, 2023, the Board issued an Order directing the parties to confer and submit a proposed joint briefing schedule and discovery plan to

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.

address the RPI, estoppel, and waiver issues. Paper 37. 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 38.

After considering the parties' arguments in their briefs, 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, vacating-in-part the Final Written Decision and the Board's Order identifying Samsung as an RPI 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 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 September 18, 2023 (Due Date 3)², MemoryWeb will file as exhibits in this proceeding the non-confidential exhibits filed in the *Unified* proceeding (IPR2021-01413) relevant to the RPI issue.

Samsung 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 (IPR2022-00222); and (ii) all agreements or contracts between Samsung and Unified Patents, including Samsung's membership agreement and any amendments or add-ons.

Samsung 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, Samsung 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 September 29, 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

² See Exhibit 3005 for parties' proposed discovery schedule.

U.S.C. § 315(e)(1) as to claims 1–7, including addressing Samsung’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 October 13, 2023 (Due Date 5), Samsung may file a response to MemoryWeb’s Motion of up to 7,000 words.

If Samsung submits a declaration after Due Date 4, Samsung 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 October 27, 2023 (Due Date 6), MemoryWeb may file a reply to Samsung’s response brief not to exceed 3,500 words. Each party may also file a Motion to Exclude.

(5) by November 3, 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 **November 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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