

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.,  
Petitioner,

v.

MEMORYWEB, LLC,  
Patent Owner.

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IPR2022-00222  
Patent 10,621,228 B2

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

BROWNE, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining Some Challenged Claims Unpatentable

Denying Motion to Terminate

Granting Motion for Protective Order

Granting Motions to Seal

*35 U.S.C. § 318(a); 37 C.F.R. § 42.14*

## I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner, Samsung Electronics Co., Ltd., has shown by a preponderance of the evidence that claims 1–17 of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 patent”) are unpatentable, but has not shown by a preponderance of the evidence that claims 18 and 19 are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

### A. *Procedural History*

Petitioner, Samsung Electronics Co., Ltd., filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 10,621,228 B2 (Ex. 1001, “the ’228 patent”).<sup>1</sup> MemoryWeb, LLC (“Patent Owner” or “MemoryWeb”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply (Paper 9) and Patent Owner filed a Preliminary Sur-Reply (Paper 10). Based upon the record at that time, we instituted *inter partes* review on all challenged claims on the grounds presented in the Petition. Paper 12 (“Institution Decision” or “Dec.”).

<sup>1</sup> We refer to the present proceeding, *Samsung Electronics Co. Ltd. v. MemoryWeb, LLC*, IPR2022-00222, as “the *Samsung* proceeding,” “this proceeding,” or “the instant proceeding” to distinguish it from two other related proceedings challenging the ’228 patent. Those other proceedings are *Unified Patents, LLC v. MemoryWeb, LLC*, IPR2021-01413 (“the *Unified* proceeding” or “*Unified*”) and *Apple, Inc. v. MemoryWeb, LLC*, IPR2022-00031 (“the *Apple* proceeding”).

After institution, Patent Owner filed a Response (Paper 19, “PO Resp.”), Petitioner filed a Reply (Paper 24, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 30, “PO Sur-reply”).

On March 16, 2023, an oral hearing was held. A transcript of the hearing was made a part of this record. Paper 34.

In the *Unified* proceeding, which challenged claims 1–7 of the ’228 patent, the Board entered an Order (Paper 56 (confidential)) on March 8, 2023, identifying Samsung as an unnamed Real Party in Interest (the “RPI Order”), and on March 14, 2023, entered a Final Written Decision (Paper 58 (confidential)) finding claims 1–7 of the ’228 Patent unpatentable.

In an email to the Board dated March 15, 2023, counsel for Patent Owner requested authorization to file a motion to terminate the *Samsung* proceeding in light of the Board’s Final Written Decision in the *Unified* proceeding. Ex. 3006; *see also* Ex. 3002, 24:18–25:7, 38:16–41:6.

On March 31, 2023, a joint conference call was held with counsel from the *Unified*, *Samsung*, and *Apple* proceedings to discuss the impact of the Board’s Final Written Decision in the *Unified* proceeding. Ex. 3002. The topics discussed on the conference call included the Board’s RPI Order in the *Unified* proceeding, Patent Owner’s request to file a motion to terminate the *Samsung* proceeding, as well as issues related to real party in interest, waiver, estoppel and discovery, among others. *See id.*

On May 4, 2023, the Chief Administrative Patent Judge determined that good cause existed to extend the one-year period for issuing a Final Written Decision in this case in view of the limited time remaining before

expiration of the one-year period for issuing a Final Written Decision and under the unique circumstances of this case. Paper 35.

On May 18, 2023, we issued an Order extending the one-year pendency of this proceeding by up to six months. Paper 36.

On May 22, 2023, the Director issued a public version<sup>2</sup> 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, we issued an Order directing the parties to confer and submit a proposed joint briefing schedule and discovery plan to address the waiver, RPI, and estoppel issues. Paper 37. The parties submitted their joint proposal by email on June 9, 2023. Ex. 3005.

On June 15, 2023, we issued an Order setting a briefing schedule for the parties to submit their arguments on the issues outlined in Exhibit 3005 (First Phase). Paper 45.<sup>3</sup>

On June 30, 2023, Patent Owner filed its opening brief on the issues of good cause, supplemental information, and additional discovery (Paper 40), and Petitioner filed its opening brief on the issues of waiver and estoppel (Paper 39).

<sup>2</sup> 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.

<sup>3</sup> Paper 45 is the corrected version of the Conduct of Proceeding Order (Paper 38).

On July 14, 2023, Patent Owner filed its response brief on the issues of waiver and estoppel (Paper 43), and Petitioner filed its response brief on the issues of good cause, supplemental information, and additional discovery (Paper 42).

On August 22, 2023, we issued an Order setting a schedule for the parties to conduct discovery on the RPI issue, to brief Patent Owner's requested motion to terminate, to file motions to exclude, and for a second oral hearing (Paper 44).

With respect to Patent Owner's motion to terminate, Patent Owner filed its opening brief (Paper 52, "PO Mot. Term."), Petitioner filed an opposition (Paper 53, "Pet. Mot. Reply"), Patent Owner filed a reply (Paper 57, "PO Mot. Reply").

On November 20, 2023, a second oral hearing was held to permit the parties to address the issues of waiver, real party in interest, estoppel, and termination, among others Related Matters

The parties state that the '228 patent is related to the following U.S. Patents: 9,098,531 ("the '531 Patent"); 9,552,376 ("the '376 Patent"); 10,423,658 ("the '658 Patent"); 11,017,020 ("the '020 Patent"); 11,163,823 ("the '823 Patent"), and 11,170,042 ("the '042 Patent"). Paper 4, 2; Paper 11, 1. The parties further state that the '228 patent is related to pending U.S. Patent Application 17/459,933. Paper 4, 3; Paper 11, 2.

The parties identify the following as related district court matters:  
*MemoryWeb, LLC v. Apple Inc.*, No. 6:21-cv-00531 (W.D. Tex.);  
*MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 6:21-cv-0411

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