

PUBLIC VERSION

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Paper 56
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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

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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 Samsung¹ 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,

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.

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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

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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

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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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implicate estoppel” under 35 U.S.C. § 315(e)(1), and because of that “the Board must address whether Apple and/or Samsung are RPIs.” PO Resp. 16.

Third, if we do not decide the RPI issue now, as Patent Owner urges, then the underlying purpose of Section 315(e) would potentially be frustrated. Determining whether Apple or Samsung are RPIs in this case is a necessary precursor to determining whether they would be estopped in a subsequent proceeding. Otherwise, Patent Owner may have to continue to unnecessarily defend against two subsequent IPR challenges filed by Apple and Samsung should they have been named as RPIs in this case.

Because the issue of Section 315(e) estoppel has been put before us, and we now have a complete factual record available to fully address the RPI question, and to avoid unnecessary prejudice to Patent Owner should Apple and Samsung be RPIs in this case, we conclude that it is appropriate to now decide whether Apple and Samsung are real parties in interest in this proceeding and whether Unified should have named them as RPIs.

B. Related Matters

According to the parties, the ’228 patent was asserted in the following district court proceedings: *MemoryWeb, LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 6:21-cv-00411 (W.D. Tex.); *MemoryWeb, LLC v. Apple Inc.*, Case No. 6:21-cv-00531 (W.D. Tex.); and *MyHeritage (USA), Inc. et al. v. MemoryWeb, LLC*, Case No. 1:21-cv-02666 (N.D. Ill.). Pet. 1–2; Paper 4, 2; Paper 7, 2; Paper 9, 2.

Patent Owner also identifies U.S. Patent No. 9,098,531 (“the ’531 patent”), U.S. Patent No. 10,423,658 (“the ’658 patent”), U.S. Patent No.

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9,552,376 (“the ’376 patent”), U.S. Patent No. 11,017,020 (“the ’020 patent”), U.S. Patent No. 11,163,823 (“the ’823 patent”), pending U.S. Patent Application 17/381,047, and pending U.S. Patent Application 17/459,933 as related to the ’228 patent. Paper 7, 2; Paper 9, 2–3.

Patent Owner additionally indicates the following *inter partes* proceedings as related matters: *Samsung Electronics Co., Ltd., v. MemoryWeb, LLC*, IPR2022-00222 (PTAB) challenging the ’228 patent; *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 (PTAB) challenging the ’228 patent; *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00111 (PTAB) challenging the ’020 patent; *Apple Inc. v. MemoryWeb, LLC*, PGR2022-00006 (PTAB) challenging the ’020 patent; *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00033 (PTAB) challenging the ’658 patent; and *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00032 (PTAB) challenging the ’376 patent. Paper 7, 2; Paper 9, 2–3.

C. *Legal Principles*

Our regulations require that parties “identify each real party-in-interest for the party” as part of its mandatory notices, and to timely update any change in the information provided in those notices. 37 C.F.R. §§ 42.8(a), (b)(1) (2023). The parties have a duty of candor and good faith when they comply with the requirements set forth in Section 42.8. *See* 37 C.F.R. § 42.11(a) (2023) (stating that parties have a duty of candor and good faith in proceedings).

The mandatory notice provision requiring the identification of all real parties in interest serves important notice functions to patent owners, to identify whether the petitioner is barred from filing a petition because of a

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real party in interest that is time-barred or otherwise estopped, and to the Board, to identify conflicts of interests that are not readily apparent from the identity of the petitioner. *See NOF Corp. v. Nektar Therapeutics*, IPR2019-01397, Paper 24 at 6 (PTAB Feb. 10, 2020) (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide 12 (Nov. 2019) (“TPG”)).²

Whether a non-party is an RPI is a “highly fact-dependent question” and must be considered on a case-by-case basis. *Ventex Co. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152 at 6 (PTAB Jan. 24, 2019) (precedential). With respect to a petition’s identification of real parties in interest, the Federal Circuit has stated that

[a] petition is presumed to identify accurately all RPIs. *See Zerto, Inc. v. EMC Corp.*, Case IPR2014-01295, slip op. at 6–7 (PTAB Mar. 3, 2015) (Paper 34). When a patent owner provides sufficient evidence prior to institution that reasonably brings into question the accuracy of a petitioner's identification of RPIs, the overall burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all RPIs.

Applications in Internet Time, LLC v. RPX Corp., 897 F.3d 1336, 1343 (Fed. Cir. 2018) (“AIT”). In a slightly later case, the Federal Circuit also stated that

[a] “petitioner’s initial identification of the real parties in interest should be accepted unless and until disputed by a patent owner.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1243 (Fed. Cir. 2018). To dispute it, the patent owner “must produce *some* evidence that tends to show that a particular third party should be named a real party in interest.” *Id.* at 1244.

² Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>

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VirnetX Inc. v. Mangrove Partners Master Fund, Ltd., 778 Fed. Appx. 897, 902 (Fed. Cir. 2019) (“*VirnetX*”).

D. Threshold Question

Given this direction, we must first consider the threshold question of whether Patent Owner has produced “some evidence that tends to show that a particular third party should be named a real party in interest” and whether that evidence “reasonably brings into question the accuracy of a petitioner's identification of RPIs” in the Petition. We also keep in mind that “the overall burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all RPIs.” *AIT*, 897 F.3d at 1343.

As noted above, Petitioner, as part of its mandatory notice obligations, identified Unified as the only real party in interest in this proceeding. Pet. 1. Since filing the Petition, Petitioner has updated its mandatory notices four times, but on each occasion has indicated that “[n]o updates to the real party-in-interest . . . are made at this time.” See Papers 6, 14, 17, 39.

Patent Owner disputes Petitioner’s identification of Unified as the only real party in interest, and contends that Apple and Samsung must also be identified as RPIs. PO Resp. 14–15. To support this contention, Patent Owner points to evidence indicating that Unified uses a business model that relies on collecting substantial membership fees from paid members, including Apple and Samsung, in exchange for Unified filing validity challenges that benefit its members. PO Resp. 19–20; Ex. 2036, 74:22–75:10; 89:16–23. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]
[REDACTED]. PO Resp. 20; Ex. 1024, 1, 15; Ex. 1025,
1; Ex. 2036, 74:5–10, 75:1–10, 88:25–89:23.

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] Ex. 1024, Sec. 2.2.

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

PO Resp. 20–21; Ex. 1024, Sec. 4.1, 4.1(c); Ex. 1025, Sec. 3.1, 3.1(c)).
Unified’s website states that “Unified works to reduce NPE activity through
monitoring, market intelligence, analytic tools, prior art, and USPTO
challenges.” Ex. 2017, 1. Unified’s website also indicates that Unified has
filed “185 IPRs since 2012” and claims a “95% Success Rate in 2020.”
Ex. 2018, 1–2.

[REDACTED]
[REDACTED]
[REDACTED] PO Resp. 20; Ex. 2036, 36:5–13; 73:3–75:10; 89:5–23.
[REDACTED]
[REDACTED]. PO Resp. 23; Ex. 2036,

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131:23–132:2.

[REDACTED]

[REDACTED]

[REDACTED] PO Resp. 23; Ex. 2033, 11–12; Ex. 2036, 131:23–132:2, 133:4–15.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] PO Resp 21; Ex. 2036, 62:19–63:10.

Unified filed this Petition challenging claims 1–7 of the '228 patent on September 3, 2021. Paper 2. Four days after filing the Petition, Unified emailed Samsung, Apple and other Unified members advising them that Unified had filed a Petition for IPR challenging the '228 patent that “is currently asserted against Apple and Samsung.” PO Resp. 21; Ex. 2027; Ex. 2028; Ex. 2036, 51:13–18, 54:24–55:1. After institution of this IPR, Unified again emailed Apple, Samsung and other Unified members, this time advising them that the '228 patent was “likely invalid.” Ex. 2029.

Sometime after Unified filed the Petition in this case, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] PO Resp. 22; Ex. 2032; Ex. 2033; Ex. 2036, 98:2–100:7.

According to Patent Owner, [REDACTED]

[REDACTED]

[REDACTED] PO Resp. 22; Ex. 2033, 20.

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Patent Owner asserts that the fact that Apple and Samsung filed their own petitions for IPR challenging the '228 patent, including the same claims challenged in this proceeding, shows that Apple and Samsung desire review of the '228 patent. PO Resp. 24; *see Apple*, IPR2022-00031, Paper 1, 1; *Samsung*, IPR2022-00222, Paper 2, 1.³ According to Patent Owner, if Unified succeeds in demonstrating that the challenged claims in the current proceeding are unpatentable, Apple and Samsung would benefit directly from that result. PO Resp. 24 (citing *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 24–25 (PTAB Oct. 2, 2020) (precedential) (“*RPX*”); *AIT*, 897 F.3d at 1363).

According to Patent Owner, Unified faces no risk of liability from enforcement of the '228 patent, and the evidence suggests that Unified may have selected the '228 patent to challenge based, at least in part, on the fact that Patent Owner was enforcing the '228 patent against Unified's members, Apple and Samsung. PO Resp. 24–25. Patent Owner argues that Unified's interest in filing this IPR includes using this IPR to promote its services to existing members and potential new members. *Id.* at 25; *see also* Ex. 2018, 1 (“Unified has filed more patent challenges than all other third-party petitioners combined . . . we have successfully neutralized more patents than any other third-party.”); Ex. 2033, 3, 17–20.

The evidence suggests that Unified's operations and communications with its members may have been crafted with an eye toward RPI

³ We note for the record that claims 1–19 of the '228 patent are challenged in both IPR2022-00031 and IPR2022-00222.

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identification requirements, which Patent Owner argues is to avoid the appearance of influence or control by Unified's member companies. PO Resp. 25–26; *see also* Paper 11, 4 (“[REDACTED] [REDACTED] [REDACTED]”). Unified's CEO has stated that “legal rules concerning estoppel, time bars, and real party-in-interest (RPI) are important issues considered any time an IPR is filed. . . . Unified Patents is well-aware of these issues, and has carefully structured our solution to comply with all of the existing legal requirements to file administrative challenges as the sole RPI.” Ex. 2011, 1.

Nonetheless, according to Unified, its strategic operating “structure provides complete alignment between Unified Patents and its member companies.” Ex. 2016, 1. Such a structure suggests independence, but also suggests that a reason for such an arrangement is to enable Unified to file IPRs that directly benefit its members without having to name those members as RPIs.

Taken together, the evidence identified and argued by Patent Owner supports its assertion that Apple and Samsung are potential beneficiaries to this proceeding, and have preexisting, established relationships with Petitioner. The evidence also supports Patent Owner's contention that Apple and Samsung should have been named as real parties in interest in this case. The evidence reasonably calls into question the accuracy of Petitioner's identification of Unified as the sole RPI in this proceeding.

E. Identifying RPIs

Having resolved the threshold question, we now consider the question of whether Petitioner has complied with its obligation to “identify each real party-in-interest.” 37 C.F.R. §§ 42.8 (2023); *AIT*, 897 F.3d at 1343 (“the overall burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all RPIs”).

As stated by the Federal Circuit, “[d]etermining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *AIT*, 897 F.3d at 1351.

In *RPX*, the Board considered a number of factors to determine whether an unnamed third-party should have been named as an RPI in a proceeding. The factors⁴ relevant to the inquiry here would include: (a) Unified’s business model, including the nature of Unified as an entity; (b) Unified’s interests in the IPR; (c) whether, and under what circumstances, Unified takes a particular member’s interests into account when determining whether to file IPR petitions; (d) Apple and Samsung’s relationship with Unified; (e) Apple and Samsung’s interest in and potential benefit from the

⁴ We recognize that some of the factors we consider, such as “control,” are not among the enumerated factors listed in the “Factual Findings” section of the *RPX* decision. *See RPX*, IPR2015-01750, Paper 128 at 10. However, the issue of “control” is discussed in the “Analysis” section of that case and these factors are relevant to the RPI inquiry here. *See id.* at 32–33; *see also TPG* at 15–17.

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IPR; (f) whether Unified can be said to be representing that interest; (g) whether Apple and Samsung actually desired review of the '228 patent; (h) whether Apple, Samsung, and Unified have any board members in common; (i) any communications between Unified, Apple, and Samsung; and (j) whether Apple or Samsung funded, directed, influenced, or exercised control over Unified's participation in this IPR. *See RPX*, IPR2015-01750, Paper 128 at 10 (citing *AIT*, 897 F.3d at 1358)⁵; *TPG* at 12–18.

F. Parties' Arguments

1. Petitioner's Arguments

Unified argues that Patent Owner “alleges Apple and Samsung should be [named] RPI[s] using the same arguments the Board has routinely rejected” and “has not alleged or submitted any evidence of direction, control, joint funding, or any relevant communication or coordination between Unified and any other entity.” Pet. Reply 22–23 (citing *Unified v. Arigna Tech. Ltd.*, IPR2022-00285, Paper 10, 6-7 (PTAB June 17, 2022); *Unified Patents, LLC v. Intellectual Ventures II, LLC*, IPR2022-00429, Paper 12, 10-11 (PTAB 2022); *Unified Patents Inc. v. Barkan Wireless IP Holdings, LP*, IPR2018-01186, Paper 57, 3-12 (PTAB Dec. 4, 2019), *aff'd*, 838 F'Appx 565 (Fed. Cir. 2021); *Unified Patents, LLC v. American Patents, LLC*, IPR2019-00482, Paper 115, 40-52 (PTAB Aug. 13, 2020)).⁶

⁵ We recognize that the *AIT* and *RPX* decisions involved a question of 35 U.S.C § 315(b) estoppel, which is not at issue in this proceeding. Nonetheless, we understand the RPI analysis to be equally applicable here.

⁶ We acknowledge that the Board decisions cited by Petitioner here determined that Unified was the sole RPI in those cases. However, two of these cases are Decisions on Institution, (IPR2022-00429; IPR2022-00285),

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Unified asserts that its “decision to challenge the ’228 Patent was without the insight, assistance, or approval from any member, and was not in furtherance of any member’s stated or implied benefit.” *Id.* at 25 (citing Ex. 1023 ¶ 13).

According to Unified, “(1) no member made Unified aware of, or expressed any interest in, the [’228] patent or [Patent Owner]; (2) Unified never sought to ascertain the desires of any third-party regarding the [’228] patent; and (3) Unified does not and cannot know if there is a specific benefit to any individual members from this IPR.” Pet. Reply 25 (citing Ex. 1023 ¶ 13). “Unified had no knowledge of Apple and Samsung’s desires regarding the ’228 patent when filing [this Petition]. Unified never communicated with or conveyed any of its plans regarding the ’228 patent to any member at any time nor coordinated with them in any way.” Pet. Reply 28.

Petitioner argues that Patent Owner’s assertion that Apple and Samsung desire review of the ’228 patent because they each filed their own challenges “is misleading because Apple and Samsung each filed different challenges against claims 1-19 rather than 1-7.” *Id.* at 25. Petitioner argues that Unified has “no way of knowing whether its members will benefit from its validity challenges or not, not only because it has no member pre-filing

which were decided on a preliminary factual record unlike the case before us. The other two cases are Final Written Decisions, (IPR2018-01186; IPR2019-00482), but were decided before the Board’s remand decision in *RPX* was issued, and therefore did not have the benefit of that precedential decision as guidance.

communications about particular challenges, but also because its many members [are] from various diverse industries and market positions.” *Id.* Petitioner asserts that “[a]ny supposed benefit to Apple and Samsung from Unified’s IPR is entirely speculative and questionable.” *Id.* at 26.

According to Petitioner, whether “Apple and Samsung may (or may not) benefit, directly or indirectly, from Unified’s challenge due to a suit is not enough.” *Id.* at 26–27.

Petitioner asserts that “[n]either this specific nor any other proceeding was filed at another’s behest and no third party is or could exercise control over this proceeding.” *Id.* at 27 (citing Ex. 1023 ¶¶ 5–6, 24). Petitioner asserts that “Apple’s and Samsung’s filings are indicative of this lack of direction or control and demonstrate ‘the companies were not motivated to avoid the estoppel associated with filing an IPR.’” Pet. Reply 27.

Petitioner explains that “Unified does not discuss forthcoming IPRs at least because it seeks to maintain total independence and control over its deterrence activities.” *Id.* “No Unified member funded this petition. As a result, no member has control, has had an opportunity to control, or has coordinated this or any other challenge Unified chooses to pursue.” *Id.* at 28 (citing Ex. 1023 ¶ 24).

With respect to the agreements between Unified and its member companies, Apple and Samsung, Unified states that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Pet. Reply
28–29 (citing Ex. 1024, Sec. 4.2; Ex. 1025, Sec. 3.2).

With respect to the emails Unified sent to its membership regarding this case, Petitioner states that “these emails are standardized emails sent to mailing lists after Unified files a petition, and they identify the defendants in related litigation who have had the challenged patent asserted against them regardless of whether they are members or not.” Pet. Reply 30 (citing Ex. 2036, 47:10–20, 58:5–11; Ex. 1023 ¶¶ 13–17; Ex. 1029; Ex. 1027).

With respect to [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

With respect to Patent Owner’s analysis of Unified’s financials, Petitioner asserts that “[n]o Unified member directly funded this specific petition or proceeding, and there were no specific payments made to Unified by Apple or Samsung shortly before filing this petition.” *Id.* at 31. “[Patent Owner] has not shown any specific evidence of any direction, funding, or control of *this* proceeding.” *Id.* at 32.

Petitioner argues that Patent Owner “has shown no ‘expectation’ for any member regarding challenges specific to the ’228 patent or [Patent Owner] . . . and its allegations amount to nothing more than unsupported attorney argument.” *Id.* Petitioner argues that “Unified has no clients and selects patents to challenge to deter NPE litigation in technology zones—not

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due to any particular member’s risk or litigation.” *Id.* at 33 (citing Ex. 1023 ¶¶ 4–7, 18, 23).

Petitioner argues that “Apple’s and Samsung’s filings do not show they desired Unified file *this IPR* and surely does not indicate that Unified filed at their *behest*.” *Id.* at 33. “When Unified filed, it had no knowledge of any its members’ desires regarding the ’228 patent.” *Id.* (citing Ex. 1023 ¶¶ 8, 10, 16). “No shared board members exist, Unified has no attorney-client relationship with, and does not act as legal counsel to, members, and Unified had no communications with members regarding this patent, MemoryWeb, or this IPR save those regarding general, public information.” *Id.* (citing Ex. 1023 ¶¶ 16–17, 23–24).

2. Patent Owner’s Arguments

In its Sur-reply, Patent Owner argues that “[d]espite its self-professed ‘independence,’ the reality is that Unified monitors court filings and selectively challenges patents to benefit its members. In return, Apple and Samsung [REDACTED] PO Sur-reply 23. Patent Owner points out that [REDACTED]

[REDACTED] *Id.* at 25.

Patent Owner also argues that “even though the risk of NPE litigation does not fall on Unified . . . Unified challenges patents to reduce or eliminate risk to members like Apple and Samsung. Indeed, reducing members’ litigation risk by challenging patents is the ‘sole purpose’ of Unified’s business, weighing in favor of finding Apple and Samsung to be RPIs.” PO Sur-reply 26 (citing Ex. 1023 ¶ 5). “[REDACTED]

The evidence also shows that Unified seeks to “[d]eter Non-Practicing Entities (NPEs) who assert bad patents (aka Patent Trolls)” and “protect against frivolous patent litigation.” Ex. 2017, 1. Unified “[m]onitor[s] companies in the protected technology (Micro-Pool) to identify NPE activity.” Ex. 2016, 1. Unified provides “benefits” to its member companies by “work[ing] to reduce NPE activity through monitoring . . . and USPTO challenges.” Ex. 2017, 1. Unified’s operating structure “provides complete alignment between Unified Patents and its member companies.” Ex. 2016.

Unified’s Membership Agreements provide that Unified “[redacted]
[redacted]
[redacted]
[redacted]. Ex. 1024, Sec. 4.1, 4.1(c); *see also* Ex. 1025 Sec. 3.1, 3.1(c)).

The evidence shows that [redacted]
[redacted] Ex. 2036, 36:3–13. Unified’s members pay subscription fees based upon the company’s revenue and the number of Unified’s “zones” they wish to subscribe to. *Id.* at 74:5–21, 75:4–6. [redacted]
[redacted] *Id.* at 74:22–75:10. [redacted] *Id.* at 75:7–10. [redacted] *Id.* at 89:5–23. [redacted]
[redacted] *Id.* at 36:3–13.

According to Unified's CEO, [REDACTED]

[REDACTED] *Id.* at 131:23–132:2.

According to Patent Owner's analysis, [REDACTED]

[REDACTED] PO Resp. 23 (citing Ex. 2033, 11–12; Ex. 2036, 131:25–132:2, 133:4–15). Unified's website indicates that Unified has filed “185 IPR petitions since 2012” and claims a “95% Success Rate in 2020”. Ex. 2018, 1–2. Unified claims to have “filed more patent challenges than all other third-party petitioners combined,” and that it has “successfully neutralized more patents than any other third-party.” *Id.* at 1.

Taken together, this evidence indicates that Unified's business model, finances, and operations are structured to support Unified's patent validity challenges, including patent reexamination and the filing of petitions for IPR. These activities act to protect Unified's members, including Apple and Samsung, from the threat of patent litigation and are important components of Unified's core subscription business. This is substantial evidence that Unified has a strong financial incentive to serve its members' needs—expressed or not—and those of its other current and potential future clients. This evidence leads to the inference that Unified filed the Petition in this case to benefit its members Apple and Samsung, supporting a conclusion that Apple and Samsung are RPIs in this proceeding.

2. *Unified's Relationships and Communications with Apple and Samsung*

[REDACTED] Ex. 1023

¶ 19; Ex. 1024. [REDACTED]

[REDACTED]. Ex. 1023 ¶ 20; Ex. 1025.

Unified’s CEO, Mr. Jakel, testified that “[REDACTED]
[REDACTED]
[REDACTED]” Ex. 2036, 46:17–
47:1. Mr. Jakel testified that [REDACTED]
[REDACTED]” *Id.* at 48:7–8.

At deposition, Mr. Jakel confirmed that Unified first learned of the ’228 patent when the ’228 patent was asserted against Samsung in a lawsuit filed on April 26, 2021. Ex. 2036, 62:19–63:10. The lawsuit accusing Apple of infringing the ’228 patent was filed on May 25, 2021. *Id.*

Unified relied on its in-house attorney team to prepare the Petition, which was filed September 3, 2021, challenging claims 1–7 of the ’228 patent. *Id.* at 129:24-130:3; Pet. 1. Four days after filing the Petition, Unified emailed Samsung, Apple and other Unified members advising them that Unified had filed a Petition for an IPR challenging the ’228 patent that “is currently asserted against Apple and Samsung.” Ex. 2027; Ex. 2028; Ex. 2036, 51:13–18, 54:24–55:1. After institution of this IPR on March 14, 2022, Unified again emailed Apple, Samsung and other Unified members, this time advising them that the ’228 patent was “likely invalid.” Ex. 2029.

[REDACTED]
[REDACTED]
Ex. 2036, 98:2–22, 100:4–7; *see* Ex. 2032; Ex. 2033. [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] *Id.* at 100:21–101:4. [REDACTED]

[REDACTED]

[REDACTED] *Id.* at 101:11–14.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Ex. 2036, 50:1–5.

The sequence and timing of this evidence, including Unified’s first learning that the ’228 patent was being asserted against its members, Apple and Samsung, the subsequent preparation and filing of the Petition by Unified’s in-house attorneys, the reporting of the filing of the Petition and Decision to Institute to Apple, Samsung, and other Unified members, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED], all indicate that Unified prepared and filed the Petition in this case to benefit its members Apple and Samsung, supporting a conclusion that Apple and Samsung are RPIs in this proceeding.

3. *Common Members Among Unified, Apple, and Samsung*

The record in this case indicates that Unified, Apple, and Samsung do not have any board members in common. Ex. 1023 ¶ 23. [REDACTED]

[REDACTED]

[REDACTED]

4. *Apple and Samsung’s Influence, Direction, or Control*

In his declaration, Unified’s CEO, Mr. Jakel, states that Unified “has sole and absolute discretion over its decision to contest patents.”

Ex. 1023 ¶ 5. According to Mr. Jakel, “Unified members are unable to participate or exercise any direction or control over Unified’s filings, and Unified does not coordinate with members regarding Unified’s filings or members’ litigation.” *Id.* Mr. Jakel, also states that “Unified has not coordinated or communicated with members regarding litigation or the substance of its IPR.” *Id.* ¶ 22. Mr. Jakel further states that “Unified has not acted at another’s behest, and it has sole control, direction, and funding over this IPR.” *Id.* ¶ 24. At his deposition, Mr. Jakel testified that “[w]e do not communicate with Samsung, Apple or any of our members about their litigation in any way.” Ex. 2036, 117:12–14, *see also id.* at 9:4–16; 136:16–138:7.

We can accept Unified’s representations that Unified’s members do not exercise direction or control over Unified’s decisions to contest patents and its filings. There is no evidence of overt direction or control by Unified’s members in the record. [REDACTED]

[REDACTED]

Unified’s stated limits on member rights, however, appear to be crafted with an eye toward RPI identification requirements, suggesting that they are written to avoid the appearance of any influence by Unified’s member companies. Mr. Jakel has even stated publicly that “legal rules concerning estoppel, time bars, and real party-in-interest (RPI) are important issues considered any time an IPR is filed. . . . Unified Patents is well-aware of these issues, and has carefully structured our solution to comply with all of the existing legal requirements to file administrative challenges as the sole RPI.” Ex. 2011, 1.

Nonetheless, Unified touts that its strategic operating “structure provides complete alignment between Unified Patents and its member companies.” Ex. 2016, 1. Unified’s approach includes “us[ing] ex-parte reexamination and inter partes review procedures at the United States Patent Office to protect technologies from attack by invalid or dubious patents.” Ex. 2015. Unified claims that its “proactive approach is a unique, effective and far less costly solution than litigating against NPEs.” Ex. 2016. According to Unified, “[c]hallenging invalid patents instead of paying for expensive licenses has proved to be the most cost-effective and successful way to stop unreasonable assertions.” Ex. 2018, 1.

Despite Unified's [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *See* Ex. 2033; Ex. 2036, 99:16–101:14. Such conduct suggests that Unified acts for the financial benefit of its members [REDACTED]

[REDACTED]

[REDACTED] This indicates that Unified has crafted its membership agreements and its communication protocols with an eye to avoid naming members as RPIs. This creates an obvious advantage for Unified's members because it allows Unified to act as a proxy for its members interests while attempting to avoid naming its members as an RPI, thus insulating Unified's members from being subjected to the statutory estoppel provisions of 35 U.S.C. § 315(e).

The Board's precedential decision in *RPX* points out, "intentionally avoiding discussion about a forthcoming IPR [challenging a patent asserted] against its [member] for the sole purpose of avoiding having to name the [member] as an RPI, yet challenging patents asserted against its [member], suggests a 'willful blindness' strategy." *See RPX*, IPR2015-01750, Paper 128 at 17–20 (citing *AIT*, 897 F.3d at 1355). Unified's CEO essentially admits as much, supporting a conclusion that Apple and Samsung are RPIs in this proceeding. *See* Ex. 2011, 1 ("Unified has carefully structured our solution to comply with all of the existing legal requirements to file administrative challenges as the sole RPI.").

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5. *IPR Related Interests and Benefits of Unified, Apple, and Samsung*

According to the record, the '228 patent has not been asserted against Unified. Pet. 1–2; Paper 4, 2. Unified, therefore, faces little or no risk of direct liability for infringement of the '228 patent. This lack of risk raises the question of Unified's interest in petitioning for *inter-partes* review of the '228 patent. Unified must expect to derive some benefit from directly challenging the '228 patent itself.

One obvious benefit to Unified is that if Unified is successful in this IPR, it will have provided a valuable service to its members, in particular Apple and Samsung who are being sued for infringement of the '228 patent. If Unified is successful in having claims 1–7 of the '228 patent found unpatentable, then Apple and Samsung will receive a valuable direct benefit from this IPR, in that they may be relieved from defending allegations of infringement of those particular claims.

Moreover, if Unified is successful, Apple and Samsung may no longer have to incur the expense of establishing the unpatentability of claims 1–7 in their own IPRs. *See Samsung Electronics Co., Ltd., v. MemoryWeb, LLC*, IPR2022-00222 (PTAB) (challenging claims 1–19 of the '228 patent); *Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031 (PTAB) (challenging claims 1–19 of the '228 patent). Given this situation, Unified's statement that "Unified does not and cannot know if there is a specific benefit to any individual members from this IPR" rings hollow. Ex. 1023 ¶ 13.

The record indicates that Unified's interest in filing this Petition is directly aligned with Apple and Samsung's interest and benefit from a

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successful IPR outcome. Unified’s documents acknowledge this alignment of interests and benefits between Unified and its member companies.

Unified’s website describes how its strategic operational structure “provides complete alignment between Unified Patents and its member companies.”

Ex. 2016, 1.

[REDACTED]

Indeed, soon after filing the Petition challenging the ’228 Patent,

[REDACTED]

See Ex. 2033, 20; 2036, 100:21–101:10.

Even though Unified’s members may not decide which patents Unified challenges, it is not credible to suggest that Apple and Samsung do not expect Unified to file petitions for IPRs against patents they are accused of infringing [REDACTED]

See Ex. 2036, 75:7–10, 89:16–20.

Unified claims that it “filed this IPR to deter the use of invalid patents in its Content Zone, not to protect the interests of any one member.” Ex. 1023 ¶ 18. Yet, Unified does not provide a specific rationale tied to the ’228 patent to explain why it chose to challenge *this* patent, as opposed to a different patent being enforced in Unified’s “Content Zone.”

Moreover, simply because Unified may have filed this Petition to “deter the use of invalid patents in its Content Zone,” does not mean that Unified did not recognize, understand, and fully appreciate that it was choosing to challenge a patent that was already being enforced against two of its paying members, Apple and Samsung. Indeed, Mr. Jakel acknowledged that Unified first learned about the ’228 patent precisely because it was being enforced against Samsung and Apple in district court. *See* Ex. 2036, 62:19–63:10.

The record shows that Unified files petitions for *inter-partes* review of patents that are being asserted against Unified members, in this case, Apple and Samsung. *See* Ex. 2033, 17–20. The fact that Unified may file other petitions for *inter-partes* review of patents that are not being asserted against Unified members does not detract from this finding.

The evidence also indicates that Unified was, or should have been, cognizant that filing the Petition in this case would provide a direct benefit to Apple and Samsung, if successful. In these situations, Unified and its members accused of patent infringement share a common interest in having the asserted patent claims challenged and found unpatentable. This supports a finding that when Unified files a petition for *inter-partes* review under these circumstances, it is representing the interests of those members.

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This scenario was addressed in one of the PTAB’s precedential decisions. There, the Board stated

[t]hat is not to say that arrangements in which an entity would benefit from having another entity file a petition on its behalf—or on the behalf of it and other similarly-situated entities—is impermissible. But all such entities should be named as RPIs to ensure that pertinent statutory time bars and estoppels apply.

RPX, IPR2015-01750, Paper 128 at 32 (emphasis added).

Given this record, we find that Unified filed the Petition in this case to benefit the interests of its existing clients, Apple and Samsung, supporting a conclusion that Apple and Samsung are RPIs in this proceeding.

6. *Apple and Samsung’s Desired Review of the ’228 Patent*

Subsequent to the filing of this Petition challenging claims 1–7 of the ’228 patent, Apple and Samsung each filed their own petitions challenging all 19 claims of the ’228 patent. *See Apple Inc. v. MemoryWeb, LLC*, IPR2022-00031, Paper 1 (Oct. 30, 2021); *Samsung Electronics Co., Ltd., v. MemoryWeb, LLC*, IPR2022-00222, Paper 2 (Dec. 3, 2021).

Patent Owner argues that Apple and Samsung filing “their own IPR petitions challenging the same claims Unified challenges” shows that “Apple and Samsung desire review of the ‘228 patent.” PO Resp. 24. Patent Owner argues that it “is not credible” to argue “that Apple and Samsung do not desire review of claims 1-7 when both parties invested in seeking review of the same claims in the Related IPRs under their own names.” *Id.*

Petitioner argues that Patent Owner’s assertion “is misleading because Apple and Samsung each filed different challenges against claims 1-19 rather than 1-7.” Pet. Reply 25. Petitioner argues that “Apple’s and

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Samsung's filings do not show they desired Unified file *this IPR* and surely does not indicate that Unified filed at their *behest*." *Id.* at 33.

We agree with Patent Owner that the fact that Apple and Samsung each filed separate petitions requesting *inter-partes* review of the '228 Patent demonstrates that they each desire review of the '228 patent. The fact that Apple and Samsung included *more* claims in their petitions than the seven claims under review in this proceeding does not detract from the reasoning that they both desire review of the '228 patent.

We find that Apple and Samsung's separate filing of petitions for *inter-partes* review of all the claims of the '228 patent demonstrates that they each desired review of the patent, supporting a conclusion that Apple and Samsung are RPIs in this proceeding.

7. *Summary*

Having considered all the evidence of record and the parties' arguments, we find that Unified has a long-term, established, mutually beneficial relationship with its members, Apple and Samsung. We also find that Apple and Samsung are clear beneficiaries to this proceeding and that Unified is representing their interests. We therefore find that Unified has failed to show, by a preponderance of the evidence, that Apple and Samsung are not RPIs in this proceeding.

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ORDER

Accordingly, it is

ORDERED that Apple, Inc. and Samsung Electronics Co., Ltd. are Real Parties in Interest to this Proceeding;

FURTHER ORDERED that Petitioner shall update its Mandatory Notices by March 10, 2023, identifying all Real Parties in Interest consistent with this Order pursuant to its obligations under 37 C.F.R. § 42.8(b)(1); and

FURTHER ORDERED that the parties shall, no later than 14 days from the entry of this Decision, jointly email a proposed redacted version of this Order, which identifies proposed redactions with red highlighting, to trials@uspto.gov.

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