

Vidal Tells PTAB To Remove Apple, Samsung From IPR

By **Dani Kass**

Law360 (May 23, 2023, 8:17 PM EDT) -- The Patent Trial and Appeal Board should not have added Apple and Samsung to a patent challenge launched by Unified Patents, as it wasn't necessary to conduct the review, U.S. Patent and Trademark Office Director Kathi Vidal has ruled.

The director on Monday vacated the PTAB's decision naming the tech giants as real parties in interest in Unified Patent's successful challenge of a MemoryWeb LLC digital file management patent.

RPIs encapsulate all parties that should rightfully be involved in the challenge, and leaving some out can negatively impact the petitioner. Analyzing RPIs can be relevant in a proceeding where a time bar or estoppel has been alleged, but that is not the case here, Vidal said in her director review decision.

"The board should not have determined whether Apple and Samsung are RPIs in this proceeding given that determination was not necessary to resolve the proceeding," she said.

The director invoked the PTAB's precedential opinion in *SharkNinja v. iRobot*. In that October 2020 decision, the board said a company's failure to name its corporate parent didn't matter in the end, because doing so wouldn't have changed the outcome of the case.

Likewise, naming Samsung or Apple would not impact the outcome of the Unified Patent case, the director wrote.

MemoryWeb had told the PTAB that Apple and Samsung should be named as RPIs since they're members of Unified Patents and the organization was aware of litigation between the companies. Unified Patents challenges patents asserted against its members, primarily patents from nonpracticing entities. MemoryWeb, however, sells an app to preserve metadata on photos.

The PTAB refused to decide related parties in its institution decision, but held in an April 5 final written decision that Apple and Samsung are RPIs. It also found that all claims challenged by Unified Patents are invalid as obvious.

The director's Monday decision did not discuss the merits of an inter partes review or address whether Apple and Samsung were rightfully found to be related parties, instead focusing solely on whether the latter should have been addressed in the first place.

"We appreciate the opportunity to be heard by the director, and are glad the office came to the right

result here," Unified Patents General Counsel Jonathan Stroud said in an email Tuesday.

Counsel for MemoryWeb, and corporate representatives for Apple and Samsung didn't immediately respond to requests for comment Tuesday.

The patent-in-suit is U.S. Patent No. 10,621,228.

Unified Patents is represented by Jonathan M. Strang and Inge A. Osman of Latham & Watkins LLP, and its own Ellyar Y. Barazesh.

MemoryWeb is represented by Jennifer Hayes, George Dandalides and Matthew A. Werber of Nixon Peabody LLP.

The case is Unified Patents, LLC v. MemoryWeb, LLC, case number IPR2021-01413, before the Patent Trial and Appeal Board.

--Editing by Emily Kokoll.