

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TOGAIL TECHNOLOGIES LTD.,
Patent Owner.

IPR2023-00720
U.S. Patent No. 10,791,502

**PETITIONER'S AUTHORIZED REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Petitioner submits this reply to Patent Owner's Preliminary Response ("POPR," Paper 13) to address Patent Owner's reliance on a Decision Granting Director Review issued after the filing of the petition: *Unified Patents, LLC v. Memoryweb, LLC*, IPR2021-01413, Paper 76 (May 22, 2023) ("*Memoryweb*"). Patent Owner cites to *Memoryweb* in the POPR to support its argument that the Petition should be discretionarily denied under 35 U.S.C. § 314(a). *See* POPR, 2-13 (analyzing the *General Plastic* factors). *Memoryweb*, however, is directed to estoppel under 35 U.S.C. § 315 and a real party in interest (RPI) determination—both of which are irrelevant to this proceeding.

I. *Memoryweb* is not relevant to this proceeding.

Patent Owner's citations to *Memoryweb* suggest that it is somehow germane to discretionary denial under § 314(a). *Memoryweb*, however, is directed to a different section of the AIA (§ 315) with a different purpose (estoppel). In *Memoryweb*, the Director reviewed whether a panel's RPI determination for the purposes of § 315(e) estoppel was necessary under *SharkNinja. Memoryweb*, 3-5. The Director vacated the RPI determination because "[t]he Board should not have determined whether Apple and Samsung are RPIs in this proceeding given that determination was not necessary to resolve the proceeding." *Id.* at 5.

Neither § 315(e) estoppel nor RPI is currently at issue in this proceeding.

Rather, the Board need only decide whether it would be proper to discretionarily deny institution under § 314(a) in view *General Plastic*. Accordingly, on its face, Patent Owner's reliance on *Memoryweb* is improper.

II. *Memoryweb* does not require a real party in interest determination in this proceeding.

To the extent Patent Owner is suggesting that the Board should engage in an RPI-type determination based on *Memoryweb*, Patent Owner is wrong. In the POPR's analysis of the first *General Plastic* factor, Patent Owner quotes the following portion of *Memoryweb*: "The 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." POPR, 5 (quoting *Memoryweb* at 5). Based on that quote, Patent Owner then spends almost three pages explaining how the Federal Circuit's analysis of an RPI issue in *Applications in Internet Time* is somehow relevant to this proceeding. POPR, 5-8 (quoting and citing *Applications in Internet Time LLC v. RPX Corp.* 897 F.3d 1336 (Fed. Cir. 2018)).

The RPI analysis in each of *Memoryweb* and *Applications in Internet Time* is in fact not relevant to this proceeding because the specific precedential case law guiding § 314 discretionary denials provides an independent basis for assessing a relationship between petitioners. *See Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (Apr. 2, 2019) (precedential) ("*Valve*"). Specifically, the

panel in *Valve* did not employ an RPI analysis when examining the relationship between the different petitioners for the purpose of the first *General Plastic* factor. *Valve*, 9-10. Instead, the panel noted that the petitioners “were co-defendants in the District Court litigation and were accused of infringing the [asserted] patent based on the same product.” *Id.* It thus found a “significant relationship between [the two petitioners] with respect to Patent Owner’s assertion of the [challenged patent].” *Id.* at 10.

Consistent with this precedent, subsequent panels evaluating various petitioners’ relationships with Unified Patents under the first *General Plastic* factor have not applied an RPI analysis—but have instead looked for the type of significant relationship found in *Valve*. For example, in *Netflix, Inc. and Hulu, LLC, v. DivX, LLC*, the Board found that “there is no business relationship involving the accused products or technology between Unified and Petitioner” and concluded that Petitioner’s Unified membership “does not create the type of ‘significant relationship’ that was found in *Valve* to favor denying institution.” IPR2020-00052, Paper 42 at 6-17 (May 14, 2020)); *see also Mercedes-Benz USA, LLC v. Carucel Investments, LP*, IPR2019-01404, Paper 12 at 7-14 (Jan. 22, 2020) (finding petitioner’s membership in Unified did not amount to a relationship that justifies discretionary denial in light of other *General Plastic* factors).

Accordingly, *Memoryweb* and the Federal Circuit’s RPI analysis cited in the

POPR are not germane to this proceeding. The Board should find, consistent with *Valve* and subsequent decisions, that Petitioner Apple and Unified do not have the type of significant relationship necessary for denial under the first *General Plastic* factor.

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CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service August 14, 2023

Manner of service Electronic Service by email: bcooper@bc-lawgroup.com;
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Documents served **Petitioner's Authorized Reply to Patent Owner's Preliminary Response**

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