UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
Petitioner,

v.

REALTIME ADAPTIVE STREAMING LLC,
Patent Owner.

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Case IPR2019-00748
Patent 8,934,535 B2

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Before KEVIN W. CHERRY, GARTH D. BAER, and
NABEEL U. KHAN, *Administrative Patent Judges.*

CHERRY, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

Google LLC ("Petitioner") filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–6, 8–12, and 14 (the "challenged claims") of U.S. Patent No. 8,934,535 B2 (Exhibit 1001, "the '535 patent"). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as party to *Sling TV, L.L.C., et al. v. Realtime Adaptive Streaming, LLC*, Case IPR2018-01342 (PTAB) ("the DISH IPR"). Paper 3 ("Mot."). Realtime Adaptive Streaming, LLC ("Patent Owner") has not filed a Preliminary Response. We have authority under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons described below, we institute *inter partes* review of all the challenged claims, and grant Petitioner's Motion for Joinder.

B. Related Proceedings

Petitioner informs us that the '535 patent is involved in a number of related matters. *See* Pet. 4–7.

C. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–6, 8–12, and 14 of the '535 patent on the following grounds:

Reference(s)	Basis	Challenged Claim(s)
Dvir[1]	§ 102	1, 2, 9, 10, and 14
Dvir	§ 103(a)	1, 2, 9, 10, and 14
Dvir and Ishii[2]	§ 103(a)	3–6, 8, 11, and 12

Pet. 8.

II. DISCUSSION

A. Institution of Inter Partes Review

In its Motion for Joinder, Petitioner represents that this Petition and the DISH IPR petition are "substantially identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims." Mot. 3. Our independent review of the Petition and the DISH IPR petition confirms Petitioner's representations. *See* Ex. 1026 (illustrating the differences between the DISH IPR petition and the present Petition).

The DISH IPR petition was filed by Sling TV, L.L.C., Sling Media L.L.C., DISH Network L.L.C., and DISH Technologies L.L.C. (collectively "DISH"), on July 3, 2018, challenging claims 1–6, 8–12, and 14 of the '535 patent on the same grounds raised in this Petition. *See* DISH IPR, Paper 9, 8. Patent Owner filed a preliminary response to the DISH IPR

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[1] Dvir, U.S. Patent No. 6,557,001 B1, (issued Apr. 29, 2003) (filed Nov. 12, 1999) (Exhibit 1004, "Dvir").
[2] U.S. Pat. No. 5,675,789 (issued Oct. 7, 1997) (filed Jun. 26, 1996) (Ex. 1005, "Ishii").

petition on November 8, 2018. DISH IPR, Paper 6. We instituted *inter partes* review based on the DISH IPR petition on January 31, 2019. DISH IPR, Paper 9 ("DISH IPR Institution Decision"). Patent Owner filed a Response to the DISH IPR petition on April 1, 2019. DISH IPR, Paper 19. Patent Owner has not filed a Preliminary Response to this Petition.

Accordingly, upon our review of the Petition and for the reasons discussed above and in the DISH IPR Institution Decision, we are persuaded Petitioner has demonstrated a reasonable likelihood of success in showing the unpatentability of the challenged claims of the '535 patent on the same grounds raised and instituted in the DISH IPR. We, therefore, institute *inter partes* review based on the Petition.

B. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which reads:

> If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

We instituted the DISH IPR on January 31, 2019. *See* DISH IPR Institution Decision. Petitioner filed this Petition and Motion for Joinder on February 27, 2019, i.e., within one month of the institution date of the DISH IPR. *See* Pet. & Mot. Thus, Petitioner timely filed its Motion for Joinder. *See* 37 C.F.R. § 42.122(b).

As discussed above, Petitioner represents that this Petition and the DISH IPR petition are "substantially identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims." Mot. 1. Petitioner represents that this Petition "does not present any new grounds of unpatentability" that are not already present in the DISH IPR Petition. *Id.* at 4. Because this Petition is substantively identical to the DISH IPR Petition, Petitioner argues Patent Owner will not be required to present any additional responses or arguments. Petitioner argues there is no reason to delay or alter the trial schedule already present in the DISH IPR and represents that it "explicitly consents to the existing trial schedule." *Id.* at 6.

Moreover, Petitioner "agrees to take an 'understudy' role." *Id.* at 7. To that effect, Petitioner states that:

> (a) all filings by Google in the joined proceeding be consolidated with the filings of [DISH], unless a filing concerns issues solely involving Google;

> (b) Google shall not be permitted to raise any new grounds not already instituted by the Board in the [DISH IPR], or introduce any argument or discovery not already introduced by [DISH];

> (c) Google shall be bound by any agreement between Patent Owner and [DISH] concerning discovery and/or depositions; and

> (d) at deposition, Google shall not receive any direct, cross examination or redirect time beyond that permitted under either

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