

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

REALTIME ADAPTIVE STREAMING, LLC,
Patent Owner.

IPR2019-01109
Patent 9,769,477 B2

Before GEORGIANNA W. BRADEN, KEVIN W. CHERRY, and
KAMRAN JIVANI, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION

Granting Motion for Joinder

35 U.S.C § 324; 35 U.S.C § 325(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, Comcast Cable Communications, LLC, filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 7, 8, 15–19, 23, 24, 28, and 29 of U.S. Patent No. 9,769,477 B2 (Ex. 1001, “the ’477 patent”). Realtime Adaptive Streaming LLC (“Patent Owner”) did not file a Preliminary Response.

Petitioner also filed a Motion for Joinder to join as a petitioner in IPR2018-01630. Paper 3 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on May 17, 2019, within one month after we instituted trial in IPR2018-01630.

As explained further below, we determine institution is warranted on the same grounds as instituted in IPR2018-01630 and grant Petitioner’s Motion for Joinder.

A. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), Petitioner identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 71–73.

B. *IPR2018-01630*

In IPR2018-01630, Netflix, Inc., challenged claims 7, 8, 15–19, 23, 24, 28, and 29 of the ’477 patent. After considering the Petition and Patent Owner’s Preliminary Response, we instituted review of the claims challenged in that case. *Netflix, Inc. v. Realtime Adaptive Streaming LLC*, IPR2018-01630 (PTAB April 19, 2019) (Paper 13, “Netflix Inst.”). Thus, the instituted review in IPR2018-01630 involves the following grounds of unpatentability:

References	Basis	Claims Challenged
Imai ¹ and Pauls ²	§ 103	15–19, 28, and 29
Imai, Pauls, and Dawson ³	§ 103	7, 23
Imai, Pauls, and Lai ⁴	§ 103	8, 24

Netflix Inst. 7. Netflix also relied on the Declaration of James A. Storer, Ph.D. (“Dr. Storer”) (IPR2018-01630, Ex. 1003). *See id.*

II. DISCUSSION

Petitioner’s Motion for Joinder states the Petition “challenges the same claims” and “asserts only the ground that the board has already instituted in the Netflix IPR,” while only relying “on the same exhibits and expert declaration” as submitted by Netflix. Mot. 7; *accord id.* (“there are no new arguments for the Board to address.”). Thus, for the same reasons stated in our Decision on Institution in IPR2018-01630, we determine institution is warranted here. *See generally* Netflix Inst.

Having determined that institution is warranted, we consider Petitioner’s Motion for Joinder. Section 325(c) provides, in relevant part, that “[i]f more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under

¹ Japanese Patent Application Publication No. H11331305, published Nov. 30, 1999 (Ex. 1005, “Imai”).

² European Patent Application Publication No. EP0905939A2, published Mar. 31, 1999 (Ex. 1007, “Pauls”).

³ U.S. Patent No. 5,553,160, issued Sep. 3, 1996 (Ex. 1025, “Dawson”).

⁴ U.S. Patent No. 6,407,680 B1, issued Jun. 18, 2002 (Ex. 1016, “Lai”).

section 324, the Director may consolidate such reviews into a single post-grant review.” When determining whether to grant a motion for joinder, we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *See Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Under the circumstances of this case, we determine that joinder is appropriate. Because the present Petition does not include any issues beyond those in the already instituted case, it will have minimal impact on the existing case. “Petitioner agrees to assume a limited ‘understudy’ role” and “would only take on an active role if Netflix were no longer a party to the IPR.” Mot. 5, 7, 8. Because Petitioner relies on the same declaration as does Netflix, no additional depositions will be required. *See id.* at 7–8.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2018-01630. We limit Petitioner Comcast Cable Communications, LLC’s participation in the joined proceeding, such that (1) Netflix alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Comcast Cable Communications, LLC is bound by all filings by Netflix in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Comcast Cable Communications, LLC receives permission to file an independent paper. Comcast Cable Communications, LLC must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding, so long as Netflix remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and

efficient administration of the ongoing trial in IPR2018-01630 and protects the interests of Netflix as original petitioner in IPR2018-01630, and of Patent Owner.

For the foregoing reasons, and with the limitations discussed above, Petitioner's Motion for Joinder is *granted*.

III. ORDER

Accordingly, it is:

ORDERED that *inter partes* review is hereby instituted as to claims 7, 8, 15–19, 23, 24, 28, and 29 of the '477 patent on the following asserted grounds:

- (1) Claims 15–19, 28, and 29 under 35 U.S.C. § 103 as unpatentable over Imai and Pauls;
- (2) Claims 7 and 23 under 35 U.S.C. § 103 as unpatentable over Imai, Pauls, and Dawson; and
- (3) Claims 8 and 24 under 35 U.S.C. § 103 as unpatentable over Imai, Pauls, and Lai;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2018-01630 is granted, and Comcast Cable Communications, LLC is joined as a petitioner in that case pursuant to 37 C.F.R. § 42.222, based on the conditions discussed above;

FURTHER ORDERED that the Petition is dismissed, pursuant to 37 C.F.R. § 42.71(a);

FURTHER ORDERED that the Scheduling Order in place for IPR2018-01630 (Paper 14) shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2018-01630;

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