

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2019-01612 (Patent 7,589,642 B1)
IPR2019-01614 (Patent 9,911,325 B2)
IPR2019-01615 (Patent 9,716,853 B2)
IPR2020-00951 (Patent 9,911,325 B2)
IPR2020-00952 (Patent 9,716,853 B2)
IPR2020-00953 (Patent 9,911,325 B2)¹

Before PATRICK M. BOUCHER, MINN CHUNG, and
SHARON FENICK, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order will be entered in each case. The parties are not authorized to use this caption style.

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On June 26, 2020, a conference call was held with the parties to discuss these cases. A court reporter retained by Petitioner was present on the call. Petitioner is asked to file the transcript of the call in each of the captioned proceedings when it is available.

The subject proceedings involve joinder motions filed by Petitioner. Specifically, in IPR2020-00951 and IPR2020-00953, Petitioner filed a motion to join IPR2019-01614. In IPR2020-00952, Petitioner filed a motion to join IPR2019-01615. In IPR2020-01012,² Petitioner filed a motion to join IPR2019-01612.

Petitioner's joinder motions seek to add additional grounds and claims to Petitioner's challenges in the already instituted proceedings. Petitioner acknowledges that its petitions in the newly filed proceedings are time-barred under 35 U.S.C. § 315(b), and seeks to take advantage of the statutory exclusion to the time bar provided for joinder. The Federal Circuit has foreclosed Petitioner's strategy under this situation, as Petitioner also acknowledges. *See Facebook, Inc. v. Windy City Innovations, LLC*, 953 F.3d 1313 (Fed. Cir. 2020). Nevertheless, Petitioner contends that its strategy may be viable, depending on the Office's position on this situation in light of the Supreme Court's decision in *Thryv, Inc. v. Click-to-Call Techs.*, 140 S. Ct. 1367 (2020), the Federal Circuit's decision in *Wi-Fi One*,

² As we explained during the call, no panel has yet been assigned to IPR2020-01012. We accordingly lack authority to take action with respect to that proceeding, and nothing herein should be construed as any action taken for that proceeding.

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LLC v. Broadcom Corp., 878 F.3d 1364 (Fed. Cir. 2018), and the Board’s decision in *Proppant Express Investments, LLC v. Oren Techs.*, IPR2018-00914, Paper 38 (PTAB Mar. 13, 2019) (designated precedential Apr. 16, 2019).

At this time, Petitioner requests that we adjust the deadlines and schedules in the proceedings to allow the additional issues it requests through joinder to be better accommodated. Specifically, Petitioner asks that we accelerate Patent Owner’s deadlines for filing preliminary responses in the newly filed proceedings, and that we delay the due dates for Patent Owner’s responses in the already instituted proceedings. Patent Owner opposes, identifying the complexity introduced in formulating its positions as a result of the additional issues sought to be added by Petitioner through joinder.

We decline to adjust the deadlines or schedules for any of these proceedings at this time. We think it ill-advised to deprive Patent Owner of its full opportunity to formulate its positions, particularly when both statute and regulation provide us with flexibility regarding the ultimate deadlines for these proceedings in the case of joinder. *See* 35 U.S.C. § 316(a)(11) (“the Director . . . may adjust the time periods in this paragraph in the case of joinder under section 315(c)); 37 C.F.R. § 42.100(c) (“The time can be . . . adjusted by the Board in the case of joinder.”). As we indicated during the call, the parties remain free to stipulate to scheduling changes in the

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already instituted proceedings as provided by the scheduling orders in those proceedings.

It is ORDERED that

Petitioner's request to adjust the deadlines and schedules in these proceedings is *denied*.

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