

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROKU, INC.,  
Petitioner

v.

UNIVERSAL ELECTRONICS, INC.,  
Patent Owner

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Case Nos. IPR2020-00951 and IPR2020-00953  
Patent 9,911,325

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**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c)  
AND 37 C.F.R. §§ 42.22 AND 42.122(b)**

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U.S. Patent and Trademark Office  
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**I. INTRODUCTION AND STATEMENT OF THE PRECISE RELIEF REQUESTED**

Petitioner, Roku, Inc. (“Roku”), respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the concurrently filed Petitions for *inter partes* review (“IPR”) of U.S. Patent No. 9,911,325 (“the ’325 patent”), IPR2020-00951 (“Roku’s Second Petition”) and IPR2020-00953 (“Roku’s Third Petition”) with its pending *inter partes* review, IPR2019-01614, also of the ’325 patent (“Roku’s First Petition”).

Joinder is appropriate because it will promote efficient resolution of the validity of the ’325 patent. Roku’s Second Petition raises new issues only in response to Patent Owner’s addition of 9 newly asserted claims in an ITC investigation filed 19 months after the district court action that prompted Roku’s First Petition of the ’325 patent. Roku’s Third Petition challenges a subset of these claims based on the priority date of the ’325 patent. The Board maintains the discretion to grant a same-party or new-issue joinder in light of the Supreme Court’s recent decision in *Thryv, Inc. v. Click-to-Call Tech, LP*, 140 S. Ct. 1367 (2020), and the Board’s precedential opinion in *Proppant Express Investments v. Oren Techs., LLC*, IPR2018-00914, Paper 38 (P.T.A.B. Mar. 13, 2019). There will be, at most, a minimal impact on the trial schedule in Roku’s First Petition. Petitioner further identifies procedures to simplify briefing and discovery.

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Therefore, joinder would not unduly delay the pending IPR2019-01614 proceeding beyond what is authorized by 35 U.S.C. §§ 316(a)(11), where the Director may, for good cause, extend IPR deadlines in the case of joinder under § 315(c) .

**II. STATEMENT OF MATERIAL FACTS**

On September 18, 2018, Patent Owner served Petitioner with a district court complaint alleging infringement of, among others, the '325 patent. On December 24, 2018, Patent Owner served infringement contentions in the district court litigation asserting, in relevant part, claims 1, 2, 4, and 7 of the '325 patent. On March 14, 2019, the district court granted Petitioner's request that Patent Owner select a subset of its asserted claims across the six patents-in-suit. In response, on April 5, 2019, Patent Owner elected to only proceed on claim 2 of the '325 patent.

On September 18, 2019, Petitioner filed a petition for *inter partes* review challenging claims 1, 2, 3, 4, 5, and 7 of the '325 patent. On April 16, 2020, the Board instituted trial in IPR2019-01614. Thus, under 37 C.F.R. § 42.122(b), any request for joinder must be filed as a motion no later than one month after the institution date, i.e., May 18, 2020.

On April 16, 2020, Patent Owner filed an ITC complaint under 19 U.S.C. § 1337 against Petitioner. Among the claims asserted in the ITC complaint, Patent Owner newly introduced claims 6, 8, 9, and 11-16 of the '325 patent, which were never asserted in the district court case. Roku's First Petition thus does not

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challenge these claims. Because Patent Owner’s ITC investigation comes over 18 months after its civil action, Petitioner is now past the one-year statutory bar set forth in 35 U.S.C. § 315(b) to file an IPR against those claims, unless a motion for joinder is granted. *See* 35 U.S.C. § 315(b) (“The time limitation set forth in the preceding shall not apply to a request for joinder under subsection (c).”).

At the time Patent Owner filed its belated ITC complaint, Petitioner was not permitted to prepare a second IPR petition on the ’325 patent on the newly asserted but unchallenged claims and seek joinder. That path had been foreclosed by the Federal Circuit’s decision in *Facebook, Inc. v. Windy City Innovations, LLC*, 953 F.3d 1313, 1322 (Fed. Cir. 2020), which overturned the Board’s decision in *Proppant Express Investments v. Oren Techs., LLC*, IPR2018-00914, Paper 38 at 4 (P.T.A.B. Mar. 13, 2019), which had previously allowed same party/new issue joinder. However, on April 20, about a month before Petitioner’s deadline to file a motion for joinder, the Supreme Court issued its decision in *Thryv*, which effectively abrogated the Federal Circuit’s decision in *Windy City*. The Director thus maintains its discretion under *Proppant* to allow same party/new issue joinder.

### **III. STATEMENT OF REASONS FOR RELIEF REQUESTED**

The Leahy-Smith America Invents Act (“AIA”) permits joinder of IPR proceedings. The statutory provision governing joinder of post-grant review proceedings is 35 U.S.C. § 315(c):

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