

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner

Case IPR2020-00952
Patent 9,716,853

**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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I. INTRODUCTION AND STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner, Roku, Inc., respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the concurrently filed Petition for *inter partes* review of U.S. Patent No. 9,716,853, IPR2020-00952 (“Roku’s Second Petition”) with its pending *inter partes* review, IPR2019-01615, also on the ’853 patent (“Roku’s First Petition”).

Joinder is appropriate because it will promote efficient resolution of the validity of the ’853 patent. Roku’s Second Petition raises new issues only in response to Patent Owner’s addition of 3 newly asserted dependent claims in an ITC investigation filed 19 months after the district court action that prompted Roku’s First Petition on the ’853 patent. The Board maintains the discretion to grant a same-party/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. Therefore, joinder would not unduly delay the pending IPR2019-01615 proceeding beyond what is

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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 '853 patent. On December 24, 2018, Patent Owner served infringement contentions in the district court litigation asserting, in relevant part, claims 1-3 and 5-8 of the '853 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 5 of the '853 patent.

On September 18, 2019, Petitioner filed a petition for *inter partes* review challenging claims 1, 3, 5 and 7 of the '853 patent. On April 17, 2020, the Board instituted trial in IPR2019-01615. 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 brought back dependent claims 2, 6, and 8 of the '853 patent, which had been dropped from the district court case by the time that Roku's First IPR Petition was filed. Roku's First Petition thus does not challenge these three dependent

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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 ’853 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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