

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

**OPPOSITION TO PETITIONERS' 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

Universal Electronics Inc. (“Patent Owner” or “UEI”) served Roku with a District Court complaint on September 18, 2018, alleging infringement of “one or more claims” of U.S. Patent No. 9,716,853 (“the ’853 Patent”). Exactly one year later, Roku strategically petitioned for review of some but not all of the claims of the ’853 Patent. The Board has now instituted review in that proceeding, Roku’s expert is being deposed next week, UEI’s Response is due in less than a month, Roku’s Reply is due in just over three months, and the Board’s Final Decision is due in less than ten months.

Now, 20 months after being served with UEI’s complaint in the District Court case, Roku seeks to flip the IPR process on its head by asking the Board to review a brand new IPR petition that has been time-barred for over eight months, and to ignore the statutory deadline to complete the originally-filed IPR. Simply put, Roku’s newly-filed IPR petition is harassing, vexatious, duplicative, and untimely; it will significantly increase the costs and resources spent litigating the validity of the ’853 Patent; and is an abuse of the IPR process.

Additionally, Roku’s motion is predicated on a misreading of the Supreme Court’s decision in *Thryv, Inc. v. Click-to-Call Tech, LP*. Contrary to Roku’s argument, *Thryv* did not abrogate the Federal Circuit’s precedential holding in *Facebook, Inc. v. Windy City Innovations, LLC* that same-party and new-issue

joinder are prohibited under §315(c). Rather, *Thryv* makes clear that the no-appeal provision of §314(d) is limited to institution decisions, while *Windy City* pertains solely to proceedings that have already been instituted.

II. FACTS

On September 18, 2018, UEI served Roku with a complaint filed in the Central District of California alleging infringement of “one or more claims” of each of U.S. Patent Nos. 7,589,642, 8,004,389, 9,911,325, 9,716,853, 7,782,309, 7,821,504, 7,821,505, 7,895,532, and 8,015,446. On December 14, 2018, UEI filed its Disclosure of Asserted Claims and Infringement Contentions, identifying 106 asserted claims across the nine patents, including claims 1-3 and 5-8 of the ’853 Patent. UEI noted that it had not yet received discovery from Roku, and that the list of claims was based on the limited information that UEI had obtained to date. UEI reserved the right to seek to amend its disclosure of asserted claims as discovery progressed.

On March 14, 2019, the District Court ordered UEI to limit the total number of asserted claims to 25 claims. *See Universal Electronics Inc. v. Roku, Inc.*, No. 8-18-cv-01580, Dkt. 64 (C.D. Cal. Mar. 14, 2019). The District Court noted that UEI would have the opportunity to reassert unselected claims upon a showing that they presented unique issues. *See id.* at 3, 9 (“Again, the Court notes that if UEI ultimately discovers that non-selected claims raise separate and distinct legal issues from those

raised by the already-selected claims, UEI may ask the Court for leave to reassert unselected claims.”). On April 5, 2019, UEI identified claims 1, 3, 5, and 7 as the claims that it would be proceeding with for the ’853 Patent.

On September 18, 2019—the very last day that Roku could file an IPR challenging the claims of the ’853 Patent—Roku petitioned for *inter partes* review of claims 1, 3, 5, and 7 of the ’853 Patent. Roku did not, however, petition for review of the full set of claims UEI asserted in its Disclosure of Asserted Claims and Infringement Contentions in the District Court case. For instance, Roku omitted claims 2, 6, and 8 from its petition.

Roku’s originally-filed IPR is now in its advanced stages. The Board instituted review over two months ago, Roku’s expert is being deposed next week, UEI’s Response is due in less than a month, Roku’s Reply is due in just over three months, and the Board’s Final Decision is due in less than ten months.

On April 16, 2020, UEI filed a complaint at the International Trade Commission, asserting infringement of claims 2, 6, and 8 against Roku. On May 18, 2020, eight months after the one year statutory bar set forth in §315(b), Roku filed a new IPR petition seeking to challenge one of the claims of the ’853 Patent that Roku has challenged in its originally-filed IPR, and three of the claims that UEI asserted in its Disclosure of Asserted Claims and Infringement Contentions in the District Court case. Roku’s new petition relies on the same art as its original petition,

and provides no explanation for why the new challenges could not have been included earlier.

III. ARGUMENT

A. Roku's Motion Should Be Denied Because It Is An Abuse Of The IPR Process

Roku's motion should be denied because it is an abuse of the IPR process. Roku has known of its alleged infringement of the '853 Patent since at least September 18, 2018 (*i.e.*, the date Roku was served with the complaint in the District Court case), and has known of the specific claims asserted against it since at least December 14, 2018 (*i.e.*, the date UEI served its Disclosure of Asserted Claims and Infringement Contentions). It was Roku's decision to file its original IPR challenging the validity of the '853 Patent on *the very last day* that Roku could file such a challenge (*i.e.*, September 18, 2019), and it was Roku's decision to challenge only a subset of the asserted claims.

Roku's new IPR petition—which was filed 20 months after being served with UEI's complaint in the District Court case—is undeniably time-barred under 35 U.S.C. § 315(b), and has been so for eight months. Additionally, in view of the advanced stage of the original IPR proceedings (*see* Section II, *supra*), granting Roku's motion for joinder would almost certainly force the Board to miss the April 17, 2020 statutory deadline to complete the originally-filed IPR. *See* 35 U.S.C. § 316(a)(11). Accordingly, Roku's motion—which seeks to flip the IPR process on

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