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
U.S. Patent 9,716,853

PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER

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The Board maintains discretion to grant same-party joinder based on the abrogation of *Windy City* by the Supreme Court's decision in *Thryv v. Click-to-Call Techs.*, 140 S. Ct. 1367 (2020) and the Board's precedential opinion in *Proppant Express Invs. v. Oren Techs.*, IPR2018-00914, Paper 38 (P.T.A.B. Mar. 13, 2019). The Board should use its discretion to grant Roku's Motion for Joinder because granting joinder will promote fairness and the efficient resolution of the validity of the '853 patent.

I. UEI's Arguments Regarding *Thryv* Are Meritless.

UEI argues that *Thryv* does not impact abrogate *Windy City* because it is only applicable to decisions under § 315(b) and not § 315(c). UEI is wrong. *Thrvy* is applicable to all decisions that are closely related to the institution decision—including § 315(c). *Thryv* therefore abrogates *Windy City* as decisions under 315(c), like 315(b), are closely related to institution.

UEI also alleges that *Thryv* does not abrogate *Windy City* because *Windy City* is related only to managing an already instituted decision and not to an institution decision. UEI focuses on the wrong petition. A decision under § 315(c) is closely related to the Board's decision to institute the *newly filed* petition. *See* USPTO Supplemental Brief, *Facebook, Inc. v. Windy City Innovations, LLC*, CAFC-18-1400, Doc. ID. No. 106, 10 (June 10, 2020).

Not only are UEI's arguments misinformed and inaccurate, UEI blatantly ignores the positions advocated by the USPTO in its supplemental brief in *Facebook v. Windy City*. UEI had full knowledge of the USPTO's positions but failed to consider or address any of the arguments or positions raised by the USPTO.

II. Granting joinder promotes fairness and prevents undue prejudice.

UEI alleges that Roku's Motion for Joinder does not implicate *Proppant's* fairness concerns because it is the "direct consequence of [Roku's] own intentional omissions." Paper 6, Opp., 10. However, UEI mischaracterizes Roku's alleged "omissions." UEI's inaccurate representations of Roku's omissions in the First Petition are insufficient to negate the fairness concerns raised by UEI's calculated actions to insulate their claims from an IPR challenge.

III. Granting joinder will not disrupt the ongoing schedule nor create a substantial burden for UEI.

UEI argues that Roku's Motion for Joinder should be denied because granting the motion would disrupt the ongoing IPR proceeding and result in a substantial duplication of effort to address the new claims and issues. Opp., 12. UEI is wrong on both counts.

Roku has made several concessions to minimize any impact on scheduling. Paper 2, Mot., 9-11. Additionally, Roku has attempted to work with UEI to minimize any potential disruptions in scheduling. In light of the USPTO's position

that it could entertain same-party joinder, Roku reached out to UEI and proposed minor changes in the schedule of Roku's First Petition. Roku's proposed adjustments included delaying the deposition of Dr. Samuel Russ, while the parties worked through the scheduling proposal. UEI refused to postpone the deposition or adjust the schedule. EX1052, 9:7-15:19. Rather than working to maximize efficiency and prevent wasting the Board's time and resources, UEI seeks to exacerbate potential scheduling differences to increase the likelihood that Roku's Motion for Joinder will be denied. Having refused to work with Roku to minimize the impact of a joined petition, UEI cannot now be heard to complain about the potential distance between the schedules.

The Board, of course, has the authority to make adjustments to accommodate joinder. *See Enzymotec Ltd. v. Neptune Tech. & Bioresources, Inc.*, IPR2014-00556, Paper 19 (Jul. 9, 2014) (adjusting the due date of the POR to accommodate joinder). To further minimize scheduling conflicts, the Board is also able to accelerate its institution deadline. And in the unlikely event that joinder does impact the schedule of Roku's First Petition, the Board has the authority to extend the 1-year decision deadline by six months in the case of joinder under § 315(c). *See* 35 U.S.C. § 316(a)(11).

Finally, UEI alleges that granting joinder would result in a substantial duplication of efforts to address the new claims and issues. Opp., 12-13. UEI

exaggerates the differences between the petitions. EX1052, 12:14-15:19. Roku's Second Petition only challenges four claims, of which only three dependent claims are newly added. The analysis of independent claim 1, from which all the challenged claims depend, is identical between Roku's petitions. As such, Roku's Second Petition is identical to its First Petition, except that it substitutes its analysis of dependent claims 3, 5, and 7 in the First Petition with its analysis of dependent claims 2, 6, and 8 in its Second Petition. Roku cites identical art in its dependent claim analysis in the First and Second Petitions. Consequently, UEI is already intimately familiar with all of the prior art references cited in Roku's Second Petition.

Not only does Roku rely on identical prior art in its Second Petition, it uses the same expert witness, Dr. Samuel Russ, for both petitions. Dr. Russ's declaration in the Second Petition is identical to his declaration in the First Petition, but for the addition of his analysis of the three new dependent claims. Roku also submitted the same declarations of its two fact witnesses in the Second Petition. What is more, all of the exhibits Roku submitted in its Second Petition are identical to the exhibits submitted in its First Petition. Roku's Second Petition also proposes the exact same claim construction as its First Petition.

Contrary to UEI's assertions, Roku's Petitions are nearly identical. Roku's Second Petition merely adds three dependent claims. A Motion for Joinder that

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