

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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THE WALT DISNEY COMPANY,  
DISNEY STREAMING SERVICES LLC, HULU LLC, and  
NETFLIX INC.,  
Petitioner,

v.

WAG ACQUISITION, L.L.C.,  
Patent Owner.

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IPR2023-00813  
Patent 9,729,594 B2

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Before HUBERT C. LORIN, JOHN A. HUDALLA, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314  
Granting Motion for Joinder  
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

## I. INTRODUCTION

On April 6, 2023, The Walt Disney Company, Disney Streaming Services LLC, Hulu LLC, and Netflix Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review of claims 1–17 of U.S. Patent No. 9,729,594 B2 (Ex. 1001, “the ’594 patent,”) and a Motion for Joinder (Paper 6, “Motion” or “Mot.”) with *Google LLC v. WAG Acquisition, L.L.C.*, IPR2022-01411 (“Google IPR”). Petitioner indicates that WAG Acquisition, L.L.C. (“Patent Owner”) does not oppose Petitioner’s Motion. Mot. 1 (citing Ex. 1069; Ex. 1070). Petitioner also indicates that Google LLC, the petitioner in the Google IPR, does not oppose the Motion. Mot. 1.

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314 (2018); *see* 37 C.F.R. § 42.4 (2023). Upon consideration of the Petition and the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least 1 claim of the ’594 patent. Accordingly, we institute *inter partes* review of claims 1–17 of the ’594 patent. We also *grant* Petitioner’s Motion

### A. *Real Parties-in-Interest*

Petitioner identifies The Walt Disney Company, Disney Streaming Services LLC, Disney Streaming Technology LLC, Disney Platform Distribution LLC, BAMTECH LLC, ESPN, Inc., Hulu LLC, and Netflix

Inc. as the real parties-in-interest. Pet. 1. Patent Owner identifies WAG Acquisition, L.L.C. as the real party-in-interest. Paper 9, 2.

*B. Related Proceedings*

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters. Pet. 1–2; Paper 9, 2–8.

*C. The Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–17 of the '594 patent on the following grounds. Pet 4.

| Challenged Claims | 35 U.S.C. §         | References                    |
|-------------------|---------------------|-------------------------------|
| 1–17              | 103(a) <sup>1</sup> | Hill <sup>2</sup>             |
| 1–17              | 103(a)              | Hill, Aharoni <sup>3</sup>    |
| 1–17              | 103(a)              | Hill, Ravi <sup>4</sup>       |
| 1–17              | 103(a)              | Carmel <sup>5</sup> , Hill    |
| 1–17              | 103(a)              | Carmel, Galensky <sup>6</sup> |
| 1–17              | 103(a)              | Carmel, Hill, Ravi            |
| 1–17              | 103(a)              | Carmel, Galensky, Ravi        |

Petitioner relies on the Declaration of Nathaniel Polish, Ph.D. (Ex. 1002) in support of its contentions.

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<sup>1</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the '594 patent has an earliest effective filing date before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA version of § 103 applies.

<sup>2</sup> U.S. Patent No. 6,005,600, iss. Dec. 21, 1999 (Ex. 1006, “Hill”).

<sup>3</sup> U.S. Patent No. 6,014,694, iss. Jan. 11, 2000 (Ex. 1008, “Aharoni”).

<sup>4</sup> U.S. Patent No. 6,292,834 B1, iss. Sept. 18, 2001 (Ex. 1004, “Ravi”).

<sup>5</sup> U.S. Patent No. 6,389,473 B1, iss. May 14, 2002 (Ex. 1003, “Carmel”).

<sup>6</sup> U.S. Patent No. 6,845,398 B1, iss. Jan. 18, 2005 (Ex. 1007, “Galensky”).

## II. ANALYSIS

### A. *Institution of Inter Partes Review*

We instituted an *inter partes* review in the Google IPR on all challenged claims and all asserted grounds of unpatentability. Google IPR, Paper 7. Petitioner here challenges the same claims and asserts the same grounds of unpatentability as those on which we instituted the Google IPR. Pet. 1 (“[T]his Petition is substantially identical to the petition filed in the Google IPR Proceeding.”) (citing Ex. 1068); Mot. 1–2. Petitioner also relies on the same declarant as did the petitioner in the Google IPR. Mot. 2 n.1 (“The expert declaration is a duplicate of the declaration filed in IPR2022-01411.”).

Because the issues in the instant Petition are identical to those in the Google IPR, and for the same reasons stated in our Decision on Institution in the Google IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition. *See* Google IPR, Paper 7.

### B. *Motion for Joinder*

Joinder in an *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder

should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address how briefing and/or discovery may be simplified to minimize schedule impact. *Kyocera Corp. v. SoftView, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We determine that Petitioner has met its burden of showing that joinder is appropriate because, as set forth above, the Petition is substantively identical to the petition in the Google IPR, contains the same grounds based on the same evidence, and relies on the same declaration of Dr. Nathaniel Polish. Mot., *passim*; Ex. 1002. Petitioner also represents that it “agree[s] to take an ‘understudy’ role” so that “Patent Owner and the current petitioner in the Google IPR can comply with the existing trial schedule without needing any duplicative efforts by the Board or the Patent Owner.” Mot. 7–8.

Additionally, so long as the current petitioner Google remains an active party in the Google IPR, Petitioner proposes the following conditions on its participation: (1) “Petitioner shall not make any substantive filings and shall be bound by the filings of Google, unless a filing concerns termination and settlement, or issues solely involving Petitioner”; (2) “Petitioner shall not present any argument or make any presentation at the oral hearing on issues not solely involving Petitioner”; (3) “Petitioner shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Petitioner”; and (4) “Petitioner shall not seek discovery from [Patent Owner] on issues not solely involving Petitioner.” Mot. 8.

We determined above that the Petition warrants the institution of an *inter partes* review. Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in the Google IPR. We limit Petitioner's participation in the joined proceeding, as follows: (1) Google alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Petitioner is bound by all filings by Google in the joined proceeding, except for (a) filings regarding termination or settlement, and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or take any action on its own in the joined proceeding, so long as Google remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in the Google IPR, and protects the interests of Google as original petitioner in IPR2022-01411, and of Patent Owner.

### III. CONCLUSION

For the foregoing reasons, we institute *inter partes* review of claims 1–17 of the '594 patent based on the grounds of unpatentability set forth in the Petition. We also *grant* Petitioner's Motion for Joinder and join Petitioner to IPR2022-01411, with the limitations set forth herein.

#### IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–17 of the '594 patent with respect to all grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(a), Petitioner's Motion for Joinder (Paper 6) is *granted*, and Petitioner is joined as a petitioner in IPR2022-01411;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2022-01411 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2022-01411, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that all further filings in the joined proceedings are to be made in IPR2022-01411;

FURTHER ORDERED that the case caption in IPR2022-01411 for all further submissions shall be modified to add The Walt Disney Company, Disney Streaming Services LLC, Hulu LLC, and Netflix Inc. as named petitioners, and to indicate by footnote the joinder of IPR2023-00813 to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record in IPR2022-01411.

IPR2023-00813  
Patent 9,729,594 B2

PETITIONER:

Larissa S. Bifano  
Jennifer Nall  
Thomas Fuller  
DLA PIPER LLP (US)  
[larissa.bifano@dlapiper.com](mailto:larissa.bifano@dlapiper.com)  
[jennifer.nall@us.dlapiper.com](mailto:jennifer.nall@us.dlapiper.com)  
[thomas.fuller@us.dlapiper.com](mailto:thomas.fuller@us.dlapiper.com)

PATENT OWNER:

Ronald Abramson  
Mord M. Lewis  
Ari J. Jaffess  
Gina K. Kim  
LISTON ABRAMSON LLP  
[ron.abramson@listonabramson.com](mailto:ron.abramson@listonabramson.com)  
[michael.lewis@listonabramson.com](mailto:michael.lewis@listonabramson.com)  
[ari.jaffess@listonabramson.com](mailto:ari.jaffess@listonabramson.com)  
[gina.kim@listonabramson.com](mailto:gina.kim@listonabramson.com)

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Sample Case Caption

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IPR2022-01411<sup>1</sup>  
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<sup>1</sup> IPR2023-00813 has been joined with this proceeding.