

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

WAG ACQUISITION, LLC,
Patent Owner

IPR2023-00813
Patent No. 9,729,594 B2

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2022-01411

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

The Walt Disney Company, Disney Streaming Services LLC, Hulu LLC, and Netflix Inc. (“Petitioner”) respectfully submits this Motion for Joinder, concurrently with a Petition (“the Joinder Petition”) for *inter partes* review of U.S. Patent No. 9,729,594 (“the ’594 patent”), filed herewith.

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with *Google LLC f/k/a Google Inc. v. WAG Acquisition, LLC*, IPR2022-01411 (“the Google IPR” or “the Google proceeding”), which the Board instituted on March 10, 2023, concerning the same claims 1-17 of the ’594 patent at issue in the Joinder Petition. This request is being submitted within the time set forth in 37 C.F.R. § 42.122(b). Patent Owner WAG Acquisition, LLC (“WAG”) does not oppose this joinder motion. EX1069 ; EX1070. Petitioner has consulted with counsel for Google LLC (“Google”), and Google does not oppose Petitioner’s joinder.

Petitioner submits that the request for joinder is consistent with the policy surrounding *inter partes* reviews, as it is the most expedient way “to secure the just, speedy, and inexpensive resolution of every proceeding.” *See* 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper No. 12 at 5-6 (June 1, 2017). Indeed, joinder is proper because the Joinder Petition and the Google IPR are substantially identical; they contain the same grounds

(based on the same prior art combinations and supporting evidence, including an identical declaration from the same expert¹) against the same claims. *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.”) (internal quotations and citations omitted).

Further, upon joining the Google proceeding, Petitioner will act as an “understudy” and will not assume an active role unless the current petitioner ceases to participate in the instituted IPR. Accordingly, the proposed joinder will neither unduly complicate the Google IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining the patentability of the ’594 patent without prejudice to Patent Owner.

II. STATEMENT OF MATERIAL FACTS

1. The ’594 Patent is asserted in four district court actions which are all stayed pending IPR review: *WAG Acquisition, L.L.C. v. Google LLC et al*, 3-22-cv-05772, Dkt. No. 98 (N.D. Cal.); *WAG Acquisition LLC v. Amazon.com Inc et al*, 2-22-cv-01424, Dkt. No. 114 (W.D. Wash.); *WAG Acquisition, L.L.C. v. Netflix, Inc.*, 3-22-cv-05003, Dkt. No. 107

¹ The expert declaration is a duplicate of the declaration filed in IPR2022-01411.

(N.D. Cal); and *WAG Acquisition, L.L.C. v. The Walt Disney Company et al*, 2-21-cv-08230, Dkt. Nos. 104-105 (C.D. Cal).

2. Petitioner previously filed a petition for *inter partes* review (IPR2022-01346) on August 2, 2022 for the '594 Patent ("the -01346 Petition"). The Board denied institution of that petition on March 10, 2023.
3. On August 12, 2022, Google filed a petition for *inter partes* review (IPR2022-01411) ("the Google Petition"). The Google Petition contains prior art and arguments not presented in the -01346 Petition.
4. On March 10, 2023, the Board instituted the Google Petition as to all claims and all grounds. *Id.*, Paper No. 7.
5. The Joinder Petition and the Google IPR are substantially identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims.
6. Google does not oppose this Motion for Joinder.
7. WAG does not oppose this Motion for Joinder.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

Pursuant to 35 U.S.C. § 315(c), the Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. See 35 U.S.C. § 315(c). A petitioner may request joinder, without prior authorization, up to

one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b). The Board, in determining whether to exercise its discretion to grant joinder, considers whether the joinder motion: (1) sets forth the reasons why joinder is appropriate; (2) identifies any new grounds of unpatentability asserted in the petition; (3) explains what impact (if any) joinder would have on the trial schedule for the existing review; and (4) addresses specifically how briefing and discovery may be simplified. *See* Frequently Asked Question (“FAQ”) H5, *available at* <http://www.uspto.gov/ip/boards/bpai/prps.jsp> (last visited Dec. 2, 2019); *see also Samsung Elecs., Co. v. Demaray LLC*, IPR2021-01091, Paper 8 at 9-10 (Dec. 20, 2021).

B. This Joinder Motion is Timely

This motion is timely. Under 37 C.F.R. § 42.122(b), joinder can be requested without prior authorization no later than one month after the institution date of the proceeding to which joinder is requested. *Samsung Elecs., Co. v. Demaray LLC*, IPR2021-01091, Paper 8 at 9-10 (Dec. 20, 2021). Because this motion is being filed within one month of the Board’s decision instituting trial in the Google IPR on March 10, 2023, it meets the requirements of § 42.122(b). *See, e.g., Biotronik, Inc. v. Atlas IP LLC*, IPR2015-00534, Paper 10 (PTAB Feb. 25, 2015) (granting motion for joinder filed concurrently with institution of IPR review).

C. Each of the Factors Weighs in Favor of the Board Granting the Motion for Joinder

All four factors weigh in favor of granting the motion for Petitioner. The Joinder Petition is substantively identical to the Google Petition. Petitioner does not present any new grounds of unpatentability. Additionally, as all issues are substantively identical and Petitioner will act as an “understudy,” joinder will have minimal or no impact on the pending schedule of the Google IPR. *See LG v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6 (Oct. 5, 2015) (granting motion for joinder where petitioners requested an “understudy” role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Google IPR Is Appropriate

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung*, IPR2016-00962, Paper No. 12 at 9 (internal quotations and citations omitted). Here, joinder with the Google IPR is appropriate because the Joinder Petition introduces identical arguments and the same grounds raised in the existing Google proceeding (i.e., challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Google Petition). Other than minor

differences, such as differences related to formalities of a different party filing the petition, there are no changes to the facts, citations, evidence, and arguments introduced in the Google Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Google IPR so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of the Joinder and Google Petition in a single proceeding.

2. Petitioner Does Not Propose New Grounds of Unpatentability

The Joinder Petition is substantively identical to the petition in the Google IPR (*i.e.*, challenging the same claims of the same patent, relying on the same expert declaration, and on the same grounds and combinations of prior art submitted in the Google Petition). *See LG*, IPR2015-01353, Paper No. 11 at 5-6 (granting institution of IPR and motion for joinder where petitioner relied “on the same prior art, same arguments, and same evidence, including the same expert and substantively identical declaration”); *see also Par Pharm., Inc. v. Novartis AG*, IPR2016-01023, Paper No. 20 at 14 (Oct. 27, 2016) (granting motion for joinder where petitioner “do not assert any new ground of unpatentability that is not already being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule”).

3. Joinder Will Not Negatively Impact the Google IPR Trial Schedule

Joinder will have minimal impact, if any, on the Google IPR trial schedule because the Joinder Petition presents no new issues or grounds of unpatentability. *See LG*, IPR2015-01353, Paper No. 11 at 6 (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”). Further, Petitioner explicitly consents to the existing trial schedule. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

The Patent Owner’s Response will not be negatively impacted because the issues presented in the Joinder Petition are identical to the issues presented in the Google Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Google Petition.

Accordingly, joinder with the Google IPR does not unduly burden or negatively impact the trial schedule.

4. Procedures to Simplify Briefing and Discovery

Petitioner explicitly agree to take an “understudy” role, which will simplify briefing and discovery. Specifically, Petitioner explicitly agrees, upon joining the

Google proceeding, that the following conditions shall apply so long as the current petitioner (Google) in IPR2022-01411 remains an active party:

- a) 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;
- b) Petitioner shall not present any argument or make any presentation at the oral hearing on issues not solely involving Petitioner;
- c) 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
- d) Petitioner shall not seek discovery from WAG on issues not solely involving Petitioner.

See, e.g., Noven Pharm., Inc. v. Novartis AG, IPR2014-00550, Paper No. 38 at 5 (Apr. 10, 2015). Unless and until the current petitioner in the Google IPR ceases to actively participate in the instituted IPR proceeding, Petitioner will not assume an active role therein.

Thus, by Petitioner accepting an “understudy” role, 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. These steps will minimize any potential complications or delay that potentially may result

by joinder. *See LG*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where petitioner agreed to an “understudy” role). Petitioner is further willing to agree to any other reasonable conditions the Board deems necessary.

D. Discretionary Denial is Not Appropriate Here

1. Discretionary Denial Under *General Plastic* is Not Appropriate

Petitioner notes that the Board has indicated that the factors outlined by *General Plastic* are not relevant “where a different petitioner files a ‘me-too’ or ‘copycat’ petition in conjunction with a timely motion to join.” *See, e.g., Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11, at 9-11 (PTAB Oct. 30, 2018); *Pfizer, Inc. v Genentech, Inc.*, IPR2017-02063, Paper 25, at 7-8 (PTAB Feb. 21, 2018). Through this motion to join and corresponding Petition, Petitioner has not modified the positions advanced in the Google IPR. *See, e.g., Celltrion*, IPR2018-01019, Paper 11, at 10-11 (finding petitioner’s “copycat” petition and motion to join an instituted IPR to “effectively obviate[] any concerns of serial harassment and unnecessary expenditure of resources,” even though petitioner “previously filed two petitions directed to the same claims of the same patent.”). As such, Petitioner respectfully submits that *General Plastic* does not apply in this circumstance.

In the event the Board does analyze the *General Plastic* factors, those factors weigh in favor of instituting the Petition submitted herewith. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16 (Sept. 6, 2017) (precedential as to § II.B.4.i). The Board has set forth seven factors that it considers in determining whether to exercise its discretion to deny a petition under 35 U.S.C. § 314(a) due to an earlier proceeding involving the same patent. *Id.* at 15-19. The *General Plastic* factors confirm that this Petition should be considered on the merits.

While the Petitioner previously filed a petition to the ‘594 patent, the second to fifth factors weigh in favor of the Petitioner here because Petitioner was unaware of specific grounds in the the Google IPR. And, while the Carmel and Hill references are common to both petitions, the Google Petition includes additional prior art and grounds different than the the -01346 Petition.

As to the sixth factor, while the Board certainly has finite resources, instituting this petition would be no more burdensome than instituting any other petition. In fact, no changes to the trial schedule are necessary by granting Petitioner’s joinder motion given Petitioner explicitly consents to the existing trial schedule.

And as to the seventh factor, there is no readily identifiable roadblock for the Board to issue a final determination within the statutory one-year limit. This motion

for joinder and Joinder Petition are being filed timely within the statutory period, and there is no reason both cannot be addressed according to the statutory deadlines. Further, all four other cases pending in district courts are already stayed, so instituting trial here will not impact any pending district court action.

Accordingly, the Board should grant the motion for joinder and grant joinder with the Google IPR.

IV. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the Joinder Petition and grant joinder with the Google IPR.

Dated: April 6, 2023

Respectfully Submitted,

By: /Larissa S. Bifano/
Larissa S. Bifano
Registration Number 59,051

Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on April 6, 2023, I caused a true and correct copy of the foregoing Motion for Joinder to *Inter Partes Review* IPR 2022-01411 to be served via Priority Mail Express on the Patent Owner at the following correspondence address of record the '594 patent as listed on Patent Center:

ERNEST D. BUFF AND ASSOCIATES, LLC.
231 SOMERVILLE ROAD
BEDMINSTER, NJ 07921

A courtesy copy of the Motion for Joinder and supporting exhibits were also served electronically to the counsel of record for the PO in the litigation pending before the U.S. District Court for the Western District of Texas entitled *WAG Acquisition, L.L.C. v. Google LLC*, No. 6:21-cv-00816 (W.D. Tex.) as follows:

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A courtesy copy of the motion was also served electronically upon counsel of record for Petitioner in *Google LLC v. WAG Acquisitions*, IPR2022-01411 at the following addresses:

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