UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY, INC.,

Petitioner,

v.

LEXOS MEDIA IP, LLC,

Patent Owner.

Case IPR2024-00336

U.S. Patent No. 5,995,102

MOTION FOR JOINDER TO
***INTER PARTES* REVIEW IPR2023-01000**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

eBay Inc. ("Petitioner") respectfully submits this Motion for Joinder ("Motion") together with a Petition for *Inter Partes* Review of U.S. Patent No. 5,995,102 (the "eBay Petition") filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Amazon.com, Inc. v. Lexos Media IP, LLC*, IPR2023-01000 (the "Amazon IPR") in view of the Patent Trial and Appeal Board's (the "Board") decision to institute trial on December 12, 2023. (Amazon IPR, Paper 9.) Counsel for eBay has conferred with counsel for Amazon.com, Inc. ("Amazon"), and counsel for Amazon does not object to eBay joining IPR2023-01000.

Petitioner's request for joinder is timely under 37 C.F.R. § 42.122(b) as it is submitted no later than one month after the December 12, 2023 institution date of the Amazon IPR. The eBay Petition is also narrowly tailored to the same claim, prior art, and grounds for unpatentability that are the subject of the Amazon IPR. In addition, Petitioner is willing to streamline discovery and briefing, as well as follow the Amazon IPR Scheduling Order.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Amazon IPR while efficiently resolving whether a

single claim (claim 72) of U.S. Patent No. 5,995,102 (the "'102 Patent") is valid and in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. On June 5, 2023, Amazon filed a petition for *inter partes* review in IPR2023-01000 requesting cancellation of claim 72 of the '102 Patent.

2. On June 22, 2022, Lexos Media IP, LLC ("Lexos" or "Patent Owner") filed a civil action against eBay, Inc., Case No. 6:22-cv-00648, in the United States District Court for the Western District of Texas ("the Western District Case"). Patent Owner filed a second amended complaint in the Western District Case on May 16, 2023.

3. On December 6, 2023, Judge Albright issued an Order granting Petitioner eBay's request to transfer venue from the Western District of Texas to the Northern District of California. The Northern District of California litigation is pending, and is stylized *Lexos Media IP, LLC v. eBay, Inc.*, No. 3:23-cv-06314-LJC (N.D. Cal.) (the "Northern District Litigation").

4. On December 12, 2023, the Board instituted Amazon's petition for *inter partes* review in IPR2023-01000, finding that "there is a reasonable likelihood that Petitioner would prevail with respect to claim 72 on at least one of the grounds raised in the Petition." *Amazon IPR*, Paper 9 at 36.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers several factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 76-78.

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the December 12, 2023 institution decision of the Amazon IPR. 37 C.F.R. § 42.122(b). Further, the one-year bar set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) does not apply to the eBay Petition because this Motion for Joinder is filed concurrently with the eBay Petition. 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor of Joinder

As explained in detail below, each of the four factors considered by the Board weighs in favor of joinder. Specifically, the eBay Petition does not present any new

grounds of unpatentability; rather it is substantively identical to the Amazon Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical, and Petitioner eBay will accept an "understudy" role unless and until Amazon is terminated from the proceeding. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate here.

Petitioner notes that Amazon may be in the late stages of settlement discussions with Patent Owner, as confirmed by the recent dismissal of Amazon from the corresponding District Court case (*Lexos Media IP, LLC v. Amazon.com, Inc*., No. 2:22-cv-00169 (E.D. Tex.)). However, should Amazon and Patent Owner settle their dispute and seek to terminate the Amazon IPR, Petitioner's Motion should still be granted because it is timely presented, the Petition presents a compelling case of unpatentability, and resolving this dispute is in the interests of justice.

Indeed, the present circumstances are similar to those of *Code200 v. Bright Data Ltd*., IPR2022-00861 ("the Code200 IPR"). There, several petitioners, including Code200, sought to join IPR2021-01492 (the '1492 IPR) in much the same manner as presented here—a petition and motion for joinder were timely filed in the Code200 IPR and before the '1492 IPR petitioner and patent owner requested termination of the '1492 IPR. The Board originally denied the motion for joinder,

generally relying on *General Plastic* grounds. *Code200 IPR*, Paper 17 at 16 (July 25, 2022). In denying institution, the Board stated:

> "Although Petitioner has agreed to an 'understudy' role, NetNut, the petitioner in the 1492 IPR to be joined, has been terminated from that proceeding due to a settlement.… Therefore, Petitioner would not be acting in the role of an understudy, but would immediately assume the leading role if joinder were granted.… Thus, if we granted joinder here, 'Petitioner would stand in to continue a proceeding that would otherwise be terminated.'" *Id*. at 8.

In stark departure from the norm, Director Vidal *sua sponte* reviewed the Code200 IPR institution decision, and vacated and remanded it. *Code200*, Vidal Remand (Paper 18) (August 23, 2022). On remand, the Board granted the motion for joinder and instituted trial despite the '1492 IPR settlement, noting:

> "[W]e determine that the merits of this action present a compelling unpatentability challenge. Absent joinder, a one-year bar would apply to Petitioner, and, again, the merits presented in this challenge would not be reached by the Board in a final written decision. Under these specific circumstances, we determine joinder is appropriate in the interests of justice." *Code200*, Paper 19 at 39 (October 19, 2022).

The panel continued:

> "Because NetNut has been dismissed from the 1492 IPR, there are no longer issues of cooperation and duplication that would have to be addressed between petitioners." *Id*.

The Board should follow the guidance of the Code 200 IPR tribunal and grant Petitioner's Motion even if Amazon and Lexos request termination of the Amazon IPR. The Amazon IPR petition presents compelling unpatentability challenges, resolving the merits of the Amazon petition is in the interest of justice, and joinder is appropriate in such circumstances. *Code200*, Paper 19 at 39. Moreover, the PTAB routinely grants motions for joinder in view of pending litigations involving the same patent and the same parties. *See, e.g., Apple Inc. v. Uniloc* 2017 LLC, IPR2020-00224, Paper 10 at 2-7 (PTAB April 6, 2020) (granting motion for joinder of a copycat petition in view of co-pending lawsuit); *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 2-13 (PTAB May 30, 2019) (same); *Celltrion, Inc. v. Genentech, Inc*., IPR2018-01019, Paper 11 at 2-15 (PTAB Oct. 30, 2018) (same); *Huawei Device Co., Ltd. v. Uniloc Luxembourg S.A*., IPR2017-02090, Paper 9 at 2-12 (PTAB March 6, 2018) (same); *Pfizer, Inc. v. Genentech, Inc*., IPR2017-02063, Paper 25 at 4-8 (PTAB Feb. 21, 2018) (same); *General Motors LLC v. Neo Wireless LLC*, IPR2023-00963, Paper 10 at 2-20 (PTAB Dec. 6, 2023) (same); T-Mobile USA, Inc. v. Dali Wireless, Inc., IPR2023-00830, Paper 7 at 2-11 (PTAB Oct. 11, 2023) (same); Cooler Master Co., Ltd. v. Asektek Danmark A/S, IPR2023-00667, Paper 6 at 2-13 (PTAB Aug. 28, 2023) (same).

1. Joinder is Appropriate with the Amazon IPR

Joinder with the Amazon IPR is appropriate because the eBay Petition involves the same patent, challenges the same claim, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Amazon Petition. The eBay Petition is substantively identical to the Amazon Petition, containing only minor differences unrelated to the merits of the proposed grounds. There are no changes to the facts, citations, evidence, or arguments presented in the Amazon Petition in relation to the grounds of the Amazon Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Amazon IPR so that the Board can efficiently resolve all grounds in both the eBay and Amazon Petitions in a single proceeding. Moreover, as explained previously, the Amazon IPR petition presents compelling unpatentability challenges, resolving the merits of the Amazon petition is in the interest of justice, and joinder is appropriate in such circumstances. *Code200*, Paper 19 at 39.

2. Petitioner Proposes No New Grounds of Unpatentability

The eBay Petition does not present any new grounds of unpatentability. The eBay Petition is substantively identical to the Amazon Petition. The eBay Petition presents the unpatentability of the same claim of the same patent in the same way as the Amazon Petition. 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 Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original); *see also STMicroelectronics, Inc. v. Lone Star Silicon Innovations*, LLC, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (granting joinder and reasoning, "[w]e rely in particular, on Petitioner's representation that its Petition is 'substantially identical'…challenges the same claims based on the same prior art and the same grounds of unpatentability….").

3. Joinder Will Not Unduly Burden or Negatively Impact the Amazon IPR Trial Schedule

Because the eBay Petition is substantively identical to the Amazon Petition, with the same grounds applied to the same claim as instituted by the Board, there are no new issues for Patent Owner to address. Due to the same issues being presented in the Amazon Petition, Patent Owner will not be required to present any additional responses or arguments. *LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 5, 2015) (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]."); *see also id.*, Paper 4 at 5–7.

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

Petition. Also, because the eBay Petition relies on the same expert and a substantively identical declaration, only a single deposition is needed for the proposed joined proceeding.[1]

Joinder of this proceeding with the Amazon IPR would not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule was necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present eBay Petition with the Amazon IPR.

4. Procedures to Simplify Briefing and Discovery

The Amazon Petition and the eBay Petition present substantively identical grounds of rejection, including the same art combinations against the same claim. Additionally, Petitioner explicitly agrees to take an "understudy" role, as described by the Board:

> "(a) all filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Amazon IPR], unless a filing

[1] Petitioner eBay has engaged Dr. Rosenberg, Amazon's expert for the Amazon IPR. Petitioner eBay has submitted Dr. Rosenberg's declaration from the Amazon IPR with the eBay IPR petition in unaltered form, except for exhibit labeling.

> solely concerns issues that do not involve [the petitioner in the Amazon IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Amazon IPR], or introduce any argument or discovery not already introduced by [the petitioner in the Amazon IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Amazon IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Amazon IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Amazon IPR]."

See IPR2014-00550, paper 38 at 5 (Apr. 10, 2015).

Petitioner eBay will assume the primary role only if Amazon ceases to participate in the Amazon IPR. Counsel for eBay has conferred with counsel for Amazon, and Amazon does not object to Petitioner eBay joining IPR2023-01000 in an "understudy" role. By Petitioner accepting an "understudy" role, Patent Owner and Petitioner eBay can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that may result due to joinder. *See, e.g., Garmin Int'l, Inc. v. Philips North Am. LLC*, IPR2020-00910, Paper 8 at 45, 47-50 (PTAB Nov. 19, 2020) (granting joinder where petitioners agreed to accept an "understudy" role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar).

IV. GENERAL PLASTIC IS GENERALLY INAPPLICABLE AND FAVORS PETITIONER

In *General Plastic*, the Board sets forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. However, Petitioner respectfully submits that the *General Plastic* analysis is inapplicable here. In the current motion, eBay merely seeks to join Amazon's proceeding in an understudy rule and does not present any new grounds. The PTAB has previously found that such circumstances "effectively neutralize[]" a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (instituting a joinder copycat petition where petitioner agreed to assume a passive understudy role, and noting such circumstances "effectively neutraliz[es] the *General Plastic* factors"); *see also Celltrion, Inc. v. Genetech, Inc.*, IPR2019-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (noting the joinder motion "effectively obviates any concerns of serial harassment and unnecessary expenditures of resources") and *Code200*, Vidal Remand (Paper 18) (finding road-mapping and other *General Plastic* concerns generally inapplicable or of limited relevance when a motion for joinder presents a copycat petition).

In any event, the *General Plastic* factors counsel heavily against discretionary denial, i.e., in favor of instituting the present IPR and joining it with the Amazon IPR. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i).

The first three General Plastic factors all strongly favor Petitioner. Petitioner has not previously filed an IPR challenge to the '102 patent, Petitioner has included a *Sotera* stipulation in its Petition, and there are no road-mapping concerns as Petitioner has simply filed a copycat version of the Amazon Petition. These factors all counsel against discretionary denial. *Code200*, Vidal Remand (Paper 18) at 4-6.

The fourth, fifth and seventh *General Plastic* factors have limited relevance when a motion for joinder with a copycat petition is presented. *Code200*, Vidal Remand (Paper 18) at 6. In any event, those factors favor Petitioner as the instant Motion is being filed within eight days of institution of the Amazon IPR and there should be no delay in the Amazon IPR if Petitioner's Motion is granted.

The sixth factor also favors Petitioner as it is "the Board's 'mission to improve patent quality and restore confidence in the presumption of validity that comes with issued patents'" which "outweighs the impact on Board resources needed to evaluate the merits of a petition." *Code200*, Vidal Remand (Paper 18) at 6, citing *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272 (2016).

Accordingly, all of the *General Plastic* factors counsel against discretionary denial and in favor granting of Petitioner's Motion. Indeed, any "concerns of fairness are outweighed by the benefits to the patent system of improving patent quality by reviewing the merits of the challenges raised in the petition[], which have not been addressed to date." *Code200*, Vidal Remand (Paper 18) at 6, citing *General*

Plastic at 16 (citing H.R. Rep. No. 112-98, pt. 1, at 40 (2011)); *see also Samsung Elecs. Am., Inc. v. Uniloc Lux. S.A.*, IPR2017-01797, Paper 8 at 33 (P.T.A.B. Feb. 6, 2018) ("Patent Owner's complaint about the multiple [IPR] petitions filed against [its] patent is not persuasive when the volume appears to be a direct result of its own litigation activity.")

V. CONCLUSION

For all of the foregoing reasons, Petitioner eBay respectfully requests that the Board grant eBay's Petition for *Inter Partes* Review of U.S. Patent No. 5,995,102 and grant joinder with the proceeding pending in *Amazon.com, Inc. v. Lexos Media IP, LLC*, IPR2023-01000.

Dated: December 20, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the Motion for Joinder has been served on the Patent Owner via United States Postal Service (USPS) Priority Express Mail, or by means at least as fast and reliable USPS Priority Express Mail, on December 20, 2023, at the following address:

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