

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner

v.

ALMONDNET, INC. AND INTENT IQ, LLC,
Patent Owner

Case No. IPR2024-00666
U.S. Patent No. 10,715,878

**PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)**

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Roku Inc. (“Roku”) respectfully submits this Motion for Joinder together with a Petition for *Inter Partes* Review of U.S. Patent No. 10,715,878 (“Roku Petition”).

On August 4, 2023, Meta Platforms, Inc. (“Meta”) filed *Meta Platforms, Inc., v. AlmondNet, Inc. and Intent IQ, LLC*, IPR2023-01281 (“the Meta IPR”) that also challenges U.S. Patent No. 10,715,878. The Meta IPR was instituted February 21, 2024. Roku requests *inter partes* review and joinder with the Meta IPR pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b). Joinder is appropriate because Roku’s Petition is substantively identical to the petition in the Meta IPR—challenging the same claims of the ’878 patent on the same grounds while relying on the same prior art, arguments, and evidence (*i.e.*, Roku’s Petition is a “copycat” petition).

Roku’s request for joinder is timely because it is filed no later than one month after the institution date of the Meta IPR. If Roku is joined, Roku proposes to streamline discovery and briefing by taking an “understudy role.” Accordingly, joinder will not unduly burden or prejudice the parties to the Meta IPR and will provide for a just, speedy, and inexpensive determination of related proceedings.

Counsel for Roku has conferred with counsel for Meta, and Meta does not oppose joinder.

II. STATEMENT OF FACTS

1. On July 15, 2021, Roku filed a complaint against AlmondNet and Intent IQ (“AlmondNet” or “Patent Owner”)—the purported Patent Owner—for declaratory judgment of non-infringement of the ’878 patent in the U.S. District Court for the District of Delaware (Case No. 1-21-cv-01035) (“the Delaware case”).

2. On the same day, AlmondNet filed a patent infringement suit against Roku involving the ’878 patent in the Western District of Texas (Case No. 6:21-cv-00731-ADA) (“the Texas case”). The Texas case was stayed by agreement pending resolution of the Delaware case.

3. On July 27, 2022, Roku filed a Petition for *Inter Partes* Review challenging claims 1-23 of the ’878 patent. *See Roku, Inc. v. AlmondNet, Inc. et al.*, IPR2022-01315, Paper 2 (PTAB Jul. 27, 2022). On March 13, 2023, the PTAB issued a Decision Denying Institution. *Id.*, Paper 9 (PTAB Mar. 13, 2023). On May 25, 2023, the PTAB issued an Order Denying Precedential Opinion Panel Review. *Id.*, Paper 12 (PTAB May 25, 2023). On July 19, 2023, the PTAB denied Roku’s Request on Rehearing of Decision Denying Institution. *Id.*, Paper 13 (PTAB Jul. 19, 2023).

4. On Nov. 18, 2022, AlmondNet asserted the ’878 patent against Meta in *AlmondNet, Inc. v. Meta Platforms, Inc.*, Case No. 4:23-cv-00438 (N.D. Cal.

filed Nov. 18, 2022).

5. On August 4, 2023, Meta filed a Petition for *Inter Partes* Review challenging claims 1-4 and 6-23 of the '878 patent ("Meta Petition"). *See Meta Platforms, Inc., v. AlmondNet, Inc. and Intent IQ, LLC*, IPR2023-01281, Paper 2 (PTAB April 4, 2022). The Board instituted trial on February 21, 2024. *Id.*, Paper 7 (PTAB Feb. 21, 2024).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

As explained in detail below, Roku's motion for joinder should be granted because the motion is timely, the petition should not be discretionarily denied under *General Plastic*, and the *Kyocera* factors favor joinder.

A. Legal Standard

The Board may join as a party to an instituted *inter partes* review a person who has properly filed a petition for *inter partes* review that warrants institution. 35 U.S.C. § 315(c). The Board "first consider[s] whether to exercise discretion under § 314(a)." *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, paper 9, pg. 4-5 (PTAB Oct. 28, 2020) (precedential) ("*Uniloc*"). Where a party's first petition is denied, a second copycat petition accompanied by a motion to join may be instituted when applying the *General Plastic* factors under § 314(a). *See Google LLC v. Express Mobile Inc.*, IPR2022-00791, Paper 15 (PTAB October 7, 2022)

(“*Express Mobile*”) (granting institution of a second, copycat petition after denial of a first petition on the same claims).

Any request for joinder must be filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). A petition for *inter partes* review is not subject to the one-year statutory time bar if the petition is accompanied by a request for joinder. 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).

“A motion for joinder should (1) set forth reasons why 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 specifically how briefing and discovery may be simplified.” *Samsung Elecs., Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 5 (PTAB Aug. 24, 2016) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

B. Petitioner's Motion for Joinder is Timely

Roku's Motion for Joinder is timely because it is being filed within one month after the institution decision in the Meta IPR. *See* 37 C.F.R. § 42.122(b).

C. The Petition Should Not Be Discretionarily Denied under 35 U.S.C. § 314(a)

The Board should consider this motion for joinder and not discretionarily

deny the copycat petition under § 314(a). Application of the *General Plastic* framework weighs in favor of institution, particularly considering that the facts here are distinguishable from *Uniloc*.

1. Whether the petition is directed to the same claims of the same patent.

This copycat petition challenges claims 1-4 and 6-23 of the '878 Patent, similar to Roku's first petition that challenges claims 1-23 of the '878 Patent. However, regardless of whether this factor weighs against institution, the totality of factors as outlined below weigh in favor of institution. *Google LLC v. Express Mobile Inc.* IPR2022-00791, Paper 15 (PTAB October 7, 2022) ("*Express Mobile*") (granting institution of a second, copycat petition after denial of a first petition on the same claims).

2. Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it.

The *General Plastic* framework addresses the situation where a petitioner files serial petitions in "an attempt to cure the deficiencies that the Board identified in its first-filed petitions." *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 11 (PTAB Sept. 6, 2017) (precedential) ("*General Plastic*"). "The filing of sequential attacks against the same claims, with the opportunity to morph positions along the way, imposes

inequities on [Patent Owner].” *Id.* That is not the case here.

In contrast, Roku is not curing deficiencies or morphing positions from its first IPR. Rather, Roku is seeking to join a petition that has already been instituted, which Roku had no part in preparing. *See Express Mobile*, 9 (“This ‘me-too’ Petition is not a new ‘serial attack,’ but rather an attempt to join a proceeding that has already been instituted.”). The Board noted in *Express Mobile* that an “explanation of the facts relevant to the second *General Plastic* factor” distinguishes *Uniloc*. *See Express Mobile*, 8. In *Uniloc*, the petitioner “failed to set forth facts or offer an explanation concerning its knowledge, at the time it filed the first petition, of the prior art asserted in the [copycat petition].” *Uniloc*, 9. Here, as in *Express Mobile*, Petitioner provides an explanation of relevant facts.

Petitioner represents that, at the time of filing of the first petition (IPR2022-01315, Paper 2 filed Jul. 27, 2022), counsel for Petitioner in any of the actions involving AlmondNet did not identify the prior art used in the Meta IPR and in the present Petition in the manner presented, despite extensive prior art search. Specifically, although the primary reference at issue in the Meta IPR (EX1003, “Baig”) and one secondary reference (EX1008, “Hahn”) were known to Petitioner at the time Petitioner filed its first IPR petition, their significance was not appreciated, as evidenced by those two references only being listed

(among over 400 state of the art references Petitioner had identified) in an Appendix to Petitioner's Preliminary Invalidity Contentions in the district court. (EX1022 at 6 (Ref. No. 161), 9 (Ref. No. 214).) Despite Petitioner's diligent search and analysis, Petitioner did not identify either of those two references in its preliminary invalidity grounds (EX1021), nor was Petitioner even aware of the other four references comprising the grounds asserted in the Meta IPR by the time of filing the first petition on Jul. 22, 2022. (IPR2022-01315, Paper 2). *See Express Mobile*, IPR2022-00791, Paper 15 at 8-11 (Oct. 7, 2022) (finding denial of institution of a joinder petition disfavored, even though it was a petitioner's second petition, where several prior art references were not known at the time of the first petition and one was accessible but its significance was not identified).

Thus, because Roku is not curing deficiencies from its first IPR—and because Petitioner has provided a detailed explanation of the facts surrounding when it became aware of the prior art from the second petition—this factor favors institution.

3. Whether Petitioner used Patent owner's preliminary response and the Board's institution decision of the first petition as a road map.

There is no "road-mapping." Roku did not "strategically stage [its] prior art and arguments in multiple petitions, using [the Board's] decisions as a

roadmap,” a primary concern in *General Plastic*. *General Plastic*, 17.

Specifically, this second, copycat petition is identical in substance to the Meta IPR, which was prepared by a third party unrelated to Roku. Roku did not have any involvement in the preparation of the Meta IPR. As such, Roku did not use the filings or institution decision of the first IPR to obtain an unfair advantage in this Petition. *See Express Mobile*, 9 (“there is no reason to conclude that Petitioner used the filings or decision [of its first IPR] to obtain an unfair advantage in this Petition, which was essentially prepared by someone else”). *See also Cisco Sys., Inc. v. Centripetal Networks, Inc.*, IPR2022-01151, Paper 12 at 48–51 (PTAB Jan. 4, 2023) (explaining “roadmapping concerns are minimized” in similar circumstances) (citing *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 5 (PTAB Aug. 23, 2022) (precedential)); *see also Choirock Contents Factory Co., Ltd. v. Spin Master Ltd.*, IPR2019-00900, Paper 17 at 14 (PTAB Sep. 26, 2019).

Therefore, this factor weighs in favor of institution.

4. Petitioner’s explanation for the time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition.

As discussed above, Petitioner was not aware of the present arguments and combinations of references applied in the Meta IPR and in the present

Petition until the August 4, 2023 filing of the Meta IPR, at which time Roku was already time barred from filing its own IPR.

After the August 4, 2023 filing of the Meta IPR, Roku was unable to file this Petition until the Meta IPR was instituted.¹ Then after the Meta IPR was instituted on Feb. 21, 2024, Roku filed this Petition within one month as provided by the rules. *See* 37 C.F.R. § 42.122(b).

When assessing this factor, it was reasonable for Petitioner to not file between the filing date and the institution of the Meta IPR, because such a filing would have been prohibited by § 315(b). *See Express Mobile*, 11-12. Because the present petition is filed within the one-month window after the institution of the Meta IPR, and Petitioner could not have joined the Meta IPR petition earlier than this window, this factor weighs against discretionary denial.

5. Petitioner's explanation for the time elapsed between the filings of multiple petitions.

As noted in factors 3 and 4, Petitioner is acting reasonably by filing this second, copycat petition within the time allotted by the rules. Accordingly, this factor also weighs against discretionary denial.

6. The finite resources of the Board.

¹ Section 315(d) provides for joinder “[i]f the Director institutes an *inter partes* review.” 35 U.S.C. § 315(d).

This petition does not require any more resources from the Board other than what the Board already allocated for the Meta IPR when it granted institution. *See Express Mobile*, 12 (“we find that Board resources are not a concern here because this panel has the capacity to see the Facebook IPR to its conclusion regardless of the constitution of the petitioner”). This factor weighs against discretionary denial.

7. The totality of factors favor institution.

Factors 2-6 weigh in favor of institution. Accordingly, Petitioner respectfully requests that the Board institute this petition.

D. The *Kyocera* Factors Favor Joinder

1. Factor 1: Joinder is appropriate.

Joinder with the Meta IPR would be appropriate because Roku's Petition involves the same patent, challenges the same claims, and is based on the same grounds and same technical expert declaration testimony relied upon in the Meta Petition. In short, Roku's Petition is substantively identical to the Meta IPR with respect to the prior art challenges.

As such, Roku's Petition does “not present issues that might complicate or delay” the existing Meta IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 at 6 (PTAB July 9, 2014) (“we are mindful of a policy preference for joining a party that does not present new issues

that might complicate or delay an existing proceeding”). Joinder would have little, if any, impact on the Meta IPR because no new grounds would be added, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on Patent Owner, as detailed below.

Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Meta IPR Proceeding so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of the Roku and Meta Petitions in a single proceeding.

2. Factor 2: Roku’s Petition proposes no new grounds of unpatentability.

Roku’s Petition does not present any new grounds or arguments regarding unpatentability. It is substantively identical to the Meta Petition in that regard. The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *BlackBerry Corp. v. Uniloc 2017 LLC*, IPR2019-01283, Paper 10 at 8 (PTAB Nov. 5, 2019) (quoting *Samsung*, IPR2016-00962, Paper 12 at 9) (emphasis added). This factor therefore favors joinder.

3. Factor 3: Joinder will not unduly burden or negatively impact the Meta IPR.

Joinder will not unduly burden Patent Owner. Because Roku's Petition presents the same grounds and arguments as the Meta Petition, there would be no new issues for Patent Owner to address post institution. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting motion for joinder and instituting IPR where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR].").

Likewise, joinder will not negatively impact the trial schedule of the Meta IPR. As described below, Roku agrees to take an "understudy" role in the joined proceeding, so long as Meta remains an active party in the joined proceeding.

Finally, Roku's Petition relies on the same technical expert and identical declaration. *See* EX1002 (Decl. of Christopher M. Schmandt).

4. Factor 4: Procedures to simplify briefing and discovery.

In the event Roku is joined, Roku agrees to take an "understudy" role in the joined proceeding, so long as Meta remains a party and active participant in the proceeding. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 6-8 (PTAB May 30, 2019) (granting motion for joinder where the movant presented a substantively identical petition and agreed to take an "understudy" role in the joined proceeding); *Intel Corp. v. Alacritech, Inc.*, IPR2018-01352, Paper 11 at 3–5 (PTAB Jan. 8, 2019) (same). To be clear, Roku only contemplates assuming the

role of primary petitioner in the instituted Meta IPR if (i) Meta is terminated as a party to the proceeding, or (ii) Meta ceases participating in the proceeding such that the proceeding is no longer “meaningfully adversarial,” contrary to the public interest. *See ZTE (USA), Inc., et al. v. CyWee Group Ltd.*, IPR2019-00143, Paper 50 at 7-9 (PTAB July 17, 2020) (allowing a joinder petitioner to assume the role of primary petitioner with respect to a motion to amend because the “trial no longer appears to be meaningfully adversarial” given the primary petitioner’s decision not to oppose revised amended claims).

As an understudy in the Meta IPR, Roku agrees to the following conditions regarding the joined proceeding, so long as Meta remains an active party in the joined proceeding:

- All filings by Roku in the joined proceeding shall be consolidated with the filings of Meta unless a filing solely concerns issues that do not involve Meta²;
- Roku shall not be permitted to raise any new grounds not already instituted

² Any consolidated filings jointly submitted by petitioners will not exceed the normal page limits for a single party set forth in the rules. Circumstances may require Roku to request and file separate papers with respect to Roku’s individual status as petitioner in the proceeding—*e.g.*, a motion to terminate.

by the Board in the Meta IPR, or introduce any argument or discovery not already introduced by Meta;

- Roku shall be bound by any agreement between Patent Owner and Meta concerning discovery and/or depositions; and
- At deposition, Roku shall not receive any direct examination, cross-examination, or redirect time beyond that permitted in this proceeding for Meta alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Meta.

See Apple, IPR2019-00958, Paper 9 at 7–8 (granting a motion for joinder where the movant proposed the above limitations on its role as understudy); *see also Intel Corp.*, IPR2018-01352, Paper 11 at 4–5 (granting a motion for joinder with such limitations on the understudy).

Additionally, with respect to any oral hearing, Meta will be responsible for the presentation before the Board. Roku, when in the understudy role, will not request any additional time to independently argue before the Board or attempt to submit its own demonstratives.³

Accordingly, if joinder is granted, briefing and discovery in the joined

³ While Roku will not materially participate in calls with the Board, depositions, and any oral hearing, Roku anticipates that its counsel will attend such events.

proceeding will be no more complex than if Roku had never been joined.

Consolidated briefing and discovery will ensure a simplified and efficient joined proceeding. As such, this factor also favors joinder.

IV. CONCLUSION

For the reasons above, Roku respectfully requests that the Board institute Roku's concurrently filed Petition for *Inter Partes* Review of U.S. Patent No. 10,715,878 and grant joinder.

Respectfully submitted,

Dated: March 20, 2024
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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service was made on Patent Owner as detailed below.

Date of service March 20, 2024

Manner of service FEDERAL EXPRESS

Documents served PETITIONER'S MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, 42.122(b).

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