

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIA NT TECHNOLOGY LLC,
Petitioner,

v.

ALMONDNET, INC.,
Patent Owner.

IPR2025-00126
Patent No. 8,775,249

**PETITIONER’S MOTION FOR JOINDER AND REQUEST FOR
EXPEDITED CONSIDERATION THEREOF UNDER**

35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)

I. STATEMENT OF PRECISE RELIEF REQUESTED

Viant Technology LLC (“Petitioner” or “Viant”) respectfully submits this Motion for Joinder concurrently with a Petition (“Viant Petition”) for *inter partes* review of U.S. Patent No. 8,775,249 (“the’249 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Viant requests institution of an *inter partes* review and joinder with IPR2024-00416 (*Freewheel Media, Inc. v. AlmondNet, Inc.* “FreeWheel IPR”), instituted on October 1, 2024. Furthermore, Viant requests expedited consideration of this Motion and joinder of its Petition to IPR2024-00416 promptly after the deadline for the Patent Owner’s Preliminary Response, or if Patent Owner waives its Preliminary Response, promptly thereafter.

This Motion for Joinder and the currently filed Petition are being filed within a month of institution, pursuant to 37 C.F.R. § 42.122(b). FreeWheel Media, Inc. does not oppose Viant’s joinder to the FreeWheel IPR. Viant’s petition challenges the same claims, on the same grounds, relies on the same prior art, and includes the exact same substantive arguments as the FreeWheel IPR¹ and therefore would create no additional burden for the Board, the FreeWheel IPR Petitioner, or Patent Owner

¹ The Viant Petition includes additional arguments regarding discretionary denial based on the specific facts relevant to Viant.

if joined. Joinder would therefore lead to an efficient resolution of the validity of the '249 patent.

Viant is currently named as a defendant in *AlmondNet, Inc. et al v. Viant Technology Inc. et al* in the District of Delaware, Civil Action No. 1-23-cv-00174 filed February 16, 2023. Viant has been accused of infringing the '249 patent. Viant has not previously filed a petition for IPR challenging the validity of the '249 patent.

Viant stipulates that if joinder is granted, it will act as an “understudy” and will not assume an active role unless the FreeWheel IPR Petitioner ceases to participate in the proceeding. The FreeWheel IPR Petitioner will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Viant also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because Viant agrees to be bound by the scheduling order in the FreeWheel IPR proceeding.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the FreeWheel IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice Viant. Viant's interests may not be adequately

protected in the FreeWheel IPR, particularly if the FreeWheel IPR Petitioner settles with Patent Owner and ceases to participate. Viant should be allowed to join in a proceeding affecting a patent asserted against it.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by Viant's cooperative participation, in an understudy role, the Board should institute IPR and grant Viant's Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

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); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-I Security*

Solutions, Inc., IPR2013-00385, Paper 17 at 3 (July 29, 2013).

B. Viant's Motion for Joinder is Timely

Joinder may be requested “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). The FreeWheel IPR was instituted on October 1, 2024. IPR2024-00416. Viant's current motion is timely as it is being filed no later than 1 month after the institution date.

C. Petitioner FreeWheel Does Not Oppose Joinder

Viant has conferred with Petitioner FreeWheel, and FreeWheel does not oppose Viant's joinder to the FreeWheel IPR.

D. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Viant's Motion for Joinder. Viant's Petition is substantively identical to the petition in the FreeWheel IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the FreeWheel IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of Viant Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the '249 Patent Without Prejudice to Any Party

Viant seeks to join the FreeWheel IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if the

FreeWheel IPR Petitioner's participation is terminated prior to completion. Thus, joining Viant to the FreeWheel IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '249 patent. *See* 37 C.F.R. § 42.1(b).

If Viant is joined as a party, the validity of the grounds raised in the FreeWheel IPR can be determined in a single proceeding. Joinder is also appropriate because Viant's petition challenges the validity of the same claims of the '249 patent on identical grounds to those in the FreeWheel IPR. There are no substantive differences between Viant's and the FreeWheel IPR Petitioner's Petition, IPR2024-00416, Paper 2 (March 1, 2024). Viant also relies on the same supporting evidence in its Petition as is relied on in the FreeWheel IPR. A consolidated proceeding, including Viant and the FreeWheel IPR Petitioner, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). 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., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper

12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining Viant as a party to the FreeWheel IPR would promote the public interest relating to the unpatentability of the '249 patent and not cause any undue prejudice to Patent Owner or the FreeWheel IPR Petitioner. The Patent Owner must respond to the common invalidity grounds identified in the FreeWheel and Viant's Petitions regardless of joinder.

2. Viant's Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the FreeWheel IPR Petitioner's Petition

Viant's Petition challenges the validity of the '249 patent on identical grounds to those in the FreeWheel IPR. *See* IPR2024-00416, Paper 2 (March 1, 2024). Viant's supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the FreeWheel IPR. *See supra* n.2. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper 11 at 5-6 (PTAB Oct. 5, 2015).

Therefore, consolidation of this proceeding with FreeWheel's via joinder of Viant's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the FreeWheel IPR

Given that the Board only recently instituted the FreeWheel IPR, joinder of Viant would not affect the schedule in any potential forthcoming trial. Viant's participation should result in no changes to the schedule.

Viant agrees to adhere to all applicable deadlines set forth in the FreeWheel IPR Scheduling Order.

4. Joinder Will Simplify Briefing Because Viant Has Agreed to Consolidated Filings and an Understudy Role if the FreeWheel Petitioner Remains

To further prevent joinder from imposing any burden on the FreeWheel IPR Petitioner, Patent Owner, or the Board and to further ensure that there are no changes in the potential trial schedule, Viant has agreed, as long as the FreeWheel IPR Petitioner remains a party to the FreeWheel IPR, to take an understudy role, which will simplify briefing and discovery. In this role, Viant agrees to the following conditions:

(a) Viant shall not make any substantive filing and shall be bound by the filings of the FreeWheel IPR Petitioner, unless a filing concerns termination and settlement, or issues solely involving Viant;

(b) Viant shall not present any argument or make any presentation at oral hearing unless an issue solely involves Viant, or when addressing Board-approved motions that do not affect the FreeWheel IPR Petitioner, or its respective position;

(c) Viant shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Viant;

(d) Viant shall not seek discovery from Patent Owner on issues not solely involving Viant;

(e) Viant will not rely on expert testimony beyond that submitted by the FreeWheel IPR Petitioner unless the FreeWheel IPR Petitioner is terminated from the case. If the FreeWheel IPR Petitioner is not terminated from the case, Viant agrees to rely entirely on, and be bound by, the expert declarations and depositions in the FreeWheel IPR. Unless and until the current petitioner in IPR2024-00416 ceases to participate in the instituted FreeWheel IPR, Viant will not assume an active role.

Accordingly, due to Viant taking only an “understudy” role, Patent Owner and the FreeWheel IPR Petitioner will only need to respond to one principal set of papers, will not require additional time to address additional arguments raised by Viant, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony*, Paper 11 at 6-7 (granting motion 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 second

petitioner agreed to “understudy” role). Viant will also abide by any additional conditions the Board deems appropriate for an “understudy” role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, Viant’s joining of the FreeWheel IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of Viant’s joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current FreeWheel IPR.

III. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

General Plastic does not apply here because Viant has not previously challenged the ’249 patent and seeks to join the FreeWheel IPR in an understudy role. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 4-5 (PTAB Apr. 6, 2020).

Factor 1: Under *General Plastic*, factor 1 considers “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic* at 16. Here, Viant has not previously filed a petition against the ’249 patent.

Viant and the FreeWheel IPR Petitioner are separate, unrelated petitioners,

and are not similarly situated for purposes of Factor 1. This factor weighs in favor of institution and against discretionary denial.

Factors 2, 4 and 5: As to the timing examined in these factors, Viant did not previously file a first petition prior to its current petition, and while Viant became aware of the prior art references in the FreeWheel IPR, it made no serial attack on the '249 patent. These factors weigh in favor of institution and against discretionary denial.

Factor 3: As Viant did not previously file a first petition, this factor weighs in favor of institution and against discretionary denial.

Factors 6 and 7: As stated above, Viant seeks to join the FreeWheel IPR and is not raising arguments beyond those raised by the FreeWheel petition. These factors thus weigh in favor of institution, as there should be no material impact on the Board's finite resources or its ability to issue a final determination on the FreeWheel petition within one year.

IV. CONCLUSION

For the foregoing reasons, Viant respectfully requests that its Petition for *Inter partes* review of the '249 Patent be instituted and that Viant be joined to the FreeWheel IPR proceeding IPR2024-00416.

Respectfully submitted,

Dated November 1, 2024

/Joshua A. Griswold/

Joshua A. Griswold, Reg. No. 46,310

Karan Jhurani, Reg. No. 71,777

Daniel G. Wheaton, Reg. No. 78,933

Susan E. Morrison, Reg. No. 56,332

Fish & Richardson P.C.

60 South Sixth Street, Suite 3200

Minneapolis, MN 55402

T: 214-292-4034

F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on November 1, 2024, a complete and entire copy of this Petitioner's Motion for Joinder was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

LOUIS J. HOFFMAN, P.C.
7689 East Paradise Lane, Suite 2
Scottsdale, AZ 85260

/Hoi Cheung/
Hoi Cheung
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
hcheung@fr.com