UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER, INC.,
Petitioner

v.

VIDEOLABS, INC.,
Patent Owner

Inter Partes Review Case No. IPR2025-00305
U.S. Patent No. 8,291,236

MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2024-01024

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

ASUSTeK Computer, Inc. ("Petitioner") respectfully submits this Motion for Joinder, together with a concurrently-filed Petition for *Inter Partes* Review of U.S. Patent No. 8,291,236 (the "'236 Patent") (IPR2025-00305 "the Present Petition").

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner respectfully requests institution of *inter partes* review and joinder with *Roku, Inc. v. VideoLabs, Inc.,* IPR2024-01024 ("the Roku IPR"), instituted December 4, 2024.

The Present Petition is substantively identical to the Roku IPR petition—it challenges the same claims, relies on the same prior art, and uses the same grounds, evidence, arguments, citations, and structure for unpatentability as the Roku IPR. The Present Petition does not add, change, or remove any substantive arguments from the Roku IPR petition. Petitioner is currently a defendant in *VideoLabs, Inc. v. ASUSTeK Computer, Inc.*, No. 6:22-cv-00720-ADA (W.D. Tex.) and has not previously filed a petitioner for *inter partes* review challenging the validity of the '236 Patent.[1] Judicial resources will be conserved by institution and joinder here because Petitioner provides a *Sotera* stipulation if institution and joinder are granted.

[1] Petitioner is concurrently filing three copycat petitions (IPR2025-00304, IPR2025-00305, IPR2025-00306) seeking to join the underlying Roku IPRs (IPR2024-01023, IPR2024-01024, IPR2024-01025). As explained by Roku, three petitions are necessary solely for word count purposes given the amount and length of the challenged claims. IPR2024-01023, Paper 3; IPR2024-01024 Paper 3; IPR2024-01025, Paper 3.

Petitioner further stipulates that if joinder is granted, it will act as an "understudy" and will not assume an active role unless the Roku IPR petitioner ceases to participate in the proceeding. Petitioner will allow the Roku IPR petitioner to maintain the lead role in the proceeding and be bound by Roku's filings so long as it remains in the proceeding. Petition agrees to the entered Scheduling Order in the Roku IPR (IPR2024-01024, Paper 13) and will not submit any filings or motions unless Roku ceases to participate or such filings or motions solely involve Petitioner. Petitioner will also not seek any additional depositions or deposition time. These limitations remove any potential burden for having another party join the proceeding and avoid any lengthy or duplicative briefing.

Accordingly, joinder is appropriate because it will efficiently resolve the question of the '236 Patent's validity in the same manner and timeframe already prescribed by the Scheduling Order in the Roku IPR (IPR2024-01024, Paper 13).

II. STATEMENT OF MATERIAL FACTS

1. On June 14, 2024, Roku Inc. filed a petition for *inter partes* review (IPR2024-01024) requesting cancellation of claims 48–50, 57, 82–84, 91, 116–118, 125, and 140–142 of the '236 Patent. IPR2024-01024, Paper 2 (June 14, 2024).

2. On December 4, 2024, the Board instituted *inter partes* review on all challenged claims and grounds. IPR2024-01024, Paper 12 (Dec. 4, 2024).

3. Contemporaneously with this Motion, Petitioner filed its Petition for *Inter Partes* Review requesting cancellation of claims 48–50, 57, 82–84, 91, 116–118, 125, and 140–142 of the '236 Patent, which is substantively identical to the Roku IPR.

III. ANALYSIS OF THE PRECISE 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 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. *Kyocera Corporation v. Softview LLC,* IPR2013-00004, Paper 15, at 4 (April 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the Decision Granting Institution of *Inter Partes* Review dated December 4, 2024, (Paper 12) of the Roku IPR. 37 C.F.R. § 42.122(b). The current Petition is not subject to the one-year statutory time bar because it is accompanied by a request for joinder. 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).

C. Each Factor Weighs in Favor ofJoinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the Present Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Roku Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical, Petitioner agrees to be bound by the current Scheduling Order, and Petitioner will accept a passive "understudy" role (unless the petitioner in the Roku IPR ceases to participate). *See* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11, at 6; (granting IPR where petitioners requested an "understudy" role); *see also* IPR2015-01353, Motion for Joinder, Paper 4, at 5–7. Lastly, the briefing and discovery should see no change given Petitioner's passive "understudy" role where Petitioner will not actively participate in the proceeding unless petitioner in the Roku IPR ceases to participate.

Accordingly, joinder is appropriate. *See* IPR2015-01353, Decision Instituting IPR Review, Motion for Joinder, Paper 11, at 5–6 (granting institution of IPR and motion for joinder where petitioners relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration."); *see also* IPR2015-01353, Motion for Joinder, Paper 4, at 4–5.

1. Joinder is Appropriate

Joinder with the Roku IPR is appropriate because the Present Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Roku IPR. *Id.* The Present Petition is substantively identical to the Roku Petition, containing only minor differences related to the formalities of a different party filing the petition. There are no changes to the facts, citations, evidence, or arguments presented in the Roku Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Roku IPR so that the Board can efficiently resolve all grounds in both the Present Petition and Roku Petition together. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The Present Petition presents the same grounds of unpatentability as the Roku Petition.

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

Because the Present Petition is substantively identical to the Roku Petition, with the same grounds rejecting the same claims as instituted by the Board, there are no new substantive issues for Patent Owner to address, and Petitioner's proposed "understudy" role will allow the Roku IPR to proceed in the same manner and timeframe as already prescribed in the Scheduling Order.

Specifically, Petitioner agrees that it will take a passive "understudy" role in the Roku IPR proceeding and not actively participate unless the petitioner in the Roku IPR ceases to be involved. Under this "understudy" role, Petitioner agrees that:

- Petitioner shall be bound by the Scheduling Order in the Roku IPR.
- Petitioner shall not make any substantive filings and shall be bound by the filings of the petitioner in the Roku IPR, unless a filing concerns termination or settlement, a filing solely involves Petitioner, or petitioner in the Roku IPR ceases to participate.
- Petitioner shall not present any argument or make any presentation at oral hearing unless an issue solely involves Petitioner, or when addressing Board-approved motions that do not affect the petitioner in the Roku IPR, or unless petitioner in the Roku IPR ceases to participate.
- Petitioner shall not seek to take a deposition or defend a deposition of any witness, unless the topic of examination concerns issues solely involving Petitioner, or petitioner in the Roku IPR ceases to participate.
- Petitioner shall not seek discovery unless petitioner in the Roku IPR ceases to participate and discovery is needed.
- Petitioner will not rely on expert testimony beyond that submitted by the petitioner in the Roku IPR unless the petitioner in the Roku IPR ceases to participate in the proceeding.

Petitioner will also abide by any additional conditions the Board deems appropriate for an "understudy" role. Given the terms of Petitioner's proposed "understudy" role, Petitioner respectfully submits that joining the Roku IPR will not require any delay or modification and will not unduly prejudice any party or the Board. "Thus [] granting the Motion for Joinder would help 'secure the just, speedy, and inexpensive resolution of these proceedings." IPR2024-00774, Paper 24, at 18–20 (PTAB Oct. 11, 2024) (granting institution and joinder where petitioner agreed to take an "understudy" role).

Due to the same issues being presented in the Roku Petition, Patent Owner will not be required to present any additional responses or arguments. *See* IPR2015-01353, Decision Instituting IPR, Motion for Joinder, Paper 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]."); *see also* IPR2015-01353, Motion for Joinder, Paper 4, at 5–7. Further, the Patent Owner Preliminary Response (Paper 7), Petitioner's Reply to Patent Owner's Preliminary Response (Paper 8) and Patent Owner's Preliminary Sur-Reply (Paper 10) already filed in the Roku IPR prior to the Board's institution decision address any and all issues in the Present Petition because the issues are substantively identical to the issues of the Roku Petition. *See* IPR2024-01024.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Roku Petition are identical to the issues presented in the Present Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Roku Petition. Also, because the Present Petition relies on the same expert and an identical declaration, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the Roku IPR does 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 Petition with the Roku IPR.

4. Procedures to Simplify Briefing and Discovery

The Roku Petition and Present Petition present substantively identical grounds of rejection, including the same art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an "understudy" role, as described in the proceeding section. Petitioner will assume an active, primary role only if Roku ceases to participate in the Roku IPR.

By Petitioner accepting an "understudy" role, Patent Owner and Petitioner 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 potentially may result by joinder. *See* IPR2015-01353, Decision Instituting IPR, Paper 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 petitioners agreed to an "understudy" role.); *see also* IPR2015-01353, Motion for Joinder, Paper 4, at 6–7.

IV. *GENERAL PLASTIC* IS INAPPLICABLE

Petitioner respectfully submits application of the *General Plastic* analysis is inapplicable here. In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. In the current motion, Petitioner merely seeks to join Roku's petition and does not present any new grounds. As such, Petitioner respectfully submits that *General Plastic* does not apply in this circumstance because Petitioner would be taking an understudy role and the Board's finite resources would not be impacted. Moreover, a joinder petition in these circumstances is not the type of serial petition to which *General Plastic* applies, especially as Petitioner has not previously filed an IPR against the '236 Patent.[2] The PTAB has previously stated that a joinder petition

[2] As explained in Footnote 1, Petitioner is filing three concurrent petitions challenging different claims of the '236 Patent in the same manner as Roku solely

"effectively neutralizes" a *General Plastic* analysis. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13, at 10 (PTAB Aug. 21, 2018) (instituting a joinder petition where joinder petitioner previously filed a non-instituted IPR, stating joinder petitioner's joinder motion agreeing to a passive understudy role "effectively neutraliz[es] the *General Plastic* factors"); *see also Celltrion, Inc. v. Genentech, Inc.,* IPR2018-01019, Paper 11, at 10 (PTAB Oct. 30, 2018) (instituting a joinder petition where joinder petition previously filed a non-instituted IPR, stating the joinder motion "effectively obviates any concerns of serial harassment and unnecessary expenditure of resources").

In the event the Board does analyze the *General Plastic* factors, those factors heavily weigh in favor of instituting the present 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).

Regarding the first factor, Petitioner has not previously filed a petition against the '236 Patent other than the three concurrently filed copycat petitions (where three are filed solely based on the amount and length of claims as explained in the Roku IPRs). Because none of the three concurrently filed copycat petitions challenge the

for word count purposes considering the amount and length of the claims. The Board declined to exercise discretionary denial on this basis. IPR2024-01024, Paper 12, at n.5 (PTAB Dec. 4, 2024) (granting institution of *inter partes* review).

same claim and Petitioner has not otherwise challenged the validity of the '236 Patent in a petition, this factor weighs in favor of institution.

The second factor is whether at the time of filing the first petition the petitioner knew or should have known of the prior art asserted in the second petition. This factor is neutral, if not inapplicable, in the *General Plastic* analysis. Here, Roku's petition and Present Petition share the same prior art because the Present Petition is a "copycat" of Roku's petition. Because Petitioner is merely seeking to join in an understudy role, the factor is neutral, at best, in determining whether to institute.

The third factor is whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition. Because this is a Motion for Joinder requesting an understudy role, Petitioner is submitting a substantively identical petition and has not added to, or changed, any of the substantive arguments from the Roku petition. Moreover, because the present Petition is submitted as a joinder and Petitioner will serve an understudy role, the Petition is not an attempt to harass the Patent Owner or otherwise engage in serial, tactical filings. Thus, this factor weighs against denial of joinder/institution.

The fourth factor is the length of time elapsed between the time the petitioner learned of the prior art asserted in the second petition and filing of the second

petition, and the fifth factor is whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent. In the context of a joinder motion where Petitioner will be taking an understudy role, these factors are inapplicable.

The sixth factor is the finite resources of the Board. Allowing Petitioner's joinder motion where it will serve in an understudy role will not impact the Board's resources beyond those resources the Board dedicates to the instant joinder motion.

The seventh factor is the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review. As noted above, joining Petitioner should not impact the schedule. Accordingly, this factor weighs in favor of institution.

An eighth factor identified by the Board in *Shenzhen* is the extent to which the petitioner and any prior petitioner(s) were similarly situated defendants or otherwise realized a similar-in-time hazard regarding the challenged patent. *Shenzhen Silver Star Intelligent Tech. Co., Ltd. v. iRobot Corp.,* IPR2018-00898, Paper 9, at 7, 13–14 (PTAB Oct. 1, 2018) (noting "the purpose of proposed Factor 8 is to discourage tactical filing of petitions over time by parties that faced the same threat at the same time" such that earlier petitions are filed as "test case(s)" to gain "tactical advantage"). Because the Present Petition does not introduce any new

grounds of unpatentability and will effectively merge into the same proceeding with Roku's IPR, no such tactical advantage is gained here.

Thus, none of the *General Plastic* factors weighs against institution and joinder in this situation.

V. *FINTIV* IS INAPPLICABLE

The Board's "analysis under *Fintiv* is guided by the USPTO Director's Memorandum issued on June 21, 2022, titled 'Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation' ('Director's Memo')." IPR2024-00099, Paper 11, at 21 (PTAB May 9, 2024) (granting motion for joinder of copycat petition with an understudy role where petitioner timely moved for joinder and provided "a stipulation like in *Sotera*"). "Pursuant to the Director's Memo, [the Board] 'will not discretionarily deny institution . . . where a petitioner presents a [*Sotera*] stipulation." *Id.*

Because Petitioner here presents such a stipulation in the Present Petition accordance with *Sotera* (i.e., "Petitioner stipulates if the present proceeding is instituted and joined with the Roku IPR, it will not pursue in the district court litigation any ground that was raised or could have been reasonably raised in an IPR in accordance with *Sotera*"), the Board should not exercise its discretion to deny institution under *Fintiv.* Further, the Board should not deny institution based on *Fintiv* if there is compelling evidence of unpatentability, which the Present Petition

provides. *Nokia of Am. Corp. v. TQ Delta, LLC*, IPR2022-00471, Paper 11, at 19–21 (Aug. 18, 2022).

VI. CONCLUSION

Based on the factors discussed above, Petitioner respectfully requests that the Board grant the Present Petition for *Inter Partes* Review of U.S. Patent No. 8,291,236 and then grant joinder with the *Roku, Inc.*, IPR2024-01024 proceeding.

Date: December 17, 2024

Respectfully submitted,

BY: */s/ Eric A. Buresh*

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CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on December 17, 2024, a complete and entire copy of this *Motion For Joinder Under 35 U.S.C. § 325(c) AND 37 C.F.R. § 42.122(b) To Related Inter Partes Review IPR2024-01024* was provided via Federal Express to the Patent Owner by serving the correspondence address of record for the '236 Patent:

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Further, a courtesy copy of this *Motion For Joinder Under 35 U.S.C. § 325(c) AND 37 C.F.R. § 42.122(b) To Related Inter Partes Review IPR2024-01024 Motion For Joinder Under 35 U.S.C. § 325(c) AND 37 C.F.R. § 42.122(b) To Related Inter Partes Review IPR2024-01024* was sent via email to Petitioner's and Patent Owner's counsel for IPR2024-01024:

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Further, a courtesy copy of this *Motion For Joinder Under 35 U.S.C. § 325(c) AND 37 C.F.R. § 42.122(b) To Related Inter Partes Review IPR2024-01024* was sent via email to Patent Owner's litigation counsel:

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