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Paper No. ____
Date: January 16, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2025-00305
Patent 8,291,236

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

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EXHIBIT LIST

Exhibit Number	Description
2001	Scheduling Order from *Roku Inc. v. VideoLabs, Inc.*, IPR2024-01024, Paper 13 (PTAB Dec. 5, 2024)
2002	Notice of Agreed Extension of Time to Respond to Plaintiff's Amended Complaint in *VideoLabs, Inc. v. ASUSTeK Computer Inc. et al.*, Civil Action No. 6:22-cv-00720, D024 (W.D. Tex. Nov. 10, 2023) ("Agreed Extension")
2003	Amended Complaint in *VideoLabs, Inc. v. ASUSTeK Computer Inc. et al.*, Civil Action No. 6:22-cv-00720, D009 (W.D. Tex. Nov. 2, 2023) (without Exhibits) ("Complaint")
2004	Pacer Civil Docket for *VideoLabs, Inc. v. ASUSTeK Computer Inc. et al.*, Civil Action No. 6:22-cv-00720 (W.D. Tex.) as of January 14, 2025 ("ASUSTeK Litigation")
2005	Declaration of Bryan C. Smith

I. INTRODUCTION AND PRECISE RELIEF REQUESTED

The motion for joinder (the "Motion") filed by ASUSTeK Computer, Inc. ("ASUSTeK" or "Petitioner") should be denied.

First, the proceeding ASUSTeK seeks to join is IPR2024-01024[1] (*Roku Inc. v. VideoLabs, Inc.*) filed June 14, 2024 (the "Roku IPR"), challenging U.S. Patent No 8,291,236 ("the '236 Patent"). That proceeding has a pending joint motion to terminate proceeding filed December 23, 2024 (Paper 14) ("Motion to Terminate"), based on a settlement between the parties in that proceeding. Thus, assuming the Board grants the Motion to Terminate (which is likely because the Motion to Terminate was filed well before the patent owner response deadline in that proceeding), the Roku IPR will be terminated prior to the Board's institution decision here. This means there will be no Roku IPR to which this proceeding could be joined. Thus, ASUSTeK's Motion will be rendered moot.

Second, ASUSTeK's Motion should be denied because permitting ASUSTeK to join the Roku IPR, despite the likely termination of that proceeding,

[1] Petitioner filed three copycat petitions (IPR2025-00304, IPR2025-00305, and IPR2025-00306) seeking to join the underlying Roku IPRs (IPR2024-01023, IPR2024-01024, and IPR2024-01025).

would allow ASUSTeK to circumvent 35 U.S.C. § 315(b) in a manner inconsistent with the purpose of the joinder mechanism.

ASUSTeK's Petition was filed more than a year after ASUSTeK was served with a complaint alleging infringement of the '236 Patent. Absent joinder, ASUSTeK's Petition would be statutorily time barred. Permitting joinder of a proceeding that otherwise will likely be terminated is inconsistent with the efficiency interests that underlie the joinder mechanism. This is evident since ASUSTeK argues for joinder premised on taking an "understudy" role, which is now inapplicable.[2] In fact, joinder here would continue a proceeding that would otherwise end, which is the opposite of efficient. This confirms that joinder here would provide an end-around the time bar in Section 315(b) in a manner inconsistent with the above-noted purpose of the joinder mechanism.

Third, ASUSTeK's Motion should be denied because joinder will negatively impact the Roku IPR trial schedule. The Board instituted trial in the Roku IPR on December 4, 2024 and issued a Scheduling Order (Paper 13) providing due dates of February 28, 2025 and May 23, 2025, respectively, for Patent Owner's response

[2] The Motion indicates that "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*." Motion, 2 (emphasis added).

to the petition and Petitioner's reply to Patent Owner's response. EX 2001, 12. In view of the Motion to Terminate, it is highly unlikely that a patent owner response or petitioner reply will be filed in the Roku IPR. Further, in this proceeding, the Patent Owner's Preliminary Response is not due until March 30, 2025, rendering an institution decision due date of June 30, 2025. Thus, in the unlikely event that the Roku IPR is not terminated prior to the institution decision, joinder would require significant changes to the Roku IPR trial schedule, because ASUSTeK's Petition would need to be instituted for any joinder to proceed. The Board should exercise its discretion to deny joinder for this additional reason.

II. RESPONSE TO STATEMENT OF MATERIALS FACTS

Patent Owner admits the facts set forth in paragraphs 1, 2, and 3 in Petitioner's Statement of Material Facts, denies the arguments and positions asserted in the IPR petitions referenced in those paragraphs, and denies that those paragraphs support grant of the relief requested in the Motion.

III. TERMINATION OF THE ROKU IPR WILL RENDER THE REQUEST FOR JOINDER MOOT

35 U.S.C. § 315(c) provides as follows:

> If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a

> petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

The Board has provided that joinder motions should be evaluated under the rules governing trial practice and procedure before the PTAB, which are "construed to secure the just, speedy and inexpensive resolution of every proceeding." *Kyocera Corp. v. Softview LLC*, IPR 2013-00004, Paper 15, at 3 (PTAB April 24, 2013) (citing 37 C.F.R. 42.1(b)). Those interests are not met here.

ASUSTeK's Motion should be denied because the Board will likely terminate the Roku IPR that ASUSTeK seeks to join prior to an institution decision here. Thus, there will be no proceeding to join. *See, e.g.*, *Amazon.Com, Inc., et al. v. Almondnet, Inc., et al.*, IPR2023-00227, Paper 10, at 8 (PTAB June 5, 2023) (holding that "[t]he Motion for Joinder is denied as moot because the [underlying] IPR has been terminated[.]")

On December 17, 2024, ASUSTeK filed its Petition and this Motion requesting joinder with the Roku IPR. Six days later, on December 23, 2024, the parties to the Roku IPR jointly filed an authorized Motion to Terminate as well as a copy of their settlement agreement. *See* IPR2024-01024, Paper 14 and EX 1018.

The Motion to Terminate is currently pending and is highly likely to be granted. Under 35 U.S.C. § 317(a), "[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." As the Board has held, settlements are favored and motions to terminate will typically be granted. *See, e.g.*, *Nokia of Am. Corp. v. TQ Delta, LLC*, IPR2022-00471, Paper 41, at 4 (PTAB Dec. 19, 2022) (stating "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding, and [t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." (quoting Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (internal quotations omitted)).

ASUSTeK's joinder request should be denied as moot based on the Motion to Terminate the Roku IPR. Specifically, the Roku IPR will likely no longer be pending at the time the institution decision will issue here (which date is on or before June 30, 2025). As a result, there will be no Roku IPR to which this proceeding could be joined.

The Board has routinely denied motions for joinder under such circumstances, explaining that the termination of the other proceeding renders a joinder motion moot. *See, e.g.*, *Hulu, LLC v. Sound View Innovations, LLC*,

IPR2018-00017, Paper 13, at 1 (PTAB Jan. 26, 2018) ("the Board terminated [the IPR to be joined] pursuant to 35 U.S.C. § 317(a) at the request of the parties to that proceeding . . . As such, Petitioner's request to join that proceeding as a party pursuant to 35 U.S.C. § 315(c) is moot."); *PAR Pharm., Inc. v. MonoSol Rx, LLC*, IPR2017-01557, Paper 9, at 5 (PTAB Oct. 5, 2017) (same); *Fresenius Kabi USA, LLC v. Hospira Inc.*, IPR2017-01055, Paper 10, at 5 (PTAB Sep. 6, 2017) (per curium) (same).

A scenario similar to (albeit less compelling than) the one presented here was addressed by the Board in *Amazon.Com, Inc., et al. v. Almondnet, Inc., et al.*, IPR2023-00227. In that proceeding, the Board terminated the underlying IPR (*Meta Platforms, Inc. v. Almondnet, Inc. et al.*, IPR2022-00773) and denied a pending motion for joinder as moot. *See* IPR2023-00227, Paper 10, at 8 (PTAB June 6, 2023). There, the Board instituted the underlying IPR on October 21, 2022 (*id.*, at 2; *see also* IPR2022-00773, Paper 6 (PTAB Oct. 21, 2022)) and a motion for joinder relying on a copycat petition was filed on November 18, 2022 (*see* IPR2023-00227, Paper 3 (PTAB Nov. 18, 2023)). Nearly <u>five months later</u>, on April 14, 2023, the parties to the underlying IPR submitted a joint motion to terminate. IPR2023-00227, Paper 10, at 2; *see also* IPR2022-00773, Paper 15 (PTAB Apr. 14, 2023)). The Board terminated the underlying IPR on June 2, 2023 (*see* IPR2022-00773, Paper 16 (PTAB June 2, 2023)), six days prior to denying the

joinder motion as moot, holding: "[t]he Motion for Joinder is denied as moot because the [underlying] IPR has been terminated[.]"). IPR2023-00227, Paper 10, at 8. On June 8, 2023, the Board likewise denied institution of the petition associated with the joinder motion based on the Section 315(b) time bar. *Id*., at 8. This is the scenario presented here, except that here, the Motion to Terminate was filed only six (6) days after this Motion.

In view of the above Board precedents, ASUSTeK's Motion should be denied as moot in view of the likely termination of the Roku IPR. Although the likely termination of the Roku IPR will be dispositive of this Motion, below Patent Owner presents additional reasons why the Motion should be denied.

IV. ASUSTEK SHOULD NOT BE PERMITTED TO CIRCUMVENT 35 U.S.C. § 315(b)

A. ASUSTeK's Petition Was Filed After The 1-Year Bar Date Under Section 315(b)

As Patent Owner's preliminary response will further explain, institution of ASUSTeK's Petition accompanying its Motion is improper because that Petition was "filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner [wa]s served with a complaint alleging infringement of the patent." 35 U.S.C. § 315(b).

ASUSTeK concedes that "ASUSTeK Computer Inc." is the "real party-in-interest." Pet., 5. ASUSTeK's Petition was filed December 17, 2024, one year,

one month and 15 days after November 2, 2023, the date on which ASUSTeK was effectively served with an amended complaint in *VideoLabs, Inc. v. ASUSTeK Computer Inc. et al.*, Civil Action No. 6:22-cv-00720, W.D. Tex. (the "ASUSTeK Litigation") (the "Complaint"), alleging infringement of the '236 Patent. EX 2002 [Agreed Extension]; EX 2003 [Complaint], ¶¶ 1, 61-67; EX2005.[3]

35 U.S.C. § 315(b) provides that:

> An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

There can be no dispute that, absent joinder, ASUSTeK's Petition would be statutorily time barred. Thus, in the event the Roku IPR is terminated,

[3] On August 22, 2022, ASUSTeK moved to stay the ASUSTeK Litgation (which was subsequently granted August 24, 2022 and lifted November 2, 2023 prior to the filing of the Complaint). *See* EX2004 [docket], D005, D006, D007, Nov. 2, 2023 Text Order; EX2005.

ASUSTeK's Petition must be denied institution. *See Amazon.Com, Inc.*, IPR2023-00227, Paper 10, at 7 ("The [underlying] IPR, however, has been terminated . . . Thus, there no longer is a pending proceeding in the [underlying] IPR for Petitioner to join. Accordingly, Petitioner's request to join the [underlying] IPR is moot, and *the Petition is not timely under 35 U.S.C. § 315(b)*.") (emphasis added).

B. Joinder Would Permit ASUSTeK to Circumvent Section 315(b) in a Manner Inconsistent with the Joinder Mechanism

While it is true that joinder motions are not subject to the Section 315(b) time bar, granting joinder here, even assuming *arguendo* that the Roku IPR is not terminated, would be inconsistent with the purpose of the joinder mechanism. As discussed above, the joinder provision of 35 U.S.C. § 315(c) must be "construed to secure the just, speedy and inexpensive resolution of every proceeding." *Kyocera Corp.*, IPR 2013-00004, Paper 15, at 3 (citing 37 C.F.R. § 42.1(b)). Indeed, ASUSTeK admits as much in the Motion by arguing "[t]hus [] granting the Motion for Joinder would help secure the just, speedy, and inexpensive resolution of these proceedings." Motion, 7 (internal quotations and citations omitted).

However, there is no efficiency benefit here. The parties in the Roku IPR have settled. ASUSTeK supports its joinder request by stating that it "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."

Motion, 2. Here, the parties in the Roku IPR will have ceased participation almost six (6) months before this Motion and institution will even be decided in this proceeding. Thus, grant of the Motion would functionally not be a joinder grant, but a grant of a new independent IPR proceeding for ASUSTeK. That would be a misapplication of the joinder rule and would allow ASUSTeK to side step the statutory bar of Section 315(b) in a manner inconsistent with the joinder mechanism. Thus, in view of the Motion to Terminate filed in the Roku IPR, this Motion should be denied.

V. EVEN IF JOINDER WERE AVAILABLE, IT SHOULD BE DENIED

Even assuming, *arguendo*, that: (i) the Roku IPR is not terminated prior to issuance of the institution decision in this proceeding; (ii) the petition were not time barred; and (iii) the Motion were not moot, ASUSTeK's joinder request should still be denied because joinder would negatively impact the schedule in the Roku IPR in view of the fact that the parties in the Roku IPR will no longer be participating.

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. *See Kyocera Corp.*, IPR 2013-00004,

Paper 15, at 3-4. As the moving party, ASUSTeK has the burden to establish entitlement to joinder. 37 C.F.R. §§ 42.20(c), 42.122(b).

As discussed above, factors (1) and (4) cannot be met because the Motion to Terminate makes joinder inappropriate and far from simplifying briefing and discovery. Joinder will continue a proceeding that would otherwise end.

Regarding factor (3), ASUSTeK's Motion asserts that "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." Motion, 5. That is now impossible in view of the Motion to Terminate, so an entirely new schedule would have to issue if joinder were allowed.

Based on the Motion to Terminate, the Roku IPR petitioner will no longer be participating and ASUSTeK would have to take a lead role. However, in the Roku IPR, the Patent Owner response to the petition and Petitioner's reply to Patent Owner's response are due on February 28, 2025 and May 23, 2025, respectively. EX 2001, 12.

Here, the institution decision is not due until June 30, 2025, which is after both of those dates. Thus, permitting joinder would require a significant alteration in the schedule, since ASUSTeK would have to take the lead role as petitioner, and it cannot do so until after the institution decision in this proceeding. Assuming

there is a proceeding available for joinder, in view of the impact on the schedule, joinder is disfavored and the Board should exercise its discretion to deny joinder.

Petitioner's sole statements on the impact on the Roku IPR schedule are premised on taking an "understudy" role. Motion, 5 ("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."). Thus, Petitioner fails to address any impact on the schedule of the Roku IPR. The Board has held that such a failure provides an alternative basis for denying joinder. *See Amazon.Com, Inc., et al. v. Almondnet, Inc., et al.*, discussed above. IPR2023-00227, Paper 10, at 7 ("[b]ecause Petitioner does not meaningfully address the impact joinder would have had on the [underlying] IPR schedule, joinder also would not have been appropriate.").

VI. CONCLUSION

Joinder should be denied because the Roku IPR will likely be terminated, rendering the motion for joinder moot. Further, the Petition underlying the joinder request is time-barred. Joinder also would be inappropriate, even if it were available, since joinder would significantly alter the schedule in the joined IPR. Accordingly, the Motion should be denied.

Respectfully submitted,

Date: January 16, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 16th day of January, 2025, I caused to be served a true and correct copy of **PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER (with EX2001-EX2005)** by e-mail on the following counsel of record (as agreed in the Service Information section of the Petition):

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