

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 B2

Before KARL D. EASTHOM, STACEY G. WHITE, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Dismiss the Petition
Denying Petitioner's Motion for Joinder
35 U.S.C. § 315 (b, c); 37 C.F.R. §§ 42.71(a), 42.122

I. INTRODUCTION

Petitioner ASUSTek Computer Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. § 311 requesting institution of *inter partes* review of claims 48–50, 57, 82–84, 91, 116–118, 125, and 140–142 of U.S. Patent No. 8,291,236 B2 (Ex. 1001, “’236 patent”). Paper 1 (“Pet.”). The Petition identifies *Roku Inc. v. VideoLabs, Inc.*, IPR2024-01024 as a related proceeding challenging the same claims of the ’236 patent that Petitioner challenges here (“Roku IPR”). Pet. 5. Petitioner filed a Motion for Joinder with the Petition that requested joinder of this proceeding as a “copycat” petition to the instituted Roku IPR. Pet. 5–6; Paper 4 (“Joinder Motion”); *see also* Roku IPR, Paper 12 (instituting Roku IPR).

On December 23, 2024, pursuant to our authorization, the parties in the Roku IPR filed a joint motion to terminate the proceeding due to settlement of all disputes between the parties related to the ’236 patent. Roku IPR, Paper 14. On January 3, 2025, Patent Owner VideoLabs, Inc. (“Patent Owner”) filed Mandatory Notices in this proceeding identifying the Roku IPR as a related proceeding, and Patent Owner further indicated the parties in the Roku IPR had filed a joint motion to terminate the Roku IPR due to settlement. Paper 7, 2. On January 16, 2025, Patent Owner filed an Opposition to Petitioner’s Joinder Motion in view of the settlement and joint motion to terminate the Roku IPR. Paper 8.

On January 21, 2025, we entered an Order terminating the Roku IPR (“Roku Termination Order”). Roku IPR, Paper 16.

On February 27, 2025, pursuant to our authorization, Petitioner filed a Motion to Withdraw the Petition “through dismissal.” Paper 9 (“Motion to Dismiss”), 1. Patent Owner, though authorized to file a response not later than

March 6, 2025, has not responded to Petitioner's motion. A preliminary response to the Petition is due to be filed no later than March 31, 2025.

We address Petitioner's Joinder Motion and Motion to Dismiss below.

II. DISCUSSION

The Board has broad discretion to dismiss a petition. 37 C.F.R. § 42.71(a) ("The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order."); *see also id.* § 42.5(a) ("The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part[.]"). Joinder of a party to an instituted inter partes review is also within the Director's sound discretion, which has been delegated to the Board. 35 U.S.C. § 315(c) ("[T]he Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition. That is, the statute requires the Director (or the Board on behalf of the Director) to make a 'joinder decision.'"); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321 (2020) ("[T]o effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to 'join as a party' the joinder applicant."). As we stated in the Roku Termination Order, "[w]e recognize that, if we terminate this proceeding, the [ASUS] motions for joinder may be moot and the petitions may be barred under 35 U.S.C. § 315(b)." Roku IPR, Paper 16, 2.

The parties agree that, absent joinder, § 315(b) bars the instant Petition. Joinder Motion, 3–4 ("[T]he current Petition is not subject to the one-year statutory time bar *because it is accompanied by a request for joinder.*" (emphasis added)); Opposition, 8 ("There can be no dispute that, absent joinder, ASUSTeK's Petition would be statutorily time barred."). Thus,

Petitioner relies on joinder to avoid the time bar of 35 U.S.C. § 315(b). Petitioner also acknowledges that, given our Roku Termination Order, Petitioner's Joinder Motion and Petition are moot and dismissal of this Petition is appropriate. Motion to Dismiss, 2. We agree. Our Roku Termination Order removed the statutory basis that underpins Petitioner's Joinder Motion, rendering it moot, because there is no longer an instituted Roku IPR for Petitioner to join.

Accordingly, we dismiss the Petition and deny the Joinder Motion.

III. ORDER

ORDERED that Petitioner's Joinder Motion is DENIED as moot; and, FURTHER ORDERED that Petitioner's unopposed Motion to Dismiss the Petition is GRANTED.

FOR PETITIONER

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