

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

REALTIME ADAPTIVE STREAMING, LLC,
Patent Owner.

Case IPR2019-00786
Patent 9,769,477

Before GEORGIANNA W. BRADEN, KEVIN W. CHERRY, and
KAMRAN JIVANI, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION

Granting Motion for Joinder

35 U.S.C § 314; 35 U.S.C § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, Comcast Cable Communications, LLC, filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–6, 9–14, 20–22, and 25–27 of U.S. Patent No. 9,769,477 B2 (Ex. 1001, “the ’477 patent”). Realtime Adaptive Streaming LLC, did not file a Preliminary Response.

Petitioner also filed a Motion for Joinder to join as a petitioner in IPR2018-01187. Paper 3 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on March 4, 2019, within one month after we instituted trial in IPR2018-01187.

As explained further below, we determine institution is warranted on the same grounds as instituted in IPR2018-01187 and grant Petitioner’s Motion for Joinder.

A. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), Petitioner identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 67.

B. *IPR2018-01187*

In IPR2018-01187, Netflix, Inc., challenged claims 1–6, 9–14, 20–22, and 25–27 of the ’477 patent. After considering the Petition and Patent Owner’s Preliminary Response, we instituted review of the claims challenged in that case. *Netflix, Inc. v. Realtime Adaptive Streaming LLC*, Case IPR2018-01187 (PTAB Feb. 4, 2019) (Paper 22, “Netflix Inst.”). Thus, the instituted review in IPR2018-01187 involves the following grounds of unpatentability:

References	Basis	Claims Challenged
Imai ¹	§ 103	1, 3–5, 12–14
Pauls	§ 103	1, 3–6, 9–14
Imai and Pauls ²	§ 103	1, 3–6, 9–14
Imai, Pauls, and Chao ³	§ 103	2, 11, 20–22, 25–27

Netflix Inst. 6–7. Netflix also relied on the Declaration of James A. Storer, Ph.D. (“Dr. Storer”) (IPR2018-01187, Ex. 1003). *See id.*

II. DISCUSSION

Petitioner’s Motion for Joinder states the Petition “challenges the same claims” and “asserts only the ground that the board has already instituted in the Netflix IPR,” while only relying “on the same exhibits and expert declaration” as submitted by Netflix. Mot. 6–7; *accord id.* (“because the invalidity grounds in the petition are identical to those instituted in the Netflix IPR, there are no new arguments for [Patent Owner] to address.”). Thus, for the same reasons stated in our Decision on Institution in IPR2018-01187, we determine institution is warranted here. *See generally* Netflix Inst.

Having determined that institution is warranted, we consider Petitioner’s Motion for Joinder. Section 315(c) provides, in relevant part,

¹ Japanese Patent Application Publication No. H11-331305, published Nov. 30, 1999 (Ex. 1005, “Imai”).

² European Patent Application Publication No. EP0905939A2, published Mar. 31, 1999 (Ex. 1007, “Pauls”).

³ International PCT Patent Application Publication No. WO 98/40842, published Sept. 17, 1998 (Ex. 1016, “Chao”).

that “[i]f more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.” When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *See Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Under the circumstances of this case, we determine that joinder is appropriate. Because the present Petition does not include any issues beyond those in the already instituted case, it will have minimal impact on the existing case. “Petitioner agrees to assume a limited ‘understudy’ role” and “would only take on an active role if Netflix were no longer a party to the IPR.” Mot. 8. Because Petitioner relies on the declaration as does Netflix, no additional depositions will be required. *See id.* at 7.

Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2018-01187. We limit Petitioner Comcast Cable Communications, LLC’s participation in the joined proceeding, such that (1) Netflix alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Comcast Cable Communications, LLC is bound by all filings by Netflix in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Comcast Cable Communications, LLC receives permission to file an independent paper. Comcast Cable Communications, LLC must obtain prior Board

authorization to file any paper or to take any action on its own in the joined proceeding, so long as Netflix remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in Case IPR2018-01187 and protects the interests of Netflix as original petitioner in Case IPR2018-01187, and of Patent Owner.

For the foregoing reasons, and with the limitations discussed above, Petitioner's Motion for Joinder is *granted*.

III. ORDER

Accordingly, it is:

ORDERED that a *inter partes* review is hereby instituted as to claims 1–6, 9–14, 20–22, and 25–27 of the '477 patent on the following asserted grounds:

- (1) Claims 1, 3–5, 12–14 under 35 U.S.C. § 103 as unpatentable over Imai;
- (2) Claims 1, 3–6, 9–14 under 35 U.S.C. § 103 as unpatentable over Pauls;
- (3) Claims 1, 3–6, 9–14 under 35 U.S.C. § 103 as unpatentable over Imai and Pauls; and
- (4) Claims 2, 11, 20–22, 25–27 under 35 U.S.C. § 103 as unpatentable over Imai, Pauls, and Chao;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2018-01187 is granted, and Comcast Cable Communications, LLC is joined as a petitioner in that case pursuant to 37 C.F.R. § 42.122, based on the conditions discussed above;

FURTHER ORDERED that the Petition is dismissed, pursuant to 37 C.F.R. § 42.71(a);

FURTHER ORDERED that the Scheduling Order in place for IPR2018-01187 (Paper 23) shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2018-01187;

FURTHER ORDERED that the case caption in IPR2018-01187 for all further submissions shall be changed to add Comcast Cable Communications, LLC Inc. as a named Petitioner after Netflix and to indicate by footnote the joinder of IPR2018-01187 to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2018-01187.

IPR2019-00786
Patent 9,769,477 B2

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Sample Case Caption

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Case IPR2018-01187⁴
Patent 9,769,477 B2

⁴ Comcast Cable Communications, LLC, which filed a petition in IPR2019-00786, has been joined as a party to this proceeding