

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2019-01612 (Patent 7,589,642 B1)
IPR2019-01613 (Patent 8,004,389 B1)
IPR2019-01614 (Patent 9,911,325 B2)¹

Before PATRICK M. BOUCHER, MINN CHUNG, and
SHARON FENICK, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.123(b)

On December 17, 2020, a conference call was held with the parties
to discuss Patent Owner's request for authorization to file a motion to submit

¹ The parties are not authorized to use this form of caption.

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supplemental information. Because of the proximity of the request to the scheduled oral hearing in these proceedings on December 22, 2020, we took the request under advisement.

Patent Owner seeks to move to submit a document titled “Rebuttal Expert Report of Stuart Lipoff Regarding Non-Infringement and Non-Domestic Industry (Technical Prong) of U.S. Patent Nos. 7,589,642, 9,911,325, and 10,593,196.” Patent Owner informs us that the document was served on December 7, 2020 in the parallel ITC proceeding, and contends that the document is evidence that Petitioner takes positions before the ITC that are inconsistent with positions Petitioner takes before the Board in these proceedings. Specifically, Patent Owner identifies positions taken by Dr. Lipoff in his “Rebuttal Expert Report” that bear on the “time information” and “timing information” limitations recited in certain of the challenged claims. Patent Owner contends that the document is relevant, could not have been obtained earlier, and that its consideration would be in the interest of justice, thereby meeting the requirements of 37 C.F.R. § 42.123(b).

Petitioner opposes Patent Owner’s request and contends that, because the document is a “Rebuttal Expert Report,” its submission as supplemental information would require submission of additional documents to provide context for Dr. Lipoff’s assertions.

We deny Patent Owner’s request. At the oral hearing, we explored the “time information” and “timing information” limitations with the parties. We do not discern that potentially inconsistent positions by Petitioner with respect to those limitations would bear significantly on our consideration of

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the issues before us. Furthermore, we agree with Petitioner that, should the document be received into evidence, it would likely be necessary for us to receive additional evidence filed in the ITC proceeding, i.e., a proceeding before a different tribunal that applies different standards, to provide context. We are not persuaded that such additional complexity is warranted in light of our understanding of the issues as presented during the oral hearing.

Accordingly, it is

ORDERED that Patent Owner's request for authorization to file a motion to submit supplemental information is *denied*.

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For PETITIONER:

Jon Wright
Lestin Kenton
Daniel Block
Tim Tang
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
jwright-ptab@sternekessler.com
lkenton-ptab@sternekessler.com
dblock-ptab@sternekessler.com
ttang-ptab@sternekessler.com

For PATENT OWNER:

Benjamin Pleune
Ryan Koppelman
Thomas Davison
James Abe
Caleb Bean
Derek Neilson
Nicholas Tsui
ALSTON & BIRD LLP
ben.pleune@alston.com
ryan.koppelman@alston.com
tom.davison@alston.com
james.abe@alston.com
caleb.bean@alston.com
derek.neilson@alston.com
nick.tsui@alston.com