

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS INC.,
Patent Owner.

Case IPR2019-01614
U.S. Patent 9,911,325

PATENT OWNER SUR-REPLY

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UPDATED LIST OF EXHIBITS

Exhibit No.	Description
EX2001	Roku's Proposed Constructions in the District Court
EX2002	Claim Construction Order, <i>UEI, Inc. v. Peel Techs., Inc.</i> , Case No. 8:13-cv-01484 (C.D. Cal. Sep. 17, 2017) (Dkt. 66).
EX2003	Declaration of Dr. Michael D. Sprenger in support of Patent Owner's Response to Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,911,325 ("Sprenger Decl.")
EX2004	U.S. Patent. No. 5,963,624 to Pope ("Pope")
EX2005	U.S. Patent No. 8,004,389 ("the '389 Patent")
EX2006	Prosecution History of U.S. Patent Application No. 13/068,820
EX2007	IPR2019-01612, EX1002, Prosecution History of U.S. Patent No. 7,589,642
EX2008	IPR2019-01612, Transcript of Deposition of Dr. Russ, dated June 17, 2020 ("Russ Depo Tr. (June 17, 2020)")
EX2009	IPR2019-01613, Transcript of Deposition of Dr. Russ, dated June 18, 2020 ("Russ Depo Tr. (June 18, 2020)")
EX2010	Transcript of Deposition of Dr. Russ, dated June 19, 2020 ("Russ Depo Tr. (June 19, 2020)")
EX2011	IPR2019-01612, EX1003, Declaration of Dr. Samuel H. Russ ("Russ Decl. 642 Patent")
EX2012	August 19, 2020 Transcript, <i>Certain Electronic Devices, Including Streaming Players, Televisions, Set Top Boxes, Remote Controllers, and Components Thereof</i> , ITC Inv. 337-TA-1200

I. Introduction

To support its obviousness positions, Petitioner actively ignores the file history and claim language that showing that the plain and ordinary meaning of certain claim terms is narrower than Petitioner would like them to be. After expanding the meaning of these claim terms, Petitioner then uses the '325 Patent as a roadmap to cobble together various references to attempt to show the limitations present in the '325 Patent claims. Petitioner asserts, without support, that modulating onto a carrier signal is required, and then, using only hindsight, combines disparate references, some of which happen to mention modulation. However, Petitioner ignores that its expert, Dr. Russ, admitted that modulating information onto a carrier signal would not have been required to transmit information, that modulating onto a carrier signal was but one protocol that was available, and that a POSITA would have needed to consider whether modulation onto a carrier signal (or even modulating at all) was desirable given the increased cost and complexity of the resulting system—an analysis which he did not perform. Meanwhile, the primary references cited by Petitioner teach reducing cost and complexity, which Dr. Russ emphasized at this deposition and which Petitioner fails to address in its Reply.

Recognizing these weaknesses in its arguments, Petitioner offers a slew of new arguments in its Reply that were not presented in the Petition. Due to the

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