

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

Case IPR2019-01615
U.S. Patent 9,716,853

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

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The Board should not exercise its discretion under § 325(d). Chardon (EX1005) is the primary reference in this IPR. Despite being presented with Chardon in an IDS, the Examiner overlooked the fact that Chardon discloses the very feature that the patentee argued was missing from the applied references during prosecution. Moreover, the Petition presents grounds relying on secondary references that were never considered by the Examiner.

The Board seeks supplemental briefing in view of its recent decision setting forth a two-part test for applying its discretion under § 325(d): “(1) whether the same or substantially the same art previously was presented to the Office”; and if so “(2) ... whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. Med-El Elektr. Gerate GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential); Paper 7 at 2-3. As explained below, the *Advanced Bionics* test confirms that the Board should not exercise its discretion under 325(d).

I. The Petition Includes Grounds Relying on Non-Cumulative Prior Art that Was Not Previously Presented to the Office.

As the Petition explains, “[t]he primary reference to Chardon (EX1005) was cited, but not applied, during prosecution.” Pet 9. Specifically, UEI included Chardon in an IDS filed at the beginning of prosecution. EX1002, 79-82 (IDS filed 4/26/16). If Chardon were the only art asserted in this IPR, it may be sufficient to meet the first part of *Advanced Bionics*’ framework. *Id.*, at 7-8. However, the

Petition includes grounds relying on additional non-cumulative prior art.

In particular, the HDMI specification (EX1010), which was never presented to the Examiner, discloses the details of the operation of the HDMI standard's CEC, EDID, and Hot Plug Detect Features. Pet 29-31, 44-45, 69-70 (describing automatic detection and identification of devices via EDID). HDMI discloses the '853 patent's claim 1 requirement that the UCE "respond[s] to a detected presence of an intended target appliance within a logical topography of controllable appliances," as well as the limitations of claim 7. Pet 42-46, 69-70. HDMI is also non-cumulative of the Deng and Hayes references which the examiner relied on during prosecution, as neither of those references even mention HDMI. *See supra*. Stecyk (EX1006) creates a "listing" (Pet 53-56), and was also never presented to the Examiner. Accordingly, the present Petition does not present "the same or substantially the same" art or arguments previously presented to the Office. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. *Becton Dickinson* factors (a) and (b) thus also weigh in favor of institution,

II. The Examiner Materially Erred in Not Using Chardon to Reject the Claims Presented During Prosecution.

Under the second part of the *Advanced Bionic* framework, an Examiner errs where they "misapprehend[] or overlook[] specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims." *Id.*, at 8-9. That is exactly what happened during the prosecution of the '853 Patent.

1. In particular, the Examiner initialed the IDS listing, *inter alia*, the Chardon reference on 10/26/16. EX1002, 182-185. Nine days later, the Examiner issued a first Office Action on the merits, *id.*, 167-79 (OA dated 11/4/16), rejecting independent claim 1 over Hayes in view of Deng, *id.*, 170. As explained in the Petition, the patentee traversed the first rejection over Hayes in view of Deng by arguing that the cited art failed to describe at least the feature of “using an identity associated with an intended target appliance to create a listing ...” Pet 8-9, *citing* EX1002, 0207. Specifically, UEI argued that “[n]owhere does Hayes disclose, teach, or suggest that the identity of an appliance is used to create a listing wherein a first communication method and a second communication method are identified for use in controlling *each of* a first functional operation and a second functional operation of that identified appliance as claimed.” EX1002, 207-208 (original emphasis). The patentee further emphasized that “while Hayes may generally disclose” using two protocols, “Hayes does not disclose, teach, or suggest *using an identify* [sic] *of an appliance to create a listing* wherein at least two of such communication protocols” are identified for use in controlling each of first and second functional operations of the identified appliance as claimed.” *Id.* (original emphasis). The patentee thus focused heavily on ascertaining the identity of the target appliance in distinguishing Hayes over independent claim 1.

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