UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS INC.,
Patent Owner.

_____

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

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PATENT OWNER'S AUTHORIZED SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

The Board should deny institution because the facts in this case are analogous to those in *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020). In *Advanced Bionics*, the Board denied institution under § 325(d) of grounds that included art considered by the Examiner in combination with non-considered art because the petitioner used the non-considered art in substantially the same manner as the art considered by the Examiner. Here, it is undisputed that Petitioner's primary reference Chardon was before the Examiner during prosecution (Reply at 1, 3). Because Petitioner's two additional references not before the Examiner are used in substantially the same manner as Chardon, the Board likewise should deny institution under § 325(d).

I. Petitioner Fails the Two-Part Framework of § 325(d)

In *Advanced Bionics*, the Board sets forth a two-part framework under § 325(d), in which if the first part of the framework is met, the Petitioner bears the burden of satisfying the second part in order to avoid denial of institution:

> (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, ***whether the petitioner has demonstrated*** that the Office erred in a manner material to the patentability of challenged claims.

IPR2019-01469, Paper 6 at 8 (emphasis added). Critically, "[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it ***cannot*** be said that the Office erred in a manner material to patentability." *Id*. at 9 (emphasis

added). In this case, Petitioner fails both parts of the *Advanced Bionics* framework.

A. Petitioner Fails Part One of the Framework

Previously presented art includes "art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent." *Id.* at 7–8. Petitioner admits that "UEI included Chardon in an IDS filed at the beginning of prosecution" and that "[i]f Chardon were the only art asserted in this IPR, it may be sufficient to meet the first part of *Advanced Bionics'* framework" (Reply at 1). But then, Petitioner makes the same mistake as in *Advanced Bionics* and does not dispute that it uses the references not before the Examiner in substantially the same manner as Chardon such as to disclose the same information. The facts here are analogous to *Advanced Bionics*, and thus Petitioner fails part one of the framework.

In *Advanced Bionics*, the grounds involved one reference that was considered during prosecution in combination with additional references that were not. *Id.* at 14. The Board rejected petitioner's argument that because the additional references "were not of record during prosecution [ ], there are 'significant and material differences between the prior art asserted in this Petition and the prior art evaluated during prosecution.'" *Id*. at 15, 19. Rather, the Board evaluated "whether Petitioner relies on [additional references] in substantially the same manner as the Examiner cited [considered reference] during prosecution such that [additional references]

discloses substantially the same information as [the considered reference]." *Id*. at 15. The Board found that because the petitioner relied on the additional references to disclose the same information already evaluated in the considered reference, the additional references were substantially the same as the prior art already considered. *See*, *e.g.*, *id*. at 15-18. Here, Petitioner makes the same mistake as in *Advanced Bionics* and uses the HDMI reference and Stecyk (not before the Examiner) in substantially the same manner as Chardon such as to disclose the same information.

In particular, Petitioner relies on the HDMI reference for "describing automatic detection and identification of devices via EDID" (Reply at 2). But Petitioner relies on the same information in Chardon (*id*. at 4-5) ("Chardon . . . queries an intended appliance to receive EDID . . . which is available for any HDMI compatible display"). Likewise, Petitioner argues that "Stecyk (EX1006) creates a 'listing' (Pet 53-56)" (*id*. at 2) but again relies on the same information in Chardon (Pet. at 53) ("the command code database built/propagated by Chardon constitutes a 'listing' of different command codes"). Because Petitioner uses the additional references in substantially the same manner as Chardon, and offers no argument to the contrary, Petitioner fails part one of the *Advanced Bionics* framework.

Instead of explaining how the HDMI reference or Stecyk are non-cumulative of Chardon, Petitioner argues that they are non-cumulative of Hayes and Deng (Reply at 2). These arguments are irrelevant to the cumulativeness with Chardon,

which was the basis of the analysis in the Patent Owner's Preliminary Response (POPR at 15-19). Thus, Petitioner fails the first part of the *Advanced Bionics* framework, and bears the burden to satisfy the second part, which it also fails to do.

B. Petitioner Fails Part Two of the Framework

Under the second part of the framework, "[P]etitioner [must have] pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art." *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. It is not enough that the additional prior art was not in front of the Examiner during prosecution. *Id*. at 20. Petitioner must "overcome persuasively [a] specific finding of record" or demonstrate some "misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims." *Id.* at 10-11, 8–9 n.9. When "the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute." *Id.* at 9. Critically, "[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability." *Id.* at 9.

Here, Petitioner alleges that the Examiner erred in failing to find that Chardon "discloses using an identity associated with the detected target appliance . . . to create a listing" (Reply at 5), but admits that this claim element was specifically discussed during prosecution a mere nine days after the Examiner considered Chardon (*id*. at 3-4). Chardon would have been fresh in the Examiner's mind when the Notice of

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