

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner

Case Nos. IPR2020-00951 and IPR2020-00953
Patent 9,911,325

**PETITIONER'S NOTICE RANKING PETITIONS FOR *INTER*
PARTES REVIEW OF U.S. PATENT NO. 9,911,325**

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I. Introduction

Petitioner is simultaneously filing two petitions (IPR2020-00951 and IPR2020-00953) challenging the patentability of certain claims in U.S. Patent No. 9,911,325. Currently pending IPR2019-01614 (instituted April 16, 2020) challenges different claims of the '325 patent. Petitioner has filed a Motion to join the two Petitions referenced here with IPR2019-01614.

Under the Board's November 2019 Consolidated Trial Practice Guide ("TPG"), Petitioner submits this paper with each petition to rank the petitions, explain their differences, and advocate for institution of both. Trial Practice Guide, 59-60 (Nov. 2019).

The Board should consider the merits of the petitions in the following order:

(1) IPR2020-00951 ("the Rye/Caris Petition"); and (2) IPR2020-00953 ("the Chardon Petition").

II. Succinct Explanation of Differences between the Petitions

Petitioner challenges the claims of the '325 patent in the following manner:

IPR2020-00951			
Ground	Basis	References	Claims
1	§103	Rye, Skerlos	1
A	§103	Rye, Skerlos and Woolgar	8, 9, 11-13, 15-16
B	§103	Rye, Skerlos, Gutman	6
C	§103	Rye, Skerlos, Woolgar, Gutman	14
2.A	§103	Caris, Dubil	1, 6, 8, 16
D	§103	Caris, Dubil, Woolgar	8, 9, 11-16
IPR2020-00953			

Ground	Basis	References	Claims
1	§103	Chardon	9, 11-15

The main difference between the two petitions is the prior-art dates of the asserted references. In Rye/Caris Petition all references predate December 16, 2003. In the Chardon Petition, on the other hand, Chardon predates May 13, 2016, the earliest filing date Petitioner believes that the '325 patent can claim priority for independent claim 9. Petitioner must therefore demonstrate that claim 9 of the '325 patent is not entitled to its earliest priority date for Chardon to qualify as prior art. The other main difference is that the Rye/Caris Petition utilizes the same primary references from the currently instituted IPR2019-01614, while the Chardon petition is narrowly tailored to use art specifically based on the '325 patent's priority date for independent claim 9, as discussed below. Accordingly, the obviousness grounds also contain material differences. Although each set of references discloses every claim element, they do not use identical language or the same level of detail. For example, in the Chardon Petition, the Chardon reference discloses almost all (if not all) of the claim elements. On the other hand, the Rye/Caris Petition relies on a combination of references to establish the obviousness of the challenged claims along with various motivations to combine. Accordingly, the petitions have different starting points and different rationales as to why the challenged claims are obvious.

III. The Board should exercise its discretion to institute both petitions.

The TPG gives two reasons why multiple petitions may be necessary: (1) “when the patent owner has asserted a large number of claims in litigation” or (2) “when there is a dispute about priority date.” TPG, 59. Here, both reasons apply.

First, Patent Owner served Petitioner, on September 18, 2018, with a district court complaint alleging infringement of the ’325 patent. On December 24, 2018, Patent Owner served infringement contentions in the district court litigation asserting, in relevant part, claims 1, 2, 4, and 7 of the ’325 patent. On March 14, 2019, the district court granted Petitioner’s request that Patent Owner select a subset of its asserted claims across the six patents-in-suit. In response, on April 5, 2019, Patent Owner elected to only proceed on claim 2 of the ’325 patent. Then, one year later, on September 18, 2019, Petitioner filed a petition for *inter partes* review challenging claims 1, 2, 3, 4, 5, and 7 of the ’325 patent. The Board instituted trial in IPR2019-01614 on April 16, 2020. At about the same time as trial was instituted, and over 18 months after serving the complaint in the district court action, Patent Owner filed an ITC complaint under 19 U.S.C. § 1337 against Petitioner. Among the claims asserted in the ITC complaint, Patent Owner newly introduced claims 6, 8, 9, and 11-16 of the ’325 patent, which were never asserted in the district court case. Independent claim 9 is a new lengthy claim and claims

11-15 depend from claim 9. Two petitions are warranted due to Patent Owner's addition of various new and lengthy claims at the ITC.

Second, two petitions are also warranted because the parties will dispute the '325 patent's priority date. The '325 patent's priority date has not been decided, so Petitioners' provide two petitions with invalidating art based on different possible priority dates. The Rye/Caris Petition is based on a priority date no earlier than December 16, 2003—the filing date of the '325 patent's earliest parent, the '642 patent. The Chardon Petition, on the other hand, is based on a priority date no earlier than May 13, 2016—the earliest priority date the '325 patent is entitled for claim 9 and 11-15.

Specifically, the '325 patent claims priority to U.S. Patent No. 7,589,642 which lists the earliest priority date of the '325 patent as December 16, 2003. *See* EX1001, (22). However, claims 9 and 11-15 are not entitled to this priority date, because the '325 patent does not disclose at least the following elements of independent claim 9: (i) a “second transmitter” or (ii) “transmit[ting] [a] formatted key code to [a] second device in a keycode signal via use of the second transmitter and a second communication protocol when it is determined that the second device is not responsive to [a] key code signal transmitted via use of the first transmitter and the first communication protocol.” These elements are also unsupported by other applications in the family. To the extent that Patent Owner argues that U.S.

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