DOCKET

## 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

DECLARATION OF DR. MICHAEL D. SPRENGER IN SUPPORT OF PATENT OWNER'S RESPONSE TO PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,911,325

Universal Electronics Inc. Exhibit 2003

A L A R M Find authenticated court documents without watermarks at <u>docketalarm.com</u>.

DOCKET

## **TABLE OF CONTENTS**

I. INTRODUCTION	1
II. QUALIFICATIONS	2
III. MATERIALS CONSIDERED	9
IV. LEGAL PRINCIPLES1	0
A. Priority1	0
B. Anticipation	1
C. Obviousness	2
D. Claim Construction	3
V. PERSON OF ORDINARY SKILL IN THE ART 1	3
VI. BACKGROUND1	5
A. Technology Background 1	5
1. Remote Control of Electronic Devices	5
2. Universal Remote Controls	2
B. U.S. Patent No. 9,911,325	3
C. Prosecution History	8
1. Applicant distinguished translating or converting a control signal from "receiving a keystroke indicator signal" and then "generating a key code within a key code generator device using the keystroke indicator signal"	8
<ol> <li>Applicant distinguished "a key code signal" from "a codeset"</li></ol>	
3. Appeal Board rejected Examiner's argument that prior art disclosed modulating a key code onto a carrier signal	у
D. Prior Denial of Institution for Inter Partes Review of '642 Patent (IPR2014-01082) 3	3
VII. Decision to Institute the Present Inter Partes Review	4
VIII. ASSERTED PRIOR ART REFERENCES	5
A. U.S. Patent Application Publication No. 2004/0080428 ("Rye")	5
B. U.S. Patent No. 4,426,662 ("Skerlos")	6
C. U.S. Patent No. 7,562,128 ("Caris")	7
D. U.S. Patent No. 8,132,105 ("Dubil")	8
IX. OPINIONS	0
A. Terms for Claim Construction	0
1. "key code"	0
2. "keystroke indicator"	1

i

Universal Electronics Inc. Exhibit 2003

#### Case IPR2019-01614 U.S. Patent 9.911.325

	rate	int 9,911,525	
	3.	"key code signal"	12
	4.	"generate a key code using the keystroke indicator signal"	14
B	. (	Ground 1: Rye and Skerlos	46
	1.	A POSITA would not have combined Rye with Dubil	46
	2.	Rye and Skerlos do not render obvious Claim 1	52
	a. and 1	Rye and Skerlos do not disclose [1.3]: "a processing device coupled to the receiver the transmitter"	53
	b. the p	Rye and Skerlos do not disclose [1.4]: "a memory storing instructions executable by processing device, the instructions causing the processing device to"	
	recei	Rye and Skerlos do not disclose [1.4.1]: "generate a key code using a keystroke cator received from a third device in communication with first device via use of the iver, the keystroke indicator having data that indicates an input element of the third ce that has been activated"	58
	d. seco	Rye and Skerlos do not disclose [1.4.2]: "format the key code for transmission to the nd device"	
	e. seco	Rye and Skerlos do not disclose [1.4.3]: "transmit the formatted key code to the nd device in a key code signal via the use of a transmitter"	58
	key ( from	Rye and Skerlos do not disclose [1.4.4]: "wherein the generated key code comprises of a plurality of key code data stored in a codeset, wherein the one of the plurality of code data is selected from the codeset as a function of the keystroke indicator received the third device, wherein each of the plurality of key code data stored in the codeset prises a series of digital ones and/or digital zeros"	d
	the p	Rye and Skerlos do not disclose [1.4.5]: "wherein the codeset further comprises time rmation that describes how a digital one and/or a digital zero within the selected one of plurality of key code data is to be represented in the key code signal to be transmitted econd device"	of to
	3. 1, w	Rye and Skerlos do not render obvious Claim 2: "The first device as recited in claim herein the receiver comprises an RF receiver"	
	4. 1, w	Rye and Skerlos do not render obvious Claim 3: "The first device as recited in claim herein the transmitter comprises an IR transmitter"	
	,	Rye and Skerlos do not render obvious Claim 5: "The first device as recited in claim herein the formatted key code is transmitted from the first device to the second device wireless connection between the first device and the second device"	е
		Rye and Skerlos do not render obvious Claim 7: "The first device as recited in claim herein the generated key code controls at least one of a power on, power off, volume and volume down functional operation of the second device"	
С	. (	Ground 2: Caris and Dubil	17
	1.	A POSITA would not have combined Caris with Dubil	17
	2.	Caris and Dubil do not render obvious Claim 1:	33

ii

Universal Electronics Inc Exhibit 2003

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

Х.

a. Caris and Dubil do not disclose [1.3]: "a processing device coupled to the receiver and the transmitter"
b. Caris and Duil do not disclose [1.4]: "a memory storing instructions executable by the processing device, the instructions causing the processing device to"
c. Caris and Dubil do not disclose [1.4.1]: "generate a key code using the keystroke indicator received from a third device in communication with first device via use of the receiver, the keystroke indicator having data that indicates an input element of the third device that has been activated"
d. Caris and Dubil do not disclose [1.4.2]: "format the key code for transmission to the second device"
e. Caris and Dubil do not disclose [1.4.3]: "transmit the formatted key code to the second device in a key code signal via the use of a transmitter"
f. Caris and Dubil do not disclose [1.4.4]: "wherein the generated key code comprises a one of a plurality of key code data stored in a codeset, wherein the one of the plurality of key code data is selected from the codeset as a function of the keystroke indicator received from the third device, wherein each of the plurality of key code data stored in the codeset comprises a series of digital ones and/or digital zeros"
g. Caris and Dubils do not disclose [1.4.5]: "wherein the codeset further comprises time information that describes how a digital one and/or a digital zero within the selected one of the plurality of key code data is to be represented in the key code signal to be transmitted to the second device"
3. Caris and Dubil do not render obvious Claim 2: "The first device as recited in claim 1, wherein the receiver comprises an RF receiver"
4. Caris and Dubil do not render obvious Claim 3: "The first device as recited in claim 1, wherein the transmitter comprises an IR transmitter"
5. Caris and Dubil do not render obvious Claim 4: "The first device as recited in claim 1, wherein the formatted key code is transmitted from the first device to the second device via a wired connection between the first device and the second device"
6. Caris and Dubil do not render obvious Claim 5: "The first device as recited in claim 1, wherein the formatted key code is transmitted from the first device to the second device via a wireless connection between the first device and the second device"
CONCLUSION

iii

Universal Flectronics Inc. Exhibit 2003

Case IPR2019-01614 U.S. Patent 9,911,325 I, Michael D. Sprenger, declare that:

#### I. INTRODUCTION

1. I have been retained by Universal Electronics Inc., which I may refer to as either the "Patent Owner" or "UEI," for this *inter partes* review proceeding, which I may refer to as an "IPR." I understand that this IPR proceeding involves U.S. Patent No. 9,911,325, which I may refer to as "the '325 patent" for shorthand. I understand that the claims challenged in this IPR are Claims 1-5 and 7 of the '325 patent.

2. I understand that the '325 patent is assigned to UEI.

3. I understand that in this proceeding Roku, Inc., which I may also refer to as the "Petitioner," filed a Petition for review of Claims 1-5 and 7 of the '325 patent.

4. I understand that the above claims are challenged on the following three grounds:

Claims Challenged	Basis	References
1-3, 5, 7	Obviousness	Ground 1: Rye, Skerlos
1-5	Obviousness	Ground 2: Caris, Dubil

5. I have been asked to provide my objective, independent analysis of the '325 patent in view of the asserted prior art references cited in the Petition and to provide my opinion regarding the allegations in the Petition, as well as the supporting opinions of Dr. Samuel H. Russ.

1

Universal Electronics Inc. Exhibit 2003

## DOCKET A L A R M



# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## **Real-Time Litigation Alerts**



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## **Advanced Docket Research**



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## **Analytics At Your Fingertips**



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

#### LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

#### FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.