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.

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

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PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE OF RANKING

The Board acknowledges that one petition is generally sufficient to challenge the claims of a patent. *See* USPTO, Trial Practice Guide Update (July 2019), at p. 26 https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf ("July Update") ("Based on the Board's prior experience, one petition should be sufficient to challenge the claims of a patent in most situations"); see also USPTO, An Analysis of Multiple Petitions in AIA Trials, Oct. 24, 2017, Slide 14, https://www.uspto.gov/sites/default/files/documents/Chat_with_the_Chief_Boardside_Chat_Multiple_Petition_Study_20171024.pdf. In fact, the Board has indicated that it "finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate." July Update at 26.

The "inefficiencies and costs" associated with piecemeal petitions do not serve "the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings." *Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc*., Nos. IPR2019-00225, 00226, 00227, 00228, 00229, Paper 14 at 4 (P.T.A.B. Jun. 3, 2019) (denying institution on five lower ranked petitions). When faced with multiple petitions the Board will generally institute only on the Petitioner's top ranked petition and deny institution on the rest. *See, e.g., Pfenex Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01478,

Paper No. 9 at 14 (P.T.A.B. Feb. 10, 2020) (denying institution of Petitioner's later filed Petition, even though it covered claims not covered by an earlier filed petition); *see also BMW of North America, LLC et al v. Carrum Technologies, LLC et al*, IPR2019-00927, Paper No. 10 at 2 (P.T.A.B. Nov. 5, 2019) (denying institution of two lower ranked petitions); *Nalox-1 Pharmaceuticals, LLC v. Opiant Pharmaceuticals, Inc. et al*, IPR2019-00686, Paper No. 11 at 10 (P.T.A.B. Aug. 27, 2019) (denying institution of two lower ranked petitions where petitions all relied on similar prior art references and the same experts).

As explained in Patent Owner's preliminary response, the Board should deny institution of review of Petitioner's *second* and *third* petitions – IPR2020-00951 and -00953 – under 35 U.S.C. § 315(b) because *both* the petitions are time-barred.

In addition, Petitioner's Notice of Ranking is mis-leading as it completely ignores that Petitioner filed a first petition over 20 months ago in IPR2019-01614. To focus on its two time-barred petitions, as if they were not in fact the *second* and *third* petitions, completely ignores the intent of the Trial Guidelines Petitioner purports to follow. The ranking should include all three of Petitioner's serial petitions for *inter partes* review of U.S. Pat. No. 9,911,325. Petitioner's failure to address the first petition renders its Notice of Ranking wholly deficient and does nothing to "aid the Board in determining whether more than one petition is

necessary." Petitioner selected its preferred grounds and prior art references over a year ago, and the Board has already instituted trial in IPR2019-01614.

The Board has instituted on multiple ranked petitions only in rare instances. None of the circumstances justifying institution on multiple ranked petitions exist here. For example, in *Comcast Cable Communications, LLC et al v. Veveo, Inc. et al,* PTAB-IPR2019-00290, Paper No. 15 at 15 (P.T.A.B. July 5, 2019), the Board instituted on the top two ranked petitions (and denied institution on two others) because the Patent Owner indicated that it may swear behind the references in the first petition and because the petitions presented differing claim constructions in view of these potentially divergent scopes of prior art: "We are persuaded that the potential to antedate a reference relied on in a Petition and claim construction arguments resulting in different manner of application of the prior art are material differences between the submitted Petitions, and these differences warrant institution of *inter partes* review of a second petition." Here, the claim constructions are consistent across all petitions, and Patent Owner has made no indication that it will swear behind the priority date of the '325 Patent.

In *SolarEdge Technologies Ltd. v. SMA Solar Technology AG*, IPR2019-01224, Paper No. 10 at 10-11 (P.T.A.B. Jan. 23, 2020) the Board instituted two out of five parallel petitions because the petitions approached the limitations in materially different ways (one petition argued that a reference disclosed a two-

chamber inverter housing directly, while the second argued that it would have been obvious to house an inverter in the two-chambered housing disclosed in a different reference). Here, however, all three of Petitioner's petitions approaches the limitations in similar ways and argues that the newly asserted references (Woolgar, Gutman, and Chardon) disclose the limitations at issue. The ranked petitions are not materially different – they are merely serial attempts to argue that the limitations of the '325 Patent are disclosed in the prior art.

Petitioner's ranked Petitions, particularly in light of its failure to acknowledge its first petition, meet none of the criteria for the rare instances where the Board has instituted on multiple ranked petitions. Patent Owner submits that the Board should follow its usual practice and institute only on the top ranked petition – which it has already done in IPR2019-01614. The Board should deny institution on Petitioner's two lower ranked petitions.

Dated: August 28, 2020

/S. Benjamin Pleune/

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