UNITEI	O STATES PATENT AND TRADEMARK OFFICE
BEFO	RE THE PATENT TRIAL AND APPEAL BOARD
	ROKU, INC., Petitioner,
	v.
	UNIVERSAL ELECTRONICS INC., Patent Owner.
	Case IPR2020-00952 Patent 9,716,853

## MANDATORY NOTICES OF THE PATENT OWNER PURSUANT TO 37 C.F.R. § 42.8(a)(2)

Mail Stop "PATENT BOARD"

Patent Trial and Appeal Board U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450



### I. REAL PARTY IN INTEREST

Patent Owner identifies Universal Electronics, Inc. as the real party in interest.

## II. RELATED MATTERS

- A. Universal Electronics, Inc. v. Roku, Inc., 8:18-cv-01580-JVS-ADS (C.D. Cal. 2018) (pending);
- B. Universal Electronics, Inc. v. Roku, Inc., 8:20-cv-00701-JVS-ADS (C.D. Cal. 2020) (pending);
- C. Universal Electronics, Inc. v. TCL Electronics Holdings LTD., et al., 8:20-cv-00704-JVS-ADS (C.D. Cal. 2020) (pending);
- D. Universal Electronics, Inc. v. Hisense Co., LTD., et. al., 8:20-cv-00696-JVS-ADS (C.D. Cal. 2020) (pending);
- E. Universal Electronics Inc. v. Funai Electric Company, LTD., et al., 8:20-cv-00700-JVS-ADS (C.D. Cal. 2020) (pending);
- F. Certain Electronic Devices, Including Streaming Players, Televisions, Set Top Boxes, Remote Controllers, and Components Thereof; Inv. No. 337-TA-1200 (U.S.I.T.C. 2020)
- G. U.S. Patent No. 9,911,325, IPR2020-00953 (petition filed on May 18, 2020, no institution decision has been issued)
- H. U.S. Patent No. 9,911,325, IPR2020-00951 (petition filed on May 18, 2020, no institution decision has been issued)
- I. U.S. Patent No. 7,589,642, IPR2020-01012 (petition filed on May 29, 2020, no institution decision has been issued)
- J. U.S Patent No. 8,015,446, IPR2019-01595 (petition filed on September 12, 2019, institution denied);



- K. U.S. Patent No. 7,895,532, IPR2019-01608 (petition filed on September 13, 2019, institution denied);
- L. U.S. Patent No. 7,782,309, IPR2019-01619 (petition filed on September 18, 2019, institution denied);
- M. U.S. Patent No. 9,911,325, IPR2019-01614 (petition filed on September 18, 2019, instituted on April 16, 2020);
- N. U.S. Patent No. 8,004,389, IPR2019-01613 (petition filed on September 18, 2019, instituted on April 1, 2020);
- O. U.S. Patent No. 7,821,504, IPR2019-01621 (petition filed on September 18, 2019, instituted on May 14, 2020);
- P. U.S. Patent No. 7,821,505, IPR2019-01620 (petition filed on September 18, 2019, instituted May on 14, 2020);
- Q. U.S. Patent No. 7,589,642, IPR2019-01612 (petition filed on September 18, 2019, instituted on April 1, 2020);
- R. U.S. Patent No. 9,716,853, IPR2019-01615 (petition filed on September 18, 2019, instituted on April 17, 2020);
- S. The following applications and patents claim, or may claim, the benefit of the priority of the '853 patent: 15/626,357 filed on 06-19-2017 which is now US Pat. No. 9,942,509;
- T. The '853 patent claims priority to the following applications and patents: 13/933,877 filed on 07-02-2013 which is now US Pat. No. 9,219,874; 13,657,176 filed on 10-22-2012 which is now US Pat. No. 9,215,394; 61/680,876 filed on 08-08-2012, 61/552,857 filed on 10-28-2011;
- U. Patent Interference No. 106,113 (JTM), entered May 21, 2019, relates to 15/900,342 which also claims priority to 13,657,176 filed on 10-22-2012 which is now US Pat. No. 9,215,394; 61/680,876 filed on 08-08-2012; and 61/552,857 filed on 10-28-2011; and
- V. Patent Interference No. 106,114 (JTM), entered July 30, 2019, relates to 15/899,971 which also claims priority to 13,657,176 filed on 10-22-2012



which is now US Pat. No. 9,215,394; 61/680,876 filed on 08-08-2012; and 61/552,857 filed on 10-28-2011.

### III. LEAD AND BACK-UP COUNSEL

## **Lead Counsel:**

S. Benjamin Pleune (Reg. No. 52,421) ALSTON & BIRD LLP Bank of America Plaza Suite 4000 101 South Tryon Street Charlotte, NC 28280-4000 Telephone: (704) 444-1000 Facsimile: (704) 444-1111 ben.pleune@alston.com

## **Backup Counsel:**

Ryan W. Koppelman (Reg. No. 58,307) ALSTON & BIRD LLP 950 Page Mill Road, Palo Alto, CA 94304 P.O. Box 51058 (for U.S. Mail only) Palo Alto, CA 94303-1058 Telephone: (650) 838-2000 Facsimile: (650) 838-2001 ryan.koppelman@alston.com

Thomas W. Davison (Reg. No. 57,160) ALSTON & BIRD LLP 950 F Street, NW Washington, DC 20004 Telephone: (202) 239-3933 Facsimile: (202) 654-4913 Email: tom.davison@alston.com

James H. Abe (Reg. No. 61,182) Caleb J. Bean (Reg. No. 72,837) ALSTON & BIRD LLP



333 South Hope Street

16th Floor

Los Angeles, CA 90071

Telephone: (213) 576-1000 Facsimile: (213) 576-1100 james.abe@alston.com

Derek S. Neilson (Reg. No. 65,447)

**ALSTON & BIRD LLP** 

caleb.bean@alston.com

Chase Tower

2200 Ross Avenue

**Suite 2300** 

Dallas, Texas 75201

Telephone: (214) 922-3400 Facsimile: (214) 922-3899 derek.neilson@alston.com

Nicholas T. Tsui (Reg. No. 71,055)

**ALSTON & BIRD LLP** 

One Atlantic Center

1201 West Peachtree Street

**Suite 4900** 

Atlanta, GA 30309-3424

Telephone: (404) 881-7000

Facsimile: (404) 881-7777

nick.tsui@alston.com

Gary Jarosik (Reg. No. 35,906)

James J. Lukas, Jr. (Reg. No. 59,114)

Benjamin P. Gilford (Reg. No. 72,072)

GREENBERG TRAURIG, LLP

77 West Wacker Drive Suite 3100

Chicago, IL 60601

Telephone: (312) 456-8400

Facsimile: (312) 456-8435

jarosikg@gtlaw.com lukasj@gtlaw.com gilfordb@gtlaw.com



# DOCKET

## 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.

