

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

ROKU, INC.,  
Petitioner,

v.

UNIVERSAL ELECTRONICS INC.,  
Patent Owner.

---

Case IPR2020-01012  
Patent 7,589,642

---

**OPPOSITION TO PETITIONERS' MOTION FOR JOINDER UNDER 35  
U.S.C. § 315(C) AND 37 C.F.R. §§ 42.22 AND 42.122(B)**

**Mail Stop "PATENT BOARD"**  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

## I. INTRODUCTION

Universal Electronics Inc. (“Patent Owner” or “UEI”) served Roku with a District Court complaint on September 18, 2018, alleging infringement of “one or more claims” of U.S. Patent No. 7,589,642 (“the ’642 Patent”). Exactly one year later, Roku strategically petitioned for review of some but not all of the claims of the ’642 Patent. The Board has now instituted review in that proceeding, Roku’s expert has already been deposed, UEI’s Response is due in less than one week, Roku’s Reply is due in less than three months, and the Board’s Final Decision is due in less than ten months.

Now, 20 months after being served with UEI’s complaint in the District Court case, Roku seeks to flip the IPR process on its head by asking the Board to review a brand new IPR petition that has been time-barred for over eight months, and to ignore the statutory deadline to complete the originally-filed IPR. Simply put, Roku’s newly-filed IPR petition is harassing, vexatious, duplicative, and untimely; it will significantly increase the costs and resources spent litigating the validity of the ’642 Patent; and is an abuse of the IPR process.

Additionally, Roku’s motion is predicated on their misreading of the Supreme Court’s decision in *Thryv, Inc. v. Click-to-Call Tech, LP*. Contrary to Roku’s argument, *Thryv* did not abrogate the Federal Circuit’s precedential holding in *Facebook, Inc. v. Windy City Innovations, LLC* that same-party and new-issue

joinder are prohibited under §315(c). Rather, *Thryv* makes clear that the no-appeal provision of §314(d) is limited to institution decisions, while *Windy City* pertains solely to proceedings that have already been instituted.

## II. FACTS

On June 30, 2014, Universal Remote Control, Inc. requested *inter partes* review of claims 2, 5 and 22-23 of U.S. Patent No. 7,589,642. On December 18, 2014, the PTAB denied institution for all of the challenged claims. Claims 2, 22 and 23 were again challenged in Roku’s originally filed IPR2019-01612, and claim 5 is being challenged again in the new IPR2020-01012 filed by Petitioner Roku.

On September 18, 2018, UEI served Roku with a complaint filed in the Central District of California alleging infringement of “one or more claims” of each of U.S. Patent Nos. 7,589,642, 8,004,389, 9,911,325, 9,716,853, 7,782,309, 7,821,504, 7,821,505, 7,895,532, and 8,015,446.<sup>1</sup> On December 24, 2018, UEI filed its Disclosure of Asserted Claims and Infringement Contentions, identifying 106 asserted claims across the nine patents, including claims 1-6, 19, and 22-25 of the

---

<sup>1</sup> Attached hereto as Appendix A is a table describing the claims identified by UEI from each of U.S. Patent Nos. 7,589,642, 9,716,853, and 9,911,325, and the claims subsequently challenged by Roku in its petitions for *inter partes* review.

'642 Patent. UEI noted that it had not yet received discovery from Roku, and that the list of claims was based on the limited information that UEI had obtained to date. UEI reserved the right to seek to amend its disclosure of asserted claims as discovery progressed.

On March 14, 2019, the District Court ordered UEI to limit the total number of asserted claims to 25 claims. *See Universal Electronics Inc. v. Roku, Inc.*, No. 8-18-cv-01580, Dkt. 64 (C.D. Cal. Mar. 14, 2019). The District Court noted that UEI would have the opportunity to reassert unselected claims upon a showing that they presented unique issues. *See id.* at 3, 9 (“Again, the Court notes that if UEI ultimately discovers that non-selected claims raise separate and distinct legal issues from those raised by the already-selected claims, UEI may ask the Court for leave to reassert unselected claims.”). On April 5, 2019, UEI identified claims 3, 6, 23, and 25 as the claims that it would be proceeding with for the '642 Patent. On September 6, 2019 UEI served Roku with its First Amended and Supplemental Disclosure of Asserted Claims and Infringement Contentions. This submission referenced the 25 claim limitation imposed by the court, but maintained UEI’s allegations of infringement for claims 1-6, 19 and 22-25 of the '642 patent. UEI specifically stated that nothing in the disclosures should be construed as a waiver of UEI’s rights to amend (EX2100).

On September 18, 2019—the very last day that Roku could file an IPR challenging the claims of the '642 Patent—Roku petitioned for *inter partes* review of claims 1-4, 6, 8-9, and 22-25 of the '642 Patent. Roku did not, however, petition for review of the full set of claims UEI asserted in its Disclosure of Asserted Claims and Infringement Contentions in the District Court case. For instance, Roku omitted claims 5 and 19 from its petition, despite those claims being explicitly disclosed in UEI's current infringement contentions. Roku also included claims 8 and 9 even though neither was identified in Roku's September 6, 2019 Infringement Contentions.

Roku's originally-filed IPR is now in its advanced stages. The Board instituted review over two months ago, Roku's expert has already been deposed, UEI's Response is due in less than one week, Roku's Reply is due in less than three months, and the Board's Final Decision is due in less than ten months.

On April 16, 2020, UEI filed a complaint at the International Trade Commission, asserting infringement of claims 1-7, 20, and 22-25 against Roku. On May 29, 2020, more than eight months after the one year statutory bar set forth in §315(b), Roku filed a new IPR petition seeking to challenge three of the claims of the '642 Patent that Roku has challenged in its originally-filed IPR, and two of the claims that UEI asserted in its Disclosure of Asserted Claims and Infringement Contentions in the District Court case. Roku's new petition relies on the same art as

# 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.