UNITED STATES PATENT AND TRADEMARK OFFICE ———— BEFORE THE PATENT TRIAL AND APPEAL BOARD ———— ROKU, INC., Petitioner, v. UNIVERSAL ELECTRONICS INC., Patent Owner.

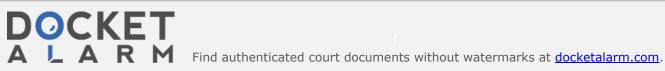
Case IPR2020-01012 U.S. Patent 7,589,642

PATENT OWNER PRELIMINARY RESPONSE



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TABLE OF AUTHORITIES

Page(s) FEDERAL CASES
ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc., 694 F.3d 1312 (Fed. Cir. 2012)
Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 15 (P.T.A.B. May 13, 2020)
Arris Group v. Cirrex Systems LLC, IPR2015-00530, Paper No. 12 (P.T.A.B. July 27, 2015)12
Arthrex, Inc. v. Smith & Nephew, Inc., No. 2018-2140, 2019 U.S. App. LEXIS 32613 (Fed. Cir. Oct. 31, 2019)
Belden Inc. v. Berk-Tek LLC, 805 F.3d 1064 (Fed. Cir. 2015)
Duncan Parking Techs., Inc. v. IPS Group Inc., IPR2016-01145, Paper No. 9 (Nov. 21, 2016)11
E-One, Inc. v. Oshkosh Corp., No. IPR2019-00161, Paper 16 (P.T.A.B. May 15, 2019)5
Facebook, Inc. v. Windy City Innovations, LLC, 953 F.3d 1313 (Fed. Cir. 2020)
General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha, Case IPR2016-01357, slip op. (P.T.A.B. Sept. 6, 2017)
Infinera Corp. v. Core Optical Technologies LLC, IPR2018-01259, Paper 923, 25
Intel Corporation v. VLSI Technology LLC, IPR2020-00112, Paper 15 (P.T.A.B. May 19, 2020)
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)



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