

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,

Petitioner,

v.

IOENGINE, LLC

Patent Owner.

Case IPR2022-01553
U.S. Patent No. 10,972,584

PETITIONER'S NOTICE RANKING PETITIONS

Petitioner Roku, Inc. (“Petitioner” or “Roku”) concurrently filed four petitions against U.S. Patent 10,972,584 (the “584 Patent”), which has 99 claims. Per the Trial Practice Guide (“TPG”), Petitioner submits this Notice including (1) a ranking of the petitions in order in which Petitioner wishes the Board to consider the merits, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should use its discretion to institute all of the petitions if it identifies one petition that satisfies Petitioner’s burden under 35 U.S.C. §314(a).

Although all of the petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions according to the following ranking:

Rank	Petition	Claims Challenged	Prior Art References Petitioner Relies On
1	IPR2022-01551 (Petition 1)	1-16, 22-24, 36-53, 58, 70-84, and 90-92	Primary Reference: Ozawa Secondary References: Prabhu and Lyle
2	IPR2022-01552 (Petition 2)	17-21, 25-35, 54-57, 59-69, 85-89, and 93-99	Primary Reference: Ozawa Secondary References: Prabhu, Spies, Boebert, and Swix
3	IPR2022-01553 (Petition 3)	1-16, 22-24, 36-53, 58, 70-84, and 90-92	Primary Reference: Alger Secondary References: Lyle and Connelly
4	IPR2022-01554 (Petition 4)	17-21, 25-35, 54-57, 59-69, 85-89, and 93-99	Primary Reference: Alger Secondary References: Lyle, Halbert, and Dowling

The material differences between the petitions warrant institution of all of them. The four petitions are divided by claims challenged, art area, and prior art date. First, because the '584 Patent has 99 claims, multiple petitions were needed to challenge different groups of claims. Specifically, Petitions 1 and 3 each challenge 56 claims related to device-terminal communications, and Petitions 2 and 4 each challenge 43 claims related to device-network communications.

Second, the petitions proceed on different primary references from different art areas. Specifically, Petitions 1 and 2 rely on Ozawa from the set-top box (“STB”) art, and Petitions 3 and 4 rely on Alger from the personal digital assistant (“PDA”) art. The STB and PDA petitions rely on different secondary references, except for one reference, Lyle.

Patent Owner IOENGINE, LLC (“Patent Owner”) has asserted all 99 claims (the “Challenged Claims”) against Petitioner in co-pending litigation, *IOENGINE, LLC v. Roku Inc.*, No. 6:21-cv-1296 (W.D. Tex.). Patent Owner has alleged in Preliminary Infringement Contentions that many different Roku products are “portable device[s]” per Claim 1 because these products communicate with a communications network (Internet) to access media content and display that content on a TV. EX1209, pp.8-13, 23-28. If all of these different Roku products are each a “portable device” as urged by Patent Owner, then the STB art cited in Petitions 1 and 2 render the Challenged Claims unpatentable as they too

communicate with a communications network (Internet) to access media content and display that content on a TV.

Patent Owner has broadly interpreted the Challenged Claims for purposes of infringement and these infringement theories affirm Petitioner's assertions as to how the STB art cited in Petitions 1 and 2 render the Challenged Claims unpatentable. However, based on discovery in the litigation, it appears that Patent Owner will argue that the Roku products accused of infringement are different than STBs and STBs are not relevant to the unpatentability of the Challenged Claims. Despite the complete inconsistency with Patent Owner's position, the PDA art cited in Petitions 3 and 4 also render the Challenged Claims unpatentable. Alger's PDA is plainly a "portable device." The '584 Patent itself discloses "PDAs . . . are considered among the smallest portable computing solution." EX1201, 2:43-46.

Further, the '584 Patent has an asserted priority date of March 23, 2004, but in the litigation Patent Owner has alleged a conception date as early as June 26, 2001. The secondary references in the petitions have different dates to account for Patent Owner's potential antedating arguments (Prabhu, Spies, Boebert, and Swix in Petitions 1 or 2 vs. Lyle, Connelly, Halbert, and Dowling in Petitions 1, 3, or 4).

Given the material differences between the four petitions, and to prevent Patent Owner from asserting the '584 Patent against Petitioner without the Office ever considering the applicability of STB art to the Challenged Claims, the Board

should use its discretion to institute all of them. That is, the STB art in Petitions 1 and 2 and the PDA art in Petitions 3 and 4 was not disclosed, cited, or considered during prosecution. The prior art in the petitions is materially different from and not cumulative to the prior art considered by the Examiner.

In view of the number and relative detail of the Challenged Claims (Claim 1 is 373 words), Patent Owner's potential arguments about STBs, and Patent Owner's potential antedating arguments, four petitions are needed to fully elaborate the obviousness grounds based on the STB art in Petitions 1 and 2 and the PDA art in Petitions 3 and 4. The Petitions are not redundant, duplicative, or substantially similar. Rather, each Petition presents compelling evidence of obviousness, without repeating the same theory or points.

The litigation history of the '584 Patent's family also supports institution of all of the petitions. Patent Owner is a serial litigant and has asserted patents in the '584 Patent family against other defendants. But the Board has found that many claims of '584 Patent family members are unpatentable. IPR2019-00879 (19 claims of '969 Patent unpatentable); IPR2019-00929 (53 claims of '703 Patent unpatentable).¹ The U.S. District Court for the District of Delaware has also

¹ The Board's judgments in IPR2019-00879 and IPR2019-00929 are pending on appeal in *IOENGINE, LLC v. Ingenico Inc.*, Case Nos. 21-1227, -1331, -1332, -

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