

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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IPR2019-01595 (Patent 8,015,446 B2); and  
IPR2019-01608 (Patent 7,895,532 B2)<sup>1</sup>

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Before PATRICK M. BOUCHER, MINN CHUNG, SHARON FENICK,  
and RUSSELL E. CASS, *Administrative Patent Judges*.<sup>2</sup>

PER CURIAM

ORDER

Granting in Part and Denying in Part Petitioner's  
Request for Additional Briefing  
*37 C.F.R. § 42.5; 37 C.F.R. § 42.108(c)*

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<sup>1</sup> This Order applies to each of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties shall not use this heading style in any subsequent papers.

<sup>2</sup> This is not a decision by an expanded panel. Judges Chung, Boucher and Cass considered the request in IPR2019-01595, and Judges Fenick, Chung, and Boucher considered the request as to IPR2019-01608.

IPR2019-01595 (Patent 8,015,446 B2); and  
IPR2019-01608 (Patent 7,895,532 B2)

On January 15, 2020, and in response to Petitioner's email of January 9, 2020, Judges Boucher, Chung, Fenick, and Cass conducted a telephonic hearing with counsel for both parties.

In each proceeding, pursuant to 37 C.F.R. § 42.108(c), Petitioner requested leave to file a reply to the Patent Owner's Preliminary Response.

In IPR2019-01595, Petitioner requested leave to file a reply to address Patent Owner's proposed claim construction of the term "user interface element." Patent Owner indicated that it does not oppose Petitioner's request, provided that Patent Owner is authorized to file a sur-reply. Finding that further briefing would be helpful, we authorized a reply and a sur-reply on this issue in the IPR2019-01595 proceeding.

In IPR2019-01608, Petitioner requested leave to file a reply to address two issues raised by the Preliminary Response. First, Petitioner argued that it could not have reasonably anticipated Patent Owner's argument under 35 U.S.C. § 325(d). Petitioner specifically identified Patent Owner's contention that certain references applied in challenging the claims are materially similar to prior art involved during examination of the subject patent. Patent Owner argued that the Petitioner could have anticipated and addressed this issue in the Petition. Second, Petitioner argued that it could not reasonably have anticipated Patent Owner's claim-construction argument directed at the term "causing the automatically created sequence of instructions to be executed by the controlling device in response to a selection of a user input element of the controlling device." Patent Owner argued that no unanticipated claim construction argument was raised by its Preliminary Response. With respect to each issue in the IPR2019-01608 proceeding,

IPR2019-01595 (Patent 8,015,446 B2); and  
IPR2019-01608 (Patent 7,895,532 B2)

Patent Owner indicated that it opposes Petitioner's request for leave to file a reply.

With respect to the claim construction issue only, finding that further briefing would be helpful, we authorized a reply and a sur-reply in the IPR2019-01608 proceeding. However, with respect to the § 325(d) issue, we did not authorize additional briefing. In the Petition, Petitioner addressed 35 U.S.C. § 325(d) and cited a precedential decision that includes a non-exclusive list of factors we weigh in evaluating whether to use our discretion under § 325(d). IPR2019-01608, Paper 2 at 55 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (designated precedential as to § III.C.5, first para.; also generally designated informative)). This list includes “the similarities and material differences between the asserted art and the prior art involved during examination” and “the cumulative nature of the asserted art and the prior art evaluated during examination.” *Becton, Dickinson*, Paper 8 at 17 (precedential portion). Petitioner could have expected that these issues would be relevant. In fact, Petitioner provides related arguments in its characterization of the prior art presented in the Petition and in the rationale for including each of the three grounds presented in the Petition. IPR2019-01608, Paper 2 at 15, 55–56. Therefore, with respect to a reply to further address discretion under 35 U.S.C. § 325(d) in IPR2019-01608, we found no showing of good cause, and Petitioner's request was denied.

Accordingly, it is:

ORDERED that, no later than Friday, January 24, 2020, Petitioner is authorized to file in IPR2019-01595 a Reply to the Patent Owner

IPR2019-01595 (Patent 8,015,446 B2); and  
IPR2019-01608 (Patent 7,895,532 B2)

Preliminary Response addressing only claim construction of the term “user interface element”;

FURTHER ORDERED that, no later than Friday, January 31, 2020, Patent Owner is authorized to file in IPR2019-01595 a responsive Sur-reply;

FURTHER ORDERED that, no later than Friday, January 24, 2020, Petitioner is authorized to file in IPR2019-01608 a Reply to the Patent Owner Preliminary Response addressing only claim construction of the term “user interface element”;

FURTHER ORDERED that, no later than Friday, January 31, 2020, Patent Owner is authorized to file in IPR2019-01608 a responsive Sur-reply;

FURTHER ORDERED that the above papers are limited to 5 pages each; and

FURTHER ORDERED that Petitioner’s request in IPR2019-01608 to file a reply to address discretion under 35 U.S.C. § 325(d) is *denied*.

IPR2019-01595 (Patent 8,015,446 B2); and  
IPR2019-01608 (Patent 7,895,532 B2)

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