

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

IOENGINE, LLC,
Patent Owner.

IPR2022-01257
Patent 10,447,819 B2

Before ELIZABETH M. ROESEL, CHRISTOPHER L. OGDEN, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Roku, Inc. (“Roku”) filed a Petition (Paper 2, “Pet.”) under 35 U.S.C. §§ 311–319 requesting *inter partes* review of claims 184–192 of U.S. Patent No. 10,447,819 B2 (Ex. 1001, “the ’819 patent”). Patent Owner IOENGINE, LLC (“IOENGINE”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).¹

Under the authority delegated to us by the Director under 37 C.F.R. § 42.4(a), we may only institute an *inter partes* review when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018); *see also* 37 C.F.R. § 42.108(c) (2022). Applying that standard, we do not institute an *inter partes* review, for the reasons explained below.

II. BACKGROUND

A. RELATED PROCEEDINGS

As a related matter, the parties identify *IOENGINE, LLC v. Roku, Inc.*, No. 6:21-cv-1296 (W.D. Tex. filed Dec. 14, 2021) (“parallel district court proceeding”). Pet. 2; Paper 4, 2.

¹ Roku also filed a Notice Ranking Petitions, arguing that we should institute trial both in this proceeding and in IPR2021-01258 where Roku challenges the same claims of the ’819 patent on different grounds. Paper 3; *see also* Paper 8 (IOENGINE’s response). Because we deny institution on the merits, we need not address whether it would be appropriate to institute trial in both proceedings.

Inter partes review IPR2022-01258, involving the same parties, also challenges the '819 patent. Paper 4, 2.

B. THE '819 PATENT (EX. 1001)

The '819 patent describes a portable “tunneling client access point (TCAP)” that “‘tunnels’ data through an access terminal’s (AT) input/output facilities.” Ex. 1001, code (57). “In one embodiment, the TCAP connects to an AT and a user employs the AT’s user input peripherals for input, and views the TCAP’s activities on the AT’s display.” *Id.*

The TCAP is a “portable device” with “storage, execution, and/or processing resources” but, unlike a traditional personal digital assistant (PDA), does not need to have its own display or other bulky input or output facilities, and can instead have “a highly portable ‘thumb’ footprint.” *See* Ex. 1001, 2:53–56. The user may “plug the [TCAP] device into any existing and available desktop or laptop computer [(the AT)], through which[] the TCAP can make use of a traditional user interface and input/output (I/O) peripherals.” *Id.* at 2:48–53.

“Access terminals (ATs) may be any number of computing devices such as servers, workstations, desktop computers, laptops, portable digital assistants (PDAs), and/or the like.” Ex. 1001, 3:56–59. According to the '819 patent, “[t]he type of AT used is not important other than the device should provide a compatible mechanism of engagement to the TCAP . . . and provide an operating environment for the user to engage the TCAP through the AT.” *Id.* at 3:59–63. For example, TCAP can connect to the AT through a USB, Bluetooth, or WiFi connection and the AT can “provide[] Java and/or

Windows runtime environments, which allows the TCAP to interact with the input/output mechanisms of the AT.” *Id.* at 3:63–4:3.

C. CHALLENGED CLAIMS AND GROUNDS

Claim 184, the sole challenged independent claim, reads as follows:

184. A portable device configured to communicate with a communications network comprising a communications network node and with a terminal comprising an output component configured to present an interactive user interface comprising at least one user interface element configured to be manipulated by a user to enable control of the portable device, the portable device comprising:

- a. a network interface configured to enable the transmission of communications between the portable device and the communications network node, wherein the communications comprise data content transmitted from the communications network node to the portable device;
- b. a communications interface configured to enable the transmission of communications between the portable device and the terminal, wherein the communications comprise a data content stream transmitted from the portable device to the terminal;
- c. a processor configured to stream data content for presentation by the terminal output component; and
- d. a memory having executable program code stored thereon, including:
 - i. first program code which, when executed, presents an interactive user interface on the terminal output component, receives a command resulting from user manipulation of a user interface element of the interactive user interface, and causes a communication to the portable device processor in response to the command resulting from user manipulation of a user interface element of the interactive user interface;
 - ii. second program code which, when executed by the portable device processor, enables the portable device to communicate with the communications network node;

- iii. third program code which, when executed by the portable device in response to a command resulting from user manipulation of a user interface element of the interactive user interface, causes a communication to be transmitted through the portable device network interface to the communications network node; and
- iv. fourth program code which, when executed by the portable device, processes data content received from the communications network node through the portable device network interface for transmission through the communications interface to the terminal and presentation by the terminal output component.

Ex. 1001, 46:48–47:28.

Roku argues six grounds for *inter partes* review, as summarized in the following table:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	184, 185, 188–190	102(b) ²	Ozawa ³
2	184, 188–190	102(b)	Clanton ⁴
3	186, 187	103(a)	Ozawa, Hendricks ⁵

² 35 U.S.C. §§ 102, 103 (2006), *amended by* Leahy–Smith America Invents Act, Pub. L. No. 112-29 §§ 102, 103, sec. (n)(1), 125 Stat. 284, 287, 293 (2011) (effective Mar. 16, 2013). Petitioner cites the pre-AIA version of § 102 (*see* Pet. 4–5), and we assume that these versions of §§ 102 and 103 apply because the ’819 patent claims the benefit of the filing date of an application filed March 23, 2004 (*see* Ex. 1001, code (63)), which is before the effective date of the AIA amendments. Our analysis would be the same under the amended versions of §§ 102 and 103.

³ Ozawa et al., US 2001/0030959 A1 (published Oct. 18, 2001) (Ex. 1005); *see also* Exs. 1006–1011 (provisional applications incorporated by reference).

⁴ Clanton et al., US 5,745,710 (issued Apr. 28, 1998) (Ex. 1012).

⁵ Hendricks et al., US 5,990,927 (issued Nov. 23, 1999) (Ex. 1013).

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
4	191, 192	103(a)	Ozawa, Spies ⁶
5	185, 186, 191, 192	103(a)	Clanton, Novak ⁷
6	187	103(a)	Clanton, Hendricks

Pet. 5.

D. DECLARATORY TESTIMONY

Roku relies on the declaration of Dr. Andrew B. Lippman. Ex. 1003.
IOENGINE relies on a declaration of Dr. Michael I. Shamos. Ex. 2001.

III. GROUNDS OF THE PETITION

Before analyzing the grounds of the Petition in detail, we address two matters that will underlie our analysis: the level of ordinary skill in the art and the construction of the claim terms.

A. LEVEL OF ORDINARY SKILL IN THE ART

The level of ordinary skill in the pertinent art at the time of the invention is a factor in how we construe patent claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–1313 (Fed. Cir. 2005) (en banc). It is also one of the factors we consider when determining whether a patent claim would have been obvious over the prior art. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

To assess the level of ordinary skill, we construct a hypothetical “person of ordinary skill in the art,” from whose vantage point we assess

⁶ Spies et al., US 6,055,314 (issued Apr. 25, 2000) (Ex. 1014).

⁷ Novak, US 2003/0097655 A1 (published May 22, 2003) (Ex. 1015).

obviousness and claim interpretation. *See In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). This legal construct “presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Relying on Dr. Lippman’s testimony, Roku argues that a person of ordinary skill in the art “would have had a Bachelor of Science degree in Electrical Engineering, Computer Science, Computer Engineering or related discipline, and experience in programming software or firmware for computers/peripheral devices or databases/servers.” Pet. 24–25 (citing Ex. 1003 ¶ 55). Petitioner also contends that this person “would have had a working understanding of computer hardware, operating systems, encryption, data storage, user interfaces, and communication protocols.” *Id.* (citing Ex. 1003 ¶ 55). IOENGINE agrees with that articulation for this proceeding. Prelim. Resp. 15–16.

We find the parties’ agreed articulation to be reasonable in light of the subject matter involved in the ’819 patent and its description of the relevant prior-art background. *See, e.g.*, Ex. 1001, 1:14–2:29. Thus, we adopt it for our decision.

B. CLAIM CONSTRUCTION

In an *inter partes* review, we construe a patent claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b). This generally includes “construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.* “[W]e look

principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–1317).

The ordinary and customary meaning of a claim term “is its meaning to the ordinary artisan after reading the entire patent,” and “as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1313, 1321. There are only two circumstances in which we adopt a construction that departs from the ordinary and customary meaning: “1) when a patentee sets out a definition and acts as [their] own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Any such special meaning of a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

In its Petition, Roku did not propose any explicit constructions. *See* Pet. 25–26. But based on IOENGINE’s infringement contentions in the parallel district court proceeding, Roku stated that it expected IOENGINE to argue that the word *terminal*, which appears in claim 184, was “[b]road enough to include a TV or monitor that displays video and/or outputs audio.” Pet. 25–26 (citing Ex. 1017, 32, 34; Ex. 1016, 24, 26). Roku provided no argument or evidence supporting this interpretation. *See id.*; *see also* Ex. 2001 ¶ 52 (Dr. Shamos opining that Roku’s interpretation finds no

support in Roku’s citation to documents in the parallel district court proceeding).

IOENGINE informs us that the court has construed the word *terminal* in the parallel district court proceeding. *See* Prelim. Resp. 16, 22–26; Ex. 2008. As such, we must consider the district court’s construction in our analysis. *See* 37 C.F.R. § 42.100(b) (“Any prior claim construction determination concerning a term of the claim in a civil action . . . that is timely made of record in the *inter partes* review proceeding will be considered.”).

In the parallel district court proceeding, both parties agreed that the word *terminal* means at least a “computing device.” *See* Ex. 2008, 6 & n.1; *see also* Prelim. Resp. 21 (citing Ex. 2009, 4:23–24; Ex. 2008, 6, 8; Ex. 2005, 1, 9–10, 12; Ex. 2001 ¶ 56). In addition to being a computing device, Roku also contended that a *terminal* must be a device “to control actions on the portable device,” or “through which the user engages the portable device.” Ex. 2008, 6 & n.1. The district court disagreed with Roku on those points. *Id.* at 14. Because Roku does not rely on its rejected construction for any of the grounds of its Petition, we need not revisit whether a person of ordinary skill in the art would have understood the word *terminal* to involve control or engagement with the portable device. *See* Prelim. Resp. 22–23 n.2 (pointing out that Roku does not rely on its district court litigation position in this proceeding).

Apart from holding that the word *terminal* has its “plain-and-ordinary meaning,” the court did not explicitly construe the term because it “is not a particularly technical word and is one that a lay juror has likely encountered.” Ex. 2008, 16. However, the interpretation of the word

terminal is key to our decision in this proceeding whether to institute trial, so we need to construe the term more specifically than the district court did. Given the evidence on this record, we agree with IOENGINE that a person of ordinary skill in the art would have understood that the word *terminal* in claim 184 refers at least to a computing device. Prelim. Resp. 20.

As IOENGINE correctly argues, the word *terminal* in claim 184 corresponds to the “access terminal” or “AT” discussed in the ’819 patent specification. *See* Prelim. Resp. 21. According to the ’819 patent, “Access terminals (ATs) may be any number of *computing devices* such as servers, workstations, desktop computers, laptops, portable digital assistants (PDAs), and/or the like.” Ex. 1001, 3:56–59 (emphasis added). The ’819 patent also discloses that “[t]he type of AT used is not important,” but that it “should provide . . . an operating environment for the user to engage the TCAP through the AT,” such as “Java and/or Windows runtime environments, which allows the TCAP to interact with the input/output mechanisms of the AT.” *Id.* at 3:59–4:3. This reference to an access terminal’s operating or runtime environment supports IOENGINE’s position that the “terminal” contemplated in the ’819 patent is a computing device.

IOENGINE also argues that the ’819 patent “distinguishes ‘terminals,’ which are computing devices, from ‘peripheral’ devices . . . [that] may connect to a computing device.” Prelim. Resp. 23 (citing Ex. 1001, 2:48–54, 3:56–59, 15:56–64, 22:44–45). According to IOENGINE, “[p]eripheral devices may include ‘output devices’ such as ‘monitors,’ ‘video devices,’ or ‘a video display, which typically comprises a Cathode Ray Tube (CRT) or Liquid Crystal Display (LCD) based monitor.” *Id.* (quoting Ex. 1001, 15:41–45, 15:62–64). IOENGINE contends that in the parallel district court

proceeding, Roku recognized this distinction between terminals, which are computing devices, and peripheral devices “like monitors or displays” which according to Roku, “the patent called separate.” *Id.* at 23–24 (quoting Ex. 2009, 10:10–13) (citing Ex. 1001, 15:52–64; Ex. 2005, 11; Ex. 2001 ¶ 58).

According to IOENGINE, a person of ordinary skill in the art would have understood “that an output component alone is not a computing device” and thus not a terminal. Prelim. Resp. 24 (citing Ex. 2001 ¶ 60). And IOENGINE contends that any “embedded control circuitry” in peripheral devices “does not render such devices ‘computing devices’ [or terminals] within the meaning of the ’819 Patent.” *Id.* at 26 (citing Ex. 2001 ¶¶ 61–63); *see also* Ex. 2001 ¶ 59 (“[A] computing device requires more than mere ‘control circuitry’ . . .”).

Neither party in this proceeding has suggested that the word *terminal* in claim 184 departs from the ordinary and customary meaning of that term, and, like the district court, we find no evidence of record to suggest such a departure. *See* Ex. 2008, 13–16. We also find no evidence of record to support Roku’s proposed construction of *terminal* that would broadly “include a TV or monitor that displays video and/or outputs audio.” Pet. 25–26. Rather, we agree with IOENGINE that the word *terminal* refers to a computing device. The evidence of record suggests that this is the ordinary and customary meaning of that term, as a person of ordinary skill in the art would have understood it after reading the ’819 patent disclosure. *See, e.g.*, Ex. 1001, 3:56–4:3.

The parties also propose constructions for the terms *first program code*, *which when executed* (or, alternatively, *first program code*) and

portable device. Pet. 26; Prelim. Resp. 17–20, 26–27. Because, as we discuss below, Roku is not likely to prevail in light of our construction of the word *terminal*, we need not construe these other terms for our decision not to institute trial. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

C. ALLEGED ANTICIPATION BY OZAWA

For its Ground 1, Roku alleges that claims 184, 185, and 188–190 are unpatentable under § 102(b) as anticipated by Ozawa. Pet. 5, 26–50. For the reasons below, we determine that Roku has not shown that there is a reasonable likelihood it would prevail on this ground.

1. Overview of Ozawa

Ozawa “relates generally to the field of television and television set-top boxes.” Ex. 1005 ¶ 3. It includes a set-top box for a cable or satellite system, which is connected to a television to provide media content and listing data. *Id.* ¶ 20.

Figure 2 of Ozawa is reproduced below:

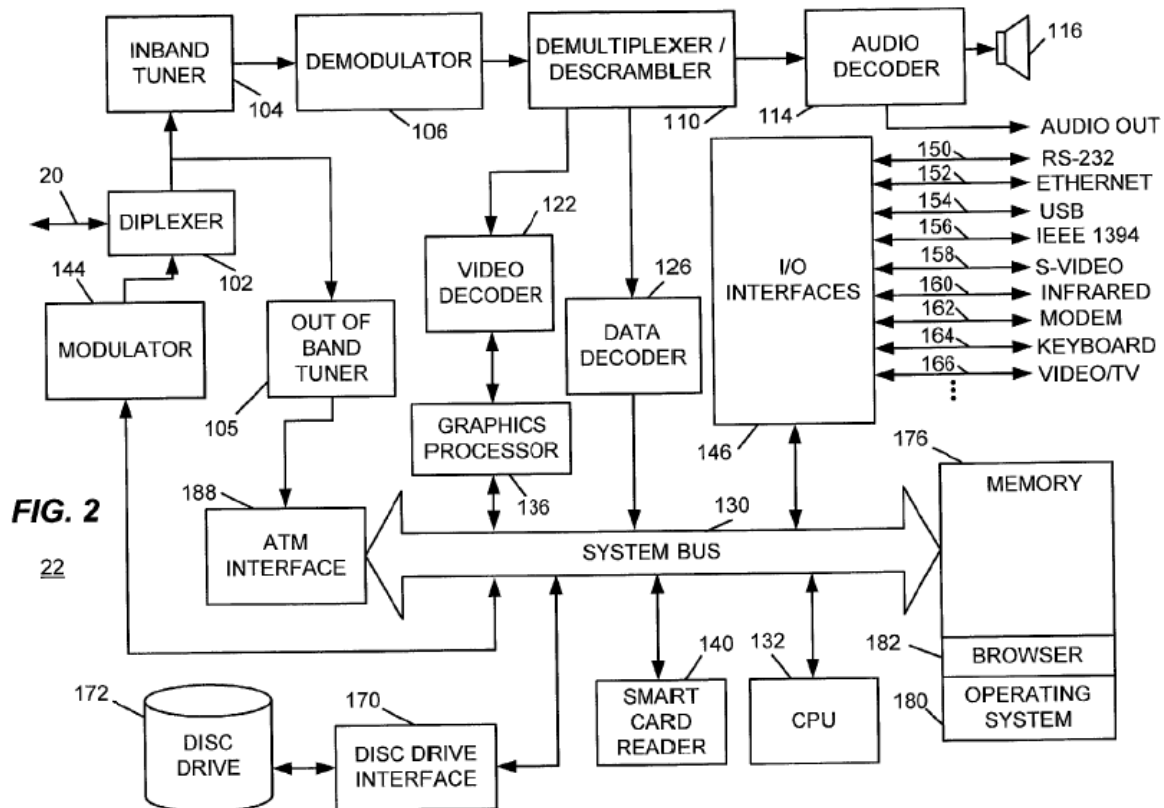


Figure 2, above, depicts a “system configuration for a digital set[-]top box 22,” which takes input from transmission medium 20, “such as a coaxial cable . . . coupled by a suitable interface through a diplexer 102 to an in-band tuner 104.” Ex. 1005 ¶ 28.

Set-top box 22 includes a set of I/O interfaces (146). Ex. 1005 ¶ 33. These may include “an IEEE 1394 (so-called firewire™ or i-link™) or IEEE 1394 wide port 156, S-video port 158,” or “basic video outputs 166 that can be used for direct connection to a television . . . instead of (or in addition to) an IEEE 1394 connection.” Ex. 1005 ¶¶ 33, 36.

2. Analysis

To show anticipation, a petitioner must locate each and every element in a claim, arranged as recited in the claim, in a single prior art reference.

See Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1369 (Fed. Cir. 2008). The limitations may be present in the reference “either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). In making this determination, we consider the reference “together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (citing *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)).

Claim 184 is directed to “[a] portable device” (corresponding to the TCAP in the ’819 patent disclosure) that is configured to interact with “a terminal comprising an output component” by (1) transmitting a “data content stream” to the terminal, (2) presenting an “interactive user interface on the terminal output component,” and (3) processing information from a communications network node for “presentation by the terminal output component.” Ex. 1001, 46:50–51, 46:61–67, 47:3–5, 47:24–28. Because the word *terminal* appears both in the preamble and in multiple claim limitations, we need not determine whether the preamble alone is limiting.⁸

Roku contends that Ozawa discloses a “terminal” in the form of “a TV . . . , such as a digital television, having a display . . . for displaying programming, an [electronic program guide], etc.” Pet. 31 (quoting Ex. 1005 ¶ 22) (citing Ex. 1005, Fig. 1; Ex. 1003 ¶ 126). According to Roku, this TV “is ‘a terminal,’ interpreted as implied by [IOENGINE]’s infringement

⁸ IOENGINE argues that at least the terms *portable device* and *terminal* in the preamble of claim 184 are limiting. *See* Prelim. Resp. 17–18, 20 n.1. Roku does not take a position on whether the preamble of claim 184 is limiting, but presents arguments as if it were limiting. *See* Pet. 26–33, 50–59.

contentions, and the display . . . of the TV . . . is ‘an output component’ of the terminal.” *Id.* (citing Ex. 1003 ¶ 126); *see also* Pet. 37 (citing Ex. 1003 ¶ 147).

In response, IOENGINE argues that “Ozawa contains no disclosure that its TV . . . is a computing device, or that it has any computing capacity at all,” and “there is no disclosure that Ozawa’s TV . . . is anything more than a mere output component.” Prelim. Resp. 36 (citing Ex. 2001 ¶¶ 85–95). According to IOENGINE, Roku “does not point to any processing or processing capability on [Ozawa’s TV] that would indicate that it is a computing device, and Ozawa does not disclose any processing capabilities of [the TV].” *Id.* at 37.

IOENGINE argues that the terminal in Ozawa, “if any[thing], would be Ozawa’s [set-top box].” Prelim. Resp. 36. And at most, Ozawa’s TV would correspond to the terminal’s “output component,” but would not be the terminal itself. *See id.* at 36–38 (citing Ex. 1001, 15:33–41, 15:48–51; Ex. 2001 ¶¶ 88–91, 94–95).

We agree with IOENGINE that Roku has not shown Ozawa’s TV to be a *terminal* as we construe that term, which is at least a computing device. *See supra* Section III.B. Roku has not, for example, shown that Ozawa’s TV is a computing device. And even if we are incorrect that a “terminal” must be a computing device, Roku has not, with any particularity, explained what aspects of Ozawa’s TV would have made it a *terminal* as a person of ordinary skill in the art would have understood that term in the context of the ’819 patent disclosure. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991) (“the dispositive question regarding anticipation” is “whether one skilled in the art would reasonably understand or infer from”

the prior art reference that the disclosed device embodies the claim limitation).

Because Roku has not shown that every limitation of claim 184 is found explicitly or inherently in Ozawa, we determine that Roku has not shown a reasonable likelihood that it would prevail in proving that Ozawa anticipates claim 184. Because claims 185 and 188–190 depend from claim 184 and thus include the requirement for interaction with a “terminal,” Roku has likewise failed to show that Ozawa anticipates these dependent claims. *See* 35 U.S.C. 112, para. 4 (2006) (“A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

D. ALLEGED ANTICIPATION BY CLANTON

For its Ground 2, Roku alleges that claims 184 and 188–190 are unpatentable under § 102(b) as anticipated by Clanton. Pet. 7, 50–72. For the reasons below, we determine that Roku has not shown that there is a reasonable likelihood it would prevail on this ground.

1. *Overview of Clanton*

Clanton discloses “[a]n improved graphical user interface for displaying and selecting video programs, such as video on demand.” Ex. 1012, code (57). A set-top box has a processor that “generates and displays [the described] graphical user interface on the subscriber’s television.” *Id.*

Figure 1 of Clanton is reproduced below:

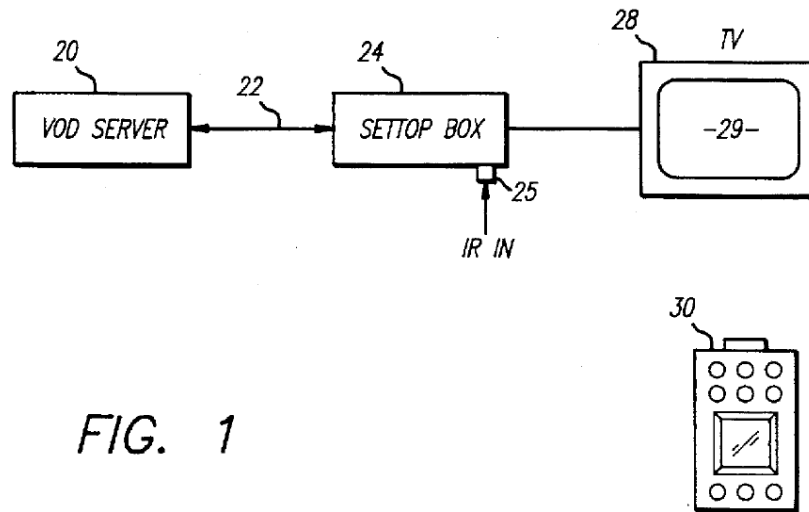


Figure 1 of Clanton, above, depicts video on demand (VOD) server 20 which “provides video on demand programming services to a plurality of users over a transmission medium 22.” Ex. 1012, 6:27–29. Set-top box 24 is coupled to transmission medium 22 and also contains infrared (IR) input 25 through which remote control input device 30 can control set-top box 24. *See id.* at 6:35–42, 6:45–48. Set-top box 24 is also “coupled to a television 28 having a screen 29, or another audiovisual device such as a video tape recorder (not shown).”

2. Analysis

Roku contends that “the television 28 of Clanton is ‘a terminal,’ interpreted as implied by [IOENGINE]’s infringement contentions, and the screen 29 of the television 28 is ‘an output component’ of the terminal.” Pet. 54–55 (citing Ex. 1003 ¶ 215).

IOENGINE argues that Clanton’s television 28 is not a terminal because it is not a computing device and, other than disclosing that it includes screen 29, “Clanton provides no other information about the

components or capability of television 28, let alone anything to suggest that the TV is a computing device.” Prelim. Resp. 55 (citing Ex. 1012, 6:43; Ex. 2001 ¶ 147). IOENGINE argues that television 28 only acts as a display, and “any computing that is performed at the subscriber’s location is undertaken by the [set-top box], not the television.” *Id.* (citing Ex. 1012, 7:64–67; Ex. 2001 ¶ 147). IOENGINE characterizes television 28 as nothing more than “a peripheral device or ‘output component’ for a terminal” which, “if any[thing], would be [set-top box] 24.” *Id.*

We agree with IOENGINE that Roku has not shown that Clanton’s TV 28 is a *terminal* as we construe that term, which must at least be a computing device. *See supra* Section III.B. Even if a “terminal” does not necessarily need to be a computing device, Roku has not explained, with sufficient particularity, why Clanton’s TV 28 is a *terminal* as a person of ordinary skill in the art would have understood that term in the context of the ’819 patent disclosure. *See Baxter*, 952 F.2d at 390.

Because Roku has not shown that every limitation of claim 184 is found explicitly or inherently in Clanton, we determine that Roku has not shown a reasonable likelihood that it would prevail in showing that Clanton anticipates claim 184. Because claims 188–190 depend from claim 184 and thus include the requirement for a “terminal,” Roku has likewise failed to show that Clanton anticipates these dependent claims. *See* 35 U.S.C. 112, para. 4 (2006).

E. OTHER GROUNDS

The remaining grounds of the Petition allege that certain dependent claims are unpatentable under § 103(a) as obvious over either Ozawa or Clanton in view of other references. *See* Pet. 5, 72–89.

As discussed above, we determine that Roku is not likely to prevail in showing that either Ozawa or Clanton anticipates claim 184, the sole independent challenged claim. As IOENGINE correctly notes, for its obviousness grounds, Roku “relies solely on either Ozawa or Clanton for all elements of independent claim 184” and “neither Ozawa nor Clanton discloses all elements of independent claim 184.” Prelim. Resp. 60. Roku’s obviousness challenges for the dependent claims do not remedy the deficiencies in Roku’s anticipation challenge for independent claim 184.

Thus, for the reasons given above in our analysis of Petitioner’s anticipation grounds, we determine that Roku is not reasonably likely to prevail in showing that claims 186 or 187 are unpatentable as obvious over Ozawa and Hendricks (Ground 3), that claims 191 or 192 are unpatentable as obvious over Ozawa and Spies (Ground 4), that claims 185, 186, 191, and 192 are unpatentable as obvious over Clanton and Novak (Ground 5), or that claim 187 is unpatentable as obvious over Clanton and Hendricks (Ground 6).

IV. CONCLUSION

After considering the evidence and arguments on the preliminary record, we determine that Roku has not demonstrated a reasonable likelihood that it would prevail in showing that at least one challenged claim of the ’819 patent is unpatentable. Therefore, we deny the Petition.

V. ORDER

In consideration of the foregoing, it is
ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2022-01257
Patent 10,447,819 B2

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