

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

ECOLINK INTELLIGENT TECHNOLOGY, INC.,
Patent Owner.

IPR2023-00792
Patent 10,692,340 B2

Before CHRISTOPHER L. OGDEN, STEVEN M. AMUNDSON, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER
Granting Supplemental Briefing
37 C.F.R. § 42.5

I. DISCUSSION

An oral hearing was held in this proceeding on August 1, 2024. A transcript has not yet been finalized and entered. This Order sets forth an issue for additional briefing and a schedule for that briefing.

The '340 patent was filed on November 26, 2018. Ex. 1001, at [22]. The '340 patent claims to be a continuation in part of Application 15/946,511, filed April 5, 2018, now Patent 10,497,230. *Id.*, at [60]. The '230 patent is a division of Application 14/629,370, filed on February 3, 2015, published as US 2016/0247370 A1 (Lamb, Ex. 1009). *Id.*

Petitioner argues in its Petition ("Pet.," Paper 2) that Lamb is prior art under 35 U.S.C. § 102(a)(1) because the challenged claims are not entitled to the benefit of either of the parent applications. *See* Pet. 5. According to the Petition, the challenged claims include subject matter not disclosed in those applications, such as "a timed alarm signal" among other things. *Id.* at 5–6. Petitioner argues that "[t]he parent applications do not disclose or reasonably suggest any subject matter related to timed alarms, measuring times, or starting countdown timers." *Id.* at 6.

In its Sur-reply (Paper 19), Patent Owner argued that, if the Board adopts Petitioner's construction of "timed alarm signal," Petitioner has not carried its burden to prove that Lamb is prior art to challenged claims 1, 2, 11, and 12. Sur-reply 8. In Patent Owner's view, "all of the functional and purpose components of Petitioner's proposed construction of 'timed alarm signal' (i.e., used for initiating a timer associated with the security panel) have no patentable weight and cannot be used to distinguish Lamb for purposes of determining whether Lamb is prior art to claims 1 and 11." *Id.* at 11. Patent Owner argues that "Petitioner still cannot meet its burden of

showing that Lamb is prior art because Petitioner and its expert argue that Lamb inherently discloses that the signal transmitted by Lamb’s alarm device can be used to initiate a timer.” *Id.* at 12 (citing Paper 15 (“Reply”), 14–15; Ex. 2004, 94:7–17, 96:18–19, 167:5–6).

At the oral hearing, Petitioner argued that Patent Owner’s arguments about Lamb fall outside the proper scope of a sur-reply. Petitioner requested additional briefing if the Board disagreed. Petitioner has not filed a motion to strike.

We take no position at this time about whether Patent Owner’s sur-reply arguments are belatedly presented. We, however, authorize additional briefing limited to Patent Owner’s arguments about Lamb’s status as prior art. *See* Sur-reply 8–12. Petitioner is to submit a supplemental brief on the issue, and Patent Owner is authorized to submit a response within one week of Petitioner’s brief.

The parties may address whether the claims include subject matter related to timed alarms under the correct construction. Although Patent Owner’s sur-reply arguments specifically discuss intended purpose (*id.* at 11), the parties are permitted to address other possible constructions, such as whether the timed alarm signal is non-functional descriptive material. *See, e.g., In re Distefano*, 808 F.3d 845 (Fed. Cir. 2015) (setting forth a two-step test for determining whether a limitation should be given patentable weight under the printed-matter doctrine); *IOENGINE, LLC v. Ingenico Inc.*, 100 F.4th 1395, 1403–06 (Fed. Cir. 2024) (applying the two-step test to determine that limitations to “encrypted communications” and “program code” did not constitute printed matter).

The Board invites the parties' attention to the following parts of the '340 patent that may be relevant to its final claim construction: "[A] timed alarm signal is generated by the barrier alarm device and transmitted to a security panel which, in response, start[s] a countdown timer that allows a person to cancel a security response from occurring if a certain action is taken before the countdown timer expires." Ex. 1001, 4:16–20. "The timed alarm signal may comprise a serial number of barrier alarm device 600 Of course, the timed alarm signal [and] the alarm signal could comprise other information, so long as central security panel 116 can differentiate between two signals." *Id.* at 17:63–18:3.

II. ORDER

It is

ORDERED that Petitioner is to submit a supplemental brief on whether Lamb is prior art;

FURTHER ORDERED that Petitioner's brief must not exceed seven pages and must be filed no later than August 12, 2024;

FURTHER ORDERED that Patent Owner is authorized to submit a brief responding to Petitioner's brief; and

FURTHER ORDERED that Patent Owner's brief must not exceed seven pages and must be filed no later than August 19, 2024.

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