UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

Case No. IPR2024-01023
Patent No. 8,291,236

PETITIONER'S NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES

Petitioner is filing three parallel petitions for *inter partes* review against U.S. Patent No. 8,291,236 ("the '236 patent"). Pursuant to the Board's Consolidated Trial Practice Guide (November 2019) ("TPG") at 59-60, Petitioner submits this notice to (1) identify a ranking of the petitions and (2) provide a succinct explanation of the differences between the petitions, why issues addressed by the differences are material, and why the Board should use its discretion to institute all petitions.

I. RANKING OF PETITIONS

Petitioner does not believe a ranking of petitions to be appropriate here, as there is no duplicative overlap of the same claims across petitions and the three petitions are pursued solely for word count purposes that preclude all claims from being challenged in single petition. For example, the petition in IPR2024-01023 is challenging claims 32-36, 38-41, 43, 66-70, 72-75, 77, and 130-137 and has a word count of 13,912 words, while the petition in IPR2024-01024 is directed to claims 48-50, 57, 82-84, 91, 116-118, 125, and 140-142 and has a word count of 11,225 words, and the petition in IPR2024-01025 is directed to claims 100-109 and 111 and has a word count of 13,990 words. Due to word count constraints, the different limitations found in the independent claims of the '236 requiring the application of different arguments, and the need to set forth constructions for claim language invoking §112, ¶6, different subsets of claims have been presented separately in

the separate petitions. *See* PTAB Consolidated Trial Practice Guide, November 2019,[1] 59-61 (permitting parallel petitions in certain circumstances, such as a large number of claims). The multiple petitions are not unnecessarily duplicative because they challenge different independent and dependent claims of the ’236, and the multiple petitions will not substantially burden the Board or the parties because they use overlapping prior art references in the grounds of unpatentability (*i.e.*, “Russ” is common to all three petitions; “Robert” and “Eskicioglu” are also common to two of the petitions), and the different claims, while directed to different components of an overall system, include overlapping limitations that have overlapping unpatentability arguments. Petitioner only submits three petitions out of necessity. The Board should not exercise discretion to deny any of the petitions directed to the ’394. *See*, *e.g.*, *Samsung Elecs. Co. Ltd. v. Mojo Mobility Inc.*, IPR2023-01090, Paper 11 at 25-26 (PTAB Jan. 11, 2024) (granting institution and declining to deny a parallel petition where, “in effect, the two petitions were filed instead of one merely because [PTAB] Rules have page limit restrictions”).

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[1] https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=

Nevertheless, to the extent ranking is necessary, Petitioner ranks the petitions as follows:

IPR No.	Rank
IPR2024-01023	1
IPR2024-01024	2
IPR2024-01025	3

Petitioner respectfully requests that the Board institute all petitions.

Respectfully submitted,
Roku, Inc.

Date: June 14, 2024

/Scott A. McKeown/

Scott A. McKeown, Reg. No. 42,866
WOLF, GREENFIELD & SACKS, P.C.
601 Massachusetts Avenue NW
Washington, DC 20001

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on June 14, 2024, I will cause a copy of the foregoing document, including any exhibits or appendices filed therewith, to be served via Overnight FedEx at the following correspondence address of record for the patent:

Workman Nydegger
60 East South Temple
Suite 1000
Salt Lake City, UT 84111

Courtesy copies of the same documents were also served at the following email addresses of record for Patent Owner's litigation counsel:

M. Elizabeth Day	eday@bdiplaw.com
Marc Belloli	mbelloli@bdiplaw.com
Jerry D. Tice II	jtice@bdiplaw.com
Aaron R. Hand	ahand@bidplaw.com
Hillary Bunsow	hbunsow@bdiplaw.com

Date: June 14, 2024

/MacAulay Rush/
MacAulay Rush
Paralegal
WOLF, GREENFIELD & SACKS, P.C.