

Cases IPR2024-01023, - 01024, and -01025
U.S. Patent 8,291,236

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner

Cases IPR2024-01023, IPR2024-01024, and IPR2024-01025
U.S. Patent 8,291,236

PATENT OWNER'S SUR-REPLY

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A. Introduction¹

In its Petition, Petitioner and its expert failed to provide any evidence or explanation for why Russ’s alleged “second root of trust” is “independent” of Russ’s alleged “first root of trust,” as required by every challenged claim. POPR, 17.² Seeking to cure its failures, Petitioner sought a broad reply brief to try to fill this clear evidentiary gap. The Board did not authorize Petitioner’s broad request for a reply, limiting the reply “only to claim construction issues.”

Petitioner nevertheless did not limit its reply. Indeed, the reply does not state what Petitioner believes is the proper construction of the “independent” term. Instead, Petitioner attempted to cure the Petition’s substantive defects, offering new theories based on attorney argument, and going as far as including an entire section discussing an alleged prior art reference. The Board already informed Petitioner that it will not consider new arguments or evidence, but, nevertheless, Petitioner’s belated attempt to save the Petition only demonstrates why it is meritless—Petitioner

¹ In its email authorizing additional briefing, the Board directed the parties to “one Reply and one Sur-Reply for each patent.” While Roku filed three Replies for the ’236 patent with different content, Patent Owner files a single Sur-Reply, as directed.

² Cites herein are to the documents in IPR2024-01023. The documents in IPR2024-01024 and -01025 include corresponding content.

cannot rebut that the alleged roots of trust are *not* independent.

B. Petitioner’s belated invalidity theories and attempts to cure the deficiencies of the Petition should not be considered.

Petitioner “has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). As such, Petitioner “may not submit new evidence or argument in reply that it could have presented earlier, e.g., to make out a prima facie case of unpatentability.” Consolidated Trial Practice Guide, 73 (Nov. 2019). Moreover, the Board instructed Petitioner in its October 4, 2024, email to limit its reply “only to claim construction issues” because “the panel will not consider [new] arguments and/or evidence.” Petitioner submitted new arguments anyway, arguing for the first time—and based solely on attorney argument without any citation—that “Russ’s roots of trust are independent ... because each grants permissions to and from different entities, each uses different criteria and the corresponding authentication decisions are not dependent on the output of the other”; that “Russ is no different from systems described in the ’236”; and a discussion of “DTCP protocols” used by Russ’s “DSCT.” Reply. 1, 5. Roku otherwise mashes together quotes from the Petition that, just like in the Petition, conflate the claim requirements of “different” and “independent,” with no discussion of the “independent” requirement. *Id.*, 5 (first full paragraph). These new arguments—supported by no

expert evidence and primarily with no citation to anything at all should be ignored. Without them, “Petitioner and its expert fail to explain how Russ’s purported second root of trust is *independent* from the purported first root of trust.” POPR, 17. With them, the Petition’s failures are only highlighted, as discussed below.

Attempting to have some “claim-construction related argument,” Petitioner incorrectly states that PO argues that “the first and second roots of trust must be construed as *independently controlled*.” Reply, 1. PO does not argue for that construction, and explained that Russ, among its other failures, does not teach a second root of trust which is “independent of and different than” a first root of trust, as claimed. *See* POPR, 17-22. As there does not appear to be any claim construction dispute, Petitioner’s reply should be ignored.

C. If considered, the reply only confirms the Petition’s deficiencies.

With no expert support, Petitioner argues that roots of trust for *authentication* need not be independent—as claimed—because, under Petitioner’s argument, the ’236 specification states that a primary server can control *content distribution* to devices in a secondary system. Reply, 1-2. Even assuming it were proper to read out claim language based on embodiments from the specification (it is not), Petitioner’s argument fails: authentication and content distribution are different concepts and related to different portions of the claims. As Dr. Malek explained, a secondary access server can “independently verify devices,” and *after* a device is authenticated,

becoming part of the domain, the secondary access server may “provide content from various security domains to the verified devices.” EX2001, ¶ 40. It is the ***authentication*** that must be independent, as described and claimed. *See* EX1001, 8:33-35 (“the client authentication in the secondary security domain is completely independent from the client authentication in the primary security domain.”).

After a device is authenticated, it may receive content from the secondary server. This content distribution need not be independent. For example, the secondary server receives entitlement messages used for decrypting content and provides access controlled data that is in an access controlled format and that is at least partially derived from the received messages to the authenticated entity in the second domain. EX1001, Fig. 15. These concepts, independent authentication while allowing controlled content distribution, is a purpose of the inventions. EX1002, 479 (having “independent authentication” while allowing content from the first domain); *see also* EX1001, 8:29-38 (“completely independent” authentication while allowing content authorization in accordance with the first domain).

These two concepts are claimed. Elements 130[a] and 130[b], for example, are related to content distribution, while 130[c] is related to authentication. EX1008, 6, 10, 18. It is 130[c] that includes the “independent” requirement. Petitioner’s citations and argument regarding content distribution is thus irrelevant and does not cure the Petition’s failures.

D. Patent Owner’s district court allegations highlight Petitioner’s misapprehensions.

Petitioner’s arguments related to the district court further expose the mistakes in Petitioner’s reply. Petitioner states that its devices use “PlayReady”-based components and “HDCP”-based components for authentication, citing to PO’s claim charts for elements 130[c] and 130[d]—elements discussing authentication. *See* Reply, 4. Yet in seeking to align the Russ reference with the district court materials, Petitioner relies on “HDCP enforcement requirements,” as discussed in claim elements 130[a] and 130[b]—elements that make *no mention of authentication* or roots of trust, and are related to content distribution. *See id.* Petitioner’s products operate just as claimed in the patent, unlike the Russ reference.

E. Russ fails to teach or suggest the challenged claims.

Russ is a different system used for a different purpose. POPR, 9-13. As explained in the POPR, “without the alleged first root of trust, the alleged second root of trust cannot be established”—it depends on the first root of trust. POPR, 19-20. Indeed, any root of trust between the DSCT 110 and client-receiver 112 is “intrinsically tied to and predicated on a root of trust between the headend 102 and DSCT 110.” *Id.* Petitioner does not and cannot rebut this.

Under the plain meaning of the claim, which requires no construction here, Russ does not teach or suggest that the purported second root of trust is “independent of and different than” the alleged first root of trust. The Petition fails.

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Dated: October 18, 2024

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on October 18, 2024, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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