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|---|---|
| **From:** | Trials |
| **To:** | Jerry Tice; Scott.McKeown@WolfGreenfield.com; Trials |
| **Cc:** | Aaron Hand; VideoLabs_Roku; Victor.Cheung@WolfGreenfield.com; SMcKeown-PTAB@WolfGreenfield.com |
| **Subject:** | RE: IPR2024-01023, IPR2024-01024, IPR2024-01025, & IPR2024-01026 |
| **Date:** | Friday, October 4, 2024 12:44:44 PM |
| **Attachments:** | image001.png<br>image002.png<br>image003.png |

Counsel, the panel authorizes a 5-page Reply by Petitioner, due within 1 week of this email, and a 5-page Sur-reply by Patent Owner, due one week thereafter, one Reply and one Sur-Reply for each patent, to address what Petitioner alleges are "unforeseeable changes in PO positions as presented in its recent POPR filings" related only to claim construction issues. To the extent Petitioner attempts to raise new arguments and/or introduce new evidence that do not arise from any unforeseeable claim construction issues, the panel will not consider the arguments and/or evidence, but in any case, will consider claim construction arguments.

Best regards,
Eric W. Hawthorne
*Supervisory Paralegal Specialist*
*Patent Trial and Appeal Board*

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**From:** Jerry Tice <jtice@bdiplaw.com>
**Sent:** Wednesday, October 2, 2024 6:42 PM
**To:** Scott.McKeown@WolfGreenfield.com; Trials <Trials@USPTO.GOV>
**Cc:** Aaron Hand <ahand@bdiplaw.com>; VideoLabs_Roku <VideoLabs_Roku@bdiplaw.com>; Victor.Cheung@WolfGreenfield.com; SMcKeown-PTAB@WolfGreenfield.com
**Subject:** RE: IPR2024-01023, IPR2024-01024, IPR2024-01025, & IPR2024-01026

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Dear Honorable Board,

Patent Owner writes to address Petitioner's "Note," provided to Patent Owner for the first time in the email below. Petitioner misrepresents that there was no "request, discussion, or 'refusal' ever occurred relative to 'additional evidence, theories and analysis…of asserted references.'" As shown in the attached correspondence, Patent Owner specifically informed Petitioner that it objects "to Petitioner straying beyond the arguments related to the meaning of the term, including any attempt to provide additional evidence, theories, or analysis to the meaning or disclosure of any asserted reference or obviousness." Petitioner declined to address that objection and instead requested an insert from Patent Owner. It is not Patent Owner's statement that is misrepresentative, and it is telling that Petitioner did not raise this issue with Patent Owner prior to sending the email below.

Regarding the purported "second contradiction," Patent Owner understands it to be related to a purported contradiction in how Roku's products practice the "independent" claim term and how Russ fails to disclose the term—i.e., the scope of the term. Indeed, as the Complaint does not discuss the Russ reference, there can be no inconsistency in how Patent Owner addressed the reference. As such, Patent Owner has not demanded or requested that briefing be limited to the purported "first contradiction."

If Petitioner is now agreeing that the reply will not provide additional evidence, theories, or analysis as to the meaning or disclosure of any asserted reference or obviousness, Patent Owner does not oppose a reply, but

Patent Owner maintains its position that the reply be limited to five pages and its request for an equal-length sur-reply.

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**From:** Scott.McKeown@WolfGreenfield.com <Scott.McKeown@WolfGreenfield.com>
**Sent:** Wednesday, October 2, 2024 5:02 PM
**To:** trials@uspto.gov
**Cc:** Jerry Tice <jtice@bdiplaw.com>; Aaron Hand <ahand@bdiplaw.com>; VideoLabs_Roku <VideoLabs_Roku@bdiplaw.com>; Victor.Cheung@WolfGreenfield.com; SMcKeown-PTAB@WolfGreenfield.com
**Subject:** IPR2024-01023, IPR2024-01024, IPR2024-01025, & IPR2024-01026

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**[EXTERNAL]**

Trials,
Petitioner seeks authorization for a 7-page Reply (one for the '304 patent and one for the '236 patent) to address unforeseeable changes in PO positions as presented in its recent POPR filings. The POPRs filed in the above captioned proceedings present arguments that contradict clam scope representations made before the Court.
Specifically:

- PO arguments pertaining to the scope of the claim term "independent" as it relates to Russ. Good cause exists for a Reply as the POPR argue that a "root of trust is not "independent" just because it is different." This directly contradicts the position explained in PO's complaint that "HDCP clients are authenticated using the HDCP authentication process (shown in the blue boxes in the below figures), which is different than the first authentication processes described above."
- PO's position pertaining to Russ that **"**the headend 102 controls any authentication of a client-receiver, controls what content it can receive, and can, at any time, remove a client-receiver as an authorized device" which contradicts the position in PO's complaint that "[c]ontent is transmitted to the connected TV, or other connected device, over the HDMI interface as HDCP encrypted content in accordance with the requirements of the HDCP enforcement security messages specified by the primary security system platform."

Petitioner proposes its filing be due one week from any Order of the Board.
(Note: Petitioner includes PO's argument below as a professional courtesy despite its extensive argumentation for a Board email, and surprising misrepresentations. Petitioner simply seeks briefing on the two contradictions above, nothing more. PO opposes the second contradiction in particular. No request, discussion, or "refusal" ever occurred relative to "additional evidence, theories and analysis…of asserted references." Petitioner simply would not agree to PO's demand that its briefing request be limited to the first contradiction above.)

**Patent Owner's Position**

While Patent Owner disagrees that it changed positions or that it was "unforeseeable" that Patent Owner would demonstrate that the asserted art fails for at least similar reasons as the similar art distinguished in prosecution, Patent Owner informed Petitioner during the conferral process that it generally does not oppose a five-page reply brief to address "claim construction argument pertaining to [the] 'independent'" claim terms, provided that Patent Owner be permitted to submit an equivalent-length sur-reply brief. More particularly, while there are no inconsistencies between the POPR and the complaint, Patent Owner does not object to Petitioner discussing any purported inconsistencies regarding the "independent" claim term to support its construction. However, Patent Owner opposes Petitioner's specific request for two reasons.

First, Petitioner's request is not limited to claim construction issues. During the conferral process, Petitioner would not agree to limit its reply to arguments related to the meaning of the claim term, and, particularly, to not provide additional evidence, theories, or analysis as to the meaning or disclosure of any asserted reference or obviousness. Petitioner's refusal strongly suggests that Petitioner does intend to provide additional evidence, theories, and analysis to the meaning and disclosures of asserted references and obviousness. The Board should reject Petitioner's attempt to do so under the guise of a purported claim

construction dispute. To the extent the Board grants a reply, Patent Owner requests that the Board narrowly limit the reply to address the construction of the "independent" claim term.

Second, any reply brief should be limited to five pages. During the conferral process, Petitioner indicated that five pages was agreeable if the parties reached full agreement regarding Petitioner's request. Further, if Petitioner does intend to limit its reply to construction of the "independent" term and purported inconsistencies in Patent Owner's complaint relating thereto, then five pages is sufficient.

Should the Board grant Petitioner a reply (however limited) Patent Owner respectfully requests permission to submit an equivalent-length sur-reply.

Should a conference be deemed necessary, the parties are available **Tuesday October 8th at 12-5PM**.




**Scott McKeown (Mik-Q-En)**
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