

From: [Trials](#)
To: [Lestin Kenton](#); [Jennifer Chagnon](#); [Christopher O'Brien](#); [Syed Ahmed](#); [Jessica Harrison](#); [PTAB Account](#); [Stephen Zinda](#); [James Hall](#); [Paralegal](#)
Cc: [Trials](#)
Subject: RE: IPR2024-01054 ('768 Patent); -01055 ('622 Patent); -01057 ('848 Patent); -01058 ('849 Patent) // Petitioner's Request for Reply to Patent Owner's Preliminary Responses
Date: Monday, January 6, 2025 2:08:48 PM
Attachments: [image001.png](#)
[image002.png](#)

Counsel,

The Board denies Petitioner's request for leave to submit a pre-institution reply in IPR2024-01054, -01055, -01057, and -01058 for the reasons given by Patent Owner.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Lestin Kenton <LKENTON@sternekessler.com>
Sent: Friday, December 20, 2024 4:06 PM
To: Trials <Trials@USPTO.GOV>
Cc: Jennifer Chagnon <JChagnon@sternekessler.com>; Christopher O'Brien <COBrien@sternekessler.com>; Syed Ahmed <SyedAhmed@sternekessler.com>; Jessica Harrison <JHarrison@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>; Stephen Zinda <stephen@chzfirm.com>; James Hall <james@chzfirm.com>; Paralegal <paralegal@chzfirm.com>
Subject: Re: IPR2024-01054 ('768 Patent); -01055 ('622 Patent); -01057 ('848 Patent); -01058 ('849 Patent) // Petitioner's Request for Reply to Patent Owner's Preliminary Responses

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Re: IPR2024-01054 ('768 Patent); -01055 ('622 Patent); -01057 ('848 Patent); -01058 ('849 Patent) // Petitioner's Request for Reply to Patent Owner's Preliminary Responses

IPR2024-01054 // U.S. Patent No. 8,510,768
IPR2024-01055 // U.S. Patent No. 8,756,622
IPR2024-01057 // U.S. Patent No. 10,719,848
IPR2024-01058 // U.S. Patent No. 10,719,849

Your Honors,

Petitioner Roku respectfully requests authorization to file a short reply to Patent Owner's

Ex. 3001
IPR2024-01054
IPR2024-01055
IPR2024-01057
IPR2024-01058

Preliminary Response in each of the referenced IPRs, on the following issues:

In IPR2024-01054 and IPR2024-01057, Petitioner requests a reply to address the prior art status of the Seet reference and the case law relied upon by Patent Owner. Patent Owner argues that the Seet provisional does not provide written description support for claim 9. Specifically, Patent Owner contends that the Seet provisional addresses only audio media, whereas Seet's claim 9 encompasses both audio and video media. Good cause exists for a Reply, because the panel can benefit from additional briefing on this issue, in particular a more fulsome analysis of the case law regarding written description support for a claimed genus with disclosure of a species thereof. Petitioner also should be afforded the opportunity to respond to the fact-based inquiry of whether the Seet provisional provides written description for claim 9.

In IPR2024-01055 and IPR2024-01058, Petitioner requests a reply to address the §325(d) discretionary denial arguments raised by Patent Owner. Good cause exists to authorize such a Reply. Consistent with previous Board rulings, the panel can benefit from additional briefing on the issue of discretionary denial, including §325(d).

Petitioner respectfully requests a 5-page Reply for each POPR, due 10 business days after the Board's authorization. Petitioner does not oppose Patent Owner also submitting a corresponding 5-page Sur-reply in each of the referenced proceedings, due 10 business days after Petitioner's reply.

The parties met and conferred, and Patent Owner opposes the request.

Patent Owner's position is as follows.

While petitioners may seek leave to file a preliminary reply, a showing of good cause is required under 37 C.F.R. § 42.108(c).

With respect to IPR2024-01054 and IPR2024-01057, Petitioner carries the burden of demonstrating that Seet is entitled to its provisional priority date, and Petitioner analyzed the Seet Provisional in an effort to carry its burden. Patent Owner's preliminary response properly responded to and rebutted Petitioner's arguments. Petitioner's request appears to simply be a request for additional briefing to address weaknesses in its arguments highlighted in the preliminary response. Petitioner's request to respond to the "fact-based inquiry of whether the Seet provisional provides written description for claim 9," does not explain why it did not perform this inquiry and analysis in its Petition as required to meet its burden of proof (and which cannot be met by any material included in reply). Petitioner's arguments that the Board "can benefit" from "a more fulsome analysis of the case law" and "additional briefing on this issue" could be said in virtually any case, and does not constitute the required good cause. The Board is well-versed in this area of law and Petitioner does not identify any mischaracterizations or misrepresentations of law purportedly made by Patent Owner.

Similarly, with respect to IPR2024-01055 and IPR2024-01058, that the "panel can benefit from additional briefing on the issue" does not demonstrate good cause. Additionally, Petitioner dedicated a considerable part of its Petition analyzing § 325(d). This was an issue that was not only foreseeable, but one that Petitioner specifically addressed. The fact Petitioner desires to respond to Patent Owner's identification of weaknesses in the Petitions' § 325(d) arguments is not good cause to file a reply.

If the Board believes a call is necessary the parties are available at the following dates/times:

12/23: any time after 10am ET

12/25: any time after 10am ET.

Respectfully,
Lestin



Lestin Kenton

Director

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