UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIVERSAL REMOTE CONTROL, INC.
Petitioner

v.

UNIVERSAL ELECTRONICS, INC.
Patent Owner

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Case IPR2013-00127
Patent 6,587,067 C1

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Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and SCOTT R.
BOALICK, *Administrative Patent Judges.*

BLANKENSHIP, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
*37 C.F.R. § 42.108*

## I. BACKGROUND

Universal Remote Control, Inc. (Petitioner) requests *inter partes* review of claims 1-6 (all the claims) of US Patent 6,587,067 C1 under 35 U.S.C. §§ 311 *et seq*. Paper No. 6; "Pet." [1]  Universal Electronics, Inc. (Patent Owner) submitted a preliminary response under 37 C.F.R. § 42.107(b) on April 30, 2013. Paper No. 12; "Prelim. Resp." We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we institute an *inter partes* review of claims 1-6 of the '067 patent.

### A. *The Challenged Patent*

The '067 patent (Ex. 1001)[2] describes a universal remote control (Fig. 1) comprising a keyboard having pushbuttons, including a macro pushbutton, and a library of codes and data for use in transmitting operating commands to different home appliances of different manufacturers. Abstract. The macro pushbutton may be programmed to achieve a function that normally requires the actuation of several buttons. '067 patent col. 14, l. 14 *et seq*.; Figs. 18A - 18B.

### B. *Illustrative Claims*

1. In a universal remote control comprising a keyboard having a plurality of pushbuttons including a macro pushbutton and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, a readable medium having instructions for performing steps comprising:

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[1] We herein refer to the amended Petition filed February 6, 2013; Paper No. 6.

[2] Petitioner has provided a copy of the *ex parte* Reexamination Certificate (Ex. 1009 at 1-2).

matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard, the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched; and

assigning to the macro pushbutton a subset of the selected codes and data from the library whereafter activation of the macro pushbutton causes the universal remote control to use the subset of selected codes and data from the library to transmit a plurality of operating commands to one or more of the matched home appliances.

2. The readable medium as recited in claim 1, wherein the instructions further perform the step of using activation of one or more pushbuttons of the keyboard to assign the subset of the selected codes and data from the library to the macro pushbutton.

*C. Related Proceedings*

The '067 patent is involved in litigation styled *Universal Electronics Inc., v. Universal Remote Control, Inc*., Case No. SACV 12-00329 AG (JPRx) (C.D. Cal.), filed on March 2, 2012.  Pet. 1.  The instant challenger has filed petitions for *inter partes* review against two other patents involved in the litigation: US 5,614,906 (IPR2013-00152); and US 5,414,426 (IPR2013-00168).  The '067 patent was the subject of a prior appeal in an *ex parte* reexamination proceeding that resulted in all claims being confirmed (Certificate Issued Feb. 15, 2011).  *See Ex parte Universal Electronics, Inc*., Appeal No. 2009-011530 (BPAI 2010) (expanded panel) (Ex. 1009).

*D. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability under 35 U.S.C. § 103(a):

I. Claims 1-6 over Rumbolt (US 4,774,511) (Ex. 1002) and Magnovox[3] (Ex. 1006);

II. Claims 1, 2, 4, and 5 over Rumbolt , Magnavox, and Evans (US 4,825,200) (Ex. 1004);

III. Claims 1-6 over Wozniak (US 4,918,439) (Ex. 1003) and CORE[4] (Ex. 1005); and

IV. Claims 1-6 over Rumbolt '359 (US 4,703,359) (Ex. 1011) and CORE. Pet. 6.

## II. ANALYSIS

*"Judicial Economy"*

Patent Owner submits that the Board should deny the petition "in the interest of judicial economy" because the patent has expired and, thus, cannot be amended and because the patent is already being litigated in the related U.S. District Court action. Prelim. Resp. 26.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

> THRESHOLD -- The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313

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[3] PR Newswire, "*Magnavox unveils Total Remote Tuning System and second generation Universal Remote Control,*" NAP Consumer Electronics Corp. (Apr. 1987).

[4] Karr et al., "*Core Reference Manual*" (1987).

shows that there is a reasonable likelihood that the petitioner would prevail
with respect to at least 1 of the claims challenged in the petition.

The threshold for instituting an *inter partes* review, defined by statute, does
not include consideration as to whether the patent can be amended, or whether the
patent is being litigated in a District Court action.  As the statutory threshold has
been met here, we decline to deny the petition on the basis proposed by Patent
Owner.

*Claim Construction*

The '067 patent has expired and, thus, as noted by both Petitioner and Patent
Owner, cannot be amended.  Our reviewing court recently acknowledged that the
USPTO applies a different standard of claim interpretation for expired patents.

> While claims are generally given their broadest possible scope during
> prosecution, *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000), the
> Board's review of the claims of an expired patent is similar to that of a
> district court's review, *Ex Parte Papst-Motoren*, 1 U.S.P.Q.2d 1655,
> 1655-56 (B.P.A.I. Dec. 23, 1986); *see also* MPEP § 2258 I.G
> (directing Examiners to construe claims pursuant to *Phillips v. AWH
> Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), during
> reexamination of an expired patent).

*In re Rambus, Inc*., 694 F.3d 42, 46 (Fed. Cir. 2012).

In *Ex parte Papst-Motoren*, 1 USPQ2d 1655 (BPAI 1986), an expanded
panel of the Board that included the PTO Commissioner, Deputy Commissioner,
and Board Chairman held that:

> [I]n reexamination proceedings in which the PTO is considering the
> patentability of claims of an expired patent which are not subject to
> amendment, a policy of liberal claim construction may properly and
> should be applied.  Such a policy favors a construction of a patent

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