

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSAL REMOTE CONTROL, INC.
Petitioner

v.

UNIVERSAL ELECTRONICS, INC.
Patent Owner

Case IPR2013-00152
Patent 5,614,906

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

BLANKENSHIP, *Administrative Patent Judge*.

DECISION
Denying 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, 10, 12, and 16 of US Patent 5,614,906 under 35 U.S.C. §§ 311 *et seq.* Paper No. 2 (“Pet.”). Universal Electronics, Inc. (Patent Owner) submitted a preliminary response under 37 C.F.R. § 42.107(b) on May 22, 2013. Paper No. 7 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

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 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.

For the reasons that follow, the petition is *denied*.

A. The Challenged Patent

The '906 patent (Ex. 1001) describes a remote control device (Fig. 1) having remote control command sets, each set consisting of commands for operating a different remotely controllable device. In a remote control device programming (select) procedure, a command from each set, having an effect that is observable in the remotely controlled device -- such as a command for “power off” -- is assigned to a corresponding one of user actuated keys. The user presses the keys one by one until the user observes the desired effect on the remotely controlled device. The user then signals the remote control device to exit the select procedure. The remote control device sets the remote control to transmit future commands from

the command set that includes the last transmitted effects observable command having the observed desired effect. '906 patent Abstract; col. 6, ll. 20-37, 50-57.

B. Illustrative Claims

1. A method for selecting an appropriate one of a plurality of command sets stored in a remote control having a plurality of assignable user actuated switches or keys for controlling a remotely controllable electronic device, comprising the steps of:

(a) assigning an effects observable command from each of said plurality of command sets to one of said plurality of assignable user actuated switches or keys, each assigned, effects observable command to be transmitted when the corresponding one of the assignable user actuated switches or keys is actuated;

(b) actuating sequentially and individually each one of the plurality of assignable user actuated switches or keys, to individually transmit each assigned effects observable command until the proper effect is observed;

(c) halting the actuating of the plurality of assignable user actuated switches or keys; and

(d) setting the remote control to transmit future remote control commands from the command set containing the last transmitted effects observable command.

16. An apparatus for selecting an appropriate one of a plurality of command sets stored in a remote control having a plurality of assignable user actuated switches or keys for controlling a remotely controllable electronic device, comprising:

means for assigning an effects observable command from each of the plurality of command sets to one of said plurality of assignable user actuated switches or keys;

means for transmitting said effects observable command when the corresponding one of said plurality of assignable user actuated switches or keys is actuated;

means for indicating the halting of the actuation of the plurality of assignable user actuated switches or keys; and

means for setting the remote control to transmit future remote control commands from the command set containing the last transmitted effects observable command.

C. Related Proceedings

The '906 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 Petitioner has filed petitions for *inter partes* review against two other patents involved in the litigation: US 6,587,067 (IPR2013-00127) and US 5,414,426 (IPR2013-00168).

D. Asserted Grounds of Unpatentability

Petitioner asserts the following ground of unpatentability under 35 U.S.C. § 102(b):

I. Claims 1 and 16 over Telefunken (DE 3313493 A1; Oct. 18, 1984)¹ (Ex. 1003).

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

II. Claims 10 and 12 over Telefunken and Casio (JP H6-311567; Nov. 4, 1994) (Ex. 1004);

III. Claims 1 and 16 over Sony (EP 0 577 267 A1; Jan. 5, 1994) (Ex. 1005) and Telefunken;

IV. Claims 10 and 12 over Sony, Telefunken, and Casio;

V. Claims 1, 10, and 12 over GHV-300/GHV-500² and MRH7700³;

VI. Claim 16 over GHV300/GHV-500, MRH7700, and Telefunken;

VII. Claims 1, 10, and 12 over GHV-300/GHV-500, Pioneer⁴, and Casio; and

VIII. Claim 16 over GHV-300/GHV-500, Pioneer, and Telefunken. Pet. 5-6.

¹ An English translation accompanies each foreign-language publication.

² GHV 300 VHS VCR User Manual (Ex. 1006) and GH500 VHS VCR User Manual (Ex. 1007), both undated.

³ Installation and Operation KI-1844A, MRH7700 IR Remote Control, Rauland-Borg Corp., May 1994 (Ex. 1009).

⁴ Operating Instructions, Audio/Video Stereo Receiver VSX-5900S, Pioneer Corp., undated (Ex. 1010).

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