

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 IPR2014-01104
Patent 5,414,761

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, Universal Remote Control, Inc., filed a Petition requesting an *inter partes* review of claims 1, 9, 10, and 14–17 of U.S. Patent No. 5,414,761 (Ex. 1001, “the ’761 patent”) under 35 U.S.C. §§ 311–319. Paper

1 (“Petition” or “Pet.”). Patent Owner, Universal Electronics, Inc., filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, on January 6, 2015, we instituted an *inter partes* review of claims 1, 9, 10, and 14–17 on one ground of unpatentability, pursuant to 35 U.S.C. § 314. Paper 9 (“Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response in both unredacted (confidential) and revised redacted forms (Papers 14 and 44 (“PO Resp.”)), along with a Motion to Seal (Paper 15). Petitioner filed a Reply in both unredacted (confidential) and revised redacted forms (Papers 21 and 45 (“Pet. Reply”)), along with a Motion to Seal (Paper 22).

Petitioner filed a Motion to Exclude (Paper 28; “Pet. Mot. to Exclude”) certain portions of Exhibits 1053 and 1054. Patent Owner filed an Opposition to the Motion to Exclude (Paper 35; “PO Exclude Opp.”), and Petitioner filed a Reply (Paper 37; “Pet. Exclude Reply”).

Patent Owner filed a Motion to Exclude (Paper 29; “PO Mot. to Exclude”) Exhibit 1043, and portions of Petitioner’s Reply that rely on Exhibit 1043. Petitioner filed an Opposition to the Motion to Exclude (Paper 33; “Pet. Exclude Opp.”), and Patent Owner filed a Reply (Paper 36; “PO Exclude Reply”). Patent Owner filed a Motion for Observations (Paper 30) and Petitioner filed a Response to the Observations (Paper 34).

An oral hearing was held on August 19, 2015, and a transcript of the hearing is included in the record (Paper 47; “Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 9, 10, 14, and 15 of the '761 patent are unpatentable. Petitioner, however, has not shown by a preponderance of the evidence that claims 16 and 17 are unpatentable.

A. Related Proceedings

According to the parties, the '761 patent is involved in the following lawsuit: *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, No. SACV 13-00984 AG (JPRx) (C.D. Cal.). Pet. 1; Paper 4.

B. The '761 Patent

The '761 patent relates to a remote control that includes input circuitry with a set of keys or pushbuttons for inputting commands to the remote control, infrared signal output circuitry for supplying an infrared signal to a controlled device, and a central processing unit (CPU) coupled to the input circuitry. Ex. 1001, Abstract, Fig. 8, Fig. 9B. Memory is coupled to the CPU, which stores code data for generating infrared light to control an apparatus. *Id.* Memory may be updated from outside the remote control through data coupling circuitry and structure coupled to the CPU. *Id.*

Figure 20 of the '761 patent is reproduced below.

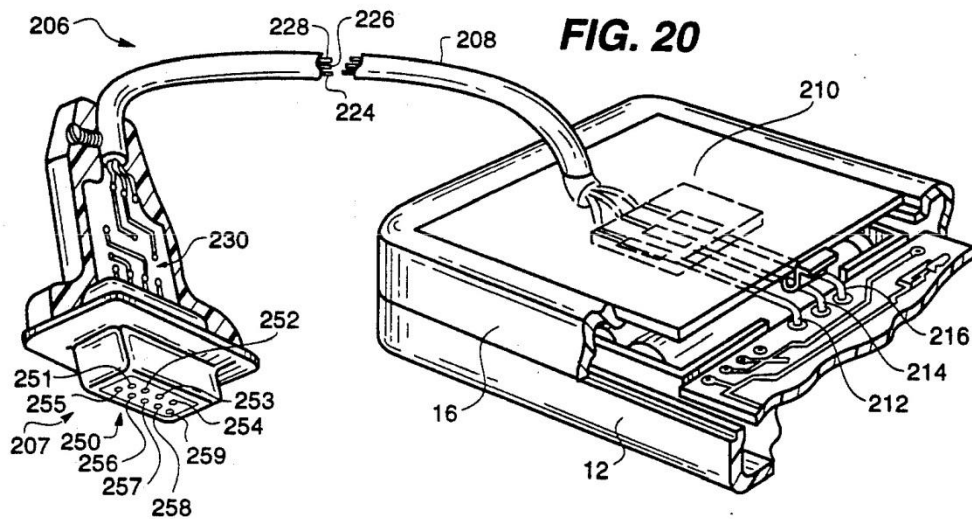


Figure 20 is a fragmentary perspective view of a connector having conversion circuitry and a battery case cover by which data can be input into the RAM of the operating circuitry of a remote control device. Ex. 1001, 4:28–33. Signal coupling and converting assembly 206 includes connector assembly 207, cable 208, and cover plate 210 for battery compartment 45 (Fig. 7). Cover plate 210 has three pins 212, 214, and 216 on its underside, which are positioned to connect with three serial ports 1, 2, and 3 (Fig. 7) of the remote control device. *Id.* at 19:43–49. Pins 212, 214, and 216 are connected by three wire conductors 224, 226, and 228 in cable 208 to connector assembly 207, which contains conversion circuitry 230. Conversion circuitry 230 (Figs. 21, 22) enables using some of the nine sockets 250 of connector assembly 207 for communication with serial ports 1, 2, and 3 via pins 212, 214, and 216. *Id.* at 19:49–59.

C. Illustrative Claim

Each of claims 1, 14, 15, 16, and 17 is independent. Claim 1, reproduced below, is illustrative.

1. A remote control system with data coupling including: a remote control comprising input means including a set of keys or pushbuttons for inputting commands into the remote control, infrared signal output means including IR lamp driver means for supplying an infrared signal to a controlled device, a central processing unit (CPU) coupled to the input means and to the signal output means, memory means coupled to the CPU and data coupling means including receiving means coupled to the CPU for enabling at least one of (a) instruction codes or (b) code data for creating appropriate IR lamp driver instructions for causing the infrared signal output means to emit infrared signals which will cause specific functions to occur in a specific controlled device, for operating a variety of devices to be controlled, to be supplied from outside the remote control through the receiving means directly to the CPU for direct entry to the memory to enable the remote control to control various devices to be controlled upon the inputting of commands to the keys of the input means and a data transmission system including coupling means for coupling the receiving means to a computer, directly, through a telephone line, through a modem and a telephone line, or through decoding means and a television set which receives a television signal containing at least one of the instruction codes or the code data.

Id. at 22:51–23:9.

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