

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 IPR2014-01106
Patent 5,255,313

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

BLANKENSHIP, *Administrative Patent Judge*.

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

I. BACKGROUND

Petitioner, Universal Remote Control, Inc., filed a petition requesting an *inter partes* review of claims 1, 2, and 20 of U.S. Patent No. 5,255,313 (Ex. 1001, “the ’313 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.”). We have jurisdiction under 35 U.S.C. § 314. Section 314 provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . 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, we institute an *inter partes* review of claims 1, 2, and 20 of the ’313 patent.

A. Related Proceedings

According to Petitioner, the ’313 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.

B. The ’313 Patent

The ’313 patent relates to a universal remote control system that includes a computer having a memory and code data for creating infrared (IR) lamp driver instructions for the remote controller. Ex. 1001, Abstract.

Figure 20 of the '313 patent is reproduced below.

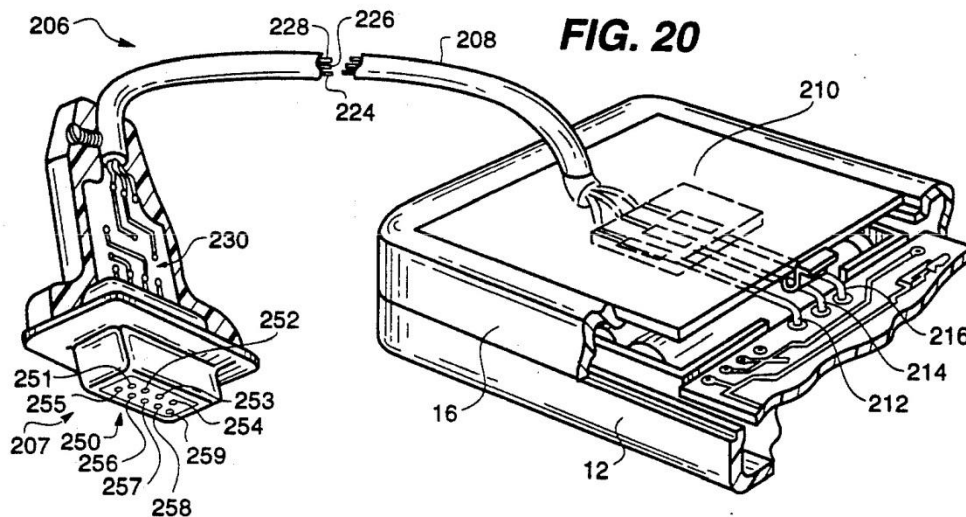


Figure 20 is a fragmentary perspective view of a connector having conversion circuitry and a battery case cover by which data can be input into the RAM of the operating circuitry of a remote control device. Ex. 1001, col. 4, ll. 22–27. Signal coupling and converting assembly 206 includes connector assembly 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 control device. *Id.* at col. 19, ll. 39–45. 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 col. 19, ll. 45–55.

C. Illustrative Claim

Each of claims 1, 2, and 20 is independent. Claim 1, reproduced below, is illustrative.

1. A universal remote control system including a computer having a memory, code data for creating appropriate infrared (IR) lamp driver instructions for causing an infrared signal generator 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, stored in said memory of said computer, a universal 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 circuitry for supplying an infrared signal to a controlled device, a central processing unit (CPU) coupled to said input means and to said signal output means, memory means coupled to said CPU, and data coupling means for periodically coupling said computer to said remote control for receiving from said computer memory said code data for creating appropriate IR lamp driver instructions for causing said infrared signals which will cause specific functions to occur in a specific controlled device, for operating a variety of devices to be controlled into said memory means of said remote control to enable said 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 said data coupling means for coupling said remote control to said computer, directly, through a telephone line, through a modem and a telephone line, or through decoding means and a television set to receive a television signal picked up by the television set.

D. Asserted Prior Art

Wozniak	US 4,918,439	Apr. 17, 1990	Ex. 1005
Hastreiter	US 4,667,181	May 19, 1987	Ex. 1006

Ciarcia	Steve Ciarcia, “Build a Trainable Infrared Master Controller,” <i>BYTE</i> , at 113	Mar. 1987	Ex. 1007
CS-232 Manual	R. Karr et al., “CORE Serial Interface (CS-232) Manual,” rev. 3.0 Copyright by CL9	1988	Ex. 1008

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability under 35 U.S.C. § 103(a) against claims 1, 2, and 20:

References	Claims
Wozniak, CS-232 Manual, and Hastreiter	1, 2, and 20
Ciarcia and Hastreiter	1, 2, and 20

II. ANALYSIS

A. Claim Interpretation

The '313 patent has expired and, thus, cannot be amended. For claims of an expired patent, the Board's claim interpretation is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17

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