

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 IPR2014-01146
Patent 8,243,207 B2

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

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

Petitioner Universal Remote Control, Inc. filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 12–15 of U.S. Patent No. 8,243,207 B2 (Ex. 1001, the “’207 patent”). Patent Owner Universal Electronics, Inc. filed a Preliminary Response (Paper 8, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a). We conclude that Petitioner has shown a reasonable likelihood of prevailing in challenging claims 13–15 and we institute *inter partes* review as to such claims.

I. BACKGROUND

A. The ’207 patent (Ex. 1001)

The ’207 patent, titled System and Method for Activity Based Configuration of an Entertainment System, relates to methods for configuring multi-input and/or multi-output home entertainment systems. Ex. 1001, 1:31–33. The invention routes the outputs and inputs of the various components of an audio/visual (“AV”) system through one central device, such as an AV receiver. *Id.* at 1:34–36.

The invention contemplates sending a signal from a universal remote control device to a central, “entertainment device” in order to initiate a pre-defined configuration of the AV system. *Id.* at 1:37–45. In addition to the control signals sent to the central entertainment device, the invention also contemplates sending control signals to other appliances in the AV system. *Id.* at 1:45–50. These signals to the other appliances can be transmitted directly from the remote control to the other appliances or indirectly by a signal transmitted from the remote to the central entertainment device, which, in turn, transmits control signals to the other appliances. *Id.* This latter feature takes advantage of the fact that the central entertainment device

has access to appliance status information not available to the remote control device and the remote control device, in turn, has access to appliance command functions not available to the central entertainment device. *Id.* at 1:49–57.

Figure 1 of the '207 patent is shown below.

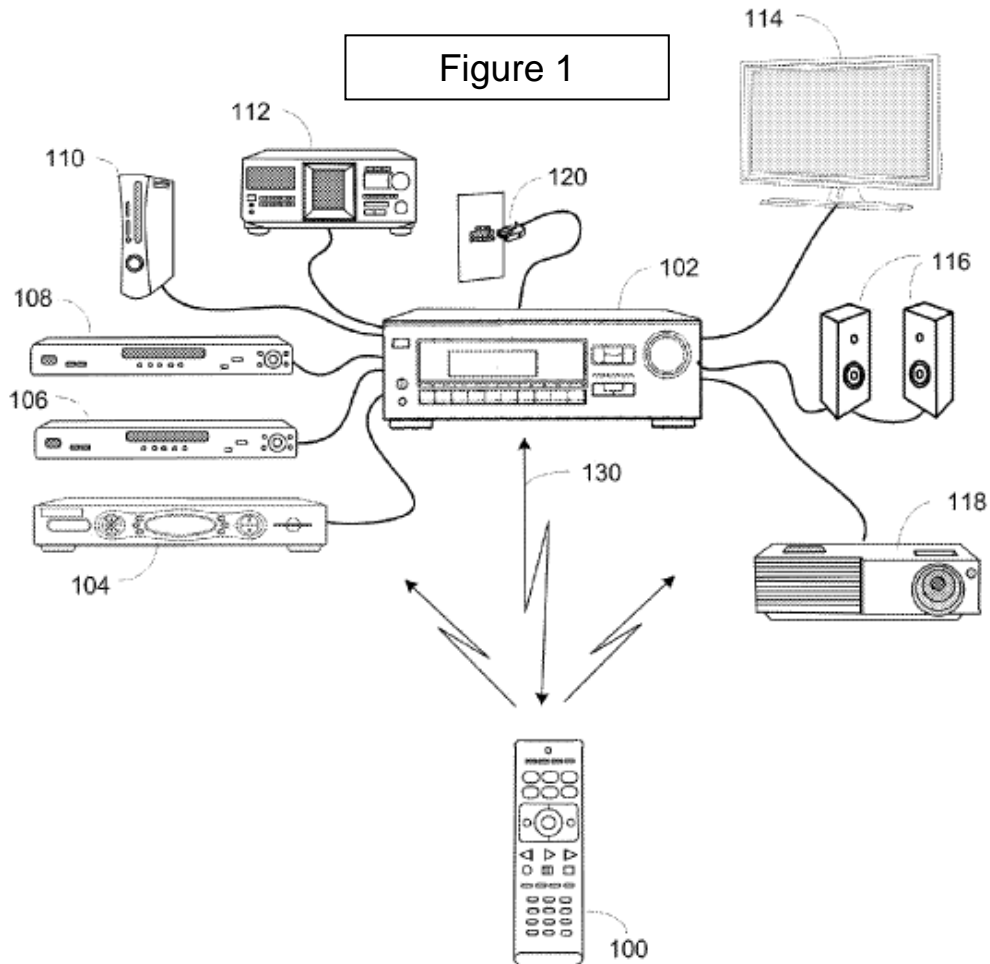


Figure 1 illustrates an AV system in which the outputs of source appliances such as set top box 104, first DVD player 106, second DVD player 108, game console 110, and CD changer 112 are all connected as inputs to an AV receiver or “entertainment device” 102. *Id.* at 2:27–32. AV receiver 102 switches the input stream to designated outputs which are connected to various AV devices such as TV 114, projector 118, and/or speakers 116. *Id.*

at 2:33–38. Also illustrated is a universal remote control or “controlling device” 100 that transmits commands to the appliances. *Id.* at 2:44–46.

B. Illustrative Claim

Petitioner challenges claims 12–15. Claim 12, reproduced below, is an independent claim:

12. A method for configuring an audio visual entertainment device in communication with a plurality of devices for an activity, comprising:

associating a command value corresponding to an activity key of a controlling device with a configuration of the entertainment device, the configuration of the entertainment device comprising at least one of the plurality of devices being used as an audio visual input source device for the entertainment device and at least one of the plurality of devices being used as an audio visual output destination device for the entertainment device;

causing the entertainment device to access and use the configuration associated with the command value corresponding to the activity key of the controlling device in response to the entertainment device receiving from the controlling device a signal which includes the command value corresponding to the activity key of the controlling device; and

displaying in a display associated with the entertainment device a graphical user interface for allowing a user to select at least one of the plurality of devices to be used in the configuration;

wherein the user selection of at least one of the plurality devices to be used in the configuration comprises one or more signals received from the controlling device having data indicative of an appliance, wherein the one or more signals are transmitted from the controlling device to the entertainment device in response to an activation of a one or more keys of the controlling device which are associated within the

controlling device to an appliance being selected for use in the configuration, and wherein the controlling device further uses the activation of the one or more keys to automatically configure itself whereupon an activation of one or more command keys of the controlling device will cause the controlling device to communicate commands to the one or more of the audio visual source device and the audio visual output destination device.

C. The Asserted Grounds of Unpatentability

Petitioner challenges claims 12–15 of the '207 patent based on the alleged grounds of unpatentability set forth in the table below, as further supported by the Declaration of James T. Geier (Ex. 1003).¹

Reference(s)	Basis	Claims challenged
Dubil (Ex. 1005) ²	§ 102	12–15
Dubil	§ 103	12–15
Niles (Ex. 1006) ³	§ 103	12–15
Niles and Dubil	§ 103	12–15
Niles and Kozakai (Ex. 1007) ⁴	§ 103	12–15
Niles, Dubil, and Kozakai	§ 103	12–15

¹ The Petition purports to advance only two (2) grounds of unpatentability denominated as such. However, due to Petitioner's use of conjunctive and/or disjunctive connectors in each of the two grounds, we calculate that Petitioner is asserting six grounds. *See Edmund Optics, Inc. v. Semrock, Inc.*, Case IPR2014-00583(PTAB Sept. 19, 2014) (Paper 9) (discussing multiplication of grounds due to use of conjunctive and disjunctive connectors).

² U.S. Patent Pub. 2003/0120831 A1, published June 26, 2003.

³ Niles Audio Corp., IntelliControl Reference Manual, Ver. 8.1, Apr. 2002.

⁴ U.S. Patent 4,527,204 to Kozakai, et al, titled Remote Control System, issued July 2, 1985.

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