

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 IPR2014-01146  
Patent 8,243,207 B2

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

CAPP, *Administrative Patent Judge*.

DECISION  
*Denying Petitioner's Request for Rehearing*  
37 C.F.R. § 42.71

Petitioner Universal Remote Control, Inc. filed a Request for Rehearing (Paper 11, “Req.”) in connection with the Decision on Institution (Paper 9, “Decision”). Petitioner contends that we erred in denying institution of *inter partes* review of claim 12 of the ’207 patent on grounds of anticipation and obviousness with respect to the Dubil reference. Req. 1.

In determining whether to institute an inter partes review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

For the reasons stated below, Petitioner’s Request for Rehearing is denied.

#### *Analysis*

In our Decision, we determined that the limitation in claim 12 directed to signal(s) transmitted from the controlling device to the entertainment device having data indicative of an appliance is not inherently satisfied by Dubil. Decision, 13. We stated that it was possible that Dubil’s remote 150 configures its AV system by doing nothing more than sending separate signals to satellite 115, VCR 113, and Television 110 without any of those separate signals containing data regarding a configuration interrelationship between and among those three AV system components. *Id.*

Petitioner argues that, even if Dubil operates in accordance with the above description, it nevertheless satisfies the claim limitation in question. Req. 2. This is not the argument that Petitioner made in its Petition. In its original Petition, Petitioner argued that:

In the '831 system, for VCR 113 (the entertainment device) to be configured to use the desired input and output devices (appliances) according to the selected activity, VCR 113 must receive signals from the remote control (controlling device) that indicate the appliances (input or output devices) to be used in the configuration. *Id.*

Petition (Paper 1), 23. Now, Petitioner argues that Dubil's VCR is not only the "entertainment device" of claim 12, but is also an "appliance," so that signals to Dubil's VCR (the entertainment device) have data "indicative of an appliance." Req. 2-3. Petitioner does not identify where this alternative theory was presented in the Petition. The Board's governing rule requires that a Request for Rehearing specifically identify the place where each matter was previously addressed. *See* 37 C.F.R. § 42.71(d). A Request for Rehearing is not an appropriate place for presenting new, alternative theories of unpatentability that could have been presented in an initial Petition.

Substantively, however, Petitioner's new theory is entirely without merit. The context of claim 12 requires that the "entertainment device" and an "appliance" are separate and distinct entities. Ex. 1001, claim 12. Thus, signals transmitted to the entertainment device having data indicative of an appliance does not refer to data indicative of the entertainment device itself.

Petitioner next argues that the transmission of three separate signals, i.e., to an entertainment device, an input appliance, and an output appliance respectively, satisfies the claim limitation in question. Req. 2. Again, this

theory was not presented in the Petition and thus also contravenes Rule 42.71(d).

Notwithstanding, Petitioner's new "three separate signal" theory is also without merit. Petitioner states that the signals sent to Dubil's TV and Satellite are also received by Dubil's VCR. Req. 3. Petitioner cites no evidence to support this statement. Petitioner offers neither evidence nor technical reasoning to explain how or why a signal that is sent to one device is necessarily received by some other device.

Petitioner next argues that the Board overlooked its discussion of obviousness at page 23 of the Petition. Req. 4. At page 23, Petitioner merely offers one conclusory sentence that: "To the extent there is an assertion that the '831 publication does not inherently disclose this limitation, a person of ordinary skill would understand that the claimed "user selection" is obvious based on the '831 disclosure itself." Petition, 23. Petitioner's evidentiary support for this conclusory statement is paragraph 39 of the Geier Declaration. *Id.* Mr. Geier's testimony is equally conclusory: "To the extent this feature is not inherent, it would have been obvious to one skilled in the art reading the '831 publication . . ." Ex. 1003, ¶ 39.

Here, Petitioner presents an obviousness ground over a single prior art reference, Dubil. Petitioner never clearly articulates the differences between Dubil and the claimed invention, nor does Petitioner clearly articulate, much less provide supporting evidence for, how or why a practitioner of ordinary skill would have modified Dubil to achieve the claimed invention.

With respect to motivation to modify the prior art to achieve the claimed invention, Mr. Geier merely states, in conclusory fashion, that it would have been obvious to transmit signals from the controlling device to

the entertainment device having data indicative of an appliance: “since the system described therein is specifically intended to allow a user to control a home theatre system, including the selected components therein through one or more signals from the remote control.” Ex. 1003, ¶ 39. This is insufficient to satisfy the threshold standard for institution of a trial. As we explained in our Decision, an entertainment device with one input appliance and one output appliance can be configured by simply transmitting separate signals to each respective component without any of those signals containing data regarding a configuration relationship between and among the three components. Decision, 13. Mr. Geier’s testimony does not amount to a threshold showing that a person of ordinary skill in the art would have modified Dubil’s system so that data indicative of an appliance would have been transmitted from the controlling device to the entertainment device.

In short, we did not overlook page 23 of the Petition, rather we carefully reviewed it and found it insufficient to meet the threshold requirement of a reasonable likelihood of prevailing. 35 U.S.C. § 314(a).

*Conclusion*

Petitioner’s Request for Rehearing is DENIED.

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