

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2019-01614
Patent 9,911,325 B2

Before PATRICK M. BOUCHER, MINN CHUNG, and
SHARON FENICK, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Roku, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–5 and 7 (the “challenged claims”) of U.S. Patent No. 9,911,325 B2 (Ex. 1001, “the ’325 patent”). Universal Electronics, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314(a) (2012); *see* 37 C.F.R. § 42.4 (2019). Taking into account the arguments and evidence presented in Patent Owner’s Preliminary Response, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of all the challenged claims. Accordingly, we institute an *inter partes* review of all challenged claims (1–5 and 7) of the ’325 patent, based on all grounds raised in the Petition.

II. BACKGROUND

A. Related Matters

According to Petitioner, the ’325 patent is the subject of the following district court litigation: *Universal Electronics, Inc. v. Roku, Inc.*, No. 8:18-cv-01580 (C.D. Cal.). Pet. 56. Patent Owner identifies the same case as a related matter. Paper 3, 2. The ’325 patent is one of several patents owned by Patent Owner that are challenged by Petitioner in various petitions for *inter partes* review, including in IPR2019-01595, IPR2019-01608, IPR2019-

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01612, IPR2019-01613, IPR2019-01615, IPR2019-01619, IPR2019-01620,
and IPR2019-01621. *See id.*

B. The '325 Patent

The '325 patent, titled “Relaying Key Code Signals Through a Remote Control Device,” issued March 6, 2018, from U.S. Patent Application No. 15/153,905, filed May 13, 2016 (“the '905 application”). Ex. 1001, codes (21), (22), (45), (54). The '905 application is a continuation of U.S. Patent Application No. 13/068,820, filed May 21, 2011 (issued as U.S. Patent No. 9,355,553), which is a continuation of U.S. Patent Application No. 12/462,526, filed August 4, 2009 (issued as U.S. Patent No. 8,004,389), which, in turn, is a continuation of U.S. Patent Application No. 10/737,029, filed December 16, 2003 (issued as U.S. Patent No. 7,589,642). *Id.* at code (63), 1:7–14.

The '325 patent “relates generally to remote control devices and, more specifically, to relaying key code signals through a remote control device to operate an electronic consumer device.” *Id.* at 1:18–21. Each of such key code signals “corresponds to a function of the selected electronic device, such as power on, power off, volume up, volume down, play, stop, select, channel up, channel down, etc.” *Id.* at 1:36–41. A set of key codes associated with a particular electronic device is referred to as a “codeset.” *Id.* at 1:36–38. The number of key code signals may be large, particularly when a single remote-control device is used to control multiple electronic devices. *Id.* at 1:54–62. Accordingly, the inventor of the '352 patent sought a system “for enabling a remote control device to control a selected one of multiple different electronic consumer devices without requiring the codeset

associated with the selected electronic consumer device to be stored on the remote control device.” *Id.* at 1:66–2:3.

Figure 1 of the '352 patent is reproduced below.

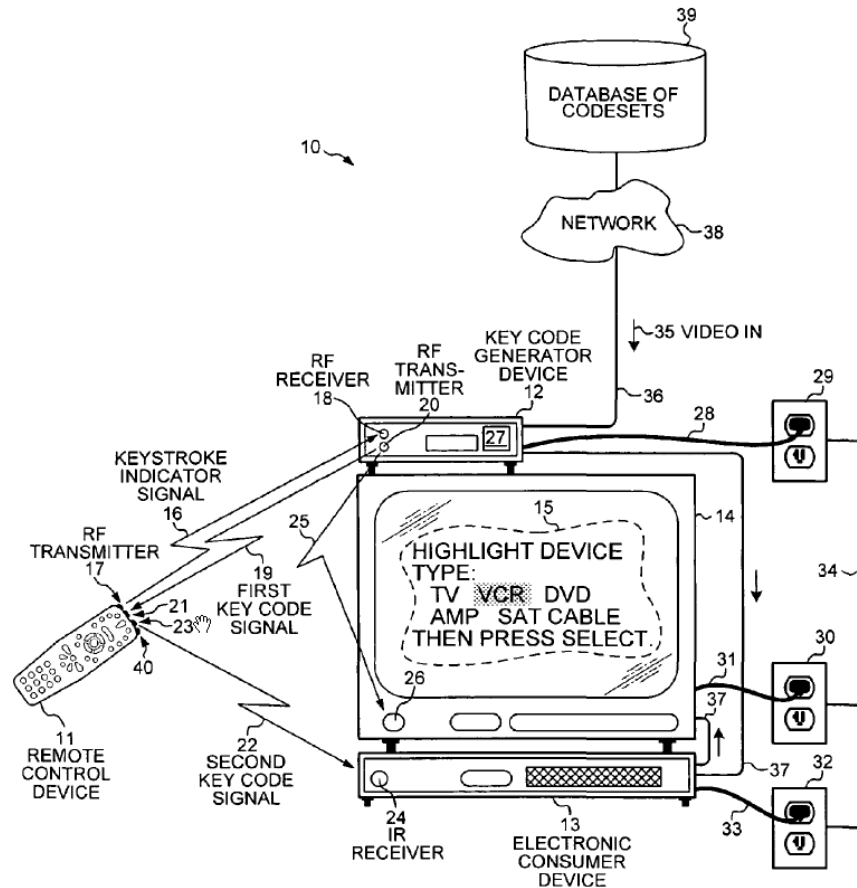


FIG. 1

Figure 1 illustrates a system for relaying a key code through a remote control device to an electronic consumer device. *Id.* at 3:19–21.

As depicted in Figure 1, system 10 includes remote control device 11, key code generator device 12 (shown as a set-top box), first electronic consumer device 13 (shown as a video cassette recorder (“VCR”)), and second electronic consumer device 14 (shown as a television set). *Id.* at 3:23–27, 3:37–40, 3:47–48. With remote control device 11, a user responds

to on-screen displays 15 of television set 14, generated by key code generator device 12, “to step through a sequence of menu screens to identify the codeset corresponding to the device that is to be controlled.” *Id.* at 3:31–35, 3:47–53. For example, system 10 may, in this way, identify the appropriate codeset to enable remote control device 11 to communicate with VCR 13 and television set 14. *Id.* at 3:47–55.

The '325 patent explains that, in some instances, key code generator device 12 is capable of communicating with remotely maintained database of codesets 39 over network 38, which may be the Internet. *Id.* at 8:60–63. A new codeset, such as may be associated with a new electronic consumer device introduced into the market, may thus be distributed from database 39 via network 38 and stored on a mass-storage hard disk within key code generator device 12. *Id.* at 8:64–9:5.

After generating a key code, key code generator device 12 modulates the key code onto a carrier signal, such as an RF signal, to generate “first key code signal 19.” *Id.* at 4:56–59. Figure 5 of the '352 patent is reproduced below.

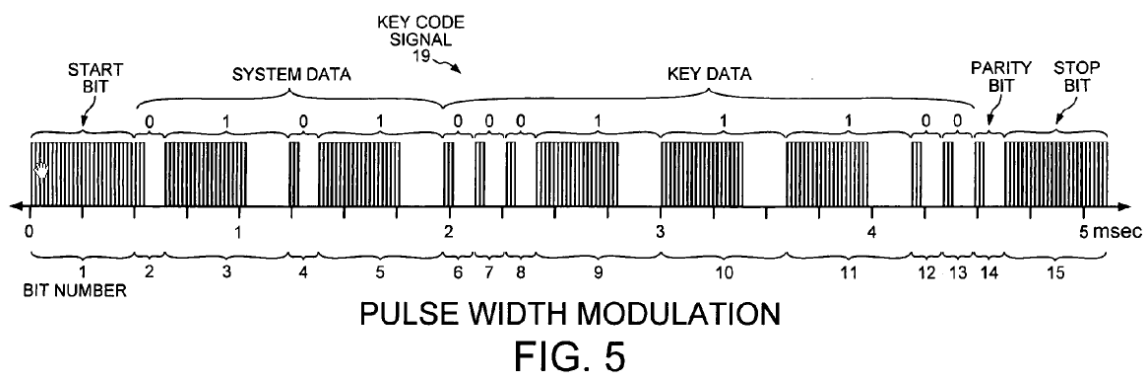


Figure 5 illustrates a twelve-bit key code modulated onto first key code signal 19 using pulse-width modulation. *Id.* at 5:21–23.

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