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Paper 31
Entered: April 13, 2021

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*.

JUDGMENT
Final Written Decision
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 318(a)

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I. INTRODUCTION

In this *inter partes* review ("IPR"), instituted pursuant to 35 U.S.C. § 314, Roku, Inc. ("Petitioner") challenges the patentability of claims 1–5 and 7 (the "challenged claims") of U.S. Patent No. 9,911,325 B2 (Ex. 1001, "the '325 patent"), owned by Universal Electronics, Inc. ("Patent Owner"). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine Petitioner has shown by a preponderance of the evidence that claims 1–5 of the '325 patent are unpatentable, but has not proven by a preponderance of the evidence that claim 7 of the '325 patent is unpatentable.

II. BACKGROUND

A. Procedural History

On September 18, 2019, Petitioner filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of the challenged claims of the '325 patent. Patent Owner filed a Preliminary Response (Paper 6, "Prelim. Resp.").

On April 16, 2020, applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we instituted an *inter partes* review of all challenged claims of the '325 patent based on all grounds presented in the Petition. Paper 7 ("Inst. Dec."), 36.

After institution, Patent Owner filed a Patent Owner Response (Paper 15, "PO Resp."), Petitioner filed a Reply to the Patent Owner Response (Paper 19, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 22, "PO Sur-reply"). An oral hearing was held on December 22, 2020, and a copy of the hearing transcript has been entered into the record. Paper 30 ("Tr.").

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B. Related Matters

Both parties identify *Universal Electronics, Inc. v. Roku, Inc.*, No. 8:18-cv-01580 (C.D. Cal.) ("the related litigation"), as involving the '325 patent. Pet. 56; 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, IPR2019-01612, IPR2019-01613, IPR2019-01615, IPR2019-01619, IPR2019-01620, and IPR2019-01621. Pet. 57; Paper 3, 2. The parties also note that the '325 patent claims the benefit of the filing date of the following patent applications: U.S. Patent Application No. 13/068,820, filed May 21, 2011 (now U.S. Patent No. 9,355,553 ("the '553 patent")); U.S. Patent Application No. 12/462,526, filed August 4, 2009 (now U.S. Patent No. 8,004,389 ("the '389 patent")); U.S. Patent Application No. 10/737,029, filed December 16, 2003 (now U.S. Patent No. 7,589,642 ("the '642 patent")). Pet. 57; Paper 3, 2–3.

In addition, the '642 patent was the subject of IPR2014-01082 ("the earlier IPR"), in which institution of trial was denied. *See* Ex. 2007, 369–379; PO Resp. 9. In the earlier IPR, independent claim 2 of the '642 patent was challenged based on anticipation and single-reference obviousness by six different references. Ex. 2007, 372–373. In considering those earlier challenges, the Board found dispositive Patent Owner's argument that none of the six references discloses "modulating [a] key code onto a carrier signal, thereby generating a key code signal" recited in claim 2. *Id.* at 373.

The shortcomings identified by the Board for each of the six anticipation challenges in the earlier IPR was the petitioner's reliance on an inherency argument, namely that each of the asserted references inherently

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discloses modulating a key code onto a carrier signal by virtue of its disclosure of transmission of key code signals. *Id.* at 373–376. Specifically, the Board rejected conclusory testimony proffered by the petitioner as lacking sufficient support for "broad statements that transmission of codes requires modulation onto a carrier signal." *See id.* at 376. The single-reference obviousness challenges suffered from a related deficiency, namely that the petitioner "appear[ed] to conflate obviousness with inherent anticipation and fail[ed] to provide a sufficient obviousness analysis." *Id.* at 376–377.

C. The '325 Patent

1. Overview

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." Ex. 1001, 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.

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Figure 1 of the '352 patent is reproduced below.

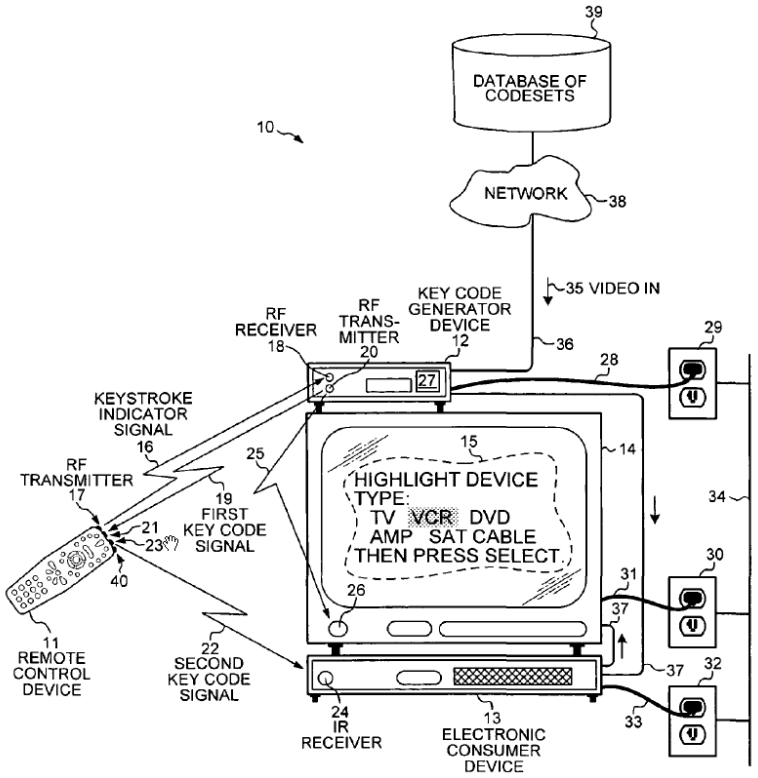

FIG. 1

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

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