Trials@uspto.gov
571-272-7822

Paper 33
Date: 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.

IPR2019-01615
Patent 9,716,853 B2

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

FENICK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

This is a Final Written Decision in an *inter partes* review challenging the patentability of claims 1, 3, 5, and 7 of Patent No. 7,895,532 B2 (Ex. 1001, "the '853 patent"). We have jurisdiction under 35 U.S.C. § 6(b)(4).

Petitioner has the burden of proving unpatentability of a claim by a preponderance of the evidence. 35 U.S.C. § 316(e). Having reviewed the arguments of the parties and the supporting evidence, we find that Petitioner has not demonstrated by a preponderance of the evidence that claims 1, 3, 5, and 7 are unpatentable.

I. INTRODUCTION

A. Background

Roku, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1, 3, 5, and 7 of the '853 patent. Paper 2 ("Pet."). Universal Electronics, Inc. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). After we issued an order (Papers 7, 8) that granted authorization for additional briefing addressing the issue of discretionary denial under 35 U.S.C. § 325(d), Petitioner filed a Reply to the Preliminary Response (Paper 9) and Patent Owner filed a Sur-reply to the Reply (Paper 11). We instituted an *inter partes* review. Paper 12 ("Dec.").

During the trial, Patent Owner filed a Response (Paper 20, "PO Resp."), Petitioner filed a Reply (Paper 24, "Reply"), and Patent Owner filed a Sur-reply (Paper 25, "Sur-reply"). An oral hearing was held with the parties on January 25, 2021, and a copy of the transcript was entered into the record. Paper 32 ("Tr.").

B. Related Matters and Real Parties in Interest

Petitioner and Patent Owner each state that the '853 patent is involved in *Universal Electronics Inc. v. Roku, Inc.*, Case 8-18-cv-01580, in the Central District of California. Pet. 72; Paper 3 (Patent Owner's Mandatory Notices), 2. Patent Owner additionally identifies as related eight other *inter partes* review petitions filed by Petitioner requesting review of other patents owned by Patent Owner. Paper 3, 2.

Petitioner identifies only itself as the real party in interest. Pet. 72. Patent Owner also identifies only itself as the real party in interest. Paper 3, 2.

C. Overview of the '853 Patent

The '853 patent relates to a device that receives "a request from a controlling device, such as a remote control, smart phone, or the like" to "have one or more target devices perform one or more functional operations." Ex. 1001, code (57). The device "responds to the request by applying the optimum methodology to propagate one or more commands" to the target device(s) to perform the functional operation(s). *Id.*

Figure 1 of the '853 patent, reproduced below, illustrates an exemplary system in which a universal control engine (UCE) according to the invention is used to issue commands to control various controllable appliances. *Id.* at 3:39–41.

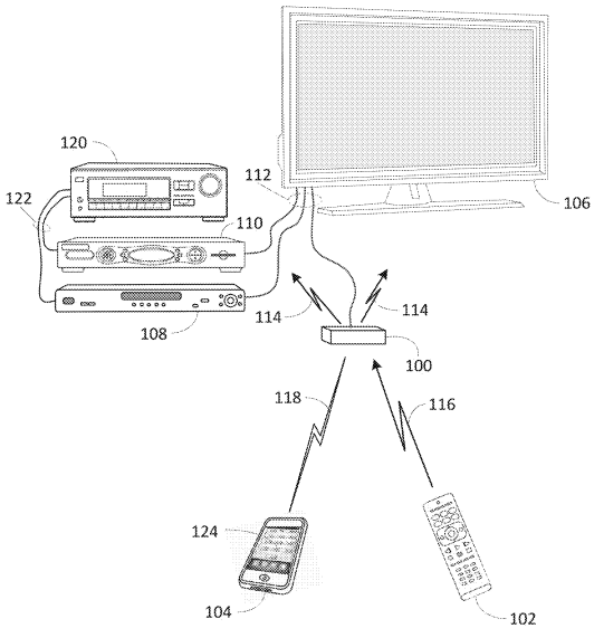

Figure 1

In Figure 1, controllable appliances include television 106, cable set top box combined with digital video recorder 110, DVD player 108, and AV receiver 120. *Id.* at 3:41–44. Appliance commands are issued by UCE 100 in response to infrared ("IR") request signals 116 received from remote control device 102 or radio frequency ("RF") request signals 118 received from app 124 resident on smart device 104. *Id.* at 3:52–56. Transmission of commands from UCE 100 to the controllable appliances may take the form of wireless IR signals 114 or Consumer Electronic Control ("CEC") commands issued over wired HDMI interface 112 if available. *Id.* at 2:38–45, 3:58–4:4.

The '853 patent describes that the method, protocol, or medium for issuing commands to controllable appliances may vary by appliance and/or by function to be performed. *Id.* at 6:62–64, 7:5–7. "[I]n some instances a particular appliance may support receipt of an operational command via more than one path," such as via a CEC command or via an IR command. *Id.* at 7:8–12. A UCE may use a matrix including data cells, each corresponding to a specific command and a specific appliance, with the data content of the cell including "identification of a form of command/transmission to be used and a pointer to the required data value and formatting information for the specific command." *Id.* at 7:26–29, Fig. 7. Matrix 700 may contain a null entry if "a particular function is not available on or not supported by a specific appliance." *Id.* at 7:46–49. "In certain embodiments one or more secondary command matrices . . . may also be provisioned, allowing for the use of alternate command methods in the event it is determined by the UCE programming that a preferred command was unsuccessful." *Id.* at 7:42–46.

Figure 13 of the '853 patent, reproduced below, illustrates an exemplary series of steps performed by a UCE in issuing a function command to an appliance. *Id.* at 3:29–31, 11:40–47.

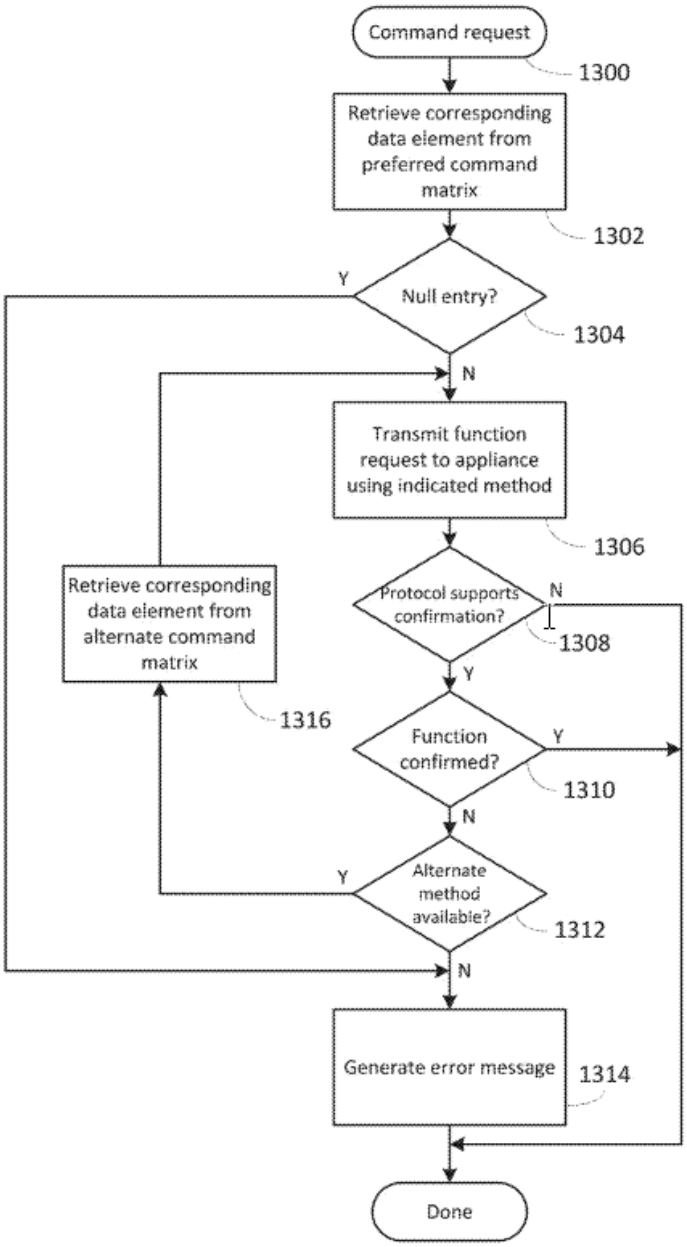

Figure 13

As shown in Figure 13, a command request is received (1300) and a corresponding data element, if one exists, is retrieved from a preferred

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