

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

Case IPR2019-01615
U.S. Patent No. 9,716,853 B2

PETITIONER ROKU, INC.'S REQUEST FOR REHEARING

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 1. Claim 1 does not *require* consulting the created listing to determine which communication method to use.5

 2. Even under the Board’s implicitly narrow construction, Chardon discloses consulting the listing to determine which communication method to use.10

 B. The Board erred in implicitly and narrowly construing the term “communication method.”13

INTRODUCTION

The Board erred by implicitly construing too narrowly key limitations of independent claim 1 that neither party advocated for. First, claim 1 does not require consulting the created listing to determine which communication method to use. Second, the term “communication method” is not limited to a command transmission medium, but instead also includes the command protocols to be used. Under a correct claim interpretation, Chardon renders the claims obvious. And, even under the Board’s narrow claim interpretation, it overlooked portions of Chardon that meet the claim limitations and render the claims obvious.

ARGUMENT

I. Standard for Rehearing

“A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board.” 37 C.F.R. § 42.71(d). “The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

II. Background

Claim 1 of the challenged ’853 patent is a system claim directed to a universal control engine (“UCE”) responsible for controlling devices in, for example, a home theater system. The UCE’s memory has executable instructions

that cause it to detect a target appliance. It then uses the target appliance's identity to "create a listing comprised of at least a first [and second] *communication method*." The two "communications methods" are different and are, broadly, "for use in controlling" a first and second "functional operation of the intended target appliance." Exemplary functional operations may be, for example, a "power on" command or a "volume up" command.

The executable instructions on the UCE respond to a received request from a "controlling device," like a hand-held remote control, "by *causing a one of the first and second communication methods* [in the listing] that has been associated with the requested one of the first and second functional operations *to be used to transmit* to the intended target appliance *a command*." The claim does not specify how the UCE chooses which communication method to use—it simply "causes" one of them "to be used to transmit" a command to the target appliance.

Chardon is the primary reference in this IPR. Like the '853 patent, it describes a universal control engine for controlling appliances in a home theater environment. Chardon's UCE (its "multi-media gateway") uses a target appliance's Extended Display Identification Data ("EDID") to generate a linked database of command codes for potential use by that target appliance. The database includes Consumer Electronic Control ("CEC") command codes – i.e., a set of CEC-specific command codes that are used where the controlling device

determines that the CEC protocol is appropriate and that the commands will thus be sent over a wired HDMI bus. Pet. at 20-21. The database also has a set of infra red (“IR”) command codes – i.e., a set of IR-specific command codes that are used where the controlling device determines that IR protocols are appropriate and that the commands will thus be sent wirelessly using infra red communications. *Id.*

This description of Chardon comports with the Board’s own description in its Final Written Decision. *See e.g.*, FWD at 21 (“Chardon describes that its remote database 135 stores sets of command codes, that these may include both ‘a set of CEC command codes’ and ‘a set of IR command codes,’ and that these may be linked to a device ID.”); *see also* FWD at 12-13.

Chardon’s controlling device also includes the physical hardware for sending both IR and CEC communications. It has an IR transceiver for sending IR command codes. Pet. at 20, *citing* EX1005, ¶40; Pet. at 57. And it has a CEC bus or communication port over which CEC command codes may be communicated to HDMI appliances. *Id.* Again, this description of Chardon comports with the Board’s own description in its Final Written decision. FWD at 12 (“[Chardon’s] remote control also may include an IR transceiver, an RF transceiver, and a bus that includes a CEC bus or communication port over which CEC command codes may be communicated to HDMI appliances.”).

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