

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2020-00951
Patent 9,911,325 B2

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

CHUNG, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314
Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Roku, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 6, 8, 9, and 11–16 of U.S. Patent No. 9,911,325 B2 (Ex. 1001, “the ’325 patent”). The Petition involves the same parties and the same patent at issue in an instituted trial proceeding in IPR2019-01614 (“the related IPR”). Concurrent with its Petition, Petitioner also filed a Motion for Joinder, seeking to join this proceeding with IPR2019-01614. Paper 3 (“Mot.”). Universal Electronics, Inc. (“Patent Owner”) filed both a Preliminary Response and an Opposition to Petitioner’s Joinder Motion. Papers 11 (“Prelim. Resp.”), 7 (“Opp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Opposition. Paper 10 (“Reply”).

For the reasons set forth below, we deny both the Petition and the Motion for Joinder.

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. 78. Patent Owner identifies the same case as a related matter. Paper 6, 1.

The parties additionally identify the following proceedings as involving the ’325 patent: (1) *Universal Electronics, Inc. v. Funai Electric Co.*, No. 8:20-cv-0700 (C.D. Cal.); (2) *Universal Electronics, Inc. v. TCL Electronics Holdings Ltd.*, No. 8:20-cv-0704 (C.D. Cal.); (3) *Universal Electronics, Inc. v. TCL Electronics Holdings Ltd.*, No. 8:20-cv-3328 (C.D.

Cal.); (4) *Universal Electronics, Inc. v. Hisense Co.*, No. 8:20-cv-0696 (C.D. Cal.); and (5) *Certain Electronic Devices, Including Streaming Players, Televisions, Set Top Boxes, Remote Controllers, and Components Thereof*, Inv. No. 337-3450 (ITC). Pet. 78–79; Paper 6, 1. Patent Owner also identifies the following case as a related matter: *Universal Electronics Inc. v. Roku, Inc.*, No. 8:20-cv-0701 (C.D. Cal.). Paper 6, 1.

The '325 patent is also the subject of a co-pending petition for *inter partes* review filed by Petitioner in IPR2020-00953, where Petitioner also seeks joinder with IPR2019-01614. Pet. 79.

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, IPR2019-01621, IPR2020-00952, IPR2020-00953, and IPR2020-01012. See Paper 6, 1–2.

B. Real Parties In Interest

The parties identify only themselves as real parties in interest. Pet. 78; Paper 6, 1.

C. 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.

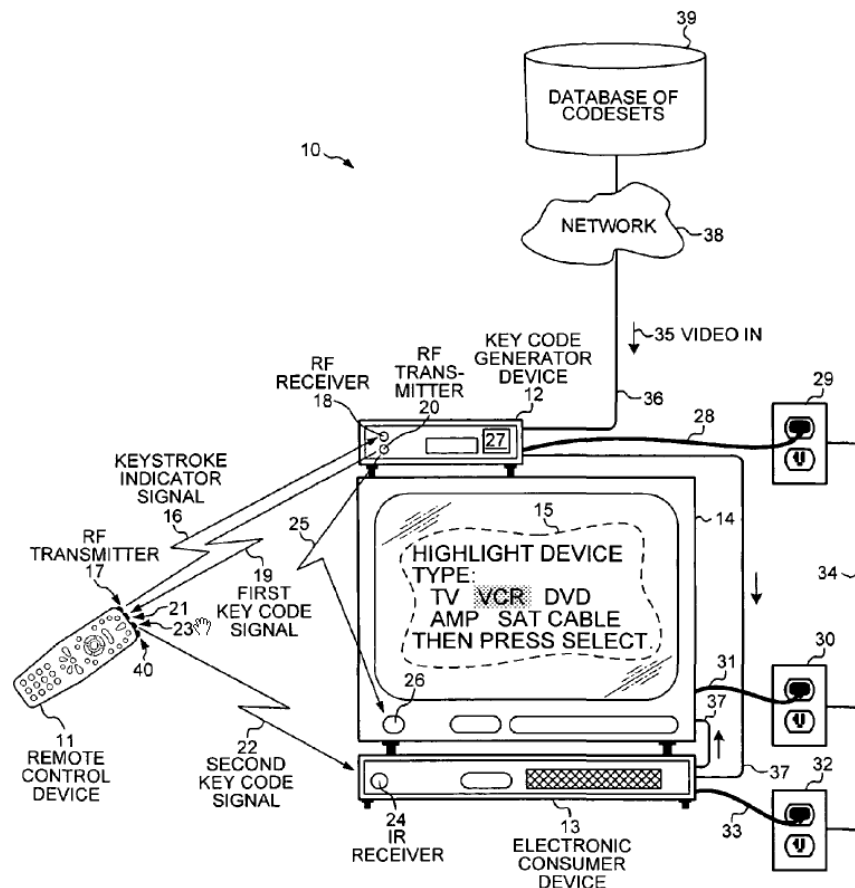


FIG. 1

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

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