

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2020-00952
Patent 9,716,853 B2

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

FENICK, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314(a)

Denying Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Roku, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 6, and 8 (“the challenged claims”) of U.S. Patent No. 9,716,853 B2 (Ex. 1001, “the ’853 patent”). Paper 1 (“Pet.”). The Petition involves the same parties and the same patent at issue in an

instituted trial proceeding in IPR2019-01615 (“the related IPR”). Concurrent with its Petition, Petitioner also filed a Motion for Joinder with IPR2019-01615. Paper 2 (“Mot.”). Universal Electronics, Inc. (“Patent Owner”) filed both a Preliminary Response and an Opposition to Petitioner’s Joinder Motion. Papers 10 (“Prelim. Resp.”), 6 (“Opp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Opposition. Paper 9 (“Reply”).

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

II. BACKGROUND

A. 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.

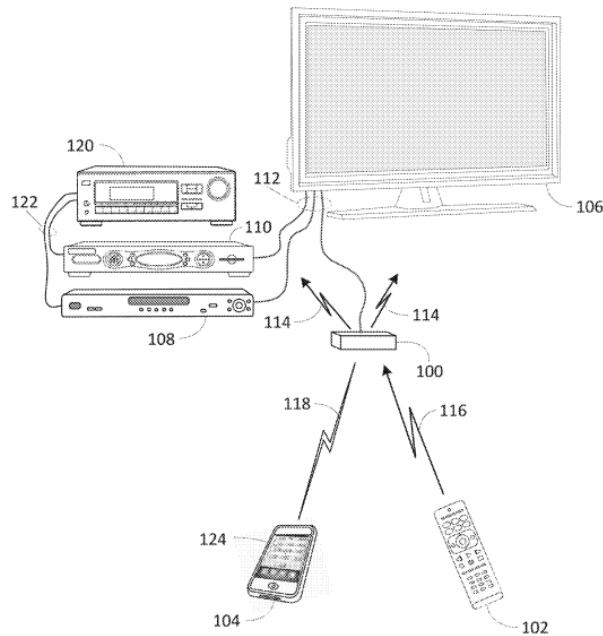


Figure 1

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 7:10–12. 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. The 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.

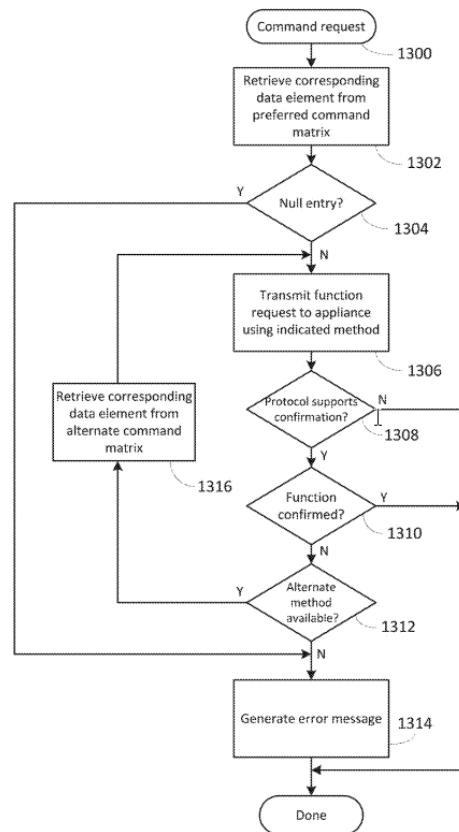


Figure 13

As shown in Figure 13, a command request is received (1300) and a corresponding data element, if one exists, is retrieved from a preferred command matrix and transmitted to the appliance (1302, 1304, 1306). *Id.* at 11:40–57, 12:4–10. In certain cases, when a determination that the communication interface and protocol used provides for a confirmation of successful transmission, if that confirmation is not received (1308, 1310) then if an alternate method of issuing the command is available, the data element from an alternate command matrix is retrieved and transmitted (1312, 1316, 1306). *Id.* at 12:10–16, 12:21–35.

B. Challenged Claims

Of the challenged claims, claim 1 is the sole independent claim. Challenged claims 2 and 8 depend from claim 1, and challenged claim 6

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