

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2020-01012
Patent 7,589,642 B1

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

BOUCHER, *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

Roku, Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1, 2, 5–7, 19, and 20 of U.S. Patent No. 7,589,642 (Ex. 1001, “the ’642 patent”). Paper 1 (“Pet.”).

The Petition involves the same parties and the same patent at issue in an instituted trial proceeding in IPR2019-01612 (“the related IPR”).

Concurrent with its Petition, Petitioner also filed a Motion for Joinder with IPR2019-01612. Paper 2 (“Mot.”). Universal Electronics, Inc. (“Patent Owner”) filed both a Preliminary Response and an Opposition to Petitioner’s Joinder Motion. Papers 8 (“Prelim. Resp.”), 6 (“Opp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Opposition. Paper 7 (“Reply”).

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

I. BACKGROUND

A. The ’642 Patent

The ’642 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, 1:6–9. 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 1:25–28. A set of key codes associated with a particular electronic device is referred to as a “codeset.” *Id.* at 1:23–25. 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 1:39–47. Accordingly, the inventor of the ’642 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 1:51–55.

Figure 1 of the ’642 patent is reproduced below.

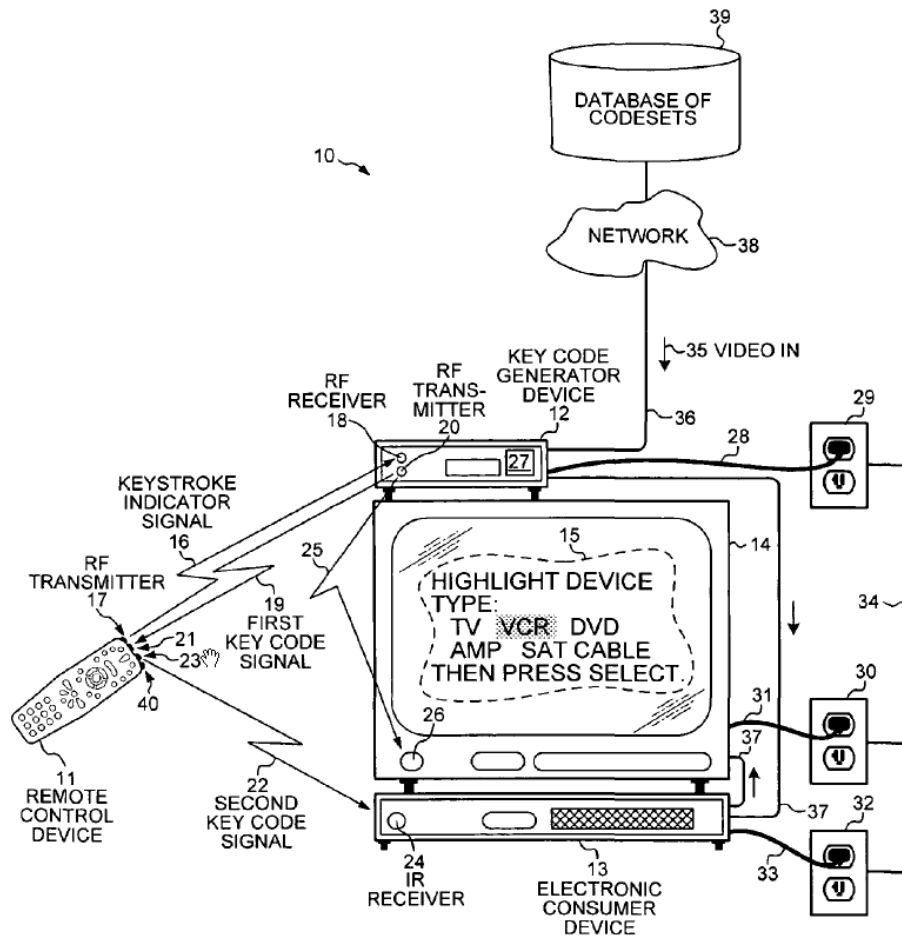


FIG. 1

Figure 1 illustrates a system for relaying a key code through a remote control device to an electronic consumer device. *Id.* at 3:1–3. 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 3:5–8; 3:18–21, 3:27–28. 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 3:12–16, 3:27–33. For example, system 10 may, in this way, identify the appropriate codeset to enable remote control device 11 to communicate with VCR 13 and television set 14. *Id.* at 3:27–35.

An alternative embodiment uses an “autoscan functionality” in which the user is “prompted by successive screens on display 15 to push the power-on key of remote control device 11 multiple times.” *Id.* at 7:60–66. As the user repeatedly presses the power-on key, “key code generator device 12 in turn generates key codes using different codesets until the electronic consumer device performs a desired function,” such as turning on. *Id.* at 8:6–10. The user is prompted to stop pressing the power-on key once the user sees the desired function being performed by first electronic consumer device 13. *Id.* at 8:10–13. “When the user stops pressing the power-on key, then the key code generator device 12 identifies the codeset of the last transmitted key code to be the codeset used by the electronic consumer device.” *Id.* at 8:15–18.

The ’642 patent explains that, in some instances, key code generator device 12 is capable of communicating with remotely maintained database of codesets 39 over network 38, which may be the Internet. *Id.* at 8:32–35. A new codeset, such as may be associated with a new electronic consumer device introduced into the market, may thus be distributed from database 39 via network 38 and stored on a mass-storage hard disk within key code generator device 12. *Id.* at 8:35–43.

After generating a key code, key code generator device 12 modulates the key code onto a carrier signal, such as an RF signal, to generate “first

key code signal 19.” *Id.* at 4:35–37. Figure 5 of the ’642 patent is reproduced below.

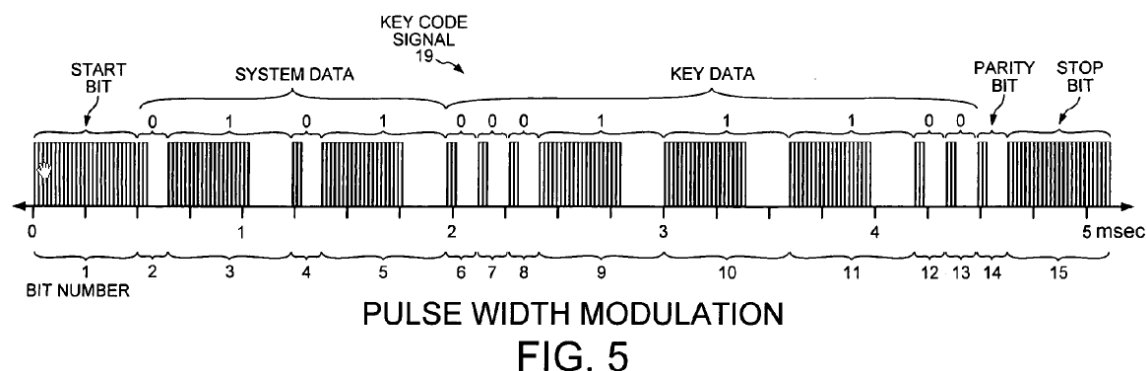


Figure 5 illustrates a twelve-bit key code modulated onto first key code signal 19 using pulse-width modulation. *Id.* at 4:66–67. Remote control device 11 receives first key code signal 19 on an RF transmission from key code generator device 12, and relays the key code to the appropriate electronic consumer device, such as VCR 13, in the form of second key code signal 22. *Id.* at 5:37–44. The electronic consumer device receives second key code signal 22, recovers the key code, and, if the key code is correct for the device, performs the function desired by the user. *Id.* at 5:64–6:1, 8:6–18.

B. Illustrative Claim

Independent claim 1 is illustrative of the challenged claims and is reproduced below.

1. A method comprising:
 - (a) receiving a keystroke indicator signal from a remote control device, wherein the keystroke indicator signal indicates a key on said remote control device that a user has selected;
 - (b) generating a key code within a key code generator device using the keystroke indic[a]tor signal;

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