

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSAL REMOTE CONTROL, INC.,
Petitioner,

v.

UEI CAYMAN, INC., and UNIVERSAL ELECTRONICS, INC.,¹
Patent Owner.

Case IPR2014-01111
Patent 6,407,779 B1

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

¹ Patent Owner represents that the owner of the patent and real party-in-interest is UEI Cayman Inc. and Universal Electronics, Inc. Paper 4. Patent Owner should update Office assignment records to be consistent with its representations made in Paper 4 of this proceeding.

Petitioner Universal Remote Control, Inc. filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 7, 8, 11, and 12 of U.S. Patent No. 6,407,779 B1 (Ex. 1001, the “’779 patent”). Patent Owner UEI Cayman Inc. and Universal Electronics, Inc. filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a). We conclude that Petitioner has failed to show a reasonable likelihood of prevailing in challenging these claims and we decline to institute *inter partes* review.

I. BACKGROUND

A. The ’779 patent (Ex. 1001)

The ’779 patent, titled *Method and Apparatus for an Intuitive Universal Remote Control System*, relates to remote control systems for televisions and other audio-visual systems. Ex. 1001, 1:6–10. The invention features bi-directional communication between a remote control device and a television set (or other audio-visual device). *Id.* at 5:34–53.

For example, the Specification teaches that the television set can forward Electronic Programming Guide (EPG) data to the remote control. *Id.* at 5:54–59. The Specification also teaches that the remote control can store EPG data and other information received from the television set. *Id.* at 5:59–65; 13:39–52.

In contrast to unidirectional remote control devices, the bi-directional remote control device of the ’779 patent can send and receive control level information to and from the television set. *Id.* at 13:26–61. Such control information includes volume control, brightness and sharpness of the TV picture, and balance control of an audio system. *Id.* at 13:56–60.

B. Illustrative Claim

Petitioner challenges claims 7, 8, 11, and 12. Claim 11, reproduced below, is an independent claim:

11. A method for a remote control to communicate with an audio/video device, said remote control comprising a user interface, and said audio/video device comprising a plurality of controlling components, wherein each of the controlling components is set at a controlling level, comprising:

- selecting one of the controlling components of the audio/video device;
- transmitting the corresponding controlling level of the selected controlling component from the audio/video device to the remote control;
- storing the selected controlling level in a memory of the remote control;
- displaying the selected controlling level on the user interface;
- adjusting the selected controlling level using the user interface; and
- transmitting the adjusted controlling level to the audio/video device to adjust the corresponding component of the audio/video device.

C. The Asserted Grounds of Unpatentability

Petitioner challenges claims 7, 8, 11, and 12 of the '779 patent as unpatentable under 35 U.S.C. § 103 over U.S. Patent 5,956,025 to Goulden, *et al.* (Ex. 1003) and U.S. Patent 5,537,106 to Mitsuhashi (Ex. 1004) as further supported by the Declaration of James T. Geier (Ex. 1005). Petitioner purportedly asserts two grounds of unpatentability over Goulden and Mitsuhashi, one with Goulden as the primary reference and Mitsuhashi

as the secondary reference and the other with the order of references reversed. Where, as here, the relevant factual inquiries underlying an obviousness determination are otherwise clear, characterization of references as primary and secondary is merely a matter of presentation with no legal significance. *In re Mouttet*, 686 F.3d 1322, 1333 (Fed. Cir. 2012). Consequently, we will consider the Petition as presenting a single ground of unpatentability over Goulden and Mitsuhashi.²

D. Claim Interpretation

In an *inter partes* review, “claims are given their broadest reasonable interpretation consistent with the specification.” *See* 37 C.F.R. § 42.100(b); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007). Within this framework, terms generally are given their ordinary and customary meaning, as understood by a person of ordinary skill in the art, in the context of the entire patent disclosure. *Translogic Tech.*, 504 F.3d at 1257.³

1. “Controlling components” and “Controlling level.”

Petitioner’s proposed construction: controlling level refers broadly to any control parameter which can take on ordered values.

Pet. 10.

Patent Owner’s proposed construction:

“controlling components” means adjustable parameters.

“controlling level” means a level within a continuous range at which the audio/video device is performing.

Prelim. Resp. 3.

² In reaching our decision, we have considered all of the evidence and all of the arguments presented by the Petitioner in both of the asserted grounds.

³ Citing *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

A claim construction analysis begins with, and is centered on, the claim language itself. *See Interactive Gift Express, Inc. v. Compuserve, Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001). In each of the challenged claims, a “controlling component” is set at a “controlling level.” Ex. 1001, claims 7 and 11. In the preamble of claims 7 and 11, an audio/video device is comprised of a plurality of controlling components. *Id.* Thus, the context of the claim language indicates that a component is a constituent element of the audio/video device.

In the Specification, “components” transmit “parameters” to the remote control. Ex. 1001, 14:31. From the context, the component does the transmitting and the parameter represents the informational content that is transmitted by the component. Thus, the Specification draws a distinction between a component and a parameter, rather than using the two terms interchangeably as proposed by Patent Owner. We decline to adopt Patent Owner’s proposed construction that controlling components means adjustable parameters. We construe “controlling component” as a constituent element of the claimed audio/video device that controls the level of an output or performance parameter of the audio/video device.

With respect to the term “controlling level,” Patent Owner argues that Petitioner’s proposed construction is too broad. Prelim. Resp. 4. Patent Owner also argues that the phrase “ordered values” in Petitioner’s proposed construction is ambiguous. *Id.* at 5. We agree that “ordered values” confuses rather than clarifies the meaning of the claim language and we decline to adopt Petitioner’s proposed construction.

On the other hand, Patent Owner’s proposed construction also is unclear. The phrase “continuous range” in Patent Owner’s proposed

construction is ambiguous. For example, if the volume control of a television set can be set at only one of a plurality of discrete values spaced 2 decibels apart, would such a system entail a “continuous range” in accordance with Patent Owner’s construction? We understand, however, that Patent Owner proposes a construction of controlling level that would exclude, for example, binary-type controlling states.

The term “controlling level” is not defined in the Specification. Outside of the claims, the word “level” is used in the Specification only in the context of setting the volume level. A somewhat similar expression is used in connection with adjusting the size of the PIP screen by resizing the PIP window using standard window management techniques. Ex. 1001, 11:44–54. On the present record and for the purpose of the present Decision, it is sufficient that we treat “controlling level” as relating to setting the value of a performance parameter of a controlling component that is adjustable within a range of values. Based on the record before us, and the Specification of the ’779 patent describing adjusting volume levels and PIP size, “controlling level” excludes binary, on-off switches and other, similar audio/video system controls that can be set to only one of two possible settings or values.

2. *“Transmitting” to/from the remote control device.*

Petitioner proposes constructions for the claim terms directed to transmitting to and from the remote control device. Pet. 10–11. Patent Owner argues that these phrases do not require construction. Prelim. Resp. 8. To the extent there is disagreement between the parties on this issue, resolution of this dispute is not material to our Decision. We agree

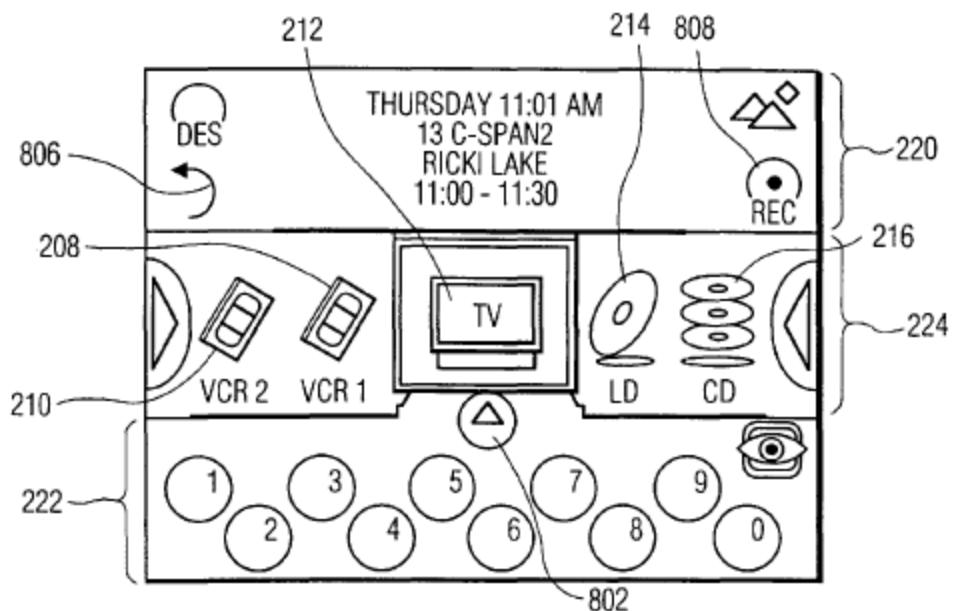
with Patent Owner that express construction of these terms is not necessary for purposes of this Decision.

II. ANALYSIS

A. Obviousness of Claims 7 and 8 over Goulden and Mitsuhashi

1. Goulden (Ex. 1003).

Goulden discloses a remote control device for a home entertainment system that features a graphic user interface with touch screen functionality. Ex. 1003, Abstract. Goulden's invention is directed to an ergonomic design of the graphic user interface that facilitates ease of use for the end user. *Id.* at 2:12–18. Figure 3 of Goulden is shown below.



220: BAND WITH GRAPHICAL REPRESENTATIONS OF BASIC INFORMATION PANELS;
222: BAND WITH GRAPHICAL REPRESENTATIONS OF BASIC CONTROLS;
224: RACK WITH LINEAR ORGANIZATION OF GRAPHICAL REPRESENTATIONS OF SELECTABLE ITEMS IN LAYER 202;
802: ARROW ICON FOR ACTIVATING PANEL 252 IN FIG. 2;
806: RETURN SOFT-KEY FOR RETURNING TO HOME LEVEL.

FIG. 3

Figure 3 is a depiction of the graphical user interface screen of Goulden. Approximately the upper one-third of the screen is devoted to band 220 which contains basic information. Ex. 1003, 4:7–15. The lower

one-third of the screen is devoted to band 222 with graphical representations of basic controls. *Id.* The middle one-third of the screen is devoted to band 224 which contains a linear organization of graphical representations of selectable items in layer 202. *Id.*

Figure 2 of Goulden and the accompanying specification disclosure teaches that the graphical user interface is organized into a hierarchical series of layers. Ex. 1003, Fig. 2, 3:25–4:65. Each of the layers comprises icons for selectable sub-systems of the audio/video system associated with the remote control. *Id.*

2. *Mitsubishi (Ex. 1004).*

Mitsubishi discloses a remote control device for an electronic device, such as a Video Tape Recorder. Ex. 1004, 1:8–11. The remote control can communicate bi-directionally with the Video Tape Recorder main unit. *Id.* at 2:22–23. Communication from the remote control *to* the Video Tape Recorder includes volume control. *Id.* at 11:42–58, Fig. 10G. Communication *from* the Video Tape Recorder to the remote control, as opposed to the opposite direction, is limited to signals representing an operational state such as playback, stop, pause, record, and status information such as record mode and input mode. *Id.* at 4:30–46.

3. *Analysis of Claims 7 and 11.*

Claims 7 and 11 are independent claims that are substantially similar in scope except that claim 11 adds a “storing” limitation. Petitioner argues that the combination of Goulden and Mitsubishi discloses all of the limitations of claims 7 and 11 and that a person of ordinary skill in the art would have been motivated to combine the references to achieve the claimed

invention. Pet. 19–27, 29–37, 39–47, and 49–58. Petitioner supports these arguments with Declaration testimony from James Geier. Ex. 1005, ¶¶ 33–60.

Patent Owner challenges the underlying factual basis beneath Petitioner’s arguments on several points. First, Patent Owner argues that Goulden fails to disclose the step of transmitting a controlling level from the audio/video device to the remote control. Prelim. Resp. 19. Patent Owner asserts that Goulden does not involve bi-directional communication. *Id.* We agree.

Goulden is directed to an ergonomic graphical user interface for a remote control device. Ex. 1003, 2:12–18. Although Goulden’s remote control device communicates with a television set, we do not discern any disclosure in Goulden that teaches bi-directional as opposed to unidirectional communication. Petitioner’s arguments to the contrary are unpersuasive.

Petitioner relies on testimony from Mr. Geier to establish that Goulden’s remote receives the volume level from the TV when the user has selected adjustment of the volume control on the remote. Pet. 22, *citing* Ex. 1005, ¶¶ 34, 39, and 44. We have reviewed Mr. Geier’s testimony and do not find that it is sufficiently credible to make a threshold showing for institution of a trial. 35 U.S.C. § 314(a) (threshold standard is reasonable likelihood of prevailing). Mr. Geier’s declaration concedes that “[s]imple remotes for consumer electronics are typically unidirectional.” Ex. 1005, ¶ 22. The passage of Goulden that Mr. Geier relies on as disclosing bi-directional communication merely indicates that information displayed on the remote can be made available through an EPG. Ex. 1005, ¶ 34, *citing* Ex. 1003, 4:66–5:13. However, there is no express disclosure in Goulden

that the EPG data is transmitted to the remote control device from the television set. Furthermore, Petitioner provides no persuasive evidence or technical reasoning that would eliminate other possible sources, such as downloading the EPG data from an Internet-capable computer using a wired connection. Similarly, we do not find credible Mr. Geier's testimony that visual feedback of volume control discussed in Goulden is necessarily based on transmission from the television set to the remote control. Ex. 1005, ¶ 34, citing Ex. 1003, 5:14–17. There is no explicit disclosure in Goulden that the feedback info is transmitted from the television and Patent Owner provides a reasonable, alternative explanation as to how the remote control device could display feedback information without engaging in bi-directional communication with the television set. Prelim. Resp. 16–17.

Patent Owner also disputes Petitioner's evidence that Mitsuhashi transmits a controlling level of a controlling component from the audio/video device to the remote control. Prelim. Resp. 20–21. Patent Owner concedes that Mitsuhashi engages in some bi-directional communication between the remote control device and audio/video device. *Id.* at 20. However, Patent Owner disputes that the data transmitted from the audio/video device to the remote control is a “controlling level.” *Id.*

Petitioner relies primarily on a single passage from Mitsuhashi's Specification as disclosing this limitation. Pet. 42–43, *citing* Ex. 1004, Abstract and 4:39–46. The column 4 passage from Mitsuhashi states:

When necessary, signals representing the operational state of the VTR such as playback, stop, pause, record, and so forth; status information, such as record mode, input mode, record time, tape remaining amount, and so forth; and timer information, such as timer reservation, reservation check, current time, and so forth are transmitted from the light

emitting/receiving portion 7 of the VTR main unit 1 to the remote commander with the infrared ray signals.

Ex. 1004, 4:39–47. Petitioner augments the foregoing language with testimony from Mr. Geier that merely states that Mitsubishi “transmits signals representing its setting state to the remote control.” Pet. 43, *citing* Ex. 1005, at ¶ 54.

Based on the record before us and our construction of “controlling level,” we are not persuaded that Mitsubishi’s “setting state” corresponds to the controlling level of a controlling component that is transmitted from the audio/video device to the remote control as required by claims 7 and 11, as “setting state” communication merely involves binary type controls and indications. Ex. 1004, 2:22-31; 4:39-47. Thus, for the reasons discussed above, Petitioner has not made a sufficient showing that either Goulden or Mitsubishi discloses transmission of a controlling level of a controlling component from an audio/video device to a remote control as required by claims 7 and 11.

Under the obviousness statute, a claim is not patentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person of ordinary skill in the art. 35 U.S.C. § 103(a). Thus, the mere fact that neither Goulden nor Mitsubishi explicitly discloses transmission of a controlling level from an audio/video device to a remote control does not end our inquiry because, “we do not ignore the modifications that one skilled in the art would make to a device borrowed from the prior art.” *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed.Cir.2007). However, in this case, the Petition fails to make any persuasive evidentiary presentation that a person of ordinary skill in the

art, starting with Goulden, as a unidirectional remote control, and Mitsuhashi, as a remote that discloses bi-directional communication of setting states, would have had either the ability or the motivation to modify the prior art to achieve the claimed invention.

Accordingly, we find that Petitioner has failed to establish a reasonable likelihood that it would prevail at trial in establishing that claims 7 and 11 are obvious over Goulden and Mitsuhashi.⁴

B. Obviousness of Claims 8 and 12 over Goulden and Mitsuhashi.

Claim 8 depends from claim 7 and claim 12 depends from claim 11. In each instance, these claims contain a dependent limitation directed to a user interface with a touch screen display. Ex. 1001. Petitioner's challenges to these two dependent claims suffer from the same infirmities that we have identified above regarding their respective independent claims.

Accordingly, we find that Petitioner has failed to establish a reasonable likelihood that it would prevail at trial in establishing that claims 8 and 12 are obvious over Goulden and Mitsuhashi.

III. CONCLUSION

We conclude that Petitioner has not shown a reasonable likelihood of prevailing in challenging any claim of the '779 patent.

⁴ We note that Petitioner makes cursory reference to the word "inherently" in two places in the Petition. Pet. 11, 59. We are not persuaded that Petitioner has made out a proper case for unpatentability under the doctrine of inherency.

IV. ORDER

After due consideration of the record before us, it is
ORDERED that the petition is denied and no trial is instituted.

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