Trials@uspto.gov
571-272-7822

Paper 12
Date: March 16, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2019-01608
Patent 7,895,532 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

I. INTRODUCTION

Roku, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claim 10 ("the challenged claim") of U.S. Patent No. 7,895,532 B2 (Ex. 1001, "the '532 Patent"). Paper 2 ("Pet."). Patent Owner Universal

Electronics, Inc. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). After we issued an order (Papers 8, 9) that granted authorization for additional briefing addressing a claim construction issue, Petitioner filed a Reply to the Preliminary Response (Paper 10 ("Pet. Reply")) and Patent Owner filed a Sur-Reply to the Reply (Paper 11 ("PO Sur-Reply")). We have authority under 35 U.S.C. § 314.

Upon consideration of the Petition, Preliminary Response, and additional briefing, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claim of the '532 Patent. We do not institute *inter partes* review.

II. BACKGROUND

A. *Related Matters and Real Parties in Interest*

Petitioner and Patent Owner each state that the '532 Patent is involved in *Universal Electronics Inc. v. Roku, Inc.*, Case 8-18-cv-01580, in the Central District of California. Pet. 1; Paper 4 (Patent Owner's Mandatory Notices) 2. Patent Owner additionally identifies as related eight other *inter partes* review petitions filed by Petitioner requesting review of other patents owned by Patent Owner. Paper 4, 2.

Petitioner identifies only itself as the real party in interest. Pet. 1. Patent Owner also identifies only itself as the real party in interest. Paper 4, 2.

B. *Overview of the '532 Patent*

The '532 Patent relates to "[a] hand-held electronic device having a remote control application user interface." Ex. 1001, code (57). The device acts as a universal remote control application, consolidating the functionality of multiple remote controls for various consumer appliances. *Id.* at 1:14–22,

3:9–13. The device replaces the multiple remote controls by providing wireless control signals to emulate those sent by standard remote controls to the consumer appliances. *Id.* at 3:13–16.

The '532 Patent details a setup wizard that allows quick setup of the device to control a user's appliances. *Id.* at 4:59–5:43, 14:56–15:53. User and room profiles may also be set up in order to provide functionality based on which user is operating the remote control application or on the location of the device. *Id.* at 15:54–17:35.

"The remote control application may also provide for the automatic or semi-automatic configuration of macros (preprogrammed sequences of command actions which may be played back by pressing a single key) for common activities." *Id.* at 17:38–41. "Macros provide a way for the user to perform a combination of tasks quickly." *Id.* at 23:66–67. Two types of macros are described in the '532 patent: system-generated macros, which "are generated automatically or semi-automatically" and user-generated macros, which are manually programmed. *Id.* at 23:67–24:10.

Two examples of system-generated macros are included. In the first, an "all on" or "power" macro, several devices are powered on or powered off with the macro, for example, for turning all devices in a home theater system on or off. *Id.* at 11:54–67, 17:42–44. "To facilitate creation of this type of exemplary macro, the remote control application may, as part of a setup wizard, display to the user a list of all currently configured devices accompanied by 'checkboxes' in which the user may indicate which of these are to participate in an 'all on' macro." *Id.* at 17:44–49 (element number elided), 11:54–67, Fig. 16g. The second example of system-generated macros concerns entry of input routing information indicating how the

controlled appliances are connected to each other by their input and outputs, to allow controls to be selected or set in order and thereby allow use of the appliances together. *Id.* at 17:53–67. This information may be provided by a user answering questions about the existing routing between the appliances, or indicating the existing routing using a drag and drop interface provided by the device. *Id.* at 17:54–63.

User-generated macros, on the other hand, are described as being generated when a user "manually program[s] a sequence of actions to be assigned to a single button such that the sequence can be repeated by a press of the single button." *Id.* at 24:7–10. In the example of this generation provided, a user enters an "activity setup wizard" and then "enter[s] a sequence of keystrokes to be stored as a macro." *Id.* at 24:17–26; Figs. 22a–22g. The user may navigate among control pages for all the controlled appliances to switch to control pages for various appliances while entering keystrokes. *Id.* at 24:27–29; 19:63–20:12. "An example of a user generated macro might be a 'Watch DVD Movie' macro, which: 1) turns on the DVD Player; 2) turns the AMP to the DVD input; 3) turns on the TV; 4) sets TV input to 'Video 1;' and 5) plays the Movie." *Id.* at 24:10–13.

C. *Challenged Claim*

The sole challenged claim, claim 10, is reproduced below, with bracketed notations, corresponding to notations in the Petition, added for reference.

> 10. A method for automatically creating a sequence of instructions to be executed by a controlling device, comprising:

[10.1] presenting to a user a graphical user interface including a representations of at least one appliance controllable by the controlling device;

[10.2] using a program to automatically create the sequence of instructions to be executed by the controlling device such that the sequence of instructions reflects one or more interactions by the user with the representations of the at least one appliance controllable by the controlling device presented via the graphical user interface; and

[10.3] causing the automatically created sequence of instructions to be executed by the controlling device in response to a selection of a user input element of the controlling device.

Ex. 1001, 39:42–40:10.

D. *Evidence Relied Upon*

Reference		Date	Exhibit
Wugoski	US 6,690,392 B1	Feb. 10, 2004	1006
Humpleman et al. ("Humpleman")	WO 98/59282	Dec. 30, 1998	1003
Harris et al. ("Harris")	WO 01/69567	Sept. 20, 2001	1008
Walkenbach, J. (1999). *Microsoft Excel 2000 Bible*. Wiley Publishing. ("Walkenbach"), pp. ix–xl, 755–784.		1999	1004

Petitioner also relies upon the Declaration of Nenad Medvidovic, PhD. (Ex. 1011).

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