

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2019-01620
Patent 7,821,505 B2

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

CHUNG, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

In this *inter partes* review (“IPR”), instituted pursuant to 35 U.S.C. § 314, Roku, Inc. (“Petitioner”) challenges the patentability of claims 5–7, 9, 10, 12, 49, and 51 (the “challenged claims”) of U.S. Patent No. 7,821,505 B2 (Ex. 1001, “the ’505 patent”),¹ owned by Universal Electronics, Inc. (“Patent Owner”). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine Petitioner has shown by a preponderance of the evidence that claims 5–7, 9, 10, 12, 49, and 51 of the ’505 patent are unpatentable.

II. BACKGROUND

A. Procedural History

On September 18, 2019, Roku, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of the challenged claims of the ’505 patent. Patent Owner filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

On May 13, 2020, applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we instituted an *inter partes* review of all challenged claims of the ’505 patent based on all grounds presented in the Petition. Paper 12 (“Inst. Dec.”), 45–46.

¹ Claims 49 and 51 were added to the ’505 patent as a result of an *inter partes* reexamination of the ’505 patent. Ex. 1003 (*Inter Partes* Reexamination Certificate No. US 7,821,505 C1), 1:19–20, 3:46–50, 3:54–57.

After institution, Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”), Petitioner filed a Corrected Reply to the Patent Owner Response (Paper 20, “Pet. Reply”), and Patent Owner filed a Corrected Sur-reply (Paper 23, “PO Sur-reply”). An oral hearing was held on February 4, 2021, and a copy of the hearing transcript has been entered into the record. Paper 38 (“Tr.”). After the hearing, with the Board authorization (Paper 34), the parties filed supplemental briefing to address alleged improper new arguments and evidence included in Petitioner’s Reply. Papers 36, 37.

B. Related Matters

According to Petitioner, the ’505 patent has been asserted in the following patent infringement cases: *Universal Electronics, Inc. v. Logitech Inc.*, 8-11-cv-01056 (C.D. Cal. 2011) (terminated); *Universal Electronics, Inc. v. Peel Technologies, Inc.*, 8-13-cv-01484 (C.D. Cal. 2013) (terminated); and *Universal Electronics, Inc. v. Roku, Inc.*, 8:18-cv-01580 (C.D. Cal. 2018) (pending) (“the related litigation”). Pet. 1–2. Patent Owner identifies the same cases as related matters. Paper 3, 2.

The ’505 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, IPR2019-01614, IPR2019-01615, IPR2019-01619, and IPR2019-01621. *See id.* The parties also note that the ’505 patent has been the subject of *Inter Partes* Reexamination No. 95/001,761 (“the ’505 Patent Reexamination Proceeding” or “the ’505 Patent Reexamination”) (Pet. 2; Paper 3, 3), which confirmed the patentability of claims 1–12 (Ex. 1003, 1:17).

C. The '505 Patent

The '505 patent, titled “CONTROLLING DEVICE WITH DUAL-MODE, TOUCH-SENSITIVE DISPLAY,” issued October 26, 2010, from U.S. Patent Application No. 12/797,695, filed June 10, 2010 (“the '695 application”). Ex. 1001, codes (21), (22), (45), (54). The '695 application is a continuation of U.S. Patent Application 12/103,895, filed on April 16, 2008 (issued as U.S. Patent No. 7,782,309 (“the '309 patent”)), which is a continuation of U.S. Patent Application No. 11/290,358, filed on November 30, 2005 (issued as U.S. Patent No. 7,432,916). *Id.* at code (63). The '505 patent also claims the benefit of U.S. Provisional Patent Application No. 60/634,680, filed on December 9, 2004. *Id.* at code (60).

The '505 patent describes a universal controlling device having a dual-mode, touch-sensitive display. *Id.* at 1:16–18, 2:12–15.

Figure 2 of the '505 patent is reproduced below.

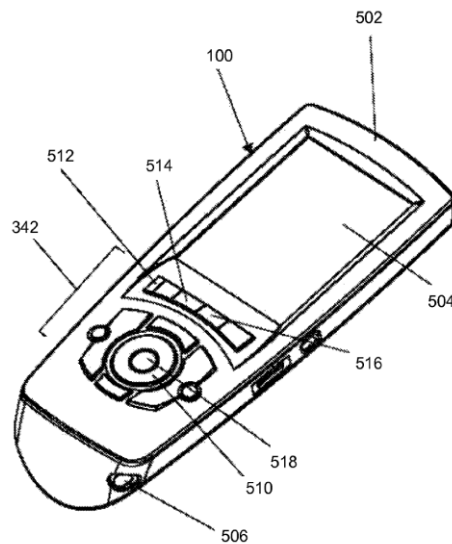


FIGURE 2

Figure 2 depicts an exemplary universal controlling device of the '505 patent. *Id.* at 2:39–41.

As shown in Figure 2, universal controlling device 100 comprises dual-mode touch-sensitive display 504 and hard keys (or mechanical buttons) 342. *Id.* at 4:41–47, 4:57–60. In an embodiment, mechanical buttons 324 include pointer mode activation button 512, which is used to toggle universal controlling device 100 between a first operational mode and a second operational mode, also called the pointer control mode. *Id.* at 5:38–42. According to the '505 patent, in the first operational mode, universal controlling device 100 is used to command conventional operational functions of home appliances. *Id.* at 5:17–19. In the second operational mode, universal controlling device 100 accepts input from a user to “control[] a cursor or pointer on a larger, second device, such as a personal computer, television, or the like.” *Id.* at 2:54–58.

Figure 3 of the '505 patent is reproduced below.

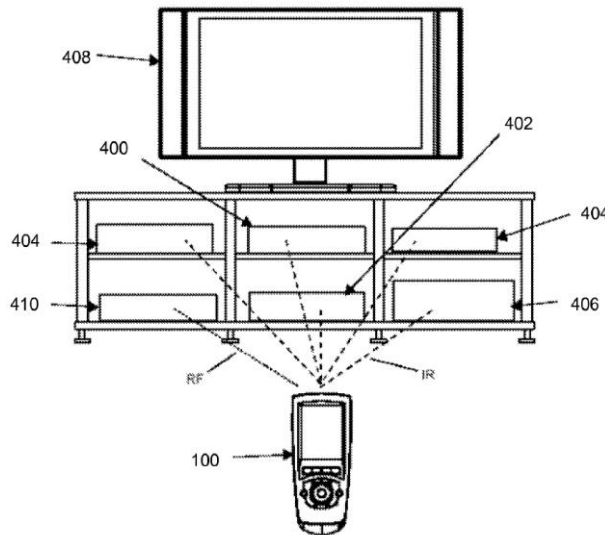


FIGURE 3

Figure 3 illustrates an exemplary system environment in which the exemplary universal controlling device of Figure 2 may be utilized. *Id.* at 2:42–44.

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