

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSAL ELECTRONICS, INC.,
GEMSTAR TECHNOLOGY (QINZHOU) CO. LTD.,
GEMSTAR TECHNOLOGY (YANGZHOU) CO. LTD.,
C.G. DEVELOPMENT LTD., UNIVERSAL ELECTRONICS BV,
UEI BRASIL CONTROLES REMOTOS LTDA., and
CG MÉXICO REMOTE CONTROLS, S. de R.L. de C.V.,
Petitioner,

v.

ROKU, INC.,
Patent Owner.

IPR2022-00818
Patent 8,378,875 B2

Before PATRICK M. BOUCHER, SHARON FENICK, and
RUSSELL E. CASS, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Universal Electronics Inc., Gemstar Technology (Qinzhou) Co. Ltd., Gemstar Technology (Yangzhou) Co. Ltd., C.G. Development Ltd., Universal Electronics BV, UEI Brasil Controles Remotos Ltda., and CG México Remote Controls, S. de R.L. de C.V. (collectively “Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–5, 8–11, and 14 of U.S. Patent No. 8,378,875 B2 (Ex. 1001, “the ’875 patent”). Paper 2, (“Pet.”). Roku, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply, Paper 9 (“Reply”), and Patent Owner filed a Sur-reply, Paper 10 (“Sur-reply”).

We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. 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 grant the Petition and institute an *inter partes* review. The Board has not made a final determination regarding the patentability of any claim.

I. BACKGROUND

A. The ’875 Patent

The ’875 patent “relates to a method of programming [a universal remote control], e.g., by using brand- and code-set identifiers.” Ex. 1001, 1:7–10. In summarizing the related art, the ’875 patent identifies three of “[t]he most popular ways” that were known for configuring a universal remote control to work with consumer electronics equipment. *Id.* at 1:12–23. First, “[e]nter[ing] a code-set from the manual.” *Id.* at 1:24–39. With this technique, a user enters a programming mode by pressing some

key combination on the universal remote control and enters a codeset identifier found in a manual for the user's device brand and type. *Id.* at 1:26–34. If that codeset does not work satisfactorily, the user can try another codeset found in the manual for that device brand and type. *Id.* at 1:34–39.

Second, “[a]uto-scan.” *Id.* at 1:50–65. After entering a different key combination, the user optionally selects the device type to search for (such as by pressing the “TV” or “DVD” button on the universal remote control), and then presses a key that initiates an auto-scan. *Id.* at 1:53–56. The universal remote control then iterates through all codesets for the selected device until the target consumer electronics device reacts. *Id.* at 1:57–60. The user then presses or releases a button to accept the codeset. *Id.* at 1:60–63.

Third, “[b]rand-search.” *Id.* at 2:6–13. This technique is similar to auto-scan, but limited to certain brands of consumer electronics devices. *Id.* at 2:12–13. After the user presses a certain key to begin the procedure, the user enters a brand identifier, rather than entering a codeset identifier as in the manual process. *Id.* at 2:7–9. The user then presses the device button on the universal remote control, e.g. “TV, DVD, Sat, [or] AMP,” which initiates an auto-scan only for the codesets for the identified brand. *Id.* at 2:10–13.

According to the '875 patent, there were disadvantages with each of these prior-art techniques, including the tediousness of manual lookups and the length of time to complete an auto-scan. *Id.* at 1:40–49, 1:66–2:3, 2:15–30. “The main improvement” described by the '875 patent to avoid such disadvantages “is to combine the ‘Brand-id’ (as used in the Brand-search

method) with the ‘Code-set-id’ (as used in the ‘manual code-set-id selection’ method).” *Id.* at 2:66–3:1.

Figure 5 of the ’875 patent is reproduced below.

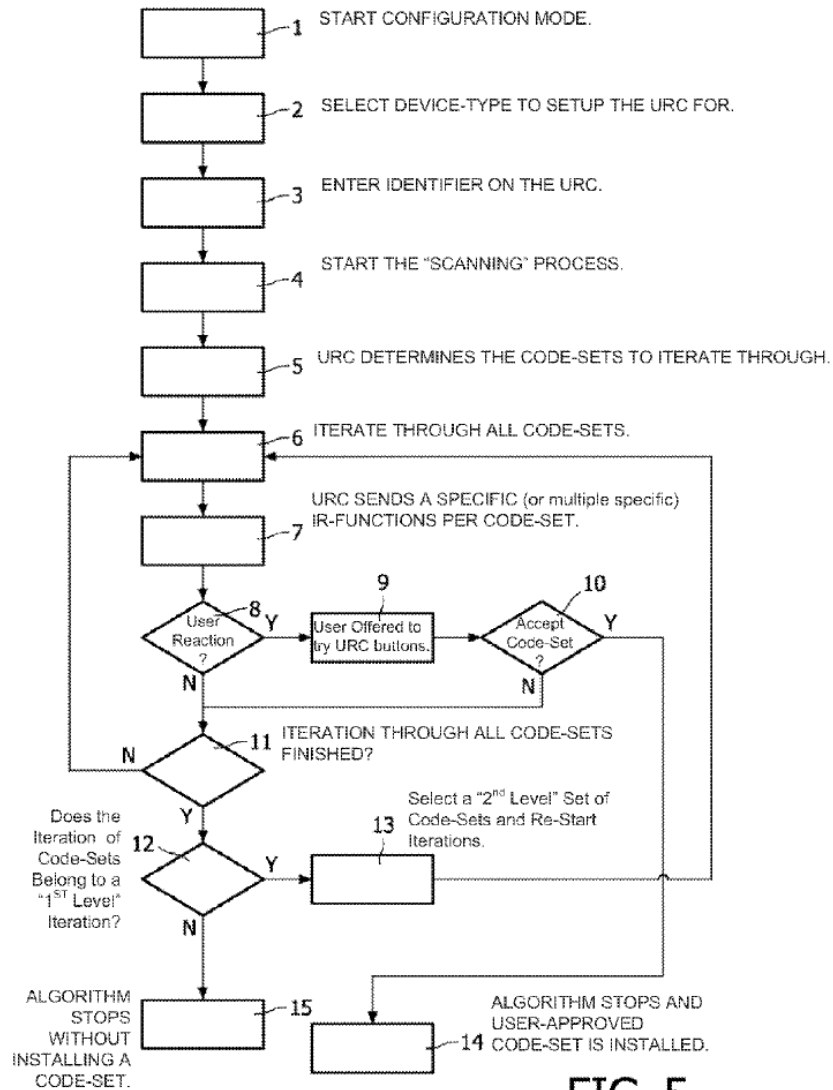


FIG. 5

Figure 5 is a flow diagram for a method of configuring a universal remote control as described by the ’875 patent. *Id.* at 5:21–22. After entering a configuration mode at step 1 by pressing a setup key or pressing certain multiple keys simultaneously, the user selects the device type for the equipment to be set up, such as “TV, VCR, DVD, Sat, Amp, ...” *Id.* at

6:7–15. The user looks up the brand-id or the single codeset-id in the instructions for use of the universal remote control at step 3. *Id.* at 6:21–23. “[T]o the user all these appear to be ‘Brand-ids’” because “the brand-ids . . . are actually a pointer to a list of code-set-ids for a certain brand/device-type combination” while other identifiers “are actually code-set-ids.” *Id.* at 6:23–24, 5:34–38.

After the user starts the scanning process at step 4 by pressing a button on the universal remote control, the universal remote control determines which codesets to iterate through at step 5. *Id.* at 6:28–32. If the identifier entered by the user was a pointer to a set of codesets, the software iterates through all of those codesets at step 6; or if the identifier was a specific codeset only, the method proceeds with only that single codeset. *Id.* at 6:32–35. “During the iteration, the universal remote control sends specific (or multiple specific) IR-functions per code-set” at step 7. *Id.* at 6:35–37. If there is a user reaction, as checked at step 8, the user is offered to try the buttons of the universal remote control at step 9, such that steps 7–9 “together form the step of testing said remote control code-sets.” *Id.* at 6:37–38, 6:46–49. If the user indicates at step 10 that the current codeset is accepted, that codeset is installed at step 14. *Id.* at 6:50–52. If there is no user reaction, or if the user does not accept the codeset at step 10, the scanning process continues by going to step 11 until all codesets have been tried. *Id.* at 6:40–41, 6:52–54. The remaining portions of the flow diagram may perform a further iteration with a “second-level” set of codesets if no codeset was found. *Id.* at 6:55–67.

The ’875 patent notes that, “[o]ften, the scanning process will find multiple code-sets that trigger a reaction on the [consumer electronics]

equipment.” *Id.* at 7:38–39. This is a result of overlap between multiple codesets, with the patent providing an example of “for code-set X the Power, digits and Teletext works ok, but volume does not, while for code-set Y the Power, digits and volume work but Teletext does not.” *Id.* at 7:39–43. Accordingly, it is “very practical” for a user to indicate, for a given codeset, which codes work and which do not. *Id.* at 7:43–45. This allows the universal remote control to “combine the working codes of multiple code-sets into a new ‘custom configuration’ code set, which contains functions from multiple code-sets.” *Id.* at 7:45–48.

B. Illustrative Claim

Challenged independent claims 1 and 11 are representative of the challenged claims, and are reproduced below.

1. A method for setting up a Remote Control that includes a keyboard, a processor, a memory, and a transmitter, the method comprising the steps of:
 - entering, via the keyboard and processor, a configuration mode;
 - accepting, via the keyboard and processor, an identifier-entry; and
 - scanning, via the processor and memory, though [*sic*] remote control code-sets in a database stored in the memory of the Remote Control, wherein the step of scanning comprises:
 - in case that the identifier-entry is a brand-identifier that identifies a brand, (i) iterating, via the processor and memory, through the remote control code-sets corresponding to the brand and (ii) testing said remote control code-sets by sending, via the transmitter, to a Consumer Electronic device for a given iteration, one or more specific control code functions of a corresponding remote control code-set, and
 - in case that the identifier-entry is a code-set-identifier that identifies a single remote control code-set which

in [*sic*] not pointed to by a brand-identifier, testing the single remote control code-set corresponding to the code-set-identifier by sending, via the transmitter, to the Consumer Electronic device one or more specific control code functions of the corresponding single remote control code-set.

Id. at 9:24–50.

11. A method for setting up a Remote Control that includes a keyboard, a processor, a memory, and a transmitter, the method comprising the steps of:

entering, via the keyboard and processor, a configuration mode;

scanning, via the processor and memory, though [*sic*] remote control code-sets in a database stored in the memory of the Remote Control;

testing, via the keyboard, if individuals [*sic*] keys of a code set send, via the transmitter, correct codes and receiving, via the keyboard, user-feedback on the correct and/or incorrect working of the tested keys;

replacing, via the processor and memory, non-working codes with codes from at least a further remote control code-set; and

combining, via the processor and memory, correct working codes from the scanned remote control code-sets into a new custom configuration code set and installing, via the processor and memory, the combined correct working codes of the new custom configuration code set for use by the remote control.

Id. at 10:28–48.

C. Evidence

Petitioner relies on the following references:

Wouters	WO 03/083801	Oct. 9, 2003	Ex. 1009
Verzulli	WO 00/70577	Nov. 23, 2000	Ex. 1010

Radio Shack Phone Up 4 Remote Control Owner’s Manual (Ex. 1014)
 (“RadioShack”)

In addition, Petitioner relies on a Declaration by Henry Houh, Ph.D.
 Ex. 1002. Patent Owner relies on a Declaration by Ravin Balakrishnan,
 Ph.D. Ex. 2002.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–5, 8–11, and 14 on the following
 grounds. Pet. 22.

Claim(s) Challenged	35 U.S.C. §¹	References
11	103(a)	Wouters, Verzulli
1–5, 8–10, 14	103(a)	RadioShack
1–5, 8–10, 14	103(a)	RadioShack, Verzulli

E. Real Parties in Interest

The parties identify only themselves as real parties in interest.
 Pet. 74–75; Paper 4, 2.

F. Related Matters

Both parties identify the following related matters as involving the
 ’875 patent: (1) *Roku, Inc. v. Universal Electronics Inc.*, No. 8:21-cv-00658

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C § 103(a). The ’875 patent resulted from a PCT application filed on March 5, 2007, and that entered the national stage on March 6, 2009. Ex. 1001 at codes (22), (86). We accordingly apply the pre-AIA version of § 103(a) herein.

(C.D. Cal.); and (2) *Certain Televisions, Remote Controls, and Components Thereof*, Inv. No. 337-TA-1263 (USITC) (“the related ITC Investigation”). Pet. 75; Paper 4, 2.²

II. ANALYSIS

A. Legal Principles

A claim is unpatentable for obviousness under 35 U.S.C. § 103 if the differences between the claimed subject matter 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 having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness, i.e., secondary considerations.³ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of

² Patent Owner does not advance any arguments for exercising discretion under § 314(a) based on a parallel proceeding. We decline to address this issue any further. See Pet. 69–72.

³ The parties do not address objective indicia of nonobviousness, which accordingly do not form part of our analysis.

obviousness”)); *see In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person of ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

In the related ITC Investigation, Petitioner proposed that a person of ordinary skill in the art

would have had a bachelor’s degree that involved coursework in interface design and computer programming, for example, electrical engineering, computer engineering, computer science, industrial engineering, physics, or a similar degree, and at least one year of real-world work experience in the field of user interfaces, or human machine interface, or software programming. Additional education might substitute for some of the experience, and substantial experience might substitute for some of the educational background.

Ex. 1007, 20. Patent Owner proposed that a person of ordinary skill in the art “would have had a bachelor’s degree in electrical engineering, computer science, or equivalent degree with two years of work experience relating to communications or consumer electronics.” *Id.* at 19–20. The Administrative Law Judge in the related ITC Investigation found the parties’ proposals “very similar,” and noted that each required “a bachelor’s degree in, *inter alia*, electrical engineering and computer science, and at least one or two years of experience in similar areas.” *Id.* at 20. According to the Administrative Law Judge, “[i]t is expected that the differences among the definitions will have little, if any, effect on the claim construction analysis,” such that both proposals were considered appropriate. *Id.*

We agree with this assessment. We also note that Petitioner takes the position that “[t]he Challenged Claims are unpatentable under both proposed levels,” and Patent Owner takes the position that “the challenged claims are patentable under either proposed level of ordinary skill.” Pet. 8; Prelim. Resp. 7.

For purposes of this Decision, we adopt Patent Owner’s proposed articulation of the level of ordinary skill as advanced in the related ITC Investigation. But we note that we would reach the same ultimate conclusion to institute an *inter partes* review were we to adopt Petitioner’s proposal.

C. Claim Construction

The Board uses “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including

construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

1. Constructions in the related ITC Investigation

In the related ITC Investigation, the parties agreed to the construction of certain terms, and the Administrative Law Judge ruled on others after a *Markman* hearing. *See* Prelim. Resp. 7. The agreed constructions are as follows:

Claim Term	Agreed Construction
“though” in the phrases “scanning, via the processor and memory, <i>though</i> remote control code-sets” (emphasis added) (claims 1, 10, 11) and “scanning <i>though</i> remote control code-sets” (emphasis added) (claim 14)	through ⁴
“in case that the identifier-entry is a brand-identifier . . . and in case that the identifier-entry is a code-set-identifier”	Must be capable of performing both/either conditional step as opposed to a system/method that could only perform one of the two conditional steps
“means for entering a configuration mode”	Construed as a means-plus-function term under 35 U.S.C. § 112 ¶ 6

⁴ “The parties agreed that the word ‘though’ in claims 1, 10, 11, and 14 is a clerical error and should be understood as ‘through.’” Ex. 1007, 4 (citations omitted).

	<u>Function</u>: entering a configuration mode <u>Structure</u>: keyboard 40 as shown in Figure 7 and as described at 9:7–8 and 6:7–11 of the ’875 patent, and equivalents thereof
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Ex. 1007, 4; Pet. 8–9; Prelim. Resp. 7 (Patent Owner agreeing that “[t]hose constructions are set out in the Petition”). Petitioner states that it “applied these agreed constructions” in the Petition, and Patent Owner also states that it “applies the agreed constructions” in its Preliminary Response. Pet. 8; Prelim. Resp. 7. We adopt these constructions as preliminary constructions for purposes of this Decision.

The terms construed by the Administrative Law Judge in the related ITC Investigation are as follows:

Claim Term	ALJ Construction
“a configuration mode . . . accepting . . . scanning” (claims 1, 10, 14)	entering “a configuration mode,” “accepting” an identifier entry, and “scanning” through remote control code-sets
“a configuration mode . . . scanning . . . testing . . . replacing . . . combining” (claim 11)	entering “a configuration mode,” “scanning,” testing,” “replacing,” and “combining”
“identifier-entry” (claims 1, 9, 10, 14)	entry of an identifier
“means for accepting an identifier entry” (claim 14)	Construed as a means-plus-function term under 35 U.S.C. § 112 ¶ 6 <u>Function</u>: accepting an identifier-entry

Claim Term	ALJ Construction
	<u>Structure</u> : a numerical or SMS keyboard
“means for scanning through remote control code-sets” (claim 14)	Construed as a means-plus-function term under 35 U.S.C. § 112 ¶ 6 <u>Function</u> : scanning through remote control code-sets <u>Structure</u> : processor and computer program, with the algorithm as described in 6:28–67, as also shown in Figure 5, steps 4–15 (step 9 being optional)

Ex. 1008; Pet. 9–11; Prelim. Resp. 7 (Patent Owner agreeing that “[t]hose constructions are set out in the Petition”). Petitioner states that it “do[es] not set forth or advocate for any specific construction of these terms in th[e] Petition” but that “the Challenged Claims are unpatentable under all of the previous proposed constructions.” Pet. 11. Patent Owner states that it “applies . . . the constructions made by the ALJ, unless otherwise noted.” Prelim. Resp. 7. For purposes of this Decision, we adopt these constructions as preliminary constructions.

2. Other Constructions

The parties address the construction of certain other phrases that appear in the claims, namely an aspect of the “scanning” step of independent claim 1 and, relatedly, an aspect of the “enabling” step of dependent claim 4. Pet. 11–16; Prelim. Resp. 7–9. Petitioner addresses such phrases because of positions taken by Patent Owner in the related ITC Investigation. Pet. 11

(Petitioner asserting that, in the related ITC Investigation, “Patent Owner attempted to narrowly construe three additional phrases The ALJ has not addressed these new constructions, but as discussed below, Patent Owner’s new constructions should be rejected.”). Patent Owner does not ask that we construe these phrases and, indeed, asserts that it is not necessary for us to do so to decide whether to institute the proceeding. Prelim. Resp. 8–9 (“the Board does not need to resolve that claim construction dispute in order to properly deny institution”); *see also id.* at 41 (“Petitioners’ arguments on this point all deal with an aspect of [Patent Owner’s] proposed claim construction in the ITC Investigation that is not at issue here”).

At this time, we decline to address construction of these additional phrases. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Overview of the Prior Art

1. Wouters

Wouters “relates to a remote control device” that “enable[s] the user to control functions of a device to be controlled via the remote control.” Ex. 1009, 1:2–5. Wouters explains that, “[d]ue to limited code set storage possibilities, numerous look-a-like device code sets are combined into one remote control code set,” such that “the user is confronted with certain buttons (object keys) of a code set that might not have the desired effect on

the device (no effect or wrong behavior).” *Id.* at 1:18–22. A user therefore “has the possibility to try out, using the remote control, all of the proposed preset code sets and pick the one that fits best.” *Id.* at 1:24–25. But in some instances “none of the proposed preset code sets includes all IR or RF codes for all features of the device and, as a result, the user cannot make full use of the capabilities of the device he/she is trying to control while using the remote control.” *Id.* at 1:25–28. Wouters accordingly discloses a remote control that “enables a user to pick IR or RF codes from different code sets to be combined in a single mode” so that the “user himself compiles a code set in such a way that all of the features of his device . . . can be controlled.” *Id.* at 2:18–21.

Figure 1 of Wouters is reproduced below.

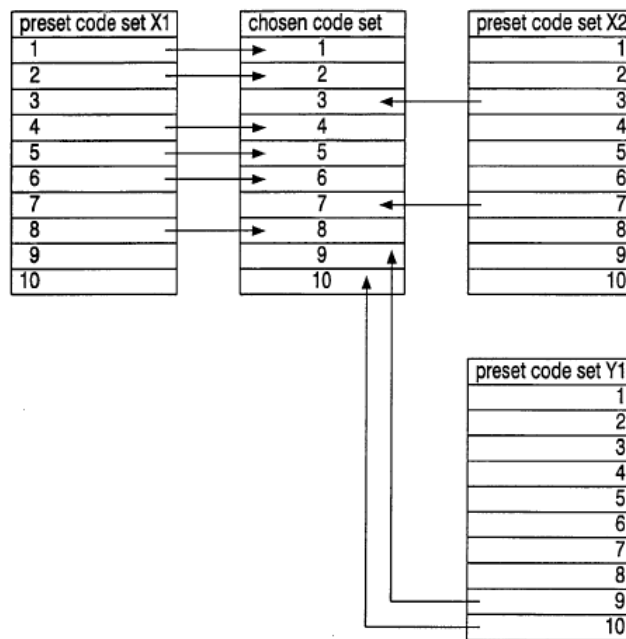


FIG. 1

Figure 1 schematically illustrates that the remote control includes several preset IR or RF codesets, namely codesets X1, X2, and Y1. *Id.* at 6:29–32.

After a process for combining data from multiple preset codesets into a single codeset (the “chosen code set”), “the object keys 1, 2, 4, 5, 6 and 8 are linked to data (commands) from the preset code set X1, the object keys 3 and 7 are linked to data (commands) from the code set X2, and the object keys 9 and 10 are linked to data (commands) from the code set Y1.” *Id.* at 7:7–11. The “chosen code set” is thus “a compilation, compiled by the user, in which data from the preset code sets X1, X2 and Y1 are combined in a single code set.” *Id.*

2. Verzulli

Verzulli “relates generally to a programmable, universal remote control, and more particularly to a programmable, universal remote control in which manufacturer and model numbers of electronic devices to be controlled are stored in the remote control.” Ex. 1010, 1:9–12. Figure 3 of Verzulli is reproduced below.

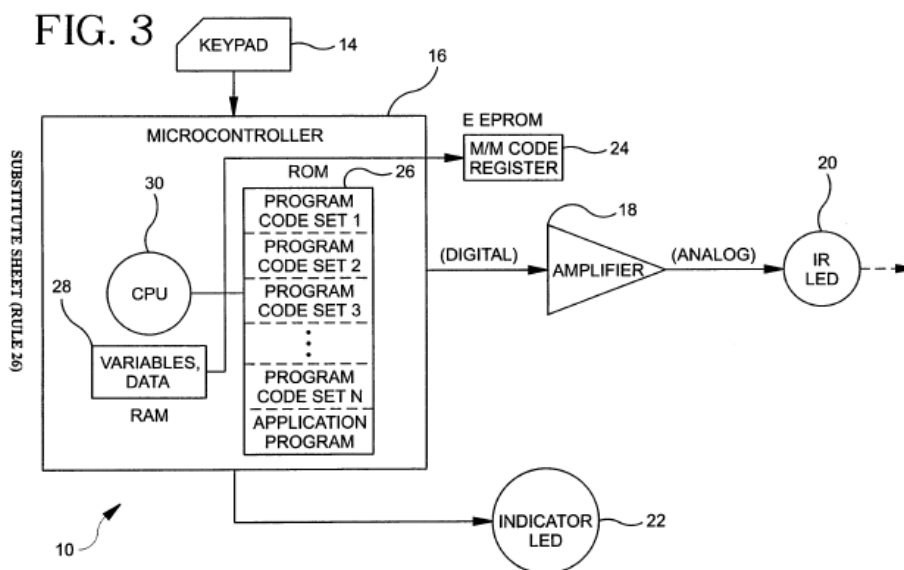


Figure 3 is “a block diagram of a programmable, universal remote control” that includes, among other components, keypad 14; “a processing circuit,

microprocessor, application specific integrated circuit (ASIC), programmable logic device, or microcontroller 16”; read-only memory (EEPROM) 24; random-access memory 28; central processing unit 30; and infrared light emitting diode 20. *Id.* at 7:3–4, 9:1–5.

3. *RadioShack*

a. *Disclosure*

RadioShack is an owner’s manual for the Phone Up 4 Remote Control, which “lets you operate almost any infrared device in your home from a distance,” including a TV, VCR, and cable converter. Ex. 1014, 2.⁵ RadioShack discloses three methods for setting up the Phone Up 4 Remote Control. *See id.* at 10–11, 32, 36–37.

First, a version of brand search may be initiated when the user presses the device key corresponding to the device the user wants to configure for remote control (“VCR, AUX, TV, or CBL”), and then holds down the “SETUP” key until the red light blinks twice. *Id.* at 10. The user then enters a four-digit code that corresponds to the brand of the device to be controlled. *Id.* The user sends a test code to the device by pressing “PWR” and, if the device does not respond, “press[ing] the numbers 1 through 9 and 0, one at a time,” to try other codesets associated with the entered brand. *Id.* When the device responds, the user presses “SETUP” to confirm selection and installation of that codeset. *Id.* If the device still does not respond after trying all codesets for that brand, the user may press “CHAN ^” to try codesets associated with other brands. *Id.* at 11.

⁵ When citing to RadioShack, we cite to its original pagination, rather than to the Bates numbers added by Petitioner.

Second, the user may use device codes to configure the remote control by pressing the device key and holding “SETUP,” after which the user enters “9 8 4,” followed by the four-digit individual codeset for the device.

Id. at 36. If a test of the “PWR” key is successful, the user presses “SETUP” to “lock in the code.” *Id.* at 37.

Third, a manual code search may be used in which the user again presses the device key and holds “SETUP,” this time followed by entering “9 9 1” and slowly alternating between pressing “PWR” and the device key. *Id.* at 32. When the device responds, the user immediately presses “SETUP” to lock in the device code. *Id.*

b. Whether RadioShack is a Printed Publication

Patent Owner contends that Petitioner has “failed to establish a reasonable likelihood that RadioShack was publicly accessible before either the priority date or the critical date of the ’875 patent.” Prelim. Resp. 26. “[T]herefore,” Patent Owner argues, Petitioner has “failed to show that RadioShack qualifies as prior art at all under 35 U.S.C. § 102(a) or (b).” *Id.* (citing *Topcon Medical Systems, Inc. v. Carl Zeiss Meditec, Inc.*, IPR2021-00452, Paper 14 at 9 (PTAB July 21, 2021)). Petitioner treats the critical date of the ’875 patent as March 15, 2006, for § 102(a) prior art, and treats the critical date as March 5, 2006, for § 102(b) prior art. Pet. 5. Patent Owner does not dispute these dates.

Whether a reference qualifies as a “printed publication” is a legal conclusion based on underlying factual findings. *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1375 (Fed. Cir. 2018) (citing *Jazz Pharm., Inc. v. Amneal Pharm., LLC*, 895 F.3d 1347, 1356 (Fed. Cir. 2018)).

The underlying factual findings include whether the reference was publicly accessible. *Id.* (citing *In re NTP, Inc.*, 654 F.3d 1279, 1296 (Fed. Cir. 2011)). To establish that RadioShack qualifies as a printed publication, Petitioner relies on indicia on the document itself, as well as testimony by Daniel Tonks. *See* Exs. 1013, 1014. With respect to the document’s indicia, Petitioner observes that RadioShack bears a 1996 copyright notice and additionally includes a date of “July 19, 1999.” Pet. 19; Ex. 1014. In addition, Mr. Tonks testifies that RadioShack “is an accurate copy of what is available on RemoteCentral.com as 151917-manual.zip, internally archived as 15-1917.pdf.” Mr. Tonks “can confirm that this file was obtained directly from a Radio Shack-owned website in 2004” and that “[i]t was not provided through a third party.” Ex. 1013 ¶ 3. Petitioner also provides a copy of upload details to RemoteCentral.com as Exhibit 1015, which appears to corroborate Mr. Tonks’s testimony.

Petitioner reasons that this evidence confirms that “RadioShack was publicly available on a RadioShack website by at least 2004,” and that “RadioShack was published and publicly available on RemoteCentral.com as of April 30, 2004.” Pet. 19 (citing Ex. 1013 ¶ 3). According to Petitioner, “RadioShack is prior art under pre-AIA 35 U.S.C. §102(a) because it was published and publicly available before the priority date of the ’875 Patent.” *Id.* In addition, Petitioner contends that “RadioShack is also prior art under pre-AIA 35 U.S.C. §102(b) because it was published and publicly available more than one year before the date of application for the ’875 Patent in the U.S.” *Id.*

Patent Owner disputes the sufficiency of Petitioner’s evidence. According to Patent Owner, Petitioner has “failed in two ways to show

public accessibility.” Prelim. Resp. 27. First, “Petitioners have failed to show how a [person of ordinary skill in the art] would have arrived at the homepage of websites allegedly containing the RadioShack reference.” *Id.* at 27–28. Second, “Petitioners have failed to show that the websites were sufficiently indexed such that a [person of ordinary skill in the art] could have located the RadioShack reference on the websites using their search functionalities.” *Id.* at 28.

The issue of whether RadioShack is a printed publication would benefit from further development at trial. Board precedent instructs us that, “at the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). *Hulu* additionally observes that, after institution, certain limited opportunities are available for a petitioner to present new evidence in support of its position. *Hulu* at 14–16. We evaluate Petitioner’s evidence as presented at this stage in light of this backdrop.

In this instance, Petitioner does not rely solely on the date indicia present on the RadioShack document, which include both the 1996 copyright notice and the further date of “July 19, 1999,” but also on the availability on the RemoteCentral.com site. Pet. 19; Ex. 1013, ¶¶ 3–6; Ex. 1014; *see Hulu* at 17–18 (“[T]he indicia on the face of a reference, such as printed dates and stamps, are considered as part of the totality of the evidence”). The testimonial evidence that Petitioner supplies supports its position, and that

testimonial evidence is subject to meaningful cross-examination as routine discovery. *See* 37 C.F.R. § 42.51(b)(1). Although Patent Owner argues that Petitioner has “failed to show that the websites were sufficiently indexed such that a [person of ordinary skill in the art] could have located the RadioShack reference on the websites using their search functionalities,” *Hulu* reminds us that the Federal Circuit has cautioned that “neither cataloging nor indexing is a necessary condition for a reference to be publicly accessible.” *Hulu* at 10 (quoting *In re Lister*, 583 F.3d 1307, 1312 (Fed. Cir. 2009)). Rather, such indexing is, like the date indicia of the document, “considered as part of the totality of the evidence.” *Id.* at 17–18 (citing *Nobel Biocare Servs. AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1377 (Fed. Cir. 2018)).

Mr. Tonks testifies that, after its founding in 1998, “RemoteCentral.com quickly grew to be the internet’s preeminent source for universal remote control information and community for both home users and Custom Installers.” Ex. 1013 ¶ 1. Patent Owner contends that a person of ordinary skill in the art would not “necessarily” be a “home user or custom installer.” Prelim. Resp. 31. This point may meaningfully be explored during the trial, particularly in the context of the standard that public accessibility may be established by a satisfactory showing that a reference was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *Jazz Pharm.*, 895 F.3d at 1355 (quoting *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981)). On the present record and for the purposes of institution, we find Mr. Tonk’s testimony

regarding RemoteCentral.com to sufficiently support Petitioner’s assertions regarding the availability of the reference on that site.

In light of these considerations, we determine that Petitioner’s showing regarding public accessibility of RadioShack is sufficient under the standard we apply at this stage of the proceeding. *See Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1370 n.6 (Fed. Cir. 2021) (“A petitioner may provide evidence of public accessibility of a reference after the petition stage if the patent owner raises a challenge to public accessibility.”).

E. Claims 1–5, 8–10, and 14: Obviousness over RadioShack

Petitioner challenges claims 1–5, 8–10, and 14 as unpatentable under 35 U.S.C. § 103(a) over RadioShack. Pet. 37–69.

1. Independent Claim 1

a. Structural Limitations of the “Remote Control”

For the “keyboard,” “processor,” “memory,” and “transmitter” of the “Remote Control” recited in independent claim 1, Petitioner relies on: (1) an illustration of RadioShack’s Phone Up 4 Remote Control that includes a keyboard, Ex. 1014, 6; (2) RadioShack’s disclosure that the Phone Up 4 is “preprogrammed,” *id.* at 2, such that a person of ordinary skill in the art would have understood that such preprogramming requires a processor; (3) RadioShack’s disclosure that the Phone Up 4 includes a “library,” *id.* at 32, which a person of ordinary skill in the art would have understood to be stored in a memory; and (4) RadioShack’s disclosure of infrared operation of the Phone Up 4 to control devices, *id.* at 2, 32, which a person of ordinary

skill in the art would have understood as requiring a transmitter.⁶ Pet. 37–40. Petitioner supports these identifications, which are not disputed by Patent Owner, with testimony by Dr. Houh, and we find them sufficient at this stage of the proceeding. *See* Ex. 1002 ¶¶ 171–180.

b. “entering” and “accepting”

We determine that Petitioner’s analysis for the first two steps of the method recited in independent claim 1 is sufficient under the standard we apply at this stage of the proceeding. *See* Pet. 42–46. In making this determination, we are mindful of our preliminary adoption of the Administrative Law Judge’s construction in the related ITC Investigation that the “accepting” and “scanning” steps of independent claim 1 may occur separate and apart from any entered configuration mode. *See id.* at 44 (citing Ex. 1008, 1–2). At this time, Patent Owner does not dispute that Petitioner’s showing is sufficient.

First, the claim requires “entering, via the keyboard and processor, a configuration mode.” Ex. 1001, 9:27–28. Petitioner contends that RadioShack discloses this step by teaching the user, during the brand search, to press a device key (“VCR, AUX, TV, or CBL”) followed by the “SETUP” key until the red light on the remote control blinks twice. Pet. 42 (citing Ex. 1014, 10). Petitioner alternatively identifies a similar procedure

⁶ These recitations are included in the preamble. Because Petitioner makes a sufficient showing that a person of ordinary skill in the art would understand RadioShack to meet these recitations, we need not decide whether the preamble is limiting.

for device-code configuration as summarized above. *Id.* (citing Ex. 1014, 36).

Second, the claim requires “accepting, via the keyboard and processor, an identifier-entry.” Ex. 1001, 9:29–30. For this step, Petitioner identifies the user input of a four-digit manufacturer’s code during the brand search or, alternatively, entry of the four-digit device code during the device search. Pet. 45. In either instance, these identifications are consistent with the Administrative Law Judge’s construction of “identifier-entry” in the related ITC Investigation, which we have adopted for purposes of this Decision. *See id.* at 46.

c. “scanning”

Independent claim 1 recites “scanning, via the processor and memory, through remote control code-sets in a database stored in the memory of the Remote Control.” Ex. 1001, 9:31–33. For this step, Petitioner identifies RadioShack’s procedure of pressing “PWR” and then “the numbers 1 through 9 and 0, one at a time,” to see whether the device to be controlled responds. Pet. 46. We determine that this identification is sufficient for this aspect of the “scanning” step, and Patent Owner does not dispute its sufficiency at this time.

The “scanning” step also includes substeps that apply for different instances of the “identifier entry.” The first set of substeps applies “in case that the identifier-entry is a brand-identifier that identifies a brand,” in which case “scanning” comprises “(i) iterating, via the processor and memory, through the remote control code-sets corresponding to the brand and (ii) testing said remote control code-sets by sending, via the transmitter, to a

Consumer Electronic device for a given iteration, one or more specific control code functions of a corresponding remote control code-set.”

Ex. 1001, 9:35–42. For these substeps, Petitioner relies on the user’s testing of “PWR” and “the numbers 1 through 9 and 0” as part of RadioShack’s brand search. Pet. 49–50.

The second set of substeps applies “in case that the identifier-entry is a code-set-identifier that identifies a single remote control code-set which [is] not pointed to by a brand-identifier,” in which case “scanning” comprises “testing the single remote control code-set corresponding to the code-set-identifier by sending, via the transmitter, to the Consumer Electronic device one or more specific control code functions of the corresponding single remote control code-set.” Ex. 1001, 9:43–50. For these substeps, Petitioner relies on RadioShack’s disclosure of device codes that are not associated with a manufacturer that has a manufacturer code, and specifically points to “Dae Ryung (0008), Everquest (0015), and Goldstar (0144)” device codes. Pet. 50–52; Ex. 1014, 13, 37.

Patent Owner disputes Petitioner’s showing only with respect to the first set of substeps. Prelim. Resp. 38–42. In particular, Patent Owner contends that “RadioShack does not disclose anything that satisfies the plain meaning of the term ‘iterating.’” *Id.* at 38. Relying on dictionary definitions and Dr. Balakrishnan’s testimony, Patent Owner contends that “[t]he plain meaning of ‘iterate’ to one of skill in the art is ‘to execute one or more statements or instructions repeatedly. Statements or instructions so executed are said to be in a loop.’” *Id.* (citing Ex. 2004, 251; Ex. 2005; Ex. 2002 ¶ 80). According to Patent Owner, “RadioShack does not disclose ‘repeatedly’ executing an instruction, or doing something ‘again and again

and again,’ because a different key is pressed to test each particular code-set.” *Id.* at 39. In doing so, Patent Owner also emphasizes that its argument is distinct from an argument presented (and rejected by the Administrative Law Judge) during the related ITC Investigation: “[Patent Owner] is not arguing that the ‘iterating’ limitation excludes user input, but rather that even if user input is allowed, the particular type of user input in RadioShack—pressing specific (and different in each instance) keys to send and test specific code-sets—is not consistent with the plain meaning of the term ‘iterating.’” *Id.* at 41 (citing Ex. 2002 ¶ 84).

On the record before us and preliminarily, we agree with Petitioner. Even applying Patent Owner’s interpretation of “iterate” as meaning “to execute one or more statements or instructions repeatedly,” the portion of RadioShack identified by Petitioner appears to satisfy the limitation. That is, RadioShack teaches a procedure for testing a series of codesets by having the user press “PWR” and “the numbers 1 through 9 and 0.” Ex. 1014, 10. In each instance, the device’s response is evaluated, and RadioShack clearly contemplates proceeding through multiple keys during this test procedure. *See id.* In each occurrence, a key is pressed, a corresponding codeset is tried, and the response evaluated. Executing these instructions is thus performed “repeatedly.” We do not understand the plain meaning of iterate to be so narrow as to require entirely unvarying repetition such that merely pressing a different key is distinguishing. Indeed, iterations commonly use an index value that is incremented (and used) in each repetition of the instructions.

We accordingly determine that Petitioner makes a sufficient showing with respect to the “scanning” step under the standard we apply at this stage.

d. Summary

Because Petitioner makes a sufficient showing for each of the structural limitations of the recited “Remote Control,” and makes a sufficient showing for each step of the recited method, we conclude that Petitioner establishes a reasonable likelihood of prevailing on its challenge of claim 1 as unpatentable under 35 U.S.C. § 103(a) over RadioShack.

2. Dependent Claims 2–5 and 8–10

We have reviewed Petitioner’s analysis of dependent claims 2–5 and 8–10, each of which depends from independent claim 1. Pet. 53–62. At this time, Patent Owner does not dispute that analysis outside of its arguments directed at underlying independent claim 1, and we determine that that analysis is sufficient.

After considering the analysis presented, we conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claims 2–5 and 8–10 as unpatentable under 35 U.S.C. § 103(a) over RadioShack.

3. Independent Claim 14

Independent claim 14 is an apparatus claim that generally parallels the method recited in independent claim 1, and includes limitations written in means-plus-function format. *Compare* Ex. 1001, 9:24–50 *with id.* at 10:55–11:7; *see* Prelim. Resp. 46 (Patent Owner agreeing that “[a]pparatus claim 14 corresponds, element-by-element, to method claim 1, but is written in mean[s]-plus-function form.”). Petitioner presents an analysis of this claim that generally tracks its analysis of independent claim 1, but addressing how

the limitations are met under the preliminary means-plus-function constructions that we have adopted for purposes of this Decision. Pet. 63–69; *see* Prelim. Resp. 46–47 (Patent Owner agreeing that “Petitioners’ arguments for invalidity of claim 14 parallel their arguments for claim 1.”). Patent Owner disputes Petitioner’s showing only “[f]or the same reasons that RadioShack [does] not satisfy the ‘iterating’ limitation of claim 1.” Prelim. Resp. 47. On the present record, we disagree with Patent Owner’s argument with respect to that limitation on the record before us. We determine that Petitioner makes a sufficient showing for the same reasons we discuss above in the context of independent claim 1.

We conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of independent claim 14 as unpatentable under 35 U.S.C. § 103(a) over RadioShack.

*F. Claims 1–5, 8–10, and 14:
Obviousness over RadioShack and Verzulli*

Petitioner challenges claims 1–5, 8–10, and 14 as unpatentable under 35 U.S.C. § 103(a) over RadioShack and Verzulli. Pet. 37–69. Petitioner presents this challenge as an alternative to its obviousness challenge over RadioShack alone, relying on Verzulli “[t]o the extent RadioShack does not disclose” what Petitioner characterizes as “the hardware limitations of a processor, a memory, and a transmitter.” *Id.* at 40–42, 43, 45–46, 47, 49–50, 53, 54–55, 56, 57, 59, 61, 62, 68. Petitioner reasons that a person of ordinary skill in the art “would have been motivated to combine RadioShack Phone Up 4 Manual with Verzulli at least because the RadioShack Phone Up 4 Manual and Verzulli both relate to the same subject matter: methods of

configuring a [universal remote control].” *Id.* at 41. In addition to contending that a person of ordinary skill in the art “reading RadioShack would have been motivated to look to references like Verzulli for implementation details regarding hardware used to execute the steps described in RadioShack,” Petitioner contends that such a skilled artisan “would have readily been able to implement the hardware block diagram of Verzulli” and “to implement the programming methods described in the RadioShack Manual using the flow charts of Verzulli.” *Id.* at 41–42.

Petitioner supports its reasoning for effecting the combination of teachings of RadioShack and Verzulli with Dr. Houh’s testimony, and, at this time, Patent Owner does not dispute that reasoning. Ex. 1002 ¶¶ 181–191. We determine that Petitioner’s reasoning is supported by rational underpinning and sufficient at this stage of the proceeding.

After considering the analysis presented, we conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claims 1–5, 8–10, and 14 as unpatentable under 35 U.S.C. § 103(a) over RadioShack and Verzulli.

G. Claim 11: Obviousness over Wouters and Verzulli

Petitioner challenges claim 11 as unpatentable under 35 U.S.C. § 103(a) over Wouters and Verzulli. Pet. 23–37. At this time, we do not make a full determination on the sufficiency of Petitioner’s evidence and argument with respect to every limitation in determining whether to institute the proceeding. Because other grounds provide a sufficient basis for instituting the proceeding, we instead provide our preliminary observations regarding Petitioner’s challenge to claim 11 and note areas where the record

would benefit from further development of the evidence and argument. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364 (Fed. Cir. 2019) (“[I]f the Board institutes an IPR, it must . . . address all grounds of unpatentability raised by the petitioner.”); 37 C.F.R. § 42.108(a).

1. Structural Limitations of the “Remote Control”

In advancing its challenge to claim 11, Petitioner relies primarily on the teachings of Wouters to meet the claim limitations, and relies on Verzulli as teaching the recited “keyboard,” “processor,” “memory,” and “transmitter” of the recited “Remote Control.”⁷ *See id.* at 25, 30, 31, 33, 34, 37. According to Petitioner, a person of ordinary skill in the art “would understand that Wouters’[s universal remote control] discloses the keyboard, processor, memory, and transmitter.” *Id.* at 25. But “[t]o the extent Wouters does not disclose these limitations,” Petitioner says, “it would be obvious to a [person of ordinary skill in the art] to combine Wouters with Verzulli to use a keyboard, processor, memory, [and] transmitter, and to teach these limitations.” *Id.*

In its proposed combination, Petitioner draws a correspondence between elements recited in the claim and structures shown in Figure 3 of Verzulli, reproduced above: between (1) the recited “keyboard” and keypad 14; (2) the recited “processor” and microcontroller 16 or central processing unit 30; (3) the recited “memory” and read-only memory 26 or

⁷ These recitations are included in the preamble. Because Petitioner makes a sufficient showing that the combination of Wouters and Verzulli meets these recitations, we need not decide whether the preamble is limiting.

random-access memory 28; and (4) the recited “transmitter” and infrared light emitting diode 20. *Id.* at 25–26. Petitioner reasons that a person of ordinary skill in the art would have been motivated to combine Wouters with Verzulli “at least because Wouters and Verzulli both relate to methods of configuring a [universal remote control].” *Id.* at 27 (citing Ex. 1002 ¶ 136; Ex. 1009, Abstr., 2:18–29; Ex. 1010, 1:9–12, 4:27–5:4). Petitioner supports this reasoning with testimony by Dr. Houh, who also testifies that a person of ordinary skill in the art would have been motivated “to use such well-known hardware to implement the configuration methods disclosed in Wouters.” Ex. 1002 ¶¶ 136, 138; *see* Pet. 27.

Petitioner articulates reasoning based on rational underpinning to effect the combination, and Patent Owner does not dispute Petitioner’s reasoning at this time. We conclude that Petitioner provides sufficient basis to support its proposed combination.

2. “entering,” “scanning,” and “testing”

We determine that Petitioner’s analysis for the first three steps of the method recited in independent claim 11 is sufficient under the standard we apply at this stage of the proceeding. *See* Pet. 27–33. In making this determination, we are mindful of our preliminary adoption of the Administrative Law Judge’s construction in the related ITC Investigation that the “scanning,” “testing,” “replacing,” and “combining” steps of independent claim 11 may occur separate and apart from any entered configuration mode. *See id.* at 29–30 (citing Ex. 1008, 1–2). At this time, Patent Owner does not dispute that Petitioner’s showing is sufficient.

First, the claim requires “entering, via the keyboard and processor, a configuration mode.” Ex. 1001, 10:31–32. Petitioner contends that Wouters teaches this step by disclosing entering a configuration mode to change an installed codeset. Pet. 28 (citing Ex. 1002 ¶ 140). In particular, Petitioner observes that Wouters teaches that a user may select a device by pressing a button on the home panel of the remote control, which then provides an option to adjust the remote control to operate with a particular brand. *Id.*; Ex. 1009, 8:5–15.

Second, the claim requires “scanning, via the processor and memory, through remote control code-sets in a database stored in the memory of the Remote Control.” Ex. 1001, 10:33–35. For this step, Petitioner identifies Wouters’s disclosure of a user instructing the remote control to scan through the code sets by following on-screen instructions to navigate to another codeset for a brand. Pet. 30 (citing Ex. 1009, 10:1–7).

Third, the claim requires “testing, via the keyboard, if individual[] keys of a code set send, via the transmitter, correct codes and receiving, via the keyboard, user-feedback on the correct and/or incorrect working of the tested keys.” Ex. 1001, 10:36–39. Petitioner addresses this step by pointing to disclosure in Wouters of a “Try” mode in which, after the user has selected a particular codeset, the user selects individual keys to test and is further prompted if the key works correctly. Pet. 31–32 (citing Ex. 1009, 9:12–20).

3. “replacing”

The claim recites “replacing, via the processor and memory, non-working codes with codes from at least a further remote control code-set.”

Ex. 1001, 10:40–42. Petitioner contends that Wouters discloses this step through its procedure of creating the “chosen code set.” Pet. 33–34.

The procedure begins when a user chooses a device type, such as “TV,” from a menu displayed by the remote control, then chooses a brand for the device, such as “Philips,” and, if available chooses one of multiple available codesets for that brand. Ex. 1009, 8:5–6, 8:17–31, 9:4–5, Figs. 2, 6–8. Tapping “Next” as illustrated in Figure 8 (not reproduced here) switches the remote control to the “Try” mode. *Id.* at 9:12, Fig. 9. In this mode, “the user may try out a button on the control panel and check if the device responds.” *Id.* at 9:13–15. If the device responds correctly to the pressed button, “the user taps Next and the code for that particular pressed button . . . will be installed (activated). On the control panel the installed button will preferably change color (or be highlighted) to communicate to the user which key(s) is (are) already installed.” *Id.* at 9:22–25. If the device does not respond correctly, the user presses the “Back” to revert to the “Try” mode screen. *Id.* at 9:17–19. In either case, the user may repeat the process until all buttons have been tried. *Id.* at 9:19–20, 9:25–26.

If some buttons did not respond correctly and remain uncolored, “the user taps Back after which the remote control will again propose selection of a new brand from the list.” *Id.* at 10:1–3. “This new brand will only have an effect on those buttons that were not installed in the last steps.” *Id.* at 10:3–5. The process is repeated for the new codeset, with buttons activated from the different codesets preferably “indicated in a different color or highlighted in another manner.” *Id.* at 10:7–13. “After activation of all object keys (or as many object keys as the user wishes to install), the chosen code set is finished.” *Id.* at 10:16–17.

Petitioner characterizes this procedure as one in which, “during the programming process, keys that are indicated by the user to not function properly will be indicated in a different color or highlighted, and [] the user can *replace those non-working key codes* by installing other key codes from other codesets onto those keys.” Pet. 33 (emphasis added). Patent Owner disputes this characterization, arguing that “Wouters does not disclose ‘replacing . . . non-working codes’ with codes from another codeset.” Prelim. Resp. 17. According to Patent Owner, this is “because non-working codes are not installed on the remote.” *Id.* (citing Ex. 2002 ¶ 52).

But Wouters discloses that “the remote control device has a storage means which can be filled with said preset code sets.” Ex. 1009, 6:32–34. Thus, even if not initially “installed,” the nonworking codes appear to be stored on the device. The procedure for creating the “chosen code set” involves beginning with a particular stored codeset selected by the user, with the nonworking codes from that codeset “replac[ed]” with codes from another codeset.

Both parties support their positions with declarant testimony. *See* Ex. 1002 ¶¶ 162–164; Ex. 2002 ¶¶ 52–53. The record would benefit from further development on this issue during trial.

4. “*combining*” and “*installing*”

The claim recites “combining, via the processor and memory, correct working codes from the scanned remote control code-sets into a new custom configuration code set and installing, via the processor and memory, the combined correct working codes of the new custom configuration code set for use by the remote control.” Ex. 1001, 10:43–48. Petitioner contends that

this step is met by Wouters, which “discloses that when all the keys are assigned from various codesets and the user completes the programming process thus combining codes from multiple codesets into a new customized codeset, the customized code set combination can be saved as a new custom configuration codeset.” Pet. 35. In addition, Petitioner observes that, once Wouters’s “chosen code set” is activated, it is available for use by the remote control. *Id.* at 36.

Patent Owner disputes Petitioner’s showing by arguing that the steps of “combining” and “installing” “must be done in that order—‘combining’ the codes first, and then ‘installing’ them.” Prelim. Resp. 18. According to Patent Owner, in Wouters “there is no ‘combining’ of ‘correct working codes into a new custom configuration code set’” because “the codes are installed one code at a time.” *Id.* at 21 (citing Ex. 2002 ¶ 57).

Petitioner has not had an opportunity to respond to Patent Owner’s argument that, not only does the claim require that “combining” must be performed before “installing,” but that the “combining” must be complete before any installation of the recited “new custom configuration code set.” Again, both parties support their positions with declarant testimony, and the record would benefit from further development on this issue during trial. *See* Ex. 1002 ¶¶ 167–170; Ex. 2002 ¶¶ 54–57.

III. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail in showing that at least one of the challenged claims is unpatentable. Accordingly, we institute *inter partes* review as to all challenged claims and

grounds presented in the Petition. *See SAS Inst.*, 138 S. Ct. at 1359–60; 37 C.F.R. § 42.108(a).

IV. ORDER

In consideration of the foregoing, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–5, 8–11, and 14 of the '875 patent on all ground set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, commencing on the entry date of this Decision.

IPR2022-00818
Patent 8,378,875 B2

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