

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS INC.,
Patent Owner.

Case IPR2022-01289
Patent No. 9,847,083

PATENT OWNER'S PRELIMINARY RESPONSE

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Patent Owner Universal Electronics Inc. ("Patent Owner") submits this Preliminary Response in accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107 and in response to the Petition filed by Roku, Inc. ("Petitioner") requesting *inter partes* review of Claims 1-19 ("Challenged Claims") of U.S. Pat. No. 9,847,083 ("the '083 patent"). Patent Owner timely filed this Preliminary Response under 37 C.F.R. § 42.107(b) within three months of the mailing date of the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response.

I. INTRODUCTION

The Petition seeks review of Challenged Claims 1-19 of the '083 patent based on four obviousness grounds. The Board should decline to institute *inter partes* review of the '083 patent for at least three reasons.

First, Petitioner has failed to show that its asserted prior art references, either alone or in combination, disclose, teach, or suggest every limitation of the Challenged Claims.

Second, Petitioner has failed to identify sufficient reasons why one of ordinary skill in the art would have been motivated to combine the asserted references to arrive at the claimed invention.

Third, Petitioner has failed to support its obviousness positions with the testimony of one of skill in the art.

Accordingly, Patent Owner respectfully requests that the Board decline to institute an *inter partes* review of the '083 patent.

II. BACKGROUND

A. The '083 Patent And The Challenged Claims.

The '083 patent, entitled "System and Method for Voice Actuated Configuration of a Controlling Device," was issued on December 19, 2017 from U.S. Patent Application No. 13/298,629 (filed November 17, 2011). (EX1001, '083 patent, at [21], [22], [45], [54].)

The '083 patent and the Challenged Claims generally relate "to remote control systems and, more particularly, to a system and method for setting up and configuring a controlling device such as a universal remote control to command functions of one or more types of remotely controllable appliances of one or more manufacturers." (*Id.* at 1:7-12.) According to the '083 patent, "it has been seen that the process of setting up and configuring a controlling device such as a universal remote control [is] demanding, exacting, and generally frustrating for many users." (*Id.* at 2:14-17.) "For example, user manuals or other documents containing setup codes and entry instructions may be lost or misplaced, or may be superseded as brand and/or model names evolve or controllable functions are added; a personal computer and/or Internet access may not be readily available at the location of the appliances to be controlled; etc." (*Id.* at 2:17-23.) Thus, the '083 patent recognized the need

“for a simplified and more user friendly system and method for conveniently setting up and configuring a controlling device.” (*Id.* at 2:23-25.)

The ‘083 patent created “a controlling device ... provisioned with means to receive voice input from a user, e.g., a microphone, such that when placed in a setup mode the controlling device may solicit spoken appliance descriptive information, for example brand and model number, to be processed by a speech recognition system in order to identify the appliance to be controlled and the command data to which it is responsive.” (*Id.* at 2:34-41.) This “speech recognition capability may be extended to allow a user to further refine the controlling device configuration, for example by assigning extended functionality to certain keys, verbally accessing infrequently used functions, defining activities, etc.” (*Id.* at 2:47-51.)

The ‘083 patent also created an appliance command code database for use in conjunction with the controlling device, wherein the command code database “may comprise a series of brand records 702 each of which points to a group of model records 704 specific to that brand, each model record in turn pointing to a codeset record 706 containing ... [data] applicable to that specific brand and model of appliance.” (*Id.* at 9:55-62.) “[E]ach code set record 706 may comprise ... a block of protocol and formatting information 752 which may describe the physical protocol requirements for transmitting the command data elements which comprise this codeset...” (*Id.* at 10:47-51.) “Following block 752 may be a series of

individual command function entries 754.” (*Id.* at 10:54-55.) “Each entry may comprise a standard function ID 756, ... a function name 758 ... together with its phonetic representation 760; and command data 762.” (*Id.* at 10:56-65.) “In some embodiments, multiple instances of function name 758 and associated phonetic representation 760 may be present to cater for synonyms and/or regional differences.” (*Id.* at 11:1-3.) An example codeset record 706 of the ‘083 patent is shown below:

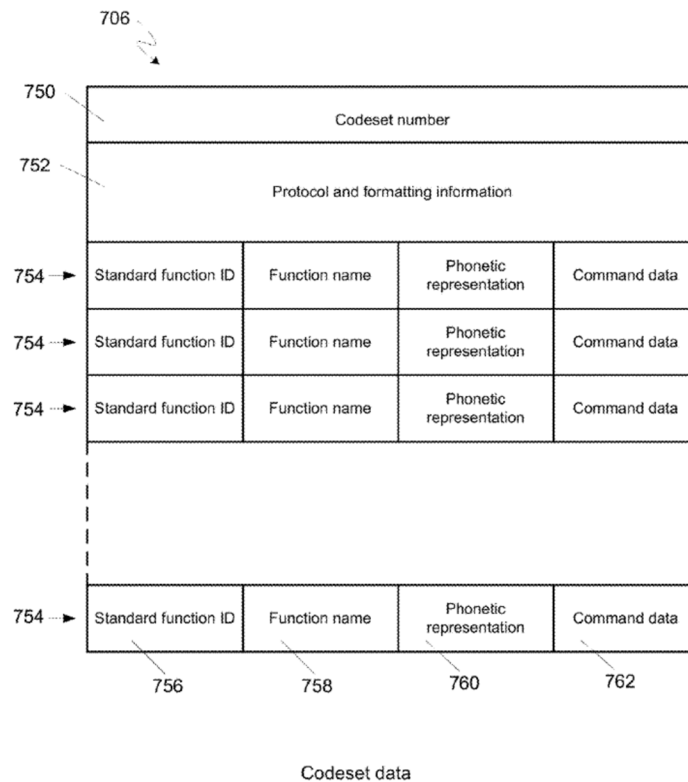


Figure 7b

(*Id.* at FIG. 7b.)

According to the '083 patent, "the information contained in the identified codeset record may be transferred to the controlling device being configured." (*Id.* at 11:5-7.) "Furthermore, in order to identify user-requested extended command functions, the phonetic representations 758 corresponding to the command function entries of the codeset number corresponding to the currently configured appliance may be searched by the speech recognition means ... and the matching command data returned to the requesting controlling device." (*Id.* at 11:13-20.)

Independent Challenged Claims 1 and 12 of the '083 patent are reproduced below:

1. A method for configuring a controlling device to command functional operations of a target appliance, the method comprising:

causing a codeset record to be provisioned to the controlling device for use in commanding functional operations of the target appliance, the provisioned codeset record comprising protocol and formatting information and a plurality of individual command function entries wherein each of the plurality of individual function entries within the codeset record comprises command data, a standard function identifier, data which comprises a phonetic representation of a function name corresponding the standard function identifier, and a plurality of data each of which comprises a phonetic representation of a unique one of a plurality of synonyms of the function name;

causing less than all of the individual command function entries from within the provisioned codeset record to each be matched to one or more of a plurality of user input elements of the controlling device whereupon a

subsequent activation of a one of the plurality of user input elements will cause the controlling device to transmit a command communication by using the protocol and formatting information and the command data of a one or more of the plurality of individual command function entries from within the provisioned codeset record that was mapped to the one of the plurality of user input element activated; and

causing the controlling device to transmit a command communication by using the protocol and formatting information and the command data of a one of the one or more of the plurality of individual command function entries from within the provisioned codeset record having a phonetic representation of the function name or a synonym of the function name which corresponds to voice data provided to a speech recognition engine.

(*Id.* at claim 1.)

12. A system for configuring a controlling device to command functional operations of a target appliance, the system comprising:

a processing device having associated instructions stored on a non-transient readable media which instructions, when executed by the processing device, cause a codeset record to be provisioned to the controlling device for use in commanding functional operations of the target appliance wherein the provisioned codeset record comprises protocol and formatting information and a plurality of individual command function entries wherein each of the plurality of individual function entries within the codeset record comprises command data, a standard function identifier, data which comprises a phonetic representation of a function name corresponding to the standard function identifier, and a plurality of data each of which comprises a phonetic representation of a unique one of a plurality of synonyms of the function name; cause less than all of the individual command codes from within the

provisioned codeset record to each be mapped to one or more of a plurality of user input elements of the controlling device wherein a subsequent activation of a one of the plurality of user input elements will cause the controlling device to transmit a command communication by using the protocol and formatting information and the command data of a corresponding one or more of the plurality of individual command function entries from within the provisioned codeset record that was mapped to the one of the plurality of user input elements activated, and cause the controlling device to transmit a command communication by using the protocol and formatting information and the command data of a one of the one or more of the plurality of individual command function entries from within the provisioned codeset record having a phonetic representation of the function name or a synonym of the function name which corresponds to voice data provided to a speech recognition engine.

(*Id.* at claim 12.)

As shown above, Challenged Claims 1 and 12 of the '083 patent recite a controlling device with a codeset record comprising protocol and formatting information and a plurality of command function entries. Each of the command function entries comprises, *inter alia*, a phonetic representation of a function name and phonetic representations of a plurality of synonyms of the function name. (*Id.* at claims 1, 12.) When a speech recognition engine recognizes a function name (or a synonym of a function name) in user-provided voice data, the data in the command function entry having the phonetic representation of the recognized function name (or a synonym of the function name) is used to cause the controlling device to transmit a command communication to a target appliance. (*Id.*)

Challenged Claims 1 and 12 of the '083 patent expressly require that the claimed phonetic representations of the function name and the synonyms of the function name be stored in a very precise location within the controlling device. (*Id.*) Not only must the phonetic representations be stored in a specific codeset record (*i.e.*, the codeset record provided to the controlling device for use in commanding functional operations of the target appliance and comprising protocol and formatting information and a plurality of command function entries), but they must also be stored in a specific location within the specific codeset record (*i.e.*, in each of the command function entries within the provided codeset record). (*Id.*)

B. The Level Of Ordinary Skill In The Art.

For the purposes of this preliminary response only, Patent Owner adopts Petitioner's proposed level of ordinary skill in the art. (Petition at 19.)

C. Petitioner's Asserted Prior Art References.

1. U.S. Patent No. 8,995,981 ("Aginsky")

Aginsky is generally directed to "systems and methods in which a controllable device transfers to [a] remote device, such as to a remote control application ('app') located on a smartphone, a data structure identifying various functions that can be controlled by [the] remote device, together with the identity of the signal type that will achieve the desired operation." (EX1004, Aginsky, at Abstract.) "The remote device, upon accepting input directly from the remote device, can then allow the remote device user to select how controls of the various functions are to be

configured and presented to, or otherwise selectively arranged for a user on a user interface of the remote device.” (*Id.*)

Aginsky discloses that a data structure may identify information such as exemplary functions (*e.g.*, on-off, menu, volume, channel, and input) and exemplary command signals (*e.g.*, XY1, XY2, XX1, ZZZ, and XY3). (*Id.* at 8:21-28.) The command signals “denote the type of signal as well as the code or code sequence of the signal.” (*Id.* at 9:9-10.) The command signals cause a function to be carried out when transmitted from the remote device 107-1 to a controllable device 101-1. (*Id.* at 8:28-30.) The data structure may also identify “the appearance, arrangement, and/or assignment of function controls (*e.g.*, left, center, right, button, up, down, button, arrow, one-click, two-click, key word) for a specific function of a controllable device, and an associated status (*e.g.*, on or off).” (*Id.* at 9:24-28.) Aginsky discloses that the memory 109-1 of the remote device 107-1 stores multiple data structures. (*See, e.g., id.* at 2:44-46 (“Small data files also enable the remote device to store many different data structures”); *see also id.* at 7:58-64.)

Aginsky generally discloses that the remote device 107-1 is capable of voice control (*id.* at 6:1-6, 8:8-12, 9:61-65), but, Aginsky ***does not*** disclose, teach, or suggest that its data structures include any information relating to voice control technology or how any such data structures are constructed. (*See generally id.* at 7:58-10:2.)

2. U.S. Patent No. 6,839,670 (“Stammler”)

Stammler is generally directed to “a process for automatic control of one or several devices by speech commands or by speech dialog in real-time operation.” (EX1005, Stammler, at 1:12-14.) Stammler’s system “permits a speech command input or speech dialog control that is for the most part adapted to the natural way of speaking, and that an extensive vocabulary of admissible commands is made available to the speaker for this.” (*Id.* at 2:61-65.) “The extensive vocabulary is used to increase the user friendliness by using synonymous words or different variations in the pronunciation.” (*Id.* at 6:8-10.)

3. U.S. Patent App. Pub. No. 2012/0271639 (“Hanson”)

Hanson is generally directed to “a solution for permitting automated speech command discovery via manual event to function mapping.” (EX1006, Hanson, at [0008].) “In the solution, a manual event (e.g., manually performed operation) within a computing system can be mapped to a function within a speech interface.” (*Id.*) “The mapping can trigger speech command discovery via one or more customizable rulesets” such as “using a grammar tree, utterance length, text strings, and the like.” (*Id.*) The mapping can support synonyms and/or alternative commands for a function. (*Id.* at [0037].) In one example of Hanson’s method, “when a user opens a car window via toggling an electronic power window switch,

a speech interface can audibly present an appropriate voice activated command to the user.” (*Id.* at [0018].)

4. U.S. Patent App. Pub. No. 2003/0103088 (“Dresti”)

Dresti “relates generally to hand-held electronic devices and, more particularly, relates to a user interface for an universal remote control application resident on the hand-held electronic device.” (EX1007, Dresti, at [0002].) The user interface “functions to display[] operational mode information to a user.” (*Id.* at Abstract.) “The graphical user interface may be used, for example, to setup the remote control application to control appliances for one or more users in one or more rooms, to perform activities, and to access favorites.” (*Id.*)

III. LEGAL STANDARDS

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petition would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

In an *Inter Partes* Review, the Petitioner bears the burden of persuasion to prove unpatentability by a preponderance of the evidence. *See Dynamic Drinkware, LLC v. Natl. Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015). To establish a *prima facie* case of obviousness, the petitioner must show “how the prior art

references, either alone or in combination, teach or suggest the claimed invention.” See *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993); see also *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017) (petitioner must persuasively explain how the references would be combined to arrive at the claimed invention). The petitioner must also demonstrate “that a skilled artisan would have had reason to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.” *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Pat. Litig.*, 676 F.3d 1063, 1068-69 (Fed. Cir. 2012); see also *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018) (holding that a finding of obviousness requires a showing “that a person of ordinary skill would have selected and combined and modified the subject matter of the references in the manner of the claimed invention, with a reasonable expectation of success.”).

IV. CLAIM CONSTRUCTION

Petitioner asserts that “[n]o terms require construction at this time.” (Petition at 20.) For the purposes of this preliminary response only, Patent Owner agrees with Petitioner. Patent Owner reserves the right to propose constructions for any terms of the Challenged Claims of the ‘083 patent should the Board elect to institute review.

V. PETITIONER HAS FAILED TO SHOW THAT THERE IS A REASONABLE LIKELIHOOD THAT THE CHALLENGED CLAIMS OF THE '083 PATENT ARE UNPATENTABLE.

A. Ground 1: Petitioner Has Failed To Show That There Is A Reasonable Likelihood That Aginsky In View Of Stammler Renders Challenged Claims 1-6, 8-10, And 12-18 Obvious.

1. Petitioner Has Failed To Show That The Combination Of Aginsky With Stammler Discloses, Teaches, Or Suggests Every Limitation Of Challenged Claims 1-6, 8-10, And 12-18.

(a) Petitioner Has Failed To Show That Aginsky, Alone, Or In Combination With Stammler, Discloses, Teaches, Or Suggests “wherein each of the plurality of individual function entries within the codeset record comprises ... data which comprises a phonetic representation of a function name corresponding to the standard function identifier, and a plurality of data each of which comprises a phonetic representation of a unique one of a plurality of synonyms of the function name” (“Phonetic Representations Limitation”).

Petitioner has failed to show that Aginsky, alone, or in combination with Stammler, discloses, teaches, or suggests the Phonetic Representations Limitation of Challenged Claims 1 and 12.

According to the Phonetic Representations Limitation, each of the plurality of individual command function entries within the claimed codeset record must comprise, *inter alia*:

(i) *a phonetic representation of a function name*; and

(ii) *phonetic representations of a plurality of synonyms of the function name*. (EX1001, '083 patent, at claims 1, 12.)

According to the Phonetic Representations Limitation, the claimed phonetic representations ***must also be stored:***

(i) ***in a specific codeset record*** (i.e., the codeset record provisioned to the controlling device for use in commanding functional operations of the target appliance and comprising protocol and formatting information and a plurality of command function entries); and

(ii) ***in a specific location within that specific codeset record*** (i.e., in each of the command function entries within the provisioned codeset record). (*Id.*)

Petitioner reads the claimed codeset record on either of the data structures in tables 115' and 116' of FIG. 1B of Aginsky. (Petition at 21-23, 35, 37.) Petitioner also asserts that each row in tables 115' and 116' represents an individual command function entry. (*Id.* at 27, 37-38.)

Petitioner asserts that Aginsky's remote device 107-1 is generally capable of voice control (*id.* at 40 (citing EX1004, Aginsky, at 6:2-6, 8:8-12, 9:60-65)), but concedes that Aginsky alone does not disclose, teach, or suggest the Phonetic Representations Limitation. (*Id.* at 40, 42; *see also id.* at 20-29 (Petitioner failing to assert that Aginsky's data structures include any information relating to voice commands); *see generally* EX1004, Aginsky, at 7:58-10:2 (Aginsky failing to disclose, teach, or suggest that its data structures include any information relating to voice commands).) Thus, Petitioner relies on a modification of Aginsky in view of

Stammler for the Phonetic Representations Limitation. (Petition at 40-42 (“Aginsky as modified by Stammler...”).)¹

Petitioner has failed to show that Aginsky in combination with Stammler discloses, teaches, or suggests the Phonetic Representations Limitation because Petitioner’s proposed modification of Aginsky ***does not disclose, teach, or suggest the Phonetic Representations Limitation.***

As noted above, the Phonetic Representations Limitation expressly requires that the claimed phonetic representations be stored ***in a specific codeset record*** (*i.e.*, the codeset record provisioned to the controlling device for use in commanding functional operations of the target appliance and comprising protocol information

¹ Petitioner states elsewhere in the Petition that Aginsky “by itself” teaches a “phonetic representation” within its data structure(s). (Petition at 42.) Petitioner’s statement is unsupported and is inconsistent with the disclosure of Aginsky and Petitioner’s assertions and admissions to the contrary. In any case, as discussed in detail below, even if Aginsky did teach a “phonetic representation” within its data structure(s) (it does not), that teaching would be insufficient to meet the Phonetic Representations Limitation because the Phonetic Representations Limitation requires far more than merely placing a single “phonetic representation” in an unspecified location of an unspecified data structure.

and formatting information and a plurality of command function entries), and ***in a specific location within that specific codeset record*** (*i.e.*, in each of the command function entries within the provisioned codeset record). (EX1001, '083 patent, at claims 1, 12.)

The Petition broadly asserts that a POSITA would have modified Aginsky in view of Stammer to include phonetic representations in an unspecified location in one of Aginsky's unspecified data structures. (*See, e.g.*, Petition at 32 ("POSITA would have been motivated to modify Aginsky with the teachings of Stammer to include phonetic representations and synonyms as elements of Aginsky's dataset");² *id.* at 40 ("it would have been obvious to modify the data structure to include phonetic representations"); *id.* at 42 ("It would have been obvious to a POSITA to apply Stammer's teachings of using synonyms, and phonetic representations thereof, in Aginsky's systems and methods...").) Notably, Petitioner fails to specify ***which data structure*** it proposes adding phonetic representations to, and ***where in this unspecified data structure*** it proposes storing the phonetic representations. (*Id.*

² Petitioner uses the terms "dataset" and "data structure" interchangeably. (*See, e.g.*, Petition at 70.)

at 32, 40, 42.) Thus, Petitioner cannot show that its proposed modification of Aginsky discloses, teaches, or suggests the Phonetic Representations Limitation.³

Petitioner's failure to specify which data structure of Aginsky it proposes adding phonetic representations to is particularly problematic for Petitioner because Aginsky's remote device stores **multiple data structures** in memory (Petition at 57; EX1004, Aginsky, at 2:44-46 ("Small data files also enable the remote device to store many different data structures")), but Petitioner reads the claimed codeset record on only Aginsky's data structures 115' and 116' in FIG. 1B (Petition at 35).

Because (i) Aginsky alone indisputably does not disclose, teach, or suggest the Phonetic Representations Limitation; and (ii) Petitioner's proposed modification to Aginsky is insufficient to meet the Phonetic Representations Limitation, Petitioner cannot show that Aginsky alone or in combination with Stammiller discloses, teaches, or suggests the Phonetic Representations Limitation. For the

³ To the extent the Petition also proposes the same modification in view of Aginsky alone (*see* Petition at 40), the proposed modification fails to disclose, teach, or suggest the Phonetic Representations Limitation for the same reasons discussed above.

same reasons, Petitioner has also failed to explain how the references would be combined to arrive at the claimed invention. *See Metalcraft*, 848 F.3d at 1367.

(b) Petitioner Has Failed To Show That Aginsky, Alone, Or In Combination With Stammler, Discloses, Teaches, Or Suggests “a speech recognition engine.”

Petitioner has also failed to show that Aginsky, alone, or in combination with Stammler, discloses, teaches, or suggests “a speech recognition engine.” Independent Challenged Claims 1 and 12 both recite providing voice data to a “speech recognition engine.” (EX1001, ‘083 patent, at claims 1 and 12.)

Petitioner does not assert that Aginsky discloses, teaches, or suggests a “speech recognition engine.” (Petition at 45-46; *see also id.* at 51 (“Aginsky does not explicitly disclose how remote device 107-1 receives voice input or creating voice data.”).)

While Petitioner asserts that Stammler discloses a “speech recognition engine,” Petitioner does not propose modifying Aginsky to have a “speech recognition engine.” (*Id.* at 45-46; *see also id.* at 32 (Petitioner only proposing to modify Aginsky in view of Stammler to include phonetic representations in Aginsky’s data structure).) Petitioner’s failure to identify any reason why a POSITA would have modified Aginsky to have a “speech recognition engine” further confirms that Petitioner has not proposed modifying Aginsky to have a “speech recognition engine.” (*Id.* at 45-46; *see also* EX1003, ¶¶ 149-151.)

Because Aginsky, alone, does not disclose, teach, or suggest a “speech recognition engine,” and because Petitioner has not proposed modifying Aginsky to include a “speech recognition engine,” Petitioner cannot show that Aginsky, alone, or in combination with Stammler, discloses, teaches, or suggests “a speech recognition engine.” For the same reasons, Petitioner has also failed to explain how the references would be combined to arrive at the claimed invention. *See Metalcraft*, 848 F.3d at 1367.

(c) Petitioner Has Failed To Show That Aginsky Discloses, Teaches, Or Suggests “the provisioned codeset record comprising protocol and formatting information.”

Petitioner has failed to show that Aginsky discloses, teaches, or suggests “the provisioned codeset record comprising protocol and formatting information.”⁴

Challenged Claims 1 and 12 recite that the codeset record provided to the controlling device must comprise protocol and formatting information. (EX1001, ‘083 patent, at claims 1 and 12.)

The Challenged Claims are clear that both the claimed (i) protocol information and (ii) formatting information *must be in the claimed codeset record itself*. (*Id.*; *see also id.* at FIG. 7b.)

⁴ Petitioner relies solely on Aginsky for the limitation “the provisioned codeset record comprising protocol and formatting information.” (Petition at 36-37.)

Petitioner asserts that Aginsky's data structures 115' and 116' (*i.e.*, the alleged codeset records) include "SIGNAL columns 112-1 and 112-2" that "denote the type of signal" to send to a controllable device for control purposes (*e.g.*, a frequency set, a coded IR signal, or a Bluetooth signal). (Petition at 36-37 (citing EX1004, Aginsky, at 8:63-9:10); *see also id.* at 25.) According to Petitioner, a POSITA would have understood that Aginsky's example signal types (*i.e.*, frequency set, IR, and Bluetooth) "require protocol and formatting information." (Petition at 37.)

Petitioner has failed to show that Aginsky discloses, teaches, or suggests "the provisioned codeset record comprising protocol and formatting information" because Petitioner fails to present any evidence that Aginsky ***stores both protocol information and formatting information in the alleged codeset record itself.*** (Petition at 37.) That protocol and formatting information may be required to transmit Aginsky's example signal types from the remote is not the same thing as what the claim requires, namely, storing the claimed protocol information and formatting information in the codeset record itself.⁵

⁵ While Petitioner asserts that Aginsky discloses the types of protocol and formatting data described in the '083 patent (*i.e.*, frequency and device address and identification), the cited portion of Aginsky makes no mention of any of this information. (Petition at 26 (citing EX1004, Aginsky, at 9:7-10).) Regardless,

Thus, Petitioner has failed to show that Aginsky discloses, teaches, or suggests “the provisioned codeset record comprising protocol and formatting information.”

2. Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Aginsky With Stammler To Arrive At The Claimed Invention Of The ‘083 Patent.

Petitioner has also failed to show that there is a reasonable likelihood that Aginsky in view of Stammler renders Challenged Claims 1-6, 8-10, and 12-18 obvious because Petitioner has failed to show that a POSITA would have been motivated to combine Aginsky with Stammler to arrive at the claimed invention of the ‘083 patent.

In an obviousness analysis, the petitioner must demonstrate that a POSITA would have been motivated to pick out the references relied upon and combine them in the manner claimed. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-94 (Fed. Cir. 2017). It is not enough to merely show that a POSITA, “once presented with the two references, would have understood that they *could be* combined.” *Id.* at 993 (emphasis in original).

whether Aginsky generally discusses protocol information and formatting information (it does not), has no bearing on whether these types of information are stored in the codeset record itself, as claimed.

(a) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Aginsky With Stammler To Arrive At The “speech recognition engine.”

Petitioner has failed to identify *any reason* why a POSITA would have modified Aginsky to have a “speech recognition engine.” (Petition at 45-46; *see also* EX1003, ¶¶ 149-151.)

Thus, the Board should hold that Petitioner has failed to establish that there is a reasonable likelihood that Aginsky in view of Stammler renders Challenged Claims 1-6, 8-10, and 12-18 unpatentable for this reason alone. *See In re Cyclobenzaprine*, 676 F.3d at 1068-69 (holding that a petition must demonstrate “that a skilled artisan would have had reason to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.”)

(b) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Aginsky With Stammler To Arrive At The Phonetic Representations Limitation.

The claimed invention of the ‘083 patent requires that phonetic representations of a function name and synonyms of the function name be stored *in a specific codeset record* (*i.e.*, the codeset record provisioned to the controlling device for use in commanding functional operations of the target appliance and comprising protocol and formatting information and a plurality of command

function entries), and *in a specific location within that specific codeset record* (i.e., in each of the command function entries within the provisioned codeset record). (EX1001, '083 patent, at claims 1, 12.)

As discussed above, Petitioner has failed to demonstrate that Aginsky in combination with Stammmler discloses, teaches, or suggests the claimed invention at least because Petitioner has failed to specify *which data structure* of Aginsky it proposes adding phonetic representations to and *where in this unspecified data structure* it proposes storing the phonetic representations. (Petition at 32, 40, 42.)

But even if Petitioner had proposed modifying Aginsky to add phonetic representations to the data structures that Petitioner relies on for the claimed codeset record (i.e., either of the data structures in tables 115'-116') and to each of the alleged command function entries within those data structures (Petitioner has not done so), Petitioner has still failed to identify any reasons why a POSITA would have been motivated to make the specific modifications to Aginsky that would have been needed to arrive at the claimed invention.

According to Petitioner, a POSITA would have been motivated to modify Aginsky in view of Stammmler to arrive at the Phonetic Representations Limitation: (i) to enable voice control in general, which was purportedly a known replacement for the alleged drawbacks of user interfaces (Petition at 32-33; *see also id.* at 40 ("such that voice command is enabled"), 41 ("to enable voice commands")); and (ii)

to take advantage of Stammer's larger, expanded vocabulary to improve upon prior speech dialog systems that allegedly suffered from limited vocabularies, which would purportedly have improved command recognition accuracy and user friendliness (*id.* at 32; *see also id.* at 33 ("the use of numerous different voice commands"), 41 ("responsive to a variety of voice command inputs"), 42 ("allow a user to use alternate words or phrases").)

However, Petitioner's asserted reasons for modifying Aginsky in view of Stammer fail to explain why a POSITA would have modified Aginsky ***in the specific manner of the claimed invention***. For example, Petitioner fails to explain why a POSITA would have added phonetic representations to the specific data structures that Petitioner relies on its obviousness analysis (*i.e.*, either of the data structures in tables 115'-116'), as opposed to different data structures in the controlling device's memory, some construct in the controlling device's memory other than a data structure, or to a different device altogether (*e.g.*, to a remote server). (Petition at 31-33, 40-42.) Similarly, Petitioner fails to explain why a POSITA would have specifically added phonetic representations to each of the alleged command function entries in these data structures, as opposed to some other location in the data structures, to only a subset of the alleged command function entries, etc. (*Id.*)

Put simply, Petitioner's asserted reasons for modifying Aginsky in view of Stammler are nothing more than generic reasons for adding voice control support and synonym support to Aginsky in general, which cannot support a finding of obviousness *as a matter of law*. See *ActiveVideo Networks, Inc. v. Verizon Commun., Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) ("testimony [that] is generic and bears no relation to any specific combination of prior art elements" is insufficient); *Toyota Motor Corp. v. General Electric Co.*, Case IPR2019-00018, Paper 7 at 15 (PTAB May 7, 2019) (denying institution of review where petitioner's expert's testimony "merely provide[d] generic reasons for adding another converter in Mitsutani's hybrid vehicle 100, but not specifically for connecting Mitsutani's AC power generator to the DC/DC converter via port 4 in Robinson."). Adding voice control support to Aginsky is also a legally insufficient reason to combine because, as Petitioner admits, Aginsky already discloses voice control support (Petition at 3, 18, 25), and the Federal Circuit has held that a POSITA would not be motivated to modify a prior art reference to add a feature the reference already has. See, e.g., *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1332 (Fed. Cir. 2019); *In re Anova Hrg. Labs, Inc.*, 809 Fed. Appx. 840, 843 (Fed. Cir. 2020).

Petitioner's failure to explain why a POSITA would have added phonetic representations to the specific data structures that Petitioner reads the claimed codeset record on—as opposed to some other data structure in the controlling

device's memory or to a different device altogether, such as a remote server—is particularly problematic for Petitioner because (i) Petitioner admits that Aginsky's alleged controlling device stores *multiple data structures* in memory (Petition at 57; *see also* EX1004, Aginsky, at 2:44-46); and (ii) Petitioner asserts that it would have been obvious—indeed preferable—to execute Aginsky's speech recognition capabilities on a remote server instead of on Aginsky's controlling device (Petition at 53-54).

Accordingly, Petitioner has failed to show that a POSITA would have been motivated to combine Aginsky with Stammler to arrive at the claimed invention of the '083 patent. *See, e.g., Avail Medsystems, Inc. v. Teladoc Health, Inc.*, Case IPR2022-00444, Paper 10 at 28-29 (PTAB July 21, 2022) (denying institution of review where the evidence in the petition merely demonstrated that the Wang and King references could be combined in some way, but did not “demonstrate a rationale for combining the references in the manner claimed because it [did] not imply a motivation to select the articulating boom King discloses to couple a second camera to the mobile robot 12 Wang discloses.”).

B. Ground 2: Petitioner Has Failed To Show That There Is A Reasonable Likelihood That Aginsky In View Of Stammler And Dresti Renders Challenged Claims 7, 11, And 19 Obvious.

Petitioner has failed to meet its burden of showing that Aginsky in combination with Stammler and Dresti renders Challenged Claims 7, 11, and 19

obvious. Challenged Claims 7 and 11 and Challenged Claim 19 depend from Challenged Claims 1 and 12, respectively, and thus incorporate each and every limitation of Challenged Claims 1 and 12. *See* 35 U.S.C. § 112(d).

As discussed above, Petitioner has failed to meet its burden of showing that Aginsky in combination with Stammeler renders Challenged Claims 1 and 12 obvious. Thus, for all the same reasons, Petitioner has failed to meet its burden of showing that Aginsky in combination with Stammeler and Dresti renders Challenged Claims 7, 11, and 19 obvious.

C. Ground 3: Petitioner Has Failed To Show That There Is A Reasonable Likelihood That Aginsky In View Of Hanson Renders Challenged Claims 1-6, 8-10, And 12-18 Obvious.

1. Petitioner Has Failed To Show That The Combination Of Aginsky With Hanson Discloses, Teaches, Or Suggests Every Element Of Challenged Claims 1-6, 8-10, And 12-18.

(a) Petitioner Has Failed To Show That Aginsky, Alone, Or In Combination With Hanson, Discloses, Teaches, Or Suggests The Phonetic Representations Limitation.

As noted above, Aginsky alone indisputably does not disclose, teach, or suggest the Phonetic Representations Limitation. (Petition at 40, 42; *see also id.* at 73-75; *see generally* EX1004, Aginsky, at 7:58-10:2.) Petitioner has also failed to show that Aginsky in combination with Hanson discloses, teaches, or suggests the Phonetic Representations Limitation because Petitioner's proposed modification of Aginsky *still does not disclose, teach, or suggest the Phonetic Representations Limitation.*

The Phonetic Representations Limitation expressly requires that the claimed phonetic representations be stored *in a specific codeset record* (i.e., the codeset record provisioned to the controlling device for use in commanding functional operations of the target appliance and comprising protocol and formatting information and a plurality of command function entries), and *in a specific location within that specific codeset record* (i.e., in each of the command function entries within the provisioned codeset record). (EX1001, '083 patent, at claims 1, 12.)

The Petition broadly asserts that a POSITA would have added Hanson's "synonymous command teachings" or "phonetic representations and synonyms" to an unspecified location in one of Aginsky's unspecified data structures. (Petition at 69-70.) Tellingly, Petitioner has failed to propose *any* particular modification to Aginsky. In several instances, Petitioner vaguely asserts that a POSITA would have applied Hanson's "teachings" to Aginsky's "device" or "systems." (See, e.g., Petition at 70, 72, 74.) Petitioner fails to specify *which data structure* it proposes adding Hanson's phonetic representations to, and *where in this unspecified data structure* it proposes storing the phonetic representations. (*Id.*) Thus, Petitioner cannot show that its proposed modification of Aginsky discloses, teaches, or suggests the Phonetic Representations Limitation.

Again, Petitioner's failure to specify which data structure of Aginsky it proposes adding Hanson's phonetic representations to is problematic for Petitioner

because Aginsky's remote device admittedly stores *multiple data structures* in memory (Petition at 57; *see also* EX1004, Aginsky, at 2:44-46), but Petitioner reads the claimed codeset record on only Aginsky's data structures 115' and 116' in FIG. 1B (Petition at 35).

Because (i) Aginsky alone indisputably does not disclose, teach, or suggest the Phonetic Representations Limitation; and (ii) Petitioner's proposed modification to Aginsky is insufficient to meet the Phonetic Representations Limitation, Petitioner cannot show that Aginsky alone or in combination with Hanson discloses, teaches, or suggests the Phonetic Representations Limitation. For the same reasons, Petitioner has also failed to explain how the references would be combined to arrive at the claimed invention. *See Metalcraft*, 848 F.3d at 1367.

(b) Petitioner Has Failed To Show That Aginsky, Alone, Or In Combination With Hanson, Discloses, Teaches, Or Suggests “a speech recognition engine.”

Petitioner has also failed to show that Aginsky, alone, or in combination with Hanson, discloses, teaches, or suggests the claimed “speech recognition engine.”

As noted above, Petitioner does not assert that Aginsky discloses, teaches, or suggests a “speech recognition engine.” (Petition at 75-76; *see also id.* at 51 (“Aginsky does not explicitly disclose how remote device 107-1 receives voice input or creating voice data.”).) While Petitioner asserts that Hanson discloses a “speech recognition engine,” Petitioner does not propose modifying Aginsky to have a

“speech recognition engine.” (*Id.*; *see also id.* at 69-70 (Petitioner proposing only to modify Aginsky in view of Hanson to include phonetic representations in Aginsky’s “data set” or “data structure”).) Again, Petitioner’s failure to identify any reason why a POSITA would have modified Aginsky to have a “speech recognition engine” further confirms that Petitioner has not proposed modifying Aginsky to have a “speech recognition engine.” (*Id.* at 69-70, 75-76.)

Because Aginsky alone does not disclose, teach, or suggest a “speech recognition engine,” and because Petitioner has not proposed modifying Aginsky to include a “speech recognition engine,” Petitioner cannot show that Aginsky, alone, or in combination with Hanson, discloses, teaches, or suggests “a speech recognition engine.” For the same reasons, Petitioner has also failed to explain how the references would be combined to arrive at the claimed invention. *See Metalcraft*, 848 F.3d at 1367.

(c) Petitioner Has Failed To Show That Aginsky Discloses, Teaches, Or Suggests “the provisioned codeset record comprising protocol and formatting information.”

Petitioner failed to show in Ground 1 that Aginsky discloses, teaches, or suggests “the provisioned codeset record comprising protocol and formatting information.” In Ground 3, Petitioner relies entirely on its Ground 1 analysis for this limitation. (Petition at 71.) Thus, for the reasons discussed above regarding Ground 1, Petitioner has again failed to show that Aginsky discloses, teaches, or suggests

“the provisioned codeset record comprising protocol and formatting information” in Ground 3.

2. Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Aginsky With Hanson To Arrive At The Claimed Invention Of The ‘083 Patent.

Petitioner has also failed to show that there is a reasonable likelihood that Aginsky in view of Hanson renders Challenged Claims 1-6, 8-10, and 12-18 obvious because Petitioner has failed to show that a POSITA would have been motivated to combine Aginsky with Hanson to arrive at the claimed invention of the ‘083 patent.

(a) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Aginsky With Hanson To Arrive At The “speech recognition engine”

Petitioner has failed to identify *any reason* why a POSITA would have modified Aginsky to have a “speech recognition engine.” (Petition at 69-70, 75-76.) Thus, the Board should hold that Petitioner has failed to establish that there is a reasonable likelihood that Aginsky in view of Hanson renders Challenged Claims 1-6, 8-10, and 12-18 unpatentable for this reason alone. *See In re Cyclobenzaprine*, 676 F.3d at 1068-69 (holding that a petition must demonstrate “that a skilled artisan would have had reason to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.”).

(b) Petitioner Has Failed To Show That A POSITA Would Have Been Motivated To Combine Aginsky With Hanson To Arrive At The Phonetic Representations Limitation.

The claimed invention of the '083 patent requires that phonetic representations of a function name and synonyms of the function name must be stored *in a specific codeset record* (*i.e.*, the codeset record provisioned to the controlling device for use in commanding functional operations of the target appliance and comprising protocol and formatting information and a plurality of command function entries), and *in a specific location within that specific codeset record* (*i.e.*, in each of the command function entries within the provisioned codeset record). (EX1001, '083 patent, at claims 1, 12.)

As discussed above, Petitioner has failed to demonstrate that Aginsky in combination with Hanson discloses, teaches, or suggests the claimed invention at least because Petitioner has failed to specify *which data structure* of Aginsky it proposes adding phonetic representations to and *where in this unspecified data structure* it proposes storing the phonetic representations. (Petition at 69-70, 73-75.) But even if Petitioner had proposed modifying Aginsky to add phonetic representations to the specific data structures that Petitioner relies on for the claimed codeset record (*i.e.*, either of the data structures in tables 115'-116') and to each of the alleged command function entries within those data structures (Petitioner has not

done so), Petitioner has failed to identify any reasons why a POSITA would have been motivated to make these specific modifications to Aginsky.

In the Petition, Petitioner asserts that a POSITA would have been motivated to modify Aginsky in view of Hanson to arrive at the Phonetic Representations Limitation: (i) to achieve a voice control system that executes a command in response to a variety of synonymous commands, which purportedly would have increased user friendliness (Petition at 70, 75, 77; *see also id.* at 72 (“to enable recognition of numerous phrases related to the same command”)); (ii) because “implementing a data set with phonetic representations and synonyms” would have been “the mere application of a known technique” (*id.* at 70); and (iii) “to achieve the predictable result of using phonetic representations to process voice commands” (*id.* at 74).

However, as with Ground 1, Petitioner’s asserted reasons for modifying Aginsky in view of Hanson fail to explain why a POSITA would have modified Aginsky ***in the specific manner of the claimed invention***. Again, Petitioner fails to explain why a POSITA would have added Hanson’s phonetic representations to the specific data structures that Petitioner reads on the claimed codeset record (*i.e.*, either of the data structures in tables 115’-116’), as opposed to different data structures in the controlling device’s memory, some construct in the controlling device’s memory other than a data structure, or to a different device altogether (*e.g.*,

to a remote server). (Petition at 69-70, 73-75.) Similarly, Petitioner fails to explain why a POSITA would have specifically added Hanson's phonetic representations to each of the alleged command function entries in these data structures, as opposed to some other location in the data structures, to only a subset of the alleged command function entries, etc. (*Id.*) Put simply, Petitioner's asserted reasons for modifying Aginsky amount to nothing more than generic reasons for adding synonym support to Aginsky in general, which cannot support a finding of obviousness *as a matter of law*. See *ActiveVideo Networks*, 694 F.3d at 1328; *Toyota Motor Corp.*, Case IPR2019-00018, Paper 7 at 15. "[A]chiev[ing] the predictable result of using phonetic representations" is also a legally insufficient reason to combine because it merely repeats the proposed modification to Aginsky (*i.e.*, adding phonetic representations to Aginsky), fails to explain why a POSITA would have made such a modification, and does not result in the claimed invention. Similarly, whether "implementing a data set with phonetic representations and synonyms" was purportedly a "known technique" cannot support a finding of a motivation to combine because merely demonstrating that something was known in the art is insufficient. See *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1369 (Fed. Cir. 2012).

Additionally, as discussed above, Petitioner's failure to explain why a POSITA would have added Hanson's phonetic representations to the specific data structures that Petitioner reads the claimed codeset record on—as opposed to some other data structure in the controlling device's memory or to a different device altogether, such as a remote server—is particularly problematic for Petitioner because (i) Petitioner admits that Aginsky's alleged controlling device stores *multiple data structures* in memory (Petition at 57; *see also* EX1004, Aginsky, at 2:44-46); and (ii) Petitioner asserts that it would have been obvious—indeed preferable—to execute Aginsky's speech recognition capabilities on a remote server instead of on Aginsky's controlling device (Petition at 53-54).

Accordingly, Petitioner has failed to show that a POSITA would have been motivated to combine Aginsky with Hanson to arrive at the claimed invention of the '083 patent.

D. Ground 4: Petitioner Has Failed To Show That There Is A Reasonable Likelihood That Aginsky In View Of Hanson And Dresti Renders Challenged Claims 7, 11, And 19 Obvious.

Petitioner has failed to meet its burden of showing that Aginsky in combination with Hanson and Dresti renders Challenged Claims 7, 11, and 19 obvious. Challenged Claims 7 and 11 and Challenged Claim 19 depend from Challenged Claims 1 and 12, respectively, and thus incorporate each and every limitation of Challenged Claims 1 and 12. *See* 35 U.S.C. § 112(d). As discussed

above, Petitioner has failed to meet its burden of showing that Aginsky in combination with Hanson renders Challenged Claims 1 and 12 obvious. Thus, for all the same reasons, Petitioner has failed to meet its burden of showing that Aginsky in combination with Hanson and Dresti renders Challenged Claims 7, 11, and 19 obvious.

E. Petitioner Failed To Support Its Petition With The Testimony Of A POSITA.

Petitioner has also failed to show that there is a reasonable likelihood that any of the Challenged Claims of the '083 are unpatentable because Petitioner has failed to support its Petition with the testimony of a POSITA.

The Federal Circuit has held that it is an abuse of discretion to admit expert testimony “on any issue that is analyzed through the lens of an ordinarily skilled artisan” (e.g., invalidity) where the expert “does not have ordinary skill in the art.” *Kyocera Senco Indus. Tools Inc. v. Intl. Trade Commn.*, 22 F.4th 1369, 1377-78 (Fed. Cir. 2022). Claims are properly held valid where the party asserting invalidity fails to offer testimony from one of skill in the art. *See Creative Compounds, LLC v. Starmark Laboratories*, 651 F.3d 1303, 1313-14 (Fed. Cir. 2011) (citing *Schumer v. Laboratory Computer Systems, Inc.*, 308 F.3d 1304, 1315 (Fed. Cir. 2002)).

Here, Petitioner asserts that a POSITA “would have had a bachelor’s degree in computer science, in electrical engineering, or a related field, and approximately *three years of experience or equivalent study in voice-controlled devices in*

universal remote controlled systems.” (Petition at 19 (emphasis added).) However, Petitioner’s expert has failed to demonstrate that he has at least “three years of experience or equivalent study in voice-controlled devices in universal remote controlled systems,” and thus has failed to demonstrate that he has ordinary skill in the art under Petitioner’s definition of a POSITA. (*See generally* Ex-1003, ¶¶ 5-11.)

Petitioner’s expert ***makes no mention*** of universal remote controls in either the “Background and Qualifications” section of his declaration or in his CV. (*See id.*; *see also id.* at pp. 197-211 (expert’s CV).) Further, Petitioner’s expert has failed to establish that he has at least three years of experience in voice-controlled devices ***of any kind***. (*See, e.g., id.*, ¶ 9 (Petitioner’s expert stating that he worked on “the voice control features for the AT&T 3450 mobile cellular phone” for an unspecified period of time).) At best, Petitioner’s expert provides the conclusory, unsupported statement that his “level of skill in the art was at least that of a person of ordinary skill.” (Ex-1003, ¶ 30.) But such conclusory testimony is not entitled to consideration. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Accordingly, Petitioner has failed to establish that its expert has ordinary skill in the art, Petitioner’s expert’s opinions are inadmissible, and Petitioner has failed to support its Petition with the requisite testimony of a POSITA. *See Kyocera*, 22 F.4th at 1377-78.

VI. CONCLUSION

Accordingly, for at least the foregoing reasons, Patent Owner respectfully requests that the Board refuse to institute an *inter partes* review because Petitioner has failed to establish a reasonable likelihood that any of the Challenged Claims of the '083 patent will be found unpatentable.

Dated: December 28, 2022

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This paper complies with the requirements of 37 C.F.R. § 42.24 and contains 8,392 words (exclusive of the table of contents, the table of exhibits, the certificate of service, and this certification).

This paper complies with the typeface requirements of 37 C.F.R. § 42.6 and has been prepared in 14 point Times New Roman proportionally spaced typeface with normal spacing.

Respectfully submitted,

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