

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSAL REMOTE CONTROL, INC.,

Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,

Patent Owner.

Case IPR2014-01146
Patent 8,243,207 B2

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

CAPP, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

Petitioner Universal Remote Control, Inc. filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 12–15 of U.S. Patent No. 8,243,207 B2 (Ex. 1001, the “’207 patent”). We issued a Decision to Institute an *inter partes* review of claims 13–15 of the ’207 patent. Paper 9 (“DI”). After institution of trial, Patent Owner Universal Electronics, Inc. filed a Patent Owner’s Response (Paper 16, “PO Resp.”) and Petitioner filed a Petitioner’s Reply (Paper 22, “Reply”). We have jurisdiction under 35 U.S.C. § 318(a).

The instant case came before the Board for a regularly scheduled oral hearing on the merits on September 2, 2015, the transcript of which is entered as Paper 35 (“Tr.”). Also before the Board is Petitioner’s Motion to Exclude. Papers 26, 30, and 32.

After considering the evidence and arguments of counsel and for the reasons set forth below, we determine that Petitioner has not met its burden of showing, by a preponderance of the evidence, that claims 13–15 of the ’207 patent are unpatentable.

Related Proceedings

Petitioner states that claims 13-15 of the ’207 patent are involved in *Universal Electronics Inc., v. Universal Remote Control, Inc.*, No. SACV 13-00984 AG (C.D. Cal.).

I. BACKGROUND

A. The ’207 Patent (Ex. 1001)

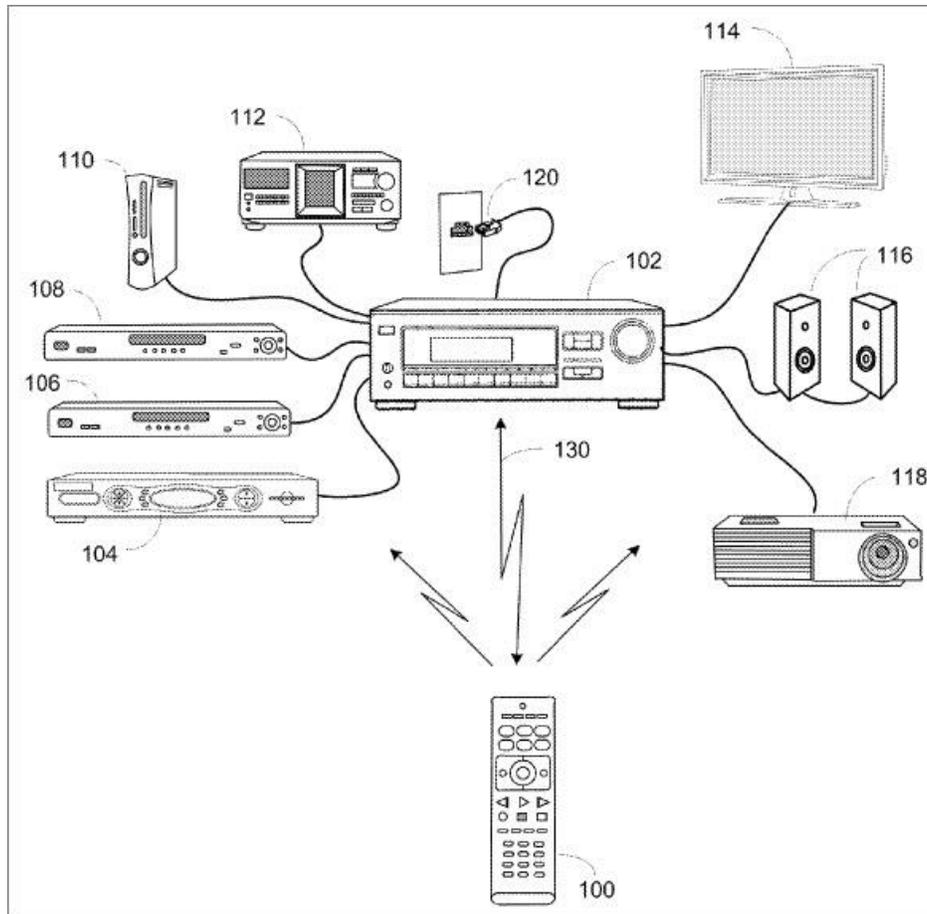
The ’207 patent, titled System and Method for Activity Based Configuration of an Entertainment System, relates to methods for configuring multi-input and/or multi-output home entertainment systems. Ex. 1001, 1:31–33. The invention routes the outputs and inputs of the

various components of an audio/visual (“AV”) system through one central device, such as an AV receiver, that is referred to generically as the “entertainment device.” *Id.* at Abstract, 1:34–36, 9:17–22, claim 13.

A personal computer is used to generate activity configuration settings. *Id.* at 8:19–67. The user then downloads configuration data from the personal computer to the entertainment device. *Id.* at 9:1–8. Activity configuration parameters are stored in memory of the entertainment device for future use in configuration of the home entertainment system when an indicated activity is requested. *Id.* at 6:39–41. The stored configuration is associated with a command value corresponding to an activity key on a remote control device. *Id.* at 6:41–43. Thereafter, the entertainment device serves as a central switching point for content streams in a home entertainment system. *Id.* at 9:13–49.

After a configuration is downloaded to or otherwise stored on the entertainment device, the invention contemplates sending a signal from a universal remote control device to the entertainment device in order to initiate a pre-defined configuration of the home entertainment system. *Id.* at 1:37–45. In addition to the control signals sent to the central entertainment device, the invention also contemplates sending control signals to other appliances in the home entertainment system. *Id.* at 1:45–50. These signals to the other appliances can be transmitted directly from the remote control to the other appliances or indirectly by a signal transmitted from the remote to the central entertainment device, which, in turn, transmits control signals to the other appliances. *Id.* Thus, activation of a device mode key may cause the transmission of data to the central entertainment device to cause the entertainment device to select one of multiple possible sources and/or

destinations. *Id.* at 9:44–49. This feature takes advantage of the fact that the entertainment device has access to appliance status information not available to the remote control device and the remote control device, in turn, has access to appliance command functions not available to the entertainment device. *Id.* at 1:49–57. Figure 1 of the '207 patent is shown below.



'207 Patent – Figure 1

Figure 1 illustrates an AV system in which the outputs of source appliances such as set top box 104, first DVD player 106, second DVD player 108, game console 110, and CD changer 112 are all connected as inputs to an AV receiver or “entertainment device” 102. *Id.* at 2:27–32. AV receiver 102 (the entertainment device) switches the input stream to designated outputs which are connected to various home entertainment

system devices such as TV 114, projector 118, and/or speakers 116. *Id.* at 2:33–38. Also illustrated is a universal remote control or “controlling device” 100 that transmits commands to the appliances. *Id.* at 2:44–46.

B. Illustrative Claim

We instituted a trial on Petitioner’s challenge to claims 13–15. DI 20. Claim 13, reproduced below, is an independent claim:

13. A method for configuring an audio visual entertainment device in communication with a plurality of devices for an activity, comprising:

associating a command value corresponding to an activity key of a controlling device with a configuration of the entertainment device, the configuration of the entertainment device comprising at least one of the plurality of devices being used as an audio visual input source device for the entertainment device and at least one of the plurality of devices being used as an audio visual output destination device for the entertainment device; and

causing the entertainment device to access and use the configuration associated with the command value corresponding to the activity key of the controlling device in response to the entertainment device receiving from the controlling device a signal which includes the command value corresponding to the activity key of the controlling device;

wherein the configuration of the entertainment device is downloaded into the entertainment device from a computing device in communication with the entertainment device and

wherein a configuration of the controlling device in which an activation of one or more command keys of the controlling device will cause the controlling device to communicate commands to the one or more of the audio visual source device and the audio visual output destination device is downloaded into the controlling device from a computing device in communication with the controlling device.

C. The Asserted Grounds of Unpatentability

Petitioner challenges claims 13–15 of the '207 patent under 35 U.S.C. § 102 as anticipated by U.S. Patent Pub. 2003/0120831 A1, published June 26, 2003 (Dubil). Ex. 1005. Petitioner supports its position with declaration testimony from James T. Geier. Ex. 1003.

II. MOTION TO EXCLUDE EVIDENCE

Petitioner moves to exclude deposition testimony from Patent Owner's expert, Mr. Cook, elicited on re-direct examination. Paper 26, 1. Petitioner objects to counsel's redirect examination of Mr. Cook as constituting leading questions. Paper 26, 1. Patent Owner opposes the motion. Paper 30. Petitioner filed a reply to Patent Owner's opposition. Paper 32.

During re-direct examination, counsel for Patent Owner asked its own expert witness, Mr. Cook, three questions. Ex. 1054, 727:14-16; 727:24-728:1; and 728:9–10. Counsel did not ask open ended questions designed to elicit a narrative description or explanation. *Id.* Rather, the questions were phrased narrowly so as to elicit either a "yes" or "no" answer. *Id.*

The admissibility of evidence in an IPR proceeding generally is governed by the Federal Rules of Evidence. *See* 37 C.F.R. § 42.62(a), *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48758. Under Federal Rule of Evidence 611(c), leading questions should not be used on the direct examination of a witness except as may be necessary to develop the witness' testimony. "A leading question is one that suggests to the witness the answer desired by the examiner." McCormick, EVIDENCE § 6 (7th ed. 2013). Questions that begin, "Isn't it true that" or "Don't you agree that" typically suggest the answer and are leading. Other types of questions, such

as questions that call merely for a yes or no answer or that ask the witness to choose between alternatives posed by the questioner, may or may not be leading, depending on the context in which the question is asked, the tone of voice employed, and the body language or conduct of counsel. *See, e.g., United States v. Warf*, 529 F.2d 1170, 1174 (5th Cir. 1976) (prosecutor improperly led witness to make identification by pointing at the accused).

Patent Owner argues that none of the questions posed by counsel gave Mr. Cook an indication of the desired answer. Paper 30, 3. In reply, Petitioner points to contextual cues in the questions that it asserts suggest an answer. Paper 32, 2–3.¹

The re-direct examination of Mr. Cook took place by deposition outside of our presence. We did not have an opportunity to view the demeanor of the witness or counsel. Neither did we have an opportunity to observe any non-verbal cues such as tone of voice, gestures, or other body language of interrogating counsel. Nevertheless, we can observe from the overall context of the questions whether counsel was leading Mr. Cook. We agree with Petitioner that counsel’s questions, while nominally phrased to elicit either a “yes” or “no” answer, also contained contextual cues sufficient to suggest the answer that counsel desired to elicit. The three questions that were asked of Mr. Cook on re-direct examination are impermissible leading questions under Federal Rule of Evidence 611. We GRANT Petitioner’s motion to exclude the re-direct examination of Mr. Cook.

¹ First question - “setting a VCR timer” Ex. 1054, 727:14;
Second question - “explicitly state” *Id.* at 727:24; and
Third question - “Does Dubil teach or suggest *any way* that . . .” *Id.* at 728:9–10 (emphasis added).

III. CLAIM INTERPRETATION

In an *inter partes* review, claims are given their broadest reasonable interpretation consistent with the specification. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015). Within this framework, terms generally are given their ordinary and customary meaning, as understood by a person of ordinary skill in the art, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007), citing *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

1. “device” versus “appliance” (Claim 13)²

In our Decision to Institute, we construed these terms such that when the claims refer to either devices or appliances that serve as either input sources or output destinations that are connected to the entertainment device, these terms are used interchangeably in the Specification and the claims and we construed them as having the same meaning. DI 6–7. The parties have not brought anything to our attention to cause us to modify this construction for purposes of the final written decision.

2. “entertainment device” (Claims 13 and 14)

The Specification states:

While described in the context of an AV receiver acting a central switching point for content streams in a home entertainment system, it will be appreciated that any other suitably equipped device, for example an advanced cable or satellite STB, a personal computer, etc., may be substituted for an AV receiver in the practice of the instant invention.

² The term “appliance” appears in claim 12. Ex. 1001, claim 12. Claim 12 was challenged in the Petition, however, we did not institute a trial as to claim 12. DI.

Ex. 1001, 9:17–22. Consistent with the foregoing disclosure, in our Decision to Institute, we construed “entertainment device” to encompass AV receivers and substantially similar devices that are capable of being connected to a plurality of AV input sources and a plurality of AV output destinations. DI 7. Neither party argues for a different construction in their respective Patent Owner’s Response and Petitioner’s Reply.

3. “*activity key*” (Claims 13 and 14)

In the Decision to Institute, we adopted Patent Owner’s proposed construction: “a key that, upon activation, transmits a signal to an entertainment device that corresponds to a previously defined configuration for an activity.” DI 8–9.

In its Reply, Petitioner states that our construction in the Decision to Institute is narrower than necessary. Reply 2. Petitioner does not otherwise argue for a different construction in its Reply. We maintain our construction of this term for the reasons set forth in our Decision to Institute.

4. “*configuration of the entertainment device*” (Claims 13 and 14)

Petitioner’s proposed construction:

an indication of an input device to and an output device from the entertainment device.

Reply 4.

Patent Owner’s proposed construction:

requires transmission of a signal to the entertainment device such that the configuration thereof contemplates affirmatively selecting an AV input source and an AV output destination and affirmatively performing switching actions accordingly.

PO Resp. 10.

Neither party proposed a construction of this term in their respective Petition or Preliminary Response. In our Decision to Institute, we noted that these terms are susceptible to more than one construction. DI 9–10. In the absence of receiving proposed constructions from either party, we construed “configuration of the entertainment device,” on a preliminary basis, as encompassing home entertainment system configurations that do not require active switching between input sources and output destinations at the entertainment device. *Id.*

Petitioner argues that our Decision to Institute acknowledged that there are two reasonable interpretations and our governing rules necessarily require *de facto* adoption of the broader interpretation. Pet. 3. We reject this argument. *See Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) (even under the broadest reasonable interpretation, the Board's construction cannot be divorced from the specification and the record evidence). In our Decision to Institute, we gave a relatively broad construction, on a preliminary basis, to provide the parties with an opportunity to propose their own constructions and brief the issue with support from the record, including intrinsic evidence in the Specification. DI 10. We indicated that our interim construction did not foreclose us from using a different construction at a later point in the proceeding upon the development of a more complete record. *Id.* at 10 n.6.³

Petitioner argues that Patent Owner's construction improperly imports additional limitations into the claim. Reply 6–7. Petitioner challenges Patent Owner's reliance on selected passages of the Specification as

³ Although we suggested two possible constructions in our Decision to Institute, both possibilities were preliminary in nature and we are not constrained to adopt either of them for purposes of this final decision.

supporting Patent Owner’s claim construction, arguing that such passages relate to embodiments of the invention that are merely exemplary. *Id.* Petitioner argues that including “affirmatively performing switching actions” in the construction is not present in the claim language as written. *Id.* Petitioner also argues that Patent Owner’s construction improperly imports “transmission of a signal” into the claim and that transmission of a signal is not required by the claim language. *Id.*

Patent Owner argues that the Specification supports a construction that requires active switching in the entertainment device. PO Resp. 7-9, citing Ex. 1001, 2:27–37; 1:34–42; 4:63–5:3. Patent Owner relies on testimony from Mr. Cook stating that the entertainment device must implement switching functionality in some manner. Ex. 2029 ¶¶ 38–46.

Extrinsic evidence in the form of expert testimony can be useful to a court for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field. *See Phillips*, 415 F.3d at 1318. However, conclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court. *Id.* The Federal Circuit cautions us to discount expert testimony that is at odds with the written record of the patent. *Id.* The Federal Circuit cautions us that extrinsic evidence in general is less reliable than the patent and its prosecution history in determining how to read claim terms. *Id.* Expert testimony is generated at the time of and for the purpose of litigation and thus can suffer from bias that is not present in intrinsic evidence. *Id.* We

have reviewed Mr. Cook's testimony at paragraphs 38–46 of his declaration and find it unhelpful in construing this term. Thus, our claim construction analysis will focus primarily on the intrinsic record before us.

A claim construction analysis begins with, and is centered on, the claim language itself. *See Interactive Gift Express, Inc. v. Compuserve, Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001). In the instant case, claim 13 is directed to a method for configuring an entertainment device. Ex. 1001, claim 13. Claim 13 differentiates between a configuration “*of the entertainment device*” and a configuration “*of the controlling device.*” *Id.* While the claim language is used in the context of an entertainment system that includes an entertainment device in communication with a plurality of devices, there is no explicit mention of a configuration *of the entertainment system* as a whole. *Id.* In the first step, the method associates a command value of a controlling device activity key with a *configuration of the entertainment device*. *Id.* Such configuration includes at least one input device and at least one output device. *Id.* In the second step of the method, the *configuration* is accessed and used by the entertainment device. *Id.* The third step of the method specifies that the *configuration of the entertainment device* is downloaded *into the entertainment device* from a computing device. *Id.*

Similarly, claim 14 is directed to a method of configuring an entertainment device. *Id.*, claim 14. In the first step, the entertainment device receives a *configuration request* signal that includes a controlling device activity key command value. *Id.* In the second step, there is an association between the command value and a *configuration of the entertainment device*. *Id.* The configuration includes at least one input

device and at least one output device. *Id.* In the third step, the entertainment device *accesses and uses* the configuration. *Id.*

The “ordinary and customary meaning of a claim term” is that meaning that a person of ordinary skill in the art in question, at the time of the invention, would have understood the claim to mean. *See Translogic Tech.*, 504 F.3d at 1257; *Phillips*, 415 F.3d at 1313. Claims should be read in light of the specification and teachings in the underlying patent. *See Proxyconn*, 789 F.3d at 1298.⁴

In the instant case, the Specification discloses that activation of an activity key on the controlling device results in transmission of a signal to the entertainment device to “initiate certain previously defined configuration actions.” Ex. 1001, 1:40–43. The entertainment device includes a control processor 400 coupled to a memory 402. *Id.* at 4:51–56. The memory stores executable instructions to control operation of the entertainment device. *Id.* at 5:19–23. The processor 400 may be programmed to cause routing of signals between various inputs and outputs. *Id.* at 5:23–27.

Furthermore, the Specification discloses a method whereby a personal computer may be used to generate command values and associated configuration choices. Ex. 1001, 8:19–67. After such activity on the personal computer is completed, the “resulting configuration data” is downloaded into the entertainment device. *Id.* at 9:1–8.

⁴ The PTO also should consult the patent’s prosecution history in proceedings in which the patent has been brought back to the agency for a second review. *Id.* Although Petitioner filed the prosecution history in the record (Ex. 1002), neither party cites to the prosecution history in their respective claim construction briefing.

Thus, as “*configuration of the entertainment device*” is used in the Specification and the claims, it is an entity or construct that can be “downloaded” from a personal computer to an entertainment device. Ex. 1001, claim 13. It is similarly a construct or entity that can be “access[ed] and use[d].” *Id.* Furthermore, the “configuration” pertains to the entertainment device, as opposed to the controlling device or audio/visual entertainment system as a whole. Finally, the term “*configuration of the entertainment device*” appears to be used interchangeably with “configuration data.” *See id.* at 9:2.

Judges are free to consult dictionaries at any time when construing claim terms so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1585 n.6 (Fed. Cir. 1996). The plain English language dictionary meaning of “configuration” is “the arrangement of the parts of something.”⁵ In the context of computer science, it refers to the particular choice of hardware items and their interconnection that makes up a particular computer system.⁶

Under the common English language definition, a *configuration of the entertainment system*, as a whole, would refer to the arrangement and interconnection of the entertainment device with its various input source and output destination devices. Similarly, a *configuration of the entertainment device* would refer to an arrangement internal to the entertainment device that would allow the entertainment device to connect to and communicate with input and output devices.

⁵ <http://www.thefreedictionary.com/configuration> (last accessed November 27, 2015).

⁶ *Id.*

However, as the term is used in the Specification, *configuration of the entertainment device* can assume one of two possible meanings. On the one hand, it can refer to the state or condition of the entertainment device *after* it has been configured. In other words, after the entertainment device has been configured, it would exhibit a *configuration of the entertainment device*. However, the Specification admits of another possible meaning. The Specification teaches that a personal computer is used to generate command values and associated configuration choices after which the “resulting configuration data” is downloaded to the entertainment device. Ex. 1001, 8:19–9: 8. Thereafter, “the entertainment device *accesses and uses the configuration associated with the command value* corresponding to the activity key of the controlling device.” *Id.*, Abstract (emphasis added). The entertainment device can “access and use” such configuration, in part, because it has memory that stores executable instructions that are intended to control the operation of the entertainment device. *Id.* at 4:19–30.

Thus, before it is physically “configured,” the entertainment device stores executable instructions in memory to control the various electronic components within the entertainment device.

Once all user selections have been made, at step **512** the activity configuration parameters may be finalized and stored in AV receiver memory **402** *for future use in configuring the home entertainment system* when the indicated activity is called for, e.g., *the final configuration is stored* and associated with the received key command value corresponding to the activity key that was activated at the start of the configuration process. *Id.* at 6:36–43 (emphasis added). In other words, *after* the entertainment device is configured, it exhibits a *configuration of the entertainment device*. However, *before* it is configured, the entertainment device stores in memory

executable instructions and data (“*the final configuration*”) that is associated with an activity key command. *Id.* at 6:41. It stores the configuration information “for future use.” *Id.* at 6:39. The entertainment device then later accesses and “uses” the configuration. *Id.*, Abstract. The memory in the entertainment device may store a plurality of sets of such executable instructions, each set of which also may be considered to be a *configuration of the entertainment device*. *Id.* at 5:43–48 (“various activities”).

As between the foregoing two possibilities, we think the latter construction is the correct one. The claims indicate that a *configuration of the entertainment device* is a construct that can be “downloaded” from a computer. *Id.*, claim 13. It is also a construct that can be “access[ed] and use[d]” in association with a controlling device activity key command value. *Id.* These attributes are more consistent with a set of executable instructions and data that is stored in memory than a physical state or configuration of the entertainment device after it has been configured. *Id.* at 6:38 (“finalized and stored”); 6:41 (“stored and associated”).

In view of the foregoing we construe *configuration of the entertainment device* in claims 13 and 14 as referring to information stored in memory in the entertainment device that can be accessed and used to configure the entertainment device.

IV. ANTICIPATION BY DUBIL

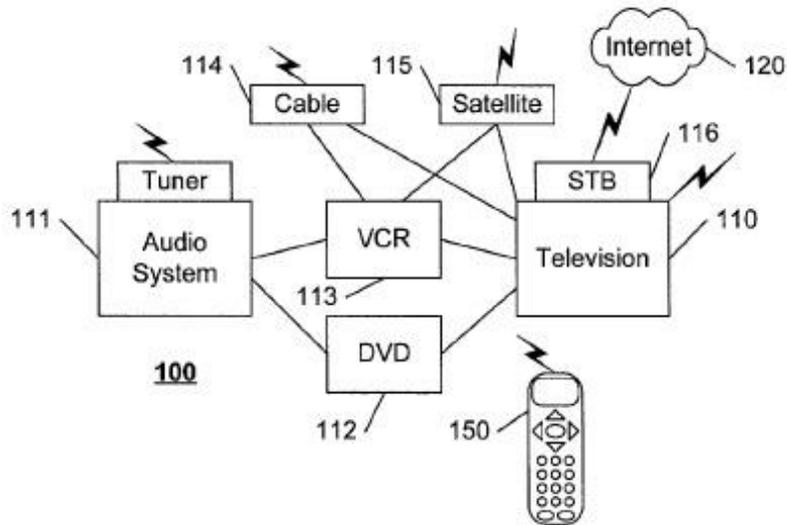
To anticipate a patent claim under 35 U.S.C. § 102, “a reference must describe . . . each and every claim limitation and enable one of skill in the art to practice an embodiment of the claimed invention without undue experimentation.” *Am. Calcar, Inc. v. Am. Honda Motor Corp.*, 651 F.3d

1318, 1341 (Fed. Cir. 2011) (citing *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009)). Anticipation [of a patent claim] is a question of fact. See *In re Montgomery*, 677 F.3d 1375, 1379 (Fed. Cir. 2012).

Whether a patent is anticipated is a two-step inquiry. *Power Mosfet Tech., LLC. v. Siemens AG*, 378 F.3d 1396, 1407 (Fed. Cir. 2004). The first step requires construction of the claims. See *id.* The second step in the analysis requires a comparison of the properly construed claim to the prior art. See *id.* As the party challenging the patentability of claims 13–15, Petitioner bears the burden of proving anticipation by a preponderance of the evidence. See 35 U.S.C. § 316(e).

A. *Dubil* (Exhibit 1005)

Dubil discloses a remote control device that provides commands based on the configuration of components in an AV system. Ex. 1005, Abstract. One embodiment of *Dubil* is illustrated in Figure 1 below.



In Figure 1, system 100 includes television 110, audio system 111, DVD player 112, VCR 113, cable interface 114, satellite receiver 115, and set-top box 116. Ex. 1005 ¶ 17. Remote control device 150 provides for

remote control of some or all of the components 110–116. In operation, the system 100 may receive audio-video information from satellite receiver 115 and provide the video to television 110 and the audio to audio amplifier 111. *Id.* At another point in time, system 100 may provide audio-video information from VCR 113, and provide both the video and the audio information to television 110. *Id.*

Dubil identifies the components of the system. *Id.* ¶ 18. An “activity set” associates select system functions to particular components to support a particular user activity. *Id.* Thus, although multiple components of a system may include an audio output signal, an activity set identifies which particular component in the system provides the audio output of the system. *Id.*

Figures 2A and 2B of Dubil are shown below.

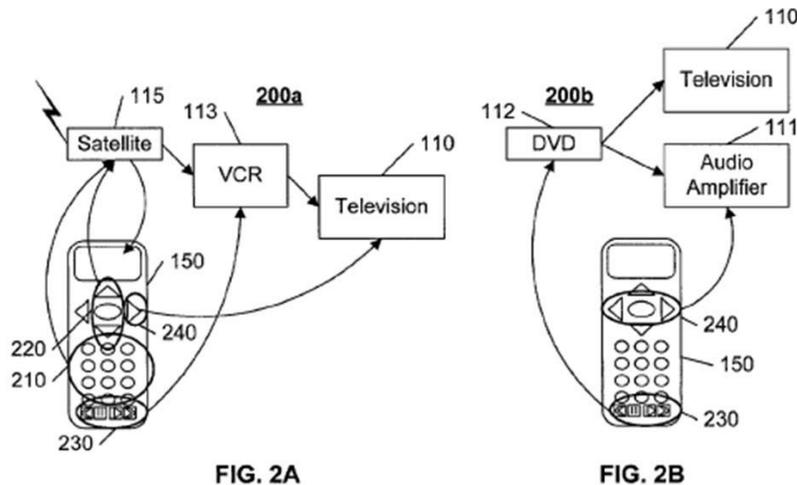
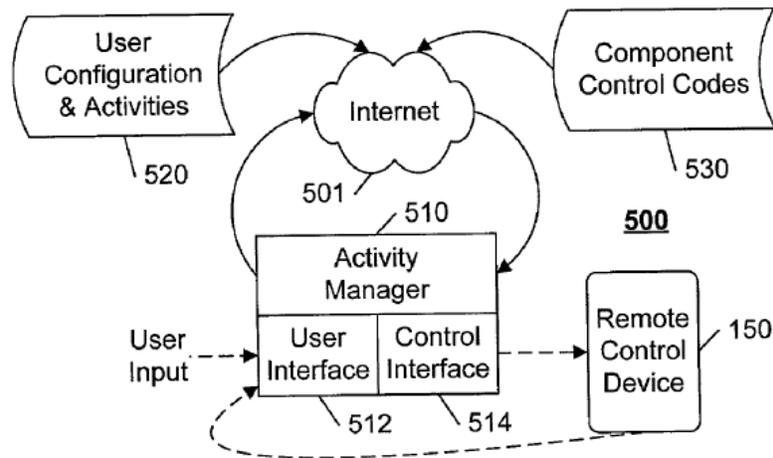


Figure 2A illustrates an activity set 200a for satellite broadcasts. *Id.* ¶ 19. Satellite receiver 115 provides AV information to VCR 113 which then provides AV information to the television 110. *Id.* Alternatively, the system may be configured as illustrated in Figure 2B to view a DVD movie. *Id.* ¶ 20. In this activity, DVD player 112 is the source of the AV

information. *Id.* DVD player 112 provides the video information to television 110, and the audio information to audio amplifier 111.

Dubil discloses an activity manager 510 that has access to a database of user configurations and activity sets 520 and a database of control codes 530. *Id.* ¶ 30. The activity manager 510 is illustrated in Figure 5 of Dubil shown below.



As shown in Figure 5, Dubil's activity manager 510 receives user input, via a user interface 512, and provides control codes to a remote control device 150 via control interface 514. *Id.* ¶ 30. The database disclosed in paragraph 30 may be distributed among a variety of storage devices and storage systems. *Id.*

The user interface 512 includes two types of user input processing, namely: (1) creating an activity set; and (2) invoking an activity set. *Id.* ¶ 31. The user invokes an activity set by selecting keys on the remote control device 150 or by using a menu that is presented on a display device. *Id.* Based on such selection input, the activity manager 510 accesses the database of user activity sets 520 to determine which component functions are being mapped to which keys on the remote control device 150. *Id.* The activity set manager 510 accesses the component control code database 530

to determine the code that the remote control device requires for the selected activity set. *Id.* If the activity set 520 includes a preset list or similar command construct, the activity set manager 510 processes the preset list and provides the appropriate commands to the remote control device 150 to effect the commands on the list.

In the system depicted in Figure 5, each device (510–530) is connected to the internet. *Id.* ¶ 37. A third party vendor may provide an internet-based application program for creating the user configuration and activity sets 520. *Id.* The command codes corresponding to each activity set may be downloaded to a storage device at the user location, such as a set-top box that is configured to provide the activity set codes to the remote control device 150 on demand. Alternatively, the remote control device 150 may be configured to store a plurality of sets of compiled command codes, corresponding to each of a plurality of user activity sets. *Id.*

B. Analysis of Claim 13

Petitioner alleges that Dubil anticipates claim 13. Pet. 25–29. Petitioner supports its allegations with declaration testimony from Mr. Geier. *Id.*, Ex. 1003 ¶¶ 43–48. Petitioner identifies Dubil’s VCR 113 as corresponding to the entertainment device of claim 13. Pet. 25. Among other things, Petitioner contends that a person of ordinary skill in the art would have understood that, in order to provide video and audio information to the television, VCR 113 must inherently access and use the configuration associated with the sent command value. *Id.* at 27–28. Petitioner further alleges that Dubil, at paragraph 34, discloses downloading a configuration from a personal computer. *Id.* at 28.

Patent Owner first argues that Dubil does not anticipate claim 13, because it does not “associate a command value corresponding to an activity key of a controlling device with a configuration of the entertainment device.” PO Resp. 12–13. Patent Owner argues that Dubil does not disclose this element explicitly and that Patent Owner has failed to make out a proper case that this limitation is met inherently. *Id.* Patent Owner’s argument is in two parts. First, Patent Owner argues that Dubil does not associate a command value with an activity key. PO Resp. 15. This argument is not persuasive. Dubil states that: “[e]ach user activity has a corresponding mapping of keys on the remote control device to facilitate the user activity.” Ex. 1005 ¶ 9. A person of ordinary skill in the art would have understood that pressing an activity key on Dubil’s remote control would result in the transmission of a signal that contains a command value associated with the activity key that was pressed.

The second part of Patent Owner’s first argument is that pressing a Dubil activity key does not associate a command value with a “configuration of the entertainment device” as claimed. PO Resp. 15. Patent Owner argues that pressing a Dubil activity key merely transmits a set of commands to various home entertainment system components. *Id.* Patent Owner argues that this occurs without associating an activity key command value with a configuration of the entertainment device. *Id.* at 16.

In reply, Petitioner argues that Patent Owner’s position is premised on an incorrect claim construction. Reply 9. Petitioner further argues that Dubil illustrates exemplary activity sets in which the source and destination devices are indicated for a desired activity. *Id.* Petitioner points out that the “Watch TV” activity may either use the cable interface or satellite receiver

as the input device and either the television or surround sound as the audio output device. *Id.* Petitioner observes Dubil's VCR 113 is the only component that is connected to all of these input and output devices. *Id.* Petitioner deduces, from this disclosure, that Dubil's VCR 113 actively selects between input devices and actively selects between output devices. *Id.* Petitioner is supported in its deduction by declaration testimony from Mr. Geier. Ex. 1055 ¶ 25.

We are not persuaded by Petitioner's argument or evidence. Petitioner's conclusion does not follow logically and necessarily from Petitioner's underlying premises. The system configuration described by Petitioner just as easily could be accomplished by sending on/off commands to the various input and output components so that the desired input device is powered on and the non-desired input device is powered off. The same can be said of the output devices. Thus, the entertainment system, as a whole, can be configured by sending power on/off commands to various devices and then passively routing the input and output signals through the VCR. Petitioner cites to no explicit disclosure in Dubil where the VCR actively switches between a plurality of inputs and a plurality outputs. We have reviewed Dubil and find no such explicit disclosure. Neither do we find that Dubil discloses active switching of the VCR inherently. While it may be possible that the VCR could switch between sources and destinations, we are not persuaded that such functionality is necessarily present in Dubil for it to operate. Inherency may not be established by probabilities or possibilities. *See Agilent Tech., Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1383 (Fed. Cir. 2009). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

Furthermore, Dubil cannot associate a remote control activity key command value with a *configuration of the entertainment device* unless Dubil first possesses a *configuration of the entertainment device* within the meaning of claim 13. We are not persuaded that Dubil discloses a “*configuration of the entertainment device*” as we have construed the term. Petitioner’s evidence and argument focuses on Dubil’s entertainment system as a whole. However, “*configuration of the entertainment device,*” as it is used in claim 13, refers to a set of executable instructions and data stored in memory in the entertainment device that is first downloaded from a personal computer and is then accessed and used after the entertainment device receives a signal from the remote control that contains a command value that is associated with such configuration. Petitioner provides no persuasive evidence that Dubil’s VCR has memory that stores executable instructions and data in the form of a “*configuration of the entertainment device*” that is downloaded from a computer and is accessed and used as claimed.

Patent Owner next argues that Dubil fails to satisfy the “access and use” limitation in claim 13. Petitioner argues against this position by attempting to point out that Dubil’s VCR 113 selects input and output devices for the activity prompted by activation of an activity key. Reply 12. Petitioner concludes that, since activation of an activity key invokes an activity set, and the activity set is stored and retrieved, the limitation is met. Reply 12, Ex. 1055 ¶ 26. This argument is not persuasive.

Dubil’s remote control has one or more activity keys. Ex. 1005 ¶ 9. When the user identifies a preferred activity, the remote control communicates commands to each system component corresponding to the activity. *Id.* The remote control also is configured so that different control

functions for various devices are mapped to keys on the remote control. *Id.* ¶ 21. For example, if the user desires to watch a satellite TV broadcast, the user presses the “watch/record satellite broadcast” activity key on the remote control. *Id.* The remote control is then configured to associate the channel up and down keys with the satellite receiver, the scanning keys (e.g., fast-forward) with the VCR, and the volume controls to the television. *Id.* Configuring a remote control by mapping keys on the remote control to components of a home entertainment system is not the same as storing a *configuration of the entertainment device* in the entertainment device and then accessing and using the configuration by transmitting a command value from the remote control.

Dubil also discloses that a collection of data may be distributed among a variety of storage devices. *Id.* ¶ 30. Such storage devices may be a TIVO or a set-top box. *Id.* ¶¶ 19, 37. However, Dubil merely discloses that command codes corresponding to activity sets are stored on or downloaded to a device that is configured to “provide the compiled code to the remote control device **150** on demand.” *Id.* ¶ 37.⁷ Dubil does not disclose storing activity set information in the VCR (Dubil’s “entertainment device”). Moreover, Dubil does not disclose storing, in the entertainment device (VCR 113), a *configuration of the entertainment device* comprised of a set of executable instructions stored in memory in the entertainment device and that is accessed and used to configure the internal components of the entertainment device in response to receipt of a signal with a command value corresponding to such configuration. In summary, at most, Dubil

⁷ Alternatively, the activity set information may be stored directly on the remote control device 150. *Id.*

discloses storing activity set information on a device that is configured to provide activity set information (compiled code) *to the remote control device*. It does not disclose storing, in the entertainment device, executable instructions to configure the internal components of the entertainment device and then accessing and using such executable instructions as required by claim 13.

Patent Owner also argues that Dubil fails to disclose the limitation in claim 13 directed to downloading the configuration of the entertainment device into the entertainment device from a computing device. PO Resp. 18. Petitioner argues that Dubil discloses the use of a personal computer to collect information regarding the configuration of the user's equipment and creates one or more data sets that can be downloaded to the equipment. Reply 12–13. Petitioner argues that the term “user's equipment” in Dubil does not exclude VCR 113. *Id.* at 13. Petitioner further argues that VCRs are programmable and may be used to store instruction information. *Id.* Petitioner further argues that Dubil does not require that configuration information be stored in any particular component. *Id.* Based on the foregoing, Petitioner concludes that Dubil teaches downloading the configuration to the VCR. *Id.* We disagree.

Dubil discloses that a user may use a personal computer to interface with a configuration application program. Ex. 1005 ¶ 34. The application program collects information from the user regarding the configuration of the user's equipment and then creates one or more data sets that can be downloaded “to the equipment” to effect the configuration. *Id.* The activity manager 510 compiles the activity set into the appropriate set of command codes and stores the corresponding set of command codes with each activity

set, so that the codes are immediately available when the user invokes an activity set. *Id.* ¶ 36. The activity set command codes may be stored on an internet site or downloaded to a storage device at the user's location, such as a set-top box. *Id.* ¶ 37. Such storage device is configured to provide the activity set codes to the remote control device. *Id.* We are not persuaded that the foregoing satisfies the "download" limitation of claim 13.

There is no explicit disclosure in Dubil that VCR 113 functions as the "storage device at the user location" as identified in paragraph 37 of Dubil. The mere possibility that it might function as a storage device is insufficient to establish anticipation either explicitly or inherently. *See Agilent Tech.*, 567 F.3d at 1383. Furthermore, the information that is downloaded and stored in Dubil relates to compiled command codes for activity sets, not a *configuration of the entertainment device* as required by claim 13. The information that is downloaded and stored in Dubil's storage device is provided to the remote control device on demand. Ex. 1005 ¶ 37. This is different from the limitation in claim 13 where a *configuration of the entertainment device* is downloaded into the entertainment device from a computing device where it can be accessed and used by the entertainment device to configure its internal components in response to receipt of a signal from the remote control containing an associated command value. Ex. 1001, claim 13.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Inasmuch as Dubil fails to disclose all elements of claim 13, we find that Petitioner has

failed to establish, by a preponderance of the evidence, that Dubil anticipates claim 13.

C. Analysis of Claim 14

Claim 14 is an independent claim that is substantially similar in scope to claim 13, except that it lacks a limitation directed to downloading a configuration of the entertainment device into the entertainment device from a computing device. Ex. 1001, claims 13, 14. Petitioner alleges that Dubil anticipates claim 14. Pet. 29–34. Petitioner supports its allegations with declaration testimony from Mr. Geier. *Id.*, Ex. 1003 ¶¶ 49–52.

Like claim 13, claim 14 also contains a limitation directed to a *configuration of the entertainment device* and, more particularly, associating an activity key command value with a configuration of the entertainment device. *Id.* claim 14. In disputing whether this limitation of claim 14 is met, the parties rely on the same arguments and evidence that we have considered previously with respect to claim 13. PO Resp. 20; Reply 13–14. We resolve this dispute in Patent Owner’s favor for essentially the same reasons discussed above with respect to claim 13.

Claim 14 also contains a limitation directed to causing the entertainment device to “access and use” the configuration associated with a command value. Ex. 1001, claim 14. We find that Dubil fails to disclose this limitation for essentially the same reasons discussed above with respect to claim 13.

We have considered Petitioner’s other arguments with respect to the anticipation of claim 14, but we need not resolve those issues in view of our determination that at least the two limitations discussed above are not

satisfied by Dubil. We find that Petitioner has failed to establish, by a preponderance of the evidence, that Dubil anticipates claim 14.

D. Analysis of Claim 15

Claim 15 depends from claim 14 and adds a limitation directed to causing the entertainment device a graphical user interface for allowing a user to select a device to be used in the configuration for the entertainment device. Ex. 1001, claim 15. Because claim 14 is not anticipated, claim 15 is not anticipated. *See Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296 (Fed.Cir. 2002).

IV. ORDER

In view of the foregoing, it is ORDERED that claims 13–15 of U.S. Patent 8,243,207 B2 have not been shown to be unpatentable as anticipated by Dubil.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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