

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

In re Patent of: Dresti et al.

Patent No.: 7,831,930

Filed: Nov. 6, 2002

Issued: Nov. 9, 2010

Assignee: Universal Electronics Inc.

Title: SYSTEM AND METHOD FOR
DISPLAYING A USER INTERFACE
FOR A REMOTE CONTROL
APPLICATION

Petition for *Inter Partes* Review under
35 U.S.C. §§ 311–319
and 37 C.F.R. § 42.100 et seq.

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,831,930

TABLE OF CONTENTS

EXHIBIT LIST iv

I. MANDATORY NOTICES1

A. Real Party-In-Interest1

B. Related Matters.....1

C. Lead and Back-Up Counsel2

D. Service Information3

II. PAYMENT OF FEES3

III. REQUIREMENTS FOR *INTER PARTES* REVIEW4

A. Grounds For Standing.....4

B. Identification of Challenge.....4

1. Claims for which *inter partes* review is requested.....4

2. The specific art and statutory grounds on which the challenge is based4

3. How the challenged claims are to be construed6

4. How the construed claims are unpatentable under the statutory grounds identified in 37 C.F.R. § 42.104(b)(2) .6

5. Supporting evidence relied upon to support the challenge.....6

IV. SUMMARY OF THE '930 PATENT7

A. Summary of the Prosecution History of the '930 patent.....9

V. DETAILED CLAIM CONSTRUCTION10

VI. THERE IS A REASONABLE LIKELIHOOD THAT AT LEAST ONE CLAIM OF THE '930 PATENT IS UNPATENTABLE12

A. Claim 1 is obvious over Realistic in view of Evans.....12

B. Claim 1 is obvious over ProntoEdit in view of Realistic14

VII. DETAILED EXPLANATION OF HOW THE CHALLENGED CLAIMS ARE UNPATENTABLE	15
A. Summary of Prior Art	15
1. Realistic Universal Remote Control Owner’s Manual Cat. No. 15-1903 (Realistic - Exhibit 1003)	15
2. U.S. Patent No. 4,825,200 (“Evans,” Exhibit 1004)	17
3. ProntoEdit User Guide (“ProntoEdit,” Exhibit 1005) ..	19
B. Detailed Grounds for Unpatentability Arguments.....	21
1. Ground 1: Claim 1 is unpatentable as obvious over Realistic in view of Evans under 35 U.S.C. § 103(a).....	21
1. Ground 2: Claim 1 is unpatentable as obvious over ProntoEdit in view of Realistic under 35 U.S.C. § 103(a).	28
VIII. CONCLUSION.....	33

EXHIBIT LIST

1001. U.S. Patent No. 7,831,930 (filed Nov. 6, 2002) (issued Nov. 9, 2010) to Dresti et al.
1002. Prosecution history of U.S. Patent Application Serial No. 10/288,727, which matured into the '930 Patent.
1003. Realistic Universal Remote Control Owner's Manual Cat. No. 15-1903
1004. U.S. Patent No. 4,825,200 (filed Jun. 25, 1987) (issued Apr. 25, 1989) to Evans et al.
1005. ProntoEdit User Guide Version 2.0
1006. Pronto Universal Intelligent Remote Control User Guide
1007. RemoteCentral.com web page
http://files.remotecentral.com/view/3492-7441-1/aaron_hugharts_pronto_setup.html#comments
1008. Declaration of Jim Geier In Support of the Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930 ("Geier Declaration").
1009. Complaint for Patent Infringement in *Universal Electronics, Inc. v. Universal Remote Control Inc.*, Civil Action No. SACV 13-00984, filed June 28, 2013 ("Current UEI Litigation").

Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930

1010. Complaint for Patent Infringement in *Universal Electronics Inc. v. Peel Technologies, Inc.*, Civil Action No. SACV 13-01484, filed September 23, 2013 (“Peel Litigation”).
1011. Joint Claim Construction Chart Pursuant to S.P.R. 3.5.1 in *Universal Electronics Inc. v. Peel Technologies, Inc.*, Civil Action No. SACV 13-01484, filed June 13, 2104 (“UEI/Peel Claim Construction Chart”)

Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930

Petitioner Universal Remote Control, Inc. (“Petitioner” or “URC”) respectfully requests *inter partes* review of claim 1 of U.S. Patent No. 7,831,930 (the “’930 Patent,” attached as Ex. 1001) in accordance with 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42.100 et seq.

I. MANDATORY NOTICES

Pursuant to 37 C.F.R. § 42.8(a)(1), Petitioner provides the following mandatory disclosures.

A. Real Party-In-Interest

Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner certifies that Universal Remote Control, Inc. is the real party-in-interest.

B. Related Matters

Pursuant to 37 C.F.R. § 42.8(b)(2), Petitioner states that claim 1 of the ’930 Patent is involved in the litigation presently styled *Universal Electronics Inc., v. Universal Remote Control, Inc., Ohsung Electronics Co., Ltd., and Ohsung Electronics U.S.A., Inc.*, Case No. SACV 13-00984 AG (JPRx) (C.D. Cal.), filed on June 28, 2013 (“2013 UEI Litigation”). Petitioner was the sole defendant in the 2013 UEI Litigation on July 2, 2013 and, consequently, the only defendant served with a complaint in the 2013 UEI Litigation on July 2, 2013. The 2013 UEI Litigation remains pending. The patents-in-suit are U.S. Patent Nos. 5,228,077,

Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930

5,255,313, 5,414,761, 5,552,917, RE39,059, 6,407,779, 7,831,930, 7,126,468, 7,589,642, and 8,243,207.

Claim 1 of the '930 Patent has also been asserted in another litigation styled *Universal Electronics Inc., v. Peel Technologies, Inc.*, Case No. SACV 13-01484 AG (JPRx) (C.D. Cal.) filed September 23, 2013 (“the Peel Litigation”). See Ex. 1010. This litigation is currently pending. Petitioner has not been served with a complaint of infringement in the Peel litigation and is not a defendant in the Peel litigation.

This Petition for *inter partes* review is directed to U.S. Patent No. 7,831,930. Petitions for *inter partes* review corresponding to the remaining nine patents in the 2013 UEI Litigation will also soon be filed. In light of this, the Patent Trial and Appeal Board (PTAB) may wish to consolidate one or more of any other *inter partes* review actions related to this matter to a single panel of Administrative Patent Judges for administrative efficiency.

C. Lead and Back-Up Counsel

Pursuant to 37 C.F.R. § 42.8(b)(3), Petitioner provides the following designation of counsel:

Lead Counsel	Back-Up Counsel
Douglas A. Miro Ostrolenk Faber LLP 1180 Avenue of the Americas New York, NY 10036 Telephone: (212) 596-0500 Facsimile: (212) 382-0888 dmiro@ostrolenk.com USPTO Customer No. 02352 USPTO Reg. No. 31,643	Peter H. Kang, Reg. No. 40,350 Theodore W. Chandler, Reg. No. 50,319 Ferenc Pazmandi, Reg. No. 66,216 Sidley Austin LLP 1001 Page Mill Rd. Building One Palo Alto, CA 94304 Telephone: (650) 565-7000 Facsimile: (65) 565-7100 pkang@sidley.com USPTO Customer No. 37803

D. Service Information

Pursuant to 37 C.F.R. § 42.8(b)(4), service information for lead and back-up counsel is provided above.

II. PAYMENT OF FEES

The undersigned authorizes the Office to charge to Deposit Account No. 15-0700 \$9,000 for the request fee required by 37 C.F.R. § 42.15(a)(1) and \$14,000 for the Post-Institution fee required by 37 C.F.R § 42.15(a)(2) for this Petition for *Inter Parties* Review. Review of 1 claim is being requested, so no excess claims fee is included in this fee calculation. The undersigned further authorizes payment for any additional fees that might be due in connection with this Petition to be charged to the above referenced Deposit Account.

III. REQUIREMENTS FOR INTER PARTES REVIEW

As set forth below and pursuant to 37 C.F.R. § 42.104, each requirement for *inter partes* review of the '930 Patent is satisfied.

A. Grounds For Standing

Pursuant to 37 C.F.R. § 42.104(a), Petitioner hereby certifies that the '930 Patent is available for *inter partes* review and that the Petitioner is not barred or estopped from petitioning for *inter partes* review of the '930 Patent on the grounds identified herein.

B. Identification of Challenge

Pursuant to 37 C.F.R. § 42.104(b), the precise relief requested by Petitioner is that the PTAB cancel as unpatentable claim 1 of the '930 Patent.

1. Claims for which *inter partes* review is requested

Pursuant to 37 C.F.R. § 42.104(b)(1), Petitioner requests *inter partes* review of claim 1 of the '930 Patent.

2. The specific art and statutory grounds on which the challenge is based

Pursuant to 37 C.F.R. § 42.104(b)(2), *inter partes* review of the '930 Patent is requested in view of the following references, each of which is prior art to claim 1 of the '930 Patent under one or more of 35 U.S.C. § 102(a), (b), and/or (e):

Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930

(1) Realistic Universal Remote Control Owner's Manual Cat. No. 15-1903 (Realistic) was published in 1989 by Tandy Corporation. Realistic is prior art to the '930 patent at least under 35 U.S.C. § 102(b).

(2) U.S. Patent No. 4,825,200 was filed Jun. 25, 1987, and issued on April 25, 1989, to Evans et al. (Evans). Evans is prior art to the '930 patent at least under 35 U.S.C. § 102(b).

(3) ProntoEdit User Guide Version 2.0 was published in September, 2000, by Philips Electronics N.V. (ProntoEdit). ProntoEdit is prior art to the '930 patent at least under 35 U.S.C. § 102(b).

The Realistic, Evans, and ProntoEdit references were not considered during prosecution of the '930 patent. Realistic, Evans, and ProntoEdit present new, non-cumulative technological teachings. A detailed discussion of the references and their applicability to claim 1 of the '930 patent is provided starting at Section VII (B) below.

Pursuant to 37 C.F.R. § 42.104(b)(2), *inter partes* review of the '930 Patent is requested on the following grounds.

Ground 1. Claim 1 is unpatentable as obvious over Realistic in view of Evans under 35 U.S.C. § 103(a).

Ground 2. Claim 1 is unpatentable as obvious over ProntoEdit in view of Realistic under 35 U.S.C. § 103(a).

3. How the challenged claims are to be construed

The '930 patent has not expired. Pursuant to 37 C.F.R. § 42.100(b), the claims of an unexpired patent subject to *inter partes* review receive the “broadest reasonable construction in light of the specification of the patent in which [they] appear.” Claim 1 of the '930 patent does not include means-plus-function or step-plus-function limitations.

4. How the construed claims are unpatentable under the statutory grounds identified in 37 C.F.R. § 42.104(b)(2)

Pursuant to 37 C.F.R. § 42.104(b)(4), an explanation of how claim 1 of the '930 patent is unpatentable under the statutory grounds identified above, including an identification of where each element is found in the prior art patents or printed publications, is provided in Section VII.B below.

5. Supporting evidence relied upon to support the challenge

Pursuant to 37 C.F.R. § 42.104(b)(5), the exhibit numbers of the supporting evidence relied upon to support the challenges are provided in an exhibit list included herein. The following text of the present Petition identifies the relevance of the evidence to the challenges raised and identifies specific portions of the evidence to support the challenges raised under the grounds of unpatentability. Further supporting evidence, including detailed discussions of the respective prior art references, is provided in the Geier Declaration (Ex. 1008).

IV. SUMMARY OF THE '930 PATENT

The '930 patent is directed to a “hand-held electronic device having a remote control application user interface that functions to displays operational mode information to a user. 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.” See Ex. 1001 at Abstract. “The user may be able to specify a list of favorite channels for a number of categories. The favorites lists may be synchronized with the channel lineup offered by a cable or satellite service provider.” *Id.* at 12:14-18. “The remote control application may provide one or more favorites pages containing button icons which the user may configure for direct access to his favorite programming (e.g., example, to cause the transmissions of commands to cause a device to tune to a favorite channel), favorite device, etc. ... An exemplary favorites page is illustrated in FIG. 17a.” *Id.* at 19:25-45.



FIGURE 17a

The '930 patent further explains that “[i]t will also be appreciated that favorites pages may be specific to particular devices (e.g. a satellite STB or a CD jukebox) while in other instances favorites pages may span multiple devices in order to allow access to all of a user's favorite media content from a single point of access.” *Id.* at 19:40-45.

Independent claim 1 of the '930 patent is directed to software for a handheld device to allow multiple lists of favorite channels to be defined and accepting input to place the hand held device into a mode to control a home appliance and, in response, using that input to select the list of favorite channels associated with that home appliance. See Ex. 1001 at 38:27-47; see also Ex. 1008 at ¶ 24.

A. Summary of the Prosecution History of the '930 patent

The application for the '930 patent was filed on November 6, 2002, claiming priority to two provisional applications filed in November and December of 2001. The '930 patent names Universal Electronics Inc. (UEI) as assignee and Dresti et al. as inventors. See Ex. 1001 at p. 1.

Original claims 1-73 were subject to a restriction requirement. Ex. 1002 at p. 382. The applicants selection included original claim 33 directed to user specific favorite lists and original claim 35 directed to appliance specific favorite lists. *Id.* at 389.

The Examiner rejected the selected claims as unpatentable over the prior art, including the Williams '988 patent which disclosed user specific favorite channels. *Id.* at 402. The applicants amended the claims to require displaying the favorite channels on the remote control and clarifying that the claimed "mode" is associated with a home appliance. *Id.* at 424.

The Examiner rejected the amended claims over the Allport '019 reference alone or in combination with the Williams '988 reference. *Id.* at 461. In response, the applicants amended the claims again to require embedded instructions and canceled claims directed to user specific favorite channels. *Id.* at 479. The applicants also argued that the claims require the mode selection input to select the

favorite channel, and that mode is different from the Allport reference, in which the favorite channels are selected based on user identity. *Id.* at pp. 483-484.

After the Examiner rejected the claims again, the applicants appealed and argued that, in the claims, the mode (the target device) selection selects the favorites list, and the Examiner failed to find a motivation to modify Allport's user based selection. *Id.* at 514. In particular, applicants argued in their Appeal Brief that the same input has to be used for mode and favorite list selection:

appliances (e.g., a TV, a VCR, etc.). Accordingly, since Allport fails to disclose, teach, or suggest a hand held device that accepts input that specifies to the hand held device that the hand held device is to be placed into a mode to control at least one of a plurality of home appliances, it is respectfully submitted that Allport **must** also fail to disclose, teach or suggest a hand held device that uses that particular form of input, i.e., the input that specifies to the hand held device that the hand held device is to be placed into a mode to control at least one of a plurality of home appliances that is missing from Allport in the first instance, to select at least one of a plurality of lists of favorite channels for display in a display of the hand held device as is expressly claimed.

Id. at 519.

After the appeal process, the Board agreed with the applicants, and the '930 patent issued on Nov. 9, 2010.

V. DETAILED CLAIM CONSTRUCTION

A. Construction of Terms

Claims in the presently requested *inter partes* review proceeding are to be construed in accordance with the broadest reasonable construction in light of the specification of the '930 patent in accordance with 37 C.F.R. §42.100(b). Unless otherwise indicated, the terms of the '930 patent are used in their ordinary and customary sense as one skilled in the relevant field would understand them under the broadest reasonable interpretation standard. Further, Petitioner reserves all rights, as it is entitled under applicable law, to assert the same or different claim constructions for the '930 patent under the different standards and different applicable court procedures in the pending 2013 UEI Litigation.

B. Construction of the Term “accepting input into the hand held device that specifies to the hand held device that the hand held device is to placed into a mode to control at least one of a plurality of home appliances and, in response, using the input to select at least one of the plurality of lists of favorite channels”

The '930 claim term “accepting input into the hand held device that specifies to the hand held device that the hand held device is to placed into a mode to control at least one of a plurality of home appliances and, in response, using the input to select at least one of the plurality of lists of favorite channels” refers to the hand held device receiving user input which puts it in a mode to control a specific home appliance and, in response to the same user input, the hand held device selects one of the favorite channel lists. Ex. 1008 at ¶ 25-27. This interpretation is also

consistent with the arguments made by the applicants during prosecution. See § IV, above.

In the co-pending Peel Litigation mentioned above, Patent Owner has agreed to a construction of the phrase “in response, using the input to select at least one of the plurality of lists of favorite channels” to mean “the mode specifying input automatically selects at least one of the favorite channel lists.” Ex. 1011 at p. 2. Regardless of whether UEI’s proposed agreed construction is deemed to be consistent with the broadest reasonable construction in accordance 37 C.F.R. §42.100(b) (and without any admission by Petitioner that such constructions are or are not correct), in this *inter partes* review proceeding, Patent Owner should not be allowed to assert a claim construction for the ‘930 patent which is any narrower than its proposed constructions in the Peel Litigation.

VI. THERE IS A REASONABLE LIKELIHOOD THAT AT LEAST ONE CLAIM OF THE '930 PATENT IS UNPATENTABLE

Petitioner provides a number of prior art patents and publications demonstrating unpatentability of claim 1 the ‘930 patent. The grounds of invalidity set forth below explain how numerous disclosures in the prior art teach expressly or inherently the limitations of claim 1 of the ‘930 patent.

A. Claim 1 is obvious over Realistic in view of Evans

Realistic is a user manual published by Tandy Corporation in 1989 for a universal remote control with an LCD display. Ex. 1003 at pp. 1-3 and 5. With

the Realistic remote, the user can control eight devices (TV, VCR1, VCR2, CABLE, RVCR, CD, SAT, and AUX). *Id.* at p. 8. The user can select the desired device by pressing the SELECT key and a corresponding device indicator appears on the display. *Id.* The Realistic remote has a favorite channel feature that allows the user to “specify up to 32 favorite-channels for each of the eight devices the URC can command.” *Id.* at p. 36. The specified “favorite-channel list” can be reviewed on the display of the remote by using the SCROLL keys. *Id.* at pp. 37-38. Realistic teaches that when the user presses the SELECT keys to change devices, the “favorite channel list becomes active for any device that you select.” *Id.* at p. 39. Thus, Realistic teaches that the same input which selects the device also selects the corresponding favorite list, as required by claim 1 of the ‘930 patent. See Ex. 1008 at ¶ 32-39.

In addition to the Realistic publication, the Tandy Corporation also disclosed detailed structure for remote controllers in patents, such as the Evans patent. See Ex. 1004 at p. 1 (identifying Tandy as Assignee). Evans discloses a “reconfigurable remote control” for multiple products that can be selected by dedicated keys. *Id.* at 1:7-11 and 4:5-22. Evans further teaches that “the heart of the controller is a microprocessor” that is coupled to a RAM and an LCD display. *Id.* at 4:46-63. Since Realistic and Evans are directed to remote controls from the same company, skilled artisans at the time understood that it was obvious to

implement the Realistic remote to use instructions executable by a processing device for displaying information to a user, as taught by Evans. See Ex. 1008 at ¶¶ 34-39.

Accordingly, as explained below in more detail, there is a reasonable likelihood that Realistic in light of Evans renders obvious claim 1 of the '930 patent.

B. Claim 1 is obvious over ProntoEdit in view of Realistic

ProntoEdit is a user guide published in 2000 by Philips for configuring a Pronto remote controller. See Ex. 1005 at pp. 5, 6, and 9. ProntoEdit “fully defines a Pronto user interface including all devices, macro groups, panel layouts, button appearances and the behavior of all buttons.” *Id.* The “Panel” defines a portion of the screen and can include buttons with corresponding actions. *Id.* at p. 8. The “Device” includes a list of panels. *Id.* In addition, any button can jump to any panel. *Id.* at pp. 8 and 19.

Furthermore, Realistic discloses defining a separate list of favorite channels for each device. See Ex. 1003 at p. 36. Thus, skilled artisans at the time understood that ProntoEdit can be used to define a button that selects a device and a corresponding panel of favorite channels as taught by Realistic. See Ex. 1008 at ¶¶ 40-48. Indeed, such a panel showing favorite channels for a TV using ProntoEdit was developed and published by Aaron Hughart in early 2001. See Ex. 1007.

Accordingly, as explained below in more detail, there is a reasonable likelihood that ProntoEdit in view of Realistic renders obvious claim 1 of the '930 patent.

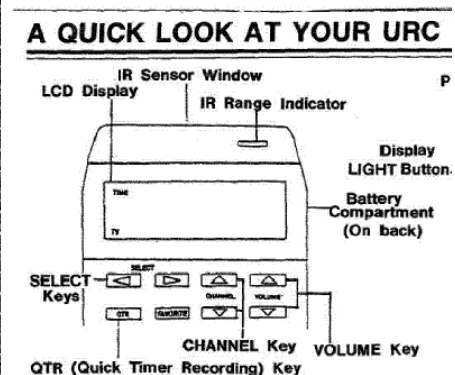
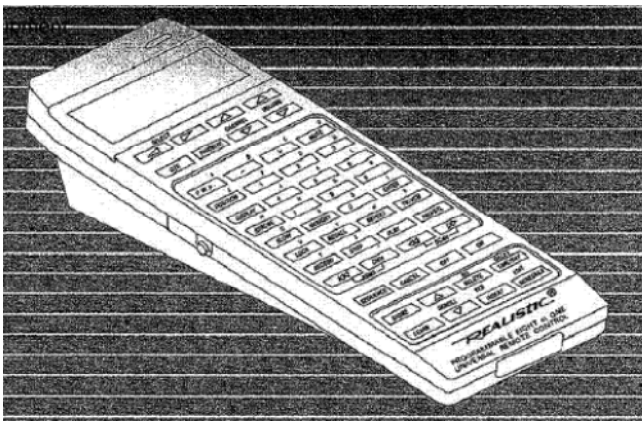
VII. DETAILED EXPLANATION OF HOW THE CHALLENGED CLAIMS ARE UNPATENTABLE

Pursuant to 37 C.F.R. § 42.104(b)(4), Petitioner provides in the following description a detailed comparison of the claimed subject matter and the prior art specifying how each element of the challenged claim is found in the prior art references. Further information and details supporting the unpatentability of claim 1 of the '930 patent over the prior art can be found in the Geier Declaration (Ex. 1008), incorporated herein by reference.

A. Summary of Prior Art

1. Realistic Universal Remote Control Owner's Manual Cat. No. 15-1903 (Realistic - Exhibit 1003)

Realistic is a user manual published by Tandy Corporation in 1989 for a universal remote control with an LCD display. Ex. 1003 at pp. 1-3 and 5.



With the Realistic remote, the user can control eight devices (TV, VCR1, VCR2, CABLE, RVCR, CD, SAT, and AUX). *Id.* at p. 8. The user can select the desired device by pressing a SELECT key and a corresponding device indicator appears on the display. *Id.*

USING SOME KEYS SEVERAL TIMES

The URC has 38 programmable keys. You can teach each command-key up to eight different remote control commands—one command for each of the eight device indicators (TV, VCR1, VCR2, CABLE, RCVR, CD, SAT, and AUX), up to the available memory space. Before you teach or use a command, press the SELECT key [◀] or [▶] to select the desired device.

The Realistic remote has a favorite channel feature that allows the user to “specify up to 32 favorite-channels for each of the eight devices the URC can command.” *Id.* at p. 36.

FAVORITE-CHANNEL SELECTION 36

Your URC has a favorite-channel feature that allows you to specify up to 32 favorite-channels for each of the eight devices the URC can command.

<p>1. Press [LEARN]. The LEARN indicator appears. SELECT and KEY alternately appear on the display.</p>		<p>3. Enter your two-digit favorite-channel. Example: If you press 04, CHN 04 appears on the display.</p>	
<p>2. Press [FAVORITE]. The FAV indicator appears and CHN ** appears on the display.</p>		<p>4. Repeat Step 3 to continue adding your favorite channels, up to 32 channels. Note: If the URC stops accepting favorite channels, press [STORE].</p>	

The specified “favorite-channel list” can be reviewed on the display of the remote by using the SCROLL keys. *Id.* at pp. 37-38. After the favorite channel lists are programmed, pressing the FAVORITE key causes the remote to then transmit the channels from the favorite channel list when the CHANNEL keys are pressed. *Id.* at pp. 38-39.

You can program a favorite-channel list for each device name on the URC. After you program your favorite-channel list into the URC, follow these steps to use the favorite-channel feature.

1. Press [FAVORITE]. The FAV indicator appears.	_____
---	-------

2. When you press CHANNEL [▲] or [▼], the URC transmits the channels from your favorite-channel list, instead of the normal CHANNEL [▲] [▼] command codes.	_____
3. Use the SELECT [◀] or [▶] keys to change devices. The favorite - channel list becomes active for any device that you select.	_____

Realistic teaches that when the user presses a SELECT key to change devices, the “favorite channel list becomes active for any device that you select.” *Id.* at p. 39. If the selected device has no favorite channel list, no favorites are displayed. *Id.*

Note: If you select a device that you have not programmed a favorite-channel list for, the FAV indicator goes out. If you use SELECT [◀] or [▶] to return to a device that you have programmed with a favorite-channel list, the FAV indicator appears again.

Thus, Realistic teaches that the same input which selects the device also selects the corresponding favorite list, as required by claim 1 of the ‘930 patent. See Ex. 1008 at ¶ 33.

2. U.S. Patent No. 4,825,200 (“Evans,” Exhibit 1004)

Evans issued in 1989 and identifies Tandy Corporation as the Assignee on its face. See Ex. 1004 at p. 1 (identifying Tandy as the Assignee). Evans discloses a “reconfigurable remote control” for multiple products that can be selected by dedicated keys. *Id.* 1:7-11 and 4:5-22. Evans’s Figure 1 shows the keys on the disclosed remote control:

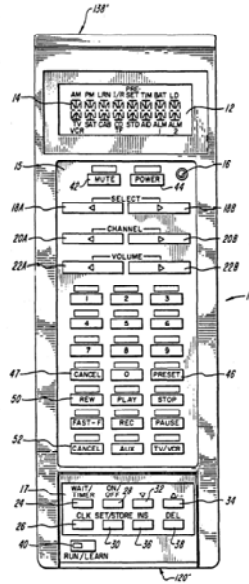


FIG. 1

Evans further teaches that “the heart of the controller is a microprocessor”, and “[m]ost of the functions ... are performed through the programming of microprocessor 100.” *Id.* at 4:46-63 and 14:40-45. Figure 2 of Evans shows the microprocessor and other functional blocks as follows:

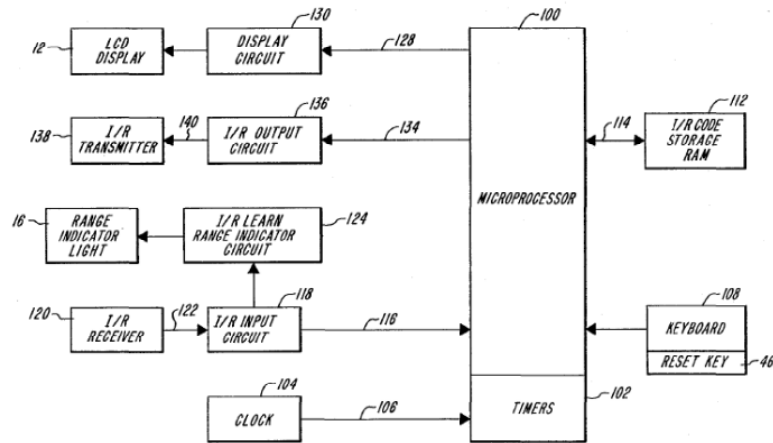


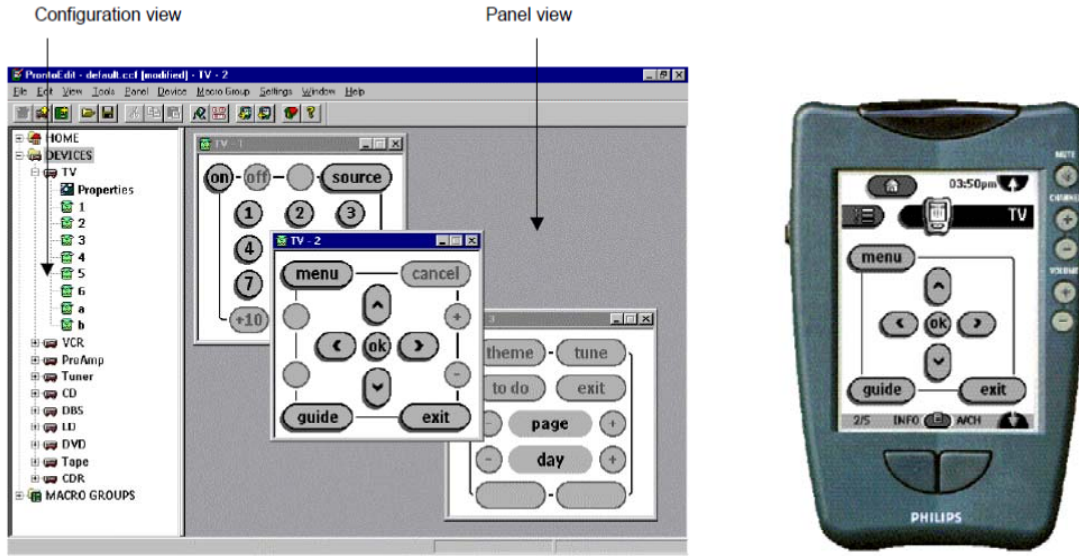
FIG. 2

In Evans, the microprocessor is coupled to a RAM and an LCD display. *Id.* at FIG. 2. The RAM in Evans stores the program code, and the LCD displays information. *Id.* at FIG. 2 and 11:57-12:26. Evans discloses, for example, that in normal use, the LCD can display information such as the name of the key or function of the code to be outputted. *Id.* at 11:57-12:26.

3. ProntoEdit User Guide (“ProntoEdit,” Exhibit 1005)

ProntoEdit is a user guide published in 2000 by Philips for a tool for configuring a remote control device with the trade name “Pronto”. See Ex. 1005 at pp. 5, 6, and 9. The User Guide for the Pronto remote control device itself specifically refers to ProntoEdit as a tool available from the Internet to personalize the Pronto remote control beyond its standard programming features. See, e.g., Ex. 1006 at p. 34.

ProntoEdit “fully defines a Pronto user interface including all devices, macro groups, panel layouts, button appearances and the behavior of all buttons.” See Ex. 1005 at pp. 5, 6, 8 and 9. This user interface is disclosed in ProntoEdit as follows:



Id. at p. 5-6.

In ProntoEdit, the “Panel” defines a portion of the screen and can include buttons with corresponding actions. Id. at p. 8. The “Device” includes a list of panels. Id. In addition, any button can jump to any panel. Id. at pp. 8 and 19.

ProntoEdit can create a “CCF, or Pronto configuration file, [which] stores a single Pronto configuration. ... CCFs have file extension ‘ccf.’” Id. at 8. For example, such a ProntoEdit configuration file can define panels of favorite channels for a Pronto remote control, as demonstrated by Aaron Hughart in early 2001. See Ex. 1007 (and figure reproduced as follows):



B. Detailed Grounds for Unpatentability Arguments

1. Ground 1: Claim 1 is unpatentable as obvious over Realistic in view of Evans under 35 U.S.C. § 103(a).

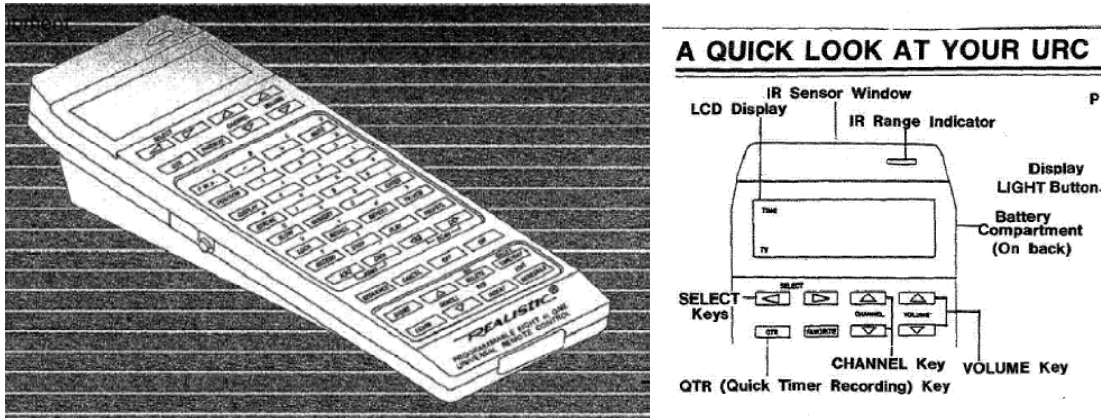
The Realistic reference in light of Evans disclose all of the elements of claim 1 of the '930 patent as discussed below. Ex. 1008 at ¶¶ 32-39. Furthermore, combining the references was obvious to skilled artisans at the time for the reasons discussed above at Section VI(A), and in more detail below. Thus, claim 1 of the '930 patent is unpatentable as obvious over the Realistic reference in light of Evans. Ex. 1008 at ¶¶ 28-39.

Claim 1

An electronically readable media having embedded instructions executable by a processing device of a hand held device for displaying information to a user of the hand held device, the instructions performing steps comprising:

Realistic discloses a universal remote control with an LCD display.

Realistic at pp. 1-3 and 5.



Realistic also discloses memory to “remember up to 119 commands or command sequences.” *Id.* at p. 45.

MEMORY CAPACITY

The URC can *remember* up to 119 commands or command sequences. A little quick multiplication tells you that you'll run out of memory space if you try to use all 24 command keys for all eight device indicator settings. And, there is no room left for command sequences!

Skilled artisans at the time understood that the remote's memory also includes instructions executable by a processing device of a hand held device for displaying information. See Ex. 1008 at ¶ 17-23, 36.

Furthermore, Evans discloses a “reconfigurable remote control” for multiple products that can be selected by dedicated keys. See Ex. 1004 at FIG. 1 and 1:7-11 and 4:5-22. Figure 1 shows the remote control with the keys:

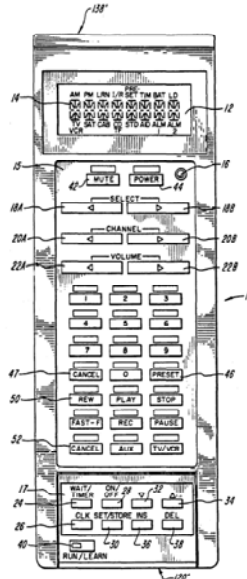


FIG. 1

Evans further teaches that “the heart of the controller is a microprocessor”, and “[m]ost of the functions ... are performed through the programming of microprocessor 100.” *Id.* at FIG. 2 and 4:46-63 and 14-40-45. Figure 2 of Evans shows the processor connected to other blocks of the system:

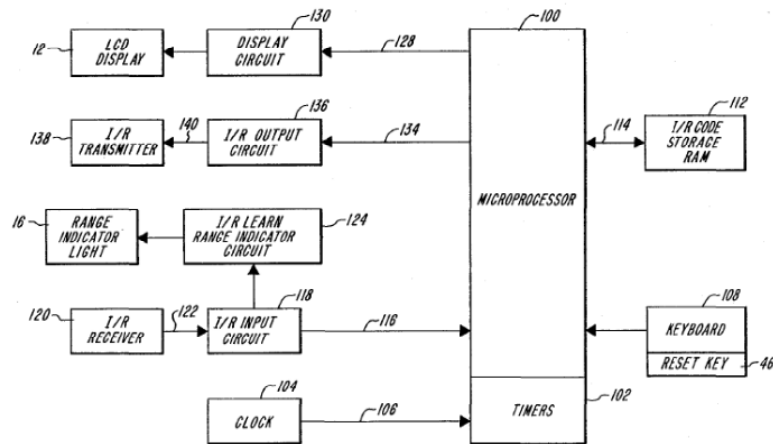


FIG. 2

In Evans, the microprocessor is coupled to a RAM and an LCD display. *Id.* The RAM stores the program code and the LCD displays information, for example in normal use, the name of the key or function of the code to be outputted. *Id.*

In a section titled “Normal Use”, Evans teaches that “[t]he first step in using the controller to control a particular device is to operate select keys 18A and/or 18B to illuminate the annunciator corresponding to the selected device. The controller is then held with the I/R transmitter 138 pointed in the general direction of the device to be controlled and the key which has been programmed for the desired function on the desired device is operated. This causes the name of the key or function to appear on display 14 and causes the I/R code for the function to be outputted.” *Id.* at 11:57-12:26.

Thus, Realistic alone or in view in Evans discloses, to a person of ordinary skill, the preamble of claim 1. See Ex. 1008 at ¶ 17-23, 36.

allowing a plurality of lists of favorite channels to be defined for display in a display of the hand held device; and

Realistic discloses allowing the user to define a separate list for each of eight devices. See Ex. 1003 at pp. 36 and 38 (“You can program a favorite-channel list for each device name on the URC.”).

FAVORITE-CHANNEL SELECTION

36

Your URC has a favorite-channel feature that allows you to specify up to 32 favorite-channels for each of the eight devices the URC can command.

<p>1. Press [LEARN]. The LEARN indicator appears. SELECT and KEY alternately appear on the display.</p>	
<p>2. Press [FAVORITE]. The FAV indicator appears and CHN ** appears on the display.</p>	

<p>3. Enter your two-digit favorite-channel. Example: If you press 04, CHN 04 appears on the display.</p>	
<p>4. Repeat Step 3 to continue adding your favorite channels, up to 32 channels. Note: If the URC stops accepting favorite channels, press [STORE].</p>	

The defined lists can be displayed on the remote's LCD display, for example, for review. *Id.* at pp. 37-38.

Notes:

- The URC stores your favorite-channels in numerical order.
- To review the favorite-channel list, use SCROLL [▲] or [▼].
- You cannot add more than 32 channels to the favorite-channel list. If you already have 32 channels stored on your favorite-channels list, you must delete channels before adding new ones to the list. See "Editing Favorite-Channel Selection."

<p>3. Use the SCROLL [▲] or [▼] keys to locate the desired channel. Press [NO/DELETE] to delete the channel. To add a channel to the list, enter the two digits for that channel. Press [STORE] after you delete or add a channel.</p>
--

Thus, Realistic discloses, to a person of ordinary skill, "allowing a plurality of lists of favorite channels to be defined for display" as required by claim 1. See Ex. 1008 at ¶ 17-23, 37.

accepting input into the hand held device that specifies to the hand held device that the hand held device is to [sic] placed into a mode to control at least one of a plurality of home appliances and

Realistic discloses that pressing the SELECT keys selects a device to be controlled. See Ex. 1003 at 8.

USING SOME KEYS SEVERAL TIMES

The URC has 38 programmable keys. You can teach each command-key up to eight different remote control commands—one command for each of the eight device indicators (TV, VCR1, VCR2, CABLE, RCVR, CD, SAT, and AUX), up to the available memory space. Before you teach or use a command, press the SELECT key [◀] or [▶] to select the desired device.

Thus, Realistic discloses, to a person of ordinary skill, “accepting input” to place the remote control into a mode to control an appliance, as required by claim 1. See Ex. 1008 at ¶ 17-23, 37.

in response, using the input to select at least one of the plurality of lists of favorite channels

Realistic discloses that the same SELECT keys also select the favorite-channel list that is defined for the selected device. See Ex. 1003 at 39.

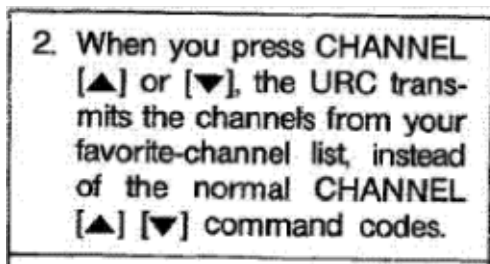
<p>3. Use the SELECT [◀] or [▶] keys to change devices. The favorite - channel list becomes active for any device that you select.</p>	<p>Note: If you select a device that you have not programmed a favorite-channel list for, the FAV indicator goes out. If you use SELECT [◀] or [▶] to return to a device that you have programmed with a favorite-channel list, the FAV indicator appears again.</p>
--	---

Thus, Realistic discloses, to a person of ordinary skill, to “select at least one of the plurality of lists of favorite channels”, as required by claim 1. See Ex. 1008 at ¶ 17-23, 37-38.

whereby the user may interact with the at least one of the plurality of lists when displayed in the display of the hand held device to cause the hand held device to transmit one or more

command codes to the at least one of the plurality of home appliances associated with the specified mode for the purpose of tuning the at least one of the plurality of home appliances to a channel represented on the at least one of the plurality of lists of favorite channels.

Realistic discloses that pressing the CHANNEL keys transmits the channels from the favorite channel list. See Ex. 1003 at 39.



Evans further teaches that the LCD displays the name of the key or function of the code to be outputted:

“The first step in using the controller to control a particular device is to operate select keys 18A and/or 18B to illuminate the annunciator corresponding to the selected device. The controller is then held with the I/R transmitter 138 pointed in the general direction of the device to be controlled and the key which has been programmed for the desired function on the desired device is operated. This causes the name of the key or function to appear on display 14 and causes the I/R code for the function to be outputted.” See Ex. 1004 at 11:57-12:26.

Since Realistic and Evans are directed to remote controls from the same company, skilled artisans at the time understood that it was obvious to implement the Realistic remote to use instructions executable by a processing device for displaying information to the user as taught by Evans. See Ex. 1008 at ¶ 34.

Thus, Realistic and Evans disclose, to a person of ordinary skill, the whereby clause of claim 1. See Ex. 1008 at ¶ 34, 39.

1. Ground 2: Claim 1 is unpatentable as obvious over ProntoEdit in view of Realistic under 35 U.S.C. § 103(a).

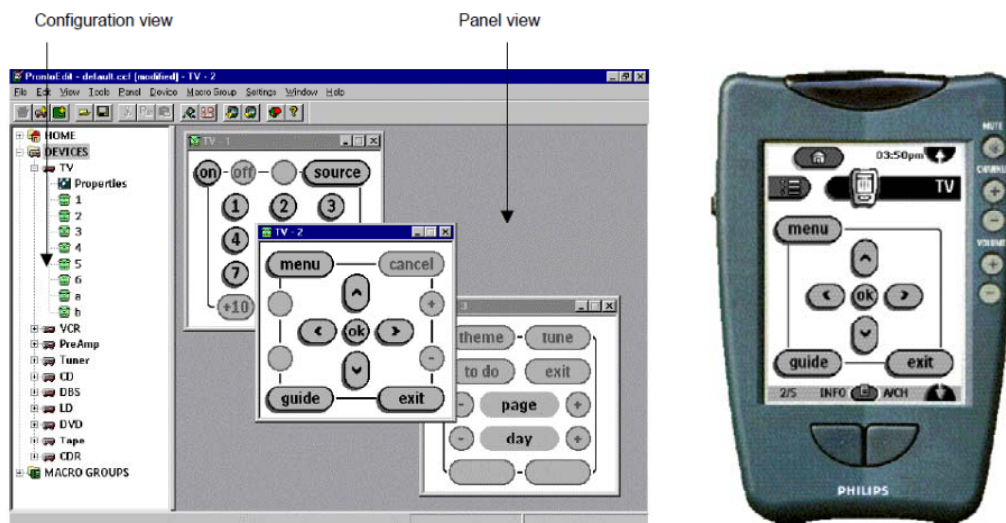
The ProntoEdit reference in light of Realistic disclose all of the elements of claim 1 of the '930 patent as discussed below. Ex. 1008 at ¶ 40-48. Furthermore, combining the references was obvious to skilled artisans at the time for the reasons discussed above at Section VI(B), and in more detail below. Thus, claim 1 of the '930 patent is unpatentable as obvious over the ProntoEdit reference in light of Realistic. Ex. 1008 ¶ 40-48.

Claim 1

An electronically readable media having embedded instructions executable by a processing device of a hand held device for displaying information to a user of the hand held device, the instructions performing steps comprising:

ProntoEdit discloses creating instructions (CCF files) executable by a Pronto remote controller to define a user interface on the remote controller. See Ex. 1005 at 5 and 6; *see also* Ex. 1006 (details of the Pronto remote control).

As the ProntoEdit reference discloses, “ProntoEdit is the visual editor for Pronto configurations. A Pronto configuration fully defines a Pronto user interface including all devices, macro groups, panel layouts, button appearances and the behavior of all buttons, direct-access and left/right keys (including all IR codes).” See Ex. 1005 at 5.



Thus, ProntoEdit discloses, to a person of ordinary skill, the preamble of claim 1. See Ex. 1008 at ¶ 40-44.

allowing a plurality of lists of favorite channels to be defined for display in a display of the hand held device; and


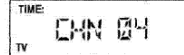
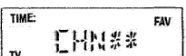

Skilled artisans at the time understood that ProntoEdit allows a plurality of lists of favorite channels to be defined for display in a display of the hand held device. See Ex. 1008 at ¶ 17-23, 40-45.

As ProntoEdit teaches, “[a] Pronto configuration fully defines a Pronto user interface including all devices, macro groups, panel layouts, and button appearances and behaviors (including all IR codes).” See Ex. 1005 at 8.

A person of ordinary skill would be motivated to define such favorite channels in light of Realistic, which teaches defining a separate list for each of eight devices. See Ex. 1003 at pp. 36 and 38 (“You can program a favorite-channel list for each device name on the URC.”).

FAVORITE-CHANNEL SELECTION 36

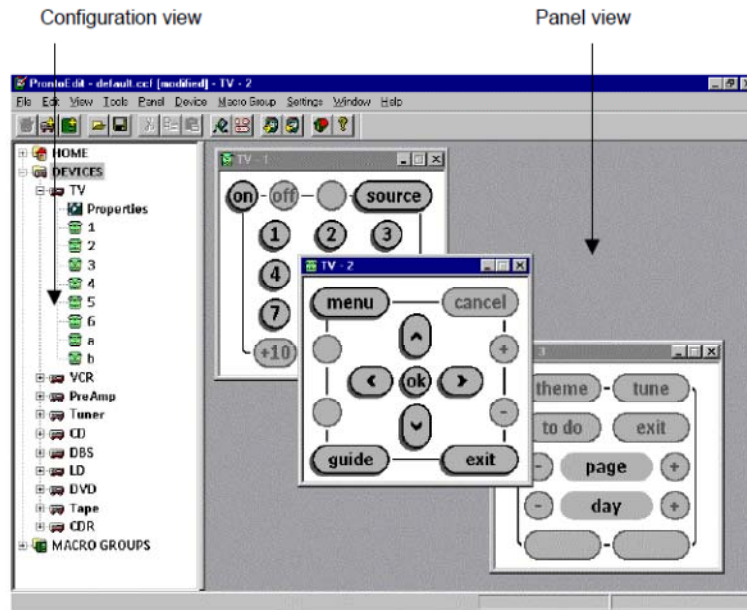
Your URC has a favorite-channel feature that allows you to specify up to 32 favorite-channels for each of the eight devices the URC can command.

1. Press [LEARN]. The LEARN indicator appears. SELECT and KEY alternately appear on the display.		3. Enter your two-digit favorite-channel. Example: If you press 04, CHN 04 appears on the display.	
2. Press [FAVORITE]. The FAV indicator appears and CHN ** appears on the display.		4. Repeat Step 3 to continue adding your favorite channels, up to 32 channels. Note: If the URC stops accepting favorite channels, press [STORE].	

Thus, ProntoEdit alone or in light of Realistic discloses “allowing a plurality of lists of favorite channels to be defined for display” as required by claim 1. See Ex. 1008 at ¶ 40-42, 45.

accepting input into the hand held device that specifies to the hand held device that the hand held device is to placed into a mode to control at least one of a plurality of home appliances and

ProntoEdit discloses that the defined user interface can be organized according to devices (modes) that can be selected by corresponding buttons. See Ex. 1005 at 5.



The ProntoEdit reference teaches that “ProntoEdit provides two complementary views on the current configuration. On the left side of ProntoEdit’s main window you’ll find the configuration view, a typical tree view of the overall structure of the current configuration. At the top level of this tree view you’ll find HOME, DEVICES and MACRO GROUPS. These top levels are associated with the home section, the right hand side device menu and the left hand side macro group menu on your Pronto.” Id. at 5.

For example, panels of favorite channels using Pronto, were demonstrated by Aaron Hughart in early 2001. See Ex. 1007.



Thus, ProntoEdit discloses, to a person of ordinary skill, “accepting input” to place the hand held device into a mode to control an appliance, as required by claim 1. See Ex. 1008 at ¶ 42, 46.

in response, using the input to select at least one of the plurality of lists of favorite channels

ProntoEdit discloses that any “button (or key) can jump to any panel (or be a link to that panel). See Ex. 1005 at 19. Thus, ProntoEdit discloses to skilled artisans that the same button that selects a device, can jump to a panel of the corresponding favorite channels, as taught by Realistic. See Ex. 1008 at ¶ 41, 47.

Indeed, Realistic discloses that the same SELECT keys also select the favorite-channel list that is defined for the selected device. See Ex. 1003 at 39.

3. Use the SELECT [◀] or [▶] keys to change devices. The favorite-channel list becomes active for any device that you select.

Note: If you select a device that you have not programmed a favorite-channel list for, the FAV indicator goes out. If you use SELECT [◀] or [▶] to return to a device that you have programmed with a favorite-channel list, the FAV indicator appears again.

2. When you press CHANNEL [▲] or [▼], the URC transmits the channels from your favorite-channel list, instead of the normal CHANNEL [▲] [▼] command codes.

Thus, ProntoEdit in light of Realistic discloses, to a person of ordinary skill, the whereby clause of claim 1. See Ex. 1008 at ¶¶ 17-23, 42-43, 48.

VIII. CONCLUSION

The prior art references identified in this Petition contain pertinent technological teachings, either explicitly or inherently disclosed (or otherwise obvious to a person of ordinary skill), that were not previously considered in the manner presented herein or applied during original examination of the '930 patent. These references provide new, non-cumulative technological teachings not previously considered and relied upon on the record, and they establish a reasonable likelihood of success as to Petitioner's assertions that claim 1 of U.S. Patent No. 7,831,930 is not valid in view of the prior art, per the grounds presented in this Petition.

The undersigned further authorizes payment for any additional fees or credit

Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930

of overpayment that might be due in connection with this Petition to Deposit
Account 15-0700.

Respectfully submitted,

Date: July 2, 2014

/Douglas A. Miro/
Reg. No. 31,643
OSTROLENK FABER LLP
1180 Avenue of the Americas
7th Floor
New York, NY 10036
(212) 382-0700
Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies service pursuant to 37 C.F.R. §§ 42.6(e), 42.8(e), and 42.105(b) on the Patent Owner by Express Mail of a copy of this Petition for *Inter Partes* Review and supporting materials on compact discs at the mailing address of counsel and current correspondence addresses of record for the '930 patent:

GREENBERG TRAURIG, LLP
77 West Wacker Drive
Suite 3100
Chicago, IL 60101

DATED: July 2, 2014

Respectfully submitted,
/Douglas A. Miro/
Reg. No. 31,643
OSTROLENK FABER LLP
1180 Avenue of the Americas
New York, NY 10036
212-382-0700
Fax: 212-362-0888
dmiro@ostrolenk.com
Counsel for Petitioner

CERTIFICATE OF SERVICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No.: 7,831,930

Patent Issue Date: November 9, 2010

Patent Filing Date: November 6, 2002

Primary Examiner: Ryan F. Pitaro

Title: SYSTEM AND METHOD FOR DISPLAYING A USER
INTERFACE FOR A REMOTE CONTROL
APPLICATION

Mail Stop *Patent Board*
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

**CERTIFICATE OF SERVICE FILED WITH PETITION FOR *INTER*
PARTES REVIEW OF U.S. PATENT NO. 7,831,930**

Dear Sir or Madam:

Petitioner in the above-identified *Inter Partes* Review proceeding respectfully submits this CERTIFICATE OF SERVICE certifying as follows:

I hereby certify that all of the below listed documents are being served via United States Postal Service Express Mail via compact discs on the counsel of record for **United States Patent No. 7,831,930** (hereinafter "Patent"), on the date set forth below and in envelopes addressed to the mailing address of counsel and current correspondence address of record related to the Patent:

Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930

GREENBERG TRAURIG, LLP
77 West Wacker Drive
Suite 3100
Chicago, IL 60101

1. Petition for Inter Partes Review of U.S. Patent No. 7,831,930
2. Exhibit 1001 - U.S. Patent No. 7,831,930 (filed Nov. 6, 2002) (issued Nov. 9, 2010) to Dresti et al.
3. Exhibit 1002 - Prosecution history of U.S. Patent Application Serial No. 10/288,727, which matured into the '930 Patent.
4. Exhibit 1003 – Realistic Universal Remote Control Owner’s Manual Cat. No. 15-1903.
5. Exhibit 1004 – U.S. Patent No. 4,825,200 (filed Jun. 25, 1987) (issued Apr. 25, 1989) to Evans et al.
6. Exhibit 1005 – ProntoEdit User Guide Version 2.0
7. Exhibit 1006 – Pronto Universal Intelligent Remote Control User Guide
8. Exhibit 1007 – RemoteCentral.com web page
http://files.remotecentral.com/view/3492-7441-1/aaron_hugharts_pronto_setup.html#comments
9. Exhibit 1008 – Declaration of Jim Geier In Support of the Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930 (“Geier Declaration”).

Petition for *Inter Partes* Review of U.S. Patent No. 7,831,930

10. Exhibit 1009 - Complaint for Patent Infringement in *Universal Electronics, Inc. v. Universal Remote Control Inc.*, Civil Action No. SACV 13-00984, filed June 28, 2013 (“Current UEI Litigation”).
11. Exhibit 1010 - Complaint for Patent Infringement in *Universal Electronics Inc. v. Peel Technologies, Inc.*, Civil Action No. SACV 13-01484, filed September 23, 2013 (“Peel Litigation”).
12. Exhibit 1011 - Joint Claim Construction Chart Pursuant to S.P.R. 3.5.1 in *Universal Electronics Inc. v. Peel Technologies, Inc.*, Civil Action No. SACV 13-01484, filed June 13, 2104 (“UEI/Peel Claim Construction Chart”).
13. Power of Attorney per 37 C.F.R. § 41.10(b)
14. This Certificate of Service

DATED: July 2, 2014

Respectfully submitted,
/Douglas A. Miro/
Reg. No. 31,643
OSTROLENK FABER LLP
1180 Avenue of the Americas
New York, NY 10036
212-382-0700
Fax: 212-362-0888
dmiro@ostrolenk.com