

## Roku Wipes Out Remote Control Patents At PTAB

By **Andrew Karpan**

*Law360 (March 30, 2021, 7:41 PM EDT)* -- The Patent Trial and Appeal Board has scratched out claims in two remote control device patents that Universal Electronics Inc. has accused Roku of infringing in parallel litigation in California federal court.

In a pair of rulings handed down Monday, a three-judge PTAB panel said all the claims Roku Inc. had challenged in two patents owned by Universal Electronics Inc. were rendered obvious by collections of prior art references.

Universal Electronics, a Scottsdale, Arizona-based electronics company, asserted the patents in an infringement case against Roku in 2018. Universal alleged that a variety of Roku's remote control devices infringed a collection of patents connected to remote control configuration software that Universal markets under the brand name QuickSet.

Last April, Universal Electronics also asserted those patents in a flurry of additional infringement suits against TCL Electronics Holdings Ltd., Funai Electric Co. Ltd. and Hisense Co. Ltd. Like the Roku case, all the suits were filed in the Central District of California.

In its complaints, Universal Electronics touted that one of the patents at issue covering its QuickSet software avoided scrutiny by the PTAB before. A New York-based company called Universal Remote Control Inc. challenged U.S. Patent No. 7,589,642 back in 2014, and the patent board declined, then, to institute inter partes review.

But the panel said Monday that Roku had brought a stronger case.

"To the extent [Universal Electronics] implies that petitioner's argument in this proceeding is akin to the arguments advanced in the earlier IPR, we disagree," Judge Patrick Boucher wrote for the panel in its decision on the '642 patent.

"Unlike the conflation of inherent anticipation with single-reference obviousness that the board found problematic in the earlier IPR, the instant petition identifies additional prior art," Judge Boucher added.

These new prior art references included a remote control system patent issued in 1984 and another patent, issued in 2012, that covers a method of using the internet to program universal remotes.

The second Universal Electronics patent that the board ruled on fared no better Monday.

"Petitioner articulates sufficient reason, supported by rational underpinning, for effecting the combination of teachings," Judge Sharon Fenick wrote for the panel, signing off on Roku's argument that a collection of three patents anticipated claims in U.S. Patent No. 8,004,389. That patent was issued to Universal Electronics in 2011 and covers a method of relaying signals through remote devices.

Universal Electronics is also litigating infringement cases against Roku and others at the U.S. International Trade Commission, where the court held one of its first remote hearings last August over claim construction in that case. The ITC is currently investigating if those companies infringe claims in Universal's '642 patent, among others.

Representatives for the parties did not immediately respond to request for comment Tuesday.

The patents-in-suit are U.S. Patent Nos. 7,589,642 and 8,004,389.

Administrative Patent Judges Patrick Boucher, Minn Chung and Sharon Fenick sat on the panels.

Roku is represented by Jon Wright, Lestin Kenton, Daniel Block and Tim Tang of Sterne Kessler Goldstein & Fox PLLC.

Universal Electronics is represented by Benjamin Pleune, Ryan Koppelman, Thomas Davison, James Abe, Caleb Bean, Derek Neilson, Nicholas Tsui of Alston & Bird LLP.

The cases are Roku Inc. v. Universal Electronics Inc., case numbers 2019-01612 and 2019-01613, before the Patent Trial and Appeal Board.

--Additional reporting by Ryan Davis. Editing by Stephen Berg.