

Roku Gets Universal Remote Patent Wiped Out At PTAB

By Britain Eakin

Law360 (September 23, 2022, 5:09 PM EDT) -- The Patent Trial and Appeal Board has invalidated a Universal Electronics Inc. remote control patent in a challenge brought by Roku Inc., with the board finding that all 13 claims in the patent are invalid as obvious.

The PTAB determined that when combined, two U.S. patent application publications called Chardon and Mishra and an HDMI technical specification contain key elements of all claims of U.S. Patent No. 9,641,785. The board also found that Roku was able to show that skilled artisans would have had good reason to combine the prior art.

The board said it was persuaded by Roku's argument that skilled artisans would have looked to the HDMI technical specification because Chardon relies on the capabilities of HDMI-compliant devices, and would have reasonably expected success in integrating the elements described in the technical specification because of Chardon's reliance on them.

The board also said it was persuaded that, as Roku proposed, skilled artisans would have thrown Mishra into the mix to leverage Chardon's two-way communication capabilities with the wireless configuration of remote control devices described in Mishra.

"Petitioner sufficiently shows that each limitation of independent claim 1 is met by the combination of the asserted references, and articulates reasons, supported by rational underpinning, to combine the teachings of the asserted references," the decision said.

The board reached the same conclusion on the other 12 claims, all of which are dependent on claim 1. While independent claims can stand alone and contain all elements to define the invention, dependent claims further limit a patent's independent claims. The board said that Universal Electronics did not contest Roku's invalidity arguments beyond independent claim 1, and that Roku had shown "by a preponderance of the evidence" that the dependent claims are also obvious.

The patent is one of five that Universal Electronics asserted against Roku in an August 2020 suit in California federal court. Roku got the PTAB to invalidate one of the other patents at issue in the suit, U.S. Patent No. 7,969,514, while the board found claims in U.S. Patent No. 10,325,486 were not shown to be invalid. The PTAB declined to review the other two asserted patents — U.S. Patent Nos. 10,593,196 and 10,600,317 — under the PTAB's controversial Fintiv policy. Under Fintiv, the board can deny patent reviews when parallel litigation is at an advanced stage.

In the case of the '196 and '317 patents, the board pointed to a fast-moving U.S. International Trade Commission investigation involving those patents as a reason to deny the patent reviews. Roku appealed the board's institution decisions, arguing that because the ITC does not actually have the authority to invalidate patents, the PTAB should not defer to it.

But the Federal Circuit shot down the argument since the board's decisions about whether to review patents are final and nonappealable.

The California suit, meanwhile, was put on hold shortly after Universal Electronics filed the ITC case. The full commission found in November that Roku infringed the '196 patent and issued a limited exclusion order blocking infringing Roku products from entering the U.S., as well as a cease-and-desist order. According to the case docket in the California suit, that litigation is still on hold.

Counsel for Roku declined to comment on Thursday's PTAB decision, while counsel for Universal Electronics did not immediately return a request for comment on Friday.

The patent-in-suit is U.S. Patent No. 9,641,785.

Administrative Patent Judges Patrick M. Boucher, Sharon Fenick and Russell E. Cass sat on the panel.

Roku is represented by Jon E. Wright, Lestin L. Kenton Jr. and Daniel S. Block of Sterne Kessler Goldstein & Fox PLLC.

Universal Electronics is represented by S. Benjamin Pleune, Stephen Lareau, Nicholas T. Tsui and Michael C. Deane of Alston & Bird LLP.

The case is Roku Inc. v. Universal Electronics Inc., case number IPR2021-00758, at the Patent Trial and Appeal Board.

--Additional reporting by Alyssa Aquino and Adam Lidgett. Editing by Kelly Duncan.