

Universal Remote Control, Inc. v. UEI Cayman, Inc. and Universal Electronics, Inc.: Order Denying Institution of Inter Partes Review IPR2014-01111

Article By:

Intellectual Property Litigation Drinker Biddle

Takeaway: If the petitioner asserts two grounds of unpatentability of obviousness based upon the same two references with the only difference being the classification of one as primary and one as secondary in each ground, then the Board will likely treat that as one ground of unpatentability.

In its [Decision](#), the Board found that Petitioner failed to show a reasonable likelihood of prevailing in challenging claims 7, 8, 11, and 12 of the '779 Patent and declined to institute inter partes review. The '779 Patent relates to remote control systems for televisions and other audio-visual systems and features a bi-directional communication between a remote control device and a television set.

Regarding the grounds of unpatentability, Petitioner asserted two grounds of obviousness – Goulden in view of Mitsuhashi, and Mitsuhashi in view of Goulden. The Board found that the characterization of references as primary and secondary are merely a matter of presentation with no legal significance; therefore, it considered the Petition as presenting a single ground of unpatentability over Goulden and Mitsuhashi.

The Board then reviewed claim construction, stating that the claim terms are given their broadest reasonable interpretation consistent with the specification. The Board reviewed two terms: “controlling components”/“controlling level” and “transmitting” to/from the remote control device. Regarding the first terms, the Board construed “controlling components” as defined in the specification, and “controlling level” to exclude binary, on-off switches and other, similar audio/video system controls that can be set to only one of two possible settings or values. Regarding the second term, the Board agreed with Patent Owner that express construction of the term was not necessary for the purposes of the Decision.

The Board then turned to whether claims 7 and 11 are obvious over Goulden and Mitsuhashi. Patent Owner argued that Goulden fails to disclose transmitting a controlling level of a controlling component from the audio/video device to the remote control because it does not disclose bi-directional communication, and the Board agreed finding Petitioner’s expert’s testimony insufficiently credible to make the threshold showing for institution of a trial. Patent Owner also disputed that Mitsuhashi transmits a controlling level of a controlling component from the audio/video device to the remote control because the data is not a “controlling level.” Based on its construction, the Board was not

persuaded that Mitsuhashi discloses a “controlling level.” Therefore, the Board found that neither reference disclosed the requisite transmission limitation in claims 7 and 11. Further, the Board found that the Petition failed to make any persuasive evidentiary presentation that a person of ordinary skill in the art starting with Goulden and Mitsuhashi would have had either the ability or the motivation to modify the prior art to achieve the claimed invention. Because claims 8 and 12 depend from claims 7 and 11, respectively, the Board also found that Petitioner’s challenge failed as to those claims.

**Universal Remote Control, Inc. v. UEI Cayman, Inc. and Universal Electronics, Inc.,
IPR2014-01111**

Paper 9: Decision Denying Institution of Inter Partes Review

Dated: November 24, 2014

Patent: 6,407,779 B1

Before: Howard B. Blankenship, Sally C. Medley, and William A. Capp

Written by: Capp

© 2025 Faegre Drinker Biddle & Reath LLP. All Rights Reserved.

National Law Review, Volume IV, Number 337

Source URL: <https://natlawreview.com/article/universal-remote-control-inc-v-uei-cayman-inc-and-universal-electronics-inc-order-de>