

# Universal Remote Control v. Universal Electronics: Final Written Decision Finding Challenged Claims Not Unpatentable IPR2014-01146

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*Takeaway: Where a claim term is susceptible to more than one construction, the Board's governing rules do not necessarily require de facto adoption of the broader interpretation. Moreover, questions eliciting yes/no answers on re-direct examination may provide contextual cues so as to be leading questions and subject to exclusion per Federal Rule of Evidence 611.*

In its [Final Written Decision](#), the Board determined “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.” 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.” Petitioner had challenged “claims 13–15 of the ’207 patent under 35 U.S.C. § 102 as anticipated by [Dubil].”

The Board first addressed Petitioner’s motion “to exclude deposition testimony from Patent Owner’s expert . . . elicited on re-direct examination,” which Petitioner objected to as “constituting leading questions.” During re-direct examination, Patent Owner’s counsel asked its own expert three questions “phrased narrowly so as to elicit either a ‘yes’ or ‘no’ answer.” The Board noted that a “leading question is one that suggests to the witness the answer desired by the examiner” and that “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.” The Board “agree[d] 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 questions that were asked on re-direct examination are thus “impermissible leading questions under Federal Rule of Evidence 611.” As such, the Board granted Petitioner’s motion to exclude the re-direct examination.

The Board next addressed claim construction under the broadest reasonable interpretation consistent with the specification. For various terms construed in its Decision to Institute, the Board maintained its constructions in the absence of argument otherwise. For the term “configuration of the entertainment device,” neither party had proposed a construction in their respective Petition or Preliminary Response, and the Board in its Decision to Institute “noted that these terms are

susceptible to more than one construction.” The Board rejected Petitioner’s argument that “our governing rules necessarily require *de facto* adoption of the broader interpretation.” Patent Owner, on the other hand, supported its construction with expert testimony, which the Board generally acknowledged “can be useful for a variety of purposes,” but “conclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court.” Here, the Board stated that its “claim construction analysis will focus primarily on the intrinsic record.” Because the “claims indicate that a *configuration of the entertainment device* is a construct that can be ‘downloaded’ from a computer” and “is also a construct that can be ‘access[ed] and use[d]’ in association with a controlling device activity key command value,” 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.” Thus, the Board construed the term “configuration of the entertainment device” as “referring to information stored in memory in the entertainment device that can be accessed and used to configure the entertainment device.”

The Board next turned to anticipation by Dubil. “Dubil discloses a remote control device that provides commands based on the configuration of components in an AV system.” Petitioner “alleges that Dubil anticipates claim 13” and supports its allegations with declaration testimony. Specifically:

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.

The Board was “not persuaded by Petitioner’s argument or evidence”:

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.*

The Board was further “not persuaded that Dubil discloses a ‘*configuration of the entertainment device*’ as we have construed the term” as “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.” 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.”

The Board also disagreed with Petitioner’s contention that “Dubil teaches downloading the configuration to the VCR.” “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.” Further, the “mere possibility that it might function as a storage device is insufficient to establish anticipation either explicitly or inherently.” Because Dubil fails to disclose all elements of claim 13, the Board found “Petitioner has failed to establish, by a preponderance of the evidence, that Dubil anticipates claim 13.”

The Board found that challenged “claim 14 is an independent claim that is substantially similar in scope to claim 13.” As such, the Board “resolve[d] this dispute in Patent Owner’s favor for essentially the same reasons discussed above with respect to claim 13.” And because challenged claim 15 depends from claim 14, claim 15 is similarly not anticipated. In sum, the Board found that Petitioner had not shown by a preponderance of the evidence that claims 13-15 of the ’207 patent are unpatentable as anticipated by Dubil.

***Universal Remote Control, Inc. v. Universal Electronics, Inc.*, IPR2014-01146**

Paper 36: Final Written Decision

Dated: December 10, 2015

Patent: 8,243,207 B2

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

Written by: Capp

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