

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSAL REMOTE CONTROL, INC.
Petitioner

v.

UNIVERSAL ELECTRONICS, INC.
Patent Owner

Case IPR2013-00152
Patent 5,614,906

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and SCOTT R.
BOALICK, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

Universal Remote Control, Inc. (Petitioner) requests *inter partes* review of claims 1, 10, 12, and 16 of US Patent 5,614,906 under 35 U.S.C. §§ 311 *et seq.* Paper No. 2 (“Pet.”). Universal Electronics, Inc. (Patent Owner) submitted a preliminary response under 37 C.F.R. § 42.107(b) on May 22, 2013. Paper No. 7 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons that follow, the petition is *denied*.

A. *The Challenged Patent*

The '906 patent (Ex. 1001) describes a remote control device (Fig. 1) having remote control command sets, each set consisting of commands for operating a different remotely controllable device. In a remote control device programming (select) procedure, a command from each set, having an effect that is observable in the remotely controlled device -- such as a command for “power off” -- is assigned to a corresponding one of user actuated keys. The user presses the keys one by one until the user observes the desired effect on the remotely controlled device. The user then signals the remote control device to exit the select procedure. The remote control device sets the remote control to transmit future commands from

the command set that includes the last transmitted effects observable command having the observed desired effect. '906 patent Abstract; col. 6, ll. 20-37, 50-57.

B. Illustrative Claims

1. A method for selecting an appropriate one of a plurality of command sets stored in a remote control having a plurality of assignable user actuated switches or keys for controlling a remotely controllable electronic device, comprising the steps of:

(a) assigning an effects observable command from each of said plurality of command sets to one of said plurality of assignable user actuated switches or keys, each assigned, effects observable command to be transmitted when the corresponding one of the assignable user actuated switches or keys is actuated;

(b) actuating sequentially and individually each one of the plurality of assignable user actuated switches or keys, to individually transmit each assigned effects observable command until the proper effect is observed;

(c) halting the actuating of the plurality of assignable user actuated switches or keys; and

(d) setting the remote control to transmit future remote control commands from the command set containing the last transmitted effects observable command.

16. An apparatus for selecting an appropriate one of a plurality of command sets stored in a remote control having a plurality of assignable user actuated switches or keys for controlling a remotely controllable electronic device, comprising:

means for assigning an effects observable command from each of the plurality of command sets to one of said plurality of assignable user actuated switches or keys;

means for transmitting said effects observable command when the corresponding one of said plurality of assignable user actuated switches or keys is actuated;

means for indicating the halting of the actuation of the plurality of assignable user actuated switches or keys; and

means for setting the remote control to transmit future remote control commands from the command set containing the last transmitted effects observable command.

C. Related Proceedings

The '906 patent is involved in litigation styled *Universal Electronics Inc., v. Universal Remote Control, Inc.*, Case No. SACV 12-00329 AG (JPRx) (C.D. Cal.), filed on March 2, 2012. Pet. 1. The Petitioner has filed petitions for *inter partes* review against two other patents involved in the litigation: US 6,587,067 (IPR2013-00127) and US 5,414,426 (IPR2013-00168).

D. Asserted Grounds of Unpatentability

Petitioner asserts the following ground of unpatentability under 35 U.S.C. § 102(b):

I. Claims 1 and 16 over Telefunken (DE 3313493 A1; Oct. 18, 1984)¹ (Ex. 1003).

Petitioner asserts the following grounds of unpatentability under 35 U.S.C. § 103(a):

II. Claims 10 and 12 over Telefunken and Casio (JP H6-311567; Nov. 4, 1994) (Ex. 1004);

III. Claims 1 and 16 over Sony (EP 0 577 267 A1; Jan. 5, 1994) (Ex. 1005) and Telefunken;

IV. Claims 10 and 12 over Sony, Telefunken, and Casio;

V. Claims 1, 10, and 12 over GHV-300/GHV-500² and MRH7700³;

VI. Claim 16 over GHV300/GHV-500, MRH7700, and Telefunken;

VII. Claims 1, 10, and 12 over GHV-300/GHV-500, Pioneer⁴, and Casio;

and

VIII. Claim 16 over GHV-300/GHV-500, Pioneer, and Telefunken. Pet. 5-6.

¹ An English translation accompanies each foreign-language publication.

² GHV 300 VHS VCR User Manual (Ex. 1006) and GH500 VHS VCR User Manual (Ex. 1007), both undated.

³ Installation and Operation KI-1844A, MRH7700 IR Remote Control, Rauland-Borg Corp., May 1994 (Ex. 1009).

⁴ Operating Instructions, Audio/Video Stereo Receiver VSX-5900S, Pioneer Corp., undated (Ex. 1010).

II. ANALYSIS

Claim Interpretation

Consistent with the statute and the legislative history of the Leahy-Smith America Invents Act (AIA), the Board will construe the claims of an unexpired patent using the broadest reasonable interpretation. 37 CFR § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012). The claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citing *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002)).

There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). By “ordinary meaning” we are guided by, *e.g.*, *Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.*, 249 F.3d 1341, 1349 (Fed. Cir. 2001) (finding no error in non-construction of “melting”); *Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365, 1380 (Fed. Cir. 2001) (finding no error in court’s refusal to construe “irrigating” and “frictional heat”).

I. Claim 1: “assigning an effects observable command from each of said plurality of command sets to one of said plurality of assignable user actuated switches or keys”

Petitioner submits that the use of the word “one,” as opposed to “a respective one,” means that the claim fails to require a one-to-one correspondence between an effects observable command and a switch or key on the remote control device. Pet. 12-14. Patent Owner submits that both the language of the claim and the '906 patent's disclosure require that an effects observable command from each of the command sets is assigned to a *corresponding* user actuated switch or key. Prelim. Resp. 3-9.

Without deciding which party has the better position, for purposes of this decision we will adopt the broader of the readings with respect to the claimed “one” of the plurality of switches or keys. That is, we will presume that claim 1 is not limited to “assigning an effects observable command from each of said plurality of command sets to [*a corresponding*] one of said plurality of assignable user actuated switches or keys.” However, the step of “assigning an effects observable command” must be read together with the next step of the claim, which we now address.

II. Claim 1: “actuating sequentially and individually each one of the plurality of assignable user actuated switches or keys, to individually transmit each assigned effects observable command until the proper effect is observed”

Petitioner submits that the broadest reasonable interpretation of the claim phrase is “pushing switches or keys one at a time to transmit effects observable commands, the switches or keys being pushed until a user observable effect is

observed.” Pet. 15. Patent Owner responds that the claim phrase does not need additional construction and does not dispute Petitioner’s proposed construction. Prelim. Resp. 10.

However, Petitioner’s proposed construction of the “actuating” step fails to account for *which* “effects observable” commands may be transmitted. Claim 1 recites “assigning an effects observable command *from each* of said plurality of command sets to one of said plurality of assignable user actuated switches or keys,” with “*each* assigned, effects observable command to be transmitted when the corresponding one of the assignable user actuated switches or keys is actuated,” and “actuating sequentially and individually each one of the plurality of assignable user actuated switches or keys, to individually transmit *each* assigned effects observable command until the proper effect is observed” (emphasis added). The plain language of claim 1 thus requires that an (i.e., *one*) effects observable command is assigned *from each* of the plurality of command sets, with *each* assigned command to be transmitted when the corresponding switch or key is actuated, and *each* assigned command is individually transmitted upon actuating sequentially and individually *each one of the plurality* of assignable switches or keys (i.e., at least two keys are actuated, causing at least two corresponding assigned commands to be transmitted). We further note that the claim limits the sequential and individual actuation of the keys in that they are actuated *until* the proper effect is observed (e.g., a “power-off” command results in turning off a remote controllable device, such as a TV).

The “assigning” and “actuating” steps of claim 1 together require that *the same* “effects observable command” from a command set (1) is assigned to one of the plurality of assignable user actuated switches and keys, (2) is to be transmitted

when the corresponding one of the switches or keys is actuated, and (3) is transmitted as a consequence of sequential and individual actuation of each of the plurality of assignable switches or keys, until the proper effect is observed. Our reading of the plain language of the claim is consistent with the disclosure of the '906 patent. In the preferred embodiment, a “power off” command is assigned not only to the “power” key but also to each of the numeric keys, such that each of the assignable user actuated keys corresponds to a “power off” signal that operates a particular remotely controlled device. '906 patent col. 6, ll. 31-37.

Claim Interpretation -- Means Plus Function

Section 112, paragraph six permits an element in a claim for a combination to be expressed as a means for performing a specified function without the recital of structure in support thereof, but with the provision that “such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” “[T]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification.” *Aristocrat Techs. Austl. Party. Ltd. vs. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (quoting *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1249 (Fed. Cir. 2005)).

III. Claim 16: “*means for assigning an effects observable command from each of the plurality of command sets to one of said plurality of assignable user actuated switches or keys*”

Petitioner and Patent Owner agree that the “means for assigning” clause of claim 16 must be construed in accordance with 35 U.S.C. § 112, sixth paragraph.

Petitioner submits that the “only structure arguably suggested to perform the function in the '906 patent is a general purpose microprocessor.” Pet. 15. Patent Owner responds that the “structure that performs the stated function is a microprocessor executing one or more of the algorithms described in col. 2, lines 39-44; col. 5, lines 17-27; and col. 6, lines 3-19 of the '906 patent. (*See also* Ex. 1001 at FIGS. 3A, 3C, 4:8-11, 44-47.)” Prelim. Resp. 11.

While the '906 patent uses the words “assign” and “assigning,” we find that the patent does not describe an algorithm for “assigning” an effects observable command as recited in claim 16. We are mindful that describing an algorithm to the satisfaction of one of ordinary skill in the art does not require, for example, detailed disclosure in a step-by-step flowchart. *See, e.g., Finisar Corp. v. The DirectTV Group*, 523 F.3d 1323, 1340 (Fed. Cir. 2008) (“the patent must disclose . . . enough of an algorithm to provide the necessary structure under § 112, ¶ 6,” which can be expressed in any understandable terms (e.g., a mathematical formula, in prose, or as a flowchart)). The '906 patent, however, does not describe, to any appreciable extent, an algorithm that corresponds to the function of the claimed “means for assigning.” As an example, Figure 3C of the '906 patent is reproduced below.

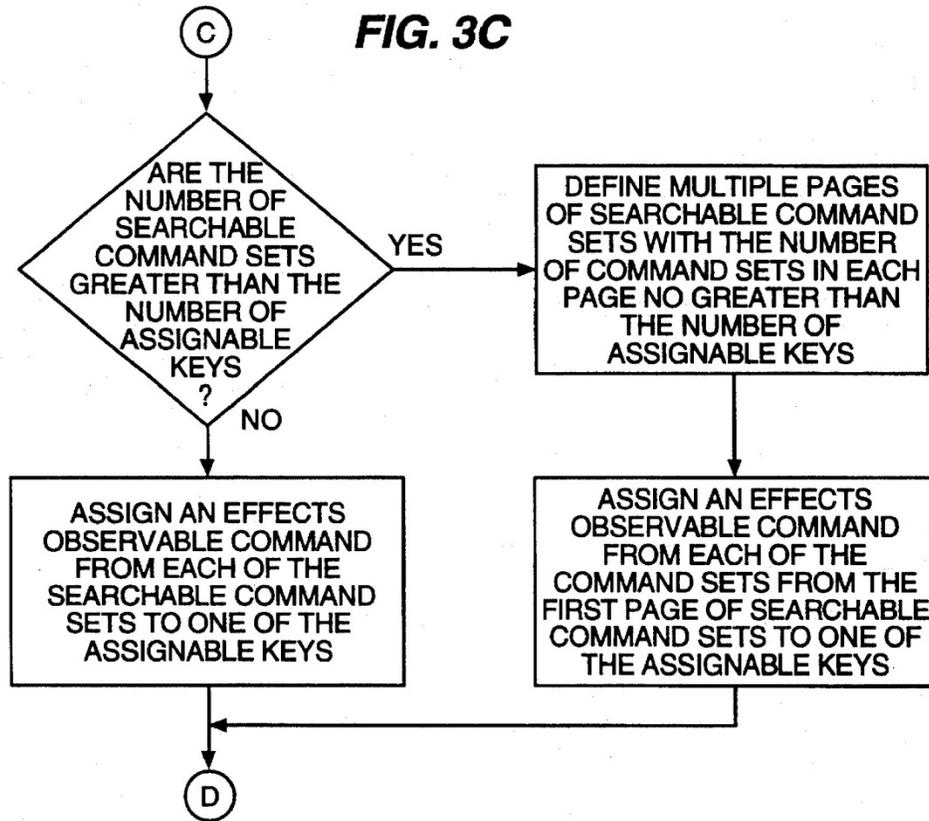


Figure 3C is said to depict a portion of a flow chart that provides instructions for assisting in the control of the remote control, with emphasis on selecting a remote control command set from a group of multiple command sets stored in the remote control. '906 patent col. 3, ll. 39-44. However, the remainder of the '906 patent provides no more detail with respect to the “assigning” of an effects observable command from each of the command sets than does Figure 3C. As shown in the Figure, the patent merely uses the word “assign,” which may correspond to the function of the claimed “means for assigning” but does not serve to describe an algorithm by which the appropriate effects observable commands are “assigned.” The patent “simply describes the function to be performed, not the

algorithm by which it is performed.” *Aristocrat*, 521 F.3d at 1334. There is thus no disclosed structure that includes an algorithm that may correspond to the claimed function of “assigning an effects observable command from each of the plurality of command sets to one of said plurality of assignable user actuated switches or keys.”

IV. Claim 16: “*means for indicating the halting of the actuation of the plurality of assignable user actuated switches or keys*”

Petitioner and Patent Owner agree that the “means for indicating” clause of claim 16 must be construed in accordance with 35 U.S.C. § 112, sixth paragraph. Petitioner contends there is no structure suggested in the '906 patent to perform the stated function. Pet. 16. Patent Owner responds that the structure that performs the claimed function “is a microprocessor executing one or more of the algorithms described in col. 2, lines 49-51; col. 6, lines 51-58,” with further reference to the '906 patent at Figure 3D and column 4, lines 8-11 and 44-47. Prelim. Resp. 12.

The '906 patent’s written description does use the word “indicating.” “Typically the user exits the setup procedure when the user observes the desired effect on the device to be controlled by the remote control **10**, *indicating* that a compatible command set has been located.” '906 patent col. 6, ll. 54-57 (italic emphasis added). The patent thus describes that *the user* exits the setup procedure upon an indication (i.e., the desired effect) to *the user* that a compatible command set has been located. If exiting the setup procedure “indicates” anything to the remote control device, the indication is to select the current command set. We find no corresponding *structure* (e.g., a microprocessor executing one or more

algorithms) that may perform the claimed function of “indicating the halting of the actuation of the plurality of assignable user actuated switches or keys.”

V. Claim 16: “*means for setting the remote control to transmit future remote control commands from the command set containing the last transmitted effects observable command*”

Petitioner and Patent Owner agree that the “means for setting” clause of claim 16 must be construed in accordance with 35 U.S.C. § 112, sixth paragraph. Petitioner contends there is no structure suggested in the '906 patent to perform the claimed function. Pet. 17. Patent Owner responds that the corresponding structure is described in column 2, lines 49-53 and column 6, lines 51-58, with further reference to Figure 3D and column 4, lines 8-11 and 44-47. Prelim. Resp. 13.

While the '906 patent uses different forms of the word “setting,” such as “set” and “sets,” we find no corresponding *structure* for the claimed function of “setting the remote control to transmit future remote control commands from the command set containing the last transmitted effects observable command.” The patent describes “setting” the remote control as claimed but does not describe any structure (e.g., a microprocessor executing one or more algorithms) capable of performing the claimed function. In particular, we do not find any description of an algorithm for setting the remote control as claimed.

Claim 1 -- Anticipation by Telefunken (Ex. 1003)

Petitioner contends that Telefunken anticipates the method of claim 1.

Figure 3 of Telefunken is reproduced (from Ex. 1003) below.

| Gerät / Funktion | s | g | h | z | f |
|------------------|----------|----------|----------|-----------------------|-----------------------|
| Play | s (PLAY) | g (PLAY) | h (PLAY) | z (PLAY) =h (PLAY) | f (PLAY) =h (PLAY) |
| Rec | s (REC) | g (REC) | h (REC) | z (REC) | f (REC) |
| Stop | s (STOP) | g (STOP) | h (STOP) | z (STOP) | f (STOP) |
| Rew | s (REW) | g (REW) | h (REW) | z (REW) | f (REW) |
| ⋮ | ⋮ | ⋮ | ⋮ | ⋮ | ⋮ |

Fig.3

Telefunken's Figure 3 is said to depict the organization of a code memory table for a remote control unit for a video recording device. Telefunken at 7 (Ex. 1003 at 7).

An annotated version of Telefunken's Figure 3 (from Ex. 1003) is reproduced below.

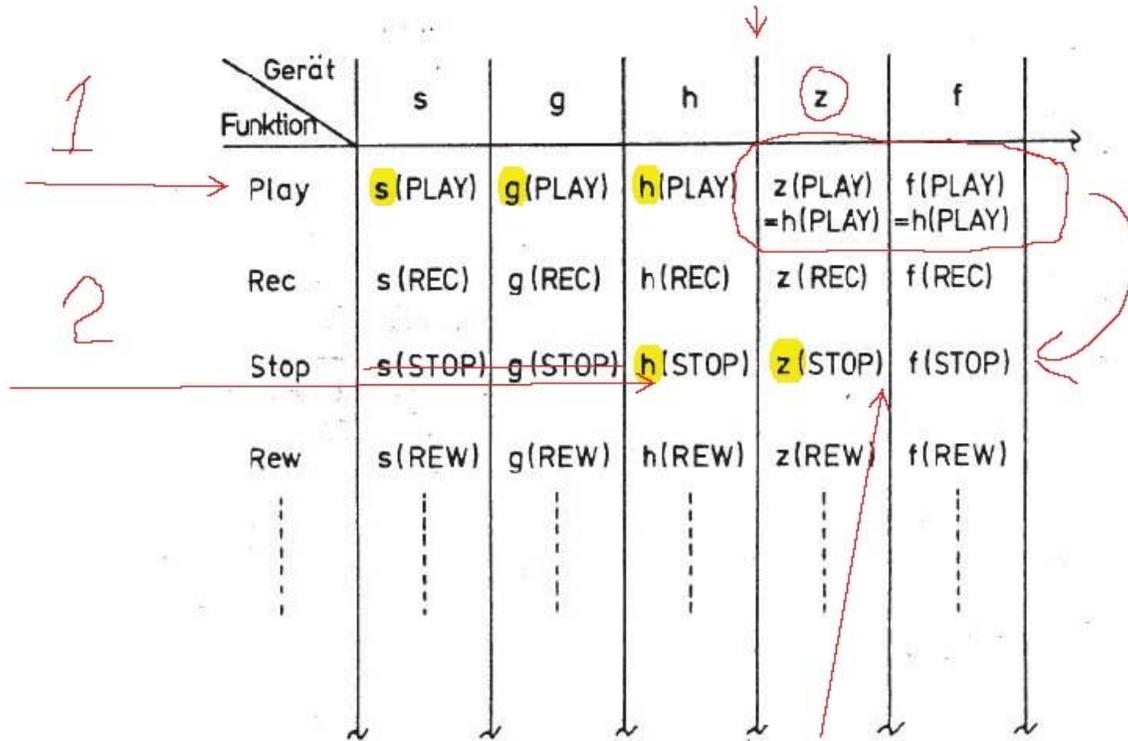


Fig.3

We have annotated Figure 3 to illustrate the exemplary programming of the remote control unit as described by Telefunken. As shown in the annotated version of the Figure, a start-up phase of operation commences with (1) actuation of the push button “PLAY.” The signals s (PLAY), g (PLAY), and h (PLAY) automatically and sequentially are generated and sent to the device to be controlled. If the user immediately releases the PLAY button after h (PLAY) is sent to the controlled device, the remote control unit registers the signal “h (PLAY)” as a remote control signal that triggers the function “PLAY” on the device to be controlled. However, there may be ambiguities in that “h (PLAY)” might also serve as a “PLAY” signal for other devices. For example, as depicted in Figure 3, a PLAY signal for an “h” type device might be identical, effectively,

to the PLAY signal for a “z” type device and an “f” type device. The remote control device consults a table for such ambiguities, with the result that when, in a second step (2), the user actuates the “STOP” button, the signals h (STOP), z (STOP), and f (STOP) are arranged to be transmitted in sequence. In the event that the user immediately releases the “STOP” button after the transmission of “z (STOP),” the device to be controlled is considered to be uniquely identified as responding to “z” control signals. That is, only the control signals specified in column “z” are used for controlling the device. Telefunken at 8-9.

Petitioner submits, *inter alia*, that Telefunken describes assigning an effects observable command from each of the plurality of command sets to one of the plurality of assignable user actuated switches or keys in accordance with claim 1, “*e.g.*, to one button, the ‘PLAY’ button.” Pet. 32. Petitioner further submits that Telefunken describes actuating, sequentially and individually, each one of the plurality of assignable user actuated switches or keys -- “*e.g.*, ‘different stored codes to be sequentially tried out,’ ‘PLAY’ button followed by ‘STOP’ button.” *Id.*

However, as we have noted in the claim interpretation section that addresses the limitations of claim 1, *supra*, proper interpretation requires that *the same* “effects observable command” from a command set (1) is assigned to one of the plurality of assignable user actuated switches and keys, (2) is to be transmitted when the corresponding one of the switches or keys is actuated, and (3) is to be transmitted as a consequence of sequential and individual actuation of each of the plurality of assignable switches or keys, until the proper effect is observed. Petitioner’s mapping of the limitations of claim 1 to the elements in Telefunken fails at least for the reason that Telefunken describes transmitting a *different* type

of effects observable command upon actuation of the second button in the sequence. In the method described by Telefunken, as Petitioner seems to acknowledge (Pet. 32), one button is actuated for a PLAY command, but the second button in the sequence results in transmission of a STOP command.

“[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986) (citation omitted), *overruled on other grounds by Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004). Petitioner has failed to identify any disclosure in Telefunken that meets all the requirements of claim 1. We conclude that Petitioner has not demonstrated a reasonable likelihood that claim 1 is unpatentable for being anticipated by Telefunken.

Claim 1 -- Obviousness

As with the application of Telefunken to claim 1 of the '906 patent, the Petition's discussion of the asserted grounds of obviousness with respect to claim 1 over the submitted prior art does not address all the actual requirements of the claim. Nor does the Herr Declaration (Ex. 1017) address all the actual requirements of claim 1. In short, the allegations fail to “specify where each element of the claim is found.” 37 C.F.R. § 42.104(b)(4).

Petitioner submits that claim 1 is unpatentable over the combination of Sony and Telefunken. However, critical limitations of claim 1 are alleged to be taught by Telefunken (*see, e.g.*, Pet. 38-39). Petitioner has not demonstrated that Telefunken teaches the critical limitations of claim 1 for the reasons set forth in our prior discussion of anticipation. Moreover, while Sony (Ex. 1005) might teach a one-to-one correspondence between an effects observable command and a user

actuated key (*e.g.*, col. 5, ll. 39-47), Petitioner has not identified any combination of Telefunken and Sony that might demonstrate the obviousness of all that claim 1 requires with respect to *the same* effects observable command.

Petitioner also offers the GHV-300 and GHV-500 references as base references in two grounds of unpatentability asserted against claim 1. The GHV references, which are substantially identical in relevant part, describe a TV remote control whereby in a code matching sequence the user presses a numeric key (*e.g.*, 1) along with the Power button, then presses the Power button to see if the TV turns off. If not, the process is repeated with the Power button and a next numeric key (*e.g.*, 2) until the proper matching code is found. *E.g.*, GHV-300 at 9 (Ex. 1006 at 10). The MRH7700 reference, which Petitioner offers in combination with the GHV references, describes identifying an effective command set by entering a three-digit numeric code, whereby if the code matches the TV, the TV will turn off. MRH7700 at 7 (Ex. 1009 at 7). The references thus teach two different ways of matching a remote control command set with a remote controlled device. Petitioner has not identified any combination of teachings that might demonstrate the obviousness of *the same* “effects observable command” from a command set (1) being assigned to one of the plurality of assignable user actuated switches and keys, (2) further is to be transmitted when the corresponding one of the switches or keys is actuated, and (3) is to be transmitted as a consequence of sequential and individual actuation of each of the plurality of assignable switches or keys, until the proper effect is observed.⁵

⁵ The parties dispute whether the GHV publications are prior art. We need not reach the issue because, even with the presumption that the publications represent prior art vis-à-vis the '906 patent, Petitioner’s assertion of unpatentability fails.

The GHV references also are offered against claim 1 in combination with Pioneer and Casio. Pioneer describes identifying a proper preset command set by pressing a remote control mode button (VCR1, VCR2, or TV), pressing next one of 12 buttons, and then determining whether the component can be operated by the selected preset code. Pioneer at 39 (Ex. 1010 at 39). Casio describes a remote control setting mode whereby each time a Power key is operated, power codes of sequentially different manufacturers are transmitted. Casio at 14 (unnumbered page) (Ex. 1004 at 14). As with the other proposed grounds against claim 1, Petitioner has not considered all the requirements of the claim with respect to the “effects observable command” and thus has not shown any combination of teachings in the presumed prior art references that might demonstrate the obviousness of the subject matter of claim 1.

In view of the foregoing, we conclude that Petitioner has not demonstrated a reasonable likelihood that claim 1 is unpatentable for obviousness over the applied prior art.

Claims 10 and 12 -- Obviousness

Claims 10 and 12 depend from claim 1. Petitioner asserts grounds of obviousness based on the combinations of: (1) Telefunken and Casio; (2) Sony, Telefunken, and Casio; (3) GHV-300/GHV-500 and MRH7700; and (4) GHV-300/GHV-500, Pioneer, and Casio. Because the grounds of unpatentability as asserted in the Petition do not remedy the deficiencies in the attempt to demonstrate the obviousness of base claim 1, we conclude that Petitioner has not demonstrated a reasonable likelihood that claims 10 and 12 are unpatentable for obviousness over the applied prior art.

Claim 16

The Petition applies Telefunken and various publications (Pet. 5-6) against claim 16 as being anticipated or obvious over the prior art. However, Petitioner construes each of the “means for assigning,” “means for indicating,” and “means for setting” limitations of claim 16 both as a “general purpose microprocessor” (Pet. 15-17) and as a microprocessor executing (non-existent) instructions in the patent drawings (*id.* at 33-35), neither of which is an acceptable interpretation of the limitations under 35 U.S.C. § 112, sixth paragraph.⁶

As indicated in the claim interpretation section, *supra*, we are unable to arrive at an interpretation of the requirements of claim 16 due to the lack of disclosed structure corresponding to the recited “means for assigning,” “means for indicating,” and “means for setting.” A lack of sufficient disclosure of structure under 35 U.S.C. § 112, sixth paragraph renders a claim indefinite, and thus not amenable to construction. *See In re Aoyama*, 656 F.3d 1293, 1298 (Fed Cir. 2011) (quoting *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010) (“If a claim is indefinite, the claim, by definition, cannot be construed.”)). In the circumstances of this case, we conclude that the information presented in the Petition and the Preliminary Response does not show there is a reasonable likelihood that Petitioner would prevail in its challenge of claim 16 in an *inter partes* review.

⁶ In a Markman Order in the related district court litigation, the District Court found there was no corresponding structure for the claimed “means for assigning,” “means for indicating,” and “means for setting.” Consequently, the District Court held that claim 16 of the '906 patent is indefinite as a matter of law. Ex. 1016 at 20-26.

III. CONCLUSION

Upon consideration of the Petition and Preliminary Response, we are not persuaded that there is a reasonable likelihood that Petitioner would prevail on at least one alleged ground of unpatentability with respect to claims 1, 10, 12 and 16 of the '906 patent. We, therefore, deny the petition for *inter partes* review and decline to institute trial on any of the asserted grounds as to any of the challenged claims. 37 C.F.R. § 42.108.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the petition is denied as to all challenged claims and no trial is instituted.

IPR2013-00152
Patent 5,614,906

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