IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

In re Application of: Darbee *et al*.

Patent No.: 6,587,067

Filed: February 23, 2001

Issued: July 1, 2003

Assignee: Universal Electronics, Inc.

Title: METHOD FOR SELECTING A REMOTE CONTROL COMMAND SET

Universal Remote Control, Inc.

v.

Universal Electronics, Inc.

Case No. IPR2013-00127

Trial Paralegal: Andrew Kellogg

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

TABLE OF AUTHORITIES

I. PATENT OWNER HAS NOT PROVED A DATE OF INVENTION EARLIER THAN THE PRIOR ART REFERENCES

Patent Owner spends the vast majority of its Response not in attacking the merits of Petitioner's prior art references (for good reason), but rather in trying to convince the Board that the references do not qualify as prior art. Although the supporting declaration of Richard Ellis (one of the co-inventors of the '067 patent) makes passing reference to conception of the invention at some unspecified time in 1986, there is no corroborating evidence to support such conception, and neither he nor Patent Owner has made any attempt to show diligence from such conception to a later reduction to practice. Accordingly, Patent Owner's attempt to antedate Magnavox, Evans, Wozniak and CORE[1] is based entirely on proving a reduction to practice date that predates those references. As shown below, Patent Owner has failed to prove such earlier reduction to practice.

A. Patent Owner Has Offered No Independent Proof Beyond The Co-inventor's Testimony To Corroborate Reduction To Practice

In its Preliminary Response, Patent Owner attempted to remove the Magnavox, Evans, Wozniak and CORE references by referring to a Rule 131 declaration filed by co-inventor Darbee in connection with the prosecution of the great, great grandparent application to the '067 patent. In its Decision, the Board correctly refused to allow the use of the Darbee declaration in this *inter partes*

[1] Patent Owner is not attempting to antedate the Rumbolt reference.

review proceeding. Nevertheless, the Board did examine the materials submitted with the Darbee declaration and found they were insufficient to show either conception, reduction to practice or diligence. Specifically, the Board found that the user manuals were not evidence of a prior reduction to practice and that "Neither the Darbee Declaration nor the Preliminary Response points to any evidence and alleges that a universal remote control corresponding to the claimed invention(s) of the '067 patent was tested and determined to work as intended." (Decision at 11)

In an effort to cure the deficiencies in its reduction to practice proof, Patent Owner has submitted a new declaration of co-inventor Ellis (Ex. 2005), attaching all of the same documents originally included with the Darbee declaration along with some additional ones. However, neither the Ellis declaration nor the new supporting materials establish that the invention was reduced to practice prior to Magnavox, Evans, Wozniak or CORE.

In order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence. *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998). A rule of reason analysis is applied to determine whether an inventor's testimony has been sufficiently corroborated. *Id.* "[A]doption of the 'rule of reason' has not altered the requirement that evidence of corroboration must not depend solely on the inventor himself." *Reese v. Hurst*,

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