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(12) EX PARTE REEXAMINATION CERTIFICATE (8031st) United States Patent

Darbee et al.

(10) Number: **US 6,587,067 C1**

(45) Certificate Issued: **Feb. 15, 2011**

- (54) **UNIVERSAL REMOTE CONTROL WITH MACRO COMMAND CAPABILITIES**
- (75) Inventors: **Paul V. Darbee**, Santa Ana, CA (US); **Richard E. Ellis**, Garden Grove, CA (US); **Louis Steven Jansky**, Long Beach, CA (US); **Avram S. Grossman**, Santa Ana, CA (US)
- (73) Assignee: **Universal Electronics Inc.**, Cypress, CA (US)

(52) U.S. Cl. **341/176; 341/173; 345/169; 345/171; 384/E5.096**

(58) **Field of Classification Search** None
See application file for complete search history.

(56) **References Cited**

PUBLICATIONS

Steve Ciarcia "Build The Home Run Control System." *Byte* Apr. 1985, vol. 10, No. 4.

Steve Ciarcia "Build The Home Run Control System Part 2" *Byte* May 1985, vol. 10, No. 5.

Steve Ciarcia "Build The Home Run Control System Part 3" *Byte* Jun. 1985, vol. 10, No. 6.

"Home Run—Micromint's Home Control System Users Manual Rev 1.0", The Micromint, Inc., pp. 1-159, Apr. 1, 1985.

Reexamination Request:

No. 90/007,876, Jan. 17, 2006

Reexamination Certificate for:

Patent No.: **6,587,067**
Issued: **Jul. 1, 2003**
Appl. No.: **09/791,354**
Filed: **Feb. 23, 2001**

Certificate of Correction issued Sep. 14, 2004.

Related U.S. Application Data

- (63) Continuation of application No. 09/408,729, filed on Sep. 29, 1999, now Pat. No. 6,195,033, which is a continuation-in-part of application No. 07/990,854, filed on Dec. 11, 1992, now Pat. No. 6,014,092, which is a continuation-in-part of application No. 07/913,523, filed on Jul. 14, 1992, now abandoned, which is a continuation-in-part of application No. 07/586,957, filed on Sep. 24, 1990, now abandoned, which is a continuation-in-part of application No. 07/127,999, filed on Dec. 2, 1987, now Pat. No. 4,959,810, which is a continuation-in-part of application No. 07/109,336, filed on Oct. 14, 1987, now abandoned.

(51) **Int. Cl.**

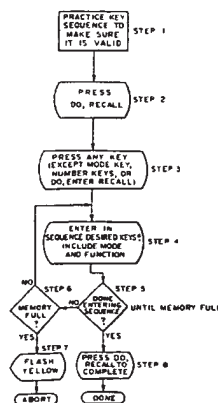
- G08C 19/28** (2006.01)
- G08C 23/04** (2006.01)
- G08C 19/16** (2006.01)
- G08C 23/00** (2006.01)
- H03J 1/00** (2006.01)
- H04B 1/20** (2006.01)
- H04B 10/10** (2006.01)
- H04N 5/44** (2006.01)
- H01H 9/02** (2006.01)

Primary Examiner—Woo H Choi

(57) **ABSTRACT**

A universal remote control comprising a keyboard having a plurality of pushbuttons including a macro pushbutton and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers. Instructions within the remote control are used match the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard. The instructions are also used to assign to the macro pushbutton a subset of the selected codes and data from the library whereafter activation of the macro pushbutton causes the universal remote control to use the subset of selected codes and data from the library to transmit operating commands to one or more of the matched home appliances.

SETTING A "DO" COMMAND MACRO



• e.g., TV, POWER, VCR 1, POWER, PLAT, TV, 3, ENTER

1
EX PARTE
REEXAMINATION CERTIFICATE
ISSUED UNDER 35 U.S.C. 307

NO AMENDMENTS HAVE BEEN MADE TO
THE PATENT

2
AS A RESULT OF REEXAMINATION, IT HAS BEEN
DETERMINED THAT:

5 The patentability of claims 1-6 is confirmed.

* * * * *



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,876	01/17/2006	6587067		7865

7590 11/16/2010
GREENBURG TRAURIG PC
77 W WACKER DRIVE
SUITE 2500
CHICAGO, IL 60101

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/16/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Kenneth D'Alessandro
Sierra Patent Group, Ltd
1657 Hwt 395, Suite 202
Minden, NV 89423

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,876.

PATENT NO. 658706Z.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

**Notice of Intent to Issue
Ex Parte Reexamination Certificate**

Control No. 90/007,876	Patent Under Reexamination 6587067	
Examiner Woo H. Choi	Art Unit 3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of

- (a) Patent owner's communication(s) filed: _____.
- (b) Patent owner's late response filed: _____.
- (c) Patent owner's failure to file an appropriate response to the Office action mailed: _____.
- (d) Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
- (e) Other: BPAI decision: September 13, 2010.

Status of *Ex Parte* Reexamination:

- (f) Change in the Specification: Yes No
- (g) Change in the Drawing(s): Yes No
- (h) Status of the Claim(s):

- (1) Patent claim(s) confirmed: 1-6.
- (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
- (3) Patent claim(s) canceled: _____.
- (4) Newly presented claim(s) patentable: _____.
- (5) Newly presented canceled claims: _____.
- (6) Patent claim(s) previously currently disclaimed: _____
- (7) Patent claim(s) not subject to reexamination: _____.

2. Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."

3. Note attached NOTICE OF REFERENCES CITED (PTO-892).

4. Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).

5. The drawing correction request filed on _____ is: approved disapproved.

6. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).

- a) All b) Some* c) None of the certified copies have
- been received.
- not been received.
- been filed in Application No. _____.
- been filed in reexamination Control No. _____.
- been received by the International Bureau in PCT Application No. _____.

* Certified copies not received: _____.

7. Note attached Examiner's Amendment.

8. Note attached Interview Summary (PTO-474).

9. Other: _____.

Woo H. Choi/

Woo H. Choi *ESIC*

cc: Requester (if third party requester)

U.S. Patent and Trademark Office

PTOL-469 (Rev. 05-10)

Notice of Intent to Issue Ex Parte Reexamination Certificate

Part of Paper No 20101004




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BIB DATA SHEET

CONFIRMATION NO. 7865

SERIAL NUMBER	FILING or 371(c) DATE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.	
90/007,876	01/17/2006	341	3992		
APPLICANTS 6587067, Residence Not Provided; UNIVERSAL ELECTRONICS INC.(OWNER), CYPRESS, CA; JONATHAN D. HANISH(3RD. PTY. REQ.), MINDEN, NV; JONATHAN D. HANISH, MINDEN, NV;					
** CONTINUING DATA ***** This application is a REX of 09/791,354 02/23/2001 PAT 6,587,067 which is a CON of 09/408,729 09/29/1999 PAT 6,195,033 which is a CIP of 07/990,854 12/11/1992 PAT 6,014,092 which is a CIP of 07/913,523 07/14/1992 ABN which is a CIP of 07/586,957 09/24/1990 ABN which is a CIP of 07/127,999 12/02/1987 PAT 4,959,810 which is a CIP of 07/109,336 10/14/1987 ABN					
** FOREIGN APPLICATIONS *****					
** IF REQUIRED, FOREIGN FILING LICENSE GRANTED **					
Foreign Priority claimed <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No 35 USC 119(a-d) conditions met <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No Verified and Acknowledged <u>/WOO H CHOI/</u> Examiner's Signature	<input type="checkbox"/> Met after Allowance Initials	STATE OR COUNTRY	SHEETS DRAWINGS	TOTAL CLAIMS 6	INDEPENDENT CLAIMS 4
ADDRESS GREENBURG TRAURIG PC 77 W WACKER DRIVE SUITE 2500 CHICAGO, IL 60101 UNITED STATES					
TITLE UNIVERSAL REMOTE CONTROL WITH MACRO COMMAND CAPABILITIES					
FILING FEE RECEIVED 2520	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:		<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees (Filing) <input type="checkbox"/> 1.17 Fees (Processing Ext. of time) <input type="checkbox"/> 1.18 Fees (Issue) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit		

Reexamination 	Application/Control No. 90007876	Applicant(s)/Patent Under Reexamination 6587067
	Certificate Date	Certificate Number CI

Requester Correspondence Address: **Patent Owner** **Third Party**

Kenneth D'Alessandro
 Sierra Patent Group, Ltd
 1657 Hwy 395, Suit 202
 Minden, NV 89423

LITIGATION REVIEW <input type="checkbox"/>	whc (examiner initials)	04/04/2008 (date)
Case Name		Director Initials
None		<i>See Head to RY</i>

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
1. None	

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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
90/007,876 01/17/2006 6587067 7865

7590 09/13/2010
GREENBURG TRAUIG PC
77 W WACKER DRIVE
SUITE 2500
CHICAGO, IL 60101

EXAMINER

CHOI, WOO H

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

09/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UNIVERSAL ELECTRONICS, INC.

Appeal 2009-011530
Reexamination Control 90/007,876
Technology Center 3900
Patent No. 6,587,067

Decided: September 13, 2010

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
JAMES T. MOORE and ALLEN R. MacDONALD, *Vice Chief
Administrative Patent Judges*, and HOWARD B. BLANKENSHIP and
SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

Appeal 2009-011530
Reexamination Control 90/007,876
Patent No. 6,587,067

Universal Electronics, Inc. appeals under 35 U.S.C. § 134(b) and 35 U.S.C. § 306 from a final rejection of claims 1-6. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We reverse.

STATEMENT OF THE CASE

Reexamination Proceedings

A request for *ex parte* reexamination of U.S. Patent 6,587,067 (“the ‘067 patent”) was filed on January 13, 2006, by Kenneth D’Alessandro of Sierra Patent Group, Ltd., Reexamination Control No. 90/007,876.

The ‘067 patent, now expired, is entitled “Universal Remote Control with Macro Command Capabilities” and issued July 1, 2003, to Paul V. Darbee, Richard E. Ellis, Louis Steven Jansky, and Avram S. Grossman, based on Application No. 09/791,354, filed February 23, 2001. The earliest priority date claimed by the ‘067 patent is October 14, 1987. The ‘067 patent is said to be assigned to Universal Electronics, Inc., said to be the real party in interest.

Appellant’s Invention

Appellant’s invention relates to a universal remote control that includes a library of codes and data for use in transmitting operating commands to different home appliances made by different manufacturers. (Abstract.)

The Claims

Claim 1 is exemplary:

1. In a universal remote control comprising a keyboard having a plurality of pushbuttons including a macro pushbutton and a library of codes and data for use in

transmitting operating commands to a plurality of different home appliances of different manufacturers, a readable medium having instructions for performing steps comprising:

 matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard, the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances [sic] of different manufacturers to which the universal remote control is to be matched; and

 assigning to the macro pushbutton a subset of the selected codes and data from the library whereafter activation of the macro pushbutton causes the universal remote control to use the subset of selected codes and data from the library to transmit a plurality of operating commands to one or more of the matched home appliances.

The References

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Micromint, Inc., *Home Run Micromint's Home Control System Users Manual* 1-159 (1985) ("Micromint").

The Rejection

Claims 1-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Micromint.

Appellant relies upon the following rebuttal evidence:

Declaration under 37 C.F.R. § 1.132 of Patrick H. Hayes, dated June 10, 2008 ("Hayes Declaration").

Declaration under 37 C.F.R. § 1.132 of Alex M. Cook, Jr., dated June 10, 2008 ("Cook Declaration").

ISSUE

With respect to independent claims 1, 3, 4 and 6, Appellant argues that the Examiner improperly construed the terms “codes” and “data” and further argues that, when properly construed, Micromint does not teach a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, as claimed. (App. Br. 7-15; *see also* Reply Br. 2-6.)

The following dispositive issue is presented:

Under the proper claim construction, does Micromint teach a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers?

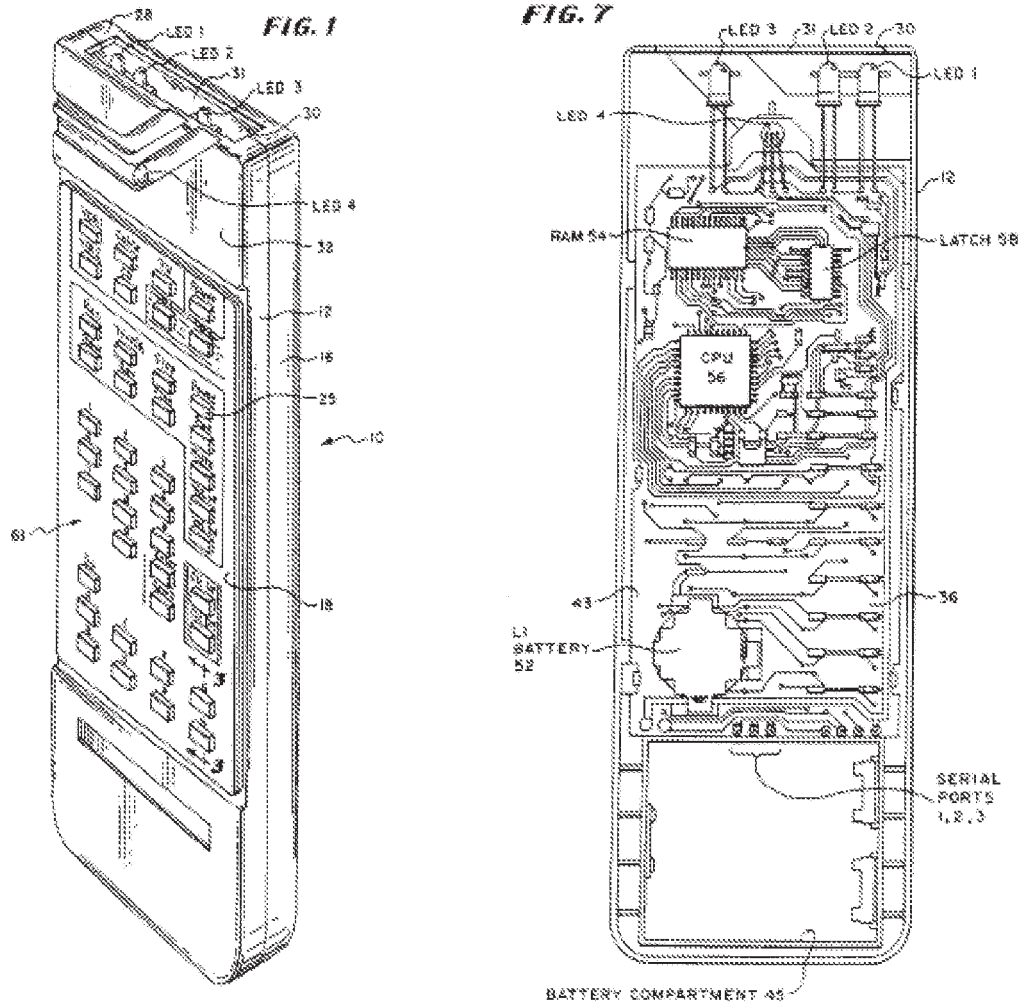
FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

'067 Patent

1. The '067 patent describes a universal remote control (col. 1, l. 42) that acquires infrared codes for a controlled apparatus (col. 1, ll. 49-51), such as a television, VCR, CD, cable converter, or other equipment (col. 8, ll. 37-40). The universal remote control generates code data related to the infrared codes for storage in a RAM (random access memory) as a library or table of code data. (Col. 1, ll. 51-56.) The code data is used to generate infrared codes for operating different electrical apparatus manufactured by different manufacturers. (Col. 1, ll. 57-58). Figure 1 (below) shows a perspective view of a universal remote control device. Figure 7 (below) shows a plan view of the

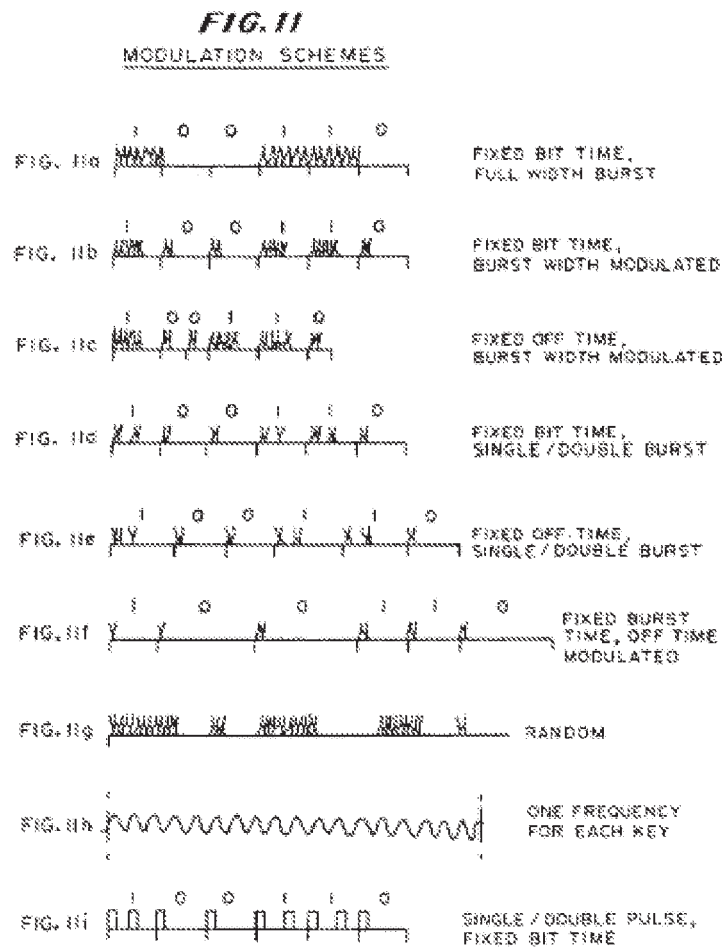
circuit board assembly mounted inside the universal remote control device.



2. The universal remote control device 10 includes a central processing unit (CPU) 56 and a read-write RAM 54. (Col. 2, ll. 35-41; col. 5, ll. 57-60; fig. 7.) The device 10 also includes light emitting diodes LED 1, LED 2, LED 3 (col. 4, ll. 54-56; fig. 1) and LED 4 (col. 4, ll. 59-60; fig. 1). LED 1, LED 2 and LED 3 are infrared light emitting diodes (col. 5, l. 67 to col. 6, l. 1) for communicating with the

controlled apparatus (col. 5, ll. 59-61). LED 4 is for communicating with the user of device 10 through red and green “blink codes.” (Col. 4, ll. 58-61; col. 5, ll. 63-64; fig. 1.)

3. The device 10 also can decipher infrared codes for operating various pieces of equipment (e.g., TV, VCR, CD player or cable converter). (Col. 8, ll. 33-40; fig. 1.) Figure 12b illustrates “a graph of the waveform of the captured, and later recreated, infrared codes, showing when the infrared signal is on and when it is off.” (Col. 10, ll. 7-9.) The CPU 56 executes IR-ON, IR-OFF and NOP (no operation) instructions for operating the infrared-emitting LEDs (i.e., LED 1, LED 2, and LED 3) such that “the infrared codes are transformed into a bit stream of 0’s and 1’s.” (Col. 10, ll. 9-15.)
4. As illustrated in Figure 11, the infrared codes can be characterized by several modulation schemes. (Col. 9, ll. 17-19; fig. 11.) In some embodiments, the modulation schemes include different carrier frequencies and gating schemes. (Col. 9, ll. 19-27; figs. 11a-11g.) Typical carrier frequencies range from 20 kHz to 45 kHz. (Col. 9, ll. 20-22.) Gating schemes include fixed and variable bit periods, non-return to zero, variable burst widths, single/double burst and a catch-all category. (Col. 9, ll. 22-27.) Figure 11 (shown below) shows graphical representations of several modulation schemes used in the universal remote control device.



5. In the Figure 11h embodiment, a continuous frequency (CW) modulation scheme is used. (Col. 9, ll. 28-30; fig. 11h.) In the Figure 11i embodiment, the modulation scheme does not use a carrier frequency and instead sends a stream of infrared pulses where the data is encoded in the spaces between the pulses. (Col. 9, 31-34; fig. 11i.)

Micromint

6. Micromint relates to a home control system (HCS), including a computer, that controls lights and appliances in a home. (P. 1, ¶ 1.) The HCS “senses presence in rooms, automatically turns lights on,

- raises the heat or lowers the air conditioning, and follows a variety (as opposed to one) of prescribed control sequences defined by the ‘real time’ assessment of the activities of the house occupants” (p. 7, ¶ 1). The HCS computer includes a keyboard console connected to a monitor for programming the home control system “by answering questions, or selecting items from a menu.” (P. 27, ¶ 3; fig. 10.) The HCS is designed around the concept of “events,” which are actions performed on a device or module. (P. 5, ¶ 6.) An “event” has four elements: (1) the type of event (e.g., ON/OFF or DIMMER); (2) the device on which the event operates; (3) a trigger that starts the event and; (4) a trigger that ends the event. (P. 5, ¶ 6; *see also* p. 101, ¶ 3.) All events entered into the HCS are stored in a RAM. (P. 106, ¶ 3; p. 12, ¶ 2.)
7. The HCS has as its central element a command controller that “sends commands to the receiver modules by coded messages sent through the AC power lines.” (P. 7, ¶ 4.) Receiver modules include lamp modules, wall switch modules, three-way wall switch modules and appliance modules for controlling “any appliance.” (P. 111, ¶¶ 1-4.) Each receiver module typically controls a single light or appliance. (P. 85, ¶ 2.) For example, any module can be turned on or off and the lamp module can be dimmed. (P. 44, ¶ 1.)
 8. A 9-bit command messages contains a 4-bit “house code” and a 5-bit “device code” (p. 8, ¶¶ 2, 4) that are “transmitted in true and inverted format on successive half cycles of the AC waveform” (p. 8, ¶ 4). “A logic 1 bit is three 1-millisecond bursts of 120 kHz signal

commencing approximately 200 microseconds after the zero crossing of the AC line. A logic 0 bit is represented by no signal for that half cycle.” (P. 8, ¶ 5.) Each receiver module monitors the AC line for “a coded message corresponding to its unique house code (A through P) and unit device code (1 through 16).” (P. 9, ¶ 1.) The HCS can accommodate a total of sixteen house codes with sixteen device codes for each house code. (P. 8, ¶ 2.)

ANALYSIS

Claim Interpretation

Claim interpretation necessarily precedes the addressing of questions of patentability. *See, e.g., Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997) (“Implicit in our review of the Board’s anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation.”).

“[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313. “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.* “[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best

guide to the meaning of a disputed term.” *Id.* at 1315 (internal citations omitted). However, it is improper to “import limitations into claims from examples or embodiments appearing only in a patent’s written description, even when a specification describes very specific embodiments of the invention or even describes only a single embodiment, unless the specification makes clear that ‘the patentee . . . intends for the claims and the embodiments in the specification to be strictly coextensive.’” *JVW Enters., Inc. v. Interact Accessories, Inc.*, 424 F.3d 1324, 1335 (Fed. Cir. 2005) (quoting *Phillips*, 415 F.3d at 1323). It is also improper to confine the claims to the specific embodiments disclosed in the specification. *Phillips*, 415 F.3d at 1323.

Interpretation of Expired Patent Claims

Appellant states that “[t]he subject reexamination proceeding involves claims of an expired patent.” (App. Br. 6).

In construing patent claims in a civil action in district court, “[t]he role [of claim construction] is neither to limit nor broaden the claim, but to define, as a matter of law, the invention that has been patented.” *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001). “‘Claim construction’ is the judicial statement of what is and is not covered by the technical terms and other words of the claims.” *Id.* That is, the district court provides a “definitive” or “true” or “exact” claim construction. By comparison, patent claims in a reexamination proceeding in the USPTO are ordinarily given their broadest reasonable interpretation consistent with the patent disclosure. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). When the patent has not expired, construing claims

broadly is not unfair to the patentee because the patentee has the opportunity to amend the claims to obtain more precise claim coverage. *Id.* However, claims of an expired patent may not be amended. 37 C.F.R. § 1.530(j).

The standard of claim construction for the claims of an expired patent in reexamination was addressed by the Board in *Ex parte Papst-Motoren*, 1 USPQ2d 1655 (BPAI 1986). The Board noted that *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984), held that claims in a reexamination proceeding should be given their broadest reasonable interpretation, consistent with the specification, because applicants had the right to amend, whereas in a district court, “claims should be so construed, if possible, as to sustain their validity.” *Yamamoto*, 740 F.2d at 1571 n.* (citing *ACH Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984)).

The Board held:

[I]n reexamination proceedings in which the PTO is considering the patentability of claims of an expired patent which are not subject to amendment, a policy of liberal claim construction may properly and should be applied. Such a policy favors a construction of a patent claim that will render it valid, i.e., a narrow construction, over a broad construction that would render it invalid.

Papst-Motoren, 1 USPQ2d at 1656; *Ex parte Bowles*, 23 USPQ2d 1015, 1017 (BPAI 1991) (both nonprecedential).² The Board also held in both *Papst-Motoren* and *Bowles* that it would be error to read “inferential

² Although *Papst-Motoren* is not designated as precedential, it was decided by an expanded panel of the Board of Patent Appeals and Interferences, including the Commissioner, the Deputy Commissioner, the Chairman of the Board, and an Examiner-in-Chief.

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Reexamination Control 90/007,876
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limitations” into the claims. *Papst-Motoren*, 1 USPQ2d at 1657; *Bowles*, 23 USPQ2d at 1017.

Papst-Motoren's holding that “claims should be so construed, if possible, as to sustain their validity” is another way of saying that the USPTO does not apply the “broadest reasonable interpretation” in construing the claims of an expired patent in a reexamination proceeding. The policy reason is that the claims in an expired patent cannot be amended. However, the maxim that “claims should be so construed, if possible, as to sustain their validity” is sometimes misunderstood and therefore, the Federal Circuit has clarified the maxim since *Papst-Motoren*. In accordance with those cases, it is clear that any claim construction must be in accord with the rules of claim construction and claims may not be redrafted. *See Generation II Orthotics Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1365 (Fed. Cir. 2001) (“[C]laims can only be construed to preserve their validity where the proposed claim construction is ‘practicable,’ is based on sound claim construction principles, and does not revise or ignore the explicit language of the claims.”); *Lucent Technologies, Inc. v. Gateway, Inc.*, 525 F.3d 1200, 1215-16 (Fed. Cir. 2008) (“This court has repeatedly held that courts may not redraft claims to cure a drafting error made by the patentee, whether to make them operable or to sustain their validity. To do so ‘would unduly interfere with the function of claims in putting competitors on notice of the scope of the claimed invention.’” (Citations and footnote omitted.)). The maxim is limited “to cases in which ‘the court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous.’” *Phillips*, 415 F.3d at 1327 (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*,

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Reexamination Control 90/007,876
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358 F.3d 898, 911 (Fed. Cir. 2004)). Importantly, it is “error . . . to use the possible invalidity of those claims, if broadly construed, as a basis for construing them narrowly.” *The Saunders Group, Inc. v. ComforTrac, Inc.*, 492 F.3d 1326, 1335 (Fed. Cir. 2007); *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, 279 F.3d 1357, 1367 (Fed. Cir. 2002) (“Fairness and the public notice function of the patent law require courts to afford patentees the full breadth of clear claim language, and bind them to it as well. Consequently, where such claim language clearly reads on prior art, the patent is invalid.”); *Phillips*, 415 F.3d at 1327 (“[W]e have certainly not endorsed a regime in which validity analysis is a regular component of claim construction.”); *Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999) (“[I]f the only claim construction that is consistent with the claim's language and the written description renders the claim invalid, then the axiom does not apply and the claim is simply invalid.”).

The maxim does not mean that claims should be construed more narrowly than is required by the rules of claim construction, as is sometimes misunderstood from cases such as *In re Prater*, 415 F.2d 1393, 1404 n.30 (CCPA 1969) (“By construing a claim as covering only patentable subject matter, courts are able, in appropriate cases, to hold claims valid in order to protect the inventive concept or the inventor's contribution to the art. The patentee *at that time* usually may not amend the claims to obtain protection commensurate with his actual contribution to the art.”) and *Yamamoto*, 740 F.2d at 1572 (“District courts may find it necessary to interpret claims to protect only that which constitutes patentable subject matter to do justice between the parties.”).

Papst-Motoren does not describe what sources of claim construction can be used. We assume for this appeal that a patentee is entitled to rely on any of the various intrinsic and extrinsic sources of claim meaning discussed in *Phillips*. It is patentee's burden to show how an argued narrower claim construction is supported by the evidence.

Papst-Motoren also does not state what methodology of claim construction should be used, e.g., whether the USPTO should consider all sources of evidence considered by district courts. Nevertheless, the USPTO always considers the specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (“[I]t would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description”). For purposes of this appeal, we assume that any type of evidence of claim meaning identified by *Phillips*, including prosecution history of the original patent, can be considered since patentee may not amend.

Interpretation of Specific Claim Terms

“Codes”

Appellant argues that, in the context of the '067 patent, “codes” for use in transmitting operating commands to a plurality of different home appliances of different manufacturers should be interpreted as “plural modulation schemes, carrier frequencies, bit encoding schemes, etc., i.e., systems of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages, that are to be used to transmit ‘data’ to plural different appliances.” (App. Br. 11.) To support this claim construction, Appellant refers to the Hayes Declaration and the Cook Declaration. (App. Br. 12.) Appellant also argues that “the specification makes clear that the ‘codes’

included in infrared codes are the same as the ‘several modulation schemes,’ different types of ‘carrier frequencies,’ etc., i.e., signal systems, that are likewise described within the specification as being included in infrared codes.” (Reply Br. 3.) We are not persuaded by Appellant’s arguments.

Appellant points to column 9, lines 14-27 of the ‘067 patent as the proper context for construing the claim term “codes.” (App. Br. 11-12.) Paragraphs 8-10 of the Hayes Declaration and paragraphs 7-9 of the Cook Declaration, which relate to the claim construction of “codes,” cite to the same text of the ‘067 patent for support. Column 9, lines 14-27 of the ‘067 patent discusses figures 11a-11g, which illustrate several different modulation schemes using a carrier frequency. (FF 4.) However, the Figure 11i embodiment illustrates a modulation scheme that sends a stream of pulses rather than using a carrier frequency. (FF 5.) Therefore, in the context of Figure 11, Appellant’s proposed claim construction of “codes” as meaning “plural modulation schemes, *carrier frequencies*, bit encoding schemes pattern of bits . . .” (second emphasis added) is overly narrow because such a construction excludes the Figure 11i embodiment. Also, while the ‘067 patent Specification describes “infrared codes” (FF 2-3), the term “infrared” is not recited in any of the independent claims and we decline Appellant's invitation to import it.

On the other hand, the Examiner points to the use of “blink codes” emitted from an LED (i.e., LED 4) in the Specification of the ‘067 patent (Ans. 10-11) and construes the term “code” as meaning “one of a set of symbols used to represent information or an assigned meaning” (Ans. 9). The “blink codes” are used to communicate with the user of the universal

remote control device 10, rather than to communicate with a controlled apparatus. (FF 2.) However, the claimed “codes” must be “for use in transmitting operating commands to a plurality of different home appliances.” In other words, the “blink codes” are not “codes” within the meaning of the claim because they do not transmit operating commands to a plurality of home appliances. Accordingly, the Examiner’s construction of the claim term “codes” is overly broad.

Figure 11 of the ‘067 patent illustrates multiple transmission schemes for relaying “data” to operate different electrical appliances. (FF 4.) Similarly, Figure 12b of the ‘067 patent describes “infrared codes” as “a graph of the waveform . . . showing when the infrared signal is on and when it is off” or “a bit stream of 0’s and 1’s” for the infrared-emitting LEDs. (FF 3.) Reading the claim term “codes” in the context of the entire patent, we interpret “codes” as transmission schemes for relaying “data” to a controlled apparatus.

“Data”

The Examiner construes the term “data” as meaning “information even when expressed with binary digits.” (Ans. 13.) Appellant argues that “data” should be more narrowly construed as a “pattern of bits, i.e., 0s and 1s, that are to be sent from the universal remote control to the appliances.” (App. Br. 10-11.)

However, we need not decide this issue. As will be discussed, Micromint fails to teach a library of codes and data under either the Examiner's or the Appellant's interpretation of “data.”

Rejection of Claims 1-6

Under the previously discussed claim interpretation, we agree with Appellant (App. Br. 14-15) that Micromint does not teach a *library of codes* and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers.

The Examiner found that the “house codes” and “device codes” transmitted from the command controller to receiver modules of Micromint correspond to the claimed “codes.” (Ans. 3-4, 12.) We do not agree.

Micromint relates to a home control system (HCS) for the “real time” control of various appliances. (FF 6.) The HCS can accommodate a total of sixteen house codes (letters A to P) and sixteen device codes (numbers 1 to 16) for each house code. (FF 8.) The HCS includes a command controller that uses unique 9-bit command messages to send commands through the AC power line to receiver modules. (FF 8.) The 9-bit command messages includes a 4-bit “house code” and a 5-bit “device code.” (FF 8.)

The “house codes” and “device codes” of Micromint are not transmission schemes for relaying “data” to a controlled apparatus, and therefore do not correspond to the claimed “codes.” Instead, the “house codes” and “device codes” of Micromint correspond to the claimed “data” under either the Examiner's construction of “data” (i.e., “information even when expressed with binary digits”) or the Appellant's construction of “data” (i.e., a “pattern of bits, i.e., 0s and 1s, that are to be sent from the universal remote control to the appliances”).

Regarding the claimed “codes,” Micromint teaches that the HCS command controller sends 9-bit command messages to the receiver modules

through the AC power line using bursts of a 120 kHz signal. (FF 7-8.) Micromint also teaches that a logic 1 bit is three 1-millisecond bursts of the 120 kHz signal commencing 200 microseconds after the zero crossing of the AC line. (FF 8.) Micromint further teaches that a logic 0 bit is represented by no signal for that half cycle. (FF 8.) This transmission scheme for relaying data to a controlled apparatus using bursts of a 120 kHz signal through the AC line is the only transmission scheme disclosed by Micromint. As discussed previously, the claimed “codes” are transmission schemes for relaying “data” to a controlled apparatus. Thus, Micromint teaches only a *single* “code” within the meaning of the claims.

In other words, rather than teaching multiple transmission schemes, Micromint teaches only a *single* transmission scheme for relaying a 9-bit command message (i.e., data) to the receiver module. Accordingly, Micromint does not teach *a library of codes* and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, as claimed.

Therefore, Micromint does not anticipate independent claims 1, 3, 4 and 6. Claims 2 and 5 depend from independent claims 1 and 4, and we conclude that Micromint does not anticipate these claims for the reasons discussed with respect to independent claims 1 and 4.

CONCLUSION

Based on the findings of fact and analysis above, we conclude that Micromint does not anticipate claims 1-6.

DECISION

The rejection of claims 1-6 under 35 U.S.C. § 102(b) is reversed.

Appeal 2009-011530
Reexamination Control 90/007,876
Patent No. 6,587,067

REVERSED

saw

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For Third Party Requester:

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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
90/007,876 01/17/2006 6587067 7865

7590 06/11/2009
GREENBURG TRAUIG PC
77 W WACKER DRIVE
SUITE 2500
CHICAGO, IL 60101

EXAMINER

CHOI, WOO H

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

06/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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CHICAGO, IL 60101

Appeal No: 2009-011530
Application: 90/007,876
Appellant: 6587067 et al.

**Board of Patent Appeals and Interferences
Docketing Notice**

Application 90/007,876 was received from the Technology Center at the Board on May 26, 2009 and has been assigned Appeal No: 2009-011530.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: August 11, 2008
Reply Brief filed on: February 23, 2009
Request for Hearing filed on: NONE

In all future communications regarding this appeal, please include both the application number and the appeal number.

The mailing address for the Board is:

**BOARD OF PATENT APPEALS AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VIRGINIA 22313-1450**

The facsimile number of the Board is 571-273-0052. Because of the heightened security in the Washington D.C. area, facsimile communications are recommended. Telephone inquiries can be made by calling 571-272-9797 and should be directed to a Program and Resource Administrator.

By order of the Board of Patent Appeals and Interferences.

cc: Third Party Requester

JONATHAN D. HANISH
SIERRA PATENT GROUP LTD
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,876	01/17/2006	6587067		7865

7590 04/03/2009
GREENBURG TRAURIG PC
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/03/2009

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Kenneth D'Alessandro
Sierra Patent Group, Ltd
1657 Hwt 395, Suite 202
Minden, NV 89423

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,876.

PATENT NO. 6587067.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90007876	1/17/06	6587067	

EXAMINER

Woo H.. Choi

ART UNIT	PAPER
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3992

20090402

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

REceipt of the Reply Brief filed February 23, 2009 is acknowledged. The case is forwarded to the BAIP for consideration.

Greenberg Traurig, LLP
77 W. Wacker Drive - Suite 3100
Chicago, IL 60601
(312) 456-8400
(312) 456-8435 (fax)

facsimile transmittal

To: Examiner Choi, Woo H. Fax: (571) 273-1586
 Art Unit 3992
 USPTO

From: Gary R. Jarosik Date: March 16, 2009

Re: Reply Brief - 90/007,876 Pages: 9 (including fax cover sheet)

Atty Docket No.
 81230.05US4

CC:

Urgent For Review Please Comment Please Reply Please Recycle

Notes: Pursuant to the phone conversation of today between Gary R. Jarosik and the Examiner, attached is a copy of the Reply Brief for application number 90/007,876 (USPN 6,587,067) originally mailed to the USPTO on February 18, 2009.

58,174,130v2

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	90/007,876	
	Filing Date	01/17/2006	
	First Named Inventor	Paul V. Darbee	
	Art Unit	3992	
	Examiner Name	Choi, Woo H.	
Total Number of Pages in This Submission	8	Attorney Docket Number	81230.05US4

ENCLOSURES <i>(Check all that apply)</i>		
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Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Customer No. 34018 - Greenberg Traurig, LLP		
Signature			
Printed name	Gary R. Jarosik		
Date	February 18, 2009	Reg. No.	35,906

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name	Sheri Fassl	Date	February 18, 2009

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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T-603 P.003/009 F-687

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	
Serial No.	90/007,876)	Examiner: Woo H. Choi
Patent:	6,587,067)	
)	Art Unit: 3992
)	

PAGE 3/3 * RCVD AT 3/16/2009 2:24:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-4/20 * DNIS:2731586 * CSID:3124568435 * DURATION (mm-ss):08-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	
)	Examiner: Woo H. Choi
Serial No.	90/007,876)	
)	
Patent:	6,587,067)	Art Unit: 3992
)	
Issued:	January 17, 2006)	
)	Attny Docket: 81230.05US4
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

REPLY BRIEF

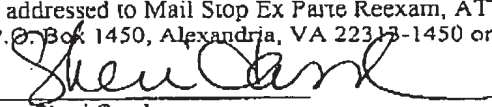
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Commissioner for Patents
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Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Reply to the Examiner's Answer dated December 19, 2008.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this document and it's enclosures are being deposited with the U.S. Postal Service via First Class Mail in an envelope addressed to Mail Stop *Ex Parte* Reexam, ATTN: Central Reexamination Unit, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 18th day of February 2009.



Sheri Fassl

REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellant hereby submits this Reply Brief in response to the Examiner's Answer.

Appellant agrees that the patentability of all of the claims at issue turns on the construction of the claim term "a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers."

Appellant further agrees that the claim term "a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" is to be construed in the context of the specification in which those words appear. Philips v AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005).

It is the position of Appellant that, *in the context of the subject patent*, the claim term "a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed as being a library of signal systems, i.e., codes, and numbers, i.e., data in the form of 0s and 1s to be conveyed using a signal system, for use in transmitting operating commands to a plurality of different home appliances of different manufacturers. Appellant has further taken the position that, *in the context of the subject patent*, the signal systems of the library, i.e., codes, can only be construed as further including, for each of the different appliances of different manufactures to which the universal remote control is to be matched, an appropriate carrier frequency, modulation scheme, and bit encoding scheme. (Ap. Br., pg. 7).

In support of this position Appellant has cited to the patent specification at Col. 9, lines 14-27 and Fig. 11. At Col. 9, lines 14-27, the specification clearly sets forth, with reference to Fig. 11, that infrared codes for use in transmitting operating commands to a plurality of different

home appliances of different manufacturers include "codes" (which carry data in the form of 0s and 1s as illustrated in Fig. 11) for operating different electrical apparatus manufactured by the same or different manufacturers and further clearly sets forth that infrared codes include "several modulation schemes," different types of "carrier frequencies," etc. Thus, by this plain language, Appellant respectfully submits that the specification makes clear that the "codes" included in infrared codes are the same as the "several modulation schemes," different types of "carrier frequencies," etc., i.e., signal systems, that are likewise described within the specification as being included in infrared codes. (Ap. Br., pg. 11).

While Appellant has demonstrated that, *in the context of the subject patent - particularly in the context of transmitting operating commands to appliances*, the claim term "a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed as being a library of signal systems, i.e., codes, and numbers, i.e., data in the form of 0s and 1s to be conveyed using a signal system, for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, it is respectfully submitted that the Examiner has elected to ignore the only definition of "code" that is supported by the specification, namely, a system of signals for communication, and has instead elected to adopt a definition of "code" that is only supported by the prior art being relied upon, namely, a system of symbols used to represent assigned and often secret meanings. (Ex. Ans., pgs. 8 and 9).

It is respectfully submitted that the failure of the Examiner to cite to any passages from the specification where the term "code" is used in the claimed context of transmitting operating commands to a plurality of different home appliances of different manufacturers to describe a system of symbols to represent assigned and often secret meanings evidences that the claim term

Application No. 90/007,876

“a library of codes...for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” cannot be construed to be a library of symbols, used to represent assigned and often secret meanings, e.g., house codes and device codes, as is being asserted. While the Examiner has cited to Cols. 11-14 of the subject application to demonstrate that “code” is being used to mean a set of symbols used to represent assigned meanings, it is respectfully submitted that Cols. 11 -14 have no relevance to the construction of the term “code” in the claimed context of transmitting operating commands to a plurality of different home appliances of different manufacturers. Rather, as acknowledged by the Examiner, the use of term “code” in Cols. 11-14 of the subject application is used not in the claimed context of transmitting commands to appliances but in **another context**, namely, in the context of blink back codes. (Ex. Ans., pg. 10) . Similarly, it is respectfully submitted that the Examiner’s reliance upon the use of the term “code” in the context of Micromint (Ex. Ans., pg. 11) cannot be said to evidence how the term “code” is to be construed when considered in the context of the subject patent.

It is further respectfully submitted that the construction of the claim term “...data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” is not irrelevant as asserted by the Examiner (Ex. Ans., pg. 13) but is highly relevant because the claims of the ‘067 patent recite **both** code and data, i.e., code data, for use in transmitting operating commands to a plurality of different home appliances of different manufacturers. In this regard, the Examiner has acknowledged that the Examiner’s construction of “code” encompasses “data” and that the Examiner’s construction of “data” encompasses “code.” (Ex. Ans., pg. 15). Thus, it is respectfully submitted that construction of the claims of the ‘067 being offered by the Examiner’s cannot stand up to close scrutiny as the Examiner’s

Application No. 90/007,876

proposed claim construction impermissibly renders the claimed “code...for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” redundant to or interchangeable with the claimed “...data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers.” As noted in Appellant’s Appeal Brief, because the claims of the ‘067 patent recite **both** code and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturer, the claimed “code” must be construed to have a meaning different than the claimed “data.” (Ap. Br., pgs. 14-15). To this end, it is only Appellant’s construction of the claim terms “code...for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” and “...data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers,” which is fully supported by the specification of the ‘067 patent, that provides non-redundant meanings to both of these positively recited claim elements.

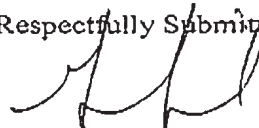
As concerns the Examiner’s assertion that the prosecution history of the ‘067 patent is irrelevant to the proper construction of the claims, Appellant respectfully notes that, while the evidence being relied upon by the current Examiner has a different title, the substance of what is disclosed within that reference is exactly the same as was considered by Examiners Wong and Horabik during the prosecution of the ‘067 patent. Accordingly, because it was previously determined under the “broadest reasonable interpretation” standard that the claims of the ‘067 patent did not encompass “house codes” and “device codes” of the prior art then considered, it is again respectfully submitted that under the narrower “ordinary and customary meaning” standard as set forth in Philips the claims cannot now be read on the exact same “house codes” and “device codes” that are disclosed within the now being relied upon Micromint.

It is additionally respectfully submitted that it is improper for the declarations of Patrick Hayes and Alex Cook, ones of ordinary skill in the relevant art, to be summarily dismissed for the reason that the conclusions drawn in those declarations do not agree with those drawn by the Examiner as to how the claims are to be construed. (Ex. Ans., pgs. 13 and 14).

Conclusion

Because it has been demonstrated that, *in the context of the subject application*, the claims of the '067 patent, which are directed to steps by which a remote control is matched to particular equipment, can only be construed as requiring a universal remote control that functions, for each of the plurality of different appliances of different manufacturers that the universal remote control is intended to be matched, i.e., to control, as directly indentified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, to select from the "library of codes and data" the particular signaling system, i.e., carrier frequency, modulation scheme, bit encoding scheme, etc., and bits, i.e., data in the form of 0s and 1s to be conveyed using the particular signaling system, that is appropriate for each home appliance so directly identified to the universal remote control and because it has been demonstrated that the claim construction being proposed by the Examiner fails to find any support within the specification of the '067 patent as is required by Philips it is respectfully submitted that the rejection of the claim under 35 U.S.C. § 102 must be withdrawn. Such action on the part of the reviewing Board is respectfully requested.

Respectfully Submitted;



Date: February 18, 2009

By: Gary R. Jarosik; Reg. No. 35,906
Greenberg Traurig, LLP
77 West Wacker Drive, Suite 2500
Chicago, Illinois 60601
(312) 456-8449

Application No. 90/007,876

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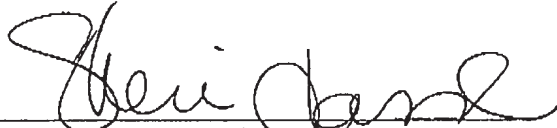
I declare that:

1. I am a citizen of the United States and am employed in the County of Cook, State of Illinois.
2. I am over the age of eighteen years and am not a party to this action.
3. My business address is 77 W. Wacker Drive, Suite 2500, Chicago, Illinois 60601-1732.
4. On February 18, 2009, I served a copy of this Reply Brief, filed in connection with Reexamination No. 90/007,876, by placing a copy of the same in a sealed envelope and mailing it via First Class Mail with the U.S. Postal Service, addressed as follows:

Jonathan D. Hanish
 Sierra Patent Group Ltd.
 1657 Hwy 395, Suite 202
 Minden, NV 89423

I declare under penalty of perjury in accordance with the laws of the State of Illinois that the foregoing is true and correct.

Date: February 18, 2009



 Sheri Fassi

CHI 57,845,666v1



02/23/09

PTO/SB/21 (01-09)

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TRANSMITTAL FORM	Application Number	90/007,876	
	Filing Date	01/17/2006	
	First Named Inventor	Paul V. Darbee	
	Art Unit	3992	
(to be used for all correspondence after initial filing)		Examiner Name	Choi, Woo H.
Total Number of Pages in This Submission	8	Attorney Docket Number	81230.05US4

ENCLOSURES (Check all that apply)		
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Date	February 18, 2009	Reg. No.	35,906

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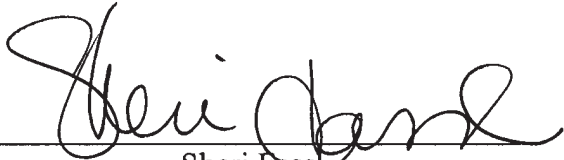
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2. I am over the age of eighteen years and am not a party to this action.
3. My business address is 77 W. Wacker Drive, Suite 2500, Chicago, Illinois 60601-1732.
4. On February 18, 2009, I served a copy of this Reply Brief, filed in connection with Reexamination No. 90/007,876, by placing a copy of the same in a sealed envelope and mailing it via First Class Mail with the U.S. Postal Service, addressed as follows:

Jonathan D. Hanish
Sierra Patent Group Ltd.
1657 Hwy 395, Suite 202
Minden, NV 89423

I declare under penalty of perjury in accordance with the laws of the State of Illinois that the foregoing is true and correct.

Date: February 18, 2009



Sheri Fass



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	
)	Examiner: Woo H. Choi
Serial No.	90/007,876)	
)	
Patent:	6,587,067)	Art Unit: 3992
)	
Issued:	January 17, 2006)	
)	Attny Docket: 81230.05US4
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

REPLY BRIEF

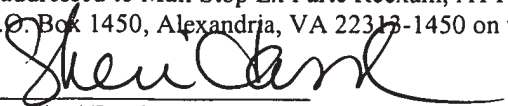
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Dear Sir:

Appellant hereby submits this Reply to the Examiner's Answer dated December 19, 2008.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

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 Sheri Fassl

REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellant hereby submits this Reply Brief in response to the Examiner's Answer.

Appellant agrees that the patentability of all of the claims at issue turns on the construction of the claim term "a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers."

Appellant further agrees that the claim term "a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" is to be construed in the context of the specification in which those words appear. Philips v AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005).

It is the position of Appellant that, *in the context of the subject patent*, the claim term "a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed as being a library of signal systems, i.e., codes, and numbers, i.e., data in the form of 0s and 1s to be conveyed using a signal system, for use in transmitting operating commands to a plurality of different home appliances of different manufacturers. Appellant has further taken the position that, *in the context of the subject patent*, the signal systems of the library, i.e., codes, can only be construed as further including, for each of the different appliances of different manufactures to which the universal remote control is to be matched, an appropriate carrier frequency, modulation scheme, and bit encoding scheme. (Ap. Br., pg. 7).

In support of this position Appellant has cited to the patent specification at Col. 9, lines 14-27 and Fig. 11. At Col. 9, lines 14-27, the specification clearly sets forth, with reference to Fig. 11, that infrared codes for use in transmitting operating commands to a plurality of different

home appliances of different manufacturers include “codes” (which carry data in the form of 0s and 1s as illustrated in Fig. 11) for operating different electrical apparatus manufactured by the same or different manufacturers and further clearly sets forth that infrared codes include “several modulation schemes,” different types of “carrier frequencies,” etc. Thus, by this plain language, Appellant respectfully submits that the specification makes clear that the “codes” included in infrared codes are the same as the “several modulation schemes,” different types of “carrier frequencies,” etc., i.e., signal systems, that are likewise described within the specification as being included in infrared codes. (Ap. Br., pg. 11).

While Appellant has demonstrated that, *in the context of the subject patent - particularly in the context of transmitting operating commands to appliances*, the claim term “a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” can only be construed as being a library of signal systems, i.e., codes, and numbers, i.e., data in the form of 0s and 1s to be conveyed using a signal system, for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, it is respectfully submitted that the Examiner has elected to ignore the only definition of “code” that is supported by the specification, namely, a system of signals for communication, and has instead elected to adopt a definition of “code” that is only supported by the prior art being relied upon, namely, a system of symbols used to represent assigned and often secret meanings. (Ex. Ans., pgs. 8 and 9).

It is respectfully submitted that the failure of the Examiner to cite to any passages from the specification where the term “code” is used in the claimed context of transmitting operating commands to a plurality of different home appliances of different manufacturers to describe a system of symbols to represent assigned and often secret meanings evidences that the claim term

“a library of codes...for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” cannot be construed to be a library of symbols, used to represent assigned and often secret meanings, e.g., house codes and device codes, as is being asserted. While the Examiner has cited to Cols. 11-14 of the subject application to demonstrate that “code” is being used to mean a set of symbols used to represent assigned meanings, it is respectfully submitted that Cols. 11 -14 have no relevance to the construction of the term “code” in the claimed context of transmitting operating commands to a plurality of different home appliances of different manufacturers. Rather, as acknowledged by the Examiner, the use of term “code” in Cols. 11-14 of the subject application is used not in the claimed context of transmitting commands to appliances but in **another context**, namely, in the context of blink back codes. (Ex. Ans., pg. 10) . Similarly, it is respectfully submitted that the Examiner’s reliance upon the use of the term “code” in the context of Micromint (Ex. Ans., pg. 11) cannot be said to evidence how the term “code” is to be construed when considered in the context of the subject patent.

It is further respectfully submitted that the construction of the claim term “...data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” is not irrelevant as asserted by the Examiner (Ex. Ans., pg. 13) but is highly relevant because the claims of the ‘067 patent recite **both** code and data, i.e., code data, for use in transmitting operating commands to a plurality of different home appliances of different manufacturers. In this regard, the Examiner has acknowledged that the Examiner’s construction of “code” encompasses “data” and that the Examiner’s construction of “data” encompasses “code.” (Ex. Ans., pg. 15). Thus, it is respectfully submitted that construction of the claims of the ‘067 being offered by the Examiner’s cannot stand up to close scrutiny as the Examiner’s

proposed claim construction impermissibly renders the claimed “code...for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” redundant to or interchangeable with the claimed “...data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers.” As noted in Appellant’s Appeal Brief, because the claims of the ‘067 patent recite **both** code and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturer, the claimed “code” must be construed to have a meaning different than the claimed “data.” (Ap. Br., pgs. 14-15). To this end, it is only Appellant’s construction of the claim terms “code...for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” and “...data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers,” which is fully supported by the specification of the ‘067 patent, that provides non-redundant meanings to both of these positively recited claim elements.

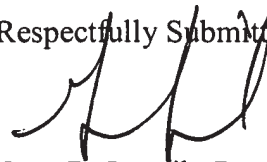
As concerns the Examiner’s assertion that the prosecution history of the ‘067 patent is irrelevant to the proper construction of the claims, Appellant respectfully notes that, while the evidence being relied upon by the current Examiner has a different title, the substance of what is disclosed within that reference is exactly the same as was considered by Examiners Wong and Horabik during the prosecution of the ‘067 patent. Accordingly, because it was previously determined under the “broadest reasonable interpretation” standard that the claims of the ‘067 patent did not encompass “house codes” and “device codes” of the prior art then considered, it is again respectfully submitted that under the narrower “ordinary and customary meaning” standard as set forth in Philips the claims cannot now be read on the exact same “house codes” and “device codes” that are disclosed within the now being relied upon Micromint.

It is additionally respectfully submitted that it is improper for the declarations of Patrick Hayes and Alex Cook, ones of ordinary skill in the relevant art, to be summarily dismissed for the reason that the conclusions drawn in those declarations do not agree with those drawn by the Examiner as to how the claims are to be construed. (Ex. Ans., pgs. 13 and 14).

Conclusion

Because it has been demonstrated that, *in the context of the subject application*, the claims of the '067 patent, which are directed to steps by which a remote control is matched to particular equipment, can only be construed as requiring a universal remote control that functions, for each of the plurality of different appliances of different manufacturers that the universal remote control is intended to be matched, i.e., to control, as directly indentified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, to select from the "library of codes and data" the particular signaling system, i.e., carrier frequency, modulation scheme, bit encoding scheme, etc., and bits, i.e., data in the form of 0s and 1s to be conveyed using the particular signaling system, that is appropriate for each home appliance so directly identified to the universal remote control and because it has been demonstrated that the claim construction being proposed by the Examiner fails to find any support within the specification of the '067 patent as is required by Philips it is respectfully submitted that the rejection of the claim under 35 U.S.C. § 102 must be withdrawn. Such action on the part of the reviewing Board is respectfully requested.

Respectfully Submitted;



Date: February 18, 2009

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,876	01/17/2006	6587067		7865

7590 12/19/2008
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/19/2008

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,876.

PATENT NO. 6587067.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 90/007,876
Filing Date: January 17, 2006
Appellant(s): 6587067

Gary R. Jarosik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 11, 2008 appealing from the Office action mailed April 11, 2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

Home Run Micromint's Home Control System User's Manual, Rev. 1.0, The Micromint Inc., Terrace Drive, Vernon, Connecticut 06066, April, 1, 1985, pp. 1-159 ("Micromint")

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Micromint.

3. With respect to claim 1 Micromint discloses **in a universal remote control** (page 1, The Home Run HCS is a single board computer that can remotely control lights and appliances in a home) **comprising a keyboard having a plurality of pushbuttons** (page 27, Figure 10; see also page 1, HCS can use any terminal, or a personal computer emulating a terminal) **including a macro pushbutton** (page 2, superkey, HCS has 16 function keys which cause a user defined list of actions to be performed when the appropriate key is entered. This allows a complete sequence of events to be transmitted.) **and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers** (page 8,

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BRS system can accommodate 256 independently addressable receivers, i.e., a library of 256 codes; see also page 44, HSC has a library of codes and data for use in transmitting operating commands such as ON, OFF, DIM, etc. to multiple appliances, each of which can be of different manufacturer), **a readable medium having instructions** (page 12, RAM and ROM used to run HCS is disclosed) **for performing steps comprising:**

matching the universal remote control to a plurality of different home appliances of different manufacturers (see page 44, HCS can be matched with 16 different home appliances of different manufacturers) **such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard** (page 44 show that in response to activation of selected pushbuttons, e.g., 1Y2N3DDD <Ret>, selected codes and data from the library, i.e. 8 bit BRS address codes and commands, are used to transmit operating commands to three different appliances), **the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched** (page 44, numeric keys of the keyboard can be pressed, or activated, to directly identify three different home appliances, each of which can be of different manufacturer, matched to the HCS as modules 1, 2, and 3, respectively); **and**

assigning to the macro pushbutton a subset of the selected codes and data from the library (pages 65 – 67, a superkey can be programmed to associate a subset of selected codes, for example, a code for a thermostat that is matched as module 1, a code for a coffee pot matched as module 9, and code for an alarm system matched as module 4, and data from the library) **whereafter activation of the macro pushbutton causes the universal remote control to use**

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the subset of selected codes and data from the library to transmit a plurality of operating commands to one or more of the matched home appliances (activation of superkey causes transmission of associated command sequence to turn down the heat, turn off the coffee pot, and activate the alarm system, in the example shown on pages 65 – 67).

4. With respect to claim 2, **the instructions further perform the step of using activation of one or more pushbuttons of the keyboard to assign the subset of the selected codes and data from the library to the macro pushbutton** (pages 65 – 67 shows a specific example of assigning the subset of selected codes and data from the library to a superkey using the keyboard).

5. With respect to claim 3, **in a universal remote control comprising a keyboard having a plurality of pushbuttons and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, a readable medium having instructions for performing steps comprising** (see rejection of claim1 above):

matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard (see rejection of claim 1 above); and

using activation of one or more pushbuttons of the keyboard to match the universal remote control to the plurality of different home appliances of different manufacturers

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(Each BRS receiver requires a device code and a house code. See page 8. HCS requires the use of the key buttons on the keyboard to set the house code to match the plurality of appliances associated with the BRS receivers to the HCS. Remote appliances will not respond to HCS control unless the house code is matched. See page 103, house code. See also pages 36 – 38, the keyboard is also used to match module 1 to front porch light. Alternatively, manual control command “C” can also be used via the keyboard to match an appliance to a particular module recognized by HCS. For example, by manually sending ON/OFF command to module 1, HCS user can match a particular appliance to HCS module 1 and verify that the appliance is matched to module 1.);

instructions further perform the step of using activation of one or more of the pushbuttons of the keyboard to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched (see page 44, each of the plurality of different home appliances of different manufacturer can be identified directly as modules 1, 2, and 3. Alternatively, each appliance can be identified directly by sending manual commands and observing it respond to commands. See also pages 36 – 38, the keyboard is used to directly identify the front porch light.).

6. **With respect to claims 4 and 5, see rejections of claims 1 and 2 above, respectively.**
7. With respect to claim 6, see rejection of claim 1 or 3.

(10) Response to Argument

The Examiner notes that the only issue raised by Appellants in this case is the construction of the claim element “a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers.” This element is common to all of the independent claims and all of patent owner's arguments are directed to the construction of the limitation in quote. Therefore, the patentability of all claims turns on the proper construction of the claim element in dispute.

Claim Construction Standard and Principles

As the patent owner noted at page 6 of the Brief, because the '067 patent term has expired and the claims cannot be amended, the claims are to be construed using the “ordinary and customary meaning” standard during reexamination. “The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” Phillips v AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005). Also, as patent owner also noted at page 6 of the Brief, the elements of the claims of the '067 are to be construed in the context of the specification in which those words appear. “In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of widely accepted meaning of commonly understood words.” Id. at 1314. In other words, the examiner is in full agreement with the patent owner as to the proper claim construction standard to be used in reexamination proceeding as well as the claim

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construction principles set forth in Phillips. However, the Examiner disagrees with the patent owner's interpretation of the disputed limitations under the applicable standards as discussed below.

“Codes for use in transmitting operating commands of different manufacturer”

Patent owner first asserts that the claimed “codes for use in transmitting operating commands of different manufacturers” can only be understood by one of ordinary skill in the art to mean the carrier frequencies, modulation schemes, and bit encoding schemes that are used to transmit data (i.e., 0s and 1s) from the universal remote control to different appliances of different manufacturers, i.e., a system of signals used to represent number (i.e., 0s and 1s) in transmitting messages of different appliances of different manufacturers. Brief at p. 7. Appellant's proposed construction equates the claim term “codes” to carrier frequencies, modulation schemes, and bit encoding schemes. This construction is directly contrary to the principles set forth in Phillips. By definition, a carrier frequency is a frequency, not a code. Modulation is a process of changing the characteristics of a carrier wave to embed encoded information (digital or analog) onto the carrier wave for transmission. Bit encoding schemes are methods used to convert electrical signals to represent binary digits for transmission through certain media. These are all means for transmitting information such as codes and data as the terms are used in the specification. They are not codes or data themselves.

Although the term "code" can mean many different things, only the following definitions are applicable in the context of transmitting commands in a remote control system: 1) a system

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of signals or symbols for communication, and 2) a system of symbols (as letters or numbers) used to represent assigned and often secret meanings (See Merriam-Webster's Collegiate Dictionary, Tenth Edition and Microsoft Computer Dictionary, Fifth Edition.) In the context of the claim and the patent specification, however, one skilled in the art would understand the term "code" as used in the specification and the claims to mean one of a set of symbols used to represent information or an assigned meaning.

This interpretation is consistent with the usage of the term "code" in the specification and the claims. At page 11 of Brief, Appellant quotes a passage from the patent specification at column 9, lines 14-27:

The infrared codes to be learned include a wide range of different codes for operating different electrical apparatus manufactured by the same or different manufacturers. In FIG. 11, which is identical to FIG. 1 in U.S. Pat. No. 4,623,887, there are illustrated several modulation schemes for infrared codes. FIGS. 11a-11g illustrate different types of gated carrier frequencies. Typical carrier frequencies for infrared remote transmitters are 20 Khz to 45 Khz, with the majority being at 38 Khz and 40 Khz. The gating schemes illustrated include both fixed and variable bit periods, non-return to zero (NRZ), variable burst widths, single/double burst modulation schemes, and a final catch-all category called random because there is no readily distinguishable pattern of ones and zeros. Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed. (*emphasis added*)

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The underlined portion of the passage clearly shows that the term code was not meant as a carrier frequency, modulation scheme, and a bit encoding scheme as Appellants contend because the phrase "several modulation schemes for infrared carrier frequencies, modulation schemes, and bit encoding schemes (such as NRZ encoding)" would make no sense. At column 1, lines 42-60, the specification states:

Additionally, the present invention relates to a method for acquiring the infrared codes for a controlled apparatus, such as a television, generating code data related to these infrared codes for storage in a remote control device and methods for using the remote control device for finding, in a library or table of code data for generating infrared codes for operating different electrical apparatus ... and then using the stored code data for generating the coded infrared signals for operating the controlled apparatus.

The above paragraph discloses that a library of code data that is stored (the Examiner notes that storage of a library of code data is not claimed) is used for generating coded infrared signals.

The specification clearly distinguishes the library of codes from the coded infrared signals that are transmitted. Thus, Appellants' assertion that the term code as used in the specification and the claims means "a system of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages to different appliances of different manufactures" (Brief, page 7) is directly contradicted by the specification itself.

The specification also uses the term "code" in another context. The specification discloses "blink codes" in Table 1, at columns 11-14 and Figure 19. These codes identify what equipment or apparatus the remote control device is set to (see column 14, lines 22-25, "FIG. 19A sets forth ... the various blink codes which identify what equipment or apparatus the remote control device 10 is set to.") Contrary to Appellants' arguments that in the context of the

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specification the term codes in the limitation in question can only mean the carrier frequencies, modulation schemes and bit encoding schemes that are used to transmit data, the term "code" here was used to mean a symbol, consisting of a color coded pattern of blinking LEDs, in a set of symbols used to represent assigned meanings, with a specific code assigned to represent a specific equipment or apparatus.

The prior art of record also provides evidence of the usage of the term "code" in the relevant art of remote control. The Micromint remote control system uses the term "house code" and "device code" to mean a specific symbol (a pattern of bits) used to represent a specific "house" or a "device" just as the term "blink code" is used to represent a specific equipment or apparatus in the patent itself. Thus the Examiner's interpretation of the term "code," as a symbol in a set of symbols used to represent an assigned meaning, comports with the '067 patent, the usage of the term in the art as evidenced by Micromint, and the dictionary definition.

Appellants further argues that "in the context of the '067 patent, the claim term "library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturer" can only be understood by one of ordinary skill in the relevant art that the universal remote control includes, for each of the different appliances of different manufacturer to which the universal remote control may be matched, a tabulation of an appropriate carrier frequency, modulation scheme, and bit encoding scheme, i.e., a system of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages to different appliances of different manufacturers, and data such that the universal remote control is

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adaptable to transmit communications that will be recognized by the intended target appliance." Brief at page 9. The above element of the claim in quote appears as a limitation in the preamble of all claims. According to Appellants' argument, the only possible construction of the limitation must include importation of means for transmission (carrier frequency, modulation scheme, encoding scheme) discussed in the specification, importation of other limitations from the body of the claims (matching remote control to appliances) and other acts from unknown sources (tabulation of carrier frequency, and recognition by the target appliance). The Examiner is not aware of any claim construction principle that requires such wholesale importation of limitations from different sources. Prohibition against importation of limitation from the specification is a firmly established principle in patent law ("In Phillips, we held that while "the specification [should be used] to interpret the meanings of a claim," court must not "**import[] limitations** from the specification into the claim." "In re Trans Texas Holdings Corp., 498 F.3d 1290, 1294 (Fed. Cir. 2007)) (emphasis in the original).

When properly construed, the library of codes limitation is simply a set of codes (a set of symbols used to represent an assigned meaning), such as the BRS house and device codes, that are for use in transmitting operating commands to a plurality of home appliances of different manufactures. BRS codes are used to transmit operating commands such as ON, OFF, DIM, etc. commands to different appliances, such as light switches (see Micromint, page 73), electric blankets (see Micromint, page 68), and CRT monitors (see Micromint, Page 85) of different manufacturers. The Examiner also notes that Appellants have not argued that the matching step in the body of the claims is not taught by Micromint.

“Data for use in transmitting operating commands of different manufacturer”

Appellants further argue that in the context of the specification of the '067 patent, the claimed “data for use in transmitting operating commands to a plurality of different home appliances of different manufacturer” can only be construed by one of ordinary skill in the relevant art to mean patterns of bits, i.e., 0s 1s, that are to be sent from the universal remote control to the appliances. Brief, pp. 10-11. The term “data” requires no special construction as it is a term well known to most people. While the Examiner does not agree with Appellant’s contention that data means patterns of bits, because data means information even when expressed with binary digits, Appellants' argument seems irrelevant as Appellants do not allege that Micromint does not teach data for use in transmitting operating commands of different manufacturers. Instead, Appellant repeats the same argument made in the Overview section of the Brief. As discussed above, the limitation "library of codes and data for use ..." does not require any matching, tabulation, recognition, or transmission. It merely requires that the library of codes and data **for use** in transmitting commands. Micromint discloses a library codes (such as house and device codes) and data (command data such as on/off/dim signals) for use in transmitting remote control commands to the controlled appliances.

As to the declarations of Patrick Hayes and Alex Cook, they only contain opinions and conclusions of an employee of the patent owner and someone hired and paid by the patent owner to offer an opinion, which apparently is consistent with the incorrect construction of the claim terms proposed by Appellants. “[C]onclusory, unsupported assertions by experts as to the

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definition of a claim term are not useful to a court. Similarly, a court should discount any expert testimony "that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent." Pillips, at 1318. Appellants' proposed claim construction is clearly at odds with the claim construction mandated by the written record of the patent.

Supports for the examiner's construction of the claims

Appellants allege that the Examiner's claim construction is improper because of the Examiner's reliance upon a selected dictionary definition and Micromint divorced from the specification of the '67 (see Brief, p. 13.) Contrary to Appellants' allegation, as discussed in details above, the Examiner's construction of the limitation in dispute is fully consistent with the specification, usage of the term "code" in the relevant art as evidenced by the prior art of record, and a dictionary definition. On the other hand, Appellants' proposed construction distorts the language of the claims by 1) conflating codes with transmission schemes, 2) importing limitations from the specification and other unknown sources, and 3) adding other limitations that are not present in the language of the claims.

As to Appellants' discussion of the prosecution history, Appellants' characterization of prior examiners' determination in a prior proceeding based on one prior art reference is irrelevant in a reexamination proceeding that is based on a different prior art reference conducted by a different examiner.

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Appellants' last argument is that it would be improper to construe the claimed "codes" in a manner that renders the claimed "codes" equivalent to the properly construed, claimed "data," i.e., patterns of 0s and 1s such as the "house codes" and "device codes" of Micromint, as such a claim construction would impermissively render the separately claimed "codes" redundant to the claimed "data." This argument is not persuasive because, 1) Appellants misconstrue the term "data" as a pattern of bits, and 2) the rejection clearly states that Micromint discloses a library codes (such as house and device codes) and data (command data such as on/off/dim signals) for use in transmitting remote control commands to the controlled appliances. Micromint also discloses that both the house code and the device code is used to transmit remote control commands to a specified device to be controlled. As discussed above, data means information, whether in analog form, or digital form or any other form. The claimed "data" reads on both the house code and the device code because its meaning encompasses all forms of information including codes. Thus, a code can be both a code and data at the same time. Because Micromint uses two codes the claim limitation "code and data" reads on the Micromint's use of a house code and a device code even if we exclude command signals which are also data.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Woo H. Choi
Primary Examiner
CRU 3992

Conferees:



Eric Keasel
Supervisory Examiner
CRU 3992



Albert Gagliardi
Primary Examiner
CRU 3992



08/11/08

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<h1>TRANSMITTAL FORM</h1> <p><i>(to be used for all correspondence after initial filing)</i></p>	Application Number	90/007,876	
	Filing Date	01/17/2006	
	First Named Inventor	Paul V. Darbee	
	Art Unit	3992	
	Examiner Name	Woo H. Choi	
Total Number of Pages in This Submission	39	Attorney Docket Number	81230.05US4

ENCLOSURES <i>(Check all that apply)</i>				
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): - Appeal Brief - Declaration of Patrick H. Hayes;		
<table border="1" style="width: 100%;"> <tr> <td style="width: 30%;">Remarks</td> <td> - Declaration of Alex M. Cook, Jr.; - return postcard </td> </tr> </table>			Remarks	- Declaration of Alex M. Cook, Jr.; - return postcard
Remarks	- Declaration of Alex M. Cook, Jr.; - return postcard			

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Greenberg Traurig, LLP Customer No. 34018		
Signature			
Printed name	Gary R. Jarosik		
Date	August 8, 2008	Reg. No.	35,906

CERTIFICATE OF TRANSMISSION/MAILING			
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Typed or printed name	Sheri Fassl	Date	August 8, 2008

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08/11/08

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	Examiner: Woo H. Choi
)	
Reexam Control No.:	90/007,876)	Attny Doc.: 81230.05US4
)	
Filing Date:	01/17/2006)	Art Unit: 3992
)	
Patent No.:	6,587,067)	
)	
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

APPEAL BRIEF

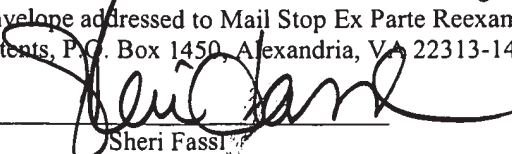
Mail Stop Ex Parte Reexam
ATTN: Central Reexamination Unit
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Appeal Brief in connection with the appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-6 which rejection was set forth in the Office Action mailed April 11, 2008. A timely Notice of Appeal was filed.

The Commissioner is hereby authorized to charge any fee deficiency to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this document and it's enclosures are being deposited with the U.S. Postal Service via First Class Mail in an envelope addressed to Mail Stop Ex Parte Reexam, ATTN: Central Reexamination Unit, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8th day of August 2008.


 Sheri Fassl

I. Real Party In Interest

The real party in interest is Universal Electronics Inc.

II. Related Appeals And Interferences

Appellant is not aware of any related appeals or interferences which would directly affect, or would be directly affected by or have a bearing on the Board's decision in the subject appeal.

III. Status Of The Claims

In the application claims 1-6 remain pending and having been finally rejected are the subject of this appeal.

The Section VIII appendix provides a clean, double spaced copy of pending claims 1-6.

IV. Status Of Amendments

The claims are in condition for appeal – no amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

In accordance with 37 CFR § 41.37(c)(1)(v), the following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal with reference, by way of example only, to the specification by paragraph number and to the drawings by reference characters, if applicable:

Independent claim 1 is directed to a readable medium having instructions for performing steps in a universal remote control 10 (Figs. 1 and 7; Col 1, lines 42-48) comprising a keyboard having a plurality of pushbuttons 25 (Fig. 15, Col. 4, lines 34-57; Col. 5, lines 33-44) including a macro pushbutton (Col. 14, line 14-Col 15, line 10) and a library (Col. 9, lines 3-5; Col 15, lines 21-25) of codes (Fig. 11; Col 9, lines 14-27) and data (Fig. 11; Col 9, lines 35-38) for use in

transmitting operating commands to a plurality of different home appliances of different manufacturers (Col 1, lines 42-48; Col. 9, lines 14-16), where the instructions perform steps comprising:

matching the universal remote control 10 to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons 25 of the keyboard, the pushbuttons 25 of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control 10 is to be matched (Fig. 17; Col. 10, line 44-Col. 11, line 7); and

assigning to the macro pushbutton a subset of the selected codes and data from the library whereafter activation of the macro pushbutton causes the universal remote control 10 to use the subset of selected codes and data from the library to transmit a plurality of operating commands to one or more of the matched home appliances (Figs. 18a and 18b; Col. 14, line 14-Col 15, line 10).

Independent claim 3 is directed to a readable media having instructions for performing steps in a universal remote control 10 (Figs. 1 and 7; Col. 1, lines 42-48) comprising a keyboard having a plurality of pushbuttons 25 (Fig. 15; Col. 4, lines 34-47; Col. 5, lines 33-44) and a library (Col. 9, lines 3-5; Col 15, lines 21-25) of codes (Fig. 11; Col. 9, lines 14-27) and data (Fig. 11; Col. 9, lines 35-38) for use in transmitting operating commands to a plurality of different home appliances of different manufacturers (Col. 1, lines 42-48; Col. 9, lines 14-16), where the instructions perform steps comprising:

matching the universal remote control 10 to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit

operating commands to the matched home appliances in response to activation of selected pushbuttons 25 of the keyboard (Fig. 17; Col. 10, line 44-Col. 11, line 7); and

using activation of one or more pushbuttons 25 of the keyboard to match the universal remote control 10 to the plurality of different home appliances of different manufacturers (Fig. 17; Col. 10, line 44-Col. 11, line 7);

wherein the instructions further perform the step of using activation of one or more of the pushbuttons 25 of the keyboard to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control 10 is to be matched (Fig. 17; Col. 10, line 44-Col. 11, line 7)

Independent claim 4 is directed to a method performed in a universal remote control 10 (Figs. 1 and 7; Col 1, lines 42-48) comprising a keyboard having a plurality of pushbuttons 25 (Fig. 15, Col. 4, lines 34-57; Col. 5, lines 33-44) including a macro pushbutton (Col. 14, line 14-Col 15, line 10) and a library (Col. 9, lines 3-5; Col 15, lines 21-25) of codes (Fig. 11; Col 9, lines 14-27) and data (Fig. 11; Col 9, lines 35-38) for use in transmitting operating commands to a plurality of different home appliances of different manufacturers (Col 1, lines 42-48; Col. 9, lines 14-16), where the method comprises:

matching the universal remote control 10 to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons 25 of the keyboard, the pushbuttons 25 of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control 10 is to be matched (Fig. 17; Col. 10, line 44-Col. 11, line 7); and

assigning to the macro pushbutton a subset of the selected codes and data from the library

whereafter activation of the macro pushbutton causes the universal remote control 10 to use the subset of selected codes and data from the library to transmit a plurality of operating commands to one or more of the matched home appliances (Figs. 18a and 18b; Col. 14, line 14-Col 15, line 10).

Independent claim 6 is directed to a method performed in a universal remote control 10 (Figs. 1 and 7; Col. 1, lines 42-48) comprising a keyboard having a plurality of pushbuttons 25 (Fig. 15; Col. 4, lines 34-47; Col. 5, lines 33-44) and a library (Col. 9, lines 3-5; Col 15, lines 21-25) of codes (Fig. 11; Col. 9, lines 14-27) and data (Fig. 11; Col. 9, lines 35-38) for use in transmitting operating commands to a plurality of different home appliances of different manufacturers (Col. 1, lines 42-48; Col. 9, lines 14-16), where the method comprises:

matching the universal remote control 10 to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons 25 of the keyboard (Fig. 17; Col. 10, line 44-Col. 11, line 7); and

using activation of one or more pushbuttons 25 of the keyboard to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control 10 is to be matched (Fig. 17; Col. 10, line 44-Col. 11, line 7).

VI. Grounds Of Rejection To Be Reviewed On Appeal

In the Office Action of April 11, 2008 pending claims 1-6 of U.S. Patent No. 6,587,067 (“the ‘067 patent”) were rejected under 35 U.S.C. § 102 as allegedly being anticipated by “Home Run Micromint’s Home Control System User’s Manual Rev. 1.0, The Micromint, Inc., Terrace Drive, Vernon, CT 06066, April 1, 1985, pages 1-159 (“Micromint”).

Appellant hereby requests review of the rejection of claims 1-6 of the ‘067 patent under

35 U.S.C. § 102 in view of Micromint.

VII. Argument

A) Overview

The subject reexamination proceeding involves claims of an expired patent. As such, the claims of the '067 patent must be construed pursuant to the principles set forth by the Court in *Phillips v. AWH Corp.* 415 F.3d 1303 (Fed. Cir. 2005). This is required by MPEP § 2258 which states:

In a reexamination proceeding involving claims of an expired patent, *>claim construction pursuant to the principle set forth by the court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim< are not subject to amendment**.

(MPEP § 2258)

According to the principles set forth within *Phillips*, the elements of the claims of the '067 patent must be given “their ordinary and customary meaning” to a person of ordinary skill in the relevant art in the context of the specification in which those words appear.

The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. *See Innova*, 381 F.3d at 1116. That starting point is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. *See Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119 (Fed. Cir. 2002) (patent documents are meant to be “a concise statement for persons in the field”); *In re Nelson*, 280 F.2d 172, 181 (CCPA 1960) (“The descriptions in patents are not addressed to the public generally, to lawyers or to judges, but, as section 112 says, to those skilled in the art to which the invention pertains or with which it is most nearly connected.”).

Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. This

court explained that point well in Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998). *See also* Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313, 1319 (Fed. Cir. 2005) (“**We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history.**”); V-Formation, Inc. v. Benetton Group SpA, 401 F.3d 1307, 1310 (Fed. Cir. 2005)

(*Phillips v. AWH Corp.*, emphasis added)

It is Appellant’s position that, in the context of the specification and prosecution history of the ‘067 patent, the claimed “codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” can only be understood by one of ordinary skill in the relevant art to mean the carrier frequencies, modulation schemes, and bit encoding schemes that are used to transmit data (i.e., 0s and 1s) from the universal remote control to different appliances of different manufacturers, i.e., a system of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages to different appliances of different manufacturers. Thus, it is Appellant’s further position that, in the context of the specification and prosecution history of the ‘067 patent, the claimed “library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” can only be understood by one of ordinary skill in the relevant art to mean that the universal remote control includes, for each of the different appliances of different manufacturers to which the universal remote control may be matched, a tabulation of an appropriate carrier frequency, modulation scheme, and bit encoding scheme, i.e., systems of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages to different appliances of different manufacturers, and data such that the universal remote control is adaptable to transmit communications that will be recognized by an intended target appliance.

In the Advisory Action of July 17, 2008, the Examiner acknowledged that Micromint

does not anticipate the claims of the '067 patent when the claims of the '067 patent are construed in the manner that is being proposed by Appellant, i.e., that Micromint does not disclose, teach, or suggest plural signal systems, namely, plural carrier frequencies, modulation schemes, and bit encoding schemes, used to transmit data (i.e., 0s and 1s) to different appliances of different manufacturers.

While the Examiner has acknowledged that Micromint does not disclose, teach, or suggest a universal remote control having “a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” as Appellant believes this claim language must be construed, the Examiner has asserted that because the inventors have not acted as their own lexicographer by specifically defining the term “code” in the specification, the term “code” must be construed according to its ordinary and customary meaning. Thus, the Examiner has selected one dictionary definition of the term “code,” namely, “a set of symbols used to represent information,” and has asserted that, because Micromint discloses a system having “codes” that meet this selected dictionary definition, the invention claimed in the '067 patent must be anticipated by Mircomint.

It is, however, respectfully noted that the Examiner's position with respect to claim construction is not correct. In this regard, *Philips* makes clear that a claim term is not simply given the “full range” of its ordinary meaning merely because an inventor does not specifically define that claim term within the specification. Rather, even when a claim term is not expressly defined within the specification, that claim term must still be provided with a definition that is consistent with the context in which that claim term is used in the specification.

Assigning such a limited role to the specification, and in particular requiring that any definition of claim language in the specification be express, is inconsistent with our rulings that **the specification is “the single best guide to the meaning of a disputed term,” and that the specification “acts as a dictionary when it**

expressly defines terms used in the claims or when it defines terms by implication.” Vitronics, 90 F.3d at 1582; Irdeto Access, Inc. v. Echostar Satellite Corp., 383 F.3d 1295, 1300 (Fed. Cir. 2004) (“Even when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.”) (citations omitted); Novartis Pharms. Corp. v. Abbott Labs., 375 F.3d 1328, 1334-35 (Fed. Cir. 2004) (same); Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc., 262 F.3d 1258, 1268 (Fed. Cir. 2001) (“[A] claim term may be clearly redefined without an explicit statement of redefinition.”).

The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent. Properly viewed, the “ordinary meaning” of a claim term is its meaning to the ordinary artisan after reading the entire patent. Yet heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.

(*Id.*, emphasis added)

Accordingly, it is respectfully submitted that, because:

a) in the context of the ‘067 patent, the claim term “library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” can only be understood by one of ordinary skill in the relevant art to mean that the universal remote control includes, for each of the different appliances of different manufacturers to which the universal remote control may be matched, a tabulation of an appropriate carrier frequency, modulation scheme, and bit encoding scheme, i.e., a system of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages to different appliances of different manufacturers, and data such that the universal remote control is adaptable to transmit communications that will be recognized by the intended target appliance;

b) a construction of the claim term “library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” to

mean that the universal remote control includes, for each of the different appliances of different manufacturers to which the universal remote control may be matched, a tabulation of an appropriate set of symbols used to represent information and data that will allow the universal remote control to transmit communications that will be recognized by the intended target appliance, as asserted by the Examiner, finds no support in the context of the specification of the '067 patent; and

c) the Examiner has acknowledged that Micromint does not anticipate the claims of the '067 patent when the claims of the '067 patent are construed in the manner that is being proposed by Appellant,

it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 102 must be withdrawn.

**B) The Claims Construed In The Context
Of The Specification And Prosecution History Of The '067 Patent**

It is respectfully submitted that the context of the specification of the '067 patent provides only one possible meaning for the claimed "data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers." In the context of the specification of the '067 patent, the claimed "data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" is illustrated in Fig. 11 and is described at Col. 9, lines 35-37 patent which sets forth:

Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed.

Thus, in keeping with the context in which these claim terms are used in the specification of the '067 patent, the claimed "data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed by one of ordinary

skill in the relevant art to mean patterns of bits, i.e., 0s and 1s, that are to be sent from the universal remote control to the appliances.

In addition to the “data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers,” the claims of the ‘067 patent further require “codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers.” In the context of the specification of the ‘067 patent, the claimed “codes for use in transmitting operating commands to a plurality of different home appliances” are also illustrated in Fig. 11 - which illustrates examples of signals that are used to represent numbers (i.e., 0s and 1s) in transmitting messages to different appliances of different manufacturers - and described at Col. 9, lines 14-27 which sets forth:

The infrared codes to be learned include a wide range of different codes for operating different electrical apparatus manufactured by the same or different manufacturers. In FIG. 11, which is identical to FIG. 1 in U.S. Pat. No. 4,623,887, there are illustrated several modulation schemes for infrared codes. FIGS. 11a-11g illustrate different types of gated carrier frequencies. Typical carrier frequencies for infrared remote transmitters are 20 Khz to 45 Khz, with the majority being at 38 Khz and 40 Khz. The gating schemes illustrated include both fixed and variable bit periods, non-return to zero (NRZ), variable burst widths, single/double burst modulation schemes, and a final catch-all category called random because there is no readily distinguishable pattern of ones and zeros. Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed. (*emphasis added*)

Thus, in keeping with the context in which the claimed terms are used in the specification of the ‘067 patent, the claimed “codes for use in transmitting operating commands to a plurality of different home appliances” can only be construed by one of ordinary skill in the relevant art to mean plural modulation schemes, carrier frequencies, bit encoding schemes, etc., i.e., systems of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages, that are to be used to transmit “data” to plural different appliances.

Thus, from the foregoing, it is respectfully submitted that, in the context of the specification of the '067 patent, the claim term "library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be understood by one of ordinary skill in the relevant art to mean that the universal remote control includes, for each of the different appliances of different manufacturers to which the universal remote control may be matched, a tabulation of an appropriate carrier frequency, modulation scheme, and bit encoding scheme, i.e., a system of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages to different appliances of different manufacturers, and data, i.e., patterns of 0s and 1s, such that the universal remote control is adaptable to transmit communications that will be recognized by the intended target appliance.

That one of ordinary skill in the relevant art, i.e., the art of remote controls and data communications, would understand the claims of the '067 to have this scope and meaning in the context of the '067 patent is further evidenced by the attached declarations of Patrick Hayes and Alex Cook.

**C) Neither The Specification Nor The Prosecution History Of The '067 Patent
Supports The Examiner's Construction Of The Claims**

In the Advisory Action of July 17, 2008, the Examiner asserted that the claimed "codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" must be construed using the selected dictionary definition of "a set of symbols used to represent information" because Micromint uses the term "code" in a manner that is asserted to be consistent with this selected definition. It is, however, respectfully submitted that the manner in which the term "code" is used in the context of Micromint cannot be said to evidence how this claim term must be construed in the context of the specification of the '067 patent.

Dictionaries, by their nature, provide an expansive array of definitions. General dictionaries, in particular, strive to collect all uses of particular words, from the common to the obscure. By design, general dictionaries collect the definitions of a term as used not only in a particular art field, but in many different settings. In such circumstances, it is inevitable that the multiple dictionary definitions for a term will extend beyond the “construction of the patent [that] is confirmed by the avowed understanding of the patentee, expressed by him, or on his behalf, when his application for the original patent was pending.” Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 227 (1880).

Even technical dictionaries or treatises, under certain circumstances, may suffer from some of these deficiencies. There is no guarantee that a term is used in the same way in a treatise as it would be by the patentee. In fact, discrepancies between the patent and treatises are apt to be common because the patent by its nature describes something novel.

(Phillips v. AWH Corp.)

Thus, because it has not been asserted by the Examiner that, in the context of the specification of the '067 patent the term “codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” is used to infer “sets of symbols used to represent information,” which it does not, it is respectfully submitted that the Examiner’s reliance upon a selected dictionary definition and Micromint divorced from the specification of the '067 patent fails to provide the evidence necessary to support the Examiner’s proposed claim construction, i.e., “it focuses the inquiry on the abstract meaning of the words rather than on the meaning of claim terms within the context of the patent” (*Phillips*). Therefore, for the reason that the context of the specification of the '067 patent supports only one possible construction for the claim term “codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers,” namely, plural modulation schemes, carrier frequencies, bit encoding schemes, etc. that are to be used to transmit “data” to plural different appliances, which is also in keeping with the ordinary and customary meaning of “codes” as a system of signals used to represent numbers (i.e., 0s and 1s) in transmitting messages, it is respectfully requested that the Board affirm the Appellant’s proposed claim construction and accordingly find

the claims of the '067 patent allowable over Micromint.

It is additionally respectfully submitted that the prosecution history of the '067 patent provides further evidence that the claim term “codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” cannot be construed to read on the “house codes” and “device codes” disclosed within Micromint. In this regard, the claims of the '067 patent were originally determined by Examiners Wong and Horabik to claim subject matter that was not disclosed, taught, or suggested by U.S. Patent No. 4,200,862 (“the '862 patent). This is particularly relevant because the '862 patent discloses the exact same system, including the “house codes” and “device codes,” that is disclosed within Micromint. (*see* U.S. Patent No. 4,200,862 - Figs. 11 and 12; Col. 1, line 64-Col. 2, line 3; Col. 4, lines 4-31; Col. 5, lines 3-11). Accordingly, because it was previously determined under the “broadest reasonable interpretation” standard that the claimed “codes” did not read on the “house codes” and “device codes” disclosed in the '862 patent, it is respectfully submitted that under the narrower “ordinary and customary meaning” standard as set forth in *Philips* the claimed “codes” cannot now be read on the exact same “house codes” and “device codes” disclosed in Micromint.

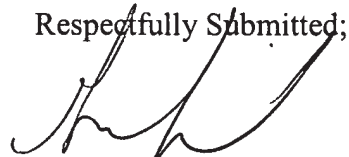
It is similarly respectfully submitted that the claim language itself provides still further evidence that the claimed “codes” cannot be construed to be equivalent to the “house codes” or “device codes” disclosed in Micromint. Specifically, in the context of Micromint, the “house code” and the “device code” are described as being nothing more than bit patterns used to identify a group of BSR receivers and a specific BSR receiver, respectively. This has been acknowledged by the Examiner. Thus, because the claims of the '067 patent recite “codes” in addition to “data” “for use in transmitting operating commands to a plurality of different home appliances,” it is respectfully submitted that it would be improper to construe the claimed

“codes” in a manner that renders the claimed “codes” equivalent to the properly construed, claimed “data,” i.e., patterns of 0s and 1s such as the “house codes” and “device codes” of Micromint, as such a claim construction would impermissibly render the separately claimed “codes” redundant to the claimed “data.” *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (“the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms”).

D) Conclusion

From the foregoing, it is respectfully submitted that, by the law set forth within *Phillips*, the claims of the ‘067 patent, which are directed to steps by which a remote control is matched to particular equipment, can only be construed as requiring a universal remote control that functions, for each of the plurality of different appliances of different manufacturers that the universal remote control is intended to be matched, i.e., to control, as directly indentified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, to select from the “library of codes and data” the particular carrier frequency, modulation scheme, bit encoding scheme, etc., i.e., signal, and the data that is appropriate for each home appliance so directly identified to the universal remote control. Because Micromint does not disclose, teach, or suggest this aspect of the invention claimed, it is respectfully submitted that the rejection of the claim under 35 U.S.C. § 102 must be withdrawn.

Respectfully Submitted;



Date: August 8, 2008

By: Gary R. Jarosik; Reg. No. 35,906
Greenberg Traurig, LLP
77 West Wacker Drive, Suite 2500
Chicago, Illinois 60601
(312) 456-8449

VIII. Claims Appendix

The following is a clean copy of the claims involved in the appeal:

Listing of claims:

1. In a universal remote control comprising a keyboard having a plurality of pushbuttons including a macro pushbutton and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, a readable medium having instructions for performing steps comprising:

matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard, the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched; and

assigning to the macro pushbutton a subset of the selected codes and data from the library whereafter activation of the macro pushbutton causes the universal remote control to use the subset of selected codes and data from the library to transmit a plurality of operating commands to one or more of the matched home appliances.

2. The readable medium as recited in claim 1, wherein the instructions further perform the step of using activation of one or more pushbuttons of the keyboard to assign the subset of the selected codes and data from the library to the macro pushbutton.

3. In a universal remote control comprising a keyboard having a plurality of pushbuttons and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, a readable medium having instructions for performing steps comprising:

 matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard; and

 using activation of one or more pushbuttons of the keyboard to match the universal remote control to the plurality of different home appliances of different manufacturers;

 wherein the instructions further perform the step of using activation of one or more of the pushbuttons of the keyboard to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched.

4. In a universal remote control comprising a keyboard having a plurality of pushbuttons including a macro pushbutton and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, a method comprising:

 matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard, the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the

universal remote control is to be matched; and

assigning to the macro pushbutton a subset of the selected codes and data from the library whereafter activation of the macro pushbutton causes the universal remote control to use the subset of selected codes and data from the library to transmit a plurality of operating commands to one or more of the matched home appliances.

5. The method as recited in claim 4, further comprising using activation of one or more pushbuttons of the keyboard to assign the subset of the selected codes and data from the library to the macro pushbutton.

6. In a universal remote control comprising a keyboard having a plurality of pushbuttons and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, a method comprising:

matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard; and

using activation of one or more pushbuttons of the keyboard to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched.

IX. Evidence Appendix

Copies of the following evidence are being submitted with this Appeal and are attached hereto:

- 1) Declaration of Patrick H. Hayes; and
- 2) Declaration of Alex M. Cook, Jr.

These Declarations were filed to address issues raised for the first time in the Office Action of April 11, 2008.

These Declarations were necessary to evidence how the claims would be interpreted by one of ordinary skill in the relevant art. *Phillips v. AWH Corp.* 415 F.3d 1303 (Fed. Cir. 2005)

It is believed that this evidence was entered into the record of the subject application as of the Advisory Action of July 17, 2008.

X. Related Proceedings Appendix

No copies of decisions rendered by a court or the Board are being submitted herewith.

PROOF OF SERVICE


I declare that:

1. I am a citizen of the United States and am employed in the County of Cook, State of Illinois.
2. I am over the age of eighteen years and am not a party to this action.
3. My business address is 77 W. Wacker Drive, Suite 2500, Chicago, Illinois 60601-1732.
4. On August 8, 2008, I served a copy of all of the papers included with this Appeal Brief filed in connection with Reexamination No. 90/007,876, including the Declarations of Pat Hayes and Alex Cook and the Notice of Appeal, by placing a copy of the same in a sealed envelope and mailing it via First Class Mail with the U.S. Postal Service, addressed as follows:

Jonathan D. Hanish
Sierra Patent Group Ltd.
1657 Hwy 395, Suite 202
Minden, NV 89423

I declare under penalty of perjury in accordance with the laws of the State of Illinois that the foregoing is true and correct.

Date: August 8, 2008



Sheri Fassl

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	Examiner: Choi, Woo H.
)	
Reexam Control No.:	90/007,876)	Attny Doc.: 81230.05US4
)	
Filing Date:	01/17/2006)	Art Unit: 3992
)	
Patent No.:	6,587,067)	
)	
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

DECLARATION OF PATRICK H. HAYES

I, Patrick H. Hayes, declare as follows:

I. INTRODUCTION

1. I hold a BSc(Eng) (Electrical) from the University of the Witwatersrand, Johannesburg.
2. I have served in various engineering and development capacities in the electronics industry since 1969, including fourteen years in commercial computers and networking, eight years in telecommunications, and sixteen years in consumer electronics.
3. Since 1992, I have been employed by Universal Electronics Inc., a major developer and manufacturer of universal remote controls, performing at various times as Director of Software Development, Vice President of Technology Development, Vice President of Core Technology, and Vice President of Intellectual Property.
4. Universal Electronics Inc. is the assignee of U.S. Patent No. 6,587,067 which is the subject of this reexamination proceeding.

5. I am a named inventor on over sixty granted and pending U.S. Patent applications, the majority of which relate to universal remote control technology.

II. INFORMATION CONSIDERED

1. In forming the opinions and conclusions set forth below, I have relied upon my knowledge and experience and have considered the following documents that have been provided to me:

- a) US Patent No. 6,587,067 ("the '067 patent")
- b) "Home Run Micromint's Home Control System User's Manual Rev. 1.0, The Micromint, Inc. Terrace Drive, Vernon, CT 06066, April 1, 1985, pages 1-159 ("Micromint")
- c) US Patent No. 4,200,862 ("the '862 patent")

III. OPINIONS AND CONCLUSIONS

1. As one of ordinary skill in the relevant art, I understand the claims of the '067 patent to require interaction to match the claimed universal remote control to a plurality of different home appliances of different manufacturers.

2. By way of example, claim 3 of the '067 patent sets forth that interaction in the form of activations of one or more pushbuttons of the keyboard of the universal remote control are used to match the universal remote control to the plurality of different home appliances of different manufacturers.

3. As one of ordinary skill in the relevant art, I understand the claims of the '067 patent to specify who or what must perform the step of matching.

4. By way of example, claim 3 of the '067 patent specifies that it is the instructions of the readable media in the universal remote control that perform various steps including the step of matching the universal remote control to a plurality of different home appliances of different manufacturers.

5. As one of ordinary skill in the relevant art, I understand the claims of the '067 patent to specify how the matching must be performed.

6. By way of example, claim 3 of the '067 patent specifies that matching is performed by selecting from a library those codes and data that are to be used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard, with activations of one or more of the pushbuttons of the keyboard being used to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched.

7. As one of ordinary skill in the relevant art, within the context of the specification of the '067 patent, the claim term "data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed to mean the patterns of bits that are to be sent from the universal remote control to appliances. By way of example, this is illustrated in Fig. 11 of the '067 patent and described at Col. 9, lines 35-37 of the '067 patent which sets forth:

Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed.

8. As one of ordinary skill in the relevant art, within the context of the specification of the '067 patent the claim term "codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed to mean the carrier frequencies, modulation schemes, and bit encoding schemes used to transmit the "data" from the universal remote control to appliances. By way of example, this is illustrated in Fig. 11 of the '067 patent and described at Col. 9, lines 14-27 of the '067 patent which sets forth:

The infrared codes to be learned include a wide range of different codes for operating different electrical apparatus manufactured by the same or different manufacturers. In FIG. 11, which is identical to FIG. 1 in U.S. Pat. No. 4,623,887, there are illustrated several modulation schemes for infrared codes. FIGS. 11a-11g illustrate different types of gated carrier frequencies. Typical carrier frequencies for infrared remote transmitters are 20 KHz to 45 KHz, with the majority being at 38 KHz and 40 KHz. The gating schemes illustrated include both fixed and variable bit periods, non-return to zero (NRZ), variable burst widths, single/double burst modulation schemes, and a final catch-all category called random because there is no readily distinguishable pattern of ones and zeros. Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed.

9. In view of the foregoing, within the context of the specification of the '067 patent, one of ordinary skill in the relevant art only interpret the claim term "a library codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" to mean that the universal remote control includes, for each of the different appliances of different manufacturers the universal remote control may be used to control, a tabulation of an appropriate carrier frequency, modulation scheme, bit encoding scheme, and data that will allow the universal remote control to transmit communications that will be recognized by the intended target appliance.

10. In view of the foregoing, within the context of the specification of the '067 patent, one of ordinary skill in the relevant art can only interpret the claim term "matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard" to mean that, for each of the plurality of different appliances of different manufacturers the universal remote control is intended to control, as directly identified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, the universal remote control will be caused to select from the "library" the particular carrier frequency, modulation scheme, bit encoding scheme, and data that is appropriate for each home appliance so identified.

11. As one of ordinary skill in the relevant art, within the context of the specification of the '067 patent, the '067 patent never discloses, teaches, or suggests that "codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" may be a "house code" or a "device code."

12. As one of ordinary skill in the relevant art, in the context of Micromint, a "house code" and a "device code" is not a carrier frequency, modulation scheme, or bit encoding schemes used to transmit "data." Rather, within the context of Micromint, the "house code" and the "device code" is a component part of the transmitted data, i.e., bits. By way of example, this is illustrated in Fig. 1 of Micromint and described in Micromint on page 8 as follows:

At the heart of a BSR command module, as well as of the other system components, are custom LSI IC's manufactured for BSR by General Instruments Corp. Fully expanded, the BSR system can accommodate 256 independently addressable receivers. That is accomplished using 16 sets of addresses called "house codes" and 16 "device codes" for each house code. The separate house codes allow next-door neighbors to use X-10's

without interfering with each other. A thumbwheel switch on the bottom of the command console and the receiver modules sets the 4-bit house code.

In normal operation the 22 button keypad on the BSR command console, which is wired as a 3x8 matrix, is scanned at a rate of 3.8 kHz. When a button is pressed, its designated function and the house code are combined into a single message. The digital message is directed to the transmitter section where it generates 120 kHz signals that are used to pulse width modulate the AC line.

13. As one of ordinary skill in the relevant art, Micromint fails to disclose, teach, or suggest a device that can use multiple carrier frequencies, modulation schemes, and bit encoding schemes for transmitting data to plural different appliances of plural different manufacturers. Rather, Micromint discloses the use of a single carrier frequency, modulation scheme, and bit encoding scheme that is dedicated for use in transmitting data only to BSR modules. This is illustrated in Fig. 1 of Micromint on page 9 and described in Micromint on page 8 as follows:

The digital message is directed to the transmitter section where it generates 120 kHz signals that are used to pulse width modulate the AC line.

The transmitted message is clocked a bit at a time, on zero crossing. A command message contains 9 bits of information consisting of the 4-bit house code and 5-bit matrix (keyboard function) code. Each message is transmitted in true and inverted format on successive half cycles of the AC waveform.

A logic 1 bit is three 1-millisecond bursts of 120 kHz signal commencing approximately 200 microseconds after the zero crossing of the AC line. A logic 0 bit is represented by no signal for that half cycle. To synchronize the receivers with the transmitters, a trigger code consisting of three successive logic 1 bits followed by a logic 0 bit is used. The complete message takes 11 full AC cycles (83 ms) to complete.

14. As one of ordinary skill in the relevant art, the inclusion of a "house code" which "... allow(s) next-door neighbors to use X-10's without interfering with each other" is specifically indicative of and necessitated by the fact that the BSR/X-10 modules used in the

Micromint system all share a single pre-determined carrier frequency, modulation scheme, and bit encoding scheme.

15. As one of ordinary skill in the relevant art, the use of "house code" and "device code" in Micromint is consistent with the description of "house code" and "appliance code" set forth in the '862 patent. I observe the similarity between Micromint Figure 1 and Figures 11 and 12 of the '862 patent. Like Micromint, the '862 patent describes that these "codes" are nothing more than a component part of the data that is transmitted to a BSR device, i.e., bits, for the purpose of allowing a BSR device to recognize that it is the intended recipient of a data transmission. By way of example, this is illustrated in Fig. 21 of the '862 patent and described in the '862 patent at Col. 1, line 64-Col. 2, line 3 as follows:

There is also preferably incorporated into the digital signals a house or system code which can be unique to that system. The slave unit must then decode a given system code before it responds to the device or operation data in the signals. In this way interference between neighbouring systems, for example different systems used in the same building or in the same street if electrically coupled, can be reduced.

at Col. 4, lines 4-31 as follows:

To distinguish between appliances, each slave unit is given an appliance code which is set manually by means of a rotary switch (8) at each slave unit. Another rotary switch (7) is provided both at the slave units and at the table top transmitter in order that a "housecode" can be set, this "housecode" being intended to be unique to the house or building concerned to prevent interference between separate systems which are electrically coupled--for example houses in the same street.

When it is desired to control one of the appliances, the keyboard is operated to key in the appliance code concerned followed by the operation desired, e.g. "on". The transmitter will in consequence develop two digital signals, the first of which represents the appliance code and the second of which represents the desired operation. The house code is added to both digital signals which are passed on to the main in sequence. The first digital signal is conveyed by the main to each slave unit but only one of the slave units will respond to this signal, i.e. the slave unit which contains the house code and appliance code concerned. This particular slave unit will be enabled by the first digital signal, so that when the second digital signal arrives it will execute the demanded operation. Subsequently, that

slave unit remains enabled for further operational orders unit such time that another appliance code is called for by the transmitter.

and at Col. 5, lines 3-11 as follows:

A house or system code is defined at the unit by rotary switch 7 of a conventional construction as indicated by FIG. 2. The four bits defined by the switch 7 are taken to input terminals H1 and H4 of the integrated circuit. The four bits of the housecode are added to the data entered via the keyboard and also appear at output "SER.OUT" for injection onto the mains.

16. As one of ordinary skill in the relevant art, Micromint does not disclose "matching" a universal remote control to an appliance to be controlled as that term can only be construed in the claims of the '067 patent. Micromint does not disclose, teach, or suggest the use of a library of multiple carrier frequencies, modulation schemes, or bit encoding schemes.

Considering the disclosure at page 9 of Micromint:

... the receiver section monitors the AC line, waiting for a coded message corresponding to its unique house code (A through P) and unit device code (1 through 16). To turn on channel 10, one simply presses 10 and ON, one after the other.

which steps correspond to those detailed in the '862 patent at column 4 lines 14-28

When it is desired to control one of the appliances, the keyboard is operated to key in the appliance code concerned followed by the operation desired, e.g. "on". The transmitter will in consequence develop two digital signals, the first of which represents the appliance code and the second of which represents the desired operation. The house code is added to both digital signals which are passed on to the main in sequence. The first digital signal is conveyed by the main to each slave unit but only one of the slave units will respond to this signal, i.e. the slave unit which contains the house code and appliance code concerned. This particular slave unit will be enabled by the first digital signal, so that when the second digital signal arrives it will execute the demanded operation.

these steps represent a simple act of selection of a BSR module to be controlled using a fixed, predetermined, carrier frequency, modulation scheme, and bit encoding, and do not anywhere describe an act of matching an appliance to a one of a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different

manufacturers, as is contemplated by the '067 patent. In this context, it is to be noted that the "matching" claimed within the '067 patent need occur only once, during initial configuration of the universal remote control, as described for example at Col 14 lines 39-46:

Matching the Device to Your Equipment

The device 10 can control most remote controlled TV's, VCR's, cable converters, and CD players, but it needs the user's input to match it to your particular equipment. The easiest way to do this is to STEP-and-SET your device 10. You will only need to do this once for each different type of device you have.

whereas in Micromint, the described selection of a BSR module to be controlled must be performed each and every time a user of the system wishes to switch between modules, i.e., this is akin to the equipment selection actions described elsewhere in the '067 patent, for example at Col 15, lines 29-30:

Take a look at the keyboard. There are four groups of buttons:

1. Equipment Selection Buttons tell the device 10 which equipment is to be controlled:

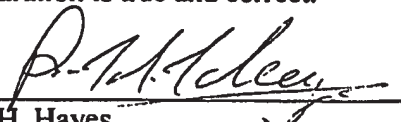
VCR1	Cable	TV
VCR2	CD	

and does not comprise "matching" as that term can only be construed in the claims of the '067 patent.

IV. DECLARATION

1. I declare under penalty of perjury that the foregoing Declaration is true and correct.

Date: JUNE 10, 2008


Patrick H. Hayes

CHI 57280651v1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	Examiner: Choi, Woo H.
)	
Reexam Control No.:	90/007,876)	Attny Doc.: 81230.05US4
)	
Filing Date:	01/17/2006)	Art Unit: 3992
)	
Patent No.:	6,587,067)	
)	
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

DECLARATION OF ALEX M. COOK, JR.

I, Alex M. Cook, Jr. declare as follows:

BACKGROUND

1) I received a Bachelor in Electrical Engineering Degree from the Georgia Institute of Technology in 1977. I did additional non-degree graduate level work at the Georgia Institute of Technology in 1978.

2) I have worked in the electronics industry since 1978 in various engineering and management positions. I worked for Scientific Atlanta, Inc. from 1985 until 1996 during a major portion of which I was directly responsible for all remote control devices designed and manufactured by the company. I have direct experience in the design of hardware, software, and transmission protocols of remote control units of both single device and universal types. During my tenure at Scientific Atlanta, I was also directly involved in drafting patent applications and reviewing issued patents for infringement concerns. Since 1996 I have worked as a engineering consultant for various clients. This work has included additional work with remote controls, including consulting on the development of advanced

remotes, procurement assistance for single device and universal remotes, and as an expert witness in a number of patent infringement cases in the area of remote control devices.

3) I am currently employed by K-TAC, LLC, a consulting firm in Lawrenceville, GA.

4) I was hired by Universal Electronics Inc. to prepare this declaration and received compensation for the preparation of this declaration.

INFORMATION CONSIDERED

1) I have reviewed the following documents and relied on my personal knowledge and experience in the remote control field in developing the opinions offered here.

US Patent No. 6,587,067 ("the '067 patent")

US Patent No. 4,200,862 ("the '862 patent")

"HOME RUN, MICROMINT'S HOME CONTROL SYSTEM" Users Manual, Rev

1.0

OPINIONS

1) As one of ordinary skill in the art, the term "instructions", as used in the claims of the '067 patent mean groups of executable control codes as used in a microprocessor or central processing unit to control the operation of the processor in order to achieve a desired outcome. I find the following examples in the '067 patent support this definition.

- a. FIG 12B, Step 4 states "TRANSFORM STORED DATA TO LIST OF EXECUTABLE INSTRUCTIONS WHICH REPRODUCE BIT STREAM"
- b. Column 2, Line 57ff, "re-enabling the central processing unit to enable the central processing unit to execute the instructions so transferred."

c. Column 8, Line 24ff, "Incoming data is received serially at serial port 3 and conveyed to input port 112, when it is desired to update the code data and/or instructions in RAM 54."

d. Column 10, Line 8ff, "When the CPU 56 executes the instructions set forth..."

2) As one of ordinary skill in the art, the claims of the '067 patent require instructions that achieve a specific outcome and qualifications on how that outcome is achieved. As an example, in claim 1, instructions are required that achieve the specific outcome of "matching the universal remote control to a plurality of different home appliances of different manufacturers".

3) As one of ordinary skill in the art, the claims of the '067 patent do specify how the "matching" must be performed. As an example, claim 1 requires the matching to be performed by "the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched". As a further example, the description of the action in the specification, beginning at Column 14, Line 40 offers a preferred embodiment of the first required element, "matching...", of the method of Claim 4

4) As one of ordinary skill in the art, the claims of the '067 patent do specify who or what must perform the required step of matching. For example, in Claim 1, the instructions contained in the readable medium in the remote control, perform the matching process in response to keys pressed by the user. As an example, one embodiment is shown in FIG 16 and referred to in Column 10, Line 39ff which clearly shows the major steps in the process defined by the instructions and also clearly shows the user interaction.

5) As one of ordinary skill in the art, the claims of the '067 patent do require an "appliance awareness" on the part of the controller. As an example, in Claim 1, the instructions for matching include the additional requirement "such that selected codes and

data from the library are used to transmit operating commands to the matched home appliance in response to activation of selected pushbuttons of the keyboard". As a further example, in the description of the preferred embodiment, in Column 14, Line 40ff, we find "The device 10 can control most remote controlled TV'S, VCR's, cable converters, and CD players, but it needs the user's input to match it to your particular equipment."

6) As one of ordinary skill in the art, the phrase "to transmit operating commands to the matched home appliances", used in Claims 1, 3, 4, and 6, can only mean that the transmitted command is received and recognized directly by the matched home appliance. As an example, in the '067 patent at Column 14, line 57 through Column 15, line 2 state "3. Aim the device 10 at the equipment and try various function buttons to see if the equipment responds correctly. Make sure you are reasonably close to the equipment and that nothing is blocking the path. The light (LED 4) at the top of the device 10 will shine green whenever it is sending an infrared code, or it will not light at all if it does not send a code for a particular button. 4. If your equipment did not respond correctly or did not respond at all, press DO1 to change the device 10 so that it will send the next set of infrared codes in its library, or press DO2 to change it so it will send the previous set of codes."

7) As one of ordinary skill in the art, the phrase "operating commands" as used in the '067 patent Claims 1,3,4, and 6, can only mean a transmission of a signal that incorporates all of the characteristics, such as frequency, modulation format, bit pattern, bit rate, error checking, and other characteristics as necessary, needed for the transmitted signal to be received and recognized by the matched home appliance and to cause matched home appliance to operate in the desired fashion. As an example, in the '067 patent, Column 9, lines 14 - 34 state "The infrared codes to be learned include a wide range of different codes for operating different electrical apparatus manufactured by the same or different manufacturers. In FIG. 11, which is identical to FIG. 1 in U.S. Pat. No. 4,623,887, there are

illustrated several modulation schemes for infrared codes. FIGS. 11a-11g illustrate different types of gated carrier frequencies. Typical carrier frequencies for infrared remote transmitters are 20 KHz to 45KHz, with the majority being at the 38 KHz and 40 KHz. The gating schemes illustrated include both fixed and variable bit periods, non-return to zero (NRZ), variable burst widths, single/double burst modulation schemes, and a final catch-all category called random because there is no readily distinguishable pattern of ones and zeros. In addition to these schemes, there is also a transmitter which puts out a different continuous frequency (CW) for each key as represented in FIG. 11h. Finally, several new types of transmitters do not use a carrier frequency at all but instead send a stream of pulses where the data is encoded in the spaces between the infrared pulses as shown in FIG. 11i.”

8) Considering the above, the phrase “library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers”, as used in the claims of the ‘067 patent, can only mean a grouping of the specific information necessary to cause the transmitter of the universal remote control to send signals including all of the characteristics, such as frequency, modulation format, bit pattern, bit rate, error checking, and other characteristics, as is necessary to cause a specific home appliance in a plurality of possible home appliances of different manufacturers to receive and recognize the transmitted signal and to perform a specific function.

9) Further considering the above, the phrase “matching the universal remote control to a plurality of different home appliances of different manufacturers” as used Claims 1, 3, 4, and 6 of the ‘067 patent can only mean the selection of a desired subset of information necessary to cause the transmitter of the universal remote control to send signals comprising all of the characteristics, such as frequency, modulation format, bit pattern, bit rate, error checking, and other characteristics, as are required to cause a specific home appliance to receive and recognize the transmitted signals and to perform a specific functions.

10) As one of ordinary skill in the art, it is my opinion that the HOME RUN, Micromint's Home Control System can transmit a signal of one and only one characteristic. Illustrating this, the HOME RUN User's Manual, Page 8 states: "A command message contains 9 bits of information consisting of the 4-bit house code and the 5-bit matrix (keyboard function) code. A logic 1 bit is three 1-millisecond bursts of 120 kHz signal commencing approximately 200 microseconds after the zero crossing of the AC line. A logic 0 is represented by no signal for that half cycle. To synchronize the receivers with the transmitter, a trigger code consisting of three successive logic 1 bits followed by a logic 0 bit is used. The complete message takes 11 full AC cycles (183 ms) to complete."

11) As one ordinary skill in the art, it is my opinion that HOME RUN, Micromint's Home Control System can control multiple devices that conform to its one signal format by use of the transmitted address and data bits contained within that signal format. This is illustrated in the HOME RUN User's Manual, Page 8, stated as:

"Fully expanded, the BSR system can accommodate 256 independently addressable receivers. That is accomplished using 16 sets of addresses called "house codes" and 16 "device codes" for each house code."

12) As one of ordinary skill in the art, it is my opinion that HOME RUN, Micromint's Home Control System can control a limited set of receivers, all of which conform to its single signal transmission format. Illustrating this, the HOME RUN User's Manual on Page 7 states: "Originally, the X-10 system consisted of five modules: The Command Controller, Cordless Controller, Lamp Module, Appliance Module, and Wall Switch Module. Today the line has been expanded to include a programmable timer, wall receptacle modules, automatic setback thermostats, and telephone auto-answer controller. The HCS can use and control any BSR receivers."

13) As one of ordinary skill in the art, it is my opinion that HOME RUN, Micromint's Home Control System controls only receiver modules and does not directly control any appliance connected to the module. This is illustrated in the HOME RUN User's Manual, where on page 7 it states: "Whatever their designation, the command controller (or any unit that functions as a command transmitter) is the central element in the system. It sends commands to the receiver modules by coded messages send through the AC power lines.

14) Considering the above, as one of ordinary skill in the art, it is my opinion that the HOME RUN, Micromint's Home Control System only provides a control signal of a single characteristic. It is my further opinion that the Home Control System ("HCS") only controls receivers that are designed to receive and recognize signals that conform to its single signal format. It is my further opinion that the HCS does not contain a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers. It is my further opinion the HCS does not provide a means or method of selecting codes and data from a library of codes and data that are used for transmitting operating command to a plurality of different home appliances of different manufacturers. It is my further opinion that the HCS does not match itself to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances. And it is my further opinion that the HCS does not provide a readable medium having instructions for performing matching of a universal remote control to a plurality of different home appliances of different manufacturers such that selected cods and data from the library are used to transmit operating commands to the matched home appliances."

15) Considering the above, as one of ordinary skill in the art, it is my opinion that the HCS is not a "universal remote control" and would not have been considered a "universal remote control" on or after October 14, 1987.

16) Considering the above, as one of ordinary skill in the art, it is my opinion that the HCS is a controller designed around a control signal of a single format and character to which many receivers of differing function but single signal format could be designed.

17) Considering the above, as one of ordinary skill in the art, the claims of the '067 patent include elements that describe the means and methods by which a controller ("universal remote control") can be adapted to the signals of many and varied formats used by a wide range of equipment (home appliances) of many different types and from many different manufacturers which elements, in my opinion, fail to be described, taught, or suggested by the HSC.

18) Considering the above, as one of ordinary skill in the art, it is my opinion that the HCS does not include any teachings that anticipate or render obvious the claims of the '067 patent.

DECLARATION

1) I declare under penalty of perjury that the foregoing Declaration is true and correct.

Date: 6-10-2008



Alex Cook

CHI 57280339v1



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,876	01/17/2006	6587067		7865

7590 07/17/2008

GREENBURG TRAURIG PC
77 W WACKER DRIVE
SUITE 2500
CHICAGO, IL 60101

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/17/2008

Please find below and/or attached an Office communication concerning this application or proceeding.



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Kenneth D'Alessandro
Sierra Patent Group, Ltd
1657 Hwt 395, Suite 202
Minden, NV 89423

MAILED
JUL 17 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,876.

PATENT NO. 6587067.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Ex Parte Reexamination Advisory Action Before the Filing of an Appeal Brief	Control No. 90/007,876	Patent Under Reexamination 6587067	
	Examiner Woo H. Choi	Art Unit 3992	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE PROPOSED RESPONSE FILED 11 June 2008 FAILS TO OVERCOME ALL OF THE REJECTIONS IN THE FINAL REJECTION MAILED 11 April 2008.

1. Unless a timely appeal is filed, or other appropriate action by the patent owner is taken to overcome all of the outstanding rejection(s), this prosecution of the present *ex parte* reexamination proceeding WILL BE TERMINATED and a Notice of Intent to Issue *Ex Parte* Reexamination Certificate will be mailed in due course. Any finally rejected claims, or claims objected to, will be CANCELLED.

THE PERIOD FOR RESPONSE IS EXTENDED TO RUN _____ MONTHS FROM THE MAILING DATE OF THE FINAL REJECTION.
Extensions of time are governed by 37 CFR 1.550(c).

NOTICE OF APPEAL

2. An Appeal Brief is due two months from the date of the Notice of Appeal filed on 11 June 2008 to avoid dismissal of the appeal. See 37 CFR 41.37(a). Extensions of time are governed by 37 CFR 1.550(c). See 37 CFR 41.37(e).

AMENDMENTS

3. The proposed amendment(s) filed after a final action, but prior to the date of filing a brief, will not be entered because:
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) They raise the issue of new matter (see NOTE below);
 - (c) They are not deemed to place the proceeding in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____ (See 37 CFR 1.116 and 41.33(a)).

4. Patent owner's proposed response filed _____ has overcome the following rejection(s): _____
5. The proposed new or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. For purposes of appeal, the proposed amendment(s) a) will not be entered, or b) will be entered and an explanation of how the new or amended claim(s) would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) patentable and/or confirmed: _____
Claim(s) objected to: _____
Claim(s) rejected: _____
Claim(s) not subject to reexamination: _____

AFFIDAVIT OR OTHER EVIDENCE

7. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because patent owner failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
8. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence fails to overcome all rejections under appeal and/or appellant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
9. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

10. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached response to arguments.
11. Note the attached Information Disclosure Statement(s), PTO/SB/08, Paper No(s) _____
12. Other: _____

Woo H. Choi
Primary Examiner
CRU 3992

cc: Requester (if third party requester)

Response to Arguments

Patent owner's arguments filed June 11, 2008, have been fully considered but they are not persuasive. Patent owner argues that because the patent has expired, claims should be interpreted under the "ordinary and customary meaning" standard, and that Micromint does not anticipate the claims when construed as proposed by Patent owner. The Examiner agrees that Micromint does not anticipate the claims when the claims are construed as proposed by Patent owner. However, the Examiner does not agree with Patent owner's claim construction. When properly construed under the "ordinary and customary meaning" standard, the claims are anticipated by Micromint.

Patent owner argues that the claimed "codes for use in transmitting operating command to a plurality of different home appliances" can only be construed to mean plural modulation schemes, carrier frequencies, bit encoding schemes, etc. that are to be used to transmit "data" to plural different appliances (Remarks, page 5). This construction is incorrect. The Examiner notes that the inventors have not acted as their own lexicographer by specifically defining the term "code" in the specification. Therefore, the term "code" takes its ordinary and customary meaning.

The ordinary meaning of the word "code" is one of a set of symbols used to represent information. A scheme, on the other hand, is a plan or program of action. Data modulation schemes, carrier frequencies, and bit encoding schemes all relate to methods, plans, or ways of carrying information from the transmitter to the receiver of the information. Schemes and

Art Unit: 3992

frequencies are not codes as Patent owner contends. While it is true that the term “code” encompasses symbols used in modulation schemes and bit/data encoding schemes (for example, “nrz” codes, error correction codes, binary decimal codes, ASCII codes etc.), its meaning is not narrowly confined to “codes” used in modulation schemes. The term also covers any other coded information transmitted using various modulation schemes, such as command codes and address codes for use in transmitting operating commands to a plurality of different home appliances. As to the declarations of Mr. Cook and Mr. Hayes, they present personal opinions of the declarants. Personal opinions are no substitutes for evidence. Micromint provides factual evidence of the use of the term “code” in connection with remote control systems. BSR system uses the term “house **code**” to refer to an encoded bit pattern used to identify a group of BSR receivers and “device **code**” to refer to a bit pattern used to identify a specific receiver. This evidence directly contradicts Patent owners assertion.

Patent owner also argues that it would be improper to construe the claimed “codes for use in transmitting operating commands to a plurality of different home appliances ” as being any type of “data” that is to be transmitted, and that such a construction would impermissively render the claimed “codes” redundant to the claimed “data.” The Examiner disagrees with Patent owner’s characterization of the rejection. The Examiner has not asserted that the limitation “code” reads on any type of “data.” As explained above, a code is a symbol used to represent information whereas data is information. For example, when an ASCII encoded character “A” is transmitted, what is transmitted is an ASCII code that represents the character “A” as well as the information content (i.e., data), the character “A”. In the case of Micromint, the system

Art Unit: 3992

transmits a house code, a device codes and other data such as a command signal. Thus, Micromint specifically discloses transmission of other data in addition to data contained in the codes.

Patent owner further argues that “by the law set forth within Phillips, the claims of the '067 patent, which are directed to steps by which a remote control is matched to particular equipment, can only be construed as requiring a universal remote control that functions, ... , as directly identified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, to select from the "library of codes and data" the particular carrier frequency, ...” (Remarks, page 5). Again, the Examiner disagrees. The matching limitation states “matching the universal remote control to a plurality of different home appliances of different manufactures ...” The claim does not state “as directly identified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, to select from the "library of codes and data" the particular carrier frequency ...” By the law set forth within Pillips, limitations are not to be imported from the specification into the claims (“In Phillips, we held that while “the specification [should be used] to interpret the meanings of a claim,” courts must not “**import**[] **limitations** from the specification into the claim.”” In re Trans Texas Holdings Corp., 498 F.3d 1290, 1294 (Fed. Cir. 2007)) (emphasis in the original).

Art Unit: 3992

All correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

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ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit


By hand to: Customer Service Window
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Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Woo H. Choi/

Woo H. Choi
Primary Examiner
Central Reexamination Unit 3992

ESK
JOT

Reexamination 	Application/Control No. 90007876	Applicant(s)/Patent Under Reexamination 6587067
	Certificate Date	Certificate Number

Requester Correspondence Address:
 Patent Owner
 Third Party

Kenneth D'Alessandro
 Sierra Patent Group, Ltd
 1657 Hwy 395, Suit 202
 Minden, NV 89423

LITIGATION REVIEW <input checked="" type="checkbox"/>	whc (examiner initials)	04/04/2008 (date)
Case Name	Director Initials	
None	<i>Lin Thavel for GM</i>	

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TYPE OF PROCEEDING	NUMBER
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FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	90/007,876
Filing Date	01/17/2006
First Named Inventor	Paul V. Darbee
Art Unit	3992
Examiner Name	Woo H. Choi
Attorney Docket Number	81230.05US4

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input checked="" type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
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<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	- Declaration of Patrick H. Hayes;
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application		
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks

- Declaration of Alex M. Cook, Jr.;

- return postcard

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name Greenberg Traurig, LLP - Customer No. 34018

Signature

Printed name Gary R. Jarosik

Date June 11, 2008

Reg. No. 35,906

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Date June 11, 2008

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Docket Number (Optional)
81230.05US4

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 on June 11, 2008
 Signature
 Typed or printed name Sheri Fassl

In re Application of
Darbee et al.

Application Number
90/007,876

Filed
01/17/2006

For UNIVERSAL REMOTE CONTROL WITH MACRO COMMAND CAPABILITIES

Art Unit
3992

Examiner
Woo H. Choi

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20 (b)(1))

\$510.00

- Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____
- A check in the amount of the fee is enclosed,
- Payment by credit card. Form PTO-2038 is attached.
- The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.
- The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 502428. I have enclosed a duplicate copy of this sheet.
- A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record.
Registration number 35,906
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Signature

Gary R. Jarosik
Typed or printed name

312-456-8449
Telephone number

June 11, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

0671372008 537EVEN5 00000003 502428 90007876

#1 FC-1401 510.00 DR

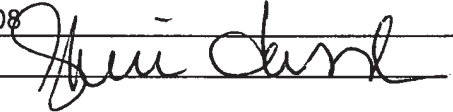
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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450"[37 CFR 1.8(a)] on <u>June 11, 2008</u> Signature  Typed or printed name <u>Sheri Fassi</u>	In re Application of Darbee et al. <hr/> <table style="width:100%;"> <tr> <td style="width:50%;">Application Number 90/007,876</td> <td style="width:50%;">Filed 01/17/2006</td> </tr> </table> For UNIVERSAL REMOTE CONTROL WITH MACRO COMMAND CAPABILITIES <hr/> <table style="width:100%;"> <tr> <td style="width:50%;">Art Unit 3992</td> <td style="width:50%;">Examiner Woo H. Choi</td> </tr> </table>	Application Number 90/007,876	Filed 01/17/2006	Art Unit 3992	Examiner Woo H. Choi
Application Number 90/007,876	Filed 01/17/2006				
Art Unit 3992	Examiner Woo H. Choi				

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

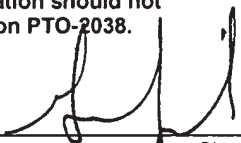
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- Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____
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- attorney or agent of record.
Registration number 35,906
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

 _____ Signature
_____ Gary R. Jarosik Typed or printed name
_____ 312-456-8449 Telephone number
_____ June 11, 2008 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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06/11/08

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	Examiner: Woo H. Choi
)	
Reexam Control No.:	90/007,876)	Attny Doc.: 81230.05US4
)	
Filing Date:	01/17/2006)	Art Unit: 3992
)	
Patent No.:	6,587,067)	
)	
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

RESPONSE AFTER FINAL

Mail Stop "Ex Parte Reexam"

Central Reexamination Unit
 Commisioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated April 11, 2008 please consider the remarks which begin on page 2 of this paper.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the US Postal Service as First Class mail in an envelope addressed to Mail Stop "Ex Parte Reexam," Central Reexamination Unit, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11 day of June, 2008

By: 

Sheri Fassl

REMARKS

At this time, Applicant would like to thank the Examiner for the courtesies extended during a recent phone interview wherein the claims of U.S. Patent No. 6,587,067 (“the ‘067 patent”) and the prior art of record were briefly discussed.

During this phone interview, it was indicated to Applicant that the claims of the ‘067 patent were being construed by the Examiner by being given their “broadest reasonable interpretation” and, for this reason, it was the opinion of the Examiner that the disclosure within “Home Run Micromint’s Home Control System User’s Manual Rev. 1.0” (“Micromint”) anticipated the claims of the ‘067 patent under 35 U.S.C. § 102.

It is, however, respectfully submitted that the claims of the ‘067 patent are not to be construed by being given their broadest reasonable interpretation. Rather, because the subject reexamination proceeding involves claims of an expired patent (the ‘067 patent expired on October 14, 2007) the claims of the ‘067 patent must be construed pursuant to the principles set forth by the court in *Phillips v. AWH Corp.* 415 F.3d 1303 (Fed. Cir. 2005). This is required by MPEP § 2258 which states:

In a reexamination proceeding involving claims of an expired patent, **>claim construction pursuant to the principle set forth by the court in Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim< are not subject to amendment**.*

Considering now *Phillips*, it is respectfully submitted that *Phillips* sets forth that the elements of the claims of the ‘067 patent must be construed to have a scope and meaning that is consistent with the description contained within the specification of the ‘067 patent:

That starting point is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. See *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119 (Fed. Cir. 2002) (patent documents are meant to be “a concise statement for persons in the field”); *In re Nelson*, 280 F.2d 172, 181 (CCPA 1960) (“The descriptions in patents are not

addressed to the public generally, to lawyers or to judges, but, as section 112 says, to those skilled in the art to which the invention pertains or with which it is most nearly connected.”).

Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. This court explained that point well in Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998). See also Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313, 1319 (Fed. Cir. 2005) (“We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history.”); V-Formation, Inc. v. Benetton Group SpA, 401 F.3d 1307, 1310 (Fed. Cir. 2005)

The claims, of course, do not stand alone. Rather, they are part of “a fully integrated written instrument,” Markman, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims “must be read in view of the specification, of which they are a part.” Id. at 979. As we stated in Vitronics, the specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” 90 F.3d at 1582.

On numerous occasions since then, we have reaffirmed that point, stating that “[t]he best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history.” Multiform Desiccants, 133 F.3d at 1478; Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1360 (Fed. Cir. 2004) (“In most cases, the best source for discerning the proper context of claim terms is the patent specification wherein the patent applicant describes the invention.”); see also, e.g., Kinik Co. v. Int’l Trade Comm’n, 362 F.3d 1359, 1365 (Fed. Cir. 2004) (“The words of patent claims have the meaning and scope with which they are used in the specification and the prosecution history.”); Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1315 (Fed. Cir. 2003) (“[T]he best indicator of claim meaning is its usage in context as understood by one of skill in the art at the time of invention.”).

In light of the statutory directive that the inventor provide a “full” and “exact” description of the claimed invention, the specification necessarily informs the proper construction of the claims. See Merck & Co. v. Teva Pharms. USA, Inc., 347 F.3d 1367, 1371 (Fed. Cir. 2003) (“A fundamental rule of claim construction is that terms in a patent document are construed with the meaning with which they are presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part.”) (citations omitted).

Turning now to the specification of the ‘067 patent, it is respectfully submitted that the specification of the ‘067 patent provides only one possible meaning for the claimed “data

for use in transmitting operating commands to a plurality of different home appliances of different manufacturers.” In the context of the ‘067 patent, the claimed “data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” is illustrated in Fig. 11 of the ‘067 patent and described at Col. 9, lines 35-37 of the ‘067 patent which sets forth:

Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed.

Thus, in keeping with the context in which the claimed terms are used within the specification of the ‘067 patent, the claimed “data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers” can only be construed to mean patterns of bits, i.e., zeros and ones, that are to be sent from the universal remote control to the appliances.

In addition to the “data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers,” the claims of the ‘067 patent further require “codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers.” In the context of the ‘067 patent, the claimed “codes for use in transmitting operating commands to a plurality of different home appliances” is illustrated in Fig. 11 of the ‘067 patent and described at Col. 9, lines 14-27 of the ‘067 patent which sets forth:

The infrared codes to be learned include a wide range of different codes for operating different electrical apparatus manufactured by the same or different manufacturers. In FIG. 11, which is identical to FIG. 1 in U.S. Pat. No. 4,623,887, there are illustrated several modulation schemes for infrared codes. FIGS. 11a-11g illustrate different types of gated carrier frequencies. Typical carrier frequencies for infrared remote transmitters are 20 Khz to 45 Khz, with the majority being at 38 Khz and 40 Khz. The gating schemes illustrated include both fixed and variable bit periods, non-return to zero (NRZ), variable burst widths, single/double burst modulation schemes, and a final catch-all category called random because there is no readily distinguishable pattern of ones and zeros. Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme

which causes different data to be sent depending upon the transmitter and the key pressed. (*emphasis added*)

Thus, in keeping with the context in which the claimed terms are used within the specification of the '067 patent, the claimed “codes for use in transmitting operating commands to a plurality of different home appliances” can only be construed to mean plural modulation schemes, carrier frequencies, bit encoding schemes, etc. that are to be used to transmit “data” to plural different appliances.

It is additionally respectfully submitted that it would be improper to construe the claimed “codes for use in transmitting operating commands to a plurality of different home appliances” as being any type of “data” that is to be transmitted. In this regard, it is first noted that the specification of the '067 patent never discloses, teaches, or suggests that a “code for use in transmitting operating commands to a plurality of different home appliances” is “data” but instead makes clear that a “code” is used to transmit “data” to an appliance. As such, the specification of the '067 patent itself would not support such a claim construction. It is further respectfully noted that such a claim construction would also impermissibly render the claimed “codes” redundant to the claimed “data.” *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (“the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms”).

From the foregoing, it is respectfully submitted that, by the law set forth within *Phillips*, the claims of the '067 patent, which are directed to steps by which a remote control is matched to particular equipment, can only be construed as requiring a universal remote control that functions, for each of the plurality of different appliances of different manufacturers that the universal remote control is intended to be matched, i.e., to control, as directly identified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, to select from the “library of codes and data” the particular carrier frequency, modulation scheme, bit encoding scheme,

etc. and the data that is appropriate for each home appliance so directly identified to the universal remote control.

That one of ordinary skill in the relevant art, i.e., the art of remote controls and data communications, would understand the claims of the '067 to have this scope and meaning is evidenced by the attached declarations of Patrick Hayes and Alex Cook.

It is additionally noted that the attached declarations are being submitted to address contentions that have been newly raised in the latest Office Action and, for this reason, the declarations could not have been earlier submitted. Among other things, the declarations are being submitted to address the contentions of the Examiner, first raised in the Office Action of April 11, 2008, that the claims of the '067 patent do not require interaction to match the claimed universal remote control to a plurality of different home appliances of different manufacturers, do not specify who or what must perform the step of matching, and do not specify how the matching must be performed.

With this proper construction of the claims of the '067 patent in mind, it is respectfully submitted that Micromint does not disclose, teach, or suggest at least the claimed "library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" or the claimed "matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard." Rather than disclose a "library of codes and data," i.e., appropriate carrier frequencies, modulation schemes, bit encoding schemes, etc. and data for each of plural, different appliances of different manufacturers the universal remote control may be used to control, from which codes and data are selected to match the universal remote control to directly identified appliances, Micromint discloses a system in which a single, predefined carrier

frequency, modulation scheme, and bit encoding scheme is used to transmit predefined data, which data includes a “house code” and a “device code,” to BSR modules in a manner that is exactly the same as was described in the previously cited to and considered US Patent No. 4,200,862. In Micromint, the “house code” and “device code” are simply not “codes” as that term is used within the context of the ‘067 patent. As noted in previously filed responses, the “house code” and “device code” of the Micromint system are nothing more than bits that are included within the data message that is transmitted to BSR modules on a fixed 120 kHz signal that is pulse width modulated on the AC line. (See Micromint, Fig. 1, pages 8-9 as compared to U.S. Patent No. 4,200,862, Figures 11 and 12, Col. 1, line 64-Col. 2, line 3, Col. 4, lines 4-31, Col. 5, lines 3-11). Thus, because the system described within Micromint fails to include a library of the specific information, i.e., “codes and data,” that would be necessary for a transmitter to send plural forms of signals, including all of the characteristics such as frequency, modulation format, bit pattern, bit rate, error checking, etc., as is necessary to allow a home appliance from a plurality of possible home appliances of different manufacturers to receive and recognize a transmitted signal and to perform a specific function, it is respectfully submitted that Micromint fails to disclose, teach, or suggest each and every element set forth in the claims of the ‘067 patent as is required to maintain a rejection under 35 U.S.C. § 102. For at least this reason it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 102 must be withdrawn.

Respectfully Submitted;



Date: June 11, 2008

By: Gary R. Jarosik; Reg. No. 35,906
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Chicago, Illinois 60601
(312) 456-8449

PROOF OF SERVICE

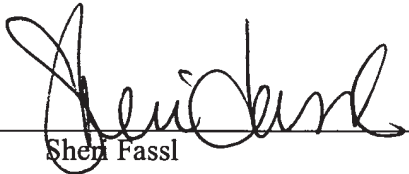
I declare that:

1. I am a citizen of the United States and am employed in the County of Cook, State of Illinois.
2. I am over the age of eighteen years and am not a party to this action.
3. My business address is 77 W. Wacker Drive, Suite 2500, Chicago, Illinois 60601-1732.
4. On June 11, 2008, I served a copy of all of the papers included with this Response in Reexamination No. 90/007,876, including the Declarations of Pat Hayes and Alex Cook and the Notice of Appeal, by placing a copy of the same in a sealed envelope and mailing it via First Class Mail with the U.S. Postal Service, addressed as follows:

Jonathan D. Hanish
Sierra Patent Group Ltd.
1657 Hwy 395, Suite 202
Minden, NV 89423

I declare under penalty of perjury in accordance with the laws of the State of Illinois that the foregoing is true and correct.

Date: June 11, 2008


Shen Fassel

CHI 57242919v1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	Examiner: Choi, Woo H.
)	
Reexam Control No.:	90/007,876)	Attny Doc.: 81230.05US4
)	
Filing Date:	01/17/2006)	Art Unit: 3992
)	
Patent No.:	6,587,067)	
)	
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

DECLARATION OF PATRICK H. HAYES

I, Patrick H. Hayes, declare as follows:

I. INTRODUCTION

1. I hold a BSc(Eng) (Electrical) from the University of the Witwatersrand, Johannesburg.
2. I have served in various engineering and development capacities in the electronics industry since 1969, including fourteen years in commercial computers and networking, eight years in telecommunications, and sixteen years in consumer electronics.
3. Since 1992, I have been employed by Universal Electronics Inc., a major developer and manufacturer of universal remote controls, performing at various times as Director of Software Development, Vice President of Technology Development, Vice President of Core Technology, and Vice President of Intellectual Property.
4. Universal Electronics Inc. is the assignee of U.S. Patent No. 6,587,067 which is the subject of this reexamination proceeding.

5. I am a named inventor on over sixty granted and pending U.S. Patent applications, the majority of which relate to universal remote control technology.

II. INFORMATION CONSIDERED

1. In forming the opinions and conclusions set forth below, I have relied upon my knowledge and experience and have considered the following documents that have been provided to me:

- a) US Patent No. 6,587,067 (“the ‘067 patent”)
- b) “Home Run Micromint’s Home Control System User’s Manual Rev. 1.0, The Micromint, Inc. Terrace Drive, Vernon, CT 06066, April 1, 1985, pages 1-159 (“Micromint”)
- c) US Patent No. 4,200,862 (“the ‘862 patent”)

III. OPINIONS AND CONCLUSIONS

1. As one of ordinary skill in the relevant art, I understand the claims of the ‘067 patent to require interaction to match the claimed universal remote control to a plurality of different home appliances of different manufacturers.

2. By way of example, claim 3 of the ‘067 patent sets forth that interaction in the form of activations of one or more pushbuttons of the keyboard of the universal remote control are used to match the universal remote control to the plurality of different home appliances of different manufacturers.

3. As one of ordinary skill in the relevant art, I understand the claims of the ‘067 patent to specify who or what must perform the step of matching.

4. By way of example, claim 3 of the '067 patent specifies that it is the instructions of the readable media in the universal remote control that perform various steps including the step of matching the universal remote control to a plurality of different home appliances of different manufacturers.

5. As one of ordinary skill in the relevant art, I understand the claims of the '067 patent to specify how the matching must be performed.

6. By way of example, claim 3 of the '067 patent specifies that matching is performed by selecting from a library those codes and data that are to be used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard, with activations of one or more of the pushbuttons of the keyboard being used to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched.

7. As one of ordinary skill in the relevant art, within the context of the specification of the '067 patent, the claim term "data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed to mean the patterns of bits that are to be sent from the universal remote control to appliances. By way of example, this is illustrated in Fig. 11 of the '067 patent and described at Col. 9, lines 35-37 of the '067 patent which sets forth:

Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed.

8. As one of ordinary skill in the relevant art, within the context of the specification of the '067 patent the claim term "codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" can only be construed to mean the carrier frequencies, modulation schemes, and bit encoding schemes used to transmit the "data" from the universal remote control to appliances. By way of example, this is illustrated in Fig. 11 of the '067 patent and described at Col. 9, lines 14-27 of the '067 patent which sets forth:

The infrared codes to be learned include a wide range of different codes for operating different electrical apparatus manufactured by the same or different manufacturers. In FIG. 11, which is identical to FIG. 1 in U.S. Pat. No. 4,623,887, there are illustrated several modulation schemes for infrared codes. FIGS. 11a-11g illustrate different types of gated carrier frequencies. Typical carrier frequencies for infrared remote transmitters are 20 Khz to 45 Khz, with the majority being at 38 Khz and 40 Khz. The gating schemes illustrated include both fixed and variable bit periods, non-return to zero (NRZ), variable burst widths, single/double burst modulation schemes, and a final catch-all category called random because there is no readily distinguishable pattern of ones and zeros. Data modulation schemes for most transmitters have a higher level of data organization which may be called a keyboard encoding scheme which causes different data to be sent depending upon the transmitter and the key pressed.

9. In view of the foregoing, within the context of the specification of the '067 patent, one of ordinary skill in the relevant art only interpret the claim term "a library codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" to mean that the universal remote control includes, for each of the different appliances of different manufacturers the universal remote control may be used to control, a tabulation of an appropriate carrier frequency, modulation scheme, bit encoding scheme, and data that will allow the universal remote control to transmit communications that will be recognized by the intended target appliance.

10. In view of the foregoing, within the context of the specification of the '067 patent, one of ordinary skill in the relevant art can only interpret the claim term "matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard" to mean that, for each of the plurality of different appliances of different manufacturers the universal remote control is intended to control, as directly identified to the universal remote control via activation of one or more of the pushbuttons of the keyboard of the universal remote control, the universal remote control will be caused to select from the "library" the particular carrier frequency, modulation scheme, bit encoding scheme, and data that is appropriate for each home appliance so identified.

11. As one of ordinary skill in the relevant art, within the context of the specification of the '067 patent, the '067 patent never discloses, teaches, or suggests that "codes for use in transmitting operating commands to a plurality of different home appliances of different manufacturers" may be a "house code" or a "device code."

12. As one of ordinary skill in the relevant art, in the context of Micromint, a "house code" and a "device code" is not a carrier frequency, modulation scheme, or bit encoding schemes used to transmit "data." Rather, within the context of Micromint, the "house code" and the "device code" is a component part of the transmitted data, i.e., bits. By way of example, this is illustrated in Fig. 1 of Micromint and described in Micromint on page 8 as follows:

At the heart of a BSR command module, as well as of the other system components, are custom LSI IC's manufactured for BSR by General Instruments Corp. Fully expanded, the BSR system can accommodate 256 independently addressable receivers. That is accomplished using 16 sets of addresses called "house codes" and 16 "device codes" for each house code. The separate house codes allow next-door neighbors to use X-10's

without interfering with each other. A thumbwheel switch on the bottom of the command console and the receiver modules sets the 4-bit house code.

In normal operation the 22 button keypad on the BSR command console, which is wired as a 3x8 matrix, is scanned at a rate of 3.8 kHz. When a button is pressed, its designated function and the house code are combined into a single message. The digital message is directed to the transmitter section where it generates 120 kHz signals that are used to pulse width modulate the AC line.

13. As one of ordinary skill in the relevant art, Micromint fails to disclose, teach, or suggest a device that can use multiple carrier frequencies, modulation schemes, and bit encoding schemes for transmitting data to plural different appliances of plural different manufacturers. Rather, Micromint discloses the use of a single carrier frequency, modulation scheme, and bit encoding scheme that is dedicated for use in transmitting data only to BSR modules. This is illustrated in Fig. 1 of Micromint on page 9 and described in Micromint on page 8 as follows:

The digital message is directed to the transmitter section where it generates 120 kHz signals that are used to pulse width modulate the AC line.

The transmitted message is clocked a bit at a time, on zero crossing. A command message contains 9 bits of information consisting of the 4-bit house code and 5-bit matrix (keyboard function) code. Each message is transmitted in true and inverted format on successive half cycles of the AC waveform.

A logic 1 bit is three 1-millisecond bursts of 120 kHz signal commencing approximately 200 microseconds after the zero crossing of the AC line. A logic 0 bit is represented by no signal for that half cycle. To synchronize the receivers with the transmitters, a trigger code consisting of three successive logic 1 bits followed by a logic 0 bit is used. The complete message takes 11 full AC cycles (83 ms) to complete.

14. As one of ordinary skill in the relevant art, the inclusion of a "house code" which "... allow(s) next-door neighbors to use X-10's without interfering with each other" is specifically indicative of and necessitated by the fact that the BSR/X-10 modules used in the

Micromint system all share a single pre-determined carrier frequency, modulation scheme, and bit encoding scheme.

15. As one of ordinary skill in the relevant art, the use of “house code” and “device code” in Micromint is consistent with the description of “house code” and “appliance code” set forth in the ‘862 patent. I observe the similarity between Micromint Figure 1 and Figures 11 and 12 of the ‘862 patent. Like Micromint, the ‘862 patent describes that these “codes” are nothing more than a component part of the data that is transmitted to a BSR device, i.e., bits, for the purpose of allowing a BSR device to recognize that it is the intended recipient of a data transmission. By way of example, this is illustrated in Fig. 21 of the ‘862 patent and described in the ‘862 patent at Col. 1, line 64-Col. 2, line 3 as follows:

There is also preferably incorporated into the digital signals a house or system code which can be unique to that system. The slave unit must then decode a given system code before it responds to the device or operation data in the signals. In this way interference between neighbouring systems, for example different systems used in the same building or in the same street if electrically coupled, can be reduced.

at Col. 4, lines 4-31 as follows:

To distinguish between appliances, each slave unit is given an appliance code which is set manually by means of a rotary switch (8) at each slave unit. Another rotary switch (7) is provided both at the slave units and at the table top transmitter in order that a “housecode” can be set, this “housecode” being intended to be unique to the house or building concerned to prevent interference between separate systems which are electrically coupled--for example houses in the same street.

When it is desired to control one of the appliances, the keyboard is operated to key in the appliance code concerned followed by the operation desired, e.g. “on”. The transmitter will in consequence develop two digital signals, the first of which represents the appliance code and the second of which represents the desired operation. The house code is added to both digital signals which are passed on to the main in sequence. The first digital signal is conveyed by the main to each slave unit but only one of the slave units will respond to this signal, i.e. the slave unit which contains the house code and appliance code concerned. This particular slave unit will be enabled by the first digital signal, so that when the second digital signal arrives it will execute the demanded operation. Subsequently, that

slave unit remains enabled for further operational orders unit such time that another appliance code is called for by the transmitter.

and at Col. 5, lines 3-11 as follows:

A house or system code is defined at the unit by rotary switch 7 of a conventional construction as indicated by FIG. 2. The four bits defined by the switch 7 are taken to input terminals H1 and H4 of the integrated circuit. The four bits of the housecode are added to the data entered via the keyboard and also appear at output "SER.OUT" for injection onto the mains.

16. As one of ordinary skill in the relevant art, Micromint does not disclose "matching" a universal remote control to an appliance to be controlled as that term can only be construed in the claims of the '067 patent. Micromint does not disclose, teach, or suggest the use of a library of multiple carrier frequencies, modulation schemes, or bit encoding schemes.

Considering the disclosure at page 9 of Micromint:

... the receiver section monitors the AC line, waiting for a coded message corresponding to its unique house code (A through P) and unit device code (1 through 16). To turn on channel 10, one simply presses 10 and ON, one after the other.

which steps correspond to those detailed in the '862 patent at column 4 lines 14-28

When it is desired to control one of the appliances, the keyboard is operated to key in the appliance code concerned followed by the operation desired, e.g. "on". The transmitter will in consequence develop two digital signals, the first of which represents the appliance code and the second of which represents the desired operation. The house code is added to both digital signals which are passed on to the main in sequence. The first digital signal is conveyed by the main to each slave unit but only one of the slave units will respond to this signal, i.e. the slave unit which contains the house code and appliance code concerned. This particular slave unit will be enabled by the first digital signal, so that when the second digital signal arrives it will execute the demanded operation.

these steps represent a simple act of selection of a BSR module to be controlled using a fixed, predetermined, carrier frequency, modulation scheme, and bit encoding, and do not anywhere describe an act of matching an appliance to a one of a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different

manufacturers, as is contemplated by the '067 patent. In this context, it is to be noted that the "matching" claimed within the '067 patent need occur only once, during initial configuration of the universal remote control, as described for example at Col 14 lines 39-46:

Matching the Device to Your Equipment

The device 10 can control most remote controlled TV's, VCR's, cable converters, and CD players, but it needs the user's input to match it to your particular equipment. The easiest way to do this is to STEP-and-SET your device 10. You will only need to do this once for each different type of device you have.

whereas in Micromint, the described selection of a BSR module to be controlled must be performed each and every time a user of the system wishes to switch between modules, i.e., this is akin to the equipment selection actions described elsewhere in the '067 patent, for example at Col 15, lines 29-30:

Take a look at the keyboard. There are four groups of buttons:

1. Equipment Selection Buttons tell the device 10 which equipment is to be controlled:

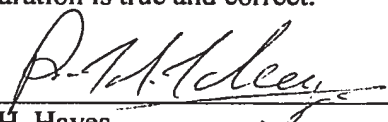
VCR1	Cable	TV
VCR2	CD	

and does not comprise "matching" as that term can only be construed in the claims of the '067 patent.

IV. DECLARATION

1. I declare under penalty of perjury that the foregoing Declaration is true and correct.

Date: JUNE 10, 2008



Patrick H. Hayes

CHI 57280651v1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Darbee et al.)	Examiner: Choi, Woo H.
)	
Reexam Control No.:	90/007,876)	Attny Doc.: 81230.05US4
)	
Filing Date:	01/17/2006)	Art Unit: 3992
)	
Patent No.:	6,587,067)	
)	
Title:	Universal Remote Control)	
	With Macro Command)	
	Capabilities)	

DECLARATION OF ALEX M. COOK, JR.

I, Alex M. Cook, Jr. declare as follows:

BACKGROUND

- 1) I received a Bachelor in Electrical Engineering Degree from the Georgia Institute of Technology in 1977. I did additional non-degree graduate level work at the Georgia Institute of Technology in 1978.
- 2) I have worked in the electronics industry since 1978 in various engineering and management positions. I worked for Scientific Atlanta, Inc. from 1985 until 1996 during a major portion of which I was directly responsible for all remote control devices designed and manufactured by the company. I have direct experience in the design of hardware, software, and transmission protocols of remote control units of both single device and universal types. During my tenure at Scientific Atlanta, I was also directly involved in drafting patent applications and reviewing issued patents for infringement concerns. Since 1996 I have worked as a engineering consultant for various clients. This work has included additional work with remote controls, including consulting on the development of advanced

remotes, procurement assistance for single device and universal remotes, and as an expert witness in a number of patent infringement cases in the area of remote control devices.

3) I am currently employed by K-TAC, LLC, a consulting firm in Lawrenceville, GA.

4) I was hired by Universal Electronics Inc. to prepare this declaration and received compensation for the preparation of this declaration.

INFORMATION CONSIDERED

1) I have reviewed the following documents and relied on my personal knowledge and experience in the remote control field in developing the opinions offered here.

US Patent No. 6,587,067 (“the ‘067 patent”)

US Patent No. 4,200,862 (“the ‘862 patent”)

“HOME RUN, MICROMINT’S HOME CONTROL SYSTEM” Users Manual, Rev

1.0

OPINIONS

1) As one of ordinary skill in the art, the term “instructions”, as used in the claims of the ‘067 patent mean groups of executable control codes as used in a microprocessor or central processing unit to control the operation of the processor in order to achieve a desired outcome. I find the following examples in the ‘067 patent support this definition.

- a. FIG 12B, Step 4 states “TRANSFORM STORED DATA TO LIST OF EXECUTABLE INSTRUCTIONS WHICH REPRODUCE BIT STREAM”
- b. Column 2, Line 57ff, “re-enabling the central processing unit to enable the central processing unit to execute the instructions so transferred.”

- c. Column 8, Line 24ff, "Incoming data is received serially at serial port 3 and conveyed to input port 112, when it is desired to update the code data and/or instructions in RAM 54."
- d. Column 10, Line 8ff, "When the CPU 56 executes the instructions set forth..."

2) As one of ordinary skill in the art, the claims of the '067 patent require instructions that achieve a specific outcome and qualifications on how that outcome is achieved. As an example, in claim 1, instructions are required that achieve the specific outcome of "matching the universal remote control to a plurality of different home appliances of different manufacturers".

3) As one of ordinary skill in the art, the claims of the '067 patent do specify how the "matching" must be performed. As an example, claim 1 requires the matching to be performed by "the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched". As a further example, the description of the action in the specification, beginning at Column 14, Line 40 offers a preferred embodiment of the first required element, "matching...", of the method of Claim 4

4) As one of ordinary skill in the art, the claims of the '067 patent do specify who or what must perform the required step of matching. For example, in Claim 1, the instructions contained in the readable medium in the remote control, perform the matching process in response to keys pressed by the user. As an example, one embodiment is shown in FIG 16 and referred to in Column 10, Line 39ff which clearly shows the major steps in the process defined by the instructions and also clearly shows the user interaction.

5) As one of ordinary skill in the art, the claims of the '067 patent do require an "appliance awareness" on the part of the controller. As an example, in Claim 1, the instructions for matching include the additional requirement "such that selected codes and

data from the library are used to transmit operating commands to the matched home appliance in response to activation of selected pushbuttons of the keyboard". As a further example, in the description of the preferred embodiment, in Column 14, Line 40ff, we find "The device 10 can control most remote controlled TV'S, VCR's, cable converters, and CD players, but it needs the user's input to match it to your particular equipment."

6) As one of ordinary skill in the art, the phrase "to transmit operating commands to the matched home appliances", used in Claims 1, 3, 4, and 6, can only mean that the transmitted command is received and recognized directly by the matched home appliance. As an example, in the '067 patent at Column 14, line 57 through Column 15, line 2 state "3. Aim the device 10 at the equipment and try various function buttons to see if the equipment responds correctly. Make sure you are reasonably close to the equipment and that nothing is blocking the path. The light (LED 4) at the top of the device 10 will shine green whenever it is sending an infrared code, or it will not light at all if it does not send a code for a particular button. 4. If your equipment did not respond correctly or did not respond at all, press DO1 to change the device 10 so that it will send the next set of infrared codes in its library, or press DO2 to change it so it will send the previous set of codes."

7) As one of ordinary skill in the art, the phrase "operating commands" as used in the '067 patent Claims 1,3,4, and 6, can only mean a transmission of a signal that incorporates all of the characteristics, such as frequency, modulation format, bit pattern, bit rate, error checking, and other characteristics as necessary, needed for the transmitted signal to be received and recognized by the matched home appliance and to cause matched home appliance to operate in the desired fashion. As an example, in the '067 patent, Column 9, lines 14 – 34 state "The infrared codes to be learned include a wide range of different codes for operating different electrical apparatus manufactured by the same or different manufacturers. In FIG. 11, which is identical to FIG. 1 in U.S. Pat. No. 4,623,887, there are

illustrated several modulation schemes for infrared codes. FIGS. 11a-11g illustrate different types of gated carrier frequencies. Typical carrier frequencies for infrared remote transmitters are 20 Khz to 45Khz, with the majority being at the 38 Khz and 40 Khz. The gating schemes illustrated include both fixed and variable bit periods, non-return to zero (NRZ), variable burst widths, single/double burst modulation schemes, and a final catch-all category called random because there is no readily distinguishable pattern of ones and zeros. In addition to these schemes, there is also a transmitter which puts out a different continuous frequency (CW) for each key as represented in FIG. 11h. Finally, several new types of transmitters do not use a carrier frequency at all but instead send a stream of pulses where the data is encoded in the spaces between the infrared pulses as shown in FIG. 11i.”

8) Considering the above, the phrase “library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers”, as used in the claims of the ‘067 patent, can only mean a grouping of the specific information necessary to cause the transmitter of the universal remote control to send signals including all of the characteristics, such as frequency, modulation format, bit pattern, bit rate, error checking, and other characteristics, as is necessary to cause a specific home appliance in a plurality of possible home appliances of different manufacturers to receive and recognize the transmitted signal and to perform a specific function.

9) Further considering the above, the phrase “matching the universal remote control to a plurality of different home appliances of different manufacturers” as used Claims 1, 3, 4, and 6 of the ‘067 patent can only mean the selection of a desired subset of information necessary to cause the transmitter of the universal remote control to send signals comprising all of the characteristics, such as frequency, modulation format, bit pattern, bit rate, error checking, and other characteristics, as are required to cause a specific home appliance to receive and recognize the transmitted signals and to perform a specific functions.

10) As one of ordinary skill in the art, it is my opinion that the HOME RUN, Micromint's Home Control System can transmit a signal of one and only one characteristic. Illustrating this, the HOME RUN User's Manual, Page 8 states: "A command message contains 9 bits of information consisting of the 4-bit house code and the 5-bit matrix (keyboard function) code. A logic 1 bit is three 1-millisecond bursts of 120 kHz signal commencing approximately 200 microseconds after the zero crossing of the AC line. A logic 0 is represented by no signal for that half cycle. To synchronize the receivers with the transmitter, a trigger code consisting of three successive logic 1 bits followed by a logic 0 bit is used. The complete message takes 11 full AC cycles (183 ms) to complete."

11) As one ordinary skill in the art, it is my opinion that HOME RUN, Micromint's Home Control System can control multiple devices that conform to its one signal format by use of the transmitted address and data bits contained within that signal format. This is illustrated in the HOME RUN User's Manual, Page 8, stated as:

"Fully expanded, the BSR system can accommodate 256 independently addressable receivers. That is accomplished using 16 sets of addresses called "house codes" and 16 "device codes" for each house code."

12) As one of ordinary skill in the art, it is my opinion that HOME RUN, Micromint's Home Control System can control a limited set of receivers, all of which conform to its single signal transmission format. Illustrating this, the HOME RUN User's Manual on Page 7 states: "Originally, the X-10 system consisted of five modules: The Command Controller, Cordless Controller, Lamp Module, Appliance Module, and Wall Switch Module. Today the line has been expanded to include a programmable timer, wall receptacle modules, automatic setback thermostats, and telephone auto-answer controller. The HCS can use and control any BSR receivers."

13) As one of ordinary skill in the art, it is my opinion that HOME RUN, Micromint's Home Control System controls only receiver modules and does not directly control any appliance connected to the module. This is illustrated in the HOME RUN User's Manual, where on page 7 it states: "Whatever their designation, the command controller (or any unit that functions as a command transmitter) is the central element in the system. It sends commands to the receiver modules by coded messages send through the AC power lines.

14) Considering the above, as one of ordinary skill in the art, it is my opinion that the HOME RUN, Micromint's Home Control System only provides a control signal of a single characteristic. It is my further opinion that the Home Control System ("HCS") only controls receivers that are designed to receive and recognize signals that conform to its single signal format. It is my further opinion that the HCS does not contain a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers. It is my further opinion the HCS does not provide a means or method of selecting codes and data from a library of codes and data that are used for transmitting operating command to a plurality of different home appliances of different manufacturers. It is my further opinion that the HCS does not match itself to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances. And it is my further opinion that the HCS does not provide a readable medium having instructions for performing matching of a universal remote control to a plurality of different home appliances of different manufacturers such that selected cods and data from the library are used to transmit operating commands to the matched home appliances."

15) Considering the above, as one of ordinary skill in the art, it is my opinion that the HCS is not a “universal remote control” and would not have been considered a “universal remote control” on or after October 14, 1987.

16) Considering the above, as one of ordinary skill in the art, it is my opinion that the HCS is a controller designed around a control signal of a single format and character to which many receivers of differing function but single signal format could be designed.

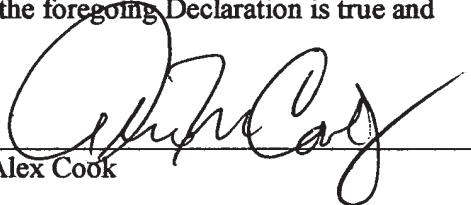
17) Considering the above, as one of ordinary skill in the art, the claims of the ‘067 patent include elements that describe the means and methods by which a controller (“universal remote control”) can be adapted to the signals of many and varied formats used by a wide range of equipment (home appliances) of many different types and from many different manufacturers which elements, in my opinion, fail to be described, taught, or suggested by the HSC.

18) Considering the above, as one of ordinary skill in the art, it is my opinion that the HCS does not include any teachings that anticipate or render obvious the claims of the ‘067 patent.

DECLARATION

1) I declare under penalty of perjury that the foregoing Declaration is true and correct.

Date: 6-10-2008



Alex Cook

CHI 57280339v1



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,876	01/17/2006	6587067		7865

7590 05/10/2008

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/10/2008

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,876.

PATENT NO. 6587067.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Ex Parte Reexamination Interview Summary	Control No. 90/007,876	Patent Under Reexamination 6587067	
	Examiner Woo H. Choi	Art Unit 3992	

All participants (USPTO personnel, patent owner, patent owner's representative):

- (1) Woo H. Choi, Eric Keaseli (3) Gary R. Jarosik
(2) Majid A. Banankhah (4) Pat Hayes

Date of Interview: 5/8/08

Type: a) Telephonic b) Video Conference
c) Personal (copy given to: 1) patent owner 2) patent owner's representative)

Exhibit shown or demonstration conducted: d) Yes e) No.
If Yes, brief description: _____

Agreement with respect to the claims f) was reached. g) was not reached. h) N/A.
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: 1 and 3.

Identification of prior art discussed: Micromint System.

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:
Patent owner basically reiterated the same arguments presented in response to the first action regarding the construction of terms "codes and data", "matching". The examiners disagreed with Patent owner's construction of the terms discussed.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNER'S STATEMENT CAN NOT BE WAIVED. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

cc: Requester (if third party requester)

Woo H. Choi 
Examiner's signature, if required



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EXAMINER

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APR 11 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/007,876.

PATENT NO. 6587067.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

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Office Action in Ex Parte Reexamination	Control No. 90/007,876	Patent Under Reexamination 6587067	
	Examiner Woo H. Choi	Art Unit 3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a Responsive to the communication(s) filed on 03 January 2007. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input type="checkbox"/> Information Disclosure Statement, PTO/SB/08. | 4. <input type="checkbox"/> _____. |

Part II SUMMARY OF ACTION

- 1a. Claims 1-6 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims _____ are patentable and/or confirmed.
4. Claims 1-6 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____ .
4 been filed in reexamination Control No. _____.
5 been received by the International Bureau in PCT application No. _____.
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

Reexamination

1. This is an *ex parte* reexamination of U.S. Patent No. 6,587,067. Claims 1 – 6 are pending. The references discussed herein are as follows:

“Home Run Micromint’s Home Control System User’s Manual Rev. 1.0, The Micromint, Inc, Terrace Drive, Vernon, Connecticut 06066, April 1, 1985, pages 1-159 (“Mircomint”).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Micromint.

4. With respect to claim 1 Micromint discloses **in a universal remote control** (page 1, The Home Run HCS is a single board computer that can remotely control lights and appliances in a home) **comprising a keyboard having a plurality of pushbuttons** (page 27, Figure 10; see also page 1, HCS can use any terminal, or a personal computer emulating a terminal) **including a macro pushbutton** (page 2, superkey, HCS has 16 function keys which cause a user defined list of actions to be performed when the appropriate key is entered. This allows a complete sequence of events to be transmitted.) **and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers** (page 8, BRS system can accommodate 256 independently addressable receivers, i.e., a library of 256

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codes; see also page 44, HSC has a library of codes and data for use in transmitting operating commands such as ON, OFF, DIM, etc. to multiple appliances, each of which can be of different manufacturer), **a readable medium having instructions** (page 12, RAM and ROM used to run HCS is disclosed) **for performing steps comprising:**

matching the universal remote control to a plurality of different home appliances of different manufacturers (see page 44, HCS can be matched with 16 different home appliances of different manufacturers) **such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard** (page 44 show that in response to activation of selected pushbuttons, e.g., 1Y2N3DDD <Ret>, selected codes and data from the library, i.e. 8 bit BRS address codes and commands, are used to transmit operating commands to three different appliances), **the pushbuttons of the keyboard being activated to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched** (page 44, numeric keys of the keyboard can be pressed, or activated, to directly identify three different home appliances, each of which can be of different manufacturer, matched to the HCS as modules 1, 2, and 3, respectively); **and**

assigning to the macro pushbutton a subset of the selected codes and data from the library (pages 65 – 67, a superkey can be programmed to associate a subset of selected codes, for example, a code for a thermostat that is matched as module 1, a code for a coffee pot matched as module 9, and code for an alarm system matched as module 4, and data from the library) **whereafter activation of the macro pushbutton causes the universal remote control to use the subset of selected codes and data from the library to transmit a plurality of operating**

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commands to one or more of the matched home appliances (activation of superkey causes transmission of associated command sequence to turn down the heat, turn off the coffee pot, and activate the alarm system, in the example shown on pages 65 – 67).

5. With respect to claim 2, **the instructions further perform the step of using activation of one or more pushbuttons of the keyboard to assign the subset of the selected codes and data from the library to the macro pushbutton** (pages 65 – 67 shows a specific example of assigning the subset of selected codes and data from the library to a superkey using the keyboard).

6. With respect to claim 3, **in a universal remote control comprising a keyboard having a plurality of pushbuttons and a library of codes and data for use in transmitting operating commands to a plurality of different home appliances of different manufacturers, a readable medium having instructions for performing steps comprising** (see rejection of claim 1 above):

matching the universal remote control to a plurality of different home appliances of different manufacturers such that selected codes and data from the library are used to transmit operating commands to the matched home appliances in response to activation of selected pushbuttons of the keyboard (see rejection of claim 1 above); **and**

using activation of one or more pushbuttons of the keyboard to match the universal remote control to the plurality of different home appliances of different manufacturers (Each BRS receiver requires a device code and a house code. See page 8. HCS requires the use

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of the key buttons on the keyboard to set the house code to match the plurality of appliances associated with the BRS receivers to the HCS. Remote appliances will not respond to HCS control unless the house code is matched. See page 103, house code. See also pages 36 – 38, the keyboard is also used to match module 1 to front porch light. Alternatively, manual control command “C” can also be used via the keyboard to match an appliance to a particular module recognized by HCS. For example, by manually sending ON/OFF command to module 1, HCS user can match a particular appliance to HCS module 1 and verify that the appliance is matched to module 1.);

instructions further perform the step of using activation of one or more of the pushbuttons of the keyboard to directly identify each of the plurality of different home appliances of different manufacturers to which the universal remote control is to be matched (see page 44, each of the plurality of different home appliances of different manufacturer can be identified directly as modules 1, 2, and 3. Alternatively, each appliance can be identified directly by sending manual commands and observing it respond to commands. See also pages 36 – 38, the keyboard is used to directly identify the front porch light.).

7. With respect to claims 4 and 5, see rejections of claims 1 and 2 above, respectively.
8. With respect to claim 6, see rejection of claim 1 or 3.

Response to Arguments

9. Patent owner's arguments filed on December 3, 2007 have been fully considered but they are not persuasive.

10. The Examiner agrees that certain BRS units act as power supply switches that are remotely controlled. However, the Examiner disagrees with Patent owner's assertion "that Micromint fails to disclose, teach, or suggest each and every element set forth in the claim forth '067 patent" (Remarks dated Nov. 29, 2007, page 5). Patent owner's first argument is that "a BRS unit simply does not transmit operating commands to an appliance that might be plugged into or otherwise electrically connected in series to the BSR unit" and that "the BSR units of the Micromint system are incapable of "directing" an appliance to do anything. In response, the Examiner notes that the claims do not require that a BSR unit transmit operating commands to an appliance or direct an appliance to do anything. The claim 1 recites in relevant part "selected codes and data from the library are used to transmit operating commands to the matched home appliances." The claim does not require that the appliances themselves receive the transmitted operating commands and be directed by the commands. It merely requires that the system be capable of transmitting operating commands to the matched home appliances in response to activation of selected pushbuttons, which is exactly what Micromint system teaches. Micromint system transmits an operating command, for example, an on/off command, to a specific, or matched, appliance to control its operation.

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11. Patent owner further argues that the Micromint central controller only functions to transmit BSR commands “to” a BSR unit having an appropriate address, namely, a BSR unit that has been matched to the house code and unit code accompanying a transmitted BSR command. While Patent owner is correct that the Micromint central controller transmits BSR command “to” a BSR unit having an appropriate address, Patent owner’s characterization that that is its only function ignores the main purpose of the Micromint system, which is to provide remote control of appliances, not the BSR units. Patent owner argues that “much like a letter that is addressed to a business is not sent “to” or “toward” a person that happens to open the letter at the addressed business, the BSR commands sent to an addressed BSR unit are not sent “to” or “toward” an appliance that happens to be plugged into the addressed BSR unit” (Remarks, page 4). Using Patent owner’s letter analogy, the BSR is more like a mailbox with a specific address. Patent owner’s argument is akin to an argument that the postal service only functions to deliver a letter to a mail box and not to a house that happens to be associated with the mail box, and therefore the letter is only sent to the mail box and not to the house. A reasonable person would agree that the US postal service delivers a letter to the house even though the letter is deposited in the mailbox and not the house itself because the main purpose of the postal delivery service is to deliver the mail to the house and the desired effect is achieved by depositing the mail in the mailbox. Likewise, the main purpose of the Micromint system is to remotely control the appliances associated with the BSR unit. Transmitting a command to a BSR is not merely to control the BSR for its own sake and the effect achieved, or remotely controlling the appliance plugged into the BSR unit, is not just an incidental side effect on an appliance that just happens to be plugged into the unit as Patent owner characterizes. Transmitting a command towards a

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specific appliance to achieve the desired effect of remotely controlling the appliance is a reasonable interpretation of "transmitting operating commands to the matched home appliances" in the context of remote control of appliances. As discussed above, the claims do not require that the matched home appliance actually receive the transmitted code, decode the received code and be directed by the code.

12. As to patent owner's argument that a BSR unit will always respond to an appropriately addressed command even when no appliance is plugged into that BSR unit, the Examiner fails to see the relevance of this argument as the claims are silent regarding transmission of commands that are not directed towards an appliance.

13. Patent owner alleges that "the Microcontroller does not include, and need not include, a library of codes and data used for transmitting operating commands to a plurality of different home appliances of different manufactures, i.e., the Micromint central controller includes only a single, fixed set of codes for use in transmitting BSR commands to BSR units." To support this allegation, Patent owner argues that Micromint central controller does not interact to match the controller to appliances of different manufacturers and that the controller does not even have any appliance awareness. The Examiner notes that the claims do not require any interaction to match the controller to appliances to different manufacturers or any appliance awareness on the part of the controller. The claims do not specify who or what must perform the step of matching. Nor do they specify how the matching must be performed.

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14. Contrary to Patent owner's assertion, the Micromint central controller does not always send the same BSR commands. Any useful remote control system requires a library of different codes and commands. In the Micromint system, there is a library of at least four different commands associated with BSR units: on, off, dimmer control, and cyclor control commands. There is also a library of home and device codes associated with BSR units. Moreover, it is not clear how "always sending the same BSR commands" tend to show or not show whether appliances of different manufacturers are matched to the Micromint controller. As to Patent owner's assertion that "*a BSR unit that is matched to the address accompanying a sent BSR command will always respond to the BSR command in the exact same manner, e.g. to activate/deactivate a relay and cause power to be switched on/off, without regard to the type of appliance plugged into the BSR unit or even if an appliance is plugged into the BSR unit*", Patent owner does not make it clear why this is relevant to the actual language of the claims and the Examiner fails to see how this shows that Micromint system does not anticipate the limitations that are actually present in the claims. On the contrary, Patent Owner's assertion tends to prove that appliances of different manufactures can be matched to the Micromint system. As discussed above, Micromint, at page 44, clearly discloses a capability to match up to 16 appliances. These appliances can be of any manufacturer. Micromint system is not limited to a single appliance manufactured by a single manufacturer.

Amendment in Reexamination Proceedings

15. Patent Owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally