

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

Applicant:	Darbee et al.	Universal Remote Control, Inc.
Case No.:	IPR2013-00127	v.
Filing Date:	2/23/2001	Universal Electronics, Inc.
Patent No.:	6,587,067	Trial Paralegal: Andrew Kellog
Title:	Universal Remote Control With Macro Command Capabilities	Attny Doc.: 059489.05US5/IPR

UEI'S MOTION TO EXCLUDE EVIDENCE UNDER 37 C.F.R. § 42.64(c)

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Patent Owner's Exhibit List

2001. Claim Construction Order from Universal Electronics, Inc. v. Universal Remote Control, Inc., C.D.Cal. Civ. No. 8:12-cv-00329
2002. Declaration of Paul Darbee from U.S. Ser. No. 07/586,957
2003. U.S. Patent No. 6,587,067 to Darbee, et al. (with Reexamination Certificate)
2004. Scheduling Order from Universal Electronics, Inc. v. Universal Remote Control, Inc., C.D.Cal. Civ. No. 8:12-cv-00329
2005. Declaration of Richard Ellis
2006. Declaration of Patrick Hayes
2007. Transcript of Deposition of Alan Herr

Universal Electronics, Inc. (“UEI”) respectfully moves the Patent Trial and Appeal Board for an Order pursuant to 37 C.F.R. § 42.64(c) that excludes the deposition testimony of Dr. Alan J. Herr offered in response to leading questions posed by Petitioner’s counsel during his redirect examination. UEI also requests that the PTAB prevent Petitioner from relying on such testimony in support of its Amended Petition for *Inter Partes* Review of U.S. Patent No. 6,587,067 (the “‘067 patent”), including, for example, in its Reply Brief in support of its Amended Petition and in the upcoming Oral Hearing.

After obtaining several admissions from Dr. Herr during his deposition, Petitioner’s counsel attempted to rehabilitate Dr. Herr’s deposition testimony by posing leading questions that elicited responses directly contradictory to those given during UEI’s counsel’s examination. Petitioner’s counsel’s objectionable questioning style improperly suggested to Dr. Herr how he should reply to counsel’s questions, which is exactly why leading questions are generally impermissible when questioning “friendly” witnesses and why the Court should therefore exclude such tainted testimony.

For these reasons, and for those discussed herein, UEI respectfully requests that the Board grant its Motion to Exclude Evidence Under 37 C.F.R. § 42.64(c).

I. FACTUAL BACKGROUND

Petitioner retained Dr. Alan J. Herr, Ph.D, as an expert witness “to provide an analysis of the scope and content of [the ‘067 patent] relative to the state of the art at the time of the earliest application underlying the ‘067 Patent” and “to provide analysis regarding what a person of ordinary skill in the data processing arts related to universal remote control devices would have understood at the time of the earliest application underlying the ‘067 patent.” (Ex. 1010 at ¶ 8.) Dr. Herr stated in his declaration submitted in support of Petitioner’s Amended Petition that:

In comparing the claims of the ‘067 patent to the known prior art, I have carefully considered the ‘067 patent and the prosecution history¹] of the ‘067 patent based upon my experience and knowledge in the relevant field. I have not encountered any terms that require consideration of a special or explicitly defined meaning. Instead, the claim terms of the ‘067 patent are used in their ordinary and customary sense as one skilled in the relevant field would understand them.

(Ex. 1010 at ¶ 22.)

UEI deposed Dr. Herr on September 24, 2013. (Ex. 2007.) Counsel for UEI asked Dr. Herr what the claimed “directly identify” limitation of the ‘067 patent meant to him, in view of his statement in his declaration that the ordinary and customary meanings of all claim terms of the ‘067 patent apply:

¹Contradicting the above-quoted statement from paragraph 22 of his declaration—which was signed under penalty of perjury—Dr. Herr admitted during his deposition that he had not considered the prosecution history of the ‘067 patent in formulating his opinions (Ex. 2007 at 14:22-18:19.)

Q. ... What do the words ‘directly identify’ mean to you?

A. To enter the user I.D. and model number.

(*Id.* at 81:1-81:3.) UEI’s counsel then posed a series of questions to Dr. Herr to determine whether the Wozniak and CORE references disclose the “directly identify” limitation, applying Dr. Herr’s definition:

Q. Okay. So if you’re only using the buttons, Wozniak does not entering a user I.D. and model number of the –

A. No.

Q. -- target appliance.

...

Q. Okay. So, again, just to clarify, so it is your opinion that the Core Reference Manual does not disclose entering the user I.D. and model number --

A. No.

Q. – of the target device via push buttons?

A. That is correct.

(*Id.* at 82:2-83:18.)

Petitioner’s counsel then attempted to rehabilitate Dr. Herr’s deposition testimony repeatedly through leading questions:

Q. Okay. Do you see in that first paragraph there on page 9 where it says, The next step is for you to store the commands from your own remote controllers in Core, assuming that you have one or more remote controllers that are not programmed into Core?

A. Yes.

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