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

PRELIMINARY RESPONSE OF PATENT OWNER PURSUANT TO 37 C.F.R. § 42.107

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

Certificate of Filing: I hereby certify that this correspondence is being electronically filed with the USPTO on this 30th day of April, 2013

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

I. INTRODUCTION 1

II. DATE OF INVENTION..2

III. CLAIM CONSTRUCTION..4

IV. PATENT OWNER'S RESPONSE TO PETITIONER'S INVALIDITY ARGUMENTS..7

A. Rumbolt '511 in View of Magnavox 7

1. The USPTO Already Expressly Considered Rumbolt '511 and Magnavox in Allowing Claims 1-6 7

2. Magnavox Is Not Prior Art to the '067 Patent..8

3. Rumbolt '511 Alone Does Not Render Claims 1-6 Obvious 8

4. The Combination of Rumbolt '511 and Magnavox Does Not Render Claims 1-6 Obvious..9

B. Rumbolt '511 in View of Magnavox in Further View of Evans 12

1. Neither Magnavox nor Evans Is Prior Art to the '067 Patent....................12

2. Rumbolt '511 Alone Does Not Render Claims 1-6 Obvious 12

3. The Combination of Rumbolt '511, Magnavox and Evans Does Not Render Claims 1-6 Obvious 13

C. Wozniak in View of CORE...14

1. The USPTO Already Expressly Considered Wozniak and CORE in Allowing Claims 1-6 14

2. CORE Is Not Prior Art to the '067 Patent 15

3. Wozniak Is Not Prior Art to the '067 Patent...17

4. Wozniak Alone Does Not Render Claims 1-6 Obvious 17

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

5. The Combination of Wozniak and CORE Does Not Render Claims 1-6 Obvious 20

D. Rumbolt '359 in View of CORE 21

1. The USPTO Already Expressly Considered the *Exact Same* Combination of Rumbolt '359 in View of CORE in Allowing Claims 1-6 21

2. CORE Is Not Prior Art to the '067 Patent 23

3. Rumbolt '359 Alone Does Not Render Claims 1-6 Obvious 23

4. The Combination of Rumbolt '359 and CORE Does Not Render Claims 1-6 Obvious 25

V. THE BOARD SHOULD DENY THE AMENDED PETITION IN THE INTEREST OF JUDICIAL ECONOMY 26

VI. CONCLUSION 27

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

I. INTRODUCTION

In its Amended Petition for *Inter Partes* Review of U.S. Patent No. 6,587,067 ("Amended Petition"), Petitioner alleges that U.S. Patent No. 6,587,067 ("'067 patent") is rendered obvious by four different combinations of prior art: 1) U.S. Patent No. 4,774,511 to Rumbolt et al ("Rumbolt '511") in view of PR Newswire (April 9, 1987), Magnavox unveils Total Remote Tuning System and second generation Universal Remote Control ("Magnavox"); 2) Rumbolt '511 in view of Magnavox in further view of U.S. Patent No. 4,825,200 to Evans et al ("Evans"); 3) U.S. Patent No. 4,918,439 to Wozniak et al ("Wozniak") in view of a 1987 "CORE Reference Manual" ("CORE"); and 4) U.S. Patent No. 4,703,359 to Rumbolt et al ("Rumbolt '359"). The Board should decline to institute *inter partes* review proceedings based on each of the above grounds, because each suffers from one or more fatal defects. For example, one of Petitioner's bases is simply an attempt to re-raise the *exact same* combination of references over which the USPTO previously granted Claims 1-6 of the '067 patent. Further, *all four* of Petitioner's bases rely upon one or more references that are not prior art to the '067 patent. Finally, even ignoring these fatal defects, each combination upon which Petitioner attempts to rely fails to teach or suggest at least one limitation of each of Claims 1-6 of the '067 patent.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

II. DATE OF INVENTION

Petitioner alleges invalidity based on a number of references that purportedly qualify as prior art under 35 U.S.C. §§ 102(a) and/or 102(e). As a threshold matter, a reference cannot qualify as prior art under either of those sections if the reference was not published or filed (in the case of a U.S. patent application) prior to the date of invention for the subject matter of Claims 1-6 of the '067 patent, which in this case is February 16, 1987. 35 U.S.C. §§ 102(a) and 102(e).

During prosecution of U.S. Application Serial No. 07/586,957—the great, great grandparent application to the '067 patent—Patent Owner submitted a Declaration Under Rule 37 CFR 1.131 by named inventor Paul Darbee ("Darbee Declaration"). *See generally* Ex. 2002.[1] In that Declaration, Mr. Darbee explains that he first developed a prototype of the "Homer Control Unit," or "HCU,"[2] in the fall/winter of 1986 and that several more prototypes and production models were built between January 1987 and June 1987. Ex. 2002 at 1-2. In support of his Declaration, Mr. Darbee attached, amongst other documents, various revisions of the HCU's user manual, including Revision 1.1 to the HCU Manual

[1] Because the Darbee Declaration is part of the '067 patent's intrinsic record, through a claim of priority, it is not "new testimonial evidence." *See* 37 C.F.R. § 42.106(c). However, to the extent the Board deems otherwise, Patent Owner hereby requests that the Board authorize Patent Owner's submission of the Darbee Declaration, *instanter*.

[2] The inventors sometimes also referred to this device as "Uni-Com." Ex. 2004 at 2.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase®
Smarter legal research.