

**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**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
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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.

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.

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