

AFTERNOON SESSION

(Proceedings resumed at 2:20 p.m.)

THE COURT: I apologize for the delay.

MR. BROWNE: Your Honor, both parties have excused Mr. Tyler. He is not back. I believe you are not disappointed?

THE COURT: He got out of town before I could ask him more questions.

MR. BROWNE: I wanted to give you a quick overview of where the defendant is going.

THE COURT: Okay.

MR. BROWNE: Our next witness is going to be Alex Cook. He is the expert on the matters of infringement for the defendant. We are taking Mr. Cook because he has a regular job and we are trying to get him back in a timely fashion, as fast as possible.

After that, we are going to have Paul Darbee, who developed the UEI remote control.

We are going to have Pat Hayes, who is also in the engineering and technical side at UEI.

After that, Rick Firehammer, who is going to talk about a number of things, such as the hot line, to try to give some perspective to this Court on how the people that

1 phone in the hot line, what they ask for in terms of the
2 remote control. By using his testimony, we hope to put into
3 context how important or not important the step and set
4 feature is.

5 This would all lead up to Mr. Vollmar, who is our
6 expert in terms of damages.

7 Mr. Vigil, as I said, will explain early contacts
8 with Philips and letters from Ms. Rich, in which she proposed
9 a royalty rate on behalf of Philips.

10 That's basically where we are.

11 THE COURT: All right.

12 Today, as I mentioned, I have a conference call
13 at 3:15, but I am placing the call, so we can move it around
14 a little bit, depending on where we are with witnesses.

15 I don't have anything scheduled at 4:30. So, if
16 we want to run to catch up for the time we lost today, we'll
17 see where we are.

18 MR. BROWNE: Mr. McDonough is going to do the
19 examination of Mr. Cook.

20 MR. McDONOUGH: Your Honor, the defendant calls
21 Alex Cook.

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... ALEX M. COOK, JR., having
been duly sworn as a witness, was
examined and testified as follows ...

DIRECT EXAMINATION

BY MR. McDONOUGH:

Q. Mr. Cook, would you state your full name for the record,
please?

A. My name is Alex M. Cook, Jr.

Q. Could you tell the Court where you live, please?

A. 290 Soaring Lane in Lawrenceville, Georgia.

Q. How long have you lived there?

A. I have lived there approximately eight years.

Q. Are you married?

A. Yes, I am.

Q. Do you have any children?

A. Yes. Three sons.

Q. Could you please give me a brief review of your
educational history after high school?

A. Okay.

In 1973 I began attending the Georgia Institute
of Technology, Georgia Tech. I studied electrical
engineering there, graduating in 1977 with a Bachelor's
degree in electrical engineering.

My work in electrical engineering consisted of a

1 broad area of things, but specializing in microprocessors,
2 computer architecture for microprocessors, and software
3 associated with microprocessors.

4 Q. After you graduated from Georgia Tech, could you tell me
5 who your first employer was?

6 A. I went to work at the Georgia Tech. Research Institute,
7 which at the time was known as the Engineering Experiment
8 Station.

9 I had worked in a different branch of ESS while a
10 student at Tech., and took a job there as a research
11 engineer, working on energy management distributor process
12 systems, energy management systems.

13 Q. How long were you employed by the Georgia Tech. Research
14 Institute?

15 A. I was employed there approximately two years.

16 I left there and went to work for a company
17 called Daytech Systems. I was doing a similar type of
18 product, a little more in the commercial marketplace. Again,
19 it was microprocessor hardware and software. For Daytech
20 much more on the software side, and GRTI much more on the
21 hardware side.

22 Q. How long were you at Daytech?

23 A. Approximately two years.

24 I went from there to Lorele (phonetic) Electronic
25 Systems, also in Atlanta. Lorele is a military contractor.

1 And at Loreale I worked on high-speed visual design for
2 display systems. Basically, it was very special-purpose
3 computer architecture for displaying technical information in
4 military aircraft at very high speeds.

5 Q. After you left Loreale, who was your next employer?

6 A. I was at Loreale for approximately three years. I left
7 there in 1983 and joined Scientific Atlanta, where I am
8 currently employed.

9 Q. Could you tell me a little bit about Scientific
10 Atlanta's business?

11 A. Scientific Atlanta is predominantly in the cable
12 television business. We are a supplier of hardware for the
13 cable television industry. The hardware includes everything
14 from antennas to uplink signals, satellite, antennas for
15 receiving the signals, equipment to process and distribute
16 those signals to the home and the subscriber equipment that
17 goes in the home, a full range of products.

18 Q. When you use the word "subscriber," could you tell us
19 what you mean by that?

20 A. In the cable industry, the subscriber is what to the
21 rest of the electronics industry would be known as the
22 consumer. And the use of subscriber today then equates to
23 consumer.

24 The consumer products are the products that
25 actually go in the home that the cable operator services

1 particularly, and that consists of two items which are
2 commonly called the cable box and the jargon a set top
3 converter and remote control.

4 Q. What is your current position at Scientific Atlanta?

5 A. Today I am the Manager of Project Engineering within the
6 Subscriber Engineering organization.

7 Q. What products are you responsible for in that position?

8 A. Well, in that position I am primarily responsible for
9 the transition of new products, especially set top products
10 from engineering into production, and in the movement of some
11 products from one factory to another. That is part of what I
12 do.

13 I am also doing some developmental work. I am
14 responsible for the development of remote controls that we
15 build.

16 Q. Those are infrared remote controls?

17 A. Yes, those are infrared remote controls.

18 Q. Does Scientific Atlanta have any relationship to the
19 parties to this case?

20 A. Yes.

21 We currently purchase remote controls from
22 Universal Electronics. I don't know the exact details of
23 this, but we are also in the area of digital video delivery
24 to the home. It is a new area that is being developed by a
25 number of different companies. I know that Philips is also

1 involved in that area.

2 There are a lot of ongoing efforts at
3 standardization, efforts at patent pools, to share knowledge
4 and to participate in the marketplace. I suspect that
5 Scientific Atlanta and Philips and others are all involved in
6 discussions in those areas. I have no direct knowledge of
7 the discussions, though.

8 Q. Have you ever testified as an expert witness before?

9 A. No, I have not.

10 Q. Are you being compensated for your time today?

11 A. Yes, I am.

12 Q. What is your rate of compensation?

13 A. \$200 per hour.

14 Q. You are here on your own time; correct?

15 A. That's correct. I am not here representing Scientific
16 Atlanta. I'm here alone.

17 Q. Mr. Cook, have you ever read a patent before?

18 A. Yes, many times.

19 Q. Are you named as an inventor on any patents?

20 A. Yes. There are three, and a possible fourth. I am not
21 sure if that fourth one has issued yet or not.

22 Q. Could you briefly describe the technologies covered by
23 those patents?

24 A. Two of the patents deal with the technology of
25 scrambling and unscrambling signals. In the cable industry,

1 protection of signals being transmitted to subscribers' homes
2 is a key thing for the protection of the revenue of the cable
3 operator. And two of the patents are dealing in those areas.

4 One patent has to do with the programming of a
5 cable television converter through the remote control input,
6 its infrared port, to program the operational features of
7 that converter.

8 And then the other one that I am not sure has
9 issued yet or not has to do with some details of our two-way
10 remote control. It receives infrared signals as well as
11 transmits.

12 Q. Do you have any experience with computer languages?

13 A. Yes, from college and on I have programmed
14 microprocessors in assembly language. I've programmed a
15 number of different microprocessors. I have also had some
16 experience in college with FORTRAN and experience with basic
17 and your four other more specialized languages for
18 microprocessors.

19 Q. Which language can you program in?

20 A. Currently basic and assembly languages are the two that
21 I am most proficient in.

22 Q. Could you tell the Court what your understanding of the
23 term "universal remote control" is?

24 A. Universal is a kind of a generic term. It's used to
25 apply to remote controls that have a number of different

1 functions. Often it is applied to a remote control that
2 controls multiple devices, and in some cases it is also
3 applied to remote controls that cover multiple manufacturers'
4 products of one type.

5 Q. Do you have any experience in designing remote controls
6 yourself?

7 A. Yes. Since about 1984/85 time frame at Scientific
8 Atlanta, I have been involved in the remote control side of
9 our efforts, both on the set top side, on the receiver side,
10 and on the remote control transmitter side. We have done a
11 number of dedicated remotes, and also some products that
12 can be considered to be universal remotes in that time
13 period.

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2 Q. In your opinion, what qualifications does a person in
3 your field have to have in order to be considered a person of
4 ordinary skill in that field?

5 A. I think there's three areas that people that are doing
6 remote control design need to be skilled in. Remote controls
7 are primarily built around microprocessors today, so the
8 hardware design of microprocessors is key.

9 Obviously they contain software and, you know,
10 many of the features are built strictly around software. So
11 a working knowledge of the software for microprocessors is
12 key.

13 In many of the cases, we have situations where we
14 have hardware/software trade-offs that are necessary to
15 achieve the functionality we want at the cost we want. So
16 the understanding of the hardware and software is key.

17 The third area is the area of user interface.
18 The remote controls through the years have been the primary
19 means that people have used to operate their appliances,
20 their cable converters, their VCR's, their TV. And how a
21 person interfaces with that remote control device is of key
22 importance, which buttons you press to do what functions, how
23 you program it, what it can control.

24 So that's also of key importance to someone who
25 is skilled in the art.

1 Q. In your opinion, would somebody have to have experience
2 in all three of those areas to be a person of ordinary skill
3 in the art?

4 A. I think to fully understand remote controls and be
5 someone, as we say, skilled in the art of remote controls,
6 yes, they need to be experienced in all three areas.

7 Q. Would you consider yourself to be a person at least of
8 ordinary skill in the art of remote controls?

9 A. Yes, I would.

10 Q. I'm going to refer to Universal Electronics, as we've
11 been doing throughout the case, as UEI.

12 How long have you been personally involved with
13 UEI?

14 A. I think my first personal contact with UEI occurred
15 probably in the latter part of 1991, 1991/1992-type time
16 frame, I think.

17 Q. How did you come to testify on behalf of UEI here
18 today?

19 A. Well, obviously, as I said, we have an ongoing business
20 relationship with UEI. And I've known a number of people at
21 UEI. They've known of my skills. And I was first contacted
22 some number of weeks ago by John Burnan (phonetic), who is
23 their current Vice President of Engineering. I was traveling
24 overseas and had a voice mail while I was in China, John
25 asking me to please get in touch with him.

1 When I was able to finally contact him, he
2 explained that he was involved in a patent case and wanted to
3 know if I was interested in being an expert witness. I told
4 him I would have to review the patent in question and other
5 materials before I would decide.

6 He had planned to get those materials to me while
7 I was in China. Unfortunately, the person that was to
8 deliver them, we didn't make connections. So upon arriving
9 back in the U.S., I did get a package of materials from your
10 office to review.

11 So that's the process. I did review those
12 materials, make up my mind about a position and agree to
13 become a witness.

14 Q. Are you aware of UEI's reputation in the industry?

15 A. Yes.

16 Q. Could you tell me what UEI's reputation is in this
17 industry?

18 A. From my perspective in this industry, they are the
19 pre-eminent player in the universal remote control business.
20 They are really the number one position in terms of
21 technology, in terms of library codes, and I guess in
22 experience in designing many, many remote controls.

23 Q. When you say in "technology," what are you specifically
24 referring to there?

25 A. That covers a couple of areas, I guess.

1 One I mentioned earlier was user interface.
2 They've obviously spent a lot of time looking at the
3 interface, studying how a subscriber or consumer would use a
4 device. They know very well the microprocessor technology.
5 They know very well the concepts of software/hardware
6 trade-offs.

7 They have a very, very advanced capability for
8 the capture of infrared codes from other remotes, and
9 technology for compression of those codes into the smallest
10 possible space, allowing the largest number of codes to be
11 put into the microprocessor.

12 I think also in looking at the developments they
13 just mentioned earlier today, I think, the telephone download
14 capability, the computer download capability, those things,
15 things that I equate to the technology that they're in the
16 forefront of.

17 Q. Are you familiar with the various types of remote
18 controls that are sold by UEI?

19 A. Most of them, I think, yes.

20 Q. And how did you gain that familiarity?

21 A. A number of different ways.

22 One is in my current job. Obviously I try to
23 keep abreast of the field. I've also had some personal
24 experience with UEI in which I've had exposure to their
25 remotes. Through the products that we have developed with

1 them, through some advertisements I've seen from them. And
2 also as a consumer I'm familiar with their remotes.

3 Q. Are you familiar with the way that UEI remotes
4 operate?

5 A. Yes.

6 Q. Do you know what is meant by the term "setting up" when
7 referring to a universal remote control?

8 A. Yes.

9 The setup of a universal remote is the
10 programming of that remote so that it will talk or transmit
11 in the appropriate format for their target devices that you
12 want to control.

13 Q. When a UEI control is first sold, first taken home by a
14 consumer, does it operate any TV or any VCR or any other
15 appliance?

16 A. Yes, I believe so.

17 Universal puts in a default code for each of the
18 target devices, and so it will operate -- for instance, I
19 know in some of the devices, at least, the Sony television
20 set is a default television set. So if you happen to own the
21 appropriate model of Sony TV, you would not have to do a
22 setup operation; it would operate that directly.

23 Q. Okay.

24 Assuming that the consumer does not happen to
25 own that specific model of Sony or whatever else it's set

1 up to, how in general is a universal remote control by UEI
2 set up?

3 A. There are two methods.

4 The primary method is direct set or direct
5 entry. The direct method, the consumer will note the brand
6 of appliance that he wants to control, turn to a table or
7 chart in the back of his user's guide, locate that brand of
8 appliance. For that brand will typically be listed a number
9 of possible codes to use, and the consumer will then try
10 those codes one by one, directly entering those codes into
11 the unit in an attempt to operate the device. When he
12 finally finds the code that operates the device correctly, he
13 stops the process.

14 A second method which is at issue here is the
15 step and set method. Step and set is a method by which the
16 library of codes can be stepped through, manually searched,
17 in an attempt to locate a format that will control the target
18 device.

19 Q. And is Scientific Atlanta at the present time selling
20 universal remote controls?

21 A. We have four remote controls that have a capability
22 that could be considered to be universal. All of our
23 products are sold directly to cable television operators;
24 they're not sold to the consumer public. The cable operator
25 would provide those products to a subscriber. So we don't

1 sell in the retail marketplace.

2 Of the four, two of those are special remotes for
3 a trial system we're doing for a particular customer in
4 Florida, and they're done in very low volume. The two other
5 remotes, one has a very limited capability of controlling the
6 television set in addition to controlling the cable
7 converter. And the last one is a very complete full-up
8 universal product.

9 Q. Do all of those remotes you identified have a direct
10 entry or direct set feature?

11 A. Yes, they do.

12 Q. Turning back to UEI's remote controls, do all of UEI's
13 remote controls have a direct entry or direct set feature?

14 A. To the best of my knowledge, they do.

15 Q. Are you familiar with remote controls, universal remote
16 controls sold by other companies on the market?

17 A. I have seen a number of them in the marketplace, and I
18 have looked at some of them in my role at scientific Atlanta,
19 yes.

20 Q. Do other companies' remote controls presently on the
21 market presently use the direct entry method?

22 A. I'm not aware of any that don't have direct entry. I
23 think they all do.

24 Q. Are you familiar with the remote controls -- universal
25 remote controls presently sold by the plaintiff Philips?

1 A. To some extent, yes.

2 Q. Do these use a direct entry method?

3 A. The ones that I've seen, yes, they do.

4 Q. You mentioned before the term step and set. And I take
5 it you're familiar with how the step and set feature
6 operates?

7 A. Yes.

8 Q. In your opinion, in your experience at scientific
9 Atlanta, is the step and set feature something that UEI has
10 to have in its remote controls in order to sell them?

11 A. In my opinion, no, they would not have to have the step
12 and set feature to be able to sell the product.

13 Q. Could you explain the basis for that opinion?

14 A. Well, step and set is really a fallback-type position,
15 a last resort, means of last resort for locating a code. And
16 I'm of the opinion it's very rarely used. I based that on my
17 experience primarily with the scientific Atlanta products,
18 the unit that has the limited television capability. I had
19 even forgotten that that had a step and save feature in it.
20 It has never come up in any issues in the field on that
21 product at all.

22 Again, it's for a very limited function.

23 On the Philips unit, the step and set feature has
24 been actually more of a detriment to the product than a help,
25 because we had some issues early on about bringing out the

1 manual for that product. We didn't always have a full list
2 of codes in the cable installers' hands in the first few
3 weeks that this was in the field, and we were forced to use a
4 step and set feature more often.

5 And I had severe problems in the field with
6 complaints about codes not being included, televisions that
7 wouldn't work when, in fact, the codes were in the unit. So
8 we found that the step and set feature actually was a
9 detriment to the product.

10 So I have no doubt that they could sell a product
11 without that feature. I suspect that the number of calls
12 they receive -- and it's my own suspicion based on my
13 experience recently -- but I expect a number of the calls
14 they receive is after someone has attempted use a step and
15 set feature.

16 Q. So based on your experience, what is the primary way
17 Scientific Atlanta's users set up their remote?

18 A. Direct entry.

19 Q. If you could please turn in your exhibit book to the
20 first exhibit which is marked as D-1 -- which I believe, your
21 Honor, is also marked as a plaintiff's exhibit, 217. It's a
22 copy of the '359 patent.

23 A. Okay.

24 Q. Have you seen this patent before?

25 A. Yes.

1 I think my first exposure to this patent came a
2 number of years ago. I believe that it probably crossed my
3 desk, as many patents in this field do. I don't recall
4 having paid any particular attention to it at that time. I
5 most recently reviewed it in relationship to this case.

6 Q. What did you do when you first received this patent in
7 relationship to this case?

8 A. Well, this patent was really the first thing that I
9 looked at. And I study the patent from front to back trying
10 to understand the structure, understand what the material of
11 the area was being covered and what the claims were and what
12 the claims meant.

13 Q. And when you finished your initial review of this
14 patent, can you tell me what your initial reaction was?

15 A. Well, I reviewed the patent, as I said, as the first
16 document, and in doing so I had looked for things that I
17 thought were limiting things that might be of interest as I
18 reviewed the other materials, then reviewed the Complaint. I
19 had been given a copy of the Complaint that Philips had
20 filed.

21 And, after reviewing the Complaint and then
22 re-reviewing the patent, I was strongly of the opinion that
23 universal does not infringe any of the '359 patent with its
24 products.

25 Q. If you could turn to the claim which begins on Column 7

1 at the bottom...

2 A. Okay.

3 Q. And have you come to a conclusion as to whether the use
4 of UEI step and set method infringes Claim 1 of this patent?

5 A. In my opinion, step and set does not infringe Claim 1.

6 Q. And what is the basis for this opinion?

7 A. The basis of my opinion is, of course, a study of this
8 patent and a careful reading of Claim 1. My knowledge of the
9 step and set method and further supported by some other
10 materials I've seen in the case.

11 Q. Okay.

12 Are there specific terms in Claim 1, specific
13 requirements in the method that are not present in the
14 practice of UEI's step and set method?

15 A. There are two areas specific to this claim, two
16 elements of this claim that are required that are not
17 included in the step and set type products, the first being
18 the requirement to set up a selected appliance to execute a
19 predetermined action upon the receipt of a response-evoking
20 signal, and the second the requirement to transmit a
21 plurality of response codes in sequence in response to the
22 user trying to program the unit.

23 Q. And I take it from your answer that you believe UEI's
24 product, the use of UEI's method does not include those
25 elements?

1 A. That's correct.

2 THE COURT: Could you repeat that again?

3 THE WITNESS: Okay. Two elements that Claim 1
4 requires, the first of interest is the setting of a said
5 selected appliance -- it's actually the second element on the
6 list:

7 The "setting of said selected
8 appliance to execute a predetermined
9 action upon receipt of a
10 response-evoking signal having said
11 required signal structure."

12 UEI's products do not require the device to be
13 set up to execute a predetermined action.

14 The second one is the following, your Honor:

15 "Transmitting in sequence a
16 plurality of response command
17 signals each commanding said
18 predetermined action in a
19 different signal structure until
20 said selected appliance executes
21 said predetermined action, whereby
22 the last transmitted one of said
23 response command signals constitutes
24 said response-evoking signal having
25 said required signal structure."

1 Universal's units do not transmit the plurality
2 of response commands in sequence. They will transmit only a
3 single one for each event, the event being the user
4 initiating the process.

5 THE COURT: All right.

6 BY MR. McDONOUGH:

7 Q. Okay. Well, we'll come back to that, as you might
8 suspect.

9 Could you please turn to Claim 6, which starts at
10 the bottom of Column 8?

11 A. Okay.

12 Q. And I take it you've read Claim 6 of this patent?

13 A. Yes, I have.

14 Q. Have you come to a conclusion as to whether UEI's
15 step and set feature in its remote controls infringes
16 Claim 6?

17 A. Yes.

18 My conclusion is that UEI's products do not
19 infringe upon Claim 6.

20 Q. And could you tell the court the basis for that
21 opinion, please?

22 A. The basis is essentially the same. Claim 6 also
23 requires the remote to have a means for transmitting this
24 plurality response commands in sequence and the means would
25 be the software in the remote to do so. There is none that

1 will do that.

2 Also in the preamble of that claim, as I recall,
3 there's again a requirement that selected device is set to
4 execute a predetermined action, which is not a requirement
5 upon the step and set method.

6 Q. Okay. Let's turn first to the predetermined action
7 element.

8 Is it your understanding that the term
9 predetermined action, as it's USED in Claim 1 and Claim 6,
10 have essentially the same meaning?

11 A. Yes, that's correct.

12 Q. What does that mean to you as a person of ordinary
13 skill in the remote control field?

14 A. To me, what the term predetermined action means is the
15 remote has been preprogrammed, programmed ahead of time,
16 with a command that's used to elicit a response from the
17 target device.

18 Q. And what is the basis for that opinion?

19 A. The basis is the study of this patent, a number of
20 points in this patent, and also the reading of the file
21 history of the prosecution of this patent, and some other
22 areas where I've seen the term predetermined used, for
23 instance, as used in the Telefunken patent that's been
24 discussed here already.

25 Would you care for me to discuss the specifics of

1 this?

2 Q. Well, let me ask -- let's turn to the patent first.
3 And maybe you could indicate to us where in the patent you
4 find support for your definition of the term predetermined
5 action?

6 A. Okay.

7 My understanding of predetermined from the
8 English language is just that it's been determined ahead of
9 time, prior to the operation of setting up the remote control
10 occurring. The question might be when was that determined.
11 And in Column 5, beginning at Line 51, we're in the midst of
12 a discussion of the software of the microprocessor and a
13 discussion of that operation.

14 And reading that paragraph, or at least a portion
15 of it, I guess perhaps all of it:

16 "Next, the key data section
17 of RAM 44 is automatically set to
18 the predetermined response command.
19 This command is a command which
20 will cause some readily observable
21 action to occur at the appliance
22 to be controlled. For TV, VCR
23 and cable converter, the channel
24 up command is used. For disc,
25 the command is used as play, while

1 for an audio unit a station advance
2 command would be used."

3 A couple of things there. One is it does talk
4 about this being automatically set up. And the second thing
5 is I attached some significance to the word "the" in front of
6 "predetermined response command." To me that implies
7 something specific.

8 There is a general tone through the whole patent,
9 if you will, that this is intended to be a process that's
10 automatic, and a requirement of it being an automatic or a
11 process that requires very little user intervention is that
12 that code be picked ahead of time.

13 There are other instances in the patent where the
14 term "predetermined" is used. I know several were discussed
15 yesterday in Claim 4, Claim 3. Both of those claims are
16 talking about predetermined items that are included in the
17 software of the microprocessor.

18 Figure 5 is supportive of the first text that I
19 read. In Figure 5, the second action box, the first
20 decision box and then the two action boxes, the second states
21 set key data to proper response command. So that's
22 indicating that in the microprocessor software, they are
23 preloading that command into RAM, as described in the
24 specification.

25 There are also other places where predetermined

1 is used. Again in the file history of this product, the
2 predetermined is used several times and it's used attached to
3 the idea of a specific command being used.

4 And then in the German, the Telefunken reference,
5 the word predetermined is used to describe the codes that
6 have been put into memory as being a predetermined set of
7 codes. And so that, again, would have to mean something that
8 was accomplished when the unit was programmed.

9 Q. Okay.

10 Could you turn in the patent to the bottom of
11 Column 1, the last paragraph, starting at, I believe, Line
12 66?

13 A. Okay. Yes.

14 Q. And could you read that paragraph, please?

15 A. Sure, certainly.

16 "In accordance with the present
17 invention, the user sets the
18 appliance to be controlled by the
19 remote control unit to execute some
20 observable action when receiving a
21 specific command signal, herein
22 referred to as a response-evoking
23 signal, having the required signal
24 structure. For example, if the
25 appliance is a television set, the

1 observable action may be a channel
2 change, for instance, the
3 response-evoking signal would be a
4 'channel up' signal."

5 That's another example of what I had said
6 earlier. That if you read this patent from start to finish,
7 what you begin to understand is that the concept here is an
8 automatic concept that is intended for minimum user
9 interface.

10 In fact, there's another section I'd like to read
11 in a second. The way they accomplish that is by choosing
12 ahead of time something that the user does not have to
13 participate in. If I may read the paragraph before that...

14 "The remote control unit is
15 to be simple to operate, light,
16 reliable, and relatively inexpensive.
17 Particularly, it is to be able to
18 'identify' a command signal structure,
19 including bit pattern and format,
20 required to control a specific
21 appliance with minimal effort on the
22 user's part and within a short time.
23 The identified signal structure is
24 to be retained until the user
25 reinitiates the "identify" mode, so

1 that no model number and/or
2 manufacturer selection by the user
3 is required for normal operation of
4 the unit."

5 To me, the key words in that are "minimal effort
6 on the user's part and within a short time." This patent is
7 describing an automatic process for accomplishing that.

8 Q. Could you please turn to Column 4 in the patent?

9 A. Okay.

10 Q. And looking at Line 63 -- it's the last paragraph --
11 would you read that, please?

12 A. Certainly. Reading beginning at Line 63:

13 "However, it should be noted
14 that the user must turn on the
15 device to be controlled and set
16 it (if necessary) so that it is
17 ready to carry out a specified
18 observable action (e.g. channel
19 change) upon receipt of a
20 correctly structured response
21 command (e.g. 'channel up') before
22 the "identifying" process can
23 begin."

24 So, here again, they're describing the way that
25 this process operates, the fact that the device has to be set

1 up first to watch for this specific action to occur before
2 the process can begin.

3 Q. Would you turn to Column 6, please, starting at Line
4 11, and would you read that paragraph, please?

5 A. Okay.

6 "The product code information
7 from EPROM 16 is combined with the
8 key data in RAM 44 to access the
9 predetermined response command in
10 the command tables in EPROM 32.
11 The command data is passed to the
12 formatter."

13 Q. Could you tell me what that paragraph means to you?

14 A. To me, again, it means that response command has been
15 chosen ahead of time. You could just as well have read that
16 paragraph without the word "predetermined" if you had not
17 chosen the command ahead of time.

18 The word predetermined has a specific meaning
19 for inclusion in this paragraph. And in my opinion it's
20 because they chose the command prior to the manufacture of
21 the device.

22 THE COURT: In that answer, you mean that they
23 chose the response command in designing the device?

24 THE WITNESS: Yes. When the device was designed,
25 that choice was made.

1 BY MR. McDONOUGH:

2 Q. And with regard to Claim 1, the use of the term
3 predetermined action, could you just repeat again, based on
4 what the reference is in the patent that you relied on and
5 the patent itself, the specification and the drawings?

6 A. Okay.

7 Again there, reading:

8 "Setting said selected appliance
9 to execute a predetermined action
10 upon receipt of a response-evoking
11 signal having said required signal
12 structure."

13 The reason for including the word predetermined
14 in that phrase is because they are defining a process where
15 that particular command has been chosen ahead of time.

16 Q. And with regard to Claim 6 of the patent and in the
17 preamble, they used the term predetermined action.

18 Can you tell us your understanding of what that
19 term requires in Claim 6?

20 A. I suppose I'll read the preamble for that again:

21 "Apparatus for adapting a
22 control unit to generate appliance
23 command signals having a required
24 signal structure for controlling a
25 selected one of a plurality of

1 appliances each responsive to
2 different signal structure, said
3 selected appliance being set to
4 execute a predetermined action
5 upon receipt of a response-evoking
6 signal having said signal structure
7 comprising the following..."

8 And again, the word for including the word
9 predetermined in the preamble is to identify the fact that
10 this has been chosen ahead of time. It doesn't say being set
11 to execute an action; it says a predetermined action.

12 I might add that there's some further definition
13 of this in the file history. I don't know if you plan to get
14 to that later.

15 Q. Yes. I'll ask you questions about that in a minute.

16 A. Okay.

17 Q. But looking at the patent itself, is there anything in
18 the patent that teaches to you as an engineer or suggests
19 that the term predetermined action in Claims 1 and 6 is
20 anything broader than what you've just described?

21 A. Absolutely not.

22 Q. Is there any language in the patent itself or any
23 teachings or suggestions that suggest to you that if you had
24 a remote control manufactured according to the claims, that
25 the user would be able to change the predetermined action at

1 any time?

2 A. I see nothing here that teaches that or implies that.

3 In fact, the whole tone of the patent is exactly
4 the opposite of having the user intervene.

5 Q. You've referenced before Figure 5 of the patent. If
6 you could turn to that, please...

7 A. Okay.

8 Q. Would you just identify what Figure 5 is, please?

9 A. Figure 5 is a flow chart of the actions that the
10 microprocessor executes when the search method defined in
11 this patent is executed. So after you've entered the search
12 method, it begins operating according to Figure 5.

13 Q. Does Figure 5 teach to you or suggest that a user of a
14 remote control made -- that incorporates this flow chart or
15 made according to this invention, that the user could
16 manually step through the library codes to do a setup?

17 A. No, it does not.

18 Q. Is there any suggestion or teaching that would show an
19 engineer how to make a remote -- let me start that question
20 again.

21 Is there any suggestion or teaching in the '359
22 patent itself, anywhere in the drawings or specifications of
23 the claims, that would teach an engineer how to make a remote
24 so that the user could change the predetermined action?

25 A. I don't find anything in this patent that teaches or

1 suggests that. And that concept to me seems counter to what
2 the patent is trying to teach.

3 Q. What, in your mind, is what the patent is trying to
4 teach?

5 A. The patent is trying to teach a process for setup of
6 the remote control that involves minimal user intervention.
7 Again, I read that earlier, but it states so in the
8 specification of the patent.

9 If you contrast that for a moment to something
10 like direct entry or step and set, those things require user
11 interaction in other ways, user in direct entry or direct set
12 has to look up a code in the code book and enter that code
13 and actually has to try a number of codes from a list in that
14 code book. In step and set, the user is required to
15 continually interact with the product, generally a very large
16 number of times.

17 I think that this patent is covering a method, an
18 apparatus to avoid those issues of having high user
19 interaction during this search process.

20 Q. You had mentioned previously the file history of the
21 patent.

22 If you could please turn to Exhibit DTX-197,
23 please, in your book?

24 A. Okay.

25 Q. Again, your Honor, I believe this is the same as

1 Plaintiff's Exhibit 93, which was admitted yesterday.

2 THE COURT: I would like to go back and ask a
3 question.

4 Go back to Column 6, Line 12.

5 THE WITNESS: Column 6, Line 12.

6 THE COURT: Well, 11, 12.

7 "The product code information
8 from EPROM is combined with the key
9 data in RAM to access the predetermined
10 response command..."

11 THE WITNESS: Yes.

12 THE COURT: You read that as leading you to
13 believe that the key data in RAM was placed there by the
14 manufacturer during the manufacturing process?

15 THE WITNESS: No. Key data in RAM was placed
16 there earlier in this program, but that was taken from the
17 program that's stored in ROM. The RAM was a temporary memory
18 that's used during the operation of the microprocessor
19 software, and it is programmed by what's in the ROM.

20 THE COURT: And what tells you that it's
21 programmed by the ROM?

22 THE WITNESS: This was Column 5, beginning Line
23 51, it states that:

24 "The key data section of RAM
25 is automatically set to the

1 predetermined response command.
2 This command is a command which
3 will cause some readily observable
4 action to occur at the appliance
5 to be controlled."

6 And I read that to say it was predetermined,
7 preprogrammed into the software of the remote control.

8 THE COURT: And the ROM sets up the RAM?

9 THE WITNESS: Yes. The RAM is used as temporary
10 storage for many different operations. While you're in the
11 operation, it's used specifically for this.

12 THE COURT: Okay. Thanks. Sorry, I didn't mean
13 to interrupt. Go ahead.

14 BY MR. McDONOUGH:

15 Q. Okay. I believe we were talking about Exhibit D-197, a
16 file history of the patent.

17 Have you reviewed this file history, Mr. Cook?

18 A. Yes, I have.

19 Q. And did you rely on this file history or any statements
20 in the file history in coming to your conclusion about
21 infringement?

22 A. I was certainly influenced by a number of things in
23 this, yes.

24 Q. Could you point out to the court the specific pages or
25 statements which form the basis of your opinion?

1 A. Certainly.

2 Give me one second to locate --

3 Q. Let me direct your attention, starting on P003715.

4 A. Okay.

5 A significant set of words in this document
6 starts on Page P003719. It's actually labeled Page 5 at that
7 point in the document. And reading beginning at the last
8 paragraph:

9 "Before discussing the particular
10 grounds of rejection in the office
11 action, applicants would like to note
12 the following definitions apply,
13 appliance command signals or any
14 command signals transmitted from
15 the remote control unit to any
16 appliance. Response command signals
17 or appliance command signals of
18 different signal structures, all of
19 which signify the same command to
20 the appliance, e.g., channel changes.
21 Finally, a response-evoking signal is
22 that response command signal which is
23 used or which caused the appliance to
24 carry out the predetermined action."

25 Q. Could you tell me why that language was important to

1 you?

2 A. This language, especially when taken somewhat in
3 reverse order, helps me to understand that this action was
4 chosen ahead of time. It defines better some of the terms
5 used in Claim 1 and Claim 6, response-evoking signals and
6 response command signals.

7 Q. Okay.

8 Could you please turn to Page 10 in this
9 amendment? The number at the bottom is P003724?

10 A. Yes.

11 Q. Would you please tell us if there's any additional
12 language in this document on which you relied in coming to
13 your opinion with regard to Claims 1 and 6?

14 A. Yes.

15 There is a discussion over on the bottom of this
16 page and over the next couple pages that talks about the
17 German patent. And in it there is some contrast that the
18 writer draws between the operation of a device built
19 according to '359 and one built according to the German
20 DE3313493. And there's I guess a number of paragraphs
21 of this.

22 Q. If you could just read out loud the specific language
23 on which you relied in coming to your conclusions...

24 A. Okay.

25 A significant paragraph starts as the first full

1 paragraph on Page 11, which is P003725.

2 "New Claim 18 is the first method
3 claim now on record. It distinguishes
4 from German patent DE3313493 in a
5 number of important respects. The
6 selected appliance is said to be
7 one of a plurality of appliances
8 of different categories as well
9 as different manufacturers. The
10 selected appliance is set to execute
11 a predetermined action upon receipt
12 of the response-evoking signal."

13 They're describing '359 at that point.

14 In the '493 patent, the selected appliance does
15 not have to be set to execute a predetermined action. Any
16 one of the controllable actions will suffice. To me, that's
17 very clear again what the definition of predetermined action
18 is; that the device has to be set up for a specifically-
19 defined predetermined action.

20 And the writer of this is saying that in the
21 German case, that that's not true and any of the controllable
22 actions will suffice. So I read that in the '359 patent,
23 any controllable action would not suffice; it has to be
24 specifically predetermined.

25 Let's see, continuing down, the German device,

1 since it is only for different manufacturers and not for
2 different categories, allows the trial and error signals,
3 response command signals, to be available for every possible
4 command. No matter which command is selected by the user,
5 the German device will generate this command in all
6 manufacturers covered by their remote control unit.

7 Stopping at that point, recognizing this is being
8 told as a contrast, that implies to me if the German device
9 will generate in the setup method coming in for any possible
10 key, then the '359 device will not. Continuing to read, it
11 is already an inventive step to consider it is not essential
12 that this capability be available. So to remove that
13 capability is part of what they're claiming as the
14 invention.

15 The difficulty in setting the device to be
16 receptive to the particular command is minimum. There again
17 is the whole patent, trying to produce a method apparatus
18 that has absolute minimum effort involved. In many cases
19 turning on the power is sufficient. That's a very direct and
20 succinct description of differences and very well defined, I
21 think, within the meaning of '359.

22 Q. Okay.

23 You read a sentence that reads it is already an
24 inventive step to consider that it is not essential that this
25 capability be available and you referenced the words "this

1 capability."

2 Could you tell us what exactly you understand was
3 meant by that?

4 A. The capability there is talking about -- is what was
5 referred to in the lines right above as being the capability
6 to transmit any of the possible command codes that the remote
7 control device could generate

8 Q. And is it your understanding, then, the '359 patent,
9 that that capability is eliminated so that only one code is
10 sent?

11 A. That's correct.

12 Q. Is there any other language in this amendment that
13 we're referring to that would form the basis of your opinion
14 with regard to the definition of the term "predetermined
15 action"?

16 A. One moment.

17 (Pause.)

18 THE WITNESS: I think that that's everything here
19 that has to do with predetermined action.

20 MR. McDONOUGH: Your Honor, I see we're past
21 3:15. Would you like to take a break at this time or shall
22 we continue?

23 THE COURT: Actually, I moved it to 3:30, so
24 that's fine. We'll proceed a little bit.

25 MR. McDONOUGH: Okay. Thank you.

1 BY MR. McDONOUGH:

2 Q. Now, going back to Claim 1 and Claim 6 of the patent,
3 with regard to the term predetermined action used in those
4 claims, my question is: Do you recognize universal remote
5 controls have a predetermined action?

6 A. They do not.

7 Q. And why do you say that?

8 A. They are not programmed. When they were designed to
9 have only one code that they could transmit to execute this
10 portion of this operation. They allow the user to press
11 other possible keys, there are other keys that will transmit
12 just as defined in the German reference.

13 Q. I'd like to turn to the other portions of the claim
14 that you identified, the transmitting and sequence language.

15 Let's look at Claim 1 first. I believe it's the
16 third element of the method.

17 A. Yes.

18 Q. The language transmitting a sequence of plurality and
19 response command signals and so forth, could you explain what
20 that language means to you?

21 A. Sure.

22 My first reading of that, as an engineer and
23 someone designing remote controls, the word "plurality" pops
24 right out. It would be very easy to read a paragraph that
25 said transmitting in sequence, response command signals, each

1 commanding set predetermined action, but the writer chose to
2 include the word plurality, which I take to have some meaning
3 there.

4 The description of this is the method that
5 describes the operation that occurs when a user initiates
6 this process.

7 So to me, just in my first reading of this, that
8 describes an action that when this process is initiated
9 transmits in sequence a plurality, a series, a large number
10 of response command signals.

11 So just by an analysis, an English analysis, if
12 you will, of the words there, the first thing it means to me
13 is that it does, upon initiation of one event, transmit a
14 number -- code and number formats, so a number of actions for
15 the remote for one action on the part of the user. The flow
16 chart on Figure 5 supports that.

17 Figure 5 very clearly shows a flow chart that
18 describes a process for transmitting without user
19 intervention, a multiple number of times. In Figure 5, a key
20 is pressed and held down until an action is seen, and many
21 transmissions occur from the remote as a result of that
22 action of the user pressing down that key.

23 I think perhaps there was some other description
24 in the specification but I'm not sure I can pinpoint it right
25 this second.

1 Q. Well, in terms of transmitting codes, would you explain
2 how UEI's step and set method works?

3 A. Okay.

4 Step and set, once you enter this process,
5 requires an action on the part of the user for each new code
6 to be transmitted. So in most cases, that's the pressing of
7 two buttons. For instance, power and C in one case, or C and
8 power. In some cases, it's the pressing of only one button.
9 But it's an action required on the part of the user for each
10 time the code is to be sent. So it requires a significant
11 amount of user interaction to be able to complete the process
12 of locating the code.

13 Q. And if you look at Claim 1 again, the transmitting in
14 sequence, could you explain the difference between UEI's
15 method that you just described and what's required by
16 Claim 1?

17 A. Claim 1 requires in Element 3, the transmitting of a
18 number of codes for this one user event, the one user
19 action. UEI's remote only transmits a single time for each
20 action by the user.

21 Q. If you could turn to Claim 6 of the patent, read us the
22 first element in the claim after the preamble.

23 A. Okay.

24 "Comprising means for transmitting,
25 in sequence a plurality of response

1 command signals each having a signal
2 structure different from the others of
3 said response command signals, until
4 said appliance executes said observable
5 action in response to said
6 response-evoking signal."

7 Q. Now, this may sound a little redundant, but could you
8 explain what that language means to you in terms of an
9 apparatus as set forth in Claim 6?

10 A. Well, this is the same concept. They're saying there
11 needs to be a means apparatus for transmitting these. And in
12 the UEI case, in the step and set method, there is no means;
13 there would be software in the microprocessor hardware, I
14 suppose, to accomplish that process. There is no software in
15 the UEI product to do that, so there is no means.

16 Q. If you could turn, please, to Exhibit PTX-9A in your
17 book...

18 A. Okay.

19 Q. Actually, if you could also look right before that at
20 PTX-9...

21 A. Okay.

22 Q. Okay.

23 If you could first identify PTX-9 for us...

24 A. PTX-9 is a copy of the Telefunken patent DE3313493 in
25 Germany.

1 Q. And could you identify PTX-9-A for us, please?

2 A. PTX-9-A is an English translation of that patent,
3 missing some of the diagrams at the back.

4 Q. Have you read Exhibit A?

5 A. I've read the English version, yes, 9-A.

6 Q. Could you please describe generally what is shown in
7 Exhibit A, keeping in mind I'm asking you what is shown in
8 Exhibit A and in the German drawings, to the extent you
9 understand both of those together?

10 A. Okay.

11 This patent is describing an operation of a
12 slightly different type of universal remote. It's one that
13 controls multiple manufacturers' products, but within a
14 single product category.

15 So, for instance, a number of different
16 television sets from different manufacturers, but not
17 necessarily -- or not VCR's and other things, so a particular
18 product category.

19 I think that this patent in general is covering
20 the concept of a universal replacement remote. For instance,
21 if I lost my remote for my television, then a retailer could
22 have just one remote on the shelf for televisions. You have
23 another version on the shelf for VCR's.

24 There's also some language in the text with this
25 patent that describes that perhaps they would have a better

1 method of user interface, for instance, might include more
2 visible keys or keys placed in other positions. So what
3 they're describing is a universal replacement remote for a
4 given type of product.

5 THE COURT: How about we take our break now.
6 I'll be back, try to be back around quarter to 4:00.

7 Why don't you talk at the break and see how late
8 you want to go today. A little late is fine with me.

9 (Short recess taken.)

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(Court resumed after the recess at 3:50 p.m.)

THE COURT: Okay.

BY MR. McDONOUGH:

Q. Mr. Cook, we were talking about Exhibit No. 9-A, Exhibit 9. If you could please explain to us your understanding of how the remote control described in Exhibit No. 9-A and Exhibit No. 9 is set up...

A. Okay.

This patent discusses a couple of different methods of entering a setup process and a couple of methods of proceeding through that process. This is an automatic process. And one method described whereby the search for the code is done with a very minimal user interaction. There is no direct set listed here.

The user would begin this process by either pressing a key and holding that key or pressing a combination of keys to indicate the beginning of the operation.

The patent that is in Claims 4 and 5 describe two different methods for proceeding through that, one of which I will call an automatic process and one a manual process.

And in Claim 4, as I recall -- let me check that to make sure I have the right claims.

Q. I believe you are referring to Claim 4 on Page 2 of Exhibit 9-A?

1 A. Yes.

2 Q. That is the first Page 2?

3 A. Yes.

4 Claim 4 teaches to transmit various possible
5 control code words once this mode has been entered.

6 Claim 5 teaches that, upon operation, each case
7 transmits another of the possible control code words or once
8 per user action. So the Germans felt strong enough about the
9 differences in these to describe an automatic process in one
10 claim and a manual process in a separate claim. In either
11 case, the user is pressing one of the function keys, one of
12 the command keys of the remote to transmit the code for that
13 remote. And once the user has seen a user-observable action,
14 he will release that key and the remote control will then
15 determine if there are any other devices in the library that
16 will also have that same code, that same function.

17 I think there has been some testimony about the
18 fact that not all infrared codes are unique, but that there
19 are overlaps in the library, the universe of codes. Some
20 devices have codes, similar codes, because they are
21 manufactured by the same manufacturer that market it under
22 different name brands, such as the OEM-type products. In
23 other cases a manufacturer will market different models of a
24 particular device. They may have some codes in common.

25 So a problem that occurs is that, once you

1 identify the code for a particular key, you may not have
2 identified the code for all the keys in the device. And this
3 patent addresses that significantly in its teachings, in that
4 it allows the user to first use a particular function and
5 then refine the selection of the overall codes needed by
6 following with a second or third or whatever.

7 So, for instance, if I'm using this with a VCR,
8 and let's say I use the play key, I can press play and hold
9 play and it will transmit a number of play codes until I see
10 one operating correctly. Then I release the play key and if
11 the memory of the unit contains library codes that have
12 several models of that VCR, all of which have the same play
13 code, the unit will recognize the fact that there is more
14 than one model with that code.

15 Then if I press, for instance, the stop key, the
16 unit will then just look at the codes that have the correct
17 play key to transmit stop codes.

18 Let's say that we find three that have the
19 correct play, two of those have the correct stop, then I
20 might use another, for instance, pause and maybe one has
21 that. At that point in time there is only one device in the
22 library of codes that uniquely matches the user's sequence of
23 observable actions, and the complete incorrect code has been
24 identified.

25 So, this patent teaches search methods and

1 teaches a refinement method for dealing with redundant codes.

2 Q. Would a device according to the Telefunken patent be
3 able to operate without this internal checking of the codes?

4 A. Yes.

5 There are portions of the patent that define the
6 fact that you can go through and you could just stop after
7 the first code has been identified. I think it is carried in
8 separate claims about the refinement process. So you could
9 have a device that meets some of the claims. It doesn't have
10 the refinement function.

11 Q. In your view, what are the similarities between the
12 device according to the Telefunken patent and a remote
13 control device according to the '359 patent?

14 A. Both teach an automatic method of locating a code that
15 doesn't require significant user interaction. In both cases,
16 a key can be pressed that will cause multiple codes to be
17 transmitted for that particular event, particular user
18 interaction with the device.

19 I believe also that both teach that once the code
20 is located, that code is used to set up the device to locate
21 the information for other keys on the device also. The
22 number of teachings in the Telefunken patent are the same as
23 the '359, with the exception that Telefunken doesn't identify
24 categories.

25 It talks in the very front of the device -- in

1 the very front of the patent about different types of
2 devices. So they were apparently recognizing that with these
3 different devices, TV's, VCR types existed, but they did not
4 teach a method of dealing with those different device types.
5 Those were probably for their particular market, which was
6 for a single type replacement remote.

7 Secondly, at the point in time when the
8 Telefunken device was being designed, microprocessor
9 technology was such that there wasn't a significant amount of
10 memory available within a microprocessor. So you had a very
11 limited library of codes that you could put into a unit.

12 Also compression techniques were not widely being
13 researched or perhaps were being researched but were not
14 widely known. So there was a limitation in the number of
15 codes that you could put into a unit.

16 So I think the limitation there at the time for a
17 marketable product was such that they could put a few codes
18 in there. The idea was to make a remote of a single type.
19 You could put enough codes to make a commercially-viable
20 replacement remote.

21 So, anyway, one of the differences, though,
22 between the two is that this doesn't talk about categories,
23 which '359 does, but otherwise it's fairly similar.

24 Q. Well, without the memory limitation, if you added more
25 memory to the Telefunken device, would it be obvious to have

1 the capability to cover multiple categories of devices to the
2 Telefunken device?

3 A. Given that Telefunken does discuss different devices and
4 addresses those without defining the idea of categories in
5 terms of implementation, they are obviously very aware of the
6 different target devices. I think it would probably be on a
7 very gradual progression in the product development to first
8 produce products that controlled one device type and then, as
9 microprocessor memory increased and costs went down on
10 microprocessors, to combine those products into one remote.

11 Yes, I think it is obvious.

12 Q. You had talked about automatic processes with regard to
13 the Telefunken patent.

14 Could you just describe what you mean by
15 automatic process as it relates to the Telefunken patent?

16 A. To me, an automatic process is one that I can start,
17 but then something happens without me having to make it
18 happen.

19 And then the Telefunken patent -- again, in Claim
20 4 I think it is -- they describe that it is going to transmit
21 various possible code words until I, the user, indicate that
22 we have hit a code that's the correct code. So the process
23 there, I initiate the operation. The operation runs forward
24 without me doing anything else until I terminate it. That's
25 automatic.

1 Q. And you also discussed with regard to Telefunken a
2 manual process.

3 Could you just elaborate on what you mean by the
4 manual process disclosed in Telefunken?

5 A. In Claim 5. And I will read a little bit to clarify:

6 "The remote controller as claimed
7 in Claim 3, wherein during the setup
8 phase and on repeated operation of
9 the same control element" -- that
10 means a key --"on the remote
11 controller, the code determination
12 circuit" -- that's the microprocessor --
13 "in each case transmits another of
14 the possible control words for the
15 apparatus to be controlled and
16 concludes from the end of the
17 operation repetition that the desired
18 function has been initiated by the
19 control word transmitted last. The
20 end of the operation can be..."

21 And it defines earlier in the patent that it can
22 be the pressing of another key, for instance, to show that
23 you have ended the operation.

24 This is a description of a case where someone is
25 pressing a button repeatedly, and each time they do that is

1 transmitting a single code.

2 Q. I would like to draw your attention, please, to PTX-1049.

3 Have you seen this document before?

4 A. Yes.

5 Q. If I could draw your attention to the two columns about
6 the middle of the page...

7 Looking at the left-hand column with regard to
8 function, it's under the column heading '359 Patent. Do you
9 see that?

10 A. Yes, I see that.

11 Q. It reads:

12 "Send codes from successive
13 signal structures until the
14 appliance responds."

15 A. Yes.

16 Q. My question is: Does the Telefunken device have that
17 function?

18 A. Absolutely.

19 Q. Below that we look at the row labeled "Way."

20 It reads:

21 "Move sequentially through a
22 memory containing appliance signal
23 structures to select and transmit
24 codes (hold down one button)."

25 Does the Telefunken patent have that way?

1 A. Yes, it does.

2 Q. And then "Result" reads:

3 "An observable response from
4 the appliance indicates the correct
5 signal structure."

6 My question is: Does the Telefunken patent
7 disclose that result?

8 A. Yes, it does.

9 Q. Let's go back again to the patent in suit here, the
10 '359 patent, in front of your exhibit book, Exhibit D-1. I
11 would like to focus again on the claims, Claims 1 and 6,
12 obviously.

13 And let's first go through this one at a time.

14 First, with regard to Claim 1, the method claim,
15 the language we first talked about:

16 "Setting said selected appliance
17 to execute a predetermined action..."

18 My question is: Understanding how UEI's remote
19 controllers operate with regard to the step and set, is the
20 step and set method equivalent to the language of Claim 1 of
21 the '359 patent?

22 A. No, I don't believe so. Because step and set does not
23 require the appliance to be set to execute a predetermined
24 action.

25 Q. And with regard to the transmitting in sequence in which

1 the codes are transmitted in UEI's device, is that equivalent
2 to that which is disclosed or claimed in Claim 1 of the
3 patent?

4 A. UEI could be set to transmit in sequence by continued
5 user interaction, but UEI does not transmit a plurality of
6 codes.

7 So I do not consider them to be equivalent.

8 Q. And with regard to Claim 6, in the apparatus claim where
9 it mentions:

10 "...said selected appliance being
11 set to execute a predetermined action..."

12 Understanding how the UEI remote controllers
13 operate, do you as a person of ordinary skill in the art
14 consider that to be equivalent to the language of Claim 6 of
15 the '359 patent?

16 A. Again, same argument: I don't, because the UEI doesn't
17 require you to set appliance to execute a predetermined
18 action.

19 Q. And with regard to the means for:

20 "transmitting in sequence a
21 plurality of response command
22 signals..."

23 The same question: Does the apparatus -- does
24 the UEI remote control apparatus operate in an equivalent
25 manner to that which is claimed in Claim 6 of the '359

1 patent?

2 A. Again, there is no means for transmitting that
3 plurality.

4 MR. McDONOUGH: May I have about 30 seconds, your
5 Honor?

6 THE COURT: All right.

7 (Pause.)

8 MR. McDONOUGH: I have no further questions at
9 this time.

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THE COURT: All right. Cross-examination.

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MR. JENNER: It will take us a few minutes to get things set up, your Honor.

5

CROSS-EXAMINATION

6

BY MR. JENNER:

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Q. Mr. Cook, during your deposition in this action, you referred to something that you characterized as a preprogrammed remote.

9

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Do you remember that?

11

A. That's correct.

12

Q. Do you recall using that word?

13

A. Yes, I do.

14

Q. What does preprogrammed remote mean to you?

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A. The development of remote controls has gone through a number of iterations. And initially remote controls were primarily dedicated, and oftentimes built and still today dedicated, most built around small IC's, sometimes containing a small microprocessor core, sometimes not.

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The next stage in the development of remote controls was really alerting remotes, remotes that would capture the infrared transmission from another remote and be able to repeat it.

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And then the third stage of development of remotes was the programming into the microprocessor's memory

1 information allowed for the remote control to repeat that
2 without having had to learn to identify the specific device.

3 So preprogrammed remote is a remote that is
4 programmed at the time of manufacture with the information to
5 allow it to repeat other codes.

6 Q. So dedicated is not a preprogrammed remote?

7 A. A dedicated --

8 Q. If it's one device?

9 A. In the term that I'm using, no. You can use a
10 preprogrammed architecture to make a dedicated remote.

11 Q. You could have a preprogrammed remote which, after it
12 selects a device, will then be dedicated. Is that what
13 you're saying?

14 A. No.

15 I'm saying you could create, using microprocessor
16 architecture, a preprogrammed remote that only had one entry
17 unit's library.

18 Q. I see. It would only have one code set worth of
19 information in it. Is that what you mean?

20 A. That's right. It would be a dedicated function.

21 Q. If you had the micro and memory running in an RCA model
22 27 TV, that would be preprogrammed, but a dedicated remote?

23 A. It could be used in that terminology, yes.

24 Q. When you speak of preprogrammed remotes -- or I should
25 say when you spoke of preprogrammed remotes at your

1 deposition, did you have in mind as one example of a
2 preprogrammed remote the UEI remotes?

3 A. Yes.

4 Q. Did you have as one example of preprogrammed remotes
5 the Philips remotes that are described in the patent?

6 A. Yes.

7 Q. I take it, though, the learning remote or the G.E. type
8 of learning remote that we saw during the week is not a
9 preprogrammed remote; is that correct?

10 A. That is correct.

11 Q. And you also said that you first saw a preprogrammed
12 remote in about 1986 or 1987.

13 A. That was my recollection. I don't have any specific
14 information exactly when or which model. That's my
15 recollection.

16 Q. But it was like a UEI remote or a Philips remote in
17 some sense in that it had a number of manufacturer or device
18 code sets in memory?

19 A. Yes.

20 One of the earliest ones I think that I saw I
21 believe may have been a remote that used a dip switch type
22 setup method, as opposed to another setup method. It had
23 more than one device programmed into it.

24 Q. And you think you first saw it in about 1986 or '87?

25 A. That's the best of my recollection at this point, yes,

1 sir.

2 Q. Not earlier than that, to the best you recall?

3 A. Yes, not earlier.

4 Q. Is it correct that, as of the time of your deposition,
5 you had not studied the entire UEI product line?

6 A. That's correct.

7 Q. And you were not familiar with all of the UEI
8 remotes?

9 A. Universal makes hundreds and hundreds of remotes.
10 Today I'm still not familiar with every single one of them.

11 Q. You testified that Scientific Atlanta is a customer of
12 UEI.

13 A. Correct.

14 Q. And it deals with UEI on four products that you
15 mentioned?

16 A. Correct.

17 Q. And in fact, Scientific Atlanta has bought hundreds and
18 thousands of remotes from UEI that fall in those four product
19 categories in total; correct?

20 A. The quantity is probably in the neighborhood of 100,000
21 at this point.

22 As you recall, some of the information you're
23 reading was from confidential material, and since I'm not
24 testifying on behalf of Scientific Atlanta today, I would be
25 very uncomfortable in presenting information on terms of

1 volumes of costs and that type of thing.

2 Q. I would not need to go farther than this. Perhaps we
3 can avoid a problem if you are able to agree with me that
4 essentially Scientific Atlanta has bought a very large volume
5 of product from UEI.

6 Can we agree on that and skip the numbers?

7 A. Well, that depends on your definition of "large
8 volume."

9 That's not necessarily a large volume of product
10 that we purchase. It's perhaps a large volume to some
11 people, but it's actually a small volume in the total number
12 of remotes that we would purchase in a year.

13 MR. JENNER: Well, your Honor, here is my
14 problem. I don't want to belabor this. I do want to
15 establish the amount of business that the witness' company
16 does with UEI.

17 It may be that we can do that by reference to
18 some numbers that are in a piece of deposition transcript.
19 It's not a jury case. If we can let your Honor know what
20 that is without it having to go into the record, if counsel
21 agrees.

22 MR. McDONOUGH: That would be my suggestion, if
23 we could have some confidential transcript or something to
24 protect Scientific Atlanta's information being open to the
25 public.

1 MR. JENNER: I wasn't suggesting a sealed
2 record.

3 THE COURT: I don't mind a sealed record. Why
4 don't we have the Court Reporter go under seal and have it
5 separately under seal until we lift it back off. That's fine
6 with me.

7 THE WITNESS: May I ask a question?

8 I'm not sure who all is in the gallery --

9 MR. McDONOUGH: I was just going to point that
10 out. We may want people to step out during this line of
11 questions.

12 (At this point the courtroom was cleared and the
13 transcript continues under separate cover, under seal,
14 beginning on Page 196.)

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1 (REPORTER'S NOTE: This is the continuation of
2 the unsealed transcript.)
3

4 A. I said I don't think that's the case, I don't have any
5 direct information on that.

6 I do know that Philips is doing visual video work
7 for some of the customers we are, in the same marketplace. I
8 know there's a lot of discussion going on between
9 manufacturers, and I'm inferring from that that there's
10 discussion going on between Scientific Atlanta and Philips in
11 the context of the industry.

12 Q. But what you really know about is a relationship that
13 Scientific Atlanta has with some of its customers and a
14 relationship that Philips has with some of its customers.

15 Isn't that what you know about?

16 A. Well, that defines it a little more narrowly than I
17 think I feel like I know. I read the industry trade
18 magazines and I know who is in this industry, and all of the
19 information isn't coming from the customers.

20 And I do see, because I'm in the engineering
21 environment, the movement toward standardization which are
22 manufacturer-related, which doesn't involve the customers
23 always. So I think my knowledge goes beyond what you're
24 trying to limit it to.

25 Q. There is not a business relationship between Scientific

1 Atlanta Philips?

2 A. No.

3 (REPORTER'S NOTE: At this point the transcript
4 continues under separate cover, under seal, for one page.)

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2 BY MR. JENNER:

3 Q. We won't bring that up again.

4 A. I'm not aware of a vendor-customer relationship between
5 Philips and Scientific Atlanta at this point.6 I do know Philips visited a number of times
7 offering manufacturing services. I do know that in seeking
8 to build universal-type remotes, I have contacted people
9 through our Legal Department in the past at Philips. So we
10 have attempted to have some relationships with each other,
11 but I'm not aware of any ongoing relationship right now on a
12 vendor/customer basis.13 Q. All I ask you to do, sir, is agree with me that you do
14 not have a customer-vendor relationship with Philips as you
15 do with UEI.

16 A. To my knowledge, we do not.

17 Q. You were retained in April?

18 A. Actually, I think it was around the 1st of May.

19 Q. The 1st of May is fine.

20 And you saw much of what you rely on in this case
21 for the first time since then; correct?

22 A. In terms of documentation, yes.

23 Q. Well, Telefunken, for example?

24 A. Telefunken, I have seen -- it's possible I have seen
25 the Telefunken patent again, but not to a degree to study it

1 enough to testify in this case.

2 What I testified here on Telefunken primarily
3 is for my study during this period of time to be an expert
4 witness.

5 Q. Would you turn to Page 55 of your transcript, please?

6 A. Yes.

7 Q. Line 8 question:

8 "When did you first see the
9 Telefunken patent?"

10 "Answer: The answer is the same
11 as earlier, I was provided a copy in
12 preparation for this. I think that
13 we have had some Telefunken patents
14 come through during the years. I
15 recall seeing some things. I don't
16 recall specifically if I have
17 reviewed this patent before, but I
18 know that we have had some Telefunken
19 patents that come through my office."

20 Were you asked that question, did you
21 give that answer?

22 A. Yes.

23 Q. Now, you said you arrived at Scientific Atlanta in
24 about 1983?

25 A. Correct.

1 Q. And I take it that when you arrived there in 1983 or
2 1984, you had some familiarity with a dedicated type of
3 remote control?

4 A. When I arrived at Scientific Atlanta my only experience
5 with remote controls was through use of remote controls as a
6 consumer.

7 Q. What did you have a TV, VCR?

8 A. Yes.

9 Q. And you got it out of the box and you could control
10 that TV or VCR?

11 A. Yes.

12 Q. When do you think you first saw a dedicated remote
13 control as a user?

14 A. I have no recollection. They were ultrasonic back when
15 I was in high school, I suppose.

16 Q. How about infrared? Before 1980?

17 A. I would think so. I don't recall exactly, though. I
18 think it was probably a little bit before '80.

19 Q. What about a dedicated remote control for a VCR?

20 A. I'm sorry, I really do not recall the time frame.

21 Q. Do you think it was before you arrived at Scientific
22 Atlanta?

23 A. I think probably so, but I don't recall when I
24 purchased my first VCR.

25 Q. Well, using when you arrived at Scientific Atlanta as

1 a frame of reference, did you see a dedicated remote control
2 for any other kind of product about then or before that
3 time?

4 A. Well, obviously when I arrived at Scientific Atlanta,
5 we had dedicated remote controls for television products,
6 cable converters and dedicated remote controls for
7 televisions, and they were all infrared at that time.

8 So I think the answer to your question is yes, I
9 had seen infrared remote controls at that point in time.

10 Q. All right.

11 When did you first see or when were you first
12 familiar with -- let me ask you that first. When were you
13 first familiar with a kind of dedicated remote control that
14 controlled both the television and another product, like a
15 VCR, by the same manufacturer?

16 A. I don't recall when I first saw the first commercial
17 version of that.

18 I will say that, in approximately 1984, my work
19 at Scientific Atlanta had me involved in the development of
20 the cable television and converters, including the portions
21 related to remote control. We were discussing at that point
22 in time within Scientific Atlanta the concept of having a
23 remote control that would control the television set and a
24 cable box.

25 However, the technology really wasn't

1 cost-effective for us to be able to do that, nor were we sure
2 exactly how to handle this wide variety of TV sets. So it
3 was a discussion item within our Engineering Group.

4 I do recall at some point early on seeing an RCA
5 remote that had approximately 50 buttons on it that would
6 control a number of different products, I think VCR and TV.
7 As far as exactly when the process -- I don't know the time
8 frame. I don't remember a time line exactly. I've not
9 prepared one, nor do I have a means of doing so, other than
10 just general recollection.

11 Q. Do you think you saw such an RCA remote control with
12 lots of buttons on it for controlling two or more devices
13 before you first saw a preprogrammed-type remote in '86 or
14 '87?

15 A. That's -- my recollection is that, yes, I would have.

16 Q. Seen it before you first saw preprogrammed?

17 A. Yes. That's my best recollection.

18 Q. All right.

19 I take it you would agree that having two or more
20 dedicated types of remotes on a tabletop is difficult to deal
21 with?

22 A. Yes, I would.

23 Q. It's a problem?

24 A. I agree both from the standpoint of a consumer and it
25 also as a person developing products that are used in a

1 consumer's home. We use products that are developed as
2 part of the consumer electronics the person uses, and
3 oftentimes the biggest difficulty occurred when a cable
4 converter was placed in the home, because now you had three
5 devices.

6 Q. Right. You could have two or three devices on the
7 tabletop, maybe even more, and you knew that that was a
8 difficulty and a problem in 1984 based on the devices you
9 were then familiar with; correct?

10 A. Yes.

11 Q. Were you aware of the learning remote in about
12 1984/1985?

13 A. Somewhere in that time frame, we were aware of the
14 learning concept of remotes, yes.

15 Q. The head-to-head kind of remote, you were aware of
16 that?

17 A. Yes.

18 Q. In about 1984/1985?

19 A. I don't recall the time frame, but it was in the time
20 frame of '83, '84, '85, when we were doing a lot of other
21 things. My primary focus at that point in time was not
22 remote controls. It was a peripheral product.

23 Nobody really had responsibility for remote
24 controls, except the people I was working with, a small group
25 of engineers, so we were constantly getting information and

1 trying to develop things to do as better concepts. But I
2 don't have a specific order of things as we did this.

3 Q. Now, you testified you considered yourself to be at
4 least a person of ordinary skill in the art.

5 A. That's correct.

6 Q. And why do you think that?

7 A. Well, in my experience, I've either designed or
8 participated in the design of a number of dedicated remote
9 controls for Scientific Atlanta, a learning remote for
10 Scientific Atlanta. And now also universal remotes for
11 Scientific Atlanta.

12 That experience has covered an area from the
13 front end of concept, marketing issues, subscriber interface,
14 through the hardware/software trade-offs, and on through the
15 manufacturing. So the full gamut of issues concerning
16 product development on remote controls.

17 Q. And you were doing that kind of design work from about
18 when you got to Scientific Atlanta, '83, '84?

19 A. I was doing that type of design work. I didn't start
20 working really with remote controls until '84. The first
21 nine months to a year at scientific Atlanta, I primarily
22 focused on the set top converter, cable converter side of
23 design.

24 And we did have some experience with remote codes
25 that were transmitting the existing remotes at that time, but

1 it was really in the '84 time frame that we started looking
2 at the remote transmitter itself.

3 Q. So you were doing work at Scientific Atlanta in this
4 area of remote controls by 1984?

5 A. Correct.

6 Q. You knew that the clutter of dedicated remotes on a
7 tabletop was a problem in 1984, and you knew that learning
8 remotes were around in 1984, and you knew about manufacturer
9 remotes, dedicated remotes in 1984 for more than one device.

10 And you were a person of ordinary skill in the
11 art. Why didn't you think this invention up yourself in
12 1984/85 if that was obvious?

13 A. You're going to have to ask that question again.

14 Q. You have said you were a person of ordinary skill in
15 the art. You work in the area of remotes. You knew about
16 the remote clutter on table tops. You knew about dedicated
17 remotes for devices. You knew about dedicated remotes that
18 control more than one device of a manufacturer. You knew
19 about learning remotes.

20 Why wasn't this invention obvious to you and,
21 therefore, why didn't you make it in 1984/85?

22 A. Which invention are you referring to?

23 Q. The invention in the patent in suit. You said it was
24 obvious in your direct testimony to a person of skill in the
25 ordinary patent.

1 A. I said from the German patent. At that time I didn't
2 have the German patent. I was not focusing on remote control
3 design. It was a peripheral concept to us at that point. We
4 were developing peripherals sold with the set tops. It was
5 not a design of our creative efforts. Had it been, we might
6 have beat you to this.

7 Q. So if you had been a person or a party that had that
8 concern, you think it might have been obvious to you? Is
9 that what you're saying?

10 A. I think it's possible that with the other information
11 that we're talking about and the focus on that, yes, it's
12 possible it may have been obvious.

13 If not obvious, it may have certainly been an
14 inventive step that we took.

15 Q. And you say that the key really for you is the
16 Telefunken reference that makes it all happen?

17 A. I can't say that the key to me taking it would have
18 been the Telefunken reference. I said in the testimony today
19 it was obvious other than the Telefunken reference we have
20 here.

21 Q. So that's where you place your reliance in distinction
22 from what I've said so far from the Telefunken reference?

23 A. I was asked was it obvious from the Telefunken
24 reference. And knowing from the information we have here
25 today, it would be.

1 MR. JENNER: Your Honor, I'm happy to go on, but
2 the question came up during the last break if we would get
3 done today, if everybody was willing to do that.

4 It's clear that's not going to happen. I don't
5 know how long your Honor would like to go. I have a
6 conference call I need to make back at my hotel.

7 THE COURT: If we're not going to finish today,
8 if it doesn't a difference to anybody, would you prefer to
9 stop now?

10 MR. McDONOUGH: Only if it would shorten his time
11 tomorrow. He indicated he needed to catch his flight to
12 Atlanta.

13 THE WITNESS: I have business in Atlanta.

14 MR. BROWNE: I can go five or ten more minutes,
15 but it's not going to be materially shortened.

16 THE COURT: I don't have anything scheduled
17 tomorrow, we'll go and make sure you get a flight.

18 THE WITNESS: Thank you, sir.

19 BY MR. JENNER:

20 Q. In considering obviousness as you testified about it
21 over the Telefunken reference, were you told about something
22 called secondary considerations of nonobviousness? Did that
23 come up?

24 A. No.

25 Q. Were you told that something called initial skepticism

1 sometimes can be an indication that an invention was not
2 obvious? Did that come to your attention?

3 A. No.

4 Q. Okay.

5 I would like you to assume for the purpose of my
6 next couple of questions that initial skepticism can be
7 what's called a secondary consideration of nonobviousness.
8 All right?

9 A. You will have to explain it further, but I'll agree.

10 Q. It is sometimes used -- I don't want to get into cases,
11 but it is sometimes used in cases as an indication that, if
12 people were initially skeptical about an idea, then perhaps
13 that idea was not obvious.

14 Can you assume that for me?

15 A. Okay. Sure.

16 Q. Isn't it true that you were initially skeptical that
17 preprogrammed remotes would work?

18 A. That's correct.

19 Q. Wasn't there a lot of resistance to the idea that a
20 universal remote control would be practical?

21 A. There was resistance to the idea, yes.

22 Q. Okay.

23 And there was such skepticism and resistance in
24 the context of people believing that having many dedicated
25 remote controls was a problem; correct?

1 A. Please ask that again.

2 Q. There was such initial skepticism and such resistance
3 at the time, meaning 1984, '85, '86, that people also were
4 aware that having many dedicated remote controls was a
5 problem, same time frame?

6 A. Yeah, I think so, yes.

7 Q. All right. I'd like to pursue this issue of
8 obviousness a little bit.

9 Could I have plaintiff's 266, please.

10 MR. JENNER: Your Honor, this is the Harger
11 patent that was put in evidence earlier.

12 MR. McDONOUGH: I guess, your Honor, if I could
13 just object here, we did not go into the Harger reference on
14 direct examination, so I believe the cross-examination goes
15 beyond the scope.

16 MR. JENNER: They opened up obviousness on
17 direct, your Honor, this goes to the issue of obviousness.

18 THE COURT: They can explore obviousness.

19 BY MR. JENNER:

20 Q. Do you have the patent, sir, 266?

21 A. I do.

22 Q. Would you please turn to Column 1 of the patent?

23 A. Yes.

24 Q. If you would look with me in Column 1, starting at
25 around Line 13, it's into the second paragraph, toward the

1 end of the line, it says, quote:

2 "As the popularity of television
3 accessories such as videocassette
4 recorders and video disc players has
5 grown, manufacturers have also started
6 to provide individual remote control
7 systems for the television accessories.
8 As a result, a user may have three or
9 more individual remote control
10 transmitters. The use of individual
11 remote control transmitters is
12 cumbersome."

13 And then the last sentence of that paragraph
14 says:

15 "Accordingly, a single unified
16 remote control transmitter, which is
17 capable of controlling more than one
18 television device, is highly desirable
19 for users which own a number of
20 television devices with remote
21 control provisions."

22 Do you see that?

23 A. Yes, I do.

24 Q. Now, that's a statement by this patent of the problem
25 of having lots of remote controls, and it also states the

1 desirability of having a unified remote control?

2 A. Okay.

3 Q. Correct?

4 And the people who dealt with this patent
5 obviously knew about microprocessors in memory; correct?

6 A. Correct.

7 Judging from the first figure, now, I've not
8 reviewed this patent probably in eight or nine years --

9 Q. Let me make it easy, then.

10 If you'd go to Column 1, lower down the paragraph
11 it starts at Line 47, refers to:

12 "In accordance with the present
13 invention, a microcontroller, i.e.,
14 a microprocessor or microcomputer,
15 or like device, preferably
16 incorporated in a single integrated
17 circuit which operates under the
18 control of a program stored in memory,"
19 and so on.

20 A. Okay.

21 Q. So these guys were well familiar with
22 microprocessors and the paraphernalia you could use with
23 them; correct?

24 A. Yes, it would seem so.

25 Q. And from your familiarity with this device -- with

1 this patent, rather, a little or a lot, I don't know, are you
2 aware that this patent issued to RCA? And, if you're not,
3 can you find that on the cover page?

4 A. Yes. I know it issued to RCA.

5 Q. And RCA came up with a remote control which would only
6 control RCA devices; right?

7 A. This was my understanding. This was a large, many-
8 button remote, I think.

9 Q. So that RCA did not come up with the idea of a
10 preprogrammed type of remote at this time?

11 A. I'm sorry, I don't follow that.

12 Q. RCA did not come out with a preprogrammed remote as you
13 have defined that prior to, say, 1986?

14 A. Does this control multiple devices?

15 Q. Controlling multiple categories of devices and
16 multiple --

17 A. No. Does this control multiple devices? My definition
18 of preprogrammed has nothing to do with categories. Multiple
19 devices.

20 Q. Multiple devices I take it this controls?

21 A. Well, multiple devices.

22 Q. But only one manufacturer?

23 A. One manufacturer.

24 Q. That's what they came up with. That was their
25 solution?

1 A. I don't understand the distinction.

2 Q. Let me try it a different way.

3 Faced with the problem of tabletop remote control
4 clutter and knowing about microprocessors, RCA's solution was
5 a remote control that would control only its own devices.

6 Is that a better way to put it?

7 A. Well, that's technically correct. They came up with a
8 remote control that controlled their devices, yes.

9 Q. Okay. That's fine.

10 Could we have Exhibit 258?

11 258 is also in evidence from earlier today.

12 This is a patent, Exhibit 258, to a person named Welles,
13 W-e-l-l-e-s.

14 A. I'm familiar with it.

15 Q. You are familiar with it?

16 A. Yes.

17 Q. And this issued to G.E., General Electric Company?

18 A. That's correct.

19 Q. And that's another big television company back in the
20 eighties?

21 A. Yes.

22 Q. As RCA was?

23 A. Yes.

24 Q. Would you turn to Column 1 of this patent, Exhibit No.
25 258?

1 A. Yes.

2 Q. And the solution is the learning remote or a type of
3 learning remote, a head-to-head device of the kind we've
4 called learning remote; correct?

5 A. Correct

6 Q. These people at G.E., confronted with the same problem,
7 they also knew about microprocessors and memory, did they
8 not?

9 And if it helps you, I will call your attention
10 to the bottom of Column 4, so you can see that.

11 A. Yes, yes.

12 Q. And we have already heard that one of the problems with
13 learning remotes is that if you don't have the original
14 dedicated remote or something happens to it, the learning
15 remote doesn't do you any good for the related appliance;
16 correct?

17 A. Correct.

18 Q. So G.E. is another company that knew about the
19 problem of tabletop clutter, but it don't come up with the
20 solution of remotes like those in the patent in suit;
21 correct?

22 A. Well, we're going to have to go back and define what
23 we mean by remotes. And I'm not sure exactly what you
24 mean.

25 Q. Did G.E. come up with a remote control with the

1 manufacturer codes stored in the memory of the remote
2 control to control categories of devices by different
3 manufacturers?

4 A. G.E.'s remote was not preprogrammed with --

5 Q. Right. It was the learning remote?

6 A. Learning remote, that's correct.

7 MR. JENNER: Could I have Defendant's Exhibit
8 170, please?

9 I'm informed that the reason this does not have a
10 tag on it as Defendant's 170 is because the Defendant's 170
11 copy that we have is a little faint, and we've simply made a
12 more legible copy to that.

13 BY MR. JENNER:

14 Q. Are you familiar with this patent, the Kozakai patent
15 that's Defendant's Exhibit 170?

16 A. I have seen this patent at some point in time in my
17 life, but I'm not intimately familiar with it, no.

18 Q. This is issued to Sony it says on the face?

19 A. That's right.

20 Q. And obviously Sony was another big television company
21 back in the 1980's, mid-1980's?

22 A. Yes.

23 Q. Would you turn over to Columns 1 and 2 in the text?

24 A. Okay.

25 Q. If you look at the bottom paragraph of Column 1 and

1 read to the end of the second paragraph in Column 2, right
2 where it starts to say, Objects and Summary of the Invention,
3 there's two paragraphs?

4 A. Do you want me to read that aloud?

5 Q. Just read it to yourself. And I will ask you to
6 confirm again that the patent is stating a problem related
7 to having two or perhaps more individually hand-held remote
8 controls?

9 A. Okay.

10 MR. McDONOUGH: Excuse me. Could you give me the
11 column and line numbers again?

12 BY MR. JENNER:

13 Q. I'm referring generally to Column 1, Line 58, going
14 over to Column 2, Line 27, particularly to the end of the
15 second paragraph, it might help.

16 THE COURT: Your conference call is at 5:00?

17 MR. JENNER: I'll quit after this one.

18 (Pause.)

19 THE WITNESS: Okay.

20 BY MR. JENNER:

21 Q. So that states a problem recognized by the Sony
22 inventors of multiple dedicated remote controls to the point
23 where, as it says, the average consumer simply chooses not to
24 use both individual remote controls; right?

25 A. That's what it states.

1 Q. Are you aware of whether Sony in the 1984, '85, '86
2 time frame developed a remote control for controlling more
3 than one category of device and with the codes for the
4 different devices in the memory of the remote control?

5 A. No.

6 Q. You're not aware of any such thing?

7 A. I'm not aware of it.

8 Q. Are you able to confirm without study that the patent
9 described here states for its solution another remote
10 control which just controls Sony devices, can you tell
11 that?

12 A. Not from what I've read so far. But I'll accept that,
13 you know, unless you have other questions.

14 Q. Well, if you tell me that you haven't read it, I won't
15 pursue it?

16 A. I haven't read it.

17 Q. You're not familiar with this patent?

18 A. I've seen it many years ago, but I'm not familiar
19 enough with it to tell you what it is.

20 Q. Is it true that, apart from your study of the
21 Telefunken reference, upon which you based your obviousness
22 opinion earlier, that you have not studied and relied on
23 other references for that obviousness opinion?

24 A. I have not, in preparation for this case, studied other
25 things other than Telefunken. I was asked a specific

1 question about obviousness from the Telefunken. And I
2 responded to that question based on my general knowledge
3 accumulated through these years and reviewing things like
4 these patents through the years and experience over the
5 years.

6 Q. That's really more than I'm asking you.

7 I just want to know have you considered other
8 prior art than the Telefunken reference in formulating your
9 obviousness opinion?

10 A. No, not at this time.

11 MR. JENNER: All right. Your Honor, if this is
12 convenient, it would be a good place to stop for today.

13 THE COURT: All right. Come back tomorrow and
14 I'll try to be on time at 9:00.

15 (Court recessed at 4:50 p.m., to reconvene on
16 Thursday, June 22, 1995, at 9:00 a.m.)

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I N D E X

DEFENDANT'S TESTIMONY	DIRECT	CROSS	REDR	RECR
Thomas C. Tyler -----	35	71	103	126
Alex M. Cook, Jr. -----	135	190	---	---

I hereby certify that this transcript is a true and correct copy of the original transcript as filed in the proceedings.

 Official Court Reporter
 U. S. District Court

- VOLUME D -

IN THE UNITED STATES DISTRICT COURT
IN AND FOR THE DISTRICT OF DELAWARE

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PHILLIPS ELECTRONICS NORTH	:	CIVIL ACTION
AMERICA CORPORATION,	:	
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Plaintiff	:	
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	:	
v.	:	
	:	
	:	
UNIVERSAL ELECTRONICS, INC.,	:	
	:	
Defendant	:	NO. 94-392 (RRM)

- - -

Wilmington, Delaware
Thursday, June 22, 1995
9:03 o'clock, a.m.

- - -

BEFORE: HONORABLE RODERICK R. MCKELVIE, U.S.D.C.J.

- - -

APPEARANCES:

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Official Court Reporters

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Counsel for Defendant

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21 Fish & Neave

22 - - -
23
24
25

P R O C E E D I N G S

(Proceedings commenced at 9:00 a.m.)

THE COURT: Good morning.

MR. JENNER: Good morning, your Honor.

THE COURT: Ready to proceed?

MR. JENNER: We have a little housekeeping time early in the morning again.

THE COURT: Good.

MR. JENNER: We spoke with counsel last night about this, and we would like to present this to your Honor.

It appears from the pace of things that UEI's case will be in through the witnesses, that is, probably sometime tomorrow, early, mid-tomorrow. It looks like the best guess right now.

And we broached with counsel the proposition of ending for the week with the close of their witnesses. We've still got scheduling problems and I know we've all been scrambling this week. And we suggested that, if we did that, it would help us with the scheduling. We would start in again Monday morning.

Counsel raised the prospect of their having the

1 weekend to get their deposition designations together. They
2 would like to read some Monday morning as we did. We don't
3 have any problem with that.

4 So the thought would be, let's get to the end of
5 their witnesses in chief, if your Honor will go along with
6 this, wrap up there and start in again Monday morning with
7 their designations.

8 We then expect in the next couple of days to have
9 not more than, at this juncture anyway, unless we hear
10 something we have not anticipated, seven witnesses, of which
11 virtually all of them are short. We would expected that they
12 would all be on and off Monday and Tuesday, with the
13 exception of one witness, who's going to have a scheduling
14 problem no matter what.

15 This is a third party, a Ms. Murphy, that we're
16 trying to get to come in. We thought we might be able to get
17 her for Friday. She can't do it. She's now telling us she
18 thinks she can do it Wednesday.

19 I expect that we will have been done by then and
20 we'll ask to put her on out of time. If she gets back to us
21 and tells us she has more scheduling problems with that
22 client, then either we'll have to ask to bring her on as
23 they are currently expecting to ask about Mr. Vigil, or maybe
24 we can reach some other accommodation in light of what the
25 testimony is that she needs to offer.

1 MR. BROWNE: Your Honor, what we had talked about
2 after I had talked to Mr. Jenner was, rather than
3 inconveniencing the Court by bringing a single witness in on
4 Wednesday and all the parties back here, that we could just
5 put maybe Ms. Murphy off until we bring in Mr. Vigil and have
6 the two of them at the same time.

7 MR. JENNER: That might be do-able if we can work
8 out a schedule that fits with the Court's schedule.

9 THE COURT: That is fine with me. All of that is
10 fine with me.

11 With regard to this week and next week, what I've
12 said is I've blocked out the time for you. Fill it now as
13 you wish to and, to the extent that you want to back off
14 certain time, that's fine. I'm starting to fill things in
15 towards the end of next week, with the thought that you'll be
16 out of here by then.

17 And as it's a non-jury trial, we can always come
18 back.

19 I put together a group of cases I wanted to read
20 over the weekend, and I thought I would like to talk to
21 people about the case at the time the evidence is in. And it
22 may be pre-Vigil, post-Vigil. And it's not -- it's more to
23 make sure we're all on the same wavelength, maybe give a
24 couple of indications what I've seen so far and what I'm
25 thinking so far.

1 And the one thing that happens when I do that is
2 people look at the week and days and we all end up doing that
3 Friday afternoon at 4:00 and everybody is exhausted and
4 you're thinking about going out of town.

5 And so maybe we should just keep in mind that
6 Tuesday, Wednesday morning, sometime we'll have an hour and
7 we'll just talk about what you think the issues are in the
8 case, what you think the proof is, what my reaction is to
9 what I've heard so far, where I may need some more education
10 on topics.

11 All right?

12 MR. BROWNE: Fine. Fine.

13 THE COURT: Okay.

14 - - -

15
16 DEFENDANT'S TESTIMONY

17 CONTINUED

18
19 ... ALEX M. COOK, JR., having
20 been previously duly sworn as a
21 witness, was resumed and testified
22 further as follows ...

23 MR. JENNER: Could we have Defendant's Exhibit
24 No. 177?

25 (Mr. Jenner handed Defendant's Exhibit No. 177 to

1 the witness.)

2 CROSS-EXAMINATION

3 BY MR. JENNER:

4 Q. Good morning.

5 A. Thank you. Good morning.

6 MR. JENNER: 177, your Honor, is the Z-a-t-o,
7 Zato patent that's in previously (handing patent to the
8 Court).

9 BY MR. JENNER:

10 Q. This is another patent having to do with remote
11 controls; is that correct, sir?

12 A. Yes, it is.

13 Q. And if you would look over at Column 1 of the
14 text...

15 A. Yes.

16 Q. Would you, again without need to read aloud, if you
17 would look down at the third paragraph in Column 1 that
18 starts at Line 26...

19 A. Okay.

20 Q. And read that paragraph and let me know at the end of
21 reading it if you would agree that it recites problems having
22 to do with known remote controls.

23 (Pause while witness reviewed the patent.)

24 THE WITNESS: Yes, it does.

25

1 BY MR. JENNER:

2 Q. Does it even recognize, in about the third sentence,
3 that it would be desirable to control a number of devices
4 from a single remote control?

5 A. Yes.

6 Q. Would you look at the last paragraph before the object
7 of the invention? That's in Column 2 and the paragraph
8 starts at Line 39.

9 Do you have that paragraph, sir?

10 A. Yes.

11 Q. It starts with, "The present invention is
12 intended..."

13 A. Yes.

14 Q. And in that paragraph does it, in fact, refer to the
15 possibility of a solution in the form of a remote control
16 that would control a large number of devices?

17 A. Let me read it. Hang on.

18 Q. Please.

19 (Pause while witness reviewed the patent.)

20 THE WITNESS: Yes.

21 BY MR. JENNER:

22 Q. Now, that paragraph indicates the Sony solution for --
23 a Sony solution, I should say, for controlling a number of
24 devices.

25 And it expressly chooses to solve the problem

1 without using a microprocessor; correct?

2 A. I can't attest whether it's the Sony solution. I have
3 not studied the Sony patent recently, so I don't know if it
4 is exactly the same thing.

5 Q. All right.

6 But, in any event, whoever's solution it is --
7 we'll leave that open for the moment -- they choose to do it
8 without using a microcomputer?

9 A. It does say that it is available to do without a
10 microcomputer.

11 Q. All right.

12 So they obviously knew about microcomputers, but
13 decided that they were going to try to solve the problem
14 without them?

15 A. That's correct.

16 Q. All right.

17 And if you would just look over to the cover page
18 of this, you have accurately corrected me. I believe this is
19 a Zenith patent. We had the Sony patent yesterday.

20 A. That's correct. This is the Zenith patent.

21 Q. Okay.

22 A. This is -- from my recollection, having reviewed this
23 in the past, it's a patent where they were trying to control
24 a number of their own products.

25 Q. Right.

1 So that is kind of like the RCA Harger patent, in
2 the sense that the solution they came up with here is a
3 control to control devices in different category, but they
4 were intended to be all Zenith devices?

5 A. And the distinction is it's multi-device, but it's
6 typically single format; therefore, it can be done without a
7 microprocesser.

8 Q. Right.

9 And, therefore, it also was not a solution which
10 involved controlling multiple categories of devices made by
11 multiple manufacturers. They did not do that; correct?

12 A. That's correct.

13 Q. All right.

14 And Zenith, of course, was another big television
15 company?

16 A. And in the cable business also.

17 Q. Right.

18 And I take it that the Zenith patent that we just
19 looked at, Zato, Defendant's 177, is another patent which you
20 did not consider recently in connection with formulating your
21 opinion about obviousness?

22 A. That's correct.

23 Q. Is that fair?

24 A. That's correct.

25 Q. Now, if you turn over -- do you have the Telefunken

1 patent up there from before?

2 A. I have a translation of the Telefunken patent, yes.

3 Q. Do you have the original German as well?

4 A. Yes.

5 Q. Okay.

6 Now, Telefunken also recognized the problem of
7 having multiple remote controls; correct?

8 A. Okay. Ask that one more time.

9 Q. Telefunken also recognized that there was a problem of
10 having multiple remote controls?

11 A. I don't think they addressed it exactly in those words,
12 but I think the answer is yes.

13 Q. Let's look over in the text portion. I'll specify the
14 text portion, because the claims are numbered 1 to something,
15 and then, after that, the text is 1 to something.

16 A. I understand.

17 Q. In the text portion, would you look at Pages 1 and 2?
18 And then start at the bottom of Page 1.

19 A. Okay.

20 Q. It talks about known remote controllers that are
21 generally unambiguously fixed and so on.

22 That's a dedicated remote?

23 A. Yes, it is.

24 Q. And then at the bottom four lines, it says that the
25 user has to obtain a new specific remote for every new

1 apparatus.

2 A. Correct.

3 Q. So that's multiple remotes if you have two or more
4 apparatuses?

5 A. Correct.

6 Q. And on the next page, 2, starting at the third line,
7 the user has to become familiar with every newly obtained
8 remote controller, once again, even if it is intended for a
9 second apparatus of the same type it says; correct?

10 A. That's what it says, yes.

11 Q. So that's a problem if you have two dedicated remotes
12 for parallel VCR's or two dedicated remotes because you have
13 two TV's?

14 A. Yes.

15 Q. And at the end of that paragraph, about halfway down
16 the page, the last five lines of the first paragraph, says,
17 in essence, that this wide range confuses even the
18 technically experienced user in the case of different remote
19 controllers which are directly alongside one another, and
20 necessarily leads to a greater frequency of incorrect control
21 operations than as necessary.

22 Do you see all that?

23 A. I see that.

24 Q. So that Telefunken recognizes the problem of
25 potentially having a plurality or a multiplicity of remote

1 controls?

2 A. Telefunken is more directly addressing the fact that
3 different remote controls have a different key pad layout,
4 and the standardization of a layout of functions for a given
5 type of device would be an advantage to a consumer.

6 Q. Right.

7 But it's still a problem of having a range of
8 remote controls?

9 A. It is.

10 Q. And Telefunken knew about microprocessors; right?

11 A. Yes, they did.

12 Q. They even refer to it on Page 3 and elsewhere?

13 For example, on Page 3 of the translation, under
14 the description of the three figures, in the third line, it
15 talks about a control mechanism 1 which is designed as a
16 microprocessor system.

17 A. Yes.

18 Q. But the Telefunken solution, as I think you've already
19 testified, is a solution where you control devices of only
20 one category, be they VCR's or TV's?

21 A. Yes.

22 Q. So that it's really just a replacement for a dedicated
23 remote control?

24 A. It would be what I would consider universal in that it
25 transmits many different types of codes but it's intended use

1 is to replace a dedicated remote.

2 Q. Right. Okay.

3 (Pause.)

4 BY MR. JENNER:

5 Q. So we've seen now patents from Telefunken, Zenith, RCA,
6 Sony, G.E., all major TV and/or VCR and/or even cable
7 companies of the early 1980's; true?

8 A. Correct.

9 Q. And they all recognized, in one way or another, the
10 problem of the proliferation of remote controls on the
11 table top; true?

12 A. Correct.

13 Q. And insofar as you're aware, none of those big TV
14 companies recognizing that problem came up with the solution
15 of a remote control to control multiple categories made by
16 multiple manufacturers, with the exception of the G.E.
17 learning remote that works in a different way; true?

18 A. I -- let's break that question down, make sure I
19 understand what you are asking, please.

20 Q. Be glad to do it.

21 Having seen the multiplicity of large television
22 company patents that we went through yesterday afternoon and
23 the two more this morning --

24 A. Right.

25 Q. -- it is the fact that every one of those patents of

1 those big companies recognized, in one way or another, a
2 problem having to do with proliferation of remote
3 controls?

4 A. Certainly. In this time period throughout the
5 industry, everybody understood that.

6 Q. And with everybody in the industry understanding that,
7 nobody, to your awareness, before the Phillips patent, came
8 up with the solution of a remote control that could control
9 multiple categories of devices made by multiple
10 manufacturers, with the exception of the G.E. learning
11 remote?

12 A. Well, the Phillips patent in question to date defines a
13 means and method for a search function, not for a universal
14 remote control.

15 Q. And nobody came up with that kind of a search function
16 for multiple devices made by multiple manufacturers?

17 A. None of these patents cover that. I'm not aware of a
18 search function, other than what is described in the
19 Telefunken patent.

20 Q. Which is not multiple categories?

21 A. Which does not list multiple categories.

22 Q. Okay.

23 Now, did you consider, in formulating your
24 opinion, whether or not the examiner in the Patent Office had
25 any of these references? And by that I mean the prior art

1 patents before him during prosecution of the Phillips
2 application?

3 Were you asked to consider that?

4 A. I wasn't asked to consider anything relative to that.

5 But I do know, from reading the case history at
6 the Patent Office, at least the German patent, Telefunken
7 patent, was discussed by the Phillips attorneys.

8 Q. So the examiner had that?

9 A. And it was a reference to another patent, I think.

10 Q. Right.

11 The examiner had and discussed the Telefunken
12 reference, as you say?

13 A. Apparently so.

14 Q. And there was reference to, in fact, all of the
15 references that we have discussed yesterday afternoon and
16 this morning.

17 Do you know that?

18 A. I would have to look to see. I don't know that from
19 memory.

20 Q. All right.

21 Do you have the Phillips patent before you?

22 A. Yes, I do.

23 Q. On the cover page of the Phillips patent, you can see
24 some references that were cited; right?

25 A. Yes.

1 Q. And included in the list of cited references at the top
2 of the second column is the Zato reference?

3 A. Yes.

4 Q. And the Welles reference?

5 A. Yes.

6 Q. And below the foreign patent title is the Telefunken
7 reference.

8 Those three you can see on the face of the
9 patent; right?

10 A. Yes.

11 Q. And were you here two days ago, I guess it was, when
12 Mr. Manbeck testified about the examiner's search notes and
13 the parent application?

14 A. No, I was not.

15 Q. You didn't hear that? All right. We'll let that part
16 of the record speak for itself.

17 I take it that it would not surprise you if the
18 other references that I've asked you to look at were also
19 initialed off on by the examiner from the parent
20 application?

21 A. It wouldn't surprise me.

22 Q. Okay.

23 Now let's turn into your testimony about the
24 patent and the claims and the infringement issues.

25 A. Okay.

1 Q. I'd like to zero in on what areas of disagreement we
2 might have as between the plaintiff and the defendant.

3 If I understood your testimony yesterday
4 correctly, you have found two principal limitations present
5 in each of the claims which are your basis for concluding
6 that there is noninfringement here. Is that fair?

7 A. That's fair.

8 Q. And in each of the claims there is a limitation that
9 involves the word predetermine; is that right?

10 A. Correct.

11 Q. And there is also a limitation which involves the
12 plurality of codes; is that right -- I should say the
13 transmission of codes.

14 A. Plurality of response command signals, yes.

15 Q. Right.

16 And has that second issue sometimes been referred
17 to as the automatic issue?

18 A. I've used that term in discussing it, yes.

19 Q. Okay.

20 So that your position is that both of the claims
21 require a certain kind of predetermined action which is not
22 involved in the UEI remote; correct?

23 A. That's correct.

24 Q. And your other position is that both of the claims
25 require an automatic type of operation which is not found in

1 the UEI devices?

2 A. That's correct.

3 Q. And is it also correct that your direct testimony did
4 not set forth any other ground of noninfringement?

5 A. I think that's correct.

6 Q. All right.

7 So that we can agree -- or I should put it a
8 different way.

9 At this juncture, your opinions agree with Mr.
10 Smith's opinion that, except for those two limitations of the
11 claims, everything else is found in the UEI devices and we
12 don't have to deal with that. True?

13 A. There is a subtlety that perhaps I should draw a
14 distinction to.

15 Q. Sir, did you testify about it in your direct case?

16 A. No, I don't think so.

17 Q. All right.

18 I want to limit this to what your opinion
19 was.

20 A. I see.

21 Q. And if you have in mind a distinction -- a third
22 distinction that you gave direct testimony about, then
23 perhaps we have to address it.

24 But my understanding is we've condensed this
25 through your direct testimony opinion to two issues in each

1 claim. Is that fair?

2 A. I did testify to the two issues you mentioned, yes.

3 Q. Okay.

4 Now, in dealing with the issue of what
5 predetermined means here, in your opinion I believe you were
6 asked to identify those places in the specification of the
7 patent and elsewhere where you found the support for your
8 views about predetermine; correct?

9 A. Correct.

10 MR. JENNER: Your Honor, may I use the easel?

11 THE COURT: All right.

12 BY MR. JENNER:

13 Q. If I followed your testimony correctly -- and I will
14 add that I looked in the transcript to make sure I wasn't too
15 far off -- in dealing with the issue of predetermine, which
16 I've already spelled wrong.

17 A. That's right.

18 Q. No. That's right.

19 You referred to Column 5, Line 51, and you
20 referred to Claims 3 and 4. You referred to Figure 5. You
21 referred to the prosecution history.

22 A. Correct.

23 Q. You referred to the Telefunken reference.

24 A. Yes.

25 Q. Then Mr. McDonough referred you to Column 1, Line 66.

1 A. Okay.

2 Q. You referred to Column 4, Line 63.

3 A. Okay.

4 Q. And you referred to Column 6, Line 11.

5 A. Okay.

6 Q. Now, I would like to ask you if you have any other
7 basis that might have not been in your mind yesterday for
8 your views about predetermined?

9 A. Well, I also testified yesterday that, just through my
10 normal English language use of the word predetermined, I had
11 a meaning. And that, as an engineer, predetermined meant
12 something specific to me.

13 Q. That's true. I was trying to deal with the documents.
14 I think you characterized predetermined as meaning something
15 like ahead of time?

16 A. Determined ahead of time or previously, yes.

17 Q. Ahead of time or previously. So let's put that in.

18 Ahead of time or previously. And I will just
19 draw a little line to separate that from the others --

20 A. Okay.

21 Q. -- to indicate on the record that this is not from the
22 documents themselves. The things above that line are from
23 the various documents.

24 A. And also in discussing the interpretation of
25 predetermined in some of these items, I've pointed out that,

1 to me, as an engineer, using this technology, predetermined,
2 to me, meant at the time of design.

3 Q. Okay. Let's include that. Or time of design.

4 A. Okay.

5 I'm trusting your list because I don't have notes
6 from yesterday.

7 Q. That's fine. I think if I've left out a significant
8 thing you relied on, I suspect that counsel will let me know
9 that.

10 At one point in your deposition testimony, you
11 had relied on one other item that I'm aware of, and I just
12 want to find out whether you rely on it any longer. And that
13 is at one point you had also relied on the abstract of the
14 patent.

15 A. I'm sorry?

16 Q. You had relied, during your deposition, on the abstract
17 of the patent.

18 Do you continue to rely on the abstract of the
19 patent or do you no longer rely on that?

20 A. Excuse me. I don't remember the abstract. Let me look
21 back again.

22 Q. Sure.

23 (Pause.)

24 THE WITNESS: I would have to say yes. The word
25 predetermined is used in the abstract and, as I've pointed

1 out, my opinion involves taking each of these things
2 individually and then in a combination to understand the
3 overall meaning.

4 And since this is part of the patent and uses the
5 word predetermined, I would have to say, in that combination,
6 I did rely on it.

7 Q. All right.

8 Do you still?

9 A. Yes.

10 Q. And did you discuss -- in the formulation of your
11 opinions, did you discuss with counsel the fact that you rely
12 on the abstract?

13 Let me jump ahead and I'll tell you where I'm
14 going, so that you know where I am going.

15 Did anybody point out to you that, in
16 interpreting the claims of the patent, you cannot rely on
17 the abstract? Did anybody tell you that?

18 A. I think that I've had that discussion before. I don't
19 recall if I've had the discussion here in the -- in this
20 particular case recently. But I've had that discussion in
21 other situations.

22 Q. Okay.

23 I have been chomping at the bit to use Elmo here,
24 so let me put something on the Elmo.

25 This is from a document called Code of Federal

1 Regulations (placing document on the Elmo). It's Chapter
2 37. And there is one of the rules, 1.72, that says Title and
3 Abstract. And it ends up by saying, at the bottom, in the
4 vicinity of where my pen is pointing, that the abstract shall
5 not be used for interpreting the scope of the claims.

6 Do you see that?

7 A. Sure.

8 Q. All right.

9 Is that anything that had been discussed with you
10 in formulating your opinions?

11 A. No, it hadn't. But if you remove this from it, it's
12 not going to significantly change my opinions, so I won't
13 disagree if you remove it.

14 Q. Okay.

15 A. I would say that perhaps we should read that.

16 Q. They don't know about that one?

17 A. No.

18 Q. Okay. Between us we'll spread the world.

19 THE COURT: What about the District Judges? I
20 can look at everything in the world but an abstract because
21 it says in the C.F.R. I can't?

22 MR. JENNER: Actually, your Honor, there are some
23 cases on that and maybe that's something we can deal with in
24 a transitional way or later.

25 But the purpose of the abstract is to give

1 somebody a quick idea of what you can find in the patent, and
2 it's not supposed to be so rigorously done as to be a
3 limitation, and that's why they put that in there.

4 THE WITNESS: Let me ask --

5 THE COURT: What we're really talking about is
6 English language. And I take it what his testimony is going
7 to end up being, if he follows along, is to say, Look,
8 whoever drafted the abstract used the word predetermined in a
9 way that I would use it and, as a matter of English language,
10 as opposed to being what the inventor or the drafter of the
11 patent intended the word to mean in his or her --

12 MR. JENNER: Well, I would agree that somebody
13 had to put together an abstract and they did it maybe with
14 deliberation and maybe hurriedly, and who knows what they had
15 in mind when they did that.

16 THE COURT: All right.

17 THE WITNESS: When you said it can't be used to
18 interpret the scope of the claims, that refers to limitations
19 of the claims.

20 Is that what you are trying to say?

21 BY MR. JENNER:

22 Q. I don't want to have to get you off on a legal matter.

23 I would say essentially --

24 A.

25 A. You introduced it. I want to make sure I understand

1 it.

2 Q. Yes. In essence, that's right. In essence, that's
3 right.

4 A. Okay.

5 Q. Now, let's look at some of the rest of this.

6 Just to separate some things out to come back to
7 in a while, the prosecution history, of course, is not
8 outside of the patent.

9 A. Okay.

10 Q. So I'll put a little line by that. We'll deal with
11 that later.

12 A. That's fine.

13 Q. The Telefunken reference is outside of the patent.

14 A. I agree.

15 Q. Now, just to help a little bit in looking at the
16 patent, I'm going to ask you if you would look at another
17 copy of the patent which I have had marked as 217-A. It's
18 an identical copy of the patent, but we've added a little
19 bit of color-coding to it (handing document to the
20 witness).

21 You will see in looking in this that the
22 color-coding that's added is intended to refer to two
23 general subject matters. One is what we referred to as the
24 preferred embodiment.

25 You've heard that term before?

1 A. Yes.

2 - - -

3 Q. The other color, which is the preferred embodiment
4 color, is yellow here. And the other one is to refer more
5 generally to the invention. And that's done in pink.

6 If you want to see what I have in mind there,
7 turn over to Columns 1 and 2, and it refers to that area that
8 has already been discussed in the testimony under the summary
9 of the invention.

10 Do you find that?

11 A. Yes.

12 MR. McDONOUGH: Could I just object to this
13 exhibit?

14 It wasn't provided to us before. And to the
15 extent it's intended to be testimony, it seems to me --

16 THE COURT: I will treat it as if it is argument;
17 that is, it reflects certain decisions about what's the
18 invention and what's the preferred embodiment.

19 You can argue later about -- people can argue
20 later about whether they make the correct designation. This
21 is simply an assumption he's using for his questioning. It's
22 appropriate cross-examination.

23 BY MR. JENNER:

24 Q. Let's see, sir, how this is put together. Let's jump
25 into Column 2.

1 At the bottom, the subtitle is highlighted in
2 yellow, the description of the preferred embodiment?

3 A. Yes.

4 Q. And if you go over to the top of Column 3, skipping over
5 a little bit there in pink where it says, "The present
6 invention is also usable with other types of remote
7 controls."

8 Do you see that at the top of Column 3?

9 A. Yes.

10 Q. Then it starts with the reference to Figure 1, and
11 everything in Columns 3, 4, 5 and 6, and the top of Column 7,
12 is highlighted in yellow.

13 A. Yes.

14 Q. Would you agree that the portion highlighted in yellow
15 from those five columns refers to the preferred embodiment
16 set forth in the patent?

17 A. It will take a few minutes to study this.

18 Q. Fine. If that's all right with the Court.

19 A. The first question I have on that --

20 Q. Sure.

21 A. Column 2 at Line 45 begins to describe the present
22 invention, and that's not in pink.

23 Is there a particular reason for that?

24 Q. Frankly, I didn't want to make the decision right there
25 of what that was.

1 A. It refers to some of the same items that you have in
2 yellow on the diagrams as being preferred embodiment, as
3 being the present invention.

4 Q. Would you like to consider that last four, five lines at
5 the bottom of Column 2 as part of the preferred embodiment?
6 I'm happy to do that if you think that's what it ought to be.

7 A. I'm saying starting at Line 45.

8 Q. 45. Okay.

9 A. You referred to the drawings and the flow charts as
10 being representative of the present invention, not of the
11 preferred embodiment. And that's a distinction that you're
12 trying to draw here. So I'm confused.

13 Q. I see what you are saying. The brief description of the
14 drawing and the description of Figures 1 through 6?

15 A. "The present invention, as well as
16 objects thereof, will be better
17 understood upon reference to the
18 following description taken in
19 conjunction with the accompanying
20 drawings."

21 Q. Right. Let's take it in pieces.

22 I would agree, first of all, that the brief
23 description of the drawing and the six drawing items listed
24 under it from Lines 50 to 60, that relates to the preferred
25 embodiment as well.

1 Is that part of what you are saying?

2 A. No.

3 I am saying it sounds like to me the drawings
4 relate to the present invention, not to the preferred
5 embodiment.

6 Q. You are saying that the drawings are not the preferred
7 embodiment?

8 A. I'm saying they describe the invention based on that
9 statement.

10 Q. What are you saying, is that the drawings, are they or
11 are they not the preferred embodiment?

12 A. They are the preferred embodiment and the present
13 invention.

14 Q. So you would say that the drawings are both?

15 A. Well, I'm not sure I'm understanding your distinction
16 here and what point you are trying to make.

17 Q. I'm not sure I'm understanding yours. Let's work on it
18 for a minute.

19 A. Okay.

20 Q. The patent is required to set forth the preferred
21 embodiment. That part we agree on; correct?

22 A. Okay.

23 Q. And the text in the bulk of Columns 3 through 7
24 describes the preferred embodiment?

25 A. Based on what you've shown here, yes.

1 Q. If we were to go through that text in Columns 3 through
2 7, it's going to refer in the text, one after the other, as
3 the narrative text back to the drawings?

4 A. Okay.

5 Q. So don't the drawings go hand in hand with the written
6 text?

7 A. Yes, I think so.

8 Q. So that the drawings are accompanying, incorporated its
9 material to the text about the preferred embodiment?

10 A. I think that's correct.

11 I'm not disagreeing at this point. I haven't
12 finished a study of this. I'm not disagreeing at this
13 point that the drawings do refer to the preferred
14 embodiment.

15 What I'm pointing out is you have to draw a
16 distinction between present invention and preferred
17 embodiment. And the first thing I saw was the section
18 describing present invention as being shown in the drawings.
19 And that's not included.

20 Q. I see what you are saying.

21 You are saying maybe there isn't a distinction
22 there or maybe a fuzzy distinction?

23 A. At this point I can't say there is a distinction. The
24 diagrams also describe the present invention and not just the
25 preferred embodiment.

1 Q. All right.

2 Why don't you continue your review and tell me
3 whether you have a problem with the rest of it?

4 A. Okay.

5 May I mark on this copy?

6 Q. Do you want to make notes on it?

7 THE COURT: Why don't you mark on that? That's
8 fine.

9 Do you want a blue pen?

10 THE WITNESS: Yes.

11 (Blue pen was handed to the witness.)

12 MR. JENNER: We have another original,
13 apparently, if need be.

14 THE COURT: That's okay. The Appeals Court
15 would want to see what he has written.

16 THE WITNESS: I have a problem on Column 3 at
17 Line 5.

18 This description that you have given here, by
19 referring to the diagram, if I read now on Column 2, Line
20 51, this says:

21 "Figure 1 is a block diagram
22 of a remote control unit and
23 associated apparatus according to
24 the present invention."

25 And yet you've highlighted this description of

1 that as being strictly preferred embodiment. So I think it
2 needs to be both again.

3 BY MR. JENNER:

4 Q. Well, is there any question that this is the preferred
5 embodiment, starting at Line 5?

6 A. No.

7 Q. The invention of the preferred embodiment is to be
8 consistent with the invention.

9 A. Okay.

10 Q. So we could probably say that what is in yellow is both,
11 the preferred embodiment and the invention, or should we say
12 perhaps that it is the preferred embodiment in accordance
13 with the invention?

14 A. Then what would you describe the pink to be?

15 Q. Not the preferred embodiment. Whatever else it is, it
16 is outside the preferred embodiment.

17 Wouldn't you say that's correct?

18 In other words, if I understand what you want to
19 do, you want to acknowledge that whatever the preferred
20 embodiment is, it is still in accordance with the, quote
21 unquote, the invention, and it is not different from the
22 invention?

23 A. Well, let's go forward. Let me read some more and
24 see.

25 (Pause while witness reviewed document.)

1 THE WITNESS: I'm not sure I can agree with that
2 statement exactly.

3 BY MR. JENNER:

4 Q. That's all right.

5 A. Let me go forward.

6 Q. Okay. Go ahead.

7 (Pause while witness reviewed document.)

8 BY MR. JENNER:

9 Q. Have you had a chance to go through it?

10 A. I have been through it.

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2 Q. All right. Let me ask you some questions.

3 A. Please do.

4 Q. Let's see if we can do it this way.

5 Would you agree, if we can do it this way, that
6 if you look at the portions of Columns 3, 4, 5, 6, and 7
7 first, that are highlighted in yellow, that those portions
8 relate to the preferred embodiment?

9 Does it say that?

10 A. Would you point out? It does say description. It is
11 in a section entitled Description of Preferred Embodiments,
12 yes.

13 Q. Right.

14 And if you look at another place, just to confirm
15 that, look at Column 7, at Line 53, the very last paragraph
16 before the claims, where it says that the invention has been
17 illustrated in a particularly preferred embodiment.

18 A. Correct.

19 Q. Okay.

20 So the portion 3, 4, 5, 6 and 7 that's in yellow
21 is the preferred embodiment.

22 Is there any doubt about that?

23 A. No. I think that's -- I think you've described
24 preferred embodiment, yes.

25 Q. Okay.

1 I don't mean to suggest to you that because it's
2 the preferred embodiment, that it's different from the
3 invention. I think we understand, don't we, that the
4 preferred embodiment is in accordance with the invention? It
5 has to be?

6 A. It has to be, right. I agree.

7 Q. Okay.

8 So let's go at it that way. The yellow portions
9 in 3, 4, 5, 6 and 7 describe the preferred embodiment.

10 A. Okay.

11 Q. The drawings, as you fairly brought up, also describe
12 that same preferred embodiment, because that is what is
13 referenced in the text.

14 A. Okay.

15 Q. The drawings, of course, are also in accordance with
16 the invention.

17 A. Correct.

18 Q. And it's also true, is it, that if you look in Column
19 2, where there's that other block of yellow text, starting at
20 Line 26 through about Line 44, that that is also drawn to the
21 preferred embodiment?

22 A. Yes.

23 Q. Because it says so?

24 A. Explicitly stated, yes.

25 Q. All right.

1 Let's go at it another way, then. As far as the
2 pink is concerned in Columns 1 and 2 and at the bottom of
3 Column 7, there's nothing in the pink area where it says
4 anything about limiting those passages to the preferred
5 embodiment; correct?

6 A. You're going to have to describe that in different
7 wording. This is where I'm confused.

8 Q. Let's look at it this way.

9 Look at the paragraph at the end of Column 7.
10 It's a typical kind of paragraph.

11 A. Boilerplate.

12 Q. It's there for a reason, because the people who are
13 putting the patent together want to make it plain that they
14 believe that their patent or their invention is directed to
15 more than just the preferred embodiment.

16 That's the reason it's in there; right?

17 A. I understand.

18 Q. And that's what that paragraph says, although what
19 we've set forth above is a particular preferred embodiment,
20 we don't intend it to be limited to that. Variations exist,
21 so on and so forth.

22 A. Okay.

23 Q. And that also, in the paragraphs in the bottom of
24 Column 1 and Column 2, those portions that are in pink
25 precede Line 25, which then goes into a presently preferred

1 embodiment; correct?

2 A. Correct.

3 Q. So isn't it fair to infer that what precedes that in
4 pink is supposed to be something other than, or more than the
5 preferred embodiment? Wouldn't you infer that from the
6 words?

7 A. Something greater than the preferred embodiment you're
8 saying?

9 Q. It's more than the preferred embodiment. Otherwise,
10 why would the words transitionally in a presently preferred
11 embodiment appear there?

12 A. Okay. I agree it's more generalized.

13 Q. Okay.

14 Let me look at it another way, just for a
15 minute. What little smidgen I remember of math from the
16 eleventh grade, because I'm having to review it with my
17 daughter.

18 That's a set. That's everything that's in the
19 invention (drawing on the easel). And the patent -- that --
20 we can represent the invention covered by the patent as some
21 set, a circle.

22 A. Okay.

23 Q. Fair?

24 A. Fair.

25 Q. And you have to set forth in the patent at least one

1 preferred embodiment.

2 A. Right.

3 Q. Which is consistent with and part of the invention.

4 A. Somewhere inside that circle.

5 Q. Right.

6 So somewhere in here (indicating), perhaps here,
7 arbitrarily, there has to be a preferred embodiment. One or
8 more.

9 A. Okay. And the bigger circle completely defines the
10 patent?

11 Q. Right. The bigger circle is fixed in space somewhere.
12 It's the whole patent. The smaller circle, which is
13 somewhere inside the bigger circle, is the preferred
14 embodiment.

15 A. Okay.

16 Q. And it would follow from that that there is something
17 more in green here (indicating) than the preferred
18 embodiment.

19 And I am not suggesting for a moment how big or
20 how small the inner circle is, how much or how little the
21 green is. But there's something in there beyond the
22 preferred embodiment.

23 A. Okay.

24 Q. Has to be.

25 A. And the distinction you're drawing is the bigger

1 circle is the, quote, present invention, description of
2 present invention. The smaller circle is the preferred
3 embodiment?

4 Q. In accordance with the present invention.

5 A. Okay.

6 Q. Fair?

7 A. Fair.

8 Q. Okay.

9 Let's go through what we have here in the
10 document and see what it is.

11 This at Column 5, whatever it is, it's part of
12 the preferred embodiment.

13 A. Okay.

14 Q. I will write "Pref. Emb.," to keep it short.

15 A. P.E. will be fine.

16 Q. Figure 5 is part of the preferred embodiment.

17 A. Well, I read, again, going back to, starting at Line 45
18 in Column 2, the list of figures describes entirely the
19 present invention.

20 "The present invention, as well
21 as additional objects thereof, will
22 be better understood upon reference
23 to the following description taken
24 in connection with accompanying
25 drawing."

1 When we talk about Figure 5 on the list, it's in
2 accordance with the present invention. Figure 6 at the end
3 of Line 59 says that.

4 So I was reading this to -- for that to be
5 included -- to be the bigger circle not the smaller circle.

6 Q. All right. So we may have a point of disagreement
7 there.

8 The specification in Column 7 ends up by saying,
9 although the invention has been illustrated in a
10 particularly -- a particular preferred embodiment -- and I
11 would suggest to you isn't the illustration, the combination
12 of the text and the drawings that are referred to above?

13 A. Okay.

14 Q. Wouldn't that mean that the drawings and the text are
15 the preferred embodiment?

16 A. This is -- we're really into a semantics issue here.

17 Q. And I don't want to belabor it, because ultimately it's
18 for the Judge.

19 A. I agree.

20 Q. I just want this proposition to be laid out on the
21 table. I think the Court has probably got the point and we
22 don't need to belabor it much more.

23 A. I think so. I think, at best, it's confusing in the
24 patent.

25 Q. All right.

1 So I'm going to put, by Figure 5, a question
2 mark, and I'm going to say P.E., or invention. And the Court
3 has the point, and will do with it what the Court does with
4 it. All right?

5 A. Okay.

6 Q. Let's go on.

7 Column 4, Line 63 is part of the preferred
8 embodiment.

9 A. Agreed.

10 Q. Column 6, Line 11 is part of the preferred
11 embodiment?

12 A. Okay.

13 Q. So that we have this portion here (indicating) in the
14 summary of the invention that you referred to. That's in
15 the pink.

16 A. Okay.

17 Q. And Claims 3 and 4, of course, are part of the claims.

18 Let me ask you a question or two about Claims 3
19 and 4, if you turn over to that.

20 A. Okay.

21 Q. Claim 3 calls for a whole lot of things, including a
22 step of transmitting the response command signals a
23 predetermined number of times?

24 A. Correct.

25 Q. Now, is there any reason -- as I asked Mr. Smith the

1 other day -- why a remote control could not be made with a
2 dial on it to enable the user to determine how many times
3 the command signal should be sent? That could be done,
4 couldn't it?

5 A. Certainly, the technology existed.

6 Q. I don't know why anybody would want to do it that way,
7 but that's not the point. One could do that if there were
8 some reason for the user to control how many times a command
9 signal should be sent, and you could have it by dialing it in
10 on the remote.

11 A. I -- I agree that the technology exists to do that.

12 Q. All right.

13 Look at Claim 4.

14 Here it includes a whole lot of things again.
15 And it then requires the step of interrupting the
16 transmission of signals for a predetermined intercommand
17 delay time.

18 Do you see that?

19 A. Yes.

20 Q. Once again, I don't know why anybody necessarily would
21 want to do it, but is there any reason why you could not have
22 another dial on a remote control so that the user could
23 arbitrarily decide how much delay time he wanted between
24 signals?

25 A. Mr. Jenner, the technology exists to do that. In my

1 opinion, those devices would be outside of the scope of this
2 patent.

3 Q. I'm not surprised to hear you say that. All I'm trying
4 to bring out is that one could do that.

5 A. The technology would exist to do it.

6 Q. All right.

7 So that there's nothing in the words of the claim
8 that prevents such user control from being exerted? The
9 claim words don't do that, do they?

10 A. I don't see anything that would prevent me from
11 designing a number of other types of products.

12 Q. All right.

13 Column 1, Line 66 in the pink area.

14 A. Okay.

15 Q. You found -- I guess I should point out, again, that's
16 an area that was called to your attention during the direct
17 by counsel.

18 A. Correct.

19 Q. But, nevertheless, you found some support in the
20 vicinity of Column 1, Line 66 for your interpretation of the
21 word predetermined; correct?

22 A. Correct.

23 Q. Would you confirm for me that if one looks through the
24 pink area preceding the preferred embodiment, that there
25 isn't any explicit explanation or use of the word

1 predetermined?

2 A. There is no explicit use of the word predetermined in
3 that area, no.

4 Q. It talks about observable. Observable actions?

5 A. And specific commands.

6 Q. And specific commands you say. Okay.

7 But it talks about observable actions.

8 A. And it gives an example of a specific command. It does
9 talk about observable actions and gives examples of specific
10 commands chosen ahead of time.

11 Q. The specific example being channel change?

12 A. Correct.

13 Q. Could be power off.

14 A. And the words, receiving a specific signal.

15 Q. And where are you pointing to right now?

16 A. Column 2, Line 1. Actually starting at the end of
17 Column 1.

18 Q. All right.

19 A. It talks about some observable action when receiving a
20 specific command signal.

21 Q. Right.

22 Q. Right.

23 And that leads you to conclude that it has to be
24 predetermined at the time of manufacture?

25 A. Yes, it did.

1 Q. What in the phrase execute some observable action when
2 receiving a specific command signal requires that the command
3 signal be installed at the time of manufacture?

4 A. When I checked that entire paragraph together,
5 including the example of channel up, that's my impression
6 from reading that paragraph as a -- an engineer designing
7 remote controls.

8 Q. That paragraph alone would not be consistent with the
9 user pushing the button channel up so that the specific
10 command signal channel up is sent and you then see the
11 observable action of channel up?

12 A. Taken alone --

13 Q. That's what my question is.

14 A. Yes.

15 Q. Taking that one by itself --

16 A. I'm trying to clarify.

17 Q. That's the one that's outside the preferred embodiment,
18 sure.

19 Taken alone, what about that leads you to believe
20 that that would have to be a channel up signal or command, if
21 you will, pre-installed at the factory, and that that could
22 not be characterizing a user just pushing the channel up
23 button and observing that the channel goes up?

24 A. Give me a minute.

25 Q. Sure.

1 A. Let me re-read that paragraph and maybe I can speak to
2 that.

3 (Pause while witness reviews document.)

4 THE WITNESS: I'm sorry, but my -- I guess the
5 word specific is a thing that -- that keeps bothering me
6 there.

7 When I read that again, I still come to the same
8 impression that there's something unique. The word specific
9 is in this for a reason. And it doesn't say an observable
10 action when receiving a command signal. It says a specific
11 command signal. And that word stands out to me to mean
12 something unique and defined as part of this process.

13 BY MR. JENNER:

14 Q. Okay. Let me ask you about that.

15 Is it true with remote controls you would expect
16 to see the observable action channel up when you receive the
17 specific command signal channel up?

18 A. When I transmit the command signal channel up, yes, I
19 would.

20 Q. And you would expect to see the observable action
21 channel down when you receive the specific command signal
22 channel down?

23 A. Yes.

24 Q. And you would expect to see the observable action, the
25 TV goes off, when you receive the specific command signal,

1 power off?

2 A. Correct.

3 Q. Isn't that completely consistent with what's in that
4 paragraph?

5 A. Nothing you said was inconsistent with that.

6 Q. Right.

7 And that, in every instance, it can be caused
8 by the user simply pushing that function on the remote
9 control?

10 A. Certainly, the user can do those functions with a
11 remote control, yes.

12 Q. And that would all be consistent with the language of
13 that particular paragraph?

14 A. Yes.

15 Q. So we have observable running through this area of the
16 pink, not predetermined. And that leads me to ask you the
17 question: Isn't the word predetermined in the claims simply
18 used interchangeably with the word observable? Isn't that
19 all that means in the claims?

20 A. Let's see what the claims are.

21 You're asking me if the term predetermined and
22 observable --

23 Q. Mean the same thing.

24 A. Mean the same thing.

25 Q. In the claims.

1 A. In the claims.

2 Q. Predetermined doesn't mean factory set in the claims,
3 it simply means observable, and that factory set is a
4 preferred embodiment.

5 Isn't that what you should derive -- one should
6 derive from the claims?

7 (Pause.)

8 THE WITNESS: I certainly don't find anything in
9 any of the text prior to the claims that define observable
10 and predetermined to be the same thing, and that's not my
11 normal definition of those two words.

12 BY MR. JENNER:

13 Q. All right.

14 Well, let's look specifically at one aspect of
15 the claims which may shed light on that. And that's Claim
16 6.

17 A. Okay.

18 Q. In Claim 6, in the preamble, it goes over to the top of
19 Column 9, where it talks about being set to execute a
20 predetermined action upon receipt of a response-evoking
21 signal. The predetermined action.

22 A. I've got to go back to the other copy because this one
23 is not readable.

24 Q. Sure.

25 A. Okay.

1 Q. Tell me when you are ready.

2 A. Okay. I'm at Claim 6, at the first part of that
3 preamble.

4 Q. All right.

5 And it trails over to the top of Column 9. And
6 what I want to call your attention over to is that it brings
7 in in the preamble the execution of the predetermined
8 action.

9 And you'll find that on Line 2 of Column 9.

10 A. Yes. I see that.

11 Q. All right.

12 Then it goes on in the first clause, the means
13 for transmitting. And it talks about what's going to
14 happen. And it's going to happen until the appliance
15 executes said observable action.

16 Do you see that?

17 A. Yes, I do.

18 Q. The word observable doesn't appear before that.

19 A. I've noticed that.

20 Q. And isn't it true that any person of ordinary skill, as
21 you have said you are, at least of ordinary skill, would
22 understand that the antecedent for said observable action has
23 to be the predetermined action? That's how you make sense of
24 that, isn't it?

25 A. I had difficulty making sense of this, actually, as a

1 person skilled in the art.

2 Q. But if you read the claims, to use the words, some
3 cases, trying to understand the claims and to make sense out
4 of them if you can, don't you come to the conclusion that the
5 antecedent for said observable action is the predetermined
6 action?

7 A. If you read that claim alone, then about your only
8 choice is to assume that -- that the predetermined action --
9 what was the word? Predetermined -- yes. Predetermined
10 action resulted in the observable action, yes.

11 Q. All right.

12 And that's consistent with the claim, isn't it?

13 A. Yes.

14 The -- reading this, however, makes you want to
15 refer back beyond that claim, unfortunately. That adds the
16 confusion to the patent.

17 Q. I understand you're saying that. And the Judge has the
18 portions that you've referred back to and what we had to say
19 about all of them.

20 A. Yes.

21 Q. But in Claim 6, it's pretty clear that you make sense
22 of the claim by understanding that what the writer did was
23 to use the predetermined action as the antecedent for said
24 observable action.

25 Don't you have to interpret it that way?

1 A. Well, if you look at Claim 6 alone and didn't read
2 anything else, that's the only interpretation. However, the
3 said observable action is a phrase that is used in some of
4 the previous claims. And the first impression I have was
5 referring to something from a previous claim.

6 Q. Okay.

7 Do you know, sir, whether or not your party, UEI,
8 has, in fact, taken the position on the record that
9 predetermined and observable mean the same thing in the
10 context of the claim?

11 A. I'm -- I'm here to represent my opinion on this. I
12 don't know what UEI's opinion is.

13 Q. Well, let me show you, because I'll want to ask you if
14 it affects your opinion.

15 A. Okay.

16 Q. Here is what has been -- wrong way.

17 This is a document that has been filed in the
18 case that's on record. It's the defendant's memorandum in
19 support of a motion that was filed in the case. I'm not
20 going to ask you about the legalities of all of that (placing
21 document on the Elmo).

22 A. Thank you.

23 Q. I just want you to know that's where it's coming from.
24 This is a document filed by the defendant.

25 A. Okay.

1 Q. And on one of the pages of the document, the statement
2 is made, several times -- does the yellow come up on the
3 screen?

4 A. Yes.

5 Q. Okay.

6 It says at the top, Philips has interchangeably
7 used the words observable action and predetermined action.
8 And then it says further down the page, the -- these are
9 statements, by the way, by the defendant UEI. These are not
10 by Philips.

11 A. Okay.

12 Q. The inventors, their own lexicographer, have
13 interchangeably used predetermined action and observable
14 action. Therefore, observable must mean the same thing as
15 predetermined. Observable action and predetermined action
16 have the same meaning.

17 A. Okay.

18 Q. Isn't it true that, in the context of the claims,
19 that's absolutely right? Not that it's factory set, but in
20 the context of the claims, that predetermined just means
21 observable?

22 A. That was not my interpretation upon reading this
23 patent.

24 Q. All right.

25 Does that -- having seen that, I must ask you the

1 question: Does that in any way affect the opinion that
2 you've given?

3 MR. McDONOUGH: Objection, your Honor.

4 I believe the testimony that counsel is giving is
5 mischaracterizing the testimony or the document that he was
6 putting before the witness there.

7 THE COURT: Overruled.

8 THE WITNESS: I would have to study that document
9 before I would make a comment on it.

10 BY MR. JENNER:

11 Q. Okay.

12 A. And that document I have not reviewed previously. I
13 may have seen it in the past, but on the screen here I don't
14 recognize that as being something I've seen.

15 Q. Okay.

16 A. So I'm not willing to change my testimony based on one
17 piece of paper that you've put in front of me.

18 Q. So the answer to my question is, as you sit here now,
19 having seen that, it does not influence the opinion that you
20 are giving now?

21 A. With just a moment of -- that you put it on the screen,
22 no, it doesn't. I'll stand by what my reading of the patent
23 was.

24 Q. Okay.

25 So let's go ahead to some things that are still

1 left here, the prosecution history and the Telefunken
2 reference.

3 What I'm going to do, just for illustrative
4 purposes -- and obviously the record reflects that you don't
5 adopt this, at least not necessarily -- I'm going to put down
6 here in the corner a question. In claims, does predetermined
7 equal observable (writing on the chart), question mark.

8 And I emphasize that I am not suggesting for a
9 minute that you agree with that.

10 A. Okay.

11 And please understand that I'm giving you my
12 first impression of this, that I have not had an opportunity
13 to review this in the same light that you have. So I have to
14 go with my --

15 Q. I understand. That's clear --

16 A. -- impression.

17 Q. And I want it to be absolutely clear. No problem.

18 A. Okay.

19 Q. I mean, I want to bring that out, that you have not
20 considered this.

21 Let's go over now to the Telefunken reference.
22 Do you have that handy?

23 A. Yes.

24 Q. That's 9 and 9-A.

25 A. Yes.

1 MR. JENNER: Before I forget, your Honor, I would
2 like to mark for identification the first chart up here as
3 Plaintiff's 1063 as illustrative of the testimony.

4 THE COURT: All right.

5 *** (Plaintiff's Exhibit No. 1063 was marked for
6 identification.)

7 MR. JENNER: And mark as 1064, as illustrative of
8 the testimony, my attempt at set theory.

9 MR. McDONOUGH: I would just like to point out
10 for the record it's illustrative of counsel's questions to
11 their witness. It is not illustrative of the witness'
12 testimony.

13 THE COURT: Overruled.

14 MR. JENNER: Fine. Back and forth.

15 *** (Plaintiff's Exhibit No. 1064 was marked for
16 identification.)

17 BY MR. JENNER:

18 Q. Now, we've agreed, have we not, that the Telefunken
19 reference controls just one category of device; be it VCR's
20 or TV's or cable converters, it is going to control one
21 category of device?

22 A. Correct.

23 Q. And whatever else may be the case, it is an unclear
24 document. Isn't that also true?

25 A. It's difficult to read.

1 Q. It's not well written.

2 A. I think that's a fair statement.

3 Q. You testified yesterday that there are two ways that
4 you find in Telefunken to get into its search method; is
5 that right?

6 A. Correct.

7 Q. One of them, you press and hold some button.

8 A. Actually, that's to execute the search method. They
9 identified several ways of initiating the search method
10 also.

11 Q. Well, let me see if I can get that clear with your
12 help.

13 One of the ways that they identify to initiate
14 the search method -- I thought of that as getting into it.

15 A. Okay.

16 Claim 6 allows you to get into the search method,
17 as you say, by operating a key for a longer period than is
18 normally used, significantly longer than it's normally used.
19 So a key that has a first function can be used to execute
20 the -- or to begin the -- initiate the process by holding it
21 down for a much longer time.

22 Q. All right.

23 So that's like in some car radios I've seen,
24 where you might have Buttons 1, 2, 3, 4, 5, and 6 for
25 stations that are preset. But if you push and hold button

1 No. 2 for a long time, it will set another station?

2 A. Correct.

3 Q. So it's got another function if you hold it for a
4 while?

5 A. Correct.

6 Q. What's another way of getting into the search?

7 A. Claim 7 talks about operating a key, which is normally
8 operated only once, repeatedly in sequence, which is not
9 operated by another control element.

10 So, for instance, a key that might have a first
11 function that typically would only be used once, maybe if I
12 press it five times as an example, it commences the set-up
13 phase.

14 Q. What about Claim 8? Is that another way to do it?

15 A. Yes. Claim 8 also talks about having a specific set-up
16 key which is protected from an inadvertent operation.

17 Q. So that could be like an identify key?

18 A. Yes. Recessed or I think it does require it be
19 protected against inadvertent operation.

20 Q. There would be lots of ways to do that, wouldn't
21 there?

22 A. Yes.

23 Q. There would be the way that's described for a learning
24 remote, where it's recessed under the surface of a panel and
25 you have to get under there with a needle or something to

1 cause it to operate?

2 A. Yes.

3 Q. Or protected, I suppose you could have an identify
4 button under a plastic cover. So you would have to pull the
5 plastic cover up?

6 A. Correct.

7 Q. Lots of ways to do that.

8 So there are at least three ways rather than two
9 that are specified in the claims forgetting into the search
10 method?

11 A. For initiating.

12 Q. For initiating.

13 A. Right.

14 Q. You said there were a couple of ways to proceed through
15 the search method.

16 What are the ways specified to proceed through
17 the search method?

18 A. Claim 4 talks of a method by which, on operation of a
19 control element, the remote control transmits various
20 possible codes -- code words -- until the user indicates,
21 preferably by releasing the key, that the appropriate code
22 has been finished. So press a key, hold it, transmits words
23 until I release the key.

24 Q. All right.

25 And what is the other way?

1 A. Claim 5 talks of a method by which the same key is
2 pressed repeatedly, in each case transmitting another one of
3 the possible control words.

4 So one control word per key press.

5 Q. Let me ask you about the three ways of initiating.

6 One is to just take any old key that you
7 designate and press it and hold it for a longer period. That
8 will get you in? That's Claim 6?

9 A. Claim 6 does say yes, if I hold the key for a
10 significantly longer time than normal.

11 Q. Claim 7 says pick any old key, but press it some
12 number of times. That will get you in?

13 A. Yes.

14 Q. Claim 8 says pick a specific key and operate that
15 key?

16 A. Yes.

17 Q. I take it all three of them, then, perform the same
18 function of initiating the search routine?

19 A. The end result is the same, yes.

20 Q. I take it that one looking at the Telefunken patent
21 would conclude you can choose any one of those three ways
22 and you would be operating consistently with this patent?

23 A. You could -- if you chose any one of those three
24 specific ways, you would be covered by this patent. Yes.

25 Q. In which case someone would say, All right, then those

1 three ways are interchangeable for the purpose of getting me
2 into the initiation; correct?

3 A. They perhaps would be interchangeable in some aspects.
4 However, from terms of implementing them from technology
5 standpoint, they might not be. From advantages and
6 disadvantages of user interface --

7 Q. How you put them together is --

8 A. The end result is the same.

9 Q. Isn't Telefunken telling you that you can choose to do
10 it any one of those three ways?

11 A. Telefunken is teaching three methods to achieve the
12 same goal.

13 Q. And it's clear that the Telefunken reference doesn't
14 care which one of them you do. You can do any one of them
15 and it gets you initiated; correct?

16 A. All three will initiate the process.

17 Q. So they are interchangeable for purposes of initiating
18 the process?

19 A. In terms of it achieving that same goal --

20 Q. Yes.

21 A. -- it can be done by any of those three methods, yes.

22 Q. Okay.

23 And isn't it also correct that you can, from the
24 point of view of the Telefunken reference, you can then
25 proceed through the search, either by pressing and holding a

1 button down in the manner of Claim 4, or by repeatedly
2 pressing a key in the manner of Claim 5? You could do it
3 either way?

4 A. You can search the table either way.

5 Q. And the patent tells you that, for purposes of
6 searching, it's interchangeable whether you press and hold
7 the key down or whether you press and release a button a
8 number of times?

9 A. The patent is specific to say there they're two
10 different methods of accomplishing the end goal.

11 Q. The patent teaches you that they are interchangeable;
12 isn't that right?

13 A. I don't like the use of the word interchangeable,
14 probably because of my engineering background, because they
15 are not the same.

16 Q. I don't mean to suggest that the technicalities of
17 implementing them are the same.

18 A. Okay.

19 Q. My point is that the patent is teaching you that, as
20 far as executing the search of the patent is concerned, the
21 patent doesn't care whether you do it by holding down a
22 button or by repeatedly pressing the button. Either one is
23 okay in the patent.

24 A. The patent says your goal of locating the code can be
25 accomplished by two methods, yes, and both methods will

1 accomplish the goal.

2 Q. And either one of them can be used?

3 A. It doesn't specify one over the other.

4 Q. So anybody that has the Telefunken reference in about
5 1985 knows from the Telefunken reference it doesn't matter
6 which of three ways you use to get into the search, and it
7 doesn't matter which of two ways you use to perform the
8 search; isn't that right?

9 A. Well, again, from my background, I can't say that I
10 would conclude it doesn't matter. They teach different
11 methods of doing it.

12 Q. All right.

13 But they are all in the patent and you have the
14 choice of which to use?

15 A. That's correct.

16 Q. Okay.

17 Now let's talk about the differences between
18 Telefunken and the '359 patent as we work our way through
19 this confusing piece of paper.

20 A. Okay.

21 Q. I believe we've gotten established that Telefunken only
22 operates one category of device. That's right?

23 A. That's correct.

24 Again, the category, you mean --

25 Q. VCR's but not TV's.

1 A. Okay.

2 Q. And we also noted that Telefunken has this somewhat
3 curious search method where the operator does something until
4 there's a first observable action. Then the operator stops
5 doing anything, but the remote itself continues to go through
6 all the rest of the codes to look for a similar code
7 structure.

8 A. Yes.

9 Q. Now, the '359 patent is different from Telefunken in a
10 number of ways; correct?

11 A. There are several ways, yes.

12 Q. One way that it's different is that Telefunken, as
13 we've said, is limited to one category of devices like VCR's,
14 and the patented remotes specify more than one category of
15 devices. So that's one difference.

16 A. That's true. Though, in the '359 patent you do confuse
17 the issue of categories, because you state that it could be
18 multiple types of devices of the same type. For instance,
19 could be TV 1 and TV 2.

20 Q. But not in the claims. All the claims that we're
21 talking about specify more than one category.

22 A. The claims use the word category and you define the
23 word category within the body of the patent.

24 Q. And it's more than one category?

25 A. Requires multiple categories.

1 Q. Yes.

2 A. However, those are defined.

3 Q. Yes. That's my point.

4 A. Yes.

5 Q. And those are different in Telefunken?

6 A. Yes.

7 Q. Another difference that we have is by virtue of this
8 curious operation of the search method, Telefunken is going
9 to go through all the codes in its library and memory, even
10 when the user releases a button, if that's what he does,
11 whereas the patented remotes will stop going through the
12 library as soon as you do whatever you do to execute the
13 identify mode; correct?

14 A. That is probably correct.

15 Telefunken is not real clear. It is clear that
16 it does say it will locate the remaining devices that match.

17 Q. It's going to go through all the codes and look for
18 remaining matching devices.

19 A. However, if you stopped at that point and didn't do
20 anything else, it's implied that it will choose that first
21 device found. And that would be similar to '359. But --

22 Q. If it did that?

23 A. Yes.

24 Q. But the description in the written description that
25 follows the claim certainly explains, go through the whole

1 library, look at all the codes and find the ones that are
2 similar to the one you observed.

3 That's what it says in the written description;
4 right?

5 A. Correct. It doesn't necessarily say that you do
6 anything with that information.

7 Q. Right.

8 And that's part of the consequence of this being
9 a somewhat confusing document?

10 A. Agreed.

11 Q. So that's a second difference, that the description in
12 Telefunken is go through all the codes, even after you've
13 seen the observable action, the remote control is
14 automatically going to go through the rest of the codes and
15 the library search, but the remote codes covered by the
16 Philips patent do not do that. That's a second difference.

17 A. That's correct.

18 The first part of that is the same. They both go
19 through automatically looking for identifiable action.
20 Telefunken teaches some additional things to do once that's
21 located.

22 Q. Okay.

23 A. So that's the difference.

24 Q. So another difference which actually flows from the
25 second difference -- and this is even pointed out in the

1 papers -- is that in the remotes covered by the patent,
2 once you have finished with the search mode, use of the
3 remote control is partly governed by the selection of the
4 category signal.

5 A. I'm sorry. You referred to the patent but you didn't
6 say which one.

7 Q. The Philips patent.

8 A. Okay.

9 Now, let's back up. Ask the question again.

10 Q. Absolutely.

11 In the Philips patent, the remote controls,
12 subsequent operation of an appliance is under control in part
13 of a category command.

14 A. Certainly. That's the first element of Claim 1.

15 Q. Has to be.

16 A. Yes.

17 Q. It has to be. It's a universal control. If you don't
18 pick a category, it's not going to do anything.

19 A. Right.

20 Q. In the Telefunken, it doesn't.

21 A. Agreed.

22 Q. A fourth difference is that there is no requirement for
23 a predetermined action in the Telefunken reference, but there
24 is a requirement for some predetermined action in the Philips
25 patent?

1 A. Correct.

2 Q. So we have at least those four differences?

3 A. Correct.

4 Q. All right.

5 MR. JENNER: Your Honor, I'm going to launch into
6 something. If this is a good time for a break?

7 THE COURT: That's fine. I have a telephone
8 conference call at 10:30 and I'll be back, I hope, at 20 of
9 or as soon thereafter as I can.

10 (Short recess taken.)

11 - - -.

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1 (Court resumed after the recess.)

2 THE COURT: All right.

3 BY MR. JENNER:

4 Q. All right.

5 Mr. Cook, before the break, I had asked you about
6 various differences between the Telefunken reference and the
7 remotes covered by the Philips patent.

8 A. Correct.

9 Q. What I would now like to do is to focus on the
10 prosecution history and what the Philips attorney had to say
11 about that.

12 So could you find your copy, if you have it
13 there? And, if not, I'll get you one.

14 A. I have it.

15 Q. Of the prosecution history? I think you used
16 Defendant's 197. It's also Plaintiff's 293. And it doesn't
17 matter what you use.

18 A. I have 197 here.

19 Q. All right.

20 The key language that we have dealt with so much
21 appears on Page 11; correct?

22 A. Yes. There's a -- there's some significant language on
23 11.

24 Q. All right.

25 I'm going to focus on that. And, if you don't

1 mind, I'd just like to step in front of you and make sure
2 that what I think I am seeing is what you are seeing.

3 A. Okay.

4 I'm not seeing much of anything on that monitor.

5 Q. I am going to push the focus buttons. And please tell
6 me if I make it better or worse for you.

7 A. That's worse. A little better. Perhaps if you could
8 zoom, it would make it somewhat better.

9 Q. Well, if I zoom, I'm going to lose the text. Let's
10 just see how we go.

11 A. Okay. I can follow along here.

12 Q. If I can help you with portions, I'll do that.

13 Now, this is the portion of the -- of the
14 prosecution history where the attorney talked about new Claim
15 18. And that's what became Claim 1 of the patent; right?
16 The first method claim?

17 A. Correct. Correct.

18 Q. And in this, the attorney talks about how the patent
19 claim distinguishes from the German patent, and that's
20 Telefunken, in a number of important respects; right?

21 A. Correct.

22 Q. Okay.

23 Let's see what some of those are.

24 One of those respects is that, as she says in the
25 second sentence, the selected appliance is said to be one of

1 a plurality of appliances of different categories; correct?

2 A. Yes.

3 Q. That's talking about the Philips patent?

4 A. Correct.

5 THE COURT: You're on Page 11?

6 MR. JENNER: Yes, your Honor.

7 THE COURT: Of PX-293?

8 MR. JENNER: It's either Plaintiff's 293 or
9 Defendant's 197.

10 THE COURT: Okay. My problem is multiple Page
11 11's. Okay.

12 MR. JENNER: I have an extra copy of Page 11, if
13 it would help.

14 THE COURT: No. Okay. P-375.

15 MR. JENNER: That's the one.

16 BY MR. JENNER:

17 Q. All right.

18 Let me just highlight here. That's where the
19 attorney says the selected appliance in the Philips patent is
20 one of a plurality of appliances of different categories;
21 correct?

22 A. Yes.

23 Q. And, in fact, she later makes the same distinction down
24 here, where she says there's nothing in the German device
25 which allows selection of a category signal, since all the

1 control devices in the German patent are of the same
2 category.

3 A. Yes.

4 Q. So she has made the point Telefunken one category,
5 Philips patent, more than one category.

6 And then she makes a second point which seems to
7 flow from that, that because there's only one category in the
8 Telefunken reference, then there cannot be what she says
9 generation of subsequent appliance command signals under
10 control of at least, in part, of a selected category signal
11 because there is no such category signal in the German
12 device; correct?

13 A. Correct.

14 Q. Well, that's another distinction.

15 A. I think what she's saying here is that the Philips
16 device must have multiple categories. The German device has
17 only one.

18 Q. That's right. But insofar as there's another claim
19 limitation that requires in the patent that when you then go
20 on and operate the remote, it has to be at least in part
21 under control of a category signal?

22 A. The generated signal must be in part under control of
23 that category signal, yes.

24 Q. Otherwise you don't know whether you're in VCR or TV or
25 something else?

1 device will generate this code in the command of all the
2 manufacturers covered by -- until such time as you release
3 the button.

4 It's my interpretation of the German patent that
5 that further refinement process doesn't occur until a second
6 button is pressed, not as a result of a release of the first
7 button.

8 Q. But it's the process of elimination thing that we've
9 seen that sets it apart?

10 A. It's a refinement process. And I don't think that this
11 particular statement speaks to the refinement process. It
12 speaks to the fact that any of the keys are available to be
13 used to help determine the appropriate target device. The
14 code for the appropriate target device.

15 Q. Okay.

16 So this is another -- it's another thing that
17 flows from the difference of Telefunken being a one-category
18 device and the Philips patent being a multiple-category
19 device?

20 A. Well, I interpret it differently. I interpret it to be
21 a distinction between the two.

22 Q. All right.

23 A. But the distinction being that the German device can be
24 used to generate a number of different possible commands to
25 execute this function. And I again still read the '359

1 patent as being able to only generate one.

2 Q. Okay. I understand that's your position.

3 A. Okay.

4 Q. But, in any event, it's another distinction.

5 A. It is a distinction, that's correct.

6 Q. And we don't necessarily agree on precisely what it
7 is.

8 A. Well, I think if you take this paragraph, entire
9 paragraph together, it's very difficult not to come to my
10 conclusion.

11 Q. I obviously disagree with you. But that's all right.
12 I don't expect you're going to agree with everything I ask
13 you.

14 A. Okay.

15 Q. Now let's look at another one, because it's probably
16 the one where the word is, and it's of major significance.

17 A. Okay.

18 Q. She also says the selected appliance -- and that's
19 still got to mean the Philips patent; right?

20 A. Yes.

21 Q. The selected appliance is set to execute a
22 predetermined action upon receipt of the response-evoking
23 signal.

24 In the German patent, the selected appliance does
25 not have to be set to execute a predetermined action. Any

1 one of the control able actions will suffice. The German
2 device, since it is only for different manufacturers, and not
3 for different categories, allows the trial and error signals
4 response command signals to be available for every possible
5 command.

6 That's the base that has to do with
7 predetermined.

8 A. Okay.

9 Q. So she's saying in the German device, the response
10 command signals are available for every possible command.
11 And isn't she saying that, in the Philips patented remotes,
12 the response command signals are not available for every
13 possible command? That's the difference?

14 A. She -- it is a difference. And my interpretation is
15 she's saying that in the German device, the response command
16 signals are available for every one of the keys. And in the
17 Philips device, it is available for a specific predetermined
18 key.

19 Q. And you are saying it can only be one key?

20 A. That's my read of this, yes.

21 Q. Okay.

22 Now, I ask you to look at the pink highlighted
23 portion. And I ask you why that pink highlighted portion
24 doesn't simply mean that the selected key in the patent is
25 one of a group of keys, but not all the keys. A group

1 determined by the category button.

2 A. A group determined --

3 Q. Determined by the category button which is not
4 available to Telefunken.

5 Specifically, for example, the German -- the
6 Philips device in the patent, you can choose to push VCR.
7 That will make available to you the response command signals
8 for VCR, play, rewind, stop, pause. And any one of those
9 predetermined actions can be used, but no other actions. No
10 TV action, no cable converter action, as opposed to
11 Telefunken, where they are all available.

12 It is, again, another aspect of the Philips type
13 of universal control that, by selecting the category signal,
14 you make a group of predetermined actions available. It
15 could be five, it could be three, it could be one. And then
16 you are going to send one of them.

17 When you send one of them, it is a predetermined
18 action. But it doesn't have to be the only predetermined
19 action, because there are a group of them available for the
20 category.

21 Can't it mean that?

22 A. Well, again, we're going to have to choose to disagree,
23 because that's not my reading of that paragraph.

24 Q. I understand.

25 But do you acknowledge that my reading is a

1 possible reading of the pink language?

2 (Pause while witness reviews document.)

3 THE WITNESS: I -- I can't agree with that. As I
4 read this, I think -- I, again, come to my conclusion very
5 clearly. And I'm sorry, I can't agree with you.

6 BY MR. JENNER:

7 Q. You're not obligated to. That's all right.

8 A. Okay.

9 Q. Let's just put a couple of marks on here that will help
10 anyone in the future.

11 I am going to put a little note in the margin
12 adjacent to the pink that will say, the predetermined issue.
13 Fair?

14 A. Fair.

15 Q. Now, you would agree, would you not, that there's no
16 reason to believe that whoever wrote this was someone who was
17 using language with perfect precision, is there?

18 A. Please ask that again. I'm sorry?

19 Q. Yes. Let me elaborate.

20 Sometimes people try to interpret documents like
21 this. And, in doing it, they assume that whoever wrote
22 something was perfectly precise with language.

23 A. Are you saying that there are no mistakes in the
24 document? Are you saying that there are mistakes?

25 Q. I am suggesting to you that whoever wrote this document

1 was a human being and could well have been imprecise with
2 words.

3 A. Well, obviously, a human wrote it.

4 Q. That's a good starting point.

5 A. And humans are imprecise and do often make mistakes in
6 wording. And I'm not sure yet if you are trying to say
7 there's a mistake here or if they didn't use the wording that
8 you would have preferred or what.

9 Q. That will be my next question.

10 Is it fair to assume that whoever wrote this
11 might not have used language in this document, Page 3725, in
12 precisely the same way that somebody used it in the patent?

13 A. I suppose it's true, although I would think they would
14 have an obligation, because they're defining something to the
15 patent examiner who is making a ruling on this patent based
16 on their language.

17 Q. Well, that's my point. That's what we're coming to,
18 because I think people always try to make that assumption.
19 But in reality, human beings, especially writing things at
20 different times, don't necessarily use language with such
21 precision. Isn't that fair?

22 A. I think that's probably fair.

23 Q. Let's look at an example of that right on this page.

24 Look up here in the blue. It talks about the
25 selected appliance is said to be one of a plurality. That's

1 going to be one of the appliances we're trying to set, like a
2 TV; right?

3 A. Right.

4 Q. So I'm going to put a circle around appliance. And
5 I'll put the word appliance out here equals TV, for example.
6 And on the next line there's a plurality of appliances.
7 That's still the TV's; right? Or VCR's, but it's still a
8 device to be set?

9 A. Yes.

10 Q. Still a TV. The next line, the selected appliance is
11 set to execute.

12 That's still the TV; right?

13 A. Correct.

14 Q. And about three lines down further it says, in the
15 German patent, the selected appliance does not have to be
16 set to do something. That's the TV again, or VCR?

17 A. Correct. What I call the target device.

18 Q. Target device. Okay.

19 I don't see any other occurrence in this
20 paragraph of the word appliance, do you?

21 A. No.

22 Q. Now let's look at another word. Down around here,
23 where I'm pointing, it starts to talk about the German
24 device. You just spoke of a target device as being the
25 appliance. And that probably illustrates the point, too,

1 because here, when she uses the word device, she's not
2 talking about the target at all. She's talking about the
3 remote, isn't she?

4 A. Certainly.

5 Q. So the German device is the remote. Device equals
6 remote.

7 A. German device equals remote.

8 Q. Yes.

9 And then she goes on for another few lines, no
10 matter which command is selected by the user, the German
11 device will generate something.

12 That's still the remote?

13 A. Correct.

14 Q. Then a couple of lines further down, she talks about
15 the difficulty in setting the device to be receptive. But
16 here, when she uses the word device, it's not the remote
17 control, it's the appliance, isn't it? It's the TV?

18 A. I'm sorry. Where are we at?

19 Q. The difficulty in setting the device. If one uses
20 words consistently, that would have to be the remote control,
21 but in the context of that sentence, it can't be remote
22 control, can it? It's got to be the target?

23 A. In this particular case, it's the target. She's used
24 German device to indicate remote and then she used the
25 generic word device I think here to represent the television

1 VCR.

2 Q. So she's actually used the same word on this page in
3 two different ways?

4 A. Well, I don't think it's completely the same word,
5 because everywhere she referred to the remote, she attached
6 the adjective German. So I think that's the distinction.

7 Q. Okay.

8 So the German device is the remote, but the
9 device by itself is the appliance and, therefore, everybody
10 would understand the distinction? That she intended to do it
11 that way?

12 A. Whether she intended or not I can't say. But it's
13 pretty clear, I think.

14 Q. Okay.

15 So we have -- the word device is kind of a half
16 horse, half rabbit, in that in this particular instance, it
17 means the appliance.

18 A. It's -- the generic word device can refer to a number
19 of things unless it has some adjective or some other way to
20 be more descriptive, either through, as I said, an attached
21 adjective or using it as -- I'm not sure of the proper
22 English, but, you know, English phrase, but a replacement for
23 something we've previously defined.

24 Q. All right.

25 So this human being, in any event, used the same

1 word in two different ways, and maybe it's because in one
2 instance it had the word German in front of it.

3 A. Okay.

4 Q. So I'm going to put sort of half red and half green,
5 but the point of it being that here the device equals
6 appliance.

7 A. I'm uncomfortable with the notations you're making
8 because I draw the distinction of, in the first case, German
9 device equals remote control.

10 Q. I'll put the word German in front of it.

11 A. Thank you.

12 Q. I have no problem with it.

13 A. Thank you.

14 Q. Sure.

15 Up here --

16 A. Yes?

17 Q. -- where I'm pointing, German device equals remote
18 control.

19 A. Okay.

20 Q. Okay.

21 Now, when you find that the word device, the
22 green/red device means the appliance, doesn't that lead to
23 some further difficulty in the language because now that we
24 know that that is referring to the TV, is there a distinction
25 there?

1 Let me read this to you with the word TV
2 inserted.

3 A. Okay.

4 Q. The difficulty in setting the TV to be receptive to the
5 particular command is minimal. In many cases, simply turning
6 on the power is sufficient.

7 Isn't that true for both the Telefunken reference
8 and the patent?

9 A. Okay. Isn't what specifically true?

10 Q. Isn't the statement that she made in those two
11 sentences --

12 A. And tell me again.

13 Q. -- about the difficulty being minimal, once you
14 understand the device there is the TV, the statement really
15 is true for both of them. In Telefunken, in many cases
16 simply turning on the power has to be sufficient. Every
17 command on the remote is going to work.

18 A. Yes.

19 Q. And the same is true for Philips, isn't it?

20 A. Yes. I think I see your point.

21 You're saying that in both cases, the --
22 actually, I guess this is saying in the Philips case, because
23 this is talking about the fact that it's an inventive step
24 that's talking about the Philips, and then the difficulty in
25 setting the device to be receptive to a particular command is

1 minimal.

2 I think that's referring specifically to the
3 Philips case.

4 Q. But it's also true for Telefunken on that particular
5 point? The difficulty --

6 A. How do you relate that?

7 Q. The difficulty of setting the Telefunken TV to be
8 receptive to a particular command is also minimal. Just turn
9 the TV on.

10 A. No, I don't agree. The -- if you back up and look at
11 the order that she's going through to contrast things, she
12 says, then, it's already an inventive step to consider that
13 it's not essential referring to this, the capability, be
14 available. The difficulty in setting the device to be
15 receptive to a particular command is minimal.

16 She's saying that with the Philips method, it's a
17 contrast to the Telefunken method.

18 Q. I agree that that is what she's saying. Tell me how
19 it's harder to set a TV to be responsive to the Telefunken
20 remote than it is to the Philips remote.

21 A. So you're -- okay.

22 You're asking me if I would -- in the case if I
23 had a Telefunken remote, would I have more difficulty in
24 setting up a television set?

25 Q. To be responsive to the Telefunken remote. Just turn

1 the TV on.

2 A. Well, I don't have a Telefunken remote and I don't know
3 that I know that that is the case. But I think she has used
4 it here to draw a distinction, saying it's easier in the
5 Philips case.

6 Q. I know that she has said that.

7 A. And you are now trying to counter that and say it's not
8 true?

9 Q. I'm trying to say that this points up the difficulty in
10 trying to put too much into these words, as I believe that
11 UEI has done.

12 A. All right.

13 Q. That the people who wrote this did the best they could
14 with imperfect use of language. That the real point that is
15 being tried to get across here is simply that everything
16 flows from Telefunken being a one-category device and Philips
17 is not.

18 A. And I read this as being a very clear contrast, where
19 she's saying there's an advantage over your method over the
20 Telefunken method, and as far as imprecise use of English, my
21 past experience in all these types of things is they're
22 reviewed by a number of people and must be. And so I have to
23 assume that they are accurate.

24 There's a responsibility within the organization
25 that I'm in to make sure these types of things are reviewed.

1 Q. Okay.

2 Let's -- before I lose track of it --

3 MR. JENNER: Your Honor, I would like to mark
4 this piece of paper as -- can I use 293-A?

5 (Pause.)

6 MR. JENNER: 293-A, and offer it as illustrative
7 of the testimony.

8 THE COURT: All right.

9 MR. McDONOUGH: I have no objection, your Honor.

10 *** (Plaintiff's Exhibit No. 293-A was marked for
11 identification and received into evidence.)

12 THE COURT: Can I ask a question --

13 MR. JENNER: Sure.

14 THE COURT: -- Of this witness. And actually you
15 can answer it.

16 If Telefunken came to you and said, We want to
17 manufacture a remote or remotes that implement the invention
18 described in the patent, is it correct that you could take
19 that invention and make a remote that simply has the button
20 keys on it for a television, and then take that invention and
21 make another remote that simply has the button keys on it for
22 a VCR?

23 And so that if Telefunken wanted to market remote
24 controls described by its invention, you'd go to Radio Shack
25 and you could see the Telefunken TV, Telefunken VCR?

1 THE WITNESS: That's exactly my reading of the
2 Telefunken patent, yes.

3 THE COURT: Do you read Telefunken as saying that
4 you could have a TV only, a VCR only, and a remote that would
5 have two sets of buttons on it? One titled TV and one titled
6 VCR?

7 THE WITNESS: The Telefunken, I think, is fairly
8 directed towards individual types of remotes. And I don't
9 see the language that says you could do that specifically.

10 THE COURT: All right.

11 And so the consumer that has the Telefunken TV
12 remote that they are setting might push channel up, might
13 push volume, might push, I guess, return to prior channel,
14 one of those buttons to get a response from the targeted
15 unit?

16 THE WITNESS: Right.

17 THE COURT: Okay.

18 MR. JENNER: And that really is our point about
19 that, your Honor, that that is what Telefunken teaches.
20 That's all that Telefunken teaches. That you are either
21 going to have what winds up being a replacement TV remote or
22 replacement VCR remote. That Telefunken missed the boat on a
23 more universal control, and that that is what the Patent
24 Office determined.

25 And that's, I guess, what we would say about that

1 for now.

2 THE COURT: Yes. As to the obviousness --

3 MR. JENNER: Yes.

4 THE COURT: -- issue, I understand that there is
5 a move to say don't just get a replacement remote, let's get
6 one machine or one unit that has all the buttons. I was more
7 focusing on, in the Telefunken situation, whether the
8 consumer is making a choice about which buttons to push.

9 MR. JENNER: Oh, right.

10 THE COURT: And labeling for VCR's this, the TV
11 for that. And it's not.

12 MR. JENNER: It's not.

13 THE COURT: As they are programming it for the
14 Telefunken, they've got the buttons are already labeled
15 because there's not going to be any choice among them.
16 They've got a limited number of buttons to choose from.
17 And the person using Telefunken may use volume, may use
18 channel up.

19 But there's not going to be a whole lot of other
20 choice for them. There may be more for the VCR, but there's
21 not going to be choices for buttons on the VCR when you do
22 anything different than what was normally done --

23 MR. JENNER: Exactly. Exactly. And that's what
24 I want to pursue.

25 MR. JENNER: We probably also ought to offer the

1 color-coded patent copy as 217-A. And we'll provide --

2 BY MR. JENNER:

3 Q. Did you make marks on that?

4 A. Yes, I did.

5 MR. JENNER: Your Honor, for record-keeping
6 purposes, we'll provide a color copy with just the color
7 code, call it 217-A, and we should mark the witness' copy
8 with the marks on it as 217-B, if that's all right.

9 THE COURT: All right.

10 MR. McDONOUGH: I have no objection to that.

11 *** (Plaintiff's Exhibits No. 217-A and 217-B were
12 marked for identification.)

13 BY MR. JENNER:

14 Q. Let me ask you some things.

15 A. That's why I'm here.

16 Q. I have a group of letters, A, B, C, D. And I could
17 choose from that group of letters any letter; correct?
18 Arbitrarily?

19 A. Certainly.

20 Q. All right.

21 So I will choose the letter B. Now I have two
22 groups of letters. And I can say as to the green group, I
23 can choose any green letter. I still like B. I could do
24 that.

25 And in the red group, I can choose any red

1 letter. And I can choose D, can't I?

2 A. Okay.

3 Q. Now, let me take my two groups of letters again. And
4 now I'm going to predetermine that only red letters can be
5 chosen.

6 Are you with me so far?

7 A. Okay.

8 (Pause.)

9 BY MR. JENNER:

10 Q. But, with that, I will say any red letter is still
11 okay.

12 So now I will choose my D. And under that
13 assumption, D is a predetermined letter; correct?

14 A. Correct.

15 Q. Now I can go one step farther than that. And you'll
16 have to bear with me for a minute while I do my thing here.

17 I am going to change the green letters like so
18 (indicating). And I'm going to give them names, so that
19 instead of A, B, C, D, they're now called rewind, play, stop
20 and record. And I'll associate with them something that's
21 called the VCR button.

22 A. Okay.

23 Q. Then I'm going to re-name the red ones, too, so that
24 they now have the names channel up now and volume up
25 and down. And I'll associate with them a button that I

1 call TV.

2 A. Understand.

3 Q. Are you with me so far?

4 A. So far.

5 Q. Now I'm going to select the VCR button. And by doing
6 that, I can predetermine that only the VCR codes will evoke a
7 response, can't I? I can choose to do that?

8 A. Okay.

9 Q. So I'll say select VCR. I can predetermine only VCR
10 codes will evoke response.

11 So now B is play. So play is a predetermined --
12 choosing play is a predetermined action under this scenario;
13 correct?

14 A. You've chosen it, and before whatever we're doing, so
15 it's predetermined.

16 Q. Right. Okay.

17 But given what I have asked you to assume, D up
18 here (indicating) is not the only predetermined letter. By
19 choosing red, I have predetermined that I could choose A, B,
20 C or D as well; correct?

21 A. You're confusing me with points of time in doing
22 predetermination. But, yes, you can choose a group and then
23 you can choose a sub-group sometime beforehand.

24 Q. So under that circumstance, D is not the only
25 predetermined letter of this hypothetical; correct?

1 A. Correct.

2 Q. So I write under this, but not the only predetermined
3 letter.

4 A. Attach different meanings to predetermine, but by
5 referencing different points in time.

6 Q. And under this same hypothetical, in choosing play as a
7 predetermined action, it's not the only predetermined action,
8 because rewind, stop and recrd are other predetermined
9 actions by having pushed the VCR button; correct?

10 A. Those are other possible predetermined actions that you
11 could choose.

12 Q. But it is not the only predetermined action.

13 A. The words I said, not the only possible predetermined
14 action.

15 Q. I agree.

16 So I ask you, sir, isn't that what was meant on
17 Page 11 of the prosecution history, in terms of predetermined
18 action? That, in the case of Telefunken, all of the commands
19 are available because there is no category button. This, in
20 essence, is Telefunken, VCR buttons (indicating), whereas in
21 the Philips, there are groups of predetermined actions,
22 depending upon what category you select (indicating), and you
23 choose one of those to be a predetermined action?

24 A. May I re-read this section, please?

25 Q. Sure.

1 A. Thank you.

2 (Pause while witness reviews document.)

3 THE WITNESS: So what you are saying is that your
4 read of this is that when it's talked about executing a
5 predetermined action, that is one of a possible group of
6 predeterminable actions, possible --

7 BY MR. JENNER:

8 Q. It means what's on this chart. That's all she was
9 signifying. In fact, that's all that's necessary. That's
10 what distinguishes Philips' universal controls of the patent
11 from Telefunken as a consequence of there being category
12 buttons. Isn't that what that means?

13 (Pause while witness reviews document.)

14 THE WITNESS: I think I'm beginning to understand
15 your argument, but I don't still agree that the flavor of
16 this paragraph addresses this issue. I still, when I read
17 this paragraph, attach the meanings to the word predetermined
18 action to be a single chosen command.

19 BY MR. JENNER:

20 Q. But you don't agree that it is a single chosen command
21 from a group which is selected by the category button?

22 A. I agree -- I agree that there are possible choices that
23 can be made of things that generate observable actions.
24 Okay? But this still applies to me, that this is chosen
25 ahead of time.

1 Q. And it's still your position that that is what it has
2 to mean?

3 A. That's my position that that is what I read it as.

4 Q. Okay.

5 MR. JENNER: Your Honor, I should mark this for
6 identification as Plaintiff's 1065.

7 THE COURT: All right.

8 MR. McDONOUGH: I have no objection.

9 *** (Plaintiff's Exhibit No. 1065 was marked for
10 identification.)

11 BY MR. JENNER:

12 Q. Now, UEI's remotes, like the Philips remotes of the
13 patent, the ones that are accused here, have a plurality of
14 categories that they can operate?

15 A. Correct.

16 Q. They are different from Telefunken that way?

17 A. Okay.

18 Q. So that way they're like the Philips patented remotes,
19 not like Telefunken?

20 A. Both Philips and UEI have category -- categories of
21 devices that can be controlled.

22 Q. Okay.

23 And another way that they are different is that
24 neither the UEI remotes nor the Philips patent remotes
25 perform this search technique of Telefunken, where the user

1 operates the remote until you get a response and then the
2 remote goes on by itself and looks for similar code
3 structures.

4 Neither UEI nor Philips does that; correct?

5 A. Can we turn to that section in the German patent and
6 review that?

7 Q. I don't know which one you have in mind.

8 A. Okay. It's --

9 Q. Oh, in the patent. The text, Pages 6 and 7 of the
10 specification?

11 A. No. The claims of the patent.

12 Q. Well, let me call you to what I'm referring to.

13 A. Would you, please?

14 Q. Yes. Turn over into the specification. I don't know
15 what the Germans would call that. It's the part after the
16 claims where the numbering starts over and it's on Pages 6
17 and 7 that Mr. Smith testified about, where it explains how,
18 in this example, when you push the play button, it goes on
19 until you find a response which in this case, I guess, was H
20 play. And then, as it says at the bottom of Page 6, it goes
21 on to resolve ambiguities by looking for anything else that
22 has a similar structure than -- as H play.

23 Do you see that generally toward the bottom of
24 Page 6?

25 A. I think so, yes.

1 Q. So that's something that the Telefunken remote has
2 described is doing. The user ends his involvement when he
3 sees a response, but the remote control continues on through
4 the rest of the codes, looking for a similar code to the one
5 that evoked the response?

6 A. Well, again, we come to this patent being somewhat
7 unclear, because if you go to the specific claim that
8 addresses that type of action -- and let me read from Claim
9 4 and interpret it as I do.

10 The remote controller -- let's make this -- is it
11 4?

12 Yes. The remote controller as claimed in Claim
13 3, where in the setting up phase and on operation of control
14 element 2 -- that's a key -- on the remote control, the code
15 determination circuit -- the microprocessor -- transmits
16 various possible code words into the apparatus to be
17 controlled until the user indicates, preferably by releasing
18 the control element, releasing the key, or by operating and
19 acknowledging the control element, pressing another key, that
20 the desired function has been initiated by the control word
21 transmitted last.

22 In the code determination circuit then continues
23 the corresponding process on operation of other control
24 elements until the valid control words determine this way
25 logically and unambiguously identify the complete control

1 word of the respective apparatus to be controlled from the
2 set of all codes stored in the remote controller. The claim
3 requires that another key be pressed for that further
4 refinement process to operate.

5 Q. Don't you understand that to be referring to the
6 process in the specification of the remote going on by itself
7 and looking for similar codes after the user stops?

8 A. I see in the specification where it discusses the
9 remote continuing the process. I see in the claim where it
10 requires pressing another key for that to happen. So there's
11 some discrepancy.

12 Q. Well, don't you understand the claim to be referring to
13 the process of the remote going on by itself?

14 A. Once initiated by the user pressing another key, yes.

15 Q. What about when the user releases the key as in the
16 specification? Doesn't the claim then also involve the
17 remote going on by itself?

18 A. No.

19 Q. You don't find that because of the specification?

20 A. I say the specifications in the claim disagree in their
21 description of the operation here.

22 Q. Well, then, let me ask you this question, sir:

23 Why is it that in giving your opinions about the
24 Philips patent, you have found that the claims are limited by
25 the preferred embodiment of the specification, but when you

1 talk about the Telefunken reference, you choose to find the
2 claims are different from the specification?

3 A. Because in the Telefunken reference, the -- the two --
4 one is not a limiting case. It's describing something that's
5 the opposite case.

6 Q. So you find that the patent is a limiting case, but the
7 Telefunken reference is not a limiting case?

8 A. The Telefunken reference, the interpretation in the --
9 let me find this. One second.

10 (Pause.)

11 THE WITNESS: See if I can be more explicit.

12 BY MR. JENNER:

13 Q. Actually, I just want to understand that you are making
14 the distinction that in the case of the patent, it's your
15 conclusion that the specification is a limiting case, but you
16 also conclude in the case of Telefunken that the
17 specification is not a limiting case.

18 Is that basically where it comes out?

19 A. No, I don't think so.

20 Let's try to go through this in more detail, if
21 you will. Can you take me back to the page again that we
22 were looking at?

23 Q. Yes.

24 A. I'm sorry. I lost it.

25 Q. Okay.

1 Pages 5, 6 and 7 of the specification generally
2 are a lengthy discussion about how the Telefunken reference
3 continues after the user is -- has let go because he saw a
4 response of how the remote control continues to search for
5 similar code structures. And we've established that that is
6 in there; right?

7 A. Yes.

8 Q. And you find in Claim -- what was it, 4?

9 A. Yes.

10 Q. You think that that just involves the process of
11 searching until and only until the user lets go of the
12 button? And I'm content -- if you say that's the way you
13 understand the claim, I'm just content to have you tell me
14 that's how you understand the claim. That's all I want.

15 (Pause while witness reviews document.)

16 THE WITNESS: In this case, the description
17 specification does seem to define that claim somewhat
18 differently than what the phrasing of the claim would say.

19 Given that this is a translation, and we've
20 already seen, I think before, that some of the translations
21 can be very different in German, I am not sure how to
22 address that.

23 I do believe that -- that from reading the
24 specification, that their intent isn't reflected well in the
25 claim.

1 Q. Okay.

2 Is it right, sir, that Scientific Atlanta has a
3 customer, Time Warner?

4 A. Yes.

5 Q. And that Time Warner wanted remotes from Scientific
6 Atlanta that included the search feature?

7 A. Time Warner did not specifically ask for the search
8 feature.

9 Time Warner asked for remote control with a
10 complete set of features.

11 Q. Full features?

12 A. Full-featured.

13 Q. And they wanted the remote that included the search
14 feature. They specified that?

15 A. I don't recall whether they specified specifically the
16 search feature. They did specify they wanted it
17 full-featured.

18 Q. And that's what you are selling?

19 A. Yes.

20 MR. JENNER: Okay. I have no further questions,
21 your Honor.

22 THE COURT: All right.

23 (Pause.)

24 MR. JENNER: Before counsel starts, perhaps if we
25 could just make life simpler if we mark the copy of the

1 color-coded exhibit with 217-B.

2 THE COURT: All right.

3 *** (Plaintiff's Exhibit No. 217-B was marked for
4 identification.)

5 MR. JENNER: And there's another one that we have
6 for A? 217-A?

7 REDIRECT EXAMINATION

8 BY MR. McDONOUGH:

9 Q. Mr. Cook, could we, again, just to back up a bit, just
10 give me your brief understanding of what the invention is of
11 the '359 patent?

12 A. My understanding of the '359 patent is that it
13 describes a method for searching a table of codes in a
14 universal remote control that includes categories; in doing
15 so, in a process that requires minimal user intervention.
16 It describes a method of doing that by transmitting
17 automatically a sequence of codes for a user initiating
18 that search process. And that sequence of codes is a
19 fixed code function transmitted into different formats
20 repeatedly.

21 Q. And could you give me a brief explanation of your
22 understanding of the Telefunken reference?

23 A. Telefunken defines a universal remote control of a
24 given device type, without a category signal, that has a
25 search function that allows it to search, either in its

1 automated process or in a manual process, and it also teaches
2 a method of refining further the code that you've chosen for
3 your target device.

4 Q. Okay.

5 Now, on cross-examination, counsel for Philips
6 showed you a series of patents.

7 Do you remember that --

8 A. Yes.

9 Q. -- yesterday and this morning?

10 Do you have a copy of those patents in front of
11 you?

12 A. I think so, yes.

13 (Pause.)

14 THE WITNESS: Okay.

15 BY MR. McDONOUGH:

16 Q. Okay.

17 I draw your attention, first, to the Kozaki
18 (phonetic) patent, which I believe is Defendant's Exhibit No.
19 170, Patent No. '274.

20 A. Okay.

21 Q. And would you just read the first clause of the first
22 sentence of the abstract?

23 A. First clause of the first sentence of the abstract?

24 Q. Yes.

25 A. A single hand-held remote control unit produces

1 command signals used to control all operational aspects of a
2 videotape recorder and associated television receiver and
3 the videotape recorder and television receiver includes
4 switches that --

5 Q. That's far enough.

6 A. Okay.

7 Q. I just wanted the first clause there.

8 A. Okay.

9 Q. Does that teach to you the benefit of having a remote
10 control having multiple categories?

11 MR. JENNER: Objection. Leading.

12 MR. McDONOUGH: Let me ask --

13 THE COURT: I don't mind him leading and then
14 just have him responding why. Get a yes or no and then you
15 can say why, if that is what you would like.

16 MR. McDONOUGH: Does --

17 THE COURT: You can go back and try a again.

18 MR. McDONOUGH: That's fine. Actually, maybe I
19 can just ask the question.

20 BY MR. McDONOUGH:

21 Q. What does that teach you, or what is your
22 understanding on the basis of that sentence, that language
23 you read?

24 A. That they're describing a remote control that will
25 control multiple device types.

1 Q. And by device types, you mean --

2 A. TV and VCR.

3 Q. Okay.

4 A. Multiple categories.

5 Q. Now, if you could turn to the Welles patent, which is
6 Exhibit 258... Patent No. 4,623,887.

7 A. Yes.

8 (Pause.)

9 BY MR. McDONOUGH:

10 Q. And I believe counsel directed your attention to, in
11 Column 1, the first paragraph under background of the
12 invention?

13 And if you could just read that paragraph to
14 yourself... You don't have to read it out loud. It's the
15 one that starts on Line 24 of Column 1.

16 A. Okay. I've read it.

17 Q. And if you could read out loud, then, the last sentence
18 of that paragraph...

19 A. "It's therefore desirable to provide
20 a single remote control transmitter
21 for controlling each of several
22 products."

23 Q. And what does that paragraph and that language you've
24 just read teach to you or mean to you?

25 A. That it's desirable to have a remote control that will

1 control, as they say in this paragraph, televisions, cable
2 converters, video cassette recorders and video disk players.
3 They're teaching that they want one remote control to control
4 multiple devices. Multiple device types.

5 Q. Okay.

6 If you could turn to Exhibit 266, the Harger
7 patent... Patent No. 4,566,034.

8 A. Yes.

9 Q. And if you could turn to Column 1, the first
10 paragraph... It's Lines 6 through 11.

11 And if you could read that out loud for the
12 Court, please...

13 A. Column 1, 6 through 11?

14 Q. Yes.

15 The first paragraph in the patent.

16 A. "The present invention concerns
17 arrangement which can be used in
18 the manufacture of individual
19 remote control transmitters for
20 controlling a television receiver,
21 a videotape recorder or a video
22 disk player or, in a single
23 unified remote control transmitter
24 for controlling the devices."

25 Q. And would you tell the Court what that language means

1 to you?

2 A. Again, they are talking about one remote control to
3 control multiple devices of different device types, the
4 advantage of that.

5 Q. Okay.

6 And then the patent that was introduced this
7 morning, it's Exhibit D-177. The Zato patent, assigned
8 Zenith Patent No. '247?

9 A. Yes.

10 Q. If you could turn to Column 1, Lines 32 through 34, the
11 sentence that starts out -- let me just read it so it's
12 clear.

13 The sentence that is:

14 "The desirability of remotely
15 controlling several home entertainment
16 devices by means of a single control
17 panel is obvious."

18 Can you tell me what that language means to
19 you?

20 A. It's, again, stating that they are in recognition
21 of the fact that it's desirable to have one remote
22 control that will control multiple products, multiple
23 categories.

24 Q. Okay.

25 And if you turn to the face of the Zato

1 patent, would you confirm that that was filed on April
2 12th, 1982?

3 A. Indeed, it was.

4 Q. And would you turn to the -- around that same first
5 page, in the references cited, do you see any reference
6 to the Telefunken patent that we've been discussing
7 before?

8 A. I don't see a reference to Telefunken. There is a
9 reference to the German patent, but I don't think that's
10 the same number.

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2 Q. The Telefunken number is DE3313493.

3

4 So the Telefunken patent wasn't considered by the
5 patent examiner when the Zato patent issued?

6

7 A. That's what it appears from the cover of the patent,
8 yes.

9

10 Q. Would you turn to Exhibit No. 170, the Kozaki patent,
11 again?

12

13 A. Yes.

14 Q. Would you again confirm the filing date of that patent
15 is February 14, 1983?

16

17 A. Yes.

18

19 Q. The issue date was July 2nd, 1985?

20

21 A. Correct.

22

23 Q. Do you see any reference in that patent to the
24 Telefunken patent?

25

26 A. No.

27

28 Q. So the Telefunken patent wasn't considered by the patent
29 examiner in considering this application; correct?

30

31 A. Not according to the face of the patent, no.

32

33 Q. The Welles patent, Exhibit No. 258, would you confirm
34 the filing date of that as May 15th, 1984?

35

36 A. Correct.

37

38 Q. The date the patent issued is November 18th, 1986?

39

40 A. Correct.

1 Q. Do you see any reference to the Telefunken patent on the
2 face of this patent?

3 A. No.

4 Q. Is it your understanding that Telefunken was not
5 considered by the patent examiner when reviewing this patent?

6 A. That would be my understanding.

7 Q. The last one I want to draw your attention to is the
8 Harger Exhibit 266.

9 Would you confirm the filing date of May 2nd,
10 1983?

11 A. Correct.

12 Q. And the issue date is January 21, 1986?

13 A. Yes.

14 Q. Is the Telefunken reference shown anywhere on the face
15 of this patent?

16 A. No, it's not.

17 Q. So you assume that the Telefunken reference was not
18 available to the examiner in considering this patent?

19 A. That's what I would assume, yes.

20 Q. Are you aware of the requirement of an inventor to
21 disclose any prior art that they are aware of to the Patent
22 Office when they are prosecuting an application?

23 A. Yes.

24 Q. Do you have any understanding -- strike that question.

25 Now, would you please turn to the patent in suit,

1 which is the first exhibit in your book, the '359 patent?

2 A. Okay.

3 Q. And the filing date of that patent is November 20th,
4 1985; correct?

5 A. Yes.

6 Q. The issue date is October 27, 1987?

7 A. That's correct.

8 Q. I see there is a reference to Telefunken on the face of
9 this patent.

10 A. Yes, there is.

11 It is interesting to note that that filing date
12 is about a year and a half after they testified they reduced
13 this to practice.

14 Q. Would you turn to Claim 3 again of the '359 patent, the
15 patent in suit?

16 A. Claim 3, okay.

17 Q. Counsel asked you questions if it was technically
18 possible to add a dial -- let me back up first.

19 Claim 3 references:

20 "Transmitting each of said
21 plurality of response command signals
22 a predetermined number of times."

23 Could you explain again what your understanding
24 of a response command signal is?

25 A. A response command signal is a signal that -- it is the

1 command that is transmitted in many different formats to the
2 target device. It's an appliance command, a single function
3 transmitted in many different formats.

4 Q. And I believe counsel asked you if it was technically
5 possible to add a dial to a remote control to let the user
6 change the number of times the response command signal would
7 be sent?

8 A. Correct.

9 Q. Would a user of a remote control ever need to change the
10 number of times the response command signal is sent to
11 operate the invention of the '359 patent?

12 A. No.

13 Q. Would such a device -- would such a remote control even
14 be a feasible device to market?

15 A. I can imagine how you build one, but I'm not sure why
16 you would ever want to build one.

17 Q. Now, going to Claim 4, it talks about "Transmitting for
18 a predetermined intercommand delay time."

19 Could you please explain again what the
20 intercommand delay time is in accordance with the '359
21 patent?

22 A. The intercommand delay time is the time the remote
23 control waits between transmitting this response command
24 signal a number of times, whichever particular format it's
25 on, and repeats that. And the intercommand delay time is the

1 time it waits between the repetitions of transmission.

2 Q. Would the user of a remote control ever have any need to
3 change the intercommand delay time?

4 A. I can't imagine that they would want to.

5 Q. Would you as a designer of remote controls want the user
6 to be changing the intercommand delay time?

7 A. No. I can think of a lot of reasons why you would not
8 want to.

9 Q. What would some of those reasons be?

10 A. If it's made too short, what is going to happen is they
11 are not going to have time to respond.

12 Actually, I think I misspoke here. Let me look
13 at something for one second.

14 Actually, I think if the time between the
15 formatted signals moving to the next formatting question.
16 The intent here is to give the user time to respond if it is
17 a proper command. And if that's made too short, then the
18 user will not have adequate time to respond and the unit will
19 have moved on to another code.

20 If it's made too long, then the whole process
21 will become very slow and cumbersome for the user.

22 Q. Would a remote control having a user-controllable
23 intercommand delay time ever be a marketable device?

24 A. In my opinion, you would never want to put that kind of
25 thing in a consumer's hands, too much flexibility. They will

1 probably not be able to operate it.

2 Q. Would it make any sense to manufacture such a product?

3 A. No.

4 Q. I would like to draw your attention to the color-coded
5 patent again that you were shown. What I am going to be
6 referring to is Column 7 at Line 41, the section immediately
7 after the yellow highlighting.

8 I would like you to just read the language I'm
9 referring to where it says:

10 "The method and apparatus of
11 the present invention, as described
12 above, allow a light, hand-held
13 remote control unit to 'identify'
14 which of a number of signal structures
15 stored in its memory is appropriate
16 for a given device to be controlled."

17 Now, my question is, we talked about the chart
18 before, the circle showing claims and the other circle inside
19 it as showing the scope of -- actually, the larger circle
20 being the scope of the invention and the circle, the small
21 circle inside being the scope of the claims.

22 Is there anything in this patent that you can
23 identify, any language that you can point to that shows --
24 that teaches you an embodiment of the patent that is broader
25 than what is set forth in the claims?

1 A. No.

2 Q. If you would look at the language below that's
3 highlighted pink on your copy...

4 A. Yes.

5 Q. I think you referred to that as boilerplate language?

6 A. I've seen it many, many times, essentially the same
7 wording, in patents.

8 Q. As an engineer practicing in this field, does that type
9 of language mean anything to you?

10 A. I think that everything in a patent has meaning, and you
11 have to pay attention to all the phraseology. Usually what
12 that means is that they have in mind some other method that
13 they would have implemented the procedure, and oftentimes in
14 patents more than one method or embodiment is discussed or
15 some suggestions made in an attempt to broaden up the
16 patent.

17 In this particular case, even though they say
18 this, I don't see anything else that indicates any other
19 method of implementation or interpretation.

20 So this would key me to try to find something
21 else in the patent that might suggest another implementation.
22 Even though I call it boilerplate, I do believe everything
23 here has meaning.

24 Q. Does that language provide you with any ability -- does
25 it enable you to determine what else you should be doing to

1

2 Q. Okay. I just have another -- a couple quick
3 questions.

4 You were asked yesterday about Scientific
5 Atlanta's relationship with UEI.

6 Do you remember that?

7 A. Yes.

8 Q. Does Scientific Atlanta have any financial stake in the
9 outcome of this litigation?

10 A. No, they don't. We are indemnified in our contract
11 with UEI.

12 MR. McDONOUGH: Thank you. I have no further
13 questions.

14 MR. JENNER: I have just one, I think just one
15 question I'd like to recross.

16 THE COURT: All right.

17 RE-CROSS-EXAMINATION

18 BY MR. JENNER:

19 Q. Counsel asked you about this set theory and how the
20 claims related to the invention. And I have just one
21 question for you.

22 Is it your opinion, or is it not your opinion,
23 that Claims 1 and 6 of the patent are limited to the
24 preferred embodiment?

25 A. Let me make sure I understand your question, since it's

1 quarter, if that's convenient for you.

2 MR. BROWNE: That's fine.

3 Mr. Jenner?

4 MR. JENNER: That's fine.

5 THE COURT: All right.

6 MR. JENNER: We should aim for what, your Honor,

7 25 of?

8 THE COURT: 25 of, 20 of. I don't have any
9 meetings scheduled like yesterday.

10 MR. BROWNE: Okay.

11 THE COURT: But so I should be back on time at
12 roughly 20 of. And so why don't we do that?

13 MR. BROWNE: Thank you.

14 THE COURT: And I do have something scheduled at
15 3:15, but then I'm basically clear.

16 (Luncheon recess taken.)

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