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

Applicant:	Hayes et al.	Universal Remote Control, Inc.
Case No.:	IPR2013-00152	v.
Filing Date:	04/23/1996	Universal Electronics, Inc.
Patent No.:	5,614,906	Trial Paralegal: Amy Kattula
Title:	Method for Selecting a Remote Control Command Set	Attorney Doc.: 059489.123900

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

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

Certificate of Filing: I hereby certify that his correspondence is being electronically filed with the USPTO on this 22nd day of May, 2013.

By: /Eric J. Maiers/
Eric J. Maiers

TABLE OF CONTENTS

I. INTRODUCTION 1

II. CLAIM CONSTRUCTION 2

A. Broadest Reasonable Interpretation Of Claim 1 3

1. Claim Phrase: "assigning an effects observable command from each of said plurality of command sets to one of said plurality of assignable user actuated switches or keys" 3
2. Claim Phrase: "actuating sequentially and individually each one of the plurality of assignable user actuated switches or keys, to individually transmit each assigned effects observable command until the proper effect is observed" 10

B. Construction of Means-Plus Function Terms of Claim 16 10

1. Claim Phrase: "means for assigning an effects observable command from each of the plurality of command sets to one of said plurality of assignable user actuated switches or keys" 11
2. Claim Phrase: "means for transmitting said effects observable command when the corresponding one of said plurality of assignable user actuated switches or keys is actuated" 11
3. Claim Phrase: "means for indicating the halting of the actuation of the plurality of assignable user actuated switches or keys" 12
4. Claim Phrase: "means for setting the remote control to transmit future remote control commands from the command set containing the last transmitted effects observable command" 13

III. PATENT OWNER'S RESPONSE TO PETITIONER'S INVALIDITY ARGUMENTS 13

A. Telefunken 14

1. The USPTO Already Expressly Considered Telefunken In Allowing Claims 1 And 16. 14
2. Telefunken Does Not Anticipate Claims 1 And 16. 14

B. Telefunken in view of Casio 16

1. Telefunken In View Of Casio Does Not Render Claim 10 Obvious. 16
2. Telefunken In View Of Casio Does Not Render Claim 12 Obvious. 18

C. Sony in view of Telefunken 19

1. The USPTO Already Considered The Teachings Of Sony In Allowing Claims 1 And 16. 19
2. Sony In View Of Telefunken Does Not Render Claims 1 And/Or 16 Obvious. 20

D. Sony and Telefunken in view of Casio 25

1. Sony And Telefunken In View Of Casio Does Not Render Claim 10 Obvious 25
2. Sony and Telefunken In View Of Casio Does Not Render Claim 12 Obvious. 26

E. GHV in view of MRH7700. 27

1. GHV Is Not Prior Art. 27
2. GHV and MRH700 Are Cumulative To The Prior Art Of Record 28
3. GHV In View Of MRH7700 Does Not Render Claim 1 Obvious. 29
4. GHV In View Of MRH7700 Does Not Render Claim 10 Obvious. 33
5. GHV In View Of MRH7700 Does Not Render Claim 12 Obvious. 34

F. GHV and MRH7700 in view of Telefunken. 35
G. GHV and Pioneer in view of Casio. 35
H. GHV and Pioneer in view of Telefunken. 39

IV. CONCLUSION 40

I. INTRODUCTION

In its Petition for *Inter Partes* Review of U.S. Patent No. 5,614,906 ("Petition"), Petitioner alleges that various claims of U.S. Patent No. 5,614,906 ("'906 patent") are anticipated by German Patent DE 3313493 to Telefunken ("Telefunken"). Petitioner further alleges that various claims of the '906 patent are rendered obvious by seven different combinations of prior art: (1) Telefunken in view of Japanese Patent JP 6311567 to Casio ("Casio"); (2) European Patent Application EP 0577267 A1 to Sony ("Sony") in view of Telefunken; (3) Sony and Telefunkun in view of Casio; (4) GoldStar GHV-300 VCR Operating Manual ("GHV-300") or GoldStar GHV-500 VCR Operating Manual ("GHV-500") (collectively "GHV") in view of Rauland-Borg MRH7700 IR Remote Control Manual ("MRH7700"); (5) GHV-300 (or GHV-500) and MRH7700 in view of Telefunken; (6) GHV-300 (or GHV-500) and Pioneer VSX-5900S Receiver Operating Instructions ("Pioneer") in view of Casio; and (7) GHV-300 (or GHV-500) and Pioneer in view of Telefunken.

The Board should decline to institute *inter partes* review proceedings based on each of the above grounds because each suffers from one or more fatal defects. For example, *four* of Petitioner's bases rely upon references that are not prior art to the '906 patent. Further, *five* of Petitioner's bases rely upon the Telefunken reference that the patent owner referred to and discussed in the "Description of

Related Art" portion of the '906 patent specification. Finally, even ignoring these defects, the allegedly anticipatory Telefunken reference and each combination of references upon which Petitioner relies for its obviousness analysis fails to teach or suggest at least one limitation of each of the Claims of the '906 patent for which Petitioner claims the reference or combination of references invalidate.

II. CLAIM CONSTRUCTION

At the outset, Patent Owner agrees with Petitioner that because the '906 patent has not expired, the Board must construe its claims under the "broadest reasonable interpretation" standard. *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); MPEP § 2111. Thus, during examination, "claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *Sci. Tech. Ctr.*, 367 F.3d at 1364; MPEP § 2111.

Patent Owner disagrees, however, with Petitioner's application of this standard to the Claims of the '906 patent at issue in this Petition.

DOCKET ALARM

Explore Litigation Insights

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

Real-Time Litigation Alerts

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

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

Advanced Docket Research

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

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

Analytics At Your Fingertips

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

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

API

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

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

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

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

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