

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

Applicant:	O'Donnell et al.	Universal Remote Control, Inc.
Case No.:	IPR2013-00168	v.
Filing Date:	12/11/1992	Universal Electronics, Inc.
Patent No.:	5,414,426	Trial Paralegal: Lawrence J. Banks
Title:	FAVORITE KEY MACRO AND CHAINED MACRO COMMAND IN A REMOTE CONTROL	Attorney Doc.: 059489.124300

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

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
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PATENT OWNER'S EXHIBIT LIST

2001. Docket Sheet for *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, Case No. SAVC 00-1125 AHS (EEx)(C.D. Cal.)
2002. Petition to Correct Inventorship, filed July 3, 2012
2003. Declaration Under Rule 37 CFR 1.131 by Paul Darbee, dated January 22, 1992

I. INTRODUCTION

Petitioner alleges that one or more claims of U.S. Patent No. 5,414,426 (“‘426 patent”) are either anticipated by U.S. Patent No. 4,918,439 to Wozniak et al (“Wozniak”) or rendered obvious by seven different combinations of prior art: 1) Realistic Catalog No. 15-1903, Universal Remote Control Owner’s Manual (“Realistic”); 2) Realistic in view of a “Cable Controller Plus” advertisement (“DAK”) or SONY “Trinitron Color TV Operating Instructions for 6 models” (“Sony”); 3) Japanese Patent Application No. JP5526759 to Matsushita (“Matsushita”); 4) Matsushita in view of DAK, Sony or Realistic; 5) Matsushita in view of U.S. Patent No. 4,959,810 to Darbee, et al. (“Darbee ‘810”); 6) Matsushita in view of Darbee ‘810 in further view of DAK, Sony or Realistic; and 7) Wozniak in view of DAK, Sony or Realistic. As a threshold issue, the Board need not consider any of the foregoing alleged grounds of invalidity. Rather, the Board should dismiss Universal Remote Control, Inc.’s Petition for *Inter Partes* Review of U.S. Patent No. 5,414,426 (“Petition”) out of hand as time-barred, because the ‘426 patent was already the subject of a complaint for patent infringement served on Petitioner nearly 12 *years* ago. Moreover, the Board should decline to institute *inter partes* review proceedings based on most of the above grounds, because *four* of the six references upon which Petitioner relies are not prior art to the ‘426 patent.

II. PETITIONER LACKS STANDING TO REQUEST *INTER PARTES* REVIEW OF THE '426 PATENT

Petitioner lacks standing for its present request for *inter partes* review, because it filed its Petition requesting the proceeding more than one year after Petitioner was served with a complaint alleging infringement of the '426 patent. 35 U.S.C. § 315(b). Indeed, Petitioner concedes that “the '426 Patent was the subject of a complaint for patent infringement filed Nov. 15, 2000, styled *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, Case No. SAVC 00-1125 AHS (EEx)(C.D. Cal.)” (the “2000 Litigation”). Petition, Paper No. 2, at 3; *see also* Ex. 1018. Patent Owner served Petitioner with that complaint on March 21, 2001—nearly 12 years prior Petitioner’s filing in the instant proceeding. 2000 Litigation Docket Sheet, Ex. 2001 at 2. Thus, all elements of the § 315(b) bar have been met, and Petitioner is barred from bringing the present proceeding.

Petitioner makes much of the fact that nearly two years after filing the 2000 Litigation, Patent Owner withdrew its claims relating to the '426 patent, and the Court subsequently dismissed those claims, notably. The PTAB and Federal Circuit decisions upon which Petitioner relies to suggest that the dismissal of Patent Owner’s claims relating to the '426 patent made it “as though the action had never been brought” are misapplied and distinguishable from the present situation because of one very important distinction—the cases to which Petitioner cites each involved dismissals *without prejudice*, whereas the 2000 Litigation involved a

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