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

In re Patent of: Darbee	Universal Remote Control, Inc.
Patent No.: 5,414,761	v.
Filed: Oct. 8, 1993	Universal Electronics, Inc.
Issued: May 9, 1995	Case No. IPR2014-01104
Assignee: Universal Electronics Inc.	Trial Paralegal: Cathy Underwood
Title: REMOTE CONTROL SYSTEM	

PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO

EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R. § 42.64

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I.   Introduction

Petitioner opposes Patent Owner's motion to exclude the datasheet for an Intel 8254 Programmable Interval Timer (Ex. 1043) and pages 14–15 of Petitioner's Reply. *See* Paper 30. Patent Owner argues that the datasheet should be excluded because it is irrelevant under Fed. R. Evid. 401. Patent Owner reasons that the datasheet is irrelevant because it was not incorporated by reference into the Ciarcia reference and was not a basis for institution of this trial. Patent Owner's reasoning is misguided. The datasheet is relevant because it is extrinsic evidence that proves the understanding skilled artisans would have had of material which is inherent in the disclosure of the Ciarcia reference, and thus proves Ciarcia contains the claim limitation "code data."

II.   Legal Authority

"Evidence is relevant if: (a) it has *any* tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action." Fed. R. Evid. 401 (emphasis added).

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Emi Grp. North Am. v.*

Cypress Semiconductor Corp., 268 F.3d 1342, 1350–51 (Fed. Cir. 2001) (quoting

Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991));

Santarus, Inc. v. Par Pharm., Inc., 694 F.3d 1344, 1354 (Fed. Cir. 2012) (affirming

a finding of obviousness based on an inherent property of an obvious

combination).

III.   Background

Patent Owner's Response for the first time construed the claim term "code

data" as "instructions and timing information," and argued that, under that

construction, Ciarcia did not disclose "code data." Paper 14 at 13. To be

conservative, Petitioner replied that even under Patent Owner's incorrect

construction of the term "code data," that element was disclosed in the reference:

Steve Ciarcia, Build a Trainable Infrared Master Controller, BYTE magazine

(March 1987) ("Ciarcia").   Paper 23 (Petitioner's Reply) at 14–15.

Specifically, Petitioner pointed out that one of Ciarcia's electronic

components, an 8254 Programmable Interval Timer (an "8254 PIT"), "is

programmed to generate the IR signals, and the corresponding 'times are stored in

external data RAM.'" Paper 23 at 14–15. The 8254 datasheet explains expressly

the details of this programming which were well known to skilled artisans at the

time, including the instructions and timing information which are used to program

the 8254 PIT, which include, for example, "control words."   Ex. 1043 (8254

Datasheet) at 3-66 and 3-67. The datasheet's disclosure thus proved that "instructions and timing information" were inherent in Ciarcia and this inherent disclosure was recognized by skilled artisans at the time (who could have read the datasheet). *Id*.

IV.   Analysis

The datasheet is relevant to whether or not, under Patent Owner's claim construction, Ciarcia includes the "code data" claim limitation. Patent Owner admits that Ciarcia uses an 8254 PIT. *See* Ex. 1005 (Ciarcia) at 118; Paper 31 at 3. Even laypersons—not to mention persons of skill in the art—are aware that electronics come with manuals. Here, the manual for the 8254 PIT is termed a "datasheet." *See* Ex. 1043. While Ciarcia does not reprint each datasheet for each electronic component used in the Ciarcia device, that does not mean the details of those electronic components must be forever lost in mystery. Indeed, the 8254 datasheet was well known to skilled artisans at the time and even Patent Owner's expert has admitted that he used the 8254 datasheet for designs. *See* Ex. 1053 at 371:16–19 ("Q. Have you ever seen the data sheet for the 8254 prior to today? A. Yes. I've used the 8254 in designs where I've designed and wrote code.").

Where a prior art reference is silent as to a given characteristic of the prior art, the reference can still disclose that characteristic to skilled artisans if it is inherently present, and that inherency can be proven with extrinsic evidence. *See*

Emi, 268 F.3d at 1350–51. Here, the datasheet explains the operation of the 8254 PIT. *See* Ex. 1005 (Ciarcia) at 118 ("An 8254 programmable interval timer provides the high-speed logic required to generate signals with microsecond timing resolution."); Ex. 1043 at 3-67 (explaining the "Write Operations"). Thus, the datasheet is relevant because it specifies the inherent properties of the Ciarcia reference, and thus proves the disclosure of the claim term "code data," as construed by Patent Owner, in Ciarcia.

Patent Owner argues the datasheet is irrelevant because it was not included in the institution decision as a basis for invalidity. Patent Owner cites no authority holding that evidence not included in the institution decision as a basis for invalidity is categorically inadmissible. Indeed, if that were so, then all of the evidence Patent Owner has submitted that was not included in the institution decision as a basis for invalidity would also be inadmissible.

Patent Owner cites *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1346 (Fed. Cir. 2009), as allegedly supporting Patent Owner's arguments. *Callaway* is inapposite because that case dealt with incorporation by reference, which is not at issue here. Whether the datasheet was incorporated by reference into Ciarcia is an issue that is itself irrelevant. The datasheet is relevant because it proves the inherent content of Ciarcia. *See* Fed. R. Evid. 401 (evidence is relevant if it has *any* tendency to make a fact more or less probable).

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