

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

Applicant:	Darbee	Universal Remote Control, Inc.
Case No.:	IPR2014-01106	v.
Filing Date:	April 8, 1993	Universal Electronics, Inc.
Patent No.:	5,255,313	Trial Paralegal: Cathy Underwood
Title:	UNIVERSAL REMOTE CONTROL SYSTEM	Attorney Doc.: 059489.144100

**RESPONSE OF PATENT OWNER
PURSUANT TO 37 C.F.R. § 42.120**

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 this correspondence is being electronically filed with the USPTO on this 1st day of April 2015.

TABLE OF CONTENTS

I. INTRODUCTION 1

II. CLAIM CONSTRUCTION 2

 A. “input means . . . for inputting commands into the remote control”
 (Claims 1, 2, and 20) 4

 B. “infrared signal output means for supplying an infrared signal to a
 controlled device” (Claims 1, 2, and 20)..... 6

 C. “data coupling means for periodically coupling said computer to said
 remote control for receiving from said computer memory said code
 data for creating appropriate IR lamp driver instructions . . . said data
 coupling means for coupling said remote control to said computer,
 directly, through a telephone line, through a modem and a telephone
 line, or through decoding means and a television set to receive a
 television signal picked up by the television set” (Claim 1)..... 7

 D. “data coupling means including terminal means comprising a
 receiving port coupled to said CPU for enabling code data for creating
 appropriate IR lamp driver instructions . . . to be supplied from outside
 said remote control through said receiving port of said terminal means
 directly to said CPU for direct entry to said memory means”
 (Claim 2)..... 14

 E. “coupling means for coupling said terminal means to a computer,
 directly, through a telephone line, through a modem and a telephone
 line, or through decoding means and a television set” (Claim 2) 17

 F. “data coupling means for periodically coupling said computer to said
 remote control for receiving from said computer memory and
 inputting into said memory means of said remote control said code
 data for creating appropriate IR lamp driver instructions”
 (Claim 20)..... 21

 G. “code data” 25

III. PATENT OWNER’S RESPONSE TO PETITIONER’S REMAINING
GROUND FOR INVALIDITY 28

 A. Neither Ciarcia nor Hastreiter Meet the “code data for creating
 appropriate IR lamp driver instructions for causing said infrared signal
 output means to emit infrared signals” Limitation..... 29

B. One Having Ordinary Skill in the Art Would Not Have Been
Motivated to Combine Ciarcia and Hastreiter31

C. The Secondary Considerations of Non-Obviousness Overcome Any
Finding that Claims 1, 2, and 20 of the '313 is Obvious33

D. Petitioner Failed to Identify All Real Parties in Interest such that its
Petition is Deficient37

IV. CONCLUSION.....42

TABLE OF AUTHORITIES

Federal Cases

<i>Cable Elec. Prods., Inc. v. Genmark, Inc.</i> , 770 F.2d 1015 (Fed. Cir. 1985).....	35
<i>Ecolochem, Inc. v. S. Cal. Edison Co.</i> , 227 F.3d 1361 (Fed. Cir. 2000).....	34
<i>Gen. Elec. Co. v. U.S.</i> , 572 F.2d 745 (Ct. Cl. 1978).....	5
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	33
<i>Harris Corp. v. Federal Express Corp.</i> , 502 Fed. Appx. 957 (Fed. Cir. 2013).....	34
<i>In re GPAC Inc.</i> , 57 F.3d 1573 (Fed. Cir. 1995).....	35
<i>In re Rambus, Inc.</i> , 694 F.3d 42 (Fed. Cir. 2012).....	2
<i>In re Robertson</i> , 169 F.3d 743 (Fed. Cir. 1999).....	28
<i>J.T. Eaton & Co. v. Atlantic Paste & Glue Co.</i> , 106 F.3d 1563 (Fed. Cir. 1997).....	34
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005).....	2
<i>RCA Corp. v. Applied Digital Data Sys., Inc.</i> , 730 F.2d 1440 (Fed. Cir. 1984).....	34
<i>Stratoflex, Inc. v. Aeroquip Corp.</i> , 713 F.2d 1530 (Fed. Cir. 1983).....	34
<i>Taylor v. Sturgell</i> , 553 U.S. 880 (2008).....	37
<i>Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.</i> , 699 F.3d 1340 (Fed. Cir. 2012).....	34

P.T.A.B. Decisions

3D-Matrix, Ltd. v. Menicon Co.,
IPR2014-00398, Paper No. 11 (P.T.A.B. Aug. 1, 2014)28

Dominion Dealer Solutions, LLC v. AutoAlert, Inc.,
IPR2013-00222, Paper No. 12 (P.T.A.B. Aug. 12, 2013)31

Heart Failure Techs., LLC v. CardioKinetix, Inc.,
IPR2013-00183, Paper No. 12 (P.T.A.B. July 31, 2013)31

Omron Oilfield & Marine, Inc. v. MD/TOTCO,
IPR2013-00265, Paper No. 11 (P.T.A.B. Oct. 31, 2013)34

Panel Claw, Inc. v. Sunpower Corp.,
IPR 2014-00388, Paper No. 10 (P.T.A.B. June 30, 2014)2

SAS Inst., Inc. v. ComplementSoft, LLC,
IPR2013-00581, Paper No. 15 (P.T.A.B. Dec. 30, 2013).....31

Federal Statutes

35 U.S.C. § 112..... *passim*

Regulations

37 C.F.R. § 42.120 *passim*

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48, 759 (Aug. 14, 2012).....37

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.