

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIVERSAL REMOTE CONTROL, INC.,  
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,  
Patent Owner.

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Cases IPR2014-01084 (Patent 7,126,468 B2)  
IPR2014-01102 (Patent 5,228,077)  
IPR2014-01103 (Patent 5,552,917)  
IPR2014-01104 (Patent 5,414,761)  
IPR2014-01106 (Patent 5,255,313)  
IPR2014-01109 (Patent 7,831,930 B2)  
IPR2014-01146 (Patent 8,243,207 B2)<sup>1</sup>

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Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, WILLIAM A. CAPP, and LYNNE E. PETTIGREW, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

ORDER  
Authorizing Motion for Additional Discovery  
*37 C.F.R. § 42.51(b)(2)*

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<sup>1</sup> This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading.

IPR2014-01084 (Patent 7,126,468)      IPR2014-01106 (Patent 5,255,313)  
IPR2014-01102 (Patent 5,228,077)      IPR2014-01109 (Patent 7,831,930 B2)  
IPR2014-01103 (Patent 5,552,917)      IPR2015-01146 (Patent 8,243,207 B2)  
IPR2014-01104 (Patent 5,414,761)

On March 2, 2015, a conference call was held involving counsel for the respective parties and Judges Blankenship, Medley, Capp, and Pettigrew. The purpose of the call was for Patent Owner to request authorization to file a motion for additional discovery. In particular, Patent Owner believes that Ohsung Electronics, a manufacturer of Petitioner's products, is a real party-in-interest for Petitioner, and seeks additional discovery from Petitioner in support of that belief.

Based on the facts presented during the conference call, the Board authorized Patent Owner to file a single motion for discovery to be filed in each proceeding. As explained, the parties may agree to additional discovery between themselves. 37 C.F.R. § 42.51(b)(2). The parties are encouraged to work together to come to any agreement regarding the discovery Patent Owner seeks prior to Patent Owner filing its motion for additional discovery. The motion should include only those items for which the parties could not agree.

During the call, the Board also explained that a party moving for additional discovery "must show that such additional discovery is in the interests of justice." See 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). The factors set forth in *Garmin Int'l, Inc. et al. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB March 13, 2013) (Paper 26) are important factors in determining whether a discovery request meets the statutory and regulatory necessary "in the interest of justice" standard. Accordingly, Patent Owner's motion should explain with specificity the discovery requested and why such discovery is necessary "in the interest of justice" using those factors. In that regard, Patent Owner should not

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expect the Board to attempt to sort through a list of items to ascertain which items may meet the necessary in the interest of justice standard. Patent Owner bears the burden to demonstrate that the additional discovery (*e.g.*, each requested item) should be granted. *See* 37 C.F.R. § 42.20(c).

*Order*

It is

ORDERED that Patent Owner is authorized to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) by March 5, 2015, limited to 10 pages as specified in this order;

FURTHER ORDERED that Petitioner is not authorized to file an opposition until further notice from the Board.

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