

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSAL REMOTE CONTROL, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

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)¹

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

MEDLEY, *Administrative Patent Judge*.

DECISION

¹ 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.

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Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

I. INTRODUCTION

Universal Electronics, Inc. ("UEI" or "Patent Owner") filed a Motion for Additional Discovery in each proceeding relating to whether Universal Remote Control, Inc. ("URC" or "Petitioner") properly named all real parties-in-interest. Paper 12² ("Mot." or "Motion").

Patent Owner contends that Petitioner failed to name Ohsung Electronics Co., Ltd., and/or Ohsung Electronics U.S.A., Inc. ("Ohsung") as real parties-in-interest. *Id.* at 1. Patent Owner submits three production requests and three interrogatory requests as follows (*id.* at 8, 10):

Production Request No. 1: Documents and things regarding any money or consideration paid or to be paid by Ohsung to URC or URC's legal counsel for the Petition of this Proceeding, and agreements regarding any such money or consideration paid or to be paid by Ohsung to URC or URC's legal counsel for the Petition or this Proceeding.

Production Request No. 2: Documents and things regarding any money or consideration paid or to be paid by Ohsung to URC or URC's legal counsel for *Universal Electronics Inc. v. Universal Remote Control, Inc., Ohsung Electronics Co., Ltd., and Ohsung Electronics U.S.A. Inc.*, Case No. SACV 13-00984 AG (JPRx) (C.D. Cal.) (the "Litigation"), and agreements regarding any such money or consideration paid or to be paid by Ohsung to URC or URC's legal counsel for the Litigation.

² Citations are to IPR2014-01103.

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Production Request No. 3: Documents and things regarding Mr. Jak You's, or any other person's, dual-status as an employee of URC and Ohsung.

Interrogatory No. 1: Identify any money or consideration paid or to be paid by Ohsung to URC or URC's legal counsel for the Petition or this Proceeding, by the payment date and the amount paid.

Interrogatory No. 2: Identify any money or consideration paid or to be paid by Ohsung to URC or URC's legal counsel for the Litigation, by the payment date and the amount paid.

Interrogatory No. 3: Identify any person who has been an employee of both URC and Ohsung, concurrently or separately, and for each identified person, please also provide the company name, title, job function, and time period for each position held for each such employee.

For the reasons that follow, we deny Patent Owner's Motions.

II. ANALYSIS

Discovery is available for the deposition of witnesses submitting affidavits or declarations and for "what is otherwise necessary in the interest of justice." 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2) ("The moving party must show that such additional discovery is in the interest of justice . . ."). Clear from the legislative history is that discovery should be limited, and that the PTO should be conservative in its grant of additional discovery in order to meet time imposed deadlines. 154 Cong. Rec. S9988-89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl).

As explained in the order (Paper 11) authorizing Patent Owner's motion for

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additional discovery, the factors set forth in *Garmin International, Inc. v. Cuozzo Speed Technologies, LLC*, Case IPR2012-00001 (PTAB Mar. 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. Patent Owner argues that each discovery request complies with the *Garmin* factors. Mot. 7.

Production Requests and Interrogatories 1 and 2

Patent Owner argues that *Garmin* factor 1³ is met because Patent Owner possesses evidence and reasoning tending to show beyond speculation that something useful will be uncovered in response to production requests and interrogatories 1 and 2. *Id.* at 8–9. Patent Owner contends that the evidence presented tends to show that there is a relationship between Ohsung and Petitioner that goes beyond an ordinary co-defendant or supplier relationship. That contention is based on Petitioner and Ohsung having shared an employee (Mr. Jak You), office space, and legal counsel. *Id.* at 8–9.

The discovery Patent Owner seeks from Petitioner relates to whether Ohsung is a real party-in-interest to the proceedings.⁴ Whether a non-identified

³ In essence, for *Garmin* factor 1, the requestor of information already should be in possession of a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered. *Garmin* at 7.

⁴ Section 312(a) of Title 35 of the United States Code provides that a petition for *inter partes* review under 35 U.S.C. § 311 may be considered only if, among other things, the petition identifies all real parties-in-interest. 35 U.S.C. § 312(a)(2).

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party is a real party-in-interest to a proceeding is a highly fact-dependent question. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (“Trial Practice Guide”) (citing *Taylor v. Sturgell*, 553 U.S. 880 (2008)). “A common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Trial Practice Guide*, 77 Fed. Reg. at 48,759 (citing *Taylor*, 553 U.S. at 895). The concept of control generally means that “it should be enough the nonparty has the actual measure of control or opportunity to control that might reasonably be expected between two formal coparties.” *Id.*

We have reviewed the reasoning and evidence to which we are directed for Patent Owner’s showing beyond speculation that something useful will be uncovered in response to production requests and interrogatories 1 and 2, but we are not persuaded by such evidence and reasoning. Evidence that Mr. Jak You first worked for URC, then worked for Ohsung for demonstrating that URC and Ohsung share employees, dates back to August 8, 2001 (Ex. 2019), July 16, 2012 (Ex. 2018), and July 2013 (Exhibit 2021). Such evidence does not tend to show that Mr. You currently holds himself out as working for both Ohsung and URC, or that Ohsung and URC currently “share employees.” We would want to know the relationship status currently between URC and Ohsung as far as sharing of employees goes. In any event, and even assuming that URC and Ohsung currently share an employee, we do not agree with Patent Owner that such a sharing of one employee (Mr. You) suggests that Ohsung has paid for anything associated with the proceedings before us. Mot. 9. Moreover, we are not persuaded by Patent

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