

1 Peter H. Kang, SBN 158101
2 pkang@sidley.com
3 SIDLEY AUSTIN LLP
4 1001 Page Mill Road, Building 1
5 Palo Alto, California 94304
6 Tel: (650) 565-7000
7 Fax: (650) 565-7100

8 ADDITIONAL COUNSEL LISTED
9 ON SIGNATURE PAGE

10 Attorneys for Defendant
11 UNIVERSAL REMOTE CONTROL, INC.

12 UNITED STATES DISTRICT COURT
13 CENTRAL DISTRICT OF CALIFORNIA
14 SOUTHERN DIVISION

15 UNIVERSAL ELECTRONICS, INC.,
16 Plaintiff and Counterclaim-
17 Defendant,

18 v.

19 UNIVERSAL REMOTE CONTROL,
20 INC.,
21 Defendant and
22 Counterclaimant.

Case No. 8:12-CV-00329 AG (JPRx)

Assigned to: Hon. Andrew J. Guilford

**DECLARATION OF PETER H.
KANG IN SUPPORT OF
DEFENDANT UNIVERSAL
REMOTE CONTROL, INC.'S
SUPPLEMENTAL SUBMISSION
RE: AWARD OF ATTORNEYS'
FEES**

1 I, Peter H. Kang, declare:

2 1. I am a partner at Sidley Austin LLP (“Sidley”), one of the law firms
3 representing Defendant Universal Remote Control, Inc. (“URC”) in the above-
4 captioned matter. I submit this declaration in support of URC’s Motion for Attorneys’
5 Fees and Sanctions against Plaintiff Universal Electronics Inc. (“UEI”) and its counsel
6 of record. The statements made in this declaration are based on my own personal
7 knowledge or records regularly maintained in the ordinary course of Sidley’s business,
8 and if sworn as a witness I could testify competently thereto.

9 2. Sidley was founded in 1866 in Chicago and established a strong and
10 highly regarded practice representing corporate America in litigation, regulatory,
11 corporate, and general banking areas. Sidley has over 100 lawyers actively involved in
12 patent litigation. Our Intellectual Property practice and, in particular, our Patent
13 Litigation practice have been consistently ranked among the top in the country. For
14 example, Chambers USA recognized the firm with the 2014 national “Team of the
15 Year” designation in the Intellectual Property category. Sidley’s patent trial lawyers
16 have successfully represented many of the largest high technology clients to verdict in
17 some of the most hotly contested patent cases in federal courts nationwide.

18 3. Sidley was retained to represent URC in this matter in November 2013.

19 4. I was lead trial counsel for URC in this matter and responsible for
20 overseeing the Sidley team of attorneys and employees representing URC in this
21 matter.

22 5. Attached hereto as Exhibit 1 is a table that provides a breakdown of the
23 total legal fees and expenses charged to URC in this matter during specific time
24 periods by Sidley and the other law firms representing URC in this matter, Ostrolenk
25 Faber LLP (“Ostrolenk”), Christie, Parker & Hale LLP (“CPH”), and Tucker Ellis LLP
26 (“Tucker”). The information in this table was derived, for Sidley, from the invoices
27 attached hereto as Exhibits 2 to 16; for Ostrolenk, the invoices attached to the Miro
28

1 Declaration as Exhibits 1 to 36; and, for CPH and Tucker, the invoices attached to the
 2 Brookey Declaration as Exhibits 1 to 2.

3 6. Exhibit 1 reflects two different methodologies used to apportion fees and
 4 expenses that were “attributable to the ’426 and ’067 Patents, and the motion for
 5 reconsideration regarding the ’367 Patent,” as the Court required: (1) an “issue”-based
 6 approach in which a percentage of the fees and expenses is derived based on, for
 7 certain specified time periods, the percentage of litigation issues associated with the
 8 ’426 and ’067 patents and the motion for reconsideration regarding the ’367 patent;
 9 and (2) a “patent”-based approach in which a percentage of the fees and expenses is
 10 derived based on, for the same time periods, the percentage of patents that were the
 11 subject of the litigation that were the ’426 and ’067 patents (and, for the time period
 12 regarding the motion for reconsideration, the ’367 patent). This is illustrated in the
 13 chart below:

Time Period	Patents and Issues	Patent %	Issue %
Complaint to Markman Order (3/2/12 to 2/1/13)	’367: Non-infringement (claim coverage), invalidity (prior art), laches (3) ’067: Non-infringement (claim coverage), invalidity (prior art), laches/estoppel, unclean hands, patent misuse, marking, damages (7) ’426: Non-infringement (claim coverage), invalidity (prior art), invalidity (inventorship), license, laches/estoppel/res judicata, unclean hands, patent misuse, marking, damages (9) ’906: Non-infringement (claim coverage), non-infringement (non-use), invalidity (prior art), unclean hands, patent misuse, damages (6)	2/4 or 50%	16/25 or 64%

Time Period	Patents and Issues	Patent %	Issue %
Motion for Reconsideration (Segregated Out) (2/1/13 to 5/14/13)	'367: No separate apportionment necessary	100%	100%
Markman Order to Summary Judgment Order (Excluding Motion for Reconsideration) (2/1/13 to 3/24/14)	'067: Non-infringement (claim coverage), invalidity (prior art), laches/estoppel, unclean hands, patent misuse, marking, damages (7) '426: Non-infringement (claim coverage), invalidity (prior art), invalidity (inventorship), license, laches/estoppel/res judicata, unclean hands, patent misuse, marking, damages (9) '906: Non-infringement (claim coverage), non-infringement (non-use), invalidity (prior art), unclean hands, patent misuse, damages (6)	2/3 or 66%	16/22 or 73%
Summary Judgment Order to Jury Verdict (3/24/14 to 5/21/14)	'426: invalidity (inventorship), laches/estoppel/res judicata, unclean hands, patent misuse (4) '906: Non-infringement (claim coverage), non-infringement (non-use), invalidity (prior art), unclean hands, patent misuse, damages (6)	1/2 or 50%	4/10 or 40%
Post-Trial Briefing on Equitable Issues, Motion for	'426: No separate apportionment necessary for briefing on equitable issues	100%	100%

Time Period	Patents and Issues	Patent %	Issue %
Attorneys' Fees, Bill of Costs (5/21/14 to Present)	Apportionment not otherwise applicable. ¹		

7. The total amount of fees and expenses for each period were calculated based on the law firms' invoices. These totals exclude certain fees and expenses that have been redacted from the attached invoices based on their subject matter and that are not presently being claimed. The calculation of total fees and expenses from Tucker Ellis takes into account a 20% discount. The 20% discount does not appear on the Tucker Ellis invoices but does appear on the Ostrolenk Faber invoices that bill URC for Tucker Ellis' services as "Charges of Associate counsel" under Disbursements.

8. Where a period began/ended in the middle of a month, expenses were generally split on a daily pro rata basis. There are two exceptions to the pro rata approach—expenses were individually shifted into their corresponding periods for the Motion for Reconsideration and for trial.

9. The amount of fees and expenses for the Motion for Reconsideration were derived from time entries and expenses devoted exclusively to the motion for reconsideration. The expenses for these periods are expenses for travel associated with the hearing for the Motion for Reconsideration that appear on Ostrolenk Invoices 00004231-00000-145 RCF and 00004231-00000-150 RCF. The 2/1/13 - 3/24/14 period numbers were reached by summing all fees and expenses for that period, and

¹ As set forth herein, URC seeks to be compensated for its attorneys' fees and expenses incurred in connection with its Motion for Attorneys' Fees and its Bill of Costs. The work performed on these matters was not patent-specific and has not been apportioned.

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.