

**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

**MOTION FOR ADDITIONAL DISCOVERY
PURSUANT TO 37 C.F.R. § 42.51(b)(2)(i)**

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Certificate of Filing: I hereby certify that this correspondence is being electronically filed with the USPTO on this 5th day of March 2015.

TABLE OF EXHIBITS

2001. *3D-Matrix, Ltd. v. Menicon Co.*, IPR2014-00398, Paper No. 11 (P.T.A.B. Aug. 1, 2014)
2002. *Synopsis v. Mentor Graphics Corp.*, IPR2012-00042, Paper No. 16 (P.T.A.B. Feb. 22, 2013)
2003. *Research in Motion Corp. v. Wi-Lan USA Inc.*, IPR2013-00126, Paper No. 10 (P.T.A.B. June 20, 2013)
2004. *OpenTV, Inc. v. Cisco Technology, Inc.*, IPR2013-00329, Paper 9 (P.T.A.B. Nov. 29, 2013)
2005. *Dominion Dealer Solutions, LLC v. AutoAlert, Inc.*, IPR2013-00222, Paper No. 12 (P.T.A.B. Aug. 12, 2013)
2006. *SAS Inst., Inc. v. ComplementSoft, LLC*, IPR2013-00581, Paper No. 15 (P.T.A.B. Dec. 30, 2013)
2007. *Heart Failure Techs., LLC v. CardioKinetix, Inc.*, IPR2013-00183, Paper No. 12 (P.T.A.B. July 31, 2013)
- 2008-2016. INTENTIONALLY SKIPPED
2017. Trial Transcript from *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, No. 8:12-cv-00329-AG-JPR (C.D. Cal.), Dkt. No. 398-1
2018. Universal Remote Control, Inc.'s ("URC's") Initial Disclosures from *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, No. 8:12-cv-00329-AG-JPR (C.D. Cal.)
2019. URC's Response to UEI's Interrogatory at No. 6 from *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, No. 8:12-cv-00329-AG-JPR (C.D. Cal.)
2020. Ohsung Website Printout, available at http://www.ohsuntec.com/02_affli/02_foreign/06.aspx.

2021. URC's Amended Initial Disclosures from *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, No. 8:12-cv-00329-AG-JPR (C.D. Cal.)
2022. Defendant Ohsung Electronics, USA, Inc.'s Answer to Second Amended Complaint, Dkt. No. 76, from *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.)
2023. LinkedIn Profile of Jak You, available at <https://www.linkedin.com/pub/jak-you/92/8a5/6b>.
2024. 09/05/2013 M. Hurley Email to L. Kenneally
2025. Amended Notice of 30(b)(6) Deposition to URC from *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, No. 8:12-cv-00329-AG-JPR (C.D. Cal.)
2026. Joint Stipulation Staying Action Pending Petitions for *Inter Partes* Review of All Asserted Claims, Dkt. No. 87 from *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.)
2027. Joint Statement of the Parties Pursuant to Order Staying Action (ECF No. 88) and Joint Request to Continue Status Conference, Dkt. No. 102 from *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.)
2028. URC NY Secretary of State, Division of Corporations, Entity Information Website Printout

**PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY
PURSUANT TO 37 C.F.R. § 42.51(b)(2)(i)**

Universal Electronics Inc. (“UEI”) respectfully moves the Board for an order granting UEI permission to obtain additional discovery from Universal Remote Control, Inc. (“URC”) relating to URC’s failure to identify all real parties-in-interest. URC did not identify Ohsung Electronics Co., Ltd., and/or Ohsung Electronics U.S.A., Inc. (collectively “Ohsung”) as real parties-in-interest. UEI has identified evidence supporting its contention that Ohsung may be a real party-in-interest subject to the mandatory disclosure provision of 35 U.S.C. § 312(a)(2). URC and Ohsung share office space, at least one key remote control executive, and legal counsel in a related federal district court litigation. Moreover, URC’s CEO’s trial testimony suggests that Ohsung has previously paid certain of URC’s legal fees. In the interest of justice, it is necessary that the Board permit UEI to take limited discovery to explore the full extent to which Ohsung may be a real party-in-interest in this proceeding.

UEI has filed this Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2)(i) in response to the Board’s March 3, 2015, Order Authorizing Motion for Additional Discovery. (Paper 12.) UEI timely filed the instant motion in accordance with the Board’s March 5, 2015, deadline. (*Id.* at 3.) UEI sought a meet and confer with URC’s counsel, in accordance with the Board’s recommendation. (*Id.*) URC’s counsel offered to permit UEI’s counsel to view

the discovery gathered in a prior UEI v. URC litigation in lieu of responding to UEI's discovery requests. UEI declined that offer because UEI would not expect to find information responsive to its discovery requests in the materials produced in that prior litigation. Ohsung was not a named defendant in that prior litigation and different patents were at issue than are at issue in the current proceedings between UEI and URC. For those reasons, among others, the real party in interest question raised here was neither litigated nor resolved in that prior litigation.

I. **FACTUAL BACKGROUND**

The Petition identifies a single real party in interest, Universal Remote Control, Inc. (Petition at 1.) URC acknowledges that UEI sued URC and Ohsung in the currently pending federal court litigation involving the patent at issue in this Proceeding. (*Id.* (*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.) (“UEI Litigation II”)).)

According to URC's CEO, Chang Park, URC and Ohsung have a “very close relationship.” (Exhibit 2017, Trial Transcript from *Universal Electronics, Inc. v. Universal Remote Control, Inc.*, No. 8:12-cv-00329-AG-JPR (“UEI Litigation I”), Dkt. No. 398-1, at 596:22-24.) This very close relationship goes beyond a simple supplier relationship. First, a key remote control executive identifies himself as both an Ohsung and URC employee, depending upon the

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