

1 COUNSEL LISTED ON SIGNATURE PAGE

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SANTA ANA DIVISION

UNIVERSAL ELECTRONICS, INC.,) Case No. 8:13-cv-00984 AG (JPRx)
)
Plaintiff,)
) JOINT STATEMENT OF THE
vs.) PARTIES PURSUANT TO ORDER
) STAYING ACTION (ECF NO. 88)
UNIVERSAL REMOTE CONTROL,) AND JOINT REQUEST TO
INC., et al.,) CONTINUE STATUS
) CONFERENCE FROM JANUARY
Defendants.) 26, 2015 TO MARCH 9, 2015;
) DECLARATION OF MARK A.
) FINKELSTEIN
)
)

Pursuant to the Court’s Order Staying Action Pending Petitions for *Inter Partes* Review of All Asserted Claims (ECF No. 88) (the “Stay Order”), Plaintiff and Counterclaim-Defendant Universal Electronics, Inc. (“UEI”) and Defendants and Counterclaimants Universal Remote Control, Inc. (“URC”), Ohsung Electronics Co., Ltd., and Ohsung Electronics U.S.A., Inc. (collectively, “Ohsung”) (all collectively, “Defendants”), met and conferred on January 15, 2015. Pursuant to the Stay Order and the parties’ meet and confer, the parties hereby provide the following joint statement and jointly request that the Status Conference currently scheduled for

1 January 26, 2015, at 9:00 a.m. be continued to March 9, 2015, at 9:00 a.m., for the
2 reasons provided below.

3 **A. Status of PTO *Inter Partes* Review Proceedings Involving the Patents-**
4 **In-Suit**

5 Pursuant to the Stay Order, the parties report that all asserted claims of the ten
6 UEI patents-in-suit were subject to ten petitions for *inter partes* review (“IPR”) filed
7 with the U.S. Patent and Trademark Office (“PTO”). As the following chart
8 demonstrates, the PTO Patent & Trademark Appeal Board (“PTAB”) instituted review
9 with respect to all asserted claims in five of the asserted patents; instituted review with
10 respect to some, but not all, asserted claims in two of the asserted patents; and did not
11 institute any review with respect to the asserted claims of the remaining three patents.

12 Asserted Patent	IPR Docket No.	Decision on Petition
13 5,228,077 to Darbee 14 (expired)	IPR2014-01102	Instituted (all asserted claims)
15 5,552,917 to Darbee 16 (expired)	IPR2014-01103	Instituted (all asserted claims)
17 5,414,761 to Darbee 18 (expired)	IPR2014-01104	Instituted (all asserted claims)
19 5,255,313 to Darbee 20 (expired)	IPR2014-01106	Instituted (all asserted claims)
21 7,831,930 to Dresti	IPR2014-01109	Instituted (all asserted claims)
22 7,126,468 to Arling	IPR2014-01084	Instituted (instituted as to claims 27, 28, 33, 35, 45, and 49; not 23 instituted as to claims 1, 2, 11, 29, and 46)
24 8,243,207 to Arling	IPR2014-01146	Instituted (instituted as to claims 25 13–15; not instituted as to 26 claim 12)
27 7,589,642 to Mui	IPR2014-01082	Not instituted

1	6,407,779 to Herz	IPR2014-01111	Not instituted
2	RE39059 to Foster	IPR2014-01112	Not instituted

3 **B. Parties' Statements Regarding Case Management**

4 **1. Statement of Plaintiff UEI**

5 On January 9, 2015, the PTAB rendered its final decision on the petitions for
6 IPR. UEI intends to seek rehearing with respect to at least one of the IPR decisions.

7 UEI and its new counsel are still evaluating the IPR decisions and, depending
8 on the outcome of its rehearing request(s), may drop certain patents from this lawsuit,
9 may seek to amend its complaint in other ways, or may stipulate to a further stay of
10 this proceeding. To preserve judicial resources while UEI completes its analysis and
11 awaits a ruling on its rehearing request(s), UEI requests that the Status Conference be
12 continued until March 9, 2015. At that time, UEI expects to be in a position to inform
13 the Court regarding its views on the case management including, without limitation,
14 whether there is any need to continue the stay.

15 **2. Statement of Defendants URC and Ohsung**

16 Defendants have no objection to rescheduling the January 26, 2015 Status
17 Conference to permit UEI and its new counsel additional time and for purposes of
18 efficiency. Specifically, Defendants agree that the January 26, 2015 Status
19 Conference should be rescheduled for March 9, 2015. At this rescheduled Status
20 Conference, Defendants expect that the parties will be in a position to discuss the
21 scope of the stay, any petitions for rehearing filed by UEI with respect to the IPRs,
22 and the status of any such petitions.

23 **C. Date for Further Case Management Conference**

24 Pursuant to the Stay Order, the parties propose that any further Case
25 Management Conference should be held on April 27, 2015, after the parties have
26 received instructions from the Court at the rescheduled Status Conference on the
27 scope of the stay and other general case management issues. The parties agree that no
28

1 later than seven (7) days prior to the Case Management Conference, the parties shall
2 jointly file a Case Management Conference Statement. For avoidance of doubt, the
3 parties understand that, pursuant to the Stay Order, the action remains stayed at least
4 until the Case Management Conference has been held.

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