

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

CANON KABUSHIKI KAISHA,
Patent Owner.

IPR2020-00341 (Patent 8,078,767 B2)
IPR2020-00342 (Patent 8,346,986 B2)
IPR2020-00343 (Patent 8,713,206 B2)
IPR2020-00355, IPR2020-00357 (Patent 7,746,413 B2)
IPR2020-00358, IPR2020-00359 (Patent 7,810,130 B2)¹

Before BART A. GERSTENBLITH, JOHN D. HAMANN, and
JASON W. MELVIN, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Granting Patent Owner's Request for Authorization
to File a Motion for Additional Discovery
37 C.F.R. § 42.5

¹ This Order addresses issues that are identical in each of the above-identified proceedings. The parties are not authorized to use this style heading without prior authorization.

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DISCUSSION

Roku, Inc. (“Petitioner”) filed seven Petitions that collectively request *inter partes* review of U.S. Patent Nos. 8,078,767 B2; 8,346,986 B2; 8,713,206 B2; 7,746,413 B2; and 7,810,130 B2. *See* IPR2020-00341, Paper 2 (“Pet.”); IPR2020-00342, Paper 2; IPR2020-00343, Paper 2; IPR2020-00355, Paper 2; IPR2020-00357, Paper 2; IPR2020-00358, Paper 2; IPR2020-00359, Paper 2. In each of the proceedings, Canon Kabushiki Kaisha, LLC (“Patent Owner”) filed a Preliminary Response. IPR2020-00341, Paper 6 (“Prelim. Resp.”); IPR2020-00342, Paper 6; IPR2020-00343, Paper 6; IPR2020-00355, Paper 6; IPR2020-00357, Paper 6; IPR2020-00358, Paper 6; IPR2020-00359, Paper 6.²

One common issue in each proceeding is whether we should deny institution of *inter partes* review pursuant to our discretion under 35 U.S.C. § 314(a). *See* Pet. 8–11 (addressing § 314(a)); Prelim. Resp. 3–13 (same); *see also* *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19–20 (PTAB Sept. 12, 2018) (precedential) (addressing discretionary denial under § 314(a)). After the Petitions and Preliminary Responses were filed, the Board designated, as precedential, the decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”). *Fintiv* identifies a non-exclusive list of factors parties may consider addressing in the context of discretionary denial under § 314(a), particularly

² The Petitions and Preliminary Responses each address common issues discussed herein. Accordingly, citations are to the Petition and Preliminary Response in IPR2020-00341, unless otherwise indicated.

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where there is a related, parallel district court action. *Fintiv* at 5–6. To aid in our consideration of this issue, we ordered additional briefing by the parties so that they could specifically address the *Fintiv* factors as well as any other factors relevant to our consideration of discretionary denial under § 314(a). Paper 7 (Order Authorizing Preliminary Reply and Preliminary Sur-reply).

In an email dated May 12, 2020, Patent Owner requests authorization to file a motion for additional discovery limited to Petitioner’s relationship with the TCL entities, which Petitioner identifies as privies.³ Petitioner opposes. On May 13, 2020, a conference call was held with counsel for the parties as well as Judges Gerstenblith, Hamann, and Melvin. During the conference call, Patent Owner explained that the additional discovery relates to the fifth *Fintiv* factor—“whether the petitioner and the defendant in the parallel proceeding are the same party.”⁴ *See Fintiv* at 6. Patent Owner

³ The Petition identifies the following TCL entities as privies of Petitioner: Shenzhen TCL New Technologies Co. Ltd. (“Shenzhen TCL”), TCL King Electrical Appliances (Huizhou) Co. Ltd. (“TCL King Huizhou”), TCL Corporation, TCL Holdings (BVI) Ltd., TTE Corporation, TTE Technology, Inc., TCL Electronics Holdings Ltd., TCL Industries Holdings (H.K.) Ltd. (“TCL Industries HK”), and TCL Industrial Holdings Co., Ltd. Pet. 3. Petitioner explains that “Shenzhen TCL is a subsidiary of TCL King Huizhou, which is a subsidiary of TCL Holdings (BVI) Ltd., which along with TTE Technology, Inc. are subsidiaries of TTE Corporation, which is a subsidiary of TCL Electronics Holdings Ltd., which is a subsidiary of TCL Industries HK, which is a subsidiary of TCL Industrial Holdings Co., Ltd.” *Id.* at 3–4. We refer to these privies collectively as “the TCL entities.”

⁴ During the conference call, Patent Owner also contended that the additional discovery sought would pertain to *Fintiv* factor 4—“overlap

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explained that the relationship between Petitioner and the TCL entities is not clear and that its additional discovery requests (i.e., three to five interrogatories) will be narrowly tailored to this specific issue.

Petitioner raised two primary arguments in opposition. First, that it already identified the TCL entities as privies in the Petitions, specifically to avoid having a dispute about their relationship with Petitioner. Second, Petitioner explained that, in the related district court litigation, Patent Owner served discovery requests pertaining to TCL's relationship with Petitioner, and Petitioner responded to those requests, although Petitioner is not a party to the district court litigation. Thus, Petitioner suggested that (1) if there was any relevant information on the subject, it would have been or will be produced in the district court litigation and (2) Patent Owner should seek to use the district court discovery in the present proceedings so that Petitioner need not respond to the same discovery requests again.

Patent Owner argued that Petitioner's identification of the TCL entities as privies does not resolve open questions regarding whether there is a more specific relationship between the TCL entities and Petitioner, particularly as such relationship may pertain to the fifth *Fintiv* factor. Additionally, Patent Owner's counsel explained that it is not counsel for Patent Owner in the related district court litigation and is not aware of

between issues raised in the petition and in the parallel proceeding" (*Fintiv* at 6). The relevance of Patent Owner's request to that factor, however, is less clear.

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information produced therein that addresses Patent Owner’s discovery concerns.

In response to questioning from the panel, Petitioner did not agree to make its district court production available to Patent Owner for use in these proceedings. Thus, the question as to whether Patent Owner can use production from the district court litigation in these proceedings remains unresolved.

In light of the discussion, which included several factors set forth in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2020-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential) (referred to as “the *Garmin* factors”), we authorized Patent Owner to file its requested motion for additional discovery and also authorized Petitioner to file a response thereto, as set forth in the Order below. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“Consolidated TPG”), 28, available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (explaining that a party seeking authorization to file a motion for additional discovery should be prepared to address the *Garmin* factors during a conference call with the Board and that identifying real parties-in-interest is an issue for which “[n]arrowly focused requests for additional discovery . . . may, if appropriate, be permitted”). In the briefing, the parties may address, *inter alia*, (1) whether Petitioner produced discovery relevant to Patent Owner’s requests in the district court, (2) if so, whether Petitioner authorizes Patent Owner to use said discovery in these proceedings, and (3) what schedule should be applied to any discovery awarded.

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