

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROKU, INC.  
Petitioner

v.

CANON KABUSHIKI KAISHA  
Patent Owner

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Case IPR2020-00343  
Patent No. 8,713,206

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**PATENT OWNER'S MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8**

Patent Owner, Canon Kabushiki Kaisha, provides the following mandatory notices pursuant to 37 C.F.R. § 42.8.

**I. Real Party-in-Interest**

Pursuant to 37 C.F.R. § 42.8(b)(1), the real party-in-interest is Canon Kabushiki Kaisha, the assignee for U.S. Patent No. 8,713,206 (“the ’206 patent”).

**II. Related Matters**

Patent Owner identifies the following matters that may be deemed related pursuant to 37 C.F.R. § 42.8(b)(2).

**A. Proceedings Before the USPTO Involving the Patent-at-Issue**

The ’206 patent, which is the subject of this proceeding, is not at issue in any other proceeding before the Office.

**B. Proceedings before the USPTO Involving Related Patents**

The following proceedings before the Office involve a patent related to the ’206 patent:

Case	Related Patent
IPR2020-00341	Patent 8,078,767
IPR2020-00342	Patent 8,346,986
IPR2020-00355	Patent 7,746,413
IPR2020-00357	Patent 7,746,413
IPR2020-00358	Patent 7,810,130

Case	Related Patent
IPR2020-00359	Patent 7,810,130

### **C. U.S. Patent Applications Related to the Patent-at-Issue**

The application for the '206 patent (U.S. Patent Application No. 13/707,652) is a continuation of U.S. Patent Application No. 13/281,543, filed on October 26, 2011 (now U.S. Patent No. 8,346,986), a division of U.S. Patent Application No. 12/545,270, filed on August 21, 2009 (now U.S. Patent No. 8,078,767), and a continuation of PCT/JP2009/055831, filed March 24, 2009.

### **D. U.S. Litigations Involving the Patent-at-Issue**

The following judicial matter, in which the '206 patent is at issue, may affect or be affected by a decision in this proceeding:

*Canon, Inc. v. TCL Electronics Holdings Ltd., et al.*, No. 18-cv-00546-JRG (E.D. Tex.).

Further, the '206 patent was at issue in *Canon, Inc. v. Roku, Inc.*, No. 19-cv-00245-ADA (W.D. Tex.) (dismissed August 7, 2019).

### **III. Lead and Back-up Counsel and Service Information**

In accordance with 37 C.F.R. § 42.8(b)(3) and (b)(4), Patent Owner identifies the following lead and back-up counsel and service information:

Lead Counsel	Back-Up Counsel
Joseph E. Palys (Reg. No. 46,508) Paul Hastings LLP 875 15 <sup>th</sup> Street NW Washington, DC 20005 Telephone: (202) 551-1996 Facsimile: (202) 551-0496 E-mail: PH-Roku-Canon-IPR@paulhastings.com	Naveen Modi (Reg. No. 46,224) Paul Hastings LLP 875 15 <sup>th</sup> Street NW Washington, DC 20005 Telephone: (202) 551-1990 Facsimile: (202) 551-0490 E-mail: PH-Roku-Canon-IPR@paulhastings.com

Respectfully submitted,

Dated: January 14, 2020

By:           /Joseph E. Palys/            
 Joseph E. Palys  
 Reg. No. 46,508

Counsel for Patent Owner

## CERTIFICATE OF SERVICE

I hereby certify that on January 14, 2020, I caused a true and correct copy of the foregoing Patent Owner's Mandatory Notices Pursuant To 37 C.F.R. § 42.8 to be served electronically on the following counsel of record for Petitioner at the following email address:

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