

1 IN THE UNITED STATES DISTRICT COURT  
2 FOR THE EASTERN DISTRICT OF TEXAS  
3 MARSHALL DIVISION

4 CANON, INC. ) (  
5 ) ( CIVIL ACTION NO.  
6 ) ( 2:18-CV-546-JRG  
7 VS. ) ( MARSHALL, TEXAS  
8 ) (  
9 TCL ELECTRONICS HOLDINGS ) ( MARCH 18, 2020  
10 LTD. ) ( 1:57 P.M.

11 CLAIM CONSTRUCTION HEARING  
12 BEFORE THE HONORABLE JUDGE RODNEY GILSTRAP  
13 UNITED STATES CHIEF DISTRICT JUDGE

14

15 APPEARANCES:

16 FOR THE PLAINTIFF: (See Attorney Attendance Sheet docketed  
17 in minutes of this hearing.)

18 FOR THE DEFENDANTS: (See Attorney Attendance Sheet docketed  
19 in minutes of this hearing.)

20 COURT REPORTER: Shelly Holmes, CSR, TCRR  
21 Official Reporter  
22 United States District Court  
23 Eastern District of Texas  
24 Marshall Division  
100 E. Houston Street  
Marshall, Texas 75670  
(903) 923-7464

25 (Proceedings recorded by mechanical stenography, transcript

02:14:53 1 Ropes & Gray on behalf of the Defendants.

02:14:54 2 If we could have Slide 7 from our binder up on the  
02:15:00 3 screen. This is --

02:15:01 4 THE COURT: Before -- before you go any further,  
02:15:03 5 counsel, respond, if you will, to Plaintiff -- Plaintiff's  
02:15:07 6 counsel's argument that you've effectively refused to  
02:15:12 7 respond to their request as to an explanation of any  
02:15:17 8 privity between Roku and your clients.

02:15:21 9 MR. THOMASES: I'm not aware --

02:15:23 10 THE COURT: I mean, it sounded to me like we  
02:15:25 11 needed to stop the claim construction and have a motion to  
02:15:27 12 compel hearing before we can go forward. It was a  
02:15:29 13 pretty -- a pretty straightforward and unequivocal argument  
02:15:33 14 that you've been stonewalling. I want to hear your  
02:15:35 15 response.

02:15:36 16 MR. THOMASES: Sure, Your Honor. We have not been  
02:15:37 17 stonewalling.

02:15:38 18 The discovery that specifically asked that is not  
02:15:41 19 due until later this week. There has not been a meet and  
02:15:44 20 confer to my knowledge at -- on this issue. And it has not  
02:15:47 21 actually been written in any discovery correspondence  
02:15:51 22 request, and it's because our discovery is due this week.

02:15:53 23 THE COURT: And as a part of the discovery that's  
02:15:55 24 due this week, is the answer to that question going to be  
02:15:58 25 forthcoming?

02:15:59 1 MR. THOMASES: I don't -- quite honestly, I don't  
02:16:03 2 know. It might be privileged because of the protected  
02:16:06 3 nature of certain of the topics that are being requested,  
02:16:12 4 either that or common interest protection or -- or another  
02:16:14 5 protection.

02:16:15 6 THE COURT: Well, if there's going to be a  
02:16:17 7 privilege asserted, we need to get a privilege log, and we  
02:16:20 8 need to get on paper and figure out where we are. If it's  
02:16:22 9 not, they're probably entitled to an answer to that  
02:16:26 10 question, because it goes to the -- it goes to the binding  
02:16:29 11 nature of the impact of that IPR proceeding here.

02:16:32 12 MR. THOMASES: I understand, Your Honor, and we'll  
02:16:35 13 take Your Honor's counsel on that.

02:16:38 14 The main issue, though, that I need to correct  
02:16:41 15 from counsel's statement is the IPRs were filed -- filed by  
02:16:47 16 Roku. Roku was sued on these patents separately in a suit  
02:16:53 17 in the Western District of Texas.

02:16:54 18 Now, Roku does supply the operating system to TCL,  
02:16:58 19 but the IPRs were signed by Roku, not by TCL. The Roku  
02:17:07 20 people have been subpoenaed in this case. And in the  
02:17:10 21 identical IPRs, they identified privies because that's  
02:17:14 22 what's customary to do. And if you don't, then there could  
02:17:20 23 be consequences at the PTAB.

02:17:22 24 But this is not -- was not a representation by  
02:17:25 25 TCL. The case law that counsel cited, the Federal Circuit

02:17:32 1 decision, applies when there's a final written decision by  
02:17:35 2 the PTAB. Who is it binding on? The petitioner and  
02:17:40 3 privies. That is what that decision is discussing.

02:17:43 4           It is not saying that the statement by a third  
02:17:46 5 party in their IPR needs to be binding on someone who is  
02:17:50 6 just identified by the petitioner as a privy.

02:17:53 7           Just going to that point that -- that he made, the  
02:17:57 8 quotes that they cite actually don't say that the operation  
02:18:02 9 form must be preset. I -- I want to go into some  
02:18:05 10 background on the technology because there's a fundamental  
02:18:07 11 misunderstanding by counsel there.

02:18:08 12           They don't say -- there's not -- there's no  
02:18:12 13 admission that the operation forms can be created ad hoc.  
02:18:18 14 The operation screens, which are separate, are actually  
02:18:21 15 created from an operation form. Those are what's kind of  
02:18:24 16 created based on forms. So I -- I have on the slide  
02:18:28 17 some -- it's actually a snippet from our tutorial.

02:18:33 18           Recall that the claim requires that there's an  
02:18:36 19 attribute of a remote control. And this is somehow  
02:18:40 20 required by your TV. And there could be different pointers  
02:18:42 21 or key -- key inputs.

02:18:44 22           Then there's some -- we're going to get into this  
02:18:47 23 determining because that's the next term which is --  
02:18:51 24 there's a question about indefiniteness. But there's some  
02:18:53 25 claim element that says there's going to be some

- 1
- 2
- 3
- 4
- 5
- 6
- 7
- 8
- 9
- 10
- 11
- 12
- 13
- 14
- 15
- 16
- 17
- 18
- 19
- 20
- 21
- 22
- 23
- 24
- 25

CERTIFICATION

I HEREBY CERTIFY that the foregoing is a true and correct transcript from the stenographic notes of the proceedings in the above-entitled matter to the best of my ability.

/S/ Shelly Holmes  
SHELLY HOLMES, CSR, TCRR  
OFFICIAL REPORTER  
State of Texas No.: 7804  
Expiration Date: 12/31/2020

3/27/2020  
Date