

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

CANON, INC.

Plaintiff,

v.

TCL ELECTRONICS HOLDINGS
LTD., *et al.*,

Defendants.

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CIVIL ACTION NO. 2:18-cv-00546

JURY TRIAL DEMANDED

**PLAINTIFF CANON, INC.’S SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF
REGARDING [REDACTED]**

After the Markman hearing, and only in response to this Court’s pointed questioning, Defendants finally admitted that Roku [REDACTED]. Defendants also admitted that Roku is [REDACTED]. In short, Roku is [REDACTED] both before this Court and the PTAB — a fact Defendants omitted from their Initial Disclosures.¹ Yet, Defendants contend Roku’s conflicting arguments before the PTAB are irrelevant to claim construction in this litigation because Roku is a different entity than Defendants.²

That position is untenable. Roku is not an unrelated party; [REDACTED]. As this Court noted, this relationship “goes to the binding nature of

¹ Defendants and Roku are both represented by the same counsel at Ropes & Gray.
² Dkt. No. 116 at 16:12-17:6. (“The main issue, though, that I need to correct from counsel’s statement is the IPRs were filed -- filed by Roku. Now, Roku does supply the operating system to TCL, but the IPRs were signed by Roku, not by TCL.”).

[REDACTED]

the impact of that IPR proceeding here.” Dkt. No. 116 (Markman Tr.) at 16:6-11. Privity is the legal concept that captures instances when a person who is not a party to a litigation nevertheless appears in that litigation through the persona of another, its privity. Accordingly, the common law prohibits a litigant from taking a second bite at the apple by relitigating the same case—or the same issues—through its privity, particularly when the privity [REDACTED]. Specifically, by virtue of collateral and judicial estoppel, any decision in Roku’s IPRs would bind not only Roku itself, but also Defendants—[REDACTED] [REDACTED]. The Court therefore should not ignore Roku’s arguments before the PTAB that manifestly contradict its privies’ positions here, and further demonstrate the correctness of Canon’s proposed claim constructions.

BACKGROUND

Canon has repeatedly requested [REDACTED] and information since November 11, 2019. Ex. 1 at 15, RFP No. 60 (Nov. 11, 2019 Letter from Ozawa to Radsch providing RFPs); Ex. 2 at 29-30, RFP Nos. 18, 20 (Dec. 20, 2019 Roku Subpoena). On December 27, 2019, Roku filed IPR petitions on each of the asserted patents, listing Defendants as statutory privies for purposes of 35 U.S.C. §§ 315(b) and 315(e), but leaving unclear the exact relationship between the parties and if they were also privies in this litigation.³ *See, e.g.*, Dkt. No. 91-14 (Ex. K, IPR2020-00357, Petition) at 9-10 (“Petitioner identifies the following companies as privies....”). Thereafter, Defendants (through its counsel, Ropes & Gray) spurned Canon’s [REDACTED] on the basis of privilege, Ex. 3 (Jan. 13, 2020, Roku

³ Defendants represented at the Markman hearing that Roku “identified privies because that’s what’s customary to do. And if you don’t, then there could be consequences at the PTAB.” Many IPR petitioners list potential privies out of caution. Dkt. No. 116 at 16:18-17:6.

[REDACTED]

Response to Subpoena), but, on January 15, 2020, produced [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Through multiple meet-and-confers, Canon pressed Defendants and Roku as to whether they were, in fact, [REDACTED], but was told the information was privileged. Then, on February 20, 2020, Defendants served amended initial disclosures that failed to mention *even the possibility* [REDACTED], despite this Court's Discovery Order requiring the parties to list any [REDACTED] and to list all persons having knowledge of relevant facts with a description of their connection to the case. Dkt. No. 78, Sections 1(d)-(e). This caused Canon additional uncertainty as to whether [REDACTED] [REDACTED]. Unable to get a yes-or-no answer, Canon thus served an additional interrogatory and requests for admission to help clarify if Roku and Defendants were privies in this litigation. *See* Ex. 5 (Canon's Second Set of Common Interrogatories); Ex. 6 (Canon's First Set of Requests for Admission). Only after repeated pressing by this Court at the Markman hearing, did Defendants admit that Roku is [REDACTED] [REDACTED]. Dkt. No. 116 at 15:4-16:11; Ex. 7 (Defendants' March 19, 2020 Responses to Canon's Second Set of Common Interrogatories).

⁴ TCL Multimedia Technology Holdings Ltd. is a named Defendant in this action.

⁵ [REDACTED], TTE Corporation is a subsidiary of TCL Multimedia Technology Holdings Ltd.

⁶ [REDACTED]

[REDACTED]

Specifically, Defendants admitted that [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Under the TCL/Roku license agreement, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

⁷ Dkt. No. 116 at 16:18 (“Now, Roku does supply the operating system to TCL . . .”).

⁸ Proceeding to list the exceptions noted in FN 6.

[REDACTED]

[REDACTED]

[REDACTED] Roku is also [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

ARGUMENT

Roku is [REDACTED], while simultaneously controlling and funding the IPR proceedings of the patents in suit. Thus, in effect, Roku (and Ropes & Gray, its common counsel with Defendants since at least November, 6, 2019) are advancing claim constructions before the PTAB [REDACTED]. Ex. 9 at 11-12 (November 6, 2019 Initial Disclosures listing “Roku, Inc.” and Roku employees as “contact only through outside counsel of record for Defendants”). While Roku’s role, [REDACTED] and the IPR proceedings, ordinarily would not be an issue if it were maintaining consistent positions between both proceedings, that did not occur here.

As is detailed in Ex. 10, Roku repeatedly advanced positions in the IPRs that are at direct odds with those advanced in this action. For example, regarding the ’413 Patent claim term “attribute of a remote control device,” Roku argued before the PTAB that the term should be construed as “remote control identification information or operation device information and, for the purposes of this Petition, include ‘code sequences transmitted from a remote control device,’” but, on the other hand, [REDACTED] before this Court that the term does not include transmitted code sequences. Dkt. No. 91-14 (Ex. K, IPR2020-00357, Petition) at 22.

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