UNITED STATES DISTRICT COURT EASTERN DISTRICT OF TEXAS MARSHALL DIVISION

CANON, INC.	§
Plaintiff,	§ CIVIL ACTION NO. 2:18-cv-00546
v. TCL ELECTRONICS HOLDINGS LTD., et al.,	§ § JURY TRIAL DEMANDED § §
Defendants.	§ §

PLAINTIFF CANON, INC.'S SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF REGARDING

After the Markman hearing, and only in response to this Court's pointed questioning,

Defendants finally admitted that Roku
. Defendants also admitted that
Roku is
. In short, Roku is both before this Court and the
PTAB — a fact Defendants omitted from their Initial Disclosures. 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;
. As this Court noted, this relationship "goes to the binding nature of

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.").



¹ Defendants and Roku are both represented by the same counsel at Ropes & Gray.

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 privy. 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 privy, particularly when the privy

Specifically, by virtue of collateral and judicial estoppel, any decision in Roku's IPRs would bind not only Roku itself, but also Defendants—

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 and information since

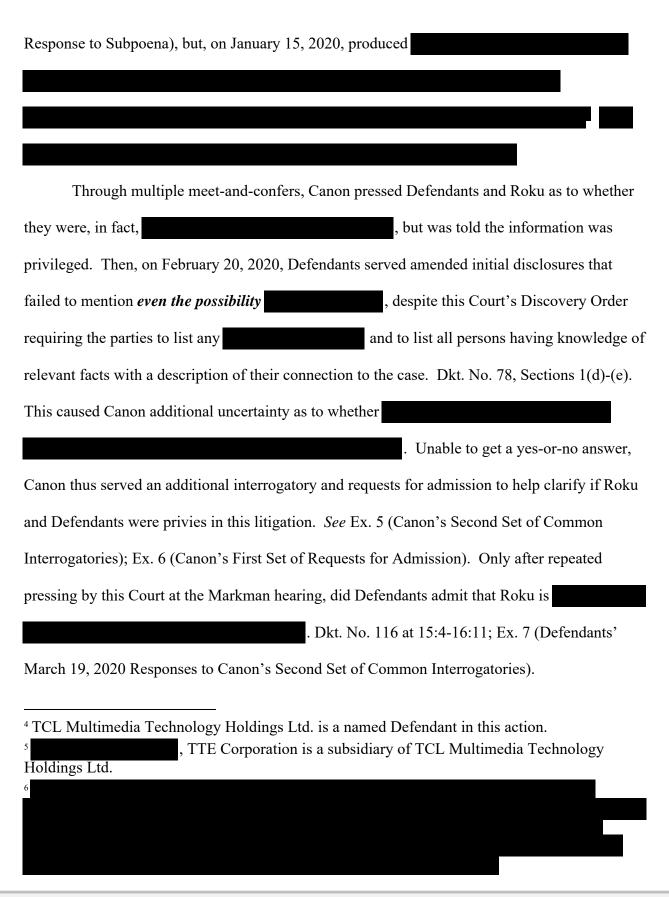
November 11, 2019. Ex. 1 at 15, RFP No. 60 (Nov. 11, 2019 Letter from Ozawa to Radsch providing RFPs); Ex. 2 at 29-30, RFP Nos. 18, 20 (Dec. 20, 2019 Roku Subpoena). On

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. See, e.g., Dkt.

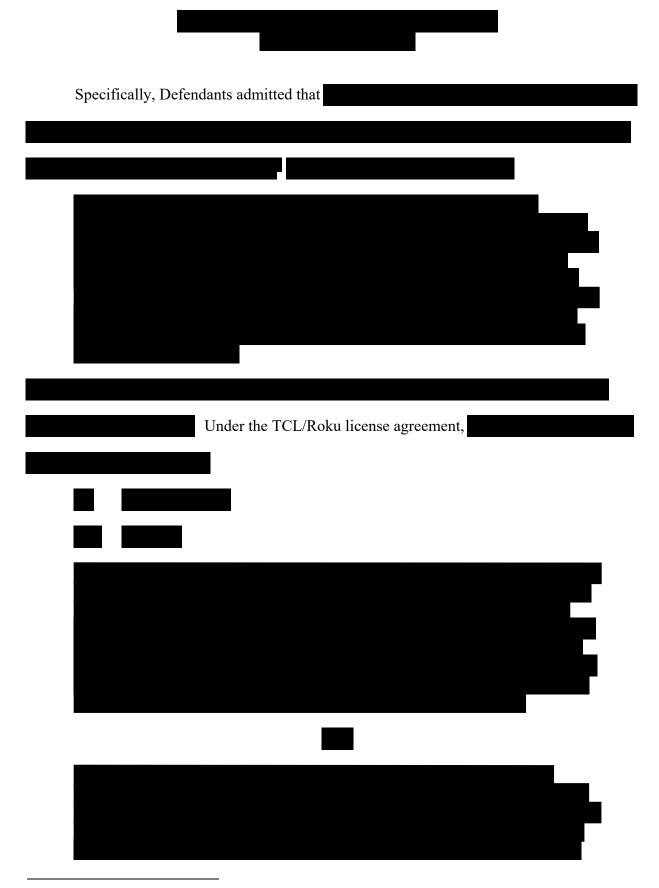
No. 91-14 (Ex. K, IPR2020-00357, Petition) at 9-10 ("Petitioner identifies the following companies as privies...."). Thereafter, Defendants (through its counsel, Ropes & Gray) spurned Canon's

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.





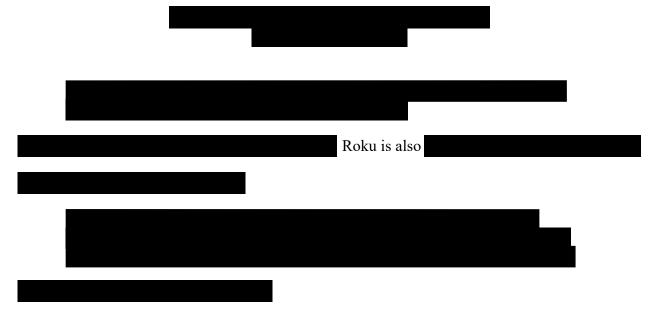




⁷ Dkt. No. 116 at 16:18 ("Now, Roku does supply the operating system to TCL").

⁸ Proceeding to list the exceptions noted in FN 6.





ARGUMENT

Roku is ______, 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 _______. 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, _______ 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, before this Court that the term does not include transmitted code sequences. Dkt. No. 91-14 (Ex. K, IPR2020-00357, Petition) at 22.

DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

