

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

CANON, INC.,

Plaintiff,

vs.

TCL ELECTRONICS HOLDINGS LTD., et
al.,

Defendants.

CIVIL ACTION NO. 2:18-cv-00546

JURY TRIAL DEMANDED

**PLAINTIFF CANON'S SECOND AMENDED PATENT RULE 3-1 AND 3-2
DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS**

Pursuant to Section 3(a)(i) of the Discovery Order (Dkt. No. 78), Plaintiff Canon, Inc. (“Canon”) serves a Second Amended Disclosure of Asserted Claims and Infringement Contentions and accompanying disclosure on Defendants TCL Electronics Holdings Ltd. (formerly known as TCL Multimedia Technology Holdings, Ltd.), TCL Corporation (“TCL Corp.”), Shenzhen TCL New Technologies Co. Ltd., and TCL King Electrical Appliances (Huizhou) Co., Ltd.’s (collectively, “TCL” or “Defendants”).

As contended in Canon’s initial September 6, 2019 Patent Rule 3-1 and 3-2 disclosures, a number of limitations of the Asserted Claims are software limitations, and these software limitations are performed by source code in the Roku, Inc. (“Roku”) OS running on all the accused TCL Roku TV products. Canon served a subpoena on Roku on December 20, 2019 that sought, *inter alia*, production of Roku’s source code relating to the accused functionalities. On January 17, 2020 Roku responded to Canon’s subpoena and indicated “it is not withholding any source code on account of its objections” to Canon’s subpoena. Beginning in early February, Roku made a number of productions of source code. Contrary to its representation in January,

Roku withheld a substantial amount of source code relating to the accused functionalities, and Canon identified specific and numerable deficiencies in Roku's productions. On February 19, Roku represented it intended to produce its full OS to address Canon's complaints, echoing its original representation in January.

Over the course of subsequent communications, Roku withdrew that representation, and did not produce any additional source code. As a result, Canon informed Roku it intended to bring a motion to compel production of the full Roku OS source code that Roku earlier represented it would produce. During a meet and confer on March 24, 2020, Roku again agreed to produce its full OS source code with "two security carve-outs" in view of Canon's anticipated motion to compel.

Because of various restrictions imposed by state governments due to the COVID-19 outbreak, the parties thereafter disputed the location and manner in which Roku's responsive source code would be produced. In particular, Roku sought to produce its source code in locations where Canon's retained source code experts were either unable to travel due to shelter-in-place orders or that would require the experts to expose themselves or at-risk members of their household to possible infection in order to travel to those locations. Disputes on the manner in which Roku produced its source code remain pending. *See, e.g.*, Dkt. No. 146 (Plaintiff Canon, Inc.'s Opposed Motion to Modify the Protective Order to Permit Remote Review of Source Code); Case No. 3:20-mc-80079 (N.D. Cal. May 4, 2020) (Roku, Inc.'s Motion to Modify and/or Quash Plaintiff Canon Inc.'s Subpoena and for a Protective Order to Prevent Remote Source Code Review ("Roku's motion to prevent remote source code review")). Despite Canon's complaints as to the manner and logistics of Roku's source code production, Canon diligently sought to inspect Roku's source code, including by retaining an additional source

code reviewer.

On April 15, 2020, despite its outstanding disputes, less than two weeks after Roku purportedly made its OS source code available for inspection, Canon first inspected Roku's production of source code it first promised in January. Canon confirmed that Roku's code production on April 15 contained hundreds of thousands more files than its earlier productions, including files relating to functionality requested numerous times by Canon. Canon has diligently continued its review of Roku's source code, including with its additional retained source code expert, and now provides its disclosure of source code that satisfies the software limitations of the Asserted Claims under section 3(a)(i) of the Discovery Order, 30 days after its first inspection of Roku's purported production of its full OS source code. *See, e.g., CXT Sys., Inc. v. Acad., Ltd.*, No. 2:18-c-171-RWS-RSP, at *2 (E.D. Tex. June 5, 2019).

These contentions are based on information reasonably available to Canon at this time. Canon's investigation of facts relevant to this case is ongoing. Further, important information about many or all of TCL's products is not publicly available, including information relevant to U.S. Patent Nos. 7,746,413 ("413 Patent"), 8,078,767 ("767 Patent"), 8,346,986 ("986 Patent"), 8,713,206 ("206 Patent"), and 7,810,130 ("130 Patent") (collectively, "Asserted Patents") and these Infringement Contentions. Canon, therefore, reserves the right to modify and/or supplement these disclosures as information becomes available, and/or based on positions taken by TCL.

For example, based on filings made in connection with Roku's motion to prevent remote source code review, it appears that source code and/or documentation relating to a "native development kit" made available to certain Roku partners, including Hulu, LLC, has not been provided to Canon. *See* Case No. 3:20-mc-80079 (N.D. Cal. May 13, 2020), Dkt. No. 19-1 at

3:23–4:1. The functionality allowed by Roku’s NDK appears to be relevant to at least receiving, playing, buffering, and accessing a URL of streaming content, all which were requests in Canon’s December 20, 2019 subpoena. *See id.* at 19-10 (Declaration of Brett Henry in support of brief of *amicus curiae* Hulu, LLC) ¶¶ 15–18. Canon reserves the right to further supplement its contentions under section 3(a)(i) of the Discovery Order in view of this new information.

A. P.R. 3-1(a): Identification of Asserted Claims

Based on the information presently available, Canon hereby discloses, for purposes of 3-1(a), the claims of each Asserted Patent that it contends are infringed (directly and/or indirectly, literally and/or under the doctrine of equivalents) by each of the Defendants, through their manufacture, use, sale, offer for sale, and/or importation into the United States of the accused products identified further below:

- ’413 Patent: Claims 1-2, 4-8, 10-11;
- ’767 Patent: Claims 1-3, 6, 7, 10-14;
- ’986 Patent: Claims 1-4, 6, 7, 9-11;
- ’206 Patent: Claims 1-5, 7-11, 13-14;
- ’130 Patent: Claims 1-8.

Canon expressly reserves the right to modify, amend and/or supplement the foregoing in light of new information made available to Canon, and/or based on positions taken by TCL.

B. P.R. 3-1(b): Identification of Accused Instrumentalities

For purposes of P.R. 3-1(b), and based on the information presently and publicly available, Canon hereby identifies the following Accused Instrumentalities of which it is currently aware:

- ’413 Patent, Claims 1-2, 4-8, 10-11: Accused products include, but are not limited to, the following TCL Roku TVs:
 - 3-series TV systems (e.g., 32S301; 40S303, 43S303, 49S303; 28S305, 32S305, 40S305, 43S305, 49S305; 32S321; 32S325, 40S325, 43S325,

- 49S325; 32S327);
- 4-series TV systems (e.g., 55S401, 65S401; 43S403, 49S403, 55S403, 65S403; 43S405, 49S405, 55S405, 65S405; 43S421, 50S421, 55S421, 65S421; 43S423, 50S423, 55S423, 65S423, 75S423; 43S425, 49S425, 50S425, 55S425, 65S425, 75S425);
- 5-series TV systems (e.g., 43S515, 49S515, 55S515, 65S515; 43S517, 49S517, 55S517, 65S517; 43S525, 50S525, 55S525, 65S525)
- 6-series TV systems (e.g., 55R615, 65R615, 75R615; 55R617, 65R617, 75R617; 55R625, 65R625)
- P6-series TV systems (e.g., 55P605; 55P607)
- C8-series TV systems (e.g., 55C803, 75C803; 55C807, 65C807, 75C807)
- S-series TV systems (e.g., 55US57; 55US5800, 65US5800; 32S3700, 48FS3700, 55FS3700; 28S3750, 32S3750, 40FS3750, 48FS3750, 55FS3750; 32S3800, 40FS3800, 50FS3800; 32S3850A, 32S3850B, 32S3850P, 32S3850, 40FS3850, 50FS3850, 55FS3850; 32FS4610R, 40FS4610R, 48FS4610R, 55FS4610R);
- P-series TV systems (e.g., 43FP110, 49FP110; 43UP120, 50UP120, 55UP120; 43UP130, 50UP130, 55UP130);
- 8-series TV systems (e.g., 65Q825, 75Q825).
- '767 Patent, Claims 1-3, 6, 7, 10-14: Accused products include, but are not limited to, the following TCL Roku TVs:
 - 3-series TV systems (e.g., 32S301; 40S303, 43S303, 49S303; 28S305, 32S305, 40S305, 43S305, 49S305; 32S321; 32S325, 40S325, 43S325, 49S325; 32S327);
 - 4-series TV systems (e.g., 55S401, 65S401; 43S403, 49S403, 55S403, 65S403; 43S405, 49S405, 55S405, 65S405; 43S421, 50S421, 55S421, 65S421; 43S423, 50S423, 55S423, 65S423, 75S423; 43S425, 49S425, 50S425, 55S425, 65S425, 75S425);
 - 5-series TV systems (e.g., 43S515, 49S515, 55S515, 65S515; 43S517, 49S517, 55S517, 65S517; 43S525, 50S525, 55S525, 65S525)
 - 6-series TV systems (e.g., 55R615, 65R615, 75R615; 55R617, 65R617, 75R617; 55R625, 65R625)
 - P6-series TV systems (e.g., 55P605; 55P607)
 - C8-series TV systems (e.g., 55C803, 75C803; 55C807, 65C807, 75C807)
 - S-series TV systems (e.g., 55US57; 55US5800, 65US5800; 32S3700, 48FS3700, 55FS3700; 28S3750, 32S3750, 40FS3750, 48FS3750, 55FS3750; 32S3800, 40FS3800, 50FS3800; 32S3850A, 32S3850B, 32S3850P, 32S3850, 40FS3850, 50FS3850, 55FS3850; 32FS4610R, 40FS4610R, 48FS4610R, 55FS4610R);
 - P-series TV systems (e.g., 43FP110, 49FP110; 43UP120, 50UP120, 55UP120; 43UP130, 50UP130, 55UP130);

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