

1 Jonathan D. Baker (SBN 196062)
2 DICKINSON WRIGHT RLLP
3 800 W. California Avenue, Suite 110
4 Sunnyvale, CA 94086
5 Telephone: (408) 701-6200
6 Facsimile: (844) 670-6009
7 jdbaker@dickinsonwright.com

Steven A. Caloiaro (SBN 284410)
DICKINSON WRIGHT PLLC
100 West Liberty Street, Ste. 940
Reno, NV 89501
Telephone: (775) 343-7500
Facsimile: (844) 670-6009
scaloiaro@dickinsonwright.com

6 Steven R. Daniels (SBN 235398)
7 Michael D. Saunders (SBN 259692)
8 DICKINSON WRIGHT PLLC
9 303 Colorado St., Ste. 2050
10 Austin, Texas 78701
11 Telephone: (512) 770-4200
12 Facsimile: (844) 670-6009
13 sdaniels@dickinsonwright.com
14 msaunders@dickinsonwright.com

15 *Attorneys for Defendant Roku, Inc.*

16
17 **UNITED STATES DISTRICT COURT**
18 **CENTRAL DISTRICT OF CALIFORNIA**

19 UNIVERSAL ELECTRONICS INC.,
20 a Delaware Company,

21 Plaintiff,

22 v.

23 ROKU, INC.,
24 a Delaware Company,

25 Defendant.

Case No. 8:18-cv-01580-JVS-ADS

**ROKU, INC.'S INITIAL
INVALIDITY CONTENTIONS AND
DOCUMENT PRODUCTION
(N.D. CAL. P.R. 3-3, 3-4)**



1 Pursuant to the Scheduling Order and N.D. Cal. Patent L.R. 3-3, Defendant
2 Roku, Inc. ("Roku" or "Defendant") hereby provides notice of Defendant's Initial
3 Invalidity Contentions, including by reference the entirety of the exhibits hereto,
4 for:

- 5 • Claims 1-6, 19, 22-25 of U.S. Patent No. 7,589,642 ("642 Patent"),
6 Claims 2-16 of U.S. Patent No. 8,004,389 ("389 Patent"), and Claims 1-
7 2, 4, and 7 of U.S. Patent No. 9,911,325 ("325 Patent") (collectively, the
8 "Mui Patents");
 - 9 • Claims 1-3 and 5-8 of U.S. Patent No. 9,716,853 ("853 Patent" or the
10 "Arling Patent");
 - 11 • Claims 1-6 and 8 of U.S. Patent No. 7,782,309 ("309 Patent"), Claims 1-
12 5, 7, 14-16, 18, 20, 21, and 27-29 of U.S. Patent No. 7,821,504 ("504
13 Patent"), and Claims 1, 2, 4-10, 12-14, 16-17, 19, 21, 38-42, 45-47, 49,
14 51, 52, 58, 69-76, 78, 79, 81, 83, and 84 of U.S. Patent No. 7,821,505
15 ("505 Patent") (collectively, the "Janik Patents");
 - 16 • Claims 10-12 of U.S. Patent No. 7,895,532 ("532 Patent") and Claims 1-
17 4 of U.S. Patent No. 8,015,446 ("446 Patent") (collectively, the "Scott
18 Patents");
- 19 (collectively "Asserted Claims").

20 As set forth in further detail below, Roku contends that each of the Asserted
21 Claims is invalid under at least 35 U.S.C. §§ 101, 102, 103, and/or 112. Roku
22 reserves the right to amend, modify and/or supplement these Initial Invalidity
23 Contentions based on, among other things, amendments, modifications or
24 supplements to Plaintiff's infringement contentions, further investigation, fact or
25 expert discovery and/or evaluation of the scope and content of the prior art,
26 disclosure of the parties' claim constructions, an order construing the Asserted
27 Claim(s), or any other basis contemplated by the Federal Rules of Civil Procedure,
28

1 the Court's Local Rules, and any other applicable order entered by the Court.

2 Roku's Initial Invalidity Contentions are based on information reasonably
3 available at this time with respect to the Asserted Claim(s), and are necessarily
4 preliminary and may require subsequent amendment, modification, and/or
5 supplementation. In particular, as Roku has explained to counsel for UEI, UEI's
6 infringement contentions are inadequate and fail to adequately apprise Roku of
7 UEI's infringement theories or where in the accused Roku products UEI alleges
8 the limitations of the claims are found. Accordingly, these contentions may
9 require amendment, modification and/or supplementation when UEI has provided
10 additional information regarding its contentions. Moreover, fact discovery is
11 ongoing and Roku has not obtained deposition testimony from any of the named
12 inventors of the Asserted Patents or any third party. To date, Roku has not
13 received from UEI a copy of any of the invalidity contentions served by any
14 defendant in any prior case in which UEI has asserted any of the Asserted Patents.
15 Accordingly, Roku incorporates by reference each such invalidity contention as if
16 fully set forth herein. Roku's investigation regarding the issues of infringement
17 and validity is therefore ongoing. These disclosures are made without prejudice to
18 Roku's right to supplement or amend its contentions as additional facts are
19 ascertained, analyses are made, research is completed, and/or claims are construed.
20 Roku expects further discovery will reveal additional prior art, including related
21 disclosures and corresponding evidence for many of the prior art references
22 identified below. As such, Roku has not yet completed its investigation, discovery
23 or analysis of matters relating to the infringement, validity, or enforceability of the
24 Asserted Claim(s), including, without limitation, invalidity due to on-sale statutory
25 bars, public use statutory bars or improper inventorship, or unenforceability due to
26 inequitable conduct. The disclosures herein are not and should not be construed as
27 a statement that no other persons have discoverable information, that no other

1 documents, data compilations, and/or tangible things exist that Roku may use to
2 support their claims or defenses, or that no other legal theories or factual bases will
3 be pursued. Accordingly, Roku reserves the right to amend, modify and
4 supplement these Initial Invalidity Contentions as additional information is
5 discovered, identified or otherwise appreciated, including testimony about the
6 Asserted Claims and the scope and content of the prior art.

7 Roku's Initial Invalidity Contentions should not be taken to mean that: (i)
8 Roku agrees with Plaintiff's bases for infringement; (ii) Roku agrees with Plaintiff
9 regarding the scope of any of the Asserted Claims; (iii) Roku agrees with
10 Plaintiff's claim constructions advanced expressly or implicitly by Plaintiff's
11 Infringement Contentions or in any other pleading, discovery request or response,
12 or written or verbal communication; (iv) Roku is precluded from propounding
13 alternative claim constructions or requesting Plaintiff's actual claim construction
14 positions in the future; or that (v) Roku agrees or believes that the claims at issue
15 are amenable to a meaningful construction or satisfy the requirements of 35 U.S.C.
16 § 112. Roku expressly reserves the right to propose and advocate for alternative
17 constructions to those apparently advocated by Plaintiff. In addition, nothing in
18 these Initial Invalidity Contentions shall be treated as an admission that any of
19 Roku's accused products meets any limitation of the Asserted Claims. Roku
20 denies that the accused products infringe any claim of the Asserted Patents. To the
21 extent that any prior art reference identified by Roku contains a claim element that
22 is the same as or similar to an element in an accused product, based on a claim
23 construction inferred from Plaintiff's infringement contentions, inclusion of that
24 reference in Roku's Invalidity Contentions shall not be deemed a waiver by Roku
25 of any claim construction or non-infringement position. Any use of these Initial
26 Invalidity Contentions to support any allegation of infringement would be
27 misleading, false and wrong as a matter of law and fact.

1 Unless otherwise specified, the Invalidity Contentions set forth herein are in
2 reliance on the alleged priority dates of the Asserted Patent(s) asserted by Plaintiff
3 in its Infringement Contentions. To the extent Plaintiff asserts entitlement to a
4 different priority date for prior art purposes, Roku reserves the right to amend these
5 contentions. Further, nothing in these contentions constitutes an admission
6 concerning the priority dates, conception date or reduction to practice of the
7 Asserted Claims of the Asserted Patents.

8 Roku reserves the right to amend these Initial Invalidity Contentions. The
9 information and documents that Roku produce are provisional and subject to
10 further revision as follows. Roku expressly reserve the right, consistent with the
11 Patent Rules, local rules, and the Court's orders, to amend these disclosures and
12 the accompanying document production should Plaintiff provide any information
13 that it failed to provide in its Infringement Contentions, or should Plaintiff amend
14 its Infringement Contentions in any way. Further, because discovery (including
15 discovery from third parties) is not complete, Roku reserves the right to, consistent
16 with the Patent Rules, local rules, and the Court's order, revise, amend, and/or
17 supplement the information provided herein, including identifying and relying on
18 additional prior art references, should Roku's further search and analysis yield
19 additional information or references. Moreover, Roku reserves the right to revise
20 its ultimate contentions concerning the invalidity of the asserted claims, which may
21 change, for example, depending upon the Court's construction of the Asserted
22 Claims, any findings as to the priority or invention date of the Asserted Claims,
23 and/or positions that Plaintiff or its expert witness(es) may take concerning claim
24 construction, infringement, and/or invalidity issues.

25 Prior art not included in this disclosure, whether known or unknown to
26 Roku, may become relevant. In particular, Roku is currently unaware of the extent,
27 if any, to which Plaintiff will contend that limitations of the asserted claims are not
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