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22 **UNITED STATES DISTRICT COURT**
23 **CENTRAL DISTRICT OF CALIFORNIA**

24 UNIVERSAL ELECTRONICS INC.,
25 a Delaware Company,

26 Plaintiff,

27 v.

28 ROKU, INC.,
a Delaware Company,

Defendant.

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

**ROKU'S REPLY IN SUPPORT OF
ITS MOTION TO SUPPLEMENT
INVALIDITY CONTENTIONS**

Judge: Hon. James V. Selna
Date: July 15, 2019
Time: 1:30 p.m.
Courtroom: 10C



1 **I. INTRODUCTION**

2 Earlier this year, Roku conducted an exhaustive search for prior art, spending
3 hundreds of hours of attorney and technical patent searcher time, and culminating in
4 hundreds of pages of charts attached to its initial invalidity contentions, which were
5 served on February 14, 2019. Approximately two months later, before *Markman*
6 briefing commenced, and months before the close of discovery, Roku discovered
7 four references related to those previously disclosed in its initial invalidity
8 contentions. Within two weeks of this discovery, Roku identified the references to
9 UEI and provided complete supplemental contentions for the four references.

10 Patent Local Rule 3-6 provides several specific examples of good cause to
11 allow supplementation of contentions, one of which is “recent discovery of material,
12 prior art despite earlier diligent search.” The undisputed facts show that Roku meets
13 this good cause standard, and UEI’s opposition brief fails to successfully challenge
14 those facts or to establish undue prejudice. Roku’s motion to supplement should be
15 granted.

16 **II. DISCUSSION.**

17 **A. Roku Was Diligent in Supplementing Its Invalidity Contentions**

18 Roku’s opening brief shows that Roku was diligent in bringing the
19 supplemental prior art references to UEI’s attention. Some (but not all) courts break
20 the diligence inquiry into two parts—diligence in supplementing invalidity
21 contentions after finding the prior art, and diligence in discovering the basis for the
22 supplemental contentions. *See, e.g., West v. Jewelry Innovations, Inc.*, C 07-1812
23 JF (HRL), 2008 WL 4532558, at *2 (N.D. Cal. Oct. 8, 2008).

24 UEI does not dispute that Roku’s supplementation was diligent under the first
25 prong—Roku provided notice of the supplemental prior art within three days of
26 finding it, and provided complete invalidity contentions, including invalidity claim
27 charts, within 10 days after that. UEI’s quarrel is solely with the second prong. But
28

1 none of UEI's cited cases stand for the proposition that supplementing infringement
2 contentions early in discovery, a little more than two months after serving initial
3 contentions, before claim construction briefing, and months before the close of
4 discovery, is anything other than diligent.

5 UEI's cited cases regarding diligence are either factually distinct because of
6 the lateness of the supplementation, or not on point legally. *See Symantec Corp. v.*
7 *Acronis Corp.*, Case No. 11-5310 EMC (JSC), 2013 WL 5368053, *3 (N.D. Cal.,
8 Sept. 25, 2013) (denying defendant's motion to amend invalidity contentions which
9 were filed on the day of the close of fact discovery); *O2 Micro Int'l Ltd. v. Monolithic*
10 *Power Sys., Inc.*, 467 F.3d 1355, 1367-68 (Fed. Cir. 2006) (affirming lower court's
11 denial of defendant's motion, made after the close of fact discovery, to amend
12 invalidity contentions and to modify schedule to allow additional discovery); *West*
13 *v. Jewelry Innovations, Inc.*, C 07-1812 JF (HRL), 2008 WL 4532558, at *3 (N.D.
14 Cal. Oct. 8, 2008) (denying defendant's motion to amend invalidity contentions
15 made after claim construction hearing and when hearing on motion was within 40
16 days of close of fact discovery); *Takeda Pharm. Co. v. TWI Pharms., Inc.*, Case No.
17 13-cv-012420-LHK, 2015 WL 1227817, at *5 (N.D. Cal. Mar. 17, 2015) (granting
18 motion to strike defendant's amended expert report, which included new theories
19 not in defendant's invalidity contentions); *Integrated Circuit Sys., Inc. v. Realtek*
20 *Semiconductor Co.*, 308 F. Supp. 2d 1106, 1107 (N.D. Cal. 2004) (denying
21 defendant's motion, made on the eve of the claim construction hearing, to compel
22 plaintiff to supplement initial disclosures to add new products plaintiff was now
23 accusing of infringement and stating that plaintiff must move to amend infringement
24 contentions if it wished to include the new products); *Finjan, Inc. v. Blue Coat Sys.*,
25 Case No. 5:13-cv-03999-BLF, 2014 WL 5305906, at *1 (N.D. Cal. Oct. 16, 2014)
26 (denying plaintiff's motion to amend infringement contentions filed after claim
27 construction briefing and about a year after complaint filed) (*see also* Allison Reply
28

1 Decl. Ex. 10 (selected pages of the *Finjan* docket with relevant filings marked)).

2 The case closest to the facts of this motion is this Court’s decision in *Glaukos*
3 *Corp. v. Ivantis, Inc.*, No. SACV 13-620 JVS (C.D. Cal. May 20, 2019) (Selna, J.)
4 (see Allison Reply Decl. Ex. 10). In that case, this Court allowed supplementation
5 of invalidity contentions early in discovery and before claim construction briefing.
6 As in this case, in *Glaukos*, the defendant’s “amendments are limited in substantive
7 scope, mostly serving to clarify and add detail to [defendant’s] existing theories of
8 invalidity.” *Glaukos*, at 2. Here, Roku is providing prior art having additional detail
9 about the already disclosed prior art products, e.g., Remote Commander,
10 PebblesDraw, SlideShow Commander, and Shortcutter for the Janik patents and the
11 TC 1000 product for the ’532 patent.

12 Other cases cited in Roku’s opening brief with similar facts include this
13 Court’s decision in *Dobeck v. Cobra Eng’g, Inc.*, No. SACV 16-1570 JVS, 2017
14 WL 8186769 (C.D. Cal. Apr. 12, 2017) (Selna, J.) and *Apple Inc. v. Samsung Elecs.*
15 *Co.*, No. CV 12-00630, 2012 WL 5632618, at *5 (N.D. Cal. Nov. 15, 2012). In both
16 cases, the courts allowed supplementation of contentions brought early in the case.
17 In its opposition, UEI did not even attempt to distinguish the *Glaukos*, *Dobeck*, or
18 *Apple* cases.

19 Roku had forty-five days between the identification of the asserted claims and
20 the deadline to search for relevant prior art and provide invalidity contentions and
21 claim charts on 108 asserted claims. For the Myers supplemental references, UEI
22 notes that the references were included on a list of publications on a website—and
23 acknowledged that this list included over 80 publications. For the ’532 patent
24 supplemental reference, UEI makes much of the fact that the ’374 patent was a cited
25 reference to the ’532 patent. Indeed, it was—along with 92 other references listed
26 on the patent. And the ’374 patent was indeed discussed in reexamination
27 proceedings—of two totally unrelated patents, the Janik ’504 and ’505 patents,

1 which have different inventors and cover unrelated technology. UEI falls far short
2 of overcoming Roku's showing of diligence, both on the law and on the facts.

3 **B. UEI Has Not Established Undue Prejudice**

4 UEI's sole claim to prejudice is that it chose its narrowed set of claims before
5 it saw Roku's supplementation (but three weeks *after* UEI received Roku's massive
6 initial invalidity contentions). But UEI does not provide any specifics regarding the
7 alleged prejudice. For example, UEI does not point out any alternative claims it
8 would have chosen, or any it would have dropped, or any other action it would have
9 taken had it had the supplemental contentions earlier. UEI simply states in a
10 conclusory fashion that it will be prejudiced by the supplementation. Such
11 conclusory allegations fall far short of demonstrating undue prejudice sufficient to
12 justify denying Roku's motion.

13 As for the Janik patents, UEI does not dispute that the prior art products
14 discussed in the Myers prior art reference in the initial invalidity contentions
15 (Remote Commander, Pebblesdraw, SlideShow Commander, and Shortcutter) are
16 the same prior art products discussed in the supplemental Myers references. UEI
17 instead refers (sometimes incorrectly) to a handful of differences in the supplemental
18 invalidity charts as compared to the initial charts. First, such differences alone,
19 without being tied to some alleged harm to UEI, do not establish prejudice. But what
20 is notable is how *few* such examples UEI can find, demonstrating how the
21 supplemental contentions add only additional details to the products disclosed in the
22 initial Myers and TC 1000 references. For example, for the '309 and '504 patents,
23 UEI points to one difference between initial and supplemental charts for each patent.
24 For the '505 patent, UEI alleges, incorrectly, that claim 10 in the initial invalidity
25 chart for the Myers reference reads "NA." It does not. In fact, it gives a lengthy
26 citation from page 37 of the Myers prior art reference. *See* Allison Reply Decl. Ex.
27 11, at 10. UEI is correct in stating that the supplemental invalidity contentions for
28

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