IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

IOENGINE, LLC *
* September 19, 2023
VS. *
* CIVIL ACTION NO. 6:21-CV-1296
ROKU INC. *

BEFORE THE HONORABLE ALAN D ALBRIGHT
PRETRIAL CONFERENCE

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09:12 1 (Hearing begins.)
09:12 2 DEPUTY CLERK: Court calls Waco
09:12 3 21-CV-1296, IOENGINE, LLC versus Roku, Inc. for a final
09:12 4 pretrial conference.
09:12 5 THE COURT: If I could have announcements
09:12 6 from counsel, please, starting with plaintiff.
09:12 7 MR. UNDERWOOD: Good morning, Your Honor.
09:12 8 Travis Underwood on behalf of the plaintiff. I'm
09:12 9 joined this morning by Mr. Noah Leibowitz, Mr. Greg
09:12 10 Chuebon, and Mr. Michael Joshi.
09:13 11 And we're ready to proceed with the
09:13 12 pretrial conference.
09:13 13 THE COURT: Good morning.
09:13 14 Yes, sir.
09:13 15 MR. DEACONSON: Good morning, Your Honor.
09:13 16 Dave Deaconson. I'm here on behalf of Roku. And
09:13 17 participating today in handling a large part of the
09:13 18 pretrial will be Tia Fenton, Christopher Ricciuti, Matt
09:13 19 Gaudet. And then depending on how the Court's pleasure
09:13 20 on MILs, Holly Engelmann will handle the MILS such as
09:13 21 they are.
09:13 22 And then we also have Lisa Mandrusiak as
09:13 23 the representative for Roku.
09:13 24 And finally but certainly not least is
09:13 25 Elissa Sanford who will be handling our technical

09:13 1 stuff.
09:13 2 THE COURT: I apologize for getting a
09:13 3 late start. We were in the back trying to figure out
09:13 4 our schedule because you all are a backup case in --
09:13 5 for your current trial setting, which in -- it appears
09:13 6 to us the case in front of you is going to go.
09:14 7 And so it looks like we're going to push
09:14 8 the trial -- have to push this trial back to early fall
09:14 9 (sic). I think that's the consensus.
09:14 10 We have a criminal trial also in October
09:14 11 that I'm dealing with, unusually for me. They usually
09:14 12 do settle or plead, but this one I don't think will and
09:14 13 we have to do some other stuff in it.
09:14 14 So it looks like this trial will be
09:14 15 pushed back. We'll set it for as early in the spring
09:14 16 as we want it.
09:14 17 Now, I'm happy if you all wanted to -- it
09:14 18 would take both of you, if both of you wanted to stay
09:14 19 as backup, you know, and go through that expense, you
09:14 20 know, that's, you know, really up to you all.
09:14 21 But it makes more sense for me to make
09:14 22 you all first on my docket in the spring than hold you
09:15 23 backup for another trial that looks like it will go.
09:15 24 But if either side would like to say that they want to
09:15 25 keep it on the backup docket, I'm happy to hear that.

09:15 1 MR. LEIBOWITZ: Thank you, Your Honor.
09:15 2 I think we would confer with our client
09:15 3 and see what the client's preference is. Right now if
09:15 4 Your Honor could keep us on this for the time being, I
09:15 5 think we would appreciate it, Your Honor. Certainly if
09:15 6 that case did not settle, we would be ready to go.
09:15 7 THE COURT: Well, as of the today, it's a
09:15 8 fairly metaphysical thing, but...
09:15 9 And so -- but let me hear from the
09:15 10 defendant.
09:15 11 MR. DEACONSON: Your Honor, Roku would
09:15 12 prefer a hard date in the spring versus a backup just
09:15 13 because of all of the planning, the costs, and all that
09:15 14 that would be necessarily incurred. It just makes
09:15 15 sense to have a hard date where we all know we're going
09:15 16 to go.
09:15 17 THE COURT: Yeah. I think that's what we
09:15 18 should probably do, and we'll get you a date as soon as
09:15 19 we can.
09:15 20 So that will -- also, the reason I'm
09:16 21 bringing that up at the beginning is because it will
09:16 22 have an -- probably have an impact -- not probably. It
09:16 23 will have an impact on some of the motions to leave to
09:16 24 supplement expert reports now that the trial date will
09:16 25 be later.

09:16 1 With regard to Roku's motion for leave to
09:16 2 serve supplemental expert reports, because I'm pushing
09:16 3 this back, I'm going to grant that.
09:16 4 With regard to the plaintiff's motion to
09:16 5 strike new fact and arguments raised in reply or
09:16 6 alternate for leave, I'm going to deny that.
09:16 7 With regard to Roku's motion for leave to
09:16 8 serve expert reports of Kindler and Russ, I'm going to
09:16 9 grant that.
09:16 10 Okay. Now I need to take up, though --
09:16 11 first, I have at least a motion for summary judgment of
09:17 12 no invalidity. Do I have also -- let me look -- motion
09:17 13 for -- do I have a motion for invalidity as well?
09:17 14 I think what I'm going to do is take up
09:17 15 the motion -- I'm going to do it in that direction.
09:17 16 Is the motion for invalidity also under
09:17 17 Section 101?
09:17 18 Okay. Well, then let me hear from the
09:17 19 plaintiff first on their motion of no invalidity due to
09:17 20 Section 101.
09:17 21 MR. LEIBOWITZ: Thank you, Your Honor.
09:17 22 Noah Leibowitz for IOENGINE.
09:17 23 THE COURT: Remind me where you practice.
09:17 24 MR. LEIBOWITZ: Where I practice, Your
09:17 25 Honor, New York.

1 THE COURT: Very good.
09:17 2 MR. LEIBOWITZ: But I will try to speak
09:17 3 slowly.
09:17 4 THE COURT: Well, you can't do worse than
09:18 5 the lawyers yesterday, so...
09:18 6 MR. LEIBOWITZ: Thank you, Your Honor.
09:18 7 And just to be clear, Your Honor, I
09:18 8 believe there is a motion for invalidity that
09:18 9 defendants will be presenting, but it's not one under
09:18 10 Section 101.
09:18 11 THE COURT: That's the way I took it.
09:18 12 MR. LEIBOWITZ: Under 101 is for no
09:18 13 invalidity. And as we explain in our brief, Your
09:18 14 Honor, in two prior cases involving parent patents to
09:18 15 the patents in -- to patents-in-suit in this case, the
09:18 16 courts found the claims not invalid under the first
09:18 17 step of Alice, the Alice Section 101 analysis, because
09:18 18 they're not directed to an abstract idea.
09:18 19 And the same holds true here, Your Honor.
09:18 20 In the first case, this is our first slide, Judge Sleet
09:18 21 in the District of Delaware found as a matter of law
09:18 22 that the claims recite a specific arrangement of
09:18 23 components and a very specific implementation and
09:18 24 structure of the executable program code.
09:18 25 And Judge Sleet also found the claims are

09:19 1 directed to addressing a specific technological problem
09:19 2 in then-existing computing environments.
09:19 3 In the second case in Delaware, Judge
09:19 4 Bryson, sitting by designation, also had a Section 101
09:19 5 motion and found the claims in the parent patents in
09:19 6 that case again not invalid under Section 101 under the
09:19 7 first step of Alice, finding that the claims are
09:19 8 directed to a novel computer architecture that's
09:19 9 designed to provide benefits because of the claim
09:19 10 structures of the computing elements, and that
09:19 11 IOENGINE's patents do not recite the use of
09:19 12 conventional computer components as a tool to
09:19 13 accomplish other objectives set forth in abstract
09:19 14 terms, and that there's sufficient structure in the
09:19 15 claims to ensure that IOENGINE is not simply laying
09:19 16 claim to an end result rather than to the process or
09:19 17 machinery employed to achieve that result.
09:19 18 And the claims -- just to be clear, the
09:20 19 claims in those parent patents in those cases, those
09:20 20 patents share an identical specification to the
09:20 21 patents-in-suit here. It's a direct line of
09:20 22 continuations. And they have claims that are
09:20 23 structured very similarly to the claims that are
09:20 24 asserted in this case, Your Honor.
09:20 25 We have -- we put it in our briefing, but

09:20 1 we have a slide comparing the independent claim on the
09:20 2 left here in the '584 patent. That's one of the
09:20 3 independent claims that forms the basis for certain of
09:20 4 the dependent claims here. And on the right side, the
09:20 5 independent claim from the '969 patent, one of the
09:20 6 grandparent patents, that were at issue before Judge
7 Bryson.
09:20 8 And you can see the structure of the
09:20 9 claim is very similar. We've obviously excerpted this
09:20 10 a bit. But they talk about a portable device,
09:20 11 communicating with a terminal. The portable device has
09:20 12 a processor. It has a communications interface. It
09:20 13 has memory, and it has certain program codes that are
09:21 14 specifically set out and recite particular
09:21 15 functionality for what the particular devices need to
09:21 16 execute.
09:21 17 And the prior holdings in those cases,
09:21 18 Your Honor, we submit, provide strongly persuasive
09:21 19 authority, although obviously not binding on Your
09:21 20 Honor, but persuasive that the asserted claims that are
09:21 21 asserted here are also directed to patent-eligible
09:21 22 subject matter.
09:21 23 As Judge Bryson held in the case before
09:21 24 him, although when he was referring to the Judge Sleet
09:21 25 case: Although the instant cases involved different

09:21 1 patents than the one involved in the Interactive Media
09:21 2 case -- that's the Judge Sleet case -- the patents are
09:21 3 from the same family, share a common specification, and
09:21 4 are directed to the same general subject matter.
09:21 5 Accordingly, Judge Sleet's analysis is directly
09:21 6 applicable here and I find his opinion to be persuasive
09:21 7 as to this issue.
09:21 8 And we would submit the same would hold
09:21 9 true here with respect to patents that again are from
09:22 10 the same family, share the same common specification,
09:22 11 directed to the same subject matter, and with claims
09:22 12 that are structured very similarly to those that were
09:22 13 at issue before Judge Sleet and Judge Bryson.
09:22 14 Moreover, Your Honor, as the -- our
09:22 15 briefing sets out, Judge Sleet and Judge Bryson were
09:22 16 correct. As we cite in our briefing, there are a
09:22 17 number of cases from the Federal Circuit that are
09:22 18 instructive.
09:22 19 I'm sure Your Honor's familiar with the
09:22 20 Enfish case, the Phillips case, and I added the case
09:22 21 from this Court the Slyce Acquisition case talking
09:22 22 about the focus of the claims being on an asserted
09:22 23 improvement rather than a process that qualifies as an
09:22 24 abstract idea.
09:22 25 And the claims here do not merely invoke

09:22 1 a computer as a tool for a well-known offline business
09:22 2 practice or just set out a mathematical formula or idea
09:22 3 and say, apply it to a computer.
09:22 4 Each of the claims in the asserted
09:22 5 patents here sets out a three-part structure with a
09:23 6 specific arrangement of hardware and purposefully
09:23 7 allocated program code to distribute computing
09:23 8 functions between devices: The portable device, which
09:23 9 has its own processor, and the terminal which the
09:23 10 parties agree, at a minimum, is a computing device.
09:23 11 And the purpose of the arrangement is to
09:23 12 improve upon then-existing computing devices. As the
09:23 13 specification explains: At the time of the invention,
09:23 14 there was no effective solution -- this is a quote from
09:23 15 the spec -- no effective solution to securely access,
09:23 16 execute, and process data is available in an extremely
09:23 17 compact form. Currently PDAs, which are considered
09:23 18 among the smallest portable computing solution, are
09:23 19 bulky, provide uncomfortably small user interfaces, and
09:23 20 require too much power to maintain their data.
09:23 21 No solution exists that allows users to
09:23 22 employ traditional large user interfaces they are
09:23 23 already comfortable with, provides greater portability,
09:23 24 provides greater memory footprints, draws less power,
09:24 25 and provides security for data on the device.

09:24 And the specification solves this problem with a distributed computing environment and architecture that's recited in the claims, including the portable device with its own processing capabilities and its own memory and the specific distribution of the program codes that are recited in the claims.

The computing and the processing resources are allocated between the portable device and the terminal and driven by the claimed program codes to accomplish and in contrast to the then-executing bulky and uncomfortable devices.

Now, Roku's argument in their -- in their opposition to our motion is that in those other cases, the Judge Sleet case and the Judge Bryson case, the claimed arrangement was nonabstract only because the portable device relied on the terminal's network interface to "tunnel to the network."

Whereas, in the asserted claims here, the portable device has its own network interface. And it does. One of the elements of the portable device in these claims is its own network interface.

But, Your Honor, Roku's argument doesn't make any sense for a few reasons.

First, Roku is essentially arguing that

09:25 1 adding a piece of hardware to a device, in this case a
09:25 2 network interface, to an otherwise nonabstract claim
09:25 3 somehow transforms that claim into something that is
09:25 4 abstract.
09:25 5 Roku doesn't cite any case supporting
09:25 6 such a notion, and we're not aware of any case that
09:25 7 would support the idea that adding a piece of hardware
09:25 8 to an otherwise nonabstract claim to a device would
09:25 9 then transform that claim into something that is
09:25 10 abstract.
09:25 11 Now, Roku argues that by no longer
09:25 12 "tunnelling" through the terminal, the claims read on
09:25 13 the prior art. Well, we -- certainly we dispute that
09:25 14 as a matter of the prior art.
09:25 15 But we also dispute what Roku means when
09:25 16 it refers to tunnel as discussed in the specification.
09:26 17 In Roku's opinion, "tunnelling" means
09:26 18 that the portable device has to go through the terminal
09:26 19 to get to the network. Right? Here's Roku's
09:26 20 conception. You have a portable device in the middle,
09:26 21 a network on the left, and a terminal on the right, and
09:26 22 the portable device has to go through the terminal to
09:26 23 get to the network.
09:26 24 But the problem for Roku is that's not
09:26 25 what the specification says when it talks about

09:26 1 tunnelling. When the specification talks about
09:26 2 tunnelling, it starts from the perspective of the user,
09:26 3 and here's the relevant quote: Thus to the user, the
09:26 4 contents of the TCAP -- that's the way the
09:26 5 specification refers to the portable device.
09:26 6 Thus to the user, the contents of the
09:26 7 TCAP appear on the AT -- that's the terminal -- as
09:26 8 being contained on the TCAP even though much of the
09:26 9 contents may actually reside on the servers and/or the
09:26 10 servers' storage facilities. In these ways, the TCAP
09:26 11 tunnels data through an AT.
09:26 12 The data may be provided through the
09:27 13 terminal's input/output for the user to observe it
09:27 14 without it actually residing on the terminal.
09:27 15 Also, the portable device may tunnel data
09:27 16 through a terminal across a communications network to
09:27 17 access remote servers without requiring its own more
09:27 18 complicated set of peripherals.
09:27 19 So the specification talks about what it
09:27 20 means to tunnel through a terminal. It's that the --
09:27 21 in these ways, the portable device tunnels through the
09:27 22 terminal. It is data that is provided from the
09:27 23 portable device to the user through the terminal's, for
09:27 24 example, output component displayed on the terminal
09:27 25 screen for the user to observe without the data

09:27 1 actually residing on the terminal.
09:27 2 And the data appears on the terminal as
09:27 3 if it's contained on the portable device even though
09:27 4 much of the contents might actually reside up in the
09:27 5 network on a server.
09:27 6 So the portable device tunnels data from
09:27 7 the server through the terminal to the user.
09:28 8 Here's the configuration that we submit
09:28 9 as what the specification is talking about. You have a
09:28 10 portable device that's tunnelling data from a network
09:28 11 through a terminal to a user.
09:28 12 Now, Roku also argues that the claims are
09:28 13 no different than a laptop connected to an external
09:28 14 monitor. But, again, we also disagree with that.
09:28 15 The patents distinguish between monitors,
09:28 16 for example, analog displays that have no computing
09:28 17 ability and what the patent -- that which the patent
09:28 18 calls and refers to as peripheral devices, and
09:28 19 terminals which are themselves computing devices as
09:28 20 even Roku recognized.
09:28 21 The Court at Markman explained that
09:28 22 plaintiff agrees with defendant that terminal is a
09:28 23 computing device.
09:28 24 And in some of its briefing, Roku tries
09:28 25 to run away from the agreement that terminal is a

09:28 1 computing device. But here's what Roku's counsel said
09:28 2 at the Markman hearing.
09:28 3 And so as Your Honor indicated, the only
09:28 4 term that we'll be discussing today is the "terminal"
09:28 5 term. And now the parties agree that "terminal" needs
09:29 6 to be construed at a minimum as a computing device.
09:29 7 So there's agreement that a terminal is a
09:29 8 computing device, not just an analog monitor that has
09:29 9 no computing capabilities. And that's the way the
09:29 10 patents use the term and the way the claims use the
09:29 11 term.
09:29 12 And so at least as a matter of judicial
09:29 13 estoppel, Roku should not be allowed to back away from
09:29 14 this agreement as to what "terminal" means now. So
09:29 15 simply construing a -- connecting a laptop to an
09:29 16 external monitor does not result in the claimed
09:29 17 configuration. The claims are to a portable device
09:29 18 communicating with another computing device; that's the
09:29 19 terminal.
09:29 20 But the bigger issue for Roku is that
09:29 21 none of that matters for the Section 101 purposes.
09:29 22 This motion is not an obviousness motion. It's not a
09:29 23 motion for no invalidity over a combination of art that
09:29 24 includes a laptop and a monitor.
09:29 25 The point here is that adding a network

09:29 1 interface to a nonabstract portable device claim
09:30 2 doesn't make it abstract.
09:30 3 The two prior Section 101 decisions
09:30 4 finding the claims not abstract were not based in any
09:30 5 way on the requirement that the portable device tunnel
09:30 6 through the terminal, much less that tunnelling
09:30 7 requires using the terminal's network interface.
09:30 8 Instead, they were based on the
09:30 9 specifically recited hardware on the different devices
09:30 10 in the -- e.g. the processors, the memory, and the
09:30 11 specifically recited program codes setting up a
09:30 12 distributed computing relationship.
09:30 13 Moreover, the supposedly abstract idea
09:30 14 that Roku points to on Page 9 of its opposition is the
09:30 15 abstract idea, and I'm quoting here: The abstract idea
09:30 16 of a portable device communicating with a network and
09:30 17 displaying its output on a separate device. That's how
09:30 18 they characterize the abstract idea.
09:30 19 And first of all, Your Honor, that may be
09:30 20 a -- kind of a high level summary of how a device might
09:30 21 work, but that's not an abstract idea. That doesn't
09:31 22 comport with the other types of abstract ideas that
09:31 23 this Court or the Federal Circuit has found ineligible
09:31 24 for patent protection under Section 101.
09:31 25 But second of all, that's the -- exactly

09:31 1 the kind of generalization, when you read what Roku
09:31 2 writes in terms of a portable device communicating with
09:31 3 a network and displaying its output on a separate
09:31 4 device, that's exactly the kind of generalization the
09:31 5 Federal Circuit has explained is not suited to the
09:31 6 Section 101 analysis.
09:31 7 And the Federal Circuit held in the McRO
09:31 8 case: We have previously cautioned that courts must be
09:31 9 careful to avoid oversimplifying the claims by looking
09:31 10 at them generally and failing to account for the
09:31 11 specific requirements of the claims.
09:31 12 Roku's generalization doesn't take into
09:31 13 account the program codes, the specifically set out
09:31 14 hardware with respect to each device, or the
09:31 15 distributed computing architecture. And this case, the
09:31 16 McRO case, that's one that Judge Sleet cited in his
09:31 17 analysis and that bears citing here.
09:31 18 The asserted claims pass muster under
09:32 19 Alice Step 1. And the Court does not need to go any
09:32 20 further to grant IOENGINE's motion.
09:32 21 To the extent the Court reaches Alice
09:32 22 Step 2, as our briefing sets out, the Federal Circuit
09:32 23 has also found claims nonabstract under Alice Step 2 in
09:32 24 very similar circumstances.
09:32 25 For example, in the Amdocs case, the

09:32 1 Federal Circuit held there was an inventive concept
09:32 2 recited in computer codes, "computer code" with
09:32 3 specific functionality. And that's just like the
09:32 4 claimed program codes here.
09:32 5 The Federal Circuit held that although
09:32 6 the solution requires arguably generic components, the
09:32 7 generic components operate in an unconventional manner
09:32 8 to achieve an improvement in computer functionality.
09:32 9 And in particular, the Amdocs Court
09:32 10 pointed, in that case, to the invention's distributed
09:32 11 architecture and the components working together in a
09:32 12 distributed manner. That's exactly the way the claims
09:32 13 are set up here with respect to different devices
09:32 14 working in a coordinated manner in executing the claim
09:32 15 program codes.
09:33 16 This Court's cases in Polaris Innovation
09:33 17 and the Meetrix IP case, which we cite in our brief on
09:33 18 Page 11, the opening brief are to the same effect.
09:33 19 And although he didn't need to reach
09:33 20 Alice Step 2 either, Judge Sleet did -- he said that
09:33 21 the Court's -- the claims pass muster under Alice Step
09:33 22 1 and didn't need to reach Alice Step 2. But if he
09:33 23 did, he would also find that the claims recite --
09:33 24 recited -- excuse me -- an inventive concept for this
09:33 25 reason.

09:33 1 Roku launches in another Section 103
09:33 2 attack with its laptop plus monitor combination and a
09:33 3 long line of what Mr. McNulty, the inventor here,
09:33 4 supposedly did not invent.
09:33 5 But even crediting Roku's argument, the
09:33 6 Federal Circuit has explained that the inventive
09:33 7 concept inquiry requires more than recognizing that
09:33 8 each element by itself was known in the art.
09:33 9 This has to be the case, because
09:33 10 otherwise the Section 101 analysis would simply devolve
09:34 11 into Section 102 or 103.
09:34 12 And nor is there any kind of user
09:34 13 interface exception to Section 101, as Roku intimates
09:34 14 on Page 12 of its opposition. Rather, the asserted
09:34 15 claims here recite the inventive concept of a portable
09:34 16 device with its own processor configured to execute
09:34 17 specified program code in response to communications
09:34 18 resulting from user interaction with a interactive user
09:34 19 interface on a terminal, which itself is a computing
09:34 20 device.
09:34 21 That's exactly the type of specificity
09:34 22 the Federal Circuit found in the Bascom case to satisfy
23 Alice Step 2.
09:34 24 Finally, Your Honor, and last, Roku
09:34 25 cannot avoid summary judgment under Section 101 by

09:34 1 reference to its conclusory expert report from
09:34 2 Dr. Russ.
09:34 3 Dr. Russ spends barely three pages in his
09:34 4 report on Section 101. He doesn't offer any factual
09:34 5 support for any of his statements. He doesn't cite to
09:34 6 any parts of the patent specification. He doesn't
09:34 7 reference the asserted claims or any technical
09:34 8 literature or any documents.
09:35 9 He has exactly one cite in the section of
09:35 10 his report and that's Mr. McNulty, the inventor's,
09:35 11 testimony. None of which related to any discussion of
09:35 12 what was conventional at the time of the invention in
09:35 13 2001 or at the time of the patent filing in 2004.
09:35 14 So we submit, Your Honor, that this Court
09:35 15 should find as a matter of law that the asserted claims
09:35 16 here satisfy Section 101 and are patent eligible as a
09:35 17 matter of law and grant IOENGINE'S motion for summary
09:35 18 judgment.
09:35 19 Thank you, Your Honor.
09:35 20 THE COURT: A response? And if you all
09:35 21 want to, maybe different people take up the motion for
09:35 22 invalidity at the same time, I'm happy for that as
09:35 23 well. If it's two people, I'm fine for that.
09:36 24 MR. RICCIUTI: May it please the Court.
09:36 25 Christopher Ricciuti on behalf of defendant Roku.

09:36 1 And just make sure I get the laptop
09:36 2 connection here. Connected.
09:36 3 Here we go. We had the wrong one.
09:36 4 So again, Your Honor, Christopher
09:36 5 Ricciuti on behalf of defendant Roku. And may it
09:36 6 please the Court.
09:36 7 I will be addressing the 101 portion of
09:36 8 invalidity, and then my colleague Mr. Gaudet will be
09:36 9 addressing the written description invalidity portion
09:36 10 of the argument here today.
09:36 11 So the crux of IOENGINE's 101 argument
09:36 12 was that 101 was adjudicated in two prior suits and
09:36 13 that this Court should therefore do the same. The
09:36 14 problem with this argument however, Your Honor, is that
09:36 15 those prior cases involve entirely different claims
09:37 16 with entirely different scope.
09:37 17 When you look at those claims and you
09:37 18 look at the claims here and the broad scope of
09:37 19 infringement allegations, you'll see that there is
09:37 20 certainly no computer improvement like you may have had
09:37 21 in the Federal Circuit Enfish or McRO; rather, you have
09:37 22 an abstract idea and nothing more.
09:37 23 And so that gets us to the second slide
09:37 24 here, Your Honor, and that specific abstract idea is a
09:37 25 portable computing device communicating with a network

09:37 1 and displaying its output on a separate device, which
09:37 2 the patent calls a "terminal."
09:37 3 Now, this is no different than what
09:37 4 counsel for both Roku and IOENGINE did today and
09:37 5 countless other counsels have done before you for years
09:37 6 when they come into your courtroom.
09:37 7 They take their Internet-enabled laptop.
09:37 8 They stick it on to the counsel's table. They get a
09:37 9 cord, and they plug it in so that what is happening on
09:37 10 the laptop, you can see on the screen here.
09:37 11 That is not a computer improvement but an
09:38 12 abstract concept that Mr. McNulty cannot lay claim to.
09:38 13 And counsel for IOENGINE tries to shove
09:38 14 off the fact that Mr. McNulty, the purported inventor
09:38 15 of IOENGINE'S patents here, he did not invent portable
09:38 16 devices. There's no allegations that he has and he
09:38 17 doesn't -- he admits that he didn't invent them.
09:38 18 He didn't invent Internet connectivity
09:38 19 and he did not invent terminals. So simply having a
09:38 20 claim where you connect these things together in an
09:38 21 abstract way is not an improvement to computers.
09:38 22 If we turn to Slide 3, Your Honor, you
09:38 23 can take a look at some of the specific language that
09:38 24 counsel for IOENGINE focuses on.
09:38 25 If you look at Claim 184 on the left, you

09:38 1 see it recites a terminal. And before I get to the
09:38 2 terminal point, I just want to note that I think there
09:38 3 is a fundamental dispute between whether Roku agrees
09:38 4 that a terminal is a computing device, full stop.
09:39 5 We've always taken the position that a terminal cannot
09:39 6 just be defined as a computing device.
09:39 7 If you define it as solely a computing
09:39 8 device and you don't actually clarify what that means
09:39 9 per the specification, that would be an improper
09:39 10 construction. And so there is no agreement that you
09:39 11 can say computing device and that is enough for the
09:39 12 definition of terminal.
09:39 13 But what does Claim 184 say? Well, it
09:39 14 says you have a terminal comprising an output component
09:39 15 configured to present an interactive user interface
09:39 16 comprising at least one user interface element.
09:39 17 What does that mean? You have a device
09:39 18 that has a screen and you present an interactive user
09:39 19 interface on that screen.
09:39 20 That is nothing more than simply saying
09:39 21 you plug a laptop, you could plug a desktop computer, a
09:39 22 DVD player, a PDA into another device that has a
09:39 23 screen. Saying that you're doing it on a terminal
09:39 24 cannot possibly make the claims any less abstract.
09:40 25 And now, in the '584 patent, counsel did

09:40 1 not bring this up today, but in the briefing, they
09:40 2 argue about the fact the '584 patent recites a key
09:40 3 exchange between the terminal and the portable device.
09:40 4 The only thing that a key exchange is is
09:40 5 a way to establish trust between these two devices.
09:40 6 And all this claim simply says is that -- perform a key
09:40 7 exchange. It doesn't give any details on how the key
09:40 8 exchange is performed, and there's absolutely no
09:40 9 allegation that Mr. McNulty invented any sort of new
09:40 10 type of key exchange or any unique key exchange that
09:40 11 would be an improvement to computers.
09:40 12 And so the claims here are nothing more,
09:40 13 again, than an abstract idea if you have a portable
09:40 14 device that can connect to a separate device and what's
09:40 15 happening on a portable device, you can go ahead and
09:40 16 see it on the screen of the terminal.
09:40 17 That is an abstract idea and the claims
09:40 18 add nothing more to that. And again, that is not an
09:41 19 improvement to computers. People have been doing that
09:41 20 in your courtroom for likely decades. It's just the
09:41 21 way people use electronic devices.
09:41 22 And the pieces and parts that allow that
09:41 23 to happen were not invented by Mr. McNulty, and there's
09:41 24 no allegations to the contrary from IOENGINE.
09:41 25 And so because we do have an abstract

09:41 1 idea here, we believe that the inventive concept should
09:41 2 go to the jury as this Court has done in at least two
09:41 3 other cases, the Freshub v. Amazon case which is
09:41 4 21-CV-511 -- Docket 253, I believe, is the jury
09:41 5 instruction there -- and then Sure (sic) v. Google,
09:41 6 it's 19-CV-663 at Docket 217 where again this Court has
09:41 7 allowed the inventive concept question to go to the
09:41 8 jury. And that is what we're asking here.
09:41 9 Quickly we can turn to that inventive
09:41 10 concept, and that is on Slide 4.
09:41 11 And so IOENGINE's purported inventive
09:42 12 concept is a processor on a portable device -- and I'm
09:42 13 quoting from their briefing. This is Docket No. 255 at
09:42 14 8. A processor on a portable device configured to
09:42 15 execute specified program code in response to
09:42 16 communications resulting from user interaction with an
09:42 17 interactive user interface on a terminal.
09:42 18 But the glaring problem with this
09:42 19 articulation of the purported inventive concept and why
09:42 20 there is none here and why there is no distributed
09:42 21 computing is that the claims actually do not require
09:42 22 the terminal to be running the interactive user
09:42 23 interface. All the claims require is that you see the
09:42 24 interactive user interface on the terminal. You see it
09:42 25 on a monitor or another device like that.

09:42 1 So there is no actual distributed
09:42 2 computing happening there. You fall right back to the
09:42 3 basic abstract concept that everyone walked in here
09:42 4 with a laptop today, you took a cable, and you plugged
09:42 5 it into an outlet so that you could see what's
09:43 6 happening on that laptop on a separate screen.
09:43 7 That's the abstract concept of the claim.
09:43 8 The details in the claim do not recite any sort of
09:43 9 inventive concept beyond that abstract concept.
09:43 10 And for those reasons, we believe that
09:43 11 this decision is just like Electric Power v. Alstom by
09:43 12 the Federal Circuit 830 F.3d 1350 at 1355, where --
09:43 13 when you have a scenario where nothing in the claims
09:43 14 require anything more than off-the-shelf conventional
09:43 15 computer technology, networking and display technology,
09:43 16 so that you can gather, send, and process data, that is
09:43 17 not an inventive concept.
09:43 18 And so, again, we believe that IOENGINE's
09:43 19 motion of no invalidity under 101 should be denied and
09:43 20 that the Court should allow the inventive concept
09:43 21 question to go to the jury again as it did in the
09:43 22 Freshub v. Amazon case and the Google case that I cited
09:44 23 to earlier.
09:44 24 And if Your Honor has no further
09:44 25 questions for me, I will give the remainder of my time

09:44 1 to Mr. Gaudet.
09:44 2 MR. GAUDET: Thank you. And may it
09:44 3 please the Court.
09:44 4 THE COURT: Yes, sir.
09:44 5 MR. GAUDET: Matt Gaudet. I'm in the
09:44 6 Atlanta office of Duane Morris, although I grew up in
09:44 7 Lafayette, Louisiana, just about five and a half hours
09:44 8 down I-10.
09:44 9 I'm going to shift gears a little bit.
09:44 10 And this is our motion on -- for invalidity on the
09:44 11 written description issue.
09:44 12 While it's a different issue, it very
09:44 13 much ties into the argument you just heard because the
09:44 14 difference between the claims that were the subject of
09:44 15 those prior 101 decisions where the Court said, all
09:44 16 right. As a matter of law, there's 101, that you can
09:44 17 satisfy 101. Difference between those claims and these
09:44 18 claims is precisely what's not described in the
09:45 19 specification.
09:45 20 And it -- the two -- the two match up
09:45 21 perfectly. The fundamental issue is whether or not the
09:45 22 specification describes a portable device, which is the
09:45 23 T-C-A-P, or the TCAP, that can directly connect to a
09:45 24 communication network so that the portable device can
09:45 25 get online all by itself.

09:45 1 Does the specification disclose that, or
09:45 2 does the specification only disclose the portable
09:45 3 device getting online by first connecting to the
09:45 4 terminal or the access terminal?
09:45 5 That's the tunnelling notion, but it's
09:45 6 just the connection between the portable device and the
09:45 7 terminal, and the terminal has to be online. And
09:45 8 without that terminal being online, the portable device
09:45 9 can't get online.
09:45 10 And the point of the motion is that's the
09:45 11 only thing that's described. For the first 15 years of
09:45 12 continuations of this patent, that's what the claims
09:45 13 cover. And that includes the orders you just saw on
09:45 14 the 101 motion.
09:45 15 And then in 2019, for the first time,
09:46 16 they drafted claims that were broad enough to capture
09:46 17 the notion of the portable device all by itself getting
09:46 18 online.
09:46 19 And as you read the briefs, you'd almost
09:46 20 have the impression that this was sort of an oversight
09:46 21 or kind of a mistake. But for precisely the same
09:46 22 reasons you saw in the very first slide of the 101
09:46 23 presentation, the reason that the portable device
09:46 24 doesn't get online itself is the very essence of the
09:46 25 invention.

09:46 1 I actually -- I have a quote up here on
09:46 2 the left from their reply on the 101 brief. It's the
09:46 3 same language that you saw them put up from the 101
09:46 4 orders, which are talking about existing computer
09:46 5 environments being bulky, requiring too much power,
09:46 6 require great processing resources.
09:46 7 And then on the right, I put the language
09:46 8 from the specification. It says that that current
09:46 9 computer environment was a PDA, a 2004 PDA that could
09:46 10 pretty much fit in your hand, which is why the example
09:47 11 was a PalmPilot. A PalmPilot was too big, took too
09:47 12 much processing resources, and took too much power.
09:47 13 And so the solution and the thing
09:47 14 describing the specification was a portable device, and
09:47 15 I underlined it in green here, that took less power and
09:47 16 was more like a thumb footprint.
09:47 17 That's why it's no accident that this
09:47 18 specification never describes a portable device that
09:47 19 could itself get online. That's just fundamental to
09:47 20 the whole point of the invention.
09:47 21 Now I'm going to go through the details.
09:47 22 Instead, what it says -- and this is Column -- this is
09:47 23 from Column 4. If the AT -- that's the terminal -- is
09:47 24 connected to a communication network, 113, then the
09:47 25 TCAP, the portable device, may then communicate beyond

09:47 1 the AT or the terminal. And then it goes into
09:47 2 different embodiments.
09:47 3 And then in Column 9, we see the flip
09:47 4 side. Well, what happens if the terminal is not
09:48 5 online?
09:48 6 And it says: If the AT is not online,
09:48 7 the TCAP may provide options for the user not including
09:48 8 online services.
09:48 9 And this is everywhere in the
09:48 10 specification.
09:48 11 The next slide explains the reason for
09:48 12 this. Because you would tunnel the data through an AT,
09:48 13 across a communications network, to the remote services
09:48 14 without requiring its own complicated set of
09:48 15 peripherals and I/O.
09:48 16 And again, as they told you in the 101
09:48 17 motion, the whole supposed magic of this invention was
09:48 18 getting the processing and -- getting particular sorts
09:48 19 of processing off of that portable device, making it
09:48 20 smaller, and getting it, instead, over to the terminal.
09:48 21 So what they have to do, much like with
09:48 22 the plaintiff had to do in the -- in Your Honor's
09:48 23 Flash-Control case is mix and match disclosures in a
09:49 24 way that's not at all described or intended in the
09:49 25 specification.

09:49 1 In particular, they're mixing and
09:49 2 matching Figure 9 and Figure 10, but those are
09:49 3 fundamentally different components.
09:49 4 So what we've got here on this slide --
09:49 5 and the top is Figure 1. This is taken from our brief.
09:49 6 That's got the three basic components here. The
09:49 7 portable device is -- we highlighted it in green in the
09:49 8 upper right. The terminals are in red in the bottom
09:49 9 right. And then what's called a TCAP server. This is
09:49 10 an online server that is accessed over a communication
09:49 11 network that the portable device can communicate with.
09:49 12 That's in blue.
09:49 13 So the description of this says: Figure
09:49 14 1 illustrates embodiments for a topology between a
09:49 15 tunnelling access point, TCAP.
09:49 16 So we've -- this is now Figure 10. This
09:49 17 is showing TCAP, a portable device. We used the same
09:49 18 color scheme. So it's obviously not to scale. But the
09:49 19 green stuff is the portable device. You see it
09:49 20 connects to the red. That's the terminal. The red has
09:50 21 a connection that we put in yellow up the communication
09:50 22 network. And that's what then communicates with the
09:50 23 server. That's Figure 10.
09:50 24 Then it says: The TCAP server, TCAPS, is
09:50 25 Figure 9.

09:50 1 So now we've got Figure 9. And we sort
09:50 2 of blew up the bottom. And to be clear, that's the
09:50 3 tunnelling client access point server. This is the
09:50 4 thing that lives in the cloud. It's online.
09:50 5 Now, that certainly does have a direct
09:50 6 connection to the communication network, but that's
09:50 7 because it's a server on the back end and it's not a
09:50 8 portable device.
09:50 9 And so we certainly agree, Figure 9, this
09:50 10 online server specification, as you see in this slide,
09:50 11 discloses it's got a communication network. The
09:50 12 network interface here connects to the communication
09:50 13 network.
09:50 14 It can have peripheral devices. Figure 9
09:50 15 does all those things. But Figure 9's not Figure 10.
09:50 16 Figure 10 is the portable device. And this language on
09:51 17 Column 22 says -- we've highlighted the first part:
09:51 18 Much of the description of the TCAPS -- the server --
09:51 19 of Figure 9 applies to the TCAP -- a lot of these
09:51 20 modules and things like that -- and as such, the
09:51 21 disclosure focuses more upon the variances -- the
09:51 22 differences -- exhibited in the TCAP.
09:51 23 The next paragraph says the first one is
09:51 24 that the TCAP or the portable device has to be small.
09:51 25 Of course it has to be small, because that's the whole

09:51 1 point of the invention.
09:51 2 And then the next one is just point
09:51 3 blank, the next variance is that -- we underlined this
09:51 4 at the bottom -- the TCAP controller may be connected
09:51 5 to or communicate with entities such as, but not
09:51 6 limited to: One or more users from an access terminal.
09:51 7 And that's what you see in the dotted
09:51 8 lines that go from the green to the red.
09:51 9 And then: The access terminal itself may
09:51 10 be connected to peripherals and/or communications
09:52 11 network, 1013, like Figure 9. And that's the yellow
09:52 12 that goes up.
09:52 13 That's the difference. The portable
09:52 14 device cannot get online by itself. It can't access
09:52 15 the communications network.
09:52 16 And it repeats these differences. It
09:52 17 talks about -- and you can have the operating system
09:52 18 allows you to access things through an access terminal.
09:52 19 And what I've got that -- what they're
09:52 20 relying on, in large part, is simply the say-so
09:52 21 conclusory declaration of their expert Dr. Shamos, who
09:52 22 just says, well, Figures 9 and 10 can kind of be put
09:52 23 together.
09:52 24 And a conclusory declaration that just
09:52 25 says that is not entitled to any weight because the

09:52 1 specification says what it says.
09:52 2 And the punch line is the specification
09:52 3 never says that anything in Figure 10 could directly
09:52 4 connect with a communication network and get online by
09:52 5 itself. It doesn't exist. You would have to mix and
09:52 6 match and it becomes a detective story that's not
09:53 7 allowed.
09:53 8 This is what they rely on, though. That
09:53 9 there is a network interface in Figure 9. No doubt
09:53 10 about it. It's item 1010, it shows is a network
09:53 11 interface. And that network interface is what connects
09:53 12 with the access terminal. The fact that you're a
09:53 13 network interface doesn't mean you get online.
09:53 14 The question is, what is the network?
09:53 15 And this instance, it's very clear: It's network of
09:53 16 two. It's the portable device and the terminal and
09:53 17 that's it. That's all that's shown there.
09:53 18 And then in -- and there's also
09:53 19 disclosures of that connection being wireless. So it
09:53 20 could be a Bluetooth chip or something else like that,
09:53 21 and it could also include peripheral devices.
09:53 22 Absolutely. That could all happen.
09:53 23 But there's never any suggestion that
09:53 24 there would be a wireless connection to the
09:54 25 communications network that would get you online. And

09:54 1 quite frankly, that would take this thing from a PDA
09:54 2 into like a -- something the size of a backpack.
09:54 3 I mean, to put that kind of processing
09:54 4 power on something in 2002, you're moving, you know,
09:54 5 180 degrees away from the invention. I don't have to
09:54 6 prove that. The point is, that's why it's no mistake
09:54 7 or oversight that you will not find that type of a
09:54 8 disclosure in the specification.
09:54 9 And in fact, Column 3 says it point
09:54 10 blank: The wireless connection is connecting the TCAP
09:54 11 and the server.
09:54 12 Dr. Shamos again posits that someone of
09:54 13 ordinary skill in the art would understand that
09:54 14 Bluetooth and WiFi provide Internet access. That's
09:54 15 great. But the whole point of the invention is you
09:54 16 would never do that on something that's supposed to be
09:54 17 the size of a thumb drive.
09:54 18 It -- that's why the specification is
09:54 19 moving in exactly the opposite direction, which is we
09:55 20 are using the online connection of the terminal, not of
09:55 21 the portable device.
09:55 22 Two other sets of points and then I'll be
09:55 23 done.
09:55 24 They rely on this language about the
09:55 25 portable device connecting across the network. As

09:55 1 they're sort of picking different phrases in the
09:55 2 specification.
09:55 3 And what you'll see is, not only does
09:55 4 that not mean you're connecting directly, but as you
09:55 5 read the language around it, it's crystal clear that
09:55 6 connection is through the terminal.
09:55 7 So they are citing this language in the
09:55 8 top quote that talks about -- there's a -- the TCAP has
09:55 9 a unique digital certificate and it's used for purposes
09:55 10 of verification and encryption across a network.
09:55 11 Well, a column and a half later, it uses
09:55 12 the same language to explain how that happens. The
09:55 13 TCAP can access and communicate with an attached access
09:55 14 terminal and beyond across a communications network.
09:55 15 But it's actually easier than that.
09:55 16 Because in the very thing they're citing, two sentences
09:56 17 earlier, it says the way that happens -- and I
09:56 18 underlined it in green here -- is through the
09:56 19 cryptographic server, 1020, as described in further
09:56 20 detail below.
09:56 21 That further detail below says -- and
09:56 22 this is the bottom of the slide: The TCAP employs the
09:56 23 cryptographic server to encrypt all data sent through
09:56 24 the access terminal.
09:56 25 We would be entitled to summary judgment

09:56 1 if it was silent. But it's not silent. It's
09:56 2 unambiguous that this always goes through the access
09:56 3 terminal.
09:56 4 Last thing I'm going to do is go through
09:56 5 the very last paragraph of Dr. Shamos' report. He
09:56 6 throws in three cites to say the specification actually
09:56 7 discloses the portable device getting online. And when
09:56 8 you look at these three cites, again, what's so
09:56 9 remarkable is he takes language that he thinks maybe is
09:56 10 kind of silent, and when you look around it, the
09:57 11 language says exactly what we're saying. It's crystal
09:57 12 clear. It has to go through the access terminal.
09:57 13 First example is Column 12. He says it
09:57 14 describes the TCAP processing the files and uploading
09:57 15 them to the back-end servers. So I underlined that
09:57 16 language. TCAP processing the files and uploading them
09:57 17 to the back-end servers.
09:57 18 But just a few sentences earlier in that
09:57 19 same column, it said: As has already been discussed,
09:57 20 initially in any of the environments, after engaging
09:57 21 the TCAP to an AT. And then it goes on.
09:57 22 And, again, this one actually gets easier
09:57 23 still. Because the part he didn't quote says: As has
09:57 24 already been discussed in Figures 5 to 6.
09:57 25 So the bottom of the quote I've got on

09:57 1 the bottom of this slide says: Figures 5 to 8
09:57 2 illustrate embodiments of facilities, programs and/or
09:57 3 services that the tunnelling client access point and
09:58 4 server may provide to the user as accessed through an
09:58 5 AT. Through the terminal.
09:58 6 The next one, he cites to Column 10 and
09:58 7 says: Online access to data may be facilitated through
09:58 8 HTTP protocols. And he says, there you have it. That
09:58 9 must mean it's doing it by itself.
09:58 10 Again, silence is not enough. But we
09:58 11 don't have silence here. Because they omitted the word
09:58 12 "such." Such online access services.
09:58 13 And previously -- or in the previous
09:58 14 column, it said, if the AT is not online, the TCAP may
09:58 15 provide options for the user, not including online
09:58 16 services. It's unambiguous. No AT, no online.
09:58 17 The last one, and then I'll be done here,
09:58 18 is he cites Column 25. Describing a TCAP operating
09:58 19 system that enables interaction with both an access
09:58 20 terminal and communications network. That's what he
09:59 21 says.
09:59 22 This is the whole column that's up there
09:59 23 and the last phrase. May -- the operating system may
09:59 24 provide communications protocols that allow the TCAP
09:59 25 controller to communicate with other entities through

09:59 1 an access terminal.

09:59 2 Unless they can show you, Your Honor,

09:59 3 where the specification says the portable device gets

09:59 4 online by itself, the portable device is connected to

09:59 5 communications network, Your Honor, we believe that

09:59 6 this is like the previous case where you've granted

09:59 7 summary judgment.

09:59 8 That's what I've got. Thank you.

09:59 9 THE COURT: A response?

09:59 10 MR. LEIBOWITZ: Thank you, Your Honor.

09:59 11 May it please the Court.

09:59 12 I submit, Your Honor, that counsel for

09:59 13 Roku began their argument with a suggestion that

10:00 14 IOENGINE mixes and matches parts of the specification

10:00 15 to prove its point. I think what you just heard, Your

10:00 16 Honor, was counsel for Roku mixing and matches places

10:00 17 in the specification trying to prove its point.

10:00 18 Now, let me -- I think my slides are...

10:00 19 Roku's argument with respect to written

10:00 20 description, Your Honor -- I'm sorry. I'm having a

10:00 21 technical issue.

10:00 22 I apologize, Your Honor.

10:01 23 Roku's argument with respect to written

10:01 24 description about the lack of a network interface on

10:01 25 the portable device is unusual. And here's why.

10:01 1 The specification explicitly says that
10:01 2 the portable device can have its own network interface.
10:01 3 Here's the part from Column 24 of the specification.
10:01 4 It's in the part of the specification describing the
10:01 5 portable device. And it says: In one embodiment, an
10:01 6 optional network interface may be provided.
10:01 7 And that's unit 1010. It's in Figure 10,
10:01 8 in the TCAP figure of the portable device.
10:01 9 Not only that, but the specification
10:01 10 expressly describes what network interfaces are. And
10:01 11 for this, Your Honor, we are harkening back in the
10:01 12 specification to what's described with respect to a
10:01 13 network interface in Figure 9.
10:01 14 But that's because that's where the
10:01 15 specification talks about what network interfaces are.
10:02 16 It doesn't need to re-explain that term in Figure 10,
10:02 17 because it already does it with respect to Figure 9.
10:02 18 In Figure 10, it says, a portable device
10:02 19 may have an optional network interface. It describes
10:02 20 what network interferes are. It says: They may
10:02 21 accept, communicate, and/or connect to a communications
10:02 22 network. They can employ protocols such as Ethernet or
10:02 23 a wireless connection such as IEEE 802 or the like.
10:02 24 So it's correct the specification doesn't
10:02 25 recite again this entire description of what network

10:02 1 interfaces are, but it does so by saying, as counsel
10:02 2 for Roku put up on the screen, that much of what's
10:02 3 recited with respect to Figure 9 also applies to the
10:02 4 portable device, to the TCAP, and by saying that the
10:02 5 TCAP can have an optional network interface.
10:02 6 Furthermore, the specification provides
10:02 7 examples of what the wireless component -- of the
10:02 8 wireless component on the portable device.
10:03 9 And it talks about -- again, this is from
10:03 10 Column 24, where they're talking about the portable
10:03 11 device, not the TCAP server: In one embodiment, a
10:03 12 wireless component may comprise a Bluetooth chip
10:03 13 disposed in communications with a transceiver.
10:03 14 And it goes further. It talks about in
10:03 15 another embodiment -- again, talking about the TCAP
10:03 16 itself, the portable device, not the server: In
10:03 17 another embodiment, both a Bluetooth chip and an IEEE
10:03 18 802.11b wireless chip may be used to communicate and/or
10:03 19 bridge communications with respectively enabled
10:03 20 devices.
10:03 21 Doesn't say that the Bluetooth chip or
10:03 22 the WiFi chip is only used to communicate with the
10:03 23 terminal. It says the Bluetooth chip or a wireless
10:03 24 chip can be used to communicate with respectively
10:03 25 enabled devices, plural.

10:03 1 And then it talks about the transceiver,
10:03 2 we just saw with respect to Bluetooth: It should
10:03 3 further be noted the transceiver, 1043, may be used to
10:03 4 wirelessly communicate with other devices powered by
10:04 5 Bluetooth chips and/or IEEE 802.11b chips, WiFi chips,
10:04 6 or the like.
10:04 7 So the specification explicitly points
10:04 8 out in the section of talking about the portable device
10:04 9 that I can have a Bluetooth chip. And it even says a
10:04 10 number of Bluetooth chips are commercially available.
10:04 11 And if WiFi is wanted, IEEE 802.11b functionality is
10:04 12 required, a number of chips are commercially available
10:04 13 for that.
10:04 14 So the specification talks about the
10:04 15 portable device having a Bluetooth or WiFi chip. It
10:04 16 talks about commercially available Bluetooth or WiFi
10:04 17 chips.
10:04 18 And so it doesn't just talk about the
10:04 19 portable device using Bluetooth or WiFi to connect only
10:04 20 to a terminal. It expressly talks about using those
10:04 21 technologies to communicate with other
10:04 22 respectively-enabled devices.
10:04 23 And of course, that's exactly how those
10:04 24 technologies work. If you have a WiFi chip in your
10:04 25 phone, it's going to connect to a WiFi access point in

10:04 1 your house or in this courtroom, and it's then going to
10:05 2 connect to other devices that are on that network.
10:05 3 And that's what Dr. Shamos explains in
10:05 4 his report. It's not at all conclusory what counsel
10:05 5 just said. I'll take you through in a minute.
10:05 6 But as Dr. Shamos explains in his report,
10:05 7 although Bluetooth, for example, is not predominantly
10:05 8 used this way today, in 2004 there were Bluetooth
10:05 9 access points which functioned the same way to connect
10:05 10 devices with Bluetooth chips to the Internet.
10:05 11 Again, here's -- you know, it's --
10:05 12 Dr. Shamos is not conclusory. He cites specific access
10:05 13 points that existed at the time and says that a person
10:05 14 of ordinary skill in the art would understand that
10:05 15 Bluetooth access points that provided Internet access
10:05 16 were also available around the time of conception, and
10:05 17 he cites examples.
10:05 18 And he talks about what a person of
10:05 19 ordinary skill in the art would understand from that
10:05 20 and understand that if the specification says the
10:05 21 portable device can have a commercially available
10:05 22 Bluetooth chip and that there are commercially
10:05 23 available Bluetooth access points out there that were
10:06 24 known, that a person of ordinary skill in the art would
10:06 25 understand that to mean that that device can

10:06 1 communicate through a Bluetooth access point to the
10:06 2 Internet.
10:06 3 And they don't cite any evidence showing
10:06 4 that in 2004, a person of ordinary skill in the art
10:06 5 would read the specification that says that the
10:06 6 portable device can have its own network interface,
10:06 7 that it could connect or communicate -- a network
10:06 8 interface that can connect or communicate to a network
10:06 9 using, for example, 802.11 or Ethernet or WiFi or
10:06 10 Bluetooth chips, and that the portable device can have
10:06 11 its own commercially available chip for Bluetooth or
10:06 12 WiFi would not understand that the inventor was in
10:06 13 possession of a portable device having its own network
10:06 14 interface. And that's what they have to show.
10:06 15 Here we have a quote from the Pozen case,
10:06 16 Your Honor, in the Federal Circuit: The patent
10:06 17 specification is written for a person of skill in the
10:06 18 art and such person comes to the patent with knowledge
10:06 19 of what has come before. Placed in that context, it is
10:06 20 unnecessary to spell out every detail on the invention
10:07 21 in the specification; only enough must be included to
10:07 22 convince a person of ordinary skill in the art that the
10:07 23 inventor possessed the invention.
10:07 24 So the specification is written for the
10:07 25 person of ordinary skill who would understand that

10:07 1 having a commercially available WiFi chip means that
10:07 2 that device can connect to the Internet.
10:07 3 Instead, their argument is built on the
10:07 4 fallacy that notwithstanding these express descriptions
10:07 5 about portable device, that somehow the specification
10:07 6 excludes the possibility of a portable device having
10:07 7 its own network connection, right?
10:07 8 That's what their argument is. That --
10:07 9 that's what counsel just went through saying, oh, in
10:07 10 this case, the portable device goes through the
10:07 11 terminal. In this case, it goes through the terminal.
10:07 12 Right.
10:07 13 The problem for that argument, Your
10:07 14 Honor, is that that's all discussing embodiments,
10:07 15 particular examples that are in the claim -- that are
10:07 16 in the specification. And they rely on two things to
10:07 17 try to get them there.
10:08 18 First, they point to Figure 10, which
10:08 19 they say -- in which they say the network connection
10:08 20 goes through the terminal.
10:08 21 But again, the specification, when it
10:08 22 talks about Figure 10, it says: Figure 10 is a block
10:08 23 diagram illustrating embodiments of a tunnelling client
10:08 24 access point controller.
10:08 25 Yes. There are -- Figure 10 shows

10:08 1 embodiments or examples. And it shows an example where
10:08 2 the portable device has a network interface. That's
10:08 3 Unit 1010. It shows the portable device having a
10:08 4 Bluetooth chip and a WiFi chip.
10:08 5 And even if Roku is correct that in the
10:08 6 particular example illustrated in Figure 10 there's
10:08 7 communication with the terminal using Bluetooth, that
10:08 8 doesn't mean that a person of ordinary skill reading
10:08 9 the specification that disclosed all the things I just
10:08 10 showed you, having a portable device having its own
10:08 11 commercially available Bluetooth or WiFi chip, would
10:08 12 conclude that the patentee only had possession of an
10:08 13 invention where the portable device operated the way it
10:08 14 did in the example of Figure 10.
10:09 15 And we've cited a couple of cases from
10:09 16 the Federal Circuit as well talking about even a single
10:09 17 representative embodiment can support written
10:09 18 description of a claimed genus.
10:09 19 In the Bilstad case: The Court has
10:09 20 continued to apply the rule the disclosure of a species
10:09 21 may be sufficient written description support for a
10:09 22 later claimed genus including that species.
10:09 23 The fact that you have a -- one way of
10:09 24 connecting, even according to Roku, at the very least
10:09 25 there is an understanding that using the WiFi chip or

10:09 1 the Bluetooth chip or the network interface, the
10:09 2 portable device can connect to the Internet through the
10:09 3 terminal -- that's Roku's argument as one example --
10:09 4 that doesn't mean that the -- that the written
10:09 5 description is limited to that example.
10:09 6 A disclosure of a species can be
10:09 7 sufficient written description support for a genus that
10:09 8 includes that species.
10:09 9 Just like the Bilstad court found in that
10:10 10 case, here, Roku provides no analysis of what one
10:10 11 skilled in the art would have understood from the
10:10 12 disclosure or the -- and this is a quote from the
10:10 13 Federal Circuit -- or the degree of predictability of
10:10 14 technical variations in the field of art.
10:10 15 Okay. There's no -- there's no
10:10 16 insinuation here from Roku nor could they make it that
10:10 17 this is a case like a pharmaceutical case or a field
10:10 18 where the art is unpredictable. Here, a person of
10:10 19 ordinary skill in the art, seeing the examples and
10:10 20 seeing what the specification talks about, the device
10:10 21 having its own WiFi chip and Bluetooth chip, would
10:10 22 clearly understand that that device can get to the
10:10 23 Internet on its own or get them to a network on its
10:10 24 own.
10:10 25 Because Roku's argument for the lack of

10:10 1 written description runs up against the specification's
10:10 2 explicit disclosure, what they -- what they -- they
10:10 3 need to prove -- what they would need to prove is that
10:10 4 a person of ordinary skill would come to the conclusion
10:10 5 that, notwithstanding everything in the specification,
10:11 6 the only thing of the specification is that the
10:11 7 portable device's network connection must go through
10:11 8 the terminal.
10:11 9 But again, Your Honor, we talked about
10:11 10 this a little bit with respect to tunnelling, that's
10:11 11 not what the specification says. The specification
10:11 12 does say -- the specification explains what it means by
10:11 13 tunnelling. This is the quote we saw before with
10:11 14 respect to the 101 motion.
10:11 15 And it does say that the TCAP can, right,
10:11 16 also the TCAP may tunnel data through an AT across a
10:11 17 communications network. That doesn't mean it must do
10:11 18 it that way. It may do it that way.
10:11 19 But what the specification means by
10:11 20 tunnelling is that data is provided from the portable
10:11 21 device to the user through the terminals input/output,
10:11 22 the I/O, for example, displayed on the terminal's
10:11 23 output component for the user to observe without the
10:11 24 data actually residing on the terminal.
10:11 25 And that's what the specification means.

10:11 1 When counsel's talking about, oh, the whole point of
10:11 2 the invention is that it means that the portable device
10:12 3 can't have its own network interface, that's incorrect.
10:12 4 But the point of the invention is and
10:12 5 what the invention when it's talking about tunnelling
10:12 6 means is that you have data that's provided through the
10:12 7 terminals input/output for the user to observe without
10:12 8 it actually residing on the AT and that much of that
10:12 9 data may not even reside on the TCAP. It may reside on
10:12 10 the servers or the servers' storage facilities.
10:12 11 Now, I'll try to skip ahead a little bit,
10:12 12 Your Honor, in my argument.
10:12 13 But the other point here, Your Honor, is
10:12 14 that by arguing that the specification only includes
10:12 15 the possibility of portable device going to the network
10:12 16 through the terminal, what Roku is really doing here is
10:12 17 reopening claim construction.
10:12 18 This is exactly the argument that they
10:12 19 made in claim construction. They say in their brief
10:12 20 that that's not true, but here's the argument from
10:12 21 their claim construction brief, right.
10:13 22 They say: Additionally, if the access
10:13 23 terminal is connected to a communications network, such
10:13 24 as the Internet, the access terminal provides the
10:13 25 portable device with network connectivity.

10:13 1 In fact -- this is again Roku's brief.
10:13 2 In fact, this is the only way disclosed in the
10:13 3 specification for the portable device to gain network
10:13 4 access.
10:13 5 And that -- and they quote the same part
10:13 6 of the specification that they quote in their slides to
10:13 7 Your Honor: If the access terminal is connected to a
10:13 8 communications network, the portable device may then
10:13 9 communicate beyond the access terminal.
10:13 10 Okay. This was their claim construction
10:13 11 argument. And that's what they're essentially
10:13 12 rearguing here with respect to the terminal needing to
10:13 13 provide network access to the portable device.
10:13 14 But this Court rejected that read. What
10:13 15 this Court said in claim construction is: Defendant
10:13 16 has not shown that there's a clear indication in the
10:13 17 intrinsic record that the patentee intended the claims
10:13 18 to be limited from limitations from a preferred
10:13 19 embodiment.
10:13 20 This Court rejected that read of the
10:14 21 specification and rejected, in fact, the exact passage
10:14 22 that Roku relies on, the "may then communicate"
10:14 23 language, and found instead that the claims are not
10:14 24 limited to what's -- to what's shown in the embodiment.
10:14 25 And that's exactly the point here.

10:14 1 We don't dispute that there are examples
10:14 2 in the specification where the portable device does use
10:14 3 the terminal network interface. But because Roku's
10:14 4 argument for lack of written description is that the
10:14 5 only way for it to read the spec is that the network
10:14 6 connection goes through the terminal, Roku needs to
10:14 7 prove that a person of ordinary skill in the art would
10:14 8 come to that conclusion.
10:14 9 And this Court rejected that very
10:14 10 argument at claim construction, and it's not better
10:14 11 now.
10:14 12 And so we think Roku's motion on this
10:14 13 ground should be denied as a matter of law. But at a
10:14 14 minimum, the question of whether a person of ordinary
10:14 15 skill in the art would read the specification which
10:14 16 again explicitly discloses the portable device having
10:15 17 its own network interface that connects to a
10:15 18 communications network, that's what network interfaces
10:15 19 do according to the spec, and that that could be a WiFi
10:15 20 or Bluetooth chip to wirelessly communicate with
10:15 21 "respectively enabled devices," whether a person of
10:15 22 ordinary skill would nonetheless conclude from examples
10:15 23 that the portable device can only connect to the
10:15 24 Internet through a terminal is at the minimum a factual
10:15 25 dispute for trial.

10:15 1 Dr. Russ, their expert, says a person of
10:15 2 ordinary skill in the art would read the spec that way.
10:15 3 And Dr. Shamos, our expert, says that's wrong. And a
10:15 4 person of ordinary skill in the art in 2004, reading
10:15 5 the specification, would understand that having a
10:15 6 commercially available WiFi or Bluetooth chip, the
10:15 7 portable device could connect to a network itself
10:15 8 without going through the terminal.
10:15 9 Thank you, Your Honor.
10:15 10 THE COURT: A brief response?
10:15 11 MR. GAUDET: Your Honor, Matt Gaudet.
10:15 12 Let me -- Defendant 2.
10:16 13 There's just three points I want to make.
10:16 14 The first one relates to the first of the
10:16 15 only two things he pointed to as his supposed
10:16 16 disclosure. Which was the existence of network
10:16 17 interface, which you see it's network interface 1010,
10:16 18 is just to the left of that big red arrow there on the
10:16 19 portable device. Stipulated. There is no doubt that
10:16 20 the portable device has a network interface. That's
10:16 21 never the question.
10:16 22 The question is, what does the network
10:16 23 interface connect to? And the difference it describes
10:16 24 between Figure 9 and Figure 10 is that in Figure 10,
10:16 25 the network interface connects with the access terminal

10:16 1 or peripheral devices and that is it. As Point No. 1.
10:16 2 Point No. 2, and this is the only other
10:16 3 thing that he points to. This is it. Is the wireless
10:17 4 connection language. He says, and he's quoting now,
10:17 5 I've got it up on the screen here. The -- that you
10:17 6 could access wirelessly, right, other wirelessly
10:17 7 enabled devices.
10:17 8 Now, speaking of the Markman, I mean, the
10:17 9 Markman order actually on Page 14 literally went
10:17 10 through the language on Column 3 and said this is
10:17 11 talking about a wireless connection between the
10:17 12 portable device and the terminal.
10:17 13 But more fundamentally, he showed you
10:17 14 exactly what's missing. The only way you could get
10:17 15 from a portable device to the Internet, get it online,
10:17 16 would be if you had -- and he said it -- an access
10:17 17 point. You would need a WiFi empowered access point.
10:17 18 You'd have to have a TCP/IP stack on the portable
10:17 19 device.
10:17 20 That's the stuff that doesn't exist
10:17 21 anywhere in the specification. It's nonexistent. It's
10:18 22 nowhere in Figure 10. It's not even in Figure 9.
10:18 23 He showed you precisely what you would
10:18 24 need, and the Federal Circuit is crystal clear that you
10:18 25 cannot do what he just invited you to do. Namely, fill

10:18 1 in the missing component. It's not there. And that's
10:18 2 game over.
10:18 3 And that was it. For all of the talk,
10:18 4 those were the only two components he pointed to.
10:18 5 Last thing. He talked about embodiments
10:18 6 and the notion of embodiments and what happened in
10:18 7 claim construction. And respectfully, he kind of has
10:18 8 that backwards.
10:18 9 Claim construction is how they created
10:18 10 this problem for themselves. And often -- and I think
10:18 11 I've seen district courts describe this as "be careful
10:18 12 what you ask for."
10:18 13 It is precisely because these claims were
10:18 14 not limited to the disclosed embodiments, which is
10:18 15 standard in claim construction, that they are so broad
10:18 16 that they go beyond what is supported by the written
10:18 17 description. Right?
10:18 18 If we get one claim construction, I'd be
10:18 19 here making a noninfringement argument to you. But
10:19 20 it's precisely because they're broader than the
10:19 21 embodiments. And what he has to show you now is the
10:19 22 example that goes his way. And he can't. Because it
10:19 23 doesn't exist.
10:19 24 And this is -- the Power Oasis case from
10:19 25 the Federal Circuit I think is the perfect example,

10:19 1 where you've got two devices that are remote from each
10:19 2 other. And the phrase was customer interface and which
10:19 3 one was it on?
10:19 4 Of course somebody could have designed
10:19 5 one where you put it on either of those things. That's
10:19 6 not what the invention was. So it was summary judgment
10:19 7 of no written description.
10:19 8 And respectfully, Your Honor, we ask for
10:19 9 that result here as well.
10:19 10 THE COURT: Thank you.
10:19 11 (Off-the-record bench conference.)
10:20 12 THE COURT: Okay. The Court is going
10:20 13 to -- with respect to the plaintiff's motion for
10:20 14 summary judgment of no invalidity due to patent
10:20 15 ineligible subject matter under Section 101, the Court
10:20 16 is going to grant that.
10:20 17 There was sort of a subliminal motion by
10:20 18 defendant to say that it was invalid, which I think is
10:21 19 mostly because you have to say that to say they're
10:21 20 wrong. But to the extent that there was a motion filed
10:21 21 implicitly even by the defendant on 101, I'm denying
10:21 22 that.
10:21 23 With respect to the argument I just
10:21 24 heard, motion for summary judgment with respect to
10:21 25 written description, I'm going to deny that.

10:21 1 Next up I have the motion -- the
10:21 2 IOENGINE's motion to strike certain opinions, witness
10:21 3 declarations, and et cetera.
10:21 4 Give me one second on that.
10:21 5 (Off-the-record bench conference.)
10:21 6 THE COURT: I'm going to -- because this
10:22 7 is a motion to strike and we have moved the trial date,
10:22 8 I'm going to deny the motion. And if there is
10:22 9 additional discovery or whatever needs to be done to
10:22 10 fix these declarations and get the evidence, I'm going
10:22 11 to allow the parties to do.
10:22 12 Next I have Roku's Daubert motion to
10:22 13 exclude opinions of Dr. Shamos related to alleged
10:22 14 conception. I'll take that up.
10:22 15 MR. RICCIUTI: Thank you, Your Honor.
10:22 16 Christopher Ricciuti again on behalf of defendant Roku.
10:23 17 And may it please the Court.
10:23 18 I think this argument will be fairly
10:23 19 short and straightforward, Your Honor.
10:23 20 So the issue here is that IOENGINE's main
10:23 21 piece of evidence allegedly corroborating Mr. McNulty's
10:23 22 conception of the invention here is a document called
10:23 23 Portable Devices Rule. And I will refer to that
10:23 24 probably throughout my talk as the PDR document for
10:23 25 short.

10:23 1 And that document is Exhibit A-1 to
10:23 2 Docket 188.
10:23 3 That PDR document has holes in it. Now,
10:23 4 IOENGINE tries to fill the holes in this document with
10:23 5 testimony of their technical expert Dr. Shamos under
10:23 6 the guise of a person of ordinary skill in the art.
10:23 7 Now, the parties present differing views
10:23 8 on how the perspective of a person of ordinary skill in
10:23 9 the art plays into this analysis, and I won't go
10:23 10 through that here. I think that's been adequately
10:23 11 described in the briefing.
10:23 12 But what's clear is no matter what
10:23 13 perspective or what influence the perspective of a
10:24 14 person of ordinary skill in the art can play,
10:24 15 Dr. Shamos himself cannot step into the shoes of the
10:24 16 inventor or manufacture corroboration evidence out of
10:24 17 whole cloth, which is only going to lead to jury
10:24 18 confusion, and that's exactly what happened here.
10:24 19 And I think the best example of that is
10:24 20 with respect to the mention of Bluetooth in the PDR
10:24 21 document. And the PDR document mentions Bluetooth as a
10:24 22 potential way to have a portable device connect to a
10:24 23 computer like a terminal.
10:24 24 The PDR document, what it doesn't do, is
10:24 25 it does not mention the Bluetooth specification at all.

10:24 1 There's no evidence that Mr. McNulty, the inventor,
10:24 2 even had any idea that there was a Bluetooth
10:24 3 specification in existence.
10:24 4 The portable devices rule document or the
10:24 5 PDR document does not mention a key exchange happening
10:24 6 between the portable device and the terminal. And
10:25 7 that's a requirement of all claims in the asserted '584
10:25 8 patent.
10:25 9 The portable devices rule document or
10:25 10 that PDR memo does not mention streaming video using
10:25 11 Bluetooth. All of which Dr. Shamos goes and says,
10:25 12 well, that's okay, because I can find that in the
10:25 13 Bluetooth specification. But that can't possibly be
10:25 14 right.
10:25 15 In order to do that, Dr. Shamos is
10:25 16 pointing to a document from 2008 or 2009, which is
10:25 17 years after when these patents were effectively filed,
10:25 18 to say that, well, Mr. McNulty would have had
10:25 19 possession of key exchange, he would have had
10:25 20 possession of streaming video, and I get that all from
10:25 21 the specification.
10:25 22 The Bluetooth specification is not part
10:25 23 of the PDR document. The Bluetooth specification is
10:25 24 not mentioned in the PDR document. There is absolutely
10:25 25 no hook in the PDR document that would give a person of

10:26 1 ordinary skill in the art any sense that Mr. McNulty
10:26 2 was trying to incorporate any teachings from that
10:26 3 specification into the document.
10:26 4 And so all we have is 20 years later, an
10:26 5 expert coming in and saying, well, if you look at the
10:26 6 specification that post dates the patent by five years,
10:26 7 maybe I can find some support in there. And somehow a
10:26 8 person of ordinary skill would have been able to look
10:26 9 into the future and know what was coming in the
10:26 10 pipeline and incorporate that back into somehow the
10:26 11 inventor having possession.
10:26 12 It simply makes no sense. It's
10:26 13 incredibly confusing. And so our request here is that
10:26 14 we would request that Dr. Shamos not be allowed to
10:26 15 offer testimony about third-party documents that have
10:26 16 no relation to Mr. McNulty's purported conception.
10:26 17 It's only going to confuse the jury and it would be
10:26 18 improper.
10:27 19 THE COURT: Unlike everything else they
10:27 20 hear.
10:27 21 (Laughter.)
10:27 22 MR. RICCIUTI: Exactly. That's very
10:27 23 true. But this would be even more confusing to the
10:27 24 point where I think it would be --
10:27 25 THE COURT: This moves to a higher level

10:27 1 of confusing that's not standard in all the other
10:27 2 patent --
10:27 3 MR. RICCIUTI: It's beyond standard
10:27 4 patent confusing talk. Absolutely, Your Honor. Which
10:27 5 I believe that the Daubert should be granted.
10:27 6 Thank you.
10:27 7 MR. CHUEBON: Good morning, Your Honor.
10:27 8 THE COURT: If you would give me just one
10:27 9 second.
10:27 10 (Off-the-record bench conference.)
10:27 11 THE COURT: I don't need a response. I'm
10:27 12 going to deny the motion.
10:27 13 Next up I have the motion to exclude the
10:27 14 opinions of Walter Bratic.
10:28 15 MS. FENTON: Good morning, Your Honor.
10:28 16 THE COURT: Good morning.
10:28 17 MS. FENTON: Tia Fenton of Duane Morris
10:28 18 on behalf of Roku.
10:28 19 Your Honor, I'll be addressing Roku's
10:28 20 motion to exclude certain opinions of Mr. Bratic and
10:28 21 Dr. Shamos. And the relevant Docket numbers are 202,
10:28 22 219, and 249.
10:28 23 For the purpose of oral argument today,
10:28 24 Your Honor, I'm only going to focus on one issue for
10:28 25 Mr. Bratic's report, which is the most problematic.

10:28 1 And that's Mr. Bratic's apportionment Step No. 1.
10:28 2 By way of a brief background, Roku
10:28 3 produced over 100 survey documents, but for this
10:28 4 apportionment step, Mr. Bratic and Dr. Shamos only
10:28 5 relied on one.
10:29 6 As you can see, this survey is a new user
10:29 7 survey from 2002. It only surveyed first-time Roku
10:29 8 users, which is a very small subsection of the people
10:29 9 actually using the accused products. Actually less
10:29 10 than 1 percent.
10:29 11 This survey is only representative of a
10:29 12 one-week period in October of the entire damages window
10:29 13 which span from 2019 to 2023.
10:29 14 And the survey does not cover all of the
10:29 15 accused products. There are at least 11 accused
10:29 16 products in this case, and this survey only covers five
10:29 17 of them.
10:29 18 Mr. Bratic describes this survey as the
10:29 19 most comprehensive marketing survey provided by Roku.
10:29 20 But even if that is true, Your Honor, it does not make
10:29 21 it an appropriate basis for apportioning damages.
10:29 22 THE COURT: Why is this use of just five
10:29 23 not okay?
10:29 24 MS. FENTON: Because it's not
10:29 25 representative of all the accused products in --

10:29 1 THE COURT: Says who?
10:29 2 MS. FENTON: I think it's clear from --
10:29 3 if IOENGINE accuses 11 or more products and only 5 are
10:30 4 represented from the single piece of evidence that he's
10:30 5 relying on for his apportionment, it's by nature not
10:30 6 representative of all the accused products.
10:30 7 THE COURT: I mean, he's an expert. He's
10:30 8 going to say -- I'm assuming in his report, he says,
10:30 9 here's why I think these five are representative or
10:30 10 whatever he says. He's done this a long time.
10:30 11 I mean, it sounds to me like you're
10:30 12 saying is logically it's just not okay, but that
10:30 13 doesn't sound like an appropriate Daubert standard to
10:30 14 me that it's an inappropriate methodology.
10:30 15 MS. FENTON: Your Honor, it's our opinion
10:30 16 that it is an inappropriate methodology.
10:30 17 THE COURT: Well, I know it's your
10:30 18 opinion. You don't like anything he did. But I'm --
10:30 19 but why is -- I heard all the little things you said
10:30 20 and you're unhappy with the way he did it. When I was
10:30 21 a lawyer, I was unhappy with the way the other experts
10:31 22 did things.
10:31 23 I don't understand where -- from where do
10:31 24 you get the standard that you can't use a subset of the
10:31 25 number of accused products?

10:31 1 MS. FENTON: I think in this instance,
10:31 2 Your Honor, the main problem is that this particular
10:31 3 survey was cherry-picked from a number of surveys that
10:31 4 were produced. And there are other surveys that were
10:31 5 produced that show different results --
10:31 6 THE COURT: Are those the ones your
10:31 7 expert used?
10:31 8 MS. FENTON: -- the same accused
9 products.
10:31 10 Excuse me?
10:31 11 THE COURT: Did your expert use those?
10:31 12 MS. FENTON: Yes. Our expert relied on
10:31 13 those.
10:31 14 THE COURT: And so they could get up and
10:31 15 say they're not happy with the surveys that your
10:31 16 gentleman used, right?
10:31 17 MS. FENTON: That's correct, Your Honor.
10:31 18 If I could -- Your Honor, if I could move
10:31 19 to the second point of the argument.
10:31 20 THE COURT: Sure.
10:31 21 MS. FENTON: Thank you.
10:31 22 IOENGINE's technical expert, Dr. Shamos,
10:31 23 as you know, identified 11 features from the survey
10:31 24 that he says are attributable to the patents-in-suit.
10:32 25 And as you can see on the right of the

10:32 1 screen, Dr. Shamos says that it is because of the
10:32 2 asserted patents that the accused products offer things
10:32 3 like lots of free shows and movies. They have specific
10:32 4 apps or channels and offer live or local TV.
10:32 5 The issue here, aside from the fact that
10:32 6 it's not clear how most of these features are actually
10:32 7 tied to the patents-in-suit, is that a number of these
10:32 8 features are also present on Roku's noninfringing
10:32 9 products, like the Roku TVs and the Roku sound bars.
10:32 10 And this is because all Roku products have the same
10:32 11 operating system and function in the same manner.
10:32 12 For instance, all Roku products have the
10:32 13 same user interface and you can get the same apps on
10:32 14 both the accused and nonaccused products.
10:32 15 And so if all of these 11 features
10:32 16 identified in this survey are truly tied to the
10:32 17 patents-in-suit and not the overall Roku operating
10:32 18 system technology, then they should not be equally
10:32 19 present in the noninfringing products, such as the Roku
10:33 20 TVs, like they are.
10:33 21 Your Honor, it's undisputed among the
10:33 22 technical experts in this case that at least 6 of the
10:33 23 11 features are common to both the accused products and
10:33 24 products that are noninfringing, like the Roku TVs.
10:33 25 Mr. Bratic and Dr. Shamos here are

10:33 1 improperly conflating the benefits of the patented
10:33 2 technology with benefits of overall technology based on
10:33 3 the shared Roku operating system. And this results in
10:33 4 an improperly inflated damages number.
10:33 5 It's Roku's position that this marketing
10:33 6 survey as a whole is not a reliable method for
10:33 7 apportioning damages, and Dr. Shamos and Mr. Bratic
10:33 8 should be precluded from relying on it.
10:33 9 But based on Your Honor's comments about
10:33 10 the survey, if the Court is not inclined to do that,
10:33 11 Roku requests that at least these six features on the
10:34 12 screen be removed from Mr. Bratic's first apportionment
10:34 13 calculation and damages be adjusted accordingly,
10:34 14 because these features are not uniquely tied to the
10:34 15 patent and both experts agree that they are common to
10:34 16 accused and noninfringing products.
10:34 17 Thank you.
10:34 18 THE COURT: Thank you. I look forward to
10:34 19 hearing you cross-examine him on all those points. I'm
10:34 20 going to deny the Daubert motion.
10:34 21 Next up I have -- oh, what a surprise.
10:34 22 You'd like to Daubert their damages expert.
10:34 23 (Laughter.)
10:34 24 THE COURT: Okay.
10:34 25 MR. LEIBOWITZ: Yes. Thank you, Your

10:34 1 Honor.
10:35 2 Thank you, Your Honor. And I'll try to
10:35 3 be --
10:35 4 THE COURT: What I'd like to hear from
10:35 5 you most on -- and you can argue whatever you -- the
10:35 6 issues I'd like to hear you focus on are the use of
10:35 7 sound bars and stream bars as noninfringing
10:35 8 alternatives. And also the issue of the downward
10:35 9 adjustment for advertising, I'd like to hear. I don't
10:35 10 need any argument with respect to the licenses.
10:35 11 MR. LEIBOWITZ: Okay. Your Honor, thank
12 you.
10:35 13 If I can have one second to get to that
10:35 14 part of my outline, I'd appreciate it.
10:35 15 THE COURT: Sure. I'm going to try to
10:36 16 limit this to the parts I understand.
10:36 17 (Laughter.)
10:36 18 MR. LEIBOWITZ: Thank you, Your Honor.
10:36 19 Here we are.
10:36 20 Okay. Your Honor, on the -- on the
10:36 21 noninfringing alternatives point, Your Honor, what
10:36 22 Ms. Kindler, Roku's expert, analysis needs to focus on
10:36 23 is the infringer's need for taking a license.
10:36 24 And the problem is that with respect to
10:36 25 most of Ms. Kindler's supposed noninfringing

10:36 1 alternatives, most of those are third-party products or
10:36 2 platforms that have no benefit to Roku.
10:36 3 And if I try to advance my slides to
10:36 4 where we are -- no. Sorry. No.
10:37 5 Sorry, Your Honor.
10:37 6 All right. Well, we'll forget the slide
10:37 7 for now, Your Honor.
10:37 8 With respect to the sound bars, Your
10:37 9 Honor, there, Roku's point on the sound bars is that
10:37 10 those are a noninfringing alternative. But the problem
10:37 11 for them, Your Honor, is that those products actually,
10:37 12 the sound bars, were accused in this case.
10:37 13 And with respect to IOENGINE's position,
10:37 14 those products are not noninfringing alternatives
10:37 15 because they infringe, though we no longer are
10:37 16 asserting them with respect to damages in this case
10:37 17 because there was such little sales with respect to
10:37 18 those products that we decided not to continue those in
10:37 19 the case.
10:37 20 Go ahead.
10:37 21 THE COURT: So you had them in the case
10:37 22 at first and you -- and you dropped them out but there
10:37 23 was no indication on your part that they were dismissed
10:38 24 because they weren't infringing. It was just the juice
10:38 25 wasn't worth the squeeze.

10:38 1 MR. LEIBOWITZ: Correct, Your Honor.
10:38 2 Now, they will point to, I assume, part
10:38 3 of Dr. Shamos, our expert's deposition in which he was
10:38 4 asked about the sound bars. And he said, oh, they
10:38 5 don't infringe. And then he -- but he then clarified
10:38 6 what he meant to say was: I didn't mean to imply they
10:38 7 don't infringe. What I meant was they're not accused.
10:38 8 Because we had at that point dropped
10:38 9 them. And so we don't think that should then somehow
10:38 10 make them noninfringing alternatives on the basis of
10:38 11 that statement.
10:38 12 THE COURT: But he corrected that in the
10:38 13 same deposition?
10:38 14 MR. LEIBOWITZ: In the same deposition,
10:38 15 Your Honor. I would have the citation for you, but I
10:38 16 apologize.
10:38 17 THE COURT: I believe you.
10:38 18 MR. LEIBOWITZ: Okay. With respect to
10:38 19 the advertising point --
10:38 20 THE COURT: Actually, let me hear from
10:38 21 them on this, because I'm particularly concerned about
10:38 22 this issue.
10:38 23 MR. LEIBOWITZ: Thank you, Your Honor.
10:38 24 THE COURT: You bet.
10:38 25 MS. FENTON: Your Honor, with respect to

10:39 1 the noninfringing alternatives, are you just
10:39 2 particularly interested in the sound bars, because
10:39 3 there's different categories of them?
10:39 4 THE COURT: I'm concerned about sound
10:39 5 bars and stream bars. Here's what -- I'm talking like
10:39 6 I know what I'm talking about.
10:39 7 From what we -- I read, the problem your
10:39 8 expert has is she includes as noninfringing
10:39 9 alternatives products -- I don't care to limit them,
10:39 10 but anything that she included that falls in the same
10:39 11 subset that the plaintiff had accused of infringement
10:39 12 and she's saying they're noninfringing alternatives.
10:39 13 It seems to me -- now, does -- what I
10:39 14 don't know and what I wanted to hear from you is, does
10:39 15 Ms. Kindler rely on something that your expert said
10:40 16 that said they were noninfringing?
10:40 17 MS. FENTON: Yes, Your Honor.
10:40 18 She -- and to just clarify the record a
10:40 19 little bit, Dr. Shamos said that the sound bars that
10:40 20 we're talking about, that they are not portable. And
10:40 21 so portability is a requirement. For the -- in the
10:40 22 claims, it has to be a portable device.
10:40 23 And so at a minimum, there's a dispute
10:40 24 among the two experts, Dr. Shamos and Roku's technical
10:40 25 expert Dr. Russ --

10:40 1 THE COURT: So there's a factual dispute
10:40 2 about whether they're portable? The --
10:40 3 MS. FENTON: Well, no.
10:40 4 THE COURT: -- the noninfringing
10:40 5 alternatives?
10:40 6 MS. FENTON: Dr. Shamos -- I think
10:40 7 Mr. Leibowitz was referencing testimony that Dr. Shamos
10:40 8 clarified in his deposition. I'm sorry. We're at a
10:40 9 little bit of a disadvantage because it's not in front
10:40 10 of us. But he cleared up some testimony about whether
10:40 11 the sound bars were accused versus noninfringing, but
10:41 12 what he said very clearly at one point in his
10:41 13 deposition was that the sound bars are not portable
10:41 14 devices and therefore not infringing.
10:41 15 And Dr. Russ --
10:41 16 THE COURT: So I'm going to go out on a
10:41 17 limb here, but it seems to me that sound bars and
10:41 18 stream bars, whether they're portable or not is not
10:41 19 something that is an expert.
10:41 20 Is there something -- is there something
10:41 21 about these -- I mean, if you ask me if my laptop was
10:41 22 portable, I -- versus the computer -- I mean, I could
10:41 23 tell what is portable and not.
10:41 24 What I'm trying to find out is there --
10:41 25 is there -- forgetting what Dr. Shamos may have said

10:41 1 and have to correct or whatever, is there evidence --
10:41 2 what did your damages expert Ms. Kindler rely on --
10:42 3 what affirmatively does she rely on to say that they
10:42 4 are noninfringing alternatives because they are
10:42 5 nonportable?
10:42 6 MS. FENTON: She relies on Dr. Russ, Your
10:42 7 Honor, our technical expert.
10:42 8 THE COURT: And he -- in his report, it
10:42 9 says they are portable -- they are not --
10:42 10 MS. FENTON: They're not.
10:42 11 THE COURT: -- they are nonportable and
10:42 12 so she is not relying -- forgetting what Shamos said
10:42 13 for a second. Her opinion is based on something that
10:42 14 your expert is going to testify about, and that's her
10:42 15 basis for saying that they are noninfringing
10:42 16 alternatives?
10:42 17 MS. FENTON: Yes, Your Honor. Her basis
10:42 18 is based on our technical expert's report, not --
10:42 19 THE COURT: Okay. Let me hear, then,
10:42 20 from the plaintiff as to why I should strike her.
10:42 21 Why -- if their expert is going to say that, why I
10:43 22 should strike her on this point.
10:43 23 MS. FENTON: And, Your Honor, can I add
10:43 24 very quickly?
10:43 25 THE COURT: Sure.

10:43 1 MS. FENTON: Are we -- again, I would
10:43 2 like to reserve the opportunity to discuss other
10:43 3 noninfringing alternatives depending on your ruling.
10:43 4 Because this is a very unique circumstance with only
10:43 5 one category of products, the sound bars.
10:43 6 There are also other noninfringing
10:43 7 alternatives that were never in this circumstance.
10:43 8 They weren't originally accused and then dropped from
10:43 9 the case.
10:43 10 THE COURT: The only thing I have in
10:43 11 front of me that I care about are products, whether
10:43 12 they are sound bars or stream bars, and there's a fight
10:43 13 over whether or not they are nonportable or portable.
10:43 14 MS. FENTON: Thank you.
10:43 15 THE COURT: If your expert is going to --
10:43 16 if you -- if the reason Ms. Kindler says -- I mean, I'm
10:43 17 doing something, and I'm doing it because my expert
10:43 18 says I'm -- we're right, then that's one thing.
10:43 19 I'm less -- I don't care very much that
10:43 20 they were dropped from that case or what Dr. Shamos
10:44 21 said that may have -- may or may not have been what he
10:44 22 intended.
10:44 23 What I care about is that your expert has
10:44 24 a foundation on your side, and it seems to me that she
10:44 25 does.

10:44 1 MS. FENTON: To be clear, yes.
10:44 2 THE COURT: Okay. I got that.
10:44 3 Now, why should I grant your Daubert
10:44 4 motion if they have an expert who's going to give the
10:44 5 foundation for Ms. Kindler here?
10:44 6 MR. LEIBOWITZ: Thank you, Your Honor.
10:44 7 So with respect to the sound bars and
10:44 8 stream bars, I think they fall into the same arguments
10:44 9 we made with respect to the other noninfringing
10:44 10 alternatives.
10:44 11 It's not -- the fact that they were
10:44 12 accused and then dropped, we raised as the point being
10:44 13 that that should not put them in a category that then
10:44 14 says they don't infringe. Because, again, that's what
10:44 15 they were relying on Dr. Shamos' testimony for.
10:44 16 But the problem with her reliance on the
10:44 17 stream bars and sound bars as noninfringing
10:45 18 alternatives, we don't think is because of the -- that
10:45 19 the issue is with respect to Dr. Russ not saying, oh,
10:45 20 these don't infringe. We don't think we should be
10:45 21 having a trial, Your Honor, on whether noninfringing
10:45 22 alternatives infringe or don't infringe. We think
10:45 23 that's the wrong way to go.
10:45 24 We think the problem here is that with
10:45 25 respect to the noninfringing alternatives that

10:45 1 Ms. Kindler relies on among them, the sound bars and
10:45 2 the stream bars, they have all the same problems. In
10:45 3 fact, they admit she didn't rely on them for purposes
10:45 4 of quantification of her analysis.
10:45 5 But all of them, Your Honor, have the
10:45 6 same issues.
10:45 7 THE COURT: I don't know what those
10:45 8 issues are.
10:45 9 MR. LEIBOWITZ: Oh, thank you, Your
10:45 10 Honor.
10:45 11 So, Your Honor, so one issue is that
10:45 12 they -- that the -- in order to be a proper
10:45 13 noninfringing alternative, they need to -- they need to
10:46 14 possess characteristics -- or cannot possess
10:46 15 characteristics that are significantly different from
10:46 16 the patented product. And they --
10:46 17 THE COURT: But -- I'm sorry. They have
10:46 18 an expert who's going to say they do, right? That's
10:46 19 what I heard her say. They have an expert who's going
10:46 20 to say that they qualify as noninfringing alternatives.
10:46 21 And it seems to me your fight is over --
10:46 22 the Daubert isn't with Ms. Kindler. The Daubert is
10:46 23 with whether or not -- with whether -- you're arguing
10:46 24 that they infringe. They're arguing that they don't
10:46 25 infringe. And they have an expert that says they

10:46 1 don't. Why don't they get to do that?
10:46 2 MR. LEIBOWITZ: Yeah. So I think -- Your
10:46 3 Honor, so with respect to -- with respect to that
10:46 4 point, I think the problem is not whether our -- our
10:46 5 argument's here, Your Honor, with respect to why
10:46 6 Ms. Kindler's opinions here should be struck and not
10:47 7 the alternatives is not that there's -- whether or not
10:47 8 there's a battle of the experts over whether the,
10:47 9 quote/unquote, noninfringing alternatives actually
10:47 10 infringe.
10:47 11 What our problem is, Your Honor, is that
10:47 12 the supposed noninfringing alternatives do not have a
10:47 13 sufficient connection to what is -- what Roku actually
10:47 14 does with respect to the products that actually are
10:47 15 accused.
10:47 16 THE COURT: So now you're back to making
10:47 17 the argument they made against your damages expert,
10:47 18 that you don't like the way they did the opinion.
10:47 19 MR. LEIBOWITZ: Well, more so that the --
10:47 20 we don't believe that the opinion -- not that we don't
10:47 21 like the way they did the opinion, but that the
10:47 22 argument --
10:47 23 THE COURT: You have the same --
10:47 24 (Simultaneous conversation.)
10:47 25 THE COURT: I'm going to deny this one.

10:47 1 Next up I have -- I'm going to deny the
10:47 2 motion with respect to Ms. Kindler with respect to her
10:47 3 reliance on license. I'm going to deny it with respect
10:47 4 to what I'm generically calling the sound bar and
10:48 5 stream bar, noninfringing alternatives. Whatever it is
10:48 6 that the fuss is there, I'm denying it.
10:48 7 Let's go next to the final issue that you
10:48 8 have with Ms. Kindler.
10:48 9 MR. LEIBOWITZ: Okay, Your Honor. And
10:48 10 this is with respect to the advertising. And the fact
10:48 11 that what Ms. Kindler does is essentially assume
10:48 12 noninfringement rather than assuming infringement.
10:48 13 And what she does, Your Honor, is she
10:48 14 just says that she's relying on an opinion from
10:48 15 Dr. Russ that certain types of advertisements are not
10:48 16 infringing.
10:48 17 Here's a section of her report: I
10:48 18 understand from Dr. Russ that to the extent any
10:48 19 advertisements could be considered as potentially
10:48 20 within the scope of the asserted claims, it would be
10:48 21 limited.
10:48 22 And "potentially within the scope of the
10:48 23 infringing claims" means that of -- if they don't fall
10:48 24 there, then they don't infringe.
10:48 25 And what she does is she says that

10:48 1 certain ads fall outside the scope of the claims, i.e.,
10:49 2 they don't infringe, and that, therefore, results in a
10:49 3 69 percent reduction when she applies her royalty math.
10:49 4 And, you know, this -- we think there's
10:49 5 two problems here.
10:49 6 One, it's essentially based on a
10:49 7 noninfringement opinion even though she's required to
10:49 8 assume infringement. She's saying that these ads fall
10:49 9 outside the scope of the claims, when she's required --
10:49 10 what IOENGINE's allegations are that they are
10:49 11 infringing and they fall within the scope of the
10:49 12 claims.
10:49 13 THE COURT: So if you'll back up just for
10:49 14 a second.
10:49 15 MR. LEIBOWITZ: Sure.
10:49 16 THE COURT: There is a quantum of -- so
10:49 17 how do the -- how does the advertising fit into what's
10:49 18 infringing? Start me there.
10:49 19 MR. LEIBOWITZ: Sure, Your Honor. So
10:49 20 Roku makes most of its money by selling advertisements.
10:49 21 THE COURT: Sure.
10:49 22 MR. LEIBOWITZ: And then the way that
10:49 23 works is with respect to a Roku product, if you're
10:49 24 using a Roku device, you see an advertisement, right,
10:49 25 and then -- and that is actually money that Roku makes.

10:49 1 And in fact, when we go through their
10:49 2 documents, they -- they -- the infringement, right,
10:50 3 both in terms of selling the product and the use of the
10:50 4 product, which are infringements, the -- Roku's
10:50 5 monetizing that through their advertising revenue.
10:50 6 THE COURT: Are these apparatus claims or
10:50 7 method claims?
10:50 8 MR. LEIBOWITZ: There's both, Your Honor.
10:50 9 THE COURT: Okay. So get me to where --
10:50 10 and I've had a couple of trials so that's my limited
10:50 11 knowledge of Roku. But I do understand that what
10:50 12 you're saying is that they have a product and the way
10:50 13 they make the product, obviously like YouTube and
10:50 14 everybody else, they -- it's through advertising.
10:50 15 What I'm -- what you need to get me --
10:50 16 just trying to connect me to is how -- the fight, I
10:50 17 guess, is over whether or not Ms. Kindler is going to
10:50 18 say that there is advertising revenue -- and let me
10:51 19 switch it just for a second because it might bring --
10:51 20 works a little better.
10:51 21 Google's a pretty big company. And they
10:51 22 have Google Maps. They have other devices. And so
10:51 23 there's got to be -- there is -- there is a way,
10:51 24 probably, you can show how Google monetizes Maps as
10:51 25 opposed to search as opposed to everything else.

10:51 1 Here, if I understand you, the fight is
10:51 2 over how to segregate the amount of advertising revenue
10:51 3 that should be attributable to the infringing method in
10:51 4 apparatus. Is that -- am I getting close?
10:51 5 MR. LEIBOWITZ: Sure, Your Honor. So
10:51 6 I'll try to explain it, Your Honor.
10:51 7 So here, there's particular types of
10:51 8 advertising. And in one sense, where the advertising
10:51 9 is coming from.
10:51 10 So, for example, if you watch a movie or
10:51 11 a TV show on your Roku device, you'll see a bunch of
10:51 12 different types of advertising along the way. Some of
10:51 13 that advertising is directly from Roku. Some of it may
10:51 14 be from the service that you -- that Roku is allowing
10:52 15 you to watch on the device.
10:52 16 And in all cases, what Mr. Bratic did in
10:52 17 terms of the money related to those ads, is it's a
10:52 18 revenue that Roku is realizing.
10:52 19 What Ms. Kindler is doing is she's
10:52 20 saying, according to Dr. Russ, there are certain types
10:52 21 of advertisements that don't fall within the scope of
10:52 22 the claims. And, therefore, she's taking them out of
10:52 23 the royalty calculation.
10:52 24 And our argument is, if you're taking
10:52 25 them out of the royalty calculation based on the expert

10:52 1 opinion that they don't fall within the scope of the
10:52 2 claims, then you're essentially saying -- you're --
10:52 3 it's a noninfringement opinion.
10:52 4 It's saying those -- that advertising --
10:52 5 THE COURT: So let me back you up for a
10:52 6 second to make sure I understand.
10:52 7 Your technical expert is going to say the
10:52 8 contrary. Your technical expert is saying all -- this
10:52 9 is what infringes and the revenue is tethered to what
10:53 10 we are claiming infringes.
10:53 11 MR. LEIBOWITZ: Correct.
10:53 12 THE COURT: And you're concerned with
10:53 13 what Ms. Kindler has done is she has not accepted --
10:53 14 and she and her -- the expert on their side have not
10:53 15 accepted the breadth of what you're saying is -- should
10:53 16 be inclusive.
10:53 17 And typically, in a hypothetical
10:53 18 negotiation, that's not an issue. Typically, it's
10:53 19 whatever you say infringes, they spot you infringes for
10:53 20 purposes of the negotiation.
10:53 21 MR. LEIBOWITZ: Correct, Your Honor. And
10:53 22 in fact, that's the law. In the hypothetical
10:53 23 negotiation, they have to assume infringement. Right?
10:53 24 I mean, that -- but -- I'm sorry.
10:53 25 THE COURT: I'm pretty up -- I got the

10:53 1 law. And so I think I've got it.
10:53 2 Okay. Let me hear a response, if I
10:53 3 could. I think I have the issue.
10:53 4 MS. FENTON: Your Honor, if I could just
10:54 5 pull up one slide for reference, please.
10:54 6 (Clarification by Reporter.)
10:54 7 MS. FENTON: Your Honor, I think you hit
10:54 8 the nail on the head with the original questions you
10:54 9 were asking IOENGINE's counsel.
10:54 10 In this instance, the issue is the
10:54 11 platform revenues or the advertising revenues. They're
10:54 12 not tied to the patent claims. And in fact, the one
10:54 13 claim that actually said advertising in it that was
10:54 14 asserted in this case, IOENGINE recently dropped.
10:54 15 IOENGINE obviously argues, based on
10:54 16 Mr. Leibowitz' statement, that Ms. Kindler didn't use
10:54 17 the total platform revenue and, therefore, she somehow
10:55 18 failed to assume infringement. But that's false.
10:55 19 As you can see on the chart here up on
10:55 20 the screen, there's two buckets of revenue. You've got
10:55 21 the product revenue, and you also have the Roku
10:55 22 platform revenue that's associated with the advertising
10:55 23 business.
10:55 24 It's Roku's position that IOENGINE is not
10:55 25 entitled to any portion of the platform revenue because

10:55 1 of the patents-in-suit have nothing to do with
10:55 2 advertising.
10:55 3 But our damages expert Ms. Kindler was
10:55 4 very conservative in her analysis, and she did include
10:55 5 some platform revenues. She properly relied on Roku's
10:55 6 technical expert Dr. Russ, as you recognized, and his
10:55 7 opinion that if any platform revenues are actually tied
10:55 8 to the patent claims at issue in this case, it's the
10:55 9 revenue from the display ads, and she adjusted downward
10:55 10 to include those.
10:55 11 And so it's not an instance here where
10:55 12 she disregarded platform revenue and didn't, you know,
10:56 13 didn't assume infringement as IOENGINE argues. It's
10:56 14 just that she did not accept Mr. Bratic's numbers based
10:56 15 on her reliance on the technical expert. And she has
10:56 16 no obligation to accept Mr. Bratic's numbers. As you
10:56 17 said, this is the, you know, the difference between the
10:56 18 two damages experts.
10:56 19 And so we respectfully request that, you
10:56 20 know, Ms. Kindler is able to rely on her well-reasoned
10:56 21 analysis based on the technical expertise of Dr. Russ
10:56 22 and what is actually tied to the patent claims in this
10:56 23 case.
10:56 24 Thank you.
10:56 25 THE COURT: Yes, sir.

10:56 1 MR. LEIBOWITZ: So, Your Honor, I think
10:56 2 that you just heard the issue, which is whether it's
10:56 3 tied to the patent claims or not. And our point is
10:56 4 that for purposes of a damages analysis, she needs to
10:56 5 assume that what will -- we say is tied to the patent
10:56 6 claims is tied to the patent claims.
10:56 7 Otherwise, "tied to the patent claims,"
10:57 8 that's a fancy way of saying noninfringing. Not tied
10:57 9 to the patent claims.
10:57 10 Our point is that there's revenue that's
10:57 11 recognized by Roku on all these advertisements. And by
10:57 12 simply saying, well, some of them are not within the
10:57 13 scope of the claim or not tied to the claim, that she
10:57 14 can then assume those out of her calculation, that is
10:57 15 incorrect as a matter of law, Your Honor.
10:57 16 And, Your Honor, if I can just go back,
10:57 17 you know, one moment with respect to the sound bars and
10:57 18 stream bars. Because I -- you know, I heard counsel's
10:57 19 representation about Dr. Russ having an opinion about
10:57 20 the sound bars and stream bars being noninfringing.
10:57 21 We don't believe that's the case, Your
10:57 22 Honor. We did not think so. I've had people looking
10:57 23 for it. At most what Dr. Russ is says is that he says,
10:57 24 they're noninfringing alternatives because they provide
10:57 25 the same benefits that the Roku products do.

10:57 1 But he doesn't have any opinion -- as the
10:57 2 technical expert, doesn't have any opinion that we can
10:58 3 find in his report that says that the sound bars and
10:58 4 stream bars do not infringe.
10:58 5 I'm sorry. I was going back, Your Honor.
10:58 6 THE COURT: No, no, no. That -- I --
10:58 7 that's fine.
10:58 8 So here's -- so let me say what I'm going
10:58 9 to do with respect to that.
10:58 10 Let me back up to that issue that you
10:58 11 just raised with regard to the sound bars and stream
10:58 12 bars.
10:58 13 At trial -- and I won't remember this.
10:58 14 But if when we start -- when we get to the trial, if
10:58 15 you will remind me of this issue, I will listen to what
10:58 16 their expert puts on -- their technical expert puts on
10:58 17 with regard to this issue. Him being limited to his
10:58 18 expert report on this issue. And I'll make my
10:58 19 determination at that time.
10:58 20 If I -- if -- obviously if the
10:59 21 defendant -- if it's in the report and you have your --
10:59 22 because he needs to testify about it at trial anyway to
10:59 23 lay the foundation for her or she just doesn't get to
10:59 24 talk about it.
10:59 25 So when he -- when their technical expert

10:59 1 finishes, which means I think you have to put him on
10:59 2 before the damages expert here, we'll take that issue
10:59 3 up separately and I'll figure that out.
10:59 4 MR. LEIBOWITZ: Thank you, Your Honor.
10:59 5 THE COURT: Now, let me -- I'm going to
10:59 6 come back in just a second to the other issue.
10:59 7 But you have spurred my -- spurred me to
10:59 8 say, the way I anticipate that you all will put on your
10:59 9 experts, because I don't -- Mr. Deaconson -- I don't
10:59 10 know who else has been in front of me at trial before,
10:59 11 but I'll pick on you since you're standing in front of
10:59 12 me.
10:59 13 If you are putting on your expert and --
10:59 14 on damages and they were to jump up and say, that's not
11:00 15 in his report, what I anticipate you being able to do
11:00 16 is say, but, Your Honor, of course it is. Because any
11:00 17 question you ask on direct, I expect you to have a key
11:00 18 in your outline to where -- not -- it's not a quote,
11:00 19 but you'll have to convince me that something in the
11:00 20 report put them on notice that this was -- the jury's
11:00 21 going to hear this.
11:00 22 Now, they get to cross. And what you all
11:00 23 enjoy more than anything else, more than winning, I
11:00 24 think, is being able to say something's not in
11:00 25 someone's report.

11:00 1 (Laughter.)
11:00 2 THE COURT: And so they will go on cross,
11:00 3 and they'll do a great job. And they're not tethered
11:00 4 to your expert's report. They can ask him whatever he
11:00 5 wants.
11:00 6 Now, when you get back up on redirect and
11:00 7 you say, Mr. Expert, you were asked on cross X. They
11:00 8 can't say it's not in his report. It may not be in his
11:00 9 report. But if it's asked on cross, on redirect there
11:00 10 is no it has to be in the report.
11:01 11 If you are asking a question on redirect
11:01 12 that asks an expert to explain what was in -- they were
11:01 13 asked on cross, they get to answer it. And I have this
11:01 14 all the time. So that's the reason I bring this up.
11:01 15 Now, finally turning to the last issue,
11:01 16 last Daubert issue with regard to Ms. Kindler. I mean,
11:01 17 I -- you know, the problem is technically you are both
11:01 18 right. I mean, obviously anything that is infringing
11:01 19 is -- you know, is part of the hypothetical. I get
11:01 20 that.
11:01 21 On the other hand, what I hear them
11:01 22 saying is that there are products that fall outside of
11:01 23 the scope of being -- I just can't understand it well
11:01 24 enough.
11:01 25 What I'm going to do is listen -- when

11:01 1 you're putting on your case -- your case-in-chief on
11:02 2 what infringes, if you lay the foundation -- if you lay
11:02 3 the foundation that X, Y, and Z infringe, and
11:02 4 Mr. Bratic lays down a foundation of why all of those
11:02 5 products should be included in the hypothetical
11:02 6 negotiation, there's a very high likelihood I'm going
11:02 7 to exclude -- I'm going to grant the Daubert on this.
11:02 8 And so -- but I'll be listening on cross.
11:02 9 If on cross they can establish that there are -- may be
11:02 10 products that shouldn't be included in what is
11:02 11 infringing and that's the basis for which Ms. Kindler's
11:02 12 saying, then I'll do that.
11:02 13 Again, I don't think this is a
11:02 14 Ms. Kindler issue, really. I think it is a what
11:02 15 should -- what the technical experts can convince me
11:02 16 should and should not be included as infringing
11:03 17 products.
11:03 18 Now, because she didn't make up -- she
11:03 19 didn't figure out what to include or not, she relied on
11:03 20 the expert here, the technical expert to do that. But
11:03 21 if I decide he was wrong in what he said, then she pays
11:03 22 the price in terms of the Daubert because they won't be
11:03 23 included in.
11:03 24 MR. LEIBOWITZ: Understood, Your Honor.
11:03 25 And just to clarify one thing. It's not

11:03 1 a matter of particular products that infringe or don't
11:03 2 infringe, right? It's a matter of -- and maybe just
11:03 3 it's to help the analysis, right -- it's a matter of
11:03 4 the, you know, whether the ad revenue that they're
11:03 5 generating, right, from all of the products infringe,
11:03 6 right?
11:03 7 THE COURT: And, again, that's why I'm
11:03 8 saying, though, I get -- I get all this. What I'm
11:03 9 saying is, until I hear the testimony -- after I hear
11:03 10 the testimony, I'll have a much better understanding of
11:03 11 whether or not I think the ad revenue -- I know why you
11:03 12 want the ad revenue in. I get that. I mean, they're
11:03 13 not selling shoes. You can't take a part of the shoe
11:03 14 sales. So I get that.
11:03 15 MR. LEIBOWITZ: Thank you, Your Honor.
11:04 16 Could I ask just one question, Your
11:04 17 Honor, also? And I don't want to belabor things if
11:04 18 Your Honor has made up his mind.
11:04 19 But I would say just two things on the
11:04 20 PRISMIQ motion that Your Honor --
11:04 21 (Simultaneous conversation.)
11:04 22 THE COURT: I don't want to go back over
11:04 23 anything I've decided.
11:04 24 MR. LEIBOWITZ: Okay. Thank you, Your
11:04 25 Honor.

11:04 1 And then one other point, Your Honor.
11:04 2 There were a number of summary judgment
11:04 3 motions that Roku made and submitted on the papers and
11:04 4 did not argue. A couple -- one on -- another one on
11:04 5 invalidity, a couple on noninfringement.
11:04 6 You know, to the extent Your Honor has
11:04 7 any questions about those or has something in those
11:04 8 motions, even though they're Roku's motions and they're
11:04 9 not arguing them, but if there is something that has
11:04 10 caught Your Honor's attention with respect to the other
11:04 11 invalidity points on written description or the
11:04 12 noninfringement points, that -- we would certainly
11:04 13 appreciate the opportunity to address those with Your
11:04 14 Honor if Your Honor's being inclined to, you know,
11:04 15 grant a motion for invalidity, let's say, or grant a
11:04 16 motion for noninfringement with respect to those
11:04 17 issues.
11:04 18 THE COURT: With respect to that -- let
11:05 19 me go through those. And I'll do what you said.
11:05 20 With respect to the motion -- Roku
11:05 21 omnibus motion for summary judgment with regard to the
11:05 22 no corroboration of the 2001 conception date, it is
11:05 23 denied.
11:05 24 With respect to the no written
11:05 25 description of a key exchange between the portable

11:05 1 device and the terminal, it is denied.
11:05 2 With respect to noninfringement based on
11:05 3 terminals, it is denied.
11:05 4 With respect to noninfringement based on
11:05 5 processors and the CPU, it is denied.
11:05 6 I'm going to come back to the next one.
11:05 7 With respect to Roku's motion to strike
11:05 8 Dr. Shamos' reliance on terminal television theory,
11:05 9 that is denied.
11:05 10 With respect to Roku's motion to strike
11:05 11 Dr. Shamos' reliance on the doctrine of equivalents,
11:06 12 I'm going to grant that, but I'm going to give the
11:06 13 plaintiff leave to serve amended infringement
11:06 14 contentions because we're kicking the trial date. And
11:06 15 so you can redo that.
11:06 16 With respect to IOENGINE's motion to
11:06 17 limit the testimony of someone who I don't know how to
11:06 18 pronounce her name, Ingrid Hsieh-Yee.
11:06 19 I think, Kevin, you could get this for me
11:06 20 for sure.
11:06 21 That is denied.
11:06 22 With respect to the motion to exclude the
11:06 23 opinions of Keith Webster, that is denied.
11:06 24 And then I have -- give me one second.
11:06 25 The one we have left is the motion to

11:06 1 strike portions of the expert report of Mr. Russ. Let
11:06 2 me look at that for a second.
11:07 3 (Off-the-record bench conference.)
11:07 4 THE COURT: With regard to motion --
11:07 5 IOENGINE's motion to strike portions of Mr. -- or is it
11:07 6 maybe Dr. Russ' report, I'm going to give leave to
11:07 7 the -- to Roku to address any of the issues that were
11:07 8 raised in this and fix those.
11:07 9 And if -- having -- if you -- let me see.
11:07 10 Let me ask the plaintiff with respect to
11:07 11 I'm assuming it's Dr. Russ. Is the issue only -- it
11:07 12 looks to me the issue was that they didn't do stuff
11:07 13 sufficiently during discovery or during giving you
11:07 14 contentions, but they did have the information in their
11:08 15 report; is that correct?
11:08 16 MR. LEIBOWITZ: This is with respect to
11:08 17 the allow reference and the Sony TV, et cetera, Your
11:08 18 Honor.
11:08 19 THE COURT: All I have here is with
11:08 20 regard to the '819 and '584 patent. I'm not sure of
11:08 21 what the art is specifically.
11:08 22 MR. LEIBOWITZ: Yes, Your Honor.
11:08 23 Mr. Chuebon will address that, Your Honor.
11:08 24 THE COURT: Well, let me ask you this.
11:08 25 MR. LEIBOWITZ: Sure.

11:08 1 THE COURT: Here's all I care about.
11:08 2 Tell me what it is you feel that you need for them to
11:08 3 provide you so that you can adequately defend their
11:08 4 argument. And I'll -- I'm going to let -- I'm going to
11:08 5 let them make this argument, but tell me what I need to
11:08 6 do to make it fair for you all to adequately respond to
11:08 7 it.
11:08 8 MR. LEIBOWITZ: Well, Your Honor, I think
11:08 9 with respect to -- since Your Honor's allowing sort of
11:08 10 supplementation, right, in terms of the motions you
11:08 11 already ruled on, I think we would want to depose
11:08 12 Dr. Russ again --
11:08 13 THE COURT: You get to do that.
11:08 14 MR. LEIBOWITZ: -- on those opinions.
11:09 15 THE COURT: That's fine.
11:09 16 MR. LEIBOWITZ: And to the extent that
11:09 17 results in another Daubert, Your Honor, we would like
11:09 18 the option to bring --
11:09 19 THE COURT: There's nothing I enjoy more.
11:09 20 (Laughter.)
11:09 21 MR. LEIBOWITZ: And finally, Your Honor,
11:09 22 I don't know how you would like to handle this, but
11:09 23 obviously I think our experts should -- we're not -- we
11:09 24 would not necessarily want more rebuttal reports, but,
11:09 25 Your Honor --

11:09 1 THE COURT: You get to do whatever you
11:09 2 need to do to be fair.
11:09 3 MR. LEIBOWITZ: Okay.
11:09 4 THE COURT: If you need to do a rebuttal
11:09 5 report, you can have a rebuttal report, and then they
11:09 6 get to depose your expert. So I'm fine with all that.
11:09 7 MR. LEIBOWITZ: Okay. Thank you, Your
11:09 8 Honor.
11:09 9 THE COURT: Now, what occasionally
11:09 10 happens that I run into -- not occasionally; I run into
11:09 11 a lot -- is I never know the names of these different
11:09 12 ones, but whatever technically should be the last round
11:09 13 of reports, whatever you would call the final -- what's
11:09 14 supposed to be the final one.
11:09 15 But the other side gets it and they're
11:09 16 like no, no, no. We still want to say something. So
11:09 17 you send another report. Now that one is always called
11:09 18 the supplemental report, and the other side gets
11:09 19 unhappy about that because it's too late and all that.
11:10 20 But the rule is you have to give them a
11:10 21 report to -- so you can say anything. So you all just
11:10 22 keep doing reports until it kills you. And if each
11:10 23 time you give a report someone wants to take a short
11:10 24 deposition about it, you get to take -- you know,
11:10 25 because my rule is going to be when you put the expert

11:10 1 on, the other side had to be given notice in a report
11:10 2 that that's what they were going to say.
11:10 3 So you all just keep doing reports until
11:10 4 the cows come home.
11:10 5 Now, I have one motion, I think, left
11:10 6 here, which is your motion -- the plaintiff's motion to
11:10 7 limit the expert testimony of Roku's expert on
11:10 8 noninfringement because of a construction issue.
11:10 9 MR. LEIBOWITZ: Yes, Your Honor.
11:10 10 THE COURT: Now, so what I have done in
11:11 11 the past here, if I have to, is -- was this a term that
11:11 12 was construed?
11:11 13 MR. LEIBOWITZ: So the term -- the term
11:11 14 "terminal" was construed as having its plain and
15 ordinary meaning.
11:11 16 But in the -- of course, in the context
11:11 17 of the discussion, Your Honor, what the Court said is
11:11 18 that -- again, as I said, we had certain slides on this
11:11 19 previously but the terminal is a computing device. The
11:11 20 parties agree that it's a computing device.
11:11 21 And what Roku did is they tried to read
11:11 22 more into that, right, and the Court rejected the
11:11 23 additional terms that Roku tried to read in.
11:11 24 But then, of course, what Dr. Ross does
11:11 25 is he puts those terms in and says, well, the plain and

11:11 1 ordinary meaning would mean the terms that Roku tried
11:11 2 to put in in claim construction and then was rejected.
11:11 3 That's the basis for that motion.
11:11 4 THE COURT: Well, give me one second. I
11:11 5 may have -- I think I have a solution.
11:12 6 (Off-the-record bench conference.)
11:12 7 THE COURT: This isn't a perfect
11:12 8 solution, but it's the best one I can have short of
11:12 9 waiting until trial and hearing what everyone says.
11:12 10 I think I'm going to turn this into --
11:12 11 you have construed it already. I think we're going to
11:12 12 set you all for a mini Markman on this claim term. And
11:12 13 primarily what I'm going to be looking at is whether or
11:13 14 not your -- what your expert says the plain and
11:13 15 ordinary meaning ought to be is correct, and what their
11:13 16 plain and ordinary meaning -- I get -- I mean, if I let
11:13 17 them talk, they're going to say, no, no. We used the
11:13 18 plain and ordinary meaning, what you would suspect. I
11:13 19 mean, we did what you said, so...
11:13 20 But -- now, there are two paths this
11:13 21 might take. And I've taken both of them. In fact, I
11:13 22 think it was one of the Roku trials where it happened.
11:13 23 In fact, it was a Roku trial where it didn't work -- it
11:13 24 didn't work well and that's why I've changed.
11:13 25 Is we had experts who had competing

11:13 1 constructions, and because the competing constructions
11:13 2 had different opinion on infringement which led you to
11:13 3 have to cross them and say, you're wrong, and him say,
11:13 4 nuh-uh, and they would say vice versa. That didn't
11:13 5 work very well. So...
11:13 6 But I may hear the competing
11:14 7 constructions and think that they are the plain and
11:14 8 ordinary meaning and that the jury could, based on what
11:14 9 the experts say, the jury could resolve it as well.
11:14 10 So...
11:14 11 But the best way I think to do it is to
11:14 12 have a mini Markman and let you all know which path
11:14 13 we're going to -- now, I may -- if -- it may turn out
11:14 14 that -- I'm going to pick on the defendant here. I
11:14 15 have no idea what I'm talking about, so I'm just making
11:14 16 this up.
11:14 17 But if I were to determine that your use
11:14 18 of the -- what your expert did was the -- was not the
11:14 19 plain and ordinary meaning of the term, that would have
11:14 20 a very negative impact on your opinion. But, again, if
11:14 21 I found that -- this is me speaking -- if I thought
11:14 22 that what he had done was in good faith, then I would
11:14 23 give you an opportunity to supplement or redo to --
11:14 24 with what I would make clear is the plain and ordinary
11:14 25 meaning.

11:15 1 I'm not predicting. I have no idea what
11:15 2 your expert put in. I'm just trying to forecast what
11:15 3 might happen.
11:15 4 So that's the way I'm going to handle
11:15 5 that claim term. And we'll try to do that sooner
11:15 6 rather than later so that if you all do need additional
11:15 7 expert reports, you all can get to that.
11:15 8 So I think -- yes, sir.
11:15 9 MR. GAUDET: So a few points of
11:15 10 clarification, if that's okay. Would you like me to
11:15 11 approach the podium, Your Honor?
11:15 12 THE COURT: Please.
11:15 13 MR. GAUDET: The -- with respect to the
11:15 14 doctrine of equivalents and Dr. Shamos, I assume like
11:15 15 with respect to Dr. Russ, we'd be afforded -- since
11:15 16 he's putting in another report, we'd be able to get a
11:15 17 deposition and that's not going to be a problem.
11:15 18 THE COURT: I have this silly notion that
11:15 19 whatever I do for one side, I should do for the other.
11:15 20 MR. GAUDET: My apologies.
11:15 21 Quick clarification on the prior art,
11:15 22 which I believe counsel referred to as the Alao motion.
11:15 23 You know, the real issue there was, you
11:16 24 know, IOENGINE was arguing that essentially evidence
25 came into a -- all of the evidence was in, all of the

11:16 1 evidence is in the expert reports. They had deposed
11:16 2 Dr. Russ already on all of this evidence.
11:16 3 And so I just wanted a little
11:16 4 clarification in terms of I'm not quite sure what we
11:16 5 would do -- I guess, other than maybe just open them up
11:16 6 for another, you could say, for a limited deposition
11:16 7 again on these topics.
11:16 8 THE COURT: Let me check.
11:16 9 (Off-the-record bench conference.)
11:16 10 THE COURT: So Kevin tells me that the
11:16 11 issue is whether or not they charted things?
11:16 12 MR. GAUDET: Right. And so the
11:16 13 plaintiff's argument is that what we were -- when we
11:16 14 introduced certain pieces of prior art which --
11:16 15 evidence in the case, I'll call it, they are saying it
11:16 16 needed to be charted.
11:16 17 And obviously we have our rationales for
11:17 18 this is background, state of the art evidence, it shows
11:17 19 the environment in the claim. It did not actually need
11:17 20 to be charted. And it was perfectly fine for Dr. Russ
11:17 21 to introduce in his report.
11:17 22 But not only did we introduce it in the
11:17 23 report, even before we got to the report, we went ahead
11:17 24 and we provided supplemental interrogatory responses
11:17 25 that disclose this evidence to them that --

11:17 1 THE COURT: Let me hear from the
11:17 2 plaintiff what the plaintiff would like you to do, and
11:17 3 I'll decide whether or not you need to do it.
11:17 4 MR. CHUEBON: Good morning, Your Honor.
11:17 5 I am Greg Chuebon. I am from Dechert's New York
11:17 6 office. Although I will disclose that my wedding
11:17 7 reception was about six blocks away.
11:17 8 THE COURT: Really? Where? Where was
11:17 9 your wedding reception?
11:17 10 MR. CHUEBON: We were married at the
11 church right outside UT, and the reception was at the
11:17 12 Driskill.
11:17 13 THE COURT: How beautiful.
11:17 14 MR. CHUEBON: The -- and actually, Your
11:17 15 Honor, the last time I appeared in court in Texas was
11:17 16 to ask for a marriage license with less than 72 hours
11:17 17 notice, so...
11:18 18 Well, maybe today will be as successful.
11:18 19 We'll see.
11:18 20 THE COURT: What happened to me is my
11:18 21 wife and I were -- had thought that you could get the
11:18 22 wedding license at the courthouse and, you know, you
11:18 23 can't. You have to go now to the -- to where you get
11:18 24 your DMV. It's horrendous. And it was horrible. And
11:18 25 we were driving around. We couldn't find a place to

11:18 1 park. And she said, you know, maybe we just shouldn't
11:18 2 get married.
11:18 3 (Laughter.)
11:18 4 THE COURT: And I thought, this is the
11:18 5 level of commitment that I like seeing out of you. And
11:18 6 so -- she hates it when I tell that story. It's true,
11:18 7 but it's -- she doesn't like when I tell that story.
11:18 8 So...
11:18 9 My -- but my solution is, you ought to go
11:18 10 to McLennan County to get the license because I don't
11:18 11 think there's a line -- my guess would be there's no --
11:18 12 you --
11:18 13 MR. DEACONSON: Very easy to do, Your
11:18 14 Honor.
11:18 15 THE COURT: Very easy to do. So that's
11:19 16 what I would do going forward. So...
11:19 17 Hopefully you won't need another marriage
11:19 18 license.
11:19 19 MR. CHUEBON: I was going to say, thank
11:19 20 you for the advice. Hopefully I won't need to take it.
11:19 21 But I think the issue here really is, as
11:19 22 your clerk noted, that these references just weren't --
11:19 23 they weren't charted. There was ample notice that --
11:19 24 or there were ample opportunity to disclose these to us
11:19 25 and they should have been disclosed and in the charts,

11:19 1 and they just weren't.
11:19 2 There was nothing in the initial
11:19 3 invalidity contentions. There was nothing in the final
11:19 4 invalidity contentions. There was nothing in -- and
11:19 5 nothing by way of any other disclosure until these
11:19 6 things essentially just popped up as invalidity
11:19 7 arguments in Dr. Russ' report.
11:19 8 And to say that they are asserted as
11:19 9 background references as to the state of the art simply
11:19 10 isn't true. The Alao reference and the Sony TV are
11:19 11 specifically asserted by Dr. Russ as parts of
11:19 12 invalidating combinations. They are parts of 103
11:19 13 combinations. These are not asserted as background
11:20 14 references.
11:20 15 And the first notice we got of these was
11:20 16 in Dr. Russ' report. So they were not in the
11:20 17 contentions. And for that reason, they were belated.
11:20 18 The Court has a scheduling order for a reason, and our
11:20 19 position is they should be struck.
11:20 20 THE COURT: What do you not have -- what
11:20 21 do you not have now that you need to respond to them?
11:20 22 What do you not -- has your -- I assume your expert's
11:20 23 already done a report -- a rebuttal report to their
11:20 24 invalidity?
11:20 25 I get that you're unhappy that they

11:20 1 weren't charted, but I'm not following where the harm
11:20 2 is.
11:20 3 MR. CHUEBON: Well, Your Honor, the issue
11:20 4 is that there wasn't the proper disclosure. So when we
11:20 5 were responding to it, we were responding to it at the
11:20 6 last minute. So it was tremendously prejudicial to
11:20 7 IOENGINE.
11:20 8 Even though there was a belated
11:20 9 disclosure in Dr. Russ' report, we --
11:21 10 THE COURT: Do you need -- do you want
11:21 11 you to have more time? Do you need to do anything else
11:21 12 to respond to these?
11:21 13 MR. CHUEBON: Well, Your Honor, if we do
11:21 14 need to put in a supplemental report by Dr. Shamos,
11:21 15 we'd appreciate the opportunity to do so. It's also
11:21 16 possible that we would need additional discovery.
11:21 17 THE COURT: Well, whatever you need with
11:21 18 respect to this issue, if you need to do an additional
11:21 19 report, if you need to do additional discovery, you
11:21 20 have permission to do so.
11:21 21 What else can I do for you to help here?
11:21 22 MR. CHUEBON: Okay. Thank you, Your
11:21 23 Honor.
11:21 24 If Your Honor will hear argument on what
11:21 25 I believe is the last remaining motion, which was with

11:21 1 regard to the motion to strike or limit Dr. Russ'
11:21 2 noninfringement testimony.
11:21 3 And this was -- well, I think this was
11:21 4 with regard to the claim construction, but I think
11:21 5 you've resolved that already.
11:21 6 THE COURT: I have no other issues, but
11:21 7 you're welcome to -- I think I've resolved everything I
11:21 8 had on my chart.
11:21 9 MR. CHUEBON: Okay. Thank you, Your
11:21 10 Honor.
11:21 11 THE COURT: Anything else from the
11:22 12 defendant?
11:22 13 MS. FENTON: Your Honor, would you like
11:22 14 to hear argument on the motions in limine today?
11:22 15 THE COURT: You know, we have some time.
11:22 16 Do I have the motions in limine here?
11:22 17 MS. FENTON: We've come to an agreement
11:22 18 on a number of them. We've come to agreement on a
11:22 19 number of them.
11:22 20 THE COURT: Why don't you tell me which
11:22 21 ones you've agreed to?
11:22 22 MS. FENTON: My colleague, Ms. Holly
11:22 23 Engelmann, is going to address them. Thank you, Your
11:22 24 Honor.
11:22 25 THE COURT: Yes, ma'am.

11:22 1 MS. ENGLEMANN: Good morning, Your Honor.
11:22 2 Holly Engelmann. I'm coming here from Dallas. I think
11:22 3 I'm the only Texas attorney who can't or doesn't tell
11:22 4 everybody that we are really good friends. And so I'm
11:22 5 happy to be here in your courtroom today.
11:22 6 THE COURT: We're friends now.
11:22 7 MS. ENGLEMANN: Okay. I'll get that
11:22 8 marketing out right away.
11:22 9 THE COURT: No. I wouldn't do that.
11:22 10 (Laughter.)
11:22 11 MS. ENGLEMANN: It hasn't stopped other
11:22 12 people.
11:22 13 The parties have agreed to IOENGINE's MIL
11:22 14 4.
11:23 15 THE COURT: IOENGINE's 4, agreed. Okay.
11:23 16 MS. ENGLEMANN: Roku MIL 1.
11:23 17 THE COURT: Give me one second. Agreed.
11:23 18 Okay.
11:23 19 MS. ENGLEMANN: And then Roku MIL 2.
11:23 20 And there's actual specific language that
11:23 21 the parties agreed to, and we submitted it in one of
11:23 22 those charts.
11:23 23 THE COURT: Whatever -- whatever you all
11:23 24 agree to, I'm happy -- I will adopt.
11:23 25 MS. ENGLEMANN: Okay.

11:23 THE COURT: So the others I need to run through real quick?

11:23 MS. ENGLEMANN: Yeah. That means seven remaining, and I'm optimistic that it'll be pretty brief.

11:23 THE COURT: Okay. Well, so you may be seated, and I'll run through these.

11:23 MS. ENGLEMANN: Thank you, Your Honor.

11:23 THE COURT: IOENGINE MIL No. 1: Preclude evidence, testimony, and argument relating to unasserted or withdrawn claims, art, and theories.

11:23 I can't -- for both sides, if it's not in the case, it's not relevant and shouldn't come in.

11:23 No. 2: Preclude fact witness testimony comparing accused products, asserted claims, and prior art.

11:24 Generally speaking, that's inadmissible. I would grant that.

11:24 Now, to the extent that this is intended to preclude Roku engineers from explaining how things work or anything like, that's not included in my MIL. The experts, if they have percipient information of how things operate or if the witnesses know how things work, that's admissible as far as I'm concerned.

11:24 They don't -- no opinion. Like, we don't

11:24 1 infringe. But if it's, you know, how something works,
11:24 2 they can -- as long as the witness was disclosed in
11:24 3 sufficient time for each you to depose them.
11:24 4 Yes, sir.
11:24 5 MR. LEIBOWITZ: I think, Your Honor, the
11:24 6 issue is with respect to fact witnesses not
11:24 7 comparing -- for example, a Roku engineer can talk
11:24 8 about how the products work, but what they shouldn't be
11:24 9 saying is, let's look at the claim language and compare
11:24 10 the products --
11:24 11 THE COURT: No. They don't get --
11:24 12 (Simultaneous speakers.)
11:24 13 MR. LEIBOWITZ: That's the expert.
11:25 14 THE COURT: The fact witnesses don't get
11:25 15 to talk about the claims.
11:25 16 MR. LEIBOWITZ: Thank you, Your Honor.
11:25 17 THE COURT: Yes, ma'am.
11:25 18 MS. ENGLEMANN: Sorry to interrupt.
11:25 19 Does that also include IOENGINE's fact
11:25 20 witness Mr. McNulty who's the inventor? Because in
11:25 21 prior trials he has gone claim-by-claim mapping, and
11:25 22 that's why this is disputed.
11:25 23 MR. LEIBOWITZ: And that's not with
11:25 24 respect to infringement, Your Honor. He talks about
11:25 25 his invention and his conception. And of course, he

11:25 1 refers to claims when he talks about the invention that
11:25 2 he invented.
11:25 3 THE COURT: No. He's not going to say
11:25 4 anything about Roku products.
11:25 5 MR. LEIBOWITZ: No, no. Of course not,
11:25 6 Your Honor.
11:25 7 THE COURT: Right. No. He can talk
11:25 8 about his patent, and y'all can cross him about his
11:25 9 patent.
11:25 10 MS. ENGLEMANN: But the problem is he's
11:25 11 not comparing them to Roku products. He's comparing
11:25 12 them to some prototypes. So he's saying
11:25 13 element-by-element, see. It's in my prototype. It's
11:25 14 here, here, and here.
11:25 15 MR. LEIBOWITZ: It's a conception issue,
11:25 16 Your Honor. Conception and reduction to practice.
11:25 17 THE COURT: I have no problem with that.
11:25 18 MR. LEIBOWITZ: Thank you, Your Honor.
11:25 19 THE COURT: No. 3: Preclude evidence,
11:25 20 et cetera, relating to Roku's investments, employment,
11:26 21 and contributions to the U.S., Texas, and this
11:26 22 district.
11:26 23 You know what interested me in the first
11:26 24 case I had with Roku was when I found out having --
11:26 25 with them so unhappy about the case being in Texas that

11:26 1 they actually -- I think that all the witnesses were
11:26 2 from Austin.
11:26 3 But however, let me make this a broader
11:26 4 issue. The facts are the facts. Whatever the
11:26 5 plaintiff is -- I don't know what -- I don't know what
11:26 6 you are, nonpracticing entity. Whatever you are,
11:26 7 that's just a fact and you get to tell your story about
11:26 8 the invention, who you are, what you are, why you're
11:26 9 here, you have a patent.
11:26 10 Roku gets to tell their story, what Roku
11:26 11 does, how successful they've been, you have IP, you own
11:26 12 your own patents, all that stuff. That's all fine.
11:26 13 Roku doesn't get to say, we have patents.
11:26 14 We would never infringe. We have our own patents. You
11:26 15 just get to say, we respect IP. We have lots of
11:26 16 patents.
11:26 17 The plaintiff doesn't get to talk about
11:27 18 Roku being a big evil corporation. You don't get to
11:27 19 say that they're an evil bloodsucking, you know, entity
11:27 20 that wants, you know, money and shouldn't get it.
11:27 21 You know, so -- and I tend to police that
11:27 22 stuff -- I say that. I've never had to do anything
11:27 23 about it, but you all -- you each get to tell your
11:27 24 stories about where you are and what you've
11:27 25 accomplished.

11:27 1 With respect to plaintiff's MIL No. 5:
11:27 2 Preclude demonstrations that were not previously
11:27 3 disclosed or of non prior art.
11:27 4 I'm going to put this in the bucket.
11:27 5 This is not a MIL. Nothing gets talked to in front of
11:27 6 the jury that's not in the expert report. And I would
11:27 7 think that would cover everything any of you all care
11:27 8 about.
11:27 9 Roku MIL No. 3. No. Settlement
11:28 10 agreements from prior litigation don't come in with the
11:28 11 exception of whatever's been disclosed in a damages
11:28 12 expert report and that's relevant. Those obviously get
11:28 13 to come in. Otherwise, discussions of other litigation
11:28 14 doesn't get to come in.
11:28 15 Now, it sounds like the plaintiff has had
11:28 16 other litigations, which means at least some of his --
11:28 17 their folks have testified before. If at my trial you
11:28 18 want to cross-examine the inventor, I guess, with what
11:28 19 he testified about before, if you want to impeach him
11:28 20 using that -- one of those sworn statements, you just
11:28 21 say from a different proceeding or something. You
11:28 22 know, don't get into, you know, he's sued other people.
11:28 23 All that, just it's, you know, let me --
11:28 24 I'm going to read to you -- now, the only catch here is
11:28 25 that the plaintiff may want the orientation of, you

11:28 1 know, where it came from if there's more than one
11:29 2 trial.
11:29 3 I mean, you all can talk about this, how
11:29 4 you'd like the defendant to -- what you'd like the
11:29 5 defendant to say with regard to if they're using
11:29 6 testimony from another trial, what you -- if there's
11:29 7 something you can agree to about how they'll address
11:29 8 that. Because I want your witness to know where it is.
11:29 9 I mean, he's probably been deposed a bunch. He's, you
10 know...
11:29 11 And so it'd be fair to him to know that,
11:29 12 but I'm also sympathetic that you don't want -- we
11:29 13 don't want to be talking about a lot of other trials.
11:29 14 And that's true of anyone. I mean, if
11:29 15 they're a Roku -- there may be Roku witnesses who have
11:29 16 testified in my court, and so that can come in -- that
11:29 17 prior testimony can be used for impeachment as well.
11:29 18 No. 4: Exclude any testimony, argument,
11:29 19 documents, or other evidence regarding the inspection
11:29 20 of the MediKey prototype device that was conducted
11:29 21 during prior litigations.
11:30 22 Is the inspection of the MediKey, which
11:30 23 is M-e-d-i-K-e-y, is that inspection disclosed anywhere
11:30 24 in any expert report?
11:30 25 MR. LEIBOWITZ: Yes, Your Honor. It is.

11:30 1 THE COURT: Okay.
11:30 2 Yes, ma'am.
11:30 3 MS. ENGLEMANN: Your Honor, the issue
11:30 4 there is just that Roku wasn't able to participate in
11:30 5 the inspection because it was done many years ago and
11:30 6 the devices have been destroyed before the litigation
11:30 7 began. So there's no way for Roku to put on its own
11:30 8 witness to talk about the prototype or device.
11:30 9 MR. LEIBOWITZ: Your Honor, I think both
11:30 10 experts are working from the same information with
11:30 11 respect to that.
11:30 12 The MediKey device was inspected in prior
11:30 13 litigation. There were reams of data that were
11:30 14 provided with respect to the -- actually all of the ins
11:30 15 and outs of the MediKey that were collected during that
11:30 16 inspection, including videos, including slides --
11:30 17 THE COURT: So their experts have the
11:30 18 same access that yours does?
11:30 19 MR. LEIBOWITZ: Correct, Your Honor.
11:30 20 THE COURT: Okay.
11:30 21 And what is your concern?
11:30 22 MR. RICCIUTI: I'll make sure that the
11:31 23 microphone is working.
11:31 24 Christopher Ricciuti again, Your Honor.
11:31 25 I think part of the issue here is that

11:31 1 the MediKey really relates to an allegation of
11:31 2 inequitable conduct that Roku has.
11:31 3 And so in 2010, Mr. McNulty submitted a
11:31 4 declaration to the PTO --
11:31 5 THE COURT: I mean, if it's inequitable
11:31 6 conduct, then it doesn't need to come in.
11:31 7 MR. RICCIUTI: But I think what plaintiff
11:31 8 is trying to do here is that we dispute the allegations
11:31 9 in that declaration, we believe that those allegations
11:31 10 are false, that the MediKey did not operate the way
11:31 11 that Mr. McNulty said, but they want to have
11:31 12 Mr. McNulty rely on that.
11:31 13 THE COURT: Here's what I'm going to do.
11:31 14 When we're at trial, I'm going to grant
11:31 15 the motion in limine in a true limine form, which just
11:31 16 means at trial. Once I understand what's going on
11:31 17 better, you can approach the bench and let me know that
11:31 18 you're going to talk about the MediKey and why it's
11:31 19 relevant to the issue that you're -- it being relevant
11:31 20 to infringement.
11:31 21 I can't think of anything else. I doubt
11:32 22 it has anything to do with --
11:32 23 MR. LEIBOWITZ: It's conception and
24 reduction to practice, Your Honor. It's a device that
11:32 25 was worked on back in 2002, and that's where it fits in

11:32 1 this story. We're certainly not raising an inequitable
11:32 2 conduct issue --
11:32 3 (Simultaneous conversation.)
11:32 4 THE COURT: Well, why -- well, okay.
11:32 5 Is the MediKey something that your folks
11:32 6 made?
11:32 7 MR. LEIBOWITZ: Yes, Your Honor.
11:32 8 THE COURT: Okay. And what they want to
11:32 9 talk about is the MediKey was -- the prototype device
11:32 10 was done -- was it done prior to the filing of the
11:32 11 filing application?
11:32 12 MR. LEIBOWITZ: Yes, Your Honor.
11:32 13 THE COURT: So y'all are trying to
11:32 14 establish that -- that date with regard to conception
11:32 15 to reduction?
11:32 16 MR. LEIBOWITZ: Sure, Your Honor.
11:32 17 It fits in the story of the conception
11:32 18 and then all the diligence that happens between
11:32 19 conception and reduction to practice.
11:32 20 THE COURT: And does that -- is anything
11:32 21 you all are doing challenging that issue? I mean, in
11:32 22 other words, are they having to get an earlier -- are
11:32 23 they having to use that to get an earlier date to get
11:32 24 behind any of your art?
11:32 25 MR. RICCIUTI: Yes. And so we're --

11:32 1 that's a part of it. And so we're --
11:33 2 (Simultaneous conversation.)
11:33 3 THE COURT: Then it's going to come in.
11:33 4 MR. RICCIUTI: But the -- what we're
11:33 5 really trying to preclude is this inspection of the
11:33 6 MediKey that happened, I believe it was in 2015 or 2016
11:33 7 in another litigation.
11:33 8 THE COURT: Well, an inspection that post
11:33 9 dates the filing of the patent.
11:33 10 MR. RICCIUTI: It was conducted in other
11:33 11 litigation.
11:33 12 THE COURT: Now, explain to me why that's
11:33 13 relevant to conception.
11:33 14 MR. LEIBOWITZ: Your Honor, it just --
11:33 15 it's just that all the inspection did was show we don't
11:33 16 have the device. The device no longer exists. And so
11:33 17 the -- for example, the inspection has pictures of what
11:33 18 happened when you clicked on a button on the device.
11:33 19 THE COURT: Are you -- is the defendant
11:33 20 fighting that the MediKey, in fact, was not part of the
11:33 21 reduction and conception -- is not proof of reduction
11:33 22 and conception?
11:33 23 MR. RICCIUTI: They don't allege that the
11:33 24 MediKey itself is reduction to practice. That
11:33 25 allegation's not there.

11:33 1 The -- we do dispute that it operated the
11:34 2 way Mr. McNulty said. And even IOENGINE actually
11:34 3 disputes that the inspection showed one way or another
11:34 4 how the device operated. And it doesn't actually show
11:34 5 that it operated the way they did.
11:34 6 And so, I mean, this is a central piece
11:34 7 of evidence related to inequitable conduct, but we
11:34 8 don't believe that it should come in as purported proof
11:34 9 of how it operated during the jury trial.
11:34 10 THE COURT: Well, we'll take it up at
11:34 11 trial. But when you move to introduce it -- I'll say
11:34 12 this generically, which is that if I'm persuaded that
11:34 13 it -- that you all are put -- by you all -- if I'm
11:34 14 persuaded the defendant is putting into question some
11:34 15 issue that this helps the plaintiff prove, then it's
11:34 16 going to come in.
11:34 17 That -- in other words, you could maybe
11:34 18 stipulate your way out of this, or you can do something
11:34 19 else to obviate the need for them to have to use this.
11:34 20 But I'm -- if either side can convince me
11:35 21 that they are putting something in evidence because the
11:35 22 other side is fighting over it and they have to prove
11:35 23 something, that -- the side that wants to put it in is
11:35 24 almost always going to win. I mean, that's bilateral.
11:35 25 And so if -- I don't know why you're --

11:35 1 so, you know, I will tell you that you all -- this
11:35 2 after five years of sitting on this side -- I know why
11:35 3 because I sat on your side for 20 years -- but I can
11:35 4 tell you all, you all get really exercised over things
11:35 5 that ultimately the jury doesn't -- put it gently --
11:35 6 couldn't give a flip about.
11:35 7 So, you know, you all feel like there's
11:35 8 going to be a gong clang and a strike of -- clap of
11:35 9 thunder when the MediKey device is talked about and it
11:35 10 will change the course of history and the course of the
11:35 11 trial. And I'm pretty sure, if I were to talk to the
11:35 12 jury at the end of it and -- about the MediKey, they
11:35 13 would say, we have no idea what you're talking about.
11:36 14 In the sea of things we heard over the five days.
11:36 15 That's been my general experience in
11:36 16 talking to them.
11:36 17 But I understand why you all care about
11:36 18 it. Because I cared a lot about those things when I
11:36 19 was on your side. So that's how I'm going to deal with
11:36 20 the MediKey issue.
11:36 21 And then finally I have exclude -- No. 5:
11:36 22 Exclude testimony, et cetera, related to any prototype
11:36 23 device for any purpose other than to show alleged
11:36 24 diligence including -- does the plaintiff intend to use
11:36 25 any prototype -- any prototype device for any purpose

11:36 1 other than to show alleged diligence, et cetera?
11:36 2 MR. CHUEBON: Thank you, Your Honor.
11:36 3 The reason that the -- these other
11:36 4 prototypes would come in is that these are similar to
11:36 5 the MediKey. They were just additional iterations of
11:36 6 prototypes created by Mr. McNulty in the time period
11:36 7 between conception and the filing of the earliest
11:36 8 priority application.
11:36 9 And the evidence not only conception but
11:37 10 diligence and they corroborate.
11:37 11 THE COURT: I think that's what I just
11:37 12 said. I mean, they -- do you intend to use them for
11:37 13 any other reason --
11:37 14 MR. CHUEBON: No, Your Honor.
11:37 15 THE COURT: -- than conception diligence?
11:37 16 Well, then I can grant the MIL because
11:37 17 that's what the MIL says. That you can't use them for
11:37 18 any reason other than those two things.
11:37 19 Now, if you want to use a prototype for
11:37 20 some other reason, just approach the bench and tell me
11:37 21 you're going to want to use a prototype and why, what
11:37 22 it has to do with infringement or invalidity, and I'll
11:37 23 be happy to rule on it.
11:37 24 MR. CHUEBON: Your Honor, just one
11:37 25 clarification.

11:37 1 The end language of the MIL says:
11:37 2 Exclusion of testimony or argument that the prototype
11:37 3 devices evidence conception of the asserted claims.
11:37 4 THE COURT: Right. If it has to do with
11:37 5 conception or diligence, I'm perfectly happy with it
11:37 6 coming in.
11:37 7 MR. CHUEBON: Okay. So I just wanted to
11:37 8 make that clarification. So it can come in for
11:37 9 conception and diligence.
11:37 10 THE COURT: Conception or diligence.
11:37 11 MR. CHUEBON: Thank you, Your Honor.
11:37 12 MR. LEIBOWITZ: Your Honor, can I raise
11:37 13 one issue with respect to one of our MILs?
11:37 14 THE COURT: Sure.
11:37 15 MR. LEIBOWITZ: Then this is our --
11:38 16 IOENGINE's MIL No. 5 with respect to the demonstration
11:38 17 of the devices which Your Honor denied.
11:38 18 And the issue there, Your Honor, isn't
11:38 19 about disclosure or something like that. The issue
11:38 20 with this MIL is one of the things we think they want
11:38 21 to do is demonstrate a supposed prior art device.
11:38 22 The problem is that it isn't in prior
11:38 23 art.
11:38 24 THE COURT: Let me make this as clear as
11:38 25 I can.

11:38 1 MR. LEIBOWITZ: Sure.
11:38 2 THE COURT: Anything that they do, if you
11:38 3 can persuade me, once they've done it -- now, this is
11:38 4 all prophylactic. You don't know that they'll do it.
11:38 5 You think that they might to it.
11:38 6 If they do something and you can persuade
11:38 7 me that because of something they asked or answer they
11:38 8 got or evidence they put in or evidence -- an exhibit
11:38 9 they used, I need to let you put something in now that
11:38 10 I ruled on, that it will have opened the door.
11:38 11 MR. LEIBOWITZ: So, Your Honor, I don't
11:38 12 think this falls in that category, which is why I
11:38 13 wanted to address it.
14 THE COURT: Okay.
11:39 15 MR. LEIBOWITZ: The issue is that the
11:39 16 device they want to demonstrate is not a prior art
11:39 17 device. The only one they have post dates --
11:39 18 THE COURT: Well, that's not a motion in
11:39 19 limine. That's a substantive objection to the exhibit.
11:39 20 MR. LEIBOWITZ: Okay.
11:39 21 THE COURT: So that's not a motion in
11:39 22 limine. And so when they -- when they move -- and I
11:39 23 don't know whether you're right or not, but when they
11:39 24 move to admit the exhibit or whatever it is you're
11:39 25 unhappy about, object and say why, and I'll rule on it.

11:39 1 MR. LEIBOWITZ: Okay.
11:39 2 THE COURT: And I promise you -- look. I
11:39 3 had a trial where -- this is going to be a longer story
11:39 4 than you want.
11:39 5 I had a trial in this -- no, it wasn't in
11:39 6 this courtroom. It was over in the old courtroom,
11:39 7 courthouse when I was a magistrate.
11:39 8 But it was a case where they were --
11:39 9 couple of gentlemen had gotten arrested and they were
11:39 10 suing the police department for arresting them. And
11:40 11 the plaintiff's on the witness stand. And the defense
11:40 12 lawyer starts asking him about all of his criminal
11:40 13 convictions. None of which -- none of which were
11:40 14 correct.
11:40 15 However, he did have a son who had the
11:40 16 identical name who had been convicted of a lot.
11:40 17 Now, none of it was relevant because it
11:40 18 was his son, and if the people asking the questions had
11:40 19 done a little better job, they might have figured out
11:40 20 the person who got arrested was a lot younger. When
11:40 21 they met the plaintiff, they would have figured that
11:40 22 out.
11:40 23 But when I went -- when I talked to them,
11:40 24 because there was a motion for mistrial, they said, oh,
11:40 25 no, just tell the jury to disregard the fact that the

11:40 1 guy's son has been arrested for all this stuff.
11:40 2 I said, I don't think that would work.
11:40 3 And I sanctioned them.
11:40 4 But my point is --
11:40 5 (Laughter.)
11:40 6 THE COURT: -- that that's the kind of
11:40 7 thing that if there's a -- if you -- that's the kind of
11:41 8 thing the jury can't forget. Like your inventor, if he
11:41 9 has a DWI -- I doubt he does, but if he has a DWI, I
11:41 10 can't just say, forget he had a DWI. That's why we
11:41 11 have motions in limine.
11:41 12 On everything y'all are talking about, no
11:41 13 one on the jury will care. Just if they move to admit
11:41 14 it, object. And I'll rule on it. And they'll -- jury
11:41 15 will yawn and we'll go down the road.
11:41 16 So I promise you, I've been through a
11:41 17 couple of trials now and everything will be fine. If
11:41 18 you're unhappy about something, just object and I'll
11:41 19 rule on it.
11:41 20 MR. LEIBOWITZ: Okay. Thank you, Your
11:41 21 Honor.
11:41 22 THE COURT: Is there anything else we
11:41 23 need to take up?
11:41 24 MR. LEIBOWITZ: I don't think there's
11:41 25 anything else from plaintiff, Your Honor.

11:41 1 MR. DEACONSON: Nothing other than if the
11:41 2 Court's going to talk about hours and jurors and all
11:41 3 that kind of stuff.
11:41 4 THE COURT: How many patents are there?
11:41 5 MR. LEIBOWITZ: There's two patents, Your
11:41 6 Honor.
11:41 7 THE COURT: 11 hours per side.
11:41 8 And you'll have the -- one of my
11:42 9 magistrate judges will pick the jury. You'll have four
11:42 10 strikes per side. You'll -- there'll be seven jurors
11:42 11 on the -- on the jury.
11:42 12 There's more I have, but we're going to
11:42 13 have another --
11:42 14 MR. DEACONSON: I'm assuming we'll get --
11:42 15 as we -- as I just saw with the trial coming next week,
11:42 16 you'll send an order that'll say, like, 30 minutes for
11:42 17 opening and closing --
11:42 18 THE COURT: Yes.
11:42 19 MR. DEACONSON: -- and that kind of
11:42 20 stuff, the standard stuff.
11:42 21 THE COURT: Anything that I've done in
11:42 22 the past, it will be exactly like I've done in the
11:42 23 past.
11:42 24 MR. DEACONSON: That's what I'm assuming,
11:42 25 Your Honor. Thank you, sir.

11:42 THE COURT: I will say that, so you know, we need the jury charge -- proposed jury charge by close of business the Friday before trial.

And also, because it's helpful I think for you all to know, the way I deal with can you talk to witnesses is: If a witness is on direct, you can talk to them. If your witness is on cross, you cannot with one exception per side. My guess is in the plaintiff's case, it' will be your client, the inventor. I don't know who it'll be for Roku.

But there's one -- if you have a person who's your corporate representative, I put no restrictions on when you can talk to them at any time during trial. And so I feel like you need to be able to talk to people regardless.

So anything else we need to take up?

Well, this was much more enjoyable than my hearing yesterday. So thank you all for being here.

(Hearing adjourned.)

UNITED STATES DISTRICT COURT)
WESTERN DISTRICT OF TEXAS)

I, Kristie M. Davis, Official Court Reporter for the United States District Court, Western District of Texas, do certify that the foregoing is a correct transcript from the record of proceedings in the above-entitled matter.

I certify that the transcript fees and format comply with those prescribed by the Court and Judicial Conference of the United States.

Certified to by me this 23rd day of September 2023.

/s/ Kristie M. Davis
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11:43