WINSTON & STRAWN LLP

BLOG

Trial Alert: Countdown to Kick-Off — The Parties and the Pleadings

OCTOBER 1, 2020

12(b)(6) Motions to Dismiss

The trial is coming, the trial is coming!!

Before the trial begins on October 5, 2020, let's take a brief trip down memory lane—starting with the allegations and the parties' motions to dismiss.

To begin, let's examine who the parties are and what the accused patent covers.

The plaintiff and patent owner is an NPE called MV3 Partners, LLC (MV3). The defendant and accused infringer is Roku, Inc. (Roku). The pertinent Roku product lines include Roku TV, several Roku media players, and a related Roku mobile app (collectively, the Roku Devices).

The lone asserted patent is U.S. Patent No. 8,863,223 (the '223 Patent), entitled "Mobile Set Top Box." The '223 Patent discloses a set-top box that acts as a conduit between disparate data networks and display devices, as roughly depicted in Figure 1:

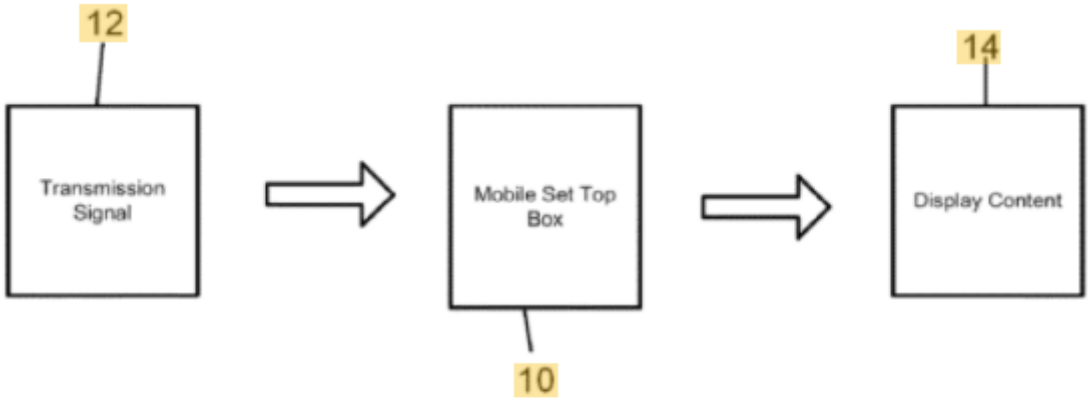

Figure 1

According to the specification of the '223 Patent, the invention solved two problems that were present in prior art. Namely: 1) prior art set top boxes could "only be used with the network that provides the box," and 2) prior art mobile computing devices could not "up-convert" the content intended for a mobile computing device, so that the content properly fit on a large-screen high-definition television.

On October 16, 2018, MV3 sued Roku. The complaint alleged direct infringement, indirect infringement, and that the infringement occurs "literally or under the doctrine of equivalents."

Roku moved to dismiss MV3's direct infringement claims for failure to meet the pleading requirements. Because MV3 asserted that Roku was "directly infringing, literally or under the doctrine of equivalents," Roku argued that MV3 needed to explain how claim limitations were met under the doctrine of equivalents.

Judge Albright denied the motion, noting that MV3 will, in good faith, proffer on its infringement contentions in due course.

This was not the only motion to dismiss: MV3 also filed a 12(b)(6) Motion, and it met a similar fate.

Following Judge Albright's denial of Roku's Motion to Dismiss, Roku answered the complaint alleging, among other things, inequitable conduct. MV3 argued that Judge Albright should dismiss the inequitable conduct claim and defense because Roku's allegations are conclusory and not based in fact. Judge Albright denied that motion.

Takeaway: It will be challenging to prevail on motions to dismiss. Motions challenging the sufficiency of the complaint's infringement allegations are likely to be denied in light of the requirement that the plaintiff provide infringement contentions according to the court's standing order. Even issues that must be plead with particularity, like inequitable conduct, may survive the pleading stage.

So, as of the pleading stage, all claims, defenses, and counterclaims are fair game at trial. Be on the lookout for our upcoming posts to see whether any claims and/or counterclaims were booted after the motion to dismiss stage!

NEXT UP: Our report on the *Markman* hearing!

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