

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ROVI TECHNOLOGIES CORP.,
Patent Owner.

Case Nos. IPR2019-00285, IPR2019-00286,
IPR2019-00287, IPR2019-00288, IPR2019-00289,
Patent No. 9,578,363 B2

Before KARL D. EASTHOM, LYNNE E. PETTIGREW, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

On November 12, 2018, Comcast Cable Communications, LLC, (“Petitioner”) filed six petitions (*see, e.g.*, IPR2019-00285, Paper 2), each requesting *inter partes* review of claims 1–20 of U.S. Patent No. 9,587,363 (*see, e.g.*, IPR2019-00285, Ex. 1101, “the ’363 Patent”). This Decision addresses the Petitions filed in IPR2019-000285 to -00289 (collectively, “the Petitions”).¹ Rovi Technologies Corp. (“Patent Owner”) filed Preliminary Responses. *See, e.g.*, IPR2019-00285, Paper 8. Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons given below, upon consideration of the Petitions, the Preliminary Responses, and the supporting evidence, we exercise our discretion under 35 U.S.C. § 314 and deny institution of an *inter partes* review.

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies as the real parties-in-interest the following: Comcast Corp., Comcast Cable Communications, LLC, Comcast Cable Communications Management, LLC, Comcast Business Communications, LLC, Comcast Holdings Corp., Comcast Shared Services, LLC, Comcast of Santa Maria, LLC, Comcast of Lompoc, LLC, Comcast Financial Agency Corporation, and Comcast STB Software I, LLC. *See, e.g.*, IPR2019-00285,

¹ The sixth petition was filed in IPR2019-00284, for which we instituted review on June 7, 2019.

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Paper 2, 1. Patent Owner names as the real parties-in-interest Rovi Technologies Corp., Rovi Guides, Inc., and Rovi Corp. *See, e.g.*, IPR2019-00285, Paper 4, 1.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), each party identifies a judicial matter that would affect, or be affected by, a decision in these proceedings. In particular, the parties inform us that the '363 Patent is asserted in *Rovi Guides, Inc. v. Comcast Corp.*, No. 2-18-cv-00253 (C.D. Cal.), filed January 10, 2018 and *In re Certain Digital Video Receivers and Related Hardware and Software Components*, Inv. No. 337-TA-1103 (ITC), filed February 8, 2018 (“related ITC proceeding”). *See, e.g.*, IPR2019-00285, Paper 2, 1; Paper 4, 1. Petitioner further informs us that Patent Owner subsequently moved to terminate the portions of the related ITC proceeding relating to the '363 Patent. *See, e.g.*, IPR2019-00285, Paper 2, 1–2.

On February 21, 2019, Patent Owner filed Reissue Application No. 16/282,142 requesting reissue of the '363 patent. *See* IPR2019-00285, Paper 9, 1 (Patent Owner’s Updated Mandatory Notices).

In addition to the instant Petitions, Petitioner additionally filed IPR2019-00284 also challenging claims 1–20 of the '363 Patent.

C. Challenged Claims

In each of the six petitions, Petitioner challenges claims 1–20 of the '363 Patent. *See, e.g.*, IPR2019-00225, Paper 2, 27–70.

D. Discretionary Denial

Patent Owner asserts we should exercise our discretion under 35 U.S.C. § 314(a) to deny all six petitions. *See, e.g.*, IPR2019-00285, Paper 8, 4–13 (citing *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 9–10 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i)).

On April 9, 2019, we issued an order in each of the six proceedings requiring that Petitioner provide a notice identifying a ranking of the six petitions in the order in which it wishes the panel to consider the merits, if the Board uses its discretion to institute any of the petitions, and a succinct explanation of the differences between the petitions, why the differences are material, and why the Board should exercise its discretion to consider instituting on more than one petition. *See, e.g.*, IPR2019-00285, Paper 10 (“Case Management Order”), 4–5. We, additionally, gave the Patent Owner an opportunity to respond. *Id.*

On April 23, 2019, pursuant to our Case Management Order, Petitioner filed its Notice Ranking Petitions. *See, e.g.*, IPR2019-00285, Paper 11 (“Notice”). On May 7, 2019, Patent Owner filed its Response to Petitioner’s Notice Ranking Petitions. *See, e.g.*, IPR2019-00285, Paper 12 (“Response”).²

In its Notice, Petitioner requests we consider the petition in IPR2019-00284 first. Notice, 1. For the reasons given in our decision instituting *inter*

² The Case Management Order instructs the parties to file the same paper in each of the proceedings. Case Management Order, 4. Our reference herein to “Notice” and “Response” is to the same paper filed in each proceeding by Petitioner and Patent Owner, respectively.

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partes review in IPR2019-00284, we conclude Petitioner establishes a reasonable likelihood of prevailing in demonstrating the unpatentability of claims 1–20 of the ’363 Patent. Accordingly, all of the challenged claims in these proceedings are subject to an *inter partes* review in IPR2019-00284.

Under § 314(a), the Director has discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Our discretionary determination of whether to institute review takes into consideration guidance in the Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39,989 (August 13, 2018) (hereinafter “Trial Practice Guide Update”), <https://go.usa.gov/xU7GP>. In particular, the Trial Practice Guide Update states

[t]here may be other reasons besides the “follow-on” petition context where the “effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings,” 35 U.S.C. § 316(b), favors denying a petition even though some claims meet the threshold standards for institution under 35 U.S.C. §§ 314(a), 324(a).

Trial Practice Guide Update 10–11. We also are mindful to construe our rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *Deeper, UAB v. Vexilar, Inc.*, Case

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IPR2018-01310, slip op. at 42 (PTAB Jan. 24, 2019) (Paper 7)
(informative).

In considering a balanced assessment of all relevant circumstances in these proceedings, we are not persuaded by Petitioner that institution of additional, concurrent proceedings would promote the efficient administration of the Office or the integrity of the system. *See* Trial Practice Guide Update 10. Specifically, Petitioner contends additional proceedings are necessary due to its concerns relating to potential arguments Patent Owner may raise regarding, among other things, priority date or specific claim limitations. *See generally* Notice. In its Response to the Notice, Patent Owner concedes the priority date issue, and is vague as to whether it intends to dispute some of the other issues. *See generally* Response.

We have considered the Petitions, Preliminary Responses, asserted art, and other evidence, as well as other submissions by the parties. We also have considered Petitioner's contentions and Patent Owner's preliminary response in IPR2019-00284 in accordance with Petitioner's preference that that proceeding be considered first. We note that the IPR2019-00284 Petition includes two obviousness challenges for each independent claim. IPR2019-00284, Paper 2, 9. We further note that there is overlap in the references at issue in these petitions. For example, the Harrar reference at issue in all of these petitions is also raised in IPR2019-00284, and the Calderwood reference, which is raised in three of these five petitions, is also raised in IPR2019-00284. As set forth in the decision on institution in IPR2019-00284, *inter partes* review of claims 1–20 of the '363 Patent is instituted with respect to all grounds set forth in that petition.

As explained above and in our Case Management Order, in exercising our discretion, we consider the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings. *See* Trial Practice Guide Update 10. We determine that the integrity of the system is sufficiently served here by our institution of *inter partes* review of all challenged claims of the '363 patent in IPR2019-00284. *See also Gen. Plastic*, slip op. at 16 (“[W]e are mindful of the goals of the AIA—namely, to improve patent quality and make the system more efficient.”). On the other hand, we do not find the asserted differences between the petition in that proceeding and the Petitions addressed here are sufficiently material and in dispute to support the inefficiencies and costs associated with instituting an additional five *inter partes* reviews.³ *Cf. id.* at 16–17 (recognizing the “potential for abuse of the review process by repeated attacks on patents”).

Accordingly, we exercise our discretion under 35 U.S.C. § 314 to deny institution of review in IPR2019-00285 to -00289.

III. CONCLUSION

For the foregoing reasons, based on a balanced assessment of the circumstances of this case, we exercise our discretion under 35 U.S.C. § 314, and deny the instant Petitions requesting institution of *inter partes* review of the '363 Patent in IPR2019-00285 to -00289.

³ Petitioner filed 28 petitions challenging six patents, including the '363 Patent discussed here.

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IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Petitions are *denied* as to all challenged claims of the '363 Patent in IPR2019-00285, IPR2019-00286, IPR2019-00287, IPR2019-00288, and IPR2019-00289 and no trial is instituted in those cases.

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