

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COMCAST CABLE COMMUNICATIONS, LLC,  
Petitioner,

v.

ROVI GUIDES, INC.,  
Patent Owner.

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Case Nos. IPR2019-00556, IPR2019-00557, and IPR2019-00558  
Patent 9,668,014 B2

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Before KARL D. EASTHOM, LYNNE E. PETTIGREW, and  
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

## I. INTRODUCTION

On January 10, 2019, Comcast Cable Communications, LLC, (“Petitioner”) filed four Petitions (*see, e.g.*, IPR2019-00556, Paper 2), each requesting *inter partes* review of claims 1–20 of U.S. Patent No. 9,668,014 B2 (*see, e.g.*, IPR2019-00556, Ex. 1001, “the ’014 Patent”). This Decision addresses the three petitions filed in IPR2019-00556, IPR2019-00557, and IPR2019-00558 (collectively, “the Petitions”). Rovi Guides, Inc. (“Patent Owner”) filed Preliminary Responses. *See, e.g.*, IPR2019-00556, Paper 6. 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 *inter partes* review in IPR2019-00556, IPR2019-00557, and IPR2019-00558.

## II. BACKGROUND

### A. *Real Parties-in-Interest*

Petitioner identifies as the real parties-in-interest the following: Comcast Corp.; Comcast Business Communications, LLC; Comcast Cable Communications Management, LLC; Comcast Cable Communications, LLC; Comcast Financial Agency Corp.; Comcast Holdings Corp.; Comcast Shared Services, LLC; Comcast STB Software I, LLC; Comcast of Santa Maria, LLC; and Comcast of Lompoc, LLC. *See, e.g.*, IPR2019-00556,

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Paper 2, 1. Patent Owner names as the real parties-in-interest Rovi Guides, Inc. and Rovi Corp. *See, e.g.*, IPR2019-00556, Paper 3, 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 '014 Patent is asserted in *Rovi Guides, Inc. v. Comcast Corp.*, Case No. 2-18-cv-00253 (C. D. Cal.) filed January 10, 2018. *See, e.g.*, IPR2019-00556, Paper 2, 1; Paper 3, 1. The parties also inform us that the '014 Patent previously was, but no longer is asserted in *Certain Digital Video Receivers and Related Hardware and Software Components*, Inv. No. 337-TA-1103 (ITC), filed February 8, 2018. *Id.*

#### *C. Challenged Claims*

In each of the Petitions, as well as the petition in IPR2019-00555, Petitioner challenges claims 1–20 of the '014 Patent. *See, e.g.*, IPR2019-00556, Paper 2, 1, 15.

#### *D. Discretionary Denial*

Patent Owner asserts we should exercise our discretion under 35 U.S.C. § 314(a) to deny all four petitions, including the three Petitions addressed here. *See, e.g.*, IPR2019-00556, Paper 6, 41–48 (citing *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 9–10 (PTAB Sept. 6, 2017) (Paper 19) (“*General Plastic*”) (precedential as to § II.B.4.i)).

On May 21, 2019, we issued an order in each of the four proceedings challenging the '014 Patent requiring that Petitioner provide a notice identifying a ranking of the four 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.*, IPR2019-00556, Paper 8 (“Case Management Order”), 4–5. We gave the Patent Owner an opportunity to respond. *Id.*

On June 4, 2019, pursuant to our Case Management Order, Petitioner filed its Notice Ranking Petitions. *See, e.g.*, IPR2019-00556, Paper 9 (“Notice”). On June 17, 2019, Patent Owner filed its Response to Petitioner’s Notice Ranking Petitions. *See, e.g.*, IPR2019-00556, Paper 10 (“Response”).<sup>1</sup>

In its Notice, Petitioner requests we consider the petition in IPR2019-00555 first. Notice, 1–2. For the reasons given in our decision instituting *inter partes* review in IPR2019-00555, we conclude Petitioner establishes a reasonable likelihood of prevailing in demonstrating the unpatentability of claims 1–20 of the '014 Patent. Accordingly, all the challenged claims in these proceedings are subject to an *inter partes* review in IPR2019-00555.

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,

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<sup>1</sup> The Case Management Order instructs Petitioner and Patent Owner 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.

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

Here, Petitioner contends additional proceedings are necessary due to its concerns relating to potential arguments Patent Owner may raise regarding, among other things, potential prior art challenges. *See generally* Notice. In particular, Petitioner asserts differences in the petitions show certain claim features in materially different ways, in part, because the

differences relate to Patent Owner's incorrect claim construction positions in its Preliminary Responses. *Id.* Regarding potential prior art challenges, Petitioner asserts that Patent Owner may dispute whether a textbook and a website reference qualify as printed publications, but certain petitions present alternative grounds based on prior art that Patent Owner cannot challenge on the same basis. *Id.* at 4.

In its Response to the Notice, Patent Owner disagrees both with Petitioner's characterization of the Preliminary Responses and with Petitioner's characterization of the differences in the petitions as material. *See generally* Response. Also, Patent Owner is vague as to whether it intends to assert in any Patent Owner Response an argument that is the same as or similar to a dispute raised in a Preliminary Response. *Id.* Patent Owner also is vague as to whether it intends to dispute Petitioner's assertion that the textbook and the website reference qualify as printed publications. *Id.*

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 IPR2019-00555 in accordance with Petitioner's preference that we consider that proceeding first. We note that in IPR2019-00555 Petitioner presents at least two alternative grounds of obviousness for every challenged claim and, for the independent claims and the majority of dependent claims, Petitioner also presents a third anticipation ground. *See* IPR2019-00555, Paper 2, 13–14. Furthermore, for dependent claims 2 and 12 involving the potential prior art challenges of whether the textbook and the website reference qualify as printed publications, Petitioner asserts six separate

obviousness grounds for each of claim 2 and claim 12, including certain grounds that Petitioner acknowledges cannot be challenged on the same basis. *Id.*; Notice, 4.

As explained 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 10. We determine that the integrity of the system is sufficiently served by our institution of *inter partes* review of all challenged claims of the '014 Patent in IPR2019-00555. *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 patent system more efficient.”); Office Patent Trial Practice Guide, July 2019 Update, 22–23 <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trial-practice-guide-july-2019-update>. Although Patent Owner presents disputes in its Preliminary Responses and is vague as to whether other identified differences between the petition in IPR2019-00555 and the Petitions addressed here are in dispute, we do not find the differences identified by Petitioner sufficiently material and in dispute to support the inefficiencies and costs associated with instituting an additional three *inter partes* reviews.<sup>2</sup> *Cf. id.* at 16–17 (recognizing the “potential for abuse of the review process by repeated attacks on patents”).

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<sup>2</sup> Petitioner filed 28 petitions challenging six patents, including the '014 Patent discussed here.

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Accordingly, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of review in IPR2019-00556, IPR2019-00557, and IPR2019-00558.

### III. CONCLUSION

For the foregoing reasons, based on a balanced assessment of the circumstances of these cases, we exercise our discretion under 35 U.S.C. § 314, and deny the instant Petitions requesting institution of *inter partes* review of the '014 Patent in IPR2019-00556, IPR2019-00557, and IPR2019-00558.

### IV. ORDER

In consideration of the foregoing, it is hereby  
ORDERED that the Petitions are denied as to all challenged claims of the '014 Patent in IPR2019-00556, IPR2019-00557, and IPR2019-00558 and no trial is instituted in these cases.

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