

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ROVI GUIDES, INC.,
Patent Owner.

Case Nos. IPR2019-00225, IPR2019-00226,
IPR2019-00227, IPR2019-00228, IPR2019-00229

Patent No. 7,827,585 B2

Before WILLIAM M. FINK, *Vice Chief Administrative Patent Judge*, and
KARL D. EASTHOM and BARBARA A. PARVIS, *Administrative Patent
Judges*.

FINK, *Vice Chief Administrative Patent Judge*.

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

I. INTRODUCTION

On November 10, 2018, Comcast Cable Communications, LLC, (“Petitioner”) filed six petitions (*see, e.g.*, IPR2019-00225, Paper 2), each requesting *inter partes* review of claims 1–28 of U.S. Patent No. 7,827,585 (*see, e.g.*, IPR2019-00225, Ex. 1101, “the ’585 Patent”). This Decision addresses the petitions filed in IPR2019-000225 to -00229 (collectively, “the Petitions”). Rovi Guides, Inc. (“Patent Owner”) filed Preliminary Responses. *See, e.g.*, IPR2019-00225, Paper 7. 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 IPR2019-00225 to -00229.

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.*, IPR2019-00225, Paper 2, 1. Patent Owner names as the real parties-in-interest Rovi Guides, Inc. and Rovi Corp. *See, e.g.*, IPR2019-00225, 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 '585 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.*, IPR2019-00225, Paper 2; Paper 3, 1.

C. Challenged Claims

In each of the five Petitions, Petitioner challenges claims 1–28 of the '585 Patent. *See, e.g.*, IPR2019-00225, Paper 2, 7. After the Petitions were filed, Patent Owner filed a Statutory Disclaimer disclaiming claims 5, 12, 19, and 26. *See, e.g.*, IPR2019-00225, Ex. 2002. Therefore, claims 1–4, 6–11, 13–18, 21–25, 27, and 28 stand challenged in these proceedings.

D. Discretionary Denial

Patent Owner asserts we should exercise our discretion under 35 U.S.C. § 314(a) to deny all six petitions, including the Petitions addressed here. *See, e.g.*, IPR2019-00225, Paper 7, 46–47, 51–56 (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 3, 2019, we issued an order in each of the six proceedings challenging the '585 patent 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.*, IPR2019-00225, Paper 10 (“Case Management Order”), 4–5. We gave the Patent Owner an opportunity to respond. *Id.*

On April 17, 2019, pursuant to our Case Management Order, Petitioner filed its Notice Ranking Petitions. *See, e.g.*, IPR2019-00225, Paper 12 (“Notice”). On May 1, 2019, Patent Owner filed its Response to Petitioner’s Notice Ranking Petitions. *See, e.g.*, IPR2019-00225, Paper 13 (“Response”).¹

In its Notice, Petitioner requests we consider the petition in IPR2019-00224 first. Notice, 1. For the reasons given in our decision instituting *inter partes* review in IPR2019-00224, we conclude Petitioner establishes a reasonable likelihood of prevailing in demonstrating the unpatentability of claims 1–4, 6–11, 13–18, 20–25, 27, and 28 of the ’585 Patent. Accordingly, all of the challenged claims in these proceedings are subject to an *inter partes* review in IPR2019-00224.

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

¹ 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.

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, priority date, 35 U.S.C. § 325(d), or specific claim limitations. *See generally* Notice. In its Response to the Notice, Patent Owner concedes it will not attempt to swear behind the prior art in IPR2019-00224 (*see* Response 2), but is vague as to whether it intends to dispute some of the other issues (*id.* at 2–5).

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 IPR2019-00224 in accordance with Petitioner's preference that that proceeding be considered first. We note that the IPR2019-00224 petition includes seven obviousness challenges for each independent claim. IPR2019-00224, Paper 2, 9. As set forth in the decision on institution in IPR2019-00224, *inter partes* review of claims 1–4, 6–11, 13–18, 20–25, 27, and 28 of the '585 Patent is instituted with respect to all grounds set forth in that petition.

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 '585 patent in IPR2019-00224. *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.”). Although Patent Owner is vague as to whether some identified differences between the petition in IPR2019-00224 and the Petitions addressed here are in dispute, we do not find these differences sufficiently material and in dispute to support the inefficiencies and costs associated with instituting an additional

five *inter partes* reviews.² *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 IPR2019-00225 to -00229.

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 '585 Patent in IPR2019-00225 to -00229.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Petitions are *denied* as to all challenged claims of the '585 Patent in IPR2019-00225, IPR2019-00226, IPR2019-00227, IPR2019-00228, and IPR2019-00229 and no trial is instituted in these cases.

² Petitioner filed 28 petitions challenging six patents, including the '585 Patent discussed here.

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PETITIONER:

Frederic Meeker
fmeeker@bannerwitcoff.com

Bradley Wright
bwright@bannerwitcoff.com

Charles Miller
cmiller@bannerwitcoff.com

Brian Emfinger
bemfinger@bannerwitcoff.com

Blair Silver
bsilver@bannerwitcoff.com

PATENT OWNER:

Jason Eisenberg
jasone-ptab@sternekessler.com

Jon Wright
jwright-ptab@sternekessler.com

Lauren Schleh
lschleh-ptab@sternekessler.com

Dohm Chankong
dchankong-ptab@sternekessler.com