

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.
IPR2019-00279, IPR2019-00280, IPR2019-00281,
IPR2019-00282, IPR2019-00283
Patent No. 9,621,956 B2

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

EASTHOM, *Administrative Patent Judge*.

Conduct of the Proceeding
37 C.F.R. § 42.5

On November 12, 2018, Petitioner filed five Petitions, each requesting *inter partes* review of claims 1–20 of U.S. Patent No. 9,621,956 B2. In its Preliminary Responses, Patent Owner contends that the five Petitions are “redundant” and “overlapping” and differ only in immaterial respects. *See, e.g.*, IPR2019-00279, Paper 6, 2, 37, 32–46. According to Patent Owner, “Petitioner . . . failed to distinguish between the five concurrently filed and redundant [P]etitions,” and “the Board should deny all [P]etitions.” *Id.* at 40–41.

The Director has discretion to deny a petition under 35 U.S.C. § 314(a). *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). The Board takes into account various considerations when exercising discretion on behalf of the Director. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (Section II.B.4.i. designated as precedential) (stating factors considered in Board’s exercise of discretion under 35 U.S.C. § 314(a)). Although the facts of *General Plastic* concern serial or “follow-on” Petitions, the Office Trial Practice Guide Update notes

[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,” favors denying a petition even though some claims meet the threshold standards for institution.

Office Trial Practice Guide Update¹ referenced at 83 Fed. Reg. 39,989 (“Trial Practice Guide Update”) (Aug. 13, 2018), at 10 (quoting 35 U.S.C. § 316(b)).

Maintaining multiple, concurrent proceedings per patent presents a significant burden for the Board, because, among other things, the Board endeavors to assign all such cases to the same panel. *See* SOP 1 (Rev. 15), III.G.3. Additionally, when there are other related patents also each challenged by multiple petitions at the same time, as is the case here, this can undermine the Office’s ability to complete proceedings in a timely manner and may place an unfair burden on the Patent Owner. *See* Trial Practice Guide Update at 10; *cf. General Plastic*, slip op. at 16 (requiring the Board to consider ability to meet statutory deadlines as an institution factor); 37 C.F.R. § 42.1(b) (“[The rules] shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”).

Nonetheless, at this stage of the proceedings, we decline Patent Owner’s invitation to deny all five Petitions on the basis that they are redundant. In fact, Petitioner points out alleged differences among the five Petitions, including different teachings pertaining to some claim limitations. *See, e.g.*, IPR2019-00279, Paper 2, 8–10. We agree with Patent Owner, however, that the number of Petitions here challenging each patent may place a substantial and unnecessary burden on the Board and Patent Owner. Accordingly, the panel issues this Order under 37 C.F.R. § 42.5 to give the parties an opportunity to focus the Board’s limited resources on genuine issues in dispute.

¹ Available at <https://go.usa.gov/xU7GP>.

Within 14 days of this Order, Petitioner shall provide a Notice not to exceed 5 pages identifying (1) a ranking of the five 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 (2) a succinct explanation of the differences between the Petitions, why the differences are material, and why the Board should exercise its discretion to consider the additional Petitions if it identifies a Petition that satisfies Petitioner's burden under 35 U.S.C. § 314(a). The Board encourages Petitioner to use a table to aid in identifying the similarities and differences between the Petitions.

If it so chooses, Patent Owner may, within 14 days of the receipt of Petitioner's Notice, provide a Response not to exceed 5 pages, stating its position with respect to any of the differences identified by Petitioner. In particular, Patent Owner should explain whether the differences identified by Petitioner are material and in dispute. If stating that reasons are not material or in dispute, Patent Owner should clearly proffer any necessary stipulations.²

Petitioner and Patent Owner are instructed to file the same paper in all proceedings and use this Order's case caption format. The panel will consider the parties' submissions in determining whether to exercise its discretion to institute *inter partes* review under 35 U.S.C. § 314(a).

It is

ORDERED that within 14 days of this Order, Petitioner shall file a Notice consistent with the foregoing instructions; and

² For example, Patent Owner may seek to avoid additional Petitions by proffering a stipulation that certain claim limitations are not disputed or that certain references qualify as prior art.

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FURTHER ORDERED that, within 14 days of Petitioner's Notice, if it chooses to, Patent Owner may file a Response consistent with the foregoing instructions.

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