

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 IPR2019-00232  
Patent 9,369,741 B2

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Before: KARL D. EASTHOM, BARBARA A. PARVIS, and  
SCOTT E. BAIN, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Comcast Cable Communications, LLC, (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–26 of U.S. Patent No. 9,369,741 B2 (Ex. 1101, “the ’741 Patent”). Paper 1 (“Pet.”). Rovi Guides, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). 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).<sup>1</sup> For the reasons given below, upon consideration of the Petition, the Preliminary Response, 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 Corp.; and Comcast STB Software I, LLC. Pet. 7. Patent Owner names as the real parties-in-interest Rovi Guides, Inc. and Rovi Corp. Paper 5, 1.

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<sup>1</sup> We have authority under 35 U.S.C. § 314 to determine whether to institute an *inter partes* review. See 37 C.F.R. § 42.4(a).

*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 this proceeding. In particular, the parties inform us that the '741 Patent is asserted in *Rovi Guides, Inc. v. Comcast Corp.*, Case No. 2-18-cv-00253 (C. D. Cal.), filed January 10, 2018 and *Digital Video Receivers and Related Hardware and Software Components*, Inv. No. 337-TA-1103 (ITC), filed February 8, 2018 (“related ITC proceeding”). Pet. 7–8; Paper 5, 1. Petitioner additionally filed IPR2019-00231 also challenging claims 1–26 of the '741 Patent. See IPR2019-00231, Paper 1 (“the '231 petition or '231 Pet.”)

*C. The '741 Patent*

The '741 Patent is directed to interactive television systems such as interactive television program guide systems. Ex. 1101, 1:25–26. Figure 1 of the '741 Patent is reproduced below.

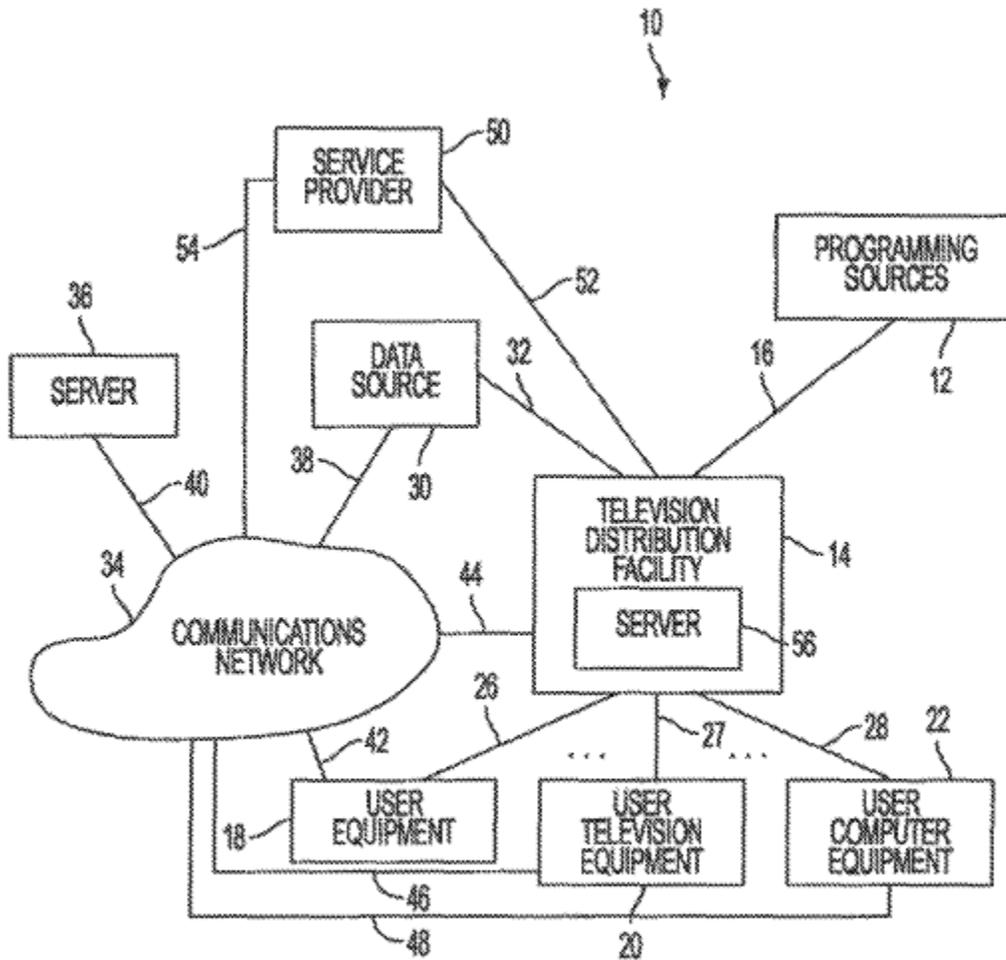


FIG. 1

Figure 1 of the '741 Patent, above, illustrates interactive television system 10 including television distribution facility 14. *Id.* at 4:50–55. Television distribution facility 14 is connected to user equipment devices 18 located in the homes of users, including user television equipment 20 and user computer equipment 22. *Id.* at 5:1–4. User equipment devices 18 receive television and music programming and other information from television distribution facility 14 over communication paths 26, 27, and 28. *Id.* at 5:6–8. Data source 30 provides program schedule information and other data to

television distribution facility 14 over communication path 32 and to user equipment 18 via communications network 34 and paths 18 and 42. *Id.* at 5:30–40.

*D. Illustrative Claim*

Petitioner challenges claims 1–26 of the '741 Patent. Pet. 7. Claims 1, 8, 15, and 21 are independent claims. Claims 2–7, 9–14, 16–20 and 22–26 depend, directly or indirectly, from claim 1, 8, 15, and 21, respectively. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A system comprising:
  - storage circuitry for storing archived copies of videos;
  - control circuitry configured to:
    - transmit a video to a plurality of user equipment, wherein the transmitting begins at a start time and ends at an end time;
    - access a database to determine whether an archived copy corresponding to the video is available to a user after the start time;
    - based on determining that the archived copy is available to the user after the start time, cause an indication corresponding to the archived copy to be displayed simultaneously with the video after a specified time after the start time but before the end time, wherein the specified time was configured prior to the start time;
    - receive a user response to the indication that is displayed;
    - and
    - based on the received user response, retrieve, from the storage circuitry, the archived copy.

Ex. 1101, 37:62–38:13.

*E. Evidence Relied Upon*

Petitioner relies on the following references:

U.S. Patent No. 8,181,215 B2, filed February 12, 2002, issued May 15, 2012 (Ex. 1104, “Brenner”);

International Application Publication No. WO 01/56285 A1, filed January 19, 2001, published August 2, 2001 (Ex. 1105, “Berberet”);

U.S. Patent No. 7,073,189 B2, filed November 22, 2002, issued July 4, 2006 (Ex. 1106, “McElhatten”);

U.S. Patent No. 6,804,825 B1, filed November 30, 1998, issued October 12, 2004 (Ex. 1107, “White”); and

U.S. Patent No. 6,769,127 B1, filed June 16, 2000; issued July 27, 2004 (Ex. 1108, “Bonomi”).

Additionally, Petitioner relies on the Declaration of Dr. Gary Tjaden. (Ex. 1102).

*F. Grounds Asserted*

Petitioner asserts the following grounds of unpatentability, under 35 U.S.C. § 103(a) (Pet. 16):

Reference(s)	Claims Challenged
Brenner and Berberet	1, 3, 5–8, 10, 12–15, 17, 19–21, 23, 25, and 26
Brenner, Berberet, and White	2, 9, 16, 22
Brenner, Berberet, and Bonomi	4, 11, 18, 24
Brenner and McElhatten	1, 3, 5–8, 10, 12–15, 17, 19–21, 23, 25, and 26
Brenner, McElhatten, and White	2, 9, 16, 22

Reference(s)	Claims Challenged
Brenner, McElhatten, and Bonomi	4, 11, 18, 24

*G. Discretionary Denial Arguments*

*1. Overview*

Patent Owner asserts we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a) because the factors enumerated in *General Plastic Industrial 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) should be applied to the related ITC proceeding and those factors support exercising discretion to deny the Petition. Prelim. Resp. 1, 4–12. Patent Owner, additionally, asserts we should exercise our discretion to deny the instant Petition under 35 U.S.C. § 325(d) as duplicative of the petition in IPR2019-00231. *Id.* at 2, 16–19.

On May 1, 2019, we issued an order requiring that Petitioner provide (1) a ranking of the two 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 petition if it identifies a petition that satisfies Petitioner’s burden under 35 U.S.C. § 314(a). Paper 11 (“Case Management Order”). We also gave Patent Owner an opportunity to respond with its position with respect to any of the differences identified by Petitioner. *Id.*

Pursuant to our Case Management Order, Petitioner requests we consider the IPR2019-00231 petition first and the instant Petition second. Paper 12 (“Notice”). Petitioner also asserts that the Board should institute two proceedings. *Id.* Patent Owner opposes. Paper 13 (“Response”).

We have considered Petitioner’s Notice and Patent Owner’s Response. For the reasons set forth below, in light of the specific facts of this case, we exercise our discretion to deny institution of the present Petition under § 314(a) in light of IPR2019-00231, which we are instituting. We, therefore, need not make a determination regarding Patent Owner’s discretionary denial arguments in its Preliminary Response.

## 2. 35 U.S.C. § 314(a)

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”), available at <https://go.usa.gov/xU7GP>. In particular, the Trial Practice Guide 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). This includes, for example, events in other proceedings related to the same patent, either at the Office, in district courts, or the ITC.

Trial Practice Guide Update 10–11. We are also 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 IPR2018-01310, slip op. at 42 (PTAB Jan. 24, 2019) (Paper 7) (informative).

### 3. Analysis

In considering a balanced assessment of all relevant circumstances in the instant proceeding and assessing the equities of instituting multiple proceedings, we are not persuaded by Petitioner that institution of multiple, concurrent proceedings would promote the efficient administration of the Office or the integrity of the system. Trial Practice Guide Update 10. Instead, we note that as compared to the ’231 petition, the present Petition was filed by the *same* petitioner and includes challenges to the *same* claims, i.e., claims 1–26, of the *same* patent, i.e., ’741 Patent. *Compare* Pet. 7 with ’231 Pet. 7. Additionally, on the record before us, we do not find the differences between the asserted art and arguments to be sufficiently material to outweigh the inefficiencies and costs of instituting an additional proceeding.

In particular, Petitioner’s assertions in the instant proceeding are the same as IPR2019-00231, with the exception that in the instant proceeding, Petitioner relies on Brenner, whereas in IPR2019-00231, Petitioner relies on U.S. Patent Publication No. 2002/0095510 A1, filed June 8, 2001, published July 18, 2002 (Ex. 1003, “Sie”). *Compare* Pet. 16, *with* ’231 Pet. 16. Below is a table summarizing the prior art asserted by Petitioner, under 35 U.S.C. § 103(a), in IPR2019-00231 and IPR2019-00232.

Claims Challenged	IPR2019-00231	IPR2019-00232
1, 5–8, 12–15, 19–21, 23, 25, and 26	(1) Sie alone; (2) Sie and Berberet; and (3) Sie and McElhatten	(1) Brenner and Berberet; and (2) Brenner and McElhatten
3, 10, and 17	(1) Sie and Berberet; and (2) Sie and McElhatten	(1) Brenner and Berberet; and (2) Brenner and McElhatten
2, 9, 16, 22	(1) Sie and White; (2) Sie, Berberet, and White; and (3) Sie, McElhatten, and White	(1) Brenner, Berberet, and White; and (2) Brenner, McElhatten, and White
4, 11, 18, 24	(1) Sie and Bonomi; (2) Sie, Berberet, and Bonomi; and (3) Sie, McElhatten, and Bonomi	(1) Brenner, Berberet, and Bonomi; and (2) Brenner, McElhatten, and Bonomi

’231 Pet. 16; Pet. 16. Petitioner additionally relies on the testimony of Dr. Tjaden in both proceedings. IPR2019-00231, Ex. 1002; Ex. 1102.

In support of its assertion that the instant Petition is not duplicative of the ’231 petition, Petitioner contends

Brenner (Ex. 1004) describes a system wherein a user is prompted to download a copy of a broadcast program based on the user being tuned into the broadcast program for a sufficient period of time. Brenner, which may not expressly mention the

use of a database, presents a different system that also independently renders the claims of the '741 Patent obvious. '231 Pet. 16–17.

Petitioner, however, contends Sie teaches these same features. For instance, Petitioner relies on the combination of Brenner's prompt and display notifications, which are similar to the notifications taught in Sie. Pet. 39–41 (Ex. 1104, 7:54–63, 8:3–21 Ex. 1102, ¶130). Brenner's notifications are described as “translucent text or graphical icon.” *See, e.g.*, Ex. 1104, 8:5. Sie describes display notifications as follows: “a special icon or alphanumeric string” and an “overlaid identifier.” Ex. 1003 ¶ 85. Regarding determining whether the user is tuned into the broadcast program for a sufficient period of time, Petitioner contends that Sie similarly teaches the “club notification symbol is shown when ‘the user has settled on that channel,’ such as ‘for a certain period of time (e.g., five seconds).” Pet. 40 (citing Ex. 1003 ¶¶ 83–85; Ex. 1002, ¶¶127–128).

We turn to Petitioner's assertion that “Brenner, which may not expressly mention the use of a database, presents a different system that also independently renders the claims of the '741 Patent obvious.” '231 Pet. 17. For teaching expressly a “database,” however, Petitioner relies on the same secondary references asserted in IPR2019-00231, i.e., Berberet and McElhatten. Pet. 38, 64.

In its Notice, Petitioner “asks that the Sie Petition (IPR2019-00231, ‘IPR-231’) be considered before the Brenner petition (IPR2019-00232, ‘IPR-232’).” Notice 1. Petitioner contends that material differences justify institution of both petitions. *Id.* For certain of these alleged material differences, however, Petitioner relies on secondary references in the instant proceeding, which as noted above also are asserted in IPR2019-00231. For

example, in its Notice, Petitioner again asserts “Sie expressly describes accessing a database,” whereas “Brenner determines availability of stored programs, but does not expressly describe accessing a database.” *Id.* at 1. Petitioner also asserts “Sie teaches the ‘retention period’” recited in claims 7, 14, 20, and 26, whereas the instant Petition “relies on the secondary references.” *Id.* at 2.

Petitioner also contends shifting claim constructions supports instituting on multiple petitions. *Id.* at 2–3. More specifically, Petitioner contends “Sie contains more detail with respect to structure and implementation,” of recited means-plus-function terms in claims 15–17 and 19–20, but “Brenner is more conceptual” and teaches nearly every step through a single algorithm depicted in Figure 2. *Id.* at 2. Petitioner also contends Sie and Brenner provide different teachings with respect to the “archived copy” limitation. *Id.* at 3. The instant Petition, however, presents theories based on alternative proposed claim constructions that are the same as those presented in the ’231 petition and Petitioner relies the same secondary references for asserting unpatentability based on those theories. *Compare* Pet. 17–24 *with* ’231 pet. 17–25.

We have considered the parties’ arguments and evidence in the instant proceeding. We also have considered Petitioner’s contentions and Patent Owner’s Preliminary Response in IPR2019-00231 in accordance with Petitioner’s preference that that proceeding be considered first. As set forth in the decision on institution in IPR2019-00231, an *inter partes* review of claims 1–26 of the ’741 Patent is instituted with respect to all grounds set forth in that Petition. As explained above, in exercising our discretion, we consider the efficient administration of the Office as well as costs in

maintaining a second proceeding on the same claims. *See* Trial Practice Guide 10; Case Management Order. We find that Petitioner does not identify sufficient differences between Sie and Brenner to support the inefficiencies and costs associated with instituting on an additional petition here.

Accordingly, we exercise our discretion under 35 U.S.C. § 314 to deny institution of review.

### III. CONCLUSION

For the foregoing reasons, based on the circumstances of this case, we exercise our discretion under 35 U.S.C. § 314, and deny the instant Petition requesting institution of *inter partes* review of claims 1–26 of the '741 Patent.

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims of the '741 Patent and no trial is instituted.

IPR2019-00232  
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