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.

PROMPTU SYSTEMS CORP.,
Patent Owner

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Case No. IPR2018-00344
U.S. Pat. No. 7,047,196

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PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE

Contents

I. PRELIMINARY STATEMENT

Promptu's Patent Owner Response detailed the history of the relationship between Promptu and Comcast from the early 2000s. Paper 20 at 28-41. This history included the fact that Comcast previously praised the AgileTV system described in the '196 Patent, deployed the AgileTV system in Comcast's cable network, and committed to investing in Promptu and in deploying the AgileTV system to all of Comcast's subscribers. None of this would have occurred if Comcast believed then that the invention described and claimed in the '196 Patent was merely an obvious advance over the prior art.

Nowhere in Promptu's Patent Owner Response did Promptu rely on testimony from Mr. Cook. Rather, after Comcast served objections to the admissibility of practically every exhibit[1] cited by Promptu in recounting this history, Promptu then provided a declaration of Mr. Cook to authenticate the exhibits as Promptu's business records. Ex. 2042. Mr. Cook was the founder and

[1] For example, Comcast objected to the License and Development Agreement (Ex. 2022) between Promptu and Comcast as inauthentic. Paper 22 at 6. But Comcast does not dispute this document was signed by Comcast's President and Vice President (Ex. 2022 at 38-39) and Comcast itself insisted that this document remain under seal because the document is "Confidential." *See, e.g.*, Paper 23.

former CEO of Promptu, and a co-inventor on the '196 Patent. Mr. Cook's four-page declaration authenticated these objected-to business records to overcome Comcast's baseless authenticity and hearsay objections. *See, e.g.*, *id.*

Mr. Cook's deposition was noticed for October 30 in connection with the co-pending district court litigation. In an email on October 23, Comcast's counsel requested "[w]e can start any IPR-related examination immediately after completing the parties' respective examinations for district-court purposes." Promptu's counsel agreed, responding that the deposition would "continu[e] with the IPR-related examination of Mr. Cook following the conclusion of District Court-related deposition." At the end of a three-day deposition for the district court deposition (during which Mr. Cook was defended by different counsel), the parties closed the district court deposition and transitioned to the IPR-related deposition (during which Mr. Cook was defended by Promptu's PTAB counsel). During the IPR-related deposition, Comcast's counsel did not ask Mr. Cook a single question about his declaration or the exhibits cited therein. Ex. 2045.

II. PORTIONS OF EXHIBIT 1024 SHOULD BE EXCLUDED

For the reasons stated in Promptu's Motion to Exclude (Paper 40), the Board should exclude the following portions of Exhibit 1024 relied on by Comcast in its Petitioner Reply: 22:2-13, 106:20-107:9, 117:12-118:7, 135:4-5, 156:5-12, 160:20-161:2, 206:2-17, 215:13-219:18, 249:6-17, 250:15-253:14, 255:22-258:21, and

316:4-6. As one example, Comcast seeks to rely on Mr. Cook's district court deposition testimony to back-fill Comcast's deficient petition. Specifically, the Board previously determined that Comcast's petition nowhere supported the bald assertion that the Diva system mentioned in Julia disclosed pay-per-view functionality as of that date. Paper 10 at 43-44. After being told by the Board during the initial call that Comcast could not provide supplemental evidence on this point, Comcast now seeks to take an ambiguous answer from Mr. Cook's district court deposition as a purported admission that the Diva Systems video-on-demand system provided pay-per-view at the time (Paper 29 at 15 (citing Ex. 1024 at 22:2-13, 249:6-17)). Mr. Cook's statement, which does not mention a specific product, product version, or a specific date, neither proves what Comcast says it does nor remedies the deficiency in Comcast's petition. More importantly for this motion, however, Comcast relies on this and other of Mr. Cook's statements for the truth of the matter asserted despite the fact that he did not offer that testimony in this proceeding. Mr. Cook's testimony is hearsay not subject to any exceptions.

III. COMCAST'S ARGUMENTS IN OPPOSITION FAIL

Comcast argues the statements should be treated as those of party opponent under Fed. R. Evid. 801(d)(2). But the only parties are Promptu and Comcast. Mr. Cook is not a party in either proceeding, and his deposition in the district court proceeding was taken in his individual capacity. Even if Mr. Cook draws a modest

monthly payment for his prior role as founder and former officer of the company, Comcast has not argued that Mr. Cook's testimony falls within any of the other requirements in Federal Rule of Evidence 801(d)(2)(B)-(E). Specifically, regarding the Diva testimony, Mr. Cook was testifying about his recollection when he was employed elsewhere. He certainly was not testifying on behalf of Promptu.

Comcast next argues the statements fall under the "former testimony" exception. But this hearsay exception expressly requires that the declarant be "unavailable as a witness." Fed. R. Evid. 804(b). Comcast does not establish that Mr. Cook was unavailable under Rule 804(a) and argues only that Mr. Cook is 94 years old and alludes to the Board's "general rule against live testimony." Mr. Cook was available, and Comcast knows that—Comcast actually deposed him in this proceeding. Ex. 2045. Comcast did not ask Mr. Cook those questions during his deposition in this proceeding (they would have been outside the scope), and Mr. Cook's statements from a prior deposition are inadmissible hearsay.

Indeed, by using Mr. Cook's district court deposition testimony here without asking those same questions in the PTAB deposition, Comcast unfairly deprived Promptu's PTAB counsel of the ability to object to Comcast's numerous questions exceeding the scope of the PTAB deposition. During the short PTAB deposition, Promptu repeatedly objected on this basis. *See* Ex. 2045 at 449:7-454:14.

Comcast also seeks to rely on the residual exception by making the

incredible argument that Mr. Cook's present-day recollection of events from over twenty-years ago is *more reliable* than documents authored at the same time as the events they describe. Promptu relied on Mr. Cook's testimony in this proceeding simply to authenticate certain business records of Promptu. As the author or recipient of these documents and the former CEO of Promptu, Mr. Cook remains one of the few witnesses who may authenticate these documents. Contrary to Comcast's allegation (Paper 46 at 7-8), Promptu is not relying on Mr. Cook's testimony as substantive evidence supporting its secondary considerations arguments—the documents themselves provide that.

Comcast also misstates the parties' agreement, which provided for separate depositions for the district court and IPR matters. The parties made a clear demarcation on the record between the two. But Promptu never agreed the district court transcript could be used wholesale in the IPR matters, and merely agreed to eventually negotiate with Comcast's counsel regarding whether and to what extent excerpts from the district court deposition could be used in the IPR matters. *See, e.g.*, Ex. 1030 at 445:13-446:22. Comcast never negotiated for such use.

IV. CONCLUSION

The Board should exclude the aforementioned portions of Ex. 1024.

Respectfully submitted,

Dated: January 14, 2019

By: /*Daniel F. Klodowski*/
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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing **PATENT OWNER'S REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE** was served by email on January 14, 2019, on Petitioner's counsel of record at:

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Dated: January 14, 2019

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