

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

PROMPTU SYSTEMS CORPORATION,
Patent Owner.

IPR2018-00344
Patent 7,047,196 B2

Before JAMESON LEE, ROBERT L. KINDER, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

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

This *inter partes* review proceeding has returned to the Board after the U.S. Court of Appeals for the Federal Circuit vacated and remanded the Final Written Decision. We authorize Comcast Cable Communications, LLC (“Petitioner”) and Promptu Systems Corporation (“Patent Owner”) to file additional briefing limited to specific issues, as detailed below.

DISCUSSION

Petitioner requested *inter partes* review of claims 1, 2, 4–6, 12, 13, 27, 28, 30–32, and 38–42 of U.S. Patent 7,047,196 B2 (Ex. 1001, “the ’196 patent”). Paper 1 (“Pet.”). We instituted trial on all challenged claims and all grounds. Paper 10. After full briefing and an oral hearing, we entered a Final Written Decision concluding that Petitioner had not shown, by a preponderance of the evidence, that any of claims 1, 2, 4–6, 12, 13, 27, 28, 30–32, and 38–42 were unpatentable under any of the asserted grounds. Paper 59 (“344 FWD”). Petitioner appealed. Paper 60.

Concurrently, in a related *inter partes* review proceeding, Petitioner filed a petition challenging claims 14, 15, 17–19, 25, 26, 53–55, 61, 62, and 64–66 of the ’196 patent. *Comcast Cable Comm’ns, LLC v. Promptu Sys. Corp.*, IPR2018-00345, Paper 1. We instituted trial in that proceeding as well, and the final written decision ultimately concluded that Petitioner had not shown, by a preponderance of the evidence, that any of the claims were unpatentable under any asserted grounds. IPR2018-00345, Paper 59 (“345 FWD”). Again, Petitioner appealed. Paper 60, IPR2018-00345.

On January 4, 2021, the U.S. Court of Appeals for the Federal Circuit affirmed the 345 FWD and vacated and remanded the 344 FWD. *Comcast Cable Comm’ns, LLC v. Promptu Sys. Corp.*, 838 F. App’x. 551, 554 (Fed. Cir. 2021) (the “Decision”). With respect to the 344 FWD at issue in this proceeding, the Federal Circuit determined that the Board erred in its construction of the term “received back channel” because “the broadest reasonable interpretation of ‘received back channel’ is a ‘back channel that has been received.’” *Id.*; *see id.* (explaining that the claim does not require an additional element of “creat[ing]” a received back channel). “Because

the IPR2018-00344 final-written decision is predicated on the Board's erroneous construction, [the Federal Circuit] vacate[d] and remand[ed] for the Board to consider the parties' arguments under the correct construction." *Id.* The mandate issued on February 25, 2021. Ex. 3003.

On March 24, 2021, a telephone conference call was held between respective counsel for the parties and Judges Lee, Kinder, and Dirba to discuss the procedure for this proceeding on remand. A court reporter was present, and Patent Owner entered the reporter's transcript into the record (Ex. 2046).

On the call, both parties took the position that the Federal Circuit's Decision raises additional issues: Petitioner contended that the Decision impacts the Board's analysis of other claim limitations, and Patent Owner contended that issue preclusion results from the Decision. Also, Petitioner argued that other cases, decided by the Board and Federal Circuit after the 344 FWD, are relevant to the parties' arguments in this proceeding. Petitioner requested additional briefing to address these issues, and Patent Owner stated that it does not oppose.

We are persuaded that additional briefing on these additional issues may be useful to the Board in rendering a remand decision. Accordingly, as stated on the call, we authorize the parties to simultaneously file an additional opening and response brief that are limited to these specific issues. This Order summarizes our ruling.¹

¹ If either party perceives any ambiguity in this Order (or conflict between this Order and the oral instructions provided by the Board), the party must notify the Board within three business days of this Order. Further, the parties are cautioned that the Board may decide not to consider a brief (in whole or in part) that addresses an unauthorized topic.

In the opening brief, a party may address the impacts of the Federal Circuit's Decision on this proceeding. Indeed, if a party contends that the Federal Circuit's Decision results in issue preclusion or affects claim limitations other than the "received back channel" limitation, then that party shall identify and substantiate its position in its opening brief. Failure to do so may result in forfeiture of that position.

Moreover, in the opening brief, the parties are authorized to identify and briefly explain any other subsequent authority regarding any issue in this proceeding. A decision qualifies as subsequent authority if: (1) it issued on or after the mailing date of the 344 FWD (June 28, 2019), and (2)(a) it is binding on the Board or (b) it was issued in a proceeding (before a court or the Board) involving the '196 patent or a related patent.

The opening brief shall not exceed ten pages and shall be filed on or before Wednesday, April 14, 2021.

The parties' response briefs are limited to responding to the opposing party's opening brief. The response brief shall not ten pages and shall be filed on or before Wednesday, May 5, 2021.

Finally, we clarify a procedural point. In the 344 FWD, we dismissed as moot Petitioner's Motion to Exclude (Paper 37) and Patent Owner's Motion to Exclude (Paper 40) because we did not reach the issue of secondary considerations. 344 FWD, 31–32, 34. Because this ruling was premised on our erroneous claim construction, we understand the Federal Circuit's Decision to have also vacated these rulings. Accordingly, we will consider and decide those motions in our remand decision. The parties do not need to renew either of these motions.

Accordingly it is:

ORDERED that each party is authorized to file a ten-page opening brief, limited to addressing the impacts of the Federal Circuit's Decision and subsequent authority, as specified above, on or before Wednesday, April 14, 2021; and

FURTHER ORDERED that each party is authorized to file a ten-page response brief, limited to responding to the other party's opening brief, on or before Wednesday, May 5, 2021.

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