

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

PROMPTU SYSTEMS CORPORATION,
Patent Owner.

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

PATENT OWNER'S OPENING REMAND BRIEF

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I. Introduction

The decisions this Board made in IPR2018-00345 for claims 14 and 53, now fully affirmed by the Federal Circuit, resolve Petitioner's challenges to claim 27 (and its dependents). The Board should reject Petitioner's challenges to claim 27 (and its dependents) for the same reasons it rejected identical challenges to claims 14 and 53.

First, claims 14, 27, and 53 identically recite a "speech recognition system coupled to a wireline node." The petitions here and in the -345 IPR ignored that this claim element requires two distinct components, one coupled to the other, and instead pointed to the same component in the alleged prior art as both the "speech recognition system" and the "wireline node." Paper 20 at 20-21; -345 Paper 20 at 10-11, 13-14. This was the basis for the Board's rejection of Comcast's challenges in the -345 IPR (-345 Paper 59 at 21-27, 30) and the Federal Circuit's affirmance (*Comcast Cable Commc'ns v. Promptu Sys.*, 838 F. App'x 551, 553-54 (Fed. Cir. 2021)). The Board elected not to reach this issue in the -344 Final Written Decision because it grounded its decision on a different issue that applied to both claim 1 and claim 27. Paper 59 at 21-22. Patent Owner respectfully requests the Board determine, just as it did in the -345 IPR, that Petitioner has failed to establish claim 27 (and its challenged dependents) unpatentable.

Second, now that the Federal Circuit's affirmance of the -345 IPR is final, issue preclusion prevents Petitioner from relitigating the same issue here.

II. Relevant Factual Background

On December 19, 2017, Petitioner filed two petitions for *inter partes* review against the '196 patent: IPR2018-00344 and IPR2018-00345. Here, the -344 petition challenged independent claims 1 and 27; whereas the -345 petition challenged independent claims 14 and 53. Both also challenged dependent claims, and the relevant parts of both petitions were practically verbatim.

A. The petitions mapped “speech recognition system” and “wireline node” to the same component in each reference.

Claim 27 recites “a speech recognition system coupled to a wireline node.” Ex. 1001, cl. 27. The petition asserted that either Julia or Murdock taught this element. For each, Petitioner mapped the “speech recognition system” and “wireline node” to the same component in the reference. For Julia, Petitioner asserted “remote server 108” is both. Paper 1 at 53; *see also* Exhibit 1019 ¶ 373 (stating “remote server 108” “is” both the “speech recognition system” and the “wireline node”). For Murdock, Petitioner asserted “remote server computer 130” is both. Paper 1 at 26; *see also* Exhibit 1019 ¶ 216 (stating “remote server computer 130” “is” both the “speech recognition system” and the “wireline node”). The petition in the -345 IPR was materially identical, except that this issue affected every challenged claim. *See generally* -345 Paper 59 at 20-27, 30.

B. The same issue existed in the -344 and -345 proceedings.

Patent Owner, in its Response, argued that by pointing to the same component in the reference as *both* the “speech recognition system” and “wireline node,” Petitioner could not establish that the reference disclosed “a speech recognition engine *coupled to* a wireline node.” Paper 20 at 20-21. And while Petitioner proposed a new mapping in its Reply (Paper 29 at 12), Patent Owner explained its impropriety and how it failed nonetheless (Paper 38 at 3-4).

This exact issue was presented, in identical fashion, in the -345 IPR with respect to claims 14 and 53. *See, e.g.*, -345 Paper 20 at 10-11; -345 Paper 38 at 1-3. And, at the consolidated hearing on the -344 and -345 IPRs, claims 14, 27, and 53 were argued together. Paper 56 at 22-24, 61-64; *see also* Paper 54 at 43-47.

C. The Board already resolved this issue in the -345 proceeding.

The Board resolved this issue in Patent Owner's favor in the -345 IPR. The Board first agreed with Patent Owner that “a speech recognition system” and “wireline node” should be interpreted to be different components. -345 Paper 59 at 26. Then, because the Petition “points to the same element” in both Julia and Murdock for both components, the Board held Petitioner could not establish claims 14 or 53 unpatentable in view of either reference. *Id.* at 26-27, 30. The Board also rejected Petitioner's attempt to change its mapping in its Reply. *Id.* at 23-24. Because this issue was dispositive of all grounds, the Board determined Petitioner

failed to show, by a preponderance of the evidence, that any of claim 14 or 53 (or their challenged dependents) is unpatentable. *See, e.g., id.* at 34.

Petitioner appealed from the Board's decision in the -345 IPR, challenging: (1) the Board's construction of "a speech recognition system coupled to a wireline node," and (2) the Board's decision to disregard Petitioner's new mapping presented in its reply. *Comcast*, 838 F. App'x at 553. The Federal Circuit affirmed (1) the Board's construction, requiring the "speech recognition system" and "wireline node" to be "distinct components," and (2) the Board's decision to ignore Petitioner's "new mapping raised for the first time in reply." *Id.* at 553-54 ("It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim." (quoting *Intelligent Bio-Sys. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016))). The mandate issued on February 25, 2021.

D. Here, the Board exercised its discretion not to address this issue.

In this IPR, although the argument for claim 27 was identical to that presented for claims 14 and 53 in the -345 IPR, that argument did not apply to claim 1—the other challenged independent claim in this proceeding. Thus, the Board elected instead to decide this IPR on an issue that cut across *both* independent claims 1 and 27—the construction of "received back channel." Paper

59 at 21-22, 29-30. The Board therefore did not need to address the “coupled to” argument regarding claim 27 (and its challenged dependents).

On appeal, the Federal Circuit modified the Board’s construction of “received back channel.” *Comcast*, 838 F. App’x at 554. And, “[b]ecause the IPR2018-00344 final-written decision is predicated on the Board’s erroneous construction,” the Federal Circuit vacated the Board’s decision and remanded for further proceedings. *Id.*

III. The Board Should Confirm the Patentability of Claim 27 for the Same Reasons It Did for Claims 14 and 53 in the -345 IPR

In the -345 IPR, this Board held Petitioner failed to establish either Julia or Murdock disclosed a “speech recognition system coupled to a wireline node” because the petition mapped “speech recognition system” and the “wireline node” to the same component in each reference—ignoring that the claims require two different components, one “coupled to” the other. -345 Paper 59 at 26, 30.

Here, as in the -345 IPR for claims 14 and 53, the petition falls short with respect to claim 27, which also recites a “speech recognition system coupled to a wireline node.” The petition asserted that either Julia or Murdock, and only Julia or Murdock, taught this element of claim 27. Paper 1 at 26, 53. For each, Petitioner mapped both the “speech recognition system” and “wireline node” to the same component in the reference. *Id.* For Julia, Petitioner asserted “remote server 108” is

both. Paper 1 at 53; *see also* Exhibit 1019 ¶ 373. For Murdock, Petitioner asserted “remote server computer 130” is both. Paper 1 at 26; *see also* Exhibit 1019 ¶ 216. Applying the same logic here as the Board applied in the -345 proceeding for claims 14 and 53 compels these same determinations for claim 27 and its dependents:

- [B]ecause the Petition points to the same element for “a speech recognition system” and “wireline no[d]e,” we determine that Petitioner has not established, by a preponderance of the evidence, that Julia teaches “a speech recognition system coupled to a wireline node in a network,” as [claim 27] require[s]. -345 Paper 59 at 26.
- [B]ecause the Petition points to the same component for “a speech recognition system” and “wireline node,” we determine that Petitioner has not established, by a preponderance of the evidence, that Murdock teaches “a speech recognition system coupled to a wireline node in a network.” -345 Paper 59 at 30.
- We need not, however, consider or discuss the objective evidence of nonobviousness, because even assuming the absence of any evidence of nonobviousness there is not sufficient evidence of obviousness to support a conclusion that any challenged claim is unpatentable. -345 Paper 59 at 30-31.

As it did in the -345 IPR with respect to claims 14 and 53, this issue fully disposes of Petitioner's challenge against claim 27 and its challenged dependents (claims 28, 30-32, 38-42), and the Federal Circuit affirmed this result on this basis in the -345 IPR for claims 14-15, 17-19, 25-26, 53-55, 61-62 and 64-66.

IV. Petitioner Never Argued Claim 27 Differed From Claims 14 and 53

Never once—not during the original briefing in this proceeding, not at the consolidated oral hearing, and not on appeal to the Federal Circuit—did Petitioner ever argue that claim 27 should be treated differently from claims 14 and 53. To the contrary, both Patent Owner and Petitioner recognized their similarity. During the consolidated hearing, both parties argued these together. Paper 56 at 22:15-24:7, 61:15-17. On appeal, Patent Owner urged the Federal Circuit to exercise its discretion to affirm the Board's decision on claim 27 based on this common limitation. *Comcast Cable Commc'ns v. Promptu Sys.*, No. 19-2287 (Fed. Cir. Feb. 10, 2020), ECF No. 28 at 64 (arguing that the Board's decision in the -345 IPR “provides an alternative basis for affirming the Board's decision in the -344 proceeding as to claims 27-28, 30-32, and 38-42”). Petitioner never responded, though its Reply Brief on appeal recognized that claim 27 presents the same issue as claims 14 and 53. *Comcast Cable Commc'ns v. Promptu Sys.*, No. 19-2287 (Fed. Cir. Mar. 9, 2020), ECF No. 32 at 17 (“Claims 14, 27, and 53 are all similarly directed to . . . a speech recognition system coupled to a wireline node.”).

V. Issue Preclusion Precludes Relitigating This Issue

“[W]hen an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or different claim.” *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 148 (2015) (internal quotation omitted). Issue preclusion applies to decisions from the Board once they become final. *Papst Licensing GmbH v. Samsung Elecs. Am.*, 924 F.3d 1243, 1250-51 (Fed. Cir. 2019); *Nestle USA, Inc. v. Steuben Foods, Inc.*, 884 F.3d 1350, 1351-52 (Fed. Cir. 2018); *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376-78 (Fed. Cir. 2018).

In the -345 IPR, Petitioner and Patent Owner litigated (a) whether “speech recognition system coupled to a wireline node” requires a “speech recognition system” distinct from a “wireline node,” (b) whether Petitioner established a reference taught a “speech recognition system coupled to a wireline node” when its petition mapped both elements to the same component, and (c) whether the Board should consider Petitioner’s new mappings presented for the first time in its Reply. *See, e.g.*, -345 Paper 20 at 10; -345 Paper 29 at 9-11; -345 Paper 38 at 1-3. These issues were essential to the Board’s decision in the -345 IPR. -345 Paper 59 at 20-27, 30. There, the Board decided: (a) “a speech recognition system” and “wireline node” should be interpreted to be different components; (b) the petition, by

pointing to the same element for “a speech recognition system” and “wireline node” failed to establish that either Julia or Murdock teaches these elements; and (c) not to consider Petitioner’s new arguments raised in its Reply. *Id.* The Federal Circuit affirmed and, upon issuance of the mandate on February 25, 2021, the Board’s decision in the -345 IPR became final. Thus, these issues of law (claim construction) and fact (whether Julia or Murdock teach a “speech recognition system coupled to a wireline node”) were litigated in the -345 proceeding, determined by the Board against Petitioner, essential to the Board’s determination, affirmed by the Federal Circuit, and became final upon the mandate’s issuance.

These same issues are also determinative for claim 27. *See supra.* Because the elements of issue preclusion are met, Petitioner cannot dispute that neither Julia nor Murdock teach “a speech recognition system coupled to a wireline node” as recited in claim 27. “Once a court has decided an issue, it is forever settled as between the parties, thereby protecting against the expense and vexation attending multiple lawsuits, conserving judicial resources, and fostering reliance on judicial action by minimizing the possibility of inconsistent verdicts.” *B&B*, 575 U.S. at 147 (internal quotations omitted). “In short, a losing litigant deserves no rematch after a defeat fairly suffered.” *Id.*

Petitioner may point out that the Federal Circuit summarily denied Patent Owner’s petition for panel rehearing. But there are several reasons why the Federal

Circuit may have done so. First, Patent Owner's petition for rehearing and the Federal Circuit's denial of it both occurred prior to February 25, 2021—the date the Board's decision in the -345 IPR became final for purposes of issue preclusion. Simply, issue preclusion was not yet ripe; it is now. Second, the Federal Circuit's denial of rehearing plausibly reflects the determination that a remand was required either way for the Board to address claim 1 (which Promptu will address responsive to Comcast's supplemental briefing). In sum, the Board should read nothing into the Federal Circuit's exercise of discretion to not decide an alternative ground for partial affirmance presented in a rehearing petition.

VI. Conclusion

In the -345 IPR, Petitioner litigated, and lost, the issue of whether Julia or Murdock teach “a speech recognition system coupled to a wireline node.” The Federal Circuit's mandate, on February 25, 2021, finally decided that issue between Patent Owner and Petitioner. Claim 27 recites that same element and the petition's mapping here is identical to the petition's mapping in the -345 IPR. The Board should conclude here, as it did in the -345 IPR, that Petitioner failed to establish either Julia or Murdock teach “a speech recognition system coupled to a wireline node”—whether by the same rationale applied in the -345 IPR, as a matter of issue preclusion, or both. Accordingly, Petitioner cannot show that any of claims 27-28, 30-32, and 38-42 is unpatentable.

Respectfully submitted,

Dated: April 14, 2021

By: /Joshua L. Goldberg/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on April 14, 2021, a copy of
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