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 CORPORATION,
Patent Owner.

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Case IPR2018-00344
Patent 7,047,196

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PETITIONER'S OPENING BRIEF AFTER REMAND

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I. INTRODUCTION

Pursuant to the Board's Order issued on March 31, 2021 (Paper 63), Petitioner provides this opening brief addressing (i) the impact of the Federal Circuit decision correcting the construction of the term "received back channel"; and (ii) the impact of other subsequent authority on issues in this proceeding.

II. IMPACT OF THE FEDERAL CIRCUIT CONSTRUCTION OF "RECEIVED BACK CHANNEL"

In its Final Written Decision, the Board at Patent Owner's urging construed the phrase "receiving said back channel to create a received back channel" in the challenged claims to require both a "back channel" and a separate "received back channel." Paper 59 at 21-26 ("FWD"). Finding that Petitioner had "shown how Julia teaches 'receiving said back channel' (signals transmitted over network 106 (i.e., 'back channel') by remote serve 108) but not the creation of a separate 'received back channel,'" the Board rejected Petitioner's grounds of unpatentability. *Id*. at 26.

On appeal, the Federal Circuit agreed with Petitioner that "the 'received back channel' is merely a relabeled 'back channel.'" *Comcast Cable Communications, LLC v. Promptu Sys. Corp.*, 838 F.App'x 551, 554 (Fed. Cir. 2021) (the "Decision"). The Court explained that "[o]ne may read the 'received back channel' as merely the 'back channel' after being received." *Id*. "Although atypical and inartful, it is not unreasonable for the patentee to apply two different

time frames to the same claim element, a 'back channel' before receipt and a 'received back channel' after receipt." *Id*. Thus, the Court ruled that the correct interpretation "of 'received back channel' is a 'back channel that has been received.'" *Id*. Because the FWD was predicated on the incorrect construction, the Court vacated and remanded the case back to the Board.

As discussed below, the Federal Circuit's construction of the term "received back channel" negates arguments Patent Owner made in connection with the "receiving" and "partitioning" steps of claim 1 and parallel limitations of claim 27. Further, because the Board rejected Petitioner's grounds of unpatentability based on Murdock using the same incorrect construction of "received back channel," those grounds are again before the Board.

A. Julia Discloses "Receiving Said Back Channel to Create a Received Back Channel"

In this proceeding, Petitioner showed that Julia discloses "receiving said back channel to create a received back channel" as recited in claims 1 and 27. Paper 1 ("Pet.") at 44-45, 54; Paper 29 ("Reply") at 8-10. Patent Owner argued that Petitioner had not identified both a "back channel" and a separate "received back channel." Paper 20 ("PO Resp.") at 10. The Federal Circuit rejected Patent Owner's implicit construction in the remand decision and confirmed that Comcast's reading of the limitation is correct. Decision at 554. Thus, the Board should find that Julia discloses "receiving said back channel to create a received

back channel" as recited in the challenged claims.

B. Julia Discloses "Partitioning Said Received Back Channel"

Petitioner showed that Julia alone or in combination with Nazarathy or Quigley discloses "partitioning said received back channel into a multiplicity of received identified speech channels" as recited in claims 1 and 27. Pet. at 45-47, 54; Reply at 10-11. Patent Owner responded by asserting that the "received back channel" is a distinct element that is different than the "back channel." PO Resp. at 14. Patent Owner argued that Petitioner's contention that "both 'said back channel' and 'said received back channel' are the same thing, i.e. the upstream communication channel" was incorrect because, "if 'said back channel' and 'said received back channel' are the same thing, 'to create a received back channel' would be read out of the claims." *Id*. at 15. The Federal Circuit rejected Patent Owner's argument. Decision at 554 (holding that the correct "construction does not result in surplusage because every claimed term, including 'to create' and 'received,' has meaning"). Patent Owner also argued that a person of ordinary skill in the art would not understand the "back channel" and "received back channel" to be the same thing, which is irrelevant in light of the Federal Circuit decision confirming that they are. *Id*. (holding that the correct "interpretation of 'received back channel' is a 'back channel that has been received'").

Based on the Federal Circuit's decision and Petitioner's reply to Patent

Owner's other arguments (Reply at 10), the Board should find that Julia discloses the "partitioning said received back channel" limitation recited in the challenged claims.

C. Whether Murdock Constitutes Prior Art Remains for the Board to Decide

The Petition includes several grounds of unpatentability based on Murdock alone or in combination with certain secondary references. Pet. at 14-42; *see also* FWD at 15-16 (identifying Grounds 1-7 based on Murdock). Petitioner provided evidence and legal argument for its reliance on Murdock as prior art to the '196 Patent under 35 U.S.C. § 102(e). *See* Pet. at 9-10; Reply at 2-8; Paper 56 ("Hr'g Tr.") at 24:10-34:10. Patent Owner argued in response that the Board should disregard Petitioner's argument and evidence. PO Resp. at 6-8; Sur-Reply at 5-8. Patent Owner did not otherwise attempt to distinguish Murdock from the challenged claims.

The Board acknowledged the parties' dispute in the Final Written Decision but expressly did not reach it. FWD at 29 ("We need not decide this issue…."). Although the parties briefed whether Murdock constitutes prior art to the Federal Circuit, it also did not reach the issue. Decision at 553, fn. 1. Therefore, whether

Murdock constitutes prior art is back before the Board for resolution.[1]

III. IMPACT OF OTHER SUBSEQUENT AUTHORITY

Several weeks after issuance of the Final Written Decision in this proceeding, the Board issued its decision in IPR2018-00343 addressing U.S. Patent No. RE44,326 (the "'326 Patent"), which is related to the '196 Patent. *Comcast Cable Communications, LLC v. Promptu Sys. Corp.*, IPR2018-00343, Paper 56 (PTAB July 18, 2019) ("FWD-00343"). In IPR2018-00343, the Board found the challenged claims unpatentable based on Julia alone or in combination with other prior art references including certain references asserted in this proceeding. Promptu appealed the Board's decision and the appeal was remanded and stayed pending the outcome of *United States v Arthrex, Inc.* (U.S. No. 19-1434). Although not binding on the remand proceeding here, the decision in IPR2018-00343 is instructive because it addressed several issues that overlap with issues in

[1] Prior to the teleconference held with the Board on March 24, 2021, Petitioner agreed that it would not further address the merits of whether Murdock constitutes prior art to the '196 Patent in this brief. Petitioner has adhered to that agreement and expressly does not waive any arguments that it otherwise could have made here.

this proceeding.[2]

A. In IPR2018-00343, the Board Found Dependent Claims Similar to Claims 5, 6, 31, and 32 in the '196 Patent to Be Unpatentable

The Petition filed in this proceeding provided evidence and argument establishing that dependent claims 5, 6, 31, and 32 are obvious over Julia combined with either Banker or Gordon. Pet. at 36-41, 61-68; Reply at 14-17; Hr'g Tr. at 14:4-21:21. These dependent claims relate to using voice commands to conduct financial transactions. Claim 5 recites the steps of (1) "assessing said speech content response identified as to said user site to create a financial consequence identified as to said user site" and (2) "billing said user site based upon said financial consequence." Exhibit 1019 ("Schmandt Decl.") ¶62 (showing claim 5 and virtually identical claim 31). Claim 6 recites the same "assessing" step and then adds the steps of "displaying said financial consequence" and "confirming said displayed financial consequence" before "billing said user site based upon said financial consequence." *Id*. ¶63 (showing claim 6 and virtually identical claim 32).

In IPR2018-00343, the Board determined that Julia and either Banker or Gordon disclose and render obvious very similar dependent claims of the related '326 Patent. FWD-00343 at 61-65. For instance, claim 8 of the '326 Patent—like

[2] The Board held a single oral argument addressing both the instant *inter partes* review and IPR2018-00343. Hr'g Tr. at 1, 3:14-19.

claims 5 and 31 here—recites the steps of (1) "assessing a response identified as to a user device…to create a financial consequence" and (2) "billing a user associated with said user device based upon said financial consequences." *Id*. at 61. The Board found Petitioner's contentions that Julia and Banker or Gordon disclose both steps to be "persuasive." *Id*. at 62. Claim 9 of the '326 Patent—like claims 6 and 32 here—recites the same "assessing" step and then adds the steps of "communicating" the financial consequence to the user and "confirming said communicated financial consequence" before reciting the same "billing" step. *Id*. at 62-63. Again, the Board found Petitioner's contentions that Julia and either Banker or Gordon disclose the steps of claim 9 "persuasive." *Id*. at 63. The Board also considered and accepted Petitioner's evidence showing that a person of ordinary skill in the art would have been motivated to combine Julia with Banker or Gordon. *Id*. at 64.

Petitioner asserted the same grounds of unpatentability regarding the similar dependent claims in this proceeding and in IPR2018-00343. In both proceedings, Petitioner asserted that the limitations of the dependent claims are disclosed by

Julia with either Banker or Gordon. *Compare* Pet. at 3, 36-41, 62-66[3] *with* IPR2018-00343, Paper 1 at 3, 33-39, 59-64. Petitioner also submitted the same evidence of motivation to combine in both proceedings. *Compare* Schmandt Decl. ¶¶446-447 *with* IPR2018-00343, Exhibit 1023 ¶¶484-485. Thus, for the reasons presented in the record here, and as subsequently discussed in the IPR2018-00343 decision, the Board should reach the same conclusion that Julia and Banker or Gordon disclose and render obvious dependent claims 5, 6, 31, and 32.

B. In IPR2018-00343, the Board Rejected the Same Secondary Considerations Evidence Submitted Here

In this proceeding, Patent Owner submitted what it argued to be "objective

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[3] In the Petition, Banker and Gordon are initially discussed in connection with Murdock and later sections addressing Julia refer back to that earlier discussion. For example, the section explaining how Julia and Banker or Gordon render claim 5 obvious (on pages 61-63) refers back to the earlier discussion of Banker and Gordon in connection with Murdock. *See* Pet. at 63 ("Julia can be combined with either Banker or Gordon to disclose the 'assessing' and 'billing' steps, as discussed above in connection with Murdock. *See* Section VII.B.1," which is on pages 36-38). Thus, Petitioner's explanation of how Julia and Banker and Gordon disclose claims 5, 6, 31, and 32 includes the discussion of Julia on pages 62-66 and the discussion of Banker and Gordon on pages 36-41.

evidence of nonobviousness." PO Resp. at 28-41 (relying on the declaration of David Chaiken, Exhibit 2032). Patent Owner submitted essentially the same arguments and evidence in IPR2018-00343. *See* IPR2018-00343, Paper 24 at 20-35 (also relying on the declaration of David Chaiken, which was Exhibit 2032 in that proceeding as well). In IPR2018-00343, the Board found Patent Owner's evidence of objective indicia of nonobviousness—the same evidence presented here—to be "weak." FWD-00343 at 43. The Board's decision stepped through each of Patent Owner's arguments and identified numerous defects with each—all of which also exist here. *Id*. at 43-54; *see also* Reply at 18-26. That is, as in IPR2018-00343, the Board should find Patent Owner's secondary considerations evidence here to be "weak" and insufficient to overcome Petitioner's strong showing that the challenged claims are obvious.

IV. CONCLUSION

Based on the evidence and arguments presented by Petitioner and in light of the Federal Circuit remand decision and other subsequent authority, the Board should find the challenged claims unpatentable as obvious.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on April 14, 2021, the foregoing **Petitioner's Opening Brief After Remand** was served on Patent Owner's counsel of record via email, as agreed to by Patent Owner, at the following email addresses:

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