

**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 RESPONSE TO PATENT OWNER'S  
OPENING REMAND BRIEF**

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## **I. INTRODUCTION**

Pursuant to the Board’s Order issued on March 31, 2021 (Paper 63), Petitioner provides this response to the Opening Remand Brief filed by Patent Owner. Paper 64 (“PO Opening Br.”). Patent Owner’s arguments are based on the decision in IPR2018-00345 that was affirmed by the Federal Circuit. *Comcast Cable Comm’ns, LLC v. Promptu Sys. Corp.*, 838 F. App’x 551 (Fed. Cir. 2021) (the “Decision”). In the Decision, the Federal Circuit concluded that the petition in that other proceeding (IPR2018-00345) did not correctly map Julia to the “speech recognition system coupled to a wireline node” recited in the preambles of claims 14 and 53. Decision at 553-554. The court’s holding was specific to the petition in IPR2018-00345, which is materially different than the Petition in this proceeding. Further, the Federal Circuit, like the Board, declined to consider the more explicit mapping provided in the reply brief filed in IPR2018-00345. The Board should consider the Reply in this proceeding because it is consistent with the arguments in the Petition and because it provides a more express explanation of how Julia maps on the “coupled to” limitation in claim 27. Because the record here is materially different than the record evaluated by the Federal Circuit, the remand decision addressing the preambles of claim 14 and 53 does not dictate the outcome for the substantive limitations of claim 27.

Patent Owner argues that the Board should reject Petitioner’s challenge to claim 27 based on issue preclusion without even considering the merits. Patent Owner made the same argument on appeal, and the Federal Circuit rejected it—with good reason. Because the Federal Circuit decision turned on (i) the specific arguments in the petition in IPR2018-00345; and (ii) excluding the arguments in the reply brief in IPR2018-00345, the issue addressed there is not identical to the issue now before the Board: whether the arguments in the Petition and Reply *in this proceeding* adequately explain how Julia discloses each limitation of claim 27. Thus, the Board should reject Patent Owner’s issue preclusion argument—as the Federal Circuit did—and find based on the entire record in this proceeding that claim 27 is unpatentable in light of the prior art.

## **II. THE BOARD SHOULD CONSIDER PETITIONER’S REPLY BRIEF**

### **A. The Reply Brief Appropriately Clarified Petitioner’s Argument in Response to Patent Owner’s Argument**

In IPR2018-00345, the Board chose not to consider Petitioner’s reply brief addressing the Patent Owner’s argument that the petition in that proceeding had not adequately explained how Julia discloses the “speech recognition system coupled to a wireline node” recited in claims 14 and 53 of the ’196 Patent. IPR2018-00345, Paper 59 at 23-24 (“FWD-00345”). In its Opening Remand Brief, Patent Owner incorrectly asserts that Petitioner has never identified any difference between claims 14 and 53 (in the IPR2018-00345) and claim 27 (in this

proceeding). In fact, Petitioner argued in IPR2018-00345 that the “coupled to” language was *not limiting* because it appears only in the preambles of the claims at issue in that proceeding (i.e., claims 14 and 53). IPR2018-00345, Paper 29 at 9 (“Reply-00345”). In contrast, the phrase appears in the body of claim 27, and Petitioner addressed it differently in this proceeding because it clearly constitutes a limitation on the claim.

Indeed, one of the reasons that the Board chose not to consider the reply brief in IPR2018-00345 was because the brief referred back to the discussion of different claims in the petition in that proceeding rather than the discussion of the preambles of claims 14 and 53. FWD-00345 at 23 (“Petitioner cites [in the reply brief] to page 53 in its Petition. However, that page is discussing claims 15, 17, and 25, not claim 14 or claim 53.”). The Reply in this proceeding cited, and clarified, the argument made in the Petition addressing claim 27. Paper 29 (“Reply”) at 12. The Petition in this proceeding stated: “In Julia, speech recognition processing is performed by remote server 108, which constitutes ‘a wireline node’ in the network.” Paper 1 (“Pet.”) at 53. In response to an argument raised in Patent Owner’s Response, Petitioner clarified in its Reply that “Julia’s remote server 108 constitutes a wireline node and within it (i.e., coupled to it) is processing logic 300 (a speech recognition system).” Reply at 12.

The explanation in the Reply merely clarified that the Petition’s reference to

“speech recognition processing” in connection with claim 27 referred to processing logic 300 executing on server 108. That clarification was entirely consistent with the Petition’s description of Julia. *See, e.g.*, Pet. at 13 (Julia discloses transmitting voice data to remote server 108 “where it is ‘processed by request processing logic 300....’”); Pet. at 47 (“Julia explains that ‘[a]t remote server 108, the voice data is *processed* by request processing logic 300....’”; emphasis in original); Pet. at 55 (“Julia’s remote server performs speech recognition by executing ‘request processing logic 300....’”). Indeed, the Petition explained in connection with claim 27 that Julia identified commercially available “speech recognition engines” that could be employed for voice recognition (i.e., as processing logic 300) and that “[a] person of ordinary skill in the art would have known that these types of products include software that would reside ‘in memory accessibly *coupled to* at least one computer’ (i.e., remote server 108).” Pet. at 55 (emphasis added).<sup>1</sup> Thus, the Reply merely clarified, in response to Patent Owner’s argument, that the speech recognition system of Julia was processing logic 300 (i.e., software), which is “coupled to” the remote server 108.

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<sup>1</sup> The petition in IPR2018-00345 did not contain a similar statement because Petitioner’s analysis of claims 14 and 53 was different than its analysis of claim 27.

Patent Owner never moved to exclude the Reply and instead requested, and was granted, permission to file a Sur-Reply. Paper 32 (“Order Authorizing Sur-Reply by Patent Owner”). The Board cited the Sur-Reply in the Final Written Decision. *See, e.g.*, FWD at 29. Thus, Patent Owner was given, and exercised, the opportunity to respond to Petitioner’s Reply. *See, e.g., Sanofi-Aventis Deutschland GMBH v. Mylan Pharmaceuticals Inc.*, 791 Fed. App’x 916 (Fed. Cir. 2019) (rejecting argument that the Board should have disregarded new evidence submitted in reply when the evidence responded to arguments in the patent owner’s response and the patent owner was permitted a sur-reply). In these circumstances, the Board should consider the Reply and determine, based on the entire record, that Julia discloses a “speech recognition system coupled to a wireline node” as recited in claim 27.

**B. It Would Be an Abuse of Discretion to Refuse to Consider the Reply**

The Federal Circuit has reversed decisions where the Board refused to consider arguments in a reply brief that respond to an argument in the patent owner’s response and merely clarified or expanded on arguments in the petition. For instance, the Federal Circuit held in *Apple Inc. v. Andrea Electronics Corp.* that it was reversible error for the Board to disregard arguments offered in the petitioner’s reply brief. 949 F.3d 697, 699 (Fed. Cir. 2020). In that case, the Board declined to consider certain arguments in Apple’s reply brief because the

Board determined that it raised new arguments. *Id.* The Federal Circuit disagreed and found that “Apple’s legal ground did not change in its reply—its reply still asserted that [the challenged claims] would have been obvious over” the prior art combination identified in the petition. *Id.* at 706. The same is true here—the Reply clarifies how Julia renders claims 27 obvious; it does not change the theory of unpatentability at all. *See, e.g., Intellectual Ventures II LLC v. Ericsson Inc.*, 685 Fed. App’x 913, 922 (Fed. Cir. 2017) (appropriate to consider reply brief that clarified which two of four asserted prior art references satisfied a particular claim limitation because the theory of obviousness did not change); *see also Kingston Tech. Co., Inc. v. SPEX Techs., Inc.*, 798 Fed. App’x 629, 634-635 (Fed. Cir. 2020) (finding abuse of discretion where the Board disregarded supplemental briefing that “merely clarified [petitioner’s] original theory of invalidity”); *Chamberlain Grp., Inc. v. One World Techs., Inc.*, 944 F.3d 919 (Fed. Cir. 2019) (finding reversible error where the Board excluded patent owner arguments made during oral argument that were in response to reply brief arguments and that were “consistent with its position throughout the IPR and [were] merely a clarification”).<sup>2</sup>

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<sup>2</sup> The *Chamberlain Group* court noted that a reply brief may not raise a “new issue” as occurred in *Dell Inc. v. Acceleron LLC*, 884 F.3d 1364, 1369 (Fed.



In addition, the *Apple* court distinguished cases properly excluding a reply brief where the petitioner cited a different embodiment in the prior art never discussed in the petition (*Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015)) and where the petitioner added a new prior art reference in its reply (*Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359 (Fed. Cir. 2016)). 949 F.3d at 706. As in *Apple*, the Reply here neither discusses previously undisclosed embodiments of Julia nor relies on any new evidence. And, as in *Apple*, Petitioner’s “reply squarely responds to” the Patent Owner Response. *Id.* at 707. Based on a record very similar to the one presented here, the Federal Circuit in *Apple* held that “the conclusion that the reply brief constitutes an impermissible new matter [was] an abuse of discretion.” *Id.*

Similarly, the Federal Circuit held in *Ericsson Inc. v. Intellectual Ventures I LLC* that it was an abuse of discretion for the Board to disregard a reply brief that included arguments based on the same asserted prior art and that merely expanded on the petitioner’s theory of unpatentability. 901 F.3d 1374 (Fed. Cir. 2018). The *Ericsson* court found reversible error where, as here, “[t]he portions of the Reply

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Cir. 2018), where the petitioner’s reply raised new evidence and a new argument for unpatentability based on a different claim construction. 944 F.3d at 925.

the Board declined to consider expressly follow from these contentions raised in the Petition.” *Id.* at 1380; *see also id.* at 1381 (holding the Board should have considered a reply brief that “cites no new evidence and merely expands on a previously argued rationale”).

**C. Issue Preclusion Does Not Apply**

Patent Owner argues that the Federal Circuit decision regarding IPR2018-00345 precludes the Board from considering Petitioner’s arguments in this proceeding regarding claim 27. But issue preclusion only applies where “(1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to the final judgment in the first action; and (4) the [opposing party] had a full and fair opportunity to litigate the issue in the first action.” *See Laguna Hermosa Corp. v. United States*, 671 F.3d 1284, 1288 (Fed. Cir. 2012) (quoting *In re Freeman*, 30 F.3d 1459, 1465 (Fed. Cir. 1994)). Patent Owner cannot make the required showing because the issue before the Board in this proceeding is not identical to the issue addressed by the Federal Circuit.

The issue before the Board is whether the entire record in this proceeding, including both the Petition and the Reply, show that Julia discloses the limitations of claim 27. Neither the Federal Circuit nor the Board has ever considered the explicit mapping provided in the Reply; therefore, the issue decided by the Federal

Circuit—based solely on the arguments in the IPR2018-00345 petition and ignoring the reply brief—is not the same as the issue here because the Board should consider the Petition *and the Reply* in this proceeding for the reasons discussed above. And because the issue presented here is not identical to the issue resolved by the Federal Circuit with respect to IPR2018-00345, Patent Owner cannot show that an identical issue was “actually litigated” in the prior action, that the resolution of an identical issue was “essential” to the final judgment, or that Petitioner had a “full and fair opportunity” to litigate the identical issue in the prior action. *See Laguna Hermosa*, 671 F.3d at 1288.

Accordingly, issue preclusion does not apply, and the Board should consider Petitioner’s grounds for unpatentability based on the full record presented here including both the Petition and the Reply.

### **III. THE BOARD SHOULD REJECT PATENT OWNER’S NEW ARGUMENT THAT MURDOCK DOES NOT DISCLOSE THE LIMITATIONS OF THE CHALLENGED CLAIMS**

Patent Owner argues for the first time in its Opening Remand Brief that Murdock does not meet the “coupled to” limitation of claim 27. PO Opening Br. at 5-6. Patent Owner never made this argument—or attempted to distinguish Murdock from the challenged claims in any way—before now. Paper 20 (“PO Resp.”) at 6-8; Paper 38 (“PO Sur-Reply”) at 5-8. In the Final Written Decision, the Board rejected the Murdock grounds based on an incorrect construction of

“received back channel” that the Federal Circuit reversed and remanded. Paper 59 at 29 (“FWD”). The Federal Circuit did not otherwise address Murdock except to confirm that it did not reach the question of whether Murdock is prior art.

Decision at 553 n.1. Thus, there can be no preclusive effect of the Federal Circuit decision because neither the Board nor the Federal Circuit has determined that Murdock does not teach the limitations of claim 27.

Because Patent Owner never argued that Murdock does not disclose every limitation of the challenged claims before now, its new argument should be deemed waived. The question of whether Murdock invalidates the challenged claims should turn entirely on Murdock’s status as prior art, which the Federal Circuit did not reach and which is again before the Board for resolution.

#### **IV. CONCLUSION**

Based on the evidence and arguments in the full record before the Board—including Petitioner’s Reply—the Board should find claim 27 and the challenged claims depending from it unpatentable as obvious over either Julia or Murdock.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on May 5, 2021, the foregoing **Petitioner’s Response to Patent Owner’s Opening Remand Brief** 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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