

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

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

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## **I. Introduction**

The Petition in this proceeding challenges independent claims 1 and 27 of the '196 patent (and their dependents) on a variety of grounds. This petition was among eight petitions for *inter partes* or covered business method review filed by Petitioner against three of Patent Owner's patents related to voice recognition processing. The Board has already invested significant time and effort learning Patent Owner's technology and resolving Petitioner's duplicative proceedings. The Board has previously decided enough of the issues remaining here to uniformly dispose of Petitioner's lingering challenges to claims 1 and 27.

Patent Owner's prior submission (Paper 64) details how the Board may easily resolve all of Petitioner's challenges to claim 27 (and its dependents) of the '196 patent exactly as the Board resolved all of Petitioner's challenges to claims 14 and 53 in the -345 proceeding—a resolution affirmed by the Federal Circuit.

In this brief, responsive to Petitioner's Remand Brief, Patent Owner explains how the Board may resolve all of Petitioner's challenges to claim 1 (and its dependents) of the '196 patent exactly as the Board resolved similar issues in Petitioner's substantively identical petitions filed the same day as this one.

The Petition's challenges to claim 1 can be grouped into two buckets based on the primary reference: Julia or Murdock. Paper 10 at 16, 20-21. As to the Julia grounds, each relies on the combination of Julia with other references, and the

Board has already decided Petitioner's conclusory arguments are insufficient to establish a motivation to combine those references. As to the Murdock grounds, the Board has already decided, here and elsewhere, that Murdock is not prior art.

In sum, the Board may easily resolve Petitioner's challenges to claims 1 and 27 (and their dependents) based on the Board's prior analysis of identical issues.

**II. Julia grounds: The Board already decided that Petitioner's conclusory motivation-to-combine analysis failed to establish unpatentability.**

Petitioner's Opening Remand Brief baldly asserts: "Petitioner showed that Julia alone . . . discloses 'partitioning said received back channel.'" Paper 65 at 3. This is demonstrably false. Nowhere does the Petition state that Julia, alone, disclosed (let alone taught) partitioning. Rather, the Petition plainly states: "Nazarathy and Quigley both disclose techniques for 'partitioning'" and that "the combination of Julia with either of these references discloses the 'partitioning' step of claim 1." Paper 1 at 46-47. The Board agreed in its Institution Decision. Paper 10 at 30-33 (acknowledging that the Petition relies on Julia in combination with either Nazarathy or Quigley to teach partitioning). Petitioner expressly acknowledged that Julia *does not* teach partitioning during the oral hearing in distinguishing claim 1 (challenged here) and claim 14 of the '196 patent (challenged in the -345 proceeding). Paper 56 at 11-12 (stating for claim 1 that "Julia doesn't describe how to do [partitioning]. So we combine Julia with some

other prior art.”); *id.* at 22 (stating: “One thing I want to note is there’s no partitioning step in Claim 14, so you don’t need Nazarathy and Quigley, we could have an obviousness ground just based on Julia.”). The Board should reject Petitioner’s new argument that Julia discloses partitioning.

Instead, each of Petitioner’s Julia grounds here requires Julia in combination with some other reference. Paper 10 at 16, 21. Patent Owner’s Response explained that Petitioner’s stated motivations to combine Julia with Nazarathy or Quigley were “facially deficient” because, among other reasons, they fail to explain how or why the references would be combined to produce the claimed invention. Paper 20 at 21-23. Specifically, Patent Owner pointed out that the Petition merely (1) alleged the references came from the same field of study, and (2) recited boilerplate legal conclusions untethered to any claim language. *Id.*

The Board did not address Patent Owner’s “motivation to combine” arguments in its Final Written Decision. Paper 59 at 21 (“Patent Owner makes numerous arguments regarding how Julia combined with the teaching of Nazarathy or Quigley would not render any of the claims obvious.”); *id.* at 21-22 (deciding only whether Julia teaches “receiving said back channel to create a received back channel”). The Board *did*, however, address this identical issue in related proceedings initiated by Petitioner on the same day (IPR2018-00340 and IPR2018-

00341) concerning Petitioner's practically identical motivation to combine Julia with a different reference (Houser). *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, IPR2018-00340, Paper 58 at 24-26 (Mar. 29, 2019) (rejecting Petitioner's motivation to combine Julia with Houser because it was "untethered to any claim element, or to the claim as a whole," and fails to explain "*how or why* the references would be combined to produce the claimed invention"); *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, IPR2018-00341, Paper 58 at 19-21 (Mar. 29, 2019) (same). There, the Board agreed with Patent Owner and rejected Petitioner's "conclusory rationale for the combinations." *See, e.g., Comcast Cable Commc'ns*, IPR2018-00340, Paper 58 at 25; *Comcast Cable Commc'ns*, IPR2018-00341, Paper 58 at 20 (same). The Federal Circuit affirmed the Board's decisions in the -340 and -341 proceedings, stating the Board's finding "that Comcast's conclusory, threadbare arguments were not enough to establish motivation to combine" was supported by substantial evidence. *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, 838 F. App'x 555, 557 (Fed. Cir. 2021) (citing *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019)).

The motivation-to-combine analysis in Petitioner's -341 petition was substantively identical to its motivation-to-combine analysis in the petition here. *Compare Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, IPR2018-00341,

Paper 1 at 35-38 (Dec. 19, 2017), *with* -344 Paper 1 at 60-61. If anything, the Petition here contained even less detail than the petition in the -341 proceeding. And Patent Owner's challenge to Petitioner's conclusory, copy-and-paste analysis was identical across these proceedings. *Compare Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, IPR2018-00341, Paper 20 at 14 (Sept. 20, 2018) ("Petitioner argues that a POSITA 'would have recognized the benefits of combining Julia with Houser,' yet merely identifies generalized purported benefits without linking them to the features of the challenged claims."), *with* -344 Paper 20 at 22 ("Petitioner argues that a POSITA would have 'recognized the benefits of combining Julia with the teachings of Nazarathy and Quigley,' yet merely identifies generalized purported benefits without linking them to the features of the challenged claims."). As a matter of consistency and efficiency, the Board should decide this issue uniformly here and find Petitioner's motivation-to-combine analysis inadequate to carry its burden to establish obviousness.

Accordingly, the Board should refuse to consider Petitioner's new argument that Julia discloses partitioning. The Board should instead agree with Patent Owner that Petitioner's conclusory, threadbare motivation to combine Julia with other references was insufficient to meet its burden—consistent with the Board's decision reached in the -340 and -341 proceedings (on a substantively identical

record) that has since been affirmed by the Federal Circuit. This will finally resolve Petitioner's Julia-based challenges to claim 1.

**III. Murdock grounds: The Board already decided that Murdock is not prior art.**

Petitioner's Opening Remand Brief states that whether Murdock constitutes prior art remains for the Board to decide, and provides incomplete cites for where the parties previously presented these arguments to the Board. Paper 65 at 4-5. Petitioner failed to mention the Board's decision in its Institution Decision here that "Petitioner has not shown that Murdock is prior art to the '196 Patent." Paper 10 at 26. Petitioner also omitted cites to Patent Owner's presentation on this issue from the combined oral hearing in this proceeding and the -343 proceeding involving the '326 patent. Paper 56 at 41:17-47:11, 74:5-75:6, 91:20-92:14.

And while Petitioner's Opening Remand Brief cherry picks issues from the Board's now-vacated Final Written Decision in that -343 proceeding as "instructive" (Paper 65 at 5-9), Petitioner neglects to mention that the Board's same decision also decided, in an analysis spanning ten pages based on the argument presented at the combined hearing, that Murdock was not prior art to the '326 patent. *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, IPR2018-00343, Paper 56 at 68-77 (July 18, 2019) ("Hence, Petitioner has not shown that Murdock is prior art to the '326 patent."). Not only is the '326 patent related to the



'196 patent (Paper 65 at 5), but both patents claim priority to the same provisional application filed on June 8, 2000 (60/210,440).<sup>1</sup> For consistency and efficiency, the Board should decide this issue uniformly here. This will finally resolve Petitioner's Murdock-based challenges to claim 1.

**IV. Petitioner's remaining points concerning purported overlapping issues are irrelevant.**

Petitioner's Brief contends the Board's now-vacated Final Written Decision in the -343 proceeding is "instructive" on two other issues that "overlap" with issues in this proceeding concerning: (1) dependent claims 5, 6, 31, and 32; and (2) secondary considerations. Paper 65 at 5-9. This is an unnecessary distraction.

**A. The Board need not separately address these issues.**

As an initial matter, if the Board agrees with Patent Owner that Petitioner has failed to establish that claim 1 (*see supra*) and claim 27 (Paper 64) are unpatentable, then the Board need not separately address the patentability of claims 5 and 6 (depending from claim 1) or 31 and 32 (depending from claim 27). Nor

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<sup>1</sup> Prior to the March 24 teleconference, the parties agreed not to further address the merits of whether Murdock constitutes prior art to the '196 patent in this briefing. Patent Owner has adhered to that agreement and responds only to points made or unfairly omitted from Petitioner's Opening Brief regarding Murdock.

would the Board need to address Patent Owner's secondary considerations evidence and arguments. *See, e.g.*, Paper 59 at 30-31 (refusing to address secondary considerations when "there is not sufficient evidence of obviousness to support a conclusion that any challenged claim is unpatentable").

**B. The Petition's analysis with respect to claims 5, 6, 31, and 32 of the '196 patent was deficient in ways not addressed by the Board's prior decision concerning a different petition's treatment of different claims from a different patent.**

Petitioner argues that in the -343 proceeding, "the Board determined that Julia and either Banker or Gordon disclose and render obvious very similar dependent claims of the related '326 Patent." Paper 65 at 6. While the Board may have determined that with respect to the petition against the '326 patent, it is irrelevant to the issues presented by the Petition here against the '196 patent.

The Petition here relied *solely* on Julia for the claimed "creat[ing] a financial consequence" element in each of claims 5, 6, 31, and 32. Paper 1 at 62-63; Paper 10 at 42-44; Paper 20 at 24-26, 27. The Board already decided this in the Institution Decision here: "we agree with Patent Owner that Petitioner appears to be relying on Julia for teaching the 'creating a financial consequence' limitation." Paper 10 at 44. But Julia discloses video on demand, not pay-per-view. *See id.* at 42-44 (agreeing with Patent Owner that "video-on-demand" does not necessarily "create a financial consequence"). It was for this reason that, in the Institution

Decision here, the Board stated: "Petitioner has not persuaded us that Julia teaches the limitation at issue" and "we are not persuaded that the information presented in the Petition and the relevant portions of Julia and the Schmandt Declaration show a reasonable likelihood that Petitioner would prevail in showing that claims 5, 6, 31, and 32 are unpatentable." *Id.* at 44. As Patent Owner explained in its Response, Julia does not disclose creating a financial consequence. Paper 20 at 24-26. In the -343 proceeding, this issue was neither raised by Patent Owner nor addressed by the Board's Final Written Decision.

**C. Patent Owner's evidence on secondary considerations differed between the '196 patent and the '326 patent.**

Petitioner argues that "as in IPR2018-00343, the Board should find Patent Owner's secondary considerations evidence here to be 'weak.'" Paper 65 at 9. As a preliminary matter, Promptu presented different evidence of secondary considerations with respect to the '196 patent than it did with respect to the '326 patent. *Compare, e.g., Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, IPR2018-00343, Ex. 2032 at 5-6 (Sept. 27, 2018) (testimony that "The AgileTV Solution Is Described in Promptu's '326 Patent"), *with* -344 Ex. 2032 at 5-6 (testimony that "The AgileTV Solution Is Described in Promptu's '196 Patent"). And, unlike the '326 patent, Petitioner knew the claims of the '196 patent had already been allowed at the time Petitioner took a license to Patent Owner's

portfolio. Paper 56 at 75-76; Ex. 2022 at 78.

More fundamentally, however, the Board's analysis of Patent Owner's evidence of secondary considerations in the -343 proceeding was intertwined with its construction of the term "network path," recited in every challenged claim of the '326 patent. *Comcast Cable Commc'ns*, IPR2018-00343, Paper 56 at 20, 39-60. The claims of the '196 patent do not recite the term "network path" and, therefore, the basis for the Board's analysis of Promptu's evidence of secondary considerations in a different proceeding, concerning a different patent, with different evidence of secondary considerations, does not apply here—especially when Petitioner offered only attorney argument, not evidence to respond to Patent Owner's evidence of secondary considerations. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1391-94 (Fed. Cir. 1988) (reversing holding of obviousness where patent challenger failed to present any evidence to rebut patent owner's evidence of secondary considerations).

## **V. Conclusion**

The Board may efficiently and uniformly resolve the remaining challenges to claims 1 and 27 based on the Board's prior analysis of identical issues.

Respectfully submitted,

Dated: May 5, 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 May 5, 2021, a copy of  
**PATENT OWNER'S RESPONSE TO PETITIONER'S OPENING REMAND  
BRIEF** was served upon the below-listed counsel by electronic mail:

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