

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner

v.

VEVEO, INC.,
Patent Owner

IPR2019-00237, IPR2019-00238,
IPR2019-00239 (Patent 7,779,011 B2);
IPR2019-00290, IPR2019-00291, IPR2019-00292,
IPR2019-00293 (Patent 7,937,394 B2)¹

Before KALYAN K. DESHPANDE, SHEILA F. McSHANE, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

PER CURIAM

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

¹ This Order applies to each of the listed cases. Given the similarities of issues, we issue one Order to be docketed in each case. The parties are not permitted to use this caption style, except as otherwise authorized.

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IPR2019-00290, -291, -292, -293 (Patent No. 7,937,394 B2)

On November 12, 2018, Petitioner filed seven Petitions in two sets: (1) the first set requesting *inter partes* review of claims 1–24 of U.S. Patent No. 7,779,011 B2 (“the ’011 patent”) in Cases IPR2019-00237, IPR2019-00238, and IPR2019-00239; and (2) the second set requesting *inter partes* review of claims 1–11 of U.S. Patent No. 7,937,394 B2 (“the ’394 patent”) in Cases IPR2019-00290, IPR2019-00291, IPR2019-00292, and IPR2019-00293. The patents at issue in each of the respective sets of proceedings are related – the ’394 patent is a continuation of the ’011 patent. IPR2019-00290, Ex. 1021, [63].

According to Patent Owner in its Preliminary Responses, the Petitions in each set of proceedings are cumulative and Petitioner does not explain why the prior art references are not redundant or that any distinctions that Petitioner attempts to raise among the Petitions are material. *See, e.g.*, IPR2019-00237, Paper 9, 49–52; IPR2019-00290, Paper 9, 53–56. Patent Owner asserts that the Petitions should be denied on this basis. *Id.*

The Director has discretion to deny a petition under 35 U.S.C. § 314(a). *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). The Board takes into account various considerations when exercising discretion on behalf of the Director. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (Section II.B.4.i. designated as precedential) (stating factors considered in Board’s exercise of discretion under 35 U.S.C. § 314(a)). Although the facts of *General Plastic* concern serial or “follow-on” Petitions, the Office Trial Practice Guide Update notes

[t]here may be other reasons besides the “follow-on” petition context where the “effect . . . on the economy, the

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integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings,” favors denying a petition even though some claims meet the threshold standards for institution.

Office Trial Practice Guide Update² referenced at 83 Fed. Reg. 39,989 (“Trial Practice Guide Update”) (Aug. 13, 2018), at 10 (quoting 35 U.S.C. § 316(b)).

Maintaining multiple, concurrent proceedings per patent presents a significant burden for the Board, because, among other things, the Board endeavors to assign all such cases to the same panel. *See* SOP 1 (Rev. 15), III.G.3. When there are other related patents also each challenged by multiple petitions at the same time, as is the case here, this may place an unfair burden on the Patent Owner and can undermine the Office’s ability to complete proceedings in a timely manner. *See* Trial Practice Guide Update at 10; *cf. General Plastic*, slip op. at 16 (requiring the Board to consider ability to meet statutory deadlines as an institution factor); 37 C.F.R. § 42.1(b) (“[The rules] shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”).

We note that Petitioner points out differences among the respective Petitions in each of the two sets of proceedings, including different teachings pertaining to some claim limitations and different priority dates among the primary references. *See, e.g.*, IPR2019-00237, Paper 2, 13–14; IPR2019-00290, Paper 2, 9–10. We agree with Patent Owner, however, that the number of Petitions here challenging the same patent may place a substantial and unnecessary burden on the Board and Patent Owner. Accordingly, the panel issues this Order under 37 C.F.R. § 42.5 to provide the parties an

² Available at <https://go.usa.gov/xU7GP>.

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opportunity to focus the Board's limited resources on genuine issues in dispute.

Within 14 days of this Order, Petitioner shall provide a Notice in each set of proceedings, not to exceed 5 pages, identifying (1) a ranking of the respective Petitions, in each set of proceedings, in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the Petitions, and (2) a succinct explanation of the differences between the Petitions in each set of proceedings, why the differences are material, and why the Board should exercise its discretion to consider the additional Petitions if it identifies a Petition that satisfies Petitioner's burden under 35 U.S.C. § 314(a). The Board encourages Petitioner to use a table to aid in identifying the similarities and differences between the Petitions.

If it so chooses, Patent Owner may, within 14 days of the receipt of Petitioner's Notice, provide a Response in each set of proceedings, not to exceed 5 pages, stating its position with respect to any of the differences identified by Petitioner. In particular, Patent Owner should explain whether the differences identified by Petitioner are material and in dispute. If stating that reasons are not material or in dispute, Patent Owner should clearly proffer any necessary stipulations.³

Petitioner and Patent Owner are instructed to file the same paper in each respective set of proceedings and are authorized to use a combined caption format for each set. The panel will consider the parties' submissions

³ For example, Patent Owner may seek to avoid additional Petitions by proffering a stipulation that certain claim limitations or priority dates are not disputed.

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in determining whether to exercise its discretion to institute *inter partes* review under 35 U.S.C. § 314(a).

It is

ORDERED that within 14 days of this Order, Petitioner shall file a Notice in each of the set of proceedings consistent with the foregoing instructions; and

FURTHER ORDERED that, within 14 days of Petitioner's Notice, if it chooses to, Patent Owner may file a Response in each set of proceedings consistent with the foregoing instructions.

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