

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Charter Communications, Inc.  
Petitioner

v.

Sprint Communications Company  
Patent Owner

Case Nos. IPR2019-01136, IPR2019-01138, IPR2019-01140  
Patent No. 6,754,907

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**PETITIONER'S NOTICE**  
**(As Authorized by the Board via Email Dated July 29, 2019)**

Patent Owner Sprint Communications Company (“Sprint”) has taken numerous inconsistent positions with respect to the scope of the ’4907 patent claims in both the pending district court litigation as well as prior litigation involving the patent. As detailed below, these inconsistent positions have forced Petitioner Charter Communications, Inc. (“Petitioner”) to file three separate petitions covering the various possible permutations of Sprint’s arguments. For example, when Sprint asserted the ’4907 patent against Comcast Cable Communications, LLC in *Comcast Cable Commc’ns, LLC v. Sprint Commc’ns Co., LP*, Case No. 2:12-cv-859-JD (E.D. Pa.), it took the position that the claims do not require using a set-top box to remotely control the claimed video-on-demand system. The *Comcast* court rejected Sprint’s proposed construction and instead held that the ’4907 patent disclaimed the use of a set-top box for remote control. Based on its adopted construction, the *Comcast* court granted summary judgment of non-infringement of the ’4907 patent, because the accused Comcast product required a set-top box for remote control of the video-on-demand system. Despite this judgment, in its pending district court litigation against Petitioner, Sprint accuses Petitioner’s products of infringing the ’4907 patent even though those products also use a set-top box for remote control of the video-on-demand system. It is unclear to what extent Sprint contends the set-top boxes in Petitioner’s accused products are relevant to the accused functionality and whether it contends, despite the prior *Comcast* court’s constructions, that the set-top boxes in

Petitioner’s accused products perform the accused remote control. Accordingly, based on Sprint’s inconsistent positions, Petitioner was forced to file three separate petitions based on the different disclosures of “video-on-demand systems” in the prior art references.

***Ordering of Petitions.*** Although Petitioner’s petitions are all meritorious, non-cumulative, and justified in light of the numerous positions Sprint has taken and may take, Petitioner requests that the Board consider them in the following order:

<b><i>Rank</i></b>	<b><i>Petition</i></b>	<b><i>Primary References</i></b>
<i>A</i>	<i>IPR2019-1136 (Pet. 1 of 3)</i>	<i>Sampsell</i>
<i>B</i>	<i>IPR2019-1140 (Pet. 3 of 3)</i>	<i>Humpleman</i>
<i>C</i>	<i>IPR2019-1138 (Pet. 2 of 3)</i>	<i>Ellis</i>

The following are exemplary material differences between the petitions:

(1) ***Sprint’s inconsistent litigation positions:*** In the pending district court litigation, Sprint fails to provide specific and consistent positions on the scope of the claims. As noted above, Sprint previously asserted the ’4907 patent against Comcast Cable Communications, LLC in Case No. 2:12-cv-859-JD (E.D. Pa.). In construing the terms “a video-on-demand system” (claim 1) and “operating a video-on-demand system” (claims 10 and 19), the *Comcast* court held that the ’4907 patent disclaims the use of a set-top box for remote control because the patent disparages the prior art’s reliance on set-top boxes and does not include a set-top box in any of its embodiments. (Petition Ex. 1010 at 28.) Based on these claim constructions, the *Comcast* court granted summary judgment of non-infringement. *Comcast Cable*

*Commc'ns, LLC v. Sprint Commc'ns Co., LP*, 203 F. Supp. 3d 499, 553 (E.D. Pa. 2016). Nonetheless, Sprint now asserts that Petitioner's products that use a set-top box for remote control—like the *Comcast* product—infringe the '4907 patent. Therefore, Petitioner was forced to file different petitions to address Sprint's disparate reading of “a video-on-demand system” as used in the claims based on prior art references that: (1) include a docking station for remote control of the video-on-demand system (*Sampsell*); (2) do not include any set-top box or docking station (*Humpleman*); and (3) disclose a set-top box in some embodiments but do not use it for remote control of the video-on-demand system (*Ellis*).

**(2) Different video-on-demand system disclosures:** Given Sprint's vague and inconsistent infringement allegations in the litigations, Petitioner relies on separate and distinct primary references that each disclose a different video-on-demand system—one in each petition. IPR2019-1136 relies on primary reference *Sampsell*. *Sampsell* discloses an image display system that is capable of displaying user selected video images on two displays—the first display device can be a screen or display and the second display can be a video remote-control that is integrated with a computer monitor, such as a WEB-TV device. (*Sampsell*, Abstract, 13:12-16.) While *Sampsell* does not use a set-top box for remote control, it does disclose a docking station for the video remote-control to “hold the remote control” and to passively “send[] and receiv[e] RF signals.” (*Sampsell*, 11:45-12:12.)

IPR2019-1140 relies on primary reference *Humpleman*. *Humpleman* discloses a system that generates a program guide to watch video content over a network that bridges various electronic devices, such as a digital video device, a digital TV, and a PC. (*Humpleman*, Abstract, 1:16-18, 4:20-24, 5:39-67, Figs. 6-8, 10-11.) *Humpleman* does not disclose the use of a set-top box, as neither the term “set-top box” nor any analogous term appears in *Humpleman*.

IPR2019-1138 relies on primary reference *Ellis*. *Ellis* discloses a video-on-demand system that allows a user to remotely control the system using a remote program access device so that the user can remotely play a stored program or a currently broadcasted program on the remote program access device or on television equipment. (*Ellis*, 2:23-28, 2:47-60, 5:9-12, Fig. 2d.) While *Ellis* discloses using a set-top box for control in some embodiments, it explicitly discloses that these embodiments are “alternative” embodiments and explicitly teaches not using the set-top box for control in the other embodiments. (*Ellis*, 7:53-65, 8:10-20, 9:4-6.)

While *Sampsell*, *Humpleman*, and *Ellis* each invalidate the claims under the *Comcast* court’s construction, it is unclear which construction Sprint will rely on in the district court litigation and PTAB proceedings against Petitioner. Therefore, Petitioner was required to file three petitions based on different primary prior art references to cover the various constructions Sprint may rely on in these proceedings.

(3) **Priority date:** Each petition relies on primary references (*Sampsell*, *Humpleman*, and *Ellis*) that qualify as prior art under § 102(e) and have different effective dates. To the extent Sprint tries to antedate any of these references, the difference in priority dates, ranging from June 24, 1998 (*Humpleman*) to July 16, 1999 (*Ellis*), could be dispositive and is a key difference between these petitions.

(4) **Number of claims:** The '4907 patent has 25 total claims. Although Sprint has not asserted all 25 claims against Petitioner in the pending district court litigation, Sprint has yet to affirmatively state that it will not assert any specific claims against Petitioner in the future. Petitioner was thus required to challenge all 25 claims. Given the number of claims, Petitioner was required to file three separate petitions with different primary references in order to adequately address the numerous claim limitations present in the '4907 patent.

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The Board should consider all three petitions and not exercise its discretion to deny institution in an IPR potentially impacting the video-on-demand feature set in millions of homes. No petition is redundant, and the materiality of the differences between the petitions are amplified by Sprint's shifting positions on claim construction (*i.e.*, what is a "video-on-demand system"), obviousness-specific defenses, antedating the prior art, and the teachings of the prior art.

Respectfully submitted,

Dated: August 19, 2019

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PETITIONER'S NOTICE was served electronically via e-mail on August 19, 2019 on the following counsel of record for Patent Owner:

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