UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,

Petitioner

v.

SPRINT COMMUNICATIONS COMPANY L.P.,

Patent Owner

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

PATENT OWNER'S NOTICE REGARDING MULTIPLE SUCCESSIVE PETITIONS

As authorized by the Board's email of July 29, 2019, Patent Owner Sprint Communications Company L.P. files this Notice in response to the Notice filed by Petitioner Charter Communications, Inc. on August 19, 2019.

Between May 30 and June 4, 2019, Petitioner filed three Petitions for *Inter Partes* Review of U.S. Patent No. 6,754,907 (the "'4907 patent"). Combined, these Petitions assert eleven grounds of challenge, and each ground is asserted against all twenty-five claims of the patent. With these filings, Petitioner imposes an unfair burden on Patent Owner and unnecessary costs on the Office and the patent system. *See* Trial Practice Guide Update at 26 (July 2019) (expressing concern about the "substantial and unnecessary burden on the Board and the patent owner" caused by parallel petitions and the effect on "fairness, timing, and efficiency"), *available at* https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf (last visited Aug. 27, 2019). Despite raising eleven grounds, Petitioner asserts only five total pieces of alleged prior art, which it rearranges in myriad configurations, as shown in the chart below. Rather than limit these grounds to a reasonable number or focus on arguments it deems superior, Petitioner foists the responsibility onto the Board to sift through hundreds of pages of repetitive briefing to consider, *e.g.*, the combinations of Ellis with Humpleman (in IPR2019-01138) and Humpleman with Ellis (in IPR2019-01140). *Cf. Nalox-1 Pharms., LLC v. Opiant Pharms., Inc.*, IPR2019-00694, et al., 2019 WL 3483268, at *1-2 (PTAB July 31,

2019) (agreeing that three Petitions "challenging the same patent . . . may place a substantial and unnecessary burden on the Board and Patent Owner, particularly if we determine the Petitions rely on substantially overlapping grounds and theories").

Case	Grounds	Overlap
IPR2019-01136	Sampsell, §102	All three primary references cited in at least one combination.
	Sampsell & Yosuke, §103	
	Sampsell, Yosuke & Browne, §103	
	Sampsell, Yosuke & Humpleman, §103	
	Sampsell & Ellis, §103	
IPR2019-01138	Ellis, §102	Only Sampsell missing.
	Ellis & Browne, §103	
	Ellis & Humpleman, §103	
IPR2019-01140	Humpleman, §102	Only Sampsell missing.
	Humpleman & Yosuke, §103	
	Humpleman & Ellis, §103	

(*See* IPR2019-01136, Paper 2, 9; IPR2019-01138, Paper 2, 9; IPR2019-01140, Paper 2, 9.)

Petitioner was given the opportunity to defend this conduct, and it cannot.

First, Petitioner complains that Patent Owner has taken "numerous inconsistent positions" about claim scope. (Paper 6, 1.) Yet Petitioner identifies only one issue of claim scope—the use of a set-top box to control a "video-on-demand

[VOD] system" of the claims—and no evidence that Patent Owner's positon on that single issue has been inconsistent in any way. Petitioner concedes that the *Comcast* court imported a negative limitation excluding the use of a set-top box for VOD system control, which was contrary to Patent Owner's proposed constructions. (*Id.*, 1. *See generally* EX1010, 27-35.) Patent Owner disagreed with the *Comcast* court's constructions, then, and continues to oppose the use of those constructions in concurrent litigation. Patent Owner's position has therefore been consistent.

In addition, Petitioner argues in every Petition that the references disclose the claimed subject matter of the '4907 patent under both the *Comcast* court's construction and Patent Owner's. (IPR2019-01136, Paper 2, 18-20, 23, 41-42, 69-70; IPR2019-01138, Paper 2, 15-18, 22-23; IPR2019-01140, Paper 2, 20-21, 24, 58, 69-70.) The difference between these constructions is therefore not material. Even if Petitioner is only allowed institution on a single Petition, it will have addressed both constructions.

Second, the differences between the disclosures of the cited references are not material for essentially the same reason. As shown in its Notice, Petitioner's position in these proceedings (with which Patent Owner disagrees) is that "*Sampsell*, *Humpleman*, and *Ellis* each invalidate the claims under the *Comcast* court's construction." (Paper 6, 4.) That construction gives the claims a narrower scope than they would have under the construction Patent Owner has proposed in litigation.

Petitioner does not appear to dispute that anything encompassed by the narrower construction would also be encompassed by the broader one. Petitioner therefore fails to identify any differences between the prior art references that would be material to the outcome on any of its Petitions.

The differences identified in the cited art are not material for the further reason that Petitioner relies on various overlapping combinations of its primary references in each Petition, as shown in the chart above.

Third, there is no priority date issue. The '4907 patent does not claim priority to any earlier filings. (*See* EX1001, cover.) And Petitioner's suggestion that antedating might be an issue is pure speculation. The filing dates of the primary references do not differ significantly; they are all within a 13-month span (June 24, 1998 to July 16, 1999). And the earliest prior conception Sprint has alleged in litigation was September 1999.

Fourth, the number of claims also does not justify the burden of instituting review on multiple parallel petitions. Petitioner challenged every claim of the '4907 patent in every ground of every Petition. In other words, the "number of claims" is not a difference between the Petitions at all, let alone a material difference. If the Board institutes on any Petition, Petitioner will have the opportunity to be heard on several grounds challenging each claim of the '4907 patent; instituting on more than one Petition is not necessary to ensure this.

Petitioner's arguments rely on facts common to nearly all infringement litigation. In the early stages of a case, claims will not yet be construed and discovery will be ongoing. Thus, claim scope, the identity of the claims to be tried, and the date of invention will all be uncertain. But this uncertainty alone does not justify filing or instituting on multiple parallel petitions for review, as Petitioner contends. If Petitioner wants to preserve a broad range of theories, it remains free to withdraw its Petitions and pursue invalidity defenses in district court. Choosing *inter partes* review instead means accepting a "quick and cost effective alternative[] to litigation." H.R. Rep. No. 112-98, Part 1, at 48 (2011) (underline added); *see id.* ("[T]he Committee intends for the USPTO to address potential abuses and current inefficiencies under its expanded procedural authority."). Instituting parallel proceedings here, based on run-of-the-mill litigation uncertainty, would encourage multiple-petition filings and undermine the purpose of *inter partes* review. The Board should exercise its discretion not to do so.

CONCLUSION

"[M]ultiple petitions by a petitioner are not necessary in the vast majority of cases," Trial Practice Guide Update at 26 (July 2019), and Petitioner has not shown this case to be an exception to the general rule. Accordingly, if the Board decides to institute review of the '4907 patent on any of the Petitions—a decision unjustified on its merits—it should restrict Petitioner to only one Petition.

Dated: September 9, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a copy of the foregoing was served on September 9, 2019 via email, with consent of Petitioner, directed to the following addresses: deepaacharya@quinnemanuel.com, jimglass@quinnemanuel.com, patrickstafford@quinnemanuel.com, and cameronclawson@quinnemanuel.com.

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