IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,

Petitioner,

v.

WHEREVERTV, INC.,

Patent Owner.

Patent No. 8,656,431
Filing Date: July 10, 2006
Issue Date: February 18, 2014
Title: GLOBAL INTERACTIVE PROGRAM GUIDE APPLICATION AND DEVICE

Inter Partes Review No.: IPR2019-01483

PETITIONER'S REPLY IN SUPPORT OF ITS PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,656,431

LIST OF EXHIBITS

Exhibit	Description
1101	U.S. Patent No. 8,656,431 ("'431 patent")
1102	Prosecution History of U.S. Patent No. 8,656,431
1103	Plaintiff's Objections and Answers to Defendant's Interrogatories (Nos. 1-2), *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, No. 2:18-cv-529-FtM-99CM (FLMD Aug 1, 2018)
1104	Plaintiff's Amended Notice of Asserted Patent Claims, *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, No. 2:18-cv-529-FtM-99CM (FLMD Aug 1, 2018)
1105	Deposition of Mark Cavicchia (named inventor on the '431 patent) dated May 15, 2019 (excerpts)
1106	Declaration of Dr. Andrew Lippman
1107	Patent Owner's proposed claim constructions in Florida action
1108	McGraw-Hill Dictionary of Scientific and Technical Terms, 6th ed. (2003) (definition of "server")
1109	Microsoft Press Computer User's Dictionary (1998) (definition of "server")
1110	U.S. Patent No. 7,546,623 ("Ramraz")
1111	U.S. Patent No. 7,373,652 ("Bayrakeri")
1112	Comcast Corporation's Form 10-K 2004 Annual Report
1113	"2004 Form 10-K, The DirecTV Group," U.S. Securities and Exchange Commission (March 17, 2004)
1114	U.S. Patent Publication No. 2006/0235800 ("Furlong")
1115	U.S. Patent No. 6,009,116 ("Bednarek")
1116	U.S. Patent No. 7,260,538 ("Calderone")

1117	KRON-TV, https://en.wikipedia.org/wiki/KRON-TV (last visited August 16, 2019)
1118	KRON-TV webpage from www.archive.org dated December 28, 2004
1119	American Broadcasting Company, https://www.wikizero.com/en/ABC_(United_States) (August 9, 2019)
1120	KABC-TV, https://en.wikipedia.org/wiki/KABC-TV (August 9, 2019)
1121	About ABC7 Los Angeles, https://abc7.com/communityevents/about-abc7-los-angeles/50642/ (August 9, 2019)
1122	Erin Joyce, TV: The Next Portal War, Internet News (August 8, 2003)
1123	Evaluating DRM: Building a Marketplace for the Convergent World, Center for Democracy and Technology (Sept. 2006)
1124	Opinion and Order in *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, No. 2:18-cv-529-TJC-NPM (M.D. Fla. Oct. 9, 2019), Dkt. No. 103, denying request to stay without prejudice
1125	Spreadsheet of cases requesting stays pending *inter partes* review in Middle District of Florida
1126	Excerpts from Comcast's invalidity contentions in *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, No. 2:18-cv-529-TJC-NPM (M.D. Fla. May 6, 2019)
1127	Minute order in *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, No. 2:18-cv-529-TJC-NPM (M.D. Fla. Dec. 23, 2019), Dkt. No. 122, cancelling claim construction hearing
1128	Minute order in *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, No. 2:18-cv-529-TJC-NPM (M.D. Fla. Jan. 2, 2020), Dkt. No. 123, reassigning case to a different judge
1129	Unopposed Motion of January 13, 2020, for Leave to Extend Expert Report Deadlines in *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, No. 2:18-cv-529-TJC-NPM (M.D. Fla. Jan. 10, 2020)

The Board should not exercise its discretion to deny institution because, unlike in *NHK*, (1) the Board likely will issue its final decision before the district court litigation ("Litigation") trial, and (2) other relevant factors weigh in favor of institution. *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc*., No. IPR2018-00752, 2018 WL 4373643 (P.T.A.B. Sept. 12, 2018) ("NHK").

First, the Board's final decision will likely occur before trial because, if the petition is granted, the Litigation likely will be stayed. *See Abbott Vascular, Inc. v. Flexstent*, No. IPR2019-00882, 2019 WL 4940254, at *13 (P.T.A.B. Oct. 7, 2019) (refusing to exercise discretion because of "possibility" of a stay). Indeed, the Middle District of Florida (where the Litigation is pending) has stayed its cases *eight of nine* times upon institution.[1] Ex. 1125. WhereverTV's claim that the court "already denied Petitioner's motion to stay" is misleading. POPR at 49. The court declined to stay pending institution *without* prejudice, saying it would reconsider once review is instituted. Ex. 1124 at 7 ("The Court agrees with the well-reasoned analysis in *Automatic*" that stayed the case upon the Board's institution decision).

Even absent a stay, the Board's decision will not necessarily issue after trial. The court just reassigned the case to a new judge who has indefinitely postponed the *Markman* hearing. Ex. 1127-28. WhereverTV is thus incorrect in asserting

[1] In the single case that the court did not stay, the primary reason was that the Board was not addressing all asserted claims in the litigation. *U.S. Nutraceuticals v. Cyanotech*, 2014 WL 12617592, at *1 (M.D. Fla. Mar. 10, 2014) (pre-*SAS*).

that the *Markman* order will "likely" issue before the institution decision. POPR at 49. Further, WhereverTV did not oppose Comcast's motion filed today for an extension on expert reports so that they would now be due after the (unscheduled) *Markman* hearing. Ex. 1129. Although other court dates have not yet changed, it is speculative to contend that trial will proceed as scheduled. And Comcast would likely appeal any adverse invalidity decision anyway. Thus, a final court ruling is very far off. [2]

Second, as the PTAB noted in *NHK*, the district court's schedule was only an "additional factor," not a dispositive one. *NHK* at *7. In fact, recent PTAB decisions confirm that a parallel district-court schedule is not, by itself, reason to exercise discretion to deny institution. *Intuitive Surgical, Inc. v. Ethicon LLC*, No. IPR2018-01703, 2019 WL 764067, at *5 (P.T.A.B. Feb. 19, 2019) ("NHK Spring does not suggest, much less hold, [an IPR] should be denied … solely because a district court is scheduled to consider the same validity issues before the [IPR]…."); *Abbott*, No. IPR2019-00882, 2019 WL 4940254, at *13 ("Treating [the court schedule] as dispositive…would be at odds with the Trial Practice Guide. [In any event, we] decline to adopt such a bright-line rule."); *Samsung Elecs. Co. v. Immersion*, No. IPR2018-01499, 2018 WL 7515967, at *8 (P.T.A.B. Mar. 6,

[2]And while WhereverTV says Comcast should have petitioned earlier, even petitioning *ten years* after being aware of prior art is acceptable. *NHK*, No. IPR2018-00752, 2018 WL 4373643, at *7.

2018); *Intel Corp. v. Qualcomm*, No. IPR2019-00128, 2019 WL 2295763, at *5 (P.T.A.B. May 29, 2019).

Third, the invalidity issues are not the same. Unlike in *NHK* (p. 20), Comcast asserts district court invalidity positions based on system art not at issue in the IPR. Ex. 1126. It is therefore speculative to presume that the "references proffered in the present Petition will be presented as the same combination in [the] ultimate case at trial." *Unified Patents v. Mv3 Partners*, No. IPR2019-00474, 2019 WL 4570444, at *4 (P.T.A.B. Sep. 20, 2019); *Abbott*, No. IPR2019-00882, 2019 WL 4940254, at *13 (not exercising discretion under *NHK* because "Petitioner may rely on IPR-ineligible grounds before the district court").

Finally, even if the court schedule disfavored institution (and it does not), other factors weigh in favor of institution, including (1) the relatively few resources needed to decide the IPR (involving one independent claim and primary reference); (2) fairness (*e.g.*, Comcast diligently prepared and expended substantial resources in filing its petition); and (3) all of the other factors the Board typically considers, all of which indicate that the Board should not exercise discretion to deny institution. In particular, denying institution based on the Litigation, where the court expressly noted that it will consider a stay post-institution, is contrary to the purpose of IPRs as a more efficient, cost-effective alternative to litigation.

The Board should therefore not exercise its discretion to deny institution.

Respectfully submitted,
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CERTIFICATE OF SERVICE ON PATENT OWNER UNDER 37 C.F.R. §§ 42.6(e) & 42.105(a)

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on January 13, 2020, a complete and entire copy of this Petitioner's Reply in Support of Its Petition for *Inter Partes* Review of U.S. Patent No. 8,656,431 and all supporting exhibits were provided via Federal Express, postage prepaid, to the Patent Owner by serving the correspondence address of record for the '431 Patent:

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