

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT AND 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 14, 2014

**Title: *Global Interactive Program
Guide Application and Device***

***Inter Partes* Review No. IPR2019-01483**

**PATENT OWNER'S SUR-REPLY IN
SUPPORT OF ITS PRELIMINARY RESPONSE**

LIST OF EXHIBITS

Exhibit	Description
2101	Declaration of Michael I. Shamos, Ph.D., J.D.
2102	July 10, 2006 Patent Application; Title: Interactive Program Guide Application and Device
2103	Case Management and Scheduling Order in Patent Case filed in Case No. 2:18-cv-529; <i>WhereverTV, Inc. v. Comcast Cable Communications, LLC</i> , United States District Court Middle District of Florida Fort Myers Division
2104	Computer Desktop Encyclopedia Ninth Edition by Alan Freeman
2105	Modern Cable Television Technology Video, Voice, and Data Communications 2 nd Edition by Walter Ciciora, James Farmer, David Large, Michael Adams
2106	A Streaming Media Primer Enabling real-time or on-demand access to audio, video, and multimedia content via the Internet or an intranet from the Adobe Dynamic Media Group
2107	Corrected Amended Joint Claim Construction Statement filed in Case No. 2:18-cv-529; <i>WhereverTV, Inc. v. Comcast Cable Communications, LLC</i> , United States District Court Middle District of Florida Fort Myers Division
2108	Minute Order dated January 2, 2020
2109	Endorsed Order dated January 14, 2020
2110	Spreadsheet distinguishing cases cited in Comcast Ex. 1126
2111	Comcast Cable Communications, LLC's Invalidity Contentions

The Board should deny institution under *NHK Spring Co., Ltd. v. Intrix-Plex Techs., Inc.*, No. IPR2018-00752 (P.T.A.B. Sept. 12, 2018). Like *NHK*, the district court trial here is scheduled to begin *only seven months* after the Board’s institution decision. Ex. 2103. Like *NHK*, the same prior art is at issue in both proceedings. Ex. 2111. Like *NHK*, the jury trial will occur months before the IPR trial. Ex. 2103. Like *NHK*, both proceedings will apply the same claim construction standard. Like *NHK*, the district court case is “nearing its final stages,” namely: (i) fact discovery ends April 14, 2020; (ii) expert discovery ends May 14, 2020; and (iii) the parties will file their Joint Pretrial Statement on August 25, 2020. *Id.* In other words, all substantive jury trial preparations will be finished with two months of extra cushion before the trial setting on October 5, 2020. *Id.*

Petitioner speculates that the jury trial could be postponed, but nothing suggests that will happen. On December 23, 2020, the *Markman* hearing set for January 13, 2020, was cancelled “pending the reassignment of the case to a different judge,” but days later the parties received notice from the new judge (Judge Corrigan) that all other “*hearings, final pretrial conferences and trials previously set. . . will be held . . . on the same date, time, and in the same courtroom as previously noticed.*” Ex. 2108. Petitioner then moved to reschedule the expert report deadlines to follow the issuance of the Markman Order by thirty days, but that motion does not affect any other deadlines. In fact, when granting the

unopposed motion, Judge Corrigan again made clear that: “*All other remaining deadlines . . . in the Case Management and Scheduling Order. . . remain in effect.*”

Ex. 2109. Thus, the district court has twice confirmed in only the past three weeks that the court will enforce its current trial schedule, including the trial date.

Petitioner also “predicts” that the court could stay the case, but Petitioner relies on cases that are inapposite.¹ Given the advanced stage of litigation, the case is *not* likely to be stayed. In any event, *NHK* does not ask litigants to “predict” the outcome of an *unfiled, future* motion to stay; instead, the analysis is whether the Board should commit limited resources to a case that is already scheduled to end long before the Board can conduct an IPR trial.

Petitioner next wrongly alleges that the prior art is not the same. Tellingly, Petitioner does not identify any art that is not also at issue in the district court. Petitioner confuses this issue by vaguely referring to “system art,” which is irrelevant, and then omitting the pages from its Invalidity Contentions that would show which prior art is before the district court. Patent Owner includes those omitted pages in its own exhibit. Ex. 2111. Other considerations also weigh against institution. Ex. 2107; *Orthopediatrics v. K2m*, No. IPR2018-01548 (P.T.A.B. Mar. 1, 2019); *Hologic v. Enzo*, No. IPR2018-00019 (P.T.A.B. Apr. 18, 2018).

¹ Petitioner submitted an exhibit listing the cases that it relies on. Patent Owner attaches a similar exhibit showing that those cases are inapposite, with copies of the unpublished cases. Ex. 2110.

Date: January 16, 2020

Respectfully submitted,

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COUNSEL FOR PATENT OWNER

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §§ 42.6 and 42.105(b), the undersigned certifies that on January 16, 2020, a complete and entire copy of this Patent Owner's Sur-Reply in Support of Patent Owner's Preliminary Response and in Opposition to Petitioner's Petitioner (and Reply) for *Inter Partes* Review of U.S. Patent No. 8,656, 431 and all supporting exhibits were served via Electronic Mail this 16th day of January 2020 on the following lead and backup counsel for Petitioner.

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