UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COMCAST CABLE COMMUNICATIONS, LLC

Petitioner

v.

WHEREVERTV, INC.

Patent Owner

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IPR2019-01482

IPR2019-01483

Patent 8,656,431

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PETITIONER COMCAST CABLE COMMUNICATIONS, LLC'S RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS

Comcast Cable Communications, LLC ("Comcast" or "Petitioner") requests *inter partes* review of claims 1 and 3-9 of U.S. Patent No. 8,656,431 ("'431 patent" (Ex. 1001)) issued February 18, 2014. Petitioner is filing two separate petitions (IP2019-01482 and IPR2019-01483) regarding the '431 patent asserted against Petitioner in pending district-court litigation. Pursuant to the July 2019 Update to the Trial Practice Guide, Petitioner submits this paper for consideration by the Board to explain the material differences between the petitions being filed against the '431 patent. Petitioner respectfully requests that the Board exercise its discretion by instituting review on the grounds identified in both petitions.

I. ORDERING OF THE PETITIONS

Although both petitions are meritorious and necessary to fully address the disparate grounds for invalidity of Patent Owner's asserted claims, Petitioner, at this stage, requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Reference
A	IPR2019-01482 (Petition 1 of 2)	Walter
B	IPR2019-01483 (Petition 2 of 2)	Ramraz

II. SUCCINCT EXPLANATION REGARDING SEPARATE PETITIONS

A. Differences in the Petitions

Comcast's petitions apply different art in different ways and are not redundant. Specifically, Petition 1 uses Walter as the primary reference for all challenged claims, while Petition 2 uses Ramraz as the primary reference for all challenged claims. The petitions also rely on different secondary references. For example, Petition 1 relies on JumpTV as its main secondary reference, while Petition 2 uses Bayrakeri as its main secondary reference. In addition, the prior art in each petition has different priority dates. Walter has a priority date of September 13, 2005, whereas Ramraz has a priority date of January 5, 2005.

The petitions also use the prior art cited in each petition in very different ways. Claim 1 is the sole independent claim being challenged, and is also the claim from which the other challenged claims depend. As shown in the following table, the petitions apply different combinations of prior art in different ways with respect to independent claim 1 (and hence, the dependent claims as well). An 'X' is used to denote the limitations that each reference discloses:

	Petition 1		**Petition 2**	
Claim 1 of the challenged '431 patent	**Walter**	**Jump TV**	**Ramraz**	**Bayrakeri**
A content manager device comprising:	X		X	
a server resident on a network containing descriptive program data about video content available from one or more multiple cable system operators (MSOs) . . .		X	X	
a server resident on a network containing descriptive program data about video content available from . . . one or more non-MSOs	X		X	
a device capable of establishing and maintaining a connection…; and	X		X	
an interactive program guide application installed on the device that provides user-configurable interactive program guide (IPG) listing at least one channel of video content available from each of the one or more MSOs … and descriptive program data from the server for the video content available on each of the channels …,		X	X	
an interactive program guide application installed on the device that provides a user-configurable interactive program guide (IPG) listing at least one channel of video content available from … each of the one or more non-MSOs and	X		X	

descriptive program data from the server for the video content available on each of the channels . . .,				
wherein each of the channels is selectable for receiving only or virtually entirely streaming video programming from its respective MSO source . . .;		X	X	
wherein each of the channels is selectable for receiving only or virtually entirely streaming video programming from its respective … non-MSO source . . .;	X		X	
wherein the server is distinct from …	X		X	
and wherein the application allows for the IPG to be configured by a user with respect to adding or deleting channels from any of the one or more MSOs . . .	X		X	X
and wherein the application allows for the IPG to be configured by a user with respect to adding or deleting channels from any of the one or more . . . non-MSOs	X			X

B. Why the Differences Are Material

First, the petitions rely on different combinations of references for different elements of claim 1, as shown in the chart above. For example, Petition 1 relies on a primary reference (Walter) for its disclosure of adding channels to an IPG and a secondary reference (JumpTV) for its disclosure of an MSO that provides streaming video content. In contrast, Petition 2 relies on a primary reference (Ramraz) for its disclosure an MSO that provides streaming video content and a secondary reference (Bayrakeri) for its disclosure of adding channels to the IPG. Additionally, as a result, the motivations to combine the prior art in each petition

are also substantially different because they address different combinations of prior art disclosures.

Second, the petitions vary in one key difference related to the limitation that the Examiner relied upon in issuing the claims of the '431 patent: "the application allows for the IPG to be configured . . . with respect to adding or deleting channels[.]" Petition 1 relies on primary-reference Walter as disclosing this limitation, whereas the prior art in Petition 2 renders it obvious (in view of secondary-reference Bayrakeri).

Third, the prior art references in each petition carry different priority dates. As explained above, Walter has a priority date of September 13, 2005 (which is within a year of the '431 patent's July 10, 2006, filing), whereas Ramraz has a priority date of January 5, 2005. The differences in the relevant prior art dates in the petitions is material, as Patent Owner has argued (albeit incorrectly) that the challenged claims are entitled to a priority date before its filing date.

Fourth, the motivations and reasons a skilled artisan at the time of the supposed invention would have combined the respective prior art of the two petitions differ. As for Petition 1, the motivations for combining the primary Walter reference with the secondary JumpTV.com reference revolve around the attractiveness of leveraging the Internet to increase service area and subscriber base by implementing JumpTV.com's Internet-based MSO streaming system in lieu of Walter's infrastructure-laden cable-based content source. This is entirely different from the reasons and motivations spurring the combination in Petition 2. In Petition 2, the attractiveness of the combination is enhancing user-friendliness of the Ramraz-disclosed system that provides video content from disparate MSO and non-MSO sources through streaming. The reasons and motivations to combine revolve around enabling a user to be able to both add channels to and delete channels from an interactive program guide the receives descriptive program

data about the video content available from the MSO and non-MSO content sources.

Therefore, the petitions present invalidity grounds using primary and secondary references that disclose different aspects of the challenged claims, different rationales for combining the prior art, and different prior art dates.

C. Why the Board Should Exercise its Discretion to Institute Review on Both Petitions

Given the above-described material differences, the Board should exercise its discretion to institute review on both petitions. The filing of the petitions is not a serial or repetitive challenge of the '431 patent. Rather, the separate petitions include distinct challenges based on different prior art, motivations to combine, and prior art dates. The invalidity grounds are equally straightforward and compelling in both petitions. Instituting proceedings on both petitions would allow the Board to fully analyze validity based on all prior art combinations and obviousness rationales presented.

There would be little, if any, inconvenience to the Board and parties if proceedings were instituted for both petitions. Each petition only presents a single ground for invalidity of each challenged claim, and only challenges a handful of the claims in the '431 patent. Therefore, the additional amount of time and resources needed if the Board instituted review on both petitions would be minimal.

Accordingly, Petitioner respectfully requests that the Board institute review on both petitions, and cancel all challenged claims of the '431 patent based on the grounds presented in the petitions.

III. CONCLUSION

In view of the foregoing, Petitioner respectfully requests that review be instituted on both petitions filed against the '431 patent.

Respectfully submitted,
BAKER & HOSTETLER LLP

Daniel J. Goettle (Reg. No. 50,983)
Jeffrey Lesovitz (Reg. No. 63,461)

Attorneys for Petitioners

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Baker & Hostetler LLP
Cira Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891
(215-568-3100)

UNDER 37 C.F.R. §§ 42.6(e) & 42.105(a)

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on August 20, 2019, a complete and entire copy of foregoing was provided via Federal Express, postage prepaid, to the Patent Owner by serving the correspondence address of record for the '431 Patent:

Robert N. Harrison
Robert N Harrison, PA
304 West Venice Avenue, Suite 201
Venice, FL 34285
robert@harrisonlawoffice.com
(941) 485-8551 (telephone)
(941) 584-8376 (facsimile)

Adam Sanderson (pending special admission)
REESE MARKETOS LLP
750 N. St. Paul, St. Ste. 610
Dallas, Texas 75201
(214) 382-9810 (telephone)
(214) 501-0731 (facsimile)
adam.sanderson@rgmfirm.com

Counsel for Plaintiff
WhereverTV, Inc.

Respectfully submitted,

BAKER HOSTETLER LLP

Daniel J. Goettle (Registration No. 50,983)
Cira Centre, 12th Floor

2929 Arch Street
Philadelphia, PA 19104-2891
P: (215) 564-8974
F: (215) 568-3100
dgoettle@bakerlaw.com
ATTORNEY FOR PETITIONER