

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner

v.

ROVI GUIDES, INC.,
Patent Owner

Case IPR2020-00787
Patent 7,200,855

**JOINT MOTION TO WITHDRAW PETITION FOR *INTER PARTES*
REVIEW**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONER’S UPDATED EXHIBIT LIST

Previously Filed:

- Ex. 1001: U.S. Patent No. 7,200,855 (“the ’855 patent”)
- Ex. 1002: Declaration of Dr. Vernon Thomas Rhyne, III
- Ex. 1003: Excerpts from the File History of U.S. App. No. 09/864,602
- Ex. 1004: In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components, Investigation No. 337-TA-1158 (U.S.I.T.C.), July 17, 2019 – Complainants’ Notice of Patent Priority Dates / Conception Dates
- Ex. 1005: U.S. Patent No. 8,601,519 (“Hicks”)
- Ex. 1006: Excerpts from *PCI Local Bus Specification, Revision 2.2*, PCI Special Interest Group, December 18, 1998 (“PCI”)
- Ex. 1007: Declaration of Doanh Vu
- Ex. 1008: Declaration of Stephen Kunin
- Ex. 1009: Reserved
- Ex. 1010: *Extending PCI Performance Beyond the Desktop*, Shlomo Weiss and Ehud Finkelstein, Computer, June 1999, pp. 80-87
- Ex. 1011: U.S. Patent No. 6,218,864 (“Young”)
- Ex. 1012: U.S. Patent No. 5,808,694 (“Usui”)
- Ex. 1013: Declaration of Dr. Carrie Gardner
- Ex. 1014: Excerpts from *Computer Networks*, Andrew S. Tanenbaum, Prentice Hall, Third Edition, 1996 (“Tanenbaum”)
- Ex. 1015: Excerpts from *Communication Systems*, Simon Haykin, John Wiley & Sons, Fourth Edition, 2001 (“Haykin”)

- Ex. 1016: Excerpts from *MPEG-2*, John Watkinson, Focal Press, 1999 (“Watkinson”)
- Ex. 1017: Excerpts from *Digital Video: An Introduction to MPEG-2*, B. Haskell *et al.*, Chapman & Hall, 1997 (“Haskell”)
- Ex. 1018: Excerpts from *Cable Television Handbook*, Eugene R. Bartlett, McGraw-Hill Video/Audio Professional, First Edition, 2000 (“Bartlett”)
- Ex. 1019: U.S. Patent No. 5,870,474 (“Wasilewski”)
- Ex. 1020: U.S. Patent No. 6,493,873 (“Williams”)
- Ex. 1021: Excerpts from In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components, Investigation No. 337-TA-1158 (U.S.I.T.C.), January 14, 2020 – Transcript of Telephonic Conference
- Ex. 1022: Excerpts from In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components, Investigation No. 337-TA-1158 (U.S.I.T.C.), January 28, 2020 – Transcript of Administrative Hearing Volume VI
- Ex. 1023: In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components, Investigation No. 337-TA-1158 (U.S.I.T.C.), October 21, 2019 – Joint Claim Construction Chart
- Ex. 1024: In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components, Investigation No. 337-TA-1158 (U.S.I.T.C.), January 22, 2020 – Comcast Respondents’ Notice of Withdrawal of Claim Terms
- Ex. 1025: In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components, Investigation No. 337-TA-1158 (U.S.I.T.C.), March 20, 2020 – Order No. 35: Initial Determination Granting Complainants’ Third Unopposed Motion for Partial Termination of the Investigation Without Prejudice [Motion Docket No. 1158-033]

- Ex. 1026: Excerpts from *Telecommunications Engineer's Reference Book*, Fraidoon Mazda, Editor, Butterworth-Heinemann Ltd, 1993
- Ex. 1027: Excerpts from *Dictionary of Computing*, Fourth Edition, Oxford University Press, 1996
- Ex. 1028: Excerpts from *Switched, Fast, and Gigabit Ethernet*, Third Edition, Robert Breyer and Sean Riley, Macmillan Technical Publishing, 1999
- Ex. 1029: Reserved
- Ex. 1030: Excerpts from *Newton's Telecom Dictionary*, Sixteenth Edition, Telecom Books, 2000
- Ex. 1031: U.S. Patent No. 7,039,021 ("Kokudo")
- Ex. 1032: Reserved
- Ex. 1033: Excerpts from *Internetworking With TCP/IP Vol I: Principles, Protocols, and Architecture*, Third Edition, Prentice-Hall, Inc., 1995.
- Ex. 1034: Excerpts from *Wireless LANs: Implementing Interoperable Networks*, Jim Geier, Macmillan Technical Publishing, 1999
- Ex. 1035: Reserved
- Ex. 1036: Reserved
- Ex. 1037: U.S. Patent No. 4,386,436 ("Kocher")
- Ex. 1038: U.S. Patent No. 6,487,362 ("Yuen")
- Ex. 1039: U.S. Patent No. 6,408,128 ("Abecassis")
- Ex. 1040: U.S. Patent No. 6,452,923 ("Gerszberg")
- Ex. 1041: U.S. Patent No. 5,990,927 ("Hendricks")
- Ex. 1042: U.S. Patent No. 7,031,380 ("Cheng")

- Ex. 1043: Excerpts from *The MPEG Handbook MPEG-1, MPEG-2, MPEG-4*, John Watkinson, Focal Press, 2001 (“Watkinson2001”)
- Ex. 1044: Excerpt of *In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components*, Investigation No. 337-TA-1158 (U.S.I.T.C.), Verified Complaint Under Section 337 of the Tariff Act of 1930, as Amended
- Ex. 1045: U.S. Patent No. 6,400,280 (“Osakabe”)
- Ex. 1046: Excerpts from *FireWire System Architecture: IEEE 1394a*, Don Anderson, Addison-Wesley, 1999 (“Anderson”)
- Ex. 1047: *PCI System Architecture, Fourth Edition*, Tom Shanley and Don Anderson, Addison-Wesley, 1999 (“Shanley”)

Filed Herewith:

- Ex. 1048: BUSINESS CONFIDENTIAL Settlement Agreement
- Ex. 1049: BUSINESS CONFIDENTIAL Licensing Agreement

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board email of November 10, 2020, Petitioner Comcast Cable Communications, LLC (“Petitioner”) and Patent Owner Rovi Guides, Inc. (“Patent Owner”) jointly request withdrawal of the Petition filed in this proceeding, IPR2020-00787, directed to U.S. Patent No. 7,200,855 (the “’855 Patent”).

I. CERTIFICATION

Petitioner and Patent Owner submit a true copy of any agreement or understanding (Exhibits 1048 and 1049) between Petitioner and Patent Owner made in connection with, or in contemplation of, the withdrawal of the Petition for the proceeding under 37 CFR § 42.74(b) with this joint motion.

II. STATUS OF RELATED PROCEEDINGS

Petitioner and Patent Owner have resolved their disputes regarding the ’855 Patent, including both in this proceeding and Patent Owner’s assertion of the ’855 Patent in the related district court litigation, 2-19-cv-03096, and the related investigation before the U.S. International Trade Commission, ITC-337-TA-1158. The parties do not anticipate further litigation between them concerning the ’855 Patent. The following related proceedings are currently before the Board: IPR2020-00788 and IPR2020-00789.

III. RELIEF REQUESTED

As authorized by the Board, the parties are jointly and contemporaneously filing: (i) this joint motion to withdraw the Petition; (ii) a true copy of any agreement or understanding (Exhibits 1048 and 1049) between Petitioner and Patent Owner made in connection with, or in contemplation of, the requested withdrawal of the Petition; and (iii) a joint request to treat the agreements as business confidential information and keep the agreements (Exhibits 1048 and 1049) separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety. Termination is appropriate at this stage and in view of a settlement between Petitioner and Patent Owner. An *inter partes* review shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceedings before the request for termination is filed. 35 U.S.C. § 317(a). Good cause exists to terminate this proceeding because (1) Petitioner and Patent Owner have resolved their disputes regarding the '855 Patent; (2) this proceeding is still at an early stage because the Office has not yet decided whether to institute trial; and (3) terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

Date: November 10, 2020

Respectfully submitted,

/Frederic M. Meeker/

Frederic M. Meeker (Reg. No. 35,282)
Banner & Witcoff, Ltd.
Attorney for Petitioner

Date: November 10, 2020

Sterne, Kessler, Goldstein & Fox P.L.L.C.

/Jason D. Eisenberg/

Jason D. Eisenberg (Reg. No. 43,447)
Attorney for Patent Owner

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATION, TYPEFACE REQUIREMENTS, AND TYPE STYLE
REQUIREMENTS**

This paper complies with the type-volume limitation of 15 pages, excluding those parts exempted by 37 C.F.R. § 42.24. This motion complies with the general formatting requirements of 37 C.F.R. § 42.6 and has been prepared using Microsoft Word 2016 in 14 point Times New Roman font.

Dated: November 10, 2020

By: /Frederic M. Meeker/

Frederic M. Meeker, Reg. No. 35,282
BANNER & WITCOFF, LTD.

Attorney for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **JOINT MOTION TO WITHDRAW PETITION FOR *INTER PARTES* REVIEW** and **Exhibits 1048 and 1049** were served electronically via e-mail on November 10, 2020 in their entireties on the following counsel for Patent Owner:

JASONE-PTAB@STERNEKESSLER.COM
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Date: November 10, 2020

/Carlos A. Goldie/

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