

**UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.**

**Before the Honorable MaryJoan McNamara
Administrative Law Judge**

In the Matter of

**CERTAIN DIGITAL VIDEO RECEIVERS,
BROADBAND GATEWAYS, AND
RELATED HARDWARE AND
SOFTWARE COMPONENTS**

Investigation No. 337-TA-1158

COMPLAINANTS' PRE-HEARING BRIEF

the '855 Patent are invalid. Comcast fails to satisfy this evidentiary burden. Comcast selected three references for its narrowed invalidity case: (a) U.S. Patent No. 8,601,519 (“Hicks”); (b) HomeRF: Wireless Networking for the Connected Home (“Negus”); and (c) U.S. Patent No. 5,708,961 (“Hylton”). All argument and discussion of other references is improper and waived.¹⁹

1. Anticipation Under 35 U.S.C. § 102

Comcast argues that the Asserted Claims are anticipated by Hicks.²⁰ Comcast failed to meet its burden to prove that Hicks discloses every limitation in each of the Asserted Claims. For Claim 14, there is no evidence that Hicks discloses receiving a plurality of channel selection commands by: (a) receiving, from a plurality of clients, a plurality of channel selection requests; and (b) processing the plurality of channel selection requests to produce the plurality of channel selection commands as Hicks does not disclose the contents of the purportedly corresponding instructions. *See, e.g.*, RX-0034 (Hicks) at 4:21-5:3. Comcast can point to no disclosure in Hicks regarding what is included in the signals that Comcast identifies as channel selection commands or requests, let alone that those signals identify a particular channel and at least one client. *Id.* Channel selection commands cannot be produced if there are no channel selection requests to process and channels cannot be produced without channel selection commands. The evidence will show that Hicks also fails to disclose monitoring a shared bus at specific time intervals or identifying a data frame at a specific time interval because, although TDMA is disclosed in reference to HomeRF, it is only in the context of voice communications and not monitoring to

¹⁹ Rovi filed a motion to enforce Comcast’s compliance with Order Nos. 5 and 12 and adherence to its selection of these three references. Motion Dkt. No. 1158-016 (Oct. 4, 2019).

²⁰ Comcast improperly relies on HomeRF in its anticipation analysis because Hicks identifies HomeRF as one of several “lower bandwidth data networking technologies” that can supplement the primary broadband network although it “can principally be used for transmitting lower bandwidth multimedia content, such as audio content, as opposed to entertainment quality audio-video” RX-0034 at 3:16-17, 13:27-30.

identify data frames containing channel selection commands. *Id.* at 3:14-31, 7:49-51. There is no evidence or argument that Hicks discloses decoding the data frame based on a data conveyance protocol, a data conveyance protocol used to both decode and encode in the claims, or that the decoding to recapture the channel selection command is done after the identifying limitation. Dr. Jones will testify that an analog to digital convertor (ADC) merely converts information from analog to digital, but does not encode based on a data conveyance protocol. Hicks also does not disclose encoding a channel based on a data conveyance protocol and Comcast does not identify a particular protocol or how it would be used to encode. Nor does Hicks disclose encryption by the multimedia server prior to encoding. The MODSP pay per view is not a user defined list. *See, e.g., id.* at 13:15-44.

Claim 29 is not invalid for the same reasons as Claim 14 (for corresponding claim limitations).²¹ There is no evidence that Hicks discloses using a particular data conveyance protocol to meet the claim limitations, monitoring a shared bus at specific time intervals, or identifying a packet containing at least a portion of channel selection commands. There is also no evidence that Hicks necessarily discloses (as required for inherent anticipation) the tuning module of Claim 29 including either a decrypting module for decrypting channel selection commands or a decompressing module for decompressing channel selection commands.

Claims 60 and 63 are not invalid for the same reasons Claim 14 is not invalid (for corresponding claim limitations) and for these additional reasons.²² Hicks does not disclose a channel selection command including an identity of one of the sources or determining whether channel selection requests can be supported and therefore does not disclose operational

²¹ Claim 29 depends from claim 28.

²² Claim 60 depends from claim 59, which depends from claim 53. Claim 63 depends from claim 53.

instructions that cause the processing module to: (a) receive, from a plurality of clients, a plurality of channel selection requests by monitoring a shared bus at specific time intervals, (b) process the plurality of channel selection requests to determine whether the request can be supported, and, if so, producing a plurality of channel selection commands that include an identity of one of the plurality of sources and an identity of the channel; or (c) select a channel of the plurality of channels per channel selection command of the plurality of channel selection command to produce selected channels. The possible use of conditional access systems for encryption, *id.* at 4:1-11, or listing generic smart card contents, *id.* at 10:35-53, that “the enhanced digital STBs can provide for pay-per-view movie delivery,” *id.* at 1:54-55, is not clear and convincing evidence. Nor does Hicks disclose “encoding each . . . selected channel[]” as Hicks does not teach, and Comcast does not explain, how MPEG (or MAC layer in HomeRF) could be the data conveyance protocol for decoding channel selection requests identifying a channel and a client or encoding a channel. Hicks also does not disclose FDMA or TDMA conveying the claimed data frames. *Id.* at 6:32-42 (disclosing TDMA or FDMA in a different context).

2. Obviousness Under 35 U.S.C. § 103

Comcast argues that the Asserted Claims are rendered obvious by Hicks in view of: (1) the knowledge of a POSITA (where Comcast is improperly relying upon non-elected references, *Mtn. to Enforce* at 7-9, 13); (2) Negus; and/or (3) Hylton. The evidence will show that the knowledge of a POSITA cannot be combined with Hicks or Hicks and Negus to meet the Asserted Claims. A POSITA would not have knowledge of entire specifications or standards such as HomeRF or PCI bus and would need the standard itself to implement it with in any other system or with any other reference. The PCI-Bus specification (including the Write command)

would not provide any of the missing limitations from Hicks or Negus. Further, a POSITA would not be able to modify a standard or specification such as HomeRF solely in order to meet the Asserted Claims because that is beyond a POSITA's skill, only something that a standard setting body would do, and because it relies on improper hindsight bias. Dr. Jones and Dr. Williams will testify that (a) the knowledge Comcast alleges a POSITA would have is not actually knowledge a POSITA would have; (b) the alleged knowledge does not fill in the gaps of Hicks; and (c) there is no motivation to combine the alleged knowledge with Hicks.

There is no evidence of a motivation to combine, or a reasonable likelihood of success in combining, any references to achieve a specific limitation of an Asserted Claim. Additionally, Comcast provides nothing other than hindsight bias as the *motivation* to combine references. Comcast's merely conclusory arguments cannot provide clear and convincing evidence of invalidity. *CytoLogix Corp. v. Ventana Med. Sys., Inc.*, 424 F.3d 1168, 1176 (Fed. Cir. 2005) ("Substantial evidence of invalidity must meet certain minimum requirements; '[g]eneral and conclusory testimony . . . does not suffice as substantial evidence of invalidity.'") (omission in original). The evidence will show that a POSITA would not have been motivated to combine Hicks with Negus to multiplex channels in a multimedia system because the relatively slow data rates of Negus would not have been viable for multimedia transmission, especially since Hicks only predates the '855 Patent by five months. For the same reasons, there would be no reasonable likelihood of success in modifying Hicks, modifying Negus, and combining the two modified systems into one system—all to meet the limitations of the Asserted Claims.

Because Negus does not disclose the contents of channel selection requests, Negus does not teach a channel selection request identifying a particular channel and at least one client. *See generally* RX-0040 (Negus). Dr. Jones will testify that Negus does not teach at least the

following limitations: monitoring a shared bus at specific time intervals, identifying a data frame . . . , or decoding the data frame. Dr. Jones and Mr. Williams will testify that, because Negus only teaches using HomeRF's TDMA for isochronous voice devices (e.g., cordless telephones), a POSITA would not combine Hicks and Negus's TDMA teaching for monitoring a shared bus at specific time intervals as part of receiving channel selection commands. There will be no evidence of a claimed data conveyance protocol for either encoding selected channels or decoding a data frame or how it would be used in the Asserted Claims. Nor will there be any evidence of a motivation to combine encryption and encoding in the claimed invention or how Hicks would be modified for encrypting before encoding. There will also not be any evidence of a decompressing module for decompressing each of the channel selection commands. Nothing in Hicks or Negus teaches producing a channel selection command including an identity of a source or a channel, determining whether channel selection requests can be supported, how MPEG could be used as a data conveyance protocol for decoding the channel selection requests that include identification of a channel and a client, or using TDMA or FDMA as the data conveyance protocol for the claimed data frame.

A POSITA would not combine Hicks and Hylton to achieve the claimed inventions because Hylton's disclosure regarding channel selection involves an ONU and a HDT that are not comparable to the BMG of Hicks. *See generally* RX-0036 (Hylton) at 32:64-66, 37:6-27. Hylton does not teach identifying a data frame at a specific time interval that contains at least a portion of a channel selection command. *See* RX-0036 at 37:6-18. Hylton's teaching of decryption is for incoming programs (including MPEG), but not channel selection commands or requests. *See* RX-0036 at 19:1-23. Nor does Hylton teach a decompressing module for decompressing each of the channel selection commands. Nor does Hylton teach how MPEG

could be used as a data conveyance protocol for decoding the channel selection requests and encoding the selected channel or using TDMA/FDMA to convey the claimed data frame.

The evidence, including the testimony of Dr. Jones and Mr. Williams, will show that secondary considerations of non-obviousness support non-obviousness. The inventions of the Asserted Claims of the '855 Patent satisfied of a long-felt unresolved need for a cost-effective multimedia system supporting channel selection over a home network with the invention of the '855 Patent, unlike the commercially unsuccessful HomeRF standard. The '855 Patent's ability to fulfill this need resulted in the commercial success of Rovi's NextGen Platform on Series 6 and Series 7, as well as Rovi's licensee Cox and Comcast's infringing products, all of which are partly attributable to features of the '855 Patent such as efficient multiplexing of multimedia channels using the same data conveyance protocol and using TDMA over coaxial cables. The references identified by Comcast show skepticism and teaching away from the inventions of the '855 Patent because they avoid using TDMA for high-bandwidth applications.

3. Other Alleged Defenses

Comcast bears the burden of proving by clear and convincing evidence that asserted claims of the '855 Patent are invalid. Comcast dropped its § 101 challenge to the '855 Patent claims in correspondence to Rovi on October 24, 2019. Comcast has offered no evidence in support of its argument regarding indefiniteness under § 112 and these issues are addressed in the parties' claim construction briefing. Rovi CC Br. at 66-88; Rovi CC Reply Br. at 52. Comcast has failed to put forward any evidence or argument that the Asserted Claims of the '855 Patent are unenforceable or that the patent term extensions are invalid. Comcast's expert Dr. Chatterjee has provided no opinions or argument supporting any of these theories. Therefore, Comcast has waived any argument regarding these issues.

PUBLIC VERSION

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Respectfully submitted,

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