UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of	
CERTAIN DIGITAL VIDEO RECEIVERS, BROADBAND GATEWAYS, AND RELATED HARDWARE AND SOFTWARE COMPONENTS	**Inv. No. 337-TA-1158**

ORDER NO. 3: PROPOSED SCHEDULING ORDER AND NOTICE OF GROUND RULES

(June 7, 2019)

On May 29, 2019, the Commission instituted this Investigation pursuant to subsection (b) of Section 337 of the Tariff Act of 1930, as amended, to determine:

> whether there is a violation of subsection (a)(1)(B) of section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of products identified in paragraph (2) by reason of infringement of one or more of claims 1-4 and 12-15 of the '564 patent; claims 1-11 and 15-24 of the '445 patent; claims 1-19, 21-29, 31-36, 38-43, 45-53, 55, and 56 of the '871 patent; claims 1-3, 6, 11-18, 20, 23, 24, 26, 27, 29-32, and 34-36 of the '528 patent; claims 1, 3, 4, 8, 10, 11, 17, 19, 23, 25, and 26 of the '900 patent; and claims 1-63 of the '855 patent, and whether an industry in the United States exists as required by subsection (a)(2)of section 337[.][1]

84 Fed. Reg. 24814-15 (May 29, 2019).

The Notice of Investigation ("NOI") names as complainants: Rovi Corporation of San Jose, CA; and Rovi Guides, Inc. of San Jose, CA. *Id.* at 24815. The NOI names as respondents: Comcast Corporation of Philadelphia, PA; Comcast Cable Communications, LLC of

[1] There asserted patents are: U.S. Patent No. 8,001,564 ("the '564 patent"); U.S. Patent No. 7,779,445 ("the '445 patent"); U.S. Patent No. 7,386,871 ("the '871 patent"); U.S. Patent No. 8,156,528 ("the '528 patent"); U.S. Patent No. 7,301,900 ("the '900 patent"); and U.S. Patent No. 7,200,855 ("the '855 patent").

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should be identified. Furthermore, Complainant(s) should identify representative accused articles, if any. The chart should further identify the asserted type(s) of infringement. For example, if there are three asserted claims and five accused articles, a sample chart might appear as follows.

'##1 Patent, claim 5	**'##1 Patent, claim 7**	**'##2 Patent, claim 12**
P Product family: Accused Product AA (7MA config. only) Accused Product BB	P Product family: Accused Product BB	P Product family: n/a
Q Product family: Accused Product CC Accused Product EE	Q Product family: Accused Product DD Accused Product EE	Q Product family: Accused Product CC (T6 config. only) Accused Product DD Accused Product EE
Representative Products: Accused Product BB Accused Product CC	Representative Products: Accused Product BB Accused Product EE	Representative Products: Accused Product CC (T6 config. only) Accused Product EE
Infringement: Literal Direct, induced, contributory	Infringement: Literal Direct, induced, contributory	Infringement: Literal, Doctrine of Equivalents (Accused Product CC, T6 config. only) Direct

Complainant(s) shall be bound by the identification of asserted claims as matched to the accused products in this submission.

Additional Submission, Respondent(s).

In addition to the above, in patent Investigations, Respondent(s) asserting any Section 102 or 103 invalidity defenses shall attach a chart or table to the pre-hearing statement listing all asserted prior art references, or combinations of references, and specifically matching these to each asserted patent claim. For example, if there are four prior art references and five asserted patent claims, a sample chart might appear as follows.

Cheng (§102)	**Davis (§103)**	**Davis, Scott, Maxwell (§103)**	**Davis, Maxwell, Aguilar (§103)**
'##1 Patent, claim 5	'##1 Patent, claim 12	'##1 Patent, claim 12	'##1 Patent, claim 12
'##2 Patent, n/a	'##2 Patent, claims 12, 16, 17	'##2 Patent, claim 17	'##2 Patent, claim 12, 16

If Respondent(s) use a single chart, each entry must clearly state whether Section 102 or 103 is applicable. (*See* above sample.) Respondent(s) may alternatively separate the Section 102 and 103 invalidity defenses into two charts in the same submission.

Respondent(s) shall be bound by the identification of asserted prior art as matched to the asserted patent claims in this submission.

For any 103 invalidity defenses identified in the chart attached to Respondent(s)'s pre-hearing statement that are based on a combination of prior art references, Respondent(s) must specifically identify in its/their invalidity contentions the combinations and provide rationale for each 103 invalidity contention.

7.2. Pre-Hearing Brief.

The parties must meet and confer prior to filing the pre-hearing briefs in order to determine appropriate common locations for each issue. *See, e.g.*, **Appendix B**. For example, in an Investigation involving patent litigation, this conference should, *inter alia*, determine the order of patents to be set forth in the pre-hearing briefing.

On or before the date set in the procedural schedule, each party shall file a pre-hearing brief. Absent prior approval of the Administrative Law Judge, said brief shall consist of no more than one hundred (150) pages and shall have no more than fifty (50) pages of relevant attachments. The parties should not use attachments to bypass the page limits of the pre-hearing brief, but may use them to attach critical charts, figures, or other pertinent material.

The pre-hearing brief shall be prefaced with a table of contents and a table of authorities, which do not count toward the page limits. The brief shall set forth with particularity the authoring party's contentions on each of the proposed issues, including citations to legal authorities in support thereof, and shall conform to the sample outline set forth in **Appendix B** hereto. All issues, including issues not specifically named in the general outline set forth in said appendix that any party seeks to address, shall be added where appropriate. The parties need not use precious space on lengthy introductory arguments.

If claim construction issues have not been resolved in a *Markman* order prior to the hearing, the parties shall provide complete proposed claim constructions for all patent claims at issue, consistent with the claim constructions provided in the joint list of proposed claim constructions for disputed claim terms submitted in accordance with the procedural schedule.

Any contentions not set forth in detail as required herein shall be deemed abandoned or withdrawn,[23] except for contentions of which a party is not aware and could not be aware in the exercise of reasonable diligence at the time of filing the pre-hearing brief. However, the parties are advised to select their best, well-reasoned and persuasive arguments, and abandon extraneous or far-fetched contentions at this time.

7.3. Content of Pre-Hearing Brief

[23] *Certain Automated Media Library Devices*, Inv. No. 337-TA-746, Comm'n Op. at 14-16 (U.S.I.T.C., 2013).

There seems to be confusion about the content of pre-hearing briefs. A pre-hearing brief should never be is a diatribe against the other parties or claims made for which the party knows there is virtually no support. Choose issues carefully. Limit. Focus on the strongest issues for which there is evidence. Additionally, a Pre-Hearing Brief should *not* consist of primarily attorney argument, conclusory statements, or a mere re-recitation of language contained in patent claims or specifications. If you argue a proposition or issue which you know you will not win and there truly is little or no dispute or evidence, concede it and focus where there is at least a colorable argument.

Any contention made, whether for infringement or for validity, and any other issues, should be supported by citations to likely exhibits, deposition testimony, supported by case law. The reasoning and explanations of expert testimony or likely expert testimony should be clear and cite to supporting evidence.

Validity arguments, where there are multiple sources, should be clearly explained. At a minimum, *why* the piece of prior art was chosen should be explained. The technology from which it comes or relates to should be explained. If there are aspects of the prior art that do not apply, be clear about that. Too often parties attempt to hide or obfuscate. It cannot be emphasized enough that conclusory statements, including about anticipation or motivation to combine needs to be explained, with reasoning, or to put it another way, a structured argument is a requirement. If the other party's critique is wrong, explain *why*, with reasoning and evidentiary support.

Block string cites are not appropriate. Similarly, merely attaching Appendices to a pre-hearing brief with block string cites is never appropriate. String cites that have meaning or contain necessary, corroborative evidence from different sources may be appropriate, especially if there are multiple evidentiary sources for a contention, proposition, illustrative point or argument. Charts are fine if, in fact, the individual elements are supported, again, by *evidence. Include the citations to evidence.*

All of the above applies to expert reports.

7.4. Joint Outline of Issues in Chart Form.

The parties must jointly create and maintain a single chart of substantive legal issues being litigated in the Investigation. The chart shall be jointly filed as a separate docket entry simultaneously with the pre-hearing and the post-hearing briefs. The parties' pre-hearing and initial post-hearing briefs will follow the order of the issues set forth in the chart. The leftmost column of the chart will list the issues being litigated, including all infringement and invalidity theories and defenses. The parties will create subsequent columns for each of their briefs, grouped by party (i.e., the chart accompanying the post-hearing reply briefs will include columns for Complainant(s)'s pre-hearing brief, initial post-hearing brief, and post-hearing reply brief, followed by columns for Respondent(s)'s pre-hearing brief, initial post-hearing brief, and post-hearing reply brief). The cells of the columns will contain page numbers of the particular sections of the briefs where those issues are addressed.

If issues, contentions, arguments, or defenses have dropped out from the pre-hearing briefs,