

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner

v.

ROVI GUIDES, INC.
Patent Owner

Patent No. 7,200,855

Filing Date: May 24, 2001

Issue Date: April 3, 2007

Title: METHOD AND APPARATUS OF MULTIPLEXING A PLURALITY OF
CHANNELS IN A MULTIMEDIA SYSTEM

Inter Partes Review Nos.: IPR2020-00787, IPR2020-00788, IPR2020-00789

**PETITIONER'S RANKING OF PETITIONS AND EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

Pursuant to the July 2019 update to the America Invents Act (AIA) Trial Practice Guide published by the USPTO, Petitioner submits this notice of its ranking of its petitions for *inter partes* review of U.S. Patent No. 7,200,855 filed in IPR2020-00787, IPR2020-00788, and IPR2020-00789, and an explanation of the material differences between the petitions. See “TRIAL PRACTICE GUIDE UPDATE (July 2019)” at 26-28.

Ordering of Petitions. Petitioner believes that its petitions are all meritorious and justified in light of the positions Patent Owner may take. At this stage, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Reference
A	IPR2020-00787 (Petition 1 of 3)	Hicks (Ex. 1005)
B	IPR2020-00788 (Petition 2 of 3)	Rakib (Ex. 1105)
C	IPR2020-00789 (Petition 3 of 3)	Bigham (Ex. 1208)

Below are some of the material differences between the petitions:

(1) ***Differences between prior art in petitions:*** The prior art combinations of the three petitions teach the’855 Patent claims, but in different ways. For example:

a) *In general:* The three petitions disclose different systems for multiplexing a plurality of channels in a multimedia system. The obviousness grounds across the petitions also provide different motivations to combine different references.

- In Petition 1, Hicks teaches a Broadband Multimedia Gateway that receives audio/video channels from sources (cable TV, satellite dish, DVD), and multiplexes the channels over a network to a plurality of set-top boxes using different protocols and media. PCI (Ex. 1006) is combined for teaching an implementation of Hicks's shared data bus that communicates data in frames.
- In Petition 2, Rakib discloses a gateway that delivers requested channels to client devices, and uses a Firewire bus to process channel requests and deliver content. Anderson (Ex. 1107) is combined for teaching details of Firewire. Crosby (Ex. 1106) teaches a conventional satellite receiver for use in Rakib's gateway.
- In Petition 3, Bigham (Ex. 1208) distributes multiplexed broadcast programming to a plurality of users using an Asynchronous Transfer Mode communication network. Blahut (Ex. 1209) is combined for its shared bus communication protocol (Time Division Multiplexing) where a plurality of user channel selections from different end devices are transmitted as individual bursts, assigned to a respective time slot, within a multiplexed frame.

b) *Monitoring shared bus at specific time intervals*: The independent claims all recite variations of "monitoring a shared bus at specific time intervals, identifying [a data frame/packet] ... to recapture ... [the channel selection command/request]." The three petitions treat these variations in different ways because they each rely on prior art using different bus protocols.

- Petition 1 relies on time intervals delineated by PCI bus clock and frame signals and cites PCI frames and IP packets for the claimed frames and packets.
- Petition 2 relies on time intervals derived (without a clock) from Firewire (IEEE 1394) bus data and strobe signals and cites Ethernet frames and IP packets for the claimed frames and packets.
- Petition 3 relies on ATM network time intervals synchronized to downstream transmission of frames (*e.g.*, an upstream frame is received two frame periods after a downstream frame is transmitted) and cites ATM upstream frames and bursts for the claimed frames and packets.

c) *Channel selection command/request types*: Claims 1, 19, 38, and 54, recite that each channel selection command is one of several types, such as a “last,” “next,” “previous,” or “favorite” channel selection command, or a “selection from a user-defined list.” For this limitation, Petition 1 relies on Hicks and/or Usui (Ex. 1012/1212), Petition 2 relies on Crosby (Ex. 1106), and Petition 3 relies on Usui.

The prior art relied upon in the three respective petitions, therefore, is not cumulative or substantially similar. Even if Patent Owner argues that some aspects of the prior art are similar, “it is axiomatic that references used to examine the patentability of and the references presented in a Petition challenging the same patent will have some similarities.” IPR2019-00239, Paper 15 at 11.

(2) ***Differences from art applied by examiner during prosecution:*** The examiner applied a combination of U.S. Patent No. 6,493,873 to Williams and U.S. Publication No. 2004/0172658 (“Rakib ’658”) during examination. Rakib (Ex. 1105), asserted in Petition 2, is a continuation-in-part of Rakib ’658’s parent. The applicant argued that the particular configuration in Rakib ’658 asserted by the examiner did not monitor packets on a shared bus to identify a packet containing at least a portion of a channel selection command. In Petition 2, a different configuration (with different shared bus) in Rakib is relied on, and Anderson is added to provide details of how that configuration in Rakib monitors the shared bus.

(4) ***New prior art:*** All prior art references (primary and secondary) relied upon in Petitions 1 and 3 were never cited or considered during prosecution. Petition 2 also relies only on references that were not cited or considered during prosecution, however Rakib is a continuation-in-part of Rakib ’658’s parent that the examiner asserted during prosecution.

(3) ***Priority date:*** Each of the Petitions 1-3 rely on at least one base reference (Hicks in Petition 1; Rakib in Petition 2; Blahut in Petition 3) that qualifies as prior art under at least one of §§ 102(a) or 102(e), meaning that Patent Owner could attempt to antedate them. Moreover, Petitions 1 and 2 rely on non-patent literature documents (PCI and Anderson), which Patent Owner could try to disqualify as prior art.

A summary of differences between the petitions is provided below.

Pet.	Primary Ref(s)	Prior Art Basis	Earliest Date	Diligence Required to Antedate	Cited/Applied In Prosecution
1	Hicks	§ 102(e)	2000-12-28	About 5 months	Not Cited
	PCI	§ 102(a)	2001-04-17	Under 1 month	Not Cited
		§ 102(b)	1999-02	NA	
		§ 102(e)	1999-08-10	Over 21 months	
2	Rakib	§ 102(e)	2000-06-23	About 11 months	Not Cited (but related to applied reference)
	Anderson	§ 102(b)	1999	NA	Not Cited
3	Bigham	§ 102(b)	1997-10-14	NA	Not Cited
	Blahut	§ 102(e)	2000-02-29	Over 14 months	Not Cited

In view of the material differences shown above, the Board should consider all three petitions and not exercise its discretion to deny institution in an IPR potentially impacting recording systems used by millions of consumers.

Dated: April 22, 2020

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of the **PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS** to be served via FedEx Priority Overnight on April 22, 2020, on the following:

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An electronic courtesy copy is concurrently being e-mailed to the following:

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