

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

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Comcast Respondents' Notice of Withdrawal of Invalidity Arguments, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Jan. 27, 2020).
2002	Complaint for Patent Infringement, <i>Rovi Guides, Inc. v. Comcast Corporation et al</i> , 2:19-cv-03096 (C.D.C.A.), Docket. No. 1 (excerpt).
2003	Order on Joint Stipulation to Stay Proceedings Pursuant to 28 U.S.C. § 1659(A), <i>Rovi Guides, Inc. v. Comcast Corporation et al</i> , 2:19-cv-03096 (C.D.C.A.), Docket. No. 57.
2004	Notice of Insitution of Investigation, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (May 23, 2019).
2005	Non-Confidential Excerpt of Order Construing Certain Terms of the Asserted Claims of The Patents at Issue (<i>Markman</i> claim construction), <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Jul. 14, 2020).
2006	Non-Confidential Excerpt of Expert Report of Sandeep Chatterjee, Ph.D. Regarding The Invalidity of U.S. Patent No. 7,200,855, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Sept. 17, 2019).
2007	Non-Confidential Expert Report of Dr. Mark T. Jones Concerning Validity of U.S. Patent No. 7,200,855, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Oct. 7, 2019).

Exhibit No.	Description
2008	Non-Confidential Excerpt of Comcast Respondents' Prehearing Brief, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Oct. 31, 2019).
2009	Non-Confidential Excerpt of Complainants' Pre-Hearing Brief, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Oct. 30, 2019).
2010	ITC Trial Transcript Day 1 <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Jan. 27, 2020) (excerpt).
2011	Comcast Respondents' Notice of Prior Art, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Jul. 26, 2019) (excerpt).
2012	Comcast Respondents' Submission Pursuant to Order No. 12, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Sept. 24, 2019).
2013	Non-Confidential Excerpt of Initial Determination on Violation of Section 337 and Recommended Determination of Remedy and Bond, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (July 28, 2020).
2014	Proof of Service, Complaint for Patent Infringement, Rovi Guides, Inc. v. Comcast Corporation et al, 2:19-cv-03096 (C.D.C.A.), Docket. No. 44.
2015	ITC Trial Transcript Day 5 <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Jan. 27, 2020) (excerpt).

Exhibit No.	Description
2016	ITC Ground Rules, <i>In re Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components</i> , Investigation No. 337-TA-1158 (Jun. 7, 2019) (excerpt).

I. INTRODUCTION

As it has done with so many of Patent Owner Rovi Guides, Inc’s (“Rovi”) patents, Comcast filed three petitions for *inter partes* review of Rovi’s United States Patent No. 7,200,855 (“the ’855 patent”). The ’855 patent is directed to multiplexing a plurality of channels within a multimedia system by monitoring a shared bus—a technology that is different from the other patents previously challenged by Comcast before the Board.¹ The ’855 patent also has a procedural posture that is unlike any of the other challenged Rovi patents. During the co-pending ITC investigation, Rovi asserted the ’855 patent against Comcast and Comcast challenged its validity. But Comcast *voluntarily withdrew* its invalidity challenge of the ’855 patent literally *in the middle of trial*. The parties had spent months developing their positions on Comcast’s arguments—which included each of the primary references that Comcast uses in the ’855 patent Petitions (“’855 Petitions”). Discovery had been exchanged. Expert reports had been served. Depositions were complete. As trial approached, Comcast had given up on nearly

¹ The ’855 patent is unrelated to any of Rovi’s patents previously challenged by Comcast, and is the only patent classified in class 725/082 (local video distribution system with multiple units or room structures having a local server or headend) across all IPR proceedings that Comcast has filed to date. Accordingly, the ’855 Petitions can be assigned to any panel to efficiently determine whether to institute.

all of its prior art references. The only invalidity challenge that remained was based on the Hicks reference—the same Hicks in Comcast’s top-ranked ’855 patent Petition. All that was left was for Comcast to formally put what remained of its invalidity case before the ALJ, Rovi to put on its rebuttal, and the ITC to render a decision. But the night before it was scheduled to present its invalidity case, Comcast suddenly dropped its entire invalidity challenge to the ’855 patent and proceeded only on noninfringement.

The only reason Comcast gave for pulling its invalidity case at the last minute was that it was “[i]n the interests of efficiency” for the ITC investigation. *See* EX2001, 1. In reality, by that point, Rovi had presented Comcast with its counter-arguments, and Comcast knew its invalidity positions were untenable. Given its recent history at the PTAB of having at least one petition instituted when filing multiple petitions, and with the knowledge and benefit of having learned Rovi’s validity positions, Comcast believed the PTAB to be a forum for getting a do-over. Indeed, Comcast’s decision to pull the plug on its invalidity challenge of the ’855 patent at the ITC came just *four days* after the Board first rejected Rovi’s argument that Comcast should not—as a matter of right—be granted institution on at least one petition for each challenged patent. *Compare* EX2001, 1 (Jan. 27, 2020) *with Comcast Cable Commc’ns. v. Rovi Guides, Inc.*, IPR2019-01431, Paper 10, 47-48 (P.T.A.B. Jan. 23, 2020). Waiting three months until just days before its

statutory deadline, Comcast then filed these Petitions with the knowledge of Rovi's ITC positions, attempting to fill the holes in its invalidity arguments that Rovi had identified. *See* EX2014, 2 (proof of service delivered on April 25, 2019).

Comcast's actions in the ITC and these subsequent IPR challenges are exactly the type of gamesmanship the Board should preclude. Comcast's latest tactics, if allowed to succeed, would establish a significant loophole in the Board's 314(a) jurisprudence concerning co-pending litigation. In the Trial Practice Guide and in *Fintiv*, *NHK Spring*, and similar decisions, the Board has stressed the importance of efficiency, fairness, and integrity of the patent system in evaluating whether to exercise discretion to deny institution of petitions under 314(a) in view of similar challenges made in another forum. *See, e.g., NHK Spring Co., Ltd. v. Intri-plex Techs., Inc.*, IPR2018-00752, Paper 8, 18-19 (P.T.A.B. Sept. 12, 2018); *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 5 (P.T.A.B. Mar. 20, 2020). The Board has stressed that it would be inefficient to proceed with an AIA trial where another forum will consider the same issues on a faster timeline and that it would be unfair to the patent owner for the petitioner to use another forum to learn a patent owner's positions. *See Fintiv*, IPR2020-00019, Paper 11, 11-12 (petitioner failing to file its petition until after patent owner responds to petitioner's invalidity contentions is a factor favoring denial). What Comcast did here is even more inefficient and a greater abuse of the system—and Rovi. This set of facts

represents exactly the inefficiency, unfairness, and abuse to patent owners and the patent system that section 314 should be applied to prevent. Given these circumstances, if the Board's use of the words "fairness," "efficiency," and "integrity" is to have any meaning, these three '855 Petitions cannot be instituted.

But even ignoring the inefficiency, unfairness, and attack on the integrity of the patent system that Comcast's gambit presents, there are other bases—applying commonly to all three '855 Petitions—that warrant denial of institution. For example, all three '855 Petitions fail to construe the claims properly, instead alleging that the Petition covers the claims under any of multiple claim constructions, violating 37 C.F.R. § 42.104(b)(3). And each of the three '855 Petitions fails on its individual merits as well. Sections I, II (except part of section II.B.2 discussing a Petition-specific example), and IV below are identical across Rovi's Patent Owner's Preliminary Responses ("POPRs") for each of the '855 Petitions, and set forth the common bases for denial of institution of all three '855 Petitions. Section III sets forth the individual bases for denial of each Petition.

Comcast's past experience of unfailingly getting at least one Petition instituted for each challenged patent has led it to act with increasing impunity, culminating with these '855 Petitions in which Comcast disregards the Board's rules and precedent. Comcast's '855 Petitions treat the Board as a pig hunting for truffles for claim construction, ignore section 325(d), disregard the rule against

incorporation by reference, and neglect motivation to combine, among other defects. None of these '855 Petitions pass the Board's standards for institution, and the Board should decline to institute even one.

II. THE BOARD'S RULES AND PRECEDENT WARRANT BOTH DISCRETIONARY AND MANDATORY DENIAL OF ALL THREE '855 PETITIONS.

A. The Petition should be denied because Comcast gained an unfair tactical advantage by withdrawing its invalidity defense in the middle of the ITC trial.

In its precedential decision *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, the Board highlighted the goal of *inter partes* review as providing a quick and cost-effective alternative to litigation and also “recognize[d] the potential for abuse of the review process by repeated attacks on patents.” *Id.*, IPR2016-01357, Paper 19, 16-17 (P.T.A.B. Sept. 6, 2017). In the last round of Rovi's POPRs, in its response to Comcast's previous 24 petitions, Rovi flagged for the Board that its prior decisions, declining to deny institution as doing so “would deny Petitioner even one Petition” would signal to Comcast that it could guarantee institution of at least one petition by filing many redundant petitions. *Comcast Cable Commc'ns v. Rovi Guides, Inc.*, IPR2019-01431, Paper 9, 45-47 (P.T.A.B. Nov. 15, 2019) (quoting *Comcast Cable Commc'ns v. Rovi Guides, Inc.*, IPR2019-00299, Paper 13 (P.T.A.B. Jul. 1, 2019)). The Board ignored Rovi's concerns, and continued to institute at least one petition for each patent Comcast challenged. *Id.*, Paper 10

(P.T.A.B. Jan. 23, 2020) (instituting top-ranked petition against Rovi's '019 patent). Indeed, in other decisions addressing Rovi's argument, the Board continued to determine that "the circumstances in this case do not warrant denying the instant Petition, because that would deny Petitioner even one petition." IPR2019-01353, Paper 10, 8 (P.T.A.B. Jan. 27, 2020). The Board issued the first of its institution decisions casting aside Rovi's forewarning on January 23, 2020. *Comcast Cable Commc'ns v. Rovi Guides, Inc.*, IPR2019-01431, Paper 10, 5-6 (P.T.A.B. Jan. 23, 2020).

Having learned as of January 23, 2020 that the Board would continue to decline to deny institution when doing so would deny Comcast even one petition, Comcast four days later voluntarily jettisoned what remained of its invalidity challenge of the '855 patent at the ITC. Then, three months later, and with full knowledge of Rovi's validity defense, Comcast sought a second bite at the apple through these IPR proceedings.

And why would it not it? Not only has Comcast been guaranteed one institution, but that guarantee has been extended to invalidity of almost every claim across almost every patent. As Rovi (a TiVo company) told the Supreme Court in its recently filed amicus briefs:

TiVo's experience presents a particularly stark example of the power that administrative patent judges wield. TiVo's patents

have been the subject of well over one hundred inter partes review petitions. Those petitions have led to Board decisions finding claims from over 18 TiVo patents unpatentable. In total, only about 5% of the challenged claims have survived. Many of these claims had been previously upheld against validity challenges by the International Trade Commission... TiVo thus has a peculiarly strong interest in ensuring that APJs exercise their considerable authority within statutory and constitutional bounds.

Brief *Amicus Curiae* of TiVo Corporation Supporting Petitioner, 15, *Polaris Innovations Ltd. v. Kingston Tech. Co., Inc.*, No. 19-1459 (U.S. Aug. 5, 2020).

Taking advantage of this forum shopping, and demonstrating why Congress “recognize[d] the potential for abuse of the review process by repeated attacks on patents,” Comcast even reused as its primary references Hicks (-00787 Petition), Rakib (-00788 Petition), and Bigham (-00789 Petition)—all prior art that it had raised during the ITC Investigation. Comcast’s interpretation of the Board’s decisions is clear: Comcast believes the Board would give them a second bite at the invalidity apple no matter the unfairness it may present to Rovi.

The July 2019 update to the Board’s Trial Practice Guide² (TPG) provides considerable guidance regarding the Board’s discretion to deny institution under 35 U.S.C. § 314(a). In providing guidance, the TPG stresses the principles of fairness, efficiency, and integrity of the patent system. TPG, 56. These principles are discussed at length in portions of the TPG addressing the Board’s discretion to petitions in the context of co-pending litigation. *Id.* at 22-26. If these principles—fairness, efficiency, and integrity—do indeed inform whether the Board should exercise its discretion under Section 314, all three ’855 Petitions should be denied to make it clear to Comcast and others of its ilk that abuse of the IPR process will not be tolerated.

1. Comcast and Rovi litigated the validity of the ’855 patent during the Co-Pending ITC Proceedings.

On April 22, 2019, Rovi filed a district court complaint against Comcast on the ’855 patent. *See* EX2002. Rovi then filed a petition to initiate an ITC investigation on April 26, 2019, which later instituted on May 22, 2019.³ *See*

² All references to the Consolidated Trial Practice Guide (“TPG”) refer to the Consolidated Trial Practice Guide (Nov. 2019).

³ The district court stayed its case pending final determination in the ITC investigation. *See* EX2003.

EX2004, 8. Rovi and Comcast then litigated the '855 patent at the ITC for nearly nine months.

On July 26, 2019, Comcast identified Hicks, Rakib, and Bigham to Rovi as part of the ITC investigations. EX2011, 8 (Hicks), 11 (Rakib), 5 (Bigham). After nearly two-months of discovery and analysis of the '855 patent, Comcast elected to proceed with the Hicks reference. EX2012, 1. The parties proceeded through claim construction in the middle of October, where the ITC later adopted most of Rovi's constructions for the '855 patent, *see* EX2005, 5-19 (determined July 14, 2020), and expert discovery. As part of discovery, Rovi provided its counterarguments to invalidity in response to an interrogatory—addressing the missing limitations in each of Hicks, Rakib, and Bigham. For the first time in the ITC litigation, Comcast raised in its opening expert report the same Hicks-PCI bus combination featured in its top-ranked -00787 Petition. EX2006, ¶230. Ultimately, the parties devoted significant attention to respective prehearing briefs addressing validity issues related to the '855 patent. EX2008, 2-11 (arguing invalidity of the '855 patent as anticipated by Hicks or rendered obvious by Hicks and HomeRF); EX2009, 70-75 (presenting its counterarguments to Comcast's invalidity arguments of the '855 patent).

The ITC trial began on January 21, 2020—three months after the filing of the pretrial briefing. *See* EX2010, 1. However, on the fifth trial day—the day

Comcast was to begin its presentation of evidence—Comcast suddenly jettisoned its entire '855 patent invalidity case. EX2015, 3:8-20. Notably, this surprise announcement came just four days after Comcast received the Board's first institution decision rejecting Rovi's argument that the Board's prior decisions to institute at least one petition in each set Comcast filed against a particular patent would lead to increased abuse. *Comcast Cable Commc'ns v. Rovi Guides, Inc.*, IPR2019-01431, Paper 10, 5-6 (P.T.A.B. Jan. 23, 2020).

On the morning it was to begin presenting evidence on the invalidity of the '855 patent, Comcast's attorneys stated:

Your Honor, as we begin the presentation of evidence, for the '855 patent, [Comcast] . . . just want[ed] to advise the Court that once we were able to assess the state of the record over the weekend, Comcast has decided not to proceed with invalidity as to the '855 patent . . . Just for the record, Your Honor, if I may state, Comcast, of course, continues to contend that the patent is invalid and is making this decision based on the current state of the record without any prejudice to any other proceedings.

EX2015, 3:2-20.

The invalidity challenge Comcast was set to present beginning that morning centered on the Hicks reference, the very reference Comcast uses as its primary

reference in its top-ranked Petition. EX2012, 1-2 (listing Hicks to remain in the ITC investigation).

2. The principles of fairness, efficiency, and integrity that undergird the Board's parallel litigation jurisprudence still apply and should not be undermined by Comcast's gamesmanship.

In its precedential decision, *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (Precedential), the Board set forth six factors that it should weigh to determine whether efficiency, fairness, and the merits support the exercise of discretionary denial based on a parallel proceeding, including proceedings at the ITC:

- (1) whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
- (2) proximity of the court's trial date to the Board's projected statutory deadline for the final written decision;
- (3) investment in the parallel proceeding by the court and the parties;
- (4) overlap between issues raised in the petition and in the parallel proceeding;
- (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and

(6) other circumstances that impact the Board's exercise of discretion, including the merits.

Id. at 5-6. Rovi will address these factors together with how institution would disturb administrative efficiency and prejudice Rovi.

Here, Rovi has sued Comcast at the ITC (factor 5: same parties), and the ITC has issued an initial determination, so the proceedings are too far along for a stay (factor 1: existence or likelihood of a stay). *See* EX2013. The evidentiary hearing for the ITC investigation involving the infringement of the '855 patent was completed on January 28, 2020, and an initial determination finding that Comcast's accused products infringe the asserted claims of the '855 patent issued on July 28, 2020, well over a year before final written decisions for these '855 Petitions would be due. *Id.*, 40-42 (factor 2: proximity of trial and final written decision). During the investigation, the parties exchanged invalidity contentions, validity contentions, infringement contentions, non-infringement contentions, expert reports, and prehearing briefs while litigating these same validity issues for over nine months. *See generally* EX2006; EX2007; EX2008, 2-12; EX2009, 70-75; EX2011, 8 (Hicks), 11 (Rakib), 5 (Bigham) (factor 3: investment). And Comcast put forward the same prior art references (Hicks, Rakib, and Bigham) at the ITC that it now asserts as primary references in the three '855 Petitions. EX2011, 8 (Hicks), 11 (Rakib), 5 (Bigham) (factor 4: overlap). Calling the ITC case co-pending is

underscoring Comcast's gamesmanship—the plain fact is that, absent Comcast's own decision to drop its entire validity case at the ITC, there would already be a final decision on the validity of the '855 patent's asserted claims.

To the extent Comcast identifies the difference in claim sets at issue in each forum as a reason that the subject matter is not overlapping (in the ITC, the validity of only claims 53, 59, 60, and 63 were at issue, whereas here Comcast seeks to challenge all 63 claims), the Board should dismiss such arguments. Under *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), if the Board finds a reasonable likelihood that a substantial number of claims and/or grounds might be unpatentable, it is required to institute review on all the challenged claims in the challenged patent and not just the likely unpatentable claims. *See Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (Nov. 7, 2018) (informative) (post *SAS* decision denying institution because an insufficient number of proposed grounds/challenges to claims meet reasonable likelihood standard); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (Jan. 24, 2019) (informative) (post *SAS* decision denying institution because an insufficient number of proposed grounds/challenges to claims meet reasonable likelihood standard). By contrast, there is almost always less than all claims in a patent at issue in parallel district court or ITC parallel because the patent owner typically must reduce the number of claims that the Court ultimately adjudicates. EX2016, 3

(limiting prehearing brief which addresses all issues to be tried, including importation, unresolved claim construction issues, infringement, invalidity, domestic industry economic and technical, and remedy and bonding to 150 pages and 50 pages of attachments). In any event, even though different claim sets are involved, as discussed *infra* Comcast's references lack limitations common to all 63 claims of the patent. Thus, even though different claim sets are at issue between the ITC and here, *the same issues of missing limitations have already been litigated at the ITC*. Under these differing standards regarding the number and scope of claims under review, if the Board gives undue weight to the difference between the claim sets without considering the subject matter and limitations at issue, the Board would waste its resources.

Accordingly, *Fintiv* factors 1-5 advocate for denying institution. And the fact that Comcast pulled its validity challenge at the last minute such that the ITC will not actually be providing a ruling on the validity of the '855 patent should not change this outcome because that is a circumstance of Comcast's own making. Ignoring Comcast's gamesmanship in this regard and instituting on any one of the '855 Petitions would violate the principles of efficiency outlined in *Fintiv* (factor 6: other circumstances). By waiting to file its '855 Petitions until after the development of the full record before the ITC, Comcast seeks to gain a tactical advantage—namely, using Rovi's fully developed ITC rebuttal as a roadmap to re-

litigate the same issues before the Board. And by withdrawing its challenge on the eve of presenting its ITC case, Comcast seeks to rob both Rovi and the Board of the efficiencies that could be gained by deferring to a parallel action in an advanced stage of litigation. This is unfairly prejudicial to Rovi and a clear abuse of the patent system as a whole. Comcast's tactic of pulling its challenge should not be a loophole to the Board's Section 314 jurisprudence. Rather, *Fintiv* factor 6 gives the Board latitude to hold Comcast accountable for its own decision to drop its invalidity challenge at the ITC. The Board should use its discretionary authority under 35 U.S.C. § 314(a) to deny Comcast's petition. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also SAS*, 138 S. Ct. at 1356 ("314(a) invests the Director with discretion on the question whether to institute review").

B. Failure to satisfy 37 C.F.R. § 42.104(b): Mandatory denial is required because Comcast fails to state what it contends are the correct claim constructions.

All three '855 Petitions must be denied under 37 C.F.R. § 42.104(b) for two reasons: first, they fail to provide a claim construction, instead just noting that there were multiple terms in dispute in the co-pending ITC investigation, with various competing and adopted constructions. Second, the '855 Petitions claim to apply all of these multiple claim constructions, but do not.

1. The '855 Petitions allude to multiple disputed claim terms and claim constructions in the co-pending ITC investigation, but do not present them or choose one.

A petition must identify “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). The '855 Petitions make no such identification. Instead, each Petition merely mentions in two sentences that the parties “in the ITC Investigation provided claim constructions (and the Administrative Law Judge (ALJ) adopted claim constructions) for certain [claim] terms.” Pet., 13 (string citing various exhibits to the Petition that, allegedly, detail the different disputed terms, constructions, and evidence in support). Then, without so much as a table describing what those different constructions are, the Petition states: “This Petition applies all of the constructions adopted by the ALJ and proposed by both parties as alternatives in the analysis below,” with a citation⁴ to declarant’s Declaration. *Id.*

⁴ To the extent this citation is intended to incorporate the declarant’s Declaration’s text and table into the Petition by reference, it is improper. 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”). “A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.” *Ariosa Diagnostics v. Verinata Health, Inc.*, IPR2013-00276, Paper 43, 16-17 (P.T.A.B. Oct. 23, 2014), citing *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999). As discussed in the next section, Comcast’s extensive incorporation by reference throughout the

Presumably, it is left to the Board to:

1. sift through the cited exhibits and declarant's Declaration to determine which constructions were proposed and adopted in the ITC investigations,
2. determine which construction should be adopted for this proceeding based on its own review of the intrinsic and extrinsic evidence, and
3. verify whether the Petition does indeed "appl[y] all of the constructions," including the construction the Board selects.

For its part, Comcast takes no position on which of the various claim constructions in the cited exhibits is the correct one, and Comcast does not cite any intrinsic or extrinsic evidence supporting any construction, again leaving this task to the Board and frustrating the purpose of Rule 104(b)(3).⁵ Even the cited

Petition represents a separate violation of Board rules and provides an independent reason the Board should deny the '855 Petitions. 37 C.F.R. § 42.6(a)(3).

⁵ The Trial Practice Guide notes that prior claim constructions from a district court or the ITC will be "considered" by the Board, if timely made of record. The Board conducts a multi-factor analysis to determine the proper weight to give claim constructions adopted by other tribunals. But nowhere does the practice guide say that a string citation to exhibits containing claim construction positions from a co-

declarant testimony in paragraph 40 of declarant’s Declaration takes no position on claim construction. *See* EX1002, ¶¶39-46. Comcast’s declarant merely states that “[i]n forming the opinions expressed in this Declaration I have initially applied Petitioner’s construction in my discussion of a term, as well as an alternative, where appropriate, applying Patent Owner’s proposed construction for that term,” and provides a table spanning seven pages of multiple claim terms and competing and adopted constructions. *Id.*, ¶40. There is no indication of which claim constructions the declarant believes the Board should adopt or what support the declarant believes exists for those constructions.

It is Petitioner’s burden to distinctly present its challenges, and not the Board’s or Patent Owner’s responsibility to parse through the Petitions (and both cited and uncited exhibits) and guess at what Petitioner meant to allege. *Tasco, Inc. v. Pagnani*, IPR2013-00103, Paper 6, 11 (P.T.A.B. May 23, 2013); *Google Inc. v. EveryMD.COM LLC*, IPR2014-00347, Paper 9, 17-24 (P.T.A.B. May 22, 2014). While it is not necessary for a petitioner to aver its “subjective belief” in the

pending litigation, devoid of discussion or support, is a substitute for 37 C.F.R. § 42.104(b)(3)’s requirement that the Petition identify how the claim is to be construed. It is not. The Petition does not even address the factors that the Board should consider in determining whether to give any weight to the ITC proceedings.

correctness of a construction, nor is it forbidden to present alternative positions for unpatentability, a petitioner must nonetheless identify the constructions that it proposes as the basis for requesting *inter partes* review and explain what support there is for those constructions. *Apple, Inc. v. AGIS Software Development LLC*, IPR2018-00818, Paper 9, 8-9 (P.T.A.B. Oct. 3, 2018); *Toyota Motor Corp. v. Blitzsafe Texas, LLC*, IPR2016-00422, Paper 12, 26-27 (P.T.A.B. July 6, 2016). Otherwise, nothing in the petition gives the Board any basis to choose one construction over the other for purposes of its decision.

The Petitions here leave the Board completely in the dark about how to proceed with the claim construction analysis—and prejudices Rovi. As with the Board’s Section 314 jurisprudence discussed above, principles of fairness, efficiency, and integrity undergird the Board’s claim construction rules. *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003, Paper 8, 9-11 (P.T.A.B. Oct. 25, 2012) (“It would be unfair to expect the Patent Owner to conjure up arguments against its own patent and just as inappropriate for the Board to take the side of the Petitioner to salvage an inadequately expressed ground proposing an alternative rationale.”) Comcast’s strategy thus fails to satisfy the requirements of 37 C.F.R. §§ 42.104(b)(3)-(4) and the Petitions should be denied.

2. The '855 Petitions falsely assert that they apply all of the competing constructions for each claim term disputed in the ITC.

Highlighting the problem with Comcast's deficient approach to claim construction, Comcast falsely states that "[t]his Petition applies all of the constructions" proposed and adopted for each disputed claim term at the ITC. Pet., 13. These '855 Petitions, however, make no effort to apply these various different constructions. Indeed, the table in paragraph 40 of the declarant's Declaration recounts some 8 disputed claim terms and a total of 19 various constructions from the ITC investigation. EX1002, ¶40. But the analysis in the '855 Petitions does not apply all 19 different constructions. Thus, Comcast's statement that "[t]his Petition applies all of the constructions" is plainly not true.

By way of example, in the ITC the parties disputed the phrase "identify[ing] a data [frame / packet] at one of the specific time intervals that contains at least a portion of one of the plurality of channel selection [commands/requests]," which is recited in all independent claims, using their respective language. EX1023, 7.

The competing and adopted constructions were as follows (EX1023, 7;

EX1021, 62:12-19; *see also* EX2005, 13-14):

Patent Owner’s Proposed Construction	Petitioner’s Proposed Construction	ALJ Adopted Construction
<p>determin[e/ing] that a data [frame / packet] at one of the specific time intervals contains at least a portion of one of the plurality of channel selection [commands/requests]</p>	<p>determining, without decoding a frame based on a data conveyance protocol of the multimedia system to recapture its contents, that the frame contains at least a portion of a channel selection [command/request]</p>	<p>Determining {E/ING}, that a data {frame/packet} at one of the specific time intervals contains at least a portion of one of the plurality of channel selection {commands/requests} without recapturing be [sic] at least a portion of one of the plurality of channel selection {commands/requests} via decoding</p>

Comcast provides no analysis and no explanation as to why the combination of Hicks and PCI discloses the above-noted claim feature under Comcast’s proposed construction in the ITC proceeding. Comcast merely states that “[p]rocessor 130 and signal processing circuit 120 would use the address and other control signals (at clock edge #2 in the figure above) to determine it was the target device and the type of transaction before decoding the data (Data-1, Data-2, etc. in Figure 3-6 above) to recapture a channel selection command.” Pet., 26. Then, Comcast concludes, “thus meeting the proposed ITC claim constructions, and that

adopted by the ALJ, of the ‘identifying’ step. Ex. 1002, ¶¶ 207-209; Ex. 1021 at 62:3-63:10; Ex. 1023 at 7.” *Id.*

Comcast’s conclusory statement is presented without any consideration of the differences between “the proposed ITC claim constructions, and that adopted by the ALJ.” For example, Comcast does not explain why Hick’s “[p]rocessor 130 and signal processing circuit 120 ...[using] the address and other control signals” of PCI discloses Comcast’s own proposed construction in the ITC proceeding, which requires “determining, **without decoding a frame** based on a data conveyance protocol of the multimedia system to recapture its contents, that the frame contains at least a portion of a channel selection [command/request].”⁶ Comcast’s failure to show how the references allegedly teach or suggest the above-noted claimed feature under Comcast’s three alternative constructions is fatal to its burden of proving unpatentability of claims 1–63.

Accordingly, to rescue Comcast from the requirements of 37 C.F.R. § 42.104(b), not only must the Board conduct its own *sua sponte* claim construction analysis because Comcast has failed to do so, but it must also apply the prior art to all 19 proposed and adopted constructions because Comcast, again, has failed to do so. The Board should decline to do so and deny institution of all three ’855 Petitions.

⁶ All emphasis added unless otherwise stated.

III. ADDITIONAL BASES FOR DENIAL OF THIS SPECIFIC PETITION

In addition to the bases for denial of all three '855 Petitions, there are further bases for denying institution that apply to this Petition individually.

A. Technical background and summary of the '855 patent.

The '855 patent is directed to a method and apparatus for multiplexing a plurality of channels within a multimedia system. EX1001, '855 patent, Abstract. The '855 patent is entitled to an earliest priority date of May 24, 2001, and covers fundamental aspects of a modern in-home communication system that receives TV channels, makes them available for selection by client devices, and transmits the selected channels to the client devices after multiplexing. *Id.*, Abstract, 1:7-9. The inventor of the '855 patent developed these novel methods and apparatus while faced with the unavailability of entertainment-data transmission multiplexers, and the high cost of implementing a conventional in-home communication system that provides each in-home device, such as a television or a personal computer, with independent access to a communication system, such as a satellite broadcast system or the Internet. *Id.*, 2:13-44.

The '855 patent discloses “a multimedia server” having access to multiple multimedia sources such as a cable connection, HDTV broadcast, or DVD player. *Id.*, 5:46-61, FIG. 5. The multimedia server receives multiple channel selection requests from client modules, selects multiple channels in the multimedia sources

corresponding to the channel selection commands, and conveys the selected multiple channels to the corresponding client modules. *Id.*, 5:56-6:8. Specifically, the selection requests from the client module identify the desired multimedia source, the client, the desired service, and any other information to assist the multimedia server in processing the requests. *Id.*, 10:62-65. “This is all done via the multimedia server 132 without requiring the clients to have direct access to the multimedia sources and without the requirement that each client have its own multimedia source and/or multimedia source connection.” *Id.*, 11:3-7.

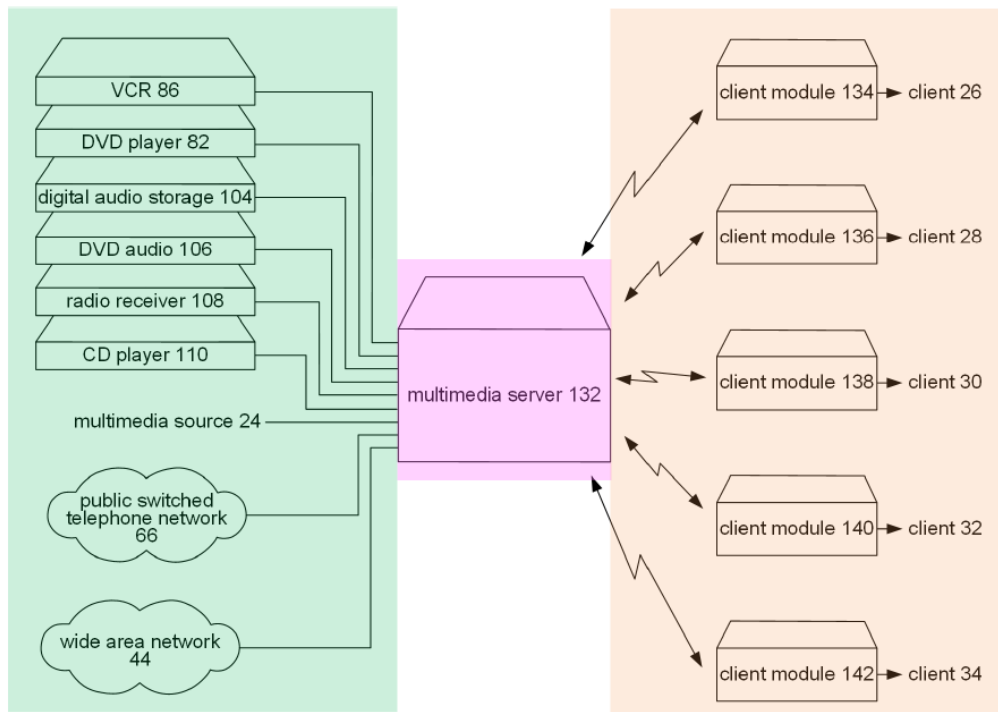


FIG. 5

EX1001, FIG. 5 (annotated).

In the above figure 5, the multiple clients are in orange, the multimedia server 132 is pink, and the several multimedia sources are in green. To serve

multiple clients, the multimedia server 132 distinguishes the channel selection requests from different client modules by “monitoring [a] shared bus at specific time intervals, identifying a data frame at one of the specific time intervals that contains at least a portion of one of the plurality of channel selection requests, decoding, based on a data conveyance protocol of the multimedia system, the data frame to recapture the at least a portion of the one of the plurality of channel selection requests.” *Id.*, 43:50-58, 63:17-25, 65:22-30, 66:55-67, 68:9-18; 70:26-34.

Monitoring of the shared bus can be performed by a monitoring module of a bus interface. *Id.*, 40:8-10, FIG. 30 (shared bus 824). The monitoring module interprets the frames on the shared bus, received at “specific time intervals,” to extract channel select commands. *Id.*, 40:28-30. In addition, monitoring of the shared bus described above can also be performed by a processing module. *Id.*, 41:60-64. In the patent, exemplary disclosed “specific time intervals” are transmit interval 748 and receive interval 750. *Id.*, FIG. 26; 37:63-38:5.

B. The Board should adopt the ITC constructions for the following claim terms.

A claim subject to *inter partes* review shall be given its ordinary and customary meaning to a POSA at the time of the invention, consistent with the prosecution history, as it would be given in a civil action under 35 U.S.C. 282(b). 37 C.F.R. § 42.100(b). As explained above, the Board should deny institution of

this Petition because it fails to provide any evidence or argument supporting any of the allegedly proffered claim constructions.

If the Board reaches the merits of the Petition, it should apply the constructions the ITC adopted for “shared bus” and “identify[ing] a data [frame / packet] at one of the specific time intervals that contains at least a portion of one of the plurality of channel selection [commands/requests]” as explained in detail below.

1. The level of skill of one of ordinary skill in the art

As proposed by Rovi in the ITC proceedings and adopted by the ALJ, a person of ordinary skill in the art (“POSA”) at the time of the invention of the ’855 patent is “someone who has the educational equivalent to a person with a bachelor’s degree in electrical engineering, computer engineering, computer science, or applied mathematics as well as two or more years of relevant industry experience, including in electronic content delivery, electronic program guides, television video signal processing, graphical user interfaces, cable or satellite television systems, set-top boxes, or multimedia systems.” EX2005, 4.

2. “shared bus”

The term “shared bus” should be construed to mean “a bus, located within a multimedia server, that is shared by components of that multimedia server.” The ALJ in the co-pending ITC Investigation adopted this construction, which was a

slightly modified version of Rovi's proposed construction. EX2005, 9-10. This term appears in all independent claims. EX1001, 63:18, 65:23, 66:59, 68:10, 70:27.

The fundamental dispute at the ITC between Rovi's and Comcast's proposed constructions concerned where the claimed "shared bus" resides. EX2005, 9, 11. The '855 patent states that "[t]he shared bus 824 is shared with the channel mixer processing module and other components of the multimedia servers." EX1001, 39:4-7, FIG. 30. The ALJ accordingly construed the "shared bus" to include the shared nature of the claimed bus – "That is why the adopted construction requires that the claimed bus reside not only within a multimedia server, but also be shared by components of that multimedia server." EX2005, 13. The ITC's adopted construction is supported by the intrinsic evidence and the Board should adopt the same construction.

3. "identify[ing] a data [frame / packet] at one of the specific time intervals that contains at least a portion of one of the plurality of channel selection [commands/requests]"

The term "identify[ing] a data [frame / packet] at one of the specific time intervals that contains at least a portion of one of the plurality of channel selection [commands/requests]" should be construed to mean "determin[e/ing] that a data [frame / packet] at one of the specific time intervals contains at least a portion of one of the plurality of channel selection [commands / requests] (without recapturing the at least a portion of one of the plurality of channel selection)"

[commands / requests] via decoding.)” This construction was adopted by the ALJ during the ITC investigation. *See* EX2005, 14-15. This term appears in all independent claims. EX1001, 63:19-22, 65:24-26, 66:60-63, 68:12-14, 70:28-31.

The ALJ adopted a construction that includes the underscored words above, which clarifies that the identifying and decoding steps are performed separately, as Comcast had argued. *See* EX2005, 17 (“Comcast is correct that the ‘identifying’ and ‘decoding’ steps are distinct and must be treated as such in infringement and *invalidity analyses*.”). Given that the ALJ adopted a construction that reflects both Rovi’s and Comcast’s proposed constructions, there is no reason for the Board to depart from that construction.

4. Other claim terms construed by the ITC

Rovi does not require construction for the following claim terms to resolve whether the Petition should be instituted. However, because the parties have already addressed these terms during the course of the ITC Investigation, and the ITC has adopted constructions, should the Board institute any of the ’855 Petitions, Rovi requests that the Board adopt those same constructions:

- “An apparatus for multiplexing channels in a multimedia system” is “limiting only to the environment in which the invention operates, and the preamble does not add steps or components to the recited claim.”

EX2005, 5-6. This term appears in independent 53. EX1001, 70:18-19.

- “channel selection request” means “data that identifies a particular channel and at least one of the clients.” EX2005, 5. This term appears in independent claims 1 and 53. EX1001, 63:6-11; 70:26-41.
- “channel selection command” means “command related to selection of a channel.” EX2005, 7-9. This term appears in all independent claims. EX1001, 63:6-31; 65:22-33; 66:45-67; 68:9-21; 70:35-48.

C. Overview of the applied references

Comcast presents twelve Grounds. Each Ground relies on primary reference Hicks in combination with PCI as summarized in the table below.

Ground	Type	Claims	References
1	§ 103(a)	1-63	Hicks and PCI
2	§ 103(a)	1-17, 19-20, 38-39, 54	Hicks, PCI, and Usui
3	§ 103(a)	2, 5, 20-21, 29, 39, 42, 53-63	Hicks, PCI, and Grier
4	§ 103(a)	2, 5, 20, 39, 54	Hicks, PCI, Usui, and Grier
5	§ 103(a)	6-11, 13, 22-24, 26, 31-32, 34, 43-48, 50, 57-60, 62	Hicks, PCI, and Watkinson
6	§ 103(a)	6-11, 13	Hicks, PCI, Usui, and Watkinson

Ground	Type	Claims	References
7-12	§ 103(a)	<i>See</i> Grounds 1-6 above	Grounds 1-6 and Osakabe, respectively

1. Hicks—primary reference applied to all grounds

Hicks (EX1005) is U.S. Patent No. 8,601,519. Hicks issued December 3, 2013, from an application filed December 28, 2000, less than 5 months before the filing date of the '855 patent.

Hicks' Figure 1 (below) illustrates a broadband multimedia gateway (BMG) 100 within a digital residential entertainment system that can operate as a multimedia gateway and a content server within a client/server architecture. EX1005, Hicks, 2:30-33, 5:57-58.

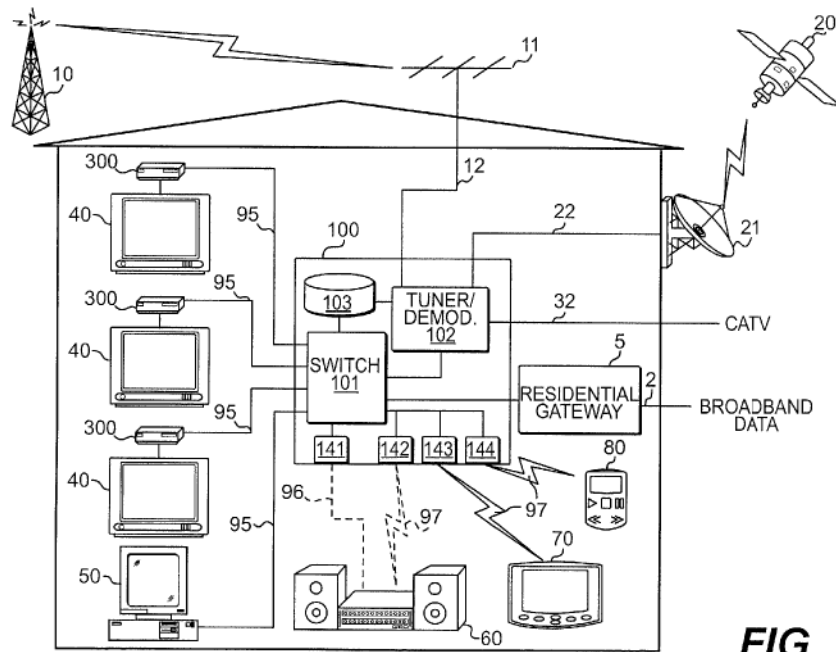
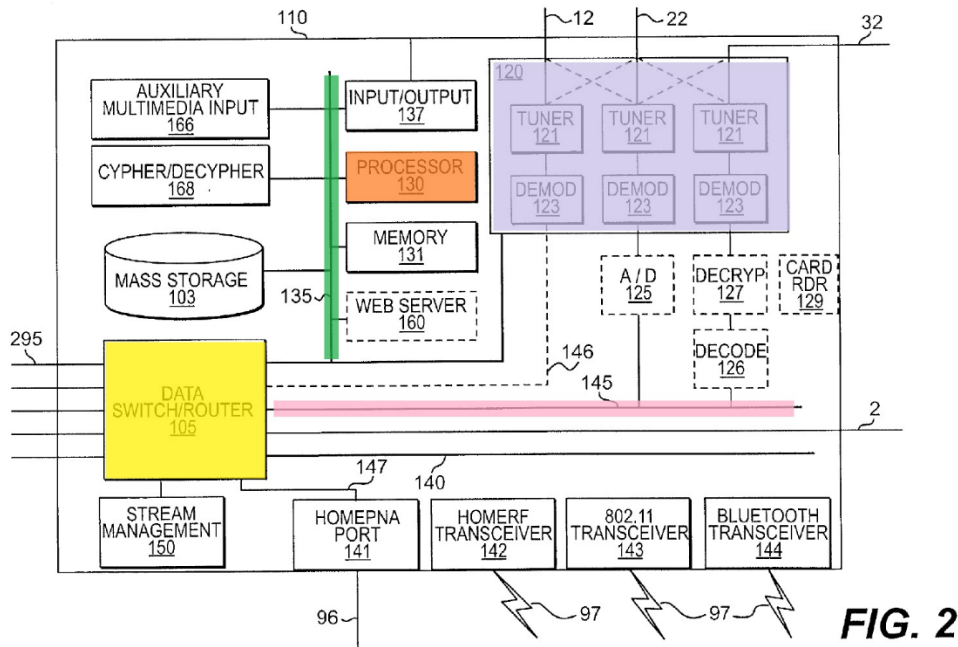


FIG. 1

EX1005, FIG. 1.

Hicks' Figure 2 (annotated below) illustrates a BMG 110 including a data switch/router 105 (yellow) coupled to a processor 130 (orange) using a shared system bus 135 (green) and coupled to a signal processing circuit 120 (purple) using, for example, the shared system bus 135 or a shared communications link 145 (pink). *Id.*, 8:15-47. Hicks does not explain how data switch/router 105, processor 130, and signal processing circuit 120 communicate with each other using the shared system bus 135 or the shared communications link 145.



EX1005, FIG. 2 (annotated).

Hicks states that “[i]nformation appliances can be coupled to data switch/router 105 via dedicated high bandwidth Ethernet communications links 295, each of which can be coupled to a respective switch port of data switch/router 105.” *Id.*, 9:49-52. “Lower bandwidth information signals (e.g., audio, text, and so forth) can be communicated over lower bandwidth communications links, which can be a dedicated lower bandwidth communication link 147 or a shared lower bandwidth communication link 140.” *Id.*, 9:57-61.

2. PCI Local Bus Specification

Comcast uses PCI Local Bus Specification Revision 2.2 (EX1006) as a secondary reference.

“The PCI Local Bus has been defined with the primary goal of establishing an industry standard, high performance local bus architecture that offers low cost and allows differentiation.” EX1006, PCI, 22. PCI’s Figure 2-1 (below) illustrates pins for a PCI interface.

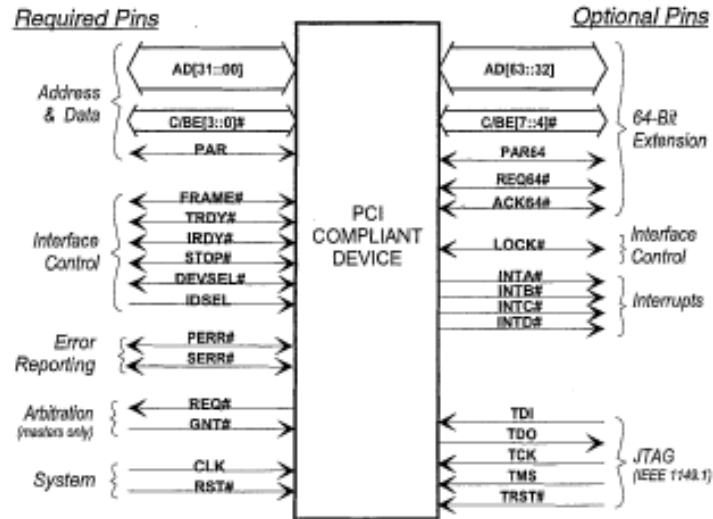


Figure 2-1: PCI Pin List

EX1006, FIG. 2-1.

Pin CLK provides timing for all transactions on PCI and is an input to every PCI device. *Id.*, 28. Pins AD[31::00] provide *Address* and *Data* that are multiplexed on the same PCI pins. *Id.*, 29. A bus transaction consists of an address phase followed by one or more data phases. *Id.*

PCI’s Figure 3-5 (reproduced below) illustrates a read transaction. *Id.*, 67. The read transaction starts with an address phase, which occurs when FRAME# is asserted for the first time and occurs on clock 2. *Id.* During the address phase, AD[31::00] contain a valid address and C/BE[3::0]# contain a valid command. *Id.*

The first clock of the first data phase is clock 3. *Id.* “One way for a data phase to complete is when data is transferred, which occurs when both IRDY# and TRDY# are asserted on the same rising clock edge.” *Id.* “When either IRDY# or TRDY# is deasserted, a wait cycle is inserted and no data is transferred. As noted in Figure 3-5, data is successfully transferred on clocks 4, 6, and 8 and wait cycles are inserted on clocks 3, 5, and 7.” *Id.*, 68.

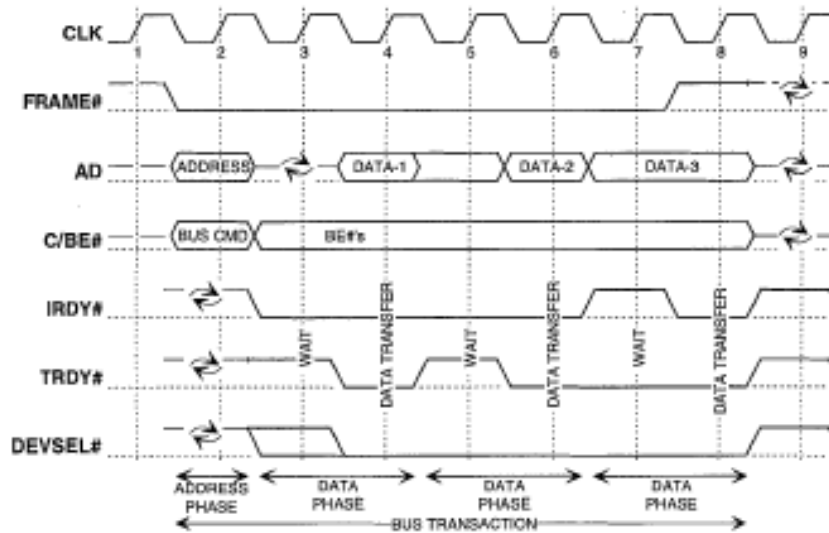


Figure 3-5: Basic Read Operation

EX1006, FIG. 3-5.

3. Osakabe

Osakabe (EX1045) is U.S. Patent No. 6,400,280. Osakabe issued June 4, 2002, from an application filed December 5, 1997.

Osakabe discusses problems with multiple devices each having their corresponding remote control. For example, a TV receiver can have its remote controller, a VCR can have its remote controller, and an LD player can have its

remote controller. EX1045, Osakabe, 1:15-25. Osakabe then states that one remote controller can be used to control multiple device. *Id.*, 1:36-42. However, when one remote controller is used for multiple devices, the devices must be placed where they can receive the remote control signals from the remote controller. *Id.*, 1:43-49. Osakabe’s disclosure is directed to a system to ease the restriction on the placement of each device of a plurality of devices when the plurality of devices are controlled by one remote controller. *Id.*, 1:59-65.

D. The Board should deny institution because the references do not render the challenged claims obvious.

Before the ITC, Comcast argued that Hicks anticipates the ’855 patent, or alternatively, Hicks combined with various secondary references renders the ’855 patent obvious. Through the course of the investigation, Rovi rebutted each of Comcast’s arguments, and having learned Rovi’s positions, Comcast now comes to the Board with another attempt to fill in the gaps of Hicks—this time with the PCI Bus specification (and other exhibits⁷). But that combination remains deficient for

⁷ For example, in the ITC proceedings, Rovi argued that Hicks does not anticipate or render obvious “channel section request,” as recited in all independent claims. *See, e.g.*, EX2007, ¶¶71-73. Now, in the Petition, Comcast turns to Exhibits 1030, 1033, and 1034 and tries—but fails—to overcome the deficiencies of its arguments

a number of reasons. Below, Rovi demonstrates just two of those reasons that dispose of all Grounds in the Petition and independently warrant denial of institution.

First, Comcast fails to explain how Hicks or any of the supporting references disclose the claimed “identifying a data frame at one of the specific time intervals that contains at least a portion of one or the plurality of channel selection commands.”

Second, Comcast fails to explain how Osakabe discloses the claimed “shared bus” as construed to be “a bus, located within a multimedia server, that is shared by components of that multimedia server.”

1. Comcast fails to explain how the references disclose “identifying a data frame at one of the specific time intervals that contains at least a portion of one or [sic: of] the plurality of channel selection commands.”⁸

Comcast relies on the combination of Hicks and PCI as teaching the claimed “identifying a data frame at one of the specific time intervals that contains at least a

in the ITC proceedings, which Comcast learned through Rovi’s rebuttals. Pet., 17-18.

⁸ “One or the plurality of” as recited in claim 1 is a typo that appears to be made by the PTO. The response faxed by Applicant on October 4, 2006, correctly stated “one of the plurality of...” EX1003, 126.

portion of one or [sic: of] the plurality of channel selection commands,” found in independent claim 1. Pet., 23–27. Comcast asserts that all other independent claims recite “elements that correspond to” this claim element and applies the same analysis to those claims as applied to claim 1. Pet., 50, 53, 59, 61. And Comcast relies on Hicks and PCI to teach this claim element in Grounds 1-6. Accordingly, all claims in all Grounds 1–6 in the Petition fall together based on this claim element and combination. Because Comcast only provides specific arguments for claim 1 and contends these arguments apply to all independent claims, Rovi’s arguments, for the purposes of this POPR, similarly address only claim 1, and should apply to all of Comcast’s Grounds and challenged claims.

Comcast states that:

Processor 130 and signal processing circuit 120 [of Hicks] would use **the address and other control signals** (at clock edge #2 in the figure above) to determine it was the target device and the type of transaction **before decoding the data** (Data-1, Data-2, etc. in Figure 3-6 above) to recapture a channel selection command, thus meeting the proposed ITC claim constructions, and that adopted by the ALJ, of the “identifying” step.

Pet., 26.

As an initial matter, Comcast does not explain what the “other control signals” are and what reference Comcast is relying on to allegedly show the “other

control signals.” Comcast is required under 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.22(a)(2) to explain how the applied references allegedly teach or suggest the claimed features. Comcast’s failure to explain what the “other control signals” are and what reference Comcast is relying on is fatal to its burden in proving unpatentability of claims 1–63.

Assuming that the other control signals are the bus commands discussed in PCI (e.g., EX1006, 41), it is not clear, and Comcast does not explain, how PCI’s address and bus commands would allow Hicks’ processor 130 and signal processing circuit 120 to “**identify[] a data frame** at one of the specific time intervals **that contains at least a portion of one or [sic: of] the plurality of channel selection commands,**” as recited in claim 1.

Comcast alleges that the Hicks’ processor 130 and signal processing circuit 120 can use the address to determine whether they are the target device of the alleged frame. Pet., 26. But determining a target device does not disclose or suggest “**identifying a data frame** at one of the specific time intervals **that contains at least a portion of one or [sic: of] the plurality of channel selection commands,**” as recited in claim 1.

Regarding bus commands, PCI states that “[b]us commands indicate to the target the type of transaction the master is requesting.” EX1006, 41. Comcast does not explain why, by receiving the “type of transaction the master is requesting” in

an alleged frame, Hicks' processor 130 and signal processing circuit 120 would identify that the alleged frame "contains at least a portion of one or [sic: of] the plurality of channel selection commands." PCI lists its command types:

C/BE[3::0]#	Command Type
0000	Interrupt Acknowledge
0001	Special Cycle
0010	I/O Read
0011	I/O Write
0100	Reserved
0101	Reserved
0110	Memory Read
0111	Memory Write
1000	Reserved
1001	Reserved
1010	Configuration Read
1011	Configuration Write
1100	Memory Read Multiple
1101	Dual Address Cycle
1110	Memory Read Line
1111	Memory Write and Invalidate

EX1006, 41.

These command types merely indicate the type of transaction requested by the master, **not** what data is on the bus. There is no reason, and Comcast does not explain why, by reading the bus commands, Hicks' processor 130 and signal processing circuit 120 can "**identify[] a data frame** at one of the specific time intervals **that contains at least a portion of one or [sic: of] the plurality of channel selection commands,**" as recited in claim 1.

Comcast is required under 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.22(a)(2) to explain how the applied references allegedly teach or suggest the claimed features. Comcast’s failure to show how the references allegedly teach or suggest the claimed “identifying a data frame at one of the specific time intervals that contains at least a portion of one or [sic: of] the plurality of channel selection commands” is fatal to its burden in proving unpatentability of claims 1–63 for all Grounds presented in the Petition. Institution should be denied on this basis alone.

2. Osakabe fails to disclose the “shared bus” as properly construed – i.e., “a bus, located within a multimedia server, that is shared by components of that multimedia server.”

Comcast relies on the combination of Hicks and Osakabe as teaching claim elements [1F], [18D], [28F], [37D], and [53D] that include the claimed “shared bus” in Grounds 7–12. Pet., 75. Accordingly, Grounds 7–12 in the Petition fall together for this claim element and combination.

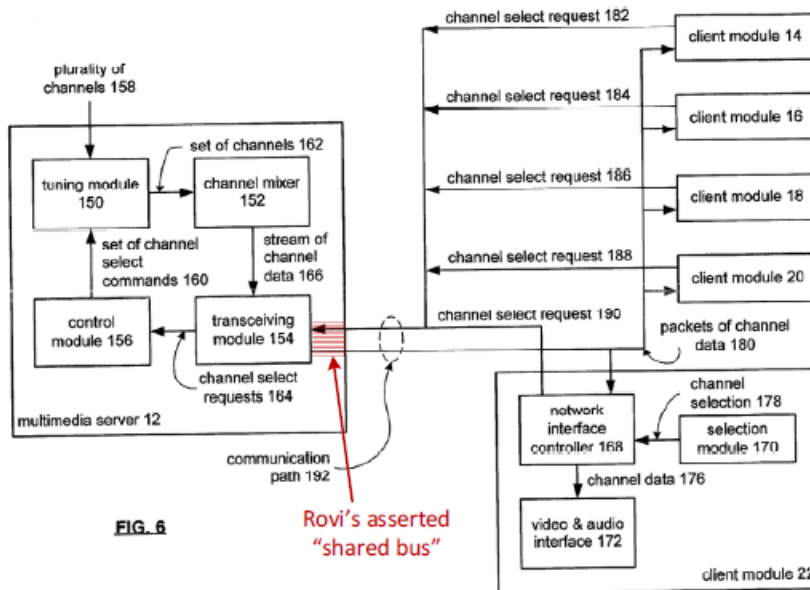
Comcast states:

In the ITC proceedings, Patent Owner asserted that “monitoring a shared bus” (Elements [1F], [18D], [28F], [37D], [53D]) was performed by a gateway monitoring a “MoCA and/or other local network.” Ex. 1044, ¶ 67 [sic., p. 67]. This is analogous to the multimedia server 12 monitoring communication path 192 of Figure 6 of the Patent (as opposed to monitoring “shared bus 824” in the Patent, and in contrast to Petitioner’s construction

of a “bus within a multimedia server used for data transfer between components of the multimedia server”).

Pet., 71.

Comcast provides the following annotation of the '855 patent's Figure 6:



Ex. 1001, Fig. 6 (annotated)

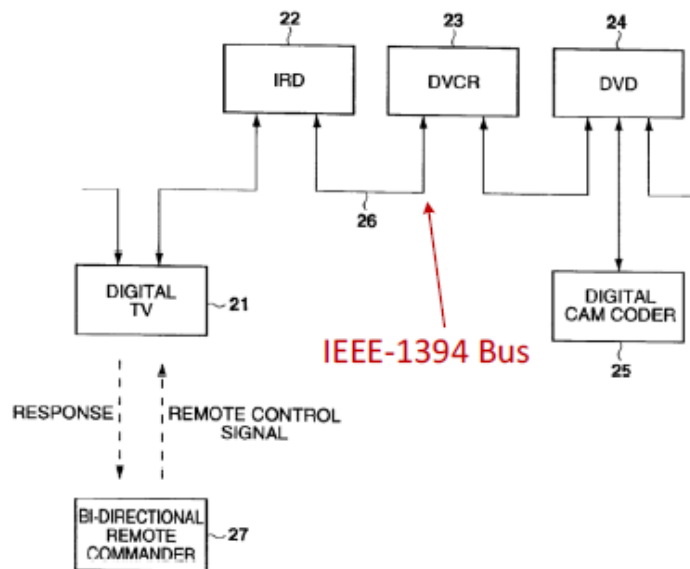
Pet., 72.

Comcast then says “[e]ven if the ‘shared bus’ were as Patent Owner suggests, there were obvious choices for implementing Hick’s networks, which would have performed the steps of Element [1F]” and proceeds to talk about what Osakabe allegedly discloses. Pet., 72.

Comcast’s reliance on Osakabe fails because Comcast does not use any of its unexplained claim constructions for the alleged “shared bus” it annotates in

Figure 6 above. In contrast, Comcast is relying on Excerpts of the ITC Complaint and Claim Chart (EX1044) to advance yet again another alleged and unsupported claim construction for the “shared bus.” Comcast is not using any of “the constructions adopted by the ALJ and proposed by both parties as alternatives in the analysis below.” Pet., 13. Comcast is relying on another document in the ITC proceedings to provide another alleged construction for the “shared bus” without explaining how this alleged construction relates to “the constructions adopted by the ALJ and proposed by both parties as alternatives.”

To allegedly show the new defined “shared bus” as obvious over applied references, Comcast relies on Osakabe’s IEEE 1394 bus and provides the annotated ’855 patent’s Figure 6 above and the following Osakabe’s Figure 3:



Ex, 1045, Fig. 3 (annotated)

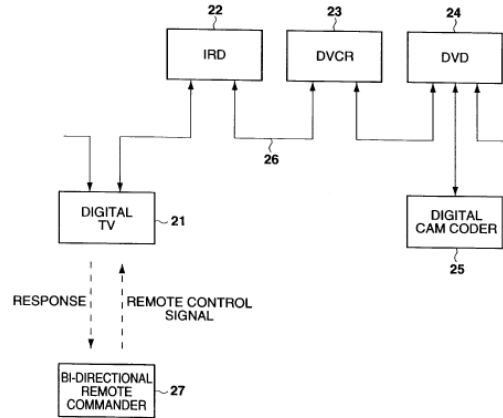
Pet., 73.

Comcast's reliance on Osakabe to allegedly show the "shared bus" is flawed because Osakabe fails to disclose a "shared bus" as recited in all independent claims and as properly construed – i.e., "a bus, located within a multimedia server, that is shared by components of that multimedia server."

Osakabe's IEEE 1394 bus does not disclose or suggest the claimed "shared bus." In contrast to the claimed "shared bus," as construed to be "a bus, located within a multimedia server, that is shared by components of that multimedia server," Osakabe's IEEE 1394 is connected between TV 21 and the media sources (e.g., IRD, DVCR, DVD). Osakabe's IEEE 1394 is plainly not a bus located within a multimedia server and Osakabe's IEEE 1394 bus is not shared by components of that multimedia server.

Osakabe is concerned with one remote controller (e.g., remote controller 11 of Osakabe's Figure 2) to be used to control multiple devices. EX1045, 1:36–42. However, when one remote controller is used for multiple devices, the devices must be placed where they can receive the remote control signals from the remote controller. *Id.*, 1:43–49. Osakabe's disclosure is directed to a system to ease the restriction on the placement of each device of a plurality of devices when the plurality of devices are controlled by one remote controller. *Id.*, 1:59–65.

FIG.3



EX1045, FIG. 3.

For example, Osakabe’s Figure 3 (reproduced above) is a block diagram showing the construction of an AV (audio visual) system to which Osakabe’s remote control system is applied. *Id.*, 4:65–67. Osakabe’s Figure 3 illustrates a digital TV 21, an integrated receiver-decoder (IRD) 22, a digital video cassette recorder (DVCR) 23, and a digital camcorder 25 that are connected to each other through IEEE-1394 serial bus 26. *Id.*, 4:67-5:7. Osakabe’s Figure 3 further illustrates a “bi-directional remote commander 27 [that] transmits a remote control signal corresponding to a predetermined command, and receives a remote control signal corresponding to a response to the control command transmitted from the digital TV 21.” *Id.*, 5:7–12. Osakabe does not disclose or suggest a multimedia server. Even assuming that Osakabe discloses a multimedia server (which it does

not), Osakabe's IEEE-1394 serial bus 26 is not located within a multimedia server and shared by components of that multimedia server.

Therefore, Osakabe's IEEE 1394 does not disclose or suggest the "shared bus," as recited in all independent claims and as properly construed. This is fatal to Comcast's burden in proving unpatentability of claims 1-63 in Grounds 7-12.

Therefore, institution should be denied on this basis alone for claims 1-63 in Grounds 7-12.

E. Comcast fails to explain why a POSA would have been motivated to combine Hicks with PCI specification or with Osakabe.

Comcast relies on the combination of Hicks and PCI in all of Grounds 1-12. Pet. 11-12. Accordingly, all of Grounds 1-12 in the Petition fall together for Comcast's failure to explain why a POSA would have been motivated to modify Hicks with PCI specification.

Comcast relies on PCI and alleges that it would have been obvious to implement Hicks' bus using the PCI bus of PCI. Pet., 24, 26-27. But Comcast's motivation to combine is conclusory and does not provide any reason why a POSA would have been motivated to combine Hicks and PCI.

Comcast's only attempt at a reason for POSA's motivation to combine is:

A PHOSITA would have been motivated to implement Hicks's system data bus according to the PCI standard and would have had a reasonable expectation of success in doing so, since PCI

was an industry standard, specifically designed to work with and often implemented with Hicks's Pentium III processor, and was widely deployed, including in off-the-shelf equipment.

Pet., 26.

Comcast's motivation to combine analysis says no more than that a POSA, once presented with the two references, would have understood that they *could be* combined. As noted in *Personal Web Technologies, LLC v. Apple Inc.*, "that is not enough: it does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention." 848 F.3d 987, 993-994 (Fed. Cir. 2017). Comcast did not identify a known problem or a market demand to modify Hicks' bus with the PCI bus.

If a petitioner seeks to show obviousness on the basis of multiple prior-art references, the petitioner bears the burden to show that a skilled artisan would have been motivated to combine the references. *See In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016); *Endo Pharm. Solutions, Inc. v. Custopharm Inc.*, 894 F.3d 1374, 1380-81 (Fed. Cir. 2018); *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016); *Millennium Pharm., Inc. v. Sandoz Inc.*, 862 F.3d 1356, 1366 (Fed. Cir. 2017). Moreover, in showing a motivation to combine, it is not sufficient that the petitioner show merely that a skilled artisan "would have been *able to*" combine the references; the petitioner must show that "a skilled artisan would have been *motivated to do [so]* at the time

of the invention.” *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1068 (Fed. Cir. 2018) (emphasis in original); *see also, Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (holding that obviousness requires a showing of more than “whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention”).

The mere fact that PCI was an industry standard (as Comcast states in Pet., 26) is not a reason why a POSA would have been motivated to combine Hicks and PCI. Comcast merely states that a POSA “could” combine two different references disclosing different elements but fails to explain how and why a POSA would be motivated to combine the two references.

Comcast’s failure to provide an explanation for a POSA to combine Hicks’ bus with PCI specification is fatal to its burden in proving unpatentability of claims 1–63. Therefore, institution should be denied on this basis alone for claims 1–63 in all of Grounds 1–12.

Additionally, with respect to Grounds 7–12, Comcast fails to explain why a POSA would have been motivated to modify Hicks with Osakabe. Comcast relies on Osakabe and alleges that it would have been obvious to implement or extend Hicks’ broadband data network with Osakabe’s IEEE-1394. Pet., 75–78. But, for similar reasons discussed above, Comcast’s motivation to combine is conclusory

and does not provide any reason why a POSA would have been motivated to combine Hicks, PCI, and Osakabe.

Comcast's first attempt at a reason for POSA's motivation to combine seems to be:

(A) Hick's BMG is compatible with any of a variety of high and low bandwidth shared networks; (B) IEEE-1394 performs the same Hicks functions of communicating commands and streaming MPEG video; and (C) IEEE-1394 is scalable, doesn't require user configuration, and was already used with Set top boxes such as those in Hicks.

Pet., 77.

But none of these alleged reasons are a reason why a POSA would have been *motivated* to combine Hicks and Osakabe. As discussed above, it is not sufficient that the petitioner show merely that a skilled artisan "would have been *able to*" combine the references; the petitioner must show that "a skilled artisan would have been *motivated* to do [so] at the time of the invention." *Polaris Indus., Inc.*, 882 F.3d at 1069.

Comcast further states that "[m]oreover, Osakabe improves upon Hicks by providing a format for commands as FCP opcodes/operands and using responses to acknowledge command reception, thus providing an obvious improvement to the Hicks's system applied in the same way as Osakabe's system implements those techniques. Ex. 1002, ¶ 474." Pet., 77. But Comcast provides no reason why the

“format for commands as FCP opcodes/operands and using responses to acknowledge command reception” is “an obvious improvement to the Hicks’s system.” Comcast’s conclusory statement that FCP opcodes/operands and an acknowledgment are obvious improvements is pure speculation without any explanation of how and why Osakabe improves Hicks’ system. As discussed above, the petitioner bears the burden to show that a skilled artisan would have been motivated to combine the references. A motivation to combine must be supported by some “articulated reasoning with some rational underpinning.” *Innogenetics, NV v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed Cir. 2008) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Comcast provides a conclusory statement with no “articulated reasoning with some rational underpinning.”

Comcast’s failure to provide an explanation for a POSA to combine Hicks with Osakabe is fatal to its burden in proving unpatentability of claims 1–63 in Grounds 7–12. Therefore, institution should be denied on this basis alone for claims 1–63 in Grounds 7–12.

F. Comcast has not demonstrated that PCI is a printed publication under any of the multiple theories it improperly sets forth.

A petitioner may request cancellation of claims in an IPR “only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). As discussed below, Comcast’s PCI document (EX1006) is not a patent and Comcast has failed to establish that it is a printed publication under any of the three theories

of public availability it set forth in the Petition. Therefore, because Comcast asserted PCI as part of each Ground, each of Comcast’s Grounds is statutorily deficient and the Board should deny institution.

Determining whether a document is a printed publication “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). “Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *In re Hall*, 781 F.2d 897, 898–899 (Fed. Cir. 1986)). As a baseline, “[p]ublic accessibility requires more than technical accessibility.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, 10 (P.T.A.B. Dec. 20, 2019) (precedential) (citing *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019)).

1. PCI is not prior art under § 102(e).

Comcast first makes the flawed assertion that PCI has “a prior art date of August 10, 1999 under 35 U.S.C. § 102(e) (pre-AIA).” Pet., 9. Comcast’s assertion is flawed because § 102(e) expressly states that it applies only to patents and patent applications—and PCI is neither. Accordingly, PCI is not and cannot be prior art

under § 102(e). Comcast states that “U.S. Pat. No. 6,218,864 (Ex. 1011) [] incorporates-by-reference PCI,” but that does not change the simple fact that PCI is not eligible to be § 102(e) art. *Id.* Further, Comcast has not included the ’864 patent as part of its grounds (Pet., 11-12), so its § 102(e) date is irrelevant.

Comcast cites to 37 C.F.R. § 1.11(a) for support of its assertion of prior art status for PCI, but that rule’s reference to file histories being “open to inspection by the public” does not mean that PCI is a prior art printed publication under §102(e).

C&D Zodiac, Inc. v. B/E Aerospace, Inc., IPR2017-01275, Paper 12, 19 (P.T.A.B. Oct. 31, 2017) (“[W]e are not persuaded that, under Rule 1.11(a) (or any other authority), file histories of patent applications generally constitute printed publications....”).

2. PCI is not prior art under § 102(a).

Comcast also incorrectly asserts that “PCI, as included in the ’864 patent file wrapper, is prior art under 35 U.S.C. § 102(a) (pre-AIA) as of August 17, 2001.” Pet., 9. Contrary to Comcast’s assertion, inclusion in a file history does not qualify a document as a prior art printed publication.

As noted by a previous panel of the Board, “inclusion in the ... prosecution history is not, by itself, enough to establish that [an incorporated reference] was sufficiently publicly accessible to constitute a printed publication.” *RPX Corp. v Iridescent Networks, Inc.*, IPR2018-00254, Paper 20, 21 (P.T.A.B. Dec. 10, 2018).

The Board reached this decision by following the Federal Circuit’s guidance that there needs to be “a sufficient roadmap” to the document in question, such that the document is “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Id.* at 22-23 (quoting *Blue Calypso*, 815 F.3d at 1348). Other Board panels have come to the same conclusion. *See, e.g., Microsoft Corp. v. Biscotti Inc.*, IPR2014-01457, Paper 9, 25-28 (P.T.A.B. Mar. 19, 2015) (holding that listing a reference on the face of a patent and inclusion of that reference in the file history is not sufficient to demonstrate public availability); *C&D Zodiac*, IPR2017-01275, Paper 12, 21 (“Petitioner has provided no argument or evidence showing a potential roadmap such that no more than reasonable diligence would have been required for relevant persons to use the [] patent to locate the [document in the file history].”).

Here, Comcast’s Petition does not show how or make any assertion as to why a POSA would have located the file history document. Instead, Comcast makes a bald assertion that inclusion in the file wrapper alone is sufficient to qualify PCI as a prior art publication under § 102(a). The Board should reject this argument, as previous panels have.

3. PCI is not prior art under § 102(b).

Comcast also fails to support its alternative assertion that “PCI, as being publically available February 1999, is prior art under 35 U.S.C. § 102(b) (pre-AIA).” Pet., 9. Comcast’s assertion fails because it does not demonstrate public availability by providing “a sufficiently definite roadmap” of how a POSA would have found PCI. *Blue Calypso*, 815 F.3d at 1350.

As the Federal Circuit noted in *Blue Calypso*, “[a]n adequate roadmap need not give turn-by-turn directions, but should at least provide enough details from which we can determine that an interested party is reasonably certain to arrive at the destination: the potentially invalidating reference.” *Id.*; *see also SRI International Inc. v. Internet Sec. Systems, Inc.*, 511 F.3d 1186, 1195 (Fed. Cir. 2008) (holding that a paper did not qualify as 102(b) prior art because the “paper was not indexed or catalogued in any meaningful way to enable a person of ordinary skill to locate the paper”). Comcast’s Petition does not provide *any* explanation of how a POSA would have found PCI, much less sufficient detail. Instead, Comcast’s Petition contains a conclusory assertion of public availability, followed by a few citations. Pet., 9. That *single sentence* is not sufficient to demonstrate public availability.

Comcast cites to a Declaration from Dr. Carrie Gardner (EX1013) as putatively supporting its assertion of public availability. At the outset, the Board

should give no weight to any arguments in Dr. Gardner's testimony because Comcast has improperly incorporated her testimony by reference. 37 C.F.R. § 42.6(a)(3). The Petition cites to 19 paragraphs of Dr. Gardner's Declaration when discussing the PCI reference, but the Petition contains no explanation or discussion of the subject matter of her testimony. Such a tactic justifies declining to consider Dr. Gardner's testimony. *See, e.g., Dept. of Justice v. EnvisionIT, LLC*, IPR2017-00186, Paper 8, 12 (P.T.A.B. May 3, 2017) (declining to consider a librarian declaration that "appear[ed] to include Petitioner's arguments and evidence to establish the public accessibility," when the "Petition does not provide a detailed statement of Petitioner's arguments as to the public accessibility"); *see, also* Section III.G *infra*.

Moreover, even if the Board considers Dr. Gardner's testimony (though it should not), her testimony is not sufficient to demonstrate the public availability of PCI. Dr. Gardner has no knowledge of the pertinent field, no knowledge of PCI itself, and no personal knowledge of PCI's purported availability before May 24, 2001. Dr. Gardner's lack of personal knowledge justifies dismissal of her testimony. *Dept. of Justice*, IPR2017-00186, Paper 8, 13-14 (dismissing a librarian declaration because the librarian "lack[ed] personal knowledge of the source or date of publication"). Further, just because Dr. Gardner found copies of PCI and makes references to PCI in her own current-day research does not mean that there

was a roadmap for a POSA to find PCI before May 24, 2001. *Blue Calypso*, 815 F.3d at 1350; *see also Argentum Pharm. LLC v. Research Corp. Tech., Inc.*, IPR2016-00204, Paper 19, 11 (P.T.A.B. May 23, 2016) (informative) (holding that evidence must be directed to whether a document “was publicly accessible in the relevant time frame”). For example, Dr. Gardner points to the “pcisig.com” web page as a potential source of PCI. EX1013, ¶¶18-21. She then notes that “PCISIG is the name of a group that creates specifications and standards for peripheral component interconnect (PCI) technology.” *Id.*, ¶18. She then notes that PCISIG started in 1992 and has over 700 industry companies as members. *Id.* But the current membership (as of April 15, 2020, the date indicated on Appendix B of EX1013) is irrelevant to whether a POSA before May 24, 2001, would have had a roadmap to find PCI. *Id.* The Internet Archive capture of the pcisig.com web page likewise does not speak to whether a POSA would have been able to find PCI because technical availability on a webpage alone does not equate to public availability. *SRI International Inc.*, 511 F.3d at 1195 (holding that a document placed on an FTP server did not qualify as a prior art printed publication).

Comcast also cites to a statement within PCI itself that version 2.2 “became available in February of 1999.” Pet., 9 (citing EX1047, 4). However, this statement does not show the public availability required to be a printed publication because the referenced date could mean any number of things. For example, “became

available” could refer to the date that version 2.2 was completed. Alternatively, it could mean “available” within a private (*i.e.*, non-public) group, or it could mean the date on which the document was posted on a server. None of these options would have necessarily meant that a person of ordinary skill in the art would have had a sufficient roadmap to find PCI.

In view of the above, Comcast has not demonstrated the public availability of PCI, PCI does not qualify as a printed publication, and the Board should deny institution of all Grounds.

G. Comcast improperly circumvents the word count limit by incorporating by reference large sections of arguments from its exhibits.

Similar to its approach with claim construction, Comcast elsewhere improperly incorporates by reference huge swathes of arguments from its exhibits. The Board should decline to consider arguments made only in Comcast’s exhibits and incorporated into the Petition by reference. The Board’s Rules limit “[p]etition[s] requesting *inter partes* review [to] 14,000 words,” 37 C.F.R. § 42.24(a)(1)(i), and unequivocally state “Arguments must *not* be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). The Rules further require IPR petitions to include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the

evidence including material facts, and the governing law, rules, and precedent.” 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(5).

An incorporation “by reference amounts to a self-help increase in the length of the [] brief[,]” and “is a pointless imposition on the court’s time.” *DeSilva*, 181 F.3d at 866-867. This tactic is in direct contravention with the fundamental policy behind IPRs to promote efficiency and fairness. “A brief must make all arguments accessible to the judges,” so that judges can efficiently understand and determine the issues of the case, “rather than ask[ing] them to play archaeologist with the record.” *Id.* If the Petition fails to do so, “parties that incorporate expert testimony by reference in their petitions, motions, or replies without providing explanation of such testimony risk having the testimony not considered by the Board.” TPG, 35-36.

The Board has held that the “practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition [] amounts to incorporation by reference. ... [so] we will not consider arguments that are not made in the Petition, but are instead incorporated by reference to the cited paragraphs [of the declarant’s] Declaration.” *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12, 7-10 (P.T.A.B. Aug. 29, 2014) (informative); *see also Comcast Cable Commc’ns Corp. v. Rovi Guides, Inc.*, IPR2017-00941, Paper 34, 3 (P.T.A.B. May 15, 2018) (“Petitioner should be mindful that Board rules

prohibit incorporating by reference arguments from one document into another document.”); *Avant Tech., Inc. v. Anza Tech., Inc.*, IPR2019-00042, Paper 7, 9 (P.T.A.B. Apr. 10, 2019) (denying institution based on Petition’s incorporation by reference for “lack of specificity and failure to communicate clearly why the Board should adopt its proposed claim constructions”); *Shenzhen Huiding Tech. Co., Ltd. v. Synaptics Inc.*, IPR2015-01741, Paper 8, 29-31 (P.T.A.B. Feb. 16, 2016) (declining to consider institution on certain grounds because Petitioner effectively used incorporation by reference to obtain eleven and a half pages over the page limit); *LG Elecs Inc., v. Advanced Micro Devices, Inc.*, IPR2015-00328, Paper 20, 8 (P.T.A.B. Jul. 8, 2015) (holding that “we do not consider arguments not made in the Petition itself” when petitioner improperly incorporates by reference several arguments from its declaration into its petition.).

Here, in one example, the Petition incorporates by reference multiple sections from multiple exhibits to allegedly show the claimed “receiving, from a plurality of clients, a plurality of channel selection requests” is disclosed by Hicks. Pet., 17–18. However, Comcast fails to explain why the evidence is significant to reach its respective conclusions. Instead, Comcast merely provides several unexplained citations to its declarant’s Declaration. Comcast incorporates twelve paragraphs from that Declaration, numerous sections from Hicks (EX1005),

sections from EX1030, sections from EX1033, and sections from EX1034 without any analysis and explanation of how these sections support its conclusions.

As another example, the Petition incorporates by reference multiple sections from multiple exhibits to allegedly show the claimed “processing the plurality of channel selection requests to produce the plurality of channel selection commands” is disclosed by Hicks. Pet., 18–19. Comcast incorporates twelve paragraphs from its declarant’s Declaration, numerous sections from Hicks (EX1005), sections from EX1030, sections from EX1033, and sections from EX1034 without any analysis and explanation how these sections support its conclusions.

In yet another example, when discussing its Grounds 7–12 (Grounds 1–6 further combined with Osakabe), Comcast attempts to discuss only claim elements [1D], [1F], [18D], [28F], [37D], [53D], and [53E]. Pet., 75–76. For the many remaining claim features, Comcast then states that “[t]he remaining elements of claims 1-63 are disclosed as described above with respect to Grounds 1-6.” *Id.*, 76; *see also id.*, 78. Comcast is inappropriately incorporating by reference its previous grounds without explaining how and why PCI, Usui, Grier, and Watkinson can be combined with Osakabe. Comcast does not explain why and how PCI is necessary to use for Grounds 7–12.

Thus, with only unexplained citations in its Petition, Comcast asks the Board to sift through its citations and reconstruct the explanations to its arguments that

are missing from the Petition. This is a classic example of incorporation by reference. *See* 37 C.F.R. § 42.6(a)(3).

These incorporations are also of particular significance as Comcast certifies its Petition is only 13 words short of the word count limit of 14,000 words. Pet., 80. However, Comcast cites to well over 58,000 words of arguments found in its declarant's Declaration. *See generally* EX1002. Thus, Comcast incorporates several arguments into its Petition that, if considered, would significantly exceed the prescribed word count limit.

Therefore, because Comcast impermissibly incorporates by reference several of its arguments into its Petition, the Board should decline to consider arguments made only in its declarant's Declaration and exhibits and should not institute the Petition.

IV. IF THE BOARD DOES NOT DENY INSTITUTION OF ALL THREE '855 PETITIONS BASED ON EITHER THE ABOVE COMMON OR INDIVIDUAL BASES, THE BOARD SHOULD INSTITUTE ONLY ONE PETITION—THE TOP-RANKED PETITION.

As discussed above, there are multiple bases for denying institution of all three '855 Petitions based on Comcast's procedural and substantive errors. However, if the Board believes that denying all three '855 Petitions would be *per se* unfair because it "would deny Petitioner even one petition" (as the Board held in IPR2019-01353, Paper 10, 8 (P.T.A.B. Jan. 27, 2020)), Rovi requests that the

Board institute only IPR2020-00787 (“the Hicks Petition”). Because Comcast has strategically chosen to ignore the Board’s guidance and filed three ’855 Petitions against the ’855 patent, the Board (1) should institute—at most—one of the ’855 Petitions and (2) afford Rovi the opportunity to choose the Petition that is instituted (if any).

A. Comcast has not offered any meaningful explanation for why multiple IPRs against the same claims of the same patent are justified.

Comcast has failed to provide sufficient justification for instituting multiple petitions. To curb parallel petition abuse—the very conduct Comcast has engaged in here—the Office revised the TPG in July 2019 to explain situations when multiple petitions are warranted.⁹ The TPG explains that “one petition should be sufficient to challenge the claims of a patent in most situations” and that filing more than one petition in parallel against a single patent tends to place a “substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” TPG, 59. The TPG notes that, based on the Board’s prior experience, it is “unlikely that circumstances will arise

⁹ Comcast’s campaign against Rovi is cited in the Trial Practice Guide as an example relevant to the new ranking policy. TPG, 60 n.4. The cited cases were the first in which the Board required a petitioner to rank its petitions.

where three or more petitions by a petitioner ... will be appropriate” and the filing of parallel petitions against the same patent “should be rare.” *Id.*

As with so many other Board rules and requirements, Comcast ignores the Board’s guidance here. Comcast has concluded that every single Rovi patent it has ever challenged meets the “rare” circumstances warranting multiple petitions.¹⁰ But Comcast’s Ranking Document fails to justify the multiple IPRs. Indeed, Comcast simply claims that three different ’855 Petitions—constituting twenty-eight separate Grounds of unpatentability—are necessary because the ’855 Petitions all “teach the ’855 Patent claims, but in different ways.” Ranking Document, Paper 3, 1.¹¹ The Board has recognized that asserting multiple

¹⁰ In 2020 alone, Comcast has filed 21 petitions against six Rovi patents—averaging 3.5 petitions per patent. Comcast has filed at least three petitions per patent and, in some cases, as many as five. The lack of meaningful explanation Comcast gives in each instance for why multiple petitions are necessary raises the very fairness, timing, and efficiency concerns the TPG attempts to discourage. *See also Gen. Plastic*, IPR2016-01357, Paper 19, 16–17.

¹¹ Comcast also uses the Ranking Document to argue the difference between Rakib (EX1105 in IPR2020-00788) and Rakib ’658, which was considered during prosecution, in an attempt to justify asserting Rakib in Petition 2. Comcast’s

“references teach these limitations, but differ in how they teach these limitations” or saying that multiple “references teach these limitations in their own way” is effectively the same as arguing that the petitions present alternative arguments against the same claims, and fails to justify multiple proceedings. *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01220, Paper 19, 7-8 (P.T.A.B. Jan. 30, 2020).

Comcast spends several pages of its ranking document explaining how the arguments in each Petition are different from each other, but this is irrelevant. “Difference” in the cited art is not sufficient to justify multiple petitions. *Pfenex Inc. v. Glaxosmithkline Biologicals SA*, IPR2019-01027, Paper 12, 13-14 (P.T.A.B. Nov. 13, 2019). Instead, the Petitioner must establish “that the differences between the Petitions are material and justify exercising [the Board’s] discretion to institute additional petitions.” *Palette Life Sci., Inc. v. Incept LLC*, IPR2020-00003, Paper 8, 8 (P.T.A.B. Apr. 17, 2020).

Comcast further attempts to justify its multiple petitions by pointing out that each of the ’855 Petitions relies on at least one base reference that qualifies as prior art under §§ 102(a) or 102(e), meaning that Patent Owner could attempt to antedate

allegations regarding the difference between Rakib and Rakib ’658 is argument, and its inclusion in the Ranking Document is yet another improper circumvention of the Petition word count limits.

them. Paper 3, 4. But “[t]he possibility that Rovi might seek to antedate references is insufficient as a rationale to justify the inefficiencies and costs associated with instituting a parallel *inter partes* review.” *Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc.*, IPR2019-01376, Paper 9, 10 (P.T.A.B. Feb. 10, 2020). In any event, Rovi will not seek to antedate any reference in the three ’855 Petitions, so this reason is rendered moot.

Accordingly, the Board should institute on—at most—one of the ’855 Petitions.

B. Fairness and efficiency warrant instituting only the top-ranked petition.

If the Board institutes one petition, under the circumstances of how the ’855 patent has been litigated, it should be the top-ranked Hicks Petition.¹² Hicks, the primary reference in each Ground of the Hicks Petition, was also the primary reference Comcast relied on in its validity challenge at the ITC before Comcast pulled the challenge in the middle of trial. Accordingly, Rovi already expended substantial time and resources preparing for trial against this reference in the ITC.

¹² The justifications for selecting IPR2020-00787 are different in kind from those set forth in Patent Owner’s responses involving U.S. Patent Nos. 7,779,445, 7,386,871, 7,301,900, and 8,156,528. Each has a unique set of facts and circumstances.

Rovi would be significantly prejudiced if the Petitions in either IPR2020-00788 or IPR2020-00789 were instituted because Rovi would be forced to expend significant time and resources defending against references that Comcast dropped earlier in the ITC investigation (Rakib as applied in the -00788 Petition and Bigham as applied in the -00789 Petition). *See Gen. Plastic*, IPR2016-01357, Paper 19, 17 (“Our intent in formulating the factors was to take undue inequities and *prejudices to Patent Owner* into account.”). The only way to avoid such prejudice to Rovi is to allow Rovi to leverage the substantial work that it has already done in the ITC in its defense of the ’855 patent before the PTAB.

Finally, the Hicks Petition is Comcast’s top-ranked petition for the ’855 patent. And as discussed above, the Hicks Petition is redundant of the two other ’855 Petitions. Accordingly, while Comcast should not be guaranteed to have at least one institution decision in its favor just because it filed multiple petitions, if the Board must institute on one, it should be the Hicks Petition.

V. CONCLUSION

Comcast has not established why the Petition should not be denied under 35 U.S.C. §§ 325(d), 314(a) or a reasonable likelihood that it will prevail on any ground. The Board should also exercise its substantial discretion and refuse to institute this Petition on the basis that Comcast did not carry its burden to justify the need for three concurrent and wholly redundant IPR Petitions on the same claims. Thus the Board can and should deny institution on this basis alone.

Respectfully submitted,
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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE** specified in 37 C.F.R. § 42.24 have 13,663 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared using Microsoft Word 2016.

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and **Exhibits 2001-2016** were served electronically via e-mail on August 14, 2020, in their entireties on the following counsel for Petitioner:

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