

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 ROVI GUIDES, INC.'S
UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R.
§ 42.8(a)(3)**

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

Patent Owner Rovi Guides, Inc. (“Patent Owner”) hereby files these

Updated Mandatory Notices Pursuant to 37 C.F.R. § 42.8(a)(3).

I. RELATED MATTERS

The following U.S. Patents are involved in both *In the Matter of Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components*, Case No. 337-TA-1158 (ITC) (“the 1158 Investigation”) and the following inter partes review proceedings:

Proceeding No.	Patent	Status
IPR2020-00787	7,200,855	Pending
IPR2020-00788	7,200,855	Pending
IPR2020-00789	7,200,855	Pending
IPR2020-00800	7,779,445	Denied under § 314(a) in view of 1158 Investigation
IPR2020-00801	7,779,445	Denied under § 314(a) in view of 1158 Investigation
IPR2020-00802	7,779,445	Denied under § 314(a) in view of 1158 Investigation
IPR2020-00809	8,156,528	Pending
IPR2020-00810	8,156,528	Pending
IPR2020-00811	8,156,528	Pending

On October 13, 2020, the International Trade Commission gave notice in the 1158 Investigation that it would review in part the final initial determination of the presiding administrative law judge finding a violation of section 337, and requested written submissions on the issues of remedy, the public interest, and bonding. *In the Matter of Certain Digital Video Receivers, Broadband Gateways, & Related Hardware & Software Components, Notice of Comm'n Decision to Review in Part an Initial Determination Finding A Violation of Section 337;*

Request for Written Submissions on the Issues Under Review & Remedy, the Pub.

Interest, & Bonding, USITC Inv. No. 337-TA-1158 (Oct. 13, 2020).

Further, the Board recently exercised its discretion under 35 U.S.C. § 314(a) to deny institution of the three Petitions involving one of the above patents, U.S. Patent No. 7,779,445 (“the ’445 Patent”), in view of the parallel 1158 Investigation. (IPR2020-00800 (Paper 10), -00801 (Paper 10), -00802 (Paper 10)). In weighing the *Fintiv* factors, the Board held that instituting trial for any of the three ’445 Patent Petitions would “raise concerns about inefficiency and duplicative costs.” *Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc.*, IPR2020-00800, -00801, -00802, Paper 10, 12 (P.T.A.B. Oct. 22, 2020). The Board noted a delay before filing of the Petitions of “more than ten months after the ITC instituted its investigation and more than 11 months after Petitioner was served with a complaint alleging infringement.” *Id.*, 14. The Board concluded that “considering the totality of the evidence before us, we determine that instituting *inter partes* review in these proceedings would not be an efficient use of the Board’s limited resources.” *Id.*, 16.

The instant Petitions involving U.S. Patent No. 7,200,855 (“the ’855 Patent”) are similarly situated to the ’445 Patent Petitions in every material way with respect to the *Fintiv* analysis—including the delayed timing of filing—except that, in the 1158 Investigation, Petitioner Comcast withdrew its invalidity

challenge of the '855 Patent in the middle of trial such that the Administrative Law Judge did not provide findings with respect to the validity of the '855 Patent.

POPR, 5-15. Because it was Petitioner's own decision to withdraw its validity challenge at that late stage, the Board's *Fintiv* analysis addressing efficiency, cost, and prevention of gamesmanship still warrants the Board exercising its discretion to deny institution of the '855 Patent Petitions under 35 U.S.C. § 314(a). *Id.*

Respectfully submitted,
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Date: October 29, 2020

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER**
ROVI GUIDES, INC.'S UPDATED MANDATORY NOTICES PURSUANT
TO 37 C.F.R. § 42.8(a)(3) were served electronically via e-mail on October 29,
2020, in their entirety on the following counsel of record for Petitioner:

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