

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COMCAST CABLE COMMUNICATIONS, LLC,  
Petitioner,

v.

ROVI GUIDES, INC.,  
Patent Owner.

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Case IPR2020-00787  
Patent 7,200,855

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**PETITIONER COMCAST CABLE COMMUNICATIONS, LLC'S  
UPDATED MANDATORY NOTICES PURSUANT TO  
37 C.F.R. § 42.8(A)(3)**

Pursuant to 37 C.F.R. § 42.8(a)(3), Petitioner Comcast Cable Communications, LLC, hereby submits these Updated Mandatory Notices.

## **I. RELATED MATTERS**

The '855 Patent has been asserted against Petitioner in *In the Matter of Certain Digital Video Receivers, Broadband Gateways, and Related Hardware and Software Components*, Inv. No. 337-TA-1158 (“ITC Investigation”), which was instituted on May 22, 2019. The Commission in that proceeding is reviewing part of the final initial determination and has requested written submissions on the issues under review, 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).

In its recent updated Mandatory Notice (Paper 8), Patent Owner listed as a related proceeding, IPR2020-00800, -00801, -00802 (the “’445 IPRs”), where the Board declined to institute based on the ITC Investigation. *Comcast Cable Communications, LLC v. Rovi Guides, Inc.*, IPR2020-00800, IPR2020-00801, IPR2020-00802, Paper 10 (PTAB Oct. 22, 2020). But the ’445 IPRs are *not* related—they involved a different, unrelated patent, U.S. Patent No. 7,779,445.

Even so, Petitioner will be seeking rehearing of that decision as it is legally incorrect. The panel in those proceedings improperly weighed Petitioner’s timely filing of its Petition within the congressionally determined statutory period for doing so against institution.<sup>1</sup> Moreover, as other Board decisions have rightly noted, the ITC cannot cancel a patent claim—its determinations have no preclusive effect on invalidity—and thus ITC investigations and determinations should not be considered in determining whether to decline institution. *3Shape A/S v. Align Tech., Inc.*, IPR2020-00223, Paper 12 (PTAB May 26, 2020). Given the expedited schedules of ITC investigations, IPR petitions likely would be denied whenever there are co-pending ITC investigations under the rationale proposed by Rovi. Unless the invalidity of all of the claims of the ’855 Patent are resolved now before the Board, invalidity will not be litigated until many years from now. All claims of the ’855

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<sup>1</sup> See S. 23, 112th Cong. sec. 5(a), § 315(b) (2011) (as passed by the Senate) (proposing 6-month deadline); 157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) (statement of Sen. Kyl) (Companies find it “difficult to determine in the first few months of the litigation which claims will be relevant and how those claims are alleged to read on the defendant’s products” and that a one year deadline “afford[s] defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation.”).

Patent are asserted and remain at issue before the Central District of California in *Rovi Guides, Inc. v. Comcast Corporation*, No. 2:19-CV-03096 (C.D. Cal), but the case is stayed until the determination of the ITC Investigation becomes final—and with the appeals and any potential remands in the ITC investigation, a final decision by the district court is many years away. For example, none of the patents previously asserted by Rovi in April of 2016 have gone to trial in the district court with respect to Comcast’s invalidity claims or otherwise. *See, e.g., Rovi Guides, Inc., v. Comcast Corp., et al., Joint Status Report*, Case No. 1:16-cv-09826-JPO (D. Ct. S.D.N.Y.) (July 2, 2020). These IPRs are the most efficient way to address invalidity of the ’855 Patent’s claims.

Patent Owner expressly discusses the Board’s analysis of the *Fintiv* factors from the ’445 IPRs, suggesting that the cases are similarly situated and the same concerns about efficiency apply here. Paper 8 at 2-3; *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 9 (PTAB Mar. 20, 2020)). Patent Owner omits that in the ’445 IPRs, the Board declined to institute in part because the ITC had already found the asserted ’445 Patent claim invalid, which would “make it difficult for Patent Owner to maintain a district court proceeding” on the ’445 Patent independent claims. IPR2020-00800, Paper 10 at 16-17. The same situation does *not* exist here because the ITC’s initial determination did *not* address invalidity of the ’855 Patent claims, as Patent Owner acknowledges. IPR2020-00800, Paper 10 at 2-3. And the

ITC proceeding is limited to only two of the 63 claims of the '855 Patent. Patent Owner, not Petitioner, chose to drop 61 of the 63 claims (97% of the claims) from the '855 Patent in the ITC Investigation. The proceedings are thus not similarly situated, and there is no overlap on issues between the ITC and the IPRs. As for Patent Owner's allegation that the parties already expended considerable resources, the costs for both parties for litigating *invalidity* (as opposed to other issues) were minimized because invalidity was not tried and Patent Owner dropped 61 claims of the '855 Patent's 63 claims.

Patent Owner's suggestion that the discretionary denial in the '445 IPR relates to and should affect the outcome in this proceeding is incorrect.

Dated: November 3, 2020

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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing PETITIONER COMCAST CABLE COMMUNICATIONS, LLC'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8(a)(3) was served electronically via e-mail on November 3, 2020 on the following counsel of record for Patent Owner:

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