

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 IPR2017-00744  
Patent 8,621,512 B2

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Before JENNIFER S. BISK, BARBARA A. BENOIT, and TERRENCE W.  
McMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

### A. Background

Comcast Cable Communications, LLC (“Petitioner”) filed a Petition to institute *inter partes* review of claims 1–24 (“challenged claims”) of U.S. Patent No. 8,621,512 B2 (Ex. 1101, “the ’512 patent”) pursuant to 35 U.S.C. §§ 311–319. Paper 2 (“Pet.”). Rovi Guides, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). We instituted this review as to all challenged claims. Paper 8 (“Inst. Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response. Paper 14 (“Resp.”). Petitioner filed a Reply. Paper 19 (“Reply”). An oral hearing held on May 9, 2018. Paper 31 (“Tr.”).

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, Petitioner has demonstrated by a preponderance of the evidence that claims 1–24 of the ’512 patent are unpatentable.

### B. Additional Proceedings

The parties inform us that the ’512 patent is the subject of the following lawsuits: *Rovi Guides, Inc. v. Comcast Corporation*, No. 1:16-cv-9826 (S.D.N.Y.) and *Comcast Corporation v. Rovi Corporation*, No. 1:16-cv-3852 (S.D.N.Y.). Pet. 1–2; Paper 6, 2 (Patent Owner’s Submission of Updated Mandatory Notice Information). The ’512 patent has been asserted in *In the Matter of Certain Digital Video Receivers and Hardware and Software Components Thereof*, Investigation No. 337-TA-1001 (U.S. International Trade Commission).<sup>1</sup> Pet. 2; Paper 6, 2. The ’512 patent is

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<sup>1</sup> The International Trade Commission (ITC) determined that claims 1, 10, 13, and 22 of the ’512 patent were obvious. Ex. 1110, 2, 29–30. The ITC’s

also the subject of IPR2017-00742, which Final Decision we issue concurrently.

*C. The '512 Patent*

The '512 patent is titled, "Interactive Television Program Guide with Simultaneous Watch and Record Capabilities." Ex. 1101, (54). The Abstract says: "[a]n interactive television program guide system is provided in which a user may use the program guide to watch one program while simultaneously recording another program without interrupting the recording or viewing process." *Id.* at (57). Figure 2(b) is reproduced below:

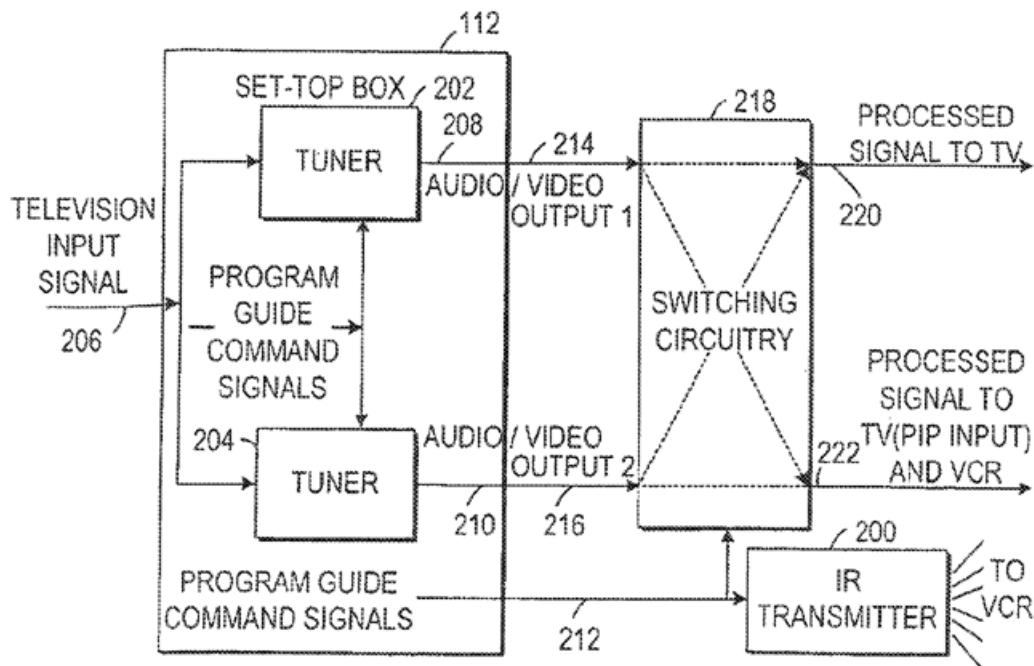


FIG. 2(b)

Figure 2(b) depicts a two tuner set-top box that provides one video output to the TV and the other video output to picture-in-picture ("PIP")<sup>2</sup> input or a

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decision has been appealed. *See* Tr. 4:17–19.

<sup>2</sup> Ex. 1101, 2:3.

VCR. *Id.* at 7:54–8:16. Figure 4(b), reproduced below, “shows an illustrative interactive television program guide viewer option for secondary function use (PIP cancellation) screen 410 which acts to alert the viewer to a conflict in tuner allocation and usage.” *Id.* at 10:25–28.

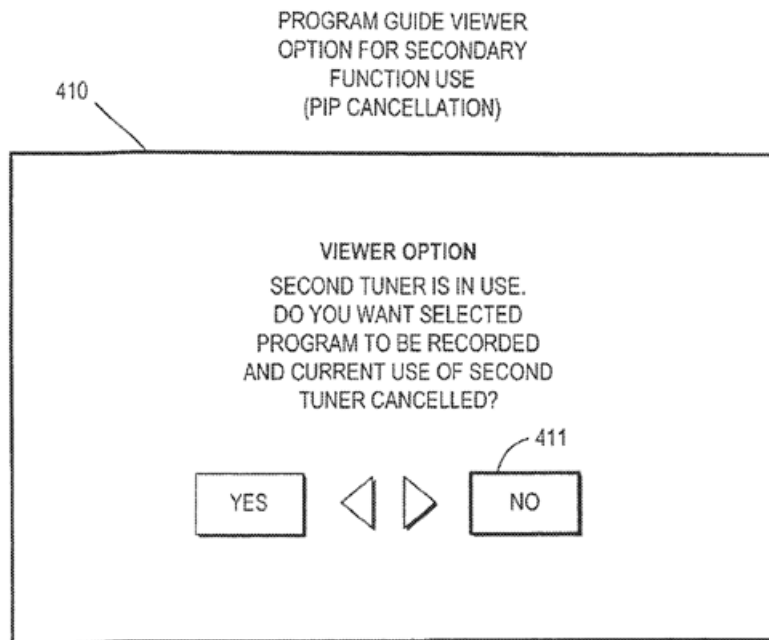


FIG. 4(b)

Figure 4(b) depicts a “viewer option selection screen.” *Id.* at 2:60–63. The detailed description of Figure 4(b) states:

If the user still desires to have the program recorded, the user will select “Yes.” The interactive television program guide will then redirect the use of the second tuner and initiate the record sequence. If the user desires to continue using the secondary function, the user will select “No.” The interactive television program guide will then cancel the record request and allow the user to continue using the second tuner for any of the available secondary functions.

*Id.* at 10:37–45.

As noted above, Petitioner challenges claims 1–24 (all issued claims)

of the '512 patent. There are two independent claims (1 and 13). Claim 1 is directed to a method, and claim 13 is directed to a system. Except for the introductory phrases referring to a method or system, the two sets of dependent claims (2–12 and 14–24) are nearly identical.<sup>3</sup>

Claim 1 recites:

1. A method for resolving a conflict when multiple operations are performed using multiple tuners controlled by an interactive television guide, the method comprising:

receiving a request to perform a tuning operation;

determining that neither a first tuner nor a second tuner are available to perform the requested tuning operation, wherein the first tuner and the second tuner are both capable of performing the tuner operation; and

in response to the determination, displaying an alert that provides a user with an opportunity to direct the interactive television program guide to cancel a function of the second tuner to permit the second tuner to perform the requested tuner operation.

Claim 13 recites:

13. A system for resolving a conflict when multiple operations are performed using multiple tuners controlled by an interactive television program guide, the system comprising:

a first tuner;

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<sup>3</sup> The parties treat the method and systems claims as essentially equivalent. However, we note the patentability of an apparatus claim “depends on the claimed structure, not the use or purpose of that structure.” *Catalina Marketing Int’l Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002).

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