

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 IPR2017-00951
Patent 8,006,263 B2

Before KEVIN F. TURNER, MICHAEL R. ZECHER, and
JESSICA C. KAISER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Comcast Cable Communications, LLC (“Comcast”), filed a Petition requesting an *inter partes* review of claims 1–19 of U.S. Patent No. 8,006,263 B2 (Ex. 1101, “the ’263 patent”). Paper 2 (“Pet.”). Patent Owner, Rovi Guides, Inc. (“Rovi”), filed a Preliminary Response. Paper 7. Taking into account the arguments presented in Rovi’s Preliminary Response, we determined that the information presented in the Petition established that there was a reasonable likelihood that Comcast would prevail in challenging claims 1–19 of the ’263 patent as unpatentable under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we instituted this *inter partes* review on September 20, 2017, as to all of the challenged claims, but not all the grounds presented by Comcast in its Petition. Paper 12 (“Dec. on Inst.”).

During the course of trial, Rovi filed a Patent Owner Response (Paper 18, “PO Resp.”), and Comcast filed a Reply to the Patent Owner Response (Paper 31, “Pet. Reply”). A consolidated oral hearing with related Cases IPR2017-00950, IPR2017-00952, IPR2017-01048, IPR2017-01049, IPR2017-01050, IPR2017-01065, IPR2017-01066, and IPR2017-01143 was held on June 19, 2018, and a transcript of the hearing is included in the record. Paper 41 (“Tr.”).

After all substantive briefing was complete, but before the consolidated oral hearing, the United States Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). Following *SAS*, the U.S. Patent and Trademark Office (“Office”) issued “Guidance on the impact of SAS on AIA trial

proceedings,” in which the Office took the policy position that a decision granting institution will institute on all of the challenged claims in the petition *and* all the grounds presented in the petition.¹ The U.S. Court of Appeals for the Federal Circuit has since endorsed this Office policy by explaining that “‘the petitioner’s petition, not the Director’s discretion, is supposed to guide the life of the litigation’ and ‘that the petitioner’s contentions, not the Director’s discretion define the scope of the litigation all the way from institution through to conclusion.’” *Adidas AG v. Nike, Inc.*, 894, F.3d 1256, 1258 (Fed. Cir. 2018) (quoting *SAS*, 138 S. Ct. at 1356–1357). In accordance with *SAS* and Office policy, we issued an Order modifying our Decision on Institution entered on September 20, 2017, to include review of all challenged claims and all grounds presented by Comcast in its Petition. Paper 38. The parties, however, agreed to waive briefing on the grounds we declined to institute in the Decision on Institution. *Id.* The parties also agreed to waive consideration of these previously non-instituted grounds at the consolidated oral hearing. *Id.*

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 1–19 of the ’263 patent. For the reasons discussed below, we hold that Comcast has demonstrated by a preponderance of the evidence that these claims are unpatentable under § 103(a).

¹ Available at <https://www.uspto.gov/patentsapplication-process/patent-trial-and-appeal-board/trials/guidance-impactsas-aia-trial>.

A. Related Matters

The '263 patent is involved in the following district court cases: (1) *Rovi Guides, Inc. v. Comcast Corp.*, No. 2:16-cv-00322 (E.D. Tex.), which has been transferred to the U.S. District Court for the Southern District of New York and is pending as *Rovi Guides, Inc. v. Comcast Corp.*, No. 1:16-cv-09826 (S.D.N.Y); and (2) *Comcast Corp. v. Rovi Corp.*, No. 1:16-cv-03852 (S.D.N.Y). Pet. 1–2; Paper 4, 2. The '263 patent also has been asserted against Comcast in a proceeding before the U.S. International Trade Commission (“ITC”) styled *In re Certain Digital Video Receivers and Hardware and Software Components Thereof*, No. 337-TA-1001. Pet. 2; Paper 4, 2.

In addition to this Petition, Comcast filed two other petitions challenging the patentability of claims 1–19 of the '263 patent (Cases IPR2017-00950 and IPR2017-00952). Pet. 3; Paper 4, 2. Comcast also filed other petitions challenging the patentability of certain subsets of claims in several patents owned by Rovi. Pet. 3.

B. The '263 Patent

The '263 patent, titled “Interactive Television Program Guide with Remote Access,” issued August 23, 2011, from U.S. Patent Application No. 11/246,392, filed on October 7, 2005. Ex. 1101, [54], [45], [21], [22]. The '263 patent is a continuation of U.S. Patent Application No. 10/927,814, filed on August 26, 2004, which, in turn, is a continuation of U.S. Patent Application No. 09/354,344, filed on July 16, 1999. *Id.* at [63]. The '263 patent also claims the benefit of U.S. Provisional Application No. 60/097,527, filed on August 21, 1998, and U.S. Provisional Application No. 60/093,292, filed on July 17, 1998. *Id.* at [60].

The '263 patent generally relates to interactive television program guide video systems and, in particular, to such systems that provide remote access to program guide functionality. Ex. 1101, 1:19–22. The '263 patent discloses that conventional interactive television program guide systems typically are implemented on set-top boxes located in the home of a user and, as a result, do not permit the user to perform program guide functions without the user being physically located in the same room as these systems. *Id.* at 1:37–45. Stated differently, conventional interactive television program guide systems require the user to be present in the home to access important program guide features, such as program reminders, parental controls, and program recording. *Id.* at 2:19–22. The '263 patent purportedly addresses this and other problems by providing an interactive television program guide system that allows a user to access certain features of the program guide remotely and establish settings for those features. *Id.* at 2:23–28.

Figure 1 of the '263 patent, reproduced below, illustrates a schematic block diagram of the system in accordance with the present invention. Ex. 1101, 3:45–46, 4:29–30.

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