Trials@uspto.gov
571–272–7822

Paper No. 31
Entered: May 38, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ROVI GUIDES, INC.,
Patent Owner.

Cases
IPR2017-00950 (Patent 8,006,263 B2)
IPR2017-00951 (Patent 8,006,263 B2)
IPR2017-00952 (Patent 8,006,263 B2)
IPR2017-01048 (Patent 8,578,413 B2)
IPR2017-01049 (Patent 8,578,413 B2)
IPR2017-01050 (Patent 8,578,413 B2)
IPR2017-01065 (Patent 8,046,801 B2)
IPR2017-01066 (Patent 8,046,801 B2)
IPR2017-01143 (Patent 8,046,801 B2)[1]

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

TURNER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

---

[1] This Order addresses issues that are identical in six of the nine cases. We, therefore, exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

On April 24, 2018, the 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*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018) (hereinafter "*SAS*"). In the above-identified cases, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims in each of the patents is unpatentable. Of those cases, the following instituted on less than all of the grounds proposed by Petitioner:

IPR2017-00950 (Patent 8,006,263 B2): *compare* Paper 12, 8, *with id*. at 37;
IPR2017-00951 (Patent 8,006,263 B2): *compare* Paper 12, 9, *with id*. at 43;
IPR2017-01048 (Patent 8,578,413 B2): *compare* Paper 9, 8, *with id*. at 37;
IPR2017-01049 (Patent 8,578,413 B2): *compare* Paper 9, 8, *with id*. at 40;
IPR2017-01065 (Patent 8,046,801 B2): *compare* Paper 8, 8, *with id*. at 32;
IPR2017-01066 (Patent 8,046,801 B2): *compare* Paper 9, 8, *with id*. at 33.

With respect to the six cases cited above, we modify our Decision on Institution to include all of the challenged claims and all of the grounds presented in the Petitions. *See* Guidance on the Impact of SAS on AIA Trial Proceedings (April 26, 2018), available at https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial.

On May 2, 2018, we held a conference call with the parties, Comcast Cable Communications, LLC ("Comcast") and Rovi Guides, Inc. ("Rovi"), to discuss the impact of the holding in *SAS* on the current schedule, and whether the parties wished to change the schedule or submit further briefing. On May 7, 2018, we held another conference call with the parties to clarify the options available regarding potential schedule changes or the submission of further briefing in light of the holding in *SAS*. In response thereto, in an email of May 11, 2018, the parties indicated that they have agreed to waive

briefing on the previously non-instituted grounds, as discussed above. In addition, the parties agreed to waive consideration of the previously non-instituted grounds at the consolidated oral hearing. *See*, *e.g.*, IPR2017-00950, Paper 36 (consolidating all nine cases into one oral hearing now scheduled on June 19, 2018).

In consideration of the foregoing, it is hereby:

ORDERED that our Decisions on Institution are modified to include review of all challenged claims and all grounds presented in the respective Petitions; and

FURTHER ORDERED that no additional briefing on the previously non-instituted grounds will be considered in the above-cited instituted proceedings, and that no consideration or discussion of the previously non-instituted grounds will be allowed at the consolidated oral hearing.

IPR2017-00950 et al.
Patents 8,006,263 B2; 8,578,413 B2; 8,046,801 B2;

For PETITIONER:

Frederic M. Meeker
Bradley C. Wright
Scott M. Kelly
Azuka C. Dike
Joshua Davenport
Camille Sauer
Bennett A. Ingvoldstad
BANNER AND WITCOFF, LTD.
fmeeker@bannerwitcoff.com
bwright@bannerwitcoff.com
skelly@bannerwitcoff.com
adike@bannerwitcoff.com
jdavenport@bannerwitcoff.com
csauer@bannerwitcoff.com
bingvoldstad@bannerwitcoff.com

For PATENT OWNER:

Mark D. Rowland
Gabrielle E. Higgins
Scott A. McKeown
James Batchelder
David Chun
Scott S. Taylor
Andrew Sutton
Josef Schenker
Henry Huang
ROPES & GRAY LLP
Mark.Rowland@ropesgray.com
Gabrielle.Higgins@ropesgray.com
Scott.McKeown@ropesgray.com
James.Batchelder@ropesgray.com
David.Chun@ropesgray.com
Scott.Taylor@ropesgray.com
Andrew.Sutton@ropesgray.com
Josef.Schenker@ropesgray.com
Henry.Huang@ropes.gray.com