# 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.

## PROMPTU SYSTEMS CORPORATION,
Patent Owner.

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Case IPR2018-00340
Patent 7,260,538 B2

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Before JAMESON LEE, ROBERT L. KINDER, and
ALEX S. YAP, *Administrative Patent Judges*.

YAP, *Administrative Patent Judge*.

## FINAL WRITTEN DECISION
*35 U.S.C. § 318(a)*

# I. INTRODUCTION

Petitioner, Comcast Cable Communications, LLC. ("Comcast"), filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–7, 17–24, and 33 of U.S. Patent 7,260,538 B2 (Ex. 1001, "the '538 Patent"). We instituted review of claims 1–7, 17–24, and 33 on all grounds asserted in the Petition. Paper 10. Patent Owner, Promptu Systems Corporation ("Promptu"), filed a Response. Paper 20 ("Resp."). Petitioner filed a Reply (Paper 29) and Patent Owner filed a Sur-Reply (Paper 37). An oral hearing was held on January 28, 2019. A copy of the transcript for the oral hearing has been entered as Paper 55 ("Tr.").

As discussed below, Petitioner has not shown, by a preponderance of the evidence, that any of claims 1–7, 17–24, and 33 is unpatentable under any asserted grounds.

## A. Related Matters

The '538 Patent is the subject of a pending civil action, *Promptu Systems Corporation v. Comcast Corporation and Comcast Cable Communications, LLC*, Case No. 2:16-cv-06516 (E.D. Pa.). Patent Owner's Mandatory Notices (Paper 6), 2. Another petition for *inter partes* review has been filed by Petitioner on this patent in IPR2018-00341, which is pending before the Board. Pet. xii; *see also* IPR2018-00341, Paper 1. According to Patent Owner, the District Court stayed the pending civil action after the Board instituted trial in this matter. Patent Owner's Updated Mandatory Notice (Paper 16), 2.

## B. The '538 Patent

The '538 Patent, titled "Method and Apparatus for Voice Control of a Television Control Device," was issued on August 21, 2007. Ex. 1001, [45].

It issued from U.S. Patent Application 10/338,591, filed on January 7, 2003, and claims the benefit of U.S. Provisional Application No. 60/346,899 filed on January 8, 2002. *Id.* at [21], [22], [60]. The '538 Patent generally relates to a "method and apparatus [] for remotely processing voice commands for controlling a television." Ex. 1001, Abstract. Figure 1 of the '538 Patent is reproduced below.
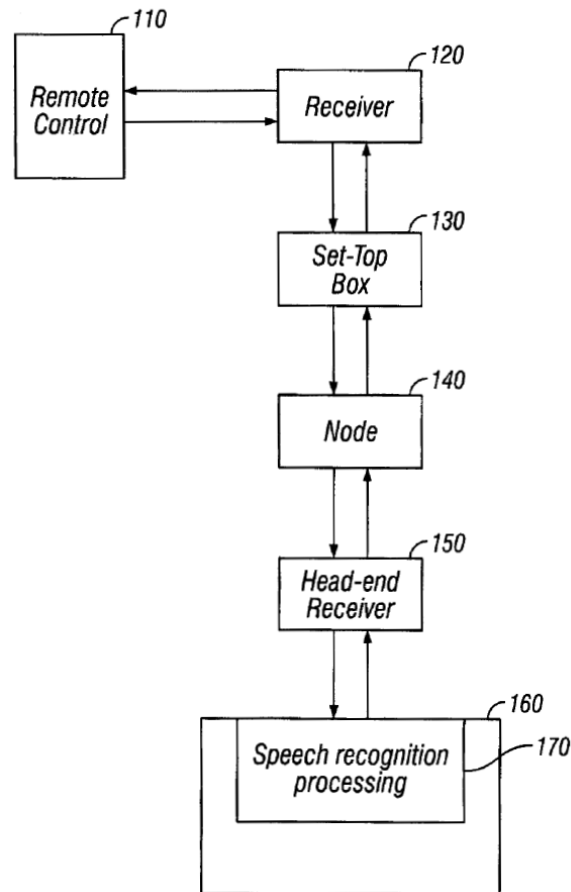


**FIG. 1**

Figure 1 "is a diagram illustrating elements of the voice control television system according to the invention." *Id.* at 2:52–53. According to the Specification, a "problem with the prior art voice recognition systems is that they require a sophisticated voice recognition system in close proximity to

the user, requiring individual units[,] which is quite costly." *Id.* at 1:59–62. The Specification discloses "method and apparatus [] for remotely processing voice commands," purportedly solving one of the alleged problems in prior art systems. *Id.* at Abstract. A user's voice command "is received by a microphone contained in a [] remote control." *Id.* at 2:23–25. The microphone in the remote control "is activated by the depression of a push-to-talk (PTT) button or by word activation." *Id.* at 2:41–42. "The voice command is modulated and wirelessly transmitted to a wireless receiver connected to the set-top box." *Id.* at 2:25–26. "The voice command is then transmitted, for example, to a central processing station located at a cable television head-end unit[, which] processes the voice command for voice command recognition." *Id.* at 2:29–33. "Once the voice command is determined a command function is created [and] transmitted back to the set-top box where the set-top box performs the command function." *Id.* at 2:33–37.

### C.  Challenged Claims

Claims 1, 2, 18, and 19 are independent. Claims 1 and 2 are method claims "for providing voice recognition processing at a cable television head-end unit." *Id.* at 9:20–21, 41–42. Claims 18 and 19 are apparatus claims directed to apparatus "for providing voice recognition processing at a cable television head-end unit" (*id.* at 11:26–27, 56–57). Claims 3–7 and 17 depend directly or indirectly from claim 2. Claims 20–24 and 33 depend directly or indirectly from claim 19. Independent claims 1 and 18, reproduced below, are illustrative of the challenged claims.

1.      A method for providing voice recognition processing at a cable television head-end unit for a plurality of voice controlled television cable set-top boxes in a cable television network, comprising the steps of:

a television remote control receiving user-activated indication of a voice command;

receiving said voice command through a microphone associated with said television remote control;

said television remote control wirelessly transmitting a signal representing said voice command to a cable set-top box;

said cable set-top box transmitting a signal representing said voice command via cable television link to a remotely located head-end unit;

processing said voice command at said head-end unit;

the head-end unit deriving a set-top-box-compatible command function corresponding to said voice command;

the head-end unit transmitting said command function to said cable set-top box via the cable television link;

performing said command function at said cable set-top box.

Ex. 1001, 9:20–40.

18.      An apparatus for providing voice recognition processing at a cable television head-end unit for a plurality of voice controlled television cable set-top boxes in a cable television network, comprising:

a television remote control including: activation means for receiving user-activated indication of a voice command, microphone means for receiving the voice command, and transmission means for wirelessly transmitting a signal representing the voice command to a cable television controller;

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