

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

PROMPTU SYSTEMS CORPORATION,
Patent Owner.

Case IPR2018-00341
Patent 7,260,538 B2

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 34, 35, 37, 40, and 41 of U.S. Patent 7,260,538 B2 (Ex. 1001, “the ’538 Patent”). We instituted review of claims 34, 35, 37, 40, and 41 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 34, 35, 37, 40, and 41 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 IPR2017-00340, which is pending before the Board. Pet. xi; *see also* IPR2018-00340, 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.

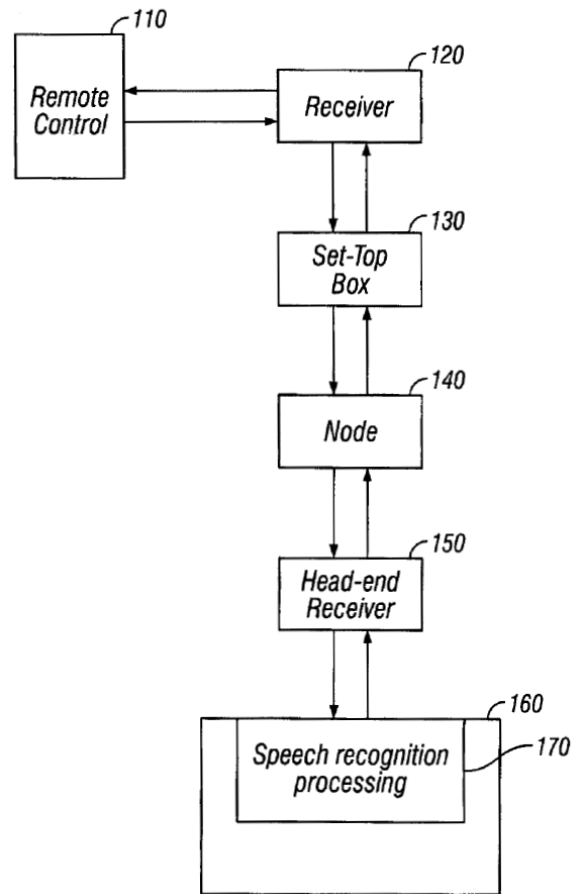


FIG. 1

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 34, 40, and 41 are independent. Claims 34 and 40 are system claims directed to “[a] centralized multi-user voice operated television control system” (*id.* at 13:37–61, 14:37–64), while claim 41 is a method claim directed to “[a] method for operating a centralized multi-user voice operated television control system that includes” (*id.* at 14:65–16:14). Claims 35 and 37 depend directly from claim 34. Independent claims 34, 40, and 41, reproduced below, are illustrative of the challenged claims.

34. A centralized multi-user voice operated television control system, comprising:

television remote controls configured to directly and wirelessly control television sets and additionally to

receive user voice input and wirelessly transmit first output representative of the voice input to television set-top boxes;

television set top boxes configured to receive television input signals via cable television link and provide television output signals compatible with television sets, the set top boxes additionally responsive to receiving the first output from the television remote controls to transmit representative second output to a central processing station via the cable television link;

a centralized processing station configured to receive and process second output from a multitude of television set top boxes by applying voice recognition to the second output to identify user-intended voice commands, to derive set-top-box-compatible instructions to carry out the identified voice commands, and returning signals representing the instructions to respective top boxes via the cable television link;

where the set top boxes are further responsive to receiving the signals representing the instructions from the central processing station to execute the instructions.

Ex. 1001, 13:37–61.

40. A centralized multi-user voice operated television control system, comprising:

a plurality of television remote control means each for directly and wirelessly controlling television sets and additionally receiving user voice input and wirelessly transmitting first output representative of the voice input to a television set-top box means;

a plurality of television set top box means each for receiving television input signals via cable television link and providing television output signals compatible with television sets, and responsive to receiving the first output from one of the television remote control means to transmit representative second output to a central processing station via the cable television link;

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