Fed. Circ. Revives Rovi Patent That Comcast Got PTAB To Ax

By **Jasmin Jackson**

Law360 (April 19, 2022, 7:52 PM EDT) -- The Federal Circuit has reversed a Patent Trial and Appeal Board decision to invalidate an interactive television patent asserted against Comcast by media company Rovi Guides, holding Tuesday that the PTAB used an incorrect claim construction to find that all of the claims were obvious based on prior art.

A three-judge panel said in a nonprecedential opinion that the PTAB wrongfully sided with Comcast Cable Communications LLC in May 2020 after an inter partes review of a patent held by Rovi Guides Inc., U.S. Patent No. 9,369,741, which covers a system that allows users to record or playback TV programs. The U.S. International Trade Commission had previously found the same patent valid, but said Comcast didn't infringe it.

The circuit judges found that "no reasonable fact finder" could have determined that a 2001 printed publication cited by Comcast — depicting a notification service for broadcast programs — rendered all of the Rovi patent's claims invalid. According to the opinion, the PTAB decision was based on flawed claim constructions.

"Put simply, the notification service precedes any determination of availability to a specific user," the panel ruled. "But the claim language requires the indication (i.e., the notification) to be based on a determination of availability to a specific user."

Rovi launched patent infringement litigation against Comcast in California federal court in January 2018 and argued that Comcast's personalized TV guide, known as X1, infringed six patents for video playback technology, including the '741 patent.

According to the complaint, Comcast had spent over $250 million on a fixed-term license for Rovi's technology but allegedly began infringing the patents after the license expired in March 2016.

The following November, Comcast petitioned the PTAB for an inter partes review of the '741 patent. According to the telecommunications company, the system's capabilities were "well-known" and disclosed in multiple printed publications prior to the patent being issued to Rovi.

The PTAB agreed with Comcast in its May 2020 decision and held that all 26 claims in Rovi's '741 patent were obvious based on eight different prior art combinations.

Rovi initiated an appeal against the PTAB ruling at the Federal Circuit in July 2020. According to Rovi's

opening brief the following December, Comcast utilized a "fatally flawed" obviousness theory to ax the patent for its "groundbreaking invention."

The U.S. Patent and Trademark Office — the body in which the PTAB resides — was allowed to intervene in the appeal in January 2021 after Comcast withdrew from the appellate proceedings in November 2020.

The Federal Circuit panel only reviewed one of the prior arts cited by Comcast — which had been found to invalidate all the claims — in its Tuesday opinion. According to the ruling, the circuit judges used the "broadest reasonable interpretation" of the claim terms to find that the patent was not obvious based on that prior art.

The USPTO declined to comment on the panel's ruling Tuesday.

Comcast and counsel for Rovi did not immediately respond to requests for comment on Tuesday.

The patent-in-suit is U.S. Patent No. 9,369,741.

Chief Circuit Judge Kimberly A. Moore and Circuit Judges Richard G. Taranto and Todd M. Hughes sat on the panel for the Federal Circuit.

Rovi is represented by Michael E. Joffre, Kristina C. Kelly, Jason D. Eisenberg, William Milliken And Ryan C. Richardson of Sterne Kessler Goldstein & Fox PLLC.

The USPTO is represented in-house by Monica B. Lateef, Peter J. Ayers, Kakoli Caprihan, Thomas W. Krause and Farheena Y. Rasheed.

The suit is Rovi Guides Inc. v. Vidal, case number 20-1994, in the U.S. Court of Appeals for the Federal Circuit.

—Additional reporting by Dani Kass. Editing by Emily Kokoll.