

PTAB Nixes Comcast Challenge To Rovi Patent As Redundant

By **Matthew Bultman**

Law360 (May 21, 2019, 5:21 PM EDT) -- The Patent Trial and Appeal Board said Monday that it would review only one of two challenges Comcast brought against a Rovi patent covering an interactive TV system, finding the second was redundant.

The PTAB was deciding two petitions for inter partes review that Comcast filed on the same day in November. Both challenges targeted the same patent claims, which the media company argues are invalid because they would have been obvious.

While Comcast's main piece of evidence was different in the two challenges, the PTAB said the cases were similar enough that simultaneous IPRs would be inefficient.

"On the record before us, we do not find the differences between the asserted art and arguments to be sufficiently material to outweigh the inefficiencies and costs of instituting an additional proceeding," the board wrote.

The PTAB in recent weeks has designated precedential or informative various decisions dealing with the board's discretion to deny IPR. Monday's panel cited one of those, *Deeper v. Vexilar*, saying it needs to interpret IPR rules to "secure the just, speedy, and inexpensive resolution of every proceeding."

The patent challenges are part of a broader legal fight between the companies that broke out after Comcast's license agreement with Rovi expired in 2016. The dispute includes multiple proceedings in district court and the U.S. International Trade Commission.

In 2017, the ITC banned the import of certain Comcast set-top boxes after finding the company and its video equipment suppliers infringed Rovi's patented technology. Comcast has appealed the ruling to the Federal Circuit.

The PTAB was asked to review this particular patent in the wake of an infringement lawsuit Rovi filed in California federal court.

Finding there was "overlap" between Comcast's two petitions, the PTAB earlier this month ordered the company to explain the differences between the challenges. The board also told Comcast to rank the petitions in the order it wanted the panel to consider them.

Comcast obliged but also pointed the finger at Rovi, which it said has alleged infringement of close to 40 patents and over 1,000 claims.

“The burden on the board in having to deal with these patents is a direct result of Rovi’s litigation strategy,” Comcast wrote.

Agreeing to institute review in one case Monday, the PTAB said Comcast had shown some patent claims were likely invalid. But the board said Comcast hadn’t identified sufficient differences in the primary references used in the two cases to justify institution in both.

“[I]n light of the specific facts of this case, we exercise our discretion to deny institution of the present petition ... in light of [Comcast’s other request for review], which we are instituting,” the board wrote.

Comcast is facing a similar issue in a series of challenges it brought against a different Rovi patent last year, when it filed five petitions. The PTAB has ordered Comcast to rank the petitions as well and explain the differences. The board has not yet reached institution decisions in those cases.

Attorneys for Rovi declined to comment. Counsel for Comcast could not immediately be reached.

The patent at issue is U.S. Patent No. 9,369,741.

Comcast is represented by Frederic Meeker, Bradley Wright, Scott Kelly, Kirk Sigmon, H. Wayne Porter, Craig Kronenthal, John Hutchins and Blair Silver of Banner & Witcoff Ltd.

Rovi is represented by Jason Eisenberg and Ryan Richardson of Sterne Kessler Goldstein & Fox PLLC.

The cases are Comcast Cable Communications LLC v. Rovi Guides Inc., case numbers IPR2019-00231 and IPR2019-00232, at the Patent Trial and Appeal Board.

--Editing by Haylee Pearl.