

PTAB Presses Rovi To Explain Why Set-Top Tech Isn't Obvious

By Christopher Cole

Law360 (February 13, 2020, 8:02 PM EST) -- Patent Trial and Appeal Board judges asked Rovi Guides Inc. on Thursday why it thinks a patent on a cable set-top box interactive system can survive a challenge from Comcast, which points to earlier technology to argue that the invention was obvious.

Rovi has been embroiled for years in a dispute with Comcast Cable Communications LLC that has also landed at the U.S. International Trade Commission, which banned import of certain Comcast boxes over the issue. The cable giant is still fighting the ITC ruling through a Federal Circuit appeal.

Rovi's patent infringement suit against Comcast over the set-top boxes, which allow users to play an entire show after its scheduled time by prompting the viewer with a replay option, led to Comcast to counter by challenging the patent.

The dispute, just one piece of a broader fight that followed the expiration of Comcast's license with Rovi in 2016, turns mainly on how Rovi interprets the phrase "available to a user" as the box determines whether someone can get the full show after it starts.

Rovi maintains that the disputed claim at the center of Comcast's petition for inter partes review involves a two-part analysis — first, finding out if an archived copy of the video is available to a user, and second, determining that the specific user does or doesn't have access. The second part depends on whether the user paid for the service, according to Rovi.

But Comcast said Rovi views the patent claim too narrowly. Rather, the cable company argued, the claim is just like prior art, referred to in proceedings as the "Sie" reference, that involves posting an indicator on the screen that a video is available to anyone turning on a show partway through. The user could be a "club member" who subscribes to a service like HBO, or someone who chooses to buy it when asked, Comcast said.

The PTAB's three-judge panel pushed both sides in oral arguments Thursday on how the referenced Sie invention works, versus how Rovi's claim in its own patent, U.S. Patent No. 9,369,741, should be read by comparison.

One question that arose in setting the prior art and Rovi's patent side-by-side was what determinations must take place before a video playback can be accessed — or before a notification pops up on the user's screen that it can be.

Administrative Patent Judge Barbara A. Parvis asked Comcast whether it was "arguing that it would have been obvious to take the data ... and actually perform a determination before displaying the notification."

Comcast's legal counsel, John Hutchins of Banner & Witcoff Ltd., told the judge that while there's no disputing that the set-top system has the data to figure out whether the user can access a playback, Rovi was "unduly narrowing" its claim to include finding out if the user is a paid subscriber.

Nothing in Rovi's patent specification limits "available to a user" to whether a user has already purchased or has preauthorized rights to a program, Hutchins said.

But Rovi's lawyer, Ryan Richardson of Sterne Kessler Goldstein & Fox PLLC, argued precisely that such a reading of the claim prevents the Sie reference from defeating the patent. The key difference is that going beyond Sie, the '741 requires that a video be "available to a user" — not just that an archived copy can, one way or another, be viewed by someone using the box. Rovi's analysis involves both parts, he said.

Unlike Rovi's claim, he said, the Sie invention was designed to market "club" programs by providing the option to buy a subscription service or access a promotional or complimentary copy, so it would make no sense to bring in the verification step that's detailed in Rovi's claim. "There would be no advertising or marketing effect to it," he said.

Richardson argued that Comcast was trying to read out the phrase "to a user" that follows "available," impermissibly changing the meaning of the claim. "Every word of the claim needs to be given its proper weight," Richardson said.

As the two sides await word from the PTAB as to whether the patent survives America Invents Act review, the parallel dispute over the ITC's ruling continues.

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

The PTAB was asked to review the '741 patent in the wake of an infringement lawsuit Rovi filed in California federal court. In May, the board agreed to review only one of two challenges that Comcast filed, saying that one was redundant.

Administrative Patent Judges Barbara A. Parvis, Karl D. Easthom and Scott E. Bain sat on the panel for the Patent Trial and Appeal Board.

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 R. Hutchins and Blair Silver of Banner & Witcoff Ltd.

Rovi is represented by Jason Eisenberg and Ryan C. 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.

--Additional reporting by Matthew Bultman. Editing by Bruce Goldman.