

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

PROMPTU SYSTEMS CORPORATION : CIVIL ACTION
: :
v. : No. 16-6516
: :
COMCAST CORPORATION, et al. :

ORDER

AND NOW, this 25th day of October, 2024, upon consideration of Plaintiff Promptu Systems Corporation’s August 22, 2024 letter to the Court regarding the parties’ discovery disputes concerning Defendants Comcast Corporation and Comcast Cable Communications, LLC’s (collectively, “Comcast”) election of prior art references; Comcast’s August 29, 2024 letter response thereto; and Promptu’s August 31, 2024 letter in reply—and following a September 26, 2024 discovery conference—it is ORDERED:

- (1) Promptu’s request for an order directing Comcast to narrow the prior art references it intends to present at trial is DENIED.¹

¹ The parties agree Comcast is limited to 12 prior art references pursuant to this Court’s order of May 12, 2022, which incorporated the parties’ agreement that the total number of asserted prior art references would not exceed six times the number of patents at issue. *See* ECF No. 298 at 2 n.3 (limiting Comcast to a total of “18 prior art references . . . , as long as there are 3 patents asserted” pursuant to the parties’ agreement). Promptu claims Comcast’s July 17, 2024 Amended Election of Asserted Prior Art far exceeds this 12-reference limit and asks the Court to require Comcast to narrow its election to include only 12 prior art references. Comcast maintains the Amended Election includes only 12 references.

On July 3, 2024, Comcast produced its Third Amended Invalidity and Non-Infringement Contentions as well as its Election of Prior Art, in accordance with the scheduling order in this case. (Although an excerpt from the Third Amended Invalidity and Non-Infringement Contentions was submitted to the Court as part of the briefing of this discovery dispute, the original Election is not before the Court.) Because the Election included more than 12 references, Promptu responded by asking Comcast to narrow it. On July 17, 2024, Comcast produced the Amended Election now at issue.

The Amended Election groups the elected prior art references into two categories: (1) “Issued Patents and Patent Applications,” consisting of six patents and one provisional application, and (2) “Other Printed Publications.” The “Other Printed Publications” category purports to

disclose five references, including two “system” references: Time Warner Cable’s Full Service Network (FSN) System and BBN HARK Systems’ Speech Recognition System, each with the notation that the system is “as disclosed by, *inter alia*, the contemporaneous evidence, testimony of witnesses with knowledge, and various references in Exhibits B1 and C1 to Defendants’ Third Amended Invalidity and Non-Infringement Contentions, including but not limited to” a bulleted list of specific references. Each of the specific references cited by Comcast as disclosing the FSN and BBN systems was previously included as an independent prior art reference in the “Other Printed Publications” category of Comcast’s July 3, 2024 Third Amended Invalidity and Non-Infringement Contentions (and, presumably, in the same category of Comcast’s original July 3, 2024 Election).

The parties dispute whether each of these system references counts as a single reference or as multiple references. Comcast argues each system counts as a single reference, citing the Federal Circuit’s Model Order Limiting Excess Patent Claims and Prior Art, which the parties previously agreed to follow in this case. The Model Order limits the number of prior art references that may be asserted against each patent in suit, but provides that “a prior art instrumentality (such as a device or process) and associated references that describe that instrumentality shall count as one reference, as shall the closely related work of a single prior artist.” ECF No. 283-2 at 21 n.2, 26 n.2. Comcast argues it has followed the Model Order by grouping the FSN and BBN systems with the associated references describing those prior art instrumentalities.

By contrast, Promptu maintains the Model Order’s instrumentality provision does not apply here because Comcast’s Amended Election identifies no “discrete system[s].” Promptu Aug. 31, 2024 Letter at 2. Specifically, Promptu contends that while Comcast previously identified certain demonstrations and systems as prior art in its Third Amended Invalidity and Non-Infringement Contentions, these systems were in the categories of “§ 102(a) Knowledge/Use,” “§ 102(b) Use/Sale,” and “§ 102(g)(2) Prior Invention.” In its Amended Election, however, Comcast identified only “Issued Patents and Patent Applications” and “Other Printed Publications,” which Promptu contends are not systems. Promptu also argues Comcast cannot rely on system prior art because it has never produced a working system of any FSN or BBN product but has made only limited items relating to the FSN system available for inspection. Finally, Promptu asserts that even if the FSN and BBN systems are instrumentalities, Comcast must still narrow its election, having previously described “14 discrete systems involving FSN or BBN” in its Invalidity and Non-Infringement Contentions. *Id.* Promptu claims each of these discrete systems should count as a separate reference.

The Court is not persuaded that Comcast’s approach in its Amended Election is impermissible. Although listed in the “Other Printed Publications” category, the FSN and BBN systems are described as systems that are disclosed by other evidence, including witness testimony and other references. Notably, these same systems were also included in the “Other Printed Publications” category of Comcast’s Third Amended Invalidity and Non-Infringement Contentions, albeit without the non-exclusive lists of specific references that disclose the system. *See* Third Amended Invalidity and Non-Infringement Contentions 12-13 (listing as references “Time Warner Cable’s Full Service Network System” and “BBN HARK Systems’ Speech Recognition System,” both “as disclosed by, *inter alia*, the contemporaneous evidence, testimony of witnesses with knowledge, and various references in Exhibits B1 and C1 to Defendants’ Third Amended Invalidity and Non-Infringement Contentions”).

- (2) Promptu’s request for an order directing Comcast to identify the date on which it or its counsel learned of each patent, patent application, and printed publication listed in its July 17, 2024 Amended Election of Asserted Prior Art is GRANTED.² Comcast shall provide this information to Promptu within seven days of the date of this order.

At the discovery conference, Comcast explained that because of their age, the FSN and BBN systems no longer exist and it will therefore rely on the testimony of witnesses who worked on were otherwise involved with the systems and documents to demonstrate the systems’ existence and what they could do. Tr. 55-56, 68, Sept. 26, 2024, ECF No. 386. This approach is permissible. “Multiple references can be used ‘to demonstrate and support how [a prior art system] functioned at the time, not as distinct references.’” *Arendi S.A.R.L. v. LG Elecs., Inc.*, Civ. No. 12-1595, 2022 WL 22401011, at *9 (D. Del. Apr. 8, 2022) (alteration in original) (citation omitted); *see also IOENGINE, LLC v. PayPal Holdings, Inc.*, 607 F. Supp. 3d 464, 512 (D. Del. 2022) (recognizing that “[c]ourts . . . have allowed the functions of prior art devices to be established through the use of documents and testimony” in a case in which a defense expert did not test the device in question but instead relied on 44 documents describing it); *Radware, Ltd. v. F5 Networks, Inc.*, Civ. No. 13-2024, 2016 WL 861065, at *1-2 (N.D. Cal. Mar. 5, 2016) (holding a party that sought to establish a prior art system through testimony, publications, and source code could rely on product manuals to describe the functionality of the single prior art system); *IP Innovation LLC v. Red Hat, Inc.*, Civ. No. 2:07-cv-447, 2010 WL 9501469, at *4 (E.D. Tex. Oct. 13, 2010) (holding multiple references may be used to describe or “recreate” a single prior art system). And when references are used “as evidence about how a single prior art system worked,” the system itself constitutes a single prior art reference. *British Telecomm. PLC v. IAC/InterActive Corp.*, Civ. No. 18-366, 2020 WL 3047989, at *6 (D. Del. June 8, 2020).

The Court is also not persuaded Comcast should be precluded from treating each system as a single prior art reference for purposes of the 12-reference limit. Whether these systems in fact constitute single prior art references will be subject to challenge at a later stage. *See Kove IO, Inc. v. Amazon Web Servs., Inc.*, Civ. No. 18 C 8175, 2024 WL 450028, at *21-24 (N.D. Ill. Feb. 6, 2024) (addressing whether claimed prior art system with multiple versions constituted a single prior art reference at the summary judgment stage); *Arendi S.A.R.L.*, 2022 WL 22401011, at *9-11 & n.12 (considering, at the summary judgment stage, whether alleged infringers could “rely on a purported ‘system’ as prior art reference when the ‘system’ is described by multiple references as including different ‘versions,’ ‘iterations,’ or ‘instantiations’”).

Promptu’s request that Comcast be directed to narrow its prior art references is therefore denied.

² Promptu also asks the Court to order Comcast to identify the date it or its counsel learned of each patent, patent application, and printed publication listed in its Amended Election of Asserted Prior Art. The Court agrees with Promptu that this information is both relevant to its invalidity defense of inter partes review (IPR) estoppel and not protected as work product. This request is therefore granted.

By statute, a petitioner in an IPR proceeding that results in a final written decision may not assert in a later civil action that a claim reviewed in the IPR proceeding “is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” 35 U.S.C. § 315(e)(2). “References that an alleged infringer ‘reasonably could have raised’ include ‘any references that were known to the petitioner or that could reasonably have been discovered by a skilled searcher conducting a diligent search.’” *Wasica Fin. GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448, 453 (D. Del. 2020) (citation omitted).

Comcast argues the dates it learned of the references in its Amended Election are irrelevant because its invalidity position relies on system prior art—the FSN and BBN systems—to which IPR estoppel does not apply. “In general, IPR estoppel does not apply to device art, because ‘a petitioner cannot use an IPR to challenge the validity of a patent claim . . . based on prior art products or systems.’” *IOENGINE, LLC*, 607 F. Supp. 3d at 511 (alteration in original) (quoting *Medline Indus., Inc. v. C.R. Bard, Inc.*, No. 17 C 7216, 2020 WL 5512132, at *3 (N.D. Ill. Sept. 14, 2020)). Here, however, the Amended Election asserts the FSN and BBN systems are disclosed by numerous printed publications. And “[w]hether and how § 315(e)(2) applies to products and systems that are related to printed publications or patents that could have been raised at IPR is a question that has not been definitively resolved.” *Singular Computing LLC v. Google LLC*, 668 F. Supp. 3d 64, 70 (D. Mass. 2023). Within the Third Circuit, some courts have held IPR estoppel extends to device art where the device is cumulative of a patent or printed publication that could have been raised during the IPR proceedings—i.e., where the device is “simply a printed publication invalidity theory in disguise.” *E.g., IOENGINE, LLC*, 607 F. Supp. 3d at 513; *Wasica Fin. GmbH*, 432 F. Supp. 3d at 453. Other courts have held estoppel does not apply to any invalidity theory that relies even in part on a prior art system. *E.g., IPA Techs. v. Microsoft Corp.*, No. 18-1, 2024 WL 1797394, at *6-7 (D. Del. Apr. 25, 2024) (characterizing this as the majority position). The Court need not choose sides in the debate at this juncture. Rather, it is sufficient that Promptu has raised the defense of IPR estoppel, and the information it seeks is relevant to that defense.

In addition, Comcast argues the dates Promptu seeks are subject to work product protection as they relate to counsel’s investigation. The Court disagrees. The work product doctrine applies to “documents and tangible things that are prepared in anticipation of litigation or for trial by or for another party or its representative (including the other party’s attorney . . .).” Fed. R. Civ. P. 26(b)(3)(A). It does not preclude a party from discovering “relevant facts known or available to the other party, even though such facts are contained in a document which is not itself discoverable.” *Raso v. CMC Equip. Rental, Inc.*, 154 F.R.D. 126, 128 (E.D. Pa. 1994) (citation omitted).

The date Comcast learned of the references included in its Amended Election of Asserted Prior Art is the type of factual information courts require parties to disclose over work product and attorney-client privilege objections. *See Panasonic Corp. v. Getac Tech. Corp.*, Civ. No. 19-01118, 2020 WL 6163239, at *1 (C.D. Cal. Oct. 5, 2020) (holding disclosure of the dates defendant first became aware of the patents-in-suit “does not reveal the thoughts and opinions of counsel developed in anticipation of litigation and therefore[] does not constitute attorney work product,” even if the information “first came to be known by counsel”); *Vadon Golf Co. v. Karsten Mfg. Corp.*, 213 F.R.D. 528, 534 (N.D. Ill. 2003) (distinguishing issue of whether inventor had knowledge of certain prior art, which was discoverable, from counsel’s notes and memos regarding these facts, which were protected work product); *cf. Vasudevan Software, Inc. v. Int’l Bus.*

BY THE COURT:

/s/ Juan R. Sánchez
Juan R. Sánchez, J.

Machines Corp., Civ. No. 09-05897, 2011 WL 1599646, at *2 (N.D. Cal. Apr. 27, 2011) (ordering disclosure of dates on which individuals involved in the prosecution of the patents-in-suit became aware of prior art references as relevant to defendant's inequitable conduct defense and not privileged). Because Comcast has not shown the dates Promptu seeks are protected by the work product doctrine, Promptu's request to compel disclosure of this information is granted.