

Comcast X1 Set-Top Boxes Infringed 2 Rovi Patents, ITC Says

By **Matthew Bultman**

Law360, New York (November 22, 2017, 6:19 PM EST) -- The U.S. International Trade Commission has banned the import of certain Comcast Corp. set-top boxes after finding the media company and its video equipment suppliers infringe two patents owned by TiVo's Rovi Corp.

The ITC's final determination, issued late Tuesday, affirmed an administrative law judge's preliminary finding earlier this year that Comcast's Xfinity X1 set-top boxes infringe Rovi's patents, which cover an "interactive program guide with remote access."

Unless vacated by President Donald Trump, the decision will result in an import ban that will take effect in 60 days, which will not apply to the Legacy set-top boxes.

Comcast said in a statement it disagrees with the commission's determination.

"Rovi has never disputed that Comcast or its predecessors independently developed our X1 platform and our cloud- and app-based technology," Comcast said. "While we believe the ITC reached the wrong decision, we will remove this feature from those offered to our subscribers while we pursue an appeal."

Rovi, for its part, said it was pleased with the decision.

"[The] commission opinion reinforces the need for Comcast to take the necessary licenses to our IP," it said in a statement.

The ITC case is one front in a legal battle between former business partners Rovi and Comcast involving program guides and set-top boxes.

Rovi has also brought similar claims in federal court claiming Comcast has been infringing various patents since a licensing agreement between the companies expired last year. The dispute, which started in Texas, has since moved to New York.

Comcast, for its part, has challenged various Rovi patents at the Patent Trial and Appeal Board, including the two the ITC found were infringed. The PTAB agreed to review both patents earlier this year, finding claims in each were likely invalid.

In its ITC complaint, Rovi said Comcast encourages its subscribers to infringe its patents by marketing

the ability to schedule a DVR recording with the Xfinity TV Remote App. Equipment providers Arris International PLC and Technicolor SA were also named in the complaint.

ITC Administrative Law Judge David P. Shaw issued an initial determination in May that found Comcast infringed two Rovi patents. The judge said there was no violation with respect to four other patents that Rovi asserted.

The commission said in August it would review various aspects of the determination.

While the ITC agreed with the judge's infringement findings with respect to the X1 set-top boxes, it vacated the judge's ruling that two alternative designs would also infringe. The commission said the designs were "too hypothetical" to rule on right now.

The ITC also affirmed the judge's conclusion that claims in a third Rovi patent were invalid as obvious. Remedies were not imposed against Arris or Technicolor.

The patents-in-suit are U.S. Patent Numbers 8,006,263 and 8,578,413.

Rovi Corp. and Rovi Guides Inc. are represented by Douglas A. Cawley, Roderick G. Dorman, Benjamin Levi and Kristina S. Baehr of McKool Smith PC, and Matthew J. Rizzolo, James R. Batchelder, Mark D. Rowland, Andrew T. Radsch and Jesse J. Jenner of Ropes & Gray LLP.

Comcast and its affiliates are represented by Thomas L. Jarvis of Winston & Strawn LLP.

Arris International and its affiliates are represented by Joshua B. Pond of Kilpatrick Townsend & Stockton LLP.

Technicolor and its affiliates are represented by Paul M. Bartkowski, Beau Jackson and Rowan Dougherty of Adduci Mastriani & Schaumberg LLP; and by Trevor Carter and Elizabeth Cowan Wright of Faegre Baker Daniels LLP.

The case is In the Matter of Certain Digital Video Receivers and Hardware and Software Components Thereof, investigation number 337-TA-1001, in the U.S. International Trade Commission.

--Additional reporting by Melissa Daniels. Editing by Adam LoBelia.