

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,
Petitioner,

v.

ADAPTIVE SPECTRUM AND SIGNAL ALIGNMENT, INC.,
Patent Owner.

IPR2024-01379
Patent 7,809,996 B2

Before KEVIN F. TURNER, KEVIN C. TROCK, and SCOTT RAEVSKY,
Administrative Patent Judges.

TROCK, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
Requesting Supplemental Briefing
37 C.F.R. § 42.5

On September 17, 2024, Petitioner, Charter Communications, Inc., filed a Petition (Paper 1), requesting an *Inter Partes* review challenging claim 20 of U.S. Patent 7,809,996 B2. On January 29, 2025, Patent Owner, Adaptive Spectrum and Signal Alignment, Inc., filed a Preliminary Response (Paper 6).

In the Petition, Petitioner requested that the Board not exercise its discretion to deny institution under 35 U.S.C. § 314(a), arguing that the factors considered by the Board in its precedential decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”), “weigh against exercising discretion to deny institution.” Pet. 4. As part of its argument against exercising discretionary denial, Petitioner invoked “Director Vidal’s Interim Guidance, dated June 21, 2022” (“*Fintiv Memo*”), arguing that “the Board would not exercise discretion to deny institution where a petition presents compelling evidence of unpatentability.” *Id.* at 7.

In its Preliminary Response, Patent Owner requested that the Board exercise its discretion to deny institution under 35 U.S.C. § 314(a), and also invoked the *Fintiv Memo*, arguing that “[t]he *Fintiv Memo* explains that ‘[c]ompelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.’” Prelim. Resp. 32 (quoting *Fintiv Memo*, 4).

On February 28, 2025, the USPTO rescinded the June 21, 2022, *Fintiv Memo*, entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.”¹

¹ <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

The statutory deadline for issuing a decision on institution in this case is April 29, 2025. Because both parties cited to, and relied upon, the now rescinded *Fintiv* Memo, the Panel requests supplemental briefing from the parties on what effect the rescission of the *Fintiv* Memo has on the parties' positions argued under 35 U.S.C. § 314(a) in the Petition and Preliminary Response.

Accordingly, is is ORDERED that each of the parties may file by March 28, 2025, a supplemental brief not to exceed 4 pages, limited to addressing what effect, if any, the rescission of the *Fintiv* Memo on February 28, 2025, has on the parties' respective *Fintiv* analysis and arguments set forth in the Petition (Sec. IV.D) and the Preliminary Response (Sec. V). No new evidence may be introduced by either party.

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