UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

Patent No. 8,356,251
Filing Date: September 26, 2011
Issue Date: January 15, 2013
Title: PLAY CONTROL OF CONTENT ON A DISPLAY DEVICE

Inter Partes Review No.: IPR2024-00321

PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS

Pursuant to the November 2019 update to the America Invents Act (AIA) Trial Practice Guide published by the USPTO, Petitioner submits this notice of its ranking of its petitions for *inter partes* review of U.S. Patent No. 8,356,251 filed in IPR2024-00321 and IPR2024-00322. *See* "CONSOLIDATED TRIAL PRACTICE GUIDE UPDATE (November 2019)" at 59-60. Petitioner also includes herein an explanation of the material differences between the petitions.

Petitioner filed two petitions. Petition 1 (IPR2024-00321) primarily relies on the Redford reference. Petition 2 (IPR2024-00322) primarily relies on the Danciu and Aldrey references, each combined with the Mahajan reference.

Ordering of Petitions. Although Petitioner believes that its petitions are all meritorious and justified in light of the positions Patent Owner may take, at this stage, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Reference(s)
A	IPR2024-00321 (Petition 1)	Redford
B	IPR2024-00322 (Petition 2)	Danciu-Mahajan; Aldrey-Mahajan

Below are some of the material differences between the petitions:

(1) *Different Prior Art Date of References*: Certain of the primary references relied on in the petitions qualify as prior art under 35 U.S.C. § 102(e), including claiming the benefit of provisional filings. It is, therefore, possible that the Patent Owner could attempt to antedate these references and/or remove them as prior art. In particular, the Danciu reference is prior art under 102(e) but only predates the

’251 Patent’s earliest possible priority date by about six weeks. Danciu claims the benefit of a provisional application, though Patent Owner may attempt to antedate Danciu’s provisional date and/or challenge its prior art status as failing the *Dynamic Drinkware* analysis. The Redford reference is also 102(e) prior art but predates the ’251 Patent’s earliest possible priority date by more than a year.

The Aldrey reference (which is a second primary reference in the same petition as the Danciu reference) is 102(b) prior art and as such cannot be antedated by Patent Owner.

(2) ***Different Approaches to the Claim Limitations***: The prior art combinations used in the petitions teach the claim limitations in different ways.

Each of the primary prior art grounds have different strengths with respect to various different claims. Petition IPR2024-00321 asserts that Redford alone renders obvious claims 1-2, 5, 7-11, 16, and 18-21. In contrast, Petition IPR2024-00322 asserts that Danciu and Aldrey each combined with Mahajan[1] (Danciu-Mahajan and Aldrey-Mahajan) render obvious all of claims 1-26.

Furthermore, the petitions generally use different secondary references as teaching certain features of dependent claims or for back-up arguments to the

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[1] Mahajan was cited during prosecution of related U.S. Pat. Nos. 11,048,751 and 11,086,934, but for a different purpose than it is being used here.

primary references. For instance, the Redford petition uses Redford combined with the Gonze and/or Bartfeld references as a back-up for its Redford alone arguments, whereas the Danciu-Mahajan combination is combined with the Calvert reference as a back-up for its arguments. With respect to dependent claims 3-4 and 12-15, which require use of a library or look-up table, the Redford petition uses the Chilvers reference, whereas Danicu-Mahajan and Aldrey-Mahajan do not require an additional reference. Similarly, with respect to claims 6 and 17, which require the content to be an interactive videogame, the Redford petition uses the Malik reference, whereas Danicu-Mahajan and Aldrey-Mahajan do not require an additional reference. Depending upon the arguments Patent Owner makes, the use of these different references could be material.

In view of the material differences shown above, the Board should consider both petitions and not exercise its discretion to deny institution of either of the IPRs.

Dated: December 27, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of the PETITIONER'S PETITION RANKING AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS to be served via FedEx Priority Overnight on December 27, 2023, on the following:

SHOOK, HARDY & BACON LLP
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Dated: December 27, 2023

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