UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

Case No. IPR2024-00321
U.S. Patent No. 8,356,251

PATENT OWNER'S RESPONSE TO 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, Patent Owner Touchstream Technologies, Inc. hereby responds to Petitioner's separate paper ranking, and describing certain differences between, its Petitions. *See* Paper 3; *see also* Patent Trial & Appeal Board Consolidated Trial Practice Guide at 59–61 (Nov. 2019), *available at* https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated.

The Trial Practice Guide describes the circumstances where two petitions may be necessary as "rare." Patent Trial & Appeal Board Consolidated Trial Practice Guide at 59 (Nov. 2019) (*hereinafter* "Trial Practice Guide"). Petitioner fails to show these rare circumstances are presented here. *See* Paper 3. The current circumstances indicate instead that Petitioner hopes to proceed on as many grounds of challenge as it can, without any concern for the inefficient use of Board resources or the unfairness to Patent Owner. *See* Trial Practice Guide at 59 (explaining that multiple parallel petitions "could raise fairness, timing, and efficiency concerns") (citing 35 U.S.C. § 316(b)). The Board should not exercise its discretion to institute more than one petition (if it institutes at all) filed by Petitioner to challenge U.S. Patent No. 8,356,251 (the "'251 patent").

ARGUMENT

Contrary to Petitioner's assertion, the differences between the Petitions do not justify multiple petitions. Petitioner describes certain differences between the

Petitions filed in IPR2024-00321 and IPR2024-00322. Paper 3 at 1–3. Those differences, however, do not justify imposing the "substantial and unnecessary burden on the Board and the patent owner" of multiple parallel IPR petitions. Trial Practice Guide at 59.

First, the fact that the Petitions assert different references with different prior art dates is insufficient to warrant multiple proceedings. *See* Paper 3 at 1–2. Petitioner asserts that Patent Owner might try to antedate the Danciu reference, in particular. *See id.* Danciu is asserted as prior art under § 102(e) (pre-AIA) and has a non-provisional filing date six weeks prior to the earliest priority date of the '251 patent. *See id.* Yet Petitioner also acknowledges (as it must) that the '322 IPR Petition, asserting Danciu, also asserts grounds based Aldrey, which is asserted to be prior art under § 102(b) (pre-AIA). *Id.* at 2. If the Board were to institute the '322 IPR and not the '321 IPR, Petitioner would be able to pursue at least one Ground, regardless of the invention date.

Petitioner also does not contend that Redford—the primary reference for the '321 IPR Petition—is at risk of being antedated, despite being asserted as prior art under § 102(e) (pre-AIA). Paper 3 at 1–2. Redford has a filing date of January 6, 2010, which predates even the provisional filing date of the '251 patent by more than a year. *See* IPR2024-00321, Ex.1005 (22); IPR2024-00321, Ex.1001 (60); *see also* Ex.2005, Touchstream's Compl't, Case No. 2:23-cv-62 (E.D. Tex.) ¶17 (alleging

David Strober, the inventor of the ’251 patent “perceived [a] need” in mid-2010 and, “[n]ear the end of 2010, . . . developed a working prototype”).

Any dispute over the invention date of the ’251 patent or the effective filing date of Danciu will not prejudice Petitioner under the present circumstances. Petitioner favors the ’321 IPR Petition, which asserts Redford and not Danciu. Paper 3 at 1. If the Board holds Petitioner to a single Petition, at most, against the ’251 patent (as it should), the dispute over Danciu’s status as prior art could only matter after the Board denies Petitioner’s favored Petition on the merits. Even then, Petitioner would still have the Aldrey-Mahajan ground in the proceeding, which is based on two § 102(b) references that cannot be antedated by a showing of prior invention.

Second, Petitioner’s general assertion that the asserted grounds each have “different strengths with respect to various different claims” fails to justify the exercise of discretion to institute on more than one Petition. Paper 3 at 2. Petitioner does not assert that the two Petitions depend on competing alternative claim constructions. *See id.* at 2–3. They are simply different grounds based on different art. But that is nearly always true when there are multiple parallel petitions challenging a single patent. Indeed, that is why multiple petitions are so burdensome and inefficient and why Petitioner should be limited to at most one petition. *Cf.* Trial Practice Guide at 59. It provides no reason to institute on more than one.

Petitioner's reliance on secondary references for certain dependent claims in the '321 IPR also fails to justify multiple petitions. *See* Paper 3 at 3. Petitioner chose to challenge every claim of the '251 patent in each of its Petitions, even though Patent Owner asserted only six in the co-pending district court case. *See* Ex.2007 at 13–14 (asserting claims 1, 2, 5, and 7–9 of the '251 patent). These six asserted claims are all subject to the principal obviousness grounds in each Petition. *See* Paper 3 at 2 (listing claims challenged based on "Redford alone" and on "Danciu and Aldrey each combined with Mahajan"). Petitioner itself is responsible for any complexity introduced by its choice to challenge unasserted claims. *Cf.* Trial Practice Guide at 59 (recognizing that "more than one petition may be necessary . . . when the patent owner has asserted a large number of claims in litigation").

Finally, in the '321 and '322 IPR Petitions (each of which challenges all 26 claims of the '251 patent on multiple grounds), Petitioner grasps at third and fourth bites at the same invalidity/unpatentability apple. As noted in the *Fintiv* discussions in Patent Owner's concurrently filed Preliminary Responses, Petitioner is advancing these very same grounds using these very same references in District Court: Petitioner's first and second bites. In case those efforts fail at trial, set to happen long before Final Written Decisions in these IPRs, Petitioner hopes to get its third and fourth bites with these two overlapping Petitions. Considering the number of attempts Petitioner is trying to get for itself, the Board's just concerns over "fairness,

timing, and efficiency" compel the conclusion that only one of these Petitions (if any) should be instituted. *See* Trial Practice Guide at 59.

CONCLUSION

Rather than presenting a single Petition with a quality theory of unpatentability against the '251 patent, Petitioner asserts a multitude of flawed theories over two Petitions in a shotgun-like approach. As shown in Patent Owner's Preliminary Responses, none of these theories meet the threshold showing for institution on the merits. A repeated barrage of weak arguments cannot compensate for this lack of quality. This, in part, is why the Trial Practice Guide encourages Petitioners to focus on presenting only its best arguments in a single Petition. Petitioner failed to follow that guidance without good cause, and it has not shown why the Board should institute on more than one (if any) of those Petitions.

Dated: April 24, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on April 24, 2024, a complete and entire copy of the foregoing Patent Owner's Response to Petitioner's Petition Ranking and Explanation of Material Differences Between Petitions was provided via email to Petitioner's counsel of record as follows:

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