

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00321
Patent 8,356,251 B2

Before GEORGIANNA W. BRADEN, MICHELLE N. WORMMEESTER,
and MATTHEW S. MEYERS, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Comcast Cable Communications, LLC (“Petitioner”) filed a Petition for *inter partes* review (Paper 2 (“Pet.” or “Petition”)) challenging claims 1–26 of U.S. Patent 8,356,251 B2 (Ex. 1001 (the “’251 patent”)). Touchstream Technologies, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). Petitioner filed an authorized Reply to Patent Owner’s Preliminary Response (Paper 11 (“Prelim. Reply”)), and Patent Owner filed a Sur-reply to Petitioner’s Preliminary Reply (Paper 12 (“Prelim. Sur-reply”)).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. For the reasons explained below, we do not institute an *inter partes* review.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters. Pet. viii–x; Paper 4 at 1–2. One related matter is *Touchstream Technologies, Inc. v. Comcast Cable Communications, LLC*, 2:23-cv-00062-JRG (E.D. Tex.) (“related district court litigation”). Pet. viii; Paper 4 at 1. Petitioner also challenges claims 1–26 of the ’251 patent in IPR2024-00322, in which we institute an *inter partes* review.

C. Real Parties in Interest

Petitioner identifies itself, Comcast Corporation, and Comcast Cable Communications Management, LLC as the real parties in interest. Paper 7 at 1. Patent Owner identifies itself as the real party in interest. Paper 8 at 1.

D. '251 Patent and Illustrative Claim

The '251 patent discloses a “system for presenting and controlling content on a display device [that] includes a network, a server system coupled to the network and comprising one or more servers, a display device coupled to the network and having a display, and a personal computing device.” Ex. 1001, code (57).

Claim 1 is reproduced below.

1. A machine-implemented method of controlling presentation of video content on a display device that loads any one of a plurality of different media players, the method comprising:

assigning, by a server system, a synchronization code to the display device;

receiving, in the server system, a message from a personal computing device that is separate from the server system and separate from the display device, wherein the message includes the synchronization code;

storing, by the server system, a record establishing an association between the personal computing device and the display device based on the synchronization code;

receiving, in the server system, one or more signals from the personal computing device, the one or more signals specifying a video file to be acted upon and identifying a particular media player for playing the video content, the one or more signals further including a universal playback control command for controlling playing of the video content on the display device by the particular media player,

converting, by the server system, the universal playback control command into corresponding programming code to control playing of the video content on the display device by the particular media player, wherein converting the universal playback control command includes selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player; and

storing, in a database associated with the server system, information for transmission to or retrieval by the display device, wherein the information specifies the video file to be acted upon, identifies the particular media player for playing the video content, and includes the corresponding programming code to control playing of the video content on the display device by the particular media player in accordance with the universal playback control command.

E. Asserted Challenges to Patentability

Petitioner presents the following bases:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5, 7–11, 16, 18–21	103(a) ¹	Redford ²
1, 2, 5, 7–11, 16, 18–21	103(a)	Redford, Gonze ³
1, 2, 5, 7–11, 16, 18–26	103(a)	Redford, Bartfeld ⁴
1, 2, 5, 7–11, 16, 18–26	103(a)	Redford, Gonze, Bartfeld
2–4, 12–15	103(a)	Redford, Chilvers ⁵
2–4, 12–15	103(a)	Redford, Gonze, Chilvers
2–4, 12–15	103(a)	Redford, Bartfeld, Chilvers
2–4, 12–15	103(a)	Redford, Gonze, Bartfeld, Chilvers
6, 17	103(a)	Redford, Malik ⁶

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. The application for the ’251 patent was filed before this date, and Petitioner applies pre-AIA §§ 102 and 103. Ex. 1001, code (22); *see* Pet. 4–7 (asserting references are prior art under pre-AIA §§ 102(b), (e)).

² US 8,660,545 B1, filed Jan. 6, 2010, issued Feb. 25, 2014 (Ex. 1005).

³ US 2008/0235588 A1, published Sept. 25, 2008 (Ex. 1006).

⁴ US 2006/0107299 A1, published May 18, 2006 (Ex. 1018).

⁵ US 8,327,403 B1, filed Sept. 7, 2007, issued Dec. 4, 2012 (Ex. 1007).

⁶ US 2007/0155506 A1, published July 5, 2007 (Ex. 1008).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
6, 17	103(a)	Redford, Gonze, Malik
6, 17	103(a)	Redford, Bartfeld, Malik
6, 17	103(a)	Redford, Gonze, Bartfeld, Malik

II. ANALYSIS

A. Discretionary Denial under 35 U.S.C. § 314(a) – *Fintiv*

Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), weigh in favor of denying institution in view of the related district court litigation. Prelim. Resp. 2–3, 36–49; Prelim. Sur-reply 1–4.

We consider the following factors to assess “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6.

1. First Factor – Likelihood of Stay

Petitioner has not yet requested a stay in the related district court litigation but represents “its intention to request a stay if the present IPR is instituted.” Prelim. Reply 2. Patent Owner argues that the related district court litigation is unlikely to be stayed based on that court’s low grant rate in other cases. Prelim. Resp. 38 (citing Ex. 2002). Petitioner argues that factor one is neutral and that Patent Owner’s stay statistics fail to account for the timing of the motions requesting a stay. Pet. 8; Prelim. Reply 1–2.

On this record, we decline to speculate as to how the district court might rule on a motion that Petitioner has not yet filed. Thus, we determine that this factor is neutral.

2. Second Factor – District Court Trial Date

The related district court litigation is currently scheduled for trial on October 28, 2024. Pet. 8; Prelim. Resp. 38. Patent Owner argues that this schedule is consistent with the district court’s median time-to-trial, which Patent Owner states is 21 months. Prelim. Resp. 38–39; *see* Ex. 2004⁷; *see Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (USPTO June 21, 2022) (“Guidance Memo”)⁸ at 8–9 (providing that “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s consideration”). Patent Owner argues that factor two favors discretionary

⁷ Patent Owner cited Exhibit 2002, which pertains to motion disposition. Based on the context and Patent Owner’s citations in IPR2024-00322, we understand Patent Owner to be referring to Exhibit 2004.

⁸ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

denial because the district court trial date is more than eight months before our final written decision would be due if we instituted in July 2024. Prelim. Resp. 38.

Petitioner does not dispute Patent Owner’s evidence regarding time-to-trial. *See* Prelim. Reply (not addressing factor 2). Patent Owner’s representation of median time-to-trial of 21 months is consistent with the most recent available data from the judiciary.⁹ *See* Ex. 2005 (complaint filed February 17, 2023). Petitioner agrees that trial is scheduled for October 28, 2024, but notes that it has pending motions to transfer. Pet. 8. According to Patent Owner, however, the district court has since denied Petitioner’s transfer motions. Prelim. Resp. 39 (citing Ex. 2006).

We find that the related district court litigation’s trial date and the district court’s median time-to-trial favor denial.

3. Third Factor – Investment in Related District Court Litigation

Petitioner argues that “[f]actor three does not warrant denial” because the district court “has not yet begun the claim construction process and fact discovery does not close until June 2024.” Pet. 9. By Petitioner’s own admission, fact discovery will have closed by the deadline for institution, and we evaluate the investment in the related district court litigation as of the time of the institution decision. *Fintiv*, Paper 11 at 9–10. Furthermore, Patent Owner argues that expert discovery also will be closed by the deadline for institution, and substantial work on claim construction will have happened, including a claim construction hearing scheduled for May 16, 2024. Prelim. Resp. 41 (citing Exs. 2003, 2007, 2009, 2010, 2021).

⁹ Available at https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf.

Patent Owner also argues that Petitioner filed the Petition “almost ten months after learning of the asserted claims and almost five months after serving its initial invalidity contentions,” which, according to Patent Owner, does not show diligence in filing the Petition. Prelim. Resp. 42–43 (emphasis omitted); *see Fintiv*, Paper 11 at 11–12 (noting that the timing of the Petition’s filing relative learning the asserted claims may be considered for factor three).

We agree with Patent Owner that factor three favors denial. Petitioner relies only on claim construction and fact discovery, which have progressed or have been completed by now. Patent Owner shows that the related district court litigation has progressed in other aspects as well and notes Petitioner’s delay in filing the Petition. Petitioner does not further address factor three in its authorized reply.

4. *Fourth Factor – Overlap of Issues*

Petitioner argues that “[f]actor four strongly favors institution” because the Petition challenges all claims while only claims 1, 2, 5, and 7–9 are asserted in the related district court litigation. Pet. 9. Petitioner also states that it “stipulates not to pursue in the District Court any ground that utilizes the same combination of prior art references relied upon in the instituted petition.” *Id.* at 18 (citing Ex. 1082). Petitioner’s characterization of the stipulation is slightly different from the stipulation itself, which states that, if trial is instituted, Petitioner “will not pursue in [the related district court litigation] the specific grounds against the instituted patent(s) as set forth in the respective instituted *inter partes* review petition(s).” Ex. 1082. Patent Owner argues that the “as set forth” language could be read broadly to allow Petitioner, in the related district court litigation, to rely on the same

combination of prior art in a different manner than “set forth” in the Petition. Prelim. Resp. 44.

Patent Owner also argues that Charter Communications, Petitioner’s co-defendant in the related district court litigation, “is pursuing almost identical invalidity defenses, including, *inter alia*, those relying on Redford, and has not agreed to be bound by any such stipulation.” Prelim. Resp. 45. According to Patent Owner, “Petitioner and Charter’s cases remain consolidated for all pretrial purposes and issues of invalidity will likely be dealt with at the same time.” Prelim. Resp. 45 (citing Ex. 2013 (order consolidating “for pretrial purposes”)).

Petitioner argues, however, that Charter is not a co-defendant but was sued separately, that the district court consolidated the cases for pretrial purposes only, and that invalidity will be a trial issue. Prelim. Reply 3–4. Petitioner also argues that Charter is not a real party in interest or privy in this proceeding and that Petitioner “cannot be held responsible for the acts of Charter.” Prelim. Reply 4.

Patent Owner responds that it “must still prepare for and defend against the petitioned grounds in a jury trial, regardless whether the Board institutes on the Petition” because Charter is pursuing the same invalidity defenses. Prelim. Sur-reply 3.

We agree with Petitioner that Charter’s invalidity defenses cannot be held against Petitioner. This is evident from the Guidance Memo, which provides that “the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Guidance Memo 3. This provision applies even if another defendant might pursue such grounds

in parallel litigation. Petitioner can only control what it pursues in the related district court litigation, and Petitioner's case is consolidated with Charter's case only for pretrial purposes, not for trial. Ex. 2013.

On the other hand, we agree with Patent Owner that the language in Petitioner's stipulation in Exhibit 1082 does not eliminate overlap with district court invalidity arguments. Furthermore, Petitioner's stipulation "not to pursue in the District Court any ground that utilizes the same combination of prior art references relied upon in the instituted petition" (Pet. 9) allows Petitioner to utilize a prior art reference that may be considered a primary reference, that is one disclosing a majority of the claim limitations, in combination with a reference that is not relied on in the Petition. This may not address adequately "concerns of inefficiency and the possibility of conflicting decisions." *See Fintiv*, Paper 11 at 12.

Finally, we agree with Petitioner that the fact that the Petition challenges claims that are not asserted in the litigation shows that there is not complete overlap. Patent Owner asserts that "Petitioner does not even attempt to show that" certain challenged-but-unasserted claims "present different issues of invalidity from claim 1." Prelim. Sur-reply 3. Even so, they are different claims, Petitioner challenges their patentability, and the district court will not resolve the issue. *Cf. SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018) ("[I]n an inter partes review the petitioner is master of its complaint and normally entitled to judgment on all of the claims it raises . . .").

Based on the foregoing discussion, we determine that factor four weighs slightly against denial.

5. *Fifth Factor – Defendant in District Court*

Petitioner is the defendant in the related district court litigation. Pet. 9; Prelim. Resp. 46. We find that this factor favors denial. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

6. *Sixth Factor – Other Circumstances, Including the Merits*

The sixth *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny, such as the merits of the patentability challenges. *Fintiv*, Paper 11 at 14–16. Under this factor, “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability.” Guidance Memo 5. Board precedent provides that we should only consider the compelling merits standard if the first five *Fintiv* factors favor discretionary denial. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB February 27, 2023) (precedential).

The second, third, and fifth *Fintiv* factors favor denial. The first factor is neutral, and only the fourth factor weighs against denial. As set forth above, we determine that the first five *Fintiv* factors favor discretionary denial, and thus, we assess compelling merits. *CommScope*, Paper 23 at 5 (“In circumstances where, however, the Board’s analysis of *Fintiv* factors 1–5 favors denial of institution, the Board shall then assess compelling merits.”). The compelling merits standard is met if “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.” Guidance Memo 4. A challenge can only meet this standard “if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.”

OpenSky Indus., LLC v. VLSI Tech. LLC, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential) (“*OpenSky*”).

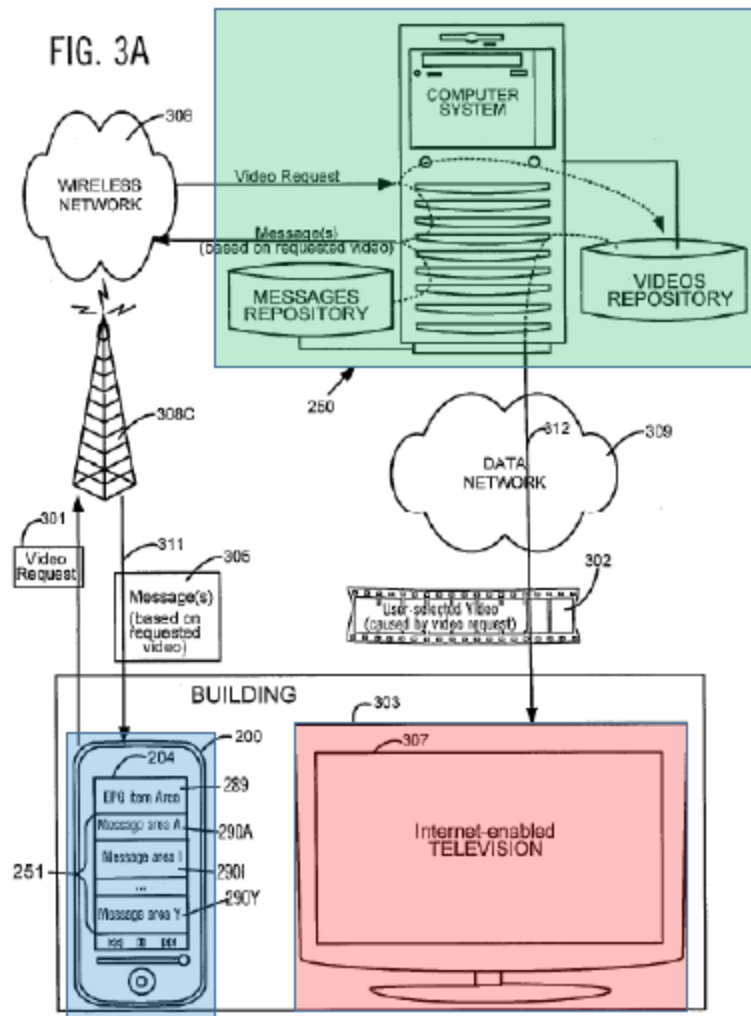
We have reviewed Petitioner’s challenges and Patent Owner’s arguments, and we determine that Petitioner has not met the compelling merits standard. We focus on Petitioner’s contentions for the “programming code” limitations of the independent claims.

Independent claim 1 recites “converting, by the server system, the universal playback control command into corresponding programming code to control playing of the video content on the display device by the particular media player” and “storing, in a database associated with the server system, information for transmission to or retrieval by the display device, wherein the information . . . includes the corresponding programming code.”

Independent claim 11 similarly recites, at the server, “converting the universal playback control command into corresponding programming code to control playing of the video content of the particular media player” and “stor[ing] in the second database information for transmission to or retrieval by the display device, wherein the information . . . includes the corresponding programming code.”

Claim 22 does not recite converting a command into programming code, but it recites “retrieving, by the display device from a server system, first information . . . that indicates corresponding programming code to control playing of the first video file on the display device by the first media player in accordance with a first playback control command.”

Petitioner provides the following colorized version of Redford’s Figure 3A to illustrate its contentions:



Pet. 12. Redford’s Figure 3A above with Petitioner’s component coloring shows computer system 250 (green) communicating with handheld device 200 (blue) and internet-enabled television 303 (red). Ex. 1005, 11:60–66. Petitioner maps television 303 to the recited “display device,” handheld device 200 to the “personal computing device,” and computer system 250 to the “server system.” Pet. 11, 22.

For the “converting” limitation of claim 11, Petitioner argues that, “[u]pon receipt of a command to play video, computer system 250 retrieves association information, sends a corresponding play command to the content provider specified in the user request, and sends a URL to the television that

can fetch and play the requested content from the content provider.” Pet. 33 (citing Ex. 1005, 29:4–20, 36:41–52, Figs. 8A, 8B, 11H; Ex. 1002 ¶ 221). Petitioner then argues that a person of ordinary skill in the art “would have known from reading Redford that computer system 250 converts the ‘PlayVideo’ command, sent from handheld device 200, to a particular ‘VideoPlay’ command.” Pet. 34 (citing Ex. 1005, 39:22–24, 40:56–41:2; Ex. 1002 ¶¶ 222–224).

For the “storing” step, Petitioner argues that a person of ordinary skill in the art

would have understood that computer system 250 stores information for transmission to or retrieval by the television 303 where the information specifies the video file to be acted upon, identifies the particular media player for playing the video content, and includes the corresponding programming code to control playing of the video content on the display device by the particular media player in accordance with the universal playback control command as a URL. Specifically, Redford describes that television 303 uses the URL to play content. Computer system 250 stores the URL, and associated data, in a database associated with the computer system. A [person of ordinary skill in the art] would have known that it was common to store, in a server associated database, information for transmission to or retrieval by a display device. Pet. 35–36 (citing Ex. 1005, 27:56–28:3, 29:4–20, 36:41–52, 38:50–57, 43:36–51, 43:63, Figs. 8A, 8B, 11H; Ex. 1002 ¶¶ 227–228).

Patent Owner points out that the storing step requires storing “the corresponding programming code” from the converting step, and Patent Owner argues that the Petition does not consistently identify what the programming code is. Prelim. Resp. 24–25 (citing Pet. 34–36). In particular, Patent Owner argues that, for the storing step, Petitioner identifies

the URL but does not mention the VideoPlay command identified in the converting step. Prelim. Resp. 24.

As noted above, our inquiry is directed to whether the Petition meets the compelling merits standard, not the “reasonable likelihood” standard of § 314(a). We agree with Patent Owner that there is some inconsistency in Petitioner’s contentions regarding the “programming code” recitations of claim 1. Petitioner’s contention for the storing limitation does not mention “VideoPlay” even though Petitioner identifies that as the converted command in the converting step. *See* Pet. 34–36. Rather, Petitioner’s contentions for the storing step focus on the URL. Petitioner does not explain how the URL is “programming code.” Petitioner relies on a portion of Figure 11H from Redford (*see* Pet. 34), but that figure shows in step 1153 that a server transmits a command to the content provider computer, not the television that Petitioner identifies as the “display device.” Ex. 1005, 11:36:45–50, Fig. 11H.

Petitioner’s contentions for claim 11 refer to the contentions for claim 1. *See* Pet. 47. Petitioner does not assert that claim 22 would have been obvious over Redford alone. *See* Pet. 8 (challenges summary table).

Based on the foregoing, we determine that Petitioner’s obviousness contentions based on Redford alone do not meet the compelling merits standard.

Petitioner also argues that independent claims 1, 11, and 22 would have been obvious based on the combined teachings of Redford and Gonze. For the converting step of claim 1, Petitioner argues:

In the proposed combinations with Gonze, as stated in Sections VI.A.1.a and VI.A.1.e–VI.A.1.f, interactions with the general user interface elements (*e.g.*, “<--”, ‘<-’, ‘Stop’, ‘Play’, ‘||’, ‘->’, ‘-->.’), Ex. 1006, [0053]) may be monitored and

associated converted commands may be sent to the loaded media player. Ex. 1006, [0059], see also, [0006], [0010], [0034]-[0035], [0040], [0049], [0051], [0058]-[0060]. Ex. 1002, ¶ 225.

Pet. 35. This assertion does not sufficiently explain what the “associated converted commands” are.

Section IV.A.1.a, to which Petitioner refers, addresses the preamble of claim 1 and argues that a person of ordinary skill in the art “would have been motivated to apply Gonze’s teaching of loading uninstalled media players to a playback device to supplement Redford’s system in order to enable the easy loading and selection of various media players to Redford’s system.”

Pet. 16 (citing Ex. 1002 ¶¶ 174–176).

Section VI.A.1.e states that, “[i]n the proposed combinations with Gonze, as stated in Section VI.A.1.a, computer system 250 receives, from handheld device 200, a playlist specifying a video file and particular media player.” Pet. 29 (citing Ex. 1006 ¶¶ 6, 10, 34–35, 40, 49, 51, 58–60; Ex. 1002 ¶ 212).

Section VI.A.1.f states the following in regard to Gonze:

In the proposed combinations with Gonze, as stated in Sections VI.A.1.a and VI.A.1.e, computer system 250 receives, from handheld device 200, a playlist including the claimed universal playback control command. Ex. 1006, [0006], [0010], [0034]-[0035], [0040], [0049], [0051], [0058]-[0060]. Interactions with the user interface elements (*e.g.*, “<--”, “<-”, “Stop”, “Play”, “||”, “->”, “-->.”), *Id.*, [0053]) may be monitored and associated commands may be sent to the loaded media player. *Id.*, [0059]. Ex. 1002, ¶ 218.

Pet. 32.

These sections do not provide further sufficient explanation as to how the combination of Redford and Gonze teaches the “programming code” recitations of claims 1 and 11.

Petitioner’s contentions for the limitation of claim 22 reciting “programming code” mention both “VideoPlay” and the URL but do not further clarify what Petitioner contends is the “programming code,” and they also do not mention Gonze. Pet. 51–53.

Based on the foregoing, we determine that Petitioner’s obviousness contentions based on the combined teachings of Redford and Gonze do not meet the compelling merits standard. Petitioner does not rely on the other prior art references—Bartfeld, Chilvers, and Malik—to address the “programming code” subject matter of the independent claims.

7. *Fintiv Determination*

The first five *Fintiv* factors favor discretionary denial, and the Petition does not meet the compelling merits standard of the Guidance Memo. Therefore, we determine that discretionary denial is appropriate in view of the related district court litigation.

B. Discretionary Denial under 35 U.S.C. § 314(a) – Multiple Petitions

As noted above, Petitioner also challenges claims 1–26 of the ’251 patent in IPR2024-00322, and we are instituting *inter partes* review in that proceeding. The Board’s Consolidated Trial Practice Guide¹⁰ (“CTPG”), issued in November 2019, notes that “[t]wo or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise

¹⁰ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

fairness, timing, and efficiency concerns” and that “multiple petitions by a petitioner are not necessary in the vast majority of cases.” CTPG 59.

“Nonetheless, the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.*

As advised by the CTPG, Petitioner filed a paper ranking its petitions and purporting to explain differences between the petitions. Paper 3. Petitioner ranks this Petition above the petition in IPR2024-00322. As discussed above, we do not find that this Petition meets the compelling merits standard, but we find that the petition in IPR2024-00322 does meet this standard at least for one claim.

Petitioner also argues that certain references are prior art under 35 U.S.C. § 102(e) that can be antedated by Patent Owner. Paper 3 at 1–2. Petitioner argues that Redford predates the ’251 patent’s earliest priority date by more than a year whereas one of the references in IPR2024-00322 only predates the ’251 by about six weeks. Paper 3 at 1–2. As Patent Owner points out, however, Petitioner asserts a challenge in IPR2024-00322 that relies only on prior art under § 102(b), which cannot be predated. Paper 10 at 2. Thus, the petition in IPR2024-00322 also provides an advantage in the event of a priority dispute.

Petitioner also generally asserts that “[e]ach of the primary prior art grounds have different strengths with respect to various different claims,” but Petitioner does not provide sufficient explanation for this assertion. Paper 3 at 2. Petitioner’s explanation does not provide “a succinct

explanation of the differences between the petitions” and “why the issues addressed by the differences are material.” *See* CTPG 59–60.

The record before us does not support the need for two petitions. In the related district court litigation noted above, Patent Owner has asserted only six claims of the ’251 patent (Paper 10 at 4), so this is not a situation in which “the patent owner has asserted a large number of claims in litigation.” *See* CTPG 59. Nor has Petitioner shown why this Petition would be preferable to a petition that has a challenge relying only on § 102(b) art, as in IPR2024-00322, should there arise a priority dispute.

Thus, in addition to our reasons for denying based on *Fintiv*, we determine that discretionary denial is appropriate here given the institution of *inter partes* review in IPR2024-00322.

III. CONCLUSION

For the foregoing reasons, we exercise discretion to deny institution under 35 U.S.C. § 314(a).

IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied and no *inter partes* review is instituted in this proceeding.

IPR2024-00321
Patent 8,356,251 B2

FOR PETITIONER:

Frederic Meeker
Paul Qualey
John Fleming
Joshua Davenport
John Hutchins
Banner & Witcoff, LTD
fmeeker@bannerwitcoff.com
pqualey@bannerwitcoff.com
jfleming@bannerwitcoff.com
jdavenport@bannerwitcoff.com
jhutchins@bannerwitcoff.com

FOR PATENT OWNER:

Kyle Friesen
Jason Mudd
Ryan Dykal
Robert Reckers
Shook, Hardy & Bacon LLP
kfriesen@shb.com,
jmudd@shb.com
rdykal@shb.com
rreckers@shb.com