

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. IPR2024-00322
U.S. Patent No. 8,356,251

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. § 42.107**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Request for an Extension of Time dated May 9, 2019 re Reply to Office Action of 01/08/2019 ('751 Remarks)
2002	Lex Machina Report – District Judge James Rodney Gilstrap Order Stats between Jan. 1, 2012 – April 12, 2024
2003	2:23-cv-00060 (E.D. Tex. 2023), Docket Control Order (Dkt. 71) filed June 16, 2023
2004	Docket Navigator – Judge Rodney Gilstrap Milestone timeline accessed April 10, 2024
2005	2:23-cv-00060 (E.D. Tex. 2023), Dkt 1 (Feb. 17, 2023)
2006	2:23-cv-00060 (E.D. Tex. 2023), Dkt 156 (Order Denying Transfer)
2007	Touchstream's Disclosure of Asserted Claims and Infringement Contentions and Accompanying Document Production to Comcast Defendants' dated May 19, 2023
2008	Charter Notice of Preliminary Election of Asserted Prior Art dated April 4, 2024
2009	Defendants' Third Supplemental Disclosures Pursuant to P.R. 3-3 and 3-4 dated March 27, 2024
2010	Defendants' Disclosures Pursuant to P.R. 3-3 and 3-4 dated August 4, 2023
2011	Comcast Defendants' Preliminary Election of Asserted Prior Art dated (April 4, 2024)
2012	Comcast Defendants' Stipulation Regarding Invalidity Defenses (Dkt. 129) filed January 9, 2024
2013	2:23-cv-00060 (E.D. Tex. 2023), Dkt 158 (Order deconsolidating cases and reconsolidating to 2:23-cv-00059)
2014	U.S. Patent No. 11,048,751 issued June 9, 2021; <i>Play Control of Content on a Display Device</i>
2015	RESERVED
2016	RESERVED

Exhibit No.	Description
2017	'751 File History, Office Action, January 8, 2019
2018	Comcast Docket Sheet (2:23-cv-00062-JRG) as of April 23, 2024
2019	Charter Docket Sheet (2:23-cv-00059-JRG) as of April 23, 2024
2020	Altice Docket Sheet (2:23-cv-00060-JRG) as of April 23, 2024
2021	Declaration of Philip A. Eckert
2022	Post-Trial Motions Hearing Transcript (Excerpt) dated January 3, 2024 re <i>Touchstream v. Google</i> case

The Petition does not show a reasonable likelihood of success on the merits, and the Board should therefore deny the Petition. The Board should also exercise its discretion to deny institution for multiple reasons.

On the merits, for every asserted Ground, Petition relies on the same secondary reference—Mahajan—for the critical *converting* step. But Mahajan fails to teach the claimed *conversion*. *See infra*, Section IV.A.1. Specifically, the claims require “converting, *by the server system*, the universal playback control command into corresponding programming code to control playing of the video content of the display device by the particular media player.” Mahajan simply does not disclose this step. First, the alleged conversion of universal commands in Mahajan is not performed by Mahajan’s *server*, but rather by its *client* (*i.e.*, the device that plays the media content). Second, Mahajan has it backwards: the alleged “generic commands” are the *output* of the alleged conversion process performed by the server. Petitioner thus fails to substantiate how Mahajan supposedly teaches the claimed “programming code” or the conversion from *universal commands*. The Petition does not even allege that the primary references supply these missing limitations. Mahajan’s deficiencies in the *conversion* step are fatal to every Ground, and the Petition should be denied.

Independent of Mahajan’s fatal flaws, the Petition also fails for its reliance on Danciu. For instance, the Danciu reference only teaches use of *a single media player*,

while the claims recite “a display device that loads *any one of a plurality* of different media player players”—repeatedly claiming use of “a *particular* media player” of the plurality. *See infra* Section V.C. This fundamental concept is entirely absent from Danciu.

Using its discretion under § 325(d), the Board should deny the Petition because the same or substantially the same prior art has been thoroughly considered and rejected. **First**, Danciu describes the YouTube Remote system, which the Examiner expressly considered before allowing the ’251 patent’s claims to issue. There is no basis to conclude the Office made an error in that allowance. Further, this same art was addressed in a July 2023 trial against Touchstream, when Google—the owner of the YouTube Remote system and assignee of Danciu—asserted invalidity based on that very system (relying on Danciu’s description). Google *lost*, and the ’251 patent was upheld as not invalid. **Second**, Mahajan was considered by the Examiner during prosecution of a sister patent of the ’251 Patent for the same reasons asserted here. The sister patent of the ’251 Patent was allowed in view of Mahajan. The Petition relies on art that has been considered and found wanting by both the Office and a federal jury.

Further, using its discretion under § 314, the Board should deny the Petition because institution would needlessly multiply litigation. Petitioner waited *ten months* to file its Petition. Because of that delay, the related district court proceedings

are only 6 months from trial, as of this Preliminary Response. If instituted, an IPR might not reach final written decision until eight months after the district court trial. Further, Petitioner’s stipulation does not alleviate the burden of duplicative litigation: instead of agreeing to a *Sotera* stipulation, equal in scope to the estoppel under § 315(e), Petitioner commits only to “not pursue in [District Court] the specific grounds against the instituted patent(s) as set forth in the respective instituted inter partes review petition(s).” Ex.2012, 2.

Because of this, Patent Owner continues to invest significant resources litigating validity in District Court. Indeed, Petitioner maintains 12 invalidity theories spanning over 500 pages—and even maintains its Danciu prior art theories at the District Court. This Petition thus represents a second bite-at-the-apple for Petitioner on substantially the same art asserted in district court.

There will be a trial on invalidity in the district court *eight months* before this IPR is finally decided. Petitioner refuses to be constrained by estoppel, and the parties will not be able to avoid the burden of litigating validity in the trial court. Institution will waste Board resources on duplicative litigation, and Petitioner will be the sole beneficiary because it attempts to preserve a second bite at invalidity. This wastes public and private resources.

For these reasons, as well as those described below, the Board should deny institution under 35 U.S.C. §§ 314(a) & 325(d), both on the merits and in the exercise of its sound discretion.

I. THE '251 PATENT

The '251 patent is titled “Play Control of Content on a Display Device,” issued on January 15, 2013, from U.S. Patent Application No. 13/245,001. Ex.1001 (cover). It generally relates to methods for presenting and controlling media content using a *display device*, a *server system*, and a *personal computing device*. *See id.* The application that matured into the '251 patent was filed September 26, 2011, and claims priority to an earlier utility application (filed June 10, 2011) that issued as U.S. Patent No. 8,904,289 (the “'289 patent”). *Id.* The '251 patent also claims priority to an earlier provisional application (filed April 21, 2011). *Id.* The '251 patent names David Strober as its sole inventor and Patent Owner as the assignee. *Id.*

A. Claims

The '251 patent has 26 claims, of which three—claims 1, 11, and 22—are independent. Independent claim 1 recites:

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 player 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.

Ex.1001, 11:22–60.

Independent claim 11 differs in several regards—notably, it claims a system, not a method. It also differs in that it recites both a “first database” and “second database.” Ex.1001, 12:34, 12:41. The “first database” is responsible for, *inter alia*, storing a relationship “between a personal computing device and the display device,” and the “second database” stores “information for transmission to or retrieval by the display device.” *Id.* Claim 11 has sundry other differences, and this is not an exhaustive list.

Independent claim 22 recites a method with various different steps. Summarized in brief, these different steps comprise:

- “displaying, by the display device, a synchronization code”;

- “retrieving, by the display device from a server system, first information”;
- “obtaining, by the display device, over the Internet the first media player for playing the first video file”;
- “loading the first media player in the display device”; and
- “executing the first playback control command with respect to the first video file using the first media player.”

Ex.1001, 13:48–14:20.

Independent claim 22 also recites subsequent “retrieving” of “second information;” “obtaining” and “loading” of a “second media player;” and “executing” a “second playback control command...” with specific limitations describing each “second” element. Ex.1001, 14:20–39.

B. Specification

The '251 patent discloses various embodiments to illustrate how the invention allows a user to locate content (*e.g.*, video content) on a personal computing device, like a mobile phone, and cause playback of that content on a second device (*e.g.*, a television set) or other display device. As recited in the claims, a server system facilitates this process.

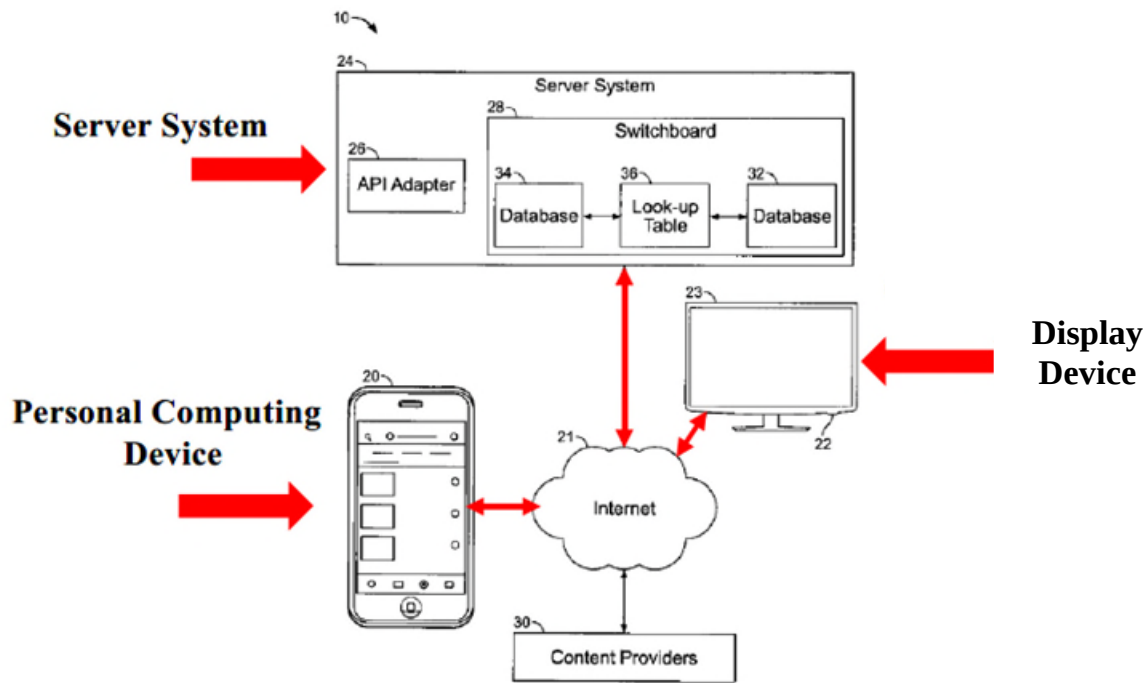


FIG. 1

Ex.1001 (Fig. 1, annotated)

Figure 1 (reproduced above in annotated form) depicts an overview of the system according to certain embodiments. Ex.1001, 2:41–42. As shown, the mobile device, digital device (e.g., television set with a display), and server system of this embodiment are connected to the Internet. *Id.*, 2:66–3:1. The personal computing device (here, mobile device) acts as a controller, locating and selecting content via the Internet and sending commands that instruct the television set to obtain the selected content from the Internet and to present the content. *See id.*, 3:1–29. In one embodiment, a mobile phone sends messages to a server system when a user selects content and requests that it be displayed on the television set. *Id.*, 3:12–15. The television set “is operable to link back to a server system 24 from which the

television set receives commands.” *Id.*, 3:10–11. The server system may send commands instructing the television set, in some embodiments, “to access a content provider 30 through the Internet 21, load a specific media player, load the media player-specific content (e.g., a video) and play the content on the television display 23.” *Id.*, 3:18–23.

For the television set to present selected content, a user must have already established a connection between the mobile phone and the television set. *See id.*, 4:65–5:7. For certain embodiments, establishing that connection involves a “synchronization code” that identifies the display device, *e.g.*, television set. *Id.*, 5:8–10, 5:14–16. For example, the user may run software on the display device that connects it to the server system. *See id.*, 7:17–23. Upon connection, the server system may assign the television set a synchronization code (or sync code), which in some embodiments may then appear on the television set display (*e.g.*, as text or a QR code). *See id.*, 5:16–21, 5:26–29, 7:24–25. The user enters the sync code (or scans it, if a QR code is used) using the mobile phone, which then sends the sync code to the server system in a message. *See id.*, 5:16–21, 5:36–41, 7:25–31. The server then establishes a connection between the mobile phone and the television set that the sync code identifies. *Id.*, 5:32–41, 7:32–35.

When there is an established connection with the television set or other display device, the mobile phone, display device, server system, and content providers send

and receive messages and information to and from each other. Figure 2 (reproduced below in annotated form) illustrates how this works in certain embodiments, and the following description references the annotations.

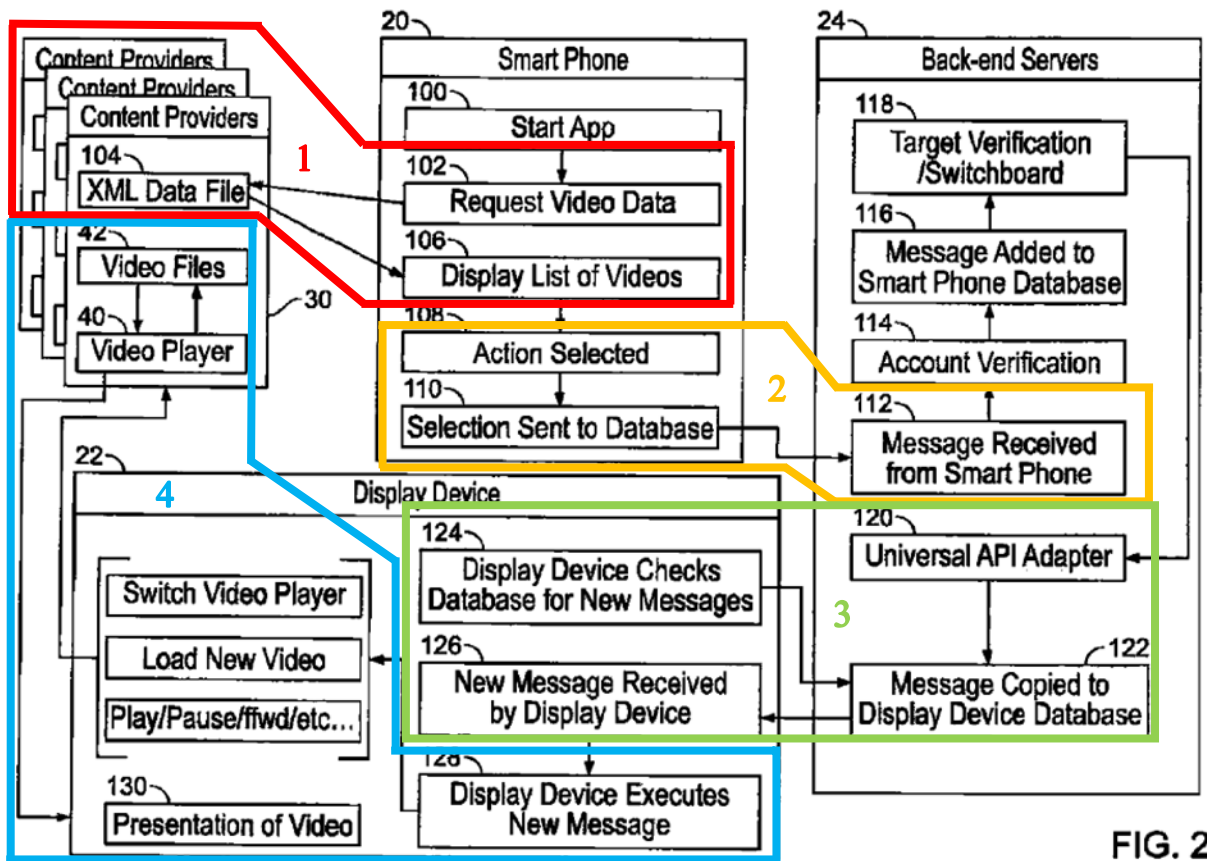


FIG. 2

Ex.1001 (Fig. 2, annotated)

(1) Using the Internet, the mobile phone 20 can retrieve information (*e.g.*, XML data files) about content (*e.g.*, video) from content providers and can display information to a user. *See id.*, 3:63–4:22. (2) The user may select an action to be performed (*e.g.*, play a selected video on a selected display device), which causes the phone to send a message to the server system. *Id.*, 4:23–29. In embodiments, the

message “contains a transmission code that includes data regarding the user information . . . , the secondary display it wants to connect to . . . , the location and name of the media player for the selected video, the command (e.g., play, pause, rewind, etc.), and the video file to be acted upon.” *Id.*, 4:29–35; *see id.*, Fig. 3 (depicting a possible transmission code format).

Because different media players may require different programming codes (e.g., JavaScript commands), the server system 24 loads protocols for the particular media player identified by mobile phone 20. *Id.*, 5:54–67. (3) Using these protocols, the server system converts an incoming universal command (e.g., play, pause etc.) “into the correct JavaScript (or other programming) code used by the target device 22 to control the specific player (block 120).” *Id.*, 5:58–62, 5:65–6:3; *see id.*, 6:7–18, 6:51–62. The correct programming code replaces the universal command in the message, which the display device may then retrieve from the server system. *See id.*, 6:3–6, 6:19–29. (4) The display device executes the message from the server, retrieving the identified content, retrieving and/or loading the particular media player identified (if not already stored and loaded on the display device), and executing the programming code that corresponds to the universal command. *See id.*, 3:18–23, 6:30–46, 6:60–62.

C. Prosecution History

The claims of the '251 patent issued after rigorous examination during which application claim 1, corresponding to issued claim 1, was twice rejected as anticipated by U.S. Published Application No. 2011/00600998 (“Schwartz”). Ex.1104, 218–33, 62–67; *see id.* at 218–249, 62–82 (office actions rejecting claims, including claim 1). Over the course of prosecution, Applicant amended claim 1 to distinguish over Schwartz. *See* Ex.1104, 275–276, 209. These amendments added limitations to recite that the display device “loads any one of a plurality of media players” and to require several steps pertaining to “the particular media player” identified in the “one or more signals” received in the server system from the personal computing device. *Id.* Applicant also added a limitation to the “converting” step requiring that “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.” *Id.* at 209. And the first three claim steps—“assigning,” “receiving,” and “storing,” which all pertain to a “synchronization code”—were added in their entirety through an Examiner’s amendment to obtain allowance. *Id.* at 270, 274–76.

Further, the prosecution history of the '251 patent made remarks about the meaning of the claim term “media player”:

In the context of the present application, it is clear that a “media player” refers to application software for playing back the video content.¹ Thus, the claims and specification refer in some cases, for example, to “loading” or “unloading” a media player. A particular display device, therefore, may, in some cases, be able to load or store any one of different media players.

Ex.1104, 190 n.2 (internal citations omitted). After a subsequent rejection (*id.*, 217), the ’251 patent claims were allowed with an examiner’s amendment. *See id.*, 271–287. That amendment added, in part, a requirement to claim 1 that the recited “display device” “loads any one of plurality of different media [] players,” and that the “media player” recited in the body of the claim be a “particular media player.” *Id.*, 276–77 (underlining in original).

¹ Then-pending claims in what became the ’251 patent recited “specifying a video file” and “playing the video content.” Ex.1104, 209–15.

II. PETITIONER’S GROUNDS AND CITED REFERENCES

Petitioner asserts through three (3) grounds that the challenged claims would have been obvious, including over Danciu² and Mahajan³ (Ground A); Danciu, Mahajan, and Calvert⁴ (Ground B); and Aldrey⁵ and Mahajan (Ground C).

A. Danciu

Danciu (Ex.1112) is U.S. Patent, No. 9,490,998, filed March 7, 2011, that purports to claim priority to U.S. Provisional Application 61/411,386, filed November 8, 2010. Danciu is assigned on its face to Google Inc. Google purports that Danciu spawned from, and describes, Google’s YouTube Remote and YouTube Leanback products considered by the examiner during prosecution and the subject of significant resources spent litigating their relevance to the ’251 Patent’s validity in *Touchstream v. Google*, by the jury and the Court itself. Ex.1104, 259 (examiner consideration); *Touchstream Techs. Inc. v. Google, LLC*, 6-21-cv-00569 (W.D. Tex., Jun. 4, 2021), Dkts. 275 at 17–20, 287 at 16–19, 292 at 9–10 (briefing), Ex.2022, at 43-44, Dkt. 262, Transcript of Proceedings on Jul. 19, 2023, at 975:6-15

² U.S. Patent No. 9,490,998 to Danciu (Ex.1112)

³ U.S. Published Application, No. 2009/0248802 to Mahajan (Ex.1114)

⁴ U.S. Published Application, No. 2004/0078812 to Calvert (Ex.1111)

⁵ U.S. Published Application, No. 2009/0172757 to Aldrey (Ex.1115)

(Google’s technical expert opining the Danciu application describes the YouTube Remote and Leanback system). The Danciu application itself was Joint Exhibit 21 at that trial, part of Google’s alleged prior art “GTS system” that included the products YouTube Remote, YouTube Leanback, and Google TV, and Google used Danciu in combination with over 20 other references to allege obviousness of the ’251 Patent. *Id.*

Danciu discloses a remote control 14 (blue) that is external to the servers 24A–24N (green), which receive messages including a remote control identifier and control information, and sends a message to a controlled device 18 (red) to control its operation. Ex.1112, 1:39–50, 4:58–67, Figs. 1, 6.

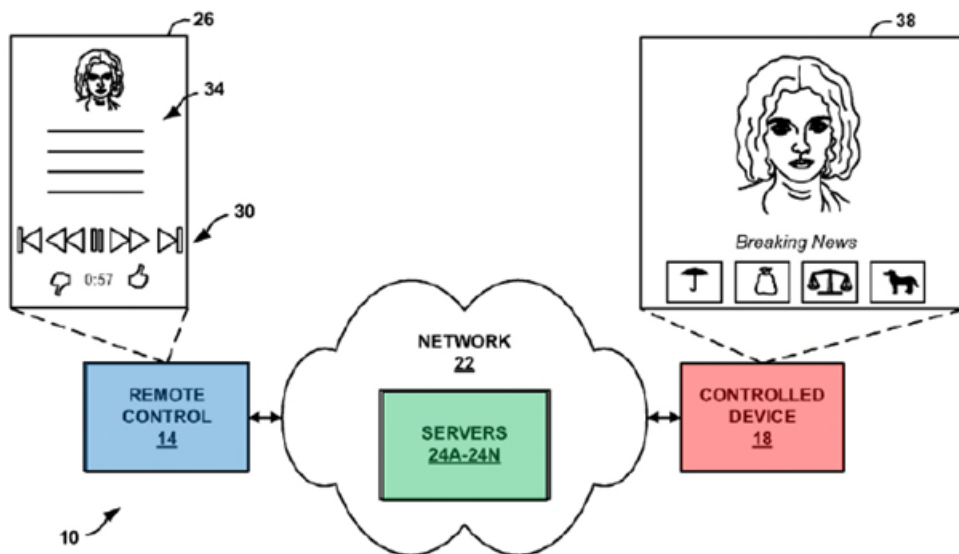


FIG. 1

Ex.1112, Fig. 1 (annotated by Petitioner)

B. Mahajan

The Mahajan reference is a U.S. Published Patent Application describing systems and methods for managing multimedia operations in remote sessions. Ex.1114. It envisions a client and a server, each with an “RTS Media Abstraction Module.” Ex.1114, [0025].

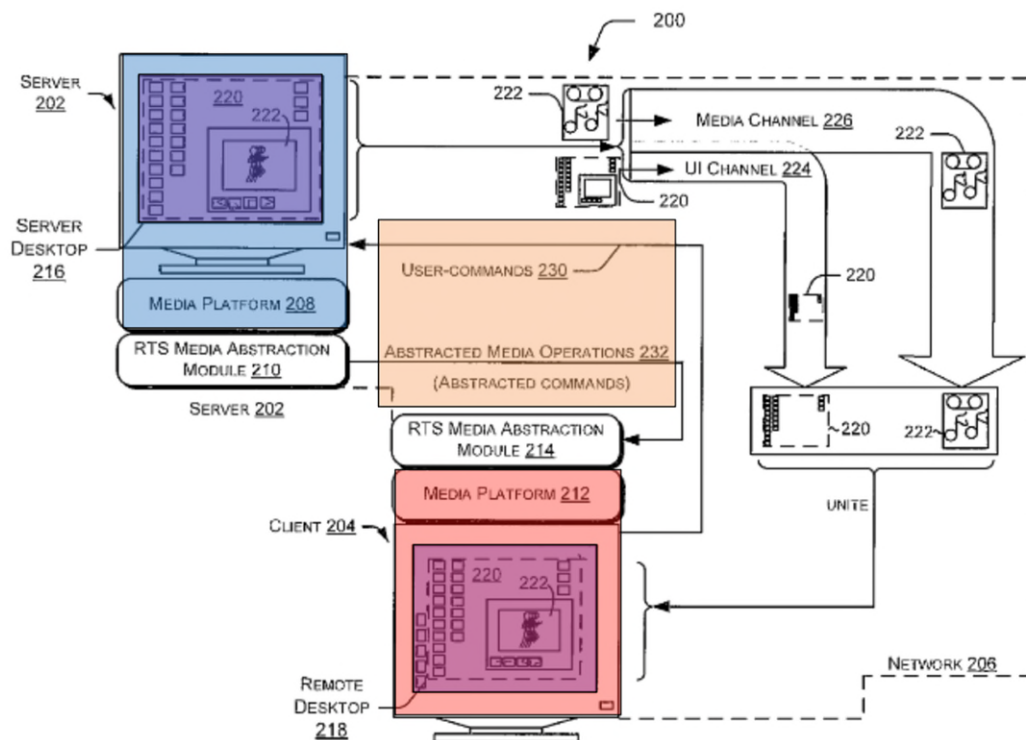


Fig. 2

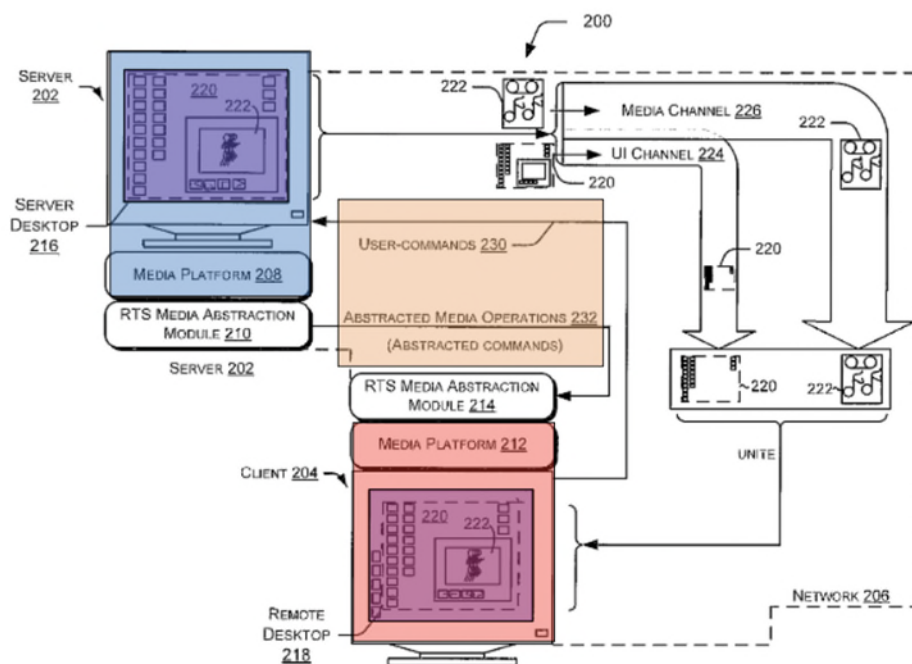
Ex.1114, Fig. 2 (annotated by Petitioner)

Mahajan teaches a “client-server collaboration session” wherein a client can use aspects of the server remotely. For example, the client uses the server’s graphical user interface (220), which is rendered within the client’s graphical user interface (shown in “remote desktop 218”). See Ex.1114, [0011], [0025]–[0026], Fig. 2. The

client 204 can also display media (shown in “media component 222”) from the server 202. *E.g., id.*, [0026]. Because the client and the server may use different “media platforms,” Mahajan describes a protocol for translating commands specific to the server platform into commands specific to the client platform. *See id.*, [0035]–[0042], Fig. 3.

Using this protocol, the user, operating client 204, first sends platform-specific commands for the server’s platform from the client to the server. *See id.*, [0035]; *see also id.*, [0037] (“[T]he server’s [remote terminal session (RTS)] media abstraction module 210 can receive media commands that are specific to the server’s media platform.”), Fig. 3. The server, using this RTS module, then translates the platform-specific commands to “generic or abstract” commands.” *See id.*, [0038]. The server then sends these commands to the client, which re-translates them into commands specific to the client’s media platform. *See id.*

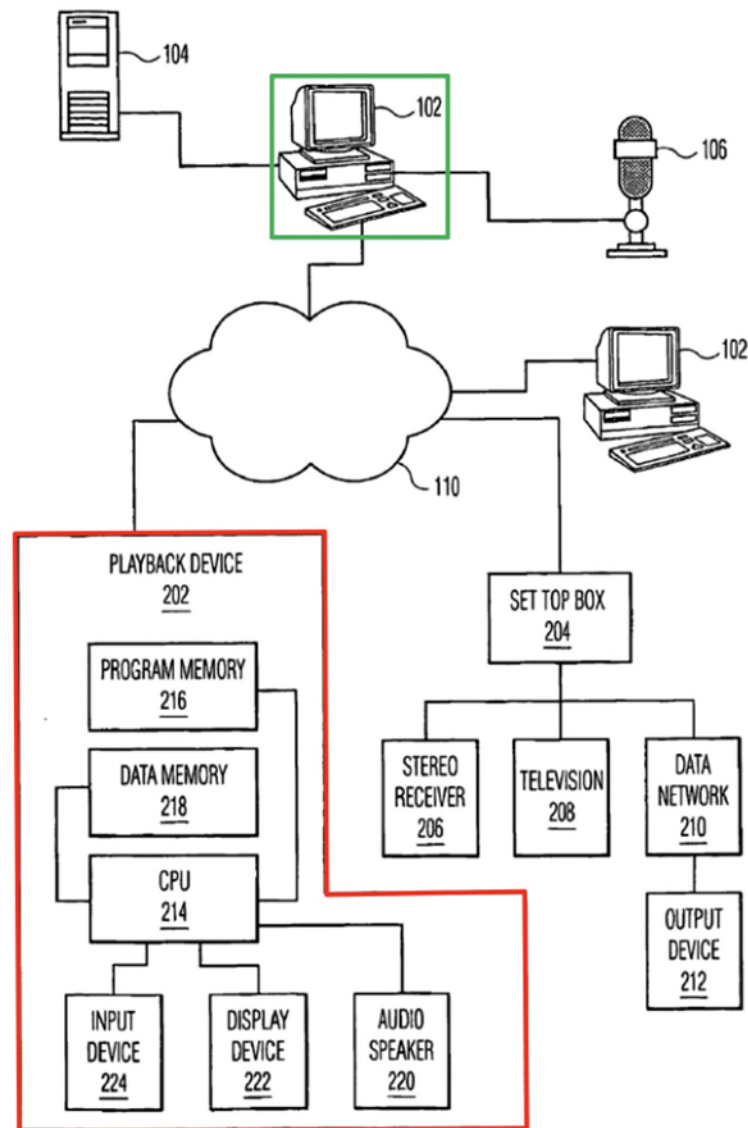
As described by Petitioner, Mahajan employs a five-step process to translate and re-translate commands within Mahajan’s “client-server collaboration session wherein a user may enter commands (**orange**) on Mahajan’s server (**blue**) for controlling content (**purple**) that is playing on a client device (**red**).” Pet. 28–29.



Ex.1114, Fig. 2 (annotated by Petitioner)

C. Calvert

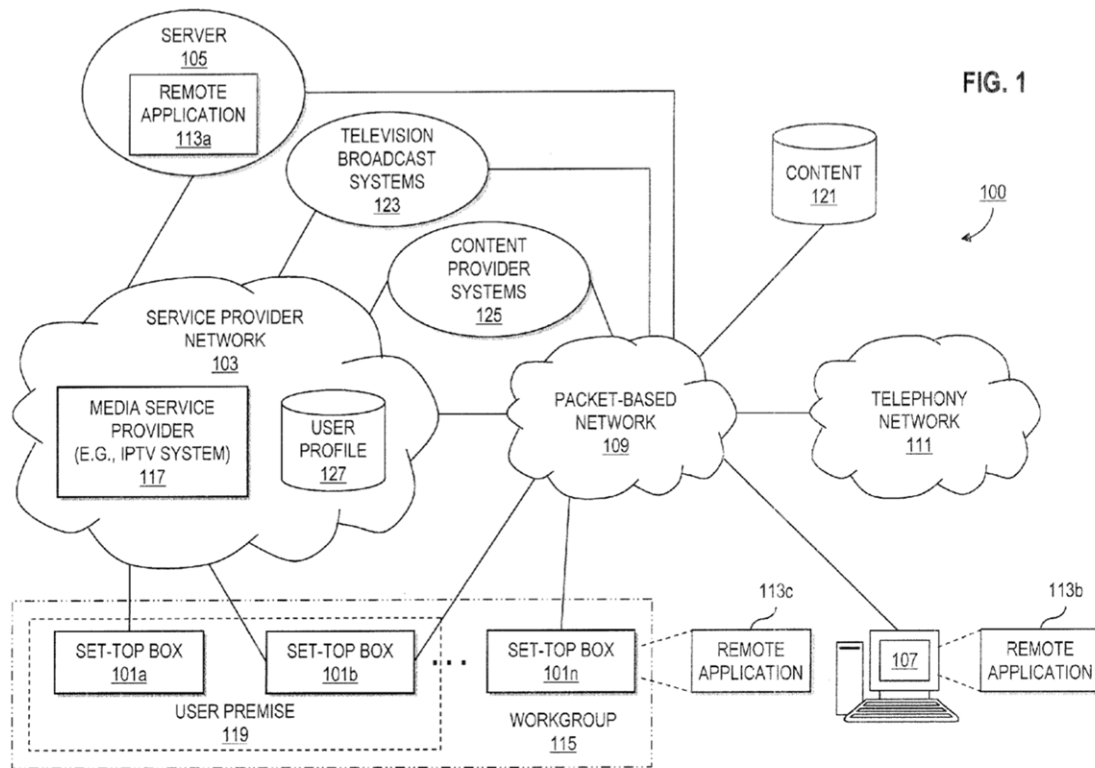
The Calvert reference is a U.S. Patent application disclosing a method and apparatus for acquiring media services available from content aggregators. It describes media players embedded in “document object model” structure and requested from aggregators (including codecs), wherein the embedded data structure comprises media service menus, locations, and types of media. Ex.1111, [0031]. No remote control is discussed, except in the unrelated context of a traditional television remote. [0064].



Ex 1111, Fig. 2 (annotated by petitioner)

D. Aldrey

The Aldrey reference is a U.S. Patent Application that teaches a method and apparatus for remote set top box management. Ex.1114. It envisions a remote application by which a user may adjust configuration settings on their set top box.



Ex.1114, Fig. 1.

For instance, a user may adjust parental controls or available channel information:

“remote application 209 may generate one or more control commands, transmit those commands to STBs 101a-101n, wherein the devices may be configured according to the commands. As such, the children will be able to immediately experience the VOD program instead of having to wait until their parent arrives home from work to manipulate one or more STBs to acquire the media content.”

Ex.1114, [0082]. Aldrey describes various other manipulatable settings, such as available channel information, favorite channels, program recording settings, viewing history, or software loaded in the STB. Ex.1114, [0020].

III. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner fails to show a reasonable likelihood of prevailing on any claim, even under the level of ordinary skill in the art it proposes. Accordingly, for the purpose of this Preliminary Response only, Patent Owner assumes Petitioner has correctly stated the level of ordinary skill in the art. Patent Owner reserves the right to present evidence and argument in support of a different position on this issue in other proceedings or later in this proceeding in the event necessary.

IV. CLAIM CONSTRUCTION

Patent Owner reserves the right to address the proper construction of any claim terms in the future, as needed. By reserving such arguments at this stage, Patent Owner does not concede that the Petition uses claim language consistent with its proper constructions.

V. PETITIONER HAS NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM

Petitioner's asserted grounds of obviousness are not supported by the evidence. The Petition thus fails to show a reasonable likelihood of prevailing on any claim, as required for institution. See 35 U.S.C. § 314(a).

The insufficiency of Mahajan infects each ground. Ground A fails because Mahajan does not teach “converting, by the server system, the universal playback control command into corresponding programming code to control playing of the video content of the display device by the particular media player” or the “storing” of information including the “programming code.” Danciu is not combined with Mahajan to remedy any of these deficiencies of Mahajan in Ground A.

Ground B fails for the same reasons; Calvert is only purportedly added for the receiving of signals “specifying a video file,” for “identifying a particular media player,” and for including a “universal playback control command.” Pet., 34–38. Petitioner does not contend that Calvert remedies the deficiencies of Mahajan.

Ground C fails for similar reasons: Mahajan fails on the same limitations it did in Grounds A and B, and the Petition does not assert Aldrey remedies these deficiencies.

**A. None of the Cited Art Discloses or Renders Obvious the
Programming Code Limitations of the Claims**

For every ground, Petitioner relies entirely on Mahajan for certain limitations associated with the *programming code* that appear in all three independent claims. See Pet., 39–42, 69–72 (arguments regarding claim 1); see also *id.*, 53, 55–56, 81, 83–84 (for independent claims 11 and 22, cross-referencing arguments regarding claim 1). But Mahajan does not disclose those limitations. Nor does Petitioner argue

that those limitations are obvious in combination with the other cited references. The Petition therefore fails to show a reasonable likelihood of prevailing on any claim.

B. Mahajan does not disclose the step of *converting, by the server system, the universal playback control command into corresponding programming code*, as recited by claim 1

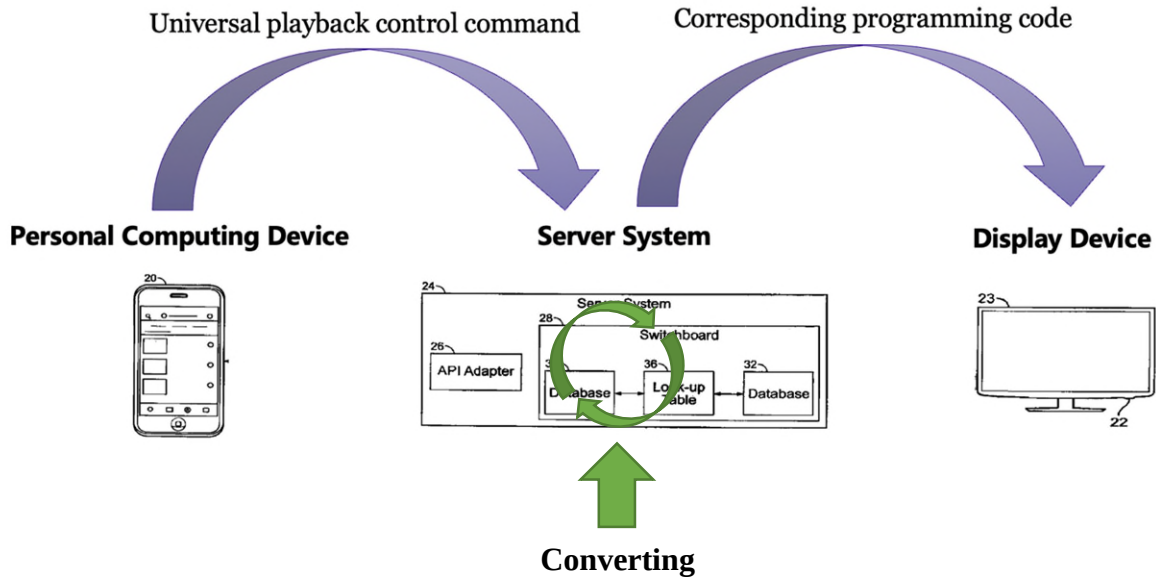
Mahajan does not disclose the limitations associated with claim 1's *converting* step. Indeed, the Petition fails to mention some of those limitations entirely. For others, it fails to account for the substantial differences between Mahajan's architecture and the architecture required by the claims of the '251 patent.

The *converting* step of claim 1 recites:

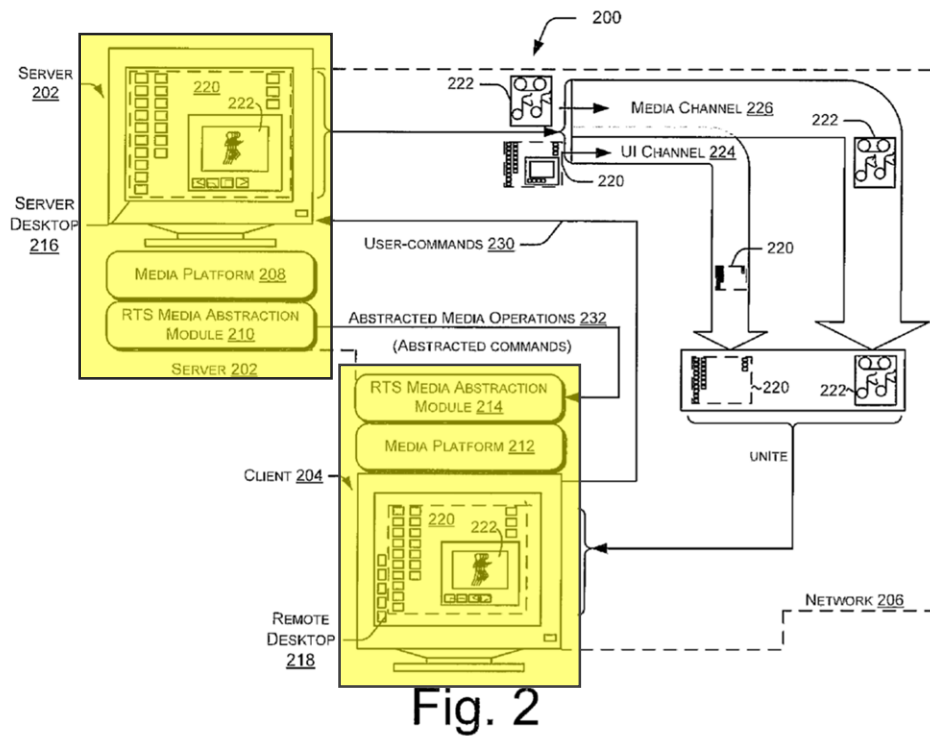
converting, by the server system, the universal playback control command into corresponding programming code to control playing of the video content on the display device by the particular media player, wherein converting the universal playback control command includes selecting from among a plurality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

Ex.1001, 11:43–51. Claim 1 also requires the *universal playback control command* be included in *one or more signals* received in the *server system*, from the *personal computing device*. *Id.*, 11:35–42. That *personal computing device* must be “separate from the server system and separate from the display device.” *Id.*, 11:28–30. The *programming code* is then stored in a database for transmission to or retrieval by the

display device. Id., 11:52–60. The flow chart below conceptually represents this process:



In contrast with the claims, Mahajan describes a two-part server-client architecture where the relevant conversion is done not by the server *but by the client*. In Mahajan’s architecture, the server (202) and the client (204) each have an RTS (Remote Terminal Session) media abstraction module (210, 214). Ex.1114, [0037], Figs. 2, 3.



Ex.1114, Fig. 2 (annotated)

Mahajan describes a user at the client controlling the media component (222) from the server by entering “user-commands” (230) at the client, which are then relayed to the server via the network (206). *Id.*, [0035]. Mahajan further describes these commands as being “platform-specific media commands of the server 202,” which are intercepted and received by “the server’s RTS abstraction module 210.” *Id.*, [0036]. The server’s RTS abstraction module converts the platform-specific media commands into generic commands to be sent to the client’s RTS abstraction module (214). *Id.* Then, “the client’s RTS abstraction module 214 can translate the generic media commands, . . . into media commands that are specific to the client’s media platform 212.” *Id.* In this way, the two abstraction modules work together to create

a “collaboration media abstraction layer 130” that “can abstract or genericize media playback commands specific to [the server’s] media platform 122.” *Id.*, [0022]; *see id.*, Fig. 1.

Referring to Mahajan’s Figure 3 (as annotated below), the user-commands (306A–I, **red**) for the server’s media platform are genericized by the server’s RTS media abstraction module (210, **orange**) using RTS mapping table 302. The corresponding generic commands (308A–I, 310A–I, **grey**) are sent to the client’s RTS media abstraction module (214, **blue**), which then converts the generic commands into platform-specific media commands (312A–I, **green**) for the client’s media platform:

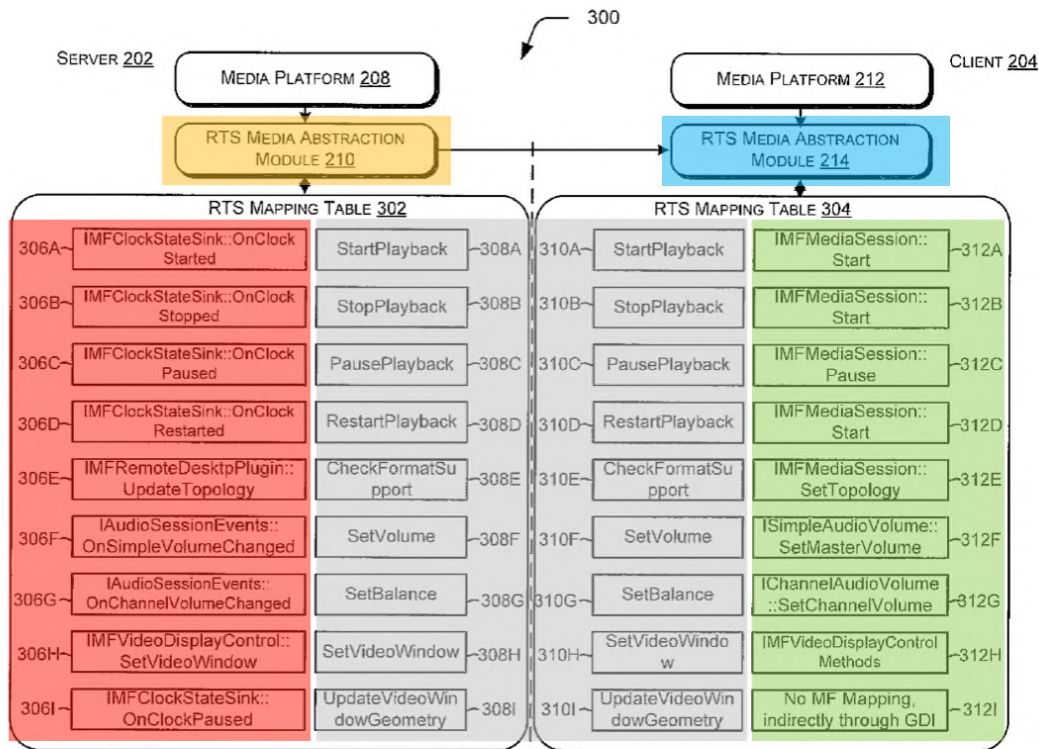


Fig. 3

Ex.1114, Fig. 3 (annotations added)

Given this operation of Mahajan’s architecture, Petitioner fails to show that Mahajan discloses the *converting* step. First, Mahajan does not disclose *converting* by the claimed component—*i.e.*, *converting a universal playback control command into corresponding programming code by the server system*. Second, Mahajan does not disclose any conversion that *includes selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player*. Third, Mahajan teaches that the generic commands alleged to be *universal playback control commands* are sent by the server to the client; it does not disclose the generic commands are ever *received* by a *server system*, as the claim recites.

1. Mahajan does not teach *converting, by the server system, the universal playback control command*

The process identified by Petitioner as being the *converting* step is performed by Mahajan’s client, not by the server. Mahajan teaches that the RTS abstraction modules work together to translate commands specific to a first media platform into commands specific to a second specific platform, using generic commands as a kind of shared language. Ex.1114, [0013]–[0014]. The server’s RTS abstraction module in Mahajan only converts specific commands into generic commands (alleged by Petitioner to be “universal commands”). *Id.*; *see also* [0063]. The only conversion

of the alleged *universal commands* is performed by the ***client's*** RTS abstraction module, not by the server. *Id.*

Petitioner acknowledges this aspect of Mahajan's disclosure, which Petitioner describes as follows:

- 1) commands for a type of media playing application on the server are received at Mahajan's server,
- 2) the commands are translated into a universal command,
- 3) the universal command is transmitted,
- 4) *the client* re-translates the universal command, and
- 5) the new specific command is executed.

Pet., 29 (citing Ex.1114, [0035]–[0036], Figs. 1, 2) (*italics added*). In this five-step process identified by Petitioner, Mahajan performs two separate translations. Even using Petitioner's contentions, the first step translates ***to*** a "universal command," so it does not result in the recited conversion to *programming code to control playing of the video content on the display device by the particular media player*. See *id.* Mahajan's second translation, where it "re-translates the universal command," is on the client, which corresponds to Petitioner's alleged *display device*. *Id.* (citing Ex.1102 ¶ 158); see also *id.*, 32 (arguing that in the combination with Danciu, the "controlled device" of Danciu—the alleged *display device*—would perform the second translation).

Likewise, Petitioner concedes that “[t]he RTS Media Abstraction module **of the client** (an API converter[]) **converts the commands** received by the client [] from the server [].” *Id.*, 40 (emphasis added) (citing Ex.1114, [0037]–[0043], Figs. 3, 5). Petitioner thus concedes that Mahajan does not disclose the alleged *converting* is by *the server system* and relies solely on obviousness for this limitation of the *converting* step. *See id.*, 41 (asserting “it would have been obvious . . . that one or more RTS Media Abstraction Modules *could* operate at a server”) (emphasis added), 72 (same). But Petitioner fails to support this conclusory assertion of obviousness, as discussed below. *See* Section V.C.

2. Mahajan does not teach *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*

No server in Mahajan’s system would have or use the *plurality of specific commands* of the claims for *converting the universal playback control command*, as the claims require. In particular, the *converting* of the claims produces *corresponding programming code to control playing of the video content on the display device by the particular media player*. And the *converting* must also include *selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player*.

Mahajan teaches, however, that the disclosed use of RTS abstraction modules means that neither the server nor the client needs to have information about the media platform(s) of the other. *See* Ex.1114, [0042]. Rather, the generic commands in Mahajan’s system serve as a kind of shared language, which the server and the client each “know” based on the mappings maintained in their respective RTS mapping tables (302, 304). *See id.*, [0038]. The server’s table translates **to** the generic commands, and the client’s table translates **from** the generic commands. *Id.*, [0038], [0042]. As a result, “the server RTS mapping table 302 may not need to take into account all the possible media platforms that can be employed on the client 204,” and “[t]he same can be said of the client’s media table 212.” *Id.*, [0042]. Mahajan teaches that this approach provides simplicity. *Id.*

In asserting this limitation is met, Petitioner relies entirely on Mahajan’s disclosure that certain “commands ‘may be specific to events associated with the playback of media files’ such as ‘when a media file is accessed for playback by one or more users at the client.’” Pet., 41 (quoting Ex.1114, [0037]). This cited disclosure is irrelevant to the limitation requiring that “converting the universal control command includes selecting from among a plurality of specific commands.” Ex.1001, 11:46–49. The “commands” described in the cited paragraph of Mahajan are “the commands received by the server’s RTS media abstraction module 210.” Ex.1114, [0037]. Mahajan states in the preceding sentence that the commands

received by the server's RTS media abstraction module are "media commands that are ***specific to the server's media platform.***" *Id.* (emphasis added). These commands are not (and are not alleged to be) universal control commands that are converted, as required by the claim.

Petitioner also fails to establish the relevance of this disclosure with its argument that "[m]essages containing the commands . . . are thus 'selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player.'" Pet., 41–42 (citing Ex.1102 ¶183). The claim language requires that *selecting from among a plurality of specific commands* be included in the step of *converting the universal playback control commands*. Ex.1001, 11:46–49. A message is not a *conversion*, and there is no evidence or argument showing how the "[m]essages containing [] commands" relate to the alleged *converting* process. See Pet., 41–42; Ex.1102 ¶183.

Petitioner therefore fails to show that Mahajan discloses the limitation of the "wherein" clause from the *converting* step.

3. Mahajan does not teach *converting . . . the universal playback control command*

Mahajan also does not disclose that the alleged *universal playback control command* being *converted* is one that was included in *one or more signals received, in the server system, from the personal computing device*, as required by the claim.

Mahajan discloses instead that Mahajan’s server generates a generic command (the alleged *universal command*) by translating a platform specific command received from the client. *See* Ex.1114, [0035]–[0037]; Pet., 29. Petitioner fails even to argue that Mahajan discloses a *universal playback control command* being received by an alleged *server system* from a *personal computing device*. Without disclosing such a *universal command*, Mahajan also cannot disclose *converting* it, as claimed.

Petitioner cannot prevail by arguing that Mahajan discloses “translating between universal commands and platform specific commands that can be understood by the client’s media platform.” Pet., 29. The claims require that a *universal playback control command* is received *in the server system, from the personal computing device*, and that the same *universal playback control command* is converted *by the server system*. Ex.1001, 11:35–45.

Petitioner therefore fails to show that Mahajan discloses the claimed method step of *converting . . . the universal control command*.

C. The combination of Mahajan with other art does not render obvious the claimed *converting* step and *programming code*

Petitioner fails to show that the claimed invention would have been obvious over Danciu and Mahajan (Ground A), Danciu, Mahajan, and Calvert (Ground B), or Aldrey and Mahajan (Ground C). All three grounds rely on Mahajan’s teachings alone for the *converting* step of claim 1. *See* Pet., 39–42, 69–72. As shown in Section

V.B above, Mahajan does not disclose key limitations associated with the *converting* step. Petitioner also fails to show that an ordinary artisan had a reason to combine Mahajan with the other asserted art in such a way that it would have satisfied these missing limitations.

“A reason for combining disparate prior art references is a critical component of an obviousness analysis; ‘this analysis should be made explicit.’” *InTouch Techs., Inc. v. VGo Communc’ns, Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (quoting *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)). The Petition lacks this critical motivation to combine analysis because it “fails to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*” *ActiveVideo Networks, Inc. v. Verizon Communc’ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) (emphasis in original) (citing *KSR*, 550 U.S. at 418). Petitioner thus fails to establish obviousness.

1. Petitioner fails to show the *converting* step would have been obvious over the combination of Mahajan with Danciu (with or without Calvert)

Petitioner fails to show that claim 1 would have been obvious over the combinations of Danciu and Mahajan or Danciu, Mahajan, and Calvert. Petitioner does not contend that either Danciu or Calvert discloses any of the limitations of the *converting* step that are absent from Mahajan. See Pet., 39–42. As noted above, Mahajan does not disclose all the limitations of that step. See Section V.B above.

Although the cited references fail to disclose all the limitations of the *converting* step, even in combination, Petitioner argues that they render that step obvious.⁶ *See id.* Petitioner fails to explain how or why such a combination would have resulted in the claimed invention, including the limitations missing from both Mahajan’s and Danciu’s disclosures. And Petitioner fails to provide any motivation to combine these references.

First, Petitioner fails to address the critical deficiencies in Mahajan when it argues, “it would have been obvious to a POSITA that one or more RTS Media Abstraction Modules could operate at a server, such as in Servers 24A-24N.” Pet., 41 (citing Ex.1114 [0018], [0058], [0078]; Ex.1102 ¶182). Mahajan already discloses that one of the two RTS media abstraction modules—the one identified as module 210—operates at Mahajan’s server. *See* Ex.1114, [0036]–[0037], Figs. 2, 3. The abstraction module on Mahajan’s server does not perform the claimed *converting*, however. *See* Section V.B above. Petitioner’s proposed combination merely substitutes one or more of Danciu’s servers 24A–24N for Mahajan’s server. The operation of the module, however, is not modified in Petitioner’s combination and therefore does not satisfy the limitations of the *converting* step. *See* Pet., 41–42.

⁶ Petitioner does not contend that the further combination with Calvert affects obviousness as to the *converting* step. *See* Pet., 39–42 (no discussion of Calvert).

Mahajan teaches that it is the other RTS media abstraction module (214)—the one that operates at the client, not the server—that can translate “generic media commands . . . into commands that are specific to the client’s media platform.” *Id.*, [0036]; *see id.*, [0038], [0040]. Mahajan also teaches that the server’s RTS media abstraction module (210) does not need information about the client’s media platform to operate. *Id.*, [0042]. And Mahajan teaches that the server’s module (210) generates the generic commands that Petitioner identifies as the *universal commands*. An RTS media abstraction module merely operating on one of Danciu’s servers, instead of Mahajan’s server, would still not *convert 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*. There is also no evidence that the *converting* performed by the server’s RTS media abstraction module, operating on Danciu’s servers instead of Mahajan’s server, would *include selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player*.

Second, Petitioner proposes contradictory theories for the combination of Mahajan with Danciu, rendering its entire obviousness theory incoherent. For example, in the context of the *receiving* step (identified as limitation [1E]), Petitioner asserts an obviousness theory in which none of the operations performed by Mahajan’s RTS media abstraction modules are implemented at the alleged *server*

system. See Pet., 32. Petitioner argues in that context that Danciu’s remote control, the alleged *personal computing device*, would perform the disclosed operations of the server’s abstraction module in Mahajan. See Pet., 32 (“Danciu’s remote control would translate commands associated with a first type of media playing application to a generic format, [and] transmit them to the controlled device, . . .”). In the same sentence, Petitioner asserts that Danciu’s controlled device, the alleged *display device*, would perform the operations of Mahajan’s client abstraction module. See *id.* (“Danciu’s remote control would . . . transmit [generic commands] to the controlled device, which would translate them to a command associated with a second type of media playing application for execution.”).

Under this alternate theory, Mahajan’s abstraction modules operate entirely on components other than Danciu’s servers. See Pet., 32. That stands in direct contradiction of Petitioner’s argument (in the context of the *converting* step) that “it would have been obvious to a POSITA that one or more RTS Media Abstraction Modules could operate at a server, such as in Servers 24A-24N.” Pet., 41. It also eliminates any possibility that the alleged *converting* from Mahajan would be performed by Danciu’s servers 24A–24N—the alleged *server system*. Any *conversion* would be performed instead by Danciu’s other system components, *i.e.*, the “remote control” and the “controlled device.” Thus, regardless which theory Petitioner applies, the resulting combination does not satisfy the *converting* step.

Third, the Petition merely asserts that “it would have been obvious to a POSITA that one or more RTS Media Abstraction Modules *could* operate at a server, such as in Servers 24A-24N.” Pet., 41 (citing Ex.1114, [0018], [0058], [0078]; Ex.1102 ¶182) (emphasis added). But whether it would have been obvious that these modules *could* operate at a server fails to set forth any prima facie case that a POSITA *would* have made such a modification and would have been motivated to do so. This is insufficient for obviousness. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (arguing that references “could” be combined “does not imply a motivation to pick [the references] and combine them to arrive at the claimed invention.”); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1074 (Fed. Cir. 2015) (“Obviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed inventions.”); *William Wesley Carnes, Sr., Inc. v. Seaboard International, Inc.*, IPR2019-00133, Paper 10 (PTAB May 8, 2019), at 18 (“asserting that a POSITA ‘could’ have combined the references to reach the claimed invention [is] insufficient for obviousness”). Petitioner’s suggestion that certain operations “could” be performed on the server does nothing to establish that a POSITA “would” have performed such operations on the server based on any motivation. Petitioner, therefore, fails to state a prima facie case of obviousness for this additional reason.

Fourth, Mahajan teaches away from performing any claimed *converting* at the server by locating one or more RTS Media Abstraction Modules at the server and it is contrary to Mahajan’s principle of operation, because Mahajan discloses a preference for locating them on the client. Specifically, Mahajan teaches that by locating them on the client, the server “may not need to take into account all the possible media platforms that can be employed on the client 204” and Mahajan teaches that this approach provides simplicity. Ex.1114, [0042]. This simplicity would be entirely defeated by Petitioner’s proposed modification, which demonstrates Mahajan teaches away from such a modification and this modification would be contrary to Mahajan’s principle of operation.

Petitioner therefore fails to show a reasonable likelihood of prevailing on Grounds A and B as to claim 1 and its dependent claims.

2. Petitioner fails to show the *converting* step would have been obvious over the combination of Mahajan with Aldrey

As with the Danciu-based Grounds, Petitioner fails to show how or why an ordinary artisan would have combined or been motivated to combine Mahajan with Aldrey in order to achieve the claimed invention. Petitioner again relies entirely on Mahajan for limitations of the *converting* step that Mahajan does not disclose. Pet., 69–72; see Section V.B above. Petitioner does not rely on Aldrey for these limitations at all. Pet., 69–72.

Petitioner’s rationale for the proposed Aldrey-Mahajan combination is virtually identical to the insufficient rationale provided for the other two grounds. *Compare* Pet., 69–72 *with id.*, 39–42. Petitioner suggests that “Mahajan’s RTS Media Abstraction Modules could operate at a server, such as Aldrey’s Service Provider Network 103.” *Id.*, 72. But Petitioner again fails to argue that this implementation would result in any modification to the modules, so they would still not satisfy the *converting* step’s limitations.

Petitioner also fails to address the “wherein” clause of the *converting* step anywhere in its discussion of the Aldrey-Mahajan ground. *See id.*, 69–72. In this way, the Petition is even more deficient in its showing for Ground C than it is for Grounds A and B.

Further, like discussed above, Petitioner’s contention that a POSITA “could” make this modification fails to set forth a *prima facie* case that a POSITA “would” have made such a modification based on any motivation to do so. This alone is fatal to Petitioner’s proposed combination for the same reasons discussed above. *See Personal Web Techs.*, 848 F.3d at 994; *Belden Inc.*, 805 F.3d at 1074; *William Wesley Carnes, Sr.*, IPR2019-00133, Paper 10 at 18.

Finally, Mahajan teaches away from this proposed combination of relocating claimed *converting* from the client to the server and it is contrary to Mahajan’s

principle of operation for the same reasons as discussed above, including that it would defeat Mahajan’s preferred simplicity.

Petitioner therefore fails to show a reasonable likelihood of prevailing on Ground C as to claim 1 and its dependent claims.

D. Petitioner’s Grounds Based on Danciu Also Fail Because Danciu Does Not Disclose or Render Obvious the Limitations Relating to the *Particular Media Player*

Petitioner’s Grounds based on Danciu (*i.e.*, Grounds A & B) also fail for the simple reason that Danciu discloses a system for controlling a single media player. In contrast, a basic aim of the ’251 patent is (as the preamble of claim 1 states) “controlling presentation of video content on a display device that loads *any one of a plurality of* different media players.” Ex.1001, 11:22–24 (*italics added*). This aim is reflected in multiple claim limitations, and Danciu does not disclose or suggest those limitations.

For instance, the *server system* receives *signals* that identify a particular media player for playing the content of a specified video file. *Id.*, 11:35–38. The need to identify a particular media player implies there are multiple media players from which to choose, confirming the preamble’s description. Otherwise, the word “particular” would become meaningless. *See, e.g., Felix v. Am. Honda Motor Co.*, 562 F.3d 1167, 1178 (Fed. Cir. 2009) (rejecting proposed construction where, under that construction, another claim term “would be surplusage”).

The rest of the claim language further supports that control of multiple media players is required in the claims of the '251 patent. The *server system* converts a “universal playback control command into corresponding programming code to control playing of the video content on the display device by *the particular media player*.” Ex.1001, 11:37–38, 11:44–46. Moreover, claim 1 specifies that “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*.” *Id.*, 11:46–51. By using a universal command and having the *server system* convert it, the *personal computing device* can control presentation by the multiple media players without needing to maintain control information particular to each one.

Danciu, on the other hand, envisions remote control of a single media player—a much different endeavor. Figure 7 of Danciu demonstrates the simplicity of its implementation by illustrating the operation of its network servers communicating with a remote control:

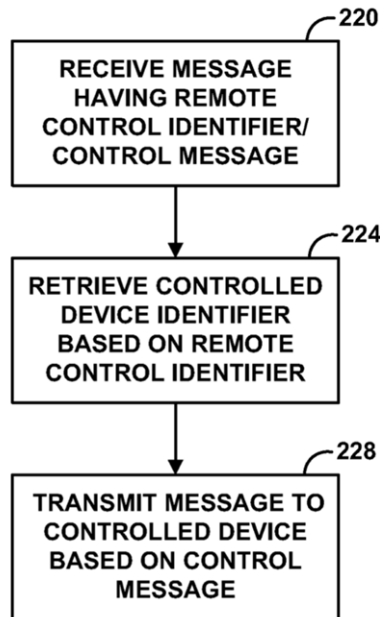


FIG. 7

Ex.1112, Fig. 7; *see id.*, 3:1–3

The network server of Danciu does not receive messages identifying a *particular* media player, nor is there any disclosure to suggest it does. The disclosed system therefore need not (and, in fact, cannot) perform other steps relating to *the particular media player* recited by the claims, *e.g.*, the claimed *converting* step.

Petitioner fails to show that Danciu teaches or suggests that the *server system* receives signals “identifying a *particular* media player for playing the video content,” as recited by claim 1. Ex.1001, 11:37–38; *see Pet.*, 25. Danciu’s “session identifier (SID) and control information” do not teach this limitation, as Petitioner suggests. *Pet.* 27 (citing Ex.1112, 14:13–64). In those teachings, Danciu describes only methods for device management; nowhere does it describe messaging that

identifies particular media players. *See* Ex.1112, 14:39–43, 14:50–53, 14:53–64. Petitioner alternately points to “controls” and “information” on the remote user interface that are “associated with content being played on controlled device.” Ex.1112, 5:31–33; Pet. 27. But being associated with a piece of content is not *identifying a particular media player*, nor does the Petition provide any evidence that it is. *Id.*

In a deft misreading, the Petition cites Danciu’s incidental reference to other media players—YouTube, Netflix, or Hulu—to suggest Danciu’s remote might “control” any one of them. Pet. 7; Ex.1112, 11:29–35. But the cited portion of Danciu describes control of these media players by the “user interface 120” on the controlled device itself. *Id.*; *see also* Ex.1112, 2:56–60, Fig. 4. Nowhere does Danciu envision “remote” control of multiple media players. Danciu only describes support for “YouTube, Hulu, Netflix” by the controlled device—in other words contextless messages from a remote and *not* messages identifying a media player, identifying content, or issuing playback control commands. Ex.1112, 13:4–15. Unrelated use of another media player by different methods does not transform the teachings of Danciu focused on a single media player: YouTube.

Petitioner makes no attempt at a comprehensive mapping of these other media players as teaching the methods of the ’251 Patent. At any rate, such remote interaction with a user interface on the display device itself would not require any

context from the remote, such as identifying a media player, or even identifying playback controls or content, and consequently fail to teach the limitations of the '251 Patent.

E. Petitioner Relies on the Same Arguments for Every Claim

For all Grounds, the Petition relies on and incorporates the arguments it makes for claim 1 in its challenges to independent claims 11 and 22. Pet. 51–54, 54–58. The same fatal deficiencies in the challenge to claim 1 infect the analysis regarding the other independent claims for all grounds. *See id.* Petitioner therefore fails to show a reasonable likelihood of prevailing on any independent claim for any ground for the reasons explained above. Nothing in the analysis of the dependent claims changes that.

The Petition thus fails to establish a reasonable likelihood of prevailing on any claim, and the Board should deny institution.

VI. THE BOARD SHOULD DENY THE PETITION UNDER § 325(D) TO BECAUSE THE OFFICE PREVIOUSLY CONSIDERED MAHAJAN FOR SIMILAR CLAIMS

Critical references of the Petition constitute the same or substantially the same art that has already been considered by the Patent Office. The Board may deny institution where “the same or substantially the same prior art or arguments” have already been presented to the Office. 35 U.S.C. § 325(d). The Mahajan reference is necessary to every ground of the petition, and the Office has already considered the

teachings of Mahajan in a substantially similar context. Ex.2001, 13–14 (*citing* Mahajan (Ex.1114), ¶[0011]).

The examiner considered Mahajan during prosecution of a patent in the same family. The '251 Patent is a continuation of U.S. Patent Application No. No.13/157,821. And U.S. Patent No. 11,048,751 ('751 Patent), contemporaneously challenged by Petitioner, resulted from a continuation-in-part of the very same application: No. 13/157,821. *See* IPR2024-00323, Paper 2 (PTAB Dec. 27, 2023); IPR-00324, Paper 2 (PTAB Dec. 27, 2023). The '751 patent resulted from a continuation-in-part application that did not add new material that is relevant here.⁷

The '751 Patent claims “programming code” functionality slightly different than the '251 Patent, but the functions remains substantially similar. The '751 Patent’s independent claim 1 includes the limitation:

“receiving, from the remote server device, a first message that includes *at least one command in a first format*, the first message being received based at least in part on the stored association and *on a second message including at least one command in a second format* having been sent from the associated second computing device.”

⁷ The added material in the specification included changing the word “device” to “devices” and the word “drawings” to “figures.” It also added a disclaimer stating, “The present technology is illustrated by way of example, and not by way of limitation, in the figures of the accompanying drawings.”

Ex. 2014, '751 Patent, 11:62–67. The '751 Patent also includes dependent claims 2 and 3, which read: “2. [t]he non-transitory computer storage medium of claim 1, wherein each command of the at least one command in the second format *is a universal command*” and “3. [t]he non-transitory computer storage medium of claim 2, wherein the first format is different than the second format.” '751 Patent, 12:11–16.

The examiner asserted Mahajan in an obviousness rejection of claims 2 and 3, in view of Morris (US2012/0130971A1).⁸ Ex.2017, 9–10. The examiner stated “Mahajan teaches translating a platform specific media playback command into a generic or universal media playback command for transmission to a client.” *Id.* at 9. The applicant responded May 9, 2019, explaining Mahajan’s architecture is incompatible with these limitations:

“[B]y virtue of the described embodiments of Mahajan, Mahajan simply cannot teach one or more computing devices that perform operations including, among other things, receiving, *from the remote server device*, a first message that includes at least one command in a first format, wherein the first message is received based at least in part on a second message including at least one

⁸ Claim 2 read at the time “wherein a command in the second format is a universal command” and did not include the “each” language.

command in a second format having been sent *from the associated remote computing device.*”

’751 File History, Applicant Remarks, May 9, 2019, at 13 (*emphasis in original*). The same architectural issues discussed *supra* in Section V.A apply to this Petition: Mahajan envisions a client-server relationship wherein the server renders its graphical user interface on the client itself and command translations occur for the device performing the conversion. *Id.* Mahajan’s translation and re-translation functions do not make sense in the context of the ’251 Patent’s “personal computing device” and “server system,” just as they did not make sense in the context of the ’751 Patent’s “remote server device” and “remote computing device”—not to mention the total inability of Mahajan’s teaching to encompass the other architectural components: the ’251 Patent’s “display device” and the ’751 Patent’s “first computing device.”

Again with regard to Mahajan, as noted above, *infra*, the applicant explained during prosecution of a sister patent application that “Mahajan recites ‘[c]ollaboration sessions can provide a remoting experience between a client computer (hereinafter, ‘client’) and a server computer (hereinafter, ‘server’)’ and that ‘[c]ollaboration can involve representing a portion, or all, of the server’s graphical user-interface (GUI) on the client.’” Ex.2001, 13. (citing Ex.1114, [0011]). Thus, Mahajan cannot teach “receiving, in the server system, one or more signals

from the personal computing device” where those one or more signals (i) specify “a video file to be acted upon,” (ii) “identify a particular media player for playing the video content,” and (iii) “further include[e] a universal playback control command for controlling playing of the video content on the display device by the particular media player.” ’251 Pat., 11:35–42. The same deficiencies are present in the Petition.

Further, the asserted Danciu art is substantially similar to and also cumulative of art that was considered by the Office. In addition, not only has the Office considered substantially similar art, so has a federal jury. Danciu’s assignee, Google, provided testimony that the Danciu application describes the “YouTube Remote” and “YouTube Leanback” products—which were considered by the examiner during the prosecution of the ’251 Patent. *See infra*, Section II.A. The Petition asserts the Patent resulting from that application—representative of the very same YouTube Remote product that was the subject of extensive expert discovery and contested in a jury trial, and representative enough of the product asserted as prior art to be entered in evidence in that trial. By now, the examiner and a federal jury have considered this prior art, and both found it lacked the teachings of the ’251 Patent. Ex.1104, 259; *Touchstream Techs. Inc. v. Google, LLC*, 6-21-cv-00569 (W.D. Tex., Jun. 4, 2021). Danciu, therefore, is substantially similar to and cumulative of art that has been considered by the Office and it is the same as prior art that was considered in District Court.

In short, the Office has already considered argument substantially similar to the one the Petition makes: that Mahajan allegedly teaches the '251 Patent limitation 1G “converting, by the server system, the universal playback control command into corresponding programming code.” Pet., 39–42, 69–72. The Petition introduces no other references for this limitation. The Office and a federal jury already considered substantially similar art to Danciu as well. Petitioner has nothing new to add to these prior disputes—they fail for the same reasons they failed before.

A. The *Becton, Dickinson* Factors Favor Denying Institution under 35 U.S.C. § 325(d)

Section 325(d) provides the Board, acting on behalf of the Director, with discretion to deny institution on a petition for IPR because “the same or substantially the same prior art or arguments previously were presented to the Office.” Under Board precedent, “the question of whether proffered art or arguments are ‘the same or substantially the same’ as art or arguments previously presented to the Office is a highly factual inquiry, which may be resolved by reference to the factors set forth in *Becton, Dickinson*.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (Feb. 13, 2020) (precedential) (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017)). The six factors from *Becton, Dickinson* favor denial of the Petition:

Factor (a), the similarities and material differences between the asserted art and the prior art involved during examination, favors denying institution because Mahajan was considered itself during prosecution of a sister patent. Further, Danciu was considered in the form of its implemented system, YouTube Remote, and its assignee argued it accurately portrays that system, which was in front of the examiner during prosecution of the '251 Patent. Dkt. 262, Transcript of Proceedings on Jul. 19, 2023, at 975:6–15 (Google’s technical expert opining the Danciu application describes the YouTube Remote and Leanback system). The differences between Danciu and the art in front of the examiner are thus immaterial according to its assignee.

Factor (b), the cumulative nature of the asserted art and the prior art evaluated during examination, favors denying institution because Mahajan was considered in a sister application and Danciu is substantially the same as and cumulative of the same YouTube Remote art already considered. Ex.2001, 13–14, *citing* Mahajan, at 91[0011] (Ex.1114).

Factor (c), the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection, favors denying institution because Mahajan was a basis for rejection by the examiner and successfully overcome via argument in a sister application. *Id.*

Factor (d), the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art, favors denying institution because, as explained above, the Petition re-asserts the very same subject matter from Mahajan that was successfully overcome via argument during prosecution of a sister patent application, namely the claim limitations in this patent family related to “translating” of “playback command[s].” Ex.2017, 9. Mahajan fails for the same reasons here.

Factor (e), whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art, favors denying institution because Petitioner has made no showing the Examiner erred in its evaluation of the asserted prior art. Indeed, Petitioner has not addressed the Examiner’s treatment of Mahajan in a sister patent application.

Factor (f), the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments, favors denying institution because the Petition does not tread any new ground related to Mahajan.

In summation, these factors show the same or substantially the same art or arguments has already been considered and no material errors were made. The Board should, therefore, exercise its discretion under § 325(d) to deny institution.

VII. THE BOARD SHOULD EXERCISE DISCRETION UNDER § 314(A) TO DENY THE PETITION

Petitioner waited almost ten months to file its Petition after Patent Owner served Petitioner with the Complaint filed in the Eastern District of Texas. This unwarranted delay makes it almost certain that trial in the district court will conclude before the Board has the opportunity to reach a final written decision. Instituting IPR on this Petition, despite considerable investment by the parties and the trial court in the co-pending litigation, would frustrate Congress's intent that IPRs serve as a faster, less costly alternative to litigation on the issue of invalidity. *See, e.g., SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1357–58 (Fed. Cir. 2016) (Newman, J., dissenting-in-part) (collecting evidence of legislative intent regarding § 315 estoppel), *rev'd in part by SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

The Board has recognized the importance of staying consistent with this goal and laid out factors meant to guide the exercise of discretion whether to institute trial on a petition. *See NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 5–16 (PTAB Mar. 20, 2020) (precedential). Applying

the *Fintiv* factors (as further clarified in the Director’s Memorandum⁹ dated June 21, 2022) establishes that the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution in this proceeding.

A. Factor 1: Likelihood of Stay

Petitioner has not moved for a stay in the district court proceeding. *See generally* Exs. 2017, 2018, 2019. Petitioner asserts its intention “to request a stay.” Pet., 17. It does not make any showing that its potential request is likely to be granted. *See id.*

Petitioner concedes that “[f]actor one appears neutral.” Pet. 8; *Sand Revolution II, LLC v. Cont’l Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative). The parallel proceeding is unlikely to be stayed pending IPR, as that Court rarely grants such stays. Ex.2002 (26% grant rate of 95 orders). Although the Board cannot conclusively know what the Court will do, it is reasonable to assume a stay is unlikely, as for a variety of factors such stays

⁹ Director Vidal’s Memorandum to Members of the Board re: Interim Procedure for Discretionary Denials in AIA Postgrant Proceedings with Parallel District Court Litigation (available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf) (hereinafter “Director’s Memorandum”).

are rare in that Court, the parallel litigation is proceeding on schedule, and the late hour of this Petition puts the trial only a few months away from the institution decision.

Factor one favors discretionary denial.

B. Factor 2: Trial Date Relative to Final Written Decision Due Date

Trial in the district court is scheduled to begin October 28, 2024. Ex.2003 (Docket Control Order). The Board’s deadline to reach a final written decision is likely to fall in July 2025, assuming no cause arises to extend that time. *See* 35 U.S.C. §§ 314(b), 316(a)(11); 37 C.F.R. § 42.100(c). Accordingly, the present trial date is more than **eight months** before the Board would issue a final written decision in this proceeding. This weighs heavily in favor of exercising discretion to deny the Petition, especially because Petitioner has offered no justification for its delay in requesting IPR. *See Verizon Bus. Network Servs. LLC v. Huawei Techs. Co. Ltd.*, IPR2020-01292, Paper 13 at 12 (PTAB Jan. 25, 2021) (trial date seven to eight months before FWD weighs in favor of discretionary denial); *see also Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 8–9 (PTAB June 15, 2020) (even when Petitioner’s delay in filing was justified, trial date seven and a half months before FWD “weighs moderately in favor of Patent Owner”).

The time-to-trial in the Marshall Division of the Eastern District of Texas (where the case is pending) also supports the conclusion that the district court will

conduct trial before this proceeding is over. *See* Ex.2004; *see also* Director’s Memorandum at 8–9. The trial court has held 98 jury trials in patent cases filed since 2012. Ex.2004. The median time from complaint to jury trial was 21 months, with the 25th to 75th percentile of cases occurring 18 to 28 months after the respective complaints. *Id.* The current trial date in the parties’ co-pending litigation is just over twenty months after the complaint, true to the median schedule, but trials in the Marshall Division have happened even earlier. *See id.* (reporting minimum time-to-trial of 7 months and 2nd percentile time of 14 months); Ex.2005 (Filed February 17, 2023); Ex.2003, 2 (Scheduling “Jury Selection/Trial” for October 28, 2024). In view of the trial court’s historical statistics, the current trial date is credible, and there is no evidence that the needs of the particular case will require moving the trial date. (Petitioner mentions its motion to transfer venue as a possible reason the trial date would change, but that motion has since been denied. *See* Ex.2006, 8. Even if one assumes trial might be delayed and applied the 75th percentile time to trial for the court (28 months), *see* Ex.2004, the hypothetical trial date would be June 15, 2025. This is still before the final written decision deadline.

Factor 2 weighs in favor of discretionary denial. Petitioner has not disputed that this factor weighs in favor of discretionary denial. *See* Pet., 17 (omitting any mention of the weight given to Factor 2). Instead, it merely asserts that it “does not warrant denial.” *Id.* With trial in the district court scheduled to begin just three

months after the Board makes a decision on institution and over eight months before the final written decision date, this factor weighs in favor of denying institution.

For these reasons, factor 2 weighs heavily in favor of discretionary denial of the Petition.

C. *Factor 3: Investment in Trial Court Proceedings*

By the institution deadline, the parties will have invested substantial time and effort in the co-pending litigation (as shown below), and Petitioner's lack of diligence is a contributing cause of this. Accordingly, factor 3 weighs heavily in favor of discretionary denial. This factor is evaluated based on the date of the Board's decision on institution. *See Verizon Bus. Network*, IPR2020-01292, Paper 13 at 14 ("[T]he appropriate time to evaluate the investment of the parties in the Parallel Proceeding is at the time of the institution decision and not at the time of the filing of the petition."). Petitioner cites the incomplete claim construction process and close of fact discovery as reasons this factor does not warrant denial, but both of these will be complete before the board is expected to make its institution decision in July 2024. Fact discovery indeed closes in June, and the Court will hold the claim construction hearing May 16, 2024.

The district court is likely to issue a claim construction order before the deadline for the decision on institution, and Patent Owner will (if authorized) notify the Board when that order issues. The parties have exchanged multiple rounds of

infringement and invalidity contentions, including Patent Owner’s Preliminary Infringement Contentions (served May 19, 2023), and Petitioner’s Third Supplemental Invalidity Contentions (served March 27, 2024). *See* Exs. 2007, 2009. Fact discovery closes in about eight weeks (on June 10) (Ex.2003, 4), and the parties have already served extensive written discovery on the merits, including third-party discovery. *See* Ex.2022, 43-44. The production of documents and ESI is already substantially complete. *See* Ex.2003, 5. By the deadline for the decision on institution, all expert reports will have been disclosed and expert discovery will be closed. *See* Ex.2003, 4.

This investment is similar to that in *Verizon Business Network*, which the Board determined “weighs in favor of exercising discretion to deny institution.” IPR2020-01292, Paper 13 at 14–15. In that case, like here, “by the time of the institution decision in this proceeding, the parties in the Parallel Proceeding will have completed substantial work, including fully briefing and arguing claim construction, completing fact discovery, and exchanging expert reports.” *Id.* Further, in *Verizon Business Network*, “expert discovery [wa]s also expected to close soon” after the Board’s institution decision, and in this case it will already be closed. *See id.* at 14; Ex.2003, 4.

Unlike the petitioner in *Verizon Business Network*, however, Petitioner in this proceeding did not diligently prepare and file its Petition after Patent Owner

identified the asserted claims in the co-pending litigation. On May 19, 2023, Patent Owner served its Preliminary Infringement Contentions, in which it identified claims 1, 2, 5, 7, 8, and 9 of the '251 patent as the claims asserted. Ex.2007, 14 (Preliminary Infringement Contentions to Comcast). Petitioner served Preliminary Invalidity Contentions listing Danciu among the prior art with its disclosures of August 4, 2023. Exs.2009, 2010 (Preliminary Invalidity Contentions). Petitioner continues to pursue the Danciu prior art as of April 4, 2024. Ex.2011, 3. Petitioner waited to file its Petition challenging the same claims asserted based on prior art from its contentions until December 27, 2023—almost ten months after learning of the asserted claims and almost five months after serving its invalidity contentions. Thus, Petitioner is not entitled to any “credit” for its diligence, which the Board gave the petitioner in *Verizon Business Network*. See IPR2020-01292, Paper 13 at 14 (noting petition was filed two months after preliminary contentions revealed the claims asserted and two weeks after serving its preliminary invalidity contentions). Petitioner’s lack of diligence further increases this factor’s weight in favor of discretionary denial. See *Fintiv*, IPR2020-00019, Paper 11 at 11 (“If, however, the evidence shows that the petitioner did not file the petition expeditiously . . . or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.”).

For these reasons, factor 3 weighs heavily in favor of exercising discretion to deny the petition.

D. Factor 4: Overlap of Issues

This factor also favors discretionary denial because the same claims and prior art are at issue in the co-pending litigation. *See Fintiv*, IPR2020-00019, Paper 11 at 12 (explaining that “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” when the same claims, prior art, and arguments are at issue in both proceedings). As noted above, the same set of claims is challenged in the Petition and asserted in the district court. Pet., 2–3; Ex.2007 at 3. Prior art asserted in the Petition is also among the art listed in Petitioner’s invalidity contentions. *Id.*

Petitioner’s stipulation regarding duplicative invalidity defenses at issue in the parallel proceeding is too weak to be effective. Petitioner stipulates only that if review is instituted it will not pursue the “*specific* grounds against the instituted patent(s) as set forth in the respective instituted *inter partes* review proceeding.” Ex.2012 (emphasis added). This appears potentially narrower than the weak stipulation offered in *Sand Revolution II, LLC v. Cont’l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020). In *Sand Revolution*, the petitioner stipulated it would not pursue the “same grounds,” and the Board found that only mitigated concerns of duplicative efforts and potentially conflicting

decisions “to some degree.” *Id.* Here, Petitioner’s stipulation does not even prevent it from re-arguing the same prior art—Petitioner can simply argue the same grounds as long as they are not argued “as set forth in the respective instituted *inter partes* review proceeding.” That is, Petitioner could merely combine the very same art differently to contend it is not the same specific grounds as set forth in the IPR. Petitioner and its co-defendants continue to pursue Danciu, the primary reference of this Petition, in the parallel proceedings, and, indeed, Petitioner advances the exact same grounds based on its incorporation by reference noted above.

Moreover, Petitioner’s co-defendant in the parallel proceeding, Charter Communications,¹⁰ is pursuing almost identical invalidity defenses and has not agreed to be bound by any such stipulation. Petitioner and Charter’s cases remain consolidated for all pretrial purposes and issues of invalidity will likely be dealt with at the same time. Ex.2013. In effect, Petitioner gets an end-run around its already weak stipulation, as its co-defendant intends to attempt to pursue the same Danciu prior art in the district court whether or not review is instituted. This duplicative

¹⁰ Charter Communications, Inc., Charter Communications Operating, LLC, Time Warner Cable Enterprises LLC, Spectrum Management Holding Company, LLC, Spectrum Gulf Coast, LLC, and Charter Communications, LLC (together, “Charter”)

litigation defeats the purpose of IPRs as a faster, less costly alternative to district court litigation. *Compare Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13–14, 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (affording substantial weight to stipulation filed with similar scope to estoppel under 35 U.S.C. § 315(e)(2)) *with Verizon Bus. Network*, IPR2020-01292, Paper 13 at 15–16, 18–19 (giving weight to limited stipulation but exercising discretion to deny institution). *See also* Director’s Memorandum at 7–8.

Factor 4 weighs in favor of discretionary denial.

E. Factor 5: Same Parties

The parties in this IPR and the parties in the co-pending litigation are identical, so this factor weighs in favor of discretionary denial. *Sotera*, IPR2020-01019, Paper 12 at 19 (precedential); *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative). Petitioner does not dispute the weight of this factor, instead only arguing it “does not warrant denial.” Pet. 18. It may not warrant denial on its own, but it certainly weighs in favor of denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (precedential) (“[T]his factor supports denying institution.”); *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative) (“[T]his factor weighs in favor of discretionary denial.”).

Factor 5 weighs in favor of discretionary denial.

F. *Factor 6: Other Considerations*

This case presents no compelling factors that weigh against discretionary denial. The merits of this case are weak, for the reasons explained above, and warrant denying institution on their own. Because the evidence does not meet the “reasonable likelihood” threshold for institution, it also does not meet the even higher threshold for a “compelling, meritorious challenge.” See Director’s Memorandum at 4 (“Compelling, 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.”) (underline added).

Moreover, Petitioner misplaces its reliance on the assertions that the art it relies on is “entirely different” from the previously-considered art asserted in the Google petition. Pet., 18; *Google, LLC. v. Touchstream Technologies, Inc.*, IPR2022-00795 (PTAB Sep. 5, 2022). This does not weigh against discretionary denial under § 314(a); Petitioner offers no authority to suggest otherwise. See *id.* Moreover, Petitioner’s assertion is ironic because it asserts Google’s IPR art, Muthukumarasamy, in the district court, and Petitioner asserts Google’s district court art, in this Petition. *Google, LLC. v. Touchstream Technologies, Inc.*, IPR2022-00795 (PTAB Sep. 5, 2022); Ex.2011, 3.

At any rate, this factor is primarily interested in the strength of the evidence on the merits, though the Board has used it to consider issues of fairness and equity

not encompassed by other factors. *See Fintiv*, IPR2020-00019, Paper 11 at 14–15; *see also Dolby Labs., Inc. v. Intertrust Techs. Corp.*, IPR2020-01106, Paper 12 at 18 (PTAB Jan. 5, 2021) (considering whether a petitioner’s suit for declaratory judgment of non-infringement favors discretionary denial).

Because there are no compelling circumstances not addressed by the other factors, this factor is neutral.

G. Combined Factors

When combined, the several factors support the exercise of discretion to deny institution under § 314(a). Factors 1–5 all weigh in favor of exercising discretion to deny institution, some heavily, and the last factor is neutral. Viewing the factors holistically, discretionary denial is the outcome that best serves the “efficiency and integrity of the system.” Far from being the *alternative* to district court litigation that Congress envisioned, Petitioner has turned this proceeding into a bonus round. Patent Owner and the Board will pay the cost.

The facts bear this out. Petitioner offers no justification for its delay of many months in filing its Petition, even after preparing invalidity contentions in the co-pending litigation relying on the art asserted in this Petition many months before it was filed. Because of this delay, the co-pending litigation advanced so far that even expert discovery will be done by the institution deadline, and the parties will bear all the expense of invalidity expert reports and related depositions. Trial, including on

invalidity, will be three months away by then and (even allowing for some delay) is all but certain to happen before the Board issues a final written decision in this case. That trial will involve the claims challenged in this case, and Petitioner will not be subject to estoppel under § 315(e) and may likely try to assert the same art or even the same grounds raised in the Petition. Even if trial ends in a judgment for Patent Owner, Petitioner would still have the option to maintain this proceeding.

Hence, whether by design or unintentional delay, the timing of the Petition gives Petitioner two chances to litigate invalidity and obtain its preferred outcome. This does not serve the efficiency of the system, which already expends considerable public resources to litigate invalidity once. In addition, the possibility of inconsistent results compromises the patent system's integrity. This is the archetypal case that justifies discretionary denial under § 314(a), and the Board should deny institution at least on that basis.

VIII. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition.

Dated: April 24, 2024

Respectfully submitted,

By: /Kyle E. Friesen/

Kyle E. Friesen, Lead Counsel

Registration No. 65,371

Email: kfriesen@shb.com

Robert H. Reckers, Back-up Counsel

Registration No. 54,633
Email: rreckers@shb.com
SHOOK, HARDY & BACON L.L.P.
600 Travis Street, Suite 3400
Houston, TX 77002

Jason R. Mudd, Back-up Counsel
Registration No. 57,700
Email: jmudd@shb.com
Ryan Dykal, Back-up Counsel
Registration No. 63,793
Email: rdykal@shb.com
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE, according to the word-processing system used to prepare the paper and not including those parts excluded by § 42.24(a)(1), has 12,787 words, which is within the type-volume limit set by § 42.24.

By: /Kyle E. Friesen/
Kyle E. Friesen
Lead Counsel for Patent Owner
Registration No. 65,371
SHOOK, HARDY & BACON L.L.P.
600 Travis Street, Suite 3400
Houston, TX 77002
Phone: 713-546-5671
Email: kfriesen@shb.com

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 Preliminary Response and Exhibits 2001-2022 were provided via email to Petitioner's counsel of record as follows:

ComcastIPRService@bannerwitcoff.com
Frederic M. Meeker - fmeeker@bannerwitcoff.com
Paul T. Qualey - pqualey@bannerwitcoff.com
John R. Hutchins - jhutchins@bannerwitcoff.com
John M. Fleming - jfleming@bannerwitcoff.com
Joshua L. Davenport - jdavenport@bannerwitcoff.com

Banner & Witcoff, Ltd.

1100 13th Street, NW Suite 1200
Washington, DC 20005

By: /Kyle E. Friesen/
Kyle E. Friesen
Lead Counsel for Patent Owner
Registration No. 65,371