

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00322
Patent 8,356,251

**PETITIONER'S REPLY TO THE PATENT OWNER'S
PRELIMINARY RESPONSE**

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EXHIBITS

Previously Submitted:

- Ex. 1101: U.S. Patent No. 8,356,251 (“the ’251 Patent”)
- Ex. 1102: Expert Declaration of David B. Lett
- Ex. 1103: Curriculum Vitae of David B. Lett
- Ex. 1104: Certified Prosecution History of the ’251 Patent
- Ex. 1105-1110: Reserved
- Ex. 1111: U.S. Pub. No. 2004/0078812 (“Calvert”)
- Ex. 1112: U.S. Pat. No. 9,490,998 (“Danciu”)
- Ex. 1113: U.S. Prov. App. No. 61/411,386 (“Danciu Provisional”)
- Ex. 1114: U.S. Pub. No. 2009/0248802 (“Mahajan”)
- Ex. 1115: U.S. Pub. No. 2009/0172757 (“Aldrey”)
- Ex. 1116-1119: Reserved
- Ex. 1120: Joint Claim Construction Statement, *Touchstream Technologies, Inc. v. Google LLC*, 6:21-cv-00569-ADA (WDTX) (Feb. 8, 2022)
- Ex. 1121: Exhibit 1 to Joint Disputed Claim Terms Charts, *Touchstream Technologies, Inc. v. Vizbee, Inc.*, 1:17-cv-06247-PGG-KNF (SDNY) (Aug. 6, 2018)
- Ex. 1122: Jury Instructions, *Touchstream Technologies, Inc. v. Google LLC*, 6:21-cv-00569-ADA (WDTX) (July 21, 2023)
- Ex. 1123-29: Reserved
- Ex. 1130: U.S. Pub. No. 2002/0104096 (“Cramer”)
- Ex. 1131: U.S. Pat. No. 7,356,575 (“Shapiro”)
- Ex. 1132: U.S. Pat. No. 7,269,842 (“Estipona”)

- Ex. 1133: U.S. Pub. No. 2004/0267899 (“Rahman”)
- Ex. 1134: U.S. Pub. No. 2004/0098533 (“Henshaw”)
- Ex. 1135: U.S. Pub. No. 2004/0172656 (“Kim”)
- Ex. 1136: Reserved
- Ex. 1137: U.S. Pat. No. 7,343,419 (“Robinson”)
- Ex. 1138-40: Reserved
- Ex. 1141: CODING OF MOVING PICTURES AND AUDIO, *MPEG-4 Overview* (Int’l Org. Standardisation 2002)
- Ex. 1142: ROBERT GODWIN-JONES, DIGITAL VIDEO UPDATE: YOUTUBE, FLASH, HIGH-DEFINITION, 11 LANGUAGE LEARNING & TECH. 16, 17 (2007)
- Ex. 1143: John C. Paolillo et al., *A Network View of Social Media Platform History: Social Structure, Dynamics and Content on YouTube*, PROC. 52ND HAWAII INT’L CONF. ON SYS. SCIS., 1, (2019)
- Ex. 1144: *YouTube Opens Internet Video to Masses; Serving 3 Million Videos Daily and Growing, YouTube Unveils a Fast, Fun, and Easy Service for Consumers to Broadcast Original Video*, MARKET WIRE, Dec. 15, 2005
- Ex. 1145: *Hulu Debuts via Private Beta and on Distribution Partners AOL, Comcast, MSN, MySpace and Yahoo!; Company Announces Major Licensing Deals with Metro-Goldwyn-Mayer Studios Inc. and Sony Pictures Television; Providence Equity Partners Makes Strategic Investment in News Corporation/NBC Universal Online Video Joint Venture*, BUS. WIRE, Oct. 29, 2007
- Ex. 1146: *Blockbuster Offers Cheaper Online Rental*, ASSOCIATED PRESS, Jun. 13, 2007
- Ex. 1147: *Adobe Delivers Flash Player 9 With H.264 Video Support; HD Quality Web Video and Audio Now Available With Adobe Flash Player Update*, BUS. WIRE, Dec. 4, 2007

- Ex. 1148: *Microsoft Unveils Silverlight to Power the Next Generation of Media Experiences on the Web; Leading Media Companies and Solution Providers Announce Support for New Solution for Video and Interactivity on Mac- and Windows-Based Web Browsers*, PR NEWswire US, Apr. 16, 2007
- Ex. 1149: *Former Apple Multimedia Pioneers Unveil WebTV; New Company Brings Internet to Television Viewers*, PR NEWswire, Jun. 12, 1996
- Ex. 1150: *Netflix, TiVo Team Up After 4-Year Courtship*, ASSOCIATED PRESS, Oct. 30, 2008
- Ex. 1151: *TiVo and Amazon.com Announce New Service Enabling Amazon Unbox Video Download to TiVo; TiVo Subscribers Will Soon Be Able to Watch Amazon Unbox Movies and TV Shows on Their TVs*, BUS. WIRE, Feb. 7, 2007
- Ex. 1152: *Wall Crumbling Between Televisions and Computers*, AGENCE FRANCE PRESSE – ENGLISH, Jan. 8, 2009
- Ex. 1153: *ENHANCED TV BINARY INTERCHANGE FORMAT 1.0, ETV (OpenCable Specifications*, Nov. 25, 2009)
- Ex. 1154: *Award-Winning Sonos™ Digital Music System Begins Shipping to Customers*, PR NEWswire US, Jan. 27, 2005
- Ex. 1155: *Sonos Introduces the Sonos™ ZonePlayer ZP80*, PR NEWswire, Jan. 4, 2006
- Ex. 1156: *Sonos Introduces the Sonos Controller for iPhone; Free Application Lets Music Lovers Control Leading Multi- Room Music System from Their iPhone*, PR NEWswire, Oct. 28, 2008
- Ex. 1157: *AT&T Opens R&D Lab in Cambridge, England*, BUS. WIRE, Feb. 10, 1999
- Ex. 1158: *Microsoft Releases Windows NT 4.0 Terminal Server Edition*, M2 PRESSWIRE, Jun 16, 1998
- Ex. 1159: *TeamViewer: TeamViewer 3.0 Beta Published; Next Generation of the Popular Remote Support Software*, M2 PRESSWIRE, Aug. 27, 2007

- Ex. 1160: *3am Labs Announces \$10 Million Series A Financing; McNamee Lawrence & Co. Acts as Exclusive Financial Advisor to 3am Labs*, BUS. WIRE, Nov. 16, 2004
- Ex. 1161: *Expertcity's GoToMyPC Product Wins A People's Choice Award At Upside Events' Showcase 2001*, INTERNET WIRE, Feb. 1, 2001
- Ex. 1162: *TV2Me(R) Goes Global By Partnering With Leading Asian Online Entertainment Company; Manila-Based ESL Adds Sales and Marketing Muscle to Bring Pioneering Place Shifting Technology to Wider Market*, PR NEWSWIRE US, May 16, 2006
- Ex. 1163: *CES Innovations 2005 Award and Red Herring Finalist for 100 Most Innovative Companies are Latest Commendations for Sling Media*, BUS. WIRE, Nov. 11, 2004
- Ex. 1164: Final Written Decision, IPR2022-00795 (Sep. 27, 2023)
- Ex. 1165: Patent Owner Response, IPR2022-00795 (Jan. 13, 2023)
- Ex. 1166: Reserved
- Ex. 1167: *Progressive Networks Launches the First Commercial Audio-On-Demand System Over the Internet*, BUS. WIRE, Apr. 10, 1995
- Ex. 1168: *Progressive Networks' RealVideo Launched With Wide Industry Support*, PR NEWSWIRE EUROPE, February 10, 1997
- Ex. 1169: Reserved
- Ex. 1170: U.S. Pat. Application No. 61/477,998
- Ex. 1171: U.S. Pat. No. 8,904,289 to Strober (“the ’289 Patent”)
- Ex. 1172: Certified Copy of Prosecution History of U.S. Pat No. 8,904,289
- Ex. 1173: U.S. Pat. No. 9,767,195 (“the ’195 Patent”)
- Ex. 1174: Certified Copy of Prosecution History of U.S. Pat. No. 9,767,195

- Ex. 1175: U.S. Pat. No. 11,048,751 to Strober (“the ’751 Patent”)
- Ex. 1176: Certified Copy of Prosecution History of U.S. Pat. No. 11,048,751
- Ex. 1177: U.S. Pat. No. 8,356,251 to Strober (“the ’251 Patent”)
- Ex. 1178: Certified Copy of Prosecution History of U.S. Pat. No. 8,356,251
- Ex. 1179: Reserved
- Ex. 1180: Lett analysis of Danciu Claim 1 in view of Danciu Provisional
- Ex. 1181: Annotated Copy of Danciu Provisional in view of Danciu
- Ex. 1182: Stipulation Regarding Invalidity Defenses

Filed Herewith:

- Ex. 1183: Transcript of Jury Trial, Volume 3 of 5, held July 19, 2023, Dkt No. 262; *Touchstream v. Google*, 6-21-cv-569 (W.D. Tex.)
- Ex. 1184: Google’s Rule 50(b) Renewed Motion for Judgment as a Matter of Law, dated September 20, 2023, Dkt No. 275; *Touchstream v. Google*, 6-21-cv-569 (W.D. Tex.)
- Ex. 1185: Touchstream’s Opposition to Google’s Rule 50(b) Renewed Motion for Judgment as a Matter of Law (Public Version), Dkt No. 287; *Touchstream v. Google*, 6-21-cv-569 (W.D. Tex.)
- Ex. 1186: Google’s Reply in Support of Rule 50(b) Renewed Motion for Judgment as a Matter of Law (Public Version), Dkt No. 292; *Touchstream v. Google*, 6-21-cv-569 (W.D. Tex.)

The Board authorized this Petitioner’s Reply to address Patent Owner’s (“PO”) arguments concerning discretionary denial of institution in these proceedings. Ex. 3001. PO argues for discretionary denial, suggesting that the *Fintiv* factors (see *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11, 5-16 (PTAB Mar. 20, 2020)) and *Becton, Dickinson* factors (see *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)) weigh in favor of denial. IPR2024-00322, POPR, 44-64. At least for the following reasons, and specifically in response to PO’s arguments, discretionary denial is not warranted.

I. 35 U.S.C. §314

A. FACTOR 1: STAY

PO asserts that “[t]he parallel proceeding is unlikely to be stayed pending IPR, as that Court rarely grants such stays.” *Id.* at 53 (citing Ex. 2002 including statistics relating to Motions to Stay Pending PTAB). PO’s assertion appears to be based on statistics that at least fail to account for the *timing* of such motions before that Court. See Ex. 2002 (where for 33 of the 58 denials for motions to “Stay Pending PTAB”, prematurity as being filed prior to IPR institution was dispositive). See, e.g., Ex. 2002, 59, 67; *Polaris PowerLED Techs., LLC v. Samsung Elecs. America, Inc.*, 2:22-cv-00469-JRG, Dkt. 54 (E.D. Tex. Aug. 17, 2023); *Oyster Optics, LLC v. Coriant America Inc.*, 2:16-cv-01302-JRG, Dkt. 199 (E.D. Tex. Dec. 21, 2017). Indeed, it is “the universal practice” of that Court to deny motions for a stay when the PTAB has

not yet acted on a petition for IPR. *Trover Grp, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E. D. Tex. Mar. 11, 2015). Petitioner also should not be faulted for not filing a futile pre-institution motion and reasserts its intention to request a stay if the present IPR is instituted.

B. FACTOR 4: OVERLAP OF ISSUES

Factor 4 strongly favors institution. PO argues for discretionary denial based on its misleading statement that “the same set of claims is challenged in the Petition and asserted in the district court.” IPR2024-00322, POPR, 59. Yet, only a subset of the challenged claims are at issue in the pending litigation. The Petition challenges **all** claims of the ’251 Patent, rather than solely claims 1, 2, 5, 7, 8, and 9. IPR2024-00322, Petition, 16-17; *see* Ex. 2007, 14–16.

Further, Petitioner must continue to pursue Danciu in the parallel proceeding because if Petitioner removed Danciu from its district court invalidity contentions and IPR were not instituted, Petitioner would have lost the ability to assert Danciu in either forum. *See* IPR2024-00322, POPR, 60.

PO argues for discretionary denial because Petitioner’s “co-defendant” in the parallel proceeding, Charter Communications (“Charter”), is pursuing invalidity defenses relying on Danciu, and has not agreed to be bound by a stipulation. IPR2024-00322, POPR, 60-61. But Charter is not a co-defendant of Petitioner, as they were sued in separate cases based on their different products and only *sua*

sponte consolidated for pretrial by order of the Court. Charter is not an RPI or privy for purposes of the Petition (nor has PO alleged as such). Petitioner did not file the Petition at the behest of or on behalf of Charter, and cannot be held responsible for the acts of Charter.

Finally, PO argues that “Petitioner and Charter’s cases remain consolidated for all pretrial purposes and issues of invalidity will likely be dealt with at the same time.” IPR2024-00322, POPR, 60. But consolidation is for **pretrial** purposes, whereas invalidity based on prior art is typically a question of fact *for trial*. Ex. 2013.

II. 35 U.S.C. §325

A. Danciu

35 U.S.C. §325(d) applies when “[1] the same or substantially the same prior art or arguments [2] previously were presented to the Office.” Neither condition is met with regard to Danciu.

First, Danciu was not considered in the ’251 Patent’s prosecution history, nor in the prosecution history of any of the related patents, nor in any other proceeding *before the Office*. The fact that Danciu was before a lay jury in a district court proceeding cannot substitute for it being before the special expertise of the Office.

Second, PO’s focus on what was presented *to a jury* obscures what is material: the *Office* was only presented with two *Internet articles* totaling four pages. Ex. 1104, 38-41, 258-259; *see* Ex. 1172, 50-51. PO must, but did not, establish why *the*

cited articles are “substantially the same”¹ as the detailed disclosure in Danciu. Even if as PO alleges “Danciu spawned from, and describes, Google’s YouTube Remote and YouTube Leanback products considered by the examiner during prosecution” (IPR2024-00322, POPR, 14, 2, 15, 48), this does not substitute for a comparison of the information actually before the Office (*i.e.*, the cited articles) to the disclosure of Danciu. Thus, Danciu is not properly within the scope of §325(d).

B. MAHAJAN

As a threshold matter, Board precedent states that “the art and arguments must have been previously presented to the Office *during proceedings pertaining to the challenged patent.*” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 7 (Feb. 13, 2020) (precedential, emphasis added). Mahajan was not considered in the prosecution history of the ’251 Patent. Rather, PO points to the prosecution history of the ’751 Patent, which was filed four years *after* the ’251 Patent issued. IPR2024-00322, POPR, 2, 44-51.² Thus, Mahajan was not “presented to the Office during proceedings pertaining to the challenged patent,” and this fact alone disqualifies Mahajan for consideration under 35 U.S.C. §325(d)

¹ PO repeatedly misstates the language of the statute as merely requiring the presented art to be “substantially similar.” IPR2024-00322, POPR, 48.

² In *Becton, Dickinson*, the cited art stemmed from a *prior*-filed priority application.

as to the '251 Patent.

Furthermore, Petitioner's arguments regarding Mahajan are not the same arguments previously presented to the Office. PO alleges that Mahajan had been presented by pointing to PO's arguments that Mahajan (a secondary reference for '751 Patent claims 2-3) did not cure deficiencies alleged to exist in U.S. Pub. No. 2012/0130971 to Morris (the primary reference for all claims). IPR2024-00322, POPR, 46-47 (citing Ex. 1176, 173). However, PO fails to acknowledge that the Office *rejected* its arguments, stating that "[t]he Examiner disagrees since Mahajan was not relied upon to disclose 'receiving, from the remote server device, ...'" Ex. 1176, 187-188. Rather, the Office *maintained* that "Mahajan teaches translating a platform specific media playback command into a generic or universal media playback command for transmission to a client." Ex. 1176, 185. Allowance only followed substantial amendments made to claim 1, which was rejected in view of Morris alone. Ex. 1176, 178-179, 226, 234-235, 833-842. Mahajan itself was never overcome during prosecution and certainly not for how it is utilized in the present Petition (providing "implementation details for transmission of commands for controlling a client." IPR2024-00322, Petition, 28). And the combination of Danciu and Mahajan was never before the Office.

III. CONCLUSION

Discretionary denial is not appropriate and trial should be instituted.

Dated: May 24, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this **PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** to be served via e-mail on May 24, 2024, in its entirety on the following counsel of record for Patent Owner:

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