IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

TOUCHSTREAM TECHNOLOGIES, INC.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	Civil Case No. 6:21-cv-569-ADA
	§	
GOOGLE LLC,	§	JURY TRIAL DEMANDED
	§	
Defendant.	§	
	§	

GOOGLE LLC'S RULE 50(b) RENEWED MOTION FOR JUDGMENT AS A MATTER OF LAW

Comcast, Ex. 1184
Comcast v. Touchstream
IPR2024-00322

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TABLE OF ABBREVIATIONS

Abbreviation	Definition
Touchstream	Touchstream Technologies, Inc.
Google	Google LLC
’251 patent	U.S. Patent No. 8,356,251 (PTX-865)
’528 patent	U.S. Patent No. 8,782,528 (PTX-885)
’289 patent	U.S. Patent No. 8,904,289 (PTX-883)
API	application programming interface
asserted patents	the ’251 patent, the ’528 patent, and the ’289 patent
asserted claims	claims 1 and 8 of the ’251 patent, claims 1 and 14 of the ’528 patent, and claims 1 and 2 of the ’289 patent
DCS	device configuration server
GTS	YouTube Remote and Leanback with Google TV System (JTX-1; JTX-3; JTX-21; JTX-51; JTX-63; DTX-118A; DTX-120; DTX-632; Tr. 892:19-904:3 (Levai))
Muthukumarasamy	U.S. Patent Application Publication No. 2010/0241699 (JTX-22)
POSA	person of ordinary skill in the art
SDK	software development kit
Tr.	Trial Transcript, located at: Dkt. 259 (Day 1, pp. 1-244); Dkt. 260 (Day 2, pp. 245-647); Dkt. 262 (Day 3, pp. 648-1028); Dkt. 264 (Day 4, pp. 1029-1310); and Dkt. 266 (Day 5, pp. 1311-1376). Certain portions of the Trial Transcript are and remain under seal.

All emphasis added unless otherwise noted.

TABLE OF EXHIBITS

Trial Exhibit	Description
JTX-1	*Control YouTube on the Desktop, or the TV ... with the YouTube Remote App for Your Phone*, YouTube Official Blog (Nov. 9, 2010)
JTX-3	*How to Control Google TV or YouTube Leanback with YouTube Remote*, YouTube (Nov. 14, 2010)
JTX-21	U.S. Patent No. 9,490,998
JTX-22	Muthukumarasamy prior-art reference
JTX-51	*Features*, Google TV (Oct. 5, 2010)
JTX-63	YouTube Remote API Server Documentation
JTX-218	Purported source code for Mr. Strober's prototype
JTX-226	Purported source code for Mr. Strober's prototype
JTX-228	Purported source code for Mr. Strober's prototype
JTX-254	Purported source code for Mr. Strober's prototype
JTX-255	Purported source code for Mr. Strober's prototype
PTX-863	'289 patent
PTX-865	'251 patent
PTX-885	'528 patent
DTX-118A	*How to Control Google TV or YouTube Leanback with YouTube Remote*, YouTube (Nov. 14, 2010) (video file)
DTX-120	Declaration of Janos Levai
DTX-632	GTS Source Code Printouts
DTX-637	Mr. Strober's purported draft summary of the claimed invention for the asserted patents

Motion Exhibit	Description
Exhibit A	The asserted claims of the asserted patents
Exhibit B	Excerpt of the prosecution history of the '251 patent
Exhibit C	Excerpt of Dr. Almeroth's infringement demonstratives

I. INTRODUCTION

Google renews its motion for judgment as a matter of law ("JMOL") under Federal Rule of Civil Procedure 50(b) on all liability issues. As shown in Google's Rule 59 motion for a new trial, instead of proving infringement, Touchstream biased the jury in its favor by focusing on its unmeritorious willfulness case, without carrying its burden on alleged infringement. Indeed, Touchstream's infringement case suffered from a fundamental flaw: Touchstream pursued a theory that requires multiple distinct components to constitute the "server system," and similarly required actions and components of third parties to meet the claims. Yet the claims do not contemplate Touchstream's mishmash "server system" theory, and Touchstream did not even attempt to show Google directed or controlled the third parties. No reasonable jury could find infringement. Nor could a reasonable jury reject Google's obviousness defenses. Touchstream's attempt to predate Google's primary art, GTS, lacked evidentiary support. And on the merits, a (moving) picture is worth a thousand words: Google clearly and convincingly showed obviousness—including via video evidence of GTS in use years ago.

Judgment of non-infringement and invalidity should be granted.

II. LEGAL STANDARD

Courts grant JMOL where "a reasonable jury would not have a legally sufficient evidentiary basis to find" for the non-movant, *Francis v. Turrack*, 2014 WL 3687311, at *3 (W.D. Tex. June 17, 2014), i.e., the record "point[s] so strongly in favor of the movant that a rational jury could not reach a contrary verdict," *Thomas v. Hughes*, 27 F.4th 995, 1008 (5th Cir. 2022).

III. NO REASONABLE JURY COULD FIND INFRINGEMENT

Touchstream's infringement case rested on a fundamental error that applies to all asserted claims: Touchstream conflated the distinct components and actors set forth in the claims. Notably, Touchstream narrowed its case to literal infringement; it dropped its doctrine-of-equivalents theory

at trial. Tr. 701:21-24. But for at least two independent though related reasons, Touchstream, as a matter of law, failed to show infringement.

First, Touchstream attempted to show infringement of the claimed "server system" limitation by pointing to functionality on the same accused device that, Touchstream argued, also constituted the claimed "content presentation device."[1] Touchstream pursued this theory with abandon because it was freed from the guardrails of an express construction of "server system." Under a proper construction, the "server system" cannot be the same as or overlap with the "content presentation device." And, under that construction, there can be no dispute that the accused products do not infringe because the accused "server system" overlaps with the accused "content presentation device."

Second, Touchstream failed to show that Google is responsible for the components and actions of third parties, including components that Touchstream included as part of the accused "server system." Touchstream had to show that Google directed or controlled those third parties. But Touchstream failed to present *any* evidence on this issue.

Finally, even setting aside both of those fatal flaws, Touchstream failed to carry its burden for a third reason: it failed to show infringement of other specific limitations.

A. Touchstream Failed To Prove The Accused Products Have The Claimed "Server System"

1. Properly Construed, The Accused Products Do Not Have The Claimed "Server System"

All the asserted claims require a "server system." The Court declined to construe that term, instead determining "to go with plain and ordinary meaning." Dkt. 225 at 50:17-19. But as the

[1] The '251 patent claims a "display device," and the '528 and '289 patents claim an analogous "content presentation device." This brief uses the terms synonymously, and primarily uses "content presentation device." For completeness, Exhibit A sets forth each asserted claim in full.

trial record shows, without a construed limit on the meaning of "server system," Touchstream engaged in an untenable trial presentation, pursuing its theory that the plain meaning permits the "server system" to overlap with the "content presentation device"—even though those are separately claimed components. Accordingly, this is a case in which post-trial claim construction is required. *See O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008) ("A determination that a claim term 'needs no construction' or has the 'plain and ordinary meaning' may be inadequate … when reliance on a term's 'ordinary' meaning does not resolve the parties' dispute."); *Olaf Sööt Design, LLC v. Daktronics, Inc.*, 839 F. App'x 505, 509 (Fed. Cir. 2021) (granting JMOL of non-infringement based on a new claim construction because the lack of a claim construction at trial "resulted in a claim construction dispute being 'improperly submitted to the jury'"). When properly construed in the context of the asserted patents, the claimed "server system" must be "distinct from and does not include the 'display device' or 'content presentation device.'" Dkt. 130 at 16.

As Google explained in its summary judgment papers, all of the intrinsic evidence compels this construction. Dkt. 130 at 12-20; Dkt. 184 at 1-10. For instance, the claims themselves recite that the server system "identif[ies]" programming code that "is for controlling presentation of the content by the content presentation device[.]" '289 Patent, claim 1. This plain reference to the content presentation device in relation to, and separate from, the server system makes clear the server system and content presentation device are distinct. Where, as here, a claim lists components separately, "[t]here is, therefore, a presumption that those components are distinct." *Kyocera Senco Indus. Tools Inc. v. ITC*, 22 F.4th 1369, 1382 (Fed. Cir. 2022); *accord Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254-55 (Fed. Cir. 2010) (citing additional authorities).

The specification, which is shared by all three asserted patents, not only fails to overcome the presumption, but instead reinforces that these components are separate. As the "Summary" states, the patents are directed to "a server system…, a display device…, and a personal computing device…"—components that are separately listed. *E.g.*, '289 Patent, 1:45-48. Likewise, "[t]he server system stores an association between the personal computing device and the display device" and, "in response to receiving the first message from the personal computing device," "provide[s]" a second message "to the display device"—again reinforcing that these components are distinct. *E.g.*, '289 Patent, 1:49-60; *id.* at 2:6-8 ("The server system is operable to provide to the display device…."); *see also* Dkt. 130 at 9-11, 17-20. Consistent with these disclosures, Figure 1 depicts the server system as distinct from the "television set 22" and describes that display device as "operable to link back to a server system 24," and Figure 2 depicts the functionality performed by the three separately claimed components—the "Smart Phone," "Display Device," and "Back-end Servers" (i.e., "server system 24"). *E.g.*, '289 Patent, Figs. 1 & 2, 2:66-4:37 (describing Figures 1 and 2). The specification *nowhere* contemplates that the "server system" and "display device" can be the same component or overlap in any way. Dkt. 130 at 17-20; Dkt. 184 at 5-7.

Further, permitting these components to overlap would divorce the claims from their disclosed purpose. As Google's expert Dr. Ketan Mayer-Patel explained, the written description identifies "two primary roles" for the "server system." Tr. 930:24-931:1. The first "is to act as … an agent to connect between the phone and the content display device via a synchronization code." Tr. 931:2-4. This is because "the patent is addressing" the scenario in which "the phone and the content presentation device either can't talk directly to each other or don't want to talk directly to each other," so the server system is "the thing that is managing that connection and making that connection possible." Tr. 931:10-18. The second role "is to step into th[e] communication gap

where the phone does not know how to issue commands that the media player on the content presentation device understands." Tr. 932:11-933:11. If the "server system" could overlap with the "content presentation device," the "server system" would not need to perform these roles.

The prosecution history confirms the server system's separateness. In responding to an office action, Touchstream made clear that, as used in the claims, "the server system acts [as] an interface for facilitating the transfer of information contained in the one or more signals (received from the personal computing device) to the display device." Ex. B at TS-00003404; *see also* Dkt. 130-3 at 62-63. If the "server system" could overlap with the "display device," there would be no need for the "server system" to act as an "interface."

In opposing Google's construction, Touchstream leaned on the claims' recitation that the "personal computing device" is "separate from" both the "server system" and the "content presentation device," without reciting the relationship between the "server system" and "content presentation device" in the same way. Dkt. 158 at 7-9. But "separate from" is not the only way to claim distinct components, as *Kyocera* and abundant other precedent make clear. *See Kyocera*, 22 F.4th at 1382 (construing elements as separate even though the claims and specification did not expressly describe them as separate); *Becton Dickinson*, 616 F.3d at 1254-55. And Touchstream ignores the claims' syntax, which, in first introducing the "server system," recites the "server system" as a distinct and separate component—separate from both the "personal computing device" and the "content presentation device."[2]

The trial record reinforces that Touchstream's proffered meaning of "server system" does not comport with the intrinsic evidence of the asserted patents. For his view of how an ordinary

[2] Touchstream's understanding of "server system" also renders the claims indefinite—an additional issue that Google preserves for appeal, if needed. *See* Dkt. 130 at 20-23.

artisan would understand "server system," Touchstream's expert Dr. Kevin Almeroth pointed to extrinsic evidence: "a technical dictionary from the Microsoft Press" and its "two different similar definitions" of "server," with one defining "server" as a computer "[o]n the Internet or other network" "that responds to commands from a client," and the other defining "server" as "a computer running administrative software that controls access to the network and its resources … and provides resources to computers functioning as workstations on the network." Tr. 431:16-432:13; Ex. C at 55 (Almeroth demonstratives). By citing only extrinsic evidence—and only for the naked word "server" taken out of context from the claims and other intrinsic evidence—Dr. Almeroth's view violates basic tenets of claim construction: "[W]hile extrinsic evidence can shed useful light on the relevant art, [the Federal Circuit has] explained that it is less significant than the intrinsic record in determining the legally operative meaning of claim language." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc) (internal quotation marks omitted). Moreover, Dr. Almeroth's testimony "suffer[s] from bias that is not present in intrinsic evidence" because it was "generated at the time of and for the purpose of litigation." *Id.* at 1318.

Furthermore, under the proper construction, Touchstream cannot prove infringement. In the accused products, it is undisputed that the accused "media player" is a software application that runs on the accused "content presentation device." Tr. 425:9-426:1, 476:6-478:6 (Almeroth); Tr. 955:7-956:20 (Mayer-Patel). Yet, for its alleged infringement read, Touchstream cobbled together the accused "server system" from parts of the accused "media player"—such as the "receiver SDK"—and parts of the accused "content presentation device." *E.g.*, Tr. 430:5-433:4, 439:4-440:7, 464:1-5. This theory is nonsensical under a proper construction of "server system" because the functionality of the accused "server system" cannot come from the accused "content

presentation device" if the two are distinct. No reasonable jury could accept that the accused products have the "server system" as claimed. The Court should grant JMOL of non-infringement.

2. Touchstream Failed To Show Infringement Of "Server System" Even Under Its Construction

Even applying its flawed view that the claimed "server system" "responds to commands from a client" or "run[s] administrative software that controls access to the network and its resources," Touchstream failed to prove the accused products infringe. There was no evidence that the accused "server system" interacts with "a client" or runs software "that controls access to" a network. In fact, although Dr. Almeroth invoked those definitions, he never explained how the numerous components he alleged made up the accused "server system" meet them. Instead, unrebutted evidence showed that the accused products utilize a peer-to-peer approach, which definitionally is the opposite of Touchstream's construction because there is no "server-client relationship" and no software "control[ling] access"; rather, "the different component[s] on the network are equal and they are talking to each other directly." Tr. 725:2-7 (Bakar). Indeed, the evidence established that Google "deliberately design[ed]" Chromecast for the second screen, typically a phone, "to talk directly to the display device over the local network" via "peer-to-peer communication." Tr. 723:15-726:7 (Bakar); *see also* Tr. 842:1-847:8 (Van Der Staay) (the peer-to-peer approach was intentionally selected); 928:18-930:2 (Mayer-Patel) (Google's products use a peer-to-peer relationship because "communication happens directly with no intermediary service system … performing the steps as claimed in the patents"); 940:5-942:18 (Mayer-Patel) (there is no external server between the cast device and phone because of Google's peer-to-peer architecture). JMOL is appropriate when there is a lack of evidence showing infringement and "unrebutted evidence showing the opposite." *CommScope Techs. LLC v. Dali Wireless Inc.*, 10 F.4th 1289, 1297-98 (Fed. Cir. 2021).

Touchstream instead engaged in handwaving, pointing to components that are labeled "server" and interact with the casting device in some respect—e.g., the "mDNS server," "MDx server," "Orbit server," or "DIAL server"—in an attempt to overcome the accused devices' non-infringing peer-to-peer architecture. Tr. 430:5-24 (Almeroth) (referencing the accused products' servers, some of which are "on Google servers in the cloud" and others which are "on the device"); 432:14-20 (Almeroth) (same). The unrebutted evidence established that these "servers" were red herrings and did not have anything to do with the functionality of the claimed "server system." Tr. 866:1-18 (Van Der Staay) (mDNS server is "used by tons of different companies," performs the "prerequisite step" of "find[ing] a cast device," and has no "role in the communications between the phone and the Chromecast during the casting process"); Tr. 870:12-23 (Van Der Staay) (DIAL/MDx relates to "second screen experiences on noncast-enabled devices" for YouTube and "is actually not related to Google Cast at all"); JTX-116 ("MDx" now called "Orbit"). Touchstream's efforts to obfuscate cannot sustain the verdict.

B. Touchstream Failed To Prove Divided Infringement

Touchstream also relied on a mash-up of distinct components to sidestep its burden on divided infringement—an independent failure of its infringement case. "Where more than one actor is involved in practicing" a claimed method, the patent owner must prove that "the acts of one are attributable to the other such that a single entity is responsible for the infringement." *Akamai Techs., Inc. v. LimeLight Networks, Inc.*, 797 F.3d 1020, 1022 (Fed. Cir. 2015) (en banc). As relevant here, an entity can be held responsible for others' performance of method steps where "that entity directs or controls others' performance."[3] *Id.* No reasonable jury could have found

[3] Only a direction or control theory, and not *Akamai*'s alternate divided-infringement theory of a "joint enterprise," is at issue in this case; the jury was instructed only on direction or control (Tr. 1286:1-1287:7), and Touchstream did not object to that instruction or its scope.

that Touchstream made this showing. In fact, the only mention of "direct" or "control" in the relevant context was when the Court instructed the jury on divided infringement. Tr. 1286:1-1287:7. Touchstream *never* argued or even referred to these concepts. Where the patentee fails to even present evidence of direction or control, there can be no infringement. *See ESW Holdings, Inc. v. Roku, Inc.*, No. 6-19-cv-00044-ADA, 2021 WL 1069047, at *2-5 (W.D. Tex. Mar. 18, 2021) (granting summary judgment of non-infringement given lack of showing of direction and control).

Touchstream cannot dispute its lack of proof of divided infringement. Nor can it claim that its infringement theory did not invoke the law on divided infringement. As the claims and specification make clear, and as Touchstream itself pursued at trial, the alleged infringement requires actions and components provided by third parties. Because Touchstream failed to present any evidence that Google directed or controlled those parties, JMOL of non-infringement is warranted for this additional, independent reason.

1. The Accused "Media Player" Is Provided By Third Parties

Each of the claimed methods requires a "media player." For example, the claimed "server system" must "identify[]" "programming code … for controlling presentation of the content by the content presentation device," and "the content presentation device" must "use[] [a] particular media player to execute the programming code." '289 Patent, claim 1; '528 Patent (same); '251 Patent (same but requiring "converting" rather than "identifying"). The specification expressly contemplates that parties other than those providing the "server system" will provide the "media player," e.g., media players from "YouTube," "Ted.com," and "Vimeo." '289 Patent, 6:7-18, Fig. 5. The specification also explains that "companies that provide on-line video platforms that host videos for other individuals or companies can obtain useful advantages by integrating the platforms with the server system," and that "[p]rogramming hooks can be created in the API so that the on-line video platform's media player can communicate with the server system." *Id.* at 9:11-33.

The only record evidence regarding the accused "media players" was that they are provided by third parties. This is true even under Touchstream's theory that the claimed "server system" included Google's "receiver SDK," which is a "software development kit" that third parties can customize for their media players. Dr. Almeroth highlighted the receiver SDK as a key to his infringement opinion, explaining that it "acts as the bridge or the glue to the cast browser," Tr. 430:15-18, "enables the communication between the cast service and the phone," Tr. 454:2-10, and performs the '289 and '589 patents' "identifying" step concerning the "action control command" and the '251 patent's equivalent "converting" step for the "universal playback control command," Tr. 453:6-23, 455:15-456:20. But Dr. Almeroth ignored the undisputed evidence that this "glue" is customized by *third parties* in creating their media players.

Although Google hosts the receiver SDK on its website for downloading, it is undisputed that third-party content providers building their apps and media players to interface with Chromecast-enabled devices "could use all of [the receiver SDK], they could use some of it, [or] they could use none of it if they wanted to." Tr. 849:23-25, 848:20-850:20 (Van Der Staay); Tr. 955:7-956:20 (Mayer-Patel). Third parties "can do whatever they want," "they [can] decide to do all their own experience, build their own things," and "[i]f they want to go down to the low level and handle everything themselves, they can." Tr. 850:11-20 (Van Der Staay). Google engineer Mr. Van Der Staay further emphasized that "some of [Chromecast's] biggest apps," such as "Netflix" "don't use all of the receiver SDK"; "Facebook" may use "a tiny bit" or not "any of the receiver SDK" at all. Tr. 850:1-10. Even when Touchstream pressed Mr. Van Der Stay regarding the receiver SDK, he reiterated that "how much is used *or if it's used is optional*." Tr. 887:13-17.

In fact, Touchstream's expert Dr. Almeroth confirmed this. He agreed there are "third parties involved in this cast ecosystem," such as "Netflix and Spotify," and that those parties

"provide … the media player." Tr. 501:22-502:8. He also agreed that when an accused product asks Netflix to send what is needed "to display that video," what "Netflix sends" is "built" and "designed by Netflix." Tr. 502:7-21. While he noted that Google informs third-party content providers about what is needed "to use" the accused products, Tr. 503:1-3, he underscored that "Netflix provides what it builds," Tr. 504:8-11. Meanwhile, Touchstream presented no evidence that Google directs or controls the third-party content providers.

Finally, Dr. Almeroth's testimony that the accused products have "an application programming interface," that "[t]here are rules that have to be in place for that app to be able to work in a cast-enabled device," and that "the browser in [the accused] devices has to be able to request from Netflix, for example, the app to download it and display it in the Chrome browser on the device," Tr. 548:2-11, was insufficient. He pointed to no evidence that such interactivity establishes direction or control.

For this independent reason, JMOL of non-infringement is required.

2. The Accused "Messages" And "Signals" Are Provided By Third Parties

Each asserted claim requires receiving "messages" or "signals" sent from a user's personal computing device (e.g., phone) to the "server system," and those messages and signals must contain and provide specific data and information. The following italicized steps of claim 1 of the '289 patent are representative of the user-performed steps:

> receiving, in a server system, one or more *messages from a personal computing device* that is separate from the server system and separate from the content presentation device, wherein the one or more message, taken together, (i) *include information associated with a unique identification code assigned to the content presentation device*, (ii) *specify a file to be acted upon*, (iii) *identify a particular media player for playing content from the specified file* wherein the media player is a computer application operable to present content and control presentation of the content, (iv) *identify a location of the particular media player*, and (v) *include an action control command for presentation of the content on the content presentation device by the particular media player*, ….

The specification likewise makes clear that users are involved. For example, it emphasizes that the messages identify "*user-selected* content and a media player to play the content," and that the invention "allow[s] the *user to control* how the content is displayed on the display device *using the personal computing device*," by "*user-initiated* play commands." '289 Patent, 1:51-57, 2:29-33, 3:12-41. In fact, every example discusses a user's actions, underscoring their central involvement to the claims. *Id.* at 2:66-9:33. Even Dr. Almeroth agreed that the claims require signals and messages from a user's device—"that kind of information *has to be received in the server system*." Tr. 401:22-402:13; 436:7-9 (the pieces of information in the claims are "required"); 445:12-448:21 (source code contained all requirements of the claimed messages); 434:12-435:2 (outlining user involvement); 435:9-24 (same); 435:7-439:16 (same); 440:18-22 (same). Indeed, he admitted that it is users "who pick[] the movie to play" and "who decide[]" "to watch Netflix." Tr. 503:24-504:4.

Yet, even though end users—not Google—make the selections on their devices that result in the claimed messages and signals, Touchstream presented *no evidence* that Google directs or controls that user action. Instead, Dr. Almeroth asserted without evidence that, "when you look at the words of the steps, that is functionality performed by Google, provided by Google." Tr. 547:17-21. Such unsupported, "[c]onclusory statements by an expert … are insufficient to sustain a jury's verdict." *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1172 (Fed. Cir. 2015); *see also Yoon Ja Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1320 (Fed. Cir. 2006) (same). In any event, Dr. Almeroth's bald assertion was directly contrary to his extensive testimony, just discussed, that the claims require messages or signals from a *user's* device.

For this additional reason, the jury's infringement verdict cannot stand.[4]

[4] Because the '251 patent claims only "video files," Touchstream does not dispute that audio-only

3. Certain Chromecast-Enabled Devices Are Made By Third Parties

Touchstream accused a category of third-party products consisting of televisions and other Chromecast-enabled devices that Touchstream alleged are the claimed "content presentation devices." But Touchstream presented *no* evidence that Google directs or controls those manufacturers in their numerous design and other choices, including whether their products have any display screens or speakers for presenting content, the media-player applications that are installed (including use, or not, of the receiver SDK), or the content that is included through the apps on the televisions and devices. Accordingly, while the Court should find no divided infringement as a matter of law for all accused products, Touchstream's independent failure with respect to this category of products would require, at minimum, a new damages trial that excludes them from trial.

* * *

In short, in multiple respects, Touchstream failed to prove divided infringement, even though the asserted claims and Touchstream's infringement theory invoked that theory. The jury's infringement verdict should be reversed for any and all of these additional reasons.

C. For Additional Reasons, No Reasonable Jury Could Find Infringement

Even under Touchstream's understanding of "server system," and setting aside the divided-infringement failure of proof, Touchstream failed to prove infringement.

1. Touchstream Failed To Establish That The Accused Products Perform The Functionality Of The "Server System" Under Its Construction

Touchstream alleged that the "receiver SDK" is a critical aspect of the "server system" under its theory, labeling it the "glue" that "enables communication between the cast service and

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accused devices—e.g., Chromecast Audio, third-party speakers with "Chromecast Built-In," Google Home, Google Home Mini, Google Home Max, Google Nest Audio, Google Nest Mini, Google Nest Wifi Point (wifi extender with speaker)—cannot infringe that patent. Tr. 482:12-17.

the phone." *See supra* Section III.B.1. But it is undisputed that, while Google offers the receiver SDK for use by media-player developers, developers can use as much or as little (including none) of the receiver SDK as they want. *See id.* Indeed, undisputed testimony established that various media players only use bits and pieces of the receiver—and some may use no part of the receiver SDK at all. *See id.* "Netflix, for example, does not use all of the receiver SDK," "YouTube does not use all of the receiver SDK," and Facebook may not use any of it. Tr. 850:3-10 (Van Der Staay). In short, it is up to each developer what pieces of the receiver SDK it may use.

Touchstream did not identify the precise part(s) of the receiver SDK that perform the "server system" functionality necessary under its infringement theory, nor did it show that *any* media player on which it relies (e.g., Netflix, YouTube, Facebook) uses such functionality. Because media players need not and do not use the receiver SDK wholesale, Touchstream's complete lack of proof precludes infringement.

2. Touchstream Failed To Show Infringement Of "Receiving" "Messages" That "Identify A Location" ('289 And '528 Patents)

Certain asserted claims (claims 1 and 2 of the '289 patent and claims 1 and 14 of the '528 patent) recite: "receiving, in a server system, one or more messages from a personal computing device," and the messages "identify a location of the particular media player." For at least two reasons, no reasonable jury could have found infringement of this limitation.

First, Dr. Almeroth's conclusion that the Cast App ID "identif[ies] a location of the particular media player" misinterpreted the evidence. The only evidence regarding the Cast App ID was that it is merely a number and does not itself identify a location. *E.g.*, Tr. 853:15-857:8 (Van Der Staay); 963:13-965:13 (Mayer-Patel). As Mr. Van Der Staay testified, there is *not* a one-to-one correspondence between the Cast App ID and a webpage, and the Cast App ID merely identifies an app, e.g., Spotify. Tr. 853:15-857:8. His unrebutted testimony made clear that a

particular app is not the same as the location. *Id.* He further testified that the purported media player (i.e., the webpage) itself may vary based on the device used. Tr. 856:19-24 (explaining that "it's up to each individual app developer" to "optimize that experience to get the best possible experience to their users," and they "can target different web apps or different URLs for different devices … that support Cast"). Because the Cast App ID itself does not identify a location, Dr. Almeroth's conclusion was unsupported, and Touchstream did not prove infringement.[5]

Second, the claims require that the "*personal computing device*" (e.g., phone) send the messages that identify the location of a particular media player. But under Touchstream's theory, the accused "*content presentation device*," i.e., the accused *Chromecast-enabled device*, identifies the location of a particular media player. Indeed, Dr. Almeroth testified that "the cast service box," which resides on the accused "content presentation device"—not the personal computing device—"will send a request to the [device configuration server ('DCS')] and say, Take this app ID and return to me information about it." Tr. 522:20-524:14; Ex. C at 67 (Almeroth demonstratives). It was undisputed that the DCS provides this information directly to the Chromecast-enabled device when it starts up. Tr. 862:8-24 (Van Der Staay). And the record shows several reasons why the personal computing device, as used with the accused products, is expressly designed *not to send* messages that identify the media player's location. *E.g.*, Tr. 853:15-857:8 (Van Der Staay) (Google intentionally did not want messages to include a URL or web address in order to let "partners build unique experiences" for different types of devices); 963:13-965:13 (Mayer-Patel) (agreeing with Mr. Van Der Staay). Because the "personal computing device" does not "identify the location of a particular media player" (rather, the DCS separately provides this information to

[5] Because Touchstream dropped its doctrine-of-equivalents case at trial, *see supra*, this difference is legally significant to the infringement inquiry.

the *Chromecast-enabled device*), none of the accused products infringe. *See CommScope*, 10 F.4th at 1297-98 (JMOL warranted where "unrebutted evidence" shows non-infringement).

3. Touchstream Failed To Show Infringement Of The "Storing" Limitation ('251 Patent)

The asserted claims of the '251 patent (claims 1 and 8) recite: "storing, in a database associated with the server system, information for transmission to or retrieval by the display device, wherein the information … includes the corresponding programming code to control playing of the video content on the display device by the particular media player in accordance with the universal playback control command." For at least two reasons, Touchstream failed to meet its burden on this limitation as a matter of law.

First, Touchstream contended that memory on the "personal computing device," e.g., a phone, stores the programming code to control playing of the video content by the particular media player. Tr. 485:17-23 (Almeroth). But unrebutted testimony showed that the phone does not store the claimed "programming code." *See* Tr. 859:17-860:21 (Van Der Staay); 959:13-963:8 (Mayer-Patel). The only time Dr. Almeroth referred to the claimed "programming code" was when he explained that the allegedly infringing code resides on the cast-enabled device—not the phone. Tr. 451:19-454:10. Dr. Almeroth based his opinion on testimony from Mr. Van Der Staay that the phone stores certain information when it enters a low power state. Tr. 484:3-485:23. However, both Mr. Van Der Staay and Dr. Mayer-Patel confirmed that this stored information does not include any "programming code to control playing of the video content on the display device by the particular media player"; instead, the system stores a single "session identifier" to resume the peer-to-peer connection between the phone and the accused device. *See* Tr. 859:17-860:21 (Van Der Staay) (a "store session" "keep[s] one ID … that tells the phone … I had a connection" and "allows it to resume that connection"); 959:13-963:8 (Mayer-Patel) (the information stored on the

phone, like the session ID, re-establishes a peer-to-peer connection; there is no evidence that the phone stores "any sort of programming code"). Jurors may not disregard unchallenged and unimpeached testimony. *Imperium IP Holdings (Cayman), Ltd. v. Samsung Elecs. Co.*, 757 F. App'x 974, 979 (Fed. Cir. 2019) (citing Fifth Circuit cases).

Second, and relatedly, Touchstream also failed to show that the phone stores the claimed programming code for transmission to or retrieval by the display device. Dr. Almeroth opined that the accused products' "session identifier" functionality meets this limitation because, in his view, the "session ID includes all of the information that the device keeps track of, where Spotify is, what the content that's being requested is, how it's being played." Tr. 450:11-16. But Mr. Van Der Staay's testimony, as further confirmed by Dr. Mayer-Patel, showed that the accused functionality stores a single "session identifier" that does not include any "programming code." *See* Tr. 859:17-860:21 (Van Der Staay); 959:13-963:8 (Mayer-Patel). Because the "session identifier" does not include any programming code, there was no evidence that the phone stores programming code for transmission to or retrieval by the display device as required by the claims.

* * *

Because Touchstream failed to show the accused products practice these three limitations, even under its construction of "server system," JMOL of non-infringement is further warranted.

IV. NO REASONABLE JURY COULD FIND THE CLAIMS NOT INVALID

Google presented clear and convincing evidence that the asserted claims were invalid. Moreover, Touchstream failed to meet its burden to come forward with evidence of its asserted priority date of October 8, 2010, to predate the GTS system that was the sole or primary reference for Google's obviousness defenses. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379-80 (Fed. Cir. 2015) (discussing patentee's burden on priority). Touchstream left whole portions of its alleged priority case unsupported.

A. Google Is Entitled To JMOL On The Priority Dispute

The parties disputed whether Touchstream was entitled to its asserted priority date of October 8, 2010, predating the GTS system used in all of Google's obviousness theories. For at least two reasons, the patents' priority date was their April 21, 2011 filing date, making the GTS system prior art.

First, Touchstream failed to corroborate Mr. Strober's testimony that he conceived of the claimed inventions by October 2010. Because conception is a mental act, courts require corroborating evidence of contemporaneous enabling disclosure. *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228-29 (Fed. Cir. 1994). Notably, though, there was no evidence of a 2010 prototype. *See* Tr. 115:5-12. The only reference to a prototype related to a meeting *in 2011*—well past the alleged October 2010 conception date. Tr. 184:8-185:17 (Rinzler); 252:15-253:19 (Mitschele). Touchstream's only other evidence of conception by October 2010 consisted of five source code snippets and a purported draft summary of the claimed invention. JTX-218; JTX-226; JTX-228; JTX-254; JTX-255; DTX-637. But those documents' metadata showed that they were modified after that date. The fact that Mr. Strober was in control of these documents further prevents them from serving as corroboration. *See Brown v. Barbacid*, 276 F.3d 1327, 1335 (Fed. Cir. 2002) ("an inventor's own unwitnessed documentation does not corroborate an inventor's testimony about inventive facts"); *EMC Corp. v. Pure Storage, Inc.*, 204 F. Supp. 3d 749, 761-62 (D. Del. 2016) (photographs with metadata not corroborative of inventor's testimony because inventor "took the photographs and had control of the camera, the photograph file names, and the metadata"); *Transocean Offshore Deepwater Drilling, Inc. v. GlobalSantaFe Corp.*, 443 F. Supp. 2d 836, 856 (S.D. Tex. 2006) (given drawings' "Last Modified Date," inventor's testimony that he created the drawings before then required corroboration).

Second, both alleged conception and reduction to practice "must include every feature or

limitation of the claimed invention." *Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997) (conception); *Slip Track Sys., Inc. v. Metal-Lite, Inc.*, 304 F.3d 1256, 1265 (Fed. Cir. 2002) (same, for reduction to practice). Dr. Almeroth *admitted* to this evidentiary failure—he "ha[dn't] gone through all of the steps" of the claims for Touchstream's alleged priority date. Tr. 408:6-9. While he said he later "might go through and actually do a step-by-step analysis … *to really establish that the conception date was October 2010*," Tr. 408:9-15, he never delivered on that promise: he never revisited priority at all. The jury had only Dr. Mayer-Patel's unrebutted testimony that Touchstream's alleged documentation of priority lacked at least four limitations. Tr. 1015:3-22.

Touchstream's evidentiary failures leave the claims with their April 2011 filing date.

B. Google Is Entitled To JMOL That The Asserted Claims Are Obvious

With GTS as prior art, a reasonable jury would have been compelled to find that Google presented clear and convincing evidence of obviousness.

By reference to, among other things, a video showing GTS in use (DTX-118A), Dr. Mayer-Patel provided a detailed, element-by-element analysis of how GTS alone rendered obvious the '251 claims and, for the '528 and '289 claims, rendered them obvious in view of GTS and Muthukumarasamy.[6] Dr. Mayer-Patel cited Muthukumarasamy only for the "identify a location of the particular media player" limitation of the '528 and '289 patents. He showed that Muthukumarasamy disclosed this and that a POSA would have been motivated to combine it with GTS to achieve the claims. Tr. 1001:4-1006:22; JTX-22; *see also, e.g.*, JTX-1; JTX-3; JTX-21;

[6] Dr. Mayer-Patel's full testimony on invalidity can be found as follows: *common limitations across the asserted claims, including all of '251 patent, claim 1*—Tr. 980:24-982:6 (preamble); 982:13-986:5 ("synchronization" limitations); 968:12-990:4 ("receiving" limitations); 990:17-993:10 ("converting" limitation); 993:11-997:6 ("storing" limitation); *'251 patent, dependent claim 8*—Tr. 998:1-999:17; *'528 patent, claim 1*—Tr. 1005:25-1006:22 ("identify a particular media player" limitation); 1007:11-1008:13 ("obtaining" limitation); *'528 patent, dependent claim 14*—Tr. 1008:22-1009:20; *'289 patent, claim 1*—Tr. 1010:18-1011:15 ("media player" "operable to present content" limitation); and *'289 patent, dependent claim 2*—Tr. 1011:25-1012:16.

JTX-51; JTX-63; DTX-118A; DTX-120; DTX-632 (supporting documentation); Tr. 892:19-904:3 (Levai).

Touchstream presented only a limited opposition and failed to rebut Google's showing. Dr. Almeroth opined that GTS could not invalidate because it supported only one media player, whereas the claims' preamble requires a "plurality of different media players." But the Court did not construe the preamble as limiting, Tr. 1251:1-9, and in any event, Google showed obviousness of using a plurality of media players. It is undisputed that GTS *controlled* at least one media player, *see* Tr. 980:24-982:6 (Mayer-Patel); Tr. 1225:4-11 (Almeroth), and that GTS *supported* multiple media players, *see* Tr. 986:12-990:4 (Mayer-Patel); Tr. 1250:1-9 (Almeroth). It thus would have been obvious to apply the means for controlling the one media player to the other GTS-supported media players. *E.g.*, *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1330-31 (Fed. Cir. 2009) (recitation of steps known in the art rendered claim obvious).

Touchstream's only other counterargument was that a POSA would not have combined GTS and Muthukumarasamy because they used two "fundamentally different kinds of architectures." Tr. 1241:13-1243:10. That argument was limited to the '528 and '289 claims because Google's obviousness case for the '251 claims relied on GTS alone. And Dr. Almeroth's conclusory testimony could not overcome Google's clear and convincing evidence that both GTS and Muthukumarasamy had the same basic architecture and were directed to the same concept as the asserted claims—controlling media systems from a personal computing device with "a server in the middle that is facilitating this." Tr. 1001:4-1005:15.

V. CONCLUSION

Google is entitled to JMOL of no infringement and of invalidity.

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Respectfully submitted,

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Exhibit A

U.S. Patent No. 8,356,251 – Asserted Claims 1 and 8

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

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

receiving, in the server system, a message form 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 form 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.

8. The method of claim 1 wherein the synchronization code is uniquely associated with the display device on which the video content is to be played.

U.S. Patent No. 8,781,528 – Asserted Claims 1 and 14

1. A method of controlling presentation of content on a content presentation device that loads anyone of a plurality of different media players, the method comprising:

receiving, in a server system, one or more messages from a personal computing device that is separate from the server system and separate form the content presentation device, wherein the one or more messages, taken together, include information associated with a synchronization code assigned to the content presentation device, specify a file to be acted upon, identify a particular media player for playing content from the file, identify a location of the particular media player, and include an action control command for presentation of the content on the content presentation device by the particular media player, the action control command being independent of the particular media player;

using the information associated with the synchronization code to store a record establishing an association between the personal computing device and the content presentation device;

identifying, by the server system, programming code corresponding to the action control command, wherein the programming code is for controlling presentation of the content by the content presentation device using the particular media layer;

obtaining, by the content presentation device, the particular media player, wherein the particular media player is obtained over a network from a content provider;

loading the particular media player in the content presentation device; and

using the particular media player to execute the programming code with respect to the file.

14. The method of claim 1 including:

receiving, in the server system, a further message form the personal computing device, the further message including a second action control command;

identifying second programming code corresponding to the second action control command, wherein the second programming code is for controlling presentation of the content by the content presentation device using the particular media player; and

using the particular media player to execute the second programming code with respect to the file.

U.S. Patent No. 8,904,289 – Asserted Claims 1 and 2

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

receiving, in a server system, one or more messages form a personal computing device that is separate from the server system and separate from the content presentation device, wherein the one or more messages, taken together, (i) include information associated with a unique identification code assigned to the content presentation device, (ii) specify a file to be acted upon, (iii) identify a particular media player for playing content from the specified file wherein the media player is a computer application operable to present content and control presentation of the content, (iv) identify a location of the particular media player, and (v) include an action control command for presentation of the content on the content presentation device by the particular media player, the action control command being independent of the particular media player;

using the information associated with the unique identification code to store a record establishing an association between the personal computing device and the content presentation device; and

identifying, by the server system, programming code corresponding to the action control command, wherein the programming code is for controlling presentation of the content by the content presentation device using the particular media player,

wherein, based on information received or retrieved from the server system, the content presentation device uses the particular media player to execute the programming code with respect to the file.

2. The method of claim 1 further including loading the particular media player in the content presentation device prior to executing the programming code with respect to the file.

Exhibit B

REMARKS

Claims 1-27 are presented for further examination.

Request that the Office consider all reference submitted in the IDS of 9/26/11

Applicant submitted an Information Disclosure Statement (IDS) together with the application on September 26, 2011. The Office action "lined through" items 12-15 and 17-28 on the form 1449 that accompanied the IDS, indicating that the Examiner might not have considered these items. The Office, however, failed to provide any explanation for not considering all the listed items.

As indicated in the IDS, copies of the foregoing items, as well as English-language abstracts for items 12-15, were provided in the parent application (serial no. 13/157,821) in an IDS submitted on June 10, 2011. Therefore, the Office should have considered each and every item listed on the form 1449 in the IDS for the present application. *See* 37 C.F.R. §§1.97-1.98. Applicant requests that the Office acknowledge its consideration of all references in the next communication.

Rejections under 35 U.S.C. §§102-103

The Office rejected the claims over the following references:

(1) Claims 1-10, 12-21 and 23-26 were rejected as anticipated by U.S. Patent Publication No. 2011/0060998 (Schwartz).[1]

(2) Claims 11 and 22 were rejected as obvious from Schwartz in view of the information from the web site www.vbulletin.com.

(3) Claim 27 was rejected as obvious from Schwartz.

[1] Although page 2, par. 3 of the Office action seems to indicate that claim 11 also is rejected as anticipated by Schwartz, the remainder of the action indicates that claim 11 is rejected only under section 103 as obvious.

Reconsideration is requested.

Claims 1-12

Independent claim 1 recites a machine-implemented method of controlling presentation of video content on a display device. The method includes receiving, in a server system, one or more signals from a remote personal computing device. The one or more signals (i) specify a video file to be acted upon, (ii) identify a media player[2] for playing the video content, and (iii) include a universal playback command for controlling playing of the video content on the display device by the media player. The claim is amended to clarify that the command is a playback control command. Support for this feature can be found, for example, in the Specification at page 6, lines 13-17, page 8, lines 18-21, page 9, lines 17-18 and 28-31. In some implementations, as explained in the Specification (page 9, line 28 – page 10, line 1):

> [T]he user of the mobile phone 20 can control the playing of the video by entering appropriate commands (e.g., pause, fast forward, rewind, stop, play, etc.) through the mobile phone. Each command is incorporated into a message including a transmission code (FIG. 3) as described above. The message is transmitted to the server system 24, . . .

The method further includes 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 media player. As recited in claim 1, 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. As

[2] In the context of the present application, it is clear that a "media player" refers to application software for playing back the video content. Thus, the claims and specification refer in some cases, for example, to "loading" or "unloading" a media player (*see, e.g.*, Specification at page 4, line 22, page 9, lines 18-27). A particular display device, therefore, may, in some cases, be able to load or store any one of different media players.

explained in the Specification (page 8, line 18 – page 9, line 6) according to example implementations:

> Various types of video players may use different JavaScript commands to control their respective playback. Therefore, in the illustrated implementation, a universal adapter 26 is provided to interpret and convert a standard or universal command (e.g., play, pause, etc.) into the specific command recognized by the media player. Each time a signal is received from the mobile device 20, the API adapter 26 checks and identifies the specific media player that is being requested. Based on this information, the system loads the appropriate set of protocols or application programming interfaces (APIs) from its library and converts the incoming commands from the mobile device 20 into the correct JavaScript (or other programming) code used by the target device 22 to control the specific player (block 120). The server system 24 then copies the converted version of the message to the database 34 associated with the target device 22, as indicated above in connection with block 122.
>
> [ ] Thus, for a universal command "New Video," the universal adapter 26 provides the corresponding command for each of several specific media players (e.g., "yt_loadVideo" for YouTube). Similarly, for a universal command "Pause," the universal adapter 26 provides the corresponding command for each of several specific media players (e.g., "pauseVideo" for Ted.com). Other universal commands and the corresponding command(s) for one of more media players also can be stored by the universal adapter 26.

The method of claim 1 also includes storing, in a database associated with the server system, a message for transmission to or retrieval by the display device. The message specifies the video file to be acted upon, identifies the 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 media player in accordance with the playback control command.

The method may be used to facilitate, for example, a user's creating a playlist based on videos from multiple sources and playing back any of the videos, where the server system acts as a single interface that can be used to control the different media players (*i.e.*, the computer software applications) that may be needed to play the various video files.

Schwartz discloses a system and method for managing Internet media content. As illustrated in FIG. 2 (reproduced below), the system can include a computing device (e.g., a mobile phone) that executes an application 10 (i.e., a software program) (see par. [0138]) to facilitate accessing various media content, including video content. The application is connected through a home network 20 to one or more media destinations 21, 22, 23 (e.g., a television), which can serve as target rendering devices to which the media content can be sent.

FIG. 2

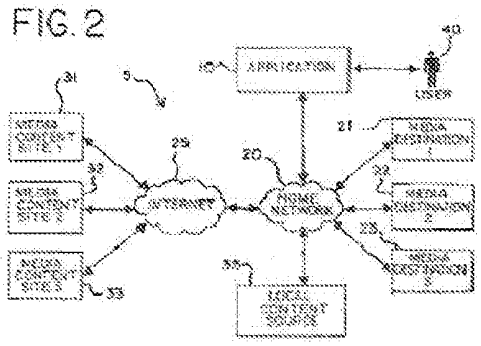
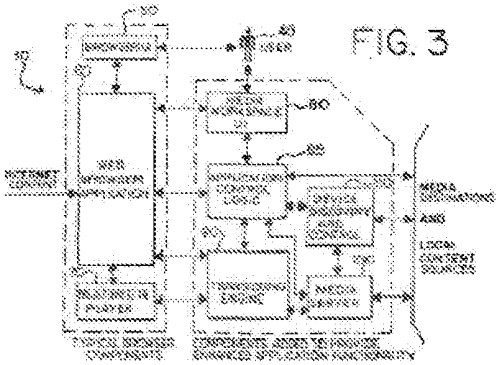


FIG. 3



As illustrated in FIG. 3 of Schwartz (reproduced above), the application 10 residing on the computing device (e.g., the mobile phone) includes various components, such as a transcoding engine 90, a media server component 100 and a device discovery and control (DDC) component 110. The transcoding engine 90 can be used to reformat media content to prepare it for delivery to the specified target media destination (pars. [0114], [0124]). Thus, for example, in response to user input directing transfer of media content to a particular target rendering device, the DDC component 110 communicates with the transcoding engine and/or the media server component 100 to obtain the media content in a form that matches the media capabilities of the target rendering device ([par.0122]). Likewise, in response to user input directing a target rendering device to render media content, the DDC component 110 communicates with the target rendering device to instruct it to request, retrieve, process and/or render the media content (par. [0118]). In addition, Schwartz discloses that the media server component 100 of the application

10 can receive messages from the target rendering device, which may request the transcoded or reformatted media content (par. [0137]).

The Office alleges that such messages sent by the target rendering device to the media server component 100 of the Schwartz's software application 10 correspond to the "one or more signals" in claim 1. As explained below, that is incorrect.

First, applicant points out that claim 1 recites that the one or more signals are received *in a server system from a remote personal computing device*, and that the message stored in the database associated with the server system is for transmission to or retrieval *by a display device*. Thus, the server system acts an interface for facilitating the transfer of information contained in the one or more signals (received from the personal computing device) to the display device. The claimed method is significantly different from the method of operation disclosed by Schwartz in which the application 10 residing on the computing device communicates directly through the home network 20 with the target rendering device (e.g., media destination 21). In view of the fact that in Schwartz's system the application 10 residing on the computing device communicates directly through the home network 20 with the target rendering device, there is no need to perform the particular operations recited in the method of claim 1 and indeed, as explained below, Schwartz does not disclose the claimed method.

The Office alleges that the media component 100 of the application 10 corresponds to the claimed "server system" and the target rendering device corresponds to the claimed "personal computing device." However, the messages sent by the target rendering device (*e.g.*, media destination 21) to the media server component 100 of the software application 10 do not correspond to the "one or more signals" in claim 1. In particular, Schwartz explains that the media server component 100 can receive request messages from the target rendering device (par. [0137]) (emphasis added):

> *The media server component 100 may receive request messages from the target rendering device which may request the transcoded, reformatted and/or repurposed internet media content. The request messages from the*

> *target rendering device may request specific portions of the transcoded, reformatted and/or repurposed internet media content.* The media server component 100 may receive instructions from the transcoding engine 90 and/or from other components of the application 10. The instructions may direct the media server component 100 to transmit the transcoded, reformatted and/or repurposed internet media content. The instructions may direct the media server component 100 to transmit the specific portions of the transcoded, reformatted and/or repurposed internet media content. In response to the request messages and/or the instructions, the media server component 100 may transmit the transcoded, reformatted and/or repurposed internet media content and/or the specific portions to the target rendering device.

There is nothing in Schwartz to indicate that the messages sent *from* the target rendering device *to* the media server component 100 include a "playback control command" for controlling playing of the video content on the display device.

Furthermore, although Schwartz elsewhere discloses user-initiated playback controls such as "play," "pause," etc., any such playback controls are sent from the DDC component 110 of the application 10 residing on the computing device to the target rendering device (par. [0119]; *see also* par. [0214] and FIG. 6). Such playback controls are *not* sent from the target rendering device (which allegedly corresponds to the claimed "personal computing device") to the media server component 100 or any component of the application 10 (which allegedly corresponds to the claimed "server system").[3] Therefore, the media component 100 of the application 10 also does not "convert" any playback control commands that were received "from" the target rendering device. Furthermore, there is nothing in Schwartz that discloses or suggests that converting a 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," as recited in claim 1.

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[3] Receipt *by the application 10* of playback controls also does not satisfy the claim language of "receiving, in a server system, one or more signals from a remote personal computing device. . ." For one thing, the application 10 and the computing device executing the application are not a "server system." Furthermore, the user-initiated playback controls are not received in the application 10 "from a *remote* personal computing device." Instead, the application 10 is being executed by the computing device on which is resides.

Applicant acknowledges that, as discussed above, the application 10 includes a transcoding engine 90 that "may reformat and/or repurpose *the media content*" for compatibility with the media destination(s) (par. [0114]). As explained by Schwartz:

> The transcoding engine 90 may process the internet *media content* and/or the locally stored *media content* to prepare the media content for delivery to the specified media destination. The transcoding engine 90 may transcode the internet *media content* and/or the locally stored *media content* based on the media capabilities of the specified media destination. For example, the transcoding engine 90 may transcode the *media content* to produce transcoded media content which may conform to media codecs, profiles and/or levels which may be supported by the specified media destination. The transcoding engine 90 may reformat the *media content*. For example, the transcoding engine 90 may reformat the *media content* to produce reformatted media content which may have a file format and/or a delivery format appropriate for the specified media destination.

Here too, however, there is nothing to indicate that the transcoding engine "converts" <u>playback control commands</u>. Instead, any reformatting or repurposing it might perform is with respect to the <u>media content</u> itself, not with respect to a playback control command.

In view of the foregoing remarks, it is clear that Schwartz fails to disclose (1) receiving, in a server system, one or more signals from a remote personal computing device, . . . 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 media player, and (2) converting, by the server system, the playback control command into corresponding programming code to control playing of the video content on the display device by the 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.

The information from the web site www.vbulletin.com also fails to disclose or render obvious the claim limitations missing from Schwartz. Therefore, neither Schwartz nor the information from the web site www.vbulletin.com, taken alone or in combination, discloses or renders obvious the subject matter of claim 1 or its dependent claims.

At least for these reasons, the rejections of claim 1 and its dependent claims should be withdrawn.

Furthermore, the dependent claims recite additional language that renders those claims independently patentable.

Claims 12-22

Independent claim 12 recites a system for controlling playing of video content on a display device. The system includes a server system operable to receive one or more signals from a remote personal computing device. The one or more signals specify a video file to be acted upon, identify a media player for playing the video content, and include a universal playback control command for controlling the playing of the video content on the display device by the media player. The server system also is operable to convert the universal playback control command into corresponding programming code to control playing of the video content on the display device by the media player.

The rejections of claim 12 as well as its dependent claims under sections 102-103 should be withdrawn at least for the same reasons as discussed above with respect to claim 1.

Claims 23-27

Independent claim 23 recites an automated machine-implemented method of presenting video content on a display device. The method includes the display device retrieving[4] from a server system first information (i) that specifies a first video file to be acted upon, (ii) that

[4] For example, in some implementations, the display device can retrieve the information by periodically checking entries in a database or polling the database to determine where there are any new messages directed to it (page 9, lines 7-10).

identifies a first media player for playing the first video file, and (iii) that indicates corresponding programming code to control playing of the first video file on the display device by the first media player in accordance with a first playback control command. The display device obtains over the Internet the first media player for playing the first video file, loads the first media player in the display device, and executes the first playback control command with respect to the first video file using the first media player. The display device also performs the foregoing operations with respect to a second video file, a second media player, and a second playback control command.

In contrast, none of the components in Schwartz's system performs the recited operations. For example, the application 10 executing on the computing device can "retrieve" specified media content from an appropriate media content site (pars. [0102], [0122]). Likewise, the DDC component 110 of the application 10 may instruct the target rendering device to "retrieve" media content and may specify an appropriate location from which the media content is to be retrieved by the target rendering device (par. [0118]).

However, neither the application 10 nor the target rendering device "retrieves," from a server system, information (i) that specifies a first video file to be acted upon, (ii) that identifies a first media player for playing the first video file <u>and</u> (iii) that indicates corresponding programming code used to control playing of a video file by the first media player in accordance with a first playback control command. Although the DDC component 110 of the application 10 transmits playback control instructions to the target rendering device (par. [0119]), neither the DDC component 110 not any other component in the application 10 "retrieves" such instructions form a server system, as recited in claim 23. Likewise, although the target rendering device can receive the playback control instructions from the DDC component 110, the target rendering device does not "retrieve" such information, as recited in claim 23.

Therefore, neither Schwartz nor the information from the web site <u>www.vbulletin.com</u>, taken alone or in combination, discloses or renders obvious the subject matter of claim 23 or its dependent claims.

At least for these reasons, the rejections of claim 23 and its dependent claims should be withdrawn.

Furthermore, the dependent claims recite additional language that renders those claims independently patentable.

Rejections under 35 U.S.C. §101

The Office rejected claims 12-21 as directed to non-statutory subject matter because the claimed system "does not exclude a system composed entirely of software."

Applicant respectfully disagrees.

First, claim 12 is directed to a "system" that includes a server system "operable to receive one or more signals . . ." Therefore, the claimed system is not an "abstract idea" that is ineligible for patent protection under the Supreme Court's 2010 decision in *Bilski*. Furthermore, in view of the fact that the claimed system is "operable to receive one or more signals . . .," it is clear that the claimed system does not encompass a system "entirely composed of software" as alleged by the Office.

Also, claim 12 is amended to recite "one or more computer-readable media storing instructions that when executed by the server system, cause the server system to perform operations . . ." Support for this amendment can be found, for example, in the Specification at page 14, lines 7-24). As explained by the MPEP (§2106.01.I):

> [A] claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.
>
> * * *

> Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.

Therefore, the system of claim 12, which includes one or more computer-readable media, clearly satisfies the requirements of section 101. Accordingly, the rejections of claim 12 and its dependent claims under section 101 should be withdrawn.

Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any necessary charges or credits to Deposit Account 06-1050, referencing the above attorney docket number. Respectfully submitted,

Date: February 22, 2012

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30655917.doc

Exhibit C

WESTERN DISTRICT OF TEXAS

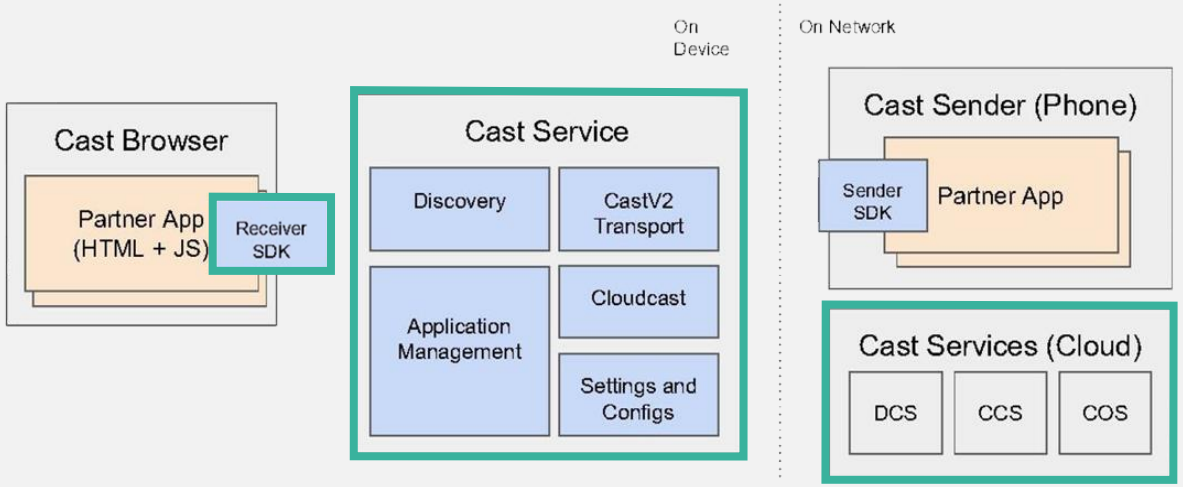
TOUCHSTREAM TECHNOLOGIES, INC.

vs.

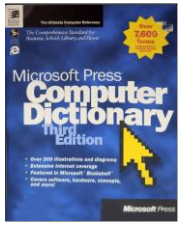
GOOGLE, LLC

Testimony of Dr. Kevin C. Almeroth

Civil Action No.: 21-cv-569



"Server System"



Microsoft Press Computer Dictionary

Third Edition

"1. On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and provides resources to computers functioning as workstations on the network.

2. On the Internet or other network, a computer or program that responds to commands from a client."

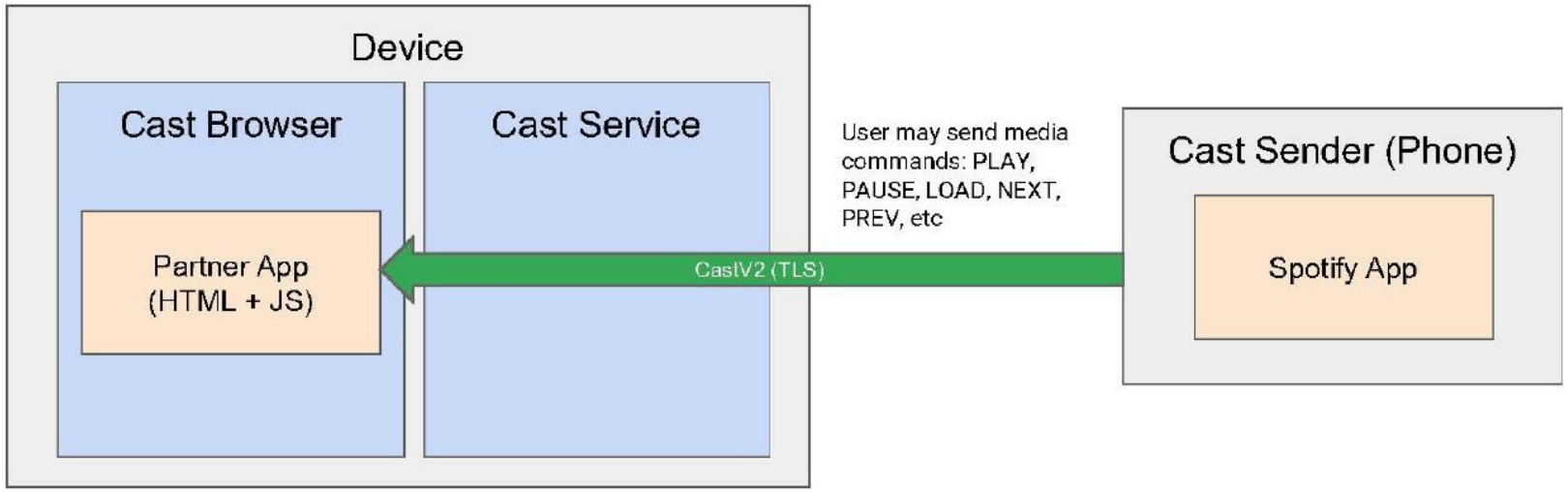
JTX 187.0010

App ID Identifies Location Of Media Player

Phone Casting Flow

Discovery > App Filtering > Connection > Launch > Load > Control

Goal: Control media playback



Google

Confidential + Proprietary

Cast v2 *MDx* *Open Cast*

JTX 187.0025