

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 SUR-REPLY IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE**

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
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
2023	Lex Machina Report – District Judge James Rodney Gilstrap Order Stats between Jan. 1, 2012 – April 12, 2024, filtered for “Stay Pending PTAB”

The Board can and should deny the Petition on its merits for at least the reasons set forth in Patent Owner’s Preliminary Response (Paper 9). The facts here also warrant the exercise of discretion to deny institution (i) under 35 U.S.C. § 314(a) and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (hereinafter “*Fintiv*”) (precedential) and (ii) under 35 U.S.C. § 325(d). Petitioner fails to show otherwise in its Reply.

I. APPLYING THE *FINTIV* FACTORS, THE BOARD SHOULD EXERCISE DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314

Petitioner fails to address at least three of the *Fintiv* factors, which undisputedly weigh in favor of denying institution. *Compare* Paper 9, 54–59, 61 *with* Paper 11. *See also* Pet., 17–18 (asserting that Factors 2, 3, and 5 “do[] not warrant denial”). Petitioner also conceded that Factor 1 is, at best, neutral. *See* Pet., 17. And Petitioner fails to make a “compelling” case of obviousness on the merits. *See generally* Paper 9. The balance of *Fintiv* factors therefore favors denial, independent of the Reply arguments, which are baseless, irrelevant, or both.

A. Factor 1 – Likelihood of a Stay

Petitioner complains that the statistics on stay motions in the district court (*see* Ex.2002) include motions filed prior to institution. *See* Paper 11, 1 (claiming “33 of the 58 denials” resulted from “premature” motions). But Petitioner fails point to a *single case* denying stay in a case as advanced as this—where fact discovery and expert reports will be complete prior to an institution decision, and trial is set a mere

three months later. The advanced stage of the litigation weighs heavily against a stay. *See* Paper 9, 53. Petitioner makes no effort to dispute that. *See* Paper 11, 1–2.

In addition, Petitioner fails to mention that the statistics *granting* stays include *stipulated* stays. *See, e.g.*, Ex. 2002, 148; *Uniloc USA Inc. v. Amazon.com, Inc.*, No. 2:18-cv-00123, Dkt. 19 (E.D. Tex. Aug. 6, 2018). Indeed, 16 of the 25 granted “Stays Pending PTAB” were stipulated.¹ *See generally* Ex. 2023.² Focusing only on *contested* motions filed *after institution* (and omitting dispositions labeled “unknown” and “moot”), leaves 9 stays granted, 25 stays denied (based on Petitioner’s count), and one “partial” grant. *See* Ex.2023. With only 25% of contested stay motions granted, the numbers confirm that “a stay is unlikely” and “Factor one favors discretionary denial.” Paper 9, 53–54.

B. Factor 4 – Overlap of Issues

Petitioner fails to address the salient issue: institution would waste public resources and risk inconsistent outcomes. The district court *will* hold a trial on invalidity months before the Board reaches final written decision. And even though the Petition challenges claims not asserted in the district court, the court will resolve

¹ This label also includes joint and unopposed motions.

² Exhibit 2023, provided for convenience, is a filtered version of the report filed as Exhibit 2002, using the same date range and limited to “Stay Pending PTAB.”

overlapping validity issues for the asserted claims, making it “inefficient to proceed” with the IPR. *Fintiv*, at 13. Indeed, Petitioner does not even attempt to show that any of challenged-but-unasserted claims present different issues of invalidity from the asserted claims to justify a duplicative use of Board resources. *See* Paper 11, 2–3.

Any mitigating effect Petitioner’s stipulation might have had is extinguished by Charter’s ongoing pursuit of invalidity defenses based on the same prior art. Whether Charter is a “co-defendant” for *trial*, or should have been named a Real-Party in Interest in this proceeding is irrelevant: Petitioner admits to a joint defense-agreement with Charter, and the two continue to coordinate on their invalidity defenses. Because of this, Patent Owner must still prepare for and defend against the petitioned grounds in a jury trial, regardless whether the Board institutes on the Petition. Petitioner’s stipulation therefore does not eliminate the risk that Patent Owner will face a trial on invalidity based on the Petitioned grounds during this proceeding. That is an overlap of issues that weighs in favor of denying institution under *Fintiv*.

II. DISCRETION UNDER § 325(D) WARRANTS DENIAL

A. Danciu

Danciu describes and is substantially similar to the YouTube Remote and YouTube Leanback services, as Danciu’s assignee confirmed. *See* Ex.1183, 975:5–25. Those services were before the Examiner during prosecution. Ex.1101, 2–3

(listing “Other Publications”). As noted in Patent Owner’s Preliminary Response, Danciu (like the YouTube-related services it describes) only provides control over content from a single source and using a single media player—YouTube. *See* Paper 9, 40–44. Danciu’s similarity to the art before the Examiner is thus sufficient. The jury trial confirms the Examiner made no “material error.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 8–9 (PTAB Feb. 13, 2020) (precedential).

B. Mahajan

Independent of Danciu’s similarity to the art of record, Petitioner’s reliance on Mahajan warrants the exercise of discretion under § 325(d). First, the Board’s precedent does not support Petitioner’s proposed rule that art considered in a *related* application cannot support application of § 325(d). *See* Paper 11, 4. The Board’s jurisprudence on § 325(d) treats art cited against a related application as art considered by the Office. *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at 3, 16, n.6 (PTAB Dec. 15, 2017) (precedential as to § III.C.5 ¶ 1 and informative). Thus, contrary to Petitioner’s implication, the file histories of related patents “pertain[] to the challenged patent.” Paper 11, 4.

Second, there is no dispute that Mahajan was cited by the Examiner in the related application, so “the same art previously was presented to the Office.” *See Advanced Bionics*, at 8. This satisfies the first part of the *Advanced Bionics*

framework, even if the arguments were not “substantially the same.” *See id.* Petitioner makes no effort to show a material error by the Examiner, and without such a showing, “the Director generally will exercise discretion not to institute *inter partes* review.” *Id.* at 9. Moreover, when Applicant argued that Mahajan does not disclose “universal commands” in the context recited by the base claim, the Examiner stated he was *not citing it for that purpose*. *See* Paper 11, 5 (citing Ex.1176, 187–88); Ex.2001, 12–13. As relevant here, the ’751 and ’251 patents include similar context, both reciting a computing device sending a message including a command in the “second format” (*i.e.*, a “universal” command) and, as a result, a server (or server device) sends a message including a command in a different format (*e.g.*, the “programming code” of the ’251 patent’s claims). *Compare* Ex.2017, 2–3, 9 *with* Ex.1101, 11:35–51.

III. CONCLUSION

For the reasons herein and in its Preliminary Response, Patent Owner respectfully requests that the Board deny institution.

Dated: June 3, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on June 3, 2024, a complete and entire copy of the foregoing Patent Owner's Sur-Reply in Support of Patent Owner's Preliminary Response and Exhibit 2023 were provided via email to Petitioner's counsel of record as follows:

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