

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

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

**PATENT OWNER'S MOTION TO STRIKE
IMPROPER REPLY ARGUMENTS AND EVIDENCE**

Petitioners violate the rules governing IPR proceedings by articulating a new obviousness theory for the first time in their Reply. *See* Paper 27 (“Reply”), 8–10. Those rules required Petitioners to set forth the bases for their grounds in the Petition. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). The Petition sets forth two alternative theories for combining Mahajan—cited for the *converting* limitations of claims 1 and 11—with each of the primary references, Danciu or Aldrey. Those theories were so flawed, they led the Board to deny institution on two parallel Petitions asserting similar theories against similar claims. *See generally* IPR2024-00324, Paper 19; IPR2024-00326, Paper 13. Petitioners now seek to revise the Petition retroactively, claiming they “identified a typographical error” that fundamentally changes how the Petition maps a critical claim element. Reply, 8 n.2. The record suggests there was no error. Even if there were, Petitioners had the opportunity to correct it sooner and chose not to do so. Patent Owner therefore requests that the Board strike the Reply arguments based on these new theories (Reply, 6–16) and the corresponding portions of the supporting declaration (Ex.1198 ¶¶6–9) as improper under 37 C.F.R. § 42.23(b). The Board authorized this Motion via email on February 24, 2025.

I. THE NEW REPLY THEORY WAS NOT PRESENTED IN THE PETITION

Claims 1 and 11 both recite (in part) *converting* performed by a *server system*. Moreover, the *universal playback control command* that the *server system converts*

must be *received*, by the *server system*, from a *personal computing device*. Petitioners rely entirely on Mahajan for the *conversion* itself (Pet., 39–42, 69–72), while relying on the primary references to disclose the *server system*, *personal computing device*, and other features (*e.g.*, Reply, 3–6). Identifying how and why they propose implementing Mahajan’s particular teachings in Danciu’s and Aldrey’s systems is a critical part of Petitioners’ grounds. *See* 37 C.F.R. § 42.104(b)(4); *ActiveVideo Networks, Inc. v. Verizon Commnc’ns, Inc.*, 694 F.3d 1312, 1327–28 (Fed. Cir. 2012) (requiring, for proof of obviousness, explanation of “how” and “why” elements would have been combined to achieve the claimed invention). The Petition offered two versions of the proposed implementation, neither of which presents the theory Petitioners now argue in Reply.

In one version of the Petition’s proposed implementation, “one or more [of Mahajan’s] RTS Media Abstraction Modules could operate at a server, such as in Servers 24A-24N” or “Aldrey’s Service Provider Network 103.” Pet., 41, 72. Notably, the Petition does not specify which of Mahajan’s two RTS Media Abstraction Modules (210, 214) would operate at the alleged *server systems* in the circumstances where there is only one. *See id.*, 41, 71–72.

This omission is critical. Mahajan does disclose one of the RTS Media Abstraction Modules—Module 210—operating at a server. *E.g.*, Ex.1114, [0036]. But the two RTS Modules 210, 214 perform different functions. *E.g.*, *id.*, [0036]–

[0040]. Petitioners’ new Reply theory requires that Mahajan’s client-based RTS Module 214, in particular, be implemented on the alleged *server systems* of Danciu or Aldrey (Reply, 11), while also requiring that Mahajan’s server-based RTS Module 210 would be implemented on the alleged *personal computing devices* of the primary references (*id.*, 7–8). The Petition did not identify the client-based RTS Module 214 as the one module that would be operating at a server in the purportedly obvious combination. *See* Pet., 41, 71–72. Contrary to Petitioners’ assertions, the Petition included no details at all about how “the media abstraction modules taught by Mahajan would operate at Danciu’s [or Aldrey’s] server.” Reply, 9–10.

The other theory set forth in the Petition states the results of the proposed combination would be that neither of Mahajan’s RTS Modules would be located on the alleged *server systems*. *See* Pet., 32, 68. In particular, Petitioners argued the “predictable results” of combining Mahajan with Danciu would have been that “Danciu’s remote control would translate commands . . . to a generic format, [and then] transmit them to the controlled device, which would translate them . . . for execution.” *Id.*, 32. Similarly, Petitioners argued the “predictable results” of combining Mahajan with Aldrey would have been that “Aldrey’s end terminal would translate commands associated with a first type of media playing application to a command associated with a second type of media playing application on a television.” *Id.*, 68. Neither of these theories includes any role for the alleged *server*

systems—Danciu’s “Servers 24A-24N” or Aldrey’s “Service Provider Network 103”—let alone the specific role asserted in Petitioners’ Reply.

II. PETITIONERS’ PURPORTED “TYPOGRAPHICAL ERROR” DOES NOT EXCUSE IMPROPER REPLY ARGUMENTS

Petitioners cannot show that their new Reply theory supports either of the original obviousness theories in the Petition. Nor do they try. Instead, Petitioners insist they made “a typographical error” when describing the predictable results of the combination of Mahajan with Danciu, causing “server” to be replaced with “controlled device” as the location where the second translation step would occur. Reply, 8 n.2 (citing Pet., 32). This is a tacit admission that their Reply theory is new; Petitioners would not otherwise need to mark-up the Petition retroactively to add the theory to the case. Claiming to fix a typo—and doing so in a way that purports to sidestep Response arguments—does not excuse improper Reply arguments.

First, the Petition as a whole discredits the claim that there even was a typo. The Petition repeatedly characterizes Danciu’s commands as going from the remote control to the controlled device, with the servers merely providing a pathway. *See* Pet., 5 (“[C]ontrolled device 18 . . . may be . . . connected via network 22, including servers 24A-24N [], to a remote control 14.”), 20 (same), 25 (“[T]he controlled device 18 (‘the display device’) is provided with commands from the remote control (‘one or more signals from the personal computing device’) that were received by

the servers.”), 31 (“Danciu’s system[] comprising a remote control sending commands to a controlled device via a server”). This characterization of Danciu matches the original text of the Petition—now claimed to be erroneous. *Id.*, 32. The original text is also consistent with the “predictable result” described for the Aldrey-Mahajan combination, which as shown above, includes no role for the alleged *server system*. Compare *id.*, 32 with *id.*, 68. Petitioner does not contend there was a typo in the Aldrey-Mahajan argument. Reply, 8 n.2. All of this suggests the Petition theory was a deliberate choice, not a “typographical error.” *Id.*

Second, Petitioners had notice that the purported typo would be relevant since at least institution. See Paper 9 (POPR), 28 (citing Pet., 32) (“[I]n the combination with Danciu, the ‘controlled device’ of Danciu—the alleged *display device*—would perform the second translation.”); Paper 13, 33–34 (quoting Pet., 32). Instead of correcting the Petition (which the rules expressly permit, 37 C.F.R. § 42.104(c)), Petitioners waited until after Patent Owner’s Response to advance their new theory.

III. CONCLUSION

The arguments in sections II.A.2 and 3 of the Reply (at 6–16) are based on improper new theories. Paragraphs 6–9 of the Lett Reply Declaration (Ex.1198) are offered in support of these improper new theories. See Reply, 10–13. Patent Owner respectfully requests the Board strike these portions of the Reply and Exhibit 1198 as improper under 37 C.F.R. § 42.23(b).

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on March 6, 2025, a complete and entire copy of this Patent Owner's Motion to Strike Improper Reply Argument and Evidence was provided via email to Petitioners' counsel of record as follows:

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