

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
CHARTER COMMUNICATIONS, INC.,
Petitioners,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner

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

PATENT OWNER'S SUR-REPLY

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Stephen Wicker
2002	Lex Machina Report – District Judge James Rodney Gilstrap Order Stats between Jan. 1, 2012 – April 12, 2024
2003	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 29, 2021 titled <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	Excerpt from Transcript of January 17, 2024 Hearing in Touchstream v. Google, No. W-21-cv-569 (W.D. Tex.)
2023	Lex Machina Report – District Judge James Rodney Gilstrap Order Stats between Jan. 1, 2012 – April 12, 2024, filtered for “Stay Pending PTAB”
2024	Claim Construction Order dated July 9, 2024 re Touchstream v. Comcast; Lead Case No. 2:23-cv-00059 (Member Case 2:23-cv-00062)
2025	Declaration of Stephen B. Wicker, Ph.D. In Support of Patent Owner’s Response
2026	Transcript of October 22, 2024 Deposition of David Lett
2027	Transcript of March 7, 2025 Deposition of David Lett

In the Petition, Petitioners failed to show that Mahajan discloses or renders obvious the *converting* limitations in claims 1 and 11 of the '251 Patent.¹ That failure is dispositive because Petitioners rely solely on Mahajan for those limitations.

Aware of the Petition's deficiencies, Petitioners present a new obviousness theory in their Reply. Although this theory is improper and should be stricken (see Paper 34), it is also not supported by the evidence. Petitioners fail to establish any reason to combine Mahajan with either Danciu or Aldrey to achieve the claimed invention. Petitioners therefore fail to show obviousness on any of the asserted grounds with respect to claims 1–21.

¹ The *converting* limitation of claim 1 recites: “converting, by the server system, the universal playback control command into corresponding programming code to control playing of the video content on the display device by the particular media player, wherein converting the universal playback control command includes selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player.” Ex.1101, 11:43–51. The *converting* limitation of claim 11 recites computer-readable instructions that when executed perform the same *converting* operation. *Id.*, 12:50–60.

Petitioners fail to establish obviousness for independent claim 22—which does not recite *converting*—because the Petition merely relied on arguments for claim 1 without addressing the limitations unique to claim 22. Petitioners’ Reply fails to rebut the demonstrated failures of proof identified in Patent Owner’s Response. Petitioners’ grounds therefore fail with respect to claims 22–26 too.

I. PETITIONERS FAIL TO SHOW CLAIMS 1–21 WOULD HAVE BEEN OBVIOUS

A. Petitioners Offer No Arguments in Reply to Support the Petition’s Theories

Patent Owner filed a Motion to Strike Petitioners’ new Reply theory and the arguments based on it. *See generally* Paper 34. If the Board grants Patent Owner’s Motion, it should also confirm the patentability of claims 1–21.

Patent Owner showed several reasons why the proposed combinations of Mahajan with the primary references set forth in the Petition did not render obvious the *converting* limitations. Resp., 23–43. Rather than defend their original theories, Petitioners claim in their Reply that they *meant* to argue entirely new theories. Reply, 8–10, n.2. Petitioners thus disavowed their original theories of how Mahajan would be combined with Danciu and Aldrey and did not refute the reasons why those theories fail. *Id.*, 3–18.

Because of this, Petitioners’ original theories fail for at least the reasons set forth in the Response. If the Board grants the Motion to Strike, that would leave no

obviousness theory directed to the *converting* limitations and would dispose of all Grounds asserted against claims 1–21.

B. Petitioners’ New Reply Theories Fail on the Merits

1. Regardless of architecture, Mahajan does not teach or suggest the *converting* limitations

As explained in the Patent Owner Response, Mahajan does not teach or suggest the *converting* limitations. *See* Resp., 24–34. Even Petitioners’ new theories fail to show otherwise.

Petitioners profess not to “rely on the architecture of Mahajan to disclose the claimed architecture,” but they place undue weight on this assertion. Reply, 3. Petitioners did (and continue to) rely on the “‘**techniques** for sending commands for media playback between a server and a client, **as is taught by Mahajan.**’” *Id.*, 4 (underline added) (quoting Pet., 31–32); *see id.*, 6 (similar). These techniques, as taught by Mahajan, do not teach or suggest any device *converting a universal playback control command into corresponding programming code for a particular media player on a different device*, as Petitioner now proposes. Petitioner also fails to show that the prior art teaches or suggests the “wherein” clause of the *converting* limitations.

a) *Mahajan lacks converting into code for a media player on a different device*

Implementing Mahajan’s Client RTS Media Abstraction Module 214 “as [] taught by Mahajan” (as Petitioners argue it would be) on the servers in Danciu or Aldrey would not satisfy the *converting* limitations. Reply, 4, 6. *Accord* Resp., 31–33. As taught by Mahajan, the translations of a “client” module on the alleged *server system* would produce specific commands for a “Media Platform” on that server system. See Ex.1114, [0038], [0041] (describing operations of the Client RTS Media Abstraction Module 214); Ex.2025 ¶37 (“[T]he device ultimately using the commands is the same device performing the conversion.”).

Mahajan teaches that each device (Server 202, Client 204) has a Media Platform (208, 212) and an RTS Media Abstraction Module (210, 214) with an RTS Mapping Table (302, 304). See Ex.1114, [0036]–[0037], Figs. 2–3. Server RTS Media Abstraction Module 210 can intercept commands specific to Server Media Platform 208 and use Server RTS Mapping Table 302 to “abstract” the command (*i.e.*, make it generic). See *id.*, [0036], [0038]. Client RTS Media Abstraction Module 214 uses Client RTS Mapping Table 304 to “translate the abstracted media operations into media operations ***that are specific to the client’s media platform,***” which then “execute[s] the media operations.” *Id.*, [0038] (emphasis added). Thus, Mahajan’s RTS modules only translate to or from specific commands for Media Platform(s) running on the same device as the module.

Petitioners’ other attempts to conjure the claim limitations from Mahajan’s teachings do not withstand scrutiny. For example, Petitioners argue that “Mahajan’s teachings are not strictly limited to a server-client implementation” and “may be deployed in different ways.” Reply, 10 (citing Ex.1114, [0017]–[0018]; Ex.1198 ¶¶6–7); *see also id.*, 10–11 (quoting Ex.1114, [0018], [0058], [0078]). Petitioners also argue that Mahajan’s disclosure of “a distributed computing environment” means that the “server” and “client” teachings can be applied to any remote computing devices, including cell phones. *Id.*, 12–13; *see* Ex.1198 ¶¶8–9 (similar).

None of these general statements suggest that a Client RTS Abstraction Module on a server would translate generic commands into specific commands for the Media Platform of another device that is neither a “server” nor a “client.” *See* Reply, 10–13. In Mahajan, a “distributed computing environment[]” is one in which “tasks are performed by remote processing devices that are linked through a communications network.” Ex.1114, [0018]. Mahajan describes various examples of such environments, but each device in those examples operates as a client, a server, or both. *See id.*

Whether Patent Owner or Dr. Wicker addressed Mahajan’s “distributed computing environment” disclosure therefore has no significance, no matter how much Petitioners might wish it did. *See* Reply, 11–12. Similarly, Dr. Wicker’s supposed admission “that a POSITA would be able to implement the abstraction

layer of Mahajan on a server in the network” is irrelevant. *Id.*, 12 (citing Ex.1197, 17:4–20:21). When asked if the abstraction layer would be on “a server in the network,” Dr. Wicker testified, “It’s not described that way in the application [Mahajan].” Ex.1197, 18:21–24. The disputed issue here is what the prior art teaches or suggests. *See* Resp., 23–43. A POSITA’s mere ability to implement some undisclosed feature, with no articulated reason for doing so, is irrelevant.

If that were not enough, implementing “the abstraction layer of Mahajan on a server in the network” (as Petitioners describe) would not result in the new mapping proposed in Petitioners’ Reply. The “abstraction layer” includes **both** RTS Media Abstraction Modules. *See* Ex.2025 ¶45 (Dr. Wicker: “[T]he two abstraction modules work together to create a ‘collaboration media abstraction layer 130.’”) (citing Ex.1114, [0022]); Ex.2027, 39:6–40:12, 44:10–19 (Mr. Lett reading from and agreeing with paragraph 45 of Dr. Wicker’s Declaration). Petitioners’ new theory requires part of the abstraction layer—the Server RTS Media Abstraction Module 210—be implemented on Danciu’s remote control or Aldrey’s end terminal, not “on a server in the network.”

Mahajan’s flexible use of the terms “server” and “client” also does not support Petitioners’ new theory. *See* Reply, 10–13 (citing, *e.g.*, Ex.1114, [0018]). Mahajan uses the terms “server” and “client” to “describe[] the relative relationship of the two components.” Ex.1114, [0018]. This means that two components are a “server” and

a “client” if they “have the described relationship between them” and “are doing the things that Mahajan is describing those two components doing,” as Mr. Lett admitted during his deposition. Ex.2027, 19:10–18. Hence, the disclosed functionality of Mahajan’s “server” would operate on one component, the functionality of the “client” on another.

Notwithstanding Petitioners’ Reply arguments—including its new obviousness theory—Petitioners still fail to prove that Mahajan teaches or suggests the *converting* limitations of claims 1 and 11.

b) Petitioners fail to show the prior art teaches or suggests the “wherein” clause of the converting limitations

The Petition did not show that Mahajan teaches or suggests *selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player*, as required by the “wherein” clause of the *converting* limitations. As Patent Owner explained in its Response, Mahajan’s teaching that “commands ‘may be specific to events associated with the playback of media files’” does not address the recited limitation. Resp., 32 (citing Pet., 41); see Ex.1114, [0037]. The claims require the server to *select a specific command* from among a *plurality of specific commands for different media players*, not just picking commands specific to an *event* associated with playback.

In their Reply, Petitioners now argue (for the first time) that Mahajan teaches selecting from a plurality of commands because it teaches multiple translations using the Client RTS Media Abstraction Module. *See* Reply, 15 (citing Ex.1114, [0041]). *Compare id. with* Pet., 39–42, 66–67 (failing to cite Ex.1114, [0041] for the limitation of the “wherein” clause). This is a different argument than was raised in the Petition, and the Board should not consider it. *See* 37 C.F.R. § 42.23(b). Moreover, as discussed above, Mahajan only teaches translation into specific commands for the Client Media Platforms on the same device as the Client RTS Media Abstraction Module. *See* Ex.1114, [0038], [0041]; Ex.2025 ¶37. That does not satisfy the claimed *converting*, as explained above. Because the “wherein” clause is a further limit on that same *converting*, it is also not satisfied by Mahajan’s *converting*.

2. Petitioners fail to show a reason *why* an ordinary artisan would have combined Mahajan with Danciu to achieve the claimed invention

Petitioners failed to establish a motivation to combine Mahajan with Danciu (with or without Calvert) in order to arrive at the invention of claims 1–21. *See* Resp., 34–43. The Petition failed to show *how* an ordinary artisan would have combined Mahajan’s teachings with those of Danciu to achieve the claimed invention, including the *converting* limitations of claims 1 and 11. *See id.*, 36–41. It also failed to show *why* an ordinary artisan would have been motivated to make the claimed

invention, particularly in the face of reasons not to do so disclosed in Mahajan itself. *Id.*, 40–41. The Reply does nothing to remedy these failings of the Petition. *See, supra*, § II.A. Even if the Board considers Petitioners’ improper new Reply arguments on their merits, Petitioners still fail “to explain why a skilled artisan would have sought to combine the prior art references to achieve the claimed invention.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016); *see Hamilton Beach Brands, Inc. v. f’real Foods, LLC*, 908 F.3d 1328, 1341–42, n.6 (Fed. Cir. 2018) (affirming Board’s nonobviousness judgment where the prior art disclosed the claim elements but the combination required using the claim as a roadmap).

First, Petitioners admit that Mahajan’s description of “distributed computing environments” does not provide a motivation for combining the Mahajan with the primary references. *See* Reply, 10–11, 14; *see also* Resp., 40–41. Rather, Petitioners rely on the Petition’s discussion of obviousness in connection with the *converting* limitations (*e.g.*, Pet., 41) and “paragraphs 18, 58, and 78 of Mahajan” to “merely confirm[]” that the proposed combination would have been successful. Reply, 14. Such success is contingent on a POSITA “having *already* been motivated to [combine the references] as previously explained by the Petition.” *Id.*; *see Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been*

motivated to make the combinations or modifications of prior art to arrive at the claimed invention.”) (citing *InTouch Techs., Inc. v. VGO Communc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)).

The “previously explained” motivation that Petitioners reference is the discussion at pages 31–33 of the Petition. *See* Reply, 14. In that discussion, Petitioners never articulate a reason for implementing Mahajan’s Client RTS Media Abstraction Module 214 on Danciu’s servers. *See* Pet., 31–33. Indeed, the only mention of Danciu’s servers during that discussion is in a high-level description of “Danciu’s system” as “a remote control sending commands to a controlled device via a server.” *Id.*, 31 (underline added).

The focus of the Petition’s obviousness discussion is implementing translation of commands in Danciu’s remote control. *See id.*, 32 (“Mahajan’s server-command teachings could be implemented on Danciu’s remote control.”) (underline added); *id.* (“Combining Mahajan with Danciu would have been nothing more than applying a known technique (Mahajan’s system for sending commands) to a known device (Danciu’s remote control system.”) (underline added); *id.*, 33 (arguing a POSITA “had the skills and knowledge” to incorporate “into Mahajan the ability for a remote control to translate commands from those associated with a first type of media playback application to another type of command such that they can be understood by the controlled device.”) (underline added). Consistent with that emphasis, the

Petition described the “predictable results” of the obviousness combination thus: “Danciu’s remote control would translate commands associated with a first type of media playing application to a generic format, transmit them to the controlled device, which would translate them to a command associated with a second type of media playing application for execution.” *Id.*, 32.

In this context, Petitioners proffered a motivation to combine focused on Danciu’s remote control and controlled device but that omits to mention Danciu’s servers:

A POSITA would have been motivated to apply Mahajan’s teachings of command conversion because a POSITA would have understood that Danciu’s remote control, which may be a portable device such as a cell phone, would likely employ different applications than Danciu’s controlled device, which may be a set top box or personal video recorder.

Id. (underline added). Petitioners’ rationale (and the practically identical declaration testimony of Mr. Lett) is generic in that it merely identifies a reason for using “Mahajan’s teachings of command conversion” in Danciu. *Id.*; Ex.1102 ¶162. It fails, however, “to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*” *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019) (quoting

ActiveVideo Networks, Inc. v. Verizon Communic’ns, Inc., 694 F.3d 1312, 1328 (Fed. Cir. 2012)). Hence, the purported motivation “previously explained by the Petition” (Reply, 14) fails to articulate a reason for implementing Mahajan’s Client RTS Media Abstraction Module 214 on Danciu’s servers, as Petitioners now propose.² *Id.*, 8–10.

Moreover, the testimony of Petitioners’ own expert Mr. Lett rebuts the proffered motivation to combine Mahajan with Danciu. According to Mr. Lett’s testimony, Danciu’s remote control stores “information [] specific to identify . . . ***commands associated with the media player.***” Ex.2027, 100:21–101:2 (emphasis added). This is consistent with the fact that Danciu teaches the same content from the same source (*e.g.*, YouTube) is playing on both the remote control and the

² Crediting Petitioners’ “typographical error” excuse and imputing a correction still does not cure Petitioners’ failure of proof. *See* Reply, 8 n.2. That “correction” would retroactively inject the mapping from the new Reply theory into the Petition. *See id.*, 8–10; Pet., 32. But the motivation to combine articulated in the Petition—which says nothing about implementing translation on Danciu’s server—would remain unchanged. *See* Pet., 32. Petitioners’ untimely revision to the Petition still does not cure Petitioners’ failure to articulate a motivation to combine the references in the manner of the proposed combination.

controlled device at the same time. See Ex.1102 ¶155; Ex.1112, Fig. 1; Ex.2027, 94:17–97:6. Using the YouTube example, Danciu’s remote control (*e.g.*, a mobile device) and Danciu’s controlled device (*e.g.*, a TV) would thus play the same YouTube content using two versions of the YouTube application. Ex.2027, 96:19–97:6.

Given this additional context, the fact that “Danciu’s remote control . . . would likely employ different applications than Danciu’s controlled device” would not have motivated a POSITA to incorporate translation from Mahajan, as Petitioners contend. Pet., 32. The proffered motivation ignores the similarities between the applications on the two devices, *e.g.*, both would play content from the same online library. See Ex.2027, 94:17–97:6. Moreover, a POSITA would have understood that “information specific to particular media players that can be executed on the controlled device”—such as the information “to identify . . . commands associated with the media player”—would be “conveyed to the server and subsequently to the controlled device via Danciu’s control information.” Ex.1198 ¶29; see Ex.2027, 100:21–101:2. Using this information, the remote control would be able to identify commands to the controlled device ***without the need for any translation.***

Petitioners’ deny this presents a contradiction because “the claims are not limited to sending only commands (and no other information).” Reply, 22–23. That denial makes no sense. Petitioners cite Mahajan for *converting* commands, and the

proffered motivation to combine relates to this command conversion. *See* Pet., 31–33, 39–42. If Danciu does not need command translation, this contradicts Petitioner’s obviousness arguments for the *converting* step, regardless of any other limitations the claims may recite. *See* Reply, 23.

In addition to all the foregoing deficiencies, the Board must consider evidence of “reasons not to combine” Mahajan with Danciu such that Danciu’s server incorporates Mahajan’s Client RTS Media Abstraction Module 214. *See* Resp., 41; *see also* *Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 8 F.4th 1349, 1358 (Fed. Cir. 2021) (“[T]he analysis must account for ‘reasons not to combine,’ which are facts relevant to the overall consideration of obviousness.”) (citing *Arctic Cat Inc. v. Bombardier Rec. Prods.*, 876 F.3d 1350, 1360, 1363 (Fed. Cir. 2017)). Mahajan teaches that “the RTS mapping tables 302, 304 can be simpler than other potential solutions.” Ex.1114, [0042]. For example, Mahajan explains that “server RTS mapping table 302 can be independent of the client’s media platform 212 (i.e., the server’s media table does not need to be configured based upon the client’s media platform configuration).” *Id.* Also, “[t]he same can be said of the client’s media table.” *Id.* “The client RTS mapping table 304 can [] translate the generic media operations . . . to media operations . . . specific to the media platform(s) 212 on the client.” *Id.*; *see* Ex.2025 ¶37 (“Mahajan describes a client-server arrangement wherein . . . the device ultimately using the commands is the same device performing

the conversion.”). None of the system components need to “know” what media platform(s) are running on any other system components. *See* Ex.1114, [0042].

Petitioners’ proposed combination would implement Mahajan’s Client RTS Abstraction Module 214—which includes Client RTS Mapping Table 304—on one of Danciu’s servers. *See* Reply, 8–9. But, according to Petitioner’s new Reply theory, the Client RTS Abstraction Module in this implementation would translate generic commands into commands for *particular media players* running on Danciu’s controlled devices. *Id.*, 9.

Mahajan’s teachings show that this is a reason not to combine the references as proposed in the Reply. Doing so deprives the RTS mapping tables of their simplicity; any RTS Mapping Table on Danciu’s servers would need to take account the media platforms on Danciu’s controlled devices. *See* Ex.1114, [0042]. Petitioners significantly ignore Danciu’s controlled devices when addressing this reason not to make the proposed combination. *See* Reply, 16 (mentioning only “Danciu’s remote control” and “Danciu’s server”). The controlled device is one of the three elements in Danciu’s “three-element system” that Petitioners compared to embodiments of the ’251 patent a few pages earlier. *See id.*, 4–5. Petitioners cannot just ignore Danciu’s architecture in favor of Mahajan’s when it suits them. *See id.*, 3–4 (disavowing reliance on Mahajan’s architecture).

In contrast with the new Reply theory, the implementation proposed in the Petition (*i.e.*, RTS Abstraction Modules on Danciu’s remote control and controlled device) provides the desired translation without the loss of simplicity. The Petition’s proposal would also not satisfy the claims. *See* Resp., 39–40.

Last, Petitioners’ “analogous art” arguments do not establish a motivation to combine. *See* Reply, 16–18. Analogousness is a threshold requirement for a reference “[t]o be considered within the prior art for purposes of the obviousness analysis.” *Circuit Check, Inc. v. QXQ Inc.*, 795 F.3d 1331, 1335 (Fed. Cir. 2015). It does not indicate a motivation to combine, which Petitioners failed to establish.

3. Petitioners’ Reply fails to address multiple holes in the Aldrey-Mahajan combination, and Ground 3 fails for those reasons too

As Patent Owner showed, the alleged motivation to combine Mahajan with Aldrey was substantially the same as the one proffered for the Danciu-Mahajan combinations. Resp., 41–43. Petitioners do not contend that the evidence of a motivation to combine Mahajan with Aldrey is superior in any way to that offered for the Danciu-based challenges (Grounds 1 and 2). *See* Reply, 6–16.

In fact, the motivation-to-combine evidence for Ground 3 (Aldrey-Mahajan) is even weaker than the corresponding evidence for Grounds 1 and 2 in at least two respects. First, the obviousness discussion in the Petition for Aldrey-Mahajan, like that for Danciu-Mahajan, does not discuss a role for Aldrey’s server in implementing

Mahajan’s translation teachings. *See* Pet., 67–69. But, unlike for Danciu-Mahajan, Petitioner does not even claim that this was an error. *See* Reply, 8 n.2.

Second, as previously shown, the Petition omits any showing that the combination of Mahajan with Aldrey renders obvious the limitation “wherein converting the universal playback control command includes selecting from among a plurality of specific commands, each of which represents a corresponding playback control command for a respective media player” (and the corresponding limitation of claim 11). *See* Resp., 42; Pet., 69–72. The Petition did not even address this limitation for Ground 3. Pet., 69–72. Petitioners do not dispute this failing. *See* Reply, 14–16. In addressing this limitation, Petitioners treat the Aldrey-Mahajan ground as equivalent to the Danciu-based grounds, but they are not equivalent. *See id.* Any argument that the Aldrey-Mahajan combination renders obvious the “wherein” clause of the *converting* limitation is new, and therefore improper Reply, as to Ground 3. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (affirming decision to exclude Reply that relied on new theory and new evidence).

II. THE PETITION FAILED TO ANALYZE THE PARTICULAR LIMITATIONS OF CLAIM 22, AND THE REPLY DOES NOT REMEDY THOSE DEFICIENCIES

The Petition failed to address the particular limitations of claim 22, which are distinct from the limitations of claim 1. *See* Resp., 43–52. Petitioners relied almost entirely on incorporation by reference of its claim 1 arguments for claim 22. Pet.,

54–58, 82–86. Even that incorporation failed to reference discussions of corresponding limitations and failed to address the differences between claims 1 and 22. *See Resp.*, 43–44; *Ex.2025 ¶¶63–65*. Petitioners do not seek to fix that in their Reply, nor would it have been proper under 37 C.F.R. § 42.23(b) for them to do so.

Even reading the Petition generously, Petitioners failed to show that the asserted art satisfies all the limitations of claim 22. *Resp.*, 45–52. As shown below, Petitioners still fail to show that (1) Danciu discloses the steps of *retrieving information* that includes *information identifying media players* and (2) Aldrey discloses the *obtaining* and *loading* steps.

1. Petitioners fail to show that Danciu teaches the *retrieving* steps of claim 22, including the *information identifying first and second media players*

Danciu does not disclose the *retrieving* steps of claim 22, which recite the *display device retrieving* particular information from the *server system*. *See Resp.*, 45–50. The recited information includes *first and second information that identifies a first media player for playing the first video file and a second media player different from the first media player for playing the second video file*. *Ex.1101*, 14:5–8, 14:21–25.

First, Petitioners ignore the relationship between the *retrieving* steps and the *information* that must be retrieved, treating the two as unrelated limitations. *See Reply*, 18–19 (*retrieving* argument); *id.*, 20–23 (*identifying* argument). The claims

recite which *information* must be *retrieved*. Petitioners cannot prevail by citing Danciu’s generic disclosure of requesting and receiving unspecified information. *Id.*, 19.

Likewise, Petitioners fail to show the relevance of “communications between the server and display device [being] initiated before the retrieving step occurs, when the server assigns a synchronization code to the display device.” Reply, 19 (citing Ex.1101, claim 22). If anything, this feature of claim 22 confirms that *retrieving information* requires more than just initiating communication and then receiving that information. The Applicant knew how to use different claim terms to indicate different modes of electronic communication; claim 1 recites at least three: “receiving,” “transmission,” and “retrieval.” Ex.1101, 11:28, 11:52–53. If the Applicant meant for the *retrieving* step of claim 22 to encompass “receiving, by the display device, . . . after the server assigns a synchronization code,” the claim would have used the word “receiving” and not “retrieving.” See *Augme Techs., Inc. v. Yahoo! Inc.*, 755 F.3d 1326, 1333 (Fed. Cir. 2014) (using different terms “creates a presumption” of different meanings).

Petitioners also argue that Danciu teaches *information that identifies a media player* without any effort to show that the relied-upon *information* is ever retrieved by the *display device*. See Reply, 20–23. Petitioners argue that certain “application instructions” stored on Danciu’s remote control would be “conveyed to the server

and subsequently to the controlled device via Danciu's control information." *Id.*, 22 (emphasis added) (citing Ex.1112, 13:7–11; Pet., 56–57). Petitioners also rely on Danciu's disclosure of "control information" that causes the controlled device 18 to "*move to other content.*" *Id.* (citing Ex.1112, 16:52–54; Pet., 28). These arguments ignore that Danciu's server just transmits the "control information" to the controlled device when the server receives that information from the remote control and processes it. *See* Pet., 25–27; Ex.1112, 16:56–61; Ex.2026, 43:22–45:17. Danciu does not disclose that the controlled device *retrieves* the control information from the server. *See* Ex.2025 ¶64 ("A POSITA would have understood 'retrieving,' given its ordinary and customary meaning in the art, to require an active step on the part of the display device to initiate the transfer of information through the transmission of a request for that information.").

Independent of whether the control information is *retrieved*, Petitioners fail to show any actual disclosure that the control information includes *information identifying a particular media player*. Contrary to Petitioners' contention, there would be a point to storing the "application instructions" "specific to [] particular media players [*e.g.*, YouTube, Hulu, Netflix]," even if the media players are not identified in the control information. Reply, 22. The point is to control those media players one at a time, after the *controlled device* initiates a session with the remote. Ex.1112, 13:16–31; POR 45–46; Ex.2025 ¶¶67–69, 74–75. Indeed, shortly after

describing the “application instructions” stored on the remote control, Danciu teaches using user interface 120 of the controlled device to select the media player for the controlled device to run. Ex.1112, 13:11–15.

Moreover, as noted above, Mr. Lett testified that the remote control and the controlled device would be running different versions of the same application (*e.g.*, YouTube). Ex.2027, 96:19–97:6. Petitioner is therefore incorrect that “instruct[ing] the controlled device to ‘move to other content’” requires identifying a media player associated with that content. The “other content” may be within the same video application (*e.g.*, YouTube) as the content previously played. *See* Ex.1102 ¶155; Ex.1112, Fig. 1; Ex.2027, 94:17–97:6. The remote control would only need to send the information identifying commands for the media player on the controlled device to “move to other content.” *See* Ex.2027, 100:21–101:2 (testifying the “information is specific to identify the media player ***and commands associated with the media player***”) (emphasis added). And, as shown above, Danciu discloses using the controlled device itself to select the media player. Ex.1112, 13:11–15.

2. Mahajan and Aldrey fail to teach the ***obtaining and loading steps***

Petitioners failed to show that Aldrey discloses the *display device obtaining and loading the first and second media players* after those *media players* have been *identified* by the *retrieved information*. *See* Resp., 50–51. Rather, “[a] POSITA considering Aldrey at the relevant time would have understood Aldrey to teach an

STB that operated with a media player that is preloaded.” *Id.*, 51. Petitioners fail to rebut this in their Reply.

The “remote application 209c” running on Aldrey’s STB 201 cannot be either the *first* or *second media player*, so Petitioners’ reliance on the remote application misplaced. Reply, 23–24. As Dr. Wicker explained, “Aldrey describes the ‘remote application’ as a collection of interfaces for configuring STBs, including the remote application on the STB itself.” Ex.2025 ¶85; *see* Ex.1115, [0074], Fig. 6. The fact that this interface may be “overlaid on the display of STB 201” (Reply, 24) may show that the remote application 209c is a graphical interface, but it does not show that it can be used “for playing the first [or second] video file,” as claim 22 recites. Beyond that, “remote application 209c” is not the *media player* identified by the alleged *information*. *See* Pet., 64–65. Nor is there any evidence to rebut that the “remote application 209c” would have been “preloaded” on STB 201. Resp., 51. Independent of all of these problems, claim 22 also requires a *second media player different from the first media player*, and Aldrey does not disclose a second “remote application” on the same STB. *See, e.g.*, Pet., 85–86.

In relying on Aldrey’s bare disclosure of online media content for the *obtaining* and *loading* steps, Petitioners ignore the testimony of Dr. Wicker regarding the state of web-based media distribution technology at the time. *See* Ex.2025 ¶90. Plugin media players, like the “flash player plugin,” were pre-installed

media players. *See id.* In contrast, claim 22 recites *obtaining first and second media players over the Internet* and *loading those media players* after the *media players* are identified, all as part of an “automated machine-implemented method.” Ex.1101, 13:48–50, 14:16–20, 14:34–36 (underline added). Patent Owner highlighted the absence of any “programmatically obtaining or loading of media players” in Aldrey. Resp., 51. Petitioners’ Reply does not address this deficiency in the evidence; it merely rehashes the same arguments based on Aldrey’s inadequate disclosure of internet media content. *See* Reply, 24 (citing Ex.1115, [0020]–[0021], [0025]). As Patent Owner already showed, that disclosure does not teach or suggest the programmatically obtaining and loading of media players that were previously identified in messages from the server. Resp., 51; Ex.2025 ¶¶89–90.

III. THE LEVEL OF SKILL PATENT OWNER PROPOSED IS NOT AMBIGUOUS

Petitioners’ criticisms of the level of skill in the art defined in Patent Owner’s Response are unfounded and largely irrelevant. *See* Reply, 24–26.

First, Petitioners do not appear to dispute that an ordinary artisan would have possessed a “working proficiency with network architecture, including Internet-hosted server-client systems, and with computer programming.” *Id.*, 25; Resp., 21. The prior art supports that an ordinary artisan would have possessed these proficiencies. *See Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1376 (Fed. Cir. 2012) (listing “prior art solutions to [] problems [encountered in the art]” among

factors for determining the level of ordinary skill). Also, Dr. Wicker may not have mentioned those proficiencies, but they are consistent with his opinions regarding the education and “professional experience” of an ordinary artisan. *See* Ex.2025 ¶23.

Second, there is no evidence that Dr. Wicker used the phrase “experience with[] or exposure to” to encompass merely using an “Internet-based video-delivery system.” *Id.*; *see* Reply, 25. Moreover, any latent ambiguity was removed by Dr. Wicker’s next sentence, stating that “[a] person of ordinary skill in the art would also have approximately two years of professional experience with these topics.” Ex.2025 ¶23.

Petitioners’ criticisms are mere excuses for attacking Dr. Wicker’s qualification as a person of ordinary skill in the art on the basis that Dr. Wicker has not personally designed or implemented a network-based content delivery system. Reply, 26. That attack is misleading. As Dr. Wicker testified, he “taught this material for decades,” and therefore understands it well. Ex.1197, 37:24–25.

At bottom, Petitioners challenge Dr. Wicker for being an academic and not a practicing engineer in the precise field of the ’251 patent. *See* Reply, 26. The disputed issues in this case do not warrant giving Dr. Wicker’s testimony any less weight based on the nature of his experience. Regardless, Petitioners fail to identify any closely disputed issue of fact for which any justified distinction in weight would be material. *See id.*

IV. CONCLUSION

For at least these reasons, and the reasons set forth in Patent Owner's Response, the Board should confirm the patentability of all claims of the '251 patent.

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Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Patent Owner's Sur-Reply, according to the word-processing system used to prepare the paper and not including those parts excluded by § 42.24(c), has 5,569 words, which is within the type-volume limit set by § 42.24.

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on March 19, 2025, complete and entire copies of Patent Owner's Sur-Reply and Exhibits 2026 and 2027 were served via e-mail to Petitioners' counsel of record as follows:

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