

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
CHARTER COMMUNICATIONS, INC.,
ALTICE USA, INC.,
Petitioner*,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

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

**PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO
STRIKE**

*Charter Communications, Inc. filed a petition and a motion for joinder in IPR2024-01231 and has been joined as a petitioner in this proceeding. Altice USA, Inc. filed a petition and a motion for joinder in IPR2024-01262 and has been joined as a petitioner in this proceeding.

Patent Owner (“PO”), having not argued in its Response why Mahajan’s conversion techniques implemented at Danciu’s or Aldrey’s servers would fail to meet the claims, now attempts to subvert the proceedings by filing a Motion to Strike (hereinafter “Motion”) alleging that Petitioner’s arguments were newly raised in Petitioner’s Reply. Motion, 1.¹ PTAB guidance instructs the Board that “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely,” such as when an issue is “beyond dispute” or prejudice demands the issue be resolved prior to the close of evidence. *Patent Trial and Appeal Board Consolidated Trial Practice Guide*, November 2019, 80-81.

PO’s argument is tellingly narrow. PO alleges that “[t]he Petition offered two versions of the proposed implementation.” Motion, 2. First, PO concedes the Petition argued that Mahajan’s RTS Media Abstraction Modules operate on Danciu’s Servers 24A-24N, merely alleging Petitioner failed to “specify which of Mahajan’s two RTS Media Abstraction Modules (210, 214) would operate at the alleged server systems.” Motion, 2. Second, PO (incorrectly) alleges that Petitioner argues for an alternative

¹ Though PO alleges denials for similar theories in other IPRs, those denials regarded allegedly differing Petitioner argument (IPR2024-00326, Paper 13) or “format” limitations not recited in the ’251 Patent (IPR2024-00324, Paper 19).

embodiment where “neither of Mahajan’s RTS Modules would be located on the alleged server systems.” Motion, 3. As Petitioner’s argument consistently relies on conversion at Danciu’s Servers 24A-24N, PO’s motion thus rests solely on whether Petitioner’s Reply (at 8-10) raises a “new theory” by alleging a particular RTS Media Abstraction Module resides on Danciu’s Servers.

Petitioner Raised the Arguments in its Petition

The Petition clearly set forth its reliance on Danciu’s architecture in view of Mahajan’s teachings on conversion generally (which alone is sufficient to defeat the Motion), while also specifying the locations where Danciu would be modified in view of particular RTS media abstraction modules. The combination was clear:

a POSITA would have been motivated **to implement Danciu’s system**, comprising a remote control sending commands to a controlled device via a server, **using known techniques for sending commands for media playback between a server and a client, such as is taught by Mahajan.**

Pet., 31-32 (emphasis added). Petitioner expressly stated that Mahajan’s teachings regarding the generation of genericized/universal playback commands are implemented in Danciu’s remote control, not Danciu’s server. Pet., 32 (“Mahajan’s server-command teachings [i.e., Mahajan’s server RTS Media Abstraction module] could be implemented on Danciu’s remote control”). Thus, in the combination, the remote control sends universal playback commands to Danciu’s server, rendering

obvious the step of “receiving, in the server system, one or more signals ... further including a universal playback control command.” Pet., 25-27, 38-39.² Then, regarding “[t]he RTS Media Abstraction module of the client (an API converter, **green**)” the Petition stated in the next paragraph that “it would have been obvious to a POSITA that *the* RTS Media Abstraction Module could be located on Mahajan’s client or server, or on an intermediary device.” Pet., 40-41 (emphasis added). Given this context, and the prior mapping of the RTS module of Mahajan’s server to Danciu’s remote control, the Petition was clearly referring to “[t]he RTS Media Abstraction module of the client” when it stated that “[b]ased on Mahajan’s express teachings that its system can operate in a distributed environment, it would have been obvious to a POSITA that one or more RTS Media Abstraction Modules could operate at a server, such as in [Danciu’s] Servers 24A-24N.” Pet., 40-41. This was

² Footnote 2 in Petitioner’s Reply (at 8) regarded the section of the Petition discussing where *the genericized commands were received*. Taken in context, the rest of the Petition makes clear where *the conversion from the genericized commands* (implementing the functionality of Mahajan’s client RTS Media Abstraction Module) takes place. See Pet. 6-8, 25-27, 31; Ex. 1112, 4:46-55, 16:47-67, 17:13-43, Figs. 6-7; Reply, 8.

also demonstrated by the **green** color-coding in the Petition linking the RTS Media Abstraction Module 214 of Mahajan's client 204 with Danciu's Servers 24A-24N:

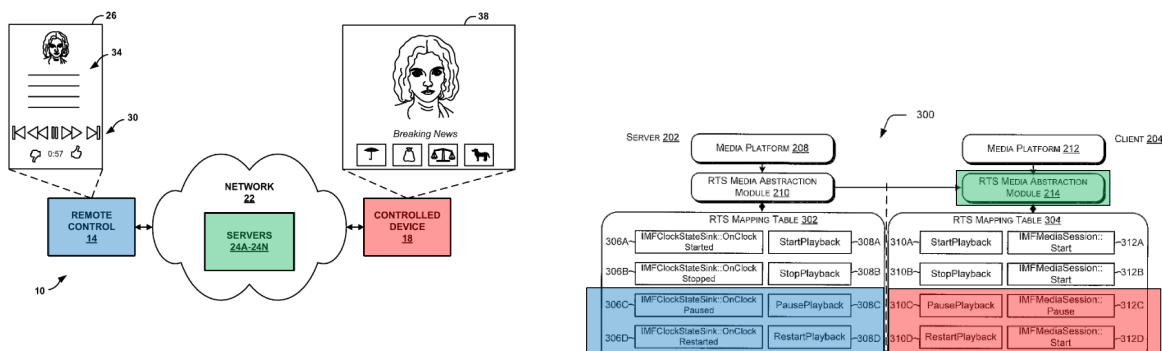


FIG. 1

Danciu, Ex. 1112, Fig. 1 (left, as annotated in Petition at 20, 26), and Mahajan, Ex. 1114, Fig. 3 (right, as annotated in Petition at 40-41)

The Petition was similarly clear as to Aldrey, stating that “A POSITA would have understood that Mahajan’s server-command teachings could be implemented on Aldrey’s end terminal remote control,” and that “it would have been obvious to a POSITA that one or more RTS Media Abstraction Modules could operate at a server, such as Aldrey’s Service Provider Network 103.” Pet., 67-68, 72.

Thus, arguments regarding modifying Danciu’s or Aldrey’s servers to convert commands based on Mahajan’s teachings were originally raised in the Petition, not introduced in Petitioner’s Reply, and the Motion should be denied.

Patent Owner Previously Acknowledged Petitioner’s Argument

The POPR shows that PO understood the Petition to contain the argument PO now alleges was raised for the first time on reply. PO acknowledged that the Petition set forth “[a]n RTS media abstraction module merely operating on one of Danciu’s

servers.” POPR, 35. Similarly, PO referenced “Petitioner’s argument (in the context of the converting step) that ‘it would have been obvious to a POSITA that one or more RTS Media Abstraction Modules could operate at a server, such as in Servers 24A-24N.’” POPR, 36; *citing* Pet., 41. PO further understood Petitioner’s argument “that Danciu’s remote control, the alleged *personal computing device*, would perform the disclosed operations of the server’s abstraction module in Mahajan.” POPR, 36; *citing* Pet., 32. Since Mahajan’s server functionality is mapped to Danciu’s remote control, Mahajan’s client functionality must be mapped to Danciu’s server. PO cannot correct its failure re-raise and flesh out its counterarguments in its Response through its Motion.

That Petitioner’s arguments are not “new” is further indicated by the ID, which explicitly references the combination in discussing a “tension” with the allegation that Mahajan alone is relied on, given that “Petitioner’s later assertion is to perform such translation at the server. See Pet. 32, 41. Nevertheless, Petitioner’s allegation that it would have been obvious to locate the command translation module at the server does address the claimed location requirement.” ID., 34. In doing so, the Board cited to Mahajan at ¶¶ 18, 22–23, 51, 58, and 78. ID., 34-35. PO, having wholly failed to address those paragraphs in its Response (and thus waiving any argument thereto), cannot now allege the issues were newly raised in Reply.

Patent Owner’s Motion to Strike should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies service on the Patent Owner, pursuant to 37 C.F.R. § 42.6(e), by electronic (e-mail) delivery of a true copy of the foregoing PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO STRIKE, to lead and back-up counsel of record for Patent Owner as follows:

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