**IN THE UNITED STATES DISTRICT COURT**
**FOR THE EASTERN DISTRICT OF TEXAS**
**MARSHALL DIVISION**

| | | |
|---|---|---|
| TOUCHSTREAM TECHNOLOGIES, INC.,<br>Plaintiff,<br>v.<br>CHARTER COMMUNICATIONS, INC. et al.,<br>Defendants. | §<br>§<br>§<br>§<br>§<br>§<br>§<br>§ | Lead Case No. 2:23-cv-00059-JRG<br>Member Case No. 2:23-cv-00062-JRG |
| TOUCHSTREAM TECHNOLOGIES, INC.,<br>Plaintiff,<br>v.<br>COMCAST CABLE COMMUNICATIONS, LLC, d/b/a XFINITY, et al.,<br>Defendants. | §<br>§<br>§<br>§<br>§<br>§<br>§<br>§ | |

**CHARTER DEFENDANTS' PRELIMINARY ELECTION OF ASSERTED PRIOR ART**

Pursuant to the Court's Order Focusing Patent Claims and Prior Art to Reduce Costs (Dkt. 84) and the Docket Control Order Court (Dkt. 71), Defendants Charter Communications, Inc., Charter Communications Operating, LLC, Time Warner Cable Enterprises LLC, Spectrum Management Holding Company, LLC, Spectrum Gulf Coast, LLC, and Charter Communications, LLC (together, "Charter"), make the following Preliminary Election of Asserted Prior Art (the "Preliminary Election").

This Preliminary Election is made subject to the Court's Order and the Local Patent Rules of this Court. It is based on information available to date to Charter upon reasonable investigation and the claims currently asserted by Plaintiff Touchstream Technologies, Inc. ("Touchstream").[1] Charter expressly reserves the right to revise this Preliminary Election based

[1] The Third Supplemental Disclosure of Asserted Claims and Infringement Contentions to Charter Defendants served by Touchstream on February 26, 2024, asserts the following claims: claims 1, 2, 5, 7, 8 and 9 of (….continued)

on further investigation, additional information obtained through discovery, and in response to any amended or supplemental allegations of infringement by Touchstream. Moreover, the claim construction process is ongoing, and Charter reserves the right to revise this Preliminary Election in light of the Court's claim construction ruling. *See* P.R. 3-6(a)(2). Finally, Charter reserves the right to revise this Preliminary Election should Touchstream dispute that any of the references below qualifies as prior art, including based on public availability or the priority date of the asserted prior art or claims.

## I. PRIOR ART REFERENCES AND SYSTEMS FOR PURPOSES OF ANTICIPATION AND OBVIOUSNESS

Charter preliminarily elects the following prior art references and systems that render the Asserted Claims invalid under 35 U.S.C. §§ 102 and/or 103:

1. U.S. Patent No. 9,276,921 entitled, "System and Method for Establishing a Communication Session," to Birkler et al. (Mar. 1, 2016) ("Birkler")
2. U.S. Patent Application Publication No. 2004/0078812 entitled, "Method and Apparatus for Acquiring Media Services Available from Content Aggregators," to Calvert (Apr. 22, 2004) ("Calvert")
3. U.S. Patent No. 9,490,998 entitled, "Network-Based Remote Control," to Danciu et al. (Nov. 8, 2016) ("Danciu")
4. U.S. Patent No. 8,918,812 entitled, "Method of Sizing an Embedded Media Player Page," to Hayward (Dec. 23, 2014) ("Hayward")
5. U.S. Patent Application Publication No. 2009/0298535 entitled, "Smart Phone as Remote Control Device," to Klein et al. (Dec. 3, 2009) ("Klein")

---

U.S. Pat. No. 8,356,251 ("the '251 patent"); claims 12, 13, 14, 16 of U.S. Pat. No. 11,048,751 ("the '751 Patent"); and claims 17, 18, 19, and 20 of U.S. Pat. No. 11,086,934 ("the '934 Patent").

6. U.S. Patent No. 10,785,027 entitled, "System and Methods for Accessing and Controlling Media Stored Remotely," to Livingston et al. (Sept. 22, 2020) ("Livingston")
7. U.S. Patent No. 9,294,800 entitled, "Intelligent Remote Control," to McMahon et al. (Mar. 22, 2016) ("McMahon")
8. U.S. Patent Application Publication No. 2011/0191677 entitled, "Methods, Systems, and Computer Program Products for Controlling Play of Media Streams," to Morris (Aug. 4, 2011) ("Morris '677")
9. U.S. Patent No. 8,396,055 entitled, "Methods and Apparatus for Enabling Media Functionality in a Content-Based Network," to Patel et al. (Mar. 12, 2013) ("Patel")
10. U.S. Patent No. 8,660,545 entitled, "Responding to a Video Request by Displaying Information on a TV Remote and Video on the TV," to Redford et al. (Feb. 25, 2014) ("Redford")
11. U.S. Patent No. 10,389,778 entitled, "Transitioning Video Between Devices Using Touch Gestures," to Smith et al. (Aug 20, 2019) ("Smith")
12. Xfinity TV Remote Mobile Application system

## II. BACKGROUND REFERENCES AND SYSTEMS

For any references and systems identified in Charter's Invalidity Contentions, but not specifically identified above, Charter reserves the right to rely on such references and systems as "evidence going to both the state of the art and the secondary considerations bearing on obviousness." *Allergan, Inc. v. Teva Pharms. USA, Inc.*, No. 2:15-CV-1455-WCB, 2017 WL 11807449, at *6 (E.D. Tex. Aug. 3, 2017). Likewise, such additional references may also provide extrinsic evidence of a motivation to combine references identified above.

Dated: April 4, 2024

Respectfully Submitted,

*/s/ Daniel Reisner*

Deron Dacus (State Bar No. 00790553)
THE DACUS FIRM, P.C.
821 ESE Loop 323, Suite 430
Tyler, TX 75701
Tel: (903) 705-1117
Fax: (903) 581-2543
ddacus@dacusfirm.com

Dina M. Hayes
Arnold & Porter Kaye Scholer LLP
70 West Madison Street, Suite 4200
Chicago, IL 60602
dina.hayes@arnoldporter.com

Daniel L. Reisner
David Benyacar
Elizabeth A. Long
Melissa Brown
Robert Stout
Arnold & Porter Kaye Scholer LLP
250 West 55th Street
New York, NY 10019
daniel.reisner@arnoldporter.com
david.benyacar@arnoldporter.com
elizabeth.long@arnoldporter.com
melissa.brown@arnoldporter.com
robert.stout@arnoldporter.com

*Counsel for Defendant Charter Communications, Inc., Charter Communications Operating, LLC, Spectrum Management Holding Company, LLC, Time Warner Cable Enterprises, LLC, Spectrum Gulf Coast LLC, Charter Communications, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on April 4, 2024 a true and correct copy of the above and foregoing document has been served on all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5(a)(3)(A).

*/s/ Daniel Reisner*

Daniel Reisner