

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00323
Patent 11,048,751 B2

Before GEORGIANNA W. BRADEN, MICHELLE N. WORMMEESTER,
and MATTHEW S. MEYERS, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Comcast Cable Communications, LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 11,048,751 B2 (Ex. 1001, “the ’751 patent”). Touchstream Technologies, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). With our authorization, Petitioner filed a preliminary Reply (Paper 11, “Prelim. Reply”), and Patent Owner filed a preliminary Sur-reply (Paper 12, “Prelim. Sur-reply”). *See* Ex. 3001.

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons that follow, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

II. BACKGROUND

A. Related Proceedings

The parties identify various related matters. Pet. i–iii; Paper 8 at 1–2 (Patent Owner’s First Amended Mandatory Notices). One related matter is *Touchstream Technologies, Inc. v. Comcast Cable Communications, LLC*, No. 2:23-cv-00062-JRG (E.D. Tex.). Pet. i; Paper 8 at 1. Petitioner also challenges claims 1–20 of the ’751 patent in IPR2024-00324, in which we institute an *inter partes* review.

B. The ’751 Patent

The ’751 patent relates to “play control of content on a display device.” Ex. 1001, 1:19–20. As an example, the ’751 patent describes “operat[ing] a television set or other display remotely from a personal

computing device, such as a mobile phone.” *Id.* at 1:37–41. To illustrate one embodiment, Figure 1 of the ’751 patent is reproduced below.

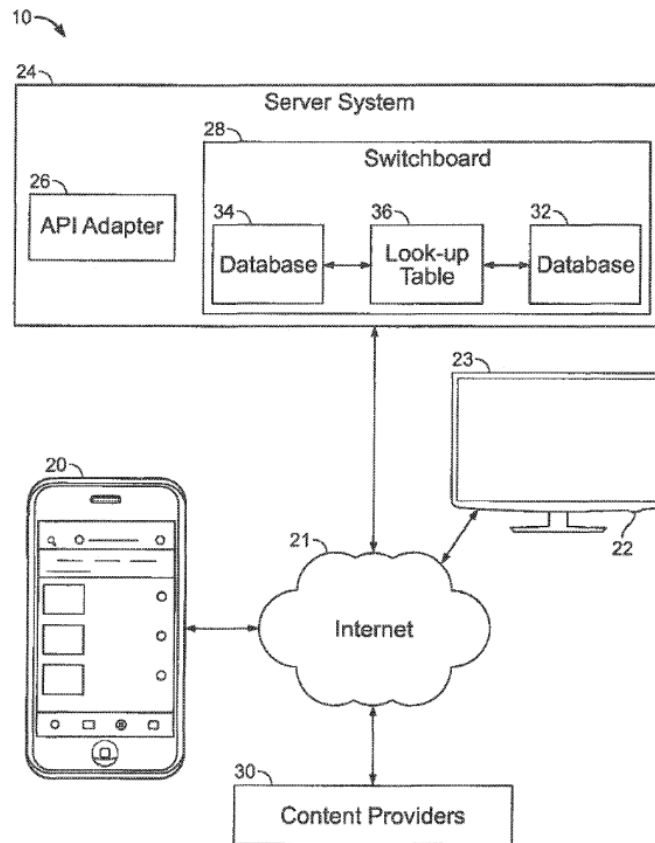


FIG. 1

Figure 1 is a block diagram of system 10, which includes personal computing device 20 and television set 22 with display 23. *Id.* at 2:53–54, 3:13–21. Personal computing device 20 displays an application or website that includes information and links to content providers 30 on Internet 21. *Id.* at 3:21–24. A user may use personal computing device 20 to select specific content to be displayed on television display 23. *Id.* at 3:26–30. In this way, personal computing device 20 may act as a controller, and television set 22 may act as a receiver that plays content selected by the user. *Id.* at 3:15–21.

When the user of personal computing device 20 selects specific content to be displayed on television display 23, personal computing device 20 sends a signal through Internet 21 to server system 24. Ex. 1001, 3:26–30. Server system 24 then sends a corresponding command signal to television set 22, which acts on a transmission code included within the signal and performs specified commands. *Id.* at 3:30–33. These commands may instruct television set 22 to access a certain content provider 30 through Internet 21, load a specific media player, load the media player-specific content (e.g., a video), and play the content on television display 23. *Id.* at 3:33–37.

The user may further use personal computing device 20 to control how the content is played on television display 23. Ex. 1001, 3:37–39. For example, the user may input play commands such as play, pause, stop, rewind, and fast forward. *Id.* at 3:51–54. These play commands also are passed from personal computing device 20, through server system 24, to television set 22. *Id.* at 3:54–56.

C. Illustrative Claim

Petitioner challenges claims 1–20 of the '751 patent, where claims 1, 12, and 17 are independent. Claim 1 is illustrative:

1. A non-transitory computer storage medium storing computer-useable instructions that, when used by a first computing device, cause the first computing device to perform operations comprising:

- obtaining a synchronization code associated with the first computing device, wherein the associated synchronization code is stored on a remote server device;

providing the synchronization code to a second computing device in communication with the remote server device, wherein the provided synchronization code causes the remote server device to store an association between the first computing device and the second computing device;

receiving, from the remote server device, a first message that includes at least one command in a first format, the first message being received based at least in part on the stored association and on a second message including at least one command in a second format having been sent from the associated second computing device;

selecting a first media player application from a plurality of media player applications based at least in part on the first format of the first message, the first media player application being selected to play a first piece of content referenced in the received first message; and

controlling how the selected first media player application plays the referenced first piece of content based on a first command of the at least one command in the first format having been included in the received first message.

Claim 12 is directed to “[a] computer-implemented method for remotely presenting various types of content.” Claim 17 is directed to “[a] content presentation device.” Both claims 12 and 17 recite similar limitations as claim 1.

D. Asserted Challenges to Patentability

Petitioner asserts the following two challenges to claims 1–20 of the ’751 patent. Pet. 8, 12–55.

Claims Challenged	35 U.S.C. §	References/Basis
1–8, 11–20	103(a) ¹	Redford, ² Bartfeld ³
1–20	103(a)	Redford, Bartfeld, Gonze ⁴

In support of its challenges, Petitioner relies on a Declaration of David B. Lett (Ex. 1002).

Patent Owner disputes Petitioner’s challenges and relies on a Declaration of Stephen B. Wicker, Ph.D. (Ex. 2001) to support its Preliminary Response.

III. DISCUSSION

A. Discretionary Denial Under 35 U.S.C. § 314(a) – Fintiv

As discussed above, the ’751 patent is the subject of a related district court proceeding. Pet. ii, 9. Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), weigh in favor of denying institution in view of the related district court litigation. Prelim. Resp. 27–39; Prelim. Sur-reply 1–4.

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the ’751 patent issued claims the benefit of priority to an application that was filed before this date, the pre-AIA version of § 103 applies.

² Redford et al., U.S. Patent No. 8,660,545 B1, issued Feb. 25, 2014 (Ex. 1005).

³ Bartfeld et al., U.S. Publ’n No. 2006/0107299 A1, published May 18, 2006 (Ex. 1018).

⁴ Gonze et al., U.S. Publ’n No. 2008/0235588 A1, published Sept. 25, 2008 (Ex. 1006).

We consider the following six factors to assess “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6.

1. Factor 1 – Likelihood of Stay

Petitioner has not yet requested a stay but represents “its intention to request a stay if this IPR is instituted.” Prelim. Reply 2. Patent Owner argues that the related district court litigation is unlikely to be stayed based on that court’s low grant rate in other cases. Prelim. Resp. 28 (citing Ex. 2002 (report on federal motion chains)). Petitioner argues that Factor 1 is neutral and that Patent Owner’s stay statistics fail to account for the timing of the motions requesting a stay. Pet. 9; Prelim. Reply 1–2.

On this record, we decline to speculate as to how the district court might rule on a motion that Petitioner has not yet filed. Thus, we determine that this factor is neutral.

2. Factor 2 – District Court Trial Date

The related district court litigation is currently scheduled for trial on October 28, 2024. Pet. 9; Prelim. Resp. 29. Patent Owner argues that this schedule is consistent with the district court’s median time-to-trial, which Patent Owner states is twenty-one months. Prelim. Resp. 29–30; *see* Ex. 2004⁵ (report on time to milestones); *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (USPTO June 21, 2022) (“Guidance Memo”)⁶ at 8–9 (providing that “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides[] for the PTAB’s consideration”). Patent Owner further argues that Factor 2 favors discretionary denial because the district court trial date is more than eight months before our final written decision would be due if we instituted in July 2024. Prelim. Resp. 29.

Petitioner does not dispute Patent Owner’s evidence regarding time-to-trial. *See generally* Prelim. Reply (addressing only Factors 1 and 4). Patent Owner’s representation of median time-to-trial of twenty-one months is consistent with the most recent available data from the judiciary.⁷ *See* Ex. 2005 (complaint filed February 17, 2023). Petitioner acknowledges that trial is scheduled for October 28, 2024, but notes that it has pending motions

⁵ Patent Owner cited Exhibit 2002, which pertains to motion disposition. Based on the context and Patent Owner’s citations in IPR2024-00324, we understand Patent Owner to be referring to Exhibit 2004.

⁶ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

⁷ Available at https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf.

to transfer. Pet. 9. According to Patent Owner, however, the district court has since denied Petitioner's transfer motions. Prelim. Resp. 30 (citing Ex. 2006 (order denying transfer motion)).

We find that the related district court litigation's trial date and the district court's median time-to-trial favor denial.

3. Factor 3 – Investment in Related District Court Litigation

Petitioner argues that “[f]actor three does not warrant denial” because the district court “has not yet begun the claim construction process and fact discovery does not close until June 2024.” Pet. 9. By Petitioner's own admission, fact discovery will have closed by the deadline for institution, and we evaluate the investment in the related district court litigation as of the time of the institution decision. *See Fintiv*, Paper 11 at 9–10. Furthermore, Patent Owner argues that expert discovery also will be closed by the deadline for institution, and substantial work on claim construction will have happened, including a claim construction hearing scheduled for May 16, 2024. Prelim. Resp. 31–32 (citing Ex. 2003 (docket order); Ex. 2007 (infringement contentions); Ex. 2009 (defendants' third supplemental disclosures); Ex. 2010 (defendants' disclosures); Ex. 2021 (attorney declaration on discovery proceedings)).

Patent Owner also argues that Petitioner filed the Petition “almost seven months after learning of the asserted claims and almost five months after serving its initial invalidity contentions,” which, according to Patent Owner, shows lack of diligence in filing the Petition. Prelim. Resp. 33–34 (emphases omitted); *see Fintiv*, Paper 11 at 11–12 (noting that the timing of

the Petition's filing relative to learning the asserted claims may be considered for Factor 3).

We agree with Patent Owner that Factor 3 favors denial. Petitioner relies only on claim construction and fact discovery, which have progressed or have been completed by now. Patent Owner shows that the related district court litigation has progressed in other aspects as well and notes Petitioner's delay in filing the Petition. Petitioner does not further address Factor 3 in its authorized preliminary Reply. *See generally* Prelim. Reply.

4. Factor 4 – Overlap of Issues

Petitioner argues that “[f]actor four strongly favors institution” because the Petition challenges all claims of the ’751 patent while only claims 12–14 and 16 are asserted in the related district court litigation. Pet. 9. Petitioner also states that it “stipulates not to pursue in the District Court any ground that utilizes the same combination of prior art references relied upon in the instituted petition.” *Id.* at 9–10 (citing Ex. 1082 (stipulation)). Petitioner's characterization of the stipulation is slightly different from the stipulation itself, which states that, if trial is instituted, Petitioner “will not pursue in [the related district court litigation] the specific grounds against the instituted patent(s) as set forth in the respective instituted *inter partes* review petition(s).” Ex. 1082, 1–2. Patent Owner argues that the “as set forth” language could be read broadly to allow Petitioner, in the related district court litigation, to rely on the same combination of prior art in a different manner than “set forth” in the Petition. Prelim. Resp. 35.

Patent Owner also argues that Charter Communications, Petitioner's co-defendant in the related district court litigation, "is pursuing almost identical invalidity defenses, including, *inter alia*, those relying on Redford, and has not agreed to be bound by any such stipulation." Prelim. Resp. 35–36. According to Patent Owner, "Petitioner and Charter's cases remain consolidated for all pretrial purposes and issues of invalidity will likely be dealt with at the same time." *Id.* at 36 (citing Ex. 2013 (order consolidating "for pretrial purposes"))).

Petitioner argues, however, that Charter is not a co-defendant but was sued separately, that the district court consolidated the cases for pretrial purposes only, and that invalidity will be a trial issue. Prelim. Reply 3–4. Petitioner also argues that Charter is not a real party in interest or privy in this proceeding and that Petitioner "cannot be held responsible for the acts of Charter." *Id.* at 4.

Patent Owner responds that it "must still prepare for and defend against the petitioned grounds in a jury trial, regardless whether the Board institutes on the Petition" because Charter is pursuing the same invalidity defenses. Prelim. Sur-reply 3.

We agree with Petitioner that Charter's invalidity defenses cannot be held against Petitioner. This is evident from the Guidance Memo, which provides that "the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB." Guidance Memo 3. This provision applies even if another defendant might pursue such grounds in parallel litigation. Petitioner can only control what it pursues in the

related district court litigation, and Petitioner's case is consolidated with Charter's case only for pretrial purposes, not for trial. Ex. 2013.

On the other hand, we agree with Patent Owner that the language in Petitioner's stipulation in Exhibit 1082 does not eliminate overlap with district court invalidity arguments. Furthermore, Petitioner's stipulation "not to pursue in the District Court any ground that utilizes the same combination of prior art references relied upon in the instituted petition" (Pet. 9–10) allows Petitioner to utilize a prior art reference that may be considered a primary reference, that is one disclosing a majority of the claim limitations, in combination with a reference that is not relied on in the Petition. This may not address adequately "concerns of inefficiency and the possibility of conflicting decisions." *See Fintiv*, Paper 11 at 12.

Finally, we agree with Petitioner that the fact that the Petition challenges claims that are not asserted in the litigation shows that there is not complete overlap. Patent Owner asserts that "Petitioner does not even attempt to show" that certain challenged-but-unasserted claims "present different issues of invalidity from the asserted claims." Prelim. Sur-reply 3. Even so, they are different claims, Petitioner challenges their patentability, and the district court will not resolve the issue. *Cf. SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) ("[I]n an inter partes review the petitioner is master of its complaint and normally entitled to judgment on all of the claims it raises . . .").

In view of the foregoing, we determine that Factor 4 weighs slightly against denial.

5. Factor 5 – Defendant in District Court

Petitioner is the defendant in the related district court case. Pet. 10; Prelim. Resp. 36. We find that this factor favors denial. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

6. Factor 6 – Other Circumstances, Including the Merits

The sixth *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny, such as the merits of the patentability challenges. *Fintiv*, Paper 11 at 14–16. Under this factor, “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability.” Guidance Memo 5. Board precedent provides that we should only consider the compelling merits standard if the first five *Fintiv* factors favor discretionary denial. *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB February 27, 2023) (precedential).

The second, third, and fifth *Fintiv* factors favor denial. The first factor is neutral, and only the fourth factor weighs against denial. Thus, we determine that the first five *Fintiv* factors favor discretionary denial, and we now assess compelling merits. *CommScope*, Paper 23 at 5 (“In circumstances where, however, the Board’s analysis of *Fintiv* factors 1–5 favors denial of institution, the Board shall then assess compelling merits.”). The compelling merits standard is met when “the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Guidance Memo 4. A challenge can only meet this standard “if it is highly likely that the petitioner

would prevail with respect to at least one challenged claim.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential) (“*OpenSky*”).

As discussed above, Petitioner asserts that claims 1–8 and 11–20 of the ’751 patent would have been obvious over Redford and Bartfeld, and that claims 1–20 would have been obvious over Redford, Bartfeld, and Gonze. Pet. 8. We have reviewed Petitioner’s challenges and Patent Owner’s arguments, and we determine that Petitioner has not met the compelling merits standard.

We focus on the disputed “message” limitations of the independent claims. Independent claim 1 recites,

the first computing device . . . receiving, from the remote server device, a first message that includes at least one command in a first format, the first message being received based . . . on a second message including at least one command in a second format having been sent from the associated second computing device.

Independent claim 12 similarly recites,

receiving, by the content presentation device and from the remote server device, a first message that includes at least one command in a first format, the first message being received based . . . on a second message including at least one command in a second format having been sent from the associated remote computing device.

Independent claim 17 also similarly recites,

at least one processor [of the content presentation device] to[] . . . receive, from the remote server device, a first message that includes at least one command in a first format, the first message being received based . . . on a second message in the second format sent from the associated remote computing device.

For these “message” limitations, Petitioner relies on its discussion of claim 1. Pet. 21–24, 48, 53. Likewise, Patent Owner raises the same arguments for these limitations. Prelim. Resp. 15–26. Accordingly, we address the language of claim 1. Our analysis for claim 1 applies to claims 12 and 17.

The “message” limitations in claim 1 require, in part, (1) a first computing device that receives a first message with a command in a first format from a remote server device, and (2) a second computing device that sends a second message with a command in a second format. Petitioner provides an annotated version of Figure 3A of Redford, reproduced below. Pet. 13.

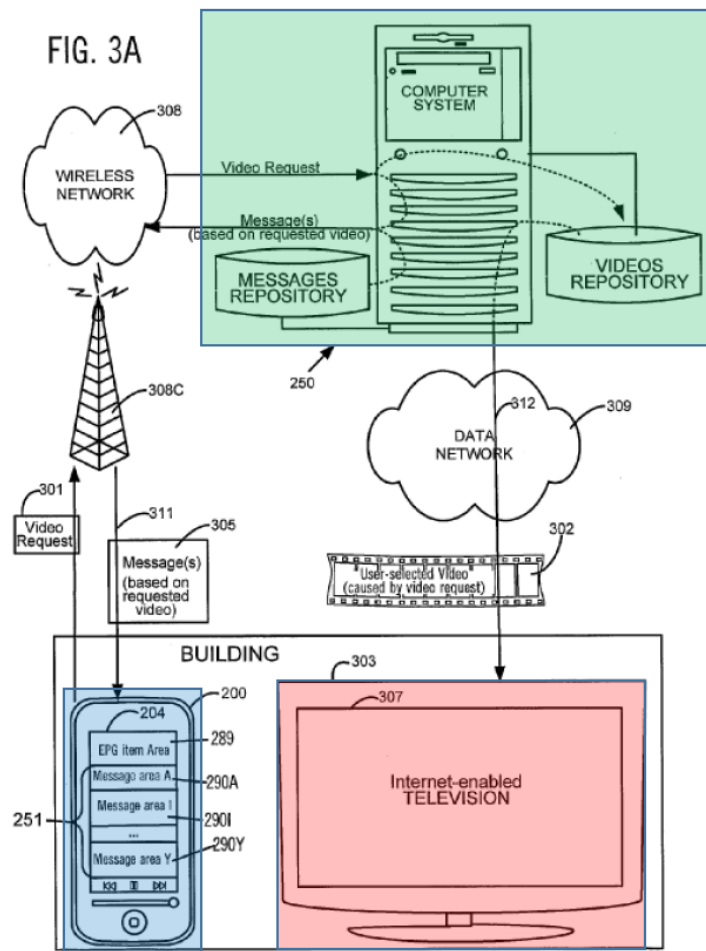


Figure 3A of Redford, as annotated by Petitioner, is a block diagram showing the flow of signals between handheld device 200, computer system 250, and television 303. *See* Ex. 1005, 3:30–34, 11:60–66.

Petitioner identifies Redford’s television 303 as a “first computing device,” Redford’s handheld device 200 as a “second computing device,” and Redford’s computer system 250 as a “remote server device.” Pet. 18–19. Thus, to satisfy the “message” limitations, Petitioner must show that television 303 receives a first message with a command in a first format from computer system 250, and that handheld device 200 sends a second message with a command in a second format.

Petitioner contends that Redford’s “handheld device 200 sends a playback control command, such as play, pause, rewind, or fast forward, to computer system 250, which thereafter sends a corresponding command (‘at least one command in a first format’) to television 303.” Pet. 21 (citing Ex. 1005, 8:5–12). As support, Petitioner asserts that these “illustrative commands from the handheld device use[] authority-compatible handheld interface software,” where, “[o]n an iPhone, the implementation library for the software is built on top of iPhone SDK which Redford calls the iLook iPhone SDK.” *Id.* at 21–22. In Redford, SDK stands for software development kit. Ex. 1005, 30:52. Petitioner asserts that “[t]he library includes a SetVideoRate command to fast forward and rewind, a PlayVideo command to play video, and . . . PauseStream and ResumeStream commands to pause and resume video.” Pet. 22 (citing Ex. 1005, 39:2–54, 40:56–41:45). According to Petitioner, a “[person of ordinary skill in the art] would have understood any of these commands sent from the handheld

device 200 to computer system 250 as ‘the at least one command in a second format.’” *Id.*

Petitioner further asserts that “Redford describes, in a set-top SDK API, a function VideoPlay (‘at least one command in a first format’), that allows video content to be played using protocols such as Real Time Streaming Protocol (RTSP), User Datagram Protocol (UDP), and Hypertext Transfer Protocol (HTTP), including media player codecs needed for decoding the content for display.” Pet. 22 (citing Ex. 1005, 40:24–29, 40:56–58, 40:66–41:2, 41:53–54). Petitioner asserts that “Redford teaches that RTSP has varying implementations depending on the content provider and service,” and, “therefore, several implementations of VideoPlay may exist to support various RTSP players.” *Id.* (citing Ex. 1005, 40:56–41:2). According to Petitioner, “[s]ince different RTSP players are supported, a [person of ordinary skill in the art] would have understood that Redford teaches that television 303 was configured to load any of the plurality of different RTSP application software for playing back the video content for a particular VideoPlay implementation.” *Id.*

To summarize its mapping of the “message” limitations to Redford’s teachings, Petitioner states,

Redford teaches a ‘PlayVideo’ command (‘at least one command in a second format’), sent from handheld device 200 to computer system 250, to play video on television 303 . . . and a ‘VideoPlay’ command (at least one command in a first format’) sent from computer system 250 and received by television 303 that allows video content to be played using protocols such as Real Time Streaming Protocol (RTSP), User Datagram Protocol (UDP) and Hypertext Transfer Protocol (HTTP), . . . including several implementations of VideoPlay existing to support various RTSP players.

Pet. 22–23. Petitioner relies on the declaration testimony of Mr. Lett. *Id.* at 21–23 (citing Ex. 1002 ¶¶ 155–159).

As additional support, Petitioner provides a truncated version of Figure 11H of Redford, reproduced below. Pet. 24.

FIG. 11H

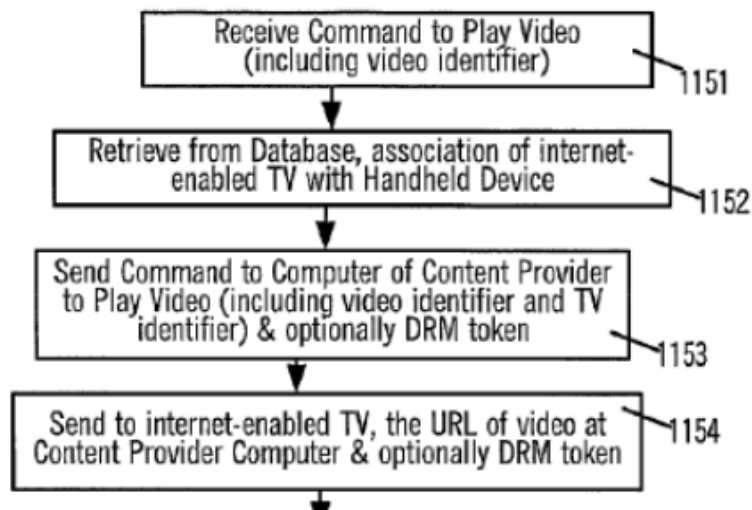


Figure 11H of Redford, as truncated by Petitioner, is a flow chart showing steps performed by authority server 282 of computer system 250. *See* Ex. 1005, 11:49–51, 36:41–52. As discussed above, Petitioner identifies Redford’s computer system 250 as a “remote server device.” Pet. 18–19. Petitioner asserts that “[u]pon receipt of a command to play video, computer system 250 retrieves association information, sends a corresponding play command to the content provider specified in the user request, and sends a URL to the television that can fetch and play the requested content from the content provider.” Pet. 23 (citing Ex. 1005, 29:4–20, 36:41–52, Figs. 8A, 8B, 11H). Petitioner relies on the declaration testimony of Mr. Lett. *Id.* (citing Ex. 1002 ¶¶ 160–161).

Patent Owner disputes certain aspects of Petitioner’s analysis. Starting with Petitioner’s reliance on Redford’s VideoPlay command as a

“command in a first format,” Patent Owner responds that “Petitioner lacks any support for its assertion that ‘a “VideoPlay” command (“at least one command in a first format”) [is] sent from computer system 250 and received by television 303.’” Prelim. Resp. 17. Patent Owner asserts that “the portion of Redford relied-upon for this very point teaches that the ‘function VideoPlay’[] is part of the ‘iLook set-top SDK API,’” which “runs on a *set-top* box device in the user’s home” as “part of Redford’s ‘internet-enabled television 303.’” *Id.* (citing Ex. 1005, 11:66–12:8, 30:23–41, 40:21–27, 40:56–41:2). Patent Owner further asserts that “Petitioner does not contend that the set-top box or internet-enabled television is the ‘remote server device,’” identifying instead “Redford’s ‘internet-enabled television 303’ as the *first computing device*.” *Id.* at 18. According to Patent Owner, “Redford merely discloses the VideoPlay function running on the alleged *first computing device*—not being received from the ‘computer system 250’ that Petitioner identifies as the *remote server device*.” *Id.*; see also *id.* at 19–20 (reiterating that VideoPlay is a function already on the television).

As to Petitioner’s contention that “several implementations of VideoPlay may exist to support various RTSP players” (Pet. 22), Patent Owner argues that “[i]t does not follow . . . that ‘computer system 250’ plays any part in implementing variations of VideoPlay, nor does Mr. Lett offer a reason why it would.” Prelim. Resp. 19–20.

Turning to Petitioner’s reliance on Redford’s Figure 11H, Patent Owner argues that the figure “does not disclose that the television receives a command from the computer system 250 (alleged to be the *remote server device*).” Prelim. Resp. 22. Referring to Figure 11H, Patent Owner asserts

that “action 1153 shows Petitioner’s alleged server system ‘[s]end[s] Command to Computer of Content Provider’ and action 1154 is ‘[s]end to internet-enabled TV, the URL of video.’” *Id.* (citing Ex. 1005, Fig. 11H). According to Patent Owner, “only one command is sent by Petitioner’s alleged *remote server device*, and that command is sent to the ‘Computer of Content Provider,’” which “is part of ‘Computer System 250’ that Petitioner asserts is the *remote server device*.” *Id.* at 22–23 (citing Ex. 1005, Fig. 8B). With respect to Redford’s teaching in Figure 11H that the television receives a URL, Patent Owner says “Petitioner does not contend that this URL is a command.” *Id.* at 23.

As noted above, our inquiry is directed to whether the Petition meets the compelling merits standard, not the “reasonable likelihood” standard of § 314(a). On this record, we agree with Patent Owner.

Petitioner points us to where Redford describes “[a]uthority-compatible set-top interface software [that] provides a common set-top API (called iLook set-top SDK API).” Pet. 22 (citing Ex. 1005, 40:24–27); Ex. 1005, 40:24–27. Petitioner highlights Redford’s teaching that “[i]n the iLook set-top SDK API, a function VideoPlay allows a video content to be played.” Pet. 22 (citing Ex. 1005, 40:56–41:2); Ex. 1005, 40:56–57. According to Petitioner, Redford’s VideoPlay function corresponds to the recited “command in a first format.” Pet. 22–23. To satisfy claim 1’s “message” limitations under this theory, Petitioner must show that Redford’s television 303 (which Petitioner identifies as a “first computing device”) receives the VideoPlay function from computer system 250 (which Petitioner identifies as a “remote server device”). *Id.*

Redford, however, teaches that its “authority-compatible set-top interface software is implemented as an implementation library specific to the circuitry in a data network interface circuit 392,” which is a part of television 303, a set-top box, or an optical disk player. Ex. 1005, 24:27–34, 30:34–41, 40:21–24. Petitioner does not point to any teaching in Redford that the authority-compatible set-top interface software can be implemented in computer system 250. Nor does Petitioner adequately explain how Redford’s television 303 receives the VideoPlay function from computer system 250, where the VideoPlay function is part of software that is implemented in television 303, a set-top box, or an optical disk player.

Moreover, Petitioner’s declarant Mr. Lett testifies in his declaration that “Redford discloses that ‘television 303 executes predetermined software,’ referred to as ‘authority-compatible set-top interface software,’ to ‘display video 302.’” Prelim. Resp. 18 (citing Ex. 1002 ¶ 122); Ex. 1002 ¶ 122 (citing Ex. 1005, 12:5–12, Fig. 2B). Mr. Lett’s testimony that television 303 executes predetermined authority-compatible set-top interface software appears to undermine Petitioner’s position that television 303 receives the VideoPlay function (which is a part of the predetermined authority-compatible set-top interface software) from computer system 250.

As to Petitioner’s further reliance on Redford’s Figure 11H, we note that Petitioner’s truncated version of the figure shows that the only items that Redford’s television 303 receives from computer system 250 are a URL of a video and a digital rights management (DRM) token. Pet. 24; *see also* Ex. 1005, 36:50–52. As Patent Owner points out, however, “Petitioner does not contend that this URL [or DRM token] is a command.” Prelim.

Resp. 23. Without further explanation, Petitioner does not sufficiently show how Figure 11H of Redford satisfies the “message” limitations of claim 1.

In view of the foregoing, we determine that Petitioner’s obviousness challenges based on Redford do not meet the compelling merits standard. Petitioner does not rely on Bartfeld or Gonze to teach the “message” limitations. *See* Pet. 14–21 (relying on Bartfeld for limitations regarding a synchronization code); *id.* at 24–36 (relying on Gonze for limitations regarding selecting and controlling a first media player application).

7. *Fintiv* Determination

On balance, the first five *Fintiv* factors favor discretionary denial, and the Petition does not meet the compelling merits standard of the Guidance Memo. Therefore, we determine that discretionary denial is appropriate in view of the related district court litigation.

B. Discretionary Denial Under 35 U.S.C. § 314(a) – Multiple Petitions

As noted above, Petitioner also challenges claims 1–20 of the ’751 patent in IPR2024-00324, and we are instituting *inter partes* review in that proceeding. The Board’s Consolidated Trial Practice Guide⁸ (“CTPG”), issued in November 2019, notes that “[t]wo or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns” and that “multiple petitions by a petitioner are not

⁸ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

necessary in the vast majority of cases.” CTPG 59. “Nonetheless, the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.*

As advised by the CTPG, Petitioner filed a paper ranking its petitions and purporting to explain differences between the petitions. Paper 3. Petitioner ranks this Petition above the petition in IPR2024-00324. *Id.* at 1. As discussed above, we do not find that the instant Petition meets the compelling merits standard, but we find that the petition in IPR2024-00324 does meet this standard for at least one claim.

Petitioner also argues that certain references are prior art under 35 U.S.C. § 102(e) that can be antedated by Patent Owner. Paper 3 at 1–2. Petitioner argues that Redford predates the ’751 patent’s earliest priority date by more than a year whereas one of the references in IPR2024-00324 only predates the ’751 by about six weeks. *Id.* at 2. As Patent Owner points out, however, Petitioner asserts a challenge in IPR2024-00324 that relies only on prior art under § 102(b), which cannot be predated. Paper 10 at 2. Thus, the petition in IPR2024-00324 also provides an advantage in the event of a priority dispute.

Petitioner also generally asserts that “[e]ach of the primary prior art grounds have different strengths with respect to various different claims,” but Petitioner does not provide sufficient explanation for this assertion. Paper 3 at 2. Petitioner’s explanation does not provide “a succinct

explanation of the differences between the petitions” and “why the issues addressed by the differences are material.” *See* CTPG 59–60.

The record before us does not support the need for two petitions. Patent Owner has asserted only four claims of the ’751 patent in the related district court case (Paper 10 at 4), so this is not a situation in which “the patent owner has asserted a large number of claims in litigation.” *See* CTPG 59. Nor has Petitioner shown why this Petition would be preferable to a petition that has a ground relying only on § 102(b) art, as in IPR2024-00324, should there arise a priority dispute.

Thus, in addition to our reasons for denying based on *Fintiv*, we determine that discretionary denial is appropriate here given the institution of *inter partes* review in IPR2024-00324.

IV. CONCLUSION

For the foregoing reasons, we exercise discretion to deny institution under 35 U.S.C. § 314(a).

V. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* and no trial is instituted.

IPR2024-00323
Patent 11,048,751 B2

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