

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,
v.
TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00324
U.S. Patent No. 11,048,751

**PATENT OWNER'S PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. § 42.107**

TABLE OF CONTENTS

I.	The '751 Patent	4
A.	Claims.....	4
B.	Specification.....	6
C.	Prosecution History	11
II.	Petitioner's Grounds and Cited References	12
A.	Danciu.....	12
B.	Mahajan	14
C.	Calvert	16
D.	Aldrey	17
III.	Level of Ordinary Skill in the Art.....	19
IV.	Claim Construction	19
V.	Petitioner Has Not Shown a Reasonable Likelihood of Prevailing on Any Claim.....	19
A.	Mahajan Does Not Disclose the Limitations Relating to <i>First and Second Messages</i> and the <i>First and Second Formats</i> of the <i>Commands</i> in the <i>Recited Messages</i>	20
B.	The Proposed Danciu-Mahajan Combinations Do Not Render the <i>Command Format</i> Limitations Obvious (Grounds A–B)	27
1.	Danciu does not disclose using multiple different <i>formats</i> for <i>commands</i> in its messaging	28
2.	Danciu does not disclose <i>selecting a first media player application from a plurality of media player applications based at least in part on the first format</i>	29
3.	Petitioner fails to provide a rationale for combining the teachings of Danciu and Mahajan to arrive at the claimed invention, as required by law	32
4.	Calvert does not provide the missing limitations to Danciu-Mahajan.....	34
C.	Aldrey in View of Mahajan Does Not Teach or Render Obvious the Limitations of the '751 Patent	35
D.	Petitioner Relies on the Same Arguments for Every Claim.....	37
VI.	The Board Should Deny The Petition Under § 325(d) Because the Office Previously Considered Mahajan and Danciu During Prosecution	38

A.	The <i>Becton, Dickinson</i> Factors Favor Denying Institution under 35 U.S.C. § 325(d).....	40
VII.	The Board Should Exercise Discretion Under § 314(a) to Deny the Petition.....	43
B.	<i>Factor 1</i> : Likelihood of Stay.....	44
C.	<i>Factor 2</i> : Trial Date Relative to Final Written Decision Due Date.....	45
D.	<i>Factor 3</i> : Investment in Trial Court Proceedings	47
E.	<i>Factor 4</i> : Overlap of Issues.....	50
F.	<i>Factor 5</i> : Same Parties	52
G.	<i>Factor 6</i> : Other Considerations.....	53
H.	Combined Factors.....	54
VIII.	Conclusion	55

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>ActiveVideo Networks, Inc. v. Verizon Communc'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012)	33
<i>Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (Feb. 13, 2020)	41
<i>Apple Inc. v. Fintiv Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	44, 50, 54
<i>Apple Inc. v. Seven Networks, LLC</i> , IPR2020-00156, Paper 10 (PTAB June 15, 2020)	45
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (Dec. 15, 2017)	40, 41
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	36
<i>Dolby Labs., Inc. v. Intertrust Techs. Corp.</i> , IPR2020-01106, Paper 12 (PTAB Jan. 5, 2021)	54
<i>Fintiv</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020)	52
<i>Google, LLC. v. Touchstream Technologies, Inc.</i> , IPR2022-00795 (PTAB Sep. 5, 2022)	53, 54
<i>InTouch Techs., Inc. v. VGo Communc'ns, Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014)	33
<i>NHK Spring Co. Ltd. v. Intri-Plex Techs. Inc.</i> , IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)	44
<i>Personal Web Techs., LLC v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	36

<i>Sand Revolution II, LLC v. Cont’l Intermodal Grp. Trucking LLC</i> , IPR2019-01393, Paper 24 (PTAB June 16, 2020)	44, 51
<i>SAS Inst., Inc. v. ComplementSoft, LLC</i> , 825 F.3d 1341 (Fed. Cir. 2016) (Newman, J., dissenting-in-part), <i>rev’d in part by SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	43
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)	3, 52
<i>Touchstream Techs. Inc. v. Google, LLC</i> , 6-21-cv-00569 (W.D. Tex., Jun. 4, 2021), Dkt. 262	41
<i>Verizon Bus. Network Servs. LLC v. Huawei Techs. Co. Ltd.</i> , IPR2020-01292, Paper 13 (PTAB Jan. 25, 2021)	<i>passim</i>
<i>William Wesley Carnes, Sr., Inc. v. Seaboard International, Inc.</i> , IPR2019-00133, Paper 10 (PTAB May 8, 2019)	36

Statutes

35 U.S.C. § 314(a)	<i>passim</i>
35 U.S.C. §§ 314(a) & 325(d)	3
35 U.S.C. §§ 314(b), 316(a)(11)	45
35 U.S.C. § 315(e)(2)	52
35 U.S.C. § 325(d)	2, 38, 40, 43

Other Authorities

37 C.F.R. § 42.100(c)	45
U.S. Patent No. 8,904,289	4
U.S. Patent No. 9,490,998	12

TABLE OF EXHIBIS

Exhibit No.	Description
2001	Request for an Extension of Time dated May 9, 2019 re Reply to Office Action of 01/08/2019 ('751 Remarks)
2002	Lex Machina Report – District Judge James Rodney Gilstrap Order Stats between Jan. 1, 2012 – April 12, 2024
2003	2:23-cv-00060 (E.D. Tex. 2023), 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 159 (Order Denying Transfer)
2007	Touchstream's Disclosure of Asserted Claims and First Supplemental Infringement Contentions and Accompanying Document Production to Comcast Defendants' dated May 26, 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 Eckert
2022	Post-Trial Motions Hearing Transcript (Excerpt) dated January 3, 2024 re <i>Touchstream v. Google</i> case

The Petition does not show a reasonable likelihood of success on the merits, and the Board should therefore deny the Petition. The Board should also exercise its discretion to deny institution for multiple reasons.

On the merits, for every asserted Ground, Petitioner relies on the same secondary reference—Mahajan—for translating or converting a command from *second format* into a *first format* that is then used to select a *first media player application from a plurality of media player applications*. But Mahajan’s architecture and messaging differ from what the claims recite, and the alleged first format in Mahajan is generic and incapable of being used for selecting a media player. Therefore neither Mahajan nor any primary reference teaches this translation step. Specifically, the claims require “receiving, from the remote server device, a first message that includes at least one command in a first format ... based at least in part on ... a second message including at least one command in a second format” before “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.” Mahajan simply does not disclose this step. First, the alleged conversion of universal commands in Mahajan is not performed by Mahajan’s server, but rather by its client (*i.e.*, the device that plays the media content). Second, Mahajan has it backwards: Mahajan’s server outputs “generic commands,” which cannot correspond to the *first format* that is later used to select a specific media player application.

Independent of Mahajan's fatal flaws, the Petition also fails for its reliance on Danciu. For instance, the Danciu reference only teaches use of *a single media player*, while the claims recite "selecting a first media player application *from a plurality of media player applications*." This fundamental concept is entirely absent from Danciu.

Using its discretion under § 325(d), the Board should deny the Petition because the same or substantially the same prior art has been thoroughly considered and rejected. **First**, Mahajan was considered by the Examiner during prosecution of the '751 Patent, and for the same reasons asserted here. Nonetheless, the '751 Patent was allowed in view of Mahajan. Next, Danciu describes the YouTube Leanback system, which the Examiner expressly considered before allowing the '751 patent's claims to issue. There is no basis to conclude the Office made an error in that allowance. The Petition relies on art that has been considered and found wanting by both the Office and a federal jury.

Further, using its discretion under § 314, the Board should deny the Petition because institution would needlessly multiply litigation. Petitioner waited *seven months* to file its Petition. Because of that delay, the related district court proceedings are only 6 months from trial, as of this Preliminary Response. If instituted, an IPR might not reach final written decision until nine months after the district court trial. Further, Petitioner's stipulation does not alleviate the burden of duplicative

litigation: instead of agreeing to a *Sotera* stipulation, equal in scope to the estoppel under § 315(e), Petitioner commits only to “not pursue in [District Court] the specific grounds against the instituted patent(s) as set forth in the respective instituted inter partes review petition(s).” Ex.2012, 2.

Because of this, Patent Owner continues to invest significant resources litigating validity in District Court. Indeed, Petitioner maintains 12 invalidity theories spanning over 500 pages—and even maintains its Danciu prior art theories at the District Court. This Petition thus represents a second bite-at-the-apple for Petitioner on substantially the same art asserted in district court.

There will be a trial on invalidity in the district court *eight months* before this IPR is finally decided. Petitioner refuses to be constrained by estoppel, and the parties will not be able to avoid the burden of litigating validity in the trial court. Institution will waste Board resources on duplicative litigation, and Petitioner will be the sole beneficiary because it attempts to preserve a second bite at invalidity. This wastes public and private resources.

For these reasons, as well as those described below, the Board should deny institution under 35 U.S.C. §§ 314(a) & 325(d), both on the merits and in the exercise of its sound discretion.

I. THE '751 PATENT

The '751 Patent is titled “Play Control of Content on a Display Device,” and issued on June 29, 2021, from U.S. Patent Application No. 15/687,249. Ex.1101 (cover). It generally relates to methods for presenting and controlling media content using a *display device*, a *server system*, and a *personal computing device*. *See id.* The application that matured into the '751 Patent was filed August 25, 2017, and claims priority to an earlier utility application (filed June 10, 2011) that issued as U.S. Patent No. 8,904,289 (the “'289 Patent”). *Id.* The '751 Patent also claims priority to an earlier provisional application (filed April 21, 2011). *Id.* The '751 Patent Names David Strober as its sole inventor and Touchstream Technologies, Inc. as the assignee. *Id.*

A. Claims

The '751 Patent has 20 claims, of which three—claims 1, 12, and 17—are independent. Independent Claim 1 recites:

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.

Ex. 1101, 11:49–12:11.

Independent claim 12 contains a few differences from claim 1. First, it claims a method rather than a non-transitory computer storage medium. Ex. 1101, 11:49, 12:64. Second, claim 12 recites a *content presentation device* and *remote computing device* rather than the *first computing device* and *second computing device* of claim 1. *Id.*, 13:3–9. Claim 17 is similar to claims 1 and 12, but is from the perspective of the content presentation device it claims. *Id.*, 14:6–35.

B. Specification

The '751 Patent discloses various embodiments to illustrate how the invention allows a user to locate content (*e.g.*, video content) on a personal computing device, like a mobile phone, and cause playback of that content on a second device (*e.g.*, a television set) or other display device.

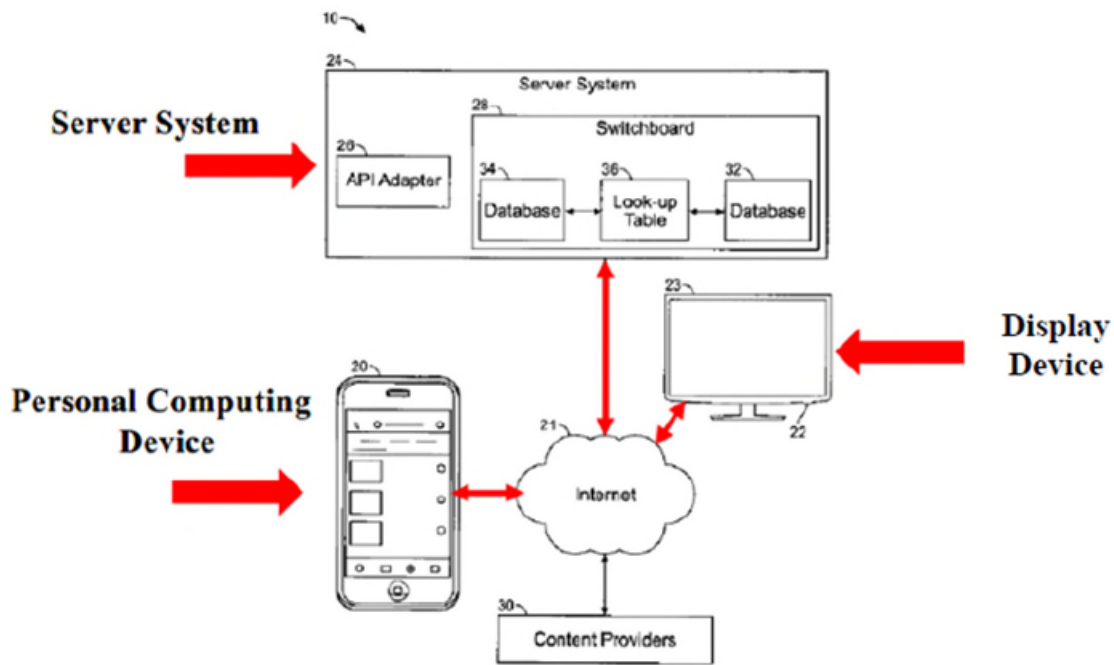


FIG. 1

Ex. 1101, Fig. 1 (annotated)

Figure 1 (reproduced above in annotated form) depicts an overview of the system according to certain embodiments. Ex. 1101, 2:53–54. As shown, the mobile device, display device (*e.g.*, television set with a display), and server system of this embodiment are connected to the Internet.¹ *Id.* 3:13–15. The personal computing device (here, mobile device) acts as a controller, locating and selecting content via

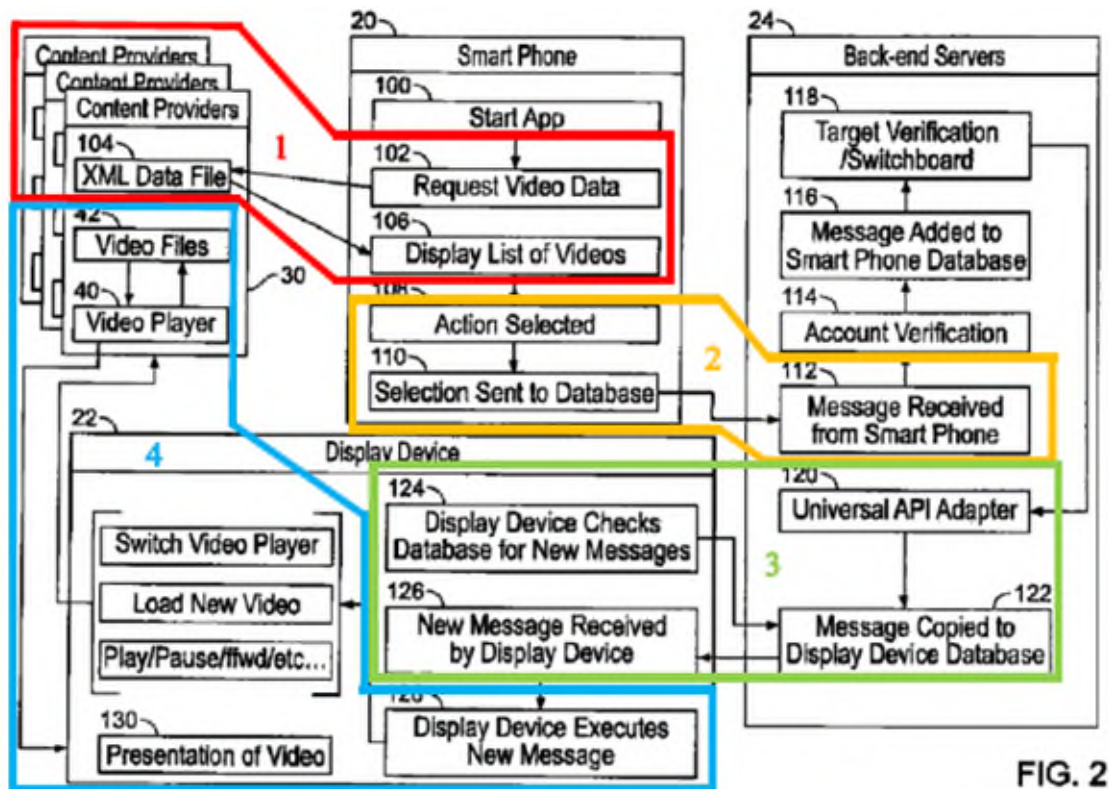
¹ The claims refer to a “second” or “remote computing device” that corresponds to the specification’s personal computing device, a “content presentation device” or “first computing device” that corresponds to the display device, and a “remote server device” that corresponds to the server system.

the Internet and sending commands that instruct the television set to obtain the selected content from the Internet and present the content. *See id.*, 3:15–44. In one embodiment, a mobile phone sends messages to a server system when a user selects content and requests that it be displayed on the television set. *Id.* 3:26–30. The television set “is operable to link back to a server system 24 from which the television set receives commands.” *Id.*, 3:24–26. The server system may send commands instructing the television set, in some embodiments, “to access a content provider 30 through the Internet 21, load a specific media player, load the media player-specific content (e.g., a video) and play the content on the television display 23. *Id.*, 3:33–37.

For the television set to present the selected content, a user must have already established a connection between the mobile phone and the television set. *See id.*, 5:15-24. For certain embodiments, establishing that connection involves a “synchronization code” (*e.g.*, a unique identifier) that identifies the display device, *e.g.*, television set. *Id.*, 5:25-27, 5:31-33. For example, the user may run software on the display device that connects it to the server system. *See id.*, 7:37-43. Upon connection, the server system may assign the television set a synchronization code (or unique identifier), which in some embodiments may then appear on the television set display (*e.g.*, as text or a QR code). *See id.*, 5:33-39, 5:44-47, 7:43-45. The user enters the synchronization code (or scans it, if a QR code is used) using the mobile

phone, which then sends the synchronization code to the server system in a message. *See id.*, 5:33-39, 5:44-47, 7:45-52. The server then establishes a connection between the mobile phone and the television set that the synchronization code identifies. *Id.*, 5:50-58, 7:52-55.

When there is an established connection with the television set or other display device, the mobile phone, display device, server system, and content providers send and receive messages and information to and from each other. Figure 2 (reproduced below in annotated form) illustrates how this works in certain embodiments, and the following description references the annotations.



Ex. 1101 (Fig. 2, annotated)

(1) Using the Internet, the mobile phone 20 can retrieve information (*e.g.*, XML data files) about content (*e.g.*, video) from content providers and can display information to a user. *See id.*, 4:11-38. (2) The user may select an action to be performed (*e.g.*, play a selected video on a selected display device), which causes the phone to send a message to the server system. *See id.*, 4:39-45. In embodiments, the message “contains a transmission code that include data regarding the user information ... the secondary display it wants to connect to ... the location and name of the media player for the selected video, the command (*e.g.*, play, pause, rewind, etc.), and the video file to be acted upon.” *Id.*, 4:45-51; *see id.*, Fig. 3 (depicting a possible transmission code format).

Because different media players may require different programming codes (*e.g.*, JavaScript commands), the server system 24 loads protocols for the particular media player identified by mobile phone 20. *Id.*, 6:5-20. (3) Using these protocols, the server system converts an incoming universal command (*e.g.*, play, pause, etc.) “into the correct JavaScript (or other programming) code used by the target device 22 to control the specific player (block 120).” *Id.*, 6:10-14, 6:16-22; *see id.*, 6:26-37, 7:4-15. The correct programming code replaces the universal command in the message, which the display device may then retrieve from the server system. *See id.*, 6:22-25, 6:38-48. (4) The display device executes the message from the server, retrieving the identified content, retrieving and/or loading the particular media

player identified (if not already stored and loaded on the display device), and executing the programming code that corresponds to the universal command. *See id.*, 3:33-37, 6:49-65, 7:13-15.

C. Prosecution History

The claims of the '751 Patent issued after rigorous examination during which claims 1 and 4-20 were twice rejected as anticipated by Morris (US 2012/0130971), while dependent claims 2 and 3 were twice rejected as obvious over Morris in view of Mahajan (US 2009/0248802). *See Ex. 1104*, 63-74, 176-188. In response, Applicant argued:

“Mahajan recited ‘[c]ollaboration sessions can provide a remotng experience between a client computer (hereinafter, “client”) and a server computer (hereinafter, “server”)’ and that ‘[c]ollaboration can involve representing a portion, or all, of the server’s graphical user-interface (GUI) on *the* client.’ As such, by virtue of the described embodiments of Mahajan, Mahajan simply cannot teach one or more computing devices that perform operations including, among other things, receiving, *from the remote server device*, a first message that includes at least one command in a first format, wherein the first message is received based at least in part on a second message including at least one command in a second

format having been sent *from the associated computing device.*”

See Ex. 1104, 168-174 (emphasis in original). Applicant ultimately amended the claims to add limitations regarding *inter alia*, obtaining and providing a synchronization code and selecting a first media player from a plurality of media players based on the first format of the first message. See Ex. 1104, 234-241.

II. PETITIONER’S GROUNDS AND CITED REFERENCES

Petitioner asserts the challenged claims would have been obvious over three (3) grounds: Petitioner argues claims 1-20 are obvious over Danciu² in view of Mahajan³ (Ground A); Danciu in view of Mahajan and Calvert⁴ (Ground B); and Aldrey⁵ in view of Mahajan (Ground C).

A. Danciu

U.S. Patent No. 9,490,998 to Danciu (Ex. 1112) was filed March 7, 2011, and purports to claim priority to U.S. Provisional Application No. 61/411,386, filed November 8, 2010. Danciu is assigned on its face to Google Inc., who claims Danciu spawned from and describes Google’s YouTube Remote and YouTube Leanback

² U.S. Patent No. 9,490,998 (Ex. 1112)

³ U.S. Published Application, No. 2009/0248802 (Ex. 1114)

⁴ U.S. Published Application, No. 2004/0078812 (Ex. 1111)

⁵ U.S. Published Application, No. 2009/0172757 (Ex. 1115)

products that were considered by the examiner during prosecution of the '751 Patent.
Ex.1104, 544.

Danciu discloses a remote control 14 (blue) that is external to the servers 24A–24N (green), which receive messages including a remote control identifier and control information, and sends a message to a controlled device 18 (red) to control its operation. Ex. 1112, 1:39–50, 4:58–67, Figs. 1, 6.

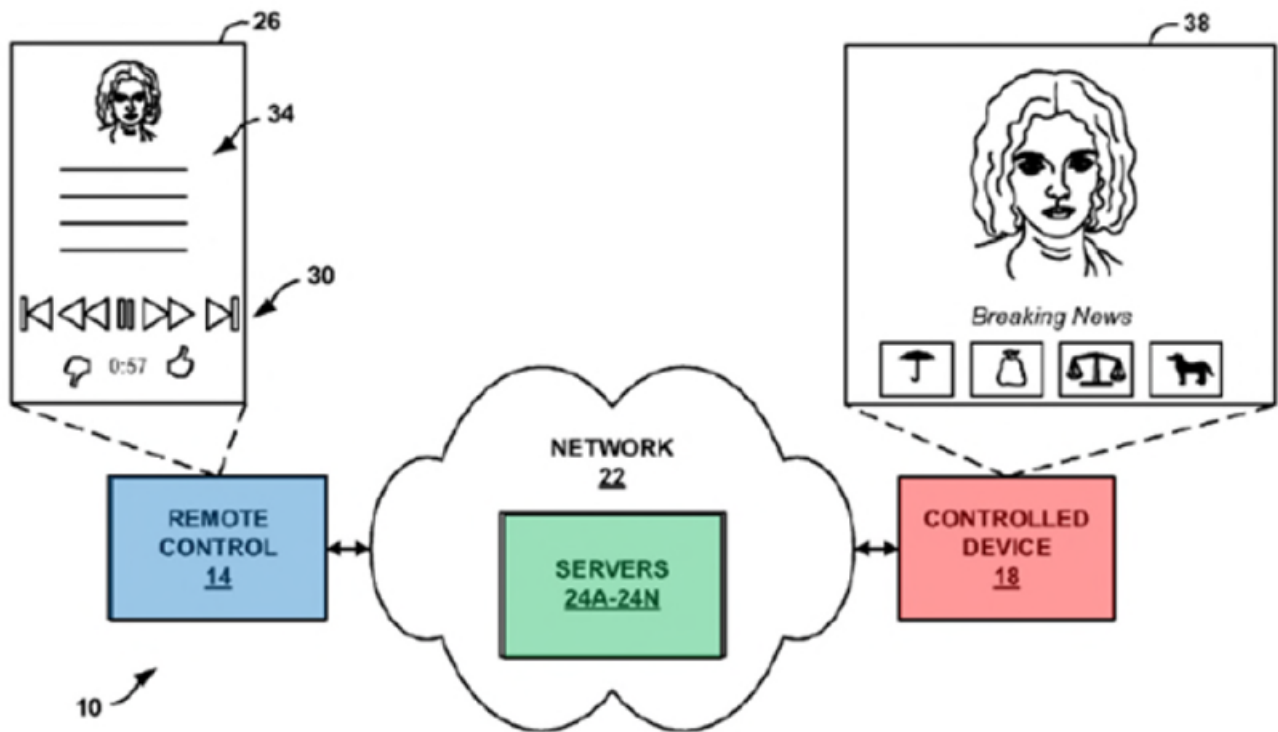


FIG. 1

Ex. 1112, Fig. 1 (annotated by Petitioner)

B. Mahajan

The Mahajan reference is a published U.S. Patent Application describing systems and methods for managing multimedia operations in remote sessions. Ex. 1114. It envisions a client and a server, each with an “RTS Media Abstraction Module.” Ex.1114, [0025].

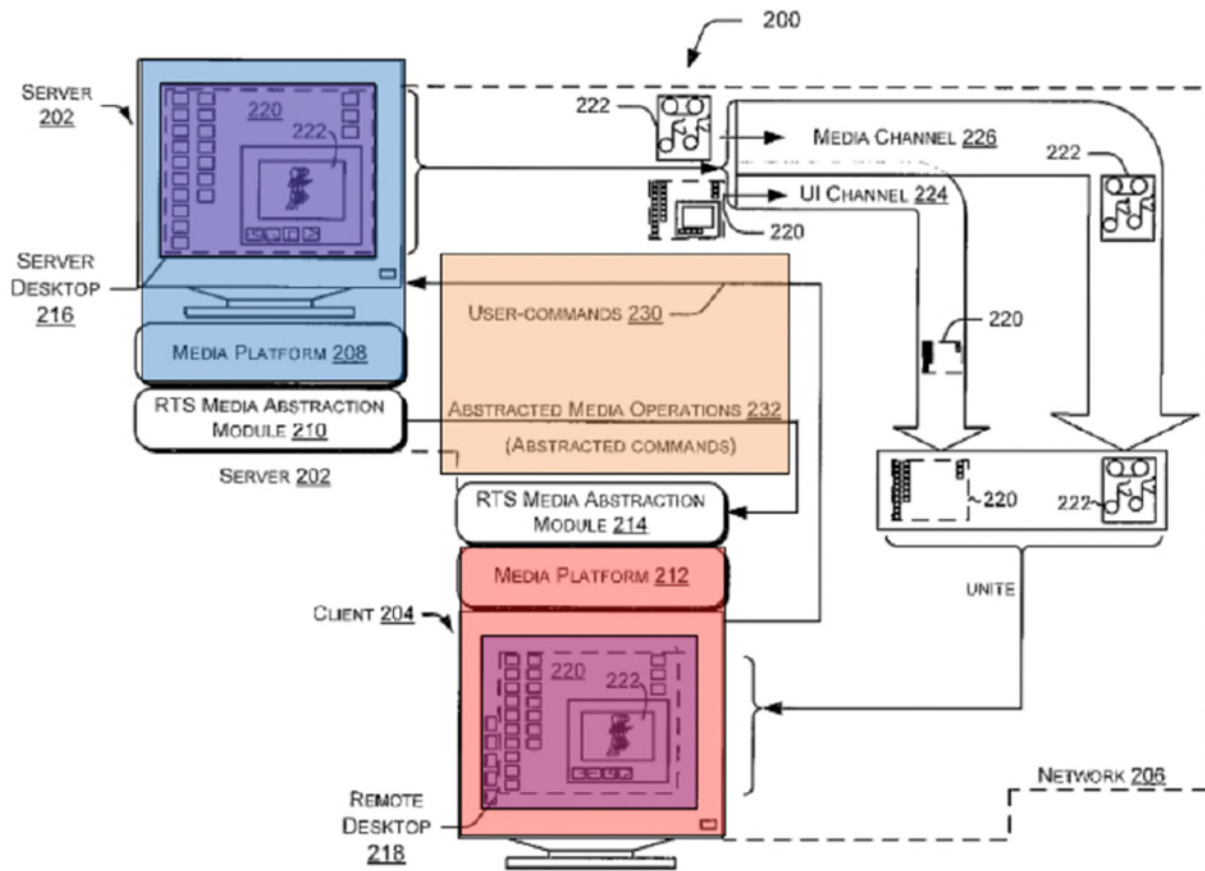


Fig. 2

Ex. 1114, Fig. 2 (annotated by Petitioner)

Mahajan teaches a “client-server collaboration session” wherein a client can use aspects of the server remotely. For example, the client uses the server’s graphical interface (220), which is rendered within the client’s graphical user interface (shown

in “remote desktop 218”). *See* Ex. 1114, [0011], [0025]–[0026], Fig. 2. The client 204 can also display media (shown in “media component 222”) from the server 202. *E.g., id.*, [0026]. Because the client and the server may use different “media platforms,” Mahajan describes a protocol for translating commands specific to the server platform into commands specific to the client platform. *See id.*, [0035]–[0042], Fig. 3.

Using this protocol, the user, via client 204, first sends platform-specific commands for the server’s platform from the client to the server. *See id.*, [0035]; *see also id.*, [0037] (“[T]he server’s [remote terminal session (RTS)] media abstraction module 210 can receive media commands that are specific to the server’s media platform.”), Fig. 3. The server, using this RTS module, then translates the platform-specific commands to “generic or abstract commands.” *See id.*, [0038]. The server then sends these commands to the client, which re-translates them into commands specific to the client’s media platform. *See id.*

As described by Petitioner, Mahajan employs a five-step process to translate and re-translate commands within Mahajan’s “client-server collaboration session wherein a user may enter commands (orange) on Mahajan’s server (blue) for controlling content (purple) that is playing on a client device (red).” Pet. at 12–13.

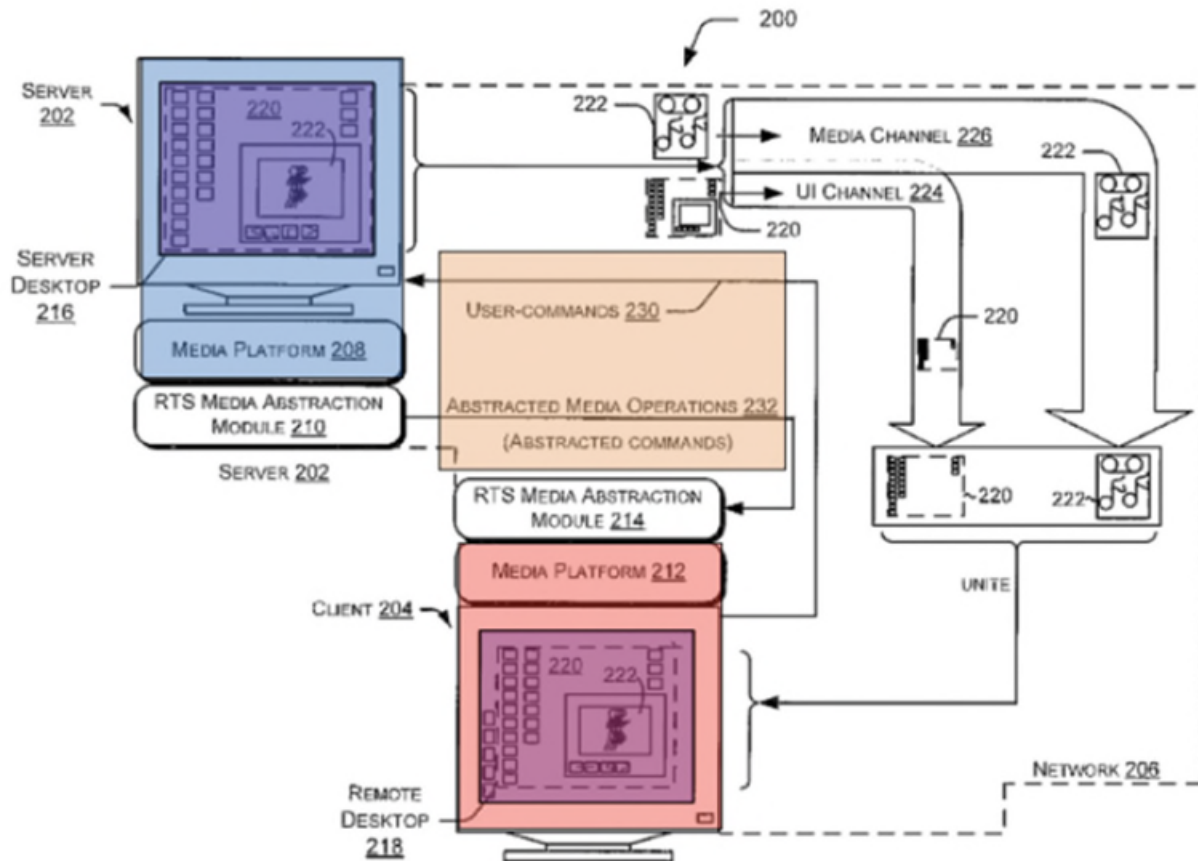
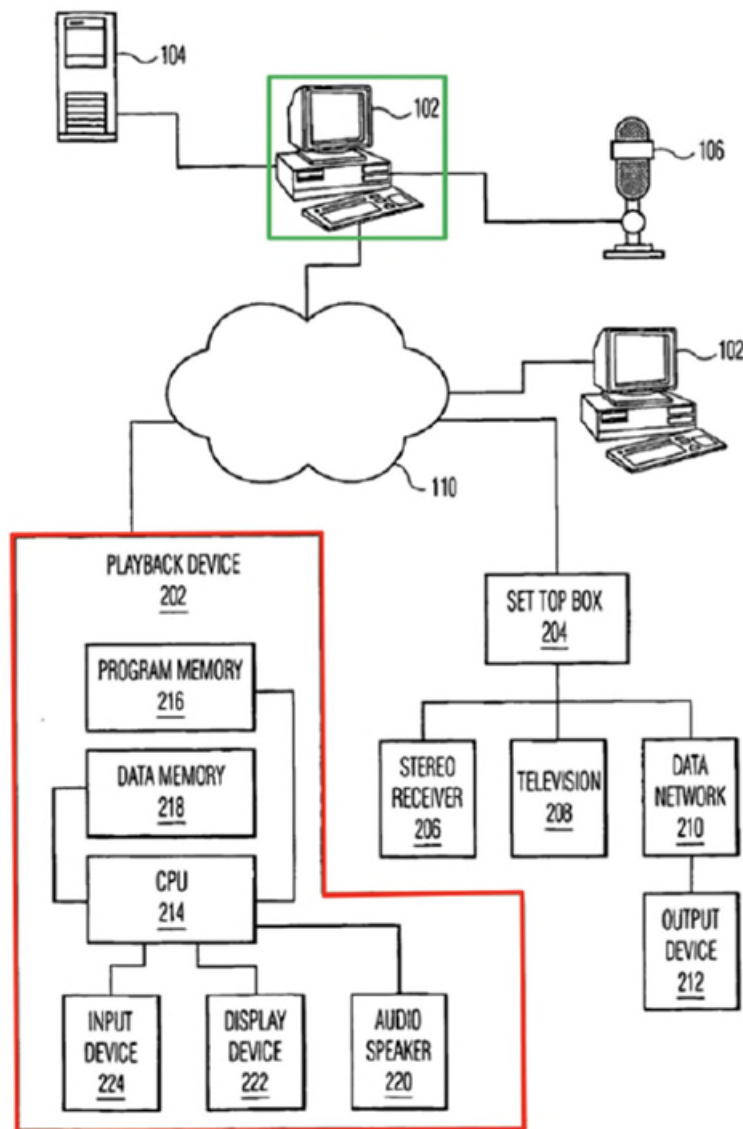


Fig. 2

Ex. 1114, Fig. 2 (annotated by Petitioner)

C. Calvert

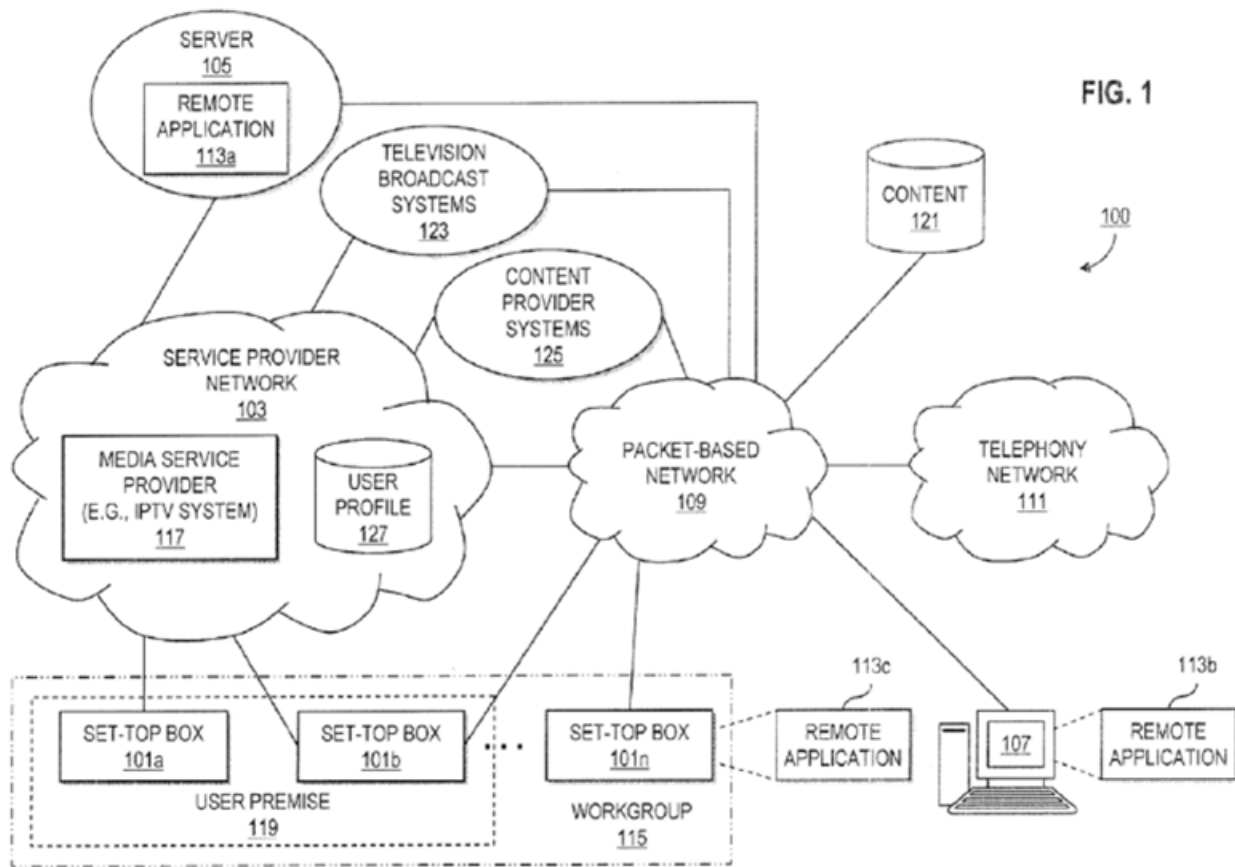
The Calvert reference is a U.S. Patent application disclosing a method and apparatus for acquiring media services available from content aggregators. It describes media players embedded in “document object model” structure and requested from aggregators (including codecs), wherein the embedded data structure comprises media service menus, locations, and types of media. Ex. 1111, [0031]. No remote control is discussed, except in the unrelated context of a traditional television remote. [0064].



Ex. 1111, Fig. 2 (annotated by Petitioner).

D. Aldrey

The Aldrey reference is a U.S. Patent Application that teaches a method and apparatus for remote set top box management. Ex. 1114. It envisions a remote application by which a user may adjust configuration settings on their set top box.



Ex. 1114, Fig. 1

For instance, a user may adjust parental controls or available channel information:

“remote application 209 may generate one or more control commands, transmit those commands to STBs 101(a)-101n, wherein the devices may be configured according to the commands. As such, the children will be able to immediately experience the VOD program instead of having to wait until their parent arrives home from work to manipulate one or more STBs to acquire the media content.”

Ex. 1114, [0082].

Aldrey describes various other manipulable settings, such as available channel information, favorite channels, program recording settings, viewing history, or software loaded in the STB. *Id.* at [0020].

III. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner fails to show a reasonable likelihood of prevailing on any claim, even under the level of ordinary skill in the art it proposes. Accordingly, for the purpose of this Preliminary Response only, Patent Owner assumes Petitioner has correctly stated the level of ordinary skill in the art. Patent Owner reserves the right to present evidence and argument in support of a different position on this issue in other proceedings or later in this proceeding in the event necessary.

IV. CLAIM CONSTRUCTION

Patent Owner reserves the right to address the proper construction of any claim terms in the future, as needed. By reserving such arguments at this stage, Patent Owner does not concede that the Petition uses claim language consistent with its proper construction(s).

V. PETITIONER HAS NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CLAIM

Petitioner's asserted grounds for obviousness are not supported by the evidence. The Petitioner thus fails to show a reasonable likelihood of prevailing on any claim as required for institution. *See* 35 U.S.C. § 314(a).

None of the cited references teaches using two sets of *commands* in two different *formats* in the context recited by the claims. First, Petitioner fails to show that the limitations relating to the *commands* in two different *formats* are taught by Mahajan (on which Petitioner principally relies for these limitations). Mahajan’s architecture and messaging differs from what the claims recite, and the alleged *first format* in Mahajan is generic and incapable of being used for selecting a media player. Second, Petitioner’s primary references—Danciu and Aldrey—do not even teach commands in multiple *formats*, let alone the other *command format* limitations. Third, Calvert does not disclose these limitations, and Petitioner does not contend otherwise. Because these limitations (present in all three independent claims) are missing from the cited references for all three asserted grounds, the Petition fails to show a reasonable likelihood of prevailing on any claim.

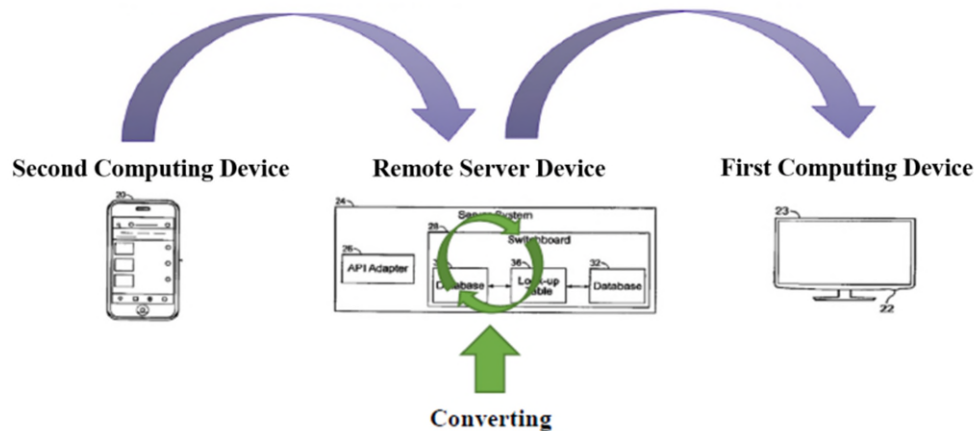
A. Mahajan Does Not Disclose the Limitations Relating to *First and Second Messages* and the *First and Second Formats* of the *Commands* in the Recited Messages

Grounds A–C all fail because they rely primarily on Mahajan for limitations Mahajan does not disclose or render obvious. In particular, all three independent claims recite limitations relating to the *first* and *second formats* for *commands* and to the *first* and *second messages* including those *commands* (the “*command format* limitations”). The relevant limitations, as they appear in claim 1, recite:

receiving [at a the first computing device], 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; and selecting a first media player application from a plurality of media player applications based at least in part on the first format ...

Ex. 1101, 11:62–67. Independent claims 12 and 17 recite substantially similar limitations. *See id.*, 13:10–22, 14:21–27.

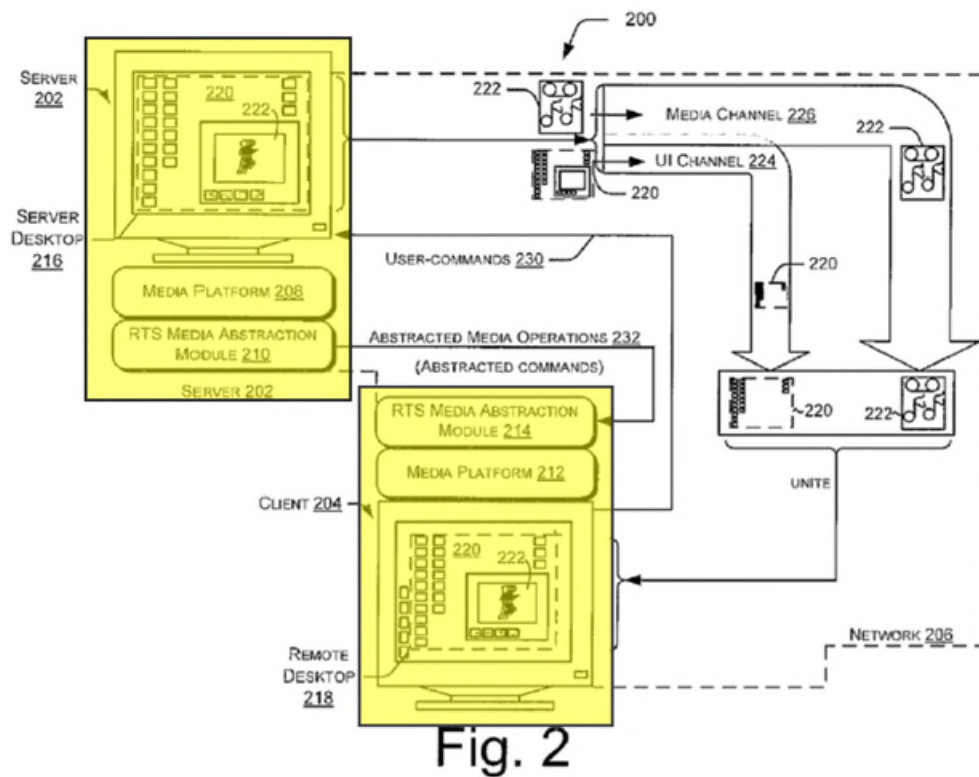
The '751 patent provides a useful illustration of using *commands* in two different *formats* in the manner recited by the *receiving* step excerpted above (*e.g.*, step 1(d)). It discloses, for example, that an API adapter (26) of a server system (24) “converts the incoming commands from the mobile device 20 into the correct JavaScript (or other programming) code used by the target [content presentation] device 22.” Ex.1101, 6:19–22; *see id.*, Fig. 1 (depicting “API adapter 26” as a component of “server system 24”). The server system of the embodiment then provides a copy of the converted message, which the content presentation device subsequently receives. *Id.*, 6:22–25, 6:38–48. The flow chart below conceptually represents this process:



The second of the excerpted claim steps above (e.g., step 1(e)) provides another requirement of the *first format* (i.e., the *format* for the *command* of the *first message*). The claims recite that the *first computing device* (or *content presentation device*, in claims 12 and 17) selects a *media player* based at least in part on the *first format*. This means the *first format* must be media-player specific (as opposed to generic or universal) in order for the selection to be “based on” that format because a generic or universal format would not indicate any specific media player.

In contrast with the '751 Patent, Mahajan describes a *two-part* server-client architecture where **the client** receives generic commands into media platform-specific commands (the *first format*). The commands received from Mahajan's **server** cannot be the *commands in the first format* of the claims for at least this reason. Furthermore, Mahajan's two-part architecture means that none of the *messages* can be the *second message* of the claims, which must be sent by the *second computing device* (claim 1) or the *remote computing device* (claims 12, 17).

In Mahajan's architecture, the server (202) and the client (204) each have an RTS (Remote Terminal Session) media abstraction module (210, 214). Ex. 1114, [0037], Figs. 2, 3.



Ex. 1114, Fig. 2 (annotated)

Mahajan describes a user, at the client, controlling the media component (222) from the server by entering “user-commands” (230) at the client, which are then relayed to the server via the network (206). *Id.*, [0035]. Mahajan further describes these commands as being “platform-specific media commands of the server 202,” which are intercepted and received by “the server’s RTS abstraction module 210.” *Id.*, [0036]. The server’s RTS abstraction module converts the server’s platform-

specific media commands into generic commands to be sent to the client's RTS abstraction module (214). *Id.* Then, "the client's RTS abstraction module 214 can translate the generic media commands ... into media commands that are specific to the client's media platform 212." *Id.* In this way, the two abstraction modules work together to create a "collaboration media abstraction layer 130" that "can abstract or genericize media playback commands specific to [the server's] media platform 122." *Id.*, [0022]; *see id.*, Fig. 1.

Referring to Mahajan's Figure 3 (as annotated below), the user-commands (306A–I, *red*) for the server's media platform are genericized by the server's RTS media abstraction module (210, *orange*) using RTS mapping table 302. The corresponding generic commands (308A–I, 310A–I, *grey*) are sent to the client's RTS media abstraction module (214, *blue*), which then converts the generic commands into platform-specific media commands (312A–I, *green*) for the client's media platform:



Fig. 3

Ex. 1114, Fig. 3 (annotations added)

Given this operation of Mahajan's architecture, Petitioner fails to show that Mahajan discloses *the first message being received [by the first computing device and from the remote server device] based at least in part on . . . a second message . . . having been sent from the associated second computing device*. Mahajan only discloses messages between the client and server without any messaging from another computing device. And the Petition never suggests that Mahajan discloses or suggests this requirement. See Pet., 27–32, 64–69.

Petitioner also fails to show that Mahajan discloses *a first computing device receiving from the remote server device, a first message that includes at least one command in a first format, where, based at least in part on that format, the first*

computing device then select[s] a first media player application from a plurality of media player applications. The process identified by Petitioner as the translation or conversion of a second message including at least one command in a second format into a first message that includes at least one command in a first format is performed by Mahajan's client, not by the server. Hence, Mahajan does not disclose any message received from the server that meets the limitations of the first message of the claimed invention.

Mahajan teaches that the RTS abstraction modules work together to translate commands specific to a first media platform into commands specific to a second media platform, using generic commands as an intermediary shared language. Ex. 1114, [0013]-[0014]. The server's RTS abstraction module in Mahajan only converts specific commands into generic commands. *Id.*; *see also id.* [0063]. The only conversion from a generic command into a media player specific command occurs at the **client's** RTS abstraction module, not at the server system. *Id.*

Petitioner acknowledges this aspect of Mahajan's disclosure, which Petitioner describes as follows:

- 1) commands for a type of media playing application on the server are received at Mahajan's server;
- 2) the commands are translated into a universal command;
- 3) the universal command is transmitted to the client;
- 4) **the client** re-translates the universal command; and

5) the new specific command is executed.

Pet., 28-29 (citing Ex. 1114, [0035]-[0036], Figs. 1-2) (emphasis added). In this five-step framework identified by Petitioner, Mahajan performs two separate translations (*i.e.*, conversions). Even so, using Petitioner’s contentions, the first step translates *to* a “universal command,” so it cannot then *select[] 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*.

B. The Proposed Danciu-Mahajan Combinations Do Not Render the Command Format Limitations Obvious (Grounds A–B)

Petitioner fails to show a likelihood of prevailing on Grounds A and B because the proposed combinations—Danciu-Mahajan and Danciu-Mahajan-Calvert—do not cure the deficiencies of the disclosure from Mahajan cited for the *command format* limitations. First, Danciu does not disclose *commands* in multiple *formats* at all, to say nothing of the related *messaging* the claims require. Second, Danciu also does not disclose *selecting a media player from a plurality of media players*; Danciu only teaches controlling a single media player (*e.g.*, YouTube). Third, Petitioner fails to provide an adequate rationale for combining the teachings of Danciu and Mahajan to achieve the claimed invention. And fourth, Calvert does not supply any of the missing limitations, nor does Petitioner argue that it does.

1. Danciu does not disclose using multiple different *formats* for *commands* in its messaging

Danciu does not disclose *receiving a first message [including] at least one command in a first format . . . based at least in part on . . . a second message including at least one command in a second format*. More specifically, Danciu does not disclose that the alleged *commands* have different *formats* at the specified points in the messaging process.

Petitioner argues that “Danciu’s remote control”—the alleged *second computing device*—“provides commands (‘fast forward, reverse, skip ahead or back, play, stop, move to new content, etc.’) via servers 24 [] for content being played on controlled device 18.” Pet., 25–26. As Petitioner’s argument suggests, the “servers” just provide a delivery system for the alleged *commands* and do not alter their *format*. Instead, according to Petitioner’s own argument, “Danciu’s servers ‘route the messages to other members of the session,’” such as controlled device 18, or “‘process and/or repackage the control information of the message into a new message.’” Pet., 27 (quoting Ex.1112, 7:17–20, 16:63–67). In either scenario, the control information from the original message remains unchanged when the “new message” is delivered to the controlled device. See Pet., 27 (asserting that messages are reformatted, but not the control information or any commands).

Accordingly, there is no evidence that the format of the alleged *command* changes (*e.g.*, is converted) between the remote control sending that command in a message to the server (the alleged *second message*) and the controlled device receiving the command in a message from the server (the alleged *first message*). Absent such evidence, Petitioner cannot show that Danciu discloses the *commands* in *first* and *second formats* are included in the alleged messages.

2. Danciu does not disclose *selecting a first media player application from a plurality of media player applications based at least in part on the first format*

Petitioner's grounds relying on Danciu fail for the additional reason that Danciu does not teach *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*, as claimed. Danciu does not disclose *selecting a media player application* because it contemplates remote control of a single media player—a much different endeavor than that undertaken by the '751 Patent. Figure 7 of Danciu demonstrates the simplicity of its implementation by illustrating the operation of its network servers communicating with a remote control:

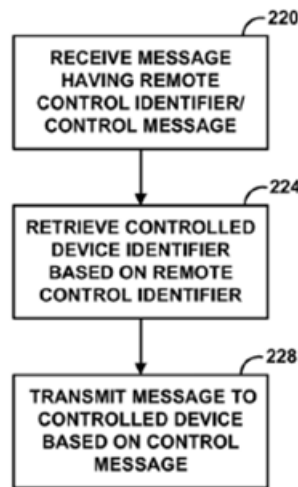


FIG. 7

Ex. 1112, Fig. 7; *see id.*, 3:1–3

Petitioner fails to show Danciu teaches or suggests that the *computing device* selects *a first media player application from a plurality of media player applications* or that it does so *based ... on the first format of the first message (i.e., the format of the at least one command included in the first message)*. Danciu’s “session identifier (SID) and control information” do not teach this limitation, as Petitioner suggests. Pet. 32-33 (citing Ex. 1112, 14:13-64). In those teachings, Danciu describes only methods for device management; nowhere does it describe messaging that can be used to identify particular media players. *See* Ex. 1112, 14:39-43, 14:50-53, 14:53-64. Petitioner alternately points to “controls” and “information” on the remote user interface that are “associated with content being played on controlled device 18.” Ex. 1112, 5:31-33; Pet. 33. But the mere fact that controls may be associated with a piece of content does not disclose *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, nor does the Petition provide any evidence that it does. Id.

Petitioner seeks to patch this hole by misguided reference to other media platforms—YouTube, Netflix, or Hulu—to suggest Danciu’s remote might “control” any one of them. Pet. 32-33; Ex. 1112, 11:31-35. But the cited portion of Danciu describes control of these media players by the “user interface 120” on the controlled device itself. *Id.*; *see also* Ex. 1112, 2:56-60, Fig. 4. Nowhere does Danciu envision “selecting” one media player from a plurality of media players. Danciu only describes support for “YouTube, Hulu, [and] Netflix” by the controlled device—in other words contextless messages from a remote without any selection of a particular media player from among a plurality of media players. Ex. 1112, 13:4-15. Unrelated use of another media player by different methods does not transform the teachings of Danciu focused on a single media player: YouTube.

Petitioner makes no attempt at a comprehensive mapping of these other media players as teaching the methods of the ’934 Patent. At any rate, such remote interaction with a user interface on the display device itself would not require any context from the remote, such as selecting a media player, and consequently fails to teach the limitations of the ’934 Patent.

3. Petitioner fails to provide a rationale for combining the teachings of Danciu and Mahajan to arrive at the claimed invention, as required by law

Yet another reason that the Petition does not establish a reasonable likelihood of prevailing is that Petitioner fails to support the proposed combination of Danciu with Mahajan. Petitioner’s proposed combination of Danciu and Mahajan renders its obviousness theory incoherent. In the *receiving* step (identified as limitation [1D]) Petitioner asserts an obviousness theory in which none of the operations performed by Mahajan’s RTS media abstraction modules are implemented at the alleged *server device*. See Pet., 31. Petitioner argues that Danciu’s remote control, the alleged *second computing device*, would perform the disclosed operations of the server’s abstraction module in Mahajan. See Pet., 31 (“Danciu’s remote control would translate commands associated with a first type of media playing application to a generic format, [and] transmit them to the controlled device”). In the same sentence, Petitioner asserts that Danciu’s controlled device, the alleged *first computing device*, would perform the operations of Mahajan’s client abstraction module. See *id.* (“Danciu’s remote control would ... transmit [generic commands] to the controlled device, which would translate them to a command associated with a second type of media playing application for execution.”).

Under this alternate theory, Mahajan’s abstraction modules operate entirely on components other than Danciu’s servers. See Pet., 31. This eliminates any

possibility that the alleged conversion of Mahajan would be performed by Danciu's servers, such that those servers would both (i) receive the *command in the second format* from Danciu's remote control and (ii) send the *command in the first format* for the "controlled device" to receive, as required by Petitioner's claim mapping. Any conversion would be performed instead by Danciu's other components, *i.e.*, the "remote control" and the "controlled device," and the *commands* and *messages* would not be sent and received by the recited system components. Thus, regardless which theory Petitioner applies, the resulting combination does not satisfy the limitations relating to the *command formats* and associated messaging.

Moreover, Petitioner provides no justification for combining Danciu and Mahajan aside from a passing remark that both of them reference a mobile phone. Pet., 30-31. "A reason for combining disparate prior art references is a critical component of an obviousness analysis; 'this analysis should be made explicit.'" *InTouch Techs., Inc. v. VGo Communc'ns, Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (quoting *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)). The Petition lacks this critical motivation to combine analysis because it "fails 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.*" *ActiveVideo Networks, Inc. v. Verizon Communc'ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) (emphasis in original) (citing *KSR*, 550 U.S. at 418). Observing that both references include

mobile phones provides no guidance as to why a POSITA would combine Danciu and Mahajan in a manner that would result in the claims at issue. Petitioner thus fails to establish obviousness.

Accordingly, Petitioner fails to establish a reasonable likelihood of prevailing on either the Danciu-Mahajan or Danciu-Mahajan-Calvert grounds.

4. Calvert does not provide the missing limitations to Danciu-Mahajan.

Petitioner's proposed addition of Calvert to the combination of Danciu and Mahajan also fails to show that the challenged claims would have been obvious. As discussed above, Mahajan, Danciu, and the combination of the two do not disclose or render obvious the *command format* limitations of, *e.g.*, limitations 1(d) and 1(e). Petitioner does not map Calvert to limitation 1(d), so the failings of Danciu-Mahajan with regard to that limitation permeate both grounds A and B. See Pet., 25–32.

Furthermore, because Calvert does not teach the *command* in the *first format* of step 1(d), including its relationship to a *command* in the *second format* from the *second message*, Calvert cannot disclose the *selecting* step of claim 1(e). This is because the *selecting* must be based at least in part on the *first format of the first message*. That *first message* must be received based in part on the *second message* of step 1(d), which is completely absent from Calvert.

Petitioner argues to no avail that Calvert “discloses a system for making content available from multiple media services via [a] content aggregator ... such that a playback device ... can request, receive, and output the content to a display device ... and/or audio speaker” and “further describes that the content aggregator 102 may transmit data parameters to the playback device 202.” Pet., 35-36. But Petitioner’s mapping does not suggest, nor could it, that Calvert teaches converting a command from a *second format* to a *first format* before the playback device receives the command and uses the *first format* to select an appropriate media player. Accordingly, Calvert does not rectify the deficiencies of Danciu and Mahajan.

Petitioner therefore fails to show a reasonable likelihood of prevails on either of Grounds A and B.

C. Aldrey in View of Mahajan Does Not Teach or Render Obvious the Limitations of the ’751 Patent

As with the Danciu-based grounds, Petitioner fails to show how or why an ordinary artisan would have combined or been motivated to combine Mahajan with Aldrey in order to achieve the claimed invention. Petitioner relies entirely on Mahajan for limitations regarding changing a *command* in a *second format* into a *command* in a *first format*. See Pet., 63–69. Petitioner argues that Aldrey discloses messages that include commands, but does not suggest that Aldrey’s messages meet the limitations regarding *commands* in a *first format* and a *second format*. See *id.*,

63–64. The deficiencies of Mahajan’s disclosure are addressed above. *See supra* Section V.A. Those deficiencies are likewise fatal to the proposed combination of Mahajan with Aldrey asserted in Ground C.

Ground C also fails for the independent reason that Petitioner fails to establish a reason for combining the cited teachings of Aldrey and Mahajan in order to achieve the claimed invention. The Petition merely asserts 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 Service Provider Network 103.” Pet., 67 (citing Ex.1114, [0018], [0058], [0078]; Ex.1102 ¶182) (emphasis added). But evidence that these modules *could* operate at a server is not sufficient to support a prima facie case of obviousness.

Petitioner failed to show *how* and *why* a POSITA *would* have made such a modification. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (arguing that references “could” be combined “does not imply a motivation to pick [the references] and combine them to arrive at the claimed invention.”); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1074 (Fed. Cir. 2015) (“Obviousness 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 inventions.”); *William Wesley Carnes, Sr., Inc. v. Seaboard International, Inc.*, IPR2019-00133, Paper 10 (PTAB May 8, 2019), at 18 (“asserting that a POSITA

‘could’ have combined the references to reach the claimed invention [is] insufficient for obviousness”). Petitioner’s suggestion that certain operations “could” be performed on the server does nothing to establish that a POSITA “would” have performed such operations on the server based on any motivation. That feeble suggestion also fails to justify the modifications necessary to the component parts of Mahajan and Aldrey for the combination to achieve the claimed invention. Pet., 66-67, 71. For this reason too, Petitioner fails to establish a prima facie case of obviousness under Ground C.

Petitioner therefore fails to show a reasonable likelihood of prevailing on Ground C.

D. Petitioner Relies on the Same Arguments for Every Claim

For all Grounds, the Petition relies on and incorporates the arguments it makes for claim 1 in its challenges to independent claims 12 and 17. Pet., 49-51, 54-56. The same fatal deficiencies in the challenges to claim 1 infest Petitioner’s analysis of the other independent claims for all grounds. *See id.* Petitioner therefore fails to show a reasonable likelihood of prevailing on any independent claim for any ground for the reasons explained above. Nothing in the analysis of the dependent claims remedies these deficiencies.

The Petition thus fails to establish a reasonable likelihood of prevailing on any claim, and the Board should deny institution.

VI. THE BOARD SHOULD DENY THE PETITION UNDER § 325(D) BECAUSE THE OFFICE PREVIOUSLY CONSIDERED MAHAJAN AND DANCIU DURING PROSECUTION

The Petition relies on critical references that are the same or substantially the same as art that the Patent Office has already considered, and the Board should exercise its discretion to deny institution on that basis. 35 U.S.C. § 325(d). The Mahajan reference is necessary to every ground of the petition, and the Office has already considered the teachings of Mahajan during prosecution. Ex.2001, 13–14 (*citing* Mahajan (Ex.1114), [0011]).

The examiner considered Mahajan during prosecution of the '751 Patent. The examiner asserted Mahajan in an obviousness rejection of dependent claims 2 and 3, in view of Morris (US2012/013097A1). Ex. 1104, 63-74, 176-190. The examiner stated “Mahajan teaches translating a platform specific media playback command into a generic or universal media playback command for transmission to a client.” *Id.* The applicant responded May 9, 2019, explaining Mahajan’s architecture is incompatible with the limitation of the '751 Patent:

“[B]y virtue of the described embodiments of Mahajan, Mahajan simply cannot teach one or more computing devices that perform operations including, among other things, receiving, *from the remote server device*, a first message that includes at least one command in a first format, wherein the first message is received based at least

in part on a second message including at least one command in a second format having been sent *from the associated remote computing device.*”

Ex.1104, 172-73. The same architectural issues discussed above in connection with Mahajan were discussed during prosecution of **this very patent**. Mahajan envisions a client-server relationship wherein the server renders its graphical user interface on the client itself and command translations occur for the device performing the conversion. *Id.* Mahajan’s translation and re-translation functions do not make sense in the context of the ’751 Patent’s “remote server device” and “remote computing device”—not to mention the total inability of Mahajan’s teaching to encompass the ’751 Patent’s “first computing device.”

Again with regard to Mahajan, as noted above, *infra*, the applicant explained during prosecution that “Mahajan recites ‘[c]ollaboration sessions can provide a remoting experience between a client computer (hereinafter, ‘client’) and a server computer (hereinafter, ‘server’)’ and that ‘[c]ollaboration can involve representing a portion, or all, of the server's graphical user-interface (GUI) on the client.’” Ex.2001, 13 (citing Ex.1114, [0011]). Thus, Mahajan cannot teach the limitations of the ’751 Patent. Ex.1104, 172-73. The same deficiencies are present in the Petition.

Further, the asserted Danciu art is substantially similar to and also cumulative of art that was considered by the Office. Danciu’s assignee, Google, provided

testimony that the Danciu application describes the “YouTube Remote” and “YouTube Leanback” products—which were considered by the examiner during the prosecution of the ’751 Patent. Ex.1104, 544. The Petition asserts the Patent resulting from that application—representative of the very same YouTube Leanback product that was considered by the examiner. Yet, the examiner found it lacked the teachings of the ’751 Patent. Ex.1104, 544. Danciu, therefore, is substantially similar to and cumulative of art that has been considered by the Office.

In short, the Office has already considered argument substantially similar to the one the Petition makes: that Mahajan allegedly teaches the limitations of the ’751 Patent. The Petition introduces no references that make up for the failings of Mahajan. The Office already considered substantially similar art to Danciu as well. Petitioner has nothing new to add to these prior disputes—they fail for the same reasons they failed before.

A. The *Becton, Dickinson* Factors Favor Denying Institution under 35 U.S.C. § 325(d)

Section 325(d) provides the Board, acting on behalf of the Director, with discretion to deny institution on a petition for IPR because “the same or substantially the same prior art or arguments previously were presented to the Office.” Under Board precedent, “the question of whether proffered art or arguments are ‘the same or substantially the same’ as art or arguments previously presented to the Office is a

highly factual inquiry, which may be resolved by reference to the factors set forth in *Becton, Dickinson*.” *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (Feb. 13, 2020) (precedential) (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017)). The six factors from *Becton, Dickinson* favor denial of the Petition:

Factor (a), the similarities and material differences between the asserted art and the prior art involved during examination, favors denying institution. Mahajan was considered during prosecution of the '751 Patent. Further, Danciu was considered in the form of its implemented system, YouTube Leanback, and its assignee argued it accurately portrays that system, which was in front of the examiner of the '751 Patent. *Touchstream Techs. Inc. v. Google, LLC*, 6-21-cv-00569 (W.D. Tex., Jun. 4, 2021), Dkt. 262, Transcript of Proceedings on Jul. 19, 2023, at 975:6-15 (Google’s technical expert opining the Danciu application describes the YouTube Remote and Leanback system). The differences between Danciu and the art in front of the examiner are thus immaterial according to Danciu’s assignee.

Factor (b), the cumulative nature of the asserted art and the prior art evaluated during examination, favors denying institution because Mahajan was considered during prosecution of the '751 Patent and Danciu is substantially the same as and cumulative of the same YouTube Leanback art already considered during

prosecution of the '751 Patent. Ex.2001, 13–14, *citing* Mahajan, at 91[0011] (Ex.1114).

Factor (c), the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection, favors denying institution. Mahajan was a basis for rejection by the examiner and successfully overcome via argument during prosecution of this very patent. *Id.*

Factor (d), the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art, favors denying institution. As explained above, the Petition re-asserts the very same subject matter from Mahajan that was successfully overcome via argument during prosecution of the '751 Patent, namely the claim limitations related to translating playback commands from a *second format* to a *first format*. Ex. 1104, 172-73. Mahajan fails for the same reasons here.

Factor (e), whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art, favors denying institution. Petitioner has made no showing the Examiner erred in its evaluation of the asserted prior art. Indeed, Petitioner has not addressed the Examiner's treatment of Mahajan during prosecution of the '751 Patent.

Factor (f), the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments, favors denying institution because the Petition does not tread any new ground related to Mahajan. In summation, these factors show the same or substantially the same art or arguments has already been considered and no material errors were made. The Board should, therefore, exercise its discretion under § 325(d) to deny institution.

VII. THE BOARD SHOULD EXERCISE DISCRETION UNDER § 314(A) TO DENY THE PETITION

Petitioner waited almost seven months to file its Petition after Patent Owner served Petitioner with the Complaint filed in the Eastern District of Texas. This unwarranted delay makes it almost certain that trial in the district court will conclude before the Board has the opportunity to reach a final written decision. Instituting IPR on this Petition, despite considerable investment by the parties and the trial court in the co-pending litigation, would frustrate Congress's intent that IPRs serve as a faster, less costly alternative to litigation on the issue of invalidity. *See, e.g., SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1357–58 (Fed. Cir. 2016) (Newman, J., dissenting-in-part) (collecting evidence of legislative intent regarding § 315 estoppel), *rev'd in part by SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

The Board has recognized the importance of staying consistent with this goal and laid out factors meant to guide the exercise of discretion whether to institute trial

on a petition. *See NHK Spring Co. Ltd. v. Intrix-Plex Techs. Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 5–16 (PTAB Mar. 20, 2020) (precedential). Applying the *Fintiv* factors (as further clarified in the Director’s Memorandum⁶ dated June 21, 2022) establishes that the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution in this proceeding.

B. Factor 1: Likelihood of Stay

Petitioner has not moved for a stay in the district court proceeding. *See generally* Exs. 2017, 2018, 2019. Petitioner asserts its intention “to request a stay.” Pet., 18. It does not make any showing that its potential request is likely to be granted. *See id.*

Petitioner concedes that “[f]actor one appears neutral.” Pet., 18; *Sand Revolution II, LLC v. Cont’l Intermodal Grp. Trucking LLC*, IPR2019-01393, Paper

⁶ Director Vidal’s Memorandum to Members of the Board re: Interim Procedure for Discretionary Denials in AIA Postgrant Proceedings with Parallel District Court Litigation (available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf) (hereinafter “Director’s Memorandum”).

24 at 7 (PTAB June 16, 2020) (informative). The parallel proceeding is unlikely to be stayed pending IPR, as that Court rarely grants such stays. Ex.2002 (26% grant rate of 95 orders). Although the Board cannot conclusively know what the Court will do, it is reasonable to assume a stay is unlikely, as several factors make such stays rare in that Court, the parallel litigation is proceeding on schedule, and the late hour of this Petition puts the trial only a few months away from the institution decision.

Factor one favors discretionary denial.

C. *Factor 2: Trial Date Relative to Final Written Decision Due Date*

Trial in the district court is scheduled to begin October 28, 2024. Ex.2003 (Docket Control Order). The Board's deadline to reach a final written decision is likely to fall in July 2025, assuming no cause arises to extend that time. See 35 U.S.C. §§ 314(b), 316(a)(11); 37 C.F.R. § 42.100(c). Accordingly, the present trial date is more than **eight months** before the Board would issue a final written decision in this proceeding. This weighs heavily in favor of exercising discretion to deny the Petition, especially because Petitioner has offered no justification for its delay in requesting IPR. See *Verizon Bus. Network Servs. LLC v. Huawei Techs. Co. Ltd.*, IPR2020-01292, Paper 13 at 12 (PTAB Jan. 25, 2021) (trial date seven to eight months before FWD weighs in favor of discretionary denial); see also *Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 8–9 (PTAB June 15, 2020) (even

when Petitioner’s delay in filing was justified, trial date seven and a half months before FWD “weighs moderately in favor of Patent Owner”).

The time-to-trial in the Marshall Division of the Eastern District of Texas (where the case is pending) also supports the conclusion that the district court will conduct trial before this proceeding is over. *See* Ex.2004; *see also* Director’s Memorandum at 8–9. The trial court has held 98 jury trials in patent cases filed since 2012. Ex.2004. The median time from complaint to jury trial was 21 months, with the 25th to 75th percentile of cases occurring 18 to 28 months after the respective complaints. *Id.* The current trial date in the parties’ co-pending litigation is just over twenty months after the complaint, true to the median schedule, but trials in the Marshall Division have happened even earlier. *See id.* (reporting minimum time-to-trial of 7 months and 2nd percentile time of 14 months); Ex.2005 (Filed February 17, 2023); Ex.2003, 2 (Scheduling “Jury Selection/Trial” for October 28, 2024). In view of the trial court’s historical statistics, the current trial date is credible, and there is no evidence that the needs of the particular case will require moving the trial date. (Petitioner mentions its motion to transfer venue as a possible reason the trial date would change, but that motion has since been denied. *See* Ex.2006, 8. Even if one assumes trial might be delayed and applied the 75th percentile time to trial for the court (28 months), *see* Ex.2004, the hypothetical trial date would be June 15, 2025. This is still before the final written decision deadline.

Factor 2 weighs in favor of discretionary denial. Petitioner has not disputed that this factor weighs in favor of discretionary denial. *See* Pet., 18 (omitting any mention of the weight given to Factor 2). Instead, it merely asserts that it “does not warrant denial.” *Id.* With trial in the district court scheduled to begin just three months after the Board makes a decision on institution and over eight months before the final written decision date, this factor weighs in favor of denying institution.

For these reasons, factor 2 weighs heavily in favor of discretionary denial of the Petition.

D. *Factor 3: Investment in Trial Court Proceedings*

By the institution deadline, the parties will have invested substantial time and effort in the co-pending litigation (as shown below), and Petitioner’s lack of diligence is a contributing cause of this. Accordingly, factor 3 weighs heavily in favor of discretionary denial. This factor is evaluated based on the date of the Board’s decision on institution. *See Verizon Bus. Network*, IPR2020-01292, Paper 13 at 14 (“[T]he appropriate time to evaluate the investment of the parties in the Parallel Proceeding is at the time of the institution decision and not at the time of the filing of the petition.”). Petitioner cites the incomplete claim construction process and close of fact discovery as reasons this factor does not warrant denial, but both of these will be complete before the board is expected to make its institution decision

in July 2024. Fact discovery indeed closes in June, and the Court will hold the claim construction hearing May 16, 2024.

The district court is likely to issue a claim construction order before the deadline for the decision on institution, and Patent Owner will (if authorized) notify the Board when that order issues. The parties have exchanged multiple rounds of infringement and invalidity contentions, including Patent Owner's First Supplemental Infringement Contentions (served May 26, 2023), and Petitioner's Third Supplemental Invalidity Contentions (served March 27, 2024). *See* Exs. 2007, 2009. Fact discovery closes in about five weeks (on June 10) (Ex.2003, 4), and the parties have already served extensive written discovery on the merits, including third-party discovery. *See* Ex.2022, 43-44. The production of documents and ESI is already substantially complete. *See* Ex.2003, 5. By the deadline for the decision on institution, all expert reports will have been disclosed and expert discovery will be closed. *See* Ex.2003, 4.

This investment is similar to that in *Verizon Business Network*, which the Board determined “weighs in favor of exercising discretion to deny institution.” IPR2020-01292, Paper 13 at 14–15. In that case, like here, “by the time of the institution decision in this proceeding, the parties in the Parallel Proceeding will have completed substantial work, including fully briefing and arguing claim construction, completing fact discovery, and exchanging expert reports.” *Id.* Further,

in *Verizon Business Network*, “expert discovery [wa]s also expected to close soon” after the Board’s institution decision, and in this case it will already be closed. See *id.* at 14; Ex.2003, 4.

Unlike the petitioner in *Verizon Business Network*, however, Petitioner in this proceeding did not diligently prepare and file its Petition after Patent Owner identified the asserted claims in the co-pending litigation. On May 26, 2023, Patent Owner served its First Supplemental Infringement Contentions, in which it identified claims 12, 13, 14, and 16 of the ’751 patent as the claims asserted. Ex.2007, 14 (First Supplemental Infringement Contentions to Comcast). Petitioner served Preliminary Invalidity Contentions listing Danciu among the prior art with its disclosures of August 4, 2023. Exs.2009, 2010 (Preliminary Invalidity Contentions). Petitioner continues to pursue the Danciu prior art as of April 4, 2024. Ex.2011, 3. Petitioner waited to file its Petition challenging the same claims asserted based on prior art from its contentions until December 27, 2023—almost seven months after learning of the asserted claims and almost five months after serving its invalidity contentions. Thus, Petitioner is not entitled to any “credit” for its diligence, which the Board gave the petitioner in *Verizon Business Network*. See IPR2020-01292, Paper 13 at 14 (noting petition was filed two months after preliminary contentions revealed the claims asserted and two weeks after serving its preliminary invalidity contentions). Petitioner’s lack of diligence further increases this factor’s weight in favor of

discretionary denial. *See Fintiv*, IPR2020-00019, Paper 11 at 11 (“If, however, the evidence shows that the petitioner did not file the petition expeditiously . . . or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.”).

For these reasons, factor 3 weighs heavily in favor of exercising discretion to deny the petition.

E. *Factor 4: Overlap of Issues*

This factor also favors discretionary denial because the same claims and prior art are at issue in the co-pending litigation. *See Fintiv*, IPR2020-00019, Paper 11 at 12 (explaining that “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong” when the same claims, prior art, and arguments are at issue in both proceedings). As noted above, the same set of claims is challenged in the Petition and asserted in the district court. Pet., 2–3; Ex.2007 at 3. Prior art asserted in the Petition is also among the art listed in Petitioner’s invalidity contentions. *Id.*

Petitioner’s stipulation regarding duplicative invalidity defenses at issue in the parallel proceeding is too weak to be effective. Petitioner stipulates only that if review is instituted it will not pursue the “*specific* grounds against the instituted patent(s) as set forth in the respective instituted *inter partes* review proceeding.” Ex.2012 (emphasis added). This appears potentially narrower than the weak

stipulation offered in *Sand Revolution II, LLC v. Cont'l Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020). In *Sand Revolution*, the petitioner stipulated it would not pursue the “same grounds,” and the Board found that only mitigated concerns of duplicative efforts and potentially conflicting decisions “to some degree.” *Id.* Here, Petitioner’s stipulation does not even prevent it from re-arguing the same prior art—Petitioner can simply argue the same grounds as long as they are not argued “as set forth in the respective instituted *inter partes* review proceeding.” That is, Petitioner could merely combine the very same art differently to contend it is not the same specific grounds as set forth in the IPR. Petitioner and its co-defendants continue to pursue Danciu, the primary reference of this Petition, in the parallel proceedings, and, indeed, Petitioner advances the exact same grounds based on its incorporation by reference noted above.

Moreover, Petitioner’s co-defendant in the parallel proceeding, Charter Communications,⁷ is pursuing almost identical invalidity defenses and has not agreed to be bound by any such stipulation. Petitioner and Charter’s cases remain

⁷ 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”)

consolidated for all pretrial purposes and issues of invalidity will likely be dealt with at the same time. Ex.2013. In effect, Petitioner gets an end-run around its already weak stipulation, as its co-defendant intends to attempt to pursue the same Danciu prior art in the district court whether or not review is instituted. This duplicative litigation defeats the purpose of IPRs as a faster, less costly alternative to district court litigation. *Compare Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13–14, 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (affording substantial weight to stipulation filed with similar scope to estoppel under 35 U.S.C. § 315(e)(2)) *with Verizon Bus. Network*, IPR2020-01292, Paper 13 at 15–16, 18–19 (giving weight to limited stipulation but exercising discretion to deny institution). *See also* Director’s Memorandum at 7–8.

Factor 4 weighs in favor of discretionary denial.

F. Factor 5: Same Parties

The parties in this IPR and the parties in the co-pending litigation are identical, so this factor weighs in favor of discretionary denial. *Sotera*, IPR2020-01019, Paper 12 at 19 (precedential); *Fintiv*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative). Petitioner does not dispute the weight of this factor, instead only arguing it “does not warrant denial.” Pet. 18. It may not warrant denial on its own, but it certainly weighs in favor of denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (precedential) (“[T]his factor supports denying institution.”); *Fintiv*,

IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020) (informative) (“[T]his factor weighs in favor of discretionary denial.”).

Factor 5 weighs in favor of discretionary denial.

G. *Factor 6: Other Considerations*

This case presents no compelling factors that weigh against discretionary denial. The merits of this case are weak, for the reasons explained above, and warrant denying institution on their own. Because the evidence does not meet the “reasonable likelihood” threshold for institution, it also does not meet the even higher threshold for a “compelling, meritorious challenge.” See Director’s Memorandum at 4 (“Compelling, meritorious challenges are those in which 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.”) (underline added).

Moreover, Petitioner misplaces its reliance on the assertions that the art it relies on is “entirely different” from the previously-considered art asserted in the Google petition. Pet., 19; *Google, LLC. v. Touchstream Technologies, Inc.*, IPR2022-00795 (PTAB Sep. 5, 2022). This does not weigh against discretionary denial under § 314(a); Petitioner offers no authority to suggest otherwise. See *id.* Moreover, Petitioner’s assertion is ironic because it asserts Google’s IPR art, Muthukumarasamy, in the district court, and Petitioner asserts Google’s district

court art, in this Petition. *Google, LLC. v. Touchstream Technologies, Inc.*, IPR2022-00795 (PTAB Sep. 5, 2022); Ex.2011, 3.

At any rate, this factor is primarily interested in the strength of the evidence on the merits, though the Board has used it to consider issues of fairness and equity not encompassed by other factors. *See Fintiv*, IPR2020-00019, Paper 11 at 14–15; *see also Dolby Labs., Inc. v. Intertrust Techs. Corp.*, IPR2020-01106, Paper 12 at 18 (PTAB Jan. 5, 2021) (considering whether a petitioner’s suit for declaratory judgment of non-infringement favors discretionary denial).

Because there are no compelling circumstances not addressed by the other factors, this factor is neutral.

H. Combined Factors

When combined, the several factors support the exercise of discretion to deny institution under § 314(a). Factors 1–5 all weigh in favor of exercising discretion to deny institution, some heavily, and the last factor is neutral. Viewing the factors holistically, discretionary denial is the outcome that best serves the “efficiency and integrity of the system.” Far from being the *alternative* to district court litigation that Congress envisioned, Petitioner has turned this proceeding into a bonus round. Patent Owner and the Board will pay the cost.

The facts bear this out. Petitioner offers no justification for its delay of many months in filing its Petition, even after preparing invalidity contentions in the co-

pending litigation relying on the art asserted in this Petition many months before it was filed. Because of this delay, the co-pending litigation advanced so far that even expert discovery will be done by the institution deadline, and the parties will bear all the expense of invalidity expert reports and related depositions. Trial, including on invalidity, will be three months away by then and (even allowing for some delay) is all but certain to happen before the Board issues a final written decision in this case. That trial will involve the claims challenged in this case, and Petitioner will not be subject to estoppel under § 315(e) and may likely try to assert the same art or even the same grounds raised in the Petition. Even if trial ends in a judgment for Patent Owner, Petitioner would still have the option to maintain this proceeding.

Hence, whether by design or unintentional delay, the timing of the Petition gives Petitioner two chances to litigate invalidity and obtain its preferred outcome. This does not serve the efficiency of the system, which already expends considerable public resources to litigate invalidity once. In addition, the possibility of inconsistent results compromises the patent system's integrity. This is the archetypal case that justifies discretionary denial under § 314(a), and the Board should deny institution at least on that basis.

VIII. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition.

Dated: May 9, 2024

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 PRELIMINARY RESPONSE, according to the word-processing system used to prepare the paper and not including those parts excluded by § 42.24(a)(1), has 10,851 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 May 9, 2024, a complete and entire copy of the foregoing Patent Owner's Preliminary Response and Exhibits 2001–2014 and 2017–2022 were provided via email to Petitioner's counsel of record as follows:

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