

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

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

**PATENT OWNER'S REQUEST FOR REHEARING
OF THE BOARD'S INSTITUTION DECISION**

TABLE OF CONTENTS

INTRODUCTION 1

LEGAL STANDARDS 2

ARGUMENT 3

 I. The Board’s Decision Was Based on a Claim Construction that
 Neither Party Offered nor Agrees With. 3

 A. Petitioner Did Not Argue that Commands Having a “First
 Format” and “Second Format” Can Have the Same Formats.....4

 B. Patent Owner Argued that the “First Format” and “Second
 Format” Must Be Different Formats. 7

 C. The Board in Its Institution Decision Found that the “First” and
 “Second” Formats Can Be the Same Format.....8

 D. In the District Court Proceedings, the Parties and the Court
 Agreed that the “First” and “Second” Formats Must Be
 Different Formats. 9

 II. The Board’s Construction of the “First” and “Second” Formats Is
 Based on Legal Errors. 9

 III. On Rehearing, the Board Should Decline to Institute the Petition. 14

CONCLUSION 15

TABLE OF AUTHORITIES

Cases

<i>3M Innovative Properties Co. v. Avery Dennison Corp.</i> , 350 F.3d 1365 (Fed. Cir. 2003).....	14
<i>AdjustaCam, LLC v. NewEgg, Inc.</i> , 861 F.3d 1353 (Fed. Cir. 2017).....	3
<i>AK Steel Corp. v. Sollac & Ugine</i> , 344 F.3d 1234 (Fed. Cir. 2003)	13
<i>Engel Indus., Inc. v. Lockformer Co.</i> , 96 F.3d 1398 (Fed. Cir. 1996).....	14
<i>Google LLC v. EcoFactor, Inc.</i> , 92 F.4th 1049 (Fed. Cir. 2024)	11
<i>In re Magnum Oil International, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016).....	11
<i>Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n</i> , 22 F.4th 1369 (Fed. Cir. 2022).....	14
<i>Marine Polymer Techs., Inc. v. HemCon, Inc.</i> , 672 F.3d 1350 (Fed. Cir. 2012)	13
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	15
<i>Teva Pharms. USA, Inc. v. Sandoz, Inc.</i> , 574 U.S. 318 (2015)	3, 4
<i>Ultratec, Inc. v. CaptionCall, LLC</i> , 872 F.3d 1267 (Fed. Cir. 2017).....	3
<i>Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.</i> , 853 F.3d 1272 (Fed. Cir. 2017).....	14
<i>Wi-LAN USA, Inc. v. Apple Inc.</i> , 830 F.3d 1374 (Fed. Cir. 2016)	13

Rules

37 C.F.R. § 42.71	3
-------------------------	---

INTRODUCTION

Patent Owner respectfully requests rehearing of the Board’s institution decision because (1) it misapprehended a legal issue by applying an incorrect claim construction (*infra* §II), and/or (2) it misapprehended or overlooked that neither party proposed that construction, and instead, both parties were operating under a contrary, shared construction, which has been adopted by a district court (*infra* §§I.A.-I.B, II).

The ’751 patent claims require a first message having a command in a “first format” that is “based at least in part” on a second message with a command in a “second format.” Ex. 1101, claims 1, 12, 17. The Board found that “first format” and “second format” can encompass commands having the *same* format. Institution Decision, Paper 13 (“Decision”) at 31. And it relied on that construction to dispose of Patent Owner’s arguments. *Id.* at 31, 33-34. As a result, the Board found that the “Petition presents a compelling challenge at least for independent claims 1, 12, and 17” under *Fintiv* factor six, and it therefore “decline[d] to deny institution based on the *Fintiv* factors.” *Id.* at 16; *see id.* at 43.

Respectfully, however, that Decision rests on legal error. The plain meaning of “first format” and “second format” requires that the formats be different. And the Petition did not challenge the claims based on the Board’s construction. Instead, both the Petitioner and the Patent Owner operated under the same shared

premise that the “first format” and “second format” refer to *different* formats.

Indeed, in parallel district court proceedings, the Petitioner, the Patent Owner, and the presiding Judge all agreed that “first format” and “second format” require different formats.¹

In short, Patent Owner requests that rehearing be granted based on legal errors related to claim construction, and that institution be denied under *Fintiv* based on a lack of “compelling merits” under the correct claim construction.

LEGAL STANDARDS

A rehearing “request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.” 37 C.F.R. § 42.71(d). The Board reviews its Decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision . . . is based on an erroneous conclusion of law” *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d

¹ In reaching its Decision, the Board did not have the benefit of the Court’s claim construction opinion, which issued just prior to the Board’s Decision. *Infra* §I.D. Shortly after the Board’s Decision, Patent Owner obtained authorization and then submitted this opinion as Exhibit 2024 pursuant to the Board’s guidance on page 47 of the Consolidated Trial Practice Guide (Nov. 2019).

1267, 1272 (Fed. Cir. 2017). Other abuse-of-discretion examples include decisions based on clearly erroneous facts findings, or records containing no evidence on which the Board could rationally base its decision. *Id.*; *see also AdjustaCam, LLC v. NewEgg, Inc.*, 861 F.3d 1353, 1358 (Fed. Cir. 2017).

Patent Owner’s rehearing request involves a claim construction issue, which is an issue of law that may involve underlying factual findings. *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 326 (2015). A claim construction is “solely” a “determination of law” if—as is the case here—it is based off of a review of “only evidence intrinsic to the patent. . . .” *Id.* at 331. As such, Patent Owner’s rehearing request is based on an abuse of discretion arising from an erroneous conclusion of law—an incorrect claim construction that the Board misapprehended.

ARGUMENT

I. The Board’s Decision Was Based on a Claim Construction that Neither Party Offered nor Agrees With.

The Board’s Decision rests on construing “first format” and “second format” as follows:

Contrary to Patent Owner’s position, claim 1 does not require that the format of any command be converted, let alone that the formats of the first and second commands be different. See Prelim. Resp. 28–29. . . . Accordingly, claim 1 is not limited to different first and second formats.

In view of the foregoing, we are persuaded that Danciu alone teaches

“receiving, from the remote server device, a first message” as recited in claim 1.

Decision at 31 (Board’s rationale omitted, but addressed in Section II, below); *id.* at 33-34. The parties (and a district court), however, agree that “first format” and “second format” (found in all of the claims) require different formats.

A. Petitioner Did Not Argue that Commands Having a “First Format” and “Second Format” Can Have the Same Formats.

The Petitioner argued to the Board that the ’751 patent claims focus on, among other things, “translating” and “convert[ing]” commands to control media:

The ’751 Patent generally *claims* computer-implemented methods directed to *translating commands* among associated devices to control media. The *methods* use a display device to present video content using one of a plurality of media players controlled via messages transmitted from a computing device to a server, *converted into commands* appropriate for the selected media player to control playing of the video content, and then transmitted to the display device.

Petition, Paper 2, at 1 (“Petition”).

As described by the Petitioner, the ’751 patent uses a **server system 24** to facilitate the selection of content by a **computing device 20** (*e.g.*, a mobile phone), and the display of the content on a **television/display device 22**. Petition at 2 (citing Ex. 1101, 3:13-36; Ex. 1102, ¶¶ 40-42). After an association is established

between the phone and the display, the phone can send a message to the server

system related to content to be played using a

media player. Petition at 3 (citing Ex. 1101,

4:56-5:4, 5:59-6:4, 6:4-37). The server then

“converts the commands from the personal

computing device *into the correct code* for

use on the display device to control the media

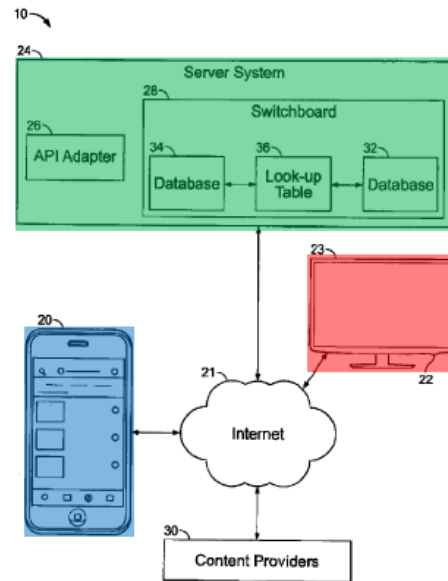
player.” *Id.* (citing Ex. 1101, 6:4-37)

(emphasis added). The display device then

receives the converted information and acts on it “by, for example, loading the

requested media player, obtaining the selected video content file, and playing the

video.” *Id.* (citing Ex. 1101, 6:38-48, 6:49-7:3).



Ex. 1101, Fig. 1 (annotated)

Among the claims the Petitioner challenged was claim 1, which included a limitation (which Petitioner labeled “1D”) requiring:

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....

Petition at 89; Ex. 1101 at 11:51, 11:62-67 (emphasis added); *id.*, claims 12, 17.

Petitioner contended that this claim and others were rendered obvious by

Danciu in view of Mahajan, and by Danciu in view of Mahajan and Calvert.

Petition at 21. As part of that analysis, Petitioner did not offer an explicit construction of any of the claim terms, instead contending that they “should be given their ordinary and customary meaning to a POSITA, consistent with the prosecution history, as they would be given in a civil action under 35 U.S.C. § 282(b).” Petition at 20.

With respect to limitation [1D], however, Petitioner and its expert implicitly interpreted “first format” and “second format” to require different formats. In explaining how the prior art allegedly taught this limitation, they focused on how the Danciu reference allegedly “reformatted” a “second message” into the format of the “first message.” *Id.* at 27; Ex. 1102 ¶ 142. For Mahajan, they argued that it translates the generic commands to specific commands. Petition at 28; Ex. 1102 ¶ 140. And they provided similar descriptions of the result of the alleged combination of the two references. Petition at 31-32 (applying “Mahajan’s teachings of command conversion” to Danciu so that Danciu “would translate commands associates with a first type” and then “translate them to a command associated with a second type” and arguing a POSITA would be able to make this combination “to translate commands from those associated with a first type . . . to another type of command.”); Ex. 1102 ¶ 149.

The Petition, therefore, demonstrates that Petitioner implicitly construed the

claims as requiring the “first format” and the “second format” to be different.

Further, Petitioner never argued they could be the same format nor asserted a theory of unpatentability premised on such a construction.

B. Patent Owner Argued that the “First Format” and “Second Format” Must Be Different Formats.

On May 9, 2024, Patent Owner filed its Preliminary Response. Paper 9 (“Response”). Consistent with Petitioner’s description of the ’751 patent, Patent Owner described how, in the ’751 patent specification, the server system uses protocols to convert “incoming universal command[s] (e.g., play, pause, etc.)” into “code used by the target device 22 to control the specific player (block 120).” Response at 10 (quoting Ex. 1101 at 6:10-14, 6:16-22) (also citing *id.*, 6:26-37, 7:4-15). Stated another way, Patent Owner explained how the patent uses “commands in two different formats” by converting “the incoming commands from the mobile device 20 into the correct JavaScript (or other programming) code used by the target [content presentation] device 22.” Response at 21 (quoting Ex.1101, 6:19–22 and citing Ex. 1101, Fig. 1 (depicting “API adapter 26” as a component of “server system 24”)).

Although Patent Owner reserved the right to dispute Petitioner’s claim constructions, Response at 19, it had no need to dispute Petitioner’s implicit construction requiring different first and second formats (with which Patent Owner agreed) and Patent Owner made clear that the “first format” and “second format”

limitations found in the claims should be construed to require two different formats. *Id.* at 20-21, 28. Patent Owner argued that limitation 1D was missing from the prior art because none of the prior art disclosed two messages having the claimed “first format” and “second format.” *Id.* at 20-22, 27-29. For example, for limitation 1D, Patent Owner pointed out that “Danciu does not disclose that the alleged commands have different formats....” *Id.* at 28.

C. The Board in Its Institution Decision Found that the “First” and “Second” Formats Can Be the Same Format.

On July 24, 2024, the Board issued its Institution Decision. It found that the “second, third, and fifth *Fintiv* factors favor denial,” that the “first factor is neutral,” and that the fourth factor “weighs slightly against denial.” Decision at 15; *id.* at 10-14. Because the balance of the first five factors favored discretionary denial, it proceeded to analyze the sixth factor for compelling merits. Decision at 15. After considering this factor, the Board declined to deny institution because it found—with respect to the proposed combination of Danciu and other references—that Petitioner presented a “compelling challenge” for at least independent claims 1, 12, and 17. *Id.* at 16, 43-44.

In reaching that conclusion, the Board found that it did not need to conduct an “express interpretation” of any claim terms. *Id.* at 17. But, with respect to the “first format” and “second format” limitations, it disagreed with “Patent Owner’s position” and found that “claim 1 is not limited to different first and second

formats.” *Id.* at 31. It then relied on that construction to distinguish Patent Owner’s arguments, and found that Petitioner is highly likely to prevail in challenging claims 1, 12, and 17. *Id.* at 31, 33-34, 43.

D. In the District Court Proceedings, the Parties and the Court Agreed that the “First” and “Second” Formats Must Be Different Formats.

Just before the Board’s institution decision, a District Court construed the ’751 patent and concluded that “‘a second format’ must be *different* from ‘a first format.’” Ex. 2024 at 26 (emphasis added). In the submissions to the Court, both Comcast (Petitioner in this proceeding) and Touchstream (Patent Owner in this proceeding) agreed that the “first format” and “second format” must be different formats. *Id.* at 22, 24.

Among the reasons that Petitioner cited for this interpretation was the prosecution history of the ’751 patent, which Petitioner argued “explicitly distinguished the invention” over the prior art “by pointing out that the formats in [the prior art] were not different.” *Id.* at 23 (citing to Ex. 1104 at p. 170 of 893).

II. The Board’s Construction of the “First” and “Second” Formats Is Based on Legal Errors.

Respectfully, the Board’s finding that the claims are not limited to commands with different “first” and “second” “formats” is legal error.

First, although the Board may adopt a claim construction of a “disputed term” that neither party proposes, *Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049,

1057 (Fed. Cir. 2024), here both parties agreed that the “first format” and “second format” refer to different formats, *see supra* §§I.A.-I.B. The Board should not adopt constructions to support institution that were not in dispute and contrary to the constructions agreed to by the parties. *Cf. In re Magnum Oil International, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (The “Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.”).

Adopting *sua sponte* constructions contrary to those agreed to by the parties deprives Patent Owner of its statutory right to respond to the positions set forth in the Petition. 35 U.S.C. § 313 (“patent owner *shall have the right* to file a preliminary response to the petition ... that sets forth reasons why no inter partes review should be instituted *based upon the failure of the petition* to meet any requirement of this chapter.”) (emphasis added). Indeed, Petitioner’s obviousness analysis applied a construction of “first format” and “second format” in which the formats are different. *See supra* §I.A. Moreover, although Petitioner did not offer an explicit construction of any of the claim terms, it contended they “should be given their ordinary and customary meaning to a POSITA, *consistent with the prosecution history, as they would be given in a civil action under 35 U.S.C. § 282(b).*” Petition at 20 (emphasis added). Petitioner submitted the prosecution history as an exhibit, and that prosecution history includes an argument by the

patentee distinguishing the “first format” and “second format” limitations from the prior art because the art does not describe “commands in different formats.” Ex. 1104 at p. 170 of 893. And in parallel district court proceedings, Petitioner argued that this amounted to a clear and unmistakable disclaimer of claim scope requiring different formats. Ex. 2024 at 23.

Thus, by adopting a construction allowing the “first format” and “second format” to be the same, which Petitioner did not argue and with which Petitioner actually disagrees, the Board committed legal error by deviating from the theory of unpatentability presented by the Petition and adopting its own theory of unpatentability. *Sirona Dental Sys. GmbH v. Institut Straumann AG*, 892 F.3d 1349, 1356 (Fed. Cir. 2018) (“It would thus not be proper for the Board to deviate from the grounds in the petition and raise its own obviousness theory.”). As the Supreme Court has confirmed, “the petitioner’s petition, not the Director’s discretion, is supposed to guide the life of the litigation.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 138 S. Ct. 1348, 1356 (2018). As such, the Director, and thereby the Board, does not “enjoy[] a license to depart from the petition and institute a *different* inter partes review of his [or her] own design.” *Id.* (emphasis in original).

Second, Patent Owner respectfully submits that the Board’s construction—a legal conclusion—is incorrect. The Board’s disagreement with Patent Owner’s argument “that the formats of the first and second commands” must “be different”

was based on the doctrine of claim differentiation:

Indeed, claim 3, which depends from claim 1, specifically recites that “the first format is different than the second format.” Our reviewing court has explained that, “[u]nder the doctrine of claim differentiation, dependent claims are presumed to be of narrower scope than the independent claims from which they depend.” *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1242 (Fed. Cir. 2003).

Decision at 31.

The doctrine of claim differentiation, however, “is a guide, not a rigid rule.” *Wi-LAN USA, Inc. v. Apple Inc.*, 830 F.3d 1374, 1391 (Fed. Cir. 2016) (citation and internal quotation omitted). For example, claim differentiation “cannot ‘overcome... a contrary construction dictated by the written description or prosecution history.’” *Id.* at 1391 (quoting *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1359 (Fed. Cir. 2012)). “Nor can claim differentiation apply untethered from the reasonable meaning of the difference in claim language on which it rests.” *Id.* at 1391.

For each of those reasons, the doctrine of claim differentiation does not apply here. The plain claim language differentiates between “a first format” and “a second format,” reciting:

the first computing device...receiving...a first message that includes at least one command in a *first format*, the first message being 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 second computing device....

Ex. 1101 at 11:51, 11:62-65 (emphasis added).

The most reasonable plain meaning for these separately identified “first” and “second” formats is that they are different formats. If the formats were the same, then referring to them as “first” and “second” formats would be stilted and unconventional, and it would improperly render the recitation of a “second format” entirely superfluous if it is no different from the “first format.” *Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1288, n.10 (Fed. Cir. 2017) (“It is highly disfavored to construe terms in a way that renders them void, meaningless, or superfluous.”). Indeed, the “use of the terms ‘first’ and ‘second’ is a common patent-law convention to *distinguish* between repeated instances of an element or limitation.” *3M Innovative Properties Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371 (Fed. Cir. 2003) (emphasis added). This recitation of two separate formats means that they “logically cannot be one and the same.” *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d 1398, 1405 (Fed. Cir. 1996); *see also Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1382 (Fed. Cir. 2022).

Moreover, as described above in Sections I.A. and I.B., both the Petitioner and the Patent Owner cited descriptions in the specification illustrating that the formats are different. And in the prosecution history the applicant distinguished the

“first format” and “second format” limitations from the prior art because the art does not describe “commands in different formats.” Ex. 1104 at p. 170 of 893. This prosecution history confirms the plain meaning: that “a first format” and “a second format” refer to different formats. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc) (“Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent.”). Petitioner agrees. Ex. 2024 at 23. So does a District Court, which analyzed the intrinsic evidence and agreed with both Petitioner and Patent Owner that the terms refer to different formats. *Id.* at 26.

III. On Rehearing, the Board Should Decline to Institute the Petition.

In instituting the proceedings, the Board relied on its construction of “first” and “second” formats to distinguish Patent Owner’s arguments. Decision at 31, 33-34. As a result, the Board declined to exercise its discretion under *Fintiv*, finding that “the Petition presents a compelling challenge at least for independent claims 1, 12, and 17. *Id.* at 16.

As described above, however, the Board’s Decision was based on a construction allowing the “first” and “second” formats to be the same, which was not presented in the Petition and which is legally erroneous. Under the correct construction, which is the construction that was relied on in the Petition and which requires different formats, Petitioner’s proposed obviousness combination fails to

demonstrate “compelling merits” with regard to the required different “first” and “second” formats for the reasons described in Patent Owner’s Preliminary Response.² *See, e.g.*, Response at 20-22, 27-29, 32-35, 37. Because the Board found that the balance of the first five *Fintiv* factors “favor[s] discretionary denial” (Decision at 15) and because no “compelling merits” exist under factor six when applying the correct claim construction, the *Fintiv* factors weigh in favor of discretionary denial. The Board, therefore, should exercise its discretion under *Fintiv* to deny institution. *See, e.g.*, Response at 43-55; Patent Owner Sur-reply, Paper 12, at 1-5.

CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board grant rehearing and deny institution.

² Should the Board alternatively consider Petitioner’s ground based on Aldrey and Mahajan under *Fintiv* factor six, this ground also fails to demonstrate “compelling merits” as shown by the Board’s comments implying potential weakness in this ground. Decision at 45 (issue of whether Petitioner’s reasoning for obviousness is persuasive “will be resolved on a full trial record”), 46 (finding Mahajan’s “disclosure provides *some support* for Petitioner’s position”) (emphasis added).

Dated: August 15, 2024

Respectfully submitted,

/Kyle E. Friesen/

Kyle E. Friesen, Lead Counsel

Registration No. 65,371

Email: kfriesen@shb.com

Robert H. Reckers, Back-up Counsel

Registration No. 54,633

Email: rreckers@shb.com

SHOOK, HARDY & BACON L.L.P.

600 Travis Street, Suite 3400

Houston, TX 77002

Jason R. Mudd, Back-up Counsel

Registration No. 57,700

Email: jmudd@shb.com

Ryan Dykal, Back-up Counsel

Registration No. 63,793

Email: rdykal@shb.com

SHOOK, HARDY & BACON L.L.P.

2555 Grand Blvd.

Kansas City, MO 64108

Ryan D. Dykal, Back-up Counsel

Registration No. 63,793

Email: rdykal@bsfllp.com

BOIES SCHILLER FLEXNER LLP

1401 New York Ave., NW

Washington, DC 20005

*Attorneys for Touchstream
Technologies, Inc.*

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on August 15, 2024, a complete and entire copy of the foregoing document was provided via email to Petitioner's counsel of record as follows:

ComcastIPRService@bannerwitcoff.com
Frederic M. Meeker - fmeeker@bannerwitcoff.com
Paul T. Qualey - pqualey@bannerwitcoff.com
John R. Hutchins - jhutchins@bannerwitcoff.com
John M. Fleming - jfleming@bannerwitcoff.com
Joshua L. Davenport - jdavenport@bannerwitcoff.com

Banner & Witcoff, Ltd.
1100 13th Street, NW Suite 1200
Washington, DC 20005

By: /Kyle E. Friesen/
Kyle E. Friesen
Lead Counsel for Patent Owner
Registration No. 65,371