

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
Patent 11,048,751 B2

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

WORMMEESTER, *Administrative Patent Judge*.

DECISION

Granting Patent Owner's Request on Rehearing of
Decision Granting Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Comcast Cable Communications, LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 11,048,751 B2 (Ex. 1101, “the ’751 patent”). Touchstream Technologies, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 9, (“Prelim. Resp.”). After considering the parties’ arguments and evidence, we instituted an *inter partes* review of the ’751 patent. Paper 13 (“Institution Decision” or “Inst. Dec.”). Patent Owner subsequently filed a Request for Rehearing of our Institution Decision. Paper 16 (“Req. Reh’g”). For the reasons that follow, Patent Owner’s Request for Rehearing is *granted*.

II. BACKGROUND

Petitioner asserted the following three challenges to claims 1–20 of the ’751 patent. Pet. 18, 21–85.

Claims Challenged	35 U.S.C. §	References/Basis
1–20	103(a)	Danciu, ¹ Mahajan ²
1–20	103(a)	Danciu, Mahajan, Calvert ³
1–20	103(a)	Aldrey, ⁴ Mahajan

¹ Danciu et al., U.S. Patent No. 9,490,998 B1, issued Nov. 8, 2016 (Ex. 1112).

² Mahajan et al., U.S. Publ’n No. 2009/0248802 A1, published Oct. 1, 2009 (Ex. 1114).

³ Calvert, U.S. Publ’n No. 2004/0078812 A1, published Apr. 22, 2004 (Ex. 1111).

⁴ Aldrey et al., U.S. Publ’n No. 2009/0172757 A1, published July 2, 2009 (Ex. 1115).

Independent claims 1, 12, and 17 recite similar limitations, including a “first format” and a “second format.” For the two asserted challenges based on Danciu, Petitioner relied on Danciu as teaching or suggesting the recited first and second formats. Pet. 25–32. We found that Petitioner presented compelling evidence of unpatentability as to claims 1, 12, and 17. Inst. Dec. 43–44. Patent Owner requests rehearing on this portion of the Institution Decision.

For the asserted challenge based on Aldrey and Mahajan, we identified potential flaws in Petitioner’s arguments. See Inst. Dec. 44–47. Patent Owner does not request rehearing on this portion of the Institution Decision.

III. STANDARD OF REVIEW

When rehearing a decision, the Board reviews the decision for an abuse of discretion. See 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). “The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must (1) “specifically identify all matters the party believes the Board misapprehended or overlooked” and (2) identify the place “where each matter was previously addressed.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768.

IV. ANALYSIS

With these principles in mind, we address Petitioner’s asserted challenges based on Danciu. For completeness, we also address Petitioner’s asserted challenge based on Aldrey and Mahajan.

A. Asserted Challenges Based on Danciu

In our Institution Decision, we assessed whether to exercise our discretion to deny institution due to the advanced state of parallel litigation, taking into consideration the six factors identified in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), as well as applying guidance set forth in a Memorandum regarding the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” issued by the Director of the U.S. Patent and Trademark Office (hereinafter, “Guidance Memo”).⁵ Inst. Dec. 6–43. We determined that the first five *Fintiv* factors favor discretionary denial,⁶ and that the Petition presents compelling evidence of unpatentability as to independent claims 1, 12, and 17 under the sixth *Fintiv* factor. *Id.* at 15–16, 23–43. Because “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability,” we declined to exercise our discretion to deny. Guidance Memo 5; Inst. Dec. 15–16.

Patent Owner “requests that rehearing be granted based on legal errors related to claim construction, and that institution be denied under *Fintiv*

⁵ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf.

⁶ Our analysis of the first five *Fintiv* factors in our Institution Decision remains undisturbed on rehearing.

based on a lack of ‘compelling merits’ under the correct claim construction.”
Req. Reh’g 2. We address Patent Owner’s arguments in turn.

1. Claim Construction

Claim 1 recites, in part,

the first computing device . . . receiving, from the remote server device, a first message that includes at least one command in a *first format*, the first message being received based 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, 11:62–67 (emphases added). Petitioner designated this limitation as limitation 1D. Pet. 25. As noted above, claims 12 and 17 also recite a “first format” and a “second format.” In our Institution Decision, we determined that the first and second formats are not limited to *different* formats, and that they also encompass the *same* formats. Inst. Dec. 31.

Patent Owner contends that we “misapprehended a legal issue by applying an incorrect claim construction” of the terms “first format” and “second format,” and that we “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.” Req. Reh’g 1. According to Patent Owner, “both the Petitioner and the Patent Owner operated under the same shared premise that the ‘first format’ and the ‘second format’ refer to *different* formats.” *Id.* at 1–2.

Patent Owner asserts that “Petitioner argued to the Board that the ’751 patent claims focus on, among other things, ‘translating’ and ‘convert[ing]’ commands to control media.” Req. Reh’g 4. As an example, Patent Owner points to where Petitioner stated that the server of

the '751 patent “*converts* the commands from the personal computing device *into the correct code* for use on the display device to control the media player.” *Id.* at 5 (quoting Pet. 3 (citing Ex. 1101, 6:4–37)) (emphases added by Patent Owner). Patent Owner also asserts that “[i]n explaining how the prior art allegedly taught [limitation 1D], [Petitioner] focused on how the Danciu reference allegedly ‘reformatted’ a ‘second message’ into the format of the ‘first message.’” *Id.* at 6 (quoting Pet. 27).

Patent Owner further asserts that it similarly “explained how the [’751] 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.’” Req. Reh’g 7 (citing Prelim. Resp. 21 (citing Ex. 1101, 6:19–22, Fig. 1)). Patent Owner adds that, “for limitation 1D, Patent Owner pointed out that ‘Danciu does not disclose that the alleged commands have different formats.’” *Id.* at 8 (quoting Prelim. Resp. 28).

Lastly, Patent Owner asserts that “Petitioner submitted the prosecution history [of the ’751 patent] as an exhibit, and that prosecution history includes an argument by the patentee distinguishing the ‘first format’ and the ‘second format’ limitation from the prior art because the art does not describe ‘commands in different formats.’” Req. Reh’g 10–11 (citing Ex. 1104, 170). Patent Owner notes that “in parallel district court proceedings, Petitioner argued that this amounted to a clear and unmistakable disclaimer of claim scope requiring different formats.” *Id.* at 11 (citing Ex. 2024, 23 (district court claim construction order)). Referring to the instant proceeding before us, Patent Owner also notes that Petitioner “contended [the claim terms] ‘should be given their ordinary and

customary meaning to a [person of ordinary skill in the art], *consistent with the prosecution history, as they would be given in a civil action under 35 U.S.C. § 282(b).*” *Id.* at 10 (quoting Pet. 20) (emphasis added by Patent Owner).

Based on the record before us, we find Patent Owner’s arguments persuasive. We now understand both parties’ respective positions in the Petition and Preliminary Response to have been that the recited first and second formats are limited to *different* formats. In the Petition, Petitioner relied on Danciu for teaching the first and second formats. Pet. 25–27. Petitioner argued that Danciu’s “message from the remote control to the server is . . . ‘a second message including at least one command in a second format having been sent from the associated second computing device,’” and, “[a]fter reformatting the message, the server then sends the claimed ‘a first message that includes at least one command in a first format.’” *Id.* at 27. As Patent Owner points out, Petitioner “focused on how the Danciu reference allegedly ‘reformatted’ a ‘second message’ into the format of the ‘first message.’” Req. Reh’g 6 (citing Pet. 27).

For its part, Patent Owner argued in its Preliminary Response that “Danciu does not disclose that the alleged commands have different formats.” Req. Reh’g 8 (citing Prelim. Resp. 28).

Moreover, Patent Owner admits the “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.’” Req. Reh’g 10–11 (citing Ex. 1104, 170). Patent Owner directs us to that argument:

Applicant submits that Morris is completely silent with regard to “*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.*”

In fact, Morris never describes commands in different formats. . . .

Ex. 1104, 170. According to Patent Owner, “in parallel district court proceedings, Petitioner argued that this amounted to a clear and unmistakable disclaimer of claim scope requiring different formats.” Req. Reh’g 11 (citing Ex. 2024, 23 (district court claim construction order)). Patent Owner does not dispute Petitioner on this point; rather, Patent Owner agrees with Petitioner. *See id.* at 7–8 (“[Patent Owner] 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 10 (“[H]ere both parties agreed that the ‘first format’ and ‘second format’ refer to different formats.”).

The parties’ shared position in this regard is consistent with case law. Our reviewing court has explained that “[t]he prosecution history modifies the scope of a claim term if ‘the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention.’” *Sentry Protection Prods., Inc. v. Eagle Mfg. Co.*, 400 F.3d 910, 915 (Fed. Cir. 2005) (quoting *CCS Fitness, Inc. v. Brunswick Corp.*, 228 F.3d 1359, 1366–67 (Fed. Cir. 2002)).

Although we were unaware of Petitioner’s arguments in parallel district court litigation at the time of the Institution Decision, we note Petitioner acknowledged in its Petition that “Applicant argued that neither Morris nor Mahajan disclose[s] ‘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.’” Pet. 4. Petitioner further cited a portion of the prosecution history that contains the applicant’s disclaimer argument discussed above. *Id.* (citing Ex. 1104, 168–173). As Patent Owner points out, Petitioner additionally argued that all claim terms “should be given their ordinary and customary meaning to a [person of ordinary skill in the art], *consistent with the prosecution history.*” Req. Reh’g 10 (quoting Pet. 20) (emphasis added by Patent Owner). Because Petitioner cited a portion of the prosecution history that reveals the applicant distinguished its claims from the prior art on the basis of *different* first and second formats, we are persuaded that Petitioner understood that the claimed first and second formats are limited to *different* formats. *See* Ex. 1104, 170.

In view of the foregoing, we are persuaded that the proper construction of the claim terms “first format” and “second format” requires the two formats to be different, and that the parties do not dispute this construction.

2. *Compelling Merits*

With this claim construction in mind, we now address whether Petitioner presented compelling evidence of unpatentability for claims 1, 12, and 17. As explained in our Institution Decision, the compelling merits

standard is met when “the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Inst. Dec. 16 (quoting Guidance Memo 4). A challenge can only meet this standard “if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *Id.* (quoting *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential)).

Claim 1 recites,

the first computing device . . . receiving, from the remote server device, a first message that includes at least one command in a *first format*, the first message being received based 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, 11:62–67 (emphases added). Again, claims 12 and 17 recite similar limitations. As part of its analysis, Petitioner provided in the Petition an annotated version of Figure 1 of Danciu, reproduced below. Pet. 26.

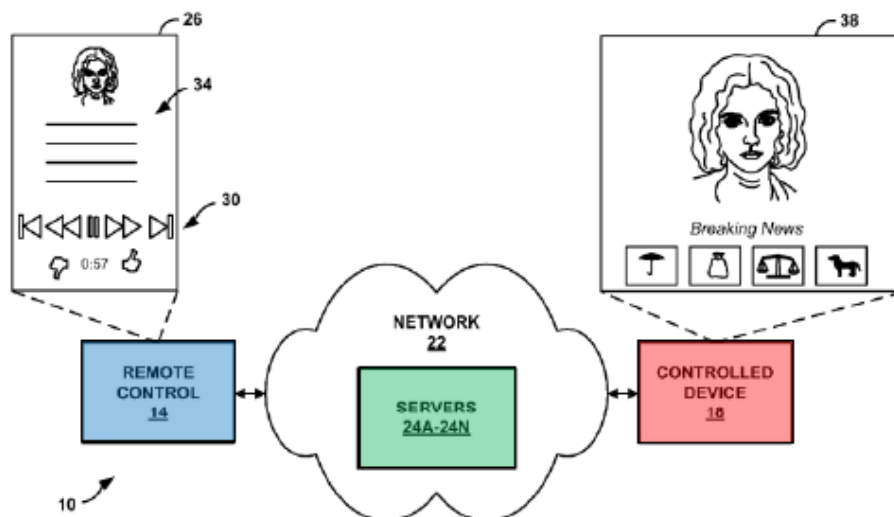


FIG. 1

Figure 1 of Danciu, as annotated by Petitioner, illustrates networked environment 10 with remote control 14 and controlled device 18. *See* Ex. 1112, 4:58–61. Referring to its version of Figure 1, Petitioner asserted that “Danciu’s remote control 14 (**blue**) provides commands (‘fast forward, reverse, skip ahead or back, play, stop, move to new content, etc.’) via servers 24 (**green**) for content being played on controlled device 18 (**red**).” Pet. 25–26 (citing Ex. 1112, 5:29–37, 5:64–6:2, 10:45–53, Fig. 1).

Regarding the claimed first and second formats in particular, Petitioner asserted that “Danciu’s servers ‘route the messages to other members of the session,’” where “there may be separate messages from the remote control to the server, and from the server to the controlled device.” Pet. 27 (citing Ex. 1112, 7:17–20, 16:24–17:43). Petitioner further asserted that, “when receiving a message from the remote control intended for the controlled device, ‘server 24 may process and/or repackage the control information of the message into a new message.’” *Id.* (quoting Ex. 1112, 16:63–67). According to Petitioner, “[t]he message from the remote control to the server is thus ‘a second message including at least one command in a second format having been sent from the associated second computing device,’” and, “[a]fter reformatting the message, the server then sends the claimed ‘a first message that includes at least one command in a first format.’” *Id.*

In its Preliminary Response, Patent Owner countered that whether the control information is processed or repackaged, “the control information from the original message remains unchanged when the ‘new message’ is delivered to the controlled device.” Prelim. Resp. 28. Patent Owner noted Petitioner’s “assert[ion] that messages are reformatted, but not the control

information or any commands.” *Id.* (citing Pet. 27). According to Patent Owner, “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*).” *Id.* at 29.

Based on the record before us, we agree with Patent Owner and find Petitioner’s argument and evidence unpersuasive. As discussed above in the claim construction section, the recited first and second formats are limited to different formats. *See supra* Part IV.A.1. To satisfy this aspect of limitation 1D under its theory, Petitioner needed to show that in Danciu the format of the control information sent from the remote control to the server is different from the format of the control information sent from the server to the controlled device. The cited disclosures in Danciu, however, do not readily teach or suggest that these formats are different. Nor did Petitioner explain adequately how Danciu’s disclosures teach or suggest the two formats are different. We recognize that the control information in Danciu may be “processed” or “repackaged,” as Petitioner asserted, but it is not clear that the control information is processed or repackaged such that the format of the control information sent from the remote control to the server and the format of the control information sent from the server to the controlled device are different.

Petitioner did not rely on Mahajan to teach or suggest the recited first and second formats but relied on Mahajan instead as providing “implementation details for transmission of commands for controlling a client.” Pet. 27. Petitioner contended that its proposed combination of

Danciu and Mahajan would have provided for a system where “Danciu’s remote control would translate commands associated with a first type of media playing application to a generic format, transmit them to the controlled device, which would translate them to a command associated with a second type of media playing application for execution.” *Id.* at 31. In other words, the controlled device would receive the generic commands sent from the remote control and then translate the generic commands. It is not clear how the proposed combination in this way teaches or suggests the format of a command sent from the remote control to a server is different from the format of a command sent from the server to the controlled device.

We note that even if Petitioner were to disagree that the claimed first and second formats require different formats, Petitioner’s case would still fall short of compelling. During prosecution, the applicant distinguished its claims on the basis of different first and second formats. Ex. 1104, 170. In light of the prosecution history, it is unclear why the claims would encompass first and second formats that are the same. We recognize that claim 3 depends from claim 1 and recites that “the first format is different than the second format.” Although “dependent claims are presumed to be of narrower scope than the independent claims from which they depend,” the applicant’s arguments during prosecution undermine such a presumption. *See AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1242 (Fed. Cir. 2003); *Fenner Invs., Ltd. v. Celco P’ship*, 778 F.3d 1320, 1327 (Fed. Cir. 2015) (“Although claim differentiation is a useful analytic tool, it cannot . . . relieve any claim of limitations imposed by the prosecution history.”).

3. Summary

In view of the foregoing, we determine that Petitioner's obviousness challenges based on Danciu do not meet the compelling merits standard with respect to claims 1, 12, or 17. Claims 2–11, 13–16, and 18–20 depend from claims 1, 12, or 17. Petitioner's contentions regarding these dependent claims relied on the same analysis for the limitation of claim 1 discussed above. See Pet. 39–49, 51–54, 56–57. Accordingly, we also determine that Petitioner's obviousness challenges based on Danciu do not meet the compelling merits standard with respect to claims 2–11, 13–16, and 18–20.

B. Asserted Challenge Based on Aldrey and Mahajan

Patent Owner does not request rehearing on the portion of our Institution Decision regarding Petitioner's challenge based on Aldrey and Mahajan. We did not make a finding as to whether Petitioner presented a compelling challenge based on Aldrey and Mahajan. Accordingly, we address this challenge for completeness.

1. Compelling Merits

In particular, we address whether Petitioner presented compelling merits of unpatentability for claims 1, 12, and 17, focusing on the language of claim 1. As noted above, limitation 1D of claim 1 recites,

the first computing device . . . receiving, from the remote server device, a first message that includes at least one command in a *first format*, the first message being received based 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, 11:62–67 (emphases added). For this limitation, Petitioner presented two theories, one based on Aldrey alone and one based on Aldrey combined with Mahajan. Pet. 63–69, 79, 83.

Under its first theory, based on Aldrey alone, Petitioner provided an annotated version of Figure 1 of Aldrey, reproduced below. Pet. 64.

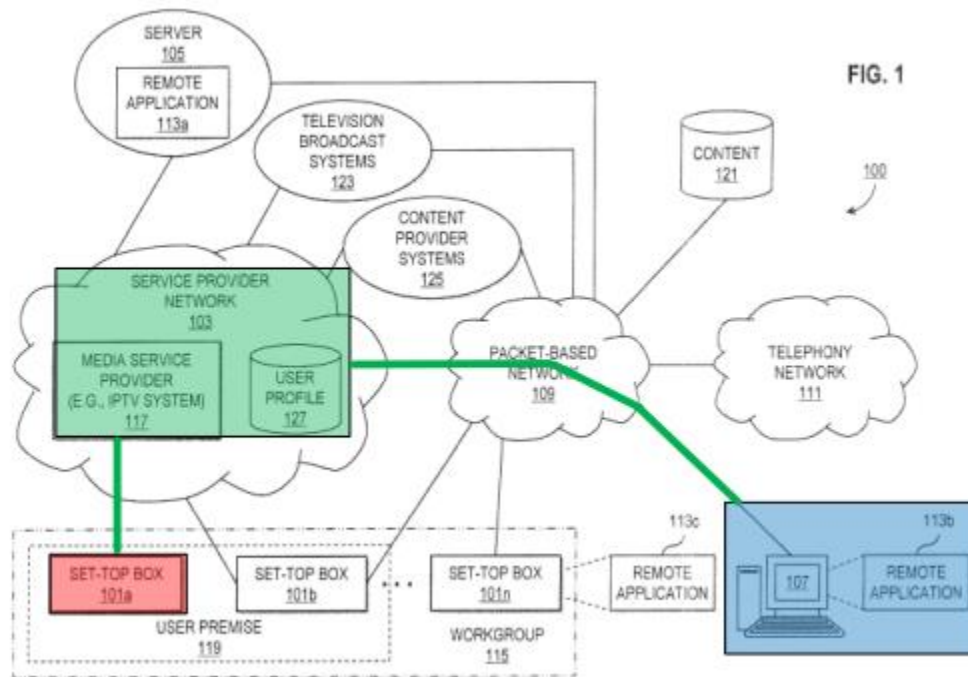


Figure 1 of Aldrey, as annotated by Petitioner, is a diagram of a system for remote set-top box (STB) management. See Ex. 1115 ¶ 4. Petitioner asserted that “Aldrey teaches a STB 101 (**red**) receiving commands from a remote application running on an end terminal 107 (**blue**),” and “that ‘connections [**green**] between the STBs 101a-101n and the end terminal(s) 107 may be established directly or through server 105 and/or MSP 117 [of service provider network 103].” Pet. 63 (citing Ex. 1115 ¶¶ 25, 35–36, 39, 48). Petitioner additionally asserted that “[a] user, who is accessing user interface menus based on the registered information from the STB . . . , may send a set of messages to be received at the STB.” *Id.* at 64

(citing Ex. 1115 ¶¶ 63–67). According to Petitioner, “[t]hese messages, which include a set of commands, satisfy the elements of limitation [1D].” *Id.* Petitioner identified Aldrey’s STB 101 as a “first computing device,” Aldrey’s end terminal 107 as a “second computing device,” and Aldrey’s service provider network 103 as a “remote server device.” *Id.* at 58, 67.

Under its second theory, based on Aldrey and Mahajan, Petitioner further relied on Mahajan “[t]o any extent that Aldrey fails to teach or suggest at least one command in a first format, and at least one command in a second format.” Pet. 64. Petitioner argued that “Mahajan teaches implementation details regarding transmitting commands from a computing device (e.g., [Aldrey’s] end terminal) to a client (e.g., [Aldrey’s] STB).” *Id.* Petitioner asserted that Mahajan’s RTS Media Abstraction module of the client . . . converts the commands received by the client . . . from Mahajan’s server.” *Id.* at 65 (citing Ex. 1114 ¶¶ 37–43, 63, Figs. 1, 3, 5). According to Petitioner, “based on Mahajan’s express teachings that its system can operate in a distributed environment, it would have been obvious to a [person of ordinary skill in the art] that one or more RTS Media Abstraction Modules could operate at a server, such as in [Aldrey’s] Service Provider Network 103.” *Id.* at 66–67. Petitioner added,

Combining Mahajan with Aldrey would have been nothing more than applying a known technique (Mahajan’s system for sending commands) to a known device (Aldrey’s web-based UI control system) ready for improvement to yield predictable results (Aldrey’s end terminal would translate commands associated with a first type of media playing application to a command associated with a second type of media playing application on a STB).
Id. at 68.

In its Preliminary Response, Patent Owner countered that “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*.” Prelim. Resp. 35. Patent Owner also argued that Petitioner “fails to establish a reason for combining the cited teachings of Aldrey and Mahajan in order to achieve the claimed invention.” *Id.* at 36 (citing Pet. 67).

On the record before us, we agree with Patent Owner and find Petitioner’s arguments unpersuasive. As discussed above in the claim construction section, the recited first and second formats of limitation 1D require different formats. *See supra* Part IV.A.1. To satisfy this aspect of limitation 1D under either of Petitioner’s theories, Petitioner needed to show that the format of a command sent from end terminal 107 to network service provider 103 is different from the format of a command sent from network service provider 103 to STB 101. *See* Pet. 64 (annotated Fig. 1 of Aldrey). With respect to Petitioner’s first theory, based on Aldrey alone, Petitioner did not address the format of any command in Aldrey, let alone whether the format of a command sent from the end terminal to the network service provider is different from the format of a command sent from the network service provider to the STB. *See id.* at 63–64. Given Petitioner’s failure to address how Aldrey teaches or suggests the claimed first and second formats, we are unpersuaded that Aldrey alone meets limitation 1D.

We also are unpersuaded that Petitioner’s proposed combination of Aldrey and Mahajan meets limitation 1D under Petitioner’s second theory. In our Institution Decision, we were persuaded by certain aspects of Petitioner’s obviousness arguments, but we also noted potential flaws in

those arguments. *See* Inst. Dec. 45–47. As to Petitioner’s arguments on the claimed first and second formats of limitation 1D in particular, we found the record provided “some support” for Petitioner’s position that “it would have been obvious to a [person of ordinary skill in the art] that one or more RTS Media Abstraction Modules could operate at a server, such as in [Aldrey’s] Service Provider Network 103,” even though Petitioner asserted that Mahajan teaches command conversion at the client. *Id.* at 45–46 (citing Pet. 66–67). Yet assuming Mahajan’s RTS Media Abstraction Module *could* have operated at a server, as Petitioner argued, it is not readily apparent *why* an ordinarily skilled artisan would have considered locating the RTS Media Abstraction Module at a *server* based on Mahajan’s disclosure of command conversion at a *client*. *See also* Pet. 66 (“[I]t would have been obvious to a [person of ordinary skill in the art] that the RTS Media Abstraction Module *could* be located on the client or server.” (emphasis added)). Nor did Petitioner adequately explain *why* an ordinarily skilled artisan would have considered locating Mahajan’s RTS Media Abstraction Module at a server.

We note Petitioner further argued that combining Mahajan and Aldrey would have provided a system where “Aldrey’s end terminal would translate commands associated with a first type of media playing application to a command associated with a second type of media playing application on a STB.” Pet. 68; *see also id.* at 67 (“Mahajan’s server-command teachings could be implemented on Aldrey’s end terminal remote control.”). Arguing that Aldrey’s *end terminal* would translate commands seems inconsistent with Petitioner’s earlier argument for locating command conversion at Aldrey’s *network service provider*. *See id.* at 66–68. Moreover, it is not

readily apparent how command translation by Aldrey's end terminal—rather than Aldrey's network service provider—teaches or suggests the format of a command sent from the end terminal to the network service provider is different from the format of a command sent from the network service provider to the STB. Petitioner did not close these logical gaps, leaving its case short of compelling.

2. Summary

In view of the foregoing, we determine that Petitioner's obviousness challenge based on Aldrey and Mahajan does not meet the compelling merits standard with respect to claims 1, 12, or 17. Claims 2–11, 13–16, and 18–20 depend from claims 1, 12, or 17. Petitioner's contentions regarding these dependent claims relied on the same analysis for the limitation of claim 1 discussed above. *See* Pet. 71–78, 80–81, 84–85. Accordingly, we also determine that Petitioner's obviousness challenge based on Aldrey and Mahajan does not meet the compelling merits standard with respect to claims 2–11, 13–16, and 18–20.

V. CONCLUSION

For the reasons given above, Patent Owner has demonstrated that we misapprehended or overlooked the proper construction of the claim terms “first format” and “second format,” and that we misapprehended or overlooked the parties' shared position on the proper construction of those terms. As described above, we now interpret “first format” and “second format” to refer to different formats. Applying our modified claim interpretation, we determine that none of Petitioner's asserted challenges

presents compelling merits of unpatentability as to any claim of the '751 patent.

As explained above and in our Institution Decision, we assess whether to exercise our discretion to deny *inter partes* review due to the advanced state of parallel litigation based on the six factors identified in *Fintiv* and the guidance set forth in the Guidance Memo. Inst. Dec. 6–43. Here, the first five *Fintiv* factors favor discretionary denial. *Id.* at 15. Moreover, the Petition does not meet the compelling merits standard of the Guidance Memo under the sixth *Fintiv* factor. Accordingly, we determine that discretionary denial is appropriate in view of the related district court litigation. We, therefore, exercise our discretion to deny institution.

VI. ORDER

In consideration of the foregoing, it is
ORDERED that Patent Owner's Request for Rehearing is *granted*;
and
FURTHER ORDERED that the Petition is *denied* and no trial is
instituted.

IPR2024-00324
Patent 11,048,751 B2

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