

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

Denying Petitioner's Request on Rehearing of
Decision Granting Patent Owner's Request on Rehearing of
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.”). Thereafter, 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 (“PO Req. Reh’g”). After considering Patent Owner’s arguments and evidence, we granted Patent Owner’s Request for Rehearing and denied institution. Paper 19 (“Rehearing Decision” or “Reh’g Dec.”). Petitioner then filed a Request for Rehearing of our Rehearing Decision. Paper 20 (“Pet. Req. Reh’g”). For the reasons that follow, Petitioner’s Request for Rehearing is *denied*.

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.” In our Rehearing Decision, we determined that the proper construction of “first format” and “second format” requires the two formats to be different, and that Petitioner did not present compelling evidence of unpatentability as to claims 1–20. Reh’g Dec. 9, 14, 19.

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.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 90 (Nov. 2019) (hereinafter, “CTPG”).⁵ 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); CTPG 90.

With these principles in mind, we address Petitioner’s Request for Rehearing.

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IV. ANALYSIS

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”).⁶ Inst. Dec. 6–43. We determined that the first five *Fintiv* factors favor discretionary denial,⁷ 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 and instituted trial. Guidance Memo 5; Inst. Dec. 15–16.

In our Rehearing Decision, however, we agreed with Patent Owner that we erred in determining the claim terms “first format” and “second format” are not limited to different formats, and determined that the proper construction of these claim terms indeed requires the two formats to be different formats. Reh’g Dec. 5–9, 19. Applying the proper construction, we further determined that none of Petitioner’s asserted challenges presents compelling merits of unpatentability as to any claim of the ’751 patent,

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

⁷ Our analysis of the first five *Fintiv* factors in our First Institution Decision remains undisturbed on rehearing.

contrary to our initial determination in the Institution Decision. *Id.* at 19–20. Having determined that the first five *Fintiv* factors favor discretionary denial, and that the Petition does not meet the compelling merits standard of the Guidance Memo under the sixth *Fintiv* factor, we modified our decision and denied institution on rehearing. *Id.* at 20.

Petitioner now “requests that the Board reverse the rehearing decision and denial of institution because it is improperly premised on an argument not raised in Patent Owner’s . . . Preliminary Response.” Pet. Req. Reh’g 1. Petitioner argues that “in granting rehearing and reversing its prior institution decision, the Board overlooked that the claim construction arguments raised by [Patent Owner] in its Rehearing Request were not previously addressed in the [Preliminary Response] (and thus should not have been permitted on rehearing) and that the Petition demonstrated that the claims are obvious in view of the prior art grounds even under this new claim construction.” *Id.* at 4. We address Petitioner’s arguments in turn.

A. 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 Rehearing Decision, we

determined that the recited first and second formats are limited to *different* formats. Reh’g Dec. 9.

In its rehearing request, Petitioner argues that “[f]ollowing institution, [Patent Owner] raised claim construction *for the first time* in its [Rehearing] Request,” and that “[t]he Board erred by considering this new argument on rehearing.” Pet. Req. Reh’g 4. According to Petitioner, we overlooked that the claim construction argument in Patent Owner’s rehearing request was not previously addressed in the Preliminary Response. *Id.*

As support, Petitioner contends that Patent Owner “chose to rebut Petitioner’s argument regarding Danciu-Mahajan teaching commands in first and second formats by alleging that *the source* of those commands was inconsistent with the claims, *without* arguing for any particular construction regarding formats.” Pet. Req. Reh’g 4 (citing Prelim. Resp. 26); *see also id.* at 4–7 (reiterating that Patent Owner did not raise claim construction in the Preliminary Response).

We disagree. In its rehearing request, Patent Owner pointed us to where it argued in the Preliminary Response that “Danciu does not disclose that the alleged commands have different formats.” PO Req. Reh’g 8 (quoting Prelim. Resp. 28) (emphasis with underlining added). That argument indicates Patent Owner’s position that the recited first and second formats are limited to different formats. Patent Owner also cited other portions of the Preliminary Response that address its claim construction position. *Id.* (citing Prelim. Resp. 27–29). For example, Patent Owner argued in the Preliminary Response that “Danciu does not disclose *commands in multiple formats* at all.” Prelim. Resp. 27 (emphasis with underlining added) (cited by PO Req. Reh’g 8). Patent Owner also argued in

the Preliminary Response that “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 (emphasis with underlining added) (cited by PO Req. Reh’g 8).

Petitioner further contends that Patent Owner “*conceded* it raised no argument as to claim construction in the [Preliminary Response].” Pet. Req. Reh’g 5. Petitioner points specifically to where Patent Owner argued in its rehearing request that “it had no need to dispute Petitioner’s implicit construction requiring different first and second formats.” *Id.* (quoting PO Req. Reh’g 7–8). Petitioner adds that “there was no implicit construction and [Patent Owner] misrepresents the Petition in this regard as the Petition stated that ‘all claim terms herein should be given their ordinary and customary meaning to a [person of ordinary skill in the art].’” *Id.* (quoting Pet. 20). According to Petitioner, it “never raised an argument that such a reading was *required* in the independent claims, but addressed this narrow interpretation because it was one construction that the district court could adopt (and is explicitly required by certain dependent claims).” *Id.* at 6.

We disagree with Petitioner. Patent Owner’s argument that “it had no need to dispute *Petitioner’s implicit construction*” does not amount to a concession that Patent Owner “raised *no argument* as to claim construction in the [Preliminary Response].” *See* PO Req. Reh’g 7–8 (emphasis added); Pet. Req. Reh’g 5 (emphasis added). Indeed, Patent Owner expressly argued in the Preliminary Response that the asserted prior art “does not disclose that

the alleged *commands* have *different formats*.” Prelim. Resp. 28 (second emphasis added).

Likewise, Petitioner’s contention that “there was no implicit construction” in the Petition does not take away from the fact that Patent Owner addressed its claim construction position in the Preliminary Response. *See* Pet. Req. Reh’g 5. Whether or not there was an implicit construction in the Petition, Patent Owner expressly argued in the Preliminary Response that the asserted prior art “does not disclose that the alleged *commands* have *different formats*.” Prelim. Resp. 28 (second emphasis added).

We note that Petitioner focuses on the Preliminary Response. Patent Owner additionally relied on the Petition, however, to support its rehearing request. *See* 37 C.F.R. 42.71(d) (“The [rehearing] request must specifically identify . . . the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.”). For example, Patent Owner pointed us to where Petitioner argued in the Petition that “all claim terms herein should be given their ordinary and customary meaning to a [person of ordinary skill in the art], *consistent with the prosecution history*.” PO Req. Reh’g 10 (quoting Pet. 20). Patent Owner also asserted that “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.’” *Id.* (citing Ex. 1104, 170). According to Patent Owner, our Institution Decision “was based on a construction allowing the ‘first’ and ‘second’ formats to be the same, . . . which is legally erroneous.” *Id.* at 14.

Contrary to Petitioner’s position, Patent Owner met its burden of showing that our Institution Decision should be modified. In our Institution Decision, we relied on claim differentiation when we determined that claim 1 is not limited to different first and second formats. Inst. Dec. 31. We did not consider the prosecution history, which was part of the record. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (“[W]e have held that a court ‘should also consider the patent’s prosecution history, if it is in evidence.’”). As we noted in our Rehearing Decision, however, the Federal Circuit 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.’” Reh’g Dec. 8 (quoting *Sentry Protection Prods., Inc. v. Eagle Mfg. Co.*, 400 F.3d 910, 915 (Fed. Cir. 2005)). The Federal Circuit also has explained that “[a]lthough claim differentiation is a useful analytic tool, it cannot . . . relieve any claim of limitations imposed by the prosecution history.” *Id.* at 13 (quoting *Fenner Invs., Ltd. v. Celco P’Ship*, 778 F.3d 1320, 1327 (Fed. Cir. 2015)). In other words, we erred in not considering the prosecution history, which led to our erroneous conclusion that claim 1 is not limited to different first and second formats. *See* Ex. 1104, 170 (prosecution history). Our Institution Decision was based on this erroneous conclusion of law, as Patent Owner argued, and we modified it accordingly.

Petitioner does not point to anything that demonstrates we misapprehended or overlooked a matter regarding claim construction in our Rehearing Decision.

B. Compelling Merits

In our Rehearing Decision, we applied our modified claim construction of “first format” and “second format,” and determined that none of Petitioner’s asserted challenges presents compelling merits of unpatentability as to any claim of the ’751 patent.

1. Standard of Review

Petitioner argues that “[t]he Board erred by applying a ‘compelling merits’ standard *de novo* based on new arguments raised for the first time in [Patent Owner’s] Rehearing request and failed to place the burden on [Patent Owner] as required by regulation.” Pet. Req. Reh’g 7; *see also id.* at 8 (arguing that “37 C.F.R. § 42.71(d) requires that any question of whether the claim constructions set forth in the institution decision are correct, or whether the art teaches those constructions, be addressed in the post-institution Response and Reply because they were not addressed by the [Patent Owner] in the [Preliminary Response]”). According to Petitioner, “the Board erred in its discussion regard[ing] claim construction of the terms ‘first format’ and ‘second format’” because “on a Request for Rehearing the Board was required to place the burden on [Patent Owner] to identify where in the [Preliminary Response] it had argued claim construction, and the Board failed to do so.” *Id.* Petitioner adds that “the Board erred in reconsidering the Petition *de novo* in view of the new construction” because doing so “does not properly place the burden on [Patent Owner] to show what ‘the Board misapprehended or overlooked’ in previously finding that Petitioner’s argument met the compelling merits standard.” *Id.* at 7–8.

We disagree. As Petitioner indicates, when rehearing a decision on institution, we do not review the merits of the decision *de novo* but instead review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). Patent Owner’s rehearing request identified where Patent Owner argued in the Preliminary Response that “Danciu does not disclose that the alleged commands have *different formats*.” PO Req. Reh’g 8 (emphasis added) (quoting Prelim. Resp. 28). This argument in the Preliminary Response addresses Patent Owner’s position that we misapprehended or overlooked the proper claim construction of “first format” and “second format.” It also addresses Patent Owner’s position that we misapprehended or overlooked the fact that the asserted prior art does not disclose different formats, as required by the proper construction of the claims. Patent Owner additionally pointed to the Petition and prosecution history to support its positions. As discussed above, Patent Owner demonstrated that our Intuition Decision was based on an erroneous conclusion of law because we misapprehended or overlooked a matter, and we modified our decision accordingly. We modified our decision based on our review for an abuse of discretion, not a *de novo* review on the merits. Petitioner does not point to anything that shows we misapprehended or overlooked a matter regarding our review for an abuse of discretion in our Rehearing Decision.

We note Petitioner’s argument that “[f]ollowing 37 C.F.R. § 42.71(d) would also allow the parties the opportunity to examine issues beyond those considered by the district court,” such as “claim differentiation in view of claim 3.” Pet. Req. Reh’g 8. Petitioner does not identify where in the papers this matter was addressed. We could not have misapprehended or overlooked a matter that was not previously addressed.

2. Asserted Challenge Based on Danciu and Mahajan

Turning to the merits of the case, Petitioner argues in its rehearing request that it “raised several arguments [in the Petition] for why Danciu in view of Mahajan (with or without Calvert) teaches a ‘first format’ and a ‘second format’ as claimed.” Pet. Req. Reh’g 9. For example, Petitioner contends it relied on Mahajan for teaching the first and second formats. *Id.* at 10. Petitioner asserts that, “[w]ith regard to claim 1, the Petition describes how Mahajan teaches platform-specific commands (i.e., a first format) that were translated from generic commands (i.e., a second format).” *Id.* (citing Pet. 27–29).

This contention is unpersuasive. Petitioner cites pages 27 through 29 of the Petition as support but does not point to where in those pages (or elsewhere in the Petition) it specifically identified Mahajan’s platform-specific commands as the recited first format or Mahajan’s generic commands as the recited second format. *See* 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”). Nor do we readily discern any discussion to that effect. We could not have misunderstood or overlooked a matter that was not previously addressed.

Petitioner also contends the Board did not address Petitioner’s arguments for claims 2, 3, 5, and 6, which “make clear that the Board erred when it asserted that ‘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. Req. Reh’g 10 (citing Reh’g Dec. 12).

We are not persuaded by this contention. Our statement regarding Petitioner’s reliance on Mahajan concerned specifically independent claims 1, 12, and 17, not dependent claims 2, 3, 5, or 6. Reh’g Dec. 9 (“[W]e now address whether Petitioner presented compelling evidence of unpatentability for claims 1, 12, and 17.”); *id.* at 9–13 (analysis). With respect to claim 1, Petitioner asserted in the Petition that “[t]o any extent that Patent Owner argues that Danciu does not explicitly disclose *implementation details* for transmission of commands for controlling a client, this would have been obvious to a [person of ordinary skill in the art] in view of Mahajan.” Pet. 27 (emphasis added); *see also* Pet. Req. Reh’g 10 (“Petitioner explains that, to any extent implementation details are not disclosed, they are taught by Mahajan.”). In Petitioner’s own words, it relied on Mahajan for “implementation details.” Petitioner does not point to anything that demonstrates we misapprehended or overlooked a matter.

According to Petitioner, “the Petition as a whole makes clear how the alleged limitation [1D] is taught.” Pet. Req. Reh’g 12. Petitioner points to its analysis of claims 2, 3, 5 and 6 as support. With respect to claim 2, Petitioner argues that in the Petition it “state[d] that ‘[a]s discussed . . . regarding limitation [1D], Danciu-Mahajan and Danciu-Mahajan-Calvert teach[] a system wherein *commands are translated between universal and platform-specific formats for transmission to a client device.*’” *Id.* at 11 (citing Pet. 39).

Petitioner’s argument is not persuasive. For limitation 1D, we noted in our Rehearing Decision that Petitioner asserted its proposed combination of Danciu and Mahajan would have provided 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.” Reh’g Dec. 12–13 (quoting Pet. 31). That is, Danciu’s “controlled device would receive the generic commands sent from the remote control and then translate the generic commands.” *Id.* at 13. We explained, “[i]t 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.” *Id.* Petitioner does not point to anything in its analysis of claim 2 that demonstrates we misapprehended or overlooked a matter. Indeed, translating commands between universal and platform-specific formats for transmission to a client device by itself does not adequately show that the format of a command sent from Danciu’s remote control to a server is different from the format of a command sent from the server to the controlled device. *See* Pet. Req. Reh’g 11 (citing Pet. 39).

With respect to claim 3, Petitioner simply says the Petition’s “discussion of claim 3 makes clear that the focus of the argument is on ‘separate messages from the remote control to the server, and from the server to the controlled device.’” Pet. Req. Reh’g 11 (citing Pet. 40). In that discussion, Petitioner asserted that “Danciu contemplates that there may be separate messages from the remote control to the server, and from the server to the controlled device.” Pet. 40. 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.*

This argument also is unpersuasive. In our Rehearing Decision, we addressed a similar argument regarding claim 1. We explained “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.” Reh’g Dec. 12. Petitioner does not point to anything in its analysis of claim 3 that demonstrates we misapprehended or overlooked a matter.

With respect to claim 5, Petitioner argues “[c]laim 5 explicitly requires conversion, and the Petition makes clear that the conversion in the combination occurs ‘on an intermediary device,’ namely ‘at a server, such as in [Danciu’s] Servers 24A-24N.’” Pet. Req. Reh’g 11 (citing Pet. 43). In the Petition, Petitioner asserted that “Mahajan describes its system as operating using a ‘collaboration media abstraction layer 130’ that is responsible for translating commands,” and that “Mahajan further states that the distribution manager 418 and multimedia component 446, which comprise the RTS Media Abstraction modules, can make use of a ‘virtual channel connection’ as part of a ‘distributed topology.’” Pet. 43. According to Petitioner, “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 [Danciu’s] Servers 24A-24N.” *Id.*

Petitioner’s argument is not persuasive. Claim 5 depends from claim 1. As discussed above with respect to limitation 1D, Petitioner asserted that its proposed combination of Danciu and Mahajan would have provided 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.” Reh’g Dec. 12–13 (quoting Pet. 31). In other words, both Danciu’s remote control and controlled device translate commands. With respect to claim 5, Petitioner asserted that Mahajan’s abstraction module *could* operate at Danciu’s server. Pet. 43. Even if Mahajan’s abstraction module (which translates commands) *could* operate at Danciu’s server, Petitioner does not adequately explain *why* an ordinarily skilled artisan would have had reason to modify Danciu’s system to locate Mahajan’s abstraction module at the server, especially where both Danciu’s remote control and controlled device already translate commands. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). Petitioner does not point to anything in its analysis of claim 5 that demonstrates we misapprehended or overlooked a matter.

With respect to claim 6, Petitioner argues that its discussion in the Petition “makes clear that Petitioner is arguing for processing a command by translating it, at server, in order to send the command to the controlled device.” Pet. Req. Reh’g 11. As support, Petitioner points us to where it said in the Petition,

Thus, when a user selects content, information on the corresponding media player may be included with the command selecting the content (“at least one command in the second format”) in the message from remote control to the controlled device (“the second message”), in **processing/formulating the command from the remote control by the server into a**

command to send to the controlled device (“at least one command in the first format”), that command may be selected based on the information about the corresponding media player (“a reference to the first media player application”). Ex. 1102, ¶ 190.

Id. (quoting Pet. 45).

Petitioner’s argument is unpersuasive. The mere fact that “*Petitioner is arguing* for processing a command by translating it” does not carry the day. Petitioner does not identify where the asserted prior art teaches “processing/formulating the command.” Moreover, even if we were to find the command is processed or formulated, as Petitioner asserts, it is not clear that the command is processed or formulated at Danciu’s server in such a way that the format of the command sent from the remote control to the server and the format of the command sent from the server to the controlled device are different. *See* Ex. 1101, claims 1 & 6. Petitioner does not point to anything in its analysis of claim 6 that demonstrates we misapprehended or overlooked a matter.

3. Asserted Challenge Based on Aldrey and Mahajan

Petitioner argues in its rehearing request that “[t]he Board’s analysis of the Aldrey-Mahajan ground begins with a significant error, leading to an additional misreading of the Petition.” Pet. Req. Reh’g 12. In our Rehearing Decision, we addressed Petitioner’s arguments for limitation 1D based on Aldrey alone as well as Petitioner’s arguments for limitation 1D based on Aldrey and Mahajan. Reh’g Dec. 14–16. Petitioner contends in its rehearing request that its challenge is based on “Aldrey *in view of Mahajan*,” that “there is no argued ground citing Aldrey alone,” and that the “[t]he

Board apparently bifurcated Petitioner’s argument, thus failing to properly consider it.” Pet. Req. Reh’g 12–13.

We disagree. Petitioner asserted in its Petition that “Aldrey teaches the elements of limitation 1[D],” and presents arguments to support its position. Pet. 63. Thereafter, Petitioner asserts that “[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, this is taught by Mahajan,” and presents arguments to support its position in that regard. *Id.* at 64. By Petitioner’s very own words, Petitioner presents two theories regarding limitation 1[D], one based on Aldrey alone and one based on Aldrey and Mahajan. We addressed both theories, including Petitioner’s reliance on Aldrey for teachings about the system architecture as well as Petitioner’s “reli[ance] on Mahajan ‘to teach or suggest at least one command in a first format, and at least one command in a second format’ by teaching ‘implementation details regarding transmitting commands from a computing device (e.g., an end terminal) to a client (e.g., a STB)’ wherein the commands are converted ‘at a server, such as in Service Provider Network 103.’” Reh’g Dec. 14–19; *see* Pet Req. Reh’g 12–13, 13 n.1 (arguing “[i]t is improper for the Board to view the teachings of a reference in isolation rather than in the context of a combination asserted in a Petition”). Petitioner does not point to anything in its analysis under either theory that demonstrates we misapprehended or overlooked a matter.

Petitioner further argues that “the Board again failed to consider Petitioner’s Aldrey-Mahajan argument regarding dependent claims 2–3 and

5–6.”⁸ Pet. Req. Reh’g 13. With respect to claim 2, Petitioner argues in the Petition that “[a]s discussed . . . regarding limitation [1D], Aldrey-Mahajan teaches a system wherein commands are translated into a universal format for transmission to a client device.” *Id.* at 14 (quoting Pet. 71).

Petitioner’s argument is not persuasive. For limitation 1D, we explained in our Rehearing Decision that Petitioner did not adequately explain *why* an ordinarily skilled artisan would have considered locating Mahajan’s abstraction module at a server like Aldrey’s network service provider 103, even if it would have been obvious to an ordinarily skilled artisan that the abstraction module *could* operate at the server. Reh’g Dec. 18 (“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 Kahn*, 441 F.3d at 988 (“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”).

We also noted Petitioner asserted that its proposed combination of Aldrey and Mahajan would have provided a system where “Aldrey’s end terminal would translate commands associated with a first type of a media playing application to a command associated with a second type of media playing application on a STB.” Reh’g Dec. 18 (quoting Pet. 68). In our

⁸ Petitioner does not further address claims 5 and 6 with respect to its challenge based on Aldrey and Mahajan in its rehearing request. Accordingly, we do not address claims 5 and 6 with respect to Petitioner’s challenge based on Aldrey and Mahajan.

view, Petitioner's argument that Aldrey's *end terminal* would translate commands seems inconsistent with Petitioner's argument about locating Mahajan's abstraction module (which translates commands) at Aldrey's *network service provider*. *Id.* We additionally said it was not clear how command translation by Aldrey's *end terminal* 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. *Id.* at 18–19.

Petitioner does not point to anything in its analysis of claim 2 that demonstrates we misapprehended or overlooked a matter.

With respect to claim 3, Petitioner points us to where it argued in the Petition that “the message formatted for an application on the portable device is in the second format, and the message formatted for an application on the STB is in the first format different from the second format.” Pet. Req. Reh'g 13 (citing Pet. 72).

We are not persuaded. Petitioner's argument in the Petition about claim 3 by itself does not sufficiently explain how the proposed combination of Aldrey and Mahajan teaches or suggests the format of a command sent from Aldrey's end terminal to the network service provider is different from the format of a command sent from the network service provider to the STB. Even if it did, we note Petitioner reiterates that it would have been obvious to an ordinarily skilled artisan that Mahajan's abstraction module *could* operate at a server like Aldrey's service provider network 103. Pet. 71. Again, Petitioner does not adequately explain *why* an ordinarily skilled artisan would have considered locating Mahajan's abstraction module at a server like Aldrey's network service provider 103, even if it would have

been obvious that the abstraction module *could* operate at the server. *See id.* Petitioner points to nothing in its analysis of claim 3 that demonstrates we misapprehended or overlooked a matter.

Regarding both claims 2 and 3, we recognize that Petitioner adds in its rehearing request that “Mahajan teaches two conversions – conversion from a server-command to a universal command, and then conversion from the universal command to a client-command.” Pet. Req. Reh’g 13–14 (citing Pet. 28–29). Petitioner further asserts that “[t]he Board thus appears to never consider Petitioner’s argument that a remote end terminal may convert a command into a universal command, and then that command may be converted into a command specific to a STB on an RTS Media Abstraction module at a server, as clarified by Petitioner’s discussion of claims 2–3.” *Id.* at 14.

Petitioner’s argument is unpersuasive. Regarding Mahajan’s two conversions, Petitioner cites its analysis for the challenge based on Danciu and Mahajan. Pet. Req. Reh’g 13 (citing Pet. 28–29 (discussing challenge based on Danciu and Mahajan)). Petitioner does not clearly discuss two conversions at all, let alone Mahajan’s two conversions, in its analysis of claims 2 or 3 for its challenge based on Aldrey and Mahajan. *See* Pet. 71–72. We could not have misapprehended or overlooked a matter that was not previously addressed.

Lastly, Petitioner argues “the Board erred by failing to properly consider the references in concluding that ‘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*.’” Pet. Req. Reh’g 14. Petitioner faults our “rigid

application of ‘server,’” which it says contradicts Mahajan’s teaching that “the terms server and client as used . . . do not connote any relative capabilities of the two devices.” *Id.* at 14–15 (emphasis in bold omitted) (citing Reh’g Dec. 18; Ex. 1114 ¶ 18).

Petitioner’s argument is unpersuasive, regardless of the presence or absence of a “rigid application of ‘server.’” As we pointed out in our Rehearing Decision, Petitioner only alleges that it would have been obvious to an ordinarily skilled artisan that Mahajan’s abstraction module *could* operate at a server. Reh’g Dec. 18. The Federal Circuit has explained that “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 invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). Petitioner does not adequately explain *why* an ordinarily skilled artisan would have considered locating Mahajan’s abstraction module at a server, even if the abstraction module *could* operate at the server. *See* Reh’g Dec. 18; *see also* Pet. Req. Reh’g 15 (“[A]s argued in the Petition, Mahajan teaches that a ‘collaboration media abstraction layer 130,’ shown as being in network 106 rather than at Mahajan’s server or client, *can* perform the translation of the commands.”). Nothing Petitioner points to demonstrates that we misapprehended or overlooked a matter.

V. CONCLUSION

For the reasons given above, Petitioner does not persuade us that we overlooked or misapprehended any matter, or sufficiently show that denying institution was an abuse of discretion.

VI. ORDER

In consideration of the foregoing, it is
ORDERED that Petitioner's Request for Rehearing is *denied*.

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