

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00325
Patent 11,086,934

**PETITIONER'S REPLY TO THE PATENT OWNER'S
PRELIMINARY RESPONSE**

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EXHIBITS

Previously Submitted:

Ex. 1001:	U.S. Pat. No. 11,086,934 (“the ’934 Patent”)
Ex. 1002:	Expert Declaration of David B. Lett
Ex. 1003:	Curriculum Vitae of David B. Lett
Ex. 1004:	Certified Prosecution History of the ’934 Patent
Ex. 1005:	U.S. Pat. No. 8,660,545 (“Redford”)
Ex. 1006:	U.S. Pub. No. 2008/0235588 (“Gonze”)
Ex. 1007-17:	Reserved
Ex. 1018:	U.S. Pub. No. 2006/0107299 (“Bartfeld”)
Ex. 1019:	Reserved
Ex. 1020:	Joint Claim Construction Statement, <i>Touchstream Technologies, Inc. v. Google LLC</i> , 6:21-cv-00569-ADA (WDTX) (Feb. 8, 2022)
Ex. 1021:	Exhibit 1 to Joint Disputed Claim Terms Charts, <i>Touchstream Technologies, Inc. v. Vizbee, Inc.</i> , 1:17-cv-06247-PGG-KNF (SDNY) (Aug. 6, 2018)
Ex. 1022:	Jury Instructions, <i>Touchstream Technologies, Inc. v. Google LLC</i> , 6:21-cv-00569-ADA (WDTX) (July 21, 2023)
Ex. 1023-29:	Reserved
Ex. 1030:	U.S. Pub. No. 2002/0104096 (“Cramer”)
Ex. 1031:	U.S. Pat. No. 7,356,575 (“Shapiro”)
Ex. 1032:	U.S. Pat. No. 7,269,842 (“Estipona”)
Ex. 1033:	U.S. Pub. No. 2004/0267899 (“Rahman”)
Ex. 1034:	U.S. Pub. No. 2004/0098533 (“Henshaw”)

- Ex. 1035: U.S. Pub. No. 2004/0172656 (“Kim”)
- Ex. 1036: Reserved
- Ex. 1037: U.S. Pat. No. 7,343,419 (“Robinson”)
- Ex. 1038-40: Reserved
- Ex. 1041: CODING OF MOVING PICTURES AND AUDIO, *MPEG-4 Overview* (Int’l Org. Standardisation 2002)
- Ex. 1042: ROBERT GODWIN-JONES, DIGITAL VIDEO UPDATE: YOUTUBE, FLASH, HIGH-DEFINITION, 11 LANGUAGE LEARNING & TECH. 16, 17 (2007)
- Ex. 1043: John C. Paolillo et al., *A Network View of Social Media Platform History: Social Structure, Dynamics and Content on YouTube*, PROC. 52ND HAWAII INT’L CONF. ON SYS. SCIS., 1, (2019)
- Ex. 1044: *YouTube Opens Internet Video to Masses; Serving 3 Million Videos Daily and Growing, YouTube Unveils a Fast, Fun, and Easy Service for Consumers to Broadcast Original Video*, MARKET WIRE, Dec. 15, 2005
- Ex. 1045: *Hulu Debuts via Private Beta and on Distribution Partners AOL, Comcast, MSN, MySpace and Yahoo!; Company Announces Major Licensing Deals with Metro-Goldwyn-Mayer Studios Inc. and Sony Pictures Television; Providence Equity Partners Makes Strategic Investment in News Corporation/NBC Universal Online Video Joint Venture*, BUS. WIRE, Oct. 29, 2007
- Ex. 1046: *Blockbuster Offers Cheaper Online Rental*, ASSOCIATED PRESS, Jun. 13, 2007
- Ex. 1047: *Adobe Delivers Flash Player 9 With H.264 Video Support; HD Quality Web Video and Audio Now Available With Adobe Flash Player Update*, BUS. WIRE, Dec. 4, 2007
- Ex. 1048: *Microsoft Unveils Silverlight to Power the Next Generation of Media Experiences on the Web; Leading Media Companies and Solution Providers Announce Support for New Solution for*

Video and Interactivity on Mac- and Windows-Based Web Browsers, PR NEWSWIRE US, Apr. 16, 2007

- Ex. 1049: *Former Apple Multimedia Pioneers Unveil WebTV; New Company Brings Internet to Television Viewers*, PR NEWSWIRE, Jun. 12, 1996
- Ex. 1050: *Netflix, TiVo Team Up After 4-Year Courtship*, ASSOCIATED PRESS, Oct. 30, 2008
- Ex. 1051: *TiVo and Amazon.com Announce New Service Enabling Amazon Unbox Video Download to TiVo; TiVo Subscribers Will Soon Be Able to Watch Amazon Unbox Movies and TV Shows on Their TVs*, BUS. WIRE, Feb. 7, 2007
- Ex. 1052: *Wall Crumbling Between Televisions and Computers*, AGENCE FRANCE PRESSE – ENGLISH, Jan. 8, 2009
- Ex. 1053: *ENHANCED TV BINARY INTERCHANGE FORMAT 1.0, ETV (OpenCable Specifications)*, Nov. 25, 2009)
- Ex. 1054: *Award-Winning Sonos™ Digital Music System Begins Shipping to Customers*, PR NEWSWIRE US, Jan. 27, 2005
- Ex. 1055: *Sonos Introduces the Sonos™ ZonePlayer ZP80*, PR NEWSWIRE, Jan. 4, 2006
- Ex. 1056: *Sonos Introduces the Sonos Controller for iPhone; Free Application Lets Music Lovers Control Leading Multi- Room Music System from Their iPhone*, PR NEWSWIRE, Oct. 28, 2008
- Ex. 1057: *AT&T Opens R&D Lab in Cambridge, England*, BUS. WIRE, Feb. 10, 1999
- Ex. 1058: *Microsoft Releases Windows NT 4.0 Terminal Server Edition*, M2 PRESSWIRE, Jun 16, 1998
- Ex. 1059: *TeamViewer: TeamViewer 3.0 Beta Published; Next Generation of the Popular Remote Support Software*, M2 PRESSWIRE, Aug. 27, 2007

- Ex. 1060: *3am Labs Announces \$10 Million Series A Financing; McNamee Lawrence & Co. Acts as Exclusive Financial Advisor to 3am Labs*, BUS. WIRE, Nov. 16, 2004
- Ex. 1061: *Expertcity's GoToMyPC Product Wins A People's Choice Award At Upside Events' Showcase 2001*, INTERNET WIRE, Feb. 1, 2001
- Ex. 1062: *TV2Me(R) Goes Global By Partnering With Leading Asian Online Entertainment Company; Manila-Based ESL Adds Sales and Marketing Muscle to Bring Pioneering Place Shifting Technology to Wider Market*, PR NEWSWIRE US, May 16, 2006
- Ex. 1063: *CES Innovations 2005 Award and Red Herring Finalist for 100 Most Innovative Companies are Latest Commendations for Sling Media*, BUS. WIRE, Nov. 11, 2004
- Ex. 1064: Final Written Decision, IPR2022-00795 (Sep. 27, 2023)
- Ex. 1065: Patent Owner Response, IPR2022-00795 (Jan. 13, 2023)
- Ex. 1066: Reserved
- Ex. 1067: *Progressive Networks Launches the First Commercial Audio-On-Demand System Over the Internet*, BUS. WIRE, Apr. 10, 1995
- Ex. 1068: *Progressive Networks' RealVideo Launched With Wide Industry Support*, PR NEWSWIRE EUROPE, February 10, 1997
- Ex. 1069: Reserved
- Ex. 1070: U.S. Pat. Application No. 61/477,998
- Ex. 1071: U.S. Pat. No. 8,904,289 to Strober (“the ’289 Patent”)
- Ex. 1072: Certified Copy of Prosecution History of U.S. Pat No. 8,904,289
- Ex. 1073: U.S. Pat. No. 9,767,195 to Strober (“the ’195 Patent”)
- Ex. 1074: Certified Prosecution History for U.S. Patent No. 9,767,195
- Ex. 1075: U.S. Pat. No. 11,048,751 to Strober (“the ’751 Patent”)

- Ex. 1076: Certified Copy of Prosecution History of U.S. Pat. No.
11,048,751
- Ex. 1077-81: Reserved
- Ex. 1082: Stipulation Regarding Invalidity Defenses

The Board authorized this Petitioner’s Reply to address Patent Owner’s (“PO”) arguments concerning discretionary denial of institution in these proceedings.¹ Ex. 3001. PO argues for discretionary denial, suggesting that the *Fintiv* factors (*see Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11, 5-16 (PTAB Mar. 20, 2020)) weigh in favor of denial. IPR2024-00325, POPR, 32-45. At least for the following reasons and specifically in response to PO’s arguments, discretionary denial is not warranted.

I. FACTOR 1: STAY

PO asserts that “[t]he parallel proceeding is unlikely to be stayed pending IPR as that Court rarely grants such stays.” *Id.* at 34 (citing Ex. 2002 including statistics relating to Motions to Stay Pending PTAB). PO’s assertion appears to be based on statistics that at least fail to account for the *timing* of such motions before that Court. *See* Ex. 2002 (where for 33 of the 58 denials for motions to “Stay Pending PTAB”, prematurity as being filed prior to IPR institution was dispositive). *See, e.g.*, Ex. 2002, 59, 67; *Polaris PowerLED Techs., LLC v. Samsung Elecs. America, Inc.*, 2:22-cv-00469-JRG, Dkt. 54 (E.D. Tex. Aug. 17, 2023); *Oyster Optics, LLC v. Coriant*

¹ A similar Reply is being filed in IPR2024-00321 through -00324 and -00326 with appropriate revisions to exhibit numbers. The replies in -00322, -00324, and -00326 also address PO’s *Becton, Dickinson* arguments in those proceedings.

America Inc., 2:16-cv-01302-JRG, Dkt. 199 (E.D. Tex. Dec. 21, 2017). Indeed, it is “the universal practice” of that Court to deny motions for a stay when the PTAB has not yet acted on a petition for IPR. *Trover Grp, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015). *See also Advanced Coding Techs LLC v. LG Electronics, Inc.*, 2:22-cv-00501-JRG, Dkt. 102 (E.D. Tex. Apr. 11, 2024) (“Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”). Petitioner also should not be faulted for not filing a futile pre-institution motion and reasserts its intention to request a stay if this IPR is instituted.

II. FACTOR 4: OVERLAP OF ISSUES

Factor 4 strongly favors institution. PO argues for discretionary denial based on its misleading statement that “the same set of claims is challenged in the Petition and also at issue in the district court.” IPR2024-00325, POPR, 40. Yet, only a subset of the challenged claims are at issue in the pending litigation. The Petition challenges **all** claims of the ’934 Patent. IPR2024-00325, Petition, 8. Whereas, claims 17, 18, 19, and 20 alone are at issue in the co-pending litigation. *See* Ex. 2007, 14–16. Further, at least some of the non-overlapping claims differ significantly (*see, e.g.*, dependent claims 2-3, 5-7, 12-13, and 15-16), and Petitioner would be harmed if institution of the non-overlapping claims is denied. For example, if Petitioner developed a new product (or changed its existing product) and PO then accused that

product of infringement under one or more of these claims, Petitioner would have no ability to challenge them through IPR because of the statutory bar of 35 U.S.C. § 315(b).

PO further intimates that factor 4 favors discretionary denial because “Petitioner and its co-defendants continue to pursue Redford, the primary reference of this Petition.” IPR2024-00325, POPR, 40. Petitioner continues to pursue Redford in the parallel proceeding because if Petitioner removed Redford from its district court invalidity contentions and IPR were not instituted, Petitioner would have lost the ability to assert Redford in either forum.

PO argues for discretionary denial because Petitioner’s “co-defendant” in the parallel proceeding, Charter Communications (“Charter”), is pursuing invalidity defenses relying on Redford, and has not agreed to be bound by a stipulation. IPR2024-00325, POPR, 41. But Charter is not a co-defendant of Petitioner, as they were sued in separate cases based on their different products. That those cases were *sua sponte* consolidated for pretrial by order of the Court does not create a relationship between them that supports discretionary denial. *Cf. Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 28 at 11 (PTAB Mar. 22, 2024) (Director review finding that court-ordered pretrial coordination between parties having different products did not support discretionary denial under *General Plastics* analysis). *See also* Trial Practice Guide at 17 (participation in a joint defense group

does not make parties into RPIs or privies).

Here, Charter and Petitioner are parts of a joint defense group in a court-ordered consolidated action. Charter is not an RPI or privy for purposes of the Petition (nor has PO alleged as such). Petitioner did not file the Petition at the behest of or on behalf of Charter. Petitioner cannot be held responsible for the acts of Charter. And Petitioner's choice to file an IPR does not become an "end-run around its own stipulation" simply because Charter has made different litigation choices.² IPR2024-00325, POPR, 41.

Finally, PO argues that "Petitioner and Charter's cases remain consolidated for all pretrial purposes and issues of invalidity will likely be dealt with at the same time." IPR2024-00325, POPR, 41. But, as PO states, consolidation is for **pretrial** purposes. Ex. 2013. PO's statement that invalidity is likely a pretrial issue finds no support particularly with regard to invalidity based on prior art, which is typically a question of fact *for trial*.

At least for the above reasons, there is substantial difference between the issues raised in the Petition and in the parallel proceeding and factor 4 strongly favors institution.

² And if instituted, Charter may choose to join this IPR under 35 U.S.C. § 315(c).

III. CONCLUSION

The compelling merits of Petitioner’s unpatentability contentions demonstrate that the PTAB should not discretionarily deny institution under *Fintiv*. See Guidance Memorandum, 4–5 (“[W]here the PTAB determines that the information presented at the institution state presents a compelling unpatentability challenge, the determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.”); see also, e.g., *Illumina Inc. v. Trs. of Columbia Univ.*, IPR2020-00988, Paper 20 (PTAB Dec. 8, 2020) (declining to deny under *Fintiv* in light of strong evidence on the merits even though four factors weighed in favor of denial and remaining factor was neutral); *Samsung Elecs. Co. v. Scramoge Tech., Ltd.*, IPR2022-00241, Paper 10 at 14 (PTAB Jun. 13, 2022) (*Fintiv* analysis concludes that “very strong” evidence on the merits outweigh concurrent litigation involving earlier scheduled trial date and significant overlap in proceedings).

Discretionary denial is not appropriate and trial should be instituted in this IPR proceeding.

Dated: May 24, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this **PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** to be served via e-mail on May 24, 2024, in its entirety on the following counsel of record for Patent Owner:

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