

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 REQUEST FOR REHEARING PURSUANT TO
37 C.F.R. §42.71(d) ON DECISION INSTITUTING *INTER PARTES*
REVIEW**

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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

Pursuant to 37 C.F.R. § 42.71(d), Petitioner Comcast Cable Communications, LLC (“Petitioner”) respectfully requests rehearing of the Patent Trial and Appeal Board’s (“Board”) July 26, 2024 Institution Decision (“ID”) (Paper 13) finding that Petitioner failed to provide compelling evidence of unpatentability of any of claims 3, 4, and 8-20 of U.S. Patent No. 11,086,934 (“the ’934 Patent”) in view of Redford-Bartfeld and Redford-Bartfeld-Gonze (Grounds A and B).¹

In the ID, the Board accepted Patent Owner’s incorrect contentions that Redford’s server sends a command only to the content provider and not the television, and that Redford’s API is solely present on the television (“media receiver”). This led to the further incorrect conclusion that Redford’s television 303, not computer system 250, performs the conversion resulting in a VideoPlay command. ID, 20-21. As explained herein, the Petition did demonstrate compellingly that, upon receipt of a PlayVideo command, Redford’s *computer system* converts the PlayVideo command, received from a handheld device, to a VideoPlay command for playback by a particular player, and then transmits that command with the video URL to the television. Pet. 25-28; Ex. 1002, ¶¶ 155-161. Petitioner submits that the Board’s misapprehension of these arguments in the

¹ “Redford” refers to Exhibit 1005, “Gonze” refers to Exhibit 1006, and “Bartfeld” refers to Exhibit 1018.

Petition and the actual disclosure of Redford necessitates rehearing.

I. APPLICABLE STANDARDS

Pursuant to 37 C.F.R. § 42.71(d), a party may request rehearing of a decision not to institute trial by the Board. The party requesting rehearing has the burden of showing that the decision from which rehearing is sought should be modified, and “[t]he 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, or a reply.” 37 C.F.R. § 42.71(d); *Apple Inc., et al. v. Uniloc Luxembourg S.A.*, IPR2017-00225, Paper 31, at 2 (P.T.A.B. Sept. 6, 2018) (“The burden here, therefore, lies with [the requester] to show we misapprehended or overlooked the matters it requests that we review.”).

In this proceeding, the Board applied a “compelling merits” standard that is met if “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.” ID, 14, *citing* Guidance Memo, 4². As noted by the Board, a Petitioner meets this standard

² While the Petition has compelling merit as discussed below, the *Fintiv* framework should not be followed because it is legally invalid as it (1) exceeds the Director’s authority, (2) is arbitrary and capricious, and (3) was adopted without notice-and-comment rulemaking.

“if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” ID, 14, *citing OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential) (“*OpenSky*”).

II. PRECISE RELIEF REQUESTED

Petitioner requests rehearing of the Board’s Decision to not institute trial on the ground that claims 3-4, and 8-20 of the ’934 Patent are unpatentable under 35 U.S.C. § 103 as obvious over Redford in view of Bartfeld (Ground A) and Redford in view of Bartfeld and Gonze (Ground B) because the Board erroneously relied on mischaracterizations of Redford put forward by the Patent Owner, which led the Board to fail to understand Redford and properly consider Petitioner’s argument. Pet., 8.³

III. THE BOARD ERRONEOUSLY RELIED ON PATENT OWNER’S MISCHARACTERIZATION OF REDFORD IN ITS ANALYSIS

Petitioner proposed combinations citing Redford-Bartfeld and Redford-Bartfeld-Gonze for teaching limitations related to claims 3, 4, 8, and 17. *See* Pet., 49-52, 57-61, 64-68. The Board concluded that the Petitioner did not meet the “compelling merits” standard with regard to any of the challenged claims. ID, 21. In so holding, the Board accepted PO’s incorrect contention that Redford’s server sends

³ Independent claim 1 and dependent claims 2 and 5-7 were disclaimed by the Patent Owner subsequent to filing of the Petition. Ex. 2023.

a command only to the content provider and not the television, and that Redford's API runs solely on a device in the user's home. POPR, 17-19 cited by the ID, 17-18. Absent these errors, "it is highly likely that the petitioner would prevail with respect to at least one challenged claim," including at least claims 8 or 17, and institution should be granted. *OpenSky* at 49. Rehearing is therefore warranted so that the Board can consider whether compelling evidence was presented as to whether Redford teaches the claims. As set forth below, the Petition did include such compelling evidence.

A. Patent Owner's Mischaracterization of What is Sent From Redford's Server to Redford's Television

To begin, Petitioner is not relying on the command sent to content provider 281I in step 1153 in Figure 11H as being the recited "set of commands," as the Board possibly misunderstood. ID, 19-20. Petitioner relies instead on the VideoPlay command ("a set of commands"), which a POSITA would have understood from this disclosure is sent from the computer system 250 to television 303 and is executed by the iLook set-top SDK operating on the television 303. Pet., 26-27 citing Ex. 1005, 29:4-20, 36:41-53, Figs. 8A-8B, 11H; Ex. 1002, ¶¶ 160-161. The Petition demonstrates Redford's use of an API to communicate between the computer system 250 and television 303 (Pet., 25-28) and explains how a POSITA would have understood that the URL of the video sent to the TV as shown in Figure 11H includes the VideoPlay command. Ex. 1005, 43:36-53; Pet., 26-28.

The misapprehension of the operation and description of Fig. 11H appears to originate from PO. POPR, 22-23. Specifically, PO argues that “Redford only discloses one command from the alleged *server system* to play a video, and that command is sent to a ‘content provider’ computer, which is another part of the alleged *server system*. Redford does not disclose any command to play a video being *received by* the internet-enabled television identified as the *media receiver*. Pet.61, 68 (*citing* Pet., 46-47, (Limitation 1E)).” POPR, 22 (original emphasis). PO’s statement is contrary to the explicit teachings of Redford, which provides that authority server 282 (part of computer system 250) “transmits the following information to the television: a VIDEO STREAM ... and COMMANDS including start, play, pause, stop, fast forward, change volume, turn on/off.” Ex. 1005, 44:48-52 (emphasis added); Pet., 24, 25, 50. As part of its analysis, the Board focused on Figure 11H of Redford as showing a command being sent to the content provider computer, not the television. ID, 19-20 (citing POPR, 22-23). But Redford’s disclosure is not limited to Figure 11H, and the Petition does point to the sending of a play command to the television explicitly disclosed in Redford to support its position. Pet., 24, 25, 50 (citing Ex. 1005, 44:48-52).

B. Patent Owner’s Mischaracterization of Redford’s API

In the ID, the Board also relied on PO’s argument that “Redford does not disclose the media receiver receiving the required converted commands because its

‘media receiver is the component [that is] doing the alleged converting.’” ID, 17 citing POPR, 16. The Board contended that “VideoPlay is a video-streaming protocol that implements video content to be played by a *set-top* API (Application Programming Interface).” ID, 20, citing Pet., 49 and Ex. 1005, 40:56–58, (original emphasis). The Board appeared to accept the mischaracterization by PO as to how a POSITA would have understood Redford’s API to operate, and as a result erroneously faulted Petitioner for allegedly failing to show “that Redford’s API converts the command at computer system 250 or at server authority 282 such that a converted command is received by television 303.” ID, 21.

Petitioner’s expert explained in his declaration what a POSITA understood about APIs and how APIs operate. Ex. 1002, ¶¶ 81-83. Specifically, Mr. Lett described that an API is “is a set of rules, protocols, and tools that allows different software applications to communicate with each other. APIs allow for the integration of functionalities from one application into another.” *Id.*, ¶ 81. His declaration noted that a POSITA would have known about how APIs operate and use procedure calls: “[b]y 2010, it was well known that API procedure calls could be used to perform a wide range of tasks, including, for example, retrieving data from remote servers and sending data to a service” including “web-based interactions” and “remote procedure calls over the Internet.” *Id.*, ¶¶ 81, 83. In order to “allow[] different software applications to communicate with each other,” and

“retriev[e] data from remote servers and send[] data to a service,” application of an API’s protocols is not limited to only one side of the interface between the services/applications. *Id.*, ¶¶ 81-83.

As discussed in the Petition, in Redford, a handheld device sends a command (PlayVideo) in accordance with its API to the computer system, which converts it into a command (VideoPlay) in accordance with the television’s API, and then sends the converted command to the television. Specifically, step 1151 of Fig. 11H indicates that the authority server 282 “Receive[s] Command to Play Video (including video identifier).” Pet., 26-28; Ex. 1005, Fig. 11H; Ex. 1002, ¶¶ 160-161. The PlayVideo command is the command received by the authority server 282 (part of the computer system 250) from handheld device 200. Pet., 25-26; Ex. 1002, ¶ 159. And Redford describes illustrative commands sent from a handheld device to the computer system using authority-compatible handheld interface software (iLook iPhone SDK API). Pet., 26 citing Ex. 1005, 38:50-63; Ex. 1002, ¶ 156.

A POSITA would have understood that Redford teaches the iLook iPhone SDK API as the protocol for communicating between the handheld 200 and authority server 282. This is why Redford describes it as “authority-compatible handheld interface software.” Ex. 1005, 38:50-63. The PlayVideo command is output from the handheld device to the authority server using the iLook iPhone SDK API. Pet., 26; Ex. 1002, ¶¶ 156, 159. As stated above, this is shown in step 1151 of Fig. 11H.

The computer system then converts the PlayVideo command to the VideoPlay command which is communicated to the television using the iLook set-top SDK API (which is the API for communicating between authority server 282 and television 303). Pet., 27-28; Ex. 1002, ¶ 159.

Therefore, as the Petition demonstrated, Redford teaches that the authority-compatible iLook iPhone SDK API allows for a command, e.g., PlayVideo, to be sent to authority-server 282, which then sends a converted COMMAND, e.g., VideoPlay for a particular player, to television 303 using the authority-compatible iLook set-top SDK API in order to play content in the particular RTSP player. Pet., 25-28, citing Ex. 1005, 44:48-52; Ex. 1002, ¶¶ 156-159. While it is true that Redford *titles* these APIs based on the end devices (iPhone/handheld and set-top/television), Redford *describes* them as authority compatible because they provide the protocols for the end devices to communicate with the authority server 282 of computer system 250. Ex. 1005, 8:1-12, 26:62-27:3, 31:18-23, 36:18-27, 38:50-63, 39:3-54, 40:56-41:45, 43:36-53, 44:6-18, 44:48-52, Figs. 2F, 8A-8B, 11H; Ex. 1002, ¶¶ 156-159.

Because the Board fundamentally misapprehended how Redford's set-top SDK API allows communication between the authority server and television, rehearing is warranted.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully submits that rehearing of the

denial of Grounds A and B of the Decision Instituting *Inter Partes* Review is warranted and that review of claims 3, 4, and 8-20 of the '934 Patent should be instituted.

Dated: August 23, 2024

By: /Frederic M. Meeker/

Frederic M. Meeker
Reg. No. 35,282

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that I caused a true and correct copy of the **PETITIONER'S REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 42.71(d) ON DECISION INSTITUTING *INTER PARTES* REVIEW** and supporting evidence to be served via electronic mail to the following:

Kyle E. Friesen - kfriesen@shb.com
Robert H. Reckers - rreckers@shb.com
Jason R. Mudd - jmudd@shb.com
Ryan Dykal - rdykal@shb.com

Dated: August 23, 2024

By: /Frederic M. Meeker/

Frederic M. Meeker
Reg. No. 35,282