

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COMCAST CABLE COMMUNICATIONS, LLC,  
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,  
Patent Owner.

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Case No. IPR2024-00325  
U.S. Patent No. 11,086,934

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**JOINT MOTION TO TERMINATE INTER PARTES REVIEW AND  
NOTICE OF WITHDRAWAL OF REQUEST FOR REHEARING**

## PETITIONER’S UPDATED EXHIBIT LIST

### *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, *Touchstream Technologies, Inc. v. Google LLC*, 6:21-cv-00569-ADA (WDTX) (Feb. 8, 2022)
- Ex. 1021: Exhibit 1 to Joint Disputed Claim Terms Charts, *Touchstream Technologies, Inc. v. Vizbee, Inc.*, 1:17-cv-06247-PGG-KNF (SDNY) (Aug. 6, 2018)
- Ex. 1022: Jury Instructions, *Touchstream Technologies, Inc. v. Google LLC*, 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

*Filed Herewith:*

Ex. 1083: BUSINESS CONFIDENTIAL Term Sheet

Pursuant to 35 U.S.C. § 317(b), 37 C.F.R. § 42.74(c), and the authorization provided by the Board in their March 26, 2025 email, Petitioner Comcast Cable Communications, LLC (“Petitioner”) and Patent Owner Touchstream Technologies, Inc. (“Patent Owner”) (collectively, the “Parties”) jointly request termination of this proceeding, IPR2024-00325, directed to U.S. Patent No. 11,086,934 (“the ’934 patent”).

On July 26, 2024, the Board denied institution of this proceeding (Paper 13).

On August 23, 2024, Petitioner filed a Request for Rehearing (Paper 15), requesting rehearing of the decision denying institution.

The Parties have entered into a confidential term sheet that resolves all underlying disputes between Petitioner and Patent Owner with respect to U.S. Patent No. 11,086,934 (“the ’934 patent”).

Based on the settlement, Petitioner hereby requests withdrawal of its Request for Rehearing. Patent Owner does not object to this request. Thus, Petitioner believes the proceeding is complete based on the withdrawal of the Request.

With this joint motion, the parties concurrently submit a true copy of any agreement or understanding (Exhibit 1083) between the Parties made in connection with, or in contemplation of, the requested termination of the proceeding under 37 CFR § 42.74(b) and a joint request to treat the term sheet as business confidential information and keep the term sheet (Exhibit 1083) separate from the file of the

involved patent, pursuant to 37 C.F.R. § 42.74(c). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

The litigation between the Parties regarding US 11,086,934 has been dismissed with prejudice pursuant to settlement and no further litigation between the Parties is contemplated. Apart from the present matter, there are no other proceedings in the U.S. Patent and Trademark Office regarding US 11,086,934. The following district court litigations involving US 11,086,934 are pending:

- *Touchstream Technologies, Inc. v. Altice USA, Inc. et al.*, 2:24-cv-03186-GRB-SIL (EDNY)
- *Touchstream Technologies, Inc. v. Charter Communications, Inc. et al.*, 2:23-cv-00059-JRG (EDTX)

This joint pleading is being filed by the Petitioner, with the consent of the Patent Owner.

Dated: March 26, 2025

Respectfully submitted

/Frederic M. Meeker/

Frederic M. Meeker  
Reg. No. 35,282  
Banner & Witcoff, Ltd.  
*Attorney for Petitioners*

Dated: March 26, 2025

Respectfully submitted

/Kyle E. Friesen/

Kyle E. Friesen  
Reg. No. 65,371  
Shook, Hardy & Bacon L.L.P.  
*Attorney for Patent Owner*

## **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this JOINT MOTION TO TERMINATE INTER PARTES REVIEW AND NOTICE OF WITHDRAWAL OF REQUEST FOR REHEARING in connection with IPR2024-00325 to be served via e-mail on March 26, 2025, in its entirety on the following counsel of record for Patent Owner:

KFRIESEN@SHB.COM  
JMUDD@SHB.COM  
RDYKAL@SHB.COM  
RRECKERS@SHB.COM  
SHBTSCOMCASTIPR@SHB.COM

Dated: March 26, 2025

By: /Carlos Goldie/

Carlos Goldie