

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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IPR2024-00326  
Patent 11,086,934 B2

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

MEYERS, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

Comcast Cable Communications, LLC (“Petitioner”)<sup>1</sup> filed a Petition to institute an *inter partes* review of claims 1–20 of U.S. Patent 11,086,934 B2 (Ex. 1101, “the ’934 patent”). Paper 2 (“Petition” or “Pet.”).

Touchstream Technologies, Inc. (“Patent Owner”)<sup>2</sup> filed a Preliminary Response to the Petition. Paper 9 (“Preliminary Response” or “Prelim. Resp.”). In its Preliminary Response, Patent Owner states that it has disclaimed claims 1, 2, and 5–7 of the ’934 patent. *Id.* at 4 (citing Ex. 2023 (the “Disclaimer”)). In light of the Disclaimer, only claims 3, 4, and 8–20 (the “challenged claims”) of the ’934 patent remain at issue in this proceeding. Pursuant to our authorization, Petitioner filed a Preliminary Reply (“Pet. Reply,” Paper 11), and Patent Owner filed a Preliminary Sur-reply (“PO Sur-reply,” Paper 12).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. For the reasons explained below, upon considering the Petition, Preliminary Response, Preliminary Reply, Preliminary Sur-reply, and evidence of record, we do not institute an *inter partes* review.

## II. BACKGROUND

### A. *Related Proceedings*

The parties identify various related matters. Pet. ix–xi; Paper 4, 1–2. One related matter is *Touchstream Technologies, Inc. v. Comcast Cable*

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<sup>1</sup> Petitioner identifies “Comcast Cable Communications, LLC,” “Comcast Corporation,” and “Comcast Cable Communications Management, LLC,” as the real parties-in-interest. Paper 7, 1.

<sup>2</sup> Patent Owner identifies itself as the real party-in-interest. Paper 8, 1.

*Communications, LLC*, 2:23-cv-00062-JRG (E.D. Tex.) (“related district court litigation”). Pet. ix; Paper 4, 1. Petitioner also challenges claims 3, 4, and 8–20 of the ’934 patent in IPR2024-00325.

*B. The ’934 patent*

The ’934 patent “relates to the creation, storage, manipulation and access of media playlists used in conjunction with display devices and control of the display devices” such as “television displays [that are] used by consumers in their home for viewing videos and other media that are either provided from the Web or previously stored.” Ex. 1101, code (54), 1:22–28. The ’934 patent explains that “[g]iven the desire to watch various World Wide Web media on a family’s primary television set, and to control this operation from the comfort of one’s couch, there is a need to operate a television set or other display remotely from a personal computing device, such as a mobile phone” and that “[i]t also is desirable to allow a user to perform a general Web search to locate and capture Web media, and to control a television or other display remotely using the personal computing device.” *Id.* at 1:39–47.

An exemplary system to carry out these objectives is shown in Figure 1, which is reproduced below, with Patent Owner’s annotations. Ex. 1101, 2:55–56; Prelim. Resp. 7.

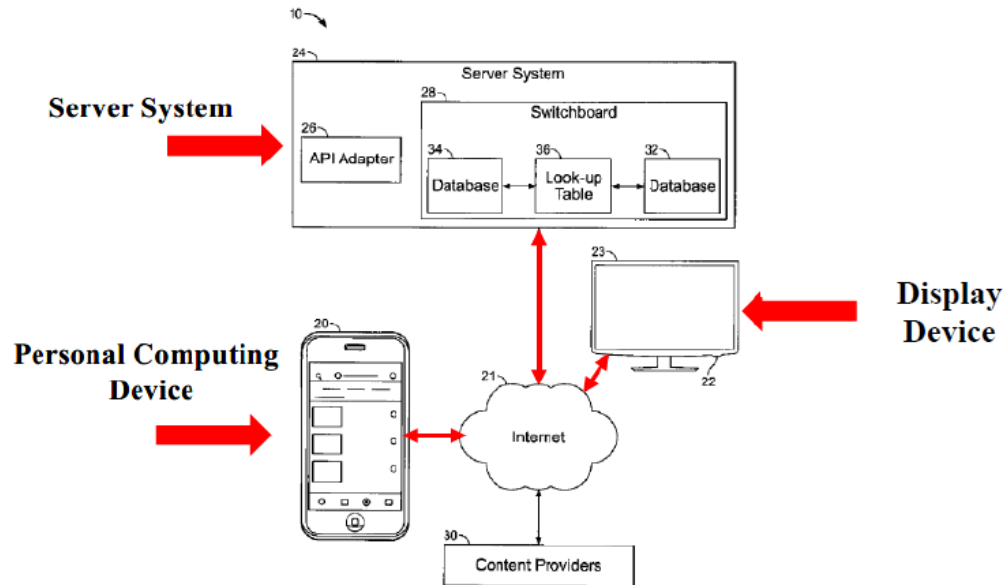


FIG. 1

Annotated Figure 1 above shows that system 10 facilitates synchronizing a connection via a computer connection (Internet 21) between first device 20 (personal computing device) and second device 22 (television set having display 23). Ex. 1101, 3:15–20. The connection allows personal computing device 20 to act as a controller and second device 22 to act as a receiver to play content selected by a user of personal computing device 20 and to respond to commands that originate at personal computing device 20. *Id.* at 3:17–23. Via connection through Internet 21, personal computing device 20 can display an application or web site that contains information and links to content providers 30. *Id.* at 3:23–26. Also, via connection through the Internet 21, television set 22 can receive commands from server system 24 so that a user can make a selection using personal computing device 20 for particular content and display the content on television display 23. *Id.* at 3:26–32. The commands can be via a transmission code to instruct television set 22 to access content provider 30, “load a specific media player, load the media player-specific content (e.g., a video) and play

the content” on television display 23. *Id.* at 3:32–39. From the established connection, the user can also use personal computing device 20 to control how the content is played on television display 23. *Id.* at 3:39–41.

### *C. Challenged Claims*

Claims 3, 4, and 8–20 of the ’934 patent are at issue in this proceeding. Claims 3 and 4 each depend, directly or indirectly, from disclaimed claim 1, and thus incorporate the subject matter of claim 1. Ex. 1101, 12:10–20. Claims 8 and 17 are independent. *Id.* at 12:32–56, 13:19–14:15. Claims 9–16 each depend, directly or indirectly, from claim 8 (*id.* at 12:57–18) and claims 18–20 each depend directly from claim 17 (*id.* at 14:16–28).

Claim 8 is illustrative, and is reproduced below with Petitioner’s added bracketing.

8. [8A] A computerized system comprising:

[8B] a server; and

[8C] a media receiver to

[8D] provide a unique identifier of the media receiver to a computing device, wherein each of the computing device and the media receiver are in communication with the server;

[8E] based on the provided unique identifier, receive a set of messages from the computing device, the received set of messages referencing a piece of content associated with a first type of media playing application of a plurality of media playing application types, and including a set of commands converted from a universal format defined by the computing device to a first format that corresponds to the first type of media playing application;

[8F] in response to the set of messages being received, select the first type of media playing application from the plurality of

media playing application types based at least in part on its association with the piece of content referenced in the received set of messages; and

[8G] control how the selected first type of media playing application plays the referenced piece of content based on at least one command of the converted set of commands included in the received set of messages.

Ex. 1101, 12:32–56.

Independent claim 17 is substantially similar to claim 8 except that claim 17 is drawn to “[a] computer-implemented method for controlling playback of various types of content, comprising” similar steps as to those recited in claim 8. Ex. 1101, 12:32–56, 13:19–14:15. Disclaimed claim 1 is drawn to “[a] non-transitory computer storage medium storing computer-usable instructions that, when used by a computing device, cause the computing device to perform [certain] operations.” *Id.* at 11:52–12:6.

#### *D. Asserted Challenges to Patentability*

Petitioner asserts that claims 3, 4, and 8–20 of the ’934 patent are unpatentable on the following three challenges (Pet. 19):<sup>3</sup>

| <b>Claim(s) Challenged</b> | <b>35 U.S.C. §<sup>4</sup></b> | <b>Reference(s)/Basis</b>                 |
|----------------------------|--------------------------------|-------------------------------------------|
| 3, 4, 8–20                 | 103(a)                         | Danciu, <sup>5</sup> Mahajan <sup>6</sup> |

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<sup>3</sup> Petitioner also asserts that claims 1, 2, and 5–7 would have been obvious based on Aldrey alone. Pet. 19, 60–70. However, as discussed above, these claims have since been disclaimed. Thus, the challenge based solely on Aldrey is moot. *See* Prelim. Resp. 22 (citing 37 C.F.R. § 42.107(e)).

<sup>4</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the ’934 patent’s priority date is before the AIA’s amendments to § 103, this decision refers to the pre-AIA version of § 103.

<sup>5</sup> US 9,490,998 B1, issued Nov. 8, 2016 (Ex. 1112, “Danciu”).

<sup>6</sup> US 2009/0248802 A1, published Oct. 1, 2009 (Ex. 1114, “Mahajan”).

| Claim(s) Challenged | 35 U.S.C. § <sup>4</sup> | Reference(s)/Basis                    |
|---------------------|--------------------------|---------------------------------------|
| 3, 4, 8–20          | 103(a)                   | Danciu, Mahajan, Calvert <sup>7</sup> |
| 3, 4, 8–20          | 103(a)                   | Aldrey, <sup>8</sup> Mahajan          |

Petitioner also relies on the Declaration of David B. Lett (Ex. 1102).

### III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(A)

Patent Owner argues that we should exercise discretion under 35 U.S.C. § 314(a) and deny institution, because the factors identified in *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), weigh in favor of denying institution in view of the related district court litigation. Prelim. Resp. 2–3, 47–59; PO Sur-reply 1–3.

We consider the following factors to assess “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

*Fintiv*, Paper 11 at 5–6.

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<sup>7</sup> US 2004/0078812 A1, published Apr. 22, 2004 (Ex. 1111, “Calvert”).

<sup>8</sup> US 2009/0172757 A1, published July 2, 2009 (Ex. 1115, “Aldrey”).

We discuss the parties’ arguments below in the context of considering the above factors.

*1. First Factor - Whether a Stay Exists or Is Likely to Be Granted if a Proceeding Is Instituted*

Petitioner argues that factor one is neutral and although Petitioner has not yet requested a stay, “[i]f trial is instituted, Petitioner expects to request a stay.” Pet. 19. Patent Owner argues that the related district court litigation is unlikely to be stayed based on that court’s low grant rate in other cases. Prelim. Resp. 49 (citing Ex. 2002). Petitioner counters that Patent Owner’s stay statistics fail to account for the timing of the motions requesting a stay. Pet. Reply 1–2 (citing Ex. 2002).

On this record, we decline to speculate as to how the district court might rule on a motion that Petitioner has not yet filed. Thus, we determine that this factor is neutral.

*2. Second Factor - Proximity of the Court’s Trial Date to the Board’s Projected Statutory Deadline*

The related district court litigation is currently scheduled for trial on October 28, 2024 and Petitioner states that that it has pending motions to transfer. Pet. 20; Prelim. Resp. 49. Patent Owner argues that this schedule is consistent with the district court’s median time-to-trial, which Patent Owner states is 21 months. Prelim. Resp. 50; *see* Ex. 2004; *see Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (USPTO June 21, 2022) (“Guidance

Memo”)<sup>9</sup> at 8–9 (providing that “[p]arties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the parallel litigation resides for the PTAB’s consideration”). Patent Owner argues that factor two favors discretionary denial because the district court trial date is more than eight months before our final written decision would be due (July 2025) if we instituted in July 2024. Prelim. Resp. 49–50. Patent Owner also notes that the district court has denied Petitioner’s transfer motions. *Id.* at 51 (citing Ex. 2006, 8).

Petitioner does not dispute Patent Owner’s evidence regarding time-to-trial. *See* Pet. Reply (not addressing factor 2).

Patent Owner’s representation of median time-to-trial of 21 months is consistent with the most recent available data from the judiciary.<sup>10</sup> *See* Ex. 2005 (complaint filed February 17, 2023).

We find that the related district court litigation’s trial date and the district court’s median time-to-trial favor denial.

### *3. Third Factor - Investment in the Parallel Proceeding by the Court and Parties*

Petitioner argues that “[f]actor three does not warrant denial” because the district court “has not yet begun the claim construction process and fact discovery does not close until June 2024.” Pet. 20. Thus, Petitioner admits that fact discovery will have closed by the deadline for institution in which

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<sup>9</sup> Available at [https://www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_memo\\_20220621\\_.pdf](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

<sup>10</sup> Available at [https://www.uscourts.gov/sites/default/files/fcms\\_na\\_distprofile1231.2023\\_0.pdf](https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf).

we evaluate the investment in the related district court litigation as of the time of the institution decision. *See Fintiv*, Paper 11 at 9–10.

Patent Owner argues that fact discovery, including expert discovery, will be closed by the deadline for institution and that a claim construction hearing was scheduled for May 16, 2024 which is also before the deadline for institution. Prelim. Resp. 52 (citing Exs. 2003, 2007, 2009, 2022). Patent Owner also notes that Petitioner filed its Petition “almost seven months after learning of the asserted claims and almost five months after serving its initial invalidity contentions,” which, according to Patent Owner, does not show diligence in filing the Petition. *Id.* at 53–54; *see Fintiv*, Paper 11 at 11–12 (noting that the timing of the Petition’s filing relative learning the asserted claims may be considered for factor three).

Petitioner does not dispute Patent Owner’s evidence regarding district court investment. *See* Pet. Reply (not addressing factor 3).

We agree with Patent Owner that factor three favors denial. In its arguments, Petitioner relies only on claim construction and fact discovery, which have progressed or have been completed by now. Patent Owner, however, shows that the related district court litigation has progressed in other aspects as well and notes Petitioner’s delay in filing the Petition.

*4. Fourth Factor - Overlap Between Issues Raised in the Petition and in the Parallel Proceeding*

Petitioner argues that “[f]actor four strongly favors institution” because the Petition challenges all claims while only claims 17–20 are asserted in the related district court litigation. Pet. 20. However, Patent Owner argues that “Petitioner also ignores that claims 2 and 5–7 have been disclaimed” (PO Sur-reply 3 (citing Ex.2023)), and makes no attempt to show that claims 3, 12, 13, 15, and 16 present different issues of invalidity

from claims 17–20 (which are asserted in the district court) “to justify a duplicative use of Board resources.” *Id.* (citing Pet. Reply 2–3).

Petitioner also states that it “stipulates not to pursue in the District Court any ground that utilizes the same combination of prior art references relied upon in the instituted petition.” Pet. 20 (citing Ex. 1182). Initially, we note that Petitioner’s characterization of the stipulation is slightly different from the stipulation itself, which states that, if trial is instituted, Petitioner “will not pursue in [the related district court litigation] the specific grounds against the instituted patent(s) as set forth in the respective instituted *inter partes* review petition(s).” Ex. 1182, 2. Patent Owner argues that Petitioner’s stipulation is “too weak to be effective” by pointing out that the “specific grounds” “as set forth” language could be read broadly to allow Petitioner, in the related district court litigation, to rely on the same combination of prior art in a different manner than “set forth” in the Petition. Prelim. Resp. 55.

Patent Owner also argues that Charter Communications, Petitioner’s co-defendant in the related district court litigation, “is pursuing almost identical invalidity defenses and has not agreed to be bound by any such stipulation.” Prelim. Resp. 56. According to Patent Owner, “Petitioner and Charter’s cases remain consolidated for all pretrial purposes and issues of invalidity will likely be dealt with at the same time.” *Id.* (citing Ex. 2013 (order consolidating “for pretrial purposes”)).

Petitioner argues, however, that Charter is not a co-defendant but was sued separately based on different products and that the district court consolidated the cases for pretrial purposes only whereas invalidity will be a trial issue. Pet. Reply 2–3. Petitioner further argues that Charter is not a

real party in interest or privy in this proceeding and that Petitioner “cannot be held responsible for the acts of Charter.” *Id.* at 3.

Patent Owner responds that it “must still prepare for and defend against the petitioned grounds in a jury trial, regardless whether the Board institutes on the Petition” because Charter is pursuing the same invalidity defenses based on the same prior art. PO Sur-reply 3.

We agree with Petitioner that Charter’s invalidity defenses cannot be held against Petitioner. This is evident from the Guidance Memo, which provides that “the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Guidance Memo 3 (emphasis omitted). This provision applies even if another defendant might pursue such grounds in parallel litigation. Petitioner can only control what it pursues in the related district court litigation, and Petitioner’s case is consolidated with Charter’s case only for pretrial purposes, not for trial. *See* Ex. 2013.

On the other hand, we agree with Patent Owner that the language in Petitioner’s stipulation in Exhibit 1182 does not eliminate overlap with district court invalidity arguments. Furthermore, Petitioner’s stipulation “not to pursue in the District Court any ground that utilizes the same combination of prior art references relied upon in the instituted petition” (Pet. 20) allows Petitioner to utilize a prior art reference that may be considered a primary reference, that is one disclosing a majority of the claim limitations, in combination with a reference that is not relied on in the

Petition. This may not address adequately “concerns of inefficiency and the possibility of conflicting decisions.” *See Fintiv*, Paper 11 at 12.

Finally, we agree with Petitioner that the fact that the Petition challenges claims that are not asserted in the litigation shows that there is not a complete overlap. In this Petition, we have some claims that are different in which the district court will not resolve issues relating to these different claims. *Cf. SAS Institute, Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018) (“[I]n an inter partes review the petitioner is master of its complaint and normally entitled to judgment on all of the claims it raises . . .”).

Based on the foregoing discussion, we determine that factor four weighs slightly against denial.

*5. Fifth Factor - Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party*

Petitioner is the defendant in the related district court case. Pet. 20; Prelim. Resp. 57. Thus, we find that this factor favors denial. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”).

*6. Sixth Factor - Other Circumstances that Impact the Board’s Exercise of Discretion, Including the Merits*

The sixth *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny, such as the merits of the patentability challenges. *Fintiv*, Paper 11 at 14–16. Under this factor, “the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability.” Guidance Memo 5. Board precedent provides that we should only consider the compelling merits standard if the first five *Fintiv* factors favor discretionary denial. *CommScope Techs. LLC v. Dali*

*Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB February 27, 2023) (precedential) (“*CommScope*”).

The second, third, and fifth *Fintiv* factors favor denial. The first factor is neutral, and only the fourth factor weighs slightly against denial. Thus, we determine that the first five *Fintiv* factors favor discretionary denial, and as such, we assess compelling merits. *CommScope*, Paper 23 at 5 (“In circumstances where, however, the Board’s analysis of *Fintiv* factors 1–5 favors denial of institution, the Board shall then assess compelling merits.”). The compelling merits standard 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.” 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.” *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (precedential) (“*OpenSky*”).

Petitioner asserts that claims 3, 4, and 8–20 of the ’934 patent would have been obvious over Danciu and Mahajan, claims 3, 4, and 8–20 would have been obvious over Danciu, Mahajan, and Calvert, and alternatively, claims 3, 4, and 8–20 would have been obvious over Aldrey and Mahajan. Pet. 19. We have reviewed Petitioner’s challenges and Patent Owner’s arguments, and we determine that Petitioner has not met the compelling merits standard.

We focus on Petitioner’s contentions for the “converted” commands limitations of dependent claims 3 and 4 and independent claims 8 and 17.

As noted above, claims 1 and 2 have been disclaimed. Relevant to our analysis of claims 3 and 4, independent claim 1 recites “a computing

device” that *receives* a set of commands “associated with a first type of media playing application of a plurality of media playing application types” and claim 2 which depends from claim 1, recites that the set of commands “is recognizable by the first type of media playing application.” Ex. 1101, 11:52–12:9. Claim 3 depends from claim 2 and recites that the set of commands “is converted via an API adapter to be recognizable by the first type of media playing application.” *Id.* at 12:10–16. Claim 4 depends from claim 1 and recites that the set of commands “is defined in a universal format and converted to a particular format recognizable by the first type of media playing application.” *Id.* at 12:17–20.

Each of independent claims 8 and 17 requires similar limitations as to those of claims 3 and 4 with a difference of rather than reciting “a computing device” that receives the converted commands, each of independent claims 8 and 17 recites instead “a media receiver” that receives the converted commands. *Id.* at 12:32–56, 13:19–14:15; *see also* Prelim. Resp. 7 n.3. Further, claim 1 recites “another computing device” whereas claims 8 and 17 recite “a computing device.” *Id.* Similar to claims 3 and 4, each of independent claims 8 and 17 recites “a set of commands converted from a universal format defined by the computing device to a first format that corresponds to the first type of media playing application.” Ex. 1101, 12:32–56, 13:19–14:15. Independent claim 8 recites “a server” whereas independent claim 17 recites “a server system.” *Id.*; *see* Prelim. Resp. 23–24. We identify these differences in language between the claims to consider Petitioner’s mapping of the claims discussed below.

Danciu, titled “Network-Based Remote Control,” “is directed to techniques for exchanging information between a networked device, such as

a network-enabled television, and web-enabled device, such as a remote control, via a network service (e.g., a ‘cloud service’).” Ex. 1112, code (54), 1:39–43. Danciu discloses that a “web-enabled cellular phone” may be used as a remote control. *Id.* at 5:1–2.

Petitioner annotates Danciu’s Figure 1, by adding color to represent different components, which is reproduced below.

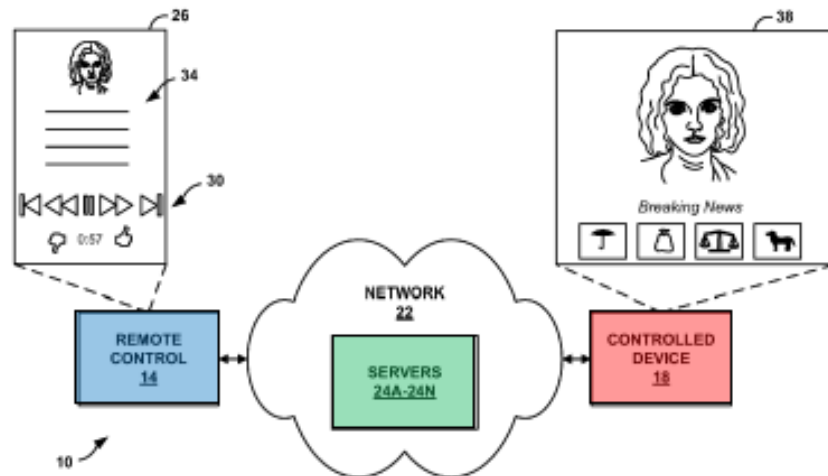
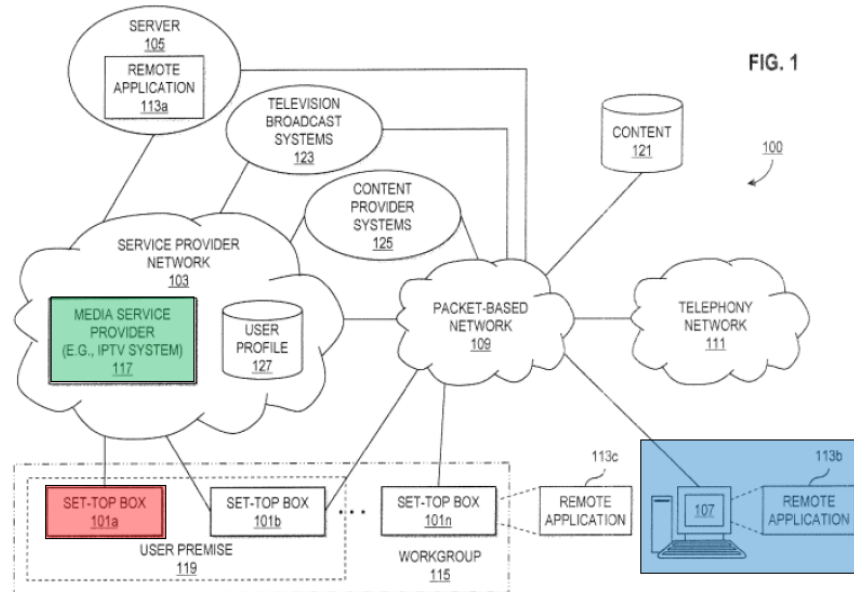


FIG. 1

Pet. 7. Danciu’s Figure 1 above, with Petitioner’s added coloring, shows networked environment 10 with remote control 14 (blue) communicating with controlled device 18 (red) via network 22 and servers 24A–24N (green) in network 22. Ex. 1112, 4:58–64. Petitioner maps controlled device 18 to the recited “computing device” or “media receiver,” remote control 14 to “another computing device” or “computing device,” and servers 24 to “server” or “server system.” Pet. 22, 24, 45, 50.

Aldrey, titled “Method and Apparatus for Remote Set-Top Box Management,” discloses that a command “is received from a computing device for controlling a plurality of set-top boxes.” Ex. 1115, codes (54),

(57). Petitioner annotates Aldrey's Figure 1, by adding color to represent different components, which is reproduced below.



Pet. 16. Aldrey's Figure 1 above, with Petitioner's added coloring, shows system 100 with service provider network 103 having media service provider (MSP) 117 (green) in communication with Set-Top Box (STB) 101a (red) and end terminal 107 (blue). Ex. 1115 ¶ 18. Petitioner appears to map STB 101a to the recited "computing device" or "media receiver," end terminal 107 to "another computing device" or "computing device," and media service provider 117 to "server" or "server system." Pet. 60–61, 76–77, 82.

Mahajan discloses techniques for handling presentation of media in client-server collaboration sessions. Ex. 1114 ¶ 11. Mahajan discloses that "the client and server may or may not support the same media platforms" and that "media playback commands specific to a media platform form supported on a server may be meaningless for a media platform supported on the client." *Id.* ¶ 12. Mahajan discloses "translat[ing] a platform specific

media playback command of the server into a generic media playback command,” which “can then be translated into a platform specific media playback command for a media platform supported on the client.” *Id.* ¶ 13.

In the combinations that include Danciu and Mahajan, with or without Calvert, Petitioner relies solely on Mahajan for teaching the converted commands. Pet. 38–41, 45, 51, 59–60. Similarly, in the combination of Aldrey and Mahajan, Petitioner also relies solely on Mahajan for teaching the converted commands. *Id.* at 70–75; *see also* Prelim. Resp. 20–23. Consequently, we focus our analysis on Petitioner’s reliance on Mahajan in all three grounds. While our comments below might refer to a particular ground, they apply equally to the other grounds as Petitioner’s contentions are the same for all three grounds.

In its contentions, Petitioner relies on Mahajan’s Figure 3 to show “[a] more detailed example for accomplishing the media command abstraction in a remote terminal session” in which “Mahajan’s server translates specific commands of a first type to genericized commands, the genericized commands are transmitted, and then Mahajan’s client translates those generic commands to specialized commands of a second type.” Pet. 12–13 (citing Ex. 1114 ¶¶ 35–43, Figs. 1–3, 5).

More particularly for the “converting” limitation of claim 3, Petitioner argues that Mahajan describes that its RTS Media Abstraction module of the client (an API converter) converts the commands received by the client from Mahajan’s server. Pet. 39 (citing Ex. 1114 ¶¶ 37–43, 63, Figs. 3, 5; Ex. 1102 ¶ 178). Petitioner then argues that a person of ordinary skill in the art “would have understood that the RTS Media Abstraction Module is a software intermediary that converts commands from one interface (e.g., a

genericized interface) into another (e.g., the interface of the first type of media playback application).” *Id.* at 40 (citing Ex. 1102 ¶ 179).

As to claim 4, Petitioner argues that Mahajan teaches genericized commands that are “‘converted to a particular format recognizable by the first type of media playing application’ when they are converted from the server’s platform-specific media command . . . to a genericized media command . . . via the RTS media abstraction module of the server.” Pet. 41 (citing Ex. 1102 ¶ 182). Petitioner contends that “those commands are further ‘converted to a particular format recognizable by the first type of media playing application’ when they are converted by the RTS abstraction module of the client into a platform-specific media command corresponding to the client’s media playing application.” *Id.* (citing Ex. 1102 ¶ 182).

In response, Patent Owner argues that “Mahajan describes a two-part server-client architecture where the relevant conversion is done *by the client after* it receives the alleged *commands*, not by the source of those commands (*i.e.*, Mahajan’s server).” Prelim. Resp. 25. Patent Owner points out that Mahajan’s architecture includes server 202 having RTS (Remote Terminal Session) media abstraction module 210 and client 204 having RTS media abstraction module 214. *Id.* at 25 (citing Ex. 1114 ¶ 37, Figs. 2, 3). Patent Owner contends that server 202’s RTS media abstraction module 210 converts platform-specific media commands into generic commands to be sent to client 204’s RTS abstraction module 214 and only thereafter does client 204’s RTS abstraction module 214 translate the generic media commands into media commands that are specific to client 204’s media platform. *Id.* at 26–27 (citing Ex. 1114 ¶¶ 35–36). Patent Owner argues that Mahajan’s Figure 3 illustrates the operation of this architecture in which the

conversion is performed after it is received by client 204 (i.e., the claims’ recited “computing device” or “media receiver”), and thus, client 204 could not have received the converted commands as required by claims 3, 4, 8, and 17. *Id.* at 27–32.

As noted above, our inquiry is directed to whether the Petition meets the compelling merits standard, not the “reasonable likelihood” standard of § 314(a). We agree with Patent Owner that Petitioner does not show that Mahajan discloses or renders obvious the converted commands limitations of the claims. Particularly, all of the claims require that a media receiver (or computing device) *receives* a set of commands that is recognizable by the first type of media application and is converted via an API adapter to be recognizable by the first type of media playing application. Petitioner’s reliance on Mahajan’s Figure 3 for disclosing this limitation is not persuasive. Pet. 12–13, 39–41; Ex. 1102 ¶¶ 178–179, 182. Mahajan’s Figure 3, with Patent Owner’s annotations added coloring for different platforms and different commands, is reproduced below.



Fig. 3

Prelim. Resp. 28. Mahajan’s Figure 3, reproduced above with Patent Owner’s added coloring, shows that user-commands 306A–I (red) for server 202’s media platform are genericized by server 202’s RTS media abstraction module 210 (orange) using RTS mapping table 302 and corresponding generic commands 308A–I, 310A–I (grey) are sent to client 204’s RTS media abstraction module 214 (blue), which then converts the generic commands into platform-specific media commands 312A–I (green) for the client 204’s media platform. Ex. 1114 ¶¶ 35–43.

More particularly, Mahajan discloses that its “RTS abstraction module 210 can translate the intercepted platform specific media commands into *generic* or abstracted media commands.” Ex. 1114 ¶ 36 (emphasis added). Next, “[t]he *generic* media commands can be sent from the server [202]’s RTS media abstraction module 210 to the client [204]’s RTS media

abstraction module 214.” *Id.* Then, “[t]he client [204]’s RTS media abstraction module 214 can translate the *generic* media commands . . . into media commands that are *specific* to the client [204]’s media platform 212.” *Id.* Mahajan also discloses that “server [202]’s RTS media abstraction module 210 can receive media commands that are *specific to the server [210]’s media platform 208.*” *Id.* ¶ 37 (emphasis added). Thus, only media commands 312A–I (green) are *specific* to client 204’s media platform 212, not commands 306A–I, nor commands 308A–I, nor commands 310A–I. *See id.* ¶¶ 39–41. It appears that Petitioner recognizes such by stating that “Mahajan’s server translates specific commands of a first type to *genericized* commands, the *genericized* commands are transmitted, and then Mahajan’s *client* translates those generic commands to *specialized* commands of a second type.” Pet. 12–13 (citing Ex. 1114 ¶¶ 35–36, Figs. 1–2) (emphasis added); *see also* Prelim. Resp. 30 (citing Pet. 34–35, 59, arguing Petitioner concedes Mahajan’s RTS Media Abstraction module of the client converts the commands received by the client from the server).

With these disclosures, we agree with Patent Owner that any conversion of generic commands into platform-specific media commands for Mahajan’s client 204’s media platform 212 (as colorized green in Figure 3 by Patent Owner) is performed on the client 204 side, not on the server 202 side and thus, “Mahajan does not disclose the claimed component *receiving* a set of *converted commands*—*i.e.*, commands that have already been *converted* when they are received.” Prelim. Resp. 27–28. We further agree with Patent Owner’s assessment that “Mahajan teaches that the client receives the generic commands alleged to be in a *universal format*; it does not disclose commands that are *receive[d]* in a *first format that corresponds*

to [or is recognizable by] the first type of media playing application, as the claims recite.” *Id.* at 28; *see* Pet. 29–31, 39, 41; Ex. 1114 ¶¶ 36, 63.

Petitioner appears to agree by stating that in regard to Mahajan’s teachings,

1) commands for a type of media playing application on the server are received at Mahajan’s server, 2) the commands are translated into a *universal* command, 3) the *universal* command is transmitted to the client, 4) the client re-translates the *universal* command, and 5) the new specific command is executed.

Pet. 31 (citing Ex. 1114 ¶¶ 35–36, Figs. 1, 2; Ex. 1102 ¶ 159); *see also* Prelim. Resp. 29 (citing Ex. 1114 ¶¶ 13–14, 63).

For independent claims 8 and 11, Petitioner relies on the same line of arguments discussed above for claims 3 and 4, which are unpersuasive for the reasons discussed above. *Id.* at 44–46, 49–51, 75–78, 81–83.

Petitioner relies on Calvert for teaching that it is known “to select between a plurality of media players based on an association with a piece of content.” Pet. 54 (citing Ex. 1102 ¶ 219). Thus, Petitioner does not explain how Calvert remedies the above-discussed deficiencies of the Danciu-Mahajan combination.

Based on the foregoing, we determine that Petitioner’s obviousness contentions based on the combined teachings of Danciu and Mahajan, Danciu, Mahajan, and Calvert, and alternatively, Aldrey and Mahajan do not meet the compelling merits standard.

Thus, we find that factor six favors denial.

### 7. *Balancing the Fintiv Factors*

We have considered the circumstances and facts before us in view of the *Apple v. Fintiv* factors. Our analysis is fact driven and no single factor is determinative of whether we exercise our discretion to deny institution under

§ 314(a). Here, we determine that most of the *Fintiv* factors (i.e., factors 2, 3, 5, and 6) weigh in favor of exercising our discretion to deny institution under § 314(a) while the first factor is neutral. Only the fourth factor weighs slightly against discretionary denial, and, in our holistic review of all the *Fintiv* factors, does not sufficiently tip the balance in favor of declining our discretion to deny under § 314(a).

For these reasons, and the reasons discussed above with respect to each of the six *Fintiv* factors, we exercise our discretion to deny institution under § 314(a).

#### IV. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(D)

Patent Owner also argues that we should exercise our discretion to deny institution of *inter partes* review in this case under 35 U.S.C. § 325(d) because “Mahajan and Danciu constitute the same or substantially the same art that has already been considered by the Patent Office.” Prelim. Resp. 42. However, because we will not be instituting an *inter partes* review based on our discretion to deny the Petition under § 314(a), we need not determine whether it would be appropriate to discretionarily deny the Petition under § 325(d).

#### V. CONCLUSION

For the foregoing reasons, we exercise discretion to deny institution under 35 U.S.C. § 314(a).

#### VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied and no *inter partes* review is instituted in this proceeding.

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