UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHARTER COMMUNICATIONS, INC.,
Petitioner

v.

TOUCHSTREAM TECHNOLOGIES, INC.
Patent Owner

Case No. IPR2024-01231
U.S. Patent No. 8,356,251

PETITIONER'S MOTION FOR JOINDER

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I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Charter Communications, Inc. ("Petitioner") respectfully moves for joinder with the *Inter Partes* Review instituted in *Comcast Cable Communications, LLC v. Touchstream Technologies, Inc.*, IPR2024-00322, instituted on July 18, 2024 ("the Comcast IPR"), for U.S. Patent No. 8,356,251 ("the '251 patent"). *See* IPR2024-00322, Paper 13.

This motion is timely because it is filed "no later than one month after the institution date of any inter partes review for which joinder is requested." 37 C.F.R. § 42.122(b). Petitioner has consulted with counsel for Comcast Cable Communications, LLC ("Comcast"), and Comcast does not oppose Petitioner's request.

The grounds in the instant Petition—and evidence upon which they rely—are identical to the grounds in the Comcast IPR, which the Board instituted. Further, if joined, Petitioner will assume a "silent understudy" role and will actively participate substantively in the Comcast IPR only if Comcast terminates its involvement after joinder. Thus, the proposed joinder will not complicate or delay the Comcast IPR in any manner, or prejudice the Patent Owner. Accordingly, Petitioner respectfully requests that the Board institute Petitioner's IPR and grant this Motion for Joinder.

II. BACKGROUND

On February 16, 2023, Patent Owner filed suit against Charter Communications, Inc., Charter Communications Operating, LLC, Time Warner Cable Enterprises LLC, Spectrum Management Holding Company, LLC, Spectrum Gulf Coast, LLC, and Charter Communications, LLC, asserting the '251 patent. *Touchstream Techs., Inc. v. Charter Commc'ns, Inc. et al*, 2-23-cv-00059-RJG (E.D. Tex.). Related U.S. Patent Nos. 11,048,751 ("the '751 patent") and 11,086,934 ("the '934 patent") were added in a first amended complaint filed on May 25, 2023.

Patent Owner filed suit against Comcast, Comcast Corp., Comcast Cable Communications Management, LLC, and Comcast of Houston, LLC on February 17, 2023, asserting the '251 patent. *Touchstream Techs., Inc. v. Comcast Cable Commc'ns, LLC et al*, 2-23-cv-00062-RJG (E.D. Tex.). On that same day, Patent Owner filed suit against Altice USA, Inc., Cequel Communications, LLC, CSC Holdings, LLC, and Friendship Cable of Texas, Inc., asserting the '251 patent. *Touchstream Techs., Inc. v. Altice USA, Inc. et al*, 2-23-cv-00060-RJG (E.D. Tex.). The '751 patent and the '934 patent were also asserted against the Comcast entities and the Altice entities in first amended complaints.

On December 27, 2023, Comcast filed IPR2024-00322 for IPR of the '251 patent. *Comcast Cable Commc'ns, LLC v. Touchstream Techs., Inc.*, IPR2024-00322, Paper 2 (PTAB Dec. 27, 2023). On July 18, 2024, the Board instituted the

Comcast IPR. IPR2024-00322, Paper 13. The instant Petition is the same as the Comcast IPR: it involves the same patent, claims, grounds of unpatentability, and evidence.

III. LEGAL STANDARD

The Board has the authority to join Petitioner as a party to the Comcast IPR. 35 U.S.C. § 315(c); *see also* 35 U.S.C. § 315(d) (The Board also has the authority to consolidate proceedings.). Whether a request for joinder should be granted is discretionary. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB April 24, 2013).

"In deciding whether to join a party to an inter partes review, § 315(c) requires 'two different decisions,' first 'whether the joinder applicant's petition for IPR warrants institution under § 314,' and then whether to 'exercise . . . discretion to decide whether to join as a party the joinder applicant.' *See Facebook, Inc. v. Windy City Innov., LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). 'The statute makes clear that the joinder decision is made after a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.' *Id*. (citing *Thryv v. Click-to-Call Techs., LP*, 590 U.S. 45, 60 (2020))." *Intel Corp. v. VLSI Techn. LLC*, IPR2022-00479, Paper 13 at 4 (PTAB June 6, 2022).

"A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain

what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address[] specifically how briefing and discovery may be simplified." *Kingston Tech. Co., Inc. v. Securewave Storage Sols., Inc.*, IPR2020-00139, Paper 12 at 6–7 (PTAB Mar. 23, 2020); *see, e.g., Hyundai Motor Co. v. Am. Vehicular Sci. LLC*, IPR2014-01543, Paper 11 at 3 (PTAB Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (PTAB Aug. 13, 2014); *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 (PTAB July 29, 2013); *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB April 24, 2013)).

Under § 315(b), entities who would otherwise be time-barred may file IPR petitions with accompanying motions for joinder pursuant to § 315(c). The Federal Circuit has recognized that "§ 315(b) includes a specific exception to the time bar." *Facebook, Inc.,* 973 F.3d at 1333 (quoting 35 U.S.C. § 315(b)). "Congress . . . demonstrated that it knew how to provide an exception to the time bar by including a second sentence in the provision: 'The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).'" *Click-To-Call Techs., LP v. Ingenio, Inc., YellowPages.com, LLC*, 899 F.3d 1321, 1331 (Fed. Cir. 2018) (quoting 35 U.S.C. § 315(b)).

IV. STATEMENT OF REASONS FOR RELIEF REQUESTED

In view of the applicable law, the Board should exercise its discretion to grant joinder and institute Petitioner's copycat IPR on the '251 patent joining it to the Comcast IPR for the reasons set forth below under the *Kingston* framework.

A. Petitioner's Motion for Joinder is Timely

The Motion for Joinder and accompanying Petition are timely because they are filed less than one month after the July 18, 2024 decision instituting trial in the Comcast IPR. 37 C.F.R. § 42.122(b) ("Any request for joinder must be filed . . . no later than one month after the institution date of any inter partes review for which joinder is requested."); *see, e.g., Kingston Tech.*, IPR2020-00139, Paper 12 at 6–7 (holding that "me-too" petition was timely where it was filed more than one year after petitioner was sued for infringement but within one month of the institution of the IPR which petitioner sought to join); *Intel*, IPR2022-00479, Paper 13 at 17 ("Petitioner's timeliness in filing the Petition and requesting joinder minimized the potential disruption to an existing proceeding if joinder is granted . . . those aspects of Petitioner's approach support granting joinder.").

B. The Board Should Permit Joinder

In deciding whether to exercise its discretion and permit joinder, the Board considers: (1) why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) any impact joinder would have on the trial

schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera Corp*., IPR 2013-00004, Paper 15 at 4. Here, each of the four factors weighs in favor of joinder.

1. Joinder is Appropriate for Several Reasons

Joinder is appropriate here because the concurrently filed Petition involves the same patent, challenges the same claims, relies on the same exhibits, and is based on the same grounds and combinations of prior art submitted in the Comcast IPR. The concurrently filed Petition is substantively identical to the Comcast IPR petition, containing only minor differences relating to (a) the procedural formalities of having a different Petitioner file the Petition, and (b) changes to arguments regarding discretionary denial under § 314(a) that result from a different co-pending litigation. There are no changes to the facts, citations, evidence, or arguments presented in the grounds for unpatentability set forth in the Comcast IPR petition. Because the proceedings are substantively identical, good cause exists for joining Petitioner as a party to the Comcast IPR and consolidating the proceedings, so that the Board can efficiently resolve identical challenges in a single proceeding. *Central Security Grp. — Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11 at 8 (PTAB Feb. 26, 2020).

2. Petitioner Proposes No New Grounds of Unpatentability

The concurrently filed Petition presents the same grounds of unpatentability as the Comcast Petition and challenges the same claims. Therefore, Petitioner does not propose any new grounds of unpatentability and this factor also favors joinder.

3. Joinder Will Not Unduly Burden or Negatively Impact the Comcast IPR Trial Schedule

Because Petitioner's Petition is substantively identical to the Comcast Petition—presenting the same grounds and challenging the same claims using the same evidence—there are no new issues for Patent Owner to address. Further, joinder with the Comcast IPR will not unduly burden or negatively impact the schedule in that proceeding in any way. Thus, this factor also favors joinder. *Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 5, 2015) (granting motion where joinder does "not necessitate any additional briefing or discovery from Patent Owner beyond that already required [by the original IPR]").

4. How Briefing and Discovery May Be Simplified

The concurrently filed Petition and the Comcast Petition present substantively identical grounds of unpatentability, including the same combinations of art against the same claims. Additionally, if this motion for joinder is granted, Petitioner agrees to take an "understudy" role, adhering to the following restrictions, as described by the Board:

> "(a) *all* filings by [Petitioner] in the joined proceeding be consolidated with [Comcast's], unless a filing solely concerns issues that do not involve [Comcast]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Comcast IPR], or introduce any argument or discovery not already introduced by [Comcast]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [Comcast] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [Comcast alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [Comcast]."

Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17 at 5 (PTAB April 10, 2015); *Sony*, IPR2015-01353, Paper 11 at 6 (granting joinder where petitioners requested an "understudy" role). Petitioner will assume the primary role only if Comcast ceases to participate in the Comcast IPR.

By joining Petitioner in the Comcast IPR and allowing Petitioner to take on an understudy role, both briefing and discovery will be simplified because Patent Owner can maintain its current trial schedule and avoid duplicative efforts. The understudy role will minimize any potential complications or delay that potentially could result by joinder, including duplicative discovery and filings. *Sony*, IPR2015-01353, Paper 11 at 6–7 ("[J]oinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the board" where petitioners sought an "understudy" role.). Thus, this factor also favors joinder.

For these foregoing reasons, each of the factors that the Board considers in evaluating potential joinder weighs in favor of granting this Motion.

V. *GENERAL PLASTIC* IS INAPPLICABLE

The *General Plastic* analysis is inapplicable to this concurrently filed Petition. In *General Plastic*, the Board set forth factors for analyzing follow-on petitions. Generally, these factors are intended to help conserve the Board's resources and to prevent a subsequent petitioner from gaining a strategic advantage from filing a later petition. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).

Here, Petitioner is not filing a follow-on petition. Rather, Petitioner seeks to join the Comcast IPR as an understudy and does not present any new grounds. This is not the type of serial petition necessitating a *General Plastic* analysis. The Board has found that the *General Plastic* factors are "not particularly relevant" in this situation, i.e., where a different petitioner files a "me-too" or "copycat" petition with a timely motion for joinder. *Central Security Grp.*, IPR2019-01609, Paper 11 at 8; *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9–11 (PTAB Oct. 30, 2018).

Even if the Board were to consider the *General Plastic* factors, they would weigh in favor of institution. Petitioner has not previously filed a petition against the '251 patent. Petitioner and the prior petitioner are not the same party and have

no significant relationship. They are competitors accused of infringement based on sales of different products. This weighs against denial. *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-00465, Paper 11 at 9 (PTAB Aug. 12, 2021) (declining to extend General Plastic and Valve to different petitioner with no relationship to previous petitioners); *Mercedes-Benz USA, LLC v. Carucel Invs. L.P.*, IPR2019-01404, Paper 12 at 11–12 (PTAB Jan. 22, 2020); *Toshiba Am. Info. Sys., Inc. v. Walletex Microelecs. Ltd.*, IPR2018-01538, Paper 11 at 20 (PTAB Mar. 5, 2019).

The second through fifth factors relate to timing issues that are largely irrelevant. When Petitioner learned of the prior art, whether Petitioner received Patent Owner's preliminary response or an institution decision, and the length of time between the filing of the petitions, are all irrelevant. Petitioner did not previously file any IPR petition, has substantively duplicated the Comcast IPR, alleging the same facts, grounds, and prior art, and has agreed to take an understudy role. As a result, this IPR cannot be considered an attempt to harass Patent Owner or otherwise engage in serial, tactical filings. Petitioner seeks to simplify and minimize the number of distinct proceedings by joining the Comcast IPR rather than pursuing a separate IPR based on different grounds.

The sixth factor considers the Board's resources and the seventh factor relates to the Board's ability to meet the one-year statutory deadline. Allowing joinder here would not impact the Board's resources (beyond those dedicated to deciding this

Motion), and would not impact the Board's ability to meet the one-year statutory deadline.

For the foregoing reasons, the *General Plastic* factors do not weigh against institution and joinder of Petitioner to the Comcast IPR.

VI. CONCLUSION

Joinder will not affect the substance, procedure, or scheduling of the Comcast proceeding but will simplify the issues and promote efficiency, justice, and speed. For the foregoing reasons, Petitioner respectfully requests *inter partes* review of U.S. Patent No. 8,356,251 and joinder with IPR2024-00322.

Respectfully submitted,

Dated: August 9, 2024

/s/ Jeffrey A. Miller
Jeffrey A. Miller
Lead Counsel (Reg. No. 35,287)
Arnold & Porter Kaye Scholer LLP
3000 El Camino Real
Five Palo Alto Square, Suite 500
Palo Alto, CA 94306-3807
Telephone: 650.319.4500
Facsimile: 650.319.4700
jeffrey.miller@apks.com

Elizabeth A. Long
Backup Counsel (Reg. No. 51,966)
Arnold & Porter Kaye Scholer LLP
250 West 55th Street
New York, New York 10019-9710
Telephone: 212.836.8000
Facsimile: 212.836.8689
elizabeth.long@arnoldporter.com

CERTIFICATE OF SERVICE

I hereby certify that on August 9, 2024, I caused a true and correct copy of the foregoing PETITIONER'S MOTION FOR JOINDER to be served via FedEx Priority Overnight on the following:

SHOOK, HARDY & BACON LLP
Touchstream Technologies (149550)
INTELLECTUAL PROPERTY DEPARTMENT
2555 Grand Blvd. Kansas City, MO 64108

Courtesy copies of the foregoing document were served by e-mail on the following counsel of record for Touchstream Technologies, Inc., the Patent Owner, in the Underlying Litigation:

Robert H. Reckers
Anita Liu
Andrew M. Long
Shook Hardy & Bacon LLP
JPMorgan Chase Tower
600 Travis Street, Suite 3400
Houston, TX 77002-2926
Tel.: (703) 227-8008
rreckers@shb.com
aliu@shb.com
amlong@shb.com

Ryan D. Dykal
Jordan T. Bergsten
Mark D. Schafer
Boies Schiller Flexner, LLP
1401 New York Avenue, NW
Washington, DC 20005
Tel.: (202) 274-1109
rdykal@bsfllp.com
jbergsten@bsfllp.com
mschafer@bsfllp.com

Philip Eckert
Evan James Weidner
Shook, Hardy & Bacon LLP
2555 Grand Boulevard
Kansas City, MO 64108
Tel.: (816) 421-5547

Melissa Richards Smith
Gillam & Smith, LLP
303 South Washington Avenue
Marshall, TX 75670
Tel.: (903) 934-8450
melissa@gillamsmithlaw.com

peckert@shb.com
eweidner@shb.com

Courtesy copies of the foregoing document were served by e-mail on the following counsel of record for Touchstream Technologies, Inc., the Patent Owner in IPR2024-00322:

Kyle E. Friesen
Robert H. Reckers
SHOOK, HARDY & BACON L.L.P.
600 Travis Street, Suite 3400
Houston, TX 77002

Jason R. Mudd
Ryan Dykal
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108

August 9, 2024: ARNOLD & PORTER KAYE SCHOLER LLP

/s/ Jeffrey A. Miller
Jeffrey A. Miller
Counsel for Petitioner,
Charter Communications, Inc.