UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALTICE USA, INC.,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES INC.,
Patent Owner

U.S. Patent No. 8,356,251
Filing Date: September 26, 2011
Issue Date: January 15, 2013
Title: PLAY CONTROL OF CONTENT ON A DISPLAY DEVICE

Inter Partes Review No. IPR2024-01262

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b)

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I. STATEMENT OF RELIEF REQUESTED

Petitioner Altice USA, Inc. ("Altice" or "Petitioner") respectfully requests joinder of the concurrently filed petition for *inter partes* review of U.S. Patent No. 8,356,251 ("the '251 Patent") (IPR2024-01262) with *Comcast Cable Communications, LLC v. Touchstream Technologies, Inc.* IPR2024-00322, instituted July 18, 2024 ("the Comcast IPR"). (*See* IPR2024-00322, Paper 13.) The instant Petition is substantially the same as the Comcast IPR: it involves the same patent, the same claims, the same grounds of unpatentability, and the same evidence (including the same prior art combinations) as the Comcast IPR. If joined, as discussed further below, Altice will assume a "silent understudy" role and will not take an active role in the *inter partes* review proceeding unless the Comcast Petitioner ceases to participate in the instituted IPR.

The instant Petition also relies on the same declaration put forth by David B. Lett ("Comcast Declarant") in the Comcast IPR. Thus, the proposed joinder will neither unduly complicate the Comcast IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining patentability in the Comcast IPR without prejudice to Patent Owner.

Finally, this Motion for Joinder, and accompanying Petition, are timely because they are filed less than one month after a decision instituting trial in the Comcast IPR. 37 C.F.R. § 42.122(b) ("no later than one month after the institution

date of any *inter partes* review for which joinder is requested."). Accordingly, Altice respectfully requests that the Board grant this Motion for Joinder.

II. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standards

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (IPR) proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

> (c) JOINDER. – If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

A motion for joinder should "(1) set forth the reasons why 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." *Dell Inc. v. Network-1 Sec. Sols., Inc*., IPR2013-00385, Paper 17 (PTAB July 29, 2013); *Hyundai Motor Co. v. Am. Vehicular Scis. 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) (*quoting Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, at 4 (PTAB April 24, 2013)).

B. Altice's Motion Is Timely

A motion for joinder is timely if the moving party files within one month of institution of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). Because Altice files this motion within one month after a decision on the institution of the Comcast IPR, this motion is timely.

C. Joinder Is Appropriate

Joinder is appropriate because Altice's Petition does not raise any new grounds of unpatentability and does "not present issues that might complicate or delay" the Comcast IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). Altice's Petition is substantially identical to the petition in the Comcast IPR, challenging the same claims of the '251 Patent on the same grounds and relying on the same expert testimony. The primary difference between Altice's Petition and the petition filed in the Comcast IPR are the sections on Real Party-In-Interest, Related Matters, Counsel, and 35 U.S.C. § 314(a), which have been appropriately updated.

Further, to simplify this proceeding, and minimize the impact on the original proceeding, Altice relies on the same Comcast Declarant. Joinder would, therefore, have little, if any, impact on the Comcast IPR, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on any party or the PTAB, as detailed below.

1. No New Grounds of Unpatentability in the Petition

Altice's Petition does not assert any new grounds of unpatentability. It challenges the same claims (1–26) of the '251 Patent based on the same arguments and analysis, prior art, evidence, and three grounds of unpatentability as the Comcast IPR. *See, e.g.*, *Hyundai*, IPR2014-01543, Paper 11, at 2–4; *Dell*, IPR2013-00385, Paper 17, at 6–10. In addition, Altice filed the identical expert declaration of Comcast's expert.

2. No Impact on the Schedule for the Existing IPR Proceeding

Because Altice's Petition raises no new grounds of unpatentability, and because a Scheduling Order was established for the Comcast IPR less than one month ago, joinder should have no impact on the schedule of the Comcast IPR. *See LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (PTAB Oct. 5, 2015) (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Altice will adhere to all applicable deadlines set in the Scheduling Order for the Comcast IPR.

As discussed further below, Altice is willing to limit its participation in this proceedings to a "silent understudy." In the event that the Comcast IPR is terminated with respect to the Comcast Petitioner, only then does Altice intend to "step into the shoes" of the dismissed petitioner and materially participate in the joined

proceedings. Accordingly, for the reasons stated above, joinder of Altice to the Comcast IPR will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

3. Briefing and Discovery Will Be Simplified

As a "silent understudy," Altice agrees that, if joined, the following conditions will apply so long as Comcast remains an active party, as previously approved by the Board in other joinder circumstances:

(a) all filings by Altice in the joined proceeding will be consolidated with the filings of Comcast, unless a filing solely concerns issues that do not involve Comcast;

(b) Altice shall not be permitted to raise any new grounds not instituted by the Board in the Comcast IPR, or introduce any argument not already introduced by Comcast;

With regard to taking of testimony, Altice will abide by 37 C.F.R. (c) § 42.53 or any agreement between Patent Owner and Comcast. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17, at 5–6 (PTAB Apr. 10, 2015) (finding the same proposed limitations "are consistent with the 'understudy' role that Petitioner agrees to assume, as well as Petitioner's assertion that its presence would not require introducing any additional arguments, briefing, or discovery.").

Altice also is willing to abide by any additional conditions the Board deems appropriate.

4. Prejudice to Patent Owner

Joinder of Petitioner to the Comcast IPR will not create any additional burden on Patent Owner. Patent Owner need not expend any additional resources above and beyond those required in the current Comcast IPR. Moreover, joinder eliminates the need for Patent Owner to participate in multiple, staggered *inter partes* review proceedings instituted upon identical grounds of unpatentability.[1]

III. CONCLUSION

For the foregoing reasons, Altice respectfully requests that its Petition for *Inter Partes* Review of the '251 Patent be granted and that the proceedings be joined with IPR2024-00322.

Dated: August 16, 2024

Respectfully Submitted,

/Scott Border/

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[1] The argument that joinder may theoretically frustrate settlement between Comcast and Patent Owner is not a basis to deny joinder because that same possibility exists in every joinder situation. *Global Foundries U.S. Inc. v . Godo Kaisha IP Bridge 1*, IPR2017-00925 and IPR2017-00926, Paper 13, at 10 (PTAB June 9, 2017).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 16th day of August, 2024, I caused to be served a true and correct copy of **PETITIONER'S MOTION FOR JOINDER UNDER 37 C.F.R. §§ 42.22 AND 42.122(b)** by FedEx on the following:

SHOOK, HARDY & BACON LLP
Touchstream Technologies (149550)
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A courtesy copy of this Petition was also served upon litigation counsel for Patent Owner via email, as follows:

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