

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ALTICE USA, INC.,  
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,  
Patent Owner.

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IPR2024-01262  
Patent 8,356,251 B2

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Before GEORGIANNA W. BRADEN, MATTHEW S. MEYERS, and  
AARON W. MOORE, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION

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

Granting Motion for Joinder  
35 U.S.C. § 325(c); 37 C.F.R. § 42.122(b)

## I. INTRODUCTION

Petitioner, Altice USA, Inc., filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–26 of U.S. Patent No. 8,356,251 B2 (Ex. 1101, “the ’251 patent”). Touchstream Technologies (“Patent Owner”) did not file a Preliminary Response.

Petitioner also filed a Motion for Joinder to join as a petitioner in IPR2024-00322. Paper 3 (“Mot.”). Petitioner filed the Petition and Motion for Joinder on August 16, 2024, which was less than one (1) month after we instituted trial in IPR2024-00322. *See* Mot. 1–3. Patent Owner does not oppose the Motion for Joinder. *Id.*

As explained further below, we determine institution is warranted on the same grounds as instituted in IPR2024-00322 and we grant Petitioner’s Motion for Joinder.

### A. *Real Parties in Interest*

Petitioner lists Altice USA, Inc.; Cequel Communications, LLC; CSC Holdings, LLC; and Friendship Cable of Texas, Inc. as the real parties-in-interest. Pet. ix (“Mandatory Notices” section). Patent Owner states that it is a “real party-in-interest.” Paper 5 (Patent Owner’s Mandatory Notice), 1.

### B. *Related Proceedings*

The parties both identify multiple district court cases involving or impacting the ’251 patent. Pet. ix-xi (“Mandatory Notices” section); Paper 5, 1–2. Petitioner states that no administrative proceedings are related. Pet. xi (“Mandatory Notices” section). Patent Owner identifies several administrative proceeding as related matters. Paper 5, 2.

*C. IPR2024-00322*

In IPR2024-00322, Comcast Communications, LLC challenged claims 1–26 of the ’251 patent. After considering the Petition and Patent Owner’s Preliminary Response, we instituted review of the claims challenged in that case. *Comcast Cable Communications, LLC v. Touchstream Technologies, Inc.*, IPR2024-00322 (PTAB July 18, 2024) (Paper 13, “Comcast Inst.”). Thus, the instituted review in IPR2024-00322 (hereafter the “Comcast IPR”) involves the following grounds of unpatentability:

| <b>Claim(s) Challenged</b> | <b>35 U.S.C. §</b>  | <b>Reference(s)/Basis</b>                 |
|----------------------------|---------------------|-------------------------------------------|
| 1–26                       | 103(a) <sup>1</sup> | Danciu, <sup>2</sup> Mahajan <sup>3</sup> |
| 1–26                       | 103(a)              | Danciu, Mahajan, Calvert <sup>4</sup>     |
| 1–26                       | 103(a)              | Aldrey, <sup>5</sup> Mahajan              |

Comcast Inst. 6.

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<sup>1</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. The application for the ’251 patent was filed before this date, and Petitioner applies pre-AIA §§ 102 and 103. Ex. 1101, code (22); *see* Pet. 4, 9, 11, 13 (asserting references are prior art under pre-AIA §§ 102(b), (e)).

<sup>2</sup> US 9,490,998 B1, filed Mar. 7, 2011, issued Nov. 8, 2016 (Ex. 1112).

<sup>3</sup> US 2009/0248802 A1, published Oct. 1, 2009 (Ex. 1114).

<sup>4</sup> US 2004/0078812 A1, published Apr. 22, 2004 (Ex. 1111).

<sup>5</sup> US 2009/0172757 A1, published July 2, 2009 (Ex. 1115).

## II. DISCUSSION

Joinder for purposes of an *inter partes* review is governed by 35 U.S.C. § 315(c), which states:

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.

“To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). “First, the statute requires that the Director (or the Board acting through a delegation of authority . . . ) determine whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* “Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to ‘join as a party’ the joinder applicant.” *Id.*

### *A. Whether the Petition Warrants Institution of Inter Partes Review*

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” The patentability challenges in the Comcast IPR met the “reasonable likelihood” standard of § 314(a). IPR2024-00322, Paper 13, 36.

Petitioner contends that the grounds in the instant Petition—and evidence upon which they rely—are identical to the grounds in the Comcast

IPR. Mot. 1; *accord id.* at 4 (“Petition does not assert any new grounds of unpatentability.”); *accord id.* at 4 (“[Petitioner] is willing to limit its participation in this proceeding to a ‘silent understudy.’”). Patent Owner does not address whether Petitioner’s contention is accurate.

Based on our comparison of the Petition in this proceeding to the petition filed in the Comcast IPR, we agree with Petitioner. *Compare* Pet. 1–87, with IPR2024-00322, Paper 2, 1–88. Accordingly, for the reasons expressed in our Decision Instituting Review in IPR2024-00322 (Paper 13), we find that the Petition in this proceeding also warrants institution of *inter partes* review.

Even if a petition meets the “reasonable likelihood” standard, institution of *inter partes* review is still discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); 35 U.S.C. § 314(a) (“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”). Therefore, we now address Petitioner’s Motion for Joinder.

*B. Whether the Motion for Joinder Should Be Granted*

Petitioner requests joinder pursuant to 35 U.S.C. § 315(c), which “authorizes joinder of a person as a party, not ‘joinder’ of two proceedings” and “does not authorize the joined party to bring new issues from its new proceeding into the existing proceeding.” *Facebook*, 973 F.3d at 1335. As the moving party, Petitioner has the burden of proof in establishing

entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b).

Petitioner argues that its Motion is timely, the “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.” Mot. 1, 4. Furthermore, Petitioner agrees that, if joined as a party to the Comcast IPR, it will act as “silent understudy” and will not assume an active role unless Comcast terminates its involvement after joinder. Mot. 1, 4–5.

Under the present circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in IPR2024-00322. Nonetheless, we lay out the following restrictions in order to ensure minimal impact on the trial schedule, cost, discovery, and potential briefing. Specifically, we limit Petitioner Altice USA, Inc.’s participation in the joined proceeding, such that (1) Comcast Communications, LLC alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Altice USA, Inc. is bound by all filings by Comcast Communications, LLC in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Altice USA, Inc. receives permission to file an independent paper. Altice USA, Inc. must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding, so long as Comcast Communications, LLC remains as a non-terminated petitioner in the joined proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in IPR2024-00322 and protects the interests of Comcast Communications, LLC as original petitioner in IPR2024-00322, and of Patent Owner.

For the foregoing reasons, and with the limitations discussed above, Petitioner's Motion for Joinder is *granted*.

### III. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted as to claims 1–26 of the '251 patent on all challenges raised in the Petition

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2024-00322 is granted, and Altice USA, Inc. is joined as a petitioner in that case pursuant to 37 C.F.R. § 42.222, based on the conditions discussed above;

FURTHER ORDERED that the Petition is instituted, pursuant to 35 U.S.C. § 314;

FURTHER ORDERED that the Scheduling Order in place for IPR2024-00322 (Paper 14) shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding shall be made only in IPR2024-00322;

FURTHER ORDERED that the case caption in IPR2024-00322 for all further submissions shall be changed to add Altice USA, Inc. as a named Petitioner after Comcast Communications, LLC and Charter Communications, Inc., and to indicate by footnote the joinder of IPR2024-00322 to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2024-00322.

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Patent 8,356,251 B2

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Sample Case Caption

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COMCAST LLC, CHARTER COMMUNICATIONS, INC.<sup>6</sup>, and ALTICE  
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<sup>6</sup> Charter Communications, Inc., which filed a petition in IPR2024-01231, has been joined as a party to this proceeding.

<sup>7</sup> Altice USA, Inc., which filed a petition in IPR2024-01262, has been joined as a party to this proceeding.