

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALTICE USA, INC.

Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

Patent No. 11,048,751
IPR2024-01263

**UNOPPOSED MOTION TO
WITHDRAW PETITION FOR INTER PARTES REVIEW**

I. INTRODUCTION

In an e-mail dated February 13, 2025, the Board authorized Petitioner to file a motion to withdraw its petition for *inter partes* review along with Petitioner's motion for joinder to IPR2024-00324 and thereby terminate IPR2024-01263 directed to U.S. Patent No. 11,048,751 ("the '751 Patent").

On February 6, 2024, the Board denied the motion for rehearing of its decision denying institution in IPR2024-00324, which IPR2024-01263 sought to join. Petitioner notes that IPR2024-01263 is in its preliminary phase and Patent Owner Touchstream Technologies Inc. does not oppose this motion. There is no written settlement agreement or any other collateral written agreement between the parties made in connection with, or in contemplation of, the withdrawal of the petition. To preserve the Board's and parties' resources and to achieve a just, speedy, and inexpensive resolution to this dispute, Petitioner requests the Board withdraw the petition for *inter partes* review and thereby terminate IPR2024-01263.

II. RELATED PROCEEDINGS

The '751 Patent is or was the subject of the following civil actions:

- *Charter Communications, Inc. v. Touchstream Technologies, Inc.* IPR2024-01232 (PTAB);
- *Comcast Cable Communications, LLC v. Touchstream Technologies, Inc.*, IPR2024-00323 (PTAB);

- *Comcast Cable Communications, LLC v. Touchstream Technologies, Inc.*, IPR2024-00324 (PTAB);
- *Touchstream Technologies, Inc. v. Charter Commc'ns, Inc.*, Case No. 2:23-cv-00059 (E.D. Tex., Marshall Division);
- *Touchstream Technologies, Inc. v. Altice USA, Inc.*, Case No. 2:23-cv-00060-JRG (E.D. Tex., Marshall Division);
- *Touchstream Technologies, Inc. v. Comcast Cable Commc'ns, LLC*, Case No. 2:23-cv-00062 (E.D. Tex., Marshall Division); and
- *Touchstream Technologies, Inc. v. Altice USA, Inc.*, Case No. 2:24-cv-03186 (E.D.N.Y.).

The following do not involve the '751 Patent but does involve patents related to the '751 Patent:

- *Charter Communications, Inc. v. Touchstream Technologies, Inc.*; IPR2024-01231 (PTAB);
- *Altice USA, Inc. v. Touchstream Technologies, Inc.*; IPR2024-01262 (PTAB);
- *Comcast Cable Commc'ns, LLC v. Touchstream Technologies, Inc.*, IPR2024-00321 (PTAB);
- *Comcast Cable Commc'ns, LLC v. Touchstream Technologies, Inc.*, IPR2024-00322 (PTAB);
- *Comcast Cable Commc'ns, LLC v. Touchstream Technologies, Inc.*, IPR2024-00325 (PTAB);
- *Comcast Cable Commc'ns, LLC v. Touchstream Technologies, Inc.*, IPR2024-00326 (PTAB);
- *Google LLC v. Touchstream Technologies, Inc.*, Case No. IPR2022-

00793 (PTAB);

- *Google LLC v. Touchstream Technologies, Inc.*, Case No. IPR2022-00794 (PTAB);
- *Google LLC v. Touchstream Technologies, Inc.*, Case No. IPR2022-00795 (PTAB);
- *Google LLC v. Touchstream Technologies, Inc.*, Case Nos. 24-1207, -1208, -1210 (Fed. Cir.) (consolidated appeals);
- *Touchstream Technologies, Inc. v. Google LLC*, Case No. 6:21-cv-00569-ADA (W.D. Tex., Waco Division);
- *Touchstream Technologies, Inc. v. Vizbee, Inc.*, Case No. 1:17-cv-06247 (S.D. NY);
- *Touchstream Technologies, Inc. v. Vizio, Inc.*, Case No. 8:24-cv-02328 (C.D. Cal.); and
- *Touchstream Technologies, Inc. d/b/a Shodogg v. Yamaha Corp.*, Case No. 2:24-cv-00739 (E.D. Tex.)

III. ARGUMENT

Good cause exists to withdraw Petitioner’s petition for *inter partes* review and thereby terminate IPR2024-01263 pursuant to 37 C.F.R. § 42.71(a) and § 42.72. IPR2024-01263 is in its preliminary stage as the Board has not yet reached the merits or issued a decision on institution. Accordingly, withdrawal at this time would preserve both the Board’s and the parties’ resources in accordance with the intent of 37 C.F.R. § 42.1(b) “to secure the just, speedy, and inexpensive resolution [of] every proceeding.”

Withdrawal of Petitioner's petition for *inter partes* review is also a just resolution as Patent Owner will not be prejudiced by such withdrawal and subsequent termination of IPR2024-01263. The lack of any such prejudice is evidenced by Patent Owner's non-opposition to the filing of this motion to withdraw.

IV. CONCLUSION

Petitioner respectfully requests withdrawal of the instant Petition for *inter partes* review and that the Board terminate IPR2024-01263.

Dated: February 20, 2025

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 20th day of February, 2025, I caused to be served a true and correct copy of the foregoing MOTION TO WITHDRAW PETITION FOR INTER PARTES REVIEW by email on the following counsel for patent owner:

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