

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2022-00795
Patent 8,356,251 B2

Before DEBRA K. STEPHENS, DANIEL J. GALLIGAN, and
AMBER L. HAGY, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background and Summary*

In this *inter partes* review, Google LLC (“Petitioner”) challenges claims 1, 2, and 5–9 of U.S. Patent 8,356,251 B2 (Ex. 1001 (“’251 Patent”)), assigned to Touchstream Technologies, Inc. (“Patent Owner”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a), addresses issues and arguments raised during the trial in this *inter partes* review. For the reasons discussed below, we determine that Petitioner has failed to prove by a preponderance of the evidence that claims 1, 2, and 5–9 of the ’251 Patent are unpatentable (*see* 35 U.S.C. § 316(e) (2018) (“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”)).

B. *Procedural History*

Petitioner filed a petition for *inter partes* review (Paper 1 (“Pet.” or “Petition”)) challenging claims 1–5, 8, 11, 12, 14, 15, 27, and 28 of the ’251 Patent.

Petitioner relies upon the following prior art references:

Reference	Exhibit No.
Muthukumarasamy et al., US 2010/0241699 A1, published Sept. 23, 2010 (“Muthukumarasamy”)	1008
Hayward, US 8,918,812 B2, issued Dec. 23, 2014 (“Hayward”)	1009

(Pet. 2). Petitioner challenges the claims on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5–9	103	Muthukumarasamy
1, 2, 5–9	103	Muthukumarasamy, Hayward

(Pet. 2–3). Patent Owner timely filed a Preliminary Response (Paper 6 (“Prelim. Resp.”)). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 7 (“Pet. Reply to POPR”)), and Patent Owner filed a Sur-reply to Petitioner’s Preliminary Reply (Paper 9 (“PO Sur-reply to Pet. Reply”)). We instituted trial on the asserted grounds of unpatentability (Paper 10 (“Inst. Dec.” or “Institution Decision”)).

After institution, Patent Owner filed a Request for Rehearing and review by the Precedential Opinion Panel (Paper 12). The Precedential Opinion Panel denied review (Paper 19, 2). We denied rehearing (Paper 20, 3).

During the trial, Patent Owner filed a Response (Paper 18 (“PO Resp.”)), Petitioner filed a Reply (Paper 22 (“Pet. Reply” or “Petitioner Reply”)), and Patent Owner filed a Sur-reply (Paper 25 (“PO Sur-reply” or “Patent Owner Sur-reply”). An oral hearing was held on June 13, 2023, a transcript of which appears in the record (Paper 34 (“Tr.”)).

Petitioner relies on testimony from Dr. Benjamin B. Bederson (Ex. 1005). Patent Owner relies on testimony from Dr. Kevin C. Almeroth (Ex. 2022). Patent Owner entered into the record a transcript of the deposition of Dr. Bederson (Ex. 2021). No deposition of Dr. Almeroth was entered into the record (*see* Tr. 103:22–24 (Patent Owner’s counsel noting that “Petitioner did not cross-examine Dr. Almeroth”)).

C. Real Parties in Interest

Patent Owner identifies itself as the real-party-in-interest (Paper 5, 1).

Petitioner identifies itself as the real-party-in-interest (Pet. 79).¹

D. Related Matters

Petitioner and Patent Owner indicate the '251 Patent was asserted in the following district court proceeding: *Touchstream Techs, Inc. v. Google, LLC*, No. 6-21-cv-00569 (W.D. Tex.) (Pet. 79; Paper 5, 1). Petitioner further indicates that the '251 Patent was asserted in the following district court proceeding: *Touchstream Techs., Inc v. Vizbee, Inc.*, No. 1-17-cv-06247 (S.D.N.Y.) (Pet. 79; Paper 30, 1). Patent Owner additionally identifies the following cases:

Touchstream Technologies, Inc. v. Altice USA, Inc., No. 2:23-cv-00060-JRG (E.D. Tex., Marshall Division);

Touchstream Technologies, Inc. v. Comcast Cable Commc 'ns, LLC, No. 2:23-cv-00062 (E.D. Tex., Marshall Division); and

Touchstream Technologies, Inc. v. Charter Commc 'ns, Inc., No. 2:23-cv-00059 (E.D. Tex., Marshall Division)

(Paper 30,1).

We are concurrently issuing final written decisions in IPR2022-00793, involving related U.S. Patent 8,782,528 B2, and IPR2022-00794, involving related U.S. Patent 8,904,289 B2.

¹ Petitioner states that Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc., and that XXVI Holdings Inc. and Alphabet Inc. are not real parties-in-interest to this proceeding (Pet. 79 n.4).

E. The '251 Patent (Ex. 1001)

The '251 Patent, titled “Play Control of Content on a Display Device,” issued January 15, 2013 (Ex. 1001, codes (45), (54)). The '251 Patent describes a system that “allow[s] a personal computing device,” e.g., a mobile phone, “to be used to select different content to be played on a remote display,” e.g., a television set, and “allow[s] the user to control how the content is displayed on the display device using the personal computing device” (Ex. 1001, 2:11–15, 2:27–33). Figure 1, reproduced below, is a block diagram illustrating an exemplary system (Ex. 1001, 2:41–42).

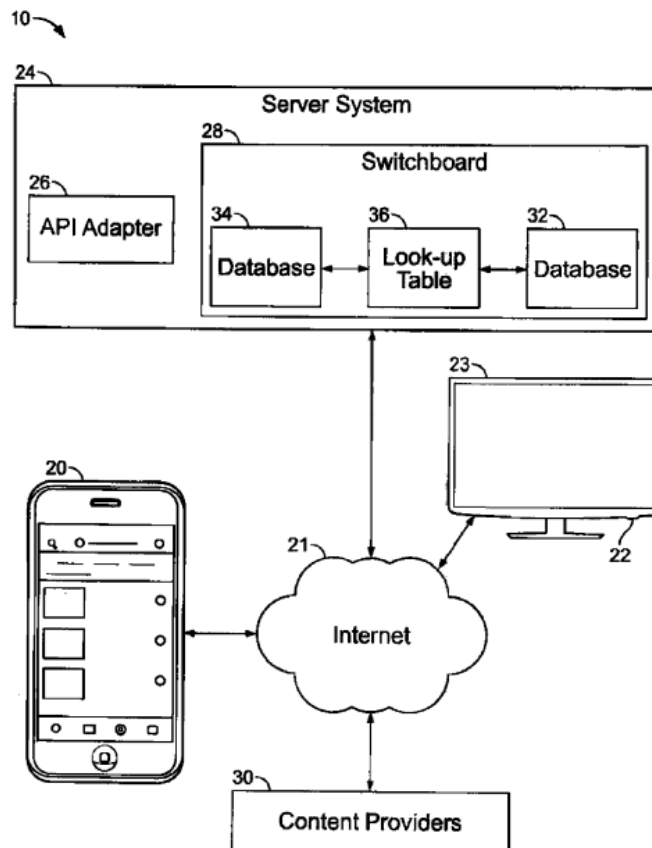


FIG. 1

As shown in the block diagram of Figure 1, “a first device (e.g., a personal computing device) 20” connects to and “acts as a controller” for “a second device (e.g., a television set 22 with a display 23) [and the second device]

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