

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:

<b>Claim(s) Challenged</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>
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).<sup>1</sup>

*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.

---

<sup>1</sup> 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).

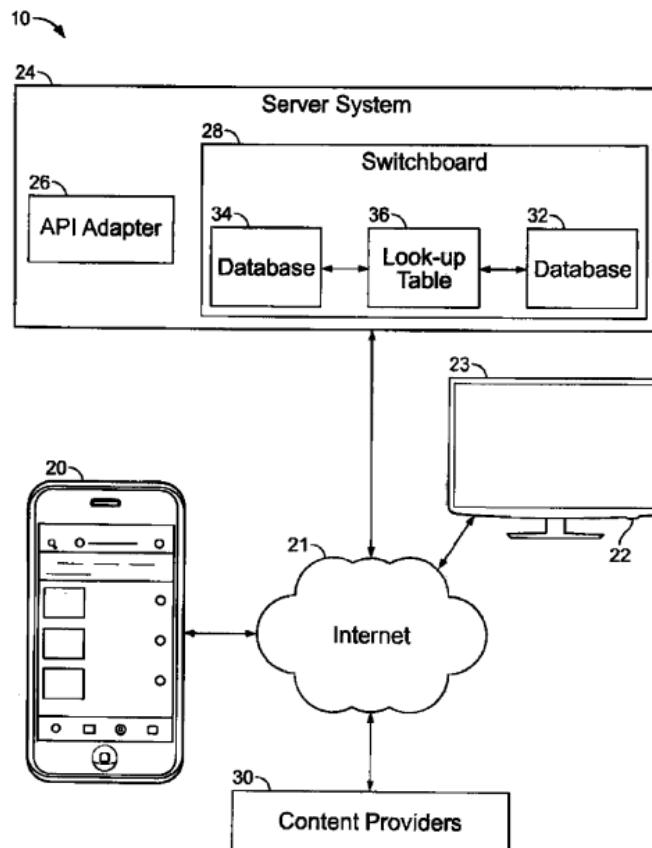


FIG. 1

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]

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.