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Pursuant to Federal Rule of Civil Procedure 72(b) and Local Rule CV-72(c), Comcast respectfully objects to the Report & Recommendation (the “R&R”), Dkt. No. 322, denying Comcast’s Motion for Partial Summary Judgment (the “Motion” or “Mot.”), Dkt. No. 85. Review of the R&R is de novo. *Traxxas LP v. Hobby Prods. Int’l, Inc.*, 2018 WL 953334, at *1 (E.D. Tex. Feb. 20, 2018).

Touchstream only asserts method claims, which can be infringed only by actually performing the patented method. As relevant here, each Asserted Claim requires that a particular message, i.e., a remote-tune request, be sent from another device to the accused X1 set-top boxes (“STBs”). Yet Touchstream’s technical expert, Dr. Kevin Almeroth, opines that all Comcast X1 STBs with the mere *capability* of receiving such remote-tune requests from another device infringe the Asserted Claims. That is incorrect as a matter of law. Without actually receiving such a message, neither an X1 STB nor any other element in Comcast’s system can perform the claimed methods, and there can be no infringement.

There is no genuine dispute that an X1 STB that has not received a remote-tune request cannot infringe, or be involved in any infringement of, any Asserted Claim. Accordingly, Comcast moved for summary judgment that any X1 STB that has not received an accused remote-tune request from another device does not infringe. As set forth below and in the Motion, the R&R erred in denying that Motion.

I. FACTUAL BACKGROUND

The Asserted Claims are all method claims. Touchstream’s Opposition to Motion (“Opp.”), Dkt. No. 122 at 3. It is undisputed that each claim requires receiving a remote-tune request sent from a mobile phone or other computing device. Opp. at 3; Mot. at 2.

Dr. Almeroth opines that the “Accused TV Remote Functionalities” infringe the Asserted Claims. Dkt. No. 85-4 ¶ 122. The Accused TV Remote Functionalities are implemented by

what Dr. Almeroth identifies as the “Infringing Instrumentalities,” which include Comcast’s TV Remote mobile application (“TV Remote App”). *Id.* ¶¶ 59, 122, 127. “Comcast’s TV Remote application enables users to select and control playback of content.” *Id.* ¶ 174.

Dr. Almeroth opines that “Comcast supports remote control sessions *through the XFINITY TV Remote Application installed on a personal computing device . . .*” Dkt. No. 85-4 ¶ 129 (emphasis added); *see* Opp. at 3; Mot. at 2. Thus, to initiate playback using the TV Remote App, a user must first download the TV Remote App on to his or her mobile device and log in with Comcast account credentials to use the application. Dkt. No. 85-4 ¶ 245 & App. 1; Dkt. No. 85-8 at 39:20–45:23. Dr. Almeroth identifies the TV Remote App as the only source of remote-tune requests. Dkt. No. 85-4 ¶ 167; *see* Opp. at 3; Mot. at 3. However, it is undisputed that not all Comcast subscribers have downloaded and used the TV Remote App and, accordingly, not all X1 STBs have actually been involved in a remote tune. Opp. at 3; Mot. at 3; *see* Dkt. No. 85-8 at 39:20–45:23. Dr. Almeroth nevertheless opines that “*any ‘XFINITY X1 STB,’ that is, capable of receiving remote tune requests from another device*, infringes the Asserted Claims of the Touchstream Patents.” Dkt. No. 85-4 ¶ 59 (emphasis added); *see* Opp. at 3; Mot. at 2. Because mere capability is insufficient to establish infringement of the Asserted Claims, Comcast moved for partial “summary judgment that any X1 [STB] that has not received an accused remote tune request from another device does not infringe.” Mot. at 1.

II. ARGUMENT

“A method claim is directly infringed only by one practicing the patented method.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 576 F.3d 1348, 1359 (Fed. Cir. 2009) (“*Cardiac*”) (quoting *Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 773 (Fed. Cir. 1993)). Thus, a product does not infringe a method claim simply because it is capable of performing the claimed process. *See, e.g., Infernal Tech., LLC v. Sony Interactive Ent., LLC*, 19-cv-00248-JRG, Dkt.



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