

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C.,
Petitioner,

v.

BROADBAND iTV, INC.,
Patent Owner.

IPR2020-01333
Patent 10,506,269 B2

Before JEFFREY S. SMITH, JUSTIN T. ARBES, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

On July 24, 2020, Petitioner DISH Network L.L.C. filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–17 of U.S. Patent No. 10,506,269 B2 (Ex. 1101, “the ’269 patent”). Patent Owner Broadband iTV, Inc. filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). Petitioner also filed a separate paper providing an explanation for filing multiple petitions ranking its petition in Case IPR2020-01332 ahead of its Petition in this proceeding. Paper 3. Patent Owner filed a response. Paper 8. With our authorization (Paper 10), Petitioner filed a Reply (Paper 12) and Patent Owner filed a Sur-Reply (Paper 13) directed solely to an issue regarding whether we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a).

The standard for instituting review is set forth in 35 U.S.C. § 314(a), which provides that

[t]he 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.

Thus, § 314(a) does not mandate institution, even if the reasonable likelihood threshold is met. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *see also 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.”).

For the reasons that follow, we do not institute an *inter partes* review in this proceeding.

B. Related Matters

The parties indicate that the '269 patent is the subject of three district court cases: *Broadband iTV, Inc. v. DISH Network, L.L.C.*, Case No. 19-cv-716 (W.D. Tex.), *Broadband iTV, Inc. v. AT&T Services, Inc.*, Case No. 19-cv-712 (W.D. Tex.), and *Broadband iTV, Inc. v. DirecTV, LLC*, Case No. 19-cv-714 (W.D. Tex.). *See* Pet. 3–4; Paper 5, 1. Petitioner filed another petition challenging claims 1–17 of the '269 patent in Case IPR2020-01332 (Paper 1) (“the 1332 Petition”) on the same day it filed this Petition, and Petitioner filed six other petitions challenging claims of related patents also asserted in the district court cases in Cases IPR2020-01267, IPR2020-01268, IPR2020-01280, IPR2020-01281, IPR2020-01359, and IPR2020-01360. A different petitioner previously filed two petitions challenging claims of a parent patent to the '269 patent, U.S. Patent No. 7,631,336 B2, in Cases IPR2014-01222 and CBM2014-00189, both of which were denied. *See* Pet. 4; Paper 5, 2.

C. Real Parties in Interest

Petitioner identifies the following real parties in interest: DISH Network L.L.C. and DISH Network Corporation. Pet. 3. Patent Owner identifies itself as the real party in interest. Paper 5, 1.

D. Prior Art and Asserted Ground

Petitioner asserts that claims 1–17 of the '269 patent are unpatentable on the following ground:

Claims Challenged	35 U.S.C. §	References/Basis
1–17	103(a) ¹	Gonder, ² Son, ³ Kelts ^{4,5}

II. ANALYSIS

The Board’s November 2019 Consolidated Trial Practice Guide⁶ (“TPG”) advises that “one petition should be sufficient to challenge the claims of a patent in most situations” but also “recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” TPG 59. The TPG further provides:

To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Based on the chain of priority of the '269 patent, we refer to the pre-AIA version of 35 U.S.C. § 103.

² US 8,434,118 B2, issued Apr. 30, 2013 (Ex. 1105).

³ US 7,159,233 B2, issued Jan. 2, 2007 (Ex. 1106).

⁴ US 2001/0030667 A1, published Oct. 18, 2001 (Ex. 1107).

⁵ Petitioner asserts that claims 1–17 are unpatentable “over the combination of Gonder, Son, and/or Kelts, when considered in view of the knowledge of a person of ordinary skill in the art.” Pet. 6. The use of “and/or” in this context typically implies multiple asserted grounds, but, for purposes of this Decision, we list it as one ground because we are exercising discretion to deny the Petition.

⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a).

TPG 59–60; *see* TPG 60 n.3 (“A separate paper filed with the petitions is limited to providing this explanation and shall be no more than 5 pages where the same paper is filed with each petition.”).

As noted above, Petitioner filed another petition, the 1332 Petition, challenging the same claims of the '269 patent. The 1332 Petition asserts obviousness of claims 1–17 based on the combination of Perez (US 2006/0026655 A1) and Kelts (US 2001/0030667 A1). Perez is the U.S. patent application publication of Application 10/909,192 (“the '192 application”), filed on July 30, 2004, which is the earliest application appearing in the chain of priority of the '269 patent. *See* Ex. 1101, code (60), 1:9–50. A continuation-in-part of the '192 application was filed on March 12, 2007, and the application for the '269 patent claims priority through a chain of continuations and a divisional application to the March 12, 2007, application. *See* Ex. 1101, code (60), 1:9–50. Perez was published on February 2, 2006, and, therefore, is prior art under 35 U.S.C. § 102(b) to claims that only have priority to the March 12, 2007, date of the continuation-in-part application. IPR2020-01332, Ex. 1008, code (43).

In its paper explaining why two are petitions necessary, Petitioner argues that the present Petition “should be instituted along with the [1332] Petition because it is expected that Patent Owner will argue that [the] '269

patent is entitled to the July 2004 priority date and that Perez is not prior art.” Paper 3, 3. Petitioner notes that fact discovery in the co-pending litigation had not begun when the Petition was filed and argues that, “[a]lthough [Petitioner] believes the position that the ’269 patent can claim priority to Perez is meritless, two petitions are necessary to cover the possibility that unforeseen arguments or evidence will allow Patent Owner to establish the earlier priority date.” Paper 3, 3–4.

In its responsive paper, Patent Owner asserts that “Petitioner’s argument does not amount to a ‘priority date’ issue as contemplated by the TPG” because “[n]o priority date issue has been raised.” Paper 8, 3. According to Patent Owner, therefore, “any such dispute is purely based on speculation, and thus no ‘dispute about priority’ exists that warrants institution of multiple proceedings.” Paper 8, 3 (citing TPG 59). Patent Owner’s argument suggests that multiple petitions are only warranted when a patent owner has already attempted to claim priority back to an earlier application, rather than when a patent owner has the opportunity to do so but simply has not done so yet. Even assuming that “a dispute about priority date” in the TPG refers to when a patent owner has already raised the issue, this is merely one “example” of a circumstance that justifies multiple petitions. TPG 59. In any event, under the circumstances presented here, we do not see the priority date as an issue that justifies a second petition because, based on Patent Owner’s arguments in IPR2020-01332, we see no avenue by which Patent Owner’s priority arguments could be successful as explained below.

Patent Owner has the burden of production to show that the claims of the ’269 patent are entitled to an earlier priority date. *See In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016); *Dynamic Drinkware*,

LLC v. Nat'l Graphics, Inc., 800 F.3d 1375, 1379–80 (Fed. Cir. 2015) (discussing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008)). For Patent Owner to show that the '269 patent is entitled to the 2004 priority date of Perez, thereby eliminating Perez as prior art, Patent Owner must show how the written descriptions in the earlier applications through which priority is claimed, and ultimately Perez, support the challenged claims. “[T]o gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997)); *see also In re Hogan*, 559 F.2d 595, 609 (CCPA 1977) (“[T]here has to be a continuous chain of copending applications each of which satisfies the requirements of § 112 with respect to the subject matter presently claimed.” (quoting *In re Schneider*, 481 F.2d 1350, 1356 (CCPA 1973)) (alteration in original)). As explained above, the chain leading back to Perez includes a continuation-in-part application filed on March 12, 2007, which added content to the written description of the parent application (published as Perez). Ex. 1101, code (60).

In Patent Owner’s paper responding to Petitioner’s explanation for filing multiple petitions, Patent Owner does not represent that it will not seek priority back to the 2004 date. *See generally* Paper 8. Yet, in its briefing in IPR2020-01332, Patent Owner argues that Perez does not provide support for certain recited subject matter. In particular, Patent Owner identifies several recitations in claim 1 of the '269 patent and argues that “[t]he combination [of] Perez and Kelts fails to disclose the aforementioned claim elements.” IPR2020-01332, Paper 9, 44–45. Patent Owner also argues that

“the Petition’s invalidity arguments suffer numerous fatal flaws, such as the prior art failing to disclose providing an electronic program guide and video-on-demand content to an ‘interactive mobile application.” IPR2020-01332, Paper 9, 31. We also note that in the related district court case between the parties, Patent Owner asserts a March 12, 2007, priority date for claims 1–6, 8–12, and 14–17 of the ’269 patent. Ex. 1122, 2–3.

On this record, given Patent Owner’s arguments that Perez does not disclose certain subject matter recited in claim 1, we see no avenue by which Patent Owner can successfully show that Perez provides written description support for all of the subject matter recited in claim 1. Thus, we do not see how “a priority date dispute will negate [Petitioner’s] first ground,” making a second ground necessary. *See* Paper 3, 3.

Petitioner also argues that two petitions are necessary because “the length and complexity of the claims of the ’269 patent make it impossible to present both grounds within the word limit for a single petition.” Paper 3, 1–2. But as discussed above, we are not persuaded that a second ground is necessary to address a potential priority date dispute. Thus, we are not persuaded that a second petition is needed to present Petitioner’s unnecessary second ground.

We therefore determine that one petition is sufficient to address the challenged claims of the ’269 patent. Petitioner has ranked the 1332 Petition as the stronger petition of the two. Paper 3, 2. For the reasons explained in our institution decision in that case, which issues concurrently with this Decision, we determine Petitioner has shown a reasonable likelihood of prevailing on its challenge based on the combination of Perez and Kelts.

III. CONCLUSION

Based on the foregoing, we do not institute an *inter partes* review in this proceeding.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied and no *inter partes* review is instituted in this proceeding.

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