

Board Institutes in Spite of *Fintiv* Even Though the WDTX Trial Was Scheduled To Complete First and the Court Had Already Reached a Markman Decision

AUGUST 31, 2021

Dish Network LLC v. Broadband iTV, Inc., [Case IPR2020-01332, Paper 14](#); [Case IPR2020-01333, Paper 14](#) (PTAB January 27, 2021).

Before: Smith, Arbes, Galligan.

Dish Network filed two petitions challenging the patentability of the same Broadband patent. In a separate paper filed with the petitions, Dish ranked one petition ahead of the other. Broadband asserted that the petitions should be denied under the Board's discretionary authority under both § 325 and § 314. The Board disagreed, instituting the 1332 petition and denying institution of the 1333 petition in view of its institution of the other.

Under § 314 discretion, the Board applied the *Fintiv* factors and found they did not support a discretionary denial of institution of the 1332 petition. Three of the factors most prominently contributed to the Board's analysis. First, under the proximity in time factor, the Board found that while the current schedule of the parallel district court litigation would place the district court trial two months prior to the final written decision deadline, there was some persuasive evidence that delays in the district court were possible. In particular, the Board found that a pending transfer motion made a delay possible. Given this, "the efficiency and system integrity concerns that animate the *Fintiv* analysis [were] not particularly strong." Second, under the investment in the parallel proceedings factor, the Board was "not persuaded" that the Court's issuance of a Markman ruling, the parties exchanging final contentions, and the Court's ruling on a motion to dismiss "indicate the type of significant investment that would support exercising [the Board's] discretion to deny institution." Under this same factor, the Board also found the petitioner's diligence also weighed against a discretionary denial of institution. And, finally, under the other circumstances factor, the Board found the merits of the petition's grounds were strong.

As for § 325(d) discretion, the asserted priority date of the challenged patent factored heavily in the Board's decision. The challenged patent claimed priority to a 2007 continuation-in-part of a 2004 application. The 1332 petition asserted that the challenged patent was only entitled to the 2007 CIP priority date. Because of this, the 1332 petition asserted that the published version of the 2004 application was 102(b) prior art because it published more than one year before the 2007 CIP. Although this was unclear at the time of the petition, in both the parallel district court litigation and the IPR proceedings, the patent owner would go on to assert the challenged patent was entitled only to the 2007 CIP priority date and not the 2004 date.

Rather than attempt to swear behind the asserted published application by asserting the 2004 priority date, the patent owner's preliminary response instead argued that the 1332 petition should be denied institution under § 325(d) discretion because the patent owner had disclosed the *issued patent* from the 2004 application to the examiner during prosecution. But the Board found that the issued patent of the 2004 application was not 102(e) prior art to the challenged patent because it was not "by another." The published version of the 2004 application, on the other hand, *was* 102(b) prior art because it had issued more than a year before the 2007 CIP date. Thus, while the patent owner made the examiner aware of the "disclosure" and "teachings" of the application, it did not make the examiner aware of a disclosure that was "prior art." Thus, § 325(d) discretion did not apply.

The Board also rejected patent owner's argument for § 325(d) discretion based on the "Kelts" reference that was another part of the petition's asserted prior art obviousness combination. Patent Owner asserted that Kelts was cumulative of a "Novak" prior art reference disclosed to the examiner because both references had similar teachings of viewing Internet content on client devices. The Board found that while the two references had similar teachings, the § 325(d) inquiry is whether the asserted reference is cumulative of the prior art considered during examination as a whole, not whether the asserted reference is cumulative of one particular reference considered during examination. The asserted reference was not cumulative of the considered art as a whole, so the Board found § 325(d) discretion was inapplicable.

After disposing of patent owner's arguments for a discretionary denial of the 1332 petition, the Board would go on to institute review of the 1332 petition.

The 1333 petition asserted that a second petition was necessary because there was a potential dispute regarding the priority date of the challenged patent and whether the published version of the 2004 application was prior art. But, as already mentioned, the patent owner ultimately did not assert the challenged patent was entitled to the 2004 priority date. Thus, the Board denied the 1333 petition in view of the lack of a priority date dispute and its institution of the 1332 petition.

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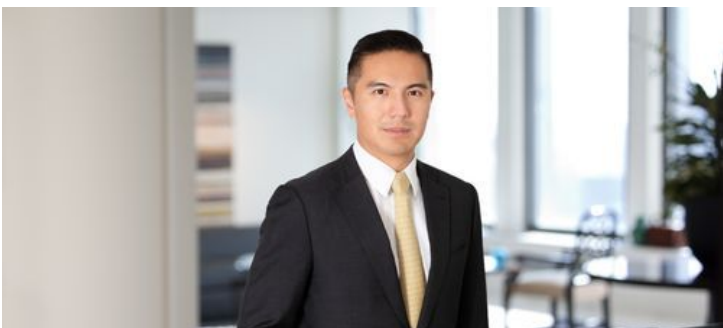
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