

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DISH NETWORK L.L.C.,  
Petitioner

v.

BROADBAND iTV, INC.,  
Patent Owner

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Case IPR2020-01267  
Patent 10,028,026 B2

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**PATENT OWNER'S REQUEST FOR REHEARING OF THE DECISION  
GRANTING INSTITUTION OF *INTER PARTES* REVIEW (PAPER 15)  
AND SUGGESTION FOR EXPANDED PANEL REVIEW**

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Alexandria, VA 22313-1450

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        1. The Panel misapprehended or overlooked the parties’ significant investment in the parallel litigation, reaching a conclusion inconsistent with *Sand Revolution* and *Fintiv II*. ....9

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## I. INTRODUCTION

Patent Owner Broadband iTV, Inc. (“BBiTV”) respectfully requests rehearing of the January 21, 2021 Decision Granting Institution of *Inter Partes* Review. Paper 15 (“DI”). The Panel misapprehended or overlooked key facts and legal precedent, and abused its discretion when evaluating and weighing the *Fintiv* factors. BBiTV also respectfully suggests an Expanded Panel should review and reverse the DI to maintain uniformity in how panels apply Board precedent.

## II. LEGAL STANDARDS

A party dissatisfied with a decision may file a request for rehearing. 37 C.F.R. § 42.71(d). The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed. *Id.* The Board reviews such requests for an abuse of discretion. *Id.* “An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004).

## III. EXPANDED PANEL REVIEW

Under the Board’s SOP 1 (Revision 15), BBiTV respectfully suggests that an Expanded Panel decide this Request to secure and maintain uniformity in applying Board precedent in *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-

00752, Paper 8 (PTAB Sept. 12, 2018), *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”), and their progeny. That institution decisions are largely nonappealable, *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1372-73 (2020), enhances the need for Expanded Panel Review here.

#### **IV. GOOD CAUSE EXISTS TO CONSIDER NEW EVIDENCE.**

*Huawei* permits a party to provide new evidence with a request for rehearing upon showing good cause. *Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19 at 3-4 (PTAB Jan. 8, 2019) (precedential). Here, good cause exists for the Panel to consider Exhibits 2031-2033, including DISH’s final invalidity contentions (EX2031) and AT&T’s final invalidity contentions (EX2032), collectively including over 200 claim charts and over 20,000 pages.<sup>1</sup>

First, the Panel previously granted DISH’s request to brief an unrelated Federal Circuit decision, finding good cause existed merely because DISH argued that the decision was relevant to the Board’s analysis of the second *Fintiv* factor. Paper 11 at 3 (“[W]e determine that there is good cause for a limited reply based on Petitioner’s assertions regarding the potential relevance of the *Apple* decision to our analysis of the second *Fintiv* factor.”). The new evidence here is not just “poten-

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<sup>1</sup> Accounting for the Panel’s concern about the amount of material to review, BBiTV significantly pruned Exhibits 2031 and 2032, seeking to provide only the most relevant portions of defendants’ contentions for the Panel’s consideration.

tially relevant”; it is highly relevant to the *Fintiv* analysis. It provides critical new information about the state of the parallel litigation, showing significant investment under factor 3 and nearly complete overlap under factor 4, as discussed below.

Second, both sets of contentions were served in January 2021, and thus BBiTV could not have filed them with its POPR. AT&T’s contentions were served January 29, 2021, after the DI issued. Third, DISH suffers no prejudice if the Panel considers this evidence. By contrast, BBiTV suffers significant prejudice in potentially having to defend its patents in IPRs that should not have been instituted. Finally, good cause exists because considering this evidence furthers the policy objectives undergirding *Fintiv*: efficiency, fairness, and integrity of the patent system.

## V. ARGUMENTS

The Panel misapprehended or overlooked key facts and abused its discretion in evaluating and weighing the *Fintiv* factors. Under Board precedent, each *Fintiv* factor weighs in favor of denying institution. Under factors 2 and 4, the Panel should also consider the AT&T case, set for trial in November 2021, because AT&T’s final invalidity contentions demonstrate that the Panel will duplicate much of the district court’s efforts. *See* Paper 9 (“POPR”), 14; Paper 14, 2.

The Panel failed to properly determine the relative weights of the factors. The Panel held that factor 1 is “neutral,” DI, 13; factor 2 “is, at most, slightly in favor of” discretionary denial, DI, 18; factor 3 “weighs strongly against” denial, DI,

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