

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.

IPR2020-01267
Patent 10,028,026 B2

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

ARBES, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing of Decision on Institution
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner filed a Request for Rehearing (Paper 18, "Req. Reh'g") of our Decision (Paper 15, "Dec.") to institute an *inter partes* review of claims 1–16 of U.S. Patent No. 10,028,026 B2 (Ex. 1001, "the '026 patent"). Petitioner contends that we "misapprehended or overlooked key facts and legal precedent, and abused [our] discretion when evaluating and weighing"

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the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). Req. Reh’g 1. Patent Owner also “suggests an Expanded Panel should review and reverse the [Decision] to maintain uniformity in how panels apply Board precedent.” *Id.*

Our governing statutes and regulations do not provide for parties to request, or panels to authorize, an expanded panel. *See generally* 35 U.S.C. § 6; 37 C.F.R. §§ 41.1–42.412. The Chief Judge, however, may consider panel expansion upon a “suggestion” from a judge, panel, or party. PTAB Standard Operating Procedure (SOP) 1,¹ 15; *see also Apple Inc. v. Rensselaer Polytechnic Inst.*, IPR2014-00319, Paper 20 at 2 n.1 (PTAB Dec. 12, 2014) (expanded panel) (per curiam).

The Standard Operating Procedure exemplifies some of the reasons for which the Chief Judge may expand a panel. PTAB SOP 1, 15 (§ III.M). For example, an expanded panel may be appropriate “to secure and maintain uniformity of the Board’s decisions, e.g., in related cases ordinarily involving different three judge panels.” *Id.* (§ III.M.1).

Upon receiving the Rehearing Request, we followed the procedure set forth in § III.M.3 of SOP 1 regarding a suggestion for an expanded panel. In this case, the Chief Judge has considered Patent Owner’s suggestion for an expanded panel but has determined that an expanded panel is not warranted.

For the reasons stated below, Patent Owner’s Request for Rehearing is *denied*.

¹ Available at <https://www.uspto.gov/sites/default/files/documents/SOP%201%20R15%20FINAL.pdf>.

II. STANDARD OF REVIEW

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “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). The party requesting rehearing bears the burden of showing an abuse of discretion, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

III. ANALYSIS

A. Patent Owner’s Request to Admit New Evidence

Before turning to Patent Owner’s arguments regarding discretionary denial under 35 U.S.C. § 314, we consider Patent Owner’s request to admit new evidence into the record. *See* Req. Reh’g 2–3. A precedential Board decision advises that,

[i]deally, a party seeking to admit new evidence with a rehearing request would request a conference call with the Board prior to filing such a request so that it could argue “good cause” exists for admitting the new evidence. Alternatively, a party may argue “good cause” exists in the rehearing request itself.

Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC, IPR2018-00816, Paper 19 at 4 (PTAB Jan. 8, 2019) (precedential). “Absent a showing of ‘good cause’ prior to filing the request for rehearing or in the request for rehearing itself, new evidence will not be admitted.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 90, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>. At Patent

Owner's request, we held a conference call with the parties before Patent Owner filed its rehearing request to hear arguments on whether good cause exists to admit certain new evidence. *See* Ex. 2034 (transcript of February 2, 2021, conference call).

During the call, Patent Owner sought authorization to file three items in this proceeding:

(1) Petitioner's Final Invalidity Contentions and relevant claim charts served January 8, 2021, in *Broadband iTV, Inc. v. DISH Network, L.L.C.*, Case No. 6:19-cv-716 (W.D. Tex.)² ("the Texas case");

(2) AT&T Services, Inc., AT&T Communications, LLC, and DIRECTV, LLC's Final Invalidity Contentions and relevant claim charts served January 29, 2021, in *Broadband iTV, Inc. v. AT&T Services, Inc.*, Case No. 6:19-cv-712 (W.D. Tex.), and *Broadband iTV, Inc. v. DirecTV, LLC*, Case No. 6:19-cv-714 (W.D. Tex.) (consolidated into Case No. 6:19-cv-712 (1:20-cv-717-ADA), "the AT&T case"); and

(3) a PACER report of the current docket in the Texas case.

Ex. 2034, 6:15–25. Patent Owner explained that Petitioner's final invalidity contentions "include about 180 claim charts that total about 7,500 pages" and that "AT&T's [final invalidity] contentions include about 50 charts totaling over 17,000 pages." *Id.* at 7:24–8:3. Patent Owner argued that good cause exists to admit this evidence, which Petitioner disputed. *See generally id.*

On the call, we expressed concern with the volume of information Patent Owner sought to introduce, and Patent Owner agreed to file a much smaller volume of information (approximately 1,000 pages). *Id.* at 23:24–31:1. We reserved ruling on Patent Owner's request to admit the new

² We refer to the United States District Court for the Western District of Texas as "the Texas court."

evidence because, at that point, we could not reach a “good cause” determination without knowing exactly what Patent Owner would seek to admit, and we instructed Patent Owner to present its arguments regarding good cause in its rehearing request. *Id.* at 31:8–32:8, 35:5–12.

After the conference call, Patent Owner filed a total of 538 pages of evidence in Exhibits 2031–2033, significantly less than the initial volume of evidence it sought to introduce. Patent Owner argues that good cause exists to admit this evidence because “it is highly relevant to the *Fintiv* analysis” and “provides critical new information about the state of the parallel litigation, showing significant investment under factor 3 and nearly complete overlap under factor 4.” Req. Reh’g 2–3. Patent Owner also notes that the invalidity contentions were both served in January 2021, and, therefore, could not have been submitted with Patent Owner’s Preliminary Response (Paper 9, “Prelim. Resp.”), which was filed in October 2020. Req. Reh’g 3.

Having considered Patent Owner’s arguments on rehearing and the parties’ arguments during the conference call on February 2, 2021, we grant Patent Owner’s request to admit Exhibits 2031–2033 with the Request for Rehearing and discuss the evidence below where relevant.

B. Discretionary Denial Under 35 U.S.C. § 314(a)

Patent Owner argues that we “misapprehended or overlooked key facts and abused [our] discretion in evaluating and weighing the *Fintiv* factors.” Req. Reh’g 3. Patent Owner also argues that we should consider the AT&T case in evaluating the second and fourth *Fintiv* factors. *Id.* For the reasons explained below, we disagree that we should exercise discretion to deny institution.

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