

PROTECTIVE ORDER MATERIAL

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

Case IPR2020-01267
U.S. Patent No. 10,028,026

DECLARATION OF LEIGHTON CHONG

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BBiTV EX2037
DISH v. BBiTV

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I, Leighton Chong, declare and state as follows:

1. I have been a registered patent attorney since May 16, 1975. My registration number is 27,621. I am licensed to practice law in New York and Hawaii. I currently reside in Honolulu, Hawaii. I am an of counsel attorney at Ostrager Chong Flaherty & Broitman P.C.
2. In 2003, I began working with Broadband iTV, Inc. (“BBiTV”) in efforts to protect the young company’s intellectual property, which included a software platform BBiTV was developing relating to video-on-demand technology. I worked primarily with Milton Diaz Perez, the inventor of the patent at issue in this proceeding, and Clifton Kagawa, Mr. Perez’s boss, to develop BBiTV’s intellectual property strategy.
3. On March 3, 2004, I met with Mr. Perez to discuss filing for a patent on his inventions at BBiTV. During this meeting, Mr. Perez disclosed to me the full subject matter contained within U.S. Patent Application 10/909,192 (“’192 application”) (EX2062) and the full subject matter of the March 31, 2004 draft of U.S. Patent Application 10/909,192 (“March Draft”) (EX2061). As was commonly my practice, a patent application would undergo several drafts to incorporate in writing the full disclosure of the invention. That was the case here. After Mr. Perez disclosed the full subject matter of the March Draft and the ’192 application at the March 3, 2004 meeting, the application underwent several drafts.

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4. During the March 3, 2004 meeting, Mr. Perez disclosed to me a roadmap of the different parts of the video-on-demand system and its interaction with an internet-connected device. *See* EX2063. At that meeting, we discussed internet connected set-top boxes and other internet connected digital devices (*e.g.*, computers) that could utilize and receive video from Mr. Perez's video-on-demand system.

5. Mr. Perez indicated that he would provide me with a description of the invention in writing for me to use as a basis for drafting the patent application that resulted in the '192 application. I corresponded with Mr. Perez on March 18 and March 19, 2004, requesting updates from Mr. Perez regarding his progress on drafting the patent specification. *See* EX2064; EX2065.

6. On March 29, 2004, Mr. Perez sent me a first draft of the patent specification. *See* EX2068. On March 30, 2004, I wrote to Mr. Perez that the draft reflected what we had mapped out during our meeting, and I requested diagrams that Mr. Perez had drawn on a whiteboard at the March 3, 2004 meeting. EX2179.

7. On March 31, 2004, I sent Mr. Perez and Mr. Kagawa the March Draft of what would become the filed '192 application. *See* EX2060; EX2061.

8. In April and May 2004, Mr. Perez and I continued corresponding about preparation of the patent application, as evidenced by emails exchanged on April 22 and April 24, and May 27, 2004. *See* EX2181-EX2184.

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9. From mid-May through June 14, I was working on revising the March Draft pursuant to Mr. Perez's feedback. Mr. Perez informed me that, while he would be engaged in fundraising meetings for BBiTV in early June, he would be reviewing the patent application draft and planned to provide edits. EX2102. During this timeframe, Mr. Perez was carefully reviewing the March Draft and providing me with his feedback, which I was using to revise the draft patent application. For example, on or about June 7, 2004, Mr. Perez sent me via email several questions about the use of the terms "VoD" and "iTV" in the draft patent application; and I responded to Mr. Perez's questions in an email on June 9, 2004. EX2105.

10. Mr. Perez, who lived in California at the time, and I, who lived in Hawaii at the time, arranged to meet in-person to discuss the disclosure of the draft '192 application on the evening of June 15 when Mr. Perez would be in Hawaii where BBiTV was based. EX2106. After the June 15 meeting, I revised and edited the draft '192 application from June 16-22, 2004 based on my discussions with Mr. Perez at the June 15 meeting. I met with Mr. Perez again on June 22, 2004, to review and discuss the draft '192 application. EX2107. Mr. Perez and I met again on June 24, 2004, to further discuss my edits and revisions to the draft '192 application (as the planned meeting on June 23 was cancelled due to Mr. Perez's busy schedule at BBiTV). EX2108. After the June 24, 2004 meeting, Mr. Perez

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and I decided that Mr. Perez should continue working on the drawings for the '192 application in light of our conversation. EX2109. Mr. Perez sent me a list of questions about the application on June 29. EX2117. I responded and asked Mr. Perez to, among other things, "sketch out an example Logic Diagram" on June 30. EX2118. Mr. Perez also completed a draft of these drawings, which I received on June 30, 2004. *See, e.g.*, EX2110-2116.

11. From June 30 to July 15, 2004, I worked on the draft '192 application making numerous revisions to the draft with input from Mr. Perez resulting in a further revised draft of the '192 application in EX2120 that was sent to Mr. Perez for review on July 15, 2004. EX2119. From July 15-21, Mr. Perez reviewed the revised draft '192 application in EX2120 in detail and provided me with "additions" to be added to the draft. EX2121. Between July 21 and July 26, 2004, I revised the draft '192 application and made Mr. Perez's suggested "additions" to the draft prior to a scheduled meeting with Mr. Perez on July 27, 2004. EX2121; EX2122.

12. Mr. Perez and I met on July 27 to finalize the application. EX2121-EX2122. On July 28, 2004, BBiTV provided approval to file the '192 application; and I finalized the application on July 29-30, 2004, resulting in the filing of the '192 application on July 30, 2004. *See* EX2185 (email confirming application filing).

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