

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.,  
AT&T SERVICES, INC., and DIRECTV, LLC,<sup>1</sup>  
Petitioner.

v.

BROADBAND iTV, INC.,  
Patent Owner.

**CONFIDENTIAL PORTION**

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IPR2020-01267  
Patent 10,028,026 B2

Record of Oral Hearing  
Held: November 1, 2021

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

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<sup>1</sup> AT&T Services, Inc. and DIRECTV, LLC filed a motion for joinder and a petition in Cases IPR2021-00603, and IPR2021-00649, which were granted, and, therefore, have been joined as petitioners in these proceedings.

IPR2020 01267  
Patent 10,028,026 B2

APPEARANCES:

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The above-entitled matter came on for hearing on Monday,  
November 1, 2021, commencing at 11:19 a.m. EDT, via Video  
Teleconference.

1 P-R-O-C-E-E-D-I-N-G-S

2 11:19 a.m.

3 JUDGE ARBES: This is the confidential portion of the hearing in  
4 Case IPR2020-01267, involving Patent 10,028,026.

5 We'll follow the same order of presentation as the public portion, and  
6 have confirmed that only the parties and the Board are on the line.

7 Any questions from the parties before we begin?

8 MR. ROBERTS: None from Petitioner, Your Honors.

9 MR. TONKOVICH: None from Patent Owner.

10 JUDGE ARBES: Okay. Counsel for Petitioner, you may begin.  
11 And would you like to reserve time for rebuttal?

12 MR. ROBERTS: Yes, thank you. I'll reserve seven minutes. So, 18  
13 minutes on the primary, if I could.

14 Thank you, I'd like to ask the Board to start with Slide 7. The only  
15 point I want to make about this is timing, which is that in order to antedate  
16 Gonder, they need to both show constructive reduction to practice. And they  
17 need to show an earlier conception date.

18 Either one of them is not sufficient on its own, because Gonder is  
19 before their alleged date of constructive reduction to practice.

20 Slide 10, the well-constructed reduction to practice, I don't need to  
21 tell the Board this, but for thoroughness, it requires that they show basically  
22 that they have an adequate written description.

23 They have to possess the full scope of what they claim is the  
24 invention, in order to get constructive reduction to practice from the 2004  
25 application.

1           And the problem is, Your Honor, that they do not have the  
2 internet-connected digital device, as claimed.

3           Now sometimes in the parties' papers and in the slides, people just  
4 talk about the internet-connected digital device. But I want to point out to  
5 the Board that the first limitation of the claim, called for the internet-  
6 connected digital device being configured to obtain and present to the  
7 subscriber, an electronic program guide as a templated video-on-demand  
8 display, et cetera.

9           So, it is not nearly sufficient, wouldn't be sufficient to show that you  
10 had the idea of an internet-connected digital device. You have to show that  
11 you have the full scope of what is claimed, which includes an  
12 internet-connected digital device configured for this purpose.

13           Meaning, it has to be an integrated part of the invention, not merely  
14 the idea that internet-connected digital devices existed.

15           Moving to Slide 11, the Board's seen this picture before. But the  
16 point is that when you look at the 2004 application, the only discussion of  
17 the internet is in connection with the upload path from the end user web  
18 browser, to the web-based content management system.

19           And when we talk about the ICDD, the internet-connected digital  
20 device of the claim, we're talking about what is used to present the electronic  
21 program guide to the consumer. And in the image that they gave the Board  
22 in the 2004 spec, this is the, Digital Set-Top Box 21, in red. And as you can  
23 see, it is connected to the system via the Digital Cable Television System. It  
24 is not connected via the internet.

1           There is nothing in the 2004 application that discusses connecting  
2 the Digital Set-Top Box 21, to anything else via the internet. It's never  
3 discussed that way.

4           Slide 12, in fact when you look at what it talks about, and this is  
5 from Paragraph 22 of the July 24 -- July 2004 application. It talks about the  
6 VOD application for the CATV, the cable TV system. And it's talking about  
7 the fact, you key press on the viewer's remote, that is sent on a back channel  
8 of the Digital Cable Television System. So, it's very clear all the way  
9 through the patent, and consistent that the digital set-top box connects  
10 through the traditional digital cable, CATV system.

11           Conversely, and this is in blue, when they talk about the Web-based  
12 Content Management System, they do talk about uploading over the internet.  
13 So, they knew how to talk about the internet. They understood what the  
14 internet was. They knew what the web was. And they used that to talk  
15 about the upload mechanism. But there is no discussion of that, or having  
16 reduced it to practice, for the delivery to the client device or the consumer.

17           Slide 13, this is the material they added in 2007 to change that. In  
18 the 2007, they added literally, 50 percent of the text, and they added half the  
19 drawings. And they added express support for internet-connected digital  
20 devices, including phones, media players, game consoles, iPods, PDAs and  
21 the like. That was added in 2007.

22           So, this is Slide 14, then the question is, how did they get there?  
23 And what they're attempting to do is they're attempting to pull in material  
24 from the Navic Patent location. And that doesn't work for the four reasons I  
25 have outlined here.

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