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
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I.   INTRODUCTION

A.   *Background and Summary*

Petitioner DISH Network L.L.C. filed a Petition (Paper 1, "Pet.")
requesting *inter partes* review of claims 1–16 of U.S. Patent No. 10,028,026
B2 (Ex. 1001, "the '026 patent") pursuant to 35 U.S.C. § 311(a). Patent
Owner Broadband iTV, Inc. filed a Preliminary Response (Paper 9, "Prelim.

Resp.") pursuant to 35 U.S.C. § 313. Petitioner also filed an explanation for filing multiple petitions ranking its Petition in this proceeding ahead of its petition in Case IPR2020-01268 (Paper 3). Patent Owner filed a response (Paper 8). With our authorization (Paper 11), Petitioner filed a Reply (Paper 13, "Reply") and Patent Owner filed a Sur-Reply (Paper 14, "Sur-Reply") directed solely to an issue regarding whether we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a).

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we institute an *inter partes* review as to claims 1–16 of the '026 patent on all grounds of unpatentability asserted in the Petition.

B. Related Matters

The parties indicate that the '026 patent is the subject of three district court cases: *Broadband iTV, Inc. v. DISH Network L.L.C.*, Case No. 6:19-cv-716 (W.D. Tex.)[1] ("the Texas case"), *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, "the AT&T case"). *See* Pet. 4; Paper 6, 1; Ex. 2009. Petitioner filed another petition challenging claims 1–16 of the '026 patent in Case IPR2020-01268, and filed six other petitions challenging

---

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

claims of related patents also asserted in the district court cases in Cases IPR2020-01280, IPR2020-01281, IPR2020-01332, IPR2020-01333, IPR2020-01359, and IPR2020-01360. Two different petitioners previously filed petitions challenging claims of a parent patent to the '026 patent, U.S. Patent No. 7,631,336 B2 (Ex. 1013, "the '336 patent"), in Cases IPR2014-01222 and CBM2014-00189, both of which were denied. *See* Pet. 5; Paper 6, 2.

C. The '026 Patent

The '026 patent discloses devices and methods for "converting, navigating and displaying video content uploaded from the Internet on a digital TV video-on-demand platform." Ex. 1001, col. 1, ll. 42–46. Video-on-demand (VOD) systems allow a viewer to "navigate through a program guide via the remote control unit and send a request via the set-top box for a desired video program to be addressed from the head-end to the subscriber's set-top box for display on the TV." *Id.* at col. 2, ll. 3–19. The '026 patent explains that "VOD content offerings [were] expected to increase dramatically" in the future and it was "desirable to find a way for . . . vast numbers of content publishers to transmit their programs to the home TV, and to enable home TV viewers to find something of interest for viewing among the vast numbers of new programs." *Id.* at col. 2, l. 66–col. 3, l. 12.

The disclosed VOD content delivery system "offers a gateway for greatly expanding TV viewing from a relatively small number of studio-produced program channels to a large number of new commercial publishers and ultimately a vast number of self-publishers or so-called 'citizen' content publishers." *Id.* at col. 3, ll. 3–12. The system provides

subscribers with an electronic program guide (EPG) for navigating through "hierarchically-arranged categories and subcategories" to find the title of desired video content, allowing subscribers to locate titles of interest "by navigating through the hierarchical addressing scheme of the provider's EPG." *Id.* at col. 3, l. 16–col. 4, l. 5.

A VOD application server at a cable head end manages a database of templates and video content segments for "generating templatized VOD content." *Id.* at col. 5, ll. 24–29, Fig. 1A. "The VOD content is generated in response to a viewer request signal transmitted from" the viewer's digital set-top box to the cable head end. *Id.* at col. 5, ll. 29–33. The '026 patent discloses that

> templates are of different types ordered in a hierarchy, and display of content in a template of a higher order includes links the viewer can select to content of a lower order in the hierarchy. Upon selecting a link using the remote control, the VOD Application Server 10 retrieves the template and video content of lower order and displays it to the viewer. Each successive templatized display may have further links to successively lower levels of content in the hierarchy, such that the viewer can use the series of linked templatized VOD displays as a "drill down navigation" method to find specific end content of interest.

Id. at col. 6, ll. 9–20, Fig. 1B (depicting exemplary "drill down navigation" for a set of automobile infomercials, where the viewer can navigate by make, model, dealer, sales event, and inventory).

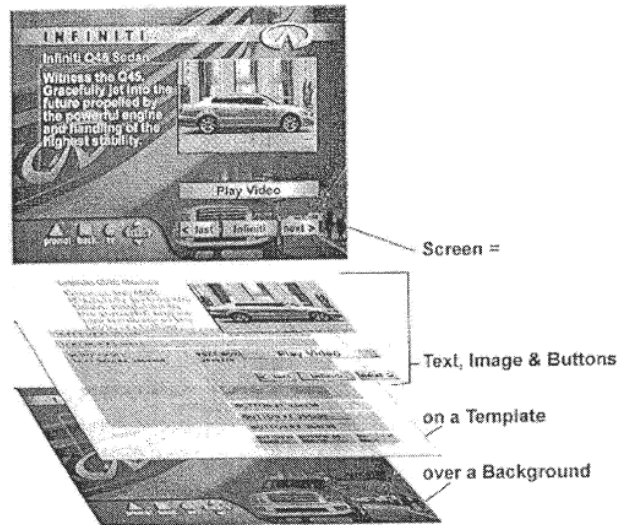Figure 1C of the '026 patent is reproduced below.

Figure 1C: Template Layer Model

Figure 1C depicts "a templatized VOD display . . . generated in layers." *Id.*

at col. 7, ll. 18–19. As shown in Figure 1C,

> [a] Background screen provides a basic color, logo, or graphical theme to the display. A selected Template (display frame) appropriate to the navigation level the intended display resides on is layered on the Background. The Template typically has a frame in which defined areas are reserved for text, display image(s), and navigation links (buttons). Finally, the desired content constituted by associated Text, Image & Buttons is retrieved from the database and layered on the Template. The resulting screen display shows the combined background logo or theme, navigation frame, and text, video images, and buttons.

Id. at col. 7, ll. 19–30.

The '026 patent also describes a web-based content management system for "enabling an individual user to upload content from their computer via a web browser to display a consumer-generated video ad" (e.g., a classified ad). *Id.* at col. 8, ll. 10–21, Fig. 2A. "The uploaded content includes meta data for classifying the video ad by title and topical area(s)." *Id.* at col. 8, ll. 21–22. A content conversion system

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.