

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 No. IPR2020-01267

**PETITIONER'S EXPLANATION OF MULTIPLE PETITIONS
CHALLENGING U.S. PATENT 10,028,026 AND RANKING OF
PETITIONS**

Pursuant to the July 2019 Trial Practice Guide Update, Petitioner DISH Network L.L.C. (“DISH”) provides this paper explaining the need to file two parallel petitions requesting *inter partes* review (“IPR”) of claims 1-16 of U.S. Patent No. 10,028,026. DISH is requesting IPR of the ’026 patent in Petition No. IPR2020-01267 based on the references Gonder, Son, and Kelts (the “Gonder Petition”), and Petition No. IPR2020-01268 based on the references Hecht, Son, Scheffler and CableLabs (the “Hecht Petition”). The ’026 patent is owned by Broadband iTV, Inc. (“Patent Owner”).

A. Two Petitions Are Necessary Based On The ’026 Patent’s Lengthy and Complex Claims.

Although it is common practice to present IPR petitions with two grounds in a single petition, DISH must present its two grounds in two petitions because the length and complexity of the claims of the ’026 patent make it impossible to present both grounds within the word limit. For example, Claim 1 of the ’026 patent is 500 words long, and is broken up into seven paragraphs. And Patent Owner is asserting 15 of the 16 claims challenged by the petitions.

DISH’s petitions are also long because they must present multiple references as a result of the way the claims were drafted. Because VOD systems were well-known in the prior art, most references, including those with the most detailed and relevant disclosures, focus on advances in specific areas of an overall VOD system. The challenged claims, in contrast, were drafted by concatenating elements from

across an entire VOD system. For example Claim 1 of the '026 patent contains limitations directed to multiple parts of a video on demand system; including the types of metadata sent from the providers to the cable company, the ingest of that information, the use of that information to create an electronic program guide, the structure and contents of the screens within that guide, the transmission of that guide to end users, and how those users interact with that guide to find and request programming. The petitions therefore require multiple references, each of which must be discussed and analyzed along with the motivation to combine them. Moreover, as explained below, the parties have a dispute about the priority date of the '026 patent, which required additional words to address. As a result of these unique circumstances, both the Gonder Petition and Hecht Petition approach the word limits even though each only presents a single obviousness ground.

B. A Second Ground Is Needed Due To Non-Substantive Vulnerabilities with DISH's First Ground.

DISH's second ground is necessary because of non-substantive vulnerabilities with the first ground. Although both petitions show a reasonable likelihood that at least one claim of the '026 patent is invalid, DISH ranks the petitions as follows:

Rank	Petition	Grounds
1	IPR2020-01267	Obviousness over Gonder, Son and/or Kelts
2	IPR2020-01268	Obviousness over Hecht, Son, Scheffler and/or CableLabs

While substantively stronger, the Gonder ground has potential exposure to a non-substantive basis for denial, discussed below. Although DISH believes neither basis is meritorious, the ground presented in the Hecht Petition does not share this exposure and is provided to ensure that the claims of the '026 patent can be examined on the merits and the state of the prior art.

The Gonder reference on which DISH's first ground relies could be antedated, as the parties dispute the priority and invention dates of the '026 patent. The '026 patent purports to claim priority to a patent filed in July 2004, but it is also descended from another patent issued from a continuation-in-part application filed in March 2007. As explained in more detail in DISH's petitions and in the accompanying supporting declarations of Dr. Samuel Russ, DISH contends that the '026 patent's claims rely on the new matter added in the continuation-in-part and are therefore entitled only to the March 2007 priority date. Patent Owner, however, contends that claims 1-9 of the '026 patent are entitled to the July 2004 priority date and have an invention date as early as October 2003.

Although DISH has a strong basis to dispute both the July 2004 priority date and Patent Owner's claims of an even earlier conception date, the Gonder patent has a filing date of May 2004 and a publication date of December 2005. It could, therefore, be antedated if Patent Owner prevails on both issues. While DISH would have preferred to obtain discovery before filing two petitions, fact discovery in the

co-pending litigation has not begun. And the Board has made it clear through its recent decisions that any delay would expose DISH's petitions to risk of discretionary denial. Because it is unlikely that the invention date issue will be resolved at the institution stage, the Board should institute IPR on both the Gonder Petition and Hecht Petition to ensure that the '026 patent's validity can be assessed based on the substantive disclosures of prior-art references, regardless of the determinations made concerning the priority and conception dates of the '026 patent.

C. The Gonder Petition and Hecht Petition are Non-Cumulative.

Both the Gonder Petition and Hecht Petition should be instituted because each petition presents a meritorious, unique obviousness ground with different system architectures and analytical frameworks. The Gonder petition relies primarily on the Gonder patent, which teaches a carousel-based cable headend system for distributing menus and video content to end-user terminal devices. The Gonder patent has a strong disclosure of using metadata and images provided by the content provider to populate the video-on-demand menus, as claimed in the '026 patent. The Son reference, which teaches a server that can receive and distribute web-based uploads of video content, is added to provide a straight-forward modification to Gonder's disclosed method of receiving video content from content providers over the Internet (as the claims require). And this petition uses Kelts to teach some of the navigation behaviors recited in the claims.

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