**IN THE UNITED STATES DISTRICT COURT**
**FOR THE WESTERN DISTRICT OF TEXAS**
**WACO DIVISION**

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| BROADBAND iTV, INC.,<br><br>Plaintiff,<br><br>v.<br><br>DISH NETWORK L.L.C.,<br><br>Defendant. | §<br>§<br>§<br>§<br>§<br>§<br>§<br>§<br>§<br>§ | NO. 6:19-cv-716-ADA |

**DISH NETWORK L.L.C.'S PRELIMINARY INVALIDITY CONTENTIONS**

Pursuant to the Order Governing Proceedings – Patent Case, entered on Feb. 26, 2020 (Dkt. No. 23), Defendant DISH Network L.L.C. ("DISH") hereby serves its Preliminary Invalidity Contentions for U.S. Patent No. 10,028,026 (the "'026 Patent"), U.S. Patent No. 10,506,269 (the "'269 Patent"), U.S. Patent No. 9,998,791 (the "'791 Patent") and U.S. Patent No. 9,648,388 (the "'388 Patent") (collectively "Patents-in-Suit" or "Asserted Patents").

Plaintiff Broadband iTV, Inc. ("BBiTV") has asserted the following 65 claims of the Asserted Patents, which are collectively called the "Asserted Claims":

- '026 Patent claims 1-9, 11-16;
- '269 Patent claims 1-6, 8-12, 14-17;
- '791 Patent claims 1-3, 5-12, 14-18; and
- '388 Patent claims 1-19.

## I. INTRODUCTORY STATEMENT

DISH has not completed its investigation of the facts and documents relating to this action and has not completed its preparation for trial. DISH has not taken any depositions in this action, including, without limitation, any depositions of the named inventor of the Patents-in-Suit

and/or other persons having potentially relevant information. As discovery in this action provides DISH with additional information, it is possible that DISH will discovery additional prior art pertinent to the invalidity of the Asserted Claims of the Patents-in-Suit, and DISH reserves the right to supplement these contentions after becoming aware of additional prior art or information. In particular, DISH reserves the right to rely on any invalidity position and any prior art reference included in the invalidity contentions of any defendant in a case brought by Plaintiff alleging any of the Asserted Patents, or any patents in the same family. DISH further reserves the right to introduce and use such supplemental materials at trial.

There has been no claim construction ruling in this case. Accordingly, DISH's Invalidity Contentions reflect the presumed readings of the claims advanced by BBiTV in its Preliminary Infringement Contentions ("Infringement Contentions") (to the extent they can be understood), not what DISH contends is the proper meaning of the claims. These Invalidity Contentions are not admissions or adoptions as to any particular claim scope or construction, nor an admission that any particular element is met in any particular way in DISH's accused instrumentalities. Nothing herein should be treated as an admission that DISH agrees with BBiTV's express or implied claim constructions or that BBiTV has proposed any discernable constructions for claims and/or claim terms in its Infringement Contentions. To the extent DISH understands BBiTV's allegations of infringement, BBiTV attempts to stretch the language of the Asserted Claims beyond the scope to which the claims could reasonably be entitled in light of the disclosures in the Patents-in-Suit and their prosecution histories. Moreover, to the extent that the Asserted Patents include means-plus-function terms, those terms lack corresponding structure. DISH has not attempted to map the term to corresponding structure. However, insofar as the Court decides that they are means-plus-function terms but disagrees that they lack corresponding structure,

DISH will amend these contentions to point to the disclosure of whatever the Court identifies as corresponding structure within the reference.

In addition, DISH contends that certain Asserted Claims do not satisfy one or more requirements of 35 U.S.C. §§ 101 and/or 112. In order to fulfill its obligations pursuant to the Order Governing Proceedings – Patent Cases, however, DISH has applied the prior art based on the assumption that BBiTV contends all Asserted Claims satisfy all of the applicable requirements of 35 U.S.C. §§ 101 and 112. The application of prior art in these Invalidity Contentions should not be construed as an admission that DISH agrees that any of the Asserted Claims satisfies all the requirements of 35 U.S.C. §§ 101 and/or 112.

These Preliminary Invalidity Contentions, including the attached exhibits, are subject to modification, amendment, and/or supplementation in accordance with the Order Governing Proceedings – Patent Case, including in DISH's Final Invalidity Contentions, and/or in light of the Court's construction of the Asserted Claims, BBiTV's Final Infringement Contentions, any findings as to the priority or invention date of the Asserted Claims, additional prior art, and/or positions that BBiTV or its expert witness(es) may take concerning claim construction, infringement, and/or invalidity issues.

The Preliminary Invalidity Contentions herein are based on DISH's present knowledge, and pursuant to the Order Governing Proceedings – Patent Case, DISH reserves the right to amend these contentions if it identifies new material despite DISH's reasonable efforts to prepare these contentions. DISH's investigation regarding invalidity of the Asserted Patents over prior art and regarding other grounds of invalidity, including those based on the public use and on-sale bars under 35 U.S.C. § 102, obviousness under 35 U.S.C. § 103, failure to comply with 35 U.S.C. § 112, derivation under 35 U.S.C. § 102(f), and prior invention under 35 U.S.C. § 102(g),

is ongoing. There may be products that were known or in public use prior to the filing dates of the applications leading to the Asserted Patents, but DISH must first obtain additional information regarding these products using available discovery tools.

Moreover, prior art not included in this disclosure, whether known or unknown to DISH, may become relevant. In particular, DISH is currently unaware of the extent, if any, to which BBiTV will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by DISH, or will contend that any of the identified references does not qualify as prior art under § 102. In particular, BBiTV has not disclosed its reasoning in support of its claim that certain of the Asserted Patents are entitled to an earlier priority date, nor has BBiTV proved entitlement to an earlier invention date.

Because DISH's investigation, prior art search, and analysis are still ongoing, it is likely that DISH will identify additional prior art or contentions that will add meaning to already known prior art or contentions or possibly lead to additions or changes to these Invalidity Contentions. Without obligating itself to do so, DISH reserves all rights to amend, modify, or supplement these Invalidity Contentions. DISH further reserves the right to rely on any facts, documents, or other evidence that are: (i) subsequently discovered; (ii) subsequently determined to be relevant for any purpose; or (iii) subsequently determined to have been omitted from a production, whether inadvertently or otherwise. DISH further reserve the right to rely on expert testimony. Documents related to expert testimony, if any, will be produced when expert discovery is exchanged pursuant to the Court's Order.

The identification of any patents as prior art shall be deemed to include identification of any foreign counterpart patents. To the extent that such issues arise, DISH reserves the right to identify additional teachings in the same references or in other references that anticipate or

would have made the addition of the allegedly missing limitation to the apparatus or method obvious.

The foregoing statements and reservations of rights are hereby expressly incorporated by reference in their entirety into each of the disclosures below, into the invalidity charts served herewith, and into each disclosure corresponding to each element of every claim.

## II. PRIORITY DATES

For each of the Asserted Claims, BBiTV has failed to demonstrate any basis upon which the claims are entitled to a priority date earlier than the filing date of the continuation applications within their family history. The priority dates of the Asserted Claims are no earlier than the filing dates of the respective parent patent applications (excluding any continuations-in-part) at least because: there is insufficient disclosure in the earlier priority documents; and any claim to an earlier date of conception is not sufficiently supported by evidence and was not adequately coupled with sufficient reduction to practice and diligence.

## III. INVALIDITY OF THE ASSERTED PATENTS

### A. Invalidity Based on 35 U.S.C. § 101

Each Asserted Claim is invalid for failing to recite patentable subject matter under 35 U.S.C. § 101. With regard to the subset of the Asserted Claims that are identified in BBiTV's Complaint, DISH's contentions regarding subject matter eligibility are set forth in DISH's briefs and accompanying exhibits in support of DISH's Motion to Dismiss, which are hereby incorporated by reference. Dkt. No. 17. Regarding the Asserted Claims that BBiTV first identified in its Infringement Contentions, they are invalid under 35 U.S.C. § 101 for the same reasons set forth in said materials at least because the claims expressly disclosed in DISH's Motion to Dismiss are representative of the additional claims BBiTV asserted in its Infringement Contentions.

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