

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  
Patent 10,028,026

---

**PATENT OWNER'S RESPONSE TO  
PETITIONER'S RANKING OF MULTIPLE PETITIONS**

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TABLE OF CONTENTS**

I. INTRODUCTION .....1

II. DISH HAS NOT PROVIDED SUFFICIENT JUSTIFICATION TO  
INSTITUTE MULTIPLE PROCEEDINGS. ....1

    A. The alleged length of the claims does not warrant multiple  
    petitions. ....2

    B. No priority date issue has been raised.....3

    C. Hecht does not materially differ from Gonder, and DISH does  
    not explain why general differences between grounds justifies  
    multiple petitions.....4

III. CONCLUSION.....5

## **I. INTRODUCTION**

The November 2019 Consolidated Trial Practice Guide (“TPG”) provides the Board’s policy and a framework for analyzing concurrently filed petitions. The TPG explains that, “[b]ased on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations.” TPG, 59.

Petitioners filing concurrent petitions must justify why multiple petitions are “necessary” and then “rank[] ... the petitions in the order in which it wishes the Board to consider the merits.” TPG, 59-60. DISH fails to provide sufficient reasons why multiple petitions are necessary, and therefore, if the Board institutes *inter partes* review, it should not institute multiple proceedings against the ’026 patent.

## **II. DISH HAS NOT PROVIDED SUFFICIENT JUSTIFICATION TO INSTITUTE MULTIPLE PROCEEDINGS.**

DISH argues that multiple petitions against the ’026 patent are needed because: (1) the length of the claims “make[s] it impossible to present both grounds within the word limit” (Paper 3, 1); (2) the Gonder reference relied on in DISH’s first petition could potentially be antedated (*id.*, 3); and (3) each petition allegedly “presents a meritorious, unique obviousness ground with different system architectures and analytical frameworks” (*id.*, 4). None of DISH’s arguments are sufficient to justify instituting multiple proceedings.

**A. The alleged length of the claims does not warrant multiple petitions.**

DISH first argues that “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.” Paper 3, 1. But DISH fails to explain why it is “impossible” to present both grounds in a single petition, and DISH’s characterization of the claims as merely an “incremental improvement” on well-known systems (Pet., 1) undercuts its argument that two petitions are necessary because “of the way the claims were drafted” (Paper 3, 1).

DISH challenges only 16 claims, the text of which accounts for only about two full columns of the ’026 patent. EX1001, 22:11-24:38. Neither the number nor the length of the claims is exceptional and warrants multiple petitions. The average number of claims challenged per patent in fiscal year 2019 was 16, the same number DISH challenges. *Fitbit, Inc. v. Koninklijke Philips N.V.*, IPR2020-00772, Paper 14 at 26 n.8 (PTAB Oct. 19, 2020). And DISH’s assertion that the claims are long or complex does not justify multiple petitions. *Volkswagen Group of America, Inc. v. Michigan Motor Technologies LLC*, IPR2020-00161, Paper 8 at 10 (P.T.A.B. June 2, 2020) (“Nor does Petitioner explain sufficiently how the claims are so ‘lengthy’ and ‘compounded by convoluted claim language’ so as to warrant institution of multiple petitions in accordance with the Consolidated Trial.”).

**B. No priority date issue has been raised.**

DISH further argues that the Gonder reference could potentially be antedated, and therefore multiple petitions are needed. Paper 3, 2-4. However, Petitioner's argument does not amount to a "priority date" issue as contemplated by the TPG. According to DISH, Gonder was filed in May 2004. So even if the patent is entitled to the earliest priority claim (July 2004), Gonder would still qualify as prior art under § 102(e).

DISH insinuates that BBiTV may seek to swear behind Gonder. Paper 3, 3. But the question of whether BBiTV can swear behind Gonder is a different issue than whether the '026 patent has priority to 2004. And, regardless, any speculation that BBiTV may seek to swear behind Gonder does not justify multiple petitions. *See Comcast Cable Commn's, LLC v. Rovi Guides, Inc.*, IPR2019-01376, Paper 9 at 10 (P.T.A.B. Feb. 10, 2020) ("The possibility that Rovi might seek to antedate references is insufficient as a rationale to justify the inefficiencies and costs associated with instituting a parallel inter partes review."); *see also Apple Inc. v. Seven Networks, LLC*, IPR2020-00281, Paper 10 at 8 (P.T.A.B. Aug. 14, 2020) (denying institution of multiple proceedings in part because "no dispute about priority dates has been raised" and petitioner's concern of antedating a reference "is based on speculation and thus insufficient to make a second Petition necessary").

# 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.