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 and IPR2020-01268 (Patent 10,028,026 B2)
IPR2020-01280 and IPR2020-01281 (Patent 9,998,791 B2)
IPR2020-01332 and IPR2020-01333 (Patent 10,506,269 B2)
IPR2020-01359 and IPR2020-01360 (Patent 9,648,388 B2)

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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In Re: Apple Inc., 979 F.3d 1332 (Fed. Cir. 2020) ("*Apple*") does not affect the Board's analysis of *Fintiv* factor 2. In its Dec. 3rd Reply ("Reply"), Petitioner, DISH Network L.L.C. ("DISH"), argues that *Apple* and public policy require the Board to consider a district's average time to trial, as opposed to a scheduled trial date, when evaluating *Fintiv* factor 2. But *Apple* addressed venue transfer in Fifth Circuit district courts, not discretionary denial at the Board. *Fintiv* is binding Board authority, and factor 2 favors denying institution when, as here, the district court trial date is earlier than the Board's FWD deadline. Even so, factor 2 is not dispositive, as DISH asserts. *Fintiv* requires evaluating and weighing six factors—the framework Patent Owner, Broadband iTV, Inc. ("BBiTV"), applied in its POPRs.

I. DISH begins with a false premise: *Fintiv* factor 2 is not dispositive.

DISH did not address the *Fintiv* factors in its Petitions. It now attempts to roll the entire *Fintiv* analysis into factor 2, arguing that the Board "has effectively treated it as a dominant and determinative factor." Reply, 1. DISH cites no support for this argument, which is untrue and mischaracterizes how panels have been applying *Fintiv*. Even a cursory review of post-*Fintiv* decisions shows that the Board, as a whole, has been faithfully evaluating all six factors, taking the "holistic approach" that *Fintiv* requires. Simply put, "this one factor is not dispositive." *SK Innovation Co., Ltd., v. LG Chem, Ltd.*, IPR2020-00981, Paper 13 at 11 (PTAB Nov. 30, 2020); *see also Fitbit, Inc. v. Philips North Am. LLC*, IPR2020-00828, Paper

13 at 21 (PTAB Nov. 3, 2020) ("no single factor is determinative").

DISH is also incorrect that "the Board has [not] ever cited *Apple v. Fintiv* to deny institution where trial in a parallel litigation was set to occur after the final written decision." Reply, 1. In *Fitbit*, the Board denied Fitbit's petition despite the *Fitbit* trial "likely [occurring] after a [FWD] would issue." *Fitbit*, 8-11. Favoring denial, the challenged patent was also asserted in another suit in a different district against non-party Garmin, and the *Garmin* trial was set before the FWD. *Id*.

Here, the four challenged patents are also asserted against AT&T in WDTX, and the AT&T trial is set to occur before the FWD deadline. *See* IPR2020-01332 POPR, 16, 18, 26. So even if the DISH case is transferred, as DISH speculates, the Board should follow *Fitbit* and evaluate factor 2 based on the AT&T trial date.

Moreover, the Board has also denied IPRs despite uncertainty about the trial date, *e.g.*, *Intel Corp. v. VLSI Tech. LLC*, IPR2020-00141, Paper 16 at 9-11 (PTAB June 4, 2020) (trial in WDTX), and where "a firm trial date in [WDTX]" was not set, *Intel Corp., v. VLSI Tech. LLC*, IPR2020-00582, Paper 19 at 6-7 (PTAB Oct. 1, 2020). The *Intel* decisions further demonstrate that factor 2 is not dispositive.

II. *Apple* is inapposite; *Fintiv* is the binding Board authority.

DISH's reliance on *Apple* is misplaced. *Apple* addressed venue transfer in Fifth Circuit district courts, not discretionary denial at the Board. 979 F.3d at 1338, 1344. *Fintiv* remains binding authority, and factor 2 favors denying institution

when, as here, the district court trial date is earlier than the FWD deadline.

The DISH trial is set for November 15, 2021, two to three months before the FWD deadline in each IPR. The court stated that trial is "not going to be delayed," IPR2020-01332, EX2002, 9:3, and issued an order **after** *Apple* reconfirming the trial date, IPR2020-01332, EX2024, indicating that *Apple* has not affected the trial date. *See Apple Inc., v. Pinn, Inc.*, IPR2020-00999, Paper 15 at 9 (PTAB Dec. 8, 2020) ("court repeatedly has reminded the parties that the … trial date is firm").

III. DISH's policy arguments are irrelevant and unavailing.

DISH argues that "[c]onsidering average time to trial also is better policy" and that patentees "should not be able to use aggressive (but unlikely) trial schedules to" avoid IPR. Reply, 3. The Board has rejected policy arguments, explaining that the Director has discretion under § 314(a) and has elected to exercise that discretion as outlined in the precedential *NHK* and *Fintiv* decisions. *E.g.*, *Apple Inc., v. Maxell, Ltd.*, IPR2020-00203, Paper 12 at 17 (PTAB July 6, 2020); *see also Supercell Oy v. GREE, Inc.*, IPR2020-00513, Paper 11 at 10 (PTAB June 24, 2020) (rejecting petitioner's argument about fast-moving districts). DISH's policy argument is also unavailing because average time to trial does not account for the nuances of each case. *Fintiv* requires a "fact-driven" analysis, *Fitbit*, 21, considering the "facts and circumstances" of each case, *SK Innovation*, 17. The policy underlying *Fintiv* is not best served by deviating from this case-specific approach.

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