

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 IPR2020-01268
Patent 10,028,026

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

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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").

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

DISH finally argues that "[b]oth the Gonder Petition and Hecht Petition

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