

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)¹

Before JEFFREY S. SMITH, JUSTIN T. ARBES, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

¹ This Order addresses an issue pertaining to all eight cases. Therefore, we exercise our discretion to issue a single Order to be filed in each case. Other than as expressly authorized herein, the parties are not authorized to use this style heading for any subsequent papers.

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A conference call in the above proceedings was held on November 25, 2020, among respective counsel for Petitioner and Patent Owner, and Judges Smith, Arbes, and Galligan.² The call was requested by Petitioner to seek authorization to file a five-page reply to Patent Owner’s Preliminary Responses in these proceedings. Patent Owner argues in each Preliminary Response that we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a) based on the state of the related district court case involving the challenged patents, *Broadband iTV, Inc. v. DISH Network, L.L.C.*, Case No. 19-cv-00716 (W.D. Tex.). *E.g.*, IPR2020-01267, Paper 9 at 8–30 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). Petitioner argued during the call that a recent decision (issued after the filing of the Petitions in the instant proceedings), *In re Apple Inc.*, No. 2020-135, – F.3d –, 2020 WL 6554063 (Fed. Cir. Nov. 9, 2020), is relevant to the second *Fintiv* factor—proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision. According to Petitioner, the decision shows that trial is not likely to occur on the date currently set by the district court (November 15, 2021) and also increases the likelihood that Petitioner’s motion to transfer in the related district court case will be granted (in which case a new trial date would be set).

Patent Owner opposed Petitioner’s request, arguing that the *Apple* decision is irrelevant to the second *Fintiv* factor because it dealt only with a petition for a writ of mandamus regarding a motion to transfer and the

² A court reporter, retained by Patent Owner, was present on the call. Patent Owner shall file a transcript of the call as an exhibit in each proceeding.

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district court recently confirmed the November 15, 2021, trial date in the related district court case. Patent Owner also argued that Petitioner's position that its motion to transfer is more likely to be granted based on the *Apple* decision is mere speculation and also incorrect, given that the facts pertaining to that motion are different from those in *Apple*.

As stated during the call, we determine that there is good cause for a limited reply based on Petitioner's assertions regarding the potential relevance of the *Apple* decision to our analysis of the second *Fintiv* factor. *See* 37 C.F.R. § 42.108(c). To ensure that both parties are heard on the issue, we also authorize Patent Owner to file a sur-reply responding to Petitioner's arguments. The parties may not present arguments regarding any other *Fintiv* factor or any other issue in their papers.

Finally, Patent Owner requested authorization to file a copy of the district court's claim constructions in all proceedings in which they have not been filed already. Petitioner did not oppose the request, and Patent Owner did so after the call pursuant to our authorization.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a Reply in the instant proceedings, limited to three pages and addressing only the issue described above, by December 3, 2020;

FURTHER ORDERED that Patent Owner is authorized to file a Sur-Reply, limited to three pages and responding to Petitioner's Reply, by December 10, 2020; and

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FURTHER ORDERED that the parties shall file a single Reply and Sur-Reply in all eight proceedings using a caption referring to all of the proceedings.

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