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 (U.S. Patent No. 10,028,026 B2)
IPR2020-01280 and IPR2020-01281 (U.S. Patent No. 9,998,791 B2)
IPR2020-01332 and IPR2020-01333 (U.S. Patent No. 10,506,269 B2)
IPR2020-01359 and IPR2020-01360 (U.S. Patent No. 9,648,388 B2)

DISH NETWORK'S PRELIMINARY RESPONSE REPLY

Pursuant to the authorization provided by the Board, Petitioner DISH Network L.L.C. ("DISH") respectfully submits this reply to Patent Owner Broadband iTV Inc's ("BBiTV's") preliminary responses in the above proceedings.

BBiTV argues that the Board should apply *Apple v. Fintiv* and deny institution in view of a November 2021 scheduled trial date in a co-pending district court case between BBiTV and DISH. (*See, e.g.*, IPR2020-01280, Paper 9, pp. 10, 17-22.) Under *Apple v. Fintiv*, the Board considers the "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision" when assessing whether institution is appropriate. IPR2020-00019, Paper 10, p. 6 (P.T.A.B. Mar. 20, 2020) (precedential). While a scheduled trial date is listed among other factors, the Board has effectively treated it as a dominant and determinative factor. Indeed, it does not appear that the Board has ever cited *Apple v. Fintiv* to deny institution where trial in a parallel litigation was set to occur after the final written decision.

When applying *Apple v. Fintiv*, the Board "generally take[s] courts' trial schedules at face value absent some strong evidence to the contrary." *See Apple v. Fintiv*, IPR2020-00019, Paper 15 at 13 (P.T.A.B. May 13, 2020) (informative). That practice cannot withstand the Federal Circuit's recent holding in *In re Apple Inc.*, No. 2020-135, – F.3d –, 2020 WL 6554063 (Fed. Cir. Nov. 9, 2020). There, the Federal Circuit explained that, at least in the case of the specific judge before whom the parallel litigation is pending here (Judge Albright in the WDTX), taking a

scheduled trial date at "face value" constitutes error. *See id.* at *8.

More particularly, *In re Apple Inc.* reviewed a decision by Judge Albright denying a motion to transfer venue. *See id.*, *1. The judge's decision was premised, in part, on the fact that he "[had] already set the trial date" leading to a "prospective time for filing to trial" of 18.4 months, which was faster than the average time to trial in the jurisdiction to which transfer was sought. *Id.*, *8. The Federal Circuit rejected this reasoning, explaining that Judge Albright's "fast-paced schedule is not particularly relevant" when assessing the relative speed differences between two jurisdictions because "the forum itself has not historically resolved cases so quickly." *Id.* The Federal Circuit then went on to emphasize that scheduled trial dates—especially those where the "anticipated time to trial is significantly shorter than the district's historical time to trial," like Judge Albright's—can only be considered "speculat[ive]." *Id.* Thus, the respective jurisdictions' average trial times—and not the aggressive trial dates set by Judge Albright—are the relevant metrics for determining which jurisdiction will reach resolution first. *See id.*

The same principle applies here. Like the decision at issue in *In re Apple*, the Board's institution decision here requires (as one element of the analysis) a comparison of the projected times to decision in the parallel district-court litigation and in the PTAB. If Judge Albright (the party who is most knowledgeable about whether trial can actually occur in the parallel litigation when scheduled) cannot take

his own scheduled trial date as a given without engaging in speculation and committing error, than the Board (who has no special knowledge about the judge's ability to timely reach trial) cannot either. It follows that the only relevant date for the Board to consider is the WDTX's ***average*** time to trial. This, according to the Federal Circuit, exceeds 2 years. *See In re Apple*, 2020 WL 6554063, *8. In other words, it would be erroneous and speculative for the Board to assume that trial in the parallel litigation will occur as scheduled in November 2021. Instead, a date in 2022 is more likely. The Board's final decisions are due no later than February 2022.

Considering average time to trial also is better policy. Patent holders should not be able to use aggressive (but unlikely) trial schedules to shut the doors to the PTAB. Moreover, DISH submits that the *In re Apple* decision increases the chances that trial will not occur before Judge Albright at all. DISH has filed a motion to transfer. If transferred (either by the trial court or by the Federal Circuit after mandamus), trial will need to be rescheduled. And, Judge Albright indicated at a November 13, 2020 claim construction hearing that he was waiting for the Federal Circuit's *In re Apple* decision before ruling on DISH's motion, to ensure he does not issue an "inconsistent" ruling. While a full accounting of all the facts underlying DISH's transfer motion is beyond the scope of this paper, at the very least, the judge's expressed desire to issue a "[c]onsistent" decision casts further doubt on the November 2021 trial date and renders that date even less relevant.

Respectfully submitted,

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