

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES, INC. and DIRECTV, LLC,
Petitioner,

v.

BROADBAND iTV, INC.,
Patent Owner.

IPR2021-00603
Patent 9,998,791 B2

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

ARBES, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

Granting Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. *Background and Summary*

AT&T Services, Inc. and DIRECTV, LLC (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–3, 5–12, and 14–18 of U.S. Patent No. 9,998,791 B2 (Ex. 1001, “the

'791 patent") pursuant to 35 U.S.C. § 311(a). Concurrently, Petitioner filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), seeking to be joined as a party to *DISH Network L.L.C. v. Broadband iTV, Inc.*, Case IPR2020-01280 ("the DISH IPR"), which also involves claims 1–3, 5–12, and 14–18 of the '791 patent. Paper 3 ("Mot."). Patent Owner Broadband iTV, Inc. filed an Opposition to Petitioner's Motion for Joinder. Paper 8 ("Opposition" or "Opp.").¹ Petitioner filed a Reply to Patent Owner's Opposition to Petitioner's Motion for Joinder. Paper 10 ("Reply"). Patent Owner filed a Preliminary Response to the Petition. Paper 11 ("Prelim. Resp.").

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the DISH IPR and grant Petitioner's Motion for Joinder.

¹ Patent Owner's Opposition was untimely. *See* 37 C.F.R. § 42.25(a)(1) ("An opposition is due one month after service of the motion."). "A late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice." 37 C.F.R. § 42.5(c)(3). Patent Owner argues that consideration of the Opposition would be in the interests of justice because (1) Patent Owner should be afforded an opportunity to be heard on the merits of Petitioner's joinder arguments, (2) Petitioner was not prejudiced by the delay in filing, and (3) Patent Owner's arguments are "the same as those" presented in Patent Owner's opposition in related Case IPR2021-00556, so Petitioner was "already on notice of [Patent Owner's] positions." *Opp.* 1–3. We agree, and excuse the late filing in the interests of justice.

B. Related Matters

The parties indicate that the '791 patent is the subject of *Broadband iTV, Inc. v. DISH Network L.L.C.*, Case No. 6:19-cv-716 (W.D. Tex.)² (“the DISH case”), as well as *Broadband iTV, Inc. v. AT&T Services, Inc.*, Case No. 6:19-cv-712 (W.D. Tex.), and *Broadband iTV, Inc. v. DirecTV, LLC*, Case No. 6:19-cv-714 (W.D. Tex.), which were consolidated into *Broadband iTV, Inc. v. AT&T Services, Inc.*, Case No. 1:20-cv-717 (W.D. Tex.) (“the AT&T case”). *See* Pet. 5–6; Paper 6, 1.

DISH Network L.L.C. (“DISH”) previously filed a petition challenging claims 1–3, 5–12, and 14–18 of the '791 patent in the DISH IPR. DISH also filed a second petition challenging claims of the '791 patent in Case IPR2020-01281, which was denied. DISH filed petitions challenging claims of related patents asserted in the district court cases in Cases IPR2020-01267 (granted), IPR2020-01268 (denied), IPR2020-01332 (granted), IPR2020-01333 (denied), IPR2020-01359 (granted), and IPR2020-01360 (denied).

Petitioner filed petitions challenging claims of related patents asserted in the district court cases in Cases IPR2021-00556 and IPR2021-00649.

Two different petitioners previously filed petitions challenging claims of a patent related to the '791 patent, U.S. Patent No. 7,631,336 B2, in Cases IPR2014-01222 and CBM2014-00189, both of which were denied. *See* Pet. 6–7; Paper 6, 2.

² We refer to the United States District Court for the Western District of Texas as “the Texas court.”

C. Illustrative Claim

Challenged claim 1 of the '791 patent is independent. Claims 2, 3, 5–12, and 14–18 depend directly from claim 1. Claim 1 recites:

1. A method for video-on-demand content delivery for providing video-on-demand services to a plurality of television service subscribers via a television service provider system that comprises a video-on-demand content delivery system having one or more computers, the method comprising:

(a) receiving, at the one or more computers of the video-on-demand content delivery system of the television service provider system from a Web-based content management system,

at least the following digital content:

(i) a first video content, along with

(ii) first metadata, associated with the first video content and usable in a video-on-demand content menu, the first metadata comprising:

(1) first title information comprising a first title,

(2) first content provider designated hierarchically arranged category information and subcategory information to specify a location of the first title information for the video content in a predetermined video-on-demand application, the first content provider designated category information and subcategory information associated with the first title information of the first video content using a same hierarchical structure of categories and subcategories as is to be used for placement of the first title information in the predetermined video-on-demand application; and

(3) first time information for availability of the first video content for scheduling of viewing of the first video content through the predetermined video-on-demand application;

wherein the first video content was uploaded to the Web-based content management system by a content provider device associated with a first video content provider via the Internet in a digital video format, along with the associated first metadata including first title information, and first content provider designated hierarchically arranged category information and subcategory information designated by the first video content provider, to specify a hierarchical location of the first title of the first video content within the video-on-demand content menu using the first category information and first subcategory information associated with the first title information;

(b) storing, at a video server comprising one or more computers and computer-readable memory operatively connected to the one or more computers of the video server, respective video content, including the first video content, wherein the video server is associated with the video-on-demand content delivery system and is configured to supply the respective video content, upon request, for transmission to a set top box operatively connected to TV equipment of a television service subscriber;

(c) providing a respective set top box operatively connected to respective TV equipment of a respective television service subscriber with access to the video-on-demand content menu for navigating through titles, including the first title of the first video content, by hierarchically-arranged category information and subcategory information including at least the first category information and the first subcategory information in order to locate a respective one of the titles whose associated video content is desired for viewing on the respective TV equipment,

wherein the video-on-demand content menu lists the titles using the same hierarchical structure of category information and subcategory information as was designated by one or more video content providers, including the first video content provider, in the uploaded metadata for the respective video content, wherein a plurality of different video display templates, including a first video display template, are accessible to the set top box, and wherein the predetermined video-on-demand application

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