

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

BROADBAND iTV, INC.,  
Patent Owner.

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IPR2021-00649  
Patent 9,648,388 B2

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

SMITH, *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 2, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 9,648,388 B2 (Ex. 1001, “the ’388 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 IPR2020-01359 (“the DISH IPR”), which also involves claims 1–19 of the ’388 patent. Paper 3 (“Mot.”). Patent Owner Broadband iTV, Inc. filed an Opposition to Petitioner’s Motion for Joinder. Paper 7 (“Opposition” or “Opp.”).<sup>1</sup> Petitioner filed a Reply to Patent Owner’s Opposition to Petitioner’s Motion for Joinder. Paper 9 (“Reply”). Patent Owner filed a Preliminary Response to the Petition. Paper 10 (“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.

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<sup>1</sup> 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 '388 patent is the subject of *Broadband iTV, Inc. v. DISH Network L.L.C.*, Case No. 6:19-cv-716 (W.D. Tex.)<sup>2</sup> (“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 5, 1.

DISH Network L.L.C. (“DISH”) previously filed a petition challenging claims 1–19 of the '388 patent in the DISH IPR. DISH also filed a second petition challenging claims 1, 2, 5, and 7–19 in Case IPR2020-01360, 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), IPR2020-01280 (granted), IPR2020-01281 (denied), IPR2020-01332 (granted), and IPR2020-01333 (denied).

Petitioner filed petitions challenging claims of related patents asserted in the district court cases in Cases IPR2021-00556 and IPR2021-00603.

Two different petitioners previously filed petitions challenging claims of a related patent to the '388 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 5, 2.

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<sup>2</sup> 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 '388 patent is independent. Claims 2–19 depend, directly or indirectly, from claim 1. Claim 1 recites:

1. A set-top box, providing video-on-demand services and operatively connected to TV equipment of a TV service subscriber, programmed to perform the steps of:

(a) receiving, at the set-top box, via a closed system from a video-on-demand content delivery system comprising one or more computers and computer-readable memory operatively connected to the one or more computers, respective video-on-demand application-readable metadata that is associated with respective video content and is usable to generate a video-on-demand content menu;

wherein the respective video content was uploaded to a Web-based content management system by a respective content provider device associated with a respective video content provider via the Internet in a digital video format along with respective specified metadata including respective title information, category information, and subcategory information designated by the respective video content provider to specify a respective hierarchical location of a respective title of the respective video content within the video-on-demand content menu displayed on the TV equipment, wherein the respective video-on-demand application-readable metadata is generated according to the respective specified metadata;

(b) providing, to the TV subscriber at the set-top box, the video-on-demand content menu for navigating through titles, including the respective titles of the respective video content, in a drill-down manner by category information and subcategory information in order to locate a particular one of the titles whose associated video content is desired for viewing on the TV equipment, wherein the video-on-demand content menu lists the titles using the same hierarchical structure of respective category information and subcategory information as was designated by the respective video content provider in the respective specified metadata for the respective video content, wherein a plurality of different video display templates are accessible to the set-top

box, and wherein the video-on-demand content menu is generated using at least one of the plurality of different video display templates and based at least upon the respective specified metadata; and

(c) in response to the TV service subscriber selecting, via a control unit in communication with the set-top box, a first respective title associated with a first video content from the hierarchical structure of respective category information and subcategory information of the video-on-demand content menu using drill-down navigation, transmitting the selection to the set-top box for display on the TV equipment; and

(d) receiving, at the set-top box, the first video content for display on the TV equipment of the TV service subscriber, wherein in response to the selection the first video content was retrieved from a video server associated with the video-on-demand content delivery system.

#### *D. Evidence*

Petitioner relies on the following prior art:

U.S. Patent No. 7,159,233 B2, filed Jan. 29, 2001, issued Jan. 2, 2007 (Ex. 1005, “Son”);

U.S. Patent Application Publication No. 2010/0153997 A1, published June 17, 2010, filed Nov. 23, 2009, continuation of application filed Jan. 21, 2004 (Ex. 1004, “Baumgartner”);

U.S. Patent Application Publication No. 2005/0160458 A1, published July 21, 2005, filed Jan. 21, 2004 (Ex. 1025, “Baumgartner II”);

Robert G. Scheffler, *Ingest & Metadata Partitioning: Requirements for Television on Demand* (Ex. 1006, “Scheffler”);<sup>3</sup> and

CableLabs Video-on-Demand Content Specification Version 1.1, MD-SP-VOD-CONTENT1.1-01-020927 (2002)

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<sup>3</sup> When citing non-patent references filed by Petitioner, such as Scheffler and CableLabs, we refer to the page numbers in the bottom-right corner added by Petitioner. *See* 37 C.F.R. § 42.63(d)(2).

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