

**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,  
Petitioners,

v.

BROADBAND iTV, INC.,  
Patent Owner.

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Case No. IPR2021-00556  
Patent No. 10,028,026

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**REPLY IN SUPPORT OF MOTION FOR JOINDER TO *INTER PARTES*  
REVIEW IPR2020-01267**

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BI's arguments are not supported by the record or the Board's precedent, and the Board should grant AT&T's motion to join the DISH IPR.

## **I. THE BOARD DENIED PATENT OWNER'S REQUEST FOR REHEARING IN THE DISH IPR**

As an initial matter, Patent Owner's argument that the Board should deny AT&T's request for joinder because the DISH IPR should be terminated is moot. On April 1, 2021, the Board denied Patent Owner's request for rehearing of the Board's decision to institute the DISH IPR and refusal to exercise discretionary denial under 35 U.S.C. § 314(a). *See* IPR2020-01267, Paper 25. Patent Owner's argument is moot.

## **II. DENIAL OF JOINDER IS INAPPROPRIATE HERE**

Citing only *Proppant Express* for support, Patent Owner argues that AT&T's motion for joinder should be denied "in view of AT&T's gamesmanship," as "AT&T is now time-barred from filing a petition sans joining IPR2020-01267." Paper 9 at 2-3. According to Patent Owner, AT&T's late request to join the DISH IPR, instead of filing its own IPR petition, "[is] precisely the kind of 'attempt[] to game the system' cautioned against in *Proppant*." *Id.* at 3. BI's reliance on *Proppant Express* is misplaced.

The issue in *Proppant Express* was whether the Board should exercise its discretion to grant same-party joinder and new-issue joinder. *See Proppant Express Investments, LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38 (PTAB

Mar. 13, 2019) at 19-21 (denying same party and issue joinder “[b]ecause Petitioner’s own conduct created the need for it to request joinder” to fix petitioner’s errors in an existing IPR proceeding). “The factors and considerations for joinder that does not involve same party and new issues are different that [sic] those set forth in *Proppant Express*.” *Kingston Tech. Co., Inc. v. Securewave Storage Solutions, Inc.*, IPR202-00139, Paper 12 at 14 (PTAB Mar. 23, 2020). As explained in the AIA legislative history: “The Office anticipates that *joinder will be allowed as of right*—if an inter partes review is instituted on the basis of a petition, . . . a party that files *an identical petition will be joined to that proceeding*.” *Id.* at 14 (internal quotations and citations omitted).

Here, unlike *Proppant Express*, AT&T is not seeking same-party joinder or joinder of new issues. To the contrary, AT&T merely seeks to join DISH’s IPR, and AT&T’s Petition is a “me-too” petition that includes identical arguments and the same grounds of invalidity already at issue in the DISH IPR. Furthermore, AT&T will act only as an understudy and will not assume an active role in the joined proceeding unless and until DISH ceases to participate. The Board routinely grants joinder in circumstances such as these. *See, e.g., id.* at 14 (granting joinder where the petition was a “me-too” petition that didn’t add any new issues); *BlackBerry Corp. v. Uniloc 2017 LLC*, IPR2019-01282, Paper 11 at 6-8 (PTAB Nov. 5, 2019) (granting joinder where the petition was substantively

identical to the instituted petition and the petitioner agreed to an understudy role); *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 5-9 (PTAB Aug. 24, 2016) (same); *Oracle America, Inc. v. Realtime Data LLC*, IPR2016-01671, Paper 15 at 4-8 (PTAB Mar. 8, 2017) (granting joinder where the petitioner asserted the same grounds of unpatentability as the instituted IPR, despite the petitioner having filed an earlier petition based on different grounds).

Moreover, AT&T timely filed its Motion for Joinder within one month of the Board's decision instituting trial in the DISH IPR, and AT&T's Petition is not time-barred under § 315(b). 37 C.F.R. § 42.122(b); *see also* 35 U.S.C. § 315(b) (indicating that the one-year time limitation "shall not apply to a request for joinder under subsection (c)"). As such, Patent Owner's reliance on *Proppant Express* is improper and its arguments are unavailing.

### **III. THE BOARD DID NOT RELY ON AT&T'S ABSENCE FROM THE DISH IPR IN ITS INSTITUTION DECISION**

Contrary to Patent Owner's suggestion, no portion of the Board's institution decision in the DISH IPR relied on AT&T's participation or lack thereof in evaluating whether to exercise its discretion under *Fintiv*.<sup>1</sup> *See* IPR2020-01267,

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<sup>1</sup> In Patent Owner's request for rehearing, Patent Owner argued that the Board should have considered the AT&T district court proceeding when analyzing *Fintiv* factors 2 and 4. *See* Paper 15 at 3.

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