

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION**

BROADBAND iTV, INC.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	Case No. 1:20-cv-717-ADA
	§	
AT&T SERVICES, INC., and AT&T COMMUNICATIONS, LLC,	§	
	§	
Defendants.	§	
<hr style="border: 0.5px solid black;"/>		
BROADBAND iTV, INC.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	
DIRECTV, LLC,	§	
	§	
Defendant.	§	
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**FINAL INVALIDITY CONTENTIONS OF
AT&T SERVICES, INC., AT&T COMMUNICATIONS, LLC, AND DIRECTV, LLC**

Pursuant to the Court’s Amended Scheduling Order (Dkt. No. 84), Defendants AT&T Services, Inc., AT&T Communications, LLC, and DIRECTV, LLC (collectively “Defendants” or “AT&T”) provide the following Final Invalidity Contentions and accompanying document production with respect to claims collectively identified by Plaintiff Broadband iTV, Inc. (“BBiTV” or “Plaintiff”) in its Preliminary Infringement Contentions served on each Defendant (“Preliminary Infringement Contentions”). AT&T reserves the right to amend these contentions in accordance with the existing rules of this Court, any orders of record in this matter, including Footnote 4 to the Order Governing Proceedings (Dkt. No. 28), and the Federal Rules of Civil



Procedure.

The Asserted Claims, as reflected in Plaintiff’s Preliminary Infringement Contentions, are summarized in the following chart:

	AT&T TV, AT&T TV Now, AT&T Watch TV	U-Verse	DirecTV
'791 Patent	1-18	1-18	1-3, 5-6, 8-12, 14-18
'388 Patent	1-19	1-19	1-13, 15-19
'026 Patent	1-9, 11-13, 15-16	1-16	1-9, 11-13
'101 Patent	-	1-8, 10, 12-17	-
'269 Patent	-	-	1-6, 8-12, 14-15, 17

I. Statement Concerning Amendment of Invalidity Contentions.

Pursuant to the Court’s Order Governing Proceedings (Dkt. No. 28), Defendants certify that Defendants undertook reasonable efforts to prepare their Preliminary Invalidity Contentions. The amendment of Defendants’ Invalidity Contentions is based on material identified and/or disclosed after the Preliminary Invalidity Contentions were served. U.S. Patent No. 5,752,160 (“Dunn”) was first brought to Defendants’ attention through BI’s recent production of DISH’s Preliminary Invalidity Contentions. U.S. Patent No. 7,159,233 (“Son”) was first brought to Defendants’ attention through DISH’s petitions for *inter partes* review of the asserted patents. U.S. Patent Publication No. 2004/0136698 (“Mock”) was first brought to Defendants’ attention through BI’s recent production of DISH’s Preliminary Invalidity Contentions. Defendants understand U.S. Patent Publication No. 2007/0157252 (“Perez”) to be prior art to the ’388 and ’791 Patents under 35 U.S.C. § 102(b) based on BI’s responses to Defendants’ Interrogatory Nos. 1-3. See BI’s Responses to AT&T’s First Set of Interrogatories (Nos. 1-21), dated January 4, 2021.

II. INVALIDITY CONTENTIONS.

Pursuant to the Court's Order Governing Proceedings (Dkt. No. 28) and the Amended Scheduling Order (Dkt. No. 84), Defendants hereby serve their final invalidity contentions in the form of (1) a chart setting forth where in the prior art references each element of the asserted claim(s) are found, (2) an identification of any limitations the Defendant contends are indefinite or lack written description under section 112, and (3) an identification of any claims the Defendant contends are directed to ineligible subject matter under section 101.

A. A Chart Setting Forth Where in the Prior Art References Each Element of the Asserted Claims are Found.

1. Overview.

Exhibits A-1 to A-19 and C-1 to C-18 to these Invalidity Contentions contain claim charts for the primary prior art references selected by Defendants. With respect to Exhibits C-1 to C-18, it is not clear from the Court's Claim Construction Order (Dkt. No. 74) whether the "was uploaded" step of independent claim 1 of each of the '388, '026, and '269 patents is a limitation of the claim. Furthermore, BI has refused to answer Defendants' Requests for Admission (Nos. 1-10) concerning the "was uploaded" step. As such, Defendants provide Exhibits C-1 to C-18 in the event the "was uploaded" step is not a limitation of claim 1. Exhibits B-1 to B-14 to these Invalidity Contentions contain claim charts showing how certain of the claimed concepts were taught by a number of prior art references and thus render the claims obvious over other prior art as recited herein.

Defendants' reliance on each prior art reference identified throughout these Invalidity Contentions (whether primary references or obviousness references) includes the reference itself, anything incorporated by the reference or described as relevant technology by the reference, any system embodying the reference, and any testimony by those with knowledge of the reference,

such as named authors and inventors. Moreover, AT&T reserves the right to seek through discovery the testimony of one or more engineers with knowledge of the development of any prior art system identified herein or subsequently discovered. On information and belief, the evidence cited in one or more exhibits as identified herein comprises evidence of a prior art system or solution and is therefore anticipatory under § 35 U.S.C. 102 even though that system may be described in multiple different documents. See *Unitherm Food Sys. v. Swift-Eckrich, Inc.*, 375 F.3d 1341, 1352-54 (Fed. Cir. 2004) (relying on “contemporaneous correspondence, color photographs, witness testimony, and promotional videos” to establish characteristics of anticipating Unitherm process), rev’d on other grounds, 546 U.S. 394, 126 S. Ct. 980, 163 L. Ed. 2d 974 (2006); *Sonoscan, Inc. v. Sonotek, Inc.*, 936 F.2d 1261, 1263 (Fed. Cir. 1991) (“That the offered product is in fact the claimed invention may be established by any relevant evidence, such as memoranda, drawings, correspondence, and testimony of witnesses.”). Moreover, while some prior art may be charted separately, Defendants reserve the right to show that combinations of individual charts describe a portion of single prior art system or solution.

Defendants reserve the right to revise, amend, and/or supplement the information provided herein, including by identifying and relying on additional references, based on developments in the case including, without limitation, based on changes in the priority date of any Asserted Claim, newly discovered prior art, depositions and document productions of prior art witnesses, claim construction determinations, challenges by Plaintiff to the authenticity or content of the prior art and positions taken by Plaintiff during the litigation. For instance, Defendants are seeking discovery from several of the individuals and companies associated with the references below and reserve the right to rely on such discovery and/or supplement these contentions to the extent that discovery reveals additional facts and/or prior art bases.

2. Anticipation.

The following printed prior art references in Table 1, taken either alone or in combination with each other, the knowledge of a person of ordinary skill in the art, and/or the references identified in Defendants' Exhibits B-1 to B-14, anticipate and/or render obvious the Asserted Claims of the Asserted Patents as identified below, along with an identification of the Asserted Patents to which the reference is applied in each chart. An explanation for how and under what statutory basis each reference qualifies as prior art can be found within each of the charts identified below.

Table 1: Printed Prior Art References

Chart	Reference	Asserted Patents
A-1	Hendricks I	'791, '388, '026, '101, '269
A-2	Hendricks II	'791, '388, '026, '101, '269
A-3	Baumgartner I	'791, '388, '026, '101, '269
A-4	Baumgartner II	'791, '388, '026, '101, '269
A-5	Grimes	'791, '388
A-6	Finseth	'791, '388, '026, '101, '269
A-7	Gagnon	'026, '101, '269
A-8	Gaydou	'791, '388, '026, '101, '269
A-9	Ellis I	'791, '388, '026, '101, '269
A-10	Ellis III	'791, '388
A-11	Haberman	'791, '388, '026, '101, '269
A-12	Bachet	'026, '101, '269
A-13	Ellis II	'026, '101, '269
A-14	Shannon	'026, '101, '269

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