

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

BROADBAND ITV, INC.,
Patent Owner

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

PATENT OWNER'S PRELIMINARY RESPONSE

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II. THE BOARD SHOULD DENY THE PETITION UNDER *FINTIV*. 4

 A. Factor 1 strongly favors denial because neither parallel district court case has been stayed and all the evidence indicates that Judge Albright would not grant a stay..... 9

 B. Factor 2 strongly favors denial because the trials will begin long before the FWD deadline, and Judge Albright has repeatedly confirmed, “We’re going to go to trial.”12

 C. Factor 3 strongly favors denial because, by the projected institution deadline, the parties and the district court will have made significant investment in the parallel cases.18

 D. Factor 4 strongly favors denial because there is significant overlap between AT&T’s copycat Petition and the issues that will be tried in the parallel district court cases.....22

 E. Factor 5 strongly favors denial because the parties involved in this IPR are the same as in the parallel district court cases.26

 F. Factor 6 strongly favors denial because the merits are weak and other discretionary factors favor denial.27

 1. The merits favor denial.28

 2. *Apple v. Uniloc 2017* also favors denial.29

III. CONCLUSION31

PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	<i>Intentionally Left Blank</i>
2002	Complaint for Patent Infringement, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), December 19, 2019.
2003	Transcript of Telephonic Discovery Hearing Before the Honorable Alan D. Albright, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), August 31, 2020.
2004	“The last thing anyone should think about WDTX is that it is patent plaintiff friendly, says Albright,” (IAM, Apr. 7, 2020), https://www.iam-media.com/law-policy/albright-the-last-thing-anyone-should-think-about-venue-it-plaintiff-friendly (accessed Sept. 14, 2020).
2005	Order Denying Motion to Stay Case, <i>Continental Intermodal Group-Trucking, LLC v. Sand Revolution, LLC</i> , Case No. 7:18-cv-00147 (W.D. Tex.), July 22, 2020.
2006	Order Denying Motion to Stay Case, <i>Kerr Machine Co. v. Vulcan Indus. Holdings, LLC</i> , Case No. 6:20-cv-00200 (W.D. Tex.), August 18, 2020.
2007	Divisional Standing Order Regarding Trials in Waco, U.S. District Court for the Western District of Texas, August 18, 2020.
2008	Divisional Standing Order Regarding Trials in Waco, U.S. District Court for the Western District of Texas, September 23, 2020.
2009	Divisional Standing Order Regarding Trials in Waco, U.S. District Court for the Western District of Texas, March 24, 2020.
2010	Order Granting Motion to Consolidate Cases, <i>Broadband iTV, Inc. v. AT&T Services, Inc.</i> , Case No. 6:19-cv-00712 (W.D. Tex.), April 15, 2020.
2011	Minute Entry for Proceedings held before Judge Alan D. Albright, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716 (W.D. Tex.), August 31, 2020.
2012	“Roku Tells WDTX Patent Jury Its Tech's Web Access Is Key” Law360, October 5, 2020, https://www.law360.com/articles/1302893/print?section=ip (accessed October 20, 2020).

Exhibit No.	Description
2013	Order Denying Motion to Dismiss, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), July 25, 2020.
2014	Dish Network LLC's Preliminary Invalidity Contentions, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), June 25, 2020.
2015	Defendants' Opening Claim Construction Brief, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-716, U.S. District Court for the Western District of Texas, dated September 10, 2020.
2016	<i>Intentionally Left Blank</i>
2017	<i>Intentionally Left Blank</i>
2018	"Roku Beats \$41M Infringement Claim In Texas Trial" Law360, October 14, 2020, https://www.law360.com/articles/1319005/print?section=ip (accessed October 21, 2020).
2019	"3 Things To Know After Busy WDTX Patent Judge's 1st Trial" Law360, October 16, 2020, https://www.law360.com/articles/1320360/print?section=ip (accessed October 21, 2020).
2020	Transcript of Telephonic Discovery Hearing Before the Honorable Alan D. Albright, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), March 26, 2020.
2021-2025	<i>Intentionally Left Blank</i>
2026	BBitV Court's Claim Constructions Final At Hearing 11/13/20, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716, U.S. District Court for the Western District of Texas, dated November 13, 2020.
2027-2029	<i>Intentionally Left Blank</i>
2030	Teleconference Transcript, November 25, 2020.
2031	DISH Final Invalidity Contentions and Example Claim Charts
2032	AT&T Final Invalidity Contentions and Example Claim Charts
2033	<i>Intentionally Left Blank</i>
2034	<i>Intentionally Left Blank</i>
2035	E-mail regarding motion for joinder of new <i>inter partes</i> review petition with IPR2020-01267, February 18, 2021.

Exhibit No.	Description
2036-2040	<i>Intentionally Left Blank</i>
2041	PACER Docket Report, <i>Broadband iTV, Inc. v. AT&T Services, Inc.</i> , Case No. 1:20-cv-00717-ADA (W.D. Tex.), retrieved June 14, 2021.
2042	PACER Docket Report, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), retrieved June 14, 2021.
2043	Court's Memorandum Opinion and Order, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), Apr. 20, 2021.
2044	Court's Claim Construction Order, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-00716-ADA (W.D. Tex.), Nov. 20, 2020.
2045	Joint Motion to Amend Certain Scheduling Order Deadlines, <i>Broadband iTV, Inc. v. AT&T Services, Inc.</i> , Case No. 1:20-cv-717-AD (W.D. Tex.), June 8, 2021.
2046	Thirteenth Supplemental Order Regarding Court Operations Under the Exigent Circumstances Created by the COVID-19 Pandemic (W.D. Tex.) (Feb. 2, 2021).
2047	Fourteenth Supplemental Order Regarding Court Operations Under the Exigent Circumstances Created by the COVID-19 Pandemic (W.D. Tex.) (Mar. 17, 2021).
2048	Order Denying Motion to Stay Case, <i>Kerr Machine Co. v. Vulcan Indus. Holdings, LLC</i> , Case No. 6:20-cv-00200 (W.D. Tex.), April 7, 2021.
2049	Joint Motion to Amend Certain Scheduling Order Deadlines, <i>Broadband iTV, Inc. v. DISH Network, LLC</i> , Case No. 6:19-cv-716-ADA (W.D. Tex.), June 11, 2021.

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