

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.

IPR2021-00556
Patent 10,028,026 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 1–16 of U.S. Patent No. 10,028,026 B2 (Ex. 1001, “the ’026 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 IPR2020-01267 (“the DISH IPR”), which also involves claims 1–16 of the ’026 patent. Paper 3 (“Mot.”). Patent Owner Broadband iTV, Inc. filed an Opposition to Petitioner’s Motion for Joinder. Paper 9 (“Opposition” or “Opp.”). 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 12 (“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.

B. Related Matters

The parties indicate that the ’026 patent is the subject of *Broadband iTV, Inc. v. DISH Network L.L.C.*, Case No. 6:19-cv-716 (W.D. Tex.)¹ (“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

¹ We refer to the United States District Court for the Western District of Texas as “the Texas court.”

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Broadband iTV, Inc. v. AT&T Services, Inc., Case No. 1:20-cv-717
(W.D. Tex.) (“the AT&T case”). *See* Pet. 4–5; Paper 5, 1.

DISH Network L.L.C. (“DISH”) previously filed a petition challenging claims 1–16 of the ’026 patent in the DISH IPR. DISH also filed a second petition challenging the same claims in Case IPR2020-01268, which was denied. DISH filed petitions challenging claims of related patents asserted in the district court cases in Cases IPR2020-01280 (granted), IPR2020-01281 (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 IPR2021-00603 and IPR2021-00649.

Two different petitioners previously filed petitions challenging claims of a parent patent to the ’026 patent, U.S. Patent No. 7,631,336 B2, in Cases IPR2014-01222 and CBM2014-00189, both of which were denied. *See* Pet. 6; Paper 5, 2.

C. Illustrative Claim

Challenged claim 1 of the ’026 patent is independent. Claims 2–16 depend, directly or indirectly, from claim 1. Claim 1 recites:²

1. An Internet-connected digital device for receiving, via the Internet, video content to be viewed by a subscriber of a video-on-demand system using a hierarchically arranged electronic program guide,

the Internet-connected digital device being configured to obtain and present to the subscriber an electronic program guide

² Claim 1 was corrected in two certificates of correction dated December 4, 2018, and February 12, 2019. Ex. 1001.

as a templated video-on-demand display, which uses at least one of a plurality of different display templates to which the Internet-connected digital device has access, to enable a subscriber using the Internet-connected digital device to navigate in a drill-down manner through titles by category information in order to locate a particular one of the titles whose associated video content is desired for viewing on the Internet-connected digital device using the same category information as was designated by a video content provider in metadata associated with the video content;

wherein the templated video-on-demand display has been generated in a plurality of layers, comprising:

(a) a first layer comprising a background screen to provide at least one of a basic color, logo, or graphical theme to display;

(b) a second layer comprising a particular display template from the plurality of different display templates layered on the background screen, wherein the particular display template comprises one or more reserved areas that are reserved for displaying content provided by a different layer of the plurality of layers; and

(c) a third layer comprising reserved area content generated using the received video content, the associated metadata and an associated plurality of images to be displayed in the one or more reserved areas in the particular display template as at least one of text, an image, a navigation link, and a button,

wherein the navigating through titles in a drill-down manner comprises navigating from a first level of the hierarchical structure of a video-on-demand content menu to a second level of the hierarchical structure to locate the particular one of the titles, and

wherein a first template of the plurality of different display templates is used as the particular display template for the templated display for displaying the first level of the hierarchical structure and wherein a second template of the plurality of different display templates is used as the particular display template for the templated display for displaying the second level of the hierarchical structure,

wherein the received video content was uploaded to a Web-based content management system by a content provider device associated with the video content provider via the Internet in a digital video format, along with associated metadata including title information and category information, and along with the associated plurality of images designated by the video content provider, the associated metadata specifying a respective hierarchical location of a respective title of the video content within the electronic program guide to be displayed on the Internet-connected digital device using the respective hierarchically-arranged category information associated with the respective title,

wherein at least one of the uploaded associated plurality of images designated by the video content provider is displayed with the associated respective title in the templated video-on-demand display.

D. Evidence

Petitioner relies on the following prior art:

U.S. Patent No. 8,434,118 B2, filed May 27, 2004, issued Apr. 30, 2013 (Ex. 1005, “Gonder”);

U.S. Patent No. 7,159,233 B2, filed Jan. 29, 2001, issued Jan. 2, 2007 (Ex. 1006, “Son”); and

U.S. Patent Application Publication No. 2001/0030667 A1, published Oct. 18, 2001 (Ex. 1007, “Kelts”).

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