

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

MOTION FOR JOINDER TO *INTER PARTES* REVIEW IPR2020-01267

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I. INTRODUCTION

AT&T Services, Inc. and DIRECTV, LLC (collectively “Petitioners” or “AT&T”) respectfully submit this Motion for Joinder, concurrently with a Petition (“AT&T’s Petition”) for *inter partes* review of U.S. Patent No. 10,028,026 (“the ’026 Patent”).

Pursuant to 35 U.S.C. ¶ 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), AT&T requests institution of *inter partes* review and joinder with IPR2020-01267 (“DISH IPR”), which was instituted on January 21, 2021. *DISH Network L.L.C. v. Broadband iTV, Inc.*, IPR2020-01267, Paper 15 (PTAB Jan. 21, 2021). The instant Petition is substantially identical to the DISH Petition; it involves the same claims of the same patent, the same grounds of unpatentability, and the same supporting evidence. This Motion for Joinder and AT&T’s Petition are timely because they are being filed less than one month after the January 21, 2021 decision instituting trial in the DISH IPR. *See* 37 C.F.R. § 42.122(b).

AT&T’s Petition and Motion for Joinder are being filed to ensure that a petitioner remains to complete the trial if DISH Network L.L.C. (“DISH”) reaches a settlement with the Patent Owner or is otherwise terminated from the proceeding. Upon joining the DISH IPR proceeding, AT&T will act as an “understudy” and will not assume an active role unless DISH ceases to participate. No new grounds are being raised by AT&T, and no alteration of the DISH IPR schedule will be

necessary due to the joinder of AT&T. The joinder will promote judicial efficiency in determining the patentability of the '026 Patent without prejudice to the Patent Owner.

AT&T has notified counsel for DISH and counsel for Patent Owner regarding the subject of this motion. Counsel for DISH indicated that DISH will not oppose this motion. Counsel for Patent Owner has indicated that Patent Owner will oppose this motion.

In light of the similarities of the proceedings, the potential benefit to the public and the Board that would accrue by AT&T's participation in the DISH IPR proceeding in the event that DISH's participation terminates unexpectedly, and the lack of prejudice to Patent Owner, Petitioner respectfully requests that the Board join AT&T as a party to the DISH IPR.

II. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

Per 35 U.S.C. § 315(c), the Board may grant a motion for joining a petitioner for *inter partes* review to another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4)

specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Paper 17 at 3 (July 29, 2013). AT&T addresses each of these points below.

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014). AT&T's Petition and this motion are being filed within one month of the Board's decision instituting trial in the DISH IPR on January 21, 2021. This motion is therefore timely. *See, e.g., Biotronik, Inc. v. Atlas IP LLC*, IPR2015-00534, Paper 10 (PTAB Feb. 25, 2015) (granting motion for joinder filed concurrently with institution of IPR review).

B. The Four Factors Favor Joinder

Each of the four factors weigh in favor of granting AT&T's Motion for Joinder. AT&T's Petition is substantively identical to the petition in the DISH IPR. AT&T's Petition does not present any new grounds of unpatentability. And because AT&T agrees to take on an "understudy" role in the DISH IPR proceeding, joinder will have minimal or no impact on the pending schedule of the DISH IPR. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6-9 (PTAB Oct. 5, 2015) (granting motion for joinder where petitioner agreed

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