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Paper 15
Date: February 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C.,
Petitioner,

v.

BROADBAND iTV, INC.,
Patent Owner.

IPR2020-01360
Patent 9,648,388 B2

Before JEFFREY S. SMITH, JUSTIN T. ARBES, and DANIEL J. GALLIGAN, *Administrative Patent Judges.*

SMITH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background and Summary

On July 31, 2020, Petitioner DISH Network L.L.C. filed a Petition (Paper 1, "Pet." or "the 1360 Petition") requesting *inter partes* review of claims 1, 2, 5, and 7–19 of U.S. Patent No. 9,648,388 B2 (Ex. 1101, "the '388 patent"). Patent Owner Broadband iTV, Inc. filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Petitioner also filed a separate paper providing an explanation for filing multiple petitions ranking its petition in Case IPR2020-01359 ahead of its Petition in this proceeding. Paper 3. Patent Owner filed a response. Paper 7. With our authorization (Paper 9), Petitioner filed a Reply (Paper 11) and Patent Owner filed a Sur-Reply (Paper 12) directed solely to an issue regarding whether we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a).

The standard for instituting review is set forth in 35 U.S.C. § 314(a), which provides that

> [t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Thus, § 314(a) does not mandate institution, even if the reasonable likelihood threshold is met. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion."); *see also Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.").

For the reasons that follow, we do not institute an *inter partes* review in this proceeding.

B. Related Matters

The parties indicate that the '388 patent is the subject of three district court cases: *Broadband iTV, Inc. v. DISH Network, L.L.C.*, Case No. 19-cv-716 (W.D. Tex.), *Broadband iTV, Inc. v. AT&T Services, Inc.*, Case No. 19-cv-712 (W.D. Tex.), and *Broadband iTV, Inc. v. DirecTV, LLC*, Case No. 19-cv-714 (W.D. Tex.). *See* Pet. 3; Paper 5, 1. Petitioner filed another petition challenging claims 1–19 of the '388 patent in Case IPR2020-01359 (Paper 1) ("1359 Pet." or "the 1359 Petition") on the same day it filed this Petition, and Petitioner filed six other petitions challenging claims of related patents also asserted in the district court cases in Cases IPR2020-01267, IPR2020-01268, IPR2020-01280, IPR2020-01281, IPR2020-01332, and IPR2020-01333. Different petitioners previously filed two petitions challenging claims of a related patent to the '388 patent, U.S. Patent No. 7,631,336 B2, in Cases IPR2014-01222 and CBM2014-00189, both of which were denied. *See* Pet. 4; Paper 5, 2.

C. Real Parties in Interest

Petitioner identifies the following real parties in interest: DISH Network L.L.C. and DISH Network Corporation. Pet. 3. Patent Owner identifies itself as the real party in interest. Paper 5, 1.

D. Prior Art and Asserted Ground

Petitioner asserts that claims 1, 2, 5, and 7–19 of the '388 patent are unpatentable on the following ground:

Claims Challenged	35 U.S.C. §	References/Basis
1, 2, 5, 7–19	103(a)[1]	Son,[2] Scheffler,[3] CableLabs,[4] Kelts[5]

II. ANALYSIS

The Board's November 2019 Consolidated Trial Practice Guide[6] ("TPG") advises that "one petition should be sufficient to challenge the claims of a patent in most situations" but also "recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references." TPG 59. The TPG further provides:

> To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the

[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. § 103. Based on the chain of priority of the '388 patent, we refer to the pre-AIA version of 35 U.S.C. § 103.

[2] US 7,159,233, filed Jan. 29, 2001, issued Jan. 2, 2007 (Ex. 1105).

[3] Robert G. Scheffler, *Ingest & Metadata Partitioning: Requirements for Television on Demand* (Ex. 1006).

[4] *CableLabs Video-on-Demand Content Specification Version 1.1* (Ex. 1109).

[5] US 2001/0030667 A1, published Oct. 18, 2001 (Ex. 1107).

[6] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

> Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a).

TPG 59–60; *see* TPG 60 n.3 ("A separate paper filed with the petitions is limited to providing this explanation and shall be no more than 5 pages where the same paper is filed with each petition.").

Petitioner filed another petition, the 1359 Petition, challenging claims 1–19 of the '388 patent as obvious in view of Baumgartner (Ex. 1104, US 2010/0153997 A1), Son, Scheffler, and CableLabs. In its paper explaining why two are petitions necessary, Petitioner argues that (a) the '388 patent includes lengthy, complex claims, (b) Patent Owner has vaguely alleged that the claims of the '388 patent may have an earlier priority date than Baumgartner,[7] and (c) the 1360 Petition is not cumulative to the 1359 Petition. *See generally* Paper 3. According to Petitioner, Baumgartner teaches a complete VOD system and hierarchical guide, and Son, Scheffler, and CableLabs provide details of Baumgartner's generic features. Paper 3, 5. Petitioner contends that Son focuses primarily on the VOD system and that such a system can be combined with the VOD guide of Kelts. *Id.* In its responsive paper, Patent Owner asserts that Petitioner

[7] Baumgartner is a continuation of an application filed on January 21, 2004. Ex. 1104, code (63). Patent Owner has asserted in the related district court case between the parties that claims 1–19 of the '388 patent have a priority date of "at least as early as July 30, 2004, but no earlier than October 2003." Ex. 1127, 2–3.

does not explain why Son is materially different from Baumgartner. Paper 7, 4.

Even were we to agree with Petitioner that the claims are lengthy and complex, and that Patent Owner may show that the '388 patent has an earlier priority date than Baumgartner, there is still considerable overlap between the 1360 Petition and the 1359 Petition. The first ground asserted in the 1359 Petition and the single ground asserted here each rely on four references, where three of the references, Son, Scheffler, and CableLabs, are identical. Further, all of the claims challenged in the 1360 Petition are also challenged in the 1359 Petition. As a result, both Petitions contain the same descriptions of the '388 patent, the same claim constructions, the same descriptions of Son, Scheffler, and CableLabs, and rely on the same teachings of Son, Scheffler, and CableLabs to teach a VOD system, providing metadata along with VOD content, and using the metadata to generate a VOD menu. *Compare* Pet 9–24, 28–31, 33–39, 43, 46, *with* 1359 Pet. 11–18, 26–33, 39, 41–42, 44–46, 49.

The main difference between the Petitions is that the first ground of the 1359 Petition relies on Baumgartner to teach a hierarchical VOD menu, and the single ground of the 1360 Petition relies on Kelts to teach the hierarchical VOD menu. *See* Paper 3, 5. Petitioner has not persuasively explained why it was unable to present an additional ground that relies on Kelts to teach a hierarchical VOD guide in the same Petition that presents a ground relying on Baumgartner to teach such a guide, given that both grounds present the same claim constructions, use the same secondary references, and rely on the same teachings of the secondary references to teach the same claim limitations.

We do not find the asserted differences between the 1359 Petition and the 1360 Petition, as explained by Petitioner, to be sufficiently material to outweigh the inefficiencies and burden on the Board and on Patent Owner that would result from instituting both Petitions. *See* TPG at 59. Instituting both Petitions would unnecessarily place a substantial burden on the Board and on Patent Owner. Rather, instituting only one Petition addresses the patentability of all challenged claims.

We therefore determine that one petition is sufficient to address the challenged claims of the '388 patent. Although the 1359 Petition does not resolve the priority date issue identified by the 1360 Petition, Petitioner has ranked the 1359 Petition as the stronger petition of the two. Paper 3, 3. For the reasons explained in our institution decision in that case, which issues concurrently with this Decision, we determine Petitioner has shown a reasonable likelihood of prevailing on its challenge based on the combination of Baumgartner, Son, Scheffler, and CableLabs.

III. CONCLUSION

Based on the foregoing, we do not institute an *inter partes* review in this proceeding.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied and no *inter partes* review is instituted in this proceeding.

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