

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

DISH NETWORK LLC,
Petitioner,

v.

ENTROPIC COMMUNICATIONS, LLC,
Patent Owner.

IPR2024-00373¹
Patent 7,594,249 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Granting Director Review, Vacating-in-Part the Final Written Decision, and
Remanding to the Board for Further Proceedings

¹ DIRECTV, LLC, who filed a petition in IPR2024-01060, has been joined as a Petitioner to this case.

Entropic Communications, LLC (“Patent Owner”) filed a request for Director Review of the Final Written Decision (“Decision,” Paper 44) in the above-captioned case, and Dish Network, LLC (“Petitioner”) filed an authorized response. *See* Paper 45 (“DR Request”); Paper 46. Patent Owner argues that the Decision should be reversed because the Board failed to address Patent Owner’s arguments as to the patentability of claim 17. DR Request 1. In particular, Patent Owner contends that claim 17 requires the use of a time division duplex (“TDD”) protocol and beacon messages, which none of the references asserted as part of Petitioner’s Grounds 3 and 4² disclose. *Id.* at 3–6 (citing Paper 17 (Patent Owner Response, “PO Resp.”) at 46–51). Patent Owner argues that the Board, in determining that Petitioner had shown that claim 17 was unpatentable under Grounds 3 and 4, either overlooked or ignored Patent Owner’s arguments. *Id.* (citing Decision 60, 77).

Petitioner responds that the Board’s unpatentability finding as to claim 17 is well-supported and should stand. Paper 46, 1. Petitioner argues that the record included ample evidence for the Board to conclude that claim 17 is unpatentable and “there is no legal requirement for [the Board] to restate each argument advanced by a patent owner.” *Id.* at 6.

² The Decision did not reach the merits of Petitioner’s Ground 1 or Ground 2. *See* Decision 15–16. Ground 3 challenges certain claims as obvious over Amit (U.S. Patent No. 7,127,734 B1, issued Oct. 24, 2006) and Jacobsen (Krista S. Jacobsen et al., *An Efficient Digital Modulation Scheme for Multimedia Transmission on the Cable Television Network*, 1994 NCTA Technical Papers, 305–312 (1994)). Paper 2, 11–12. Ground 4 challenges certain claims as obvious over Amit, Jacobsen, and DSL-Book (Dr. Walter Y. Chen, DSL, SIMULATION TECHNIQUES AND STANDARDS DEVELOPMENT FOR DIGITAL SUBSCRIBER LINE SYSTEMS (1998)). *Id.*

In its Decision, the Board stated that Patent Owner “does not present any arguments specific to claims 2, 9, and 17.” Decision 60, 77. That statement is erroneous. Patent Owner presented multiple arguments disputing Petitioner’s unpatentability contentions for claim 17. PO Resp. 46–49. For example, Patent Owner argued that Amit, which Petitioner relied on as teaching TDD, instead discloses time division multiplexing and is entirely silent on the use of the claimed beacon messages, which are used for synchronizing TDD communications. *Id.* at 46–47. Patent Owner also argued that DSL-Book’s pilot tones do not suggest the claimed beacon messages, rendering Ground 4 deficient. *Id.* at 48; *see also* Paper 34, 20–21. The Board did not explicitly address those arguments, and it appears that Patent Owner has raised a persuasive argument that Amit does not disclose the claimed TDD protocol for communications.

In view of the foregoing, Director Review is granted, the Decision is vacated in part, and this case is remanded to the Board with instructions to consider Patent Owner’s arguments as to claim 17 under Petitioner’s Grounds 3 and 4.³

Absent good cause, the Board shall issue its decision within 30 days of this Order.

Accordingly, it is:

ORDERED that Director Review is granted;

³ The Board also shall determine whether Petitioner has shown by a preponderance of the evidence that claims 2 and 9 are unpatentable because those claims recite the same limitations as claim 17 and the Board addressed all three claims together. *See* Decision 60, 77; DR Request 6.

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FURTHER ORDERED that the Final Written Decision (Paper 44) is vacated-in-part; and

FURTHER ORDERED that the case is remanded to the Board for further proceedings consistent with this Order.

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