

From: [Trials](#)
To: [Williams, Eliot D.](#); [Paquette, Ian G.](#); [Trials](#)
Cc: [Gasparo, Frank M.](#); [DishvMindGeek](#); [Guy, Hop](#); [Dhanani, Ali](#); [Carter, Thomas](#); [Sheng, Philip T.](#)
Subject: RE: Request for Leave to file motions to strike Sur-Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00512, -00513, -00515, -00518, and -00519
Date: Tuesday, July 2, 2024 2:49:51 PM

Counsel,

From the Board –

The Board does not authorize Petitioner's intended motion to strike. To the extent that there was confusion regarding the due date for Patent Owner's Preliminary Sur-reply, we excuse any late action because we find that the consideration of Patent Owner's arguments is in the interests of justice. See 37 C.F.R. § 42.5(c)(3).

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Williams, Eliot D. <Eliot.Williams@BakerBotts.com>
Sent: Tuesday, July 2, 2024 12:06 PM
To: Paquette, Ian G. <IGPaquette@Venable.com>; Trials <Trials@USPTO.GOV>
Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>; Sheng, Philip T. <PTSheng@Venable.com>
Subject: RE: Request for Leave to file motions to strike Sur-Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00512, -00513, -00515, -00518, and -00519

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Dear Honorable Board:

Dish (PO) disagrees with several aspects of Petitioner's argumentative email below. As Dish explained to Petitioner in the course of the parties' meet and confer, through a clerical error, our docketing system calendared these deadlines based on the Board's 6/13 email authorizing the filing of the sur-replies within "two weeks" of the 6/13 email. The Board's subsequent email sent the next day, which changed those deadlines, was inadvertently not forwarded to our docketing department and, because the order was received via email only and not filed in the record, our docketing department was unaware of the revised deadline.

Separately, contingent on the Board granting Petitioner's request to file motions to strike PO's sur-replies, Dish would similarly request leave to file motions to strike Petitioner's pre-institution relies

in IPR2024-00512, -00513, -00515, -00518, and -00519 for failure to comply with Rules 42.6(a)(4) and 42.11(b) and/or for being over the page limit to which the parties' agreed (and the Board ordered). In particular, Petitioner's reply briefs were limited to 6 pages inclusive of the required signature. However, none of Petitioner's reply briefs contained signatures on page 6, and no Rule or Order permits Petitioner to exclude the required signature from the page limit. *Cf. Verasonics, Inc. v. Supersonic Imagine*, IPR2019-00799, Paper 6 at *4 (P.T.A.B., May 13, 2019) ("we agree with Patent Owner that [the signature block] should be reflected in the total word count..."). Petitioner should be required to re-file corrected replies that comply with the Board's Order regarding length, and PO should be permitted to file revised sur-replies responding to the corrected replies. Dish believes the Board's resolution of this motion would moot Petitioner's proposed motion.

Respectfully submitted,

Eliot D. Williams

BAKER BOTTS LLP 

+1 202 639-1334 (Direct Dial)

From: Paquette, Ian G. <IGPaquette@Venable.com>

Sent: Monday, July 1, 2024 6:23 PM

To: Trials <Trials@USPTO.GOV>

Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek

<DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop

<hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas

<thomas.carter@bakerbotts.com>; Sheng, Philip T. <PTSheng@Venable.com>

Subject: Request for Leave to file motions to strike Sur-Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00512, -00513, -00515, -00518, and -00519

[EXTERNAL EMAIL]

Dear PTAB Board,

Petitioner ("Aylo") requests leave to file motions to strike Patent Owner's ("DISH") untimely POPR sur-replies in IPR2024-00512, -00513, -00515, -00518, and -00519. The parties met and conferred on July 1, 2024, and DISH opposes the motions.

Per the Board's email to the parties on Friday, May 24, 2024 at 9:16 AM, DISH's sur-reply in IPR2024-00515 was due on June 21, 2024. Although DISH received authorization on June 14, 2024 to file a corrected POPR to correct minor clerical errors in its original filing, the Board did not alter DISH's deadline to file its sur-reply on June 21, 2024. DISH did not file its sur-reply until June 26, 2024—five days late.

Per the Board's email to the parties on Friday, June 14, 2024 at 4:40 PM, DISH's sur-replies in IPR2024-00512, -00513, -00518, and -00519 were due on June 24, 2024. Notably, the Board's email confirmed Aylo's request for clarification that if Aylo filed its replies on Monday, June 17, 2024 that DISH's sur-replies would be due "7 days after Petitioner files," i.e., June 24, 2024. Aylo proceeded to file its replies on June 17, 2024. However, DISH did not file its sur-replies until June 27, 2024—three days late.

As Aylo intends to show in its motion, this is a rare instance where the “exceptional remedy” of striking a paper in its entirety is warranted because the Board previously warned DISH about missing deadlines, DISH cannot show good cause, and striking the sur-replies would be in the interest of justice. *See Aylo Freesites Ltd v. DISH Technologies LLC*, IPR2024-00044, Paper 7 (though DISH “ha[d] not shown good cause,” the Board “excuse[d] Patent Owner’s late filing” but “caution[ed] the parties that the Board expects compliance with all future deadlines”); PTAB Consolidated Trial Practice Guide at 80. Aylo also has been prejudiced by DISH’s untimely filings because part of the purpose of Aylo’s replies in these IPRs was to request that the Board institute the IPRs early so that the schedules can be aligned with Aylo’s Ogdon IPRs. *E.g.*, IPR2024-00515, Paper 10 at 3-4, EX1013. Any delay could make alignment more difficult.

Aylo proposes an expedited briefing schedule as follows:

- (1) Aylo’s 7-page motions to strike be due within 3 days of authorization from the Board;
- (2) DISH’s 7-page oppositions be due within 3 days of the filing of Aylo’s motion;
- (3) Aylo’s 4-page replies be due within 3 days of the filing of DISH’s opposition.

Aylo thanks the Board for its consideration. If the Board would like to hold a conference call, the parties are generally available this Wednesday or Friday morning.

Regards,

Ian G. Paquette, Esq. | Venable LLP
t 212.218.2324 | f 212.307.5598 | m 301.752.8254
151 W. 42nd Street, 49th Floor, New York, NY 10036

IGPaquette@Venable.com | www.Venable.com

From: Trials <Trials@USPTO.GOV>

Sent: Friday, June 14, 2024 4:40 PM

To: Paquette, Ian G. <IGPaquette@Venable.com>; Trials <Trials@USPTO.GOV>

Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>

Subject: RE: Request for Leave to file Replies and Sur-Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00512, -00513, -00518, and -00519

Caution: External Email

Counsel,

From the Board –

Patent Owner’s Preliminary Sur-reply will be due 7 days after Petitioner files the Preliminary Reply.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Paquette, Ian G. <IGPaquette@Venable.com>
Sent: Thursday, June 13, 2024 4:55 PM
To: Trials <Trials@USPTO.GOV>
Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>
Subject: RE: Request for Leave to file Replies and Sur-Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00512, -00513, -00518, and -00519

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Dear PTAB Board,

Thank you for the authorization. For clarification, the parties requested that Petitioner's reply "be due anytime within 7 days of the Board's approval" and that "Patent Owner's sur-reply be due anytime within 7 days of when Petitioner files its POPR replies."

If Aylo files on Monday, June 17, for example, would Patent Owner's responses be due within 7 days of when Aylo files, or two weeks from the date of the Board's email below?

Regards,

Ian G. Paquette, Esq. | Venable LLP
t 212.218.2324 | f 212.307.5598 | m 301.752.8254
151 W. 42nd Street, 49th Floor, New York, NY 10036

IGPaquette@Venable.com | www.Venable.com

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, June 13, 2024 2:20 PM
To: Paquette, Ian G. <IGPaquette@Venable.com>; Trials <Trials@USPTO.GOV>
Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>
Subject: RE: Request for Leave to file Replies and Sur-Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00512, -00513, -00518, and -00519

Caution: External Email

Counsel,

The panel authorizes the requested briefing in the subject cases. The Preliminary Reply and Sur-reply, each of no more than 6 pages, are due one week and two weeks, respectively, from the date of this email.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Paquette, Ian G. <IGPaquette@Venable.com>
Sent: Thursday, June 13, 2024 9:33 AM
To: Trials <Trials@USPTO.GOV>
Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>
Subject: Request for Leave to file Replies and Sur-Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00512, -00513, -00518, and -00519

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Dear PTAB Board,

The Board previously granted the parties' requests in IPR2024-00514, -00515, -00516, and -00517 for Petitioner to file a 6-page POPR reply and for Patent Owner to file a 6-page sur-reply on certain topics (listed in the below correspondence with the Board). The parties jointly request the same 6-page reply and sur-reply covering the same topics in IPR2024-00512, -00513, -00518, and -00519, which are directed to Patent Owner's related patents and involve the same Leaning reference.

The parties propose that Petitioner's POPR replies in IPR2024-00512, -00513, -00518, and -00519 be due anytime within 7 days of the Board's approval of this request and that Patent Owner's sur-reply be due anytime within 7 days of when Petitioner files its POPR replies.

The parties thank the Board for its consideration. The parties do not believe a conference call is necessary but, if the Board requests one, the parties will confer and provide their availability.

Regards,

Ian G. Paquette, Esq. | Venable LLP
t 212.218.2324 | f 212.307.5598 | m 301.752.8254
151 W. 42nd Street, 49th Floor, New York, NY 10036

IGPaquette@Venable.com | www.Venable.com

From: Trials <Trials@USPTO.GOV>

Sent: Friday, May 24, 2024 9:16 AM

To: Trials <Trials@USPTO.GOV>; Paquette, Ian G. <IGPaquette@Venable.com>

Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>

Subject: RE: Petitioner's Request for Leave to file Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00514, -00515, -00516, and -00517

Caution: External Email

Counsel,

From the Board –

Please disregard the due date times of the prior email. The Preliminary Reply and Sur-reply, each of no more than 6 pages, are due two weeks and four weeks, respectively, from the date of this email.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Trials <Trials@USPTO.GOV>

Sent: Friday, May 24, 2024 8:22 AM

To: Paquette, Ian G. <IGPaquette@Venable.com>; Trials <Trials@USPTO.GOV>

Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>

Subject: RE: Petitioner's Request for Leave to file Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00514, -00515, -00516, and -00517

Counsel,

The panel authorizes the requested briefing in the subject cases. The Preliminary Reply and Sur-reply, each of no more than 6 pages, are due one week and two weeks, respectively, from the date of this email.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Paquette, Ian G. <IGPaquette@Venable.com>
Sent: Thursday, May 23, 2024 11:01 AM
To: Trials <Trials@USPTO.GOV>
Cc: Gasparo, Frank M. <FMGasparo@Venable.com>; DishvMindGeek <DishvMindGeek@BakerBotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Guy, Hop <hop.guy@BakerBotts.com>; Dhanani, Ali <ali.dhanani@bakerbotts.com>; Carter, Thomas <thomas.carter@bakerbotts.com>
Subject: Petitioner's Request for Leave to file Replies to Patent Owner's Preliminary Responses in Aylo v. DISH IPR2024-00514, -00515, -00516, and -00517

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Dear PTAB Board,

Petitioner in IPR2024-00514, -00515, -00516, and -00517 respectfully requests authorization in each IPR to file a Preliminary Reply of no more than 6 pages not inclusive of exhibits to respond to Patent Owner's arguments in its preliminary response. The parties met and conferred, and Patent Owner does **not** oppose this request as long as it can file an equal-length sur-reply.

A Preliminary Reply is warranted because Patent Owner did not address any of the merits of the IPR petitions, but instead dedicated its entire allotted word count arguing for discretionary denial. Thus, Patent Owner raised arguments that Petitioner believes it could not reasonably have had space to address or could not be expected to have anticipated and preemptively addressed in its petition. The parties have agreed that Petitioner's Preliminary Reply will be limited to the following:

- Responding to Patent Owner's arguments regarding lack of examiner error based on events that happened after the petitions were filed, such as the notice of allowance of the just issued 18/069,450 Application (U.S. Pat. No. 11,991,234);
- Responding to Patent Owner's arguments regarding the timing that Petitioner filed the Ogdon-based petitions and to explain the relevance of a preliminary injunction motion Patent Owner had filed against Petitioner in district court;
- Proposing a schedule for the Leaning-based petitions in the event they are instituted, including proposals to align the schedule of the Leaning-based petitioners with the schedule

of the Ogdon-based petitions.

The parties thank the Board for its consideration. If a conference call is needed, the parties will confer and provide their availability.

Respectfully submitted,

Ian Paquette
Counsel for Petitioner Aylo Freesites, Ltd

[Ian G. Paquette, Esq. | Venable LLP](#)
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