UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner
v.

DISH TECHNOLOGIES L.L.C.,
Patent Owner

U.S. Patent 9,407,564
Issue Date: August 2, 2016
Title: APPARATUS, SYSTEM, AND METHOD FOR ADAPTIVE-RATE SHIFTING OF STREAMING CONTENT

Inter Partes Review No. IPR2024-00518

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

PETITIONER'S UPDATED EXHIBIT LIST

Table of Exhibits for U.S. Pat. 9,407,564 Petition for *Inter Partes* Review

Exhibit Number	Description
1001	U.S. Pat. 9,407,564 ("the '564 Patent")
1002	File History of U.S. Pat. 9,407,564
1003	Declaration of Dr. Henry Houh including Curriculum Vitae ("Houh declaration")
1004	International P.C.T. Publication WO 2002049343 to Leaning et al. ("Leaning")
1005	<RESERVED>
1006	<RESERVED>
1007	U.S. Patent No. 6,848,004 to Chang ("Chang")
1008	WO1997044942 to Kliger ("Kliger")
1009	337-TA-1265 ITC Investigation Initial Determination
1010	337-TA-1265 ITC September 11, 2023 Enforcement Complaint
1011	<RESERVED>
1012	Board email authorizing reply to POPR and sur-reply
1013	U.S. Patent No. 6,637,031 to Chou ("Chou")
1014	U.S. Pat. No. 11,991,234 File History
1015	Exemplary disclosures from Leaning disclosing allegedly allowable limitations of the '234 Patent
1016	Excerpts from March 27, 2024 hearing before the High Court of Justice Business and Property Courts of England and Wales Intellectual Property List (ChD) Patents Court in DISH Technologies & Sling TV v. Aylo Premium & Others, Claim No. HP-2023-000043
1017	Example Proposed Due Dates
1018	<RESERVED>
1019	<RESERVED>
1020	U.S. Patent Publication No. US 2004/0093420 to Gamble ("Gamble")

It is telling that DISH spent its entire POPR arguing for discretionary denial and not one word on the merits. DISH knows Leaning is a strong reference. Indeed, DISH has admitted to the United Kingdom High Court in parallel foreign litigation that it will likely need to amend its related European patents to overcome Leaning. The Board should not discretionarily deny Aylo's petition because (1) Aylo's Ogdon petitions were caused by DISH filing an early preliminary-injunction motion; (2) the schedules for the Ogdon and Leaning petitions can be aligned; and (3) events occurring after the Leaning petitions were filed confirm examiner error. EX1012.

I. The Timing of Aylo's Ogdon Petitions Was Due to DISH Filing a Preliminary-Injunction Motion in District Court

DISH argues under *General Plastics* that Aylo should not have filed its Ogdon petitions ten months before its statutory deadline. POPR, 4. But the timing of Aylo's Ogdon petitions was due to DISH filing a preliminary-injunction ("PI") motion in district court seeking to shut down Aylo's business. Specifically, DISH sued Aylo in the District of Utah on August 22, 2023, and asked Aylo to waive service. Utah Action,[1] D.I. 18. On the same day Aylo agreed to waive service, and without warning, DISH filed a PI motion. *Id.*, D.I. 19. Aylo had only one month to respond and prove that DISH was unlikely to succeed on the merits at trial, including that

[1] *DISH Techs. L.L.C. et al. v. MG Premium LTD et al.*, No. 2:23-cv-552 (D. Utah.).

DISH's patents were likely invalid. Thus, Aylo moved as quickly as possible to draft and file IPRs on all of DISH's asserted patents based on the best art Aylo was aware of at that time, i.e., Ogdon, to show the Utah court that Aylo's invalidity arguments were not mere conjecture. On May 24, 2024, the Utah court issued a stay pending Aylo's IPRs (to which DISH objected (*id.*, D.I. 106)), rejected the reasons for DISH's PI Motion, and requested ongoing status updates on both the Ogdon petitions and Leaning petitions. *Id.*, D.I. 101. DISH's POPR omits any mention of its PI motion, but instead makes the vague, disingenuous claim that Aylo's early filing of the Ogdon petitions was "for [Aylo's] own unique reasons." POPR, 8.

DISH further argues under *General Plastics* that Aylo's decision to challenge certain claims and not others was its own fault. POPR, 4-5. Specifically, DISH claims that Aylo filed its Ogdon petitions on October 13, 2023 "despite knowing that DISH would serve its infringement contentions in the parallel litigation . . . on November 21, 2023" that would identify its asserted claims. POPR, 4. DISH is not referring to the Utah action but to a separate NDCA action.[2] Aylo could not have waited for DISH's contentions in the NDCA action because Aylo was facing DISH's PI motion in Utah and also because DISH had moved to dismiss the NDCA action months before its contentions were due (which the NDCA court ultimately granted).

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[2] *MG Freesites Ltd. v. DISH Techs. L.L.C. et al.*, No. 3:23-cv-03674 (N.D. Cal.).

Moreover, even had Aylo waited and risked a PI, DISH would have just amended its asserted claims. Indeed, on May 21, 2024, DISH was granted leave in Delaware to add 171 new claims against fuboTV.[3] Notably, this was soon after fuboTV filed copycat petitions of Aylo's Ogdon and Leaning petitions.[4] DISH's choice of asserted claims is a moving target, and Aylo should be permitted to challenge the additional claims in its Leaning petitions that were not challenged in its Ogdon petitions.

II. Aylo Will Agree to Shorten Its Own Deadlines to Align the Schedules of the Ogdon Petitions with the Leaning Petitions

Although Aylo's Ogdon petition for the '564 Patent was not instituted, Aylo is still willing to consolidate proceedings and align deadlines with the instituted Ogdon petitions for DISH's related patents to conserve the resources of the Board and to maintain "Patent Owners' interests in quick, efficient resolution of invalidity challenges." POPR, 14. Aylo is willing to agree to a 4-week response time for its Petitioner Reply, which is significantly shorter than the statutory three months under 35 U.S.C. § 314(b). In addition, since DISH did not challenge the merits of this petition and the Board need only decide the issue of discretionary denial, Aylo respectfully submits that the Board may institute earlier than the three-month period to provide for consolidation and schedule alignment.

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[3] *DISH Techs. L.L.C. et al. v. fuboTV Media Inc.*, No. 23-986 (D. Del.), D.I. 38.
[4] IPR2024-00901, -00902, -00903, -00904, -00905, -00917, -00918, and -00919.

Presuming this slightly earlier institution decision in mid- to late-July, DISH would be given its full three months to submit its Patent Owner's Response, and Aylo would submit its Petitioner Reply 4 weeks later. The remaining due dates could then be scheduled to align Oral Hearings for the Ogdon and Leaning petitions on January 16, 2025, and the Board could issue a combined final written decision by April 16, 2025. This proposed schedule is outlined in EX1017.

III. The Examiner Materially Erred in Allowing the Patent Claims

DISH argues under section 325(d) that the examiner considered Leaning in a child application, Pat. App. No. 18/069,450, which recently issued as U.S. Pat. No. 11,991,234 (the "'234 Patent"). POPR, 19-20. However, during prosecution of that patent, DISH did not submit Leaning until ***after*** the examiner issued three separate notices of allowance, where DISH filed serial IDS's after each allowance. EX1014, 201, 356-358, 657. By the time DISH finally submitted Leaning, the examiner had already erred by allowing the claims over Ogdon and Allen (*id.*, 657), as shown by the Board's institution of IPRs on Ogdon and Allen for DISH's related patents.[5] The allowance of the '234 Patent over Leaning is just another error by the same examiner. Indeed, as shown in the claim chart in EX1015 and also in Aylo's recently filed IPR petition covering the '234 Patent, the limitations the examiner said rendered the '234

[5] IPR2024-00043, -00044, -00045, -00046, -00146.

Patent allowable are all disclosed by Leaning. EX1015; *Aylo Freesites Ltd v. DISH Techs. L.L.C.*, IPR2024-00940, Paper 1 (PTAB May 21, 2024).

DISH makes similar arguments under section 325(d) with respect to US2004/0030547, which it calls "Leaning US." POPR, 15. The same examiner errors apply to Leaning US, where it is even less likely the examiner considered any relevant disclosures. As Aylo argued in its petition, Leaning US is entitled "Encoding Audio Signals," and the abstract and claims are directed to encoding audio signals—not the technology at issue here, i.e., adaptive bitrate video streaming—and Leaning and Leaning US are in different patent families. Pet., 65. That the title, abstract, and claims of Leaning US have nothing to do with adaptive bitrate video streaming is likely why the examiner failed to appreciate its disclosure (and, as Aylo pointed out in its petition, is likely why no examiner, nor any of the ITC respondents relied on Leaning US, Pet., 62, 65). In contrast, Leaning is titled "Transmission and Reception of Audio and/or Video Material," and its abstract and claims are directly pertinent to DISH's claims and relied on in Aylo's petition. EX1004, Title; *e.g.*, Pet., 14, 18, 20, 26 (citing Leaning's Abstract); *e.g.*, Pet., 14, 27, 29, 31 (citing Leaning's claims).

Further, as the Director and Board have recognized, it is not uncommon for examiners to err with respect to art cited in an IDS. *See Keysight Techs., Inc. v. Centripetal Networks.*, IPR2022-01421, Paper 14 at 4-8 (PTAB Aug. 24, 2023) (finding examiner misapprehended or overlooked teachings from IDS-cited art);

Hanshow America Inc. v. Ses-Imgotag Inc., IPR2024-00208, Paper 14 at 11-17 (PTAB May 20, 2024) ("[A] signed and initialed IDS, without more, does not indicate that the Office conducted any analysis or evaluation of [the reference]"). The Board has also found that *Becton, Dickinson* factors (c) and (e) weigh against discretionary denial where the examiner did not "expressly evaluate" the IDS-cited art and where the "merits of [the] Petition . . . [are] persuasive." *Amcol Int'l Corp. v. Oil-Dri Corp. of America*, IPR2022-01107, Paper 10 at 10-13 (PTAB Dec. 5, 2022). Significantly, DISH does not challenge the merits of Leaning in this petition.

Finally, DISH relies on events that occurred after the Leaning petitions were filed, such as the allowance of the '234 Patent; but it does not cite other post-filing events that confirm examiner error, such as DISH's statements to the UK High Court, where DISH has sued Aylo on related European patents that share the same parent application and contain similar limitations. Aylo raised Leaning in defense of the UK action, and DISH admitted in open court that it will "likely" need to amend its European patent claims to survive Leaning as a primary obviousness reference. EX1016, 58:19-59:15 (DISH's counsel: "if we seek to amend, which would seem to be likely"), 62:4-25 ("[W]e may well amend the patent, we are contemplating it"), 65:2-65:7 ("There is a likelihood we may amend . . . it is something that it is a real possibility"), 65:12-14 ("MR. JUSTICE MEADE: For all I know, Mr. Moody-Stuart, you have reached the conclusion that you have to amend over Leaning.").

DATED: June 17, 2024

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CERTIFICATE OF SERVICE

I hereby certify that on June 17, 2024 I caused a true and correct copy of the foregoing Petitioner's Reply to Patent Owner's Preliminary Response to be served via email to counsel of record:

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