

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

fuboTV MEDIA INC.,
Petitioner,

v.

DISH TECHNOLOGIES L.L.C.,
Patent Owner.

IPR2024-00904
Patent 10,951,680 B2

Before THU A. DANG, JOHN A. HUDALLA, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

On May 13, 2024, fuboTV Media Inc. (“Petitioner”) filed a Petition (Paper 2, “Petition” or “Pet.”) to institute *inter partes* review of claims 1, 2, 4–12, 14–19, 21–25, and 27–29 of U.S. Patent No. 10,951,680 B2 (Ex. 1001, “the ’680 patent,”) and a Motion for Joinder (Paper 3, “Motion” or “Mot.”) with *Aylo Freesites Ltd v. DISH Technologies L.L.C.*, IPR2024-00046 (“Aylo IPR”). DISH Technologies L.L.C. (“Patent Owner”) did not file an opposition to Petitioner’s Motion and waived the filing of the preliminary response. *See* 37 C.F.R. § 42.25(a)(1) (2023); Ex. 3001 (Patent Owner’s July 1, 2024, email indicating that it waives the filing of the preliminary response). Petitioner indicates that Aylo Freesites Ltd (“Aylo”), the petitioner in the Aylo IPR, does not oppose the Motion. Mot. 2.

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314 (2018); *see* 37 C.F.R. § 42.4 (2023). Upon consideration of the Petition and the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least 1 claim of the ’680 patent. Accordingly, we institute *inter partes* review of claims 1, 2, 4–12, 14–19, 21–25, and 27–29 of the ’680 patent. We also *grant* Petitioner’s Motion for Joinder.

A. *Real Parties-in-Interest*

Petitioner identifies fuboTV Media Inc. as the real party-in-interest. Pet. 1. Patent Owner identifies DISH Technologies L.L.C. and Sling TV

L.L.C., as well as EchoStar Corporation, as the real parties-in-interest.
Paper 5, 2.

B. Related Proceedings

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including the Aylo IPR. Pet. 1–3; Paper 5, 2–6.

C. The '680 Patent

The '680 patent, titled “Apparatus, System, and Method for Multi-Bitrate Content Streaming,” issued on March 16, 2021. Ex. 1001, codes (45), (54). The application that led to the '680 patent was filed on May 18, 2022, and claims priority to, *inter alia*, a provisional application that was filed on April 30, 2004. Ex. 1001, codes (22), (60). Petitioner “assumes” a priority date of April 30, 2004 (Pet. 8), and, for purposes of this Decision, we apply April 30, 2004 for determining whether the asserted references qualify as prior art.

The '680 patent relates to adaptive-rate shifting of streaming content over packet switched networks such as the Internet. Ex. 1001, 1:31–34. The '680 patent recognizes that “[s]treaming offers the advantage of immediate access to the content” (*id.* at 2:1–2), wherein “a need exists for an apparatus, system, and method [that] would offer instantaneous viewing along with the ability for fast forward, rewind, direct seed, and browse multiple streams.” *Id.* at 2:58–63. Accordingly, the '680 patent addresses a purported need to “utilize multiple connections between a source and destination, requesting varying bitrate streams depending upon network conditions.” *Id.* at 2:64–67.

An illustration of the “system for dynamic rate shifting of streaming content” (*id.* at 4:48–50) is depicted in Figure 1 of the ’680 patent, reproduced below:

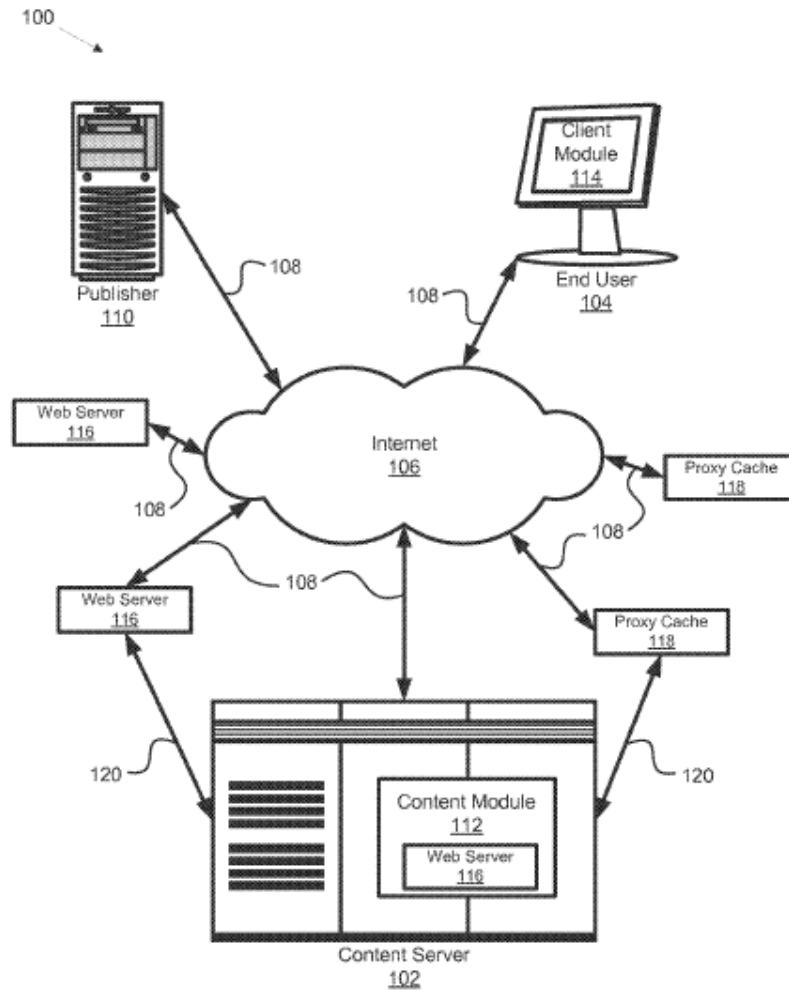


FIG. 1

Figure 1 of the ’680 patent shows system 100 comprising content server 102, end user station 104, publisher 110, and web server 116. *Id.* at 6:36–37, 51–52. Content is transferred over Internet 106 to content server 102, and content from content server 102 may be replicated to other web servers 116. *Id.* at 6:56–57, 7:1–3.

An illustration of “a plurality of streams having varying degrees of quality and bandwidth” (*id.* at 4:53–55) is depicted in Figure 2b of the ’680 patent, reproduced below.

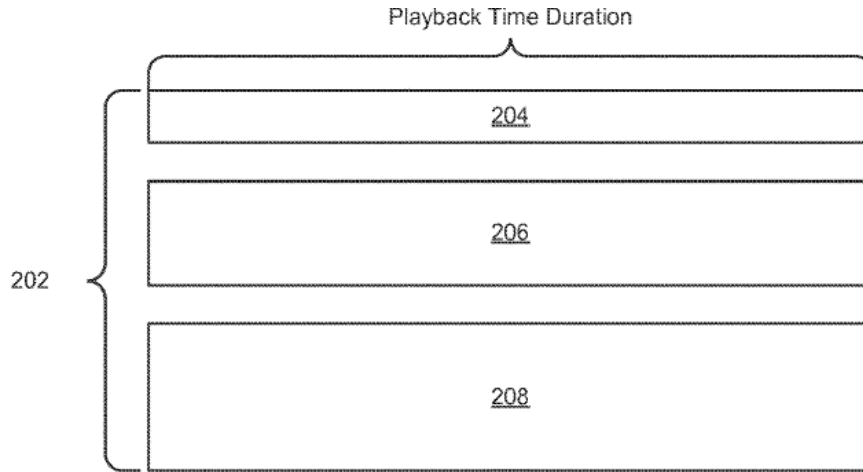


FIG. 2b

Figure 2b shows a plurality of streams 202 comprising low quality stream 204, medium quality stream 206, and high quality stream 208, wherein each of streams 204, 206, 208 is a copy of content file 200 encoded and compressed to varying bit rates. *Id.* at 7:27–31.

An illustration of a stream “divided into a plurality of source streamlets” (*id.* at 4:56–58) is depicted in Figure 3a of the ’680 patent, reproduced below.

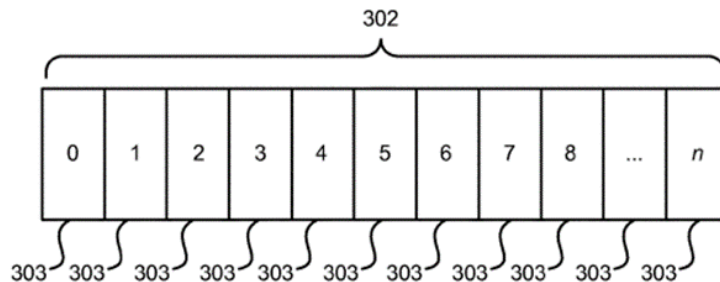


FIG. 3a

Figure 3a shows stream 302 divided into a plurality of source streamlets 303, wherein a “streamlet” is “any sized portion of the content file.” *Id.* at 7:37–40.

An illustration of “sets of streamlets” (*id.* at 4:59–61) is depicted in Figure 3b of the ’680 patent, reproduced below.

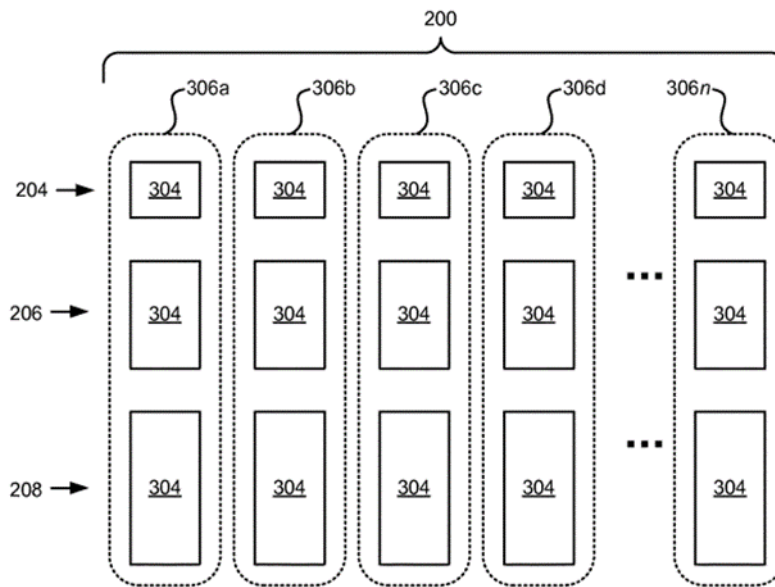


FIG. 3b

Figure 3b shows sets 306 of streamlets, wherein a “set” is a “group of streamlets having identical time indices and durations but varying bitrates.” *Id.* at 7:55–59. As shown in Figure 3b, set 306a includes encoded streamlets 304 having “low, medium, and high 204, 206, 208 bitrates.” *Id.* at 7:61–62.

D. Illustrative Claim

Of the challenged claims, claims 1, 14, 22, and 28 are the independent claims. Claims 2 and 4–12 depend from claim 1, claims 15–19 and 21 depend from claim 14, claims 23–25 and 27 depend from claim 22, and

claim 29 depends from claim 28. Claim 1 is illustrative, and is reproduced below:

1. A system for adaptive-rate content streaming of video playable on one or more end user stations over the Internet, the system comprising:

at least one processor executing non-transitory executable instructions for generating at least one virtual timeline corresponding to the video;

wherein the video encoded at a plurality of different bitrates creating a plurality of streams including a low quality stream, a medium quality stream, and a high quality stream, the low quality stream, the medium quality stream, and the high quality stream each comprising a group of streamlets encoded at a respective one of the plurality of different bit rates, each group of streamlets comprises at least first and second streamlets, each of the streamlets corresponding to a portion of the video;

wherein at least one of the low quality stream, the medium quality stream, and the high quality stream is encoded at a bit rate of no less than 600 kbps; and

wherein the first streamlet of each of the groups of streamlets has the same first duration and encodes the same first portion of the video in each of the low quality stream, the medium quality stream, and the high quality stream, and wherein the first streamlet of the low quality stream encodes the same first portion of the video at a different bitrate than the first streamlet of the high quality stream and the first streamlet of the medium quality stream.

Ex. 1001, 18:24–51.

E. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1, 2, 4–12, 14–19, 21–25, and 27–29 of the ’680 patent on the following grounds (Pet. 5):

Challenged Claims	35 U.S.C. §	References
1, 2, 4–12, 14–19, 21–25, 27–29	103(a) ¹	Ogdon, ² Allen ³
1, 2, 4–12, 14–19, 21–25, 27–29	103(a)	Ogdon, Allen, SMIL 2.0 ⁴

Petitioner relies on the Declaration of Henry Houh, Ph.D. (Ex. 1003) in support of its contentions.

II. ANALYSIS

A. Institution of Inter Partes Review

We instituted an *inter parties* review in the Aylo IPR on all challenged claims and all asserted grounds of unpatentability. Aylo IPR, Paper 8. Petitioner here challenges the same claims and asserts the same grounds of unpatentability as those on which we instituted the Aylo IPR.

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the ’680 patent claims priority to applications that were filed before March 16, 2013, the effective date of the relevant amendment, we assume that the pre-AIA version of § 103 applies. However, our decision would be the same under the current version of the statutes.

² U.S. Patent No. 6,161,137, issued Dec. 12, 2000, filed Mar. 31, 1998 (Ex. 1004, “Ogdon”).

³ PCT Publication No. WO 02/075482 A2, published Sept. 26, 2002, filed Mar. 15, 2002 (Ex. 1005, “Allen”).

⁴ *Synchronized Multimedia Integration Language (SMIL 2.0)*, published Aug. 7, 2001 (Ex. 1006, “SMIL 2.0”).

See Pet. 2 (“The Board has instituted review of all challenged claims in IPR2024-00046, which concerns precisely the same invalidity grounds raised by this Petition.”); Mot. 1–2 (“The Petition is a typical copycat petition that is substantively identical to the Instituted Aylo IPR and introduces no new grounds. Indeed, [Petitioner]’s Petition is a near-verbatim copy of the Instituted Aylo IPR.”); *id.* at 4 (“The two petitions have identical unpatentability arguments, grounds and supporting evidence, and challenge the same claims.”). Petitioner represents that the only differences in Petitioner’s Petition from the instituted Aylo IPR “are reflected in administrative portions (e.g., mandatory notices), a statement regarding [Petitioner]’s agreement with the expert who signed the declaration in support of the Instituted Aylo IPR . . . , the explanation as to why discretionary denial would be inappropriate, and other minor formatting changes and non-substantive corrections.” *Id.* at 2. Petitioner also relies on the same declarant as did the petitioner in the Aylo IPR. Mot. 6 (“[T]he Petition and its accompanying expert declaration are substantively identical to the Instituted Aylo IPR and its accompanying expert declaration.”); Pet. 2–3 (“Petitioner has entered into an agreement with Dr. Henry Houh, who prepared the declaration set forth at Ex. 1003. Dr. Houh confirmed that he has no conflict in working with Petitioner, and agreed to be engaged by Petitioner at his standard rate, should Aylo be unable to proceed with IPR2024-00046 and Petitioner is therefore no longer in the understudy role.”); Mot. 6 n.2 (same); Ex. 1003, 1 (cover page indicating Declaration of Dr. Henry Houh in support of the petition submitted in IPR2024-00046), 82 (signature page dated October 13, 2023).

Because the issues in the instant Petition are identical to those in the Aylo IPR, and for the same reasons stated in our Decision on Institution in the Aylo IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition. *See* Aylo IPR, Paper 8.

B. Motion for Joinder

Joinder in an *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address how briefing and/or discovery may be simplified to minimize schedule impact. *Kyocera Corp. v. SoftView, LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We determine that Petitioner has met its burden of showing that joinder is appropriate because, as set forth above, the Petition is substantively identical to the petition in the Aylo IPR, contains the same grounds based on the same evidence, and relies on the same declaration of Dr. Henry Houh. Mot., *passim*; Ex. 1003. Petitioner also represents that it

“agrees to take an understudy role” so that “the parties can comply with the trial schedule assigned to the Instituted Aylo IPR without any duplicative efforts by the Board or the Patent Owner.” Mot. 7–8.

Additionally, so long as the current petitioner Aylo remains in the Aylo IPR, Petitioner proposes that “Aylo’s lead counsel will act as the lead counsel,” “Aylo’s counsel will submit all briefs, and take and defend all depositions, take the lead for petitioners on any conference calls, and will argue the case before the Board,” and Petitioner’s “counsel will be present only to observe and to answer any questions pertaining specifically to [Petitioner] as the joining party, should any such questions arise.” Mot. 7–8.

We determined above that the Petition warrants the institution of an *inter partes* review. Under these circumstances, we agree with Petitioner that joinder is appropriate and will not unduly impact the ongoing trial in the Aylo IPR. We limit Petitioner’s participation in the Aylo IPR, as follows: (1) Aylo alone is responsible for all petitioner filings in the Aylo IPR until such time that it is no longer an entity in the Aylo IPR, and (2) Petitioner is bound by all filings by Aylo in the Aylo IPR, except for (a) filings regarding termination or settlement, and (b) filings where Petitioner receives permission to file an independent paper. Petitioner must obtain prior Board authorization to file any paper or take any action on its own in the Aylo IPR, so long as Aylo remains as a non-terminated petitioner in the Aylo IPR. This arrangement promotes the just and efficient administration of the ongoing trial in the Aylo IPR, and protects the interests of Aylo as original petitioner in IPR2024-00046, and of Patent Owner.

III. CONCLUSION

For the foregoing reasons, we institute *inter partes* review of claims 1, 2, 4–12, 14–19, 21–25, and 27–29 of the ’680 patent based on the grounds of unpatentability set forth in the Petition. We also *grant* Petitioner’s Motion for Joinder and join Petitioner to the Aylo IPR (i.e., IPR2024-00046), with the limitations set forth herein.

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1, 2, 4–12, 14–19, 21–25, and 27–29 of the ’680 patent with respect to all grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122, Petitioner’s Motion for Joinder (Paper 3) is *granted*, and Petitioner is joined as a petitioner in IPR2024-00046;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2024-00046 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2024-00046, and any modifications thereto, shall govern the schedule of the joined proceeding;

FURTHER ORDERED that all further filings in the joined proceeding are to be made only in IPR2024-00046;

FURTHER ORDERED that Petitioner’s participation in IPR2024-00046 shall be limited as stated above in § II.B unless and until Aylo Freesites Ltd is terminated from that proceeding;

FURTHER ORDERED that the case caption in IPR2024-00046 for all further submissions shall be modified to add fuboTV Media Inc. as named petitioner, and to indicate by footnote the joinder of fuboTV Media Inc. to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record in IPR2024-00046.

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Patent 10,951,680 B2

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Sample Case Caption

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DISH TECHNOLOGIES L.L.C.,
Patent Owner.

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¹ fuboTV Media Inc., which filed a petition in IPR2024-00904, has been joined as a petitioner in this proceeding.