IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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fuboTV Media Inc.,
Petitioner
v.

DISH TECHNOLOGIES L.L.C.,
Patent Owner

Case Unassigned
U.S. Patent 10,469,555

MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c),
37 C.F.R. §§ 42.22, AND 42.122(b)

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I. STATEMENT OF PRECISE RELIEF REQUESTED

fuboTV Media Inc. ("fuboTV") submits this Motion for Joinder ("Motion") concurrently with a "copycat" petition for *inter partes* review ("Petition") of U.S. Patent No. 10,469,555 ("'555 patent") (Ex. 1001), under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b).

At present, and not including fuboTV's Petition submitted concurrently with this Motion, two IPRs have been filed challenging the '555 patent, both by Aylo Freesites Ltd. f/k/a MG Freesites Ltd. ("Aylo"): IPR2024-00146, filed November 7, 2023, and IPR2024-00515, filed January 30, 2024. On April 25, the Board granted institution of *inter partes* review in IPR2024-00146 (the "Instituted Aylo IPR"). In IPR2024-00515, no institution decision has issued yet.

fuboTV seeks party joinder to the Instituted Aylo IPR. fuboTV's request for joinder is timely under 37 C.F.R. § 42.122(b) as it is submitted no later than one month after the April 26, 2024 institution of IPR2024-00146. Further, and as discussed below, fuboTV would remain in an understudy role, following the common PTAB practice, unless and until Aylo is no longer a party to the proceeding. While in an understudy role, fuboTV agrees to allow Aylo to lead the joined proceedings, absent settlement or termination for some other reason.

Joinder would not prejudice either Patent Owner or Aylo. The Petition is a typical copycat petition that is substantively identical to the Instituted Aylo IPR and

introduces no new grounds. Indeed, fuboTV's Petition is a near-verbatim copy of the Instituted Aylo IPR; the only differences are reflected in administrative portions (e.g., mandatory notices), a statement regarding fuboTV's agreement with the expert who signed the declaration in support of the Instituted Aylo IPR (*see also infra* at 6 n.2), the explanation as to why discretionary denial would be inappropriate, and other minor formatting changes and non-substantive corrections.

Aylo has stated that it does not oppose joinder.

II. BACKGROUND AND RELATED PROCEEDINGS

The '555 Patent is assigned to DISH Technologies L.L.C. ("Patent Owner") and based on information and belief, Sling TV L.L.C. is an exclusive licensee. Patent Owner has asserted the '555 patent against Petitioner and numerous other parties. The '555 patent is the subject of the following pending civil actions:

- *DISH Technologies LLC et al. v. Vidgo Inc.*, No. 2 :23-cv-00624 (D. Utah)
- *DISH Technologies LLC v. fuboTV Media Inc.*, No. 1:23-cv-00986 (D. Del.)
- *DISH Technologies LLC v. BritBox, LLC*, No. 1:23-cv-08971 (S.D.N.Y.)
- *DISH Technologies LLC v. Yanka Industries, Inc. d/b/a MasterClass*, No. 1:23-cv-01305 (D. Del.)

- *Aylo Freesites Ltd. f/k/a MG Freesites Ltd. v. DISH Technologies LLC et al.*, No. 1:24-cv-00086 (D. Del.)

Petitioner is a named party only in *DISH Technologies LLC v. fuboTV Media Inc.*, No. 1:23-cv-00986 (D. Del.) (the "District Court Litigation").

As noted above, the '555 patent is also the subject of two sets of IPR proceedings initiated by Aylo, the Instituted Aylo IPR (IPR2024-00146) and IPR2024-00515.

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an existing IPR proceeding. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Sony Mobile Commc'ns AB v. Ancora Techs., Inc.*, IPR2021-00663, Paper 17 at 29-33 (June 10, 2021); *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 at 4-6 (July 29, 2013); *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15 at 3-7 (Sept. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 3-5 (Feb. 25, 2013).

"The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *Dell*, IPR2013-00385, Paper 17 at 3. A motion for joinder should:

> (1) set forth the reasons why 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 specifically how briefing and discovery may be simplified.

Id. at 4 (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013)).

B. Joinder with the Instituted Aylo IPR is Appropriate

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (Aug. 24, 2016) (internal quotation marks omitted). Here, joinder is appropriate because there are no substantive differences between the Petition and the Instituted Aylo IPR. The two petitions have identical unpatentability arguments, grounds and supporting evidence, and challenge the same claims.

When, as here, the petitions are identical, joinder should be granted as a matter of right. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that joinder will be allowed as of right—if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.").

Further, fuboTV may be prejudiced if it is not permitted to join the Instituted Aylo IPR. Patent Owner has asserted the '555 patent against fuboTV in pending litigation. *See supra* Related Proceedings. fuboTV should be permitted to join the IPR(s) to participate in proceedings affecting a patent asserted against it, and thereby allowed to continue the proceedings should the other parties settle under 37 C.F.R. § 42.74 before a final written decision is issued. *See Lowes Cos. Inc. v. Nichia Corp.*, IPR2017-02011, Paper 13 at 19 (Mar. 12, 2018) ("[d]enial of the Petition in part would prejudice the Petitioner in this proceeding should the Vizio Petitions be resolved by settlement").

In addition, permitting fuboTV to join these proceedings helps ensure that the patentability of the challenged claims will ultimately be decided by the Board, efficiently protecting the public and providing the patent owner with predictable and reliable expectations regarding its patent rights.

Thus, this factor favors joinder.[1]

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[1] The factors outlined by *General Plastic Industries Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017), are not particularly relevant here "where a different petitioner files a 'me-too' or 'copycat' petition in conjunction with a timely motion to join." *See, e.g.*, *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019,

C. Joinder Will Not Add Any New Grounds or Issues

The Petition does not include any new grounds of unpatentability. In fact, the Petition and its accompanying expert declaration are substantively identical to the Instituted Aylo IPR and its accompanying expert declaration.[2] *See Everlight Elecs. Co. v. Document Sec. Sys., Inc.*, IPR2018-01260, Paper 12 at 6-7 (Nov. 14, 2018) (granting motion for joinder where petitioner submitted separate but substantially identical expert declaration); *see also Celltrion*, IPR2018-01019, Paper 11 at 14 (same); *Sun Pharm. Indus. Ltd. v. Merck Sharp & Dohme Corp.*, IPR2020-01072, Paper 12 at 7 (Sept. 1, 2020) (same). Therefore, this factor weighs in favor of joinder.

Paper 11 at 9-11 (Oct. 30, 2018); *Pfizer, Inc. v Genentech, Inc.*, IPR2017-02063, Paper 25 at 7-8 (Feb. 21, 2018).

[2] As explained in the Petition, fuboTV 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 IPR2024-00146 and Petitioner is therefore no longer in the understudy role. This would include attendance at deposition to discuss his opinions as set forth in Ex. 1003 or any future declarations in IPR2024-00146. He also confirmed that his opinions have not changed since signing his Ex. 1003 declaration on October 24, 2023.

D. Joinder Will Not Impact the Trial Schedule

Joinder will not unduly burden or negatively impact the trial schedule in any meaningful way because fuboTV does not seek to introduce any new grounds or challenge any new claims. Moreover, fuboTV will not require any discovery beyond what is needed in the Instituted Aylo IPR. Further, because fuboTV relies on the same expert and a substantively identical declaration, only a single deposition is needed for the proposed joined proceeding. Accordingly, this factor also favors joinder.

E. Briefing and Discovery Will Be Simplified

As noted above, joining fuboTV will not require any additional discovery. Nor would joining fuboTV require any additional briefing. fuboTV's Petition adds no new issues whatsoever. Further, fuboTV agrees to take an understudy role, which will simplify briefing and discovery. Aylo's lead counsel will act as the lead counsel so long as Aylo remains in the proceeding. Likewise, 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, so long as Aylo remains in the proceeding. So long as Aylo remains in the proceeding, fuboTV's counsel will be present only to observe and to answer any questions pertaining specifically to fuboTV as the joining party, should any such questions arise.

By fuboTV accepting an understudy role, 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. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6-9 (Oct. 5, 2015) (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where petitioners agreed to an understudy role). fuboTV is further willing to agree to any other reasonable conditions the Board deems necessary. Therefore, this final factor also weighs in favor of joinder.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests institution of IPR proceedings based on its Petition and joinder with the Instituted Aylo IPR.

Respectfully submitted,

Dated: May 13, 2024

By: / Inge A. Osman /

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CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of **Motion for Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)** was served on the official correspondence address for the patent shown in Patent Center:

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