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Subject:	RE: IPR2024-00917, -00918, -00919: Request for Authorization to File Motion for Additional Discovery
Date:	Wednesday, February 12, 2025 2:03:00 PM

[EXTERNAL EMAIL]

Good afternoon counsel.

From the Board –

Patent Owner's request to for authorization to file a motion for additional discovery is denied. Given that the Board has not issued any "final written decision under section 318(a)" with respect to the challenged patents, Patent Owner's concern about estoppel cannot relate to 35 U.S.C. § 315(e)(1). As such, we need not address whether Aylo is "an unnamed RPI because, even if it were, it would not create a time bar or estoppel under 35 U.S.C. § 315." *SharkNinja Operating LLC v. IRobot Corp.*, IPR2020-00734, Paper 11, 18 (PTAB Oct. 6, 2020) (precedential). Further, to the extent Patent Owner's concern about estoppel relates to 35 U.S.C. § 315(e)(2), that sort of estoppel only pertains to later tribunals, not the Board. We also deny Patent Owner's request because Patent Owner's mere allegation of collusion is insufficient to demonstrate that the requested discovery is necessary in the interest of justice. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (PTAB Mar. 5, 2013) (precedential).

Regards,

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

From: Lynn, Jamie <Jamie.Lynn@BakerBotts.com>
Sent: Tuesday, February 11, 2025 6:00 PM
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Subject: IPR2024-00917, -00918, -00919: Request for Authorization to File Motion for Additional Discovery

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IPR2024-00917
IPR2024-00918
IPR2024-00919

Honorable Board,

Patent Owner ("PO") respectfully requests authorization to file a motion for additional discovery under 37 CFR 42.51(b)(2) in each of IPR2024-00917, -00918, and -00919 (the "Fubo IPRs"). In particular, PO requests copies of Dr. Houh's billing records relating to Dr. Houh's work on the above-referenced IPRs.

As background, each relevant IPR is the result of a copy-cat IPR petition filed by fuboTV Media Inc. and Yanka Industries, Inc. (the Fubo petitioners). They are substantively identical to IPR petitions previously filed by Aylo Freesites Ltd f/k/a MG Freesites Ltd ("Aylo") (Aylo's "Leaning IPRs"). Aylo's Leaning IPRs were the second set of IPR petitions filed by Aylo against these same patents. Aylo's first IPR petitions (Aylo's "Ogdon IPRs") had been denied substantively, and consequently Aylo's Leaning IPRs were denied under *General Plastics*. The table below identifies the relevant patent and IPR numbers.

Patent	**Aylo Ogdon IPR (all denied institution)**	**Aylo Leaning IPR (all denied institution under *General Plastics*)**	**Fubo Copycat IPR**
USP 9,407,564	IPR2024-00047	IPR2024-00518	IPR2024-00918
USP 8,868,772	IPR2024-00048	IPR2024-00519	IPR2024-00919
USP 10,757,156	IPR2024-00147	IPR2024-00513	IPR2024-00917

On February 6, 2025, PO's counsel deposed the Fubo petitioners' technical expert witness—Dr. Henry Houh—who had provided an expert declaration in each of the Fubo IPRs. At Aylo and the Fubo petitioners' request, Dr. Houh's deposition for the three Fubo IPRs was combined with the deposition of Dr. Houh related to yet another IPR initiated by Aylo for a separate patent (IPR2024-00940).

At the deposition, Dr. Houh testified that he met jointly with counsel for Aylo and Fubo and then also met individually with counsel for Aylo. Dr. Houh testified that he did not meet individually with counsel for Fubo. Thus, it appears that Aylo is fully involved in prosecuting the Fubo IPRs. Moreover, Dr. Houh could not remember the details regarding how many hours he had billed to Aylo, Fubo, and Yanka respectively since the institution of the Fubo IPRs. Although Dr. Houh testified that he had records that would reflect the details of his billing records, he refused to search for them during the deposition.

PO thus seeks leave to file a motion for additional discovery under 37 CFR 42.51(b)(2) to obtain copies of Dr. Houh's billing records.

These records are relevant to the Fubo IPRs at least because:
1 – It appears that Aylo is attempting to end-run around the Board's denial to institute Aylo's own IPRs under the *General Plastics* factors. The fact that Aylo is taking at least an equal, if not a leading, role in the preparation of the Fubo petitioners' expert witness, strongly suggests that Aylo is attempting to circumvent the Board's prior refusal to institute Aylo's Leaning IPRs.

2 – The billing records of Dr. Houh are directly relevant to whether Aylo should have been identified as a real-party-in-interest (RPI) in the Fubo IPRs. If Dr. Houh is charging Aylo for his preparation work related to the Fubo IPRs, then Aylo should have been disclosed as an RPI. This is particularly important because, if Aylo is found to be an RPI, it may be subject to estoppel under 35 U.S.C. § 315(e).

Petitioners' Portion

Petitioners FuboTV and MasterClass oppose. The *Garmin* factors make clear that Patent Owner is not entitled to the additional discovery it seeks. Indeed, Patent Owner's request is an undisguised effort to relitigate the arguments it made at the institution phase, relying this time on baseless accusations and speculation of a real party in interest relationship between Aylo and FuboTV/MasterClass. There is no such relationship.

Patent Owner has not demonstrated that the requested discovery is in the interest of justice and will lead to useful information, nor has it provided anything more than mere speculation to support its request. Patent Owner complains that Dr. Houh's deposition in IPR2024-00918, -00919, -00917 (the FuboTV/MC IPRs) was combined with his deposition in Aylo's IPR2024-00940 (Aylo's IPR). But Aylo's IPR involves a related patent, overlapping prior art, and Dr. Houh provided similar opinions in his declarations for the FuboTV/MC and Aylo IPRs. Indeed, the Board recognized the overlap between these IPRs, placing each of them on the same schedule. To the extent that FuboTV and MasterClass decided to limit Dr. Houh to only one deposition on these overlapping issues, it reflects the same recognition the Board made of related subject matter and desired efficiency, not an RPI relationship between the parties. Notably, Patent Owner agreed to move forward with one deposition for the four IPRs, presumably hoping to later use the combined deposition against FuboTV and MasterClass.

Next, Patent Owner speculates that Aylo must be "fully involved in prosecuting the Fubo IPRs" because "Dr. Houh testified that he met jointly with counsel for Aylo and Fubo." This assumption is unwarranted, unsupported, and flatly wrong. FuboTV and MasterClass prepared Dr. Houh for his deposition regarding the FuboTV/MC IPRs. Dr. Houh met jointly with the parties due to the overlapping issues, but only counsel for FuboTV and MasterClass prepared Dr. Houh on issues related to the FuboTV/MC IPRs. Indeed, Dr. Houh testified to that effect at his deposition, noting that he recorded more than 4.2 hours of preparation in just one session with FuboTV and MasterClass, separate and apart from any preparation with Aylo. And, to be sure, Dr. Houh had separate counsel defending him for the different IPRs: counsel for FuboTV and MasterClass defended Dr. Houh at his deposition as to issues related the FuboTV/MC IPRs, while Aylo's counsel defended Dr. Houh as to issues related to Aylo's IPR.

Further, Patent Owner has not shown that any useful information will be uncovered by its request. Patent Owner suggests that it is entitled to Dr. Houh's billing records because they are "directly relevant to whether Aylo should have been identified" as an RPI. This circular logic should not be credited. As noted, Aylo is not an RPI to the FuboTV/MC IPRs. But the Board need not address whether Aylo is "an unnamed RPI because, even if it were, it would not create a time bar or estoppel under 35 U.S.C. § 315." *SharkNinja Operating LLC v. IRobot Corp.*, IPR2020-00734, Paper 11, 18 (PTAB Oct. 6, 2020) (precedential). There is no allegation that FuboTV and MasterClass's alleged failure to name Aylo "should result in termination of the proceeding," *id.*, and the Board has no reason to litigate the estoppel issue at this point. Patent Owner's request for an advisory opinion should be rejected.

Finally, Patent Owner had the ability to generate equivalent information by other means. Patent Owner had the opportunity to, and did, cross-examine Dr. Houh about his billing records during his deposition. Indeed, Dr. Houh testified that he billed FuboTV and MasterClass for more than 4.2 hours of preparation the day before his deposition. Further, Dr. Houh also testified that he did not bill Aylo for any work done on the FuboTV/MC IPRs. The Board should reject Patent Owner's attempt at a fishing expedition.

* * * * *

For the foregoing reasons, Patent Owner respectfully requests a conference with the Board to discuss authorization to file a motion under 37 CFR 42.51(b)(2). The parties are available for a conference at the following times:

- Wednesday (2/12/2025) from 2-4 pm Eastern;
- Friday (2/14/2025) from 9:30am-1pm Eastern.

Best regards,
Jamie

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Partner

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