From: Trials
To: Inge.Osman@lw.com; Wilson, Andrew; Trials
Cc: Williams, Eliot D.; Guy, Hop; Steven.Peters@lw.com; Lynn, Jamie; DISHvFubo; Tara.Elliott@lw.com; Rick.Frenkel@lw.com; Rebecca.Rabenstein@lw.com; cnaples@cgsh.com
Subject: RE: IPR2024-00917; -00918; -00919
Date: Thursday, May 1, 2025 3:31:30 PM

[EXTERNAL EMAIL]

Counsel,

Patent Owner's request for authorization is denied. Patent Owner already presented arguments regarding a potential petition to the Director in its briefs opposing a stay. The panel also addressed these arguments in the Order staying the co-pending *ex parte* reexaminations.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Inge.Osman@lw.com <Inge.Osman@lw.com>
Sent: Wednesday, April 30, 2025 8:18 PM
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Subject: RE: IPR2024-00917; -00918; -00919

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Dear Honorable Board,

Patent Owner submitted its position to the Board without giving Petitioners fuboTV Media Inc. and Yanka Industries, Inc. an opportunity to respond.

Petitioners oppose Patent Owner's request to transfer jurisdiction over the Co-pending EPRs. Unhappy with the Board's decision to stay the Co-pending EPRs, Patent Owner is seeking a do-over, asking the Board to transfer jurisdiction so that it can make the same arguments again, this time before the USPTO's Office of Petitions. But the parties already briefed and argued—and the Board

decided—this precise issue. The Board properly found that there is good cause to stay the Co-pending EPRs. *See* IPR2024-00917, Paper 23; IPR2024-00918, Paper 23; IPR2024-00919, Paper 23. As the Board correctly explained, Patent Owner has failed "to explain why a stay would negatively impact[]" its plans to "terminate the *ex parte* reexaminations." *See* IPR2024-00917, Paper 23 at 9; IPR2024-00918, Paper 23 at 9; IPR2024-00919, Paper 23 at 9. It provides no further explanation here. Patent Owner's effort to re-litigate the same issue is a waste of the Board and the USPTO's resources. The Board should deny the request.

Respectfully,

Inge Osman
Counsel for Petitioners

Inge A. Osman

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From: Wilson, Andrew <andrew.wilson@BakerBotts.com>
Sent: Wednesday, April 30, 2025 5:49 PM
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Subject: IPR2024-00917; -00918; -00919

Dear Honorable Board,
Patent Owner DISH Technologies L.L.C., seeks authorization to file a motion in each of the above-captioned proceedings requesting that the Board transfer jurisdiction over the *ex parte* reexaminations having control numbers 90/019,672 ('156 Patent), 90/019,671 ('564 Patent), and 90/019,670 ('772 Patent) (collectively, the "Co-pending EPRs"), which the Board recently stayed, to the USPTO's Office of Petitions ("OPET"), and to authorize DISH to file a petition to terminate those proceedings under *Vivint*. 14 F.4th 1342, 1353 (Fed. Cir. 2021).
The Board has authority to "enter any appropriate order regarding [another matter involving the patent before the office] including providing for the ... transfer ... of any such matter" (37 CFR 42.122(a)), and the USPTO's Office of Petitions ("OPET") is the proper branch for adjudicating DISH's forthcoming petition to terminate proceedings. *See* 37 CFR 1.181; MPEP 1002.02(b)(3);

https://www.uspto.gov/patents/apply/petitions/20-general-supervisory-review-director-uspto-decision-director. In opposing stay of the Co-pending EPRs, DISH explained that a stay would prejudice DISH and reward third-party petitioner and *ex parte* reexamination requester Aylo Freesites Ltd.'s ("Aylo's") abusive petitioning practices because it would "delay DISH's ability to challenge the threshold question of whether the Office improperly granted the EPR in the first instance." *See* IPR2024-00917, Paper 19 at 8; IPR2024-00918, Paper 19 at 8; IPR2024-00919, Paper 19 at 7. Although the Board stayed the EPRs, the Board stated in its order that "it is unclear why Aylo would allegedly benefit from staying proceedings...," and implied that DISH's plan to petition to terminate the Co-pending EPRs would not be "negatively impact[ed]" by a stay. *See* IPR2024-00917, Paper 23 at 9, 11; IPR2024-00918, Paper 23 at 9, 11; IPR2024-00919, Paper 23 at 9, 11. DISH therefore seeks authorization from the Board to pursue its petition to terminate.

Counsel for Patent Owner and Petitioners fuboTV Media Inc. and Yanka Industries, Inc. d/b/a MasterClass have met and conferred, and Petitioner indicated that it opposes DISH's request.

Counsel for the parties are available for a conference call with the Board any time Monday May 5th or between 10:30am and 12:00pm eastern time on Wednesday May 7th.

Respectfully,

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