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Subject:	IPR2024-00940 (and -917, -918, -919) -- Discovery Request
Date:	Tuesday, May 20, 2025 5:14:28 PM
Attachments:	05-15-25 Aylo v. Dish - Peter Ratcliffe - Condensed.pdf

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Dear PTAB Board,

Petitioner Aylo Freesites in IPR2024-00940 and Petitioners FuboTV Media Inc. and Yanka Industries, Inc. in IPR2024-00917, -00918, and -00919 respectfully request a conference to discuss granting Petitioners leave to file a motion to compel discovery under 37 C.F.R. §§ 42.51(b)(1) and (b)(2). Patent Owner DISH opposes. The parties are available for a conference on: Thursday (5/22) 2-4:30 pm ET; Tuesday (5/27) 1:30-3 pm ET; or Thursday (5/29) 12-3 pm ET. The specific relief sought is that Petitioners believe DISH should be required to produce (1) DISH's correspondence with its third-party declarant Peter Ratcliffe related to his investigation, (2) Mr. Ratcliffe's draft declarations, and (3) DISH's correspondence with inventor Anthony Leaning related to the Leaning application/invention.

Petitioner Aylo's Position:

Aylo sincerely apologizes for the length of this email but respectfully submits that the below context is necessary to provide the Board an understanding of the unique circumstances presented and the bases for Aylo's requested relief.

The primary reference relied on by Aylo in the -00940 IPR is a patent application by inventor Anthony Leaning and assigned to British Telecom ("BT"). In support of its POR, DISH submitted a declaration from a third-party declarant, Peter Ratcliffe, who is a lawyer for BT. Mr. Ratcliffe's declaration makes certain statements regarding whether BT ever licensed or commercialized the Leaning application, and DISH and its expert rely on Mr. Ratcliffe's statements to argue non-obviousness. EX2143 (Ratcliffe Decl.) ¶¶ 6-11; Paper 21 at 61; EX2141 (Jeffay Decl.) ¶ 225. Following Mr. Ratcliffe's May 15, 2025 deposition, however, Aylo has serious concerns regarding the propriety of Mr. Ratcliffe's declaration and has good reason to believe DISH is withholding information that is inconsistent with its positions and/or discoverable in the interests of justice. A copy of Mr. Ratcliffe's transcript is attached for the Board's reference.

Mr. Ratcliffe testified *inter alia* that in February he was contacted by DISH's counsel, Baker Botts ("Baker"), seeking information regarding the Leaning application and a specific BT product called Voyager 2000. Ratcliffe Tr. at 11:22-12:19. Mr. Ratcliffe agreed to help Baker apparently without being told the underlying purpose of Baker's request or that he would be deposed in this matter. *Id.*; *see also id.* at 46:19-47:11. Mr. Ratcliffe testified that after a phone call and email

correspondence, Baker drafted his declaration and presented it to him. *Id.* at 28:21-29:4. Mr. Ratcliffe and Baker then exchanged at least four drafts of the declaration, which included various revisions. *Id.* at 28:13-30:2, 35:2-13. These revisions were substantive in nature. For example, Mr. Ratcliffe testified that an earlier version of Baker's draft "included a statement that [BT] hadn't asserted or licensed [the Leaning application], and I had to correct that because I believe we did assert it whilst it was alive." *Id.* at 126:11-127:3.

Furthermore, Mr. Ratcliffe testified that he had additional communications with Baker that included emails "pass[ing] on the information from [his] investigations and before the declaration was drafted," emails discussing his conversations with BT employees that were "part of a chain of communication that led up to the declaration," and emails containing "information of [his] investigation into the request that DISH had sent BT." *Id.* at 48:22-49:11, 35:21-36:11; 41:6-12. Mr. Ratcliffe also testified that he reviewed his correspondence with Baker for purposes of preparing for his deposition. *Id.* at 47:25-49:18. In addition, while Mr. Ratcliffe's declaration makes certain statements regarding whether the Leaning application was ever licensed or commercialized by BT, he testified that Baker instructed him to limit his investigation to a single product—Voyager 2000. *Id.* at 73:16-74:15, 77:25-78:23, 79:7-14. Mr. Ratcliffe did not investigate any other video streaming products by BT, such as Voyager 2100 and Fastnets. *Id.* at 131:6-25, 110:4-7.

Prior to Mr. Ratcliffe's deposition, DISH did not produce any of its correspondence with Mr. Ratcliffe or the drafts of Mr. Ratcliffe's declaration. These documents are relevant, and they are not privileged. Mr. Ratcliffe confirmed multiple times during his deposition that he does not have an attorney-client relationship with Baker, Baker does not represent him or BT, and there is no engagement letter or non-disclosure agreement with Baker. *Id.* at 27:25-28:9, 30:20-31:6, 32:11-13.

Just as concerning to Aylo, Mr. Ratcliffe testified that while investigating the Leaning application, he did not try to contact the named inventor, Anthony Leaning—who is a former BT employee—because "Baker Botts had already spoken with [him]." *Id.* at 89:7-23. In fact, Mr. Ratcliffe testified that Mr. Leaning was the one who told Baker how to contact Mr. Ratcliffe and that Baker may have "accidental[ly]" sent him this correspondence with Mr. Leaning. *Id.* at 89:24-91:18, 93:21-94:10. It is puzzling that DISH is in direct contact with Mr. Leaning, yet it submitted a declaration by Mr. Ratcliffe, who is a lawyer and who relied on conversations with former BT engineers but not Mr. Leaning. *E.g.*, EX2143 ¶ 10. And it also raises questions as to what Mr. Leaning has told DISH about his invention and why DISH has never disclosed or relied on any information it learned from Mr. Leaning to support its positions in this IPR.

In view of the foregoing, Aylo respectfully requests leave to file a motion to compel DISH to produce (1) DISH's correspondence with Mr. Ratcliffe related to his investigation, (2) Mr. Ratcliffe's draft declarations, and (3) DISH's correspondence with Anthony Leaning related to the Leaning application/invention. Aylo's requested relief is supported by 37 C.F.R. §§ 42.51(b)(1) and (b)(2).

Petitioners FuboTV Media Inc. and Yanka Industries, Inc.'s Position:

Petitioners FuboTV Media Inc. and Yanka Industries, Inc. likewise respectfully seek authorization to

file a motion to compel routine discovery pursuant to 37 C.F.R. § 42.51(b)(1) and/or for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2) in the inter partes reviews IPR2024-00917, -00918, and -00919.

In these proceedings, Patent Owner Dish submitted a declaration from Mr. Peter Ratcliffe, a licensing attorney for BT Group. Patent Owner relied on Mr. Ratcliffe's declaration to support its secondary considerations of non-obviousness. IPR2024-00917, POR at 56, 72; IPR2024-00918, POR at 53, 68; and IPR2024-00919, POR at 55, 71. Patent Owner also submitted the same declaration in IPR2024-00940, in which Aylo is the petitioner. Because the patents challenged in IPR2024-00917, -00918, -00919, and -00940 are related, Petitioners and Aylo took a combined deposition of Mr. Ratcliffe.

As Aylo outlined in its request, there is good cause for additional discovery based on certain actions taken by Patent Owner relating to Mr. Ratcliffe's declaration. So as not to burden the Board, Petitioners FuboTV Media Inc. and Yanka Industries, Inc. request that whatever ruling the Board makes regarding Aylo's motion for more discovery also have the same impact in these IPRs.

Patent Owner DISH Technologies L.L.C.'s ("DISH") Position:

The declaration that Mr. Ratcliffe submitted is short—just 12 paragraphs long—and is the result of Mr. Ratcliffe searching for and failing to identify any records showing that BT ever commercialized the video portions of Leaning (Petitioners' primary reference). Now, having taken a 3.5 hour (170 page) deposition that only served to bolster Mr. Ratcliffe's declaration, Petitioners are on a fishing expedition that is quintessentially what the statute and *Garmin* are meant to prevent: full district court litigation. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) ("Garmin").

This request is not dissimilar to DISH's earlier request for the limited production of billing records from Petitioners' technical expert, which was denied. At that time, Petitioners argued that "the *Garmin* factors make clear that Patent Owner is not entitled to the additional discovery it seeks." (*See* email of Feb. 12, 2025, *citing Garmin*). Yet here, Petitioners make no mention of *Garmin* at all and fail to identify what, ***specifically***, they believe will be obtained through discovery that would be "useful" or would be "inconsistent" with positions DISH has taken. Just as the Board did for DISH's request, it should reject Petitioners' request for leave to file a motion to compel.

Garmin

The bar to obtain discovery in a PTAB proceeding is a high one. *See Garmin*. Petitioners have failed to justify either "routine discovery" under 37 C.F.R. § 42.51(b)(1) or "additional discovery" under 37 C.F.R. § 42.51(b)(2).

- **Routine Discovery.** For the discovery to be "routine" under 37 C.F.R. § 42.51(b)(1), the requested discovery must be for "***specific information known to the responding party to be inconsistent*** with a position advanced by that party in the proceeding, and ***not*** broadly directed to any subject area in general within which the requesting party hopes to discover such inconsistent information." *Id*. at 4. Petitioners have pointed to no "specific information"

known to be inconsistent and the requests evidence nothing more than a "hope[] to discover" such an inconsistency.

- **<u>Additional Discovery</u>.** "Additional discovery" under 37 C.F.R. § 42.51(b)(2) is only permitted with satisfaction of the five *Garmin* factors, none of which Petitioners even mention. *Id*. at 6-7. In particular, here the first and third factors are disqualifying.
    - ***Garmin* Factor 1**: "The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The ***party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered***." *Id*. at 6. Here, Petitioners' requests all amount to nothing more than speculation.
    - ***Garmin* Factor 3**: "Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery." *Id*. Petitioners already deposed BT's in-house counsel for 3.5 hours and had an opportunity to obtain a ruling on the need for document discovery during the deposition. Instead, after stopping the deposition purportedly to call the Board on this issue, Petitioner reversed course and chose to waive its opportunity. Regardless, Mr. Radcliffe testified extensively about BT's communications with DISH during cross-examination.

<u>Petitioners' Specific Requests</u>

1. **Communications with Mr. Ratcliffe** - Petitioners request all communications between Mr. Ratcliffe and Baker Botts. As an initial matter, Petitioners attempt to cast aspersions on Baker Botts by wholly mischaracterizing Mr. Ratcliffe's testimony; Mr. Ratcliffe ***did not*** testify that "Baker instructed him to limit his investigation to a single product—Voyager 2000" as Petitioners allege. Rather, Mr. Ratcliffe testified that "it quickly became apparent that the Voyager 2000 system, as they referred to it -- I'd call it a product -- was not something they were interested in; ***they were more interested in a Leaning patent and whether we had commercialized the Leaning patent***." Ratcliffe Tr. at 19:2-14. Voyager 2000, a separate product that Petitioners are not alleging as invalidating prior art, is irrelevant.

   Petitioners also reference two additional products—"Voyager 2100" and "Fastnets"—but fail to state what about these products creates an inconsistency with a position DISH has taken. Nor do Petitioner's allege that there would be a likelihood of obtaining ***any*** information about these products from Mr. Ratcliffe's correspondence with DISH. Indeed, Mr. Ratcliffe testified that he was not aware of either of them. Ratcliffe Tr. 99:16-100:11; 131:6-15.

2. **Draft Copies of Declarations.** Petitioners also request draft copies of Mr. Ratcliffe's declaration on the basis that Mr. Ratcliffe admitted to having revised his declaration multiple

times. But that does not show an inconsistency or impropriety. Quite the opposite, it demonstrates the accuracy of the declaration. In particular, Mr. Ratcliffe testified that he was extremely focused on making sure that his declaration was accurate and doing so "kept [him] up at night" in at least one instance. Ratcliffe Tr. at 159:10-160:5. In that vein, even the example Petitioners give—removing the word "asserted" from a paragraph—was a sentence that Mr. Ratcliffe testified that he himself added and then he himself edited. Ratcliffe Tr. at 158:23-159:8. The unsurprising fact that a declarant edited his declaration for accuracy before submission to the Board does not go "beyond speculation" to show that "something useful will be uncovered." *Garmin* at 4.

3. **Communications with Anthony Leaning.** Finally, Petitioners argue that all communications between Baker Botts and Mr. Leaning must be turned over. But Petitioners do not indicate what specific information they believe will be turned over in response to such a discovery request, nor how any information is inconsistent or would otherwise be useful. And despite Petitioner characterizing DISH's alleged communications with Mr. Leaning as "puzzling" and "rais[ing] questions," Mr. Ratcliffe's testimony on that subject is much more milquetoast:

> Q. It's your understanding that Baker Botts has spoken with Mr. Leaning; is that correct?
> A. I believe so. Yes, I believe that prior to contacting -- ***I think they got BT's legal contact details from Anthony Leaning. That's how they knew who to reach out to in BT***. Hence, they reached out to Jeff Langlands eventually and then Jeff to me.
> Q. What is this understanding based on?
> A. An email correspondence. There was an email correspondence, I think, in one of [Baker Botts attorney] Jamie Lynn's emails in to BT, one of his original emails in to BT which showed a correspondence, I think, between Baker Botts -- I am pretty sure it was Anthony Leaning rather than Richard Whiting, but it was based on that. Email correspondence.
> Q. Do you recall what that email correspondence between Baker Botts and Mr. Leaning said?
> A. No.
> Q. You have no recollection at all?
> A. I know it was to do with the patent, I know it was to do with whether it was commercialized. And I believe that Anthony was saying his recollection of it was that only the audio elements were ever -- were ever commercialized. We are using that phrase repeatedly here, but, yes. In Anthony's vernacular, when he was part of the team, it was only the audio and not the video. But this is just from memory. Roughly, it was that type of correspondence between the two. ***And then they were asking, you know, who to contact, and he was apologizing that he doesn't give more details than the general who to contact in BT details that you get from***

looking at a website.

Ratcliffe Tr. 89:24-91:18. That DISH contacted BT legal with respect to a declaration to confirm that BT had never commercialized the Leaning reference in the video space is not surprising. Had DISH presented a declaration from one of the inventors, certainly Petitioners would be claiming that DISH should have obtained a declaration from BT. And if Petitioners believe that Mr. Leaning will provide them with a useful declaration, nothing is stopping them from contacting him themselves. Indeed, as Mr. Ratcliffe testified "somehow Baker Botts found him so I am sure you can." Ratcliffe Tr. 93:21-94:10.

In short, this is an IPR, not a District Court proceeding. Congress chose to limit discovery in IPRs, and Petitioner cannot show it is entitled to this discovery under the Board's rules. Its request should be denied.

Respectfully,
Ian Paquette (Back-up Counsel for Petitioner Aylo Freesites, Ltd)

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