

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEBGROUP CZECH REPUBLIC, A.S., and
NKL ASSOCIATES, S.R.O.,
Petitioner,

v.

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

IPR2025-00347
Patent 9,407,564 B2

Before THU A. DANG, KARL D. EASTHOM, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

EASTHOM, *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

Webgroup Czech Republic, a.s. and NKL Associates, s.r.o. (collectively “Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 1–16 (the “challenged claims”) of U.S. Patent No. 9,407,564 B2 (Ex. 1001, the “’564 patent”). With the Petition, Petitioner filed a Motion for Joinder (Paper 4, “Motion” or “Mot.”), seeking to join as a party to *fuboTV Media Inc. and Yanka Indus., Inc. v. DISH Techs. L.L.C.*, IPR2024-00918 (the “fuboTV/MasterClass IPR”).¹ Mot. 1. Patent Owner, DISH Technologies L.L.C., did not timely file either an opposition to the Motion or a preliminary response to the Petition.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a) (2024); Paper 8 (referral to panel after no discretionary denial briefing under the Interim Processes memorandum). Under 35 U.S.C. § 314(a), an *inter partes* review may not be authorized unless the information in the Petition and any preliminary 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.”

For the reasons that follow, we institute an *inter partes* review as to the challenged claims of the ’564 patent on all grounds of unpatentability presented. We also *grant* Petitioner’s Motion.

¹ The petitioner (collectively) in the fuboTV/MasterClass IPR is fuboTV Media Inc. (“fuboTV”) and Yanka Industries, Inc. d/b/a MasterClass (“Yanka”). fuboTV/MasterClass IPR, Paper 3 (“fuboTV/MasterClass petition”), 1.

A. Real Party in Interest

Petitioner identifies Webgroup Czech Republic, a.s. and NKL Associates, s.r.o. as the real parties-in-interest. Pet. 1.

Patent Owner submits that “[t]he real parties-in-interest are DISH Technologies L.L.C., . . . Sling TV L.L.C. . . . [and] EchoStar Corporation, which after recently merging with DISH Network Corporation, became the ultimate parent company of DISH Technologies L.L.C. and Sling TV L.L.C.” Paper 5, 2.

B. Related Matters

The parties state that the ’564 patent has been asserted in several district court lawsuits, including *DISH Technologies LLC v. fuboTV Media Inc.*, No. 1:23-cv-00986 (D. Del.); *DISH Technologies LLC v. Yanka Industries, Inc. d/b/a MasterClass*, No. 1:23-cv-01305 (D. Del.); *DISH Technologies LLC v. MG Premium Limited*, No. 2:23-cv-00552 (D. Utah); *DISH Technologies LLC v. WebGroup Czech Republic A.S.*, No. 2:23-cv-00553 (D. Utah); *DISH Technologies LLC v. Vidgo Inc.*, No. 2:23-cv-00624 (D. Utah); *DISH Technologies LLC v. BritBox, LLC*, No. 1:23-cv-08971 (S.D.N.Y.); *DISH Technologies LLC et al. v. Aylo Freesites Ltd. f/k/a MG Freesites Ltd.*, No. 2:24-cv-00066 (D. Utah); and *MG Freesites Ltd. v. DISH Technologies LLC*, No. 3:23-cv-03674 (N.D. Cal., dismissed for lack of personal jurisdiction on January 24, 2024). Pet. 2–3; Paper 5, 2–3.

The ’564 patent has been the subject of the following proceedings before the Board: *Aylo Freesites Ltd. v. DISH Technologies L.L.C.*, IPR2024-00047, Paper 8 (PTAB Apr. 16, 2024) (institution denied); *Aylo Freesites Ltd. v. DISH Technologies L.L.C.*, IPR2024-00518, Paper 12 (PTAB Aug. 13, 2024) (institution denied); and *fuboTV Media Inc. and*

Yanka Industries, Inc. d/b/a MasterClass v. DISH Technologies L.L.C., IPR2024-00918, Paper 14 (PTAB Nov. 21, 2024) (instituted). Pet. 3; Paper 5, 4–5.

The parties also submit that patents related to the '564 patent have been the subject of the following proceedings before the Board: IPR2024-00046 and IPR2024-00516 (challenging U.S. 10,951,680); IPR2024-00147 and IPR2024-00513 (challenging U.S. 10,757,156); IPR2024-00045 and IPR2024-00514 (challenging U.S. 10,469,554); IPR2024-00146 and IPR2024-00515 (challenging U.S. 10,469,555); IPR2024-00048 and IPR2024-00519 (challenging U.S. 8,868,772); IPR2024-00043 and IPR2024-00517 (challenging U.S. 11,677,798); IPR2024-00044 and IPR2024-00512 (challenging U.S. 11,470,138); and IPR2024-00940 and IPR2024-00941 (challenging U.S. 11,991,234); IPR2024-00904 (challenging U.S. 10,951,680); IPR2024-00903 (challenging U.S. 10,469,554); IPR2024-00905 (challenging U.S. 10,469,555); IPR2024-00901 (challenging U.S. 11,677,798); IPR2024-00902 (challenging U.S. 11,470,138); IPR2024-00917 (challenging U.S. 10,757,156); and IPR2024-00919 (challenging U.S. 8,868,772). Pet. 4; Paper 5, 3–5.

Patent Owner also identifies the following reexamination requests for claims of the '564 patent and patents related to the '564 patent: *ex parte* reexamination of U.S. 8,868,772 (filed Sept. 19, 2024), Reexam Control No. 90/019,670 (stayed); *ex parte* reexamination of U.S. 9,407,564 (filed Sept. 19, 2024), Reexam Control No. 90/019,671 (stayed); and *ex parte* reexamination of U.S. 10,757,156 (filed Sept. 20, 2024), Reexam Control No. 90/019,672 (stayed). See Paper 5, 5; fuboTV/MasterClass IPR, Paper 23 (stay order).

C. The '564 Patent (Ex. 1001)

The '564 patent describes adaptive-rate shifting of streaming content. Ex. 1001, code (57), 1:18–21. The '564 patent addresses a purported need to “utilize multiple connections between a source and destination, requesting varying bitrate streams depending upon network conditions.” *Id.* at 2:44–48.

Figure 1 of the '564 patent follows:

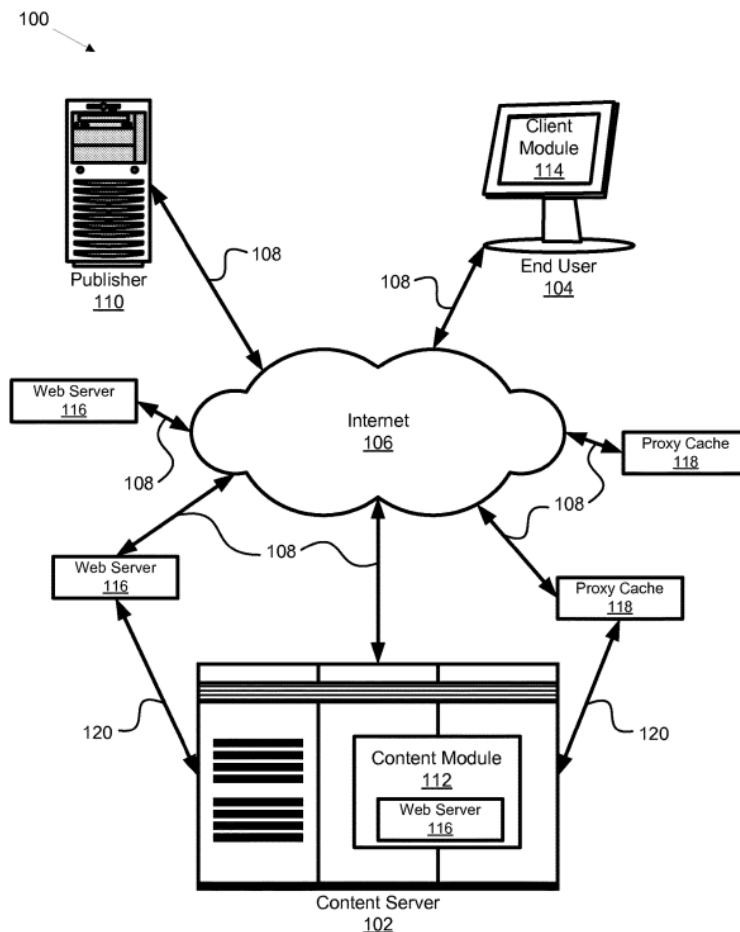


FIG. 1

Figure 1 depicts “system 100 for dynamic rate shifting of streaming content.” Ex. 1001, 6:3–5. System 100 includes content server 102, end user station 104, publisher 110, and web server 116. *Id.* at 6:6–19.

Publisher 110 transfers content over Internet 106 to content server 102. *Id.* at 6:23–25.

Figure 2b of the '564 patent follows:

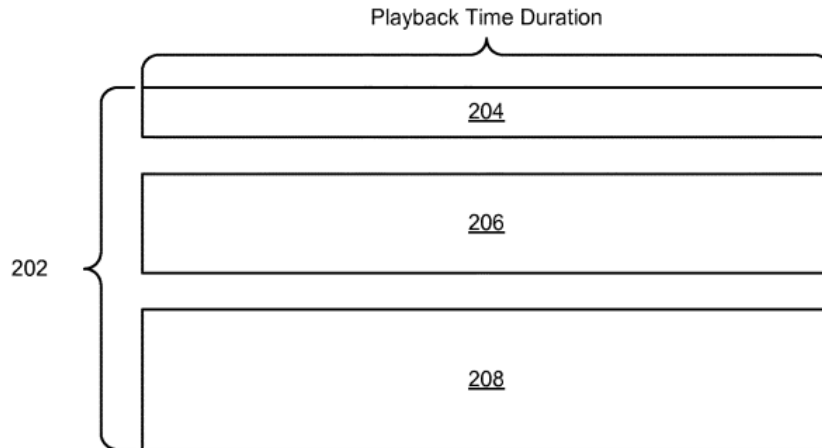


FIG. 2b

Figure 2b depicts “a plurality of streams 202 having varying degrees of quality and bandwidth.” Ex. 1001, 6:46–48. Streams 202 comprise low-quality stream 204, medium-quality stream 206, and high-quality stream 208, and each of streams 204, 206, 208 is a copy of content file 200 encoded and compressed to varying bit rates. *Id.* at 6:48–50.

Figure 2c of the '564 patent follows:

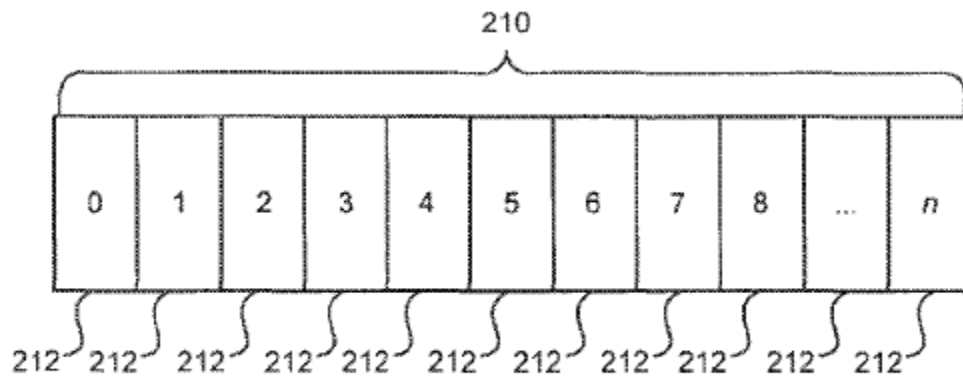


FIG. 2c

Figure 2c depicts “stream 210 divided into a plurality of streamlets 212,” which are “any sized portion[s] of the content file 200.” Ex. 1001, 6:59–61.

D. Challenged Claims

Petitioner challenges claims 1–16 of the ’564 patent. Claims 1 and 8 are independent. Claim 1 is illustrative:

1.[Pre] An end user station for adaptive-rate content streaming of digital content from a video server over a network, the end user station comprising:

[A][1] a media player operating on the end user station [2] configured to stream a video from the video server via at least one transmission control protocol (TCP) connection over the network, [3] wherein multiple different copies of the video encoded at different bit rates are stored on the video server as multiple sets of files, [4] wherein each of the files yields a different portion of the video on playback, [5] wherein the files across the different copies yield the same portions of the video on playback, [6] and wherein each of the files comprises a time index such that the files whose playback is the same portion of the video for each of the different copies have the same time index in relation to the beginning of the video, and wherein the media player streams the video by:

[B] requesting a plurality of sequential files of one of the copies from the video server based on the time indexes;

[C][1] automatically requesting from the video server subsequent portions of the video by requesting for each such portion one of the files from one of the copies dependent upon successive determinations by the media player to shift the playback quality to a higher or lower quality one of the different copies, the automatically requesting including [2] repeatedly generating a factor indicative of the current ability to sustain the streaming of the video using the files from different ones of the copies, wherein the set of one or more factors relate to the performance of the network;

[D] making the successive determinations to shift the playback quality based on the factor to achieve continuous

playback of the video using the files of the highest quality one of the copies determined sustainable at that time so that the media player upshifts to a higher quality one of the different copies when the factor is greater than a first threshold and downshifts to a lower quality one of the different copies when the factor is less than a second threshold; and

[E] presenting the video by playing back the requested media files with the media player on the end user station in order of ascending playback time.

Ex. 1001, 13:20–61 (reference designations by Petitioner); *see* Pet. x–xi.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 6):

Claim(s) Challenged	35 U.S.C.² §	Reference(s)/Basis
1–16	103(a)	Leaning ³
9, 11	103(a)	Leaning, Gamble ⁴

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. The ’564 patent was filed after that date (on October 16, 2014), but claims priority to applications filed as early as April 30, 2004. Ex. 1001, codes (22), (60), (63). Petitioner assumes the earliest possible priority date for purposes of this proceeding (*see* Pet. 9–10). Patent Owner does not address the priority date (Patent Owner has not filed a Preliminary Response). In this Decision, we assume that the pre-AIA version of Section 103 applies; however, our analysis would be the same under the current version of the statute.

³ WO 02/49343 A1, published June 20, 2002 (Ex. 1004).

⁴ US 2004/0093420 A1, filed Nov. 13, 2002, published May 13, 2004 (Ex. 1020).

II. ANALYSIS

A. Institution of Inter Partes Review

The Board instituted an *inter partes* review in the fuboTV/MasterClass IPR on all challenged claims and all asserted grounds of unpatentability. *See* fuboTV/MasterClass IPR, Paper 14 (institution decision). Petitioner here challenges the same claims and asserts the same grounds of unpatentability as those on which the Board instituted the fuboTV/MasterClass IPR. Pet. 6; Mot. 1 (asserting “[t]he Instant Petition is also substantively identical to the fuboTV/MasterClass petition, addressing the same claims, prior art, and grounds for unpatentability that are the subject of the fuboTV/MasterClass IPR”), 5 (asserting “the Instant Petition . . . [is] a copycat of the [f]ubo[]TV/MasterClass petition” as “[t]he Instant Petition and the fuboTV[/MasterClass p]etition” are substantively identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims, using substantially the same evidence and arguments, including the same testimony from the same expert”). As indicated, Petitioner also relies on the same declarant as did the petitioner in the fuboTV/MasterClass IPR. Mot. 5, 7–8, 10; *compare* Ex. 1003 (Declaration of Dr. Henry Houh, Ph.D.), *with* fuboTV/MasterClass IPR, Ex. 1003 (Declaration of Dr. Henry Houh, Ph.D.).

Because the grounds of unpatentability in the instant Petition are identical to those in the fuboTV/MasterClass IPR and for the same reasons stated in institution decision in the fuboTV/MasterClass IPR, we institute *inter partes* review in this proceeding on all the grounds presented in the Petition. *See* fuboTV/MasterClass IPR, Paper 14, 10–25 (analyzing challenges in the fuboTV/MasterClass petition).

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.

To join Petitioner to the instituted fuboTV/MasterClass IPR, the Board first determines whether the Petition “warrants” institution under § 314, which we determined above. *See Facebook, Inc. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). The Board next determines whether to exercise “discretion to decide whether to ‘join as a party’ the joinder applicant,” i.e., Petitioner here. *Id.* Petitioner timely filed its Motion on December 20, 2024, within one month after the institution of the fuboTV/MasterClass IPR on November 21, 2024. *See* Paper 4; fuboTV/MasterClass IPR, Paper 14; 37 C.F.R. § 42.122(b).

As 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; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See 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 (1) is substantially identical to the fuboTV/MasterClass petition, (2) contains the

same grounds based on the same evidence, and (3) relies on the same testimony from the same expert (Dr. Henry Houh, Ex. 1003). Mot. 1, 5–9. Petitioner also represents that joinder will not impact the fuboTV/MasterClass IPR schedule. *See, e.g.*, Mot. 6–7 (“joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical, and Petitioner will accept an ‘understudy’ role. . . . Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding”), 9–10 (“[b]ecause the Instant Petition is substantively identical to the fuboTV/MasterClass [p]etition, with the same grounds applied to the same claims as instituted by the Board, there are no new issues for Patent Owner to address,” and “[j]oinder of this proceeding with the fuboTV/MasterClass IPR would not unduly burden or negatively impact the trial schedule in any meaningful way”).

Additionally, Petitioner represents that it is willing to accept a limited, “‘understudy’ role” to fuboTV and Yanka (the original petitioner in the fuboTV/MasterClass IPR) such that Petitioner “will assume the primary role only if fuboTV and Yanka cease to participate in the [f]uboTV/MasterClass IPR.” Mot. 7, 11.

Specifically, Petitioner represents that in its understudy role, it agrees that the following conditions will apply:

- (a) all filings by [Petitioner] in the joined proceeding [will] be consolidated with [the filings of fuboTV/MasterClass IPR petitioner], unless a filing solely concerns issues that do not involve [fuboTV/MasterClass IPR petitioner]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in [the fuboTV/MasterClass IPR], or introduce any argument or discovery not already introduced by [the fuboTV/MasterClass IPR petitioner]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the

fuboTV/MasterClass IPR petitioner] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [fuboTV/MasterClass IPR petitioner] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the fuboTV/MasterClass IPR petitioner].

Mot. 10–11 (citing IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015)).

Petitioner further represents that the original petitioner in the fuboTV/MasterClass IPR does not oppose Petitioner’s motion to join the fuboTV/MasterClass IPR in an “understudy” role. Mot. 1, 11. As indicated above, Patent Owner did not file an opposition to the Motion. 37 C.F.R. § 42.23 (setting default filing times). Nor did Patent Owner file a preliminary response by the April 14, 2025 deadline.

We determine 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 fuboTV/MasterClass IPR. We limit Petitioner’s participation in the fuboTV/MasterClass IPR as follows: (1) the original petitioner in the fuboTV/MasterClass IPR (fuboTV and Yanka) is responsible for all petitioner filings in the proceeding until such time that it is no longer an entity in the proceeding, and (2) Petitioner is bound by all filings by fuboTV and Yanka in the proceeding, 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 proceeding, so long as fuboTV and Yanka remains as a non-terminated petitioner in the proceeding. This arrangement promotes the just and efficient administration of the ongoing trial in the fuboTV/MasterClass IPR, and protects the interests of fuboTV

and Yanka as original petitioner in IPR2024-00918 and of Patent Owner.

IV. CONCLUSION

For the foregoing reasons, we institute *inter partes* review of the challenged claims of the '564 patent based on the grounds of unpatentability set forth in the Petition. We grant Petitioner's Motion for Joinder and join Petitioner to IPR2024-00918, with the limitations set forth herein.

V. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–16 of the '564 patent on all the 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 is *granted*, and Petitioner is joined as a petitioner in IPR2024-00918, subject to the above-described limitations on Petitioner's participation in that proceeding;

FURTHER ORDERED that the asserted grounds of unpatentability on which the Board instituted *inter partes* review in IPR2024-00918 are unchanged and remain the only instituted grounds;

FURTHER ORDERED that the Scheduling Order in IPR2024-00918, and any modifications thereto, shall govern the schedule of the proceeding;

FURTHER ORDERED that all further filings are to be made in IPR2024-00918;

FURTHER ORDERED that the case caption in IPR2024-00918 for all further submissions shall be modified to add Webgroup Czech Republic, a.s. and NKL Associates, s.r.o., as a named Petitioner, and to indicate by

footnote the joinder of Petitioner 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 IPR2025-00347.

IPR2025-00347
Patent 9,407,564 B2

For PETITIONER:

James Glass
Quincy Lu
Christopher Mathews
Brian Mack
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
jimglass@quinnemanuel.com
quincylu@quinnemanuel.com
chrismathews@quinnemanuel.com
brianmack@quinnemanuel.com

For PATENT OWNER:

Eliot Williams
George Guy
Ali Dhanani
Thomas Carter
Andrew Wilson
Jamie Lynn
BAKER BOTTS L.L.P.
eliot.williams@bakerbotts.com
hop.guy@bakerbotts.com
ali.dhanani@bakerbotts.com
thomas.carter@bakerbotts.com
andrew.wilson@bakerbotts.com
jamie.lynn@bakerbotts.com

Sample Case Caption

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUBOTV MEDIA INC., YANKA INDUSTRIES, INC., WEBGROUP
CZECH REPUBLIC, A.S., and NKL ASSOCIATES, S.R.O.,⁵
Petitioner,

v.

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

IPR2024-00918
Patent 9,407,564 B2

⁵ Webgroup Czech Republic, a.s. and NKL Associates, s.r.o. filed a petition in IPR2025-00347 and have been joined as parties to this proceeding.