Trials@uspto.gov
571-272-7822

Paper 43
Entered: June 3, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUBOTV MEDIA INC. and YANKA INDUSTRIES, INC.,
Petitioner,
v.
DISH TECHNOLOGIES L.L.C.,
Patent Owner.

IPR2024-00917 (Patent 10,757,156 B2)
IPR2024-00918 (Patent 9,407,564 B2)
IPR2024-00919 (Patent 8,868,772 B2)

AYLO FREESITES LTD,
Petitioner,
v.
DISH TECHNOLOGIES L.L.C.,
Patent Owner.

IPR2024-00940 (Patent 11,991,234 B2)[1]

[1] This Order addresses the same issue for the above-identified proceedings. Therefore, we exercise our discretion to issue one order to be filed in each proceeding. The parties are not authorized to use this caption style in any subsequent papers.

Before THU A. DANG, KARL D. EASTHOM,
MICHELLE N. WORMMEESTER, and JOHN A. HUDALLA,
Administrative Patent Judges.[2]

HUDALLA, *Administrative Patent Judge*.

ORDER
Denying Petitioners' Request for Authorization
to File Motions for Additional Discovery
37 C.F.R. § 42.51

On May 20, 2025, Aylo Freesites Ltd ("Aylo")[3] and FuboTV Media Inc. and Yanka Industries, Inc. (collectively, "FuboTV")[4] jointly sent an email to the Board seeking "leave to file a motion to compel discovery under 37 C.F.R. §§ 42.51(b)(1) and (b)(2)." *See* Ex. 3003[5] (email correspondence). The panels held a conference call with the parties on May 29, 2025, to discuss Aylo's and FuboTV's request. A transcript of the call is included in the record at Exhibit 1021. Although Aylo's and FuboTV's request cites our rule for routine discovery, we consider this

[2] This is not an expanded panel decision. Judges Dang, Wormmeester, and Hudalla are the panel in IPR2024-00917 and IPR2024-00940. Judges Dang, Easthom, and Hudalla are the panel in IPR2024-00918 and IPR2024-00919.
[3] Aylo is the petitioner in IPR2024-00940.
[4] FuboTV is the petitioner in IPR2024-00917, IPR2024-00918, and IPR2024-00919
[5] We cite to papers and exhibits in IPR2024-00940. Similar documents were filed in IPR2024-00917, IPR2024-00918, and IPR2024-00919.

request to be a request for authorization to file motions for additional discovery under 37 C.F.R. § 42.51(b)(2).

The instant request for additional discovery relates to Patent Owner's argument that British Telecom (BT), the owner of the asserted prior art reference known as "Leaning,"[6] never commercialized the video teachings disclosed in Leaning. *See* Paper 20, 61. According to Patent Owner, this may be "the most direct and probative indicium of non-obviousness" of the challenged patents. *Id.* Patent Owner supports its argument with a declaration of Peter Ratcliffe, an attorney with BT. *See* Ex. 2126. In response to Patent Owner's argument, Aylo and FuboTV request authorization to seek the following discovery from Patent Owner: (1) Patent Owner's correspondence with Mr. Ratcliffe related to his investigation of the alleged lack of commercialization; (2) Mr. Ratcliffe's draft declarations; and (3) Patent Owner's correspondence with inventor Anthony Leaning related to the Leaning application/invention. Ex. 3003.

Importantly, Aylo and FuboTV have already taken a 3½-hour deposition of Mr. Ratcliffe. The deposition is where Aylo and FuboTV learned of the existence of the draft declarations, and Aylo and FuboTV have already had an opportunity to question Mr. Ratcliffe about any changes made among the drafts. Aylo and FuboTV also probed the steps Mr. Ratcliffe took as part of his investigation into the commercialization of Leaning. In our view, this shows that Aylo and FuboTV have had an

[6] International Patent Publication No. WO 02/49343 A1, filed Dec. 14, 2001, published June 20, 2002 (Ex. 1004, "Leaning")

opportunity to generate information related to Patent Owner's correspondence with Mr. Ratcliffe regarding his investigation and his draft declarations. This militates strongly against the need for additional discovery. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, at 6–7 (PTAB Mar. 5, 2013) (precedential) (noting that "Ability to Generate Equivalent Information by Other Means" is an important factor for determining whether additional discovery is necessary in the interests of justice).

Regarding Patent Owner's correspondence with Mr. Leaning, Patent Owner represented during the call that it has not had substantive discussions with Mr. Leaning. Indeed, Mr. Leaning appears to have responded to Patent Owner's contacts by referring Patent Owner to Mr. Ratcliffe. Given the non-substantive nature of Patent Owner's contacts with Mr. Leaning, we find it highly unlikely that something useful would be discovered in Patent Owner's correspondence. This also would not meet our "interest of justice" standard for obtaining additional discovery. *See Garmin*, Paper 26, at 6 (stating that "[t]he 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"). Furthermore, Aylo and FuboTV could independently seek discovery from Mr. Leaning, though both parties apparently could not locate contact information for Mr. Leaning. Patent Owner shall share Mr. Leaning's publicly available contact information with Aylo and FuboTV for that purpose. In this way, Aylo and FuboTV could generate

equivalent—and potentially better—information by means other than Patent Owner's correspondence. *See id.*

We additionally note that, during the call, Aylo and FuboTV previewed other ways of attacking Patent Owner's underlying objective indicium argument irrespective of the requested discovery. These include, for example, proving that BT did in fact commercialize the video teachings of Leaning with a system known as "Fastnets." Aylo indicated that it already possessed relevant information about Fastnets. The availability of other countervailing evidence to attack Patent Owner's underlying theory also weighs against additional discovery.

For these reasons, we deny Aylo's and FuboTV's joint request for authorization to file motions for additional discovery.

ORDER

In consideration of the foregoing, it is hereby

ORDERED that Aylo's and FuboTV's joint request for authorization to file motions for additional discovery is *denied*; and

FURTHER ORDERED that Patent Owner shall share Anthony Leaning's publicly available contact information with Aylo and FuboTV.

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For PETITIONER:

Frank Gasparo
Ian Paquette
VENABLE LLP
fmgasparo@venable.com
igpaquette@venable.com

PATENT OWNER:

Eliot Williams
Ali Dhanani
George Guy
Thomas Carter
BAKER BOTTS L.L.P.
eliot.williams@bakerbotts.com
ali.dhanani@bakerbotts.com
hop.guy@bakerbotts.com
thomas.carter@bakerbotts.com