

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner

v.

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

IPR2024-00940
U.S. Patent No. 11,991,234

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION
TO DISMISS PETITION UNDER 35 U.S.C. § 312(a)(2)**

TABLE OF CONTENTS

I.	9219-1568 QUEBEC INC. IS NOT AN UNNAMED RPI.....	1
A.	DISH Confuses the Law of RPI with That of Privity	1
B.	No Corporate Blurring or Relation of 9219 to this Proceeding	2
C.	9219 as a Post-Petition District Court Co-Defendant does not Establish RPI Status	4
D.	Whether 9219 is an RPI in a Different IPR Involving a Different Patent and Patent Owner is Irrelevant to this Proceeding	5
II.	DISH’S MOTION IS UNTIMELY	5
III.	<i>CORNING</i> DID NOT OVERRULE <i>LUMENTUM</i> OR <i>PROPPANT</i>	6

PETITIONER’S EXHIBIT LIST

Updated Exhibit List for U.S. Pat. 11,991,234 Petition for *Inter Partes* Review

Exhibit Number	Description
1001	U.S. Pat. 11,991,234 (“the ’234 Patent”)
1002	File History of the ’234 Patent
1003	Declaration of Dr. Henry Houh including Curriculum Vitae (“Houh declaration”)
1004	International P.C.T. Publication WO 2002049343 to Leaning et al. (“Leaning”)
1005	<RESERVED>
1006	U.S. Patent Publication No. 2003/0236906 to Klements (“Klements”)
1007	U.S. Patent No. 6,848,004 to Chang (“Chang”)
1008	WO1997044942 to Kliger (“Kliger”)
1009	337-TA-1265 ITC Investigation Initial Determination
1010	337-TA-1265 ITC September 11, 2023 Enforcement Complaint
1011	Internet Archive Affidavit for URLs including EX1019
1012	Gourley, David, and Brian Totty. HTTP: the definitive guide. O’Reilly Media, Inc., 2002 (“Gourley”). available at https://archive.org/details/httpdefinitivegu00gour/page/n1/mode/2up .
1013	Patent Owner Preliminary Response in IPR2024-00514
1014	DISH May 7, 2024 letter in support of its motion for leave to file first amended complaint in <i>DISH Technologies L.L.C. et. Al. v. fuboTV Media Inc.</i> , 1:23-cv-00986-GBW (D. Del.)
1015	Excerpted transcript from March 27, 2024 hearing at United Kingdom High Court of Justice in <i>DISH Technologies, L.L.C. et al. v. Aylo Premium Ltd et al.</i> , Claim No. HP-2023-000043
1016	File History of U.S. Pat. No. 11,470,138 (“’138 Patent”)
1017	Petition for IPR in IPR2024-00512
1018	File History of U.S. Pat. No. 8,868,772
1019	HTTP 1.1 Protocol - RCF2616 (https://web.archive.org/web/20020802040147/https://www.ietf.org/rfc/rfc2616.txt)
1020	U.S. Patent Publication No. 2004/0093420 to Gamble (“Gamble”)

1021	Transcript of Conference Call with the Board regarding Petitioners' request for discovery in IPR2024-00940 and in -917, -918, -919 on May 29, 2025
1022	Supplemental Declaration of Dr. Henry Houh
1023	Deposition Transcript of Dr. Kevin Jeffay, May 8, 2025
1024	EPO Preliminary opinion for Opposition against EP 3 822 805 March 26, 2025
1025	Deposition Transcript of Drew Major, May 14, 2025
1026	Deposition Transcript of Mark Mitchell, May 30, 2025
1027	Deposition Transcript of David Ericson, May 9, 2025
1028	Deposition Transcript of Drew Major, Ogdon IPRs, September 17, 2024
1029	Excerpted infringement chart appended to complaint from DISH Technologies L.L.C. and Sling TV L.L.C. v. Aylo Freesites Ltd and 9219-1568 Quebec Inc. Case No. 2:24-cv-00066
1030	IPR2024-00046 Ogdon IPR Final Written Decision
1031	IPR2024-00046 Ogdon IPR Patent Owner Response
1032	US 6,389,473 ("Carmel")
1033	US 6,175,862 ("Chen/Feig")
1034	US 2002/0143973A1 ("Price")
1035	Willebeek-LeMair -- Bamba - Audio and Video Streaming over the Internet
1036	Dr. Jeffay Declaration from IPR2022-01430
1037	Deposition Transcript of Peter Ratcliffe, May 15, 2025
1038	Ratcliffe Exhibit 1 – Innovative Research BT Research & Venturing IPR Overview: Issue 1.7 (23 rd February 2007)
1039	Petitioner's Demonstratives
1040	Timeline of Relevant Events
1041	Affidavit of Service from Utah Case 2:24-cv-00066
1042	D.I. 19-6 Exhibit RR from Utah Case 2:23-cv-00552

DISH's motion (Paper 68, "Motion") should be denied. **First**, 9219-1568 Québec Inc. ("9219") is not a Real Party in Interest ("RPI") under 35 U.S.C. § 312(a)(2). DISH confuses the law of RPI with that of privity, cites no evidence that 9219 is an RPI in this proceeding, and cannot overcome Federal Circuit law holding that § 312(a)(2) is not jurisdictional. **Second**, DISH's motion is untimely. DISH waited nearly 18 months—just three weeks before the final written decision was due and after 9219 was time-barred under § 315(b)—to raise its alleged RPI issues, despite long knowing the facts it relies on now. DISH's gamesmanship should not be condoned.

I. 9219-1568 QUEBEC INC. IS NOT AN UNNAMED RPI

9219 was not served a district-court complaint asserting the '234 Patent when the Petition was filed, and 9219 did not fund or control this IPR. Nonetheless, DISH makes three arguments that 9219 is an RPI: (1) 9219 and Petitioner have a "pre-existing, established relationship" since 9219 provides business services to Petitioner; (2) 9219 is currently a co-defendant with Petitioner in a district-court lawsuit asserting the '234 Patent; and (3) Petitioner named 9219 as an RPI in a different IPR between different parties relating to a different patent. These arguments bear no relation to *this proceeding* and all fail.

A. DISH Confuses the Law of RPI with That of Privity

As a preliminary matter, DISH conflates RPIs with privies, which infects its entire argument. Specifically, § 312(a)(2) requires identification of all RPIs, but not

privies. *Cirrus Logic Inc. v. Omnivision Technologies, Inc.*, IPR2024-00017, Paper 115 at 15 (PTAB Oct. 30, 2025). An RPI under § 312(a)(2) is different from a “privity of the petitioner” under 35 U.S.C. § 315(b). *See Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 n.9 (Fed. Cir. 2018). “The notion of ‘privity’ is more expansive, encompassing parties that do not necessarily need to be identified in the petition as a ‘real party-in-interest.’” Trial Practice Guide, 14. “RPI is the relationship between a party and a *proceeding*; RPI does not describe the relationship between *parties*.” *Aruze Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 13 at 11 (PTAB Feb. 20, 2015) (emphasis in original). With respect to RPIs, “Section 312(a)(2) is akin to a pleading requirement that can be corrected, and . . . ‘the Director [of the PTO] can, and does, allow the petitioner to add a real party in interest.’” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1364 (Fed. Cir. 2018) (quoting *Wi-Fi One*, 878 F.3d at 1374 n.9) (alteration in original).

B. No Corporate Blurring or Relation of 9219 to this Proceeding

Consistent with the above, that 9219 and Petitioner have a “pre-existing, established relationship” or that 9219 provides business services to Petitioner does not render 9219 an RPI in *this proceeding*. *Contra* Motion, 3-5. Such points “relate to relationships among the parties, rather than any specific relationship between [9219] and this proceeding. These facts go to the issue of privity, *which should not be conflated with the real parties in interest inquiry*.” *Donner Technology, LLC v.*

Pro Stage Gear, LLC, IPR2018-00708, Paper 38 at 7 (PTAB May 3, 2019) (citing *Wi-Fi One*, 878 F.3d at 1374 n.9) (emphasis added); *see also First Quality Baby Products, LLC v. Kimberly-Clark Worldwide, Inc.*, IPR2014-01021, Paper 42 at 9 (PTAB July 16, 2015) (general sharing of business resources, cooperation in business, and overlapping managers “falls short of indicating” RPIs).

Corning does not hold otherwise. *Corning* did not rely solely on corporate blurring but also on the fact that the unnamed entity actually “**funded these IPR proceedings**,” and also exercised or could have exercised **control** over Petitioner’s participation in **these proceedings**.” *Corning Optical Commc’ns RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 at 16 (PTAB Aug. 18, 2015) (emphasis added). Indeed, “*Corning Optical* does not stand for the proposition that an unnamed entity that is ‘intertwined with’ a named petitioner is necessarily an RPI. Rather, we must substantively evaluate the relationship of the unnamed entity to *these proceedings*.” *Geotab Inc. v. Perdiemco LLC*, IPR2016-01061, Paper 21 at 11 (PTAB Dec. 9, 2016) (emphasis in original).

All DISH has asserted here is that 9219 and Petitioner have two overlapping directors and that 9219 provides business services to Petitioner. Motion, 3-5. That is plainly not enough to show RPI status in this (or any) IPR. In fact, DISH’s own cited evidence shows that Petitioner and 9219 are “organized and exist separately under the laws of” Cyprus and Canada, respectively. EX2159, 2-3. Each is “separate from

the other[] and has its own bank accounts.” *Id.*, 3. And each “observe[] all necessary corporate formalities.” *Id.*, 5, 8. Thus, DISH’s own evidence shows that 9219 is not an unnamed RPI in this proceeding.

C. 9219 as a Post-Petition District Court Co-Defendant does not Establish RPI Status

DISH’s argument that 9219 is an RPI simply because it was served a complaint asserting the ’234 Patent—*after* the Petition was filed—fails. Motion, 5. “[S]tatus as co-defendants suggests, at most, that [the unnamed party] might be in privity with the named real parties in interest.” *Donner* at 10. Further, “because Patent Owner’s Motion is premised on a defect in the Petition[], the relevant time frame for analyzing the real parties-in-interest for the purposes of this Motion is the time when the Petition[] [was] filed.” *FPUSA, LLC v. M-I LLC*, IPR2016-00213, Paper 45 at 3 (PTAB Mar. 20, 2017). The Petition was filed on May 21, 2024—the same day the ’234 Patent issued, and the same day DISH filed an amended complaint in district court asserting the ’234 Patent. However, DISH failed to serve 9219 until nine days later on May 30, 2024. *See* EX1040 (Timeline); EX1041. While DISH complains that 9219 refused to waive service, the refusal concerned the *original* complaint, which did not assert the ’234 Patent and is completely irrelevant to this proceeding. The ’234 Patent did not exist when DISH asked 9219 to waive service in January 2024 (EX2155, 3-4) and DISH never asked Aylo to waive service with respect to a complaint asserting the ’234 Patent. *See* EX1041 (alternate service).

D. Whether 9219 is an RPI in a Different IPR Involving a Different Patent and Patent Owner is Irrelevant to this Proceeding

DISH's argument that 9219 is an RPI simply because Petitioner listed 9219 as an RPI in a different IPR involving a different patent and patent owner lacks merit. *See* Motion, 5-6. DISH fails to cite any case to support its theory. The law is clear: DISH must show evidence tied to **this** proceeding. *E.g., Mobile Tech, Inc. v. Sennco Solutions, Inc.*, IPR2017-02199, Paper 9 at 9-10 (PTAB Apr. 10, 2018). Indeed, "Patent Owner's allegation that Petitioner has identified other entities as real parties in interest in other unrelated proceedings is insufficient to establish that those entities are real parties in interest in the present proceeding." *Id.*

II. DISH'S MOTION IS UNTIMELY

As a separate basis for denial, DISH's motion is untimely. The Board's order specifically asked DISH to "address the timing of Patent Owner's request and whether Patent Owner could have or should have sought its requested relief earlier." Paper 65, 2. DISH failed to respond, and its failure is glaring. DISH simply has no explanation for not raising its RPI challenge earlier at any point in this proceeding.

DISH was aware of 9219, its corporate structure, and its board members since at least September 2023 when it attached the **same** declaration it relies on here (EX2159) to a motion in district court against entities related to Petitioner. EX1040; EX1042. Yet DISH waited until three weeks before final written decision to raise its RPI challenge. EX1040. The Board has deemed such late RPI challenges waived.

For example, in *Apple v. MemoryWeb, LLC*, Patent Owner raised an RPI issue for the first time post-POR, and the Board found that “Patent Owner has forfeited and/or waived any right it may have to raise the RPI issue.” IPR2022-00031, Paper 85 at 20, 31; *see also id.* at 21-22 (collecting cases). So too should DISH’s Motion be denied as untimely and waived.

III. CORNING DID NOT OVERRULE LUMENTUM OR PROPPANT

DISH is wrong that *Corning* and *Proppant* “cannot be reconciled.” Motion, 6-7. The Director de-designated *SharkNinja* and designated *Corning* as precedential “to restor[e] the Office’s pre-*SharkNinja* practice of requiring petitioners to identify the [RPIs] to their petitions *before institution*.” EX2152, 1 (emphasis added). In other words, the Director can deny institution based solely on the failure to name all RPIs—particularly for national security concerns not at issue here. *Id.*, 2-4. But this IPR is already *post-institution*, such that *Lumentum* and *Proppant* govern, as the Federal Circuit has confirmed. Under *Lumentum*, the Board does not lose jurisdiction when there are defects under § 312(a)(2). *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 at 5 (PTAB Mar. 4, 2016) (precedential); *AIT*, 897 F.3d at 1364; *Wi-Fi One*, 878 F.3d at 1374 n.9. And under *Proppant*, a Petitioner can update its mandatory notices post-institution to add an RPI while maintaining the original filing date, even without conceding that the named entity is in fact an RPI, as long as there is no circumvention of the § 315(b)

time bar, bad faith, gamesmanship, or prejudice to Patent Owner. *Proppant Express Investments, LLC v. Oren Techs., LLC*, IPR2017-01917, Paper 86 at 6-7 (PTAB Feb. 13, 2019) (precedential). Notably, both *Lumentum* and *Proppant* were decided after *Corning*, both were designated precedential before *SharkNinja*, and both remain precedential. Thus, designating *Corning* precedential “to restor[e] the Office’s pre-*SharkNinja* practice[s]” (EX2152, 1) did not overrule *Lumentum* or *Proppant*.

In sum, even if the Board finds that 9219 should be listed as an RPI, Petitioner should be permitted to update its mandatory notices to identify 9219 since there is no evidence, or even assertion, of circumvention of the § 315(b) time bar, bad faith, gamesmanship, or prejudice to DISH. Otherwise, “to grant Patent Owner’s motion under these circumstances would create incentives encouraging Patent Owners to reserve arguments relating to RPIs that could be brought early in the proceeding until after all the merits in the underlying review have been briefed and argued.” *Sony Computer Entertainment America LLC v. Game Controller Technology LLC*, IPR2013-00634, Paper 31 at 3-4 (PTAB Apr. 2, 2015). And it would result in severe prejudice to Petitioner.

As Petitioner indicated in its email to the Board (EX3005, 2), to the extent the Board deems it necessary to list 9219 as an RPI, Petitioner seeks permission to update its mandatory notices accordingly while maintaining the Petition’s filing date.

DATED: November 24, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 24, 2025, I caused a true and correct copy of the foregoing Petitioner's Opposition to Patent Owner's Motion to Dismiss Petition under 35 U.S.C. § 312(a)(2) to be served via email to counsel of record:

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