

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
Patent 11,991,234 B2

Before THU A. DANG, MICHELLE N. WORMMEESTER, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motion to Dismiss Petition
Authorizing Petitioner to File Updated Mandatory Notices
35 U.S.C. § 312(a)(2); 37 C.F.R. § 42.72

With our authorization (Paper 65), Patent Owner filed a motion to dismiss the Petition due to Patent Owner's alleged failure to name all real parties-in-interest (RPIs). Paper 68 ("Mot."). Petitioner filed an opposition (Paper 69, "Opp."), and Patent Owner filed a reply in support of the motion (Paper 70, "Reply"). Patent Owner's motion alleges that Petitioner failed to

name 9219-1568 Québec Inc. (“9219”) as an RPI. Mot. 1. In addition to opposing Patent Owner’s motion, Petitioner puts forth an alternative position in which it seeks authorization to update its mandatory notices to list 9219 as an RPI if we were to deem it necessary. Opp. 7.

For the reasons that follow, we *deny* Patent Owner’s motion to dismiss the Petition. We authorize Petitioner to file updated mandatory notices naming 9219 as an RPI.

A. Background

Patent Owner’s motion was precipitated by the Director’s de-designation of *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 (PTAB Oct. 6, 2020), as precedential, and the Director’s October 28, 2025, memorandum (“Director memo,” Ex. 2152) re-designating *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (“*Corning Optical*”), as precedential (except for § II.E.1). The Director memo clarified that petitioners must satisfy the RPI identification requirement before the Director can institute trial. Ex. 2152, 1. The Director also noted that “[t]he integrity of PTAB proceedings depends on knowing who is behind a petition—who funds it, directs it, and/or benefits from it.” *Id.* at 4. Notably, the Director’s actions did not affect other precedential decisions of the Board regarding the identification of RPIs, including *Proppant Express Investments, LLC v. Oren Technologies, LLC*, IPR2017-01917, Paper 86 (PTAB Feb. 13, 2019) (precedential) (“*Proppant*”), and *Lumentum Holdings, Inc. v. Capella Photonics, Inc.*,

IPR2015-00739, Paper 38 (PTAB Mar. 4, 2016) (precedential)
 (“*Lumentum*”).

In general, a petition for *inter partes* review “may be considered *only if* . . . the petition identifies *all* real parties in interest.” 35 U.S.C.

§ 312(a)(2) (emphasis added). The identification of all real parties-in-interest assists the Board in ascertaining potential conflicts of interest, helps identify any potential estoppel issues with respect to 35 U.S.C. § 315(e)(1), and may affect the credibility of evidence presented in a proceeding. *See* Rules of Practice for Trials before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,617 (Aug. 14, 2012). Identification of all real parties-in-interest also enables the Board to determine whether *inter partes* review may be barred under 35 U.S.C. §§ 315(a)(1) or 315(b). “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, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1374 n.9) (alteration in original); *see also Lumentum*, Paper 38 at 5 (“Simply stated, § 312(a) sets forth requirements that must be satisfied for the Board to give consideration to a petition, however, a lapse in compliance with those requirements does not deprive the Board of jurisdiction over the proceeding or preclude the Board from permitting such lapse to be rectified.”).

“[A]n IPR petitioner’s initial identification of the real parties in interest should be accepted unless and until disputed by a patent owner.” *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018). Where,

as here, a patent owner disputes the identification of real parties-in-interest, then the “patent owner must produce some evidence to support its argument that a particular third party should be named a real party in interest.” *Id.*

“Determining whether a non-party is a ‘real party in interest’ demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *RPX*, 897 F.3d at 1351; *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 13 (Nov. 2019) (“Consolidated Trial Practice Guide”), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (stating that the real party in interest inquiry is a “highly fact-dependent question” that takes into account how courts generally have used the term to “describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion”). We must probe the extent to which each non-party has an interest in and will benefit from Petitioner’s actions, and inquire whether Petitioner can be said to be representing that interest after examining the non-party’s relationship with Petitioner. *See RPX*, 897 F.3d at 1353; *see also* Consolidated Trial Practice Guide at 14 (stating that a real party in interest is “the party that desires review of the patent” and “may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed”). One potentially relevant factor is whether the non-party is funding or directing the proceeding. Consolidated Trial Practice Guide at 17. For example, “a party that funds and directs and controls an IPR . . . petition or proceeding constitutes a ‘real party-in-interest,’ even if that party is not a ‘privy’ of the petitioner.” *Id.* Complete

funding or control is not required for a non-party to be considered a real party in interest, however; the exact degree of funding or control “requires consideration of the pertinent facts.” *Id.*

The issue of whether an entity is real party in interest under 35 U.S.C. § 312(a)(2) is different from the issue of whether an entity is a “privy of the petitioner” under 35 U.S.C. § 315(b). *See Wi-Fi One*, 878 F.3d at 1374 n.9. “The notion of ‘privy’ 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, 77 Fed. Reg. at 48,759. In other words, the real party in interest inquiry focuses on “the relationship between a party and a *proceeding*,” whereas the privy inquiry focus on “the relationship between *parties*.” *Aruze Gaming Macau, Ltd. v. MGT Gaming, Inc.*, Case IPR2014-01288, slip op. at 11, 13 (PTAB Feb. 20, 2015) (Paper 13) (citing *Int’l Nutrition Co. v. Horphag Research, Ltd.*, 220 F.3d 1325, 1329 (Fed. Cir. 2000)).

B. Whether 9219 is an Unnamed RPI

Patent Owner adduces evidence that Petitioner named 9219 as an RPI in another *inter partes* review, *Aylo Freesites Ltd v. WellcomeMat, LLC*, IPR2024-00710, Paper 2, at 13 (filed Mar. 29, 2024) (“WellcomeMat”). Ex. 2153, 13.¹ Like the challenged patent in the instant case, the challenged patent in *WellcomeMat* pertains to online video. *Id.* at 18; *see also* Reply, 2 (noting that the two cases involve “nearly identical technology”). 9219 also is a named defendant in the parallel district court action that shares the same

¹ We follow Patent Owner’s convention of referencing the page numbers added to the footer of Exhibit 2153.

counsel with Petitioner here. *See, e.g.*, Ex. 2160. Patent Owner additionally establishes that the two entities share at least two common directors who hold executive roles with binding authority as to each entity. Ex. 2158, 66–67; Ex. 2159 ¶¶ 1–2.² Patent Owner also puts forth testimony in another proceeding from one of those directors, Andreas Andreou, as to the close relationship between Petitioner and 9219. He stated that “[Aylo] Freesites Ltd is responsible for operating Pornhub. That entity . . . relies upon the services of other entities, including . . . 9219-1568 Quebec Inc.” Ex. 2159, 4.

In its Opposition, Petitioner argues that Patent Owner improperly conflates privies with RPIs. Opp. 1–3. Petitioner suggests that naming 9219 as an RPI in *WellcomeMat* does not impact the instant case because Patent Owner has not established a tie between 9219 and this proceeding. *Id.* at 2–3, 5. Petitioner also argues that overlapping directors and 9219’s provision of business services to Petitioner is not enough to establish 9219 as an RPI. *Id.* at 3. Petitioner notes that Petitioner and 9219 are separate business entities with separate bank accounts that observe corporate formalities in different jurisdictions. *Id.* at 3–4. Petitioner also notes that 9219’s status as a co-defendant in the parallel litigation should not lead to dismissal here because 9219 was not served until after the Petition in this case was filed. *Id.* at 4.

² Certain evidence put forth by Patent Owner pertains to an entity known as “MG Freesites Ltd.” MG Freesites Ltd. appears to be the former name of Petitioner by Petitioner’s own admission. Ex. 2153, 13. Thus, we treat the two named entities as one and the same for purposes of this Order.

We find that Patent Owner has put forth sufficient evidence to show that 9219 should be identified as an RPI in this proceeding. Importantly, Petitioner previously identified 9219 as an RPI in an *inter partes* review pertaining to similar technology, and Petitioner provides no facts or evidence to show why the instant case should be treated differently. Moreover, the mere possibility that a petitioner might have occasion to name different RPIs across different cases does not change the calculus here.

Patent Owner also has adduced evidence of common controlling directors and Petitioner's reliance upon 9219 for the provision of business services to Petitioner. We also note Petitioner's and 9219's status as co-defendants in the parallel litigation that share counsel. This evidence, when viewed in light of Petitioner's position in *WellcomeMat*, tends to show that 9219 has a controlling interest in this proceeding. *See* Consolidated Trial Practice Guide at 17. The fact that Petitioner and 9219 observe corporate formalities and maintain separate bank accounts (Opp. 3–4) does little to counteract the evidence put forth by Patent Owner.

For these reasons, and based on the present record, we find that Petitioner should identify 9219 as an RPI.

C. The Appropriate Remedy

Patent Owner argues that, under *Corning Optical*, we are required to dismiss the Petition based on Petitioner's failure to identify 9219 as an RPI. Mot. 6. In particular, Patent Owner argues that “*Proppant*’s holding that a petition’s RPI identification can be amended while preserving the petition’s filing date cannot be reconciled with the opposite *Corning* holding,” so

Corning Optical should control given the recency of the Director memo. *Id.* at 7–8.

Petitioner argues that this proceeding is already past the institution phase, so *Lumentum* and *Proppant* govern it. Opp. 6. According to Petitioner, *Proppant* allows a petitioner to “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.” *Id.* at 6–7 (citing *Proppant*, Paper 86 at 6–7). And Petitioner highlights that “there is no evidence, or even assertion, of circumvention of the § 315(b) time bar, bad faith, gamesmanship, or prejudice to [Patent Owner].” *Id.* at 7.

We agree with Petitioner that, to the extent there is a perceived conflict with *Corning Optical*, *Proppant* governs this post-institution phase. The Director memo expressly states that *Corning Optical* was being re-designated to restore the practice of requiring petitioners to identify RPIs *before institution*. Ex. 2152, 1. Thus, the post-institution guidance of *Proppant* remains unchanged, and Petitioner may update its identification of RPIs so long as it meets the requirements outlined in *Proppant*. We also agree with Petitioner that the record reflects no evidence of circumventing the § 315(b) time bar, bad faith, gamesmanship, or prejudice to Patent Owner. For these reasons, we decline to dismiss the Petition at this late

juncture in the proceeding.³ We also authorize Petitioner to update its mandatory notices to identify 9219 as an RPI.

D. Conclusion

For the reasons outlined above, and based on the current record, we find that Petitioner should identify 9219 as an RPI. Petitioner shall update its mandatory notices within five business days to reflect the same. We deny Patent Owner's motion to dismiss the Petition based on Petitioner's failure to name 9219 as an RPI earlier in the case.

ORDER

It is hereby

ORDERED that, within five business days, Petitioner shall update its mandatory notices to identify 9219-1568 Québec Inc. as a real party-in-interest; and

FURTHER ORDERED that Patent Owner's motion to dismiss the Petition for failure to identify all real parties-in-interest is *denied*.

³ We also note that Patent Owner has known about 9219's relationship with Petitioner for essentially the whole duration of this proceeding, but waited until very late in the case to raise the issue. Although we acknowledge the changed circumstances of the Director memo, we nonetheless note that, as a matter of policy, patent owners should not be rewarded for delaying RPI challenges.

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