

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.

IPR2024-00941
Patent 11,991,234 B2

Before THU A. DANG, JOHN A. HUDALLA, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Aylo Freesites Ltd (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–20 (“the challenged claims”) of U.S. Patent No. 11,991,234 B2 (Ex. 1001, “the ’234 patent”). Petitioner filed a Declaration of Henry Houh, Ph.D. (Ex. 1003) with its Petition. DISH Technologies L.L.C. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”), along with a Declaration of Dr. Kevin Jeffay (Ex. 2001).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2023). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the 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.” However, we have discretion to deny institution even if a petitioner meets that threshold. *See* 35 U.S.C. § 314(a); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). For the reasons that follow, we exercise our discretion to deny institution of *inter partes* review.

I. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies Aylo Freesites Ltd (f/k/a MG Freesites Ltd), Aylo Premium Ltd (f/k/a MG Premium Ltd), and Aylo Billing Limited (f/k/a MG Billing Limited) as the real parties-in-interest. Pet. 1. Patent Owner identifies DISH Technologies L.L.C. and Sling TV L.L.C., as well as EchoStar Corporation, as the real parties-in-interest. Paper 4, 2.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters. Pet. 1–3; Paper 4, 2–6.

Of note, Petitioner concurrently filed another petition challenging claims 1–20 of the '234 patent in IPR2024-00940. Pet. 2; Paper 4, 5. Petitioner also filed a ranking of the two petitions in which it ranked the petition in IPR2024-00940 first and the instant Petition second. Paper 3 (“Pet. Ranking”).

C. The '234 Patent

The '234 patent is directed to “adaptive-rate shifting of streaming content” over packet-switched networks such as the Internet. Ex. 1001, 1:35–38. The '234 patent addresses a purported need to “utilize multiple connections between a source and destination, requesting varying bitrate streams depending upon network conditions.” *Id.* at 2:67–3:3.

Figure 1 of the '234 patent is reproduced below.

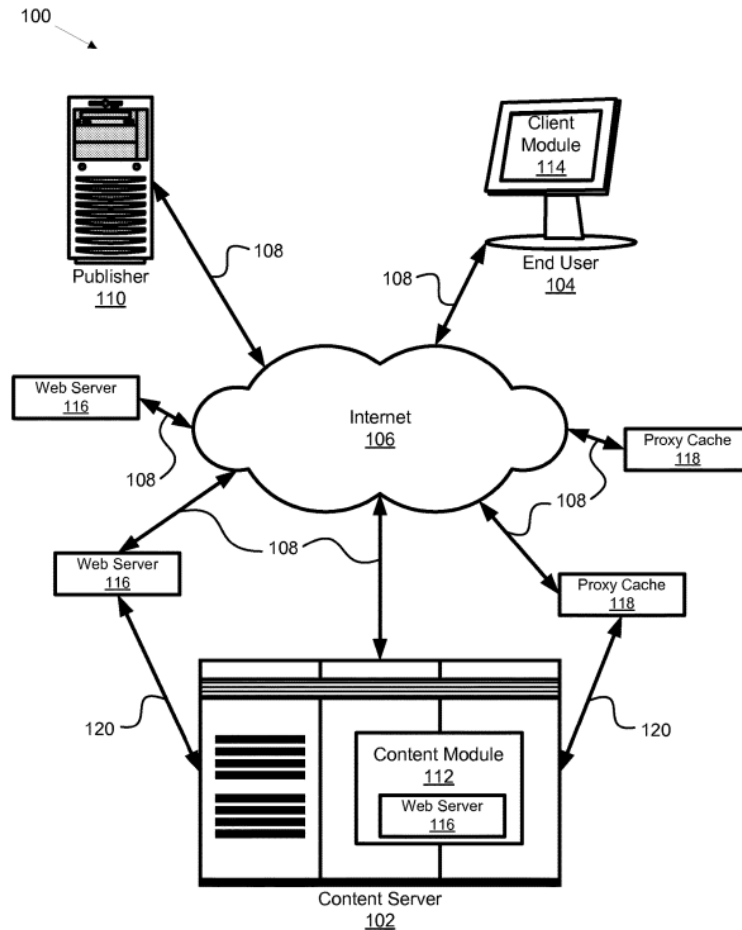


FIG. 1

Figure 1 depicts “system 100 for dynamic rate shifting of streaming content.” Ex. 1001, 6:36–38. System 100 includes content server 102, end user station 104, publisher 110, and web server 116. *Id.* at 6:39–55. Content may be transferred over Internet 106 to content server 102, and content from content server 102 may be replicated to other web servers 116. *Id.* at 6:59–61, 7:4–5.

Figure 2b of the '234 patent is reproduced below.

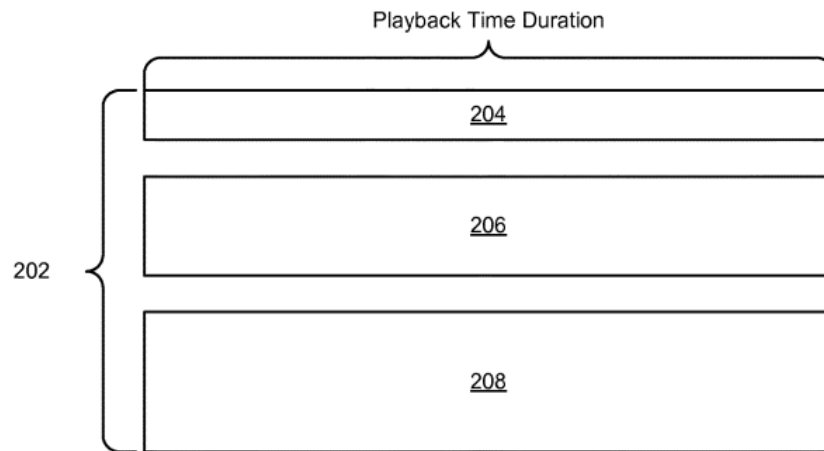


FIG. 2b

Figure 2b depicts “a plurality of streams 202 having varying degrees of quality and bandwidth.” Ex. 1001, 7:28–30. 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 7:30–34.

Figure 3a of the '234 patent is reproduced below.

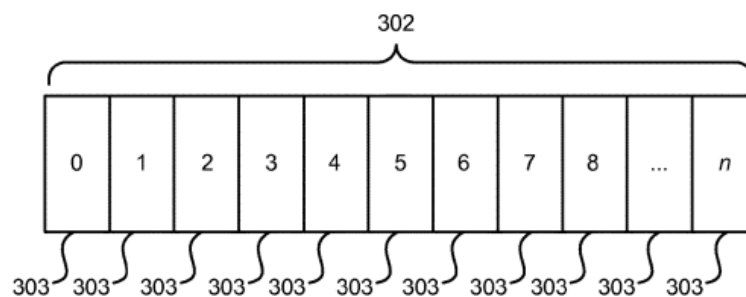


FIG. 3a

Figure 3a depicts “stream 302 divided into a plurality of source streamlets 303,” which are “any sized portion[s] of the content file 200.” Ex. 1001, 7:40–43.

Figure 3b of the '234 patent is reproduced below.

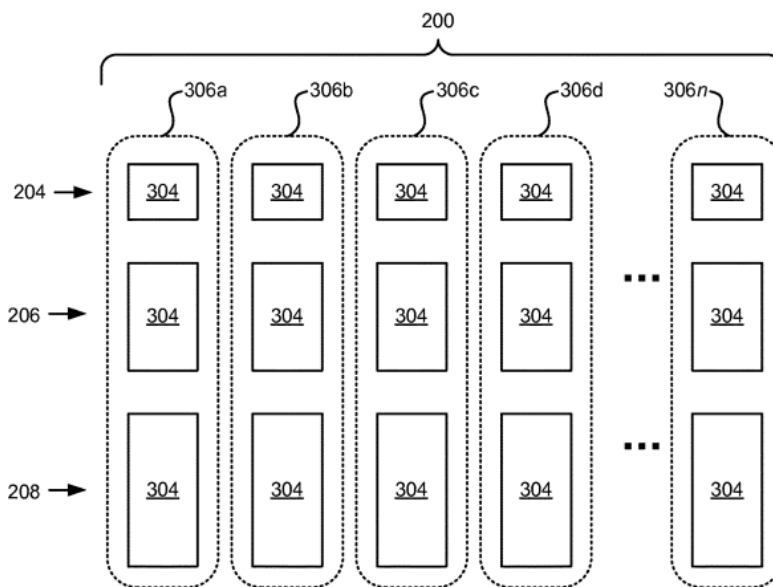


FIG. 3b

Figure 3b depicts “sets 306 of streamlets.” Ex. 1001, 7:58–59. A “set” is a “group of streamlets having identical time indices and durations but varying bitrates.” *Id.* at 7:60–62. For example, “set 306a includes encoded streamlets 304 having low, medium, and high 204, 206, 208 bitrates.” *Id.* at 7:64–65.

The application that led to the '234 patent was filed on December 21, 2022, and claims priority to, *inter alia*, a provisional application that was filed on April 30, 2004. Ex. 1001, codes (22), (60); *see also* Pet. 8, 11 (noting same).

D. Illustrative Claim

Of the challenged claims, claims 1 and 12 are independent. Claims 2–11 depend directly or indirectly from claim 1, and claims 13–20 depend from claim 12. Claim 1 is illustrative of the challenged claims and recites:

1. An end user station for adaptive-rate content streaming of digital content comprising:

a client module configured to be connected to a network having at least one server and further configured to request digital content over the network via at least one transmission control protocol (TCP) connection, wherein at least two different copies of the digital content are each encoded at different bit rates and stored on the at least one server, wherein each copy of the digital content is divided into a plurality of streamlets, each of the plurality of streamlets of a corresponding copy comprising a different portion of the digital content during presentation, wherein corresponding streamlets across the at least two different copies comprise the same corresponding portions of the digital content during presentation, and wherein the client module streams the digital content by:

requesting a first streamlet from the at least one server;

automatically requesting from the at least one server subsequent portions of the digital content by requesting for each subsequent portion one of the streamlets from the different copies of the digital content dependent upon successive determinations by the client module to change a currently requested bit rate to a higher or lower bit rate, the automatically requesting including repeatedly generating a factor indicative of a current ability to receive digital content at a rate sufficient for presenting the digital content as the digital content is received;

making the successive determinations to change the digital content bit rate based on the factor using the streamlets of one of the different copies of the digital content having the highest bit rate determined receivable for presentation so that the client module selects a higher bit rate one of the different copies when the factor is greater than a first threshold and selects a lower bit rate one of the different copies when the factor is less than a second threshold; and

arranging the streamlets requested from the at least one server in order of ascending presentation time for output to a presentation device.

Ex. 1001, 18:30–19:3.

E. Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 6,161,137, filed Mar. 31, 1998, issued Dec. 12, 2000 (Ex. 1004, “Ogdon”);

International Patent Publication No. WO 02/075482 A2, filed Mar. 15, 2002, published Sept. 26, 2002 (Ex. 1005, “Allen”);

U.S. Patent Application Publication No. 2003/0236906 A1, filed June 24, 2002, published Dec. 25, 2003 (Ex. 1006, “Klemets”);¹ and

U.S. Patent Application Publication No. 2004/0093420 A1, filed Nov. 13, 2002, published May 13, 2004 (Ex. 1020, “Gamble”).

F. The Asserted Grounds

Petitioner challenges claims 1–20 of the ’234 patent based on the following grounds (Pet. 4):

Claims Challenged	35 U.S.C. §	References
1–8, 10–15, 17–20	103(a) ²	Ogdon, Allen
9	103(a)	Ogdon, Allen, Klemets
16	103(a)	Ogdon, Allen, Gamble

¹ Petitioner mistakenly identifies this reference as “Klements” throughout the Petition.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103. Because the ’234 patent claims priority to an application filed before March 16, 2013 (the effective date of the relevant amendments), we assume that the pre-AIA versions of §§ 102 and 103 apply. However, our decision would be the same under the current version of the statutes.

II. ANALYSIS

Our disposition of this case turns on the issue of discretionary denial. As mentioned above, Petitioner concurrently filed two petitions, each challenging all of the claims of the '234 patent. Pet. Ranking 1. The petition in IPR2024-00940 relies on Leaning³ as its primary reference, whereas the instant Petition relies on Ogdon as its primary reference. *Id.* Petitioner asks us to prioritize the petition in IPR2024-00940 over the instant Petition. *Id.* Given that we are instituting *inter partes* review on all claims in the '234 patent and all grounds presented based on Leaning in IPR2024-00940, we now consider whether to exercise our discretion to deny the instant Petition under 35 U.S.C. § 314(a).

Our Trial Practice Guide recognizes that “one petition should be sufficient to challenge the claims of a patent in most situations.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (“Consolidated Trial Practice Guide”) at 59 (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>. “Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” *Id.* (citing 35 U.S.C. § 316(b)). Notwithstanding, the paper ranking the order of petitions gives a petitioner an opportunity to address “the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one

³ International Patent Publication No. WO 02/49343 A1, filed Dec. 14, 2001, published June 20, 2002 (“Leaning”).

petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” *Id.* at 59–60. Situations warranting more than one petition might include, for example, “when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.* at 59.

Petitioner provides several reasons why it believes that we should institute both petitions. We are not persuaded by any of them.

First, Petitioner cites “Patent Owner’s conduct in its patent-assertion campaign” in which Patent Owner asserted all claims of the ’234 patent “immediately upon issuance.” Pet. Ranking 3 (emphasis omitted). Petitioner also cites the “lengthy claims in the ’234 Patent” and argues that “there is not sufficient space to challenge every claim and include independent invalidity grounds based on Leaning and based on Ogdon and Allen.” *Id.*; *see also id.* at 5 (“two petitions were required due to the need to challenge all twenty claims”).

Patent Owner faults Petitioner for not explaining “why it could not have picked a subset of claims to challenge, permitting it to assert multiple grounds in a single petition, or why it could not have picked a subset of grounds to assert.” Prelim. Resp. 56.

We agree with Patent Owner that Petitioner fails to explain why the Leaning grounds in IPR2024-00940 are not sufficient for challenging claims 1–20 of the ’234 patent. Indeed, “both petitions contain strong invalidating prior art” by Petitioner’s own reckoning (Pet. Ranking 2), and Petitioner characterizes Leaning as “undoubtedly very strong invalidating prior art” (*id.* at 4). We further note that both petitions challenge all 20 claims of the ’234 patent, so the scope of the challenges is exactly the same

in both cases. As a result, we are not persuaded that the differences between the petitions militate in favor of instituting both proceedings.

Petitioner's additional arguments are similarly unavailing. Although Petitioner points to the timing of Patent Owner's assertions relative to the issuance of the '234 patent (Pet. Ranking 3), we are not persuaded that such timing bears on whether Petitioner should get a second *inter partes* review. In addition, the fact that Patent Owner's "patent assertion campaign" may extend beyond the '234 patent (*id.*) similarly does not justify a second petition here, where the challenges in IPR2024-00940 address all claims of the '234 patent. Further, to the extent Petitioner relies on the number of claims or their length (*id.*), we disagree: Petitioner challenges 20 claims that are not unusually long. *See* Ex. 1001, 18:30–21:5. We additionally note that, based on the present record, neither petition involves a dispute about priority dates for the asserted prior art references. For these reasons, we see no basis for extending Petitioner's challenges against the claims of the '234 patent into a second petition.

Second, Petitioner contends that "the #2 ranked Ogdon-based petition also presents strong invalidity grounds for the challenged claims" given that "the Board has already instituted on related patents having similar claims in IPR2024-00043, -00044, -00045, -00046, [and] -00146—each of which presented similar Ogdon in view of Allen obviousness grounds in the #2 ranked Ogdon-based petition here." Pet. Ranking 4–5. Although we instituted *inter partes* reviews of other patents where Ogdon is the primary reference, this does not mean that Petitioner is entitled to a second petition here. We note that the Board exercised its discretion to deny institution of follow-on petitions based on Leaning related to each of the cited Ogdon-

based cases,⁴ which demonstrates the principle that “multiple petitions by a petitioner are not necessary in the vast majority of cases.” Consolidated Trial Practice Guide at 59. Allowing only one petition to go forward in this instance is consistent with our treatment in those related cases.

Third, Petitioner argues that “instituting both petitions should not impose an undue burden on the Board” given that “the Board has instituted Ogdon and Allen invalidity grounds in IPR2024-00043, -00044, -00045, -00046, [and] -00146 already.” Pet. Ranking 5. Petitioner further explains that it “relies on the same secondary references (Klements [sic] and Gamble) in a similar manner in both the Leaning-based petition and the Ogdon-based petition[,] which provides further overlap and minimizes the additional issues that the Board must consider.” *Id.*

Addressing the burden on Patent Owner and the Board, Patent Owner argues that there is little overlapping material between the two petitions. Prelim. Resp. 57. According to Patent Owner, “arguments relating to Klemets and Gamble only make up 5 pages of the 63-page Petition [in IPR2024-00941], and only 6 pages of its 65-page Leaning-based petition [in IPR2024-00940].” *Id.* Patent Owner also argues that the schedules of the instituted Ogdon-based proceedings (i.e., IPR2024-00043, -00044, -00045, -00046, and -00146) would be far ahead of the instant proceeding if it were instituted, which weighs against institution. *Id.* at 56–57 (noting “vastly differing timeframes”).

⁴ We exercised our discretion under 35 U.S.C. § 314(a) to deny institution of Leaning-based petitions in IPR2024-00517, IPR2024-00512, IPR2024-00514, IPR2024-00516, and IPR2024-00515, which were related to Ogdon-based petitions in IPR2024-00043, IPR2024-00044, IPR2024-00045, IPR2024-00046, and IPR2024-00146, respectively.

We agree with Patent Owner that Petitioner does not justify why the Board and Patent Owner should shoulder the additional burden of a second instituted *inter partes* review. In particular, we disagree with Petitioner's assertion that the instituted Ogdon-based proceedings weigh in favor of instituting this proceeding. Although we have previously instituted *inter partes* reviews with Ogdon-based grounds, the instant case involves new claims, so it is necessarily different. Also, given that the instituted Ogdon-based proceedings are scheduled to conclude over seven months earlier than would this proceeding, we do not agree that instituting this case would yield appreciable efficiencies. We also agree with Patent Owner that the overlap between the petitions in IPR2024-00940 and IPR2024-00941, which relates mostly to the secondary references (Klemets and Gamble), is minimal. As such, Petitioner cannot deny that instituting review in this case would increase our workload and require Patent Owner to defend another case with different issues. We find that this circumstance implicates "fairness, timing, and efficiency concerns" sufficient to render a trial based on the instant Petition an "unnecessary burden." Consolidated Trial Practice Guide at 59.

Based on our assessment of the present record, and because we are instituting *inter partes* review of all claims of the '234 patent in IPR2024-00940, we exercise our discretion to deny the instant Petition under 35 U.S.C. § 314(a).

III. CONCLUSION

For the reasons above, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied as to all challenged claims, and no *inter partes* review is instituted.

IPR2024-00941
Patent 11,991,234 B2

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