

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEBGROUP CZECH REPUBLIC, A.S.,

NKL ASSOCIATES, S.R.O.,

Petitioners,

v.

DISH TECHNOLOGIES L.L.C.,

Patent Owner.

Case No. IPR2025-00347

U.S. Patent No. 9,407,564

**MOTION FOR JOINDER TO
INTER PARTES REVIEW IPR2024-00918**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Webgroup Czech Republic, A.S. and NKL Associates, S.R.O. (collectively “Petitioners”) respectfully submit this Motion for Joinder (“Motion”) with respect to its Petition (Paper 1) (the “Instant Petition”) filed on December 20, 2024. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners request institution of an *inter partes* review and joinder with the *inter partes* review in *fuboTV Media Inc. and Yanka Indus., Inc.. v. DISH Techs. L.L.C*, IPR2024-00918 (the “fuboTV/MasterClass IPR”) in view of the Board’s decision to institute trial on November 21, 2024 (IPR2024-00918, Paper 14).

Counsel for Petitioners has conferred with counsel for petitioners in the fuboTV/MasterClass IPR, and fuboTV and Master Class do not object to Petitioners joining IPR2024-00918.

Petitioners’ request for joinder is timely under 37 C.F.R. § 42.122(b) as it is submitted no later than one month after the November 21, 2024 institution date of the fuboTV/MasterClass IPR. The 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. In addition, Petitioners are willing to follow the fuboTV/MasterClass IPR’s Scheduling Order.

Petitioners submit that joinder is appropriate because it will not unduly

burden or prejudice the parties to the fuboTV/MasterClass IPR while efficiently resolving whether claims 1-16 of the '564 Patent are valid.

II. STATEMENT OF MATERIAL FACTS

1. On August 22, 2023, Patent Owner brought a lawsuit against MG Premium Ltd and other purportedly related companies in the District of Utah (Case No 2:23-cv-552). MG Premium Ltd is now known as “Aylo Premium Ltd.” The complaint alleged infringement of the ’564 Patent.

2. On the same day, Patent Owner brought a lawsuit against Petitioners in the District of Utah (Case No. 2:23-cv-553). The complaint alleged infringement of the ’564 Patent.

3. On September 6, 2023, Patent Owner brought a lawsuit against fuboTV in the District of Delaware (Case No. 1:23-cv-00986). The complaint alleged infringement of the ’564 Patent.

4. On October 13, 2023, in IPR2024-00047, Aylo Freesites Ltd filed a petition (“Aylo’s Ogdon Petition”) for *inter partes* review requesting cancellation of claims 1-8, 10, and 12-16 of the ’564 Patent. Aylo’s Ogdon Petition “certified that 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) are the only real parties-in-interest.” IPR2024-00047, Paper 1.

5. On November 15, 2023, Patent Owner brought a lawsuit against Yanka Indus., Inc. d/b/a Masterclass in the District of Delaware (Case No. 1:23-cv-01305). The complaint alleged infringement of the ’564 Patent.

6. On January 24, 2024, Patent Owner brought a lawsuit against Aylo Freesites Ltd and another purportedly related company in the District of Utah (Case No 2:24-cv-00066). The complaint alleged infringement of the '564 Patent.

7. On January 30, 2024, in IPR2024-00519, Aylo Freesites Ltd filed a second petition ("Aylo's Leaning Petition") for *inter partes* review requesting cancellation of claims 1-16 of the '564 Patent. Aylo's Leaning Petition "certified that 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) are the only real parties-in-interest." IPR2024-00518, Paper 1.

8. On April 16, 2024, the Board denied Aylo's Ogden Petition. IPR2024-00047, Paper 8.

9. On May 17, 2024, in IPR2024-0918, fuboTV and MasterClass filed the fuboTV/ MasterClass Petition as a copycat of the Aylo Leaning Petition, requesting cancellation of claims 1-16 of the '564 Patent. The fuboTV/ MasterClass Petition "certifie[d] that fuboTV Media Inc. and Yanka Industries, Inc. are the only real parties-in-interest." IPR2024-0918, Paper 3.

10. On August 13, 2024, the Board discretionarily denied Aylo's Leaning Petition under 35 U.S.C. § 314. IPR2024-00518, Paper 12.

11. On November 21, 2024, the Board instituted the fuboTV/Masterclass IPR. IPR2024-00518, Paper 14. In its Institution Decision, the Board declined to exercise its discretion to deny under 35 U.S.C. § 314(a) finding that “Petitioner has filed only one petition challenging the ’564 patent, and we do not agree that its copying of an earlier petition—rather than filing a new and different petition—constitutes improper roadmapping or gamesmanship.” *Id.* at 29.

12. On December 20, 2024, in the instant case IPR2025-00347, Petitioners filed the Instant Petition as a copycat of the Fubo TV/MasterClass Petition, requesting cancellation of claims 1-16 of the ’564 Patent.

13. The Instant Petition and the fuboTV Petition 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.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers several

factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 76-78.

B. Petitioners' Motion For Joinder Is Timely

This Motion for Joinder is timely because it is filed within one month of the November 21, 2024 institution decision of the fuboTV/MasterClass IPR. 37 C.F.R. § 42.122(b). Further, the Instant Petition was filed within the one-year bar set forth in 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b).

C. Every Factor Weighs In Favor Of Joinder.

All four factors considered by the Board weigh in favor of joinder. Specifically, the Instant Petition does not present any new grounds of unpatentability; it is substantively identical to the fuboTV/MasterClass Petition.¹ Further, joinder will have minimal, if any, impact on the trial schedule, as all issues

¹ Indeed, for the most part, the Instant Petition is a word-for-word copy of the fuboTV/MasterClass Petition; changes were made only in a few instance to account for the different parties and different positioning of the parties.

are substantively identical, and Petitioner will accept an “understudy” role unless and until fuboTV and MasterClass are terminated from the proceeding. Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate here.

The Board routinely grants motions for joinder in view of pending litigations involving the same patent and the same parties. *See, e.g., Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 2-7 (PTAB April 6, 2020) (granting motion for joinder of an Instant Petition in view of co-pending lawsuit); *Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 2-13 (PTAB May 30, 2019) (same); *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 2-15 (PTAB Oct. 30, 2018) (same); *Huawei Device Co., Ltd. v. Uniloc Luxembourg S.A.*, IPR2017-02090, Paper 9 at 2-12 (PTAB March 6, 2018) (same); *Pfizer, Inc. v. Genentech, Inc.*, IPR2017-02063, Paper 25 at 4-8 (PTAB Feb. 21, 2018) (same); *General Motors LLC v. Neo Wireless LLC*, IPR2023-00963, Paper 10 at 2-20 (PTAB Dec. 6, 2023) (same); *T-Mobile USA, Inc. v. Dali Wireless, Inc.*, IPR2023-00830, Paper 7 at 2-11 (PTAB Oct. 11, 2023) (same); *Cooler Master Co., Ltd. v. Asektek Danmark A/S*, IPR2023-00667, Paper 6 at 2-13 (PTAB Aug. 28, 2023) (same).

1. Joinder Is Appropriate With The fuboTV/MasterClass IPR.

Joinder with the fuboTV/MasterClass IPR is appropriate because the Instant Petition involves the same patent, challenges the same claims, relies on the same

testimony from the same expert, and is based on the same grounds and combinations of prior art submitted in the fuboTV/MasterClass Petition. The Instant Petition is substantively identical to the fuboTV/MasterClass Petition, containing only minor differences unrelated to the merits of the proposed grounds. There are no changes to the facts, citations, evidence, or arguments presented in the Instant Petition in relation to the grounds of the fuboTV/MasterClass Petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the fuboTV/MasterClass IPR so that the Board can efficiently resolve all grounds in both the Instant and the fuboTV/MasterClass Petitions in a single proceeding. Moreover, the fuboTV/MasterClass Petition presents compelling unpatentability challenges, resolving the merits of the fuboTV/MasterClass Petition is in the interest of justice, and joinder is appropriate in such circumstances. *Code200 v. Bright Data Ltd.*, IPR2022-00861, Paper 19 at 39.

2. Petitioners Propose No New Grounds Of Unpatentability.

The Instant Petition does not present any new grounds of unpatentability. The Instant Petition is substantively identical to the fuboTV/MasterClass Petition. The Instant Petition presents the unpatentability of the same claims of the same patent in the same way as the fuboTV/MasterClass Petition. The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *Samsung Elecs. Co. v.*

Raytheon Co., IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original); *see also STMicroelectronics, Inc. v. Lone Star Silicon Innovations, LLC*, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (granting joinder and reasoning, “[w]e rely in particular, on Petitioner’s representation that its Petition is ‘substantially identical’...challenges the same claims based on the same prior art and the same grounds of unpatentability....”).

3. Joinder Will Not Unduly Burden Or Negatively Impact The fuboTV/MasterClass IPR Trial Schedule.

Because the Instant Petition is substantively identical to the fuboTV/MasterClass Petition, with the same grounds applied to the same claims as instituted by the Board, there are no new issues for Patent Owner to address. Due to the same issues being presented in the fuboTV/MasterClass Petition, Patent Owner will not be required to present any additional responses or arguments. *LG v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 5, 2015) (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR].”); *see also id.*, Paper 4 at 5–7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the fuboTV/MasterClass Petition are identical to the issues

presented in the Instant Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the fuboTV/MasterClass Petition. Also, because the Instant Petition relies on the same expert and a substantively identical declaration, only a single deposition is needed for the proposed joined proceeding.

Joinder of this proceeding with the fuboTV/MasterClass IPR would not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule were necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. *See* 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present Instant Petition with the fuboTV/MasterClass IPR.

4. Procedures To Simplify Briefing And Discovery

The fuboTV/MasterClass Petition and the Instant Petition present substantively identical grounds of rejection, including the same prior art combinations against the same claims. Additionally, Petitioners explicitly agree to take an “understudy” role, as described by the Board:

“(a) all filings by [Petitioners] in the joined proceeding [will] be consolidated with [the filings of the petitioners in the fuboTV/MasterClass IPR], unless a filing solely concerns issues that do not involve [the petitioners in the fuboTV/MasterClass

IPR]; (b) [Petitioners] 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 petitioners in the FuboTV/MasterClass IPR]; (c) [Petitioners] shall be bound by any agreement between [Patent Owner] and [the petitioners in the FuboTV/MasterClass IPR] concerning discovery and/or depositions; and (d) [Petitioners] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioners in the FuboTV/MasterClass IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioners in the FuboTV/MasterClass IPR].”

See IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015).

Petitioners will assume the primary role only if fuboTV and MasterClass cease to participate in the FuboTV/MasterClass IPR. Counsel for Petitioners has conferred with counsel for fuboTV and MasterClass, and they do not object to Petitioners joining IPR2024-00918 in an “understudy” role. By Petitioners accepting an “understudy” role, Patent Owner and Petitioners can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that may result due to joinder. *See, e.g., Garmin Int’l, Inc. v. Philips North Am. LLC*, IPR2020-00910, Paper 8 at 45, 47-50 (PTAB Nov. 19, 2020) (granting joinder where

petitioners agreed to accept an “understudy” role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar).

IV. GENERAL PLASTIC IS INAPPLICABLE AND FAVORS INSTITUTION

In *General Plastic*, the Board set forth a series of factors that may be analyzed for follow-on petitions to help conserve the finite resources of the Board. In the current motion, Petitioners merely seek to join the fuboTV/MasterClass proceeding in an understudy rule and does not present any new grounds. The PTAB has previously found that such circumstances “effectively neutralize[]” a *General Plastic* analysis. See *Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (instituting a joinder Instant Petition where petitioner agreed to assume a passive understudy role, and noting such circumstances “effectively neutraliz[es] the *General Plastic* factors”); see also *Celltrion, Inc. v. Genetech, Inc.*, IPR2019-01019, Paper 11 at 10 (PTAB Oct. 30, 2018) (noting the joinder motion “effectively obviates any concerns of serial harassment and unnecessary expenditures of resources”) and *Code200*, Vidal Remand (Paper 18) (finding roadmapping and other *General Plastic* concerns generally inapplicable or of limited relevance when a motion for joinder presents an Instant Petition).

Prior to the Petition in the instant case, Petitioners had not previously filed a Petition seeking *inter partes* review of the ’564 Patent. Thus, the *General Plastic*

factors counsel against discretionary denial, *i.e.*, in favor of instituting the present IPR and joining it with the fuboTV/MasterClass IPR. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. at 16 (PTAB Sept. 6, 2017) (Paper 19) (precedential as to § II.B.4.i); *cf. Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (precedential) (denying motion for joinder and denying Instant Petition because Petitioner has previously filed a Petition challenging same claims and patent).

V. CONCLUSION

For the foregoing reasons, Petitioners respectfully request the Board grant Petitioners' Petition and Motion for Joinder with the FuboTV/MasterClass IPR.

Date: December 20, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on December 20, 2024, true and correct copies of the foregoing document was served in its entirety on the Patent Owner at the following address of record as listed in Patent Center via FedEx Priority Mail:

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