

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.

IPR2024-00512
Patent 11,470,138 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 (IPR) of claims 1–12 and 14–30 (“the challenged claims”) of U.S. Patent No. 11,470,138 B2 (Ex. 1001, “the ’138 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 7, “Prelim. Resp.”). With our authorization (*see* Ex. 1012), Petitioner filed a Preliminary Reply (Paper 8, “Pet. Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 11, “PO Prelim. Sur-reply”)¹ limited to addressing Patent Owner’s arguments regarding discretionary denial.

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.” 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

¹ Patent Owner filed its Preliminary Sur-reply three days late (*see* Ex. 3001), but we excuse Patent Owner’s late filing because we find that the consideration of Patent Owner’s arguments is in the interests of justice. *See* 37 C.F.R. § 42.5(c)(3).

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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 (Patent Owner’s Mandatory Notices).

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including:

DISH Technologies LLC v. MG Premium Limited, No. 2:23-cv-00552 (D. Utah filed Aug. 22, 2023) (“the Utah action”);

MG Freesites Ltd. v. DISH Technologies LLC, No. 3:23-cv-03674 (N.D. Cal. filed July 25, 2023) (“the California action”);

DISH Technologies LLC v. fuboTV Media Inc., No. 1:23-cv-00986 (D. Del. filed Sept. 6, 2023) (“the fuboTV action”); and

IPR2024-00044 (instituted Apr. 16, 2024).²
Pet. 1–2; Paper 4, 2–4; Paper 7, 1.

C. The ’138 Patent

The ’138 patent is directed to “adaptive-rate shifting of streaming content” over packet-switched networks such as the Internet. Ex. 1001, 1:31–34. The ’138 patent addresses a purported need to “utilize multiple connections between a source and destination, requesting varying bitrate streams depending upon network conditions.” *Id.* at 2:64–67.

Figure 1 of the ’138 patent is reproduced below.

² Patent Owner filed the petition in IPR2024-00044 as Exhibit 2008 in this proceeding.

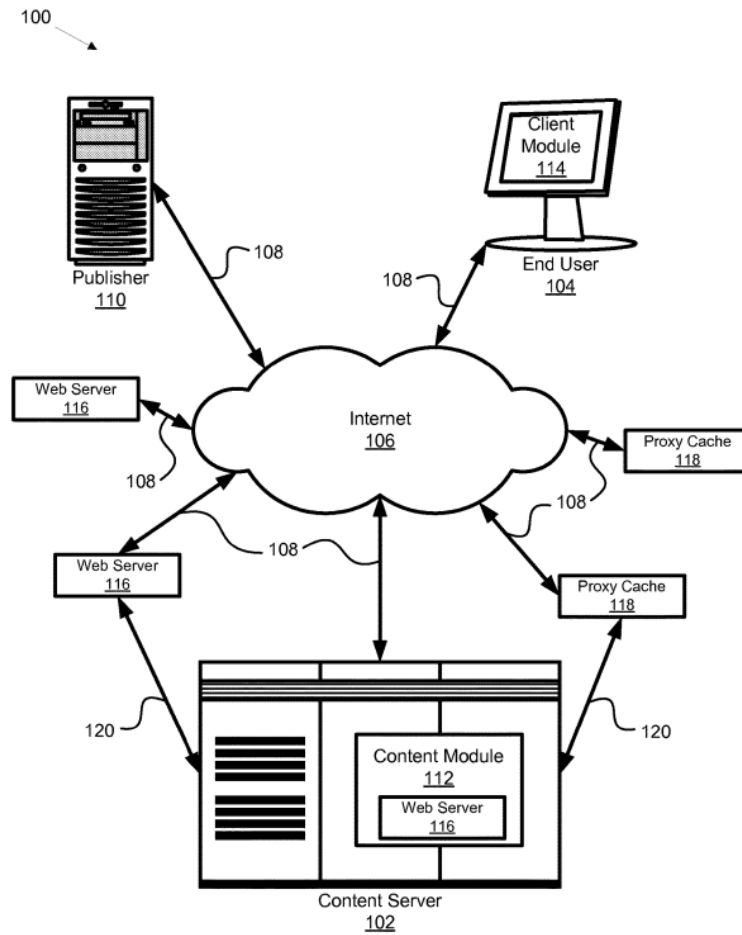


FIG. 1

Figure 1 depicts “system 100 for dynamic rate shifting of streaming content.” Ex. 1001, 6:33–35. System 100 includes content server 102, end user station 104, publisher 110, and web server 116. *Id.* at 6:36–52. 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 6:56–58, 7:1–2.

Figure 2b of the '138 patent is reproduced below.

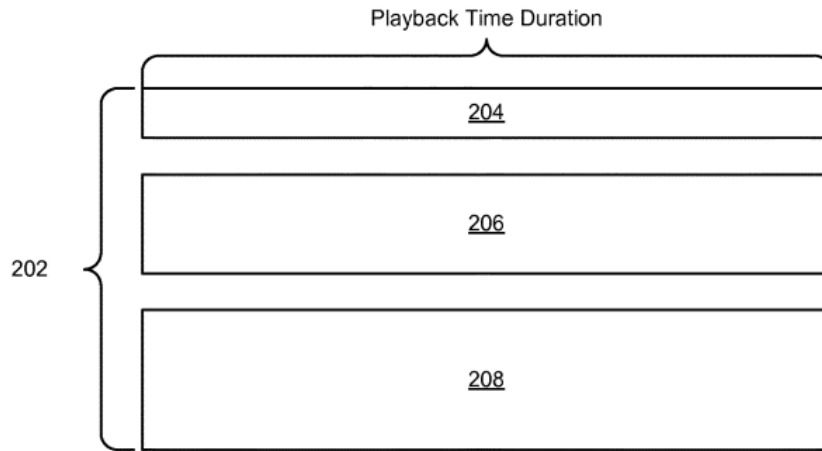


FIG. 2b

Figure 2b depicts “a plurality of streams 202 having varying degrees of quality and bandwidth.” Ex. 1001, 7:25–27. 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 7:27–31.

Figure 3a of the '138 patent is reproduced below.

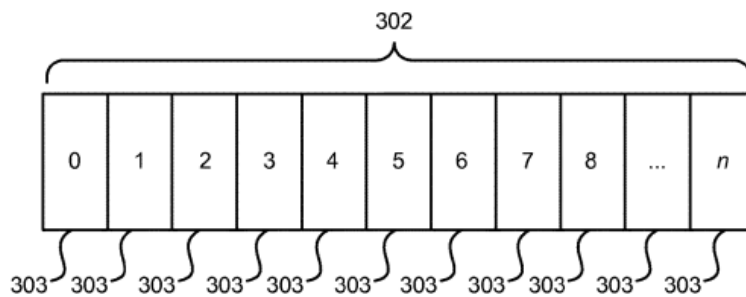


FIG. 3a

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, 7:37–39.

Figure 3b of the '138 patent is reproduced below.

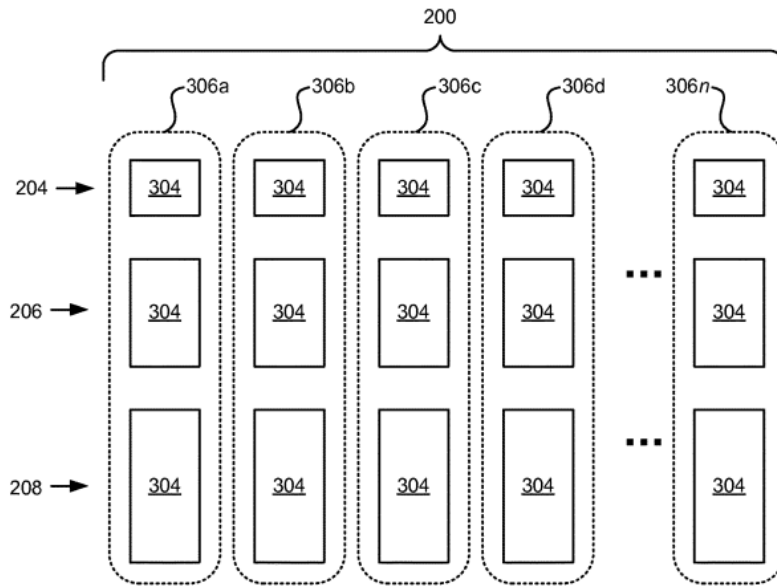


FIG. 3b

Figure 3b depicts “sets 306 of streamlets.” Ex. 1001, 7:55–56. A “set” is a “group of streamlets having identical time indices and durations but varying bitrates.” *Id.* at 7:57–59. For example, “set 306a includes encoded streamlets 304 having low, medium, and high 204, 206, 208 bitrates.” *Id.* at 7:61–62.

D. Illustrative Claim

Of the challenged claims, claims 1, 14, 23, and 28 are independent. Claims 2–12 depend directly or indirectly from claim 1; claims 15–22 depend directly or indirectly from claim 14; claims 24–27 depend from claim 23; and claims 29 and 30 depend from claim 28. Claim 1 is illustrative of the challenged claims and recites:

1. A system for adaptive-rate content streaming of a video that is playable on one or more end user stations over the internet, the system comprising:

at least one storage device storing the video, wherein the video is digitally encoded at a plurality of different bitrates creating a plurality of streams including a low quality stream, a medium quality stream, and a high quality stream, the low quality stream, the medium quality stream, and the high quality stream each comprising a group of streamlets, wherein each streamlet corresponds to a portion of the video, and wherein each streamlet in each group of streamlets is encoded at a respective one of the plurality of different bitrates, and wherein each group of streamlets comprises at least first and second streamlets;

wherein at least one of the low quality stream, the medium quality stream, and the high quality stream is encoded at a bitrate of no less than 600 kbps; and

wherein the first streamlet of each of the groups of streamlets has the same first duration and encodes the same first portion of the video in each of the low quality stream, the medium quality stream, and the high quality stream, and wherein the first streamlet of the low quality stream encodes the same first portion of the video at a lower bitrate than the first streamlet of the high quality stream and the first streamlet of the medium quality stream.

Ex. 1001, 18:24–50.

E. Prior Art

Petitioner relies on the following prior art:

International Patent Publication No. WO 02/49343 A1, filed Dec. 14, 2001, published June 20, 2002 (Ex. 1004, “Leaning”);

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

Synchronized Multimedia Integration Language (SMIL 2.0), published Aug. 7, 2001 (Ex. 1006, “SMIL 2.0”).

F. The Asserted Grounds

Petitioner challenges claims 1–12 and 14–30 of the ’138 patent based on the following grounds (Pet. 4):

Claims Challenged	35 U.S.C. §	References
1–12, 14–30	103(a)	Leaning, Allen
9–12, 18–20	103(a)	Leaning, Allen, SMIL 2.0

II. ANALYSIS

Our disposition of this case turns on the issue of discretionary denial. Patent Owner argues that we should exercise our discretion to deny institution under 34 U.S.C. § 314(a) based on Petitioner’s earlier petition in IPR2024-00044, which challenged most of the same claims of the ’138 patent based on two obviousness combinations including U.S. Patent No. 6,161,137 (“Ogdon”) as the primary reference. Prelim. Resp. 2–16; PO Prelim. Sur-reply 1–6. Patent Owner includes an analysis based on the Board’s precedential decision in *General Plastic*. *See id.* (citing *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)). Petitioner also analyzes the *General Plastic* factors and argues that they weigh against discretionary denial. Pet. 61–64; Pet. Prelim. Reply 1–6.

35 U.S.C. § 314(a) provides that the Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Section 314(a) does not require the Director to institute a review. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). Rather, a decision whether to institute is within the Director’s discretion, and that discretion has been delegated to the Board. *See General Plastic* at 15, 18–19; 37 C.F.R. § 42.4(a).

In *General Plastic*, the Board set forth a non-exhaustive list of factors to consider in evaluating whether to exercise discretion, under § 314(a), to deny a petition challenging a patent previously challenged before the Board. Those factors include:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

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General Plastic at 16 (citing *NVIDIA Corp. v. Samsung Elecs. Co.*, IPR2016-00134, Paper 9 at 6–7 (PTAB May 4, 2016)). These factors are “a non-exhaustive list” and “additional factors may arise in other cases for consideration, where appropriate.” *Id.* at 16, 18.

We now consider the factors enumerated above.

A. *General Plastic Factor 1*

The first *General Plastic* factor asks “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic* at 16. Patent Owner notes that there is no dispute that “the same petitioner” previously filed the petition in IPR2024-00044 challenging claims of the ’138 patent. Prelim. Resp. 3. Patent Owner further notes that the two petitions have 25 overlapping challenged claims. *Id.* at 4. According to Patent Owner, “[c]laims 2, 21, 26, and 30, the only nonoverlapping claims between the two petitions, depend directly from claims 1, 14, 23, and 28, which were challenged in [IPR2024-00044].” *Id.* Patent Owner also notes that Petitioner “devotes less than one page of text to addressing claims 2, 21, 26, and 30.” *Id.* (citing Pet. 31–32, 52, 54, 56). Thus, Patent Owner contends this factor “weighs strongly against institution.” *Id.* at 6.

Petitioner touts its additional challenges of claims 2, 21, 26, and 30 in support of its contention that this factor “favors institution or is at least neutral.” Pet. 61.

Petitioner filed two staggered petitions challenging 25 common claims, including all of the independent claims of the ’138 patent. Only four of the 29 claims challenged in the instant Petition are not included in the

earlier petition, and Petitioner’s treatment of these four claims comprises about one page of analysis. Given that the two petitions challenge nearly all of the same claims of the ’138 patent, we find that this factor weighs in favor of exercising discretion to deny institution.

B. General Plastic Factor 2

The second factor asks whether, at the time of filing the petition in IPR2024-00044, Petitioner knew or should have known of the references asserted in this Petition. *See General Plastic* at 16. Petitioner knew of Allen and SMIL 2.0 at the time of filing the earlier petition because they are asserted in IPR2024-00044. *See Ex. 2008, 3*. Thus, the only remaining issue under this factor is whether Petitioner, with the exercise of reasonable diligence, could have found the primary reference in this case, Leaning, before filing the petition in IPR2024-00044. *See General Plastic* at 20.

Petitioner argues that it first became aware of Leaning on January 5, 2024. Pet. 61. Petitioner asserts that, “[o]nce Leaning was discovered and sufficiently analyzed, Petitioner immediately and diligently proceeded to draft and file this Leaning-based Petition.” *Id.* at 61–62. Regarding the “knew . . . or should have known” aspect of this factor, Petitioner argues that Leaning “was not discovered or relied upon by any USPTO examiners, the respondents at the ITC, or prior targets of DISH’s district court assertions of related patents to the ’138 Patent.” *Id.* at 62. Petitioner acknowledges that the ’138 patent cites another reference by the same inventors of Leaning, U.S. Patent Application Publication No. 2004/0030547 A1 (Ex. 2001, “Leaning US”). *Id.* (citing Ex. 1001, code (56)). But Petitioner contends that Leaning US “is not in the same family as the Leaning reference relied

upon in this Petition.” *Id.* Petitioner also argues that Leaning US “is just one of more than 400 references cited on the face of the ’138 Patent . . . and it was never used by the Examiner or identified by the Applicant during prosecution of the ’138 Patent or any related patents other than being cited in an IDS [Information Disclosure Statement].” *Id.* (citing Ex. 1001, code (56)); *see also* Pet. Prelim. Reply 4–6 (arguing that the patent examiner materially erred in allowing the claims of the ’138 patent over Leaning US).

Patent Owner argues that Petitioner “provides no explanation of what steps it took prior to filing the [petition in IPR2024-00044] to locate prior art, and no explanation of why those steps were ‘diligent’ yet unable to uncover Leaning.” Prelim. Resp. 7. Patent Owner also highlights substantial similarities between Leaning and Leaning US and argues that Petitioner’s “initial searching was not and could not have been diligent” given that Leaning US is a cited reference on the face of the ’138 patent.³ *Id.* at 6–7 (citing, *inter alia*, Ex. 2002 (redline comparison of Leaning and Leaning US)), 28–37 (appendices comparing Leaning and Leaning US citations). Patent Owner additionally notes that the petition in IPR2024-00044 was “filed early in the statutory time period” and “Petitioner gives no explanation as to why petitioning for *inter partes* review could not have waited until [its prior art] search was complete.” *Id.* at 8.

We agree with Patent Owner (Prelim. Resp. 7) that Petitioner fails to provide any evidence or testimony to substantiate the manner and timing of its search efforts. All we can glean from Petitioner’s attorney argument is

³ On this basis, Patent Owner also argues that we should exercise our discretion to deny institution under 35 U.S.C. § 325(d). Prelim. Resp. 16–23. We need not reach this issue.

that Petitioner discovered Leaning almost three months after it filed the petition in IPR2024-00044. *See* Pet. 62. Petitioner makes no attempt to establish that it could not have known of Leaning at the time of the earlier petition or that it could not have found Leaning by exercising reasonable diligence at that time. Furthermore, Petitioner’s allusion to the allegedly fruitless search efforts of USPTO examiners and other litigants (*see* Pet. 62) does not justify *Petitioner’s* actions. Thus, we find that Petitioner has not sufficiently explained why it could not have found Leaning in earlier searches through the exercise of reasonable diligence before it filed the petition in IPR2024-00044. *See General Plastic* at 20.

Petitioner’s failure to sufficiently address whether it “should have known” of Leaning is particularly problematic because a substantially similar reference was cited during prosecution. In particular, Patent Owner has shown substantial similarities between Leaning and Leaning US, which is cited on the ’138 patent. *See* Prelim. Resp. 7, 28–37; Ex. 2002. These similarities pertain directly to Petitioner’s unpatentability analysis in this case. For example, limitation 1[B] recites that “the video is digitally encoded at a plurality of different bitrates creating a plurality of streams including a low quality stream, a medium quality stream, and a high quality stream.” Ex. 1001, 18:27–31. We note that all of Petitioner’s citations to the written description of Leaning for limitation 1[B] (*see* Pet. 23–24) are disclosed in identical language in Leaning US. *Compare* Ex. 1004, 1:3–29, 9:3–7, 16:6–12, *with* Ex. 2001 ¶¶ 45–48, 57, 90–91. This supports Patent Owner’s argument that Petitioner should have known of Leaning at the time it filed the petition in IPR2024-00044. In other words, because Leaning US was cited during prosecution, and because Leaning and Leaning US have

substantially similar disclosure in relevant part, it stands to reason that a reasonably diligent searcher would have located both Leaning and Leaning US.

Petitioner argues that Leaning is not in the same patent family as Leaning US and that Leaning US is one of over 400 references cited on the '138 patent. Pet. 62; *see also* Ex. 1001, code (56) (list of cited references). These facts do not, however, excuse Petitioner's failure to show that Leaning could not have been found with reasonable diligence and do not outweigh the circumstances discussed above. In addition, we note that Petitioner neither asserts that it was unaware of Leaning US at the time it filed the petition in IPR2024-00044 nor explains why it did not rely on Leaning US in the earlier petition.

Petitioner knew of Allen and SMIL 2.0 at the time of the earlier petition. Petitioner also fails to explain what steps it took to identify relevant prior art before filing the petition in IPR2024-00044, and a reference nearly identical to Leaning is cited on the '138 patent. Based on these considerations, we find that the second *General Plastic* factor weighs strongly in favor of exercising discretion to deny institution.

C. *General Plastic Factor 3*

The third *General Plastic* factor asks whether Petitioner had already received Patent Owner's preliminary response or our institution decision in IPR2024-00044 prior to filing the present Petition. *See General Plastic* at 16. Petitioner acknowledges that it filed the instant Petition 12 days after Patent Owner filed its preliminary response in IPR2024-00044. Pet. 63. Notwithstanding, Petitioner argues that it did not and could not use that

preliminary response as a roadmap for the instant Petition given the differences in asserted references in the two cases. *Id.*

Patent Owner argues that Petitioner had “ample opportunity” to study and respond to Patent Owner’s preliminary response in IPR2024-00044, which “details, in depth, the technical deficiencies with the grounds asserted” in the earlier case. Prelim. Resp. 9–10.

Petitioner cannot deny that it had a window of time, albeit small, to review and respond to Patent Owner’s preliminary response in IPR2024-00044. Accordingly, we agree with Patent Owner that this factor weighs in favor of exercising discretion to deny institution.

D. General Plastic Factor 4

The fourth *General Plastic* factor asks us to consider the length of time that elapsed between the time Petitioner learned of the prior art asserted here and the filing of the present Petition. *See General Plastic* at 16. Petitioner argues that it filed the instant Petition only 25 days after discovering Leaning. *See Pet.* 61–63. Yet, as noted by Patent Owner, Petitioner did not “submit a declaration or other factual evidence” related to the manner and timing of its search efforts. Prelim. Resp. 7–8.

Although 25 days may be a reasonable time frame for filing a new petition after discovering a new reference, Petitioner has not established this alleged time frame (or the circumstances of Petitioner’s search efforts) with any testimony or other evidence. Accordingly, we find this factor to be neutral.

E. General Plastic Factor 5

The fifth *General Plastic* factor asks “whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.” *General Plastic* at 16. The petition in IPR2024-00044 was filed on October 13, 2023 (Ex. 2008, 86), and the instant Petition was filed on January 30, 2024 (Pet. 67), which means that approximately 3½ months elapsed between the two filings.

Petitioner argues that the timing of the petition in IPR2024-00044 “was due to [Patent Owner] filing a preliminary-injunction (‘PI’) motion in [the Utah action] seeking to shut down [Petitioner’s] business.” Pet. Prelim. Reply 1. Petitioner further argues that, in light of the PI motion, Petitioner “had only one month to respond and prove that [Patent Owner] was unlikely to succeed on the merits at trial, including that [Patent Owner’s] patents were likely invalid.” *Id.* at 1–2. Accordingly, Petitioner contends that it “moved as quickly as possible to draft and file IPRs on all of [Patent Owner’s] asserted patents based on the best art [Petitioner] was aware of at that time, i.e., Ogdon, to show the Utah court that [Petitioner’s] invalidity arguments were not mere conjecture.” *Id.* at 2.

Patent Owner argues that Petitioner “could, and did, make its invalidity arguments to the District Court; and those arguments were not made more or less conjectural by filing them with this Board.” PO Prelim. Sur-reply 2. As such, Patent Owner argues that Petitioner’s “deci[sion] to file IPR petitions before the completion of its prior art search was a tactical decision that [Petitioner] now must live with.” *Id.*

Petitioner attempts to justify the filing of its petition in IPR2024-00044 early in the one-year statutory period under 35 U.S.C. § 315(b) based on Patent Owner's act of filing a motion for a PI in the Utah action. *See* Pet. Prelim. Reply 1–2. Yet we are not aware of any substantive reason why Petitioner would have been compelled to file an early IPR petition to respond to the PI motion in district court. Thus, to the extent that Petitioner's early filing bears on the elapsed time between the two petitions, we do not find that the exigencies of Patent Owner's PI motion provide an adequate justification. We agree with Patent Owner (PO Prelim. Sur-reply 2) that the timing of Petitioner's early filing in IPR2024-00044 was a matter of Petitioner's own choosing.

The parties also put forth arguments about how Patent Owner's disclosure of infringement contentions in parallel litigation might have impacted petition timing. Patent Owner argues that Petitioner could have awaited Patent Owner's infringement contentions that were disclosed on November 21, 2023, in which case Petitioner would have known to include the four additional dependent claims challenged in the instant Petition. Prelim. Resp. 4 (citing Ex. 2004).

Petitioner argues that the November 21, 2023, infringement contentions referenced by Patent Owner pertained to the California action rather than the Utah action. Pet. Prelim. Reply 2. Petitioner further argues that it “could not have waited for [Patent Owner's] contentions in the [California] action because [Petitioner] was facing [Patent Owner's] PI motion in [the Utah action] and also because [Patent Owner] had moved to dismiss the [California] action months before its contentions were due (which the [California] court ultimately granted).” *Id.* Petitioner

additionally argues that Patent Owner’s “choice of asserted claims is a moving target,” as illustrated by Patent Owner’s recent amendment of asserted claims in the fuboTV action. *Id.* at 3.

In its Preliminary Sur-reply, Patent Owner argues that the risk of changes in the claims asserted in parallel litigation “is well-understood by PTAB practitioners, and the solution is to challenge all claims that could plausibly be asserted in the future when filing a single petition (or simultaneously filing parallel petitions).” PO Prelim. Sur-reply 3.

Similar to our finding above, we do not agree that Patent Owner’s PI motion in the Utah action necessitated immediate action in this forum by Petitioner such that it “could not have waited.” Pet. Prelim. Reply 2. Moreover, we find that Petitioner’s choice to challenge a slightly smaller set of claims in IPR2024-00044 at a relatively early juncture represents its own tactical decision. At that time, Petitioner reasonably could have anticipated shifts in Patent Owner’s identification of asserted claims—both in the Utah action and in other parallel litigation—given that further disclosures about Patent Owner’s asserted claims were forthcoming. Finally, we note that the scope of the instant Petition goes far beyond challenging just the newly asserted claims; it relies on a new primary reference, *Leaning*, and challenges all of the claims previously challenged in IPR2024-00044. Thus, to the extent that changes in asserted claims bear on the elapsed time between the two petitions, we do not find that such changes provide an adequate justification.

Aside from these considerations, Petitioner vaguely argues that it “has been diligent in searching for prior art.” Pet. 61. This suggests that Petitioner’s search efforts continued after the petition was filed in

IPR2024-00044. But Petitioner provides no explanation of its initial search methodology or of “how or when it changed its search methodology that led to the discovery of Leaning,” as Patent Owner correctly observes. Prelim. Resp. 8. In the absence of any explanation, we see no basis to excuse the 3½ month gap between the two petitions.

For these reasons, we find that this factor weighs in favor of exercising discretion to deny institution.

F. General Plastic Factor 6

The sixth *General Plastic* factor addresses “the finite resources of the Board.” *General Plastic* at 16. In support of its argument that Factor 6 “favors institution or is at least neutral,” Petitioner argues that the “two petitions collectively consist of only two primary references.” Pet. 64. Petitioner proposes “to consolidate proceedings and align deadlines” between this case and IPR2024-00044 “such that the Board may issue a combined final written decision on Ogdon and Leaning.” Pet. Prelim. Reply 3–4 (citing Ex. 1013 (proposed schedule)). Petitioner also warns that, in the event we were to exercise discretion to deny institution here, “the Board will see a similar or copycat Leaning-based petition in the future” from other parties that Patent Owner has sued in district court for infringement of the ’138 patent.⁴ Pet. 64

⁴ Petitioner notes that “fuboTV filed copycat petitions of [Petitioner’s] Ogdon and Leaning petitions” in IPR2024-00901, IPR2024-00902, IPR2024-00903, IPR2024-00904, IPR2024-00905, IPR2024-00917, IPR2024-00918, and IPR2024-00919. Pet. Prelim. Reply 3 & n.4. Leaning is asserted in IPR2024-00917, IPR2024-00918, and IPR2024-00919, but none of these cases pertain to the ’138 patent.

Patent Owner argues that it is no longer feasible to consolidate the two proceedings, so the Board would have to conduct two separate proceedings based on different evidentiary records. Prelim. Resp. 14–15. According to Patent Owner, this would be a waste of the Board’s resources. *Id.* at 15.

We have considered Petitioner’s proposal to consolidate this case with IPR2024-00044 and shorten various deadlines to align the schedules in the two cases. *See* Pet. Prelim. Reply 3–4; Ex. 1013. Although Petitioner highlights that it would shorten its own deadlines, we note that Petitioner’s proposal also assumes the Board would (1) institute this case nearly two months earlier than required, and (2) issue a Final Written Decision several months earlier than required. *See id.* We additionally note that instituting this proceeding would double the number of unpatentability grounds at issue. Thus, even under Petitioner’s proposal, our workload would increase and our normal time frames for completing the work would shrink. Given these negative impacts on the resources of the Board, we find that this factor weighs in favor of exercising discretion to deny institution.

G. General Plastic Factor 7

The last *General Plastic* factor pertains to the requirement under 35 U.S.C. § 316(a)(11) that we must issue a final determination within one year of institution. *See General Plastic* at 16. Petitioner argues this factor is neutral because “[a]ny trial in the present proceeding could be resolved within the one-year statutory timeframe.” Pet. 64. Patent Owner relies on the same arguments that we have already discussed with respect to Factor 6. *See* Prelim. Resp. 14–16. We have already considered the potential impact of issuing an early final determination (in accordance with Petitioner’s

proposed schedule) in our analysis of Factor 6. In the absence of any other evidence that bears on Factor 7, we agree with Petitioner that this factor is neutral.

H. Conclusion Regarding General Plastic Factors

Most of the *General Plastic* factors favor exercising our discretion to deny institution, and the others are neutral. Therefore, based on our assessment of these factors, we exercise our discretion to deny institution of an *inter partes* review.

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.

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