

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

AYLO FREESITES LTD,
Petitioner,

v.

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

IPR2024-00940
Patent 11,991,234 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER

Initiating *Sua Sponte* Director Review, Vacating the Final Written Decision,
and Dismissing the Petition

On January 9, 2026, the Board issued an Order (Paper 71) denying Patent Owner’s Motion to Dismiss the Petition for failure to name all real parties in interest (“RPI”). In denying the motion, the Board determined that Petitioner should have identified 9219-1468 Quebec Inc. (“9219”)—a services affiliate of Petitioner and co-defendant in parallel district court litigation involving the challenged patent—as an RPI in the proceeding. *Id.* at 7. Nevertheless, the Board determined that, because the proceeding already had been instituted, *Proppant Express Investments, LLC v. Oren Technologies, LLC*, IPR2017-01917, Paper 86 (PTAB Feb. 13, 2019) (precedential) (“*Proppant*”) governs. *Id.* at 8.

Under *Proppant*, the Board may “accept updated mandatory notices as long as the petition would not have been time-barred under 35 U.S.C. § 315(b) if it had included the [RPI].” *Proppant*, Paper 86 at 7. *Proppant* also explains that in determining whether to accept mandatory notices while maintaining a petition’s original filing date, the Board considers: (1) whether the petitioner has attempted to circumvent the time bar or estoppel rules, (2) petitioner bad faith, (3) prejudice to the patent owner from the delay, and (4) petitioner gamesmanship. *Id.* at 6–7.

The Board subsequently applied *Proppant* and found that there was no evidence that Petitioner attempted to circumvent the time bar or engaged in bad faith or gamesmanship, that there was no prejudice to Patent Owner, and that the appropriate remedy under *Proppant* was to allow Petitioner to update its identification of RPIs while preserving the Petition’s filing date. Paper 71, 7–8. The Board considered Patent Owner’s argument that, under *Corning Optical Communications RF, LLC v. PPC Broadband Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (precedential), the Petition

should not retain its filing date and, thus, the Board was required to dismiss the Petition. *Id.* However, the Board determined that, “to the extent there is a perceived conflict with *Corning Optical, Proppant* governs this post-institution phase.” *Id.* at 8. Petitioner updated its mandatory notices on January 9, 2026, to identify 9219. Paper 72.

Corning Optical explains that, “[u]nder 35 U.S.C. § 312(a)(2), we may consider a petition for *inter partes* review ‘only if . . . the petition identifies all real parties in interest.’” IPR2014-00440, Paper 68 at 23; *see also* 37 C.F.R. § 42.8 (requiring petitioners and patent owners to “[i]dentify each real party-in-interest for the party”). Thus, under *Corning Optical*, “any Petition corrected to disclose additional RPIs must be given a new filing date.” IPR2014-00440, Paper 68 at 23. The Board did not err in relying on *Proppant*. However, in view of my designation of *Corning Optical* as precedential and the requirement of § 312(a)(2) to identify all RPIs, *Proppant* is de-designated as precedential.¹ Thus, Petitioner’s correction to disclose additional RPIs requires according the Petition a new filing date of January 9, 2026. *Id.*

Petitioner admits that 9219 was time-barred under § 315(b) before Patent Owner filed its Motion to Dismiss. Paper 69, 1. The new filing date accorded to the Petition, which is after the filing date of the Motion to Dismiss, results in the Petition being time-barred under § 315(b). As a

¹ For the same reasons, *Adello Biologics, LLC v. Amgen Inc.*, PGR2019-00001, Paper 11 (PTAB Feb. 14, 2019), which grants a petitioner’s motion to amend its mandatory notices while keeping the petition’s filing date, is also de-designated as precedential.

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result, the Board's Final Written Decision (Paper 73) is vacated and the Petition is dismissed.

Accordingly, based on the foregoing, it is:

ORDERED that a *sua sponte* Director Review is initiated;

FURTHER ORDERED that the Board's Final Written Decision (Paper 73) is vacated; and

FURTHER ORDERED that the Petition is dismissed and the proceeding is terminated.

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