UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON WEB SERVICES, INC.
AND AMAZON.COM SERVICES LLC,
Petitioners,

v.

Zentian Limited
Patent Owner.

Case IPR2023-01192
Patent No. 7,587,319

PATENT OWNER'S PRELIMINARY RESPONSE AND CONTINGENT JOINDER OPPOSITION

TABLE OF CONTENTS

I. The Board should not institute and join Amazon's Petition unless Amazon is bound by the same *Sotera* stipulation to which Apple agreed 1

EXHIBIT LIST

Exhibit No.	Description
2001	Amazon's District Court Amended Invalidity Contentions
2002	Scheduling Order in *Zentian Ltd. v. Amazon.com, Inc.,* 6:22-cv-00123 (W.D. Tex.)
2003	Correspondence between counsel for Zentian and Amazon re: *Sotera* stipulation

I. The Board should not institute and grant joinder of Amazon's Petition unless Amazon is bound by the same *Sotera* stipulation to which Apple agreed

Amazon Web Services, Inc. and Amazon.com Services LLC ("Amazon") and Zentian are currently involved in litigation with respect to the '319 Patent before the Western District of Texas. The complaint in that proceeding was served no later than April 25, 2022, more than one year before the date on which Amazon filed its Petition in this proceeding. *Compare Zentian Ltd. v. Amazon.com, Inc.,* 6:22-cv-00123 (W.D. Tex.), Dkt. 15 *with* Paper 2 (Petition filed on July 12, 2023).

Amazon's Petition in this proceeding thus violates the statutory time bar set forth in 35 U.S.C. § 315(b). The Petition therefore cannot be instituted unless the Board grants Amazon's accompanying motion for joinder with respect to IPR2023-00033. *See* § 315(c); Paper 3 (joinder motion).

Moreover, Amazon has served invalidity contentions in the district court proceeding in which Amazon presents many of the same art and arguments raised in its Petition. *Compare* Ex. 2001 at 8-10, 38 (relying on Jiang[1], Thelen, and Bailey) *with* Petition at 6 (relying on same references for Petition's grounds). The district court proceeding is not stayed, and is set for trial on September 23, 2024. Ex. 2002 at 3 (district court scheduling order). Amazon's invalidity expert report is

[1] Amazon's invalidity contentions refers to "Jiang II" for the reference corresponding to Jiang in this proceeding.

due by May 2, 2024, and Zentian's rebuttal report is due on May 30, 2024. *Id.* Meanwhile, the underlying proceeding that Amazon seeks to join is on track for an oral hearing on March 11, 2024, and a final written decision by June 12, 2024.

Accordingly, *Fintiv* factors 1-5 here warrant non-institution and denial of joinder.

Fintiv factor 6 likewise warrants non-institution unless the Board requires Amazon to enter the same *Sotera* stipulation to which Apple agreed, and on which the Board relied, in underlying proceeding IPR2023-00033, which Amazon seeks to join.

In particular, in that proceeding, Apple mooted Zentian's *Fintiv*-based non-institution arguments by committing to "not pursue in the parallel district court proceeding the same grounds as in the Petition or any grounds that could have reasonably been raised in the pending Petition." IPR2023-00033, Paper 9 at 1 (the *Sotera* stipulation). The Board relied on Apple's *Sotera* stipulation as a basis for granting institution. IPR2023-00033, Paper 10 at 6-7. Notably, because Apple provided a *Sotera* stipulation, the Board did not assess Apple's Petition under the "compelling merits" standard that would have applied without Apple's *Sotera* stipulation. *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4 (Feb. 27, 2023) (precedential). "The compelling merits standard is a higher

standard than the standard for institution set by statute." *Id.* at 3. To meet the "compelling merits" standard, the Petition must demonstrate that it is "***highly likely*** that the petitioner would prevail with respect to at least one challenged claim." *Id.* at 3-4 (emphasis added).

But although Amazon's Petition purports to wholly adopt Apple's arguments and positions in IPR2023-00033, *see* Mot. for Joinder (Paper 3) at 2-4, Amazon's Petition and Motion for Joinder do not expressly agree to undertake the *Sotera* stipulation on which Apple relied in order to obtain institution. Indeed, in response to Zentian's inquiry on the issue, Amazon responded that it would not voluntarily provide a *Sotera* stipulation in this proceeding. *See* Ex. 2003 at 1.

But given that Amazon is otherwise time-barred, and that Amazon effectively seeks to enjoy the benefits of joining Apple's instituted proceeding on the same terms and conditions through which Apple obtained institution, it would be unfair and prejudicial to Zentian if Amazon were permitted to join without being bound by the same *Sotera* stipulation to which Apple has agreed, and on which the Board's institution decision relied.

Accordingly, Zentian respectfully requests that the Board only grant Amazon's request for institution and joinder contingent on Amazon being bound by the same *Sotera* stipulation terms as Apple. Otherwise, the Board should deny

institution and joinder as prejudicial and unfair. *See* Trial Practice Guide (2019) at 42 (providing that, in the context of same party and/or issue joinder, the Board will permit joinder "***only*** where fairness requires it and to avoid undue prejudice to a party.").

Respectfully submitted,

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Date: October 12, 2023

CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S PRELIMINARY RESPONSE AND CONTINGENT JOINDER OPPOSITION** specified in 37 C.F.R. § 42.24 have 703 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared using Microsoft Word 365.

/Peter Knops/
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Counsel for Patent Owner

Date: October 12, 2023

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE AND CONTINGENT JOINDER OPPOSITION** was served electronically via e-mail on October 12, 2023, on the following counsel of record for Petitioner:

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