

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

B.S.D. CROWN, LTD.,
Patent Owner.

Case IPR2025-00057
U.S. Patent No. 8,934,887

**PATENT OWNER'S SUR-REPLY IN SUPPORT OF ITS
PRELIMINARY RESPONSE**

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PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Plaintiff’s Preliminary Claim Constructions, Case No. 3:24-CV-03503-JD (N.D. Cal. Jan. 10, 2025)
2002	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Defendants’ Preliminary Claim Constructions, Case No. 3:24-CV-03503-JD (N.D. Cal. Jan. 10, 2025)
2003	Comparison of Districts Within the Ninth Circuit — 12-Month Period Ending December 31, 2024 (available at https://www.uscourts.gov/sites/default/files/2025-02/fcms_na_distcomparison1231.2024.pdf)
2004	Patent Owner’s Power of Attorney
2005	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Defendants’ Invalidity Contentions, Case No. 3:24-CV-03503-JD (N.D. Cal. Dec. 9, 2024)
2006	<i>B.S.D. Crown, Ltd. v. Amazon.com, Inc.</i> , Case No. 3:24-CV-03503-JD, Scheduling Order

As authorized by the Board by email on March 24, 2025, Patent Owner files this Preliminary Sur-Reply in support of its Preliminary Response (“POPR”) and in response to Petitioner’s Preliminary Reply (“Reply”). Contrary to the Reply, the *Fintiv* factors continue to weigh strongly in favor of discretionary denial.

I. The Director or Board Should Deny Institution Under *Fintiv*

A. Factor 1 Favors Denial (Likelihood of Stay)

In arguing that the district court is likely to grant a stay, Petitioner relies exclusively on an unofficial, single-page Docket Navigator tally of Judge Donato’s rulings on stays with the title “Motion Success for Stay Pending IPR (Post-Institution).” Ex. 1042. Petitioner reveals nothing about the status of the five cases in which stays were granted. But three cases located during that period involved *unopposed* stay motions: *Global Touch Sols., LLC v. Toshiba Corp.*, No. 3:15-cv-02746-JD (N.D. Cal., Sept. 16, 2015); *Fujinomaki v. Google, Inc.*, No. 3:16-cv-03137-JD (N.D. Cal., March 27, 2017); and *Realtime Data, LLC v. Apple Inc.*, No. 3:16-cv-02595-JD (N.D. Cal., Mar. 23, 2017). Another case, *Google LLC v. EcoFactor, Inc.*, was in its infancy: the parties had not exchanged initial disclosures and the defendant had not even *filed an answer*. Finally, in *WAG Acquisition, L.L.C. v. Netflix, Inc.*, No. 3:22-cv-05003-JD (N.D. Cal., Mar. 25, 2024), two parallel litigations had already been stayed.

If a motion to stay is filed, Patent Owner intends to oppose based on

Northern District of California precedent. *See Netfuel, Inc. v. Cisco Sys. Inc.*, No. 5:18-cv-02352-EJD, at *2 (N.D. Cal. Feb. 20, 2020) (denying post-institution stay motion); *Haptic, Inc. v. Apple, Inc.*, No. 3:24-cv-02296-JSC, 2024 WL 4859080, at *2-3 (N.D. Cal., Nov. 20, 2024) (examining stage of case, including setting of trial date). As argued in the POPR, Factor 1 favors denial of institution or at least remains neutral.

B. Factor 2 Favors Denial (Timing of Trial)

Fintiv factor 2 weighs in favor of denying institution because district court trial is set to commence on April 6, 2026, two months before the Board's FWD would be expected, on or about June 10, 2026. Petitioner provides only speculation on how and why this Ordered trial date might change in the future. Reply, 1-2. Speculation is not enough to modify this factor. The Board generally takes a court's trial schedule at face value absent strong contradictory evidence, which does not exist here. *See, e.g., Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (PTAB May 13, 2020); *see also Celco Partnership v. Huawei Tech., LLC*, IPR2021-00086, Paper 12 at 11 (PTAB Mar. 22, 2021). Even Petitioner's unscientific Ex. 1044 suggests Judge Donato has held a trial in less time (15.8 months) than set for this case. For these reasons, the district court judge's Order setting the litigation's trial date substantially before any Final Written Decision would issue here weighs heavily in favor of denial. *See* POPR, 28-29.

C. Factor 3 Favors Denial (Investment in Parallel Proceedings)

Petitioner claims that its late *Sotera* statement prevents overlap, but this is false. Petitioner's invalidity contentions include six different non-patent/printed publication systems (Ex. 2005, 7-12), and even reserve the right to "combine any of the references identified together" from Petitioner's invalidity contentions. Ex. 2005, 14. Petitioner has further augmented such district court litigation non-patent/printed publication matter by serving "third party subpoenas on Sony Interactive Entertainment LLC, Activision-Blizzard, Inc., Valve Corporation, Citrix Systems, Inc., VMWare LLC and GenyMobile, Inc." *Id.* at 2. Surely Petitioner would view a combination of the same subject matter relied upon in the Petition with any system reference, even for a minor feature of a claim, to be outside of the *Sotera* stipulation, thus rendering the stipulation ineffective in avoiding overlap between the district court litigation and this proceeding. *See SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 9 (PTAB April 7, 2025) ("Although Petitioner has filed a *Sotera* stipulation, we agree with Patent Owner that the stipulation has limited practical effect in reducing the overlapping efforts here and in the Texas litigation."). Notwithstanding Petitioner's late *Sotera* stipulation, the risk of overlap between Petitioner's evidence in this proceeding and its invalidity theories in the litigation remains high.

Further, Petitioner argues that the “district court’s investment [in the litigation] is minimal,” but this is also incorrect. By the time institution is decided in this IPR, fact discovery will be nearly complete. As of the filing of this Sur-Reply, the parties have collectively issued nearly 120 Requests for Production, 21 Interrogatories, 10 third-party production subpoenas, 7 third-party deposition subpoenas, and fact depositions are in full swing. Moreover, discovery-related motions are also active, with Patent Owner filing a motion to compel discovery, and Petitioner filing a Motion to Strike certain of Patent Owner’s Infringement Contentions and a Protective Order. The above-described investment in litigation does not include the contention and claim construction work described in the POPR. Thus, Factor 3 also favors denial of institution.

D. Factor 4 Favors Denial (Overlap of Issues)

As already noted in Factor 3, Petitioner’s *Sotera* stipulation is not likely to reduce the overlap between this proceeding and district court. Factor 4 also weighs in favor of discretionary denial.

E. Factor 5 Favors Denial (Overlapping Parties)

Petitioner tries to turn Factor 5 into another analysis of the trial date. But even so, a Final Written Decision in this case is not expected until two months after the district court trial, and both the IPR and the district court litigation involve the same parties. Factor 5 weighs strongly in favor of denial.

F. Factor 6 Favors Denial (Other Factors)

For the reasons set forth in the POPR (*see* POPR, 36-38), Factor 6 also weighs in favor of discretionary denial. Moreover, Petitioner's new reliance on Overton fails to tip the scales in its favor. As previously explained in the POPR (*e.g.*, at 15-16), the Petition failed to identify any hardware action data, such as haptics. Notably, Petitioner now, in the Reply stage, modifies the quotation from Overton by putting "incorporating haptic technologies" in brackets, and seemingly admits that the Petition failed to identify this aspect. Petitioner's Reply quotes a portion of Overton that allegedly describes Overton's Fig. 1, and then notes that Fig. 1 (but *not* the quoted portion of Overton) was "reproduced" in the Petition. Plainly, the Petition was unprepared to address this claimed feature. *See, e.g.*, POPR, 15-16. The Petition's failure to address this claimed feature in Overton, and the Reply's failure to identify any on-point argument in the Yoon and Lu grounds for the claimed hardware action, undercuts Petitioner's assertion that the "Petition presents a strong case of unpatentability." Reply, 4.

II. CONCLUSION

For the reasons presented above, the Petition should be denied, and no *inter partes* review should be instituted.

Dated: April 21, 2025

/Wayne M. Helge/

Wayne M. Helge, Reg. No. 56,905

James T. Wilson, Reg. No. 41,439

BUNSOW DE MORY LLP

277 S. Washington St., Suite 210 #1088

Alexandria, VA 22314

T: (571) 208-0186

Email: whelge@bdiplaw.com

Email : jwilson@bdiplaw.com

Counsel for B.S.D. Crown, Ltd.

CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on this date, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

Jessica Kaiser
kaiser-ptab@perkinscoie.com

Jon R. Carter
carter-ptab@perkinscoie.com

Atanas Baitchev
baitchev_ptab@perkinscoie.com

Dated: April 21, 2025

/Wayne M. Helge/
Wayne M. Helge (Reg. No. 56,905)
BUNSOW DE MORY LLP
277 S. Washington St., Suite 210, #1088
Alexandria, VA 22314
Email: whelge@bdiplaw.com
Telephone: 571-208-0186

Counsel for B.S.D. Crown, Ltd.