

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**AMAZON.COM, INC.,
AMAZON.COM SERVICES LLC, and
AMAZON WEB SERVICES, INC.,**
Petitioners,

v.

SOUNDCLEAR TECHNOLOGIES LLC,
Patent Owner.

Case No. IPR2025-00565
Patent No. 11,069,337

**PETITIONERS' OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL**

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I. INTRODUCTION

The Director should reject Patent Owner’s (“PO”) request for discretionary denial. PO’s primary argument is that the Director should decline to institute this IPR because of co-pending district court litigation. *But the district court has stayed that litigation.* In issuing its stay, the district court correctly recognized that it was “relatively early in the litigation” and that the IPRs Amazon filed against the asserted patents would simplify the issues for the court. PO now argues that the Petition should be denied so that the district court will lift its stay and resume litigation, but this argument is contrary to the very purpose of the IPR process.

Congress created the IPR process to provide “a more efficient system for challenging patents that should not have issued” and to reduce “unwarranted litigation costs.” PO’s proposed approach would eliminate this efficiency and needlessly increase litigation costs. Given the early stage of the litigation and its status (stayed), the *Fintiv* factors strongly favor proceeding to the merits of this IPR.

PO also argues that discretionary denial is warranted under §325(d) because the Examiner identified, during prosecution, one of the references relied on in the Petition. But it is clear from the record that the Examiner did not substantively analyze the reference, never applied it in a rejection, and overlooked the most relevant disclosures in that reference. Further, the Petition includes grounds that are based

on different prior art and that do not rely on this reference at all. In such circumstances, discretionary denial under §325(d) is not warranted.

PO also raises a host of procedural arguments, including complaints about hypothesized future claim construction positions, “insufficient notice” of the five Grounds, Amazon’s reliance on expert testimony, and a translation declaration. All of these arguments lack merit and are meant to distract from the core issue: the claims of the ’337 patent are unpatentable. With the co-pending litigation stayed and the Petition making a strong showing that the ’337 patent never should have issued, the Director should reject PO’s request for discretionary denial.

II. DISCRETIONARY DENIAL IS NOT WARRANTED.

A. The *Fintiv* Factors Weigh Against Discretionary Denial.

The Director should decline to exercise discretion under §314(a) because efficiency, fairness, and the merits support institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”). Each *Fintiv* factor is addressed below. Five factors weigh against discretionary denial and the remaining factor is neutral. Thus, discretionary denial is unwarranted.

1. Factors 1 and 2 Weigh Against Denial.

Factor 1 considers whether a stay exists or is likely to be granted if a proceeding is instituted, and Factor 2 considers the proximity of the district court’s trial date to the Board’s projected statutory deadline. *Fintiv*, IPR2020-00019, Paper 11 at 6-

9. Here, the district court case is stayed and there is no trial date set. (EX-1103, 41:24-42:1.) Thus, Factors 1 and 2 weigh strongly in favor of denying PO’s request. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00819, Paper 15 at 9 (P.T.A.B. Oct. 21, 2020) (precedential) (presence of a stay “weighs strongly against exercising discretion to deny institution”); *Micron Tech., Inc. v. Yangtze Memory Techs. Co., Ltd.*, IPR2025-00117, Paper 19 at 11 (P.T.A.B. June 4, 2025) (same).

Despite the stay, PO argues that Factor 1 is “neutral at best” (Paper 6 (“PO Req.”) at 55) and that Factor 2 favors denial because, *if institution is denied*, the stay will be lifted, and the case “will proceed to trial by January or February 2026”—before the September 2026 deadline for the final written decision in this IPR (*id.* at 10-13). This argument is speculative and the Board has rejected similar arguments.

In *Snap*, the Board explained that arguments about what a district court would do if institution is denied amount to “unfounded speculation as to how the court might proceed.” *Snap*, IPR2020-00819, Paper 15 at 9 (rejecting arguments regarding potential trial date based on schedule set by the court before the stay). Rather, because “the District Court’s stay of the litigation pending denial of institution or a final written decision allays concerns about inefficiency and duplication of efforts[,]” the presence of a stay “weighs strongly against exercising discretion to deny institution.” *Id.*; *see also id.* at 18 (declining to exercise discretion to deny institution). The same is true here.

PO's assertion that trial would occur in January or February 2026 is speculative. PO relies on time-to-trial statistics for Judge Trenga that include no patent cases. (PO Req. at 11 (relying on EX-2005); EX-2005 (showing statistics for 59 trials presided over by Judge Trenga); EX-1101 at 2-6 (listing Judge Trenga's 59 trials and showing none were patent cases).) According to Lex Machina, PO's source for statistics, Judge Trenga has never held a patent trial. (EX-1101 at 1.) And PO's case against Amazon has not followed the typical timing of Judge Trenga's non-patent cases. When the court stayed the case on March 26, 2025, the case had been pending for eight months—nearly as long as Judge Trenga's median time-to-trial of roughly 9.5 months. Yet, only Amazon's first motion to dismiss and motion to transfer had been decided. PO had filed a second amended complaint and Amazon's motion to dismiss that complaint was still pending. Even if the stay were to be lifted, that pending motion may take months to resolve. Fact discovery, expert discovery, claim construction briefing, and dispositive motions would still lie ahead. Thus, it is highly unlikely that the litigation would proceed to trial in January or February 2026 as PO contends.

Factors 1 and 2 therefore strongly favor denying PO's request. *Snap*, IPR2020-00820, Paper 15 at 8-9; *Micron*, IPR2025-00117, Paper 19 at 11-12.

2. Factor 3 Weighs Against Denial.

Factor 3 considers the investment in the parallel proceeding by the court and the parties. *Fintiv*, IPR2020-00019, Paper 11 at 9-12. “This investment factor is related to the trial date factor, in that more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.* at 10. As part of this factor, the Office may consider whether the district court has issued a claim construction order or other substantive orders related to the patent-at-issue in the petition. *See id.* at 10, 10 n.17.

a. The Litigation Is in its Early Stages.

The district court litigation is still in its pleading stage, with PO recently filing two amended complaints. (*See* EX-2001 at 13-14 (Dkt. 89, Dkt. 96).) A motion to dismiss is still pending. PO has produced less than 100 documents and the parties have not started claim construction briefing. (EX-1102 at ¶4; *see* EX-2001.) No claim construction hearing is scheduled and no expert discovery has occurred. (*See* EX-2001; *see also* EX-1102 at ¶¶3-6.) As the district court itself recognized when it issued the stay, it is “relatively early in the litigation.” (EX-1103 at 40:21-41:6.)

Under such circumstances, this factor weighs against denial because the remaining investment that would be required to bring the litigation to trial “far outweighs” the investments that have already been made in the litigation. *Snap*,

IPR2020-00820, Paper 15 at 11 (“Where the District Court has not issued claim construction orders and the discovery process is not yet complete, the remaining investment of time and effort likely necessary to bring co-pending litigation to trial appears to far outweigh that which has already been invested.”).

Also, little risk of duplicative costs exists in this case. With the litigation stayed, if any claims were to survive this IPR and the litigation were to resume after the Board’s final written decision, Amazon would be estopped from arguing invalidity based on any ground raised in this IPR or that reasonably could have been raised. 35 U.S.C. §315(e)(2).

Lastly, Amazon promptly filed its petition. Amazon filed the Petition less than a month after the district court vacated its prior order dismissing the ’337 patent, and six months before the statutory deadline for filing an IPR. *See Micron*, IPR2025-00117, Paper 19 at 12-13 (*Fintiv* factor 3 weighs against denial even with “a non-trivial level of effort” expended in the district court because of the petitioner’s “expeditious filing of the Petition”).

Thus, this factor weighs against discretionary denial.

b. Amazon’s Motions Do Not Justify Discretionary Denial.

PO argues that this factor favors denial because Amazon “prioritized at least nine substantive, fact-specific, dispositive issues” in the district court prior to filing

an IPR. (PO Req. at 13-15.) PO alleges these motions amount to a “unilateral, sequential approach designed to favor [] Amazon.” (*Id.*) They do not.

What PO alleges are “nine substantive [] issues” are just three routine motions. PO filed its original complaint in July 2024. (EX-2001 at 1 (Dkt. 1).) Amazon filed a motion to dismiss for failure to state a claim because the asserted patents are invalid under 35 U.S.C. §101 and because the complaint failed to state a plausible claim of infringement. (EX-1104 at 3.) In November 2024, the district court found the patents invalid under §101 and entered judgment in Amazon’s favor without addressing the infringement issues. (EX-1008 at 16.) In January 2025, the district court reconsidered and reversed its ruling on §101 for the ’337 and ’675 patents based on alleged factual disputes, and allowed PO to file an amended complaint. (EX-1014 at 3.)

On January 24, 2025, PO filed its first amended complaint. (EX-2001 at 13 (Dkt. 89).) Just one week later, Amazon filed its Petition in this IPR. (Paper 1 (“Pet.”) at 74.)

On February 3, 2025, PO filed a second amended complaint. (EX-2001 at 14 (Dkt. 96).) On February 18, 2025, Amazon moved to dismiss the second amended complaint on the issue that the court did not previously reach (non-infringement). (*See* EX-1105.) That motion was still pending when the district court stayed the

litigation on March 26, 2025. Thus, the court has not invested any time analyzing infringement issues or invalidity issues under §§102 or 103.

The only other motion Amazon filed was a motion to transfer the case to a venue that is more convenient for the parties and witnesses. (*See* EX-1106.) That procedural motion had nothing to do with the substance of the '337 patent.

The filing of routine, well-founded motions at the outset of the litigation does not warrant denial of this IPR. That is especially true where the issues raised in the district court—invalidity under §101 and noninfringement—could not be raised in an IPR and are appropriately addressed by the district court at the pleading stage. *Toast, Inc. v. Gratuity, LLC*, IPR2023-01408, Paper 11 at 8-10 (P.T.A.B. Mar. 27, 2024) (*Fintiv* factor 3 favors institution even where district court has resolved motion to dismiss under §101); *see* Fed. R. Civ. P. 12(b)(6) (motions for failure to state a claim upon which relief can be granted “must be made before pleading if a responsive pleading is allowed”); *Prod. Grp. Int’l, Inc. v. Goldman*, 337 F. Supp. 2d 788, 800 (E.D. Va. 2004) (“a motion to transfer venue must be brought at an early stage in litigation.”).

c. PO’s Speculation Regarding Future Claim Construction Proceedings Lacks Merit.

PO argues that there is a risk of “duplicative efforts” and “conflicting decisions” because PO speculates that Amazon will take “diametrically opposite claim construction approaches” before the PTAB and the district court. (PO Req. at 16-

23.) PO speculates that Amazon may seek to apply broad constructions in the IPR and narrow constructions in the litigation. (*Id.* at 16.) This argument fails for many reasons.

First, *Fintiv* factor 3 considers the court’s and the parties’ investment in the litigation, not the substance of the arguments being made. *Fintiv*, IPR2020-00019, Paper 11 at 9-12; *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00124, Paper 11 at 11-13 (P.T.A.B. June 15, 2023) (“[w]e are not persuaded that this issue bears on *Fintiv* factor 3”). One party’s speculation about what positions another party *may* take *if* the litigation were to resume are irrelevant. With respect to claim construction, the Office may consider whether the district court has issued a claim construction order (or other substantive orders related to the patent), but it is undisputed that the district court has not issued any claim construction order in the co-pending case. (*Supra* §II.A.2.a.) And, the only substantive order it has issued relating to the challenged patent is a preliminary §101 decision, which has no relevance to the invalidity arguments raised in this IPR proceeding.

Second, PO speculates that Amazon will seek contradictory constructions but offers no evidence supporting this speculation. (PO Req. at 16-23.) The statements PO cites from the litigation simply show that Amazon expects some claim construction to occur in district court, not that any of Amazon’s positions in district court will contradict any position here. (*Id.*)

Third, PO's argument is based on a misunderstanding of when claim construction is necessary. It is entirely possible (even likely) that no claim construction is needed to resolve the invalidity issues in an IPR, but claim construction is necessary to resolve infringement issues in the district court. *See, e.g., Chanel, Inc. v. Molo Design, Ltd.*, IPR2022-00543, Paper 7 at 9-10 (P.T.A.B. Aug. 12, 2022). Amazon provided one example where this would be possible, and PO does not dispute that it would be appropriate in that case. (PO Req. at 18.) Many other examples exist. For example, if a claim limitation recited "about 50 mg" of a certain ingredient, no construction would be necessary in an IPR where the prior art expressly disclosed using exactly 50 mg of the ingredient. But that same limitation might require construction in a litigation if the accused product included 52.2 mg of the ingredient. Because the issues before the district court differ from the issues in this IPR, it is possible for disputes that are immaterial in this IPR to require claim construction in the district court. But this possible need for claim construction in the district court does not show any contradiction in Amazon's positions.

Fourth, PO argues that "there is no law that allows Amazon to apply a favorable claim scope on invalidity but to turn around and seek to apply narrower scopes [sic] for purposes of non-infringement." (*Id.* at 23.) PO is incorrect. *CrowdStrike*, IPR2023-00124, Paper 11 at 12-13 ("nothing inherently wrong" with requesting IPR on broader construction than positions in district court). Regardless, this has not

happened. To the extent any claim survives this IPR and the litigation resumes, and PO believes that Amazon is contradicting itself, PO can raise that issue with the district court. The district court can then adopt the correct claim construction in view of the full IPR record, which will form part of the patent’s prosecution history. *See Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1361 (Fed. Cir. 2017).

Developing the full IPR record is the best way to prevent all parties from taking contradictory positions. As PO admits, the claims must be construed consistently for invalidity and non-infringement. Developing a complete record of any claim constructions that PO attempts to advance in this IPR to avoid invalidity will ensure that the district court has all the information it needs to ensure consistency.

d. Amazon Is Not Seeking an “Advisory Opinion.”

PO argues that Amazon is seeking an “advisory opinion” from the Board because the Board would issue a final written decision “without knowing whether or how any claim terms will later be construed before the district court.” (PO Req. at 23-24.) But district court litigation is routinely stayed so that the Board, which is well qualified to construe claims, can do so and render a decision on validity. Indeed, district courts often stay cases specifically so they can obtain the benefit of the Board’s expertise. *E.g., Intirion Corp. v. College Prods., Inc.*, No. 5:23-cv-04023, 2024 WL 3747178 at *4 (N.D. Iowa Aug. 9, 2024) (“Courts have observed that it is often prudent for a court to await the [USPTO’s] reassessment of the patents at issue

before resuming litigation over the validity, enforceability, or infringement of those patents.” (internal quotation marks omitted)).

To the extent any claims survive, the district court will have the benefit of the IPR record—both the Board’s expertise and the parties’ arguments—when resolving any further claim construction issues that may be relevant to the litigation. *See id.* Indeed, the district court specifically acknowledged that any claim construction that occurs in this IPR will help simplify the issues before the Court if the litigation were to later resume. (EX-1103 at 41:7-15 (“Whether ... claims are construed ... would certainly affect what is going to be before this Court to ultimately adjudicate.”).)

In sum, *Fintiv* factor 3 weighs against discretionary denial.

3. Factor 4 Weighs Against Denial.

Factor 4 considers the overlap between issues raised in the petition and in the parallel proceeding. *Fintiv*, IPR2020-00019, Paper 11 at 12-13. Where a petition includes the same or substantially the same claims, grounds, arguments, and evidence presented in the co-pending district court litigation, there may be “concerns of inefficiency and the possibility of conflicting decisions.” *Id.*

Here, the district court case is stayed and, if any challenged claims were to survive this IPR, Amazon would be statutorily estopped from raising in the litigation any grounds that were raised or reasonably could have been raised in the Petition.

35 U.S.C. §315(e)(2). Thus, the stay obviates concerns of inefficiency and the possibility of conflicting decisions. *Snap*, IPR2020-00820, Paper 15 at 15-16 (stay of litigation “obviat[es] concerns of inefficiency and conflicting decisions while providing the possibility of simplifying issues for trial in the parallel District Court proceeding”); *Fintiv*, IPR2020-00019, Paper 11 at 6 (a stay “allays concerns about inefficiency and duplication of efforts”).¹

PO argues that discretionary denial is appropriate because the IPR would not be “dispositive of all factual or technical issues that might arise[.]” (PO Req. at 24.) But PO cites no authority for its proposition that an IPR must be dispositive of “all factual or technical issues” for this factor to weigh against denial.

PO also argues that Amazon’s *Sotera* stipulation is “not particularly meaningful” in light of FAQ 14. (*See id.* at 26.) That FAQ states that “[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.” But that is not the case here. Amazon’s invalidity grounds in the district court proceeding do not rely on “corresponding” system art, but rather physical prior art devices independent

¹ Even if the case had not been stayed, Amazon’s *Sotera* stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020).

from the patent and printed publication prior art that it relies on in the Petition. Nor is this a case where Amazon expects to rely primarily on patent and printed publication prior art in combination with a generic physical prior art device; instead, the record shows that physical prior art devices practiced all or nearly all of the limitations of the challenged claims. (*See* EX-1002 at ¶35.)

Furthermore, the Board has rejected PO’s *Sotera* argument. As here, where “the present case does not involve ‘substantial investment’ in the District Court Litigation per *Fintiv* factor 3 ... even discounting the weight of Petitioner’s *Sotera* stipulation as the Director did [in *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025)], ... the *Fintiv* factors as a whole indicate that the efficiency and integrity of the patent system are best served by instituting review.” *Liberty Energy, Inc. v. U.S. Well Svcs., LLC*, IPR2025-00031, Paper 9 at 18-19 (P.T.A.B. Apr. 29, 2025); *see also Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01374, Paper 19 at 20-22 (P.T.A.B. Apr. 29, 2025) (“even considering the presence of system art as a mitigating factor in favor of Patent Owner, we still find that the *Sotera* stipulation significantly reduces the overlap between the district court litigation and this IPR”).

Given the stay of the district court litigation, Amazon’s *Sotera* stipulation, and the estoppel that will apply upon issuance of a final written decision, there will be minimal overlap—if any—between the invalidity issues addressed by the Petition

and those Amazon will raise in the district court proceeding if any claims survive IPR and the litigation resumes. *See Snap*, IPR2020-00820, Paper 15 at 13-16. And, any overlap may benefit the district court’s analysis of what remains. *Id.*; *MED-EL Elektromedizinische Geräte GmbH v. Sonova AG*, IPR2020-00176, Paper 13 at 15 (P.T.A.B. June 3, 2020) (overlap “may inure to the district court’s benefit ... by simplifying issues for trial”). Thus, *Fintiv* factor 4 weighs against discretionary denial.

4. Factor 5 Is Neutral.

Factor 5 considers whether the parties are the same. *Fintiv*, IPR2020-00019, Paper 11 at 13-14. Where the parties are the same, the Board has held that this factor is “neutral or, at most, weighing slightly in favor of exercising discretion to deny institution.” *Snap*, IPR2020-00820, Paper 15 at 16. Regardless, this factor does not outweigh the other *Fintiv* factors, which weigh strongly against discretionary denial. *Id.*

5. Factor 6 Weighs Against Denial.

Factor 6 considers “other circumstances” that impact discretionary denial, such as the merits of the petition. *Fintiv*, IPR2020-00019, Paper 11 at 14-16. This factor weighs against discretionary denial because the merits of the Petition are strong. PO’s contrary arguments fail.

**a. Shin and Shimomura Each Disclose
“Classifying a Voice.”**

Claim element 1[b] recites “a voice classifying unit configured to analyze a voice spoken by a user and acquired by a voice acquiring unit to *classify the voice as either one of a first voice or a second voice based on the distance between the user and the voice-content control device.*” PO argues that neither primary reference—Shin or Shimomura—“expressly mentions classifying voices.” (PO Req. at 28.) But as the Petition explains, Shin and Shimomura classify a voice in exactly the same way as the ’337 patent.

As Amazon explained, the ’337 patent merely describes setting a threshold distance and then classifying a voice as a “first” voice or a “second” voice based on whether the distance exceeds the threshold. (Pet. at 11; EX-1001 at 8:20-34.) Similarly, the prior art relied on in the Petition sets threshold distances and classifies the voice based on whether the distance exceeds the threshold. Those references need not refer to the classifications as a “first” voice and a “second” voice to disclose the claim limitation; they merely need to disclose classifying the voice into two or more groups based on distance. *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 910 (Fed. Cir. 2022) (prior art “need not disclose the elements in the very same terms used by the patent”). Both Shin and Shimomura disclose the limitation.

Shin’s device obtains a user’s speech as a voice input and analyzes the acquired voice signal to determine the “output scheme,” which includes the content

and volume level of the output. (EX-1003 at ¶¶[0078], [0086]; Pet. at 13.) Shin determines the content and volume level to output by classifying the voice based on the distance between the user and the device. (EX-1003 at ¶¶[0053], [0078], [0086]; Pet. at 13.) Shin outputs different content depending upon the user-to-device distance, which is shown below in Table 3:

TABLE 3		
	Distance (D) between user and electronic device	Output amount of information of content
First Voice	$D < 1\text{ m}$	Amount of information of original content
	$1\text{ m} \leq D < 2\text{ m}$	Content of first abbreviation level
	$2\text{ m} \leq D < 3\text{ m}$	Content of second abbreviation level
	$3\text{ m} \leq D < 4\text{ m}$	Content of third abbreviation level
Second Voice	$D \geq 4\text{ m}$	Content of fourth abbreviation level (abstract content)

(EX-1003 at Table 3 (annotated); Pet. at 14.) Shin therefore discloses classifying voices into groups based on thresholds (e.g., voice less than 1 meter away, voice 4 or more meters away, etc.), and therefore discloses classifying the voice as a “first voice” or “second voice” in exactly the same way as the ’337 patent.

Although PO criticizes Amazon and its expert for annotating the figures to show which classifications can be considered the “first voice” and “second voice” recited in the claim, such annotations are routine in IPR petitions to help the Board in understanding a petitioner’s ground and in expert declarations to help show how

a POSITA would have understood a reference. And, contrary to PO’s suggestion, Amazon expressly explained that the figures had been “annotated for clarity.” (Pet. at 4 n.1.)

Shimomura also discloses claim element 1[b]. Shimomura discloses an electronic device, such as a robot. (EX-1004 at ¶¶[0020]-[0022], [0096]; Pet. at 36.) Shimomura changes the content spoken by the robot and the volume of the response “according to the distance to the conversation partner.” (EX-1004 at ¶¶[0058], [0067]-[0070], [0060]-[0063], [0073]-[0084]; Pet. at 39.) An example of Shimomura classifying the voice based on distance (less than 350 cm v. 350 cm or more) is shown below in Figure 7:

[FIG. 7]

Second Voice	First Voice
Less than 350 cm	350 cm or more
None	Implementation

(EX-1004 at Fig. 7; Pet. at 40.) Thus, Shimomura classifies the received voice into two categories based on a distance threshold (e.g., a first voice if more than 350 cm away and a second voice if less than 350 cm away) in the same way as described in the ’337 patent.

Thus, PO’s arguments that the merits are “weak” (PO Req. at 27) because the prior art references purportedly fail to disclose classifying a voice as a first voice or

a second voice is incorrect. The prior art discloses the same voice classification that the '337 patent requires.

b. Shin and Shimomura Are Not “Deficient in Other Respects.”

As discussed below (*infra* §II.B.2), the Examiner failed to properly consider Shin. PO argues that Shin “lacks the voice classification limitations,” citing a single paragraph of Shin. (PO Req. at 30 (citing EX-1003 at ¶[0039]).) As discussed above and as set forth in detail in the Petition, Shin plainly discloses classifying voices into categories based on the user-to-device distance—disclosure PO completely fails to address. (Pet. at 11-14 (citing EX-1003 at Abstract, ¶¶[0003]-[0011], [0029], [0041], [0045], [0047]-[0048], [0051], [0053], [0060]-[0062], [0077]-[0081], [0086]-[0087], [0155], [0158], claims 1, 6, 15, 17, 20, Tables 1, 3, Fig. 3).)

PO also argues that Shin is cumulative of another reference (“Tsai”) considered by the Examiner. (PO Req. at 31.) But that argument is based on PO’s superficial comparison of Shin’s Figures 1A and 1B to Tsai’s Figure 1, which merely show voice inputs to a device and responses from the device. (*Id.*) Such a superficial comparison does not show that the references are cumulative with respect to their disclosures of the subject matter of the challenged claims. For example, PO identifies nothing in Tsai that discloses classifying a voice based on distance and altering the content of an output response based on that distance, as shown in Shin’s Table 3. Thus, PO’s criticisms of Shin fail.

PO also argues that Shimomura is deficient. (*Id.*) But PO admits that Shimomura discloses altering voice response “according to the distance between the device and the user.” (*Id.* (emphasis omitted).) That is precisely what the ’337 patent claims are about. Thus, PO’s brief confirms the strong merits of the Petition.

PO’s assertion that Amazon “relies solely on expert testimony to attempt to disclose classifying voices based on distance” (*id.* at 31-32) is incorrect. PO cites an introductory sentence that explains that Shimomura discloses classifying voices based on distance. (*Id.* (citing Pet. at 39; EX-1002 at ¶138).) But the sentences that follow explain *how* Shimomura discloses classifying a voice based on distance with ample citations and quotations. (*See, e.g.*, Pet. at 39-40 (citing EX-1004 at ¶¶[0036]-[0037], [0046], [0058], [0060]-[0064], [0067]-[0070], [0073]-[0084], Abstract, claims 1-24, Figs. 4, 7).) And, Petitioner’s expert explained how Shimomura’s disclosure would have been understood by a POSITA to disclose the relevant claim limitations. (*See, e.g.*, EX-1002 at ¶¶137-40.)

PO also argues in conclusory fashion that Shimomura fails to disclose the “omission of information” limitation. (PO Req. at 32.) This appears to be a reference to claim element 1[g], which recites “generat[ing] a second output sentence in which *information is omitted* as compared to the first output sentence as the output sentence when the acquired voice has been classified as the second voice.” But as

the Petition explains, Shimomura discloses omitting information in precisely the same way as the '337 patent. (Pet. at 44-56.)

PO's assertion that Shimomura's omission of "ne" is not an omission of information is incorrect. Shimomura discloses inserting and omitting words such as "ne" after "each phrase end" and that "words other than 'ne' can be used as words to be inserted after each phrase end." (EX-1004 at ¶[0092].) Thus, Shimomura discloses omitted information in precisely the same way as the '337 patent.² The strength of the Petition's merits weighs against discretionary denial. *Fintiv*, IPR2020-00019, Paper 11 at 14-16, 15 n.29 (collecting cases).

c. The Petition Provides Notice of the Grounds.

PO next argues that Amazon conflates "obviousness and anticipation" and that Amazon's grounds are "stated in a shrouded and inseparable manner." (PO Req. at 32, 34.) But they are not. Amazon clearly identifies its invalidity references and statutory basis in a chart at the beginning of its Petition:

² Shimomura does not equate inserting and omitting "ne" or other words with a "change[] in intonation," as PO argues. (PO Req. at 32.) Rather, Shimomura discloses *both* a change in intonation and inserting or omitting words as separate embodiments. (EX-1004 ¶[0092].)

Ground	Reference(s)	Basis	Challenged Claims
1	Shin	§102	1-5
2	Shin	§103	1-5
3	Shimomura	§103	1-5
4	Shimomura and Shin	§103	1-5
5	Shin and/or Shimomura in view of Kristjansson	§103	1-5

(Pet. at 6.)

Based on PO’s citations, its complaints about “improper” invalidity grounds are directed to Grounds 4 and 5. (PO Req. at 32 (citing Pet. at 1, 59, 62, 64-65, 69).) In particular, PO complains about the language “disclose and render obvious” (PO Req. at 32) in sentences like “Shimomura and Shin individually disclose and render obvious all limitations of claim 1 as discussed for Grounds 1-3” (Pet. at 59). But this sentence, and others that PO identifies, explains that the previous grounds, Grounds 1-3, describe how Shin and Shimomura disclose the limitations or render them obvious in a single-reference obviousness ground. In each of Grounds 1-3, the Petition identifies where the element is disclosed in the art or explains why the element would have been obvious. For example, in Ground 2, Amazon explains that if claim 1 requires classifying the voice into no more than two classifications based on distance, Shin renders this limitation obvious and explains why. (Pet. at 30-32.)

Ground 4 combines primary reference Shimomura with secondary reference Shin. (Pet. at 59-61.) Contrary to PO’s complaints, the Petition explicitly identifies what it is combining from Shin with Shimomura. For example, the Petition explains that Shimomura discloses all limitations of claim 1 (*id.* at 35-53 (Ground 3)), but does not explicitly specify that the output sentences have different volumes as recited in element 1[h]. (*Id.* at 47.) The Petition explains how a POSITA would have found it obvious to modify Shimomura to include this feature based on Shimomura’s disclosure alone. (*Id.* at 47-53.) The Petition then describes, in Ground 4, the relevant disclosure from Shin and why the modification to Shimomura also would have been obvious in view of Shin’s disclosure. (*Id.* at 59-64.)

Ground 5 combines Kristjansson with Shin and/or Shimomura. (*Id.* at 65.) The Petition explains that, to the extent Shin and/or Shimomura do not disclose the “process executing unit” limitations (e.g., claim limitations 1[c], 2[a], 4[d], and 5[d]), “Kristjansson discloses those limitations and renders the claims obvious.” (*Id.*) In other words, to the extent PO argues that any of the grounds—anticipation by Shin (Ground 1), obviousness over Shin (Ground 2), obviousness over Shimomura (Ground 3), or obviousness over Shimomura in view of Shin (Ground 4)—do not disclose the “process executing unit,” those limitations would have been obvious over any of those Grounds in further view of Kristjansson. (*Id.*;

EX-1002 at ¶¶216-23.) The Petition explains how Kristjansson discloses the “process executing unit” and why a POSITA would have combined the “process executing unit” with Shin or Shimomura. (Pet. at 65-68.)

The Petition identifies where elements are disclosed, or alternatively explains why such element is obvious if the PO argues the element is missing in the art. The Petition does not conflate anticipation or obviousness. Moreover, as described below, the Petition analyzes the *Graham* factors. (*Infra* §II.A.5.e.) Thus, contrary to PO’s arguments, the Petition does not provide improper groupings.

PO’s argument that Amazon has not described its obviousness combinations for Ground 5 with particularity similarly fails. (PO Req. at 34-36.) As explained above (and in the Petition), Ground 5 merely adds Kristjansson to the earlier grounds if PO argues that a particular limitation is missing from the references in Grounds 1-4. The Petition clearly explains the combination and identifies specific teachings in specific prior art references that disclose specific elements of the challenged claims. (Pet. at 65-68.) This is all that is required. *E.g.*, *Chanel*, IPR2022-00543, Paper 7 at 6-8 (“we reject the notion that [petitioner’s] use of ‘and/or’ when listing its challenges in an abbreviated format” is improper where there are “detailed explanation[s] of those challenges elsewhere in the Petition”).

d. Amazon’s Expert Declaration Is Proper.

PO argues that Amazon’s expert declaration is entitled to little or no weight because it merely restates the Petition. (PO Req. at 27, 36-37.) PO is both factually and legally incorrect.

As a factual matter, the expert declaration is not a verbatim copy of the Petition. Amazon’s expert declaration provides Dr. Stern’s testimony based on his knowledge, experience, and reading of the references. For example, in Paragraph 111 of his declaration, Dr. Stern explains that “[a] person of ordinary skill in the art would have recognized binary classification as an efficient, user-friendly solution for Shin’s described needs.” (EX-1002 at ¶111.) He supports this with his personal experience: “For example, many systems developed in my own work rely on binary classification such as detecting the presence or absence of speech (*e.g.*, Vuong et al., 2021, 2023) or determining whether the source of detected speech is actually a person in the room or a recording (*e.g.*, Lindsey et al., 2023).” (*Id.*) Similarly, in Paragraph 123, Dr. Stern supports his obviousness statement with reference to findings by his own research group. (*Id.* at ¶123.) Dr. Stern’s declaration is detailed and the factual bases for his opinions are thoroughly explained.

Even if Amazon’s expert declaration did mirror the Petition, that would not be sufficient to give it “little or no weight” as PO contends. PO relies on *Xerox*, but the Board has explained that the expert testimony in *Xerox* was entitled to little

weight because it was “conclusory and lacking supporting evidence or technical reasoning.” *Unified Patents, LLC v. Togail Techs., Ltd.*, IPR2023-00338, Paper 7 at 11 (P.T.A.B. Aug. 18, 2023). The Board does “*not* accord the [expert] testimony little or no weight simply because it is verbatim to what Petitioner states in the Petition. The *Xerox* case ... does not require or indicate otherwise.” *Id.* (emphasis added); *see also Amazon.com, Inc. v. Nokia Techs. OY*, IPR2024-00691, Paper 10 at 65-66 (P.T.A.B. Sept. 24, 2024).

“Rather, the critical inquiry is whether a declaration discloses underlying facts or data on which the opinion is based.” *Bizlink Tech., Inc. v. Anderson Power Prods., Inc.*, IPR2024-00687, Paper 7 at 27-28 (P.T.A.B. Nov. 22, 2024). As explained above, this is exactly what Amazon’s expert declaration does. The declaration discloses, in detail, the underlying facts (e.g., the disclosures in the references, the expert’s knowledge and experience, etc.) on which his opinions are based. Thus, it is entitled to its full weight. *See Hum Indus. Tech., Inc. v. Amsted Rail Co., Inc.*, IPR2023-00540, Paper 10 at 37 (P.T.A.B. Aug. 11, 2023) (“If declaration testimony is supported sufficiently and, in turn, supports contentions in the Petition, we do not give it little to no weight simply because it is repeated in the Petition[.]”); *Nintendo Co., Ltd. v. Am. GNC Corp.*, IPR2024-00668, Paper 10 at 42-43 (P.T.A.B. Sept. 10, 2024). Indeed, the Board has recognized that it is logical for the Petition and the expert declaration to be similar as the expert declaration supports the invalidity

grounds in the Petition. *Hum*, IPR2023-00540, Paper 10 at 37 (finding overlap results from the petition citing the expert declaration without any deviation from the matters to which the expert testifies); *Nintendo*, IPR2024-00668, Paper 10 at 42 (same).

**e. The Petition Analyzed Obviousness under the
Graham Factors and *KSR*.**

PO next argues that the Director should deny institution because Amazon did not address the *Graham* factors and *KSR*. (PO Req. at 37-42.) This is incorrect.

The Supreme Court has set out four factors for analyzing obviousness: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations of non-obviousness. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). The Petition addresses these factors.

The vast majority of the Petition is dedicated to analyzing the “scope and content” of the prior art references upon which Amazon relies. And, where any differences between the prior art and the claims exist—or potential differences that PO may argue exist—the Petition addresses those differences by showing why any modification would have been obvious. (*See, e.g.*, Pet. at 59-68.) The Petition also addressed the level of skill in the art (*id.* at 7 (citing EX-1002 at ¶¶30-34) and secondary considerations (*id.* at 68).

PO claims that the Petition does not identify any “gaps” in the prior art and therefore does not adequately address the second *Graham* factor. (PO Req. at 37-38.) But the Petition analyzes the differences, if any, between the claimed invention and the prior art. *See Aruba Networks, LLC v. Sipco, LLC*, IPR2021-00787, Paper 7 at 16-17 (P.T.A.B. Oct. 12, 2021) (*Graham* factor 2 satisfied where a petitioner “explains what features of [the references] it relies on and points out where the primary reference may not teach a feature and, in that case, explains what features of the supporting references it relies on and how they are to be combined”). For example, the Petition explained in Ground 2 that if the claims required no more than two classifications of the voice based on distance, that element would have been obvious over Shin. (Pet. at 30.) In other words, to the extent that the claim required two classifications, and such disclosure was not in Shin, then it would have been obvious as described in Ground 2. As another example, in Ground 3, the Petition explains that Shimomura “does not specify that the output sentences have different volumes.” (*Id.* at 47.) The Petition continues by explaining that such element would have been obvious to a POSITA under a *KSR* analysis. (*Id.* at 47-49.)

PO raises four criticisms about the obviousness analyses in the Petition. Although Petitioner addresses PO’s attorney argument here, Petitioner notes that these arguments merely reflect PO’s disagreement with Amazon’s expert. The Board should resolve these disputes after a full trial.

First, PO incorrectly argues that the Petition “provides purely conclusory obviousness statements.” (PO Req. at 39.) Both the Petition and Amazon’s expert thoroughly address every limitation and, where obviousness is argued, provide specific rationales as to why a POSITA would have been motivated to modify the primary reference or combine the references’ teachings. For example, in Ground 3, the Petition identifies *six* motivations to modify Shimomura to have output sentences with different volumes. (Pet. at 48-50.) The Petition also explains that a POSITA would have expected to succeed in such modification because it was trivial. (*Id.* at 50-52.) The reasoning is not mere boilerplate, but rather a full analysis of why the claims would have been obvious to a POSITA.

If PO believes that the obviousness rationales lack merit or that a POSITA would have not been so motivated, PO should submit testimony from an expert during the trial phase and that expert will be subject to cross-examination. PO’s attorney argument is no substitute for competent evidence.

PO’s second and third arguments are that Amazon fails to show that any results would have been predictable or that a POSITA would have had a reasonable expectation of success. Again, these portions of the Petition are supported by sworn testimony of Amazon’s expert, whom PO will have an opportunity to cross-examine during the trial phase. If PO believes that the results would not have been predictable

or that a POSITA would not have had a reasonable expectation of success, then it can submit testimony from its own expert and the Board can resolve those disputes.

Fourth, PO argues that the Petition’s analysis of the level of ordinary skill in the art is insufficient. (PO Req. at 42.) But Amazon’s expert explained the level of skill in the art in his declaration. (EX-1002 at ¶¶30-34.) Moreover, the expert explained the background in the art, including what information was known at the time. (*Id.* at ¶¶35-44.) Thus, Amazon met its burden.

PO’s cases do not support PO’s argument. In *Ex Parte Jud*, the Board of Patent Appeals and Interferences concluded the examiner met her burden to prove the skill level because she outlined “what one would know from references[.]” *Ex Parte Jud*, No. 2006-1061, at 9 (B.P.A.I. Jan. 30, 2007). In *Dionne*, the Board of Patent Appeals and Interferences similarly explained the level of skill should be supported by “standard texts and other publicly available documents[.]” *Dionne v. Liotta*, Int. No. 104, 333, 2001 WL 37113864 at *4 (B.P.A.I Oct. 31, 2001). These cases comport with the Board’s approach in the IPR context, where the level of ordinary skill may be based on the documentary evidence of record (e.g., the prior art) and an expert’s experience. *Magic Leap, Inc. v. Percept Techs. Inc.*, IPR2023-00495, Paper 10 at 6-10 (P.T.A.B. Aug. 3, 2023). Here, Amazon’s expert provided support for the level of skill, explaining the technical background, the references, and relying on his own experience in the field. (EX-1002 at ¶¶30-44.)

f. There Are No Expert Disputes.

PO's assertion that the "entire Petition *is* expert testimony" (PO Req. at 42) is incorrect. The Petition merely explains why the challenged claims are anticipated and would have been obvious to a POSITA at the time of the alleged invention. Although it is supported by a detailed and thorough expert opinion, the Petition is not expert testimony.

PO argues that "wholesale disagreement between experts is much better resolved before an Article III court and by a jury." (*Id.* at 43.) This argument ignores that PO has submitted *no* expert testimony. It is likely that PO's expert, should PO choose to submit testimony from one, will agree with Amazon's expert on many topics, particularly when cross examined under oath. Thus, it would be premature for the Director to find that there are "wholesale disagreements" as to how a POSITA would have understood a prior art reference, whether certain features are disclosed or would have been obvious, and other issues. PO's argument hinges on hypothetical disputes unsupported by evidence and should be rejected.

g. The Certificate of Translation Is Proper.

PO incorrectly argues that the declaration submitted by a translator is deficient. (PO Req. at 43-44.) When submitting a translation of a reference, the trans-

lation must be accompanied by “an affidavit attesting to the accuracy of the translation.” 37 C.F.R. §42.63. Ms. Snorteland’s declaration provides the required attestation.

PO argues that the certification is deficient because it does not “identify whether the signatory (Ms. Snorteland) is a translator or is fluent in Japanese.” (PO Req. at 43.) But Ms. Snorteland stated in her declaration that she is “a Translator at TransPerfect.” (EX-1005 at ¶1.)

PO then argues that the declaration does not state how the translation was performed or who performed it. (PO Req. at 43.) These arguments miss the point. What is relevant is whether the translation is accurate—regardless of how the translated document itself was created. The Board’s rules “require a translation, but do not require the certification to be signed by someone with personal knowledge of the translation.” *Globus Med., Inc. v. Moskowitz Family LLC*, IPR2020-01306, Paper 7 at 20 (P.T.A.B. Jan. 8, 2021). On this issue, Ms. Snorteland’s declaration is clear: she certifies that she has examined both the Japanese and the English versions of Shimomura and, based on her review, the English version is a “true and accurate translation” of the Japanese application. (EX-1005 at ¶6.) Thus, the declaration complies with the Board’s requirements. *See Maplebear Inc. v. Conuseron, LLC*, IPR2022-01357, Paper 9 at 6 n.7 (P.T.A.B. Mar. 3, 2023) (finding certification complied with the rules even “assuming the translation itself may have been done by

another”). PO also ignores that, even if the certification was somehow deficient, it would not justify denial of institution. *Globus*, IPR2020-01306, Paper 7 at 20 (a deficient certification “is not fatal, as the Board routinely allows a Petitioner to correct such a declaration”).

Notably, PO identifies no errors in the translation. Ms. Snorteland’s declaration and the translation were filed with the Petition in January, five months before PO filed its discretionary denial brief. PO had ample time to obtain its own certified translation to dispute the accuracy of the translation. PO did not. And, while PO cites cases suggesting that some translations raise interpretation questions that may require expert testimony, PO identifies no such issues in Ms. Snorteland’s translation.

Thus, PO’s arguments regarding the sufficiency of the declaration do not justify denying institution.

Because five of the six *Fintiv* factors weigh against exercising discretion to deny the Petition, the *Fintiv* analysis as a whole favors institution.

B. Section 325(d) Does Not Favor Discretionary Denial.

Under §325(d), “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. §325(d). In applying §325(d),

the Board “uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential).

The Board’s *Advanced Bionics* decision applies this two-part framework using the *Becton* factors for considering discretionary denial under §325(d). *Id.* at 7-11 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton*”)). Those factors are set forth in the relevant sections below.

Both prongs of the *Advanced Bionics* framework favor institution here.

1. Prong 1 of *Advanced Bionics* Favors Institution.

The first prong of *Advanced Bionics* determines whether the same or substantially the same art was previously presented to the Patent Office or whether the same or substantially the same arguments were previously presented to the Patent Office. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. When considering the first prong, the following *Becton* factors inform the analysis: (a) the similarities and material differences between the asserted art and the prior art involved during examination;

(b) the cumulative nature of the asserted art and the prior art evaluated during examination; and (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art. *Id.* at 10; *Becton*, IPR2017-01586, Paper 8 at 17-18.

It is undisputed that Shimomura, a primary reference relied on in the Petition, was never before the Patent Office. This fact is sufficient to avoid denial under §325(d). *Shenzen Chic Elecs. Co., Ltd. v. Pilot, Inc.*, IPR2023-00810, Paper 12, at 21 n.11 (P.T.A.B. Nov. 8, 2023); *TP-Link Corp. Ltd. v. Netgear, Inc.*, IPR2023-01469, Paper 10 at 9-10 (P.T.A.B Apr. 2, 2024).

PO's attempt to distinguish *Shenzen Chic* fails. (PO Req. at 50.) In that case, multiple prior art references relied on in the petition were previously before the Patent Office. *Shenzen Chic*, IPR2023-00810, Paper 12 at 21 n.11. The Board found that the Patent Office “erred in a manner material to the patentability of the challenged claims” by not substantively evaluating one of the references (Baxter). *Id.* at 20-21. The Board declined to consider other §325(d) arguments based on the other references that were before the Patent Office because Baxter alone was sufficient to make denial under §325(d) unwarranted. *Id.* at 21 n.11. *Shenzen Chic* shows that the Examiner's failure to substantively evaluate one reference relied on in the Peti-

tion (here, Shimomura) is a sufficient basis for the Board to not exercise its discretion under §325(d), even though other references relied in the Petition (e.g., Shin) were previously before the Office.³

PO also states that “[u]nder Amazon’s approach every petitioner could avoid *Advanced Bionics* simply by citing an additional reference.” (PO Req. at 51.) Not so. Amazon has not merely tacked on Shimomura as an “additional reference”—instead, the Petition argues that Shimomura discloses and/or renders obvious each limitation of each challenged claim. (Pet. at 35-59.) Thus, the Petition includes grounds of unpatentability that include only references that were not before the Examiner. (*Id.*)

PO argues that Shimomura is cumulative of Shin, relying on Amazon’s annotations showing how the prior art references each disclose one of the claim limitations. (PO Req. at 51.) But the mere fact that Amazon asserts that the two prior art references each disclose the same limitation of the challenged claims does not render the references cumulative. *Luxottica of Am. Inc. v. E-Vision Optics, LLC*, IPR2024-01030, Paper 12 at 13 (P.T.A.B. Jan. 7, 2025) (“merely relying on new prior art to teach the same limitations as art before the Examiner, standing alone, does not establish cumulativeness of the art as a whole”). PO never attempts to show that Shimomura’s disclosure is cumulative of Shin’s disclosure beyond its assertion that

³ PO’s argument regarding *TP-Link* fails for the same reasons. (PO Req. at 50.)

“Amazon makes the same argument based upon both references.” (PO Req. at 51.)

Indeed, the Petition demonstrates how Shin and Shimomura are *not* cumulative, as they provide different motivations to modify and combine references. (*Compare* Pet. at 30-32 (motivations to modify Shin) *with id.* at 47-50 (motivations to modify Shimomura)); *Halliburton Energy Servs., Inc. v. U.S. Well Servs., LLC*, IPR2021-01065, Paper 9 at 14 (P.T.A.B. Feb. 9, 2022) (references not cumulative “because they provide teachings that go to motivation to combine”).

PO argues that Ground 5 “confirms that Amazon treats the references interchangeably.” (PO Req. at 52.) PO argues that Ground 5 does not “distinguish a single fact, disclosure, statement, or argument between the two references (when applying them in view of Kristjansson).” (*Id.*) PO is incorrect. Ground 5 simply shows that Kristjansson can be combined with Shin (Grounds 1/2), Shimomura (Ground 3), and Shimomura and Shin (Ground 4). PO ignores that Ground 5 incorporates the previous grounds, which discuss Shin, Shimomura, and the differences between them in great detail. (Pet. at 8-64.) The separate evidence and explanation that Amazon raised in each of Grounds 1, 2, 3, and 4 show that Shin, Shimomura, and the Shin/Shimomura combination disclose the claim limitations in different ways. (*Id.*) That a POSITA would combine Kristjansson with Shin and Shimomura in similar ways is far from sufficient to show that Shin and Shimomura are cumulative.

Because the Petition relies on Shimomura to show the invalidity of all challenged claims, the Examiner did not previously consider this reference, and the reference is not cumulative, discretionary denial under §325(d) is not warranted.

2. Prong 2 of *Advanced Bionics* Favors Institution.

Because the first *Advanced Bionics* prong is not met, the second prong need not be evaluated. *JUUL Labs, Inc. v. NJOY, LLC*, IPR2024-00160, Paper 10 at 11-13 (P.T.A.B. May 24, 2024); *Quasar Sci. LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10 at 12 (P.T.A.B. Oct. 10, 2023). However, the second prong also favors institution.

The second prong determines whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, 2020 IPR2019-01469, Paper 6 at 8. When considering the second prong, the following *Becton* factors inform the analysis: (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments. *Id.* at 10; *Becton*, IPR2017-01586, Paper 8 at 17-18.

The Examiner identified Shin as “Pertinent” and cited to Paragraph [0037] during prosecution of the ’337 patent. (EX-1007 at 62-63.) As Amazon explained

in the Petition, however, the Examiner overlooked the most relevant disclosures in Shin. (Pet. at 70-71.) The Examiner noted only that Shin disclosed a voice output response that could be “adjusted or determined according to the *volume of the user input*.” (EX-1007 at 62-63 (emphasis added); Pet. at 71.) The Examiner overlooked Shin’s disclosure regarding adjusting the content and volume of the output *based on the distance* between the user and the device. (Pet. at 71.) These were the very features the Examiner believed were “missing” in the prior art when allowing the claims. (EX-1007 at 16-19.) Thus, the Examiner clearly failed to fully consider Shin.

PO argues that Amazon failed to show how the Examiner failed to discuss the relevant disclosures. (PO Req. at 52.) But the Petition describes, in detail, how the disclosures in Shin *other than the one paragraph the Examiner cited* anticipate or render obvious the claims. In doing so, Amazon plainly showed why and how the Examiner erred when considering Shin. (*See, e.g.*, Pet. at 8-30.)

PO’s description of Shin’s Paragraph [0037] is misleading. PO argues that the Examiner’s citation to Paragraph [0037] demonstrates the Examiner considered “purported disclosures of ‘*different content*’ at ‘*different volume*.’” (PO Req. at 48 (emphasis in original).) PO argues that the entire point of Paragraph [0037] is to take “distance into consideration” because it describes “different adjustments based upon a user being ‘at a standstill.’” (*Id.*)

The full context of Paragraph [0037] is key to understanding its limited disclosure:

Referring to FIG. 1A, a user 10, who is spaced apart from an electronic device 100 by a specific distance and is at a standstill, may speak to the electronic device 100. The speech of the user 10 may be provided to the electronic device 100 as a voice input. For example, the user 10 may speak “Let me know what time it is now.” *with a moderate volume and at a moderate speech rate*, and the speech may be provided to the electronic device 100 as a voice input. The electronic device 100 may receive the voice input through an embedded audio input module (e.g., a microphone) and may generate content corresponding to a result of analyzing the voice input. For example, the electronic device 100 may generate content, such as “The current time is nine ten AM”, in response to a voice input, such as “Let me know what time it is now.” The electronic device 100 may provide the generated content as sound through an embedded audio output module (e.g., a speaker). In this case, *since the user 10 provides a voice input with a moderate volume and at a moderate speech rate at a standstill, the electronic device 100 may provide the content as sound with a moderate output volume level and at a moderate output speed*. As such, the user 10 may be provided with the content corresponding to the voice input.

(EX-1003 at ¶[0037] (emphases added).)

Paragraph [0037] describes a user speaking to the device at a standstill with moderate voice volume and moderate speech rate. (*Id.*) The device responds to the user in a corresponding manner, with a moderate output volume and moderate output speed. (*Id.*) While the opening sentence mentions a “distance,” Paragraph [0037] does not include any disclosure about changing the device output *based on distance between the user and device*. Rather, the output is altered based on the input volume and speech rate. Other parts of Shin disclose changing the output based on the user-

to-device distance as the challenged claims require, but there is no evidence that the Examiner ever considered those disclosures.

For example, as Amazon argued, “Shin’s processor adjusts the amount of information provided to the user based on the user-to-device distance.” (Pet. at 19 (citing EX-1003 at ¶¶[0053], [0051], [0086]-[0090], claims 8, 17).) The Petition then explains in detail how Shin accomplishes that. (Pet. at 18-22.) In particular, Amazon argued that Shin’s device abbreviated content based on the user-to-device distance, as shown in Shin’s Table 3:

TABLE 3

Distance (D) between user and electronic device	Output amount of information of content
$D < 1\text{ m}$	Amount of information of original content
$1\text{ m} \leq D < 2\text{ m}$	Content of first abbreviation level
$2\text{ m} \leq D < 3\text{ m}$	Content of second abbreviation level
$3\text{ m} \leq D < 4\text{ m}$	Content of third abbreviation level
$D \geq 4\text{ m}$	Content of fourth abbreviation level (abstract content)

(EX-1003 at Table 3; Pet. at 20-21.)

The Examiner allowed the claims because the Examiner believed that the prior art altered the output based on the *input volume and speech rate* and not based on the *distance between the user and the device*. (EX-1007 at 16-17.) But the portions of Shin cited in the Petition disclose the very element that the Examiner thought was missing. (See, e.g., Pet. at 18-24, 30-32.)

The Patent Office cited to Shin as “pertinent” and not as a basis for a rejection. (EX-1007 at 62-63.) The Examiner’s rejection explains that the pertinent prior art identified, including Shin, was “made of record and not relied upon.” (*Id.*) Furthermore, the Examiner failed to consider substantial relevant disclosure in Shin. Thus, *Becton* factor (c) weighs in favor of institution.

PO argues that the Petition does not identify “any error” by the Patent Office. (PO Req. at 52.) But Amazon did so. (Pet. at 70-71.) And, it is clear that the Examiner erred in relegating Shin to a mere two lines of discussion (EX-1007 at 62-63) and failing to rely on it to reject the challenged claims. Thus, *Becton* factor (e) weighs against discretionary denial. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 10 (“if the record of the Office’s previous consideration of the art is not well developed ... then a petitioner may show the Office erred by overlooking something persuasive”).

PO also argues that “Amazon applied Shin the same way the Examiner did by relying on the disclosure in paragraph [0037].” (PO Req. at 53.) That is incorrect. The Petition does not apply Shin the same way that the Patent Office did—with a two-line statement regarding a single paragraph. Amazon explained and cited to Shin’s pertinent disclosures throughout the Petition. And with respect to key limi-

tations that recite outputting different content at a different volume *based on distance*, Petitioner relied on entirely different disclosures in Shin. (Pet. at 11-14, 18-24.)

PO's attempts to distinguish *Quasar* and *Apple* fail. PO argues that *Quasar* is inapplicable because the Examiner in that case cited the prior art in a list of "Notice of References Cited" but did not discuss the reference anywhere in the prosecution history, whereas PO asserts that the Examiner here "substantively addressed Shin." (PO Req. at 54.) But as explained above, the Examiner did not substantively address the relevant portions of Shin nor use Shin as a basis for any rejection. As *Quasar* explains, "the showing of material error necessary to satisfy the second step of the framework varies, depending on the degree to which the previously-presented art was substantively addressed by the Office." *Quasar*, IPR2023-00611, Paper 10 at 14. Here, the Examiner's analysis of Shin was minimal and omitted any analysis of the most relevant portions of Shin, whereas the Petition includes substantial detail regarding the portions of Shin the Examiner failed to cite. PO's argument regarding *Apple* relies on its incorrect assertion that "Amazon has not sufficiently shown that the Examiner overlooked any applicable disclosure in Shin." (PO Req. at 54; Pet. at 71 (arguing "[t]he Examiner clearly overlooked the most relevant disclosures in Shin" and citing to portions of the Petition explaining the overlooked disclosure).)

Furthermore, PO’s reliance on *r-pac International Corporation v. ADASA Inc.*, IPR2024-01416, Paper 11 at 18-19 (P.T.A.B. Mar. 25, 2025), is misplaced. In *r-pac*, the petition primarily relied on a reference that was also used in a rejection during a reexamination proceeding. There, the Board denied institution, explaining that the reexamination rejection relied upon disclosures that “substantially recite the same portions of [the reference] relied upon by Petitioner.” *Id.* at 28. Those facts do not exist here, where the Petition relies on much more of Shin’s disclosure than the single paragraph relied on by the Examiner.

Lastly, *Becton* factor (f) favors institution. The Examiner did not have the benefit of the Petition’s analysis, mapping, and Dr. Stern’s expert opinion, all of which identify and explain the other—more relevant—disclosures in Shin. Thus, even if the Examiner had substantively considered Shin, the additional evidence and facts presented in the Petition would warrant reconsideration of the prior art.

For the reasons set forth above, discretionary denial under §325(d) is inappropriate.

C. PO’s Argument Regarding an Unrelated Patent Does Not Warrant Discretionary Denial Here.

PO argues that it will be prejudiced if this IPR is instituted because the district court’s stay pending IPR will delay PO’s ability to appeal the district court’s decision that an unrelated patent (the ’487 patent) is invalid under §101. (PO Req. at 12.) This argument fails for many reasons.

First, the Board’s decision to institute an IPR should not depend on a patent owner’s decision to assert other invalid patents in litigation.

Second, PO’s argument that the district court’s ruling on the unrelated patent “has a strong chance of being overturned” is baseless and speculative. (*See id.*) PO had two chances to show that this patent satisfied §101—first when opposing Amazon’s motion and again when arguing for reconsideration—but failed each time. (EX-1008; EX-1014.) And PO provides no concrete argument as to why the Federal Circuit should be inclined to disagree with the district court. (PO Req. at 12-13.)

Third, PO’s arguments about relevant dates are misleading because they include the time for appeal in some calculations but not others. (*Id.* at 12-13; *compare, e.g., id.* at 12 n.9 *with id.* at 13 n.12.) The reality is that, with appeals, it will take several years to resolve the parties’ disputes regardless of whether this IPR is instituted.

Thus, PO’s arguments are unavailing.

III. CONCLUSION

For the reasons set forth in the Petition and herein, Amazon respectfully requests that the Director deny PO’s Request for Discretionary Denial.

Respectfully submitted,

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Dated: June 12, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), the undersigned certifies that this **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** contains 10,387 words according to the word-processing program used to prepare this paper. The foregoing word count complies with the 14,000-word type-volume limit specified by the Memorandum from Acting Director Stewart, *Interim Processes for PTAB Workload Management* (March 26, 2025).

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **PETITIONERS’
OPPOSITION TO PATENT OWNER’S REQUEST FOR DISCRETIONARY
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