

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. IPR2025-00673
Patent No. 11,244,675

**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 arguments here mirror the unsuccessful arguments it raised in a related proceeding between the parties, *Amazon.com, Inc. v. SoundClear Techs. LLC*, IPR2025-00565. There, the Director denied PO’s request for discretionary denial. *Id.*, Paper 11 at 2 (P.T.A.B. July 10, 2025). The Director should do the same here for the same reasons.

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 various references relied on in the Petition are cumulative of references before the Examiner. But PO fails to show how the references are cumulative, particularly in view of the disclosure discussed in the Petition, which is plainly different from what the Examiner applied. 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 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 ’675 patent are unpatentable. With the co-pending litigation stayed and the Petition making a strong showing that the ’675 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 Strongly 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); *Amazon.com*, IPR2025-00565, Paper 11 at 2.

Despite the stay, PO argues that Factor 1 is neutral or should be given little weight (Paper 6 (“PO Req.”) at 60-61) and that Factor 2 favors denial because, *if institution is denied*, the stay will be lifted, and the case “will proceed to trial by February or March 2026”—before the October 2026 deadline for the final written decision in this IPR (*id.* at 10-14). This argument is speculative and the Director has rejected similar arguments.¹ *E.g., Micron Tech., Inc. v. Yangtze Memory Techs. Co.*,

¹ PO’s invocation of *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (P.T.A.B. Mar. 29, 2025) is not to the contrary. That case dealt with *Fintiv* factors 3 and 4; while there was a stay in the co-pending district court litigation, the relevant consideration was the “substantial time and effort the parties and the district court

Ltd., IPR2025-00190, Paper 21 at 3 (denial not appropriate where co-pending litigation is stayed); *ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, Paper 10 at 2 (P.T.A.B. June 12, 2025) (same); *Amazon.com*, IPR2025-00565, Paper 11 at 2.

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. Indeed, there is reason to believe that the stay would not be lifted even if institution is denied in this proceeding, because the Director has referred Petitioners’ IPR petition against the other asserted patent in the district court litigation to the Board, and its merits are strong. *Amazon.com*, IPR2025-00565, Paper 11.

had invested in the parallel proceeding,” including “extensive” contentions, expert reports, and claim construction briefing and *Markman* order. *Id.* at 3. In contrast, the investment in the parallel proceeding here has been minimal.

PO's assertion that trial would occur in February or March 2026 is speculative. PO relies on time-to-trial statistics for Judge Trenga that include no patent cases. (PO Req. at 11-12 (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 February or March 2026 as PO contends.

The cases (*ARM* and *Ericsson*) PO cites in support of its argument are inapposite. In each case, the district court had an operative schedule, including a trial date, which is not the case here. *ARM Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (P.T.A.B. May 16, 2025); *Ericsson Inc. v. Procomm Int'l Pte, Ltd.*,

IPR2024-01455, Paper 15 at 2 (P.T.A.B. May 16, 2025). And, even more importantly, in both cases there was “insufficient evidence the district court is likely to stay its proceeding even if the Board were to institute trial.” *Id.* Here, the district court *has already stayed the proceeding*.

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 two months after the district court vacated its prior order dismissing the ’675 patent, and 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 14-16.) 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 over one month later, Amazon filed its Petition in this IPR. (Paper 1 (“Pet.”).)

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 ’675 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 argues that Amazon will take “diametrically opposite claim construction approaches” before the PTAB and the district court. (PO Req. at 17-32.) PO speculates that Amazon may seek to apply broad constructions in the IPR and narrow constructions in the litigation. (*Id.* at 17.) 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 17-32.) 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 19.) 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.

PO appears to conflate Amazon’s position in this IPR (that no construction is necessary) with an affirmative argument for a “broad” or “plain and ordinary meaning” construction. (*See, e.g.*, PO Req. at 25-26.) This is a misunderstanding of the situation and the applicable law. Amazon’s position in this proceeding is that no claim construction is necessary because the prior art discloses each claim limitation *under any reasonable construction*. PO repeatedly complains that Amazon is advancing inconsistent or contradictory claim construction positions. (*Id.*) But that is simply not the case—Amazon has only stated that no claim construction is necessary here to resolve the invalidity challenges, while acknowledging that claim construction may be necessary in the district court to resolve the infringement questions. PO has identified no claim construction issues it believes are relevant to invalidity.

PO further argues that, under *Vivid*, the Board must construe the claims to resolve “all issues,” including infringement issues not before the Board. (*Id.* at 24.) PO cites no caselaw for this proposition, and indeed it contradicts what the Board has called the “common standard.” *Google LLC v. Hammond Dev. Int’l, Inc.*, IPR2020-00081, Paper 37 at 15-16 (P.T.A.B. June 4, 2021). In that case, the patent

owner argued that the petitioner sought constructions for ten terms in a related district court litigation while taking the position that no terms needed to be construed by the Board. *Id.* The Board stated that “the common standard does not mandate that all claim construction disputes submitted to the district court must also be aired here,” and then proceeded to construe only the terms relevant to the invalidity questions before the Board. *Id.*; *Id.* at 16-29. This approach is confirmed by numerous Board decisions. *E.g.*, *Juniper Networks, Inc. v. Swarm Tech. LLC*, IPR2022-00141, Paper 53 at 11 (P.T.A.B. Apr. 26, 2023) (no need to construe terms disputed elsewhere where, “in light of the arguments and evidence presented ... during trial, the scope and meaning of the ... terms are not in controversy”); *Google LLC v. Nariste Networks Pty. Ltd.*, IPR2023-01374, Paper 27 at 12-13 (P.T.A.B. Apr. 9, 2025) (“As our consideration of the asserted grounds of unpatentability is not affected by the outcome of this [claim construction] dispute, we need not address it.”); *PEAG LLC v. Varta Microbattery GmbH*, IPR2020-01212, Paper 48 at 16-17 (P.T.A.B. Jan. 5, 2022).

Fourth, PO argues that “[t]here 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.” (PO Req. at 25.) 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.

PO’s approach, on the other hand, creates an unworkable standard that would either deny IPR relief to nearly every petitioner engaged in co-pending district court litigation (frustrating Congress’s intent), or routinely burden the Board with claim construction disputes that are completely unrelated to invalidity (wasting substantial Board resources). Under PO’s theory, either the district court or the Board must “resolve *all* issues” of claim construction in controversy between the parties, regardless of how or in what venue they arise. (PO Req. at 24.) That is not only contrary to existing law, but it would create substantial additional work for the Board in nearly every IPR where there is co-pending district court litigation.

PO also appears to suggest that the Board’s long-standing practice regarding claim construction somehow contravenes Federal Circuit and Supreme Court precedent. (*Id.* at 26.) PO is wrong. The Board’s practice of deciding only claim construction issues necessary to determine validity *applies* precedent by limiting the Board’s consideration to terms “that are in controversy, and only to the extent necessary to resolve the controversy.” *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

PO also suggests that the Board’s long-standing practice, and the cases that apply it, are overruled by the informative decision in *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (P.T.A.B. Dec. 13, 2024) (informative). (PO Req. at 26-27.) But *Cambridge* does not stand for the broad proposition PO suggests. (*See id.*) Rather, *Cambridge* dealt with a situation different from this one in at least two key, dispositive ways.

First, in *Cambridge*, the claim construction question at issue was whether the claims included means-plus-function limitations under §112(f). *Cambridge*, IPR2024-00952, Paper 12 at 5-9. As the Board noted, when a means-plus-function construction is at issue, “37 C.F.R. §42.104(b)(3) mandates that the Petition ‘identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.’” *Id.* at 8. The Board found the petition

failed to do so, which was the basis of its decision. *Id.* at 8-9. But here, no party has advanced a means-plus-function construction in any forum.

Second, any inconsistency between the petitioner’s IPR and district court constructions was not merely speculative—the petitioner advocated for a means-plus-function construction in the district court and provided a different construction to the Board that it admitted it did not believe was correct. *Cambridge*, IPR2024-00952, Paper 12 at 7. Not so here, where no constructions have even been proposed in the district court litigation, rendering any alleged “inconsistency” speculative. *Cambridge* did not overrule the Board’s practice of only construing terms to the extent necessary to decide validity; rather, it clarified what analysis was necessary to decide validity in the case where a means-plus-function construction is implicated.

Finally, PO complains that the Board’s decision in *Chanel* improperly shifted the burden to the patent owner. (PO Req. at 30.) But no burden was shifted. The petitioner there, as here, presented grounds of invalidity and stated that no express construction was required to resolve the invalidity issues. *Chanel*, IPR2022-00543, Paper 7 at 9. Thus, the petitioner there met its burden to demonstrate invalidity. If the patent owner believed there was a claim construction issue relevant to invalidity, it could have proffered a construction, the parties could have briefed the issue, and

the Board could have decided whether the petitioner met its burden to show invalidity in view of the resulting construction—but that does not shift the ultimate burden to the patent owner.

If PO believes there is a claim construction issue relevant to validity, it should present that to the Board in its POPR. If PO believes Amazon has taken a position in this IPR that contradicts a position Amazon later takes in the district court, it should raise that issue with the district court. But the mere fact that infringement issues exist in the district court litigation that are not before the Board is not a reason to deny the Petition here.

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 32-33.) 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”).²

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 34.) 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.³

PO also argues that Amazon’s *Sotera* stipulation is “not particularly meaningful” in light of FAQ 14. (*See id.* at 36-37.) 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

² 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).

³ PO’s complaint regarding Amazon’s alleged “representation that discovery involving third-party witnesses ... is needed to address validity” fails for the same reason. (PO Req. at 33-34.) As PO admits, Amazon merely stated that it would seek testimony from third-party witnesses regarding prior art devices, an issue that is not and cannot be before the Board. (*Id.*)

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 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 ¶33.)

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*, IPR2024-01205, Paper 19], ... 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. The Petition’s Merits Are Strong.

The Petition’s merits are strong because the asserted prior art references clearly disclose each limitation of the challenged claims. Indeed, PO only disputes that the art discloses one limitation of the challenged claims: claim element 1[b]. (See PO Req. at 37-41.) That is the same claim element the applicant added during prosecution to allegedly overcome the prior art cited by the Examiner. (See EX-1007 at 47-50, 34-37.) Claim element 1[b] recites “a voice classifying unit configured to calculate a distance between the user and the output-content control device by a proximity sensor *to classify the voice into either a first voice or a second voice based on the calculated distance.*” As the Petition explains, Shin and Shimomura classify a voice in exactly the same way as the ’675 patent.

The ’675 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 12; EX-1001 at 10:32-46.) Similarly, the prior art relied on in the Petition—e.g., primary references Shin and Shimomura—sets threshold distances and classifies the voice based on whether the distance exceeds the threshold.

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 of the output. (EX-1003 at ¶¶[0078], [0086]; Pet. at 12.) Shin determines the content

to output by classifying the voice based on the distance between the user and the device. (EX-1003 at ¶¶[0053], [0078], [0086]; Pet. at 12.) 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
Second Voice	$D < 1\text{ m}$	Amount of information of original content
First Voice	$1\text{ m} \leq D < 2\text{ m}$	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 (annotated); Pet. at 13.) Shin therefore discloses classifying voices into groups based on thresholds (e.g., voice less than 1 meter away, voice between 1 and 2 meters away, etc.), and therefore discloses classifying the voice as a “first voice” or “second voice” in exactly the same way as the ’675 patent.

Shimomura also discloses claim element 1[b]. Shimomura discloses changing the content spoken by its device “according to the distance to the conversation partner.” (EX-1004 at ¶¶[0058], [0067]-[0070], [0060]-[0063], [0073]-[0084]; Pet. at 49-50.) 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 (annotated); Pet. at 50.) 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 '675 patent.

PO argues that neither primary reference—Shin or Shimomura—“expressly mentions classifying voices.” (PO Req. at 38.) But the 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”). Accordingly, both Shin and Shimomura disclose the limitation.

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 3 n.1.)

Thus, PO’s arguments that the merits are weak (PO Req. at 40) because the prior art references purportedly fail to disclose classifying a voice as a first voice or a second voice are incorrect. The prior art discloses the same voice classification that the ’675 patent requires.

PO’s arguments to the contrary are incorrect. For example, PO cites a single paragraph of Shin. (PO Req. at 40-41 (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 12-15 (citing EX-1003 at ¶¶[0037], [0039], [0047], [0051], [0053], [0060], [0077]-[0078], [0086]-[0087], claim 17, Table 3).)

PO also argues that Shimomura is deficient. (PO Req. at 41.) 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 ’675 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.*) is incorrect. PO refers to an introductory sentence that explains that Shimomura discloses classifying voices based on distance. (*Id.* (citing Pet. at 49-50).) 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 49-50 (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 ¶¶169-71.)

The strength of the Petition’s merits weighs against discretionary denial. *Fin-tiv*, IPR2020-00019, Paper 11 at 14-16, 15 n.29 (collecting cases).

b. 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 41, 43.) But they are not. Amazon clearly identifies its invalidity references and statutory basis in a chart at the beginning of its Petition:

Ground	Reference(s)	Challenged Claims
1a	Shin and Aoyama	1-7
1b	Shin and Iwase	1-2, 5-7
2a	Shimomura and Aoyama	1-7
2b	Shimomura and Iwase	1-2, 5-7
3	Grounds 1b or 2b and Aoyama	3-4
4	Grounds 1a-2b and Schuster	5
5	Grounds 1a-4 and Kristjansson	1-7

(Pet. at 5.)

PO complains about the language “disclose or render obvious” and “disclose or suggest” (PO Req. at 41) in sentences like “Even if Shin did not disclose or render obvious these units, they are disclosed by and would have been obvious in view of Aoyama.” (Pet. at 18). But this sentence, and others that PO identifies, merely summarize and explain the Petition’s various arguments. 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.d.) Thus, contrary to PO’s arguments, the Petition gives sufficient notice of the Grounds.

c. 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 37-38, 43-44.) 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 66 of his declaration, Dr. Stern explains that “[a] person of ordinary skill would have recognized binary classification as an efficient, user-friendly solution for Shin’s

needs.” (EX-1002 at ¶66.) 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.*) 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 ex-

plained 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).

d. 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 44-49.) 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 22-28.) The Petition also addressed the level of skill in the art (*id.* at 7 (citing EX-1002 at ¶¶28-32) and secondary considerations (*id.* at 70).

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 44-45.) 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 1 that if Shin did not expressly disclose replacing words to generate abbreviated/simplified content, that element would have been obvious over Aoyama. (Pet. at 23.) In other words, to the extent that the required

disclosure was not in Shin, then it would have been obvious over Aoyama. As another example, in Ground 5, the Petition explains that PO may argue that “Shin and/or Shimomura do not disclose the “intention analyzing unit” and “notification-information acquiring unit” limitations” and that Kristjansson also discloses those claim elements. (*Id.* at 67.)

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 46-47.) 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 1, the Petition identifies *seven* motivations to combine Shin with Aoyama. (Pet. at 25-27.) The Petition also explains that a POSITA would have expected to succeed in such modification because it was trivial. (*Id.* at 27-28.) 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 third⁴ 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. (PO Req. at 47-49.) 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 49.) But Amazon's expert explained the level of skill in the art in his declaration. (EX-1002 at ¶¶28-32.) Moreover, the expert explained the background in the art, including what information was known at the time. (*Id.* at ¶¶33-43.) Thus, Amazon met its burden.

⁴ PO's third argument appears to be copied-and-pasted from its brief in IPR2025-00565 and does not appear to address this proceeding.

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 ¶¶28-43.)

e. There Are No Expert Disputes.

PO's assertion that the "entire Petition *is* expert testimony" (PO Req. at 50) 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.*; *see also id.* at 33.) 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.

f. The Certificate of Translation Is Proper.

PO incorrectly argues that the declaration submitted by a translator is deficient. (PO Req. at 50-52.) When submitting a translation of a reference, the translation 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 50-51.) 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 51.) 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. Consumeron, 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 February, 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 Shin and Shimomura, the primary references relied on in the Petition, were 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 55.) 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 primary references relied on in the Petition (here, Shin and/or Shimomura) is a sufficient basis for the Board to not exercise its discretion under §325(d), even though other references relied in the Petition were previously before the Office.⁵

To evade the fact that each Ground in the Petition relies on a primary reference that was not before the Office, PO argues that various references in the Petition are cumulative of references that were before the Examiner. (PO Req. at 56-59.) These arguments fail because the references are not cumulative.

⁵ PO’s argument regarding *TP-Link* fails for the same reasons. (PO Req. at 55.)

PO first argues that Iwase, which was not before the Examiner (and which is relied on as a secondary reference in Grounds 1b, 2b, and 3-5), is cumulative of Aoyama, which was before the Examiner. (*Id.* at 56-58.) PO states that the Petition “relies on Iwase and Aoyama to disclose the same limitations for claim 1 ... and claim 2” and cites portions of the references that are similar in that they both disclose those limitations. (*Id.* at 56-57.) 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 then cites one of the Petition’s motivations to combine Shin with Aoyama (out of seven) and one of the Petition’s motivations to combine Shin with Iwase (out of seven) to suggest that the motivations are the same. (PO Req. at 57-58.) But PO ignores the numerous reasons that are unique to each reference. (*See, e.g.*, Pet. at 25-26 (POSITA motivated to combine Shin and Aoyama because “Aoyama teaches the desirability” of doing so, citing disclosure of Aoyama), 42 (POSITA motivated to combine Shin and Iwase because “Iwase suggests doing so,” citing disclosure of Iwase)); *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”). Thus, Aoyama and Iwase are not cumulative.

But even if Aoyama and Iwase were cumulative, that would not be a reason to deny the Petition under §325(d) because neither primary reference (Shin or Shimomura) was before the Examiner, as PO admits. (PO Req. at 58.) PO appears to argue that Shin and Shimomura are cumulative of proximity sensor prior art that was considered by the Examiner, but provides no evidence or discussion of the prior art references of which Shin and Shimomura are allegedly cumulative. (*Id.* at 58-59.) And, the Petition relies on Shin and Shimomura for substantially more than simple disclosure of a proximity sensor. *Luxottica*, IPR2024-01030, Paper 12 at 13-14 (reference not cumulative where it “discloses aspects of [the claim] that the prior art before the Examiner ... does not”). Thus, Shin and Shimomura are not cumulative of previously presented references.

Because the Petition relies on Shin, Shimomura, and Iwase to show the invalidity of all challenged claims, the Examiner did not previously consider these references, and the references are 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*, 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.

PO argues that the Petition “fails to assert that the Examiner erred in addressing Aoyama or Schuster.” (PO Req. at 59.) Not so; the Petition stated that “[t]he disclosures presented here,” including those in Aoyama and Schuster, “show that the Examiner erred in allowing the claims.” (Pet. at 73.) While the Petition here pre-dates the precedential decision in *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 (P.T.A.B. May 19, 2025), it nevertheless satisfies the standard there because it asserts grounds covering all challenged claims that rely on prior art that “was not a basis for rejection during examination, is not substantially

the same as prior art the Examiner applied, and includes specific teachings that ‘impact patentability of the challenged claims.’” *Id.* at 5. The Petition clearly shows that the asserted prior art references render the challenged claims obvious; thus, issuing those claims represents material error by the Examiner. *E.g., Microsoft Corp. v. ParTec Cluster Competence Center GmbH*, IPR2025-00318, Paper 9 at 2-3 (P.T.A.B. Jun. 12, 2025) (“the Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error”); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13 at 2 (P.T.A.B. Jun. 25, 2025); *Amazon.com*, IPR2025-00565, Paper 11 at 2.

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 highly relevant disclosures in the prior art. Thus, even if the Examiner had already considered the art presented, the additional evidence and facts presented in the Petition would warrant reconsideration.

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

C. Additional Factors Favor Institution.

1. Settled Expectations Favor the Board’s Review of the Challenged Claims.

PO lacks settled expectations regarding the patent’s validity for at least three reasons. First, the ’675 patent issued in 2022, three years before the Petition was

filed, and therefore no settled expectations regarding its validity exist. *See Amazon.com*, IPR2025-00565, Paper 11 at 2 (no settled expectation of validity for patent issued in 2021); *Embodiment, Inc. v. Lifenet Health*, IPR2025-00248, Paper 13 (P.T.A.B. June 26, 2025) (no settled expectation of validity for patent issued in 2022); *Yealink Network Tech. Co., Ltd. v. Barco NV*, IPR2025-00491, Paper 18 (P.T.A.B. June 25, 2025) (no settled expectation of validity for patent issued in 2020); *Cambridge Indus. v. Applied Optoelects.*, IPR2025-00434, Paper 11 (P.T.A.B. June 26, 2025) (no settled expectation of validity for patents issued in 2019 and 2020). Instead, “[e]arly challenges to patents favor robust, predictable patent rights and weigh against discretionary denial.” *Yealink*, IPR2025-00491, Paper 18 at 3.

Second, PO is a non-practicing entity formed in 2023 for the purpose of acquiring the ’675 patent, among other patents, and filing lawsuits to enforce those patents. (*See* EX-1106 at 1-3; EX-1104 at 1.) To the extent PO had any “settled expectations” when it acquired the ’675 patent in 2023, those expectations were that any accused infringer would have the opportunity to file IPR petitions and that the IPRs would be instituted if the challenger could meet the standard for institution (i.e., a reasonable likelihood that at least one claim is unpatentable). Under such circumstances, PO’s settled expectation was—or should have been—that the patent’s validity would be reviewed.

Third, to the extent Petitioners had any “settled expectations,” those expectations also favor institution. When the ’675 patent issued, it was assigned to a large technology company, JVC Kenwood Corporation. (EX-1001, 1.) Such companies rarely assert patents, and are substantially more likely to negotiate and license patents rather than assert them. Even if Amazon had known about the ’675 patent, it would have had no reason to believe that JVC Kenwood would assert it against Amazon. Nor would Amazon have had reason to believe that JVC Kenwood would transfer the patent to a non-practicing entity like PO or that the patent would be asserted against Amazon. *Cf. Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 at 2 (P.T.A.B. Jun. 12, 2025) (“discretionary denial is not appropriate” where the petitioner “expected non-enforcement of the challenged patent”). To the extent Petitioners had any “settled expectations” generally, for more than a decade their “settled expectations” have been that if an invalid patent is asserted against them, they could file IPR petitions and use the cost-efficient mechanism for resolving validity challenges as Congress intended.

Thus, the parties’ settled expectations favor institution.

2. Efficiency Considerations Favor Institution.

In the co-pending litigation, PO asserted three patents against Petitioners. PO also filed a second case, assigned to a different judge, asserting three additional patents. The district court in the co-pending litigation held one patent invalid under

§101 and Petitioner has filed IPR petitions challenging the validity of the other five asserted patents (the two in the co-pending litigation, including the patent at issue here, and the three in the second litigation). *See* IPR2025-00565, IPR2025-01096, IPR2025-01067, IPR2025-01080.

The remaining patent at issue in the co-pending litigation, the '337 patent, is closely related to the '675 patent at issue in this proceeding.⁶ The patents each claim a content control device comprising a proximity sensor, a unit that classifies voices based on distance from the device, and units that analyze information input from a user's voice and tailor corresponding output content. (*Compare, e.g.,* Pet. at 76 with IPR2025-00565, Paper 1 at 75.) And Petitioners' IPR petitions challenging both patents rely on the same primary prior art references, Shin and Shimomura. (Pet. at 5; IPR2025-00565, Paper 1 at 6.) The Director has referred the petition challenging the '337 patent to the Board, and its merits are strong, leading to a high chance of institution. *Amazon.com*, IPR2025-00565, Paper 11 (referring petition to the Board and noting that "Petitioner persuasively argues that the Office erred in a manner material to the patentability of the challenged claims"). Accordingly, it is an efficient use of Board resources to also review the instant petition, which substantially overlaps in claimed subject matter and prior art asserted. *Cf. Embody*, IPR2025-

⁶ While the patents are not in the same family, they have the same inventor.

00248, Paper 13 at 3 (“it is an efficient use of Board resources to address the related patent”).

The three patents asserted in PO’s separate second case against Petitioners relate to various technologies, including: (a) receiving sound signals at a device, detecting voice, and performing adaptive noise reduction (IPR2025-01096, U.S. Pat. No. 9,031,259); (b) a communication device that switches between receiving and transmitting modes, evaluates speech quality, and turns a light on, off, or blinking to indicate the communication mode (IPR2025-01067, U.S. Pat. No. 9,070,374); and (c) a method for controlling volume of a speaker having a locked state and an unlocked state and methods for switching between the states (IPR2025-01080, U.S. Pat. No. 9,804,819). None of the three patents in that case are related to each other, or to the patent at issue here.

The complexity of the district court litigations also weighs against discretionary denial. *Tesla v. Intellectual Ventures*, IPR2025-00217, Paper 9 (P.T.A.B. June 13, 2025). Both district court litigations are currently stayed pending IPR, which will allow the Board to efficiently decide the validity issues presented. If the IPRs are discretionarily denied and the litigations resume, then the cases will proceed before two different judges in two different courthouses and will require two juries to be empaneled. Deciding the validity issues through district court litigation will require multiple judges, clerks, and juries to learn the diverse subject matter of the

patents, the prior art, and the law. It would be an efficient use of the Board’s resources to have a panel of three APJs, already technically trained and able to understand the technology, and with deep knowledge of the law, resolve the invalidity challenges presented in the IPRs. *See id.* (“the Board is better suited to review a large number of patents involving diverse subject matter”); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2 (P.T.A.B. July 2, 2025) (“Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.”).

3. 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 13-14.) 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 13-14.)

Third, PO's arguments about relevant dates are misleading because they include the time for appeal in some calculations but not others. (*Id.*; *compare, e.g., id.* at 13 n.10 *with id.* at 14 n.13.) 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, the challenges here represent an appropriate use of Board resources. Accordingly, Amazon respectfully requests that the Director deny PO's Request for Discretionary Denial.

Respectfully submitted,

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Dated: July 14, 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 11,049 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).

Dated: July 14, 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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