

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AMAZON.COM SERVICES LLC,
AMAZON WEB SERVICES, INC., and AUDIBLE, INC.,
Petitioner

v.

AUDIO POD IP, LLC,
Patent Owner

Case IPR2025-00769
U.S. Patent No. 9,954,922

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107(a)**

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U.S. Patent and Trademark Office
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I. INTRODUCTION

Patent Owner Audio Pod IP, LLC (“Audio Pod”) respectfully requests that Board deny institution of Petitioner Amazon.com, Inc.’s Petition for *inter partes* review (IPR) of U.S. Patent No. 9,954,922 (“the ’922 patent”). Three entrepreneurial brothers and a friend, all with software backgrounds, invented server-based, segmented streaming for use with audio book technology. They did so to make it possible for the brothers’ aging mother to continue to enjoy her passion for reading as her eyesight failed. Realizing their inventions represented fundamental technology breakthroughs, they sought patent protection for their inventions and formed Audio Pod to bring their technology to market. Amazon met with Audio Pod and expressed interest in the technology. But Amazon then incorporated the technology into their products without even speaking with Audio Pod after the meeting. It established and expanded its dominant e-reader Kindle market position. That market presence thwarted all of Audio Pod’s efforts to build its business following its meeting with Amazon. Those realities, and the related IPRs, result from Amazon’s approach to use its nearly unlimited resources to best small, innovative entities.

The merits of the Petition are weak. The entire Petition is founded on flip-phone technology. The result is a scattershot and piecemeal approach to the claims, disclosures, prior, combinations, and obviousness. The proposed invalidity grounds

are premised on claim construction positions that conflict with constructions that Amazon took in the parallel district court proceeding in the Eastern District of Virginia (EDVA). Amazon does not acknowledge that discrepancy. It does not provide any justification for the inconsistency. Amazon's conclusory assertions regarding motivation to combine and reasonable expectation of success throughout the Petition only exacerbate the weakness of the challenge.

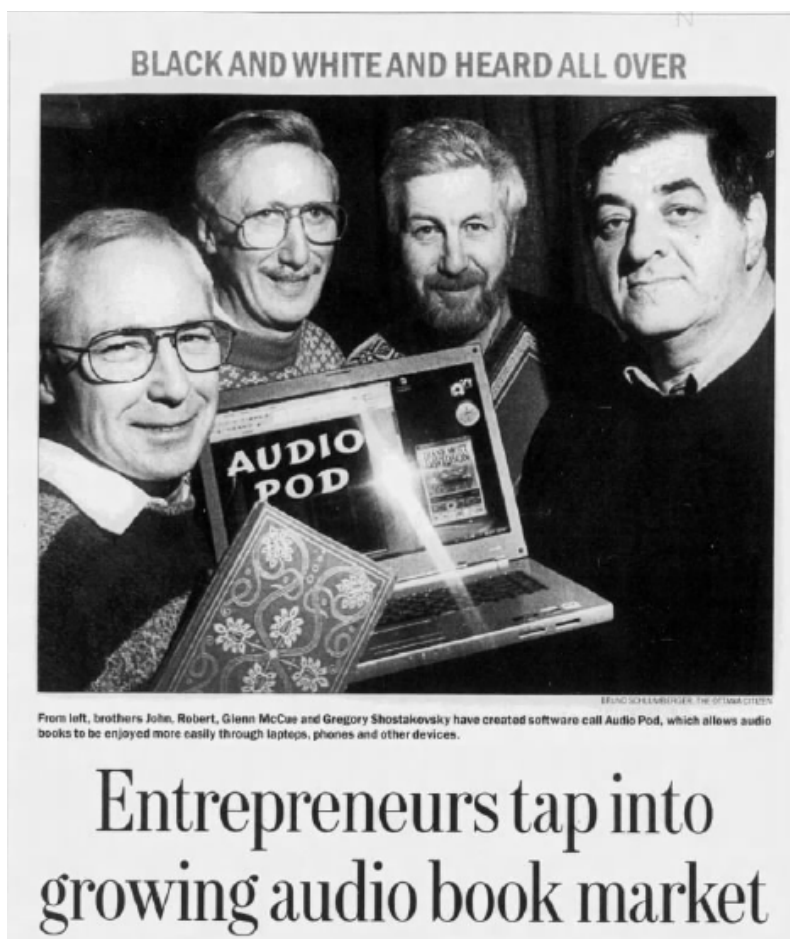
And Amazon did not even attempt to make the required minimum showing *in the Petition* that one of the references (Loukopoulos) was even a prior art printed publication. Thus, at minimum, claims 4-6 are valid.

Finally, given the many deficiencies affecting the asserted grounds, even if the Board were to agree that Amazon has met its burden for a single claim or ground, the Board should exercise its discretion under the Board's informative *Chevron* and *Deeper* decisions, and deny institution here.

II. BACKGROUND

A. Audio Pod's founders invented key early media streaming technologies, including the inventions claimed in the '922 patent.

Audio Pod's innovative concepts and early technology development was headlined in The Ottawa Citizen newspaper in January 2008.



EX2003, 1.

The news story recounts that, in the late 1990s, “John McCue began looking for a way to help his mother, Monica, continue her lifelong love affair with literature in spite of her failing eyesight.” EX2003, 1; EX2015, ¶6. He teamed up with senior software architect, and co-founder, Gregory Shostakovsky, as well as his brothers, Robert McCue and Glenn McCue. EX2003, 1; EX2015, ¶6. All four had computer science backgrounds. EX2003, 1.

They created a brilliant solution—a server-based, virtual approach to streaming audio across multiple devices:

Say, for example, you are in an airport departure lounge in a WiFi hotspot listening to a podcast or an audio book....

... Then your flight is called and you may lose your wireless Internet service while airborne.

But even without a wireless connection, Audio Pod's technology will allow you to pick up that story again on the plane exactly where you left off.

This is possible because Audio Pod's memory manager retains the content and is able to deliver it to the user seamlessly, even on a different device.

The technology is unique because it utilizes a digital virtual representation of the audio stream. This virtual approach eliminates the delays associated with mass downloads that could easily take eight to 10 hours for larger books, and it also eliminates the network dependence used by streaming technologies

EX2003, 2; *see also* EX2015, ¶6.

According to Mr. McCue's 2008 interview, "[t]he hardest part in developing th[e] technology was devising a way to break up a media stream into a large number of manageable audio chunks that can then be played in perfect sequence."

EX2003, 2. Solving that problem unlocked a world of possibilities. "[T]he

successful result provides users with a seamless audio experience for bookmarking and memory management in a way that allows the delivery of ‘many, many media streams through very small devices using limited network resources’” *Id.* That benefit extended to any type of media stream, including, for example, handheld messaging. *Id.*

The patent claims constitute foundational technology that make multi-media, multi-device streaming possible.

B. Audio Pod disclosed their innovative technology to Amazon, but Amazon ignored their subsequent outreach attempting to partner or license, and Amazon instead implemented Audio Pod’s technology on its own.

The inventors formed Audio Pod Inc. in 2005. EX2015, ¶7; EX2001, ¶64; EX2002, ¶56. They had a working product, and in July 2007, the inventors had a lengthy meeting with Amazon and Brilliance Audio (an audiobook publisher acquired by Amazon in May 2007), who had expressed interest in Audio Pod’s technology. EX2015, ¶¶9-10; EX2001, ¶¶68-69; EX2002, ¶¶60-61.

A small group from Amazon and Brilliance agreed to meet with Audio Pod. EX2015, ¶9. The meeting was originally scheduled for one hour; in fact, the Amazon team initially expressed disbelief that the technology would work. EX2015, ¶¶9-11. But, when Audio Pod presented a working product, the meeting extended to the entire day—with more and more Amazon/Brilliance representatives joining as the day went on. EX2015, ¶¶10-11. By the end, there

was acknowledgement from the Amazon team that they had “never thought of using a central server.” EX2015, ¶11.

After the meeting, beyond a brief acknowledgement of a “thank you” email sent by the Audio Pod team, Amazon broke contact with Audio Pod, ignoring repeated attempts by Audio Pod to follow up after the meeting. EX2015, ¶12. Amazon acquired Audible in 2008, and subsequently released “Whisper Sync for Voice” Kindle technology. *See* EX2013; EX2016. Through 2013, Audio Pod continued its efforts to partner with Amazon.

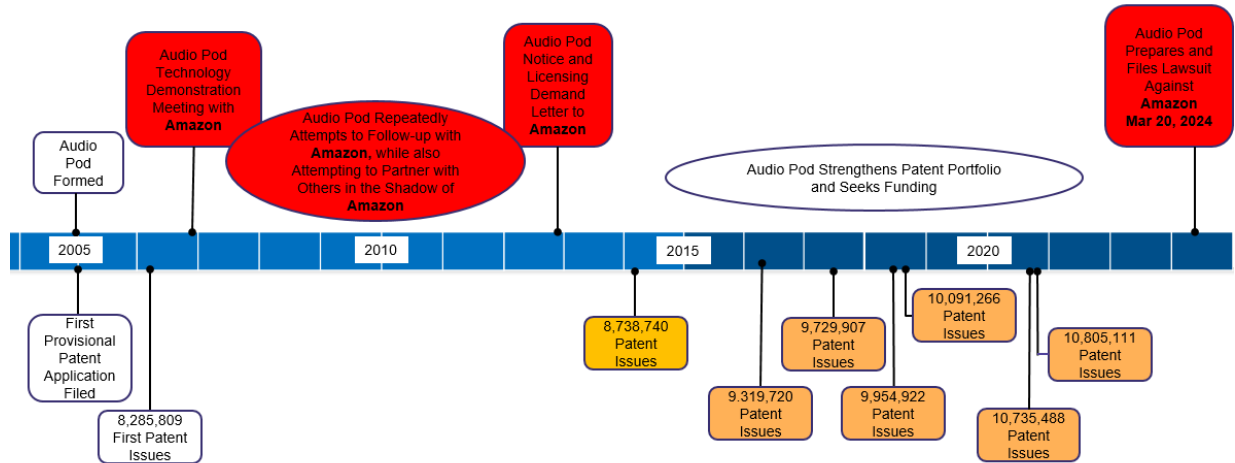
Audio Pod also marketed its technology to other companies in the industry, but Amazon, already a market giant, had cornered the market, limiting Audio Pod’s ability to compete. As Mr. McCue testifies:

It was common for us to present our technology and get the response “Amazon is already doing that” or concerns about having to compete with Amazon as a direct competitor.

EX2015, ¶17.

In sum, Amazon’s disregard for Audio Pod’s intellectual property led to Audio Pod’s infringement suit—a suit Audio Pod tried to avoid. The following timeline portrays the long road taken by Audio Pod to attempt to realize the benefit of its inventions in the face of Amazon’s stonewalling Audio Pod’s attempt to work

together, while bringing Amazon's strikingly similar and infringing audio book products to market. *See* EX2015, ¶¶6-17.



III. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM.

The Petition is cobbled together in every respect. Amazon addresses independent claim 1, for example, in piecemeal fashion. The asserted grounds start with alleged teachings of the content rendered on a single device (elements 1[a]-1[e]). They then *presume* the presence of a second device (such as required by elements 1[f]-1[i]) without addressing any express disclosure in the references of the two devices interacting. The asserted grounds then address the memory-related limitations (elements 1[j]-1[m]) in complete isolation from either of the foregoing.

The Petition's contentions regarding alleged motivations to combine the asserted references are similarly flawed. In fact, none of the asserted motivations to combine relate to creating a system or method where *two devices* communicate or interact in the manner claimed.

Further still, none of the alleged motivations to combine actually address the three-plus reference combinations presented in Grounds 1A-C and 2B-C. Rather, they discuss only the results/predictability of two-reference subsets of the asserted combinations.

Each of the foregoing is a foundational deficiency on its own. Prior art must be considered as a whole. “It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965); *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 449-49 (Fed. Cir. 1986) (district court ignored portions of the reference that led away from obviousness).

Merck Sharp & Dohme is instructive:

In making [the obviousness] inquiry, we have cautioned that “[t]he inventor’s own path itself never leads to a conclusion of obviousness; that is hindsight.” ... Thus, it is improper to combine references “like separate pieces of a simple jigsaw puzzle” without “explain[ing] what reason or motivation one of ordinary skill in the art at the time of the invention would have had to place these pieces together.”

Merck Sharp & Dohme B.V. v. Warner Chilcott Co., 711 F. App’x 633, 636 (Fed. Cir. 2017) (citing *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed.

Cir. 2012) and *InTouch Techs., Inc. v. VGO Commc 'ns, Inc.*, 751 F.3d 1327, 1349 (Fed. Cir. 2014)).

Further still, Amazon has not even attempted to show *in the Petition* that the Loukopoulos reference added in Grounds 1B and 2B is a prior art printed publication. In addition, Amazon improperly advances claim construction positions in this IPR inconsistent with positions taken in the parallel district court proceedings. Finally, Amazon's obviousness analysis is fundamentally lacking. Amazon does not provide any reasoned analysis as to reasonable expectation of success in making the asserted combinations

A. All Grounds: There is insufficient support for the alleged disclosures in Weisman.

1. Amazon's primary reference is plainly incapable of supporting its position.

The Petition relies on Weisman as its primary reference for every asserted ground and claim. This includes, for example, relying on Weisman for allegedly disclosing such things as downloading digital content (e.g., claims 1 and 20) in the form of "a plurality of digital media segments" (e.g., claim 8) that are adjusted based upon things such as "natural language gaps" (e.g., claim 10), or media streams "having different formats" (e.g., claim 17), where memory is manageable on two devices based upon, among other things, sharing a bookmark (e.g., claims

1, 14, and 20) and servers are “managed and optimized to maintain uninterrupted rendering” of digital content.

But Weisman focuses on technology for use on a flip-phone, and is plainly incapable of supporting Amazon's positions:

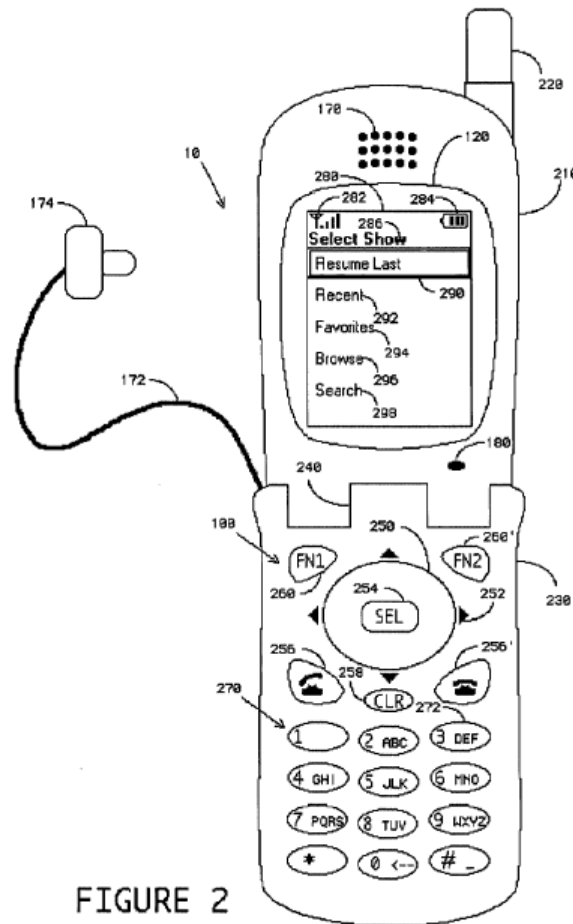


FIGURE 2

EX1035. Indeed, Weisman describes:

The present invention [of Weisman] relates generally to a way to provide entertainment and information services over a communication channel. More specifically, it provides a way to deliver selected program materials to a user having a communication device, such as a telephone or computer. *More specifically still, it provides a way to*

deliver selected audio program materials to a modern mobile telephone.

Id., ¶38 (emphasis added). Weisman, thus, teaches that its technology is intended to be implemented on and is compatible with 2002-era flip-phone technology.

With this background, it becomes clear why the Petition presents such a fragmented approach. The asserted grounds are all based on an unworkable premise that Weisman’s flip-phone technology could render every patent claim unpatentable. Indeed, the Petition presents arguments based on conclusory statements, supported only by string cites, without providing any additional reasoning or explanation. That confusion is only compounded in places where the Petition makes alternative assertions about single claim elements without explaining any of them in the full context of the reference(s).

2. Ground 1A: Weisman’s teachings do not support Amazon’s asserted ground.

A non-exclusive list of elements from claim 1 for which Amazon has not made a sufficient showing is discussed below.

a. Element 1[e]: creating a bookmark.

Element 1[e] recites “creating a bookmark by setting the current position as a bookmarked position, the bookmark including information for identifying the media work and the bookmarked position.” EX1001, 16:27-30.

The assertions about a “bookmark” in the Weisman reference are a good example of the Petition’s use of alternatives without explanation in the full context of the reference and claims. Here, the Petition asserts that “Weisman discloses creating a bookmark using the current position in multiple ways.” Pet., 15. Section VII.A.6 of the Petition addresses those multiple ways—prefaced by “First,” “Second,” and “Third.” *See* Pet., 15-16. But no other subsequent section in the Petition carries that analysis forward. It is, thus, not clear on which “way” the Petition relies when addressing other claim elements, disclosures, or motivations to combine. In fact, as discussed below, those details are left hanging behind a vague assertion of an analogy.

In terms of string cites, the primary argument is demonstrative. It states a conclusion without any elucidating analysis:

First, if playback is interrupted, the system creates a bookmark at that position and stores it in the “[r]ecent table.” (EX1035, Fig. 4; *id.* ¶¶[0049]-[0050], [0203]-[0204], [0208]-[0209].) [Fig. 4 shown] (*Id.* Fig. 4; EX1002 ¶56.).

Pet., 15.

That position is indecipherable on its face. It is also inconsistent when reviewing the citations. Paragraphs [0049] and [0050] of Weisman mention a “bookmark” but no “table.” *See* EX1035, ¶¶49-50. Paragraphs [0203] and [0204] say nothing of any “bookmark”; they describe “status” information stored in one of

at least *three* non-bookmark tables (“player table,” “recent table,” “synopsis data table”). *See id.*, ¶¶203-204. None of those even relate to the “bookmark table” disclosed later on in the specification and relied on elsewhere in the Petition. *Id.*, ¶¶253-254, 256.

Paragraphs [0208] and [0209] likewise say nothing of any “bookmark.” *Id.*, ¶¶208-209. They again describe the non-bookmark tables. They mention “limitations on the freedom to lend your telephone to other users.” *Id.*, ¶208. Paragraph [0208] concludes with a statement that is neither explained nor applied in the Petition: “the translation from PID to UID can be made through an owns relationship 422.” *Id.*.

The second argument is even more perfunctory: “Second, the user can create a bookmark with the same content discussed above using a ‘save’ button. (*Id.* ¶¶[0051], [0203]; EX1002 ¶57.)” Pet., 16. The third mirrors the second, except it replaces the word “save” with “mark.” *Id.*

The Petition attempts to tie the foregoing disparate concepts together as follows:

The bookmark table is analogous to the recent table, and stores the “position column” with the UID and EID “in the same manner” discussed above. (*Id.* ¶[0216]; EX1002 ¶58.).

Pet., 16.

Neither the Petition nor the expert declaration addresses the “bookmark table” of Weisman in any detail. Each mentions it exactly twice with no technical explanation or support. *See* EX1002, ¶58; Pet., 16. And the Petition relies upon Weisman’s “recent table” (not the “bookmark table”) in connection with other limitations. *See, e.g.*, Pet., 18, (citing ¶¶212-213 regarding resuming content “from where it was left off”), 22 (similar); *also id.*, 19, 49. Amazon does not explain why Weisman’s recent table and bookmark table can be treated as interchangeable in the asserted grounds. The Petition includes no discussion or explanation of how the many tables, UUIDs, EIDs, and other components of Weisman interrelate or are arranged as in limitation 1[e]—or how they fit into the other steps. The section addressing limitation 1[e] concludes by citing six paragraphs of the expert declaration, which merely repeat verbatim the paragraphs in the Petition. Together they constitute a single conclusory and unsupported ultimate conclusion about disclosure of a “bookmarked position.”

b. Element 1[f]: transferring a bookmark.

Element 1[f] recites “transferring the bookmark to a second client device via the network.” EX1001, 16:31-32.

The Petition asserts that Weisman “discloses [limitation 1[f]] or renders it obvious in two ways.” Pet., 17. But the Petition misapplies Weisman in two respects.

Its “First” argument is internally inconsistent and attempts to write in the notion of device-to-device transmission. The paragraph opens by asserting that Weisman discloses transferring “a bookmark via the network to a second user at a second *station*.” Pet. 17 (emphasis added). But the next sentence quotes Weisman to say that a user may “bookmark a passage ... for transferring to another *participant*.” *Id.* (citing EX1035, ¶¶81, 134-135) (emphasis added). And the two following sentences likewise cite to portions of Weisman regarding “allow[ing] user to send bookmarked passage to another *user*” and bookmarks sent by “another *participant*.” *Id.* (citing EX1035, ¶¶138, 216-219) (emphasis added). Indeed, the cited portions of Weisman do not discuss sending bookmarks to other devices or stations.

Its “Second” argument includes unsupported extrapolation of Weisman’s teachings. The Petition states that “A user can access those records from different stations” Pet., 17-18 (citing EX1035, ¶153-154). But Weisman does not expressly disclose the use of multiple stations by a user (using a single ID). Rather, it states, “Each time a participant uses *one* of the stations 10, 12 to access the head-end 18, *the* head-end preferably receives *the* phone number (as with caller-ID), or other identifying information, from *the* station.” EX1035, ¶154 (emphasis added).

There is no express disclosure in Weisman of a single user transferring bookmarks when using multiple stations or multiple users transferring bookmarks

between devices. And, Amazon has not made any inherency or obviousness argument on any of the foregoing points.

c. Elements 1[g]-1[i]: downloading, storing, and rendering second digital content on a second client device.

Elements 1[g]-1[i] recite downloading, storing, and rendering “second digital content” on a “second client device” (stated in summary fashion). *See* EX1001, 16:33-45.

Even if the transferring limitation 1[f], discussed above, were met by some implication, Weisman does not disclose any of those operations on a *second device*. Rather, the operation of an alleged second device is merely assumed. The Petition merely repeats disclosures/citations related to the first device. Pet., 18-22. The only support offered is the following:

A POSITA would have understood that Weisman’s disclosure of storing content on the client applies generally to any content to be rendered and any network-connected client device (e.g., stations 10, 12), including both the first and second client devices. (EX1002 ¶74; EX1035 ¶[0176] (“program captur[ed]” by stations 10, 12), Fig. 5.)
Pet., 21.

That is pure tautology. A system that works on one type of device independently will always work on an identical type of device independently. That does not mean the two devices can or do interact with each other—especially in the

manner claimed (e.g., reciting specific transfers, downloading, storing, let alone determining and managing storage and memory).

d. Elements 1[j]-[1]m: “memory management” on a second client device.

The Petition characterizes elements 1[j]-1[m] as the “memory management” limitations. *See* Pet., 23; EX1001, 16:46-59. Even if the limitations 1[f]-1[i] were met by way of some implication, the Petition still fails. This is because the Petition only addresses memory management only on a *single* device. It states that “elements 1[j]-[m] are related to memory management.” Pet., 23. It addresses those limitations in Section VII.A.11, on pages 23-41. The following is every bit of alleged support offered for the Petition’s assertion that memory management is conducted on a “second device” or “second client device” (other than repeating claim language):

- “*Accordingly*, Weisman, alone or with Guo, discloses or renders obvious releasing storage resources (e.g., chunks in a buffer) allocated to all content of the second digital content (e.g., episode) that is not identified as content to be retained (e.g., in the buffer) on the second client device (e.g., station). (EX1002 ¶¶94-97.)” Pet., 30 (emphasis added).
- “*Thus*, Weisman renders obvious determining whether sufficient storage (e.g., empty buffer space) is available on the second client

device (e.g., station) to meet storage demand (e.g., for subsequent episodes or chapters) after releasing the storage resources allocated to the content of the second digital content that is not identified as content to be retained (supra §VII.A.11.c). (EX1002 ¶100.).” Pet., 32 (emphasis added).

- “*Accordingly*, Weisman in combination with Guo discloses or renders obvious determining whether sufficient storage is available (e.g., determining if memory is full or nearly full) on the second client device to meet storage demand after releasing the storage resources (e.g., chunks) allocated to the content of the second digital content (e.g., part of an episode) that is not identified as content to be retained (e.g., not preserved under the replacement policy). (EX1002 ¶¶98-102.).” Pet., 33 (emphasis added).
- “*By determining whether sufficient memory is available whenever an object (or chunk) is deleted*, Aviani determines whether sufficient storage is available (e.g., computes free disk space) on the second client device to meet storage demand (e.g., based on object size) after releasing the storage resources allocated to the content (e.g., deleting object) of the second digital content that is not identified as content to be retained. (EX1002 ¶104.).” Pet., 34-35 (emphasis added).

Every mention of the second device is prefaced with a subordinating conjunction: meaning it states a conclusion. But neither Amazon nor its expert points to disclosure in the asserted art or otherwise provides explanation to support the conclusions that that memory management is conducted on a “second device” or “second client device.” The Petition—which generally mirrors the expert declaration (*see* EX2009, pgs. 49-90)—does not even mention them in any analysis leading up to those conclusions.

e. Element 1[m]: narrowing range of content.

Element 1[m] recites “if insufficient storage is available [on the second client device], narrowing the range of content surrounding the bookmarked position that is identified as content to be retained.” EX1001, 16:57-59. The Petition does not address any “second device” or “second client device” in connection with limitation 1[m]. It does not even mention those words. Thus the Petition fails to establish a *prima facie* ground of invalidity on that basis alone.

* * *

For these reasons, Amazon has not shown a reasonable likelihood of success as to independent claim 1 under asserted Ground 1A. For claim 20, the only other independent claim, the Petition exclusively refers back to the argument presented for claim 1. Pet., 53. Thus, because Amazon has not established a reasonable likelihood of success as to claim 1, it also has not established a reasonable likelihood of success as to any challenged claim.

3. Ground 2A is perfunctory and confusing.

The Petition addresses independent claim 1 in Ground 1A on pages 8-41. It addresses the same claim in Ground 2A on eight pages. Pet., 61-68. That latter Ground (2A) repeatedly cites back to Section VII.A (Ground 1A, claim 1). *Id.* That sole-citation-back approach cannot support Amazon's burden. 35 U.S.C. §312(a)(3) (a petition must "identif[y], in writing and *with particularity*, each claim challenged, the grounds on which the challenge to each claim is based, and *the evidence that supports the grounds for the challenge to each claim*" (emphasis added)); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019).

It is also problematic from a technical-coherency standpoint. The two grounds are not coextensive. Ground 1A is based upon the combination of Weisman, Guo, and Aviani. Pet., 7. It is not clear, then, which portions of the Ground 1A discussion are to be incorporated or applied in Ground 2A (e.g., express disclosures or those that Amazon asserts would have been obvious). The Petition even acknowledges the confusion by lumping the analysis together. It repeatedly states "Weisman discloses or renders obvious this limitation." Pet., 61, 64, 67.

For these reasons, Amazon also has not shown a reasonable likelihood of success as to independent claim 1 under asserted Ground 2A. Again, for claim 20,

the Petition exclusively refers back to the argument presented for claim 1. Pet., 71.

Thus, because Amazon has not established a reasonable likelihood of success as to claim 1, it also has not established a reasonable likelihood of success as to any challenged claim.

B. All Grounds: None of the references or motivations to combine address the recited second client device.

In addressing motivation to combine the references, the Petition completely fails to address the communication or interplay between the first and second client devices that is recited in the claims.

The claims recite a number of limitations related to identifying a range of content in the second digital content, retaining certain content, releasing certain storage resources, determining whether sufficient storage is available, and narrowing the range of content. *See* Elements 1[j]-1[m]. Each of those claim elements relates to *second* digital content on a *second* client device. But each one also relates, directly or indirectly, to “content corresponding to the media work,” which is “download[ed]” by the “first client device,” as recited in elements 1[a]-1[c]. The steps are related to each other via the sharing of the bookmark recited in elements 1[e]-1[g] and 1[i]. But the Petition never addresses elements 1[e]-1[g] and 1[i] in the context of elements 1[a]-1[c].

That failing is clear from the obviousness assertions. The Petition introduces a number of secondary references to address the claimed memory management

claim elements—namely, Guo and Aviani for Ground 1A and Ottesen for Ground 2A. Pet., 7. For example, in the context of elements 1[j], the Petition addresses motivation to combine Guo with Weisman on pages 28-29. Here, neither the Petition nor the expert declaration mentions “a second client device” or anything “corresponding to the media work” or any “corresponding” content. *Id.*

Likewise, the Petition addresses motivation to combine Weisman and Aviani in the context of element 1[l] on pages 35-37. Again, neither the Petition nor the expert declaration mentions “a second client device” or anything “corresponding to the media work” or any “corresponding” content. *Id.*

Similarly, the Petition addresses motivation to combine Weisman and Ottesen in the context of element 1[j] on pages 63-64. Yet again, neither the Petition nor the expert declaration mentions “a second client device” or anything “corresponding to the media work” or any “corresponding” content. *Id.*

In short, the Petition only addresses one individual portion of the independent claims—in isolation from the other steps—at any given time. It thus fails to present a tenable obviousness assertion. Section 103 of the Patent Act requires that the entire claimed invention be considered, not simply a missing limitation. MPEP § 2141.02. *See Jones v. Hardy*, 727 F.2d 1524, 1530 (Fed. Cir. 1984); *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (“The ‘as a whole’ instruction in title 35 prevents evaluation of the invention part by part. ...

This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result—often the very definition of invention.”); *Princeton Biochemicals, Inc. v. Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005); *Allergan, Inc. v. Apotex, Inc.*, 754 F.3d 952 (Fed. Cir. 2014).

C. Ground 1A-C and 2B-C: Amazon fails to perform a proper motivation to combine analysis under *Graham*.

Amazon fails to explain how or why a POSITA would have been motivated to implement the teachings of the *combinations* asserted in Grounds 1A-C and 2B-C. Instead, the Petition only discusses alleged motivations for combining *discrete* references. For example, Ground 1A relies on Weisman, Guo, and Aviani. Pet. 7. But the only asserted motivations to combine are for a Weisman-Guo combination (Pet., 28-29) or a Weisman-Aviani combination (Pet., 35-36). The complete Weisman-Guo-Aviani combination is never addressed. *Id.*

Similarly, Ground 1B relies on Weisman, Guo, Aviani, and Loukopoulos. Pet., 7. But the only asserted motivations to combine are for a Weisman-Loukopoulos combination. Pet., 54-58. The Weisman-Guo-Aviani-Loukopoulos combination is never addressed. *Id.* And Ground 1C relies on Weisman, Guo, Aviani, and Sull. Pet., 7. But the only asserted motivations to combine are for a Weisman-Sull combination. Pet., 59-60. The Weisman-Guo-Aviani-Sull combination is never addressed. *Id.* In the same way, Ground 2B relies on

Weisman, Ottesen, and Loukopoulos. Pet., 7. But *no motivation* to combine is provided in the one, conclusory sentence that constitutes Ground 2B. Pet., 71. The same is true of Ground 2C. *Id.*

As such, Amazon has failed to perform a proper motivation to combine analysis under *Graham*. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966) (“*Graham*”). The three key factual inquiries set forth in *Graham* for establishing obviousness under 35 U.S.C. § 103(a) are: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, and (3) resolving the level of ordinary skill in the pertinent art. *Graham* at 17-18. These factual inquiries must be tied together by “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Here, Amazon’s motivation to combine arguments—or lack thereof—run afoul of the bedrock principles set forth in *Graham*. They fail to set forth the differences between the art and the claims, as required by the second factual inquiry under *Graham*. The second *Graham* factor necessarily involves an analysis of what the references and claims teach, and what is missing, and “requires a comparison of the properly construed claim to the prior art.” *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010). When a petitioner seeks to

rely on a three reference combination (References A, B, and C, for example), the second *Graham* factor requires an analysis of what is missing from the combination of References A and B compared to the claims before determining whether a motivation exists to add Reference C to that existing combination. *See, e.g., Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, 122 F.4th 1378, 1386 (Fed. Cir. 2024) (*citing Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013) (holding that when analyzing a proposed combination of references, the references sought to be combined “must be read together, not in isolation.”)). Those differences are necessary to articulate which portions of the references a POSITA would have sought to combine or modify. For example, the motivation to use a different memory storage device in Reference B with Reference A would be far different than the motivation to use a transmission protocol in Reference B with Reference A.

If a proposed ground of invalidity fails to identify the differences between the existing combination of prior art references (e.g., combination of References A and B) and the claimed invention, then such a ground has necessarily failed to establish a *prima facie* case of obviousness, and the petition should be denied. *Id.*; *see also Apple, Inc. v. ContentGuard Holdings, Inc.*, IPR2015-00355, Paper 9 at 9 (P.T.A.B. June 26, 2015) (finding no reasonable likelihood of prevailing because “the Petition does not identify sufficiently the differences between the claimed

invention and the prior art, or how the prior art teachings are to be modified or combined, if at all.”). Therefore, the Board should deny institution because the Petition fails to satisfy at least the second factual inquiry under *Graham*. *Enzo Biochem*, 599 F.3d 1325 at 1332.

D. Grounds 1B and 2B: Amazon fails to demonstrate in the Petition that Loukopoulos is a prior art printed publication.

Amazon has not even attempted to make the required minimum showing, *in the Petition*, that Loukopoulos (EX1038) is a prior art printed publication. Thus, Grounds 1B and 2B, the only grounds challenging claims 2-6, must fail.

Board precedent requires that a petitioner establish a reasonable likelihood *in the petition* that a reference is a printed publication. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (P.T.A.B. Dec. 20, 2019) (precedential). Amazon has not met that burden here. Amazon provides *no* discussion supporting the alleged publication date of Loukopoulos. Pet., 7.

Amazon “does not discuss in the Petition *any* evidence supporting the implicit position that [Loukopoulos] was *publicly accessible* prior to the critical date of the claimed invention.” *BabyBjörn AB v. The ERGO Baby Carrier, Inc.*, IPR2025-00110, Paper 20 at 14 (P.T.A.B. Apr. 22, 2025) (emphasis original). In *BabyBjörn*, as here, petitioner submitted a declaration allegedly supporting the publication date and public accessibility of the reference at issue. *Id.*, at 14. The Board declined to “search through the record to develop [p]etitioner’s arguments on th[e] issue.” *Id.*

(citing *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) (“Judges are not like pigs, hunting for truffles buried in briefs.” (quoting *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991))).

The *only* evidence cited by Amazon in support of the publication dates is a bare citation in the parenthetical following the list of references of “EX1097 ¶¶45-53.” Pet., 7. Paragraphs 45-53 of Exhibit 1097, however, encompasses 5 pages of a declaration from Sylvia D. Hall-Ellis, Ph.D. Citing to *multiple pages of the declaration* with no accompanying explanation fails the requirement that “the petition identif[y] [the supporting evidence], in writing and *with particularity*.” 35 U.S.C. § 312(a)(3) (emphasis added). It also runs afoul of Rule 42.6(a)(3), which provides that “[a]rguments must not be incorporated by reference from one document into another document.” *See also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. § 312(a)(3))).

Amazon simply has not met its burden under *Hulu* to show *in the Petition* a reasonable likelihood that these references are prior art printed publications. Therefore, Grounds 1B and 2B, each of which relies on Loukopoulos, fail.

E. All Grounds: Amazon advances inconsistent claim constructions here and in the District Court.

Claims must be interpreted the same for invalidity and infringement: “It is axiomatic that claims are construed the same way for both invalidity and infringement.” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988)). “A patent may not, like a ‘nose of wax,’ be twisted one way to avoid anticipation and another to find infringement.” *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (citing, among others, *White v. Dunbar*, 119 U.S. 47, 51 (1886)). Yet, Amazon attempts to do just that—applying a broader plain and ordinary meaning construction in this and related IPRs, while simultaneously proposing narrower constructions for several terms in the district court.

In particular, in this IPR, filed on March 24, 2025, Amazon asserted that “[n]o claim terms require construction.” Pet., 6. Just one month later, in the district court, the parties jointly submitted their claim construction positions. EX2007. Unlike in the Petition which argues no construction is necessary,¹ in the district

¹ Across all of the IPRs filed against Audio Pod’s patents, Amazon has not proposed construction for a single claim term. See IPR2025-00757 Pet., 12; IPR2025-00765 Pet., 7-8; IPR2025-00768 Pet., 6; IPR2025-00774 Pet., 5;

court, Amazon proposed constructions for several claim terms and argued that others are indefinite. EX2007. In fact, the EDVA court set a longer time-to-trial schedule based on Amazon's representation that it would conduct extensive claim construction proceedings, including introducing expert testimony.² EX2019; EX2010.

Amazon provides no explanation to justify the different positions taken in the two forums. That is improper. *Cf. Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (P.T.A.B. Dec. 13, 2024) (informative) (denying institution where petitioner argued for a means-plus-function construction in

IPR2025-00777 Pet., 5; IPR2025-01003 Pet., 4; IPR2025-01041 Pet., 6. In the district court proceedings on the other hand, Amazon contends many terms require construction. *See, e.g.*, EX2007. Notably, some of these petitions were filed *after* Amazon's claim construction positions were submitted in the district court.

² The parties initially negotiated a schedule around an August 2025 *Markman* hearing and early 2026 trial. That schedule was pushed out when the Court could not schedule a *Markman* hearing until October 2025, and then a medical issue with Audio Pod's expert necessitated an additional extension to November 2025.

district court and a plain and ordinary meaning construction in the petition, but failed to explain the difference in claim construction positions).

Amazon puts Audio Pod and the Board in the untenable position of assessing Amazon's asserted grounds without an understanding Amazon's true position as to the scope of the challenged claims. Amazon's approach is fundamentally unfair, and results in a certainty of inconsistent results between the Board and the district court. *See Kiosoft Techs., LLC v. PayRange, Inc.*, IPR2021-00086, Paper 12 at 16 (P.T.A.B. Mar. 22, 2021) (petitioner and its expert advocated for different constructions at the district court and the PTAB).

Amazon's inconsistent claim construction positions is likely one of the reasons Amazon relies on a different expert for the IPRs (Ketan Mayer-Patel, Ph.D) than it does in the underlying litigation (Dan Schonfeld, Ph.D). Audio Pod's expert (Kevin Almeroth, Ph.D) provided an expert declaration addressing claim construction in the underlying litigation. He was deposed for the better part of a day on those issues on July 9. And Dr. Schonfeld already provided two declarations related to claim construction. He will be deposed on July 22. All that testimony arose from Amazon's positions on claim construction. Amazon neither identified nor addressed any of those positions in its various petitions.

F. All Grounds: Amazon’s obviousness analysis is fundamentally lacking due to conclusory assertions regarding reasonable expectation of success.

To show obviousness, Amazon must “demonstrate *both* that a skilled artisan would have been *motivated to combine* the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a *reasonable expectation of success* in doing so.” *Intelligent Bio-Sys.*, 821 F.3d at 1367–68 (internal citations omitted, emphasis added). To satisfy its burden, a petitioner must “articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness”—“mere conclusory statements” will not suffice. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Here, in addition to the deficiencies regarding motivation to combine discussed above, Amazon’s assertions about reasonable expectation of success and predictable results are also insufficient.

Even if there were any basis for concluding that the smattering of references were compatible, that is not enough. “Mere compatibility of references is ... not sufficient” to support obviousness. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 17 (P.T.A.B. Oct. 16, 2018) (denying institution based on lack of showing of expectation of success; citing *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017)). And “similarities in transmission hardware” are not enough to close the gaps between prior art “without additional,

reasoned analysis.” *DSS Tech. Mgmt. v. Apple Inc.*, 885 F.3d 1367, 1376-77 (Fed. Cir. 2018).

Likewise, generic desires for improvement are also insufficient. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-00582, Paper 34 at 21-22 (P.T.A.B. Aug. 5, 2019) (informative decision) (“a generic desire for ‘improved access times’” is “merely a bald statement ...”). “The factual inquiry whether to combine references must be thorough and searching,” and “[t]he need for specificity pervades this [Court’s] authority” on the Board’s findings on motivation to combine. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

But that is what the Petition provides. Most assertions of “reasonabl[e] expect[ation]” are based on flat statements that a general concept (e.g., “memory management techniques,” “media segmenting,” or “transfer of information”) was “well known.” Pet., 29, 36, 42, 46, 66. “It does not suffice to simply be known. A reason for combining must exist.” *Virtek Vision Int’l ULC v. Assembly Guidance Systems, Inc.*, 97 F.4th 882, 888 (Fed. Cir. 2024) (reversing the Board’s obviousness determination). Other times, the Petitions relies on the empty conclusion that the general concept of being “more efficient” somehow demonstrates reasonable expectation of success. Pet., 29 (“Guo explains how that could be implemented more efficiently.”), 37 (“Aviani provides details about how that could be accomplished efficiently”), 55 (“Loukopoulos provides details about

how those could be implemented efficiently.”), 64 (“Ottesen describes how that could be accomplished efficiently.”); *see also id.* 69 (“Ottesen teaches an implementation for that approach.”).

Every recitation of predictable results is a circular statement that combining the references would create the effect of the combination. Pet., 28 (“predictable results (storing and deleting chunks of Weisman’s content)”), 29 (“predictable results (significantly increased storage utilization and streaming performance)”), 36 (“predictable results (determining whether content should be retained or removed)”) and (“predictable results (improved buffer performance)”), 55 (“predictable results (reducing latency)”), 60 (“predictable results (refreshing user’s memory and providing context)”), 63 (“predictable results (Weisman’s stations providing VCR-type control)”), 64 (“predictable results (efficient memory usage and VCR-type control)”), 66 (“predictable results (identifying available storage)”).

Rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (citing *KSR*, 550 U.S. at 418)). “This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103.” *Id.* (citing

Kahn, 441 F.3d at 988). Accordingly, “a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine” because “[t]his type of finding, without more, tracks the ex post reasoning *KSR* warned of and fails to identify any actual reason why a skilled artisan would have combined the elements in the manner claimed.” *Id.* (citing *In re Van Os*, 844 F.3d 1359, 1361-62 (Fed. Cir. 2017)).

In short, Amazon’s conclusory statements are insufficient for institution. *See, e.g., NJOY, LLC v. JUUL Labs, Inc.*, IPR2024-00536, Paper 17 (P.T.A.B. Aug. 12, 2024) (denying institution where petitioner did not show a reasonable expectation of success in combining the asserted references); *Honeywell Int’l Inc. v. DSM IP Assets, B.V.*, IPR2024-00493, Paper 7 (P.T.A.B. Aug. 21, 2024) (same).

IV. CONSERVATION OF RESOURCES

If the Board finds that Amazon fails to meet its burden for less than all of the Challenged Claims and/or proposed grounds, the Board should deny institution to conserve resources.

Audio Pod identifies numerous deficiencies in Amazon’s arguments in the discussion above. Should the Board determine that Amazon met its burden for some claims or Grounds, but failed to meet its burden for other claims or Grounds, the Board should still deny institution to conserve the Board’s valuable resources. *See Interim Processes for PTAB Workload Management Memorandum* (March 26,

2025) (“March 26, 2025 Memo”), 3; *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10–11 (P.T.A.B. Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative); *see also* EX1008, FAQ9 (Board panel may address discretionary considerations “where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources, as explained in” *Chevron* and *Deeper*), FAQ11.

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless ... the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” But even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims, institution of review remains discretionary. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). 35 U.S.C. § 316(b) also provides that, when determining whether to exercise its discretion, the Board should consider the effect of any regulations on “the efficient administration of the Office [and] the ability of the Office to timely complete proceedings.”

Additionally, 37 C.F.R. § 42.1(b) provides that the Board should also take into account the requirement to construe the rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” The Trial Practice Guide also explains that the Board may consider the number of claims and grounds that meet and do not meet the reasonable likelihood standard when deciding whether to institute *inter partes* review under 35 U.S.C. § 314(a). Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019, p. 64 (Nov. 20, 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“CTPG”) (“[T]he panel will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied.”).

Here, should the Board determine that Amazon failed to meet its burden of establishing unpatentability for some but fewer than all of the challenged claims of the '922 patent as discussed in Section III, the Petition should still be denied in order to conserve the Board’s valuable time and resources. March 26, 2025 Memo, 3; *Deeper*, IPR2018-01310, Paper 7 at 43 (finding that because petitioner only demonstrated a reasonable likelihood of prevailing with respect to a subset of the 23 challenged claims, “instituting a trial with respect to all twenty-three claims ... would not be an efficient use of the Board’s time and resources.”). Similarly, should the Board determine that Amazon has failed to meet its burden of

establishing unpatentability for some but not all grounds, the Petition should again be denied in order to conserve the Board's valuable time and resources. March 26, 2025 Memo, 3; CTPG, 64; 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

V. CONCLUSION

The Petition fails to show a reasonable likelihood that any of the challenged claims is unpatentable as obvious in view of the cited art and, therefore, the Board should deny institution.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 7,598 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER PRELIMINARY
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