

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 IPR2025-00777
U.S. Patent No. 9,319,720

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

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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	2
A.	Audio Pod’s founders invented key early media streaming technologies, including the inventions claimed in the ’720 patent.....	2
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.	5
III.	THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM.	7
A.	Grounds 1A-1I and 2C: Amazon fails to demonstrate in the Petition that DTB, Yoshimura, Bulterman, and Amir are prior art printed publications.....	8
B.	All Grounds: Amazon advances inconsistent claim constructions here and in the District Court.....	10
C.	All Grounds: Amazon’s obviousness analysis is fundamentally lacking due to conclusory assertions regarding reasonable expectation of success and motivation to combine.	13
1.	Amazon’s contentions regarding reasonable expectation of success are insufficient.....	14
2.	Amazon fails to perform a proper motivation to combine analysis under <i>Graham</i> for many dependent claims.....	16
3.	Other alleged motivations are purely conclusory	19
D.	Claims 1, 24-26, Grounds 1A and 1F	24
1.	Amazon has not sufficiently shown that Yoshimura alone teaches elements 1[f] or 1[h].	25
2.	Amazon also has not shown that Yoshimura in combination with Lindahl teaches these limitations.	28
E.	Claims 1, 24-26, Grounds 2A and 2B	30
F.	Amazon gives the dependent claims short shrift.	31

IV.	CONSERVATION OF RESOURCES.....	33
V.	CONCLUSION	35

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. 9,319,720 (“the ’720 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. Amazon did not even attempt to make the required minimum showing *in the Petition* that four non-patent literature references included in ten of the thirteen asserted grounds were even prior art

printed publications. Moreover, 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.

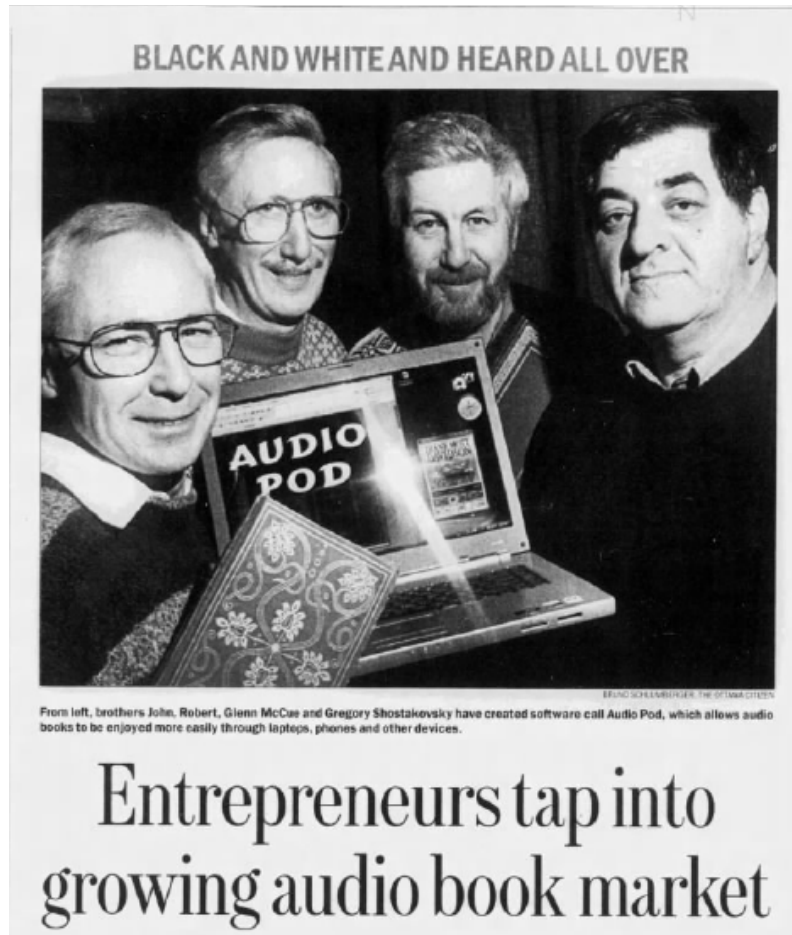
Further still, for each of the asserted grounds challenging the independent claims, Amazon has failed to show at least one element of the claims. That is true for many of the dependent claims as well, where Amazon provides only perfunctory discussion, or simply refers back to earlier claims while ignoring much of the claim language in the dependent claims.

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 '720 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.

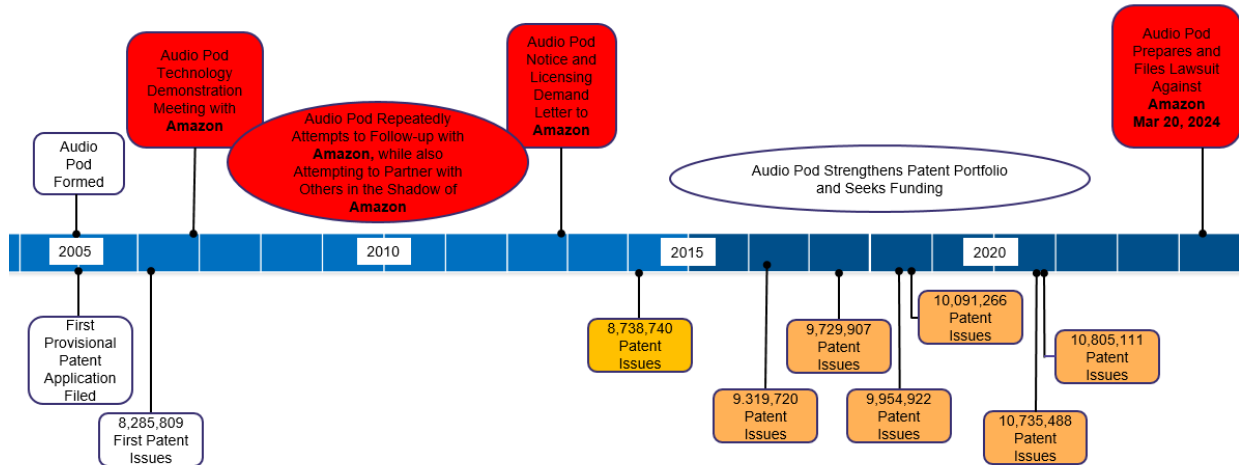
After the meeting, beyond a brief acknowledgement of a “thank you” email sent by the Audio Pod team, Amazon broke contact with Audio Pod, ignoring repeated attempts by Audio Pod to follow up after the meeting. EX2015, ¶12. Amazon acquired Audible in 2008, and subsequently released “Whisper Sync for Voice” 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.

Amazon cobbles together eleven references into thirteen alleged grounds of unpatentability. The Petition is fundamentally flawed, as Amazon has not even attempted to show *in the Petition* that several of the asserted references are prior art printed publications. In addition, Amazon improperly advances claim construction positions in this IPR inconsistent with positions taken in the parallel district court proceedings. Further, Amazon's obviousness analysis is fundamentally lacking. Amazon does not present a proper analysis under the *Graham* factors, nor does Amazon provide any reasoned analysis for its alleged motivations to combine the various references or as to reasonable expectation of success in making the combinations.

As to the specific challenges, Amazon fails to show that the asserted

combinations teach or render obvious “determining a first digital data file from the plurality of digital data files ... using the time information in the descriptor file and a predetermined time offset, the predetermined time offset external to the descriptor file,” as recited in the independent claims. Further still, Amazon gives short shrift to the majority of the dependent claims, presenting only cursory analysis, if any at all, in alleging the dependent claims are obvious.

Based on the many deficiencies in the Petition described below, this IPR should be denied.

A. Grounds 1A-1I and 2C: Amazon fails to demonstrate in the Petition that DTB, Yoshimura, Bulterman, and Amir are prior art printed publications.

Amazon has not even attempted to make the required minimum showing *in the Petition* that certain asserted references—DTB (EX1003), Yoshimura (EX1006), Bulterman (EX1012), and Amir (EX1040)—are prior art printed publications. This is particularly remarkable in that Yoshimura is the primary reference relied upon in nine of the asserted grounds. In total, these references are included in 10 of Amazon’s 13 asserted grounds. *See Pet.*, 5-6.

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[s]” of these references, Pet., 6-7, nor does Amazon “discuss in the Petition *any* evidence supporting the implicit position that the[se] [references] w[ere] *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 of “*see* EX-1097.” Pet., 6-7. Exhibit 1097, however, is a 43-page declaration from Sylvia D. Hall-Ellis, Ph.D. Citing to the *entire 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 1A-1I and 2C, each of which relies on one or more of these references must fail.

B. 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., 5. 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 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.

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; IPR2025-00769 Pet., 6; IPR2025-00774 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

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 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 (PTAB 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

medical issue with Audio Pod's expert necessitated an additional extension to November 2025.

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.

C. All Grounds: Amazon's obviousness analysis is fundamentally lacking due to conclusory assertions regarding reasonable expectation of success and motivation to combine.

In addition to specific reasons discussed below (Sections III.D-F), Amazon's asserted grounds are deficient for failing to establish a *prima facie* case of obviousness for the combination of references it presents. 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., Inc.*, 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, Amazon's allegations both for motivation to combine and reasonable expectation of success are conclusory and insufficient.

1. Amazon’s contentions regarding reasonable expectation of success are insufficient.

Amazon’s contentions regarding reasonable expectation of success are insufficient. For example, as to claim 1, Amazon asserts:

A POSITA would have reasonably expected success in transmitting audiobooks using Yoshimura’s system at least because Yoshimura already uses “modified SMIL files” to “enable multimedia content to be delivered” (EX-1006, 1778), and because using SMIL files for audiobooks was widely known (EX-1004 ¶[0004]; EX-1003, vii, 3). (EX-1002 ¶53.)

Pet., 13 (discussing Element 1[b]). And similarly for Element 1[f], the sole basis for an expectation of success provided is that “both Yoshimura and Lindahl are adapted for use with SMIL-file based systems.” Pet., 21.

As an initial matter, the allegation of reasonable expectation is legally insufficient. Even if there were any basis for concluding that both references disclosed compatible variants of SMIL, “[m]ere 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 despite Amazon’s contentions that both references use SMIL, nothing in Lindahl mentions SMIL. *See generally* EX1004. Nor does the Petition provide

any argument or analysis as to how SMIL relates to Lindahl's system. Pet., 21; EX1002 ¶76 (mirrors petition). Further, even if SMIL files were "widely known," Pet., 13, Yoshimura's system does not rely on SMIL files. It relies on something new: Yoshimura's "*modified* SMIL files." See Pet., 8-9, 10, 12, 13-14, 29 (emphasis added). Amazon does not address this distinction in discussing the reasonable expectation of success, and provides insufficient evidence to support that a POSITA would have been able to implement Yoshimura's specific variant in any other system.

Amazon's contentions regarding reasonable expectation of success are similarly conclusory and deficient throughout the Petition's other 12 asserted grounds. See, e.g., Pet., 25 (claim 2, "A POSITA would have reasonably expected success in applying Heckerman's segmentation method in Yoshimura's system because Yoshimura discloses segmenting media content and because segmenting content based on gaps in natural language was well known."), 28 (claim 6, "A POSITA would have been motivated to use Heckerman's segmented text files in Yoshimura's system and would have reasonably expected success in doing so."), 39 (claim 17, "A POSITA would have reasonably expected success ... because streaming media including images and/or user annotations was well known."), 42 (claim 16, "Methods to automate page turning were commonplace and well-understood, giving a POSITA a reasonable expectation of success in the

modification.”).

Amazon’s conclusory statements regarding a reasonable expectation of success 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).

2. Amazon fails to perform a proper motivation to combine analysis under *Graham* for many dependent claims.

Likewise, for many of the dependent claims, Amazon fails to explain how or why a POSITA would have been motivated to implement the teachings of the additional references into the *combination* asserted against claim 1. Instead, the Petition only addresses the combination with only a single reference of the combination asserted against the independent claims. *See, e.g.,* Pet., 24-25 (claim 2, discussing only how to combine Heckerman with Yoshimura), 32 (claim 5, discussing only how to combine Bulterman with Yoshimura), 41-42 (claim 16, discussing only how to combine Hay with Yoshimura), 43 (claim 19, discussing only how to combine Sull-948³ with Lindahl), 45-46 (claim 21, discussing only

³ Audio Pod also notes that the Petition asserts that “The Office has not considered ... Sull-948.” Pet., 75 (citing (EX1060, WO2002/08948A2 (“Sull-

how to combine Amir with Yoshimura).

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 at 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

948’’)). But the Office considered U.S. Patent Publication No. 2002/0069218 (EX1005 (“Sull-218’’)). It is cited on IDS forms in three places. EX1095, at 2, 27, 218. Sull-948 is a parallel WIPO publication to Sull-218. Compare EX1005, (22), (63), with EX1060, (22), (30) (showing both Sull-218 and Sull-948 claim priority to the same five provisional applications, and were filed on the same day).

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 at 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.

3. Other alleged motivations are purely conclusory

Unpatentability determinations 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)).

Amazon's motivations for many of the dependent claims reduce to an assertion that the additional feature "was known in the art" or a ubiquitous desire to make things "more efficient." A non-exhaustive list of examples of the Petition's perfunctory analysis is provided below:

- Claim 3, Ground 1, the entire motivation to combine analysis alleges:
"Even if the [missing elements] were not inherent in Yoshimura's SMIL file, it would have been obvious to add them because doing so was known in the art." Pet., 26.
- Claim 6[a], Ground 1, the entire motivation to combine analysis alleges: "A POSITA would have been motivated to use Heckerman's [disclosure] in Yoshimura's system and would have reasonably expected success in doing so. (*Supra* §VIII.A; EX-1002 ¶114.)." Pet. 28.
- Claim 12, Ground 1, the entire motivation to combine analysis alleges: "Assigning start and end times to a plurality of text fragments would have been obvious in view of Yoshimura, Lindahl, and Bulterman. (*Supra* §IX.B; EX-1002 ¶153.)." Pet., 35; *see also* EX1002, ¶153 (repeating the same conclusory statement).

- Claim 14, Ground 1, the Petition provides *no motivation*; it simply concludes as follows: “Thus, this claim would have been obvious in view of Yoshimura, Lindahl, and Heckerman. (EX-1002 ¶¶128-31.).” Pet., 31; *see also* EX1002, ¶¶130-131 (repeating the same conclusory statement in two ways).
- Claim 15, Ground 1, the Petition provides *no motivation*; it simply concludes as follows: “Thus, this limitation was obvious in view of Yoshimura, Lindahl, and Heckerman. (*Supra* §§VII.A.9; VIII.A, VIII.J; EX-1002 ¶¶132-33.).” Pet. 31; *see also* EX1002, ¶133 (similar conclusory statement).
- Claim 20, Ground 1, the Petition provides *no motivation*; it simply concludes as follows: “It would have been obvious an audiobook stream would include illustrations from the book segmented in the same manner. (*See, e.g.*, EX-1003, 60-61 (disclosing audiobooks with text and images are synchronized); EX-1002 ¶170.).” Pet., 40; *see also* EX1002, ¶170 (repeating the same conclusory statement).
- Claim 22, Ground 1, the Petition provides *no motivation*; it simply concludes as follows: “This limitation would have been obvious in view of Yoshimura, Lindahl, and Heckerman. (*Supra* §§VII.B,

VII.A.7, VIII.J; EX-1002 ¶¶134-35.).” Pet. 31; *see also* EX1002,

¶¶134, 135 (repeating the same conclusory statement in two ways).

- Claim 24, Ground 1, the Petition provides no identifiable motivation, only a string cite: “Claim 24 combines the limitations of previously discussed claims. Claim 24 would have been obvious. (Supra §§VII.A, VIII.C-VIII.E, VIII.H-VIII.I, VIII.K, XII.A; EX-1002 ¶¶180-82.).” Pet., 42; *see also* EX1002, ¶¶180-182 (similarly referring back only to discussion of prior claims).
- Claim 19, Ground 1, the Petition relies upon a general desire to be more efficient without explaining how or why an SMIL file would make bookmark retrieval more efficient: “A POSITA would have understood this would be a faster and more efficient way to retrieve the bookmarked file.” Pet., 43 (citing Ex1002, ¶187); *see also* EX1002, ¶187 (providing no further explanation).
- Claim 21, Ground 1, the entire motivation to combine analysis alleges: “A POSITA would have been motivated to obtain a time offset from a text search of media content because text search in multimedia content was well known. (See, e.g., EX-1048, Abstract, 8:15-44, Fig. 12; EX-1003, 18; EX-1040, 210-11; EX-1002 ¶198.).”

Pet., 45-46; *see also* EX1002 ¶198 (repeating the same without further explanation).

- Claim 27, Ground 1, the Petition provides *no motivation*; it simply concludes as follows: “Claim 27 would have been obvious. (Supra §XIII.B; EX-1002 ¶¶194-95.)” Pet., 45; *see also* EX1002, ¶¶194-195 (repeating the same conclusory statement in two ways).

None of these statements is sufficient to meet Amazon’s burden regarding motivation to combine. *TQ Delta, LLC v. Cisco Sys.*, 942 F.3d at 1359. “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).

For the claims in Ground 2, the lack of explanation is even more egregious. They often refer back to the motivation discussed with respect to Ground 1. But Ground 1 *is based on different references*. *See, e.g.*, Pet., 60 (claim 2, referring back to ground 1 analysis for reasons to combine with Heckerman), 65 (claim 11, referring back to ground 1 analysis), 69 (claims 16, 24, referring back to ground 1 analysis for reasons to combine with Hay).

Accordingly, Amazon has not met its burden to show a motivation to combine the references in any of these grounds. *Magnum Oil*, 829 F.3d at 1380.

D. Claims 1, 24-26, Grounds 1A and 1F

Amazon fails to sufficiently show that the combination of Yoshimura and Lindahl teaches or renders obvious “determining a first digital data file from the plurality of digital data files ... using the time information in the descriptor file and a predetermined time offset, the predetermined time offset external to the descriptor file” (Element 1[f]) and “rendering the digital content ... at an arbitrary point determined using the predetermined time offset” (Element 1[h]) as recited in independent claim 1 and similarly recited in independent claims 24-26.

Independent claim 1 recites, “determining a first digital data file from the plurality of digital data files in a first media stream from the plurality of media streams ... using the time information in the descriptor file and *a predetermined time offset, the predetermined time offset external to the descriptor file.*” EX1001, 40:38-45 (emphasis added). Claim 1 further recites “rendering the digital content ... *at an arbitrary point* determined using the predetermined time offset.” EX1001, 40:51-53. Independent claims 24-26 include a similar claim element. *See* EX1001, 43:27-44:67; *see also* Pet., 23, 42 (for claims 24-26, referring back to analysis of claim 1, without further discussion).

The Petition advances two theories as to why the applied references allegedly render obvious these claim elements—one based on Yoshimura alone, and a second based on the combination of Yoshimura and Lindahl. *See* Pet., 17-21

(discussing element 1[f]), 22 (referring back to the discussion of element 1[f] for element 1[h]). However, both theories fail, at least because the Petition does not establish that either Yoshimura or Lindahl discloses or suggests the claimed “determining a first digital data file” based on “a predetermined time offset,” or that the predetermined time offset determines “an arbitrary point” at which rendering begins.

1. Amazon has not sufficiently shown that Yoshimura alone teaches elements 1[f] or 1[h].

Amazon has not shown that Yoshimura teaches or suggests “determining a first digital file” “using ... a predetermined offset.” or that the subsequent rendering is “at an arbitrary point determined using the predetermined offset.”

In Yoshimura, the SMIL file is modified such that the content is divided into segments having set lengths. EX1006, 1780-81. According to Amazon, the audio and video content within each segment is rendered in parallel. EX1006, 1781; Pet. 15. Amazon alleges that “Yoshimura’s media files can be determined based on their position within the body of a SMIL file (time information in the descriptor file).” Pet., 18. Amazon further contends that a user request to “skip ahead to 15 minutes” is a “predetermined [time] offset.” Pet., 18.

Amazon’s theory is unsupported. Amazon presumes that “*at any given time* in the presentation, Yoshimura’s client will determine, request, and render the media file indicated by the parallel active at that time.” Pet., 18 (emphasis added).

Amazon does not explain how Yoshimura's client determines or requests a media file *at any given time* in the presentation (i.e., the "at 15 minutes" in Amazon's example). Rather, Amazon simply asserts it is so. Pet., 18. Yoshimura's teachings, by contrast, focus on improved cache efficiency, based on the idea that the media segments are pre-fetched by surrogates (e.g., Real-Time Streaming Protocol servers) based on a set pre-fetch scheduling table, before streaming to a client requesting the segments. EX1006, 1780, 1782. Yoshimura explains that "the time when the clients will request each segment can be estimated" based on the timing information in the SMIL file, and based on the estimated times, pre-fetching is thus scheduled to be finished "before the clients request the segments." *Id.*, 1782. In this way, Yoshimura solves the problem of "manag[ing] the timing relations among the segments" of media content so that the "servers can determine which segments are [] next to the segments currently served and how long the segments will last." *Id.*, 1780.

Yoshimura provides an example pre-fetch scheduling table as shown below.

Session ID			123456789		
Client IP address			10.20.30.40		
Start time			12:34		
Pre-fetch status			ACTIVE		
#	Time	Dur.	Seg. Name	Orig. Loc.	Surrogate
1	0 m	10 m	content-A-1.mp4	content-server	surrogate2
2	0 m	10 m	content-V.1.mp4	content-server	surrogate2
3	10 m	20 m	content-A-2.mp4	content-server	surrogate2
4	10 m	20 m	content-V-2.mp4	content-server	surrogate2
5	30 m	30 m	content-A-3.mp4	content-server	surrogate3
6	30 m	30 m	content-V-3.mp4	content-server	surrogate3

Fig. 9 Pre-fetch scheduling table.

EX1006, FIG. 9.

As seen in Figure 9, the “[p]re-fetch information includes estimated request times, segment durations, segment names, original locations, and surrogates selected to serve the segment.” EX1006, 1782.

Amazon alleges that “[l]ike the ’720 patent, Yoshimura discloses the user may skip ahead or go back to previously viewed segments.” Pet., 18. According to Amazon, in order to “skip ahead to 15 minutes,” “a POSITA would have understood that Yoshimura’s client will evaluate the start/end point for each parallel to find the parallel containing the requested time (15 minutes).” *Id.* But the Petition does not actually identify any such teaching or suggestion of skipping

ahead to a particular (i.e., arbitrary) time. And the Petition does not identify any other alleged predetermined time offset that is “external to the descriptor file,” as claimed. Amazon’s declarant provides no further analysis on this point, as the declaration is a *verbatim* copy of the Petition. *See* EX1002, ¶¶66-69; *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15 (P.T.A.B. Aug. 24, 2022) (repeating “verbatim” conclusory assertions from the Petition in a declaration is conclusory and unsupported, and therefore entitled to little weight).

2. Amazon also has not shown that Yoshimura in combination with Lindahl teaches these limitations.

Amazon’s alternative reliance on Lindahl’s bookmarks as the claimed “predetermined offset” does not remedy the deficiencies discussed with respect to Yoshimura alone. Again, Amazon does not explain how Lindahl teaches “*determining a first digital data file ... using ... a predetermined time offset.*” Amazon relies on Lindahl’s bookmark as the claimed “predetermined offset.” Pet., 18-19. According to Amazon, “Lindahl discloses a bookmark including a time offset used to determine which audio file to stream.” Pet., 19. But that allegation is inconsistent with the express teachings to which it cites.

The Petition does not establish that Lindahl discloses any time offset information that is *used* to determine a relevant audio file, as recited in the claims. It at most establishes that Lindahl points to a passage. EX1004, ¶17; *see also id.*, ¶36. Lindahl discloses two modes of transmitting audio files, namely, “selected

download” or “streaming.” EX1004, ¶¶22, 23, 40. For the selected download mode, the audio book is transmitted to the client by downloading the audio file “either chapter-by-chapter, or the whole file.” EX1004, ¶40. The Petition identifies nothing in either Yoshimura or Lindahl that teaches or suggests any time offset information in Lindahl’s that could or would be used to “determin[e] a first digital data file from a plurality of digital data files...” as recited in the claims. Again, Amazon’s declarant provides no further analysis on this point, as the declaration is a *verbatim* copy of the Petition and does not cite to any other supporting authority. See EX1002, ¶¶66-77. *Xerox*, IPR2022-00624, Paper 9, at 15. Thus, even if combined the claimed method does not result.

* * *

For at least these reasons, Amazon has not shown that the combination of Yoshimura and Lindahl teaches or renders obvious “determining a first digital data file from the plurality of digital data files ... using the time information in the descriptor file and a predetermined time offset, the predetermined time offset external to the descriptor file” or that the subsequent rendering is “at an arbitrary point determined using the predetermined offset.” Therefore, Amazon’s asserted Grounds 1A and 1F fail as to independent claims 1 and 24-26. Amazon, likewise, has not made a sufficient showing for dependent claims 2-23 and 27-29, at least due to their dependency from independent claim 1 or 26.

E. Claims 1, 24-26, Grounds 2A and 2B

Independent claim 1 recites “the at least one server having stored thereon a descriptor file ...” (element 1[b]). EX1001, 40:25-26. Independent claims 24-26 include a similar claim element. *See* EX1001, 43:27-44:67; *see also* Pet., 69 (for claims 24-26, referring back to analysis of claim 1, without further discussion).

Amazon relies solely on Reid at teaching the claimed descriptor file. *See* Pet., 49-50. In particular, Amazon asserts that “Reid synchronizes a plurality of media streams along the same timeline (‘common time base’) using an index for each media stream.” Pet., 49 (citing EX1076, 6:19-9:20, Figs. 2-4; EX1002, ¶221). The Petition further states that “[t]he indices provide corresponding positions between the media streams to synchronize the streams during playback.” Pet., 49-50 (citing EX1076, claim 5, 4:1-3, 12:19-26, 13:10-20, 20:21-21:3). It then provides the conclusory assertion that “Reid’s indices are a descriptor file.” Pet., 50. The Petition cites to the expert declaration (EX1002, ¶221), which mirrors the conclusory attorney argument. There is no analysis explaining the basis for this conclusion in either. *Xerox*, IPR2022-00624, Paper 9, at 15.

Amazon appears to rely on Reid’s collective “indices” as the claimed “descriptor file.” The Petition does not differentiate or identify which index it relies upon. It does not describe how one or more operate as a descriptor file. And Reid does not mention any specific set or collective arrangement of specific

“indices” or how they collectively operate/interact. Rather, Reid describes different types of indexes (e.g., “Slide index,” “Hypertext index,” “Outline Index,” and other uses of the term “index”). *See generally* EX1076.

For at least these reasons, Amazon has not shown that the asserted combination of teaches or renders obvious “the at least one server having stored thereon a descriptor file” Therefore, Amazon’s asserted Grounds 2A and 2B fail as to independent claims 1 and 24-26. Amazon, likewise, has not made a sufficient showing for dependent claims 2-23 and 27-29, at least due to their dependency from independent claim 1 or 26.

F. Amazon gives the dependent claims short shrift.

Amazon’s analysis for the majority of the dependent claims is completely lacking, providing only perfunctory discussion and ignoring much of the claim language. Audio Pod provides a non-exhaustive list of examples here.

For example, dependent claim 2 recites “wherein the plurality of media streams comprises an audio stream including a plurality of digital audio files, the plurality of digital audio files created by *segmenting the audio recording in dependence upon natural language gaps* so that when the plurality of digital audio files are rendered sequentially using the media player an experience of a contiguous audio stream is reproduced for a user without reassembling sequential digital audio files, and wherein the first digital data file is a first digital audio file

from the plurality of digital audio files in the audio stream.” But Amazon’s contentions address only the emphasized language in the claim, ignoring the rest. Pet., 23-25. It is Amazon’s burden to show each element of the claim is taught or suggested in the prior art and they have not done so here. 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).

As another example, for several dependent claims, the Petition provides no independent analysis, simply referring back to prior discussion provided in connection with the independent claims. *See* Pet., 26-27 (ground 1, claim 4), 29 (ground 1, claims 7, 8), 30 (ground 1, claims 9, 10), 31 (ground 1, claims 15, 22), 42 (ground 1, claim 24), 60 (ground 2, claim 2), 65 (ground 2, claim 11[a]), 69 (ground 2, claims 7-10, 15, 20-21, and 25-26). “The presence of a particular limitation in a dependent claim raises a presumption that the limitation in question is not found in the independent claim.” *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 806 (Fed. Cir. 2007) (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004)). But Amazon provides no additional explanation for these dependent claims.

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* EX2008, 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 '720 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 7,326 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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