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.,
Petitioners,

v.

AUDIO POD IP, LLC,
Patent Owner.

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

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

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I. INTRODUCTION

The Director should reject Patent Owner's ("PO") request for discretionary denial. PO's primary argument is that the Director should decline to institute this IPR because of co-pending district court litigation. But the parties and the district courts have invested little in the co-pending proceedings, and those proceedings are highly likely to be stayed should the Board institute review, avoiding duplication of effort and allowing the Board to fulfill its purpose as an effective and efficient forum for determining validity. Given the early stage of the litigation, the *Fintiv* factors strongly favor proceeding to the merits of this IPR.

Institution here would be a particularly efficient use of the Board's resources. The challenged '720 patent is asserted in three separate district court cases before three different judges, and is one of seven patents *from the same family* that PO asserts against Petitioners in those cases. As the Acting Director has recognized, where "litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient." Indeed, Congress created the IPR process to provide "a more efficient system for challenging patents that should not have issued" and to reduce "unwarranted litigation costs." Denial here would eliminate this efficiency and needlessly increase litigation costs by requiring the parties to litigate the validity of the same patent, and other closely related patents, in multiple jurisdictions.

PO raises a host of procedural arguments, including complaints about delay, claim construction positions, "particularity" of the Petition, Petitioners' reliance on expert testimony, and public availability of the references. All of these arguments lack merit and are meant to distract from the core issue: the claims of the '720 patent are unpatentable. With the patent asserted in multiple cases in multiple courts, co-pending litigation likely to be stayed, and the Petition making a strong showing that the '720 patent never should have issued, the Director should reject PO's request for discretionary denial.

II. DISCRETIONARY DENIAL IS NOT WARRANTED.

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

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

PO sued Petitioners for infringement of the '720 patent in two district court cases: *Audio Pod IP, LLC v. Amazon.com, Inc.*, 2:24-cv-00185 (E.D. Va.) ("the -185 case") and *Audio Pod IP, LLC v. Amazon.com, Inc.*, 3:24-cv-00407 (E.D. Va.) ("the -407 case"). PO's claims against Audible, Inc. in the -185 case were severed and

transferred to the District of New Jersey as *Audio Pod IP, LLC v. Audible, Inc.*, No. 2-25-cv-02198 (D.N.J.) ("the DNJ case").

PO asserts that the most relevant parallel proceeding here is the -407 case. (Paper 8 ("PO Req.") at 24.) PO does not explain why the -407 case is more relevant than the -185 case, nor does it apply the *Fintiv* factors to the facts of the -185 case. But PO cannot have it both ways—for example, in other portions of the Request it relies on the -185 case's filing date to argue that Petitioners were not diligent in filing the Petition because it was filed so close to the statutory bar date. (PO Req. at 27.) Where there are multiple parallel proceedings involving the challenged patent, each must be considered when conducting a *Fintiv* analysis, not just the proceeding that tends to support PO's arguments more. *See Shenzhen Carku Tech. Co., Ltd. v. Noco Co.*, IPR2020-00944, Paper 20 at 56-69 (P.T.A.B. Nov. 12, 2020) (inappropriate to "engage[] in selective 'mix and match' of separate facts in different cases" for *Fintiv* analysis without persuasive reason); *Global Tel*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00444, Paper 14 at 12-13 (P.T.A.B. July 22, 2021) (same).

1. Factor 1 Weighs Against Denial Because a Stay Is Likely.

Factor 1 considers whether a stay exists or is likely to be granted if a proceeding is instituted. *Fintiv*, IPR2020-00019, Paper 11 at 6-9. Petitioners will shortly move to stay the -185 case, the -407 case, and the DNJ case pending resolution of this and related IPRs challenging the asserted patents. The EDVA and DNJ

routinely stay cases pending IPR proceedings[1]; accordingly, a stay is likely in each of the co-pending cases. *Sec. First Innovations, LLC v. Google LLC*, No. 2:23-cv-00097, 2024 WL 234720 (E.D. Va. Jan. 22, 2024); *Sharpe Innovations, Inc. v. T-Mobile USA, Inc*., No. 2:17-cv-00351, 2018 WL 11198604 (E.D. Va. Jan. 10, 2018); *Canfield Sci., Inc. v. Drugge*, No. CV 16-4636 (JMV), 2018 WL 2973404, (D.N.J. June 13, 2018); *Kirsch Rsch. & Dev., LLC v. GAF Materials, LLC*, No. CV 20-13683 (JMV), 2021 WL 2434082, (D.N.J. June 15, 2021). Because there is persuasive evidence that Petitioners' stay motions will be granted, this factor weighs against denial.[2] *See Imperative Care, Inc. v. Inari Med., Inc.*, IPR2025-00289, Paper 9 at 2 (P.T.A.B. June 12, 2025) (institution favored where "Petitioner … provides evidence that the district court is likely to grant a stay if this proceeding is instituted"); *Microsoft Corp. v. X1 Discovery, Inc.*, IPR2025-00253, Paper 13 at 2 (P.T.A.B. June 25, 2025).

[1] Statistics show that the EDVA grants or partially grants post-institution motions to stay pending IPR in 70% of cases, and DNJ grants or partially grants such motions in 79% of cases. (EX-1111 (statistics from Docket Navigator).) This is "persuasive evidence that '[t]here is good reason to believe that a stay will be granted.'" *Twitch Interactive, Inc. v. RazDog Holdings LLC*, IPR2025-00307, Paper 18 at 2 (P.T.A.B. May 16, 2025).

[2] PO's cases suggesting that the Board should decline to "infer" or "speculate" about a stay are inapposite where, as here, no inference or speculation is necessary to recognize that the district court proceedings are likely to be stayed. (PO Req. at 25.)

2. Factor 2 Weighs Strongly Against Denial.

Factor 2 considers the proximity of the district court's trial date to the Board's projected statutory deadline. *Fintiv*, IPR2020-00019, Paper 11 at 6-9. Here, Factor 2 weighs strongly in favor of denying PO's request because no trial date has been set in any of the co-pending district court cases and it is clear that trial will occur far later than the projected statutory deadline for issuing an FWD in the IPR. *Imperative Care*, IPR2025-00289, Paper 9 at 2 (institution favored where "no trial date [is] scheduled in the district court"); *Microsoft*, IPR2025-00253, Paper 13 at 2 (same); *Amazon.com, Inc. v. Nokia Techs. OY*, IPR2024-01140, Paper 9 at 9 (P.T.A.B. Feb. 12, 2025); *Aptiv Servs. US, LLC v. Microchip Tech., Inc*., IPR2024-00646, Paper 11 at 32 (P.T.A.B. Sept. 25, 2024). The cases (*ARM* and *HP*) PO cites in support of its argument are inapposite. In each case, the district court had an operative schedule, including a trial date, which is not the case here. *See ARM Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 10 at 2 (P.T.A.B. May 16, 2025); *HP Inc. v. Universal Connectivity Techs., Inc.*, IPR2024-01428, Paper 12 at 5-6 (P.T.A.B. Apr. 8, 2025).

PO further argues that according to time-to-trial statistics, not only will trial occur before the projected FWD deadline, it should have already occurred. This argument defies reality. PO argues that the median time-to-trial from filing in

EDVA is 11.9 months.[3] (PO Req. at 26.) But median time-to-trial is not helpful in cases, like here, where a longer schedule is needed. *See Ericsson Inc. v. XR Commc'ns LLC*, IPR2024-00613, Paper 9 at 34 n.12 (P.T.A.B. Oct. 9, 2024) ("median-time-to trial information" not useful where circumstances "do[] not reflect the normal course of a litigation"). Indeed, median time-to-trial statistics fail to capture an accurate story here. More granular statistics tracking patent cases in the EDVA show that few go to trial, and those that do require a much longer time to do so—of cases filed in the past 10 years, only six have had a jury trial, and the average time to reach that milestone is more than 28 months.[4] (EX-1113 (statistics from Docket Navigator).) Thus, the -407 case would not be expected to go to trial until October 2026—around the same time as the Board's final written decision. And, with no trial date set and a stay likely (*supra* §II.A.1), there is good reason to think the -407 case would substantially exceed EDVA's average.[5]

[3] PO quotes the median time-to-trial for the 12-month period ending in March 31, 2025. (PO Req. at 26; EX-2004 at 25.) However, in the 12-month period ending in December 31, 2024, the median time-to-trial was 14.6 months. (EX-1112 at 25; *see* Pet. at 72, 72 n.3.) And the three 12-month periods before the one PO cites (i.e., ending in March 31, 2022, March 31, 2023, and March 31, 2024) had significantly longer median time-to-trials of 18.1 months, 23.2 months, and 18.2 months respectively. (EX-2004 at 25.) Thus, PO's statistic is an extreme outlier.

[4] Cases reaching a bench trial have an even longer average time of 48 months. (EX-1113.)

[5] PO does not argue that the -185 case or the DNJ case are relevant to this factor, and Petitioners agree. (*See* PO Req. at 25-26.) No schedule has been set at all in the -185 case, and much of its relevant portions have recently been transferred to the DNJ case, which also lacks any schedule. And the DNJ's patent milestones are even

Because no trial date has been scheduled and there is good reason to think that even if the -407 case is not stayed, trial would occur at the earliest around the same time as the final written decision in this case, this factor strongly favors institution.

3. Factor 3 Weighs Against Denial.

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

PO asserts that there are two considerations under Factor 3 that support denial: (1) the amount of work done in the parallel litigation, and (2) whether the Petitioner could have filed the petition more expeditiously. (PO Req. at 27-33.) For consideration (1), PO discusses the -407 case to purportedly show that much work has already been done. (*See id.* at 28-32.) But for consideration (2), PO relies on the filing date of the complaint in the -185 and DNJ cases to argue that Petitioners were not

longer than the EDVA's, with patent trials averaging 70 months for jury trials and 37 months for bench trials. (EX-1114 (statistics from Docket Navigator).) Thus, the -185 and DNJ cases are substantially behind the -407 case.

diligent in filing the Petition. (*Id.* at 27-28.) In doing so, PO engages in "selective 'mix[ing] and match[ing]' of separate facts in different district court proceedings, without persuasively explaining why they should be combined, which is inappropriate here." *Shenzhen Carku*, IPR2020-00944, Paper 20 at 56-69 (analyzing the facts of each parallel proceeding separately under the *Fintiv* factors). Instead, the cases should be analyzed separately. Under such an analysis, *Fintiv* factor 3 weighs strongly against discretionary denial.

a. The -185 and DNJ cases

The parties have invested very little in the -185 and DNJ cases. Petitioners moved to dismiss or transfer the -185 case on May 31, 2024, and the court ruled on that motion on March 31, 2025, splitting the case into the -185 case and the DNJ case. Amazon recently filed its answer to the amended complaint in the -185 case on May 14, 2025. In the DNJ case, PO filed a second amended complaint on July 3, 2025. To date, no discovery has taken place in either case. No case schedule has been set, and as such, the courts have neither set a *Markman* hearing date nor a trial date. In view of how little the parties and the court have invested in the -185 and DNJ cases, this factor strongly weighs against denial. *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 at 11 (P.T.A.B. Oct. 21, 2020) (precedential as to §II.A) ("Where the District Court has not issued claim construction orders and the discovery process is not yet complete, the remaining investment of time and effort likely

necessary to bring co-pending litigation to trial appears to far outweigh that which has already been invested."); *Samsung Elecs. Co. v. Empire Tech. Dev. LLC*, IPR2024-00896, Paper 15 at 13 (P.T.A.B. Dec. 13, 2024) (factor weighs against denial where *Markman* hearing and close of fact and expert discovery were after institution deadline); *Ericsson*, IPR2024-00613, Paper 9 at 34-35 (factor weighs against denial where "most efforts from the parties and court will take place after institution"); *Amazon.com*, IPR2024-01140, Paper 9 at 9-10.

b. The -407 case

In the -407 case, much work remains to be done after the institution decision. As PO admits, the *Markman* hearing is scheduled for after the institution decision. (PO Req. at 32; EX-2012.) The current scheduling order does not extend past that hearing (EX-2010) and much work will remain after that, including expert reports, expert discovery, dispositive motions, pretrial motions, and trial. While PO recites a laundry list of work that has already occurred, that list includes minor, routine actions such as answering and amending the complaint, litigating discovery motions, and conducting the beginnings of basic fact discovery. (PO Req. at 28-31.) The additional work to be completed prior to institution is merely claim construction briefing and a settlement conference. (*Id.* at 31-32.) These activities do not rise to

the level of investment that would warrant discretionary denial.[6] *Samsung*, IPR2024-00896, Paper 15 at 13 (factor weighs against denial where *Markman* hearing and close of fact and expert discovery were after institution deadline); *Snap*, IPR2020-00820, Paper 15 at 11; *Ericsson*, IPR2024-00613, Paper 9 at 34-35; *Amazon.com*, IPR2024-01140, Paper 9 at 9-10. And notably, none of the activities raised by PO implicate the invalidity issues before the Board in this proceeding.

PO also argues that the Petition's filing date shows a "lack of diligence" by Petitioners. As discussed below, that is not so. (*Infra* §II.B.3.a.ii.) However, even if that were the case, Petitioners' use of the full statutory period afforded for the filing of a petition does not outweigh the limited investment in the district court cases here. *See Snap*, IPR2020-00820, Paper 15 at 12-13 ("In view of our finding that the parallel District Court proceeding was in an early stage … the timing of the filing of the Petition does not weigh in favor of exercising discretion to deny institution."); *RØDE Microphones, LLC v. Zaxcom, Inc.*, IPR2025-00232, Paper 14 at 9-10 (P.T.A.B. June 16, 2025); *Medtronic, Inc. v. Avanos Med. Sales, LLC*, IPR2020-00895, Paper 16 at 29 (P.T.A.B. Oct. 23, 2020) ("Congress has expressly provided

[6] At worst, even PO's cited case confirms this factor would be neutral—but that case involved "extensive third party discovery," unlike this case. *HP*, IPR2024-01428, Paper 12 at 6-7 (Factor 3 neutral where PO had conducted extensive third-party discovery, claim construction briefing was completed and the *Markman* hearing was soon after institution, and discovery motions had been filed).

a one-year grace period …. We decline to consider any petition filed within such a statutorily mandated grace period to be *ipso facto* 'not-expeditious-enough.'").

Thus, this factor weighs against denial.

4. Factor 4 Weighs Against Denial.

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

PO admits that this factor favors institution because of Petitioners' *Sotera* stipulation. (PO Req. at 33.)

Furthermore, as discussed above, stays of the co-pending district court cases are likely. If any challenged claims were to survive this IPR, Petitioners would be statutorily estopped from raising in those litigations any grounds that were raised or reasonably could have been raised in the Petition. 35 U.S.C. §315(e)(2). Thus, the stays obviate concerns of inefficiency and the possibility of conflicting decisions. *Snap*, IPR2020-00820, Paper 15 at 15-16 (stay of litigation "obviat[es] concerns of inefficiency and conflicting decisions while providing the possibility of simplifying issues for trial in the parallel District Court proceeding"); *Fintiv*, IPR2020-00019, Paper 11 at 6 (a stay "allays concerns about inefficiency and duplication of efforts").

PO attempts to diminish Petitioners' *Sotera* stipulation by arguing that it "'does not ensure that th[is] IPR proceeding[] would be a "true alternative" to the district court proceeding.'" (PO Req at 34 (quoting *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025)).) PO suggests that "nothing about Petitioner's stipulation prevents them from raising combinations of the asserted art with other system art." (*Id.*) But as PO admits, "Petitioner has not yet provided invalidity contentions," rendering PO's argument entirely speculative. (*Id.*)

Because little has been invested in the various district court proceedings, and a stay of each is likely, this IPR is a true alternative to the district court proceedings. As the Board has recognized, where "the present case does not involve 'substantial investment' in the District Court Litigation per *Fintiv* factor 3 … even discounting the weight of Petitioner's *Sotera* stipulation as the Director did [in *Motorola*, IPR2024-01205, Paper 19], … the *Fintiv* factors as a whole indicate that the efficiency and integrity of the patent system are best served by instituting review." *Liberty Energy, Inc. v. U.S. Well Svcs., LLC*, IPR2025-00031, Paper 9 at 18-19 (P.T.A.B. Apr. 29, 2025); *see also Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01374, Paper 19 at 20-22 (P.T.A.B. Apr. 29, 2025) ("even considering the presence of system art as a mitigating factor in favor of Patent Owner, we still find that the *Sotera* stipulation significantly reduces the overlap between the district court

litigation and this IPR"). And, should any claims survive this IPR, any overlap may benefit the district court's analysis of what remains. *MED-EL Elektromedizinische Geräte GmbH v. Sonova AG*, IPR2020-00176, Paper 13 at 15 (P.T.A.B. June 3, 2020) (overlap "may inure to the district court's benefit … by simplifying issues for trial").

Thus, this factor weighs against denial.

5. Factor 5 is Neutral.

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

6. Factor 6 Weighs Against Denial Because the Petition's Merits Are Strong.

Factor 6 considers "other circumstances" that impact discretionary denial, such as the merits of the petition. *Fintiv*, IPR2020-00019, Paper 11 at 14-16. This factor weighs against discretionary denial because the merits of the Petition are strong. PO's contrary arguments fail.[7]

[7] The only argument PO presents in its Request is the so-called "printed publication issue," which is addressed below. (PO Req. at 35; *infra* §II.B.3.b.i.) PO also

During prosecution, PO overcame the Examiner's rejections by adding limitations reciting that (1) each of the claimed plurality of media streams "includ[es] a plurality of digital data files" and (2) the claimed descriptor file includes "information allowing a simultaneous synchronized rendering of the plurality of media streams that provides a literary experience of the originating written work." (*See* EX-1095 at 18-24, 42-61.) But the prior art references relied on in the Petition clearly disclose these limitations. (Paper 1 ("Pet.") at 13-14, 52-53.)

For example, Yoshimura discloses that its media streams comprise a plurality of digital data files because it discloses "segmenting" media streams stored on servers into multiple "smaller segments" that are stored as separate files. (EX-1006 at 1780-83, Figs. 3, 5; Pet. at 13-14.) And Yoshimura discloses a descriptor file (e.g., SMIL file) that includes information describing the synchronization of media streams and specifying how and when the content is displayed. (EX-1006 at 1779-81, Fig. 5; Pet. at 14.) Furthermore, a POSITA would have understood that delivering text content, such as a book or script, using Yoshimura's system would result in a literary experience of the originating written work. (EX-1002 ¶59; Pet. at 14.) Thus, the Petition's merits are strong, and this factor favors institution.

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relies on its not-yet-filed POPR; because the discretionary denial procedure allows petitioners to oppose a patent owner's request for denial, Petitioners here may seek a reply to the POPR to address merits issues that impact *Fintiv* factor 6. (PO Req. at 35.)

Accordingly, the *Fintiv* factors as a whole weigh against denial.

B. Additional Discretionary Factors Favor Institution.

1. Settled Expectations Favor Institution.

PO argues that it has settled expectations regarding the '720 patent's validity because it issued in 2016. (PO Req. at 13.) This argument fails for several reasons.

First, the '720 patent is one of several related patents challenged by Petitioners, and other patents in the family have issued much more recently. For example, the '111 patent (*see* IPR2025-00768) and the '488 patent (*see* IPR2025-01041) both issued in 2020. Thus, PO has no settled expectations of validity with respect to them, and it would be an efficient use of Board resources to address the validity of the closely related '720 patent along with the recently issued '111 and '488 patents. *Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13 at 2-3 (P.T.A.B. June 26, 2025) (where "Patent Owner has not developed strong settled expectations" as to a newer-issued patent, "it is an efficient use of Board resources to address the related patent" that issued earlier); *Yealink Network Tech. Co., Ltd. v. Barco NV*, IPR2025-00491, Paper 18 (P.T.A.B. June 25, 2025) (no settled expectation of validity for patent issued in 2020); *Cambridge Indus. v. Applied Optoelecs.*, IPR2025-00434, Paper 11 (P.T.A.B. June 26, 2025) (no settled expectation of validity for patents issued in 2019 and 2020).

Second, PO is a non-practicing entity that has spent years engaging in the business of preparing to bring lawsuits to enforce its patents. (PO Req. at 4.) To the extent PO had any "settled expectations" during those years, those expectations were that any accused infringer would have the opportunity to file IPR petitions and that the IPRs would be instituted if the challenger could meet the standard for institution (i.e., a reasonable likelihood that at least one claim is unpatentable). Under such circumstances, PO's settled expectation was—or should have been—that the patents' validity would be reviewed.

Third, PO relies on the fact that Amazon purportedly knew about the application that led to the '720 patent in 2012. (PO Req. at 14.) But PO's letter did not allege infringement of its patents or patent applications (only "marked similarity" between Audio Pod's technology and aspects of Amazon's products). (EX-2013.) And the letter provides no notice or indication that PO had any intention to assert its patents; to the contrary, the letter is entirely an offer to sell Audio Pod's intellectual property rights to Amazon. (*Id.*) And, the '720 patent did not issue until several years after the letter. After the patent issued, Audio Pod never informed Amazon of its issuance or of its relevance to any Amazon product.

PO's invocation of *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) to argue that PO's letter created settled expectations of the '720 patent's validity is misplaced because it ignores the context of

Petitioners' alleged knowledge of the patent. (PO Req. at 13-15.) In *iRhythm*, the petitioner was aware of the challenged patent because the petitioner cited it in an IDS in petitioner's own patent application, indicating that the petitioner was aware of the content of the challenged patent and how it related to the petitioner's own technology. *See* IPR2025-00363, Paper 10 at 3. Here, however, PO's letter provides no information about the subject matter of PO's patents (beyond the name of each patent or application), does not identify which features of Petitioners' products were allegedly similar to which claims of which patent (beyond a vague assertion that certain products bore "marked similarity" to PO's technology generally), and made no assertion of infringement at all. (*See generally* EX-2013.) Under these circumstances, Petitioners did not have adequate knowledge of the '720 patent to hold them to the standard in *iRhythm*.

Furthermore, applying PO's theory here would create a sweeping obligation for innovators to research the entire portfolio of every entity that offers to sell, license, or otherwise transfer patent rights to it, and a further obligation to monitor every patent application owned by those entities, and file an IPR on every claim of every patent that issues; the consequences of not doing so would be forever forfeiting the right to IPR via discretionary denial. Such a requirement would severely burden innovation and economic activity in the United States and overwhelm the Office

with astronomical numbers of IPR petitions against patents that may never otherwise be asserted or litigated.

To the extent Petitioners had any "settled expectations" at all, for more than a decade their "settled expectations" have been that if an invalid patent is asserted against them, they could file IPR petitions and use the cost-efficient mechanism for resolving validity challenges as Congress intended.

Thus, the parties' settled expectations favor institution.

2. The Existence of Multiple Cases and Multiple Technologies Favors Institution.

As discussed above, the '720 patent is at issue in three different district court proceedings (the -185 case, the -407 case, and the DNJ case). (*Supra* §II.A.) PO has also asserted an additional related patent in another district court case against Petitioners: *Audio Pod IP, LLC v. Amazon.com, Inc.*, 3:24-cv-00406 (E.D. Va.) ("the -406 case"). The -406 case is consolidated with the -407 case. Petitioners have filed seven additional IPRs to address the six additional patents across the district court cases. The six additional asserted patents are directed to various related, yet distinct aspects of the technology described in PO's patents: for example, the '740 patent includes claims directed to selecting servers from which to download content based on server performance statistics (IPR2025-00774); the '922 patent includes claims directed to transferring bookmarks and content between client devices (IPR2025-00769); the '266 patent includes claims directed to transferring identifiers of a

position within content between two devices and simultaneously presenting synchronized content on each device (IPR2025-00757); and the '111 patent includes claims directed to downloading various portions of a page of content and assembling the page on the local device (IPR2025-00768).

The complexity of the district court litigations weighs against discretionary denial. *Tesla v. Intellectual Ventures*, IPR2025-00217, Paper 9 (P.T.A.B. June 13, 2025); (*see* EX-2020 at 1 (PO admitting "[t]his is a complex lawsuit for patent infringement").) All of the district court litigations are likely to be stayed pending IPR, which will allow the Board to efficiently decide the validity issues presented. If the IPRs are discretionarily denied and the litigations continue, then the cases will proceed before three different judges in two different districts and will require several juries to be empaneled. Deciding the validity issues through district court litigation will require multiple judges, clerks, and juries to learn the diverse subject matter of the patents, the prior art, and the law. It would be an efficient use of the Board's resources to have a panel of three APJs, technically trained and with deep knowledge of the law, resolve the invalidity challenges presented in the IPRs. *See Tesla*, IPR2025-00217, Paper 9 at 3 ("the Board is better suited to review a large number of patents involving diverse subject matter"); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2 (P.T.A.B. July 2, 2025) ("Because the litigation between the parties would proceed to several district court trials

in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.").

3. PO's Objections Are Unavailing.

a. Petitioners Have Not Engaged in "Dilatory Tactics" or "Gamesmanship."

PO accuses Petitioners of "engag[ing] in delay" and "gamesmanship" in the co-pending litigation. (PO Req. at 16; *see id.* at 9-11.) But Petitioners have merely engaged in routine litigation activity.

i. Petitioners' Motions Are Not Dilatory.

What PO alleges are "iterative fact-intensive motions that delay progress" are just routine motions. (PO Req. at 16, 10-11.) PO filed its original complaint in the -407 case in May 2024. (EX-2006 at 1 (Dkt. 1); PO Req. at 28.) In August 2024, Petitioners filed a motion to dismiss for failure to state a claim because the asserted patents are invalid under 35 U.S.C. §101 and because venue was improper. (EX-2006 at 1 (Dkt. 16); PO Req. at 28.) Less than three months later, in November 2024, Petitioners filed a motion to stay discovery pending the motion to dismiss, in order to preserve the resources of the parties and the court. (EX-2006 at 2 (Dkt. 37); PO Req. at 28.) Less than three months after that, in February 2025, Petitioners filed a motion to supplement the protective order to protect their confidential information. (EX-2005 at 4 (Dkt. 71); PO Req. at 30.)

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

ii. Petitioners Were Diligent in Filing the Petition.

PO suggests that the Petition was not filed expeditiously enough because Petitioners "wait[ed] until nearly the statutory deadline" to file it. (PO Req. at 16.) But this argument is inconsistent with the purpose of the AIA and the IPR framework. Congress intentionally set the statutory bar for filing an IPR at one year from the service of the complaint. *See* 157 Cong. Rec. S5429 (daily ed. Sept. 8, 2011) (purpose of giving defendants a full year to seek IPR is to "afford defendants a reasonable opportunity to identify and understand the patent claims that are relevant to the litigation"); *Medtronic*, IPR2020-00895, Paper 16 at 29 ("Congress has expressly

provided a one-year grace period for a petitioner to file a petition for *inter partes* review. We decline to consider any petition filed within such a statutorily mandated grace period to be *ipso facto* not-expeditious-enough.").

Indeed, Petitioners filed the Petition just over two months after PO disclosed its infringement contentions in the -407 case.[8] (*See* PO Req. at 29 (infringement contentions served January 2025).) "Patent Owner's infringement contentions play an important role …. They inform Petitioner of the claims that are in fact at issue, as well as how Patent Owner views the scope of the claims, both of which are material considerations in preparing a petition." *Liberty Energy*, IPR2025-00031, Paper 9 at 12-15 (petitioner was diligent in filing petition three months after receiving infringement contentions); *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00124, Paper 11 at 12 (P.T.A.B. June 15, 2023). Thus, Petitioners were diligent in filing the Petition.

iii. Petitioners Have Participated in Discovery at the District Court.

PO argues that Petitioners have "failed to meaningfully participate in discovery in the district court," suggesting that PO was forced to file a motion to compel in the -407 case. (PO Req. at 11.) PO is wrong because Petitioners have complied with discovery obligations throughout, and have provided detailed objections and responses that were tailored to each RFP, RFA, and interrogatory.

[8] PO has not served infringement contentions in either the -185 case or the DNJ case.

To date, Petitioners have produced more than 52,000 pages of documents; made three witnesses available for deposition; and made over 43,000 source code files available for inspection. PO filed a motion to compel because it disagreed with Petitioners' objections, but the objections were well-founded because PO's requests sought discovery far beyond the scope of Rule 26. That motion is currently pending. PO cannot accuse Petitioners of failing to participate in discovery merely because Petitioners have not given PO information that is outside the required scope.

iv. Petitioners' Claim Construction Positions Are Not Inconsistent.

PO suggests Petitioners are engaging in "gamesmanship" by stating that no claim construction is necessary in this IPR while proposing constructions for certain terms in the district court. (PO Req at 16-18; *see id.* at 11-12.) PO's argument is based on a misunderstanding of when claim construction is necessary. It is entirely possible (even likely) that no claim construction is needed to resolve the invalidity issues in an IPR, but claim construction is necessary to resolve infringement issues in the district court. *See, e.g.*, *Chanel, Inc. v. Molo Design, Ltd.*, IPR2022-00543, Paper 7 at 9-10 (P.T.A.B. Aug. 12, 2022). For example, if a claim limitation recited "about 50 mg" of a certain ingredient, no construction would be necessary in an IPR where the prior art expressly disclosed using exactly 50 mg of the ingredient. But that same limitation might require construction in a litigation if the accused product included 52.2 mg of the ingredient. Because the issues before the district court differ

from the issues in this IPR, it is possible for disputes that are immaterial in this IPR to require claim construction in the district court. But this possible need for claim construction in the district court does not show any contradiction in Petitioners' positions. Nor has PO shown any contradiction. PO does not identify any term it believes Petitioners construe inconsistently. (*See* PO Req. at 16-18.)

PO appears to conflate Petitioners' position in its IPRs (that no construction is necessary) with an affirmative argument for a "broad" or "plain and ordinary meaning" construction. (*See, e.g.*, PO Req. at 17.) This is a misunderstanding of the situation and the applicable law. Petitioners' position in this proceeding is that no claim construction is necessary because the prior art discloses each claim limitation *under any reasonable construction*. PO repeatedly complains that Petitioners are advancing inconsistent or contradictory claim construction positions. (*Id.* at 16-18.) But that is simply not the case—Petitioners have only stated that no claim construction is necessary to resolve the invalidity challenges in the IPRs, while acknowledging that claim construction may be necessary in the district court to resolve infringement questions. Such an approach is commonplace in IPR proceedings. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (claim construction limited to terms "that are in controversy, and only to the extent necessary to resolve the controversy"); *CrowdStrike*, IPR2023-00124, Paper 11 at 12-13 ("it is not unusual for a patent litigation defendant to pursue an IPR based on

a broader construction … while also taking a narrower position in the district court. We find nothing inherently wrong with that").

PO cites *Cambridge Mobile Telematics, Inc. v. Safara, Inc.*, IPR2024-00952, Paper 12 (P.T.A.B. Dec. 13, 2024) (informative), but that case is easily distinguished. First, in *Cambridge*, the claim construction question at issue was whether the claims included means-plus-function limitations under §112(f). *Cambridge*, IPR2024-00952, Paper 12 at 5-9. As the Board noted, when a means-plus-function construction is at issue, "37 C.F.R. §42.104(b)(3) mandates that the Petition 'identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.'" *Id.* at 8. The Board found the petition failed to do so, which was the basis of its decision. *Id.* at 8-9. But here, no party has advanced a means-plus-function construction in any forum. Second, any inconsistency between the petitioner's IPR and district court constructions was not merely speculative—the petitioner advocated for a means-plus-function construction in the district court and provided a different construction to the Board that it admitted it did not believe was correct. *Cambridge*, IPR2024-00952, Paper 12 at 7. Not so here, where PO has identified no construction it believes is actually inconsistent.

b. The Petition Presents Evidence With Particularity.

PO argues that the Petition should be denied because it does not meet the "particularity" requirement in 35 U.S.C. §312(a)(3). (PO Req. at 18-21.) PO's arguments are unavailing.

i. The References in the Petition are Printed Publications.

PO argues that Petitioners failed to establish a reasonable likelihood that certain references used in the Petition are prior art printed publications. (PO Req. at 18-20.) Specifically, PO argues that a "bare citation" of Dr. Hall-Ellis's declaration was insufficient to meet Petitioners' burden, citing *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (P.T.A.B. Dec. 20, 2019) (precedential). PO is incorrect. *Hulu* merely requires that the petition "identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent[.]" *Id.* Petitioners have done so.

The Board's decision in *Meta Platforms, Inc. v. Eight kHz, LLC*, IPR2023-01005, Paper 9 at 23-28 (P.T.A.B. Jan. 9, 2024) is instructive. There, the Board found that the petitioner met its burden, and did not improperly incorporate the declaration by reference, because the petitioner "identifie[d] the statutory provision, 35 U.S.C. §102(a)(1), under which [the reference] wa[s] a prior art printed

publication, and cite[d] particular paragraphs of the declaration as supporting that contention, such that Patent Owner was able to address the substance of the allegedly supporting evidence in its Preliminary Response." *Id.* at 27. The same is true here. The Petition identified the statutory provision (§102(b)) and cited to EX-1097, Dr. Hall-Ellis's declaration, for each reference for which a publication date needed to be established. (Pet. at 6-7.) Because Dr. Hall-Ellis's declaration clearly shows by bolded headers which paragraphs correspond to which reference (*see generally* EX-1097), PO can easily tell which paragraphs to look at, such that PO is "able to address the substance of the allegedly supporting evidence in its Preliminary Response[.]" *Meta*, IPR2023-01005, Paper 9 at 27. However, PO has not identified any reason to doubt Dr. Hall-Ellis's conclusion that each of the references she reviewed were publicly available more than one year before the '720 patent's priority date. (PO Req. at 18-20.)

Furthermore, PO's reliance on *BabyBjörn AB v. The ERGO Baby Carrier, Inc.*, IPR2025-00110, Paper 20 (P.T.A.B. Apr. 22, 2025) to argue that Petitioners failed to "discuss in the Petition *any* evidence" that the references were publicly accessible is incorrect and misplaced. (PO Req. at 19.) In *BabyBjörn*, the petition had "no citation, no discussion, and no support" other than a copyright notice in the reference itself to show that the reference was a printed publication. IPR2025-00110, Paper 20 at 13-15. By contrast, here, Petitioners provided, and cited to,

ample evidence in Dr. Hall-Ellis's declaration to show that Yoshimura, DTB, Bulterman, and Amir were publicly available. Thus, PO's arguments fail.

ii. The Petition Analyzed Obviousness under the *Graham* Factors.

PO next states that it will argue in the POPR that the Petition is deficient because it fails to properly address the *Graham* factors: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations of non-obviousness. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); (PO Req. at 20.) The Petition addresses these factors.

To the extent that PO claims in the POPR that the Petition fails to identify the scope and content of the prior art, that is incorrect. The vast majority of the Petition is dedicated to analyzing the "scope and content" of the prior art references upon which Petitioners rely. And, where any differences between the prior art and the claims exist—or potential differences that PO may argue exist—the Petition addresses those differences by showing why any modification would have been obvious. (*See, e.g.*, Pet. at 12-13.)

To the extent that PO claims in the POPR that the Petition fails to identify the differences between the claimed invention and the prior art, that is also incorrect. The Petition analyzes the differences, if any, between the claimed invention and the prior art. *See Aruba Networks, LLC v. Sipco, LLC*, IPR2021-00787, Paper 7 at 16-

17 (P.T.A.B. Oct. 12, 2021) (*Graham* factor 2 satisfied where a petitioner "explains what features of [the references] it relies on and points out where the primary reference may not teach a feature and, in that case, explains what features of the supporting references it relies on and how they are to be combined"). For example, the Petition explained in Ground 1I that, if Lindahl did not disclose electronically transferring a bookmark to another computer, doing so would have been obvious over DTB. (Pet. at 47-48.) In other words, to the extent that the required disclosure was not in Lindahl, then it would have been obvious over DTB.

The Petition also addressed the level of skill in the art (*Id.* at 4-5 (citing EX-1002 at ¶¶27-31)) and secondary considerations (*Id.* at 71). Thus, the Petition analyzed obviousness using the *Graham* factors.

iii. Amazon's Expert Declaration Is Proper.

PO argues that Amazon's expert declaration is entitled to little or no weight because it merely restates the Petition. (PO Req. at 20-21.) PO's arguments misunderstand the law.

PO relies on *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. Aug. 24, 2022), but the Board has explained that the expert testimony in *Xerox* was entitled to little weight because it was "conclusory and lacking supporting evidence or technical reasoning." *Unified Patents, LLC v. Togail Techs., Ltd.*, IPR2023-00338, Paper 7 at 11 (P.T.A.B. Aug. 18, 2023). The Board does "*not*

accord the [expert] testimony little or no weight simply because it is verbatim to what Petitioner states in the Petition. The *Xerox* case … does not require or indicate otherwise." *Id.* (emphasis added); *see also Amazon.com, Inc. v. Nokia Techs. OY*, IPR2024-00691, Paper 10 at 65-66 (P.T.A.B. Sept. 24, 2024).

"Rather, the critical inquiry is whether a declaration discloses underlying facts or data on which the opinion is based." *Bizlink Tech., Inc. v. Anderson Power Prods., Inc.*, IPR2024-00687, Paper 7 at 27-28 (P.T.A.B. Nov. 22, 2024). This is exactly what Petitioners' expert declaration does. The declaration discloses, in detail, the underlying facts (e.g., the disclosures in the references, the expert's knowledge and experience, etc.) on which his opinions are based.[9] Thus, it is entitled to its full weight. *See Hum Indus. Tech., Inc. v. Amsted Rail Co., Inc.*, IPR2023-00540, Paper 10 at 37 (P.T.A.B. Aug. 11, 2023) ("If declaration testimony is supported sufficiently and, in turn, supports contentions in the Petition, we do not give it little to no weight simply because it is repeated in the Petition[.]"); *Nintendo Co., Ltd. v. Am. GNC Corp.*, IPR2024-00668, Paper 10 at 42-43 (P.T.A.B. Sept. 10, 2024). Indeed, the Board has recognized that it is logical for the Petition and the expert declaration to be similar as the expert declaration supports the invalidity

[9] PO's reliance on *Tableau Software, LLC v. iCHARTS LLC*, IPR2024-01388, Paper 8 (P.T.A.B. May 14, 2025) and *Solus Advanced Materials Co., Ltd. v. SK nexilis Co., Ltd.*, IPR2024-01461, Paper 14 (P.T.A.B. Apr. 23, 2025) is inapposite for at least this reason.

grounds in the Petition. *Hum*, IPR2023-00540, Paper 10 at 37 (finding overlap results from the petition citing the expert declaration without any deviation from the matters to which the expert testifies); *Nintendo*, IPR2024-00668, Paper 10 at 42 (same). Thus, PO's arguments regarding Petitioners' expert declaration do not warrant denial.

c. The Board Is Well Equipped to Handle the Issues Presented.

PO argues that because several related petitions include grounds relying on references that are prior art under §§102(a) or 102(e), the Board is not the best forum to resolve any argument that PO's alleged invention antedates those references. (PO Req. at 21-22.) PO's argument fails for several reasons.

First, PO does not allege that *this Petition* contains any references that can be "sworn behind." (PO Req. at 21.) In fact, all references relied on in this Petition are prior art under §102(b). (Pet. at 6-7.) Nor has PO identified any antedating evidence in any of the proceedings. (PO Req. at 21-22.) Thus, PO's arguments are entirely speculative and have no relevance to this proceeding.

Second, PO's attempt to create relevance by arguing that the parties' dispute should be resolved in a single forum is unavailing because the Board routinely adjudicates antedating reference issues and is well equipped to determine the validity of all seven challenged patents. *See, e.g.*, *Envirotainer AB v. DoubleDay Acquisitions LLC*, IPR2022-00293, Paper 83 at 37-46 (P.T.A.B. Feb. 1, 2024); *Viken*

Detection Corp. v. Am. Sci. & Eng'g Inc., IPR2022-00028, Paper 61 at 22-33 (P.T.A.B. May 1, 2023). Beyond IPRs, the Board also adjudicates similar issues that require evaluating factual evidence and credibility of testimony in derivation proceedings. *See generally* 35 U.S.C. §135; *Andersen Corp. v. GED Integrated Sols, Inc.*, DER2017-00007, Paper 57 (P.T.A.B. Mar. 20, 2019). Thus, should PO submit any antedating evidence, the Board is experienced in adjudicating these issues and will serve as an effective forum to do so.

d. PO's Size and the Age of the Inventors Are Not Relevant.

PO argues that it "is a small company" and that "[t]he remaining inventors and owners of the '720 patent … are also in their retirement years" and "deserve to have their day in court." (PO Req. at 22-23.) PO does not identify any reason why these arguments are relevant to institution of this proceeding. (*Id.*) Nor could it. The Office's decision whether to institute an IPR does not, and should not, depend on the size of the patent owner or the age of the inventors. Indeed, PO provides no explanation for why it delayed eight years from the '720 patent's issuance to bring suit. (*See id.* at 9.) And given the strong invalidity showing in the Petition, this IPR is likely the quickest way to fully and finally adjudicate the dispute between the parties. Indeed, PO's concern about its small size and limited resources favors resolving the parties' prior art invalidity disputes at the Board, in a time- and cost-efficient manner, rather than in four distinct yet overlapping district court

proceedings in different courts and before different judges. Thus, PO's arguments do not warrant denial.

III. CONCLUSION

For the reasons set forth in the Petition and herein, the challenges here represent an appropriate use of Board resources. Accordingly, Petitioners respectfully request that the Director deny PO's Request for Discretionary Denial.

Respectfully submitted,

KNOBBE MARTENS OLSON & BEAR, LLP

Dated: July 16, 2025

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(d), the undersigned certifies that this **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** contains 7,890 words according to the word-processing program used to prepare this paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

Dated: July 16, 2025

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** is being served on July 16, 2025, via e-mail on counsel of record for Patent Owner at the address below:

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