IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM SERVICES LLC,

Petitioner,

v.

VB ASSETS, LLC,

Patent Owner.

Case: IPR2025-01167

U.S. Patent No. 11,087,385

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

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EXHIBIT LIST (37 C.F.R. § 42.63(e))

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1002	Declaration of Padhraic Smyth, Ph.D.
1003	Prosecution File History for the '385 patent
1004	U.S. Patent App. Pub. No. 2012/0284105 ("Li")
1005	U.S. Patent No. 9,922,364 ("Chen")
1006	U.S. Patent App. Pub. No. 2012/0096358 ("Barnes")
1007	U.S. Patent App. Pub. No. 2004/0193420 ("Kennewick")
1008	U.S. Patent App. Pub. No. 2014/0344106 ("Lee")
1009	U.S. Patent No. 7,376,586 ("Partovi")
1010	Asthana, A. & Krzyzanowski, P., "A Small Domain Communications System for Personalized Shopping Assistance," Proceedings of 1994 International Conference on Personal Wireless Communications (pp. 199-203), IEEE Press (1994, Aug.), ("Asthana")
1011	Lucente, M., "Conversational interfaces for e-commerce applications," Communications of the ACM (Sept. 2000), 43(9), 59-61, ("Lucente")
1012	Huang, X. et al., "Spoken Language Processing: A Guide to Theory, Algorithm, and System Development," Prentice Hall (2001) ("Huang")
1013	Heinroth, T. et al., "Introducing Spoken Dialogue Systems into Intelligent Environments," Springer (2013) ("Heinroth")
1014	U.S. Patent No. 6,859,776 ("Cohen")
1015	WO Pub. No. 02/073331 ("Aretoulaki")
1016	U.S. Patent No. 7,818,176 ("Freeman")
1017	Complaint for Patent Infringement, *VB Assets, LLC, v. Amazon.com Services, LLC*, 1:24-cv-00839-MN (D. Del. July 18, 2024), Dkt. 1

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1018	Claim Construction Memorandum Order, *VB Assets, LLC, v. Amazon.com, Inc., et al*., 1:19-cv-01410-MN (D. Del. June 23, 2021), Dkt. 90
1019	Curriculum Vitae of Padhraic Smyth, Ph.D.
1020	Docket Navigator statistics regarding Judge Noreika decisions on motions to stay pending IPR

I. INTRODUCTION

The Director should deny Patent Owner's ("PO") request for discretionary denial. PO filed its application for the challenged patent in 2019, five years *after* Petitioner Amazon released to the public its revolutionary speech recognition technology called "Alexa." With the benefit of Alexa's public disclosures and through claims of earlier priority, PO drafted the claims of the challenged '385 patent in a way that it could try to accuse Alexa of infringement. The '385 patent then issued in 2021, but PO chose to wait until mid-2024 to accuse Alexa of infringing the patent. In response, Petitioner diligently and promptly filed its IPR Petition that shows how the prior art discloses each claim of the '385 patent. Discretionary denial would be fundamentally unfair in view of PO's gamesmanship in crafting the patent claims to try to read on Alexa and then belatedly accusing Alexa, particularly given Petitioner's diligence in filing its IPR Petition that complies with all applicable rules.

The relevant discretionary denial factors warrant referral to the merits panel. The challenged patent issued just four years ago, so no settled expectations exist. And the Board will enter its Final Written Decision ("FWD") in this IPR before trial in the related district court case. The other *Fintiv* factors also weigh against discretionary denial. The district court case is in its early stages before Judge Noreika, who routinely grants stays once IPRs are instituted. The scope of this IPR is broader than the litigation because Petitioner challenges all 40 claims of the

'385 patent, while the district court case is limited to the 19 claims PO asserts. And the merits of this IPR also weigh against discretionary denial because the Petition presents strong invalidity challenges based on prior art that the Examiner never considered during prosecution. The Examiner materially erred by allowing the '385 patent without first finding and considering the grounds presented in this IPR Petition that disclose each claim limitation.

PO misapplies the *Fintiv* factors to request discretionary denial. Rather than address the facts specific to this challenged patent and proceeding, PO points to unrelated patents, separate proceedings, and alleged historical meetings. It asserts that this IPR should be denied because Petitioner has challenged other unrelated patents in pending IPRs, has initiated prior IPRs against other patents in PO's portfolio, was allegedly shown PO's portfolio years before the application for the '385 patent was filed, and has previously faced litigation before Judge Noreika involving different patents. None of these arguments justify discretionary denial in this case. They instead distract from the proper inquiry, which—when applied to the '385 patent—warrant referral to the merits panel.

II. ANALYSIS

As explained below, no strong settled expectations exist for the challenged patent, and the FWD in this IPR will issue before the scheduled trial date in the district court litigation. These factors weigh in favor of referral for merits

consideration. *See, e.g.*, *TankLogix, LLC v. SitePro, Inc.*, IPR2025-00651, Paper 10 at 2 (July 31, 2025) (denying discretionary denial request because there were no settled expectations and FWD expected before trial date); *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10 (Aug. 14, 2025) (same); *Google LLC v. BrodTi Inc.*, IPR2025-00472, Paper 19 (June 25, 2025) (same).

A. Absence of Settled Expectations Favors Referral

The challenged patent issued only four years ago—on August 10, 2021. There can be no reasonable claim of settled expectations, let alone strong settled expectations because the patent has "not been in force for a significant period of time." *See Microsoft Corp. v. Edge Networking Sys., LLC*, IPR2025-00617, Paper 12 at 2 (July 31, 2025) (challenged patent issued in 2021 has "not been in force for a significant period of time"); *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00479, Paper 10 at 2 (July 10, 2025) ("the challenged patent issued in 2021, and Patent Owner has not developed strong settled expectations that favor discretionary denial"). To the contrary, Petitioner presents an "early challenge" that serves to promote "robust, predictable patent rights," which "weigh[s] against discretionary denial." *Microsoft*, IPR2025-00617, Paper 12 at 2; *see also Micron Tech., Inc. v. Yangtze Memory Techs. Co. Ltd.*, IPR2025-00190, Paper 21 at 3 (June 25, 2025) (2021 patent is "issued recently" and subject to an "early challenge").

PO argues that strong settled expectations exist because "Amazon was on notice of the '385 patent well before its issue date of August 10, 2021," but it provides no evidence supporting this false claim. PO Br. at 15. Instead, PO asserts that the '385 patent claims priority to applications filed in 2014 and 2015, that PO's predecessor VoiceBox purportedly "provided the details of its entire patent portfolio to Amazon in early 2017," and that a related patent was cited in two 2018 IDS's for "Amazon-owned patents." PO Br. at 18. But, according to PO's own allegations, these events occurred *before the application for the '385 patent was even filed* on August 28, 2019. *Id.* These allegations do not establish Amazon's knowledge of the '385 patent before it issued, much less create settled expectations for the '385 patent that had not yet been filed or issued. PO cites decisions to try to show that knowledge of a challenged patent's parents creates settled expectations (*id*. at 17-19), but the decisions simply confirm that settled expectations exist for challenged patents that had been in force for more than six years. *See Murata Mfg. Co., Ltd. v. Georgia Tech. Rsch. Corp.*, IPR2025-00384, Paper 13 at 2-3 (July 29, 2025) (challenged patent issued 16 years ago creates strong settled expectations); *see Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00777, Paper 15 at 2-3 (Aug. 14, 2025) (challenged patents issued 7, 9, and 11 years ago create strong settled expectations). In contrast, Petitioner sought "early review" by filing this Petition less than four years after the challenged patent issued. *See Murata*, IPR2025-00384,

Paper 13 at 3. PO also contends that *Dabico Airport Sols. Inc. v. AXA Power ApS* held that published patent applications provide sufficient notice to create settled expectations, but *Dabico* instead granted discretionary denial because "the *challenged patent* has been in force almost eight years, creating settled expectations." IPR2025-00408, Paper 21 at 2 (June 18, 2025) (emphasis added).[1]

PO argues that Petitioner "was also put on notice of its potential infringement of the '385 patent family through assertion of the '703 patent in the 2019 district court litigation." PO Br. at 19. But PO filed that suit *before* it even filed the application for the '385 patent, and well before that patent issued in 2021. And PO fails to mention that the '385 patent was never at issue in the previous litigation and that Petitioner was found to *not infringe* the related '703 patent.[2] EX2002 at 1.

PO also contends that this IPR should be discretionarily denied because Petitioner should have instead filed a PGR soon after the '385 patent issued. PO Br.

[1] And regardless, the '385 patent application published less than six years ago, in December 2019.

[2] PO also argues that "the Examiner issued a notice of allowance during the '703 patent IPRs' pendency," but this is irrelevant. PO Br. at 19. This fails to establish that Petitioner had earlier knowledge of the '385 patent, which had not yet issued, much less to create strong settled expectations.

at 19. But, as explained above, PO fails to provide any evidence that Petitioner had knowledge of the '385 patent before it issued, and it cites no authority supporting its PGR argument. Instead, PO proposes a policy that would render IPRs obsolete by requiring petitioners to either file a PGR or fall victim to IPR discretionary denial. PO's proposal is entirely inconsistent with the America Invents Act, which provides *both* pathways as appropriate means for challenging a patent.

PO cannot establish strong settled expectations for the '385 patent challenged in this IPR, so as a last resort, it argues that discretionary denial is warranted because two of four *other* pending IPRs Petitioner filed challenge patents issued 6.5 and eight years ago. PO Br. at 20. PO thus concedes that—based on the age of the patents—no settled expectations exist for three out of the five patents challenged in Petitioner's pending IPRs. *Id.* Referral to the merits panel is therefore proper for this additional reason. *See TankLogix*, IPR2025-00651, Paper 10 at 2-3 (referring four IPRs where challenged patents were less than six years old, even though three other challenged patents in other pending IPRs filed by same petitioner were more than six years old). In contrast, the decisions PO cites denied institution when only a *minority* of the patents challenged in co-pending IPRs had no strong settled expectations. *See Audio-Pod*, IPR2025-00777, Paper 15 at 2-3 (only one of six challenged patents was less than six years old); *Samsung Elecs. Am., Inc. v. iCashe, Inc.*, IPR2025-00641, Paper 12 at 3 (Aug. 22, 2025) (only two out of seven

challenged patents was less than six years old). As Petitioner will explain in opposition to any forthcoming discretionary denial requests from PO, the relevant factors favor referral for merits consideration for each IPR, especially because most of the challenged patents issued less than six years ago and because the FWD for each IPR will precede the scheduled trial date.

B. FWD Before Trial Favors Referral

The FWD will issue before trial in the district court case begins. The FWD in this IPR is expected by January 7, 2027. *See* PO Br. at 9. Trial is scheduled to begin two months later, on March 15, 2027. EX2003 at 16. The time-to-trial statistics suggest that trial will start even later, in June 2027. EX2007. These schedules weigh against discretionary denial. *See Apple Inc. v. Apex Beam Techs. LLC*, IPR2025-00910, Paper 10 at 2 (Sept. 3, 2025) (referral to merits panel where FWD projected less than one month before scheduled trial date); *Am. Airlines, Inc. v. Intell. Ventures I LLC*, IPR2025-00785, Paper 11 at 2-3 (Aug. 29, 2025) (referral to merits panel where FWD expected two months before scheduled trial date); *Amazon.com Servs. LLC v. NL Giken, Inc.*, IPR2025-00250, Paper 14 at 2 (May 16, 2025) (referral to merits panel where FWD expected same month as scheduled trial date and time-to-trial statistics suggest that trial will start six months later).

PO's argument that "[t]he Director has exercised her discretion to deny institution under similar timeframes" is wrong. PO Br. at 9. The decisions PO cites

support Petitioner because the Director determined that the anticipated issuance of FWDs months before trial "counsel[ed] against discretionary denial." *See OnePlus Tech. (Shenzhen) Co., Ltd. v. Pantech Corp.*, IPR2025-00637, Paper 17 at 2 (Aug. 14, 2025); *Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00794, Paper 13 at 2 (Aug. 14, 2025). And the other decisions PO cites (PO Br. at 9-10) are inapposite because they address IPRs where the FWD would issue *after* trial. *See Advanced Micro Devices, Inc. v. XtreamEdge, Inc.*, IPR2025-00223, Paper 9 at 2 (June 12, 2025) ("it is unlikely that a final written decision in this proceeding will issue before the district court trial occurs"); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00354, Paper 11 at 2 (June 12, 2025) (FWD would issue over a month *after* scheduled trial date); *Amazon.com, Inc. v. KAIFI LLC*, IPR2025-00626, Paper 16 at 2 (July 29, 2025) (FWD would issue five months *after* scheduled trial date).[3]

C. The *Fintiv* Factors Weigh Against Discretionary Denial

As explained below, no *Fintiv* factor weighs in favor of discretionary denial. On balance, the factors warrant referral to the merits panel.

[3] PO is also wrong that Judge Noreika's experience presiding over the previous litigation outweighs the benefits of the FWD issued before the trial date. PO Br. at 10. Neither the '385 patent challenged in this IPR nor any of the other four patents challenged in Petitioner's other four pending IPRs were at issue in the earlier case.

1. Factor 1: Likelihood of a stay is neutral or favors referral

Factor 1 is neutral at worst because Judge Noreika has not indicated whether the litigation will be stayed pending final resolution of Petitioner's IPRs, and the Director "decline[s] to infer" how a district court might rule on a stay motion. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (May 13, 2020) ("We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here."); *see also Sand Revolution II, LLC v. Cont'l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (June 16, 2020).

That said, Judge Noreika grants or partially grants 84% of motions to stay pending instituted IPRs or PGRs. EX1020. When multiple patents are asserted in the litigation, Judge Noreika has granted stays when IPRs have been instituted for most of the asserted patents. *See, e.g., MQ Gaming, LLC v. Lego Sys., Inc.*, No. 1:19-cv-00905, Dkt. 145 at 1 (Feb. 18, 2021); *see also id.,* Minute Entry (D. Del. Mar. 17, 2021) (granting motion to stay following instituted IPRs for five of eight patents); *Nuance Commc'ns, Inc. v. MModal, LLC*, No. 1:17-cv-01484, Dkt. 226 at 25-30 (D. Del. Apr. 11, 2019) (granting stay pending IPR of five of six asserted patents). PO asserts five patents in the pending litigation, and Petitioner challenges each one in pending IPR petitions. *See* EX2001; PO Br. at 2. Given the strong

merits of each Petition and absence of factors supporting discretionary denial, each IPR will likely be instituted, leading to a stay of the litigation.

PO's arguments to the contrary fail. PO first criticizes Petitioner because it has not yet requested a stay of the district court case. PO Br. at 7. But this argument ignores that the customary practice in the District of Delaware is to wait until after institution to seek a stay because pre-institution motions to stay are typically denied as premature. *See, e.g., Waters Corp. v. Agilent Techs., Inc.*, No. 1:18-cv-01450, Dkt. 95 (D. Del. Aug. 6, 2019) (denying "request to stay the litigation pending IPR without prejudice to renew after the PTAB decision on institution"). Petitioner will submit a motion for a stay immediately upon institution of its IPRs.

PO also argues that the likelihood of a stay is low because an institution decision for the last-filed IPR is expected on February 13, 2026, one month before the *Markman* hearing in the litigation. PO Br. at 11. But Judge Noreika routinely grants stays just before the *Markman* hearing. *See Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, No. 1:17-cv-01612, Dkt. Entry for May 31, 2018 (D. Del.); *see also id.*, Dkt. Entry for Dec. 21, 2018 (Judge Noreika granting stay pending IPRs less than one month before scheduled Markman hearing); *see also Rein Tech, Inc. v. Mueller Sys., LLC*, No. 1:18-cv-01683, Dkt. 24 (D. Del. June 3, 2019); *see also id.*, Dkt. Entry for Mar. 12, 2020 (Judge Noreika granting stay pending *ex parte* reexamination less than one month before scheduled Markman hearing).

Finally, PO argues that a stay is unlikely because patents *related to* the five patents Petitioner now challenges in IPRs were previously held to not be invalid. PO Br. at 8. These prior challenges do not bear on the pending IPRs, which challenge patents and claims that the Board has never previously considered based on invalidity grounds that the Board has never previously considered.

2. Factor 2: FWD before trials favors referral

As discussed above, the Board's statutory deadline for issuing its FWD falls before both the scheduled trial date and anticipated trial date based on time-to-trial statistics. *Supra* § II.B. This factor therefore favors referral to the merits panel.

3. Factor 3: Litigation in early stages favors referral

The district court litigation is in its early stages. By the January 7, 2026 institution deadline, the *Markman* hearing will still be over two months away and close of expert discovery will be over seven months away. EX2003 at 15-16. This early phase of the litigation weighs against discretionary denial. *See, e.g., SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 10-11 (Apr. 7, 2025) (factor 3 favors referral where claim construction terms and contentions exchanged, no *Markman* hearing held, and expert discovery to close in approximately two months); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00321, Paper 10 at 12 (June 18, 2025) (factor 3 weighs against discretionary denial where "expert discovery do[es] not close until next year"); *Kia Corp. v. Emerging Auto. LLC,*

IPR2024-01167, Paper 14 at 17 (Jan. 27, 2025) (a *Markman* hearing 18 days after institution decision deadline "weighs against discretionary denial"). Given the early phase, "the district court has not issued orders related to the patent at issue in the petition," which further "weighs against exercising discretion to deny institution." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 10 (Mar. 20, 2020).

PO argues that "Amazon waited nearly a year to file its IPR petitions, with the last IPR petition being filed just ten days before Amazon's statutory bar deadline." PO Br. at 11. But Petitioner diligently prepared each IPR Petition and timely filed them within statutory deadline, including this Petition filed *two months* before the deadline. Petitioner's diligence is highlighted by the fact that it filed this Petition without the benefit of PO's amended infringement contentions, approximately two months after serving its initial invalidity contentions, and less than four months after receiving PO's initial infringement contentions. *See, e.g., Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 17 (Dec. 1, 2020) (diligence shown where "Petitioner filed its Petition approximately two months after serving its initial invalidity contentions, and approximately two weeks before the statutory deadline").

And PO's complaint that the FWD here will issue after the *Markman* hearing and may therefore lead to inconsistent constructions ignores the high likelihood that the district court case is stayed pending resolution of the instituted IPRs, as discussed for factor 1, above. Moreover, "it is neither uncommon nor impermissible" for

different claim constructions to be advanced "before a District Court and the PTAB," as district court proceedings involve additional issues "outside the scope of *inter partes* review" such as infringement and indefiniteness. *See Chanel, Inc. v. Molo Design, Ltd.*, IPR2022-00543, Paper 7 at 9 (Aug. 12, 2022).[4]

4. Factor 4: Lack of overlapping issues in IPR and litigation favors referral

This Petition challenges all 40 claims of the '385 patent. Only 19 of the claims are at issue in the district court case. Thus, this Petition challenges 21 additional claims—more than half of the claims recited in the '385 patent—which weighs in favor of referral to the merits panel. *POSCO Co., Ltd. v. ArcelorMittal*, IPR2024-01377, Paper 11 at 15-16 (Mar. 18, 2025) (factor 4 "weighs heavily against discretionary denial" where Petition "addresses 16 more claims" than the parallel litigation); *Samsung Elecs. Co., Ltd. v. SiOnyx, LLC*, IPR2024-01431, Paper 21 at 16 (Apr. 10, 2025) (factor 4 weighs against discretionary denial where parallel litigation will not adjudicate invalidity of claims challenged in petition); *Samsung Elecs. Co., Ltd. v. Dynamics Inc.*, IPR2020-00504, Paper 16 at 9 (Oct. 13, 2020)

[4] PO also argues that claim terms from related patents were construed in the previous litigation and that the parallel litigation involves some products also accused in the previous litigation. PO Br. at 12-13. PO does not explain how these points support discretionary denial under factor 3, because these points are irrelevant.

(discussing factor 4: discretionary denial was not warranted because "claims [that did not overlap with those addressed in the parallel litigation] remain in the '631 Patent and Petitioner has challenged their patentability in this [IPR] proceeding").

PO's emphasis on a *Sotera* stipulation is misplaced because the PTO's Guidance explains that "a stipulation may not be particularly meaningful" where, as here, "the petitioner is relying on corresponding system art in a co-pending proceeding." EX2013 at 5. As PO is well-aware, Petitioner relies on several prior art systems in the district court case to prove invalidity. Thus, any *Sotera* stipulation here would "not be particularly meaningful" to the discretionary denial inquiry. *Id.* Moreover, estoppel under § 315(e)(2) precludes Petitioner from submitting overlapping grounds of invalidity at the district court. As such, PO's concerns of inefficiency are limited in this case by the combination of IPR estoppel and a high likelihood of a stay upon institution. *See Anthony, Inc. v. ControlTec LLC*, IPR2025-00636, Paper 9 (July 16, 2025) (referring IPR to merits panel over PO's complaint in discretionary denial request that Petitioner had not filed a *Sotera* stipulation); *see also id.*, Paper 6 (June 10, 2025). On balance with the lack of overlap between the 40 claims of the '385 patent challenged here and the 19 claims at issue in the district court case, this factor favors referral.

5. Factor 5: Petitioner is the defendant in the litigation, favoring referral

Petitioner is the defendant in the district court case. Since the FWD will be entered "around" the same time as the scheduled trial date (two months prior) this factor favors referral to the merits panel. *NVIDIA Corp. v. Invensas Corp.*, IPR2020-00603, Paper 11 at 23 (Sept. 3, 2020) (factor 5 favors referral "[b]ecause NVIDIA is the same party in both district court case and this proceeding, and we are likely to reach the merits at or around the same time as the district court, this factor weighs slightly against discretionary denial").

At worst, this factor is "neutral or weighs slightly in favor of not exercising discretionary denial" because, like here, "the district-court trial—and hence any ruling on the validity of the claims asserted in the district court—may not occur before the entry of a final written decision in this IPR." *BOE Tech. Grp. Co. v. Optronic Scis. LLC*, IPR2024-01130, Paper 16 at 13-14 (Jan. 27, 2025) (factor 5 is neutral or in favor of institution where parties are the same in IPR and district court case); *Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 19-20 (Feb. 25, 2025) (same); *see Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 30 at 13 (Dec. 3, 2024) ("*Fintiv* factor 5 is neutral" where the petitioner is a defendant in the district court case).

6. Factor 6: Other relevant considerations favor referral

Other "relevant considerations" outlined in the Interim Processes for PTAB Workload Management weigh against discretionary denial. First, "the validity or patentability of the challenged patent claims" has not already been adjudicated at the PTAB or any other forum. "Interim Processes for PTAB Workload Management" (March 26, 2025) at 2. Second, the Petition does not exceedingly rely on expert testimony. *See id*. That is because, as explained below, the "unpatentability challenge" is strong based on the express disclosures of the prior art references cited in the Petition. *See id.*

The Examiner materially erred in determining during prosecution that two claim limitations were not disclosed in the prior art: "searching...one or more databases of products or services" and "selecting...without further user input other than the single first user input, a product or service from the database." EX1003 at 405, 475-477. Based on this "material error during patent examination," the Examiner allowed the '385 patent. *See Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (June 12, 2025). But the Petition shows that both the Li invalidity ground and the Chen-Barnes invalidity ground disclose and render obvious the limitations missed by the Examiner.

The Petition explains how Li discloses receiving a first user utterance, such as "Buy XYZ" or "Buy and send flowers to Mary this Valentine's Day," and

searching one or more databases, e.g., a "Retailer Data structure" to select a product or service, e.g., an "Object of Interest," without further user input. *See* Pet. at 13, 15-19; *see also* EX1004, FIGs. 2A1-2A2 (method flowchart showing receiving a single first user input ("Request for immediate single purchase") and using it to search for and select a product or service ("Object F"), without further user inputs). In addition, the Petition explains how Chen in combination with Barnes renders obvious receiving a first user utterance, e.g., "Buy Brand X basketball shoes for me," and searching one or more databases "through a series of queries" to select a product or service, e.g., the requested shoes, without further user input. *See* Pet. at 51-52, 54-60; *see also* EX1005, FIG. 7 (illustrating searching for and selecting "Brand X model 1 basketball shoes [for] $99.99" without further user input other than the single first user input of "Buy Brand X basketball shoes for me"). The Examiner erred by failing to consider these grounds during prosecution, and "it is an appropriate use of Office resources to review [such] potential error." *Microsoft*, IPR2025-00318, Paper 9 at 3; *see also Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (Sept. 3, 2025).

PO argues that the Petition is weak because it cites different, allegedly "disparate," portions of the prior art, but PO does not identify any inconsistencies in the Petition's mapping of the prior art to the asserted claims. PO Br. at 15-17. PO's criticism instead confirms that the prior art references repeatedly disclose the

requirements of the challenged claims, which only highlights the strength of the merits. For example, PO criticizes the Petition's reliance on two portions of Chen that disclose a "single first user input" and "identif[ying] 'a target product or service in response to the [user's] voice request.'" *See id.* at 16-17. Both citations explain that Chen's system receives a "single first user input," e.g., "a first speech-segment message" indicating a "command or request," and identifies "a target product or service in response to the [user's] voice request." *See* Pet. at 51, 54 (citing to EX1005, columns 1 and 18). The two excerpts of Chen therefore describe the same concepts that meet the asserted claim requirement. These repeated and consistent disclosures highlight how the claim elements are disclosed throughout the Chen reference in the Chen-Barnes invalidity ground.

Similarly, Li often describes a specific component and then refers to the same component elsewhere in its detailed description. For example, PO criticizes the Petition's reliance of Li's description of an Offer ID Engine that identifies qualifying offer data, because it cites to a first portion describing that Li's Inter Server includes an Offer ID Engine, and multiple additional portions describing how the same Offer ID Engine works. *See* PO Br. at 16; Pet. at 15. These repeated and consistent disclosures demonstrate how Li discloses the claim elements. *See* Pet. at 15-18.

D. PO's Mischaracterizations Do Not Justify Discretionary Denial

PO's discretionary denial request should be denied for the reasons provided above. The Director should afford no weight to PO's additional mischaracterizations of Petitioner and prior meetings PO alleges occurred, which are addressed here.

PO discusses at length alleged meetings between its predecessor VoiceBox and Amazon, which it alleges occurred in 2011 and 2017—two years before the '385 patent application was filed. PO Br. at 2-5. PO also harps on the previous litigation between the parties, which also began before the '385 patent application was filed and never involved the '385 patent. *Id*. at 5-7. The '385 patent has never been challenged in IPR, so PO instead raises previous IPRs addressing patents that are not subject to a pending IPR. *Id*. at 6, 8, 19. While the PTAB denied institution of the IPRs challenging the '703 patent, it did so because it found that certain claim limitations recited in the independent claims of that patent were not disclosed in the prior art. *See Amazon.com, Inc. v. VB Assets, LLC*, IPR2020-01380, Paper 8 at 16, 22 (Feb. 4, 2021) (discussing claim elements of "determining, by the computer system, a context based at least on the one or more words or phrases" and "completing, by the computer system, without further user input after the receipt of the user input, a purchase transaction for the product or service based on the payment information and shipping information"); *Amazon.com, Inc. v. VB Assets, LLC*, IPR2020-01381,

Paper 8 at 17, 23 (Feb. 4, 2021) (same). None of those limitations are recited in the broader independent claims of the '385 patent challenged here.

When describing the alleged meetings and prior proceedings from years ago, PO repeatedly mischaracterizes Amazon. As just a few examples, PO asserts that VoiceBox "learned Amazon had been actively poaching its customers," that Amazon "was using its vast resources to supplant VoiceBox," and that after the judgment in the original litigation, "Amazon continued to heavily promote its infringing technology, even introducing a smart speaker nearly identical in appearance to the original VoiceBox." PO Br. at 4-5, 7. These statements are false.

Amazon is a pioneer in speech recognition. It developed its now ubiquitous "Alexa" speech recognition technology over many years and through the hard work of thousands of engineers. Amazon never poached customers from VoiceBox, does not infringe any of PO's patents, never copied the design of any VoiceBox speaker, and never tried to "supplant VoiceBox." Instead, Amazon focused on developing world-class speech recognition technology that its customers would love. After Amazon succeeded, VoiceBox focused its efforts on trying to craft patent claims that read on Alexa—half a decade after Alexa's release. PO's statements to the contrary are wrong, and those gratuitous statements do not justify discretionary denial.

III. CONCLUSION

For the foregoing reasons, PO's discretionary denial request should be denied.

Dated: October 7, 2025

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on October 7, 2025, I caused a true and correct copy of the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL and related Exhibit 1020 to be served electronically on Petitioner's lead and backup counsel at the following addresses:

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The foregoing was also electronically served upon counsel of record for Patent Owner in the litigation pending before the U.S. District Court for the District of Delaware entitled *VB Assets, LLC v. Amazon.com Services LLC*, No. 1:24-cv-00839-MN, as follows:

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