Colette Woo

From: Nathan Lowenstein
Sent: Tuesday, August 19, 2025 10:31 AM
To: drabinowitz@fenwick.com
Cc: Kenneth Weatherwax; Colette Woo; dhadden@fenwick.com; amazonDivX@fenwick.com
Subject: RE: Amazon v. DivX: IP2025-01062, IPR2025-01222, IPR2025-01223

Daniel,

Thanks for calling me back. I understand from our call on Friday 8/15 that while Amazon seeks consent to withdraw its IPRs and will not file any additional IPRs, Amazon does plan to file reexamination requests against at least the three currently challenged patents. Amazon's plan to file reexamination requests was, to be sure, not volunteered. It was only revealed when I specifically asked. DivX's position is as follows:

DivX does not oppose Amazon filing a motion to withdraw the IPR petitions because it is overwhelmingly clear that those petitions will be denied. Here, *inter alia*, there is no possibility of a stay (Amazon's stay motion was denied and it did not file the additional two IPRs it promised), the trial date is 10-12 months before the FWD deadlines, nearly all pretrial activities will have concluded by the time of the institution decisions, Amazon is raising precisely the same grounds in both the IPRs and the district court action, has offered no stipulation to avoid duplication, and the parties to the district court litigation are the parties to the IPR. The writing is on the wall and the IPRs are certain to be denied under these indisputable facts. We are aware of well over 100 instances of the Director denying institution on the basis that it is a waste of the Office's resources to conduct duplicative IPR proceedings when the petitioner has a prior opportunity to raise its validity challenges in the district court. And, the facts here—the stay motion was denied, there is 10-12 month gap between the trial date and the FWDs, the lack of any stipulation, the enormous investment by the parties and the District Court—are even more clearly in favor of denial than in the overwhelming majority of those cases. Indeed, we are not aware of a single decision under the current discretionary denial regime that would favor even sending the petitions to the merits panel. In this regard, withdrawing the IPR petitions is, in Patent Owner's view, a reflection of the reality that the Director will deny institution of the three petitions.

And, for this very same reason, Patent Owner strongly objects to any attempt by Amazon to further burden the Office and Patent Owner with repackaged validity challenges that were on the cusp of being rejected in the form of ex parte reexaminations. Where Amazon is fully aware the Office will not allow its validity challenges to go forward, once it has withdrawn those failed challenges, refile them. This is improper gamesmanship. Patent Owner reserves all of its rights including, without limitation, the right to respond to Amazon's withdrawal motion to make its position clear.

Please let us see your proposed email to the Board so we may add our position. Additionally, because (i) DivX has already substantially prepared its discretionary denial briefing prior to Amazon stating it would attempt to withdraw its petitions, (ii) we, as I mentioned, had to assume we would need to file our brief in view of the timing, and (iii) DivX wants the record to be clear on why Amazon's petitions are doomed to fail, DivX will file its discretionary denial briefs. Thus, there is no urgency to get this in before the Wednesday deadline.

Many thanks,

Nathan Lowenstein | **Lowenstein & Weatherwax LLP**
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From: Nathan Lowenstein
Sent: Friday, August 15, 2025 1:19 PM
To: drabinowitz@fenwick.com
Cc: Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>; Colette Woo <woo@lowensteinweatherwax.com>; dhadden@fenwick.com; amazonDivX@fenwick.com
Subject: RE: Amazon v. DivX: IP2025-01062, IPR2025-01222, IPR2025-01223

Hi Daniel,

Thank you again for returning my call yesterday. As we discussed, you indicated that Amazon would not file any additional IPRs against the patents asserted in the district court action but could not confirm that Amazon would not bring any other Office challenges, noting that you needed to discuss with your team. As I explained, our discretionary denial brief is due on Wednesday so it would be good to get greater clarity concerning Amazon's plans in this regard as soon as possible so we can provide our position.

Many thanks,

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From: Daniel Rabinowitz <DRabinowitz@fenwick.com>
Date: August 13, 2025 at 8:10:45 AM PDT
To: Kenneth Weatherwax <weatherwax@lowensteinweatherwax.com>
Cc: David Hadden <DHadden@fenwick.com>, Amazon DivX <AmazonDivX@fenwick.com>
Subject: Amazon v. DivX: IP2025-01062, IPR2025-01222, IPR2025-01223

Counsel,

Amazon intends to seek authorization from the Board to file a motion to withdraw the *inter partes* review petitions for U.S. Patent Nos. 10,715,806, 10,412,141 and 11,611,785. Please let us know if DivX consents to the withdrawal of these three petitions.

Best,
Daniel

Daniel Rabinowitz

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