

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 No. IPR2025-01365
Patent No. 10,297,249

**PATENT OWNER'S BRIEF IN SUPPORT OF
DISCRETIONARY DENIAL**

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I. INTRODUCTION

Pursuant to 35 U.S.C. §314(a) and the Director’s Memorandum on Interim Processes for PTAB Workload Management (the “Workload Memo”), Patent Owner VB Assets, LLC, requests the Director to exercise his discretion to deny institution of *inter partes* review of U.S. Patent No. 10,297,249 (the “’249 patent”).

This proceeding is one of five IPRs filed by Petitioner Amazon.com, Services LLC (“Petitioner” or “Amazon”) challenging five patents asserted in a parallel district court litigation brought by VB Assets over a year ago in July 2024 (collectively, the “Challenged Patents”). The facts of this case strongly favor discretionary denial. First, Patent Owner’s settled expectations weigh in favor of denial. The ’249 patent has been in force for over six years, creating strong settled expectations for Patent Owner. Further strengthening those settled expectations is Amazon’s awareness of the families of the Challenged Patents (including the ’249 patent) and their applicability to the technology space. Despite this knowledge, Amazon did not challenge any of the Challenged Patents at the PTAB early in the patents’ term. Amazon’s failure to do so additionally favors discretionary denial. In addition, analysis under *Fintiv* demonstrates that there are no efficiencies to be gained through institution of this proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, (2020) (precedential). The parallel litigation has been proceeding over the past year with substantial investment by both parties. A trial is also

scheduled to occur in close proximity to the projected final written decision and, based on a previous litigation between the parties, the presiding judge is no stranger to the subject matter of the Challenged Patents and related issues.

Moreover, Amazon has not offered a stipulation to mitigate overlap with the parallel litigation, despite two earlier-filed discretionary denial requests alerting Amazon to this failure. In fact, in response to the requests, Amazon stated it has **no** intent to offer one. These facts demonstrate that the district court litigation is the more appropriate forum to assess the validity of the Challenged Patents and any institution will only duplicate efforts and risk inconsistent decisions.

II. BACKGROUND

The below table provides an overview of the five IPRs brought by Amazon.

IPR No.	IPR Filing Date	Challenged Patent
IPR2025-01167	June 16, 2025	11,087,385 (the “’385 patent”)
IPR2025-01240	July 1, 2025	11,080,758 (the “’758 patent”)
IPR2025-01343	July 31, 2025	9,502,025 (the “’025 patent”)
IPR2025-01365 (this proceeding)	July 30, 2025	The ’249 patent
IPR2025-01379	August 4, 2025	10,755,699 (the “’699 patent”)

This is not the first time that Amazon has been made aware of the subject matter claimed by the '249 patent and the other Challenged Patents. Since as early as 2011, Amazon has been aware of the Challenged Patents, including through a previous litigation involving related patents. These facts are pertinent to Amazon's notice and opportunity to seek their review well before it has done so here.

A. Initial Meetings with Amazon

Originating in 2001, Patent Owner's predecessor, VoiceBox, was a pioneer in conversation computing technology, having developed the first smart speaker using natural language understanding ("NLU") technology. EX2001, 1-3.

Fourteen years ago, VoiceBox contacted Amazon to explore a potential business relationship where VoiceBox would provide core NLU services to Amazon. *Id.*, 3. Expressing interest, Amazon requested more detail. *See id.*, 3-4. Over a series of meetings occurring in October 2011, VoiceBox members met with Amazon executives and engineers to discuss VoiceBox's technology and patents. *Id.*

During an October 26, 2011 meeting at VoiceBox's office, which included technology demonstrations, a review of technical architecture, and a disclosure of plans for next generation products, VoiceBox presented Amazon with a slide presentation that provided even more detail about VoiceBox's patented technology. *Id.*, 5. The presentation explained that VoiceBox had 12 patents and 14 pending applications at the time. *Id.* Those patents and applications included

three of the four patent families from which the Challenged Patents originated. For example, both the application for the presently-challenged '025 patent, filed in 2009, as well as an application for an ancestor patent to the '249 and '699 patents, filed in 2006, were published and publicly available at the time of the 2011 meeting. Moreover, an ancestor patent to the '758 patent was not only already issued, it was specifically discussed as part of the slide presentation. *See id.*, 6, FIG. 4 (illustrating slide describing U.S. Patent 7,818,176). VoiceBox's presentation proposed a business arrangement where VoiceBox would provide "Voice Services" to Amazon, but Amazon instead went silent. *See id.*, 7-8.

After this early meeting, VoiceBox continued to expand, gaining industry-leading customers to its NLU technology, such as Toyota, TomTom, and Chrysler. *Id.*, 8-9. However, Amazon launched its own competing technology in 2014, and began to solicit and hire VoiceBox engineers. *See id.*, 9-10. In 2017, when it became apparent Amazon was using its vast resources to supplant VoiceBox, VoiceBox again reached out to Amazon to propose a business solution. *Id.*, 10.

At Amazon's request, the parties met on February 2, 2017, at VoiceBox's offices with key members of Amazon's Alexa program. EX2001, 10. VoiceBox again provided a detailed technical presentation, which included information about patents and pending applications then owned by VoiceBox. *Id.* Specifically, slides in the presentation listed all VoiceBox patents and published applications, which at

the time included the issued '025 patent, the published application that would later issue as the '249 patent (which is itself a parent to the '699 parent), issued ancestor patents related to the '758 patent, and a published application related to the '385 patent. *Id.*, 11. Following the meeting, Amazon asked for even more technical details and specifically asked VoiceBox for a list of all patents owned by the company, which VoiceBox promptly provided. *Id.*, 11-12. Despite providing all requested information, Amazon once again ceased communications, and VoiceBox later learned Amazon had been actively poaching its customers. *Id.*, 12. Soon after, VoiceBox was sold, but key VoiceBox patents were retained by named inventor Mike Kennewick via Patent Owner after the sale. *Id.*, 12-13.

B. 2019 Litigation Against Amazon

On July 29, 2019, VoiceBox filed a complaint against Amazon in the United States District Court for the District of Delaware asserting infringement of patents related to the Challenged Patents. The claims of four patents reached final determination after a jury trial. *See id.*, 13; EX2002. These patents were U.S. Patent 8,073,681 (the "'681 patent") (related to the '249 and '699 patents), U.S. Patent 7,818,176 (the "'176 patent") (related to the '758 patent), U.S. Patent 9,269,097 (the "'097 patent") (related to the '758 patent), and U.S. Patent No. 9,626,703 (the "'703 patent") (related to the '385 patent).

In addition to challenging these patents' validity at trial, Amazon also challenged the patents at the PTAB, filing five IPRs.¹ All but one IPR challenging the '681 patent were denied institution on the merits. *See Amazon.com, Inc. v. VB Assets, LLC*, IPR2020-01390, Paper 7 (Mar. 11, 2021) (denying institution of IPR against the '176 patent); IPR2020-01388, Paper 10 (Feb. 24, 2021) (denying institution of IPR against the '097 patent); IPR2020-01380, Paper 7 (Feb. 4, 2021) (denying institution of IPR against the '703 patent); IPR2020-01381, Paper 10 (Feb. 4, 2021) (same). For the IPR involving the '681 patent, all claims that reached final written decision were found not unpatentable by the Board. *Amazon.com, Inc. v. VB Assets, LLC*, IPR2020-01367, Paper 27 (Mar. 7, 2022).

Following a jury trial in 2023, the district court entered final judgment confirming the validity of these patents. EX2002, 1-2. The court further found that Amazon had willfully infringed the '681, '176, and '097 patents and

¹ Amazon filed three additional IPRs against patents that were asserted in the 2019 litigation, but did not reach trial. Two of these IPRs were denied on the merits, while one reached final written decision. *See* IPR2020-01374, Paper 10 (Feb. 4, 2021) (denying institution of IPR against U.S. Patent 8,886,536); IPR2020-01377, Paper 10 (Feb. 4, 2021) (same); IPR2020-01346, Paper 25 (Feb. 1, 2022) (determining claims of U.S. Patent 9,015,049 unpatentable).

determined that Amazon should pay over \$40 million in damages for its infringement. *Id.*; see also EX2001, 13. Despite this judgment, Amazon continued to heavily promote its infringing technology, even introducing a smart speaker nearly identical in appearance to the original VoiceBox. EX2001, 13-15. Amazon's actions compelled VoiceBox to file a second complaint against Amazon for willful infringement of the Challenged Patents. *Id.*, 1-2, 15. This second litigation is also occurring in the District of Delaware and is assigned to the same judge who presided over the previous litigation.

III. ANALYSIS

As detailed below, a holistic assessment of the considerations outlined in the Workload Memo and the *Fintiv* factors weigh in favor of discretionary denial. The length of time the '249 patent has been in force and Amazon's notice of the patent favor denial. In addition, the stage of the parallel litigation and its relation to the previous litigation against Amazon support denying this petition.

A. Patent Owner's Settled Expectations Favor Discretionary Denial

The Workload Memo identifies several factors to consider when exercising discretion to deny institution, including the "[s]ettled expectations of the parties, such as the length of time the claims have been in force." Workload Memo, 2. In addition to the patent's age, other factors may be considered in determining the strength of a patent owner's settled expectations, including whether the petitioner

was previously made aware of the challenged patent but failed to seek its early review. *See iRhythm Techs. v. Welch Allyn*, IPR2025-00363, Paper 10 at 3 (June 6, 2025). Here, VB Assets has settled expectations with regard to the '249 patent. The patent has been in force for a significant time and adding to VB Assets' settled expectations is evidence establishing that Amazon was aware, or should have been aware, of the '249 patent, but Amazon chose not to seek early review.

First, the '249 patent issued on May 21, 2019, and thus has been in force for over six years. This length of time creates strong settled expectations for Patent Owner. *See, e.g., Hyosung Advanced Materials Corp. v. Kolon Indus., Inc.*, IPR2025-00662, Paper 12 at 2-3 (Aug. 14, 2025) (“the challenged patents have been in force for more than seven, six, and nine years, respectively, creating strong settled expectations for Patent Owner”); *Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00498, Paper 11 at 2 (Aug. 14, 2025) (patent in force for six years creates settled expectations); *Apple Inc. v. Advanced Coding Techs. LLC*, IPR2025-00983, Paper 10 at 2 (Oct. 3, 2025) (same).

Second, reinforcing these settled expectations is Amazon's knowledge of the '249 patent. Specifically, at multiple instances, Amazon was made aware of the '249 patent. In the October 2011 meeting, Patent Owner informed Amazon of its pending applications at the time, including a publicly available application for an ancestor patent (the '681 patent) to the '249 patent. EX2001, 5. When

VoiceBox provided the details of its entire patent portfolio to Amazon in early 2017, Amazon was aware of the published application that would eventually mature as the '249 patent. *Supra*, §II.B; *cf. Murata Mfg. Co., Ltd. v. Georgia Tech. Res. Corp.*, IPR025-00384, Paper 13 at 2-3 (July 29, 2025) (petitioner's awareness that patent owner was involved in the same technology space since 2007 favored denial); *Amazon.com, Inc. v. Audio Pod IP, LLC*, IPR2025-00777, Paper 15 at 2-3 (Aug. 14, 2025) (evidence showing patent owner had informed petitioner of its patent portfolio in 2012, including an issued ancestor patent to the challenged patents, established notice); *Aquestive Therapeutics, Inc. v. Iono Pharma, LLC*, IPR2025-00874, Paper 11 at 2 (Oct. 3, 2025) (patent owner informing petitioner of 2018 publication of patent application that matured into challenged patent favored denial). In addition, other independent evidence exists demonstrating Amazon's awareness of the '249 patent family. For instance, the related '681 patent and its published application was cited by the examiner during prosecution of six Amazon-owned patents between 2015 and 2020. EX2014, 2 (reference E); EX2015, 2 (reference A); EX2016, 2 (reference B); EX2017, 2 (reference B); EX2018, 2 (references A and B); EX2019, 2 (reference B).

More critically, Amazon was also put on notice of its potential infringement of the '249 patent through assertion of the related '681 patent in the 2019 district court litigation. *Supra*, §II.B. Amazon demonstrated its willingness to take

advantage of PTAB review proceedings by filing an IPR petition against this patent in July 2020. *See Amazon*, IPR2020-01367. At that point, the '249 patent had already issued, providing sufficient notice and time for Amazon to mount an early challenge to the '249 patent. *Cf. Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (June 18, 2025) (noting patent applications and issued patents “are almost always available to provide notice,” and thus, “actual notice of a patent or of possible infringement is not necessary to create settled expectations”). Amazon’s failure to do so supports a finding that the settled expectations of Patent Owner weigh in favor of discretionary denial. *See LifeVac v. DCSTAR*, IPR2025-00454, Paper 11, 2 (July 11, 2025) (early challenges that “occur before expectations in the patent rights are strongly settled” favored); *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (July 31, 2025) (petitioner’s failure to seek early review when petitioner was informed of patent owner’s patent portfolio in 2017 favored denial).

Finally, settled expectations exist with regard to the other Challenged Patents. For example, the '025 patent issued nearly nine years ago and Amazon was aware of each of the Challenged Patents by virtue of the 2011 and 2017 meetings with Amazon (*supra*, §II.A) and the assertion of related patents in the 2019 litigation (*supra*, §II.B). These additional considerations, together with the timing of the parallel district court litigation and the court’s already-established

familiarity with the Challenged Patents as a whole (*infra*, §III.B), further demonstrate that discretionary denial is appropriate.

B. The *Fintiv* Factors Weigh in Favor of Discretionary Denial

1. *Fintiv* Factor 1

Factor 1 assesses “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” The district court litigation is not stayed, and Amazon has not requested one. Furthermore, the case is assigned to Judge Maryellen Noreika. See EX2003, 13. Judge Noreika has denied a stay of litigation when only some of the IPR proceedings challenging asserted patents have been instituted. See, *e.g.*, EX2004 (denying motion for stay pending institution decision on second patent); EX2005 (denying motion for partial stay of one patent undergoing IPR); EX2006, 11:21-12:9 (denying motion where only three of six asserted patents were instituted). The likelihood of a stay is therefore low because a decision on a motion will likely not occur until after an institution decision in the last-filed IPR (February 13, 2026), by which time substantial investment in the litigation will have occurred. *Infra*, §III.B.3. Moreover, success on a motion likely will be predicated on the Board granting institution on all five proceedings. The likelihood of this occurring is also low in view of Amazon’s previous unsuccessful attempts in establishing the invalidity of patents related to the Challenged Patents before both the district court and the PTAB. *Supra*, §II.B.

This includes the '681 patent, an ancestor patent to the '249 patent, which was the subject of an IPR that reached final written decision determining no claims unpatentable and confirmed valid in the 2019 litigation. *See* IPR2020-01367, Paper 27.

Thus, factor 1 weighs in favor of discretionary denial.

2. *Fintiv* Factor 2

Factor 2 assesses the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” The scheduled trial date is March 15, 2027, which is in close proximity to any projected final written decision. EX2003, 12-13. All of the IPRs have expected final written decision deadlines within roughly one to two months of the scheduled trial. With respect to this proceeding, the trial would occur just one month after a final written decision (approximately February 12, 2027). Time-to-trial statistics for the District of Delaware confirm trial will occur in close proximity to any final written decision. *See* EX2007 (listing 35 months to trial). The Director has exercised discretion to deny institution under similar timeframes. *See, e.g., OnePlus Tech. (Shenzhen) Co., Ltd. v. Pantech Corp.*, IPR2025-00637, Paper 17 (Aug. 14, 2025) (no scheduled trial date, but statistics suggested December 2026 trial, two months after projected October 2026 final written decision); *Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00794, Paper 13 (Aug. 14, 2025) (final written decision

projected for October 17, 2026, and trial date scheduled for November 16, 2026, with statistics suggesting a trial date of November 2026 through July 2027).

Moreover, the Director has recognized that, while “a district court trial date that occurs after a projected final written decision date [may] reduce[] the possibility of conflicting decisions,” that benefit may be outweighed by “the efficiencies gained by avoiding parallel proceedings.” *Advanced Micro Devices, Inc. v. XtreamEdge, Inc.*, IPR2025-00223, Paper 9 at 2 (June 12, 2025). This is the case here. In addition to the parties’ meaningful investment (*infra*, §III.B.3), other efficiencies outweigh any benefit that theoretically may be gained by a projected final written decision occurring before the trial. Specifically, the parallel litigation is occurring in the same district court and before the same judge as the previous litigation filed against Amazon. *See* EX2003, 13; EX2002, 3. Thus, given her experience with the previous litigation involving related patents, Judge Noreika is already familiar with the Challenged Patents’ subject matter, the accused products, many of the claim terms, and the prior art. *Infra*, §III.B.3.

This familiarity leads to efficiencies that will not be provided by a parallel IPR proceeding. It will also better ensure that consistent decisions will be maintained across the Challenged Patents and the previously-litigated patents. As such, although a final written decision in this proceeding may occur shortly before the scheduled trial, given their close proximity and the district court’s position to

efficiently resolve issues likely to be raised against the Challenged Patents, maintaining a parallel IPR proceeding is more likely to result in unnecessary duplication of efforts and risk inconsistent decisions. *See Shenzen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00354, Paper 11 at 2 (June 12, 2025) (finding “it will be inefficient to maintain two parallel proceedings when the district court scheduled trial date and the projected final written decision due date are in close proximity”); *Amazon.com, Inc. v. KAIFI LLC*, IPR2025-00626, Paper 16 at 2 (July 29, 2025) (finding “the close proximity of a final written decision to the projected trial date ... would result in the significant duplication of effort, additional expenses for the parties, and a risk of inconsistent decisions”). Moreover, as explained more below, these risks are even further compounded by Amazon’s failure to provide any stipulation to mitigate overlap between the IPR proceedings and the district court litigation. *See infra*, §III.B.4.

Thus, factor 2 weighs in favor of discretionary denial.

3. *Fintiv* Factor 3

Factor 3 assesses the “investment in the parallel proceeding by the court and the parties.” 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. During that time, and up until this request’s filing, meaningful investment in the parallel proceeding has already occurred. For example, the parties have

substantially completed document production, exchanged infringement and invalidity contentions, proposed claim terms for construction, and the period for fact discovery has closed. *See* EX2003, 14. By the time the Board issues its institution decisions in all five IPRs, additional investment will have occurred. By February 12, 2026, the projected institution date for this proceeding, the parties will have exchanged final infringement and invalidity contentions and completed claim construction briefing, with a *Markman* hearing scheduled for March 11, 2026. *Id.* This timing raises the risk of additional inefficiencies, conflicting decisions, and prejudice to Patent Owner—by the time the Board reaches any final written decision, the district court will have likely construed the terms of the Challenged Patents, but neither the Board nor Patent Owner will be able to address the impact of those constructions in the institution decision or Patent Owner Response. Indeed, while Petitioner purports to “appl[y] plain-and-ordinary meaning to all terms,” Petitioner expressly “reserves the right to offer different claim constructions in other forums” (Pet., 8 & n.2) and has, in fact, proposed differing claim constructions in the parallel litigation prior to this petition’s filing. For example, Amazon has contended that the preamble of claim 1 is limiting and terms recited in the claim are indefinite, contrary to the “plain-and-ordinary meaning” position advanced in the petition. *See* EX2008 (providing other differing constructions for the ’249 patent, such as “context”); *cf. Sun Pharms. Indus. Inc. v.*

Nivagen Pharms., Inc., IPR2025-00893, Paper 18 at 2-3 (Sept. 19, 2025) (finding petitioner’s failure to “explain why it advanced a narrow construction in district court and advances a broader construction in its Petition” favors denial).

Moreover, the parties and the court have already invested substantially in the parallel proceeding in view of the previous litigation. For example, in the previous litigation, the court construed certain claim terms that are also recited in the Challenged Patents. *See, e.g.*, EX1019, 1-2 (construing “context”); EX1001, claims 1, 2 (reciting same claim term). The parallel litigation also involves accused products and invalidity contentions that overlap with those in the 2019 litigation. *E.g.*, EX2001, 7, 37-40, 193 (alleging Alexa products infringe ’249 patent); EX2010, 2, 21-24, 83-84 (alleging Alexa products infringe related ’681 patent); EX2011, 39-40 (asserting MIT Galaxy against the ’249 patent); EX2012, 11 (asserting same against the related ’681 patent). Thus, the parties’ and court’s investment in the previous litigation carry over and provide efficiencies to the current litigation. Accordingly, factor 3 weighs in favor of discretionary denial.

4. *Fintiv* Factor 4

Factor 4 assesses the extent of “overlap between issues raised in the petition and in the parallel proceeding.” There will be substantial overlap between issues raised in the petition and in the parallel proceeding. In its invalidity contentions, Amazon alleges that the asserted claims of the ’249 patent are invalid based on the

same prior art references applied in its petition grounds. *See* Pet., i-ii, 2-3 (applying Kennewick, Oviatt, Fujimoto, Shimomura, Matsuda, and Cooper); EX2011, 39-44 (alleging obviousness based on combinations involving same references). Amazon’s invalidity contentions also raise combinations of the petition references with system prior art. *See* EX2011, 40-41 (asserting combinations of references with MiPad and MIT Galaxy systems).

Amazon has not filed, nor has made any offer to file, a stipulation to mitigate this extensive overlap. The Director has repeatedly found that a failure to offer a stipulation to prevent overlap between parallel proceedings weighs in favor of discretionary denial, even where a final written decision was projected to occur before the district court trial. *See, e.g., DataDome SA v. Arkose Labs Holdings, Inc.*, IPR2025-00694, Paper 14 at 3 (Aug. 14, 2025) (lack of stipulation weighed in favor of discretionary denial even where there was no scheduled trial date); *HS Hyosung*, IPR2025-00662, Paper 12 at 2-3 (lack of stipulation weighed in favor of discretionary denial even where parallel litigation stayed); *Full-Metal-Power B.V. v. InFocus Downhole Sols. USA LLC*, IPR2025-00391, Paper 14 at 2 (June 25, 2025). In addition, by the time Amazon filed its petition, Amazon was on notice of the Workload Memo and the Office’s guidance that “[a] petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable.” EX2013, 5.

VB Assets specifically noted Amazon’s failure to offer a stipulation in its discretionary denial requests in the IPRs challenging the ’385 and ’758 patents. *See* IPR2025-01167, Paper 6; IPR2025-01240, Paper 6. In response, Amazon stated its intent **not** to offer any form of stipulation, characterizing it as “‘not [] particularly meaningful’ to the discretionary denial inquiry.” IPR2025-01167, Paper 7 at 14. Amazon’s arguments showcase that it is trying to have it both ways. As even Amazon’s self-selected cases illustrate, the granting of a stay is not guaranteed (*id.*, 9), and Amazon seeks to preserve the possibility of maintaining in parallel the same invalidity grounds before both the district court and the Board. Moreover, Amazon admits that it intends to also rely on “several prior art systems in the district court case to prove invalidity,” which it proposes combining with the same references asserted in the petition. EX2011, 40-41. While Amazon partially quotes the Office’s Guidance (IPR2025-01167, Paper 7 at 14), it fails to acknowledge its full context—*i.e.*, in such cases, “a stipulation may not be particularly meaningful because ***the efficiency gained in an AIA proceeding will be limited.***” EX2013, 5 (emphasis added). This is the case here because, regardless of IPR estoppel, Amazon will be free to pursue grounds relying on the same references. *Ingenico Inc. IOENGINE, LLC*, 136 F.4th 1354 (Fed. Cir. 2025). Thus, Amazon’s avoidance of a stipulation in these proceedings only magnifies the risk of duplication of efforts and inconsistent decisions. *Cf. Shenzhen*, IPR2025-

00354, Paper 11 at 2-3 (finding petitioner Shenzhen's *Sotera* stipulation insufficient to eliminate inefficiencies caused by overlap).

Accordingly, factor 4 weighs in favor of discretionary denial.

5. *Fintiv* Factor 5

Factor 5 considers "whether the petitioner and the defendant in the parallel proceeding are the same party." This factor weighs in favor of discretionary denial because the parties are the same in the parallel proceeding. *See* EX2001, 1.

6. *Fintiv* Factor 6

Factor 6 assesses "other circumstances that impact the Board's exercise of discretion, including the merits." As discussed above in §III.A, considerations outlined in the Workload Memo provide additional bases that favor discretionary denial. Strong settled expectations for Patent Owner exist because the '249 patent has been in force for over six years and Amazon was on notice of the '249 patent well before its issue date of May 21, 2019, but Amazon failed to timely challenge the '249 patent at the PTAB. Furthermore, as also discussed above, referral of this petition would be an inefficient use of Board resources in view of settled expectations with respect to other Challenged Patents and the circumstances surrounding the parallel litigation.

The merits of the petition are also weak. For example, each of the petition's four grounds rely on Oviatt. Pet., 2-3. According to Petitioner, Oviatt is a printed

publication that “was publicly accessible before the priority date of the ’249 patent.” *Id.*, 4. However, the version of Oviatt that Petitioner relies on for its grounds states that it “was downloaded” on “27 September 2014” and “[p]ublished online” on “09 Dec 2009,” well after the ’249 patent’s 2006 priority date. EX1005, 1; Pet., 2. The petition does not address this discrepancy. Moreover, each of Petitioner’s grounds relies on Fujimoto for the limitation of “filtering ... sound from the first voice input and the second voice input based on the comparison.” Pet., 22-23. However, while Petitioner cites to Fujimoto as **disclosing** this requirement, Petitioner relies on Fujimoto’s noise canceling unit 304 that only “corrects the main voice data and removes noise” (*i.e.*, the alleged first voice input). *Id.*, 22. Petitioner points to no description that sound from a “second voice input” is filtered. This deficiency is highlighted by Petitioner’s expert, who, instead of advancing a theory premised on disclosure, argues it would have been obvious. See EX1002, ¶122 (stating “a POSITA would have found it obvious” to filter the two inputs, citing to a non-grounds reference).

IV. CONCLUSION

Based on the considerations discussed above as a whole, Patent Owner respectfully submits that discretionary denial is warranted.

Date: October 14, 2025

Respectfully submitted,

/ Matthew A. Argenti /
Matthew A. Argenti, Lead Counsel
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V. APPENDIX

Exhibit No.	Description
2001	Complaint for Patent Infringement and Exhibits, <i>VB Assets, LLC v. Amazon.com Services, LLC</i> , Case No. 1:24-cv-00839 (D. Del.) (filed July 18, 2024)
2002	Final Judgment, <i>VB Assets, LLC v. Amazon.com Services, LLC</i> , Dkt. No. 350, Case No. 1:19-cv-01410 (D. Del.) (filed May 16, 2025)
2003	Scheduling Order, <i>VB Assets, LLC v. Amazon.com Services, LLC</i> , Dkt. No. 19, Case No. 1:24-cv-00839 (D. Del.) (filed Dec. 9, 2024)
2004	<i>Exact Sciences Corp. v. Geneoscopy, Inc.</i> , Case No. 1:23-cv-01319, Dkt. Entry entered Nov. 1, 2024 (D. Del.)
2005	<i>PureWick Corp. v. Sage Prods. LLC</i> , Case No. 1:19-cv-01508, Dkt. Entry entered May 4, 2021 (D. Del.)
2006	<i>Intuitive Surgical, Inc. v. Auris Health, Inc.</i> , Case No. 1:18-cv-01359, Dkt. Entry No. 238 (D. Del.) (Apr. 14, 2020)
2007	Federal Court Management Statistics, U.S. District Courts Profiles, District of Delaware (June 30, 2025)
2008	Amazon's Identification of Proposed Constructions, <i>VB Assets, LLC v. Amazon.com Services, LLC</i> , Case No. 1:24-cv-00839 (D. Del.) (served June 25, 2025)
2009	<i>Reserved</i>
2010	Complaint for Patent Infringement and Exhibits, <i>VB Assets, LLC v. Amazon.com, Inc.</i> , Case No. 1:19-cv-01410 (D. Del.) (filed July 29, 2019)

2011	Defendant's Preliminary Invalidity Contentions, <i>VB Assets, LLC v. Amazon.com Services, LLC</i> , Case No. 1:24-cv-00839 (D. Del.) (served April 11, 2025)
2012	Final Jury Instructions, <i>VB Assets, LLC v. Amazon.com, Inc.</i> , Case No. 1:19-cv-01410 (D. Del.) (Nov. 8, 2023)
2013	USPTO, <i>FAQs for Interim Processes for PTAB Workload Management</i> (archived), available at: https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management
2014	Excerpts from File History of U.S. Patent Application No. 13/739,826 (issued as U.S. Patent No. 9,922,639)
2015	Excerpts from File History of U.S. Patent Application No. 13/842,804 (issued as U.S. Patent No. 9,424,840)
2016	Excerpts from File History of U.S. Patent Application No. 15/463,339 (issued as U.S. Patent No. 10,600,406)
2017	Excerpts from File History of U.S. Patent Application No. 13/776,594 (issued as U.S. Patent No. 10,102,845)
2018	Excerpts from File History of U.S. Patent Application No. 14/283,017 (issued as U.S. Patent No. 10,726,831)
2019	Excerpts from File History of U.S. Patent Application No. 15/454,832 (issued as U.S. Patent No. 10,706,843)

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Patent Owner's Brief In Support of Discretionary Denial and accompanying Exhibits 2001-2008 and 2010-2019 were served on October 14, 2025, on the Petitioner at the electronic correspondence address of the Petitioner as follows:

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