

**‘ “IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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AMAZON.COM SERVICES LLC,

Petitioner,

v.

VB ASSETS, LLC,

Patent Owner.

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Case: IPR2025-01365

U.S. Patent No. 10,297,249

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**PETITIONER’S OPPOSITION TO PATENT OWNER’S  
REQUEST FOR DISCRETIONARY DENIAL**

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**EXHIBIT LIST (37 C.F.R. § 42.63(e))**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                                                  |
|----------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1001           | U.S. Patent No. 10,297,249 (“the ’249 patent”)                                                                                                                                                                                                      |
| 1002           | Declaration of Padhraic Smyth, Ph.D.                                                                                                                                                                                                                |
| 1003           | Prosecution File History for the ’249 patent                                                                                                                                                                                                        |
| 1004           | U.S. Patent Application Publication No. 2004/0193420 A1 (“Kennewick”)                                                                                                                                                                               |
| 1005           | “Designing the User Interface for Multimodal Speech and Pen-Based Gesture Applications: State-of-the-Art Systems and Future Research Directions” by Sharon Oviatt et al., <i>Human-Computer Interaction</i> (2000, Vol. 15) (“Oviatt”)              |
| 1006           | Declaration of Rachel J. Watters on Authentication of Publication                                                                                                                                                                                   |
| 1007           | Japanese Patent Application No. 2004145025A                                                                                                                                                                                                         |
| 1008           | Certified English Translation of Japanese Patent Application No. 2004145025A (“Fujimoto”)                                                                                                                                                           |
| 1009           | “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, August), (“Asthana”) |
| 1010           | Lucente, M., “Conversational interfaces for e-commerce applications,” Communications of the ACM (Sept. 2000), 43(9), 59-61, (“Lucente”)                                                                                                             |
| 1011           | Huang et al., “Spoken Language Processing: A Guide to Theory, Algorithm, and System Development,” Prentice Hall (2001) (“Huang”)                                                                                                                    |
| 1012           | U.S. Patent No. 6,859,776 (“Cohen”)                                                                                                                                                                                                                 |
| 1013           | Complaint for Patent Infringement, <i>VB Assets, LLC, v. Amazon.com Services, LLC</i> , 1:24-cv-00839-MN (D. Del. July 18, 2024), Dkt. 1                                                                                                            |

## Opposition to Request for Discretionary Denial

| Exhibit | Description                                                                                                                                                                                                                                                                                                                                                                                                                    |
|---------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1014    | U.S. Patent Application Publication No. 2001/0021909 A1 (“Shimomura”)                                                                                                                                                                                                                                                                                                                                                          |
| 1015    | Japanese Patent Application No. JP2004334591A                                                                                                                                                                                                                                                                                                                                                                                  |
| 1016    | Certified English Translation of Japanese Patent Application No. JP2004334591A (“Matsuda”)                                                                                                                                                                                                                                                                                                                                     |
| 1017    | U.S. Patent No. 6,757,362 (“Cooper”)                                                                                                                                                                                                                                                                                                                                                                                           |
| 1018    | Curriculum Vitae of Padhraic Smyth, Ph.D.                                                                                                                                                                                                                                                                                                                                                                                      |
| 1019    | Claim Construction Memorandum Order, <i>VB Assets, LLC, v. Amazon.com, Inc., et al.</i> , 1:19-cv-01410-MN (D. Del. June 23, 2021), Dkt. 90                                                                                                                                                                                                                                                                                    |
| 1020    | Excerpt from Microsoft Computer Dictionary, Fifth Edition (2002)                                                                                                                                                                                                                                                                                                                                                               |
| 1021    | Docket Navigator statistics regarding Judge Noreika decisions on motions to stay pending IPR                                                                                                                                                                                                                                                                                                                                   |
| 1022    | Plaintiff VB Assets, LLC’s Responses to Defendant’s First Set of Interrogatories (Nos. 1-14), <i>VB Assets, LLC v. Amazon.com Services, LLC</i> , Case No. 1:24-cv-00839 (D. Del.)                                                                                                                                                                                                                                             |
| 1023    | Plaintiff VB Assets Responses to Defendants’ First Set of Interrogatories (No. 1-16), <i>VB Assets, LLC v. Amazon.com Services, LLC</i> , Case No. 1:19-cv-01410 (D. Del.)                                                                                                                                                                                                                                                     |
| 1024    | Nomination of John A. Squires To Be Under Secretary of Commerce for Intellectual Property and the Director of the United States Patent and Trademark Office, Question for the Record, May 28, 2025, available at <a href="https://www.judiciary.senate.gov/imo/media/doc/2025-0521_qfrresponses_squires.pdf">https://www.judiciary.senate.gov/imo/media/doc/2025-0521_qfrresponses_squires.pdf</a> (last visited Nov. 4, 2025) |

## I. INTRODUCTION

The Director should deny Patent Owner's ("PO") request for discretionary denial. The Director recently emphasized the importance of issuing patents that are "born strong." EX1024 at 23. To reach this end, the Director has explained that the Patent Office must avoid "errors of all types." *Id.* For issued patents that are not born strong and then asserted in litigation, the Director confirmed that IPR serves as "an important avenue of redress." *Id.* at 2, 17. The '249 patent challenged here is a weak patent that was only issued because of examiner error. The Examiner allowed the '249 patent after determining that the prior art did not disclose filtering the claimed "sound from the first voice input and the second voice input ... based on the comparison." EX1003 at 40-41. But the Petition shows that Fujimoto discloses this limitation. It is "an appropriate use of Office resources" to review this examiner error. *Anthony, Inc. v. ControlTec, LLC*, IPR2025-00636, Paper 9 at 2-3 (July 16, 2025); *Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (June 12, 2025).

Institution is also warranted in view of PO's gamesmanship. PO filed its application for the challenged patent in 2015, *after* Petitioner Amazon released to the public its revolutionary speech recognition technology called "Alexa" in 2014. With the benefit of Alexa's public disclosures and through claims of earlier priority, PO drafted the claims of the challenged '249 patent to try to accuse Alexa of

## Opposition to Request for Discretionary Denial

infringement. The '249 patent then issued in 2019, 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 '249 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. A holistic assessment of the *Fintiv* factors, including considerations outlined in the Workload Memo, supports institution.

The relevant discretionary factors also weigh against denial. The Board will enter its Final Written Decision ("FWD") in this IPR before trial in the related district court case. The district court case is in its early stages before Judge Noreika, who routinely grants stays once IPRs are instituted. And the scope of this IPR is broader than the litigation because Petitioner challenges claims that are not at issue in the district court. The Director should therefore deny PO's request for discretionary denial.

## II. ANALYSIS

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

As explained below, the *Fintiv* factors, on balance, weigh against discretionary denial.

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

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); *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. EX1021. In litigation involving multiple asserted patents, 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 (D. Del. 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, three of which are subject to currently-pending IPRs. *See* EX2001; PO Br. at 2. Given the strong merits of each Petition and factors supporting discretionary denial, each IPR should be instituted, leading to a stay of the litigation.

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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 11. 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 move to stay immediately upon institution of its IPRs.

PO also argues that a stay is unlikely because an institution decision for the last-filed IPR is expected 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 (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 (granting stay pending *ex parte* reexamination less than one month before scheduled *Markman* hearing).

Finally, PO argues that a stay is unlikely because some patents *related to* the patents Petitioner now challenges in IPRs were not found to be invalid in prior

proceedings. PO Br. at 11-12. 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 institution**

Factor 2 weighs against discretionary denial because the Board will enter its Final Written Decision (“FWD”) in this IPR before trial in the district court case. The FWD in this IPR is expected by February 12, 2027. *See* PO Br. at 12. Trial is scheduled to begin one month 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) (granting referral to merits panel where FWD projected less than one month before scheduled trial date); *Freightcar Am., Inc. v. Nat’l Steel Car Ltd.*, IPR2025-01046, Paper 20 at 2 (Oct. 10, 2025) (same); *Amazon.com Servs. LLC v. NL Giken, Inc.*, IPR2025-00250, Paper 14 at 2 (May 16, 2025) (granting referral where FWD expected same month as scheduled trial date and time-to-trial statistics suggested that trial will start six months later).

PO’s argument that “[t]he Director has exercised discretion to deny institution under similar timeframes” is wrong. PO Br. at 12-13. The decisions PO cites *support Petitioner* because the Director determined that the anticipated issuance of FWDs 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 13-14) are inapposite because the FWDs in those IPRs 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. Stratasy, 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).<sup>1</sup>

### 3. Factor 3: Litigation in early stages favors institution

Factor 3 weighs against discretionary denial, because the district court case is in its early stages. By the institution deadline in this IPR, the *Markman* hearing will still be nearly one month away and close of expert discovery will be over six months away. EX2003 at 14-15. This early phase of the litigation weighs against

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<sup>1</sup> 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 13-14. Neither the ’249 patent challenged in this IPR nor either of the other two patents challenged in the other pending IPRs were at issue in the earlier case.

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discretionary denial. *See, e.g., SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 10-11 (Apr. 7, 2025) (factor 3 favors institution 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”). 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 filed this Petition near the statutory deadline. PO Br. at 14. But Petitioner diligently prepared and timely filed this Petition, without the benefit of PO’s amended infringement contentions, less than four months after serving its initial invalidity contentions, and less than five months after receiving PO’s initial infringement contentions. *Samsung Elecs. Co., Ltd. v. Mullen Indus. LLC*, IPR2024-01472, Paper 9 at 10 (Mar. 31, 2025) (“Petitioner’s diligence” under similar circumstances “weighs against exercising discretionary denial”).

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

## Opposition to Request for Discretionary Denial

for factor 1 above. PO Br. at 15-16. PO nevertheless contends that Petitioner proposes plain meaning for all terms in the Petition while proposing constructions for some terms in the litigation, including that the preambles are limiting and that one term<sup>2</sup> is indefinite. *Id.* But Petitioner *adopts* PO's plain meaning construction for the term that Petitioner proposes is indefinite in the litigation. *See* EX2008; *Chanel, Inc. v. Molo Design, Ltd.*, IPR2022-00543, Paper 7 at 9 (Aug. 12, 2022) (“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 indefiniteness). And consistent with its proposal in the litigation that the preamble of independent claim 1 is limiting, the Petition explains in detail how the prior art discloses the limitations recited in the preamble. The remainder of Petitioner's proposed constructions in the litigation are consistent with the plain meaning it proposes in the Petition, which PO does not dispute.<sup>3</sup>

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<sup>2</sup> The term is “comparing, by the computer system, the first voice input with the second voice input; [and] filtering, by the computer system, sound from the first voice input and the second voice input based on the comparison,” recited in claim 1.

<sup>3</sup> 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

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

This Petition challenges all 28 claims of the '249 patent. Only 11 of the claims are at issue in the district court case. Thus, this Petition challenges 17 additional claims—more than half of the claims recited in the '249 patent—which weighs against discretionary denial. *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 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) (same).

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 asserts 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.*

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previous litigation. PO Br. at 16. PO does not explain how these points support discretionary denial under factor 3, because these points are irrelevant.

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While PO cites decisions noting that a stipulation may weigh against discretionary denial, those cases do not address the facts here, where a stipulation lacks value because Petitioner asserts system art at the district court. PO Br. at 17-18. Nor do the decisions hold that the presence of a stipulation outweighs the lack of overlapping issues between an IPR and district court case when assessing *Fintiv* factor 4, much less that it outweighs all other factors in the *Fintiv* analysis. *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 already limited in this case by the combination of IPR estoppel and a high likelihood of a stay upon institution. *See Anthony*, IPR2025-00636, Paper 9 (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). That the Board will decide the merits of the case before the district court trial even if no stay is granted further reduces PO's concerns of potential inefficiency. On balance with the lack of overlap between the IPR and district court case, this factor is at worst neutral.

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

Petitioner is the defendant in the district court case. Since the FWD will be entered "around" the same time as the scheduled trial date (one month prior) this factor weighs against discretionary denial. *NVIDIA Corp. v. Invensas Corp.*,

IPR2020-00603, Paper 11 at 23 (Sept. 3, 2020). 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); *see also Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 19-20 (Feb. 25, 2025) (“fifth *Fintiv* factor’s weight is neutral” where the petitioner is a defendant in the district court case).

**6. Factor 6: Other relevant considerations favor institution**

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” (Mar. 26, 2025) at 2. Second, the Petition does not exceedingly rely on expert testimony because, as explained below, the “unpatentability challenge” is strong based on the express disclosures of the prior art cited in the Petition that the Examiner failed to consider during prosecution. *See id.*

The Examiner’s failure to consider the invalidity grounds presented in the Petition before allowing the ’249 patent was an error “material to the patentability of the challenged [claims] during patent examination,” and “it is an appropriate use

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of Office resources to review the potential error.” *See Anthony*, IPR2025-00636, Paper 9 at 2; *Microsoft*, IPR2025-00318, Paper 9 at 3; *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (July 17, 2025). The Examiner allowed the patent after determining that the cited prior art did not disclose filtering the claimed “sound from the first voice input and the second voice input,” which the Examiner understood as meaning “sound that is based on both voice inputs from the first and second input devices.” EX1003 at 40-41 (emphasis in original).

But the Petition shows that the Kennewick-Oviatt-Fujimoto invalidity ground renders this limitation obvious. The Petition explains that Fujimoto discloses receiving sound via two input devices: a main microphone 102 that receives “main voice data” corresponding to a “first voice input,” and a reference microphone 202 that receives “reference data” corresponding to a “second voice input.” Pet. at 19-20. Fujimoto further discloses a “noise canceling unit 304” that receives and filters both inputs, which is the claimed “sound from the first voice input and the second voice input.” Pet. at 22-23. The Examiner “erred in a manner material to the patentability of the challenged [claims]” by failing to consider this ground during prosecution, and “it is an appropriate use of Office resources to review the potential error.” *Anthony*, IPR2025-00636, Paper 9 at 2; *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). Institution here furthers the

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Director's goal of providing an "important avenue of redress" for companies, like Amazon, sued on weak patents, like the '249 patent. *See* EX1024 at 2, 17.

PO arguments on the merits of the Petition's invalidity grounds each fail. *See* PO Br. at 19-20. First, PO's argument that Oviatt is not prior art is wrong because it was published in 2000, well before the October 16, 2006 priority date of the '249 patent. *See* EX1005 at 3; EX1006. Indeed, the Petition confirms that Oviatt was published in the journal *Human-Computer Interaction* in 2000, and a supporting declaration confirms that a printed copy was received, catalogued, and made publicly available by the University of Wisconsin-Madison on or before April 25, 2001. Pet. at 4; *see also* EX1002, ¶¶70-71; EX1006.

PO next argues that the Petition does not explain how "sound from a 'second voice input' is filtered" in Fujimoto. PO Br. at 20. But the Petition explains that Fujimoto discloses comparing "the first voice input" from a main microphone with "the second voice input" from a reference microphone, to obtain "the main voice data and the extracted reference voice data" which meet the claimed "sound from the first voice input and the second voice input." Pet. at 20-22. A "noise canceling unit 304" receives this "sound from the first voice input and the second voice input" and filters it to produce an output signal that "corrects the main voice data and removes noise" based on the comparison. *Id.* at 21-23. Fujimoto thus discloses

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filtering sound from a second voice input by filtering the “the main voice data and the extracted reference voice data” to obtain a corrected signal with reduced noise.<sup>4</sup>

In addition, the ’249 patent has not developed sufficient settled expectations that would, on balance, favor discretionary denial. While PO notes that the ’249 issued slightly over six years ago (on May 21, 2019), there is “no bright-line rule on when expectations become settled,” and there “may be persuasive reasons why the Board should review challenged claims [even] several years after their issuance date.” PO Br. at 8; *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2 (June 18, 2025); *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2–3 (June 26, 2025). Persuasive reasons exist here because the ’249 patent was never commercialized, practiced, or marked, which weighs against PO’s claim of “settled expectations.” See *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00531, Paper 10 at 3 (July 17, 2025) (finding that challenged patent “in

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<sup>4</sup> PO’s additional argument that Dr. Smyth relied on a reference outside of the invalidity grounds misinterprets Dr. Smyth’s declaration. PO Br. at 20. Dr. Smyth instead explained that a POSITA would have understood that Fujimoto discloses the claimed filtering, and further explained that a POSITA would have been familiar with common filtering techniques that process multiple input signals to produce an output with reduced noise. EX1002, ¶¶121-122.

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force for approximately 10 years” but had “never been ‘commercialized, asserted, marked, licensed, or otherwise applied’ in Petitioner’s ‘particular technology space’” had not developed strong settled expectations). Indeed, PO admits that no VoiceBox product ever embodied the technology of the ’249 patent, any of the other patents subject to pending IPR challenges by Petitioner, or the technology of any of the patents asserted in the 2019 district court litigation. EX1022 at 5 (“VBA is currently unaware of any publicly available products or services of VBA, VoiceBox Technologies, Inc., VoiceBox Technologies, Corp. or licensees of the asserted patents that practice or embody any claim of the asserted patents”); *see also* EX1023 at 10 (“VoiceBox is currently unaware of any products, technologies, or services of VoiceBox or its licensees that practice or embody any claim of the patents-in-suit”).

In addition, even patents that have been in force for many years may nevertheless be appropriate for Board review when “the Office materially erred during prosecution of the challenged patent.” *Xencor*, IPR2025-00604, Paper 12 at 2-3 (referring IPR challenging patent that had been “in force for approximately nine years” due to material error by Office); *Anthony*, IPR2025-00636, Paper 9 at 2 (referring IPRs challenging patents in force for “approximately eighteen and seventeen years”). This is the case here because, as explained above, “the Office erred in a manner material to the patentability of the challenged [claims]...” “by

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overlooking the teachings of” Fujimoto and “and it is an appropriate use of Office resources to review the potential error.” *Anthony*, IPR2025-00636, Paper 9 at 2.

The ’249 patent is also related to the ’699 patent challenged by the Petitioner in IPR2025-01379. PO Br. at 2. The ’699 patent is only five years old. As a result, that patent has not developed strong settled expectations, and “it is an efficient use of Board resources to address the related [’249] patent,” even though the ’249 patent issued just over six years ago. *Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13 at 2-3 (June 26, 2025) (when “Patent Owner has not developed strong settled expectations that favor discretionary denial as to [a] first patent, ... it is an efficient use of Board resources to address the related patent” that issued more than six years ago); *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 at 3-4 (July 16, 2025) (same).

PO argues that the ’249 patent’s settled expectations are “reinforc[ed]” because “Amazon was on notice of the ’249 patent well before its issue date of May 21, 2019,” but it provides no evidence supporting this false claim. PO Br. at 8, 19. Instead, PO asserts that an ancestor of the ’249 patent was part of a “slide presentation” to Amazon in 2011, 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 by the Examiner during prosecution in a number of “Amazon-owned patent[s]” between 2015 and 2020. PO Br. at 3-4, 8-9. But,

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according to PO's own allegations, most of these events occurred before the application for the '249 patent issued on May 21, 2019, and do not establish Amazon's knowledge of the '249 patent before it issued, much less create settled expectations for it. PO further argues that Petitioner "was also put on notice of its potential infringement of the '249 patent through assertion of [related patents] in the 2019 district court litigation." PO Br. at 9. However, the 2019 litigation could not have put Petitioner on notice of the '249 patent, because PO elected not to assert the '249 patent in the litigation.

PO cites decisions to try to show that knowledge of a challenged patent's parents creates settled expectations (PO Br. at 9-10), but the decisions simply confirm that settled expectations may exist for challenged patents that have been in force for seven years or more. *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); *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). PO also contends that *Dabico* 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.

**B. 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 that purportedly occurred in 2011 and 2017—before the '249 patent issued. PO Br. at 2-5. PO also harps on the previous litigation between the parties, which never involved the '249 patent. *Id.* at 5-7. The '249 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, 12. While PO notes that some IPRs filed against unrelated patents were denied institution, one IPR challenging a patent *related* to the '249 patent resulted in the Board holding *all* claims unpatentable. *See Amazon.com, Inc. v. VB Assets, LLC*, IPR2020-01346, Paper 25 (Feb. 1, 2022). The other IPR on a related patent led PO to disclaim several of the challenged claims. *See Amazon.com, Inc. v. VB Assets, LLC*, IPR2020-01367, Paper 27 at 2 (Mar. 7, 2022). The Board subsequently found the remaining claims to be not unpatentable based on claim limitations not recited in any of the claims of the '249 patent challenged here. *See id.* at 12-20 (discussing claim limitation of utterance that “includes one or more words that have different meanings in different contexts”).

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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 4-7. 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, years 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.

IPR2025-01365

Opposition to Request for Discretionary Denial

Dated: November 12, 2025

Respectfully submitted,

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**CERTIFICATION OF SERVICE**

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on November 12, 2025, I caused a true and correct copy of the foregoing PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL and related Exhibits 1021-1024 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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