

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: IPR2025-01379

U.S. Patent No. 10,755,699

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. ANALYSIS.....	3
A. Absence of Settled Expectations Favors Institution	3
B. FWD Before Trial Favors Institution.....	6
C. The <i>Fintiv</i> Factors Weigh Against Discretionary Denial.....	8
1. Factor 1: Likelihood of a stay is neutral or favors institution	8
2. Factor 2: FWD before trials favors institution.....	10
3. Factor 3: Litigation in early stages favors institution	10
4. Factor 4: Lack of overlapping issues in IPR and litigation favors institution.....	13
5. Factor 5: Petitioner is the defendant in the litigation, favoring institution	15
6. Factor 6: Other relevant considerations favor institution	15
D. PO’s Mischaracterizations Do Not Justify Discretionary Denial	18
III. CONCLUSION.....	20

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Advanced Micro Devices, Inc. v. XtreamEdge, Inc.</i> , IPR2025-00223, Paper 9 (June 12, 2025).....	7
<i>Amazon.com Servs. LLC v. NL Giken, Inc.</i> , IPR2025-00250, Paper 14 (May 16, 2025).....	7
<i>Amazon.com, Inc. v. Audio Pod IP, LLC</i> , IPR2025-00777, Paper 15 (Aug. 14, 2025)	5
<i>Amazon.com, Inc. v. KAIFI LLC</i> , IPR2025-00626, Paper 16 (July 29, 2025)	8
<i>Amazon.com, Inc. v. VB Assets, LLC</i> , IPR2020-01346, Paper 25 (Feb. 1, 2022)	19
<i>Amazon.com, Inc. v. VB Assets, LLC</i> , IPR2020-01367, Paper 27 (Mar. 7, 2022)	19
<i>Anthony, Inc. v. ControlTec, LLC</i> , IPR2025-00636, Paper 6 (June 10, 2025).....	14
<i>Anthony, Inc. v. ControlTec, LLC</i> , IPR2025-00636, Paper 9 (July 16, 2025)	1, 14, 16, 17
<i>Apple Inc. v. Apex Beam Techs. LLC</i> , IPR2025-00910, Paper 10 (Sept. 3, 2025).....	6
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (Mar. 20, 2020)	11
<i>Apple, Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (May 13, 2020).....	2, 8, 13, 15
<i>BOE Tech. Grp. Co. v. Optronix Scis. LLC</i> , IPR2024-01130, Paper 16 (Jan. 27, 2025).....	15
<i>Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00434, Paper 11 (June 26, 2025).....	3, 6

TABLE OF CONTENTS

(Continued)

	Page
<i>Chemours Co. FC, LLC v. Daikin Indus., Ltd.</i> , No. 1:17-cv-01612, Dkt. Entry for May 31, 2018 (D. Del.)	9
<i>Chemours Co. FC, LLC v. Daikin Indus., Ltd.</i> , No. 1:17-cv-01612, Dkt. Entry for Dec. 21, 2018 (D. Del.)	10
<i>Dabico Airport Sols. Inc. v. AXA Power ApS</i> , IPR2025-00408, Paper 21 (June 18, 2025).....	5
<i>DataDome S.A. v. Arkose Labs Holdings, Inc.</i> , IPR2025-00694, Paper 14 (Aug. 14, 2025)	14
<i>Freightcar Am., Inc. v. Nat’l Steel Car Ltd.</i> , IPR2025-01046, Paper 20 (Oct. 10, 2025)	7
<i>Full-Metal-Power B.V. v. InFocus Downhole Sols. USA LLC</i> , IPR2025-00391, Paper 14 (June 25, 2025).....	14
<i>Google LLC v. BrodTi Inc.</i> , IPR2025-00472, Paper 19 (June 25, 2025).....	3
<i>Google LLC v. Withrow Networks Inc.</i> , IPR2025-00775, Paper 10 (Aug. 14, 2025)	3, 4
<i>HS Hyosung Advanced Materials Corp. v. Kolon Indus., Inc.</i> , IPR2025-00662, Paper 12 (Aug. 14, 2025)	14
<i>Intel Corp. v. Advanced Cluster Sys., Inc.</i> , IPR2025-00794, Paper 13 (Aug. 14, 2025)	7
<i>Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH</i> , IPR2025-00318, Paper 9 (June 12, 2025).....	1, 16, 17
<i>MQ Gaming, LLC v. Lego Sys., Inc.</i> , No. 1:19-cv-00905, Dkt. 145 (D. Del. Feb. 18, 2021)	8
<i>MQ Gaming, LLC v. Lego Sys., Inc.</i> , No. 1:19-cv-00905, Minute Entry (D. Del. Mar. 17, 2021)	9

TABLE OF CONTENTS (Continued)

	Page
<i>Murata Mfg. Co., Ltd. v. Georgia Tech. Rsch. Corp.</i> , IPR025-00384, Paper 13 (July 29, 2025)	5
<i>Nuance Commc'ns, Inc. v. MModal, LLC</i> , No. 1:17-cv-01484, Dkt. 226 (D. Del. Apr. 11, 2019)	9
<i>NVIDIA Corp. v. Invensas Corp.</i> , IPR2020-00603, Paper 11 (Sept. 3, 2020)	15
<i>NVIDIA Corp. v. Neural AI, LLC</i> , IPR2025-00606, Paper 18 at 2-3 (July 31, 2025)	5
<i>OnePlus Tech. (Shenzhen) Co., Ltd. v. Pantech Corp.</i> , IPR2025-00637, Paper 17 (Aug. 14, 2025)	7
<i>Phison Elecs. Corp. v. Vervain, LLC</i> , PGR2025-00010, Paper 14 (July 10, 2025)	14
<i>Rein Tech, Inc. v. Mueller Sys., LLC</i> , No. 1:18-cv-01683, Dkt. 24 (D. Del. June 3, 2019)	10
<i>Rein Tech, Inc. v. Mueller Sys., LLC</i> , No. 1:18-cv-01683, Dkt. Entry for Mar. 12, 2020 (D. Del.)	10
<i>Samsung Elecs. Co., Ltd. v. Dynamics Inc.</i> , IPR2020-00504, Paper 16 (Oct. 13, 2020)	13
<i>Samsung Elecs. Co., Ltd. v. Mullen Indus. LLC</i> , IPR2024-01472, Paper 9 (Mar. 31, 2025)	11
<i>Samsung Elecs. Co., Ltd. v. SiOnyx, LLC</i> , IPR2024-01431, Paper 21 (Apr. 10, 2025)	13
<i>Samsung Elecs. Co., Ltd., v. Wilus Inst. of Standards and Tech. Inc.</i> , IPR2025-01069, Paper 11 (Oct. 10, 2025)	4
<i>Sand Revolution II, LLC v. Cont'l Intermodal Grp. – Trucking LLC</i> , IPR2019-01393, Paper 24 (June 16, 2020)	8

TABLE OF CONTENTS (Continued)

	Page
<i>SAP Am., Inc. v. Cyandia, Inc.</i> , IPR2024-01433, Paper 13 (Apr. 7, 2025).....	10
<i>Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.</i> , IPR2024-01296, Paper 9 (Feb. 25, 2025).....	15
<i>Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.</i> , IPR2025-00354, Paper 11 (June 12, 2025).....	7
<i>Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.</i> , IPR2025-00321, Paper 10 (June 18, 2025).....	11
<i>Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.</i> , IPR2025-00847, Paper 11 (Sept. 3, 2025).....	17
<i>TankLogix, LLC v. SitePro, Inc.</i> , IPR2025-00651, Paper 10 (July 31, 2025)	3, 6
<i>Waters Corp. v. Agilent Techs., Inc.</i> , No. 1:18-cv-01450, Dkt. 95 (D. Del. Aug. 6, 2019).....	9
<i>Xencor, Inc. v. Merus N.V.</i> , IPR2025-00604, Paper 12 (July 17, 2025)	16
 STATUTES AND RULES	
35 U.S.C. § 315(e)(2).....	14
 OTHER AUTHORITIES	
“Interim Processes for PTAB Workload Management” (Mar. 26, 2025)	15, 16

EXHIBIT LIST (37 C.F.R. § 42.63(e))

Exhibit	Description
1001	U.S. Patent No. 10,755,699 (“the ’699 patent”)
1002	Declaration of Padhraic Smyth, Ph.D.
1003	Prosecution File History for the ’699 patent
1004	U.S. Patent App. Pub. No. 2004/0193420 (“Kennewick”)
1005	U.S. Patent No. 6,757,362 (“Cooper”)
1006	Japanese Patent App. Pub. No. 2004/334591 (“Matsuda”)
1007	Certified English Translation of Japanese Patent App. Pub. No. 2004/334591 (“Matsuda”)
1008	Excerpt of The American Heritage Dictionary of the English Language, 4th Ed. (2000), Houghton Mifflin Co., ISBN 0-395-82517-2
1009	Asthana, A. & Krzyzanowski, P., “A Small Domain Communications System for Personalized Shopping Assistance,” Proceedings of 1994 International Conference on Personal Wireless Communications, IEEE Press 199-203 (Aug. 1994) (“Asthana”)
1010	Lucente, M., “Conversational interfaces for e-commerce applications,” Communications of the ACM 43(9) 59-61 (Sept. 2000) (“Lucente”)
1011	Huang, X. 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
1014	Curriculum Vitae of Padhraic Smyth, Ph.D.
1015	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

Exhibit	Description
1016	Docket Navigator statistics regarding Judge Noreika decisions on motions to stay pending IPR
1017	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 https://www.judiciary.senate.gov/imo/media/doc/2025-0521_qfrresponses_squires.pdf (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 ensuring that patents are "born strong." EX1017 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 '699 patent challenged here is a weak patent that was only issued because of examiner error. The Examiner allowed the '699 patent after determining that the prior art did not disclose "long-term knowledge...accumulated based on one or more natural language utterances received prior to the predetermined time period." EX1003 at 122, 125-126. But the Petition shows that Kennewick with Matsuda discloses this limitation. It is "an appropriate use of Office resources" to review this examiner error. *Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (June 12, 2025); *Anthony, Inc. v. ControlTec, LLC*, IPR2025-00636, Paper 9 at 2-3 (July 16, 2025).

Institution is also warranted in view of PO's gamesmanship. 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

Opposition to Request for Discretionary Denial

priority, PO drafted the claims of the challenged '699 patent in a way that it could try to accuse Alexa of infringement. The '699 patent then issued in 2020, 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 '699 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 factors also weigh against denial. The challenged patent issued just five 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 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 claims that are not at issue in the district court.

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 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 '699 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 '699 patent—warrant institution.

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 support institution. *See, e.g., TankLogix, LLC v. SitePro, Inc.*, IPR2025-00651, Paper 10 at 2-3 (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 Institution

The challenged patent issued only five years ago—on August 25, 2020. 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 Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11 at 2-3 (June 26, 2025) (challenged patents issued in 2020 and 2019

Opposition to Request for Discretionary Denial

“have not been in force for a significant period of time”); *Samsung Elecs. Co., Ltd., v. Wilus Inst. of Standards and Tech. Inc.*, IPR2025-01069, Paper 11 at 3 (Oct. 10, 2025) (challenged patents issued in 2020 have “not been in force for a significant period of time” and “Patent Owner has not developed strong settled expectations that favor discretionary denial”); *Google*, IPR2025-00775, Paper 10 at 2 (same). To the contrary, Petitioner presents an “early challenge” that serves to promote “robust, predictable patent rights,” which “weigh[s] against discretionary denial.” *Google*, IPR2025-00775, Paper 10 at 2.

PO argues that strong settled expectations exist because “Amazon was on notice of the ’699 patent well before its issue date of August 25, 2020,” but it provides no evidence supporting this false claim. PO Br. at 16. Instead, PO asserts that its predecessor VoiceBox purportedly informed Amazon of “a publicly available application for an ancestor patent” in 2011, “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 of “six Amazon-owned patents” between 2015 and 2020. *Id.* at 18. But, according to PO’s own allegations, these events occurred before the ’699 patent issued on August 25, 2020, and the alleged VoiceBox meetings occurred *before the application for the ’699 patent was even filed* on May 20, 2019. *Id.* These allegations do not establish Amazon’s knowledge of the ’699

Opposition to Request for Discretionary Denial

patent before it issued, much less create settled expectations for the '699 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 may exist for challenged patents that had been in force for more than six years. *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); *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); *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (July 31, 2025) ("Petitioner's failure to seek early review of" patent "originally issued in 2015" "favors denial"). In contrast, Petitioner sought "early review" here by challenging a patent that is only five years old. *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).

PO argues that Petitioner "was also put on notice of its potential infringement of the '699 patent family through assertion of [related patents] in the 2019 district

Opposition to Request for Discretionary Denial

court litigation.” PO Br. at 19. But PO filed that suit *before* its ’699 patent issued in 2020, and thus it fails to establish that Petitioner had earlier knowledge of the yet-to-be-issued ’699 patent, much less create strong settled expectations.

PO cannot establish strong settled expectations for the ’699 patent challenged in this IPR, so as a last resort, it argues that discretionary denial is warranted because two *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 patent—no settled expectations exist for the ’699 patent. *Id.* And even where a petitioner challenged patents more than six years old in other pending IPRs, the Director has denied discretionary denial requests for IPRs challenging patents less than six years old. *See, e.g., TankLogix*, IPR2025-00651, Paper 10 at 2-3 (referring IPRs challenging patents less than six years old, even though challenged patents in other pending IPRs filed by same petitioner were more than six years old); *Cambridge*, IPR2025-00434, Paper 11 at 2-3 (same).

B. FWD Before Trial Favors Institution

The FWD will issue before trial in the district court case. The FWD in this IPR is expected by February 13, 2027. *See* PO Br. at 9. 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-

Opposition to Request for Discretionary Denial

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 to merits panel 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 9. The decisions PO cites *support Petitioner* because the Director determined that the anticipated issuance of FWDs before trial "counsel[ed] against discretionary denial." *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 the FWDs in those IPRs would issue *after* trial. *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 Tuozyu 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).¹

C. The *Fintiv* Factors Weigh Against Discretionary Denial

As explained below, the *Fintiv* factors, on balance, weigh in favor institution.

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. EX1016. In cases involving multiple 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,

¹ 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 ’699 patent challenged in this IPR nor either of the other two patents challenged in Petitioner’s other pending IPRs were at issue in the earlier case.

Opposition to Request for Discretionary Denial

Dkt. 145 at 1 (D. Del. Feb. 18, 2021); *see also id.*, Minute Entry (D. Del. Mar. 17, 2021) (granting 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 of these IPRs should 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 move to stay immediately upon institution of its IPRs.

PO also argues that the likelihood of a stay is low because an institution decision for this IPR is expected one month before the *Markman* hearing in the litigation. PO Br. at 8. But Judge Noreika routinely grants stays just before the *Markman* hearing. *See Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, No. 1:17-cv-

Opposition to Request for Discretionary Denial

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 some patents *related to* the patents Petitioner now challenges in IPRs were not held invalid in prior proceedings. 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 institution

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 institution.

3. Factor 3: Litigation in early stages favors institution

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 15-16. This early phase of the litigation weighs against discretionary denial. *See, e.g., SAP Am., Inc. v. Cyandia,*

Opposition to Request for Discretionary Denial

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. Stratasy, 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 11. But Petitioner diligently prepared and timely filed this Petition. Petitioner’s diligence is highlighted by the fact that it filed this Petition without the benefit of PO’s amended infringement contentions, approximately four months after serving its initial invalidity contentions, and 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 11-12. 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 in the '699 patent claims is indefinite. *Id.* But Petitioner adopts PO's plain meaning construction for the one term Petitioner proposes is indefinite in the litigation. *See* EX2008. That term is "contextual signifiers," recited only in dependent claims 4 and 15. Notwithstanding the indefiniteness of this claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the requirements of claims 4 and 15 because both recite "contextual signifiers and/or grammatical rules," and the asserted art discloses the claimed "grammatical rules." Pet. at 43-44. And consistent with its proposal in the litigation that the preambles of the two independent claims are 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.²

² PO also argues that claim terms from related patents were construed in the previous litigation and that the pending 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.

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

This Petition challenges all 22 claims of the '699 patent, including two claims that are not at issue in the district court case, which weighs in favor of institution. *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.* 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 13-14. 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.* Rather, each decision PO cites denied institution because the challenged patent was

Opposition to Request for Discretionary Denial

more than six years old or trial would begin before the final written decision. *See DataDome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00694, Paper 14 at 2-3 (Aug. 14, 2025) (challenged patents were 10 and 17 years old); *HS Hyosung Advanced Materials Corp. v. Kolon Indus., Inc.*, IPR2025-00662, Paper 12 at 2-3 (Aug. 14, 2025) (challenged patents have “been in force for more than seven, six, and nine years”); *Full-Metal-Power B.V. v. InFocus Downhole Sols. USA LLC*, IPR2025-00391, Paper 14 at 2 (June 25, 2025) (“it is unlikely that a final written decision in this proceeding will issue before district court trial occurs”); *Phison Elecs. Corp. v. Vervain, LLC*, PGR2025-00010, Paper 14 at 3 (July 10, 2025) (“significantly earlier trial date” than FWD date).

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 favors institution. *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 the district court case and this proceeding, and we are likely to reach the merits at or around the same time as the district court”). 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. Optronix 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

Opposition to Request for Discretionary Denial

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 ’699 patent was “material error during patent examination,” and “it is an appropriate use of Office resources to review the potential error.” *Microsoft*, IPR2025-00318, Paper 9 at 3; *see also Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12 at 2-3 (July 17, 2025); *Anthony*, IPR2025-00636, Paper 9 at 2. The Examiner allowed the patent after determining that the prior art did not disclose the claimed element “long-term knowledge...accumulated based on one or more natural language utterances received prior to the predetermined time period.” EX1003 at 122, 125-126. But the Petition shows that Kennewick with Matsuda discloses this limitation. The Petition explains that Kennewick discloses a user profile that stores data based on received utterances from prior conversations. Pet. at 27-28. Matsuda further discloses accumulating and storing data from multiple conversations in “nonvolatile memory,” including information about utterances from conversations “prior to the predetermined time period.” *Id.* at 29-31. Petitioner’s expert explained that this disclosure shows that Matsuda accumulates “long-term knowledge ... accumulated based on one or more natural language utterances received prior to the predetermined time period.” Pet. at 29-31; EX1002,

¶¶124-128. He further explained that a POSITA would have been motivated to incorporate this disclosure of accumulating long-term knowledge as part of Kennewick’s user profile to achieve a more natural conversational environment. *Id.* The Examiner erred by failing to consider this ground 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 Anthony*, IPR2025-00636, Paper 9 at 2; *Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (Sept. 3, 2025). Institution here furthers the Director’s goal of providing an “important avenue of redress” for companies, like Amazon, sued on weak patents, like the ’699 patent. *See EX1017* at 2, 17.

PO argues that Petitioner’s Kennewick-Matsuda-Cooper invalidity ground is “based on a piecemeal approach to the claims” because it argues that the Petition relies on Kennewick and Matsuda to disclose one claim element reciting “short-term knowledge” and then Kennewick and Cooper to disclose another claim element reciting “short-term knowledge.” PO Br. at 16-17. PO is wrong, because the Petition consistently relies on the combination of Kennewick, Matsuda, *and* Cooper to disclose both claim elements. The Petition explains that Kennewick discloses accumulating short-term knowledge, e.g., “dialog history” identifying what the user has said during the conversation. Pet. at 21-22, 25. Matsuda also discloses accumulating information about the conversation, e.g., words the user used to refer

Opposition to Request for Discretionary Denial

to certain subjects, “during a predetermined time period,” and the Petition explains that a POSITA would have been motivated to “incorporate Matsuda’s accumulated information” during this predetermined time into Kennewick’s short-term knowledge. *Id.* at 25-26. The Petition further discusses how a POSITA would have been motivated to combine Kennewick and Matsuda with Cooper, by modifying Kennewick to analyze “the words of the dialog to identify the manner in which the user is speaking” as taught in Cooper, where the words are from Kennewick’s short-term knowledge, e.g., dialog history, which, as modified based on Matsuda, was accumulated “during a predetermined time period.” Pet. at 32-36. Thus, the Petition explains how a POSITA would have been motivated to modify Kennewick’s short-term knowledge to include knowledge accumulated during a predetermined time as taught by Matsuda, and to use the short-term knowledge to identify the manner in which the user speaks as taught by Cooper.

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 that purportedly occurred in 2011 and 2017—before the ’699 patent application was even filed. PO Br. at 2-5. PO also harps on the previous litigation

Opposition to Request for Discretionary Denial

between the parties, which also began before the '699 patent issued and never involved the '699 patent. *Id.* at 5-7. The '699 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 PO notes that some IPRs filed against unrelated patents were denied institution, one IPR challenging a patent *related* to the '699 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 '699 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”).

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.

Opposition to Request for Discretionary Denial

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.

Dated: November 13, 2025

Respectfully submitted,

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/J. David Hadden/

J. David Hadden

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on November 13, 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 1016 and 1017 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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