

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM SERVICES LLC
Petitioner,

v.

SMART SPEAKER LLC
Patent Owner.

Patent No. 12,316,706

Inter Partes Review No. IPR2026-00146

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

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I. INTRODUCTION

The Petition should be referred for merits consideration for the following reasons. *First*, there are no settled expectations because the '706 patent and the other patents-in-suit issued less than four and a half years ago and some just a few months ago:

Patent No.	Earliest Claimed Priority Date	Filing Date	Issue Date
11,128,710	1/9/2012	7/23/2017	9/21/2021
11,190,590	1/9/2012	5/30/2018	11/30/2021
12,010,174	1/9/2012	8/23/2021	6/11/2024
12,316,706	1/9/2012	5/28/2024	5/27/2025
12,401,720	1/9/2012	5/28/2025	8/26/2025
12,401,721	1/9/2012	5/28/2025	8/26/2025

Second, a series of Examiner errors pollute this and subsequent patents.

Third, there are compelling economic and public interests that demand review of the challenged claims: an attack on America's billion-dollar Internet of Things (IoT) economy. The applicant filed a kitchen-sink style provisional application on January 9, 2012, and filed several applications that were ultimately abandoned after prolonged prosecution. (EX1068, EX1054.) Five and a half years later, it filed the '710 patent application (the earliest issued patent in the family) in 2017. The patent issued in 2021, almost a decade after the earliest provisional was filed. The applicant then filed the '706 application in 2024, which issued in 2025,

over 13 years after the earliest provisional. In the meantime, IoT technology matured as U.S. companies, such as Amazon, spent millions on R&D to develop and patent technologies (including *Williams*, a primary reference in this IPR), while the applicant remained on the sidelines, tailoring its claims to read on those innovations without developing any products.

Fourth, a review will promote efficiency as it will resolve current and potential future disputes that may stem from numerous pending applications.

Fifth, the *Fintiv* factors strongly weigh against discretionary denial. The scheduled trial date is *after* the anticipated Final Written Decision deadline. Time-to-trial statistics and Judge Gilstrap's caseload suggest that the trial date will likely be delayed even further. The parallel litigation is in its early stages: claim construction briefing has not yet begun, no depositions have been taken, and the district court has not made any substantive rulings.

As discussed below, each of these reasons compels a merits consideration.

II. THIS IPR IS AN APPROPRIATE USE OF OFFICE RESOURCES

A. Patent Owner Has No Settled Expectations

The '706 patent had been in force for less than half a year before Amazon filed the petition for *inter partes* review. The Director has repeatedly found that patent owners do not have settled expectations for patents issued less than six years prior to a petition. *See e.g., Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR-2025-

00913, Paper 13, 2 (finding “Patent Owner has not developed strong settled expectations” as patents issued in 2022, 2023, and 2025 “have not been in force for a significant period of time”); *MIM Software Inc. v. Progenics Pharms., Inc.*, IPR2025-00630, Paper 13, 2. The Director has also found patents do not have settled expectations if the patents have not been commercialized, asserted, marketed, or licensed. *See e.g., Home Depot USA Inc., v. H2 Intellect LLC*, IPR2025-00480, Paper 11, 2–3. No assignee of the ’706 patent has ever claimed to have made, commercialized, asserted, marketed, licensed, or otherwise used the alleged invention. (EX1080, 13–15.) The Director has likewise emphasized that “early challenges favor robust, predictable patent rights and weigh against discretionary denial.” *MIM Software Inc. v. Progenics Pharms., Inc.*, IPR2025-00630, Paper 13, 2. Amazon’s challenge is early; it filed its Petition less than half a year after the patent issued and about four months from suit.

Patent Owner argues that it has settled expectations based on the patent’s 2012 priority date. (Br., 16.) Patent Owner cites *no* authority for this position, nor could it. First, there is no statutory basis to petition for *inter partes* review of a patent application. 35 U.S.C. § 311(a). Patent Owner simply cannot have settled expectations in an unissued application. Additionally, Patent Owner created its own delay by waiting over five years to file the ’710 application (the earliest issued

patent in the family) and eight more years to file the '706 application. Patent Owner cannot claim settled expectations now.

Patent Owner's assertion that Amazon should have filed its Petition immediately after the July 23, 2024, pre-suit letter is contradicted by the Board's settled practice. (Br., 12–13.) First, the '706 patent was not listed in the July 23, 2024 letter. Further, Patent Owner cites *no* authority. On the contrary, the Board “recognizes that it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted . . . [and i]f the evidence shows that the petitioner filed the petition expeditiously, . . . , this fact . . . weigh[s] against . . . deny[ing] institution.” *Apple v. Fintiv*, IPR2020-00019, Paper 11, 11. Here, Petitioner acted expeditiously by filing the Petition barely two months after Patent Owner's disclosure of asserted claims in its infringement contentions and only four months after the Patent Owner filed suit.

Further, the Petition relies on Amazon's own *Williams* patent, which covers technology Amazon invented, publicly disclosed, and patented. Petitioner has no reason to anticipate being sued when it practices what itself patented—years later—by non-practicing entities tailoring its claims to existing products.

B. This IPR Will Allow the Office to Correct Material Errors During Prosecution

This Petition presents an opportunity to correct examiner errors. The Examiner committed material errors: (1) using deficient search strategies, and (2) relying on deficient examination of the parent '710 and '174 patents.

First, the Examiner misunderstood the actual claim scope, and his search strategy did not match it. The Examiner focused on the term “actuator,” without recognizing that the specification defined “actuator” to encompass commonplace devices not ordinarily described as actuators. (Paper 2, 2.) Not once did he search for “speaker,” “display,” or “buzzer”—consistent with the specification’s expansive definition of “actuator.” (EX1003, 24-30). Nor did he search for “home automation,” the stated purpose in the specification. (EX1001, 139:34.) Had he searched so¹, he would have found the primary references as the *first* results on Google Patents. (EX1075; EX1076.) The Examiner’s failure to understand and search for the actual claim scope supports instituting review. (*See* EX1077-79.)

Second, the Examiner relied on deficient prior examination of the parents. He *never* issued *any* prior art–based rejections. The sole Office Action raised a

¹ Example search strings: (“speech recognition” + “server” + “home automation” “speaker”); (“speech recognition” + “appliance” + “server” + “buzzer”).

double-patenting rejection over the parent '710 and '174 patents. However, the '710 parent application was allowed despite a previous Board decision finding substantially identical claims obvious. (EX1004, 389–421.) The applicant thereafter offered only minor amendments. (EX1004, 122–23, 345–46.) But instead of targeting the new concept, the '710 Examiner used *identical* patent classification search strings that he used *before* the Board decision mostly related to *transportation and vehicles*. (See, e.g., EX1004, 25–74, 675–676.) This was a critical error. The record also reflects a few cursory queries on Google Patents that were not tailored to the new limitations. (EX1004, 24.)

The '710 Examiner also misunderstood the actual claim scope, just like the '706 Examiner, focusing on the term “actuator.” (EX1004, 24-28.) Moreover, the applicant’s last amendment in '710 merely incorporated subject matter of already rejected dependent claim 2 into the independent claim without presenting new arguments. (EX1004, 123-130, 224-228, 346.) The '710 Examiner’s unexplained reversal was therefore arbitrary and unreasonable based on the record. (EX1004, 13–14.)

After the '710 application, both the '174 and '706 applications sailed through without any prior art-based office actions. The allowance of the '706 patent is thus due to accumulation of material errors across multiple patents.

C. There Are Compelling Economic and Public Interest Reasons to Examine the Challenged Claims

The '706 patent is directed to server-based control of devices, *i.e.*, the core functionality of widely deployed IoT systems. The breadth of the challenged claims affects a significant part of the U.S. economy, implicating millions of jobs and billions in economic activity. This IPR is an efficient use of Office resources to prevent abuse and review claims implicating a critical segment of our economy.

Patent Owner is a non-practicing entity formed less than one year ago for litigation. (EX1051; EX1052; EX1053; EX1003.) The '706 patent was initially assigned to May Patents Ltd. ("May Patents"), a foreign entity operated by the named inventors. *Id.* One of those inventors doubled as the patent agent prosecuting the patent. (EX1003; EX1052; EX1053.)

The applicant dragged its feet prosecuting the '706 application. In the 13 years between the filing of the earliest provisional and issuance, American companies invested over \$4 billion in IoT research and development. (EX1054; EX1055; EX1056.) Amazon alone invested hundreds of millions. (EX1057; EX1058.) By the end of 2017, venture capital funds invested nearly \$5 billion in IoT startups. (EX1059.) The federal government even invested \$200 million in smart and connected devices. (EX1060; EX1061.) By July 2017, "[a]lmost any device you use in the home [] has a connected smart version from light bulbs and

thermostats to tea kettles, fridges, and ovens.” (EX1062.) IoT technology extends to wearables, logistics, and fleet management. (*Id.*) The industry is estimated to generate \$2.8-\$6.3 trillion in economic value globally in 2025, and is expected to grow to \$5.5-\$12.6 trillion by 2030. (EX1063.) One billion smart devices are projected to be shipped in 2028. (EX1034.)

Because Patent Owner is asserting its patent against IoT consumer devices, the ’706 patent’s patentability affects a significant part of the U.S. consumer-electronics sector, implicating an estimated \$6.3 trillion global IoT industry. (EX1063.) Moreover, Patent Owner has asserted the ’706 patent and the above related patents against Petitioner Amazon Services, LLC. Petitioner is an American company responsible for \$1.8 trillion in investments in the U.S. economy since 2010 and supports almost five million jobs across the country. (EX1064.) Petitioner actively develops technology in this space and patents its inventions. (*E.g.*, EX1006.) Patent Owner has never produced a product, yet it seeks to stifle innovation and encumber the consumer-electronics industry in America. As the Petition demonstrates, the challenged claims are unpatentable: they cover well-known technology readily disclosed in prior patents and publications and are obvious variations from Petitioner’s own disclosed invention.

D. This IPR Will Promote Efficiency And Prevent Serial Litigation

Patent Owner continues to prosecute continuation applications—fourteen pending when suit was filed and six filed thereafter (EX1068)—and may file more. Patent Owner can thus pursue patentably indistinct claims and later assert them against Petitioner. These IPRs will efficiently resolve future disputes and prevent serial litigation. If the claims are held unpatentable, Patent Owner would be estopped from later obtaining patentably indistinct claims. 37 C.F.R. §42.73(d)(3)(i); *SoftView LLC v. Apple Inc.*, 108 F.4th 1366 (Fed. Cir. 2024).

E. 35 U.S.C. § 325(d) Does Not Apply

It is undisputed that none of Petitioner’s art or arguments were previously presented or considered by the Office. (Br., 8-10.) The first part of the *Advanced Bionics* framework is thus not met. *Apple Inc. v. Seven Networks, LLC*, IPR2020-00285, Paper 10, 31. (PTAB Jul. 28, 2020).

Patent Owner nevertheless contends the Petition “relies on the same types of ideas,” but cannot pinpoint any concrete similarity other than they “fit within that same technical space.” (Br., 8–9.) That is true for all analogous art. *See PLR Worldwide Sales Ltd. v. Flip Phone Games, Inc.*, IPR2024-00171, Paper 9, 6 (PTAB May 10, 2024) (“It is no surprise that Petitioner would rely on art” that discloses the subject matter recited in the claims).

III. THE *FINTIV* FACTORS WEIGH STRONGLY AGAINST DENIAL

The scheduled trial date is *after* the anticipated Final Written Decision deadline, and the trial date will likely be delayed even further. The parallel litigation is in its early stages, *Markman* is not till end of the year, and there have been no substantive rulings. Importantly, the merits are strong; Patent Owner does not (and cannot) identify *any* substantive deficiencies in the Petition or declaration.

A. Factor 1: Likelihood of Post-Institution Stay Is Neutral

The Board has previously refused to speculate whether Judge Gilstrap will enter a stay after institution. *See SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13, 9 (PTAB April 7, 2025); *BOE Tech. Grp. Co., Ltd. v. Optronic Scis., LLC*, IPR2024-01133, Paper 16, 9 (PTAB January 27, 2025); *Hanwha Sols. Corp., v. Maxeon Solar Pte. Ltd.*, IPR2024-01203, Paper 17, 12–13 (PTAB February 26, 2025). Accordingly, this factor is at best neutral.

Patent Owner argues that a stay is “unlikely.” (Br., 10–11.) But stays are frequently granted if the court has not yet held a *Markman* hearing. *See, e.g., Broadphone LLC v. Samsung Elecs. Co.*, No. 2:23- CV-00001, 2024 WL 3524022, at *2–3 (E.D. Tex. July 24, 2024); *Foras Technologies Ltd. v. Aptiv PLC*, No. 2:23-CV-00314, 2024 WL 5348631, at *2 (E.D. Tex. July 25, 2024). The litigation is in its early stages, and the *Markman* is scheduled well after the Board’s institution deadline of May 28, 2026. Although it claims that a stay motion would

not be resolved before the *Markman*, Patent Owner provides no support. (Br., 11–12.) Further, Judge Gilstrap resolves motions to stay pending *inter partes* review motions quickly, typically less than 40 days. (EX1065.) Thus, the court is likely to consider a motion to stay pre-*Markman* and decide it expeditiously.

Patent Owner further claims that a stay is unlikely because Petitioner has not yet filed petitions for *inter partes* review of U.S. Patent Nos. 12,401,720 and 12,401,721. (Br., 11; IPR2026-00276; IPR2026-00280.) Patent Owner added those patents in October 2025, two months after they issued. Amazon diligently prepared petitions. As of the date of this opposition, Amazon has petitioned for review of the ’721 patent and will soon file a petition for review of the ’720 patent.

B. Factor 2: Weighs Against Denial - District Court Trial Will Occur *After* the FWD

Patent Owner asserts that “this factor strongly weighs in favor of discretionary denial.” (Br., 13.) That is incorrect. Patent Owner admits that trial is set for June 7, 2027, *after* the projected Final Written Decision due date in May 2027. (*Id.*, 14.) Thus, this factor weighs strongly against denial.

The trial date, moreover, is also likely to be delayed, even further after the projected Final Written Decision date. As of September 2025, the median time-to-trial in the Eastern District of Texas is 24.5 months. (EX1066, 35.) Trial in the district court litigation would likely be delayed to August 2027, almost *three*

months after the Final Written Decision deadline. Judge Gilstrap’s increasing caseload also shows that trial will likely be delayed. Judge Gilstrap has been assigned over 1,015 patent cases in 2025, more than half of which remain open. (EX1067.) Trial conflicts often cause delays in his heavy caseload. *See, e.g., Headwater Rsch. LLC v. AT&T Inc.*, No. 2:23-cv-00397 (E.D. Tex. Sep. 1, 2023) (resetting trial from June 2, 2025 (ECF 41) to November 17, 2025); *CLO Virtual Fashion Inc. v. Zhejiang Lingdi Digital Technology Co., Ltd.*, No. 2:23-cv-00274 (E.D. Tex. June 14, 2023) (resetting trial, for the ninth time, from April 7, 2025 (ECF 32) to October 27, 2025).

Judge Gilstrap regularly double- or triple-tracks trial dates. The Board has held that *Fintiv* factor 2 is “neutral or weighs slightly in favor of not exercising [] discretion” where Judge Gilstrap “set 10 cases for jury selection on the same day,” because of “uncertainty whether the trial in that proceeding would actually begin on that date.” *BOE Tech. Grp. Co. v. Optronix Scis. LLC*, IPR2024-01130, Paper 16, 10 (PTAB Jan. 27, 2025). This trial date is shared by *six* others. (EX1069-74.)

Patent Owner’s reliance on selective quotes from *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC* is misplaced. IPR2025-00223, Paper 9, 2–3 (P.T.A.B. June 12, 2025) (“AMD”). The denial in *AMD* turned on i) a trial date that is before the final written decision deadline, ii) speculation of the court granting a motion to transfer, and iii) substantial investment in litigation. *Id.*, 2-3.

Here, trial is scheduled for *after* the Final Written Decision deadline. Unlike *AMD*, where *Markman* would occur *before* the institution decision and the parties had engaged in seven months of fact discovery (*id.*, 2–3), discovery has just begun and *Markman* is almost seven months *after* the institution deadline.

C. Factor 3: Weighs Against Denial - Investment in the District Court Is Not “Substantial”

The parties’ investment in the district court proceeding is far from “substantial.” (Br., 12–13.) Fact discovery just began, and the parties have yet to take any depositions. Claim construction briefing will not begin until November 2026. (EX2004, 4.) The district court has not issued any substantive rulings and has not considered the patentability arguments in this Petition. That will still be true when an institution decision comes in late May.

The only motion pending in the district court is a partial motion to dismiss, which does not overlap with the Petition’s prior art challenges. Other than that, the Court is not likely to issue any rulings before the institution decision on May 28, 2026. “If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion.” *Apple Inc. v Fintiv, Inc.*, IPR2020-00019, Paper 11, 9–10 (PTAB Mar. 20, 2020); *see also Bio-Rad Lab’ys, Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, 10 (PTAB Mar. 27, 2025) (weighing against exercising

discretion because “expert reports, expert discovery, expert depositions, and pretrial motions and disclosures” had yet to occur).

Finally, Patent Owner’s suggestion that it “prepar[ed] and fil[ed]” the complaint in reliance on Amazon’s “delay” in filing its petition after receiving Patent Owner’s pre-suit letter is simply not credible. *See supra* Section II.A.

D. Factor 4: Sotera Stipulation Weighs Against Denial

Consistent with Patent Office precedent, Amazon committed to a full *Sotera* stipulation. Amazon’s *Sotera* stipulation requires that if the Board institutes *inter partes* review, it will not advance in the parallel district court proceeding “any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.” (Paper 7, 1.) The *Sotera* stipulation “weighs strongly in favor of not exercising discretion to deny institution” because it “obviate[s] much, if not all, of any potential overlap between the issues in the proceeding and the district court proceeding.” *Liberty Energy Servs. LLC v. U.S. Well Servs., LLC*, IPR2025-00139, Paper 14, 13–14 (Jun. 11, 2025); *see also Stingray Grp. Inc. v. Hernandez-Mondragon*, IPR2025-00349, Paper 19, 7-8 (Jun. 13, 2025) (same); *Kubota N. Am. Corp. v. Vermeer Mfg. Co.*, IPR2025-00170, Paper 15, 13 (Jun. 10, 2025) (same); *Apple Inc. v. Vampire Labs, LLC*, IPR2025-01215, Paper 8, 8-9 (Oct. 17, 2025) (referencing *Sotera* stipulation), Paper 10, 2 (Dec. 1, 2025) (granting institution); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00969, Paper 8, 2 (Sep. 18, 2025)

(referencing Sotera stipulation), Paper 13, 2 (Oct. 10, 2025) (referring for merits review), Paper 14, 17 (Nov. 28, 2025) (granting institution), Paper 19, 2 (Jan. 12, 2026) (denying director review).

Patent Owner’s authority does not show otherwise. In *Motorola Sols., Inc.*, the Director found that a *Sotera* stipulation “may mitigate some concern of duplication between the [litigation] proceeding and [the IPR] proceeding,” but denied review because the stipulation did not “outweigh the substantial investment in the district court proceeding or *Fintiv* factors 1, 2, and 5.” *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 4 (PTAB Mar. 28, 2025). But that case was much farther along; “the parties had . . . served . . . expert reports, filed claim construction briefs, and conducted several depositions” and “[t]he court [] had . . . construed the disputed claim terms.” *Id.*, 3. Here, the district court proceeding has not reached any of those stages.

Further, Patent Owner’s argument regarding the newly asserted ’720 and ’721 patents is moot because Amazon has acted quickly to file those petitions. (*See supra* Section III.A; Br., 5–6.) And the Petition also includes claims (15, 17–19, 22, and 26) not asserted in the district court litigation. Petitioner’s *Sotera* stipulation and additional challenged claims in the Petition weigh against denial.

E. Factor 5: Identity of Parties Weighs Against Denial Because the FWD Is Likely to Precede the Trial

The parties are the same parties in the parallel district court litigation and this IPR. Where, as here, the FWD “is likely to issue before the district court trial,” this factor weights “against exercising discretion.” *BMW of N. Am., LLC v. Mich. Motor Techs. LLC*, IPR2023-01234, Paper 11, 14–15 (PTAB Jan. 26, 2024).

F. Factor 6: Other Considerations Weigh Strongly Against Discretionary Denial

The strength of the petition weighs against discretionary denial. There are compelling economic and public interests to examine the challenged claims (*see supra* Section II.C) and this IPR will allow the Office to correct material errors during prosecution (*see supra* Section II.B). And, the Petition is strong on merits.

1. The grounds are straightforward and compelling

Patent Owner’s sole complaint about the Petition has nothing to do with the merits. Patent Owner fixates on the number of asserted grounds and references. (Br., 7.) But the Board evaluates a petition’s substantive limitation-by-limitation showing, not merely the number of references cited or the number of grounds. *Samsung Elecs. Co., Ltd. v. Resonant Sys., Inc.*, IPR2023-00993, Paper 17, 24 (PTAB Jan. 10, 2024) (“The Board’s concern in *Adaptics* was not the number of grounds, references, or asserted claims, but that ‘the Petition suffers from a lack of particularity that results in voluminous and excessive grounds.’”). The Petition

provides clear limitation-by-limitation analysis, and each of the grounds is straightforward. There are only *two* grounds against the sole independent claim: a *single-reference* ground and a *two-reference* combination, and each dependent ground adds only *one reference*. (Pet., 7.)

Patent Owner complains that the Petition has nine references and sixteen grounds. (Br., 7.) But this is because it chose to include dependent claims reciting nothing more than details of how conventional components work. They span everything from generic sensors (*e.g.*, claim 3, 4), to generic actuators (*e.g.*, claims 5, 6), to conventional microphone types (*e.g.*, claims 7–9), to standard networking protocols (*e.g.*, claims 10–15), to various home appliances (*e.g.*, claims 16–23), to routine lighting and audio components (*e.g.*, claims 24–29). These features were so trivial (*e.g.*, that a “sounder” is for “converting an electrical energy to . . . sound waves” in claim 27) that they are not normally described in patent filings. Thus, the total number of references and grounds reflects the lack of focus—and lack of real innovation—by the Patent Owner and counsels against discretionary denial.

Petitioner’s secondary references underscore how unremarkable the claimed inventions are. The references include a layman *manual* (*Wireless Home Networking Simplified*) and *textbooks* on speech processing (*Springer Handbook of Speech Processing*), networking (*Wireless Communications*), and acoustics

(*Springer Handbook of Acoustics*). These are basic materials, not frontier research, and they demonstrate non-inventiveness of the challenged claims.

Nor is the Petition “weak” because it “does not assert any anticipation.” (Br., 7.) The Office routinely institutes *inter partes* reviews for obviousness. *See, e.g., Apple Inc. v. Vampire Labs., LLC*, IPR2025-01215, Paper 2, 9 (Jun. 27, 2025) (presenting obviousness grounds); *id.*, Paper 10, 2 (granting institution). Finally, Patent Owner’s reliance on *Hisense USA Corp. v. Light Guide Innovations LLC*, IPR2025-01537 and *Hisense USA Corp. v. Light Guide Innovations LLC*, IPR2025-01526 is misplaced. (Br., 7–8.) These summary decisions offer no indication that the outcomes hinged on the number of references or grounds.

2. Patent Owner fails to show “gap” filling

Patent Owner identifies *no* substantive deficiencies in the expert declaration. Instead, it baldly asserts that the declaration “fill[s] in holes in the prior art,” but provides no example (nor could it) of a single “gap.” (Br., 10.); *see Cambridge Indus. USA, Inc., v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11, 2 (PTAB, June 26, 2025) (denying request for discretionary denial and finding that “Patent Owner does not identify any portions of the expert testimony that suggest Petitioner is using its expert to fill gaps in the prior art.”).

Unable to find faults in the merits, Patent Owner resorts to attacking the length of the declaration. (Br., 7, 10–11.) But this is beside the point. Longer

declarations are not grounds for discretionary denial. Patent Owner cites recent summary decisions denying institution on discretionary grounds to conclude that long declarations in those proceedings were the reasons for denial. (Br., 10–11.) This is unsupportable and ignores proceedings that were referred for merits considerations with similar or longer accompanying expert declarations. *See, e.g., Ford Motor Co. v. Autoconnect Holdings LLC*, IPR2025-01524, Ex. 1003 (258 pages on 21 claims), IPR2025-01342, Ex. 1003 (313 pages on 21 claims), IPR2025-01383, Ex. 1003 (416 pages on 21 claims); *3D Sys. Corp. v. Intrepid Automation, Inc.*, IPR2025-01241, Ex. 1003 (286 pages on 20 claims).

In fact, the Declaration’s length reflects Amazon’s compliance with USPTO requirements. (*See* July 31, 2025, Memorandum on Permissible Uses of General Knowledge in Inter Partes Reviews.) As an initial matter, it is readily apparent—even from a cursory review—that most of the declaration consists of verbatim quotations from references and claims for readability. The remaining portions do not supply missing elements and Patent Owner did not point to any. They provide technical background and context, as well as scientific principles underlying the Petition’s arguments. (*E.g.*, EX1002, 37-45, 156-161.) Petitioner’s compliance with the Office procedure is not grounds to deny.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that Patent Owner's request be denied and the Petition be referred for merits consideration.

Dated: March 2, 2026

By: /s/ Alex S. Yap

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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION and supporting materials were served on the below date via email
(by agreement) to the following counsel of record for Patent Owner:

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Dated: March 2, 2026

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