

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and YOUTUBE, LLC

Petitioner

v.

VOXER, INC. and VOXER IP LLC

Patent Owner

IPR2026-00421
Patent No. 11,146,516

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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2001	Biography of Clara Bourget
2002	Declaration of Clara Bourget in Support of Motion for <i>Pro Hac Vice</i> Admission
2003	Complaint, Case No. 1:25-cv-00873, D.I. 1 (D. Del.), filed July 14, 2025
2004	Scheduling Order, Case Nos. 1:25-cv-00872, 1:25-cv-00873, D.I. 36 (D. Del.), entered Jan. 8, 2026
2005	Stipulated Protective Order, Case No. 1:25-cv-00873, D.I. 76 (D. Del.), entered Mar. 20, 2026
2006	Opening Brief in Support of Motion to Dismiss Plaintiff's Complaint, Case No. 1:25-cv-00873, D.I. 14 (D. Del.), filed Sept. 24, 2025
2007	Opening Brief in Support of Motion to Transfer, Case No. 1:25-cv-00873, D.I. 31 (D. Del.), filed Dec. 12, 2025
2008	Notice of Service of Initial Infringement Contentions, Case No. 1:25-cv-00873, D.I. 87 (D. Del.), filed July 23, 2026
2009	Notice of Service of Initial Invalidity Contentions, Case No. 1:25-cv-00873, D.I. 93 (D. Del.), filed Sept. 3, 2026
2010	Defendants' Initial Invalidity Contentions, Case No. 1:25-cv-00873 (D. Del.), served Sept. 3, 2026
2011	U.S. Patent No. 8,705,714
2012	Thomas G. Hallin Declaration Under 37 C.F.R. § 1.132, submitted September 6, 2013 during prosecution of App. No. 13/555,034
2013	U.S. Patent No. 9,674,122
2014	U.S. Patent No. 9,264,390
2015	U.S. Patent No. 9,294,522
2016	First Amended Final Judgment, Case No. 1:20-cv-655, D.I. 433 (W.D. Tex.), entered Jul. 31, 2023
2017	Decision Denying Institution of <i>Inter Partes</i> Review of U.S. Patent No. 10,511,557, IPR2021-00113, Paper 14, entered May 7, 2021
2018	Decision Denying Institution of <i>Inter Partes</i> Review of U.S. Patent No. 10,511,557, IPR2021-00112, Paper 14, entered May 7, 2021

2019	Decision Denying Institution of <i>Inter Partes</i> Review of U.S. Patent No. 10,142,270, IPR2021-00115, Paper 16, entered May 7, 2021
2020	U.S. Patent No. 10,142,270 with <i>Ex Parte</i> Reexamination Certificate
2021	U.S. Patent No. 10,511,557 with <i>Ex Parte</i> Reexamination Certificate
2022	Comparison of '516 Petition (Paper 2) and Dr. Houh Decl. (EX1002)
2023	Opening Brief in Support of Motion to Dismiss Plaintiff's Complaint, Case No. 1:25-cv-00872, D.I. 14 (D. Del.), filed Sept. 24, 2025
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TABLE OF ABBREVIATIONS

Abbreviation	Description
'516 Patent	U.S. Patent No. 11,146,516
'883 Patent	U.S. Patent No. 11,777,883
'929 Patent	U.S. Patent No. 11,658,929
'270 Patent	U.S. Patent No. 10,142,270
'557 Patent	U.S. Patent No. 10,511,557
Petitioner	Google, LLC & YouTube, LLC
Patent Owner	Voxer, Inc. & Voxer IP LLC
Amazon	Amazon.com, Inc., Amazon Web Services, Inc., & Twitch Interactive, Inc.
'400 App	U.S. Patent Application No. 12/028,400
'558 Pub	U.S. Patent Publication No. 2009/0003558
'029 Patent	U.S. Patent No. 8,180,029
'552 App	June 2007 Provisional Application No. 60/937,552
'619 App	October 2007 Provisional Application No. 60/999,619
'034 App	U.S. Patent Application No. 13/555,034
'714 Patent	U.S. Patent No. 8,705,714
Memo	Director's March 26, 2025 Memorandum
'647 Patent	U.S. Patent No. 8,693,647
'122 Patent	U.S. Patent No. 9,674,122

I. INTRODUCTION

On July 14, 2025, Patent Owner sued Petitioner in Delaware district court for infringement of five patents: the '270, '557, '516, '929, and '883 Patents. EX2003. Just shy of the one-year deadline, Petitioner challenged three of the five patents—the '516, '929, and '883 Patents—based on the theory that certain claim language lacks written description support in earlier priority applications. *See* IPR2026-00421; IPR2026-00422; IPR2026-00423. Tellingly, however, Petitioner did not challenge the '270 and '557 Patents despite these patents reciting similar disputed claim language and claiming priority to the same priority applications. Petitioner's decision to not challenge the '270 and '557 Patents makes sense: these patents each survived prosecution, a jury trial, an *inter partes* review, and an *ex parte* reexamination—without any findings of lacking written description support. And Amazon, who Patent Owner sued on the same five patents on the same day in the same district court as Petitioner, did not file any challenges or join Petitioner's.

This Petition and its litigation-driven timing is the kind of duplicative, meritless challenge that discretionary denial can prevent. The *Fintiv* factors favor discretionary denial: no stay has been requested; the underlying litigation is advanced; the Petition and the district court case overlap; the parties are the same; and the Petition is weak. Moreover, Patent Owner's settled expectations warrant denial: the '516 Patent has been in force for five years and its family longer.

II. THE *FINTIV* FACTORS SUPPORT DISCRETIONARY DENIAL

Section 314(a) affords the Director discretion to deny institution of an *inter partes* review in view of parallel proceedings involving the same issues and patents. 35 U.S.C. § 314(a); *Harmonic Inc. v. Avid Tech.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR.”); *see NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 11 (Sept. 12, 2018) (precedential). The Director takes a “holistic view” of whether the system is best served by denying or instituting review using six factors: (1) whether the court granted a stay or evidence exists that one may be granted; (2) the proximity of the court’s trial date to the projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the court and the parties; (4) overlap between the issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the exercise of discretion, including the merits. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (Mar. 20, 2020) (precedential) (“*Fintiv*”). Here, the *Fintiv* factors heavily favor discretionary denial.

A. Factor 1: the lack of a stay in the underlying litigation favors denial.

The first *Fintiv* factor favors denial. The underlying action has been pending since July 14, 2025. EX2003. In that time, no stay has been entered, no motion to stay has been filed, and no party has raised the possibility of seeking a stay.

A stay would also be impractical as a matter of case management. Petitioner challenged only three of the five patents asserted in Delaware. This limits the court's ability to meaningfully pause or save effort in its proceedings: it must still address claim construction, infringement, and invalidity regardless of the IPR proceedings. EX2004 at 20-22; *see, Samsung Elecs. Co. v. SnapAid, Ltd.*, IPR2025-01519, Paper 6 at 11 (Nov. 17, 2025); *Samsung Elecs. Co. v. SnapAid, Ltd.*, IPR2025-01519, Paper 12 at 1 (Jan. 9, 2026) (granting discretionary denial where five of eight asserted patents were challenged and petitioner had not sought a stay); *Tigo Energy, Inc. v. SMA Solar Tech. Am. LLC*, No. 22-915-GBW, 2024 WL 1637511, at *3 (D. Del. Apr. 16, 2024) (a partial stay confers no meaningful efficiency and risks piecemeal litigation). The parallel Amazon litigation compounds the problem: a stay of the Petitioner's case would leave the Amazon litigation to proceed on the same patents. EX2004 at 20-22.

In short, a stay remains both unrequested and unlikely. And even if one were granted, it would not resolve the broader concerns weighing against institution as discussed below. Regardless, at a minimum, this factor is neutral since no party has requested a stay. *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (May 13, 2020) (precedential) ("*Fintiv II*").

B. Factor 2: the trial date in the underlying district court litigation does not outweigh the totality of the other factors.

The second *Fintiv* factor is neutral and does not weigh against discretionary denial. The statutory deadline for a Final Written Decision is January 21, 2028. 35 U.S.C. § 316(a)(11). Trial in the underlying district court litigation is scheduled for February 5, 2029, and trial in the co-pending Amazon litigation for November 27, 2028. EX2004 at 22. But even where no parallel trial precedes the projected Final Written Decision, this factor standing alone is not dispositive; the Board “takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv II*, at 8.

Indeed, institution is frequently denied even where trial is set to occur after the projected Final Written Decision. *See, e.g., iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 2 (June 6, 2025); *Samsung Elecs. Co. v. VB Assets, LLC*, IPR2025-00870, Paper 11 at 2 (Oct. 10, 2025). And as *Fintiv* instructs, where “the court’s trial date is at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding.” *Fintiv* at 9. Those other factors decisively favor denial.

C. Factor 3: the investment in the underlying district court case before the institution decision favors denial.

The third *Fintiv* factor weighs in favor of discretionary denial. Since Patent Owner filed its complaint, the parties have poured substantial time and resources into the district court litigation, and every investment described below applies with equal force to the parallel Amazon litigation. *See generally* EX2004; EX2023; EX2024.

Over the past year, the parties have negotiated scheduling and protective orders, briefed motions to dismiss and transfer, exchanged infringement and invalidity contentions, and engaged in party and third-party discovery. *See* EX2004 at 20-22; EX2005; EX2006; EX2007; EX2008; EX2009. Within three days of this Request, the parties will have exchanged claim terms for construction (September 24, 2026), and by the expected institution decision date (January 21, 2027) claim construction briefing will be substantially complete. 35 U.S.C. § 314(b)(1); EX2004 at 20-21; *Fintiv II*, at 14; *see also Comcast Cable Commc'ns, LLC v. Touchstream Techs., Inc.*, IPR2024-00323, Paper 13 at 9-10 (July 24, 2024) (“Factor 3 favor[ed] denial” where “substantial work on claim construction [had] happened” and the litigation “ha[d] progressed in other aspects as well”).

By the Final Written Decision, the parties will have completed the *Markman* hearing (April 8, 2027), final infringement (August 30, 2027) and invalidity contentions will have been served (October 7, 2027), fact discovery will have ended

(November 4, 2027), and opening expert reports will have been served (December 1, 2027). EX2004 at 21-22. The underlying litigation is, by any measure, well advanced.

Petitioner's lack of diligence compounds the importance of those investments. *See Fintiv*, at 11-12 (“[I]f the evidence shows that the petitioner did not file the petition expeditiously...or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.”). As explained in Section IV.B, *infra*, Petitioner could have filed the Petition many months earlier but instead filed just shy of the one-year deadline. By the time of the Petition, the parties in both district court litigations had committed significant time and resources. *Glob. Tel*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00444, Paper 14 at 22-23 (July 22, 2021).

D. Factor 4: the substantial overlap between this IPR and the underlying district court case favors denial.

The fourth *Fintiv* factor weighs in favor of discretionary denial. The Petition identifies a single ground of invalidity—Katis in combination with Abbazia—pursuant to 35 U.S.C. § 103. Petitioner stipulated that it will not pursue in the district court “(i) the specific grounds raised in IPR2026-00421, or (ii) any ground that Petitioner[] reasonably could have been raised in IPR2026-00421.” EX1026. But even if this *Sotera*-style stipulation is considered, Petitioner can still take multiple effective bites at the invalidity apple because it allows Petitioner to assert various prior art in various ways (and the very same arguments)—including patents, patent

application publications, printed publications, and system art, and combinations thereof—in district court. *See generally* EX2010; *Shenzen Tuozhu Tech. Co. v. Statasys, Inc.*, IPR2025-00354, Paper 11 at 2-3 (June 12, 2025); *Cisco Sys. Inc. v. WSOU Investments LLC*, IPR2025-00188, Paper 14 at 2-3 (Aug. 22, 2025); *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 2-4 (Mar. 28, 2025); *cf. Ingenico, Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365-66 (Fed. Cir. 2025).

In district court, Petitioner’s invalidity contentions include forty prior art references—including numerous patents, patent application publications, and system art—under 35 U.S.C. § 102, any of which may be combined under 35 U.S.C. § 103. EX2010 at 15-24; *Fintiv II* at 15 (stating that “Petitioner’s assertion of additional invalidity contentions in the District Court is not relevant to the question of the degree of overlap for this factor.”). Petitioner also reserved “the right to identify other prior art that would disclose such limitation(s) and anticipate and/or render obvious any of the Asserted Claims, alone and/or in combination with identified or additional prior art.” EX2010 at 5. Effectively, Petitioner reserved the right to later assert Katis and Abbazia as prior art references.

In practice, this means that Petitioner could still rely on the same art and effectively all of the same arguments in district court. Petitioner’s stipulation is thus ineffective, is likely to result in significant duplication of efforts across forums, and

does not provide any efficiency gains for an IPR proceeding. *Shenzen Tuozhu*, IPR2025-00354, Paper 11 at 2-3; *Cisco*, IPR2025-00188, Paper 14 at 2-3; *Motorola*, IPR2024-01205, Paper 19 at 2-4 (“[A]lthough Petitioner’s *Sotera* stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation does not outweigh the substantial investment in the district court proceeding or [other] *Fintiv* factors...which the Board found weighed in favor of denial.”). That is anything but a “true alternative.” *Cisco*, IPR2025-00188, Paper 14 at 3.

Petitioner’s stipulation cannot cure the overlap between these proceedings or outweigh the other *Fintiv* factors favoring denial.

E. Factor 5: the parties being the same as in the underlying district court litigation favors denial.

The fifth *Fintiv* factor weighs heavily in favor of discretionary denial. The parties here and in the district court are the same, and “[b]ecause the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II*, at 15.

F. Factor 6: other circumstances, such as the merits, weigh heavily in favor of discretionary denial.

The sixth *Fintiv* factor—other circumstances, including the merits—weighs strongly in favor of discretionary denial. The merits of the Petition are weak; its

invalidity grounds depend entirely on (1) an improper stripping of the priority date of the challenged claims, and (2) a near-verbatim expert declaration.

1. Petitioner improperly strips the challenged claims of their priority date.

Priority applications for the '516 Patent include the 2008 non-provisional '400 App (EX1018), which published as the '558 Pub (EX1004) and issued as the '029 Patent, as well as the provisional '552 (EX1010) and '619 (EX1011) Apps, which were filed on June 28, 2007, and Oct. 19, 2007. Each supports the “E2E Limitation.”

The '400 App's disclosure of prior art-related problems and Patent Owner's solution is instructive. For instance, the Description of the Related Art discussion in the '400 App extensively discusses the shortcomings of then-existing live communications platforms, which required end-to-end connections before any communication began. *See, e.g.*, EX1018 at [0003] (when using telephones, “[o]ne is still required to pick up the phone, dial another party, wait for a connection to be made” before engaging in a conversation), [0006], [0011]. And the solution described in the '400 App addresses the above-described prior art problem by eliminating the need to establish an end-to-end connection before communication may begin. *Id.* at [0038] (“When you ‘Vox’ someone...no dedicated circuit is needed for the conversation to take place, as required with conventional telephone calls.”). Indeed, the '400 App expressly provides that “no dedicated circuit is needed for the conversation to take place” (where “messages of conversations may contain voice

only or voice, video and other data, such as sensor information”), yet:

Users are empowered to conduct communications in either: (i) a near-synchronous or “live” conversation, providing a user experience similar to a standard full duplex phone call; or (ii) in a series of back and forth time-delayed transmissions (i.e., time-shifted mode). Further, users engaged in a conversation can seamlessly transition from the live mode to the time-shifted mode and back again.

Id. at [0037]-[0038], [0040]. The ’400 App confirms that Patent Owner’s “store and stream” technology required no end-to-end connection for communications to begin:

An improved voice and other media communication and management system and method is disclosed which provides one or more of the following features and functions: ...

iii. enabling users to seamlessly transition a conversation between a synchronous “live” mode and a time shifted mode;

iv. enabling users to participate in conversations without waiting for a connection to be established with another participant or the network. This attribute allows users to begin conversations, participate in conversations, and review previously received time-shifted messages of conversations even when there is no network available, when the network is of poor quality, or other participants are unavailable;

Id. at [0041]. As this disclosure shows, unlike in the prior systems, a sender can begin transmitting media, through a communication and management system, regardless of the intended recipient(s)’ availability or connection on the network.

Moreover, the '552 and '619 Apps contain complementary disclosures from 2007. *See, e.g.*, '552 App (EX1010) at 2 (“Stream and store protocol - streaming voice, video or other media as quickly as possible while still guaranteeing delivery, even when network conditions are poor”), 15 (“Message Switch - this is the Store and Streamer. It accepts a Message from a sending Device, and then starts sending that Message to any and all recipients.”); '619 App (EX1011) at 3 (“Users could transition from a series of back and forth transmissions to a synchronous, full duplex conversation (similar to today’s phone calls) and then back again. Recipients don’t need to wait for a message to finish being left before listening to it.”), 4 (“No dedicated circuit is required for the conversation.”).

Nor is Patent Owner making this claim about the E2E Limitation language for the first time in this proceeding. Indeed, in the prosecution of the '034 App (EX1020), which became the '714 Patent (EX2011), Dr. Thomas G. Hallin submitted a September 6, 2013 declaration under 37 C.F.R. § 1.132 in which he noted with respect to “THE VOXER INVENTION- STORE & STREAM”:

Similar to real-time communication systems, the progressive transmission and delivery of messages, as the voice media is created, enables the recipient to selectively review the message in near real-time (delayed only by the inherent latency on the network). ***But unlike real-time systems, no circuit or other network connection between the parties is needed before the message can be sent.*** See the Summary of

the Invention provided in paragraphs [0017] through [0021] and the "Functional Overview" provided in paragraph [0039].

EX2012 at ¶ 24 (emphasis added). And Dr. Hallin's cited materials ([0017]-[0021], [0039] in the '034 App) are also found in the '400 App at [0036]-[0040] and [0041].

These are just some of the disclosures that will be discussed in Patent Owner's forthcoming Patent Owner Preliminary Response. Because the challenged claims are entitled to at least their 2008 non-provisional filing date, Petitioner's asserted references are not prior art and its grounds fail on the merits.

2. The Houh Declaration parrots the Petition.

The Petition's unhelpful expert testimony further highlights its weak merits. The Petition is supported by an expert declaration from Petitioner's expert, Dr. Houh, that, in many instances, "merely repeats, *verbatim*, the conclusory assertion[s] for which it is offered to support." *Xerox v. Bytemark*, IPR2022-00624, Paper 9 at 15 (Aug. 24, 2022) (precedential) (denying institution); *compare* Petition at 4-53, *with* EX1002 ¶¶ 39-136. As a comparison of the Petition and declaration illustrates, Dr. Houh's declaration reproduces the Petition's substantive arguments nearly verbatim, rendering it devoid of any independent expert analysis. *See* EX2022 at 30-42, 46-48, 51-96 (showing minimal substantive differences between the following sections: IV. (Petition) vs V. (Houh); VII.A and VII.B.2. (Petition) vs IX.A. and IX.

C. (Houh); VIII. (Petition) vs X. (Houh)). Table 1, below, shows how Dr. Houh’s “E2E Limitation” testimony merely reproduces the Petition’s substantive arguments.

Table 1. Comparison of ’516 Petition (Paper 2) and Dr. Houh Decl. (EX1002)

'516 Petition Excerpts	Dr. Houh Declaration Excerpts
As explained above, the E2E Limitation requires (1) the receiving device to be able to render portions of video media while the sending device is transmitting the video media (which requires the sending and receiving devices to both be online), and (2) that this occur without having first established an end-to-end connection between the sending and receiving devices. This limitation is not disclosed in the '528 Specification. EX1002, ¶63. See <i>Novartis</i>, 38 F.4th at 1016. First, the '528 Specification does not expressly describe the E2E Limitation. There is simply no express discussion of the need/ability to avoid or omit an end-to-end connection before exchanging video media between online devices, as required by the E2E Limitation. EX1002, ¶64. See <i>D Three Enters.</i>, 890 F.3d at 1052 (“[A]dequate written description does not ask what is permissible, rather, it asks 18 Petition in IPR2026-00421 Patent No. 11,146,516 what is disclosed.”). Second, a PHOSITA would not infer, from the Specification, any reason to avoid, or advantage in avoiding, end-to-end connections before exchanging video media between online devices. EX1002, ¶65. In fact, where the '528 Specification discusses interaction between the first and second devices, it implies that an end-to-end connection is useful. EX1002, ¶65. For example, the '528 Specification states that client 12 in device 13 includes modules 40 and 44, which facilitate “multi-party <i>end-to-end authentication, encryption and security ... between Clients 12.</i>” EX1006, ¶82 (emphasis added); EX1002, ¶65. In other words, the '528 Specification teaches that <i>establishing</i> an end-to-end connection between online devices provides an <i>advantage</i>, i.e., end-to-end encryption. EX1006, ¶82; EX1002, ¶65. Also, the '528 Specification elsewhere implies other advantages to such a connection, such as packet acknowledgement (EX1006, ¶120) and sharing of presence data to optimize network utilization (EX1006, ¶20). EX1002, ¶65.	63. As explained above, the E2E Limitation requires (1) the receiving device to be able to render portions of video media while the sending device is transmitting the video media (which requires the sending and receiving devices to both be online), and (2) that this occur without having first established an end-to-end connection between the sending and receiving devices. In my opinion, this limitation is not disclosed in the '528 Specification. 64. First, the '528 Specification does not expressly describe the E2E Limitation. There is simply no express discussion of the need/ability to avoid or omit an end-to-end connection before exchanging video media between online devices, as required by the E2E Limitation. 65. Second, a PHOSITA would not infer, from the Specification, any reason to avoid, or advantage in avoiding, end-to-end connections before exchanging video media between online devices. In fact, where the '528 Specification discusses interaction between the first and second devices, it implies that an end-to-end connection is useful. For example, the '528 Specification states that client 12 in device 13 includes modules 40 and 44, which facilitate “multi-party <i>end-to-end authentication, encryption and security ... between Clients 12.</i>” EX1006, ¶82 (emphasis added). In other words, the '528 Specification teaches that <i>establishing</i> an end-to-end connection between online devices provides an <i>advantage</i>, i.e., end-to-end encryption. EX1006, ¶82. Also, the '528 Specification elsewhere implies 34 Declaration of Dr. Houh Patent No. 11,146,516 other advantages to such a connection, such as packet acknowledgement (EX1006, ¶120) and sharing of presence data to optimize network utilization (EX1006, ¶20).

Regarding the claim language that a sending device begins to transmit the video media of the video message, <i>see</i> immediately above, elements [1a] and [1b]. EX1004, ¶0128; EX1002, ¶105. The combination renders obvious doing so without having to first establish an end-to-end connection over the network between the sending device and any recipient devices respectively. EX1002, ¶106. As explained above in §VIII.A and §VIII.B, it would have been obvious to combine Katis with Multicast functionality, as taught by Abbazia. EX1002, ¶107. Abbazia teaches that Multicast functionality avoids connections with target devices to gain efficiency. EX1005, 1:35-45, 2:4-5 (“The multicast approach eliminates the undesirable overhead associated with forming connections with each system....”); EX1002, ¶107. Specifically, in Multicast, a packet is transmitted to single Multicast IP address, and then network-level devices, such as routers, forward it to its end destination. EX1002, ¶107. When the sending device sends to a Multicast address (e.g. when livestreaming a video to a large audience and all users opt to use Multicast), no end-to-end connection is formed with the recipient device before the sending device begins to transmit the video media of the video message. EX1002, ¶107.	105. Regarding the claim language that a sending device begins to transmit the video media of the video message, <i>see</i> immediately above, elements [1a] and [1b]. EX1004, ¶0128. 106. In my opinion, the combination renders obvious doing so without having to first establish an end-to-end connection over the network between the sending device and any recipient devices respectively. 107. As explained above in §X.A and §X.B, it would have been obvious to combine Katis with Multicast functionality, as taught by Abbazia. Abbazia teaches that Multicast functionality avoids connections with target devices to gain efficiency. EX1005, 1:35-45, 2:4-5 (“The multicast approach eliminates the undesirable overhead associated with forming connections with each system....”). Specifically, in Multicast, a packet is transmitted to single Multicast IP address, and then network-level devices, such as routers, forward it to its end destination. When the sending device sends to a Multicast address (e.g. when livestreaming a video to a large audience and all users opt to use Multicast), no end-to-end connection is formed with the recipient device before the sending device begins to transmit the video media of the video message.
It would have been obvious to perform this function as suggested by Katis. EX1004, ¶¶0119, 0139, 0059, 0085, 0074, 0082, 0139, 0061, 0102, 0221-0222, 0236, Fig. 9C; EX1002, ¶117. For example, Katis defines encoding as: “Encoding: The process of translating Media either created by a User (such as voice or video) or otherwise originating on a Device (such as GPS or other sensor data), and converting the media into digital data to be processed by a Client.” EX1004, ¶0082. Katis states that “[s]ervers provide . . . transcoding . . . and the optimization of the transmission of data across the network.” EX1004, ¶0061. Katis further states that “different Codec or Codecs, each having a different bit rate versus quality tradeoff, may be used.” EX1004, ¶0221; EX1002, ¶117. Katis states that “the rendering and encoding module 21 is responsible for performing all rendering tasks for the MCMS application 20. These tasks include rendering Media appropriately for the device 13 running application 12.” EX1004, ¶¶0128, 0139,	117. It would have been obvious to perform this function as suggested by Katis. EX1004, ¶¶0119, 0139, 0059, 0085, 0074, 0082, 0139, 0061, 0102, 0221-0222, 0236, Fig. 9C. For example, Katis defines encoding as: “Encoding: The process of translating Media either created by a User (such as voice or video) or otherwise originating on a Device (such as GPS or other sensor data), and converting the media into digital data to be processed by a Client.” EX1004, ¶0082. Katis states that “[s]ervers provide . . . transcoding . . . and the optimization of the transmission of data across the network.” EX1004, ¶0061. Katis further states that “different Codec or Codecs, each having a different bit rate versus quality tradeoff, may be used.” EX1004, ¶0221. Katis states that “the rendering and encoding module 21 is responsible for performing all rendering tasks for the MCMS application 20. These tasks include rendering Media appropriately for the device 13 running application 12.” EX1004, ¶¶0128, 0139, 0161.

Testimony that merely parrots counsel’s assertions is entitled to little or no weight. *See Xerox*, IPR2022-00624, Paper 9 at 15-17 (denying institution where declaration “merely repeats, verbatim, the conclusory assertion[s] for which it is offered to support”); *TikTok v. NTECH Props.*, IPR2024-01339, Paper 9 at 16 (Feb. 25, 2025) (“Petitioner fails to establish a reasonable likelihood of” prevailing where

its expert “testimony repeats, almost verbatim, the language in the Petition without any further explanation or supporting reasoning or evidence.”). This matters because Petitioner bears the burden of demonstrating a reasonable likelihood of prevailing, and that burden cannot be satisfied by counsel’s argument alone. Without independent expert analysis, the Petition lacks evidentiary support for its analysis, and no weight should be afforded to Dr. Houh’s conclusory testimony. *See, e.g.*, EX2022 ¶¶ 62, 87, 88, 104, 137 (showing conclusory statements); 37 C.F.R. § 42.65; *Tableau Software v. iCHARTS*, IPR2024-01388, Paper 8, at 44 (May 14, 2025) (denying institution; giving “little weight” to an expert’s “conclusory statements” that “do[] not state the basis for [the] testimony”). The lack of expert support is a relevant consideration for the Director. Memo at 2; *Wowza Media Sys., LLC v. Adobe Sys. Inc.*, IPR2013-00054, Paper 12 at 12 (Apr. 8, 2013).

As such, the merits of the Petition are weak and favor discretionary denial.

III. PATENT OWNER’S SETTLED EXPECTATIONS INDEPENDENTLY WARRANT DISCRETIONARY DENIAL

Patent Owner’s settled expectations independently warrant discretionary denial. The Director’s Memo confirms that “the parties are permitted to address all relevant considerations” weighing in favor of discretionary denial, including the settled expectations of the parties. Memo at 2-3. The Director may deny institution based on the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Memo at 2. “Although there is no bright-line rule on

when expectations become settled,” *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 3 (June 18, 2025), the Director has repeatedly found expectations settled—and denied institution—where patents have been in force for several years. *See, e.g., Samsung Elecs. Co. v. Genghis Comm Holdings, LLC*, IPR2025-00788, Paper 11 at 2 (Aug. 22, 2025) (patents in force for ~3 years).

The ’516 Patent issued on October 12, 2021, and will have been in force for five and six years, respectively, by the time the institution and the Final Written Decisions are issued. This exceeds the period the Director found sufficient in *Samsung*, where institution was denied on three patents issued from February-August 2022—two to three years before the April 2025 petitions. IPR2025-00788, Paper 11 at 2.

Actual notice is not required. “[I]ssued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests[,] ..., actual notice of a patent or of possible infringement is not [even] necessary to create settled expectations.” *Dabico*, IPR2025-00408, Paper 21 at 3. The ’516 Patent has been publicly available for years. *See iRhythm Techs., Inc.*, IPR2025-00363, Paper 10 at 3 (“Petitioner’s awareness of [p]atent [o]wner’s applications and failure to seek early review of the patents favors denial.”).

Prolonged public notice of the patent family to Petitioner and others makes those expectations even stronger. The ’516 Patent is part of a family with provisional

applications filed in June and October 2007—nearly two decades ago. *Id.*; *Aquestive Therapeutics, Inc. v. Iono Pharma, LLC*, IPR2025-00874, Paper 11 at 2 (Oct. 3, 2025). The ’122 Patent—a related family member that is noted in the priority chain for the ’516 Patent and contains language similar to the “E2E Limitation”—issued on June 6, 2017, almost a decade ago. EX2013 at 45:33-46:12. And to the extent Petitioner argues it could not have notice merely because Patent Owner’s familial applications and patents were publicly available, this is refuted by the fact that at least two of Petitioner’s patents cite, on their face, Patent Owner’s applications that share a substantially similar specification with the ’516 Patent: (1) U.S. Patent No. 9,264,390 (EX2014 at 2) cites U.S. Patent Pub. Nos. 2012/0275583 (issued as the ’647 Patent) and 2012/0288074 (issued as the ’714 Patent); and (2) U.S. Patent No. 9,294,522 (EX2015 at 2) cites the same publications but they were “cited by examiner.”

Moreover, the two related, unchallenged patents—the ’270 and ’557 Patents—contain language similar to the “E2E Limitation” and issued in November 2018 and December 2019, respectively. Relevant language is shown in Table 2.

Table 2. Comparison of “E2E Limitation” across ’516, ’270, and ’557 Patents

’516 Patent	’270 Patent	’557 Patent
Claim [1a]-[1e]: “receiving ... a video message transmitted by a sending device” at an	Claim [34c]-[34f]: “receiving” the “video communication” from the sending communication	Claim [1a], [1d]: “receiving ... a video message transmitted by a sending device” at a

“infrastructure” and “transmitting the video media of the video message from the ... infrastructure to a recipient device so that a recipient can render at least a portion of the video media ... on the recipient device, ... so that the rendering occur[s]: (i) while the video media ... is being ... transmitted over the network by the sending device; and (ii) <u>without having to first establish an end-to-end connection ... between the sending device and the recipient device.</u>”	device” over a network, “storing the video communication,” and “delivering portions of the video communication” to the second communication device over the network” where the delivery enables “the video communication to be at least partially rendered at the second communication device while the video communication is transmitted by the sending communication device, wherein the video communication is received from the sending communication device <u>without first establishing an end-to-end connection ... between the sending and second communication devices.</u>”	“video message infrastructure” and “transmitting the selected degraded version of the video media from the video message service infrastructure to the recipient device so that the recipient device can render at least a portion of the video media on the recipient device,” so the rendering can occur: “(i) while the video media ... is being ... transmitted over the network by the sending device; and (ii) <u>without having to first establish an end-to-end connection ... between the sending device and the recipient device</u>”
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After Patent Owner sued Meta for infringement—including of the ’270 and ’557 Patents—the patents’ validity was tested through jury trial (EX2016), *inter partes* reviews (EX2017; EX2018; EX2019), and *ex parte* reexaminations. EX2020 at C1; EX2021 at C1. Petitioner, with its live video platform that competed with Meta’s technology, had ample opportunity to watch the Meta case unfold, declined

to challenge either patent at the time, and waited years to raise this lack-of-priority theory.

Such knowledge of the challenged “patent family for a significant period of time” favors discretionary denial. *Amazon.com, Inc. v. Audio Pod IP*, IPR2025-00768, Paper 15 at 3 (Aug. 14, 2025); *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 2-3 (July 31, 2025) (discretionary denial warranted based on petitioner’s prior knowledge of patent owner’s portfolio).

Accordingly, Patent Owner’s settled expectations favor discretionary denial.

IV. OTHER FACTORS SUPPORT DISCRETIONARY DENIAL

The Director’s Memo further permits the parties to address factors such as the extent of the petition’s reliance on expert testimony and any other considerations bearing on the Director’s discretion. Memo at 2-3. These considerations independently confirm that institution would serve neither the efficiency nor the integrity of the system. The Petition relies on an expert declaration that parrots the Petition, which highlights the lack of independent expert analysis. And the litigation-driven timing of Petitioner’s filing, along with Amazon’s decision to not file challenges, further reinforces why institution should be discretionarily denied.

A. The Petition’s expert declaration merely parrots the petition.

As discussed in Section II.F.2, *supra*, Dr. Houh’s declaration reproduces the Petition’s substantive arguments nearly verbatim, and contains several conclusory

statements. This highlights the lack of independent expert analysis, and lack of expert support is a relevant consideration the Director should consider. Memo at 2; *Wowza*, IPR2013-00054, Paper 12 at 12.

B. Petitioner’s delay and Amazon’s decision not to challenge the patent confirm that the Petition is litigation-driven.

Patent Owner filed the underlying case on July 14, 2025. EX2003. Petitioner waited until July 13, 2026 to file its Petition. That was not the product of circumstance. *See Fintiv*, at 11-12. The Petition’s scope refutes any suggestion that Petitioner needed the time: it challenges all eighteen claims of the ’516 Patent and it falls significantly under the PTAB’s allowable word limit, belying any suggestion that the volume of challenged claims taxed Petitioner’s capacity or resources.

Amazon’s silence confirms the point. Patent Owner has asserted the same five patents against Amazon, who possessed identical information available to Petitioner and had every incentive to challenge these claims, yet Amazon has not filed a single petition. Petitioner stands alone in contesting the validity of three of the five asserted patents—a challenge rooted not in any genuine deficiency in the ’516 Patent but in a litigation strategy unique to Petitioner.

V. CONCLUSION

The Director should discretionarily deny institution, allowing all validity issues to be more efficiently resolved by the district court.

Dated: September 21, 2026

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** has been served on Petitioner via email on the following counsel of record for Petitioner:

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Dated: September 21, 2026

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