

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMAZON.COM, INC., AMAZON.COM SERVICES LLC, AMAZON WEB  
SERVICES, INC., and AUDIBLE, INC.,  
Petitioner

v.

AUDIO POD IP, LLC,  
Patent Owner

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Case IPR2025-01003  
U.S. Patent No. 9,729,907

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**PATENT OWNER PRELIMINARY RESPONSE  
UNDER 37 C.F.R. § 42.107(a)**

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**TABLE OF CONTENTS**

I. INTRODUCTION ..... 1

II. BACKGROUND ..... 3

    A. Audio Pod’s founders invented key early media streaming technologies, including the inventions claimed in the ’907 patent. ....3

    B. Audio Pod disclosed their innovative technology to Amazon, but Amazon ignored their subsequent outreach attempting to partner or license, and Amazon instead implemented Audio Pod’s technology on its own. ....6

III. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM..... 8

    A. Grounds 1A-1G, 2C, and 2F: Amazon fails to demonstrate in the Petition that DTB, Yoshimura, Bulterman, and Yang are prior art printed publications. ....9

    B. All Grounds: Amazon advances inconsistent claim constructions here and in the District Court. ....12

    C. All Grounds: Amazon’s obviousness analysis is fundamentally lacking due to conclusory assertions regarding reasonable expectation of success and motivation to combine.....15

        1. Amazon’s contentions regarding reasonable expectation of success are insufficient. .... 15

        2. Amazon fails to perform a proper motivation to combine analysis under *Graham* for many dependent claims..... 18

        3. Amazon’s alleged motivations are purely conclusory..... 20

    D. Grounds 1A-1G: Amazon fails to show how DTB teaches both “content points” and “synchronization points.” .....28

        1. Amazon does not sufficiently explain how DTB teaches the recited “content points” of claim element 1[c][ii]. .... 28

        2. Amazon does not sufficiently explain how DTB teaches the recited “synchronization points” of claim element 1[e]. .... 29

E. Grounds 2A-2H: Amazon fails to show how McCartney teaches the claimed “descriptor file” or the claimed “synchronization points”/ “synchronized rendering.” .....29

    1. Amazon does not sufficiently explain how McCartney discloses or renders obvious the claimed “descriptor file.” ..... 30

F. Amazon gives the dependent claims short shrift. ....31

IV. CONSERVATION OF RESOURCES..... 33

V. CONCLUSION..... 36

## I. INTRODUCTION

Patent Owner Audio Pod IP, LLC (“Audio Pod”) respectfully requests that the Board deny institution of Amazon’s Petition<sup>1</sup> for *inter partes* review (IPR) of U.S. Patent No. 9,729,907 (“the ’907 patent”). Three entrepreneurial brothers and a friend with software backgrounds invented server-based, segmented streaming for use with audio book technology, so the brothers’ aging mother could continue to enjoy her passion for reading as her eyesight failed. Realizing their inventions represented fundamental technology breakthroughs, they sought patent protection for their inventions and formed Audio Pod to bring their technology to market.

Early on Amazon met with Audio Pod and expressed interest in the technology. But Amazon then incorporated the technology into their products without even speaking with Audio Pod after the meeting. Relying at least in part on Audio Pod’s innovations, Amazon established and expanded its dominant e-reader Kindle market position. That market presence thwarted all of Audio Pod’s efforts to build its business following its meeting with Amazon. Those realities, and the related IPRs, result from Amazon’s approach here to use its nearly unlimited resources to best Audio Pod – a small, innovative company.

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<sup>1</sup> The Petitioner entities are referred to collectively as “Amazon” herein for expediency.

The Petition merits are weak and do not support institution. Amazon did not even attempt to make the required minimum showing *in the Petition* that four non-patent literature references included in nine of the fifteen asserted grounds were prior art printed publications. Moreover, there are significant shortcomings in the proposed invalidity grounds, which are premised on claim construction positions that conflict with constructions that Amazon took in the parallel district court proceeding in the Eastern District of Virginia (EDVA). Amazon does not acknowledge that discrepancy. It does not provide any justification for the inconsistency. Amazon's conclusory assertions regarding motivation to combine and reasonable expectation of success throughout the Petition only exacerbate the weakness of the challenge.

Further still, for each of the asserted grounds challenging the independent claims, Amazon has failed to show at least one element of the claims. Grounds 1A-1G fail because Amazon does not sufficiently explain how the primary reference, DTB, teaches both "content points" and "synchronization points" as recited in claim 1. Notably, they impermissibly use the same DTB disclosure to allegedly teach both "content points" and "synchronization points." Grounds 2A-2H fail because Amazon fails to show that the primary reference, McCartney, teaches a descriptor file or the claimed synchronization points/synchronized rendering.

The dependent claims fare even worse, where Amazon provides only

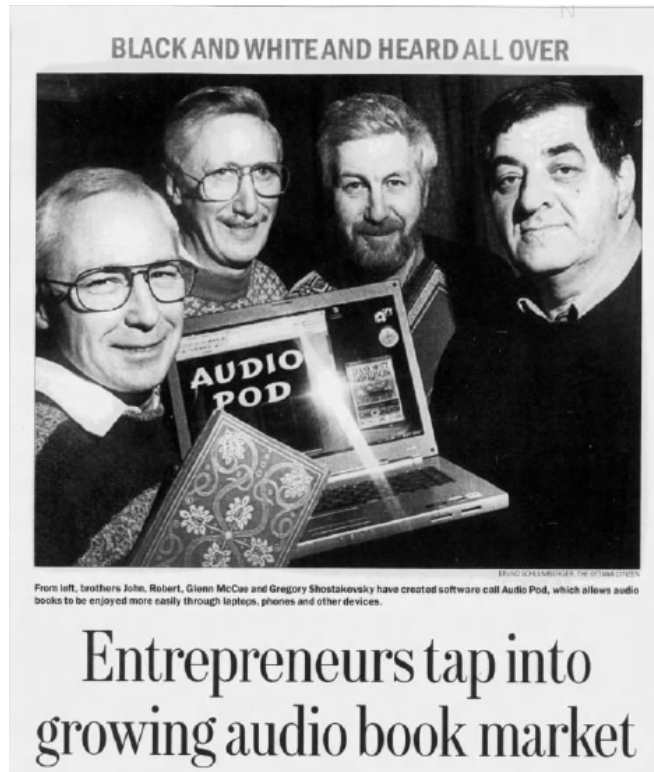
perfunctory discussion, or simply refers back to earlier claims while ignoring much of the claim language and failing to specifically point out how the claim elements are taught by the asserted references.

Finally, given the many deficiencies affecting the asserted grounds, even if the Board were to agree that Amazon has met its burden for a single claim or ground, the Board should exercise its discretion under the Board's informative *Chevron* and *Deeper* decisions and deny institution here.

## **II. BACKGROUND**

### **A. Audio Pod's founders invented key early media streaming technologies, including the inventions claimed in the '907 patent.**

Audio Pod's innovative concepts and early technology development was headlined in The Ottawa Citizen newspaper in January 2008.



EX2003, 1.

The news story recounts that, in the late 1990s, “John McCue began looking for a way to help his mother, Monica, continue her lifelong love affair with literature in spite of her failing eyesight.” EX2003, 1; EX2015, ¶6. He teamed up with senior software architect, and co-founder, Gregory Shostakovsky, as well as his brothers, Robert McCue and Glenn McCue. EX2003, 1; EX2015, ¶6. All four had computer science backgrounds. EX2003, 1.

They created a brilliant solution—a server-based, virtual approach to streaming audio across multiple devices:

Say, for example, you are in an airport departure lounge in a WiFi hotspot listening to a podcast or an audio book....

... Then your flight is called and you may lose your wireless Internet service while airborne.

But even without a wireless connection, Audio Pod's technology will allow you to pick up that story again on the plane exactly where you left off.

This is possible because Audio Pod's memory manager retains the content and is able to deliver it to the user seamlessly, even on a different device.

The technology is unique because it utilizes a digital virtual representation of the audio stream. This virtual approach eliminates the delays associated with mass downloads that could easily take eight to 10 hours for larger books, and it also eliminates the network dependence used by streaming technologies

EX2003, 2; *see also* EX2015, ¶6.

According to Mr. McCue's 2008 interview," [t]he hardest part in developing th[e] technology was devising a way to break up a media stream into a large number of manageable audio chunks that can then be played in perfect sequence."

EX2003, 2. Solving that problem unlocked a world of possibilities. "[T]he successful result provides users with a seamless audio experience for bookmarking and memory management in a way that allows the delivery of 'many, many media streams through very small devices using limited network resources' ...." *Id.* That benefit extended to any type of media stream, including, for example, handheld

messaging. *Id.*

The patent claims constitute foundational technology that make multi-media, multi-device streaming possible.

**B. Audio Pod disclosed their innovative technology to Amazon, but Amazon ignored their subsequent outreach attempting to partner or license, and Amazon instead implemented Audio Pod's technology on its own.**

The inventors formed Audio Pod Inc. in 2005. EX2015, ¶7; EX2001, ¶64; EX2002, ¶56. They had a working product, and in July 2007, the inventors had a lengthy meeting with Amazon and Brilliance Audio (an audiobook publisher acquired by Amazon in May 2007), who had expressed interest in Audio Pod's technology. EX2015, ¶¶9-10; EX2001, ¶¶68-69; EX2002, ¶¶60-61.

A small group from Amazon and Brilliance agreed to meet with Audio Pod. EX2015, ¶9. The meeting was originally scheduled for one hour; in fact, the Amazon team initially expressed disbelief that the technology would work. EX2015, ¶¶9-11. But, when Audio Pod presented a working product, the meeting extended to the entire day—with more and more Amazon/Brilliance representatives joining as the day went on. EX2015, ¶¶10-11. By the end, there was acknowledgement from the Amazon team that they had “never thought of using a central server.” EX2015, ¶11.

After the meeting, beyond a brief acknowledgement of a “thank you” email sent by the Audio Pod team, Amazon broke contact with Audio Pod, ignoring

repeated attempts by Audio Pod to follow up after the meeting. EX2015, ¶12.

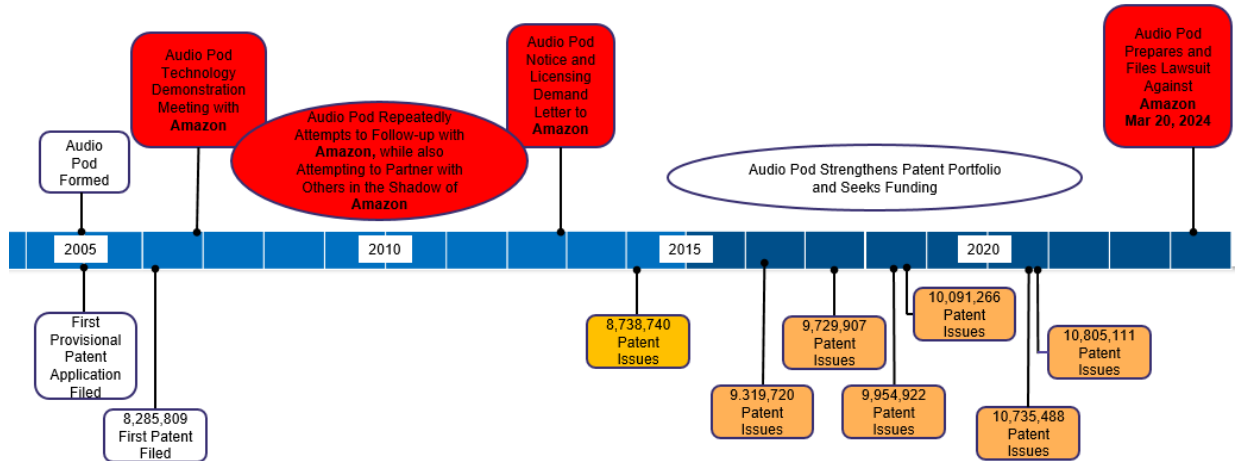
Amazon acquired Audible in 2008, and subsequently released “Whisper Sync for Voice” Kindle technology. *See* EX2013; EX2016. Through 2013, Audio Pod continued its efforts to partner with Amazon.

Audio Pod also marketed its technology to other companies in the industry, but Amazon, already a market giant, had cornered the market, limiting Audio Pod’s ability to compete. As Mr. McCue testifies:

It was common for us to present our technology and get the response “Amazon is already doing that” or concerns about having to compete with Amazon as a direct competitor.

EX2015, ¶17.

In sum, Amazon’s disregard for Audio Pod’s intellectual property led to Audio Pod’s infringement suit—a suit Audio Pod tried to avoid. The following timeline portrays the long road taken by Audio Pod to attempt to realize the benefit of its inventions in the face of Amazon’s stonewalling Audio Pod’s attempt to work together, while bringing Amazon’s strikingly similar and infringing audio book products to market. *See* EX2015, ¶¶6-17.



### III. THE PETITION FAILS TO ESTABLISH A REASONABLE LIKELIHOOD OF PREVAILING ON ANY CHALLENGED CLAIM.

Amazon cobbles together eleven references into fifteen alleged grounds of rejections. The Petition is fundamentally flawed, as Amazon has not even attempted to show *in the Petition* that several of the asserted references are prior art printed publications. In addition, Amazon improperly advances inconsistent claim construction positions in this IPR as compared to in the parallel district court proceedings. Further, Amazon’s obviousness analysis is fundamentally lacking. Amazon does not present a proper analysis under the *Graham* factors, nor does Amazon provide any reasoned analysis for its alleged motivations to combine the various references or as to reasonable expectation of success in making the combinations.

As to the specific challenges, Amazon fails to show that the asserted primary references DTB and McCartney, respectively, teach or render obvious both

“content points” and “synchronization points,” or “descriptor file” as recited in the independent claims. Further still, Amazon gives short shrift to the majority of the dependent claims, presenting only cursory analysis, if any at all, in alleging the dependent claims are obvious.

Based on the many deficiencies in the Petition described below, this IPR should be denied.

**A. Grounds 1A-1G, 2C, and 2F: Amazon fails to demonstrate in the Petition that DTB, Yoshimura, Bulterman, and Yang are prior art printed publications.**

Amazon has not even attempted to make the required minimum showing *in the Petition* that certain asserted references—DTB (EX1003), Yoshimura (EX1006), Bulterman (EX1007), and Yang (EX1045)—are prior art printed publications. This is particularly remarkable in that DTB is the primary reference relied upon in seven of the asserted grounds. In total, these references are included in 9 of Amazon’s 15 asserted grounds. *See* Pet., 5-6.

Board precedent requires that a petitioner establish a reasonable likelihood *in the petition* that a reference is a printed publication. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (P.T.A.B. Dec. 20, 2019) (precedential). Amazon has not met that burden here. Amazon provides *no* discussion supporting the alleged publication dates of these references, Pet., 5-6, nor does Amazon “discuss in the Petition *any* evidence supporting the implicit

position that the[se] [references] w[ere] *publicly accessible* prior to the critical date of the claimed invention.” *BabyBjörn AB v. The ERGO Baby Carrier, Inc.*, IPR2025-00110, Paper 20 at 14 (P.T.A.B. Apr. 22, 2025) (underlining added, other emphasis original). In *BabyBjörn*, as here, the petitioner submitted a declaration allegedly supporting the publication date and public accessibility of the reference at issue. *Id.* at 14. The Board declined to “search through the record to develop [p]etitioner’s arguments on th[e] issue.” *Id.* (citing *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) (“Judges are not like pigs, hunting for truffles buried in briefs.” (quoting *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991))).

The only evidence cited (without any discussion) by Amazon in support of the publication dates is a bare citation of “See EX-1097.” Pet., 5-6. Exhibit 1097, however, is a 44-page declaration from Sylvia D. Hall-Ellis, Ph.D. Not only does citing to the *entire declaration* with no accompanying explanation fall short of the requirement that “the petition identifies [the supporting evidence], in writing and *with particularity*,” 35 U.S.C. § 312(a)(3) (emphasis added), it also runs afoul of Rule 42.6(a)(3), which provides that “[a]rguments must not be incorporated by reference from one document into another document.” *See also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the

requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. § 312(a)(3)).

The Board should not consider Dr. Hall-Ellis’s testimony because the Petition includes no explanation of such testimony. *See* 37 C.F.R. § 42.104(b)(5) (“The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide, 35–36 (Nov. 2019) (“CTPG”) (citing *Cisco Systems, Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 (P.T.A.B. Aug. 29, 2014) (informative)) (“[P]arties that incorporate expert testimony by reference in their petitions ... without providing explanation of such testimony risk having the testimony not considered by the Board.”). Amazon simply has not met its burden under *Hulu* to show *in the Petition* a reasonable likelihood that these references are prior art printed publications. *See VMware, Inc. v. WSOU Investments, LLC*, IPR2021-00572, Paper 8 at 49-50 (P.T.A.B. Sept. 7, 2021) (determining that petitioner’s general cites to a declaration without identifying any specific portions thereof was insufficient to meet petitioner’s burden under *Hulu* that a prior art reference qualified as a printed publication, and that it amounted to an improper attempt to incorporate the testimony by reference).

Amazon simply has not met its burden under *Hulu* to show *in the Petition* a reasonable likelihood that these references are prior art printed publications.

Therefore, Grounds 1A-1G, 2C, and 2F, each of which relies on one or more of these references, must fail.

**B. All Grounds: Amazon advances inconsistent claim constructions here and in the District Court.**

Claims must be interpreted the same for invalidity and infringement: “It is axiomatic that claims are construed the same way for both invalidity and infringement.” *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988)). “A patent may not, like a ‘nose of wax,’ be twisted one way to avoid anticipation and another to find infringement.” *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (citing, among others, *White v. Dunbar*, 119 U.S. 47, 51 (1886)). Yet, Amazon attempts to do just that—applying a broader plain and ordinary meaning construction in this and related IPRs, while simultaneously proposing narrower constructions for several terms in the district court.

In particular, in this IPR, filed on May 13, 2025, Amazon asserted that “[n]o claim terms require construction.” Pet., 4. However, prior to filing the IPR, in the district court, the parties jointly submitted their claim construction positions.

EX2007. Unlike in the Petition which argues no construction is necessary,<sup>2</sup> in the district court, Amazon proposed constructions for several claim terms. EX2007. In fact, the EDVA court set a longer time-to-trial schedule based on Amazon's representation that it would conduct extensive claim construction proceedings, including introducing expert testimony.<sup>3</sup> EX2019; EX2010.

Amazon provides no explanation to justify the different positions taken in the two forums. That is improper. *Cf. Cambridge Mobile Telematics, Inc. v. Sfara*,

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<sup>2</sup> Across all of the IPRs filed against Audio Pod's patents, Amazon has not proposed construction for a single claim term. *See* IPR2025-00757 Pet., 12; IPR2025-00765 Pet., 7-8; IPR2025-00768 Pet., 6; IPR2025-00769 Pet., 6; IPR2025-00774 Pet., 5; IPR2025-00777 Pet., 5; IPR2025-01041 Pet., 6. In the district court proceedings on the other hand, Amazon contends many terms require construction. *See, e.g.*, EX2007. Notably, these petitions were filed both before and *after* Amazon's claim construction positions were submitted in the district court.

<sup>3</sup> The parties initially negotiated a schedule around an August 2025 *Markman* hearing and early 2026 trial. That schedule was pushed out when the Court could not schedule a *Markman* hearing until October 2025, and then a medical issue with Audio Pod's expert necessitated an additional extension to November 2025.

*Inc.*, IPR2024-00952, Paper 12 (P.T.A.B. Dec. 13, 2024) (informative) (denying institution where petitioner argued for a means-plus-function construction in district court and a plain and ordinary meaning construction in the petition but failed to explain the difference in claim construction positions).

Amazon puts Audio Pod and the Board in the untenable position of assessing Amazon's asserted grounds without an understanding of Amazon's true position as to the scope of the challenged claims. Amazon's approach is fundamentally unfair, and results in a certainty of inconsistent results between the Board and the district court. *See Kiosoft Techs., LLC v. PayRange, Inc.*, IPR2021-00086, Paper 12 at 16 (P.T.A.B. Mar. 22, 2021) (petitioner and its expert advocated for different constructions at the district court and the PTAB).

Amazon's inconsistent claim construction positions are likely one of the reasons Amazon relies on a different expert for the IPRs (Ketan Mayer-Patel, Ph.D.) than it does in the underlying litigation (Dan Schonfeld, Ph.D.). Audio Pod's expert (Kevin Almeroth, Ph.D.) provided an expert declaration addressing claim construction in the underlying litigation. He was deposed for the better part of a day on those issues on July 9 and July 22. And Dr. Schonfeld already provided two declarations related to claim construction. All that testimony arose from Amazon's positions on claim construction. Amazon neither identified nor addressed any of those positions in its various petitions.

**C. All Grounds: Amazon’s obviousness analysis is fundamentally lacking due to conclusory assertions regarding reasonable expectation of success and motivation to combine.**

In addition to specific reasons discussed below (Sections III.D-F), Amazon’s asserted grounds are deficient for failing to establish a *prima facie* case of obviousness for the modifications proposed for the independent claims and for the combinations of references it presents for the dependent claims. To show obviousness, Amazon must “demonstrate *both* that a skilled artisan would have been *motivated to combine* the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a *reasonable expectation of success* in doing so.” *Intelligent Bio-Sys., Inc.*, 821 F.3d at 1367–68 (internal citations omitted, emphasis added). To satisfy its burden, a petitioner must “articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness”—“mere conclusory statements” will not suffice. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Here, Amazon’s allegations both for motivation to combine and reasonable expectation of success are conclusory and insufficient.

**1. Amazon’s contentions regarding reasonable expectation of success are insufficient.**

Amazon’s contentions regarding reasonable expectation of success are insufficient. For example, as to a proposed modification to McCartney in Ground 2A for claim 1, Amazon asserts:

A POSITA would have been motivated to do so at least because it would make it easier to manage, review, share, access, and revise the information contained in the files. (*Id.*) Moreover, a POSITA would have had a reasonable expectation of success in combining the TSD and BPM files because McCartney explains that both TSD and BPM files can be processed by “an XML application,” meaning they share a compatible format. (EX-1013 ¶¶[0026], [0031]; EX-1002 ¶230.)

Pet., 50 (discussing element 1[a][i] descriptor file). Similarly, for claim 2 in Ground 1B, the sole basis for an expectation of success is that “both references [DTB and Yoshimura] disclose using the same file type (SMIL file) for the same purpose (synchronization of audio and text data).” Pet., 34.

As an initial matter, the allegation of reasonable expectation is legally insufficient. Even if the teachings of McCartney or DTB-Yoshimura are in fact “compatible,” “[m]ere compatibility of references is ... not sufficient” to support obviousness. *Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 17 (P.T.A.B. Oct. 16, 2018) (denying institution based on lack of showing of expectation of success; citing *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017)).

Moreover, there is no basis for concluding that Yoshimura and DTB disclosed compatible variants of SMIL or XML. And even if SMIL files were “widely known,” Pet., 19, Yoshimura’s system does not rely on SMIL files. It relies on something new: Yoshimura’s “*modified* SMIL files.” *See* Pet., 33

(emphasis added). Amazon does not address this distinction in discussing the reasonable expectation of success and provides insufficient evidence to support that a POSITA would have been able to implement Yoshimura’s specific variant in any other system.

Amazon’s contentions regarding reasonable expectation of success are similarly conclusory and deficient throughout the Petition’s other 14 asserted grounds. *See, e.g.*, Pet., 39 (Ground 1C, claim 7 “methods to automate page turning were commonplace and disclosed by numerous references, giving a POSITA a reasonable expectation of success in the modification.”), 42 (Ground 1D, claim 8 “segmenting audio based on natural language gaps was ‘merely one of several alternative straightforward possibilities which the skilled person would select[,]’ ‘notoriously well-known’, and disclosed by numerous references. A POSITA would have had a reasonable expectation of success in the modification.” (citation omitted)), 44 (Ground 1E, claim 14 “including text to be rendered within the SMIL file was commonplace and disclosed by numerous references, giving a POSITA a reasonable expectation of success in the modification”), 48 (Ground 1G, Claim 16 “server optimization based on failure conditions, network degradation, and throughput was commonplace and disclosed by numerous references, giving a POSITA a reasonable expectation of success in the modification.”), 66 (Ground 2B, claim 2 “storing descriptor files on servers was commonplace and disclosed in

other references, giving a POSITA a reasonable expectation of success in the modification.”), 67 (Ground 2B, claim 18 “A POSITA would have reasonably expected success in making the modification because storing and transferring media streams from remote servers was well known and conventional”), 69 (Ground 2C, claim 4 “A POSITA would have had a reasonable expectation of success in implementing the tracking because McCartney and DTB are related to similar systems using similar formats (e.g., XML/SMIL) and because tracking a position in a media stream was well known in the art.”).

Amazon’s conclusory statements regarding a reasonable expectation of success are insufficient for institution. *See, e.g., NJOY, LLC v. JUUL Labs, Inc.*, IPR2024-00536, Paper 17 (P.T.A.B. Aug. 12, 2024) (denying institution where petitioner did not show a reasonable expectation of success in combining the asserted references); *Honeywell Int’l Inc. v. DSM IP Assets, B.V.*, IPR2024-00493, Paper 7 (P.T.A.B. Aug. 21, 2024) (same).

**2. Amazon fails to perform a proper motivation to combine analysis under *Graham* for many dependent claims.**

Likewise, for many of the dependent claims, Amazon has failed to perform a proper motivation to combine analysis under *Graham*. *See Graham v. John Deere Co.*, 383 U.S. 1 (1966) (“*Graham*”). The three key factual inquiries set forth in *Graham* for establishing obviousness under 35 U.S.C. § 103(a) are: (1) determining the scope and content of the prior art, (2) ascertaining the differences

between the prior art and the claims at issue, and (3) resolving the level of ordinary skill in the pertinent art. *Graham*, 383 U.S. at 17-18. These factual inquiries must be tied together by “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977 at 988 (Fed. Cir. 2006)).

Here, Amazon’s motivation to combine arguments—or lack thereof—run afoul of the bedrock principles set forth in *Graham*. They fail to set forth the differences between the art and the claims, as required by the second factual inquiry under *Graham*. The second *Graham* factor necessarily involves an analysis of what the references and claims teach, and what is missing, and “requires a comparison of the properly construed claim to the prior art.” *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325 at 1332 (Fed. Cir. 2010). If a proposed ground of invalidity fails to identify the differences between the existing combination of prior art references (e.g., combination of References A and B) and the claimed invention, then such a ground necessarily fails to establish a *prima facie* case of obviousness, and the petition should be denied. *Id.*; *see also Apple, Inc. v. ContentGuard Holdings, Inc.*, IPR2015-00355, Paper 9 at 9 (P.T.A.B. June 26, 2015) (finding no reasonable likelihood of prevailing because “the Petition does not identify sufficiently the differences between the claimed invention and the prior art, or how the prior art teachings are to be modified or combined, if at all.”).

Therefore, the Board should deny institution because the Petition fails to satisfy at least the second factual inquiry under *Graham. Enzo Biochem*, 599 F.3d 1325 at 1332.

**3. Amazon’s alleged motivations are purely conclusory.**

Unpatentability determinations on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (citing *KSR*, 550 U.S. at 418)). “This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103.” *Id.* (citing *Kahn*, 441 F.3d at 988). Accordingly, ““a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine’ because ‘[t]his type of finding, without more, tracks the *ex post* reasoning *KSR* warned of and fails to identify any actual *reason* why a skilled artisan would have combined the elements in the manner claimed.”” *Id.* (citing *In re Van Os*, 844 F.3d 1359, 1361-62 (Fed. Cir. 2017)).

The Petitions proffered motivations to combine are plainly conclusory. They do not identify any alleged improvement, whether a POSITA would have recognized the possibility of that improvement, or why a POSITA would have combined the references to bring it about. But that simply restates the result of the

combination. Others do not even make an attempt to establish that a technique could have been applied in “the same way,” beyond a bare statement that it is so.

Examples of such insufficient motivation statements are reproduced below:

- “The combination represents using a known technique (e.g., storing SMIL files on servers) to improve a similar device and method (e.g., DTB’s ‘media units’ (hard drives)) in the same way.” Pet., 34.
- “The combination represents the use of a known technique (e.g., Yoshimura’s transfer of the SMIL file to the client) to improve a similar method (DTB’s navigation of media streams using a SMIL file) in the same way.” Pet., 35.
- “The combination uses a known technique (e.g., retrieving content from Yoshimura’s servers) to improve a similar method (e.g., DTB’s playback of a multimedia presentation) in the same way.” Pet., 36.
- “Third, the combination uses a known technique (e.g., Duncan’s automatic page turning) to improve a similar method (e.g., DTB’s rendering of a digital talking book) in the same way.” Pet., 38-39.
- “Fourth, the combination uses a known technique (e.g., Heckerman’s synchronization offsets) to improve a similar method (e.g., rendering DTB’s digital talking book) in the same way.” Pet., 41.
- “Fourth, the combination uses a known technique (e.g., Bulterman’s

inclusion of text to be rendered in the SMIL file) to improve a similar method (e.g., DTB's SMIL file) in the same way." Pet., 43-44.

- "Third, the combination uses a known technique (e.g., Yang's just-in-time retrieval) to improve a similar method (e.g., DTB's retrieval of information identified in a SMIL file) in the same way." Pet., 46.
- "Third, the combination uses a known technique (e.g., Copley's server optimization) to improve a similar method (e.g., DTB's presentation of multimedia as modified by Yang) in the same way." Pet., 48.
- "The combination uses a known technique (e.g., server storage) to improve a similar method (e.g., McCartney's computer storage) in the same way." Pet., 66.
- "Third, the combination uses a known technique (e.g., DTB's progress tracking/marking) to improve a similar method (e.g., McCartney's TOAC rendering) in the same way." Pet., 68.
- "Fourth, the combination uses a known technique (e.g., providing automated page turns) to improve a similar method (e.g., McCartney's rendering of book content) in the same way." Pet., 72.

Other proffered motivations based upon application-of-a-known-technique are even more deficient. They do not address whether or how a POSITA would have recognized that a device was "ready for improvement." *See* M.P.E.P.

§ 2143(I)(D). Nor does the Petition ever mention “finding that the prior art contained a known technique that is applicable to the base device (method, or product).” *Id.* The following examples result from such deficiencies:

- “The combination represents using a known technique (e.g., storing SMIL files on servers) to improve a similar device and method (e.g., DTB’s ‘media units’ (hard drives)) in the same way.” Pet., 34.
- “The combination further applies a known technique (e.g., storing SMIL files on servers) to a known device and method (e.g., DTB’s SMIL files) that is ready for improvement and yields predictable results (e.g., DTB’s SMIL file stored on a server).” Pet., 34.
- “The combination represents the use of a known technique (e.g., Yoshimura’s transfer of the SMIL file to the client) to improve a similar method (DTB’s navigation of media streams using a SMIL file) in the same way.” Pet., 35.

Others rely on a “simple addition,” which is not a motivation in and of itself. When the alleged combination requires an addition, the motivation must result from a desire to improve the device. M.P.E.P. § 2143. The Petition cites *KSR*, 550 U.S. at 417. Indeed, to show obviousness, *KSR* requires that “[t]he two [disclosures] in combination did no more than they would in separate, sequential operation.” *Id.* But the Petition provides no analysis as to why any proposed

addition would be simple or obtain predictable results. It simply describes the resulting combination, as illustrated in the following examples:

- “The combination represents merely the simple addition of one known element (e.g., Yoshimura’s servers) with other known elements (e.g., DTB’s client device and SMIL file) to obtain predictable results (e.g., a SMIL file stored on a server accessible to the client device).” Pet., 33-34.
- “Moreover, the combination represents the simple addition of one known element (e.g., downloading content from a server as in Yoshimura) to another known element (e.g., DTB’s player) to obtain a predictable result (a player that can down-load content remotely).” Pet., 36.
- “Third, the combination represents the simple addition of one known element (e.g., Heckerman’s synchronization offsets) to another known element (e.g., DTB’s system) to obtain a predictable result (e.g., synchronizing in dependence on natural language or inter-word gaps).” Pet., 40.
- “Third, the combination represents merely the simple addition of one known element (e.g., Bulterman’s text included directly in the SMIL file) to another known element (e.g., DTB’s SMIL file) to obtain

predictable results (e.g., a more efficient SMIL file).” Pet., 43.

- “Second, the combination represents merely the simple addition of one known element (e.g., Copley’s server optimization) to another known element (e.g., DTB’s player as modified by Yang) to obtain predictable results (e.g., presentation of multimedia via multiple servers).” Pet., 48.
- “Moreover, the combination represents merely the simple addition of one known element (e.g., server storage) to another known element (e.g., McCartney’s system) to obtain predictable results (e.g., descriptor files stored on a server).” Pet., 66.
- “Second, the combination represents merely the simple addition of one known element (e.g., DTB’s progress tracking/markings) to another known element (e.g., McCartney’s system) to obtain predictable results (e.g., tracking progress while rendering content on TOAC).” Pet., 68.
- “Third, the combination represents merely the simple addition of one known element (e.g., automatic page turns) to another known element (e.g., McCartney’s rendering) to obtain predictable results (e.g., rendering content using automatic page turns).” Pet., 72.

In terms of predictable results, some are purely conclusory; others apply

circular reasoning to state that the combination would include elements of each reference in combination. The Petition never explains why the results would have been predictable. That approach vitiates the meaning of the standard. The following are thus deficient:

- “The combination applies a known technique (e.g., Yoshimura’s transfer of the SMIL file to the client) to a known method (e.g., DTB’s navigation of media streams using a SMIL file) that is ready for improvement and yields predictable results (e.g., local access to the SMIL file).” Pet., 35.
- “The combination applies a known technique (e.g., Yoshimura’s retrieval of content from a remote site) to a known method (e.g., DTB’s playback of a multimedia presentation) that is ready for improvement and yields predictable results (e.g., retrieval of content from a remote source).” Pet., 36.
- “Fifth, the combination applies a known technique (e.g., inclusion of the text to be rendered within the SMIL file) to a known method (e.g., DTB’s method SMIL file) that is ready for improvement and yields predictable results (e.g., a SMIL file with less likelihood for delay or broken links).” Pet., 44.
- “Fourth, the combination applies a known technique (e.g., Yang’s

object retrieval) to a known method (DTB's delivery of content) that is ready for improvement and yields predictable results (e.g., prefetched objects)." Pet., 46.

- "Second, the combination represents merely the simple addition of one known element (e.g., Copley's server optimization) to another known element (e.g., DTB's player as modified by Yang) to obtain predictable results (e.g., presentation of multimedia via multiple servers)." Pet., 48.
- "The combination applies a known technique (e.g., server storage) to a known method (e.g., McCartney's computer storage) that is ready for improvement and yields predictable results (e.g., descriptor files saved on a server)." Pet., 66.

In short, the obviousness rationales are incomplete and conclusory. They derive from a robotic application of MPEP standards to each limitation and are supported only by a few words in parentheses. None offer any actual or discernable motivation that distinguishes between finding and matching isolated words or concepts in a hindsight approach to create combinations. Accordingly, Amazon has not met its burden to show a motivation to combine the references in any of these grounds. *Magnum Oil*, 829 F.3d at 1380.

**D. Grounds 1A-1G: Amazon fails to show how DTB teaches both “content points” and “synchronization points.”**

Amazon fails to identify how DTB teaches both “content points” as recited in element 1[c][ii] and “synchronization points” as recited in element 1[e]. These are distinct elements of claim 1. Amazon cites to different portions of text in DTB. But it fails to articulate how any particular alleged “point” in DTB corresponds to a content point or to a synchronization point, or why a POSITA would have relied upon the same aspects of DTB as teaching those distinct claim elements.

**1. Amazon does not sufficiently explain how DTB teaches the recited “content points” of claim element 1[c][ii].**

Amazon asserts that DTB’s “parallels” correspond to the recited “content points.” Pet., 13. But it does not provide any explanatory analysis. DTB denotes those parallels using the following syntax: “<par>” and “</par>.” Amazon flatly asserts that DTB uses parallels to coordinate elements for simultaneous playback. Pet., 13 (citing EX1003, 26). But DTB only expressly discloses that parallels “group[]” text, audio, and image data. EX1003, 21, 26. Amazon does not sufficiently explain if or how DTB’s “parallels” relate to any alleged content points within a digital audio narration. Rather, it simply states it is so. Amazon’s declarant provides no further analysis on this point, as the declaration is essentially a *verbatim* copy of the Petition. See EX1002, ¶¶62-65; *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. Aug. 24, 2022) (repeating

“verbatim” conclusory assertions from the Petition in a declaration is conclusory and unsupported, and therefore entitled to little weight).

**2. Amazon does not sufficiently explain how DTB teaches the recited “synchronization points” of claim element 1[e].**

Amazon relies on similar information within DTB’s SMIL file as teaching the alleged content point and the claimed synchronization point, without sufficient explanation as to how this information teaches both. Merely citing short snippets of code, without accompanying explanation, is insufficient to disclose separate limitations of claim 1. Amazon’s declarant provides no further analysis on this point, as the declaration is essentially a *verbatim* copy of the Petition. *See* EX1002, ¶¶69-74; *Xerox*, IPR2022-00624, Paper 9 at 15.

\* \* \*

For at least these reasons, Amazon has not shown that DTB renders obvious independent claim 1. Independent claim 21 includes similar limitations. Therefore, Amazon’s asserted Ground 1A fails as to independent claims 1 and 21. Amazon, likewise, has not made a sufficient showing for dependent claims 2-20 at least due to their dependency from independent claim 1.

**E. Grounds 2A-2H: Amazon fails to show how McCartney teaches the claimed “descriptor file” or the claimed “synchronization points”/ “synchronized rendering.”**

Claim element 1[a][i] recites “creating a descriptor file for synchronizing a plurality of digital media streams.” And claim elements 1[e] and 1[g] recite

“identifying synchronization points in the digital media content of the one or more other digital media streams” and “storing the synchronization time offsets and the synchronization points in the descriptor file in a manner indicating a correlation between the synchronization time offsets and the synchronization points, such that the descriptor file allows a synchronized rendering of the plurality of digital media streams on a client device.” Amazon does not explain how McCartney discloses or renders obvious either of these limitations.

**1. Amazon does not sufficiently explain how McCartney discloses or renders obvious the claimed “descriptor file.”**

Amazon points to McCartney’s synchronization files (e.g., TSD file and BPM file) as allegedly teaching the claimed “descriptor file.” Pet., 49-50.

McCartney describes creating multiple “synchronization files.” EX1013, ¶¶26 (“first synchronization file”), 31 (“second synchronization file”), 35 (“third synchronization file”). But Amazon does not sufficiently explain how these teachings interrelate. It does not explain how they constitute or render obvious a descriptor file for synchronizing a plurality of digital media *streams*.

Nor does Amazon explain how or why a POSITA would have combined the HTML text file and audio clips of McCartney into a “descriptor file” as claimed. Amazon’s declarant provides no further analysis on this point, as the declaration is essentially a *verbatim* copy of the Petition. See EX1002, ¶¶226-231; *Xerox*, IPR2022-00624, Paper 9 at 15.

For at least these reasons, Amazon has not shown that McCartney renders obvious independent claim 1. Independent claim 21 includes similar limitations. Therefore, Amazon's asserted Ground 2A fails as to independent claims 1 and 21. Amazon, likewise, has not made a sufficient showing for dependent claims 2-20 at least due to their dependency from independent claim 1.

**F. Amazon gives the dependent claims short shrift.**

Amazon's analysis for the majority of the dependent claims is completely lacking, providing only perfunctory discussion and ignoring much of the claim language. Amazon bears the burden to show each element of the claim is taught or suggested in the prior art and they have not done so here. Audio Pod provides a non-exhaustive list of examples here.

Claim 2 recites "storing the descriptor file on a server that is accessible to the client device." According to the specification, the server is accessed via a network. EX1001, 3:21-34. In Ground 1A, the Petition states that "DTB discloses playback of multimedia presentations 'over the Internet,' which a POSITA would have understood involves retrieving content not originally resident on the client device." Pet., 19 (citing EX1003, 21; EX1002 ¶86). However, the portion of DTB that Amazon cites only states "[SMIL] was developed ... as a standard for definition and playback of multimedia presentations over the Internet." EX1003, 21. The media unit that DTB uses for distribution is a CD-ROM. EX1003, 2

(defining “Media Unit. A single object on which a DTB is stored for distribution to the reader. For example, a single CD-ROM disk.”), 29, 40, 55, 56, 58, 59. In Ground 1A, Amazon does not sufficiently explain why it would have been obvious for a POSITA to turn away from the CD-ROM storage method used in DTB and switch to a client accessible server. *See* Pet., 19. In Ground 1B, Amazon attempts to combine Yoshimura and DTB to fill in the missing limitation of a server. *See* Pet., 33. However, the SMIL file described in Yoshimura is a modified SMIL file. EX1006, 1785 (“SMIL modification”) and Amazon does not explain how the modified SMIL file described in Yoshimura would be combined with DTB let alone how a modified SMIL file renders obvious the descriptor file described in claim 2.

In Ground 2A, Amazon states that since the computer that stores the TOAC program can contain a server, the descriptor file is located on a server for at least a short period of time. However, McCartney states specifically that the TOAC is implemented “by a software application that is loaded from a storage device and resides in the memory 144 of the computer.” EX1013, ¶25.

For several additional dependent claims, the Petition provides no independent analysis, simply referring back to prior discussion provided in connection with the independent claims. *See, e.g.*, Pet., 20 (Ground 1A, claim 3), 23 (Ground 1A, claim 7[a]), 28 (Ground 1A, claim 13), 30 (Ground 1A, claim 17),

37 (Ground 1B, claim 19), 61 (Ground 2A, claim 3), 64 (Ground 2A, claims 17, 18), 70 (Ground 2C, claims 5, 6). “The presence of a dependent claim that adds a particular limitation raises a presumption that the limitation in question is not found in the independent claim.” *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 806 (Fed. Cir. 2007) (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004)). But Amazon provides no additional explanation for these dependent claims.

#### **IV. CONSERVATION OF RESOURCES**

If the Board finds that Amazon fails to meet its burden for less than all of the Challenged Claims and/or proposed grounds, the Board should deny institution to conserve resources.

Audio Pod identifies numerous deficiencies in Amazon’s arguments in the discussion above. Should the Board determine that Amazon met its burden for some claims or Grounds, but failed to meet its burden for other claims or Grounds, the Board should still deny institution to conserve the Board’s valuable resources. *See* Interim Processes for PTAB Workload Management Memorandum (March 26, 2025) (“March 26, 2025 Memo”), 3; *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10–11 (P.T.A.B. Nov. 7, 2018) (informative); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (P.T.A.B. Jan. 24, 2019)

(informative); *see also* Interim Director Discretionary Process<sup>4</sup>, I.F. (Board panel may address “whether a petition presents a sufficient number of grounds/challenges of claims that meet the reasonable likelihood standard,” as explained in *Chevron* and *Deeper*).

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless ... the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” But even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims, institution of review remains discretionary. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review ....” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). 35 U.S.C. § 316(b) also provides that, when determining whether to exercise its discretion, the Board should consider the effect of any regulations on “the efficient administration of the Office [and] the ability of the Office to timely complete proceedings.” Additionally, 37 C.F.R. § 42.1(b) provides that the Board should also take into

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<sup>4</sup> <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>

account the requirement to construe the rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” The Trial Practice Guide also explains that the Board may consider the number of claims and grounds that meet and do not meet the reasonable likelihood standard when deciding whether to institute *inter partes* review under 35 U.S.C. § 314(a). CTPG, 64 (“[T]he panel will evaluate all the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system, the entire petition should be denied.”).

Here, should the Board determine that Amazon failed to meet its burden of establishing unpatentability for some but fewer than all of the challenged claims of the '907 patent as discussed in Section III, the Petition should still be denied in order to conserve the Board’s valuable time and resources. March 26, 2025 Memo, 3; *Deeper*, IPR2018-01310, Paper 7 at 43 (finding that because Petitioner only demonstrated a reasonable likelihood of prevailing with respect to a subset of the 23 challenged claims, “instituting a trial with respect to all twenty-three claims ... would not be an efficient use of the Board’s time and resources.”). Similarly, should the Board determine that Amazon has failed to meet its burden of establishing unpatentability for some but not all grounds, the Petition should again be denied in order to conserve the Board’s valuable time and resources. March 26, 2025 Memo, 3; CTPG, 64; 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

**V. CONCLUSION**

The Petition fails to show a reasonable likelihood that any of the challenged claims is unpatentable as obvious in view of the cited art and, therefore, the Board should deny institution.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

//Michael D. Specht//

Michael D. Specht  
Registration No. 54,463  
Attorney for Patent Owner

Date: September 15, 2025

1101 K Street, NW  
10th Floor  
Washington, DC 20005  
(202) 371-2600

**CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))**

1. This Patent Owner Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 7,369 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14-point Times New Roman font.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

//Michael D. Specht//

Michael D. Specht  
Registration No. 54,463  
Attorney for Patent Owner

Date: September 15, 2025

1101 K Street, NW  
10th Floor  
Washington, DC 20005  
(202) 371-2600

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

I certify that the above-captioned **PATENT OWNER PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107(A)** was served in its entirety on September 15, 2025, upon the following parties via electronic mail:

Colin B. Heideman (Lead Counsel) [2cbh@knobbe.com](mailto:2cbh@knobbe.com)  
Joseph R. Re (Back-up Counsel) [2jrr@knobbe.com](mailto:2jrr@knobbe.com)  
Jeremy A. Anapol (Back-up Counsel) [2jaa@knobbe.com](mailto:2jaa@knobbe.com)  
Christie R.W. Matthaei (Back-up Counsel) [2crw@knobbe.com](mailto:2crw@knobbe.com)  
Nathan D. Reeves (Back-up Counsel) [2ndr@knobbe.com](mailto:2ndr@knobbe.com)  
Logan P. Young (Back-up Counsel) [2lpy@knobbe.com](mailto:2lpy@knobbe.com)  
Daniel Hughes (Back-up Counsel) [2dph@knobbe.com](mailto:2dph@knobbe.com)  
KNOBBE, MARTENS, OLSON & BEAR, LLP  
[BoxSEAZNL2185L2LP@knobbe.com](mailto:BoxSEAZNL2185L2LP@knobbe.com)

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

//Michael D. Specht//

Michael D. Specht  
Registration No. 54,463  
Attorney for Patent Owner

Date: September 15, 2025

1101 K Street, NW  
10th Floor  
Washington, DC 20005  
(202) 371-2600