

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM SERVICES LLC,

Petitioner,

v.

SMART SPEAKER LLC,

Patent Owner.

Patent No. 11,190,590
Filing Date: May 30, 2018
Issue Date: November 30, 2021

Inventors: Yehuda Binder and Benjamin Maytal
Title: SYSTEM AND METHOD FOR SERVER BASED CONTROL

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

Case No. IPR2026-00148

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Exhibit No.	Description of Document
2001	Plaintiff's Disclosure of Asserted Claims and Infringement Contentions in <i>Smart Speaker LLC v. Amazon.com Servs. LLC</i> , Case No. 2:25-cv-00707-JRG (E.D. Tex.), dated September 16, 2025
2002	Defendant's Invalidity and Subject Matter Eligibility Contentions in <i>Smart Speaker LLC v. Amazon.com Servs. LLC</i> , Case No. 2:25-cv-00707-JRG (E.D. Tex.), dated December 9, 2025
2003	Federal Register, Vol. 90, No. 199, dated Friday, October 17, 2025
2004	Second Amended Docket Control Order (Dkt. 33) in <i>Smart Speaker LLC v. Amazon.com Servs. LLC</i> , Case No. 2:25-cv-00707-JRG (E.D. Tex.), dated October 29, 2025
2005	Letter to Amazon.com, Inc. re May Patents Ltd. Patent Portfolio, dated July 23, 2024
2006	Appeal Statistics, Patent Trial and Appeal Board, dated October 31, 2025
2007	Patent Trial and Appeals Board (PTAB) data at a glance December 2025

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025, Memorandum Regarding Interim Processes for PTAB Workload Management (“Process Memorandum”), Smart Speaker LLC (“Patent Owner”) files this Request for Discretionary Denial of Institution.

On November 22, 2025, Amazon.com Services LLC (“Petitioner”) submitted a Petition (Paper 2, “Petition,” or “Pet.”) requesting *inter partes* review (“IPR”) of U.S. Patent No. 11,190,590 (Ex. 1001, the “590 Patent”), challenging Claims 1-36 and 38-63 (the “Challenged Claims”). The Petition identifies co-pending district court litigation *Smart Speaker LLC v. Amazon.com Servs. LLC*, No. 2:25-cv-00707 (E.D. Tex.) (the “District Court Litigation”).

The Director should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel District Court Litigation and the Petition involve the same parties; (ii) the District Court Litigation involves the same patent and the same claims; (iii) the Petition is weak and overly reliant on expert testimony, and Petitioner does not reasonably contend any error was made during prosecution; (iv) a motion to stay the District Court Litigation has not been filed and would not likely be granted; (v) the Petitioner delayed in filing the Petition and the parties are significantly invested in the District Court Litigation; (vi) trial in the District Court Litigation will be approximately contemporaneous with the

projected statutory deadline for any FWD; (vii) the PTAB's resources are better spent on *ex parte* appeals; (viii) the '590 Patent has been in force for over 4 years and settled expectations have been created; and (ix) no changes in the law support reconsideration of patentability.

For the reasons set forth herein, the Director should exercise discretion to deny the Petition.

II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

The circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding"; (c) "proximity of the court's trial date to the Board's projected statutory deadline for a final written decision"; (d) "investment in the parallel proceeding by the court and the parties"; (e) "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted"; and (f) "other circumstances that impact the Board's exercise of discretion, including the merits.").

As set forth below, these factors along with the Process Memorandum collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)) (denying Petition because institution would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.”).

A. The Parallel District Court Litigation and the Petition Involve the Same Parties

As Petitioner notes, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the '590 Patent). Pet. at 99. The District Court Litigation involves causes of action asserting the '590 Patent against Petitioner's products, which include, *inter alia*, Amazon's Alexa-enabled smart speaker products including the Amazon Echo, Amazon Echo Dot, Amazon Echo Dot Kids, Amazon Echo Dot with Clock, Amazon Echo Glow, Amazon Echo Look, Amazon Echo Plus, Amazon Echo Pop Kids, Amazon Echo Pop, Amazon Echo Show, Amazon Echo Show 15, Amazon Echo Show 21 Amazon Echo Show 5, Amazon Echo Show 8, Amazon Echo Spot, Amazon Echo Studio, Amazon Fire TV Cube, Amazon Fire TV, Amazon Glow, Amazon Tap, Carrera Smart Glasses with

Alexa, Echo Auto, Echo Buds, Echo Flex, Echo Frames, Echo Hub, Echo Input, and Echo Loop. *See* Ex. 2001 at 2-3. *Apple Inc.*, IPR2020-00019, Paper 15 at 15 (P.T.A.B. May 13, 2020) (when “the petitioner and the defendant in the parallel proceeding are the same party,” that fact weighs in favor of discretionary denial).

Accordingly, this factor weighs strongly in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims and Petitioner’s Stipulation Does Not Mitigate These Concerns

There is substantial overlap between the claims and grounds at issue in this Petition and the District Court Litigation because the Petition challenges the same claims asserted in the District Court Litigation under the same grounds. *See* Ex. 2001 at 1; Pet. at 1. For example, each of the fifteen Grounds raised in the Petition are also raised as invalidity defenses in Petitioner’s invalidity contentions served in the District Court Litigation. *See* Ex. 2002 at 79-99; Pet. at 9. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Further, although this Petition formally concerns only the ’590 Patent, it does not arise in isolation: the ’590 Patent is one of six related Asserted Patents being litigated together against Petitioner in the District Court Litigation, and Petitioner

has filed parallel Petitions challenging three of the other Asserted Patents.¹ The district court will manage invalidity, expert discovery, and trial preparation across *all* the Asserted Patents on an integrated schedule. Instituting parallel PTAB proceedings on a subset of these Asserted Patents at the PTAB while other Asserted Patents proceed on similar timelines in district court invites duplicative briefing, duplicative expert disputes, inconsistent outcomes, and layered estoppel and stipulation disputes that do not meaningfully simplify the District Court Litigation. These are precisely the inefficiencies that *Fintiv* and the Process Memorandum aim to prevent. *Fintiv* at 12-13; Process Memorandum at 2-3.

Petitioner's conditional *Sotera* stipulation does not mitigate these inefficiency concerns in view of the substantial but nonetheless incomplete overlap between the PTAB proceedings and the District Court Litigation. As noted, of the six related patents asserted in the District Court Litigation, Petitioner has challenged only four of those patents at the PTAB. *See* IPR2026-00145, -00146, and -00147. Petitioner has relied on largely the same set of prior art in support of its invalidity contentions for the two patents asserted in District Court Litigation that are not challenged via

¹ *See Amazon.com Servs. LLC v. Smart Speaker LLC*, IPR2026-00145; *Amazon.com Servs. LLC v. Smart Speaker LLC*, IPR2026-00146; and *Amazon.com Servs. LLC v. Smart Speaker LLC*, IPR2026-00147.

IPR as Petitioner does for the four patents that it has challenged via IPR.² Thus, Petitioner’s *Sotera* stipulation in this IPR proceeding does little (if anything) to mitigate against the concerns of duplicative briefing and expert disputes, and inconsistent outcomes on the many issues common across the invalidity grounds raised against these six related patents in the district court and before the PTAB. *See Fintiv* at 12-13. The Director has rejected similar conditional or narrow stipulations that fail to eliminate inefficiencies, particularly when the other *Fintiv* factors favor denial. *See, e.g., Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (P.T.A.B. Dec. 1, 2020) (precedential); *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 4 (P.T.A.B. Mar. 28, 2025). The subsequent March 24, 2025 guidance memorandum from Chief Administrative Patent Judge Boalick further confirmed a *Sotera* stipulation is not “dispositive by itself.” Guidance Memorandum at 3. As the USPTO has emphasized, such parallel challenges “can add significant expense and delay compared with standalone district court litigation” and undermine the AIA’s goal of making IPRs an “alternative” rather than a duplicate. Ex. 2003, at 2.

Accordingly, this factor weighs strongly in favor of discretionary denial.

² *See* Ex. 2002 at 99-117 for U.S. Patent No. 12,401,720 and 117-141 for U.S. Patent No. 12,401,721.

C. The Petition Is Weak and Overly Reliant on Expert Testimony

Separately, the Petition’s unpatentability challenge is weak, supporting denial. The Petition does not assert any anticipation. *See* Pet. at 9; *see also Fintiv*, at 8 (considering “other circumstances that impact the Board’s exercise of discretion, including the merits.”). Rather, the Petition asserts a patchwork of **fifteen** obviousness grounds combining **eleven** different references, strongly weighing in favor of discretionary denial. Pet. at 9. Further, the Petitioner relies on an expert declaration spanning **317 pages, 595 paragraphs**, and over **58,000 words** in an effort to backfill the many gaps in those eleven references. Discretionary denial is routinely granted even where far fewer grounds and references are offered in a Petition. *See, e.g., Hisense USA Corp. v. Light Guide Innovations LLC*, IPR2025-01537, Paper 7 at 3 (P.T.A.B. Nov. 21, 2025) (granting discretionary denial where petition relied on seven combinations of six references), Paper 10 (P.T.A.B. Jan. 16, 2025); *Hisense USA Corp. v. Light Guide Innovations LLC*, IPR2025-01526, Paper 7 at 2-3 (P.T.A.B. Nov. 21, 2025) (granting discretionary denial where petition relied on four combinations of five references), Paper 10 (P.T.A.B. Jan. 16, 2025).

Moreover, as Petitioner admits, “[t]he application faced multiple Office Actions and an *ex parte* appeal before the Board.” Pet. at 4. As such, the claims of the ’590 Patent have already been subject to rigorous examination and review by the

PTAB. Further, Petitioner is wrong in its assertion that the Examiner misunderstood the PTAB's decision in the *ex parte* proceeding as "allow[ing]" the language in dependent Claim 32. Pet. at 1. The Examiner did not misunderstand the PTAB's decision. The PTAB was "persuaded that the Examiner erred in rejecting dependent claim 32" because the Examiner relied on "disparate findings from different embodiments" to reject dependent Claim 32 as anticipated. Ex. 1003 at 197. The PTAB subsequently reversed the Examiner's rejection of the claim. *Id.* at 197-198 ("[b]ecause this issue is dispositive regarding our reversing the Examiner's rejection of these claims . . ."). Petitioner argues that the PTAB's reversal was only with respect to Examiner's anticipation analysis, and that the Examiner then failed to consider obviousness for the claim language in dependent Claim 32 in subsequent prosecution. Petitioner's characterization of the record, however, is incorrect. In the subsequent Notice of Allowance, the Examiner stated that "all Claims 1-64 are hereby rejoined and **fully examined for patentability under 37 CFR 1.104.**" Ex. 1003 at 34 (emphasis added). Examination under 37 CFR 1.104 requires searching for examining prior art for potential obviousness rejections, which is precisely what the Examiner did. In the Examiner's search conducted after the *ex parte* proceeding before the PTAB, the Examiner cited thirteen prior art references as part of the Examiner's search and examination. *Id.* at 36. If the Examiner had determined that any of those thirteen prior art references rendered the claims obvious as amended

after the PTAB appeal, the Examiner would have issued an obviousness rejection in another office action—which did not occur. Thus, Petitioner cites to no real or reasonable “error” on the part of the Examiner during prosecution. The Examiner, taking the Board’s decision, associated reasoning, and subsequently-cited prior art references, determined that “disparate findings from different embodiments” did not warrant an additional office action based on obviousness.

Further, Petitioner relies on the same types of ideas the Examiner and Board already confronted during prosecution (*e.g.*, a current sensor coupled to an AC connector for measuring current, a single enclosure housing the current sensor and other electronics, controlling an appliance in response to digital data received from a wireless network)—yet the Petitioner merely swaps in different references for these same ideas without introducing any fundamentally different teaching that undercuts the Examiner’s reasoning. *See, e.g.*, Pet. at 23-26, 30-32, and 36-37. For example, the Examiner previously searched for and analyzed prior art directed to systems and methods for server-based control of client and controlled devices, including *Sharood*, *Legaspi*, *Rada*, *Kiko*, and *Hendrickson*, and issued explicit reasons for allowance explaining that even the closest art, alone or in combination, did not teach or motivate the methods claimed in the ’590 Patent. Ex. 1003, 34. The Petition’s new references—*Chan*, *Botts*, *Scherz*, *Middelhoek*, *Goldsmith*, *Rossing*, *Benesty*, *Fraden*, *Doherty*, *Ozturk*, *Seo*, and *Betts-LaCroix*—fit within that same

technical space and confirm only that the field was at best beginning to experiment with server-based control of appliances using digital data received in single enclosures comprising wireless transceivers. However, none of the new references provide a direct teaching of the particular methods the Examiner found nonobvious.

Under the precedential *Advanced Bionics* framework, when the same or substantially the same prior art and arguments have already been considered by the Office, the petitioner must identify how the Office erred in a manner material to patentability. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 7-10 (P.T.A.B. Feb. 13, 2020). Petitioner does not contend that the Examiner misunderstood the core references, misapplied the law, or overlooked a teaching in the new references that tracks the allowed claims. At most, the Petition asserts that a different combination of cumulative references—and *significant* expert hindsight—would have produced a different outcome. That is not the type of material error that justifies reopening patentability in a parallel IPR.

The weakness of the Petition's merits is further confirmed by its heavy reliance on expert testimony. Petitioner submits more than **317 pages, 595 paragraphs**, and over **58,000 words**, of expert declaration to supply motivations to combine, map disparate disclosures onto the claim language, and bridge gaps that the references do not and cannot fill. *See* Ex. 1002. Discretionary denial is also routinely granted in this circumstance, where a Petitioner overly relies on expert

testimony to fill in holes in the prior art. *See, e.g., CrowdStrike, Inc. v. Skysong Innovations, LLC*, IPR2025-01399, Ex. 2010 at 17-18 (P.T.A.B. Dec. 6, 2025) (discretionary denial request granted where Petition relied on 150-paragraph, 20,000-word expert declaration), Paper 12 (P.T.A.B. Jan. 16, 2026); *BOE Tech. Grp. Co. v. Paneltouch Techs. LLC*, IPR2025-01483, Paper 7 at 8 (P.T.A.B. Nov. 24, 2025) (discretionary denial request granted where Petition relied on 201 pages of expert testimony), Paper 10 (P.T.A.B. Jan. 16, 2026). Indeed, that level of expert reconstruction is a sign that the prior art does not speak for itself and that the obviousness case is, at best, a close and highly fact intensive dispute. The USPTO's own Interim Processes recognize that such expert-driven contests, particularly when built on cumulative art already considered in substance, are better resolved in the advancing District Court Litigation rather than through a duplicative PTAB proceeding. *See* FAQs for Interim Processes for PTAB Workload Management, #22.

D. A Motion to Stay Has Not Been Filed and Is Unlikely to Be Granted

Amazon has not sought a stay of the District Court Litigation pending IPR proceedings, and any future stay motion is unlikely to be granted. The Eastern District of Texas, and Judge Gilstrap specifically, routinely deny motions to stay pending IPR proceeding when the PTAB instituted review on less than all asserted claims of *all asserted patents*. *See, e.g., AGIS Software Dev. LLC v. Google LLC*,

No. 2:19-CV-00361, 2021 WL 465424, at *2 (E.D. Tex. Feb. 9, 2021); *see also Arthrex, Inc. v. Medshape, Inc.*, IPR2025-00053, Paper 11, 9 (P.T.A.B. Apr. 25, 2025) (agreeing stay less likely when parallel proceedings involve patents not the subject of a petition). Here, Amazon has not filed validity challenges against two of the six Asserted Patents in the District Court Litigation, and thus a stay cannot be considered “likely” under *Fintiv*. *Fintiv* at 5-6.

Moreover, the timing of any future stay request ensures that the motion would not be resolved until after the parties have invested substantial additional resources, and likely not before the *Markman* hearing. Ex. 2004. In this posture, a stay is also unlikely.

At best, the likelihood of a stay would require serial speculation that: the Director would assume institution, the Petitioner files a stay motion, and the district court grants that motion, despite a general tendency to deny stay motions covering less than all asserted patents and having likely already held a *Markman* hearing, opened fact discovery, and set a firm trial date. That stack of contingencies is the opposite of the straightforward, schedule-based assessment called for by *Fintiv*. *See Samsung Elecs. Co. v. Vasu Holdings, LLC*, IPR2025-00446, Paper 12, 2 (P.T.A.B. July 10, 2025) (granting discretionary denial where, *inter alia*, “there is insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial”).

Accordingly, this factor weighs strongly in favor of discretionary denial.

E. Petitioner’s Delay in Filing the Petition and Significant Investment

The Petitioner’s delay in filing the Petition and the parties’ investment in the parallel proceeding also weighs strongly in favor of discretionary denial. Petitioner was put on notice of the ’590 Patent at least as of July 23, 2024, when Petitioner received a notice letter from Patent Owner alleging that Petitioner’s products infringe claims of the ’590 Patent. Ex. 2005. Petitioner then delayed *sixteen months* before filing the Petition. Patent Owner reasonably relied on Petitioner’s inaction in challenging the ’590 Patent in preparing and filing the District Court Litigation.

Further, in the District Court Litigation, the parties have already exchanged infringement and invalidity contentions. Ex. 2004. Fact discovery is underway, including costly source code review, and the parties will only be further along into fact discovery as of the expected decision on institution on May 27, 2026. *Id.*

Accordingly, the Petitioner’s delay in filing the Petition and the parties’ and Court’s substantial investment in the District Court Litigation weighs strongly in favor of denial of institution.

F. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision also strongly weighs in favor of discretionary denial. The parties’ trial is scheduled for June 7, 2027. Ex.

2004. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is May 27, 2027.³ As the District Court’s trial will be approximately contemporaneous with the earliest projected statutory deadline, this factor weighs in favor of denying institution. *See Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9, 2-3 (P.T.A.B. June 12, 2025) (granting discretionary denial where the projected final written decision due date was within sixteen days of the scheduled trial date because “even though a district court trial date that occurs after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings”). As of the earliest date the parties could theoretically expect a Final Written Decision on this Petition, the parties will be on the eve of trial in the District Court Litigation. Ex. 2004. There will thus be essentially no efficiencies gained with respect to costs

³ Patent Owner will file a timely preliminary response on February 27, 2026. The statutory deadline for institution is May 27, 2026, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for a Final Written Decision is August 27, 2027, “not later than 1 year after the date on which the Director notices the institution of a review.”

expended by the parties and court in having a Final Written Decision at most slightly before trial. Further, any delays in the issuance of a Final Written Decision under 35 U.S.C. § 316(a)(11) would almost certainly result in the Final Written Decision issuing after trial in the District Court Litigation.

Accordingly, this factor strongly weighs in favor of discretionary denial.

G. PTAB Resources Are Better Spent on *Ex Parte* Appeals

The Director should also deny institution because its limited resources are better spent on the growing backlog of *ex parte* appeals. In 35 U.S.C. § 6(b)(1), the PTAB is tasked with “review[ing] adverse decisions of examiners upon applications for patents pursuant to section 134(a).” Congress also tasked the PTAB with reviewing appeals of reexaminations, derivation proceedings, IPRs, and PGRs. 35 U.S.C. § 6(b)(2)-(4). Current Office policy is to focus on *ex parte* appeals “[t]o ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings, the Director will exercise her discretion on institution of AIA proceedings” Process Memorandum. The Board should exercise that discretion here because the pendency of *ex parte* appeals has increased over the last year and year-over-year since Fiscal

Year 2022. *See* Ex. 2006, 7 and Ex. 2007, 2. The PTAB should focus its efforts on the pending *ex parte* appeals—not this IPR.

Accordingly, this factor strongly weighs in favor of discretionary denial.

H. Settled Expectations of the Parties

The '590 Patent was granted November 30, 2021, over four years before Petitioner brought this action. *See* '590 Patent. The '590 Patent also claims priority to an application from 2012, which is over thirteen years before Petitioner filed its Petition—as such, Patent Owner has settled expectations as to validity of the '590 Patent. *Id.* As the PTAB has observed, “the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Sols. Inc. v. AXA Powers Aps*, IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025). Further, while “actual notice of a patent or of possible infringement is not necessary to create settled expectations,” here, as discussed above, Petitioner *had* actual notice of the '590 Patent since at least the July of 2024 notice letter and failed to challenge the patent’s validity until after the District Court Litigation had been filed. *Id.*

Accordingly, this factor weighs in favor of discretionary denial.

I. No Changes in the Law Support Reconsideration of Patentability

No change in law justifies reconsidering the '590 Patent claims’ validity.

When viewing all of these factors collectively together, the Petition should be denied in the Director’s discretion under 35 U.S.C. § 314(a).

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: January 28, 2026

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 3,697 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Request for Discretionary Denial of Institution and Exhibits 2001 through 2007 been served on Petitioner's counsel of record as follows:

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