UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMAZON WEB SERVICES, INC.
AND AMAZON.COM SERVICES LLC,
Petitioners,

v.

Zentian Limited
Patent Owner.

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Case IPR2023-01197
Patent No. 10,971,140

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**PATENT OWNER'S SUR-REPLY IN SUPPORT OF ITS PRELIMINARY
RESPONSE AND CONTINGENT JOINDER OPPOSITION**

EXHIBIT LIST

Exhibit No.	Description
2001	Amazon's District Court Amended Invalidity Contentions
2002	Scheduling Order in *Zentian Ltd. v. Amazon.com, Inc.,* 6:22-cv-00123 (W.D. Tex.)
2003	Correspondence between counsel for Zentian and Amazon re: *Sotera* stipulation

Amazon's analysis of the *Fintiv* factors and the *Sotera* stipulation issue is inaccurate, and the Board should not institute unless Amazon at least agrees not to pursue the same grounds and prior art presented in the Petition in the parallel district court proceeding.

Fintiv factor 1 weighs against institution: there is no stay of the proceedings before the district court, nor is there any expectation of a stay.

Fintiv factor 3 also weighs against institution. As *Fintiv* explained, "if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial" of the Petition. *Fintiv* at 9–10. Here, the district court has already issued a *Markman* order construing the claims. *See* 6:22-cv-00123, Dkt. 66 (June 20, 2023). Contrary to Amazon's assertions, factor 3 thus favors denial.

Fintiv factor 4 also strongly weighs against institution. This factor is directed to "overlap between issues raised in the petition and in the parallel proceeding," *not* to a comparison between the date for the final written decision and the district court trial date, as Amazon contends. *See* Paper 8 at 1-2. As demonstrated in the POPR, Amazon's invalidity contentions before the district

court raise effectively all of the same key prior art references as Amazon's petition before the Board. Accordingly, factor 4 weighs against institution.

Fintiv factor 5 also weighs against institution because the same parties are involved before the Board and the district court. Contrary to Amazon's assertion, factor 5's impact is not "slight," and this factor should be given due weight in the Board's analysis.

As for factor 2, the close proximity between the date for the Board's final written decision and the district court's trial date should weigh against institution here. Nonetheless, factors 1 and 3-5 plainly weigh against institution, and factor 2's effect in the overall analysis is thus minimal in any event.

Finally, with respect to *Fintiv* factor 6, Amazon's arguments are unavailing. *Zhuhai v. Maxell* did not hold that a time-barred follow-on petitioner such as Amazon need not adopt a *Sotera* stipulation when it seeks to join a proceeding in which the lead petitioner obtained institution in part by offering a *Sotera* stipulation. IPR2022-00984, Paper 8 at 4. *Zhuhai* did not address that issue at all. Amazon's reliance on *Zhuhai* for the general proposition that a *lead* petitioner need not adopt a *Sotera* stipulation in order to obtain institution has no persuasive value in this context. The question is not whether Apple was *required* to adopt a *Sotera* stipulation; the point is that Apple *did* do so, and thereby avoided the "compelling

merits" standard at the institution phase and benefited its ability to obtain

institution. It would be entirely unfair and prejudicial for Amazon to now obtain

institution of its time-barred petitions through the discretionary process of joinder

without also being bound by an appropriate *Sotera* stipulation. And while Amazon

contends that it would not be estopped before the district court from raising

"grounds that could have reasonably been raised in the Petition," Paper 8 at 3,

citing *Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1027 (Fed.

Cir. 2020), the Board should *at a minimum* require, as a condition to institution,

that Amazon agree not to pursue in the parallel district court proceeding the same

grounds and prior art references that have been presented in the Petition. To the

extent Amazon refuses to provide that stipulation, the Board should respectfully

deny institution.

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Respectfully submitted,

/s/ *Peter Knops*

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Date: November 15, 2023

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