

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SOUNDCLEAR TECHNOLOGIES LLC,
Patent Owner.

Case No. IPR2025-00345
U.S. Patent No. 9,031,259

**PETITIONER'S SUR-REPLY TO PATENT OWNER'S REPLY ON
DISCRETIONARY DENIAL**

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UPDATED LIST OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 9,031,259 to Yamabe (“the ’259 patent”)
1002	Prosecution History of U.S. Patent No. 9,031,259
1003	Declaration of Stuart Lipoff (“Lipoff”)
1004	CV of Stuart Lipoff
1005	U.S. Patent Appl. Pub. No. 2011/0026730 to Li et al (“Li-730”)
1006	U.S. Patent Appl. Pub. No. 2012/0027219 to Kale et al. (“Kale”)
1007	U.S. Patent Appl. Pub. No. 2011/0135107 to Konchitsky et al. (“Konchitsky”)
1008	U.S. Patent Appl. Pub. No. 2010/0111329 to Namba et al. (“Namba”)
1009	U.S. Patent Appl. Pub. No. 2012/0197638 to Li et al. (“Li-638”)
1010	U.S. Patent Appl. Publ. No. 2012/0128187 to Yamada et al. (“Yamada”)
1011	U.S. Patent Appl. Pub. No. 2010/0303267 to Pedersen et al. (“Pedersen”)
1012	U.S. Patent Appl. Pub. No. 2012/0022373 to Tateyama (“Tateyama”)
1013	U.S. Patent No. 8,615,392 to Goodwin et al. (“Goodwin”)
1014	<i>SoundClear Technologies LLC v. Google LLC</i> , Case No. 1:24-cv-00729, Complaint for Patent Infringement (E.D. VA May 1, 2024) (Dkt. No. 1)
1015	<i>SoundClear Technologies LLC v. Google LLC</i> , Case No. 2:24-cv-00321, Order Granting Motion to Stay Pending <i>Inter Partes</i> Review (E.D. VA Mar. 31, 2025) (Dkt No. 84) (“Court Order”)

Exhibit	Description
1016	<i>SoundClear Technologies LLC v. Amazon.Com, Inc</i> , Case No. 2:24-cv-00320, Order Granting Motion to Stay Pending <i>Inter Partes</i> Review (E.D. VA Jul. 1 2025) (Dkt. No. 56)
1017	Patent Assignment Recordation
1018	Andrew Karpan, <i>Amazon And Google Face New Suits Over Japanese Patents</i> , Law360 (Jul. 26, 2024)

I. Settled Expectations Do Not Warrant Discretionary Denial

Patent Owner now argues in its Discretionary Reply (Paper 11, “Reply”) that “settled expectations strongly favor denial” because the ’259 patent issued ten years ago. Reply, 1. Patent Owner does not argue, however, that settled expectations outweigh the District Court’s order staying the parallel litigation pending the IPR Proceedings. Nor could it.

In fact, none of the cases Patent Owner cited involved the key fact here—a parallel litigation stayed pending resolution of the underlying IPR proceeding, and prior to entering a scheduling order. Nor do any of those cases suggest that settled expectations outweigh such stays—let alone the stay of a litigation involving no trial date, minimal investments, and a lack of overlapping issues. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 2, 75 (Jan. 9, 2025) (no parallel litigation); *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 7, 5-8 (Apr. 29, 2025) (no stay; trial date scheduled); *Ericsson Inc. v. Procomm*, IPR2024-01452, Paper 13, 3-4 (May 28, 2025) (stay denied); *see also* Paper 15, 3 (June 25, 2025) (“inefficiency and settled expectations tip the balance in favor of discretionary denial.”).

The fact that parallel litigations in *Cambridge Indus. USA, Inc. v. Applied Optoelec* and *Amazon.com, Inc. v. Virtamove, Corp.* were stayed does not provide a complete picture. *Cambridge Indus.* was stayed *after* the court entered a

scheduling order and the parties filed opening, responsive, and reply claim construction briefs. IPR2025-00443, Paper 8, 20 (Apr. 28, 2025). And *Amazon* was stayed for reasons unrelated to pending IPRs. IPR2025-00561, Paper 11, 2 (July 11, 2025). So neither case is analogous to the discretionary considerations at issue here.

The facts here also weigh against settled expectations. The Director has been clear that “[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date” including where a patent was “in force for years” but wasn’t “commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space.” *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (these “considerations [] weigh against a patent owner’s claim of settled expectations and bear[] on the Director’s discretion.”). Such is the case here. First, Petitioner was not on notice of the ’259 patent at least because Patent Owner is a non-practicing entity that only recently acquired and began asserting the patent. Opposition at 1, 5-6; Ex. 1017; *see also* Ex. 1018 (confirming the patent was not previously commercialized). Patent Owner does not dispute this. *See generally* Reply. The District Court’s Order granting a stay pending IPR confirms the same. Ex. 1015, 6 (“it is undisputed that SoundClear is a non-practicing entity (‘NPE’) which ... *does not directly compete* with Google.” (emphasis added)). Second, Patent Owner acquired the ’259 patent

in September 2023 (Ex. 1017), less than eight months before asserting it, and could not have reasonably developed settled expectations in that timeframe.

Accordingly, settled expectations do not weigh in favor of discretionary denial or outweigh the other factors favoring institution, as set forth in the Opposition. *See e.g. Stingray Group Inc. v. Edwin Hernandez-Mondragon*, IPR2025-00349, Paper 19, 7 (June 13, 2025) (referring and instituting IPR on seven year old patent); *Globus Medical, Inc. v. Spinelogik, Inc.* IPR2025-00226, Paper 8 (June 12, 2025) (referring petition challenging 8 year old patent to panel).

II. Patent Owner’s Clarification Confirms that *Fintiv* Factor 2 Favors Institution

Factor 2 still favors institution because trial cannot precede a Final Written Decision (“FWD”). Ex. 1015, 7-8. Patent Owner appears to cast aside its original representation that trial would occur 9 months before a FWD. Paper 5, 10-13. It now argues that if institution is denied in August, that a trial would commence 5 months thereafter. Reply, 2-3. This hypothetical is inapposite because it doesn’t explain how trial would commence *before a FWD*. It is also absurd to assume trial could begin 5 months after the stay is lifted given the early stage of the litigation.

III. Conclusion

The Petition should be referred to the panel for further consideration on the merits.

Date: July 22, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **SUR-REPLY TO PATENT OWNER'S REPLY ON DISCRETIONARY DENIAL** was served electronically via email on July 22, 2025, in its entirety on the following:

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