

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

SOUNDCLEAR TECHNOLOGIES, LLC ,  
Patent Owner.

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

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**PETITIONER'S OPPOSITION TO PATENT OWNER'S  
DISCRETIONARY DENIAL BRIEF**

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**UPDATED LIST OF EXHIBITS**

<b>Exhibit</b>	<b>Description</b>
<b>1001</b>	U.S. Patent No. 9,031,259 to Yamabe (“the ’259 patent”)
<b>1002</b>	Prosecution History of U.S. Patent No. 9,031,259
<b>1003</b>	Declaration of Stuart Lipoff (“Lipoff”)
<b>1004</b>	CV of Stuart Lipoff
<b>1005</b>	U.S. Patent Appl. Pub. No. 2011/0026730 to Li et al (“Li-730”)
<b>1006</b>	U.S. Patent Appl. Pub. No. 2012/0027219 to Kale et al. (“Kale”)
<b>1007</b>	U.S. Patent Appl. Pub. No. 2011/0135107 to Konchitsky et al. (“Konchitsky”)
<b>1008</b>	U.S. Patent Appl. Pub. No. 2010/0111329 to Namba et al. (“Namba”)
<b>1009</b>	U.S. Patent Appl. Pub. No. 2012/0197638 to Li et al. (“Li-638”)
<b>1010</b>	U.S. Patent Appl. Publ. No. 2012/0128187 to Yamada et al. (“Yamada”)
<b>1011</b>	U.S. Patent Appl. Pub. No. 2010/0303267 to Pedersen et al. (“Pedersen”)
<b>1012</b>	U.S. Patent Appl. Pub. No. 2012/0022373 to Tateyama (“Tateyama”)
<b>1013</b>	U.S. Patent No. 8,615,392 to Goodwin et al. (“Goodwin”)
<b>1014</b>	<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)
<b>1015</b>	<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”)

<b>Exhibit</b>	<b>Description</b>
<b>1016</b>	<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 )

## **I. Introduction**

Faced with the reality that all parallel litigations are stayed pending resolution of the IPRs, Patent Owner manufactures discretionary denial theories not only divorced from the Board’s precedent and mandates, but also the facts.

There is no potential for overlap, and thus no concerns of inefficiency, between the proceedings: (1) The District Court stayed the parallel litigation “pending resolution of [this IPR and pending IPR2025-00344],” (2) it also stayed the *Amazon* litigation “pending resolution of Google’s IPR Petitions before the PTAB,” and (3) both stays occurred prior to entering a scheduling order, and before any meaningful investment by the parties. Ex. 1015, 4-8; Ex. 1016, 5, 8.

None of the “other” considerations support denial. Patent Owner’s attorney argument of a “weak” Petition contradicts the evidence. It is undisputed that the prior art here was not considered during prosecution and discloses the identified allowable subject matter. *See* Petition (Pet.) at 96. And, while it should be irrelevant, Petitioner had no actual or constructive notice of the ’259 patent before Patent Owner asserted it—Patent Owner does not contend otherwise.

Accordingly, the Director should reject Patent Owner’s arguments and refer the Petition to the panel for evaluation on the merits. Doing so would improve patent quality by providing a more efficient means to adjudicate patent validity issues, as Congress intended, and comport with law and the precedent.

## II. The *Fintiv* Factors Favor Institution

### A. Factor 1: The Parallel Litigation is Stayed

Factor 1 strongly favors institution because the parallel litigation between Patent Owner and Petitioner has been stayed “pending resolution of the IPR.” Ex. 1015, 7-8. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 6 (Mar. 11, 2020) (precedential) (“[a] district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts”); *ResMed Corp. v. Cleveland Medical Devices, Inc.*, IPR2025-00158, Paper 11 at 8-9 (June 13, 2025) (Finding Factor 1 favored institution because there was “no dispute that Petitioner sought and obtained a stay”); *see also id.* at Paper 10, 2 (referring Petition to Panel for evaluation on the merits because the parallel litigation was stayed).

Patent Owner tellingly omitted the Court Order granting Google’s motion for a stay from its request because it belies its assertions here. The Court thoughtfully considered the merits of a stay and found that (1) “the ‘stage of litigation factor favors issuing a stay’” because “no Rule 16(b) scheduling order has been entered, discovery has not begun, and no trial date has been set”; (2) “if instituted by the PTAB, will ‘undoubtedly simplify the issues in this case’”; and (3) “it is undisputed that SoundClear is a non-practicing entity (“NPE”) which

holds the patents at issue but does not directly compete with Google” and would not “be subject to undue prejudice for purposes of the stay factors.” Ex. 1015, 4-7.

Despite clear Board precedent, and the Court’s Order confirming that resolution through IPR serves the court’s goals of economy and efficiency, Patent Owner argues Factor 1 is “neutral” because “if the Director denies institution, then the stay would be lifted.” Paper 5 at 24. This is not the test for Factor 1—rather, Factor 1 asks whether a stay *has been* granted. The Board does not operate on speculation, and Factor 1 does not contemplate what might happen if a stay is lifted. Such an analysis would render the Factor 1 inquiry moot because stays are lifted following resolution of an IPR—be it at the institution or final written decision stage. Accordingly, Patent Owner’s arguments miss the mark and Factor 1 strongly favors institution.

**B. Factor 2: No Trial Date has been Scheduled**

Factor 2 strongly favors institution because no trial date has been set. In fact, “no Rule 16(b) scheduling order has been entered” and the parallel proceeding, by Court Order is stayed “pending resolution of inter partes review proceedings.” Ex. 1015, 4, 8. *ResMed Corp.* IPR2025-00158, Paper 11, 8-9 (rejecting patent owner’s request for discretionary denial where the parallel litigation was stayed and no trial date had been set); *Stingray Group Inc. v. Edwin Hernandez-Mondragon*, IPR2025-00349, Paper 19, 7 (June 13, 2025) (“Under the second *Fintiv* factor, the

proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision weighs against exercising our authority to deny institution because there is no trial date scheduled.”) (citing *Fintiv*, Paper 11, 9).

In a troubling departure from the facts of this case and Board precedent, Patent Owner argues that “*Fintiv* Factor 2 strongly favors denial” because “median time-to-trial statistics suggest that the two parallel district court cases will proceed to trial by January 2026 [which is] 9 months before final written decision is due.” Paper 5 at 10-12; *see also Id.* at 12 (“if the Petition is instituted, a Final Written Decision would be due in October 2026. That is 9 months after the projected district court trial date.”). But the Court Order staying the parallel litigation is clear—no trial date will be scheduled, and no trial would ever proceed until *after* the IPR proceedings conclude. Ex. 1015, 4 (“Moreover, no Rule 16(b) scheduling order has been entered, discovery has not begun, and no trial date has been set”), 7-8. It simply does not compute that a trial could or would proceed in the parallel litigation before a FWD issues in this (or the related) IPR proceeding. Patent

Owner’s illogical arguments are at best, misleading, and at worst an abuse of process.<sup>1</sup>

Even assuming Patent Owner acted in good faith in arguing that the trial-statistics should outweigh clear evidence that the trial will not occur until after resolution of the IPR proceedings, the Board has been equally clear that such statistics may be consulted but are not controlling. *See e.g.*, Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” at 3 (the Board *may* consider trial statistics). Here, the case is stayed “pending resolution of the IPR proceedings” and has no Rule 16(b) scheduling order —thus, there is no scenario in which a trial would occur prior to a Final Written Decision.

Patent Owner’s other arguments related to prejudice (see Paper No. 5 at 13-15) are completely divorced from the relevant inquiry under Factor 2 (i.e., whether a trial will proceed to a Final Written Decision), and otherwise fail to undercut the weight of the facts. Furthermore, the District Court already found there is no undue

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<sup>1</sup> Patent Owner’s lack of candor before the Board is troubling, particularly in light of its failure to provide important evidence (e.g., the Court’s Order Granting Motion to Stay) and false narrative regarding the status and implications of the parallel litigation.

prejudice: “SoundClear is a non-practicing entity (“NPE”) which holds the patents at issue but does not directly compete with Google” and would not be “unduly prejudiced” by staying the litigation pending resolution of the IPR proceedings. Ex. 1015, 6-8. Moreover, “[t]he Federal Circuit has made clear that by itself, the passage of time is not sufficient to conclude that the non-moving party will suffer evidentiary prejudice.” Ex. 1015, 7 (citing *Sec. First Innovations, LLC v. Google LLC*, No. 2:23cv97, 2024 WL 234720, at \*1 (E.D. Va. Jan. 22, 2024) (internal citations omitted)). Accordingly, Factor 2 strongly favors institution.

**C. Factor 3: The Parallel Litigation “is still in the early stages”**

Factor 3 strongly favors institution because the parties have not exchanged contentions, discovery has not begun, and no *Markman* has taken place. The Court Order says it best:

Although it has been pending ten months since service of the Complaint, this litigation is still in the early stages. Due to the pending motion to dismiss, Google has not yet answered. Moreover, no Rule 16(b) scheduling order has been entered, discovery has not begun, and no trial date has been set.

Ex. 1015, 4-5.

Once again, in a baseless rejection of the facts, Patent Owner argues that Factor 3 “should weigh in favor of discretionary denial” because Petitioner availed itself of routine litigation practices such as filing a motion to dismiss the parallel

proceeding. Paper 5 at 25-27. Patent Owner *does not* argue that the parallel proceeding is at an advanced stage, nor does it argue that Petitioner failed to exercise diligence in filing the instant IPR—the relevant inquiries under Factor 3. This alone demonstrates that institution is warranted under Factor 3. Indeed, the Court rejected Patent Owner’s argument that such filings and any associated delay in the litigation, were prejudicial (Ex. 1015, 5-7). Moreover, the Board has consistently held that Factor 3 favors institution where investments in a parallel proceeding are nominal, as is the case here. *Stingray Group Inc.*, IPR2025-00349, Paper 19, 7; *see also Id.* at 10 (“regardless of Petitioner’s reasons for timing of Petition filing, ‘[i]n view of our finding that the [Ohio case] was *in an early stage prior to the stay*, the timing of the filing of the Petition does not weigh in favor of exercising discretion to deny institution.’” (emphasis added)) (citing *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 12–13 (Oct. 21, 2020) (precedential as to Section II.A).)

Accordingly, Petitioner’s undisputed diligence in filing the instant IPR and the early stage of the parallel proceeding strongly favor institution.

**D. Factor 4: There Are No Overlapping Issues With The Parallel Litigation**

Factor 4 strongly favors institution because the parties have not exchanged contentions and the parallel litigation is stayed “pending resolution of the IPR.” As

the Court Order explains, “the IPR proceedings have the potential to dispose of all of the claims as to two of the patents, possibly eliminating two of the three counts in the Complaint” and will “undoubtedly simplify the issues in this case.” Ex. 1015, 5-6 (internal citation omitted). Thus, there are no concerns of overlap under Factor 4.

Despite this, Patent Owner argues that “[t]he lack of *Sotera* or *Sand* stipulation in the district court cases raises ‘concerns of inefficiency and the possibility of conflicting decision’ between the district court and the Board. Paper 5, 28-29. Patent Owner’s argument misses the mark because there are no concerns of inefficiency where as here, the parallel litigation has been stayed prior to a Rule 16(b) scheduling order, discovery, and *Markman*. Ex. 1015, 5. In fact, the Court granted a stay prior to institution “precisely” because it wished to prevent the parties from “necessarily engag[ing] in litigation efforts that would be duplicative of their efforts before the PTAB.” Ex. 1015, 6 (internal citations omitted).

Patent Owner’s arguments also ignore that Petitioner will be estopped from raising any grounds that were raised or reasonably could have been raised following a Final Written Decision. Thus, a stipulation was not warranted in the instant proceeding because the stayed litigation “allays concerns about inefficiency and duplication of efforts.” *Fintiv, Inc.*, IPR2020-00019, Paper 11, 6; *ResMed Corp.*, IPR2025-00158, Paper 11 at 12 (“In any event, we agree with Petitioner that

because the Ohio case is stayed, there is no danger of overlap, and if any challenged claims were to survive, Petitioner would be estopped under 35 U.S.C. § 315 from bringing any invalidity challenge that was raised or reasonably could have been raised during the IPR.”) (internal citation omitted); *see also id.* at Paper 10, 2 (referring Petition to Panel for evaluation on the merits because the parallel litigation was stayed). Accordingly, Factor 4 weighs strongly in favor of institution.

**E. Neither of Factors 5 or 6, Alone or Combined, Outweigh Factors 1-4.**

It is undisputed that Petitioner is defendant in the parallel litigation and that under such circumstances, Factor 5 traditionally favors discretionary denial. On balance, however, this factor alone is insufficient to grant Patent Owner’s request for discretionary denial. *ResMed Corp.*, IPR2025-00158, Paper 11 at 12, 14; *see also id.* at Paper 10, 2 (referring Petition to Panel for evaluation on the merits because the parallel litigation was stayed).

As to Factor 6, Patent Owner argues that the Petition is “weak,” but fails to identify a deficient mapping for any independent claim. Paper 5, 33-49. Instead, Patent Owner alleges that Petitioner’s arguments are conclusory—despite the Petition citing prior art references and supporting expert testimony for each claim limitation. Patent Owner also alleges that the Petition is “technically flawed”

because of purported errors (clerical and otherwise) in Kale and Li's disclosure. Paper 5, 34-42. But Mr. Lipoff squarely addressed any apparent errors. *See e.g.*, Ex.1003, ¶71 fn. 3 ("In Figure 8, element 830 is erroneously marked "DOA" and should read "IFFT module" or "IFFT." Kale, [0028]."). Moreover, Patent Owner's arguments that a POSITA (*see e.g.* Paper 5, 34-35) might have interpreted the alleged inconsistencies in the prior art differently from how Mr. Lipoff, are unsupported by evidence.

Patent Owner also argues that the Petition "gives insufficient notice of Google's unpatentability grounds." Paper 5, 42-44. This is categorically false as the Petition unmistakably articulates the Grounds for unpatentability at the outset of the petition (Pet. at 1) and explains which reference is being relied on (and how) for each claim limitation. *See generally* Pet. Finally, Patent Owner argues that Petition "fail[s] to provide a prima facie case under Graham." Paper 5, 44-49. Tellingly, Patent Owner *does not* argue that the claims are non-obvious over the combinations advanced in the Petition. Indeed, none of the references cited in the Petition were previously presented to or evaluated by the Examiner, and Patent Owner does not dispute that Kale and Li-730 disclose the allegedly allowable subject matter corresponding to [1d] identified by the Examiner during prosecution. Ex. 1002, 35-36; *see generally* POR. Thus, the asserted Grounds show the Examiner erred in allowing the claims because the references were not before

them. Moreover, Patent Owner's misgivings over the adequacy of Petitioner's analysis are unfounded, naked attorney argument, and thus insufficient to overcome Petitioner's analysis.

### **III. Conclusion**

Petitioner has established a reasonable likelihood of prevailing for the challenged claims and requests the Director deny Patent Owner's request for discretionary denial and refer the Petition to the panel for further consideration on the merits.<sup>2</sup>

Date: July 9, 2025

Respectfully submitted,

/Erika H. Arner/  
Erika H. Arner, Lead Counsel  
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<sup>2</sup> Petitioner reserves the right to challenge the March 26, 2025 Interim Process for PTAB Workload Management at least because it is legally invalid as (1) exceeding the Director's authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

**CERTIFICATE OF COMPLIANCE**

The undersigned hereby certifies that the foregoing **Opposition to Patent Owner's Discretionary Denial Brief** contains 2,398 words, excluding those portions identified in 37 C.F.R. § 42.24(a), as measured by the word-processing system used to prepare this paper.

/Erika H. Arner/  
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**CERTIFICATE OF SERVICE**

The undersigned certifies that a copy of the foregoing **PETITIONER'S  
OPPOSITION TO PATENT OWNER'S DISCRETIONARY DENIAL  
BRIEF** was served electronically via email on July 9, 2025, in its entirety on the  
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