

**From:** [Director Discretionary Decision](#)  
**To:** [Aguilar, Safiya](#); [Director Discretionary Decision](#); [Steve Reynolds](#)  
**Cc:** [DI-SoundClear](#); [Bell, Cory](#); [Hines, Lisa](#); [Arner, Erika](#); [Young, Michael](#); [Google-Soundclear-IPRs](#)  
**Subject:** RE: IPR2025-00345 (U.S. Patent No. 9,031,259) - Request for Leave to File Reply  
**Date:** Friday, July 18, 2025 9:20:44 AM  
**Attachments:** [image001.png](#)

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Petitioner is authorized to file a 3-page sur-reply in IPR2025-00345, due no later than Tuesday, July 22, 2025

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**From:** Aguilar, Safiya <[Safiya.Aguilar@finnegan.com](mailto:Safiya.Aguilar@finnegan.com)>  
**Sent:** Thursday, July 17, 2025 4:43 PM  
**To:** [Director\\_Discretionary\\_Decision <Director\\_Discretionary\\_Decision@uspto.gov>](#); [Steve Reynolds <sreynolds@daignaultiyer.com>](#)  
**Cc:** [DI-SoundClear <DI-SoundClear@daignaultiyer.com>](#); [Bell, Cory <Cory.Bell@finnegan.com>](#); [Hines, Lisa <Lisa.Hines@finnegan.com>](#); [Arner, Erika <erika.arnier@finnegan.com>](#); [Young, Michael <Michael.Young@finnegan.com>](#); [Google-Soundclear-IPRs <Google-Soundclear-IPRs@finnegan.com>](#)  
**Subject:** RE: IPR2025-00345 (U.S. Patent No. 9,031,259) - Request for Leave to File Reply

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Honorable Board,

Petitioner respectfully requests a 3-page sur reply (equal in length to the reply granted Patent Owner) in each of the above captioned IPRs to respond to Patent Owner's new arguments and evidence. Patent Owner does not oppose a sur-reply, but argues that such a sur-reply should be limited to two pages.

Regards,  
Safiya  
Counsel for Petitioner

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**From:** [Director\\_Discretionary\\_Decision <Director\\_Discretionary\\_Decision@uspto.gov>](#)  
**Sent:** Friday, July 11, 2025 1:17 PM  
**To:** [Steve Reynolds <sreynolds@daignaultiyer.com>](#); [Director\\_Discretionary\\_Decision <Director\\_Discretionary\\_Decision@uspto.gov>](#)  
**Cc:** [DI-SoundClear <DI-SoundClear@daignaultiyer.com>](#); [Bell, Cory <Cory.Bell@finnegan.com>](#); [Hines, Lisa <Lisa.Hines@finnegan.com>](#); [Arner, Erika <erika.arnier@finnegan.com>](#); [Young, Michael <Michael.Young@finnegan.com>](#); [Aguilar, Safiya <Safiya.Aguilar@finnegan.com>](#); [Google-Soundclear-IPRs <Google-Soundclear-IPRs@finnegan.com>](#)  
**Subject:** RE: IPR2025-00345 (U.S. Patent No. 9,031,259) - Request for Leave to File Reply

Patent Owner is authorized to file a 3-page reply in IPR2025-00345, due no later than Wednesday, July 16, 2025, limited to addressing the arguments raised below.

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**From:** Steve Reynolds <[sreynolds@daignaultiyer.com](mailto:sreynolds@daignaultiyer.com)>

**Sent:** Thursday, July 10, 2025 10:52 PM

**To:** Director\_Discretionary\_Decision <[Director\\_Discretionary\\_Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov)>

**Cc:** DI-SoundClear <[DI-SoundClear@daignaultiyer.com](mailto:DI-SoundClear@daignaultiyer.com)>; Bell, Cory <[Cory.Bell@finnegan.com](mailto:Cory.Bell@finnegan.com)>; Hines, Lisa <[Lisa.Hines@finnegan.com](mailto:Lisa.Hines@finnegan.com)>; Arner, Erika <[erika.arnner@finnegan.com](mailto:erika.arnner@finnegan.com)>; Young, Michael <[Michael.Young@finnegan.com](mailto:Michael.Young@finnegan.com)>; Aguilar, Safiya <[Safiya.Aguilar@finnegan.com](mailto:Safiya.Aguilar@finnegan.com)>; Google-Soundclear-IPRs <[Google-Soundclear-IPRs@finnegan.com](mailto:Google-Soundclear-IPRs@finnegan.com)>

**Subject:** IPR2025-00345 (U.S. Patent No. 9,031,259) - Request for Leave to File Reply

**CAUTION:** This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Acting Director Stewart, Discretionary Denial committee, and Honorable Board,

Patent Owner SoundClear received Petitioner Google's Opposition to Patent Owner's Discretionary Denial Brief on July 9, 2025—responding to SoundClear's opening brief on June 9, 2025. SoundClear seeks authorization to file a 5-page Reply to Google's brief by no later than three business days following the grant of leave to do so. SoundClear believes that the Director and Board would benefit from supplemental briefing.

First, good cause for a reply brief exists because Google's brief makes a serious and unsupported allegation about SoundClear's counsel's alleged violation of its duty of candor. Paper 9 ("Resp. Br."), 4-5 and n.1. It is baseless and contradicted by express statements in SoundClear's opening discretionary denial brief. *See, e.g.*, Paper 5 ("Opening Br."), 11 ("Thus, **if** institution of this IPR is denied in August 2025, the district court case will proceed to trial by January 2026." (emphasis added)).

SoundClear requests the opportunity to resolve Google's misunderstanding. Stated succinctly, SoundClear compared the expected time-to-trial versus expected time-to-resolution in two scenarios: (1) if IPR is instituted in August and (2) if institution is denied in August. SoundClear omitted from its calculation the time during which the case has will have been stayed if institution is denied in August (March 30 to August). SoundClear requests leave to file a short reply to expressly clarify how the January 2026 date was calculated so there can be no further misunderstanding.

Second, Acting Director Morgan Stewart and the Board issued multiple decisions clarifying the "settled expectations" factor. *See e.g. Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (PTAB June 18, 2025); *Intel Corporation v. Proxense LLC*, IPR2025-00327, Paper 12

(PTAB June 26, 2025); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12 (PTAB June 27, 2025) (clarifying *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025)); *Ericsson Inc. v. Procomm*, IPR2024-01452, Paper 15, 3 (PTAB June 25, 2025) (citing *iRhythm*). That guidance was issued following the date on which SoundClear filed its Discretionary Denial brief (June 9, 2025). That guidance clarified the *iRhythm* ruling, which was issued just one business day before SoundClear filed its Discretionary Denial brief—such that SoundClear’s counsel had not yet seen it when it filed its opening brief.

The foregoing cases establish that a primary controlling fact on settled expectations is whether the patents have been in force for at least seven years or more. It is the petitioner’s burden to establish otherwise. SoundClear’s patent has been in force for 10 years. It was published as the patent of one of Google’s competitors (JVC Kenwood). Further, Google “does not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Office resources,” as required in *Dabico*. Paper 21, p. 3.

The parties conferred on this issue. Google asked whether SoundClear will introduce new evidence in its reply. SoundClear will not.

Google opposed on the following grounds:

Google opposes your request for three reasons.

1. Good cause does not exist for supplemental briefing. Regarding your first request, the acting Director can assess whether SoundClear violated its duty of candor based on the record before her because the evidence speaks for itself. Regarding your second request, Patent Owner should have raised any arguments regarding settled expectations in its brief. Settle expectations were highlighted in the Director’s memo that predated your request for discretionary denial. At a minimum, you should have requested additional briefing when the first wave of settled expectation decisions issued (the 1<sup>st</sup> being one day after SoundClear filed its opening brief) rather than waiting for Google’s response.
2. Granting supplemental briefing at this stage and under these circumstances would also only undermine the stated goals of efficiency.
3. As stated above, the scope of the request and the basis for portions of it are unclear.

Thank you for your consideration.



**Steven J. Reynolds**  
Partner

Daignault Iyer LLP  
312.636.4674  
[sreynolds@daignaultiyer.com](mailto:sreynolds@daignaultiyer.com)

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