

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

SOUNDCLEAR TECHNOLOGIES LLC,
Patent Owner

U.S. Patent No. 11,069,337
Issue Date: July 20, 2021

Title: VOICE-CONTENT CONTROL DEVICE, VOICE-CONTENT
CONTROL METHOD, AND NON-TRANSITORY STORAGE MEDIUM

Inter Partes Review No. IPR2025-01123

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF
UNITED STATES PATENT NO. 11,069,337**

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PATENT OWNER EXHIBIT LIST

Exhibit No.	Description
2001	Webpage of JVC Kenwood Corporate History, available at https://www.jvckenwood.com/en/corporate/history/
2002	Webpage of JVC Kenwood Amateur Radio, available at https://www.kenwood.com/usa/com/amateur/
2003	Webpage of JVC Kenwood USA, available at https://www.jvc.com/usa/
2004	Docket Printout of <i>SoundClear Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00321 (EDVA) (“-321 case”)
2005	Docket Printout of VA No. 2:24-cv-00320 (EDVA) (“-320 case”)
2006	Memorandum in Support of Google LLC’s Partial Motion to Dismiss Plaintiff’s Complaint Under Rule 12(b)(6) (-321 case, Dkt. 14)
2007	Memorandum in Support of Amazon’s Motion to Dismiss Plaintiff’s Complaint Under Rule 12(b)(6) (-320 case, Dkt. 31)
2008	Docket Printout of VA No. 1:24-cv-01283 (EDVA) (“-1283 case”)
2009	Docket Printout of VA No. 3:24-cv-00540 (EDVA) (“-540 case”)
2010	Memorandum of Law in Support of Google LLC’s Motion to Dismiss Plaintiff’s Complaint Under Rule 12(B)(6) (-540 case, Dkt. 17)
2011	Memorandum in Support of Defendant’s Motion to Dismiss Under Rule 12(b)(6) (-1283 case, Dkt. 32)
2012	Memorandum of Law in Support of Defendant Google LLC’s Unopposed Motion to Stay Pending <i>Inter Partes</i> Review (-540 case, Dkt. 48)
2013	Declaration of Joshua Yin in Support of Defendant Google LLC’s Unopposed Motion to Stay Pending <i>Inter Partes</i> Review (-540 case, Dkt. 49)

2014	Memorandum in Support of Defendants' Motion to Stay Pending <i>Inter Partes</i> Review (-320 case, Dkt. 50)
2015	Amazon's Preliminary Invalidity Contentions, dated March 12, 2025 (-1283 case)
2016	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 15/611,228, dated June 1, 2017.
2017	U.S. Patent No. 10,418,033
2018	U.S. Patent No. 11,705,108
2019	U.S. Patent No. 11,531,736
2020	U.S. Patent No. 11,393,471
2021	U.S. Patent No. 12,002,469
2022	U.S. Patent No. 11,783,833
2023	U.S. Patent No. 10,943,583
2024	U.S. Patent No. 11,562,739
2025	U.S. Patent No. 10,600,408
2026	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 14/096,623, dated July 27, 2017.
2027	U.S. Patent No. 9,830,924
2028	U.S. Patent No. 10,276,149
2029	Defendant Google LLC's Unopposed Motion To Stay Pending <i>Inter Partes</i> Review (-540 case, Dkt. 47)

Patent Owner SoundClear Technologies LLC (“SoundClear”) submits this Request for Discretionary Denial brief respectfully requesting that the Director deny institution of the Petition for *Inter Partes* Review (“Petition”) filed by Google LLC (“Google”) challenging claims 1-5 (“the challenged claims”) of U.S. Patent No. 11,069,337 (“’337 patent,” EX-1001).

I. INTRODUCTION

Discretionary denial is appropriate here at least because SoundClear has settled expectations in the ’337 patent in view of recent case law, and Google’s instant Petition is a follow-on to Amazon’s earlier petition in IPR2025-00565. The ’337 patent has been in force for four years. Under recent case law, that creates settled expectations sufficient to support discretionary denial. Further, while the petition in IPR2025-00565 was not filed by Google, discretionary denial of this Petition is appropriate under the *General Plastic* factors because Google and Amazon have a significant relationship and all such factors support denial.

Several other factors also support discretionary denial. First, no Sotera/Sand stipulation was filed, and the district court case will address system prior art already identified. Second, the Petition conflates attorney argument with expert testimony. Third, letters rogatory discovery mechanisms will be required. Fourth, the Petition fails to articulate a proper obviousness analysis under *Graham*. Finally, the prior art fails to disclose the claimed subject matter.

II. SUMMARY OF PARALLEL PROCEEDINGS AND RELATED LITIGATIONS

Case Name	Case Number	Patents Involved
<i>SoundClear Techs. LLC v. Amazon.com, Inc. et al.</i>	2:24-cv-00320 (E.D. Va.) ("SoundClear-320 Case")	9,031,259 9,070,374 9,804,819
<i>SoundClear Techs. LLC v. Google LLC</i>	2:24-cv-00321 (E.D. Va.) ("SoundClear-321 Case")	9,031,259 9,070,374 9,804,819
<i>SoundClear Techs. LLC v. Amazon.com, Inc. et al.</i>	1:24-cv-01283 (E.D. Va.) ("SoundClear-1283 Case")	11,069,337 11,244,675 9,223,487
<i>SoundClear Techs. LLC v. Google LLC</i>	3:24-cv-00540 (E.D. Va.) ("SoundClear-540 Case")	11,069,337 11,244,675 9,223,487
<i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i>	IPR2025-00565	11,069,337
<i>Google LLC v. SoundClear Techs. LLC</i>	IPR2025-00344	9,070,374
<i>Google LLC v. SoundClear Techs. LLC</i>	IPR2025-00345	9,031,259
<i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i>	IPR2025-00673	11,244,675
<i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i>	IPR2025-01067	9,070,374
<i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i>	IPR2025-01080	9,804,819
<i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i>	IPR2025-01096	9,031,259
<i>Google LLC v. SoundClear Techs. LLC</i>	IPR2025-01123	11,069,337
<i>Google LLC v. SoundClear Techs. LLC</i>	IPR2025-01177	11,244,675
<i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i>	IPR2025-01368	9,223,487

In this brief, the SoundClear-320 Case and SoundClear-321 Case are collectively referred to as the “SoundClear I Cases.” The SoundClear-1283 Case and SoundClear-540 Case are collectively referred to as the “SoundClear II Cases.”

III. LEGAL STANDARDS

A. Discretionary Denial Framework

“The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

The new discretionary denial framework goes beyond prior rules and guidance, as demonstrated by recent memoranda and FAQs. *See* FAQs for Interim Processes for PTAB Workload Management, April 25, 2025 (<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>) (“FAQs”); *see also* Interim Processes for PTAB Workload Management, March 26, 2025 (<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>) (“Morgan Stewart Memo”).

The Morgan Stewart Memo permits the Director to consider existing precedent under *General Plastic* and other factors and guidance. Morgan Stewart Memo, 2 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*,

IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential)).

But the Morgan Stewart Memo goes further. It advises parties to address all relevant considerations, which may include:

- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition’s reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any *other* considerations bearing on the Director’s discretion.

Morgan Stewart Memo, 2-3 (emphasis added).

B. *General Plastic*

The Board’s precedential *General Plastic* decision provides seven factors the Board considers “in evaluating follow-on petitions”:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or

received the Board’s decision on whether to institute review in the first petition;

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Gen. Plastic, IPR2016-01357, Paper 19, 16.

While follow-on petitions are often filed by the same petitioner, “application of the *General Plastic* factors is not limited solely to instances where multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 2 (PTAB Apr. 2, 2019) (precedential).

IV. ARGUMENT

A. SoundClear’s Settled Expectations in the ’337 Patent Support Discretionary Denial

Although IPR2025-00565 was recently instituted against the ’337 patent, SoundClear has settled expectations in the ’337 patent in view of recent case law.

See Samsung Elecs. Co. Ltd. et al. v. GenghisComm Holdings LLC, IPR2025-00788, Paper 11, 2 (PTAB Aug. 22, 2025) (finding that a patent in force for *three* years supported discretionary denial); *see also Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025); *Coretronic Corp. v. Maxell, Ltd.*, IPR2025-00474, Paper 11, 2 (Director July 10, 2025) (emphasis added); *see also Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 (Director June 26, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00433, Paper 12 (Director June 27, 2025) (clarifying *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (Director June 6, 2025)); *Ericsson Inc. v. Procomm*, IPR2024-01452, Paper 16, 3 (Director June 25, 2025) (citing *iRhythm*). Further, actual notice of a patent is not required for settled expectations. *Dabico*, Paper 21, 3.

The '337 patent issued on July 20, 2021. As such the patent has been in force for over four years. That is more than enough time to create settled expectations.

Further, all of the patents-in-suit in the district court case have settled expectations. For example, the '487 patent has been in force for nearly ten years (it issued on December 29, 2015). And the '675 patent has been in force for over three years (it issued on February 8, 2022). All patents were assigned to JVC Kenwood, which has been active in the electronic communication field. EX-2001; EX-2002; EX-2003. Discretionary denial is appropriate where a patent is asserted in a district

court case with another patent having strong settled expectations. *See Samsung*, IPR2025-00788, Paper 11, 2.

SoundClear's settled expectations merit discretionary denial here.

B. The *General Plastic* Analysis Supports Discretionary Denial

In addition to settled expectations, the *Gen. Plastic* factors also support discretionary denial. This Petition is a follow-on petition to IPR2025-00565.

SoundClear will address Google's expected opposition to the *Gen. Plastic* analysis in a reply brief after requesting permission from the Board to file one.

1. Amazon and Google Have a Significant Relationship

Although Google and Amazon are different entities, they are each involved in litigation with SoundClear in the same venue (the EDVA). The SoundClear II Cases each involve the same patents-in-suit and similar competing products.

Moreover, throughout all district court and IPR proceedings involving SoundClear, Amazon and Google have engaged in a thematic pattern of strategic conduct that demonstrates a significant relationship created for litigation purposes. As shown below, they have coordinated their strategy since early in the district court litigations with Google taking the lead on the SoundClear I Cases and Amazon taking the lead on the SoundClear II Cases.

The initial Rule 12 briefing in the district court proceedings demonstrates this strategic relationship. In the SoundClear I Cases, Google filed its Motion to

Dismiss three weeks before Amazon did. *Compare* EX-2004 (Dkts. 13 and 14 (filed Aug. 5, 2024)) *with* EX-2005 (Dkts. 30 and 31 (filed Aug. 26, 2024)).

Notably, Amazon’s subsequent motion mirrored Google’s motion. *Compare* EX-2006 *with* EX-2007. Like Google’s brief, Amazon’s brief: (1) did not include allegations against the ’259 patent, (2) alleged that the ’374 patent was invalid under § 101, and (3) alleged that the complaint did not plausibly allege infringement of the ’819 patent. *Id.* (comparing both supporting memorandums to show that the same arguments were made by both Google and Amazon) Similarly, in the SoundClear II Cases, Amazon filed its Motion to Dismiss over two weeks before Google did. *Compare* EX-2008 (Dkts. 31 and 32 (filed Sept. 13, 2024)) *with* EX-2009 (Dkts. 16 and 17 (filed Sept. 30, 2024)). Google’s subsequent motion adopted the same approach in Amazon’s motion. *Compare* EX-2010 *with* EX-2011. Like Amazon’s brief, Google’s brief: (1) alleged that the ’337 patent and ’675 patent were invalid under § 101, and (2) alleged that the complaint did not plausibly allege infringement of any of the three patents-in-suit. *Id.*

The subsequent conduct by the parties demonstrates that their relationship was for Amazon to drive the strategy for the SoundClear II Cases and related IPRs while Google drove the strategy for the SoundClear I Cases and related IPRs. In the SoundClear-1283 Case, Amazon: filed a Motion to Transfer on October 8, 2024; filed IPR petitions against two of the three patents-in-suit (i.e. the ’337

patent and '675 patent on January 31, 2025 and February 27, 2025, respectively); and filed a Motion to Stay the next day on February 28, 2025. EX-2008 (Dkt. 109 (filed February 28, 2025)). Meanwhile, Google, during the same period of time in the SoundClear-321 Case: filed a Motion to Transfer on November 4, 2024; filed IPR petitions against two of the three patents-in-suit (the '374 patent and '259 patent on February 10, 2025); and filed a Motion to Stay roughly a week later on February 18, 2025. EX-2004 (Dkts. 73, 74, and 75).

Only after Amazon filed IPRs and moved to stay its SoundClear II case did Google move to stay its SoundClear II case (the SoundClear-540 Case) and file its own IPRs. Google moved to stay the SoundClear-540 Case on April 8, 2025—over a month after Amazon did. *See* EX-2009 (Dkts. 47, 48, and 49). And in its motion to stay, Google relied on *Amazon's* IPR filings against the patents-in-suit and *Amazon's* motion to stay. EX-2012; EX-2013. Indeed, Google had not yet filed IPRs against the patents-in-suit in the SoundClear II Cases when it filed its motion to stay. It did not file those IPRs until a few weeks before the statutory deadline.

Similarly, only after Google filed IPRs and moved to stay its SoundClear I case did Amazon move to stay its SoundClear I case and file its own IPRs. Amazon moved to stay the SoundClear-320 case on April 7, 2025—over a month after Google did. *See* EX-2005 (Dkts. 49 and 50). And in its motion to stay, Amazon relied on *Google's* IPR filings against the patents-in-suit and *Google's* motion to

stay. EX-2014. Indeed, Amazon had not yet filed IPRs against the patents-in-suit in the SoundClear I Cases when it filed its motion to stay. It did not file those IPRs until a few days before the statutory deadline.

The timing and sequence of actions demonstrate a coordinated and deliberate division of labor between Amazon and Google. It is not coincidental. In its SoundClear II case, Amazon even cited Google products as alleged prior art products against the '337 patent and the other patents-in-suit. EX-2015 at 9, 20.

Google and Amazon each chose to create a significant relationship with each other by strategically hitching their respective cases together. For the SoundClear II Cases, Google specifically chose to avail itself of *Amazon's* prior IPR filings to support a stay motion in its own district court case and give itself more time to file its own IPRs. It did not wait until after filing its own IPRs to file a stay motion.

Thus, Amazon and Google have a “significant relationship” with respect to SoundClear’s assertion of the '337 patent. *See Valve*, IPR2019-00062, Paper 11, 9-10. Such circumstances are sufficient to invoke the *Gen. Plastic* analysis.

2. Factor 1 – Both Petitions are Directed to the Same Claims

Google’s Petition is directed to all claims (1-5) of the '337 patent. The prior filed Amazon petition (IPR2025-00565) is directed to the same claims. Further, as stated above, Amazon and Google have a significant relationship in these matters.

General Plastic factor 1 thus favors denial.

3. Factor 2 – Amazon Knew About the Alleged Prior Art Cited in Google’s Petition Before Filing IPR2025-00565.

The sole ground of Google’s Petition relies on EX-1005 (the Ocampo reference (U.S. Publication No. 2018/0122361)) and EX-1006 (the Yi reference (U.S. Publication No. 2014/0303971)). Amazon knew about each of these references before it filed its petition in IPR2025-00565 against the ’337 patent.

Amazon has known about the Ocampo reference since at least June 1, 2018 when the patent examiner of U.S. App. No. 15/611,228 (now U.S. Patent No. 10,418,033) cited it in connection with a non-final rejection. EX-2016. The ’033 patent is owned by Amazon. EX-2017. Indeed, at least *eight* other Amazon patents also cite the Ocampo reference as relevant art. *See, e.g.*, EX-2018; EX-2019; EX-2020; EX-2021; EX-2022; EX-2023; EX-2024; EX-2025. Thus, Amazon knew about the Ocampo reference over *six years* before its January 31, 2025 petition.

The Ocampo reference is owned by Google. EX-1001. Thus, Google knew about it since at least November 1, 2016 when it was filed with the USPTO—over *eight years* before Amazon filed its petition.

Amazon has known about the Yi reference since at least July 27, 2017 when the patent examiner of U.S. App. No. 14/096,623 (now U.S. Patent No. 9,830,924) cited it in connection with office action. EX-2026. The ’924 patent is owned by Amazon. EX-2027. At least one other Amazon patent also cites Yi as relevant art.

EX-2028. Thus, Amazon knew about the Yi reference over *seven years* before it filed its petition on January 31, 2025. Factor 2 favors denial.

4. Factor 3 – Google Filed its IPR Petition One Month After SoundClear Filed its POPR Brief on Discretionary Denial in IPR2025-00565.

SoundClear filed its discretionary denial brief for Amazon’s IPR petition against the ’337 patent on May 12, 2025. *See* IPR2025-00565, Paper 6. That was *one month* before Google filed the instant Petition against the ’337 patent.

SoundClear’s May 12th brief was 55 pages and contained a variety of arguments including a *Fintiv* analysis, an *Advance Bionics* analysis, and several other arguments relevant to discretionary denial. *Id.*

Google’s delay in filing its Petition until a month after SoundClear’s May 12th brief on the same ’337 patent is prejudicial to SoundClear. Google was aware of Amazon’s earlier petition at least by April 8, 2025 when Google moved to stay the SoundClear-540 case on the basis of that petition. *See* EX-2029, EX-2012, EX-2013. Yet, Google waited over 2 months to file this follow-on Petition. Again, that was not coincidental. The Board accorded a filing date for IPR2025-00565 on March 12, 2025. *See id.*, Paper 5. Thus, when Google moved to stay the SoundClear-540 case on April 8th, it already knew when SoundClear’s discretionary denial brief would be due in IPR2025-00565. It deliberately chose to wait and see what SoundClear’s discretionary denial arguments would be.

As discussed above, Google and Amazon have created a significant relationship for the purpose of coordinating litigation strategy. Google delayed its follow-on Petition until after SoundClear filed its discretionary denial brief against Amazon is yet another example of that coordinated strategy. That gamesmanship should not be rewarded here, particularly when SoundClear has settled expectations in the '337 patent in view of recent case law. Factor 3 favors denial.

5. Factor 4 – Amazon and Google Knew About the Alleged Prior Art Well Before Google’s Petition Was Filed

As stated above for factor 2, Google knew about Ocampo—the primary reference in its Petition—at least since November 1, 2016 when it filed the Ocampo patent application. *See* EX-1001. That is over *eight years* before it filed its Petition against the '337 patent, and over *four years* before the '337 patent issued.

Amazon knew about Ocampo since at least June 1, 2018—over *six years* before it filed its own petition against the '337 patent and *seven years* before Google filed its Petition. Amazon knew about Yi since at least July 27, 2017—over *seven years* before its own petition against the '337 patent or Google’s Petition.

Amazon and Google collectively knew about the references at least seven years before Google’s Petition was filed. *Gen. Plastic* factor 4 favors denial.

6. Factor 5 – No Explanation Justifies the Lapse of Time Discussed in Factor 4

As discussed above, both references in the Petition were known to Google or Amazon long before the Petition was filed. Each party knew about Ocampo at least six years beforehand. Amazon knew about Li at least seven years beforehand.

There is no adequate explanation for the lapse of time between Google learning about Ocampo and the filing of Google’s Petition. Indeed, Google has *always* known about Ocampo. It is the publication of a Google patent application that was filed nearly *nine* years ago. Google knew about Ocampo when the ’337 patent issued over four years ago. And it knew about Ocampo when SoundClear asserted the ’337 patent against Google over one year ago.

Likewise, there is no adequate explanation for the lapse of time between Amazon learning about both references and the filing of Google’s Petition. Indeed, as discussed *supra*, Amazon knew about both references since at least June 1, 2018. Yet when it filed the petition in IPR2025-00565 against the ’337 patent nearly *five months before* Google’s Petition, it chose not to rely on either one of those references. Thus, *Gen. Plastic* factor 5 favors denial.

7. Factors 6 and 7 – An IPR Proceeding is Already Pending Against the ’337 Patent

Gen. Plastic “sixth and seventh factors are efficiency considerations.”

Valve, IPR2019-00062, Paper 11, 15. “[H]aving multiple petitions challenging the

same patent, especially when not filed at or around the same time ... is inefficient and tends to waste resources.” *Id.* Current constraints on PTAB resources justified the Board’s new approach to discretionary denial. *See* Morgan Stewart Memo.

The Board already instituted a proceeding against the ’337 patent: IPR2025-00565. It would be inefficient for the Board to institute a second proceeding here against the same patent. The first petition was filed more than *fourth months* before the instant Petition. And, if institution is granted for the instant Petition, the Board’s Final Written Decision in IPR2025-00565 would issue approximately four months before a Final Written Decision for the instant Petition. Moreover, SoundClear has settled expectations in the ’337 patent in view of recent case law.

Thus, factors 6 and 7 favor denial. On balance, all *Gen. Plastic* factors collectively favor discretionary denial of the instant Petition.

C. Other Factors Support Discretionary Denial

1. Google Did Not File a *Sotera* or *Sand* Stipulation

Google has not filed a *Sotera* or *Sand* stipulation in the district court case. The lack of a *Sotera* or *Sand* stipulation in the district court cases raises “concerns of inefficiency and the possibility of conflicting decision” between the Board and district court. *Fintiv*, IPR2020-00019, Paper 11, 12; *see also Phison Elecs. Corp. v. Vervain, LLC*, IPR2025-00212, Paper 10, 13 (PTAB May 28, 2025) (“Given that both proceedings involve claim 1 of the ’298 patent and the same invalidity

challenges, in addition to the lack of any [*Sotera*] stipulation to avoid duplicative efforts and conflicting decisions” this factor favors discretionary denial.).

That, along with Amazon and Google’s strategy of inconsistent claim construction positions, evinces an intent to evade finality. Estoppel aside, nothing bars Google from relying on substantially identical prior art combinations and the same invalidity theories already presented to the Board.

2. Google Will Pursue Contradictory Claim Constructions

Google states: “[h]ere, no [claim] terms require express construction” Pet., 7. The “here” qualification means that Google believes it can seek to construe terms when it comes time in the district court to apply them to the accused products/services. That indicates Google intends to pursue contradictory claim construction positions for purposes of invalidity (at the Board) and non-infringement (in district court). If even a single claim escapes the IPR proceeding, Google will seek claim constructions that favor noninfringement.

Yet, Google’s approach is also wrong under the law. Claims must be interpreted the same for invalidity and infringement: “It is axiomatic that claims are construed the same way for both invalidity and infringement.” *Amgen Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988)). “A patent may not, like a nose of wax, be twisted one way to avoid anticipation and another

to find infringement.” *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (citing, e.g., *White v. Dunbar*, 119 U.S. 47, 51 (1886)).

3. District Court Discovery and A Jury Are Required

Technical, factual, and evidentiary issues will dominate this case. Many result from the expert fight Google teed up on almost every issue. Google’s Petition relies on statements made in expert declarations (which largely mirror attorney argument) far more than the express disclosures in the asserted prior art. Thus, the issues will require discovery into those opinions. And ultimately a jury should weigh the testimony and balance the credibility of the experts. *See* FAQ 21.

Fact issues also pervade. Google will likely rely on product prior art before the district court. Whether and to what extent those overlap with the prior art identified in its Petition remains to be seen.

Testimony of the two named inventors of the patents-in-suit in the SoundClear II Cases may be material and relevant, because it relates to issues of validity and infringement. Both inventors reside in Japan. *See, e.g.*, EX-1001 (“Inventor”). That will necessitate overseas discovery (e.g., via Letters Rogatory), which the PTAB cannot provide. Google may also seek important testimony from other individual and corporate witnesses in connection with validity issues. That would require discovery into JVC Kenwood Corporation, their employer, which is famous for having innovated in these areas.

It would be highly prejudicial to SoundClear for Google to seek out a forum to address an issue (e.g., invalidity at the PTAB) where certain third-party discovery related to that issue is unavailable.

4. Confluence of Expert Testimony and Attorney Argument

Google’s Petition heavily relies on mirrored statements of its attorneys and expert. Its declaration should thus be given little or no weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15-17 (PTAB Aug. 24, 2022) (designated precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340-41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that “merely repeated Petitioner’s argument, nearly verbatim, without citation to the basis for his testimony”).

Google’s arguments demonstrate this. For at least claim 1, nearly every paragraph in the declaration mirrors an argument paragraph in the Petition. *Compare, e.g., Pet.*, 14-38 *with* EX-1003, ¶¶76-105. In the rare instances where there is some difference, they are superficial.

5. Failure to Establish a Prima Facie Case under *Graham*

Google does not explain its obviousness case—what specifically is missing from the primary references, where it is found, or why a POSITA would have been

motivated to bridge the gap. Google *never* mentions *Graham* factor 2, despite basing each ground on obviousness under §103. *See Pet., generally.* It merely provides boilerplate recitations in support of factor one and then simply identifies alternative disclosures for each limitation. *See, e.g., id.*, 14-38. That approach violates *Graham* and *KSR*. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). One cannot merely point to disparate disclosures between multiple references and presume a POSITA would be motivated to, or could with reasonable success, piece the references together in some unarticulated way to make it work. *Id.*

It is not possible to determine whether a POSITA would have been motivated to combine references, or had a reasonable expectation of success / predictable results, without *specifically* identifying and addressing the difference—or “gaps”—between the claims and the art. It is necessary to determine whether it would have been obvious “to bridge the gaps between the prior art and the claims.” *Apple Inc. v. Samsung Elecs. Co., Ltd.*, 839 F.3d 1034, 1061 (Fed. Cir. 2016); *Pfizer Inc. v. Sanofi Pasteur Inc.*, 94 F.4th 1341, 1348 (Fed. Cir. 2024).

The Petition does not identify “the differences between the claims and the prior art.” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 2350, 1358 (Fed. Cir. 2017) (citing *Graham*, 383 U.S. at 17–18). The Petition is rife with examples of *Graham* factor 2 omissions. *See Pet., generally.* Indeed, it completely

fails to identify those gaps or provide any *KSR*-mandated analysis to support overcoming them. In other words, Google presumes a combination and then addresses disclosures of each reference in vacuum.

As in *Johns Manville Corp. v. Knauf Insulation, Inc.*: “[Google] does not support, in its claim-by-claim analysis, which elements of the cited references could be predictably combined.” IPR2018-00827, Paper 9, 12 (PTAB Oct. 16, 2018) (designated informative) (denying institution for insufficient reason to combine references). “For example, in its discussion of claim [1], [Google] indicates which of the references purportedly discloses each element of claim [1], but does not indicate which of the prior art elements allegedly has a known function, what that function is, and why that function is allegedly predictable.” *Id.* “Petitioner’s reliance on the testimony of [its expert] to support its arguments fails to direct us to evidence supporting that [the] claims [at issue] represent nothing more than the predictable use of prior art elements.” *Id.* Stating something as “well-known and predictable” is not enough. *Id.*, 13-14.

V. CONCLUSION

For all of the foregoing reasons, SoundClear respectfully requests the Director exercise its discretion and deny the Petition.

Dated: September 2, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d) and the Interim Director Discretionary Process § II.C.iii, the undersigned certifies that this Brief in Support of Discretionary Denial complies with the type-volume limitations of those sections because it contains 4,501 words and no more than 20 pages, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

Dated: September 2, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF PETITION
FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 11,069,337
was served electronically via email on September 2, 2025, on the following
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