

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

CERENCE OPERATING COMPANY,

Patent Owner

Case IPR2024-01465

U.S. Patent No. 11,087,750

**PETITIONERS' REPLY TO
PATENT OWNER'S SUPPLEMENTAL BRIEFING**

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PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,087,750 (“’750 Patent”)
1002	Declaration of Christopher M. Schmandt (“Schmandt”)
1003	Curriculum Vitae of Christopher M. Schmandt
1004	File History of U.S. Patent No. 11,087,750
1005	U.S. Patent Application Publication No. 2014/0163978 (“Basye”)
1006	U.S. Patent Application Publication No. 2014/0006825 (“Shenhav”)
1007	U.S. Patent Application Publication No. 2015/0106089 (“Parker”)
1008	U.S. Patent Application Publication No. 2012/0016678 (“Gruber”)
1009	U.S. Patent No. 9,275,637 (“Salvador”)
1010	U.S. Patent Application Publication No. 2013/0110521 (“Hwang”)
1011	U.S. Patent No. 9,634,855 (“Poltorak”)
1012	U.S. Patent No. 7,664,642 (“Espy-Wilson”)
1013	U.S. Patent No. 10,573,304 (“Gemmeke”)
1014	U.S. Patent Application Publication No. 2012/0034904 (“LeBeau”)
1015	U.S. Patent No. 9,998,977 (“Joshi”)
1016	U.S. Patent No. 6,594,630 (“Zlokarnik”)
1017	U.S. Patent Application Publication No. 2011/0314185 (“Conroy”)
1018	U.S. Patent Application Publication No. 2012/0296655 (“Kristjansson”)
1019	U.S. Patent No. 9,031,847 (“Sarin”)
1020	Claim Mapping Table

Exhibit No.	DESCRIPTION
1021	Plaintiff Cerence Operating Company's Disclosure of Asserted Claims and Infringement Contentions, Cerence Operating Company v. Samsung Electronics Co., Ltd. et al., No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Mar. 11 2024)
1022	Docket Control Order, Cerence Operating Company v. Samsung Electronics Co., Ltd. et al., No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Apr. 16, 2014)
1023	U.S. Patent No. 8,694,316 ("Pickering")
1024	U.S. Patent Application Publication No. 2013/0332165 ("Beckley")
1025	U.S. Patent Application Publication No. 2014/0350927 ("Yamabe")
1026	U.S. Patent Application Publication No. 2003/0179888A1 ("Burnett")
1027	U.S. Patent No. 9,020,459 ("Waters")
1028	U.S. Patent Application Publication No. 2020/0279576A1 ("Binder")
1029	U.S. Patent Application Publication No. 2013/0006638 ("Lindahl")
1030	Letter from Jin-Suk Park to James S. Tsuei dated Feb. 3, 2025

I. INTRODUCTION

The Board should not discretionarily deny institution. The *Fintiv* factors do not apply to Google LLC (“Google”), and, as applied to Samsung, they weigh against discretionary denial considering the EDTX litigation’s speculative trial date and remaining work, Samsung’s *Sotera* stipulation, and the Petition’s strong merits.

II. THE DISCRETIONARY FACTORS FAVOR INSTITUTION

A. Factor 1: The Board Will Not Speculate on a Stay

This factor is neutral. Samsung’s motion to stay was denied “without prejudice” for it to be refiled later. The Board has refused to speculate on future-filed stays. *See Home Depot U.S.A., Inc. v. Security Tech., LLC*, IPR2024-01420, Paper 12 at 43-44 (PTAB Mar. 24, 2025) (“If Petitioner were to file a motion to stay in the EDTX Litigation, we decline to speculate how the district court would rule on such a motion.”). Indeed, Judge Gilstrap has granted such re-filed stay motions post-institution even if opposed. *See, e.g., Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, Dkt. 83 (E.D. Tex. Mar. 8, 2024).

B. Factor 2: The Trial Date Is Uncertain and Shifting

The EDTX litigation schedule has been in flux for the past few months.¹ Magistrate Judge Payne’s Report and Recommendation denying Samsung’s motion

¹ For example, on April 4, 2025, PO stipulated to non-infringement of U.S. Patent Nos. 7,395,078 and 8,081,993 in the parallel litigation.

to transfer the EDTX litigation (which is still subject to objections being resolved by the District Judge) does not alter the analysis. As of the Petition's filing date, jury selection was set for August 4, 2025. Ex-1022. Jury selection is now set for October 6, 2025 based on a joint motion for additional time to complete important technical discovery obligations. Ex-2004. The docket control order also allows for further amendments. *Id.* at 4. Indeed, there are currently 12 trials set for the same date. While PO speculates that trial will occur before the FWD, 12 trials cannot proceed before the same judge on the same date. *See BOE Tech. Grp. Co., Ltd. v. Optronic Sci. LLC*, IPR2024-01131, Paper 15 at 11 (PTAB Feb. 12, 2025) ("Because a number of cases are scheduled for jury selection on January 5, 2026..., there is some uncertainty...we consider this factor to be ***neutral or weigh slightly against***" (emphasis added)).

Nor does the six-month gap between the current trial date (October 2025) and the FWD deadline (April 2026) compel denial because this factor is not determinative. *Facebook, Inc. v. USC IP P'Ship*, IPR2021-00034, Paper 13 at 11 (PTAB Apr. 13, 2021) ("[T]his factor is not considered in isolation, but holistically along with other factors"). Indeed, the Board has instituted IPR on similar timing, assigning only minimal weight in favor of denial. *See, e.g., Palo Alto Networks, Inc. v. Croga Innovations Ltd.*, IPR2024-01421, Paper 8 at 11 (PTAB Mar. 14, 2025) (FWD five months after trial); *Google LLC v. Multimodal Media LLC*, IPR2024-00056, Paper 9 at 8 (PTAB Apr. 12, 2024) (FWD six months after trial).

C. Factor 3: There is Significant Work Remaining

This factor weighs against discretionary denial. While the parties have been working to complete fact discovery and opening expert reports, substantial work remains, as evidenced by the parties' joint request for more time. Ex-2004. While claim construction is complete, expert discovery deadlines, depositions, dispositive motions, and pre-trial disclosures all remain in the future. *Id.* Finally, patent owners may agree to stays post-institution² and, if still opposed after institution, the Board should weigh inefficiencies against PO, not Samsung.

Moreover, the timing weighs against discretionary denial because Samsung timely filed the petition within its statutorily-allowed period. 35 U.S.C. §315(b)³; *Google LLC v. Motion Offense, LLC*, IPR2022-01312, Paper 17 at 47 (PTAB Mar. 6, 2023) (“waiting until the last day to file the Petition without explaining the delay is neutral.”). And here, since Google is not a party to the litigation, the time period was reasonable because it allowed Google and Samsung to prepare a single petition, instead of two separate petitions, to best conserve the Board’s resources.

D. Factor 4: No Overlap

² See, e.g., *Power2B, Inc. v. Samsung Elecs. Co.*, No. 2:21-cv-00348, Dkt. 71 (E.D. Tex. July 21, 2021); *Flip Phone Games Inc. v. PLR Worldwide Sales Ltd.*, No. 2:23-cv-00139-JRG, Dkt. 138 (E.D. Tex. Dec. 10, 2024); *Athalonz LLC v. Under Armour, Inc.*, No. 2:23-cv-00193-JRG, Dkt. 77 (E.D. Tex. Sept. 13, 2024).

³ PO’s complaint against Samsung was served one year and five months after any PGR on ’750 patent could have been filed.

Samsung’s *Sotera* stipulation (Ex-1030) refutes PO’s overlap argument. A *Sotera*-type stipulation “weighs strongly in favor of not exercising discretion... under 35 U.S.C. §314(a).” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). Samsung agreed that it will not raise in district court any art or arguments that it raised or reasonably could have raised in the IPR.⁴ Unless fully described in a publication, system art could never reasonably be raised before the Office. *See Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01003, Paper 9 at 11-12 (PTAB Jan. 9, 2024) (rejecting that the “right to assert overlapping system art in the district court” risks inconsistent outcomes because it “essentially attacks the reasoning of *Sotera* itself” despite *Sotera* remaining binding precedent). For these reasons, *Sotera* remains fully supported by former USPTO Directors Andrei Iancu and David Kappos.⁵

Motorola Sols., Inc. v. Stellar, LLC, IPR2024-01205, Paper 19 at 3 (PTAB Mar. 28, 2025) is distinguishable. First, unlike *Motorola*’s 11-month gap between trial and the FWD; here it is a 6-month gap. Second, unlike *Motorola*, the parties

⁴ Contrary to PO’s argument, the fact that Samsung was obligated under EDTX P.R. 3-3 and 3-4 to identify all possible prior art months before its Petition to preserve its defenses, cannot be held against Samsung’s IPR now. Moreover, Google has not served **any** contentions in district court, as Google is not a party to the litigation.

⁵“C4IP agrees ... and has discussed at length additional reasons for supporting the use of *Sotera* stipulations.” June 18, 2024 C4IP Comments (available at <https://c4ip.org/wp-content/uploads/2024/06/C4IP-Comment-RE-PTO-P-2023-0048.pdf>).

have already pushed out the trial in view of the remaining work to be done and may do so again. Third, unlike *Motorola*, this IPR is co-Petitioner Google’s *only* forum to present its invalidity challenge.

E. Factor 5: There is no Parallel Google Litigation

This factor weighs against discretionary denial because Google and the Samsung defendants are not the same party and the underlying litigation would not resolve Google’s interest in invalidating the patent. *See Google LLC v. Multimodal Media LLC*, IPR2024-00053, Paper 10 at 8 (PTAB June 5, 2024) (“*Fintiv* does not apply to Google”); *Motion Offense*, IPR2022-01312, Paper 17 at 51 (“Petitioner and Dropbox are not the same party...factor 5 weighs against [denial]”).

F. Factor 6: The Petition’s Merits are Strong

Petitioners have established a strong case on the merits that involve new, non-cumulative obviousness theories that will not be addressed in the parallel EDTX litigation. Notably, PO’s POPR did not present *any* argument against the merits.⁶

III. CONCLUSION

The Board should not discretionarily deny institution.

⁶ PO’s Reply seems to attack the underlying declaration’s sufficiency, but “duplication between a petition and a declaration does not require giving the declarant’s testimony little or no weight.” *Apple Inc. v. Carbyne Biometrics, LLC*, IPR2024-00329, Paper 10 at 52 (PTAB Aug. 1, 2024).

Dated: April 11, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on April 11, 2025, I caused a true and correct copy of the foregoing PETITIONER'S REPLY TO PATENT OWNER'S SUPPLEMENTAL BRIEFING to be served electronically on counsel for Patent Owner at the following addresses:

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