

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CERENCE OPERATING COMPANY,
Patent Owner.

IPR2024-01465
Patent 11,087,750 B2

Before MICHELLE N. WORMMEESTER, BRIAN P. MURPHY, and
LISA A. MURRAY, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Google LLC (“Google” or “Petitioner Google”), as well as Samsung Electronics Co., Ltd., and Samsung Electronics, America, Inc. (collectively, “Samsung” or “Petitioner Samsung”) filed a Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 11,087,750 B2 (Ex. 1001, “the ’750 patent”). We refer to Google and Samsung collectively as “Petitioner.” Cerence Operating Company (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). With our authorization, Patent Owner also filed a supplemental preliminary response (Paper 13, “Supp. Prelim. Resp.”), and Petitioner filed a preliminary reply (Paper 14, “Prelim. Reply”) to Patent Owner’s supplemental preliminary response. *See* Ex. 3002 (e-mail authorization).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons that follow, we exercise our discretion to deny institution of an *inter partes* review of the challenged claims.

II. BACKGROUND

A. *Related Proceedings*

The parties identify various related matters. Pet. 75; Paper 12, Part II (Patent Owner’s Updated Mandatory Notices). One related matter is *Cerence Operating Co. v. Samsung Electronics Co.*, 2:23-cv-00482-JRG-RSP (E.D. Tex.) (hereinafter, “the District Court Litigation”), which was filed on October 13, 2023. Pet. 75; Paper 12, Part II. Petitioner Samsung is a party to the District Court Litigation, but Petitioner Google is not. *See* Pet. 71 (“[T]here is no litigation currently pending against Co-petitioner Google.”).

B. The '750 Patent

The '750 patent is titled “Methods and Apparatus for Detecting a Voice Command.” Ex. 1001, code (54). The abstract describes the subject matter as follows:

According to some aspects, a method of monitoring an acoustic environment of a mobile device, at least one computer readable medium encoded with instructions that, when executed, perform such a method and/or a mobile device configured to perform such a method is provided. The method comprises receiving acoustic input from the environment of the mobile device while the mobile device is operating in the low power mode, detecting whether the acoustic input includes a voice command based on performing a plurality of processing stages on the acoustic input, wherein at least one of the plurality of processing stages is performed while the mobile device is operating in the low power mode, and using at least one contextual cue to assist in detecting whether the acoustic input includes a voice command.

Id. at code (57).

C. Challenged Claims

Petitioner challenges claims 1–19 of the '750 patent. Claims 1, 14 and 19 are independent. Claim 1, reproduced below, is illustrative.

1. A device configured to operate in a lower power mode and a higher power mode, the device comprising:

at least one processor configured to perform at least one processing stage on an acoustic input received from an environment of the device while the device is operating in the lower power mode, performing the at least one processing stage comprising:

determining in the lower power mode whether the acoustic input includes a specific word or phrase that, when spoken, indicates that a voice interface of the device is

to be engaged for provision of subsequent input,
wherein the determining comprises:

performing automatic speech recognition (ASR),
while in the lower power mode, to recognize at
least one word or phrase in the acoustic input;

determining, while in the lower power mode,
whether the recognized at least one word or
phrase matches the specific word or phrase;

in response to determining that the acoustic input includes
the specific word or phrase, requesting, via a network
while in the lower power mode, that at least one server
perform recognition on at least a portion of the acoustic
input to determine whether the acoustic input includes
at least one voice command;

in response to receiving an indication from the at least one
server that the acoustic input includes at least one voice
command, selecting whether to remain in the lower
power mode or to transition to a higher power mode;
and

responding to the at least one voice command, in either the
lower power mode or the higher power mode,
depending on the selecting.

Ex. 1001, 43:50–44:15.

D. Asserted Challenges to Unpatentability

Petitioner asserts four challenges against various subsets of claims 1–
19 of the '750 patent as follows. Pet. 2, 17–70.

Claims Challenged	35 U.S.C. §	References/Basis
1–8, 11, 13–15, 19	103(a) ¹	Basye, ² Shenhav ³
19, 16	103(a)	Basye, Shenhav, Parker ⁴
10, 18	103(a)	Basye, Shenhav, LeBeau ⁵
12, 17	103(a)	Basye, Shenhav, Conroy ⁶

In support of its challenges, Petitioner relies on a Declaration of Christopher M. Schmandt (Ex. 1002).

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

As noted above, the validity of the '750 patent is at issue in the District Court Litigation. Pet. 75; Paper 12, Part II. Patent Owner argues we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.* IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), weigh in favor of denying institution in view of the District Court Litigation. Prelim. Resp. 7–16; Supp. Prelim. Resp. 1–5. Petitioner argues we should not discretionarily deny institution. Pet. 70–75; Prelim. Reply 1–5. For the reasons explained below, we exercise our discretion to deny institution under 35 U.S.C. § 314(a).

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the '750 patent issued claims priority to an application filed before this date, the pre-AIA version of § 103 applies.

² U.S. Publ’n No. 2014/0163978 A1, published June 12, 2014 (Ex. 1005).

³ U.S. Publ’n No. 2014/0006825 A1, published Jan. 2, 2014 (Ex. 1006).

⁴ U.S. Publ’n No. 2015/0106089 A1, published Apr. 16, 2015 (Ex. 1007).

⁵ U.S. Publ’n No. 2012/0034904 A1, published Feb. 9, 2012 (Ex. 1014).

⁶ U.S. Publ’n No. 2011/0314185 A1, published Dec. 22, 2011 (Ex. 1017).

A. Fintiv Analysis

We consider the following six factors to assess “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6. In considering these factors, we apply the guidance set forth in a Memorandum regarding “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,’” issued by the Chief Administrative Patent Judge of the Patent Trial and Appeal Board on March 24, 2025 (hereinafter, “Guidance Memo”).⁷

We address each factor in turn.

⁷ Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf.

1. Factor 1: Likelihood of Stay

A district court stay of parallel litigation pending resolution of an *inter partes* review allays concerns about inefficiency and duplication of efforts, and strongly weighs against exercising our authority to deny institution. *Fintiv*, Paper 11 at 6.

Patent Owner argues “discretionary denial is appropriate” because the district court has already denied Petitioner Samsung’s request for a stay in the District Court Litigation. Supp. Prelim. Resp. 5.

Petitioner argues “[t]his factor is neutral” because “[Petitioner] Samsung’s motion to stay was denied ‘without prejudice’ for it to be refiled later.” Prelim. Reply 1. Petitioner adds that the district court “has granted such re-filed stay motions post-institution even if opposed.” *Id.*

There is no indication in the record of whether a subsequent request for a stay will be granted or denied. Because we decline to speculate on how the district court might rule on a renewed motion to stay that has not been filed, we weigh this factor as neutral. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 12 (PTAB May 13, 2020) (informative) (cautioning against speculating whether the district court would grant a stay if one were requested).

2. Factor 2: District Court Trial Date

If a district court’s trial date is earlier than the Board’s projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution. *Fintiv*, Paper 11 at 9. Here, the district court has set its trial date for October 6,

2025, almost seven months before our deadline to reach a final decision.
Ex. 2004, 1 (Third Amended Docket Control Order).

Patent Owner contends “discretionary denial is appropriate” because “the parties . . . recently agreed to extend the trial date in the District Court action to ensure there is sufficient time to complete all necessary work, thereby raising the likelihood that the new trial date will remain firm.” Supp. Prelim. Resp. 5 (citing Ex. 2004). Patent Owner adds that “even with this newly extended trial date, a decision on the validity of the ’[750] Patent is still expected in the parallel District Court proceeding[] *more than six months prior* to any final written decision in this matter.” *Id.*

Petitioner, on the other hand, suggests this factor is “neutral or weigh[s] slightly against” discretionary denial because the parallel “litigation schedule has been in flux for the past few months.” Prelim. Reply 1–2 (emphasis omitted). Petitioner notes that jury selection was extended from August 4, 2025, to October 6, 2025, “based on a joint motion for additional time to complete important technical discovery obligations,” and that “[t]he docket control order also allows for further amendments.” *Id.* at 2 (citing Ex. 2004); *see also id.* at 4–5 (“[T]he parties have already pushed out the trial . . . and may do so again.”). Petitioner also asserts there are twelve trials set for the same date before the same judge and they cannot all proceed as scheduled. *Id.* In addition, Petitioner asserts the six-month gap between the scheduled trial date and our deadline for a final decision does not compel denial because “this factor is not determinative.” *Id.* at 2; *see also id.* at 4 (“[H]ere it is a 6-month gap.”).

Considering the arguments and evidence presented by the parties, we find this factor weighs in favor of exercising discretion to deny institution.

As noted above, the district court has set a trial date of October 6, 2025, which is almost seven months before the final written decision in this proceeding would be due in late April 2026. Although a number of cases may be scheduled for jury selection on the same day as the District Court Litigation, nothing in the record indicates a trial in the District Court Litigation would not take place months before our deadline to reach a final decision. Because the District Court Litigation will address the issues relating to the validity of the '750 patent in a trial scheduled to occur several months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.

3. Factor 3: Investment in the Related District Court Litigation

We consider now the amount and type of work that the court and the parties will have completed in the parallel litigation by the time of our institution decision. *See Fintiv*, Paper 11 at 9.

Petitioner contends “[t]his factor weighs against discretionary denial” because “substantial work remains, as evidenced by the parties’ joint request for more time” in the District Court Litigation. Prelim. Reply 3. Petitioner acknowledges that claim construction, fact discovery, and opening expert reports are complete, but asserts “expert discovery deadlines, depositions, dispositive motions, and pre-trial disclosures all remain in the future.” *Id.* (citing Ex. 2004). Petitioner also asserts Patent Owner “may agree to stays post-institution[] and, if still opposed after institution, the Board should weigh inefficiencies against [Patent Owner], not [Petitioner] Samsung.” *Id.* Lastly, Petitioner adds the timing of its Petition “weighs against discretionary denial because Samsung timely filed the petition within its

statutorily-allowed period,” and that it “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.” *Id.*

By contrast, Patent Owner argues “discretionary denial is appropriate” because “the parties will have completed claim construction, fact discovery, and expert reports prior to any institution decision, demonstrating an already substantial investment by the parties” in the District Court Litigation. Supp. Prelim. Resp. 5 (citing Ex. 2004). As to timing, Patent Owner complains that Petitioner filed its Petition nearly one year after Samsung was served with the complaint in the District Court Litigation. *Id.* at 4–5 (“Petitioner Samsung . . . was served with a complaint asserting the challenged patent on October 19, 2023 . . . , but Petitioners waited until October 16, 2024—*almost the entire 12 months permitted by statute*—before filing their Petition.”) (citing Ex. 2003 (Proof of Service)).

We agree with Patent Owner’s assessment that work by the district court and the parties is at an advanced stage, whether or not Patent Owner would agree to a post-institution stay. The District Court Litigation has been pending since October 2023, and trial is scheduled to start approximately five months from issuance of this Institution Decision. Claim construction and fact discovery have been completed, and expert discovery is well underway. Petitioner’s timing argument, that it was “reasonable” to file a “single petition” a few days before the 12-month statutory deadline, is not sufficient to overcome the substantial work completed in the District Court Litigation in preparation for a trial scheduled to begin approximately five months from now.

Under these circumstances, we find this factor favors exercising our discretion to deny institution. *See Fintiv*, Paper 11 at 10 (“[D]istrict court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”); *id.* at 11 (“[I]t may impose unfair costs to a patent owner if the petitioner . . . waits until the district court trial has progressed significantly before filing a petition [H]owever, . . . it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding. Thus, the parties should explain facts relevant to timing.”); *see also Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (PTAB Mar. 28, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review) (finding “factor 3 strongly favors discretionary denial” where “the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and “[t]he court also had held a claim construction hearing and construed the disputed claim terms”).

4. Factor 4: Overlap of Issues

This factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art is submitted in both the district court and the *inter partes* review proceeding. *Fintiv*, Paper 11 at 12. In the Guidance Memo, the Chief Judge stated,

[A] timely-filed *Sotera* stipulation[] (*i.e.*, a stipulation from a petitioner that, if an [*inter partes* review] or [post-grant review] is instituted, the petitioner will not pursue in district court . . . any

ground raised or that could have been reasonably raised in the [*inter partes* review]/[post-grant review]) is highly relevant, but will not be dispositive by itself.

Guidance Memo, 2–3; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential).

Petitioner Samsung has offered a *Sotera*-type stipulation, where Samsung represents that if the Board “institutes this [*inter partes* review] petition on the grounds presented therein, then Samsung will not pursue in the [District Court Litigation] any grounds that were raised or reasonably could have been raised in the [*inter partes* review].”⁸ Ex. 1030, 1. Petitioner Samsung further represents the “stipulation does not extend to co-petitioner Google, which is not a party to the [District Court Litigation].” *Id.* According to Petitioner, the stipulation “weighs strongly in favor of not exercising discretion” to deny institution. Prelim. Reply 4.

Patent Owner, however, argues “the District Court invalidity contentions purport to preserve the ability to combine the Apple Siri and Samsung S Voice systems with any of the patent and printed publication art, undermining the effect of the submitted *Sotera* stipulation.” Supp. Prelim. Resp. 2 (citing Ex. 2002, 406, 416 (Defendants’ Second Amended Invalidity Contentions)).

⁸ In its Preliminary Reply, Petitioner asserts that “Samsung agreed that it will not raise in district court any art or arguments that it raised or reasonably could have raised in the [*inter partes* review].” Prelim. Reply 4 (emphasis added). The stipulation, however, states that “Samsung will not pursue in the . . . litigation any grounds that were raised or reasonably could have been raised in the [*inter partes* review].” Ex. 1030, 1 (emphasis added). Contrary to Petitioner’s assertion in the Preliminary Reply, the wording in the stipulation contemplates relying on art raised in this proceeding.

On this record, Petitioner Samsung’s stipulation appears to mitigate some concern of duplication between the District Court Litigation and this proceeding as well as the possibility of conflicting decisions. It does not, however, ensure this proceeding would be a “true alternative” to the District Court Litigation. *See Sotera*, Paper 12 at 19; *see also Motorola*, Paper 19 at 3–4 (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [*inter partes* review] proceedings would be a ‘true alternative’ to the district court proceeding”). Petitioner Samsung’s invalidity contentions in the District Court Litigation are much more expansive, including pages of cited references, and Samsung has reserved the right to rely on any of the references to prove invalidity. Ex. 2002, 12–13 (citing eleven additional references); *id.* at 406, 411–416 (citing “other relevant references” across six pages). Also, Petitioner Samsung does not dispute Patent Owner’s concern that the invalidity contentions contemplate combining the Apple Siri and Samsung S Voice systems with any of the cited references, including those cited in this proceeding. *See* Prelim. Reply. Indeed, Petitioner notes in its Preliminary Reply that “system art could never reasonably be raised before the Office.” *Id.* at 4.

We recognize the contention that “this [*inter partes* review] is co-Petitioner Google’s **only** forum to present its invalidity challenge.” Prelim. Reply 5. As noted above, Petitioner Google is not a party to the District Court Litigation, and, therefore, the stipulation discussed above does not apply to Google. This fact does not alter our analysis because there is no parallel proceeding in which Google is currently challenging the validity of

the '750 patent. Thus, Petitioner Google's presence in this proceeding does not raise the concerns that a *Fintiv* analysis is designed to address.

If we were to grant institution in this proceeding, we would be considering the same claims of the '750 patent whose validity would have been previously tried before the district court. On balance, therefore, we find this factor weighs slightly against exercising our discretion to deny institution.

5. Factor 5: Identity of Parties

For this factor, we consider “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 13 (emphasis omitted).

Petitioner and Patent Owner acknowledge that Petitioner Samsung and Patent Owner are parties to both this proceeding and the District Court Litigation. Pet. 74; Prelim. Resp. 14; Supp. Prelim. Resp. 3. Petitioner argues “[t]his factor weighs against discretionary denial,” however, because Google and Samsung “are not the same party” and the District Court Litigation “would not resolve [Petitioner] Google’s interest in invalidating the [’750] patent.” Prelim. Reply 5.

Patent Owner argues that “[t]he addition of Google LLC as a petitioner should not alter the analysis.” Prelim. Resp. 14.

As explained above, the District Court Litigation is scheduled to go to trial well before our deadline to reach a final decision should we institute *inter partes* review in this proceeding. Although Petitioner Google is not a defendant in the District Court Litigation, the invalidity of the '750 patent will have been fully litigated in the District Court Litigation, which is well

underway. Petitioner does not address sufficiently why we should redo the work of another tribunal regarding substantially the same issues, notwithstanding the identity of the parties. Under these circumstances, we find this factor weighs in favor of exercising our discretion to deny institution. *See Fintiv*, Paper 11 at 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.”).

6. Factor 6: Other Circumstances, Including the Merits

The final *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny institution, such as the merits of the patentability challenges. *Fintiv*, Paper 11 at 14–16.

Each party appears to argue that the merits tip the balance in its favor. *See Supp. Prelim. Resp.* 2–4; *Prelim. Reply* 5. Petitioner asserts it “ha[s] established a strong case on the merits that involve new, non-cumulative obviousness theories that will not be addressed in the parallel [District Court Litigation].” *Prelim. Reply* 5. Patent Owner asserts “the Petition’s extensive reliance on conclusory expert testimony to gap-fill holes in the prior art demonstrates discretionary denial is appropriate.” *Supp. Prelim. Resp.* 3–4.

Although we may consider the merits for this factor, a full analysis of the merits is not necessary; rather, the parties may point out particular strengths or weaknesses to aid us in deciding whether the merits tip the balance one way or another. *Fintiv*, Paper 11 at 14–16. We have considered

the parties' arguments and evidence regarding the asserted challenges. On this record, we find the merits of Petitioner's asserted challenges do not outweigh the other *Fintiv* factors.

In view of the foregoing, we determine this factor is neutral.

B. Fintiv Determination

We have taken into account the circumstances and facts before us in view of the *Fintiv* factors. As discussed above, factors 1 and 6 are neutral, factors 2, 3, and 5 weigh in favor of discretionary denial of institution, and factor 4 weighs slightly against discretionary denial. We conclude that, on balance, the evidence of record favors exercising our discretion to deny institution of *inter partes* review.

IV. CONCLUSION

For the reasons given above, we exercise our discretion under § 314(a) to deny institution of *inter partes* review.

V. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* and no trial is instituted.

IPR2024-01465
Patent 11,087,750 B2

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