

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioners

v.

SOUNDCLEAR TECHNOLOGIES LLC,
Patent Owner

U.S. Patent No. 9,031,259
Issue Date: May 12, 2015

Title: NOISE REDUCTION APPARATUS, AUDIO INPUT APPARATUS,
WIRELESS COMMUNICATION APPARATUS, AND NOISE REDUCTION
METHOD

Inter Partes Review No. IPR2025-00345

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF
UNITED STATES PATENT NO. 9,031,259**

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PATENT OWNER EXHIBIT LIST

Exhibit No.	Description
2001	Memorandum of Law in Support of Google's Motion to Transfer to the Northern District of California Under 28 U.S.C. § 1404(a) (Dkt. 39)
2002	Judge Wright Allen's median time to trial available at https://law.lexmachina.com/federal-court/district/judge/3373/cases/?pending-from=2009-01-01&filters=true&view=analytics&tab=timing&cols=title%2Ccivil-number%2Ccase_type%2Ccourt%2Cfiled%2ClastDE%2Cterminated
2003	Docket Printout of VA No. 2:24-cv-00321 (EDVA)
2004	Docket Printout of VA No. 2:24-cv-00320 (EDVA)
2005	Eastern District of Virginia's median time to trial in patent cases available at https://law.lexmachina.com/court/vaed/cases/?pending-from=2009-01-01&filters=true&view=analytics&tab=timing&cols=title%2Ccivil-number%2Ccase_type%2Ccourt%2Cfiled%2ClastDE%2Cterminated
2006	Reply Brief in Support of Google LLC's Partial Motion to Dismiss Plaintiff's Complaint Under Rule 12(b)(6) (Dkt. 25)

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 1-20 (“the challenged claims”) of U.S. Patent No. 9,031,259 (“’259 patent,” Ex. 1001).

I. INTRODUCTION

The Director should exercise her discretion to deny institution of this Petition in view of the new discretionary denial considerations, informed by the *Fintiv* factors. They counsel against the Board being used as a strategic vehicle—especially in the face of fact issues, discovery matters, and expert disputes that only an Article III court has the tools to address. The district court will adjudicate those matters—and every issue in a case involving three patents—before this *Inter Partes* Review (“IPR”) proceeding concludes.

This Petition is one of two IPRs (IPR2025-00344 (“344 Petition”), IPR2025-00345) filed by Google challenging a subset of patents at issue in *SoundClear Technologies LLC v. Google LLC*, 2:24-cv-00321¹ (E.D. Va., May 1, 2024). If institution is denied for both Google Petitions, median time-to-trial statistics indicate that the parallel district court case will proceed to trial in January 2026.

¹ Hereinafter “the district court case.”

That is *9 months before* the statutory deadline for the Board’s final written decisions.

Moreover, the issues before the district court will be more expansive than those asserted in its Petitions. IPR proceedings would not, and could not, serve as an effective alternative to the district court proceedings. For example, Google only filed IPRs against two of the three patents² asserted against it. And Google will raise additional product prior art and claim constructions regardless of the outcome of this IPR.

Further, SoundClear will suffer immediate prejudice in this IPR by being cut off from discovery related to conception and reduction to practice of the patent. It is subject to pre-AIA first-to-invent laws. Thus, discovery could defeat the Petition *ab initio* by establishing a priority date that predates the asserted prior art. The named inventor, however, is a third-party who resides in Japan. Google admitted to the district court that his testimony, and indeed the testimony of “all six named inventors [of the patents in suit,] ... is material and relevant, because it will relate to

² The ’259 patent (at issue in the instant IPR proceeding); U.S. Patent No. 9,070,374 (“’374 patent”) (at issue in IPR2025-00344), and U.S. Patent No. 9,804,819 (“’819 patent”) (not challenged by Google before the Board).

A third party filed an IPR against the third patent. But it waited much later—until the last minute—to do so. That Petition is weak, and the reasons for discretionary denial exceptionally strong.

issues of validity and infringement.” Ex. 2001, 14. It admitted that all six reside in Japan. *Id.* Those third-party witnesses in Japan are beyond the reach of a U.S. subpoena. Letters Rogatory are required, but the PTAB is unable issue them. Thus, Google acknowledged the existence of discovery that could only favor SoundClear in the district court. Then it filed IPRs where SoundClear cannot obtain it.

Google also stated that it will seek the testimony of at least two additional individual and corporate witnesses in connection with validity issues. *Id.*

Then there is the immediate prejudice to SoundClear. Institution of this IPR will delay its ’819 patent case by two or three years.³

Worse yet, Google essentially seeks a purely advisory opinion from the Board. Google did not commit to *any* stipulation that it will forego invalidity positions in the parallel district court proceeding if the Petition is instituted. Estoppel notwithstanding, nothing bars Google from any attempt to rely on substantially identical prior art combinations and the same invalidity theories already presented to the Board.

Each of the above concerns are compounded by Google’s intent to pursue contradictory claim construction positions for purposes of invalidity (before the Board) and non-infringement (in district court). If even a single claim escapes the

³ 12-18 months for the Final Written Decision plus 12-19 months for appeal (Ex. 2002).

IPR proceeding, Google will seek claim constructions more favorable to infringement issues.

Furthermore, Google deliberately delayed the parallel district court litigation and prevented the case from moving forward. Google sequentially filed fact-intensive motions and resisted discovery at every turn. Google even submitted fact and lay opinion testimony of three of its own witnesses in connection with a motion to transfer. SoundClear attempted to conduct limited discovery targeting the basis for such opinions. But Google refused even that.

Google waited to move for a stay pending IPR until well after briefings for its motions were completed. That is neither accident nor coincidence. It is a coordinated approach, mirrored between Google and Amazon. Other large tech defendants will no doubt follow suit if that approach bears fruit.

Google's litigation tactics directly contravene the purpose of IPRs—to ensure a speedy, just, and efficient resolution of patent disputes. They necessitate expenditure of considerable time and resources by the district court and the parties, only to seek an abrupt disruption long after the case was filed.

Finally, the Petition is facially deficient in multiple ways. None of the prior art references in the Petition, either alone or in combination, expressly discloses the claimed invention as arranged. The Petition rarely relies on express disclosures in the prior art in their full context. It instead selects snippets of quotes in some

places and applies its own annotations to relabel or retitle other components. It then leans on expert declaration testimony to render ultimate conclusions. But the expert declaration constitutes no more than conclusory, attorney-argument. It is a mirror image of the Petition with only superficial and/or typographical changes. Even if credited, the declaration/argument contradicts express disclosures in the prior art, fails to notice or resolve errors in the prior art (that could not have been missed had Google considered it as a whole), and is internally inconsistent.

The Petition also fails to provide a *prima facie* obviousness analysis under *Graham*. It does not specify what limitations are missing from the primary references (second factor), why a POSITA would have been motivated to bridge the gap (first factor), or *any* analysis supporting conclusory statements of reasonable expectation of success.

II. PROCEDURAL BACKGROUND OF PARALLEL LITIGATIONS

On May 1, 2024, SoundClear filed two separate suits in the U.S. District Court for the Eastern District of Virginia against Google (*SoundClear Technologies LLC v. Google LLC*, 2:24-cv-00321, Dkt. 1 (E.D. Va., May 1, 2024) and Amazon.com, Inc., Amazon.com LLC, and Amazon Web Services, Inc. (*SoundClear Technologies LLC v. Amazon.com, Inc. et al.*, 2:24-cv-00320, Dkt. 1 (E.D. Va., May 1, 2024) (the “Amazon Case”)). Both the Google case and the Amazon case were assigned to Judge Arenda L. Wright Allen.

The same three patents are at issue in both the Google case and the Amazon case:

- the '259 patent;
- the '374 patent; and
- the '819 patent.

On August 5, 2024, Google filed a motion to dismiss in the district court case raising a number of both substantive and dispositive grounds. *See* Ex. 2003, Dkt. 13. Those grounds included patent eligibility under §101 and non-infringement. On August 26, 2024, Amazon also filed a motion to dismiss in the district court case based on grounds similar to those raised in the Google case. *See* Ex. 2004, Dkt. 30.

On November 4, 2024, Google filed a motion to transfer the district court case to the Northern District of California. Ex. 2003, Dkt. 38. Google supported its motion to transfer with lay opinion and fact testimony of three of its own witnesses. On January 23, 2025, SoundClear filed a motion for expedited venue discovery in the Google case. *Id.*, Dkt. 69. The district court held a hearing on the same and denied SoundClear's motion on March 5, 2025. *Id.*, Dkt. 78.

On February 18, 2025, Google filed a motion to stay pending *inter partes* review in the district court case. *Id.*, Dkt. 73. The district court granted Google's motion to stay on March 31, 2025. *Id.*, Dkt. 84.

Also on March 31, 2025, the district court issued an order in the Amazon Case granting in part and denying in part Amazon’s motion to dismiss. Ex. 2004, Dkt. 48. Specifically, the court denied Amazon’s motion with respect to invalidity of the ’374 patent under Section 101 but granted Amazon’s motion with respect to non-infringement of the ’819 patent and willfulness. *Id.* The motion was granted without prejudice and allowed SoundClear to amend its complaint. SoundClear will do so in a manner that clarifies the issue that the district court found to be ambiguous.

On April 7, 2025, Amazon filed a motion to stay pending *inter partes* review in the district court case. *Id.*, Dkt. 49. On April 21, 2025, SoundClear filed notice of non-opposition to Amazon’s stay motion. *Id.*, Dkt. 52.

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.⁴

The Morgan Stewart Memo permits the Director to consider existing precedent under *Fintiv*, and *Advanced Bionics* along with the Consolidated Trial Practice Guide (Nov. 2019).⁵ Morgan Stewart Memo, 2 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR2019-01469, Paper 6 (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

⁴ See FAQs for Interim Processes for PTAB Workload Management, April 25, 2025, (<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>) (“FAQs”).

⁵ Consolidated Trial Practice Guide (Nov. 2019), available at <https://www.uspto.gov/patents/ptab/trials/practice-guides>.

- Any *other* considerations bearing on the Director’s discretion.

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

B. *Fintiv*

The Board’s precedential *Fintiv* decision provides six factors for determining “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.” *Fintiv*, IPR2020-00019, Paper 11, 5-6. The Director takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Google LLC v. Personalized Media Commc’ns, LLC*, IPR2020-00720, Paper 16, 5 (PTAB Aug. 31, 2020) (citing *Fintiv*, IPR2020-00019, Paper 11, 5-6). Here, the factors favor discretionary denial. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, 20 (PTAB Sept. 12, 2018) (precedential) (“Institution of an *inter partes* review under these circumstances would not be consistent with ‘an objective of the AIA . . . to provide an effective and efficient alternative to district court litigation.’” (citation omitted)). As such, the Board should exercise its discretion and deny institution here.

IV. ARGUMENT

A. Judicial Economy and Efficiency Support Denial

Google’s choices support denying institution. It deployed a procedural strategy that is taking hold among large tech defendants.

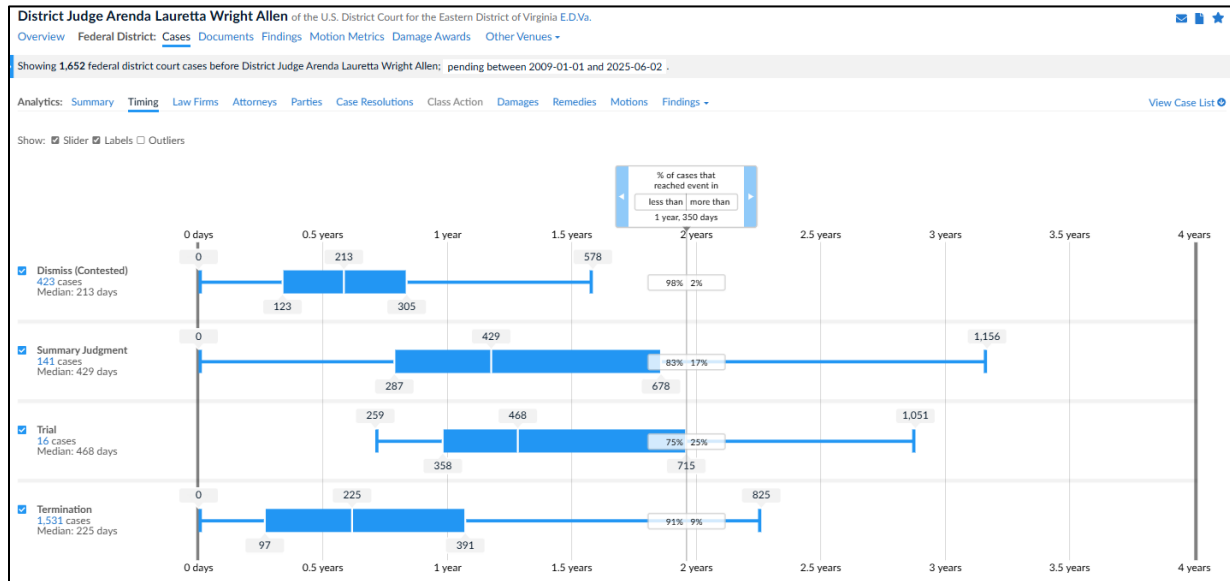
Google repeatedly prioritized district court proceedings over IPR proceedings. It resisted discovery, kept the patentee's case from moving forward, and then pivoted to filing IPRs and moving to stay only when it did not obtain quick resolution on its motion to dismiss. In other words, its approach *avoids* a speedy, just, and efficient resolution and gives it a strategic advantage. It directly contravenes the purpose of IPRs. Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012) (codified at 37 C.F.R. §§ 42.100 et seq.) (establish a “streamlined” system that “limit[s] unnecessary and counterproductive litigation costs.”); 37 C.F.R. § 42.1 (the rules “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”). A number of factors demonstrate why denial is justified under such circumstances.

1. *Fintiv* Factor 2 Strongly Favors Denial – The District Court Trial Would Conclude 9 Months Before FWD for this IPR is Due

According to *Fintiv*, “[i]f the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution.” *Fintiv*, IPR2020-00019, Paper 11, 9. Here, the Final Written Decision is not due until October 2026. In contrast, median time-to-trial

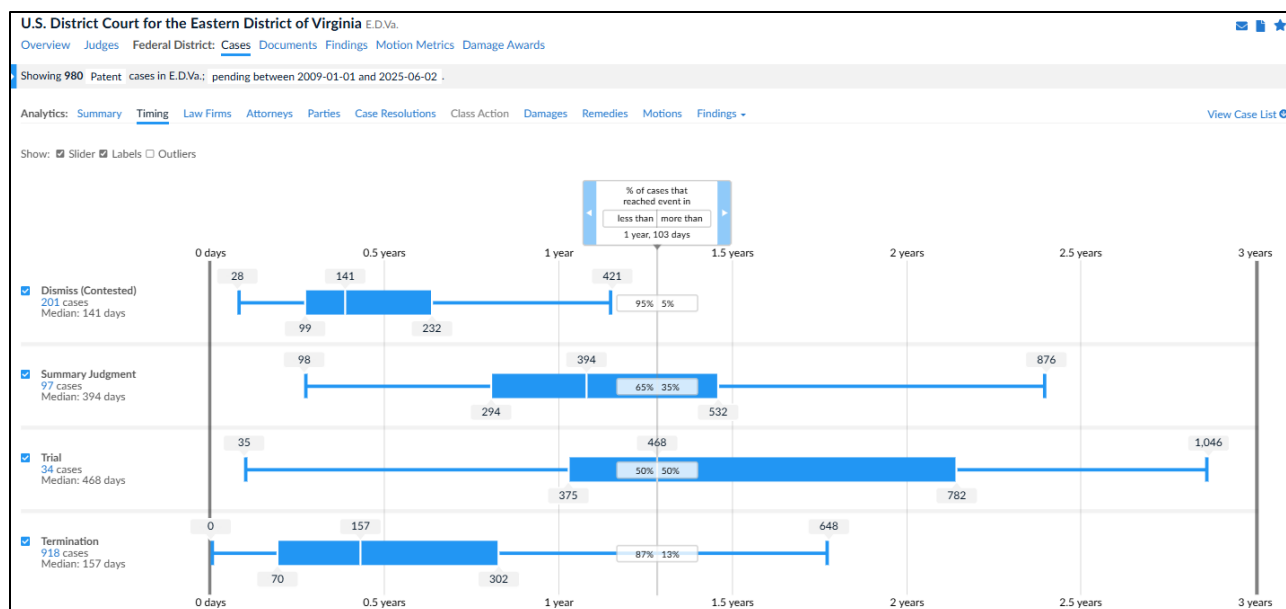
statistics suggest that the two parallel district court cases will proceed to trial by January 2026. That is 9 months before final written decision is due.

Judge Wright Allen has presided over 16 trials. For those trials, the median time-to-trial was 468 days—or 15.4 months:



Ex. 2002.

Judge Wright Allen’s median time-to-trial statistics align with those of the patent cases in the Eastern District of Virginia, which also had a median time-to-trial of 468 days:



Ex. 2005.

Thus, if institution of this IPR is denied in August 2025, the district court case will proceed to trial by January 2026 (assuming the case proceeds on the timeline discussed above). In the alternative, 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.

Accordingly, *Fintiv* Factor 2 weighs strongly in favor of discretionary denial. *See ARM Ltd. V. Daedalus Prime LLC*, IPR 2025-00207, Paper 10, 2 (PTAB May 16, 2025) (granting request for discretionary denial where projected trial date based on time-to-trial statistics precedes projected final written decision due date by 1-3 months); *Ericsson Inc. v. Procomm Int’l PTE. Ltd.*, IPR 2024-01455, Paper 15, 2 (PTAB May 16, 2025) (granting discretionary denial where

scheduled jury selection and projected trial date based on median time-to-trial precedes projected final written decision due date by 9 months).

a) There *Will* Be a Two-to-Three Year Delay in Related Cases

Institution of Google's Petition will immediately prejudice SoundClear. In addition to the delay in the district court case that is still pending in the Eastern District of Virginia, it will needlessly delay the resolution of SoundClear's case on the '819 patent by two or three years.⁶

That case is ready to proceed right now.

b) *Fintiv* Factor 3 and Avoiding Becoming a Tactical Vehicle to Prejudice Patent Owners

Google submitted to the district court for ruling on many fact-laden, dispositive issues. It also sought transfer to another district court. It now calls on the Board as its third recourse. And it does so by raising only some of its invalidity arguments (*see* Section IV.B.3 *infra*) and only on two of the three patents in the case. Those grounds are far down Google's list of the substantive merits to address.

Google proceeded as follows:

June 17, 2024 Google sought an extension of time to answer complaint.

Aug. 5, 2024 Google did not answer any count. Google moved to dismiss *with prejudice* on two fact-specific grounds:

⁶ 12-18 months for the Final Written Decision plus 12-19 months for appeal (Ex. 2002).

- Ineligible subject matter ('374 patent)
- Non-infringement ('819 patent)

Dkts. 13-14.

<u>Nov. 4, 2024</u>	Google filed a motion to transfer, relying on the declaration testimony of three Google employees
Jan. 23, 2025	SoundClear filed a motion to conduct venue discovery addressing the foundation of facts and opinions raised by the Google employee declarants. Google filed an opposition to that motion on Feb. 6, 2025.
<u>Feb. 18, 2025</u>	Google filed a motion to stay
Mar. 5, 2025	Court held a hearing and denied SoundClear's motion to conduct venue discovery

Ex. 2003.

In short, Google filed sequential motions at the pleadings stage to prevent discovery from proceeding. It first sought a prompt *with-prejudice* ruling on fact-specific, dispositive issues. When it did not obtain one, it filed a motion to transfer.

SoundClear sought to have discovery proceed into at least the factual/lay-opinion issues raised in connection with the motion to transfer. Google again pivoted and filed its motions to stay.

That is a unilateral, sequential approach designed to favor one party: Google. It takes advantage of the fact that the decision of when to begin IPR

proceedings lies with Google alone. IPR proceedings were designed for the opposite purpose: to streamline litigation and promote just resolution.⁷

The Director can ensure IPR proceedings serve their intended purpose by considering petitioners' choices in related proceedings when exercising her discretion to deny institution. At some point, petitioners should have to make some choices. Choose to litigate fact-laden, dispositive issues before the district court or proceed first to the Board.⁸ Choose to proceed under plain-and-ordinary meaning or disclose, and commit to, consistent claim construction positions.

In short, if Google were committed to addressing obviousness as a priority, it would have filed IPR petitions, and sought a stay, before seeking to transfer the district court case. It would have done so before raising arguments that are better suited for summary judgment or trial (*e.g.*, *Alice* and non-infringement). And it

⁷ See §IV.A.1 *supra*.

⁸ That is not to say that challenging the pleadings for failing to provide proper notice or to seek a more definite statement will always preclude institution. But there are matters that are more appropriate for summary judgment or trial. For example, detailed, fact-specific matters like non-infringement and *Alice* step 2 (in most cases). If a petitioner believes that written-prior-art-based invalidity issues predominate, there would be no prejudice to saving dispositive resolution on those highly factual issues until after IPR proceedings.

In short, SoundClear submits that the Director's analysis should be made on a case-by-case basis. The amount and extent to which a party seeks to have a district court prioritize, and delve into, substantive factual and technical issues should be considered in connection with discretionary denial of IPRs.

would have disclosed and committed to claim construction positions in both proceedings.

2. FAQ 11 and 37 C.F.R. § 42.104(c) – No *Sotera*-type Protection for Divergent Claim Construction Approaches

Google’s petition does not seek to construe any terms.⁹ But it included an express qualification for the purpose of allowing it to seek different, narrowing constructions before the district court: “[Google] may raise indefiniteness and/or claim constructions in other forums.” Pet. 4, n.4. There is no “may” about it.

Google included that language for a reason. Google cites the inapplicable *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) case that many petitioners use to attempt to justify their inconsistent, prejudicial approach.

Google plans to take diametrically opposite claim construction positions before the PTAB and the district court to attain an unfair strategic advantage. Indeed, Google admitted that it will seek to engage in “time consuming claim construction” in the district court. Ex. 2006, 1; *see also id.* (“claim construction has not happened *yet*.” (emphasis added). If the Board grants institution, Google will

⁹ The Petition does not seek a formal construction for any claim term. *See* Pet., 4 (“[n]o terms need construction to resolve the unpatentability issues in this Petition.””).

get the chance to argue validity under broad claim constructions at the Board¹⁰ while preserving its ability to argue non-infringement under narrow constructions¹¹ at a later date. There is no mechanism—akin to a *Sotera* stipulation—to prevent it.

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, among others, *White v. Dunbar*, 119 U.S. 47, 51 (1886)).

¹⁰ *Roku, Inc. v. Universal Elecs., Inc.*, No. 2023-1019, 2024 U.S. App. LEXIS 14723, at *9-10 (Fed. Cir. June 18, 2024) (finding “no clear basis for deviating from the disputed term’s broad plain and ordinary meaning” (emphasis added); see also *VSolvit, LLC v. United States*, 166 Fed. Cl. 201, 214 (2023) (plain and ordinary meaning can be “rather broad”).

¹¹ “We depart from the plain and ordinary meaning of claim terms based on the specification in only two instances: lexicography and disavowal.” *Talexmedical, LLC v. Becon Med. Ltd.*, Nos. 2021-2069, 2021-2071, 2021-2109, 2021-2110, 2022 U.S. App. LEXIS 20252, at *14 (Fed. Cir. July 22, 2022) (citations omitted). Google has identified no lexicography. And disavowal can only narrow a claim.

The Board’s FAQ 11 expressly also prohibits Google’s approach. It states that the non-discretionary considerations “may include for example: (1) claim construction issues . . .” (citing *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024)). The Board, in *Cambridge*, stated that “[a]t a minimum, the Petition should have explained why the plain and ordinary meaning of the [the] terms should apply in this proceeding (why the inconsistent positions are warranted) or set forth an alternative [] claim construction.” *Cambridge*, IPR2024-00952, Paper 12, 8.

To be sure, inconsistent positions are sometimes allowed. But only when they are justified. And only when they avoid risking inconsistent results. The *10x Genomics, Inc. v. Bio-Rad Lab ’ys, Inc.*, IPR2020-00086, Paper 8, 18 (PTAB Apr. 27, 2020) decision *Cambridge* cites provides an example. *Cambridge*, IPR2024-00952, Paper 12, 8. It is distinguishable from Google’s approach for at least four reasons.

First, *10x Genomics* involved a dispute that had been crystalized. Both parties knew what the issue was and what each side’s positions were. *10x Genomics*, IPR2020-00086, Paper 8, 18-21. Google has not identified what its proposed constructions in the district court will be.

Second, the petitioner did not seek to take inconsistent positions before two adjudicative bodies. It submitted alternative positions, in the same proceeding, to

the same body (the Board). Google has not disclosed its alternative positions for the Board to consider.

Third, the factual records will diverge between the Board and the district court case—which was not an issue in *10x Genomics*. Google may introduce extrinsic evidence supporting its claim construction positions in the district court. That evidence will not be available in the IPR proceedings.

Fourth, in *10x Genomics*, the petitioner had proposed a narrowing construction, which would have guaranteed a consistent record. *Id.* 11-12. It thus presented a more conservative position on invalidity. The petitioner only presented the broader, alternative grounds, in response to the *patent owner's* broader construction. *Id.*, 12. In short, the petitioner presented the Board with two options, (1) address invalidity under a narrow construction, which would have made petitioner's position more difficult or (2) proceed under a construction the patentee proposed, which the patentee would not be able to disavow in any later proceeding. Google's approach is the exact opposite in every respect.

The *Nidec* case on which Google relies (*see* Pet., 4) is inapplicable.

First and foremost, if there were a rule of law allowing a party to orchestrate proceedings for the purpose of taking divergent positions, it would be plainly stated. That is not the type of gambit that would be incidentally countenanced; such as, for example, when reviewing results in hindsight on appeal. Or when

determining, after *all* issues have been put on the table, whether claim construction is needed.

The law set forth in *Amgen* and *White* is clear. *Nidec* does not change it. The *Nidec* court and Board analyzed proposed constructions in hindsight—at the end of the case. They determined, *post hoc*, that the parties’ disagreement on a proposed construction/interpretation had no bearing on the court’s determination. *Nidec*, 868 F.3d at 1017 (“Whether or not *Nidec* is correct, the result does not change.”). *Nidec* did not address—let alone countenance—issuing final rulings on one dispositive issue before conducting claim construction to decide another dispositive issue. And it certainly did not address whether a party engaged in litigation with an affirmative plan to benefit from taking inconsistent positions.

In short, there is no law that allows Google to apply a favorable claim scope on invalidity but then turn around and seek to apply a narrower scope for purposes of non-infringement. Thus, Google’s attempt to gain an unfair advantage by doing so here weighs heavily against institution under Factor 6.

3. Google Improperly Seeks an Advisory Opinion

Google seeks an advisory opinion from the Board. Its Petition seeks to have the Board issue a final decision on validity without knowing whether or how any claim terms will later be construed before the district court.

For example, consider if Google were to prevail on invalidity of an independent claim (*e.g.*, claim 1) by applying a broad plain and ordinary meaning of one or more terms but fail to establish invalidity on the dependent claims (*e.g.*, claims 2-11). Google believes it would be appropriate to nonetheless ask the district court to construe terms in claim 1; *e.g.*, when addressing claims that depend from it (which incorporate the language of claim 1). That construction would almost certainly be narrower than¹²—but at least different from—the plain and ordinary meaning. In that instance, the operability of the Board’s decision would all of a sudden stand in conflict with the ruling of an Article III court. *Cf. Samsung Electronics America, Inc. v. Uniloc, 2017 LLC, IPR2020-00046, Paper 6 at 7-8* (PTAB Apr. 1, 2020) (declining to issue “advisory opinion”).

4. SoundClear Will be Prejudiced If Not Allowed Access to the District Court’s Discovery Mechanisms and to a Jury

Technical, factual, and evidentiary issues will dominate this case. Many result from the expert fight Google teed up on almost every issue. Google’s Petitions rely 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

¹² See notes 10-11 *supra*.

will have to weigh the testimony and balance credibility of the experts. *See* FAQ 21.

Fact issues also pervade. SoundClear will suffer immediate prejudice in this IPR by being cut off from discovery related to conception and reduction to practice of the patent. It is subject to pre-AIA first-to-invent laws. Thus, discovery could defeat the Petition *ab initio* by establishing a priority date that predates the prior art. The named inventor, however, is a third-party who resides in Japan. Google admitted to the district court that his testimony, and indeed the testimony of “all six named inventors [of the patents in suit,] ... is material and relevant, because it will relate to issues of validity and infringement.” Ex. 2001, 14. It admitted that all six reside in Japan. *Id.* Google’s statements are as follows:

Inventors of the Asserted Patents. Inventor testimony is material and relevant because it will relate to issues of validity [A]ll six named inventors appear to live in Japan. Although residing far outside of both districts, it would be quicker and more convenient for the inventors to travel to the NDCA than the EDVA....

Inventors of prior art. Although this case is in early stages, Google has identified at least one promising prior art system that it believes will be highly relevant and material to this case These witnesses [plural] should be considered for the same reasons here.

Ex. 2001, 14-15.

There is a big problem. Third-party witnesses residing in Japan are beyond the reach of a U.S. subpoena. Letters Rogatory are required. But the PTAB is unable to issue them. Thus, Google acknowledged the existence of discovery that

could only favor SoundClear in the district court. Then it filed IPRs where SoundClear cannot obtain it.

There is more. In the statements quoted above, Google also stated that it will rely on product prior art before the district court. Whether and to what extent those overlap with the prior art it identified in its Petition (e.g., from Kale and Li-730) remains to be seen.

Additionally, Google stated that it will seek “highly relevant and material” testimony of at least two additional individual and corporate witnesses in connection with validity issues. *Id.* That would require discovery into JVC Kenwood Corporation, their employer, which is famous for having innovated in these areas.

It is a prejudicial tactic to identify foreign, third-party discovery related to an issue (e.g., validity), assert that it is relevant to the case, and then seek out a forum to address that issue (e.g., invalidity at the PTAB) where that discovery is unavailable.

Thus, the Board should defer to the district court based upon Google’s decision to rely almost exclusively on expert-testimony/attorney-argument in its Petition. It should also defer to Google’s admission to the district court that discovery of all six inventors is needed to address validity, which only the district court can provide.

B. The Additional *Fintiv* Factors Favor Discretionary Denial

The other *Fintiv* factors favor discretionary denial.

1. *Fintiv* Factor 1 is Neutral

The district court stayed litigation amongst substantial uncertainty about future proceedings before the PTAB and without the benefit of the PTAB's latest guidance. The Board's recent guidance was not presented in briefing to the Court. *see* Ex. 2003, Dkts. 73 (Feb. 18, 2025) to 80 (Mar. 10, 2025). If institution is denied, the stay will be lifted, and the case will proceed to trial in the district court in January 2026.

Indeed, the bifurcation of discretionary and merits considerations allows the Director to proceed quickly to make a determination as to discretionary denial, without issuing a formal opinion on the merits of the IPR. The new procedure and guidance further allays concerns of inefficiency and duplication of efforts between the Board and district courts.

In view of this bifurcated review process, district courts' granting of a temporary stay should carry little weight in the Director's decision to discretionarily deny institution of IPR—if the Director denies institution, then the stay would be lifted. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3-4 (PTAB Mar. 29, 2025) (order granting director review and denying institution of IPR despite stay of district court proceeding pending institution

decision; noting that “[b]ecause the petitions in these IPR proceedings are now denied, the claims challenged in the petitions are no longer subject to IPR proceedings,” and thus stay can be lifted).

Accordingly, where (as here) all other factors indicate that IPR proceedings would not serve as an efficient alternative to district court proceedings, a stay granted before the Director’s discretionary denial decision should not weigh against discretionary denial.

2. *Fintiv* Factor 3, Under the New Guidance, Should Favor Denial

SoundClear submits that the Director should not only consider the district court’s investment in a proceeding; she should also consider whether and to what extent either party was at fault for delaying the case. And she should consider whether one party sought to, or did, obtain an advantage over the other party in terms of the district court’s investment. Each favors denial here.

In this instance, Google’s serial filings ensured that SoundClear’s district court case never got off the ground. Additionally, Google has ensured that the court’s investment related solely to issues that might benefit Google. SoundClear, by contrast, has not even been able to begin discovery. Google even resisted discovery into fact and opinion testimony it introduced into the record via declaration testimony of three of its own employees.

Google's serial-filing approach does not appear coincidental. Amazon followed that approach in its case: extension, then substantive motion to dismiss, then motion to stay pending IPR proceedings.

Both parties chose to prioritize substantive, fact-specific, dispositive issues ahead of their obviousness cases before the Board. Specifically, both Amazon and Google prematurely sought district court rulings on fact-laden dispositive issues—including invalidity under 35 U.S.C. § 101, non-infringement, and venue transfer—instead of diligently preparing their obviousness case before the Board. As a result of Amazon and Google's litigation strategy, the district court and the parties have invested considerable time and resources in the district court cases.

In both district court cases, Amazon and Google respectively filed a motion to dismiss on § 101 and non-infringement grounds. Those issues were fully briefed. Ex. 2003, Dkts. 13-54.

In addition, Google filed a motion to transfer the district court case to the Northern District of California. Google even submitted fact and lay opinion testimony of three of its own witnesses in support of its motion to transfer. SoundClear attempted to conduct limited discovery into the basis for such opinions. But Google refused at every turn. That necessitated a motion and briefing. SoundClear's reply in support of its objections to the magistrate judge's

ruling on that issue was pending when the stay was implemented. Ex. 2003, Dkts. 73 and 80.

Because Amazon and Google both chose to file its motion to stay pending IPR until after briefing and hearing for these fact-specific motions were completed (and in Google’s district court case, until after the court has ruled on Amazon’s motion to dismiss), the district court expended considerable time and resources on the parallel proceedings. Those circumstances weigh in favor of discretionary denial. *See 10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15, 18 (PTAB Mar. 7, 2024) (noting that the district court’s consideration of two motions to dismiss and several discovery disputes, among other things, evince investment of “significant amount of time and resources to the parallel proceeding”).

Moreover, to ensure that IPRs serve their intended purpose of streamlining litigation and promoting just and efficient resolution, the Director should consider petitioners’ choices in related proceedings when exercising its discretion to deny institution—discretionary denial of petitions filed by petitioners which have deliberately chosen to first burden the district court with fact-laden, dispositive issues before presenting its obviousness case to the Board better serve the object and purpose of IPR proceedings.

Here, if Google and Amazon were committed to addressing obviousness as a priority with efficiency and judicial resources in mind, they would have filed IPR petitions, and sought to stay their respective district court proceedings, *before* raising fact-intensive arguments (*e.g.*, *Alice* and non-infringement). In view of the resource expenditure necessitated by Google and Amazon’s coordinated, one-sided litigation strategy, *Fintiv* Factor 3 should weigh in favor of discretionary denial.

3. *Fintiv* Factor 4 Favors Denial – No *Sotera* or *Sand* Stipulation

The 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. *Fintiv*, Paper 11, 12; *see also, e.g., 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, we determine that this factor weighs in favor of discretionary denial.”).

Google decided not to provide any stipulation. That, along with its strategy of inconsistent claim construction positions, evinces an intent to evade finality.

Moreover, FAQ 14 instructs petitioners to “file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the

stipulation in its discretionary denial brief.” Thus, the Director should disregard any subsequently filed stipulation as untimely.

Even if Google had timely filed a *Sotera* or *Sand* stipulation, such stipulation would not be “particularly meaningful” given Google’s statement that it *will* rely on system prior art regardless of the outcome of the IPR. FAQ 14; *see Motorola*, IPR2024-01205, Paper 19, 4 (denying institution despite *Sotera* stipulation; explaining that “Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.”)

For example, Google identified at least one piece of product/system prior art “that it believes will be highly relevant and material to this case.” *See* Ex. 2001, 15 (identifying “telecommunication and conferencing produces provided by Poly Inc.”). And Google stated that multiple “witnesses” will have to be deposed. *Id.*

That was before discovery even opened. Google will not deny that it will assert additional product prior art in connection with each patent. *Id.* (“This prior art system is directly relevant to the material issue of invalidity”). It will not deny that it will seek to avoid estoppel of other prior art grounds when the case returns to the district court.

Thus, *Fintiv* factor 4 favors discretionary denial.

4. *Fintiv* Factor 5 Favors Denial – The Parties Are the Same

The parties are the same in the Petition and the district court case, which supports denial of Institution. *See Fintiv*, IPR2020-00019, Paper 15, 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”); *Lenovo (United States) Inc. v. Univ. Connectivity Techs., Inc.*, IPR2024-01481, Paper 19, 14 (PTAB Apr. 17, 2025) (treating affiliate and its parent as the same entities for purposes of discretionary denial analysis).

Thus, *Fintiv* factor 5 favors discretionary denial.

5. *Fintiv* Factor 6 — Google’s Invalidity Grounds Are Weak

Factor 6 favors denial all by itself. It is certainly not irrelevant. *See Pet.*, 95-96. Tellingly, the Petition’s two-paragraph analysis on discretionary denial completely skips over Factor 6. Google’s discretionary denial arguments also rely on the USPTO’s June 21, 2022 “Guidance Memo,” which has now been rescinded. In view of the Board’s new discretionary denial policies suggest, Factor 6 carries as much weight as the circumstances of the petition demand. As detailed below, the circumstances relevant to Factor 6 underscore the weakness of the Petition. Thus, Factor 6 weighs heavily against institution.

a) Confluence of Expert Testimony and Attorney Argument

Google’s Petition relies entirely 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 Ground 1 and Ground 5 arguments demonstrate this. For at least independent claims 1, 12, and 13, nearly every paragraph in the declaration exactly mirrors an argument paragraph in the Petition. *Compare* Pet., 5-19, 50-89, with Ex.1003, ¶¶65-73,117-120, 174-200, 218-230. In the rare instances where there is some difference, they are superficial or typographical. *Compare, e.g.*, Pet., 84 and 88 (citing “Fig. 2B” below image labeled “Fig. 2A”) *with* Ex. 1003, ¶¶218, 227 (citing “Fig. 2B” below image labeled “Fig. 2B”). Google adjusted the look and feel of the document paragraphs in the declaration and the Petition. *Compare, e.g.*, Pet., 75 *with* Ex. 1003, ¶¶193-194. But a review of the written statements in each

document demonstrates that the declaration statements are virtually a carbon copy of the Petition arguments.

The Ground 2 arguments in the Petition further exemplify Google’s approach. For claim 3, 6, 8 15, 18, and 19, the Petition simply states that modifying the alleged disclosure of Kale to incorporate the alleged teaching of Namba “does not alter” the alleged disclosure of Kale. Pet., 32, 36-37. The mirrored paragraphs in the Lipoff declaration state the exact same thing. Ex. 1003, ¶¶131, 138-139, 145, 147-148. Neither the Petition nor declaration provides any explanation as to *why* the combination does not alter the alleged disclosure of Kale.

The Petition thus reduces to pure, conclusory attorney argument as to important claim limitations. The expert/attorney statements are conclusory and unsupported. Thus, the Petition fails for those reasons alone.

b) FAQ 21 — Extensive Reliance on Expert Testimony

Even if the declaration were to be credited, the disputed issues are best resolved at the district court:

While the Board may consider expert testimony, as a matter of efficiency, *extensive* reliance on expert testimony and/or *reasonable disputes between experts* on dispositive issues may suggest that the questions are better resolved in an Article III court.

FAQ 21; *see also* Morgan Stewart Memo, 2 (bullet 4).

The Petition relies heavily on the expert/declaration—which largely extrapolates the primary references—and attorney argument instead of express

disclosures. Google relies on either its Kale reference (Ex. 1006) or Li-730 reference (Ex. 1005) for every ground. But they are foundationally distinguishable from the claims at a high level. Thus, none of the combinations of disclosures/references discloses the claimed inventions as arranged. For that reason, Google rarely relies on express disclosures in the prior art. It instead relies upon its own annotations of the prior art—often in a manner that retitles disclosed components and creates contradiction with other disclosures. Thus, even if its expert-testimony/attorney-argument is accepted, it will require a jury to determine credibility and decide the factual contest between experts.

a) The Petition Is Weak and Technically Flawed

Google’s Petition exemplifies what happens when a party relies solely on impermissible hindsight to hunt and peck through references to find disclosures. *Fox Factory, Inc. v. SRAM, LLC*, 813 F. App’x 539, 542 (Fed. Cir. 2020) (“The Supreme Court has held that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Instead, there must have been an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” (cleaned up, internal citation omitted)).

That approach fails to assess the disclosure as a whole. And it leads to a party like Google missing what would otherwise be unavoidable errors in the disclosure.

Starting with Kale. Neither Google nor its expert nor the Petition identified the clear errors in Kale's disclosure. Or, if they noticed them, they declined to address them. Either way, the Petition lacks any explanation of how a POSITA would have understood Kale's disclosure despite those errors. Neither points out that, for example, Kale is inconsistent as to which functions the "Direction of Arrival module (DOA) 820" and "beamformer 825" perform. Ex. 1006, ¶¶[0034]-[0041] and [0047]. Both are introduced in Kale ¶[0028]. There are at least three clerical errors: Kale refers the DOA as component "825" three times. A POSITA may have determined that every citation to component 825 should be understood as a citation to the beamformer. But that still does not resolve inconsistencies in Kale. It is ambiguous and inconsistent as to which component (the DOA or beamformer) performs which functions and when. Or how they are connected. As one example, in one instance, Kale discusses direction in connection with component 825. *Id.*, ¶¶[0034]-[0039]. In other instances, it discusses beam forming in connection with component 825. *Id.*, ¶[0040]. Kale never clarifies which component relates to which function; it seems to leave them all mixed together in non-enabling confusion. *See, e.g., id.*, ¶[0047] (unspecified recitation of "the above

described computations”). SoundClear and its expert will address these matters in SoundClear’s substantive responses. But there is no doubt they exist: An initial review of paragraphs [0034]-[0041] and [0047] of Kale is certain to confuse the reader enough to know that (1) such concerns are present and (2) Google did not address them in its Petition.

Kale also hints at an optional but non-enabled modification when discussing Fig. 9. It states that “[a]n initial step *may* be to determine which of the raw audio data signals comprises the speech signal.” *Id.*, ¶[0044] (emphasis added). But Kale only enables a system that predetermines which microphone will receive speech. That decision is hardwired into the process. Fig. 8 shows that only one signal (805) from one microphone (“a first microphone” (*id.*, ¶[0029])) is input to the “Formant Detection Module (FDM)” (*id.*, ¶[0028]); and that signal is sent straight to the beamformer:

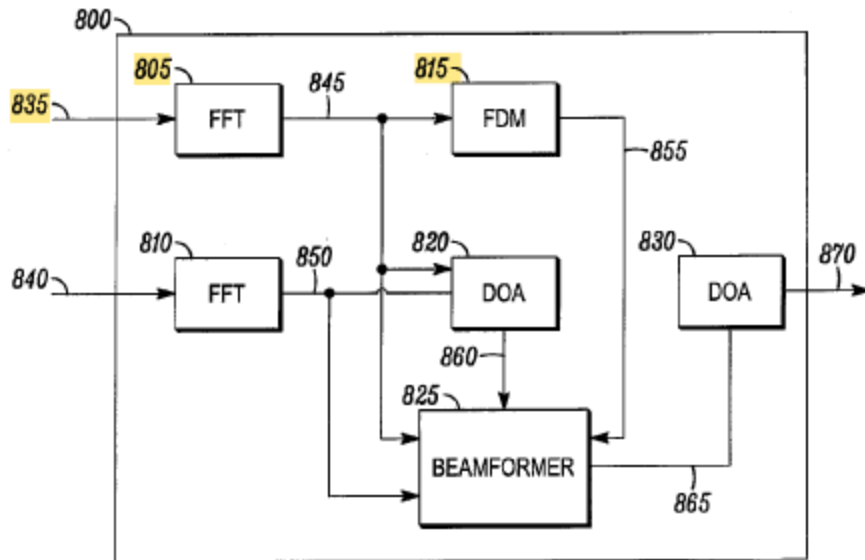
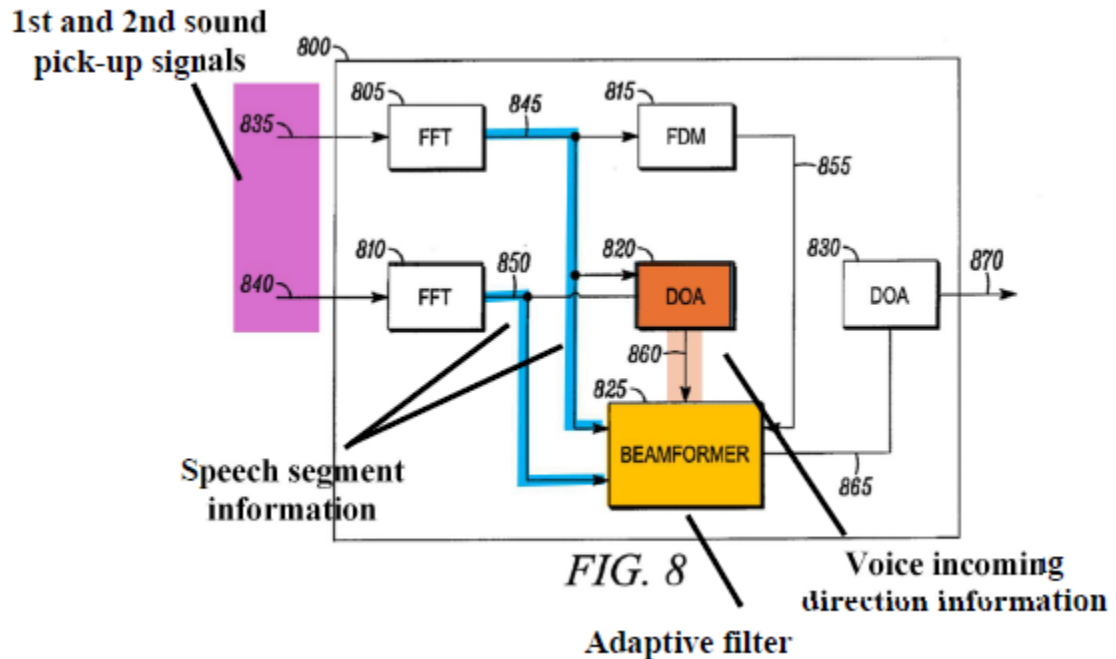


FIG. 8

Id., Fig. 8 (annotations by SoundClear).

The Petition is also technically deficient and confusing in this regard. It asserts that *both* signals contain speech (see “Speech segment information” annotation added by Google).



Pet., 17 (citing Ex. 1006, Fig. 8) (annotations by Google).

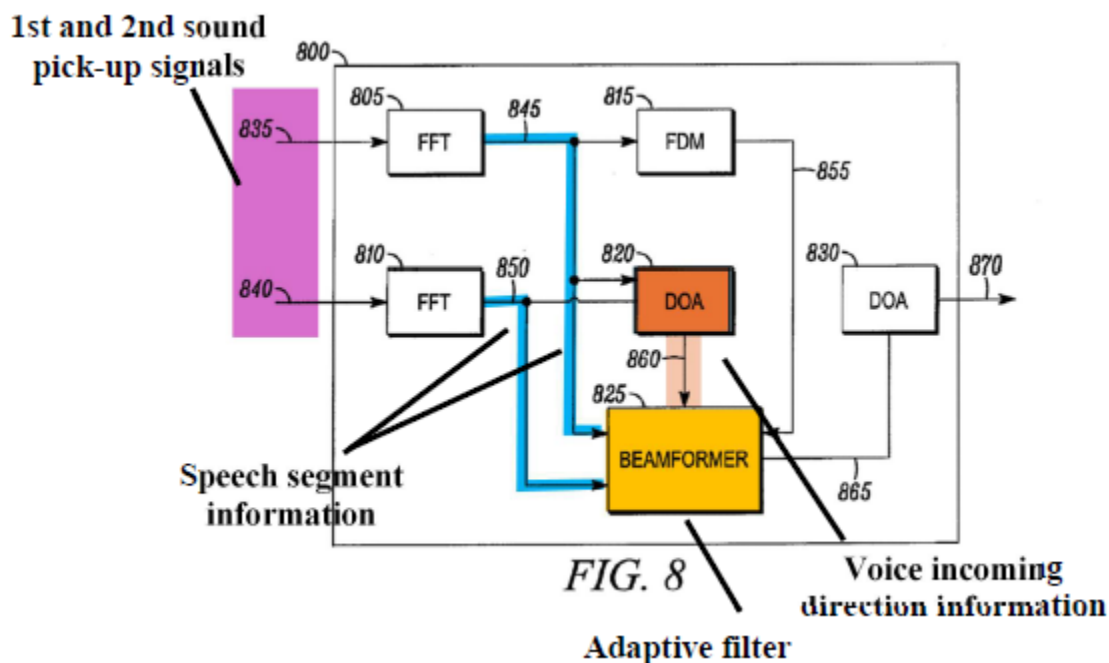
Google’s position is at best inconsistent. Google elsewhere asserts that Kale determines “which of the raw audio data signals comprises the speech signal.” *Id.*, 9. It does not explain how Kale makes a determination between two signals when both purportedly contain speech. Nor does it explain how that can be done when the speech signal is predetermined and hardwired in.

That is not the only inconsistency. Google relies on *different* disclosures in Kale as supposedly determining speech. In one instance, Google asserts that Kale “is similar to the speech segment determiner of the ’259 patent which *also* uses formants to detect speech segments.” *Id.*, 10 (emphasis added). Indeed, Kale discloses an eponymous Formant Detection Module (FDM) 815.

But Google elsewhere asserts that it is Kale's Fast Fourier Transform (FFT) module(s) that constitute the claimed "speech segment determiner[s]." *Id.*, 8. That directly contradicts Kale paragraph [0044] (which Google cites throughout the Petition). Paragraph [0044] states that speech determination (if any) has already been made before the FFT blocks: "Upon determining which microphone received the speech signal, a first processing may be the FFT." Ex. 1006, ¶[0044]. As stated above, that option in Kale is not enabled, and is contradicted by Fig. 8. Either way, Google does not address Kale's inconsistency and lack of clarity. It attempts to revise the disclosure and creates its own internal inconsistency by doing so.

In short, Google's attorney/experts have modified the express disclosure of what FFTs are (and do) as well as what the beamformer and DOA are (and do).

There is more. Google's Petition reads the Formant Detection Module out of the process:



Pet., 17 (annotations by Google).

They all add up to improper and inconsistent attempts to revise Kale’s disclosure via an amalgam of expert and attorney arguments.

Google’s other primary reference, Li-730, fares no better—for at least two reasons. First it relies on attorney argument that contradicts the express disclosure of Li-730. For example, Li-730 discloses a “direction of arrival (DOA) estimator 232.” Ex. 1005, ¶[0025]. But the Petition ignores that component and relies on the “beamformer” as disclosing the recited “voice direction detector.” Pet., 66-68. The version of Li-370 Fig. 2A Google annotated follows:

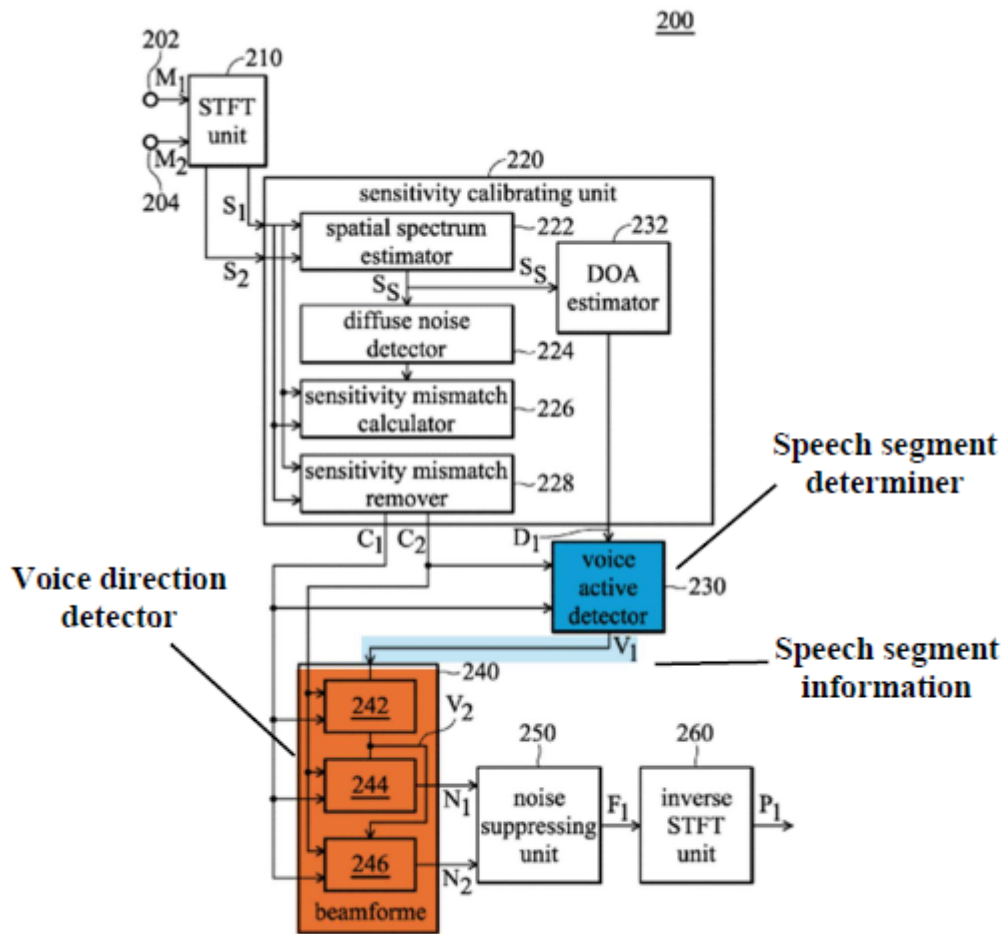


FIG. 2A

Pet., 68 (citing Li-730, Fig. 2A) (annotations added by Google).

The Petition ignores the DOA estimator 232 altogether. That is not to say that components associated with a beamformer can never determine direction. But the Petition does not explain how or why a POSITA would understand Li-370 to disclose a second direction determination component. There is certainly no express disclosure in that regard. And the Petition does not even mention the DOA estimator. In short, the Petition provides no record on which the Board could

conclude that Li-730 accomplishes a direction of arrival determination somewhere other than the DOA estimator.

A similar facial deficiency occurs across Ground 5 in the Petition. For example, in connection with limitation [1a], Google identifies M1 and M2 as picking up “speech segment[s].” Pet., 57; *id.*, 58 (highlighting M1 and M2). But, in connection with limitation [1d] (e.g., “based on the speech segment information”), it relies on some amalgamation of signals V1, C1, N1, etc. Pet., 76-83.

Those portions (Pet., 76-83) rest entirely on attorney argument (i.e., statements in the petition that mirror the expert declaration). There is no express disclosure of the noise suppressing unit 250 acting as Google asserts that it does. Nor does Google explain how the “noise suppressing unit 250” is based on any of the recited information. M1 and M2 (cited in connection with claim [1a]) are separated by a complex process from N1 and N2 (cited in connection with claim [1d]). The Petition recites snippets of how various signals are generated. But it never explains how they tie together in connection with the claims (especially at limitation [1d]).

The Petition and declaration also rely on their own customized wording in many places. For example, the Petition and declaration refer to Kale’s beamformer as an “adaptive noise filter.” Pet. 21, 25, 36; Ex. 1003, ¶¶100, 112, 138. But Kale does not recite or mention an “adaptive noise filter.”

Thus, again, the Petition is inconsistent and faulty. The best Google can hope for is an expert battle over whether Google's annotations and omissions of relevant components are correct.

The above guidance reflects a reality of the judicial system and inherent limits of PTAB proceedings. A wholesale disagreement between experts is much better resolved before an Article III court and by a jury. The more issues raised for dispute, the more the credibility of the expert needs to be considered. And juries are best suited for that task.

Indeed, "[t]he failure to provide focused expert testimony may weigh against institution." FAQ 21. Google's Petition is almost entirely duplicative of its expert's opinions. Thus it is not only unfocused, but also indistinguishable.

C. The Petition Gives Insufficient Notice of Google's Unpatentability Grounds

Google conflates obviousness and anticipation. They are two different grounds upon which a patent can be invalid. They require distinct analytical approaches.

Google's Petition and expert declaration each repeatedly state contradictory alternative positions without differentiating between the two: "discloses or renders obvious." *See, e.g.*, Pet., 94; Ex. 1003, ¶215. That is confusing, non-committal, multiplicative language.

Obviousness and anticipation are separate and distinct grounds with separate statutory requirements. *See SNF S.A. v. Chevron U.S.A.*, IPR2022-01534, Paper 46 at 18-19 (PTAB Apr. 18, 2024); *Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) (explaining how “[t]he tests for anticipation and obviousness are different). They “require[] different tests and different elements of proof.” *Minkin v. Gibbons, P.C.*, 680 F.3d 1341, 1351 (Fed. Cir. 2012).

A reference anticipates if it “disclose[s] each and every limitation of the claimed invention, either expressly or inherently.” *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1306 (Fed. Cir. 2019). In contrast, every obviousness ground requires weighing “(1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the art; and (4) objective considerations of nonobviousness.” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1358 (Fed. Cir. 2017) citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966)). And since “it is error to reach a conclusion of obviousness until all of those factors are considered” (*id.*), a “technically anticipated invention” need not be obvious. *Cohesive Techs.*, 543 F.3d at 1364.

Google and its expert use alternative phrasing that invokes both anticipation and obviousness. But they explain neither. They use those arguments to preface discussions about the alleged disclosures. But they do not apply any applicable

legal standard for anticipation (*e.g.*, express or inherent) or obviousness (*e.g.*, single-reference¹³ or in combination). They fail to address any specific *Graham* factor. For example, Google’s position that certain elements are disclosed implicitly asserts that there are no differences between the claims and the prior art; whereas *Graham* factor 2, in direct contrast, requires that those differences be expressly identified. *See Arctic Cat*, 876 F.3d at 1358. Alternative positions are sometimes appropriate, but not when they are stated in a shrouded and inseparable manner. Neither Google nor its expert ever addressed the differences between the claims and the prior art. Neither explained why the claimed combinations would have been obvious despite any (unidentified) differences.

The Petition thus fails to fairly disclose its arguments, fails to articulate any reasoning to support it, fails to establish a *prima facie* case, and contradicts positions required under *Graham*. In short, the Petition provides no basis for invalidating the patents without requiring that the Board commit reversible error.

D. 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. Despite basing each ground of the Petition on

¹³ *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016) (explaining legal standard that applies even for missing disclosures that are “unusually simple”)

obviousness under §103 and several other grounds on combinations of multiple references, Google *never* mentions *Graham* factor two. It merely provides boilerplate recitations in support of factor one. And then it proceeds to simply identify alternative disclosures for each limitation. That approach violates *Graham* and *KSR*. One cannot merely point to disparate disclosures between multiple references and presume a POSITA would have been motivated to, or could with reasonable success, piece the references together in some unarticulated way to make it work.

Graham factors one and two go hand-in-hand. Motivation to combine and expectation of success are generally considered as part of the first factor. *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1370 (Fed. Cir. 2006). And 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).¹⁴

¹⁴ See also, e.g., MPEP 2143 (every example of “rationales” requires an assessment of “difference[s] between the claimed invention and prior art,” how

The Petition does not identify “the differences between the claims and the prior art.” *Arctic Cat*, 876 F.3d at 1358 (citing *Graham*, 383 U.S. at 17–18). For example, the Petition states, in connection with claim 10, that “Kale discloses ...” certain details, “Kale further explains...” certain details, and “Yamada teaches...” certain details. Pet., 48. But that is it in terms of applying *Graham*. The Petition never states what Kale does *not* disclose. It simply fails to identify those gaps it uses obviousness to fill, nor does it 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.

Graham factor two must be applied expressly. And it must be done so in compliance with *KSR*.¹⁵ Thus, every obviousness position that missing an express application of factor two is legally insufficient.

The Petition’s failure to address *Graham* factor one is also problematic for at least three reasons.

First, the Petition provides purely conclusory obviousness statements. That much is clear from the fact that the language in the Petition is virtually identical to

prior art “differed from the claimed device,” what “improvement” that claimed device lacked, identifying a finite number of potential “improvements,” or identifying a “modif[ication]” to be made).

¹⁵ *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (citation omitted)).

that of Google’s expert. They constitute neither opinion nor analysis. They are boilerplate—yet incomplete—restatements of some of the exemplary motivation-to-combine rationales set forth in MPEP § 2143. And they only provide generalized assertions about alleged improvements such as simplifying systems. Each fails as a matter of law. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-00582, Paper 34, 21-22 (PTAB Aug. 5, 2019) (informative decision) (“a generic desire for ‘improved access times’ is “merely a bald statement . . .”). “The factual inquiry whether to combine references must be thorough and searching, and the need for specificity pervades this Court’s authority on the Board’s findings on motivation to combine.” *Id.* (cleaned up); *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Second, the Petition fails to implicitly establish that any results would have been “predictable” or that a POSITA would have had a “reasonable expectation of success”—other than repeating the words “reasonable expectation of success” or some version of “improve.” It never mentions the word “predictable.” Each of the six instances where the Petition relies on a “reasonable expectation of success” rationale are supported by the conclusory statement that “it would have merely required routine skill in the art to do so.” *See, e.g.*, Pet., 31, 35, 39, 43, 45, 49. There is no *KSR*-level reasoning or discussion of how or why that would have been the case. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013) (“Even assuming that a person of ordinary skill might have some motivation to

[combine], the record does not show any reasonable expectation that this significant change would be successful.”); *A/S v. Coolit Sys. Inc.*, No. 19-cv-00410-EMC, 2022 U.S. Dist. LEXIS 246288, at *23-24 (N.D. Cal. Sep. 11, 2022) (finding the following “conclusory sentence” insufficient: “[w]hen the cited references are combined or modified as a POS[IT]A would have been motivated to do, the combination or modification is also based on conventional or known methods that would have yielded predictable results and been reasonably expected to be successful by a POS[IT]A.’ ... This conclusory assertion is insufficient show reasonable expectation of success.”); *see* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to credit unsupported assertions of an expert witness).

Third, the Petition fails to state the level of ordinary skill in the art. The Board has provided informative decisions on this issue. For instance:

Two common types of testimony regarding skill level, however, are in themselves typically *insufficient*: (1) what education and work experience the hypothetical person of skill had and (2) whether the skill level was high or low. A statement that "a person of ordinary skill in the art had a Ph.D. in X and 7 years of relevant experience in Y" assumes that the reader already appreciates what such a person would have known.

Ex Parte Jud, 2006-1061 (Jan. 30, 2007) (Informative) at 6 (emphasis added); *see also Dionne v. Liotta, Int.*, 104, 333, Paper 119, 5 (Oct. 31, 2001) (“Beyond the conclusory statements of its experts, Dionne has failed to identify sufficient evidence in support of its alleged skill level.”).

The petition provides even less than the two insufficient pieces above. It addresses (1) but not (2). *See Pet.*, 4 (“a bachelor’s degree in electrical engineering or related discipline, and at least two years of experience in voice or audio processing.”).

V. CONCLUSION

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

Dated: June 9, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Brief in Support of Discretionary Denial complies with the type-volume limitations of 37 C.F.R. §§ 42.24(b)(1) because it contains 9,833 words, 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).

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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. 9,031,259 was served electronically via email on June 9, 2025, on the following counsel of record for Petitioner:

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