

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
AMAZON.COM SERVICES LLC, and
AMAZON WEB SERVICES, INC.,
Petitioner,

v.

SOUNDCLEAR TECHNOLOGIES LLC,
Patent Owner.

IPR2025-00565
Patent 11,069,337 B2

Before ST. JOHN COURTENAY III, DAVID C. McKONE, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

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

Amazon.com, Inc., Amazon.com Services LLC, and Amazon Web Services, Inc., (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–5 (“the challenged claims”) of U.S. Patent No. 11,069,337 B2 (Ex. 1001, “the ’337 patent”). Petitioner also filed a Declaration of Richard Stern, Ph.D., with the Petition. *See* Ex. 1002. SoundClear Technologies LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2022). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “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.”

Upon consideration of the Petition, the Preliminary Response, and the evidence of record, for the reasons given below we determine the information presented in the Petition demonstrates there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the ’337 patent.

Accordingly, we institute an *inter partes* review of claims 1–5 of the ’337 patent based upon the second ground of unpatentability set forth in the Petition over Shin. Pet. 30–32.

I. INTRODUCTION

A. *Real Parties in Interest*

Petitioner identifies “Amazon.com, Inc., Amazon.com Services LLC, and Amazon Web Services, Inc.” as the real party-in-interest. Pet. 72. Patent Owner identifies itself, SoundClear Technologies LLC, as the real

party-in-interest. Paper 3, 1. Patent Owner indicates that “SoundClear Technologies LLC is a wholly owned subsidiary of SoundClear LLC.” *Id.*

B. Related Matters

The parties identify the following related district court cases involving the ’337 patent: *SoundClear Technologies LLC v. Amazon.com, Inc., et al.*, CA No. 1:24-cv-01283 (E.D. Va.); *SoundClear Technologies LLC v. Google LLC*, CA No. 3:24-cv00540 (E.D. Va.). Paper 3, 1–2; Paper 10, 1; Pet. 72–73.

C. The ’337 patent

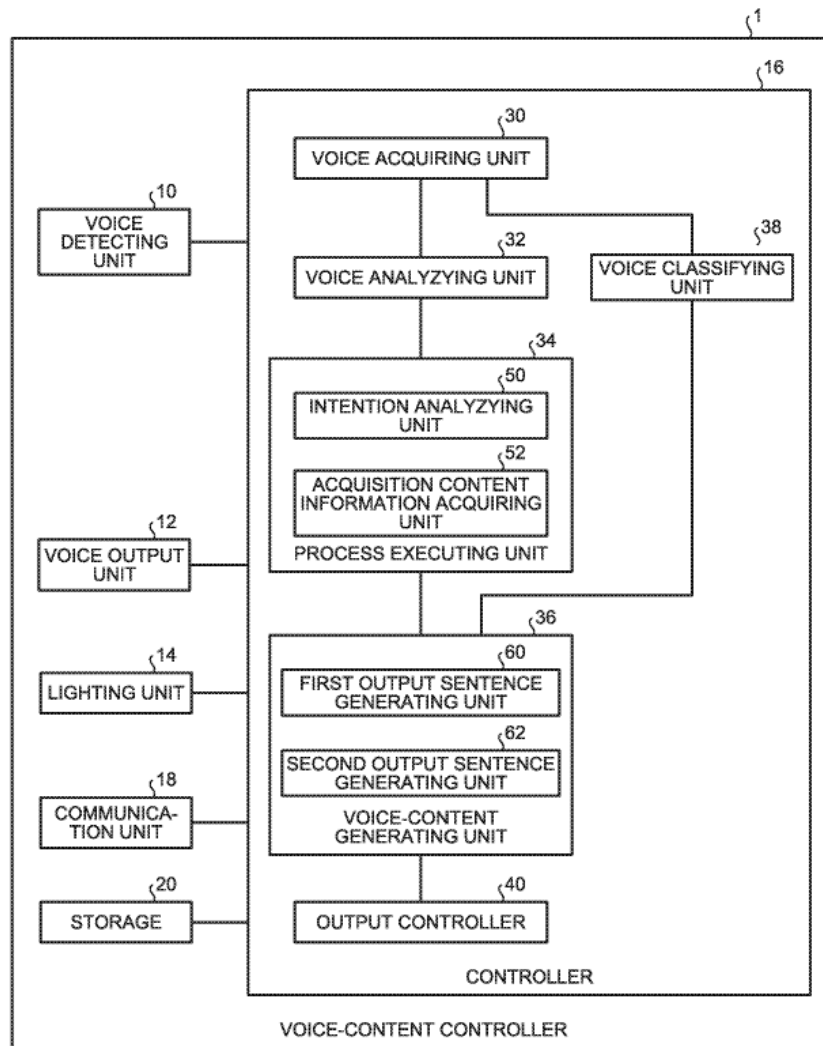
The ’337 patent is entitled “Voice-Content Control Device, Voice-Content Control Method, and Non-Transitory Storage Medium,” and “relates to a voice-content control device, a voice-content control method, and a non-transitory storage medium.” Ex. 1001, code (54), 1:15–17.

The ’337 patent describes “when a voice processing device that outputs voice is used, the output voice may be heard by a person who is not the user of the voice processing device and is around the voice processing device,” and, “on outputting the voice to the user, influence of the output voice to people other than the user is desired to be suppressed, and content of the output voice to the user is desired to be made adequately understandable.” Ex. 1001, 1:29–32, 1:39–42. The ’337 patent further describes “analyzing the acquired voice to classify the acquired voice as either one of a first voice and a second voice” and then generating “a first output sentence . . . as the output sentence when the acquired voice has been classified as the first voice” and “a second output sentence . . . as the output sentence in which a part of information included in the first output sentence

is omitted when the acquired voice has been classified as the second voice.”
Id. at 1:65–2:11; *see id.* at 1:46–64, 2:12–26.

Figure 2 of the '337 patent, reproduced below, illustrates an example of the voice-content control device. Ex. 1001, 2:38–39.

FIG.2



An exemplary embodiment of the Voice-Content Control Device is depicted above in Figure 2 of the '337 patent.

D. Illustrative Claim

Petitioner challenges claims 1–5 of the '337 patent. Pet. 1, 6. Claims 1, 4, and 5, are the independent claims. Claim 1 is illustrative of the challenged claims, and recites the following (Petitioner's bracketing and identifiers added):

1[pre]. A voice-content control device, comprising:

1[a] a proximity sensor configured to calculate a distance between a user and the voice-content control device;

1[b] a voice classifying unit configured to analyze a voice spoken by a user and acquired by a voice acquiring unit to classify the voice as either one of a first voice or a second voice based on the distance between the user and the voice-content control device;

1[c] a process executing unit configured to analyze the voice acquired by the voice acquiring unit to execute processing required by the user;

1[d] a voice-content generating unit configured to generate, based on content of the processing executed by the process executing unit, output sentence that is text data for a voice to be output to the user; and

1[e] an output controller configured to adjust a sound volume of voice data obtained by converting the output sentence thereinto, wherein

1[f] the voice-content generating unit is further configured to generate a first output sentence as the output sentence when the acquired voice has been classified as the first voice, and

1[g] generate a second output sentence in which information is omitted as compared to the first output sentence as the

output sentence when the acquired voice has been classified as the second voice, wherein

1[h] the output controller is further configured to adjust the sound volume of voice data such that the sound volume of voice data obtained by converting the first output sentence thereinto differs from the sound volume of the voice data obtained by converting the second output sentence thereinto.

Ex. 1001, 18:39–19:3.

E. Prior Art

Petitioner submits the following asserted references as evidence:

Name ¹	Reference	Issue or Publication Date	Exhibit(s)
Shin	U.S. Pat. App. Pub. No. 2017/0083281 A1	Mar. 23, 2017	Ex. 1003
Shimomura	JP Pat. App. Pub. No. 2005-202076 A	Oct. 28, 2005	Ex. 1004
Kristjansson	U.S. Pat. No. 10,147,439 B1	Dec. 4, 2018	Ex. 1013

a. Summary of Shin (Ex. 1003)

Shin is titled “method and electronic device for providing content.” Ex. 1003, code (54) (capitalization omitted). Shin relates “to voice input for an electronic device, and more particularly, to a method and an electronic device for providing content in response to a voice input.” *Id.* ¶ 3.

¹ First named author or inventor only.

Shin describes performance drawbacks associated with providing content based on electrical signals converted from user voice input, such as lack of an emotional connection between the user and the electronic device when providing content. Ex. 1003 ¶¶ 6–7. For example, “the electronic device provides the content with a uniform speed, a monotonous tone, and a preset volume, regardless of the user’s conditions while providing the voice input,” and because “the electronic device does not consider nuances according to a form of the user’s speech, it is difficult for the electronic device to provide content appropriate for the user’s condition.” *Id.* ¶ 7. To address these drawbacks, Shin discloses “a content providing method that analyzes a voice input of a user’s speech and determine an output scheme of content based on the various speech features obtained from results of the analysis and an electronic device performing the same.” *Id.* ¶ 8.

Shin discloses a processor “to determine an output scheme of the content” corresponding to the voice input “based on at least one of a speech rate of the speech, a volume of the speech, or a keyword included in the speech, which is obtained from an analysis of the voice input.” Ex. 1003 ¶ 9. Shin discloses an example with the processor that “may determine an output scheme of the content such that an output amount of information of the content decreases as a distance between the user and the electronic device 101 increases” and also “such that the output amount of information of the content increases as the distance between the user and the electronic device 101 decreases.” *Id.* ¶ 86. Shin explains that “a user who requests content with a voice input to the electronic device 101 while being far away from the electronic device 101 may want core content corresponding to the voice input rather than detailed content,” and “the user may be provided with

corresponding content in a suitable output amount of information based on a distance between the user and the electronic device 101.” *Id.* ¶ 89.

b. Summary of Shimomura (Ex. 1004)

Shimomura is titled “speech control device and method and robot device.” Ex. 1004, code (54) (capitalization omitted). Shimomura relates “to a speech control device and method, and a robot device, which is suitable for application to, for example, an entertainment robot.” *Id.* ¶ 1.

Shimomura describes performance drawbacks associated with conventional robots equipment with voice and speech recognition and interaction control functions, due to conventional robots always conversing “with the user at a constant speech volume set in advance, regardless of the physical distance between the robot and the user.” Ex. 1004 ¶ 4. As a result, the speech volume setting may be too low for a user a little distance away from the robot to hear the speech content even when appropriate for a user closer to the robot, or the speech volume may be too high for a user close to the robot to hear the speech content even when appropriate for a user a little distance away from the robot. *Id.* ¶ 5. However, merely making it possible to freely change the speech volume of the entertainment robot impairs the naturalness of the interaction between the user and the robot, and also does not address when a room has a lot of reverberation. *Id.* ¶¶ 6–7.

To address these drawbacks, Shimomura discloses “a speech control device and method, and a robot device, that can improve the entertainment value of a robot having a dialogue control function.” Ex. 1004 ¶ 9. Shimomura discloses a “speech control device that controls the speech of the device during a dialogue between the device and a user” with “a speech form changing means . . . that changes the speech form of the device during a

dialogue with the user as necessary according to the distance between the device and the user.” *Id.* ¶ 10.

c. Summary of Kristjansson (Ex. 1013)

Kristjansson is titled “volume adjustment for listening environment.” Ex. 1013, code (54) (capitalization omitted). Kristjansson relates to speech processing systems that combine speech recognition and natural language understanding processing techniques. *Id.* at 1:6–22.

Kristjansson describes performance drawbacks associated with speech processing due to “listening environments for users” that “may vary in terms of the amount of noise experienced by the user” that “make it difficult for user to hear and/or understand output audio from a device.” Ex. 1013, 2:27–30. To address these drawbacks, “a system may determine a location of a user and noise sources relative to a device, may determine the noise level at the user’s location, and may determine a gain for output audio data to ensure the output audio is at a sufficient volume when it reaches the user’s location.” *Id.* at 2:30–36.

Kristjansson discloses a user in an environment with device 110 as well as with noise sources 190a and 190b, and the “device 110 may detect (130) the input audio which may include both the utterance as well as noise from the noise sources” and “may send (132) audio data to the server 120 for speech processing.” Ex. 1013, 3:1–8. “The device 110 may determine (134) the user’s location relative to the device 110,” as well as “the location(s) of noise sources in the environment,” through “range finding, image processing, estimation or other techniques.” *Id.* at 3:8–13.

F. Patent Owner's arguments regarding an improper certificate of translation for the Shimomura reference (Ex. 1004)

The issue regarding the accuracy of the English translation of the Shimomura reference (Ex. 1004) was briefed by both parties during the bifurcated discretionary consideration by the Acting Director, who declined to exercise her discretion to deny the Petition.

G. Patent Owner's Constitutional Arguments

Patent Owner raises several “Constitutional issues” in its Preliminary Response, at 48–51. These issues go to the Director’s discretion under 35 U.S.C. 314(a), not to non-discretionary considerations or merits, and should have been raised to the Director in Patent Owner’s Request for Discretionary Denial of Institution, Paper 6, and will not be addressed in this Decision. *See* C. Stewart, Memorandum: Interim Processes for PTAB Workload Management, at 1 (Mar. 26, 2025) (“[D]ecisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations. Under this interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. . . . The three-member panel will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.”); *see also* FAQs for Interim Processes for PTAB Workload Management (available at <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>”), FAQ 23 (“If a patent owner wishes to raise any applicable bases for discretionary denial, it must do so in a discretionary denial brief. Absent extraordinary circumstances, the Director

and the Board panel will not consider arguments relating to discretionary denial raised in a POPR . . . Unless otherwise authorized by the Director, the Board panel will not address any discretionary considerations presented in the Process Memorandum.”), FAQ 12 (“The ‘merits’ considerations refer to whether there is a reasonable likelihood that a petitioner would prevail with respect to at least one of the claims challenged in an IPR petition.”).

H. The Asserted Grounds of Unpatentability

Petitioner challenges claims 1–5 of the ’337 patent based upon five proposed grounds of unpatentability:

Grounds²	Claim(s) Challenged	35 U.S.C. §	Reference(s)
1	1–5	102 ³	Shin
2	1–5	103 ⁴	Shin
3	1–5	103 ⁵	Shimomura
4	1–5	103	Shimomura and Shin
5	1–5	103	Shimomura and/or Shin in view of Kristjansson

² Five proposed grounds of unpatentability as listed at page 6 of the Petition.

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, effective on March 16, 2013. The ’337 patent claims the benefit of filing dates after the effective date of the applicable AIA amendments. *See* Ex. 1001 (code 30). Therefore, we refer to the AIA versions of 35 U.S.C. §§ 102, 103.

⁴ A single prior art reference may render an invention obvious notwithstanding the failure to describe all claim limitations. *See, e.g., B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582 (Fed. Cir. 1996) (holding that the difference between the claimed invention and the sole reference would have been obvious); *In re O’Farrell*, 853 F.2d 894, 902 (Fed. Cir. 1988) (“[A]ppellants’ claimed invention would have been obvious in light of the Polisky reference alone.”).

⁵ *See supra* n.4.

Pet. 6. Patent Owner disputes that Petitioner has sufficiently shown that any of its five proposed grounds of unpatentability render the challenged claims obvious. *See generally* Prelim. Resp.

II. LEVEL OF ORDINARY SKILL IN THE ART

We consider the asserted grounds of unpatentability in view of the understanding of a person of ordinary skill in the art. In assessing the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (quoting *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)). “[O]ne or more factors may predominate.” *Id.*

Relying on the declaration testimony of Dr. Stern, Petitioner contends that an ordinarily skilled artisan for the ’337 patent “would have had a minimum of a bachelor’s degree in computer engineering, computer science, electrical engineering, or a similar field,” and would have “approximately two years of industry or academic experience in a field related to controlling the audio output of electronic devices.” Pet. 7 (citing Ex. 1002 ¶¶ 30–34). Petitioner further asserts that “[w]ork experience could substitute for formal education and additional formal education could substitute for work experience.” *Id.*

At this stage, Patent Owner does not specifically address the level of skill of the ordinary artisan. *See generally* Prelim. Resp.

For purposes of this Decision on Institution, we adopt Petitioner’s definition of the level of ordinary skill in the art. On the present record, we

are satisfied that this definition comports with the level of skill necessary to understand and implement the teachings of the '337 patent and the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that the prior art itself can reflect an appropriate level of ordinary skill in art).

III. CLAIM CONSTRUCTION

In interpreting the claims of the '337 patent, we “us[e] the same claim construction standard that would be used to construe the claim[s] in a civil action under 35 U.S.C. [§] 282(b).” *See* 37 C.F.R. § 42.100(b) (2023). Accordingly, our claim construction standard is the same as that of a district court. *See id.* Under the standard applied by district courts, claim terms are generally given their plain and ordinary meaning, as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). “There are only two exceptions to this general rule: (1) when a patentee sets out a definition and acts as his own lexicographer, or (2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

“In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is

“less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317 (citations omitted).

Here, Petitioner contends “[n]o claim terms require construction to resolve the invalidity challenges here.” Pet. 8 (citing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Patent Owner responds: “The Petition relies on plain and ordinary meaning of every limitation in every claim.” Prelim. Resp. 8 (citing Pet. 8). Patent Owner further states: “[Petitioner] provides no proposed construction. Nor will [Patent Owner].” *Id.*

We construe only those claim terms that require analysis to determine whether to institute an *inter partes* review. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc.*, 200 F.3d at 803); *Nidec Motor Corp.*, 868 F.3d at 1017.

However, on this initial record, we find some claim terms require analysis to determine whether to institute an *inter partes* review

First, claim 1[pre] is directed to “[a] voice-content control device,” but claim 1[b] also recites “a voice spoken by a user.” We initially conclude that although the device of claim 1 is configured to interact with “a user,” the “user” (person) is necessarily outside the scope of the claimed 1[b] “voice-content control device,” because the one or more users (persons) cannot be an integral physical part of the claimed device.

Second, and further regarding the “user” of claim 1, our reviewing court has

repeatedly emphasized that an indefinite article “a” or “an” in patent parlance carries the meaning of “one or more” in open-ended claims containing the transitional phrase “comprising.” That “a” or “an” can mean “one or more” is best described as a rule, rather than merely as a presumption or even a convention. *The exceptions to this rule are extremely limited: a patentee must “evinced [] a clear intent” to limit “a” or “an” to “one.” The subsequent use of definite articles “the” or “said” in a claim to refer back to the same claim term does not change the general plural rule, but simply reinvokes that non-singular meaning.*

SanDisk Corp. v. Kingston Tech. Co., Inc., 695 F.3d 1348, 1360 (Fed. Cir. 2012) (quoting *Baldwin Graphic Systems, Inc. v. Siebert*, 512 F.3d 1338, 1342 (Fed. Cir. 2008)).

These controlling case authorities are applicable here. At this stage, we preliminarily construe the scope of the claim 1[b] term “a user” as covering one or more users. Likewise, we preliminarily construe the scope of the 1[b] phrase “a voice spoken by a user” as covering one or more voices spoken by a single user, or by plural users.

Our initial claim constructions are particularly relevant regarding Patent Owner’s implicit position that claim 1 requires *more than one user*: e.g., Patent Owner argues “Shin never refers to a ‘first user’ or ‘second user’ or ‘multiple users.’” Prelim. Resp. 23. (citing *generally* Ex. 1003). Patent Owner contends that “[i]nstead, Shin discusses how ‘a user 10, who is spaced apart from an electronic device 100 by a specific distance and is at a standstill, may speak to the electronic device 100.’” *Id.* at 23–24 (quoting Ex. 1003 ¶ 37).

But we note Patent Owner acknowledges that Shin teaches “[t]he same ‘user 10 who moves away from the electronic device 100 may speak to the electronic device 100.’” *Id.* at 24 (quoting Ex. 1003, ¶ 38).

Accordingly, for the purpose of our decision on institution, our preliminary claim construction only requires Petitioner to show a single user who may perform both a first and second voice depending upon the single user’s changing distance (and associated changing voice volume) from the voice-content control device.

We emphasize that our preliminary claim construction only requiring at least one user (performing both a first and second voice depending upon the distance from the voice-content control device) renders unpersuasive Patent Owner’s arguments regarding the classification of the 1[b] “voice as either one of a first voice or a second voice” and as similarly recited in limitation 1[f] (“classified as the first voice”) and limitation 1[g] (“classified as the second voice”). *See* Prelim. Resp. 21–24.

Both parties are invited to fully develop this claim construction issue during trial.

IV. PRINCIPLES OF LAW

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to Patent Owner except in certain limited circumstances not present here. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375,

1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness.⁶ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). “[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 550 U.S. at 416 (citing *United States v. Adams*, 383 U.S. 39, 50–51 (1966)). An obviousness inquiry is not limited to the prior art’s preferred embodiment. *See, e.g., Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1370 (Fed. Cir. 2007). We also recognize that prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (citing *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)).

⁶ Patent Owner does not present arguments or evidence of secondary considerations (i.e., objective indicia of non-obviousness) in its Preliminary Response. *See generally* Prelim. Resp. Therefore, secondary considerations do not constitute part of our analysis herein.

V. ALLEGED OBVIOUSNESS OVER SHIN UNDER GROUND 2

Petitioner contends that claims 1–5 of the '337 patent are unpatentable under 35 U.S.C. § 103 as obvious over Shin under Ground 2. Pet. 30–35. Petitioner contends that “[i]f [Patent Owner] argues that Shin fails to disclose any limitations [under anticipation Ground 1], such limitations would have been obvious over Shin [under obviousness Ground 2].” Pet. 30. Therefore, we refer to Petitioner’s individual mappings for claim 1 to Shin as set forth under anticipation Ground 1 as also being applicable to obviousness Ground 2, because “anticipation is the epitome of obviousness.” *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984).

We note that under Ground 2, no modifications are required to arrive at the claimed invention. Therefore, no showing of a motivation to modify Shin or a reasonable expectation of success is required. *See Unification Techs. LLC v. Micron Tech Inc.*, 23-1348, 2024 WL 3738401, at *6 (Fed. Cir. Aug. 9, 2024) (nonprecedential). We have also considered the Declaration by Dr. Stern, as cited by Petitioner in support of institution. *See* Ex. 1002 ¶¶ 107–116.

Regarding Ground 2, Patent Owner opposes, arguing at the outset that “Ground 2 is moot.” Prelim. Resp. 24. Patent Owner contends Petitioner is conflating obviousness with anticipation. *Id.* Patent Owner explains that “[t]he only obviousness ground actually disclosed is based upon one inapplicable disclosure missing from Shin: the lack of disclosing two and only two classifications. No party asserts that the '337 patent claims require classification of two and only two voices. Thus, Ground 2, to the extent properly asserted, is moot.” *Id.* at 24–25.

In support, Patent Owner asserts that “[t]he '337 patent specifically does not limit classifications based on distance.” *Id.* at 25 (citing *e.g.*,

Ex. 1001, 7:56–62 (classifying voices as either a whisper or not a whisper). Patent Owner contends that “[m]odifying table 3 [of Shin] as Petitioner suggests would limit the amount of outputs. That is not what the claims recite.” *Id.* Patent Owner contends the “claims recite classification of input voices.” *Id.*

We note Patent Owner asserts that “[Petitioner] acknowledges that ‘claim 1 requires the user’s voice to be classified into no more than two classifications based on distance’” as a difference between the claimed invention and the prior art. Prelim. Resp. 33 (quoting Pet. 30). We address the classification limitations recited in claim 1, *infra*.

A. Claim 1

1. Preamble 1[pre]

The preamble of claim 1 recites: “A voice-content control device, comprising:” Ex. 1001, 18:39.

Petitioner contends that preamble limitation 1[pre] is taught by Shin, by *inter alia*,⁷ the “electronic device” described in the Abstract, and also at paragraph 37, and within Figure 1A. Pet. 8. *See e.g.*, “[t]he electronic device includes an audio input module configured to receive a speech of a user as a voice input . . . [that includes] a processor configured to determine an output scheme of the content based on at least one of a speech rate of the

⁷ We refer throughout this Decision to our preliminary assessment of Shin’s *best teachings* of the particular claim 1 limitations argued and mapped by Petitioner, and do not exclude from further consideration the remaining Shin teachings cited by Petitioner for each respective identified claim 1 limitation. *See generally* Pet.

speech, a volume of the speech, and a keyword included in the speech, which is obtained from an analysis of the voice input.” Ex. 1003, Abstr. *See also* Shin at paragraph 37 (referring to Figure 1A): “The electronic device 100 may receive the voice input through an embedded audio input module (e.g., a microphone) and may generate content corresponding to a result of analyzing the voice input.” Figure 1A also depicts corresponding content being provided from electronic device 100 in response to a voice input from user 10, who in Figure 1B, moves away from electronic device 100.

Regarding limitation 1[pre], Patent Owner does not substantively traverse Petitioner’s arguments regarding the specific paragraphs of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraph 51 relied upon to buttress Petitioner’s arguments regarding preamble limitation 1[pre]. Pet. 9 (citing Ex. 1002 ¶ 51).

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches preamble 1[pre].

2. *Limitation 1[a]*

Limitation 1[a] of claim 1 recites: “a proximity sensor configured to calculate a distance between a user and the voice-content control device;” Ex. 1001, 18:40–41.

Petitioner contends that “proximity sensor” limitation 1[a] is taught by Shin, for example, at paragraph 53 (“the processor 120 may determine a distance between the user and the electronic device 101 based on . . . the distance computed, calculated, or measured by the distance detection module 180”). Pet. 9 (quoting Ex. 1003 ¶ 53). Petitioner also contends that Shin

teaches electronic device 101 may use “a proximity sensor.” Pet. 10 (citing Ex. 1003 ¶ 153; *see also* Fig. 9 (“proximity sensor” 940G as depicted within “sensor module” 940)).

Regarding limitation 1[a], Patent Owner does not substantively traverse Petitioner’s arguments regarding the specific paragraphs and Figures of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraph 54 relied upon to buttress Petitioner’s arguments regarding limitation 1[a]. Pet. 10 (citing Ex. 1002 ¶ 54).

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches limitation 1[a].

3. *Limitation 1[b]*

Limitation 1[b] of claim 1 recites: “a voice classifying unit configured to analyze a voice spoken by a user and acquired by a voice acquiring unit to classify the voice as either one of a first voice or a second voice based on the distance between the user and the voice-content control device;” Ex. 1001, 18:42–46.

Petitioner contends that “voice classifying unit” limitation 1[b] is taught by Shin. Pet 12 (citing Ex. 1003, Fig. 3, ¶ 45). Specifically, Petitioner contends that Shin discloses that device 101 includes a processor 120 and an audio input module 151, as depicted in Figure 3. *Id.* Thus, Petitioner contends that Shin teaches a “voice classifying unit (processor) configured to analyze a voice spoken by a user and acquired by a voice acquiring unit (e.g., audio input module and/or portion of processor that receives voice from the audio input module).” Pet. 13 (citing Ex. 1002 ¶ 62).

Petitioner further contends that “Shin’s processor executes a voice recognition application to process the voice input and generates corresponding content for output.” Pet. 13 (citing Ex. 1003 ¶¶ 47, 60; *see also id.* ¶¶ 37, 39). Petitioner contends “[t]he processor determines the ‘output scheme,’ which includes the content and its volume level, ‘based on the distance between the user and the electronic device 101.” *Id.* (citing Ex. 1003 ¶¶ 78, 86; *see also id.* ¶¶ 53, 77–80, claims 6, 17). Petitioner notes that to do so, “Shin’s processor classifies the voice based on the distance.” *Id.* (citing Ex. 1002 ¶ 63).

Petitioner relies upon Shin’s Table 3, which is reproduced below:

TABLE 3

Distance (D) between user and electronic device	Output amount of information of content
$D < 1\text{ m}$	Amount of information of original content
$1\text{ m} \leq D < 2\text{ m}$	Content of first abbreviation level
$2\text{ m} \leq D < 3\text{ m}$	Content of second abbreviation level

TABLE 3-continued

Distance (D) between user and electronic device	Output amount of information of content
$3\text{ m} \leq D < 4\text{ m}$	Content of third abbreviation level
$D \geq 4\text{ m}$	Content of fourth abbreviation level (abstract content)

Reproduced above, Shin’s Table 3, which depicts providing a different amount of information based upon the user-to-device distance. Ex. 1003 ¶ 86.

Relying upon the first and last rows of Shin’s Table 3 (above), Petitioner asserts that “Shin discloses classifying the voice as a ‘first voice’ when the distance is less than 1 meter, and a ‘second voice’ when the distance is greater than 4 meters.” Pet. 14. In support, Petitioner also refers to Shin’s Table 1 and paragraph 51 (content may be “classified dichotomously”). *Id.* (citing Ex. 1003 Table 1, ¶¶ 51, 79–81, 86–87; Ex. 1002 ¶ 64). Petitioner explains: “For example, a voice between 3 and 4 meters away could be considered the recited ‘first voice.’” *Id.* Petitioner notes that “[a]lternatively, all of the distances less than 4 meters could collectively be considered a first voice (e.g., a voice less than 4 meters away).” *Id.*

Petitioner concludes: “Thus, Shin discloses that the voice classifying unit (processor) is configured to analyze the voice to classify the voice as either one of a first voice (e.g., closer than 1 meter) or a second voice (e.g., farther than 4 meters) based on the distance between the user and the device.” *Id.* (citing Ex. 1002 ¶¶ 59–66).

Patent Owner disagrees. Patent Owner argues that “[t]he table [3 in Shin] also confirms that it addresses one variable (D) in terms of *one ‘user.’* There is no variable related to *different users.*” Prelim. Resp. 22 (emphases added).

Patent Owner thus contends “[t]he Petition attempts to spin Shin’s different outputs based on distance into a disclosure of first and second voices.” Prelim. Resp. 23 (citing Pet. 14). Patent Owner concludes: “[Petitioner’s] argument fails. Shin is incapable of distinguishing multiple voices.” *Id.* Patent Owner notes that “Shin never refers to a ‘first user’ or ‘second user’ or ‘multiple users.’” *Id.* (citing *generally* Ex. 1003). Patent Owner contends that “[i]nstead, Shin discusses how ‘a user 10, who is

spaced apart from an electronic device 100 by a specific distance and is at a standstill, may speak to the electronic device 100.” *Id.* 23–24 (citing Ex. 1003 ¶ 37). Patent Owner notes that “[t]he same ‘user 10 who moves away from the electronic device 100 may speak to the electronic device 100.’” Prelim. Resp. 24 (citing Ex. 1003 ¶ 38).

Patent Owner additionally contends that “[t]he patentee of Shin also knew how to disclose classifications. Shin does so when addressing content. Shin states that ‘[t]he detailed *content* and the abstract content may be classified dichotomously.’” Prelim. Resp. 24 (citing Ex. 1003 ¶ 51). Patent Owner concludes: “[c]ontent is output. Voices, by contrast, are input. Thus, Shin fails to disclose any type of classification required by the claims.” Prelim. Resp. 24. Patent Owner reiterates essentially the same argument on page 29 of the Preliminary Response:

[Petitioner] identifies no express disclosure of voice classification in place of inherency or obviousness, in any reference. The closest disclosure it can find relates to classification of *content*. Shin states that “content may be classified dichotomously.” Pet., 14; Ex. 1003, ¶[0051]. But that demonstrates, by comparison, [Petitioner’s] failure to identify any express disclosure of “classification” of “*voices*.”

Prelim. Resp. 9.

However, as explained *supra* under our “Claim Construction” section III, our preliminary claim construction only requires Petitioner to show a single user who may perform both a first and second voice depending upon the single user’s changing distance (and associated changing voice volume) from the voice-content control device.

As also explained *supra* under our “Claim Construction” section III, we emphasize that our preliminary claim 1 construction (only requiring at least one user performing both a first and second voice based upon distance)

renders unpersuasive Patent Owner’s arguments regarding the classification of the 1[b] “voice as either one of a first voice or a second voice,” and as similarly recited in limitation 1[f] (“classified as the first voice”), and limitation 1[g] (“classified as the second voice”). *See* Prelim. Resp. 21–24.

Regarding Shin’s use of the literal term “***classified*** dichotomously” to refer to detailed *content* and the abstract content (Prelim. Resp. 24 (citing Ex. 1003 ¶ 51 (emphasis added))), we note the literal 1[b] term “voice ***classifying*** unit” does not need to be recited by Shin to render limitation 1[b] obvious.⁸ (emphasis added).

Therefore, we find Patent Owner’s arguments are not persuasive regarding the “voice classifying unit” and its associated configured functions, as recited in limitation 1[b]. Accordingly, at this stage, we preliminarily find Petitioner has shown that Shin teaches or suggests limitation 1[b].⁹

⁸ There is no requirement in an obviousness analysis for the prior art to “contain a description of the subject matter of the appealed claim in *ipsissimis verbis*.” *In re May*, 574 F.2d 1082, 1090 (CCPA 1978).

⁹ “[T]he question under 35 USC 103 is not merely what the references expressly teach but what they would have *suggested* to one of ordinary skill in the art at the time the invention was made.” *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 - 808 (Fed. Cir. 1989) (emphasis added) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)); *see also* MPEP § 2123.

4. *Limitation 1[c]*

Limitation 1[c] of claim 1 recites: “a process executing unit configured to analyze the voice acquired by the voice acquiring unit to execute processing required by the user;” Ex. 1001, 18:47–49.

Petitioner contends that “Shin’s processor analyzes the voice acquired by the voice acquiring unit (e.g., the ‘audio input module’ and/or portion of [the] processor that receives voice from the audio input module).” Pet. 15 (citing Ex.1003 ¶¶ 48, 62). Petitioner argues that “Shin discloses analyzing the acquired voice ‘to execute processing required by the user’ in the same way as the ’337 patent.” Pet. 16 (citing Ex. 1002 ¶ 69). Petitioner contends: “[f]or example, Shin describes analyzing a user’s speech (‘Let me know today’s weather’) to execute processing to obtain the required weather information.” *Id.* (citing Ex. 1003 ¶ 88). Petitioner concludes: “Thus, Shin discloses a process executing unit (processor) configured to analyze the voice acquired by the voice acquiring unit to execute processing required by the user.” *Id.* (citing Ex. 1002 ¶¶ 67–70).

Regarding limitation 1[c], Patent Owner does not substantively traverse Petitioner’s arguments regarding the specific paragraphs of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraphs 67–70 relied upon by Petitioner. Pet. 16.

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches limitation 1[c].

5. *Limitation 1[d]*

Limitation 1[d] of claim 1 recites: “a voice-content generating unit configured to generate, based on content of the processing executed by the

process executing unit, output sentence that is text data for a voice to be output to the user; and” Ex. 1001, 18:50–53.

Petitioner contends that “Shin discloses a voice-content generating unit that generates an output sentence as text data for a voice to be output to the user.” Pet. 17 (citing Ex. 1002 ¶ 72). Petitioner argues that “[t]his content may be converted into a voice using text-to-speech technology and output audibly.” Pet. 17 (citing Ex. 1003 ¶ 48; *see also id.* ¶¶ 7, 37, 39, 62, 72, 109, 131, 139, 158). Petitioner concludes: “Thus, Shin discloses a voice-content generating unit (processor) configured to generate an output sentence that is text data for a voice to be output to the user.” *Id.* (citing Ex. 1002 ¶¶ 71–72). We note particularly that Shin teaches text-to-speech (TTS) in paragraph 48.

Regarding limitation 1[d], Patent Owner does not substantively traverse Petitioner’s arguments regarding the specific paragraphs of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraphs 71–72 relied upon by Petitioner. Pet. 17.

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches limitation 1[d].

6. *Limitation 1[e]*

Limitation 1[e] of claim 1 recites: “an output controller configured to adjust a sound volume of voice data obtained by converting the output sentence thereinto, wherein” Ex. 1001, 18:54–56.

Petitioner contends that limitation 1[e] is taught by “Shin’s processor [that] converts the content to voice . . . , and can ‘adjust’ the ‘output volume level.’” Pet. 18 (citing Ex. 1003 ¶ 53; *see also id.* ¶¶ 76–81, 98–101, 105;

claims 6, 17). Petitioner thus concludes, that “Shin discloses an output controller (processor) configured to adjust a sound volume of voice data obtained by converting the output sentence thereinto.” *Id.* (citing Ex. 1002 ¶ 75).

Regarding limitation 1[e], Patent Owner does not substantively traverse Petitioner’s arguments regarding the specific paragraphs of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraphs 74 and 75 relied upon by Petitioner. Pet. 18.

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches limitation 1[e].

7. *Limitation 1[f]*

Limitation 1[f] of claim 1 recites: “the voice-content generating unit is further configured to generate a first output sentence as the output sentence when the acquired voice has been classified as the first voice, and” Ex. 1001, 18:57–59.

Regarding limitation 1[f], Petitioner contends that “Shin’s processor adjusts the amount of information provided to the user based on the user-to-device distance.” Pet. 19 (citing Ex. 1003 ¶ 53; *see also id.* ¶¶ 51, 86–90; claims 8, 17; Ex. 1002 ¶ 77). Petitioner specifically argues: “when a voice is classified as a first voice (e.g., closer than 1 meter), the device generates a first output comprising all available information.” *Id.* (citing Ex. 1003 ¶ 87) (when distance “is less than 1 m, an output amount of information of the content may be set highest” and provides “the most detailed original content corresponding to a voice input”). Petitioner also refers to Shin at paragraph 51 (describing e.g., “with regard to the output amount of information, the

content may be classified into detailed content that includes rich and extended information and abstract content that includes only a gist of the response corresponding to the voice input.”). Pet. 19. Petitioner additionally refers to the amount of information provided as being shown in Table 3, which we have reproduced above. *Id.*

As explained *supra* under our “Claim Construction” section III, we emphasize that our preliminary claim 1 construction (only requiring at least one user performing both a first and second voice based upon distance) renders unpersuasive Patent Owner’s arguments regarding the classification of the 1[b] “voice as either one of a first voice or a second voice,” and as similarly recited in limitation 1[f] (“classified as the first voice”), and limitation 1[g] (“classified as the second voice”). *See* Prelim. Resp. 21–24.

Regarding limitation 1[f], Patent Owner does not otherwise substantively traverse Petitioner’s arguments regarding the specific paragraphs of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraph 77 relied upon by Petitioner. Pet. 19.

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches limitation 1[f].

8. *Limitation 1[g]*

Limitation 1[g] of claim 1 recites: “generate a second output sentence in which information is omitted as compared to the first output sentence as the output sentence when the acquired voice has been classified as the second voice, wherein” Ex. 1001, 18:62–64.

Petitioner contends that Shin discloses “whenever the user-to-device ‘distance increases by 1 m, the electronic device 101 may decrease the output amount of information by making the abbreviation level of the original content high.” Pet. 20 (citing Ex. 1003 ¶ 87; *id.* ¶ 86 (“output amount of information of the content decreases as a distance between the user and the electronic device 101 increases.”)).

Petitioner additionally refers to the varying abbreviation levels in Shin’s Table 3, in which Petitioner annotates that first voice corresponds to the first row ($D < 1\text{m}$. . . “Amount of information of original content”), and the second voice corresponds to the fourth row ($D \geq 4\text{m}$. . . “Content of fourth abbreviation level (abstract content).” Pet. 21.

Petitioner notes that Shin’s Figure 3 depicts “when the user is more than 4 meters from the device, the voice falls into a second classification and the processor outputs ‘[c]ontent of fourth abbreviation level (abstract content).” Pet. 21 (citing Ex. 1003 ¶ 87). Petitioner concludes: “Thus, when the voice is classified as a second voice (e.g., greater than 4 meters), the output content omits some information provided when the voice is classified as a first voice.” *Id.* (citing Ex. 1003 ¶ 51) (“content may be classified into a second category that includes the ‘least’ amount of information); *id.* (the processor may ‘extract[]’ a portion of the content”). Pet. 21 (citing Ex. 1002 ¶ 81). Thus, Petitioner concludes that Shin teaches limitation 1[f]. Pet. 22 (citing Ex. 1002 ¶¶ 80–85).

As explained *supra* under our “Claim Construction” section III, we emphasize that our preliminary claim 1 construction (only requiring at least one user performing both a first and second voice based upon distance) renders unpersuasive Patent Owner’s arguments regarding the classification of the 1[b] “voice as either one of a first voice or a second voice,” and as

similarly recited in limitation 1[f] (“classified as the first voice”), and limitation 1[g] (“classified as the second voice”). *See* Prelim. Resp. 21–24.

Patent Owner does not otherwise substantively traverse Petitioner’s arguments regarding the specific paragraphs of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraphs 80–85 relied upon by Petitioner. Pet. 22.

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches limitation 1[g].

9. *Limitation 1[h]*

Limitation 1[h] of claim 1 recites: “the output controller is further configured to adjust the sound volume of voice data such that the sound volume of voice data obtained by converting the first output sentence thereinto differs from the sound volume of the voice data obtained by converting the second output sentence thereinto.” Ex. 1001, 18:65:19–3.

Petitioner contends that preamble limitation 1[h] is taught by Shin, because “Shin’s processor adjusts the content’s output volume based on the user-to-device distance.” Pet. 22 (citing Ex. 1003 ¶¶ 53, 77–81). Petitioner argues “Shin discloses that the “device 101 may set an output volume level of the content to 40 dB when the distance between the user and the electronic device 101 is less than 1 m and may increase the output volume level by 5 dB whenever the distance increases by 1m.” Pet. 22–23 (citing Ex. 1003 ¶ 80). We note paragraph 80 of Shin describes the relationship between distance (D) and the output volume level of the content (in dBs), as depicted in Table 1. We reproduce both paragraph 80 and Table 1 of Shin below:

For example, as shown in Table 1, the electronic device 101 may set an output volume level of the content to 40 dB when the distance between the user and the electronic device 101 is less than 1 m and may increase the output volume level by 5 dB whenever the distance increases by 1 m. For example, a user who is far away from the electronic device 101 may be provided with corresponding content as sound of a suitable output volume level.

Ex. 1003 ¶ 80.

Table 1 of Shin is reproduced below:

TABLE 1	
Distance (D) between user and electronic device	Output volume level of content
$D < 1 \text{ m}$	40 dB
$1 \text{ m} \leq D < 2 \text{ m}$	45 dB
...	...
$D \geq 5 \text{ m}$	65 dB

Table 1 of Shin is reproduced above, depicting for example, that when a user is far away from the electronic device 101 the user may be provided with corresponding content as sound of a suitable output volume level

Petitioner contends that “[c]onsidering Shin’s disclosure regarding the output information and volume together, Shin discloses that when a voice is classified as a first voice (e.g., closer than 1 meter), a first output sentence containing the ‘original content’ is provided (Table 3) at a volume level of 40 dB (Table 1).” Pet. 23 (citing Ex. 1002 ¶ 88). Petitioner asserts that “[w]hen a voice is classified as a second voice (e.g., greater than 4 meters), a second output sentence containing ‘content of fourth abbreviation level’ is

provided (Table 3) at a volume level of 60 or 65 dB.” *Id.* (citing Ex. 1003 Table 1 ¶ 80). Petitioner emphasizes that “Shin repeatedly discloses that both content and volume may vary based on distance.” *Id.* (citing Ex. 1003 ¶¶ 49, 53, 140; Ex. 1002 ¶ 88).

Petitioner thus concludes:

Shin discloses that the output controller (processor) is further configured to adjust the sound volume of voice data such that the sound volume (e.g., 40 dB) of voice data obtained by converting the first output sentence (e.g., information of original content) thereinto differs from the sound volume (e.g., 60 or 65 dB) of the voice data obtained by converting the second output sentence (e.g., content at fourth abbreviation level) thereinto.

Pet. 23–24 (citing Ex. 1002 ¶ 89).

Patent Owner does not substantively traverse Petitioner’s arguments regarding the specific paragraphs of Shin relied upon by Petitioner. *See generally* Prelim. Resp. Nor does Patent Owner substantively traverse Dr. Stern’s Declaration (Ex. 1002) by rebutting the specific paragraphs 88–89 relied upon by Petitioner. Pet. 23–24.

Therefore, at this stage, we preliminarily find Petitioner has shown that Shin teaches limitation 1[h].

10. Conclusion for Claim 1

Having considered the arguments and evidence presented by both the Petitioner and Patent Owner, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of independent claim 1 would have been obvious over the second proposed ground of unpatentability over Shin. (Ex. 1003).

B. Claims 2–5

Patent Owner does not separately and substantively argue claims 2–5 of the '337 patent as considered under proposed Ground 2 over Shin. *See generally* Prelim. Resp.

Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of remaining claims 2–5 as considered under the second proposed ground over Shin. Ex. 1003. We have reviewed the record and find Petitioner's evidence (Pet. 24–30; 32–35) and arguments regarding the obviousness of claims 2–5 under Ground 2 over Shin are sufficient at this juncture.

Because we find Petitioner has demonstrated a reasonable likelihood of success in demonstrating that at least one claim of the '337 patent is unpatentable, we institute trial on *all* challenged claims 1–5 on *all* grounds raised in the Petition. *See* 37 C.F.R. § 42.108(a) (2023).

VI. CONCLUSION

After considering the arguments presented in the Petition, the Preliminary Response, and the evidence of record, we determine that Petitioner has demonstrated at least a reasonable likelihood of success in proving that at least claim 1 of the '337 patent is unpatentable as obvious over Shin under Ground 2.

Accordingly, we institute an *inter partes* review of *all* challenged claims 1–5 on *all grounds* 1–5 set forth in the Petition. Our determinations at this stage of the proceeding are based on the evidentiary record currently before us. This decision to institute trial is not a final decision as to the patentability of any claim for which we have instituted an *inter partes*

review. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a [P]etitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”). We will base any final decision on the full record developed during trial.

VII. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for all claims 1–5 of the ’337 patent on all five unpatentability grounds asserted in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this decision.

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