

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.,
Petitioners

v.

SOUNDCLEAR TECHNOLOGIES LLC,
Patent Owner

U.S. Patent No. 11,244,675

Issue Date: February 8, 2022

Title: WORD REPLACEMENT IN OUTPUT GENERATION FOR
DETECTED INTENT BY VOICE CLASSIFICATION

Inter Partes Review No. IPR2025-00673

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF
INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF
UNITED STATES PATENT NO. 11,244,675**

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PATENT OWNER EXHIBIT LIST

Exhibit No.	Description
2001	Docket Printout of CA No. 1:24-01283 (EDVA)
2002	Order from Judge Anthony Trenga, dated January 10, 2025 (Dkt. 84)
2003	Scheduling Order, dated September 23, 2024 (Dkt. 34)
2004	Final Scheduling Order, dated October 18, 2024(Dkt. 55)
2005	Judge Anthony Trenga’s median time to trial, available at https://law.lexmachina.com/shared/eyJzaGFyZWRFcGFnZV9pZCI6MTI3OTMxfQ.aA_aRw.A2n-SunBPfmUP2aka341_-3f27g
2006	Excerpts from the Motion to Stay hearing transcript, dated March 26, 2025
2007	Joint proposed scheduling order (Dkt. 48)
<i>Exhibit Numbers 2008-2011 not used</i>	
2012	U.S. Patent No. 11,069,337
2013	Motion to Dismiss, dated September 13, 2024 (Dkt. 32)
2014	11,244,675 Prosecution History
2015	Defendant’s Invalidity Contentions CA No. 1:24-01283

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 Amazon.com, Inc., Amazon.com Services LLC, and Amazon Web Services, Inc (“Amazon”) challenging claims 1-7 (“the challenged claims”) of U.S. Patent No. 11,244,675 (“’675 patent,” Ex. 1001).

I. INTRODUCTION

The Board’s recent guidance on discretionary denials highlights why denial of Amazon’s Petition is particularly appropriate here.

If IPR institution is denied, the district court case will proceed to trial in February or March 2026, long before the IPR proceedings would have concluded.

That timeline extends one month beyond the timeline in connection with the ’337 patent (at issue in IPR2025-00565). The patent-at-issue and the ’337 patent share the same inventor (Tatsumi Naganuma-san). They both relate to a “voice classifying unit.” *See* Abstracts, Ex. 1001 and Ex. 2012. And Amazon alleged that “[t]he claims of the ’337 and ’675 patents can be summarized in three basic steps ...” Ex. 2013, 2. Thus, Amazon’s decision to file one IPR and then wait almost a month before filing the second is notable for the delay it introduces. If institution is denied on the ’337 patent, the district court will resume with a trial date in January or February 2026. If institution is denied on this patent, there will be no reason that

the trial date would have to change; under Amazon’s own admission, many of the issues in the case will overlap.

The Board must now consider all evidence addressing time-to-trial.¹ District Court Judge Trenga previously set the case for trial on a firm six-to-eight-month schedule. He will set a similar timeline when the case begins again. The median statistics in connection with his 59 trials confirm that schedule. If institution is denied, he will decide every issue between the parties before Amazon’s reply would have been due in this IPR.

Further, institution will immediately prejudice SoundClear. It will delay SoundClear’s ’487 patent case by two or three years.² SoundClear asserted three patents in the Eastern District of Virginia.³ Judge Trenga already ruled on two rounds of *Alice* motions. He initially found all patents to be invalid for want of patentable subject matter. But one deposition was sufficient to uncover facts supporting validity. Judge Trenga reversed that decision, as to two of the patents. He did so based on the testimony of an Amazon witness with industry knowledge of voice-content control devices. Judge Trenga maintained his decision on the ’487

¹ Chief Administrative Judge Boalick’s March 24, 2025 memo (“Boalick Memo”).

² 12-18 months for decision on IPR plus 12-19 months for appeal (Ex. 2011).

³ The ’675 patent (at issue in the instant IPR proceeding); U.S. Patent No. 11,069,337 (“’337 patent”) (a different voice-content control device), and U.S. Patent No. 9,223,487 (“’487 patent”) (improved touchscreen).

patent, which claims an improved touchscreen. But that was only because SoundClear had not yet deposed a witness knowledgeable about touchscreens.⁴ That decision is ready to be appealed and has a strong chance of being overturned.

Amazon also recently filed its second motion for non-infringement. That motion addresses the '675 patent and one other voice-content control patent. It requires that the Court address the underlying factual record (including deposition testimony). It is fully briefed and ready for a ruling. Additionally, SoundClear recently filed a motion to compel, which is awaiting a response from Amazon. Both will languish during IPR proceedings.

Those are just a few of the substantive issues Judge Trenga will decide by early 2026.

The *Fintiv* factors also favor discretionary denial. The only factor that might have favored Amazon (a *Sotera* stipulation) is no longer dispositive. *See* Boalick Memo. It is also ineffective in this case; the substantial majority of Amazon's invalidity positions, about 79%, remain with the district court. And all prior art references at issue in the Petition are shuffled into that 79%. Thus, there is significant risk of inconsistent results—as the parties, experts, and Judge Trenga

⁴ The merits of the appeal are strong. *See* note 10 *infra*.

may have to reexamine the same references at issue in the Petition in connection with the system prior art Amazon disclosed.

Yet more considerations favor denial. The Director is permitted to consider “all relevant considerations” in connection with seeking a discretionary denial.⁵ That includes Amazon’s admission that it will pursue contradictory positions on claim scope, and related expert discovery, before the district court.

Additional considerations also include Amazon’s attempt to use the Board as merely a fallback option and tactical vehicle. Amazon chose to litigate many fact-laden, dispositive issues in the district court. The parties and court expended substantial time, effort, and resources addressing them. Amazon only changed course after the court set a brisk schedule. Two weeks after that schedule was set, Amazon filed a motion to transfer. When that was denied, Amazon began filing its IPRs, one month at a time. In short, Amazon unilaterally chose to proceed on a delayed, sequential basis.

Still more factors favor denial. Amazon’s positions are facially deficient under *Graham* and *KSR*. Amazon provides only an amalgam of expert testimony mixed with attorney argument in an attempt to add the missing disclosures to those

⁵ March 26, 2025 memorandum by Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office, Coke Morgan Stewart (“Morgan Stewart Memo”).

references. And the translation of the Shimomura reference lacks sufficient foundation.

II. PROCEDURAL BACKGROUND OF PARALLEL LITIGATION

On July 25, 2024, SoundClear filed suit against Amazon in the U.S. District Court for the Eastern District of Virginia. *See SoundClear Technologies LLC v. Amazon.com, Inc. et al.*, 1:24-cv-01283⁶, Dkt. 1 (E.D. Va., Jul. 25, 2024). The initial complaint was served on all entities in that case on or before August 2, 2024.

Three patents were at issue in the -1283 case:

- the '675 patent;
- the '337 patent; and
- the '487 patent.

On September 13, 2024, Amazon filed a motion to dismiss in the -1283 case raising a number of both substantive and dispositive grounds. *See* Ex. 2001, Dkt. 32. Those grounds included patent eligibility under §101 and non-infringement.

On October 8, 2024, Amazon attempted to move the -1283 case to a different district court. *See Id.*, Dkt. 41. It filed a motion to transfer the case to the Northern District of California based upon the declaration testimony of three Amazon employees. *Id.*, 6-10. Amazon further supported its motion to transfer

⁶ Hereinafter “the -1283 case” or “the district court case.”

with declarations from three Amazon employees in California that had knowledge of various accused products.

On November 1, 2024, the district court held a lengthy hearing on Amazon's motion to dismiss. *See* Ex. 2001, Dkt. 58.

On November 5, 2024, SoundClear deposed two Amazon employees: Philip Hilmes, Director of Audio Technology at Amazon's Lab126, and Suchit Ligade, Senior Product Manager at Amazon.

On November 8, 2024, the district court denied Amazon's motion to transfer and granted Amazon's motion to dismiss. *See* Ex. 2001, Dkt. 63.

On November 15, 2024, SoundClear filed a motion to alter judgment based upon the deposition testimony of Mr. Hilmes. *See* Ex. 2001, Dkt. 66.

On January 10, 2025, the district court granted-in-part and denied-in-part SoundClear's motion to alter judgment. *See* Ex. 2002. Judge Trenga stated that "taking all factual inferences most favorably to SoundClear, a plausible claim for patent validity exists as to the 337 and 675 patents." *Id.*, 2. Additionally, the court emphasized that "[a]t *Alice* Step Two, the question of '[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.'" *Id.* The court denied the remainder of Amazon's motion to dismiss.

On January 24, 2025, SoundClear filed an amended complaint according to the district court's order. *See* Ex. 2001, Dkt. 89. In response, Amazon filed a second motion to dismiss for non-infringement—notwithstanding testimony of Mr. Hilmes, which SoundClear added to support its allegations in the second amended complaint. *See* Ex. 2001, Dkt. 104.

On February 28, 2025, Amazon filed a motion to stay pending IPR. *See* Ex. 2001, Dkt. 108.

On March 21, 2025, SoundClear filed a motion to compel based upon Amazon's substantial discovery deficiencies. *See* Ex. 2001, Dkt. 134.

On March 26, 2025, the district court granted Amazon's motion to stay pending IPR.⁷ *See* Ex. 2001, Dkt. 140. SoundClear's motion to compel, and Amazon's second motion to dismiss are currently pending.

The parties exchanged comprehensive discovery. SoundClear served 57 requests for production and 26 interrogatories. Amazon served 90 requests for production and 12 interrogatories. SoundClear served Preliminary Infringement Contentions for each patent. Amazon's discovery responses included their

⁷ Another district court case against a different defendant but involving the same three patents has been stayed as well. *See SoundClear Technologies LLC v. Google LLC*, 3:24-cv-00540, Dkt. 51 (E.D. Va., Apr. 18, 2025).

Invalidity contentions. Both parties have exchanged more than three rounds of responses, objections, and productions.

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 Morgan Stewart Memo permits the Director to consider existing precedent under *Fintiv*, and *Advanced Bionics* along with the Consolidated Trial Practice Guide (Nov. 2019).⁸ Morgan Stewart Memo at 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)).

The Morgan Stewart Memo also advised 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;

⁸ Consolidated Trial Practice Guide (Nov. 2019), *available at* <https://www.uspto.gov/patents/ptab/trials/practice-guides> (“CTPG”).

- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Morgan Stewart Memo, 2-3.

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. An Overwhelming Number of Factors Support Denial

1. Judicial Economy and Efficiency

Amazon’s choices support denying institution. It repeatedly prioritized district court proceedings over IPR. But it later changed course in order to *avoid* a speedy, just, and efficient resolution as well as to gain strategic advantage. That approach directly contravenes the purpose of IPRs. *See* 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 more specifically demonstrate why denial is justified under such circumstances.

a) *Fintiv* Factor 2 — The District Court Trial Would Conclude Before Amazon’s Reply in the IPR Would Be Due

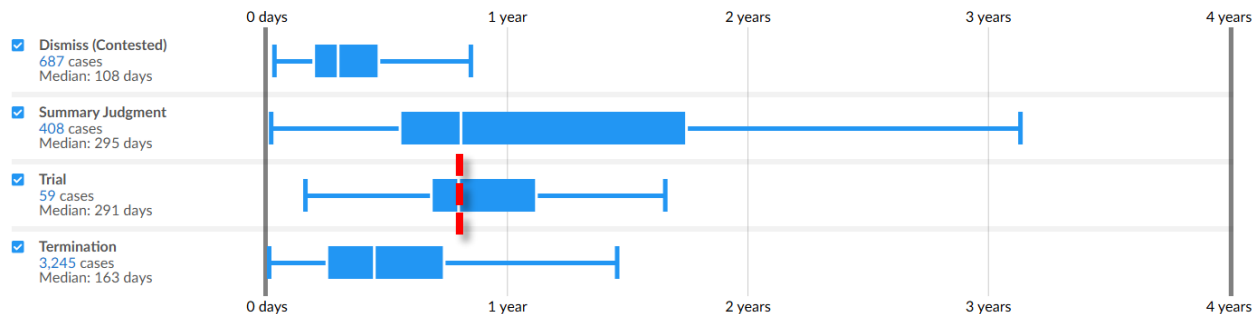
The Board will not issue a final written decision in this IPR until October 2026. The district court case, by contrast, would proceed to trial at least seven or

eight months earlier, in February or March 2026. As noted, above, January or February is likely. *See* Section I.

The court’s first scheduling order in the district court case set a final pretrial conference five months after the issuance of the order. Ex. 2003. Trial was to occur four to eight weeks after that. *Id.* The district court eventually extended that schedule, but only by less than five weeks. *Compare* Ex. 2003 (Dkt. 34 Final Pretrial Conference set for February 14, 2025) with Ex. 2004 (Dkt. 55 Final Pretrial Conference moved to March 20, 2025). The Magistrate Judge made clear that such an extension was unusual. Consistent with the norms of local practice in the Eastern District of Virginia, he firmly stated that there would be no further adjustment to the schedule.⁹ The standing Order in the district court case sets trial “within 4-8 weeks of the final pretrial conference.” Ex. 2003. Indeed, if the district court had not granted Amazon’s request for a stay, trial would have begun as early as June 2025.

Median statistics confirm that timeline. Judge Trenga has presided over 59 trials. For those trials, the median time to trial was 291 days—or 9.5 months:

⁹ As of the date of this brief, a transcript of the initial hearing was not available. If Amazon denies or contests that the district court made clear that the trial schedule would not change, SoundClear will seek to obtain the transcript and submit it to the Director.



Ex. 2005 (red-dashed annotation added at median).

If institution is denied for this IPR in August 2025, the district court case will proceed to trial by February or March 2026 (assuming the case proceeds on the timeline discussed above). However, if institution is granted, Amazon's IPR Reply would be not even be due until April 2026. That is, after the would-be district court trial date.

Accordingly, *Fintiv* Factor 2 strongly favors discretionary denial. *See ARM Ltd. V. Daedalus Prime LLC*, IPR2025-00207, 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.*, IPR2024-01455, 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).

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

Institution of Amazon's Petition will immediately prejudice SoundClear. In addition to the delay in the district court case that is still pending in the EDVA, it will delay the resolution of SoundClear's case for the '487 patent by two or three years.¹⁰

The district court entered judgment of invalidity of the '487 patent, which discloses and claims inventive touchscreen technology. SoundClear will appeal that judgment after final disposition of the district court case. If Amazon's Petition is instituted here, SoundClear's appeal in for the '487 patent will not begin until at least 2028. Further, the district court's ruling on the '487 patent has a strong chance of being overturned.¹¹ When that happens, a case SoundClear filed in 2024 for infringement of the '487 patent will not begin being litigated until **2028 or 2029**.

¹⁰ 12-18 months for decision on IPR plus 12-19 months for appeal (Ex. 2011).

¹¹ Even a cursory review of the '487 patent claims demonstrates that the *Alice* ruling will likely be overturned. The ruling was premature, especially at the motion to dismiss stage. And especially in view of the fact that only one deposition was necessary to present facts requiring that the Court overturn its previous ruling as to the other two patents. Further, the sheer specificity in process and application of the claims demonstrates that they are valid. Certainly, there are factual issues as to whether such specific claims could have been conventional—under *Alice* step two. There is little chance, for example, any witness could have testified that the specific, intricate, stepwise process for detecting user touches on a touchscreen was conventional.

By contrast, if institution is denied,¹² *every issue* in this case will be resolved by early 2026.¹³

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

Amazon 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 12% of its invalidity arguments (7 of 59). *See* §IV.A.2. *infra*. Those grounds are far down Amazon’s list of the substantive merits to address.

Amazon prioritized at least nine substantive, fact-specific, dispositive issues ahead of its obviousness case:

- i. ’675 patent invalid under 35 U.S.C. § 101 (Sep. 13, 2024) (granted and then vacated);
- ii. ’337 patent invalid under 35 U.S.C. § 101 (Sep. 13, 2024) (same);
- iii. ’487 patent invalid under 35 U.S.C. § 101 (Sep. 13, 2024) (granted);
- iv. ’337 patent not infringed (Sep. 13, 2024) (denied);
- v. ’675 patent not infringed (Sep. 13, 2024) (denied);

¹² On the current Petition as well as on Amazon’s other Petition addressing the ’337 patent related to voice control technology.

¹³ These prospective dates do not include appeals. The reason is that cases on appeal that address all issues (*e.g.*, appeal from a district court) present a greater likelihood of settlement than appeals of a subset of issues (*e.g.*, only IPR decisions).

- vi. '487 patent not infringed (Sep. 13, 2024) (denied);
- vii. Motion to transfer supported by declarations of a director, principal technical program manager, senior manager, and applied science manager at Amazon (Oct. 8, 2024);
- viii. '675 patent not infringed based on deposition testimony (Feb. 18, 2025) (pending); and
- ix. '337 patent not infringed based on deposition testimony (Feb. 18, 2025) (pending).

The district court set a brisk time-to-trial schedule. Two weeks later, Amazon sought to transfer the district court case to another district court. When that failed, it began filing IPR petitions, one month at a time.

That is a unilateral, sequential approach designed to favor one party: Amazon. It takes advantage of the fact that the decision of when to begin IPR proceedings lies with Amazon alone. IPR proceedings were designed for the opposite purpose: to streamline litigation and promote just resolution.¹⁴

The Director can ensure IPRs serve their intended purpose by considering petitioners' choices in related proceedings when exercising its 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

¹⁴ See §IV.A.1 *supra*.

the Board.¹⁵ Choose to proceed under plain-and-ordinary meaning or disclose its claim construction positions and undergo claim construction proceedings (and related expert discovery). In short, if Amazon were committed to addressing obviousness as a priority, it would have filed IPR petitions 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 would have disclosed and committed to claims construction positions in both proceedings.

Judge Trenga, SoundClear, and Amazon have invested considerable time, effort and resources in the district court case. Discovery and non-infringement motions are pending. They need not be delayed or upended to allow Amazon to pursue a small fraction of one of its affirmative defenses. The Board, by contrast, is heavily constrained by the cases currently before it. Its time and resources are better spent in serving its statutory mandate than as a tactical vehicle.

¹⁵ That is not to say that attacking the pleadings for failing to provide improper notice or to seek a more definite statement will always preclude institution. The analysis should be made on a case-by-case basis. The amount and extent to which a party seeks to have a district court delve into substantive issues should be considered.

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

Amazon seeks to use the PTAB to invalidate the '675 patent under a broad reading of the claims, while preparing to address infringement using narrowing constructions. Amazon admitted that it *will* take diametrically opposite claim construction approaches before the PTAB versus the district court. That is not simply a contradictory position as to one or two terms. Amazon's overall approach is designed, *a priori*,¹⁶ with divergence in mind.

The mere “potential” for “duplicative efforts” or “conflicting decisions” between the district court and the Board is bad enough.¹⁷ But Amazon's approach actively seeks them out. And there is no mechanism—akin to a *Sotera* stipulation—to prevent it.

¹⁶ *O2 Micro* does not apply in this instance. That case requires claim construction when a “determinative” dispute has “arise[n]” naturally. *TNS Media Research, LLC v. Tivo Research & Analytics, Inc.*, 629 F. App'x 916, 938 (Fed. Cir. 2015); *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (“When the parties present a fundamental dispute regarding the scope of a claim term, it is the court's duty to resolve it.”). In other words, SoundClear does not contend that claim construction can never be revisited. But the *O2 Micro* circumstance is far different than allowing a party to orchestrate proceedings to facilitate a divergent approach long before any concrete dispute actually arises.

¹⁷ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to § II.A).

For example, the Petition is based upon a plain and ordinary meaning of every limitation. “No claim terms require construction to resolve the invalidity challenges *here*.” Pet., 7 (emphasis added). The word “here” demonstrates Amazon’s approach will be different elsewhere (before the district court).

Amazon indeed took the opposite approach before the district court. Amazon stated that it is a matter of “when,” not “if,” it will seek to construe the claims. At a hearing on March 26, Amazon’s counsel stated: “this Court, *when* it does claim construction....” Ex. 2006, 3-4 (emphasis added); *id.*, 3 (referencing the district court’s eventual “own claim construction”); *id.*, 7 (arguing that “[y]ou can say there’s no claim construction necessary to resolve those validity issues, but there is claim construction necessary for other issues in the case.”).

Amazon also admitted that it will engage in expert discovery in the district court, which will bear on claim construction:

Claim Construction Briefing. Amazon’s proposal requires the parties to simultaneously serve claim construction *expert declarations* (Nov. 7) and requires both experts to sit for *deposition* the following week (by Nov. 15). Then, the parties simultaneously file their *opening claim construction briefs* (Nov. 22) and then simultaneously file their responsive briefs (Dec. 9).

Ex. 2007, 5 (italicized emphasis added).

Amazon attempts to justify its approach with a contrived hypothetical. Ex. 2007; Ex. 2006, 5-7.¹⁸ It is over-simplified—presupposing that only one claim term is at issue and that it only bears on a single infringement question (whether “red” includes “pink”). It is also designed to support Amazon’s approach, while the equally probable converse would guarantee conflicting results.¹⁹ And it is unrealistic. It presupposes that both sides know the contours of every dispute that will arise in the case, with only one dispute occurring on the infringement side. (That is especially untrue in the case below, where Amazon “almost universally refused to comply with its discovery obligations.” Dkt. 135, 1). It also presupposes that the Board and district court stand ready to determine, *a priori*, the relative strength of every single validity and infringement issue between the parties.

By analogy to *Sotera* stipulations,²⁰ Amazon declined to state that it will not seek to narrow the interpretation or construction of any term in future district court

¹⁸ The hypothetical claim recites a “red truck.” The prior art is a “[red] fire engine.” The accused product is “pink ice cream van.”

¹⁹ Consider if the prior art were a “pink ice cream van” and the accused product a heavily faded “red fire engine.” It would be wrong for a petitioner to seek to invalidate the “red truck” over a broad reading of “red” that includes “pink” and then seek to exclude a heavily faded red fire engine from infringement, during claim construction, by seeking to limit the scope of the word “red.”

²⁰ Which should be filed prior to this discretionary denial brief. See FAQs for Interim Processes for PTAB Workload Management, April 25, 2025, (<https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>).

proceedings. It, in fact, did the opposite when it told the court it will propose constructions. Amazon cannot even state, at this point, what its positions will ultimately be. Especially since Amazon requested expert discovery in connection with the claim construction process.

In short, Amazon will seek to invalidate the patents by applying a broad scope of the claims before this Board.²¹ It will then turn around and seek to avoid infringement by seeking to have the district court issue narrowing constructions.²²

That approach is patently unfair. 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.”

²¹ *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”).

²² “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). Amazon has identified no lexicography. And disavowal can only narrow a claim.

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)).

The Board’s FAQ 11 also expressly prohibits Amazon’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. Amazon did not do so here.

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 Amazon’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. Amazon has not identified what its proposed constructions will be.

Second, the petitioner did seek to take inconsistent positions before two adjudicative bodies. It submitted alternative positions, in the same proceeding, to the same body (the Board). Amazon 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*. Amazon stated that it will 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 patentee would not be able to disavow in any later proceeding. Amazon's approach is the exact opposite in every respect.

The two cases on which Amazon relies are inapplicable. Pet., 7 (citing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) and *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

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. Manipulating two proceedings for strategic benefit is not the type of gambit that would be incidentally countenanced. It would not be announced, for example, (1) when reviewing results in hindsight on appeal or (2) when determining, after all issues have been put on the table, whether claim construction should have been conducted on a particular issue. *Nidec*, 868 F.3d at 1017. Or when determining at which point in a case it makes the most sense, from a logistical standpoint, to conduct claims construction. *Vivid Techs.*, 200 F.3d at 803 (rejecting a “uniform rule” of when, during discovery, to conduct claims construction).

The *Nidec* court analyzed proposed constructions in hindsight—at the conclusion of the administrative trial proceedings. It 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.”)

The *Vivid Technologies* court simply determined that there is no set rule as to when claims construction should occur during a district court case schedule. 200 F.3d at 803. It did not address making final rulings on one dispositive issue before conducting claims construction to decide another dispositive issue. Indeed, the *Vivid Technologies* court referred to construing claims to resolve a “controversy.” *Id.* That includes all disputes between the parties. Infringement and validity are both at issue in the present controversy between Amazon and SoundClear. So even under *Vivid*, the claims must be construed—consistently—to resolve *all* issues, not just infringement.

Further, the *Vivid Technologies* court identified two core principles that prevent Amazon’s gambit. First, it described bedrock law that “the meaning and scope” of claim terms be determined *before* the claims are applied to the accused device or method or prior art—not after. *Id.*; *see also Markman v. Westview Instruments*, 517 U.S. 370, 384 (1996); *In re Aoyama*, 656 F.3d 1293, 1296 (Fed. Cir. 2011) (“The second step involves comparing the claims to the prior art.”) Second, *Vivid Technologies* repeated that “the Rules shall be construed and administered to secure the just, speedy, and inexpensive determination of every action.” 200 F.3d at 804 (citing Fed. R. Civ. P. 1) (cleaned up). Amazon’s approach contradicts both.

In short, the law set forth in *Amgen* and *White* is clear. Neither *Nidex* nor *Vivid Technologies* changes it. There is no law that allows Amazon to apply a favorable claim scope on invalidity but to turn around and seek to apply narrower scopes for purposes of non-infringement.

e) Amazon Admitted Its Approach in the '337 Patent IPR

In the related '337 patent IPR, Amazon admitted that it will rely on the position that there *is* a “law that allows Amazon to apply a favorable claim scope on invalidity but to turn around and seek to apply [a] narrower scope[] for purposes of non-infringement.” *Amazon v. SoundClear*, IPR2025-00565, Paper 7, 10 (PTAB June 12, 2025). SoundClear expects Amazon will take the same approach here.

In other words, Amazon has not promised to avoid inconsistent positions. It has affirmatively taken the position that it should be allowed to do just that. That position runs afoul of bedrock law. *See* §IV.A.1.d. *infra* (discussing *Amgen*, *Gore*, and *White*).

Amazon’s position also fails based upon a fundamental misunderstanding. It conflates alternative legal positions in the same proceeding with seeking contradictory or inconsistent relief across proceedings. The former is allowed. The latter is not. *Cf. e.g., Marchelletta v. Bergstrom*, 752 F. App’x 724, 733-34 (11th Cir. 2018) (“It is one thing to present inconsistent theories of relief in one pleading. It is another thing entirely to test a legal theory on one set of alleged facts, lose and

suffer an adverse judgment, and then use the first decision as a roadmap to alter the alleged facts, and then re-plead post-judgment.”). A party cannot seek to prevail, in one proceeding, on a favorable construction while having admitted that they will seek a contradictory ruling in another. Again, *Amgen*, *Gore*, and *White* are unequivocal in that regard.

The PTAB cases Amazon cited in connection with the ’337 IPR—and will likely cite here—are inapplicable. They do not overrule or change Federal Circuit and Supreme Court law. *Amazon v. SoundClear*, IPR2025-00565, Paper 7, 10-11 (citing *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1360 (Fed. Cir. 2017); *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00124, Paper 11, 11-13 (PTAB June 15, 2023); *Chanel, Inc. v. Molo Design, Ltd.*, IPR2022-00543, Paper 7, 9-10 (PTAB Aug. 12, 2022)).

The *Aylus* case is the only binding authority Amazon cites. And it counters Amazon’s position. The *Aylus* court affirmed that claims must be construed consistently—regardless of the context: “Ultimately, the doctrine of prosecution disclaimer ensures that claims are not construed one way in order to obtain their allowance and in a different way against accused infringers.” 856 F.3d at 1360.

The other PTAB decisions predate the Board’s decision in *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024)) and the related FAQ 11, which applies *Cambridge*. And the *Cambridge*

decision carries the “Informative” designation whereas Amazon’s cited decisions do not.

But even if the PTAB decisions Amazon cites are viable, they do not prohibit the Director from exercising her discretion. Indeed, it would make little logical sense to assess the existence and effect of a *Sotera* or *Sand* stipulation to prevent “duplicative efforts” and “conflicting decisions” at the discretionary denial stage but not address a more pernicious concern in the form of contradictory or duplicative work on claim construction. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”).

The PTAB decisions are also distinguishable for other reasons. They rely heavily on the ability for a party to reserve the right to later assert that claims challenged in IPR are indefinite (e.g., before the district court).²³ And, in each case, the Board and the district court knew the parties positions and were able to avoid inconsistencies.

For example, Amazon relies on mere dicta in *CrowdStrike*. The Board, in that case, actually declined to address the inconsistency argument. *See CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00124, Paper 11, 12 (PTAB June 15,

²³ SoundClear does not contest that a petitioner can challenge claims in an IPR and still later assert, in the district court, that they are indefinite.

2023). The other statements were just offhand remarks about how usual it is for patent defendants to take inconsistent positions and an unspecified statement about whether doing so is “inherently wrong.” The dicta likely resulted from the circumstances of *CrowdStrike*, which are distinguishable from those of Amazon’s petition. The district court proceedings were moving forward at the same time as the IPR. *Id.*, 10. The petition had not requested a stay of the district court proceedings. Thus, the Board was in a position to address alternative positions and prevent inconsistency by monitoring the district court rulings. *Crowdstrike*, 12-13 (“we certainly will consider any claim construction issued by the district court and made of record.”).

Chanel is inapplicable as well. The petitioner in that case had at least disclosed its claim construction positions to the district court. So, the parties and panel were each able to address potential inconsistencies. And the district court had already determined that “it [wa]s not entirely clear” there were any inconsistencies in petitioner’s position. *Molo Design, Ltd. v. Chanel, Inc.*, No. 21-CV-01578 (VEC), 2022 U.S. Dist. LEXIS 79480, 9, n.1 (S.D.N.Y. May 2, 2022). There is no such record or ability to avoid inconsistency here.

Further, the *ratio decidendi* of *Chanel* does not apply here. The *Chanel* panel relied solely on two prior decisions. One was from a ruling in the trial court (the Southern District of New York) below. *Chanel, Inc. v. Molo Design, Ltd.*, IPR2022-

00543, Paper 7, 9 (PTAB Aug. 12, 2022). (citing Ex. 3001 (“SDNY Decision”), 9 n.1). It stated that there was no clear contradiction between asserting indefiniteness in the district court while pursuing an invalidity position in IPR. As stated above, SoundClear does not contest that Amazon can save indefiniteness issues for the district court. The SDNY court also justified its position on the general proposition that “it is neither uncommon nor impermissible for a party to advance different arguments before a District Court and the PTAB.” *Molo Design, Ltd. v. Chanel, Inc.*, No. 21-CV-01578 (VEC), 2022 U.S. Dist. LEXIS 79480, 9, n.1 (S.D.N.Y. May 2, 2022) (citing *Target Corp. v. Proxicom Wireless, LLC*, IPR2020-00904, Paper 11, 12 (PTAB Nov. 10, 2020)). But the *Target* case the SDNY court cited, again, only addressed whether indefiniteness can be reserved for the district court. *See Target Corp. v. Proxicom Wireless, LLC*, IPR2020-00904, Paper 11, 12 (PTAB Nov. 10, 2020) (“That is the only issue before us.”). And the *Target* case simply recognized that “alternative pleading before a district court is common practice . . .” *Id.* Alternative pleadings are, of course, fine. Seeking inconsistent judgments or relief is not. *Marchelletta*, 752 F. App’x at 733-34. The second case the *Chanel* panel cited was *Nidec*. But *Nidec* fails to support Amazon’s position, and *Chanel*’s reasoning, for the reasons discussed above. *see* §IV.A.1.d *supra* (discussing why *Nidec* is inapplicable).

Additionally, *Chanel* should be limited to its facts, because it suggests an approach that could violate the Patent Act and fundamental fairness in other instances. The *Chanel* panel attempted to put the onus on the party trying to avoid inconsistency. It relied on the fact that the patent owner “neither proffers its own construction of these claim terms nor otherwise explains why [petitioner’s] position—that no express construction is required to resolve the issues in dispute—is erroneous.” *Chanel, Inc. v. Molo Design, Ltd.*, IPR2022-00543, Paper 7, 9 (PTAB Aug. 12, 2022). That approach could contradict the Informative *Cambridge* decision and the Board’s statutory mandate. Amazon has the burden to demonstrate invalidity. 35 U.S.C. § 316(e); 37 C.F.R. § 104(c)(e). Indeed, the following suggestion in *Chanel* should not apply, especially where the inconsistent positions have not been disclosed: one party should not be able to freely choose inconsistent or arbitrary positions and thereby shift the burden to the other party to both (1) identify the possible inconsistencies and (2) demonstrate why they should not be allowed. It also presupposes that the party taking inconsistent positions has explained what the various positions will be and what factual and legal arguments it will offer in support. But, as is the case here, Amazon has not been clear about what its alternative positions are—only that it *will* raise numerous claim construction issues before the district court.

Amazon should have committed to claim construction positions when it filed its IPR. Or, at a bare minimum, Amazon should have affirmatively demonstrated why its non-committal position is justified. That cannot be done with a strained hypothetical of a pink ice cream van (accused product) and red fire truck (prior art). *See* Subsection (d) above. Nor can it be done with an oversimplified hypothetical of a single claim component at issue (“about 50 mg” of an ingredient) that the hypothetical prior art just so happens to disclose —both expressly and in the exact same amount. *Amazon v. SoundClear*, IPR2025-00565, Paper 7, 10 (PTAB June 12, 2025).

Indeed, the actual facts here are far different. Amazon’s grounds are not based upon express recitations in the prior art exactly covering every claim and limitation at issue (e.g., “about 50 mg” or a “red fire engine”). Amazon requires its expert to annotate core limitations of the claims because there is no express disclosure of the voice classification limitations. *See* Section IV.A.4 (regarding *Fintiv* Factor 6) *infra*. And the issues extend beyond a single contested issue (e.g., whether “about 50mg” includes “52.2 mg.”) In sum, Amazon’s grounds are a patchwork of obviousness combinations and expert testimony:

Ground	Reference(s)	Challenged Claims
1a	Shin and Aoyama	1-7
1b	Shin and Iwase	1-2, 5-7
2a	Shimomura and Aoyama	1-7
2b	Shimomura and Iwase	1-2, 5-7
3	Grounds 1b or 2b and Aoyama	3-4
4	Grounds 1a-2b and Schuster	5
5	Grounds 1a-4 and Kristjansson	1-7

Pet., 6.

f) Amazon Improperly Seeks an Advisory Opinion

Amazon seeks an advisory opinion by 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 Amazon 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 2-3). Amazon 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 than²⁴—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*

²⁴ See note n.21-22 *supra*.

Electronics America, Inc. v. Uniloc, 2017 LLC, IPR2020-00046, Paper 6, 7-8

(PTAB Apr. 1, 2020) (declining to issue “advisory opinion”).

g) 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 Amazon teed up on almost every issue. Amazon’s Petition relies on statements made in expert declarations (which largely mirror attorney argument) far more than the express disclosures in the asserted prior art. Thus, the issues will require discovery into those opinions. And ultimately a jury will have to weigh the testimony and balance credibility of the experts. *See* FAQ 21.

Fact issues also pervade. Amazon identified at least 5 system prior art and asserted over 90 invalidity grounds in the district court case based on combinations of these system art and prior art references at issue in this IPR. *See infra* Section IV.A.2. Amazon stated that it will seek testimony from “relevant witnesses”—including employees of Apple and Google—regarding these system prior art. Ex. 2001, Dkt. 41, 10. It is a prejudicial tactic to identify 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 Amazon's decision to rely almost exclusively on expert-testimony/attorney-argument in its Petition. It should also defer to Amazon's representation that discovery involving third-party witnesses, which only the district court can provide—is needed to address validity.

2. *Fintiv* Factor 4 and FAQ 14 — Only a Fraction of Amazon's Invalidity Case Is Before the Board

Amazon's Petition addresses only 21% of its invalidity case. The other 79% includes different grounds. The differences could well prevent the IPR proceedings from being dispositive of all factual or technical issues that might arise—to the extent not legally precluded by estoppel. And yet there would be room for inconsistent results. Because, although different, the other 79% of grounds will require the parties, experts, and district court to reexamine some of the same prior art being presented to the Board.

On March 12, 2025, Amazon served its preliminary invalidity contentions. Amazon asserted invalidity grounds as part of their discovery responses. The chart below shows the overlap in Amazon's invalidity position before the Board versus in district court. Additionally, Amazon has included the Amazon Echo, Google Home, Apple HomePod, Sonos One, and Sony Aibo devices as prior art.

Ground	Petition	Invalidity Contention
1	Shin and Aoyama (103)	Shin and Aoyama (103)
2	Shin and Iwase (103)	Shin and Iwase (103)
3	Shimomura and Aoyama (103)	Shimomura and Aoyama (103)
4	Shimomura and Iwase (103)	Shimomura and Iwase (103)
5-6	Grounds 2 or 4 and Aoyama (103)	Shin or Shimomura, in view of Iwase and Aoyama (103)
7-10	Grounds 1-4 and Schuster (103)	Shin or Shimomura, and/or Aoyama or Iwase, in further view of Schuster (103)
11-20	Grounds 1-10 and Kristjansson (103)	Shin, Shimomura, Aoyama, and/or Iwase in further view of Kristjansson ²⁵
New grounds based on prior art from petition		
21	None in Petition	Shin (103)
22		Shin and Shimomura (103)
23		Shin, Shimomura, Iwase, and Aoyama (103)
24-32		Shin, Shimomura, Aoyama and/or Iwase in further view of Kristjansson (103)
New grounds based on both prior art from petition and system prior art		
33-36		Amazon Echo Devices in view of Shin or Shimomura and Aoyama or Iwase
37-40		Google Home Device in view of Shin or Shimomura and Aoyama or Iwase
41-44		Apple HomePod Device in view of Shin or Shimomura and Aoyama or Iwase
45-48		Sonos One Device in view of Shin or Shimomura and Aoyama or Iwase

²⁵ See *infra* Grounds 24-32 not asserted in the Petition.

Ground	Petition	Invalidity Contention
49-52	<i>None in Petition</i>	Sony Aibo Device in view of Shin or Shimomura and Aoyama or Iwase
53-72		Amazon Echo Devices, Google Home Devices, Apple HomePod Device, Sonos One Device, or Sony Aibo Device in view of Shin or Shimomura and Aoyama or Iwase, in further view of Schuster
73-92		Amazon Echo Devices, Google Home Devices, Apple HomePod Device, Sonos One Device, or Sony Aibo Device in view of Shin or Shimomura and Aoyama or Iwase, in further view of Kristjansson

There is significant overlap between the Petition and district court litigation. Amazon relies on Shin, Shimomura, Aoyama, Iwase, Schuster, and Kristjansson in both cases. The overlap in references cited in both the district court litigation and the Petition create strong “concerns of inefficiency and the possibility of conflicting decision.” *Fintiv*, Paper 11, 12. The parties, experts, and district court may have to analyze those same references in connection with the system prior art Amazon disclosed.

Amazon will likely rely upon its *Sotera* statement. But that statement is “not particularly meaningful” in this case. FAQ 14. That is, “[w]here the petitioner is relying on corresponding system art in a co-pending proceeding and/or several

other invalidity theories.” *Id.* Indeed, Amazon’s *Sotera* statement is unlikely to moot the substantial majority (about 79%) of Amazon’s invalidity positions, which remain with the district court. *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.”)

3. *Fintiv* Factor 5 — 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).

4. *Fintiv* Factor 6 — Amazon’s Invalidity Grounds Are Weak

Amazon’s Petition relies entirely on mirrored statements of its attorneys and expert. It is unclear, therefore, whether such statements constitute attorney

argument or expert testimony. What is clear is that they are conclusory and not supported by the record.²⁶

The Petition relies upon two primary references: Shin (Ex. 1003) and Shimomura (Ex. 1004):

Ground	Reference(s)	Challenged Claims
1a	Shin and Aoyama	1-7
1b	Shin and Iwase	1-2, 5-7
2a	Shimomura and Aoyama	1-7
2b	Shimomura and Iwase	1-2, 5-7
3	Grounds 1b or 2b and Aoyama	3-4
4	Grounds 1a-2b and Schuster	5
5	Grounds 1a-4 and Kristjansson	1-7

Pet., 5 (red and yellow annotations added).

Amazon asserts that those references disclose “classify[ing] the [acquired] voice into either a first voice or a second voice based on the calculated distance.” A similar limitation is present in every claim.

Neither reference expressly mentions classifying voices. And neither discloses it inherently; nor does Amazon make an inherency argument as to that

²⁶ *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (PTAB Aug. 24, 2022) (designated: February 10, 2023) (AIA, denying institution – holding declaration is entitled to little weight when it contains an exact restatement of the petition’s unsupported, conclusory assertions without any additional supporting evidence or reasoning).

limitation. Amazon relies solely on its amalgam of attorney argument and expert testimony to fill in the gaps.

For instance, in connection with the Shin reference, Amazon annotates the “First” and “Second” voices:

TABLE 3	
Distance (D) between user and electronic device	Output amount of information of content
Second Voice — $D < 1 \text{ m}$	Amount of information of original content
First Voice — $1 \text{ m} \leq D < 2 \text{ m}$	Content of first abbreviation level
$2 \text{ m} \leq D < 3 \text{ m}$	Content of second abbreviation level
$3 \text{ m} \leq D < 4 \text{ m}$	Content of third abbreviation level
$D \geq 4 \text{ m}$	Content of fourth abbreviation level (abstract content)

Pet., 13; Ex. 1002, ¶61.

Amazon does not expressly state that its lawyers/expert added the red portions (“First Voice” and “Second Voice”). They did. Shin does not include them:

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)

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Ex. 1003, ¶[0086]. Amazon makes the exact same argument in connection with Shimomura—which is cumulative of Shin on this point:

[FIG. 7] Second Voice First Voice

Less than 350 cm	350 cm or more
None	Implementation

Pet., 50; Ex. 1002, ¶170.

Again, Shimomura does not include the red portions that assert to be “Second Voice” or “First Voice”:

[FIG. 7]

Less than 350 cm	350 cm or more
None	Implementation

FIG. 7 Character string transformation determination table

Ex. 1004, 17 (Fig. 7).

Thus, the weakness of the Petition is as plain as Amazon’s red annotations. Voice classification is not disclosed by either of Amazon’s primary references. Indeed, Shin discloses volume adjustment based upon a single user’s movements. It lacks the voice classification limitations:

In this case, since the user 10 provides a voice input with a louder volume than usual and at a faster speech rate than usual *while the user 10 moves away from the electronic device 100*, the electronic device 100 may provide the content as sound with a relatively louder output volume level and at a relatively faster output speed. As such, the user 10 may be provided with content corresponding to a voice input.

Ex. 1003, ¶[0039] (emphasis added).

Similarly, Shimomura is also based solely on distance and does not disclose voice classification: “the speech form of the device during a dialogue with the user is changed *as necessary according to the distance* between the device and the user.” Ex. 1005, ¶[0012] (emphasis added). Amazon relies solely on expert testimony to attempt to disclose classifying voices based on distance. Pet., 49-50 (citing only expert declaration in support of Shimomura discloses the claimed voice classifying unit).

5. The Petition Gives Insufficient Notice of Amazon’s Unpatentability Grounds

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

Amazon’s Petition and expert declaration each repeatedly state contradictory alternative positions without differentiating between the two: “disclose or render obvious,” “disclose or suggest.” *See, e.g.*, Pet., 18, 41, 46, 58, 60; Ex. 1002, ¶¶80, 159, 172, 183, 207, 215 (*e.g.*, “Shimomura and Aoyama disclose or render obvious these claim elements”). 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, 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.

Amazon 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-reference²⁷ or in combination). They fail to address any specific *Graham* factor. For example, Amazon’s position that all 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 Amazon 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.

6. Confluence of Expert Testimony and Attorney Argument

The Petition relies solely on indeterminate statements to address important claim limitations (e.g., voice classification and operations based on it). The language in the Petition mirrors statements in the expert declaration in that regard. So, it is not clear whether the statements are intended to constitute expert opinion,

²⁷ *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”)

legal argument, or something else. *Compare* Ex. 1002, ¶¶54-70 *with* Pet., 10-15 (Ground 1A); *Compare* Ex. 1002, ¶¶166-71 *with* Pet., 49-50 (Ground 2A).

Amazon’s expert declaration should thus be given little or no weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15-17 (PTAB August 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”).

The expert/attorney statements are conclusory and unsupported. They do not rely on any express disclosure for “voice classifying unit.” They do not argue that it is inherent in either reference. Thus, the Petition fails for those reasons alone.

7. Failure to Establish a Prima Facie Case

a) No Application of *Graham* Factors

Amazon 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. Amazon does not, in fact, address *Graham* factor two at all. It 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).²⁸

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

²⁸ See also, e.g., MPEP § 2143 (every example of “rationales” requires an assessment of “difference[s] between the claimed invention and prior art,” how 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).

example, the Petition makes a cursory mention of a possible lack of disclosure of the “intention analyzing unit,” “notification-information acquiring unit,” and “first output sentence” in connection with claim 1. But that is it in terms of applying *Graham*. And yet Amazon’s petition asserts obviousness to fill in far more gaps than just those limitations. It simply fails to identify those gaps or provide any *KSR*-mandated analysis to support overcoming them. In other words, Amazon 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*. See n.**Error! Bookmark not defined.** *supra*. Thus, every obviousness position that extends beyond the “intention analyzing unit,” “notification-information acquiring unit,” and “first output sentence” is legally insufficient.

The Petition’s failure to address *Graham* factor one is also problematic for at least four 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 that of Amazon’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 “predictable results / improvements / responses / solution / benefits / implementation” 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 only purports to provide detail regarding predictable results in one instance: in connection with limiting the number of rows in a table. Pet., 30-32. The rest is either completely missing or constitutes undeveloped generalizations such as, “would have been a predictable and logical extension of Shin’s functionalities.” Pet., 18. As in *Johns Manville Corp. v. Knauf Insulation, Inc.*: “[Amazon] does not support, in its claim-by-claim analysis, which elements of the cited references could be predictably combined. For example, in its discussion of claim 1, [Amazon] indicates which of the references purportedly discloses each element of claim 1, but it does not indicate which of the prior art elements allegedly has a known function, what that function is, and why that function is allegedly predictable.” IPR2018-00827, Paper 9, 12 (PTAB Oct. 16, 2018) (informative opinion). “Petitioner’s reliance on the testimony of [its expert]

to support its arguments fails to direct us to evidence supporting that [the] claims [at issue] represent nothing more than the predictable use of prior art elements.” *Id.* Stating that something was “well-known and predictable” is not enough. *Id.*, 13-14.

Fourth, 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), 6 (emphasis added); *see also Dionne v. Liotta, Int.*, 104, 333, Paper 119 at 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.*, 7 (“a bachelor’s degree in computer engineering, computer science, electrical engineering, or a similar field, and approximately two years of industry or academic experience in a field related to controlling the audio output of electronic devices.”).

b) FAQ 21 — Extensive Reliance on Expert Testimony

The entire Petition *is* expert testimony.

FAQ 21 states:

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 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. Amazon’s Petition is almost entirely duplicative of its expert’s opinions. Thus it is not only unfocused, but also indistinguishable.

c) Improper Certificate of Translation

Amazon relies upon a translated Japanese reference without laying the proper foundation for the translation. *See* Ex. 1005. The certification does not identify whether the signatory (Ms. Snorteland) is a translator or is fluent in

Japanese. It does not state how the translation was performed. It does not even identify *who* performed the translation.

Those are material deficiencies. They are especially acute in the context of Amazon’s Petition. The Petition relies heavily upon purported expert testimony to address the lack of express disclosures in Shimomura. The lack of express disclosures elevate the potential for dispute over the context in which specific words are used. Such disputes go beyond whether a translation is certified as either true or not. They proceed into the realm of expert testimony. *See, e.g., Kurotaki v. United States*, No. 22-00063 MWJS-WRP, 2024 U.S. Dist. LEXIS 215953, at *13-15 (D. Haw. Nov. 27, 2024) (distinguishing between lack of dispute over “proper translation” versus expert testimony as to “different linguistic connotations” of a “properly translated” Japanese word); *see also Hayashi v. Ozawa*, No. 17-cv-2558 (AJN), 2018 U.S. Dist. LEXIS 53559, at *5 (S.D.N.Y. Mar. 19, 2018) (“This case turns primarily on whether a particular Japanese word for ‘doctor’ refers only to people with medical degrees. The Court has no basis to rule on that question, and it will likely require the testimony of experts to aid the trier of fact in determining whether that is true.”). Ms. Snorteland has not laid the foundation for her understanding of the Japanese language (e.g., fluency), let alone laid the foundation for her qualification as an expert. *Kurotaki*, 2024 U.S. Dist. LEXIS 215953, at *15.

Further, in the era of AI-based language models, it is particularly necessary to lay the foundation for how translations are performed. Ms. Snorteland is a translator with TransPerfect, Inc. Ex. 1005. TransPerfect advertises services in which humans assist with AI-generated translations. Ex. 2010 (“That’s why a human-in-the-loop (HTL) approach, involving subject matter experts, is essential to validate AI-generated content.... TransPerfect IP combines advanced NMT technology with human expertise to deliver high-quality, cost-effective patent translations and support across the IP lifecycle.”).

8. Section 325(d) and the *Advanced Bionics* Framework Favors Discretionary Denial

The Petition should be denied in view of 35 U.S.C. § 325(d) because 2 out of 6 prior art references at issue in this Petition were expressly and extensively relied upon by the Examiner and the remaining references and arguments relating thereto were cumulative to those already presented to the Office.

According to *Advanced Bionics*,

[U]nder § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, IPR2019-01469, Paper 6, 8 (PTAB Feb. 3, 2020) (precedential).

Further, the *Becton* factors inform how the two-part framework is applied. *Id.*, 9.

The *Becton* factors are as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Id., n.10 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). As explained in *Advanced Bionics*, factors (a), (b), and (d) are used to inform step 1, whereas factors (c), (e), and (f) are used to inform step 2. *Id.*, 10.

The first step of *Advanced Bionics* is satisfied because the asserted prior art references were either previously presented to the Office or cumulative to the same: Aoyama and Schuster were relied upon by the Examiner during prosecution of the '675 patent; Iwase is cumulative to Aoyama; and Shin and Shimomura are both deficient for the same reason articulated by the Examiner.

The second step of *Advanced Bionics* is satisfied because Amazon does not identify any error in the Examiner's analysis of Aoyama and Schuster. And Amazon attorney and expert's conclusory statements cannot support a showing of material error by the Office.

a) *Advanced Bionics* Step One

The Petition tacitly acknowledges that Aoyama and Schuster were previously presented to the Office. *See* Pet., 72 (stating that “Shin, Shimomura, Iwase, and Kristjansson were never before the Examiner,” but omitting Aoyama and Schuster). Indeed, the Examiner expressly relied upon Aoyama and Schuster as bases for rejections, but ultimately allowed the claims over both references. Ex. 2014, 133-134 and 179-190.

Nonetheless, Amazon argues that the first prong of *Advanced Bionics* is not met here because “Shin, Shimomura, Iwase, and Kristjansson were never before the Examiner.” Pet., 72. This argument misapprehends the standard under *Advanced Bionics*. The inquiry under Prong 1 is “whether the same *or substantially*

the same art previously was presented to the Office or whether the same *or substantially the same* arguments previously were presented to the Office.” Simply identifying new references, especially where (as here) the new references are cumulative to those presented to the Office, is not enough to avoid denial.

The cases cited by Amazon are inapposite. *Shenzen Chic Electronics* did not address how newly prior art affects step one. It addressed a reference (Baxter) that the examiner had considered. *Shenzen Chic Elecs. v. Pilot, Inc.*, IPR2023-00810, Paper 12, 20-21 (PTAB Nov. 8, 2023) (the prior art reference was cited in an IDS). The Board declined to address other references solely because the Patent Office’s error in connection with Baxter was sufficient, in and of itself, to preclude denial. The Board simply did not need to address regardless of any other argument or analysis as a procedural matter. The Board applied the same logic in *TP-Link* and *Quasar*.²⁹ Pet., 72 (citing *TP-Link Corp. Ltd. v. Netgear, Inc.*, IPR2023-01469, Paper 10, 9-10 (PTAB Apr. 2, 2024) and *Quasar Sci. LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10, 12-14 (PTAB Oct. 10, 2023)). *JUUL Labs* is also inapplicable because there, the parties did not dispute that all references at issue

²⁹ The Petition cites *Quasar* for the proposition that “[b]ecause the first prong is unmet, the Board need not address the second prong.” Pet., 72. But the Board in *Quasar* did the opposite—it did not address the first prong because it found that the Office materially erred under the second prong. *Quasar Sci. LLC v. Colt Int’l Clothing, Inc.*, IPR2023-00611, Paper 10, 12-14 (P.T.A.B. Oct. 10, 2023).

were arguably before the Examiner. *JUUL Labs, Inc. v. NJOY, LLC.*, IPR2024-00160, Paper 10, 12 (PTAB May 24, 2024) (“all three of the asserted references ... were disclosed during examination”).

In short, the mere fact that the Petition relies upon newly cited references does not preclude discretionary denial under §325(d). Petitioners cannot circumvent *Advanced Bionics* simply by asserting new (but cumulative) references. Here, Amazon’s new references add nothing new and are cumulative to references previously considered by the Office.

Amazon relies on Iwase to make the same cumulative argument it made with Aoyama. Amazon acknowledges that both Iwase and Aoyama were filed by Sony and that both allegedly disclose “customizing[/tailoring] voice output by replacing words.” *See* Pet., 2-3. Amazon relies on Iwase and Aoyama to disclose the same limitations for claim 1 (replacing words in the output content), Pet., 23-25 (based on Aoyama), 41-42 (based on Iwase), and claim 2 (notification information and output-content generating unit), *id.*, 30-33 (based on Aoyama), 44-45 (based on Iwase). Amazon’s arguments with respect to both references are substantially similar. For example, Amazon argues that Aoyama discloses replacing words in the output content based on Aoyama’s description of “tailor[ing] output by replacing words based on the user or situation”:

Aoyama also discloses replacing other words in an output sentence, such as the date and time. (*Id.* ¶[0140].) For example, Aoyama replaces the name “Taro Yamada” with the name “Mr. Yamada,” the date “10/1/2014” with “tomorrow,” and “13:00” with “1 pm.” (*Id.* ¶¶[0138]-[0140].) Thus, the device can generate an output sentence such as “You have a meeting with Mr. Yamada in room A tomorrow at 1pm.” instead of “You have a meeting with Taro Yamada in room A at 13:00 10/1/2014.” (*Id.*)

Pet., 23-26. Amazon similarly argues that Iwase discloses replacing words in the output content based on Iwase’s description of adjusting notification information presented to the user:

This adjusting may involve word replacement, such as replacing “I recommend” in the phrase “I recommend bringing an umbrella” with “You should,” yielding: “You should take an umbrella.”

Pet., 42 (citing Ex. 1017, 15:6-14).

Amazon’s proffered motivation to combine Aoyama and Iwase with other references are also substantially similar. *Compare, e.g.,* Pet., 26 (“such a configuration merely represents the addition of one known element (Aoyama’s word replacement) to another known element (Shin’s distance-based content abbreviation/simplification) to obtain predictable results (using word replacement to simplify content for distant users)”) *with id.*, 42 (“such a configuration represents the simple addition of one known element (Iwase’s word replacement)

to another known element (Shin's distance-based output adjustment) to obtain predictable results (easier-to-understand output to users at greater distances).

Indeed, Amazon's own treatment of Aoyama and Iwase confirms that these references are cumulative—Amazon's invalidity contentions treat Aoyama and Iwase as interchangeable:

It would have been obvious to a POSITA to modify the [Amazon Echo Devices/Google Home Devices/Apple HomePod Device/Sonos One Device/Sony Aibo] device to include the distance calculation functionality of Shin and/or Shimomura and ***the word replacement feature of Aoyama or Iwase*** to provide an output with content determined based on the user-to-device distance, as disclosed by the prior art.

Ex. 2015, 39-41 (emphasis added).

Amazon's other references fair no better. While Shin and Shimomura were not cited by the Examiner, both references are deficient for the reason expressly articulated by the Examiner: "Proximity sensors are commonly known in speech recognition to determine if a user is within a predetermined distance to a control device, but not to classify a voice into a first voice or a second voice based on a distance." Ex.2014, 133-134. As discussed above in Section IV.A.6, notwithstanding Amazon attorney and expert's mirrored conclusory arguments, neither Shin nor Shimomura expressly discloses classifying voice based on distance. Shin and Shimomura thus fall under the same category of prior art

already known to, and considered by, the Examiner—they at best disclose the use of proximity sensors in connection with speech recognition, but not to classify voices based on distance. *id.*

For the foregoing reasons, *Advanced Bionics* Step 1 and *Becton* factors (a), (b), and (d) favors denial.

b) *Advanced Bionics* Step Two

Amazon fails to assert that the Examiner erred in addressing Aoyama or Schuster. Instead, it argues that the second step of *Advanced Bionics* favors institution because the Examiner “did not consider Shin, Shimomura, Iwase, or Kristjansson” and did not “benefit from this Petition’s mapping and accompanying expert declaration.” Pet., 72. That is a conclusive and undeveloped argument. And, as discussed above, Iwase is cumulative of Aoyama. And contrary to Amazon’s conclusory assertion, it could not and did not show that the Office committed material error by failing to consider the remaining references because, as discussed for step 1 above, none of these references discloses what the Examiner found missing in the prior art. Amazon thus failed its burden of showing that that the Examiner erred. *See Advanced Bionics*, 9.

For the foregoing reasons, *Advanced Bionics* Step 2 and *Becton* factors (c), (e), and (f) favors denial.

B. The Other Factors Are Neutral or Should be Given Little Weight

1. *Fintiv* Factor 1

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 the 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. *Sotera* Stipulation

Amazon’s *Sotera* stipulation is ineffective in this case for the reasons stated above in Section IV.A(a). Most notably, the Petition only addresses 21% of Amazon’s case. And the other 79% relies on the same printed publications. Thus, to the extent the Board awards it any weight, it should be minimal.

V. CONCLUSION

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

Dated: June 16, 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 12,991 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).

Dated: June 16, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 11,244,675 was served electronically via email on June 16, 2025, on the following counsel of record for Petitioner:

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