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. 9,031,259
Issue Date: May 12, 2015

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

Inter Partes Review No. IPR2025-01096

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

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37 C.F.R. § 42.104(c).....32

PATENT OWNER EXHIBIT LIST

Exhibit No.	Description
2001	Memorandum of Law in Support of Google's Motion to Transfer to the Northern District of California Under 28 U.S.C. § 1404(a) (Dkt. 39)
2002	Judge Wright Allen's median time to trial, available at https://law.lexmachina.com/federal-court/district/judge/3373/cases/?pending-from=2009-01-01&filters=true&view=analytics&tab=timing&cols=title%2Ccivil-number%2Ccase_type%2Ccourt%2Cfiled%2ClastDE%2Cterminated
2003	Docket Printout of VA No. 2:24-cv-00321 (EDVA)
2004	Docket Printout of VA No. 2:24-cv-00320 (EDVA)
2005	Eastern District of Virginia's median time to trial in patent cases, available at https://law.lexmachina.com/court/vaed/cases/?pending-from=2009-01-01&filters=true&view=analytics&tab=timing&cols=title%2Ccivil-number%2Ccase_type%2Ccourt%2Cfiled%2ClastDE%2Cterminated
2006	Reply Brief in Support of Google LLC's Partial Motion to Dismiss Plaintiff's Complaint Under Rule 12(b)(6) (Dkt. 25)
2007	Median Time to Disposition in Cases Terminated After Hearing or Submission, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, available at https://www.cafc.uscourts.gov/wp-content/uploads/reports-stats/FY2024/MedianDispositionTime-Merits.pdf
2008	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 15/067,088, dated February 26, 2018
2009	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 15/629,155, dated November 1, 2018
2010	Webpage of JVC Kenwood Corporate History, available at https://www.jvckenwood.com/en/corporate/history/

2011	Webpage of JVC Kenwood Amateur Radio, available at https://www.kenwood.com/usa/com/amateur/
2012	Webpage of JVC Kenwood USA, available at https://www.jvc.com/usa/
2013	Applicant (Google) Information Disclosure Statement for Application No. 13/955,198, dated October 7, 2015
2014	U.S. Patent No. 9,237,225
2015	U.S. Patent No. 10,229,697
2016	U.S. Patent No. 9,979,531
2017	U.S. Patent No. 9,813,262
2018	U.S. Patent No. 10,020,963
2019	U.S. Patent No. 9,591,508
2020	U.S. Patent No. 9,549,290
2021	U.S. Patent No. 9,491,007
2022	U.S. Patent No. 9,478,847
2023	Applicant Supplemental Information Disclosure Statement for Application No. 13/692,520 IDS, dated September 22, 2017
2024	U.S. Patent No. 9,813,262
2025	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 14/510,838, dated March 23, 2016
2026	U.S. Patent No. 9,502,021
2027	Brief in Support of Amazon's Motion to Dismiss Plaintiff's Complaint Under Rule 12(b)(6) (-320 Case Dkt. 31)
2028	Brief in Support of Google LLC's Partial Motion to Dismiss Plaintiff's Complaint Under Rule 12(b)(6) (-321 Case Dkt. 14)
2029	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 16/036,345, dated March 14, 2019

2030	U.S. Patent No. 10,475,445
2031	U.S. Patent No. 12,249,331
2032	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 16/284,085, dated December 27, 2019
2033	U.S. Patent No. 11,170,766
2034	U.S. Patent No. 11,996,092
2035	USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 14/582,305, dated April 26, 2016
2036	U.S. Patent No. 9,560,441

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 1-20 ("the challenged claims") of U.S. Patent No. 9,031,259 ("'259 patent," EX-1001).

I. INTRODUCTION

A. Discretionary Denial Is Appropriate Based Upon the Director's Previous Ruling

The director already denied an *inter partes* review ("IPR") petition challenging the '259 patent. The Petition was discretionarily denied because the patent has been in force for ten years, creating "strong settled expectations." *See Google LLC v. SoundClear Techs. LLC*, IPR2025-00345, Paper 15 (PTAB Aug. 4, 2025). The instant follow-on Petition should be denied for those and other reasons. Settled expectations have grown stronger, as the patent has continued to be in force and an earlier petition was denied. Amazon also had prior knowledge of this patent—one of many in the assignee's portfolio, who was active in the electronics communication field. And further unnecessary delay (due to a stay in the district court proceeding) will result here without denial.

The *General Plastics* factors also favor denial, given coordination between Amazon and Google, including successively filed petitions relying on related prior art or arguments.

B. Other Factors

Other factors forming part of the holistic record are similarly addressed below. This Petition is one of three (IPR2025-01096, IPR2025-01067 ("067 Petition"), and IPR2025-01080 ("080 Petition")) filed by Amazon challenging the patents at issue in *SoundClear Technologies LLC v. Amazon.com, Inc. et al.*, 2:24-cv-00320[1] (E.D. Va., May 1, 2024). If institution is denied for the Amazon Petitions, median time-to-trial statistics suggest that the parallel district court case will proceed to trial as soon as December 2025. That is almost *a year before* the statutory deadline for the Board's final written decisions. Further, the prior discretionary denial of two related petitions (IPR2025-00344 and IPR2025-00345)[2] increases the likelihood that a related district court case (*SoundClear Technologies*

[1] Hereinafter "the district court case."

[2] The '259 patent (at issue in IPR2025-00345); U.S. Patent No. 9,070,374 ("'374 patent") (at issue in IPR2025-00344).

LLC v. Google LLC, 2:24-cv-00321 (E.D. Va., May 1, 2024)) will proceed to trial on a similar time frame.[3] Those cases will move forward promptly.

Denial is also appropriate under the *General Plastic* factors. They counsel against the Board being used as a strategic vehicle—especially in the face of fact issues, discovery matters, and expert disputes that only an Article III court has the tools to address. The district court will adjudicate those matters—and every issue in a case involving three patents—before the IPR proceeding concludes.

Moreover, the issues before the district court will be more expansive than those asserted in its Petitions. IPR proceedings would not, and could not, serve as an effective alternative to the district court proceedings. For example, Amazon will raise additional product prior art and claim constructions regardless of the outcome of this IPR.

There are matters related to validity that only the district court can address. The testimony of all six named inventors of the patents-in-suit is material and relevant, because it will relate to issues of validity and infringement. All six reside in Japan. That will necessitate overseas discovery (e.g., via Letters Rogatory), which the PTAB cannot provide.

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[3] Notably, Google did not file an IPR against the third patent in that case (U.S. Patent No. 9,804,819).

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

Each of the above concerns are compounded by Amazon's intent to pursue contradictory claim construction positions for purposes of invalidity (before the Board) and non-infringement (in district court). If even a single claim escapes the IPR proceeding, Amazon will seek claim constructions more favorable to infringement issues.

Furthermore, Amazon deliberately delayed the parallel district court litigation and prevented the case from moving forward. Amazon requested and received a 60-day extension to respond to SoundClear's complaint. EX-2004, Dkt. 15, Dkt. 16. Then Amazon filed a fact-intensive motion to dismiss which required the Court to take over six months to consider before denying the invalidity arguments raised in the motion. *Id.*, Dkt. 48.

Amazon also waited to move for a stay pending IPR until well after briefing for its MTD was completed. In fact, it waited more than a year after the complaint was filed to file this Petition, the 080 Petition, and the 067 Petition—just a few

days shy of the statutory deadline. That is neither accident nor coincidence. It is a coordinated approach, mirrored between Amazon and Google. Other large tech defendants will no doubt follow suit if that approach bears fruit.

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

Finally, the Petition is facially deficient in multiple ways. For example, the Petition relies extensively on expert declaration testimony to cure the many resulting gaps. But it merely parrots the Petition's conclusory statements. Such mirrored statements between attorney and expert should be given little to no weight.

The Petition also fails to disclose its grounds with particularity or provide a prima facie obviousness analysis under *Graham*. It relies on indeterminate and multiplicative combinations of references. And it rarely specifies what limitations are missing from the primary references (second factor), why a POSITA would have been motivated to bridge the gap (first factor), or *any* analysis supporting conclusory statements of reasonable expectation of success.

II. PROCEDURAL BACKGROUND OF PARALLEL LITIGATIONS

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

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

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

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

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

On February 10, 2025, Google filed IPR petitions against the '374 patent, and '259 patent.

On February 18, 2025, Google filed a motion to stay pending *inter partes* review in the district court Google case. EX-2003, Dkt. 73. The district court granted Google's motion to stay the Google case on March 31, 2025. *Id.*, Dkt. 84.

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

On April 7, 2025, Amazon filed a motion to stay the Amazon case pending resolution of the *inter partes* review petitions filed by Google against the '374 patent (IPR2025-00344) and '259 patent (IPR2025-00345). *Id.*, Dkt. 49, Dkt. 50. On April 21, 2025, SoundClear filed notice of non-opposition to Amazon's stay motion. *Id.*, Dkt. 52.

Amazon filed IPR petitions against the '374 patent, '819 patent, and '259 patent on May 28, 2025, May 30, 2025, and June 2, 2025 respectively.

On July 1, 2025, the court granted Amazon's stay motion. *Id.*, Dkt. 56.

On August 4, 2025, the two Google petitions were discretionarily denied.

III. LEGAL STANDARDS

A. Discretionary Denial Framework

"The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition … shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

The new discretionary denial framework goes beyond prior rules and guidance, as demonstrated by recent memoranda and FAQs.[4]

[4] *See* FAQs for Interim Processes for PTAB Workload Management, April 25, 2025, (https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-

The Morgan Stewart Memo permits the Director to consider existing precedent under *Fintiv*, and *Advanced Bionics* along with the Consolidated Trial Practice Guide (Nov. 2019).[5] Morgan Stewart Memo, 2 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential)).

But the Morgan Stewart Memo goes further. It advises parties to address all relevant considerations, which may include:

- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;

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management) ("FAQs"); *see also* Interim Processes for PTAB Workload Management, March 26, 2025 (https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf) ("Morgan Stewart Memo").

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

- 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 (emphasis added).

B. *Fintiv*

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

C. *General Plastic*

The Board's precedential *General Plastic* decision provides seven factors the Board considers "in evaluating follow-on petitions":

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;

2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;

6. the finite resources of the Board; and

7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Gen. Plastic, IPR2016-01357, Paper 19, 16.

While follow-on petitions are often filed by the same petitioner, "application of the *General Plastic* factors is not limited solely to instances where multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners

when weighing the *General Plastic* factors." *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 2 (PTAB Apr. 2, 2019) (precedential).

IV. ARGUMENT

A. The Director Already Found Discretionary Denial Appropriate

1. The Holistic Record Supports Denial

Earlier this month, the Director discretionarily denied a prior petition against the '259 patent. *See Google LLC v. SoundClear Techs. LLC*, IPR2025-00345, Paper 15 (PTAB Aug. 4, 2025) ("Google IPR"). The Director "consider[ed] the parties' arguments and the record . . . ." *Id.*, 2. The Director determined that "in view of all relevant considerations, discretionary denial of institution [wa]s appropriate in th[at] proceeding." *Id.* That "determination [wa]s based on the totality of the evidence and arguments the parties ha[d] presented." *Id.* The Director made clear that "[a]lthough certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented." *Id.*, 3. As addressed below, the same holistic assessment applies here.

Nothing has changed since, except settled expectations have only grown stronger, and delay in the district court proceedings has continued.

2. The Director Determined that SoundClear's Strong Settled Expectations Support Discretionary Denial

The Director found that because the '259 patent has been in force for ten years (it issued on May 12, 2015), SoundClear had "strong settled expectations." *Id.*, 2 (citing *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025)).

The same facts support discretionary denial here. Indeed, patents "in force for approximately eight, twelve, and fifteen years, create[e] *strong* settled expectations." *Coretronic Corp. v. Maxell, Ltd.*, IPR2025-474, Paper 11, 2 (Director July 10, 2025) (emphasis added); *see also Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 (Director June 26, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelecs., Inc.*, IPR2025-00433, Paper 12 (Director June 27, 2025) (clarifying *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (Director June 6, 2025)); *Ericsson Inc. v. Procomm*, IPR2024-01452, Paper 16, 3 (Director June 25, 2025) (citing *iRhythm*). Even patents in force for *three* years create settled expectations sufficient to support discretionary denial. *See Samsung Elecs. Co. Ltd. et al. v. GenghisComm Holdings LLC*, IPR2025-00788, Paper 11, 2 (PTAB Aug. 22, 2025).

Further, actual notice of a patent is not required for settled expectations. *Dabico*, Paper 21, 3. The director found that "[Google] had knowledge of the challenged patents." *Id.*, 3. That knowledge was based upon the fact that Google

cited the ’374 patent on an IDS during its prosecution of two of its own patent applications. The ’374 patent was one of the two patents Google challenged in related proceedings (the other being the ’259 patent). Both of those two patents were originally assigned to JVC Kenwood. *Google IPR,* Paper 11, 1-2.

The same is true here. Amazon had knowledge of the disclosure of the ’259 patent (one of the three patents-in-suit in the district court case that Amazon has challenged in IPR petitions) at least as early as February 26, 2018. In fact, two different Examiners notified Amazon of U.S. Publication No. 2013/0073283 (the published patent application that would eventually issue as the ’259 patent)—each identifying it as “pertinent” to Amazon’s respective applications. EX-2008; EX-2009. All challenged patents in the underlying district court case were assigned to JVC Kenwood, which has been active in the electronic communication field. EX-2010; EX-2011; EX-2012.

Thus, SoundClear’s strong settled expectations alone merit discretionary denial here.

B. The *General Plastic* Analysis Supports Denial

In addition to the *Fintiv* factors, the *General Plastic* factors also support discretionary denial because the instant Petition is a follow-on petition to IPR2025-00345.

1. Amazon and Google Have a Significant Relationship

Although Google and Amazon are different entities, they are each involved in litigation with SoundClear in the same venue (the EDVA), before the same judge (Judge Wright Allen), involving the same patents-in-suit, and involving similar and competing accused products.

Moreover, Amazon based its motion to stay its district court case on the resolution of *Google's* IPR petitions—not Amazon's—and the stay motion and order in *Google's* district court case. As such, it chose to create a significant relationship with Google in the related litigation by strategically hitching its district court case to Google's case. Instead of waiting until after it filing its own IPRs to file a stay motion, Amazon chose to avail itself of *Google's* prior IPR filings to support a stay motion in its own district court case and give itself more time to file its own IPRs. In fact, Amazon even teed up *Fintiv* arguments against discretionary denial by specifically highlighted in its eleventh-hour petitions that it had filed a "Motion to Stay Pending IPR" in the district court case, and that "a stay is highly likely." 067 Petition, 73, n.8. Tellingly, it conveniently failed to tell the Board that the "Pending IPR[s]" referenced in its stay motion were *Google's* IPR petitions. Thus, Amazon's strategic and significant relationship with Google allowed it to reinforce its arguments in favor of its motion to stay and against discretionary denial.

In view of the foregoing, Amazon and Google have a "significant relationship" with respect to SoundClear's assertion of the '259 patent. *See Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 9-10 (PTAB Apr. 2, 2019) (precedential). Such circumstances are sufficient to invoke the *General Plastic* analysis.

2. Factor 1 – Amazon's Petition is Directed to the Same Claims of the '259 Patent as Google's Petition.

Amazon's Petition is directed to all claims (1-20) of the '259 patent. The prior filed Google petition (IPR2025-00345)—which was discretionarily denied—was directed to the same claims. Further, as stated above, Amazon and Google have a significant relationship in these matters.

General Plastic factor 1 thus favors denial.

3. Factor 2 – Google Knew About the Alleged Prior Art Cited in Amazon's Petition Before Filing IPR2025-00345.

All grounds of Amazon's Petition rely on either EX-1003 (the Chen reference (U.S. Publication No. 2010/0081487)), EX-1010 (the Strömmer reference (U.S. Publication No. 2013/0013303)), and EX-1005 (the Florencio reference (U.S. Publication No. 2008/0240463)). Google knew about each of these references before it filed its petition in IPR2025-00345 against the '259 patent.

Google has known about the Chen reference since at least October 7, 2015 when it cited the reference in an IDS during the prosecution of U.S. Application

13/955,198 (now U.S. Patent No. 9,237,225). EX-2013. The ’225 patent is owned by Google. EX-2014. Indeed, at least *eight* other Google patents also cite the Chen reference as relevant art.[6] EX-2015; EX-2016; EX-2017; EX-2018; EX-2019; EX-2020; EX-2021; EX-2022. Thus, Google knew about the Chen reference over *nine years* before it filed its petition on February 10, 2025.

Google has known about the Strömmer reference since at least September 22, 2017 when it cited the reference in an IDS during the prosecution of U.S. Application 13/692,520 (now U.S. Patent No. 9,813,262). EX-2023. The ’262 patent is owned by Google. EX-2024. Indeed, at least *three* other Google patents also cite the Strömmer reference as relevant art.[7] EX-2015; EX-2016; EX-2018. Thus, Google knew about the Strömmer reference over *seven years* before it filed its petition on February 10, 2025.

Google has known about the Florencio reference since at least March 23, 2016 when the patent examiner of U.S. Application 14/510,838 (now U.S. Patent No. 9,502,021) relied on it in a non-final rejection. EX-2025. The ’021 patent is

[6] U.S. Patent Nos. 10,229,697; 9,979,531; 9,813,262; 10,020,963; 9,591,508; 9,549,290; 9,491,007; and 9,478,847.

[7] U.S. Patent Nos. 10,229,697; 9,979,531; and 10,020,963.

owned by Google. EX-2026. Thus, Google knew about the Florencio reference nearly *nine years* before it filed its petition on February 10, 2025.

General Plastic factor 2 thus favors denial.

4. Factor 3 – Amazon Waited Until the Last Possible Moment to File its IPR Petition.

Amazon's Petition was filed on June 2, 2025—one day before its statutory deadline of June 3, 2025[8]. It filed its other petitions (IPR2025-01067 and IPR2025-1080) against the other patents-in-suit in the district court case on May 28, 2025 and May 30, 2025 respectively. SoundClear filed its POPR discretionary denial brief for Google's earlier petitions (IPR2025-00344 and IPR2025-00345) on June 9, 2025. Thus, while Amazon filed its petitions before SoundClear filed its POPR discretionary denial briefs, it only did so to meet its statutory deadline.

Amazon's wait-and-see strategy is thematic of its litigation approach in the district court thus far. That suggests it would have waited until after SoundClear had filed its POPR for the Google IPRs to file its own IPRs. Google and Amazon were served with a separate district court complaint on the same day (June 3, 2024). Yet, only after Google requested additional time to respond to the complaint did Amazon also request more time. EX-2003, Dkt. 11; EX-2004, Dkt. 15. And when Amazon did request more time, they requested three more weeks than

[8] Amazon was served with the district court case Complaint on June 3, 2024.

Google did. *Id.* When Amazon filed its motion to dismiss, it was substantially similar to Google's motion to dismiss that was filed three weeks earlier. *Compare* EX-2027 *with* EX-2028. Like Google did in its MTD, Amazon alleged that the '374 patent was invalid under § 101 and the infringement count based on the '819 patent should be dismissed due to noninfringement.[9] *Id.* As stated previously, Amazon also did not file its motion to stay until after Google had filed IPR petitions and moved the district court to stay that case.

Consistent with its litigation strategy over the past year, Amazon was expecting to benefit from SoundClear having to file its POPR for the Google petitions in May 2025—approximately three months after the Google IPRs were filed. But Amazon was not expecting the USPTO Director's new discretionary denial policy that was announced on March 26, 2025. The implementation of that policy delayed the Board in according a filing date for the Google petitions by nearly two months after they were filed, which consequently pushed the due date for SoundClear's POPR deadlines beyond Amazon's statutory deadline of June 3, 2025.

[9] Like Google, Amazon did not challenge '259 patent under invalidity or noninfringement in its MTD. *Id.*

Amazon's wait-and-see approach should not be rewarded here, particularly when the Google petition has already been discretionarily denied for the '259 patent in view of SoundClear's strong settled expectations. Therefore, *General Plastic* factor 3 favors denial or is at least neutral.

5. Factor 4 – Amazon and Google Knew About the Alleged Prior Art Well Before Amazon's Petition Was Filed.

As stated above for factor 2, Google knew about all of the primary references asserted in Amazon's Petition at least seven years before the Petition was filed. As shown below, Amazon knew about all of these references at least five years before it filed its Petition.

Amazon has known about the Chen reference since at least March 14, 2019 when the patent examiner of U.S. Application 16/036,345 (now U.S. Patent No. 10,475,445) cited it as "pertinent" to the disclosure of that application. EX-2029. The '445 patent is owned by Amazon. EX-2030. Indeed, at least one other Amazon patent also cites the Chen reference as relevant art.[10] EX-2031. Thus, Amazon knew about the Chen reference over *six years* before it filed its petition on June 2, 2025.

Amazon has known about the Strömmer reference since at least December 27, 2019 when the patent examiner of U.S. Application 16/284,085 (now U.S.

[10] U.S. Patent No. 12,249,331.

Patent No. 11,170,766) cited it in connection with an office action for that application. EX-2032. The ’766 patent is owned by Amazon. EX-2033. Indeed, at least one other Amazon patent also cites the Strömmer reference as relevant art.[11] EX-2034. Thus, Amazon knew about the Strömmer reference over *five years* before it filed its petition on June 2, 2025.

Amazon has known about the Florencio reference since at least April 26, 2016 when the patent examiner of U.S. Application 14/582,305 (now U.S. Patent No. 9,560,441) relied on U.S. Patent No. 8,098,842 (which issued from the Florencio reference cited in the Petition) in a non-final rejection. EX-2035. The ’441 patent is owned by Amazon. EX-2036. Thus, Amazon knew about the Florencio reference over *nine years* before it filed its petition on June 2, 2025.

Collectively, Amazon and Google both knew about each and every primary reference at least five years before Amazon’s Petition was filed. Thus, *General Plastic* factor 4 favors denial.

6. Factor 5 – No Explanation Justifies the Lapse of Time Discussed in Factor 4.

As discussed above, Amazon and Google each separately knew about the Chen, Strömmer, and Florencio references for at least five years before Amazon cited them in the Petition.

[11] U.S. Patent No. 11,996,092.

There is no adequate explanation for the five-year lapse of time between Amazon learning about all three references and the filing of Amazon's Petition. Indeed, as discussed *supra*, Amazon knew about the disclosure of the '259 patent since at least February 26, 2018. Yet it waited until one day before the statutory deadline to file its Petition.

Likewise, there is no adequate explanation for the seven-year lapse of time between Google learning about all three references and the filing of Amazon's Petition. Indeed, even when Google chose to file IPR2025-00345 against the '259 patent, it chose not to rely on those references, despite having knowledge of them.

Thus, *General Plastic* factor 5 favors denial.[12]

7. Factors 6 and 7 – The Director Already Discretionarily Denied Google's Petition (IPR2025-00345) Due to SoundClear's Strong Settled Expectations.

General Plastic "sixth and seventh factors are efficiency considerations." *Valve*, Paper 11, 15. "[H]aving multiple petitions challenging the same patent, especially when not filed at or around the same time … is inefficient and tends to waste resources." *Id.* The former Acting Director has made clear that current

[12] SoundClear expects Amazon to offer an allegedly adequate explanation in an opposition brief. SoundClear intends to address any such explanation in a reply brief after requesting permission from the Board to file one.

constraints on PTAB resources justified the new approach to discretionary denial. *See* Morgan Stewart Memo.

Under its new policies, the Acting Director previously considered and discretionarily denied a petition against the ’259 patent. That petition was denied because the patent has been in force for ten years, which created “strong settled expectations” for SoundClear. *See Google*, IPR2025-00345, Paper 15. Amazon’s Petition does not change the length of time the ’259 patent has been in force. Therefore, it does not change SoundClear’s strong settled expectations in the ’259 patent.

Thus, *General Plastic* factors 6 and 7 favor denial.

On balance, the *General Plastic* factors collectively favor discretionary denial of the instant Petition.

C. Other Considerations of the Holistic Record

1. Judicial Economy and Efficiency Support Denial

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

Amazon prioritized district court proceedings over IPR proceedings. It kept the patentee’s case from moving forward, waited for Google to file IPRs on two of the three asserted patents, and then it pivoted to filing IPRs at the last possible instant after it did not obtain a favorable resolution on its motion to dismiss. In

other words, its approach *avoids* a speedy, just, and efficient resolution and gives it a strategic advantage. It directly contravenes the purpose of IPRs. *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."). As explained below, a number of factors demonstrate why denial is justified under such circumstances.

2. *Fintiv* Factor 2 Strongly Favors Denial – The District Court Trial Would Conclude Nearly a Year Before FWD for this IPR is Due

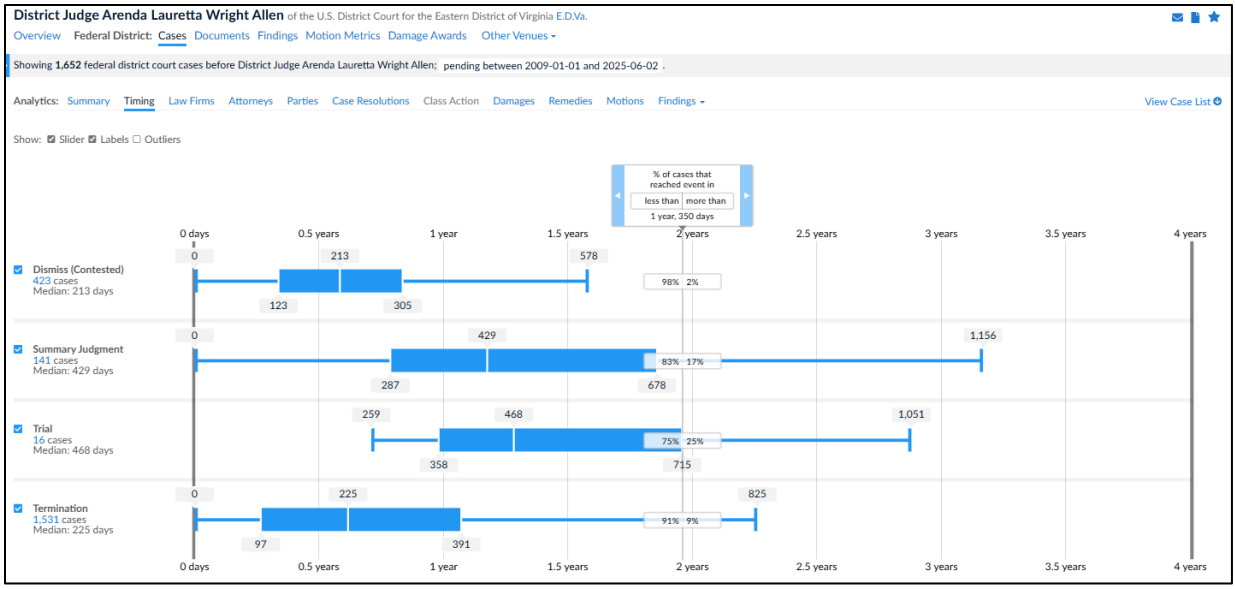
According to *Fintiv*, "[i]f the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution." *Fintiv*, IPR2020-00019, Paper 11, 9. The Board has invited consideration of median time-to-trial statistics in making that determination. Mar. 24, 2025 Boalick Memo, 3. It does so even when "there is no currently scheduled trial date in the co-pending district court litigation." *See, e.g.*, *Google LLC v. Brodti Inc.*, IPR2025-00472, Paper 19, 2 (Director June 25, 2025); *Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 18, 2 (Director May 16, 2025).

Here, the Final Written Decision will not be due until November 2026. The district court case will proceed much faster than that. The median statistics indicate that trial would proceed as soon as December 2025. The specific circumstances of the underlying case may push that date back a little bit, and diverge from the median statistics, but not by much. After all, the median statistics are what they are because the Eastern District of Virginia quickly readies cases for trial.

Specifically, the district court case was filed on May 1, 2024. A stay was implemented on July 1, 2025.[13] The deadline to rule on SoundClear's discretionary denial request is October 24, 2025.

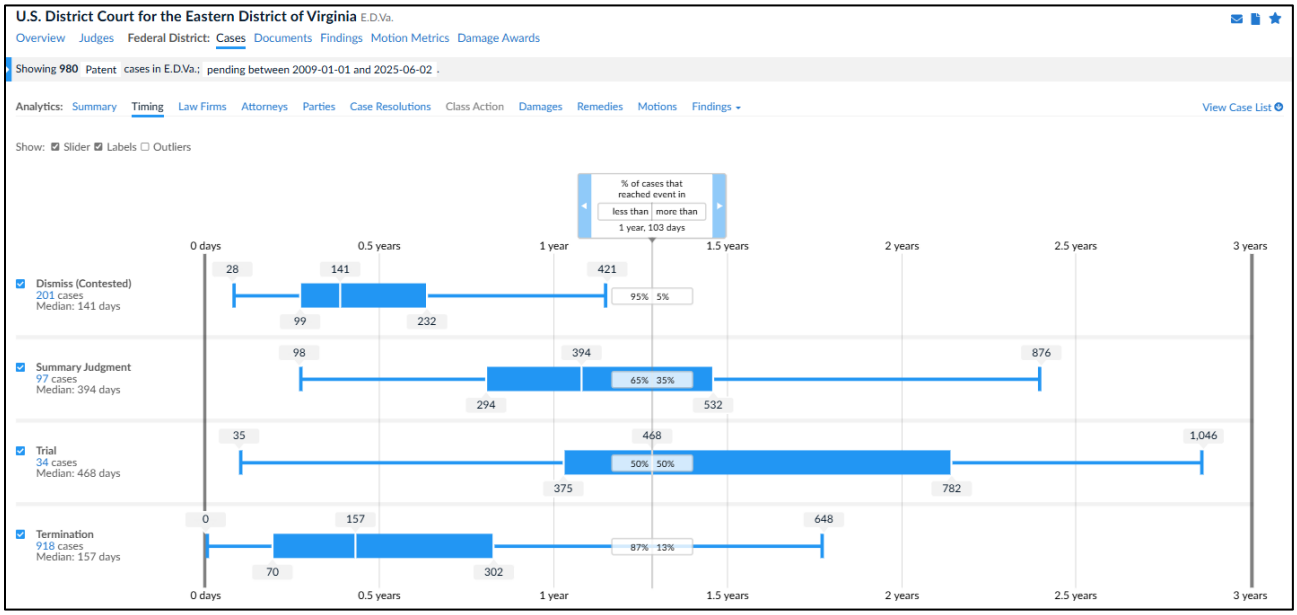
Judge Wright Allen has presided over 16 trials. For those trials, the median time-to-trial was 468 days—or 15.4 months:

[13] SoundClear did not contest Amazon's motion for a stay solely because a prior court ruled in Google's favor, over SoundClear's opposition, in a case involving the same patents.



EX-2002.

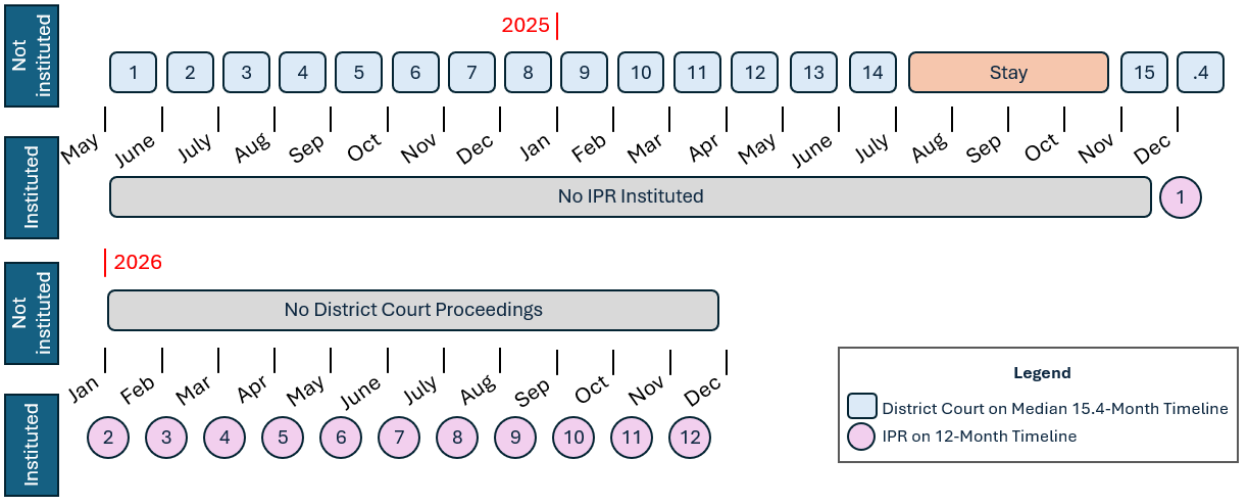
Judge Wright Allen's median time-to-trial statistics align with those of the patent cases in the Eastern District of Virginia, which also had a median time-to-trial of 468 days:



EX-2005.

Thus, if institution of this IPR is denied here in October 2025, median statistics indicate that the Amazon district court case could proceed to trial as early as December 2025 (assuming the case proceeds on the timeline discussed above), or as early as January 2026 (if it proceeds in parallel with the Google case).

The applicable comparison, then, is the expected time-to-trial (in district court) to the expected time-to-resolution (in IPR) in alternate scenarios: (1) if IPR is instituted in November 2025 and (2) if institution is discretionarily denied in October 2025. The following visual demonstrates the two potential outcomes. Each blue block represents one month of the 15.4-month median time-to-trial; each pink circle, one month of IPR:



As shown above, the district court trial could begin as early as December 2025 or January 2026. And a final written decision would not issue until almost December 2026.

Notably, the Board considered a similar timeline when discretionarily denying Google's IPRs. The median statistics indicate that the present case may proceed to trial quicker. But, at minimum, this case would not be expected to proceed to trial any slower than the underlying Google case. Thus that decision, and the basis, supports denial of this petition by Amazon.

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

3. 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 Amazon case that is still pending in the Eastern District of Virginia, it will likely needlessly delay the resolution of

SoundClear's Google case—which is also pending in the EDVA—by two or three years.[14]

The Google case is ready to proceed right now, particularly in view of the recent discretionary denial of Google's petitions. The Amazon case is also ready to proceed.

4. *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 now calls on the Board as its second recourse. And it does so by raising only some of its invalidity arguments (as discussed *infra* for *Fintiv* Factor 4). Those grounds are far down Amazon's list of the substantive merits to address.

Amazon proceeded in the district court case as follows:

June 24, 2024	Amazon sought an extension of time to answer complaint.
Aug. 26, 2024	Amazon did not answer any count. Amazon moved to dismiss on two fact-specific grounds: ▪ Ineligible subject matter ('374 patent) ▪ Non-infringement ('819 patent) (*with prejudice*)

[14] 12-18 months for the Final Written Decision plus 12-19 months for appeal (EX-2007).

Dkts. 30-31.

Apr. 7, 2025 — Amazon filed a motion to stay pending resolution of Google's IPR petitions. Dkts. 49-50.

Apr. 14, 2025 — Amazon filed an Answer to SoundClear's Complaint. EX-2004.

In short, Amazon delayed their response time and then sought a *with-prejudice* ruling on fact-specific, dispositive issues. It only filed IPR petitions several months after Google filed earlier petitions, and only after receiving an unfavorable result on its motion to dismiss. Even then, Amazon's petitions were filed only a few days before its statutory deadline of June 3, 2025.

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.[15]

The Director can ensure IPR proceedings serve their intended purpose by considering petitioners' choices in related proceedings when exercising her discretion to deny institution. At some point, petitioners should have to make some choices. Choose to litigate fact-laden, dispositive issues before the district court or

[15] *See supra*.

proceed first to the Board.[16] Choose to proceed under plain-and-ordinary meaning or disclose, and commit to, consistent claim construction positions.

In short, if Amazon were committed to addressing obviousness as a priority, it would have filed its own IPR petitions earlier. 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 claim construction positions in both proceedings.

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

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

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

Amazon's petition does not seek to construe any terms before the Board.[17] But it included an express qualification for the purpose of allowing it to seek different, narrowing constructions before the district court: "No claim terms require construction to resolve the invalidity challenges here." Pet., 10. The "here" qualification means that Amazon believes it can argue that it can seek to construe the terms when it comes time in the district court to apply them to the accused products/services. Petitioners often attempt this gambit by citing to inapplicable cases such as *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). Amazon will not deny, in its response brief, that the quoted language above confirms its noncommittal position.

Indeed, Amazon has a roadmap for this approach. In the district court Google case, Google admitted that it will seek to engage in "time consuming claim construction" in the district court. EX-2006, 1; *see also id.* ("claim construction has not happened *yet*." (emphasis added). Google's prior petition in IPR2025-00345

[17] The Petition does not seek a formal construction for any claim term. *See* Pet., 10.

clarifies what it means with careful wording: "[Google] may raise indefiniteness and/or claim constructions in other forums." IPR2025-00345, Paper 1, n. 4.

Like Google, Amazon plans to take diametrically opposite claim construction approaches before the PTAB and the district court to attain an unfair strategic advantage. If the Board grants institution, Amazon will get the chance to argue validity under broad claim constructions at the Board[18] while preserving its ability to argue non-infringement under narrow constructions[19] at a later date. There is no mechanism—akin to a *Sotera* stipulation—to prevent it.

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[18] *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").

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

Amazon's approach is also wrong under the law. Claims must be interpreted the same for invalidity and infringement: "It is axiomatic that claims are construed the same way for both invalidity and infringement." *Amgen Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir. 1988)). "A patent may not, like a nose of wax, be twisted one way to avoid anticipation and another to find infringement." *Amazon.com, Inc. v. Barnesandnoble.com*, *Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (citing, among others, *White v. Dunbar*, 119 U.S. 47, 51 (1886)).

The Board's FAQ 11 expressly also 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.

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 in the district court will be.

Second, the petitioner did not seek to take inconsistent positions before two adjudicative bodies. It submitted alternative positions, in the same proceeding, to the same body (the Board). 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 may introduce extrinsic evidence supporting its claim construction positions in the district court. That evidence will not be available in the IPR proceedings.

Fourth, in *10x Genomics,* the petitioner had proposed a narrowing construction, which would have guaranteed a consistent record. *Id.*, 11-12. It thus presented a more conservative position on invalidity. The petitioner only presented the broader, alternative grounds, in response to the *patent owner's* broader construction. *Id.*, 12. In short, the petitioner presented the Board with two options,

(1) address invalidity under a narrow construction, which would have made petitioner's position more difficult or (2) proceed under a construction the patentee proposed, which the patentee would not be able to disavow in any later proceeding. Amazon's approach is the exact opposite in every respect.

The *Nidec* and *Vivid Technologies* cases on which Amazon relies are inapplicable. Pet., 10.

First and foremost, if there were a rule of law allowing a party to orchestrate proceedings for the purpose of taking divergent positions, it would be plainly stated. That is not the type of gambit that would be incidentally countenanced; such as, for example, when reviewing results in hindsight on appeal (*Nidec)*, or when determining, after *all* issues have been put on the table, whether claim construction is needed (*Vivid Technologies*).

The law set forth in *Amgen* and *White* is clear. Neither *Nidec* nor *Vivid Technologies* changes it. The *Nidec* court and Board analyzed proposed constructions in hindsight—at the end of the case. They determined, *post hoc*, that the parties' disagreement on a proposed construction/interpretation had no bearing on the court's determination. *Nidec*, 868 F.3d at 1017 ("Whether or not Nidec is correct, the result does not change."). *Nidec* did not address—let alone countenance—issuing final rulings on one dispositive issue before conducting claim construction to decide another dispositive issue. And it certainly did not

address whether a party engaged in litigation with an affirmative plan to benefit from taking inconsistent positions.

The *Vivid Technologies* court simply determined that there is no set rule as to when claims construction should occur during a 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.

Further, the *Vivid Technologies* court did identify 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. *Id.*; *see also Markman v. Westview Instruments*, 517 U.S. 370, 384 (1996); *In re Aoyama*, 656 F.3d 1293, 1296 (Fed. Cir. 2011). Second, it 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) (citation modified). Amazon's approach contradicts both.

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

6. Amazon Improperly Seeks an Advisory Opinion

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

For example, consider if 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 than[20]—but at least different from—the plain and ordinary meaning. In that instance, the operability of the Board's decision would all of a sudden stand in conflict with the ruling of an Article III court. *Cf. Samsung Electronics America, Inc. v. Uniloc*, 2017 LLC, IPR2020-00046, Paper 6, 7-8 (PTAB Apr. 1, 2020) (declining to issue "advisory opinion").

7. The District Court's Discovery Mechanisms and Jury Are Required

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

[20] *See* notes 17-18 *supra*.

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 will likely rely on product prior art before the district court. Whether and to what extent those overlap with the prior art it identified in its Petition remains to be seen.

Testimony of all six named inventors of the patents-in-suit in the Amazon case may be material and relevant, because it relates to issues of validity and infringement. All six inventors reside in Japan. *See, e.g.,* EX-1001 ("Inventor"). That will necessitate overseas discovery (e.g., via Letters Rogatory), which the PTAB cannot provide. Amazon may also seek important testimony from other individual and corporate witnesses in connection with validity issues. That would require discovery into JVC Kenwood Corporation, their employer, which is famous for having innovated in these areas.

It would be highly prejudicial to SoundClear for Amazon to seek out a forum to address an issue (e.g., invalidity at the PTAB) where that certain third-party discovery related to that issue 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 the fact that discovery of all six inventors is needed to address validity, which only the district court can provide.

8. The Additional *Fintiv* Factors Favor Discretionary Denial

The other *Fintiv* factors favor discretionary denial or should be neutral.

a) *Fintiv* Factor 1 Favors Discretionary Denial

The district court stayed the Amazon case based on the IPR petitions that were filed by Google against two of the three patents (IPR2025-00344 and IPR2025-00345) and the district court's stay of the Google case pending resolution of those IPRs. Indeed, at the time Amazon moved the district court to stay its case, it had not filed IPR petitions against any of the three patents-in-suit. However, as mentioned above, the Board discretionarily denied Google's petitions on August 4, 2025. Thus, SoundClear expects the stay to be lifted in each of the Amazon case and Google case very shortly. For this reason, Factor 1 favors discretionary denial.

Alternatively, Factor 1 is at the very least neutral. The stay in the Google case (upon which the stay in the Amazon case is based) was granted 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 district court in the Google case. *See* EX-2003, Dkts.

73 (Feb. 18, 2025) to 80 (Mar. 10, 2025). Since institution has been denied for the Google IPR petitions, the stay in the Google case will be lifted, and that case will proceed to trial in the district court as early as January 2026. Even if the stay in the Amazon case is not immediately lifted due to its dependence on the stay in the Google case, the stay would certainly be lifted in the Amazon case if institution is denied for Amazon's instant petitions. SoundClear expects that the Amazon case would then proceed to trial in the district court as early as December 2025.

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, n. 5 (Director 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.

b) *Fintiv* Factor 3, Under the New Guidance, Should Favor Denial

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

In this instance, Amazon's filings ensured that SoundClear's district court case never got off the ground. Additionally, Amazon has ensured that the court's investment related solely to issues that might benefit Amazon. SoundClear, by contrast, has not even been able to begin discovery.

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

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

In both district court cases, Amazon and Google respectively filed a motion to dismiss on § 101 and non-infringement grounds. Those issues were fully briefed. EX-2003, Dkts. 13-54; EX-2004, Dkts. 30-34.

In addition, Google filed a motion to transfer the district court case to the Northern District of California. Google even submitted fact and lay opinion testimony of three of its own witnesses in support of its motion to transfer. SoundClear attempted to conduct limited discovery into the basis for such opinions. But Google refused at every turn. That necessitated a motion and briefing. SoundClear's reply in support of its objections to the magistrate judge's ruling on that issue was pending when the stay was implemented. EX-2003, Dkts. 73 and 80.

Because Amazon and Google both chose to file its motion to stay pending IPR until after briefing and hearing for these fact-specific motions were completed

(and in Google's district court case, until after the court has ruled on Amazon's motion to dismiss), the district court expended considerable time and resources on the parallel proceedings. Indeed, Amazon did not even file its IPR petitions until after that hearing. Those circumstances weigh in favor of discretionary denial. *See 10X Genomics, Inc. v. President and Fellows of Harvard College*, IPR2023-01299, Paper 15, 18 (PTAB Mar. 7, 2024) (noting that the district court's consideration of two motions to dismiss and several discovery disputes, among other things, evince investment of "significant amount of time and resources to the parallel proceeding").

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

Here, if Amazon and Google were committed to addressing obviousness as a priority with efficiency and judicial resources in mind, they would have filed IPR petitions, and sought to stay their respective district court proceedings, *before* raising fact-intensive arguments (*e.g.*, *Alice* and non-infringement). In view of the

resource expenditure necessitated by Amazon and Google's coordinated, one-sided litigation strategy, *Fintiv* Factor 3 should weigh in favor of discretionary denial.

c) *Fintiv* Factor 4 Favors Denial or Should Otherwise be Given Little Weight

Amazon has not filed a *Sotera* or *Sand* stipulation in the district court case. The lack of *Sotera* or *Sand* stipulation in the district court cases raises "concerns of inefficiency and the possibility of conflicting decision" between the district court and the Board. *Fintiv*, Paper 11, 12; *see also*, *e.g.*, *Phison Elecs. Corp. v. Vervain, LLC*, IPR2025-00212, Paper 10, 13 (PTAB May 28, 2025) ("Given that both proceedings involve claim 1 of the '298 patent and the same invalidity challenges, in addition to the lack of any [*Sotera*] stipulation to avoid duplicative efforts and conflicting decisions, we determine that this factor weighs in favor of discretionary denial."). Further, Google also did not to provide any such stipulation.

That, along with Amazon and Google's strategy of inconsistent claim construction positions, evinces an intent to evade finality.

Moreover, FAQ 14 instructs petitioners to "file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief." Thus, the Director should disregard any subsequently filed stipulation as untimely.

In the Google case, even if it had timely filed a *Sotera* or *Sand* stipulation, such stipulation would not be "particularly meaningful" given Google's statement

that it *will* rely on system prior art regardless of the outcome of the IPR. FAQ 14; *see Motorola*, IPR2024-01205, Paper 19, 4 (denying institution despite *Sotera* stipulation; explaining that "Petitioner's invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot.")

For example, Google identified at least one piece of product/system prior art "that it believes will be highly relevant and material to this case." *See* EX-2001, 15 (identifying "telecommunication and conferencing produces provided by Poly Inc."). And Google stated that multiple "witnesses" will have to be deposed. *Id.* That was before discovery even opened. Thus, Google clearly intends to assert additional product prior art in connection with each patent. *Id.* ("This prior art system is directly relevant to the material issue of invalidity"). It will not deny that it will seek to avoid estoppel of other prior art grounds when the case returns to the district court.

Given Amazon's approach in this case of following Google's lead, SoundClear anticipates that Amazon will rely on the same or similar product/system prior art in its case that Google identifies. Nothing would prevent Amazon from doing so.

Amazon's IPR Petition does state "[i]f this IPR is instituted and the above proceeding is not stayed, Petitioners hereby stipulate not to pursue in that proceeding any ground of invalidity, against any claim challenged herein, that was raised or reasonably could have been raised in this Petition." Pet., 80. However, tellingly, Amazon does not characterize this as a full-throated *Sotera* or *Sand* stipulation. And not because Amazon does not know how to provide a more thorough stipulation. *See, e.g.*, *Amazon.com, Inc., et al. v. SoundClear Techs. LLC*, IPR2025-00565, Paper 1, 69. As such, for the reasons stated above, Amazon's statement is ineffective in this case.[21] Thus, to the extent the Board awards it any weight, it should be minimal.

Thus, *Fintiv* factor 4 favors discretionary denial, or at least should be given little weight.

[21] SoundClear further notes that Amazon's statement is improperly included in the "Related Matters" sub-section of the Mandatory Notices section of its Petition. This appears to be an attempt to circumvent the Board's rules regarding word limits in petitions. *See* November 2019 TPG at 39 ("Page and word count limits do not include … mandatory notices under 37 C.F.R. § 42.8 …").

d) *Fintiv* Factor 5 Favors Denial – The Parties Are the Same

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

Thus, *Fintiv* factor 5 favors discretionary denial.

e) *Fintiv* Factor 6 — Amazon's Invalidity Grounds Are Weak

Factor 6 favors denial all by itself. The Board's new discretionary denial policies suggest, Factor 6 carries as much weight as the circumstances of the petition demand. As detailed below, the circumstances relevant to Factor 6 underscore the weakness of the Petition. Thus, Factor 6 weighs heavily against institution.

i. Amazon's Prior Art is Deficient

Amazon's Petition fails for a number of technical reasons. But, in some sense they all derive from the fact that the prior art references fail to disclose the claimed subject matter. SoundClear expects to address the merits of these technical

deficiencies in more detail in its preliminary response and/or post-institution response.

ii. Confluence of Expert Testimony and Attorney Argument

Amazon's Petition heavily relies entirely on mirrored statements of its attorneys and expert. Its declaration should thus be given little or no weight. *See Xerox Corp. v. Bytemark, Inc*., IPR2022-00624, Paper 9, 15-17 (PTAB Aug. 24, 2022) (designated precedential) (according "little weight" to declaration testimony that contains a verbatim restatement of a petition's conclusory assertions without additional supporting evidence or reasoning); *Facebook, Inc. v. Windy City Innovations*, LLC, 973 F.3d 1321, 1340-41 (Fed. Cir. 2020) (affirming Board decision giving no weight to expert testimony that "merely repeated Petitioner's argument, nearly verbatim, without citation to the basis for his testimony").

Amazon's Ground 1 arguments demonstrate this. For at least claim 1, nearly every paragraph in the declaration mirrors an argument paragraph in the Petition. *Compare, e.g.*, Pet., 10-19 *with* EX-1002, ¶¶44-66. In the rare instances where there is some difference, they are superficial. *Compare, e.g.*, Pet., 18 ("A POSITA") *with* EX-1002, ¶61 ("A person of ordinary skill"). Certain statements are also grouped together in the declaration and separated in the Petition. *Compare, e.g.*, Pet., 13 (starting the paragraph with "Chen discloses or renders obvious this limitation") *with* EX-1002, ¶47 (ending the paragraph with "Chen discloses or

renders obvious this claim element"). But a review of the written statements in each document demonstrates that the declaration statements are virtually a carbon copy of the Petition arguments.

Further, the Petition thus reduces to pure, conclusory attorney argument as to important claim limitations. *See, e.g.*, Pet., 17 (citing EX-1002, ¶58); *see also, e.g.*, Pet., 18 (citing EX-1002, ¶59). The expert/attorney statements are conclusory and unsupported. They do not rely on any express disclosure. Nor do they argue that the corresponding elements are inherent in either reference. Thus, the Petition fails for those reasons alone.

iii. FAQ 21 — Extensive Reliance on Expert Testimony

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

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

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

The Petition relies heavily on the expert/declaration and attorney argument instead of express disclosures. *See generally*, Pet.

The nature and extent of those failings will be issues for a jury.

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.

In view of the foregoing, the *Fintiv* factors support discretionary denial.

9. The Petition Gives Insufficient Notice of Amazon's Unpatentability Grounds

Amazon conflates obviousness and anticipation. Those 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[s] or render[s] obvious." *See, e.g.*, Pet., 26-27; EX-1002, ¶¶86-88, 90. 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-reference[22] 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.

[22] *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").

10. The Petition is Not Presented "[W]ith [P]articularity," As Required by the Statute.

It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify 'with particularity' the 'evidence that supports the grounds for the challenge to each claim.'" *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016); 35 U.S.C. § 312(a)(3). Amazon has not done so here, and the Board, thus, should not waste its limited resources instituting trial.

Most egregiously, Amazon has not even attempted to make the required minimum showing *in the Petition* that certain asserted references—Kim (EX-1006) and Brandstein (EX-1011)—are prior art printed publications. This is particularly remarkable in that those references are relied upon in at least seven of the asserted grounds. *See* Pet., 7-8. Board precedent requires that a petitioner establish a reasonable likelihood *in the petition* that a reference is a printed publication. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, 13 (PTAB Dec. 20, 2019) (precedential). Amazon has not met that burden here. Amazon provides *no* discussion supporting the alleged publication dates of these references, Pet., 7-9, nor does Amazon "discuss in the Petition *any* evidence supporting the implicit position that the[se] [references] w[ere] *publicly accessible* prior to the critical date of the claimed invention." *BabyBjörn AB v. The ERGO Baby Carrier, Inc.*, IPR2025-00110, Paper 20, 14 (PTAB Apr. 22, 2025) (underlining added, other

emphasis original). In *BabyBjörn*, as here, the petitioner submitted a declaration allegedly supporting the publication date and public accessibility of the reference at issue. *Id.*, 14. The Board declined to "search through the record to develop [p]etitioner's arguments on th[e] issue." *Id.* (citing *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) ("Judges are not like pigs, hunting for truffles buried in briefs.") (quoting *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991)).

The *only* evidence cited (without any discussion) by Amazon in support of the publication dates is a bare citation of "EX-1021." Pet., 9. Exhibit 1021, however, is a 28-page declaration from Sylvia D. Hall-Ellis, Ph.D. Not only does citing to the *entire declaration* with no accompanying explanation fall short of the requirement that "the petition identifies [the supporting evidence], in writing and *with particularity*," 35 U.S.C. § 312(a)(3) (emphasis added), it also runs afoul of Rule 42.6(a)(3), which provides that "[a]rguments must not be incorporated by reference from one document into another document." *See also Intelligent Bio-Sys., Inc.*, 821 F.3d at 1369 ("It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify 'with particularity' the 'evidence that supports the grounds for the challenge to each claim.'" (quoting 35 U.S.C. § 312(a)(3))).

The Board should not consider Dr. Hall-Ellis's testimony because the Petition includes no explanation of such testimony. *See* 37 C.F.R. § 42.104(b)(5) ("The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge."); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide, 35–36 (Nov. 2019) ("CTPG") (citing *Cisco Systems, Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014) (informative)) ("[P]arties that incorporate expert testimony by reference in their petitions . . . without providing explanation of such testimony risk having the testimony not considered by the Board."). Amazon simply has not met its burden under *Hulu* to show *in the Petition* a reasonable likelihood that these references are prior art printed publications. *See VMware, Inc. v. WSOU Investments, LLC*, IPR2021-00572, Paper 8, 49-50 (PTAB Sept. 7, 2021) (determining that petitioner's general cites to a declaration without identifying any specific portions thereof was insufficient to meet petitioner's burden under *Hulu* that a prior art reference qualified as a printed publication, and that it amounted to an improper attempt to incorporate the testimony by reference).

11. Failure to Establish a Prima Facie Case under *Graham*

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. Despite basing each ground of the Petition on obviousness under §103, Amazon mentions *Graham* factor 2 only three times. *See* Pet., 16, 47, 68. It merely provides boilerplate recitations in support of factor one. And then it proceeds to simply identify alternative disclosures for each limitation. *See, e.g.*, *id.*, 20-23, 40-41. 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).[23]

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). The Petition is rife with examples of *Graham* factor 2 omissions. *See* Pet., *generally*. Indeed, it completely 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*.[24]

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[23] *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).

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

The Petition's failure to fully address the *Graham* factors 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.* (citation modified); *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 some version of the words "predictable," "reasonably expected success," or "improve." 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, nearly all motivations to combine in the Petition that are based on reasonable success are coupled with the conclusory statement that making the proposed combination would have been "trivial" or "routine[]." Aside from these generalized and conclusory statements, neither the Petition nor declaration articulates bases for why such a combination or modifications of the references

would have been trivial or routine. Such unsupported reasoning is insufficient under *Graham*.

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

Here, the Petition provides even less than the two insufficient pieces above. It addresses (1) but not (2). *See* Pet., 9 ("at least a bachelor's degree in electrical engineering, computer engineering, computer science, or a similar field, and at least three years of industry or academic experience in the design, development, and/or implementation of microphone arrays and/or speech signal processing.").

V. CONCLUSION

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

Dated: August 25, 2025

Respectfully submitted,

By: /Steven J. Reynolds/

Steven J. Reynolds (USPTO Reg. No. 61,445)*
Kevin H. Sprenger (USPTO Reg. No. 79,466)
Chandran B. Iyer (USPTO Reg. No. 48,434)
Erin Hadi (USPTO Reg. No. 79,904)*
Louay Meroueh (USPTO Reg. No. 81,304)*
sreynolds@daignaultiyer.com
ksprenger@daignaultiyer.com
cbiyer@daignaultiyer.com
ehadi@daignaultiyer.com
lmeroueh@daignaultiyer.com
DAIGNAULT IYER LLP
8229 Boone Boulevard
Suite 450
Vienna, VA 22182
**Not admitted in Virginia*

Attorneys for SoundClear Technologies LLC

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 limitation s of 37 C.F.R. §§ 42.24(b)(1) because it contains 12,700 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: August 25, 2025

Respectfully Submitted,

By: /Steven J. Reynolds/
Steven J. Reynolds
USPTO Reg. No. 61,445

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 9,031,259 was served electronically via email on August 25, 2025, on the following counsel of record for Petitioner:

Colin B. Heideman
Joseph R. Re
Jeremy A. Anapol
Christie R.W. Matthaei
Nathan D. Reeves
Logan P. Young
KNOBBE, MARTENS, OLSON, & BEAR, LLP
2cbh@knobbe.com
2jrr@knobbe.com
2jaa@knobbe.com
2crw@knobbe.com
2ndr@knobbe.com
2lpy@knobbe.com
BoxSEAZN2L2103LP1@knobbe.com

Dated: August 25, 2025

Respectfully Submitted,

By: /Steven J. Reynolds/
Steven J. Reynolds
USPTO Reg. No. 61,445