

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner

v.

SOUNDCLEAR TECHNOLOGIES LLC,  
Patent Owner

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U.S. Patent No. 11,244,675  
Issue Date: February 8, 2022

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

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*Inter Partes* Review No. IPR2025-01177

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**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**

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                     |
|--------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2001               | Webpage of JVC Kenwood Corporate History, available at <a href="https://www.jvckenwood.com/en/corporate/history/">https://www.jvckenwood.com/en/corporate/history/</a> |
| 2002               | Webpage of JVC Kenwood Amateur Radio, available at <a href="https://www.kenwood.com/usa/com/amateur/">https://www.kenwood.com/usa/com/amateur/</a>                     |
| 2003               | Webpage of JVC Kenwood USA, available at <a href="https://www.jvc.com/usa/">https://www.jvc.com/usa/</a>                                                               |
| 2004               | Docket Printout of <i>SoundClear Techs. LLC v. Google LLC</i> , Case No. 2:24-cv-00321 (EDVA) (“-321 case”)                                                            |
| 2005               | Docket Printout of <i>SoundClear Techs. LLC v. Amazon.com, Inc. et al.</i> , Case No. 2:24-cv-00320 (EDVA) (“-320 case”)                                               |
| 2006               | Memorandum in Support of Google LLC’s Partial Motion to Dismiss Plaintiff’s Complaint Under Rule 12(b)(6) (-321 case, Dkt. 14)                                         |
| 2007               | Memorandum in Support of Amazon’s Motion to Dismiss Plaintiff’s Complaint Under Rule 12(b)(6) (-320 case, Dkt. 31)                                                     |
| 2008               | Docket Printout of <i>SoundClear Techs. LLC v. Amazon.com, Inc. et al.</i> , Case No. 1:24-cv-01283 (EDVA) (“-1283 case”)                                              |
| 2009               | Docket Printout of <i>SoundClear Techs. LLC v. Google LLC</i> , Case No. 3:24-cv-00540 (EDVA) (“-540 case”)                                                            |
| 2010               | Memorandum of Law in Support of Google LLC’s Motion to Dismiss Plaintiff’s Complaint Under Rule 12(B)(6) (-540 case, Dkt. 17)                                          |
| 2011               | Memorandum in Support of Defendant’s Motion to Dismiss Under Rule 12(b)(6) (-1283 case, Dkt. 32)                                                                       |
| 2012               | Memorandum of Law in Support of Defendant Google LLC’s Unopposed Motion to Stay Pending <i>Inter Partes</i> Review (-540 case, Dkt. 48)                                |

|      |                                                                                                                                                 |
|------|-------------------------------------------------------------------------------------------------------------------------------------------------|
| 2013 | Declaration of Joshua Yin in Support of Defendant Google LLC's Unopposed Motion to Stay Pending <i>Inter Partes</i> Review (-540 case, Dkt. 49) |
| 2014 | Memorandum in Support of Defendants' Motion to Stay Pending <i>Inter Partes</i> Review (-320 case, Dkt. 50)                                     |
| 2015 | Amazon's Preliminary Invalidity Contentions, dated March 12, 2025 (-1283 case)                                                                  |
| 2016 | USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 15/611,228, dated June 1, 2018.                           |
| 2017 | U.S. Patent No. 10,418,033                                                                                                                      |
| 2018 | U.S. Patent No. 11,705,108                                                                                                                      |
| 2019 | U.S. Patent No. 11,531,736                                                                                                                      |
| 2020 | U.S. Patent No. 11,393,471                                                                                                                      |
| 2021 | U.S. Patent No. 12,002,469                                                                                                                      |
| 2022 | U.S. Patent No. 11,783,833                                                                                                                      |
| 2023 | U.S. Patent No. 10,943,583                                                                                                                      |
| 2024 | U.S. Patent No. 11,562,739                                                                                                                      |
| 2025 | U.S. Patent No. 10,600,408                                                                                                                      |
| 2026 | USPTO Notice of Allowance and List of References Cited by Examiner for U.S. Application No. 14/096,623, dated July 27, 2017.                    |
| 2027 | U.S. Patent No. 9,830,924                                                                                                                       |
| 2028 | U.S. Patent No. 10,276,149                                                                                                                      |
| 2029 | Defendant Google LLC's Unopposed Motion To Stay Pending <i>Inter Partes</i> Review (-540 case, Dkt. 47)                                         |
| 2030 | USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 15/386,333, dated July 30, 2018.                          |

|      |                                                                                                                       |
|------|-----------------------------------------------------------------------------------------------------------------------|
| 2031 | USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 15/278,735, dated May 17, 2018. |
| 2032 | U.S. Patent No. 10,223,356                                                                                            |
| 2033 | U.S. Patent No. 10,261,995                                                                                            |
| 2034 | U.S. Patent No. 10,229,113                                                                                            |
| 2035 | U.S. Patent No. 10,235,362                                                                                            |
| 2036 | U.S. Patent No. 10,275,459                                                                                            |
| 2037 | Request for Continued Examination and IDS for U.S. Application No. 13/478,998 dated February 22, 2018.                |
| 2038 | U.S. Patent No. 10,152,723                                                                                            |

Patent Owner SoundClear Technologies LLC (“SoundClear”) submits this Request for Discretionary Denial brief respectfully requesting that the Director deny institution of the Petition for *Inter Partes* Review (“Petition”) filed by Google LLC (“Google”) challenging claims 1-7 (“the challenged claims”) of U.S. Patent No. 11,244,675 (“’675 patent,” EX-1001).

## **I. INTRODUCTION**

Discretionary denial is appropriate here at least because SoundClear has settled expectations in the ’675 patent in view of recent case law, and Google’s instant Petition is a follow-on to Amazon’s earlier petition in IPR2025-00673. The ’675 patent has been in force over three years and is involved in an action involving one patent that has been in force much longer (nearly 10 years). Under recent case law, that creates settled expectations sufficient to support discretionary denial. Further, while the petition in IPR2025-00673 was not filed by Google, discretionary denial of this Petition is appropriate under the *General Plastic* factors because Google and Amazon have a significant relationship and all such factors support denial.

Several other factors also support discretionary denial. First, no Sotera/Sand stipulation was filed, and the district court case will address system prior art already identified. Second, the Petition conflates attorney argument with expert testimony. Third, letters rogatory discovery mechanisms will be required. Fourth,

the Petition fails to articulate a proper obviousness analysis under *Graham*. Finally, the prior art fails to disclose the claimed subject matter.

## II. SUMMARY OF PARALLEL PROCEEDINGS AND RELATED LITIGATIONS

| Case Name                                               | Case Number                                          | Patents Involved                      |
|---------------------------------------------------------|------------------------------------------------------|---------------------------------------|
| <i>SoundClear Techs. LLC v. Amazon.com, Inc. et al.</i> | 2:24-cv-00320 (E.D. Va.)<br>("SoundClear-320 Case")  | 9,031,259<br>9,070,374<br>9,804,819   |
| <i>SoundClear Techs. LLC v. Google LLC</i>              | 2:24-cv-00321 (E.D. Va.)<br>("SoundClear-321 Case")  | 9,031,259<br>9,070,374<br>9,804,819   |
| <i>SoundClear Techs. LLC v. Amazon.com, Inc. et al.</i> | 1:24-cv-01283 (E.D. Va.)<br>("SoundClear-1283 Case") | 11,069,337<br>11,244,675<br>9,223,487 |
| <i>SoundClear Techs. LLC v. Google LLC</i>              | 3:24-cv-00540 (E.D. Va.)<br>("SoundClear-540 Case")  | 11,069,337<br>11,244,675<br>9,223,487 |
| <i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i> | IPR2025-00565                                        | 11,069,337                            |
| <i>Google LLC v. SoundClear Techs. LLC</i>              | IPR2025-00344                                        | 9,070,374                             |
| <i>Google LLC v. SoundClear Techs. LLC</i>              | IPR2025-00345                                        | 9,031,259                             |
| <i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i> | IPR2025-00673                                        | 11,244,675                            |
| <i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i> | IPR2025-01067                                        | 9,070,374                             |
| <i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i> | IPR2025-01080                                        | 9,804,819                             |
| <i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i> | IPR2025-01096                                        | 9,031,259                             |
| <i>Google LLC v. SoundClear Techs. LLC</i>              | IPR2025-01123                                        | 11,069,337                            |
| <i>Google LLC v. SoundClear Techs. LLC</i>              | IPR2025-01177                                        | 11,244,675                            |
| <i>Amazon.com, Inc. et al. v. SoundClear Techs. LLC</i> | IPR2025-01368                                        | 9,223,487                             |

In this brief, the SoundClear-320 Case and SoundClear-321 Case are collectively referred to as the “SoundClear I Cases.” The SoundClear-1283 Case and SoundClear-540 Case are collectively referred to as the “SoundClear II Cases.”

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

The Morgan Stewart Memo permits the Director to consider existing precedent under *General Plastic* and other factors and guidance. Morgan Stewart Memo, 2 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*,

IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential)).

But the Morgan Stewart Memo goes further. It advises parties to address all relevant considerations, which may include the “[s]ettled expectations of the parties, such as the length of time the claims have been in force...,” the “extent of the petition’s reliance on expert testimony, ” and “any *other* considerations bearing on the Director’s discretion.” Morgan Stewart Memo, 2-3 (emphasis added).

#### **B. *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. SoundClear’s Settled Expectations in the ’675 Patent Support Discretionary Denial**

Although IPR2025-00673 against the ’675 patent was recently referred to the Board, SoundClear has settled expectations in the ’675 patent in view of recent case law. *See Samsung Elecs. Co. Ltd. et al. v. GenghisComm Holdings LLC*, IPR2025-00788, Paper 11, 2 (PTAB Aug. 22, 2025) (finding that a patent in force for *three* years supported discretionary denial); *see also Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (Director June 18, 2025); *Coretronic Corp. v. Maxell, Ltd.*, IPR2025-00474, 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 Optoelects., 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*). Further, actual notice of a patent is not required for settled expectations. *Dabico*, Paper 21, 3.

The '675 patent issued on February 8, 2022. As such the patent has been in force for over three years, and another patent at issue has been in force much longer. That is sufficient to create settled expectations. The '487 patent has been in force for nearly ten years (it issued on December 29, 2015). And the '337 patent has been in force for over four years (it issued on July 20, 2021). All patents were assigned to JVC Kenwood, which has been active in the electronic communication field. EX-2001; EX-2002; EX-2003. Discretionary denial is appropriate where a patent is asserted in a district court case with another patent having strong settled expectations. *See Samsung*, IPR2025-00788, Paper 11, 2. In such scenarios, for discretionary denial purposes, the Board should consider IPRs filed against multiple patents asserted in the same district court litigation to be filed at the same time. That approach would prevent gamesmanship of petitioners filing IPRs

against the younger patents first while delaying filing IPRs against the patents that have stronger settled expectations.

SoundClear's settled expectations merit discretionary denial here.

## **B. The *General Plastic* Analysis Supports Discretionary Denial**

In addition to settled expectations, the *General Plastic* factors also support discretionary denial. This Petition is a follow-on petition to IPR2025-00673.

SoundClear will address Google's expected opposition to the *General Plastic* analysis in a reply brief after requesting permission from the Board to file one.

### **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). The SoundClear II Cases each involve the same patents-in-suit.

Moreover, throughout all district court and IPR proceedings involving SoundClear, Amazon and Google have engaged in a thematic pattern of strategic conduct that demonstrates a significant relationship created for litigation purposes. As shown below, they have coordinated their strategy since early in the district court litigations with Google taking the lead on the SoundClear I Cases and Amazon taking the lead on the SoundClear II Cases.

The initial Rule 12 briefing in the district court proceedings demonstrates this strategic relationship. In the SoundClear I Cases, Google filed its Motion to

Dismiss three weeks before Amazon did. *Compare* EX-2004 (Dkts. 13 and 14 (filed Aug. 5, 2024)) *with* EX-2005 (Dkts. 30 and 31 (filed Aug. 26, 2024)).

Notably, Amazon's subsequent motion mirrored Google's motion. *Compare* EX-2006 *with* EX-2007. Like Google's brief, Amazon's brief: (1) did not include allegations against the '259 patent, (2) alleged that the '374 patent was invalid under § 101, and (3) alleged that the complaint did not plausibly allege infringement of the '819 patent. *Id.* (comparing both supporting memorandums to show that the same arguments were made by both Google and Amazon). Similarly, in the SoundClear II Cases, Amazon filed its Motion to Dismiss over two weeks before Google did. *Compare* EX-2008 (Dkts. 31 and 32 (filed Sept. 13, 2024)) *with* EX-2009 (Dkts. 16 and 17 (filed Sept. 30, 2024)). Google's subsequent motion adopted the same approach in Amazon's motion. *Compare* EX-2010 *with* EX-2011. Like Amazon's brief, Google's brief: (1) alleged that the '337 patent and '675 patent were invalid under § 101, and (2) alleged that the complaint did not plausibly allege infringement of any of the three patents-in-suit. *Id.*

The subsequent conduct by Google and Amazon demonstrates that their relationship was for Amazon to drive the strategy for the SoundClear II Cases and related IPRs while Google drove the strategy for the SoundClear I Cases and related IPRs. In the SoundClear-1283 Case, Amazon: filed a Motion to Transfer on October 8, 2024; filed IPR petitions (IPR2025-00565 and IPR2025-00673) against

two of the three patents-in-suit (i.e. the '337 patent and '675 patent on January 31, 2025 and February 27, 2025, respectively); and filed a Motion to Stay the next day on February 28, 2025. EX-2008 (Dkt. 42; Dkt. 109). Meanwhile, Google, during the same period of time in the SoundClear-321 Case: filed a Motion to Transfer on November 4, 2024; filed IPR petitions (IPR2025-00344 and IPR2025-00345) against two of the three patents-in-suit (the '374 patent and '259 patent on February 10, 2025); and filed a Motion to Stay roughly a week later on February 18, 2025. EX-2004 (Dkt. 39, 73, 74, and 75).

Only after Amazon filed IPRs and moved to stay its SoundClear II case did Google move to stay its SoundClear II case (the SoundClear-540 Case) and file its own IPRs. Google moved to stay the SoundClear-540 Case on April 8, 2025—over a month after Amazon did. *See* EX-2009 (Dkts. 47, 48, and 49). And in its motion to stay, Google relied on *Amazon's* IPR filings against the patents-in-suit and *Amazon's* motion to stay. EX-2012; EX-2013. Indeed, Google had not yet filed IPRs against the patents-in-suit in the SoundClear II Cases when it filed its motion to stay. It did not file those IPRs until a few weeks before the statutory deadline.

Similarly, only after Google filed IPRs and moved to stay its SoundClear I case did Amazon move to stay its SoundClear I case and file its own IPRs. Amazon moved to stay the SoundClear-320 case on April 7, 2025—over a month after Google did. *See* EX-2005 (Dkts. 49 and 50). And in its motion to stay, Amazon

relied on *Google's* IPR filings against the patents-in-suit and *Google's* motion to stay. EX-2014. Indeed, Amazon had not yet filed IPRs against the patents-in-suit in the SoundClear I Cases when it filed its motion to stay. It did not file those IPRs until a few days before the statutory deadline.

The timing and sequence of these actions demonstrate a coordinated and deliberate division of labor between Amazon and Google. It is not coincidental. In its SoundClear II case, Amazon even cited Google products as alleged prior art products against the '675 patent and the other patents-in-suit. EX-2015 at 9, 20.

Google and Amazon each chose to create a significant relationship with each other by strategically hitching their respective cases together. For the SoundClear II Cases, Google specifically chose to avail itself of *Amazon'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. It did not wait until after filing its own IPRs to file a stay motion.

Thus, Amazon and Google have a "significant relationship" with respect to SoundClear's assertion of the '675 patent. *See Valve*, IPR2019-00062, Paper 11, 9-10. Such circumstances are sufficient to invoke the *General Plastic* analysis.

## **2. Factor 1 – Both Petitions are Directed to the Same Claims**

Google's Petition is directed to all claims (1-7) of the '675 patent. The prior filed Amazon petition (IPR2025-00673) is 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 – Amazon Knew About the Alleged Prior Art Cited in Google’s Petition Before Filing IPR2025-00673**

Google’s Petition relies on EX-1005 (the Ocampo reference (U.S. Publication No. 2018/0122361)), EX-1006 (the Raitio reference (U.S. Publication No. 2014/0303971)), and EX-1007 (the Fahlman reference (U.S. Patent No. 5,960,080)). Amazon knew about each of the references before it filed its petition in IPR2025-00673 against the ’675 patent.

Amazon has known about the Ocampo reference since at least June 1, 2018 when the patent examiner of U.S. App. No. 15/611,228 (now U.S. Patent No. 10,418,033) cited it in connection with a non-final rejection. EX-2016, 9. The ’033 patent is owned by Amazon. EX-2017. Indeed, at least *eight* other Amazon patents also cite the Ocampo reference as relevant art. *See, e.g.*, EX-2018; EX-2019; EX-2020; EX-2021; EX-2022; EX-2023; EX-2024; EX-2025. Thus, Amazon knew about the Ocampo reference over *six years* before its February 27, 2025 petition.

The Ocampo reference is owned by Google. EX-1005. Thus, Google knew about it since at least November 1, 2016 when it was filed with the USPTO—over *eight* years before Amazon filed its petition.

Amazon has known about the Raitio reference since at least May 29, 2018 when the patent examiner of U.S. App. No. 15/386,333 (now U.S. Patent No. 10,276,149) relied on it in an office action to reject the claims at issue. EX-2030, 8-

10, 25. The '149 patent is owned by Amazon. EX-2028. At least one other Amazon patent also cites Raitio as relevant art. EX-2020. Thus, Amazon knew about the Raitio reference nearly *seven years* before it filed its petition on February 27, 2025.

Google has known about the Raitio reference since at least February 22, 2018 when it cited the reference on an Information Disclosure Statement (IDS) during the prosecution of one its own patent applications (U.S. App. No. 13/478,998), now U.S. Patent No. 10,152,723. EX-2037, 5; EX-2038. The '723 patent is owned by Google. *Id.* Thus, Google knew about the Raitio reference over *seven years* before it filed its petition on July 14, 2025.

Amazon has known about the Fahlman reference since at least May 17, 2018 when the patent examiner of U.S. App. No. 15/278,735 (now U.S. Patent No. 10,223,356) cited it in connection with a Final Rejection. EX-2031, 31. The '356 patent is owned by Amazon. EX-2032. At least four other Amazon patents also cite Fahlman as relevant art. EX-2033; EX-2034; EX-2035; EX2036. Thus, Amazon knew about the Fahlman reference nearly *seven years* before it filed its petition on February 27, 2025. Factor 2 favors denial.

**4. Factor 3 – Google Filed its IPR Petition One Month After SoundClear Filed its POPR Brief on Discretionary Denial in IPR2025-00673**

SoundClear filed its discretionary denial brief for Amazon's IPR petition against the '675 patent on June 16, 2025. *See* IPR2025-00673, Paper 5. That was

*one month* before Google filed the instant Petition against the '675 patent.

SoundClear's June 16th brief was 61 pages and contained a variety of arguments including a *Fintiv* analysis, an *Advance Bionics* analysis, and several other arguments relevant to discretionary denial. *Id.*

Google's delay in filing its Petition until a month after SoundClear's June 16th brief on the same '675 patent is prejudicial to SoundClear. Google was aware of Amazon's earlier petition at least by April 8, 2025 when Google moved to stay the SoundClear-540 case on the basis of that petition. *See* EX-2029, EX-2012, EX-2013. Yet, Google waited over 3 months to file this follow-on Petition. Again, that was not coincidental. The Board accorded a filing date for IPR2025-00673 on April 14, 2025. *See id.*, Paper 10. Thus, when Google moved to stay the SoundClear-540 case on April 8th, it already knew when SoundClear's discretionary denial brief would be due in IPR2025-00673. It deliberately chose to wait and see what SoundClear's discretionary denial arguments would be.

As discussed above, Google and Amazon created a significant relationship for coordinating litigation strategy. Google delaying its follow-on Petition until after SoundClear filed its discretionary denial brief against Amazon is yet another example of that coordinated strategy. That gamesmanship should not be rewarded here, particularly when SoundClear has settled expectations in the '675 patent in view of recent case law. Factor 3 favors denial.

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

As stated above for factor 2, Google knew about Ocampo at least since November 1, 2016 when it filed the Ocampo patent application. *See* EX-1005. That is over *eight years* before it filed its Petition against the ’675 patent, and over *five years* before the ’675 patent issued.

Amazon knew about Ocampo since at least June 1, 2018—over *six years* before it filed its own petition against the ’675 patent and *seven years* before Google filed its Petition. Amazon knew about Raitio since at least May 29, 2018—over *six years* before it filed its own petition against the ’675 patent and *seven years* before Google filed its Petition. Amazon knew about Fahlman since at least May 17, 2018—over *six years* before it filed its own petition against the ’675 patent and *seven years* before Google filed its Petition.

Amazon and Google collectively knew about the references at least seven years before Google’s Petition was filed. *General Plastic* factor 4 favors denial.

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

As discussed above, the Ocampo and Raitio references in the Petition were known to Google and Amazon long before the Petition was filed. Each party knew about Ocampo and Raitio at least six years beforehand. Further, Amazon knew of Fahlman at least six years before Google’s Petition.

There is no adequate explanation for the lapse of time between Google learning about Ocampo and Raitio and the filing of Google’s Petition. Indeed, Google has *always* known about Ocampo; it is the publication of a Google patent application that was filed nearly *nine* years ago. And Google cited the Raitio reference in an IDS in February 2018. Thus, Google knew about both references when the ’675 patent issued over three years ago and when SoundClear asserted the ’675 patent against Google over one year ago.

Likewise, there is no adequate explanation for the lapse of time between Amazon learning about both references and the filing of Google’s Petition. Indeed, as discussed *supra*, Amazon knew about both references since at least June 1, 2018. Yet when it filed the petition in IPR2025-00673 against the ’675 patent nearly *five months before* Google’s Petition, it chose not to rely on either one of those references. Thus, *General Plastic* factor 5 favors denial.

**7. Factors 6 and 7 – An IPR Proceeding is Already Pending Against the ’337 Patent**

*General Plastic* “sixth and seventh factors are efficiency considerations.” *Valve*, IPR2019-00062, 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.* Current constraints on PTAB resources justified the Board’s new approach to discretionary denial. *See* Morgan Stewart Memo.

The Board is already considering institution of a proceeding against the '675 patent: IPR2025-00673. It would be inefficient for the Board to consider instituting a second proceeding here against the same patent. The first petition was filed more than *fourth months* before the instant Petition. And, if institution is granted for both petitions, the Board's Final Written Decision in IPR2025-00673 would issue approximately four months before a Final Written Decision for the instant Petition. Moreover, SoundClear has settled expectations in the '675 patent in view of recent case law.

Thus, factors 6 and 7 favor denial. On balance, all *General Plastic* factors collectively favor discretionary denial of the instant Petition.

### **C. Other Factors Support Discretionary Denial**

#### **1. Google Did Not File a *Sotera* or *Sand* Stipulation**

Google has not filed a *Sotera* or *Sand* stipulation in the district court case. The lack of a *Sotera* or *Sand* stipulation in the district court cases raises “concerns of inefficiency and the possibility of conflicting decision” between the Board and district court. *Fintiv*, IPR2020-00019, Paper 11, 12; *see also 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” this factor favors discretionary denial.).

That, along with Amazon and Google’s strategy of inconsistent claim construction positions, evinces an intent to evade finality. Estoppel aside, nothing bars Google from relying on substantially identical prior art combinations and the same invalidity theories already presented to the Board.

## **2. Google Will Pursue Contradictory Claim Constructions**

Google states: “[n]o terms need construction to resolve the unpatentability issues in this Petition.” Pet., 5. Yet, in a footnote, Google states: “Petitioner may raise indefiniteness and/or claim constructions in other forums.” *Id.*, note 2. This indicates Google intends to pursue contradictory claim construction positions for purposes of invalidity (at the Board) and non-infringement (in district court). If even a single claim escapes the IPR proceeding, Google will seek claim constructions that favor non-infringement.

But Google’s approach is 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, e.g., *White v. Dunbar*, 119 U.S. 47, 51 (1886)).

Further, Google’s seeking of divergent claim construction positions at the Board and district court weighs against institution, particularly when they do not explain why differing positions are warranted. *See Sun Pharmaceuticals Industries Inc. v. Nivagen Pharmaceuticals, Inc.*, IPR2025-00893, Paper 18 (PTAB Sept. 19, 2025).

### **3. District Court Discovery and A Jury Are Required**

Technical, factual, and evidentiary issues will dominate this case. Many result from the expert fight Google teed up on almost every issue. Google’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 should weigh the testimony and balance the credibility of the experts. *See* FAQ 21.

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

Testimony of the two named inventors of the patents-in-suit in the SoundClear II Cases may be material and relevant, because it relates to issues of validity and infringement. Both 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. Google 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 Google to seek out a forum to address an issue (e.g., invalidity at the PTAB) where certain third-party discovery related to that issue is unavailable.

#### **4. Confluence of Expert Testimony and Attorney Argument**

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

Google's 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., 14-38 *with* EX-1003, ¶¶77-105. In the rare instances where there is some difference, they are superficial.

## **5. Failure to Establish a Prima Facie Case under *Graham***

Google does not adequately 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.

As in *Johns Manville Corp. v. Knauf Insulation, Inc.*: “[Google] does not support, in its claim-by-claim analysis, which elements of the cited references could be predictably combined.” IPR2018-00827, Paper 9, 12 (PTAB Oct. 16, 2018) (designated informative) (denying institution for insufficient reason to combine references). “For example, in its discussion of claim [1], [Google] indicates which of the references purportedly discloses each element of claim [1], but 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.” *Id.* “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 something as “well-known and predictable” is not enough. *Id.*, 13-14.

## **V. CONCLUSION**

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

Dated: September 23, 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) and the Interim Director Discretionary Process § II.C.iii, the undersigned certifies that this Brief in Support of Discretionary Denial complies with the type-volume limitations of those sections because it contains 4,515 words and no more than 20 pages, 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: September 23, 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. 11,069,675  
was served electronically via email on September 23, 2025, on the following  
counsel of record for Petitioner:

Erika H. Arner  
Cory C. Bell  
Daniel C. Tucker  
Michael V. Young  
Safiya Aguilar  
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
erika.arner@finnegan.com  
cory.bell@finnegan.com  
daniel.tucker@finnegan.com  
michael.young@finnegan.com  
safiya.aguilar@finnegan.com  
Google-Soundclear-IPRs@finnegan.com

Dated: September 23, 2025

Respectfully Submitted,

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