

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

DIALECT, LLC,
Patent Owner.

Case IPR2025-01334
Patent 7,398,209

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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PATENT OWNER’S EXHIBIT LIST

Exhibit No.	Description
2001	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Google LLC v. Dialect, LLC</i> , IPR2024-00746, Paper 11 (PTAB Oct. 15, 2024)
2002	Complaint in <i>Dialect, LLC v. Microsoft Corp.</i> , Civ. No. 2-24-cv-01067 (E.D. Tex. Dec. 20, 2024)
2003	Third Amended Docket Control Order in in <i>Dialect, LLC v. Microsoft Corp.</i> , Civ. No. 2-24-cv-01067 (E.D. Tex. Aug. 6, 2025)
2004	Defendant’s Preliminary Invalidity Contentions, <i>Dialect, LLC v. Meta Platforms, Inc.</i> , Civ. No. 7:25-cv-60 (W.D. Tex. Sept. 17, 2025)
2005	Scheduling Order, <i>Dialect, LLC v. Meta Platforms, Inc.</i> , Civ. No. 7:25-cv-60 (W.D. Tex. Aug. 7, 2025)
2006	Decision Denying Institution of <i>Inter Partes</i> Review, <i>Microsoft Corporation v. Dialect, LLC</i> , IPR2025-00655 (lead case), Paper 12 (PTAB Aug. 14, 2025)
2007	Redacted Order in <i>Dialect, LLC v. Samsung Electronics Co., Ltd.</i> , Civ. No. 2-23-cv-00061 (E.D. Tex. Aug. 28, 2023)

IPR2025-01334 Patent Owner's Request for Discretionary Denial

Pursuant to the Director's Memorandum issued on March 26, 2025, Patent Owner Dialect, LLC ("Dialect" or "Patent Owner") files this request and brief on discretionary denial, setting forth reasons why the Director should exercise discretion to deny the Petition for *inter partes* review ("IPR") of claims 1, 4, and 6-9 of U.S. Patent 7,398,209 (the "'209 Patent"), as requested by Meta Platforms, Inc. ("Petitioner" or "Meta").

I. INTRODUCTION

The '209 patent is part of a portfolio of voice-processing patents owned by Dialect. The '209 patent has a filing date of June 3, 2003, and 890 days of patent term adjustment, which means that the '209 patent will expire in November 2025, prior to a decision to institute in this case. There is no reason for the Board to dedicate over a year's worth of Office resources to review the validity of an expired patent. This logic and policy is magnified here, where the '209 patent was involved in a prior failed *inter partes* review proceeding brought by a different petitioner and denied on the merits (in IPR2024-00746) and was involved in a prior litigation that was settled. Moreover, Meta will have its opportunity to challenge the '209 patent's validity in district court if it so chooses, and the district court trial will occur shortly after a final written decision would be due in this case. Discretionary denial is appropriate and respectfully requested.

II. HISTORY OF THE SUCCESSIVE CHALLENGES TO THE '209 PATENT

A. Outcome of Google's Prior IPR Petition

Google filed a petition for *inter partes* review on April 5, 2024 challenging claims 1-9 and 12 of the '209 patent. *Google LLC v. Dialect, LLC*, IPR2024-00746, Paper 2 (PTAB Apr. 5, 2024). After briefing concerning Patent Owner's preliminary response, the Board denied Google's petition on the merits, finding "[i]n view of our determination that Petitioner has not demonstrated Coffman teaches the limitations of claim 1 for which Coffman is cited, we determine that Petitioner has not demonstrated that the references in any of its asserted grounds teach the limitations of challenged dependent claims 2–9, and 12." *Google LLC v. Dialect, LLC*, IPR2024-00746, Paper 11 at 30 (PTAB Oct. 15, 2024) (Ex2001).

B. Microsoft Litigation

On December 20, 2024, Dialect filed a complaint alleging that Microsoft Corp. infringed Dialect's portfolio of voice processing patents, including the '209 patent. Ex2002, ¶1. Trial in that litigation is scheduled for November 2, 2026. Ex2003.

In addition to the failed IPR challenge in IPR2024-00746, claims 1, 2, 4-9, and 12-14 of the '209 patent are being challenged in another co-pending IPR filed by Microsoft, IPR2025-01351, using different set of references than those applied by either Google or Meta. Although the Microsoft IPR bears a higher control

number (-01351 vs. -01334), the petition in the Microsoft IPR was filed before the instant Petition.

C. District Court Challenge

On February 7, 2025, Patent Owner filed suit against Meta in District Court for the Western District of Texas. Petitioner has served its invalidity contentions in that matter (Ex2004), and the District Court has set a trial date of April 5, 2027. Ex2005.

III. ARGUMENT

This third attack on the '209 patent should be denied as there is no reason for the Office to spend additional resources to evaluate a patent that will expire prior to the Board reaching a final written decision regarding its validity, and even prior to the expected institution decision. Further, the district court activities and Google's prior failed IPR also weigh in favor of denial.

A. Strong Settled Expectations Favor Denial

The "strong settled expectations" for the '209 patent weigh heavily in favor of discretionary denial. The '209 patent issued on July 8, 2008, and each of the three required maintenance fees to keep the patent in force for the full lifetime of the '209 patent have been paid. Accordingly, the '209 patent was in force for over 17 years before Petitioner filed its Petition.

Moreover, the '209 patent, even with its 890 days of patent term extension, will expire in November 2025, even before any institution decision is likely to be

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rendered. Under current USPTO policy, the '209 patent is not a patent that warrants Board review. *See iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (PTAB, June 6, 2025) (Director's Decision Granting Discretionary Denial).¹

The settled expectations also weigh even more heavily considering that the '209 patent has been involved in commercial transactions, including ownership transfers and settlement of prior litigation. These commercial transactions show that the '209 patent has had recognized value in the industry, and Dialect has been a willing licensor of its portfolio of patents including and related to the '209 patent. In addition to the transfer and license discussed in the Board's discretionary denial decisions in other Dialect IPRs (Ex2006, 2), the '209 patent has been subject to enforcement action in district court followed by settlement, including Samsung. Ex2007. As a matter of policy, the IPR system should not be employed by Petitioners as a tool for hold outs to gain leverage in negotiations against a willing licensor with a history of settling its infringement disputes with others in the industry.

Further, Dialect's portfolio has long been known to Meta, with related patent 8,112,275 having been cited during the prosecution of no fewer than thirty-nine Meta patents: 10,936,346; 11,231,946; 11,245,646; 11,249,773; 11,249,774;

¹ IPR2025-00363 is the lead case of five to which this Director's Decision applies.

11,263,031; 11,263,276; 11,301,521; 11,307,880; 11,308,169; 11,368,420;
11,429,649; 11,544,305; 11,636,140; 11,651,586; 11,657,333; 11,663,812;
11,676,220; 11,688,159; 11,704,899; 11,704,900; 11,715,042; 11,715,289;
11,721,093; 11,727,677; 11,842,522; 11,886,473; 11,887,359; 11,908,179;
11,908,181; 12,001,862; 12,008,802; 12,112,530; 12,125,272; 12,131,522;
12,131,523; 12,198,413; 12,374,097; and 12,406,316.

B. District Court Activities Still Weigh in Favor of Denial

The Petition's challenges against the '209 patent are based on the Ross, Ittycheriah, Ross018, Aridor, Hartono, and Baker references. Petitioner has presented overlapping validity contentions in a district court proceeding, *see* Ex2004, 30 (pdf page) (also citing the Ross, Ittycheriah, Ross018, Aridor, Hartono, and Baker references against the '209 patent).

Further, trial in the parallel *Meta* case has been scheduled to occur shortly after the date when a final written decision in this case could be expected (around February 22, 2027). Ex2005 (setting April 5, 2027 trial date). Even with this slightly later trial date, the parties will have invested considerable resources into claim construction and validity challenges by the time a final written decision issues in this proceeding.

Additionally, a trial in the parallel *Microsoft* case will occur on November 2, 2026, well before the date for when a final written decision could be expected.

While Meta may complain that the *Microsoft* case's trial date should have no bearing on whether Meta's Petition should be discretionarily denied, that is contrary to current Office policy. Specifically, per the Director's September 16, 2025 Memorandum entitled "PTAB consideration of prior findings of fact and conclusions of law,"² the parties must keep the Board apprised of developments regarding adjudication of validity or patentability of the challenged patent claims, or substantially similar patent claims, such as claim construction, findings of fact, or conclusions of law, in "any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding." This is because the Director's policy requires Office consideration of related adjudications involving the patent-at-issue in a district court, regardless of whether that district court proceeding involves the same petitioner presenting the IPR challenge.

Moreover, the outcome of the *Microsoft* litigation ensures that this IPR would not be an efficient use of Office resources. If Microsoft succeeds in invalidating the '209 patent in district court litigation, then this IPR would not be needed. On the other hand, if Patent Owner is successful in defending the '209 patent's validity in the *Microsoft* litigation, then that outcome should be persuasive evidence to the Board that the same outcome should be reached here. Either way,

² Available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf.

that District Court outcome is scheduled to occur well before a final decision would be reached in this IPR, and the timing weighs in favor of discretionary denial.

C. The Prior Failed IPR Against the '209 Patent Also Weighs in Favor of Denial

This follow-on petition against the '209 patent also raises concerns of roadmapping. A prior petition against the '209 patent filed by Google was denied on the merits because the references Google relied on failed to satisfy the claim limitations of the '209 patent. *See Google LLC v. Dialect, LLC*, IPR2024-00746, Paper 11 at 30 (PTAB Oct. 15, 2024) (Ex2001). Meta based its petition, filed nearly a year after Google's petition was denied on the merits, on a completely different set of references than Google. This serial use of the IPR process, which subjects patent owners to multiple challenges on the same patent, presents an additional reason to deny the Petition. Under similar circumstances, the Director has weighed that such roadmapping favors of denial of institution. *See Amazon Web Services, Inc. v. Croga Innovations, Ltd.*, IPR2025-00884, Paper 9 at 2 (PTAB Sept. 3, 2025) (weighing roadmapping in favor of denial).

IV. CONCLUSION

Discretionary denial is respectfully requested and appropriate in this case given the strong settled expectations based on the age of the '209 patent, the impending expiration of the '209 patent, the failed prior challenge of the '209

patent on the merits, and the advanced stage of the co-pending litigations. When these factors are considered individually, these factors each weigh strongly in favor of discretionary denial and would be sufficient to warrant denial. However, when these factors are considered as a whole, discretionary denial is extremely compelling and should be granted.

For the reasons presented above, Patent Owner respectfully asks that the Director exercise discretion to deny the Petition. No *inter partes* review should be instituted.

Dated: October 21, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on this date, a true and correct copy of the foregoing document was served via email, by consent, to Petitioner by serving the correspondence email addresses of record as follows:

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