

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SOUNDCLEAR TECHNOLOGIES LLC,  
Patent Owner

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U.S. Patent No. 9,223,487  
Issue Date: December 29, 2015

Title: ELECTRONIC APPARATUS, METHOD OF CONTROLLING THE  
SAME, AND RELATED COMPUTER PROGRAM

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*Inter Partes* Review No. IPR2025-01368

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF  
INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF  
UNITED STATES PATENT NO. 9,223,487**

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### **PATENT OWNER EXHIBIT LIST**

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                               |
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| 2001               | <i>SoundClear Techs. LLC v. Amazon.com, Inc. et al.</i> , Case No. 1:24-cv-01283 (EDVA) (“-1283 case”) Excerpts from the Motion to Stay hearing transcript, dated March 26, 2025 |
| 2002               | -1283 case, Joint proposed scheduling order, dated October 9, 2024 (Dkt. 48)                                                                                                     |
| 2003               | -1283 case, Order from Judge Anthony Trenga, dated November 8, 2024 (Dkt. 63)                                                                                                    |
| 2004               | United States Patent Publication No. 2008/0168403                                                                                                                                |
| 2005               | USPTO Office Action and List of References Cited by Examiner for U.S. Application No. 13/604,942, dated January 28, 2015                                                         |
| 2006               | USPTO Final Office Action for U.S. Application No. 13/604,942, dated July 16, 2015                                                                                               |

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 1-3 and 10-12 (“the Challenged Claims”) of U.S. Patent No. 9,223,487 (“’487 patent,” EX-1001).

## **I. INTRODUCTION**

Discretionary denial is appropriate here at least because the ’487 patent has already been held invalid under 35 U.S.C. § 101 in a parallel district court proceeding and SoundClear has strong settled expectations in the ’487 patent. The ’487 patent has been in force for nearly 10 years. Under Board precedent, that creates settled expectations sufficient to support discretionary 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. Finally, the Petition fails to articulate a proper obviousness analysis under *Graham*.

The *Advanced Bionics* analysis also favors denial because a reference substantially similar to the an alleged prior art reference cited in the Petition was previously considered by the Examiner during prosecution of the ’487 patent.

## 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. *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)).

**C. *Advanced Bionics***

“[U]nder § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first [the] part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics LLC v. Med-EL Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6, 8 (PTAB Feb. 13, 2020) (precedential).

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

*Id.* at 9. The *Becton* factors are as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;

(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

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

#### **IV. ARGUMENT**

##### **A. Discretionary Denial is Warranted Because the '487 Patent Was Already Invalidated Under § 101 in the SoundClear-1283 Case**

As indicated above, the '487 patent is asserted in the SoundClear II Cases. In one of those cases (the SoundClear-1283 Case), the district court determined that the claims of the '487 patent were invalid under § 101. EX-2003, 14-16.

The Board and/or Director have repeatedly found that denial of institution under *NHK/Fintiv* is appropriate when, in pending parallel litigation, a district court has already granted final judgment of invalidity under § 101 on the challenged claims. *See, e.g., Hulu LLC v. Piranha Media Distribution, LLC*, IPR2024-01253, Paper 27 (PTAB Mar. 4, 2025) (routine decision denying institution where district court had found claims invalid under § 101); *AviaGames, Inc., v. Skillz Platform Inc.*, IPR2022-00530, Paper 12 (Aug. 9, 2022) (denying

institution where district court had found claims invalid under § 101), remanded, Paper 14 ) (PTAB Mar. 2, 2023), denial reinstated, Paper 15 (Mar. 22, 2023). These rulings are consistent with the key consideration of *NHK/Fintiv* and IPR proceedings—to prevent inefficient use of Board resources. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 17 (PTAB Mar. 20, 2020) (precedential).

That is the same scenario here. The district court’s order that “the ’487 patent is not valid under § 101” applies to all claims of the ’487 patent because the order analyzes one claim and determines that it is representative of all other claims, including those challenged in the Petition. EX-2003, 14-16. The district court’s order is a final judgment on the validity of the claims under § 101 that is appealable. And the district court’s order was issued on November 8, 2024—nearly nine months before Amazon filed the Petition. Because the challenged claims have already been found to be invalid under § 101, it is not an efficient use of Board resources to review them for patentability under other grounds. *See Google LLC v. TJTM Technologies, LLC*, IPR2025-00586, Paper 12 at 2 (PTAB Aug. 14, 2025); *see also Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27 (Director Apr. 17, 2025) (informative)).

Because the district court ruled all claims of the ’487 patent invalid under § 101, discretionary denial under *Fintiv* and the Board’s discretionary denial framework is appropriate here even without an exhaustive analysis of the *Fintiv*

factors.<sup>1</sup> *See Hulu*, IPR2024-01252, Paper 27, 3; *see also TJTM*, IPR2025-00586, Paper 12, 2. As Acting Director Stewart explained in the *Hulu* case, “the *Fintiv* framework does not fit neatly with the circumstances of this case, where the district court already ha[s] already determined that the challenged claims are invalid under § 101 before [a] Board[] Decision.” *See Hulu*, IPR2024-01252, Paper 27, 3. The purpose of the *Fintiv* analysis is to assess the efficiency of conducting a IPR proceeding on a patent in parallel with a proceeding in a different court against the same patent. Here, as the Director and/or Board determined in *Hulu* and *TJTM*, “a district court already has found the challenged claims invalid,” therefore “the efficiency and integrity of the patent system is best served by denying institution.” *See Hulu*, IPR2024-01252, Paper 27, 3; *TJTM*, IPR2025-00586, Paper 12, 2 (citing *Hulu*, IPR2024-01252, Paper 27). “The Director is permitted, but never compelled, to institute an IPR.” *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021).

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<sup>1</sup> While Patent Owner does not present individual arguments for each *Fintiv* factor in this brief, it reserves the right to request a Reply to Petitioner’s expected opposition brief to address any factor-specific arguments raised by Petitioner.

Thus, discretionary denial is appropriate here under *Fintiv* and the Board’s discretionary denial framework to promote efficiency and preserve crucial Board resources.

**B. SoundClear’s Strong Settled Expectations in the ’487 Patent Support Discretionary Denial**

The ’487 patent has been in force for nearly 10 years (it issued on December 29, 2015). EX-1001. Patents “in force for approximately eight, twelve, and fifteen years, creat[e] *strong* settled expectations.” *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 15, 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.

Thus, SoundClear has strong settled expectations in the ’487 patent. Consistent with the Director’s discretionary denial reasoning in other cases, SoundClear’s settled expectations merit discretionary denial of this Petition.

**C. The *Advanced Bionics* Analysis Supports Discretionary Denial**

As explained above, the *Advanced Bionics* framework is a two-part framework informed by the *Becton* factors. Here the first part of *Advanced Bionics* is satisfied because the Examiner of the predicate application of the '487 patent issued at least one rejection based on U.S. Publication No. 2008/0168403 to Westerman (“Westerman-403”) during prosecution. EX-2004; EX-2005; EX-2006. The technical disclosures in Westerman-403 that were considered by the Examiner are substantially the same as those disclosed in Westerman-632 and relied on in Grounds 2A-2C of Amazon’s Petition. *See* Pet., 63-70, 72-73 (citing EX-1005). Notably, the first-named inventor is also the same for both references.

The second step of *Advanced Bionics* is satisfied because Amazon does not identify any error in the Examiner’s analysis or consideration of the disclosures of Westerman-403 that are substantially the same as those disclosed in Westerman-632 and relied on in Grounds 2A-2C of Amazon’s Petition.<sup>2</sup>

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<sup>2</sup> The Petitioners do not address the Westerman-403 reference at all in its Petition. To the extent Amazon presents related *Advanced Bionics* arguments in opposition to this discretionary denial brief, SoundClear intends to address those arguments in a reply brief after requesting permission from the Board to file one.

**1. *Advanced Bionics* Step One – The Examiner Issued the Claims Over Westerman-403**

*Advanced Bionics* step one supports discretionary denial at least because prior art substantially similar to Westerman-632 was previously considered by the Examiner during prosecution. “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 7-8. The Examiner is not required to have applied prior art to a rejection for it to be considered “previously presented.” *Sony Interactive Entm’t LLC v. Terminal Reality, Inc.*, IPR2020-00711, Paper 15 at 11 (PTAB Oct. 13, 2020) (finding reference was previously considered by the Examiner because it was listed in the Examiner’s Notice of References Cited); *Biocon Pharma Ltd. v. Novartis Pharm. Corp.*, IPR2020-01263, Paper 12 at 9 (PTAB Feb. 16, 2021) (holding that a reference that was “not applied by the Examiner” was still considered).

Here, the Examiner actually did rely on Westerman-403 in two separate office actions. It was not merely cited passively in an IDS or PTO-892 form. This indicates that the Examiner thoroughly assessed the disclosure of Westerman-403 and still determined that the claims of the ’487 patent should be allowed despite that reference.

Further, the Westerman-403 reference cited during prosecution includes disclosures that are at least substantially the same as the disclosures in the Westerman-632 reference relied on in the Petition. The Examiner relied on Figure 12 of Westerman-403 (shown below) to disclose several claim elements during prosecution. The Examiner also stated that Westerman-403 “discloses the concept of performing function based on a two touch input gesture and measuring the distance between two touch points during a period of time.” EX-2006, 7.

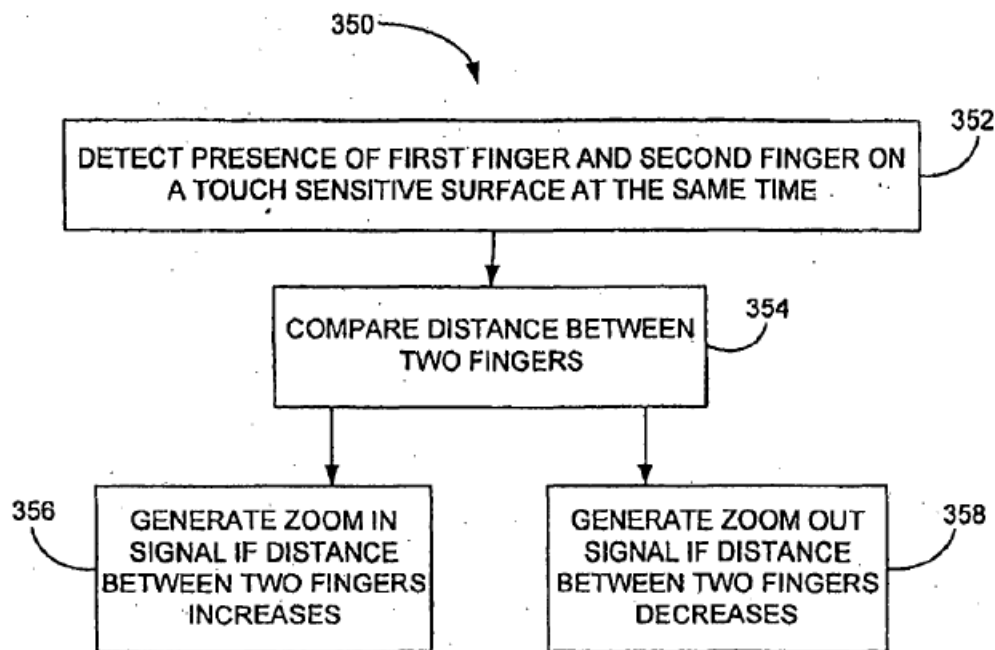


FIG. 12

See EX-2004, 23.

Figure 12 of Westerman-403 and the Examiner’s summary of the disclosure of Westerman-403 disclose the same, or otherwise substantially similar, functionality as the “pinch” functionality disclosed in each paragraph of

Westerman-632 relied on in the Petition. *See* Pet., 63-70, 72-73 (citing EX-1005, ¶¶[0007], [0027], [0059], [0066]). Indeed, the Petition relies on those paragraphs to disclose exactly those functions. *Id.*

Thus, because the Petition relies on the disclosures of the Westerman-632 reference that are substantially similar or the same as the disclosures of the Westerman-403 reference considered by the Examiner during prosecution, *Advanced Bionics* Step One favors discretionary denial.

**2. *Advanced Bionics* Step Two – The Examiner Did Not Err in Allowing the Claims of the '487 Patent Over Westerman-403**

During prosecution, the Examiner carefully evaluated the Westerman-403 reference before allowing the claims of the '487 patent over that reference. The Examiner relied on Westerman-403 in two separate office actions and applied it in combination with other references to reject multiple claims. EX-2005, 5-8; EX-2006, 2-6. The Examiner's written rejections articulate detailed technical analysis (based on Figure 12 of Westerman-403) and specify exactly how the Westerman-403 reference is being combined with the other references for the rejection. *Id.* Indeed, the Examiner also specifically responded to arguments against Westerman-403 that were presented by the Applicant. *Id.*, 7.

Amazon bears the burden of showing that the Examiner erred. *See Advanced Bionics* at 9. Amazon's Petition does not address this point directly at all. As such

SoundClear reserves the right to respond (in a reply brief) to any arguments Amazon raises on this point in an opposition brief.

To the extent Amazon relies on the technical arguments in its Petition to allegedly demonstrate error by the Examiner, such arguments are insufficient. They do not explain why the Examiner’s reasoning was incorrect or provide any alternative reasoning to that of the Examiner. *See Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01533, Paper 14, 19 (PTAB Mar. 27, 2023) (petitioner did not demonstrate why a different conclusion should be reached based on the same reference cited during prosecution).

Thus, the *Advanced Bionics* Step Two favors discretionary denial.

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

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

Amazon 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's strategy of inconsistent claim construction positions, evinces an intent to evade finality. Estoppel aside, nothing bars Amazon from relying on substantially identical prior art combinations and the same invalidity theories already presented to the Board. This will result in duplicative work before the Board and district court and conflicting decisions between the forums.

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

Amazon states that “[n]o claim terms require construction to resolve the obviousness challenges here.” Pet., 8. However, in the district court proceeding in the SoundClear-1283 case, Amazon submitted a proposed discovery order to the court which required significant claim construction briefing. *See* EX-2002 5-6). Amazon took the position that it will file several claim construction briefs along with expert depositions on construed claims. *Id.* Amazon also took the position that its invalidity contentions may be amended in response to any claim construction ruling by the court. *Id.* Further, Amazon stated that it is a matter of “when,” not “if,” it will seek to construe the claims. At a hearing on March 26, Amazon's counsel stated: “this Court, *when* it does claim construction....” EX-2001, 3-4 (emphasis added); *id.*, 3 (referencing the district court's eventual “own claim construction”); *id.*, 7 (arguing that “[y]ou can say there's no claim construction

necessary to resolve those validity issues, but there is claim construction necessary for other issues in the case.”).

Amazon improperly attempts to apply a broader plain and ordinary meaning in this IPR, while simultaneously arguing before the district court that many terms will require narrower constructions. Amazon’s position before the Board (that no claim terms require construction) and before the district court (that claim construction briefing is required) is at odds with Board precedent. *See Sun Pharma. v. Nivagen Pharma.*, IPR2025-00893, Paper 18 at 2 (PTAB Sept. 19, 2025). There, as here, the petitioner did not explain *why, in this case*, Amazon may need to advance a narrow construction in district court and a broader construction in its Petition. *Id.* at 2-3. Amazon 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, Amazon will seek claim constructions that favor noninfringement.

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, e.g., *White v. Dunbar*, 119 U.S. 47, 51 (1886)).

### **3. District Court Discovery and A 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 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. Amazon 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. 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 certain third-party discovery related to that issue is unavailable.

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

Amazon'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").

Amazon'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., 10-37 with EX-1002, ¶¶56-119. In the rare instances where there is some difference, they are superficial. Further, Dr. Rosenberg does not provide additional technical reasoning to support many of his substantive statements. Additionally, as set forth in the USPTO guidance about the PTAB

Workload Management Memo, “[t]he failure to provide focused expert testimony may weigh against institution.” FAQ 22.

Given the lack of particularity in Amazon’s asserted grounds—on fundamental factual issues underlying the asserted grounds and in the legal analysis of obviousness—in addition to the copy-and-paste declaration, the Board should not waste resources instituting trial here.

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

Amazon 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.*: “[Amazon] 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], [Amazon] 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.

Moreover, Amazon’s Petition fails because it never articulates the required factual underpinnings for an obviousness determination. Amazon does not identify specific findings regarding the scope and content of the prior art, any meaningful differences between the asserted references and the challenged claims, or the level of ordinary skill in the art—each a mandatory element of the *Graham* inquiry. Without these predicate findings, the Petition offers nothing more than a conclusory assertion that combining the cited references would have been obvious. *See, e.g.*, Pet., 34-35; 42-45.

## **V. CONCLUSION**

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

Dated: October 14, 2025

Respectfully submitted,

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## **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 4,088 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: October 14, 2025

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing PATENT OWNER'S  
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF PETITION  
FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 9,223,487  
was served electronically via email on October 14, 2025, on the following counsel  
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