

1 UNITED STATES DISTRICT COURT
2 EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

3 SOUNDCLEAR TECHNOLOGIES LLC,) Case 1:24-cv-1283
4 Plaintiff,)
5 v.) Alexandria, Virginia
6 AMAZON.COM, INC., et al.) March 26, 2025
7 Defendants.) 10:00 a.m.
8) Pages 1 - 42

9 TRANSCRIPT OF DEFENDANTS' MOTION TO STAY
10 PENDING *INTER PARTES* REVIEW
11 BEFORE THE HONORABLE ANTHONY J. TRENGA
12 UNITED STATES DISTRICT COURT JUDGE
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25 COMPUTERIZED TRANSCRIPTION OF STENOGRAPHIC NOTES

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1 survive the IPR, but they're amended. So SoundClear
2 will have the opportunity in the IPR to actually amend
3 and change their patent claims. And if this litigation
4 were to proceed and then the claims get amended, you
5 would basically start over again with the new
6 substitute claims that would issue from the IPR
7 proceedings. So that's the third possibility.

8 The fourth possibility is that all the claims
9 survive. And if that's true and that's the outcome,
10 then this case is still simplified because there's
11 estoppel effects from the IPR. So Amazon would then
12 not be allowed to assert in this litigation the
13 defenses that are raised or could have been raised in
14 the IPR. So even if we get through the IPR process and
15 all of the claims survive, the litigation would still
16 be simplified.

17 Then the last option is that the IPRs don't
18 get instituted in the next six months when the PTAB has
19 to issue its institution decision. And in that case,
20 this litigation would still be simplified because the
21 arguments that lead up to that institution decision and
22 the board's institution decision become a part of the
23 file history at the patent office, the file history
24 record for the patent. And this Court, when it does
25 claim construction litigation, is supposed to consider

1 that prosecution history.

2 So Amazon has filed its IPR petitions. Three
3 months later SoundClear has an opportunity to file a
4 brief at the patent office arguing that it should not
5 institute the IPRs, and then three months after that,
6 the board decides whether to institute.

7 What they say in their patent order
8 preliminary response -- the brief they'll file -- and
9 what the patent office or the PTAB says in its
10 institution decision become a part of the file history
11 that this Court is supposed to consider in its own
12 claim construction. So it doesn't make sense to go
13 through this case, do our own claim construction
14 proceedings, and meanwhile, there's parallel
15 proceedings now happening at the patent office that
16 will affect the claim constructions in this case.

17 So those are the five possible outcomes. All
18 of them necessarily simplify the case.

19 And so we cited in our brief a case called
20 *Security First*, which is a 2024 case from this
21 district. And the court there recognized that any
22 possible outcome of the IPR petitions will, albeit to
23 varying degrees, simplify the issues before the Court.
24 There's no scenario in which this case is not
25 simplified by the IPR proceeding. And so the second

1 things they're referring to are common to all cases.
2 The reality is the proceedings that are happening in
3 the patent office will affect claim construction in
4 this case.

5 So both parties are going to make statements
6 to the patent office. They will be in the file history
7 of the patents, and this Court is supposed to consider
8 that complete record when it does claim construction
9 here.

10 The idea that Amazon will somehow argue for a
11 certain construction there and then argue for a
12 different construction here, first of all, is
13 speculative. Second of all, it doesn't make any sense
14 precisely because the same standard applies in both
15 cases. And third, if that were the case, we should be
16 completing that record at the patent office so that the
17 Court can rely on it here. We shouldn't be having
18 these claim construction proceedings happening at the
19 same time.

20 There's no inconsistency between Amazon's
21 positions, and we try to explain this in our reply
22 brief. When you have a patent claim -- and, Your
23 Honor, if you don't want me to rehash this, I won't.
24 But if you have a patent claim -- we used an example in
25 our reply brief. If the patent claim is to -- a red

1 truck is the example we used because the patent
2 describes a fire engine, right. It's a red truck. It
3 has flashing lights. It has a siren. And their claim
4 says a red truck. And we have prior art that we're
5 telling the patent office, "Please review the validity.
6 Here's prior art that disclosed a red truck. It's a
7 fire truck. It was red. It had sirens. It's exactly
8 what they described in their patent." No claim
9 construction is necessary of what a red truck is for
10 the patent office to resolve that validity question.

11 If at the same time they're suing somebody
12 for driving a pink ice cream van with a loud speaker on
13 it and normal headlights, there might be claim
14 construction that has to happen in the district court
15 for the jury to know whether that pink van infringes.
16 Is red as it's used in the patent broad enough to
17 include pink or the specific shade of pink? Something
18 with a siren, does that include a loud speaker that the
19 van plays music through? When the patent says a light,
20 does that include a headlight like a normal van or is
21 that limited to a flashing light like emergency
22 vehicles have?

23 Those are claim construction issues the Court
24 might have to decide so that it can instruct the jury
25 on the proper scope of the patent so that the jury can

1 decide whether a pink van infringes this patent that
2 was really about a red fire truck.

3 But if the prior art at the patent office is
4 a magazine about a red fire truck, the patent office
5 doesn't have to get into that level of detail on claim
6 construction. So what we said in our briefs, in our
7 IPR petitions is that there's no claim construction
8 necessary to resolve the invalidity issues before the
9 patent office, and that's true.

10 Does that mean that there's no claim
11 construction issues whatsoever that the jury might need
12 to have? No, it doesn't. You can say there's no claim
13 construction necessary to resolve those validity
14 issues, but there is claim construction necessary for
15 other issues in the case. And that happens all the
16 time. There's nothing nefarious about that. It's
17 common. That's just how it is.

18 But like I said, even if there were
19 inconsistencies that would support staying this case so
20 that the record at the patent office would be complete,
21 then Your Honor would know the positions that both
22 sides took when we're addressing claim construction in
23 this proceeding.

24 With respect to validity, I want to make sure
25 we're clear on the estoppel and the validity issues.