

2025-____

United States Court of Appeals for the Federal Circuit

In re Google LLC, Samsung Electronics Co., Ltd.,
Samsung Electronics America, Inc.

Petitioners

On petition for a writ of mandamus to the United States Patent and
Trademark Office, Patent Trial and Appeal Board,
in Nos. IPR2024-01464, IPR2024-01465

Petition for a Writ of Mandamus

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August 18, 2025

Certificate of Interest for petitioner Google LLC

I certify that the information below is complete to the best of my knowledge.

Date: August 18, 2025

Signature: /s/Nathan K. Kelley

Name: Nathan K. Kelley

1. Represented Entity	2. Real Party in Interest	3. Parent Corporations and 10% Stockholders
Google LLC	None	XXVI Holdings Inc.; Alphabet Inc.

4. Other Legal Representatives

O'Melveny & Myers LLP: Benjamin M. Haber; Jeff Baxter; Argirenia Zervos; Kyla Butler

Arnold & Porter Kaye Scholer LLP: Patrick Reidy; Albert J. Boardman; Douglas L. Clark

5. Related Cases

See separate notice.

6. Organizational Victims and Bankruptcy Cases

None

**Certificate of Interest for petitioners Samsung Electronics Co., Ltd.
Samsung Electronics America, Inc.**

I certify that the information below is complete to the best of my knowledge.

Date: August 18, 2025

Signature: /s/Ali R. Sharifahmadian

Name: Ali R. Sharifahmadian

1. Represented Entity	2. Real Party in Interest	3. Parent Corporations and 10% Stockholders
Samsung Electronics Co., Ltd.	None	N/A
Samsung Electronics America, Inc.		Samsung Electronics Co. Ltd.

4. Other Legal Representatives

O'Melveny & Myers LLP: Benjamin M. Haber; Jeff Baxter; Argirenia Zervos; Kyla Butler
 Arnold & Porter Kaye Scholer LLP: Patrick Reidy; Albert J. Boardman; Douglas L. Clark

5. Related Cases

See separate notice.

6. Organizational Victims and Bankruptcy Cases

None

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2022 Guidance	Memorandum from Director Vidal to Board, <i>Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation</i> (June 21, 2022)
2025 Memo	Memorandum from Chief APJ Boalick to Board, <i>Guidance on USPTO’s Rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation”</i> (Mar. 24, 2025)
Acting Director	Acting Director of the U.S. Patent & Trademark Office
AIA	Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011)
APJ	administrative patent judge
Board or PTAB	Patent Trial and Appeal Board
Cerence	respondent Cerence Operating Co.
DACA	Deferred Action for Childhood Arrivals
Director	Director of the U.S. Patent and Trademark Office
Google	petitioner Google LLC
IPR	<i>inter partes</i> review
Petitioners	Google and Samsung
Rescission	USPTO, <i>USPTO Rescinds Memorandum Addressing Discretionary Denial Procedures</i> (Feb. 28, 2025)
Samsung	collectively, petitioners Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc.
USPTO	United States Patent and Trademark Office

VA	United States Department of Veterans Affairs
(<i>x</i> : <i>y</i> - <i>z</i>)	column <i>x</i> , lines <i>y</i> - <i>z</i>
'461 patent	U.S. Patent No. 11,393,461
'750 patent	U.S. Patent No. 11,087,750

Related Cases

No other appeal relating to this case has been before this or any other appellate court.

This case is related to *Cerence Operating Co. v. Samsung Electronics Co.*, 2:23-cv-00482-JRG-RSP (E.D. Tex.), in which Cerence asserts the challenged '461 and '750 patents against Samsung.

Relief Sought

Petitioners respectfully request that this Court issue a writ compelling the USPTO to apply the discretionary-denial guidance in place when the IPR petitions in Nos. IPR2024-01464 and -01465 were filed.¹

Introduction

Petitioners Google and Samsung filed five IPR petitions challenging Cerence's patents over a few months. Each petition was diligently prepared and filed within the statutory limitations period. Each presented compelling merits. And each was accompanied by a nonrefundable request fee the USPTO justified based on the cost of a panel of APJs considering its merits. For certainty in view of co-pending litigation, Samsung made a *Sotera* stipulation promising not to pursue before the district court any grounds it did or could raise in the IPRs. That was a sure way to avoid a *Fintiv* denial because the Director had years earlier constrained her discretion and instructed the Board not to deny institution on *Fintiv* grounds if a *Sotera* stipulation came

¹ Because the USPTO issued a single Director review denial for both IPRs, the institution denials were substantively identical, and the relief requested is the same, Petitioners have challenged both denials in a single mandamus petition.

before an institution decision. Google could thus join Samsung's petition without worry that Samsung's litigation participation would be held against it. And indeed, the first three IPRs were instituted because of that *Sotera* stipulation.

The new Acting Director rescinded that guidance without explanation. Even though the facts did not materially differ from the three instituted IPRs, the USPTO, exercising the Acting Director's delegated discretion, denied the last two petitions—those at issue here—on grounds that the *Sotera* stipulation did not go far enough. The USPTO applied the rescission retroactively without explanation and despite Petitioners' reasonable reliance on the prior guidance.

That was unlawful in three ways. *First*, the USPTO violated due process when it made the Rescission retroactive, vitiating Petitioners' interest in the Director's surrender of some discretion. *Second*, it violated the APA: the Rescission came without notice-and-comment rulemaking, improperly applied retroactively, and violated the change-in-position doctrine because it came without explanation or consideration of reliance interests. *Third*, the USPTO

acted outside its limited grant of statutory authority by pressuring petitioners into surrendering defenses that cannot be raised in IPR, effectively expanding the scope of the IPR-estoppel statute.

Cuozzo and *SAS* concluded that the Director enjoyed unreviewable discretion in applying the statutory institution standard, but also made clear the USPTO could not use that general proposition to insulate constitutional problems and shenanigans. Retroactively changing the rules, flouting the requirements of the APA, and expanding the reach of the estoppel provision are such errors.

Mandamus is warranted and the remedy Petitioners seek is modest: the Court should order the USPTO to consider Petitioners' IPR2024-01464 and IPR2024-01465 petitions under the guidelines in place when they were filed.

Issue Statement

1. Did the USPTO violate the Constitution's due process clause and the APA when the Rescission and the 2025 Memo retroactively made *Sotera* stipulations non-dispositive?

2. Did the USPTO exceed its statutory authority—violating the APA and the Constitution's separation of powers—by requiring petitioners

to forgo invalidity defenses beyond the scope of IPR as a condition to weighing *Sotera*-style stipulations against discretionary denial?

Background

A. In 2022, the Director issued “binding” guidance proclaiming that the Board “will not” discretionarily deny an IPR under *Fintiv* if the petitioner makes a *Sotera* stipulation

The America Invents Act (AIA) allocated IPR institution decisions to the Director of the USPTO. 35 U.S.C. § 314(b). Section 314(d) precludes review of institution decisions “where the grounds for attacking the decision ... consist of questions that are closely tied to the application and interpretation of statutes related to the ... decision to initiate inter partes review.” *Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 274-75 (2016). But § 314(d) does not preclude review of what the Supreme Court termed “shenanigans,” such as “a due process problem,” or situations in which the agency “act[s] outside its statutory limits.” *Id.* at 275. The Director’s discretion is thus not boundless.

In 2020, the Director designated as precedential a six-factor test to guide discretionary denial when there are related district-court proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, 2020 WL 2126495, at *2 (P.T.A.B.

Mar. 20, 2020) (precedential). The *Fintiv* framework considered the likelihood of a stay, the trial date, investment in the parallel litigation, whether the parties in the IPR and litigation were the same, and other circumstances such as the merits. *Id.* *Fintiv* also considered the presence of overlapping issues, i.e., whether “the petition include[d] the same or substantially the same claims, grounds, arguments, and evidence” as the parallel litigation. *Id.* at *5. Whether both proceedings would involve “the same prior art” was not the whole inquiry. *Id.* at *6.

The Director refined the *Fintiv* framework through another precedential decision directed to the issue-overlap factor. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, 2020 WL 7049373, at *7 (P.T.A.B. Dec. 1, 2020) (precedential in pertinent part). Under *Sotera*, a promise not to pursue in district court “any ... ground ... that was raised or *could have reasonably been raised in an IPR*” sufficed to “mitigate[] any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Id.* (emphasis omitted). That stipulation was enough to “ensure that an *inter partes* review is a ‘true alternative’ to the district court proceeding.” *Id.*

Faced with allegations that *Fintiv* violated the APA, *see* Complaint, *Apple Inc. v. Iancu*, No. 20-cv-6128 (N.D. Cal. Aug. 31, 2020), ECF No. 1, the USPTO requested public comments on its discretionary-denial policies. *Request for Comments on Discretion to Institute Trials Before Patent Trial & Appeal Board*, 85 Fed. Reg. 66,502, 66,505 (Oct. 20, 2020). After considering “822 comments from a wide range of stakeholders,” the Director issued the 2022 Guidance that partially cabined discretionary denials. Appx38-39. (citing 35 U.S.C. §3(a)(2)(A)). The Director deemed the 2022 Guidance “binding” on the exercise of her delegated discretion until it could be superseded by notice-and-comment rulemaking. Appx39.

The 2022 Guidance restricted exercise of discretion under *Fintiv* in specific circumstances. It announced that if a petitioner makes a *Sotera* stipulation, agreeing “not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that *could have reasonably been raised* in the petition,” then the Board “*will not* discretionarily deny institution” on *Fintiv* grounds. Appx43-44 (emphases added). Because “the grounds the PTAB resolves will differ” from those left for decision before the district court in such cases, a stipulation would “avoid[] inconsistent outcomes.” Appx43-44.

B. Cerence sued Samsung in Texas, asserting five patents and dozens of claims

Cerence sued Samsung in the Eastern District of Texas, accusing it of infringing five patents that “generally relate to improvements in handwritten characters recognition, voice messaging[,] and voice command monitoring for electronic devices.” Complaint, *Cerence Operating Co. v. Samsung Elcs. Co.*, No. 23-cv-00482 (E.D. Tex. Oct. 13, 2023), ECF No. 1. Cerence did not specify which claims it was asserting until it served infringement contentions in March 2024. Appx234. Cerence further adjusted the set of asserted claims in August 2024. Appx246.

C. Samsung and non-litigant Google jointly petitioned for IPR, and Samsung made a *Sotera* stipulation, in reliance on the agency’s then-“binding” guidance

Google and Samsung jointly filed the two IPR petitions at issue here in October 2024. *E.g.*, Appx60-155.² Those petitions challenged U.S. Patent Nos. 11,393,461 and 11,087,750, two of the five patents Cerence had asserted

² Because the discretionary-denial briefing and issues were the same, Petitioners cite IPR2024-01464 here for simplicity.

against Samsung; additional petitions challenged the other asserted patents.³ Samsung moved to stay the Texas litigation pending IPR. Appx9. The district court denied a stay because the IPRs had not yet been instituted, but it did so without prejudice to a renewed motion upon institution. Appx9. The district court also set the case for trial for the same date, and in the same courtroom, as eleven other cases. Appx11.

Each petition raised four obviousness grounds with five total references among them. *See, e.g.*, Appx76. Each was accompanied by a lengthy expert declaration detailing those grounds, as well as the technological backdrop of the art. *See, e.g.*, Appx76-144 (citing Ex. 1002 throughout). In preparing the petitions, Google and Samsung addressed the *Fintiv* factors under precedent and guidance the agency deemed “binding.” *See, e.g.*, Appx145-149. In particular, they explained that the investment, overlap, and merits factors weighed against denial under *Fintiv*. *See, e.g.*, Appx147-149.

³ *Samsung Elecs. Co., Ltd. v. Cerence Operating Co.*, IPR2024-00978 (P.T.A.B. July 24, 2024); *Samsung Elecs. Co., Ltd. v. Cerence Operating Co.*, IPR2024-00979 (P.T.A.B. July 24, 2024); *Samsung Elecs. Co., Ltd. v. Cerence Operating Co.*, IPR2024-01267 (P.T.A.B. Aug. 9, 2024).

Cerence's preliminary response said almost nothing about the petitions' merits other than they were not "compelling." Appx174. Instead, Cerence pushed for denial under *Fintiv*, arguing issue overlap based on Samsung's citation of some of the same references before the district court. Appx172. Cerence also argued that trial was set for a few months before the final written decision would come due and insisted, despite the wildly overbooked trial date, there was "no evidence to suggest" the trial would be delayed. Appx168-170.

Samsung further submitted a *Sotera* stipulation. Appx268. (Google was not a party to any parallel litigation and so had nothing to stipulate.) That stipulation provided an independently sufficient basis to rule out *Fintiv*-based discretionary denial in view of the 2022 Guidance.

D. After discretionary-denial issues were briefed, the Acting Director rescinded the 2022 Guidance

By late February 2025, the parties had briefed discretionary-denial issues, Samsung had made a *Sotera* stipulation, Cerence had not opposed institution on specific merits grounds, and the institution decision was pending. As noted below, similarly situated petitions filed just a few months earlier had already been instituted based on an identical stipulation.

Then, on February 28, 2025, the USPTO posted to its website a notice that it had “rescinded” the 2022 Guidance (“the Rescission”). Appx46. The Rescission offered no explanation for the dramatic change in the agency’s approach and came without prior notice to the public or bar. The USPTO also de-designated as “binding,” or even persuasive, “any” prior decisions of the Board or decisions on Director review “relying on” the 2022 Guidance. *Id.* Notably, the Rescission did explicitly refer parties to the *Fintiv* and *Sotera* decisions “for guidance.” *Id.*

A month later, the USPTO issued a guidance memorandum (the 2025 Memo) about the Rescission. Appx48.⁴ There, the Chief APJ clarified for the first time that the Rescission applied retroactively to any petition in which the Board had not yet issued an institution decision. Appx49. The 2025 Memo underscored that the effect of *Sotera* stipulations was significantly altered: where they were previously “dispositive,” they were now merely “part of [the] holistic analysis” under the Rescission. Appx49-50.

⁴ https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf

The next day, the Acting Director issued a memorandum on “[i]nterim [p]rocesses” the agency would be using each time “the Director will exercise her discretion on institution of AIA proceedings.” Appx51. The Acting Director did not cite the Rescission and did not explain her change to the *Sotera* standard.

As of filing this Petition, Petitioners have collectively received at least seventy Director decisions under that new discretionary denial process—of those, all but two were discretionary denials. Appx279.

E. The Board denied institution based on the retroactivity of the Rescission and a new demand for petitioners to give up defenses beyond the scope of IPRs

1. Discretionary denial on *Fintiv* grounds was ruled out by the guidance and precedent in effect when the petition was filed and when Samsung made its *Sotera* stipulation. Indeed, the Board had instituted IPR on three petitions Google and Samsung filed two months earlier stemming from the same set of asserted patents. Samsung’s *Sotera* stipulations were dispositive in each of those cases. *See Samsung Elecs. Co. v. Cerence Operating Co.*, IPR2024-00978, 2025 WL 495613, at *3 (P.T.A.B. Feb. 13, 2025); *Samsung Elecs. Co. v. Cerence Operating Co.*, IPR2024-00979, 2025 WL 355171, at *3

(P.T.A.B. Jan. 31, 2025); *Samsung Elecs. Co. v. Cerence Operating Co.*, IPR2024-01267, 2025 WL 355169, at *3 (P.T.A.B. Jan. 31, 2025).

The Rescission issued a few weeks after those institution decisions. Here, the Board permitted five pages of supplemental briefing for the parties to address discretionary denial under the Rescission. Appx270. Cerence argued that Samsung’s *Sotera* stipulation giving up overlapping grounds was “no longer sufficient” and that any viable stipulation must give up *any art* from the IPR. Appx183-184. Although Cerence had complained of supposed overlap in art, Petitioners explained that Cerence was relying on early disclosures in the litigation made for preservation purposes under the local rules—not the *actual* issues for trial. Appx198. Furthermore, Petitioners explained that the IPR was Google’s *only* current forum to litigate its invalidity challenge. Appx199.

2. The Board denied institution of the petitions challenging the ’461 and ’750 patents purely on *Fintiv* grounds. Appx8; *see also* Appx24. Most relevant here, the Board agreed with Cerence that the Rescission effectively nullified *Sotera* stipulations. Appx14-16. Not only that: they were no longer good even as one of many factors. *Id.* The USPTO’s new position was that a petitioner may need to go further and give up grounds *involving* any art

raised in the IPR, even if such *grounds* could not be raised in the IPR because, for example, they were additionally premised on public use or sales. Appx15. According to the Board, such broader stipulations were necessary to ensure IPR was a “true alternative” to district-court litigation. *Id.*

3. Google and Samsung requested Director review on grounds that the agency’s non-institution decision was both *ultra vires* and impermissibly retroactive. Appx206-210.

Their review request explained that the Board’s attempt to compel defendants to surrender defenses beyond the IPR estoppel statute was the kind of *ultra vires* “shenanigans” contemplated in *Cuozzo*. Appx206-207. Google and Samsung also explained that they had relied on the “binding” 2022 Guidance and that the agency’s course-change without a reasoned explanation or consideration of reliance interests deprived them of due process. Appx209-210. The agency’s new position under the Rescission required that a petitioner’s stipulation go well beyond *Sotera* to have effect in the *Fintiv* analysis and must make IPRs a “true alternative” to district court proceedings, even though by statute they cannot be. Appx207.

In response, Cerence insisted the Rescission did not change any statute, regulation, or liability standard. Appx226-227. Cerence did not dispute

that the agency moved the goalposts for the kinds of stipulations that would suffice under *Fintiv*. Instead, it argued the Board had “recognized” that *Sotera* stipulations were “gamesmanship” because they did not foreclose using patents or printed publications in combinations based on system art that could not be raised in any IPR. Appx228-229.

The Acting Director summarily denied review in a single order addressing both petitions. Appx1-2.

Legal Standard

This Court has jurisdiction to review any petition for a writ of mandamus challenging a denial of IPR institution. *Mylan Labs. Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1381 (Fed. Cir. 2021). A petitioner must show (1) “a clear and indisputable legal right,” (2) that “it does not have any other adequate method of obtaining relief,” and (3) that “the writ is appropriate under the circumstances.” *Id.* at 1382.

Why Mandamus Is Warranted

I. Petitioners’ right to relief is clear and indisputable

“[J]udicial review is available in extraordinary circumstances by petition for mandamus” in cases of “decisions denying institution.” *In re Palo Alto Networks, Inc.*, 44 F.4th 1369, 1374 (Fed. Cir. 2022) (citation omitted).

Extraordinary circumstances happened here because the USPTO made the Rescission retroactive without proper procedure and effectively expanded the IPR estoppel statute.

A. *Mylan* does not bar mandamus

As a threshold matter, *Mylan* does not preclude writ relief here, notwithstanding the government’s argument elsewhere that mandamus is limited to “colorable constitutional claims.” See Acting Director’s Response, *In re SAP Am., Inc.*, No. 25-132 (Fed. Cir. July 18, 2025) (“U.S. SAP Opp.”), ECF No. 39 at 1, 11 (citation omitted). *Mylan*’s conclusion that “there is no reviewability of the Director’s exercise of his discretion to deny institution except for colorable constitutional claims” refers to reviewing *unfettered* discretion—which was the case in the two cases *Mylan* relied on. 989 F.3d at 1382 (discussing *Webster v. Doe*, 486 U.S. 592, 603-04 (1988) (“absolute discretion”); *Woodward v. United States*, 871 F.2d 1068, 1072 (Fed. Cir. 1989) (“generally unfettered” discretion)). *Mylan* did not rule out review where discretion was fettered. *Mylan* also did not rule out challenges to the underlying rules—as necessarily recognized by this Court permitting a challenge to a discretionary-denial rule to proceed despite §314(d) in *Apple Inc. v. Vidal*, 63 F.4th 1, 14-15 (Fed. Cir. 2023). Petitioners’ arguments are also different in

kind from *Mylan*'s.⁵ Petitioners are not challenging the Acting Director's exercise of discretion she possessed, or the substance of her decision—Petitioners challenge the Rescission itself as a rule, and contend the Acting Director *purported* to have discretion she did not *actually* have—e.g., because it was unequivocally surrendered.

The challenge here turns on the Rescission's non-compliance with the APA, the statutory limits on the Director's authority, and the Constitution. This Court held in *Apple*, 63 F.4th at 14-15, that §314(d) does not insulate the agency from a challenge to its rules—including that it failed to follow required procedures under the APA. That was not a novel legal theory; the government's rescission of DACA was reviewable under the APA despite similar statutory provisions dictating unreviewability of removal orders. *DHS v. Regents of the Univ. of Cal.*, 591 U.S. 1, 19 (2020). This Court has also confirmed

⁵ Petitioners understand *Mylan*'s argument regarding 35 U.S.C. §316(a)(2) to have been an allegation that *Fintiv* exceeded the USPTO's statutory authority, and not that it violated the APA by not providing notice and an opportunity to comment on *Fintiv*'s precedential designation.

that reviewable “shenanigans” include “blatant violations of legal constraints.” *IGT v. Zynga Inc.*, No. 23-2262, 2025 WL 2045301, *6 (Fed. Cir. July 22, 2025) (precedential).

Finally, if this Court reads *Mylan* to categorically limit mandamus challenges from IPR petition denials to colorable constitutional challenges, that limitation is inconsistent with prior Supreme Court and Federal Circuit decisions. See *In re Power Integrations, Inc.*, 899 F.3d 1316, 1321 (Fed. Cir. 2018) (describing “circumstances described by the Supreme Court” in which challenges from institution denials could be justified, including “constitutional issues” and “actions by the agency beyond its statutory limits” (citing *Cuozzo*, 579 U.S. at 273-74; *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 370-71 (2018)); *Thryv, Inc. v. Click-to-Call Techs., LP*, 590 U.S. 45, 54 n.6 (2020) (leaving open possibility of mandamus in “extraordinary,” not merely constitutional, case); *Deckers Corp. v. United States*, 752 F.3d 949, 965 (Fed. Cir. 2016) (explaining that panels are bound by prior panel decisions “until they are overruled by the court en banc or the Supreme Court”).

B. The USPTO violated the Constitution and the APA by retroactively making *Sotera* stipulations non-dispositive

Under “binding” guidance operating before the Rescission, Petitioners had a right for their petitions to proceed to an institution decision on the merits. The 2022 Guidance waived the Director’s discretion to deny petitions on parallel-litigation grounds if the petitioner made a *Sotera* stipulation. Appx43-44. That is what Samsung did. Appx268-269.⁶ Petitioners prepared and filed their IPR petitions, and Samsung offered that stipulation, in reliance on expectations established by the 2022 Guidance. The Rescission flipped those expectations without explanation and changed the result by rendering Samsung’s *Sotera* stipulation not only non-dispositive but non-significant. Appx14-16. Retroactively applying the Rescission to this case violated Petitioners’ procedural right to have institution considered on the merits (or to be precise, not be denied institution based on *Fintiv* when a *Sotera* stipulation is presented) in two ways: as a violation of due process and as a violation of the APA.

⁶ Google was not a litigant and had nothing to stipulate to in litigation. See also *Samsung*, 2025 WL 495613, at *3 (explaining, instituting IPR weeks earlier, that “Google LLC’s presence in this proceeding does not raise the concerns that a *Fintiv* analysis is designed to address”).

1. The agency violated Petitioners’ due process rights

“[T]he Due Process Clause provides that certain substantive rights—life, liberty, and property—cannot be deprived except pursuant to constitutionally adequate procedures.” *Cleveland Bd. of Educ. v. Loudermill*, 470 U.S. 532, 541 (1985). Here, the agency violated Petitioners’ due process rights by retroactively applying the Rescission to their IPR petitions.

a. The 2022 Guidance created a protected interest for petitioners in reaching an institution decision on the merits when they made the stipulation based on the agency’s having “restrict[ed] the exercise of official discretion.” *Tarpeh-Doe v. United States*, 904 F.2d 719, 722-23 (D.C. Cir. 1990); see *Olim v. Wakinekona*, 461 U.S. 238, 249 (1983) (protected interest is created “by placing substantive limitations on official discretion”).

Even where the government possesses significant discretion, a protectable interest exists if the government “plac[es] substantive limitations” on that discretion. *Ky. Dep’t of Corrections v. Thompson*, 490 U.S. 454, 462 (1989) (citation omitted). For example, the government is given exceptional discretion in prison administration. But prison-created rules limiting that discretion have given incarcerated persons protected interests “in parole, in good-time credits, in freedom from involuntary transfer to a mental hospital, and

in freedom from more restrictive forms of confinement within a prison,” to name a few. *Id.* at 461 (citations omitted). “[T]he most common manner” by which the government creates such an interest involves “establishing ‘substantive predicates’ to govern official decision-making and ... by mandating the outcome to be reached upon a finding that the relevant criteria have been met.” *Id.* at 462 (citation omitted).⁷

The 2022 Guidance did just that. It prohibited discretionary denial on *Fintiv* grounds so long as the petitioner made a *Sotera* stipulation. Appx43-44. The unequivocal command invoked the Director’s “authority to issue binding agency guidance” governing the Board. Appx39. The 2022 Guidance thus “restrict[ed] the exercise of official discretion” with “‘explicit mandatory language.’” *Tarpeh-Doe*, 904 F.2d at 722-23 (quoting *Thompson*, 490 U.S. at 463). That guidance dictated that the Board “will not” deny institution on *Fintiv* grounds if the petition was supported by a *Sotera* stipulation.

⁷ The restriction-of-discretion standard is not confined to prison contexts; it is a general test. *See, e.g., Wash. Legal Clinic for the Homeless v. Barry*, 107 F.3d 32, 36 (D.C. Cir. 1997) (housing benefits); *Laborde-Garcia v. Puerto Rico Tel. Co.*, 993 F.2d 265, 267 (1st Cir. 1993) (employment); *Jacobs, Visconsi & Jacobs, Co. v. City of Lawrence*, 927 F.2d 1111, 1117 (10th Cir. 1991) (property rezoning).

Appx43-44. *See Thompson*, 490 U.S. at 463 (collecting cases holding that “shall” language limits discretion). Regardless of any flaws in the guidance’s enactment, Petitioners were entitled to rely on it as an existing, and deemed “binding,” agency rule.

That voluntary restriction of agency discretion gave *Sotera*-stipulating petitioners a “legitimate entitlement” to have their petitions considered on the merits. *See Tarpeh-Doe*, 904 F.2d at 722-23. It was a protected interest for due-process purposes. *See Thompson*, 490 U.S. at 463 (“use of ‘explicitly mandatory language,’ in connection with the establishment of ‘specified substantive predicates’ to limit discretion,” created protected interest (citations omitted)); *Perry v. Sindermann*, 408 U.S. 593, 601 (1972) (“A person’s interest in a benefit is a ‘property’ interest for due process purposes if there are such rules or mutually explicit understandings that support his claim of entitlement to the benefit.”); *Furlong v. Shalala*, 156 F.3d 384, 395 (2d Cir. 1998) (“[P]roperty interests may be established through such diverse sources as unwritten common law and informal institutional policies and practices.”). The Supreme Court has contrasted “completely unfettered” discretion, on the one hand, with expressly limited discretion as set out under the

2022 Guidance, on the other. *Thompson*, 490 U.S. at 462 (citation omitted) (collecting cases).

Petitioners also had a protected interest in the fees and costs they expended preparing and filing their petitions—including the IPR request fees, *see* 37 C.F.R. §42.15(a)(1)—under the reasonable expectation that pairing the IPR petitions with a *Sotera* stipulation would lead to a decision on the merits at institution under the agency’s “binding” guidance. The agency collects the request fee for that very reason. There are two sets of fees paid to the USPTO upon filing an IPR petition: a non-refundable request fee and a post-institution fee that can be refunded if institution is denied. *See* 37 C.F.R. §§42.15(a)(1) (*Inter Partes* Review request fee (\$23,750), 42.15(a)(2) (*Inter Partes* Review Post-Institution fee (\$28,125)). The agency calculates those fees based on an estimate of the number of needed APJ hours. *See, e.g., Rules for Practice for Trials Before the Patent Trial & Appeal Board*, 77 Fed. Reg. 6879, 6897 (Feb. 9, 2012) (estimating “98.7 hours of judge time” required for an IPR petition challenging up to 20 claims). After all, the statute requires a decision “in writing, of the Director’s determination under subsection (a),” 35 U.S.C. § 314(c), and the only determination set forth in subsection (a) is the

“determin[ation] ... [whether] there is a reasonable likelihood that the petitioner would prevail,” *id.* §314(a). But none of that work took place because the Director denied the petitions without them ever getting to a panel of APJs. No such determination is being made under the Director’s new procedures, despite the requisite fee paid for this review.

b. The agency’s deprivation of those interests was procedurally inadequate. The Rescission included no justification for the about-face, the Acting Director solicited no input from the public, and Petitioners were caught unaware with no opportunity to conform their previously filed petitions to the new and radically different standard, or to instead choose not to expend the resources in preparing the petitions in the first place.

“To satisfy the Due Process Clause,” an agency must “provide regulated parties fair warning of the conduct a regulation prohibits or requires.” *Mexichem Fluor, Inc. v. EPA*, 866 F.3d 451, 462 (D.C. Cir. 2017) (citation omitted). The government failed to meet that standard because it drastically changed the effect of *Sotera* stipulations with no advance notice and no regard for established reliance interests, particularly those of parties like Petitioners who had *already* filed petitions under the suddenly rescinded 2022 Guidance.

Moreover, the agency deprived Petitioners of their request fee without the requisite process—consideration of the petitions on the merits for institution purposes. That was the required process because it was the premise of the agency’s fee collection in the first place and the result Petitioners were told they could expect if they followed the “binding” 2022 Guidance.

The agency has argued that the Rescission was not retroactive because it was applied “only to cases in which a final decision on institution had not yet been made” and because the Board has allowed supplemental briefing in pending cases. *Motorola Sols, Inc. v. Stellar, LLC*, IPR2024-01284, 2025 WL 1503220, at *2 (P.T.A.B. May 23, 2025). But the retroactivity question is not whether the rule applied to *future decisions* but whether it applied to *past acts*—“whether the new provision attaches new legal consequences to events completed before its enactment.” *Landgraf v. USI Film Prods.*, 511 U.S. 244, 269-70 (1994). Here, Samsung made a *Sotera* stipulation, developed its district-court positions, and prepared and filed their IPR petitions under the expectation that the rule in effect at the time would apply. Petitioners relied on the existing 2022 Guidance’s assurances that Samsung’s *Sotera* stipulation would foreclose discretionary denial on *Fintiv* grounds. In reliance on those assurances, Petitioners paid non-refundable request fees to the agency. Non-

litigant Google also jointly petitioned for IPR with litigant Samsung relying on the assurances that the co-pending litigation would not block the petitions on *Fintiv* grounds if a *Sotera* stipulation was made.

The Board permitted supplemental briefing at Cerence's request, but that was cold comfort because that briefing could not cure the due process problem. The agency did not provide notice and opportunity to comment on the promulgation of the retroactive Rescission itself. But regardless, the due-process issue was not lack of notice of and opportunity to address the applicability of the Rescission to institution—it was that Petitioners had no “reasonable opportunity ... to conform to the changed requirements” because the USPTO applied a new set of criteria to *already set* facts.

2. The agency violated the APA

Despite § 314(d), “[i]f a party believes the Patent Office has engaged in shenanigans by exceeding its statutory bounds, judicial review remains available consistent with the Administrative Procedure Act, which directs courts to set aside agency action not in accordance with law or in excess of statutory jurisdiction, authority, or limitations.” *SAS*, 584 U.S. at 371 (cleaned up). Here, the agency violated the APA in three ways.

a. The Rescission was a rule change effected without notice-and-comment rulemaking

The APA requires agencies to promulgate rules through notice and comment, aside from “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.” 5 U.S.C. § 553(b). And the AIA required that the Director “shall prescribe” regulations governing IPR. 35 U.S.C. § 316(a). Agency action must be set aside if the agency failed to follow the APA’s rulemaking requirements. *See, e.g., Gen. Elec. Co. v. EPA*, 290 F.3d 377, 385 (D.C. Cir. 2002) (vacating EPA guidance document for failure to follow notice-and-comment procedures); *Coal. for Common Sense in Gov’t Procurement v. Sec’y of Veterans Affs.*, 464 F.3d 1306, 1317 (Fed. Cir. 2006) (vacating VA’s letter to industry for same reason). An agency’s pronouncement is a substantive rule, subject to notice-and-comment requirements, if it “effect[s] a change in existing law or policy or ... affect[s] individual rights and obligations.” *Coal. for Common Sense*, 464 F.3d at 1317 (citation omitted).

The Rescission was a substantive rule. It both effected a change in existing law or policy and affected individual rights and obligations because it rescinded Petitioners’ right to avoid *Fintiv*-based denial by making a *Sotera*

stipulation. Before the Rescission, *Sotera* stipulations triggered that right under a bright-line rule that the Director issued as “binding” agency policy. Appx39. The Rescission withdrew that right, and the agency has acknowledged that withdrawal resulted in a change in law or policy. Appx46; Appx48-50. Moreover, the Rescission altered the “substantive standards by which the USPTO evaluates” IPR petitions. *See In re Chestek PLLC*, 92 F.4th 1105, 1110 (Fed. Cir. 2024).

Accordingly, because the Rescission is invalid for failure of the agency to follow notice-and-comment rulemaking procedures, *see* 35 U.S.C. § 316(a); 5 U.S.C. §§ 553, 706(2)(D), the non-institution decision must be vacated.

The current chaos around discretionary denials underscores the need for notice-and-comment rulemaking in this area. The Acting Director is increasingly denying petitions in batches while making up previously unannounced standards along the way⁸—even applying new ones no one asked

⁸ *See, e.g.,* Theresa Schliep, *With Discretionary Denials, PTAB Accepting Fewer Petitions*, Law360 (July 16, 2025), <https://www.law360.com/ip/articles/2360783/> (institution rate has plummeted to 20% for the month of July); Ryan Davis, *PTAB Ramps Up Fintiv Denials After Withdrawal of Memo*, Law360 (May 13, 2025), <https://www.law360.com/articles/2339744> (institution rate was between 58–68% before 2025, but fell to 44% in April). “On July 25, 2025, the FAQs were updated to add a new FAQ 10 under the

for.⁹ That storm of unpredictability threatens the viability of the IPR system that Congress created: not only is the USPTO now denying an abundance of petitions *regardless of their merits*, but petitioners have no idea whether the agency will follow its own rules from one day (or administration) to the next. The whole point of notice-and-comment requirements is to ensure public participation, 5 U.S.C. § 553(c), and “fairness and deliberation,” *United States v. Mead Corp.*, 533 U.S. 218, 230 (2001), in the rulemaking process—and to ensure agencies are transparent and “accountable to the public.” *Regents*, 591 U.S. at 16 (citation omitted). Those concerns are especially keen here.

Procedures/processes tab,” which explained the Office’s view that the Director is not limited by the parties’ arguments. See <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>, *as archived at* <https://perma.cc/2BDY-X2JL>).

⁹ See, e.g., Anthony Insogna, *Acting Director Denies IPR Institution Based on “Settled Expectations,”* PTAB Litig. Blog (July 8, 2025), <https://www.ptablitigationblog.com/acting-director-denies-ipr-institution-based-on-settled-expectations/> (citing examples in which Director denied institution on grounds of “settled expectations” even though the petitioner did not raise that argument).

b. Regardless of whether the Rescission was a rule or a policy change, its retroactive application violated the APA

Whether the Rescission is deemed a rule or a “statement[] of policy,” 5 U.S.C. § 552(a)(2)(B), the agency violated the APA by applying it retroactively. That retroactive application was “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law,” *id.* § 706(2)(A).

Policy statements “advise the public *prospectively* of the manner in which the agency proposes to exercise a discretionary power.” *Lincoln v. Vigil*, 508 U.S. 182, 197 (1993) (citation omitted) (emphasis added). On the other hand, if the Rescission qualified as a rule—even assuming the lack of notice-and-comment rulemaking is not fatal in itself—rules “are presumed not to have retroactive effect,” *Durr v. Nicholson*, 400 F.3d 1375, 1380 (Fed. Cir. 2005), and “will not be construed to have retroactive effect unless their language requires this result,” *Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988). The USPTO rescinded the 2022 Guidance with a short statement stating only that it was rescinded; nothing in the Rescission requires retroactive application. Appx46. And while the USPTO’s subsequent statements explained its intention to apply the Rescission retroactively, that does not flow from the Rescission’s language. Further, the USPTO lacks “the

power to promulgate retroactive rules” because that power was not “conveyed by Congress in express terms.” *Bowen*, 488 U.S. at 208.

The 2022 Guidance should therefore have applied to the petitions at issue here. *See Durr*, 400 F.3d at 1380 (error to apply procedural rule promulgated after filing but before decision). Cerence argued before the agency that applying the Rescission here would not be “retroactive” because Petitioners were permitted to address the guidance. Appx226. But that is wrong. The Rescission had retroactive effect here because it arose after Google and Samsung filed their petitions and Samsung made its *Sotera* stipulation. Petitioners acted in reliance on the 2022 Guidance, when it was still in effect. Under the 2022 Guidance, the agency surrendered any discretion to issue a *Fintiv* denial once Samsung made its *Sotera* stipulation.

c. The agency also violated the APA under the change-in-position doctrine

The USPTO “told [petitioners] in guidance documents that it would do one thing” when it promised that it would not deny petitions on *Fintiv* grounds if accompanied by a *Sotera* stipulation, and it “then turned around and did something different” by issuing and applying the Rescission during the pendency of the IPR petitions. *See FDA v. Wages & White Lion Invs., L.L.C.*,

145 S. Ct. 898, 917 (2025). That violated the change-in-position doctrine, which prohibits an agency from changing policies without “provid[ing] a reasoned explanation for the change, display[ing] awareness that [it is] changing position, and consider[ing] serious reliance interests.” *Id.* (cleaned up).

The change-in-position doctrine “asks two questions.” *Id.* at 918. The first is whether the agency “changed existing policy.” *Id.* The answer here is yes. The agency did so when it rescinded its prior mandatory policy of not denying institution based on parallel litigation if the petitioner made a *Sotera* stipulation. That was “inconsistent[] with an earlier position,” a “reversal of its former views as to the proper course,” and a “disavow[al] [of] prior inconsistent agency action as no longer good law.” *Id.* (cleaned up). The agency has acknowledged its change repeatedly: it expressly “rescinded” the 2022 Guidance, Appx46; the 2025 Memo acknowledged that *Sotera* stipulations were no longer “dispositive,” Appx49-50; and the Board has consistently described the Rescission as a “change of binding guidance,” *see, e.g., Dell Inc. v. Universal Connectivity Techs. Inc.*, IPR2024-01478, 2025 WL 1090038, at *1 (P.T.A.B. Apr. 7, 2025); *HP Inc. v. Universal Connectivity Techs. Inc.*, IPR2024-

01428, 2025 WL 1040187, at *1 (P.T.A.B. Apr. 8, 2025); *Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01374, 2025 WL 1249839, at *3 (P.T.A.B. Apr. 29, 2025). Cerence described the agency's conduct the same way. Appx271 (citing "the changing circumstances for discretionary denial" based on the Rescission and the "shift" under it).

To be clear, the change-in-position doctrine would apply whether or not the 2022 Guidance or Rescission were in fact binding. It has applied "to an agency's divergence from a position articulated in nonbinding guidance documents" or "policy statement[s]." *Wages & White Lion*, 145 S. Ct. at 918 n.5. So while the express terms of the 2022 Guidance, Appx37-45, its apparent consistent application, and the later characterizations in the 2025 Memo, Appx48-50, all confirm that the agency considered its 2022 Guidance binding, the doctrine applies regardless of whether that is so.

The second question is whether the agency "display[ed] awareness that it [was] changing position" and offered "good reasons for the new policy." *Wages & White Lion*, 145 S. Ct. at 918 (citation omitted). And in "explaining its changed position, an agency must also be cognizant" of "serious reliance interests" related to its prior policy "that must be taken into ac-

count.” *Encino Motorcars, LLC v. Navarro*, 579 U.S. 211, 221-22 (2016) (quoting *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 515 (2009)). A “reasoned explanation is needed for disregarding facts and circumstances that underlay or were engendered by the prior policy.” *Id.* (quoting *Fox*, 556 U.S. at 515-16).

The agency failed to do that here despite acknowledging the policy change. Appx46 (“rescind[ing]” the 2022 Guidance); Appx49-50 (acknowledging *Sotera* stipulations were no longer “dispositive”). The agency offered *no* explanation for the change—it merely announced its effect. *See* Appx46; Appx48-50. And there is nothing in the record suggesting the agency accounted for the serious reliance interests of parties like Samsung and Google here, who developed and coordinated district-court and IPR strategies based on the agency’s promises. That failure to account for “significant reliance,” *Encino*, 579 U.S. at 222; *Regents*, 591 U.S. at 30, is true both for the Rescission *and* the agency’s unexplained decision to apply it retroactively. Appx48-50. That the agency “failed to address” reliance confirms that its actions were arbitrary and capricious. *Regents*, 591 U.S. at 30

C. The USPTO’s extra-statutory expansion of statutory IPR estoppel violates the Constitution’s separation of powers

Under the Rescission, as clarified by additional pronouncements, petitioners must consider whether to surrender all *art*, not just *grounds*, involved in the IPR for a *Sotera* stipulation to have its desired effect. If the Board demanded petitioners give up challenges based on § 112 or § 101, that unquestionably would cross “outside its statutory limits,” *Cuozzo*, 579 U.S. at 275, because IPRs are statutorily limited to novelty and obviousness grounds. It is no different for the Board to demand surrender of grounds involving system art as a condition for conducting an IPR because IPRs are statutorily limited to grounds based on patents and printed publications. For any petitioner who accedes to those demands, the result is *de facto* estoppel against raising any such invalidity grounds at all. The Board’s newfound demands on petitioners thus expand the effective scope of estoppel beyond statutory bounds for the IPRs it institutes. That constitutes action “in excess of statutory jurisdiction, authority, or limitations” under the APA, 5 U.S.C. § 706, and a violation of the Constitution’s separation of powers.

To the extent the Board considered Samsung’s *Sotera* stipulation as part of a “holistic” analysis, it deemed the stipulation insufficient because

Samsung did not surrender grounds based on system art. Appx14-15. The Board acknowledged system art could never be raised in any IPR, but it nonetheless found the stipulation deficient because Samsung had preserved the right to cite some of the IPR art within system-art combinations. Appx15-16. The Board concluded IPR would thus not be a “true alternative” to litigation in this case, Appx15, even though *Sotera* held waiving *grounds* available in IPR was enough to make IPR a “true alternative.” *Sotera*, 2020 WL 7049373, at *7. The Board also relied on *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, at 3-4 (P.T.A.B. Mar. 28, 2025) (mandamus petition pending, No. 25-134), which followed the Rescission and reflected the agency’s newfound standard requiring more expansive stipulations. The Board’s analysis made clear that petitioners hoping to file a stipulation with substantive effect in the *Fintiv* analysis now must give up their unpatentability challenges based on system-art combinations that *could not* have been raised in the IPR.¹⁰ In such cases, when it institutes, the Board expands the effective scope of the IPR estoppel.

¹⁰ See, e.g., Denying Request for Discretionary Denial, *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9, at 2 (P.T.A.B. June 13, 2025)

That brazen approach exceeds the scope of the IPR statute, arrogates authority reserved to Congress, and constitutes the kind of extra-statutory “shenanigans” contemplated by *Cuozzo*. 579 U.S. at 275. The scope of estoppel is limited to “ground[s] that the petitioner raised or reasonably *could have raised*” in the IPR. 35 U.S.C. §315(e)(2) (emphasis added). The Board disregarded Samsung’s stipulation because it did not prevent some of the IPR *art* from being raised before the district court, but “a ground is not the prior art asserted during an IPR.” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365 (Fed. Cir. 2025). Congress *could have* extended estoppel to all art in the IPR but did not. *Id.* at 1365-66. IPR estoppel does not preclude a petitioner from invalidity positions in district court that combine system art with patents and printed publications that were raised or could have been raised in other grounds in an IPR. *Id.* at 1366-67. Importing that requirement by coercion “renders superfluous” the limits in the IPR statute. *See Unwired Planet, LLC v. Google Inc.*, 841 F.3d 1376, 1382 (Fed. Cir. 2016).

(crediting “broad stipulation”); Opposition to Request for Discretionary Denial, *id.*, Paper 8, at 10–12 (stipulation disclaiming system art combined with any IPR art); *Tesla, Inc. v. United States*, IPR2025-00341, Paper 12 (P.T.A.B. June 13, 2025) (same).

The agency later suggested a *Sotera* stipulation “may not be particularly meaningful” if art from surrendered grounds remains available for invalidity combinations that could not have been raised via IPR, but that statement underscores the *ultra vires* nature of this new standard. Appx56. Congress already defined to what extent IPRs are an alternative to district-court litigation. And Congress chose not to extend estoppel to all *art* that was raised—or to grounds involving *system* art that cannot be raised in IPR at all.

Courts regularly declare unlawful agency actions that similarly conflict with congressional design. *See, e.g., Util. Air Regul. Grp. v. EPA*, 573 U.S. 302, 322-27 (2014) (agency’s rule “would deal a severe blow to the Constitution’s separation of powers” where it was “inconsistent with” the statutory structure and in excess of the statutory thresholds; statute defined numerical thresholds for regulatory review, and “[w]hen EPA replaced those numbers with others of its own choosing, it went well beyond the ‘bounds of its statutory authority’” (citation omitted)); *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 462 (2002) (agency lacked authority “to develop new guidelines or to assign liability in a manner inconsistent with” an “unambiguous statute”); *City of Providence v. Barr*, 954 F.3d 23, 26, 45 (1st Cir. 2020) (holding it unlawful for agency to condition law-enforcement grants on additional terms

not included in statute); *see also Civil Aeronautics Bd. v. Delta Air Lines, Inc.*, 367 U.S. 316, 328 (1961) (questioning agency’s “power to do indirectly what it cannot do directly”), *cited in SAS*, 584 U.S. at 368 n.*. The Court should do the same here.

II. Petitioners have no other adequate means to obtain relief

Having exhausted administrative remedies, Petitioners have no other avenue to obtain relief. Precisely because “there is no adequate remedy by way of direct appeal of decisions denying institution,” this Court has “conclude[d] that judicial review is available in extraordinary circumstances by petition for mandamus.” *Palo Alto*, 44 F.4th at 1374 (alteration in original) (citation omitted). It would not afford meaningful relief to proceed against the agency in district court to challenge the Rescission under the APA; a district court’s review of the lawfulness of the Rescission in the abstract would not provide any relief with respect to the specific IPR petitions here.

III. Mandamus relief is appropriate under the circumstances

“[W]hen the Board denies institution, [this Court’s] mandamus jurisdiction is especially important” because a decision denying institution “defeats [the Court’s] prospective jurisdiction.” *Mylan*, 989 F.3d at 1380 (cita-

tion omitted); *see* 28 U.S.C. §1651(a). Because of the unpredictability and significant effect of the Director’s new approach, mandamus is especially appropriate here.

AIA trial practice is in a tumult. There are “unsettled” but “fundamental” legal issues at play. *In re Google LLC*, 949 F.3d 1338, 1341-42 (Fed. Cir. 2020) (citation omitted). And there is a pressing need to resolve those issues. The Acting Director has been denying a flood of petitions in batches and creating new rules along the way such that the need for notice-and-comment rulemaking and predictability is more acute than it has been at any time since the *Fintiv* rule came out. As the rate of discretionary denials balloons, unreliable and rapidly shifting IPR institution standards threaten to effectively kneecap the statutory IPR process. Yet because of their nature and the unavailability of direct appeal, “it is unlikely that ... these issues will be preserved and presented to this court through the regular appellate process.” *Id.* at 1342. Mandamus is appropriate to resolve “substantial uncertainty and confusion” about the state of discretionary denial. *In re MSTG, Inc.*, 675 F.3d 1337, 1342 (Fed. Cir. 2012) (citation omitted).

Furthermore, IPR petitions cost hundreds of thousands of dollars in agency, legal, and expert fees to prepare and file,¹¹ and “the substantial expense to the parties that would result from” an unlawful approach by the agency also “confirms” the need for review now. *Google*, 949 F.3d at 1342-43. Mandamus is thus appropriate to ensure that parties who relied on agency guidance deemed “binding” are not penalized.

Finally, discretionary denial is relevant only to petitions where there is a reasonable likelihood the petitioner will prevail on at least one challenged claim. Br. of *Amicus Curiae* CCIA at 20-21, *In re Motorola Sols., Inc.*, No. 25-134 (Fed. Cir. June 27, 2025), ECF No. 15-2. Mandamus is appropriate because permitting an unlawful framework to insulate invalid claims “would undermine the claimed important public interests,” *MSTG*, 675 F.3d at 1342, in AIA proceedings. See Br. of *Amicus Curiae* Public Interest Pat. Law Inst. at 10-13, *In re SAP Am., Inc.*, No. 25-132 (Fed. Cir. June 20, 2025), ECF No. 13 (detailing public interest).

¹¹ See, e.g., Br. of Dell Inc. et al. as *Amici Curiae*, *Cuozzo Speed Techs., LLC v. Lee*, No. 15-446, 2016 WL 1319652, at *23 (U.S. Mar. 30, 2016); 37 C.F.R. §42.15(a).

Conclusion

The Court should direct the USPTO to apply the discretionary-denial guidance in place when the IPR petitions were filed.

Respectfully submitted,

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Certificate of Compliance with Type-Volume Limitation

This petition complies with the relevant type-volume limitations of the Federal Rules of Appellate Procedure and the Federal Circuit Rules because it has been prepared using a proportionally spaced 14-point typeface and includes 7,792 words, excluding the portions exempted by rule.

Dated: August 18, 2025

/s/Nathan K. Kelley

Nathan K. Kelley

Certificate of Authority

I certify that I have the authority of Ali R. Sharifahmadian to file this document with his electronic signature.

Dated: August 18, 2025

/s/Nathan K. Kelley

Nathan K. Kelley

Proof of Service

I certify that on August 18, 2025, I caused a paper copy of this document (and the attached appendix, entries of appearance, certificates of interest, and notices of related cases) to be sent by express carrier to lead counsel for respondent Cerence Operating Co. at the following address:

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I further certify that I caused courtesy electronic copies of this document (and the attached appendix, entries of appearance, certificates of interest, and notices of related cases) to be sent to Qi (Peter) Tong at ptong@raklaw.com and to the following additional counsel of record for respondent:

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copy of this document to be sent by an express carrier to the following address:

Office of the Solicitor
United States Patent and Trademark Office
Mail Stop 8
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Alexandria, VA 22313-1450

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: August 18, 2025

/s/Nathan K. Kelley
Nathan K. Kelley

2025-____

United States Court of Appeals for the Federal Circuit

In re Google LLC, Samsung Electronics Co., Ltd.,
Samsung Electronics America, Inc.

Petitioners

On petition for a writ of mandamus to the United States Patent and
Trademark Office, Patent Trial and Appeal Board,
in Nos. IPR2024-01464, IPR2024-01465

Appendix to Petition for a Writ of Mandamus

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August 18, 2025

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¹ "-01464" is IPR2024-01464. "-01465" is IPR2024-01465.

² The administrative materials were not exhibits or papers in the IPR and therefore do not have a docket number but were published by the agency.

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		https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management [https://web.archive.org/web/20250528173846/https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management]	
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³ The relevant portions of the cited materials are substantively identical between IPR2024-01464 and IPR2024-01465.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED
STATES PATENT AND TRADEMARK OFFICE

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD, and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

CERENCE OPERATING COMPANY,
Patent Owner.

IPR2024-01464 (Patent 11,393,461 B2)
IPR2024-01465 (Patent 11,087,750 B2)¹

Before MICHELLE N. ANKENBRAND,² *Senior Lead Administrative
Patent Judge, performing the duties of Director Review Executive.*

ORDER

¹ This order applies to each of the above-listed proceedings. All citations are to the record in IPR2024-01464. Similar papers were filed in IPR2024-01465.

² Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office, is recused and took no part in this decision. The Acting Director delegated her authority as set forth in the Notice of Delegation entered in this case. *See* Paper 18.

IPR2024-01464 (Patent 11,393,461 B2)

IPR2024-01465 (Patent 11,087,750 B2)

The Office received a request for Director Review of the Decision denying institution in each of the above-captioned cases and an authorized response to each request. *See* Papers 16, 17.

Having reviewed the requests and responses, it is:

ORDERED that the requests for Director Review are denied.

IPR2024-01464 (Patent 11,393,461 B2)

IPR2024-01465 (Patent 11,087,750 B2)

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Paper 15
Date: April 23, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

CERENCE OPERATING COMPANY,
Patent Owner.

IPR2024-01464
Patent 11,393,461 B2

Before MICHELLE N. WORMMEESTER, BRIAN P. MURPHY, and
LISA A. MURRAY, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

IPR2024-01464
Patent 11,393,461 B2

I. INTRODUCTION

Google LLC (“Google” or “Petitioner Google”), as well as Samsung Electronics Co., Ltd., and Samsung Electronics, America, Inc. (collectively, “Samsung” or “Petitioner Samsung”) filed a Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–18 of U.S. Patent No. 11,393,461 B2 (Ex. 1001, “the ’461 patent”). We refer to Google and Samsung collectively as “Petitioner.” Cerence Operating Company (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). With our authorization, Patent Owner also filed a supplemental preliminary response (Paper 13, “Supp. Prelim. Resp.”), and Petitioner filed a preliminary reply (Paper 14, “Prelim. Reply”) to Patent Owner’s supplemental preliminary response. *See* Ex. 3002 (e-mail authorization).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons that follow, we exercise our discretion to deny institution of an *inter partes* review of the challenged claims.

II. BACKGROUND

A. Related Proceedings

The parties identify various related matters. Pet. 77–78; Paper 12, Part II (Patent Owner’s Updated Mandatory Notices). One related matter is *Cerence Operating Co. v. Samsung Electronics Co.*, 2:23-cv-00482-JRG-RSP (E.D. Tex.) (hereinafter, “the District Court Litigation”), which was filed on October 13, 2023. Pet. 77; Paper 12, Part II. Petitioner Samsung is a party to the District Court Litigation, but Petitioner Google is not. *See* Pet. 71 (“[T]here is no litigation currently pending against Co-petitioner Google.”).

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B. The '461 Patent

The '461 patent is titled “Methods and Apparatus for Detecting a Voice Command.” Ex. 1001, code (54). The abstract describes the subject matter as follows:

According to some aspects, a method of monitoring an acoustic environment of a mobile device, at least one computer readable medium encoded with instructions that, when executed, perform such a method and/or a mobile device configured to perform such a method is provided. The method comprises receiving acoustic input from the environment of the mobile device while the mobile device is operating in the low power mode, detecting whether the acoustic input includes a voice command based on performing a plurality of processing stages on the acoustic input, wherein at least one of the plurality of processing stages is performed while the mobile device is operating in the low power mode, and using at least one contextual cue to assist in detecting whether the acoustic input includes a voice command.

Id. at code (57).

C. Challenged Claims

Petitioner challenges claims 1–18 of the '461 patent. Claims 1 and 18 are independent. Claim 1, reproduced below, is illustrative.

1. A method of monitoring an acoustic environment of a mobile device for voice commands when the mobile device is operating in a low power mode, the method comprising:

receiving acoustic input from the environment of the mobile device while the mobile device is operating in idle mode;
and

in response to receiving the acoustic input, determining whether the received acoustic input includes a voice command by processing the received acoustic input, the processing employing at least one contextual cue, the at least one contextual cue comprising information other than

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content of the acoustic input and comprising a time the acoustic input was received, motion of the mobile device, location of the mobile device, occurrence of an event on the mobile device, recent activity on the mobile device, a stored sample of the acoustic environment of the mobile device and/or a power source of the mobile device, the processing of the received acoustic input comprising a plurality of processing stages, at least one of the processing stages being performed while the mobile device is operating in the idle mode.

Ex. 1001, 43:46–67.

D. Asserted Challenges to Unpatentability

Petitioner asserts four challenges against various subsets of claims 1–18 of the ’461 patent as follows. Pet. 2, 14–70.

Claims Challenged	35 U.S.C. §	References/Basis
1–4, 6, 7, 11, 14, 16, 18	103(a) ¹	Sarin, ² Hwang ³
13	103(a)	Sarin, Hwang, Garner ⁴
3, 5, 7, 9, 10, 12, 15, 17	103(a)	Sarin, Hwang, Gruber ⁵
8	103(a)	Sarin, Hwang, LeBeau ⁶

In support of its challenges, Petitioner relies on a Declaration of Christopher M. Schmandt (Ex. 1002).

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the ’461 patent issued was filed before this date, the pre-AIA version of § 103 applies.

² U.S. Patent No. 9,031,847 B2, issued May 12, 2015 (Ex. 1005).

³ U.S. Publ’n No. 2013/0110521 A1, published May 2, 2013 (Ex. 1006).

⁴ U.S. Patent No. 7,475,012 B2, issued Jan. 6, 2009 (Ex. 1007).

⁵ U.S. Publ’n No. 2012/0265528 A1, published Oct. 18, 2012 (Ex. 1008).

⁶ U.S. Publ’n No. 2012/0034904 A1, published Feb. 9, 2012 (Ex. 1016).

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III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

As noted above, the validity of the '461 patent is at issue in the District Court Litigation. Pet. 77; Paper 12, Part II. Patent Owner argues we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.* IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), weigh in favor of denying institution in view of the District Court Litigation. Prelim. Resp. 4–14; Supp. Prelim. Resp. 1–5. Petitioner argues we should not discretionarily deny institution. Pet. 71–75; Prelim. Reply 1–5. For the reasons explained below, we exercise our discretion to deny institution under 35 U.S.C. § 314(a).

A. Fintiv Analysis

We consider the following six factors to assess “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”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

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Fintiv, Paper 11 at 5–6. In considering these factors, we apply the guidance set forth in a Memorandum regarding “Guidance on USPTO’s recission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,’” issued by the Chief Administrative Patent Judge of the Patent Trial and Appeal Board on March 24, 2025 (hereinafter, “Guidance Memo”).⁷

We address each factor in turn.

1. Factor 1: Likelihood of Stay

A district court stay of parallel litigation pending resolution of an *inter partes* review allays concerns about inefficiency and duplication of efforts, and strongly weighs against exercising our authority to deny institution. *Fintiv*, Paper 11 at 6.

Patent Owner argues “discretionary denial is appropriate” because the district court has already denied Petitioner Samsung’s request for a stay in the District Court Litigation. Supp. Prelim. Resp. 5.

Petitioner argues “[t]his factor is neutral” because “[Petitioner] Samsung’s motion to stay was denied ‘without prejudice’ for it to be refiled later.” Prelim. Reply 1. Petitioner adds that the district court “has granted such re-filed stay motions post-institution even if opposed.” *Id.*

There is no indication in the record of whether a subsequent request for a stay will be granted or denied. Because we decline to speculate on how the district court might rule on a renewed motion to stay that has not been filed, we weigh this factor as neutral. *See Apple Inc. v. Fintiv, Inc.*,

⁷ Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf.

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IPR2020-00019, Paper 15, 12 (PTAB May 13, 2020) (informative) (cautioning against speculating whether the district court would grant a stay if one were requested).

2. Factor 2: District Court Trial Date

If a district court’s trial date is earlier than the Board’s projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution. *Fintiv*, Paper 11 at 9. Here, the district court has set its trial date for October 6, 2025, almost seven months before our deadline to reach a final decision. Ex. 2004, 1 (Third Amended Docket Control Order).

Patent Owner contends “discretionary denial is appropriate” because “the parties recently agreed to extend the trial date in the District Court action to ensure there is sufficient time to complete all necessary work, thereby raising the likelihood that the new trial date will remain firm.” Supp. Prelim. Resp. 5 (citing Ex. 2004). Patent Owner adds that “even with this newly extended trial date, a decision on the validity of the ’4[6]1 Patent is still expected in the parallel District Court proceeding[] *more than six months prior* to any final written decision in this matter.” *Id.*

Petitioner, on the other hand, suggests this factor is “neutral or weigh[s] slightly against” discretionary denial because the parallel “litigation schedule has been in flux for the past few months.” Prelim. Reply 1–2 (emphasis omitted). Petitioner notes that jury selection was extended from August 4, 2025, to October 6, 2025, “based on a joint motion for additional time to complete important technical discovery obligations,” and that “[t]he docket control order also allows for further amendments.” *Id.*

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at 2 (citing Ex. 2004); *see also id.* at 4–5 (“[T]he parties have already pushed out the trial . . . and may do so again.”). Petitioner also asserts there are twelve trials set for the same date before the same judge and they cannot all proceed as scheduled. *Id.* In addition, Petitioner asserts the six-month gap between the scheduled trial date and our deadline for a final decision does not compel denial because “this factor is not determinative.” *Id.* at 2; *see also id.* at 4 (“[H]ere it is a 6-month gap.”).

Considering the arguments and evidence presented by the parties, we find this factor weighs in favor of exercising discretion to deny institution. As noted above, the district court has set a trial date of October 6, 2025, which is almost seven months before the final written decision in this proceeding would be due in late April 2026. Although a number of cases may be scheduled for jury selection on the same day as the District Court Litigation, nothing in the record indicates a trial in the District Court Litigation would not take place months before our deadline to reach a final decision. Because the District Court Litigation will address the issues relating to the validity of the ’461 patent in a trial scheduled to occur several months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.

3. *Factor 3: Investment in the Related District Court Litigation*

We consider now the amount and type of work that the court and the parties will have completed in the parallel litigation by the time of our institution decision. *See Fintiv*, Paper 11 at 9.

Petitioner contends “[t]his factor weighs against discretionary denial” because “substantial work remains, as evidenced by the parties’ joint request

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for more time” in the District Court Litigation. Prelim. Reply 3. Petitioner acknowledges that claim construction, fact discovery, and opening expert reports are complete, but asserts “expert discovery deadlines, depositions, dispositive motions, and pre-trial disclosures all remain in the future.” *Id.* (citing Ex. 2004). Petitioner also asserts Patent Owner “may agree to stays post-institution[] and, if still opposed after institution, the Board should weigh inefficiencies against [Patent Owner], not [Petitioner] Samsung.” *Id.* Lastly, Petitioner adds the timing of its Petition “weighs against discretionary denial because Samsung timely filed the petition within its statutorily-allowed period,” and that it “was reasonable because it allowed Google and Samsung to prepare a single petition, instead of two separate petitions, to best conserve the Board’s resources.” *Id.*

By contrast, Patent Owner argues “discretionary denial is appropriate” because “the parties will have completed claim construction, fact discovery, and expert reports prior to any decision on institution, demonstrating an already substantial investment by the parties in the [District Court Litigation].” Supp. Prelim. Resp. 5 (citing Ex. 2004). As to timing, Patent Owner complains that Petitioner filed its Petition nearly one year after Samsung was served with the complaint in the District Court Litigation. *Id.* at 4–5 (“Petitioner Samsung . . . was served with a complaint asserting the challenged patent on October 19, 2023 . . . , but Petitioners waited until October 16, 2024—*almost the entire 12 months permitted by statute*—before filing their Petition.”) (citing Ex. 2003 (Proof of Service)).

We agree with Patent Owner’s assessment that work by the district court and the parties is at an advanced stage, whether or not Patent Owner would agree to a post-institution stay. The District Court Litigation has been

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pending since October 2023, and trial is scheduled to start approximately five months from issuance of this Institution Decision. Claim construction and fact discovery have been completed, and expert discovery is well underway. Petitioner's timing argument, that it was "reasonable" to file a "single petition" a few days before the 12-month statutory deadline, is not sufficient to overcome the substantial work completed in the District Court Litigation in preparation for a trial scheduled to begin approximately five months from now.

Under these circumstances, we find this factor favors exercising our discretion to deny institution. *See Fintiv*, Paper 11 at 10 ("[D]istrict court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial."); *id.* at 11 ("[I]t may impose unfair costs to a patent owner if the petitioner . . . waits until the district court trial has progressed significantly before filing a petition [H]owever, . . . it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding. Thus, the parties should explain facts relevant to timing."); *see also Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (PTAB Mar. 28, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review) (finding "factor 3 strongly favors discretionary denial" where "the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions" and "[t]he court also had held a claim construction hearing and construed the disputed claim terms").

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4. Factor 4: Overlap of Issues

This factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art is submitted in both the district court and the *inter partes* review proceeding. *Fintiv*, Paper 11 at 12. In the Guidance Memo, the Chief Judge stated,

[A] timely-filed *Sotera* stipulation[] (*i.e.*, a stipulation from a petitioner that, if an [*inter partes* review] or [post-grant review] is instituted, the petitioner will not pursue in district court . . . any ground raised or that could have been reasonably raised in the [*inter partes* review]/[post-grant review]) is highly relevant, but will not be dispositive by itself.

Guidance Memo, 2–3; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential).

Petitioner Samsung has offered a *Sotera*-type stipulation, where Samsung represents that if the Board “institutes this [*inter partes* review] petition on the grounds presented therein, then Samsung will not pursue in the [District Court Litigation] any grounds that were raised or reasonably could have been raised in the [*inter partes* review].”⁸ Ex. 1030, 1. Petitioner Samsung further represents the “stipulation does not extend to co-petitioner Google, which is not a party to the [District Court Litigation].” *Id.*

⁸ In its Preliminary Reply, Petitioner asserts that “Samsung agreed that it will not raise in district court any art or arguments that it raised or reasonably could have raised in the [*inter partes* review].” Prelim. Reply 4 (emphasis added). The stipulation, however, states that “Samsung will not pursue in the . . . litigation any grounds that were raised or reasonably could have been raised in the [*inter partes* review].” Ex. 1030, 1 (emphasis added). Contrary to Petitioner’s assertion in the Preliminary Reply, the wording in the stipulation contemplates relying on art raised in this proceeding.

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According to Petitioner, the stipulation “weighs strongly in favor of not exercising discretion” to deny institution. Prelim. Reply 4.

Patent Owner, however, argues “the District Court invalidity contentions purport to preserve the ability to combine the Apple Siri and Samsung S Voice systems with any of the patent and printed publication art, undermining the effect of the submitted *Sotera* stipulation.” Supp. Prelim. Resp. 2 (citing Ex. 2002, 406, 416 (Defendants’ Second Amended Invalidity Contentions)).

On this record, Petitioner Samsung’s stipulation appears to mitigate some concern of duplication between the District Court Litigation and this proceeding as well as the possibility of conflicting decisions. It does not, however, ensure this proceeding would be a “true alternative” to the District Court Litigation. *See Sotera*, Paper 12 at 19; *see also Motorola*, Paper 19 at 3–4 (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [*inter partes* review] proceedings would be a ‘true alternative’ to the district court proceeding”). Petitioner Samsung’s invalidity contentions in the District Court Litigation are much more expansive, including pages of cited references, and Samsung has reserved the right to rely on any of the references to prove invalidity. Ex. 2002, 11–12 (citing fifteen additional references); *id.* at 406, 411–416 (citing “other relevant references” across six pages). Also, Petitioner Samsung does not dispute Patent Owner’s concern that the invalidity contentions contemplate combining the Apple Siri and Samsung S Voice systems with any of the cited references, including those cited in this proceeding. *See* Prelim. Reply. Indeed, Petitioner notes in its Preliminary

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Reply that “system art could never reasonably be raised before the Office.”
Id. at 4.

We recognize the contention that “this [*inter partes* review] is co-Petitioner Google’s **only** forum to present its invalidity challenge.” Prelim. Reply 5. As noted above, Petitioner Google is not a party to the District Court Litigation, and, therefore, the stipulation discussed above does not apply to Google. This fact does not alter our analysis because there is no parallel proceeding in which Google is currently challenging the validity of the ’461 patent. Thus, Petitioner Google’s presence in this proceeding does not raise the concerns that a *Fintiv* analysis is designed to address.

If we were to grant institution in this proceeding, we would be considering the same claims of the ’461 patent whose validity would have been previously tried before the district court. On balance, therefore, we find this factor weighs slightly against exercising our discretion to deny institution.

5. Factor 5: Identity of Parties

For this factor, we consider “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 13 (emphasis omitted).

Petitioner and Patent Owner acknowledge that Petitioner Samsung and Patent Owner are parties to both this proceeding and the District Court Litigation. Pet. 74; Prelim. Resp. 13; Supp. Prelim. Resp. 3. Petitioner argues “[t]his factor weighs against discretionary denial,” however, because Google and Samsung “are not the same party” and the District Court

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Litigation “would not resolve [Petitioner] Google’s interest in invalidating the [’461] patent.” Prelim. Reply 5.

Patent Owner argues that “[t]he addition of Google LLC as a petitioner should not alter the analysis.” Prelim. Resp. 12.

As explained above, the District Court Litigation is scheduled to go to trial well before our deadline to reach a final decision should we institute *inter partes* review in this proceeding. Although Petitioner Google is not a defendant in the District Court Litigation, the invalidity of the ’461 patent will have been fully litigated in the District Court Litigation, which is well underway. Petitioner does not address sufficiently why we should redo the work of another tribunal regarding substantially the same issues, notwithstanding the identity of the parties. Under these circumstances, we find this factor weighs in favor of exercising our discretion to deny institution. *See Fintiv*, Paper 11 at 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.”).

6. Factor 6: Other Circumstances, Including the Merits

The final *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny institution, such as the merits of the patentability challenges. *Fintiv*, Paper 11 at 14–16.

Each party appears to argue that the merits tip the balance in its favor. *See Supp. Prelim. Resp.* 2–4; *Prelim. Reply* 5. Petitioner asserts it “ha[s] established a strong case on the merits that involve new, non-cumulative

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obviousness theories that will not be addressed in the parallel [District Court Litigation].” Prelim. Reply 5. Patent Owner asserts “the Petition’s extensive reliance on conclusory expert testimony to gap-fill holes in the prior art demonstrates discretionary denial is appropriate.” Supp. Prelim. Resp. 3–4.

Although we may consider the merits for this factor, a full analysis of the merits is not necessary; rather, the parties may point out particular strengths or weaknesses to aid us in deciding whether the merits tip the balance one way or another. *Fintiv*, Paper 11 at 14–16. We have considered the parties’ arguments and evidence regarding the asserted challenges. On this record, we find the merits of Petitioner’s asserted challenges do not outweigh the other *Fintiv* factors.

In view of the foregoing, we determine this factor is neutral.

B. Fintiv Determination

We have taken into account the circumstances and facts before us in view of the *Fintiv* factors. As discussed above, factors 1 and 6 are neutral, factors 2, 3, and 5 weigh in favor of discretionary denial of institution, and factor 4 weighs slightly against discretionary denial. We conclude that, on balance, the evidence of record favors exercising our discretion to deny institution of *inter partes* review.

IV. CONCLUSION

For the reasons given above, we exercise our discretion under § 314(a) to deny institution of *inter partes* review.

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V. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* and no trial is instituted.

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Paper 15
Date: April 23, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

CERENCE OPERATING COMPANY,
Patent Owner.

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Patent 11,087,750 B2

Before MICHELLE N. WORMMEESTER, BRIAN P. MURPHY, and
LISA A. MURRAY, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

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I. INTRODUCTION

Google LLC (“Google” or “Petitioner Google”), as well as Samsung Electronics Co., Ltd., and Samsung Electronics, America, Inc. (collectively, “Samsung” or “Petitioner Samsung”) filed a Petition (Paper 4, “Pet.”) requesting *inter partes* review of claims 1–19 of U.S. Patent No. 11,087,750 B2 (Ex. 1001, “the ’750 patent”). We refer to Google and Samsung collectively as “Petitioner.” Cerence Operating Company (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”). With our authorization, Patent Owner also filed a supplemental preliminary response (Paper 13, “Supp. Prelim. Resp.”), and Petitioner filed a preliminary reply (Paper 14, “Prelim. Reply”) to Patent Owner’s supplemental preliminary response. *See* Ex. 3002 (e-mail authorization).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons that follow, we exercise our discretion to deny institution of an *inter partes* review of the challenged claims.

II. BACKGROUND

A. Related Proceedings

The parties identify various related matters. Pet. 75; Paper 12, Part II (Patent Owner’s Updated Mandatory Notices). One related matter is *Cerence Operating Co. v. Samsung Electronics Co.*, 2:23-cv-00482-JRG-RSP (E.D. Tex.) (hereinafter, “the District Court Litigation”), which was filed on October 13, 2023. Pet. 75; Paper 12, Part II. Petitioner Samsung is a party to the District Court Litigation, but Petitioner Google is not. *See* Pet. 71 (“[T]here is no litigation currently pending against Co-petitioner Google.”).

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B. The '750 Patent

The '750 patent is titled “Methods and Apparatus for Detecting a Voice Command.” Ex. 1001, code (54). The abstract describes the subject matter as follows:

According to some aspects, a method of monitoring an acoustic environment of a mobile device, at least one computer readable medium encoded with instructions that, when executed, perform such a method and/or a mobile device configured to perform such a method is provided. The method comprises receiving acoustic input from the environment of the mobile device while the mobile device is operating in the low power mode, detecting whether the acoustic input includes a voice command based on performing a plurality of processing stages on the acoustic input, wherein at least one of the plurality of processing stages is performed while the mobile device is operating in the low power mode, and using at least one contextual cue to assist in detecting whether the acoustic input includes a voice command.

Id. at code (57).

C. Challenged Claims

Petitioner challenges claims 1–19 of the '750 patent. Claims 1, 14 and 19 are independent. Claim 1, reproduced below, is illustrative.

1. A device configured to operate in a lower power mode and a higher power mode, the device comprising:

at least one processor configured to perform at least one processing stage on an acoustic input received from an environment of the device while the device is operating in the lower power mode, performing the at least one processing stage comprising:

determining in the lower power mode whether the acoustic input includes a specific word or phrase that, when spoken, indicates that a voice interface of the device is

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to be engaged for provision of subsequent input,
wherein the determining comprises:

performing automatic speech recognition (ASR),
while in the lower power mode, to recognize at
least one word or phrase in the acoustic input;

determining, while in the lower power mode,
whether the recognized at least one word or
phrase matches the specific word or phrase;

in response to determining that the acoustic input includes
the specific word or phrase, requesting, via a network
while in the lower power mode, that at least one server
perform recognition on at least a portion of the acoustic
input to determine whether the acoustic input includes
at least one voice command;

in response to receiving an indication from the at least one
server that the acoustic input includes at least one voice
command, selecting whether to remain in the lower
power mode or to transition to a higher power mode;
and

responding to the at least one voice command, in either the
lower power mode or the higher power mode,
depending on the selecting.

Ex. 1001, 43:50–44:15.

D. Asserted Challenges to Unpatentability

Petitioner asserts four challenges against various subsets of claims 1–
19 of the '750 patent as follows. Pet. 2, 17–70.

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Claims Challenged	35 U.S.C. §	References/Basis
1–8, 11, 13–15, 19	103(a) ¹	Basye, ² Shenhav ³
19, 16	103(a)	Basye, Shenhav, Parker ⁴
10, 18	103(a)	Basye, Shenhav, LeBeau ⁵
12, 17	103(a)	Basye, Shenhav, Conroy ⁶

In support of its challenges, Petitioner relies on a Declaration of Christopher M. Schmandt (Ex. 1002).

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

As noted above, the validity of the '750 patent is at issue in the District Court Litigation. Pet. 75; Paper 12, Part II. Patent Owner argues we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.* IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), weigh in favor of denying institution in view of the District Court Litigation. Prelim. Resp. 7–16; Supp. Prelim. Resp. 1–5. Petitioner argues we should not discretionarily deny institution. Pet. 70–75; Prelim. Reply 1–5. For the reasons explained below, we exercise our discretion to deny institution under 35 U.S.C. § 314(a).

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the '750 patent issued claims priority to an application filed before this date, the pre-AIA version of § 103 applies.

² U.S. Publ’n No. 2014/0163978 A1, published June 12, 2014 (Ex. 1005).

³ U.S. Publ’n No. 2014/0006825 A1, published Jan. 2, 2014 (Ex. 1006).

⁴ U.S. Publ’n No. 2015/0106089 A1, published Apr. 16, 2015 (Ex. 1007).

⁵ U.S. Publ’n No. 2012/0034904 A1, published Feb. 9, 2012 (Ex. 1014).

⁶ U.S. Publ’n No. 2011/0314185 A1, published Dec. 22, 2011 (Ex. 1017).

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A. Fintiv Analysis

We consider the following six factors to assess “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”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6. In considering these factors, we apply the guidance set forth in a Memorandum regarding “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,’” issued by the Chief Administrative Patent Judge of the Patent Trial and Appeal Board on March 24, 2025 (hereinafter, “Guidance Memo”).⁷

We address each factor in turn.

⁷ Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf.

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1. Factor 1: Likelihood of Stay

A district court stay of parallel litigation pending resolution of an *inter partes* review allays concerns about inefficiency and duplication of efforts, and strongly weighs against exercising our authority to deny institution. *Fintiv*, Paper 11 at 6.

Patent Owner argues “discretionary denial is appropriate” because the district court has already denied Petitioner Samsung’s request for a stay in the District Court Litigation. Supp. Prelim. Resp. 5.

Petitioner argues “[t]his factor is neutral” because “[Petitioner] Samsung’s motion to stay was denied ‘without prejudice’ for it to be refiled later.” Prelim. Reply 1. Petitioner adds that the district court “has granted such re-filed stay motions post-institution even if opposed.” *Id.*

There is no indication in the record of whether a subsequent request for a stay will be granted or denied. Because we decline to speculate on how the district court might rule on a renewed motion to stay that has not been filed, we weigh this factor as neutral. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 12 (PTAB May 13, 2020) (informative) (cautioning against speculating whether the district court would grant a stay if one were requested).

2. Factor 2: District Court Trial Date

If a district court’s trial date is earlier than the Board’s projected statutory deadline for a final written decision, the Board generally has weighed this fact in favor of exercising discretion to deny institution. *Fintiv*, Paper 11 at 9. Here, the district court has set its trial date for October 6,

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2025, almost seven months before our deadline to reach a final decision.
Ex. 2004, 1 (Third Amended Docket Control Order).

Patent Owner contends “discretionary denial is appropriate” because “the parties . . . recently agreed to extend the trial date in the District Court action to ensure there is sufficient time to complete all necessary work, thereby raising the likelihood that the new trial date will remain firm.” Supp. Prelim. Resp. 5 (citing Ex. 2004). Patent Owner adds that “even with this newly extended trial date, a decision on the validity of the ’[750] Patent is still expected in the parallel District Court proceeding[] *more than six months prior* to any final written decision in this matter.” *Id.*

Petitioner, on the other hand, suggests this factor is “neutral or weigh[s] slightly against” discretionary denial because the parallel “litigation schedule has been in flux for the past few months.” Prelim. Reply 1–2 (emphasis omitted). Petitioner notes that jury selection was extended from August 4, 2025, to October 6, 2025, “based on a joint motion for additional time to complete important technical discovery obligations,” and that “[t]he docket control order also allows for further amendments.” *Id.* at 2 (citing Ex. 2004); *see also id.* at 4–5 (“[T]he parties have already pushed out the trial . . . and may do so again.”). Petitioner also asserts there are twelve trials set for the same date before the same judge and they cannot all proceed as scheduled. *Id.* In addition, Petitioner asserts the six-month gap between the scheduled trial date and our deadline for a final decision does not compel denial because “this factor is not determinative.” *Id.* at 2; *see also id.* at 4 (“[H]ere it is a 6-month gap.”).

Considering the arguments and evidence presented by the parties, we find this factor weighs in favor of exercising discretion to deny institution.

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As noted above, the district court has set a trial date of October 6, 2025, which is almost seven months before the final written decision in this proceeding would be due in late April 2026. Although a number of cases may be scheduled for jury selection on the same day as the District Court Litigation, nothing in the record indicates a trial in the District Court Litigation would not take place months before our deadline to reach a final decision. Because the District Court Litigation will address the issues relating to the validity of the '750 patent in a trial scheduled to occur several months before we would issue a final written decision, we weigh the second *Fintiv* factor as favoring discretionary denial.

3. Factor 3: Investment in the Related District Court Litigation

We consider now the amount and type of work that the court and the parties will have completed in the parallel litigation by the time of our institution decision. *See Fintiv*, Paper 11 at 9.

Petitioner contends “[t]his factor weighs against discretionary denial” because “substantial work remains, as evidenced by the parties’ joint request for more time” in the District Court Litigation. Prelim. Reply 3. Petitioner acknowledges that claim construction, fact discovery, and opening expert reports are complete, but asserts “expert discovery deadlines, depositions, dispositive motions, and pre-trial disclosures all remain in the future.” *Id.* (citing Ex. 2004). Petitioner also asserts Patent Owner “may agree to stays post-institution[] and, if still opposed after institution, the Board should weigh inefficiencies against [Patent Owner], not [Petitioner] Samsung.” *Id.* Lastly, Petitioner adds the timing of its Petition “weighs against discretionary denial because Samsung timely filed the petition within its

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By contrast, Patent Owner argues “discretionary denial is appropriate” because “the parties will have completed claim construction, fact discovery, and expert reports prior to any institution decision, demonstrating an already substantial investment by the parties” in the District Court Litigation. Supp. Prelim. Resp. 5 (citing Ex. 2004). As to timing, Patent Owner complains that Petitioner filed its Petition nearly one year after Samsung was served with the complaint in the District Court Litigation. *Id.* at 4–5 (“Petitioner Samsung . . . was served with a complaint asserting the challenged patent on October 19, 2023 . . . , but Petitioners waited until October 16, 2024—*almost the entire 12 months permitted by statute*—before filing their Petition.”) (citing Ex. 2003 (Proof of Service)).

We agree with Patent Owner’s assessment that work by the district court and the parties is at an advanced stage, whether or not Patent Owner would agree to a post-institution stay. The District Court Litigation has been pending since October 2023, and trial is scheduled to start approximately five months from issuance of this Institution Decision. Claim construction and fact discovery have been completed, and expert discovery is well underway. Petitioner’s timing argument, that it was “reasonable” to file a “single petition” a few days before the 12-month statutory deadline, is not sufficient to overcome the substantial work completed in the District Court Litigation in preparation for a trial scheduled to begin approximately five months from now.

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Under these circumstances, we find this factor favors exercising our discretion to deny institution. *See Fintiv*, Paper 11 at 10 (“[D]istrict court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”); *id.* at 11 (“[I]t may impose unfair costs to a patent owner if the petitioner . . . waits until the district court trial has progressed significantly before filing a petition [H]owever, . . . it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding. Thus, the parties should explain facts relevant to timing.”); *see also Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (PTAB Mar. 28, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review) (finding “factor 3 strongly favors discretionary denial” where “the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions” and “[t]he court also had held a claim construction hearing and construed the disputed claim terms”).

4. Factor 4: Overlap of Issues

This factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially identical prior art is submitted in both the district court and the *inter partes* review proceeding. *Fintiv*, Paper 11 at 12. In the Guidance Memo, the Chief Judge stated,

[A] timely-filed *Sotera* stipulation[] (*i.e.*, a stipulation from a petitioner that, if an [*inter partes* review] or [post-grant review] is instituted, the petitioner will not pursue in district court . . . any

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ground raised or that could have been reasonably raised in the [*inter partes* review]/[post-grant review]) is highly relevant, but will not be dispositive by itself.

Guidance Memo, 2–3; *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential).

Petitioner Samsung has offered a *Sotera*-type stipulation, where Samsung represents that if the Board “institutes this [*inter partes* review] petition on the grounds presented therein, then Samsung will not pursue in the [District Court Litigation] any grounds that were raised or reasonably could have been raised in the [*inter partes* review].”⁸ Ex. 1030, 1. Petitioner Samsung further represents the “stipulation does not extend to co-petitioner Google, which is not a party to the [District Court Litigation].” *Id.* According to Petitioner, the stipulation “weighs strongly in favor of not exercising discretion” to deny institution. Prelim. Reply 4.

Patent Owner, however, argues “the District Court invalidity contentions purport to preserve the ability to combine the Apple Siri and Samsung S Voice systems with any of the patent and printed publication art, undermining the effect of the submitted *Sotera* stipulation.” Supp. Prelim. Resp. 2 (citing Ex. 2002, 406, 416 (Defendants’ Second Amended Invalidity Contentions)).

⁸ In its Preliminary Reply, Petitioner asserts that “Samsung agreed that it will not raise in district court any art or arguments that it raised or reasonably could have raised in the [*inter partes* review].” Prelim. Reply 4 (emphasis added). The stipulation, however, states that “Samsung will not pursue in the . . . litigation any grounds that were raised or reasonably could have been raised in the [*inter partes* review].” Ex. 1030, 1 (emphasis added). Contrary to Petitioner’s assertion in the Preliminary Reply, the wording in the stipulation contemplates relying on art raised in this proceeding.

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On this record, Petitioner Samsung’s stipulation appears to mitigate some concern of duplication between the District Court Litigation and this proceeding as well as the possibility of conflicting decisions. It does not, however, ensure this proceeding would be a “true alternative” to the District Court Litigation. *See Sotera*, Paper 12 at 19; *see also Motorola*, Paper 19 at 3–4 (Director vacating decision granting institution where the petitioner’s “stipulation does not ensure that these [*inter partes* review] proceedings would be a ‘true alternative’ to the district court proceeding”). Petitioner Samsung’s invalidity contentions in the District Court Litigation are much more expansive, including pages of cited references, and Samsung has reserved the right to rely on any of the references to prove invalidity. Ex. 2002, 12–13 (citing eleven additional references); *id.* at 406, 411–416 (citing “other relevant references” across six pages). Also, Petitioner Samsung does not dispute Patent Owner’s concern that the invalidity contentions contemplate combining the Apple Siri and Samsung S Voice systems with any of the cited references, including those cited in this proceeding. *See* Prelim. Reply. Indeed, Petitioner notes in its Preliminary Reply that “system art could never reasonably be raised before the Office.” *Id.* at 4.

We recognize the contention that “this [*inter partes* review] is co-Petitioner Google’s **only** forum to present its invalidity challenge.” Prelim. Reply 5. As noted above, Petitioner Google is not a party to the District Court Litigation, and, therefore, the stipulation discussed above does not apply to Google. This fact does not alter our analysis because there is no parallel proceeding in which Google is currently challenging the validity of

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the '750 patent. Thus, Petitioner Google's presence in this proceeding does not raise the concerns that a *Fintiv* analysis is designed to address.

If we were to grant institution in this proceeding, we would be considering the same claims of the '750 patent whose validity would have been previously tried before the district court. On balance, therefore, we find this factor weighs slightly against exercising our discretion to deny institution.

5. Factor 5: Identity of Parties

For this factor, we consider "whether the petitioner and the defendant in the parallel proceeding are the same party." *Fintiv*, Paper 11 at 13 (emphasis omitted).

Petitioner and Patent Owner acknowledge that Petitioner Samsung and Patent Owner are parties to both this proceeding and the District Court Litigation. Pet. 74; Prelim. Resp. 14; Supp. Prelim. Resp. 3. Petitioner argues "[t]his factor weighs against discretionary denial," however, because Google and Samsung "are not the same party" and the District Court Litigation "would not resolve [Petitioner] Google's interest in invalidating the ['750] patent." Prelim. Reply 5.

Patent Owner argues that "[t]he addition of Google LLC as a petitioner should not alter the analysis." Prelim. Resp. 14.

As explained above, the District Court Litigation is scheduled to go to trial well before our deadline to reach a final decision should we institute *inter partes* review in this proceeding. Although Petitioner Google is not a defendant in the District Court Litigation, the invalidity of the '750 patent will have been fully litigated in the District Court Litigation, which is well

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underway. Petitioner does not address sufficiently why we should redo the work of another tribunal regarding substantially the same issues, notwithstanding the identity of the parties. Under these circumstances, we find this factor weighs in favor of exercising our discretion to deny institution. *See Fintiv*, Paper 11 at 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.”).

6. Factor 6: Other Circumstances, Including the Merits

The final *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny institution, such as the merits of the patentability challenges. *Fintiv*, Paper 11 at 14–16.

Each party appears to argue that the merits tip the balance in its favor. *See Supp. Prelim. Resp.* 2–4; *Prelim. Reply* 5. Petitioner asserts it “ha[s] established a strong case on the merits that involve new, non-cumulative obviousness theories that will not be addressed in the parallel [District Court Litigation].” *Prelim. Reply* 5. Patent Owner asserts “the Petition’s extensive reliance on conclusory expert testimony to gap-fill holes in the prior art demonstrates discretionary denial is appropriate.” *Supp. Prelim. Resp.* 3–4.

Although we may consider the merits for this factor, a full analysis of the merits is not necessary; rather, the parties may point out particular strengths or weaknesses to aid us in deciding whether the merits tip the balance one way or another. *Fintiv*, Paper 11 at 14–16. We have considered

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the parties' arguments and evidence regarding the asserted challenges. On this record, we find the merits of Petitioner's asserted challenges do not outweigh the other *Fintiv* factors.

In view of the foregoing, we determine this factor is neutral.

B. Fintiv Determination

We have taken into account the circumstances and facts before us in view of the *Fintiv* factors. As discussed above, factors 1 and 6 are neutral, factors 2, 3, and 5 weigh in favor of discretionary denial of institution, and factor 4 weighs slightly against discretionary denial. We conclude that, on balance, the evidence of record favors exercising our discretion to deny institution of *inter partes* review.

IV. CONCLUSION

For the reasons given above, we exercise our discretion under § 314(a) to deny institution of *inter partes* review.

V. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* and no trial is instituted.

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Patent Trial and Appeal Board

Rescinded: February 28, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

MEMORANDUM

DATE: June 21, 2022

TO: Members of the Patent Trial and Appeal Board

FROM: Katherine K. Vidal *Katherine Kelly Vidal*
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office (USPTO or the Office)

SUBJECT: INTERIM PROCEDURE FOR DISCRETIONARY DENIALS IN AIA POST-GRANT PROCEEDINGS WITH PARALLEL DISTRICT COURT LITIGATION

Introduction

Congress designed the America Invents Act (AIA) post-grant proceedings “to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” H.R. Rep. No. 112–98, pt. 1, at 40 (2011), 2011 U.S.C.C.A.N. 67, 69; *see* S. Rep. No. 110–259, at 20 (2008). Parallel district court and AIA proceedings involving the same parties and invalidity challenges can increase, rather than limit, litigation costs. Based on the USPTO’s experience with administering the AIA, the agency has recognized the potential for inefficiency and gamesmanship in AIA proceedings, given the existence of parallel proceedings between the Office and district courts. To minimize potential conflict between the Patent Trial and Appeal Board (PTAB) and district court proceedings, the Office designated as precedential *Apple Inc. v. Fintiv, Inc.*¹ This precedential decision articulates

¹ *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020).

the following set of nonexclusive factors (the *Fintiv* factors) that the PTAB considers on a case-specific basis in determining whether to institute an AIA post-grant proceeding where there is parallel district court litigation:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

The Office issued a Request for Comments (RFC)² on the PTAB's current approaches to exercising discretion on whether to institute an AIA proceeding, including situations involving parallel district court litigation. The Office received 822 comments from a wide range of stakeholders. In light of the feedback received, the Office is planning to soon explore potential rulemaking on proposed approaches through an Advanced Notice of Proposed Rulemaking. In the meantime, I have determined that several clarifications need to be made to the PTAB's current application of *Fintiv* to discretionary institution where there is parallel litigation.

As explained below, to benefit the patent system and the public good, the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district court litigation where a petition presents compelling evidence of unpatentability. This memorandum also confirms that the precedential import of *Fintiv* is limited to facts of that case. Namely, *Fintiv* involved institution of an AIA proceeding with a parallel district court litigation. The

² Discretion to Institute Trials Before the Patent Trial and Appeal Board, 85 FR 66502 (Oct. 20, 2020); Discretion to Institute Trials Before the Patent Trial and Appeal Board; Extension of Comment Period, 85 FR 73437 (Nov. 18, 2020).

plain language of the *Fintiv* factors is directed to district court litigation and does not apply to parallel U.S. International Trade Commission (ITC) proceedings, as the ITC lacks authority to invalidate a patent and the ITC's invalidity rulings are not binding on the Office or on district courts.

Consistent with *Sotera Wireless, Inc.*,³ the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB. Additionally, when considering the proximity of the district court's trial date to the date when the PTAB final written decision will be due, the PTAB will consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides.⁴ This memorandum clarifies those practices.

This memorandum is issued under the Director's authority to issue binding agency guidance to govern the PTAB's implementation of various statutory provisions, including directions regarding how those statutory provisions will apply to sample fact patterns. *See, e.g.*, 35 U.S.C. 3(a)(2)(A); PTAB Standard Operating Procedure (SOP) 2 at 1–2.

Analysis

Compelling Merits

In the AIA, Congress established post-grant proceedings, including IPR, PGR, and covered business method (CBM) proceedings to improve and ensure patent quality by providing “quick and cost-effective alternatives to litigation” for challenging issued patents. H.R. Rep. No. 112–98, pt. 1, at 48; *see also* S. Rep. No. 110–259, at 20 (explaining that the “post-grant review

³ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

⁴ <https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics>

system . . . will give third parties a quick, inexpensive, and reliable alternative to district court litigation to resolve questions of patent validity”). Congress granted the Office “significant power to revisit and revise earlier patent grants” as a mechanism “to improve patent quality and restore confidence in the presumption of validity that comes with issued patents.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 272 (2016) (quoting H.R. Rep. No. 112-98, pt. 1, at 45, 48). Given those objectives, compelling, meritorious challenges will be allowed to proceed at the PTAB even where district court litigation is proceeding in parallel. Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence. That said, the PTAB retains discretion to deny institution for proceedings where abuse has been demonstrated.

Fintiv factor six reflects that the PTAB considers the merits of a petitioner’s challenge when determining whether to institute a post-grant proceeding in view of parallel district court litigation. Where the information presented at the institution stage is merely sufficient to meet the statutory institution threshold,⁵ the PTAB has the authority, where warranted, to exercise discretion to deny institution in view of the other *Fintiv* factors. In contrast, where the PTAB determines that the information presented at the institution stage presents a compelling

⁵ Institution of an IPR is authorized by statute only when “the information presented in the petition . . . and any response . . . 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) (2018). Similarly, institution of a PGR, including a CBM, is authorized only when “the information presented in the petition . . . , if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable” *Id.* § 324(a).

unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.⁶

This clarification strikes a balance among the competing concerns of avoiding potentially conflicting outcomes, avoiding overburdening patent owners, and strengthening the patent system by eliminating patents that are not robust and reliable. Consistent with Congress's giving the Office the authority to revisit issued patents, the PTAB will not deny institution based on *Fintiv* if there is compelling evidence of unpatentability. This approach "allows the proceeding to continue in the event that the parallel proceeding settles or fails to resolve the patentability question presented in the PTAB proceeding." *Fintiv*, Paper 11 at 15. The patent system and the public good benefit from instituting compelling unpatentability challenges.

ITC and *Fintiv*

In 2018, the PTAB issued a decision in *NHK Spring*.⁷ There, the PTAB held that the advanced state of a parallel district court litigation involving similar validity disputes could be a factor weighing in favor of denying institution of an IPR because of concerns over the inefficient

⁶ The compelling evidence test affirms the PTAB's current approach of declining to deny institution under *Fintiv* where the evidence of record so far in the case would plainly lead to a conclusion that one or more claims are unpatentable. See, e.g., *Illumina Inc. v. Trs. of Columbia Univ.*, IPR2020-00988, Paper 20 (PTAB Dec. 8, 2020) (declining to deny under *Fintiv* in light of strong evidence on the merits even though four factors weighed in favor of denial and remaining factor was neutral); *Synthego Corp. v. Agilent Techs., Inc.*, IPR2022-00402, Paper 11 (May 31, 2022) (granting institution as efficiency and integrity of the system would not be served by denying institution of petition with particularly strong evidence on the merits); *Samsung Elecs. Co. v. Scramoge Tech., Ltd.*, IPR2022-00241, Paper 10 (June 13, 2022) (*Fintiv* analysis concludes that "very strong" evidence on the merits outweigh concurrent litigation involving earlier scheduled trial date and significant overlap in proceedings).

⁷ *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). This decision also based the denial of institution on Director discretion under 35 U.S.C. § 325(d).

use of PTAB's resources. *NHK Spring*, Paper 8 at 19–20. Later, in 2020, the PTAB announced the *Fintiv* factors, which the PTAB considers when a patent owner raises an argument for discretionary denial under *NHK Spring* due to an earlier trial date. *Fintiv*, Paper 11 at 5–6. The *Fintiv* factors focus on the interplay between IPRs and district court litigation. Through that focus, the *Fintiv* factors seek to avoid duplicative efforts between the PTAB and federal district courts. For example, *Fintiv* factor one asks whether the “court” has granted a stay or if one may be granted. Similarly, *Fintiv* factor two looks at the proximity of the “court” trial date. Likewise, *Fintiv* factor three concerns the amount of investment in the parallel proceeding by the “court” and the parties. *Fintiv* factors five and six refer to the same parallel proceeding described in factor three.

Although the *Fintiv* factors are directed to district court litigation and not ITC proceedings,⁸ the PTAB has, in the past, denied AIA reviews based on parallel ITC investigations.⁹ Important differences, however, distinguish ITC investigations from patent invalidity trials in federal district courts. Unlike district courts, the ITC lacks authority to invalidate a patent and its invalidity rulings are not binding on either the Office or a district court. See *Tandon Corp. v. U.S.I.T.C.*, 831 F.2d 1017, 1019 (Fed. Cir. 1987). Therefore, an ITC determination cannot conclusively resolve an assertion of patent invalidity, which instead requires either district court litigation or a PTAB proceeding to obtain patent cancellation. Thus, denying institution because of a parallel ITC investigation will not necessarily minimize

⁸ *Fintiv* refers to ITC proceedings in discussing factor one. *Fintiv*, Paper 11 at 8–9. Addressing the situation where district court litigation is stayed pending an ITC investigation, *Fintiv* states in *dicta* that “it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC.” *Id.* at 9.

⁹ See, e.g., *Philip Morris Prods. S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-00919, Paper 9 (PTAB Nov. 16, 2020).

potential conflicts between PTAB proceedings and district court litigation. For the foregoing reasons, the PTAB no longer discretionarily denies petitions based on applying *Fintiv* to a parallel ITC proceeding. This memorandum memorializes that practice. The PTAB will not discretionarily deny petitions based on applying *Fintiv* to a parallel ITC proceeding.

***Sotera* Stipulations**

Fintiv factor four looks at the overlap between the issues raised in the IPR petition and in the parallel proceeding in order to evaluate “concerns of inefficiency and the possibility of conflicting decisions.” *Fintiv*, Paper 11 at 12. If the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial. *Id.* at 12. Conversely, if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution. *Id.* at 12–13.

When a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition, it mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB. *See Sotera*, Paper 12 at 18–19. With such a stipulation, if an IPR or PGR is instituted, the grounds the PTAB resolves will differ from those present in the parallel district court litigation. For these reasons, the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition. This clarification avoids inconsistent outcomes

between the PTAB and the district court and allows the PTAB to review grounds that the parallel district court litigation will not resolve.

Trial Date

Fintiv factor two considers the proximity of the court's trial date to the Board's projected statutory deadline for a final written decision. When applying this factor, the PTAB has taken the "courts' trial schedules at face value absent some strong evidence to the contrary."¹⁰ Thus, the PTAB has generally weighed this factor in favor of exercising discretion to deny institution if the trial date is scheduled before the projected statutory deadline for a final written decision.

In response to the RFC, a number of commenters expressed concern with the use of trial dates as a factor.¹¹ Stakeholders correctly noted that scheduled trial dates are unreliable and often change. A court's scheduled trial date, therefore, is not by itself a good indicator of whether the district court trial will occur before the statutory deadline for a final written decision.

Accordingly, when analyzing the proximity of the court's trial date under factor two of *Fintiv*, when other relevant factors weigh against exercising discretion to deny institution or are neutral, the proximity to trial should not alone outweigh all of those other factors. *See In re Genentech, Inc.*, 566 F.3d 1338, 1347 (Fed Cir. 2009). Parties may present evidence regarding the most recent statistics on median time-to-trial for civil actions in the district court in which the

¹⁰ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 13 (May 13, 2020) (informative) (applying the *Fintiv* factors articulated in the precedential *Fintiv* decision).

¹¹ *See USPTO Executive Summary of Public Views on Discretionary Institution of AIA Proceedings* (Jan. 2021) (available at <https://www.uspto.gov/sites/default/files/documents/USPTOExecutiveSummaryofPublicViewsonDiscretionaryInstitutiononAIAProceedingsJanuary2021.pdf>).

parallel litigation resides¹² for the PTAB's consideration. Where the parties rely on time-to-trial statistics, the PTAB will also consider additional supporting factors such as the number of cases before the judge in the parallel litigation and the speed and availability of other case dispositions. *See id.*; *In re Google LLC*, No. 2021-178, 2021 WL 5292267 at *3 (Fed. Cir. 2021).

Conclusion

In summary, the PTAB will not deny institution of an IPR or PGR under *Fintiv* (i) when a petition presents compelling evidence of unpatentability; (ii) when a request for denial under *Fintiv* is based on a parallel ITC proceeding; or (iii) where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition. Additionally, when the PTAB is applying *Fintiv* factor two, the PTAB will consider the speed with which the district court case may come to trial and be resolved. The PTAB will weigh this factor against exercising discretion to deny institution under *Fintiv* if the median time-to-trial is around the same time or after the projected statutory deadline for the PTAB's final written decision. That said, even if the PTAB does not deny institution under *Fintiv*, it retains the right to deny institution for other reasons under 35 U.S.C. §§ 314(a), 324(a), and 325(d). For example, the PTAB may deny institution if other pertinent circumstances are present, such as abuse of process by a petitioner.

This interim guidance applies to all proceedings pending before the Office. This interim guidance will remain in place until further notice. The Office expects to replace this interim guidance with rules after it has completed formal rulemaking.

¹² The most recent statistics are available at: <https://www.uscourts.gov/statistics/table/na/federal-court-management-statistics/2022/03/31-1>.



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Update: On March 24, 2025, the USPTO published an updated [Guidance memorandum on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation"](#), which can be found in the Guidance Memorandum section of the [PTAB resources page](#).

USPTO rescinds memorandum addressing discretionary denial procedures

February 28, 2025

Today, the USPTO rescinded the June 21, 2022, memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Memorandum).

Parties to post-grant proceedings should refer to Patent Trial and Appeal Board (PTAB) precedent for guidance, including [Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 \(PTAB Mar. 20, 2020\) \(precedential\)](#) and [Sotera Wireless, Inc. v. Masimo Corp., IPR2020-01019, Paper 12 \(PTAB Dec. 1, 2020\) \(precedential as to § II.A\)](#).

To the extent any other PTAB or Director Review decisions rely on the Memorandum, the portions of those decisions relying on the Memorandum shall not be binding or persuasive on the PTAB.

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United States Patent and Trademark Office

Patent Trial and Appeal Board

MEMORANDUM

To: Members of the Patent Trial and Appeal Board

From: 
Scott R. Boalick, Chief Administrative Patent Judge

Subject: Guidance on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation"

Date: March 24, 2025

On February 28, 2025, the USPTO rescinded the June 21, 2022 memorandum entitled "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" ("Interim Procedure"). The Interim Procedure was intended to provide guidance while the USPTO explored potential rulemaking, but the USPTO did not subsequently propose a final rule addressing the Director's and, by delegation, the Patent Trial and Appeal Board's ("Board") exercise of discretionary institution in an *inter partes* review ("IPR") or a post-grant review ("PGR") in view of a parallel litigation. In the absence of rulemaking, the USPTO rescinded the Interim Procedure to restore policy in this area to the guidance in place before the Interim Procedure, including the Board's precedential decisions in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) ("*Fintiv*") and *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) ("*Sotera*"). This memorandum sets forth additional guidance.

First, the Interim Procedure's recission applies to any case in which the Board has not issued an institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending. The Board will consider timely requests for additional briefing on the application of the Interim Procedure's recission on a case-by-case basis. Absent extraordinary circumstances, the Board will not revisit a decision on institution if the time for seeking Director Review or rehearing has passed.

Second, the Board will apply the *Fintiv* factors when there is a parallel proceeding at the International Trade Commission ("ITC"). As the *Fintiv* decision explains, although an ITC final invalidity determination does not have preclusive effect, it is difficult as a practical matter to assert patent claims that the ITC has determined are invalid. *See Fintiv*, Paper 11 at 8–9. Additionally, instituting an IPR or a PGR where the ITC has set a target date for completing its investigation (i.e., the full Commission's final determination) to occur earlier than the Board's deadline to issue a final written decision in a challenge involving the same patent claims means that multiple tribunals may be adjudicating validity at the same time, which may increase duplication and expenses for the parties and the tribunals. Thus, the Board is more likely to deny institution where the ITC's projected final determination date is earlier than the Board's deadline to issue a final written decision, and the Board is less likely to deny institution under *Fintiv* where the ITC projected final determination date is after the Board's deadline to issue a final written decision.

Third, a timely-filed *Sotera* stipulation¹ (i.e., a stipulation from a petitioner that, if an IPR or PGR is instituted, the petitioner will not pursue in district court

¹ *See NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (Sept. 7, 2022) (precedential) (holding that the only appropriate time for a petitioner to offer a stipulation is prior to the Board's decision on institution).

(or in the ITC) any ground raised or that could have been reasonably raised in the IPR/PGR) is highly relevant, but will not be dispositive by itself. Instead, the Board will consider such a stipulation as part of its holistic analysis under *Fintiv*.

Fourth, in applying *Fintiv*, the Board may consider any evidence that the parties make of record that bears on the proximity of the district court's trial date or the ITC's final determination target date, including median time-to-trial statistics for civil actions in the district court in which the parallel litigation resides.

Fifth, as stated in *Fintiv*, the factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the strength of the merits. However, compelling merits alone is not dispositive in making the assessment.

MEMORANDUM

To: All PTAB Judges

From: Coke Morgan Stewart 
Acting Under Secretary of Commerce for Intellectual Property
and Acting Director of the United States Patent and Trademark Office

Subject: Interim Processes for PTAB Workload Management

Date: March 26, 2025

The Patent Trial and Appeal Board (PTAB) is tasked with several statutory duties under 35 U.S.C. § 6(b), including deciding *ex parte* appeals from adverse examiner decisions by patent applicants and conducting America Invents Act (AIA) trial proceedings, such as *inter partes* reviews (IPRs) and post-grant reviews (PGRs). To ensure that the PTAB continues to meet its statutory obligations as to *ex parte* appeals, while continuing to maintain its capacity to conduct AIA proceedings, the Director will exercise her discretion on institution of AIA proceedings under 35 U.S.C. §§ 314(a) and 324(a) as outlined below.

First, decisions on whether to institute an IPR or PGR will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary statutory considerations. Under this interim procedure, the Director, in consultation with at least three PTAB judges, will determine whether discretionary denial of institution is appropriate. If it is appropriate, the Director will issue a decision denying institution. If it is not appropriate, the Director will issue a decision regarding that determination and refer the petition to a three-member panel of the PTAB assigned according to Standard Operating Procedure (SOP) 1 (Rev. 16). The three-member panel will then handle the case in the normal course including by issuing a decision on institution addressing the merits and other non-discretionary statutory considerations.

Second, to facilitate this bifurcated approach, the USPTO will permit parties to file separate briefing on requests for discretionary denial of institution. The discretionary denial briefing shall proceed as follows: (1) within two months of the date on which the PTAB enters a Notice of Filing Date Accorded to a petition, a patent owner may file a brief explaining any applicable bases for discretionary denial of institution; and (2) a petitioner may file an opposition brief no later than one month after the patent owner files its brief. Leave to file further briefing may be permitted for good cause. Consistent with 37 C.F.R. § 42.24, discretionary denial briefing will be limited to 14,000 words. A reply brief, if any, will be limited to 5,600 words. The merits briefing schedule and the schedule for requesting rehearing or Director Review as to a decision on institution remain unchanged.

Third, consistent with the discretionary considerations enumerated in existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics*^{*}) and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and

^{*} *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2027) (precedential as to § II.B.4.i); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential).

- Any other considerations bearing on the Director's discretion.

The Director will also consider the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs. *See* 35 U.S.C. § 316(b).

These processes aim to improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings, reduce pendency in *ex parte* appeals, and promote consistent application of discretionary considerations in the institution of AIA proceedings. The processes described herein will be implemented in IPR and PGR proceedings where the deadline for the patent owner to file a preliminary response has not yet passed. In that situation, if the time for filing discretionary denial briefing as described herein has already elapsed, the patent owner may submit discretionary denial briefing within one month of the date of this memorandum.

The processes described herein are temporary in nature due, in part, to the current workload needs of the PTAB.



Home > Patents > PTAB > FAQs for Interim Processes for PTAB Workload Management

FAQs for Interim Processes for PTAB Workload Management

On March 26, 2025, the United States Patent and Trademark Office (USPTO or Office) issued a [memorandum on interim processes for PTAB workload management](#) (Process Memorandum). Under the Process Memorandum, decisions on whether to institute *inter partes* reviews (IPR) and post-grant reviews (PGR) will be bifurcated between (i) discretionary considerations and (ii) merits and other non-discretionary considerations.

To help facilitate briefing, this page provides answers to frequently asked questions (FAQs) the Office has received about the bifurcated process and the discretionary considerations. The Office may update the FAQs after some experience with the interim processes, so please check back frequently for updates. The information presented in the FAQs controls the interim processes.

FAQs

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▼ Availability and timing

1. In which *inter partes* review (IPR) and post-grant review (PGR) proceedings is the bifurcated process available?

The bifurcated process is available in IPRs and PGRs in which patent owner files a preliminary response, or the deadline for patent owner to file a preliminary response occurs, after March 26, 2025.

2. What are the timing requirements for briefing on discretionary considerations under the bifurcated process?

A patent owner may file a brief explaining any applicable bases for discretionary denial of institution within two months of the date on which the PTAB enters a Notice of Filing Date Accorded to a petition. The petitioner may file an opposition brief no later than 1 month after the due date for the patent owner discretionary denial brief (i.e., on the due date for the patent owner preliminary response (POPR)). Leave to file further briefing may be permitted by the Director for good cause.

3. What happens if the time for filing a discretionary denial brief has not yet elapsed, but will elapse in 1 month or less after the issuance of the Process Memorandum?

In such cases, the Board has or will issue a notice extending the deadline for a discretionary denial brief. In this situation, the patent owner may file a discretionary denial brief within 1 month of the date of the notice. The petitioner may file an opposition to the discretionary denial brief no later than 1 month after the due date for the patent owner discretionary denial brief.

4. What happens if the time for filing a discretionary denial brief has elapsed, but the deadline for filing a POPR has not yet passed?

As the March 26, 2025 Process Memorandum states, in this situation, the patent owner may file a discretionary denial brief within 1 month of the date of the Process Memorandum. The petitioner may file an opposition to the discretionary denial brief no later than 1 month after the due date for the patent owner discretionary denial brief.

5. What is the process if a patent owner filed a POPR, or the deadline for filing a POPR passed, on or before the Process Memorandum issued on March 26, 2025?

In this situation, the bifurcated process is not available, and a Board panel will proceed as it would have before the Process Memorandum issued. Thus, during the preliminary phase of an AIA proceeding, a Board panel will address any discretionary considerations and merits and other non-discretionary considerations the parties raise (e.g., in a petition or a POPR), as enumerated in previously existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics*) and the Consolidated Trial Practice Guide (Nov. 2019). The panel will not address any new factors outlined in the Process Memorandum, nor consider a request for rehearing based on those new factors.

6. Can the parties stipulate to later due dates for discretionary considerations briefing?

To ensure statutory deadlines are met, the parties may not stipulate to later due dates for filing the discretionary considerations briefing. A party, however, may file its discretionary denial brief or an opposition before the due date.

7. How will the timing change if a patent owner files its discretionary denial brief early? For example, if a patent owner files its discretionary denial brief early enough, will a petitioner's opposition brief be due, and the Director's decision on discretionary considerations issue, before the POPR due date?

The timing will not change if a patent owner files its discretionary denial brief early. A petitioner opposition will be due within 1 month of the due date for a patent owner discretionary denial brief (i.e., on the POPR due date) and the Director's decision will not issue until after a patent owner files its POPR or the deadline for filing the POPR has passed.

▼ Procedures/processes

8. What procedures will the Director follow if a patent owner timely files a discretionary denial brief?

The Director will receive each petition, discretionary denial brief, opposition brief, and POPR, as well as any evidence the parties have made of record in support of their papers. Similar to the Director Review process, once received, the Director will determine, in consultation with at least three senior PTAB judges who will be separate from judges addressing the merits, whether discretionary denial is appropriate, as set forth in the Process Memorandum. In deciding whether to exercise discretion to institute IPR, the Director may consult with other USPTO employees as needed, as long as those individuals do not have a conflict of interest.

(UPDATED May 7, 2025) When parties present arguments regarding the strength of the merits, the Director will consult with USPTO personnel with relevant technical expertise.

Absent good cause, the Director will issue a decision on discretionary considerations within 1 month of the due date of the last relevant paper filed. The Director's decision will explain why the Director has decided to exercise discretion to deny institution or why a discretionary denial is not appropriate.

9. In cases where the bifurcated process is available, will the Director issue a decision on discretionary considerations in every case, or only those where patent owner files a discretionary denial brief?

If a patent owner chooses not to file a discretionary denial brief, the Director will not issue a decision on discretionary considerations. In that situation, the Office will enter a notice into the docket indicating the case is now before a Board panel to consider the non-discretionary issues.

After such a notice is entered, a Board panel will issue a decision on institution addressing the merits and other non-discretionary considerations the parties have raised in the petition, a POPR, and any additional briefing that the Board panel has authorized. Unless otherwise authorized by the Director, the Board panel will not address discretionary considerations, except where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources, as explained in *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative) ("*Chevron*") and *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative) ("*Deeper*").

10. How is responsibility for institution decisions allocated during the bifurcated process?

Under the bifurcated process, the Director retains authority over institution decisions but delegates certain responsibilities depending on whether a patent owner files a discretionary denial brief.

If a patent owner timely files a discretionary denial brief, unless the Director states otherwise, the Director retains responsibility for resolving whether the proceeding should be denied on discretionary grounds.

If the Director issues a decision determining that discretionary denial is not appropriate, responsibility for preparing the institution decision on the merits and other non-discretionary issues is delegated to a panel of the Board. The Board panel will typically have 2 months to issue the decision on institution.

If a patent owner does not file a discretionary denial brief, responsibility will pass to a Board panel the day after the due date for such a brief. In that situation, after the due date for a discretionary denial brief has passed, the Office will enter a notice into the record indicating the case is before a Board panel.

If a party has a question about a proceeding before the due date for a discretionary denial brief, they may contact the Board at 571-272-9797, from 8:30 a.m. to 5 p.m. ET on weekdays, or email Director_Discretionary_Decision@uspto.gov.

11. What are examples of “discretionary considerations” versus merits or other non-discretionary considerations, as mentioned in the Process Memorandum?

The Process Memorandum includes a non-exhaustive list of issues that may be raised in discretionary briefing. Parties are encouraged to address any fact or circumstance they believe bears on the Director’s discretion to institute, including reasons not discussed in current Board precedent or in the Process Memorandum.

The “merits” considerations refer to whether there is a reasonable likelihood that a petitioner would prevail with respect to at least one of the claims challenged in an IPR petition, or whether it is more likely than not that at least one of the claims challenged in a PGR petition is unpatentable or the PGR petition raises a novel or unsettled legal question that is important to other patents or patent applications.

In addition to the discretionary considerations involving whether a petition presents a sufficient number of grounds/challenges of claims that meet the reasonable likelihood standard, as discussed in FAQ 9 (see *Chevron* and *Deeper*), non-discretionary considerations include those relevant to, for example, 35 U.S.C. §§ 311, 312, 315(a), (b), and (e), 322, and 325(a) and (e). Such considerations also may include, for example: (1) claim construction issues (see, e.g., *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024)); or (2) whether a petition meets the requirements of 37 C.F.R. § 42.104(b) (see, e.g., *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (PTAB Mar. 6, 2019) (informative)).

12. If a patent owner argues merits in a discretionary denial brief, and the Director determines that discretionary denial is not appropriate, will the Board panel consider merits arguments made in a discretionary denial brief or related briefing, such as an opposition brief by a petitioner?

No. Once the Director determines that discretionary denial is not appropriate, the Board panel will not consider papers filed by parties relating to discretionary considerations. Parties must make all their arguments (citing evidence, as needed) on the merits and other non-discretionary considerations in the petition, POPR, and any authorized reply or sur-reply. A Board panel will consider only arguments and evidence cited in those papers when determining whether to grant or deny institution.

However, the Director will consider the merits in the merits briefing if the parties ask the Director to do so. Parties should not repeat their merits arguments verbatim but should briefly explain why the merits are relevant.

13. If the Director’s discretionary consideration decision addresses the strength of the merits in a petition (e.g., as part of *Fintiv* factor 6), is the Board panel bound by such findings or conclusions in rendering a decision on institution?

A Board panel is not bound by merit findings or conclusions in a discretionary consideration decision but must explain in the decision on institution why the panel’s findings and/or determination are different (citing the parties’ evidence of record as relevant), if that occurs.

14. When should a petitioner file a *Sotera* or *Sand* stipulation if they wish to do so? What happens if a petitioner files a *Sotera* or *Sand* stipulation after the Director issues a decision on discretionary considerations?

A petitioner should file a *Sotera* or *Sand* stipulation as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief. The Director will take into account whether the stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.

15. Will cases involving motions for joinder be handled differently with respect to processes or timing?

No, such cases will be handled the same way as discussed above. Thus, in a proceeding involving a motion for joinder, if a patent owner files a POPR (or the deadline for filing a POPR passes) after March 26, 2025, the bifurcated process is available. By contrast, if a patent owner had filed a POPR (or the deadline for filing a POPR had passed) on or before March 26, 2025, the bifurcated process is not available.

A decision on whether to grant a joinder motion and join a party to an instituted proceeding will be decided by a Board merits panel. To the extent a party disagrees with the Board’s decision, that party may file a request for Director Review.

16. What is the process for requesting a reply brief to a petitioner’s discretionary denial opposition brief?

A patent owner who wants to request a reply should send an email request, with a copy to counsel for all parties, to Director_Discretionary_Decision@USPTO.gov.

17. Who determines whether good cause exists for a petitioner to file a reply to a POPR, or for a patent owner to file a sur-reply to such a reply?

The Board panel. For example, as noted in the Consolidated Trial Practice Guide (Nov. 2019) (pp. 51–52), submission of patent owner testimonial evidence at the preliminary stage may warrant granting the petitioner a reply to such evidence. A request to file a reply to a

POPR must make a showing of good cause. A decision concerning whether the petitioner will be afforded a reply and the appropriate scope of such a reply rest with the Board panel.

18. Who decides pro hac vice motions and other procedural motions that do not relate to discretionary considerations?

The Board panel will decide procedural motions that do not relate to discretionary considerations regardless of when those motions are filed. To facilitate resolution of procedural motions, the PTAB will assign a Board panel to the case before the Director issues a decision on discretionary decisions. That Board panel will decide all procedural motions.

▼ Briefing requirements

19. What are the word limits for the discretionary considerations briefs?

As set forth in the Process Memorandum, a patent owner's discretionary denial brief is limited to 14,000 words and a petitioner's opposition brief is limited to 14,000 words.

20. What types of issues should the parties address in their discretionary considerations briefing?

Parties are encouraged to address any fact or circumstance they believe bears on whether the Office should or should not institute trial, including reasons not discussed in current Board precedent or the Process Memorandum.

21. How does the extent of the petition's reliance on expert testimony bear on discretion to institute IPR or PGR?

While the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court. The statute and our reviewing court require that petitions be based on prior art patents and printed publications. As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.

22. If the bifurcated process is available, is a patent owner required to address discretionary denial issues in a discretionary denial brief, or may it address such issues in a POPR instead?

If a patent owner wishes to raise any applicable bases for discretionary denial, it must do so in a discretionary denial brief. Absent extraordinary circumstances, the Director and the Board panel will not consider arguments relating to discretionary denial raised in a POPR.

If a patent owner does not file a discretionary denial brief, a Board panel will address any merits and other non-discretionary considerations raised by the parties in the petition, POPR, and, as applicable, any related papers, such as a reply and sur-reply (if authorized for good cause). Unless otherwise authorized by the Director, the Board panel will not address any discretionary considerations presented in the Process Memorandum.

23. If a patent owner's discretionary denial brief is due after the due date of the POPR in view of an extension notice (or by operation of the 1-month extension provided in the Process Memorandum), should the patent owner address discretionary issues in its POPR or only address such issues in its discretionary denial brief?

If a patent owner would like the Office to consider discretionary denial arguments, it must file a discretionary denial brief and address such issues in that brief, even if that brief is due after a POPR due date. As noted above in response to FAQs 9 and 22, absent extraordinary circumstances, a Board panel will not address any discretionary considerations presented in a POPR.

24. Should a petitioner address discretionary issues in its petition?

No. The petition should not address discretionary issues. A petitioner should raise any discretionary issues in its opposition to a patent owner's discretionary denial brief, including issues relating to 35 U.S.C. § 325(d), parallel proceedings, parallel petitions, serial petitions, and any other matter bearing on the Director's discretion to institute.

25. May a discretionary denial brief or opposition include arguments relating to merits or claim construction?

The parties should not treat a discretionary denial brief or opposition as an additional opportunity for merits briefing.

Notwithstanding the prohibition on incorporation by reference in 37 C.F.R. § 42.6(a)(3), when filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits. Similarly, in arguing about the strengths or weaknesses of the merits, the parties may refer to arguments made in the petition and cite to record evidence. As explained

above in response to FAQ 8, the Director will receive the petition, the POPR, and the parties' discretionary briefing. Thus, the Director will consider the merits arguments made in the petition and the POPR when relevant to the discretion determination.

The parties' discretionary briefing may also address claim construction if it is relevant to the discretionary considerations.

26. Can parties introduce evidence with their discretionary briefing and, if so, what evidence can they introduce?

Yes. The parties may introduce evidence relevant to the discretionary issues raised in their briefing. However, parties should keep in mind that the Director will consider the petition, the POPR, and the evidence cited therein in determining whether discretionary denial is appropriate.

▼ Requests for rehearing by the Board panel or Director Review

27. May I file a request for rehearing with the Board panel where the request raises issues regarding both (i) discretionary considerations and (ii) merits or other non-discretionary considerations?

No. A party may request rehearing by a Board panel only if the request raises issues regarding the merits and other non-discretionary considerations. A party may request rehearing by the Director if the request only raises discretionary considerations. If a party would like to request rehearing where the request will raise (i) discretionary considerations and (ii) merits or other non-discretionary considerations, that party must file a request for Director Review.

If the Director exercises discretion to deny institution, then a party may file a request for rehearing or Director Review within 30 days of the Director's decision. If the Director issues a decision determining that discretionary denial is not appropriate, a party should file a single request for rehearing or Director Review after the Board panel issues its decision. If the party is requesting Director review, the party shall file its request under the procedures set forth in 37 C.F.R. § 42.75(c) and submit the fee as set forth in 37 C.F.R. § 42.15(f).

If a party incorrectly files a request for rehearing by the Board panel, the Office will treat that request as a request for Director Review, and the party will be notified that it must refile the request as a request for Director Review and pay the Director Review fee.

28. May I file a request for rehearing of a decision on institution where the request raises issues regarding merits or other non-discretionary considerations, but does not raise discretionary considerations?

Yes, a party may file either a request for rehearing by the Board panel or a request for Director Review (but not both).

29. If circumstances change after the Director issues a decision on discretionary considerations (e.g., a trial date changes), can a party raise that fact in a request for rehearing or a request for Director Review?

Yes, a party may raise changed circumstances in a request for rehearing or a request for Director Review filed within the applicable time period in exceptional cases.

▼ Conflicts of interest

30. How will conflicts of interest be handled for the bifurcated process?

If the Director, a consulting member of the PTAB, or any other USPTO employee has a conflict of interest, they shall recuse themselves from the case.

In determining whether a conflict of interest exists, the USPTO follows the guidance set forth in the Standards of Ethical Conduct for Employees of the Executive Branch at 5 C.F.R. Part 2635 and will consult with the Department of Commerce Ethics Law and Programs Office, as necessary, to resolve any questions pertaining to conflicts of interest. Conflicts may include, for example, involvement in the examination or prosecution of the underlying patent or a related patent at issue. Further information is available in the U.S. Department of Commerce USPTO Summary of Ethics Rules.

As a matter of policy, the PTAB judges who consult with the Director will additionally follow the guidance on conflicts of interest set forth in the PTAB's [SOP 1](#).

▼ New paper types for discretionary denial briefing

31. How do I file a patent owner discretionary denial brief in P-TACTS?

After the PTAB issues a Notice of Filing Date Accorded (or a Notice of Defective Petition) and the PTAB accepts a patent owner's Mandatory Notice, the new paper type "PO Discretionary Denial Brief" will be available. To select the new paper type, a patent owner should: (1) log into P-TACTS; (2) go to My Docket and select the AIA review case number to open Case Viewer; (3) select the "+Add" button and File Other Document modal from the menu option; (4) select "PO Discretionary Denial Brief" from the list of paper types; (5) enter information into all required fields marked by a red asterisk beginning with paper type; (6) select "PO Discretionary Denial Brief"; and (7) click on "Add to List" and then "Submit."

32. How do I file a petitioner opposition to the patent owner discretionary denial brief in P-TACTS?

After a patent owner files its discretionary denial brief, the new paper type "PET Opposition to Discretionary Denial Brief" will be available. To select the new paper type, a petitioner should: (1) log into P-TACTS; (2) go to My Docket and select the AIA review case number to open Case Viewer; (3) select the "+Add" button and File Other Document modal from the menu option; (4) select "PET Opposition to Discretionary Denial Brief" from the list of paper types; (5) enter information into all required fields marked by a red asterisk beginning with paper type; (6) select "PET Opposition to Discretionary Denial Brief"; and (7) click on "Add to List" and then "Submit."

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

CERENCE OPERATING COMPANY,

Patent Owner

Case IPR2024-01464

U.S. Patent No. 11,393,461

**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 11,393,461**

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- a. 1[pre]: A method of monitoring an acoustic environment of a mobile device for voice commands when the mobile device is operating in a low power mode, the method comprising:20
- b. 1[a]: receiving acoustic input from the environment of the mobile device while the mobile device is operating in idle mode; and.....22
- c. 1[b]: in response to receiving the acoustic input, determining whether the received acoustic input includes a voice command by processing the received acoustic input,24
- d. 1[c]: the processing employing at least one contextual cue, the at least one contextual cue comprising information other than content of the acoustic input and comprising a time the acoustic input was received, motion of the mobile device, location of the mobile device, occurrence of an event on the mobile device, recent activity on the mobile device, a stored sample of the acoustic environment of the mobile device and/or a power source of the mobile device,26
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PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,393,461 (“’461 Patent”)
1002	Declaration of Christopher M. Schmandt
1003	Curriculum Vitae of Christopher M. Schmandt
1004	File History of U.S. Patent No. 11,393,461
1005	U.S. Patent No. 9,031,847 (“Sarin”)
1006	U.S. Patent Application Publication No. 2013/0110521 (“Hwang”)
1007	U.S. Patent No. 7,475,012 (“Garner”)
1008	U.S. Patent Application Publication No. 2012/0265528 (“Gruber”)
1009	U.S. Patent No. 8,396,463 (“Marcellino”)
1010	U.S. Patent No. 8,331,315 (“Purkayastha”)
1011	U.S. Patent No. 8,694,316 (“Pickering”)
1012	U.S. Patent Application Publication No. 2013/0173269 (“Adler”)
1013	Intentionally Left Blank
1014	U.S. Patent Application Publication No. 2020/0279576 (“Binder”)
1015	U.S. Patent Application Publication No. 2014/0006825 (“Shenhav”)
1016	U.S. Patent Application Publication No. 2012/0034904 (“LeBeau”)
1017	U.S. Patent Application Publication No. 2010/0129068 (“Binda”)
1018	U.S. Patent Application Publication No. 2012/0296655 (“Kristjansson”)
1019	U.S. Patent Application Publication No. 2014/0163978 (“Basye”)

IPR2024-01464
U.S. Patent No. 11,393,461

Exhibit No.	DESCRIPTION
1020	Claim Mapping Table
1021	Plaintiff Cerence Operating Company's Disclosure of Asserted Claims and Infringement Contentions, <i>Cerence Operating Company v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Mar. 11 2024)
1022	Docket Control Order, <i>Cerence Operating Company v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Apr. 16, 2014)
1023	Intentionally Left Blank
1024	U.S. Patent Application Publication No. 2013/0332165 ("Beckley")
1025	U.S. Patent Application Publication No. 2014/0350927 ("Yamabe")
1026	U.S. Patent Application Publication No. 2003/0179888 ("Burnett")
1027	Intentionally Left Blank
1028	Intentionally Left Blank
1029	U.S. Patent Application Publication No. 2013/0006638 ("Lindahl")

LISTING OF CHALLENGED CLAIMS

Claim 1	
1[pre]	A method of monitoring an acoustic environment of a mobile device for voice commands when the mobile device is operating in a low power mode, the method comprising:
1[a]	receiving acoustic input from the environment of the mobile device while the mobile device is operating in idle mode; and
1[b]	in response to receiving the acoustic input, determining whether the received acoustic input includes a voice command by processing the received acoustic input,
1[c]	the processing employing at least one contextual cue, the at least one contextual cue comprising information other than content of the acoustic input and comprising a time the acoustic input was received, motion of the mobile device, location of the mobile device, occurrence of an event on the mobile device, recent activity on the mobile device, a stored sample of the acoustic environment of the mobile device and/or a power source of the mobile device,
1[d]	the processing of the received acoustic input comprising a plurality of processing stages, at least one of the processing stages being performed while the mobile device is operating in the idle mode.
Claim 2	
2	The method of claim 1, further comprising transitioning the mobile device from the idle mode to an active mode in response to detecting that the acoustic input includes a voice command.
Claim 3	
3	The method of claim 1, wherein the at least one contextual cue includes the time the acoustic input was received, and the method comprises influencing evaluation of at least one of the plurality of

	processing stages based on the time the acoustic input was received.
Claim 4	
4	The method of claim 1, wherein the at least one contextual cue includes recent activity on the mobile device, the method further comprising evaluation of at least one of the plurality of processing stages based on at least one of how recently the user activated the mobile device, how recently the user issued a voice command and how recently the user performed at least one action on the mobile device.
Claim 5	
5	The method of claim 1, wherein the at least one contextual cue includes an occurrence of an event on the mobile device, and the method comprises influencing evaluation of at least one of the plurality of processing stages based on whether the acoustic input is received proximate in time with the occurrence of the event.
Claim 6	
6	The method of claim 1, wherein the at least one contextual cue includes motion of the mobile device received as an input from an accelerometer of the mobile device, the method comprises influencing evaluation of at least one of the plurality of processing stages based on an assessment of whether the user moved the mobile device proximate in time with receiving the acoustic input based, at least in part, on the input from the accelerometer.
Claim 7	
7	The method of claim 1, wherein the at least one contextual cue includes the location of the mobile device, and the method comprises influencing evaluation of at least one of the plurality of processing stages based on determining whether the mobile device is located in at least one of a vehicle, a home or a place of work of the user of the mobile device.
Claim 8	

8	The method of claim 1, wherein the at least one contextual cue includes the power source of the mobile device, and the method comprises influencing evaluation of at least one of the plurality of processing stages based on at least one of determining whether the mobile device is being powered using a battery or wall power, and a state of the battery if the mobile device is being powered using the battery.
Claim 9	
9	The method of claim 1, wherein the at least one contextual cue includes the sample of the acoustic environment obtained by the mobile device by storing acoustic input previously received by the mobile device and determined not to include a voice command, and the method comprises subtracting the sample of the acoustic environment from the acoustic input.
Claim 10	
10	The method of claim 1, wherein a sequence of performing the plurality of processing stages is determined, at least in part, by the at least one contextual cue.
Claim 11	
11	The method of claim 1, wherein the mobile device includes a primary processor and a secondary processor, and wherein at least one first processing stage of the plurality of processing stages is performed by the secondary processor prior to engaging the primary processor to process the acoustic input.
Claim 12	
12	The method of claim 11, wherein at least one second processing stage of the plurality of processing stages is performed by the primary processor only after the at least one first processing stage is performed and neither concludes that the acoustic input includes a voice command nor concludes that the acoustic input is the result of spurious acoustic activity.

Claim 13	
13	The method of claim 11, wherein performing the at least one first processing stage includes performing at least one voice activity detection processing stage including performing at least one of spectral analysis on the acoustic input to evaluate whether a spectrum of the acoustic input is indicative of voice activity, periodicity analysis to evaluate whether signal periodicity of the acoustic input is indicative of voice activity, and phone loop analysis to evaluate whether the acoustic input includes speech.
Claim 14	
14	The method of claim 11, wherein performing the at least one first processing stage comprises performing limited vocabulary automatic speech recognition on the acoustic input to detect whether the acoustic input includes an explicit voice trigger.
Claim 15	
15	The method of claim 11, wherein performing the at least one second processing stage comprises performing at least one speech processing stage including at least one of automatic speech recognition on the acoustic input and at least one natural language processing stage to understand the meaning of the voice command.
Claim 16	
16	The method of claim 1, wherein the mobile device is capable of connecting to at least one server via a network, and the method comprises transmitting at least a portion of the acoustic input to the at least one server via the network for processing by the at least one server.
Claim 17	
17	The method of claim 1, comprising performing one or more default actions when a specific task could not be ascertained from the acoustic input.

Claim 18	
18[pre]	A mobile device comprising:
18[a]	at least one processor configured to:
18[a(i)]	in response to the mobile device receiving acoustic input from the environment while operating in an idle mode, determine whether the received acoustic input includes a voice command by processing the received acoustic input,
18[a(ii)]	the processing employing at least one contextual cue, the at least one contextual cue comprising information other than content of the received acoustic input and comprising a time the acoustic input was received, motion of the mobile device, location of the mobile device, occurrence of an event on the mobile device, recent activity on the mobile device, a stored sample of the acoustic environment of the mobile device and/or a power source of the mobile device,
18[a(iii)]	the processing of the received acoustic input comprising a plurality of processing stages, at least one of the processing stages being performed while the mobile device is operating in the idle mode.

I. INTRODUCTION

Google LLC (“Google”), Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Samsung”) (collectively “Petitioners”) request *inter partes* review of Claims 1-18 of U.S. Patent No. 11,393,461 (“the ’461 Patent”).

II. GROUNDS FOR STANDING (37 C.F.R. § 42.104(A))

Petitioners certify that the ’461 Patent is available for *inter partes* review and that Petitioners are not barred or estopped from requesting *inter partes* review to challenge the claims on the grounds herein.

III. STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED

For purposes of this proceeding only, Petitioners apply the earliest alleged priority date of the ’461 Patent: March 12, 2013. Accordingly, pre-AIA 35 U.S.C. §102 applies. Petitioners respectfully request review and cancellation under 35 U.S.C. § 311 of Claims 1-18 (“Challenged Claims”) in view of:¹

Reference	Date(s)	Prior Art At Least Under
US9031847 (“Sarin”) (Ex-1005)	11/15/2011 (filed) 5/16/2013 (published)	§102(e)

¹ Petitioners do not concede that any Challenged Claims satisfy other requirements for patentability that cannot be raised in IPR.

Reference	Date(s)	Prior Art At Least Under
US20130110521 (“Hwang”) (Ex-1006)	5/30/2012 (filed) 5/2/2013 (published)	§102(e)
US7475012 (“Garner”) (Ex-1007)	1/6/2009 (issued)	§102(b)
US20120265528 (“Gruber”) (Ex-1007)	9/30/2011 (filed) 10/18/2012 (published)	§§102(a), (e)
US20120034904 (“LeBeau”) (Ex-1016)	08/6/2010 (filed) 02/09/2012 (published)	§§102(a), (b), (e)

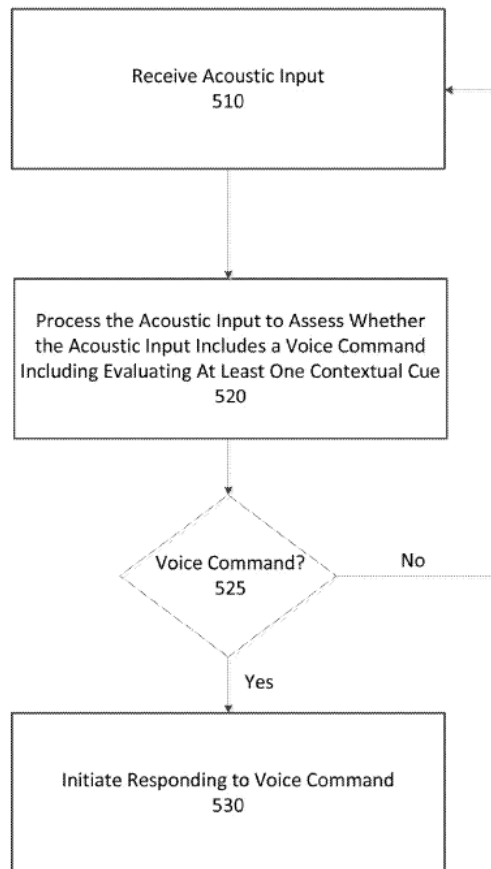
Petitioners request review and cancellation of the Challenged Claims as unpatentable based on the following grounds, supported by a declaration from Mr. Christopher Schmandt. Ex-1002 ¶¶1-38, 48-73; Ex-1003; Ex-1020.

Ground	Claims	Basis
1	1-4, 6, 7, 11, 14, 16, 18	§103: Sarin, Hwang
2	13	§103: Sarin, Hwang, Garner
3	3, 5, 7, 9, 10, 12, 15, 17	§103: Sarin, Hwang, Gruber
4	8	§103: Sarin, Hwang, Lebeau

IV. OVERVIEW OF THE '461 PATENT

A. Specification

The '461 Patent is generally directed to techniques used by mobile devices to detect voice commands in received audio in a way that minimizes the device's power consumption. Ex-1001, 6:17-20. To this end, the patent discloses “a hierarchical approach to monitoring and processing acoustic input that applies relatively low power processing to received acoustic information first and generally higher power processing as needed to evaluate the likelihood that the acoustic information includes a voice command.” *Id.*, 6:21-26.

**FIG. 5**

As shown in Figure 5, “contextual cues” are used to help the mobile device detect whether received acoustic input includes a voice command. *See id.*, 2:29-31, 20:35-44. Example contextual cues include “the time of day, the location of the mobile device, motion of the mobile device, recent activity on the mobile device, biometric information, status of the power source, information about the acoustic environment, etc.” *Id.*, 20:45-49; Ex-1002 ¶¶39-43.

B. Prosecution History

The '461 Patent was filed on March 12, 2013 as U.S. Application 13/795,933 (“the '933 App.”). The '933 App. remained pending for over nine years and the claims were rejected ten times. On October 30, 2015, the applicant amended the independent claims to replace “low power mode” with “idle mode,” and to recite that the at least one contextual cue is used “while the mobile device is operating in the idle mode.” Ex-1004, 478-482. On April 4, 2016, the applicant further amended the independent claims to recite specific types of contextual cues. *Id.*, 535-539.

On March 3, 2022, the applicant overcame a double patenting rejection by filing a terminal disclaimer over U.S. Patent No. 9,361,885, and canceled one of the independent claims to obviate a §101 rejection. *Id.*, 1457-1459. The Office subsequently issued a Notice of Allowance on March 16, 2022. *Id.*, 1463-1471. This Petition presents arguments not considered during prosecution. *See* Ex-1004; Ex-1002 ¶¶44-47.

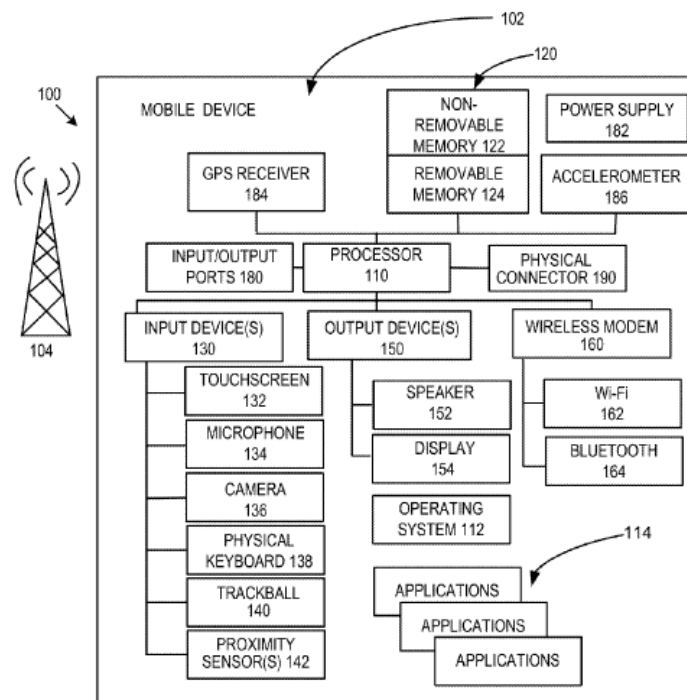
V. OVERVIEW OF THE PRIMARY PRIOR ART REFERENCES

The prior art references analyzed in the grounds below are analogous to the '461 Patent because they are within the same field of endeavor as the '461 Patent and reasonably pertinent to one or more problems addressed by the '461 Patent. Ex-1002 ¶74.

A. Sarin (Ex-1005)

Sarin discloses a mobile device capable of operating in a “low-power” state and an “active” state with a camera that captures images based on voice commands. Ex-1005, 1:43-44; Ex-1002 ¶¶75-82. Sarin’s mobile device receives and recognizes image capture-related voice commands while the device is operating in a low-power state. Ex-1005, 13:38-46; *see also id.*, 6:39-44 (“speech recognition also can be used for other applications and functionality such as voice calls ... and search functions (e.g., to perform searches”). According to Sarin, “in a low-power state, the display is typically dimmed or powered off, and other components (e.g., hardware buttons, keypads, trackballs) can be deactivated, as well.” *Id.*, 9:63-65. If the device determines that a received voice command matches an expected command associated with an image capture application, the device transitions from a low-power state to an active state. *Id.*, 13:53-57, 13:57-62. Once in the active state, the mobile device’s display is typically powered on, and the device’s operating system may be started to activate an image capture application to capture images. *Id.*, 9:46-49, 10:53-55, 13:62-14:6, Fig. 10.

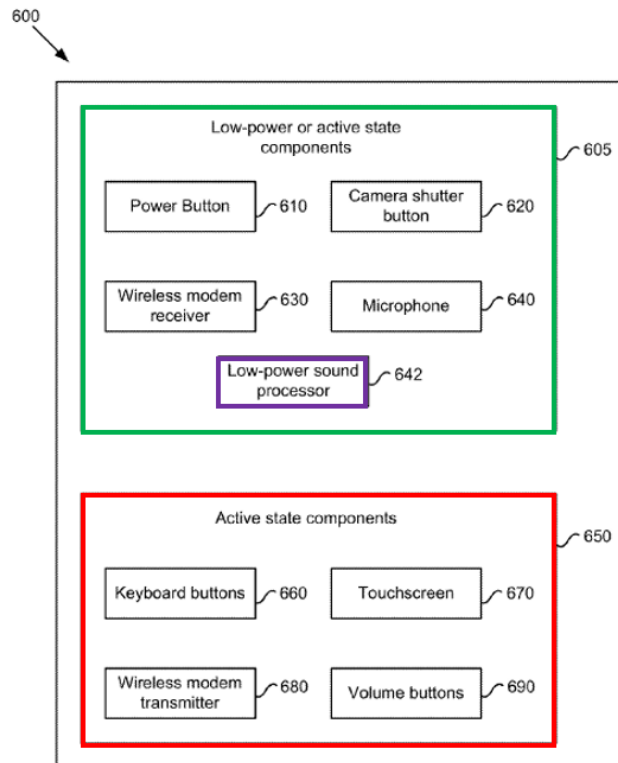
FIG. 1



As shown in Figure 1, Sarin's mobile device includes one or more primary processors 110, which perform "signal coding, data processing, input/output processing, power control, and/or other functions." Ex-1005, 4:15-20, 6:19-22. As shown below in Figure 6, to enable voice command recognition while in a low-power state, Sarin's mobile device utilizes low-power sound processor 642 (purple), which is functional when the mobile device is in the low-power state or active state (605, green). *Id.*, 11:10-15, 11:22-25.² Sarin's mobile device can also recognize voice commands when it is in an active state (650, red) (Ex-1005, 10:3-7, 10:22-26),

² All emphases/annotations/color are added unless noted otherwise.

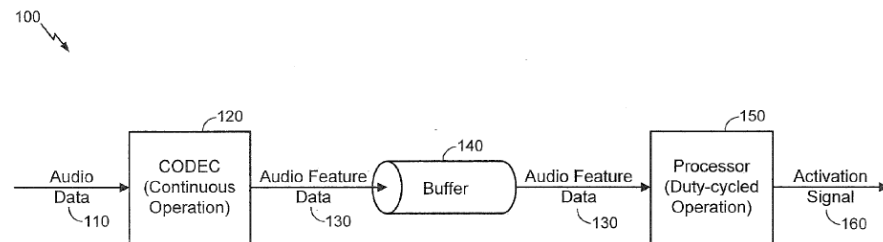
such that voice command recognition can be performed “at a remote server; on a general purpose processor, or on a dedicated special-purpose processor.” *Id.*, 13:6-8.

FIG. 6

To recognize image capture-related voice commands in a power efficient manner, Sarin, like the '461 Patent, uses contextual cues to disambiguate voice commands that are applicable to different functions which may be invoked with the same word or phrase. Ex-1005, 9:9-13, 11:32-34. Exemplary contextual cues include “which applications or functions are active on a device, time of day, and location.” *Id.*, 9:42-43.

B. Hwang (Ex-1006)

Hwang teaches techniques for processing audio in an electronic device (e.g., wireless telephone) with reduced power consumption. Ex-1006 ¶¶5, 26; Ex-1002 ¶¶83-90. Hwang discloses a low-power system for receiving audio, extracting and analyzing feature data from the received audio, and activating components of the device, such as the application processor, based on the analysis. Ex-1006 ¶¶5, 26. As shown in Hwang's Figure 1, CODEC 120 receives "raw" audio data and extracts audio features from the audio data to store in buffer 140, which is then analyzed by DSP 150. Ex-1006 ¶¶24, 26.

**FIG. 1**

As shown in Figure 2 below,³ DSP 230 includes sound recognition modules (241-245) that analyze the audio feature data extracted by CODEC 220. Ex-1006 ¶38. For example, continuous keyword detection module 243 may "detect the existence of pre-enrolled (e.g., predetermined) keyword sets" in a relatively low-

³ CODEC 220 and DSP 230 in Figure 2 correspond to CODEC 120 and DSP 150 shown in Figure 1. Ex-1005 ¶33.

power state and “activate predefined applications based on detected keywords.” *Id.*

¶41. Hwang also discloses that its DSP can perform the audio processing functions performed by its CODEC (e.g., audio feature extraction). *Id.* ¶52; Fig. 3.

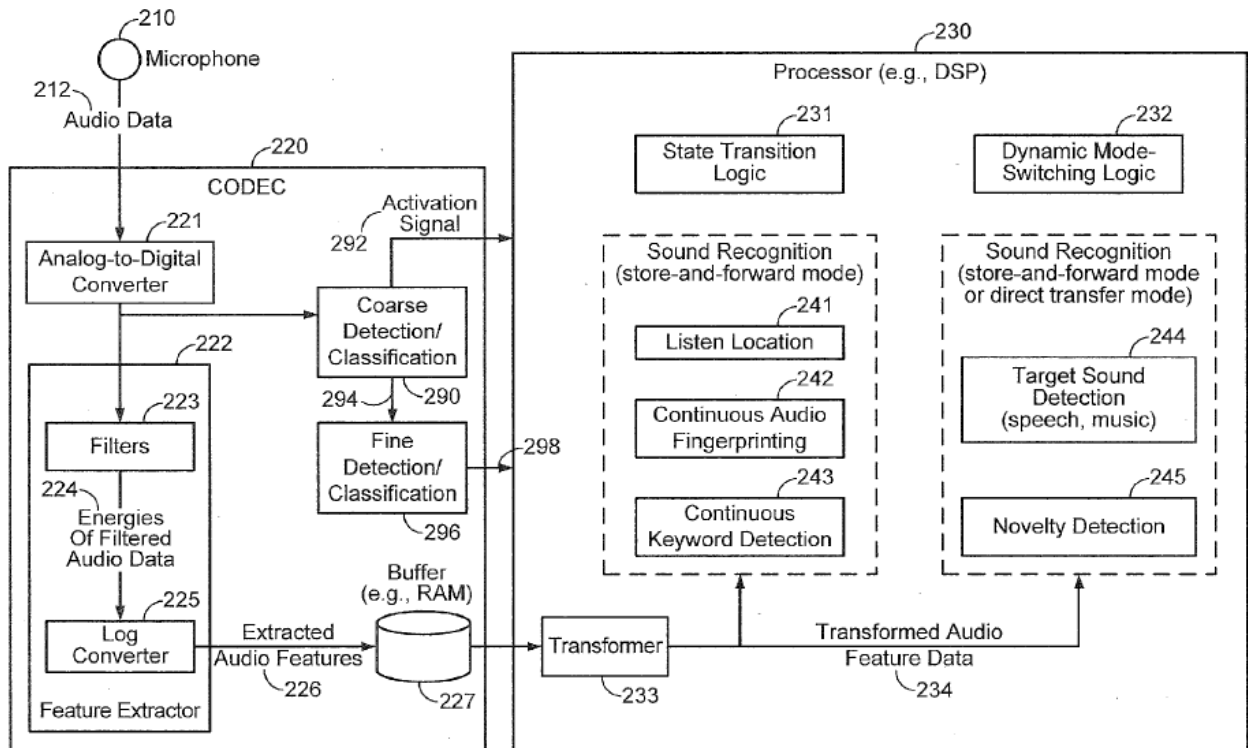


FIG. 2

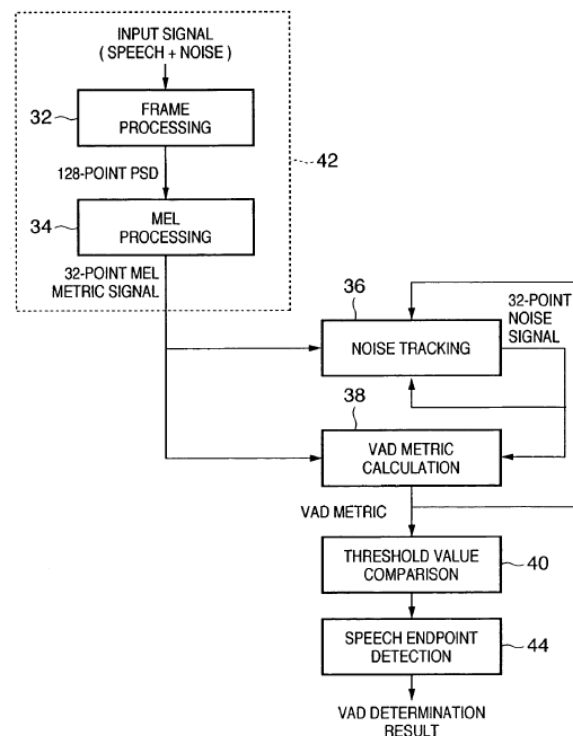
Based on its analysis, the DSP generates activation signal 160 to activate various components of the device, such as “an application processor and/or component(s) of a mobile station modem.” Ex-1006 ¶¶31, 44. For example, DSP 150 may generate the activation signal when “the analysis of the audio feature data 130 identifies a particular voice input command (e.g., ‘wake up’).” *Id.* ¶31. Hwang’s

DSP may also provide “higher-level applications” with the results of its sound recognition operations. *Id.* ¶45.

C. Garner (Ex-1007)

Garner teaches signal detection techniques designed to be robust against background noise for voice activity detection (VAD). Ex-1007, 2:65-67; Ex-1002 ¶¶91-94. As shown below in Figure 4, Garner divides an acoustic signal into frames, performs mel processing on the frames, and calculates a likelihood ratio that a frame is noise or voice. Ex-1007, 5:55-6:46. The likelihood ratio is compared with a predetermined threshold value to generate a value indicating speech or noise (i.e., VAD determination result). *Id.*, 11:24-26.

FIG. 4



D. Gruber (Ex-1008)

Gruber teaches a “virtual assistant” implemented on a smartphone (Ex-1008, ¶74), which uses “context information” to supplement natural language input (spoken and/or text) from a user. Ex-1008, Abstract, ¶11; Ex-1002 ¶¶95-99. The virtual assistant “interprets user inputs, operationalizes the user’s intent into tasks and parameters to those tasks, executes services to support those tasks, and produces output that is intelligible to the user.” Ex-1008 ¶11.

Gruber’s use of context information “helps to clarify the user’s intent and to reduce the number of candidate interpretations of the user’s input, ... reduc[ing] the need for the user to provide excessive clarification input.” *Id.* ¶13. Gruber discloses that “[c]ontext can include any available information that is usable by the assistant to supplement explicit user input to constrain an information-processing problem and/or to personalize results.” *Id.*; *see also id.* ¶178.

Examples of Gruber’s context information used in processing speech input include: applications currently in use on a device (Ex-1008 ¶180); information stored on a device (*id.* ¶193); a user’s dialog history with the virtual assistant (*id.* ¶203); sensor data that reports the user’s current location, the local time, the position, orientation, and motion of the device, and environmental data (*id.* ¶218); and events, such as incoming texts, emails, phone calls, and alerts (*id.* ¶238).

E. Lebeau (Ex-1016)

Lebeau teaches a mobile device that operates in two modes of operation. Ex-1016, Abstract; Ex-1002 ¶100. Lebeau determines to “switch” the device to receive voice input indicating a request to perform an operation. Ex-1016 ¶9. Lebeau’s device attempts to infer whether, based on the current context, monitoring for voice input would provide at least a threshold level of convenience for the user and, if so, monitors for voice input. Ex-1016 ¶23. Lebeau explains that a context includes whether the device’s battery is “running low on stored power (e.g., below 25% charge remaining in the battery)” (Ex-1016 ¶24) or the device is receiving power from a power cord. Ex-1016 ¶30.

VI. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSITA”) at the time of the alleged invention of the ’461 Patent, which for purposes of this proceeding is no earlier than March 12, 2013, would have possessed a Bachelor of Science (or equivalent) in electrical engineering or computer science, and two years of work experience in the field of speech and natural language interfaces for interacting with and directing computer systems and software, including speech recognition and processing. A greater amount of education could compensate for less work experience, and vice versa. Ex-1002 ¶¶32-33.

VII. CLAIM CONSTRUCTION

Petitioners are unaware of any “prior claim construction determination” related to the ’461 Patent. *See* 37 C.F.R. §42.100(b). Given the close correlation and substantial identity between the prior art references and the Challenged Claims, Petitioners believe that no express constructions of the claims are necessary to assess whether the prior art reads on the Challenged Claims. Thus, the claims should be given their plain and ordinary meaning.⁴ *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc); Ex-1002 ¶101.

VIII. DETAILED EXPLANATION OF GROUNDS

A. Ground 1: Sarin in Combination with Hwang Renders Obvious Claims 1-4, 6, 7, 11, 14, 16, and 18

1. Motivation to Combine Sarin and Hwang

A POSITA would have been motivated to combine Sarin and Hwang (“Sarin-Hwang”) in the manner discussed in the Grounds presented here, for the reasons discussed in this section, and for the additional reasons specifically discussed below. Ex-1002 ¶¶102-110.

A POSITA also would have been motivated to combine Sarin with Hwang because they are analogous art and teach improvements to the same type of devices.

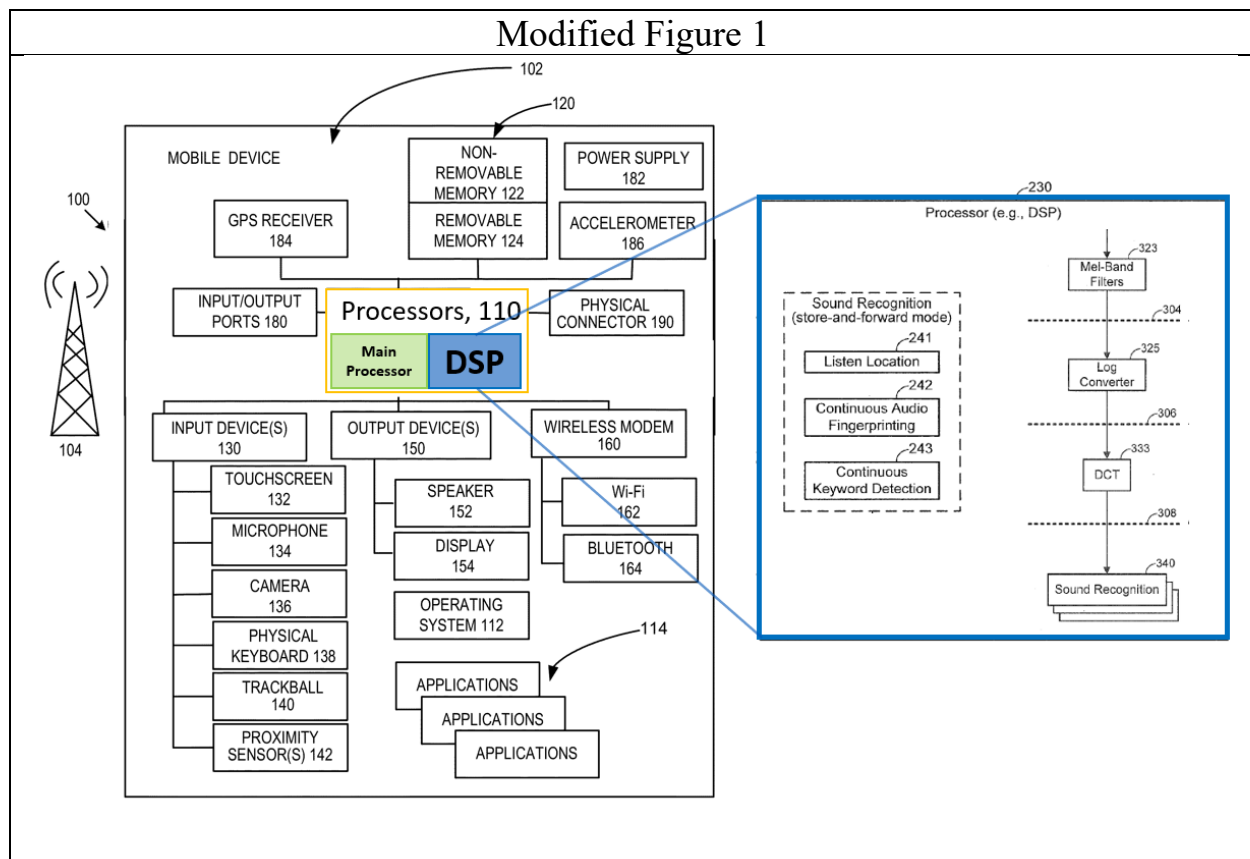
⁴ Petitioners reserve all rights to raise claim construction arguments and other arguments in any parallel or future litigation concerning the ’461 Patent. For example, comparing the claims to the accused products in the litigation may raise controversies that require construction of certain claim terms.

Sarin teaches a mobile device that uses contextual cues to assist in recognizing voice commands (such as image capture commands), which reduces power consumption and can extend battery life. Ex-1005, 11:32-34. Sarin also reduces power consumption through its use of a low-power sound processor. *Id.*, 10:65-11:1. Hwang similarly teaches techniques for processing audio in an electronic device (such as a wireless telephone) with reduced power consumption. Ex-1006 ¶¶5, 26. For example, Hwang's low-power system receives audio, extracts and analyzes feature data from the received audio, and activates components of the electronic device based on the analysis. Ex-1006 ¶5. Specifically, Hwang's feature extractor includes "a plurality of filters 223 that filter the audio data 212 to generate energies 224 (e.g., mel-band energies) of filtered audio data." Ex-1006 ¶35. Therefore, Sarin and Hwang both listen and perform sound recognition with a goal of reducing power consumption. Ex-1002 ¶¶103-105.

Hwang offers additional benefits to Sarin's mobile device. First, while Sarin's sound processor is functional when the mobile device is in a low-power state (Ex-1005, 11:9-19), where the display and other components are deactivated (*id.*, 9:62-65), Sarin leaves the implementation details of its low-power sound processor to a POSITA. A POSITA would have been motivated to look to references that include details for implementing a low-power sound processor that meets Sarin's goal of reducing power consumption, such as Hwang. Ex-1002 ¶105. To address this

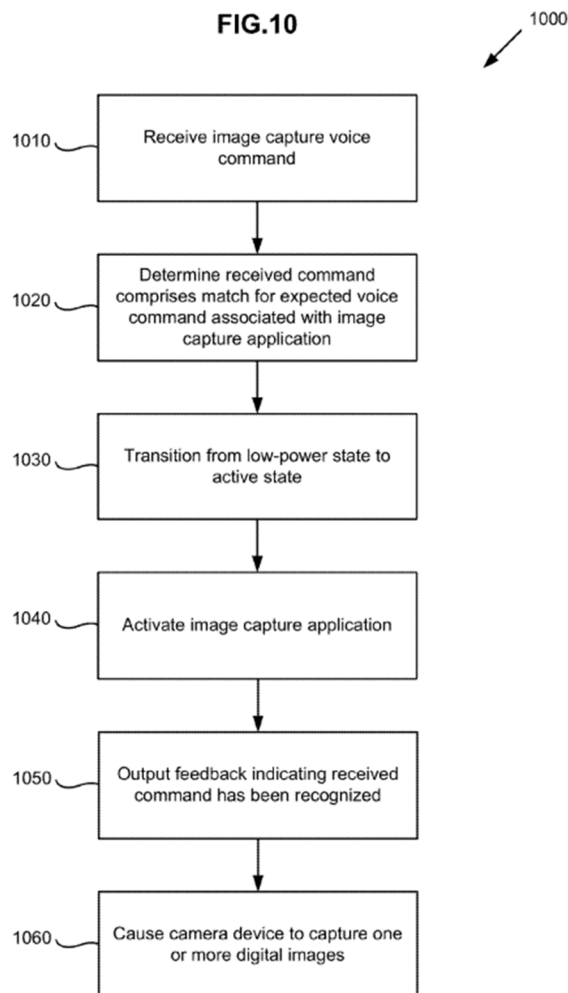
problem, Hwang detects voice commands in audio in a way that reduces power consumption (Ex-1006 ¶5) by using a DSP that receives and processes audio input while other mobile device components (such as an application processor) are not activated. *Id.* ¶26.⁵

A POSITA would have thus been motivated to implement Sarin's low-power sound processor using Hwang's DSP, as shown below in an example modified Figure 1 of Sarin (Ex-1002 ¶106):



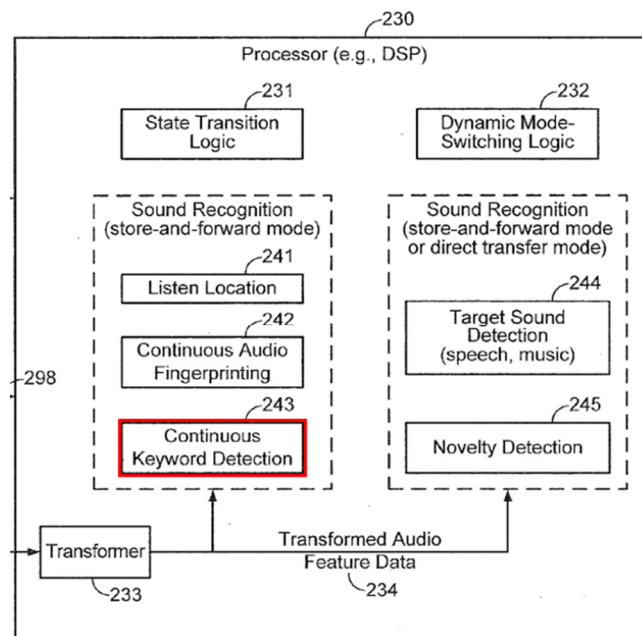
⁵ As discussed in §V.B, Hwang discloses that the audio processing functions of the CODEC and DSP can be consolidated in one DSP. Ex-1006 ¶52, Fig. 3.

A POSITA would have recognized that Hwang's DSP is compatible with and meets the functional requirements of Sarin's low-power sound processor. *Id.* ¶107. As shown in Figure 10, Sarin teaches a low-power state voice command recognition, focusing on voice commands associated with image capture:



A POSITA would have understood that Hwang's DSP is capable of receiving and recognizing the type of image capture-related commands that Sarin's low-power sound processor would need to recognize. Ex-1002 ¶108. For example, as highlighted below, Hwang's DSP includes a "continuous keyword detection

module,” which operates “in a relatively low-power state and may activate predefined applications” based on “predetermined keywords.” Ex-1006 ¶41. A POSITA would have recognized that Hwang’s detected “keyword sets” are similar to Sarin’s image capture-related voice commands and that Sarin’s image capture application is an example of a predefined application that Hwang’s DSP could activate after detecting image capture-related commands. Ex-1002 ¶108; Ex-1005, 13:62-63 (after transitioning to an active state, “the computing device activates the image capture application.”).



Ex-1006, Fig. 2 (excerpt)

Based on Hwang’s teachings, a POSITA would have been motivated to incorporate Hwang’s teachings regarding its DSP into Sarin’s mobile device because

Hwang furthers Sarin's goal of conserving power in a mobile device. Sarin recognizes that, aside from the display, *other components* may be deactivated in a low-power state, and that transitioning out of a low-power state may entail *starting the operating system*. A POSITA would have recognized that the operating system typically runs on the primary processors and, thus, Sarin teaches changing the power state and/or usage of the primary processor. For this additional reason, a POSITA would have been motivated to apply Hwang's teachings and perform low-power voice command detection while Sarin's main processor is deactivated. Ex-1002 ¶109. A POSITA would have recognized that receiving and processing audio using the DSP while the primary processor is inactive is desirable in a mobile device that runs on a battery, as maintaining the primary processor in a deactivated state until the processor is needed would tend to conserve power usage and extend the battery's life (a goal of Sarin). Ex-1005, 11:32-34; Ex-1002 ¶109.

Further, a POSITA would have had a reasonable expectation of success in combining Sarin and Hwang because a POSITA would have recognized that Hwang's DSP meets the functional requirements of Sarin's low-power sound processor and could be readily incorporated into Sarin's mobile device. Ex-1002 ¶110. A POSITA would have understood, therefore, that these references disclose interrelated teachings based on routine technologies that would have been amenable

to various well-understood and predictable combinations to provide quick and efficient speech recognition and processing. *Id.*

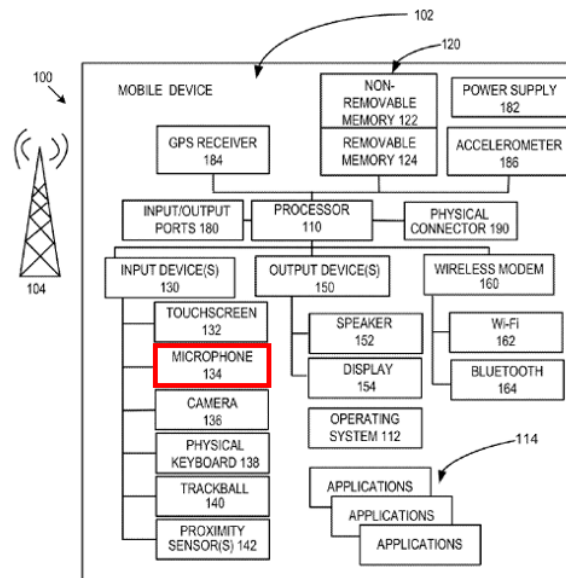
2. Independent Claim 1

a. 1[pre]: A method of monitoring an acoustic environment of a mobile device for voice commands when the mobile device is operating in a low power mode, the method comprising:

To the extent the preamble is limiting, Sarin teaches this element.⁶ Sarin teaches monitoring an acoustic environment of a mobile device for voice commands when the mobile device is in a low power mode. Ex-1002 ¶¶111-115. As shown in Figure 1 below, Sarin teaches a mobile device with microphone 134 (Ex-1005, 4:10-14, 4:50-54), which allows the user to speak a voice command that cause the mobile device to capture an image. Ex-1005, 7:49-52. Sarin's mobile device "*receives the image capture voice command while in a low-power state.*" *Id.*, 13:48-53; Ex-1002 ¶113.

⁶ Petitioner uses the term "teaches" as including both express teachings or those fairly suggested to a person of ordinary skill in the art. *In re Baird*, 16 F.3d 380, 383 (Fed. Cir. 1994); *In re Keller*, 642 F.2d 413, 425 (CCPA, 1981) ("The test for obviousness is ... what the combined teachings of the references would have suggested to those of ordinary skill in the art." (citations omitted)).

FIG. 1



A POSITA would have understood that Sarin’s mobile device’s “low-power state” is similar to the ’461 Patent’s “low power mode.” Ex-1002 ¶114. Sarin describes its “low-power state” as a state where “the display is typically dimmed or powered off, and other components (e.g., hardware buttons, keypads, trackballs) can be deactivated, as well.” Ex-1005, 9:62-65. Similarly, the ’461 Patent teaches that “[e]ntering a low power mode may include turning off the display, shutting down one or more processors (e.g., disabling the clock tree associated with one or more processors) and/or deactivating components that would otherwise draw power if left operational.” Ex-1001, 5:5-9; Ex-1002 ¶114.

Accordingly, Sarin teaches a mobile device that listens for voice commands (“a method of monitoring an acoustic environment of a mobile device for voice

commands”) while the mobile device is operating in a low-power state (“when the mobile device is in a low power mode”). Ex-1002 ¶115.

b. 1[a]: receiving acoustic input from the environment of the mobile device while the mobile device is operating in idle mode; and

Sarin-Hwang teaches this element. Sarin-Hwang’s mobile device receives acoustic input from its environment while operating in idle mode. Ex-1002 ¶¶116-121. As discussed in §VIII.A.1, Sarin-Hwang’s DSP is functional when the primary processor is not activated.⁷ Specifically, Hwang achieves reduced power consumption in a mobile device by incorporating a DSP, which receives and processes audio input while other mobile device components (such as an application processor) are not activated. Ex-1006 ¶26. Hwang’s DSP includes a “continuous keyword detection module,” which, “receive[s] sound input and may detect the existence of *pre-enrolled (e.g., predetermined) keyword sets. Continuous keyword detection may be performed in a relatively low-power state and may activate*

⁷ As explained in §VIII.A.2.a, Sarin’s mobile device receives acoustic input and interprets voice commands (such as commands relating to image capture), while operating in a low-power state in which “the display is typically dimmed or powered off, and other components (e.g., hardware buttons, keypads, trackballs) can be deactivated, as well.” Ex-1005, 9:63-65. Sarin also teaches that, when its mobile device recognizes a voice command, the device can “transition to an active state, start the operating system, display a GUI for the tool, and generate command events to cause one or more digital images to be captured by an image capture device.” *Id.*, 10:52-57. Thus, Sarin’s sound processor is functional when the mobile device is in a low-power state. *Id.*, 11:9-19; Ex-1002 ¶117 n.6.

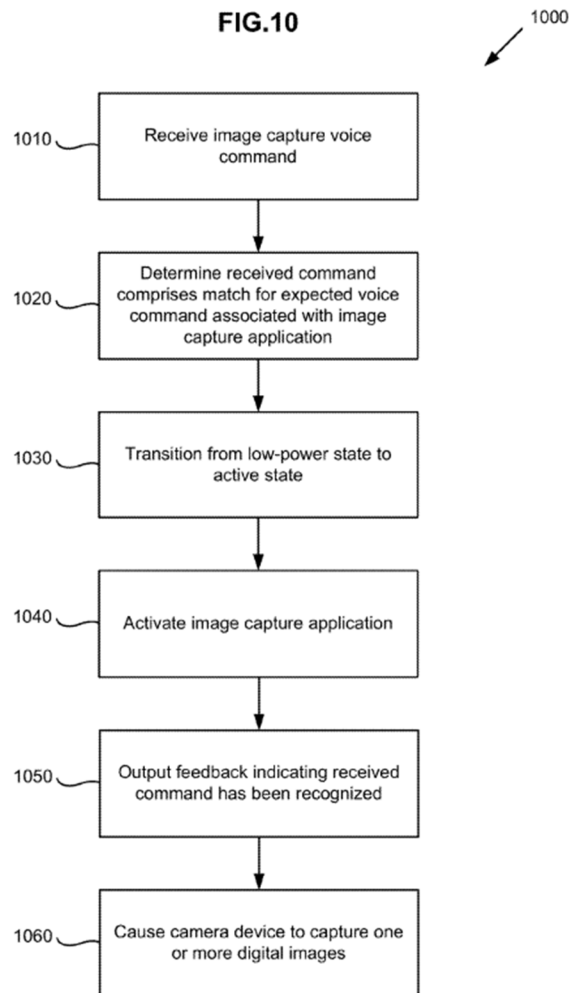
predefined applications based on detected keywords.” Ex-1006 ¶41. Hwang’s DSP further includes sound recognition modules that analyze audio feature data and, based on the analysis, “determine[s] whether to *activate an application processor* and/or component(s) of a mobile station modem.” Ex-1006 ¶44. In mobile devices, an “application processor” typically refers to the device’s primary (or main) processor. Ex-1002 ¶¶117 (discussing Exs-1009, 1010). Accordingly, a POSITA would have understood that Hwang teaches detecting voice commands while a mobile device’s primary processor is not activated to reduce power consumption and extend battery life. Ex-1002 ¶118.

When Sarin-Hwang’s primary processor is not activated, the mobile device consumes less power and is in an idle mode. The ’461 Patent states that, “when a mobile device enters a low power mode (*e.g., powers down into a sleep or idle mode*), *the primary processor may be powered down* to a desired extent.” Ex-1001, 26:46-48. Based on this disclosure, “idle mode,” as used in the ’461 Patent, encompasses using less power, including by powering down a primary processor. Ex-1002 ¶119-120.

Accordingly, Sarin-Hwang teaches a mobile device that receives audio (“receives acoustic input from the environment of the mobile device”) while consuming less power as the primary processor of the mobile device is not activated (“operating in an idle mode”). *Id.* ¶121.

c. 1[b]: in response to receiving the acoustic input, determining whether the received acoustic input includes a voice command by processing the received acoustic input,

Sarin-Hwang teaches this element. Sarin-Hwang teaches to determine whether the received acoustic input includes a voice command. Ex-1002 ¶¶122-125. As shown in Figure 10 below, Sarin “receives an image capture voice command” at step 1010, and in response, at step 1020, “determines that the received command comprises a match for an expected command associated with an image capture application.” Ex-1005, 13:47-55; Ex-1002 ¶123.



Sarin-Hwang’s mobile device “process[es] the received acoustic input.” Ex-1002 ¶124. For example, Hwang’s DSP includes a “continuous keyword detection module 243” that “may receive sound input and may detect the existence of pre-enrolled (e.g., predetermined) keyword sets.” Ex-1006 ¶41. As discussed in §VIII.A.1, a POSITA would have understood that Sarin’s image capture-related voice commands would be included among the “keyword sets” recognized by Hwang’s DSP. Ex-1002 ¶124. Detecting keywords in audio input by the continuous keyword detection module is consistent with the “processing” described in the ’461

Patent. *See, e.g.*, Ex-1001, 30:56-62 (“speech processing stages may include ASR ... acoustic input 705 may undergo limited vocabulary ASR to perform ***keyword spotting***”).

Accordingly, Sarin-Hwang’s mobile device recognizes predetermined keywords corresponding to image capture-related voice commands (“determining whether the received acoustic input includes a voice command”) in received audio input (“in response to receiving the acoustic input”), using a continuous keyword detection module (“by processing the received acoustic input”). Ex-1002 ¶125.

d. 1[c]: the processing employing at least one contextual cue, the at least one contextual cue comprising information other than content of the acoustic input and comprising a time the acoustic input was received, motion of the mobile device, location of the mobile device, occurrence of an event on the mobile device, recent activity on the mobile device, a stored sample of the acoustic environment of the mobile device and/or a power source of the mobile device,

Sarin-Hwang teaches this element. Sarin teaches several “contextual cue[s] comprising information other than content of the acoustic input” that may assist in recognizing voice commands. Ex-1002 ¶¶126-129. As explained in §VIII.A.2.b, Sarin-Hwang’s low-power DSP processes the acoustic input while the device is in an idle mode. Sarin further teaches that “voice-controlled applications” deployed on its mobile device “can use ***contextual cues*** to assist in recognizing commands and

using resources (e.g., battery life) efficiently.” Ex-1005, 11:32-34; *see also id.*, 9:9-12 (contextual cues used to disambiguate voice commands). For example, Sarin teaches contextual cues comprising: a “time the acoustic input was received” (Ex-1005, 11:42-46), “motion of the mobile device” (*id.*, 12:19-24 (a gyroscope or an accelerometer for additional contextual cues)), “location of the mobile device” (*id.*, 11:42-46), “occurrence of an event on the mobile device” (*id.*, 11:47-52 (if “a voice call is active on a smart phone” or “whenever the camera is not active”)), and “recent activity on the mobile device” (*id.*).

A POSITA would have understood that Sarin’s contextual cues are similar to the contextual cues described in the ’461 Patent, including information other than content of the acoustic input in the same way. *See also* Ex-1001, 21:29-33 (time of day), 21:5-10 (mobile device’s location in the home or office), 22:41-47 (response from an accelerometer); Ex-1002 ¶128.

Accordingly, Sarin-Hwang’s mobile device processes audio input using a contextual cue (“employing at least one contextual cue”) comprising a number of the specific contextual cues required by the claim. Moreover, as the claim is drafted, only one contextual clue is required, yet Sarin discloses several. Ex-1002 ¶129.

- e. 1[d]: the processing of the received acoustic input comprising a plurality of processing stages, at least one of the processing stages being performed while the mobile device is operating in the idle mode.**

Sarin-Hwang teaches this element. Sarin-Hwang teaches at least one processing stage being performed while the mobile device is in the idle mode. Ex-1002 ¶¶130-133. As shown in Figure 3, Sarin-Hwang's DSP "may perform feature extraction (e.g., via mel-band filters 323 and a log converter 325), data transformation (e.g., via a DCT transformer 333), and sound recognition (e.g., via sound recognition modules 340)." Ex-1006 ¶52. Each of these are "processing stages" because they are stages used in processing the received acoustic input to extract identifiable features. Ex-1002 ¶131.

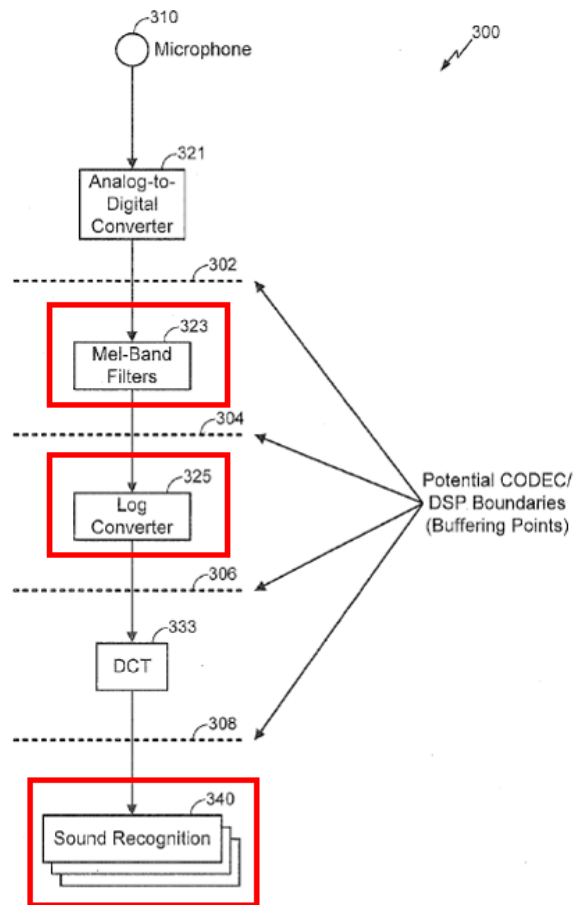


FIG. 3

At least one of the above processing stages is performed when the mobile device is operating in idle mode. Ex-1002 ¶132. As discussed in § VIII.A.2.b, Sarin-Hwang's DSP receives and processes audio while the mobile device's primary processor is not activated and the device is in an idle mode as it consumes less power. Specifically, both feature extraction and sound recognition are processing stages performed prior to the DSP activating the mobile device's primary processor. Ex-1006 ¶¶44 ("processor 230 may analyze the transformed audio feature data 234....,

and may determine whether to activate an application processor”), 53-55 (“Data transformation and sound recognition may be performed by the DSP.”).

Accordingly, Sarin-Hwang’s mobile device extracts audio features from audio input and performs keyword detection on the extracted audio features (“processing of the received acoustic input comprising a plurality of processing stages”) while the device’s primary processor is not activated and consuming less power (“at least one of the processing stages being performed while the mobile device is operating in the idle mode”). Ex-1002 ¶133.

3. Dependent Claims 2-4, 6, 7, 11, 14, and 16

a. **Claim 2: The method of claim 1, further comprising transitioning the mobile device from the idle mode to an active mode in response to detecting that the acoustic input includes a voice command.**

Sarin-Hwang teaches this claim. Sarin-Hwang transitions the mobile device from idle to an active mode in response to a detected voice command. Ex-1002 ¶¶134-136. Specifically, Hwang’s DSP analyzes audio feature data 130 and generates “activation signal 160 to activate various components of an electronic device” when the audio feature data 130 “identifies a particular *voice input command* (e.g., ‘*wake up*’).” Ex-1006 ¶31; *see also id.* ¶¶41 (continuous keyword detection module enabling “voice-activation commands without the use of a dedicated voice command button or non-verbal user input.”), 44 (DSP “may analyze

the transformed audio feature data ... via one or more of the sound recognition modules 241-245, and *may determine whether to activate an application processor*”).

Accordingly, Sarin-Hwang’s mobile device activates its primary processor (“transitions the mobile device from the idle mode to an active mode”) when it recognizes a “wake up” voice command (“in response to detecting that the acoustic input includes a voice command”). Ex-1002 ¶136.

b. Claim 3: The method of claim 1, wherein the at least one contextual cue includes the time the acoustic input was received, and the method comprises influencing evaluation of at least one of the plurality of processing stages based on the time the acoustic input was received.

Sarin-Hwang teaches this claim. Sarin’s contextual cues include the time the acoustic input was received and that time influences the evaluation of a processing stage. Ex-1002 ¶¶137-139. First, Sarin teaches that “voice-controlled applications” deployed on its mobile device “can use *contextual cues* to assist in recognizing commands and using resources (e.g., battery life) efficiently.” Ex-1005, 11:32-34. Second, Sarin teaches different “contextual cues” that may assist in recognizing voice commands corresponding to image capture functionality, such as the time the acoustic input was received. *Id.*, 11:42-46 (“Other contextual clues include ... time of day.”). A POSITA would have understood that Sarin’s consideration of the “time

of day,” is a contextual cue that influences the processing stage when used to recognize voice commands corresponding to image capture functionality. Ex-1002 ¶138. For example, Sarin explains that the “time of day” cue can be used to influence the evaluation of the processing stage by, for example, turning off image capture-related voice recognition. Ex-1005, 11:44-46 (“if the time of day and location indicate that the user is at work, voice recognition relating to image capture operations can be turned off.”).

Accordingly, Sarin-Hwang’s mobile device uses time of day (“contextual cue includes the time the acoustic input was received”) to recognize voice commands corresponding to image capture functionality (“influencing evaluation ... based on the time the acoustic input was received.”). Ex-1002 ¶139.

c. Claim 4: The method of claim 1, wherein the at least one contextual cue includes recent activity on the mobile device, the method further comprising evaluation of at least one of the plurality of processing stages based on at least one of how recently the user activated the mobile device, how recently the user issued a voice command and how recently the user performed at least one action on the mobile device.

Sarin-Hwang teaches this claim. Sarin teaches that the contextual cues include recent activity on the mobile device. Ex-1002 ¶¶140-144. As explained in §VIII.A.2.d, Sarin teaches using contextual cues to assist in recognizing voice commands. Ex-1005, 11:32-34. Sarin’s contextual cues include “which applications

or functions are active on a device.” Ex-1005, 11:42-43. Sarin thus teaches a contextual cue of the recent activity on the mobile device. Ex-1002 ¶141; Ex-1001, 23:67-24:5 (“if a user opens a text or email ... [o]pening a calendar or scheduling application”).

Sarin teaches to base the evaluation on how recently the user performed at least one action on the mobile device. Sarin provides that if a “voice call is active on a smart phone, voice recognition relating to image capture operations can be turned off” to avoid “unintended camera operation.” Ex-1005, 11:47-53. Sarin’s consideration of whether a “voice call is active” is a contextual cue that influences the processing stage when used to recognize voice commands corresponding to image capture functionality. Ex-1002 ¶142. In particular, Sarin’s system considers whether a voice call is currently active to influence the evaluation of the processing stage by, for example, turning off the processing of image capture-related voice commands, until the call is finished. *Id.* A POSITA would have understood that the recently performed action of an active voice call is an example of considering “how recently the user performed at least one action on the mobile device.” *Id.* ¶¶142-143 (citing Ex-1014). Indeed, a user engaging in a currently active voice call is as recent as a user action can be.

Accordingly, Sarin-Hwang’s mobile device considers whether a voice call is currently active (“contextual cue includes recent activity on the mobile device”) to

turn off the processing of image capture-related voice commands until the call is finished (“evaluation of ... how recently the user performed at least one action on the mobile device”). *Id.* ¶144.

d. Claim 6: The method of claim 1, wherein the at least one contextual cue includes motion of the mobile device received as an input from an accelerometer of the mobile device, the method comprises influencing evaluation of at least one of the plurality of processing stages based on an assessment of whether the user moved the mobile device proximate in time with receiving the acoustic input based, at least in part, on the input from the accelerometer.

Sarin-Hwang teaches this claim. Sarin’s contextual cues include the mobile device’s motion received as an input from the mobile device’s accelerometer. Ex-1002 ¶¶145-152. Sarin provides an example of the mobile device using an accelerometer and/or gyroscope to detect “the orientation of the device as being ready perform an operation such as capturing an image or recording video.” Ex-1005, 12:19-24. A POSITA would have understood that Sarin thus teaches that the contextual cue includes “motion of the mobile device received as an input from an accelerometer” because Sarin receives input from other device components, such as accelerometers, which sense motion. Ex-1002 ¶146.

Sarin teaches that the processing stage is influenced by the accelerometer in assessing whether the user moved the mobile device (e.g., into a specific orientation)

proximate in time with receiving the acoustic input. Sarin's accelerometer and gyroscope detect the "orientation of the device," which is then used to determine that the device is "ready [to] perform an operation such as capturing an image or recording video." Ex-1005, 12:19-24. A POSITA would have understood that the device is "ready" to take a picture near in time to the end of the motion because a movement would have brought the device into the specific orientation. Ex-1002 ¶¶147-148 (citing Ex-1017 ¶¶22, 31). A POSITA would have thus understood that moving the device into a particular orientation results in motion that would influence the evaluation of the processing stage by ensuring that the device is "ready" to capture the picture near in time to when the motion ends, the device is oriented correctly, and the user issues the command to capture an image. Ex-1002 ¶¶148-151.

Accordingly, Sarin-Hwang's mobile device uses motion information from an accelerometer to determine the device's orientation ("contextual cue includes motion of the mobile device received as an input from an accelerometer") to determine whether the device is "ready" to take a picture near in time to the end of the motion because a movement would have brought the device into the specific orientation ("influencing evaluation ... based on an assessment of whether the user moved the mobile device proximate in time with receiving the acoustic input based... on the input from the accelerometer"). Ex-1002 ¶152.

- e. Claim 7: The method of claim 1, wherein the at least one contextual cue includes the location of the mobile device, and the method comprises influencing evaluation of at least one of the plurality of processing stages based on determining whether the mobile device is located in at least one of a vehicle, a home or a place of work of the user of the mobile device.**

Sarin-Hwang teaches this claim. Sarin teaches that the user's work location is a contextual cue that influences the processing stage. Ex-1002 ¶¶153-155. Sarin teaches different "contextual cues" that may assist in recognizing voice commands corresponding to image capture functionality, such as when the "location indicate[s] that the user is at *work*." Ex-1005, 11:42-46. This "work" location is a cue used to influence the evaluation of the processing stage by, for example, turning off image capture-related voice recognition. *Id.* ("image capture operations can be turned off.").

- f. Claim 11: The method of claim 1, wherein the mobile device includes a primary processor and a secondary processor, and wherein at least one first processing stage of the plurality of processing stages is performed by the secondary processor prior to engaging the primary processor to process the acoustic input.**

Sarin-Hwang teaches this claim. Sarin teaches that its mobile device includes a primary processor. Ex-1002 ¶¶156-160. Sarin's mobile device includes "controller

or processor 110” for “signal coding, data processing, input/output processing, power control, and/or other functions.” Ex-1005, 4:15-20.

Sarin-Hwang teaches that the mobile device has a secondary processor. Ex-1002 ¶158. Sarin teaches that its mobile device may have more than one main processor. Ex-1005, 6:19-22. Moreover, as discussed in §VIII.A.1, Hwang teaches a device that includes a DSP, which processes and extracts features from audio input. *See, e.g.*, Ex-1006 ¶52. A POSITA would have understood that Hwang’s DSP is a distinct processor from the first processor because Hwang describes that the DSP may determine whether to activate a different application processor. Ex-1006 ¶44; Ex-1002 ¶158.

Sarin-Hwang’s secondary processor performs a first processing stage before engaging the primary processor to process the acoustic input. Sarin teaches to perform speech recognition to listen for and interpret voice input, on the local device. Ex-1005, 6:29-49, 13:15-20. Moreover, Sarin-Hwang’s DSP performs feature extraction, data transformation, and sound recognition *before* engaging a primary processor to further process audio. For example, the DSP “may analyze ... transformed audio feature data 234 via one or more of the sound recognition modules 241-245, and *may determine whether to activate an application processor ... based on the analysis.*” Ex-1006 ¶44. Because the DSP analyzes with sound recognition

modules before activating the application processor, the application processor is not engaged to process the acoustic input. Ex-1002 ¶159.

Accordingly, Sarin-Hwang's mobile device includes audio feature extraction, data transformation, and sound recognition ("at least one first processing stage of the plurality of processing stages") performed by a DSP ("performed by the secondary processor") and, based on the results of the sound recognition, may activate an application processor ("prior to engaging the primary processor to process the acoustic input"). Ex-1002 ¶160.

g. Claim 14: The method of claim 11, wherein performing the at least one first processing stage comprises performing limited vocabulary automatic speech recognition on the acoustic input to detect whether the acoustic input includes an explicit voice trigger

Sarin-Hwang teaches this claim. Sarin-Hwang teaches performing a limited vocabulary automatic speech recognition, as part of the first processing stage. Ex-1002 ¶¶161-164. As explained in §VIII.A.3.f (Claim 11), the first processing stage is performed by Sarin-Hwang's DSP. Sarin-Hwang's DSP includes a "continuous keyword detection module 243," which "receive[s] sound input and may detect the existence of pre-enrolled (e.g., predetermined) keyword sets." Ex-1006 ¶41. Sarin-Hwang's continuous keyword detection using "pre-enrolled (e.g., predetermined) keyword sets," is the claimed "limited vocabulary automatic speech recognition"

because it is a restricted set of predefined words, just like the '461 Patent. Ex-1001, 18:14-16 (“using a vocabulary restricted to the words in the explicit voice trigger phrase (which may include as few as a single word)”).

Sarin-Hwang teaches using limited vocabulary automatic speech recognition to detect whether the acoustic input includes an explicit voice trigger. For example, a keyword set recognized by the DSP may include a specific voice trigger such as “wake up,” which may cause the DSP to “generate [an] activation signal ... to activate various components of an electronic device.” Ex-1006 ¶31.

Accordingly, Sarin-Hwang’s mobile device includes a DSP with a continuous keyword detection module (“performing limited vocabulary automatic speech recognition on the acoustic input”) that recognizes keyword sets, such as “wake up” (“to detect whether the acoustic input includes an explicit voice trigger”). Ex-1002 ¶164.

h. Claim 16: The method of claim 1, wherein the mobile device is capable of connecting to at least one server via a network, and the method comprises transmitting at least a portion of the acoustic input to the at least one server via the network for processing by the at least one server.

Sarin-Hwang teaches this claim. Sarin-Hwang teaches that the mobile device connects to a server via a network. Ex-1002 ¶¶165-168. For example, Sarin teaches that the mobile device has a “wireless modem” which is coupled to an antenna and

supports “*two-way communications between the processor 110 and external devices.*” Ex-1005, 4:60-63. The wireless modem may be “a cellular modem for communicating with [a] *mobile communication network.*” Ex-1005, 4:63-65. Sarin also teaches that the mobile device’s speech recognition components can also be “implemented in whole or in part *on remote servers.*” *Id.*, 6:15-18.

Sarin-Hwang teaches transmitting a portion of the acoustic input for the server to process. For example, in performing voice command recognition for image-capture functionality, the mobile device or remote server (Ex-1005, 13:4-8) “compares ... received audio input with an expected audio command (e.g., a word or phrase) associated with an image capture operation.” *Id.*, 12:32-35. Sarin teaches that the decision “on where to perform speech recognition tasks can be based on,” among other things, “resources available at local devices and remote servers (e.g., processing power, memory or storage capacity).” *Id.*, 13:8-12. Thus, for recognizing more general voice commands, e.g. beyond those directed to image capture, a POSITA would have been motivated to transmit audio that includes such general voice commands to a remote server with sufficient processing power to process those commands. Ex-1002 ¶167; Ex-1005, 6:44-49 (“generalized voice input modes”).

Accordingly, Sarin-Hwang’s mobile device “is capable of connecting to at least one server via a network” because it has a wireless cellular modem to transmit received audio input over a network to a remote server for speech recognition

(“transmitting at least a portion of the acoustic input to the at least one server via the network for processing by the at least one server”). Ex-1002 ¶168.

4. Independent Claim 18

a. 18[pre]: A mobile device comprising:

Sarin teaches this element for the reasons discussed in §VIII.A.2.a. Ex-1002 ¶169.

b. 18[a]: at least one processor configured to:

Sarin-Hwang teaches this element for the reasons discussed in §VIII.A.2.b. Ex-1002 ¶170. In particular, as discussed in §VIII.A.1, Sarin-Hwang’s mobile device includes a low power DSP and an application processor. While Claim 18 does not recite the specific processor employing the following processing steps, Sarin-Hwang’s low-power DSP (identified as the “processor” for Claim 1) is being applied as Claim 18’s “at least one processor” in substantially the same way it is applied with respect to Claim 1.

(i) Elements 18[a(i)]-18[a(iii)]

Sarin-Hwang teaches Elements 18[a(i)]-18[a(iii)] for the reasons discussed in §§VIII.A.2.c-VIII.A.2.e, according to the table below. Ex-1002 ¶¶171-173.

Element	Section
18[a(i)]	VIII.A.2.c.
18[a(ii)]	VIII.A.2.d.

18[a(iii)]	VIII.A.2.e.
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B. Ground 2: Sarin in Combination with Hwang and Garner Renders Obvious Claim 13

1. Motivation to Combine Garner with Sarin-Hwang

A POSITA would have been motivated to combine the teachings of Sarin, Hwang, and Garner (“Sarin-Hwang-Garner”) and would have had a reasonable expectation of success in doing so because each relates to the same well-known technologies, such that they are analogous art and teach improvements to the same type of devices. Ex-1002 ¶¶174-178. Each teach using speech processing. Ex-1005, 6:29-49, 13:15-20; Ex-1006 ¶¶52 (“feature extraction..., data transformation..., and sound recognition”), 41 (“continuous key word detection”); Ex-1007, 1:45-51.

Garner teaches that voice activity detection (“VAD”) prevents a speech recognition process in an ASR unit “from recognizing background noise as speech” (Ex-1007, 1:45-47), which “prevent[s] an error of converting noise into a word.” *Id.*, 1:47-49. VAD “more skillfully manage[s] the throughput of the entire [automatic speech recognition] system ... that utilizes many computer resources.” *Id.*, 1:49-51. Thus, a POSITA would have understood that Garner’s VAD allows for more efficient use of device resources because it allows the device “to concentrate on other functions while speech recognition is not in progress and concentrate on ASR while the user utters.” *Id.*, 1:56-58; Ex-1002 ¶176. Indeed, a POSITA would have

understood that incorporating Garner's VAD as a lead-in to Sarin-Hwang's continuous keyword detection would have furthered Sarin-Hwang's goal of conserving device power by allowing keyword detection to focus on speech instead of noise. Ex-1002 ¶176.

A POSITA would have understood that Garner's VAD is compatible with, and could successfully be implemented on, Hwang's DSP. *Id.* ¶¶177-178. In particular, Hwang's feature extractor includes a plurality of mel-band filters that generate mel-band energies from input audio data, which, similar to Garner, is divided into frames. Ex-1006 ¶¶35-36. A POSITA would have understood that the mel-band energies produced in Hwang are comparable to the mel metric signals produced in Garner. Ex-1002 ¶178.

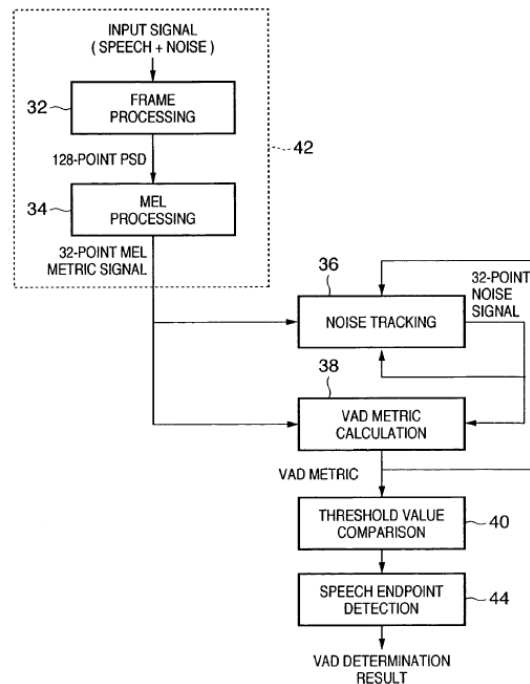
2. Dependent Claim 13

- a. Claim 13: The method of claim 11, wherein performing the at least one first processing stage includes performing at least one voice activity detection processing stage including performing at least one of spectral analysis on the acoustic input to evaluate whether a spectrum of the acoustic input is indicative of voice activity, periodicity analysis to evaluate whether signal periodicity of the acoustic input is indicative of voice activity, and phone loop analysis to evaluate whether the acoustic input includes speech.**

Sarin-Hwang-Garner teaches this claim. Sarin-Hwang-Garner teaches that its first processing stage includes performing voice activity detection including spectral

analysis on the acoustic input to evaluate whether the acoustic input is indicative of voice activity. Ex-1002 ¶¶179-193. As explained in §VIII.A.2.e (Element 1[d]), Sarin-Hwang's DSP "may perform feature extraction (e.g., via mel-band filters 323 and a log converter 325), data transformation (e.g., via a DCT transformer 333), and sound recognition (e.g., via sound recognition modules 340)." Ex-1006 ¶52. Moreover, Hwang's "target sound detection module 244" "detect[s] speech." Ex-1006 ¶42.

A POSITA would have understood that the detection of speech in input audio may be an example of VAD, as taught by Garner. Ex-1002 ¶180. As shown in Figure 4 below, Garner teaches a "voice activity detection processing stage" through its signal detection technique that uses VAD to determine whether a signal includes speech. *Id.*

FIG. 4

As shown in Figure 4, Garner processes an acoustic input into frames before mel processing module 34 generates mel metric signals, which are further processed to generate a “VAD metric.” Ex-1007, 5:55-56, 6:3-12, 6:25-26. The VAD metric indicates the likelihood that an acoustic frame is speech as opposed to noise. *Id.*, 6:31-46. In describing the VAD metric, Garner teaches that the speech variance calculation in a given audio frame uses a “spectral subtraction method.” Ex-1007, 6:60-67. Garner also discloses using “spectral magnitude” or “spectral power” in computing an estimate of speech variance in the frame. *Id.*, 6:57-60. Garner’s VAD technique thus is spectral analysis for evaluating whether the spectrum of the acoustic input is indicative of voice activity. Ex-1002 ¶¶181-183.

As discussed in §VIII.B.1, a POSITA would have been motivated to incorporate Garner’s VAD technique as a precursor to Sarin-Hwang’s keyword detection in order to conserve device power. Ex-1002 ¶¶184-192. As such, Garner’s VAD processing stage runs on Sarin-Hwang’s DSP (i.e., the “secondary processor”) and is therefore a “first processing stage.” *See* §VIII.A.3.f (Claim 11).

Accordingly, Sarin-Hwang-Garner’s mobile device includes a DSP that performs VAD to determine that audio input more likely comprises speech rather than noise before performing keyword detection on the audio input (“performing...voice activity detection processing stage”) that uses spectral subtraction, spectral magnitude, and spectral power (“performing spectral analysis on the acoustic input) to compute a likelihood that indicates whether audio input includes speech (“to evaluate whether a spectrum of the acoustic input is indicative of voice activity”). Ex-1002 ¶193.

C. Ground 3: Sarin in Combination With Hwang and Gruber Renders Obvious Claims 3, 5, 7, 9, 10, 12, 15, and 17

1. Motivation to Combine Gruber With Sarin and Hwang

A POSITA would have found it obvious to combine Gruber with Sarin and Hwang (“Sarin-Hwang-Gruber”) and would have had a reasonable expectation of success in doing so because each relates to the same well-known technologies such that they are analogous art and teach improvements to the same type of devices. Ex-

1002 ¶¶194-199. Each teach using speech processing to determine a voice command. Ex-1005, 6:29-49, 13:15-20; Ex-1006 ¶¶52, 41; Ex-1008 ¶11 (“interprets user inputs, operationalizes the user’s intent into tasks and parameters to those tasks”). Relatedly, Sarin and Gruber both teach using contextual cues. Ex-1005, 11:37-41; Ex-1008 ¶¶131, 354.

Gruber offers additional benefits to Sarin-Hwang’s mobile device, such as employing contextual cues when a general voice command is ambiguous. Ex-1002 ¶¶196-197. Particularly, Gruber receives user input, such as spoken language, processes the input, and generates output to the user and/or performs actions on behalf of the user. Ex-1008 ¶178. Gruber’s processing includes “speech recognition, natural language processing, task flow processing, and dialog generation.” *Id.* ¶14. Like Sarin, Gruber recognizes that contextual cues are advantageous because they assist in disambiguating voice commands. *Compare* Ex-1005, 9:9-12 (“desired functionality ... based on contextual cues”) *with* Ex-1008 ¶15 (“use context when ... disambiguating among competing interpretations”). Gruber additionally teaches “prompt[ing] the user for confirmation and/or request additional context information from any suitable source before calling a service ... to perform a function.” Ex-1008 ¶88. Additionally, like Sarin, Gruber considers “the acoustic environments in which the speech is entered.” Ex-1008 ¶250. Gruber stores “noise profiles” of the user’s

location since “noise profiles of a quiet office are different from those of automobiles or public places.” *Id.*

Gruber, therefore, addresses a stated goal of Sarin (disambiguation), and does so for voice commands beyond image capture functionality. Ex-1002 ¶¶197-198. A POSITA would have understood that implementing Gruber’s teachings on Sarin’s mobile device would result in a device that is better equipped to disambiguate and recognize general voice commands by “reduc[ing] the need for the user to provide excessive clarification input.” Ex-1008, Abstract; Ex-1002 ¶198.

A POSITA would also have understood that Gruber’s teachings are compatible with, and can be implemented on Sarin-Hwang’s combined system. *Id.* ¶199. Gruber explains that its software can be implemented on “CPU 62,” which may include one or more processors, such as microprocessor(s). Ex-1008 ¶77; *see also id.* ¶¶75-76, Fig. 28. A POSITA would have understood that Sarin-Hwang’s application processor is similar to the processor disclosed in Gruber, and, therefore, a POSITA would have understood that Sarin-Hwang would have had a reasonable expectation of success of implementing Gruber’s teachings. Ex-1002 ¶199.

2. Dependent Claims 3, 5, 7, 9, 10, 12, 15, and 17

a. Claim 3

Sarin-Hwang-Gruber teaches this claim. Sarin-Hwang-Gruber teaches that the contextual cue includes the time the acoustic input was received and that time

influences the evaluation of a processing stage. Ex-1002 ¶¶200-205. As explained above in §VIII.A.3.b (Claim 3), Sarin’s consideration of the “time of day,” is a contextual cue that influences the processing stage when used to recognize image-capture related voice commands.

Further, a POSITA would have been motivated to apply Gruber’s teachings to Sarin-Hwang to recognize more general voice commands based on the time acoustic input was received in order to disambiguate those commands. Ex-1002 ¶202. For example, Gruber teaches that “[t]ime information from clocks on client devices” can be used as contextual information for interpreting phrases within voice commands. Ex-1008 ¶132. Phrases such as “in an hour” and “tonight,” may be spoken in the context of user requests, and for which time information can be used to ascertain the meaning of the request. *Id.*; Ex-1002 ¶202.

Additionally, a POSITA would have understood, or at least found it obvious, that in a conversational system such as the virtual assistant implemented in Sarin-Hwang-Gruber’s mobile device (*see* Ex-1008 ¶17), which a user interacts with in real time, that phrases such as “in an hour” or “tonight” appearing in voice commands would be interpreted based on the time the voice command was received by the device. Ex-1002 ¶¶203-204.

Accordingly, Sarin-Hwang-Gruber’s mobile device includes a conversational virtual assistant that uses time (“contextual cue includes the time the acoustic input

was received”) to interpret certain phrases within received voice commands (“influencing evaluation...based on the time the acoustic input was received.”). *Id.* ¶205.

b. Claim 5: The method of claim 1, wherein the at least one contextual cue includes an occurrence of an event on the mobile device, and the method comprises influencing evaluation of at least one of the plurality of processing stages based on whether the acoustic input is received proximate in time with the occurrence of the event.

Sarin-Hwang-Gruber teaches this claim. Ex-1002 ¶¶206-217. As explained above in §VIII.A.2.d, Sarin teaches that an occurrence of an event on the mobile device is a contextual cue. *See, e.g.*, Ex-1005, 11:47-52 (“if a voice call is active on a smart phone” or “whenever the camera is not active”).

A POSITA would have been motivated to use Sarin’s contextual cue and influence evaluation of at least one of the plurality of processing stages based on whether the acoustic input is received proximate in time with the occurrence of the event, in view of Gruber. Ex-1002 ¶¶208-213.

First, Gruber’s “virtual assistant 1002 is able to use context associated with *asynchronous events* that happen independently of the user’s interaction.” Ex-1008 ¶238. Exemplary asynchronous events include “incoming text messages or pages; incoming email messages; incoming phone calls; reminder notifications or task alerts; calendar alerts; alarm clock, timers, or other time-based alerts; notifications

of scores or other events from games; notifications of financial events such as stock price alerts; news flashes or other broadcast notifications; [and] push notifications from any application.” *Id.* ¶¶240-249.

Second, Gruber considers whether the acoustic input is received proximate in time with the occurrence of various events. For example, as shown in Figure 23, an incoming text message is an event that is used by the system (such as the message being received at 6:23 PM). Ex-1008 ¶238.



FIG. 23

Next, as shown below in Figure 24, an end user has spoken the command “call him.” *Id.* Gruber then “use[s] the event context to disambiguate the command by interpreting ‘him’ to mean the person who sent the incoming text message.” *Id.* Based on the time displayed (6:34 PM), a POSITA would have understood that the device received the voice command (“call him”) proximate in time with the event (the receipt of the 6:23 PM text message) and would use this proximity in time to determine to whom the command is directed to (i.e., to discern who “him” refers to in the command “call him”), as Gruber suggests. Ex-1002 ¶¶211-212. Specifically, Gruber teaches to “interpret instructions such as ‘send him a text message’, wherein the ‘him’ is interpreted according to context information derived from a *current* phone call.” Ex-1008 ¶18.



FIG. 24

Thus, a POSITA, in order to disambiguate the pronoun “him” in the voice command “call him,” would have been motivated to implement Gruber’s teachings to consider whether receipt of an event (e.g., a text message) was received contemporaneously with the voice command. Ex-1002 ¶¶213-215. This is just like the ’461 Patent, which provides an event example of the mobile device providing a “reminder to call John,” so that “the user may instruct the mobile device to ‘Call John Doe,’ to initiate a telephone call.” Ex-1001, 23:46-64 (providing certain events that trigger a voice response). The ’461 Patent further explains that “various system resources may be activated to, for example, check for recent activity, check for an

occurrence of an event, check the battery power, etc. to incrementally wake-up portions of the mobile device on an as-needed basis.” *Id.*, 16:26-30. A POSITA would have understood that, just like the ’461 Patent wakes-up portions of the device to check for an occurrence of an event, Gruber’s considers the event and timing of the event. Ex-1002 ¶¶215-216.

A POSITA would have been motivated to implement Gruber’s teachings of considering whether the asynchronous events occurred proximate in time with the receipt of audio input, in Sarin-Hwang’s mobile device because doing so would better address events that happen independently of the user’s interaction with the mobile device, and better evaluate the acoustic input for a precise, executable statement. Ex-1008, Abstract, ¶238; Ex-1002 ¶216.

Accordingly, Sarin-Hwang-Gruber’s mobile device uses events, such as a received text message (“contextual cue includes an occurrence of an event on the mobile device”) and considers whether the reception of the text message (i.e. the event) was close in time with the receipt of audio containing a voice command (“influencing evaluation ... based on whether the acoustic input is received proximate in time with the occurrence of the event”). Ex-1002 ¶217.

c. Claim 7

Sarin-Hwang-Gruber teaches this claim. Sarin-Hwang-Gruber teaches that the contextual cue includes the location of the mobile device and that location influences

the evaluation of a processing stage. Ex-1002 ¶¶218-224. As explained above in §VIII.A.3.e (Claim 7), Sarin’s consideration of the “location of the mobile device,” is a contextual cue that influences the processing stage of image-capture related voice commands.

Further, a POSITA would have been motivated to apply the teachings of Gruber to Sarin-Hwang to recognize more general voice commands based on the location of the mobile device in order to better understand these commands. Ex-1002 ¶¶220-223. For example, the virtual assistant implemented in Sarin-Hwang-Gruber’s mobile device uses “[l]ocation information coming from sensors or location-based systems” as contextual information. Ex-1008 ¶131 (using Global Positioning System). Virtual assistant combines location information with the explicit user input “to *detect when a user is at home*, based on known address information and current location determination.” *Id.* Thus, “*certain inferences may be made about the type of information the user might be interested in when at home* as opposed to outside the home, as well as the type of services and actions that should be invoked on behalf of the user depending on whether or not he or she is at home.” *Id.*

Accordingly, Sarin-Hwang-Gruber’s mobile device uses its GPS location data to assist in interpreting voice commands, (“contextual cue includes the location of the mobile device”), and considers whether a user is at home in making certain

inferences while interpreting the voice command (“influencing evaluation...based on determining whether the mobile device is located in ... a home”). Ex-1002 ¶224.

d. Claim 9: The method of claim 1, wherein the at least one contextual cue includes the sample of the acoustic environment obtained by the mobile device by storing acoustic input previously received by the mobile device and determined not to include a voice command, and the method comprises subtracting the sample of the acoustic environment from the acoustic input.

Sarin-Hwang-Gruber teaches this claim. Sarin-Hwang teaches a contextual cue that includes the sample of the mobile device’s acoustic environment and subtracting the sample from the acoustic input. Ex-1002 ¶¶225-232. Sarin determines whether audio input is a sufficient match to a command depending on “environmental factors,” such as the background noise. Ex-1005, 8:21-25. For example, Sarin’s voice recognition engine listens for specific commands by “quickly dismiss[ing] some sounds (such as background noise or conversation) and focus[ing] on a command grammar and vocabulary that is relevant to the current context (e.g., words or phrases that correspond to image capture commands).” Ex-1005, 11:37-41. A POSITA would have understood that an obvious implementation of Sarin’s sampling and dismissal of background noise would have been to subtract a sample of the acoustic environment from the received acoustic input. Ex-1002 ¶226.

Further, a POSITA would have been motivated to store the acoustic input previously received by the mobile device and determined not to include a voice command, as taught by Gruber. Ex-1002 ¶227. Gruber stores acoustic profile data, which can be used as contextual information to “aid in recognition and interpretation” of speech. Ex-1008 ¶250. Specifically, Gruber takes in to “account the acoustic environments in which the speech is entered,” by storing “noise profiles” of the user’s location. *Id.* For example, “noise profiles of a quiet office are different from those of automobiles or public places.” *Id.* The noise profiles are identified and stored as the acoustic environment, which includes sounds but not a voice command. Ex-1002 ¶227.

A POSITA would have been motivated to remove the background noise using Gruber’s stored acoustic environment (noise profiles) to “aid in recognition and interpretation of input” by being used as a contextual cue. Ex-1008 ¶250; Ex-1002 ¶¶228-231. Additionally, Sarin-Hwang’s recognition would have been improved by using Gruber’s saved noise profiles of the user’s location so that when Sarin considers the user’s location and compares audio input with other audio data to determine the image capture-related command, it can estimate noise models and dismiss the background noise commonly associated with the user’s location more efficiently and accurately. Ex-1005, 12:38-41; Ex-1002 ¶¶229-231 (citing Ex-1018 ¶¶42, 57).

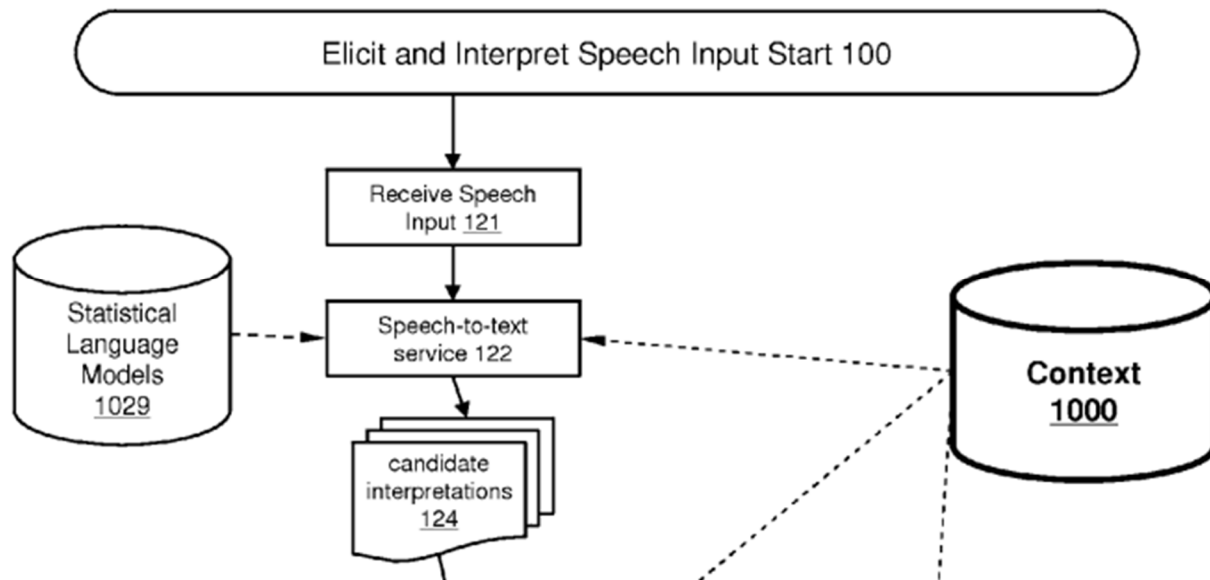
Accordingly, Sarin-Hwang-Gruber stores noise profiles of the user's location(s) which include sound but not a voice command ("contextual cue includes the sample of the acoustic environment obtained by the mobile device by storing acoustic input previously received by the mobile device and determined not to include a voice command") to estimate noise models and dismiss the background noise commonly associated with the user's location ("subtracting the sample of the acoustic environment from the acoustic input"). Ex-1002 ¶232.

e. Claim 10: The method of claim 1, wherein a sequence of performing the plurality of processing stages is determined, at least in part, by the at least one contextual cue.

Sarin-Hwang-Gruber teaches this claim. Ex-1002 ¶¶233-239. As explained in §VIII.A.2.d (Element 1[c]), Sarin-Hwang uses "contextual cues" in processing image capture-related voice commands. Moreover, Sarin-Hwang performs a plurality of processing stages. *See* §VIII.A.2.e (Element 1[d]).

A POSITA would have been motivated to perform Sarin-Hwang's plurality of processing stages in a sequence based on a contextual cue, as taught by Gruber. Ex-1002 ¶235. Gruber's virtual assistant employs a number of processing stages, such as using "statistical language models" ("SLMs") to generate candidate text interpretations of input speech. Ex-1008 ¶317. As shown in excerpted Figure 3 below, contextual information (context 1000) is used by speech-to-text service 122

to select appropriate SLMs 1029 (i.e. processing stages) and generate candidate interpretations 124 of received input speech 121.



Specifically, Gruber’s “Personal Acoustic Context Data 1080” is “used to *select from possible SLMs* 1029 or otherwise tune them to optimize for recognized acoustical contexts.” *Id.* ¶332. Gruber’s personal acoustic context data includes the acoustic environments, which can be used to “aid in recognition and interpretation of input.” *Id.* ¶250. Thus, Gruber uses context data, such as the user’s location, to determine the SLM (that is, to select the appropriate processing stage for a given context) for further processing the voice input. Ex-1002 ¶235.

Gruber’s selection of SLMs are “processing stages” that use contextual cues, consistent with the ’461 Patent because the selection of appropriate SLMs based on contextual information determines the sequence that speech-to-text processing

stages are performed. Ex-1002 ¶236. For example, after interpreting speech input, Gruber teaches to produce candidate interpretations based on one or more SLMs to the speech input. Ex-1008 ¶¶307, 317, Figure 2 (element 190). Further, Gruber teaches that “process steps, method steps, algorithms or the like may be described in a *sequential* order.” *Id.* ¶63. Thus, selecting additional SLMs based on contextual information impacts the sequence of speech recognition processing performed by the virtual assistant. Ex-1002 ¶236; Ex-1008 ¶321 (noting that an SLM can be *added* and tuned based on contextual information).

A POSITA would have been motivated to implement Gruber’s teaching to apply processing sequences based on at least one contextual cue into Sarin-Hwang’s processing stages to improve the speech recognition processing to further personalize results. Ex-1002 ¶¶237-238. For example, Gruber teaches that one benefit of its approach is to provide adaptive processing based on user or “environmental measures” (Ex-1008 ¶¶218, 222, 250), such that the contextual cue will be used to evaluate the processing steps appropriate based on the user’s location or schedule. Ex-1002 ¶¶237-238 (discussing Ex-1005, 11:42-50; Ex-1016 ¶¶3, 22, 43).

Accordingly, Sarin-Hwang-Gruber selects the speech recognition processing sequence (“a sequence of performing the plurality of processing stages”) based on

contextual information (“at least in part, by the at least one contextual cue”). *Id.* ¶239.

- f. Claim 12: The method of claim 11, wherein at least one second processing stage of the plurality of processing stages is performed by the primary processor only after the at least one first processing stage is performed and neither concludes that the acoustic input includes a voice command nor concludes that the acoustic input is the result of spurious acoustic activity.**

Sarin-Hwang-Gruber teaches this claim. Sarin-Hwang-Gruber teaches a second processing stage performed by the primary processor only after the first processing stage and neither concludes that the acoustic input includes a voice command nor concludes that the acoustic input is the result of spurious acoustic activity. Ex-1002 ¶¶240-245. Gruber teaches that when a user request is ambiguous, Gruber’s virtual assistant may undertake a number of actions, “including active elicitation, paraphrasing, suggestions, and the like, and including obtaining context information, so that the correct services ... are called and the intended action taken.” Ex-1008 ¶88. Gruber “may *prompt the user for confirmation and/or request additional context information* from any suitable source before calling a service ... to perform a function.” *Id.*

A POSITA would have been motivated to implement Gruber’s second stage of processing in Sarin-Hwang’s mobile device when the first stage of processing is

not sufficient to specifically identify the voice command to request additional information and confirm that the acoustic input indeed includes a voice command. Ex-1002 ¶¶242-244. A POSITA would have been motivated to modify Sarin-Hwang to include a second processing stage performed by the primary processor, as taught by Gruber, only after the first processing stage is performed in cases where the first stage is not sufficient to definitively identify the command, because doing so would have improved the Sarin-Hwang mobile device's ability to disambiguate voice commands. Ex-1002 ¶244.

Accordingly, Sarin-Hwang-Gruber's second processing stage determines that an audio input includes a voice command ("second processing stage...is performed by the primary processor") after a first processing stage is unable to definitively identify the command ("only after the...first processing stage is performed and neither concludes that the acoustic input includes a voice command nor concludes that the acoustic input is the result of spurious acoustic activity"). *Id.* ¶245.

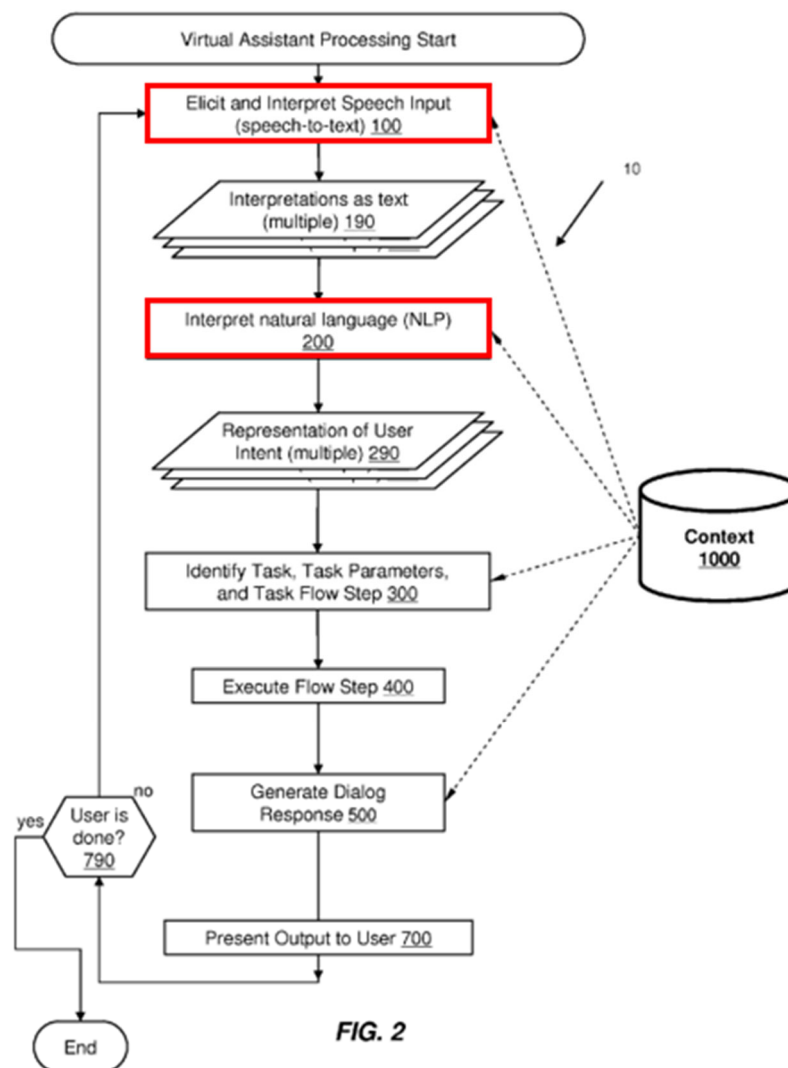
g. Claim 15: The method of claim 11, wherein performing the at least one second processing stage comprises performing at least one speech processing stage including at least one of automatic speech recognition on the acoustic input and at least one natural language processing stage to understand the meaning of the voice command.

Sarin-Hwang-Gruber teaches this claim. Ex-1002 ¶¶246-251. As discussed in §VIII.A.2.e, Sarin-Hwang teaches performing at least one processing stage,

including automatic speech recognition on the acoustic input to detect keywords and image capture-related voice commands.

Further, a POSITA would have been motivated to apply the teachings of Gruber to modify Sarin-Hwang's mobile device to perform at least one second processing stage of automatic speech recognition and natural language processing to understand the meaning of more general voice commands utilizing Sarin-Hwang's primary processor. Ex-1002 ¶248.

As shown in Gruber's Figure 2 below, speech input is received as an auditory signal at step 100 and "*speech-to-text service 122 or processor generates a set of candidate text interpretations 124 of the auditory signal.*" Ex-1008 ¶316. A POSITA would have understood that the speech-to-text processing performed by the virtual assistant on the primary processor entails automatic speech recognition. Ex-1002 ¶¶248-249 (discussing Ex-1012).



At step 200, “[t]he set of candidate interpretations” produced at step 100 is processed by a natural language processor, “which parses the text input and generates a set of possible interpretations of the user’s intent.” Ex-1008 ¶308.

A POSITA would have been motivated to implement Gruber’s automatic speech recognition and natural language processing in Sarin-Hwang’s mobile device because Gruber’s technique enables more reliable interpretation of general voice commands by using speech models that better parse acoustic input and generate a

set of possible interpretations of the user's intent. Ex-1002 ¶250. Moreover, a POSITA would have understood the advantages of implementing Gruber's virtual assistant on Sarin-Hwang's more powerful primary processor because a POSITA would have understood that Sarin-Hwang's low power DSP does not have sufficient processing power to implement Gruber's speech models. *Id.*

Accordingly, Sarin-Hwang-Gruber's second processing stage includes a speech-to-text processing step ("performing at least one speech processing stage including at least one of automatic speech recognition") and a natural language processing step ("and at least one natural language processing stage to understand the meaning of the voice command"). Ex-1002 ¶251.

h. Claim 17: The method of claim 1, comprising performing one or more default actions when a specific task could not be ascertained from the acoustic input.

Sarin-Hwang-Gruber teaches this claim. Sarin-Hwang-Gruber teaches performing a default action when a specific task could not be ascertained from the acoustic input. Ex-1002 ¶¶252-256. Specifically, when a user request is ambiguous or needs further clarification, Gruber teaches to undertake a number of actions, "including active elicitation, paraphrasing, suggestions, and the like, and including obtaining context information, so that the correct services ... are called and the intended action taken." Ex-1008 ¶88. For example, Gruber "may *prompt the user*

for confirmation and/or request additional context information from any suitable source before calling a service ... to perform a function.” *Id.*

The above actions are consistent with “default actions” disclosed in the ’461 Patent that are performed when a detected voice command “cannot be suitably mapped to a specific task or set of tasks.” Ex-1001, 37:27-28. For example, “the default action may include *formulating a question to be rendered to the user to obtain further information* and/or clarification regarding the voice command.” *Id.*, 37:30-33; Ex-1002 ¶254.

A POSITA would have been motivated to implement a default action when a specific task could not be ascertained from the acoustic input, as taught by Gruber, in Sarin-Hwang’s mobile device in order to request additional information in so that the task can be performed. Ex-1002 ¶255.

Accordingly, Sarin-Hwang-Gruber’s mobile device prompts the user to confirm the request and/or requests additional contextual information (“performs one or more default actions”) when a user request is found to be ambiguous, (“when a specific task could not be ascertained from the acoustic input”). Ex-1002 ¶256.

D. Ground 4: Sarin in Combination with Hwang and Lebeau Renders Obvious Claim 8**1. Motivation to Combine Lebeau with Sarin-Hwang**

A POSITA would have been motivated to combine the teachings of Sarin, Hwang, and Lebeau (“Sarin-Hwang-Lebeau”) and would have had a reasonable expectation of success in doing so because they are analogous art and teach improvements to the same type of devices. Ex-1002 ¶¶257-261. Each teach an electronic device in a first mode of operation which then switches to a second mode of operation. Ex-1005, 13:53-62 (transitions from a low-power state to an active state); Ex-1006 ¶¶5 (low-power system for receiving audio), ¶31 (based on analysis of the audio feature data, activating various components); Ex-1016, Abstract, ¶¶7-9 (“switch to the second mode of operation”). Each teach using speech processing to determine a voice command. Ex-1005, 6:29-49, 13:15-20; Ex-1006 ¶¶52; Ex-1016 ¶¶7-9 (“monitors ambient sounds for voice input that indicates a request to perform an operation”).

Lebeau offers additional benefits to Sarin-Hwang’s mobile device. Lebeau teaches that the mobile device will detect its condition in order to determine whether to switch the device to monitor for voice input indicating a request. Ex-1016 ¶9. Lebeau’s device attempts to infer whether, based on the current context, monitoring for voice input would provide at least a threshold level of convenience for the user

and, if so, monitor for voice input. Ex-1016 ¶23. Lebeau explains that a context includes whether the mobile device's battery is "running low on stored power (e.g., below 25% charge remaining in the battery)" (Ex-1016 ¶24) or the mobile device is powered from a power cord. Ex-1016 ¶30. Lebeau's device determines whether the "potential convenience to the user of monitoring for voice input is outweighed by the inconvenience to the mobile computing device...of potentially draining the battery in a relatively short period of time (short when compared to standby operation)." *Id.* ¶31.

A POSITA would have recognized that considering the mobile device's battery when processing a voice input is desirable in a mobile device that runs on a battery, as maintaining the primary processor in a deactivated state until the processor is needed would tend to conserve power usage and extend the battery's life, which is a goal of Sarin-Hwang. Ex-1005, 11:32-34; Ex-1002 ¶¶259-260.

A POSITA would have had a reasonable expectation of success in combining Lebeau with Sarin-Hwang. Ex-1002 ¶261. The electronic components of Lebeau and Sarin-Hwang's devices are similar and compatible. A POSITA would have understood that Sarin-Hwang's and Lebeau's electronic components are similar and are interchangeable, therefore, disclose interrelated teachings based on routine technologies that would have been amenable to various well-understood combinations to provide quick and efficient speech recognition. *Id.*

2. Dependent Claim 8

- a. Claim 8: The method of claim 1, wherein the at least one contextual cue includes the power source of the mobile device, and the method comprises influencing evaluation of at least one of the plurality of processing stages based on at least one of determining whether the mobile device is being powered using a battery or wall power, and a state of the battery if the mobile device is being powered using the battery.**

Sarin-Hwang-Lebeau teaches Claim 8. Sarin-Hwang-Lebeau teaches that the mobile device's power source is a contextual cue that influences the processing stage's evaluation based on determining that the device is being powered using the battery. Ex-1002 ¶¶262-266.

A POSITA would have been motivated for Sarin-Hwang's contextual cue (*see* §VIII.A.2.d) that influences evaluation of at least one processing stage to be based on whether the mobile device is being powered using a battery or wall power, and a state of the battery if the mobile device is being powered using the battery, in view of Lebeau. Ex-1002 ¶¶263-264. Lebeau considers “a battery for the mobile computing device running low on stored power (e.g., below 25% charge remaining in the battery)” when determining whether “to switch the mobile computing device from a current mode of operation to a second mode of operation” based on a voice input indicating a request. Ex-1016, Abstract, ¶24. Lebeau also teaches that the mobile device can be powered from a power cord plugged into an outlet. Ex-1016

¶30. Therefore, Lebeau considers the mobile device's power source and allows the battery's status to influence the evaluation performed in the processing stage by not performing voice recognition if the battery is low but performing voice recognition when the device is powered using wall power. Ex-1002 ¶264.

A POSITA would have been motivated to consider the mobile device's battery status, as taught by Lebeau, as one of Sarin-Hwang's contextual cues used when processing the acoustic input because doing so would allow the device to determine whether the "potential convenience to the user of monitoring for voice input is outweighed by the inconvenience of the mobile computing device ... potentially draining the battery in a relatively short period of time." Ex-1016 ¶31; Ex-1002 ¶265.

Accordingly, Sarin-Hwang-Lebeau considers whether the device is being powered by a battery or wall power ("contextual cue includes the power source of the mobile device") and not performing voice recognition if the device is being powered by the battery and it is running low, but performing voice recognition when the device is powered using wall power ("influencing evaluation ... based on at least one of determining whether the mobile device is being powered using a battery or wall power, and a state of the battery if the mobile device is being powered using the battery"). Ex-1002 ¶266.

IX. THE DISCRETIONARY FACTORS FAVOR INSTITUTING TRIAL

A. 35 U.S.C. § 314(a)

Patent Owner (“PO”) may ask the Board to exercise its discretion to deny institution despite the strong invalidity showing on the merits. The Board should decline to do so because the weight of the factors articulated in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential) favors institution.

As an initial matter, there is no litigation currently pending against Co-petitioner Google. Accordingly, none of the *Fintiv* factors that depend on actions or activities of a petitioner in a co-pending litigation apply in any respect to Google. When each of these factors is weighed against Co-petitioner Google, they strongly weigh against denial. Accordingly, the Board should decline to exercise its discretion under 35 U.S.C. §314(a).

1. Stay

This factor is neutral. Petitioners have not requested a stay but intend to do so. The PTAB has explained that it will not speculate on how any such motion would be resolved, before one is filed. *Google LLC v. Parus Holdings, Inc.*, IPR202000847, Paper 9 at 12 (PTAB Oct. 21, 2020). Additionally, the PTAB has explained that this factor is neutral where no such stay motion has yet been filed. *See, e.g., Hulu LLC*

v. SITO Mobile R&D IP, LLC, IPR2021-00298, Paper 11 at 10-11 (PTAB May 19, 2021) (concluding that without evidence of a requested stay or consideration by the district court, this factor does not significantly impact the Board’s exercising discretion to deny institution of the IPR).

2. Trial Date

The district court in the parallel litigation against Co-petitioner Samsung held a scheduling conference on March 25, 2024, and set jury selection for August 4, 2025, approximately nine months away. Ex-1022. Any comparison of a projected FWD date against the scheduled trial date is speculative. *See Dish Network v. Broadband iTV*, IPR2020-01280, Paper 17 at 16 (PTAB Feb. 4, 2021) (“We cannot ignore the fact that the currently scheduled trial date is more than nine months away and much can change during this time”).

Setting that aside, as this Petition is filed on October 16, 2024, a FWD would be expected by April 2026. Although this is approximately eight months after the currently scheduled (speculative) trial date, this factor is not determinative or considered in isolation. *Facebook, Inc. v. USC IP P’Ship*, IPR2021-00034, Paper 13 at 11 (PTAB April 13, 2021) (“[T]his factor is not considered in isolation, but holistically along with other factors”) (citation omitted). Moreover, the Board has instituted IPR and found, on similar facts, that this factor weighs only minimally in favor of denial. *See, e.g., Google LLC, et al. v. Multimodal Media LLC*, IPR2024-

00056, Paper 9 at 8 (PTAB Apr. 12, 2024) (six months between trial and the expected FWD “weighs only marginally in favor” of denial); *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-01492, Paper 12 at 9-16 (PTAB Mar. 21, 2022) (instituting IPR without stipulation and copending trial date six months before FWD); *Facebook*, IPR2021-00034, Paper 13 at 11 (five months between trial and expected FWD “slightly favors denial”); *Coolit Systems, Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11 (PTAB Dec. 28, 2021) (five months between trial and expected FWD “weighs slightly in favor” of denial); *Equipmentsshare.com Inc. v. Ahern Rentals, Inc.*, IPR2021-00834, Paper 19 at (PTAB Nov. 16, 2021) (seven months between trial and expected FWD “weighs somewhat in favor” of denial).

3. Diligence/Investment

This factor weighs strongly against discretionary denial. No substantive orders have been issued by the court in the underlying litigation, and investment in the parallel litigation against Co-petitioner Samsung will have remained low at the time of institution. *See, e.g., Hulu LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11 at 12-14 (PTAB May 19, 2021) (holding that this factor supports instituting IPR given the early stage of the district court proceedings, the lack of substantial discovery related to invalidity claims, and the petitioner’s diligent filing of the petition after receiving preliminary infringement contentions). Assuming that a Decision on Institution is issued by April 2025, much work in district court will

remain. *Id.* The opening claim construction brief is currently due January 10, 2025, the *Markman* hearing is scheduled for February 21, 2025, opening expert reports are due March 17, 2025, and dispositive motions are due April 28, 2025. *Id.*

4. Overlap

Factor 4 weighs against discretionary denial. As noted above, the case is in an early stage and there has been very little activity in the case. At present, there is little overlap in issues between the litigation and any IPR resulting from this petition. It would be premature to conclude that the issues raised in this proceeding will overlap with those in the District Court. Instituting this proceeding will allow the Board to address the asserted prior art, narrowing the issues in the co-pending litigations due to the estoppel provisions of 35 U.S.C. §315(e)(2).

Moreover, as noted above, Co-Petitioner Google is not a party to the copending litigation. This IPR is thus the only forum in which Google can currently present its invalidity challenge.

5. Parties

The Board should give little weight to the fact that Co-petitioner Samsung and Patent Owner are also parties to the parallel litigation because Co-petitioner Google and the Samsung defendants are not the same party.

6. Other considerations

Even if the *Fintiv* factors favor discretionary denial (which they do not), the merits are compelling here. The Office did not consider a wealth of prior art during prosecution that discloses and/or suggests the alleged invention. Petitioners therefore respectfully submit that the *Fintiv* factors favor institution and that discretionary denial of this Petition would be neither appropriate nor equitable.

B. 35 U.S.C. § 325(d)

In considering its discretion under 35 U.S.C. §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 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 at 8 (PTAB Feb. 13, 2020) (precedential).

Here, the first *Advanced Bionics* prong is not met. Four of the references relied upon in this petition (Sarin, Hwang, Garner, and Gruber) were not cited or discussed by the Examiner. While the Lebeau reference was cited substantively in rejections by the Examiner, this is not sufficient to satisfy the first *Advanced Bionics* prong because Lebeau is used in combination with Sarin and Hwang (Ground 4), both not

of record. *See Godbersen-Smith Constr. Co. d/b/a Gomaco Corp. v. Guntert & Zimmerman Const. Div., Inc.*, IPR2021-00050, Paper 24 at 19-21 (PTAB May 7, 2021) (where “neither [the combination references] nor similar prior art was before the examiner ... the prosecution history does not include any overlapping arguments directed to this prior art”); *K/S HIMPP v. Bragi GmbH*, IPR2023-01205, Paper 8 at 20 (PTAB Mar. 19, 2024) (“Although one reference ... was previously presented to the Office, in each asserted ground, Petitioner relies on either Hain or Hain in combination with Sørensen. Because neither of those references was before the office, Patent Owner has not satisfied the first prong of the *Advanced Bionics* test.”).

Moreover, under the second prong, which need not be reached, it was a material error for the Examiner not to have considered the disclosures of Lebeau, as applied here. More particularly, the Office erred in not recognizing that Lebeau teaches to consider the device’s battery power when monitoring for voice input. Ex-1016 ¶¶9, 23-24, 30. During prosecution, the applicant argued that Lebeau uses contextual cues to determine whether or not to enable itself to receive acoustic input so that “Lebeau says nothing about using at least one contextual cue to assist in detecting whether acoustic input which has already been received includes a voice command.” Ex-1004, 1162. But using contextual cues to determine whether the acoustic input includes a voice command is obvious in view of other prior art that the Examiner failed to meaningfully consider. *See* §§VIII.A-C. Because the record

is silent as to the Examiner's understanding of Lebeau in combination with other prior art's teaching of using contextual cues to determine whether the acoustic input includes a voice command, the Examiner must have overlooked it because Lebeau, in combination with Sarin and Hwang teach the claim limitations. *See K/S HIMPP v. Bragi GmbH*, IPR2023-01205, Paper 8 at 20-21 (PTAB Mar. 19, 2024). In view of the foregoing, the Board should not exercise its discretion under §325(d) to deny institution because Sarin, Hwang, Garner, and Gruber were not before the Office and together render all but one of the claims unpatentable.

X. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8

A. Real Parties-in-Interest

Petitioners identify themselves as the real parties-in-interest.⁸

1. Related Matters

To the best of Petitioners' knowledge, the '461 Patent has only been involved in the following district court litigation: *Cerence Operating Co. v. Samsung Electronics Co., Ltd. et al.*, 2:23-cv-00482-JRG-RSP (E.D. Tex.), filed October 13, 2023. Ex-1021.

⁸ Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc. XXVI Holdings Inc. and Alphabet Inc. are not real parties-in-interest to this proceeding.

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To the best of Petitioners' knowledge, the '461 Patent has not been challenged in any other *inter partes* review or post-grant review prior to this proceeding.

Petitioners also plan to file IPR2024-01465 directed to U.S. 11,087,750, which is a continuation of the '461 Patent.

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D. Power of Attorney

A power of attorney is filed herewith according to 37 C.F.R. §42.10(b).

XI. FEES

Petitioners concurrently electronically submit the required fees for this Petition. The PTO is authorized to charge any fees due during this proceeding to Deposit Account No. LA500639.

Date: October 16, 2024

Respectfully submitted,

/ Benjamin M. Haber /
Benjamin M. Haber (Reg. No. 67,129)
Counsel for Petitioner

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing Petition for *Inter Partes* Review contains 13,936 words, excluding those portions identified in 37 C.F.R. § 42.24(a), as measured by the word-processing system used to prepare this paper.

/ Benjamin M. Haber /
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Counsel for Petitioner

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CERTIFICATE OF SERVICE

I certify that on October 16, 2024, I caused a true and correct copy of the foregoing Petition for *Inter Partes* Review of U.S. Patent No. 11,393,461 and supporting exhibits to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on PAIR:

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Paper No. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS, AMERICA, INC.,
Petitioners,

v.

CERENCE OPERATING COMPANY,
Patent Owner.

Case No. IPR2024-01464
U.S. Patent No. 11,393,461

PATENT OWNER'S PRELIMINARY RESPONSE

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TABLE OF AUTHORITIES

Cases

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PATENT OWNER'S EXHIBIT LIST

<i>Exhibit No</i>	<i>Description</i>
2001	Federal Court Management Statistics, Eastern District of Texas, 2019-2024
2002	Excerpt of Defendant's Amended Invalidity Contentions (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))
2003	Proof of Service of Samsung Electronics America, Inc. (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))

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I. INTRODUCTION

The Board should exercise its discretion to deny institution under *Fintiv*. Trial in the district court case between Patent Owner and the Samsung Petitioners is scheduled to begin eight and a half months before a final written decision would be due in this case. Given the Petition's weak position on the merits, the lack of a *Sotera* stipulation, and the likely wasteful duplication of effort that would result from instituting this IPR, institution should be denied.

II. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner proposes that a person of ordinary skill in the art at the time of the priority date would have had "a Bachelor of Science (or equivalent) in electrical engineering or computer science, and two years of work experience in the field of speech and natural language interfaces for interacting with and directing computer systems and software, including speech recognition and processing." Petition at 13. Petitioner also notes that "[a] greater amount of education could compensate for less work experience, and vice versa." *Id.*

Patent Owner reserves the right to offer a different level of ordinary skill in this or in other proceedings concerning the '461 patent. However, Patent Owner does not believe that the issues presented in this Preliminary Response turn on the precise level of ordinary skill in the art and believes that the Board

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could assume Petitioner’s proposed level of ordinary skill for the purposes of deciding whether to institute.

III. LEGAL STANDARDS

The petitioner has the burden to clearly set forth the basis for its challenges in the petition. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) as “requiring IPR petitions to identify ‘with particularity ... the evidence that supports the grounds for the challenge to each claim’”). A petitioner may not rely on the Board to substitute its own reasoning to remedy the deficiencies in a petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“Congress chose to structure a process in which it’s the petitioner, not the Director, who gets to define the contours of the proceeding.”); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (rejecting the Board’s reliance on obviousness arguments that “could have been included” in the petition but were not, and holding that the Board may not “raise, address, and decide unpatentability theories never presented by the petitioner and not supported by the record evidence”); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (holding that “a challenge can fail even if different evidence and arguments

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might have led to success”); *Wasica Finance GMBH v. Continental Auto. Systems*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (holding that new arguments in a reply brief are “foreclosed by statute, our precedent, and Board guidelines”).

The Board “may reject even uncontroverted expert testimony when it is intrinsically unpersuasive.” *Granite Constr. Co. v. United States*, 962 F.2d 998, 1006 (Fed. Cir. 1992). The petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *Magnum*, 829 F.3d at 1380.

An obviousness determination requires finding that a POSITA would have been motivated to modify or combine teachings in the prior art. *In re Stepan Co.*, 868 F.3d 1342, 1345–46 (Fed. Cir. 2017). Obviousness concerns “whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). The “mere fact that these possible arrangements existed in the prior art” does not provide a motivation to substitute the arrangement in one prior art embodiment with the arrangement in another.” *Virtek Vision International ULC v. Assembly Guidance Systems, Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024). Because a motivation to modify or combine is part of the *prima facie* case for obviousness that must be set forth in the petition, a petitioner should not be

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permitted to present “an entirely new rationale to explain why one of skill in the art would have been motivated to combine” in its reply. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1370 (Fed. Cir. 2016).

IV. CLAIM CONSTRUCTION

Petitioners state that “no express constructions of the claims are necessary” and state that “the claims should be given their plain and ordinary meaning.” Petition at 14. Patent Owner agrees that no construction of the terms is required to decide whether to institute this IPR. As Patent Owner explains further below, institution should be denied applying the plain and ordinary meaning to the relevant claim terms.

V. ARGUMENT

A. The Board Should Exercise Its Discretion to Deny Institution on *Fintiv* Grounds

35 U.S.C. § 314(a) gives the Board discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19-21 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”). The Board has set forth six factors for determining whether discretionary denial in light of such parallel litigation is appropriate, and in analyzing them, “takes a holistic view of whether efficiency and integrity of the system are best served by denying

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or instituting review.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv I*”); *see also Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (PTAB May 13, 2020) (informative) (“*Fintiv II*”); Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (dated June 21, 2022) (“Interim Discretionary Denial Memo”).

Each of these six *Fintiv* factors weigh in favor of the Board exercising its discretion to deny institution here. For Factor 1, no stay of the parallel district court litigation has been granted, and a stay is unlikely given the advanced stage of the case. For Factor 2, the district court trials will occur approximately eight and a half months before the deadline for a final written decision in this proceeding. For Factor 3, there will be much investment by the parties and the district court—by the time the Board issues its institution decision, the claim construction hearing, fact discovery, expert reports, and expert depositions will be complete, and summary judgment and other key motions will have been filed or be due within days. For Factor 4, there is substantial overlap in both the claims and art at issue in this proceeding and in the district court; Petitioners have not made a *Sotera* stipulation to address the concerns of inefficiency and inconsistent rulings. For Factor 5, the Samsung Petitioners are

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defendants in the parallel litigation. And for Factor 6, the Petition fails to present a compelling challenge on the merits, and the Petitioners delayed significantly in filing their petition. Each of these factors is addressed in more detail below.

1. *Fintiv* Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted.

In the parallel district court proceeding (*Cerence Operating Company v. Samsung Electronics Co., Ltd.*, Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.)) involving the '461 Patent and the Petitioners, the district court has not granted a stay pending IPR. Further, there is no evidence that a stay will be granted.

Moreover, the facts here indicate that it is unlikely that the district court would grant a stay pending IPR even if this IPR were instituted, given the late stage of litigation. The parties have already exchanged their first two rounds of claim construction briefs (Ex. 1022 at 3), and the fact discovery period is seven weeks from completion (Ex. 1022 at 3). By the time the Board's institution decision is due in this proceeding (April 28, 2025), the claim construction hearing will have been held, expert discovery will be complete, and motions for summary judgment will be due. (Ex. 1022 at 3.) Trial is currently set for August 4, 2025—more than eight and a half months before the earliest deadline for a final written decision in this IPR. (Ex. 1022 at 1.)

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Where the district court litigation has not been stayed, and any stay is speculative and unlikely, allowing this IPR to proceed in parallel would be wasteful and inefficient. Factor 1 weighs against institution.

2. *Fintiv* Factor 2: The district court trials will occur more than seven months before the deadline for a final written decision in this proceeding.

“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv I* at 9.

Here, the deadline for a final written decision in this IPR is April 28, 2026, which may be extended to October 28, 2026, for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). Meanwhile, the district court litigation is set for trial on August 4, 2025. (Ex. 1022 at 1.) The timeframe set by the district court is consistent with the Federal Court Management Statistics for the Eastern District of Texas. *See* Interim Discretionary Denial Memo at 3 & n.4 (encouraging use of these statistics in evaluating this factor). Those statistics indicate that, over the past six years, a civil case in the district was brought to trial 19.8 months after filing. Ex. 2001 (indicating median times to trial for civil cases for the twelve-month period ending in September for 2019-2024 as 16.8, 18.0, 22.1, 21.0, 19.0, and 21.9). Here, the trial is set approximately 22 months after October 13, 2023, the date the case was filed. (Ex. 1019 at 1;

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Cerence Operating Company v. Samsung Electronics Co., Ltd., Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.), Dkt. 1.)

Thus, the district court trial is set to occur ***eight and a half months*** before the deadline for a final written decision, and possibly more than a year before the deadline if extended. This weighs heavily against institution. Indeed, the Board has denied institution on account of even smaller gaps between the final written decision and trial. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly ***one or two months*** before any final decision would have been due had *inter partes* review been instituted”); *Fintiv II* at 13 (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur ***two months*** before the deadline for the Board to reach a final written decision); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 17 at 9 (PTAB May 2, 2022) (“*NXP*”) (same), *reh’g denied*, Paper 20 (PTAB Aug. 25, 2022).

Petitioners imply that the Board should ignore these set trial dates because it is “speculative.” Petition at 72. But the Petition presents no evidence

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that the trials will not proceed on the set date, which, as noted above, is consistent with the most current time-to-trial statistics for the Eastern District of Texas. *See* Interim Discretionary Denial Memo at 3 & n.4. “[B]ased on the evidence of record, there is no evidence to suggest that trial will be delayed.” *Nine Energy* at 9; *see also NXP* at 9 (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”) (quoting *Fintiv II* at 13).

Because the district court trial is currently set to occur eight and a half months before the earliest deadline for a final written decision in this IPR, the set date is consistent with current time-to-trial statistics, and there is no evidence that the date may change, this factor weighs heavily against institution. *Fintiv II* at 13.

3. *Fintiv* Factor 3: By the time an institution decision is reached, fact discovery and expert reports will be complete, and summary judgment motions will be due.

Factor 3 relates to the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv I* at 9 (emphasis added). Here, the claim construction hearing, fact discovery, expert reports, and expert depositions will be complete when the institution decision is due. (Ex. 1022 at 3.) Summary judgment and other key motions will have been filed or be due within days. (Ex. 1022 at 2–

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3.) Those investments weigh strongly against institution because they ensure that this IPR cannot be an efficient alternative to district court litigation. This favors discretionary denial, and panels have found this factor to favor denial when the parallel litigation was at a substantially less advanced stage than here. *See, e.g., BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 23-24 (PTAB Nov. 15, 2023) (denying institution in part because “[s]ignificant discovery has been completed, including the exchange of infringement and invalidity contentions, document requests and interrogatories, and proposed claim terms for construction, and ... close of fact discovery is near”).

Because there has been substantial investment in the parallel proceedings, Factor 3 weighs heavily against institution.

4. *Fintiv* Factor 4: There is substantial overlap between this IPR and the district court proceeding.

This factor looks at “whether all or some of the claims challenged in the petition are also at issue in district court” and whether the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as the parallel district court case. *Fintiv I* at 12-13. Here, there is overlap between the challenged and asserted claims, and the same prior art applied in the Petition is also relied upon at the district court.

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First, the Petition challenges claims 1–18, the same claims that are asserted in litigation. (Ex. 1021 at 2). Second, there is substantial overlap between the prior art arguments presented in the Petition and arguments advanced by Petitioners in litigation. The Samsung Petitioners’ invalidity contentions in district court assert that the same Sarin, Hwang, Gruber, and Lebeau¹ references relied upon in this IPR anticipate or render obvious claims of the ’461 patent. (Ex. 2002 at 11–12.)

Ground 2 of this IPR adds a reference Garner, which Samsung’s district court contentions list as merely a “relevant reference,” but even in the IPR petition, Garner is only used to challenge dependent claim 13.

In short, the Petition challenges the same claims asserted in the parallel litigation, and the Samsung Petitioners rely on each of the IPR references at the district court. Thus, the overlap between IPR grounds and district court invalidity theories raises substantial “concerns of inefficiency and the possibility of conflicting decisions,” weighing against institution. *See Fintiv I* at 12.

¹ The contentions in district court point to the issued Lebeau patent, while this IPR points to the published patent application.

5. *Fintiv* Factor 5: Samsung Petitioners are defendants in the district court litigation.

The Petitioners are defendants in the parallel litigation. “Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.” *Fintiv II* at 15.

The addition of Google LLC as a petitioner should not alter the analysis. First, Google chose to join with the Samsung Petitioners as a party to the IPR, rather than file its own petition, now or at a later date. While the Petitioners have not provided an explanation for this decision, it appears likely that Google did so because of its own interest in the outcome of Patent Owner’s litigation against the Samsung Petitioners. The products accused of infringement in the litigation are Samsung Galaxy smartphones and tablets (Ex. 1021 at 4–5.), which use the Android OS, supplied by Google.² Google’s interest in the outcome of the litigation against Samsung will be resolved on the same schedule as the Samsung Petitioners’ interests in that outcome.

Second, the *Fintiv* analysis in another IPR case brought by Google points toward denial of institution. In *Google v. Ikorongo*, Google brought an IPR challenging a patent asserted against LGE and Samsung. *Google LLC v. Ikorongo Tech. LLC*, IPR2021-00205, Paper 13 at 13 (PTAB June 7, 2021). LGE

² See https://en.wikipedia.org/wiki/Samsung_Galaxy_S_series; [https://en.wikipedia.org/wiki/Android_\(operating_system\)](https://en.wikipedia.org/wiki/Android_(operating_system)).

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and Samsung were named as real parties-in-interest, but were not petitioners.

Id. There, the Board found that the identity of the real parties-in-interest in the IPR and the district court cases favored denial of institution. *Id.*; *Google LLC v. Ikorongo Tech. LLC*, IPR2021-00205, Paper 16 at 9 (PTAB Jan. 25, 2022) (granting rehearing but maintaining the same conclusion as to *Fintiv* Factor 5). Here, not only are the Samsung parties real parties-in-interest and defendants in the district court litigation, as in *Ikorongo*, but they are also petitioners in the IPR. *Fintiv* Factor 5 should weigh against institution of this IPR at least as strongly as it did in *Ikorongo*.

6. *Fintiv* Factor 6: Other circumstances weigh strongly against institution, including the weakness of the Petition and Petitioners' delay.

This factor looks at “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv I* at 9. This factor weighs heavily against institution for two reasons. Contrary to Petitioner’s assertion, the Petition fails to present a “compelling” merits (*see* Interim Discretionary Denial Memo at 2-5). Moreover, Petitioner Samsung Electronics America, Inc. was served with a complaint asserting the challenged patent on October 19, 2023. (Ex. 2003.) Petitioners waited until October 16, 2024, almost the entire 12 months permitted by statute, before filing their petition, virtually ensuring that this IPR could not be resolved prior to a trial in the District Court.

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* * *

Each of the six *Fintiv* factors weigh in favor of the Board exercising its discretion to deny institution.

VI. CONCLUSION

The petition fails to establish a reasonable likelihood that Petitioner would succeed in showing that the prior art discloses or renders obvious any of the challenged claims, and the Board should deny institution on that basis. Alternatively, the Board should exercise its discretion to deny institution of this IPR on *Fintiv* grounds.

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U.S. Patent No. 11,393,461

Dated: January 27, 2025

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Case No. IPR2024-01464

U.S. Patent No. 11,393,461

CERTIFICATE OF WORD COUNT

I certify that there are 3,003 words in this paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1), according to the word count tool in Microsoft Word.

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Case No. IPR2024-01464

U.S. Patent No. 11,393,461

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
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SAMSUNG ELECTRONICS, AMERICA, INC.,
Petitioners,

v.

CERENCE OPERATING COMPANY,
Patent Owner.

Case No. IPR2024-01464
U.S. Patent No. 11,393,461

SUPPLEMENTAL BRIEFING IN SUPPORT OF PATENT
OWNER'S PRELIMINARY RESPONSE

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<i>Motorola v. Stellar</i> , IPR2024-01205, -01206, -01297, -01208, Paper 19 (March 28, 2025)	2

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PATENT OWNER'S EXHIBIT LIST

<i>Exhibit No</i>	<i>Description</i>
2001	Federal Court Management Statistics, Eastern District of Texas, 2019-2024
2002	Excerpt of Defendant's Amended Invalidity Contentions (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))
2003	Proof of Service of Samsung Electronics America, Inc. (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))
2004	Third Amended Docket Control Order (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))

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I. INTRODUCTION

Patent Owner submits this supplemental briefing in support of its POPR in view of the USPTO's recent rescission of former Director Vidal's 2022 "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," and subsequent guidance from the USPTO on this rescission. While each of the relevant *Fintiv* factors already weighed in favor of denying institution (*see* POPR at 4-14), the rescission of former Director Vidal's 2022 memo and subsequent guidance from the USPTO further confirms that the Board should exercise its discretion here.

II. ARGUMENT

First, while the now-rescinded Vidal 2022 memo previously explained that the existence of a *Sotera*-type stipulation was dispositive to the discretionary denial analysis, Chief Judge Boalick's March 24, 2025 guidance explains that said stipulation is now just one factor to consider as part of the Board's holistic analysis of the *Fintiv*'s factors. Boalick Memo at 2.

Moreover, as discussed in the director review decision in *Motorola v. Stellar*, a standard *Sotera* stipulation is no longer sufficient to determine that *Fintiv* factor 4 weighs in favor of institution where the district court invalidity contentions "are more expansive and include combinations of the prior art

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asserted in these proceedings with unpublished system prior art, which Petitioner's stipulation is not likely to moot." *Motorola v. Stellar*, IPR2024-01205, -01206, -01297, -01208, Paper 19 at 4 (March 28, 2025) (vacating the Board's decision granting institution); *id.* ("although Petitioner's *Sotera* stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation does not outweigh the substantial investment in the district court proceeding or *Fintiv* factors 1, 2, and 5...."). The same applies here, as the District Court invalidity contentions purport to preserve the ability to combine the Apple Siri and Samsung S Voice systems with any of the patent and printed publication art, undermining the effect of the submitted *Sotera* stipulation. *See, e.g.*, Ex. 2002 at 406, 416.

Second, while a showing of "compelling" merits previously foreclosed discretionary denial, Chief Judge Boalick's March 24, 2025 guidance confirms that "compelling merits alone" is no longer dispositive in determining whether discretionary denial is appropriate. Boalick Memo at 3. This change in guidance is important because each of the *Fintiv* factors *strongly* weighs in favor of discretionary denial, including because: 1) the District Court denied Petitioner Samsung's request for a stay in the parallel proceedings; 2) the District Court trial will occur more than 6 months before the earliest deadline of the final written decision; 3) claim construction, fact discovery, and expert

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reports will be complete prior to any institution decision; 4) the same prior art applied in the Petition is also relied upon at the District Court; 5) the Samsung Petitioners are defendants in the District Court litigation; and 6) other circumstances weigh in favor of discretionary denial, including Petitioners' substantial delay in filing the Petition. POPR at 4-14; (Ex. 2004 (Amended DCO)).

Thus, because each of the *Fintiv* factors weighs strongly in favor of discretionary denial, the only remaining argument Petitioners can proffer to support institution is an argument that its Petition demonstrates "compelling" merits of unpatentability. But since "compelling merits alone" is no longer dispositive in determining whether discretionary denial is appropriate, the weight of the relevant *Fintiv* factors compels a finding that discretionary denial is appropriate. Put simply, *even if* the Petition demonstrated "compelling" merits of unpatentability—and it does not—instituting IPR proceedings here would be a waste of judicial resources because the same validity issues will already be addressed in the parallel District Court action more than 6 months prior to any final written decision in this matter.

Third, additional "relevant considerations" further demonstrate that discretionary denial is appropriate. *See* Stewart March 26, 2025 Memo at 2-3 (outlining additional "relevant considerations"). As an initial matter, the Petition's extensive reliance on conclusory expert testimony to gap-fill holes in

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the prior art demonstrates discretionary denial is appropriate. For example, Petitioners support their Petition with the 146-page declaration of Mr. Christopher Schmandt, repeatedly using Mr. Schmandt's testimony to bridge gaps in the prior art and summarily conclude that a POSITA would be motivated to combine or modify the prior art. (Ex. 1002.) But Mr. Schmandt's declaration largely parrots nearly *verbatim* the attorney arguments from the Petition, without additional supporting evidence or reasoning. *See, e.g.*, Ex. 1002 ¶¶ 105, 107-110, 114-119, 125, 127-129, 131-133, 136, 144, 152, 159, 161-170, 174-177, 179, 193, 197-202, 205, 208-212, 215-217, 232, 235-236, 243, 252-256, 259-261, 264, 266. This is thus an additional relevant factor weighing in favor of discretionary denial. *See, e.g., Facebook v. Windy City Innovations, LLC*, 973 F.3d 1321, 1340-41 (Fed. Cir. 2020) (affirming Board's findings where an expert's testimony "did not add materially to Petitioner's unpersuasive attorney argument").

Moreover, as an additional "relevant consideration," it was Petitioners' own delay in filing their Petition which ensured that judicial resources would be wasted by granting institution. Petitioner Samsung Electronics America, Inc. was served with a complaint asserting the challenged patent on October 19, 2023 (Ex. 2003), but Petitioners waited until October 16, 2024—*almost the*

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entire 12 months permitted by statute—before filing their Petition, virtually ensuring that this IPR could not be resolved prior to any District Court trial.

Finally, developments in the parallel District Court action further demonstrate that discretionary denial is appropriate. For example, since the filing of the POPR, the District Court has since denied Petitioner Samsung’s request for a stay. *See Cerence Operating Company v. Samsung Elec. Co. Ltd. et al.*, 2:23-cv-0482, D.I. 94 (Feb. 2, 2025). Additionally, under the recently issued amended Docket Control Order, the parties will have completed claim construction, fact discovery, and expert reports prior to any decision on institution, demonstrating an already substantial investment by the parties in the parallel proceedings. Ex. 2004. Likewise, as reflected in the recently amended Docket Control Order, the parties recently agreed to extend the trial date in the District Court action to ensure there is sufficient time to complete all necessary work, thereby raising the likelihood that the new trial date will remain firm. *Id.* And even with this newly extended trial date, a decision on the validity of the ’421 Patent is still expected in the parallel District Court proceedings *more than six months prior* to any final written decision in this matter.

III. CONCLUSION

In view of the forgoing, discretionary denial is appropriate.

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U.S. Patent No. 11,393,461

Dated: April 8, 2025

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Case No. IPR2024-01464

U.S. Patent No. 11,393,461

CERTIFICATE OF WORD COUNT

I certify that there are 1057 words in this paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1), according to the word count tool in Microsoft Word.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

CERENCE OPERATING COMPANY,

Patent Owner

Case IPR2024-01464

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**PETITIONERS' REPLY TO
PATENT OWNER'S SUPPLEMENTAL BRIEFING**

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PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,393,461 (“’461 Patent”)
1002	Declaration of Christopher M. Schmandt
1003	Curriculum Vitae of Christopher M. Schmandt
1004	File History of U.S. Patent No. 11,393,461
1005	U.S. Patent No. 9,031,847 (“Sarin”)
1006	U.S. Patent Application Publication No. 2013/0110521 (“Hwang”)
1007	U.S. Patent No. 7,475,012 (“Garner”)
1008	U.S. Patent Application Publication No. 2012/0265528 (“Gruber”)
1009	U.S. Patent No. 8,396,463 (“Marcellino”)
1010	U.S. Patent No. 8,331,315 (“Purkayastha”)
1011	U.S. Patent No. 8,694,316 (“Pickering”)
1012	U.S. Patent Application Publication No. 2013/0173269 (“Adler”)
1013	Intentionally Left Blank
1014	U.S. Patent Application Publication No. 2020/0279576 (“Binder”)
1015	U.S. Patent Application Publication No. 2014/0006825 (“Shenhav”)
1016	U.S. Patent Application Publication No. 2012/0034904 (“LeBeau”)
1017	U.S. Patent Application Publication No. 2010/0129068 (“Binda”)
1018	U.S. Patent Application Publication No. 2012/0296655 (“Kristjansson”)
1019	U.S. Patent Application Publication No. 2014/0163978 (“Basye”)

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Exhibit No.	DESCRIPTION
1020	Claim Mapping Table
1021	Plaintiff Cerence Operating Company's Disclosure of Asserted Claims and Infringement Contentions, <i>Cerence Operating Company v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Mar. 11 2024)
1022	Docket Control Order, <i>Cerence Operating Company v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Apr. 16, 2014)
1023	Intentionally Left Blank
1024	U.S. Patent Application Publication No. 2013/0332165 ("Beckley")
1025	U.S. Patent Application Publication No. 2014/0350927 ("Yamabe")
1026	U.S. Patent Application Publication No. 2003/0179888 ("Burnett")
1027	Intentionally Left Blank
1028	Intentionally Left Blank
1029	U.S. Patent Application Publication No. 2013/0006638 ("Lindahl")
1030	Letter from Jin-Suk Park to James S. Tsuei dated Feb. 3, 2025

I. INTRODUCTION

The Board should not discretionarily deny institution. The *Fintiv* factors do not apply to Google LLC (“Google”), and, as applied to Samsung, they weigh against discretionary denial considering the EDTX litigation’s speculative trial date and remaining work, Samsung’s *Sotera* stipulation, and the Petition’s strong merits.

II. THE DISCRETIONARY FACTORS FAVOR INSTITUTION

A. Factor 1: The Board Will Not Speculate on a Stay

This factor is neutral. Samsung’s motion to stay was denied “without prejudice” for it to be refiled later. The Board has refused to speculate on future-filed stays. *See Home Depot U.S.A., Inc. v. Security Tech., LLC*, IPR2024-01420, Paper 12 at 43-44 (PTAB Mar. 24, 2025) (“If Petitioner were to file a motion to stay in the EDTX Litigation, we decline to speculate how the district court would rule on such a motion.”). Indeed, Judge Gilstrap has granted such re-filed stay motions post-institution even if opposed. *See, e.g., Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, Dkt. 83 (E.D. Tex. Mar. 8, 2024).

B. Factor 2: The Trial Date Is Uncertain and Shifting

The EDTX litigation schedule has been in flux for the past few months.¹ Magistrate Judge Payne’s Report and Recommendation denying Samsung’s motion

¹ For example, on April 4, 2025, PO stipulated to non-infringement of U.S. Patent Nos. 7,395,078 and 8,081,993 in the parallel litigation.

to transfer the EDTX litigation (which is still subject to objections being resolved by the District Judge) does not alter the analysis. As of the Petition’s filing date, jury selection was set for August 4, 2025. Ex-1022. Jury selection is now set for October 6, 2025 based on a joint motion for additional time to complete important technical discovery obligations. Ex-2004. The docket control order also allows for further amendments. *Id.* at 4. Indeed, there are currently 12 trials set for the same date. While PO speculates that trial will occur before the FWD, 12 trials cannot proceed before the same judge on the same date. *See BOE Tech. Grp. Co., Ltd. v. Optronics Sci. LLC*, IPR2024-01131, Paper 15 at 11 (PTAB Feb. 12, 2025) (“Because a number of cases are scheduled for jury selection on January 5, 2026..., there is some uncertainty...we consider this factor to be ***neutral or weigh slightly against***” (emphasis added)).

Nor does the six-month gap between the current trial date (October 2025) and the FWD deadline (April 2026) compel denial because this factor is not determinative. *Facebook, Inc. v. USC IP P’Ship*, IPR2021-00034, Paper 13 at 11 (PTAB Apr. 13, 2021) (“[T]his factor is not considered in isolation, but holistically along with other factors”). Indeed, the Board has instituted IPR on similar timing, assigning only minimal weight in favor of denial. *See, e.g., Palo Alto Networks, Inc. v. Croga Innovations Ltd.*, IPR2024-01421, Paper 8 at 11 (PTAB Mar. 14, 2025) (FWD five months after trial); *Google LLC v. Multimodal Media LLC*, IPR2024-00056, Paper 9 at 8 (PTAB Apr. 12, 2024) (FWD six months after trial).

C. Factor 3: There is Significant Work Remaining

This factor weighs against discretionary denial. While the parties have been working to complete fact discovery and opening expert reports, substantial work remains, as evidenced by the parties' joint request for more time. Ex-2004. While claim construction is complete, expert discovery deadlines, depositions, dispositive motions, and pre-trial disclosures all remain in the future. *Id.* Finally, patent owners may agree to stays post-institution² and, if still opposed after institution, the Board should weigh inefficiencies against PO, not Samsung.

Moreover, the timing weighs against discretionary denial because Samsung timely filed the petition within its statutorily-allowed period. 35 U.S.C. §315(b)³; *Google LLC v. Motion Offense, LLC*, IPR2022-01312, Paper 17 at 47 (PTAB Mar. 6, 2023) (“waiting until the last day to file the Petition without explaining the delay is neutral.”). And here, since Google is not a party to the litigation, the time period was reasonable because it allowed Google and Samsung to prepare a single petition, instead of two separate petitions, to best conserve the Board’s resources.

D. Factor 4: No Overlap

² See, e.g., *Power2B, Inc. v. Samsung Elecs. Co.*, No. 2:21-cv-00348, Dkt. 71 (E.D. Tex. July 21, 2021); *Flip Phone Games Inc. v. PLR Worldwide Sales Ltd.*, No. 2:23-cv-00139-JRG, Dkt. 138 (E.D. Tex. Dec. 10, 2024); *Athalonz LLC v. Under Armour, Inc.*, No. 2:23-cv-00193-JRG, Dkt. 77 (E.D. Tex. Sept. 13, 2024).

³ PO’s complaint against Samsung was served five months after any PGR on ’461 patent could have been filed.

Samsung’s *Sotera* stipulation (Ex-1030) refutes PO’s overlap argument. A *Sotera*-type stipulation “weighs strongly in favor of not exercising discretion... under 35 U.S.C. §314(a).” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). Samsung agreed that it will not raise in district court any art or arguments that it raised or reasonably could have raised in the IPR.⁴ Unless fully described in a publication, system art could never reasonably be raised before the Office. *See Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01003, Paper 9 at 11-12 (PTAB Jan. 9, 2024) (rejecting that the “right to assert overlapping system art in the district court” risks inconsistent outcomes because it “essentially attacks the reasoning of *Sotera* itself” despite *Sotera* remaining binding precedent). For these reasons, *Sotera* remains fully supported by former USPTO Directors Andrei Iancu and David Kappos.⁵

Motorola Sols., Inc. v. Stellar, LLC, IPR2024-01205, Paper 19 at 3 (PTAB Mar. 28, 2025) is distinguishable. First, unlike *Motorola*’s 11-month gap between trial and the FWD; here it is a 6-month gap. Second, unlike *Motorola*, the parties

⁴ Contrary to PO’s argument, the fact that Samsung was obligated under EDTX P.R. 3-3 and 3-4 to identify all possible prior art months before its Petition to preserve its defenses, cannot be held against Samsung’s IPR now. Moreover, Google has not served **any** contentions in district court, as Google is not a party to the litigation.

⁵“C4IP agrees ... and has discussed at length additional reasons for supporting the use of *Sotera* stipulations.” June 18, 2024 C4IP Comments (available at <https://c4ip.org/wp-content/uploads/2024/06/C4IP-Comment-RE-PTO-P-2023-0048.pdf>).

have already pushed out the trial in view of the remaining work to be done and may do so again. Third, unlike *Motorola*, this IPR is co-Petitioner Google’s *only* forum to present its invalidity challenge.

E. Factor 5: There is no Parallel Google Litigation

This factor weighs against discretionary denial because Google and the Samsung defendants are not the same party and the underlying litigation would not resolve Google’s interest in invalidating the patent. *See Google LLC v. Multimodal Media LLC*, IPR2024-00053, Paper 10 at 8 (PTAB June 5, 2024) (“*Fintiv* does not apply to Google”); *Motion Offense*, IPR2022-01312, Paper 17 at 51 (“Petitioner and Dropbox are not the same party...factor 5 weighs against [denial]”).

F. Factor 6: The Petition’s Merits are Strong

Petitioners have established a strong case on the merits that involve new, non-cumulative obviousness theories that will not be addressed in the parallel EDTX litigation. Notably, PO’s POPR did not present *any* argument against the merits.⁶

III. CONCLUSION

The Board should not discretionarily deny institution.

⁶ PO’s Reply seems to attack the underlying declaration’s sufficiency, but “duplication between a petition and a declaration does not require giving the declarant’s testimony little or no weight.” *Apple Inc. v. Carbyne Biometrics, LLC*, IPR2024-00329, Paper 10 at 52 (PTAB Aug. 1, 2024).

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SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

CERENCE OPERATING COMPANY,

Patent Owner

Case IPR2024-01464

U.S. Patent No. 11,393,461

PETITIONERS' DIRECTOR REVIEW REQUEST

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PETITIONERS' EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,393,461 (“’461 Patent”)
1002	Declaration of Christopher M. Schmandt
1003	Curriculum Vitae of Christopher M. Schmandt
1004	File History of U.S. Patent No. 11,393,461
1005	U.S. Patent No. 9,031,847 (“Sarin”)
1006	U.S. Patent Application Publication No. 2013/0110521 (“Hwang”)
1007	U.S. Patent No. 7,475,012 (“Garner”)
1008	U.S. Patent Application Publication No. 2012/0265528 (“Gruber”)
1009	U.S. Patent No. 8,396,463 (“Marcellino”)
1010	U.S. Patent No. 8,331,315 (“Purkayastha”)
1011	U.S. Patent No. 8,694,316 (“Pickering”)
1012	U.S. Patent Application Publication No. 2013/0173269 (“Adler”)
1013	Intentionally Left Blank
1014	U.S. Patent Application Publication No. 2020/0279576 (“Binder”)
1015	U.S. Patent Application Publication No. 2014/0006825 (“Shenhav”)
1016	U.S. Patent Application Publication No. 2012/0034904 (“LeBeau”)
1017	U.S. Patent Application Publication No. 2010/0129068 (“Binda”)
1018	U.S. Patent Application Publication No. 2012/0296655 (“Kristjansson”)
1019	U.S. Patent Application Publication No. 2014/0163978 (“Basye”)
1020	Claim Mapping Table

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Exhibit No.	DESCRIPTION
1021	Plaintiff Cerence Operating Company's Disclosure of Asserted Claims and Infringement Contentions, <i>Cerence Operating Company v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Mar. 11, 2024)
1022	Docket Control Order, <i>Cerence Operating Company v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:23-cv-0482-JRG-RSP (E.D. Tex. Apr. 16, 2014)
1023	Intentionally Left Blank
1024	U.S. Patent Application Publication No. 2013/0332165 ("Beckley")
1025	U.S. Patent Application Publication No. 2014/0350927 ("Yamabe")
1026	U.S. Patent Application Publication No. 2003/0179888 ("Burnett")
1027	Intentionally Left Blank
1028	Intentionally Left Blank
1029	U.S. Patent Application Publication No. 2013/0006638 ("Lindahl")
1030	Letter from Jin-Suk Park to James S. Tsuei dated Feb. 3, 2025

I. INTRODUCTION

Petitioners request Director Review under 37 C.F.R. § 42.75 as to the Board’s denial of institution based on the *Fintiv* Factors. *See* Paper 15 (“DI”). The Board made multiple errors, some of which suggest systemic issues worthy of correction by the Director. Among them, the Board erred by applying new Director guidance retroactively, thereby depriving Petitioners of their due process. And the Board’s suggestion that Samsung’s *Sotera* stipulation was not broad enough demonstrates an *ultra vires* overreach of the Board’s authority and amounts to the “shenanigans” the Supreme Court warned against in its landmark *Cuozzo* decision.

Beyond the due process and *ultra vires* concerns, the Board weighed various factors incorrectly—at Factor 2, the trial date is more uncertain than the Board appreciated because it failed to reckon with the impossibility of the district court’s existing schedule; at Factor 3, there is much more work left to do in the district court than the Board acknowledged, and Petitioners were diligent in preparing a single petition even though Google is not a party to the litigation; at Factor 4, the *Sotera* stipulation eliminated any overlap between the proceedings; and at Factor 6, the Board wrongly demanded a showing of strength that outweighed all the other factors without actually assessing the merits.

II. THE BOARD’S DECISION WAS *ULTRA VIRES* AND IMPERMISSIBLY RETROACTIVE

The Board acted beyond its statutory authority here, in other recent USPTO

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decisions, and in various “FAQs” by suggesting that *Sotera*-type stipulations are no longer sufficient to avoid discretionary denial. Any attempt by the USPTO to require—or even “encourage”—litigants to give up defenses that they *cannot* bring in an IPR runs afoul of Constitutional due process requirements, is arbitrary and capricious, amounts to improper substantive rulemaking, and does not respect the letter of the AIA or Congress’s intent underlying that legislation. By attempting to leverage its authority under the AIA to compel a defendant’s surrender of defenses that are beyond the scope of IPR in order to “ensure this proceeding would be a ‘true alternative,’” (DI, 12), the USPTO is engaged in the type of *ultra vires* “shenanigans” that the Supreme Court forbids. *See Cuozzo Speed Techs. v. Lee*, 579 U.S. 261, 275 (2016).

Sotera fully addressed the permissible scope of overlap that the USPTO can seek to police (if any). That is because grounds that include system art based on an on-sale bar or public use can ***never*** be raised in an IPR. *Ingenico Inc. v. IOENGINE, LLC*, No. 2023-1367, 2025 WL 1318188, at *6-7 (Fed. Cir. May 7, 2025) (“Congress intentionally limited an IPR’s scope to invalidity challenges based on ‘***prior art consisting of patents or printed publications.***’” (citing 35 U.S.C. § 311(b) (emphasis added))).

Forcing parties, via new FAQs adopted without notice and comment, to surrender more issues than the USPTO can adjudicate undermines Congressional

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intent limiting the scope of IPR challenges. *Cf. Ingenico* at *6 (“These are grounds that could normally be raised under §§ 102 or 103, but Congress excluded in IPR proceedings”). The rationale that *Sotera* stipulations otherwise “may not be particularly meaningful” (*see* FAQ 14) is based on the misguided notion that such stipulations serve efficiency only if they “ensure that these IPR proceedings would be a **‘true alternative,’** to the district court proceeding.” *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (PTAB Mar. 28, 2025) (granting Director Review). But what “ensures” that the IPR is a “true alternative” is now a moving target. For example, the *Sotera* precedential case itself said its stipulation ensures that an IPR is a “true alternative.” *Sotera*, Paper 12 at 19 (“Accordingly, Petitioner’s broad stipulation ensures that an inter partes review is a **‘true alternative’** to the district court proceeding.”).

Since *Sotera* was made precedential in 2020, there is nothing new about district court litigation that justifies the reasoning of recent FAQ 14 and *Motorola Sols.* Such stipulations were as much a true alternative then as they are now. Treating *Sotera* stipulations now as insufficient to make this proceeding a “true alternative” is arbitrary and capricious. The new FAQs undermine four years of *Sotera*-based precedent and thwart Congressional intent by ensuring certain district courts are

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effectively IPR-proof.¹ And this new “true alternative” requirement, to allow one forum and one forum only, lacks any limiting principle.

A stipulation ensuring such a “true alternative” to district court litigation would force a would-be petitioner not only to stipulate away all prior art defenses (see Motorola Rehearing Request, IPR2024-01205, Paper 20 at 9-11 (offering to stipulate to no prior art defense at trial)), but also to stipulate away the full range of § 282 defenses in district court, which cannot be raised in an IPR, leaving petitioners without any alternative at all.²

Furthermore, Petitioners operated under the June 21, 2022, Vidal Memo’s binding guidance³ when they prepared and filed petitions in response to PO’s assertion of five patents, and served corresponding *Sotera* stipulations. Applying

¹ Law360, “PTAB Ramps Up Fintiv Denials After Withdrawal Of Memo,” available at <https://www.law360.com/articles/2339744/ptab-ramps-up-fintiv-denials-after-withdrawal-of-memo> (May 13, 2025) (“The Patent Trial and Appeal Board has denied dozens of petitions by citing upcoming trials, mostly in the Eastern District of Texas.”).

² See Brief of The National Retail Federation, The High Tech Inventors Alliance, et al., as Amici Curiae in Support of Apple and Reversal, *Apple Inc., v. Stewart*, No. 24-1864 at 22 (Fed. Cir. Aug. 12, 2024) (“A stipulation not to raise prior art in district court can badly skew damages awards—it allows a plaintiff to misrepresent an incremental invention as a pioneering one. It also tends to distort claim construction allowing a patent owner to advance broad constructions that it otherwise would avoid because they read on prior art.”).

³ Katherine K. Vidal, “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (June 21, 2022), available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

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changed policy retroactively to deny institution violates Petitioners’ due process rights. “When an agency changes course, as [the USPTO] did here, it must ‘be cognizant that longstanding policies may have “engendered serious reliance interests that must be taken into account.”’” *Dep’t of Homeland Sec. v. Regents of the Univ. of Cal.*, 591 U.S. 1, 30-31 (2020) (cleaned up). “[C]onstitutional protections sounding in due process and equal protection, as embodied in our longstanding traditions and precedents addressing retroactivity in the law” may also “constrain retroactive application.” *Kirwa v. U.S. Dep’t of Def.*, 285 F. Supp. 3d 21, 41 (D.D.C. 2017) (quoting *De Niz Robles v. Lynch*, 803 F.3d 1165, 1171–72 (10th Cir. 2015)).

Rescission of the Vidal Memo and discretionarily denying institution under *Fintiv*, as applied here, had the effect of summarily denying consideration of the merits, which would have proceeded to a FWD in view of Samsung’s *Sotera* stipulation. The availability of Director Review does not alter that result because the Vidal Memo by its own terms cabined how the Director would exercise her discretion. As a result, “all events necessary to establish” Petitioners’ rights had occurred in this case before the Vidal Memo was rescinded, thereby preventing the retroactive application of the rescission. *Covey v. Hollydale Mobilehome Ests.*, 116 F.3d 830, 837-38 (9th Cir. 1997).

III. THE BOARD ERRED IN ITS ASSESSMENT OF THE *FINTIV* FACTORS, WHICH FAVOR INSTITUTION

Beyond applying the Vidal Memo rescission retroactively and refusing to give full faith to a *Sotera* stipulation absent surrender of grounds outside the USPTO's authority, the Board erred in its assessment of *Fintiv* under the facts here.

A. Factor 1: Mere Speculation About a Stay Is Neutral

The Board correctly weighed Factor 1 as neutral. DI, 6. Samsung's stay motion was denied "without prejudice," Paper 14, 1. The Board consistently refuses to speculate on future stays for good reason: EDTX judges have granted contested stays in similar circumstances when IPR is instituted on all district-court asserted claims.⁴ That is true even when trial is fast approaching.⁵

B. Factor 2: The Uncertain Trial Date Weighs Against Discretionary Denial or Is Neutral

The Board erred when it weighed Factor 2 as favoring discretionary denial when it is, at best for PO, neutral. Jury selection was set for August 4, 2025, when the petition was filed, Ex-1022, and it has since slipped to October 6, 2025, based on a *joint* motion for more time, Ex-2004. And the docket control order allows for further delays. *Id.* at 4; Paper 14, 2. That possibility is more than speculative: the

⁴ See, e.g., *Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-00423, Dkt. 83 at 6 (E.D. Tex. Mar. 8, 2024) (granting stay where IPR instituted on all claims asserted in litigation and noting that cancellation of even some claims could simplify issues).

⁵ See, e.g., *STA Grp. LLC v. Motorola Sols., Inc.*, No. 2:22-cv-00381, 2024 WL 2852961, at *2-3 (E.D. Tex. June 5, 2024) (stayed about 3.5 months before trial date).

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district court has scheduled *nine trials* for the same day. The Board’s answer that “nothing in the record indicates a trial in the District Court Litigation would not take place months before” the April 2026 FWD deadline (DI, 8) defies logic. *Nine* trials cannot proceed before the same judge on the same day. That traffic jam means that the trial date *will not* stick for 90% of the scheduled cases. The *impossibility* of knowing which eight cases will be delayed makes this factor at least neutral if not tipping against discretionary denial.⁶

Moreover, while the Board found that the district court would hold a validity trial several months before a FWD would issue, DI, 7-8, readily available data show that a final judgment generally lags about four months after a jury verdict due to post-trial motions. The proper comparison should turn on the court’s final judgment and the Board’s FWD. And at least one APJ has previously noted the same: “that a jury trial may occur in the district court before any Final Decision would be due here does not guarantee the entry of final judgment by the district court” in that same timeframe “as the district court litigation may still need to continue with a damages trial and post-trial motions.” *See Provisur Techs., Inc. v. Weber Food Tech. GmbH*,

⁶ *See, e.g., BOE Tech. Grp. Co. v. Optronic Scis. LLC*, IPR2024-01131, Paper 15 at 11 (PTAB Feb. 12, 2025) (“Because a number of cases are scheduled for jury selection on January 5, . . . , there is some uncertainty . . . [so] we consider this factor to be neutral or *weigh slightly against*”).

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IPR2024-00269, Paper 8 at 31-32 (PTAB June 13, 2024) (concurrence).⁷

Accordingly, the typical post-trial briefing delay must also be accounted for in evaluating this factor. On balance, this factor weighs against denying institution or is, at best for PO, as neutral.

C. Factor 3: The Significant Work Remaining Weighs Against Discretionary Denial

The Board found that this factor favored discretionary denial, DI, 10, but the parties' recent joint request for more time shows otherwise: claim construction may be complete, but discovery deadlines, depositions, dispositive motions, and pre-trial disclosures are still to come.⁸ Ex-2004; Paper 14, 3.

The Board was also wrong to dismiss Petitioners' explanation about why it was reasonable to file a joint petition shortly before Samsung's 12-month statutory

⁷ See also *Provisur Techs.*, Paper 8 at 31-32 (“post-trial briefing ... could be extensive” and “delay final judgment in the parallel action”); *Microchip Tech. Inc. v. Bell Semiconductor, LLC*, IPR2021-00147, Paper 20 at 9 (PTAB May 14, 2021) (considering the time between a FWD and “the district court trial (including post-trial briefing [taking] 1-2 months)”).

⁸ See e.g., *IQE PLC v. Cornell Rsch. Found. Inc.*, IPR2024-00609, Paper 9 at 11 (PTAB Sept. 13, 2024) (finding that “although the district court issued a claim construction order, and the parties ... exchanged infringement and invalidity contentions,” “significant effort” remained because the parties had yet to exchange dispositive motions and expert discovery has not yet closed.); *AGIS Software Dev. LLC v. Google LLC*, No. 2:19-CV-00359-JRG, 2021 WL 465424, at *3 (E.D. Tex. Feb. 9, 2021) (Gilstrap, J.) (noting that even “with discovery complete, pretrial briefing submitted, and jury selection pending—***there remain significant resources yet to be expended by the parties***, including at the pretrial conference and preparations leading up to an actual trial of this case” (emphasis added)).

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deadline given the scope of litigation. *See* 35 U.S.C. §315(b); *Google LLC v. Motion Offense, LLC*, IPR2022-01312, Paper 17 at 47 (PTAB Mar. 6, 2023) (finding that “waiting until the last day to file the Petition *without explaining the delay* is neutral” (emphasis added)). PO asserted five patents against Samsung, with infringement contentions for 58 claims spanning over 200 pages of claim charts. Petitioners expeditiously prepared and filed five IPR petitions between July-October 2024, within 4-7 months of receiving PO’s infringement contentions. It is this timing, between Petitioners’ awareness of the asserted claims via the infringement contentions and the filing of the IPRs that matters, not the timing between the filing of the complaint and the IPRs. *See Liberty Energy, Inc. v. U.S. Well Servs, LLC*, IPR2025-00031, Paper 9 at 14-15 (PTAB Apr. 29, 2025) (determining that “Petitioner was reasonably diligent in filing the Petition” four months after receiving infringement contentions because “Patent Owner’s infringement contentions ... inform Petitioner of the claims that are in fact at issue, as well as how Patent Owner views the scope of the claims, both of which are material considerations in preparing a petition”); *Zynga Inc. v. IGT*, IPR2022-00199, Paper 11 at 15-16 (PTAB June 14, 2022) (determining that Petitioner acted diligently by filing about 5 months after receiving infringement contentions). Petitioner diligently prepared challenges to all asserted claims, and any arguable “delay” was caused by PO’s scattershot litigation strategy.

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And, since Google is not a party to the litigation, that timing was all the more reasonable here because it allowed Google and Samsung to prepare a single petition and thus conserve the Board's resources. *See also IQE*, IPR2024-00609, Paper 9 at 11 (PTAB Sept. 13, 2024) (rejecting PO's argument about the Petitioner's supposed lack of diligence where Petitioner was not a party to the parallel litigation). If Google had filed its own Petition, it would not have been denied on *Fintiv* grounds. *Google LLC v. Multimodal Media LLC*, IPR2024-00053, Paper 10 at 8 (PTAB June 5, 2024) ("*Fintiv* does not apply to Google and, even if applied, the *Fintiv* factors weigh[] against denial."). Applying *Fintiv* to Google thus perversely penalizes both Google and Samsung for filing one Petition. That reality, combined with the Board's failure to consider the amount of district court work yet to be done and the Petitioners' specific reason for filing the petition when they did, makes this factor weigh against discretionary denial.

D. Factor 4: No Overlap Weighs Strongly Against Discretionary Denial

The Board weighed Factor 4 only "slightly against" denying institution particularly because of Samsung's ability to rely on system art in the parallel litigation. DI, 13. But this is incorrect. In this case, Samsung's later-served expert report, which narrows the issues that can be presented at trial, does not rely on system

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art.⁹ Therefore, as an initial matter, Samsung’s early invalidity contentions, served months before its IPR Petition, are not relevant to the analysis here. This factor thus weighs heavily against discretionary denial.

Regardless, the Board erred by not weighing the *Sotera* stipulation (Ex-1030) strongly against exercising discretion, as required by that still-precedential opinion. Paper 14, 4; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential). Between December 17, 2020, when *Sotera* was designated precedential, and the June 21, 2022 Vidal Memo, the vast majority of Board decisions did not exercise discretion based on *Fintiv*.¹⁰ Newly promulgated FAQ 14¹¹ cannot be reconciled with the letter or spirit of the still-precedential *Sotera*

⁹ Cerence’s Rebuttal Expert Report also now states that PO is no longer asserting infringement of claims 4, 6, 7, 12, and 17 of the ’461 patent. Therefore, those claims need not be addressed in the litigation, and the Board will be the only current forum to decide the validity of those 5 claims.

¹⁰ Of the 57 cases that were filed with a *Sotera* stipulation during that time period, institution was granted in 52 cases. All 5 denials are distinguishable: 4 are the *Cisco v. Estech* cases where there was an 11-month gap between trial and the FWD (IPR2021-00329, -00321, -00332, and -00333), and in *Immersion Sys. LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 16-17 (PTAB Jan. 6, 2022), the *Sotera* stipulation was found insufficient because it was contingent upon completing the IPR with a FWD and tied to an asserted likelihood of the court granting a stay in the litigation.

¹¹ See USPTO, “FAQs for the Interim Processes for PTAB Workload Management,” FAQ #14, available at <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (“The Director will take into account whether the stipulation materially reduces overlap between the proceedings. Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited”).

decision.

By the terms of the stipulation, Samsung’s agreement that it will not raise in district court ***any grounds*** that it raised or reasonably could have raised in the IPR is coextensive with the scope of statutory estoppel. *Compare* Ex-1030 (“[If instituted,] Samsung will not pursue in the above-captioned ***litigation any grounds*** that were raised or reasonably could have been raised in the IPR.”), *with* 35 U.S.C. §315(e)(2) (“[Upon a FWD, the petitioner may not assert invalidity], on ***any ground*** that the petitioner raised or reasonably could have raised in the [IPR]”). Thus, *Sotera* stipulations effectively bring IPR estoppel forward to the point of institution, ensuring that the IPR is a true alternative—as much as it can be under the governing statutes.¹² There is simply no reasonable basis for forcing Samsung and others to consent to estoppel broader than the AIA permits to avoid discretionary denial.

The Board reasoned that Samsung did not dispute PO’s concern that the “invalidity contentions contemplate combining” system art with “any of the cited references, including those cited in this proceeding.” DI, 12. But Samsung should not have to address those contentions under *Sotera*. As the Federal Circuit recently explained, estoppel applies only to invalidity in district court under 35 U.S.C. §§ 102

¹² *See also, e.g., Singular Comput. LLC v. Google LLC*, 668 F. Supp. 3d 64, 70 (D. Mass. 2023) (“A petitioner in an IPR proceeding cannot challenge the validity of a patent based on prior-art products or systems.”).

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or 103 based on patents and printed publications and does not preclude on-sale or public-use assertions. *See Ingenico* at *7-8 (“These are different grounds that could not be raised during an IPR.”); *see also Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01003, Paper 9 at 11-12 (PTAB Jan. 9, 2024) (explaining the notion that a “right to assert overlapping system art in the district court” risks inconsistent outcomes “essentially attacks the reasoning of *Sotera* itself” despite *Sotera* remaining binding precedent).

Even were there any remaining gray areas where system art may have an arguable relationship to IPR grounds, that is an issue for the *courts* to address,¹³ *not* for the USPTO to police with ever more burdensome restrictions on petitioners to access IPRs. *See Dell, Inc. v. Universal Connectivity Techs.*, IPR2024-01479, Paper 11 at 7-8 (PTAB Apr. 7, 2025) (“[O]ur evaluation at this juncture is based on the facts before us, not on how Petitioner might challenge the validity of the patent at trial.”).

The Board thus erred by ignoring the letter and spirit of the precedential *Sotera* decision and weighing Factor 4 only “slightly against” discretionary denial when the stipulation in this, and every other case in which it is made, effectively

¹³ *See, e.g., Medline Indus., Inc. v. C.R. Bard, Inc.*, No. 17-cv-7216, 2020 WL 5512132, at *5 (N.D. Ill. Sept. 14, 2020) (defendant not estopped because its claim charts were “replete with photographs of the products” so these were not “patent- or printed publication-based invalidity theories in disguise”).

prevents any arguable overlap between the district court litigation and any ground that could be raised in the IPR.

E. Factor 5: Google’s Involvement as a Nondefendant Weighs Against Discretionary Denial or Is Neutral

The Board weighed Factor 5 in favor of discretionary denial by focusing only on Samsung’s presence. DI, 14. But Google’s decision to participate in the IPRs and accept the estoppel consequences should tip this factor away from discretionary denial. Paper 14, 5. The Board has found under similar circumstances that, at least as to the nondefendant (i.e., Google), this factor weighs against discretionary denial or is, at best for PO, as neutral.¹⁴

F. Factor 6: The Petition’s Strong Merits Weigh Against Discretionary Denial

PO did not address the merits at all, nor did the Board make its own assessment. Despite that analysis vacuum, the Board concluded that “the merits of Petitioner’s asserted challenges do not outweigh the other *Fintiv* factors.” DI, 15. This was wrong. First, the Board could not weigh what it did not assess, and it is no

¹⁴ See *Charter Commc’ns, Inc. v. Adaptive Spectrum Signal Alignment, Inc.*, IPR2025-00087, Paper 14 at 14 (PTAB May 5, 2025) (“Because [co-]Petitioner Plume is not a party in both proceedings, we find that this factor weighs slightly against exercising discretionary denial.”); *Google LLC v. Mullen Indus. LLC*, IPR2025-00019, Paper 14 at 12 (PTAB May 12, 2025) (“Because of the involvement of a nondefendant . . . this factor is neutral.”); *VMWare, Inc. v. Proven Networks, LLC*, IPR2021-00196, Paper 11 at 15 (PTAB May 21, 2021) (“presence of [co-Petitioner] VMware, who is not a party to the underlying litigation, weighs against exercising our discretion”).

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answer that a *full* analysis was not required when the Board conducted *no* analysis (and PO pointed to no weakness on the merits, instead merely touching on procedural issues related to the presentation of expert testimony). *Fintiv* requires “a balanced assessment of all the relevant circumstances in this case, including the merits.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 14 (PTAB Mar. 20, 2020). Second, Petitioner has established strong merits based on new, non-cumulative obviousness theories. Paper 14, 5.

IV. CONCLUSION

The Director should reverse the Board’s decision and grant institution.

Dated: May 23, 2025

Respectfully submitted,

/s/ Benjamin M. Haber

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CERTIFICATE OF SERVICE

I hereby certify that on May 23, 2025, I caused a true and correct copy of the foregoing PETITIONERS' DIRECTOR REVIEW REQUEST to be served electronically on counsel for Patent Owner at the following addresses:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS, AMERICA, INC.,
Petitioners,

v.

CERENCE OPERATING COMPANY,
Patent Owner.

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PATENT OWNER CERENCE OPERATING COMPANY'S
RESPONSE TO PETITIONERS' DIRECTOR REVIEW
REQUEST

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TABLE OF AUTHORITIES

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<i>Covey v. Hollydale Mobilehome Ests.</i> , 116 F.3d 830 (9th Cir. 1997).....	1, 2
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PATENT OWNER'S EXHIBIT LIST

<i>Exhibit No</i>	<i>Description</i>
2001	Federal Court Management Statistics, Eastern District of Texas, 2019-2024
2002	Excerpt of Defendant's Amended Invalidity Contentions (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))
2003	Proof of Service of Samsung Electronics America, Inc. (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))
2004	Third Amended Docket Control Order (<i>Cerence Operating Company v. Samsung Electronics Co., Ltd.</i> , Case No. 2:23-cv-00482-JRG-RSP (E.D. Tex.))

I. INTRODUCTION

Petitioners' Request for Director Review should be denied. The Board acted within its authority in denying institution, and Petitioners' due process rights were not violated. Moreover, Petitioners' *Fintiv* arguments amount to nothing more than a disagreement with the result.

II. THE BOARD ACTED WITHIN ITS AUTHORITY, AND PETITIONERS' DUE PROCESS WAS NOT VIOLATED

First, Petitioners assert that they relied on the prior Vidal Memo in filing their IPR, and that their due process rights were violated by the retroactive application of the rescission. Motion at 4-5. Not so. Tellingly, Petitioners do not identify any additional "process" that was due to them, or anything that they would have changed in their Petition or subsequent filings had they been aware that the Vidal Memo would be rescinded. Instead, Petitioners simply do not agree with the outcome. Nor do Petitioners address the fact that they were provided ample opportunity to file a supplemental briefing to address the updated guidance and its impact on these proceedings. *See* IPR2024-01464, Paper 14. Petitioners have also been afforded the right to seek Director Review of the institution decision, as evident by Petitioners' present Motion.

Petitioners' case law is also inapposite. For example, Petitioners cite to *Covey v. Hollydale Mobilehome Ests.* for the premise that "all events necessary to establish" Petitioners' rights had occurred prior to the Vidal Memo

being rescinded, thereby precluding retroactive application of the rescission. (Motion at 5 (citing 116 F.3d 830, 837-38 (9th Cir. 1997)). But *Covey* dealt with provisions related to housing discrimination, and specifically the question of “whether the new regulations may retroactively change the standard for determining whether Appellees may be liable for past actions.” 116 F.3d at 837. Here, the new guidance did not change the statutory or regulatory framework for IPR proceedings, nor did it impact liability of either party for any cause of action. Moreover, here, “all of the events necessary to establish” Petitioners’ rights ***did not*** occur prior to the new guidance, as Petitioners were afforded supplemental briefing to address the new guidance, and the Board did not issue its decision until ***after*** Petitioners were afforded a fair opportunity to address the new guidance.¹

Second, Petitioners argue that the Board acted beyond its statutory authority in suggesting that *Sotera*-type stipulations are no longer sufficient to avoid discretionary denial, asserting that the Board’s new guidance amounts

¹ Likewise, Petitioners cite to *Dep’t of Homeland Sec. v. Regents of the Univ. of Cal.* (“*Regents*”) for the premise that an agency must be cognizant that previous policies may have “engendered serious reliance interests that must be taken into account.” (Motion at 5 (citing 591 U.S. 1, 30-31 (2020) (cleaned up))). But *Regents* dealt with a rescission to the DACA program, thereby affecting the legal immigration status of hundreds of thousands of individuals across the nation. 591 U.S. at *passim*. Here, Petitioners do not explain how they detrimentally relied on the prior Director guidance.

to impermissibly demanding that litigants “give up defenses that they *cannot* bring in an IPR.” Motion at 2-4 (emphasis in original). But Petitioners’ hyperbolic arguments ignore the fact that the Board *still* considers *Sotera* stipulations as part of its analysis—*said stipulations are just not dispositive*.

Moreover, Petitioners misrepresent the new guidance, as well as the Board’s decision, in asserting that the Director / Board is demanding that they give up defenses and rights unavailable through the IPR process. *See* Motion at 2-3. Nowhere in the new guidance, or the Board’s decision, is there a requirement for Petitioners to give up defenses they couldn’t have raised during the IPR process. Instead, here, the Board simply observed that Samsung’s district court invalidity contentions “contemplate combining the Appel Siri and Samsung S Voice systems with any of the cited references, including those cited in this proceeding.” Paper 14 at 12 (emphasis in original). Thus, the Board merely recognized that Samsung was engaging in gamesmanship, i.e., providing a stipulation that it would *not* utilize IPR prior art references in the district court action, and then subsequently carving out a loophole where it *could* still use these references by combining them with system prior art.

In short, this is not a constitutional crisis, as Petitioners claim. The Board’s opinions regarding the scope of *Sotera* stipulations is merely a re-

sponse to Petitioners' *own* attempts to game the system to levy multiple validity challenges in parallel tribunals utilizing essentially the same grounds. Notably, even with the new guidance, Petitioners are still free to rely on system prior art in district court proceedings—*they just can't use system prior art as a backdoor to re-introduce invalidity grounds already being asserted in the parallel IPR proceedings*. Petitioners are similarly free to assert any of the other available defenses in district court, including challenges to patentability, written description and enablement, prior use and/or knowledge, and equitable defenses. And Petitioners are free to utilize *all* of the available defenses—even those asserted in the IPR proceedings—in the event that institution is denied. *See* Ex. 1010 (conditioning its stipulation on institution).

III. THE BOARD CORRECTLY FOUND THE *FINVTIV* FACTORS WEIGHED IN FAVOR OF DENIAL

Petitioners argue that the Board erred in its Fintiv analysis with respect to Factors 2, 3, 4, and 6. Motion at 6-15. But Petitioners arguments amount to a mere disagreement with the result, without identifying any error in law or fact. With respect to Factor 2, Petitioners do not dispute that the district court trial date is still *months* before the deadline for a FWD. And while Petitioners argue that there are “nine” trials currently scheduled for the same date (inferring that trial date would be “impossibl[e]”) (*id.* at 6-7), the stacking of trials is a common logistical occurrence and does not change the medium time-to-

trial dates for the district or suggest that trial would somehow take place *months-later* than currently scheduled.²

Regarding Factor 3, Petitioners merely disagree with the Board’s conclusion regarding the significance of work already completed in the district court, without identifying any legal error in the Board’s analysis. *Id.* at 8-10. Regarding Factor 4, Petitioners once again simply complain about the Board’s decision to not hold their *Sotera* stipulation as dispositive (*id.* at 10-13), which, as discussed above, is simply a response to Petitioners’ *own* attempts to game the system. Finally, regarding Factor 6, Petitioners assert that the Board “could not weigh the merits it did not assess.” *Id.* at 14-15. But as the Board explained, “a full analysis of the merits is not necessary” at the discretionary denial stage, and on the record before it, the Board properly found that the *Fintiv* factors outweighed any arguments regarding the strength of the merits. Paper 15 at 14-15.

IV. CONCLUSION

In view of the forgoing, discretionary denial is appropriate.

² While Petitioners further argue that the FWD date should be compared to the estimated date for receiving a final judgment in district court (*id.* at 7-8), this does not address the concern of having conflicting results from multiple tribunals regarding the validity of a challenged patent, and Petitioners ignore the fact that the majority of jury verdicts are *not* overturned by district courts.

Dated: June 3, 2025

/ Qi Tong /

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above document was served on June 3, 2025, by filing this document through the P-TACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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/ Qi Tong /

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

Cerence Operating Company,

Plaintiff,

vs.

Samsung Electronics Co., Ltd. and Samsung
Electronics America, Inc.,

Defendants.

CASE NO. 2:23-CV-0482-JRG-RSP

**PLAINTIFF CERENCE OPERATING
COMPANY'S DISCLOSURE OF
ASSERTED CLAIMS AND
INFRINGEMENT CONTENTIONS**

JURY DEMANDED

**PLAINTIFF CERENCE OPERATING COMPANY'S DISCLOSURE OF
ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS**

Pursuant to P.R. 3-1 and P.R. 3-2, patent owner Cerence Operating Company ("Cerence") hereby provides its disclosure of asserted claims and infringement contentions and its accompanying document production. This disclosure is based on the information available to Cerence as of the date of this disclosure, before Cerence has received any discovery on the design or operation of the defendants' products. Cerence reserves the right to amend this disclosure to the full extent permitted under the court's rules and orders.

**P.R. 3-1: DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT
CONTENTIONS**

P.R. 3-1(A): ASSERTED CLAIMS

Cerence asserts that defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively "Samsung") infringe one or more of the following claims, directly, by inducement, or by contributory infringement:

<i>U.S. Patent No.</i>	<i>Asserted Claims</i>
7,395,078	1-3, 8-10, 12, 15-17
8,081,993	1-2, 6-8, 10-11, 15-17
11,393,461	1-18
11,087,750	1-19
9,026,428	1

Collectively, these five patents are referred to herein as the Asserted Patents, and these claims as the Asserted Claims.

**P.R. 3-1(B): ACCUSED INSTRUMENTALITIES OF WHICH CERENCE IS
AWARE**

What follows are lists of accused products that Cerence is aware of infringing based upon information presently available to it and its investigation to date. Cerence's infringement claims are not limited to these listed products and specifically extend to all products and apparatuses of Samsung similar to the listed products that include the claimed elements. Unless otherwise stated, Cerence's infringement assertions apply to all variations, versions, editions, and applications of each of the listed products.

U.S. PATENT NO. 7,395,078

Cerence accuses the following Samsung products which implement voice message functionality of infringing one or more of the Asserted Claims of the '078 patent:

Galaxy Tab A6, Galaxy J1 mini Prime/Galaxy V2, Galaxy C5 Pro, Galaxy A3 (2017), Galaxy A5 (2017), Galaxy A7 (2017), Galaxy Tab S3, Galaxy S8+, Galaxy S8, Galaxy Xcover 4, Galaxy J7 Max, Galaxy J7 Pro (2017), Galaxy J7 (2017), Galaxy J5 (2017), Galaxy J3 Prime, Galaxy J3 (2017), Galaxy Note Fan Edition (FE), Galaxy S8 Active, Galaxy J7+, Galaxy J7 Sky Pro, Galaxy J7 Nxt, Galaxy J7 V, Galaxy C8 / C7 (2017), Galaxy Tab A 8.0 (2017), Galaxy Tab Active 2, Galaxy J4 (2017), Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy J4 Pro (2018), Galaxy S9+, Galaxy S9, Galaxy J7 Duo, Galaxy J6 (2018), Galaxy J4 (2018), Galaxy A6+ (2018), Galaxy A6 (2018), Galaxy J7 (2018), Galaxy On6, Galaxy J8 (2018), Galaxy Tab S4, Galaxy Tab A 10.5

(2018), Galaxy Note 9, Galaxy J6+, Galaxy J4+, Galaxy A7 (2018), Galaxy A9 (2018), Galaxy A6s, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy A8s, Galaxy M20, Galaxy M10, Galaxy M30, Galaxy Tab A 10.1 (2019), Galaxy Tab S5e, Galaxy A10, Galaxy A30, Galaxy A50, Galaxy S10e, Galaxy S10, Galaxy S10+, Galaxy A2 Core, Galaxy A20e, Galaxy A20, Galaxy A40, Galaxy A70, Galaxy A80, Galaxy A60, Galaxy View 2, Galaxy S10 5G, Galaxy M40, Galaxy Note 10+, Galaxy Note 10, Galaxy A10e, Galaxy A10s, Galaxy Fold, Galaxy A90 5G, Galaxy A30s, Galaxy A50s, Galaxy A70s, Galaxy M10s, Galaxy A20s, Galaxy M30s, Galaxy A51, Galaxy A71, Galaxy A01, Galaxy S10 Lite, Galaxy Note 10 Lite, Galaxy Xcover Pro, Galaxy Tab S6, Galaxy Tab S6 5G, Galaxy Z Flip, Galaxy M31, Galaxy A11, Galaxy M21, Galaxy A41, Galaxy A31, Galaxy M11, Galaxy S20 Ultra, Galaxy S20+, Galaxy S20, Galaxy Tab S6 Lite, Galaxy A21, Galaxy A51 5G, Galaxy A51 5G UW, Galaxy A71 5G, Galaxy A21s, Galaxy M01, Galaxy M01s, Galaxy A01 Core, Galaxy M31s, Galaxy Tab S7+, Galaxy Tab S7, Galaxy Z Flip 5G, Galaxy Note 20 Ultra, Galaxy Note 20 Ultra 5G, Galaxy Note 20, Galaxy M51, Galaxy Z Fold2 5G, Galaxy S20 FE, Galaxy S20 FE 5G, Galaxy S20 FE 2022, Galaxy F41, Galaxy A42 5G, Galaxy M21s, Galaxy A12, Galaxy A02s, Galaxy M02s, Galaxy A32 5G, Galaxy S21 Ultra, Galaxy S21+, Galaxy S21, Galaxy A02, Galaxy M02, Galaxy M12, Galaxy F62, Galaxy M62, Galaxy A32, Galaxy A52, Galaxy A52 5G, Galaxy A72, Galaxy F12, Galaxy F02s, Galaxy M42 5G, Galaxy F52 5G, Galaxy Tab A7 Lite, Galaxy Tab S7 FE, Galaxy A22, Galaxy A22 5G, Galaxy M32, Galaxy F22, Galaxy Z Flip3 5G, Galaxy Z Fold3 5G, Galaxy A52s 5G, Galaxy A03s, Galaxy M32 5G, Galaxy M22, Galaxy M52 5G, Galaxy F42 5G, Galaxy A03 Core, Galaxy A03, Galaxy Tab A8 10.5, Galaxy A13 5G, Galaxy S21 FE, Galaxy S22, Galaxy S22+, Galaxy S22 Ultra, Galaxy A13, Galaxy A23 5G, Galaxy A23, Galaxy F23, Galaxy A53 5G, Galaxy Tab S8, Galaxy Tab S8+, Galaxy Tab S8 Ultra, Galaxy A73 5G, Galaxy A33 5G, Galaxy M33 5G, Galaxy M23, Galaxy M53 5G, Galaxy F13, Galaxy M13, Galaxy M13 5G, Galaxy Xcover6 Pro, Galaxy Z Flip 4, Galaxy Z Fold 4, Galaxy Tab Active4 Pro, Galaxy A04s, Galaxy A04, Galaxy A04e, Galaxy Tab A7 10.4 (2022), Galaxy M04, Galaxy F04, Galaxy A14 5G, Galaxy S23 Ultra, Galaxy S23+, Galaxy S23, Galaxy Xcover 5, Galaxy Tab A7, Galaxy Tab A7 10.4 (2020), Galaxy Tab A 8.0 (2019), Galaxy J3 (2018), Galaxy Tab E, Galaxy S24, Galaxy S24+, Galaxy S24 Ultra, Galaxy Z Fold 5, and Galaxy Z Flip 5.

The Samsung products in the preceding list, including all variations, editions, and applications of the foregoing, and all products and apparatuses of Samsung similar to the foregoing that include the claimed elements are the '078 Accused Instrumentalities.

U.S. PATENT NO. 8,081,993

Cerence accuses the following Samsung products which implement voice over short message functionality of infringing one or more of the Asserted Claims of the '993 patent:

Galaxy Tab A6, Galaxy J1 mini Prime/Galaxy V2, Galaxy C5 Pro, Galaxy A3 (2017), Galaxy A5 (2017), Galaxy A7 (2017), Galaxy Tab S3, Galaxy S8+, Galaxy S8, Galaxy Xcover 4, Galaxy J7 Max, Galaxy J7 Pro (2017), Galaxy J7 (2017), Galaxy J5 (2017), Galaxy J3 Prime, Galaxy J3 (2017), Galaxy Note Fan Edition (FE), Galaxy S8 Active, Galaxy J7+, Galaxy J7 Sky Pro, Galaxy J7 Nxt, Galaxy J7 V, Galaxy C8 / C7 (2017), Galaxy Tab A 8.0 (2017), Galaxy Tab Active 2,

Galaxy J4 (2017), Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy J4 Pro (2018), Galaxy S9+, Galaxy S9, Galaxy J7 Duo, Galaxy J6 (2018), Galaxy J4 (2018), Galaxy A6+ (2018), Galaxy A6 (2018), Galaxy J7 (2018), Galaxy On6, Galaxy J8 (2018), Galaxy Tab S4, Galaxy Tab A 10.5 (2018), Galaxy Note 9, Galaxy J6+, Galaxy J4+, Galaxy A7 (2018), Galaxy A9 (2018), Galaxy A6s, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy A8s, Galaxy M20, Galaxy M10, Galaxy M30, Galaxy Tab A 10.1 (2019), Galaxy Tab S5e, Galaxy A10, Galaxy A30, Galaxy A50, Galaxy S10e, Galaxy S10, Galaxy S10+, Galaxy A2 Core, Galaxy A20e, Galaxy A20, Galaxy A40, Galaxy A70, Galaxy A80, Galaxy A60, Galaxy View 2, Galaxy S10 5G, Galaxy M40, Galaxy Note 10+, Galaxy Note 10, Galaxy A10e, Galaxy A10s, Galaxy Fold, Galaxy A90 5G, Galaxy A30s, Galaxy A50s, Galaxy A70s, Galaxy M10s, Galaxy A20s, Galaxy M30s, Galaxy A51, Galaxy A71, Galaxy A01, Galaxy S10 Lite, Galaxy Note 10 Lite, Galaxy Xcover Pro, Galaxy Tab S6, Galaxy Tab S6 5G, Galaxy Z Flip, Galaxy M31, Galaxy A11, Galaxy M21, Galaxy A41, Galaxy A31, Galaxy M11, Galaxy S20 Ultra, Galaxy S20+, Galaxy S20, Galaxy Tab S6 Lite, Galaxy A21, Galaxy A51 5G, Galaxy A51 5G UW, Galaxy A71 5G, Galaxy A21s, Galaxy M01, Galaxy M01s, Galaxy A01 Core, Galaxy M31s, Galaxy Tab S7+, Galaxy Tab S7, Galaxy Z Flip 5G, Galaxy Note 20 Ultra, Galaxy Note 20 Ultra 5G, Galaxy Note 20, Galaxy M51, Galaxy Z Fold2 5G, Galaxy S20 FE, Galaxy S20 FE 5G, Galaxy S20 FE 2022, Galaxy F41, Galaxy A42 5G, Galaxy M21s, Galaxy A12, Galaxy A02s, Galaxy M02s, Galaxy A32 5G, Galaxy S21 Ultra, Galaxy S21+, Galaxy S21, Galaxy A02, Galaxy M02, Galaxy M12, Galaxy F62, Galaxy M62, Galaxy A32, Galaxy A52, Galaxy A52 5G, Galaxy A72, Galaxy F12, Galaxy F02s, Galaxy M42 5G, Galaxy F52 5G, Galaxy Tab A7 Lite, Galaxy Tab S7 FE, Galaxy A22, Galaxy A22 5G, Galaxy M32, Galaxy F22, Galaxy Z Flip3 5G, Galaxy Z Fold3 5G, Galaxy A52s 5G, Galaxy A03s, Galaxy M32 5G, Galaxy M22, Galaxy M52 5G, Galaxy F42 5G, Galaxy A03 Core, Galaxy A03, Galaxy Tab A8 10.5, Galaxy A13 5G, Galaxy S21 FE, Galaxy S22, Galaxy S22+, Galaxy S22 Ultra, Galaxy A13, Galaxy A23 5G, Galaxy A23, Galaxy F23, Galaxy A53 5G, Galaxy Tab S8, Galaxy Tab S8+, Galaxy Tab S8 Ultra, Galaxy A73 5G, Galaxy A33 5G, Galaxy M33 5G, Galaxy M23, Galaxy M53 5G, Galaxy F13, Galaxy M13, Galaxy M13 5G, Galaxy Xcover6 Pro, Galaxy Z Flip 4, Galaxy Z Fold 4, Galaxy Tab Active4 Pro, Galaxy A04s, Galaxy A04, Galaxy A04e, Galaxy Tab A7 10.4 (2022), Galaxy M04, Galaxy F04, Galaxy A14 5G, Galaxy S23 Ultra, Galaxy S23+, Galaxy S23, Galaxy Xcover 5, Galaxy Tab A7, Galaxy Tab A7 10.4 (2020), Galaxy Tab A 8.0 (2019), Galaxy J3 (2018), Galaxy Tab E, Galaxy Tab E, Galaxy S24, Galaxy S24+, Galaxy S24 Ultra, Galaxy Z Fold 5, and Galaxy Z Flip 5.

The Samsung products in the preceding list, including all variations, editions, and applications of the foregoing, and all products and apparatuses of Samsung similar to the foregoing that include the claimed elements are the '993 Accused Instrumentalities.

U.S. PATENT NO. 11,393,461

Cerence accuses the following Samsung products which implement detecting a voice command functionality of infringing one or more of the Asserted Claims of the '461 patent:

Galaxy S8+, Galaxy S8, Galaxy Note Fan Edition (FE), Galaxy S8 Active, Galaxy Note 8, Galaxy Tab A 8.0 (2017), Galaxy Tab Active 2, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy S9+, Galaxy S9, Galaxy A6+ (2018), Galaxy A6 (2018), Galaxy Tab S4, Galaxy Tab A 10.5 (2018), Galaxy Note 9, Galaxy A7 (2018), Galaxy A9 (2018), Galaxy A6s, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy A8s, Galaxy M20, Galaxy M10, Galaxy M30, Galaxy Tab A 10.1 (2019), Galaxy Tab S5e, Galaxy A10, Galaxy A30, Galaxy A50, Galaxy S10e, Galaxy S10, Galaxy S10+, Galaxy A2 Core, Galaxy A20e, Galaxy A20, Galaxy A40, Galaxy A70, Galaxy A80, Galaxy A60, Galaxy View 2, Galaxy S10 5G, Galaxy M40, Galaxy Note 10+, Galaxy Note 10, Galaxy A10e, Galaxy A10s, Galaxy Fold, Galaxy A90 5G, Galaxy A30s, Galaxy A50s, Galaxy A70s, Galaxy M10s, Galaxy A20s, Galaxy M30s, Galaxy A51, Galaxy A71, Galaxy A01, Galaxy S10 Lite, Galaxy Note 10 Lite, Galaxy Xcover Pro, Galaxy Tab S6, Galaxy Tab S6 5G, Galaxy Z Flip, Galaxy M31, Galaxy A11, Galaxy M21, Galaxy A41, Galaxy A31, Galaxy M11, Galaxy S20 Ultra, Galaxy S20+, Galaxy S20, Galaxy Tab S6 Lite, Galaxy A21, Galaxy A51 5G, Galaxy A51 5G UW, Galaxy A71 5G, Galaxy A21s, Galaxy M01, Galaxy M01s, Galaxy A01 Core, Galaxy M31s, Galaxy Tab S7+, Galaxy Tab S7, Galaxy Z Flip 5G, Galaxy Note 20 Ultra, Galaxy Note 20 Ultra 5G, Galaxy Note 20, Galaxy M51, Galaxy Z Fold2 5G, Galaxy S20 FE, Galaxy S20 FE 5G, Galaxy S20 FE 2022, Galaxy F41, Galaxy A42 5G, Galaxy M21s, Galaxy A12, Galaxy A02s, Galaxy M02s, Galaxy A32 5G, Galaxy S21 Ultra, Galaxy S21+, Galaxy S21, Galaxy A02, Galaxy M02, Galaxy M12, Galaxy F62, Galaxy M62, Galaxy A32, Galaxy A52, Galaxy A52 5G, Galaxy A72, Galaxy F12, Galaxy F02s, Galaxy M42 5G, Galaxy F52 5G, Galaxy Tab A7 Lite, Galaxy Tab S7 FE, Galaxy A22, Galaxy A22 5G, Galaxy M32, Galaxy F22, Galaxy Z Flip3 5G, Galaxy Z Fold3 5G, Galaxy A52s 5G, Galaxy A03s, Galaxy M32 5G, Galaxy M22, Galaxy M52 5G, Galaxy F42 5G, Galaxy A03 Core, Galaxy A03, Galaxy Tab A8 10.5, Galaxy A13 5G, Galaxy S21 FE, Galaxy S22, Galaxy S22+, Galaxy S22 Ultra, Galaxy A13, Galaxy A23 5G, Galaxy A23, Galaxy F23, Galaxy A53 5G, Galaxy Tab S8, Galaxy Tab S8+, Galaxy Tab S8 Ultra, Galaxy A73 5G, Galaxy A33 5G, Galaxy M33 5G, Galaxy M23, Galaxy M53 5G, Galaxy F13, Galaxy M13, Galaxy M13 5G, Galaxy Xcover6 Pro, Galaxy Z Flip 4, Galaxy Z Fold 4, Galaxy Tab Active4 Pro, Galaxy A04s, Galaxy A04, Galaxy A04e, Galaxy Tab A7 10.4 (2022), Galaxy M04, Galaxy F04, Galaxy A14 5G, Galaxy S23 Ultra, Galaxy S23+, Galaxy S23, Galaxy Xcover 5, Galaxy Tab A7, Galaxy Tab A7 10.4 (2020), Galaxy Tab A 8.0 (2019), Galaxy J3 (2018), Galaxy Tab E, Galaxy Tab E, Galaxy S24, Galaxy S24+, Galaxy S24 Ultra, Galaxy Z Fold 5, Galaxy Z Flip 5, Galaxy Watch (2018), Galaxy Watch Active (2019), Galaxy Watch Active 2 (2019), Galaxy Watch 3, Galaxy Watch 4, Galaxy Watch 4 Classic, Galaxy Watch 5, Galaxy Watch 5 Pro, Galaxy Watch 6, and Galaxy Watch 6 Classic.

The Samsung products in the preceding list, including all variations, editions, and applications of the foregoing, and all products and apparatuses of Samsung similar to the foregoing that include the claimed elements are the '461 Accused Instrumentalities.

U.S. PATENT NO. 11,087,750

Cerence accuses the following Samsung products which implement detecting a voice command functionality of infringing one or more of the Asserted Claims of the '750 patent:

Galaxy S8+, Galaxy S8, Galaxy Note Fan Edition (FE), Galaxy S8 Active, Galaxy Note 8, Galaxy Tab A 8.0 (2017), Galaxy Tab Active 2, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy S9+, Galaxy S9, Galaxy A6+ (2018), Galaxy A6 (2018), Galaxy Tab S4, Galaxy Tab A 10.5 (2018), Galaxy Note 9, Galaxy A7 (2018), Galaxy A9 (2018), Galaxy A6s, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy A8s, Galaxy M20, Galaxy M10, Galaxy M30, Galaxy Tab A 10.1 (2019), Galaxy Tab S5e, Galaxy A10, Galaxy A30, Galaxy A50, Galaxy S10e, Galaxy S10, Galaxy S10+, Galaxy A2 Core, Galaxy A20e, Galaxy A20, Galaxy A40, Galaxy A70, Galaxy A80, Galaxy A60, Galaxy View 2, Galaxy S10 5G, Galaxy M40, Galaxy Note 10+, Galaxy Note 10, Galaxy A10e, Galaxy A10s, Galaxy Fold, Galaxy A90 5G, Galaxy A30s, Galaxy A50s, Galaxy A70s, Galaxy M10s, Galaxy A20s, Galaxy M30s, Galaxy A51, Galaxy A71, Galaxy A01, Galaxy S10 Lite, Galaxy Note 10 Lite, Galaxy Xcover Pro, Galaxy Tab S6, Galaxy Tab S6 5G, Galaxy Z Flip, Galaxy M31, Galaxy A11, Galaxy M21, Galaxy A41, Galaxy A31, Galaxy M11, Galaxy S20 Ultra, Galaxy S20+, Galaxy S20, Galaxy Tab S6 Lite, Galaxy A21, Galaxy A51 5G, Galaxy A51 5G UW, Galaxy A71 5G, Galaxy A21s, Galaxy M01, Galaxy M01s, Galaxy A01 Core, Galaxy M31s, Galaxy Tab S7+, Galaxy Tab S7, Galaxy Z Flip 5G, Galaxy Note 20 Ultra, Galaxy Note 20 Ultra 5G, Galaxy Note 20, Galaxy M51, Galaxy Z Fold2 5G, Galaxy S20 FE, Galaxy S20 FE 5G, Galaxy S20 FE 2022, Galaxy F41, Galaxy A42 5G, Galaxy M21s, Galaxy A12, Galaxy A02s, Galaxy M02s, Galaxy A32 5G, Galaxy S21 Ultra, Galaxy S21+, Galaxy S21, Galaxy A02, Galaxy M02, Galaxy M12, Galaxy F62, Galaxy M62, Galaxy A32, Galaxy A52, Galaxy A52 5G, Galaxy A72, Galaxy F12, Galaxy F02s, Galaxy M42 5G, Galaxy F52 5G, Galaxy Tab A7 Lite, Galaxy Tab S7 FE, Galaxy A22, Galaxy A22 5G, Galaxy M32, Galaxy F22, Galaxy Z Flip3 5G, Galaxy Z Fold3 5G, Galaxy A52s 5G, Galaxy A03s, Galaxy M32 5G, Galaxy M22, Galaxy M52 5G, Galaxy F42 5G, Galaxy A03 Core, Galaxy A03, Galaxy Tab A8 10.5, Galaxy A13 5G, Galaxy S21 FE, Galaxy S22, Galaxy S22+, Galaxy S22 Ultra, Galaxy A13, Galaxy A23 5G, Galaxy A23, Galaxy F23, Galaxy A53 5G, Galaxy Tab S8, Galaxy Tab S8+, Galaxy Tab S8 Ultra, Galaxy A73 5G, Galaxy A33 5G, Galaxy M33 5G, Galaxy M23, Galaxy M53 5G, Galaxy F13, Galaxy M13, Galaxy M13 5G, Galaxy Xcover6 Pro, Galaxy Z Flip 4, Galaxy Z Fold 4, Galaxy Tab Active4 Pro, Galaxy A04s, Galaxy A04, Galaxy A04e, Galaxy Tab A7 10.4 (2022), Galaxy M04, Galaxy F04, Galaxy A14 5G, Galaxy S23 Ultra, Galaxy S23+, Galaxy S23, Galaxy Xcover 5, Galaxy Tab A7, Galaxy Tab A7 10.4 (2020), Galaxy Tab A 8.0 (2019), Galaxy J3 (2018), Galaxy Tab E, Galaxy Tab E, Galaxy S24, Galaxy S24+, Galaxy S24 Ultra, Galaxy Z Fold 5, Galaxy Z Flip 5, Galaxy Watch (2018), Galaxy Watch Active (2019), Galaxy Watch Active 2 (2019), Galaxy Watch 3, Galaxy Watch 4, Galaxy Watch 4 Classic, Galaxy Watch 5, Galaxy Watch 5 Pro, Galaxy Watch 6, and Galaxy Watch 6 Classic.

The Samsung products in the preceding list, including all variations, editions, and applications of the foregoing, and all products and apparatuses of Samsung similar to the foregoing that include the claimed elements are the '750 Accused Instrumentalities.

U.S. PATENT NO. 9,026,428

Cerence accuses the following Samsung products which implement text/character input functionality of infringing the Asserted Claim of the '428 patent:

Galaxy S7, Galaxy S7 Edge, Galaxy S7 Active, Galaxy S8+, Galaxy S8, Galaxy Note Fan Edition (FE), Galaxy S8 Active, Galaxy Note 8, Galaxy Tab A 8.0 (2017), Galaxy Tab Active 2, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy S9+, Galaxy S9, Galaxy A6+ (2018), Galaxy A6 (2018), Galaxy Tab S4, Galaxy Tab A 10.5 (2018), Galaxy Note 9, Galaxy A7 (2018), Galaxy A9 (2018), Galaxy A6s, Galaxy A8+ (2018), Galaxy A8 (2018), Galaxy A8s, Galaxy M20, Galaxy M10, Galaxy M30, Galaxy Tab A 10.1 (2019), Galaxy Tab S5e, Galaxy A10, Galaxy A30, Galaxy A50, Galaxy S10e, Galaxy S10, Galaxy S10+, Galaxy A2 Core, Galaxy A20e, Galaxy A20, Galaxy A40, Galaxy A70, Galaxy A80, Galaxy A60, Galaxy View 2, Galaxy S10 5G, Galaxy M40, Galaxy Note 10+, Galaxy Note 10, Galaxy A10e, Galaxy A10s, Galaxy Fold, Galaxy A90 5G, Galaxy A30s, Galaxy A50s, Galaxy A70s, Galaxy M10s, Galaxy A20s, Galaxy M30s, Galaxy A51, Galaxy A71, Galaxy A01, Galaxy S10 Lite, Galaxy Note 10 Lite, Galaxy Xcover Pro, Galaxy Tab S6, Galaxy Tab S6 5G, Galaxy Z Flip, Galaxy M31, Galaxy A11, Galaxy M21, Galaxy A41, Galaxy A31, Galaxy M11, Galaxy S20 Ultra, Galaxy S20+, Galaxy S20, Galaxy Tab S6 Lite, Galaxy A21, Galaxy A51 5G, Galaxy A51 5G UW, Galaxy A71 5G, Galaxy A21s, Galaxy M01, Galaxy M01s, Galaxy A01 Core, Galaxy M31s, Galaxy Tab S7+, Galaxy Tab S7, Galaxy Z Flip 5G, Galaxy Note 20 Ultra, Galaxy Note 20 Ultra 5G, Galaxy Note 20, Galaxy M51, Galaxy Z Fold2 5G, Galaxy S20 FE, Galaxy S20 FE 5G, Galaxy S20 FE 2022, Galaxy F41, Galaxy A42 5G, Galaxy M21s, Galaxy A12, Galaxy A02s, Galaxy M02s, Galaxy A32 5G, Galaxy S21 Ultra, Galaxy S21+, Galaxy S21, Galaxy A02, Galaxy M02, Galaxy M12, Galaxy F62, Galaxy M62, Galaxy A32, Galaxy A52, Galaxy A52 5G, Galaxy A72, Galaxy F12, Galaxy F02s, Galaxy M42 5G, Galaxy F52 5G, Galaxy Tab A7 Lite, Galaxy Tab S7 FE, Galaxy A22, Galaxy A22 5G, Galaxy M32, Galaxy F22, Galaxy Z Flip3 5G, Galaxy Z Fold3 5G, Galaxy A52s 5G, Galaxy A03s, Galaxy M32 5G, Galaxy M22, Galaxy M52 5G, Galaxy F42 5G, Galaxy A03 Core, Galaxy A03, Galaxy Tab A8 10.5, Galaxy A13 5G, Galaxy S21 FE, Galaxy S22, Galaxy S22+, Galaxy S22 Ultra, Galaxy A13, Galaxy A23 5G, Galaxy A23, Galaxy F23, Galaxy A53 5G, Galaxy Tab S8, Galaxy Tab S8+, Galaxy Tab S8 Ultra, Galaxy A73 5G, Galaxy A33 5G, Galaxy M33 5G, Galaxy M23, Galaxy M53 5G, Galaxy F13, Galaxy M13, Galaxy M13 5G, Galaxy Xcover6 Pro, Galaxy Z Flip 4, Galaxy Z Fold 4, Galaxy Tab Active4 Pro, Galaxy A04s, Galaxy A04, Galaxy A04e, Galaxy Tab A7 10.4 (2022), Galaxy M04, Galaxy F04, Galaxy A14 5G, Galaxy S23 Ultra, Galaxy S23+, Galaxy S23, Galaxy Xcover 5, Galaxy Tab A7, Galaxy Tab A7 10.4 (2020), Galaxy Tab A 8.0 (2019), Galaxy J3 (2018), Galaxy Tab E, Galaxy Tab E, Galaxy S24, Galaxy S24+, Galaxy S24 Ultra, Galaxy Z Fold 5, and Galaxy Z Flip 5.

The Samsung products in the preceding list, including all variations, editions, and applications of the foregoing, and all products and apparatuses of Samsung similar to the foregoing that include the claimed elements are the '428 Accused Instrumentalities.

The '078 Accused Instrumentalities, '993 Accused Instrumentalities, '461 Accused Instrumentalities, '750 Accused Instrumentalities, and '428 Accused Instrumentalities, collectively are the Accused Instrumentalities.

P.R. 3-1(C): CLAIM CHARTS

Cerence's analysis of Samsung's products and apparatuses is based upon information that is publicly available and based on Cerence's own investigation prior to any discovery in this action.

While the publicly available information constitutes evidence of the methods and apparatuses used by Samsung in the Accused Instrumentalities, direct evidence of the actual apparatuses and methods are at times not publicly available. Accordingly, these infringement contentions are based on the available public information, analysis, and reasonable inferences drawn from that information.

Cerence reserves the right to amend or supplement these disclosures for any of the following reasons (along with any other reason that may be permitted under the court's rules and orders):

- (1) Samsung provides evidence of the apparatuses and methods used in the Accused Instrumentalities;
 - (2) The Asserted Claims may include elements that involve features that are implemented by hardware structures and logic and Cerence's current positions on infringement are set forth without the benefit of access to Samsung's source code, schematics, drawings, or other proprietary specifications or information, which cannot be obtained through publicly available information, for the Accused Instrumentalities. Therefore, it may be necessary for Cerence to supplement its positions on infringement after a complete production of such proprietary specifications or information by Samsung;
 - (3) Cerence's position on infringement of specific claims will depend on the claim constructions adopted by the Court. Because said constructions have not yet occurred, Cerence cannot take a final position on the bases for infringement of the Asserted Claims;
- and

(4) Cerence's investigation and analysis of Samsung's Accused Instrumentalities are based upon information made publicly available by Samsung and by Cerence's own investigations. Cerence reserves the right to amend these contentions based upon discovery of non-public information that Cerence anticipates receiving from Samsung during discovery.

Attached as Exhibit A, and incorporated herein in their entirety, are charts identifying where each element of the Asserted Claims of the '078, '993, '461, '750, and '428 patents respectively are found in the Accused Instrumentalities.

Unless otherwise indicated, the information provided that corresponds to each claim element is considered to indicate that each claim element is found within each of the different variations, versions, editions, and applications of each respective Accused Instrumentalities.

P.R. 3-1(D): LITERAL INFRINGEMENT AND DOCTRINE OF EQUIVALENTS

With respect to the patents at issue, Cerence contends that each element of each Asserted Claim is literally present. To the extent that Samsung identifies elements of the Asserted Claims that it contends are not literally present in the Accused Instrumentalities, Cerence contends that such elements are present under the doctrine of equivalents.

P.R. 3-1(E): PRIORITY DATES

<i>U.S. Patent No.</i>	<i>Priority Date</i>
7,395,078	April 20, 2004
8,081,993	April 20, 2004
11,393,461	March 12, 2013
11,087,750	March 12, 2013
9,026,428	October 15, 2012

**P.R. 3-1(F): IDENTIFICATION OF INSTRUMENTALITIES PRACTICING THE
CLAIMED INVENTION**

The Cerence Voice Assistant and/or Voice Over Short Message Service may incorporate or reflect the claims of the Asserted Patents. Cerence reserves the right to supplement this response should further investigation, discovery, or the court's claim construction rulings make such supplementation appropriate.

P.R. 3-2: DOCUMENT PRODUCTION ACCOMPANYING DISCLOSURE

P.R. 3-2(A) DOCUMENTS

Cerence is presently unaware of any documents that evidence any discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, any of the inventions claimed in the patents in suit prior to their respective application dates.

A diligent search continues for documents, and Cerence reserves the right to supplement this response.

P.R. 3-2(B) DOCUMENTS

Cerence is presently unaware of any documents that evidence the conception, reduction to practice, design, or development of the claimed inventions, which were created on or before the application dates of the patents in suit or priority date identified pursuant to P.R. 3-1(e).

A diligent search continues for documents, and Cerence reserves the right to supplement this response.

P.R. 3-2(C) DOCUMENTS

The file histories for the '078, '993, '428, '750, and '461 patents may be found in Cerence's production at CERENCE-00000010-CERENCE-00000172; CERENCE-00000182-CERENCE-00000294; CERENCE-00000320-CERENCE-00000754; CERENCE-00000790-CERENCE-00001841; CERENCE-00001877-CERENCE-00003394.

Dated: March 11, 2024

Respectfully submitted,

/s/ Benjamin T. Wang

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CERTIFICATE OF SERVICE

I certify that this document is being served upon counsel of record for Defendants on March 11, 2024 via electronic mail.

/s/ Benjamin T. Wang
Benjamin T. Wang

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

CERENCE OPERATING CO.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.; and
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

Case No. 2:23-cv-00482-JRG-RSP

JURY TRIAL DEMANDED

DEFENDANTS' SECOND AMENDED INVALIDITY CONTENTIONS

Pursuant to the Local Patent Rules and the Court's Scheduling Order, Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Samsung" or "Defendants") provide these Second Amended Invalidity Contentions with respect to the Asserted Claims of U.S. Patent Nos. 7,395,078 ("078 patent), 8,081,993 ("993 patent"), 11,393,461 ("461 patent"), 11,087,750 ("750 patent"), and 9,026,428 ("428 patent"), (collectively, the "Asserted Patents") identified by Cerence Operating Co., ("Cerence" or "Plaintiff") in its Infringement Contentions.¹

The Asserted Claims, as reflected in Plaintiff's Infringement Contentions, are as follows:

U.S. Patent No.	Asserted Claims
7,395,078	1-3, 8-10, 12, 15-17
8,081,993	1-2, 6-8, 10-11, 15-17
11,393,461	1-18

¹ Plaintiff served infringement contentions on March 11, 2024. Plaintiff also served what it purports are amended infringement contentions on August 7, 2024. However, Plaintiff has failed to either seek leave to amend its contentions or obtain Samsung's consent to substitute its amended infringement contentions. Plaintiff's original March 11, 2024 infringement contentions remain operative and are referred to as the "Infringement Contentions."

Number	Filing Date	Published/Issued Date	Short Name	Exhibit Numbers
US 6,516,298B1	April 17, 2000	February 4, 2003	Kamai	B-4
US 6,073,094A	June 2, 1998	June 6, 2000	Chang	B-5
US 2004/0176114A1	March 6, 2003	September 9, 2004	Northcutt	B-6
EP1039768A2	March 20, 2000	September 27, 2000	Sim	B-7
US 5,617,507A	July 14, 1994	April 1, 1997	Lee	B-8
WO 2004/019583A2	August 4, 2003	March 4, 2004	Guglielmi	B-9
US 4,799,261A	September 8, 1987	January 17, 1989	Lin	B-10
US 6,304,845B1	August 3, 2000	October 16, 2001	Hünlich	B-11
US 6,173,250B1	June 3, 1998	January 9, 2001	Jong	B-12
US 5,630,205A	June 14, 1994	May 13, 1997	Ekelund	B-13

c) The '461 Patent

Number	Filing Date	Published/Issued Date	Short Name	Exhibit Numbers
US20200279576A1	2020-05-20	2020-09-03	Binder	C-1
US20120265528A1	2011-09-30	2012-10-18	Gruber	C-2
US20130110521A1	2012-05-30	2013-05-02	Hwang	C-3
US9031847B2	2011-11-15	2015-05-12	Sarin	C-4
US20140012573A1	2012-09-13	2014-01-09	Hung	C-5

Number	Filing Date	Published/Issued Date	Short Name	Exhibit Numbers
US20120296655A1	2012-07-31	2012-11-22	Kristijansson	C-6
US20150162002A1	2011-12-07	2015-06-11	Liu	C-7
US20130080171A1	2011-09-27	2013-03-28	Mozer '171	C-8
US20130289994A1	2012-04-26	2013-10-31	Newman	C-9
US20100009719A1	2009-05-21	2010-01-14	Oh	C-10
US20150106089A1	2010-12-30	2015-04-16	Parker	C-11
US20130339028A1	2012-06-15	2013-12-19	Rosner '028	C-12
US20100332236A1	2010-06-23	2010-12-30	Tan	C-13
US20140244269A1	2013-02-28	2014-08-28	Tokutake	C-14
US20100312547A1	2009-06-05	2010-12-09	Van Os	C-15
US7383189B2	2004-04-07	2008-06-03	Halonen	C-19
US8359020B2	2010-08-06	2013-01-22	Lebeau	C-20
US8713119B2	2012-09-13	2014-04-29	Lindahl	C-21
US20140006825A1	2012-06-30	2014-01-02	Shenhav	C-22

d) The '750 Patent

Number	Filing Date	Published/Issued Date	Short Name	Exhibit Numbers
US20140163978A1	2012-12-11	2014-06-12	Basye	D-1

Number	Filing Date	Published/Issued Date	Short Name	Exhibit Numbers
US20200279576A1	2020-05-20	2020-09-03	Binder	D-2
US20120265528A1	2011-09-30	2012-10-18	Gruber	D-3
US20140237277A1	2013-03-08	2014-08-21	Mallinson	D-4
US20140006825A1	2012-06-30	2014-01-02	Shenhav	D-5
US20130080167A1	2011-12-16	2013-03-28	Mozer '167	D-6
US20130289994A1	2012-04-26	2013-10-31	Newman	D-7
US9552037B2	2012-04-23	2017-01-24	Ooi	D-8
US20150106089A1	2010-12-30	2015-04-16	Parker	D-9
US9031847B2	2011-11-15	2015-05-12	Sarin	D-10
US9818407B1	2013-02-07	2017-11-14	Secker-Walker	D-11
US20090043580A1	2008-07-24	2009-02-12	Mozer '580	D-12
US2011/0166855	2010-07-06	2011-07-07	Vermeulen	D-13
US8713119B2	2012-09-13	2014-04-29	Lindahl	D-17
US8359020B2	2010-08-06	2013-01-22	Lebeau	D-18
US20110314185A1	2011-08-31	2011-12-22	Conroy	D-19

VI. OTHER RELEVANT REFERENCES

Defendants hereby cite the following additional references as being relevant to the subject matter claimed in the Asserted Patents. *In addition to those references cited in the sections below, Defendants incorporate by reference all those references found on the face of the Asserted Patents and/or in the prosecution history.* Defendants reserve the right to rely on one or more of the following references as anticipatory references under 35 U.S.C. §102, as further evidence of obviousness under 35 U.S.C. §103, as background references demonstrating the state of the art, as a limitation upon the doctrine of equivalents, or for any other purpose. Based on further investigation and discovery, based on positions that Plaintiff may take regarding the scope of the asserted claims, and/or based on the Court's claim construction, Defendants reserve the right to revise these contentions and to rely on these references to prove the invalidity of the Asserted Patents in a manner consistent with this Court's Rules and with the Federal Rules of Civil Procedure.

A. The '078 and '993 Patents

1. Prior Art Patents and Applications

Number	Filing Date	Published/Issued Date	Short Name
US6977921B1	August 19, 1998	December 20, 2005	Dolan '921
KR20010003635A	June 24, 1999	January 15, 2001	Sim
WO1999053682A1	April 15, 1999	October 21, 1999	He
US6061718A	July 23, 1997	May 9, 2000	Nelson
US6173259B1	March 27, 1998	January 9, 2001	Bijl
KR20030024409A	September 18, 2001	Mar. 26, 2003	Cho

Number	Filing Date	Published/Issued Date	Short Name
JP2000010578A	June 19, 1998	January 14, 2000	Shirotsuka
WO2000035214A1	October 16, 1999	June 15, 2000	Hans
KR20010047394A	November 19, 1999	November 7, 2002	Jin
WO2003034271A2	October 11, 2002	April 24, 2003	Alber
JP2000-138956A	August 18, 1999	May 16, 2000	Dolan '956
KR20030086756A	May 6, 2002	November 12, 2003	Baek
US20020169610A1	April 5, 2002	November 14, 2002	Luegger
US6636733B1	March 31, 2000	October 21, 2003	Helferich '733
EP1273162A2	April 2, 2001	January 8, 2003	Helferich '162
US20030194990A1	May 27, 2003	October 16, 2003	Helferich '990
CA2404409A1	April 2, 2001	October 11, 2001	Helferich '409
KR20010027175A	September 10, 1999	April 6, 2001	Kim '175
KR20030037316A	November 1, 2001	May 14, 2003	Kim '316
US6449342B1	May 5, 1999	September 10, 2002	Johanson
US20030139922A1	December 12, 2002	July 10, 2007	Hoffmann
US6636733B1	March 31, 2000	October 21, 2003	Helferich '733
US6163765A	March 30, 1998	December 19, 2000	Andric
US20030088418A1	October 7, 2002	May 8, 2003	Kagoshima
US20030139922A1	December 12, 2002	July 24, 2003	Hoffmann

Number	Filing Date	Published/Issued Date	Short Name
US20030120492A1	February 26, 2002	June 26, 2003	Kim '492
US20020163544A1	March 2, 2001	November 7, 2002	Baker '544
US6452947B1	July 2, 1998	September 17, 2002	Kojima
US6574598B1	January 13, 1999	June 3, 2003	Nakatsuyama
US20060161426A1	January 19, 2006	July 20, 2006	Ikegami
US20060258378A1	June 20, 2003	November 16, 2006	Kaikuranata
US7184049B2	May 8, 2003	February 27, 2007	Ballin
US20030210280A1	May 1, 2003	November 13, 2003	Baker '280
GB2370190A	December 13, 2000	June 19, 2002	Cooper
WO1999000791	November 5, 1997	January 7, 1999	Mermelstein
US6324515B1	June 2, 1998	November 27, 2001	Rabipour
US5870427	June 1, 1995	February 9, 1999	Tiedemann
US5963548	January 21, 1997	October 5, 1999	Virtanen
US6081724	January 31, 1996	June 27, 2000	Wilson
WO2001039177A2	November 22, 2000	May 31, 2001	Huang '177

2. Prior Art Publications

Author or Publisher	Title	Publication/Use Date
Masuko et al.	"A Very Low Bit Rate Speech Coder Using HMM with Speaker Adaption"	1997
Pagarkar et al.	"Language Independent Speech Compression Using Devanagari Phonetics"	December 1, 2003
GSM-SMS	Digital cellular telecommunications system (Phase 2+); Technical realization of the Short Message Service (SMS) Point-to-Point (PP) (3GPP TS 03.40 version 7.5.0 Release 1998)	2001
GSM-SMS	Universal Mobile Telecommunications System (UMTS); Technical realization of the Short Message Service (SMS) (3G TS 23.040 version 3.4.1 Release 1999)	2001
GSM-SMS	3rd Generation Partnership Project; Technical Specification Group Terminals; Technical realization of the Short Message Service (SMS); (Release 6)	2002
GSM-SMS	Digital cellular telecommunications system (Phase 2+); General description of a GSM Public Land Mobile Network (PLMN) (GSM 01.02)	March 1996
GSM-SMS	Digital cellular telecommunications system (Phase 2+); Point-to-Point (PP) Short Message Service (SMS) support on mobile radio interface (GSM 04.11 version 7.0.0 Release 1998)	1999
GSM-SMS	Digital cellular telecommunications system (Phase 2+); Compression algorithm for text messaging	1999

Author or Publisher	Title	Publication/Use Date
	services (GSM 03.42 version 7.1.1 Release 1998)	
GSM-SMS	Digital cellular telecommunications system (Phase 2+); Mobile Station - Base Station System (MS - BSS) interface; Channel structures and access capabilities (GSM 04.03 version 7.0.0 Release 1998)	1999
GSM-SMS	Digital cellular telecommunications system (Phase 2+); Mobile radio interface layer 3 specification (GSM 04.08 version 7.2.0 Release 1998)	1999
GSM-SMS	Digital cellular telecommunications system (Phase 2+); Point-to-Point (PP) Short Message Service (SMS) support on mobile radio interface (GSM 04.11 version 7.0.0 Release 1998)=	1999
MMS	Open Mobile Alliance (OMA) Enabler Release Definition for MMS Version 1.1 Version 4-Nov-2002	2002
MMS	Open Mobile Alliance (OMA) MMS Conformance Document Version 2.0.0 Version 6-Feb-2002	2002
MMS	Open Mobile Alliance (OMA) Multimedia Messaging Service Architecture Overview Version 1.1 Version 01-Nov-2002	2002
MMS	Open Mobile Alliance (OMA) Multimedia Messaging Service Client Transactions Version 1.1 Version 31-Oct-2002	2002
MMS	Open Mobile Alliance (OMA) Multimedia Messaging Service Encapsulation Protocol Version 1.1 Version 30-October-2002	2002

Author or Publisher	Title	Publication/Use Date
Roth	International Application Status Report, WO 2005/104092 (Roth); PCT/US2005/013478	November 30, 2005

B. The '461 and '750 Patents

1. Prior Art Patents and Applications

Number	Filing Date	Published/Issued Date	Short Name
JP2007286180A	2006-04-13	2007-11-01	Kaneko
US 2012/0035931	2011-09-29	2012-02-09	LeBeau
US 2013/0339028	2012-06-15	2013-12-19	Rosner
US 2014/0164476	2012-12-06	2014-06-12	Thomson
US10573304	2015-11-04	2020-02-25	Gemmeke
US11223882B2	2020-04-13	2022-01-11	Ferren
US20050216271	2005-02-04	2005-09-29	Konig
US20060074658	2004-10-01	2006-04-06	Chadha
US20070281761	2006-09-07	2007-12-06	Kim '761
US20080228493	2007-03-12	2008-09-18	Hu
US20090204410	2008-07-10	2009-08-13	Mozer 410
US20100082351	2007-09-12	2010-04-01	Lee
US20100088100	2008-10-02	2010-04-08	Lindahl
US20110131291	2010-09-28	2011-06-02	Hon-Anderson
US20110208524	2010-02-25	2011-08-25	Haughay

Number	Filing Date	Published/Issued Date	Short Name
US20110306304	2010-06-10	2011-12-15	Forutanpour
US2012/0035931	2011-09-29	2012-02-09	LeBeau
US20120016670	2010-07-13	2012-01-19	Khorashadi
US20120016678	2011-01-10	2012-01-19	Gruber '678
US20120078397	2011-03-30	2012-03-29	Lee
US20120089392	2010-10-07	2012-04-12	Larco
US20120137156	2011-11-07	2012-05-31	Huang '156
US20120296655	2012-07-31	2012-11-22	Kristjansson
US2013/0110521	2012-05-30	2013-05-02	Hwang
US20130080167	2011-12-16	2013-03-28	Mozer 167
US20130080171	2011-09-27	2013-03-28	Mozer 171
US20130085755	2012-09-15	2013-04-04	Bringert
US20130124207	2011-11-15	2013-05-16	Sarin '207
US20130173269	2012-06-03	2013-07-04	Adler
US20130197915	2012-09-27	2013-08-01	Burke
US20140244268	2013-02-27	2014-08-28	Abdelsamie
US20140244273	2014-02-26	2014-08-28	Laroche
US20150051913	2012-03-16	2015-02-19	Choi

Number	Filing Date	Published/Issued Date	Short Name
US20150127345	2011-09-30	2015-05-07	Parker '345
US20150138333	2012-02-28	2015-05-21	DeVaul
US20160086603	2015-09-21	2016-03-24	Rosner
US20200219384	2019-12-04	2020-07-09	Chen
US5345538	1992-01-27	1994-09-06	Narayannan
US6198947	1996-03-09	2001-03-06	Barber
US6212408	1999-05-03	2001-04-03	Son
US6321199	1999-04-13	2001-11-20	Theimer
US6839670	1996-09-09	2005-01-04	Stammmler
US7171356	2002-06-28	2007-01-30	Deisher
US7349851	2005-03-21	2008-03-25	Zuberec
US7472020	2005-08-04	2008-12-30	Brülle-Drews
US7475012	2004-12-09	2009-01-06	Garner
US7664642	2005-03-17	2010-02-16	Espy-Wilson
US8195467	2008-07-10	2012-06-05	Mozer
US8331315	2008-09-12	2012-12-11	Purkayastha
US8396458	2012-04-06	2013-03-12	Raleigh
US8396463	2012-03-09	2013-03-12	Marcellino

Number	Filing Date	Published/Issued Date	Short Name
US8442447	2010-02-01	2013-05-14	Veluppillai
US8483780	2012-05-16	2013-07-09	Goris
US8681949	2011-11-28	2014-03-25	Witten
US8694316	2005-10-20	2014-04-08	Pickering
US8843173	2013-03-15	2014-09-23	Lee
US8861351	2013-08-13	2014-10-14	Brisebois
US8898496	2012-03-23	2014-11-25	Chi
US8996375	2013-07-26	2015-03-31	Gagnon
US9082035	2012-04-18	2015-07-14	Hwang '035
US9098467	2012-12-19	2015-08-04	Blanksteen
US9099098	2012-11-06	2015-08-04	Atti
US9142215	2012-06-15	2015-09-22	Rosner
US9148501	2013-07-02	2015-09-29	Korn
US9256269	2013-03-08	2016-02-09	Mallinson '269
US9275637	2012-11-06	2016-03-01	Salvador
US9275642	2013-03-15	2016-03-01	Abdossalami
US9368113	2013-01-30	2016-06-14	LeBeau
US9374451	2002-02-04	2016-06-21	Salmenkaita

Number	Filing Date	Published/Issued Date	Short Name
US9401144	2015-04-24	2016-07-26	Garber
US9437206	2013-03-15	2016-09-06	Yu
US9510094	2014-04-09	2016-11-29	Paquier
US9552037	2012-04-23	2017-01-24	Ooi
US9620144	2013-12-27	2017-04-11	Parkinson
US9634855	2011-05-12	2017-04-25	Poltorak
US9818407	2013-02-07	2017-11-14	Secker-Walker
US9842489	2013-02-14	2017-12-12	Shires
US9858925	2011-09-30	2018-01-02	Gruber '925
US9947333	2012-02-10	2018-04-17	David
US9998977	2015-11-12	2018-06-12	Joshi
WO2012025784	2010-08-23	2012-03-01	Savolainen

2. Prior Art Publications

Author or Publisher	Title	Publication/Use Date
V.Z. Kēpuska	A Novel Wake-Up-Word Speech Recognition System, Wake-Up-Word Recognition Task, Technology And Evaluation	December 15, 2009
Gopala Krishna Anumanchipalli (IEEE)	Significance Of Early Tagged Contextual Graphemes In Grapheme Based Speech	May 12, 2008

Author or Publisher	Title	Publication/Use Date
	Synthesis And Recognition Systems	
Ron Amadeo	Full Hands-On With Samsung's S Voice From The Galaxy S III	MAY 20, 2012
Alistair Charlton	Samsung Galaxy S3 Mini Review	December 14, 2012
Charles Arthur	Samsung Galaxy S3: the latest bid to dominate the Android market	May 4, 2012
David Daw	What Makes Siri Special?	October 24, 2011
Federico Viticci	Apple Officially Unveils Siri Voice Assistant – Supports English, French and German	October 4, 2011
Samsung	GT-I9300 user manual	2012
Samsung	Galaxy S III User Guide (Virgin Mobile)	2013
Samsung	Galaxy S III User Manual (T-Mobile)	2013
Samsung	Galaxy S III User Manual (Android)	2012
Samsung	Galaxy S 4 User Manual	2015
Samsung	Galaxy S 4 Mini User Manual (4G LTE)	2014
Samsung	GT-S7562 user manual	2012
Apple	iPhone User Guide For iOS 6.1 Software	2013
Samsung	Galaxy Mega User Manual (4G LTE)	2013
Apple	iPhone User Guide For iOS 5.1 Software	2012
Apple	iPhone User Guide For iOS 7.1 Software	2014
Apple	iPhone User Guide For iOS 5.0 Software	2011
Samsung	Galaxy Axiom User Manual (SCH – R830 Android)	2012

C. The '428 Patent**1. Prior Art Patents and Applications**

Number	Filing Date	Published/Issued Date	Short Name
US2005/0219226	2004-04-02	2005-10-06	Liu '226
US2006/0239561	2006-07-03	2006-10-26	Huapaya
JP H06259605	1993-03-02	1994-09-16	Shimabara
JP 2008/250708	2007-03-30	2008-10-16	Kawajiri
JP 2012/073757	2010-09-28	2012-04-12	Sudo
JP H08255157	1995-03-15	1996-10-01	Oka
JP H0916710	1995-07-03	1997-01-17	Kazamaki
JP 3456931	1999-12-10	2003-10-14	Hirose '931
U.S. 2009/0198691	2008-02-05	2009-08-06	Kraft
WO 2007/068505A1	2006-06-16	2007-06-21	Cocco
U.S. 2005/0043949	2004-09-24	2005-02-24	Roth '949
U.S. 2014/0085215	2012-09-26	2014-03-27	Och '215
JP 2003/196593	2001-12-28	2003-07-11	Kawamura '593
U.S. 2009/0226091	2008-03-04	2009-09-10	Goldsmith '091
U.S. 2011/0090151	2009-04-20	2011-04-21	Huang '151
U.S. 2008/0235003	2008-03-18	2008-09-25	Lai
U.S. 2002/0064308	1997-07-22	1999-12-21	Altman '308

Number	Filing Date	Published/Issued Date	Short Name
U.S. 6,005,973	2004-12-05	2008-12-16	Seybold '973
U.S. 7,467,089	2004-12-13	2006-10-31	Roth '089
U.S. 7,130,798	2008-10-03	2011-07-05	Williamson '798
US 7,974,979	2002-05-13	2006-01-10	Qui
U.S. 6,986,106	2003-12-15	2009-03-17	Soin '106
U.S. 7,506,271	2004-12-27	2009-09-01	Wang '271
U.S. 7,583,825	2006-05-30	2007-12-13	Wang '825
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JP 4,890,551	2007-11-20	2009-03-10	Hirose '551
U.S. 7,502,017	1994-10-19	1997-01-14	Ratzlaff
U.S. 5,594,640	2003-07-18	2007-01-18	Capps
US20070014475	1985-11-12	1988-11-08	Prymus
U.S. 4,783,803	1986-08-11	1989-09-12	Baker '803
U.S. 4,866,778	1997-06-26	2000-08-08	Baker '778
U.S. 6,101,468	2000-08-01	2007-11-06	Gould
U.S. 7,293,231	1995-10-25	2000-07-25	Gunn
U.S. 6,094,506	2002-07-30	2006-11-14	Hullender
U.S. 7,137,076	2010-07-02	2012-01-10	Iwema

Number	Filing Date	Published/Issued Date	Short Name
U.S. 8,095,364	2004-08-30	2008-08-26	Longe
U.S. 7,418,137	1986-12-01	1989-06-13	Luice
U.S. 4,839,634	1997-06-03	2000-03-07	More
U.S. 6,035,063	2000-07-25	2003-01-28	Nakashima
U.S. 6,513,005	1995-01-23	1999-12-14	Qin
U.S. 6,002,799	2001-05-02	2005-06-28	Sklarew
U.S. 6,912,498	1996-10-01	1998-12-29	Stevens
U.S. 5,855,000	1990-11-13	1996-02-13	Waibel
U.S. 5,491,495	1999-05-18	2002-08-20	Ward
U.S. 6,438,523	2012-09-03	2016-11-08	Oberteuffer
U.S. 9,489,571	1995-12-28	1998-07-28	Kuno '571
US 5,787,455	2012-01-17	2016-11-29	Seybold '455
U.S. 9,507,435	1996-06-14	1999-01-19	Markiewicz '435
U.S. 5,862,256	2000-08-22	2004-10-05	Zetts
U.S. 6,801,660	2004-05-04	2005-11-10	Williamson '660
U.S. 2005/0249419	2002-06-14	2002-12-27	Rieman
WO 2002/103619	2004-03-17	2005-02-03	Lindberg
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U.S. 2006/0282575	2009-02-13	2011-01-13	Schultz
U.S. 2011/0010175	1997-09-08	2002-12-10	Kitade
U.S. 6,493,464	1997-09-08	2002-12-10	Hawkins
JP 2004/246607	2003-02-13	2004-09-02	Hosokawa
U.S. 2004/0140956	2003-01-16	2004-07-22	Kushler '956
JP H10198759	1997-01-09	1998-07-31	Takasu
JP H06208655	1993-01-11	1994-07-26	Kawamura '655
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U.S. 6,137,427	1998-10-27	2000-10-24	Binstead
U.S. 5,956,020	1995-07-27	1999-09-21	D'Amico
U.S. 7,928,964	2006-05-21	2011-04-19	Kolmykov-Zotov '964
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U.S. 7,369,865	2003-10-16	2008-05-06	Gabriel
U.S. Pub. No. 2008/0016132	2006-07-14	2008-01-17	Merhar
JP 2001/167229	1999-12-10	2001-06-22	Hirose '229
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JP5627372	2010-09-28	2014-11-19	Tomohiro

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US 10,254,952	2012-09-26	2019-04-09	Och '952
US 2002/0138265	2001-05-02	2002-09-26	Stevens
US 2003/0016873	2001-07-19	2003-01-23	Nagel '873
US 2003/0038788	2001-08-22	2003-02-27	Demartines '788
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US 2004/0021700	2002-07-30	2004-02-05	Iwema
US 2004/0082348	2003-10-16	2004-04-29	Gabriel
US 2005/0025363	2004-08-30	2005-02-03	Lui
US 2005/0096914	2004-12-13	2005-05-05	Williamson '914
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US 2005/0159948	2004-12-05	2005-07-21	Roth '948
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Number	Filing Date	Published/Issued Date	Short Name
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US 7,680,334	2003-07-18	2010-03-16	Oknelid
US 7,742,642	2006-05-30	2010-06-22	Goldstein '642
US 7,809,574	2004-09-24	2010-10-05	Roth '574
US 7,831,922	2006-07-03	2010-11-09	Huapaya
US 7,885,464	2005-12-08	2011-02-08	Kawamura '464
US 7,996,589	2005-10-14	2011-08-09	Schultz
US 8,103,499	2008-03-18	2012-01-24	Lai
US 8,411,958	2004-05-04	2013-04-02	Rieman
US 8,797,293	2013-07-09	2014-08-05	Kim '293
US 8,892,435	2009-02-13	2014-11-18	Kitade
US 8,908,973	2008-03-04	2014-12-09	Goldsmith '973
US 9,323,345	2009-04-20	2016-04-26	Huang '345

2. Prior Art Publications

Author or Publisher	Title	Publication/Use Date
Blackberry	"A short history of the BlackBerry"	2013-10-03

Author or Publisher	Title	Publication/Use Date
Nadeau	https://classictech.wordpress.com/2021/09/30/microsoft-multi-tool-word/	2021-09-30
Napper	Computer 50: The University of Manchester Celebrates the Birth of the Modern Computer	2010-07-26
Datamath	Datamath Calculator Museum, http://www.datamath.org/Related/Casio/fx-7000G.htm	2004-02-28
World Economic Forum	IBM Created the world's first smartphone 25 years ago, https://www.weforum.org/agenda/2018/03/remembering-first-smartphone-simon-ibm/	2018-03-13

Dated: November 12, 2024

/s/ Patrick C. Reidy

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February 3, 2025

VIA E-MAIL

James S. Tsuei
Russ August & Kabat
12424 Wilshire Boulevard, 12th Floor
Los Angeles, California 90025
jtsuei@raklaw.com

Re: *Cerence Operating Company v. Samsung Elecs. Co., Ltd., et al.*,
Case No. 2:23-CV-00482-JRG-RSP (E.D. Tex.)

Dear James:

We write regarding IPR2024-01464, in which Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. (together “Samsung”), and Google, Inc. (“Google”) challenge the patentability of claims 1-18 of U.S. Patent No. 11,393,461 (“the ’461 patent”). Samsung hereby stipulates that, if the Patent Trial and Appeal Board (“PTAB”) permits Samsung to file this stipulation as an exhibit in the IPR proceeding prior to issuing its decision on institution and, thereafter, institutes this IPR petition on the grounds presented therein, then Samsung will not pursue in the above-captioned litigation any grounds that were raised or reasonably could have been raised in the IPR. For the sake of clarity, this stipulation does not extend to co-petitioner Google, which is not a party to the above-referenced litigation.

In so stipulating, Samsung seeks to avoid multiple proceedings addressing the validity of claims 1-18 of the ’461 patent based on the grounds that were raised or reasonably could have been raised in this IPR. But, for the sake of clarity and to avoid any doubt, if the PTAB does not permit Samsung to file this stipulation as an exhibit in the IPR proceeding prior to its decision on institution, declines institution, or later vacates institution of this IPR, Samsung reserves the right to pursue in this litigation any ground that was raised or reasonably could have been raised in the IPR. This stipulation is not intended, and should not be construed, to limit Samsung’s ability to assert invalidity of the asserted claims of the ’461 patent on any other ground (e.g., invalidity under

Arnold & Porter

James Tsuei
February 3, 2025
Page 2

35 U.S.C. §§ 102 and 103 not available in IPR and under 35 U.S.C. §§ 101 and 112),
regardless of whether IPRs are instituted.

Sincerely,

A handwritten signature in black ink, appearing to read "Jin-Suk Park", with a stylized flourish extending to the right.

Jin-Suk Park

From: [Trials](#)
To: [Bradley Hyde](#); [Trials](#)
Cc: [Baxter, Jeff](#); [Zervos, Renia](#); [Butler, Kyla](#); ali.sharifahmadian@arnoldporter.com; patrick.reidy@arnoldporter.com; albert.boardman@arnoldporter.com; douglas.clark@arnoldporter.com; [Haber, Ben](#); rak_cerence@raklaw.com
Subject: RE: Google LLC, Samsung Electronics Co. LTD., and Samsung Electronics America, Inc. v. Cerence Operating Company, IPR2024-1464, -1465
Date: Friday, April 4, 2025 9:53:12 AM

Counsel,

Patent Owner is authorized to file a 5-page brief, due no later than Tuesday, April 8, to address only the issue of discretionary denial based on the parallel district court proceeding discussed below. Patent Owner may also file the most recent docket control order from that proceeding. Petitioner is authorized to file a 5-page reply brief, due no later than Friday, April 11, to address Patent Owner's brief.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Bradley Hyde <bhyde@raklaw.com>
Sent: Thursday, April 3, 2025 1:21 PM
To: Trials <Trials@USPTO.GOV>
Cc: Baxter, Jeff <jbaxter@omm.com>; Zervos, Renia <rzervos@omm.com>; Butler, Kyla <kbutler@omm.com>; ali.sharifahmadian@arnoldporter.com; patrick.reidy@arnoldporter.com; albert.boardman@arnoldporter.com; douglas.clark@arnoldporter.com; [Haber, Ben](#) <bhaber@omm.com>; rak_cerence@raklaw.com
Subject: Google LLC, Samsung Electronics Co. LTD., and Samsung Electronics America, Inc. v. Cerence Operating Company, IPR2024-1464, -1465

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Dear Board,

I am counsel for Patent Owner Cerence Operating Company ("Patent Owner" or "Cerence") in the above captioned *Inter Partes* Review proceedings. Cerence hereby requests leave to file a five (5) page supplemental briefing to the Patent Owner's Preliminary Responses filed in each action (*i.e.*, IPR2024-1464, Paper 8; IPR2024-1465, Paper 8), and to further submit the most recent Docket Control Order from the parallel District Court matter outlining the new trial date as an exhibit to said supplemental briefing.

Cerence's request is based on the changing circumstances for discretionary denial under *Fintiv* after the USPTO's recent rescission of former Director Vidal's 2022 memo "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," as well as the Chief Judge Boalick's March 24, 2025 guidance regarding the rescission and Acting Director Stewart's subsequent March 26, 2025 Interim Processes for PTAB Workload Management.

There is good cause to grant this request because both the Petitioners and the Patent Owner's Preliminary Responses were filed prior to the rescission of former Director Vidal's 2022 memo, meaning neither Petitioners, nor Patent Owner, were able to address this change in their respective briefings. Thus, given the Board's shift back to a more holistic application of the *Fintiv* factors, as well as the additional "relevant considerations" for discretionary denial outlined in Acting Director Stewart's March 26 memorandum, we believe that the Board would benefit from additional briefing on the discretionary denial issue.

Lead Counsel for Petitioners is included on this communication, and Petitioners have confirmed that they do not oppose this request, on the condition that they be provided the opportunity to submit a five (5) page responsive briefing. Patent Owner agrees with this compromise. Thus, in total the parties are requesting permission to file:

- A 5 page supplemental briefing from Patent Owner addressing the issue of discretionary denial in view of the new guidance from the USPTO, along with permission to submit the most recent Docket Control Order from the parallel District Court matter.
- A 5 page responsive briefing from Petitioners.

If the Board wishes to schedule a teleconference to discuss this request, Petitioners and Patent Owner are available at the following times:

- Monday, April 7, from 11am - 5pm ET
- Tuesday, April 8, after noon ET.

Respectfully submitted,

Bradley Hyde

Russ, August & Kabat

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Case # [IPR2024-01464](#) INSTITUTION DENIED
Patent # [11393461](#)

Parties Google LLC et al. v. Cerence Operating Company et al.

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Documents & claims

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Claims

Updated: 08/13 11:45AM



Papers

Next available paper # 20

All (19) Board (4) Petitioner (7) Patent Owner / Respondent (8)



	Paper #	Filing date	Paper type	Document name	Pages	Filing party	Availability
✓							
✓	19	07/17/2025	Order Denying Director Review of Institution Decision	Order Denying Director Review of Institution Decision	3	Board	Public
✓	18	06/10/2025	Notice: Other	Delegation Notice	2	Board	Public
✓	17	06/03/2025	Other: other	Patent Owner Cerence Operating Company's Response to Petitioners' Director Review Request	11	Patent Owner	Public
✓	16	05/23/2025	Request for Director Review - Institution Decision	Petitioners' Director Review Request	20	Petitioner	Public
✓	15	04/23/2025	Institution Decision: Deny	Decision Denying Institution of Inter Partes Review	16	Board	Public
✓	14	04/11/2025	Other: other	Petitioners' Reply to Patent Owner's Supplemental Briefing	11	Petitioner	Public
✓	13	04/08/2025	Other: other	SUPPLEMENTAL BRIEFING IN SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE	12	Patent Owner	Public
✓	12	04/08/2025	Notice: Updated Mandatory Notice	PATENT OWNER'S UPDATED MANDATORY NOTICES	5	Patent Owner	Public
✓	11	04/07/2025	Notice: Power of Attorney	PATENT OWNER'S SUPPLEMENTAL POWER OF ATTORNEY	3	Patent Owner	Public
✓	10	03/06/2025	Notice: Exhibit list	Petitioner's Updated List of Exhibits	4	Petitioner	Public
✓	9	02/13/2025	Notice: Updated Mandatory Notice	PATENT OWNER'S UPDATED MANDATORY NOTICES	5	Patent Owner	Public
✓	8	01/27/2025	POPR: filed	Patent Owner's Preliminary Response	22	Patent Owner	Public

✓	Paper #	Filing date	Paper type	Document name	Pages	Filing party	Availability
✓	7	11/08/2024	Notice: Power of Attorney	Notice : Power of Attorney	3	Patent Owner	Public
✓	6	11/08/2024	Notice: Mandatory Notice	Notice : Mandatory Notice	5	Patent Owner	Public
✓	5	10/25/2024	Notice: Notice filing date accorded	Notice: NOTICE OF FILING DATE ACCORDED TO PETITION AND TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE	6	Board	Public
✓	4	10/16/2024	Petition: as filed	Petition for Inter Partes Review of U.S. Patent No. 11,393,461	97	Petitioner	Public
✓	3	10/16/2024	Notice: Power of Attorney	Samsung Electronics America, Inc.'s Power of Attorney	5	Petitioner	Public
✓	2	10/16/2024	Notice: Power of Attorney	Samsung Electronics Co., Ltd.'s Power of Attorney	5	Petitioner	Public
✓	1	10/16/2024	Notice: Power of Attorney	Google LLC's Power of Attorney	5	Petitioner	Public

Exhibits

All (47) 1000s (40) 2000s (4) 3000s (3)

Y 0

✓	Exhibit #	Filing date	Document name	Pages	Filing party	Availability
✓	3100	05/27/2025	Email, Subject IPR2024-01464 and IPR2024-01465 Director Review Requests	1	Board	Public
✓	3002	04/23/2025	Email	2	Board	Public
✓	3001	03/06/2025	Correspondence from the Board.	2	Board	Public
✓	2004	04/08/2025	Exhibit 2004 - 3rd Amended Docket Control Order	5	Patent Owner	Public
✓	2003	01/27/2025	Proof of Service of Samsung Electronics America, Inc.	4	Patent Owner	Public
✓	2002	01/27/2025	Excerpt of Defendant's Amended Invalidity Contentions	22	Patent Owner	Public
✓	2001	01/27/2025	Federal Court Management Statistics, Eastern District of Texas, 2019-2024	1	Patent Owner	Public
✓	1030	03/06/2025	Letter from Jin-Suk Park to James S. Tsuei dated Feb. 3, 2025	2	Petitioner	Public
✓	1029	10/16/2024	U.S. Patent Application Pub. No. 2013/0006638 ("Lindahl")	19	Petitioner	Public
✓	1026	10/16/2024	U.S. Patent Application Pub. No. 2003/0179888 ("Burnett")	40	Petitioner	Public
✓	1025	10/16/2024	U.S. Patent Application Pub. No. 2014/0350927 ("Yamabe")	49	Petitioner	Public
✓	1024	10/16/2024	U.S. Patent Application Pub. No. 2013/0332165 ("Beckley")	21	Petitioner	Public
✓	1022	10/16/2024	Docket Control Order (23-cv-482)	6	Petitioner	Public
✓	1021	10/16/2024	Pl's Disclosure of Asserted Claims and Infringement Contentions (23-cv-482)	13	Petitioner	Public
✓	1020	10/16/2024	Claim Mapping Table	5	Petitioner	Public
✓	1019	10/16/2024	U.S. Patent Application Pub. No. 2014/0163978 ("Basve")	20	Petitioner	Public
✓	1018	10/16/2024	U.S. Patent Application Pub. No. 2012/0296655 ("Kristjansson")	12	Petitioner	Public
✓	1017	10/16/2024	U.S. Patent Application Pub. No. 2010/0129068 ("Binda")	9	Petitioner	Public

✓	Exhibit # ↓	Filing date	Document name	Pages	Filing party	Availability
✓	1016	10/16/2024	U.S. Patent Application Pub. No. 2012/0034904 ("LeBeau")	25	Petitioner	Public
✓	1015	10/16/2024	U.S. Patent Application Pub. No. 2014/0006825 ("Shenhav")	14	Petitioner	Public
✓	1014	10/16/2024	U.S. Patent Application Pub. No. 2020/0279576 ("Binder")	35	Petitioner	Public
✓	1012	10/16/2024	U.S. Patent Application Pub. No. 2013/0173269 ("Adler")	23	Petitioner	Public
✓	1011	10/16/2024	U.S. Patent No. 8,694,316 ("Pickering")	16	Petitioner	Public
✓	1010	10/16/2024	U.S. Patent No. 8,331,315 ("Purkayastha")	37	Petitioner	Public
✓	1009	10/16/2024	U.S. Patent No. 8,396,463 ("Marcellino")	30	Petitioner	Public
✓	1008	10/16/2024	U.S. Patent Application Pub. No. 2012/0265528 ("Gruber")	58	Petitioner	Public
✓	1007	10/16/2024	U.S. Patent No. 7,475,012 ("Garner")	16	Petitioner	Public
✓	1006	10/16/2024	U.S. Patent Application Pub. No. 2013/0110521 ("Hwang")	22	Petitioner	Public
✓	1005	10/16/2024	U.S. Patent No. 9,031,847 ("Sarin")	23	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 1 of 14)	321	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 2 of 14)	192	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 3 of 14)	155	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 4 of 14)	90	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 5 of 14)	55	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 6 of 14)	87	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 7 of 14)	49	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 8 of 14)	52	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 9 of 14)	44	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 10 of 14)	42	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 11 of 14)	103	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 11 of 14)	103	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 12 of 14)	126	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 13 of 14)	200	Petitioner	Public
✓	1004	10/16/2024	Prosecution History of the '461 Patent (Part 14 of 14)	2	Petitioner	Public
✓	1003	10/16/2024	Curriculum Vitae of Christopher M. Schmandt	7	Petitioner	Public
✓	1002	10/16/2024	Declaration of Christopher M. Schmandt	146	Petitioner	Public
✓	1001	10/16/2024	U.S. Patent 11,393,461	35	Petitioner	Public

› Real party

› Counsel

› Payments

Case # [IPR2024-01465](#) INSTITUTION DENIED
Patent # [11087750](#)

Parties Google LLC et al. v. Cerence Operating Company et al.

Tech center 2600 Art unit 2644

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Documents & claims

Documents

Claims

Updated: 08/13 11:55AM



Papers

Next available paper # 20

All (19) Board (4) Petitioner (7) Patent Owner / Respondent (8)



	Paper #	Filing date	Paper type	Document name	Pages	Filing party	Availability
✓							
✓	19	07/17/2025	Order Denying Director Review of Institution Decision	Order Denying Director Review of Institution Decision	3	Board	Public
✓	18	06/10/2025	Notice: Other	Delegation Notice	2	Board	Public
✓	17	06/03/2025	Other: other	Patent Owner Cerence Operating Company's Response to Petitioners' Director Review Request	11	Patent Owner	Public
✓	16	05/23/2025	Request for Director Review - Institution Decision	Petitioners' Director Review Request	20	Petitioner	Public
✓	15	04/23/2025	Institution Decision: Deny	Decision Denying Institution of Inter Partes Review	17	Board	Public
✓	14	04/11/2025	Other: other	Petitioners' Reply to Patent Owner's Supplemental Briefing	11	Petitioner	Public
✓	13	04/08/2025	Other: other	SUPPLEMENTAL BRIEFING IN SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE	12	Patent Owner	Public
✓	12	04/08/2025	Notice: Updated Mandatory Notice	PATENT OWNER'S UPDATED MANDATORY	5	Patent Owner	Public
✓	11	04/07/2025	Notice: Power of Attorney	PATENT OWNER'S SUPPLEMENTAL POWER OF ATTORNEY	3	Patent Owner	Public
✓	10	03/06/2025	Notice: Exhibit list	Petitioner's Updated List of Exhibits	4	Petitioner	Public
✓	9	02/13/2025	Notice: Updated Mandatory Notice	PATENT OWNER'S UPDATED MANDATORY NOTICES	5	Patent Owner	Public
✓	8	01/27/2025	POPR: filed	Patent Owner's Preliminary Response	24	Patent Owner	Public

✓	Paper #	Filing date	Paper type	Document name	Pages	Filing party	Availability
✓	7	11/08/2024	Notice: Power of Attorney	Notice : Power of Attorney	3	Patent Owner	Public
✓	6	11/08/2024	Notice: Mandatory Notice	Notice : Mandatory Notice	5	Patent Owner	Public
✓	5	10/25/2024	Notice: Notice filing date accorded	Notice: NOTICE OF FILING DATE ACCORDED TO PETITION AND TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE	6	Board	Public
✓	4	10/17/2024	Petition: as filed	Petition for Inter Partes Review of U.S. Patent No. 11,087,750	95	Petitioner	Public
✓	3	10/17/2024	Notice: Power of Attorney	Samsung Electronics America, Inc.'s Power of Attorney	5	Petitioner	Public
✓	2	10/17/2024	Notice: Power of Attorney	Samsung Electronics Co., Ltd.'s Power of Attorney	5	Petitioner	Public
✓	1	10/17/2024	Notice: Power of Attorney	Google LLC's Power of Attorney	5	Petitioner	Public

Exhibits

All (37) 1000s (30) 2000s (4) 3000s (3)

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✓	Exhibit #	Filing date	Document name	Pages	Filing party	Availability
✓	3100	05/27/2025	Email, Subject IPR2024-01464 and IPR2024-01465 Director Review Requests	1	Board	Public
✓	3002	04/23/2025	Email	2	Board	Public
✓	3001	03/06/2025	Correspondence from the Board.	2	Board	Public
✓	2004	04/08/2025	Exhibit 2004 - 3rd Amended Docket Control Order	5	Patent Owner	Public
✓	2003	01/27/2025	Proof of Service of Samsung Electronics America, Inc.	4	Patent Owner	Public
✓	2002	01/27/2025	Excerpt of Defendant's Amended Invalidity Contentions	22	Patent Owner	Public
✓	2001	01/27/2025	Federal Court Management Statistics, Eastern District of Texas, 2019-2024	1	Patent Owner	Public
✓	1030	03/06/2025	Letter from Jin-Suk Park to James S. Tsuei dated Feb. 3, 2025	2	Petitioner	Public
✓	1029	10/17/2024	U.S. Patent Application Pub. No. 2013/0006638 ("Lindahl")	19	Petitioner	Public
✓	1028	10/17/2024	U.S. Patent Application Pub. No. 2020/0279576 ("Binder")	35	Petitioner	Public
✓	1027	10/17/2024	U.S. Patent No. 9,020,459 ("Waters")	40	Petitioner	Public
✓	1026	10/17/2024	U.S. Patent Application Pub. No. 2003/0179888 ("Burnett")	40	Petitioner	Public
✓	1025	10/17/2024	U.S. Patent Application Pub. No. 2014/0350927 ("Yamabe")	49	Petitioner	Public
✓	1024	10/17/2024	U.S. Patent Application Pub. No. 2013/0332165 ("Beckley")	21	Petitioner	Public
✓	1023	10/17/2024	U.S. Patent No. 8,694,316 ("Pickering")	16	Petitioner	Public
✓	1022	10/17/2024	Docket Control Order (23-cv-482)	6	Petitioner	Public
✓	1021	10/17/2024	Pl's Disclosure of Asserted Claims and Infringement Contentions (23-cv-482)	13	Petitioner	Public
✓	1020	10/17/2024	Claim Mapping Table	8	Petitioner	Public
✓	1019	10/17/2024	U.S. Patent No. 9,031,847 ("Sarin")	23	Petitioner	Public

✓	Exhibit # ↓	Filing date	Document name	Pages	Filing party	Availability
✓	1018	10/17/2024	U.S. Patent Application Pub. No. 2012/0296655 ("Kristjansson")	12	Petitioner	Public
✓	1017	10/17/2024	U.S. Patent Application Pub. No. 2011/0314185 ("Conroy")	19	Petitioner	Public
✓	1016	10/17/2024	U.S. Patent No. 6,594,630 ("Zlokarnik")	16	Petitioner	Public
✓	1015	10/17/2024	U.S. Patent No. 9,998,977 ("Joshi")	30	Petitioner	Public
✓	1014	10/17/2024	U.S. Patent Application Pub. No. 2012/0034904 ("LeBeau")	25	Petitioner	Public
✓	1013	10/17/2024	U.S. Patent No. 10,573,304 ("Gemmeke")	27	Petitioner	Public
✓	1012	10/17/2024	U.S. Patent No. 7,664,642 ("Espy-Wilson")	30	Petitioner	Public
✓	1011	10/17/2024	U.S. Patent No. 9,634,855 ("Poltorak")	26	Petitioner	Public
✓	1010	10/17/2024	U.S. Patent Application Pub. No. 2013/0110521 ("Hwang")	22	Petitioner	Public
✓	1009	10/17/2024	U.S. Patent No. 9,275,637 ("Salvador")	18	Petitioner	Public
✓	1008	10/17/2024	U.S. Patent Application Pub. No. 2012/0016678 ("Gruber")	100	Petitioner	Public
✓	1007	10/17/2024	U.S. Patent Application Pub. No. 2015/0106089 ("Parker")	17	Petitioner	Public
✓	1006	10/17/2024	U.S. Patent Application Pub. No. 2014/0006825 ("Shenhav")	14	Petitioner	Public
✓	1005	10/17/2024	U.S. Patent Application Pub. No. 2014/0163978 ("Basye")	20	Petitioner	Public
✓	1004	10/17/2024	Prosecution History of the '750 Patent	1052	Petitioner	Public
✓	1003	10/17/2024	Curriculum Vitae of Christopher M. Schmandt	7	Petitioner	Public
✓	1002	10/17/2024	Declaration of Christopher M. Schmandt	158	Petitioner	Public
✓	1001	10/17/2024	U.S. Patent 11,087,750	35	Petitioner	Public

> Real party

> Counsel

> Payments

IPR Director discretion decisions under “interim process” announced March 26, 2025 in which Google and/or Samsung was a petitioner:

- **Petitions denied on discretionary grounds:**

IPR2025-00024; IPR2025-00025; IPR2022-00137; IPR2025-00138; IPR2025-00197; IPR2025-00227; IPR2025-00290; IPR2025-00291; IPR2025-00292; IPR2025-00293; IPR2025-00317; IPR2025-00331; IPR2025-00333; IPR2025-00335; IPR2025-00336; IPR2025-00344; IPR2025-00345; IPR2025-00365; IPR2025-00366; IPR2025-00367; IPR2025-00368; IPR2025-00369; IPR2025-00446; IPR2025-00447; IPR2025-00448; IPR2025-00449; IPR2025-00450; IPR2025-00457; IPR2025-00458; IPR2025-00459; IPR2025-00460; IPR2025-00482; IPR2025-00481; IPR2025-00483; IPR2025-00484; IPR2025-00487; IPR2025-00488; IPR2025-00489; IPR2025-00490; IPR2025-00493; IPR2025-00494; IPR2025-00495; IPR2025-00496; IPR2025-00526; IPR2025-00527; IPR2025-00528; IPR2025-00529; IPR2025-00535; IPR2025-00536; IPR2025-00537; IPR2025-00538; IPR2025-00539; IPR2025-00540; IPR2025-00541; IPR2025-00542; IPR2025-00543; IPR2025-00544; IPR2025-00586; IPR2025-00613; IPR2025-00639; IPR2025-00640; IPR2025-00641; IPR2025-00642; IPR2025-00643; IPR2025-00644; IPR2025-00645; IPR2025-00780; IPR2025-00781

- **Petitions referred to an APJ panel for consideration of the merits:**

IPR2025-00472; IPR2025-00775