

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.,
Petitioner,

v.

GOOGLE LLC,
Patent Owner.

IPR2023-01284
Patent 11,024,311 B2

Before KEVIN F. TURNER, TERRENCE W. McMILLIN, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Sonos, Inc. (“Petitioner”) filed a Petition (Paper 1; “Pet.”) to institute an *inter partes* review of claims 1–3, 8–12, and 14–20 (the “challenged claims”) of U.S. Patent No. Patent 11,024,311 B2 (Ex. 1001, “the ’311 Patent”) pursuant to 35 U.S.C. § 311 *et seq.* Google LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With our authorization, the parties filed additional pre-institution briefings to address whether we should exercise our discretion, where Petitioner filed a Reply (Paper 8; “Pet. Reply”) and Patent Owner filed a Sur-reply (Paper 9; “PO Sur-reply”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary 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). After considering the Petition, the Preliminary Response, the Pet. Reply, and the PO Sur-reply, and the evidence of record, we decline to institute this *inter partes* review as to the challenged claims of the ’311 Patent on the grounds of unpatentability presented in the Petition.

A. Related Proceedings

Petitioner acknowledges that the instant Petition is its second petition filed against the instant ’311 Patent in its Ranking and Explanation for Second Petition. Paper 3 (“Explanation”), 1. On September 29, 2022, Petitioner filed a first petition challenging all of the instant challenged claims of the ’311 Patent, save claim 19, upon which it additionally seeks challenge in this proceeding. *Id.* (citing IPR2022-01592 (“1592IPR”), Paper

1). We instituted, on April 14, 2023, an *inter partes* review of claims 1–3, 8–12, 14–18, and 20 of the ’311 Patent in the former proceeding, with a final written decision to be issued shortly. 1592IPR, Paper 9. Petitioner indicated that the instant Petition is ranked second with respect to the petitions filed against the ’311 Patent. Explanation 1.

Petitioner also acknowledges that U.S. Patent 9,812,128 (“’128 patent”) is related to the ’311 Patent, and an *inter partes* review challenging claims of the ’128 patent was instituted and is denominated IPR2022-01594. Pet. 1 n.1. Petitioner further states that “[Patent Owner] asserted, *inter alia*, the ’311 Patent and [’128 patent] against [Petitioner] in the following ITC and district court proceedings: *Certain Audio Players and Components Thereof*, Inv. No. 337-TA-1330; *Google LLC v. Sonos, Inc.*, No. 3:22-CV-04553 (N.D. Cal.).” Pet. 1–2. Petitioner further provides that Patent Owner has also asserted related U.S. Patents 10,134,398 and 10,593,330 against Petitioner in *Certain Audio Players and Components Thereof*, Inv. No. 337-TA-1329 and *Google LLC v. Sonos, Inc.*, No. 3:22-CV-04552 (N.D. Cal.). Pet. 2. Patent Owner also identifies the above ITC proceeding, the litigation in the Northern District of California, and the 1592IPR as “judicial and administrative matters that would be affected by a decision in this proceeding.” Paper 5, 2.

B. The ’311 Patent

The ’311 patent is titled “Device Leadership Negotiation Among Voice Interface Devices.” Ex. 1001, code (54). The patent “relates generally to voice interfaces and related devices, including but not limited to methods and systems for coordination amongst multiple voice interface devices.” *Id.* at 1:44–47.

C. The Asserted Grounds

Petitioner challenges claims 1–3, 8–12, and 14–20 of the '311 Patent based on the grounds set forth in the table below.

Ground	Claim[s] Challenged	35 U.S.C.	Reference(s)
1A	1–3, 8–11, 14–20	§ 102	Piersol ¹
1B	1–3, 8–12, 14–20	§ 103	Piersol, Meyers ²
2A	1–3, 8–11, 14, 16, 17, 19, 20	§ 102	Masahide ³
2A'	3	§ 103	Masahide
2B	1–3, 8–11, 14, 16, 17, 19, 20	§ 103	Masahide, Jang ⁴

With respect to ground “2A',” we note that Petitioner does not separate this ground from the others, but notes that “Masahide alone also renders claim 3 obvious,” (Pet. 5 n.3), implicitly distinguishing this assertion from the other grounds. Petitioner relies on a declaration from Dr. Michael T. Johnson (Ex. 1002) to support the contentions in the Petition. Patent Owner has not supported its arguments with any testimonial evidence. *See generally* Prelim. Resp.

II. ANALYSIS

Discretion under 35 U.S.C. § 314(a)

The instant Petition was filed by Petitioner about four months after the institution in the 1592IPR and challenges all of the same patent claims, with the addition of claim 19. Because Petitioner has filed staggered, multiple

¹ US 2017/0357478 A1, published Dec. 14, 2017 (Ex. 1003).

² US 2017/0083285 A1, published Mar. 23, 2017 (Ex. 1004).

³ Japanese Publication No. 2003/223188, published Aug. 8, 2003 (Ex. 1005; English translation Ex. 1006).

⁴ US 2013/0073293 A1, published Mar. 21, 2013 (Ex. 1007).

petitions challenging mostly the same claims of the same patent, we first consider whether we should exercise our discretion to deny the second petition under § 314(a), which invests the Director, and by delegation the Board, “with discretion on the question whether to institute review.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018); *see Harmonic Inc. v Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

The Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”)⁵ states that generally “one petition should be sufficient to challenge the claims of a patent in most situations” and that “multiple petitions by a petitioner are not necessary in the vast majority of cases.” CTPG 59. “[T]o aid the Board’s assessment of ‘the potential impacts on both the efficiency of the *inter partes* review process and the fundamental fairness of the process for all parties,’” we consider a number of non-exclusive factors, “especially as to ‘follow-on’ petitions challenging the same patent as challenged previously in an IPR.” *Id.* at 56. Those factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to

⁵ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

the first petition or received the Board’s decision on whether to institute review in the first petition;

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;

6. the finite resources of the Board; and

7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Id. at 57 (citing *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, slip op. 16–17 (PTAB Sept. 6, 2017) (Paper 19) (precedential) (“*General Plastic*”). We consider those factors below based on the representations of Petitioner and Patent Owner in their filings.

1. Factor 1

Petitioner asserts that the instant Petition “addresses an additional dependent claim not challenged in” the 1592IPR, and that “*General Plastic* factor 1 favors institution.” Explanation 4 (citing *Panduit Corp. v. CCS Tech., Inc.*, IPR2017-01375, Paper 8, 10 (PTAB Nov. 8, 2017). Patent Owner responds that “[t]he near complete overlap along with the circumstance that the same petitioner filed both petitions, favors denying institution.” Prelim. Resp. 7 (citing *Apple Inc. v. Koss Corp.*, IPR2022-00053, Paper 10 at 9 (PTAB Apr. 4, 2022)).

In response, Petitioner asserts that factor 1 must be read in conjunction with factors 2 and 3, and that those factors only weigh in favor of discretionary denial when there are “road-mapping” concerns under factor 3 or other concerns under factor 2. Pet. Reply 7 (quoting *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 5 (PTAB Aug. 23, 2022)). Petitioner continues “[t]here are no ‘road-mapping’ concerns here because the Board has yet to comment on the proper construction of ‘detecting a voice input,’ which means [Petitioner] was not afforded commentary used to refine its position in” the instant Petition. *Id.*

Patent Owner responds that “Petitioner does not deny using Patent Owner’s response to inform the instant petition,” and that all aspects of the instant Petition were informed by Patent Owner’s prior Response in the 1592IPR. PO Sur-reply 4. Patent Owner continues that “road-mapping concerns arise where Petitioner has access to documents, including Patent Owner’s Response and expert testimony.” *Id.* at 5 (citing *Shanghai Lunion Information Technologies, Ltd v. Telefonaktiebolaget LM Ericsson*, IPR2018-00995, Paper 18 at 10 (PTAB Nov. 13, 2018)).

We note, first, that the *General Plastic* factors enumerated above are separately listed, such that we do not agree that factor 1 must be contingently read in lockstep with the other factors; each factor should be considered separately and an overall, holistic view of the totality of the circumstances presented should be considered. As such, we do not agree that any apparent lack of “road-mapping” concerns obviates this factor.

Second, we agree with Patent Owner that the degree of overlap is substantial, with 14 of the 15 challenged claims being considered again under different grounds. Additionally, although claim 19 is challenged for

the first time in the instant Petition, its challenge also includes challenges to the remaining 14 claims. This is also a relevant difference between the instant Petition and the proceeding cited by Petitioner, namely *Panduit Corp.* In the latter proceeding, the additional, second petition sought review of three additional claims only, i.e., not those additional claims, as well as previously instituted claims, and several were not previously instituted because “one of the asserted references was not shown to have been a printed publication,” and the panel did not construe the additional claims in the original proceeding. *Panduit Corp.*, Paper 8, 9–10. In contrast, the instant Petition is largely directed to the same claims of the same patent, such that we determine this factor weighs in favor of discretionary denial.

Third, Petitioner asserts that Patent Owner adding claim 19 to the claims it originally asserted in the ITC was unforeseeable. Pet. Reply 2. But Petitioner acknowledged that adding claims to an ITC action can only be made upon a heightened showing of good cause. *Id.* We agree with Patent Owner (PO Sur-reply 2–3) that if Patent Owner met this ITC requirement, it would have been permitted by the ITC’s rules and cannot have been unforeseeable to Petitioner.

2. *Factor 2*

With respect to this factor, Petitioner asserts that it “did not look for (and had no reason to look for) prior art to address this new disclaimer, especially in view of [Patent Owner’s] then-existing broad interpretation.” Explanation 4. Petitioner continues that art cited only became relevant after Patent Owner changed its claim interpretation. *Id.* at 4–5. Patent Owner responds that Petitioner should have known of the asserted references as of the date of the 1592IPR, and points out that Factor 2 does not ask if

Petitioner considered the references “relevant” at the time of the first petition or anytime thereafter, only whether Petitioner knew or should have known about them. Prelim. Resp. 7–8. Patent Owner also cites multiple patents belonging to Petitioner that cite to the newly cited references. *Id.* at 8.

Petitioner responds that the altered claim construction was unforeseeable, and asserts that it is “absurd” to require Petitioner to have relevant knowledge of every reference cited in its patents in the instant context. Pet. Reply 7-8. Patent Owner responds that “Petitioner does not even attempt to argue that a reasonable search would not have uncovered the patents at the time of the first-filed petition—leaning instead on the alleged unforeseeability of Patent Owner’s claim construction.” PO Sur-reply 5.

We determine that Petitioner has made no argument nor presented any evidence that it did not know nor should have known of the newly cited references at the time of filing of the first petition. Petitioner’s argument that Patent Owner’s changed claim interpretation was material, changed the priority that the claims could rely upon, and opened the claims to be considered in view of a wider array of prior art, does not respond to this factor. Even assuming that the change was material, which we do not decide, the delay in filing the instant Petition was substantial, as discussed below, in the context of the overall time for trial of the 1592IPR. We determine this factor weighs in favor of discretionary denial.

3. *Factor 3*

Petitioner does not initially respond as to how this Factor impacts our discretionary decision. *See generally* Explanation. Patent Owner asserts that “Petitioner received Patent Owner’s Preliminary Response and the Board’s institution decision, as well as Patent Owner’s Response in

[1592IPR] before filing the instant Petition,” and asserts that this factor strongly favors denying institution. Prelim. Resp. 9.

We agree with Patent Owner that Petitioner clearly had already received the patent owner’s preliminary response and our institution decision on in 1592IPR at the time it filed the instant Petition. We determine this factor weighs in favor of discretionary denial.

4. *Factor 4*

Petitioner does not initially respond as to how this Factor impacts our discretionary decision. *See generally* Explanation. Patent Owner asserts that Petitioner should have known of the newly cited references at the time of the 1592IPR, and that any subsequent petition could have been filed shortly after learning of Patent Owner’s changed claim interpretation. Prelim. Resp. 9. Petitioner asserts that it searched for new art and filed the instant Petition within six (6) weeks of Patent Owner’s “attempted disclaimer before the Board.” Pet. Reply 8. Patent Owner responds that:

Petitioner does not dispute that it was aware of Patent Owner’s construction of “detecting a voice input” when validity contentions were served January 9, 2023 or that it knew in December 2022 that Patent Owner articulated that “speech recognition” and “voice input detection” are distinct processes *seven* months before filing the instant petition.

PO Sur-reply 3.

We agree with Patent Owner that the time between when Petitioner was informed of Patent Owner’s changed claim interpretation and when Petitioner filed the instant Petition was closer to seven months. Petitioner has agreed that it did not search for additional references until it was informed of the changed claim interpretation. *See* Pet. Reply 3–4. We

further agree with Patent Owner that “prosecution disclaimer” before the PTO was not needed to start the clock on a party’s diligence to file. PO Sur-reply 3–4. We determine this factor weighs in favor of discretionary denial.

5. *Factor 5*

With respect to this factor, Petitioner asserts that “any delay in filing [the instant] Petition . . . is justified because [the] Petition [in the 1592IPR] could not have accounted for” Patent Owner’s alleged disclaimer that Petitioner states occurred in June of 2023. Explanation 4. Petitioner continues that its asserted prior art only became relevant after Patent Owner changed its interpretation of “detecting a voice input” claim limitation. *Id.* Patent Owner reiterates that Petitioner was on notice of the changed claim construction for seven months and has not provided an adequate explanation for the time elapsed between the filings. Prelim. Resp. 10.

As discussed above, we are persuaded that the relevant timeframe upon which Petitioner was informed of the changed claim construction was closer to seven months, such that Petitioner’s arguments are insufficient to account for a delay over such a period. We determine this factor weighs in favor of discretionary denial.

6. *Factors 6 and 7*

Petitioner asserts that the institution of the instant Petition would not frustrate the finite resources of the Board or its requirement to issue a final determination within the statutory limit. Explanation 5. Petitioner reasons that if the challenged claims are cancelled in the 1592IPR, the Board “could decide to only consider Grounds 2A-2B in [the instant Petition] that address dependent claim 19, which was not challenged in” the 1592IPR. *Id.* This is not correct, however, because all grounds of the instant Petition are asserted

against claim 19 as well. Additionally, as Patent Owner argues (Prelim. Resp. 11), in such a scenario, estoppel will attach to all claims but claim 19, and we would still need to examine the efficacy of the instant Petition with respect to the rest of the challenged claims, although no further consideration of the rest of the claims could occur after estoppel attaches. We agree that such an occurrence would not be an efficient use of the finite resources of the Board. Further, we agree with Patent Owner that “Petitioner certainly could have raised Grounds 2A-2B, neither of which address the alleged priority dispute, at the time of the first filing,” such that estoppel will attach to all but claim 19 when the final written decision issues in the 1592IPR, under this scenario. PO Sur-reply 6–7 (citing 35 U.S.C. § 315(e)(1)).

Petitioner also asserts that if we determine all claims to be patentable in the 1592IPR, and instituted review of the instant Petition, we would “not expend further resources on [the instant] Petition . . . until the end of 2024 in advance of the final determination expected around February 2025.” Explanation 5. Such suppositions appear to suggest that the Board’s resources are not tasked until oral hearing and the writing of a final written decision in any proceeding, but such suppositions are speculative and not based on how the Board’s resources are actually utilized over the course of a proceeding. The institution of the instant Petition would require consideration of the alternate priority assertions regarding the challenged claims, which Petitioner asserts because the changing claim interpretation have no support in the earliest priority documents, which would become a fixture of many arguments over the course of the expectant trial, and burden the Board’s resource more than asserted by Petition. We further note that

Factor 6 considers the finite resources of the Board, which is different from the Petitioner's assertions that Board's resources will "not be unduly exhausted" by the instant Petition thereby. Explanation 5.

Overall, we determine that Factor 6 weighs in favor of discretionary denial.

Lastly, Petitioner asserts that "there is no readily identifiable roadblock for the Board to issue a final determination for" the instant Petition within the statutory limit. Explanation 5. We agree with Petitioner that if the instant Petition is instituted, it would arrive at a final written decision by the statutory limit, such that Factor 7 would be neutral in determining that we should apply our discretion.

III. CONCLUSION

"Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse." *General Plastic*, Paper 19 at 17. The instant Petition was filed by Petitioner about four months after the institution in the 1592IPR and challenges all of the same patent claims, with the addition of claim 19. Taking a holistic view of the totality of the circumstances presented, on this record, we exercise our discretion under § 314(a) and do not institute an *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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