

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**SONOS, INC.,**  
Petitioner,

v.

**GOOGLE LLC,**  
Patent Owner.

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Case No. IPR2023-01284  
U.S. Patent No. 11,024,311

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**SONOS, INC.'S RANKING AND  
EXPLANATION FOR SECOND PETITION**

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## **I. Introduction**

On September 29, 2022, Petitioner Sonos, Inc. (“Sonos”) filed a first petition challenging claims 1-3, 8-12, 14-18, and 20 of the ’311 Patent. IPR2022-01592, Petition (“Petition 1”). The Board instituted IPR of those claims on April 14, 2023. IPR2022-01592, Paper 9. Sonos has now filed a second petition challenging claim 19, in addition to the foregoing claims challenged in Petition 1. *See* IPR2023-01284, Petition (“Petition 2”). Pursuant to the Consolidated Trial Practice Guide (“TPG”), Sonos provides a ranking of the petitions, an explanation of the material differences between the petitions, and why the Board should exercise discretion to institute Petition 2. *See* TPG, pp. 59-60.

## **II. Ranking of Petitions**

| <b>Rank</b> | <b>Petition</b>              | <b>Prior Art</b>                |
|-------------|------------------------------|---------------------------------|
| 1           | IPR2022-01592 (“Petition 1”) | Rosenberger, Kim                |
| 2           | IPR2023-01284 (“Petition 2”) | Piersol, Meyers, Masahide, Jang |

## **III. Petitions 1 & 2 Are Materially Different**

### **A. Petition 2 Challenges a Claim Not Challenged in Petition 1**

Petition 1 was filed on September 29, 2022 and challenged claims Google asserted in its original district court and ITC complaints against Sonos. But, on February 6, 2023—months after Sonos filed Petition 1—Google amended its ITC complaint to assert a ’311 claim (i.e., claim 19) not previously asserted. *See* IPR2023-01284, Ex.1022, p. 9. Thus, in addition to the claims challenged in Petition 1, Petition 2 challenges claim 19. If the Board were to discretionarily deny Petition

2, the parties would likely need to address the same grounds concerning claim 19 in the parallel district court proceeding, which would be highly inefficient.

### **B. Petition 2 Addresses Google’s New Prosecution Disclaimer**

In its district court complaint, Google asserted that certain Sonos devices satisfied the “detecting a voice input” limitation recited in the ’311 independent claims simply because “*a user may speak commands* to a Sonos [device] to trigger the device to perform certain activities” and “each of the devices *receive the spoken audio input*, including a wake word (‘Hey Sonos’) followed by a user command.” IPR2023-01284, Ex.1023, pp. 5, 8. Accordingly, Petition 1 applied an interpretation of this limitation commensurate with Google’s broad interpretation. Petition 1, Ex.1002, ¶69-70.

However, in an attempt to rescue the ’311 Patent from invalidity, Google *materially changed* its interpretation of “detecting a voice input” when it filed its Patent Owner’s Response to Petition 1 on June 30, 2023. Specifically, Google asserted that “detecting a voice input” now refers “to a process for identifying that an audio input includes voice” which must be “*separate from performing speech recognition (e.g., speech to text)* on the voice input.” IPR2022-01592, Paper 11, pp. 12-13; Petition 2, §VII.A. In this way, Google—for the first time—made clear and unmistakable statements to the USPTO attempting to narrow the scope of “detecting a voice input” from its plain and ordinary meaning. These statements can give rise

to prosecution disclaimer for proceedings initiated after June 30, 2023.<sup>1</sup> Petition 1 could not have accounted for this new disclaimer. Thus, Petition 2 shows that the challenged claims are invalid under Google’s narrow interpretation of “detecting a voice input.” Sonos requests that the Board institute Petition 2 for this reason.<sup>2</sup>

### **C. Petitions 1 & 2 Address Different Priority Dates and Prior Art**

The ’311 Patent ultimately claims priority to the ’830 Provisional filed on October 9, 2014 and the ’107 Patent filed on April 1, 2015. *See* Petition 2, §VIII. Petition 1 assumed the ’311 claims were entitled to the benefit of the ’830 Provisional’s ***October 9, 2014*** filing date. In contrast, Petition 2 shows that the ’311 claims have a priority date no earlier than ***October 3, 2016*** because the ’107 Patent lacks written description support for (and expressly contradicts) Google’s narrow interpretation of “detecting a voice input.” *Id.* The Board frequently institutes multiple petitions when they are based on different priority dates.<sup>3</sup>

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<sup>1</sup> *CUPP Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1383-84 (Fed. Cir. 2022) (“[A] disclaimer in an IPR proceeding is binding in later proceedings, whether before the PTO or in court.”).

<sup>2</sup> *See 3shape a/s v. Align Tech., Inc.*, IPR2020-00222, Paper 12, 19 (PTAB May 26, 2020) (“[A] genuine dispute about how claim terms should be construed could support multiple petitions.”).

<sup>3</sup> *See, e.g., Samsung Elecs. Co., Ltd. v. Acorn Semi LLC*, IPR2020-01206, Paper 22, 42 (PTAB Jan. 13, 2021) (instituting IPR on petitions “premised on different priority positions”); *RG Energy, Inc. and Talen Energy Corp. v. Midwest Energy Emissions Corp.*, IPR2020-00926, Paper 19, 26 (PTAB Dec. 2, 2020) (same); *see also* TPG, p. 59 (explaining circumstances where “more than one petition may be necessary,” such as “a dispute about priority date”).

Petition 2 also asserts different prior art not asserted in Petition 1 in part because of Google’s narrow interpretation that results in a later priority date.

#### **IV. Board Should Exercise Discretion to Institute Petition 2**

Sonos respectfully requests that the Board institute Petition 2 because the material differences highlighted above present unique circumstances that favor institution. Moreover, the non-exclusive *General Plastic* factors further favor institution for at least the following reasons.

**First**, as discussed above, Petition 2 addresses an additional dependent claim not challenged in Petition 1. Thus, *General Plastic* factor 1 favors institution.<sup>4</sup>

**Second**, any delay in filing Petition 2 is justified because Petition 1 could not have accounted for Google’s June-2023 disclaimer discussed above.<sup>5</sup> Indeed, at the time of filing Petition 1, Sonos did not look for (and had no reason to look for) prior art to address this new disclaimer, especially in view of Google’s then-existing broad interpretation. The Piersol and Meyers prior art—which post-date the ’107 Patent’s filing date—only became relevant after Google materially changed its interpretation of “detecting a voice input” (and were only recently identified by Sonos’s IPR

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<sup>4</sup> See *Panduit Corp. v. CCS Tech., Inc.*, IPR2017-01375, Paper 8, 10 (PTAB Nov. 8, 2017) (instituting subsequent petition challenging claim not previously challenged).

<sup>5</sup> Google also advanced its narrow interpretation in the parallel ITC proceeding months after Sonos filed Petition 1, but statements made in the ITC do not give rise to prosecution disclaimer. See *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063 (Fed. Cir. 2016) (explaining “prosecution history disclaimer” requires “claims of a patent be interpreted in light of the proceedings *in the PTO*”).

counsel). Thus, *General Plastic* factors 2 and 5 favor institution.

*Third*, institution of Petition 2 would not frustrate the finite resources of the Board or its requirement to issue a final determination within the statutory limit. *See General Plastic* factors 6 and 7. Petition 1 was instituted on April 14, 2023. If the Board were to reject Google’s interpretation of “detecting a voice input” in Petition 1, the Board would responsively cancel the claims challenged in Petition 1<sup>6</sup> and could decide to only consider Grounds 2A-2B in Petition 2 that address dependent claim 19, which was not challenged in Petition 1.<sup>7</sup> On the other hand, if the Board were to adopt Google’s interpretation, that would occur at the conclusion of Petition 1 (expected April 2024) and the Board would institute Petition 2 around February 2024 and not expend further resources on Petition 2 until the end of 2024 in advance of the final determination expected around February 2025. Thus, the Board’s resources will not be unduly exhausted by Petition 2, and there is no readily identifiable roadblock for the Board to issue a final determination for Petition 1 within the statutory limit.<sup>8</sup>

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<sup>6</sup> Google *only* disputes the “detecting a voice input” limitation in connection with the independent claims challenged in Petition 1. IPR2022-01592, POR, pp. 17-25.

<sup>7</sup> Because Google’s interpretation of “detecting a voice input” is *narrower* than its plain and ordinary meaning (*see* Petition 2, Ex.1002, ¶¶65-66), Masahide and Jang (Grounds 2A-2B) disclose this limitation even if Google’s interpretation is rejected.

<sup>8</sup> *See, e.g., W. Digital Corp. v. Spex Techs., Inc.*, IPR2018-00082, Paper 11, 19 (PTAB Apr. 25, 2018) (“Filing of [subsequent] petition... [that] appl[ies] substantially different prior art, based on substantially different arguments, cannot be said to be wasteful of resources of the Board.”).

Respectfully submitted,

LEE, SULLIVAN, SHEA & SMITH LLP

Dated: August 7, 2023

/Michael P. Boyea/

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## **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Ranking and Explanation For Second Petition is being served on August 7, 2023, via Federal Express overnight courier on counsel of record for Patent Owner:

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A courtesy copy is also being served on counsel for the Patent Owner in the related district court litigation:

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August 7, 2023

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