

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.,
Petitioner,

v.

GOOGLE LLC,
Patent Owner.

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

**PETITIONER SONOS, INC.'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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Sonos files this reply to address Google’s arguments for discretionary denial under 35 U.S.C. § 314(a). Petition 2 should be instituted because it addresses (i) a claim not at issue in Petition 1, which is the case since Google unforeseeably added it to the related ITC case after Sonos filed Petition 1, and (ii) an unforeseeable construction advanced by Google in response to Petition 1 that alters the ’311 Patent’s priority date and renders additional prior art applicable. As to the latter, in response to Petition 1, Google completely changed course from the interpretation advanced in its ITC complaint, attempting to disclaim scope by adding a negative limitation to “detecting a voice input.” Such a limitation finds no written description support in the earlier-filed ’107 Patent to which the ’311 Patent claims priority (“priority document”). In this way – *after* Petition 1 was filed – Google squarely put the ’311 Patent’s priority at issue and opened the door to new prior art references that post-date the priority document. Thus, the Board should institute Petition 2.

I. Google’s Addition of Claim 19 to the ITC Case Was Unforeseeable

As required by ITC rules, Google’s original complaint identified the asserted claims of the ’311 patent and specifically excluded claim 19. *See* 19 C.F.R. § 210.12(a)(9)(viii); Ex.1024, p.20. Thus, Petition 1 did not include claim 19 since it was not asserted against Sonos. But, after Sonos filed Petition 1, Google moved to amend its ITC complaint to assert claim 19.

Google simply announces without explanation that its post-Petition 1 ITC

amendment to assert claim 19 was “foreseeable.” But, it was not foreseeable because the ITC rules require complainants to identify all asserted claims in the complaint and then only permit amendments thereto upon a heightened showing of “good cause” and on “conditions” that “avoid prejudice[e].” *See* 19 C.F.R. § 210.12(a)(9)(viii); 19 C.F.R. § 210.14(b)(1); *see also In the Matter of Certain Hsp Modems, Software & Hardware Components Thereof*, 337-TA-439, Ord. No. 12, at *2 (Feb. 8, 2001) (the “swift nature with which [ITC cases] proceed... militates against the late addition of new claims except in compelling circumstances.”) (citation/quotation omitted). Thus, Sonos was justified in relying on Google’s compliance with ITC rules in identifying the asserted claims in preparing Petition 1.

Exercising discretionary denial would encourage patent owners to engage in the same gamesmanship Google did and hide the ball on the asserted claims until after the filing of an IPR petition. Unfortunately, in turn, this would require petitioners to raise grounds on every claim of a patent, rather than just the ones asserted, for fear that the patent owner might amend to assert new claims and lock out petitioner’s ability to file an IPR on those claims. Of course, this wastes everyone’s resources in addressing claims that may never be asserted.

The Board previously found a second petition warranted in like circumstances. *See Usa v. Invs.*, IPR2019-01644, Paper 9, p.11 (PTAB Mar. 26, 2020) (finding “second petition is warranted,” where Patent Owner “delayed

assertion” of claims in parallel case until after filing of first petition). Google’s reliance on *Apple Inc. v. Koss Corp.* (Paper 7, p.3) is misplaced. That case involved the filing of a **third** petition, which merely “assert[ed] challenges and evidence identical to those asserted” in a third-party IPR that was filed two weeks **before** Apple’s **second** petition. See IPR2022-00053, Paper 10, p.3 (PTAB Apr. 4, 2022).

II. Google Materially Altered Its Construction After Petition 1 Was Filed

Prior to filing Petition 1, Google never indicated that it would interpret “detecting a voice input” as narrowly as it did in response to Petition 1. Its ITC and district court complaints suggested the exact opposite. Google attempts to argue that its complaint “did not set forth any affirmative interpretation of the claims ...” (Paper 7, p.4), but it didn’t have to. Google’s **application** of the claim indicated Google’s broad interpretation. Specifically, Google clearly asserted that “detecting a voice input” was satisfied by Sonos devices because “a user may **speak commands** to a [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.” Paper 3, p.2. It was only after Sonos filed Petition 1 that Google completely changed course, injecting a negative limitation to “detecting a voice input” such that Google’s interpretation demands “a process for identifying that an audio input includes voice” that is “**separate from performing speech recognition** (e.g., speech to text)....” *Id.* These two interpretations are clearly divergent.

Tellingly, Google does not argue that Sonos could have (or should have) foreseen Google’s attempted disclaimer before filing Petition 1. *See* Paper 7, p.3-5. Google only argues that the time between when Google advanced a similarly narrow interpretation in the ITC and Sonos’s filing of Petition 2 is too long. *See id.* But this is not the test. The proper test measures the time between when Google advanced its interpretation before the Board and the filing of Petition 2, since advancing the interpretation before the Board can create a prosecution disclaimer while advancing the interpretation before the ITC or district court cannot. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063 (Fed. Cir. 2016) (noting prosecution disclaimer requires “claims of a patent be interpreted in light of the proceedings in the *PTO*”) (emphasis added). Thus, any measure of diligence should be evaluated from the time Google first disclosed its position to the Board.¹ Here, such disclosure occurred when Google filed its POR to Petition 1 on June 30, 2023. This prompted Sonos to search for new art, consult with an expert, and file Petition 2—all *within 6 weeks* of

¹ Google misrepresents its ITC *Markman* positions. Paper 7, p.3. Google’s statement that “voice input detection and speech recognition are distinct processes” (*id.*) was in a “technology background” section referring to both the ’311 Patent and the unrelated ’748 Patent (*see* Ex.2001, p.2-7) and was thus not a clear explanation of how Google interpreted “detecting a voice input” in the ’311 Patent.

Google's disclosure. Thus, Sonos diligently filed Petition 2.

In its POPR, Google improperly uses *Axonics* as both a sword and a shield. *See* Paper 7, p.4. On the one hand, Google contends Sonos had an opportunity to respond to Google's new construction in Sonos's Reply to Petition 1. On the other hand, in its Sur-Reply to Petition 1, Google contends that Sonos cannot discuss certain evidence addressing Google's new construction because such evidence is allegedly new and not discussed in Petition 1. *See* IPR2022-01592, Paper 19, p.13. In this way, Google is inappropriately attempting to preclude Sonos from addressing Google's attempted disclaimer altogether.

Further, Google's reliance on *Guardant Health* (*see* Paper 7, p.5) is unavailing. Unlike that case, Sonos did not use a prior institution decision as a "roadmap" to guide its arguments in Petition 2. *See* IPR2022-01388, Paper 9, p.20 (PTAB Jan. 31, 2023). In other words, Petition 2 is not "refined based on lessons learned" from a prior institution decision. *See id.*, p.21.

III. Estoppel Would Not Prevent the Board from Proceeding with Petition 2 if Petition 1 Proceeds to Final Written Decision

Google baldly contends "estoppel will attach" to the Board's FWD stemming from Petition 1 and preclude it from deciding Petition 2. This is incorrect. Estoppel applies only to a ground that a petitioner "reasonably could have raised" and is measured using the "skilled searcher" standard, requiring a patent owner to prove that "a skilled searcher exercising reasonable diligence would have identified an

invalidity ground.” *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1299 (Fed. Cir. 2023). Google does not even attempt to satisfy its burden, nor could it.

Indeed, Google’s attempted disclaimer (which occurred *after* Sonos filed Petition 1) was not a foreseeable event for two reasons: (i) Google already interpreted the claim broadly for purposes of filing its complaints and (ii) the attempted disclaimer is one that finds no support in the priority document. No “skilled searcher” exercising “reasonable diligence” would have proceeded with the assumption that Google would interpret the claim contrary to how Google already interpreted it and do so in a way that annihilates its priority claim in order to locate prior art that meets this construction and is dated after the priority claim. As such, Petition 2’s grounds are not grounds that Sonos “reasonably could have raised.”

As it must, Google acknowledges “a dispute over priority may present a circumstance where multiple petitions are necessary....” Paper 7, p.6. Google’s only response is “Petitioner does not attempt to explain why a second IPR is necessary if the Board has already instituted an IPR where priority is not in dispute.” *Id.*, p.5. But if the Board rejects Google’s attempted disclaimer in Petition 1, Google will undoubtedly appeal to the Federal Circuit as it has previously done with each dispositive issue it has lost to Sonos. Petition 2 ensures that Google will not be able to delay and avoid the indisputable conclusion that the Challenged Claims are invalid even under Google’s unduly-narrow construction.

IV. Google's Application of *General Plastic* Factors Is Flawed

Google's application of *General Plastic* factors 1-3 is both legally and factually incorrect. The Board explains "factor 1 must be read in conjunction with factors 2 and 3," and "[w]here the first-filed petition under factor 1 ... otherwise was not evaluated on the merits, factors 1-3 only weigh in favor of discretionary denial when there are 'road-mapping' concerns under factor 3 or other concerns under factor 2." *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18, p.5 (PTAB Aug. 23, 2022). There are no "road-mapping" concerns here because the Board has yet to comment on the proper construction of "detecting a voice input," which means Sonos was not afforded commentary used to refine its position in Petition 2.

Further, with respect to factor 2, Google contends "Petitioner should have known of the asserted references as of the date of [Petition 1]" and "certainly Petitioner had reason to look for prior art that discloses *identifying that an audio input includes voice* when the claims themselves recite 'detecting a voice input.'" Paper 7, p.7 (emphasis original). To the contrary, Sonos could not have foreseen that Google would interpret the claims to require a negative limitation that finds no written description support in the priority document and was divergent from how Google had already broadly interpreted this claim element in its complaints.

Google also suggests that because the Piersol and Meyers references are cited amongst hundreds of other references on certain of Sonos's own patents, that

somehow means Sonos should have known about them soon after Google's new construction became known in the ITC. *See* Paper 7, p.8. This is absurd. Under Google's faulty logic, Google knows (or should know) of every patent that has ever issued by virtue of Google maintaining its patents.google.com database.

As explained, factors 4 and 5 also favor institution because Sonos searched for new art and filed Petition 2 within 6 weeks of Google's attempted disclaimer before the Board. And, Google's estoppel argument with respect to factors 6 and 7 is incorrect for the reasons discussed above. *Supra* §IV.

V. Google Relies on Mere Attorney Argument Regarding Peirsol & Meyers

Google's position that Peirsol and Meyers are not prior art (Paper 7, p.12-15) is supported solely by attorney argument and lacks testimony from a POSITA. Specifically, Google relies exclusively on attorney argument to contend the priority document supports its unduly-narrow interpretation of "detecting a voice input." But Dr. Johnson explained that the passages Google cites inform a POSITA that speech recognition is being used. *See* Petition, p.14; Ex.1002 ¶¶77-81. Thus, "there is no evidence to rebut the specific testimony of Petitioner's declarant"² that the Challenged Claims are not entitled to the date of the priority document.

² *General Electric Company v. United Technologies Corporation*, IPR2017-00428, Paper 8, 18 (PTAB, June 26, 2017).

Respectfully submitted,

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Dated: January 12, 2024

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CERTIFICATE OF SERVICE

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