

Filed: January 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.
Petitioner,

v.

GOOGLE LLC,
Patent Owner.

Case IPR2023-01284
U.S. Patent 11,024,311

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S PRE-INSTITUTION
REPLY**

The Board authorized Petitioner to submit an eight-page pre-institution reply (“Reply”) addressing Patent Owner’s “legal and factual characterizations regarding discretionary denial under 35 U.S.C. § 314(a) and that Piersol and Meyers are purportedly not prior art.” The Board also authorized a Sur-Reply of the same length.

I. NEITHER THE RANKING NOR PETITIONER’S REPLY JUSTIFY THIS SERIAL PETITION

Despite requesting supplemental briefing, Petitioner’s pre-institution reply repeats the same arguments made in its five page “justification” of the second petition. Petitioner confirms that it was not diligent in filing the instant petition and that it used the papers in the first-filed petition as a roadmap for filing the second. In sum:

- Petitioner does not dispute that Patent Owner asserted claim 19 *six* months before filing the instant petition (Reply, 1-3);
- Petitioner does not dispute that it could have challenged dependent claim 19 in the first-filed petition (Reply, 1-3);
- 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 construed “speech recognition” and “voice input detection” to be distinct processes *seven* months before filing the instant petition (Reply 3-5); and

- Petitioner does not dispute that it used Patent Owner’s Preliminary Response and Patent Owner’s Response in the first-filed petition to guide the instant petition (Reply 7).

These undisputed facts alone provide a sufficient basis to deny institution.

A. Petitioner Offers No Justification for Its Six-Month Delay in Challenging Claim 19

Petitioner never attempts to address Patent Owner’s argument that there is no justification for challenging dependent claim 19 six months after it was asserted in the ITC. POPR, 2-3; Reply, 1-3. The undisputed lack of diligence weighs in favor of discretionarily denying institution.

Unable to shed light on its delay, Petitioner argues that it was unforeseeable that claim 19 would be asserted because the ITC rules “only permit amendments to the asserted claims in the complaint “upon a heightened showing of ‘good cause’ and on ‘conditions’ that ‘avoid prejudice[e].’” Reply, 2. This argument only demonstrates that Petitioner knew the ITC could grant a request to amend the asserted claims after the complaint. It is clearly permitted by the ITC’s Rules, and *was allowed* in the parallel proceeding. Reply, 2.

Petitioner then argues that exercising discretionary denial would “encourage” patent owners to engage in gamesmanship and “require” petitioners to raise grounds on every claim “rather than just the ones asserted.” Reply, 2. That argument lacks

support. On the facts here, Petitioner acknowledges the “heightened” showing of good cause needed to amend asserted claims before the ITC—Patent Owner can hardly be accused of gamesmanship when such cause was found to exist.

Instead, the gamesmanship here is Petitioner’s. None of Petitioner’s “foreseeability” arguments excuse the six-month lapse between assertion of claim 19 and the filing of the second petition. The addition of claim 19 was an afterthought—Petitioner’s true goal is to rebut Patent Owner’s responses to the first-filed petition for all claims. These facts alone distinguish the instant case from *Mercedes-Benz USA*, where the second-filed petition was filed “less than two months” after the first *to join* another proceeding. IPR2019-01644, Paper 9, 10 (PTAB Mar. 26, 2020); Reply, 2.

B. Petitioner Does Not Dispute That It Was On Notice Of Patent Owner’s Construction 7 Months Before Filing The Instant Petition

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. Reply 4 (“Google advanced a similarly narrow construction in the ITC”). Instead, Petitioner argues that because these briefings did not rise to the level of “prosecution disclaimer” that Petitioner was not required to

diligently file its second petition at that time. Reply, 3-5. But “prosecution disclaimer” is not a prerequisite for filing a serial petition, and Petitioner does not cite any cases to establish that diligence ought to be measured from the date of a purported disclaimer. It cannot be true that Patent Owner’s complaint was sufficient to inform Petitioner’s grounds in the first-filed petition, but that its contentions and representations during *Markman* were somehow insufficient to inform the grounds for a second petition.

C. General Plastic Factors Favor Discretionary Denial.

Regarding factors 1-3, Petitioner argues that “[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 Sonos was not afforded commentary used to refine its position in Petition 2.” Reply, 7. That argument is incorrect. Petitioner does not deny using Patent Owner’s response to inform the instant petition. Instead, Petitioner makes it abundantly clear that everything, from the selection of its prior art to its treatment of certain claim limitations, and even the language of its expert’s testimony, are informed by Patent Owner’s Response. Reply, 4; Ranking, 2-3, Pet., 9, 11, 15.

Since claim construction of the term “detecting a voice input” may not be resolved by the Board until the Final Written Decision, Petitioner effectively argues that there are no road-mapping concerns unless and until the Board issues a Final

Written Decision. Reply, 7. Petitioner also attempts to distinguish *Guardant Health*, because Petitioner “did not use a prior institution decision as a ‘roadmap’ to guide its arguments” just Patent Owner’s Response. Reply, 5. This contradicts the express policy of the Board. The Board and Director have acknowledged on numerous occasions that road-mapping concerns arise where Petitioner has access to documents, including Patent Owner’s Response and expert testimony. *See e.g.*, IPR2018-00995, Paper 18, 10 (PTAB Nov. 13, 2018) (“Petitioner also had the Patent Owner’s Responses and Patent Owner’s expert testimony in the other related proceedings when the Petition was filed. Thus, the timing of Petitioner’s filing in this case raises the potential for abuse, because Petitioner had ample opportunity to study the arguments raised by Patent Owner.”) This is certainly the case here—accordingly, Petitioner’s road-mapping weighs in favor of discretionary denial.

Regarding factor 2, Petitioner does not dispute that it should have known about references Piersol and Meyers when it filed its first petition. Reply 7. Instead, Petitioner sidesteps the issue—arguing that it is “absurd” to expect Petitioner to have known that Peirsol and Meyers are cited on the face of its own patents in the same technical field of the challenged patent. Reply 7. 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. But even if Patent Owner’s construction was

unforeseeable at the time of the first-filed petition (it was not), it was certainly known several months before Petitioner allegedly began searching, and Petitioner's delay in searching and in filing the instant petition are equally unjustified. Accordingly, factor 2 weighs in favor of discretionary denial.

Regarding factors 6 and 7, Petitioner argues that estoppel would not attach because estoppel “only applies to a ground that a petitioner ‘reasonably could have raised’” and that *patent owners* bear the burden of proving that “a skilled searcher exercising reasonable diligence would have identified an invalidity ground.” Reply, 5-6 (quoting *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1299 (Fed. Cir. 2023)).

Petitioner, in stating that it “search[ed] for new art, consult[ed] with an expert, and file[d] Petition 2—all ***within 6 weeks***” proves that a skilled searcher exercising reasonable diligence could have found each of the references relied on for Grounds 1-2 at the time of the first-file petition. Reply, 4 (emphasis in original). Petitioner certainly could have raised Grounds 2A-2B, neither of which address the alleged priority dispute¹, at the time of the first filing. Pet. 3, 24-25, 29-31. Thus, estoppel will attach to all but claim 19 when the FWD issues for the first-filed petition. 35

¹ Both Masahide (published in 2003) and Jang (published 2013) were published before the priority date relied on in the first-filed petition. Pet. 24-25, 29-31.

USC §315(e)(1). The same is true for Grounds 1A-1B. That Petitioner allegedly could not foresee Patent Owner’s claim construction, or was unsure if it should raise Grounds 1A-1B, does not bear on the issue of whether it reasonably could have. Indeed, as the Trial Practice Guide acknowledges, petitioners may file parallel petitions—one of which addresses an alleged priority dispute. TPG., 59.

D. Petitioner’s Testimony Parrots The Petition And Ignores the Plain Language of the ’107 Patent Disclosure

Petitioner argues that there is no evidence to rebut the specific testimony of its expert, and suggests that Patent Owner’s arguments should be discounted on that basis alone. Reply, 8. But the expert testimony at ¶¶77-81 parrots the petition (*Compare* Ex. 1002, ¶¶77-81 *with* Pet., 19-20) and sheds no light on what the ’107 patent discloses—only on what other devices from the extrinsic evidence do “in some cases” and their potential to serve as a “promising future alternative.” Ex. 1002, 78. The testimony, like the petition, reads out the plain language of the ’107 patent which indicates that speech recognition on “audio data” is “initiated” after detecting a hotword. POPR, 13-14. Ex. 1001, claim 1, 1:14-17 (emphasis added).

Accordingly, Patent Owner submits that there is evidence to rebut the expert’s testimony for the purposes of institution.

II. CONCLUSION

For at least these reasons and those articulated in Patent Owner's Preliminary Response, the Board should exercise its discretion to deny the instant petition.

Date: January 19, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Sur-Reply to Petitioner's Pre-Institution Reply** was served upon the below-listed counsel on January 19, 2024 by email:

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