

Paper No. ____
Filed: August 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.
Petitioner,

v.

GOOGLE, LLC,
Patent Owner.

Case No. IPR2023-00806
U.S. Pat. No. 11,050,615

PATENT OWNER'S PRELIMINARY RESPONSE

Google requests denial of institution because Sonos's grounds fail to present a reasonable likelihood that any of the challenged claims of U.S. Pat. No. 11,050,615 (the "615 patent") are unpatentable. Of the challenged claims, claims 1, 11, and 16 are independent. The Petition proposes two alternative grounds for these claims: 1) a single reference obviousness ground based on Suumäki and 2) an obviousness ground based on the combination of Roberts and Asokan.

The requirements of obviousness are well established. Critical to the grounds here, an obviousness ground must include "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 401-02, 418 (2007). And that reason must be related to the "specific combination of prior art elements" proposed. *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012). The reason cannot be based simply "on what a skilled artisan would have been *able* to do," as such analysis leads to impermissible "hindsight bias;" rather, one must show "what a skilled artisan would have been *motivated* to do at the time of the invention." *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1068 (Fed. Cir. 2018). The need to provide a reason for a combination also applies to combinations of embodiments in a single reference. *Intel Corp. v. Qualcomm Inc.*, 2022-1046, 2023 WL 4196901 at *3 (Fed. Cir. June 27, 2023) (affirming a Board decision

finding that a petition failed to provide a motivation to combine different embodiments of a single reference).

I. SONOS PROVIDES NO EXPLANATION OF HOW OR WHY THE DIFFERENT EMBODIMENTS OF SUUMÄKI WOULD HAVE BEEN COMBINED

Sonos fails to provide a complete obviousness ground for Suumäki. Sonos admits that the Petition references different embodiments of Suumäki throughout its proposed mappings. Pet. at 4. But the Petition does not explain how or why those embodiments are proposed to be combined. Instead, it offers only a single conclusory paragraph on this topic:

While the above discussion of Suumäki refers, in some cases, to different embodiments, a POSITA would have been motivated to use these embodiments together and would have expected to succeed when doing so. (See Ex. 1003, ¶¶ 493-505.) Indeed, Suumäki itself says as much explaining that its system has broad, flexible applicability. It allows for the use of many different communication methods (e.g., Ex. 1005: 3:27-50), network commissioning functionality that can be alternatively implemented in either hardware or software (e.g., id., 24:43-58), and the transmission of various different types of network information from one device to another (e.g., id., 3:20-21, 25:60-46, 29:62-30:24).

Pet. at 73. Nothing in this paragraph explains how Petitioner proposes to combine the admittedly different embodiments of Suumäki or ties the stated motivations to

the specific modifications necessary to drive a skilled artisan to arrive at that combination, as required under Federal Circuit law. *See KSR Int'l Co.*, 550 U.S. at 401-02, 418; *ActiveVideo*, 694 F.3d at 1328. The Board has also found such sparse arguments insufficient because they require the Board to play archaeologist with the record rather than clearly setting forth the parties' position. *Ariosia Diagnostics v. Verinata Health, Inc.*, IPR 2013-00276, Paper No. 43 ("*Ariosia*"); *Athena Automation Ltd. v. Husky Injection Molding Systems Ltd.*, IPR2013-00290, Paper No. 45 ("*Athena*"). The Federal Circuit has also rejected obviousness arguments when the arguments failed to "clearly explain[] ... how the combination ... was supposed to work" or merely assert "what a skilled artisan would have been *able* to do," and not what the artisan would be motivated to do. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017); *Polaris*, 882 F.3d at 1068.

II. SONOS ALSO FAILS TO PROVIDE AN ADEQUATE REASON TO MODIFY ROBERTS WITH ASOKAN

Sonos relies on modifying Roberts with Asokan's teachings for claim elements [1-3], [11-3], [16-3] and claims 3, 5-8, and 19. Sonos fails to provide *any rationale* on why one skilled in the art would specifically combine Roberts and Asokan for these claim limitations, which, on its own, wholly undermines Sonos's attempt to combine Roberts and Asokan. *See* Pet. at 25-28 (merely asserting what Asokan discloses for claim element [1-3]), 34-40 (same for claims 3, 5-8), 43;

KSR, 550 U.S. at 401-02, 418; *ActiveVideo*, 694 F.3d at 1328. This is also improper under Sonos's own interpretation of what the law requires, as Sonos stated in another IPR proceeding:

To start, [Petitioner] provides no specific reason why a POSA would have been motivated to combine [the references] to achieve limitation 1-i. Petition, 45. Instead, [Patent Owner] improperly relies exclusively on its high-level reasons and reasons for limitation 1-f discussed above. *ActiveVideo*, 694 F.3d at 1328 (finding "generic" expert opinions that "bear[] no relation to any specific combination of prior art elements" insufficient).

Google LLC v. Sonos Inc., No. IPR2021-01563, Paper No. 22, at 58-59 (July 11, 2022).

The general motivations to combine that Sonos does assert are unpersuasive. Sonos's primary rationale merely identifies a feature in Asokan that is already described in Roberts. Pet. at 43-47. Specifically, Sonos asserts that a skilled artisan would be motivated to combine Roberts and Asokan because Asokan discloses out-of-band communication channels. Pet. at 44-45. But Sonos admits that this is disclosed in Roberts, which utilizes "out-of-band" communication paths as the "short-range signal transmission path." Pet. at 2-3, 46; *see also* Roberts, 6:62-65, 7:45-51.

The Federal Circuit has found this type of motivation to be improper. *See South-Tek Sys., LLC v. Engineered Corrosion Sols., LLC*, 748 Fed. Appx. 1003, 1006 (Fed. Cir. 2018) (finding insufficient motivation to combine two references when the primary reference already disclosed the feature disclosed in the secondary reference); *In re Anova Hearing Labs, Inc.*, 809 Fed. Appx. 840, 843 (Fed. Cir. 2020) (noting that when a primary prior art reference already provides a solution to a problem, there must be evidence as to why there would be a motivation to modify that primary reference to include an additional or redundant solution disclosed in a secondary reference).

The remaining arguments that Sonos asserts are conclusory and unpersuasive. Sonos argues that incorporating Asokan's teachings into Roberts's system would be "nothing more than a routine design choice," that the combined system "would continue to operate as intended," and that one skilled in the art "would [] have had a reasonable expectation of success" due to the similarities between Asokan and Roberts. Pet. at 46-47. But the Federal Circuit has also rejected such conclusory reasoning. *See ActiveVideo*, 694 F.3d at 1327 (rejecting motivations to combine that had no supporting "factual basis"); *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) ("[Federal Circuit]'s opinions have repeatedly recognized that conclusory expert testimony is inadequate to support an obviousness determination").

Lastly, Sonos asserts “easy management of guest access” as “[an]other benefit[]” of incorporating Asokan, but omits the details of how to modify Roberts to incorporate this benefit from Asokan. Pet. at 45. Again, the Federal Circuit has rejected an obviousness argument when the argument failed to “clearly explain[] ... how the combination of the two references was supposed to work.” *Personal Web Techs.*, 848 F.3d at 994. Sonos’s assertion also fails for relying on improper hindsight bias as, at most, it only shows “what a skilled artisan would have been *able* to do, rather than what a skilled artisan would have been *motivated* to do at the time of the invention.” *Polaris*, 882 F.3d at 1068.

Thus, even the motivation to combine arguments that Sonos does present are unpersuasive and fail to support that a skilled artisan would combine Roberts and Asokan, as Sonos attempts.

III. CONCLUSION

For the foregoing reasons, the Board should deny institution because Sonos fails to meet its burden to show a reasonable likelihood that one or more challenged claims are unpatentable.

Respectfully submitted,

Dated: August 22, 2023

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I, Cory C. Bell, certify that **PATENT OWNER'S PRELIMINARY RESPONSE** contains 1,329 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.

Dated: August 22, 2023

By: /Cory C. Bell/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on August 22, 2023, a copy of
PATENT OWNER'S PRELIMINARY RESPONSE was served upon the
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