

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC.,

Petitioner,

v.

JAWBONE INNOVATIONS, LLC,

Patent Owner.

Patent No. 10,779,080

Filing Date: July 22, 2013

Issue Date: September 15, 2020

Inventor: Gregory C. Burnett

Title: DUAL OMNIDIRECTIONAL MICROPHONE ARRAY (DOMA)

PATENT OWNER'S PRE-INSTITUTION SUR-REPLY

Case No. IPR2023-01065

TABLE OF CONTENTS

	<u>Page(s)</u>
I. INTRODUCTION	1
II. THE PETITION IDENTIFIED NO MOTIVATION TO IMPLEMENT IKEDA IN A HEADSET OR TO LOOK TO MCCOWAN TO IMPROVE A HEADSET	1
III. THE PETITION IDENTIFIED NO MOTIVATION TO USE KANAMORI TO IMPLEMENT A NEAR-FIELD DEVICE	3

EXHIBIT LIST

Exhibit No.	Description of Document
2001	Scheduling Order, Paper No. 13, <i>Google LLC v. Jawbone Innovations, LLC</i> , Case No. IPR2022-01059, entered December 7, 2022
2002	Declaration of Akbar M. Sayeed, Ph.D.
2003	Akbar M. Sayeed Curriculum Vitae
2004	Email from Russell W. Faegenburg to the Board, dated October 18, 2023

I. INTRODUCTION

Petitioner sought a reply to respond to issues raised in the POPR concerning “the significance of far-field versus near-field,” Ex. 2004, but the Reply does not address those issues. The Reply rehashes the Petition’s arguments without explaining how the near-field/far-field dichotomy affects Petitioner’s combination of far-field (Ikeda and Kanamori) and near-field (McCowan) references to arrive at a hypothetical near-field headset. The Reply is improper and should be disregarded.

II. THE PETITION IDENTIFIED NO MOTIVATION TO IMPLEMENT IKEDA IN A HEADSET OR TO LOOK TO MCCOWAN TO IMPROVE A HEADSET

The Reply concedes that the Petition presents no evidence why a POSITA would want to modify Ikeda to implement a headset. Petitioner rests on its argument that since a POSITA would know that a headset is a type of “hands-free telephone unit”—an example of a *far-field* application in Ikeda—a POSITA would be motivated to modify Ikeda to make a headset, a *near-field* application. Reply, 1-2. Like the Petition, the Reply does not articulate why mere *recognition* that a hands-free telephone unit could be adapted to a headset provides a *motivation* to do so. For this reason alone, the Petition should not be instituted.

The Reply begins by heavily redacting a statement from Patent Owner’s expert to create a rebuttable strawman. Reply, 1 (quoting Ex. 2002, ¶ 71). Patent Owner’s expert noted that Petitioner identified a POSITA’s desire to make a headset

as the motivation to modify Ikeda, but neither McCowan nor Kanamori discloses a headset, and the Petition did not rely on the desire to make a headset as the motivation to combine Ikeda with McCowan or Kanamori. Ex. 2002, ¶¶ 70-71. Petitioner does not contest that its Petition relies on shifting motivations to combine as it cherry-picks components from McCowan and Kanamori to reverse-engineer the patented apparatus. The Reply points to nothing in the Petition or Dr. Vipperman's Declaration to explain why a POSITA with the goal of creating a headset would look to McCowan's table-top microphone array device or Kanamori's far-field device for components to convert Ikeda's far-field device into a near-field headset. Reply at 1.

The Reply falsely claims that "Jawbone faults Sony for not including McCowan's large microphone array . . . in Ikeda" to support a facile bodily-incorporation argument. Reply, 2. Patent Owner actually argued that a POSITA would not have looked to McCowan to supply a component for making a headset when McCowan's device includes a massive microphone array that cannot be used in a headset. POPR, 24. Patent Owner also argued that Petitioner failed to show why a POSITA would look to McCowan to extract a single gain to incorporate into Ikeda's Vr circuit while ignoring McCowan's near-field superdirective beamformer solution for the Vm circuit. POPR, 25-26. Patent Owner never argued that the combination was not obvious because McCowan's microphone array could not be physically combined with Ikeda to make a headset.

Petitioner's Reply confuses the issue of whether McCowan's gain would work in an Ikeda-McCowan combination with whether a POSITA would have been motivated to make the combination in the first instance. Reply, 3. Again, Petitioner has no answer for why a POSITA seeking to make a headset effective across the entire frequency band for speech would look to McCowan's apparatus aimed at improving the *low frequency* directivity of a conventional adaptive beamformer. If the mere fact that a combination of components is operable were sufficient to provide a motivation to make the combination as Petitioner apparently presumes, the motivation to combine requirement would be rendered superfluous.

III. THE PETITION IDENTIFIED NO MOTIVATION TO USE KANAMORI TO IMPLEMENT A NEAR-FIELD DEVICE

Petitioner's Reply repeats that a POSITA would look to Kanamori to supply a Vm circuit (modified in hindsight) because it would allegedly result in better noise reduction. Reply, 3. Petitioner does not address, however, why a POSITA would look to a far-field reference like Kanamori to construct a near-field device. Petitioner requested a Reply to address that very issue but did not. Contrary to Petitioner's Reply, a Patent Owner is not required to show that a combination is inoperable in order to show that the Petitioner has failed to establish a motivation to combine. *Id.* Petitioner's failure to address the inconsistencies in its motivations to combine near-field and far-field references is fatal to its Petition. POPR, 28-29.

Respectfully submitted,

Dated: November 3, 2023

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CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Pre-Institution Sur-Reply and Exhibit
2004 have been served on Petitioner's counsel of record as follows:

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