

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.
Petitioner,

v.

GOOGLE, LLC,
Patent Owner.

Case No. IPR2023-01288
U.S. Pat. No. 9,632,748

PATENT OWNER'S PRE-INSTITUTION SUR-REPLY

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EXHIBIT LIST

Ex. 2001	<i>Certain Audio Players and Components Thereof (II)</i> , Inv. No. 337-TA-1330 (“1330 ITC Investigation”), Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond (Sept. 15, 2023)
Ex. 2002	Email exchange between Petitioner and Board
Ex. 2003	Email exchange between Petitioner's and Patent Owner's Counsel (Jan. 2-5, 2024)

The Board authorized Sonos to file a Pre-Institution Reply (“Reply”) to address the Preliminary Response’s contention “that the Petition fails to establish that Rosenberger anticipates the ‘determining... whether the first computing device should perform speech recognition on the spoken audio input’ limitation found in each challenged claim.” Ex. 2002, 1-2. Sonos never contends that any of Google’s arguments or characterizations are wrong—including Google’s explanation of how finding Rosenberger to anticipate would conflict with the Initial Determination at the ITC. Instead, Sonos only asks the Board to “disregard” them.

The Board should not disregard Google’s argument for at least four reasons. First, as explained in the Preliminary Response, disregarding Google’s argument would conflict with the prior decision at the ITC. Second, Sonos fails to identify what specific statement in the Preliminary Response is inconsistent with a position at the ITC. Third, Sonos’s own Pre-Institution Reply asserts that the arguments in the Preliminary Response are consistent with Sonos’s ultimately successful non-infringement arguments. Reply, 6-8. Fourth, Sonos fails to point to any precedent using unsuccessful arguments as a sword against a party (if one were to assume that Sonos’s characterization of Google’s ITC arguments were accurate). Instead, the fundamental tenant is that successful arguments—like Sonos’s non-infringement arguments—should be consistent with positions in later proceedings. *SkyHawke Techs., LLC v. Deca Int’l Corp.*, 828 F.3d 1373, 1376 (Fed. Cir. 2016)

(Judicial estoppel binds a party to a position that it advocated and successfully achieved.). Accordingly, the Board should deny institution because, under the ITC's conclusions on what meets the claims, Sonos's and Google's products do not practice the claims, and Rosenberger fails to anticipate them. Ex. 2001, 188-189.

Sonos also argues that Google violated its discovery obligations and duty of candor by not producing documents marked confidential and subject to an ITC protective order. The alleged inconsistency relates to domestic industry and infringement, which are not at issue here. The Board did not authorize this argument and should also disregard it because Google's arguments here are consistent with its ITC arguments. Further, while the ITC's Initial Determination adopted Google's arguments that Rosenberger does not anticipate, it did not adopt Google's arguments on infringement and domestic industry. For that additional reason, they are not material to this proceeding.

I. Google's Positions in this Proceeding are Consistent with its Positions at the ITC

Sonos fails to point out what statement in the Preliminary Response contradicts statements made at the ITC. Google takes the same validity position that it took at the ITC, and Google's ITC positions on infringement, domestic industry, claim construction, and invalidity, while nuanced, were not contradictory, as evidenced by the ALJ's Initial Determination. The Board can resolve the

validity issues here without relitigating, or otherwise reinterpreting, the issues and arguments the ITC already addressed. *See e.g., Arthrex, Inc. v. P Tech, LLC*, IPR2022-01043, Paper 22, FN 29 (PTAB 2023).

A. Neither Party is Relitigating the ALJ's Claim Construction

At the ITC, the parties litigated the construction of the “determine” element. As Sonos points out, the ALJ agreed with Google that the “determine” element leaves open whether speech recognition is performed before the determination is made. *See* Pet. Reply, 4-5. Sonos does not dispute that this construction was applied consistently by the ALJ in its Initial Determination. Indeed, neither party is relitigating the merits of this construction. *See* Pet., 8-9; *see generally* POPR. As described in more detail below, Google makes the same validity argument here as it did at the ITC, which is not at odds with the ALJ's claim construction.

Nothing in the claim precludes performing some speech recognition before the determination. Rather, what is required is that a determination be made, with a subsequent instruction to refrain from performing speech recognition being issued to certain devices in response. If all devices continuously perform speech recognition, then there can be no determination (and subsequent instruction) that certain devices should refrain from performing speech recognition.

Thus, there is nothing contradictory with respect to the claim construction between the two proceedings.

B. The ITC Agreed that Rosenberger's Continuous Speech Recognition Does not Anticipate the "Determine" Element

The Preliminary Response argues that Rosenberger does not anticipate the claims under the same theory Google won on at the ITC. POPR, 2-15. Rosenberger does not anticipate the "determine" element—not because Rosenberger recognizes speech *before* arbitration, but because Rosenberger's devices continuously recognize speech (i.e., none of Rosenberger's devices will ever refrain from performing speech recognition responsive to the required determination). *See* Ex. 2001, 49-51 ("[T]he other devices continuously perform speech recognition on whatever they hear, even after they stop 'handl[ing] the speech command.'" (quoting Rosenberger, 11:62-67)). Google is not disclaiming from the "determine" element situations where the first computing device recognizes speech *before* the determin[ation] is made and situations where the one or more additional computing devices recognize speech *before* they calculate and send their information to the first computing device, as accused by Sonos. The dispute is not whether a device recognizes speech *before* the determination. The dispute is whether Rosenberger's devices that continuously recognize speech, even after they are not selected to further process a spoken command, can anticipate the "determine" element because there is never a determination that they should refrain from performing speech recognition. This nuance was understood by the ALJ. *See* Ex. 2001, 34-45, 49-51.

C. Google's Unsuccessful Infringement and Domestic Industry Arguments at the ITC are Irrelevant to Whether Rosenberger Anticipates the Claims.

Sonos fails to identify any inconsistencies between Google's invalidity arguments at the ITC and those taken in this IPR. Pet. Reply, 3-8. Instead, Sonos appears to argue that Google's claim construction and validity arguments, which Sonos does not dispute do not vary from what was argued at the ITC, are contradictory to its infringement and domestic industry theories at the ITC. These positions are irrelevant to this proceeding.

While Google disagrees with Sonos's characterizations regarding inconsistencies, the Board need not weigh in on the complexities of the arguments at the ITC because infringement and domestic industry are not at issue in this case. Instead, the Board is permitted to rely upon the ALJ's findings, which Sonos does not argue are inconsistent. *See Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01456, Paper No. 10 at FN 10 (PTAB 2022). At the ITC, the ALJ found that for the same reason that neither the Sonos products nor Google products practice the asserted claims of the '748 patent, Rosenberger does not anticipate these claims. *See Ex. 2001*, 34-41, 42-45, 49-51. Specifically, the ALJ found that each of these devices—Sonos's, Google's, and Rosenberger's—perform continuous speech recognition, which negates the need to determine whether to perform speech recognition (or otherwise refrain from performing speech recognition) as required

by the claims. *Id.* If Sonos believed there were inconsistencies between Google's claim construction position and its infringement and domestic industry positions or with the ALJ's findings, the venue for that was the ITC.

II. Google has not Violated its Routine Discovery Obligations

In its Reply, Sonos makes vague allegations that Google violated its routine discovery obligations and duty of candor and good faith. This argument is not only outside the scope of authorized briefing but also wrong. Indeed, Sonos was unable to identify any specific statement in the Preliminary Response that is inconsistent despite Google's requests. *See* Ex. 2003, 2.

Sonos's motion does not accurately represent what transpired between the parties. Less than 72 hours before its Reply was filed, Sonos asked for Google's permission on the consent provision of the ITC protective order to submit more than twenty pages of documents marked confidential under the ITC protective order that include analysis of Google's source code for an active product. Ex. 2003, 4-5. Sonos first indicated that it would request the Board to apply the same provisions as the ITC protective order but later admitted that it knew the Board would not likely keep the prosecution bar. *Id.* at 2, 5. Google indicated that it would not give consent the next day and also explained that "Sonos's proposal to disseminate Google CBI on a selective basis ignores the ALJ's ultimate determination. There is no inconsistency in the ALJ's ruling on the issues of

invalidity and domestic industry.” *Id.* at 4. The next afternoon, Sonos for the first time demanded that these documents be produced under routine discovery along with various other threats. *Id.* at 3. Google immediately replied (in less than 15 minutes) and asked Sonos to identify the specific statements in the Preliminary Response that it claimed were inconsistent. *Id.* at 2-3. Sonos took the remainder of the day and, seeming unable to identify any inconsistent statement, cited the Preliminary Response’s entire argument back at Google after close of business. *Id.* at 2. Sonos then filed its Reply without waiting for a response from Google that further explained why it did not consent to production of the confidential documents.¹ Google made its best efforts to investigate Sonos’s assertions given the limited information from Sonos and ultimately decided and maintains that it did not take any inconsistent positions. Google’s reply to Sonos was provided at the same time in the early afternoon as Sonos’s response and Sonos did not correct its Brief to the Board nor has it responded to Google’s email since.

Google provided the Board with the ITC’s decision that summarized the dispute between the parties and its conclusions. *See* Ex. 2001. The Initial Determination shows that for infringement, domestic industry, and invalidity, the

¹ Sonos filed its Reply at 2:27 pm. Google replied to Sonos at 2:28 pm, less than six business hours from Sonos’s email.

parties disputed claim element [7.2], the “determine” element. Ex. 2001, 34-41, 42-45, 49-51, 188-189. Nothing in the Initial Determination indicates that the positions taken by either party were inconsistent for these issues. The Board also has the following ITC documents cited in Sonos's Petition: (1) Google's Initial Markman Brief in the 1330 Investigation; (2) the claim construction order; (3) excerpts of Google's infringement chart for the '748 patent; (4) redacted portions of Google's Interrogatory responses; and (5) redacted excerpts of the evidentiary hearing. Sonos's desire to put additional evidence before the Board does not make it routine discovery.

Finally, the Board did not authorize briefings on these topics, so these arguments should be disregarded. Sonos never indicated to the Board that discovery and duty of good faith and candor were issues that needed to be briefed. Ex. 2002, 1-2. Nor did Sonos alert the Board that it wanted relief from the ITC the protective order. *Id.*

III. Conclusion

The Board should deny institution because Rosenberger does not anticipate any challenged claim of the '748 patent.

Respectfully submitted,

Dated: January 12, 2024

By: /Erika H. Arner/
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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 PRE-INSTITUTION SUR-REPLY** is no more than eight pages, 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: January 12, 2024

By: /Cory C. Bell/
Cory C. Bell, Reg. No. 75,096

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on January 12, 2024, a copy of
PATENT OWNER'S PRE-INSTITUTION SUR-REPLY was served upon the
below-listed counsel by electronic mail:

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