

From: [Bell, Cory](#)
To: [Cole Richter](#); [Aguilar, Safiya](#); [Arner, Erika](#)
Cc: [Hines, Lisa](#); [Michael Boyea](#); [Jae Pak](#)
Subject: RE: IPR2023-01288 -- Petitioner's Pre-Institution Reply
Date: Friday, January 5, 2024 2:28:31 PM
Attachments: [image004.png](#)

Hi Cole,

Google disagrees with your assertions.

First, our position on timing is that Sonos should have raised all the relevant issues (i.e., not only the request to file a pre-institution reply, but also the need for a protective order and its request for discovery) when it made its initial request to the Board and when it originally reached out to Google (i.e., before it went to the Board). This would have allowed the Board to address all the related issues at once. Instead, Sonos took a piecemeal approach that denied both the Board and Google the opportunity to appreciate the full scope of Sonos' request when it was made. This also would have given the parties more time to negotiate Sonos' various requests.

Second, I was surprised to receive your related email about the protective order. You originally requested that "Google agree to counsel's submission of these excerpts on a Board and Patent Owner access only basis and simultaneous motion for entry of a protective order with provisions that provide the same protections as the -1330 protective order." But your email on the protective order sent last night after COB admits that you know that the "PTAB does not typically enter orders with such provisions." This alone is a valid reason why Google does not consent to Sonos' request.

Third, I asked you to identify which statement was made in the POPR that was inconsistent. You did not identify any. Instead, you generally cite our entire argument on Rosenberger (except one page). Because Sonos is seemingly unable to identify any inconsistent statement, we do not understand why Sonos believes it has a good faith basis for alleging any inconsistencies or threatening sanctions. We have made our best efforts to investigate Sonos' assertions given the limited information Sonos provided and are not aware of anything that should fall under the scope of routine discovery as explained in the Consolidated Trial Practice Guide.

Fourth, your email asserts that "Google took the opposite position in the ITC where at *Markman* and the contentions phase." This confirms that additional discovery is unwarranted. Sonos already cited and discussed the following ITC documents in the 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. Google's preliminary response also cited the public version of the Initial Determination that disagreed with Google's infringement and DI theories, which further diminishes any arguable relevance of Google's ITC contentions. Sonos' desire to cite additional ITC material is clearly outweighed by (1) its limited—if any—relevance and (2) the fact that this information is highly confidential and will likely not be afforded the same protections here as it was given in the ITC where it was originally produced. Indeed, Sonos' request for approximately 20 pages plus 20 paragraphs of CBI without any explanation as to why all the information would be necessary demonstrates that Sonos's request is unjustified. Furthermore, if Sonos wants relief from the ITC protective order, it would be more appropriate for Sonos to request that relief from the ITC.

Best,

Cory

From: Cole Richter <richter@ls3ip.com>
Sent: Thursday, January 4, 2024 5:31 PM
To: Bell, Cory <Cory.Bell@finnegan.com>; Aguilar, Safiya <Safiya.Aguilar@finnegan.com>; Arner, Erika <erika.arnner@finnegan.com>
Cc: Hines, Lisa <Lisa.Hines@finnegan.com>; Michael Boyea <boyea@ls3ip.com>; Jae Pak <pak@ls3ip.com>
Subject: RE: IPR2023-01288 -- Petitioner's Pre-Institution Reply

Cory,

Thanks for getting back to me. I'm having a little bit of a hard time understanding the timing aspect of Google's objection, which you've raised twice now. Are you saying that Google would have agreed if we had asked earlier or that Google doesn't have enough time to decide if it can agree? This is Google's own litigation positions and would be submitted under a protective order that provides the same protections as the ITC protective order. Nevertheless, Google should have already submitted this or otherwise apprised the Board under the routine discovery rule (at the time it filed its POPR) without Sonos having to request over Google's objection to providing it.

The inconsistent statements arose in Google's POPR. In Google's POPR, Google took the position that "*determine, based at least in part on information received from the one or more additional computing devices, whether the first computing device should perform speech recognition on the spoken audio input*" can't be satisfied when devices engage in some speech recognition before the determination is made and/or before the "*information*" is calculated and sent. POPR at 1-3, 5-13. By contrast, Google took the opposite position in the ITC where at *Markman* and the contentions phase, Google argued (and convinced the ALJ) that engaging in some speech recognition before the determination is made and/or before the "*information*" is calculated and sent falls within the scope of the claims.

Best,
Cole

From: Bell, Cory <Cory.Bell@finnegan.com>
Sent: Thursday, January 4, 2024 2:12 PM
To: Cole Richter <richter@ls3ip.com>; Aguilar, Safiya <Safiya.Aguilar@finnegan.com>; Arner, Erika <erika.arnner@finnegan.com>
Cc: Hines, Lisa <Lisa.Hines@finnegan.com>; Michael Boyea <boyea@ls3ip.com>; Jae Pak <pak@ls3ip.com>
Subject: RE: IPR2023-01288 -- Petitioner's Pre-Institution Reply

Hi Cole,

As Safiya previously stated, this would have been much easier to address this if Sonos had raised this before going to the Board in the first instance.

Sono still has not identified the specific statement in our preliminary it claims to be inconsistent. Can you please identify which statement in the preliminary response you are referring to in your email below?

Thanks,
Cory

From: Cole Richter <richter@ls3ip.com>
Sent: Thursday, January 4, 2024 1:56 PM
To: Aguilar, Safiya <Safiya.Aguilar@finnegan.com>; Arner, Erika <erika.arnner@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>
Cc: Hines, Lisa <Lisa.Hines@finnegan.com>; Michael Boyea <boyea@ls3ip.com>; Jae Pak <pak@ls3ip.com>
Subject: RE: IPR2023-01288 -- Petitioner's Pre-Institution Reply

EXTERNAL Email:

Safiya,

Thanks for the response. We understand that the ITC protective order prohibits use of CBI for purposes other than the Investigation, absent consent. That is why we asked Google if it would consent. You've indicated that Google "does not consent" but failed to explain why. The protective order does not mandate that Google decline consent. Does Google have a position on why it is declining to consent here?

The information that we would like to submit is information that is inconsistent with a position Google has advanced in its POPR. Specifically, the information is an example of Google interpreting the claims in the ITC in a way that directly contradicts its interpretation in this IPR. Google should have already submitted this information as routine discovery pursuant to 37 C.F.R. § 42.51. *See* 37 C.F.R. § 42.51(b)(1)(iii) ("Unless previously served, a party must serve relevant information that is inconsistent with a position advanced by the party during the proceeding concurrent with the filing of the documents or things that contains the inconsistency."). Google's failure to serve this information concurrently with the filing of its POPR, and its continued refusal to consent to its submission under the ITC protective order constitutes a violation of the Duty of Candor and Good Faith under Rules 1.56, 42.11, 11.106, and 11.303. *See, e.g.,* 37 C.F.R. § 1.56(b)(2)(ii) ("... information is material to patentability when ... it refutes, or is inconsistent with, a position the applicant takes in asserting an argument of patentability (cleaned up); *Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC*, IPR2021-00847, Paper 107 (P.T.A.B. May 3, 2023) ("This misconduct begins with the intentional failure of Patent Owner to serve or inform the Board of relevant information that is inconsistent with a position advanced by Patent Owner, which applies to its Response in all of the proceedings."). We urge you to reconsider.

Best,
Cole

From: Aguilar, Safiya <Safiya.Aguilar@finnegan.com>
Sent: Wednesday, January 3, 2024 6:35 PM
To: Cole Richter <richter@ls3ip.com>; Arner, Erika <erika.arner@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>
Cc: Hines, Lisa <Lisa.Hines@finnegan.com>; Michael Boyea <boyea@ls3ip.com>; Jae Pak <pak@ls3ip.com>
Subject: RE: IPR2023-01288 -- Petitioner's Pre-Institution Reply

Counsel,

Google does not agree.

First, this issue should have been raised at the time of the original request for supplemental briefing.

Second, the ITC protective order expressly prohibits use of CBI for purposes other than the Investigation, absent consent. Google does not consent.

Third, 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.

Regards,
Safiya

Safiya Aguilar
Associate

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW, Washington, DC 20001-4413
+1 202 408 4160 | fax +1 202 408 4400 | safiya.aguilar@finnegan.com | www.finnegan.com

From: Cole Richter <richter@ls3ip.com>
Sent: Tuesday, January 2, 2024 4:33 PM
To: Arner, Erika <erika.arner@finnegan.com>; Bell, Cory <Cory.Bell@finnegan.com>; Aguilar, Safiya <Safiya.Aguilar@finnegan.com>
Cc: Hines, Lisa <Lisa.Hines@finnegan.com>; Michael Boyea <boyea@ls3ip.com>; Jae Pak <pak@ls3ip.com>
Subject: IPR2023-01288 -- Petitioner's Pre-Institution Reply

EXTERNAL Email:

Counsel,

On 12/27, the Board authorized Sonos to file a pre-institution reply so that Sonos could, *inter alia*, “apprise the Board of Patent Owner’s arguments in the 1330 ITC Investigation where the ’748 Patent was at issue that are inconsistent with the arguments it now makes before the Board.” In order to do this, Sonos’s counsel would like to submit the following excerpts, which come from documents that Google marked CBI in the -1330 ITC Investigation.

1. Paragraphs 1320-1325 and 1360-1375 of Dr. Mahon’s 3/6/23 Initial Expert Report; and
2. Pages 17-36 of Google’s ’748 Final DI Contentions (2023.01.31 Supplemental Exhibit G).

Will Google agree to counsel’s submission of these excerpts on a Board and Patent Owner access only basis and simultaneous motion for entry of a protective order with provisions that provide the same protections as the -1330 protective order? We will redact any source code cites and references to variable names from these excerpts – so this information would not be submitted even under the Board and Patent Owner access only basis.

Please let us know if you need any further information and/or if you think a conferral on this issue would be productive.

Best,

Cole B. Richter



Lee Sullivan Shea & Smith LLP
656 W Randolph St, Ste. 5W, Chicago, IL 60661
312.754.9602 *Main* | 312.757.4478 *Direct*
richter@ls3ip.com | www.ls3ip.com

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

This e-mail message is intended only for individual(s) to whom it is addressed and may contain information that is privileged, confidential, proprietary, or otherwise exempt from disclosure under applicable law. If you believe you have received this message in error, please

advise the sender by return e-mail and delete it from your mailbox. Thank you.