

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SONOS, INC.,
Patent Owner.

Case No. IPR2025-01213
U.S. Patent No. 10,541,883

**PATENT OWNER SONOS, INC.'S REQUEST
FOR DISCRETIONARY DENIAL OF INSTITUTION**

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Exhibit	Description
2001 to 2100	RESERVED FOR PRELIMINARY RESPONSE
2101	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, D.I. 30, Oral Re Joint Stipulation Seeking Extension of Time to Respond (C.D. Cal. Mar. 4, 2020)
2102	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, D.I. 70, Order Lifting Stay (C.D. Cal. Dec. 27, 2024)
2103	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, D.I. 128, Order Setting Pretrial Deadlines (C.D. Cal. August 26, 2025)
2104	DocketNavigator, Time to Trial Statistics for California Central District from January 1, 2020 to September 11, 2025
2105	<i>Certain Audio Players and Controllers, Components Thereof, and Products Containing the Same</i> , No. 337-TA-1191, Commission Opinion Public Version (Feb. 1, 2022)
2106	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, D.I. 78, Joint Discovery Stipulation (C.D. Cal. Apr. 28, 2025)
2107	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, Google's First Amended Invalidity Contentions (C.D. Cal. Apr. 28, 2025)
2108	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, D.I. 101, Google's First Amended Answer and Counterclaims (C.D. Cal. July 25, 2025)
2109	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, D.I. 124, Sonos's Answer and Counterclaims (C.D. Cal. Aug. 15, 2025)
2110	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, Exhibit 883-02 (Cheshire) to Google's First Amended Invalidity Contentions (C.D. Cal. Apr. 28, 2025)
2111	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, Exhibit 883-B (Additional References) to Google's First Amended Invalidity

	Contentions (C.D. Cal. Apr. 28, 2025)
2112	<i>Certain Audio Players and Controllers, Components Thereof, and Products Containing the Same</i> , No. 337-TA-1191, Exhibit 896-11 (Meenan) to Google’s Final Invalidity Contentions (Sept. 4, 2020)
2113	Redacted, Public Version of ITC Expert Report of Dr. Shoemake, relevant excerpts only
2114	Side-by-side Comparison of Cheshire arguments in Petition with Redacted, Public Version of ITC Expert Report of Dr. Shoemake (Ex.2113)
2115	<i>Certain Audio Players and Controllers, Components Thereof, and Products Containing the Same</i> , No. 337-TA-1191, Exhibit 896-5 (Cheshire) to Google’s Final Invalidity Contentions (Sept. 4, 2020)
2116	<i>Certain Audio Players and Controllers, Components Thereof, and Products Containing the Same</i> , No. 337-TA-1191, Order No. 20, Construing the Terms of the Asserted Claims of the Patents at Issue, Public Version (Oct. 6, 2020)
2117	Sonos August 13, 2021 Notice Letter to Google
2118	<i>Certain Audio Players and Controllers, Components Thereof, and Products Containing the Same</i> , No. 337-TA-1191, Order No. 35, Initial Determination Granting Sonos’s Unopposed Motion for Summary Determination, Public Version (Feb. 4, 2021)
2119	<i>Certain Audio Players and Controllers, Components Thereof, and Products Containing the Same</i> , No. 337-TA-1191, Sonos’s Summary Determination Motion, Public Version (Dec. 4, 2020)
2120	U.S. Patent No. 10,965,545
2121	U.S. Patent No. 11,025,509
2122	U.S. Patent No. 11,025,509 file history, relevant excerpts only
2123	U.S. Patent No. 10,965,545 file history, relevant excerpts only
2124	Side-by-side comparison of ’883, ’545, and ’509 Patents

2125	Side-by-side comparison of U.S. Patent App. Pub. Nos. 2002/0174243 and 2002/0173273
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2127	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, Exhibit 883-09 (Airport Express) to Google’s First Amended Invalidity Contentions (C.D. Cal. Apr. 28, 2025)
2128	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, June 2025 Email Exchange Between Parties Concerning Claim Construction
2129	<i>Sonos, Inc. v. Google LLC</i> , 20-CV-00169, D.I. 97, Order RE Google’s Motion for Leave to Amend Answer and Counterclaims (C.D. Cal. July 15, 2025)

I. INTRODUCTION

Pursuant to the March 26, 2025 Memorandum titled “Interim Processes for PTAB Workload Management” (“Workload Memo”), Patent Owner Sonos, Inc. (“Sonos” or “Patent Owner”) respectfully requests that the Director exercise its discretion to deny institution of this *inter partes* review (IPR) filed by Petitioner Google LLC (“Google” or “Petitioner”) against U.S. Patent No. 10,541,883 (“’883 Patent”) under 35 U.S.C. §§ 314(a) and 325(d). The unique circumstances surrounding the challenged ’883 Patent present a clear case for discretionary denial under both of these sections.

The challenged ’883 Patent is directed to technology for setting up a playback device on a secure network and is currently being litigated in *Sonos, Inc. v. Google LLC*, 20-cv-00169 (C.D. Cal.) (“California Litigation”). That litigation involves nine other Sonos patents, including the closely related U.S. Patent No. 10,439,896 (“’896 Patent”)—which shares a common specification with the ’883 Patent—as well as two of Google’s own patents which are also related to setting up a device on a secure network—namely, U.S. Patent Nos. 9,485,790 and 12,132,608. Google previously argued to the California Court that judicial efficiency strongly favored adjudicating Sonos’s ’883 and ’896 Patents together with Google’s own two setup patents in a single proceeding. The California Court agreed with Google. Yet here, Google now seeks to carve out the ’883 Patent for separate review before the Board,

while continuing to litigate the other setup patents in California. Far from serving judicial efficiency, Google's maneuver underscores its vexatious litigation tactics.

Google's selective targeting of the '883 Patent in an IPR is no accident. Google is statutorily barred from filing an IPR against Sonos's related '896 Patent, which Sonos successfully asserted against Google over five years ago in ITC Investigation No. 337-TA-1191 ("ITC Investigation"). Unable to challenge the '896 Patent in an IPR, Google now argues that an IPR should be instituted against the closely related '883 Patent.

But regardless of whether this IPR is instituted against the challenged '883 Patent, the closely related '896 Patent will proceed in the California Litigation, and the California Court will therefore necessarily decide overlapping claim construction and validity issues that apply to both patents. Not only do these two related patents share the same priority chain and a common specification, their claims are directed to substantially the same setup technology, recite similar features, and use many of the same claim terms. *See supra* §II.B.1. In fact, Google itself describes Sonos's '883 and '896 Patents as “*two sides of the same coin.*” Ex.2107, 188-89. Google also relies on the *same* alleged prior art references to challenge both of these patents in the California Litigation. *Compare id.*, 60-67 with *id.*, 68-75. Instituting this IPR would therefore lead to duplicative proceedings, invite inconsistent outcomes, and unnecessarily waste the Board's resources—the exact inefficiencies Section 314(a)

is designed to prevent.

Setting that aside, the weak merits of this IPR make clear that denial is appropriate. This IPR is simply a rehash of abandoned invalidity positions Google unilaterally dropped in the ITC Investigation. In the ITC Investigation, Google argued that the closely related '896 Patent was invalid over Cheshire and Meenan—the same primary and secondary references Google now asserts here against the '883 Patent—only to abandon both references before trial in favor of other art Google deemed stronger. Despite presenting art that Google itself believed to be stronger than Cheshire and Meenan, the ITC upheld the validity of the '896 Patent. Given this, and the close relationship between the '883 and '896 Patents, Google's renewed reliance on second-tier references confirms that the Petition is objectively weak on the merits and should be denied under Section 314(a).

The Petition's objectively weak merits are further confirmed by the fact that all three references Google relies on were previously presented to and considered by the Office during prosecution of the '883 Patent and/or related continuation patents with substantially similar claims as the '883 Patent. In particular, with respect to Cheshire—the primary reference in all four Petition grounds—the same Examiner that reviewed the '883 Patent had both the Cheshire reference as well as Google's detailed invalidity contentions and expert analysis concerning Cheshire before him during prosecution of two such continuation patents. As to the secondary references,

both Meenan and a virtually identical Spurgat reference were considered during prosecution of the '883 Patent. Revisiting the same art under these circumstances would undermine the efficiency and consistency that Sections 314(a) and 325(d) are designed to protect.

At bottom, this Petition reflects Google's gamesmanship involving multiple patents related to setup technology, and its weak attempt at a do-over using the same art it chose to abandon at the ITC and the Office has already considered. Institution would undermine judicial efficiency, invite inconsistent outcomes, and needlessly burden both the Office and Sonos. The Director should therefore decline institution under both Sections 314(a) and 325(d).

II. DISCRETIONARY DENIAL IS WARRANTED UNDER SECTION 314(A)

The Director should deny institution of IPR under 35 U.S.C. § 314(a). It is well-settled that institution of IPR is discretionary. *See* 35 U.S.C. § 314(a) ("The Director may not authorize an inter partes review to be instituted unless..."); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding"); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion.").

The core of the Board's precedential decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020) ("*Fintiv*") focuses on whether

institution would promote efficiency, fairness, and align with the strength of the unpatentability challenge. *Fintiv*, 5-6. The Director’s Workload Memo lends further support to this approach by accounting for “all relevant considerations,” including, *inter alia*, the strength of the unpatentability challenge, the extent of the petition’s reliance on expert testimony, and settled expectations of the parties, among others. Workload Memo, 2-3. As discussed below, all the *Fintiv* factors and five additional “relevant considerations” weigh decisively in favor of denying institution.

A. The *Fintiv* Factors Favor Discretionary Denial

Fintiv identifies the following non-exclusive six factors for the Director to consider in deciding whether to exercise discretion to deny institution based on parallel proceedings involving the same patent:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and

6. other circumstances that impact the [Director]’s exercise of discretion, including the merits.

Fintiv, 5-6. When the Director evaluates these factors, it is to take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*, 6.

Given the unique circumstances here, all six *Fintiv* factors favor discretionary denial as set forth below. As Google itself previously argued, the California Court is best positioned to resolve overlapping issues involving the challenged ’883 Patent and its related ’896 Patent, as well as Google’s own asserted setup patents, together in one proceeding.

1. Factor 1 Favors Denial: Stay of California Litigation Is Unrealistic

Factor 1 favors denial as there is no viable basis for a stay in the California Litigation based on this IPR, and Google has not sought one.

The California Litigation involves not only the ’883 Patent, but also nine other Sonos patents and two Google patents. Critically, Google is statutorily barred from challenging five of the asserted Sonos patents in an IPR. Accordingly, this IPR cannot meaningfully simplify the broader California Litigation. *See also infra* §II.A.4. And courts in the Central District of California routinely deny stay motions under similar circumstances. *See, e.g.,*:

- *Realtime Adaptive Streaming LLC v. Google LLC*, Case No. 18-CV-3629, 2019 WL 13039329, at *3 (C.D. Cal. May 6, 2019) (“[T]he fact that [defendant] has only filed an IPR petition for one of the seven asserted patents ... strongly warrants against a stay.”); and
- *Entropic Commc'ns, LLC v. DISH Network Corp.*, Case No. 23-CV-01043, 2025 WL 519639, at *3 (C.D. Cal. Feb. 13, 2025) (denying stay because PTAB instituted review of only two patents, and “[t]he PTAB proceedings thus cannot offer any possible simplification with respect to eight of the 10 remaining patents.”).

Moreover, a stay would cause significant competitive harm to Sonos because Google and Sonos are direct competitors. Unsurprisingly, courts in the Central District of California are “generally reluctant to grant a stay” under these circumstances. *Inneos LLC v. Opticis Co.*, Case No. 23-CV-185, 2023 WL 6787821, at *3 (C.D. Cal. Sept. 13, 2023) (recognizing “infringement among competitors can cause harm in the marketplace that is not compensable by readily calculable money damages” and thus finding “undue prejudice factor weighs against granting a stay.”) (citation omitted).

Further, Google itself is fully aware that a stay is not viable. The California Litigation was already stayed once for nearly five years pending the ITC Investigation and Federal Circuit appeal. *See* Ex.2101. Since that stay was lifted (*see* Ex.2102) and this IPR was filed, Google has never once proposed another stay. Instead, Google has intensified its efforts in the California Litigation, pursuing a

scorched-earth strategy focused on alleged prior art.

Factor 1 therefore favors denial.

2. Factor 2 Favors Denial: Trial May Precede FWD Deadline and Risk of Inconsistent Outcomes Looms Regardless of Trial Date

Factor 2 favors denial for at least two reasons.

First, despite the California Court not yet setting a trial date for the California Litigation, it remains possible that trial will occur *before* the projected FWD on January 17, 2027.

The California Litigation commenced in January 2020 and resumed on December 27, 2024 after a nearly five-year long stay. *See* Exs.2101-2102. And the current schedule has all discovery ending on May 11, 2026 and briefing on dispositive motions ending on June 1, 2026. Ex.2103, 2. While no trial date has

been set¹, the median time-to-trial² for patent cases in the Central District of California is approximately 20 months. Ex.2104. Applying the 20-month median time-to-trial to the date the stay was lifted on December 27, 2024 would place a potential trial around August 27, 2026—nearly five months before the projected FWD. Moreover, even if the case progresses more slowly, there remains a meaningful chance that trial could still occur before the Board’s FWD.

Second, even if the FWD were to precede trial in the California Litigation, Factor 2 would still favor denial here because of the unique circumstances surrounding the challenged ’883 Patent.

As with other *Fintiv* factors, the core purpose of Factor 2 is to determine whether institution might result in duplicative effort and inconsistent rulings across forums. *See, e.g., Samsung Electronics America, Inc. f/k/a Samsung*

¹ Not having a trial date for the California Litigation is not unusual and does not reflect the case’s maturity as the California Court’s standard practice is to assign a trial date at the final pretrial conference, which is typically held weeks before trial. *See* Ex.2103, 2 (“The trial estimate will be set at the final pretrial conference.”).

² The Director routinely considers median time-to-trial statistics as part of the Factor 2 analysis. *See, e.g., Cellco Partnership d/b/a Verizon Wireless et al v. Procomm International Pte. Ltd.*, IPR2024-01455, Paper 15, *2 (PTAB May 16, 2025).

Telecommunications America LLC et al v. Cerence Operating Company, IPR2025-00457, Paper 13, at *2 (PTAB Aug. 4, 2025); *Transcend Information Inc. v. Truesight Communications LLC*, IPR2025-00723, Paper 10, at *2 (PTAB Aug. 4, 2025). Here, as previously mentioned, even if this IPR proceeds against the '883 Patent, and even if the FWD were to precede trial in the California Litigation, overlapping claim construction and validity issues will still be litigated and tried in the California Litigation for Sonos's closely related '896 Patent. Institution would therefore split the dispute across forums, leading to duplicative effort and inviting inconsistent outcomes.

For these reasons, Factor 2 favors denial.

3. Factor 3 Favors Denial: Substantial Resources Have Been Invested in the Related ITC Investigation and Parallel California Litigation

Factor 3 also favors denial because the parties have already invested—and will continue to invest—substantial resources leading up to the institution decision.

The dispute between the parties began more than five years ago when Sonos filed its original complaint in the California Litigation on January 7, 2020, asserting five of the ten Sonos patents now at issue. On the same day, Sonos also initiated the ITC Investigation asserting those same five patents, which resulted in a stay of the California Litigation pending resolution of the ITC Investigation. While the California Litigation was stayed for nearly five years, the parties fully litigated the

five originally asserted Sonos patents (including the closely related '896 Patent) at the ITC and Federal Circuit.

In the ITC Investigation, the parties served infringement and invalidity contentions, completed fact and expert discovery, filed dispositive motions, submitted pre-hearing briefs, and tried the case in an evidentiary hearing. The ALJ issued multiple substantive rulings in the process, including a *Markman* order, a summary determination, and an initial determination on infringement and validity. Ultimately, the Commission reviewed the record and issued a final opinion upholding the validity of all five Sonos patents, ruling that Google's non-redesigned products infringed all five Sonos patents, and finding that Google violated Section 337 of the Tariff Act of 1930, 19 U.S.C. §1337. Ex.2105. The Board has found that Factor 3 favors denial in cases involving far less progress in an ITC investigation while the parallel district court case was stayed. *See, e.g.:*

- *Kiss Nail Prods., Inc. v. Lashify, Inc.*, PGR2021-00046, 2021 WL 3504569, at *5 (PTAB Aug. 9, 2021) (finding “[t]his factor weighs against institution” because “[a]lthough the district court litigations were stayed pending the ITC Investigation, the parties, the ALJ, and the staff in the ITC Investigation have expended considerable time and resources on the investigation.”);
- *Sk Innovation Co., Ltd. v. Lg Chem, Ltd.*, IPR2020-00982, 2020 WL 7029006, at *5 (PTAB Nov. 30, 2020) (finding this factor weighs against institution because, while the district court proceeding was stayed, “the ITC and the parties have made substantial investments in the ITC proceeding, in

the form of addressing claim construction and completing fact discovery, and in view of the hearing scheduled”).

The parties’ substantial investment did not stop there. Both parties appealed certain of the Commission’s findings to the Federal Circuit. Google appealed infringement and validity findings, including infringement and validity findings concerning the closely related ’896 Patent, while Sonos appealed the Commission’s noninfringement findings for Google’s redesigns, including noninfringement of the ’896 Patent. The parties devoted extensive resources from briefing to oral argument. Ultimately, the Federal Circuit affirmed the Commission’s findings in full. *See Sonos, Inc. v. International Trade Commission*, No. 2022-1421, 2024 WL 1507605 (Fed. Cir. Apr. 8, 2024).

Following the Federal Circuit decision, Judge Kronstadt lifted the stay of the California Litigation on December 27, 2024. Ex.2102. To preserve the substantial work already done, the parties expressly agreed to “use any discovery, including any document, interrogatory response, response to request for admission, privilege log, or deposition transcript that was produced or offered by the other party in [the ITC Investigation] as if the discovery had been provided in [the California Litigation].” Ex.2106, 10. Google’s own invalidity contentions further state that it “anticipates [] to raise all invalidity and unenforceability arguments based on those raised in [the ITC Investigation] also in this litigation ... and thus incorporates its positions from

[the ITC Investigation] by reference into [its invalidity contentions].” Ex.2107, 12.

The California Court has also entered an aggressive scheduling order notwithstanding the complexity and large scope of the California Litigation. *See* Ex.2103. Today, the litigation involves 10 asserted Sonos patents, 2 asserted Google patents, dozens of accused Google products (along with software apps), at least a dozen accused Sonos products, 14 affirmative defenses and 2 counterclaims from Google, and 14 affirmative defenses and 6 counterclaims from Sonos. *See* Exs.2108-2109. The parties have already exchanged and continue to amend their initial infringement and invalidity contentions. Google’s invalidity contentions for the ’883 Patent *alone* include an identification of around 140 prior art references (11 of which are charted, 7 of which are system art), invalidity grounds under § 101 and § 102(f), and at least 8 different invalidity grounds under § 112 while leaving the door open to add more § 112 grounds during expert discovery. *See* Ex.2107, 68-81, 107-22, 185-94, 213-15, 228-29, 247-48, 251.

Significantly, by the January 17, 2026 institution decision deadline, all *Markman* briefing in the California Litigation will be complete. The *Markman* hearing is scheduled for December 2025, with an order expected by January 20, 2026. *See* Ex.2103. Thus, Judge Kronstadt will likely issue the *Markman* order only shortly after, if not before, the institution decision deadline. As a result, by the institution decision deadline, there will likely be a *Markman* order in the California

Litigation addressing both the '883 Patent and the closely related '896 Patent (as well as Google's two setup patents), in addition to the already-issued *Markman* order from the ITC Investigation addressing the '896 Patent.

In sum, the parties, the ITC, the ITC staff, the Federal Circuit, and the California Court have already invested substantial resources over the past five years, and the parties and California Court will continue to do so in the months ahead as the California Litigation progresses. Instituting review would disregard these many years of investment. Thus, Factor 3 favors denial.

4. Factor 4 Favors Denial: Petition Issues Substantially Overlap with California Litigation and Google's *Sotera* Stipulation Fails to Prevent Wasteful Parallel Proceedings

Factor 4 also favors denial. As an initial matter, there is substantial overlap between the claims, grounds, and arguments raised in the Petition and Google's invalidity contentions in the California Litigation.

As to the claims, the challenged claims in this IPR largely mirror those already at issue in the California Litigation, with Google adding only independent claim 20 and dependent claims 3, 6-8, 12, and 18 here. For these additional claims, however, Google simply refers back to arguments from overlapping claims, repackages those arguments without meaningful distinction, and/or relies on the same underlying disclosures. *See, e.g.,*:

- Pet., 29-30 (claim 3 repurposing arguments from limitation 1e.2(a));

- *id.*, 57 (claim 6 referring back to claim 4);
- *id.*, 31 (claim 7 referring back to claim 3);
- *id.*, 32 (claim 8 relying on same disclosure from limitation 1(a));
- *id.*, 34 (claim 12 referring back to limitation 1e.3);
- *id.*, 61 (claim 18 referring back to claim 6); and
- *id.*, 38-40 (claim 20 referring back to claim 1).

As to the grounds and arguments, Google’s invalidity contentions in the California Litigation include the same primary reference Google relies on here for all four Grounds 1-3B, Cheshire, as well as one of Google’s secondary references, Spurgat, including a Cheshire and Spurgat combination (Ground 3A). Ex.2107, 68-69; Ex.2110 (charting Cheshire); Ex.2111, 26, 36, 39, 42, 45 (charting Spurgat, among other secondary references). Although the remaining secondary reference, Meenan, is not expressly identified in Google’s invalidity contentions, Google incorporates by reference “all invalidity and unenforceability arguments” raised in the ITC Investigation, where Google relied on Meenan in connection with the closely related ’896 Patent. *See supra* §II.A.3; Ex.2112 (charting Meenan in the ITC Investigation). The Petition also largely repackages the same Cheshire arguments advanced (unsuccessfully) by Google in the ITC Investigation. *See* Ex.2114 (comparing Petition’s claim 1 arguments to ITC expert testimony).

Amid this substantial overlap, Google offered a *Sotera* stipulation on August 15, 2025, stating:

Google hereby stipulates that, if the PTAB institutes IPR2025-01213 on the grounds presented in the Petition challenging the claims of the '883 patent, Google will not pursue in this district court litigation the same grounds in the petition or any grounds that reasonably could have been raised during the IPR with respect to the patent claims subjected to the instituted IPR (i.e., any ground that reasonably could have been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications).

Google's *Sotera* stipulation above is not intended and should not be construed to limit Google's ability to assert invalidity of any claims of the asserted patents in this litigation based on any other ground.

Ex.1022. As the Recission Memo states, such a stipulation is "highly relevant, but will not be dispositive by itself." Recission Memo, 2-3.

Here, Google's narrowly tailored *Sotera* stipulation is practically meaningless for several reasons.

First, Google relies on the ***same*** alleged prior art references in the California Litigation for both the '833 and '896 Patents, including Cheshire and Spurgat. *Compare* Ex.2107, 60-67 *with id.*, 68-75. As a result, despite the *Sotera* stipulation, Google remains free to pursue the same invalidity grounds in the California Litigation against the related '896 Patent that it raises or could have raised here against the '883 Patent. This defeats the purpose of a *Sotera* stipulation and

undermines the *Sotera* Board’s rationale for Factor 4, which is to “mitigate[] any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12, p.19 (PTAB Dec. 1, 2020).

Second, Google’s *Sotera* stipulation is narrowly crafted to preserve its ability to assert system art in the California Litigation. In fact, Google’s invalidity contentions already rely on seven separate systems as primary references (*see* Ex.2107, 68), with Cheshire (the primary patent reference here for all four Grounds 1-3B) allegedly describing the operation of one of those systems—namely, Apple’s Airport Express system. Ex.2127, 2 (Google asserting that Apple’s Airport Express system is described in Cheshire). This confirms that this IPR is no “true alternative” to the California Litigation. *See Sap Am., Inc. v. Cyandia, Inc.*, IPR2024-01432, 2025 WL 1092308, at *4 (PTAB Apr. 7, 2025) (finding Factor 4 favored denial despite *Sotera* stipulation because the publications asserted in the IPR were described in system art asserted in the parallel litigation); *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, *3-4 (PTAB Mar. 28, 2025).

Third, the Federal Circuit’s recent decision in *Ingenico Inc. v. IOENGINE, LLC* casts significant doubt on whether a *Sotera* stipulation is meaningful in any event. 136 F.4th 1354 (Fed. Cir. May 7, 2025). In *Ingenico*, the Federal Circuit interpreted the word “ground”—found in a *Sotera* stipulation like Google’s—

narrowly in the context of IPR estoppel under 35 U.S.C. § 315(e)(2). 136 F.4th at 1365-66. The Federal Circuit made clear that “a ground is *not* the prior art asserted during an IPR” and “IPR estoppel does *not* preclude a petitioner from asserting the *same* prior art raised in an IPR in district court, but rather precludes a petitioner from asserting grounds that were raised or reasonably could have been raised during an IPR.” *Id.* (emphasis added). In other words, the Federal Circuit explained “IPR estoppel does *not* preclude a petitioner from relying *on the same patents and printed publications* as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Id.*, 1366 (emphasis added).

The Federal Circuit’s interpretation of the word “ground” in connection with IPRs likewise limits the scope of a *Sotera* stipulation. For example, a Petitioner that agrees to a *Sotera* stipulation can lose before the Board in arguing a given prior art publication anticipates challenged claims but get a second bite at the apple by arguing before a district court that the same prior art publication renders the challenged claims obvious in combination with system art (whether related to the publication or not) that was known or used by others, on sale, or in public use, even if that obviousness combination relies almost exclusively on the disclosure of the prior art publication and gap fills with the system art.

This is analogous to the situation here where Google relies on the disclosure of the Cheshire patent reference to support its Airport Express system art. *See generally* Ex.2127 (relying on Cheshire throughout claim chart). This further undermines the *Sotera* Board’s rationale for Factor 4. *Sotera Wireless*, IPR2020-01019, Paper 12, p.19. As such, a *Sotera* stipulation in view of the Federal Circuit’s interpretation of the word “ground” no longer ensures that an IPR is a “true alternative” to a district court proceeding. *Id.* (quoting *Sand Revolution II, LLC v. Cont’l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at *7 (PTAB June 16, 2020)).

Given the extensive overlap between Google’s Petition here and its invalidity contentions in the California Litigation and the ineffectiveness of Google’s *Sotera* stipulation, Factor 4 favors denial.

5. Factor 5 Favors Denial: The Parties Overlap

Factor 5 favors denial because the same parties are involved in this IPR and the parallel California Litigation.

6. Factor 6 Favors Denial: The Merits of Google’s Arguments Are Weak

Factor 6 favors denial because Google’s invalidity grounds are objectively weak. *See, e.g., Innolux Corp. v. Phenix Longhorn LLC*, IPR2025-00043, Paper No. 10, p.13 (PTAB May 15, 2025) (finding weakness of petitioner’s arguments

“determinative” “for application of [Board’s] discretion overall” to deny institution).

This weakness is evident from at least the following:

- (1) Google abandoned its Cheshire and Meenan arguments before trial in the ITC Investigation in favor of art Google itself considered stronger. Yet, the ITC still upheld the validity of the closely related ’896 Patent (*supra* §II.B.1);
- (2) Google’s Petition improperly relies on general POSITA knowledge to supply missing limitations (*supra* §II.B.5); and
- (3) The Office previously considered all three of the references relied on in the Petition, along with Google’s final invalidity chart and expert analysis concerning Cheshire, during prosecution of the ’883 Patent family (*supra* §III.A).

Given the foregoing, filing of a Preliminary Patent Owner’s Response is unnecessary. But if Sonos chooses to file one, it will only underscore why the Petition fails to show a reasonable likelihood of success. And should the Board nevertheless institute this IPR, Sonos will demonstrate the patentability of every challenged claim.

7. Summary of *Fintiv* Factors

In summary, all six *Fintiv* factors favor denial, making this a very strong case for discretionary denial under Section 314(a).

B. Other Considerations Also Favor Discretionary Denial

The Workload Memo identifies additional considerations that the Director may consider for discretionary denial, including:

1. Whether the PTAB or another forum has already adjudicated the

- validity or patentability of the challenged patent claims;
2. Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
 3. The strength of the unpatentability challenge;
 4. The extent of the petition's reliance on expert testimony;
 5. Settled expectations of the parties, such as the length of time the claims have been in force;
 6. Compelling economic, public health, or national security interests; and
 7. Any other considerations bearing on the Director's discretion.

Workload Memo, 2.

As explained below, several of these considerations further favor denial.

1. Google's Abandonment of Cheshire and Meenan in the ITC Investigation, Followed by the ITC's Finding of Validity of the Related '896 Patent, Favors Denial

Pursuant to the Workload Memo, the Director may consider “[w]hether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims.” Workload Memo, 2. Here, as previously discussed, the validity of the closely related '896 Patent was fully litigated in the ITC Investigation—and Google lost. Ex.2105. The Federal Circuit affirmed. This consideration therefore strongly favors discretionary denial.

In the ITC Investigation, Google argued that the closely related '896 Patent was invalid over the *same* references it now asserts in this IPR against the '883 Patent—namely, Cheshire (the primary reference for all four Grounds 1-3B) and

Meenan (a secondary reference for Grounds 2 and 3B). *See* Ex.2112; Ex.2115. In this regard, Google charted Cheshire (*see id.*) in its final invalidity contentions and had its own expert devote 67 pages of testimony to its teachings. *See* Ex.2113. But after a detailed rebuttal from Sonos’s expert identifying Cheshire’s deficiencies, Google abandoned Cheshire and did not present it at the ITC trial. Meenan, which was also charted in Google’s final ITC invalidity contentions (Ex.2112), was abandoned even earlier—before expert discovery began. Google’s decision to abandon these references speaks volumes: by its own assessment, Cheshire and Meenan were not worth pursuing at trial.

Now, after the ITC upheld the validity of the closely related ’896 Patent over the art Google deemed stronger, Google seeks to resurrect Cheshire and Meenan in this IPR against the ’883 Patent. Worse, Google largely repackages the same Cheshire-based theories its ITC expert advanced in the ITC Investigation. Ex.2114 (comparing Petition’s claim 1 arguments to ITC expert testimony). But if Google did not believe Cheshire and Meenan were strong enough to invalidate the ’896 Patent, there is no credible reason to believe they would fare any better against the ’883 Patent.

Google itself has described the ’833 and ’896 Patents as “two sides of the same coin.” Ex.2107, 188-89. Google’s characterization stems from the complementary nature of the two patents: the ’883 Patent is directed to a “*playback*

device” configured to be set up via a “*computing device*,” and the ’896 Patent is directed to a “*computing device*” configured to set up a “*playback device*.” *Id.* Unsurprisingly, these two patents share numerous overlapping claim terms. For illustration, the functions recited in independent claim 1 of each patent are presented below, with overlapping claim language annotated:

'883 Patent	'896 Patent
1. A <i>playback device</i> comprising: ... program instructions ... to perform functions comprising:	1. A <i>computing device</i> comprising: ... program instructions ... to perform functions comprising:
detecting a triggering event that causes the playback device to enter a setup mode in which the playback device transmits at least a first message indicating that the playback device is available for setup;	while operating on a secure wireless local area network (WLAN) that is defined by an access point, (a) receiving, via a graphical user interface (GUI) associated with an application for controlling one or more playback devices, user input indicating that a user wishes to set up a playback device to operate on the secure WLAN and (b) receiving a first message indicating that a given playback device is available for setup;
while in the setup mode, receiving a response to the first message that facilitates establishing an initial communication path with a computing device that is installed with an application for controlling the playback device, wherein the computing device is operating on a secure wireless local area network (WLAN) that is defined by an access point, wherein the initial communication path with the computing device does not traverse the access point;	after receiving the user input and receiving the first message, transmitting a response to the first message that facilitates establishing an initial communication path with the given playback device, wherein the initial communication path with the given playback device does not traverse the access point;
receiving, from the computing device via the initial communication path, at least a second message containing network configuration parameters for the secure WLAN, wherein the network configuration parameters comprise an identifier of the secure WLAN and a security key for the secure WLAN;	transmitting, to the given playback device via the initial communication path, at least a second message containing network configuration parameters, wherein the network configuration parameters comprise an identifier of the secure WLAN and a security key for the secure WLAN;
using the network configuration parameters to connect to the secure WLAN that is defined by the access point; and	after transmitting at least the second message containing the network configuration parameters, detecting an indication that the given playback device has successfully received the network configuration parameters; and
transitioning from communicating with the computing device via the initial communication path to communicating with the computing device via the secure WLAN that is defined by the access point.	after detecting the indication, transitioning from communicating with the given playback device via the initial communication path to communicating with the given playback device via the secure WLAN that is defined by the access point.

Further underscoring the close relationship between the two patents, Google notes that during prosecution of the '883 Patent Sonos filed a terminal disclaimer referencing the '896 Patent. Ex.2107, 189.

In short, Google already had its shot with Cheshire and Meenan—and chose to walk away. The ITC upheld the '896 Patent's validity, and the Federal Circuit affirmed. Rehashing references Google itself previously relegated to second-tier status and abandoned would only waste the Board's time and resources. This consideration therefore favors discretionary denial.

2. Risk of Competing Claim Constructions Favors Denial

The Board may consider “[a]ny other considerations bearing on the Director’s discretion.” Workload Memo, 2. A compelling consideration here is the substantial risk of competing claim constructions involving the related '883 and '896 Patents. This makes the California Court the more appropriate forum to resolve these disputes.

Critically, regardless of whether this IPR is instituted against the '883 Patent, the closely related '896 Patent will proceed in the California Litigation, and the California Court will therefore necessarily decide overlapping claim construction and validity issues that apply to both patents. Instituting this IPR would therefore inject unnecessary risk of competing constructions and inconsistent outcomes.

That risk is magnified by Google’s inconsistent claim construction positions concerning the ’883 Patent. In this IPR, Google insists that “no construction is necessary.” Pet., 3. But weeks before filing its Petition, Google had already agreed with Sonos to the constructions of several terms (annotated in green) and was actively disputing the construction of another term (annotated in red) in the California Litigation:

- *“at least a second message containing network configuration parameters [for the secure WLAN], wherein the network configuration parameters comprise an identifier of the secure WLAN and a security key for the secure WLAN”*
- *“the [given] playback device is configured to play back audio content in synchrony with at least the first playback device”*
- *“playback device”*
- *“network interface”*
- *“initial communication path”*
- *“an application for controlling [one or more / the] playback devices”*

Ex.2128, 1-4, 6-7.

Google’s strategic omission of these constructions here creates a substantial risk that parallel proceedings will result in the same claim terms being construed inconsistently.

That risk extends even further in view of the ITC Investigation. The ITC construed additional overlapping terms appearing in both the ’883 and ’896 Patents

—namely, “*wireless local area network (WLAN)*” and “*security key*”—that were not identified by the parties in the California Litigation. Ex.2116, 17-21, 28-31. Deferring to the California Court to consider the parties’ and the ITC’s constructions will ensure consistent interpretations across both the ’833 and ’896 Patents. In contrast, construing the ’883 Patent in isolation invites conflicting interpretations and inconsistent validity outcomes.

Given the foregoing, the California Court is best positioned to resolve overlapping claim construction issues across both the ’833 and ’896 Patents efficiently and consistently. Accordingly, the Board should exercise its discretion to deny institution.

3. Google’s Clear Gamesmanship Favors Denial

Another compelling consideration bearing on the Director’s discretion is Google’s gamesmanship—reflected in its shifting positions driven by immediate interests rather than consistency or candor.

For background, to justify adding two of its own setup patents in the California Litigation, Google represented to the California Court that its patents “***substantially overlap*** with, and indeed, ***mirror*** Sonos’s claims,” and that “there will be significant overlap in discovery between these claims and those asserted [by Sonos], as well as in any affirmative defenses.” Ex.2129, 4.

At the hearing on Google's motion to add its patents, Google's counsel reiterated to the California Court that claim construction issues will overlap not just between the '833 and '896 Patents, but also with Google's setup patents:

[MR. PAK—Google's Counsel:] That raises one of the issues that Your Honor asked counsel about, which is *will there be overlapping claim construction. We absolutely believe there will be*, both in terms of access point as well as other elements that are covered in both sets of claims. So there will be *not only factual overlap but there will be overlap in terms of legal issues.*

Ex.2126, 11:4-10.

When pressed further by the California Court, Google's counsel doubled down:

THE COURT: [] *Do you see any overlap --*

MR. PAK: *Yeah.*

THE COURT: -- *in claim construction?*

MR. PAK: I do, Your Honor, and the reason for that is although the claim language is slightly different, for example, the Sonos patent talks about an access point, for example, and there are other limitations that are going to be at issue with respect to the Sonos patents and the Google patents use different words, *it's the same area of technology*, Your Honor. And I do -- *I do contemplate overlap, both in terms of the technology tutorial and Your Honor's decision on some of those claims construction issues.*

Id., 20:3-15.

Based on Google’s representations, the California Court ultimately agreed, holding that “judicial efficiency will be promoted” by allowing Google to add its patents to the case. Ex.2129, 7.

Yet here, Google seeks to carve out the ’883 Patent for separate review before the Board, while continuing to litigate it in California alongside the closely related ’896 Patent and its own setup patents. Far from promoting judicial efficiency, instituting this IPR would only reward Google’s gamesmanship.

Further underscoring its gamesmanship, Google has also taken inconsistent positions before the Office concerning the ’883 Patent and its own two patents. In this IPR, Google insists that Sonos’s ’883 Patent claims were obvious over the prior art as of June 2004. Yet, to procure its own setup patents—which Google itself proclaims “*substantially overlap* with, and indeed, *mirror* Sonos’s claims” of the ’883 Patent—Google repeatedly represented to the Office that its claims were novel and non-obvious as late as April 2012. Google cannot have it both ways. If Google’s later-filed setup patents are valid over the prior art, then so is Sonos’s earlier-filed ’883 Patent. Google’s flatly inconsistent representations to the Office do not reflect a principled application of patent law. Instituting this IPR would reward Google’s opportunistic tactics that undermine the integrity of the Office.

Discretionary denial is therefore warranted.

4. Overlapping Expert Disputes Across Multiple Patents as Well as Google’s Overreliance on Expert Testimony—Including Reliance on General POSITA Knowledge to Supply Missing Claim Limitations—Favors Denial

As noted above, “[t]he extent of the petition’s reliance on expert testimony” is a consideration set forth in the Workload Memo. This consideration favors discretionary denial here for several reasons.

First, the prudent course is to deny institution and let the California Court resolve overlapping expert disputes. Regardless of this IPR’s outcome, experts for both parties will testify in the California Litigation concerning the closely related ’896 Patent. That makes the California Court better positioned to address expert disputes that span both the ’896 and ’883 Patents, which share a common specification and claim substantially the same setup technology, as explained above. In contrast, instituting this IPR would split related expert testimony across two different forums and invite inconsistent outcomes.

Second, institution would inevitably create reasonable disputes between experts on dispositive issues that are better resolved in the California Court. Indeed, if instituted, Sonos’s expert will directly rebut Dr. Lipoff’s flawed analysis, creating a classic “battle of the experts” better resolved in the California Litigation, where a jury can assess the credibility of the experts in person.

Third, Google’s Petition improperly relies extensively on the unfocused testimony of Dr. Lipoff, which consists of 299 paragraphs spanning nearly 156 pages

and lacks the hallmarks of offering helpful context or explanation about terms of art. *See generally* Ex.1003. For instance, Google relies on Dr. Lipoff’s testimony as a crutch to supply numerous claim limitations missing from its relied-on references and to patch up clear deficiencies in its obviousness theories.

As one example, for its lead ground (Ground 1), Google tries to supply missing claim limitations under the guise of “the knowledge of a POSITA.” *See generally* Pet., 4-40. However, both Federal Circuit and Board precedent make clear that such practice is rarely accepted—and only in cases where the missing limitation is “unusually simple” and the technology “particularly straightforward.” *See, e.g.,*:

- *DSS Tech. Mgmt. Inc. v. Apple Inc.*, 885 F.3d 1367, 1374 (Fed. Cir. 2018) (rejecting Board’s reliance on “common knowledge” to “supply a missing limitation” related to wireless communication network technology);
- *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016) (rejecting Board’s reliance on “common sense” to “supply a missing limitation” related to computer-implemented searching technology);
- *Motorola Mobility LLC v. Largan Precision Co. Ltd.*, IPR2024-00689, 2025 WL 26137, *10 (PTAB Jan. 3, 2025) (denying institution where Petitioner tried to rely on “general knowledge to supply missing claim limitation” related to lens technology and explaining that “given that Petitioner relies on a single reference to argue obviousness, its reliance on numerous additional texts, articles and patent publications—purportedly used to establish the state of the art as of the August 2014 priority date of the ’845 patent—but actually used to fill in missing claim requirements absent from Fukaya—is not appropriate”);

- *Microsoft Corp. v. LiTL LLC*, IPR2024-00457, 2024 WL 4044511, *9-10 (PTAB Sept. 4, 2024) (denying institution where Petitioner tried to rely on “common sense” to “fill in a missing limitation” related to computer display technology).

Google’s use of general POSITA knowledge does not fall within the narrow exceptions recognized by Federal Circuit and Board precedent and, in some instances, the Petition even goes so far as to improperly alter Cheshire’s teachings under the pretext of general POSITA knowledge. Particularly when viewed through the lens of a June 2004 invention date (over two decades ago), the limitations Google seeks to supply through expert testimony are not “unusually simple” and the claimed technology is not “particularly straightforward.” *See, e.g.,*:

- Pet., 16 (“[A] POSITA would have known or found it obvious that existing device 102 *is installed with an application for controlling the playback device.*”);
- *Id.*, 22 (“A POSITA would have understood or found it obvious that existing network 112 *is defined by an access point*”);
- *Id.*, 24 (“A POSITA would have understood or found it obvious that the communication between new device 104 and existing device 102 during configuration *does not traverse the access point.*”);
- *Id.*, 19, 21 (modifying Cheshire’s FIG. 3 to supply missing limitations under the pretext of “the knowledge of a POSITA”):

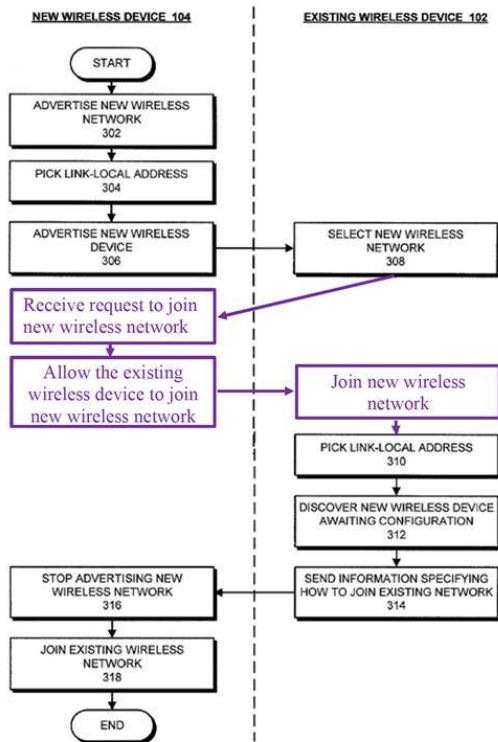


FIG. 3

EX1005, Fig. 3 (modified; annotated).

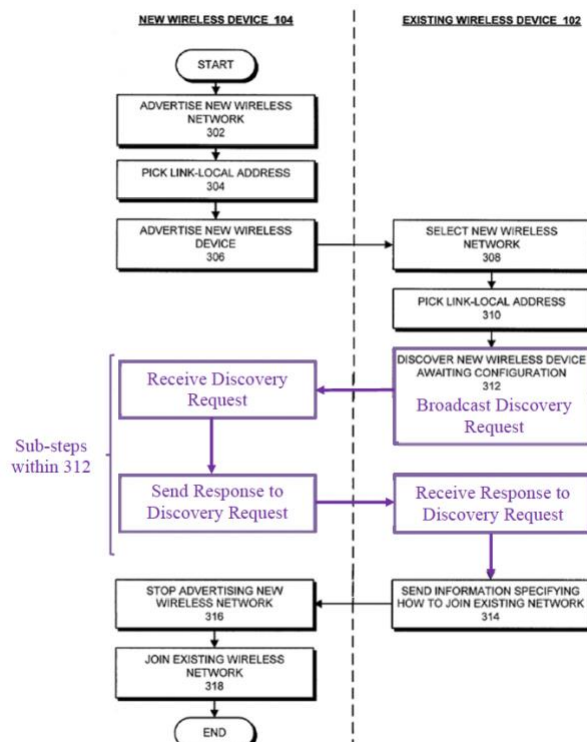


FIG. 3

EX1005, Fig. 3 (modified; annotated); EX1003, ¶125.

- *Id.*, 30 (“[A] POSITA would have found it obvious to configure new device 104 to be controlled by existing device 102 over existing network 112 because remote controlling audio devices were known and common.”); and
- *Id.*, 33 (“A POSITA would have known or found it obvious that communication between new device 104 and existing device 102 would have included receiving a command related to playback of audio content....”).

Although not necessarily governing this IPR due to its filing date, the Director’s July 31, 2025 Memorandum titled “Enforcement and Non-Waiver of 37 C.F.R. § 42.104(B)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews” (“July 31, 2025 Memo”) reinforces that Google’s reliance on general POSITA knowledge to supply missing limitations is improper. *See* July 31, 2025

Memo, 1 (stating that “general knowledge” “may not be used to supply a missing claim limitation.”).

In sum, discretionary denial is warranted given the overlapping expert disputes involving both the ’896 and ’883 Patents that will be litigated in the California Litigation, as well as Google’s overreliance on unfocused expert testimony—including its improper reliance on general POSITA knowledge to supply missing limitations. The Board’s resources would be better spent on other petitions that pose little risk of inconsistent outcomes and rely on the strength of the prior art; not on expert overreach.

5. Settled Expectations of the Parties Favor Denial

Another consideration the Director may weigh is the “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” This consideration favors denial for three main reasons.

First, the Director made clear that “there is no bright-line rule on when expectations become settled.” *Dabico Airport Sols. v. AXA Power ApS*, IPR2025-00408, Paper 21, at *3 (June 18, 2025). But here, the ’883 Patent (and the closely related ’896 Patent) has been in force for over five years. During that time, Google had actual knowledge of the ’883 Patent (and the ’896 Patent) but waited until now to challenge it in an IPR.

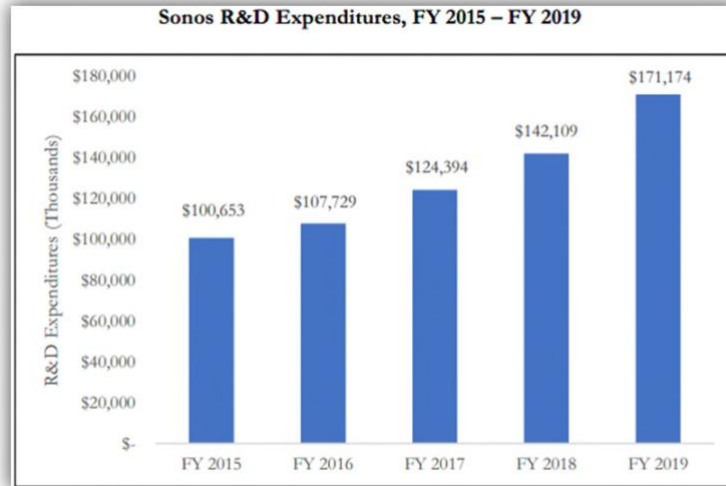
For context, the '883 Patent traces back to an original non-provisional patent application filing from June 6, 2005 that issued on December 4, 2012 as U.S. Patent No. 8,326,951 (“the '951 Patent”) and a provisional application filing from June 5, 2004. Ex.1001, codes (63), (60). The '883 Patent issued on January 21, 2020, and expired on June 6, 2025. Ex.1001, codes (45), (*). Despite its recent expiration, Google had actual notice of the '883 Patent since at least August 13, 2021, and of the closely related '896 Patent since at least January 6, 2020. Ex.2117, 5, 27. Against this backdrop, the parties’ expectations as to validity and enforceability are firmly settled. And with both the ITC and Federal Circuit having already upheld the validity of the '896 Patent, Google’s attempt to relitigate validity —this time against the '883 Patent—should be rejected.

Second, the Director also emphasized that a petitioner’s awareness of the patent owner’s involvement in the “same technology space for a significant amount of time before filing” an IPR favors discretionary denial. *Murata Mfg. Co., Ltd. v. Georgia Tech. Research Corp.*, IPR2025-00383, Paper 14, *2-3 (July 29, 2025). Here, the parties’ discussions about Sonos’s setup technology date back to at least August 2016. Ex. 2117, 3-4 (summarizing the parties’ 2016 discussions). Around that time, Sonos even put Google on notice of one of its setup patents—namely, the '951 Patent, from which the '883 Patent descends. Thus, Google has known for

nearly a decade that Sonos was actively patenting and investing in setup technology before filing this IPR.

Third, settled expectations also arise from substantial investment in the patented technology. As the Director explained, settled expectations are particularly strong where “an extraordinary amount of investment, time, and resources dedicated to research, development, trials, and regulatory approval correlates to settled expectations.” *Amgen Inc v Bristol-Myers Squibb Co*, IPR2025-00601, Paper 9, at *2 (July 24, 2025). That is exactly the case here.

Sonos has invested millions in developing its patented setup technology. In the ITC Investigation, the ALJ found on summary determination that Sonos’s R&D efforts were extensive and patent-specific, including with respect to the closely related ’896 Patent. Ex.2118, 2-3. Sonos corroborated this with a 45-page brief detailing years of R&D labor, equipment, and facilities devoted to developing its “wireless speakers and the applications that control them,” including “product setup” functionality. Ex.2119, 8, 13-14, 28, 40, 15 (showing Sono’s R&D expenditures from 2015-2019):



Faced with this overwhelming record, Google did not even attempt to oppose Sonos’s motion. Ex.2118, 1. Thus, Sonos’s well-documented investment in its patented setup technology weighs heavily in favor of discretionary denial.

In short, Google chose to ignore the ’883 Patent for years—despite having actual knowledge of (1) the patent itself, (2) Sonos’s long-standing presence in the patented setup technology space, and (3) Sonos’s substantial investment in its patented setup technology. At this stage, the firmly settled expectations of the parties foreclose Google’s belated IPR challenge.

6. Summary of Additional Considerations

In sum, at least five additional considerations weigh in favor of denial.

III. DISCRETIONARY DENIAL IS WARRANTED UNDER SECTION 325(D)

35 U.S.C. § 325(d) provides that the Director may deny institution when “the same or substantially the same prior art or arguments previously were presented to

the Office.” 35 U.S.C. § 325(d). The Board’s *Advanced Bionics* decision provides a two-part framework for evaluating whether denial under Section 325(d) is warranted: (1) whether the same or substantially the same prior art or argument was previously presented to the Office; and (2) if the first part is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, 2020 WL 740292, at *3 (PTAB Feb. 13, 2020). The *Advanced Bionics* framework “reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.*

The Board also explained that *Becton Dickinson* provides useful factors in applying the *Advanced Bionics* framework. The *Becton Dickinson* factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson and Co. v. B. Braun Melsungen AG, IPR2017- 01586, Paper 8 at 17 (PTAB Dec. 15, 2017).

The Board further explained that *Becton Dickinson* factors (a), (b), and (d) provide insight into whether the same or substantially the same art or arguments were previously presented to the Office (i.e., the first part of the *Advanced Bionics* framework), and *Becton Dickinson* factors (c), (e), and (f) provide insight into whether the petitioner has shown the Office materially erred (i.e., the second part of the *Advanced Bionics* framework). *Advanced Bionics*, 2020 WL 740292, at *4.

A. *Advanced Bionics*, Part 1—Each Reference Was Previously Presented to and Considered by the Office

As set forth below, the Petition relies on four different grounds based on three different references. Specifically, the Petition relies on primary reference Cheshire for all four Grounds 1-3B, secondary reference Meenan for Grounds 2 and 3B, and secondary reference Spurgat for Grounds 3A and 3B.

Grounds	Claims	Basis	Prior Art
1	1-3, 7-8, 10, 12, 14-15, 20	§103	Cheshire in view of the knowledge of a POSITA
2	1-10, 12, 14-18, 20	§103	Cheshire, Meenan
3A	1-3, 7-8, 10-15, 19	§103	Cheshire, Spurgat

Grounds	Claims	Basis	Prior Art
3B	1-19	§103	Cheshire, Meenan, and Spurgat

Pet., 1-2.

As explained below, each of these references was previously presented to and considered by the Office.

1. Cheshire Was Previously Presented and Considered Multiple Times

The Board has made clear that a reference cited in an IDS during prosecution of a continuation application qualifies as a reference previously presented to the Office under Section 325(d)—particularly where “the [continuation] claims were determined by Examiner to not be patentably distinct from the claims of the [challenged] patent.” *Ivantis, Inc. v. Sight Scis., Inc.*, IPR2022-01529, 2023 WL 2588217, at *7 (PTAB Mar. 21, 2023). That is exactly the case here with Cheshire.

Cheshire was cited by Sonos in an IDS and considered by the Examiner³ during prosecution of continuation applications that issued as U.S. Patent Nos. 10,965,545 (“the ’545 Patent”) and 11,025,509 (“the ’509 Patent”). The ’545 Patent is a continuation of the ’883 Patent, and the ’509 Patent is a continuation of the ’545 Patent. As shown below, Cheshire is listed on the face of both the ’545 and ’509 Patents:

7,483,538 B2	1/2009	McCarty et al.	7,483,538 B2	1/2009	McCarty et al.
7,483,540 B2	1/2009	Rabinowitz et al.	7,483,540 B2	1/2009	Rabinowitz et al.
7,483,958 B1	1/2009	Elabbady et al.	7,483,958 B1	1/2009	Elabbady et al.
7,492,912 B2	2/2009	Chung et al.	7,492,912 B2	2/2009	Chung et al.
7,505,889 B2	3/2009	Salmonsens et al.	7,505,889 B2	3/2009	Salmonsens et al.
7,509,181 B2	3/2009	Champion	7,509,181 B2	3/2009	Champion
7,519,667 B1	4/2009	Capps	7,519,667 B1	4/2009	Capps
7,532,862 B2	5/2009	Cheshire	7,532,862 B2	5/2009	Cheshire
7,548,744 B2	6/2009	Oesterling et al.	7,548,744 B2	6/2009	Oesterling et al.
7,548,851 B1	6/2009	Lau et al.	7,548,851 B1	6/2009	Lau et al.

Ex.2120, 5; Ex.2121, 5.

Moreover, the Examiner did not just consider the Cheshire patent on its own. During prosecution of each of the ’545 and ’509 Patents, the Examiner also considered Google’s detailed final invalidity contentions from the 1191 ITC Investigation, including Google’s Cheshire claim chart (the same chart cited here as Ex.2115), and its expert’s invalidity report concerning Cheshire. This is also confirmed on the face of both the ’545 and ’509 Patents:

³ The same Examiner who examined the ’883 Patent also examined the continuation applications that issued as the ’545 and ’509 Patents.

Sonos, Inc. v. Google LLC. Order 20: Construing the Terms of the Asserted Claims of the Patents at Issue dated Sep. 25, 2020, 53 pages.

Sonos, Inc. v. Google LLC. Respondents' Final Invalidity Claims Charts for US Pat. No. 10,439,896, Exhibits 1-13, 15-16, and B, 1324 pages.

Sonos, Inc. v. Google LLC. Respondents' Final Invalidity Contentions [Redacted] dated 4 Sep. 2020, 261 pages.

Sound Blaster Wireless Music Network Setup, 28 pages. [produced by Google in Inv. No. 337-TA-1191 on Sep. 1, 2020].

Kangas, Mauri. Authentication and Authorization in Universal Plug and Play Home Networks. Helsinki University of Technology, 12 pages [produced by Google in Inv. No. 337-TA-1191 on December 9, 2020].

Notice of Allowance dated Nov. 30, 2020, issued in connection with U.S. Appl. No. 17/018,401, filed Sep. 11, 2020, 9 pages.

Sonos, Inc. v. Google LLC, Expert Report of Matthew B. Shoemaker, Ph.D., Regarding the Invalidity of U.S. Pat. No. 10,439,896 [Redacted Dec. 9, 2020] dated Oct. 23, 2020, 659 pages.

Universal Serial Bus Specification Revision 1.1 Sep. 23, 1998, 327 pages. [produced by Google in Inv. No. 337-TA-1191 on Dec. 9, 2020].

OTHER PUBLICATIONS

Sonos, Inc. v. Google LLC. Order 20: Construing the Terms of the Asserted Claims of the Patents at Issue dated Sep. 25, 2020, 53 pages.

Sonos, Inc. v. Google LLC. Respondents' Final Invalidity Claims Charts for US Pat. No. 10,439,896, Exhibits 1-13, 15-16, and B, 1324 pages.

Notice of Allowance dated Aug. 26, 2019, issued in connection with U.S. Appl. No. 16/298,542, filed Mar. 11, 2019, 8 pages.

Kangas, Mauri. Authentication and Authorization in Universal Plug and Play Home Networks. Helsinki University of Technology, 12 pages [produced by Google in Inv. No. 337-TA-1191 on Dec. 9, 2020].

Sonos, Inc. v. Google LLC, Expert Report of Matthew B. Shoemaker Ph.D., Regarding the Invalidity of U.S. Pat. No. 10,439,896 [Redacted Dec. 9, 2020] dated Oct. 23, 2020, 659 pages.

Universal Serial Bus Specification Revision 1.1 Sep. 23, 1998, 327 pages. [produced by Google in Inv. No. 337-TA-1191 on Dec. 9, 2020].

Ex.2120, 26-27; Ex.2121, 16, 27. As previously mentioned, the Petition largely recycles the same Cheshire arguments set forth in the expert report cited during prosecution of each of the '545 and '509 Patents. Ex.2114 (comparing Petition's claim 1 arguments to ITC expert testimony).

Yet, even with the benefit of Google's comprehensive contentions and expert analysis on Cheshire, the Examiner still found no basis for a rejection. That conclusion is telling—and aligns with Google's own decision to abandon Cheshire before trial in the ITC Investigation. *Supra* §II.B.1.

Further, during prosecution of the '509 Patent application, the Examiner contacted Sonos's representative to request the filing of a terminal disclaimer because the Examiner determined that the '509 Patent claims were not patentably distinct from those in the '883 Patent. Ex.2122, 8. Sonos complied by filing a terminal disclaimer on the '883 Patent application. *Id.*, 1-2.

Similarly, during prosecution of the '545 Patent application, the Examiner issued a non-statutory obviousness-type double patenting rejection over the '896 Patent. Ex.2123, 3-5. The Examiner stated that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other.” *Id.*, 4. Sonos complied by filing a terminal disclaimer on the '896 Patent application (*id.*, 43-44)—just as it had done during prosecution of the '883 Patent. Ex.2107, 189.

In sum, because Cheshire was considered during prosecution of multiple continuation applications, and the Examiner determined that the continuation claims were not patentably distinct from the '883 Patent claims⁴, the first part of the *Advanced Bionics* framework is satisfied. *See Ivantis*, 2023 WL 2588217, at *7.

2. Meenan Was Previously Presented and Considered

The secondary reference Meenan was previously presented to and considered by the Office during prosecution of the '883 Patent. Specifically, Sonos cited Meenan in an IDS and thereafter the Examiner considered the reference, as confirmed by its appearance on the face of the '883 Patent:

⁴ A side-by-side comparison of claim 1 of each of the '883, '545, and '509 Patents is set forth in Ex.2124, illustrating the substantial overlap in both claim language and scope.

7,308,188	B2	12/2007	Namatame
7,310,334	B1	12/2007	Fitzgerald et al.
7,312,785	B2	12/2007	Tsuk et al.
7,313,384	B1	12/2007	Meenan et al.
7,313,593	B1	12/2007	Pulito et al.
7,319,764	B1	1/2008	Reid et al.
7,321,784	B2	1/2008	Serceki et al.
7,324,857	B2	1/2008	Goddard

Ex.1001, 3.

Not only did the Examiner correctly allow the '883 Patent over Meenan, he also did not even consider it close enough to warrant a rejection.

Because Meenan was cited in an IDS and considered by the Examiner during prosecution of the '883 Patent, the first part of the *Advanced Bionics* framework is satisfied. *See, e.g., Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, 2025 WL 1441509, at *2 (P.T.A.B. May 19, 2025) (“Challenging the claims using the same prior art that was previously presented on an IDS is sufficient to satisfy the first part of the *Advanced Bionics* framework.”).

3. Spurgat Was Previously Presented and Considered

The secondary reference Spurgat (2002/0174243) was effectively presented to and considered by the Office during prosecution of the '883 Patent. Specifically, an IDS filed by Sonos during prosecution listed Spurgat (2002/0173273), as confirmed by its appearance on the face of the '883 Patent. Ex. 1001, 6. Although the Spurgat reference asserted in the Petition is not the exact same publication cited in the IDS, the two Spurgat references are virtually identical.

In fact, aside from their Abstracts, Cross-Reference to Related Applications, Field of Invention, and Summary of the Inventions sections, the remainder of their disclosures and figures are the same (save for a few formatting and spelling variations). *See* Ex.2125 (comparing the two Spurgat references). Thus, for all intents and purposes, the Spurgat reference asserted in the Petition was previously presented to and considered by the Office. Thus, the first part of the *Advanced Bionics* framework is satisfied. *Ivantis*, 2023 WL 2588217, at *7 (finding first part of *Advanced Bionics* framework satisfied based on Examiner’s consideration of reference that contains the same disclosure as asserted reference).

B. *Advanced Bionics*, Part 2—Google Has Not Demonstrated The Office Materially Erred

Because the first part of the *Advanced Bionics* framework is satisfied, Google has the added burden to demonstrate that the Examiner erred in a manner material to the patentability of challenged claims. Specifically, Google “must explain, with reference to *Becton Dickinson* factors (c), (e), and (f), how the Examiner erred in overlooking the prior art.” *Ecto World*, 2025 WL 1441509, at *2. Importantly, “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments” by the Examiner, then “it cannot be said that the Office erred in a manner material to patentability.” *Advanced Bionics*, 2020 WL 740292, at *3.

While Google will have an opportunity to respond and attempt to show material error by the Examiner, it faces an uphill battle. As noted above, during

prosecution of the continuation applications, the Examiner had not only the primary reference Cheshire itself, but also Google's detailed invalidity contentions and expert analysis from the ITC Investigation concerning Cheshire. Under these circumstances, it is highly unlikely Google can credibly argue that the Examiner simply overlooked Cheshire. Discretionary denial under Section 325(d) is therefore warranted.

IV. CONCLUSION

Sonos respectfully submits that discretionary denial is warranted here. Given the unique circumstances surrounding the challenged '883 Patent—including the full litigation of the closely related '896 Patent before the ITC and Federal Circuit and its current assertion in the parallel California Litigation—all six *Fintiv* factors plus five additional considerations favor denial under Section 314(a). Denial is also warranted under Section 325(d) because each reference relied on by Google was previously presented to and considered by the Office during prosecution of the '883 Patent family, and Google cannot credibly demonstrate that the Office materially erred.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION complies with the type-volume limits in 37 C.F.R. § 42.24(b)(1). According to the utilized word-processing system's word count, this paper—excluding the caption, table of contents, table of authorities, table of exhibits, certificate of word count, and certificate of service—contains 9,139 words.

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