

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

SONOS, INC.,  
Patent Owner.

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

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

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## EXHIBIT LIST

Exhibit	Description
2001 to 2100	<b>RESERVED FOR PRELIMINARY RESPONSE</b>
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
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## I. INTRODUCTION

Patent Owner Sonos, Inc. requests that the Director exercise its discretion to deny institution of *inter partes* review (IPR) filed by Petitioner Google LLC against U.S. Patent No. 10,541,883 (“’883 Patent”) under 35 U.S.C. §§ 314(a) and 325(d).

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 that are also directed to device setup—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 Sonos and Google 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 the related ’896 Patent, which Sonos successfully asserted against Google over five years ago in ITC Investigation

No. 337-TA-1191 (“ITC Investigation”). But 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. Not only do these two related patents share the same priority chain and a common specification, but 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. Google itself describes the ’883 and ’896 Patents as “*two sides of the same coin*” (Ex.2107, 188-89) and relies on the *same* alleged prior art to challenge both patents in the California Litigation (*compare id.*, 60-67 *with id.*, 68-75). Instituting this IPR would lead to duplicative proceedings, invite inconsistent outcomes, and waste the Board’s resources—inefficiencies that § 314(a) is designed to prevent.

The weak merits of this IPR also make clear that denial is appropriate. This IPR is simply a rehash of invalidity positions Google 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 asserts here against the ’883 Patent—only to abandon both references before trial in favor of other art Google deemed stronger. Despite Google presenting its stronger art, the ITC upheld the ’896 Patent’s validity. Given this, Google’s renewed reliance on second-tier references to challenge the ’883 Patent

confirms that the Petition is objectively weak and should be denied under §314(a).

The Petition's weak merits are further confirmed by the fact that all three references Google relies on were previously considered by the Office during prosecution of the '883 Patent family. 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 continuation patents with substantially similar claims as the '883 Patent. As to the secondary references, both Meenan and a virtually identical Spurgat reference were considered during prosecution of the '883 Patent itself. Revisiting the same art under these circumstances would undermine the efficiency and consistency that Sections 314(a) and 325(d) are designed to protect.

## **II. DISCRETIONARY DENIAL IS WARRANTED UNDER § 314(A)**

### **A. Each *Fintiv* Factor Favors Discretionary Denial**

#### **1. Factor 1 Favors Denial**

There is no viable basis to stay the California Litigation based on this IPR. 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 Sonos asserted patents in an IPR. Accordingly, this IPR cannot meaningfully simplify the California Litigation. *See also infra* §II.A.4. The Central District of California routinely denies stays under similar circumstances.

*See, e.g., Realtime Adaptive Streaming LLC v. Google LLC*, 18-CV-3629, 2019 WL 13039329, at \*3 (C.D. Cal. May 6, 2019); *Entropic Commc'ns, LLC v. DISH Network Corp.*, 23-CV-01043, 2025 WL 519639, at \*3 (C.D. Cal. Feb. 13, 2025).

Moreover, a stay would cause significant competitive harm to Sonos because Google and Sonos are direct competitors. The Central District of California is “generally reluctant to grant a stay” under these circumstances. *Inneos LLC v. Opticis Co.*, No. 23-CV-185, 2023 WL 6787821, at \*3 (C.D. Cal. Sept. 13, 2023).

Further, Google itself is fully aware that a stay is not viable. The California Litigation was previously stayed 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 scorched-earth strategy in the California Litigation.

## **2. Factor 2 Favors Denial**

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 is 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 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 is set<sup>1</sup>, the Central District of California’s median time-to-trial for patent cases 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 the California trial, Factor 2 would still favor denial because overlapping claim construction and validity issues will still be litigated and tried in California for Sonos’s closely related ’896 Patent. Institution would therefore split the dispute across forums, leading to duplicative effort and inviting inconsistent outcomes—inefficiencies that the *Fintiv* factors, including Factor 2, are designed to prevent. *See, e.g., Transcend Information Inc. v. Truesight Communications LLC*, IPR2025-00723, Paper 10, at \*2 (PTAB Aug. 4, 2025).

### **3. Factor 3 Favors Denial**

The parties, ITC, Federal Circuit, and California Court have already invested substantial resources, and the parties and California Court will continue to invest substantial resources leading up to the institution decision.

The parties’ dispute began more than five years ago. Sonos filed its complaint

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<sup>1</sup> The California Court’s standard practice is to set trial date at the final pretrial conference, which is typically held weeks before trial. *See* Ex.2103, 2.

in the California Litigation on January 7, 2020, asserting five of the ten Sonos patents now at issue. On the same day, Sonos initiated the ITC Investigation asserting those same patents, which resulted in a stay of the California Litigation. While the California Litigation was stayed for nearly five years, the parties fully litigated the five Sonos patents (including the '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, and the Commission 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 violation by Google. 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); *Sk Innovation Co., Ltd. v. Lg Chem, Ltd.*, IPR2020-00982, 2020 WL 7029006, at \*5 (PTAB Nov. 30, 2020).

The parties' substantial investment did not stop there as both parties appealed certain of the Commission's findings, including findings concerning the closely related '896 Patent. And after the parties devoted extensive resources from briefing to oral argument, the Federal Circuit affirmed the Commission's findings in full.

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 agreed to reuse discovery and arguments from the ITC Investigation in the California Litigation, with Google explicitly incorporating its ITC positions into its invalidity contentions. Ex.2106, 10; Ex.2107, 12.

The California Court has also entered an aggressive scheduling order notwithstanding the complexity of the California Litigation. *See* Ex.2103. Today, the litigation involves 10 Sonos patents, 2 Google patents, dozens of accused Google products, 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 already exchanged and continue to amend initial infringement and invalidity contentions. Google's invalidity contentions for the '883 Patent *alone* include around 140 prior art references (7 of which are system art), § 101 and § 102(f) grounds, and at least 8 different § 112 grounds, while leaving the door open to add more 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 deadline, all *Markman* briefing will be complete, with *Markman* hearing set for December 2025 and 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 deadline.

Instituting review would disregard these many years of investment.

#### **4. Factor 4 Favors Denial**

The overlap between Google's Petition and its invalidity contentions in California, combined with Google's ineffective *Sotera* stipulation, favors denial.

As an initial matter, there is substantial overlap between the claims, grounds, and arguments raised in Google's Petition here 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)), 57 (claim 6 referring back to claim 4), 31 (claim 7 referring back to claim 3), 32 (claim 8 relying on same disclosure from limitation 1(a)), 34 (claim 12 referring back to limitation 1e.3), 61 (claim 18 referring back to claim 6), 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 Cheshire reference Google relies on here for all four Grounds 1-3B, as well as Google's secondary Spurgat reference, and even set forth a Cheshire and Spurgat combination like Google asserts here for

Ground 3A. Ex.2107, 68-69; Ex.2110 (charting Cheshire); Ex.2111, 26, 36, 39, 42, 45 (charting Spurgat, among other references). Although the remaining secondary Meenan reference 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 unsuccessfully advanced 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 in August 2025. *See* Ex.1022. But Google’s *Sotera* stipulation is practically meaningless. **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 closely 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 where Google’s invalidity contentions rely on seven separate systems as primary references (*see* Ex.2107, 68), with Cheshire—the primary reference here for all four Grounds 1-3B—allegedly describing the operation of one of those systems (Ex.2127, 2 (Google asserting that Apple’s Airport Express system is described in Cheshire)). Thus, 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 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 decision in *Ingenico Inc. v. IOENGINE, LLC* casts doubt on the effectiveness of a *Sotera* stipulation. *See* 136 F.4th 1354, 1365-66 (Fed. Cir. May 7, 2025) (narrowly interpreting “ground” in the IPR estoppel context). For example, under *Ingenico*, 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 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. *See id.* This is analogous to the situation here where Google relies on the disclosure of the Cheshire patent to support its Airport Express system art. *See generally* Ex.2127 (relying on Cheshire throughout claim chart). In view of this, Google’s *Sotera* stipulation does not ensure that this IPR is a “true alternative” to the California Litigation. *Sotera*, IPR2020-01019, Paper 12, p.19.

**5. Factor 5 Favors Denial**

The same parties are involved in this IPR and the California Litigation.

**6. Factor 6 Favors Denial**

Google’s grounds are objectively weak. *See supra* §§II.B.1, II.B.5, III.A.

**B. Five Other Considerations Also Favor Discretionary Denial**

**1. Google’s Abandonment of Cheshire and Meenan and the ITC’s Finding of Validity of the ’896 Patent, Favors Denial**

Despite abandoning its ’896 Patent invalidity contentions based on Cheshire and Meenan during the ITC Investigation in favor of art Google deemed stronger—and losing nevertheless (Ex.2105)—Google now asks the Board for a do-over against the related ’883 Patent. But rehashing references Google itself previously relegated to second-tier status would only waste the Board’s resources.

In the ITC Investigation, Google argued that the ’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 also had its expert

opine on the same. *See* Ex.2113. But after Sonos’s expert identified Cheshire’s numerous 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.

Now, after the ITC and Federal Circuit 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 by repackaging the same Cheshire theories its 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 patents’ complementary nature—the ’883 Patent is directed to a “*playback device*” configured to be set up via a “*computing device*” while the ’896 Patent is directed to a “*computing device*” configured to set up a “*playback device*” (*id.*)—and numerous overlapping claim language. Further underscoring the close relationship between the patents, Google notes that during prosecution of the ’883 Patent Sonos filed a terminal disclaimer referencing the ’896 Patent. Ex.2107, 189.

## **2. Risk of Competing Claim Constructions Favors Denial**

The California Court is the more appropriate forum to resolve overlapping claim construction issues for the '883 and '896 Patents efficiently and consistently.

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 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 five terms and was actively disputing the construction of another term in the California Litigation. 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 terms being construed inconsistently.

That risk extends further in view of the ITC Investigation, where additional terms appearing in both the '883 and '896 Patents were construed—namely, "*wireless local area network (WLAN)*" and "*security key.*" Ex.2116, 17-21, 28-31.

## **3. Google's Clear Gamesmanship Favors Denial**

To justify adding its two setup patents in the California Litigation, Google represented to the California Court that judicial efficiency will be served because 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. Google also argued that claim construction issues will overlap not just between Sonos’s ’833 and ’896 Patents, but also with Google’s setup patents. Ex.2126, 11:4-10, 20:3-15. The California Court ultimately agreed, holding that “judicial efficiency will be promoted” by adding Google’s patents to the case. Ex.2129, 7.

Yet here, Google seeks to carve out the ’883 Patent for separate review by the Board, while continuing to litigate it in California alongside the closely related ’896 Patent and its own setup patents. This is a far cry from judicial efficiency.

#### **4. Overlapping Expert Disputes Across Multiple Patents and Google’s Overreliance on Expert Testimony Favors Denial**

There are several reasons why expert discovery favors denial of this IPR. *First*, regardless of the outcome in this IPR against the ’883 Patent, experts for both parties will testify in the California Litigation concerning the closely related ’896 Patent, which makes the California Court better positioned to address expert disputes that span both patents. 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 “battle of the experts” better suited for 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 spans nearly 156 pages without offering helpful context or explanation about terms of art. *See generally* Ex.1003. 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. But both Federal Circuit and Board have made 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); *Motorola Mobility LLC v. Largan Precision Co. Ltd.*, IPR2024-00689, 2025 WL 26137, \*10 (PTAB Jan. 3, 2025).

Google’s use of general POSITA knowledge does not fall within the narrow exceptions recognized by the Federal Circuit and Board 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.”*), 22 (“A POSITA would have understood or found it obvious that existing network 112 *is defined by an access point ...*”), 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.*”), 19 (modifying Cheshire’s FIG. 3 to supply missing limitations under the pretext of “the knowledge of a POSITA”), 21 (same).

Although not necessarily governing this IPR due to its filing date, the Director’s July 31, 2025 Memorandum reinforces that Google’s reliance on general POSITA knowledge to supply missing limitations is improper. *See id.*, 1.

#### **5. Settled Expectations of the Parties Favor Denial**

While “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)), there are at least three reasons why the parties’ expectations are settled here.

**First**, the ’883 Patent (and the closely related ’896 Patent) has been in force for over five years. Ex.1001. Despite its recent expiration, Google had actual notice of the ’883 Patent since at least August 2021 (and of the ’896 Patent since at least January 2020). *See* Ex.2117, 5, 27. The parties’ expectations are thus firmly settled.

**Second**, 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 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. 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 patenting and investing in setup technology before this IPR.

*Third*, settled expectations also arise from Sonos’s substantial investment in the patented setup technology. *See Amgen Inc v Bristol-Myers Squibb Co*, IPR2025-00601, Paper 9, at \*2 (July 24, 2025). The ITC 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. This determination was supported by Sonos’s 45-page motion 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 Sonos’s substantial R&D expenditures from 2015-2019 in millions). Google did not even attempt to oppose Sonos’s motion. Ex.2118, 1.

### **III. DISCRETIONARY DENIAL IS WARRANTED UNDER § 325(D)**

#### **A. *Advanced Bionics*, Part 1**

All three references relied on in the Petition—Cheshire (Grounds 1-3B), Meenan (Grounds 2, 3B), Spurgat (Grounds 3A-3B)—were previously considered by the Office.

## 1. Cheshire Was Previously Considered

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 and considered by the Office under Section 325(d) 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.

The primary Cheshire reference was cited by Sonos in an IDS and considered by the Examiner during prosecution of U.S. Patent Nos. 10,965,545 (“’545 Patent”) and 11,025,509 (“’509 Patent”), as confirmed by Cheshire being listed on the face of both patents. Ex.2120, 5; Ex.2121, 5.<sup>2</sup> The ’545 Patent is a continuation of the ’883 Patent, and the ’509 Patent is a continuation of the ’545 Patent.

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 ITC Investigation, including Google’s Cheshire claim chart (Ex.2115) and its expert’s invalidity report concerning Cheshire, as confirmed on the face of the ’545 and ’509 Patents. Ex.2120, 26-27; Ex.2121, 16, 27. Yet, even with the benefit of Google’s ITC contentions and expert analysis on Cheshire, the Examiner still found no basis for a

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<sup>2</sup> The ’883, ’545 and ’509 Patents were examined by the same Examiner.

rejection, which aligns with Google’s own decision to abandon Cheshire in the ITC Investigation. *Supra* §II.B.1. And as previously mentioned, Google’s Petition here largely recycles the same Cheshire arguments set forth in Google’s ITC expert report that Sonos cited during prosecution of each of the ’545 and ’509 Patents. Ex.2114 (comparing Petition’s claim 1 arguments to its ITC expert testimony).

Further, during prosecution of the ’509 and ’545 Patents, the Examiner effectively determined that the claims of these patents were not patentably distinct from those of the ’883 Patent. Specifically, during prosecution of the ’509 Patent, the Examiner requested that Sonos file a terminal disclaimer in view of the ’883 Patent claims. Ex.2122, 8. Sonos complied. *Id.*, 1-2. Similarly, during prosecution of the ’545 Patent, the Examiner issued a non-statutory obviousness-type double patenting rejection over the closely related ’896 Patent stating that “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other.” Ex.2123, 3-5. In turn, Sonos filed a termination disclaimer. *Id.*, 43-44.<sup>3</sup>

## **2. Meenan Was Previously Considered**

The secondary Meenan reference was cited by Sonos in an IDS and considered by the Examiner during prosecution of the ’883 Patent, which satisfies the first part of the *Advanced Bionics* framework. *See* Ex.1001, 3 (listing Meenan on face of ’883 Patent); *Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, 2025 WL

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<sup>3</sup> A comparison of claim 1 of the ’883, ’545, and ’509 Patents is set forth in Ex.2124.

1441509, at \*2 (P.T.A.B. May 19, 2025).

### **3. Spurgat Was Previously Considered**

The secondary reference Spurgat (2002/0174243) was effectively considered by the Examiner during prosecution of the '883 Patent by virtue of Sonos citing Spurgat (2002/0173273) in an IDS. Ex. 1001, 6. Although the Spurgat reference asserted in the Petition is not the exact same publication cited by Sonos in the IDS, the two Spurgat references are virtually identical. See Ex.2125 (comparing the two Spurgat references). This satisfies the first part of the *Advanced Bionics* framework.

#### **B. *Advanced Bionics*, Part 2**

Given the first part of the *Advanced Bionics* framework is satisfied, Google must demonstrate that the Examiner materially erred. *Ecto World*, 2025 WL 1441509, at \*2. But “[i]f reasonable minds can disagree regarding the [Examiner’s] purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Advanced Bionics*, 2020 WL 740292, at \*3.

Google is unlikely to succeed in showing material error by the Examiner given that the Examiner considered not only the Cheshire patent itself, but also Google’s detailed ITC invalidity contentions and expert analysis concerning Cheshire.

## **IV. CONCLUSION**

Give the unique and compelling circumstances surrounding the challenged '883 Patent, Sonos respectfully requests denial under Sections 314(a) and 325(d).

Respectfully submitted,

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Dated: September 19, 2025

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**CERTIFICATE OF SERVICE**

The undersigned hereby confirms that the foregoing Request for Discretionary Denial of Institution was served on September 19, 2025 via email directed to counsel of record for the Patent Owner at the following:

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