UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

JAWBONE INNOVATIONS, LLC,

Patent Owner.

Case IPR2022-01124

Patent No. 11,122,357

PETITIONER'S PRE-INSTITUTION REPLY

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The Board should institute review and not apply the *Fintiv* factors. But even if applied, the most relevant *Fintiv* factors (2, 3, and 4) favor institution.

I. The Petition Presents Compelling Evidence of Unpatentability

The Board will not deny institution based on *Fintiv* "where a petition presents compelling evidence of unpatentability." Memo. from Director Vidal, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* at 2 (U.S.P.T.O. June 21, 2022) ("Int. Procedure"). Here, Petitioner has shown such compelling evidence. For example, Petitioner has demonstrated that the combination of Kanamori (Ex. 1005), McCowan (Ex. 1006), and Elko (Ex. 1009) renders all challenged claims obvious. Paper 1 ("Pet.") 14-76.

Patent Owner's contrary arguments lack merit. Paper 6 ("Prelim. Resp.") 6-13. Patent Owner argues that Dr. Vipperman did not explain how he performed his linear-response simulations. Prelim. Resp. 7. To the contrary, the section of Dr. Vipperman's declaration titled "Simulations of Virtual Microphone Responses" explained in detail the equations used for each simulation and the values of the variables in each equation based on Kanamori, McCowan, and the knowledge of a POSITA. Ex. 1003, ¶¶ 50-60. Patent Owner failed to identify any details missing from this explanation that would have prevented a POSITA from recreating his simulations. Patent Owner also argued that "1000 Hz is not a valid speech signal." Prelim. Resp. 7-11. This argument ignores that the '357 patent repeatedly refers to

"a 1 kHz speech source." Ex. 1001, 2:54-57, 2:62-64, 11:40-42, 12:39-41. Additionally, contrary to Patent Owner's argument, the Petition provided ample evidence of a motivation to combine Kanamori and McCowan to make Kanamori's noise-cancellation effective for near-field devices like headsets. Pet. 21-40. Such a modification does not "destroy the objective of the prior art," Prelim. Resp. 13, but rather modifies it for a well-known device (e.g., headsets), supported by Kanamori, state-of-the-art evidence, and Dr. Vipperman, *see, e.g.*, Pet. 29-30.

This combination is compelling despite the district court construing terms within the '357 patent to be indefinite. Claim Construction Order, *Jawbone Innovations, LLC v. Google LLC*, No. 6:21-cv-00985-ADA, Dkt. 88 at 4 (W.D. Tex. Oct. 14, 2022) ("Claim Construction Order"; Ex. 1023). The linear responses to speech shown to be obvious in the petition look like Figures 9 and 11 of the '357 patent, which are described as having different speech responses. *Compare* Pet. 38-39, *with* Ex. 1001, Figs. 9, 11, 12:55-58. The linear responses to noise shown to be obvious in the petition look like Figures 10 and 12 of the '357 patent, which are described as having "very similar" noise responses. *Compare* Pet. 37-38, *with* Ex. 1001, Figs. 10, 12, 11:44-49, 12:44-48. The Board does not need to know the outer bounds of "substantially similar" and "substantially dissimilar" to determine that Kanamori, McCowan, and Elko render an embodiment within the scope of these terms obvious.

II. The *Fintiv* Factors Favor Institution

In addition to the merits, the *Fintiv* factors either favor institution or are neutral. The Board should institute review.

A. *Fintiv* Factors 2, 3, 4, and 6 Favor Institution

Factor 2 favors institution because, to the extent the trial proceeds on the '357 patent, the Board's projected final written decision date (January 6, 2024), as explained below, is before the expected trial date based on the median time to trial (January 30, 2024). Int. Procedure at 8-9. Patent Owner relies on the scheduled trial date for this factor. Prelim. Resp. 17-20. But a court's scheduled trial date is often "unreliable" and "not by itself a good indicator of whether the district court trial will occur before the statutory deadline for a final written decision." Int. Procedure at 8. To better assess time to trial, the Board should consider the "median time-to-trial," and "the number of cases before the judge . . . and the speed and availability of other case dispositions." *Id.* at 8-9.

The median time from the filing of a civil case to trial in the Western District of Texas is 28.3 months, placing the expected trial date in the parallel litigation around January 30, 2024. Ex. 1019, 5. This is after the January 6, 2024 statutory deadline for a final written decision. Judge Albright's high volume of open patent cases—848 as of August 2022—also makes it less likely that trial will proceed on schedule. Ex. 1020, 68. The *Markman* hearing occurred nearly three months after its

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