

CAN THE NUMBER OF CONTINUATIONS BE LIMITED?

A Discussion of and reaction to *Sonos v. Google*

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Introduction

Sonos, Inc. v. Google LLC, No. C 20-06754 WHA, 2023 WL 6542320
(N.D. Cal. Oct. 6, 2023)

Sonos sue Google over wireless speaker patents –

Patents relate wireless multi-room audio technology:

Relevant feature is overlapping zone scenes. Judge likens feature to email, where a single email can be included in more than one email group.

Prosecution Laches

Hyatt v. Hirshfeld, 998 F.3d 1347, 1360 (Fed. Cir. 2021) - Doctrine of prosecution laches may render a patent unenforceable when it has issued only after an unreasonable and unexplained delay in prosecution that constitutes an egregious misuse of the statutory patent system under a totality of the circumstances.

Symbol Techs., Inc., v. Lemelson Med., Educ. & Rsch Found., LP (Symbol Techs., II), 422 F.3d 1378, 1385-86 (Fed. Cir. 2005) -the determination of unreasonable and inexcusable delay is not limited to the circumstances surrounding the particular patent applications at issue and can include “the prosecution history of all of a series of related patents and overall delay in issuing claims.

In re Bogese, 303 F.3d 1362, 1369 (Fed. Cir. 2002) - Federal Circuit applied prosecution laches and found patents unenforceable based on an eight-year delay in presenting claims.

Personalized Media Commc'ns, LLC v. Apple Inc. (PMC), [57 F.4th 1346, 1355](#) (Fed. Cir. 2023) - unenforceable based on a 10 to 19 year delay in presenting claims

Background

District Court rendered two patents unenforceable due to prosecution laches and rejected \$32 million jury verdict

United States Patent Nos. 10,848,885 and 10,469,966

Provisional application filed in 2006; utility application filed in 2007



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Chain of Cases

- 1) 60/825,407 – filed 9/12/2006
- 2) 11/853,790 – filed 9/11/2007; issued as 8,483,853 on 7/9/2013
- 3) 13/896,829 – filed 5/17/2013; issued as 8,843,228 on 9/23/2014
- 4) 14/465,457 – filed 8/21/2014; issued as 9,344,206 on 5/17/2016
- 5) 15/130,919 – filed 4/15/2016; issued as 11,388,532 on 7/12/2022
- 6a) 16/383,565 – filed 4/12/2019; issued as 10,469,966 on 11/5/2019
- 6b) 16/383,561 – filed 4/12/2019; issued as 10,848,885 on 11/24/2020
- 7) 17/861,882 – filed 7/11/2022; pending

Patent Family History

The first patent issued in 2013 as US 8,483,853 on July 9, 2013

First Action mailed March 2011

First RCE filed February 2012

Notice of Allowance mailed April 2013

Claims directed to displaying zone scenes, each zone having at least one player, the players having access to a first multimedia source and a second multimedia source.

Judge referred to first three patents as niche variations of little consequence

Prior Dealings

- In 2014, five years before Sonos filed the applications and presented the claims, accused infringer Google LLC shared with Sonos a plan for a product that would practice what would become the claimed invention. The parties were exploring a potential collaboration, but it never materialized.
- Started with using Sonos for Google music streaming service but Google shared idea of audio devices being a member of several groups – eventually released as Chromecast



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District Court

Parties agreed that affirmative defenses would be decided by the judge after the jury verdict

The patents issued after an unreasonable, inexcusable, and prejudicial delay of *over thirteen years* by the patent holder, Sonos, Inc. Sonos filed the provisional application from which the patents in suit claim priority in 2006, but it did not file the applications for these patents and present the asserted claims for examination until 2019.



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The Federal Circuit has explained that “subject matter disclosed by a patentee, but not claimed, is considered dedicated to the public,” the reason being “that members of the public reading a disclosure of particular subject matter are entitled, absent a claim to it, to assume that it is not patented and therefore dedicated to the public.” *Eli Lilly & Co. v. Hospira, Inc.*, [933 F.3d 1320, 1334](#) (Fed. Cir. 2019) (citations omitted). True, the Federal Circuit has recognized an exception for subject matter “claimed in a continuation or other application based on the disclosure,” *ibid.*, but it has also recognized that unreasonable, inexcusable delay “is not what is contemplated by the patent statute when it provides for continuation and continuation-in-part applications” *Hyatt*, [998 F.3d at 1361](#) (alterations in original) (quoting *Symbol Techs. II*, [422 F.3d at 1386](#))



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District Circuit

It is also true that a patent applicant is allowed to draft claims to read on competitors' products and claim a priority date that precedes them. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, [358 F.3d 898, 909](#) n.2 (Fed. Cir. 2004) (citing *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, [863 F.2d 867, 874](#) (Fed. Cir. 1988)). But that is only so long as there is no unreasonable, inexcusable delay, and so long, of course, that an earlier specification really did disclose the claimed invention.

District Circuit

Case Law cited by District Court

- *Symbol Techs., Inc., v. Lemelson Med., Educ. & Rsch Found., LP (Symbol Techs., II)*, [422 F.3d 1378, 1385-86](#) (Fed. Cir. 2005).
- *Hyatt v. Hirshfeld*, [998 F.3d 1347, 1360](#) (Fed. Cir. 2021)
- *In re Bogese*, [303 F.3d 1362, 1369](#) (Fed. Cir. 2002)
- The Federal Circuit has not expressly clarified an accused infringer's burden of proof for prosecution laches, so this order errs on the side of caution and applies clear and convincing evidence, consistent with what is required for other unenforceability defenses.

Patent Disclosure

The patents contemplate customizing, saving, and invoking groups of multimedia players from selected rooms with a name like “Morning” or “Downstairs.” They refer to the multimedia players as “zone players” and the customized, saved groups of zone players that can be invoked on demand as “zone scenes.” Specifically, the patents in suit claim devices that implement *overlapping* zone scenes, which share one or more zone players.



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In the two asserted patents, Sonos sought to patent zone scenes with a new twist: overlap. With overlap, a zone player could be a member of more than one zone scene at the same time. This was thirteen years after Sonos filed the provisional application, but also five years after Google had *itself* disclosed overlapping zone scenes to Sonos, and four years after Google had released products that implemented the feature. Initially, Sonos's applications for the patents in suit were rejected on obviousness grounds. Yet after Sonos amended the applications to incorporate new specification language (with new matter) and narrowed claim language (with “standalone mode” limitations), they issued as patents. Sonos promptly asserted these patents against Google.



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District Court

Prosecution laches may “render a patent unenforceable when it has issued only after an unreasonable and unexplained delay in prosecution that constitutes an egregious misuse of the statutory patent system under a totality of the circumstances.”

At trial, “remarkably,” Sonos never provided any sworn explanation for why it waited until April 2019 to claim overlapping zone scenes.

That Sonos diligently prosecuted patent applications in the interim does not render the delay any less unreasonable and inexcusable. Indeed, it renders the delay *all the more* unreasonable and inexcusable.



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Sonos let the industry develop and only then sought to extract an invention from a much earlier application that would read on an industry trend. It is worse than that, actually, for Sonos learned of Google's specific product plans and *still waited five years* to frame claims to read on those products. A patent holder may only need a short (seven-year) term to extract a substantial (thirty-two-million-dollar) damages award.

District Court

Prejudice to Google

Whether the accused infringer or others invested in, worked on, or used the claimed technology during the period of delay

Google could have studied the tortured prosecution history dating back to 2006 before investing in infringing products

unearthing the layers of file histories would have resembled an exercise in archeology

The 2007 non-provisional application was filed with a request for non-publication, it was not even published until it issued in 2013



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District Court

Sonos has done exactly what the Supreme Court has long said should not be done. “It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretense of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms.” *Miller v. Bridgeport Brass Co.*, [104 U.S. 350, 355](#) (1881)



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This was not a case of an inventor leading the industry to something new. This was a case of the industry leading with something new and, only then, an inventor coming out of the woodwork to say that he had come up with the idea first – wringing fresh claims to read on a competitor’s products from an ancient application



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District Court

The essence of this order is that the patents issued after an unreasonable, inexcusable, and prejudicial delay of over thirteen years by the patent holder, Sonos, Inc. Sonos filed the provisional application from which the patents in suit claim priority in 2006, but it did not file the applications for these patents and present the asserted claims for examination until 2019. By the time these patents issued in 2019 and 2020, the industry had already marched on and put the claimed invention into practice.



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District Court

It is wrong that our patent system was used in this way. With its constitutional underpinnings, this system is intended to promote and protect innovation. Here, by contrast, it was used to punish an innovator and to enrich a pretender by delay and sleight of hand. It has taken a full trial to learn this sad fact, but, at long last, a measure of justice is done.



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Sonos Appeal Brief

Sonos argues that prosecution laches does not apply unless there is unfair timewise extension of the monopoly granted by the patent

Sonos diligently prosecuted patents and not unreasonable to prioritize other claims over the claims asserted against Google

Sonos Appeal Brief

In re Bogese – Applicant included the same rejected claims in a dozen successive applications, abandoning each one without amendment or response, covering a period of 20 years.

Hyatt – bulk filed 381 applications, each one having one of 11 disclosures. Applications included 115,000 claims with 45,000 independent claims

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Sonos Appeal Brief

Google has burden of proofing that delay was unreasonable or inexcusable

Court clearly focuses on 13 year delay:

PTO took seven years to issue first application – delay resulted in 1443 days of Patent Term Adjustment

Remaining period until filing patents was six years.

Sonos took no action that intentionally delayed the prosecution of the chain of applications



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Sonos Appeal Brief

District Court asserts that Sonos did not claim or disclose overlapping zones until after competitors developed products having this feature but, if true, claims would be invalid for lack of support.

Reason for adding claims to overlapping zones stems from desire for Sonos to cover their own product.

Sonos Appeal Brief

Footnote in District Court Opinion

- Likewise, the Federal Circuit has not expressly clarified whether the presumption that a delay of more than six years is unreasonable, inexcusable, and prejudicial applies when prosecution laches is raised as a defense to infringement, as it does when it is raised in a civil action challenging an adverse decision of the PTO. See *Hyatt*, [998 F.3d at 1369](#); see also *Personalized Media Commc'ns*, [552 F.Supp.3d at 685](#) (declining to apply presumption). This order does not reach this question. It too makes no difference here.

Takeaways and Summary

Discussion of new matter is misplaced when considering prosecution laches

Is shortened patent term enough of a consequence for patents issuing from continuation applications?

How do you measure prejudice to the defendant?

Is the disposition of earlier applications/patents in the continuation relevant?

Options for the CAFC on Appeal

Thank you

