

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SONOS, INC.,
Patent Owner.

IPR2021-01563
Patent 9,967,615 B2

Before MICHAEL R. ZECHER, TERRENCE W. McMILLIN, and
GARTH D. BAER, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion to Dismiss
35 U.S.C. § 315(a)(1)

I. INTRODUCTION

A. *Background and Summary*

On September 28, 2021, Google LLC (“Petitioner”)¹ filed a Petition requesting an *inter partes* review (“IPR”) of claims 1, 2, 6–14, 18–25, and 27–29 (the “challenged claims”) of U.S. Patent No. 9,967,615 B2 (Ex. 1001, “the ’615 patent”). Paper 1 (“Pet.”). Sonos, Inc. (“Patent Owner”)² filed a Preliminary Response. Paper 6 (“Preliminary Response” or “Prelim. Resp.”). With our authorization, Patent Owner filed a Motion to Dismiss under 35 U.S.C. § 315(a) (Paper 7, “Mot.”) and Petitioner filed an Opposition to Patent Owner’s Motion to Dismiss (Paper 10, “Opp.”).

For the reasons set forth below, we *deny* the Motion.

II. ANALYSIS

A. *35 U.S.C. § 315(a)(1)*

Patent Owner “moves to dismiss the Petition on grounds that institution is precluded under 35 U.S.C. § 315(a)(1).” Mot. 1. Section 315(a)(1) of Title 35 of the United States Code provides, “[a]n *inter partes* review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.”

The relevant facts are not in dispute. Patent Owner does not contend that Petitioner filed a civil action challenging the validity of a claim of the ’615 patent before the Petition was filed on September 28, 2021. Petitioner filed a declaratory judgment action (“DJ action”) on September 28, 2020.

¹ Petitioner identifies itself, Google LLC, as the real party-in-interest to this proceeding. Pet. 76.

² Patent Owner identifies itself, Sonos, Inc., as the real party-in-interest to this proceeding. Paper 3, 1.

Mot. 1; Opp. 1. The only relevant claim sought a declaration that the Petitioner did not, directly or indirectly, infringe the '615 patent. Ex. 2010 (Complaint for Declaratory Judgment of Non-Infringement), 5–6. However, on February 4, 2022, Petitioner filed a Second Amended Complaint by which it seeks a declaration of invalidity of the '615 patent. Ex. 2012, 12.

Patent Owner argues that the Second Amended Complaint relates back to—should be considered as having been filed on—the original filing date of the civil action. Mot. 1. The Motion states, in relevant part:

This amended civil action, which challenges the validity of the patent, relates back to the filing date of the original civil action, and is thus considered to have been filed on the date of the original civil action. Accordingly, [Petitioner] has filed a civil action before the Petition challenging the validity of the patent through an affirmative claim. Section 315(a)(1) precludes institution.

Id. Patent Owner bases this argument on Federal Rule of Civil Procedure 15(c)(1)(B), which provides:

(c) Relation Back of Amendments

(1) *When an Amendment Relates Back.* An amendment to a pleading relates back to the date of the original pleading when:

(A) the law that provides the applicable statute of limitations allows relation back;³

(B) the amendment asserts a claim or defense that arose out of the conduct, transaction, or occurrence set out—or attempted to be set out—in the original pleading[.]

Patent Owner asserts that Petitioner's amendment to its pleading relates back to the date of its original pleading because "its amendment asserting

³ Even if we treat Section 315(a)(1) as an applicable statute of limitation, it does not provide that it allows relation back of pleadings in a civil action.

invalidity of the '615 Patent concerns the same dispute as its original pleading asserting non-infringement of the '615 Patent.” Mot. 2.

In response, Petitioner argues that the Motion should be denied “because it is based on an unsupported interpretation of the clear language in 35 U.S.C. § 315. [Petitioner’s] Petition should not be dismissed because it was filed before [Petitioner] filed a civil action challenging the validity of the '615 Patent, as permitted by § 315.” Opp. 1. And, Petitioner contends that “no requests for declaratory judgment on invalidity were filed in the DJ action until *after* the IPR petition was filed, in accordance with § 315.” *Id.* at 2.

B. Discussion

Patent Owner concedes that the factual situation and the issue presented “appears to be an issue of first impression.” Mot. 1. Therefore, we start with the language of the applicable statute, 35 U.S.C. § 315(a)(1). *See SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348, 1355 (2018) (“Where a statute’s language carries a plain meaning, the duty of an administrative agency is to follow its commands as written.”). Here, the plain meaning of the language of the Section 315(a)(1) is clear.

Section 315(a)(1) states, “[a]n inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” The plain meaning of Section 315(a)(1) provides that we first determine if a petitioner “filed a civil action challenging the validity of a claim” of the challenged patent “before the date on which the petition is filed” and, if so, “[a]n inter partes review may not be instituted.” Applying the plain meaning to the undisputed facts here, before

September 28, 2021, the date on which the Petition was filed, Petitioner had not “filed a civil action challenging the validity of a claim” of the challenged patent. Accordingly, Section 315(a)(1) does not command that we dismiss the Petition. For this reason alone, we *deny* the Motion.

With regard to Patent Owner’s reliance on the relation back of pleading amendments in federal courts under Federal Rule of Civil Procedure 15(c)(1)(B), the Federal Rules of Civil Procedure do not govern our proceedings. Fed. R. Civ. P. 1 provides, “[t]hese rules govern the procedure in all civil actions and proceedings in the United States district courts, except as stated in Rule 81;”⁴ *see also* 37 C.F.R. § 42.1(a) (“Part 42 governs proceedings before the Patent Trial and Appeal Board.”).⁵ We, therefore, make our decision on the present Motion without applying the Federal Rules of Civil Procedure, specifically Fed. R. Civ. P. 15(c)(1)(B). If we disregard Fed. R. Civ. P. 15(c)(1)(B), there exists no basis for considering Petitioner’s declaratory invalidity claim filed on February 4, 2022, as having been filed before September 28, 2021, the date the Petition was filed, and it is clear that the Motion must be denied.

The only cases that Petitioner cites in support of the Motion are district court proceedings. *See* Mot. 2–3. Pursuant to Fed. R. Civ. P. 1, those cases were governed by the Federal Rules of Civil Procedure and those

⁴ Fed. R. Civ. P. 81 deals more specifically with the applicability of the Federal Rules of Civil Procedure to particular proceedings (such as, e.g., bankruptcy proceedings), but makes no mention of proceedings in the Office, before the Board, or for an IPR.

⁵ Section 42.62 of Title 37 of the Code of Federal Regulations provides that the Federal Rules of Evidence apply to proceedings before the Board. There is no provision in the statutes, regulations, or rules governing proceedings before the Board that the Federal Rules of Civil Procedure apply.

courts were compelled to apply Fed. R. Civ. P. 15(c)(1)(B). Those courts had to consider under Fed. R. Civ. P. 15(c)(1)(B) whether the amendments to the pleadings related back to the filing date of the action. We do not (and, pursuant to the plain meaning of Section 315(a)(1), should not) consider the impact under Fed. R. Civ. P. 15(c)(1)(B) of Petitioner's amendment to its pleadings in the district court action. We, therefore, do not find the reasoning or holding of those cases to be controlling of, or persuasive in, our decision on the present Motion. For these additional reasons, we also *deny* the Motion.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to Dismiss the Petition (Paper 7) is *denied*.

IPR2021-01563
Patent 9,967,615 B2

FOR PETITIONER:

Erika Arner
Cory Bell
Kara Specht
Umber Aggarwal
FINNEGAN, HENDERSON, FARABOW, GARRETT, & DUNNER, LLP
Erika.arner@finnegan.com
Cory.bell@finnegan.com
Kara.specht@finnegan.com
Umber.aggarwal@finnegan.com

FOR PATENT OWNER:

Cole Richter
Michael Boyea
John Smith
David Grosby
LEE SULLIVAN SHEA & SMITH LLP
richter@ls3ip.com
boyea@ls3ip.com
smith@ls3ip.com
grosby@ls3ip.com

Jeffrey Armstong
AKERMAN LLP
Jeffrey.armstrong@akerman.com