

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2022-00604
Patent 8,326,611 B2

Before GEORGIANNA W. BRADEN, JASON M. REPKO, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Institution
37 C.F.R. § 42.71(d)

On October 6, 2022, the Board denied institution of *inter partes* review of claims 1–28 of U.S. Patent No. 8,326,611 B2 (Ex. 1001, “the ’611 patent”). Paper 12 (“Decision” or “Dec.”). Petitioner filed a Request for Rehearing. Paper 15 (“Request” or “Req.”).¹ For the reasons below, we *deny* Petitioner’s Request.

I. STANDARD FOR REHEARING

A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). “The burden of showing a decision should be modified lies with the party challenging the decision.” *Id.*

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “An abuse of discretion is found if [a] decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016).

II. BACKGROUND

In the Petition, Petitioner argued that independent claim 1 and its dependent claims (i.e., claims 2–28) are unpatentable as obvious over Elko and Boll. Paper 1 (“Pet.”), 3. Claim 1 requires a method that includes:

¹ Petitioner also filed another, earlier request for rehearing (Paper 14), but asked the Board to expunge that paper and to consider only the corrected version, found in Paper 15 (Ex. 3001). We have done so.

[a] forming a *first virtual microphone* by combining a *first signal* of a first physical microphone and a *second signal* of a second physical microphone;

[b] forming a filter that describes a relationship for speech between the first physical microphone and the second physical microphone; [and]

[c] forming a *second virtual microphone* by applying the filter to the first signal to generate a first intermediate signal, and summing the *first intermediate signal* and the *second signal*.

Ex. 1001, 36:61–37:4 (emphases added). For these claim limitations, the Petition relied exclusively upon Elko. Pet. 18–23; *see also* Dec. 9–11 (summarizing contentions). In the Decision, we found that Petitioner failed to show sufficiently that Elko teaches or suggests elements 1[a] and 1[c], which require forming first and second microphones (Dec. 8–13), and as a result, we determined that Petitioner had failed to show a reasonable likelihood of prevailing on its challenge to any claim (*id.* at 13–14).

Specifically, the Petition mapped the claimed first and second virtual microphones to the output of Elko’s difference and sum blocks, respectively. Pet. 18–20 (pointing to the output of the difference block as “forming the first virtual microphone”), 22–23 (pointing to the output of the sum block as “forming the second virtual microphone”); *accord* Dec. 9–11. We found that Elko provides “identical inputs” to the difference and sum blocks (Dec. 11) and, as a result, determined that Petitioner fails to show sufficiently that Elko discloses forming the first and second virtual microphones in the manner required by the claim (*id.* at 12). We explained:

[E]ven if we accept Petitioner’s contentions—i.e., assuming that the “first virtual microphone” is output by the difference block and the “second virtual microphone” is output by the sum block—Petitioner fails to sufficiently show that Elko discloses

forming the first virtual microphone by combining *a first signal* and *a second signal*, where the second virtual microphone is formed by summing *a first intermediate signal* (generated by applying a filter to the first signal) and *the second signal*, as claim 1 requires. Instead, both of the alleged “virtual microphones” are formed by combining the same two signals. Stated differently, Petitioner at most shows that Elko discloses forming a first virtual microphone by combining *the first intermediate signal* and the second signal, rather than showing that Elko discloses forming a first virtual microphone by combining *the first signal* and the second signal.

Id. We also found that the Petition failed to address this discrepancy between Elko’s disclosure and the claim’s requirements. *Id.* at 12–13.

III. ANALYSIS

Petitioner’s Request does not ask us to revisit our findings regarding Elko’s disclosure or the Petition’s mapping to it. *See* Req. Instead, Petitioner argues that rehearing is appropriate because the Decision misapprehended the claim language. Req. 1, 7–14. According to Petitioner, “even assuming Elko provides ‘identical inputs . . . to the difference block and the sum block,’” “[t]here is . . . no inconsistency between Elko and the requirements of clam 1.” *Id.* at 10 (quoting Dec. 11) (first alteration in original). In support, Petitioner presents arguments regarding the relationship between the “first signal” and “first intermediate signal” recited in the claim. *See id.* at 1, 7–14. We have considered these arguments, but none reveal that we abused our discretion or misapprehended or overlooked a matter in our Decision.

First, Petitioner’s arguments are premised on an assumption that the claimed “first intermediate signal” can be the same as the “first signal.” *See* Req. 1, 8–10. We disagree. “Where a claim lists elements separately, the

clear implication of the claim language is that those elements are distinct components of the patented invention.” *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (cleaned up). Here, claim 1 recites a “first signal” and a “first intermediate signal,” and it specifies a specific relationship between those signals—the “first intermediate signal” must be generated “by applying the filter to the first signal.” Ex. 1001, 37:1–2. Neither the Petition nor the Request explain how the first intermediate signal and the first signal could satisfy this claim language if they are the same. Petitioner’s reliance on *Powell* (see Req. 9–10) is unavailing because, in *Powell*, the claim language did not require separate components. See *Powell v. Home Depot U.S.A., Inc.*, 663 F.3d 1221, 1231–32 (Fed. Cir. 2011) (explaining that *Becton* is distinguishable given the claim’s requirements). Moreover, the Petition did not argue that these signals could be the same, and the Decision cannot misapprehend or overlook an argument that was never made.

Second, we disagree with Petitioner’s argument that the Petition “identified substantial evidence from the written description and claims that demonstrates that the Institution Decision’s interpretation is incorrect.” Req. 9 (citing Pet. 19, 48–49); see also *id.* 10 (citing Pet. 18–20). When discussing claim 1, the Petition briefly addressed the scope of the terms “virtual microphone” and “forming,” but it failed to address the dispositive issue. See Pet. 19–20; see also *id.* at 22–23. As for dependent claim 11 (see Pet. 48–49), the Decision explained that the Petition failed to clearly state²

² Petitioner was obligated to make its contentions clear in the Petition. See 35 U.S.C. § 312(a)(3); see also, e.g., *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016).

that its analysis of this claim should be considered in connection with independent claim 1. Dec. 13. When evaluating claim 11, we would have considered claim 1's analysis (*see* Pet. 48), but we disagree with Petitioner's argument that the reverse should also be true. *See* Req. 14. In addition, the relevant discussion of claim 11 includes only a conclusory assertion and string citation, which are insufficient (*see* Dec. 13), and Petitioner fails to identify any arguments or evidence that we overlooked (*see* Req. 13–14). We cannot misapprehend or overlook an argument that was never made.

Third, even if the Request's new arguments had been included in the Petition, they would not have been persuasive because they are explained insufficiently. Petitioner contends that the claimed "first intermediate signal" is a subset of the claimed "first signal," and in support, Petitioner points to "plain language" of claim 1, a single passage from the Specification, and dependent claim 9. Req. 8, 10–12. Yet, none appear to support Petitioner's position. As for the "plain language" of the claim, Petitioner states that "first intermediate signal originates from the first physical microphone and therefore remains a signal 'of a first physical microphone'" (Req. 8), but this fails to show that the claimed "first intermediate signal" is a subset of the claimed "first signal."³ As for the Specification, Petitioner argues that the cited passage shows that signals "remain signals 'of a [first/second] physical microphone'" after different

³ To the extent Petitioner now contends that all signals derived from Elko's mic1 collectively map to the claimed "first signal" (*see* Req. 8), this contention was not presented in the Petition (*see* Pet. 18 (instead contending that the output of mic1 is the claimed "first signal")). Petitioner does not explain how the "first intermediate signal" can be a subset of the "first signal" identified in the Petition. *See* Req.

filters are applied (*id.* at 10–11 (alteration in original) (citing Ex. 1001, 5:20–6:29, Figs. 3–4)), but on this record, we cannot agree. The passage describes forming virtual microphones by applying one or more filters to the output of physical microphones O₁ and O₂, but it neither refers to a “signal” per se nor describes an “intermediate” signal. *See* Ex. 1001, 5:20–6:29. Finally, as for dependent claim 9, Petitioner argues that this claim “explicitly contemplate[s] a second filtered/intermediate signal remaining a second signal” (*id.* at 11), but again, Petitioner’s explanation is lacking. Claim 9 recites “forming a first virtual microphone by combining a first signal . . . and a second signal,” where that forming “comprises applying the filter to the second signal.” Ex. 1001, 36:62–64, 37:30–32. Petitioner asserts that “the same signal feeding into the first virtual microphone must be a second *filtered* signal *and* a second signal” (Req. 11), but we cannot agree. Moreover, contrary to Petitioner’s arguments (*id.* at 12), we discern no tension between the requirements of this claim and the understanding of claim 1 applied in the Decision (*cf.* Dec. 11–12).

Petitioner’s remaining arguments are inaccurate or inapposite. For example, Petitioner asserts that the Decision concluded “that the ‘first intermediate signal’ must be completely distinct from the ‘first signal,’” but the Decision made no such determination. Req. 8 (citing Dec. 12); *see* Dec. 12. Petitioner also asserts that “the same structure from Elko can[] be used when addressing both the ‘first signal’ and ‘first intermediate signal’” (Req. 8; *see id.* at 1), but this misses the mark. Although the same structure from Elko can be *discussed* for different claim elements, our Decision did not fault the Petition for merely discussing the same structure when addressing different elements. *See* Dec. 12. Rather, it found the Petition to

be deficient because it failed to sufficiently show that Elko discloses both of these different claim elements. *Id.*

Ultimately, Petitioner disagrees with our Decision and argues that we should have reached a different result. Mere disagreement with the Board's analysis or conclusion is not a proper basis for rehearing.

IV. CONCLUSION

Consequently, Petitioner has not persuaded us that we misapprehended or overlooked any matter or that we abused our discretion. Accordingly, we see no reason to modify our Decision in this proceeding.

V. ORDER

Accordingly, it is:

ORDERED that Petitioner's Request for Rehearing (Paper 15) is *denied*.

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