

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SPEAKWARE, INC.,
Patent Owner.

Case IPR2019-00340
Patent 6,397,186 B1

Before DEBRA K. STEPHENS, DAVID C. MCKONE, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Google LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–20 (“the challenged claims”) of U.S. Patent No. 6,397,186 B1 (Ex. 1001, “the ’186 patent”). SpeakWare, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition. Also, as authorized, Petitioner filed a Reply (Paper 10, “Reply”) to the Preliminary Response, and Patent Owner filed a Sur-reply (Paper 11, “Sur-reply”) to the Reply.

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Further, a decision to institute may not institute on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). After considering the evidence and arguments presented in the Petition, Preliminary Response, Reply, and Sur-reply, we determine that Petitioner demonstrates a reasonable likelihood of prevailing in showing that at least one of the challenged claims of the ’186 patent is unpatentable. Accordingly, we institute an *inter partes* review as to all the challenged claims of the ’186 patent on all the grounds of unpatentability set forth in the Petition.

A. *Related Proceedings*

The parties indicate that the ’186 patent is or has been the subject of several cases in the United States District Court for the Central District of California. Pet. 78–79; Paper 4, 1. The parties also indicate that the ’186

patent is the subject of a petition for *inter partes* review in IPR2019-00342. Pet. 78; Paper 4, 2.

B. *The '186 Patent*

The '186 patent relates to “a wireless, user-programmable, voice-activated and voice-operated remote control system for controlling appliances.” Ex. 1001, 1:6–9. According to the '186 patent, “[a]n important aspect of the invention relates to voice-actuated mode switching for switching the present invention from a low power consumption mode.” *Id.* at 4:31–33.

The '186 patent describes a system that includes a microphone, an audio switching circuit, a sound activation circuit, a speech recognition circuit, and a transmitter. *Id.* at 7:22–26. The '186 patent explains that the microphone receives sound, converts it into an output signal, and directs the output signal to the audio switching circuit. *Id.* at 7:43–46. If the speech recognition circuit is in speech recognition mode (i.e., it is awake), the audio switching circuit routes the output signal to the speech recognition circuit. *Id.* at 7:46–50. If, on the other hand, the speech recognition circuit is in sound activation mode (i.e., it is asleep), the audio switching circuit routes the output signal to the sound activation circuit. *Id.* at 7:50–53. The sound activation circuit includes an amplification circuit and a trigger circuit. *Id.* at 7:54–59. “If the amplified [output] signal is of sufficient amplitude to activate the trigger circuit . . . , the output of the trigger circuit causes a logic state change on the input/output pin of the speech recognition circuit . . . , causing the invention to change modes from a sleep or sound activation mode to an awake or speech recognition mode.” *Id.* at 7:62–67.

C. *Illustrative Claim*

Of the challenged claims, claim 1 is independent and is reproduced below.

1. An audio signal activated control system for controlling appliances comprising:

a microphone for receiving audio signals and converting said audio signals to electrical signals;

a speech recognition system for receiving said electrical signals, said speech recognition system including a processor and having a low power sound activation mode for detecting the presence of said electrical signals and a speech recognition mode for converting said electrical signals to electrical representative signals, decoding said electrical representative signals and generating control signals for controlling one or more appliances, wherein in said speech recognition mode said processor decodes said electrical representative signals and wherein in said sound activation mode said processor is in a low power state, said speech recognition system configured to automatically switch from said sound activation mode to said speech recognition mode as a function of the amplitude of said electrical signals; and

an appliance control circuit which includes a transmitter, said appliance control circuit configured to receive said control signals from said speech recognition system and generate and automatically transmit one or more appliance control signals to said one or more appliances.

Ex. 1001, 52:3–28.

D. *Evidence of Record*

Petitioner submits the following references and declaration (Pet. 2–3):

| Reference or Declaration | Exhibit No. |
|--|-------------|
| Salazar et al., U.S. Patent No. 5,802,467 (filed Sept. 28, 1995, issued Sept. 1, 1998) (“Salazar”) | Ex. 1002 |
| Miyazawa et al., U.S. Patent No. 5,983,186 (filed Aug. 20, 1996, issued Nov. 9, 1999) (“Miyazawa”) | Ex. 1003 |

| Reference or Declaration | Exhibit No. |
|---|--------------------|
| Bossemeyer, Jr., U.S. Patent No. 6,012,027 (filed Sept. 17, 1997, issued Jan. 4, 2000) (“Bossemeyer”) | Ex. 1004 |
| Oppendahl, U.S. Patent No. 5,008,954 (filed Sept. 24, 1990, issued Apr. 16, 1991) (“Oppendahl”) | Ex. 1005 |
| Reichel et al., U.S. Patent No. 5,459,792 (filed Dec. 15, 1993, issued Oct. 17, 1995) (“Reichel”) | Ex. 1006 |
| Clark et al., U.S. Patent No. 6,425,086 B1 (filed Apr. 30, 1999, issued July 23, 2002) (“Clark”) | Ex. 1007 |
| Douma et al., U.S. Patent No. 5,583,965 (filed Sept. 12, 1994, issued Dec. 10, 1996) (Douma”) | Ex. 1008 |
| Declaration of Stuart J. Lipoff (“Lipoff Declaration”) | Ex. 1009 |

E. *Asserted Grounds of Unpatentability*

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 3):

| Claim(s) | Basis | References |
|-----------------------|--------------------|--|
| 1–4, 7–16, 19, and 20 | 35 U.S.C. § 103(a) | Salazar and Miyazawa |
| 1–4, 7–16, 19, and 20 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, and Bossemeyer |
| 5 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, and Oppendahl |
| 5 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, Bossemeyer, and Oppendahl |
| 6 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, and Reichel |
| 6 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, Bossemeyer, and Reichel |
| 8 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, and Clark |
| 8 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, Bossemeyer, and Clark |
| 17 and 18 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, and Douma |
| 17 and 18 | 35 U.S.C. § 103(a) | Salazar, Miyazawa, Bossemeyer, and Douma |

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.