

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SPEAKWARE, INC.,
Patent Owner.

Case IPR2019-00342
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 21–55 (“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. 83–84; Paper 4, 1. The parties also indicate that the ’186

patent is the subject of a petition for *inter partes* review in IPR2019-00340. Pet. 83; 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, claims 21 and 41 are independent. Claim 21 is reproduced below.

21. An audio signal activated control system for controlling one or more appliances, said control system comprising:

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

a speech recognition circuit including a processor and having a plurality of modes of operation including a speech recognition mode and a low power sound activation mode, wherein in said speech recognition mode said speech recognition circuit converts said electrical signals to electrical representative signals and said processor decodes said electrical representative signals and wherein in said sound activation mode said processor is placed in a low power state;

a sound activation circuit configured for determining if the amplitude of said electrical signals exceeds a predetermined threshold and causing said speech recognition circuit to switch automatically from said sound activation mode to another of said plurality of said modes of operation;

said speech recognition circuit configured for generating first control signals in said speech recognition mode if said electrical signals represent one or more predetermined audible commands, said speech recognition circuit configured for switching automatically from said speech recognition mode to another of said plurality of said modes of operation under predetermined conditions; and

an appliance control circuit configured for receiving said first control signals from said speech recognition circuit and generating second control signals to cause one or more appliances to perform one or more functions associated with said first control signals.

Ex. 1001, 53:55–54:19.

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
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
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
21, 23–26, 28–36, 39–41, 43–52, and 55	35 U.S.C. § 103(a)	Salazar and Miyazawa
21, 23–26, 28–36, 39–41, 43–52, and 55	35 U.S.C. § 103(a)	Salazar, Miyazawa, and Bossemeyer
22 and 42	35 U.S.C. § 103(a)	Salazar, Miyazawa, and Oppendahl
22 and 42	35 U.S.C. § 103(a)	Salazar, Miyazawa, Bossemeyer, and Oppendahl
27	35 U.S.C. § 103(a)	Salazar, Miyazawa, and Reichel
27	35 U.S.C. § 103(a)	Salazar, Miyazawa, Bossemeyer, and Reichel
37, 38, 53, and 54	35 U.S.C. § 103(a)	Salazar, Miyazawa, and Douma

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