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Sonos, Inc. v. Google LLC: CAFC Leaves Expanded Role for Prosecution Laches in Limbo

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The practice of serially filing continuation applications through a patent's lifetime has come under increased pressure in recent years from newly implemented continuing application fees to expanded case law on non-statutory obviousness-type double patenting. A somewhat new interpretations of the doctrine of prosecution laches emerging from *Sonos, Inc. v. Google, LLC* in late 2023, however, that threatened an outright repudiation of the practice late into a patent's 20-year term. In a post-trial motion, District Court Judge William H. Alsup set aside a $32.5M jury verdict that Google infringed Sono's 10,469,966 and 10,848,885 patents, finding the patents unenforceable due to a 13-year delay from the priority date to the filing of the continuation applications that resulted in the patents at issue. Recently a Court of Appeals for the Federal Circuit (CAFC) panel of Chief District Judge Bumb and Judges Lourie and Prost reversed the finding of laches as unsupported by the evidence nonprecedential decision, stopping short of repudiating the possibility of finding laches for continuation applications filed late into a patent's 20-year term.

Prosecution laches most commonly is associated with the issue of “submarine patents.” These increasing rare cases are relics of the pre- Uruguay Round for the General Agreement on Tariffs and Trade (GATT) system where patent term was calculated based on the time of issuance rather than filing date. Under the old law, applicants could be incentivized to delay the issuance of a patent to better align patent term with commercial use of the invention. More problematically was the use of long pending and unpublished applications to coerce royalties from parties that often independently developed their own products, unaware of pending patent applications for related technologies. Prosecution laches offered an affirmative defense to these alleged infringers, rendering an otherwise valid patent unenforceable in these cases where the patent owner engaged in unreasonable and unexplained delay in prosecution that, in totality of the circumstances, constitutes an egregious misuse of the patent system that prejudiced the defendant. *Hyatt v. Hirshfeld*. Following a transition period after GATT, the United States switched to calculating patent term as 20-years from the application’s filing date, greatly reducing the threat of submarine patents and leaving some to question what role of prosecution laches would serve going forward, or even if the doctrine would survive at all.

Returning to the dispute between Google and Sonos, Judge Alsup found Sonos’s continuation applications—filed thirteen years from the priority date—unenforceable due to the “unreasonable, inexcusable, and prejudicial delay” in pursing the claimed subject matter. To be clear, Sonos’s later filed continuation applications were entirely within its statutory rights. The conduct constituting unreasonable delay here according to the court was that Sonos had waited too long to claim the subject matter of the patents, amounting to “wringing fresh claims to read on a competitor’s products from an ancient application.” In this interpretation, Sonos’s published application served as a new kind of “submarine patent,” allegedly obfuscating the claimed invention through a complex priority chain, delayed publication of the application, and nonpublication of the priority application. While the patents at issue were all filed post-GATT—and thus did not benefit in an extended term from delaying issuance—the opinion nonetheless maintained that Sonos’s continuation applications amounted to a different form of “submarine patent” intended to ambush Google, notably focusing the analysis as to a lack of explanation for why Sonos did not pursue the patents until more than a decade into the patent term.

In reviewing the lower court's finding of laches, the CAFC panel confined its analysis to the prejudice suffered by Google, sidestepping the issue of whether the 13-year wait by Sonos before prosecuting the claimed invention constituted unreasonable and unexplained delay. Ultimately, the panel determined that no evidence on the record could support a finding of prejudice, reversing the finding of laches as an abuse of discretion. Key was that the record only substantiated that Google developed their allegedly infringing products *after* the publication of Sonos's patent specification. As such, there was "no evidence that [Google] suffered prejudice attributable to Sonos's delay in claiming, but not disclosing," the invention at issue.

CAFC's analysis in determining prejudice using a patent's publication as providing notice to potential infringers should provide applicants with some relief, but cabining the analysis to the issue of prejudice leaves many questions as to the limits of prosecution laches unanswered. Likewise, focusing on the publication of Sonos's specification as pre-dating Google's investments provided CAFC with an easy path to dispose of the issue, counterfactuals abound with the opinion providing little guidance. Navigating prosecution of continuing applications in commercially important families has become increasingly complex. Until CAFC speaks to the issue more directly, prosecution laches may become yet another consideration when planning and evaluating patent portfolios.

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