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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA,  
SAN FRANCISCO DIVISION

SONOS, INC.,  
Plaintiff and Counter-defendant,  
v.  
GOOGLE LLC,  
Defendant and Counter-claimant.

Case No. 3:20-cv-06754-WHA  
Related to Case No. 3:21-cv-07559-WHA

**SONOS, INC.'S MOTION *IN LIMINE*  
NO. 3 TO EXCLUDE INVALIDITY  
BASED ON LACK OF WRITTEN  
DESCRIPTION OR ENABLEMENT  
FOR THE '885 AND '966 PATENTS**

Judge: Hon. William Alsup  
Pretrial Conf.: May 3, 2023  
Time: 12:00 p.m.  
Courtroom: 12, 19th Floor  
Trial Date: May 8, 2023

SONOS, INC.'S MOTION *IN LIMINE* No. 3 TO  
EXCLUDE INVALIDITY BASED ON LACK OF WRITTEN

**NOTICE OF MOTION**

TO ALL PARTIES AND THEIR ATTORNEYS:

PLEASE TAKE NOTICE that on May 3, 2023 at 12:00 p.m., or as soon thereafter as may be heard before the Honorable Judge William H. Alsup, in Courtroom 12 on the 19th Floor of the United States District Court for the Northern District of California, San Francisco Courthouse, 450 Golden Gate Avenue, San Francisco, CA 94102, Sonos, Inc. (“Sonos”) will, and hereby does, move this Court to preclude argument, evidence, or references that the ’885 and ’966 patents are invalid for lack of written description or enablement under 35 U.S.C. § 112. This motion is based on this Notice of Motion and Motion, the accompanying Memorandum of Points and Authorities, the Declaration of Joseph R. Kolker (“Kolker Decl.”), all exhibits filed herewith, all documents in the Court’s file, and such other written or oral evidence and argument as may be presented at or before the time this motion is heard by the Court.

**STATEMENT OF THE RELIEF REQUESTED**

Sonos requests that this Court exclude any argument, evidence, or references that the ’885 and ’966 patents are invalid for lack of written description or enablement.

**MEMORANDUM OF POINTS AND AUTHORITIES****I. INTRODUCTION**

Google should not be permitted to present evidence or argument that the '885 and '966 patents are invalid for lack of enablement or written description. The Court granted summary judgment on Google's written description challenge to the '885 patent. Google did not provide any expert opinion that the '966 patent—which has the same specification as the '885 patent and the same relevant claim language—is invalid for lack of written description. Together with the prior summary judgment ruling, Google therefore has no basis for presenting a written description challenge to the '966 patent at trial. Meanwhile, Google has provided no expert opinion that either patent is invalid for lack of enablement. Accordingly, at trial, Google should be precluded from making any argument, introducing any evidence, or making any references whether the '885 and '966 patents meet the written description and enablement requirements of § 112, including any argument that if the '885 and '966 patents are enabled, the prior art must be as well.

**II. STATEMENT OF RELEVANT FACTS**

Sonos asserts that Google directly and indirectly infringes two patents: U.S. Patent No. 10,848,885 (“the '885 patent”) and U.S. Patent No. 10,469,966 (“the '966 patent”). The '885 and '966 patents are referred to as the “Zone Scenes” patents. They share the same specification and both claim aspects of Sonos's zone scenes technology.

As relevant here, at the showdown summary judgment stage, the Court concluded that certain Google products infringe the '885 patent, and the Court rejected Google's written description challenge to the '885 patent. Dkt. 309 at 14-17.

At the very early stages of this case, Google asserted § 112-based invalidity claims with respect to both the '966 and '885 patents. *See* Kolker Decl. Ex. A at 18-21, 25-28. Google contended that both the '966 and '885 patent claims “may fail to satisfy the requirements of §112, ¶ 1 because the specification and original patent application fail to provide an enabling disclosure of and written description support for” certain claim limitations and terms. *Id.* at 19-20, 26.

At the showdown summary judgment stage, Google moved for summary judgment of

1 invalidity of claim 1 of the '885 patent, contending that the patent's "claimed set of operations"  
2 lacked written description support. Dkt. 247-3 at 18-25.

3 The Court considered and rejected Google's argument. First, the Court rejected Google's  
4 specific argument "that the specification 'never discloses that a zone player may be added to two  
5 zone scenes at the same time,'" noting that Figure 5B of the specification and other disclosures in  
6 the specification "adequately convey that a zone player can be added to multiple zone scenes."  
7 Dkt. 309 at 14-15. Second, the Court rejected Google's contention "that the specification does  
8 not provide support for the zone player 'continuing to operate in the standalone mode until a  
9 given one of the first and second zone scenes has been selected for invocation' and 'transitioning  
10 from operating in the standalone mode to operating in accordance with the given one of the first  
11 and second predefined groupings of zone players.'" *Id.* at 15. The Court noted that while  
12 "Google repeatedly points out [that] the specification never expressly refers to the term  
13 'standalone mode,'" "the specification does not have to use the term verbatim to provide  
14 sufficient disclosure," and it "does so here." *Id.* at 16-17.

15 With Google's leading § 112 argument removed from play, Google stopped pursuing  
16 written description or enablement challenges to the '885 or '966 patents. Google's remaining  
17 invalidity challenges to these zone scene patents are all laid out in the opening expert report of  
18 Google's technical expert, Dr. Schonfeld. *See* Kolker Decl. Ex. B at i-ix. Dr. Schonfeld contends  
19 that both patents are invalid based on alleged prior art, but offers no opinion on any written  
20 description or enablement challenges. *Id.* And Google's pending motion for summary judgment,  
21 like Dr. Schonfeld's invalidity report, asserts only prior art-based invalidity claims with respect to  
22 the '885 and '966 patents. *See* Dkt. 483 at i-ii.

23 As relevant here, Google contends that the combination of the Sonos 2005 system and  
24 Sonos Forum posts render the asserted claims of the '885 and '966 patents obvious. *See id.* at 18-  
25 20. In opposition, Sonos explains, among other things, that nothing in these asserted references  
26 teach "a person of ordinary skill in the art how to implement the claimed 'zone scene'  
27 technology," and the "Sonos Forum posts express a mere hope that Sonos would one day invent  
28

1 technology that allowed users to have ‘virtual zones,’ without providing any direction, guidance,  
2 or working examples of how to carry out the invention.” Dkt. 508 at 18. For these as well as  
3 other reasons, Sonos explains that Google’s asserted prior art fails to teach the challenged claim  
4 limitations and also fails to enable the claimed invention. *See id.* at 17-18.

5 In the face of Sonos’s proffered evidence showing lack of enablement by the prior art,  
6 Google pivoted, and argued that the *patent* claims are pitched at the same level of generality as  
7 the prior art, which was somehow a flaw in Sonos’s response to Google’s invalidity arguments:

8 Sonos argues that the combination of the Sonos Forums and Sonos 2005 system  
9 would not “enable a skilled artisan to make and use the claimed invention” because  
10 they do not teach “critical details” such as the “programming” for how the speakers  
11 would interact with a controller, how the speakers would operate, and how they  
12 would be commanded to play back music.[] Opp. at 17-18. But, critically, the patent  
13 claims also do not recite any of these “details” or “programming.”

14 Dkt. 538 at 10. At oral argument, Google leaned into this position, defending its “obviousness  
15 case” by pointing the Court back to its prior “ruling on written description,” Ex. C at 60:9-14, in  
16 which the Court held that that the specification underlying the ’885 patent provided adequate  
17 written description support for claim 1 of that patent, Dkt. 309 at 14-17. Summarizing Google’s  
18 argument, the Court asked:

19 But on that last point, I’m asking this question. If the specification, itself, does not  
20 elaborate on how to save [speaker groups], can we take that under the case -- does  
21 the case law say we can take that as an admission against interest to the patentholder  
22 that anybody skilled in the art would know how to do it?

23 Ex. C at 66:19-24. Counsel for Google responded “[y]es, Your Honor,” and contended that  
24 support for this proposition could be found in “the *KSR* case.” *Id.* at 66:25-67:4.

25 Google similarly defended its obviousness case—and its contention that the prior art is  
26 enabling—by arguing the *specification* underlying the ’885 patent lacks explicit references to the  
27 claimed “indication” that a speaker has been added to a speaker group: “Just like with saving,  
28 Your Honor, you can look through the entire patent, and you won’t even see any algorithms or  
any specific messages on this indication. The only time the word ‘indication’ ever shows up is in

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