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December 13, 2019

The Honorable Leonard P. Stark
United States District Court
844 North King Street
Wilmington, DE 19801

VIA ELECTRONIC FILING

Re: *Arendi S.A.R.L. v. LG Elecs., Inc., et al.*, C.A. No. 12-1595-LPS
Arendi S.A.R.L. v. Apple Inc., C.A. No. 12-1596-LPS
Arendi S.A.R.L. v. Microsoft Mobile, Inc., C.A. No. 12-1599-LPS
Arendi S.A.R.L. v. Motorola Mobility LLC, et al., C.A. No. 12-1601-LPS
Arendi S.A.R.L. v. Sony Mobile Commc'ns (USA) Inc., e. al., C.A. No. 12-1602-LPS
Arendi S.A.R.L. v. Google LLC, C.A. No. 13-919-LPS
Arendi S.A.R.L. v. Oath Holdings Inc., et al., C.A. No. 13-920-LPS

Dear Chief Judge Stark:

Pursuant to the Court's October 28, 2019 Order, Defendants[1] submit this letter responding to the questions in the "101 Motions Pre-Hearing Checklist" for the December 20, 2019 Hearing on Defendants' Motion for Judgment on the Pleadings (D.I. 115[2]).

1. (a) What claim(s) is/are representative? (b) For which claim(s) must the Court determine eligibility?

As discussed in Defendants' letter briefing on this question (D.I. 134 and 137), Arendi and Defendants agree that claim 1 of the '843 patent, claim 2 of the '356 patent and claim 1 of the '993 patent are representative of the claims in those respective patents. Google and Oath contend that either claim 13 or claim 93 is representative of the claims in the '854 patent.

Defendants disagree with Arendi's prior assertion that the Court should also separately evaluate the patent ineligibility of the dependent claims if the independent claims are found to be patent ineligible. (D.I. 135 at 2-3.) Arendi did not provide any argument in its opposition to the Section 101 Motion or in the prior letter briefing to the Court articulating why the dependent claims would be patent-eligible if the representative claims are not, and has therefore waived any

[1] The Blackberry defendants (C.A. No. 12-1597) did not join the Motion and therefore do not join this letter.

[2] All docket references in this letter cite to C.A. No. 12-1595.

such argument. *See, e.g. Athena Diagnostics, Inc. v. Mayo Collaborative Svcs., LLC*, 915 F.3d 743, 756 (Fed. Cir. 2019) (holding that arguments specific to claims not specifically addressed in plaintiff's briefing were waived); *British Telecomms. PLC v. IAC/InterActiveCorp*, 381 F. Supp. 3d 293, 321-22 (D. Del. 2019) (same).

2. (a) Is claim construction necessary before patentability can be decided? (b) If so, which terms must be construed? (c) What are your proposed constructions for the term(s) you contend must be construed?

No. Claim construction in this matter has been fully briefed and argued, and the Court issued a Claim Construction Opinion on August 19, 2019. Defendants do not believe any further claim construction is necessary to decide the subject matter eligibility of the Asserted Claims. As discussed in Defendants' prior letter briefing on this question (D.I. 134 and 137), which is incorporated by reference, the Court's claim construction rulings provide further support for Defendants' Motion.

3. If you are contending that factual dispute(s) should cause the Court to deny the motion, identify with specificity such factual dispute(s).

Defendants do not contend that there are any relevant factual disputes and none were identified by Arendi in the briefing on the Motion.

4. (a) Are there materials other than the complaint/answer and the intrinsic patent record (i.e., the patent and prosecution history) that you contend the Court should consider in evaluating the motion? (b) If so, identify those materials and the basis on which the Court may properly consider them at this stage.

Defendants do not contend there are any additional materials beyond the Complaints, the Answers and the intrinsic patent record that that Court should consider in evaluating the Motion.

Arendi attached three unrelated patents addressed in Federal Circuit patent eligibility cases to its Responsive Brief. (D.I. 128, Exs. 5-7.) These unrelated patents are not relevant to the subject matter eligibility of the Asserted Claims and not properly before the Court for consideration on a Motion for Judgment on the Pleadings.

5. What Supreme Court or Federal Circuit case is this case most like? That is, if the Court is to analogize the claims at issue in the motion to claims that have previously been found to be patent (in)eligible by a higher court, which case provides the best analogy?

The most analogous Federal Circuit case to the Asserted Claims is *Content Extraction & Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343 (Fed. Cir. 2014). Similar to the claims at issue here, the *Content Extraction* claims generally recited 1) extracting data from documents,

2) recognizing specific information from the extracted data, and 3) storing that information in a memory. *Id.* at 1345.

Regarding Step One of *Alice*, the Federal Circuit found that the *Content Extraction* claims were directed to the abstract idea of recognizing and storing certain data within the collected data set. *Id.* at 1347. Although the claims recited hardware devices like a "scanner," the Federal Circuit still found the claims invalid because "[t]he concept of data collection, recognition, and storage is undisputedly well-known" and "humans have always performed these functions." *Id.* Similarly, the Asserted Claims here are directed to the abstract idea of identifying information in a document (like a name in a letter), searching for related information in a separate source (such as an address book), and using the related information found in some way (like addressing the letter). In fact, the Asserted Patents admit that the basic abstract idea of identifying information in a document, searching for related information and using the related information predates its invention, and simply propose taking what was done manually and automating it on a computer (*e.g.*, '843, 1:28-42).

Turning to the second step of *Alice*, the Federal Circuit determined that the *Content Extraction* claims were not directed to an inventive concept because they "merely recite[d] the use of existing scanning and processing technology to recognize and store data from specific data fields such as amounts, addresses, and dates." *Id.* at 1348. The Federal Circuit considered the claim limitations – both individually and as an ordered combination – and held there was no inventive concept in the use of generic computer hardware "to perform well-understood, routine, and conventional activities commonly used in industry." *Id.* Similarly, there is no inventive concept in Arendi's Asserted Claims because they require no more than generic computers, word processors, and database programs to implement the abstract idea and fail to describe *how* to program a conventional computer system in order to implement the abstract idea.

6. Why should/shouldn't the Court deny the motion without prejudice to renew at a later stage of this litigation?

There is no reason to delay a decision on patent eligibility in this matter. Claim construction and fact discovery are complete. Moreover, Arendi has not identified any factual disputes or other issues that would preclude the Court resolving the Motion at this time.

Respectfully,

/s/ Jack B. Blumenfeld

Jack B. Blumenfeld (#1014)

JBB/bac

cc: Clerk of the Court (via hand delivery)
All Counsel of Record (via electronic mail)