

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

ARENDI S.A.R.L.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 12-1595-LPS
)	
LG ELECTRONICS, INC.,)	
LG ELECTRONICS USA, INC. and)	
LG ELECTRONICS MOBILECOMM U.S.A.,)	
INC.,)	
)	
Defendants.)	
ARENDI S.A.R.L.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 12-1596-LPS
)	
APPLE INC.,)	
)	
Defendant.)	
ARENDI S.A.R.L.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 12-1599-LPS
)	
MICROSOFT MOBILE INC.,)	
)	
Defendant.)	
ARENDI S.A.R.L.,)	
)	
Plaintiff,)	
)	
v.)	C.A. No. 12-1601-LPS
)	
MOTOROLA MOBILITY LLC)	
f/k/a MOTOROLA MOBILITY, INC.,)	
)	
Defendant.)	
)	

ARENDI S.A.R.L.,)
)
 Plaintiff,)
)
 v.) C.A. No. 12-1602-LPS
)
 SONY MOBILE COMMUNICATIONS (USA))
 INC. f/k/a SONY ERICSSON MOBILE)
 COMMUNICATIONS (USA) INC.,)
 SONY CORPORATION and)
 SONY CORPORATION OF AMERICA,)
)
 Defendants.)

ARENDI S.A.R.L.,)
)
 Plaintiff,)
)
 v.) C.A. No. 13-919-LPS
)
 GOOGLE LLC,)
)
 Defendant.)

ARENDI S.A.R.L.,)
)
 Plaintiff,)
)
 v.) C.A. No. 13-920-LPS
)
 OATH HOLDINGS INC., and)
 OATH INC.,)
)
 Defendants.)

**ARENDI S.A.R.L.’S LETTER RESPONDING TO THE COURT’S SECTION 101
MOTIONS PRE-HEARING CHECKLIST**

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Dated: December 13, 2019

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Attorneys for Plaintiff Arendi S.A.R.L.

Dear Chief Judge Stark:

In accordance with the Court's October 28, 2019 Order, Plaintiff Arendi S.A.R.L. ("Arendi") submits this letter to address the questions in the Court's "Section 101 Motions Pre-Hearing Checklist." *See* D.I. 175.¹

1. (a) What claims are representative?

Arendi submits that claim 1 is representative of the asserted claims of the '843 Patent. Arendi submits that claim 1 is representative of the asserted claims of the '993 Patent. For the '356 Patent, Arendi submits that claim 2 is representative. For the '854 Patent, Arendi submits that claim 93 is representative.

(b) For which claims must the Court determine eligibility?

'843 Patent: Defendants seek to invalidate all asserted claims of the '843 Patent. Claims 1 and 23 are asserted against all Defendants. Claims 8 and 30 are asserted against all Defendants except Oath Holdings Inc. and Oath Inc. Claims 13, 15, 17, 18, and 19 are asserted against Google only.

'993 Patent: Defendants seek to invalidate all asserted claims of the '993 Patent. Claims 1, 5, 8, 9, 16, 17, and 24 are asserted against all Defendants. Claims 13 and 21 are asserted against all Defendants except Oath Holdings Inc. and Oath Inc. Claim 2 is asserted against Oath Holdings Inc., Oath Inc, and Google. Claim 18 is asserted against all Defendants except Microsoft Mobile Inc., Google, Oath Holdings Inc., and Oath Inc.²

'356 Patent: Claims 2, 11, and 19 are asserted against Google. Google seeks to invalidate claims 2, 11, and 19.

'854 Patent: Claim 93 is asserted against Google; Google seeks to invalidate claim 93. Other asserted claims were held indefinite during claim construction.

2. (a) Is claim construction necessary before patentability can be decided?

The Court has already issued a claim construction order, *see* D.I. 143, and the parties have submitted letter briefs addressing the constructions' effect on this §101 motion, *see* D.I. 148, 149, 151, 152. As Arendi explained in its opening letter brief, the Court's claim construction order confirms that the asserted claims are directed to a specific method for solving a computer-based problem, narrows the preemptive footprint of the claims, and solidifies the non-abstract character of the claims. D.I. 149, at 1-2.

¹ Unless otherwise noted, all docket items refer to Case No. 13-cv-919.

² D.I. 149 inadvertently stated that claim 2 of the '993 Patent was not asserted against the Oath Defendants and that claims 13 and 21 are being asserted. Claims 13 and 21 are not asserted against the Oath Defendants. Claim 2 is being asserted against the Oath Defendants.

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

A motion for judgment on the pleadings will be granted “only if no relief could be afforded under any set of facts that could be proved.” *Intellectual Ventures I LLC v. AT&T Mobility LLC*, 235 F. Supp. 3d 577, 584 (D. Del. 2016). Defendants’ motions can be resolved in Arendi’s favor at step one because the claims are not drawn to an abstract idea. Should the Court, however, consider under *Alice* step two whether any claim “involve[s] more than the performance of well-understood, routine, [and] conventional activities previously known to the industry,” the following factual disputes exist. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018); *see also Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1318 (Fed. Cir. 2019) (“[F]actual disputes about whether an aspect of the claims is inventive may preclude dismissal at the pleadings stage under §101.”).

As Arendi explained in its Responsive Brief, D.I. 139, the patents’ specification recites how the claimed inventions “allow the user to locate, retrieve, and use information from an outside data source without having to leave or stop working within a document.” *Id.* at 1. As the specification notes, the inventions provide “a function item ... [that] initiates retrieval of a name and address and/or other person or company related information, while the user works simultaneously in another document, e.g., a word processor.” *Id.* at 2 (citing ’843 Patent col. 2 ll. 14-23). Realizing the benefits of the invention “requires little to no training on the part of the user” and can be accomplished “with a minimal number of user commands.” *Id.* at 3 (citing ’843 Patent at col. 9 ll. 51-54). The Federal Circuit described the invention as “directed to providing beneficial coordination between a first computer program displaying a document and a second computer program for searching an external information source”; echoing the specification, it said, “the patent allows a user to access and conduct a search using the second computer program while remaining in the first computer program displaying the document.” *Arendi S.A.R.L. v. Apple, Inc.*, 832 F.3d 1355, 1357 (Fed. Cir. 2016).

Like the claims in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), the claims give users access to outside content without forcing them to separately launch another computer program, and they do so in a way that breaks with the expected sequence of events. At a minimum, a question of fact thus exists about whether these features of the inventions are more than well-understood, routine, and conventional activity suggested by prior art. *Berkheimer*, 881 F.3d at 1367.

- 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 evaluation the motion?**
(b) If so, identify those materials and the basis on which the Court may properly consider them at this stage.

Yes. The Court can, and should, consider the patents at issue in the Federal Circuit cases cited by Arendi in opposition to the motion. In particular, the Court should consider the patents attached as Exhibits 5-7 to Arendi’s responsive §101 brief. *See* D.I. 139-1. These patents may properly be considered because they are incorporated by reference into the opinions discussing them and they are matters of public record. *See Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1008 n.9

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