

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

ARENDI S.A.R.L.,)	
)	C.A. No. 12-1601-LPS
Plaintiff,)	
vs.)	
)	
MOTOROLA MOBILITY LLC f/k/a)	
MOTOROLA MOBILITY, INC.,)	
)	
Defendant.)	
ARENDI S.A.R.L.,)	
)	C.A. No. 13-919-LPS
Plaintiff,)	
vs.)	
)	
GOOGLE INC.,)	
)	
Defendant.)	

PLAINTIFF’S NOTICE OF SUBSEQUENT AUTHORITY

In accordance with D. Del. L.R. 7.1.2(b), Plaintiff Arendi S.A.R.L. (“Arendi”) submits this notice of subsequent authority in support of Plaintiff Arendi S.A.R.L.’s Motion for Partial Summary Judgment (C.A. No. 12-1601-LPS, D.I. 277, and C.A. No. 13-919-LPS, D.I. 281).

Arendi argued in support of its motion that the *inter partes* review (“IPR”) estoppel provision of 35 U.S.C. § 315(e)(2) barred Defendants Google Inc. and Motorola Mobility, Inc. (collectively “Defendants”) from raising grounds of invalidity that they reasonably could have raised, but omitted, from their IPR petition. *E.g.*, C.A. No. 12-1601-LPS, D.I. 278 at 7-8; C.A. No. 13-919-LPS, D.I. 282 at 7-8. Arendi argued that, notwithstanding *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016), such grounds were within the scope of IPR estoppel. *Id.* Defendants did not contest that legal point. *Cf.* C.A. No. 12-1601-LPS, D.I. 344 (arguing only that estoppel did not apply to grounds *included in their petition* for which the PTAB declined to institute IPR).

Last week, the Federal Circuit issued its opinion in *California Institute of Technology v. Broadcom Ltd.*, No. 2020-2222 (Fed. Cir. Feb. 4, 2022), expressly overruling *Shaw*. A copy of the opinion is attached hereto as Exhibit A. The Federal Circuit “overrule[d] *Shaw* and clarif[ied] that estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all claims and grounds not in the IPR but which reasonably could have been included in the petition.” Slip Op. at 23; *see also id.* at 22–23 (“Given the statutory interpretation in [*SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018)], any ground that could have been raised in a petition is a ground that could have been reasonably raised ‘during inter partes review.’”). The Federal Circuit thus affirmed the district court’s decision to bar defendants from raising grounds of invalidity because the defendants “were aware of the prior art references that they sought to raise in the district court” at the time of the IPR petition and “reasonably could have been included in the petitions, and thus in the IPR.” *Id.* at 24.

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SMITH, KATZENSTEIN & JENKINS LLP

Of Counsel:

Seth Ard
Beatrice Franklin
Max Straus
SUSMAN GODFREY, LLP
1301 Avenue of the Americas, 32nd Floor
New York, NY 10019
(212) 336-8330
sard@susmangodfrey.com
bfranklin@susmangodfrey.com
mstraus@susmangodfrey.com

/s/ Eve H. Ormerod
Neal C. Belgam (No. 2721)
Eve H. Ormerod (No. 5369)
Julie M. O’Dell (No. 6191)
1000 West Street, Suite 1501
Wilmington, DE 19801
(302) 652-8400
nbelgam@skjlaw.com
eormerod@skjlaw.com
jodell@skjlaw.com

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

John Lahad
Ibituroko-Emi Lawson
Robert Travis Korman
Brenda Adimora
1000 Louisiana Street, Suite 5100
Houston, TX 77002-5096
jlahad@susmangodfrey.com

elawson@susmangodfrey.com
tkorman@susmangodfrey.com
badimora@susmangodfrey.com

Kalpana Srinivasan
SUSMAN GODFREY, LLP
1900 Avenue of the Stars, Suite 1400
Los Angeles, CA 90067
(310) 789-3106
ksrinivasan@susmangodfrey.com