IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ARENDI S.A.R.L., Plaintiff, v. MOTOROLA MOBILITY LLC F/K/A MOTOROLA MOBILITY, INC., Defendant.	)	C.A. No. 12-1601-LPS **JURY TRIAL DEMANDED**
ARENDI S.A.R.L., Plaintiff, v. GOOGLE LLC, Defendant.	)	C.A. No. 13-919-LPS **JURY TRIAL DEMANDED**

DEFENDANTS' RESPONSE TO PLAINTIFF'S
NOTICE OF SUBSEQUENT AUTHORITY

On February 11, Plaintiff Arendi S.A.R.L. ("Arendi") filed a Notice of Subsequent Authority (Motorola D.I. 380; Google D.I. 387), in which it submitted to the Court the Federal Circuit's opinion in *California Institute of Technology v. Broadcom Ltd.*, No. 2020-2222 (Fed. Cir. Feb 4, 2022). Arendi highlighted that, "[T]he Federal Circuit 'overrule[d] *Shaw [Industries Group Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293 (Fed. Cir. 2016) in light of *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018)] 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.'" (Motorola D.I. 380; Google D.I. 387 at 1 (quoting *California Institute of Technology*, Slip Op. at 23).)

The *California Institute of Technology v. Broadcom Ltd*. opinion is not relevant to the issues in the captioned cases, however, because (1) the opinion dealt only with printed prior art potentially subject to IPR estoppel, not system art of the type at issue in these matters, and (2) the opinion explicitly recognized that it was not addressing the situation involved in these cases, where the relevant IPR proceedings were fully completed prior to the *SAS* decision, and where the IPR proceedings were instituted on only some of the grounds raised in the IPR petitions. In fact, footnote 5 of the *California Institute of Technology* opinion explicitly states: "In this case, *SAS* was decided while IPR proceedings remained pending before the Board. Accordingly, we need not decide the scope of preclusion in cases in which the Board declined to institute on all grounds and issued its final written decision pre-*SAS*." *California Institute of Technology*, Slip Op. at 23-24.

Arendi's Notice of Supplemental Authority is thus irrelevant to the issues presented by Arendi's pending Motions for Partial Summary Judgment (Motorola D.I. 277; Google D.I. 281).

Respectfully submitted,

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