

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

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ARENDI S.A.R.L.,

Plaintiff,

v.

GOOGLE LLC,

Defendant.

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) C.A. No. 13-919-JLH  
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LETTER TO THE HONORABLE JENNIFER L. HALL FROM NEAL BELGAM  
REGARDING PRIOR ART ESTOPPEL

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Dated: April 11, 2023

Dear Judge Hall:

At the Court's direction after the Final Pretrial Conference in this matter on April 6, Google finally disclosed its long overdue prior art combinations on Friday, April 7. As Arendi previewed during the Pretrial Conference, it expected there may be estopped art or art subject to evidentiary objections once Google disclosed the eight combinations permitted under the Court's order. Many of Google's now-disclosed combinations feature CyberDesk. Google is estopped from relying on the CyberDesk prior art and any grounds that include CyberDesk. Because this implicates what may be shown to the jury during opening, Arendi respectfully requests the Court address this issue as soon as practicable.

In accordance with its representation at the Pretrial Conference, Google identified the following grounds of invalidity on April 7, 2023:

- Anticipation based on the CyberDesk System
- Obviousness based on the following combinations:
  1. Pandit + CyberDesk System
  2. Pandit + Apple Data Detectors System
  3. Pandit + Newton System
  4. CyberDesk System + Chalas
  5. CyberDesk System + Apple Data Detectors System
  6. CyberDesk System + Newton System
  7. CyberDesk System + Microsoft Word 97 System
  8. Apple Data Detectors System + Microsoft Word 97 System

The so-called "CyberDesk System" is subject to IPR estoppel under 35 U.S.C. §315(e)(2) because it is cumulative of a ground that Google reasonably could have raised during IPR of the Patent-in-Suit. *Cal. Inst. of Tech. v. Broadcom Ltd.*, 991 (Fed. Cir. 2022) ("*Caltech*"). Although Google contends this is a "system," there is no actual system – just reliance on an amalgamation of estopped printed publications and/or uncorroborated testimony.

CyberDesk references are cited on the face of the Patent-in-Suit,<sup>1</sup> and Judge Stark ruled there is no question the CyberDesk publications "could have been raised during the IPR of the '843 patent." D.I. 391 at 14. Accordingly, Google is plainly estopped from relying on the CyberDesk publications as grounds of invalidity.

Google attempts to skirt estoppel under §315(e)(2) by framing CyberDesk as a "system." In denying summary judgment, Judge Stark identified a predicate "fact issue" as to whether testimony relating to the purported CyberDesk system is merely "cumulative" of the printed publications that Google could have raised in its failed IPR petition, or whether it "provides any non-cumulative disclosures germane to [] Google's invalidity theories." D.I. 391 at 15.<sup>2</sup> The

<sup>1</sup> For example, Google's DTX-14 is the publication "CyberDesk: A Framework for Providing Self-Integrating Ubiquitous Software Services" that appears on page 2 of the Patent-in-Suit.

<sup>2</sup> As the Court recognized during the Pretrial Conference, whether invalidity grounds are properly before the jury is a threshold issue that implicates the Court's gatekeeping function. *See*

answer to that question is undoubtedly that the testimony is cumulative for the reasons below and previously briefed. *See* D.I. 282 at 9-13.

First, as Google conceded in its summary judgment briefing, “no working version [of CyberDesk] still exists.” D.I. 348 at 14. Thus, Google will not be presenting to the jury an operable (or even inoperable) CyberDesk “system.” There will be no software demonstration and Google will not wheel out a vintage computer running the program. Instead, Google will rely on the same amalgamation of publications that it could have raised at IPR, and claim that, when cobbled together, they describe the alleged functionality of CyberDesk at some unspecified moment in time. But there is no “system” apart from these publications. The only evidence of the CyberDesk “system” are the publications. Google is merely relabeling the estopped grounds as a “system” to make an end run around §315. That is impermissible and cumulative. *See Wasica Fin. GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448, 453 (D. Del. 2020) (“Since the estoppel provision, § 315(e)(2), applies to **grounds**, a petitioner is estopped from proceeding in litigation on those **grounds**, even if the **evidence** used to support those grounds was not available to be used in the IPR.” (emphasis in original)).

Second, Google may argue that the alleged “system” is evidenced by testimony from one of CyberDesk’s developers, Anind Dey, which Google claims describes a “system” that goes *beyond* the written materials. That attempted end-run around estoppel, which would be a recipe for avoiding estoppel in *every case* with a cooperating prior art author, is not surprisingly barred by black-letter law. Mr. Dey’s testimony is completely uncorroborated, by definition, because Google relies on the portion of his testimony that allegedly goes *beyond* the written materials, and there is no physical system to support it either. Without documentation or a physical system, there is nothing to corroborate it. “[C]orroboration is required of any witness whose testimony alone is asserted to invalidate a patent.” *CEATS, Inc. v. Cont’l Airlines, Inc.*, 526 F. App’x 966, 969 (Fed. Cir. 2013) (quoting *TypeRight Keyboard Corp. v. Microsoft Corp.*, 374 F.3d 1151, 1159 (Fed. Cir. 2004)); *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1378 (Fed. Cir. 2003) (same); *Rosco, Inc. v. Mirror Lite Co.*, 120 F’Appx. 832, 836 (Fed. Cir. 2005) (“Testimony evidence of invalidity must be corroborated.” (citing *Finnigan Corp. v. Int’l Trade Comm’n*, 180 F.3d 1354, 1366–70 (Fed. Cir. 1999))). Any testimony by Mr. Dey (or any other witness) must be limited to the four corners of the publications. If the testimony of these witnesses is substantially similar to the CyberDesk publications, there is no difference in the invalidity grounds and estoppel under §315(e)(2) applies with full force. If the testimony of these witnesses strays from the printed publications, it is uncorroborated and improper. Accordingly, Google cannot escape estoppel by arguing that this *uncorroborated testimony* somehow proves a “system” that exceeds the printed publications.

Google is attempting to present the CyberDesk publications—which it indisputably could have raised in its IPR petition—to the jury through Mr. Dey’s testimony about the non-existent “CyberDesk system.” This is squarely improper. *See Clearlamp, LLC v. LKQ Corp.*, 2016 WL

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*IOENGINE, LLC v. PayPal Holdings, Inc.*, 607 F. Supp. 3d 464, 517-18 (D. Del. 2022) (Bryson, C.J.) (District Court must resolve IPR estoppel objections “in advance of the trial”); *Innovative Memory Sys. v. Micron Tech., Inc.*, No. 14-1480-RGA, 2022 U.S. Dist. LEXIS 177092, at \*12 (D. Del. Sep. 29, 2022) (“Sending that question [re IPR estoppel] to the jury would be contrary to one of the purposes of IPR estoppel....”).

4734389, at \*9 (N.D. Ill. Mar. 18, 2016) (“While LKQ seeks to cloak its reliance upon UVHC3000 as a product, so as to avoid § 315(e)(2) estoppel, such an argument is disingenuous as it is the UVHC3000 datasheet upon which LKQ relies to invalidate the asserted claims”); *Milwaukee Elec. Tool Corp. v. Snap-On Inc.*, 271 F. Supp. 3d 990, 1032 (E.D. Wis. 2017) (“Snap-On cannot skirt [IPR estoppel] by purporting to rely on a device without actually relying on the device itself”).

Third, even if Mr. Dey’s testimony *were* corroborated, which it is not, it would still not convert the estopped CyberDesk publications into a CyberDesk “system” that circumvents estoppel because the testimony is cumulative of the publications. D.I. 282 at 9-13. “[S]imply swap[ping] out publications that were available through a diligent search with the same prior art, only in a slightly different format” is not permitted. *See Wasica*, 432 F. Supp. 3d at 453–54, n.7 (D. Del. 2020).

Google’s approach violates the spirit and the letter of §315(e). The estoppel provisions were designed to prevent second bites at the invalidity apple based on grounds that were raised or reasonably could have been raised during IPR. In Google’s view, estoppel can be avoided simply with uncorroborated testimony that a non-existent system performed various functions that were not captured in the printed materials supposedly describing that system. Not only is the corroboration requirement specifically designed to prevent this sort of end run, but under the Federal Circuit’s decision in *Caltech*, estoppel is applied strictly. Google’s attempt to rebrand estopped grounds as a separate “system”—without any existing system to show—would be a recipe to avoid estoppel in any case where there is a cooperating prior art author.

Given that CyberDesk is subject to IPR estoppel, Google cannot raise it as an anticipatory reference or as part of a combination with other art as grounds for invalidity. Google is barred from raising the estopped CyberDesk reference in combination with other estopped references. *See* D.I. 391 at 10 (barring Google “from presenting combinations that consist of Pandit with *estopped* prior art references and systems”); *id.* at 19 (“[G]rounds consisting of combinations of Tso, Domini, Hachamovitch, or Chalas with other estopped prior art references and systems are barred ....”).<sup>3</sup>

Arendi is available at the Court’s convenience to address any questions or concerns.

Respectfully,

/s/ Neal C. Belgam

Neal C. Belgam (No. 2721)

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<sup>3</sup> Arendi also contends, as a separate and unrelated argument, that no *written documents* evidencing estopped art should be usable in combinations with non-estopped references, as a court held last week. *See Singular Computing LLC v. Google LLC*, No. CV 19-12551-FDS, 2023 WL 2839282, at \*7 (D. Mass. Apr. 6, 2023) (“Google is estopped from using patents and printed publications of which it was aware, or reasonably should have been aware, at the time of the IPR proceeding. That bar applies whether the patents and printed publications are offered as stand-alone evidence, *or in combination with other evidence that could not have been presented at the IPR proceeding.*”).

cc: Clerk of Court (via CM/ECF)  
All Counsel of Record (via CM/ECF)