

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

ARENDI S.A.R.L.,)	
)	
Plaintiff,)	C.A. No. 13-919-JLH
)	
v.)	JURY TRIAL DEMANDED
)	
GOOGLE LLC,)	
)	
Defendant.)	

**LETTER TO THE HONORABLE JENNIFER L. HALL FROM DAVID E. MOORE
IN OPPOSITION TO PLAINTIFF'S MOTION REGARDING PRIOR ART ESTOPPEL**

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Dated: April 13, 2023
10746717

Dear Judge Hall:

The Court should deny Arendi's eve-of-trial request for IPR estoppel as improper, untimely, and meritless. Judge Stark ***already decided over a year ago*** that the first two arguments in Arendi's letter—supposed lack of a working version of CyberDesk and unreliability of testimony from Dr. Dey, CyberDesk's lead developer—do not support the application of IPR estoppel in this case. D.I. 281 (Mot.); D.I. 391 at 2, 14–15 (Mem. Op.). Arendi's third argument regarding cumulativeness fares no better. The court's intervening decision in *Chemours Co. v. Daikin Indus., Ltd.*, 2022 WL 2643517 (D. Del. July 8, 2022) (Noreika, J.), clarifies that cumulativeness is irrelevant here, and as a matter of statutory interpretation, estoppel cannot apply.

If the Court were to revisit the issue of estoppel, Google agrees with Arendi that the Court, not the jury, should decide it. *See* D.I. 456 (Arendi Letter) at 1 n.2 (citing cases); *see also Hemstreet v. Comp. Entry Sys. Corp.*, 972 F.2d 1290, 1292 (Fed. Cir. 1992) (equitable issues are “committed to the sound discretion of the trial court,” even when they “ultimately turn on underlying factual determinations”). Here, Arendi falls far short of its burden to prove under 35 U.S.C. § 315(e)(2) that Google “reasonably could have raised” CyberDesk during IPR. Its arguments are legally wrong and factually unsupported. In contrast, Google submitted extensive evidence in opposing summary judgment, which showed that CyberDesk is materially different from any printed publications. The evidence shows that Google is not “simply swapping labels for what is otherwise a patent or printed publication invalidity ground in order to ‘cloak’ its prior art ground and ‘skirt’ estoppel.” *Cal. Inst. of Tech. v. Broadcom Ltd.*, 2019 WL 8192255, at *7 (C.D. Cal. Aug. 9, 2019), *aff'd*, 25 F.4th 976 (Fed. Cir. 2022). If the Court disagrees that the record evidence is sufficient to deny estoppel of CyberDesk, Google respectfully requests a bench trial on the issue.

I. The Court Has Already Rejected Arendi's Arguments Other Than Cumulativeness

On March 5, 2021, Arendi filed a summary judgment motion arguing, among other things, that IPR estoppel bars certain prior art—including ***CyberDesk alone or combined with other art***—and that Google cannot combine publications into one “aggregate” system. *See* D.I. 281 at 1–2, 6–35. Judge Stark denied that motion in relevant part on March 31, 2022. D.I. 391; D.I. 392 (Order). He considered, among other things, the same arguments that Arendi now raises in its letter: (i) “there is no evidence that . . . a system exists”; (ii) Dr. Dey's testimony is “uncorroborated”; and (iii) non-printed publication evidence, including Dr. Dey's testimony, is “cumulative” of “printed CyberDesk references.”¹ D.I. 281 at 9–13 & nn.6–10 (emphases in original). In denying summary judgment of estoppel against CyberDesk, Judge Stark left open ***only*** a question of whether CyberDesk is “cumulative” of printed publications that could have been raised during IPR, thereby rejecting Arendi's other arguments. *See* D.I. 391 at 2, 14–15.

In the year since Judge Stark's decision, Arendi never moved for reargument, and it fails to provide any legitimate basis for doing so now. *See* L.R. 7.1.5 (motion for reargument due within 14 days). The first two arguments in Arendi's letter therefore stand rejected, and there is no need or basis to reconsider them. At most, the only issue left is “cumulativeness,” but as explained

¹ To the extent Arendi argues CyberDesk cannot be described by an “amalgamation” of references, D.I. 456 at 1, that argument was also decided or else waived. Arendi unsuccessfully challenged other systems, but not CyberDesk, on this basis. *See* D.I. 281 at 25–35; D.I. 391 at 19–23.

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below, that too does not warrant application of estoppel.²

II. As a Matter of Statutory Interpretation, Prior Art Estoppel Does Not Apply

A few months after Judge Stark’s order, the court issued the *Chemours* decision, which clarified that a genuine dispute about cumulateness is insufficient to apply IPR estoppel under 35 U.S.C. § 315(e)(2). This development in the law confirms that further fact-finding is unnecessary to hold that IPR estoppel does not apply to CyberDesk.

In *Chemours*, the court had also initially denied summary judgment of IPR estoppel on the basis that “there was at least a factual dispute” as to the cumulateness of prior art products and related publications. 2022 WL 2643517, at *1. However, it ultimately held that “[a]s a matter of statutory interpretation, estoppel does not apply to prior-art products that [defendant] relies on . . . **regardless of whether those products are ‘cumulative.’**” *Id.*³ Estoppel does not bar any invalidity theory—or “ground”—based in part on a prior art product because “any invalidity theory relying upon that product as a prior art reference is not a ‘ground’ that reasonably could have been raised during the IPR.” *Id.* *1–2 (discussing canons of statutory construction); *see also Microchip Tech. Inc. v. Aptiv Servs. US LLC*, 2020 WL 4335519, at *4 (D. Del. July 28, 2020) (“On its face,” the statute “does not estop references based on physical prior art”).

To be sure, in *Wasica Finance GmbH v. Schrader Int’l, Inc.*, 432 F. Supp. 3d 448 (D. Del. 2020), the court referred to cumulateness in applying estoppel. However, the scenario in that case is distinguishable, as the parties agreed that prior art ZR-1 sensors and a printed publication called Siuru were materially identical and differed in labels only. *Id.* at 453–55 & n.5. Therefore, in view of *Wasica*, *Chemours* stands for the rule that cumulateness is irrelevant at least where the prior art system is not materially identical to and merely a substitution for a single printed publication. Here, Arendi has not pointed to any single printed publication that discloses all the material features of CyberDesk. Indeed, there is none. As in *Chemours*, estoppel does not apply.

III. Arendi Has Not Carried Its Burden of Proving that Prior Art Estoppel Applies

Arendi has the burden to prove by a preponderance of the evidence that Google “reasonably could have raised” CyberDesk during IPR. *Ironburg Inventions Ltd. v. Valve Corp.*, -- F.4th --, 2023 WL 2749199, at *13–15 (Fed. Cir. 2023). To the extent the Court reaches any fact issues (it need not, *see* §§ I–II), Arendi does not come close to carrying its burden.

First, Arendi’s assertion that CyberDesk does not exist apart from printed publications has no evidentiary support. As Google explained in its summary judgment briefing, Dr. Dey testified that he publicly demonstrated CyberDesk “dozens” or “hundreds” of times through 1997–1998.

² Arendi does not dispute Judge Stark’s ruling that Google is **not estopped** from raising the three other prior art systems in its narrowed invalidity grounds: Apple Data Detectors, Newton, and Word 97. *See* D.I. 391 at 14–18. Arendi also does not dispute that Google is “**not** barred from presenting combinations that consist of [an estopped reference] with **non-estopped** prior art references and systems.” *Id.* at 10 (emphases in original). Thus, even under Arendi’s theory, there is no estoppel for CyberDesk combined with Apple Data Detectors, Newton, or Word 97.

³ All emphases are added unless otherwise noted.

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D.I. 348 (Opp.) at 16–17. Nor is there any basis for Arendi’s argument that Google needs an “*operable*” prior art version of CyberDesk to demonstrate to the jury. D.I. 456 at 2. As Judge Stark recognized, “[m]ultiple references can be used ‘to demonstrate and support how [a prior art system] functioned at the time.’” D.I. 391 at 20 (collecting cases); *see, e.g., Zenith Elecs. Corp. v. PDI Commc’n Sys., Inc.*, 522 F.3d 1348, 1358 (Fed. Cir. 2008) (product sheet, fact testimony). A system “need not work to qualify as prior art.” *Geo. M. Martin Co. v. Alliance Mach. Sys. Int’l LLC*, 618 F.3d 1294, 1302 (Fed. Cir. 2010).

Second, Dr. Dey’s testimony is more than adequate to establish CyberDesk’s features. For one thing, Google is not relying on his testimony *alone* for material aspects of CyberDesk, so Arendi is incorrect that corroboration is required. *See* D.I. 456 at 2 (citing cases where testimony alone was asserted for invalidation). Even if it applies, the corroboration inquiry asks only whether there is evidence that “makes [the inventor’s testimony] credible”; it is a “flexible” inquiry that does not require that every factual assertion be individually corroborated. *Fleming v. Escort Inc.*, 774 F.3d 1371, 1377 (Fed. Cir. 2014). Thus, when determining whether “testimony is sufficiently corroborated, [courts] apply a rule-of-reason analysis and consider all pertinent evidence.” *Mosaic Brands, Inc. v. Ridge Wallet LLC*, 55 F.4th 1354, 1363 (Fed. Cir. 2022); *see Sandt Tech., Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1351 (Fed. Cir. 2001) (illustrative factors). In any event, Dr. Dey’s testimony is corroborated by evidence including printed publications, screen shots, and other website materials that are consistent with his testimony, and the extent and details of his testimony and lack of contradicting evidence also weigh toward sufficient corroboration.⁴ *See, e.g.,* D.I. 349 Ex. 8 ¶¶ 120–34 (summarizing context, including testimony, for CyberDesk).

Third, Arendi has failed to prove “cumulativeness.” Evidence of CyberDesk’s availability and relevant features draws not only from printed publications (which disclose less than all material features) but also non-cumulative disclosures from other sources, such as website materials (including code fragments, screen shots, and conference posters), slides, lab notebooks,⁵ and Dr. Dey’s testimony. D.I. 348 at 14–15; D.I. 349 Ex. 8 (Fox Rep.) ¶¶ 120, 133. This evidence shows that CyberDesk is materially different from any printed publications. For example, the printed publications available as of mid-1997, by themselves, do not expressly disclose that the system could be used with word processing software; could search and display maps related to a street address; and could insert information back into an analyzed document, all of which are relevant to whether and how asserted claim limitations are disclosed. *See, e.g.,* D.I. 349 Ex. 8 ¶ 121; *id.* Ex. 18 (Dey Dep.) at 61, 176–77. Dr. Dey also explains how CyberDesk operated in much more detail than the printed publications. *See* D.I. 348 at 15–18. Such additional capabilities and context make CyberDesk a far more important, understandable, and compelling reference than the printed publications alone.

⁴ Arendi’s passing argument that “written documents” cannot support a system, D.I. 456 at 3 n.3, misreads the non-binding *Singular* case. Regardless, Judge Stark has held that Google is not barred from relying on printed publications related to prior art systems, “provided that these publications are not presented as individual prior art references.” D.I. 391 at 18 (citing *SPEX Techs. Inc. v. Kingston Tech. Corp.*, 2020 WL 4342254 (C.D. Cal. June 16, 2020)).

⁵ Materials like webpages, slides, and notebooks do not necessarily qualify as prior art printed publications. *See, e.g., Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331 (Fed. Cir. 2016).

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Respectfully,

/s/ David E. Moore

David E. Moore

DEM:nmt/10746717

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