







explain the flaws in Google’s logic—namely that the PTAB’s decision is a legal nullity; and the Court should permit Arendi to explain that the PTAB rejected significant aspects of Google’s remaining invalidity grounds.

None of the law cited by Google supports excluding all evidence of IPR unhelpful to Google. In *Evolved Wireless, LLC v. Apple Inc.*, No. CV 15-542-JFB-SRF, 2019 WL 1100471, at \*3 (D. Del. Mar. 7, 2019), the Court excluded evidence of the PTAB’s non-institution decision because i) willfulness was not at issue in that case; ii) the PTAB’s decision was on appeal and not binding; and iii) the denial of the petition meant there was no estoppel effect. None of those predicates apply here.

Google’s second case, *Contour IP Holding v. GoPro, Inc., LLC*, No. 3:17-CV-04738-WHO, 2021 WL 75666, at \*8 (N.D. Cal. Jan. 8, 2021), did not find evidence of IPR irrelevant. First, the Court held that the IPR could provide evidence of willful infringement—which is the case here where Defendant developed infringing products *after* Arendi’s patent survived IPR. Second, the Court allowed that the plaintiff could “introduce IPR evidence to rebut” any implication by the Defendant that the PTO had not previously considered the prior art at issue. Arendi must similarly have the opportunity to rebut Google’s suggestion that the PTAB has approved of its invalidity theory.

The final case cited by Google to exclude Arendi’s use of IPR also rejected Google’s one-sided approach. In *Intellectual Ventures II LLC v. FedEx Corp.*, 2018 WL 10638138, at \*4 (E.D. Tex. Apr. 26, 2018), the Court ruled, “No Party will be permitted to reference any post-issuance proceedings without leave of the Court.” *Intellectual Ventures II LLC* does not support Google’s sword-and-shield tactics.

Google’s caselaw also does not support their use of the IPR determination as a defense to willfulness. Neither *Eko Brands, LLC v. Adrian Rivera Maynez Enters., Inc.*, 946 F.3d 1367, 1377–79 (Fed. Cir. 2020), nor *C.R. Bard Inc. v. AngioDynamics Inc.*, 979 F.3d 1372, 1380 (Fed. Cir. 2020), even involved IPR. And not one of the other cases cited by Google concerns PTAB decisions reversed on appeal. *Contour IP Holding v. GoPro, Inc., LLC*, No. 3:17-CV-04738-WHO, 2021 WL 75666, at \*8 (N.D. Cal. Jan. 8, 2021), stated that an unsuccessful IPR could provide evidence of willfulness—not the reverse position Google advances. In *K-TEC, Inc. v. Vita-Mix Corp.*, 696 F.3d 1364, 1376 (Fed. Cir. 2012), the Court rejected the *defendant’s* challenge to informing the jury that the PTO had considered certain prior art during IPR. And, while *Hologic, Inc. v. Minerva Surgical, Inc.*, No. 1:15-CV-1031, 2018 WL 3348998, at \*4 (D. Del. July 9, 2018), acknowledged that some facts about the IPR proceedings might be admissible, it precluded “evidence of the PTAB’s findings.” Yet Google intends to introduce those findings.

Arendi respectfully requests that the Court deny Google’s untimely motion *in limine* and proposed “stipulation of fact.”

Respectfully,

/s/ Neal C. Belgam

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cc: Clerk of Court (via CM/ECF)

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