

**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
REGARDING UPDATE ON GOOGLE'S POSITION ON IPR EVIDENCE**

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Dated: April 24, 2023

April 24, 2023

Dear Judge Hall:

Per the Court's instruction on April 21, Google respectfully submits this letter update on the parties' positions regarding the use of IPR evidence and argument at trial. The parties have met and conferred over the weekend and are currently at an impasse:

- On Saturday morning, in an effort to reach a compromise, Google informed Arendi that it would not be presenting the Pandit reference at trial, which would remove any overlap in the prior art references relied upon in the IPR and trial—*i.e.*, Arendi's stated basis for presenting the IPR proceeding to the jury. *See* D.I. 476 (4/21/23 Arendi Letter) at 3. Google proposed that the parties agree not to present any evidence, testimony, or argument concerning the IPR proceedings to the jury (including any and all aspects of those proceedings and the related appeals), in order to avoid risk of confusing the jury and tainting the trial.¹
- Arendi declined Google's proposal, stating its disagreement that evidence of IPR determinations may only be admissible to defend against a claim of willfulness.
- On Sunday, in further efforts to resolve the issue, the parties traded counterproposals on a proposed stipulation and limiting instruction. However, they were unable to reach a resolution.
- Attached as Exhibit A is Google's final proposal of compromise.²
- Arendi's final proposal dropped any contemporaneous limiting instruction about the IPR proceeding, which Google believes would only serve to increase the risk of misleading and confusing the jury.

Google refers the Court to its letter brief filed on April 20 (D.I. 473), with the following updated positions:

- It has become even more clear that Arendi wants to introduce evidence about the IPRs for improper purposes, such as to expressly or implicitly suggest to the jury that Google already tried and failed multiple times to invalidate the '843 Patent; that Google is seeking a do-over in district court; and that the Patent Office and Federal Circuit have already green-lighted the validity of the '843 Patent. For example, in its proposed opening demonstrative PX1 at 48, Arendi asserts regarding the 2016 date of the Federal Circuit's IPR decision: "Google Further Review of Patent Unsuccessful"—omitting that the review was only as to one prior art ground (single-reference obviousness in view of Pandit) that is no longer at issue for trial. *See* Ex. B. The slide also shows a green check mark on that date, meant to suggest to the jury that the

¹ Under this compromise, while Google would not raise the IPR proceeding to the jury for purposes of willfulness, it would reserve the right to do so for any subsequent enhancement assessment before the Court, where there is no risk of misleading or confusing the jury.

² Google offered this proposal on the condition that (1) the Court would read and/or provide a hard copy of the stipulation to the jury when one of the parties first asks for it at a relevant time during trial; and (2) the parties would not introduce any other evidence regarding the IPR to the jury or make any arguments that contradict the stipulation to the jury.

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Patent Office and Federal Circuit found the '843 Patent to be valid, rather than not unpatentable in view of only one particular prior art ground.

- Arendi's intended arguments regarding patent validity are incomplete, misleading, and highly prejudicial. An IPR petitioner is restricted in what prior art grounds it can raise (and can only argue invalidity based on anticipation or obviousness); the considerations for which grounds to raise and why may be different in an IPR than in a jury trial; an IPR institution decision is without a fulsome record and has no statutory estoppel effect; an IPR proceeding is based on the PTAB's own claim construction and different legal standards; and an IPR outcome relates to specific prior art grounds and cannot find that a patent is valid. Furthermore, in this situation, the Patent Office and Federal Circuit did not consider *any* of the same prior art grounds or all the same evidence that Google now relies on for trial. *See, e.g., Vaporstream, Inc. v. Snap Inc.*, 2020 WL 978731, at *8 (C.D. Cal. Feb. 28, 2020) (excluding IPR evidence because even if there were "marginal relevance" there was "danger of jury confusion and wasting of time and resources," plus the need to explain various differences and limitations with IPR that would "potentially lead to jury confusion over the invalidity issues in the case"); *Bio-Rad Labs., Inc. v. 10X Genomics, Inc.*, 2018 WL 6629705, at *1 (D. Del. Oct. 12, 2018) ("failure to institute an IPR has little or no probative value" and is "substantially outweighed by the risk of confusing the issues, misleading the jury, and undue delay for time spent providing appropriate context").
- Google no longer plans to (1) rely on any of the prior art references that was considered in the IPR; or (2) provided Arendi does not open the door, affirmatively introduce evidence about the IPR proceeding to the jury. Therefore, the IPR proceedings are no longer relevant to any issue that the jury will be asked to decide. There is no legitimate argument that IPR evidence should be admissible before the jury, even with a limiting instruction. *See Breakiron v. Horn*, 642 F.3d 126, 147 (3d Cir. 2011) (recognizing that exposure to some evidence "may be so prejudicial that it cannot be cured even by a proper limiting instruction."); *see also HVLPO2, LLC v. Oxygen Frog, LLC*, 949 F.3d 685, 690 (Fed. Cir. 2020) (recognizing evidence that "substantially prejudiced the outcome of the case" paired with an inadequate limiting instruction required a new trial).
- Arendi cannot be heard to complain that Google did not raise a MIL on this issue. Arendi *did not have the IPR petition, PTAB decisions, or related Federal Circuit decision on its trial exhibit list* when the parties exchanged MILs on March 13, 2023, or when the parties filed their Proposed Joint Pretrial Order (including MILs) on March 27, 2023. *See* D.I. 443 Ex. 6P. In fact, Arendi did not indicate that it might introduce IPR evidence at trial until April 4, 2023, when it untimely amended its trial exhibit to add IPR documents at PX785 through PX787. As shown in the April 14, 2023 Revised Proposed Joint Pretrial Order, Google then raised numerous objections to those exhibits, including untimely disclosure, relevance, prejudice, confusion, misleading, cumulative, and waste of time. *See* D.I. 460-1 Ex. 6P. In contrast, Google had IPR evidence on its initial exhibit list. Rather than have the parties dispute the admissibility of IPR evidence and curative instructions during trial, Google wanted to raise the issue with the Court beforehand to obtain clarity on this complex issue and minimize potential jury confusion.

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Respectfully,

/s/ David E. Moore

David E. Moore

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Enclosures

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