

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

ARENDI S.A.R.L.,

Plaintiff,

v.

LG ELECTRONICS, INC.,  
LG ELECTRONICS U.S.A., INC., and  
LG ELECTRONICS MOBILECOMM  
U.S.A., INC.,

Defendants.

C.A. No. 12-1595-LPS

ARENDI S.A.R.L.,

Plaintiff,

v.

BLACKBERRY LIMITED and  
BLACKBERRY CORPORATION,

Defendants.

C.A. No. 12-1597-LPS

ARENDI S.A.R.L.,

Plaintiff,

v.

MOTOROLA MOBILITY LLC  
f/k/a MOTOROLA MOBILITY, INC.,

Defendant.

C.A. No. 12-1601-LPS

ARENDI S.A.R.L.,

Plaintiff,

v.

SONY MOBILE COMMUNICATIONS  
(USA) INC., f/k/a SONY ERICSSON  
MOBILE COMMUNICATIONS (USA) INC.,  
SONY CORPORATION, and SONY  
CORPORATION OF AMERICA,

Defendants.

C.A. No. 12-1602-LPS

ARENDI S.A.R.L.,

Plaintiff,

v.

GOOGLE LLC,

Defendant.

C.A. No. 13-919-LPS

ARENDI S.A.R.L.,

Plaintiff,

v.

OATH HOLDINGS INC. and  
OATH INC.,

Defendants.

C.A. No. 13-920-LPS

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## **MEMORANDUM OPINION**

**REDACTED PUBLIC VERSION (ISSUED April 8, 2022)**  
March 31, 2022  
Wilmington, Delaware

  
STARK, U.S. Circuit Judge:

On November 29, 2012 and May 22, 2013, Plaintiff Arendi S.A.R.L. ("Plaintiff" or "Arendi") initiated 10 patent infringement cases against a series of defendants ("Defendants").

These cases and the corresponding defendant(s) in each case are listed below:

- C.A. No. 12-1595 (the "*LG* Action"): LG Electronics Inc., LG Electronics U.S.A., Inc., and LG Electronics Mobilecomm U.S.A., Inc. (collectively, "*LG*");
- C.A. No. 12-1596 (the "*Apple* Action"): Apple Inc. ("*Apple*");
- C.A. No. 12-1597 (the "*BlackBerry* Action"): BlackBerry Limited and BlackBerry Corporation (collectively, "*BlackBerry*");
- C.A. No. 12-1598 (the "*Samsung* Action"): Samsung Electronics Co. Ltd., Samsung Electronics America Inc., and Samsung Telecommunications America LLC (collectively, "*Samsung*");
- C.A. No. 12-1599 (the "*Microsoft Mobile* Action"): Microsoft Mobile, Inc. ("*Microsoft Mobile*");
- C.A. No. 12-1600 (the "*HTC* Action"): HTC Corporation ("*HTC*");
- C.A. No. 12-1601 (the "*Motorola* Action"): Motorola Mobility LLC f/k/a Motorola Mobility, Inc. ("*Motorola*");
- C.A. No. 12-1602 (the "*Sony* Action"): Sony Mobile Communications (USA) Inc. f/k/a Sony Ericsson Mobile Communications (USA) Inc., Sony Corporation, and Sony Corporation of USA (collectively, "*Sony*");
- C.A. No. 13-919 (the "*Google* Action"): Google LLC ("*Google*");
- C.A. No. 13-920 (the "*Oath* Action"): Oath Holdings Inc. and Oath Inc. (collectively, "*Oath*").

Arendi asserted one or more of the following five patents against each Defendant: U.S. Patent Nos. 6,323,853 (the "'853 patent"), 7,496,854 (the "'854 patent"), 7,917,843 (the "'843 patent"), 7,921,356 (the "'356 patent"), and 8,306,993 (the "'993 patent"). These patents are entitled "method, system and computer readable medium for addressing handling from" either "a computer program" or "an operating system."

These cases were stayed between 2014 and 2018, as the parties engaged in multiple *inter partes* review (“IPR”) proceedings before the Patent Trial and Appeal Board (“PTAB”). After these IPR proceedings and the appeals from them concluded, the only remaining patent asserted in any of the cases is the ’843 patent.<sup>1</sup>

The *Apple* Action, the *Samsung* Action, and the *Microsoft Mobile* Action have settled. (See C.A. No. 12-1596 D.I. 421; C.A. No. 12-1598 D.I. 103; C.A. No. 12-1599 D.I. 204) The *HTC* Action is stayed pending the outcome of the *Google* Action. (See C.A. No. 12-1600 D.I. 195 at 4)

Pending before the Court are a total of 36 motions filed by the parties in the six remaining active cases, consisting of 21 motions to exclude expert testimony (“*Daubert* motions”); 14 motions for summary judgment; and a motion for leave to file supplemental infringement contentions, re-open discovery, and file a supplemental brief. (C.A. No. 12-1595 D.I. 256, 260, 263, 266, 268, 270, 333; C.A. No. 12-1597 D.I. 190, 193, 195, 200, 203, 207; C.A. No. 12-1601 D.I. 265, 268, 271, 277, 279, 282; C.A. No. 12-1602 D.I. 223, 226, 230, 231, 236, C.A. No. 13-919 D.I. 269, 272, 275, 281, 283, 286; C.A. No. 13-920 D.I. 233, 236, 238, 240, 241, 246)

The Court has considered the voluminous briefs and other materials submitted by the parties in connection with this large number of motions. The Court also held a consolidated hearing on July 29, 2021, in which the Court heard oral argument on the pending motions in all six cases. (C.A. No. 12-1595 D.I. 346; C.A. No. 12-1597 D.I. 271; C.A. No. 12-1601 D.I. 378; C.A. No. 12-1602 D.I. 294; C.A. No. 13-919 D.I. 385; C.A. No. 13-920 D.I. 319) (“Tr.”)

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<sup>1</sup> The details of these IPR proceedings and their respective outcomes are documented in a joint status report filed on August 6, 2018, docketed in each of the cases. (See, e.g., C.A. No. 12-1595 D.I. 81)

This memorandum opinion will address the following eight motions:

Daubert motions:

- Arendi's motions to exclude portions of the expert reports and testimony of Dr. Edward Fox (C.A. No. 12-1601 D.I. 268; C.A. No. 13-919 D.I. 272)

Motions for summary judgment:

- Arendi's motions for partial summary judgment (C.A. No. 12-1595 D.I. 256; C.A. No. 12-1597 D.I. 193; C.A. No. 12-1601 D.I. 277; C.A. No. 12-1602 D.I. 226; C.A. No. 13-919 D.I. 281; C.A. No. 13-920 D.I. 236)

**A. Daubert And Federal Rule Of Evidence 702**

In *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 597 (1993), the Supreme Court explained that Federal Rule of Evidence 702 creates “a gatekeeping role for the [trial] judge” in order to “ensur[e] that an expert’s testimony both rests on a reliable foundation and is relevant to the task at hand.” The rule requires that expert testimony “help the trier of fact to understand the evidence or to determine a fact in issue.” Fed. R. Evid. 702(a). Expert testimony is admissible only if “the testimony is based on sufficient facts or data,” “the testimony is the product of reliable principles and methods,” and “the expert has reliably applied the principles and methods to the facts of the case.” Fed. R. Evid. 702(b)-(d). There are three distinct requirements for admissible expert testimony: (1) the expert must be qualified; (2) the opinion must be reliable; and (3) the expert’s opinion must relate to the facts. *See generally Elcock v. Kmart Corp.*, 233 F.3d 734, 741-46 (3d Cir. 2000). Rule 702 embodies a “liberal policy of admissibility.” *Pineda v. Ford Motor Co.*, 520 F.3d 237, 243 (3d Cir. 2008). Motions to exclude evidence are committed to the Court’s discretion. *See In re Paoli R. R. Yard PCB Litig.*, 35 F.3d 717, 749 (3d Cir. 1994).

## **B. Summary Judgment And Federal Rule Of Civil Procedure 56**

“The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). The moving party bears the burden of demonstrating the absence of a genuine issue of material fact. *See Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586 n.10 (1986). An assertion that a fact cannot be – or, alternatively, is – genuinely disputed must be supported either by citing to “particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for the purposes of the motion only), admissions, interrogatory answers, or other materials,” or by “showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact.” Fed. R. Civ. P. 56(c)(1)(A) & (B). If the moving party has carried its burden, the nonmovant must then “come forward with specific facts showing that there is a genuine issue for trial.” *Matsushita*, 475 U.S. at 587 (internal quotation marks and emphasis omitted). The Court will “draw all reasonable inferences in favor of the nonmoving party, and it may not make credibility determinations or weigh the evidence.” *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150 (2000).

To defeat a motion for summary judgment, the non-moving party must “do more than simply show that there is some metaphysical doubt as to the material facts.” *Matsushita*, 475 U.S. at 586; *see also Podohnik v. U.S. Postal Serv.*, 409 F.3d 584, 594 (3d Cir. 2005) (stating party opposing summary judgment “must present more than just bare assertions, conclusory allegations or suspicions to show the existence of a genuine issue”) (internal quotation marks omitted). However, the “mere existence of some alleged factual dispute between the parties will



not defeat an otherwise properly supported motion for summary judgment;” and a factual dispute is genuine only where “the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). “If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted.” *Id.* at 249-50 (internal citations omitted); *see also Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986) (stating entry of summary judgment is mandated “against a party who fails to make a showing sufficient to establish the existence of an element essential to that party’s case, and on which that party will bear the burden of proof at trial”). Thus, the “mere existence of a scintilla of evidence” in support of the non-moving party’s position is insufficient to defeat a motion for summary judgment; there must be “evidence on which the jury could reasonably find” for the non-moving party. *Anderson*, 477 U.S. at 252.

## **II. DISCUSSION**

### **A. Arendi’s Motions To Exclude Portions Of The Expert Reports And Testimony Of Dr. Edward Fox**

Arendi moves to exclude Dr. Fox’s “opinions on anticipation and obviousness” (C.A. No. 12-1601 D.I. 269 at 2), contending that: (1) Dr. Fox fails to “set forth his rationale and the bases” of his invalidity opinions (*id.* at 6-17); and (2) Dr. Fox “ignores claim elements” with respect to the obviousness combinations that include the “Pandit” reference (U.S. Patent No. 5,859,636) (*id.* at 17-20).

Motorola and Google first respond that Arendi’s *Daubert* motion with respect to Dr. Fox is “untimely and waived.” (*Id.* D.I. 332 at 2) In their view, the issues raised in Arendi’s *Daubert* motion – which they identify as a disclosure dispute – should have been addressed during expert discovery and Arendi’s *Daubert* motion is an untimely Rule 26 motion in disguise. (*See id.* at 5-6) The Court disagrees. Federal Rule of Civil Procedure 26 and Federal Rule of Evidence 702

govern different aspects of the requirements for expert disclosures, and Dr. Fox's expert reports and testimony need to satisfy both. Here, Arendi challenges the reliability of Dr. Fox's reports and testimony under Rule 702, on the basis that they are "conclusory and purposefully equivocal." (*Id.* D.I. 269 at 6) A *Daubert* motion is an appropriate vehicle by which to seek relief on this ground. *See, e.g., Mettler-Toledo, Inc. v. Fairbanks Scales, Inc.*, 2008 WL 11348468, at \*4 (E.D. Tex. Oct. 27, 2008) (striking unreliable expert report under Rule 702 because it "makes conclusory statements . . . but provides little in the way of analysis or reasoning"). None of the cases cited by Motorola and Google (*see* C.A. No. 12-1601 D.I. 332 at 5-7) support the notion that Arendi is prohibited from bringing a *Daubert* motion merely because relief for the challenged conduct may also be available through a Rule 26 motion. (*See id.* D.I. 359 at 1-2)

Turning to the merits of Arendi's motion, the Court finds that exclusion of Dr. Fox's reports and testimony is unwarranted. Dr. Fox's expert reports have identified 33 specific obviousness combinations of primary and secondary references,<sup>2</sup> and included adequate analysis to explain how and why a person of ordinary skill in the art ("POSA") would have been motivated to combine these references. (*See, e.g., id.* D.I. 333 Ex. 1 ¶¶ 186, 191) Dr. Fox has also provided in his reports detailed claim charts with element-by-element analyses of how the prior art references disclose the limitations of the asserted claims. While some screenshots and block quotes in Dr. Fox's claim charts would surely benefit from more contextualization (*see id.*

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<sup>2</sup> In view of Motorola and Google's representation during oral argument that they will not make an effort to get Dr. Fox to suggest to the jury that there are "thousands more [three-reference obviousness] combinations" (Tr. at 156-57; *see also* C.A. No. 12-1601 D.I. 332 at 8-9 ("[I]n an attempt to streamline the presentation for trial, Defendants submit that they will not present any testimony from Dr. Fox related to three-reference combinations.")), the Court need not address Arendi's contention that Dr. Fox fails to "identify and explain his thousands of obviousness combinations" (*id.* D.I. 269 at 6; *see also id.* D.I. 270 Ex. 1 Ex. U).

D.I. 269 at 9-11), the Court agrees with Motorola and Google that those claim charts, overall, sufficiently explain the connection between prior art disclosures and claim limitations and, when examined in context, are not “insufficient or confusing.” (*Id.* D.I. 332 at 16) Thus, Dr. Fox’s reports and testimony do not require exclusion.

Arendi also faults Dr. Fox for failing to address all claim elements in his analysis of the Pandit-based obviousness combinations. (*See id.* D.I. 269 at 17-20) Dr. Fox states in his expert report that Pandit discloses every limitation of the asserted claims “with the exception of one limitation – ‘performing a search using at least part of the first information as a search term in order to find the second information.’” (*See id.* at 18; *see also id.* D.I. 270 Ex. 1 ¶ 186) Arendi contends that if Pandit does not disclose that limitation, “it also cannot disclose the numerous additional claim limitations concerning the nature and use of that second information.” (*Id.* D.I. 269 at 18) In Arendi’s view, then, Dr. Fox necessarily failed to address these additional limitations in his Pandit-based obviousness analysis. (*See id.* at 19) Notwithstanding the statement cited by Arendi, it appears that Dr. Fox has, in fact, accounted for the purported “additional claim limitations,” both in his report and in the accompanying claim chart. (*See id.* D.I. 332 at 20; *see also id.* D.I. 333 Ex. 1 ¶¶ 188-96 & Ex. T) Thus, Arendi has not provided a meritorious basis for excluding Dr. Fox’s reports and testimony regarding the Pandit-based obviousness combinations.<sup>3</sup>

For the foregoing reasons, Arendi’s motion to exclude portions of the expert reports and testimony of Dr. Fox will be denied.

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<sup>3</sup> To the extent Arendi contends that Dr. Fox’s opinions are “grounded in a misunderstanding” of the effect of a final written decision in an IPR proceeding (*see* C.A. No. 12-1601 D.I. 269 at 19-20), that challenge goes to the weight, not the admissibility, of Dr. Fox’s reports and testimony.

## **B. Motions For Summary Judgment**

### **1. Arendi's Motions For Partial Summary Judgment In The *Motorola* And *Google* Actions**

Arendi argues it is entitled to partial summary judgment on four issues: (1) Motorola and Google are prevented from asserting certain invalidity grounds due to estoppel triggered by the final written decision in an IPR proceeding (*see* C.A. No. 12-1601 D.I. 278 at 6-25); (2) Motorola and Google cannot establish invalidity by improperly merging multiple references and devices to create a single piece of the purported system (*see id.* at 25-35); (3) Motorola and Google cannot establish invalidity by relying on two demonstrative laptops that do not qualify as prior art (*see id.* at 35-37); and (4) Motorola and Google have presented no evidence to support certain affirmative defenses and statutory limitations on damages (*see id.* at 37-40). The Court will address each of these issues.

#### **a. IPR Estoppel**

On December 2, 2013, Apple, Motorola, and Google petitioned for IPR of the '843 patent, raising four independent obviousness grounds: (1) Pandit; (2) U.S. Patent No. 5,946,646 ("Miller"); (3) LiveDoc/Drop Zones articles; and (4) U.S. Patent No. 5,644,735 ("Luciw"). (*See id.* D.I. 289 Ex. 1 at 8) On June 11, 2014, the PTAB instituted an IPR proceeding on the Pandit ground only and denied institution on the other three grounds. (*See id.* Ex. 7 at 19) On June 9, 2015, the PTAB issued a final written decision, finding claims 1, 8, 23, and 30 of the '843 patent unpatentable for being obvious over Pandit.<sup>4</sup> (*See id.* Ex. 8 at 15) On appeal, the Federal Circuit reversed the PTAB's finding of unpatentability. *See Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d

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<sup>4</sup> The final written decision was issued before the Supreme Court decided, in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), that the PTAB did not have the power of "partial institution."

1355, 1367 (Fed. Cir. 2016). Arendi now contends that Motorola and Google are estopped, pursuant to 35 U.S.C. § 315(e)(2), from asserting several invalidity grounds that were raised or “reasonably could have been raised” during the IPR proceeding. *Cal. Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022).

Motorola and Google first contend that Arendi has “waived” IPR estoppel. (C.A. No. 12-1601 D.I. 344 at 9-11) The Court is not persuaded. The parties engaged in discussions about IPR estoppel from April to June of 2019, regarding at least the references that had been asserted in the petition for IPR of the ’843 patent. (*See id.* at 10; *see also* Tr. at 137-38) Despite the fact that there were no subsequent discussions about IPR estoppel, Motorola and Google were on notice that Arendi would potentially assert IPR estoppel as a defense in the *Motorola* and the *Google* Actions. While the Court agrees with Motorola and Google that Arendi should have further clarified the scope of its IPR estoppel defense – at a minimum, after Motorola and Google’s expert, Dr. Fox, disclosed invalidity grounds in his expert reports – any prejudice may be remedied by, as suggested by Motorola and Google, their invalidity expert presenting additional non-estopped combinations, including three-reference combinations (*see* C.A. No. 12-1601 D.I. 332 at 9 n.3), provided the expert explains the rationale for such combinations and is made available for depositions. This additional discovery would not disrupt trial, which has not yet been scheduled. Thus, the Court will consider the merits of Arendi’s IPR estoppel defense.<sup>5</sup>

**i. Pandit**

Arendi contends that, because “Pandit was actually raised by [Motorola and Google] during IPR, and it formed the basis of the PTAB’s Final Written Decision” (*id.* D.I. 278 at 9),

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<sup>5</sup> Arendi contends that it has raised “a *statutory* bar – not a factual one” (C.A. No. 12-1601 D.I. 364 at 3) but does not cite authority that such a bar can never be waived (*see, e.g.*, Tr. at 138).

Motorola and Google are estopped from asserting Pandit as invalidating prior art, including in combination with other prior art references and systems that are also estopped. (*see id.* at 8-9)

Motorola and Google do not directly address Arendi's positions. They contend, however, that because they are only asserting Pandit in the instant actions as combinations with prior art systems that they argue could not have been raised during the IPR (i.e., not estopped), these asserted combinations are not estopped. (*See id.* D.I. 344 at 26)

On the one hand, the Court agrees with Arendi that Motorola and Google are barred from presenting combinations that consist of Pandit with *estopped* prior art references and systems as their invalidity theories. On the other hand, the Court agrees with Motorola and Google that they are *not* barred from presenting combinations that consist of Pandit with *non-estopped* prior art references and systems (i.e., prior art that was not and could not have been presented during the IPR). *See Milwaukee Elec. Tool Corp. v. Snap-On Inc.*, 271 F. Supp. 3d 990, 1030 n.15 (E.D. Wisc. 2017) (“[T]o the extent references are being relied upon in combinations that could not have been raised in an IPR petition – for instance, if some of the instituted references are now being combined with references that are physical specimens, not printed publications or patents – those combinations are not barred.”). To decide which Pandit-based combinations are estopped or not estopped, thus, the Court will turn to examining which references and systems, other than Pandit, Motorola and Google are estopped from asserting.

## **ii. Miller, Luciw, And LiveDoc/Drop Zones Articles**

These prior art references were included in petitions for IPR but the reviews sought were not instituted. Arendi contends that Motorola and Google are estopped from raising these references as part of an obviousness combination with other estopped references and systems. (*See* C.A. No. 12-1601 D.I. 278 at 9) To be clear, Arendi is not seeking to bar these references

as independent invalidity grounds. According to Arendi, since Motorola and Google actually raised these references in the petition for IPR, they could have raised obviousness combinations consisting of these references with other references or systems that also could have been raised during the IPR. (*See id.*)

In response, Motorola and Google insist, relying on the Federal Circuit's decision in *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293, 1300 (Fed. Cir. 2016), as well as this Court's decision in *Princeton Digital Image Corp. v. Ubisoft Entertainment SA*, 2019 WL 410432, at \*3 (D. Del. Feb. 1, 2019), these references are not barred since the PTAB denied institution of IPR based on these references. (*See* C.A. No. 12-1601 D.I. 344 at 23-25) *Shaw* and *Princeton Digital* are inapposite here.

In the petition for IPR, Motorola and Google asserted the references at issue as independent obviousness grounds. But they did not assert these references as combinations, either among themselves or together with other references, as they seek to do here. Thus, the PTAB's institution decision in the IPR does not affect the applicability of IPR estoppel to those combinations.<sup>6</sup> To the extent that Motorola and Google attempt to assert combinations consisting of these references with other *estopped* references and systems, because they could have sought to present those combinations during the IPR, Motorola and Google are estopped from asserting them here.

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<sup>6</sup> To be clear, the Court need not and does not reach the question of whether the petitioned but non-instituted grounds in pre-*SAS* IPRs are subject to estoppel under 35 U.S.C. § 315(e)(2). *See generally Cal. Inst. of Tech.*, 25 F.4th at 991 n.5 (“In this case . . . 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*.”).

Motorola and Google argue in the alternative that the references at issue avoid estoppel because they were asserted “only as evidence of related prior art systems.”<sup>7</sup> (*Id.* at 25) This argument, however, is undermined by Dr. Fox’s expert reports, in which he not only lists the “related prior art systems” as part of the obviousness combinations, but also includes the “evidence” references as independent alternatives. (*See id.* D.I. 364 at 10-11; *see also, e.g., id.* D.I. 289 Ex. 9 ¶ 186 (“CyberDesk System + Apple Data Detector System [and/or *specific publications describing aspects of Apple Data Detector System*]”) (emphasis added)) Thus, to the extent Motorola and Google rely on the references at issue – rather than the prior art systems these references purportedly describe – as part of the obviousness combinations, they are barred from raising these references in combination with other estopped references and systems.<sup>8</sup>

**iii. CyberDesk, Newton, Eudora, Word 97,  
Outlook 97, And Selection Recognition Agent**

Arendi contends that Motorola and Google are barred from raising these prior art “systems” – individually and in combination with other estopped references and systems – as invalidity grounds in the *Motorola* and *Google* Actions because these “systems” are cumulative of other patent and printed publication references that could have been raised as invalidity grounds during the IPR.<sup>9</sup> (*See id.* D.I. 278 at 9-13, 15-20, 22-23) Motorola and Google counter

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<sup>7</sup> According to Motorola and Google, Miller and LiveDoc/Drop Zones articles are partial evidence for Apple Data Detectors and for LiveDoc, and Luciw is partial evidence for Newton. (*See* C.A. No. 12-1601 D.I. 344 at 25 n.9)

<sup>8</sup> Although Arendi only seeks to prevent Motorola and Google from raising these references as part of an obviousness combination with other *estopped* references and systems, the Court agrees with Motorola and Google (*see* C.A. No. 12-1601 D.I. 344 at 25) that they are *not* estopped from presenting combinations that consist of these references with *non-estopped* prior art references and systems. *See Milwaukee Elec. Tool*, 271 F. Supp. 3d at 1030 n.15.

<sup>9</sup> Motorola and Google argue that Arendi improperly included with its motion Mr. Lhymn’s declaration regarding whether certain prior art references could have been readily identified by a



that “the challenged prior art systems are *not* entirely cumulative of any patents or publications, but instead are separate prior art that could not have been presented in the ’843 Patent IPR.” (*Id.* D.I. 344 at 13)

An invalidity ground based on a physical product – which could not have been raised during an IPR (*see* 35 U.S.C. § 311(b)) – may be subject to IPR estoppel if a publication describing the physical product could have been raised as an invalidity ground during the IPR. For example, in *Wasica Finance GmbH v. Schrader International, Inc.*, 432 F. Supp. 3d 448, 453-54 (D. Del. 2020), the Court held that an invalidity ground involving a physical product is barred in litigation if a publication reasonably could have been raised in the IPR that is “materially identical” to the physical product; in that circumstance, the physical product is “entirely cumulative” of the estopped prior art publication. *See also Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, 2019 WL 861394, at \*10 (N.D. Ill. Feb. 22, 2019) (“Where there is evidence that a petitioner has reasonable access to printed publications corresponding to or describing a product that it could have proffered during the IPR process, it cannot avoid estoppel simply by pointing to the finished product (rather than the printed materials) during litigation.”); *Milwaukee Elec. Tool*, 271 F. Supp. 3d at 1030 (“[The defendant] cannot skirt [IPR estoppel] by purporting to rely on a device without actually relying on the device itself.”).

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skilled searcher conducting a diligent search at the time of the IPR petition. (*See* C.A. No. 12-1601 D.I. 344 at 27-28) (“Mr. Lhymn’s declaration is an improper and untimely expert report under the guise of a witness statement, and fails to comply with the expert disclosure requirements of Rule 26.”) Arendi has provided evidence of the availability of the references even independent of Mr. Lhymn’s declaration; for example, the references at issue were cited in the ’843 patent, in other contemporaneous IPR petitions, or in the documents generated around the time of the IPR petition for the ’843 patent. (*See, e.g., id.* D.I. 278 at 10-22) Motorola and Google have “neither contest[ed] Arendi’s evidence nor put forward their own” to create a factual dispute over the discoverability of the references at issue. (*See id.* D.I. 364 at 12-13) Thus, the Court need not and does not rely on Mr. Lhymn’s declaration.

For the reasons explained below, the Court finds that: (1) there is a genuine factual dispute – precluding summary judgment – as to whether CyberDesk, Newton, Word 97, and Outlook 97 are “materially identical” to the references that could have been raised during the ’843 patent IPR; and (2) there is no genuine factual dispute that Eudora and Selection Recognition Agent are “materially identical” to the references that could have been raised during the IPR. Thus, Motorola and Google are precluded from relying on the latter two purported systems – individually or in combination with other estopped references and systems – but are not precluded from relying on the other listed system references as part of their invalidity theories in the instant actions.

**CyberDesk:** Arendi contends that a series of references describing the CyberDesk system “were readily available” to Motorola and Google when they petitioned for IPR of the ’843 patent, and the alleged CyberDesk system “is not merely *cumulative* of the printed CyberDesk references. It *is* the printed CyberDesk references.” (C.A. No. 12-1601 D.I. 278 at 9, 11) In response, Motorola and Google contend that “Dr. Fox’s expert reports lay out in great detail how the CyberDesk System cannot adequately be captured for purposes of invalidity analysis by any of its related publications.” (*Id.* D.I. 344 at 14-15; *see also id.* 345 Ex. 8 ¶ 120)

The Court agrees with Motorola and Google that there is at least a genuine dispute of material fact as to whether the CyberDesk system is cumulative of the prior art publications that could have been raised during the IPR of the ’843 patent. Dr. Fox’s expert reports explicitly rely on the deposition transcript of Dr. Anind Dey, CyberDesk’s lead developer, which describes “certain features and certain aspects of the operation of the [CyberDesk] System.” (*Id.*) Motorola and Google contend that Dr. Fox’s reports and accompanying claim charts show that the testimony of Dr. Dey “explain[s] certain CyberDesk features that are not disclosed in its

related publications, placed each publication within the overall context and development of the CyberDesk System, and clarified how multiple instantiations of CyberDesk were presented to the public.” (*Id.* D.I. 344 at 15; *see also generally id.* D.I. 345 Ex. 18) While Arendi disagrees that Dr. Dey’s testimony provides any non-cumulative disclosures germane to Motorola and Google’s invalidity theories relying on the CyberDesk system (*see id.* D.I. 364 at 5-7), that dispute creates a fact issue that is not amenable to resolution on a motion for summary judgment.

**Newton:** Arendi contends that IPR estoppel should apply to the Newton system because Motorola and Google “reasonably could have raised during IPR printed references of which the Apple Newton [system] is cumulative.” (*Id.* D.I. 278 at 15) Motorola and Google respond that the Newton system “is an actual device that is not adequately described in its related publications.” (*Id.* D.I. 344 at 18) They point to Dr. Fox’s expert reports, in which he explains that “[t]he Newton is a handheld computer device, which [he] personally used,” and which he inspected and took photographs of to document its operation. (*Id.* D.I. 345 Ex. 8 ¶¶ 149, 183) Dr. Fox’s reports also confirm that he relies on the Newton physical device and the deposition testimony of [REDACTED], one of its developers, regarding certain aspects of Newton’s operation. (*See id.* Ex. 10 ¶¶ 159-85)

There is a genuine factual dispute as to whether the Newton system is entirely cumulative of the printed references identified by Arendi. Although Arendi contends that Dr. Fox’s screenshots, references to [REDACTED] deposition, and descriptions of the operation of the Newton system only “add some color” to his account of the Newton system (*see id.* D.I. 278 at 16), whether the additional evidence provides a basis of invalidity that goes beyond the published references presents a genuine dispute of fact, defeating summary judgment.

**Eudora:** Arendi contends that Motorola and Google are barred from relying on the purported Eudora system because “Dr. Fox relies entirely on three printed references as evidence of the Eudora products.” (*Id.* at 17) These three printed references, according to Arendi, could reasonably have been raised during the IPR of the ’843 patent. (*See id.*) In their responsive brief, Motorola and Google claim that the Eudora system is “another example of a system reference that is greater than the sum of its publications” (*id.* D.I. 344 at 21), but they fail to point to any evidence in the record to support their contention that the Eudora system includes any disclosures beyond the three printed references at issue. Motorola and Google’s conclusory claim does not amount to evidence from which a reasonable jury could find that the Eudora system forms an invalidity ground different from the three printed references. (There is no dispute that the three references could reasonably have been raised during the IPR.)

Thus, Motorola and Google are precluded from relying on the purported Eudora system – individually or in combination with other estopped references and systems – as theories of invalidity in the *Motorola* and the *Google* Actions.

**Word 97 and Outlook 97:** Arendi contends that IPR estoppel applies to the Word 97 and the Outlook 97 systems because they are cumulative of the user guides and manuals for these products, which are printed references that could have been raised during the IPR of the ’843 patent. (*See id.* D.I. 278 at 18-20) Motorola and Google respond that these systems are “supported by evidence that extends well beyond its related publications, and includes screenshots” of these systems taken by Dr. Fox during his inspection. (*Id.* D.I. 344 at 21) Pointing to evidence, Motorola and Google show that screenshots (among other things) “walk step-by-step through the relevant features” of these systems, and “uniquely capture how [these

systems] operated and disclose[d] the asserted claims of the '843 patent.” (*Id.*; *see also id.* D.I. 345 Ex. 8 Ex. L)

The Court finds that there is a genuine dispute of material fact as to whether the Word 97 and the Outlook 97 systems relied on by Dr. Fox for his invalidity opinions are cumulative of the user guides and manuals identified by Arendi. This will be an issue for the jury to decide.

**Selection Recognition Agent:** Arendi contends that the purported “Selection Recognition Agent” system is subject to IPR estoppel because “[n]either the expert report nor [Motorola and Google’s] invalidity contentions point to the software itself, instead discussing the Selection Recognition Agent Article by Pandit and the Pandit Patent,” references that were either actually raised (the Pandit patent) or reasonably could have been raised (the Selection Recognition Agent Article by Pandit) during the IPR. (*Id.* D.I. 278 at 22) Motorola and Google’s response is conclusory; they argue, without pointing to any supporting record evidence, that “Selection Recognition Agent . . . constitutes an independent system because it is not adequately disclosed by either associated publication, but instead must be understood and applied as an independent and integrated system.” (*Id.* D.I. 344 at 22) Motorola and Google have not demonstrated a genuine dispute of fact as to whether the purported “Selection Recognition Agent” system constitutes a different invalidity ground from the two references (references Motorola and Google do not deny that they actually raised or reasonably could have raised during the IPR). Accordingly, Motorola and Google are barred from asserting the purported “Selection Recognition Agent” system – individually or in combination with other estopped references and systems – as part of their invalidity theories in these actions.

**iv. Nardi And Other Publications Related To The  
Purported Apple Data Detectors And LiveDoc Systems**

Arendi does not challenge the purported Apple Data Detectors<sup>10</sup> and LiveDoc systems based on IPR estoppel. However, it contends that “to the extent that [Motorola and Google] are permitted to rely on distinct components of the amalgamated systems, they are estopped from relying on printed publications that comprise it.” (*Id.* D.I. 278 at 14) Motorola and Google represent that none of the printed publications at issue “is offered as an individual prior art reference. Instead, each is merely one piece of evidence offered to help explain the operation of the larger Apple Data Detectors and LiveDoc systems.” (*Id.* D.I. 344 at 26-27) Since the printed publications at issue only act as a collection of underlying evidence to describe prior art systems, these publications are not themselves “grounds” being asserted in the *Motorola* and the *Google* Actions. Thus, Motorola and Google are not barred from relying on Nardi and other printed publications related to the purported Apple Data Detectors and LiveDoc systems, provided that these publications are not presented as individual prior art references.<sup>11</sup> See *SPEX Techs. Inc. v. Kingston Tech. Corp.*, 2020 WL 4342254, at \*15 (C.D. Cal. June 16, 2020) (“[T]he reliance on some printed publications in an overall collection of documents being used to describe a system invalidity theory should not lead to estoppel of the overall system invalidity theory itself, nor piecemeal exclusion of the printed publications underlying that system invalidity theory, absent a showing that the system invalidity theory is a patent or printed publication theory in disguise.”).

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<sup>10</sup> The Court understands “Apple Data Detector” and “Apple Data Detectors” to be the same system, as Arendi uses them interchangeably in its brief, and so does Dr. Fox in his expert reports.

<sup>11</sup> Since Motorola and Google do not contest that they reasonably could have raised these publications during the IPR of the ’843 patent, they are precluded from presenting these publications as individual prior art references, either individually or in combination with other estopped references and systems.

**v. Tso, Domini, Hachamovitch, And Chalas**

Arendi contends that IPR estoppel applies to these references because Motorola and Google reasonably could have raised them during the IPR. (*See* C.A. No. 12-1601 D.I. 278 at 20-21) Without disputing that these references could have been raised during the IPR, Motorola and Google respond that these references are asserted in the instant actions as invalidity grounds only when combined with asserted prior art systems, which they contend are not subject to IPR estoppel. (*See id.* D.I. 344 at 27) For the same reasons explained in connection with Pandit (*see supra* II.B.1.a.i), grounds consisting of combinations of Tso, Domini, Hachamovitch, or Chalas with other estopped prior art references and systems are barred, whereas grounds consisting of combinations of Tso, Domini, Hachamovitch, or Chalas with other non-estopped prior art references and systems are not barred.

**vi. References Appearing Only In Dr. Fox's Exhibit U**

The Court need not address these references as Motorola and Google have represented that they intend to rely only on the 33 grounds listed in Dr. Fox's opening report and not on the references in Dr. Fox's Exhibit U. (*See id.* at 27 n.12; *see also* Tr. at 156-57; C.A. No. 12-1601 D.I. 332 at 8-9 ("[I]n an attempt to streamline the presentation for trial, Defendants submit that they will not present any testimony from Dr. Fox related to three-reference combinations."))

**b. Prior Art Systems Described By Multiple References**

Arendi contends that Motorola and Google "improperly combine multiple prior art publications and devices into posited invalidating 'systems.'" (*Id.* D.I. 278 at 20-25) According to Arendi, "[n]o evidence in the record establishes" that the purported "Apple Data Detector System," the "LiveDoc System," the "Selection Recognition Agent System," and the "Eudora System" "existed as prior art systems." (*Id.*) In response, Motorola and Google insist that Dr.

Fox has confirmed in his expert reports and at his deposition the existence of the asserted systems before the priority date of the '843 patent and has explained that the “relevant overall feature-sets of those systems can be understood only by considering multiple pieces of evidence.” (*Id.* D.I. 344 at 29)

Multiple references can be used “to demonstrate and support how [a prior art system] functioned at the time, not as distinct references.” *Finjan, Inc. v. Symantec Corp.*, 2013 WL 5302560, at \*17 (D. Del. Sept. 19, 2013); *see also Radware, Ltd. v. F5 Networks, Inc.*, 2016 WL 861065, at \*2 (N.D. Cal. Mar. 5, 2016) (denying motion for summary judgment of no anticipation because defendant is “simply trying to use the [multiple] proffered product manuals to describe a single prior art system”); *Good Tech. Corp. v. Mobileiron, Inc.*, 2015 WL 4197554, at \*5 (N.D. Cal. July 10, 2015) (“[S]imply because a system can be employed in various ways and on various platforms or devices does not mean that all of those devices and platforms are being combined. Rather, these documents are illustrative of the system itself and how it functions.”); *IP Innovation L.L.C. v. Red Hat, Inc.*, 2010 WL 9501469, at \*4 (E.D. Tex. Oct. 13, 2010) (“This court sees no error in using multiple references to describe a single prior art system for the purpose of showing anticipation.”). Here, for the reasons explained below, the Court finds, for each of the challenged prior art systems – with the exception of the purported “Selection Recognition Agent System” – there is a genuine dispute of material fact as to whether there was a single prior art system that encompassed the features described by multiple combined references.<sup>12</sup>

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<sup>12</sup> The parties appear to disagree on whether Motorola and Google may rely on a purported “system” as prior art reference when the “system” is described by multiple references as including different “versions,” “iterations,” or “instantiations” of the “system.” (*See* C.A. No. 12-1601 D.I. 344 at 34; *id.* D.I. 364 at 16) This appears to be a genuine dispute of a material fact. Among other things, the exact definitions of “version,” “iteration,” or “instantiation”



### **i. Apple Data Detector**

Arendi contends, relying in part on the different user interfaces and features disclosed in the multiple references relied on by Dr. Fox in describing the purported Apple Data Detector system (*see* C.A. No. 12-1601 D.I. 278 at 27-30), that Dr. Fox “pick[ed] and [chose] elements from these disclosures to construct an imaged and preferred ‘full feature-set.’” (*Id.* at 27) The Court agrees with Motorola and Google that Arendi’s challenge “sets up material factual disputes about the scope and content of the challenged prior art systems” that “cannot appropriately be resolved on summary judgment.” (*Id.* D.I. 344 at 30)

Dr. Fox explicitly states in his expert reports that “[t]he Apple Data Detector (“ADD”) System was created and publicly displayed at least as early as in 1996.” (*Id.* D.I. 345 Ex. 8 ¶ 135) He further explains that, since “no single publication accurately captures or describes the full feature-set and the full operation” of the Apple Data Detector system, his understanding of the system came from multiple pieces of evidence, including patents, publications, videos, screenshots, descriptions of the system demonstrations, examination of a working version of the system, and the deposition transcript of one of the creators of the system. (*See id.* ¶¶ 135-42) Thus, there is a genuine dispute of material fact as to the existence, scope, and content of the Apple Data Detectors system, precluding summary judgment. *See Open Text S.A. v. BOX, Inc.*, 2015 U.S. Dist. LEXIS 16901, at \*7 (N.D. Cal. Feb 11, 2015) (noting that extent to which different documents describe particular version of software product is “a fact issue for the jury to decide”).

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appear to be ambiguous. (*See id.* D.I. 344 at 33 n.17; *see also id.* D.I. 345 Ex. 11 at 89-90 (Dr. Fox explaining that referring to “versions” for software can be confusing, calling it “a funny term”))

## **ii. LiveDoc**

For the purported LiveDoc System, Arendi essentially repeats its argument in connection with the Apple Data Detector system, contending that “Dr. Fox amalgamate[d] many of the same systems and references to invent their ‘LiveDoc system’ as when creating their preferred ‘Apple Data Detector System.’” (C.A. No. 12-1601 D.I. 278 at 31) Motorola and Google again point to Dr. Fox’s expert reports, in which he details evidence supporting the existence and features of the LiveDoc system. (*See id.* D.I. 344 at 36-37; *see also id.* D.I. 345 Ex. 8 ¶¶ 143-47) Thus, there is a genuine dispute of material fact, and summary judgment is unwarranted.

## **iii. Selection Recognition Agent**

Arendi contends there is “no evidence” to support the assumption that the two references relied on by Dr. Fox – (1) Pandit; and (2) the “Selection Recognition Agent” article written by Pandit and Kalbag – describe the same Selection Recognition Agent system, noting that “neither reference mentions the other,” and adding that the inventions described in the two references “materially differ.” (*Id.* D.I. 278 at 33) In his expert reports, Dr. Fox merely lists these two references under the subtitle “Selection Recognition Agent/Pandit,” without stating that he relies on these two references as describing a single, integrated system. (*See id.* D.I. 345 Ex. 8 ¶¶ 177-82) Nor does Dr. Fox opine that Pandit discloses a Selection Recognition Agent system or the same system as described in the “Selection Recognition Agent” article. (*See id.*) Thus, Motorola and Google have failed to point to any evidence that would allow a reasonable jury to conclude that the two references disclose a single purported Selection Recognition Agent system.<sup>13</sup> It

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<sup>13</sup> Motorola and Google refer to a 1997 Technical Report on CyberDesk, purporting to show the existence of the Selection Recognition Agent system. (*See* C.A. 12-1601 D.I. 344 at 37 n.19; *see also id.* D.I. 345 Ex. 22) However, the Technical Report neither mentioned the Pandit patent nor stated that the Pandit patent described the same Selection Recognition Agent system as disclosed in Pandit and Kalbag’s “Selection Recognition Agent” article.

follows, then, Motorola and Google cannot rely on the purported Selection Recognition Agent system as a single prior art reference in their invalidity theories.

#### **iv. Eudora**

With respect to the purported Eudora system, Arendi contends that Dr. Fox has “impermissibly amalgamated” references describing “three different software titles” into a single alleged system. (*Id.* D.I. 278 at 34) While these references may describe different “versions” of different software products, Dr. Fox’s expert reports disclose that there was a single Eudora system that he “personally used,” which included the functionalities disclosed by the different references. (*See id.* D.I. 345 Ex. 8 ¶¶ 157-59) Thus, there is at least a genuine dispute of material fact as to whether there existed a single Eudora system that possessed all the features disclosed in those references, rendering summary judgment inappropriate.

#### **c. Demonstrative Apple Data Detector And LiveDoc Laptops**

Arendi contends that the two laptops demonstrating the Apple Data Detector and LiveDoc systems (Powerbook 3400c and Powerbook 1400cs marked as [REDACTED] Exhibits 8 and 9) do not qualify as prior art systems. (*See id.* D.I. 278 at 35-37) According to Arendi, the systems on the laptops were created during this litigation in 2013 and 2014, and Motorola and Google only “have evidence that certain *components* of the two laptop systems existed” prior to the invention claimed in the ’843 patent, and cannot show “the components had been assembled at the time into the systems represented by the two laptops.” (*Id.* at 35-36)

Motorola and Google point to Dr. Fox’s expert reports, in which he states that his analysis of the Apple Data Detector system included “examinations of a working version of the Apple Data Detector system on a computer produced by Apple in this litigation.” (*Id.* D.I. 345 Ex. 8 ¶ 135) He makes a similar statement regarding the LiveDoc system. (*See id.* ¶ 144) Dr.

Fox further explained that “the software on the laptops inspected was the appropriate software from the time period at issue,” even though it “was installed recently.” (*Id.* Ex. 10 ¶ 47) In addition, [REDACTED] confirmed that [REDACTED]

[REDACTED]<sup>14</sup> (*Id.* D.I. 298 Ex. 82 at 95-96) There is, thus, a genuine dispute of material fact as to whether the Apple Data Detector and the LiveDoc systems as demonstrated by these two laptops reflect the operation of these systems before the priority date of the ’843 patent. Summary judgment, then, is unwarranted.

**d. Affirmative Defenses And Statutory Limitations On Damages**

Arendi contends that Motorola and Google have failed to present evidence to support the affirmative defenses of limitations on damages imposed by 35 U.S.C. §§ 286 and 288, equitable estoppel, waiver, unclean hands, and laches. (*See id.* D.I. 278 at 37-40)

With respect to the limitation on damages by 35 U.S.C. § 286, Arendi contends that Motorola and Google cannot assert § 286 to limit its damages because the earliest dates it asserts damages against Motorola and Google are “well within the six-year period” prescribed by § 286. (*Id.* at 38) Google responds that, since Arendi did not allege infringement by Google of claims 8 and 30 of the ’843 patent until the amended complaint was filed on December 21, 2018, the six-year damages period for these two claims should not begin until December 21, 2012 – several months after the claimed damages start date of February 1, 2012. (*See id.* D.I. 344 at 39-40; *see*

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<sup>14</sup> Arendi contends that [REDACTED]  
[REDACTED]  
[REDACTED] (C.A. No. 12-1601 D.I. 278 at 37)  
Contrary to Arendi’s insistence, [REDACTED]  
[REDACTED] may be subject to different interpretations.

*also* C.A. No. 13-919 D.I. 97 ¶ 19) Since a reasonable factfinder may find that Arendi's claim for damages against Google is limited by § 286, Arendi's motion for summary judgment of no limitation on damages by § 286 will be denied in the *Google* Action. There is, however, no indication in the brief that Google's § 286 defense also applies to Motorola; thus, Arendi's motion with respect to § 286 will be granted in the *Motorola* Action.

With respect to the affirmative defenses of equitable estoppel, waiver, unclean hands, laches, and limitations on damages under 35 U.S.C. § 288, Motorola and Google state that they "do not intend," or "do not presently intend" to assert them. (C.A. No. 12-1601 D.I. 344 at 40) They additionally seek to "reserve the right" to raise the defenses of equitable estoppel, waiver, and unclean hands "if warranted by changed circumstances." (*Id.*)

Motorola and Google have had ample opportunity during extensive discovery to develop these affirmative defenses but have failed to present any evidence with respect to them. The time for Motorola and Google to have made their case on these issues has come and gone. The record would not permit a reasonable factfinder to find for Motorola or Google with respect to these defenses. Accordingly, Arendi's motion for summary judgment will be granted. *See, e.g., Intellectual Ventures I LLC v. T-Mobile USA, Inc.*, 2017 WL 3723934, at \*3 (D. Del. Aug. 29, 2017).

## **2. Arendi's Motion For Partial Summary Judgment In The *LG* Action**

Arendi requests partial summary judgment on two issues: (1) no anticipation (*see* C.A. No. 12-1595 D.I. 257 at 3-5); and (2) no limitation on Arendi's damages under 35 U.S.C. § 286 (*see id.* at 5).

**a. Anticipation**

Arendi contends that “at no point” in the reports of LG’s invalidity expert, Dr. Tajana Rosing, did she “provide an opinion that any asserted claim of the ’843 Patent was invalid as anticipated by any of the prior art.” (*Id.* at 3) Arendi also argues that “[d]uring her deposition, Dr. Rosing confirmed that she was not offering any anticipation opinions.” (*Id.* at 4; *see also id.* D.I. 258 Ex. 2 at 18, 24) Thus, in Arendi’s view, LG has “no evidence of anticipation.” (*Id.* D.I. 257 at 3)

The Court, however, agrees with LG that summary judgment is unwarranted. Dr. Rosing has expressed a contingent anticipation opinion, one which arises only if Arendi is permitted to make certain infringement arguments. Specifically, with respect to the claim limitation “providing an input device, configured by the first computer program,” Dr. Rosing states in connection with the CyberDesk prior art:

I understand that the ActOn bar is configured by CyberDesk, which is separate from the services like the scratchpad or email program. I do not believe that a program, like the scratchpad or email programs, together with the separate CyberDesk program can constitute a “first program” in the meaning of the patent. *I understand, however, that Arendi may take the position that the “first program” can include two programs working together, like a program in combination with the operating system. To the extent that Arendi contends that a “first program” can be two programs together, CyberDesk discloses an input device (the ActOn bar) configured by a first program, because the “the first program” would be both the service and CyberDesk together.*

(*Id.* D.I. 258 Ex. 1 ¶ 278; *see also id.* ¶ 289 (similarly contingent opinion with respect to “in consequence of receipt by the first computer program” claim term)) (emphasis added) Except for these two limitations, Dr. Rosing opines that CyberDesk disclosed all other limitations of claim 1 of the ’843 patent. (*See id.* ¶¶ 251-96) If Arendi pursues the infringement theories with

respect to these terms that Dr. Rosing predicts, she will be permitted to express her contingent anticipation opinions. Hence, summary judgment for Arendi is not warranted.

**b. Limitation On Damages Under 35 U.S.C. § 286**

Arendi contends it is entitled to summary judgment because LG has failed to present any evidence to limit Arendi's damages under 35 U.S.C. § 286. (*See id.* D.I. 257 at 5) LG responds that "Arendi's motion must be denied as moot" because "the earliest date for which Arendi asserts damages is . . . well within the six-year window permitted by 35 U.S.C. § 286." (*Id.* D.I. 302 at 8) LG argues that "Arendi's motion is also futile" because "[a] party does not obtain a 'judgment' that a statute does not limit its damages." (*Id.*)

This portion of Arendi's motion will be granted. LG has pled the statutory limitation on damages as one of its affirmative defenses. (*See id.* D.I. 36 ¶ 66) LG has neither explicitly withdrawn that defense nor produced any evidence to support it. Thus, Arendi is entitled to a judgment on that defense.<sup>15</sup>

**3. Arendi's Motion For Partial Summary Judgment In The BlackBerry Action**

Arendi contends it is entitled to partial summary judgment because BlackBerry has no evidence of anticipation. (*See* C.A. No. 12-1597 D.I. 194 at 3-5) For the same reasons provided in the LG Action (*see supra* II.B.2.a), this portion of Arendi's motion will be denied.

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<sup>15</sup> The case cited by LG is inapposite. In *Bradford Co. v. Jefferson Smurfit Corp.*, 2001 WL 35738792, at \*9-10 (Fed. Cir. Oct. 31, 2001), the Federal Circuit found that "a limitation on damages is not a statutory defense that must be pleaded," and concluded that the district court did not err in allowing the defendant to raise the defense of 35 U.S.C. § 286 for the first time at trial. Here, by contrast, LG has pled the statutory limitations on damages under § 286 as one of its affirmative defenses – and then made no effort to prove its applicability.

Arendi also contends that BlackBerry has presented no evidence to support the limitations on damages under 35 U.S.C. §§ 286 and 288; the affirmative defenses of equitable estoppel, waiver, unclean hands, and laches; or the limitations on remedies under 28 U.S.C. § 1498. (*See id.* at 6-8)

With respect to the limitation on damages under 35 U.S.C. § 286, BlackBerry raises the same argument as LG does. (*See id.* D.I. 236 at 8-9) For the same reasons provided in the *LG* Action (*see supra* II.B.2.b), this portion of Arendi's motion will be granted.

For the affirmative defense of equitable estoppel, BlackBerry contends that Arendi's motion should be "conditionally granted." (*See id.* at 9-10) It appears that BlackBerry's position is: Arendi's motion should be granted because BlackBerry "admits that there is a lack of evidence to establish" (*id.* at 10) the elements of equitable estoppel, as set out in *High Point SARL v. Sprint Nextel Corp.*, 817 F.3d 1325, 1330 (Fed. Cir. 2016). However, BlackBerry continues, if Arendi contends that the doctrine of equitable estoppel "includes a prohibition of the prosecution history estoppel" (C.A. No. 12-1597 D.I. 236 at 10 n.4), then its motion should be denied. (*See id.* at 10)

It is not for Arendi to define the scope of equitable estoppel. Instead, the Court must follow the law, including that set out by the Federal Circuit in *High Point*. Doing so, the Court concludes that, even taking the evidence in the light most favorable to BlackBerry, no reasonable factfinder could find equitable estoppel (as BlackBerry admits). Thus, Arendi's motion with respect to equitable estoppel will be granted, without the condition requested by BlackBerry.

BlackBerry has neither responded to Arendi's motion on the other defenses nor affirmatively withdrawn such defenses. These portions of Arendi's motion will also be granted.



#### **4. Arendi's Motion For Partial Summary Judgment In The *Sony* Action**

Arendi and Sony raise the same anticipation-related issues discussed above in connection with the *LG* Action. (See C.A. No. 12-1602 D.I. 227 at 3-5; *see also supra* II.B.2.a) For the same reasons given above, this portion of Arendi's motion will be denied.

Arendi also contends that Sony has presented no evidence to support the limitations on damages under 35 U.S.C. §§ 286 and 288; the affirmative defenses of equitable estoppel, waiver, unclean hands, and laches; or the limitations on remedies under 28 U.S.C. § 1498. (See *id.* at 6-8) Sony represents that it "will not be pursuing [those] defenses." (*Id.* D.I. 265 at 6) Sony's withdrawal appears materially more definitive than that of other Defendants. Nevertheless, the time has come – and passed – for Sony to come forward with sufficient evidence to sustain a verdict on issues it has injected into this litigation and, by its own admission, it cannot do so. Therefore, the Court will grant Arendi's motion.

#### **5. Arendi's Motion For Partial Summary Judgment In The *Oath* Action**

All the same issues discussed above in connection with the *Sony* Action are presented in Arendi's motion in the *Oath* Action. (See C.A. No. 13-920 D.I. 237 at 3-7) For the same reasons provided above (*see supra* II.B.2.a, II.B.4), the portion of Arendi's motion directed to anticipation will be denied and the remainder of Arendi's motion will be granted.

### **III. CONCLUSION**

An appropriate order follows.