22-1762, 23-2029

United States Court of Appeals
for the Federal Circuit

———————

ARENDI S.A.R.L.,
Plaintiff-Appellant

v.

OATH HOLDINGS INC., OATH INC.,
Defendants-Appellees

———————

Appeal from the United States District Court for the District of Delaware
Case No. 13-cv-00920, Chief Judge Leonard P. Stark

———————

ARENDI S.A.R.L.,
Plaintiff-Appellant

APPLE INC.,
Third-Party Defendant

v.

GOOGLE LLC,
Defendant-Appellee

———————

Appeal from the United States District Court for the District of Delaware
Case No. 13-cv-00919, Judge Jennifer L. Hall

———————

BRIEF OF APPELLEES OATH HOLDINGS INC. AND OATH INC.

———————

July 17, 2024

Jeffri A. Kaminski
Megan S. Woodworth
VENABLE LLP
600 Massachusetts Ave, NW
Washington, DC 20001
Telephone: (202) 344-4048
Facsimile: (202) 344-8300

Attorneys for Defendants-Appellees Oath Holdings Inc. and Oath Inc

CERTIFICATE OF INTEREST FOR OATH HOLDINGS INC. AND OATH INC.

Counsel for Defendants-Appellees Oath Holdings Inc. and Oath Inc. certifies the following:

1.   The full name of every party represented by me is:

Oath Holdings Inc. and Oath Inc.

2.   The names of the real parties in interest represented by me are:

Yahoo Inc. and Yahoo Holdings Inc.

3.   All parent corporations and any publicly held companies that own 10% or more of stock in the parties represented by me are:

Yahoo Inc. states that it is a Delaware corporation with its principal place of business in New York. Yahoo Inc. is an indirect wholly-owned subsidiary of College Parent, L.P. Yahoo Inc. is part of Apollo Investment Fund IX's portfolio, in which Apollo Global Management, Inc. has an indirect interest. There is no publicly held corporation that owns a 10% or more interest in Apollo Global Management, Inc. Verizon Communications Inc., a publicly traded company, retains an indirect minority ownership interest of approximately 10% of Yahoo Inc.

Yahoo Holdings Inc. states that it is a Delaware corporation with its principal place of business in New York. Yahoo Holdings Inc. is a direct wholly-owned subsidiary of Yahoo Inc. Yahoo Inc. is part of Apollo Investment Fund IX's portfolio, in which Apollo Global Management, Inc. has an indirect interest. There is no publicly held corporation that owns a 10% or more interest in Apollo Global Management, Inc. Verizon Communications Inc., a publicly traded company, retains an indirect minority ownership interest of approximately 10% of Yahoo Inc.

4.   The names of all law firms and the partners or associates that appeared for the parties now represented by me before the originating court or that are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

Morris, Nichols Arsht & Tunnell LLP.: Anthony David Raucci, Jack B. Blumenfeld

Venable LLP: Calvin R. Nelson, Katherine C. Dearing, William A. Hector, Neha Bhat

5.　The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this Court's decision in the pending appeal is:

- Arendi S.A.R.L. v. LG Electronics Inc., No. 1:12-cv-1595-VAC (D. Del.)

- Arendi S.A.R.L. v. Blackberry Ltd., No. 1:12-cv-1597-VAC-JLH (D.Del.)

- Arendi S.A.R.L. v. Motorola Mobility LLC, No. 1:12-cv-1601 (D. Del.)

- Arendi S.A.R.L. v. Sony Mobile Communications (USA) Inc., 1:12-cv-1602-VAC-JLH (D. Del.)

- Arendi S.A.R.L. v. HTC Corp., No. 1:12-cv-1600-VAC (D. Del.)

- Arendi S.A.R.L. v. HTC Corp., No. 2:18-cv-1725-BJR (W.D. Wash.)

6.　Organizational Victims and Bankruptcy Cases: Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees) are not applicable because this is not a criminal or bankruptcy case. See Fed. Cir. R. 47.4(a)(6).

N/A

DATED: July 17, 2024　　　　　　By:　 /s/ *Jeffri A. Kaminski*
　　　　　　　　　　　　　　　　　　Jeffri A. Kaminski

iv

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

STATEMENT OF RELATED CASES

Arendi alleged infringement by Oath and Google of U.S. Patent Nos. 7,917,843 ("the '843 patent"), 8,306,993 ("the '993 patent"), and 7,496,854 ("the '854 patent"), and, with respect to Google, U.S. Patent No. 7,921,356 ("the '356 patent"), the patents at issue in this appeal. The outcome of this appeal may affect related cases pending before the U.S. District Courts for the District of Delaware and the Western District of Washington, in which Arendi alleges infringement of the '843, '854, and '993 patents by other defendants. Those cases are *Arendi S.A.R.L. v. Motorola Mobility LLC*, 12-cv-01601-JLH (D. Del.); *Arendi S.A.R.L. v. LG Electronics Inc.*, et al., 12-cv-1595-GBW (D. Del.); *Arendi S.A.R.L. v. HTC Corp.*, 12-cv-1600-GBW (D. Del.); *Arendi S.A.R.L. v. Blackberry Limited, et al.*, 12-cv-1597-GBW (D. Del.); *Arendi S.A.R.L. v. HTC America, Inc.*, 2:18-cv-1725-BJR (W.D. Wash.). Those cases and this appeal concern the construction of terms in the '843 and '993 patents, as well as the invalidity of the '993 and '854 patents under 35 U.S.C. § 101. In addition, this appeal concerns non-infringement of the '843 patent by Oath.

Oath is unaware of any cases currently pending before other tribunals that would directly affect the Court's decision in this appeal.

STATEMENT OF ISSUES PRESENTED

1.   Whether the district court correctly found the '993 patent and '854 patent ineligible under 35 U.S.C. § 101?

2.   Whether the district court correctly construed the claim terms "document" and "while it is electronically displayed"?[1]

3.   Whether the district court correctly granted summary judgment of no direct infringement in favor of Oath?

INTRODUCTION

The Asserted Patents are generally directed to using conventional computer programs to allow users who have typed text into a document in one program to search for, retrieve, and use related information from a second program (*e.g.*, finding contact information associated with a typed name). Arendi sued Oath claiming that Oath software, when combined with hardware and software not provided by Oath, infringed various claims of the asserted patents. Appx6125; Appx5449. The accused products included Oath's applications, such as Yahoo! Mail, Yahoo! Sports, Yahoo! Finance, etc. ("Accused Apps"), for smartphones and tablets. Appx6506. These applications are downloaded by users onto the users' own smartphones and tablets. Those smartphones and tablets also include an operating system framework, such

---

[1] For issues 1. and 2. Oath incorporates by reference Sections II.(A). and (B.); III.(A.) and (B.); and IV. of the Argument in the Brief of Appellee Google in Appeal 2023-2029, consolidated with the present appeal. Oath also agrees with Section II.(C.) of the Google Brief, but procedurally that issue is not in the Oath appeal.

Android, which is separate from the Oath apps. Appx6513-Appx6514; Appx6520. Arendi accuses the combination of the Oath app code with the operating system framework on the user's device of infringement. Appx6506; Appx6515. The district court case against Oath (and Google) proceeded through fact and expert discovery.

At summary judgment, claim 23 of the '843 patent was the only remaining claim asserted against Oath. Claim 23 recites, in part, "[a]t least one non-transitory computer readable medium encoded with instructions which . . . establish processes for finding data related to the contents of a document," "providing an input device, configured by the first computer program," and "causing a search for the search term in the information source, using a second computer program." Appx166 at 12:40-44; *see* Appx88-Appx90.

Arendi's infringement allegations for claim 23 require Oath software, apps such as Yahoo! Mail, Yahoo! Finance, Yahoo! Sports, etc., to be installed on a computer, such as a mobile phone, that also has the Android operating framework installed. *See* Appx6506; Appx6513- Appx6514; Appx6591 at ¶42; Appx6672 at ¶227; Appx6744-Appx6745 at ¶¶367-369. The software applications provided by Oath do not include any code from the Android framework, as admitted by Arendi's technical expert. Appx6513-Appx6514; Appx6520. That Android framework code may be provided via a mobile phone pre-loaded with the Android operating system. *Id.*

It is undisputed that the accused Oath software alone does not include the code required to perform all of the claimed "processes." Appx90 at n.17. It is only when a user combines the Oath code with other, non-Oath code that any alleged infringement occurs. This is insufficient for *direct* infringement. For this reason, after completion of fact and expert discovery, the district court granted summary judgment of no direct infringement in favor of Oath with respect to claim 23 of the '843 patent, ending the case against Oath.

The District Court's ruling is well supported. Arendi lacks evidence of direct infringement, and cannot overcome dispositive evidence, including their own expert's admissions, that the accused Oath apps alone do not directly infringe the asserted claim. The District Court properly held that no reasonable juror could find the Oath apps directly infringe. The grant of summary judgment of no direct infringement by Oath should be affirmed.

Arendi also appeals the determination of the '993 and '854 patents[2] as ineligible under 35 U.S.C. § 101; the construction of the claim terms "document" and "while it is electronically displayed" and the partial summary judgement of non-infringement based on these claim constructions. For these issues, Oath incorporates by reference Sections II.(A). and (B.); III.(A.) and (B.); and IV. of the Argument in the Brief of Appellee Google in Appeal 2023-2029.

---

[2] The '356 patent is not asserted against Oath.

In the Google case consolidated for this appeal, Arendi proceeded to trial against Google on claims 23 and 30 of the '843 patent. The jury returned a verdict that the '843 patent was invalid for both anticipation and obviousness and that Arendi had failed to prove infringement by a preponderance of the evidence. Appx6171-Appx6175.

SUMMARY OF ARGUMENT

Arendi raises three issues on appeal: (1) Whether the district court correctly found the '993 patent and '854 patent ineligible under 35 U.S.C. § 101? (2) Whether the district court correctly construed the claim terms "document" and "while it is electronically displayed"?[3] (3) Whether the district court correctly granted summary judgment of no direct infringement in favor of Oath?

For the first two issues, Oath incorporates by reference the argument of Appellee Google in Appeal 2023-2029, as noted above, consolidated with the present case.

As to the third issue, the judgment in Google's favor with respect to the '843 patent rests on two independent grounds: noninfringement and invalidity. Appx6171-Appx6175. Arendi failed to appeal the invalidity verdict. Should this Court decide that issue in Google's favor, then this Court need not reach Arendi's

---

[3] Claim 98 of the '854 patent that Arendi identifies as part of this issue is not asserted against Oath.

arguments regarding Oath's alleged infringement of the '843 patent. The asserted claim of the '843 is invalid.

In the event this Court does consider Arendi's arguments, the District Court correctly found that there was no evidence that the Oath apps include all of the elements of the asserted claim, and as such cannot directly infringe. It is undisputed that the Oath apps alone do not meet all of the claim elements. It is only when an Oath app is combined with non-Oath software and hardware by loading the Oath app onto a user's device (smartphone or tablet) that is pre-installed with the Android framework can any alleged infringement occurs.

Arendi's argument on appeal that Oath somehow makes and sells the claimed "computer readable medium" via a "software download" is a red herring and not supported by evidence or citations to the record. There is a complete lack of evidence that the Oath software alone infringes claim 23 of the '843 patent or that Oath itself downloads its apps onto users' smartphones or tablets. Because Oath's software alone does not include all the elements of the claim, and Oath does not provide the claimed "computer readable medium," no reasonable juror could find that Oath directly infringes.

ARGUMENT

I. **The District Court Correctly Found No Question of Material Fact That Oath's Software Does Not Meet the Elements of Claim 23**

The District Court correctly found that Arendi provided no evidence that the

Oath software alone can practice all elements of claim 23 when loaded onto a computer or device *without* the underlying Android operating system framework. Indeed, Arendi's expert only provided evidence of infringement of the accused software *combined* with the underlying Android framework. Appx6513-Appx6514. This undisputed fact, which is not addressed in Arendi's opening brief, is fatal to Arendi's claim of direct infringement. The District Court properly concluded that Arendi failed to set forth evidence sufficient to support a finding of direct infringement. Appx71-Appx72; Appx101.

A.   Arendi Offers No Proof That Oath's Software Itself Meets All Limitations of Claim 23

Claim 23 recites, in part, ""[a]t least one non-transitory computer readable medium encoded with instructions which . . . establish processes for finding data related to the contents of a document," "providing an input device, configured by the first computer program," and "causing a search for the search term in the information source, using a second computer program." These claim elements are absent from the Accused Apps. For example, Arendi alleged that these claim elements are satisfied by a smartphone's underlying Android framework, as opposed to the programming code for the Accused Apps that Oath provides. Appx6591 at ¶42; Appx6672 at ¶227; Appx6744-Appx6745 at ¶¶367-369. Arendi's expert confirmed that the infringement analysis in his expert report is limited to the Accused

Apps combined with the underlying Android frameworks, as opposed to the Accused

Apps in isolation (or with some other framework):

> Q: Well, in your report, do you assert that the app-specific code for the Oath applications infringed when they are not loaded onto a computer having either iOS or Android operating systems?
>
> A: I'm pretty sure I haven't given an opinion on that one way or the other.

Appx6515.

Arendi's expert also testified that when any of the Accused Apps are

downloaded from the application store onto a smartphone, only the programming

code specific to the Accused Apps is downloaded, not the underlying Android

framework code. Appx6520; *See also* Appx6520 at ¶12 ("code relating to Linkify is

defined in libraries distributed with the Android framework."); Appx6520 at ¶13

("Code relating to Text Classifier is likewise defined in libraries distributed with the

Android framework."). Thus, there is no dispute that Oath does not provide the

Android framework code required for infringement under Arendi's infringement

theory.

A patent is infringed when a person "without authority makes, uses, offers to

sell, or sells any patented invention, within the United States . . . during the term of

the patent . . ." 35 U.S.C. § 271(a). "In order to 'make' the system under § 271(a),

[defendant] would need to combine all the claim elements." *Centillion Data Sys.,*

LLC v. Qwest Commc'ns Int'l, Inc., 631 F.3d 1279, 1288 (Fed. Cir. 2011). The

defendant has not infringed if a user, rather than defendant, performs the final step to assemble the system. *See Id.*

Oath does not make, sell, or offer to sell the computer readable medium (CRM) of claim 23. Appx6523-Appx6524. Rather, the end user or device manufacturer makes the CRM by loading the Oath software in the form of the Accused Apps onto their own hardware, which is preloaded with the Android framework. Appx6513-Appx6514. *See Centillion*, 631 F.3d at 1288 ("Qwest manufactures only part of the claimed system. In order to 'make' the system under § 271(a), Qwest would need to combine all of the claim elements – this it does not do. The customer, not Qwest, completes the system by providing the 'personal computer data processing means' and installing the client software.").

Arendi's evidence of infringement only concerns the combination of the Accused Apps with the underlying Android framework. Arendi has provided no evidence that the instructions encoded by the Accused Apps alone, without the underlying operating system frameworks, are capable of the process claimed in claim 23 when they are loaded on a computer. It follows that there is no genuine dispute of material fact that Oath does not infringe claim 23.

Arendi dubs claim 23 a "computer readable medium" or "CRM" claim, and asserts that such a claim only requires that the accused Oath software be capable of performing the functions recited in the claim. Even if this is correct, Arendi's

9

infringement expert admits that he does not offer any opinion that any Oath software or app alone meets all the elements of claim 23. Arendi's expert only offers opinions that infringement of claim 23 occurs when an Oath app is installed on a device that includes other non-Oath software. Appx6515. According to Arendi's expert, it is only when the Oath software is combined with other software and loaded onto a computer that claim 23 is met. Thus, there is no evidence that the Oath software alone infringes claim 23, and summary judgement of no direct infringement of claim 23 was proper.

On appeal, Arendi does not seem to dispute these findings, arguing instead that the a "software download" can infringe a CRM claim. Arendi Op. Br at 54-55. But there is no evidence or case law to support that a "software download" can directly infringe a CRM claim when the "software download" does not include the code required for the claimed processes.

B.   The Case Law Cited by Arendi Does Not Support Its Position

Arendi relies on *Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197 (Fed. Cir. 2010) as support for direct infringement by Oath's code even though a user must download the Oath code onto the user's device. Arendi Op. Br. at 55.

In discussing direct infringement by software on a CRM in *Finjan*, this Court emphasized that "[t]he code for [the claimed function] was **'already present'** in Defendants' accused products when sold." *Finjan*, 626 F.3d at 1205 (emphasis

added); and that "it is undisputed that software for performing the claimed functions **existed in the products when sold** in the same way that an automobile engine for propulsion exists in a car even when the car is turned off." *Id.* (emphasis added). As explained in *Finjan*, to infringe a CRM claim that recites capability to perform the steps recited in the claim and not actual operation, only "the existence of the claimed structure in the accused software" to perform the steps is required for infringement. *Id.* at 1204-05.

In contrast, there is no evidence that Oath makes, uses, or sells any "computer readable medium" having code "already present" that itself is capable of performing the recited claim elements. It's undisputed that the Android functionalities relied on by Arendi for infringement are not part of the Oath software that is downloaded. Appx6513-Appx6514; Appx6520. Arendi's expert admits that the framework code for performing the claimed functions is not part of the Oath code that is downloaded by the user, as explained above. Appx6513- Appx6514. Moreover, as noted above, Arendi's expert offers no opinion that the Oath software alone infringes. Appx6515. This is a failure of proof of direct infringement.

In addition, Arendi appears to be citing *Finjan* for the proposition that a "software download" may infringe a CRM claim. ("this Court held that a software download could infringe a CRM claim"). Arendi Op. Br at 54. That is simply wrong. Finjan holds no such thing. In fact, *Finjan* explicitly states that whether a software

download can infringe a CRM claim is not presented in the appeal. ("Defendants have not argued that the Webwasher software download product is not a "system" or "computer-readable storage medium.") *Finjan*, 626 F.3d at 1205, n.2. In any event, Arendi presents no evidence that a "software download" is the claimed computer readable medium (it is not). And again, it is undisputed that the code for establishing the claimed functions does not exist in the "software download" of the Accused Apps, because the "software download" of the Accused Apps do not contain the underlying operating system framework required for the ability to perform the claimed functions. Appx6513-Appx6514.

Precedent does not support expanding direct infringement of a CRM claim to include source code beyond that source code already existing in the software itself. This Court's cases that hold that a finding of direct infringement is not precluded if a user needs to unlock or activate a feature that is <u>already present</u> in software do not help Arendi. In those cases, the code capable of performing the accused function was already present in the software provided to the customer. See *Fantasy Sports Props., Inc. v. Sportsline.com, Inc.*, 287 F.3d 1108, 1118-19 (Fed. Cir. 2002); *Versata Software, Inc. v. SAP America, Inc.,* 717 F.3d 1255, 1262-63 (Fed. Cir. 2013). In no case was the code that actually performed the function missing from the accused software, or was supplying the software that actually performs the claimed function deemed to be activation or assembly of an already present feature.

12

This activation of a feature already present in software is not analogous with the present case involving the use of the separate Android framework code with the accused apps. Here, there is no dispute that the Android framework code is not part of the Oath accused app downloaded onto a smartphone. Appx6513-Appx6514; Appx6520; Appx6591 at ¶42.

In addressing *Finjan*, the District Court correctly stated that "[h]ere, by contrast, it is undisputed that the 'software for performing the claimed functions' does not exist in the Accused Apps, because the Accused Apps do not contain the underlying operating system frameworks required for the ability to perform the claimed functions." Appx90 at n.17. Using the automobile analogy of *Finjan*, it is not the case that the "automobile engine" is present but turned off in the Oath code. The "automobile engine" is entirely missing from the code provided by Oath.

II.   Summary Judgement Based on Claim Construction was Correct

The District Court granted summary judgment of noninfringement of the asserted claims of the '843 patent with respect to Defendants' accused products' use of "Linkify" and "Smart Linkify" functionality. Appx70-Appx73, Appx86-Appx87. If this Court addresses the '843 patent at all, it should affirm this portion of the District Court's summary judgement ruling because that construction was correct.

CONCLUSION

For the above reasons, the district court's grant of summary judgment should be affirmed.

Dated: July 17, 2024

/s/ *Jeffri A. Kaminski*

Jeffri A. Kaminski
Megan S. Woodworth
VENABLE LLP
600 Massachusetts Ave, NW
Washington, DC 20001

Telephone: (202) 344-4048
Facsimile: (202) 344-8300

Attorneys for Defendants-Appellees Oath Holdings Inc. and Oath Inc.

CERTIFICATE OF COMPLIANCE

1.   This brief complies with the type-volume limitation of Federal Circuit Rule 32(b)(1), because it contains 10,427 words (including those parts incorporated by reference), excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2).

2.   This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6), because it has been prepared in a proportionally spaced typeface using Microsoft Word in Times New Roman 14-point font.

Dated: July 17, 2024   */s/ Jeffri A. Kaminski.*

                                                             Jeffri A. Kaminski

                                                             Attorney for Defendants-Appellees Oath Holdings Inc. and Oath Inc.

15

CERTIFICATE OF SERVICE

I hereby certify that on the 17ᵗʰ day of July, 2024, the foregoing document was served via served on counsel of record using the Court's CM/ECF notification system.

/s/ *Jeffri A. Kaminski*
Jeffri A. Kaminski
Venable LLP
600 Massachusetts Ave, N.W.
Washington, D.C. 20001
(202) 344-4048
Fax (202) 344-8300
JAKaminski@venable.com

16