

1 Robert W. Dickerson, Jr. (SBN 89367)
E-mail: rdickerson@bwsllaw.com
2 BURKE, WILLIAMS & SORESENSEN, LLP
444 South Flower Street, Suite 2400
3 Los Angeles, CA 90071-2953
Tel: 213.236.0600 Fax: 213.236.2700

4 Patricia L. Peden (SBN 206440)
E-mail: ppeden@bwsllaw.com
5 Burke, Williams & Sorensen, LLP
1901 Harrison Street, Suite 900
6 Oakland, California 94612-3501
7 Tel: 510-273-8780 Fax: 510-839-9104

8 Lenny Huang (SBN 264386)
E-mail: lhuang@bwsllaw.com
9 BURKE, WILLIAMS & SORESENSEN, LLP
1 California Street, Suite 3050
10 San Francisco, California 94111-5432
Tel: 408-606-6300 Fax: 408-6064333

11 Attorneys for Plaintiffs
12 SMITH MICRO SOFTWARE, INC. and
13 SMITH MICRO SOFTWARE, LLC

14 UNITED STATES DISTRICT COURT
15 NORTHERN DISTRICT OF CALIFORNIA

16
17 SMITH MICRO SOFTWARE, INC.
18 and SMITH MICRO SOFTWARE,
LLC,

19 Plaintiffs,

20 v.

21 AGIS SOFTWARE
22 DEVELOPMENT LLC, and DOES
1 to 10,

23 Defendants.

Case No. 3:21-cv-03677-JD

**PLAINTIFF’S ADMINISTRATIVE
MOTION TO CONSIDER
WHETHER CASES SHOULD BE
RELATED**

*[Proposed Order filed concurrently
herewith]*

Judge: Honorable James Donato

24
25 Pursuant to Civil L.R. 3-12, Plaintiffs Smith Micro Software, Inc. and Smith
26 Micro Software, LLC (jointly “Smith Micro” or “Plaintiffs”) hereby move this
27 Court for an Order declaring that the pending case *WhatsApp LLC v. AGIS Software*
28

1 *Development LLC*, Case No. 5:21-cv-03076-BLF (“WhatsApp action”) and the
2 pending case *Smith Micro Software, Inc., Smith Micro Software, LLC v. AGIS*
3 *Software Development LLC*, Case No. Case No. 5:21-cv-3677 (“Smith Micro
4 action”) are “related” such that the Smith Micro action should be assigned to the
5 Honorable Judge Beth Labson Freeman, who presides over the earlier-filed
6 WhatsApp action.

7 Defendant in both actions, AGIS Software Development LLC (“AGIS”), has
8 agreed that the cases are related under Civil Rule L.R. 3-12 (*see* Exhibit A
9 attached).

10 Both actions are in their infancy, as defendant AGIS has not yet responded to
11 the complaint in either action.

12 **I. FACTUAL BACKGROUND**

13 AGIS has filed separate patent infringement lawsuits against four defendants
14 in the Eastern District of Texas, including a case against Smith Micro’s customer,
15 T-Mobile USA, Inc. and T-Mobile US, Inc. (together, “T-Mobile”), and a case
16 against WhatsApp LLC (“WhatsApp”).¹

17 AGIS’s Texas action against T-Mobile alleges that T-Mobile’s *FamilyMode*
18 and *FamilyWhere* applications (“Accused Products”) infringe various AGIS
19 patents.² *AGIS Software Development LLC v. T-Mobile USA, Inc., et al.*, 2:21-cv-
20 00072-JRG (E.D. Tex.), Dkt. No. 1 (the “EDTex action”). The Smith Micro
21 plaintiffs supply the technology that is used by T-Mobile in the Accused Products.

22 The same Patents-in-Suit are asserted against WhatsApp in Texas.

23 _____
24 ¹ AGIS has filed the following cases in the Eastern District of Texas: 1) *AGIS*
25 *Software Development LLC v. Uber Technologies Inc. d/b/a Uber*, Case No. 2:21-
26 *cv-00026-JRG-RSP*; 2) *AGIS Software Development LLC v. Lyft, Inc.*, Case No.
27 *2:21-cv-00024-JRG-RSP*; 3) *AGIS Software Development LLC v. WhatsApp, Inc.*,
28 *Case No. 2:21-cv-00029-JRG-RSP*; and 4) *AGIS Software Development LLC v. T-*
Mobile USA, Inc. et al., Case No. 2:21-cv-00072-JRG-RSP, all assigned to the
same judge. The Court in EDTex has consolidated these cases for pre-trial matters.

² U.S. Patent Nos. 7,031,728; 7,630,724; 9,408,055; 9,445,251; 9,467,838; and
9,749,829 (collectively, the “Patents-in-Suit”).

1 WhatsApp then filed the WhatsApp action in the Northern District of California, a
2 declaratory judgment action alleging that WhatsApp does not infringe the same
3 Patents-in-Suit and/or that the Patents-in-Suit are invalid. The earlier filed
4 WhatsApp action is assigned to the Honorable Judge Beth Labson Freeman.

5 Because the AGIS EDTex action vs. T-Mobile places the Smith Micro
6 technology at issue regarding AGIS's allegations of patent infringement, Smith
7 Micro filed the Smith Micro action, a declaratory judgment action against AGIS
8 alleging that Smith Micro's technology does not infringe the same Patents-in-Suit
9 as in the WhatsApp action, and/or that the Patents-in-Suit are invalid. The Smith
10 Micro action is currently assigned to the Honorable Judge James Donato.

11 **II. THE SMITH MICRO ACTION AND THE WHATSAPP ACTION ARE RELATED**

12 As defined in Civil L.R. 3-12, actions are related when: "(1) The actions
13 concern substantially the same parties, property, transaction or event; and (2) It
14 appears likely that there will be unduly burdensome duplication of labor and
15 expense or conflicting results if the cases are conducted before different judges."
16 Civ. L.R. 3-12(a). The Smith Micro and WhatsApp actions satisfy both prongs of
17 the requirement.

18 First, the two actions concern the same parties (defendant AGIS), and the
19 same property (the Patents-in-Suit). Therefore, issues of validity and claim
20 construction will be at least substantially the same, if not very much the same.
21 Duplicate claim constructions, tutorials, pre-trials and trials would be a waste of
22 time and resources for the Courts, juries and the parties. If AGIS disputes venue or
23 jurisdiction in the Northern District of California, it is expected to do so in both
24 actions, so those issues will also be substantially related in both actions.

25 Second, there is no reasonable basis to incur the undue burden or risk of
26 inconsistent rulings that would result from two different judges, sitting in different
27 courthouses, adjudicating the same claims asserted against the same declaratory
28 judgment defendant. Thus, the Court should find the Smith Micro action and

1 WhatsApp action related under Civil L.R. 3-12(a) and assign both actions to one
2 judge to conserve judicial resources and promote the efficient resolution of the
3 action. Otherwise, there is too great a risk of inconsistent findings that will have to
4 be reconciled at the appellate level. *See* Civil L.R. 3-12(a)(2).

5 **III. CONCLUSION**

6 Smith Micro respectfully requests a determination that the above-captioned
7 Smith Micro action is related to the WhatsApp action and an assignment of the
8 Smith Micro action to the Honorable Judge Beth Labson Freeman.

9
10 Dated: August 20, 2021

Respectfully Submitted,

11 BURKE, WILLIAMS & SORENSEN, LLP
12 Lenny Huang
13 Patricia L. Peden

14 By: /s/ Robert W. Dickerson, Jr.
15 Robert W. Dickerson, Jr.

16 Attorneys for Plaintiffs
17 SMITH MICRO SOFTWARE, and SMITH
18 MICRO SOFTWARE, LLC

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EXHIBIT A

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