

1 Lisa K. Nguyen (Bar No. 244280)
2 lisa.nguyen@lw.com
3 Richard G. Frenkel (Bar No. 204133)
4 rick.frenkel@lw.com
5 Clara Wang (Bar No. 321496)
6 clara.wang@lw.com
7 LATHAM & WATKINS LLP
8 140 Scott Drive
9 Menlo Park, CA 94025
10 Telephone: (650) 328-4600
11 Facsimile: (650) 463-2600

12 Alan M. Billharz (*pro hac vice*)
13 alan.billharz@lw.com
14 Tiffany C. Weston (*pro hac vice*)
15 tiffany.weston@lw.com
16 LATHAM & WATKINS LLP
17 555 Eleventh Street, NW, Suite 1000
18 Washington, DC 20004
19 Telephone: (202) 637-2200
20 Facsimile: (202) 637-2201

21 *Attorneys for Plaintiff*
22 *WhatsApp LLC*

Alfred R. Fabricant (*pro hac vice*)
afabricant@fabricantllp.com
Peter Lambrianakos (*pro hac vice*)
plambrianakos@fabricantllp.com
Vincent J. Rubino, III (*pro hac vice*)
vrubino@fabricantllp.com
Enrique Iturralde (*pro hac vice*)
eiturralde@fabricantllp.com
FABRICANT LLP
411 Theodore Fremd Road, Suite 206 South
Rye, New York 10580
Telephone: (212) 257-5797
Facsimile: (212) 257-5796

Benjamin T. Wang (CA SBN 228712)
bwang@raklaw.com
Minna Y. Chan (CA SBN 305941)
mchan@raklaw.com
RUSS AUGUST & KABAT
12424 Wilshire Boulevard, 12th Floor
Los Angeles, California 90025
Telephone: (310) 826-7474
Facsimile: (310) 826-9226

Attorneys for Defendant
AGIS Software Development LLC

17 **UNITED STATES DISTRICT COURT**
18 **NORTHERN DISTRICT OF CALIFORNIA**
19 **SAN JOSE DIVISION**

22 WHATSAPP LLC,
23 Plaintiff,
24 v.
25 AGIS SOFTWARE DEVELOPMENT LLC,
26 Defendant.

Case No. 5:21-cv-03076-BLF

**JOINT CASE MANAGEMENT
STATEMENT & [PROPOSED] ORDER**

Date: September 2, 2021
Time: 11:00 a.m.
Courtroom: 3, 5th Floor, San Jose
Judge: Hon. Beth Labson Freeman

Complaint Filed: April 27, 2021

1 Pursuant to the Civil Local Rule 16-9 and the Court's May 14, 2021 Notice (Dkt. No. 15),
2 Plaintiff WhatsApp LLC ("WhatsApp") and Defendant AGIS Software Development LLC
3 ("AGIS Software") submit this Joint Case Management Statement and [Proposed] Order.

4 **1. JURISDICTION AND SERVICE**

5 This Court has jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1331,
6 1338(a), 2201, and 2202 and the patent laws of the United States (35 U.S.C. § 1, *et seq.*).
7 WhatsApp contends that venue is proper in this district and that the Court has personal jurisdiction
8 over the parties. AGIS disputes that venue is proper in this district, and further disputes that the
9 Court has personal jurisdiction over the parties. On August 23, 2021, AGIS moved the Court, for:
10 (1) an order dismissing the Complaint for Declaratory Judgment filed by Plaintiff WhatsApp LLC
11 ("WhatsApp" or "Plaintiff") pursuant to Rule 12(b)(2) of the Federal Rules of Civil Procedure; (2)
12 an order dismissing the Complaint for Declaratory Judgment in favor of the first-filed action; or
13 (3) in the alternative, an order staying this action pending a decision on WhatsApp's motion to
14 dismiss, or in the alternative, to transfer, which is currently pending in the Eastern District of
15 Texas. Dkt. 37. AGIS's motion to dismiss is currently scheduled for this Court's next available
16 hearing date on January 27, 2022. No parties remain to be served.

17 **2. FACTS**

18 WhatsApp's Summary of Relevant Facts

19 WhatsApp is a Delaware limited liability corporation with its principal place of business
20 in Menlo Park, California. Per AGIS Software's allegations in another litigation between the
21 parties, AGIS Software is a Texas limited liability company, having its principal place of business
22 at 100 W. Houston Street, Marshall, Texas 75670. According to Texas public records, AGIS
23 Holdings, Inc. ("AGIS Holdings") is the sole member of AGIS Software. According to Florida
24 public records, AGIS Holdings is organized and exists under the laws of the State of Florida, and
25 maintains its principal place of business at 92 Lighthouse Drive, Jupiter, FL 33469, which shares
26 the same address with Advanced Ground Information Systems, Inc., a Florida corporation. On

27

28

1 information and belief, AGIS Software is an agent and alter ego of Advanced Ground Information
2 Systems, Inc.

3 On January 29, 2021, AGIS Software sued WhatsApp in the U.S. District Court for the
4 Eastern District of Texas, alleging infringement of U.S. Patent Nos. 7,031,728 (“’728 Patent”),
5 7,630,724 (“’724 Patent”), 9,408,055 (“’055 Patent”), 9,445,251 (“’251 Patent”), 9,467,838 (“’838
6 Patent”), and 9,749,829 (“’829 Patent”) (collectively, the “Patents-in-Suit”). *AGIS Software
7 Development LLC v. WhatsApp, Inc.*, Case No. 2:21-cv-00029 (E.D. Tex. Jan. 29, 2021) (“Texas
8 Action”), Dkt. No. 1 (“Texas Compl.”). AGIS Software alleges WhatsApp infringes the Patents-
9 in-Suit by manufacturing, using, distributing, selling, offering for sale, and/or exporting from and
10 importing into the United States the “WhatsApp and WhatsApp Messenger Applications and the
11 related services and/or servers for the applications.” Texas Compl. ¶ 16. AGIS Software purports
12 to own all right, title, and interest in the Patents-in-Suit. *Id.* ¶ 1. On April 16, 2021, the Texas
13 district court consolidated the WhatsApp action with three other patent infringement actions filed
14 by AGIS Software. *AGIS Software Development LLC v. T-Mobile USA, Inc.*, Case No. 2:21-cv-
15 00072, Dkt. No. 14 (E.D. Tex. Apr. 16, 2021) (Lead Case). On April 27, 2021, WhatsApp filed
16 this declaratory judgment action and moved to dismiss the Eastern District of Texas litigation for
17 improper venue. *Id.*, Dkt. No. 34. WhatsApp’s motion to dismiss for improper venue is fully
18 briefed and a hearing is currently scheduled for September 1, 2021.

19 Several of the Patents-in-Suit are currently subject to pending petition for *inter partes*
20 review (“IPR”) or subject to *ex parte* reexamination proceedings (“EPR”) before the U.S. Patent
21 and Trademark Office. On June 24, 2021, WhatsApp filed petitions for IPR of the asserted claims
22 of the ’728 Patent and ’724 Patent in Case Nos. IPR2021-01177 and IPR2021-01178, respectively.
23 On July 30, 2021, WhatsApp filed a petition for IPR of all claims of the ’838 Patent in Case
24 No. IPR2021-01327. All claims of the ’829 Patent are challenged in Case No. IPR2020-00870,
25 filed May 22, 2020, currently subject to a petition for rehearing. Certain claims of the ’055 Patent
26 are subject to pending *Ex parte* Reexamination No. 90/014,508, filed May 15, 2020.

27

28

1 An actual and justiciable controversy exists between WhatsApp and AGIS Software
2 regarding the Patents-in-Suit. WhatsApp denies that the Patents-in-Suit are infringed through
3 making, using, distributing, sale, offering for sale, exportation, or importation of WhatsApp
4 Messenger or any other WhatsApp product or service. AGIS Software's infringement allegations
5 and related actions threaten actual and imminent injury to WhatsApp that can be redressed by
6 judicial relief and warrant declaratory judgment.

7 AGIS Software's Summary of Relevant Facts

8 On May 17, 2021, WhatsApp filed this action seeking declaratory judgment of non-
9 infringement as to the Patents-in-Suit. *See* Dkt. 1. On August 23, 2021, AGIS moved the Court,
10 for: (1) an order dismissing the Complaint for Declaratory Judgment filed by Plaintiff WhatsApp
11 LLC ("WhatsApp" or "Plaintiff") pursuant to Rule 12(b)(2) of the Federal Rules of Civil
12 Procedure; (2) an order dismissing the Complaint for Declaratory Judgment in favor of the first-
13 filed action; or (3) in the alternative, an order staying this action pending a decision on WhatsApp's
14 motion to dismiss, or in the alternative, to transfer, which is currently pending in the Eastern
15 District of Texas. Dkt. 37. The Complaint is deficient on the grounds that this Court lacks personal
16 jurisdiction over AGIS Software because AGIS Software is not "at home" in California, and it has
17 not purposefully directed activities related to the enforcement or defense of the Patents-in-Suit at
18 California sufficient to justify the exercise of personal jurisdiction over AGIS Software in
19 California in accordance with Due Process. In addition, pursuant to under 28 U.S.C. § 1404(a),
20 AGIS intends to file a motion to transfer this action to the Eastern District of Texas on convenience
21 grounds with an accompanying motion to stay this action pending resolution of the motions. If the
22 Court denies each of AGIS's motion to dismiss (Dkt. 37), AGIS's forthcoming motion to transfer
23 under 28 U.S.C. § 1404(a), and AGIS's accompanying motions to stay this action pending
24 resolution of the motions, AGIS Software expects to file an answer.

25 Malcolm K. "Cap" Beyer, Jr., the CEO of AGIS Software and a named inventor of the
26 Patents-in-Suit, is a graduate of the United States Naval Academy and a former U.S. Marine. Mr.
27 Beyer founded Advanced Ground Information Systems, Inc. ("AGIS, Inc.") shortly after the
28

1 September 11, 2001 terrorist attacks because he believed that many first responder and civilian
2 lives could have been saved through the implementation of a better communication system. He
3 envisioned and developed a new communication system that would use integrated software and
4 hardware components on mobile devices to give users situational awareness superior to systems
5 provided by conventional military and first responder radio systems. AGIS, Inc. developed
6 prototypes that matured into its LifeRing system, which provides first responders, law
7 enforcement, and military personnel with what is essentially a tactical operations center build into
8 hand-held mobile devices. LifeRing applications and services provide the functionalities so that
9 users can form and/or join networks or groups, share and view locations with other users, display
10 symbols corresponding to locations (including locations of other users) on a map, and communicate
11 with other users via text, voice, and multimedia-based communication. LifeRing users can also
12 display map information, including symbols corresponding with users, entities, and locations, and
13 form groups to track other users and communicate with other users, including through text
14 messages and voice calls. The claimed inventions of the Patents-in-Suit are directed to these
15 features. In this action, WhatsApp does not contend that the Patents-in-Suit are invalid under 35
16 U.S.C. 101, 102, 103, and 112.

17 **3. LEGAL ISSUES**

18 The parties agree that the principal issues are likely to be as follows:

- 19 1. WhatsApp's allegations that the Patents-in-Suit are not infringed; and
- 20 2. WhatsApp's allegations that the Patents-in-Suit are unenforceable.

21 In addition, WhatsApp believes the following issues are also principal to this dispute:

- 22 • Construction of claim terms in the Patents-in-Suit;
 - 23 • Issues of law regarding prosecution history estoppel and/or argument-based
24 estoppel relating to the Patents-in-Suit; and
 - 25 • Issues of law regarding whether AGIS Software's infringement allegations are
26 precluded by prior license agreements, covenants not to sue, and/or patent
27 exhaustion relating to the Patents-in-Suit.
- 28

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.