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21 **UNITED STATES DISTRICT COURT**  
 22 **NORTHERN DISTRICT OF CALIFORNIA**

23 LYFT, INC.,

24 *Plaintiff,*

25 v.

26 AGIS SOFTWARE DEVELOPMENT LLC,

27 Defendant.

Case No. 5:21-cv-04653-BLF

**DEFENDANT AGIS SOFTWARE  
 DEVELOPMENT LLC'S RESPONSE IN  
 OPPOSITION TO LYFT, INC.'S  
 MOTION TO STAY PENDING PATENT  
 OFFICE PROCEEDINGS INVOLVING  
 THE PATENTS-IN-SUIT (Dkt. 103)**

**Hon. Judge Beth Labson Freeman**

## I. INTRODUCTION

Plaintiff Lyft, Inc. (“Lyft”) seeks to stay a case that does not have an operative complaint. Lyft’s motion for leave to file its amended complaint is still pending and thus, Lyft has not alleged non-infringement of U.S. Patent Nos. 8,213,970 (the “’970 Patent”); 7,630,724 (the “’724 Patent”); 7,031,728 (the “’728 Patent”); 10,299,100 (the “’100 Patent”); and 10,341,838 (the “’838 Patent”).

Nonetheless, the circumstances do not warrant a stay because there is no chance that each claim of the patents-in-suit will be either amended or cancelled in any parallel proceeding. No IPR petition has been filed against the ’970 patent, and Lyft is statutorily barred from filing any petitions against the ’970 patent. There is no instituted IPR review against any patent-in-suit. There are no reexamination rejections against any patent-in-suit.

## II. FACTUAL BACKGROUND

On January 29, 2021, Defendant AGIS Software Development LLC (“AGIS Software”) filed a complaint against Lyft alleging infringement of the ’970, ’724, ’728, ’100, and ’838 Patents in the Eastern District of Texas. *AGIS Software Dev. LLC v. Lyft, Inc.*, No. 2:21-cv-00024-JRG, Dkt. 1 (E.D. Tex. Jan. 29, 2021).

On June 16, 2021, Lyft filed a complaint against AGIS Software seeking a declaratory judgment of non-infringement of ’970, ’724, ’728, ’100, and ’838 Patents. *Lyft, Inc. v. AGIS Software Dev. LLC*, No. 5:21-cv-04653-BLF, Dkt. 1 (N.D. Cal. June 16, 2021). AGIS Software filed a motion to dismiss the complaint for declaratory judgment on September 27, 2021 (Dkt. 32) and the Court subsequently granted AGIS Software’s motion to dismiss without prejudice on January 28, 2022. Dkt. 61. Lyft filed a motion for leave to file its first amended complaint on March 28, 2022, which is currently scheduled for a hearing on July 28, 2022. *See* Dkt. 78.

On July 23, 2021, Uber Technologies, Inc. d/b/a Uber (“Uber”) filed three petitions for *inter partes* review (“IPR”) against the ’100 and ’838 Patents. *See Uber Technologies, Inc. d/b/a Uber v. AGIS Software Dev. LLC*, IPR2021-01306, Paper 1 (P.T.A.B. July 23, 2021); *Uber Technologies, Inc. d/b/a Uber v. AGIS Software Dev. LLC*, IPR2022-01307, Paper 1 (P.T.A.B. July 23, 2021); *Uber Technologies, Inc. d/b/a Uber v. AGIS Software Dev. LLC*, IPR2022-01308, Paper 1 (P.T.A.B.

1 July 23, 2021). On March 16, 2022, Uber and AGIS Software filed a joint motion to terminate all  
 2 three IPRs following settlement. *Uber Technologies, Inc. d/b/a Uber v. AGIS Software Dev. LLC*,  
 3 IPR2021-01306, Paper 14 (P.T.A.B. Mar. 16, 2022); *Uber Technologies, Inc. d/b/a Uber v. AGIS*  
 4 *Software Dev. LLC*, IPR2022-01307, Paper 15 (P.T.A.B. Mar. 16, 2022); *Uber Technologies, Inc.*  
 5 *d/b/a Uber v. AGIS Software Dev. LLC*, IPR2022-01308, Paper 16 (P.T.A.B. Mar. 16, 2022). The  
 6 Board terminated the Uber IPRs on March 17, 2022.

7 Uber also filed requests for *ex parte* reexamination on October 22, 2021 against the '724 and  
 8 '728 Patents. See No. 90/014,889; No. 90/014,890. The United States Patent and Trademark Office  
 9 ("PTO") ordered reexamination on December 7, 2021. No rejections have been issued to date in  
 10 either reexamination.

11 Lyft filed its own IPR petitions on January 29, 2022 together with motions to join Uber's  
 12 IPRs. *Lyft, Inc. v. AGIS Software Dev. LLC*, IPR2022-00513, Paper 1 (P.T.A.B. Jan. 29, 2022);  
 13 *Lyft, Inc. v. AGIS Software Dev. LLC*, IPR2022-00514, Paper 1 (P.T.A.B. Jan. 29, 2022); *Lyft, Inc.*  
 14 *v. AGIS Software Dev. LLC*, IPR2022-00515, Paper 1 (P.T.A.B. Jan. 29, 2022). However, the  
 15 joinder motions are now moot in view of the termination of the Uber IPRs. AGIS Software's  
 16 preliminary responses are not due until May 8, 2022, and the PTAB's institution decisions will be  
 17 issued within three months.

### 18 III. LEGAL STANDARDS

19 "Courts have inherent power to manage their dockets and stay proceedings, including the  
 20 authority to order a stay pending conclusion of a PTO reexamination." *Ethicon, Inc. v. Quigg*, 849  
 21 F.2d 1422, 1426-27 (Fed. Cir. 1988). While the case law states several general considerations that  
 22 are helpful in determining whether to order a stay, ultimately the Court must decide stay requests  
 23 on a case-by-case basis. *Comcast Cable Commc'ns Corp., LLC v. Finisar Corp.*, No. 06-cv-04206-  
 24 WHA, 2007 WL 1052883, at \* 1 (N.D. Cal. Apr. 5, 2007) ("From a case management perspective,  
 25 the possible benefits must be weighed in each instance against the possible drawbacks.").

26 In determining whether to stay a case pending reexamination, courts consider the following  
 27 factors: (1) the stage and history of the litigation; (2) whether a stay would simplify the issues in  
 28

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1 question and trial of the case; and (3) whether a stay would unduly prejudice or present a clear  
 2 tactical disadvantage to the non-moving party. *TPK Touch Sols., Inc v. Wintek Electro-Optics Corp.*,  
 3 No. 13-CV-02218-JST, 2013 WL 6021324, at \*2 (N.D. Cal. Nov. 13, 2013). Courts traditionally  
 4 consider three main factors in determining whether to stay a case pending the conclusion  
 5 of IPR proceedings: “(1) whether discovery is complete and whether a trial date has been set; (2)  
 6 whether a stay will simplify the issues in question and trial of the case; and (3) whether a stay would  
 7 unduly prejudice or present a clear tactical disadvantage to the non-moving party.” *Telemac Corp.*  
 8 *v. Teledigital, Inc.*, 450 F.Supp.2d 1107, 1111 (N.D. Cal. 2006) (citation omitted); *see also Robert*  
 9 *Bosch Healthcare Sys., Inc. v. Cardiocom, LLC*, No. C–14–1575 EMC, 2014 WL 3107447, at \*3  
 10 (N.D. Cal. July 3, 2014). “The party seeking the stay bears the burden of persuading the court that  
 11 a stay is appropriate.” *Evolutionary Intelligence*, 2014 WL 2738501, at \*3 (citing *Nken v.*  
 12 *Holder*, 556 U.S. 418, 433–34 (2009)).

#### 13 **IV. ARGUMENT**

##### 14 **A. Simplification of the Issues and Trial of the Case Do Not Favor a Stay**

15 This factor addresses whether and to what degree a stay will simplify the litigation.  
 16 *PersonalWeb Techs., LLC v. Facebook, Inc.*, No. 5:13-cv-01356-EJD, 2014 WL 116340, at \*4 (N.D.  
 17 Cal. Jan. 13, 2014). This factor does not favor a stay because at least one of the patents-in-suit are  
 18 not subject to review at the USPTO. There is no IPR or reexamination challenge to the '970 patent.  
 19 For the remaining patents-in-suit, the IPRs sought for the '838 and '100 patents have not been  
 20 instituted, and whether the PTAB will institute the IPR proceedings is based on Lyft's pure  
 21 speculation. *Skillz Platform Inc. v. Aviagames Inc.*, 2022 WL 1189882, at \*3 (N.D. Cal. Apr. 21,  
 22 2022) (“The Court finds that simplification from the IPRs is purely speculative at this stage.”). Lyft  
 23 concedes that the PTAB has not instituted review on the three IPRs which address only a subset of  
 24 the patents-in-suit, the '838 and '100 Patents. Dkt. 103 at 5-6. Similarly, there have been no  
 25 rejections in the reexaminations requested for the '724 and '728 patents.

26 Lyft waited to file its IPR petitions exactly one year after receipt of a complaint.  
 27 Accordingly, AGIS Software's response has yet to be filed, review has not yet been instituted, and  
 28

1 the institution decision will not come for several months. *See GoPro, Inc. v. C&A Marketing, Inc.*,  
2 2017 WL 2591268, at \*4 (N.D. Cal. June 15, 2017) (“With respect to this factor, the Court finds  
3 most relevant the fact that C&A’s petition was filed shortly before its motion, review has not yet  
4 been instituted, and the institution decision will not come for several months.”). This Court has held  
5 that “the filing of an IPR request by itself does not simplify the issues in question and trial of the  
6 case. Ultimately, the PTO may not institute IPR proceedings.” *TPK*, 2013 WL 6021324, at \*4. Lyft  
7 argues that *if* IPR is granted, it would increase the likelihood of simplification, but “this argument  
8 is largely undercut by the reality that IPR has not yet been instituted.” *SAGE Electrochromics, Inc.*  
9 *v. View, Inc.*, 2015 WL 66415, at \*2 (N.D. Cal. Jan. 5, 2015). Lyft’s reliance on cases which granted  
10 pre-institution stays is unpersuasive. *See Skillz*, 2022 WL 1189882, at \*4 (“AviaGames’ lengthy  
11 list of pre-institution stays is unpersuasive. Some courts in this district favor pre-institution stays  
12 while others do not.”). Because there is no review of the ’970 patent and because there is no chance  
13 that each claim of the patents-in-suit will be either amended or cancelled in any parallel proceeding,  
14 the instant request should be denied.

15 While Lyft alleges that the Court’s current schedule is unfeasible, it has not moved this Court  
16 for a continuance of any dates and this Court’s Case Management Order sets forth a date for the  
17 claim construction hearing on September 1, 2022. *See* Dkt. 59. Further, the parties submitted a  
18 *joint* stipulated scheduling order that requires parties engage in claim construction proceedings prior  
19 to issuance of the PTAB’s institution decision. *See* Dkt. 69. While Lyft alleges that a stay would  
20 “simultaneously conserve resources by avoiding depositions and other work which may be rendered  
21 moot,” likewise, if the Court granted a stay and the IPRs were not instituted, “the parties would have  
22 to engage in discovery in approximately half the amount of time they have currently.” *Skillz*, 2022  
23 WL 1189882, at \*4 (“In light of that risk, the Court is not convinced that discovery considerations  
24 indicate simplification at this stage.”).

25 Further, while there is a possibility that an IPR or EPR proceeding may simplify the issues  
26 in a case, an EPR is less likely to simplify the case than an IPR “because the *ex parte* reexamination  
27 lacks the estoppel benefits of IPR.” *TPK*, 2013 WL 6021324, at \*3. The PTO grants 92.2% of  
28

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