

1
2
3
4 UNITED STATES DISTRICT COURT
5 NORTHERN DISTRICT OF CALIFORNIA
6

7 LYFT, INC.,

8 Plaintiff,

9 v.

10 AGIS SOFTWARE DEVELOPMENT LLC,

11 Defendant.

Case No. 21-cv-04653-BLF (SVK)

**ORDER RE MOTION TO COMPEL
DISCOVERY AND COMPLIANCE
WITH LOCAL PATENT RULES**

Re: Dkt. Nos. 88, 106, 122, 123, 124

12 Before the Court is Plaintiff Lyft Inc.'s ("Lyft") Motion to Compel Discovery and
13 Compliance with Local Patent Rules [Dkt. 88] and Defendant AGIS Software Development
14 LLC's ("AGIS Software") opposition [Dkt. 106]. Plaintiff's motion springs from Judge
15 Freeman's Order Granting Motion to Dismiss for Lack of Personal Jurisdiction with Leave to
16 Amend; Granting Jurisdictional Discovery, in which Plaintiff was granted leave to take
17 jurisdictional discovery consisting of five interrogatories and one four-hour 30(b)(6) deposition.
18 Dkt. 61. The undersigned held a hearing on April 29, 2022 and determined that further briefing
19 was required. Dkt. 116. After considering the briefing in this case, including the requested
20 supplemental briefing, the relevant law, and the arguments of counsel, for the reasons set forth
21 below, the Court **GRANTS IN PART AND DENIES IN PART** Lyft's motion.

22 **I. PROCEDURAL HISTORY**

23 The Court recounts only the background relevant to the resolution of this motion. AGIS
24 Software filed a patent infringement suit against, *inter alia*, Lyft in the Eastern District of Texas
25 on January 29, 2021 (the "Texas Action"). Dkt. 1 at ¶ 4. Roughly a year later, Judge Gilstrap
26 dismissed Lyft from the Texas Action. *See AGIS Software Dev. LLC v. T-Mobile USA, Inc.*, No.
27 21-00072, ECF No. 212 (E.D. Tex. Jan. 19, 2022). While the Texas Action was still pending, Lyft
28 went on the offensive and filed suit against AGIS Software in this Court for declaratory judgment

1 of noninfringement of the same patents asserted against it in the Texas Action. Dkt. 1. Lyft did
2 not name AGIS, Inc. or AGIS Holding, Inc. in its complaint. *See id.* AGIS Software moved to
3 dismiss the action under Federal Rule of Civil Procedure 12(b)(2) for lack of personal jurisdiction.
4 Dkt. 32. Lyft opposed arguing, in part, that AGIS, Inc. and AGIS Holding, Inc. are alter egos of
5 AGIS Software. Dkt. 41.

6 Judge Freeman granted the motion but, at Lyft’s request, permitted Lyft to take limited
7 jurisdictional discovery. Dkt. 61. Judge Freeman found that although Lyft had failed to allege
8 sufficient facts to establish personal jurisdiction over AGIS Software, Lyft had shown at least a
9 “colorable” basis for personal jurisdiction under the Federal Circuit’s recent decision in *Trimble*
10 *Inc. v. PerDiemCo LLC*, 997 F.3d 1147 (Fed. Cir. 2021), entitling Lyft to jurisdictional discovery.
11 Lyft argues that AGIS Software has sued multiple California Companies in the Texas Action and,
12 consequently, AGIS Software’s patent licensing and negotiating activities with those California
13 Companies is sufficient for specific jurisdiction under *Trimble*.

14 The *Trimble* court underscored that the personal jurisdiction analysis in patent cases is no
15 different than the analysis in non-patent cases. 997 F.3d at 1154. It then concluded that
16 defendant’s exchanging 22 communications with the California plaintiff over three months was
17 sufficient to satisfy the minimum contacts test in that action. *Id.* at 1156-57; *see also Apple Inc. v.*
18 *Zipit Wireless, Inc.*, 30 F.4th 1368, 1376 (Fed. Cir. 2022) (finding defendant had requisite
19 minimum contacts with California based on communications regarding alleged infringement and
20 potential licensing). Here, Lyft seeks to show that AGIS Software’s communications with
21 California Companies AGIS Software has sued in the Texas Action are sufficiently extensive to
22 meet the purposeful direction prong of the specific jurisdiction test in this suit.

23 As authorized, Lyft propounded five jurisdictional interrogatories on AGIS Software, only
24 one of which is at issue: “Identify all interactions, including Communications, between AGIS
25 Software, AGIS Holdings, and/or AGIS, Inc. and any Person, company, or entity located, based,
26 or incorporated in California from 2015 to the present” Dkt. 88-11 (“Jurisdictional
27 Interrogatories”). The dispute before the undersigned concerns the scope of the Jurisdictional
28 Interrogatories Judge Freeman’s order allowed and the adequacy of AGIS Software’s production

1 to date under Patent L.R. 3-2. Both of these disputes turn on the question of whether AGIS
2 Software has custody and control over AGIS Inc. documents.¹

3 The Parties appeared before the undersigned for a hearing on April 29, 2022, during which
4 it became clear that additional briefing was needed on issues of custody and control as between
5 AGIS Software and AGIS Inc. as well as the appropriate time frame for evaluation of personal
6 jurisdiction. Dkt. 117. The Court ordered AGIS Software to elucidate the circumstances under
7 which AGIS Software produced AGIS, Inc. documents in the Texas Action. *Id.* AGIS Software
8 later advised the Court through an *ex parte* communication that its production of AGIS Inc.
9 documents in the Texas Action had been voluntary. AGIS Software did not file further briefing on
10 this issue. In response, Lyft filed a brief, with evidentiary support, that under the Northern District
11 of California's Local Patent Rule 3-2 and in response to Jurisdictional Interrogatory No. 1, AGIS
12 Software must produce more than just the AGIS, Inc. documents already produced in the Texas
13 Action. Dkt. 123. The Court also ordered both Parties to file briefs regarding the appropriate time
14 frame for which AGIS Software would be obligated to produce documents regarding its
15 communications with the California Companies involved in the Texas Action. Dkt. 117. The
16 Parties accordingly briefed this issue as well. Dkts. 122, 124.

17 The Court's rulings are set forth below.

18 **II. LYFT'S MOTION TO COMPEL A MORE COMPLETE PRODUCTION UNDER
PATENT LOCAL RULE 3-2: DENIED.**

19 As set forth above, Lyft's complaint against AGIS Software has been dismissed, pending
20 amendment to demonstrate that AGIS Software is subject to this Court's jurisdiction. Accordingly,
21 Lyft's request for additional documentation pursuant to Patent L. R. 3-2 is not proper at this
22 juncture and is therefore **DENIED**. The issue of custody and control is addressed more fully in
23 section III, below.

24 **III. LYFT'S MOTION TO COMPEL MORE COMPLETE RESPONSES FROM AGIS
SOFTWARE TO JURISDICTIONAL INTERROGATORY NO. 1 REGARDING
25 AGIS SOFTWARE'S INTERACTIONS: GRANTED.**

26 As the Court indicated at the hearing, identification of interactions, including
27

28 ¹ At the hearing, Lyft argued AGIS Software's custody and control over both AGIS Inc. and AGIS

1 communications, between AGIS Software and any person or entity located in California is
 2 relevant to determining whether AGIS Software is subject to the Court's jurisdiction. *See*
 3 *Trimble*, 997 F.3d at 1156-57; *Apple*, 30 F.4th at 1376. The only question is the proper time frame
 4 for production. Upon further review of the Parties' supplemental position statements and relevant
 5 legal authority, **the Court ORDERS the identification of interactions, including**
 6 **communications, between AGIS Software and any person or entity located in California**
 7 **from the period January 2015 to present.** The Court notes AGIS Software's argument that the
 8 earliest date should be the date of its formation, June 2017. Although the company was officially
 9 formed as of that date, it is conceivable that it was interacting with third parties prior to that date.²
 10 The Parties also dispute the appropriate end date for identification of interactions, whether it
 11 should be the date of AGIS Software suing Lyft in the Texas Action, the date of the Complaint in
 12 this action or beyond. The Court will adopt Lyft's time frame from January 2015 to present, and
 13 the Parties can argue the relevance of interactions after the disputed dates in their respective briefs
 14 addressing jurisdiction.

15 **IV. LYFT'S MOTION TO COMPEL MORE COMPLETE RESPONSES FROM AGIS**
 16 **SOFTWARE TO JURISDICTIONAL INTERROGATORY NO. 1 REGARDING**
 17 **INTERACTIONS OF AGIS, INC. OR AGIS HOLDINGS IN CALIFORNIA:**
 18 **GRANTED.**

19 In granting AGIS Software's motion to dismiss, Judge Freeman limited the mechanisms of
 20 discovery to those proposed by Lyft: five interrogatories and one 30(b)6 deposition. As the
 21 undersigned indicated at the hearing, although the scope of Judge Freeman's order does not
 22 facially provide for third-party discovery, the resolution of this dispute turns on whether AGIS
 23 Software has possession, custody or control of AGIS, Inc.'s documents for purposes of Federal
 24 Rule of Civil Procedure 34. *See* Dkt. 125 at 27:1-5. Under Rule 34, "control" has been
 25 "construed broadly by the courts as the legal right, authority, or practical ability to obtain the
 26 materials sought on demand." *Stella Sys., LLC v Medeanalytics, Inc.*, No. 14-880, 2015 WL
 27 1870052, at *3 (N.D. Cal. Apr. 22, 2015) (quoting *Steele v. Software Sys. Corp. v. DataQuick*

28 ² In its Complaint. Lyft states that public records reveal that AGIS Software sued Apple Inc. in

1 *Info. Sys., Inc.*, 237 F.R.D. 561, 564 (D. Md. 2006)). “Common relationships between a party and
2 its related nonparty entity are particularly important to the determination of control. Critical
3 factors here include the ownership of the nonparty, any overlap of directors, officers, and
4 employees, and the financial relationship between the two entities.” *Id.* In response to further
5 production pursuant to Patent L.R. 3-2, above, Lyft makes a strong showing of AGIS Software’s
6 control over AGIS Inc.’s documents based upon numerous voluntary productions in the Texas
7 Action. First, Lyft asserts, and AGIS Software does not deny, that AGIS Software and AGIS, Inc.
8 have the same CEO, Malcolm K. Beyer, Jr. Dkts. 89-3 at 2, 5; 124; 125 at 29:8-11.

9 Second, Lyft points to specific, voluntary productions of AGIS Inc. documents by AGIS
10 Software in the Texas Action. For example, AGIS Software produced AGIS, Inc. documents in
11 the Texas Action months *before* Lyft served a subpoena on AGIS, Inc. Dkt. 123-4 at 1. This
12 included making AGIS, Inc.’s source code available for inspection. Dkts. 123-10, 123-4 at 1-2.
13 Further, in response to the subpoena Lyft eventually served in the Texas Action, AGIS, Inc.’s
14 objections and responses acknowledged that AGIS Software already had produced AGIS, Inc.
15 documents in that action. Dkt. 123-7 at 6.

16 The Court finds this evidence indicative of “custody and control” over AGIS Inc.
17 documents. Significantly, in stating its position regarding production of documents in the Texas
18 Action, AGIS Software is utterly silent on the issue of control. Dkt. 124. Accordingly, in light of
19 AGIS Software’s demonstrated control over AGIS Inc. documents in the Texas Action, **AGIS
20 Software is ORDERED to identify interactions, including communications, between AGIS,
21 Inc. and any person or entity located in California for the period from January 2015 to the
22 present.**

23 **SO ORDERED.**

24 Dated: May 9, 2022

25
26 
27 _____
SUSAN VAN KEULEN
United States Magistrate Judge