

BAKER BOTTS L.L.P.
Jeremy J. Taylor (SBN 249075)
jeremy.taylor@bakerbotts.com
Arya Moshiri (SBN 324231)
arya.moshiri@bakerbotts.com
101 California St., Ste. 3600
San Francisco, CA 94111
Telephone: 415.291.6200
Facsimile: 415.291.6300

Kurt M. Pankratz (*pro hac vice*)
kurt.pankratz@bakerbotts.com
Bethany R. Salpietra (*pro hac vice*)
bethany.salpietra@bakerbotts.com
2001 Ross Ave., Ste. 900
Dallas, TX 75201
Telephone: 214.953.6500
Facsimile: 214.953.6503

Attorneys for Plaintiff Lyft, Inc.

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

*Attorneys for Defendant/Counterclaim
Plaintiff AGIS Software Development LLC*

Additional counsel listed on signature page

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

LYFT, INC.

Plaintiff,

v.

AGIS SOFTWARE DEVELOPMENT LLC,

Defendant.

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

PARTIES' JOINT STATUS UPDATE

Judge: Hon. Beth Labson Freeman
Courtroom: 3, Fifth Floor

Pursuant to the Court’s May 19, 2022 Order staying this action pending disposition of the *ex parte* reexaminations (“EPR”) before the United State Patent and Trademark Office (“USPTO”) and the *inter partes* review (“IPR”) proceedings before the Patent Trial and Appeals Board, and the Court’s November 14, 2023 Order directing a further status update 180 days from the date of that order, Plaintiff Lyft, Inc. (“Lyft”) and Defendant AGIS Software Development LLC (“AGIS”) (collectively, the “Parties”) submit this Joint Status Report regarding the status of the EPRs concerning U.S. Patent Nos. 7,031,728 (the “728 Patent”), 7,630,724 (the “724 Patent”), and

1 8,213,970 (the “’970 Patent”), and the IPR proceedings relating to U.S. Patent Nos. 10,299,100 (the
2 “’100 Patent”) and 10,341,838 (the “’838 Patent”).

- 3 • The EPR concerning the ’728 Patent (Serial No. 90/014,890) is concluded with no
4 amendments or cancellations to any challenged claims. A Reexamination Certificate
5 issued on April 18, 2023.
- 6 • The EPR concerning the ’724 Patent (Serial No. 90/014,889) is currently pending,
7 awaiting a Reply Brief from AGIS to the USPTO’s Examiner’s Answer. The
8 USPTO issued an Order Granting *Ex Parte* Reexamination on December 7, 2021
9 and, subsequently, issued a Non-Final Office Action on July 7, 2022, rejecting
10 asserted claims 9 and 12-16 under 35 U.S.C. § 103.¹ On November 7, 2022, AGIS
11 filed its Response to the July 7, 2022 Non-Final Office Action, which included
12 amendments to asserted independent claims 9 and 16 and added new dependent
13 claims 17-18, in addition to remarks. The USPTO subsequently issued a Final Office
14 Action on December 22, 2022, rejecting asserted claims 9 and 12-16 under 35 U.S.C.
15 § 112 and 35 U.S.C. § 103.² Claims 16 and 18 were further rejected under 35 U.S.C.
16 § 305 as enlarging the scope of the claims being reexamined. On April 24, 2023,
17 AGIS filed its Response to the December 22, 2022 Final Office Action, which
18 included amendments to asserted independent claims 9 and 16, in addition to
19 remarks. On May 3, 2023, the USPTO issued an Advisory Action stating that
20 AGIS’s proposed amendments from its April 24, 2023 Response would not be
21 entered. On June 20, 2023, AGIS filed a Supplemental Response, cancelling
22 dependent claims 17 and 18 in response to the May 3, 2023 Advisory Action stating
23 they raised new issues. On June 22, 2023, AGIS filed a Notice of Appeal. On June
24 29, 2023, the USPTO issued an Advisory Action indicating that AGIS overcame
25 some of the rejections but that claims 9-10 and 12-16 remain rejected under 35 U.S.C.
26 § 112 and 35 U.S.C. § 103. On August 14, 2023, AGIS submitted a petition for a
27

28 ¹ The Non-Final Office Action dated December 7, 2021 also rejects unasserted claim 10.

² The Final Office Action dated December 22, 2022 also rejects unasserted claim 10 and newly added claims 17-18.

1 two-month extension of time to file an Appeal Brief associated with the Notice of
2 Appeal. On August 15, 2023, the USPTO granted AGIS's request to extend the time
3 to file the Appeal Brief. On October 23, 2023, AGIS filed its Appeal Brief. On
4 March 25, 2024, the USPTO issued an Examiner's Answer to AGIS's Appeal Brief.
5 On May 6, 2024, AGIS submitted a petition for a one-month extension of time to file
6 a Reply Brief in response to the Examiner's Answer. On May 7, 2024, the USPTO
7 granted AGIS's request to extend the time to file the Reply Brief.

- 8 • The IPR petitions filed by Lyft challenging the '100 Patent (IPR2022-00514;
9 IPR2022-00515) were both instituted on June 2, 2022. On May 25, 2023, the PTAB
10 issued a Final Written Decision, ordering that all claims of the '100 Patent are
11 unpatentable. On July 27, 2023 (CAFC-23-2237), AGIS filed a Notice of Appeal of
12 the Final Written Decision. On August 24, 2023, the Federal Circuit ordered that the
13 appeals for the IPRs involving the '100 and '838 Patents be consolidated. On January
14 12, 2024, AGIS filed its Appellant's Brief. On May 6, 2024, Lyft filed its Appellee's
15 Brief. AGIS's reply brief is currently due May 27, 2024.
- 16 • The IPR petition filed by Lyft challenging the '838 Patent (IPR2022-00513) was
17 instituted on June 2, 2022. On May 25, 2023, the PTAB issued a Final Written
18 Decision, ordering that all claims of the '838 Patent are unpatentable. On July 27,
19 2023 (CAFC-23-2237), AGIS filed a Notice of Appeal of the Final Written Decision.
20 On August 24, 2023, the Federal Circuit ordered that the appeals for the IPRs
21 involving the '100 and '838 Patents be consolidated. On January 12, 2024, AGIS
22 filed its Appellant's Brief. On May 6, 2024, Lyft filed its Appellee's Brief. AGIS's
23 reply brief is currently due May 27, 2024.
- 24 • The "'970 Patent" is not subject to any EPRs or IPR proceedings.
- 25 • The EPR concerning the '970 Patent (Serial No. 90/014,507) is concluded with
26 amendments to the challenged claims. A Reexamination Certificate issued on
27 December 12, 2021.

28

1 Dated: May 13, 2024

Respectfully submitted,

2 /s/ Vincent J. Rubino

By: /s/ Jeremy J. Taylor

3 Vincent J. Rubino, III

Jeremy J. Taylor

4 Alfred R. Fabricant (pro hac vice)
afabricant@fabricantllp.com
5 Peter Lambrianakos (pro hac vice)
plambrianakos@fabricantllp.com
6 Vincent J. Rubino, III (pro hac vice)
vrubino@fabricantllp.com

Jeremy J. Taylor (SBN 249075)
Arya Moshiri (SBN 324231)
jeremy.taylor@bakerbotts.com
arya.moshiri@bakerbotts.com
BAKER BOTTS L.L.P.
101 California St., Ste. 3600
San Francisco, CA 94111
Telephone: 415.291.6200
Facsimile: 415.291.6300

7 Enrique Iturralde (pro hac vice)
8 eiturralde@fabricantllp.com

Kurt M. Pankratz (*pro hac vice*)
kurt.pankratz@bakerbotts.com
Bethany R. Salpietra (*pro hac vice*)
bethany.salpietra@bakerbotts.com
BAKER BOTTS L.L.P.
2001 Ross Ave., Ste. 900
Dallas, TX 75201
Telephone: 214.953.6500
Facsimile: 214.953.6503

FABRICANT LLP

9 411 Theodore Fremd Road, Suite 206
10 South Rye, New York 10580
Telephone: (212) 257-5797
11 Facsimile: (212) 257-5796

12 Benjamin T. Wang (CA SBN 228712)
bwang@raklaw.com

13 Minna Y. Chan (CA SBN 305941)
mchan@raklaw.com

RUSS AUGUST & KABAT

14 12424 Wilshire Boulevard, 12th Floor
15 Los Angeles, California 90025
16 Telephone: (310) 826-7474
17 Facsimile (310) 826-9226

Attorneys for Plaintiff Lyft, Inc.

18 *Attorneys for Defendant/Counterclaim*
19 *Plaintiff AGIS Software Development LLC*

20 **ATTESTATION OF CONCURRENCE IN FILING**

21 Pursuant to Northern District of California Local Rule 5-1(i)(3), I attest that concurrence in
22 the filing of this document has been obtained from the other Signatories to this document.

23
24 By: /s/ Jeremy J. Taylor

25
26
27
28
Jeremy J. Taylor