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**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
(San Jose Division)**

LYFT, INC.,  
  
  Plaintiff,  
  
  v.  
  
AGIS SOFTWARE DEVELOPMENT LLC,  
  
  Defendant.

Case No. 5:21-cv-04653-BLF  
  
**JOINT CASE MANAGEMENT  
CONFERENCE STATEMENT**  
  
Date: January 27, 2022  
Time: 11:00 a.m.  
Dept: Courtroom 3 – 5th Floor  
Judge: The Honorable Beth Labson Freeman

1 Plaintiff Lyft, Inc. (“Lyft”) and Defendant AGIS Software Development, LLC (“AGIS”)  
2 submit this Joint Case Management Conference Statement pursuant to Rule 26(f) of the Federal  
3 Rules of Civil Procedure, Civil Local Rule 16-9, Patent Local Rule 2-1, the Standing Order for all  
4 Judges of the Northern District of California titled “Contents of Joint Case Management Statement,”  
5 and the Clerk’s Notice Setting Case Management Conference, (Dkt. No. 33), in advance of the Case  
6 Management Conference scheduled for January 27, 2022.

7 **1. JURISDICTION AND SERVICE**

8 This Court has subject matter jurisdiction under 28 U.S.C. §§ 2201, 2202, 1331, and 1338(a),  
9 because this action arises under the laws of the United States, and in particular the Patent Act of  
10 the United States, 35 U.S.C. § 100 *et seq.*, and seeks relief under the Federal Declaratory Judgment  
11 Act.

12 On September 27, 2021, AGIS moved the Court for: (1) an order dismissing the Complaint  
13 for Declaratory Judgment filed by Plaintiff pursuant to Rule 12(b)(2) of the Federal Rules of Civil  
14 Procedure; (2) an order dismissing the Complaint for Declaratory Judgment in favor of the first-  
15 filed action; or (3) in the alternative, an order staying this action pending a decision on Lyft’s  
16 motion to dismiss, or in the alternative, to transfer to the Eastern District of Texas. Dkt. 32. This  
17 Motion has been fully briefed and will be heard by the Court on January 27, 2022. Lyft intends to  
18 file an amended complaint adding AGIS’s affiliate, Advanced Ground Information Systems, Inc.  
19 (“AGIS, Inc.”), as a defendant to the instant lawsuit and alter ego to AGIS, and adding additional  
20 allegations to support its contention that this Court has personal jurisdiction over AGIS and AGIS,  
21 Inc. AGIS has not agreed to allow protected information obtained during discovery in the EDTX  
22 Action and subject to the protective order in the EDTX Action to be used in the amended pleading.  
23 If an agreement cannot be reached to include the protected information in Lyft’s amended  
24 complaint, Lyft intends to seek formal discovery from AGIS in this action and then seek leave to  
25 amend its complaint. AGIS submits that AGIS, Inc. is a separate and distinct entity and is not the  
26 assignee or owner of any of the Patents-in-Suit, and AGIS intends to file a motion to dismiss the  
27 amended complaint.

28 AGIS filed a motion to transfer to the United States District Court for the Eastern District of

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1 Texas pursuant to 28 U.S.C. § 1404(a), on October 5, 2022, asserting that this action should be  
2 transferred to the first-filed Court for convenience. Dkt. 34.<sup>1</sup> This issue has been fully briefed and  
3 will be heard by the Court on January 27, 2022.

4 AGIS does not contest service.

## 5 **2. FACTS**

### 6 **a. Lyft's Statement**

7 Lyft, which is headquartered in San Francisco, California, is one of the largest multimodal  
8 platforms in the United States and Canada that provides a marketplace that allows independent  
9 drivers to provide rideshare services to people requesting transportation. Since 2012 it has provided  
10 a marketplace that can help people access transportation and continues to pioneer innovations  
11 aligned with its mission to improve people's lives with the world's best transportation. Prior to Lyft  
12 filing this declaratory judgment action, AGIS alleged that Lyft infringed U.S. Patent Nos. 7,031,728;  
13 7,630,724; 8,213,970; 10,299,100; and 10,341,838 (collectively, the "Patents-in-Suit"). Lyft denies  
14 AGIS's allegations that it has infringed any claim of any of the Patents-in-Suit and seeks a  
15 declaratory judgment of non-infringement.

16 Because substantial discovery already occurred in the dismissed EDTX Action, Lyft  
17 proposes limiting discovery allowed in this case and allowing discovery obtained in the EDTX  
18 Action to be used in the present case. In addition, because there are Patent Office proceedings  
19 involving four of the five asserted patents pending which have the potential of substantially  
20 impacting the present case, Lyft proposes delaying entry of a formal schedule and/or staying this  
21 case until the Patent Office proceedings resolve.

### 22 **b. AGIS's Statement**

23 On June 16, 2021, Lyft filed this action seeking declaratory judgment of noninfringement as  
24 to the Patents-in-Suit. *See* Dkt. 1. On September 27, 2021, AGIS moved the Court, for: (1) an order  
25 dismissing the Complaint for Declaratory Judgment filed by Plaintiff pursuant to Rule 12(b)(2) of

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26 <sup>1</sup> On January 19, 2022, Judge Gilstrap issued a ruling adopting Magistrate Judge Payne's report and  
27 recommendation granting Lyft's Motion to Dismiss the EDTX Action for improper venue. *See*  
28

1 the Federal Rules of Civil Procedure; (2) an order dismissing the Complaint for Declaratory  
2 Judgment in favor of the first-filed action; or (3) in the alternative, an order staying this action  
3 pending a decision on Lyft’s motion to dismiss, or in the alternative, to transfer, which is currently  
4 pending in the Eastern District of Texas. Dkt. 32. On October 5, 2021, AGIS moved the Court for  
5 an order to transfer this case to the Eastern District of Texas Pursuant to 28 U.S.C. §1404(a). Dkt.  
6 34. The Complaint is deficient on the grounds that this Court lacks personal jurisdiction over AGIS  
7 Software because AGIS Software is not “at home” in California, and it has not purposefully directed  
8 activities related to the enforcement or defense of the Patents-in-Suit at California sufficient to justify  
9 the exercise of personal jurisdiction over AGIS Software in California in accordance with Due  
10 Process. To the extent Lyft files its intended amended complaint, AGIS submits that AGIS, Inc. is a  
11 separate and distinct entity and is not the assignee or owner of any of the Patents-in-Suit, and AGIS  
12 intends to file a motion to dismiss the amended complaint. If the Court denies each of AGIS’s  
13 motion to dismiss (Dkt. 32), AGIS’s motion to transfer under 28 U.S.C. § 1404(a) (Dkt. 34), and  
14 AGIS’s forthcoming motion to dismiss the forthcoming amended complaint, AGIS Software expects  
15 to file an answer.

16 Malcolm K. “Cap” Beyer, Jr., the CEO of AGIS Software and a named inventor of the  
17 Patents-in-Suit, is a graduate of the United States Naval Academy and a former U.S. Marine. Mr.  
18 Beyer founded Advanced Ground Information Systems, Inc. (“AGIS, Inc.”) shortly after the  
19 September 11, 2001 terrorist attacks because he believed that many first responder and civilian lives  
20 could have been saved through the implementation of a better communication system. He  
21 envisioned and developed a new communication system that would use integrated software and  
22 hardware components on mobile devices to give users situational awareness superior to systems  
23 provided by conventional military and first responder radio systems. AGIS, Inc. developed  
24 prototypes that matured into its LifeRing system, which provides first responders, law enforcement,  
25 and military personnel with what is essentially a tactical operations center build into hand-held  
26 mobile devices. LifeRing applications and services provide the functionalities so that users can form  
27 and/or join networks or groups, share and view locations with other users, display symbols  
28 corresponding to locations (including locations of other users) on a map, and communicate with

1 other users via text, voice, and multimedia-based communication. LifeRing users can also display  
2 map information, including symbols corresponding with users, entities, and locations, and form  
3 groups to track other users and communicate with other users, including through text messages and  
4 voice calls. The claimed inventions of the Patents-in-Suit are directed to these features.

5 In this action, Lyft does not contend that the Patents-in-Suit are invalid under 35 U.S.C. 101,  
6 102, 103, and 112. At this time, AGIS does not agree to permit Lyft to use protected information  
7 obtained during discovery in the EDTX Action and subject to the protective order in the EDTX  
8 Action, where that protective order specifically states: “Documents, information or material  
9 produced in this Action, including but not limited to Protected Material designated as  
10 DESIGNATED MATERIAL, shall be used by the Parties only in the litigation of this Action and  
11 shall not be used for any other purpose.” EDTX Action, Dkt. 96 at 8.

### 12 13 **3. LEGAL ISSUES**

14 The parties currently believe that the principal disputed legal issues are:

- 15 • Whether personal jurisdiction exists over AGIS;
- 16 • Whether this case should be transferred to the Eastern District of Texas for  
17 convenience;
- 18 • Whether Lyft has infringed the Patents-in-Suit;
- 19 • Whether AGIS is barred from construing certain of the asserted claims of the Patents-  
20 in-Suit in particular ways due to prosecution history estoppel and/or disclaimer (in  
21 defense of a counterclaim of infringement);
- 22 • Whether AGIS is barred by the doctrines of express or implied license, covenant not  
23 to sue, and/or exhaustion to the extent AGIS has granted rights to any of the Patents-  
24 in-Suit that extend to the Accused Products (in defense of a counterclaim of  
25 infringement); Whether any damages awarded may be limited under 35 U.S.C. §§  
26 271, 286, 287, and/or 288 (in defense of a counterclaim of infringement);
- 27 • Whether any claims for relief against Lyft for alleged infringement are barred by the  
28 doctrine of waiver, acquiescence, unclean hands, and/or estoppel (in defense of a

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