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

LYFT, INC.

Plaintiff,

v.

AGIS SOFTWARE DEVELOPMENT LLC,

Defendant.

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

**PLAINTIFF LYFT, INC.’S MOTION TO
COMPEL DISCOVERY AND
COMPLIANCE WITH LOCAL PATENT
RULES**

Judge: Hon. Beth Labson Freeman
Trial Date: October 16, 2023
Courtroom: 3, Fifth Floor

MEMORANDUM OF POINTS AND AUTHORITIES

1
2 AGIS Software Development LLC's ("AGIS Software") Patent L.R. 3-2 deadline passed on
3 February 25, 2022 without the production of certain required categories of documents, including
4 patent licenses, conception and reduction to practice materials, and documents evidencing third-
5 party disclosures of the alleged invention. AGIS Software has provided no reason for withholding
6 these materials and continues to refuse to produce them. Likewise, AGIS Software has failed to
7 provide full and accurate responses to Lyft, Inc.'s ("Lyft") discovery served pursuant to this Court's
8 Order (Dkt. 61), which expressly permitted discovery regarding "AGIS Software's patent
9 enforcement communications with California companies" after finding that Lyft had established "a
10 'colorable' basis for personal jurisdiction" under *Trimble v. PerDiemCo LLC*, 997 F.3d 1147 (9th
11 Cir. 2021)). And, despite the Court's further explicit grant of discovery into "the relationship
12 between AGIS Software, AGIS, Inc., and AGIS Holdings and their contacts with California," the
13 AGIS affiliates have refused to provide any information responsive to discovery about AGIS
14 Holdings or AGIS, Inc. because they were not named in the original complaint and because Lyft
15 had not yet filed an amended complaint, even though this is precisely *why* the Court ordered
16 discovery. Dkt. 61 at 9-10; *see also* Exs. 11-14. Lyft therefore seeks court intervention to compel
17 AGIS Software to comply with its obligations set forth under the Patent Local Rules and Dkt. 61.

18 As a result of AGIS Software's failure to fulfill its obligations under the Patent Local Rules
19 and the Court's order, Lyft has been forced to unnecessarily repeat discovery previously taken in
20 the EDTX Action¹ and file this motion to compel the production of relevant information that is
21 readily accessible to AGIS Software, much of which was likely produced in the EDTX Action, and
22 that AGIS Software is under independent obligation to produce in this case. AGIS Software's
23 refusal to comply with its discovery obligations and the requirements of the Patent L.R. 3-2
24 prejudices Lyft's ability to prepare its amended complaint and prepare defenses, and jeopardizes the
25 current case schedule, which was set with deadlines shorter than those provided under the Patent
26 Local Rules based on AGIS Software's assurances of a smooth discovery process that was "virtually

27 _____
28 ¹ *AGIS Software Development LLC v. Lyft, Inc.*, 2:21-cv-00024-JRG (E.D. Tex.) (later consolidated
with 2:21-cv-00072-JRG (E.D. Tex.))

1 complete” due to the advanced stages of the EDTX Action. CMC Hearing Tr. at 49:19-50:2. AGIS
2 Software’s withholding of this discovery calls into question AGIS Software’s assurance that the
3 parties would be able to work through discovery disputes “very quickly.” *Id.* at 35:4-5.

4 **A. AGIS Software’s Deficient Patent L.R. 3-2 Production**

5 Patent L.R. 3-2 requires the production of numerous categories of documents, including
6 “[a]ll agreements, including licenses, transferring an interest in any patent-in-suit” (Patent L.R. 3-
7 2(f)); documents “sufficient to evidence each discussion with, disclosure to, or other manner of
8 providing to a third party, or sale of or offer to sell, or any public use of, the claimed invention prior
9 to the date of application for the patent in suit” (Patent L.R. 3-2(a)); and “documents evidencing the
10 conception, reduction to practice, design, and development of each claimed invention” (Patent L.R.
11 3-2(b)). AGIS Software has not produced any documents for at least these categories.

12 AGIS Software’s 30(b)(6) witness and public statements by AGIS Software or its affiliates
13 confirm agreements of the kind contemplated by Patent L.R. 3-2(f) exist. *See, e.g.*, Ex. 18 (March
14 22, 2022 Deposition Tr. of Thomas Meriam) at 44:14-45:4, 50:23-52:12 ([REDACTED]
15 [REDACTED]); 2:21-cv-00024-JRG, Dkt. 1 (“AGIS Software licenses its patent portfolio,
16 including the ’970, ’724, ’728, ’838, and ’100 Patents, to AGIS, Inc.”); Ex. 2 (“LifeRing
17 applications, solutions, and software products are covered by patents licensed from AGIS Software
18 Development LLC.”); Ex. 1. However, AGIS Software failed to produce any license agreements.

19 AGIS Software also possesses and has previously relied on documentation relevant to Patent
20 L.R. 3-2(b) to establish alleged priority dates in public proceedings. *See, e.g.*, Ex. 3 at 5-150
21 (explaining AGIS Software’s conception and reduction to practice evidence for a related patent,
22 which specifically identifies features recited in claims of the patents-in-suit). But no such
23 documentation was provided in AGIS Software’s Patent Local Rule 3-2 production. Likewise,
24 AGIS Software also possesses—and did not produce—documentation evidencing disclosures of the
25 claimed inventions that pre-date the filing date of applications of the patents-in-suit (Patent L.R. 3-
26 2(a)). Malcolm K. Beyer, Jr. AGIS Software’s CEO and inventor of the patents-in-suit, submitted
27 a declaration to the U.S. Patent and Trademark Office (“USPTO”) identifying, describing, and
28 providing various third-party disclosures of the practicing LifeRing products, which both AGIS,

1 Inc. and AGIS Software claim as their own. *See* Ex. 3; Ex. 4 at 4; Exs. 5-7. Despite this previous
2 disclosure, AGIS Software produced no such documentation in its Patent L.R. 3-2 production.

3 Patent L.R. 3-2(a)–(c) are coextensive with the entirety of the Eastern District of Texas
4 (“EDTX”) Patent Local Rule 3-2. *See* Exs. 8 & 9. Patent L.R. 3-2 includes an *additional seven*
5 categories of documents, Patent L.R. 3-2(d)–(j), beyond those required in EDTX. *See* Ex. 9. Despite
6 the fact that Patent L.R. 3-2 require the production of substantially more documents, AGIS
7 Software’s 3-2 production in this case contained about 5,000 pages *less* than AGIS Software’s 3-2
8 production in the EDTX Action. AGIS Software provided no explanation for why nearly 5,000
9 documents relevant in EDTX would not also be relevant in NDCA, and AGIS Software’s lack of
10 response and omission of at least the specifically identified documents suggests AGIS Software is
11 intentionally withholding these documents in violation of the duties it owes this Court and Lyft.

12 **B. AGIS Software’s Deficient Response to Lyft’s Interrogatory No. 1**

13 Pursuant to the Court’s order granting discovery “regarding the relationship between AGIS
14 Software, AGIS, Inc., and AGIS Holdings and their contacts with California,” Lyft served
15 Interrogatory No. 1. *See* Ex. 11 at 6. In response to this interrogatory, AGIS Software claims that
16 its only interactions with California are its [REDACTED]
17 [REDACTED]. *See* Ex. 10 at 6-9. Based on publicly available information and AGIS
18 Software’s 30(b)(6) witness, however, this is not accurate. AGIS Software has entered into license
19 agreements [REDACTED] Ex.
20 18 at 44:14-45:4, 50:23-52:12. It is not possible that AGIS Software executed even one of these
21 licenses without communications to and from the licensee. It has become clear through meet and
22 confers and testimony from AGIS Software’s 30(b)(6) witness that AGIS Software is improperly
23 withholding non-privileged communications made by AGIS Software’s agents, including attorneys
24 hired to enforce and negotiate its license agreements. AGIS Software’s position is untenable, as a
25 company only acts through its employees, officers, and other agents, *including* its attorneys. [REDACTED]

26 [REDACTED]
27 [REDACTED]
28 [REDACTED] Ex. 18 at 212:23-213:3. [REDACTED]

1 [REDACTED]
2 [REDACTED], and AGIS Software continues to refuse to
3 provide discovery into these communications. *See generally* Ex. 18 at 55:6-69:21.

4 Interrogatory No. 1 seeks information proportional to the needs of the case that is directly
5 relevant to Lyft's claim that this Court has personal jurisdiction over AGIS Software. Indeed, the
6 Federal Circuit confirmed in *Trimble Inc. v. PerDiemCo LLC* that nonexclusive license agreements
7 and communications sent into a jurisdiction are relevant to the jurisdictional inquiry in a patent
8 infringement case. 997 F.3d 1147, 1156 (Fed. Cir. 2021). AGIS Software is best situated to provide
9 the information sought. And, if AGIS Software lacks minimum contacts with California as it asserts,
10 the burden and expense associated with providing a full and accurate response to this interrogatory
11 would be low. The benefit of Lyft's proposed discovery therefore outweighs any burden or expense
12 to AGIS Software. In view of the foregoing, Interrogatory No. 1 seeks information that is both
13 relevant and proportional to the needs of the case, and Lyft respectfully requests this Court compel
14 AGIS Software to provide a full and accurate response to this interrogatory and additional time to
15 depose AGIS Software on this topic. In particular, Lyft requests an identification of all
16 communications or other interactions between AGIS Software (including its employees, officers,
17 and/or agents, such as attorneys) and any company or individual located in California (including a
18 company's employees, officers, and/or agents), specifically communications involved in negotiating
19 and executing licenses to AGIS Software's patents.

20 C. AGIS Software's Failure to Provide Discovery from Its Affiliates

21 In addition to communications by AGIS Software, Lyft's Interrogatory No. 1 seeks
22 communications and interactions by AGIS Software's affiliates and alter egos AGIS, Inc. and AGIS
23 Holdings. The Court specifically recognized Lyft's alter ego theory and permitted discovery into
24 "the relationship between [the AGIS affiliates] and their contacts with California." Dkt. 61 at 9.
25 Instead of identifying the communications and other interactions for all three affiliates, however,

26 [REDACTED]
27 [REDACTED] Ex. 10 at 2.
28

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