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13 **UNITED STATES DISTRICT COURT**
 14 **NORTHERN DISTRICT OF CALIFORNIA**
 15 **SAN JOSE DIVISION**

17 GOOGLE LLC,

18 Plaintiff,

19 v.

20 AGIS HOLDINGS, INC., ADVANCED
 21 GROUND INFORMATION SYSTEMS,
 INC., AND AGIS SOFTWARE
 22 DEVELOPMENT LLC,

23 Defendants.

Case No. 5:23-cv-03624-BLF

JOINT CASE MANAGEMENT STATEMENT

Hearing Date: January 4, 2024

Time: 11:00am

Judge: Hon. Beth Labson Freeman

Courtroom: 3, Fifth Floor

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1 Plaintiff Google LLC (“Google”) and Defendants AGIS Holdings, Inc. (“AGIS Holdings”),
2 Advanced Ground Information Systems, Inc. (“AGIS, Inc.”), and AGIS Software Development
3 LLC (“AGIS Software”) (collectively “AGIS” and together with Google “the parties”) hereby
4 submit this Joint Case Management Statement and Proposed Order pursuant to Federal Rule of
5 Civil Procedure 26(f), Civil Local Rule 16-9, Patent Local Rule 2-1, the Standing Order for All
6 Judges of the Northern District of California – Contents of Joint Case Management Statement, and
7 the Court’s notices and orders setting the January 4, 2024 Case Management Conference (ECF 11,
8 30).

9 **1. JURISDICTION & SERVICE**

10 This Court has subject matter jurisdiction over this declaratory judgment action pursuant to
11 the Declaratory Judgment Act, 28 U.S.C. §§ 2201-02, and the patent laws of the United States, 35
12 U.S.C. § 100 et seq. AGIS contests personal jurisdiction. All parties have been served.

13 **2. FACTS**

14 In this declaratory judgment action, Google seeks judgments that: (1) claims 2 and 10-13
15 of the U.S. Patent No. 8,213,970 (“’970 Patent”), assigned to AGIS Software, are not infringed by
16 Google’s Find My Device (“FMD”) application; (2) claims 2 and 10-13 of the ’970 Patent are
17 invalid; (3) any claims asserted by AGIS that Google infringes the ’970 Patent are barred under
18 claim preclusion and the *Kessler* doctrine; and (4) claims 2 and 10-13 of the ’970 Patent are
19 unenforceable due to inequitable conduct and unclean hands. ECF 41-2.

20 The following is a history of litigation over the ’970 Patent between AGIS and Google.

21 2018 Patent Office Challenges¹

22 On May 15, 2018, Google filed a petition for *inter partes* review of the ’970 Patent,

23 ¹ **Plaintiff’s Additional Statement:** Before the “2018 Patent Office Challenges,” on June 21,
24 2017, AGIS Software asserted, among other claims, infringement of the ’970 Patent based on
25 FMD in cases filed in the Eastern District of Texas (“EDTX”) against Huawei, LG, ZTE, and
26 HTC, who are all customers of Google and sell mobile devices that are capable of running FMD.
27 See *AGIS Software Development LLC v. ZTE Corp.*, 2:17-cv-00517 (E.D. Tex.); *AGIS Software*
28

1 challenging original claims 1 and 3-9 of the '970 Patent. *Google LLC v. AGIS Software*
2 *Development LLC*, IPR2018-01079 (P.T.A.B.). On November 19, 2019, the PTAB issued a final
3 written decision finding claims 1 and 3-9 unpatentable, which the Federal Circuit affirmed. *Id.*,
4 Paper No. 34 (Nov. 19, 2019); *AGIS Software Development, LLC v. Google LLC*, No. 20-1401,
5 ECF 46 (Fed. Cir. Feb. 4, 2021).

6 AGIS's 2019 Litigations ("AGIS I") And Related Patent Office Challenges

7 On November 4, 2019, AGIS Software filed a complaint against Google in the EDTX
8 asserting, among other claims, the '970 Patent against FMD. *AGIS Software Development LLC v.*
9 *Google LLC*, No. 2:19-CV-00361-JRG (E.D. Tex. Nov. 4, 2019) ("*AGIS I*").²

10 On May 15, 2020, Google filed a third-party *ex parte* reexamination ("EPR") request
11 challenging the patentability of original claims 2 and 10-13 of the '970 Patent. Reexamination No.
12 90/014,507. During the EPR proceedings, AGIS Software amended the claims of the '970 Patent
13 to overcome an examiner rejection based on prior art. On December 9, 2021, an *ex parte*
14 reexamination certificate issued for the '970 Patent, amending claims 2 and 10-13.

15 On May 23, 2022, the Federal Circuit ordered that the *AGIS I* case be transferred to this
16 District. ECF 388; *In re Google LLC*, No. 2022-140-42, 2022 WL 1613192, at *1 (Fed. Cir. May
17 23, 2022).

18 After transfer to this District, the *AGIS I* case was assigned to this Court on August 31,
19

20 *Development LLC v. LG Elecs. Inc.*, 2:17-cv-00515 (E.D. Tex.); *AGIS Software Development*
21 *LLC v. HTC Corp.*, 2:17-cv-00514 (E.D. Tex.); *AGIS Software Development LLC v. Huawei*
22 *Device USA Inc.*, 2:17-cv-00513 (E.D. Tex.). As part of those actions, AGIS Software served
23 subpoenas on Google seeking discovery relating to FMD. In 2019, each of those actions was
24 dismissed following settlements.

25 ² **Plaintiff's Additional Statement:** On November 4, 2019, AGIS also filed cases against Waze
26 Mobile Limited ("Waze") and Samsung Electronics Co. Ltd. and Samsung Electronics America,
27 Inc. (collectively, "Samsung"). Those cases were consolidated into the *AGIS I* case. *AGIS I*, ECF
28 29.

1 2022. *AGIS Software Development LLC v. Google LLC*, No. 5:22-CV-04826-BLF. Google filed
2 a Rule 12(b)(1) motion to dismiss the original claims 2 and 10-13 of the '970 Patent for lack of
3 subject matter jurisdiction based on the issuance of the reexamination-amended claims 2 and 10-
4 13 of the '970 Patent. *AGIS I*, ECF 249, 425. On April 7, 2023, the parties filed a joint stipulation
5 and motion to dismiss the original claims of the '970 Patent with prejudice. *See AGIS I*, ECF 437.³
6 On April 10, 2023, this Court granted the parties stipulated dismissal of the original claims of the
7 '970 Patent, and *AGIS I* proceeded with the remaining claims. *See AGIS I*, ECF 438.

8 AGIS's 2022 ITC Action

9 On November 16, 2022, AGIS Software and AGIS, Inc. filed an ITC action against Google
10 and twelve other respondents, accusing FMD of infringing the '970 Patent. On June 15, 2023,
11 AGIS withdrew its ITC complaint and moved to terminate its ITC investigation. On July 13, 2023,
12 a notice of the ITC's decision terminating the ITC investigation was published in the Federal
13 Register. Certain Location-Sharing Systems, 88 Fed. Reg. 44,840 (July 13, 2023).

14 AGIS's 2023 WDTX Litigation And This Declaratory Judgment Action

15 On March 1, 2023, AGIS Software filed suit against Google in the Western District of
16 Texas, asserting the reexamination-amended claims 2 and 10-13 of the '970 Patent against FMD.
17 *AGIS Software Development LLC v. Google LLC*, No. 6:23-CV-00160-DC-DTG ("the WDTX
18 Case"). On April 4, 2023, the WDTX court granted Google's unopposed motion to stay the WDTX
19 Case pending resolution of the ITC proceedings. *See WDTX Case*, ECF 11. On July 20, 2023,
20 AGIS Software voluntarily dismissed the WDTX Case. *See WDTX Case*, ECF 12.

21 The next day, July 21, 2023, Google filed this declaratory judgment action against the
22 reexamination-amended claims 2 and 10-13 of the '970 Patent. ECF 1. On November 13, 2023,
23 Google filed a Sealed Amended Complaint. ECF 41-2. On November 27, 2023, AGIS filed a

24 _____
25 ³ **Defendants' Additional Statement:** The parties' joint stipulation and motion to dismiss was
26 filed pursuant to a compromise between Plaintiff and Defendant AGIS Software and expressly
27 stated that the "dismissal does not cover the reexamination-amended claims of the '970 Patent that
28 issued on December 9, 2021." *Id.*

1 motion to dismiss Google's Amended Complaint. Google's Opposition is due December 29,
2 2023. ECF 46. AGIS's Reply is due January 23, 2024. *Id.*

3 **3. LEGAL ISSUES**

4 The principal disputed legal issues are:

- 5 • Whether this Court has personal jurisdiction over AGIS Holdings, AGIS, Inc., and AGIS
6 Software.
- 7 • Whether Google's FMD and Google devices running FMD directly or indirectly infringe
8 any claim of the '970 Patent, either literally or under the doctrine of equivalents.
- 9 • Whether each claim of the '970 Patent is invalid.
- 10 • Whether AGIS is barred from asserting the '970 Patent against Google or FMD under
11 claim preclusion, res judicata, or the *Kessler* doctrine.
- 12 • Whether each claim of the '970 Patent is unenforceable due to inequitable conduct.
- 13 • Whether each claim of the '970 Patent is unenforceable due to unclean hands.
- 14 • Whether this case is exceptional under 35 U.S.C. § 285.
- 15 • Whether any party is entitled to its costs and attorneys' fees in connection with this action.
- 16 • Whether any other forms of relief are due to any party.

17 The parties reserve the right to raise additional factual or legal issues that may arise
18 through the course of this action.

19 **4. MOTIONS**

20 **A. Prior Motions**

21 ECF No.	Date	Title	Status
22 40	23 October 23, 2023	AGIS Motion to Dismiss, or in the Alternative, to Transfer	Moot, in light of Google's Amended Complaint (ECF 42)

25 **B. Pending Motions**

26 ECF No.	Date	Title	Status
27 43	28 November 27, 2023	AGIS Motion to Dismiss Amended Complaint, or in the Alternative, to	Pending.

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