

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

AGIS SOFTWARE DEVELOPMENT, LLC,

Plaintiff,

v.

ZTE CORPORATION, ZTE (USA) INC.,
AND ZTE (TX), INC.,

Defendants.

Civil Action No. 2:17-cv-00517-JRG

Lead case: 2:17-cv-00513-JRG

**ZTE (USA) INC., AND ZTE (TX), INC.’S PRELIMINARY ELECTION OF PRIOR ART
REFERENCES**

Defendants ZTE (USA) Inc. and ZTE (TX), Inc. (“ZTE”)¹ serves its Preliminary Election of Prior Art References, as set forth below, pursuant to the Court’s First Amended Docket Control Order (Dkt. 115)² and in view of Plaintiff AGIS Software Development, LLC’s (“AGIS”) April 16, 2018 Preliminary Election of Asserted Claims. ZTE expressly reserves its right to assert at or before trial that the patents-in-suit are invalid for additional reasons, including (without limitation) under 35 U.S.C. §§ 101 and/or 112. ZTE further expressly reserves its rights to assert additional prior art references uncovered during the course of fact discovery (including, but not limited to, any references based upon discovery from third parties).

I. U.S. Pat. No. 8,213,979

The asserted claims of U.S. Pat. No. 8,213,970 are invalid in view of the following prior art references alone, in combination with certain references as identified in the exhibits to ZTE’s March 15, 2018 invalidity contentions cited herein (Dkt. 94), and/or in combination with the

¹ Defendant ZTE Corporation has not yet been served or otherwise appeared in this case.

² Unless otherwise indicated, case citations will refer to the lead case docket (2:17-cv-00513-JRG).

IPR2019-00485, Exhibit 2004

knowledge of a person of ordinary skill in the art prior to the date of the alleged invention of the asserted claims:

1. United States Patent Publication No. 2003/0217109, entitled “Method and Apparatus for Automatic Notification and Response” to Ordille (ZTE-AGIS-00026285 - 00026324), as demonstrated in Exhibit A-1 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
2. United States Patent Application No. 08/0219416, entitled “Method and System for Obtaining Feedback from at Least One Recipient Via a Telecommunication Network” to Roujinsky (ZTE-AGIS-00026268 - 00026284), as demonstrated in Exhibit A-2 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
3. United States Patent No. 7,609,669, entitled “Voice Directed System and Method Configured for Assured Messaging to Multiple Recipients” to Sweeney (ZTE-AGIS-00027192 - 00027202), as demonstrated in Exhibit A-3 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
4. United States Patent No. 7,386,589, entitled “Managed Messaging Platform with Message Response Aggregation” to Tanumihardja (ZTE-AGIS-00027137 - 00027191), as demonstrated in Exhibit A-4 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
5. United States Patent No. 6,816,878, entitled “Alert Notification System” to Zimmers (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-5 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
6. United States Patent App. Pub. No. 2006/0218232, entitled “Method and System for Accommodating Mandatory Responses in Electronic Messaging” to Kubala (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-6 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
7. United States Patent No. 6,854,007, entitled “Method and System for Enhancing Reliability of Communication with Electronic Messages” to Hammond (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-6 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
8. United States Patent No. 5,325,310, entitled “Method and System for Persistent Electronic Mail Reply Processing” to Johnson et al. (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-7 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
9. United States Patent No. 5,742,905, entitled “Personal Communications Internetworking” to Pepe et al. (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-7 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
10. United States Patent No. 7,619,584, entitled “Messaging Including Active Response Feature” to Wolf. (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-8 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.

11. United States Patent No. 7,912,913, entitled “Facilitating Presentation and Monitoring of Electronic Mail Messages with Reply by Constraints” to Accapadi et al. (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-9 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
12. WO App. No. 2008/118878, entitled “Enhanced Messaging Features” to Swanburg et al. (ZTE-AGIS-00027089 - 00027136), as demonstrated in Exhibit A-10 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.

II. Each of U.S. Pat. Nos. 9,408,055; 9,445,251; and 9,467,838

The asserted claims of U.S. Pat. Nos. 9,408,055; 9,445,251; and 9,467,838 are invalid in view of the following prior art references alone, in combination with certain references as identified in the exhibits to ZTE’s March 15, 2018 invalidity contentions cited herein, and/or in combination with the knowledge of a person of ordinary skill in the art prior to the proper priority date of the asserted claims:

1. United States Patent Publication No. 2007/0281690, entitled “Displaying and Tagging Places of Interest on Location-Aware mobile Communication Devices in a Local Area Network” to Altman et al. (ZTE-AGIS-00027043 - 00027069), as demonstrated in Exhibit C-1, E-1, and G-1 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
2. United States Patent No. 7,330,112, entitled “Location-Aware Services” to Emigh et al. (ZTE-AGIS-00026891 - 000026914), as demonstrated in Exhibit C-2, E-2, and G-2 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
3. United States Patent No. 7,917,866, entitled “Method, System, and Graphical User Interface for Meeting-Spot-Related Online Communications” to Karam (ZTE-AGIS-00026955 - 000026977), as demonstrated in Exhibit C-3, E-3, and G-3 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
4. United States Patent Publication No. 2002/0115453, entitled “Method and System for Location Based Wireless Communication Services” to Poulin et al. (ZTE-AGIS-00026936 - 00026954), as demonstrated in Exhibit C-4, E-4, and G-4 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
5. United States Patent No. 6,867,733, entitled “Method and System for Plurality of Mobile Units to Locate One Another” to Sandhu et al. (ZTE-AGIS-00026878 - 00026890), as demonstrated in Exhibit C-5, E-5, and G-5 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.

6. United States Patent No. 7,271,742, entitled “Method and Apparatus for Sending, Retrieving and Planning Location Relevant Information” to Sheha et al. (ZTE-AGIS-00026823 - 000026877), as demonstrated in Exhibit C-5, E-5, and G-5 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
7. United States Patent No. 7,450,003, entitled “User-Defined Private Maps” to Weber et al. (ZTE-AGIS-00026915 - 00026935), as demonstrated in Exhibit C-6, E-6, and G-6 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
8. The Active Campus System made available to the public no later than April 2003, (ZTE-AGIS-00026703 - 00026735), as demonstrated in Exhibit C-7, E-7, and G-7 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
9. The AGIS’s LifeRing Product and its prototypes (the “AGIS system”) made available to the public by October 3, 2005, (ZTE-AGIS-00026765 - 00026781), as demonstrated in Exhibit C-8, E-8, and G-8 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
10. The APRS Protocol Reference 1.0 (“APRS 1.0”) and the Automatic Packet/Position Reporting System (“APRS System”) where APRS 1.0 was published on or before August 29, 2000 and the APRS system was made available to the public no later than September 21, 2004, (ZTE-AGIS-00026537 - 00026668), as demonstrated in Exhibit C-9, E-9, and G-9 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
11. The AT&T Find Friends system (the “AT&T system”) made available to the public by June 24, 2002, (ZTE-AGIS-00026497 - 00026497), as demonstrated in Exhibit C-10, E-10, and G-10 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
12. The BuddySpace system (the “BuddySpace system”) made available to the public by June 2002, (ZTE-AGIS-00026475 - 00026496), as demonstrated in Exhibit C-11, E-11, and G-11 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
13. The Force XXI Battle Command, Brigade and Below system (the “FBCB2 system”) made available to the public by March 21, 2003, (ZTE-AGIS-00026325 - 00026421), as demonstrated in Exhibit C-12, E-12, and G-12 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
14. The Navizon system (the “Navizon system”) made available to the public by October 2005, (ZTE-AGIS-00026422 - 00026423), as demonstrated in Exhibit C-13, E-13, and G-13 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
15. United States Patent No. 6,366,782, entitled “Method and Apparatus for Allowing a User of a Display-Based Terminal to Communicate with Communication Units in a Communication System” to Fumarlol et al. (ZTE-AGIS-00026915 - 00026935), as demonstrated in Exhibit C-14, E-14, and G-14 to ZTE’s March 15, 2018 invalidity contentions and in any subsequent amendments thereto.
16. United States Patent No. 6,868,333, entitled “Group Interaction System for Interaction with other Vehicles of a Group” to Melen. (ZTE-AGIS-00026915 -

00026935), as demonstrated in Exhibit C-16, E-16, and G-16 to ZTE's March 15, 2018 invalidity contentions and in any subsequent amendments thereto.

In addition, as ZTE explained in its March 15, 2018 Patent Rule 3-3 Invalidity Contentions, U.S. Pat. Nos. 9,408,055; 9,445,251; and 9,467,838; are entitled to a priority date no earlier than October 31, 2014. ZTE expressly reserves its right to assert at trial that, under that priority date, to the extent that any of the accused ZTE products are determined to infringe any claim of any of those asserted patents, those accused Apple products would also render the claims invalid under at least AIA 35 U.S.C. § 102(a)(1) because they were each in public use and on sale or available for download before the effective filing date of those patents. ZTE further reserves the right to assert at trial that, under that priority date, earlier AGIS patents and/or applications, including (without limitation) U.S. Patent No. 7,630,724, would also render the claims invalid under at least AIA 35 U.S.C. § 102(a)(1) because they were publicly available before the effective filing date of the those asserted patents.

Dated: April 30, 2018

Respectfully submitted,

/s/ Bradford C. Schulz

Bradford C. Schulz

Lionel M. Lavenue (Lead)

email: Lionel.Lavenue@finnegan.com

Bradford C. Schulz (Back-up)

email: Bradford.Schulz@finnegan.com

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP

Two Freedom Square

11955 Freedom Drive

Reston, VA 20190

Phone: (571) 203-2700

Fax: (202) 408-4400

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