

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

AGIS SOFTWARE DEVELOPMENT LLC,

Plaintiff,

v.

HUAWEI DEVICE USA INC., et al.,

Defendants.

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**Civil Action No. 2:17-CV-513-JRG
(LEAD CASE)**

AGIS SOFTWARE DEVELOPMENT LLC,

Plaintiff,

v.

APPLE INC.,

Defendant.

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**Civil Action No. 2:17-CV-516-JRG
(CONSOLIDATED CASE)**

**DEFENDANT APPLE INC.'S MOTION FOR SUMMARY JUDGMENT OF
APPLICATION OF POST-AIA LAW TO U.S. PATENT NOS. 9,408,055; 9,445,251;
9,467,838; AND 9,749,829; AND FOR SUMMARY JUDGMENT OF
UNENFORCEABILITY DUE TO UNCLEAN HANDS**



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Ex. 1	U.S. Patent No. 9,408,055
Ex. 2	U.S. Patent No. 9,445,251
Ex. 3	U.S. Patent No. 9,467,838
Ex. 4	U.S. Patent No. 9,749,829
Ex. 5	'838 File History Excerpt - 2015-10-30 Corrected Application Data Sheet
Ex. 6	'838 File History Excerpt - 2016-04-25 Reply to Office Action
Ex. 7	'829 File History Excerpt - 2015-10-07 Corrected Application Data Sheet
Ex. 8	'829 File History Excerpt - 2016-01-20 Corrected Application Data Sheet
Ex. 9	'251 File History Excerpt - 2015-11-13 Reply to Office Action
Ex. 10	'251 File History Excerpt - 2016-01-26 Reply to Office Action
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I. INTRODUCTION

During prosecution of four of the patents-in-suit, Plaintiff AGIS¹ or its sister entity represented to the Patent Office that its applications included “claims that have an effective filing date *on or after March 16, 2013*,” and that they are accordingly governed by post-AIA law. AGIS now attempts to renounce those representations. AGIS does so because it seeks to establish priority dates going back *as early as 2003* by asserting conception and reduction to practice of certain claims before its earliest-filed application—an assertion that is prohibited under post-AIA law. Apple respectfully submits that this Court should apply post-AIA law to four of the patents-in-suit—consistent with the positions AGIS entities took in the Patent Office.

Apple further respectfully submits that AGIS’s tactics warrant a finding of unclean hands. AGIS made the unequivocal factual representation to the Patent Office that its patent applications (now issued patents) contained claims that had an effective filing date on or after March 16, 2013. AGIS thus avoided the Patent Office’s scrutiny over whether the claims were enabled or otherwise supported by applications filed prior to March 2013. There was no need for the Patent Office to undertake such an analysis in view of AGIS’s factual statements that at least some of the claims had an effective filing date on or after March 2013.

AGIS now says the opposite of its representations to the Patent Office to improve its validity arguments in this case—going so far as to *deny*, in Requests for Admission, the *word-for-word factual statements* made in the Patent Office. This is not a situation where different legal standards in the Patent Office and District Courts (like claim construction) can justify advancing different positions in the two venues. Instead, having secured issuance of its patents, AGIS now

¹ “AGIS” refers to Plaintiff AGIS Software Development LLC. Several of the patents-in-suit were prosecuted by Plaintiff’s sister entity—AGIS, Inc.—before being assigned to Plaintiff shortly before this lawsuit.

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