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

AGIS SOFTWARE DEVELOPMENT LLC,	§	Case No. 2:17-CV-0513-JRG
	§	(LEAD CASE)
Plaintiff,	§	
	§	**JURY TRIAL DEMANDED**
v.	§	
	§	
HUAWEI DEVICE USA INC. ET AL.,	§	
	§	
Defendants.	§	

APPLE, INC.,	§	Case No. 2:17-CV-0516-JRG
	§	(CONSOLIDATED CASE)
Defendant.	§	
	§	**JURY TRIAL DEMANDED**

PLAINTIFF AGIS SOFTWARE DEVELOPMENT LLC'S REPLY TO APPLE INC.'S RESPONSE IN OPPOSITION TO AGIS'S MOTION TO STRIKE THE EXPERT REPORT OF NEIL SIEGEL FOR FAILURE TO DISCLOSE OBVIOUSNESS COMBINATIONS BASED ON THE SIEGEL PATENTS (DKT. 234)

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Plaintiff AGIS Software Development LLC ("AGIS"), by and through its undersigned counsel, hereby submits this reply in support of its Motion to Strike the Expert Report of Neil Siegel for Failure to Disclose Obviousness Combinations Based on the Siegel Patents (Dkt. 234).

I. APPLE FAILS TO ESTABLISH THAT THE "SUPPORTING DOCUMENTATION" ARE NOT PRIOR ART REFERENCES FOR PURPOSES OF OBVIOUSNESS

Apple relies on the U.S. Patent Nos. 6,212,559 (the "'559 patent"); 5,672,840 (the "'840 patent"); 6,904,280 (the "'280 patent"); and 7,278,023 (the "'023 patent") (collectively, the "Siegel patents") as an obviousness combination with the FBCB2 system as invalidating prior art. Apple states that a separate reference to the Siegel patents was not required in its election of prior art references "because its invalidity contentions are based on the ***FBCB2 system***, which is described in the Siegel patents, among other documents." *Id.* at 4. Whether Apple identified the Siegel patents in its invalidity contentions is not at issue. Apple surrendered those references when it did not identify them in its final election of prior art—a meaningful exchange whereby both Apple and AGIS narrowed the scope of the case. However, Apple's expert, Dr. Siegel, continues to rely on the surrendered Siegel patents in order to establish certain claims are invalid as anticipated and obvious in contravention of the agreed reduction procedure set forth in the Court's DCO.

Apple argues that its invalidity expert, Dr. Neil Siegel, has cited to "the Siegel patents (among other documents) in its charts as evidence of the features and operation of that system," and that the Siegel patents are not references because they are merely supporting documents. Dkt. 258 at 3-4. However, Dr. Siegel attempts to establish how FBCB2 meets the asserted claims by improperly relying on the *combination* of the Siegel patents. In several places in his report, Dr. Siegel relies exclusively on the Siegel patents to establish various purported limitations of the asserted claims. *See* Dkt. 234-2 at ¶¶ 17, 83, 97-98, 119, 154, 161-162, 186-

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

187, 191, 194, 216, 222-223, 227, 230, 237-238, 244, 250, 267-268, 274, 280, 303, 324, 345, 350, 376, 404, 415-416, 431, 437, 467-468, and 485. Further, Dr. Siegel admits that for certain claims and claim limitations, the Siegel patents themselves, without the FBCB2 system, are the source for allegedly teaching one or more claim limitations. Ex. D at 216:9-19; 216:21-217:11. ("I cite . . . U.S. Patent 7,278,023, and that patent includes explicit language about remote control capabilities. And I describe what FBCB2 does in other parts of this text . . . but I also cite that patent as a document that also talks about remote control in the same way that the patent claim limitation does.").

Accordingly, Apple's attempts to shoehorn the surrendered prior art references into the FBCB2 "system" are an end-run around to the agreed claim and prior art election process and should be treated as such. Accordingly, because Apple did not identify the Siegel patents in its final election, Apple's arguments relying on those references should be stricken.

II. APPLE RELIES ON AN UNDISCLOSED OBVIOUSNESS ARGUMENT BASED ON THE FBCB2 SYSTEM IN COMBINATION WITH THE SIEGEL PATENTS

Apple discloses an obviousness argument based on the undisclosed prior art references in combination with the FBCB2 system in the Siegel Report. Apple argues that the obviousness argument is based on the FBCB2 system with the Siegel patents as "supporting documentation describing the functionality of the FBCB2 system, consistent with Apple's invalidity contentions." Dkt. 258 at 4. However, Dr. Siegel testifies that his obviousness analysis utilizes the Siegel patents in combination with the FBCB2 system as prior art. Ex. D at 212:2-3; 212:5-11; 212:13-14 ("Q. And so you are using in your analysis those patents as prior art under one of these sections of 102; correct? . . . THE WITNESS: I'm using FBCB2 and those patents"). Apple argues that Dr. Siegel "confirmed that the Siegel patents are not separate references in an obviousness combination; they are support evidence of the FBCB2 system's features." Dkt. 258

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

at 5. However, Dr. Siegel's own testimony states that there are portions of the claim limitations where he relies solely on the patents and others where he "describe[s] what FBCB2 does." Ex. D at 217:2-11; *see id.* at 219:21-220:3.

Apple responds that it has not disclosed any new theories and "the Siegel patents that are purportedly the basis of this motion were ***charted in invalidity contentions*** as early as April 2018." Dkt. 258 at 11 (emphasis added). However, Apple concedes that it charted ***the Siegel patents*** in its invalidity contentions and then failed to include those references in its final election of prior art.

Apple attempts to minimize Dr. Siegel's understanding of obviousness by referring to his "non-attorney's mind" and his "non-lawyer's way" despite his testimony that he has an understanding of 35 U.S.C. § 102 and of obviousness. Ex. D at 210:3-211:4; 219:3-4; 219:6-24; 220:1-220:3. Apple has proffered Dr. Siegel as a purported expert related to the invalidity of the patents in suit. Apple likely expects that Dr. Siegel will provide his opinions on obviousness to a lay jury. Moreover, Dr. Siegel himself stated that he is "an expert offering an opinion as to whether the claims in the patents-in-suit are valid" and he is "obliged to apply the applicable law." Ex. E, Invalidity Report of Neil Siegel at ¶ 26. He further states that he understands how to assess the obviousness of a patent. *Id.* at ¶¶ 39-45. Apple's implication that Dr. Siegel can't grasp obviousness based on his "non-attorney's mind" and his "non-lawyer's way," while simultaneously proffering Dr. Siegel as an expert for purposes of invalidity is disingenuous. Apple provides no legitimate reason as to why the Court should ignore Dr. Siegel's own testimony.

Apple asserts that this motion would cause significant prejudice to Apple. However, by Apple's own admissions, the patents are merely four documents that are "supporting

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

documentation." Apple has conceded that it does not intend to present any "combination" theory at trial. Dkt. 258 at 1. It was within Apple's control to select its prior art references. Apple cannot assert now that their choice not to assert these references is prejudicial.

III. CONCLUSION

For the foregoing reasons, AGIS respectfully requests that the Court grant its Motion to Strike the Expert Report of Neil Siegel for Failure to Disclose Obviousness Combinations Based on the Siegel Patents.

Dated: January 11, 2019

BROWN RUDNICK LLP

/s/ Alfred R. Fabricant

Alfred R. Fabricant
NY Bar No. 2219392
Email: afabricant@brownrudnick.com
Lawrence C. Drucker
NY Bar No. 2303089
Email: ldrucker@brownrudnick.com
Peter Lambrianakos
NY Bar No. 2894392
Email: plambrianakos@brownrudnick.com
Vincent J. Rubino, III
NY Bar No. 4557435
Email: vrubino@brownrudnick.com
Alessandra C. Messing
NY Bar No. 5040019
Email: amessing@brownrudnick.com
Shahar Harel
NY Bar No. 4573192
Email: sharel@brownrudnick.com
John A. Rubino
NY Bar No. 5020797
Email: jrubino@brownrudnick.com
Enrique W. Iturralde
NY Bar No. 5526280
Email: eiturralde@brownrudnick.com
Daniel J. Shea, Jr.
NY Bar No. 5430558

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase®
Smarter legal research.