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

AGIS SOFTWARE DEVELOPMENT LLC,	§	
	§	
Plaintiff,	§	
	§	**Civil Action No. 2:17-CV-513-JRG**
v.	§	**(LEAD CASE)**
	§	
HUAWEI DEVICE USA INC., *et al.*,	§	
	§	
Defendants.	§	

	§	
AGIS SOFTWARE DEVELOPMENT LLC,	§	
	§	
Plaintiff,	§	**Civil Action No. 2:17-CV-516-JRG**
	§	**(CONSOLIDATED CASE)**
v.	§	
	§	
APPLE INC.,	§	
	§	
Defendant.	§	

DEFENDANT APPLE INC.'S REPLY IN SUPPORT OF ITS 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

TABLE OF AUTHORITIES

Pages

Cases

Statutes

TABLE OF EXHIBITS

Exhibit Number	Description
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
Ex. 11	'251 File History Excerpt - 2016-06-03 Reply to Office Action
Ex. 12	'055 File History Excerpt - 2015-10-30 Reply to Office Action
Ex. 13	'055 File History Excerpt - 2016-02-26 Reply to Office Action
Ex. 14	'055 File History Excerpt - 2016-05-31 Reply to Office Action
Ex. 15	AGIS's Responses to Apple's Interrogatories Nos. 12-15
Ex. 16	AGIS's Responses to Apple's Requests for Admission Nos. 1-4
Ex. 17	AGIS's Responses to Apple's Interrogatories Nos. 17-22
Ex. 18	McAlexander Infringement Report Excerpts
Ex. 19	McAlexander Validity Report Excerpts
Ex. 20	'838 File History Excerpt - 2016-08-04 Office Action
Ex. 21	'838 File History Excerpt - 2015-08-19 Office Action
Ex. 22	'829 File History Excerpt - 2015-02-27 Application Data Sheet
Ex. 23	'829 File History Excerpt - 2015-04-07 Office Action
Ex. 24	Apple's Final Election of Prior Art
Ex. 25	Siegel Deposition Excerpt

AGIS concedes the key fact requiring application of the AIA to the '055, '251, '838, and '829 patents: an application leading to those patents "contained at any time, a claim to an invention that has an effective filing date on or after March 16, 2013." (Dkt. No. 260 ("Opp.") at 9.) That is what AGIS ***repeatedly*** told the Patent Office after taking on "heavy burdens" and "complex analyses" to determine AIA law applied. (*Id.* at 12.) AGIS should be held to its representations and cannot "swear behind" prior art. Further, AGIS's attempts to wordsmith around its representations—forcing Apple to bring this issue to the Court—warrants finding unclean hands.

First, AGIS's opposition confirms that AIA law governs the '838 patent. AGIS admits that the '838 patent's application "contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013." (Opp. at 9.) The statute dictates that the AIA applies to such applications, and there is no dispute that the '838 patent issued from its corresponding application.[1] AGIS's argument that "issued patents" are not subject to the AIA (Opp. at 9) is wrong.[2] Whether or not issued claims might have a priority date earlier than March 2013 is irrelevant; by the statutory terms, the AIA applies to the patent as a whole. *Id.* And contrary to AGIS's argument (Opp. at 11), expert opinions on the priority of specific claims do not impact the legal determination of the applicability of AIA law to the patent.[3]

Second, AGIS's opposition confirms that the AIA governs the '055, '251, and '829 patents, because AGIS admits that "[t]he '838 patent is included in the priority chain of each" of those

[1] Leahy–Smith America Invents Act ("AIA"), Pub. L. No. 112-29, § 3(n)(1)(A), 125 Stat. 284, 293 (2011) (outlining that AIA applies "to any application for patent, and to any patent issuing thereon, that contains or contained at any time . . . a claim to a claimed invention that has an effective filing [on or after March 16, 2013]").
[2] *Id.* (The AIA "shall apply to any application . . . ***and to any patent issuing thereon*** . . . .").
[3] AGIS's reliance on *Blue Calypso LLC v. Groupon, Inc.*, 815 F. 3d 1331 (Fed. Cir. 2016), is misplaced. *Blue Calypso* involved patents that were filed ***and issued*** before March 16, 2013, and thus could not have ever contained a post-AIA claim, in contrast to the patents at issue here.

patents. (Opp. at 4.) Because the '838 patent's application contained a post-AIA claim, AIA law also applies to the '055, '251, and '829 patents claiming priority to it. AIA § 3(n)(1)(B).

Third, AGIS's citation to correspondence (*see* Opp. at 1-2, 13) simply highlights its gamesmanship. AGIS craftily acknowledged that "AGIS's prosecution counsel stated" that certain claims had an effective filing date after March 16, 2013, but still ***denied*** those facts. (Opp. at 1; *see also* Ex. C.) Indeed, AGIS maintains those denials in discovery responses.[4]

Fourth, AGIS's reliance on 35 U.S.C. § 102(g) is misplaced. (*See* Opp. at 2-3, 10.) That subsection of pre-AIA law addresses ***interference proceedings*** and ***prior invention*** prior art.[5] As AGIS knows, Apple and its experts assert invalidity based on printed publications and public systems. (Ex. 24.[6]) Apple does not intend to assert prior invention under § 102(g) at trial; AGIS confirmed that at deposition.[7] AGIS asserts that § 102(g) allows AGIS to swear behind "any prior art in this case" (Opp. at 10), but the case upon which AGIS relies did not apply AIA law, and in particular did not apply AIA 35 U.S.C. § 102, which is applicable here.[8]

At bottom, by telling the Patent Office that its applications contained (at one time) claims with a post-March 2013 priority date, AGIS avoided the Patent Office's scrutiny over whether those claims were adequately supported in earlier applications—a key dispute between the parties here. Reversing course, AGIS now asserts that its patents should be entitled to a priority date before the effective filing date—something the AIA expressly prohibits. That conduct is egregious, and Apple respectfully submits that it warrants a finding of unclean hands.

---

[4] *Compare* Opp. at 1, *with* Ex. 16 at 4-5, *and* Ex. 15 at 5.
[5] *Fox Grp., Inc. v. Cree, Inc.*, 700 F.3d 1300, 1304 (Fed.Cir.2012); *see also TQP Dev., LLC v. 1-800-Flowers.com, Inc.*, 120 F. Supp. 3d 600, 608 (E.D. Tex. 2015).
[6] Exs. 1-23 were filed with Apple's opening brief (Dkt. No. 227). Exs. 24-25 are filed herewith.
[7] Ex. 25 at 210:10-211:16 ("Q. How about 102 (g)? A. No. My – my analysis was focused on 102 (a) and 102 (b).")
[8] *Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1006 (Fed. Cir. 2016).

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.