

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)

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AGIS SOFTWARE DEVELOPMENT LLC,

Plaintiff,

v.

APPLE INC.,

Defendant.

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

APPLE'S MOTION TO STAY PENDING *INTER PARTES* REVIEW

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I. INTRODUCTION

The Patent Trial and Appeal Board (“PTAB”) has instituted *inter partes* review (“IPR”) of every asserted claim of three of the five patents at issue in this case, and it will issue an institution decision concerning all of the asserted claims of one other asserted patent before trial. Crucially, IPR proceedings that have *already* been instituted will likely *fully foreclose* AGIS’s infringement claims on *all* of the patents at issue in this case. Because the outcome of the IPRs may ultimately obviate the need for trial of *any* issue, Apple respectfully requests that this case be stayed until the PTAB issues final written decisions in the currently-pending IPR proceedings concerning the asserted patents.

II. FACTUAL BACKGROUND

A. Procedural Posture

AGIS asserts infringement of five U.S. Patents in this case: U.S. Pat. No. 8,213,970 (the “’970 patent”); U.S. Pat. No. 9,467,838 (the “’838 patent”); U.S. Pat. No. 9,445,251 (the “’251 patent”); U.S. Pat. No. 9,408,055 (the “’055 patent”); and U.S. Pat. No. 9,749,829 (the “’829 patent”) (collectively, the “asserted patents”). (*See* Dkt. No. 32 (AGIS’s First Amended Complaint) ¶¶ 17-81.) The ’838, ’251, ’055, and ’829 patents share a common specification, and are directed to similar systems and methods of sharing location information and communications among a group of participants in a communications network. *See, e.g.*, ’838 pat. cl. 1; ’251 pat. cl. 1; ’055 pat. cl. 1; and ’829 pat. cl. 1.

Fact discovery in this case closed on October 26, 2018. Expert discovery closed on December 7, 2018. Summary judgment briefing was completed on January 22. The pre-trial conference is set for February 21, 2019, and trial is scheduled to begin on March 4, 2019. (*See* Dkt. No. 220; Ex. 1 (Order Resetting Pretrial Conference).)

Apple and non-party Google LLC have filed IPR petitions concerning each of the asserted patents. The PTAB has instituted IPR of the '970 patent,¹ the '055 patent,² and the '838 patent,³ finding a reasonable likelihood that all of the asserted claims of those patents will be found unpatentable.⁴ The PTAB is required by statute to issue final written decisions in each IPR no later than December 7, 2019 (absent a very rare extension by the Board of up to six months for good cause). *See* 37 C.F.R § 42.100(c). In addition to these instituted IPRs, another Petition for IPR remains pending against the '829 patent,⁵ and an institution decision is due before the start of trial in this case.

A summary of the IPRs that have been instituted concerning the asserted patents, and proceeding in which an institution decision is forthcoming, is included below:

AGIS Patent	Proceeding	Status
'970 Patent	IPR2018-01079	Granted
'838 Patent	IPR2018-00819	Granted
'055 Patent	IPR2018-01080	Granted
'829 Patent	IPR2018-01471	Institution Decision Due 2/28/2019

¹ *See* Ex. 2 *Google LLC v. AGIS Software Development, LLC*, IPR2018-01079, Paper No. 9 (Nov. 20, 2018) (Institution of *Inter Partes* Review). Apple has moved to join this IPR pursuant to 37 C.F.R § 42.122(e). *See* *Apple, Inc. v. AGIS Holdings, Inc.*, IPR2019-00411, Paper No. 3 (Dec. 7, 2018) (Motion for Joinder).

² *See* Ex. 3 *Google LLC v. AGIS Software Development, LLC*, IPR2018-01080, Paper No. 9 (Dec. 4, 2018) (Institution of *Inter Partes* Review). Apple has moved to join this IPR pursuant to 37 C.F.R § 42.122(e). *See* *Apple, Inc. v. AGIS Holdings, Inc.*, IPR2019-00432, Paper No. 3 (Dec. 13, 2018) (Motion for Joinder).

³ *See* Ex. 4 *Apple Inc. v. AGIS Software Development, LLC*, IPR2018-00819, Paper No. 9 (Nov. 7, 2018) (Institution of *Inter Partes* Review).

⁴ *See* Ex. 5 (Plaintiff AGIS Software Development, LLC's Final Election of Asserted Claims to Defendant Apple Inc.) at 10; Ex. 2; Ex. 3; Ex. 4.

⁵ *Apple Inc. v. AGIS Software Development, LLC*, IPR2018-00819 (filed Jul. 31, 2018) (seeking IPR of every asserted claim of the '829 patent).

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