

EXHIBIT 8

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

AGIS SOFTWARE DEVELOPMENT LLC,

Plaintiff,

v.

HUAWEI DEVICE USA INC., HUAWEI
DEVICE CO., LTD. AND HUAWEI DEVICE
(DONGGUAN) CO., LTD.,
HTC CORPORATION,
LG ELECTRONICS, INC.,
APPLE INC.,
ZTE CORPORATION, ZTE (USA), INC.,
AND ZTE (TX), INC.,

Defendants.

Civil Action No. 2:17-CV-513-JRG (Lead
Case)

Civil Action No. 2:17-CV-514-JRG
Civil Action No. 2:17-CV-515-JRG
Civil Action No. 2:17-CV-516-JRG
Civil Action No. 2:17-CV-517-JRG

DEFENDANT APPLE'S AMENDED PATENT RULE 3-3 INVALIDITY CONTENTIONS

HTC (17-cv-514), LG (17-cv-515), and ZTE (17-cv-517) and the petitions submitted in related *inter partes* review proceedings before the U.S. Patent & Trademark Office (Cases IPR2018-00817, Case IPR2018-00818).

II. INVALIDITY CONTENTIONS

A. Priority Dates

In its infringement contentions, AGIS contends that each of the asserted claims of the patents-in-suit are entitled to a priority date of “at least as early as September 21, 2004,” and that “AGIS reserves the right to establish an earlier date of invention based upon actions related to conception and reduction to practice of the claimed inventions.” Apple contends that none of the claims are entitled to a priority date of (or earlier than) September 21, 2004.

First, according to AGIS’s own representations to the U.S. Patent and Trademark Office during prosecution, the ’055, ’251, ’838, and ’829 patents contain or claim priority to at least one patent application—U.S. Application No. 14/579,978 (the “’978 application”), the application for the ’838 patent—that includes or at one time included at least one claim having an effective filing date after March 16, 2013. (*See* ’978 application Reply to Office Action dated April 25, 2016 at 15-16 (“Applicant respectfully notes that the Corrected Application Data Sheet filed on October 30, 2015, indicates that the ‘application... contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.”).) Accordingly, under AGIS’s representations, each of the ’055, ’251, ’838, and ’829 patents is governed by post-AIA 35 U.S.C. §§ 102 and 103, and therefore AGIS cannot establish a priority date earlier than the effective filing date based on alleged earlier conception or reduction to practice for any of those patents. Leahy-Smith America Invents Act of 2011, Pub. L. No. 112-29, § 3(n)(1), 125 Stat. 284, 293 (Sept. 16, 2011).

Second, the '055, '251, '838, and '829 patents are not entitled to a priority date any earlier than October 31, 2014, the effective filing date of the '978 application that led to the '838 patent. AGIS cannot claim priority to any earlier applications in the patent family because the teachings of most of the earlier applications in the patent family—including at least Appl. Nos. 13/751,453, 12/761,533, 11/615,472, and 11/308,648—were not incorporated by reference into the '978 application (leading to the '838 patent). The chain of applications (including continuation applications and continuations-in-part) upon which AGIS purportedly relies to establish an earlier priority date therefore lacks continuity of disclosure, a defect that cannot be cured. 35 U.S.C. § 120; *Zenon Environmental, Inc. v. U.S. Filter Corp.*, 506 F.3d 1370 (Fed. Cir. 2007). Apple reserves the right to assert additional theories of invalidity based on the determination of the proper priority date, including a contention that earlier applications in the patent family constitute invalidating prior art to the asserted claims of the patents-in-suit.

Third, as set forth below, the application on which AGIS appears to rely to establish a priority date of September 21, 2004 (Appl. No. 10/711,490, filed on Sep. 21, 2004, now U.S. Pat. No. 7,031,728) does not contain sufficient disclosure of at least one limitation of every asserted claim in each patent-in-suit and that, accordingly, none of the asserted claims is entitled to the benefit of the September 21, 2004 filing date for that additional reason:

a. '970 Patent

Apple contends that none of the asserted claims of the '970 patent is entitled to a priority date of (or earlier than) September 21, 2004 because at least the claim limitations listed below are not sufficiently disclosed in Appl. No. 10/711,490 (now U.S. Pat. No. 7,031,728). Apple contends that the '970 patent is entitled to a priority date no earlier than November 26, 2008, the effective filing date of the application (Appl. No. 12/324,122) leading to the '970 patent.