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

AGIS SOFTWARE DEVELOPMENT LLC, Plaintiff, v. HTC CORPORATION, Defendant.	§ § § § § § § § § §	Case No. 2:17-CV-0514-JRG (LEAD CASE) **JURY TRIAL DEMANDED** [redacted]
LG ELECTRONICS INC., Defendant.	§ § § § §	Case No. 2:17-CV-0515-JRG (CONSOLIDATED CASE) **JURY TRIAL DEMANDED**

PLAINTIFF AGIS SOFTWARE DEVELOPMENT LLC'S RESPONSE IN OPPOSITION TO LG ELECTRONICS INC.'S MOTION FOR SUMMARY JUDGMENT THAT U.S. PATENT NO. 7,630,724 MAY NOT BE RELIED UPON TO SHOW THAT U.S. APPLICATION NO. 14/027,410 PROVIDES WRITTEN DESCRIPTION SUPPORT FOR U.S. PATENT NOS. 9,408,055; 9,445,251; AND 9,467,838 (DKT. 106)

Plaintiff AGIS Software Development LLC ("AGIS") hereby submits its Response in Opposition to LG Electronics Inc.'s ("LG") Motion for Summary Judgment that U.S. Patent No. 7,630,724 may not be relied upon to show that U.S. Application No. 14/027,410 provides written description support for U.S. Patent Nos. 9,408,055; 9,445,251; and 9,467,838 (Dkt. 106).

I. INTRODUCTION

U.S. Patent Application No. 14/027,410 (the "'410 application") properly incorporates by reference U.S. Patent No. 7,630,724 (the "'724 patent"). LG alleges that the '410 application to which U.S. Patent Nos. 9,408,055 (the "'055 patent"); 9,445,251 (the "'251 patent"); and 9,467,838 (the "'838 patent") claim priority failed to incorporate the '724 patent by reference.

II. RESPONSE TO STATEMENT OF ISSUES

1. Whether U.S. Patent No. 7,630,724 may be relied upon to show that U.S. Application No. 14/027,410 provides written description support for the asserted claims of U.S. Patent Nos. 9,408,055; 9,445,251; and 9,467,838 where U.S. Application No. 14/027,410 fails to incorporate U.S. Patent No. 7,630,724 by reference.

Response: LG has failed to show that the '724 patent cannot be relied upon to show the '410 application provides written description support for the '055, '251, and '838 patents because LG has not shown that the incorporation statement in the '410 application does not expressly and unambiguously incorporate the '724 patent.

III. RESPONSE TO STATEMENT OF UNDISPUTED MATERIAL FACTS

LG has failed to present a Statement of Undisputed Material Facts as required by Local Rule CV-56(a) because the statements contain disputed facts and are argumentative under Local Rule CV-56(d). AGIS presents the following responses to the allegations in the Statement of Undisputed Material Facts.

1. Response: Undisputed that AGIS asserts infringement of the '055 patent, the '251 patent, and the '838 patent (collectively, the "location sharing patents") against LG.

2. Response: Undisputed that the location sharing patents claim priority to the '410 application.

3. Response: Undisputed that the location sharing patents claim priority to the '724 patent and U.S. Patent No. 7,031,728 (the "'728 patent").

4. Response: Undisputed that the '410 application includes an incorporation-by-reference section that lists the '724 patent. AGIS disputes that the '724 patent is only mentioned in a single instance in the '410 application. The '724 patent is first identified as pertaining to related subject matter in the first paragraph of the specification of the '410 application. Dkt. 106-6 at [0001]. The '724 patent is identified for a second time for the purpose of incorporation by reference. Dkt. 106-6 at [0005].

5. Response: AGIS disputes that the Patent Office has held the '410 application did not incorporate by reference the '724 patent. AGIS states that the Patent Office denied institution of *inter partes* review on other grounds and AGIS did not take any position regarding the priority statement alleged in those proceedings. Any statements made by the PTAB in institution decisions were preliminary, non-precedential, and not based on a full record.

IV. COUNTER-STATEMENT OF UNDISPUTED MATERIAL FACTS

1. The '410 application contains two references to the '724 patent: (1) in the statement of Cross References to Related Applications; and (2) in the incorporation by reference statement. Dkt. 106-6 at [0001]; [0005].

V. LEGAL STANDARD

A. Summary Judgment

Summary judgment is proper if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. *Baker v. Putnal*, 75 F.3d 190, 198 (5th Cir. 1996). In considering a summary judgment motion, the court must "view the evidence in the light most favorable to the non-moving party." *United States v. Renda Marine, Inc.*, 667 F.3d 651, 655 (5th Cir. 2012).

B. Incorporation by Reference

Incorporation by reference requires (1) clear intend to incorporate by reference using the root words "incorporat(e)" and "reference"; and (2) clear identification of the referenced patent, application, or publication. 37 C.F.R. § 1.57(b) (2004). "[T]o gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112." *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed. Cir. 2007) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997)).

"Whether and to what extent a patent incorporates material by reference is a question of law we review *de novo*." *Harari v. Hollmer*, 602 F.3d 1348, 1351 (Fed. Cir. 2010). The standard to be applied in determining whether a document describes the material to be incorporated by reference with sufficient particularity is of one reasonably skilled in the art. *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).

VI. ARGUMENT

The '410 application properly incorporates by reference both the '728 patent and the '724 patent. LG alleges that the language used by the patentee was insufficient to incorporate by

reference the '724 patent. Incorporation by reference requires a (1) clear intent to incorporate by reference, using, for example, "incorporated by reference," and (2) a clear identification of the referenced patent application or publication. 37 C.F.R. § 1.57(b). In the '410 application, the applicant explicitly uses the words "incorporated by reference." Further, both the '728 and '724 patents are clearly identified in the '410 application, in both the Cross Reference to Related Applications and the incorporation by reference statement. LG fails to acknowledge the identification of the '728 and '724 patents in the Related Applications statement. If the incorporation by reference statement were merely another identification of the related applications, the incorporation statement would be rendered superfluous. Thus, because LG's interpretation of the specification would render portions superfluous, it should not be credited.

In *Callaway Golf Co. v. Acushnet Co.*, the court held that Nesbitt, the alleged prior art reference, identifies "what specific material is being incorporated by reference . . . and where it may be found." 576 F.3d 1331, 1346 (Fed. Cir. 2009). The court also held that language "nearly identical to that used in Nesbitt ('[r]eference is made to') can be sufficient to indicate to one of skill in the art that the referenced material is fully incorporated into the host document." *Id.* The incorporation statement here is more explicit than that of Nesbitt and sufficiently identifies the specific material incorporated by reference (the method and operation of communication devices), and where it may be found (the '728 and '724 patents). *Id.*; *see also Husky Injection Molding Sys. Ltd. v. Athena Automation Ltd.*, 838 F.3d 1236, 1248 (Fed. Cir. 2016) (the sentence "[a]ll cross-referenced patents and application[s] referred to in this specification are hereby incorporated by reference" in concert with the sentence describing the portions of the patent that are incorporated by reference was sufficient to demonstrate incorporation by reference to a skilled artisan); *Cf. Hollmer v. Harari*, 681 F.3d 1351, 1358 (Fed. Cir. 2012) (where the court

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