

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

AGIS SOFTWARE DEVELOPMENT LLC, §  
v. § CASE NO. 2:21-cv-00072-JRG  
T-MOBILE USA, INC., AND T-MOBILE § (Lead Case)  
US, INC. §

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AGIS SOFTWARE DEVELOPMENT LLC, §  
v. § CASE NO. 2:21-cv-00026-JRG  
UBER TECHNOLOGIES, INC., § (Member Case)  
d/b/a UBER, §

**DEFENDANT UBER TECHNOLOGIES, INC.'S MOTION TO STAY PENDING  
PATENT OFFICE PROCEEDINGS REGARDING THE ASSERTED PATENTS**

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Defendant Uber Technologies, Inc. (“Uber”) respectfully requests that the Court stay Plaintiff AGIS Software Development LLC’s (“AGIS”) case against Uber based on validity challenges at the United States Patent and Trademark Office (“USPTO”) covering the asserted claims of all five patents asserted by AGIS against Uber.

## I. BACKGROUND

AGIS filed its complaint against Uber on January 29, 2021. *See* Compl. (No. 2:21-cv-00026, Dkt. 1). In that complaint, AGIS asserts that Uber infringes U.S. Patent Nos. 7,031,728 (“the ’728 patent”); 7,630,724 (“the ’724 patent”); 8,213,970 (“the ’970 patent”); 10,299,100 (“the ’100 patent”); and 10,341,838 (“the ’838 patent”). Prior to filing its complaint against Uber, AGIS filed a suit against Google LLC asserting the ’970 (and other) patents. *See AGIS Software Development LLC v. Google LLC*, No. 2:19-cv-00361 (E.D. Tex.).

***Reexamination of the ’970 Patent.*** On May 15, 2020, Google filed a Request for *Ex Parte* Reexamination of the ’970 patent, challenging claims 2 and 10–13—the same claims AGIS alleges Uber infringes.<sup>1</sup> The USPTO granted the request on July 27, 2020, finding a substantial new question of patentability. On August 19, 2021, the challenged claims were finally rejected on multiple bases. Recently, on October 19, 2021, in response to the rejection, AGIS amended the two challenged independent claims. 10/19/2021 Amendment (Ex. 1) at 3–4, 6–7, 9. As a result, all claims of the ’970 patent asserted against Uber are affected by the pending reexamination.

***Inter Partes Review of the ’100 and ’838 Patents.*** On July 23, 2021, Uber filed three IPR petitions, one challenging claims 1–23 of the ’100 patent, one challenging claims 24–31 of the ’100 patent, and one challenging claims 1–26 of the ’838 patent. *See* IPR2021-01306;

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<sup>1</sup> Claims 1 and 3-9 were previously found unpatentable in an IPR proceeding filed by Google. *See Google LLC v. AGIS Software Dev., LLC*, IPR2018-01079, Final Written Decision (P.T.A.B. Nov. 19, 2019).

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