EXHIBIT 1

[redacted]

From: Enrique Iturralde
To: Robb, Andrew; Reiter, Mark; *** GDC-Uber-Agis; melissa@gillamsmithlaw.com
Cc: AGIS; jtruelove@mckoolsmith.com; sbaxter@mckoolsmith.com
Subject: Re: AGIS v. Uber - discovery deficiency
Date: Tuesday, October 26, 2021 8:39:14 PM
Attachments: image002.png

[WARNING: External Email]

Hi Andrew,

Please provide Uber lead and local counsel's availability to meet and confer tomorrow in advance of AGIS's motion to compel.

Thanks,
Enrique

From: Robb, Andrew <ARobb@gibsondunn.com>
Sent: Tuesday, October 26, 2021 11:23 PM
To: Enrique Iturralde <eiturralde@fabricantllp.com>; Reiter, Mark <MReiter@gibsondunn.com>; *** GDC-Uber-Agis <GDC-Uber-Agis@gibsondunn.com>; melissa@gillamsmithlaw.com <melissa@gillamsmithlaw.com>
Cc: AGIS <AGIS@fabricantllp.com>; jtruelove@mckoolsmith.com <jtruelove@mckoolsmith.com>; sbaxter@mckoolsmith.com <sbaxter@mckoolsmith.com>
Subject: RE: AGIS v. Uber - discovery deficiency

Enrique,

AGIS appears to justify its demand for world-wide Uber revenue based on alleged deposition testimony [redacted]. First, the witness who provided that testimony was not designated on that issue. [redacted] Mr. Postnikoff did not testify that servers did not exist outside of the United States, nor did he testify that servers outside of the United States are not involved ride requests. [redacted]

Next, AGIS's treatment of this testimony, as well as its demand for world-wide revenue, conflicts with the arguments AGIS presented to the Court in opposition to Uber's Motion to Dismiss for Improper Venue. Indeed, in its Motion to Dismiss, Uber explained that in its Complaint, AGIS acknowledged that the '838 patent claims were limited to server claims. Dkt. No 24 at 6, citing AGIS's Complaint at ¶¶ 82–87. Uber further explained to the Court that AGIS had failed to allege that Uber operates any servers in the Eastern District of Texas, nor could it because Uber has no servers in the District or in Texas. *Id.* In response, AGIS asserted that Uber "has publicly disclosed that it engages in a 'classic hybrid cloud approach' which utilizes co-located data centers located in the United States and multiple third-party cloud computing services." Dkt. 43 at 8. AGIS continued

that Uber relies on "'third-party service providers to host or otherwise process some of [its] data and that of platform users.'" *Id.* As a result, AGIS argued, "the physical server infrastructure used by [Uber] appears to be much broader than just the 'servers,' as submitted by Mr. Rapipong and [Uber]." *Id.* And in its Sur-Reply, AGIS represented to the Court that "[Uber] and its customers have performed at least one step of the '838 Patent claims in this District and some portion of [Uber's] infringing products, systems, and/or servers is located in this District." Dkt. 69 at 2.

As you know, the Court accepted AGIS's arguments and representations. In his order, Judge Payne wrote: "AGIS has presented evidence that Uber engages in a 'classic hybrid cloud approach' which 'utilizes co-located data centers located in the United States and multiple third-party cloud computing systems.'" Dkt. 142 at 6. Judge Payne, moreover, relied specifically on AGIS's statement that "'[a]ccordingly, the physical infrastructure used by [Uber] appears to be much broader than just the 'servers,' as submitted by Mr. Rapipong and [Uber].'" *Id.*

AGIS now seeks to walk away from these representations, which the Court accepted and relied upon in denying Uber's motion. AGIS represented that acts of infringement occurred in the District because Uber and its customers have performed at least one step of the '838 claims in the District, and as a result of Uber's cloud approach that utilizes servers and third-party cloud computing systems, allegedly located in the District. Given these representations, AGIS cannot now assert that all steps of the '838 patent claims occur solely in the United States by Uber's servers located in the United States. The doctrine of judicial estoppel precludes AGIS from taking such a contrary position. *See, e.g., Love v. Tyson Foods, Inc.,* 677 F.3d 258, 261 (5th Cir. 2012). Indeed, (1) AGIS's current position is inconsistent with the legal position presented in opposition to Uber's Motion to Dismiss, (2) the Court accepted AGIS's position, and (3) AGIS clearly did not act inadvertently. *Id.*

Indeed, AGIS's prior position—that acts of infringement occur wherever the riders or drivers are located—is fully consistent with the positions AGIS has taken in its infringement contentions. Repeatedly, AGIS relies on the rider or driver application to prove infringement for claims of the '838 patent. *See*, *e.g.*, Third Amended Contentions at E-3 *et seq.*, E-13 *et seq.*, E-19 *et seq.*, E-32 *et seq.*, E-37 *et seq.*, E-39 *et seq.*, E-44 *et seq.*, E-48 *et seq.*, E-53 *et seq.* For example, claim limitation 1[H] requires that the mobile device be configured in certain ways, and AGIS relies heavily on application code of the mobile device to show that those limitations are satisfied. *See id.* at E-32 through E-36 (attempting to map Uber application source code modules to configuration requirements set forth in claim). AGIS's new position, that infringement occurs solely at Uber's own servers, is an abandonment of this position.

Because AGIS has represented that the location of Uber's servers is irrelevant, which (again) the Court accepted, to the extent a rider or driver is located outside of the United States or co-located third-party or cloud servers are located outside of the United States, steps of the '838 patent occur outside of the United States. In other words, based on AGIS's own representations to the Court that certain claim elements of the '838 patent are satisfied wherever the rider, driver, or co-located third-party or cloud servers are physically located, it necessarily follows that, for riders, drivers, or co-located third-party or cloud servers outside of the United States, at least one step of the '838 patent claims occurs in that non-U.S. jurisdiction. Under established Federal Circuit law, there can be no infringement for foreign rides. *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1318 (Fed.

Cir. 2005), *abrogated on other grounds*, *see IRIS Corp. v. Japan Airlines Corp.*, 769 F.3d 1359, 1361 n.1 (Fed. Cir. 2014) ("A method or process consists of one or more operative steps, and, accordingly, '[i]t is well established that a patent for a method or process is not infringement unless ***all*** steps or stages of the claimed process are utilized.'") (emphasis added).

At least for the foregoing reasons, the requested information is not relevant and is not proportional to the needs of the case, and Uber therefore will not produce it.

Regards,
Andrew

Andrew Robb

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From: Enrique Iturralde <eiturralde@fabricantllp.com>
Sent: Wednesday, October 13, 2021 8:05 PM
To: Reiter, Mark <MReiter@gibsondunn.com>; *** GDC-Uber-Agis <GDC-Uber-Agis@gibsondunn.com>; melissa@gillamsmithlaw.com
Cc: AGIS <AGIS@fabricantllp.com>; jtruelove@mckoolsmith.com; sbaxter@mckoolsmith.com
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[WARNING: External Email]

Counsel for Uber:

During today's deposition of Mr. Tate Postnikoff, the Uber corporate representative testified [redacted]

Because AGIS has asserted infringement of server method claims and server system claims and because domestic and foreign usage/requests/transactions of Uber's rider/driver apps result in infringing activities that occur on Uber's servers in the United States, Uber's responses to Interrogatory No. 3 and Uber's document productions concerning financial information (transactions/sales/revenues/profits/costs/pricing) are deficient and incorrectly limited to US-only financial information. AGIS requests that Uber immediately supplement its interrogatory responses and accompanying document productions to further include worldwide financial information for all accused activities occurring on U.S. servers. Please confirm that Uber will complete this supplementation by October 20, 2021.

Regards,
Enrique

[redacted]

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