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

AGIS SOFTWARE DEVELOPMENT LLC,	§ § §	Case No. 2:21-cv-00072-JRG **(LEAD CASE)**
Plaintiff,	§ §	**JURY TRIAL DEMANDED**
v.	§ §	
T-MOBILE USA, INC. and T-MOBILE US, INC.,	§ § §	
Defendants.	§	
AGIS SOFTWARE DEVELOPMENT LLC,	§ § §	Case No. 2:21-cv-00026-JRG (MEMBER CASE)
Plaintiff,	§ §	**JURY TRIAL DEMANDED**
v.	§ §	
UBER TECHNOLOGIES, INC., d/b/a UBER,	§ § §	
Defendant.	§	

PLAINTIFF AGIS SOFTWARE DEVELOPMENT LLC'S MOTION FOR SUMMARY JUDGMENT OF COMPLIANCE WITH 35 U.S.C. § 287(a)

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Plaintiff AGIS Software Development LLC ("AGIS" or "Plaintiff"), by and through its undersigned counsel, respectfully submits this Motion for Summary Judgment of Compliance with 35 U.S.C. § 287(a) (the "Motion").

I.   INTRODUCTION

Defendant Uber Technologies, Inc., d/b/a Uber ("Uber" or "Defendant") has not met its burden of production to articulate the products it contends are unmarked patented articles subject to Section 287(a) of the Patent Act. According to the Federal Circuit, an alleged infringer must put the patentee on notice that the patentee or its authorized licensees sold specific unmarked products which the alleged infringer believes practice the patent. Only when the alleged infringer meets this burden of production does the patentee bear the burden of showing that the unmarked products do not practice the patented invention. With fact discovery closed and expert reports served, Defendant has never identified any specific products of AGIS or its licensees which Defendant contends were unmarked and covered by either of the Patents-in-Suit.

AGIS pled that it has complied with the requirements of 35 U.S.C. § 287(a), and it has stated in discovery that all of its own products practicing the Patents-in-Suit were marked as of the issuance of the patents. Since the record contains no evidence to the contrary, and Defendant has not met its burden of production, summary judgment that AGIS complied with 35 U.S.C. § 287(a) should be granted.

II.   STATEMENT OF ISSUES TO BE DECIDED BY THE COURT

1.   Whether Defendant has met its burden of production to identify unmarked patent products that support its marking defense under 35 U.S.C. § 287(a).

2.   Whether AGIS marked its own covered products.

III.   STATEMENT OF UNDISPUTED MATERIAL FACTS

1.   AGIS alleges that Defendant's Accused Products infringe U.S. Patent Nos. 8,213,970, 7,630,724, 7,031,728, 10,299,100 (the "'100 Patent"), and 10,341,838 (the "'838 Patent") (collectively, the "Patents-in-Suit").

2.   AGIS alleged in its Complaint for Patent Infringement that "AGIS Software and all previous assignees of the Patents-in-Suit have complied with the requirements of 35 U.S.C. § 287(a)." *See AGIS Software Dev. LLC v. Uber Techs., Inc., d/b/a Uber*, Case No. 2:21-cv-00026-JRG, Dkt. 1 at ¶ 25 (E.D. Tex. Jan. 29, 2021).

3.   Defendant has not identified any specific products of AGIS which it contends are unmarked and covered by any of the Patents-in-Suit.

4.   Defendant has not identified any specific products of AGIS's licensees which it contends are unmarked and covered by any of the Patents-in-Suit.

5.   Defendant's Answer to AGIS's Complaint included a "failure to mark" defense, stating "AGIS's claims are barred in whole or in part by failure to adequately plead compliance with patent marking pursuant to the requirements of 35 U.S.C. § 287(a). *See* Dkt. 230 ¶ 116.

6.   In its Answer, Defendant did not identify specific products which it contends are unmarked or covered by any of the Patents-in-Suit.

7.   At no time during the discovery period did Defendant identify any products it contends are unmarked or covered by any of the Patents-in-Suit.

IV.   LEGAL STANDARD

Summary judgment is appropriate when, drawing all justifiable inferences in the non-movant's favor, there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 329 (1986).

"Compliance with § 287 is a question of fact." *Arctic Cat Inc. v. Bombardier Recreational*

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