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Plaintiff AGIS Software Development LLC (“AGIS” or “Plaintiff”), by and through its undersigned counsel, hereby submits this response in opposition to Defendant Uber Technologies, Inc., d/b/a Uber’s (“Defendant” or “Uber”) Motion to Dismiss U.S. Patent No. 8,213,970 (Dkt. 248) (the “Motion”).

I. INTRODUCTION

Uber’s Motion seeks to dismiss the asserted claims of the ’970 Patent because the claims were amended following reexamination. However, Uber submits a non-technical analysis, relying only on the addition of words to the claim to argue that the claims have substantially changed. However, such an analysis fails to demonstrate that the claims are not substantially identical such that dismissal is warranted.

The amendments to the claims merely encompassed disclosures in the specification, which did not change the scope of the claims. Accordingly, Uber’s Motion should be denied.

II. BACKGROUND

U.S. Patent No. 8,213,970 (the “’970 Patent”), entitled “METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS,” issued on July 3, 2012. Claim 10 is an independent method claim and claims 11, 12, and 13 are dependent method claims. Claim 2, which is a dependent apparatus claim, has been withdrawn as per the December 21, 2021 AGIS’s Motion for Leave to Serve Supplemental Expert Report of Joseph McAlexander Regarding Infringement. Dkt. 264; Dkt. 264-3, Supplemental McAlexander Expert Report.

On May 15, 2021, Google LLC filed a request for *ex parte* reexamination of the ’970 Patent. The USPTO issued a reexamination certificate on December 9, 2021, determining Claims 2 and 10 to be patentable as amended, and Claims 11-13, dependent on the amended claims, to be patentable. Ex. A.

Claim 10 was amended during reexamination to read, as follows (amendments italicized):

A method of receiving, acknowledging, and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgement, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone;

transmitting an automatic acknowledgement of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and

transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/ cell phone;

displaying the response received from the PDA cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and

providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message; *and displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone; obtaining location and status data associated with the recipient PDA/cellphone; and presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA cellphone based on at least the location data.*

AGIS filed the present suit against Uber on January 29, 2021, asserting infringement of the '970 Patent. *See* Dkt. 1. On May 19, 2021 AGIS served its Disclosure of Asserted Claims and Infringement Contentions on Uber, asserting Claims 2, 10-13 of the '970 Patent. Ex. B, PICs Cover. On November 1, 2021, AGIS withdrew Claim 11 of the '970 Patent. *See* Dkt. 187. On December 21, 2021, AGIS filed a Motion for Leave to Serve the Supplemental Expert Report of

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