

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

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

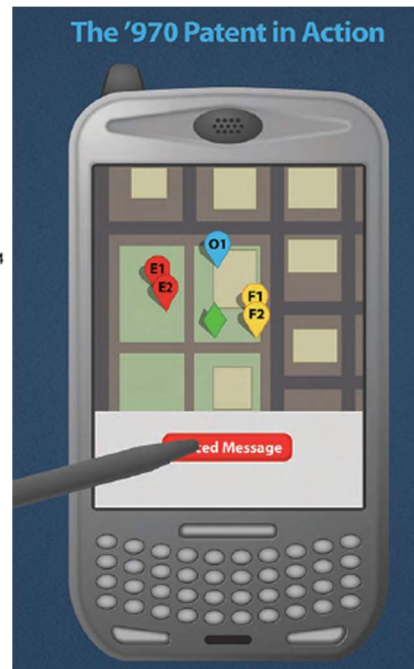
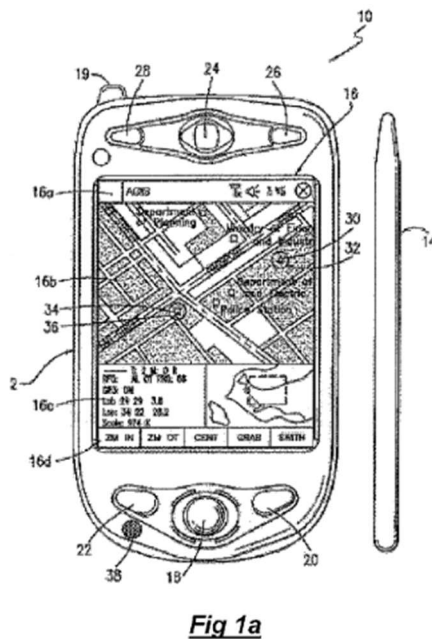
**PLAINTIFF AGIS SOFTWARE DEVELOPMENT LLC'S SUR-REPLY
IN FURTHER OPPOSITION TO DEFENDANT UBER TECHNOLOGIES, INC.,
D/B/A UBER'S MOTION TO DISMISS U.S. PATENT NO. 8,213,970 (DKT. 248)**

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Plaintiff AGIS Software Development LLC (“AGIS” or “Plaintiff”), by and through its undersigned counsel, hereby submits this sur-reply in further 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”).

The amended Claims 10, 12, and 13 of the '970 Patent are “substantially identical” to the original claims because the amendments did not substantially alter the scope of the claimed inventions. The amended claims added map location features which were already part of the “forced message alert software application program,” as described in the '970 Patent specification. The '970 Patent specification expressly describes and depicts a “forced message alert software” with locations displayed on a map, and Uber acknowledged the inclusion of these map location features in the “forced message alert software application program” when it created mock-up demonstratives for claim construction. *See* Dkt. 248-1, '970 at Fig. 1a and Ex. F, Dkt. 175-2 at 24 (respectively reproduced below).



It would be legal error to dismiss the '970 Patent without a factual determination regarding the absence of a substantial change in scope of the claimed invention. Uber's request to dismiss without this factual determination is legally unsupportable, and Uber's reliance on case law for cancelled (rather than amended) claims is an attempt to mislead the Court to commit legal error.

Contrary to Uber's allegations, the reexamination of the '970 Patent did not result in cancelled claims. *See* Reply at 1. Because the reexamination resulted in amended claims only (no cancelled claims), Uber's reliance on *Fresenius* is misplaced. In *Fresenius*, the Court reviewed cancelled claims only, not amended claims. *See Fresenius USA Inc. v. Baxter Intern., Inc.*, 721 F.3d 1330, 1347 (Fed. Cir. 2013), (“In light of the cancellation of Baxter's remaining claims, Baxter no longer has a viable cause of action against Fresenius.”). Accordingly, Uber's reliance on *Fresenius* to allege that an amendment to the claims alone extinguishes AGIS's cause of action are incorrect. As submitted by Uber itself, *Fresenius* acknowledges that where there has been an amendment of the claims requires an analysis to determine whether the amendment resulted in a substantial change in scope of the claimed invention. *See Fresenius USA, Inc.*, 721 F.3d at 1337-38. Accordingly, amendments on reexamination cannot result in automatic dismissal.

Uber's contention that an *amendment* is a *cancellation* is frivolous and unwarranted by law. The law is set forth clearly in *Laitram Corp. v. NEC Corp.*, 952 F.2d 1357, 1362 (Fed. Cir. 1991), where the Federal Circuit held that a claim amendment made during reexamination is not *per se* a substantive change. Rather, “[t]o determine whether a claim change is substantive it is necessary to analyze the claims of the original and the reexamined patents in light of the particular facts, including the prior art, the prosecution history, other claims, and any other pertinent information.” *Id.* at 1362-63.

In *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1347 (Fed. Cir. 1998), the Court determined that the original claims covered “a printer or method of printing which generates *any* quality of alphanumeric characters” where the amended claims “seem to cover only a printing apparatus or method of printing which generates ‘*type quality*’ alphanumeric characters.” The Court’s decision came “in light of an overall examination of the written description, the prosecution history and the language of the respective claims.” *Id.* at 1348. Specifically, it is notable that the “type quality” found in the amended claims does not appear in the written description. *Id.* at 1347. Unlike *Laitram*, the amendment of the claims of the ’970 Patent did not involve amendment to include terms or limitations that are not in the written description. To the contrary, AGIS has pointed to specific disclosures in the specification for the additional limitations. *See* Resp. at 6-9. Further, the “forced message alert software application program” described in the ’970 Patent *already included* the additional features found in the amended claims. Such disclosures demonstrate that AGIS did not substantively change the scope of the claimed inventions because the ’970 Patent already included the features as part of the original scope. *See* Resp. at 5 (citing to *Tennant Co. v. Hako Minuteman, Inc.*, 878 F.2d 1413, 1417 (Fed. Cir. 1989)).

Uber’s allegations that AGIS conflates the written description requirement with the analysis of whether an amended claim is “substantially identical” misconstrues AGIS’s arguments. AGIS submitted that the amended claims are “without substantive change,” as “[c]laims are not interpreted in a vacuum, but are part of and read in light of the specification.” *Tennant Co.*, 878 F.2d at 1417 (“The addition of the word ‘bottom’ does not substantively change the scope of the original claim 2, but merely makes the claim more definite. The ’070 specification makes numerous references to a movable bottom wall.”); *Slimfold Mfg. Co., Inc. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987) (“[I]t is the scope of the claim that must be identical, not that

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