

**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
Plaintiff,	§	(LEAD CASE)
	§	
v.	§	<u>JURY TRIAL DEMANDED</u>
	§	
T-MOBILE USA, INC. and T-MOBILE US,	§	
INC.,	§	
	§	
<hr/>		
LYFT, INC.,	§	Case No. 2:21-cv-00024-JRG
	§	(MEMBER CASE)
	§	
	§	<u>JURY TRIAL DEMANDED</u>
	§	
<hr/>		
UBER TECHNOLOGIES, INC., d/b/a	§	Case No. 2:21-cv-00026-JRG
UBER,	§	(MEMBER CASE)
	§	
	§	<u>JURY TRIAL DEMANDED</u>
	§	
<hr/>		
WHATSAPP, INC.,	§	Case No. 2:21-cv-00029-JRG
	§	(MEMBER CASE)
Defendants.	§	
	§	<u>JURY TRIAL DEMANDED</u>
	§	

**JOINT MOTION FOR ENTRY OF PARTIALLY DISPUTED PROPOSED
PROTECTIVE ORDER AND STIPULATED FEDERAL RULES OF EVIDENCE 502(d)
ORDER AND CLAWBACK AGREEMENT**

Pursuant to the Court’s Order dated April 19, 2021 (Dkt. 15), Plaintiff AGIS Software Development LLC (“AGIS”) and Defendants T-Mobile USA, Inc., T-Mobile US, Inc., Lyft, Inc., Uber Technologies, Inc., d/b/a Uber, and WhatsApp, Inc. (“Defendants”) (collectively, the “Parties”), hereby submit the Partially Disputed Proposed Protective Order attached as **Exhibit A** and the Stipulated Federal Rules of Evidence 502(d) Order and Clawback Agreement attached as **Exhibit B**.

The Parties have indicated their competing proposals using highlighting and square brackets in **Exhibit A** (the Parties' respective proposals are indicated with **Plaintiff's Proposal** and **Defendants' Proposal**). The Parties were able to reach agreement on almost all provisions of the Protective Order, but have two disputes regarding (1) whether the Protective Order should include a so-called "acquisition bar" preventing individuals with access to designated discovery from subsequently engaging in activities related to the acquisition of patents related to the subject matter of that designated discovery, (2) whether the scope of an otherwise agreed upon "prosecution bar" should extend to designated discovery. The Parties' competing proposals and arguments in favor of their proposals are presented below:

Plaintiff's Position

AGIS submits that Defendants' proposed acquisition and prosecution bars are inappropriate. First, Defendants' proposed acquisition bar relates to (a) acquiring patents or patent applications relating to both the field of the invention of the patents-in-suit and Defendants' designated discovery, and (b) advising or counseling its clients regarding such acquisitions during the pendency of this case and for two years after the final disposition of this action. Second, Defendants propose to extend the scope of an agreed upon prosecution bar from the field of the invention of the patents-in-suit to include Defendants' designated discovery. Defendants bear the burden of showing that each proposed bar is appropriate because (1) the risk of inadvertent disclosure exists; and (2) the balance of interests suggest a bar is appropriate. *In re Deutsche Bank Tr. Co. Ams.*, 605 F.3d 1373, 1378 (Fed. Cir. 2010).

Regarding the proposed acquisition bar, Defendants have not shown good cause to prevent Plaintiff's counsel from any activities relating to acquiring patents or patent applications relating to both the field of the invention of the patents-in-suit and Defendants' designated

discovery, and advising or counseling its clients regarding such acquisitions, for two years after the final disposition of this action. Defendants have not shown that there is a real risk of inadvertent disclosure or that the balance of interests indicates a bar is appropriate. The balance of interests does not favor the bar, and Defendants cannot demonstrate that any potential harm may occur without the bar. By contrast, imposing the bar will drastically harm both Plaintiff's counsel and other parties, including AGIS, who would be denied the counsel of their choice. *See In re Deutsche Bank*, 605 F.3d at 1379 (“[T]he district court must balance the risk against the potential harm to the opposing party from restrictions imposed on that party’s right to have the benefit of counsel of its choice.”). Moreover, the proposed acquisition bar is overbroad and unascertainable because the bar extends to Defendants’ designated discovery, which can include documents and testimony concerning irrelevant matters. Because Defendants have failed to show that there is a risk of inadvertent disclosure and that the balance of interests favors a bar, the Court should decline to enter Defendants’ proposed Acquisition Bar. *Jenam Tech., LLC v. Samsung Elecs. Am., Inc.*, No. 4:19-cv-00250-ALM-KPJ, 2020 WL 757097, at *1-*2 (E.D. Tex. Feb. 4, 2020) (“The Court finds Defendants have not met their burden, particularly considering the broad restriction the proposed Acquisition Bar would impose upon Plaintiff’s counsel and Defendants’ failure to demonstrate the potential harm of not including the Bar.”).

Regarding Defendants’ proposal to broaden the scope of the prosecution bar to the Defendants’ designated discovery, Defendants similarly have not met their burden. Basing the prosecution bar on Defendants’ designated documents and testimony renders the prosecution bar overbroad and unascertainable, which can include documents and testimony concerning irrelevant matters. The proposed breadth of the prosecution bar is harmful to Plaintiff’s counsel and other parties and extends well beyond the scope of cases in this District. *See AGIS Software*

Dev. LLC v. Google LLC, No. 2:19-cv-00361-JRG, Dkt. 89 (E.D. Tex. Apr. 22, 2020); *see also* *Vocalife LLC v. Amazon.com, Inc.*, No. 2:19-cv-00123-JRG, Dkt. 53 (E.D. Tex. Nov. 7, 2019).

Defendants' Position

The provisions of the protective order proposed by Plaintiff do not provide adequate protection to Defendants' highly confidential information and source code. First, Plaintiff disputes the propriety of an acquisition bar, barring attorneys and experts that access highly confidential information from advising or counseling clients on the acquisition of patents or patent applications pertaining to such information. Such a provision is necessary to protect against the inadvertent disclosure of Defendants' highly confidential information. The Federal Circuit has recognized that attorneys and retained experts cannot always separate what they learned from legitimate sources from what they learned by analyzing a defendant's confidential information. *See In re Deutsche Bank Trust Co. Am.*, 605 F.3d 1373, 1378 (Fed. Cir. 2010). Thus, courts routinely impose acquisition bars on attorneys and experts. *See, e.g., E-Contact Techs., LLC v. Apple, Inc.*, No. 1:11-cv-426, 2012 WL 11924448, at *1-2 (E.D. Tex. June 19, 2012); *Catch A Wave Techs., Inc. v. Sirius XM Radio, Inc.*, No. C 12-05791, 2013 WL 9868422, at *1 (N.D. Cal. Aug. 6, 2013). Here, as the Court found in *E-Contact Technologies.*, counsel for plaintiff here "has acquiesced to the imposition of a patent prosecution bar, and, therefore, apparently agrees that there could possibly be a risk of inadvertent disclosure of Defendants' confidential information in the course of representing their client before the PTO." *E-Contact Techs.*, 2012 WL 11924448, at *2. As the Court further explained, "it is hard to conceive that there would be little or no risk of inadvertent disclosure when these same attorneys advise their client in matters regarding acquisitions of patents." *Id.* Because Plaintiff is seeking discovery of Defendants' highly confidential

information, including source code, “the potential harm of inadvertent disclosure outweighs the restriction imposed” by the acquisition bar. *Id.* Defendants do not doubt that Plaintiff’s attorneys’ and experts are of high moral character and would not intentionally use Defendants’ highly confidential information outside of these litigations. Still, courts recognize that even with the best intentions, it is extremely difficult to separate what one learns legitimately from what he or she learns through a litigation. *See Safe Flight Instrument Corp. v. Sundstrand Data Control Inc.*, 682 F. Supp. 20, 22 (D. Del. 1988) (“[A]ccepting that Mr. Greene is a man of great moral fiber, we nonetheless question his human ability during future years of research to separate the applications he has extrapolated from Sundstrand’s documents from those he develops from his own ideas.”).

Second, the scope of the prosecution and acquisition bars proposed by Plaintiff is far too narrow. Plaintiff would limit the scope of the prosecution and acquisition bars to “location display technology” and “the patents asserted in this Action and any patent or application claiming priority to or otherwise related to the patents asserted in this Action.” Through discovery in this action, however, Plaintiff and its experts will have access to highly confidential technical information that does not fall into either of those two categories. That is, Defendants’ documents and source code related to the accused features in this case will certainly contain information about other unaccused features. Unless the prosecution and acquisition bars are broad enough to cover the full scope of discovery to be provided to Plaintiff, there remains a risk of inadvertent disclosure of Defendants’ information.

Thus, Defendants respectfully request this Court impose the requested acquisition bar on attorneys and experts who review Defendants’ confidential technical documents and source code to prevent inadvertent disclosure, and that the prosecution and acquisition bars be broad enough to cover the subject of any highly confidential or source code information disclosed in discovery.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.