

EXHIBIT O

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

AGIS SOFTWARE DEVELOPMENT LLC,	§	Case No. 2:22-cv-00263-JRG-RSP
	§	
Plaintiff	§	JURY TRIAL DEMANDED
	§	
v.	§	
	§	
SAMSUNG ELECTRONICS CO., LTD. and	§	
SAMSUNG ELECTRONICS AMERICA,	§	
INC.,	§	
Defendants.	§	

**DEFENDANTS’ INITIAL INVALIDITY CONTENTIONS AND SUBJECT MATTER
ELIGIBILITY CONTENTIONS**

I. INTRODUCTION

Pursuant to the Court’s Docket Control Order (Dkt. No. 28) and Patent Local Rules 3-3 and 3-4, Defendants Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “Samsung” or “Defendants”) provide these initial invalidity contentions (“Invalidity Contentions”) to Plaintiff AGIS Software Development LLC (“AGIS”) for the following patents (collectively, “Asserted Patents”) and claims (collectively, “Asserted Claims”) identified as asserted in AGIS’s Disclosure of Asserted Claims and Infringement Contentions (“Infringement Contentions”) served on December 1, 2022:

- U.S. Patent No. 8,213,970 (“970 Patent”) — Claims 2 and 10-13 (“970 Asserted Claims”)
- U.S. Patent No. 9,467,838 (“838 Patent”) — Claims 1-84 (“838 Asserted Claims”)
- U.S. Patent No. 9,749,829 (“829 Patent”) — Claims 1-68 (“829 Asserted Claims”)
- U.S. Patent No. 9,820,123 (“123 Patent”) — Claims 1-48 (“123 Asserted Claims”)

Defendants address the invalidity of the Asserted Claims and conclude with a description of their document production and identification of additional reservations and explanations. These Invalidity Contentions use the acronym “PHOSITA” to refer to a person having ordinary skill in the art to which the alleged invention pertains.

For the purposes of these Invalidity Contentions, Defendants assume that pre-AIA patent statutes apply based on AGIS’s claimed priority date of September 21, 2004 for all Asserted Claims. This is in no way a concession that AGIS is entitled to that priority date. If the Court later finds that AGIS is not entitled to its claimed priority date and that post-AIA patent statutes apply, Defendants reserve the right to amend their Invalidity Contentions to apply post-AIA patent statutes and assert new prior art.

II. ’970 PATENT

A. Priority Date

The application for the ’970 Patent was filed on November 26, 2008, and purports to claim priority to September 21, 2004, through a chain of three continuations-in-part. AGIS claims a priority date of September 21, 2004 in its Infringement Contentions for the ’970 Asserted Claims. But, for the reasons discussed below, no claim of the ’970 Patent is entitled to an earlier effective filing date than November 26, 2008. The Patent Trial and Appeal Board (“PTAB”) previously held the same in IPR2018-010719. (IPR2018-010719, Paper 9, 8; IPR2018-01079, Paper 34).

The ’970 Patent states that “[t]he heart of the invention lies in the forced message alert software application program provided in each PC or PDA/cell phone.” (’970 Patent, 4:47-49). This “forced message alert software application program” is required by every single independent claim (*see id.*, 8:65-9:39 (claim 1) and 10:7-41 (claim 6)) and is also described throughout the specification (*see id.*, 1:19-23, 1:57-67, 2:7-35, 2:49-55, 3:4-14, 3:22-28, 7:8-

8:57). Similar disclosures are not contained in any of the applications to which the '970 Patent claims priority.

The '970 Patent claims priority to three earlier-filed applications: (i) U.S. Application No. 10/711,490 ("490 application"), filed on September 21, 2004; (ii) U.S. Application No. 11/308,648 ("648 application"), filed on April 17, 2006; and (iii) U.S. Application No. 11/612,830 ("830 application"), filed on December 19, 2006. None of these earlier-filed applications provide sufficient written-description support for at least a forced-message alert software-application program, as required by each independent claim of the '970 Patent.

First, the '490 application is directed to employing cellular telephone communications to monitor locations, initiating cellular calls and conference calls with other cellular telephones of a plurality of communications net participants by touching a display screen, and causing a remote cellular phone to annunciate audio announcements or call another phone number. ('490 application, Abstract, 8-32). The '490 application notes that each cellular phone can poll the other cell phones to transmit their location and status. But each of the cellular phones that poll do not include a "forced message alert" in the poll, nor do they track the poll responses. (*Id.* at 14, ¶14). And, in contrast to the '970 patent, the '490 application allows a sending PDA/cell phone to remotely control a recipient PDA/cell phone without action by the remote phone operator:

In spite of the rapid advance in cellular phone technology, it would also be desirable to actuate a remote cellular phone to annunciate an audio message to alert the remote user that there is an emergency (or for another reason) . . . and cause the remote phone to call another phone number (as an example, to automatically establish an 800 number conference call), to vibrate, or increase the loud-ness of an announcement without any action by the re-mote phone operator.

(*Id.* at 9 ¶4). Thus, the '490 application performs steps for remotely controlling recipient phones without a manual response from the recipient remote phone operator. The '490 application does

not teach or suggest a “forced message alert software application program” as described and claimed in the ’970 Patent. Accordingly, the ’970 Patent is not entitled to the priority date of the ’490 application, September 21, 2004.

Second, the ’648 application also does not disclose a forced-message alert as required by the independent claims of the ’970 Patent. The ’648 application is directed to automatically shifting from GPRS/EDGE/CDMA/1XEVD0 to SMS when any cellular phone of a plurality of cellular phones of communication net participants makes or receives a voice call and shift back upon completion of the voice call. (’648 application, Abstract, 16-61). Embodiments also cause an alert (audible voice alert, beep) to emanate from a user’s device when an incoming message arrives, show a location of the sender of a message on the user’s display, and cause an alert (verbal announcement, vibration, or text) when another participant of the communication net participants is within a predetermined distance. (*Id.* at 42-44, ¶¶69, 72, 74). But nowhere does the ’648 application teach or suggest at least a “forced message alert” let alone the “forced message alert software application program” as described and claimed in the ’970 Patent. Accordingly, the ’970 Patent is not entitled to the priority date of the ’648 application, April 17, 2006.

Third, the ’830 application also does not disclose a forced-message alert as required by the independent claims of the ’970 Patent. The ’830 application is directed to a plurality of cellular phone/PDA/GPS devices of communication net participants with advanced communication software (ACS) application programs that can: poll other cell phone/PDA/GPS devices of the plurality for location, status, and identity; and remotely control one or more of the other cell phone/PDA/GPS devices of the plurality. (’830 application, 7-8 (specification pages

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