

1 Robert W. Dickerson, Jr. (SBN 089367)
E-mail: rdickerson@bwslaw.com
2 BURKE, WILLIAMS & SORESENSEN, LLP
444 South Flower Street, Suite 2400
3 Los Angeles, CA 90071-2953
Tel: 213-236-0600
4 Fax: 213-236-2700

5 Patricia L. Peden (SBN 206440)
E-mail: ppeden@bwslaw.com
6 BURKE, WILLIAMS & SORESENSEN, LLP
1901 Harrison Street, Suite 900
7 Oakland, California 94612-3501
Tel: 510-273-8780
8 Fax: 510-839-9104

9 Lenny Huang (SBN 264386)
E-mail: lhuang@bwslaw.com
10 BURKE, WILLIAMS & SORESENSEN, LLP
1 California Street, Suite 3050
11 San Francisco, California 94111-5432
Tel: 408-606-6300
12 Fax: 408-606-6333

13
14 Attorneys for Plaintiffs
SMITH MICRO SOFTWARE, INC. and
15 SMITH MICRO SOFTWARE, LLC

16 UNITED STATES DISTRICT COURT
17 NORTHERN DISTRICT OF CALIFORNIA
18
19 SAN JOSE DIVISION

20 SMITH MICRO SOFTWARE, INC.,
21 and SMITH MICRO SOFTWARE,
LLC

22 Plaintiffs,

23 v.

24 AGIS SOFTWARE
25 DEVELOPMENT LLC, and DOES
1 to 10

26 Defendants.
27
28

Case No. 5:21-cv-3677

**COMPLAINT FOR
DECLARATORY JUDGMENT**

JURY TRIAL DEMANDED

1 Plaintiffs Smith Micro Software, Inc. (“SMSI”) and Smith Micro Software,
2 LLC (“SMSL”) (jointly “Smith Micro” or “Plaintiffs”) hereby bring this Complaint
3 for Declaratory Judgment against Defendant AGIS Software Development LLC
4 (“AGIS Software”) and Does 1-10, and allege as follows:

5 **THE PARTIES**

6 **Smith Micro Software, Inc. and Smith Micro Software, LLC**

7 1. SMSI is a corporation that was originally founded, incorporated, and
8 opened its first office in California in 1983. The company reincorporated in
9 Delaware in 1995 in conjunction with its initial public offering, and the California
10 corporation merged into the Delaware corporation SMSI at that time. SMSI is
11 currently organized under the laws of Delaware. SMSI’s headquarters were located
12 in Aliso Viejo, California until 2019, at which time its office in Pittsburgh,
13 Pennsylvania was designated as the company headquarters.

14 2. SMSI continues to maintain its office in Aliso Viejo, which is the
15 home office for the company’s CEO and other key members of the company’s
16 leadership team, including SMSI’s Chief Technology Officer, who has been with
17 the company since 1989, has held the position of Chief Technology Officer since
18 1999, and resides and works in California.

19 3. SMSL (formerly known as Location Labs, LLC) is a Delaware limited
20 liability company that is wholly owned by SMSI. SMSI acquired Location Labs,
21 LLC and related assets in April, 2021, and at that time changed its name to Smith
22 Micro Software, LLC. As a result of that acquisition, SMSI and/or SMSL have in
23 excess of fifty (50) employees who reside and work in Northern California.

24 4. In terms of the SMSI and SMSL documents and personnel who are
25 most likely to have knowledge and information relevant to the technology at issue
26 in this lawsuit, the majority currently resides and works in California, and many of
27 those work and reside in Northern California.

28 5. SMSI also acquired some of the technology at issue in this lawsuit

1 from Circle Media Labs, Inc., located in Portland, Oregon. Plaintiffs are informed
2 and believe that some documents and personnel having knowledge and information
3 relevant to that technology are located in and around Portland, Oregon, and that
4 trial in Northern California would be much more convenient for them than in
5 Marshall, Texas.

6 6. SMSI and/or SMSL have offices in Northern California in Emeryville,
7 California (where Location Labs, LLC had its headquarters) and also in Petaluma,
8 California. SMSI further maintains certain servers in Santa Clara, California for the
9 operation of its business.

10 7. SMSI and SMSL are both registered to do business in the state of
11 California, and both conduct business in the state of California on a regular and
12 continuous basis.

13 8. Smith Micro is a leading global provider of highly scalable mobile
14 applications and value-added solutions for mobile and cable operators.

15 **AGIS Software and Related Entities**

16 9. Smith Micro is informed and believes that AGIS Software is a Texas
17 limited liability company, listing 100 W. Houston Street, Marshall, Texas 75670 as
18 its office address. According to Google Maps, the only sign on the building at that
19 address says “Truelove Law Firm” and a Google search for the Truelove Law Firm
20 lists its address as 100 W. Houston Street, Marshall, Texas 75670.

21 10. Smith Micro is informed and believes that AGIS Software has no other
22 “office” in Texas; that AGIS Software has no employees who reside or work in
23 Texas; and that AGIS Software does not conduct any meaningful business from its
24 “office” in Marshall, Texas, other than bringing patent infringement lawsuits in the
25 federal district court in Marshall, Texas, in which the Truelove Law Firm acts as
26 local counsel for AGIS Software..

27 11. According to Texas public records, the sole member of AGIS Software
28

1 is AGIS Holdings, Inc. (“AGIS Holdings”). According to Florida public records,
2 AGIS Holdings is organized and existing under the laws of the state of Florida, and
3 maintains its principal place of business at 92 Lighthouse Drive, Jupiter, FL 33469.
4 AGIS Holdings shares the same address with Advanced Ground Information
5 Systems, Inc. (“AGIS”), a corporation organized and existing under the laws of the
6 state of Florida that also maintains its principal place of business at 92 Lighthouse
7 Drive, Jupiter, FL 33469. Smith Micro is informed and believes that neither AGIS
8 nor AGIS Holdings has any office, officers or employees that reside and work in
9 the state of Texas. Hereinafter, AGIS, AGIS Holdings and AGIS Software will be
10 collectively referred to as “the AGIS Companies.”

11 12. Smith Micro is informed and believes that AGIS Holdings registered
12 AGIS Software as an LLC in Texas on June 1, 2017, twenty (20) days before filing
13 patent infringement cases against Apple and ZTE in the Eastern District of Texas.

14 13. Smith Micro is informed and believes that only two months prior to
15 the registration of AGIS Software, AGIS was litigating a patent infringement action
16 in the Southern District of Florida against Life360, Inc., a company headquartered
17 in San Francisco, California (*see Advanced Ground Information Sys., Inc. v.*
18 *Life360, Inc.*, 9:14-cv-80651 (S.D. Fla.)). Based on Public Access to Court
19 Electronic Records (“PACER”), AGIS asserted that Life360 infringed the ’728
20 patent (one of the Patents-in-Suit) and other related patents. Based on PACER,
21 AGIS’s claims against Life360 resulted in a jury finding of no-infringement and, on
22 December 1, 2015, an award of nearly \$700,000 in attorneys’ fees against AGIS for
23 litigating “an exceptionally weak case.” *Id.*, Dkts. 200, 212.

24 14. Smith Micro is informed and believes that AGIS and AGIS Holdings
25 thereafter, in an attempt to remake AGIS and to distance AGIS from the adverse
26 result in *Advanced Ground Information Sys., Inc. v. Life360, Inc.*, 9:14-cv-80651
27 (S.D. Fla.), and from the federal district court in Florida, created the Texas LLC,
28 AGIS Software, and listed its only “office” as being in the Eastern District of

1 Texas. Smith Micro is informed and believes that the creation of AGIS Software as
2 a Texas LLC was a pretext and a façade for the sole purpose of being able to file
3 patent infringement suits in the Eastern District of Texas and allege that AGIS
4 Software “resides” in that judicial district. Smith Micro is informed and believes
5 that the AGIS Companies consider the Eastern District of Texas to be a venue that
6 favors patent plaintiffs, and an inconvenient forum for non-Texas-based defendants,
7 including those primarily located in California.

8 15. Smith Micro does not have access to complete information concerning
9 all of the corporate relationships, responsibilities and decision-making processes
10 within, between and among AGIS, AGIS Holdings, AGIS Software and each of
11 their owners, officers, directors, members and managers, but is informed and
12 believes that from time to time there have been corporate realignments among and
13 between them. Smith Micro therefore reserves the right to add defendants or to
14 substitute the current correct name of a defendant as that information is obtained
15 through discovery, and to amend the complaint to identify a DOE defendant.

16 **NATURE OF THE ACTION**

17 16. Smith Micro brings this action for a declaratory judgment that U.S.
18 Patent Nos. 7,031,728 (“the ‘728 patent”), 7,630,724 (“the ‘724 patent”), 9,408,055
19 (“the ‘055 patent”), 9,445,251 (“the ‘251 patent”), 9,467,838 (“the ‘838 patent”),
20 and 9,749,829 (“the ‘829 patent”) (collectively, the “Patents-in-Suit”) are not
21 infringed, directly or indirectly, by the Family Mode application and systems and
22 the FamilyWhere application and systems (including all related services and
23 infrastructure) owned by Smith Micro (“Accused Products” or “Smith Micro
24 Products”) that Smith Micro sells to T-Mobile USA, Inc., among others.

25 17. Smith Micro acquired the FamilyWhere application and systems as
26 part of its April 2021 acquisition of Avast plc’s Family Safety Mobile Business,
27 mainly based in Emeryville, California, in this judicial district. Smith Micro is
28 informed and believes that the persons involved in the development of the

1 FamilyWhere application and systems, and relevant documents relating thereto, are
2 located in this judicial district.

3 18. Smith Micro also seeks a declaratory judgment that each of the claims
4 of the Patents-in-Suit that has not been invalidated with finality is invalid for failure
5 to comply with at least one or more of 35 U.S.C. §§ 101, 102, 103 and 112.

6 19. In a complaint filed on March 3, 2021 in *AGIS Software Development*
7 *LLC v. T-Mobile USA, Inc., et al.*, 2:21-cv-00072-JRG (E.D. Tex.), AGIS Software
8 asserted the Patents-in-Suit against T-Mobile, USA, Inc. and T-Mobile US, Inc.
9 (collectively, “T-Mobile”) based upon T-Mobile’s sales of the Accused Products.
10 Smith Micro has an adverse legal interest to AGIS Software by virtue of AGIS
11 Software’s patent infringement claims against Smith Micro Products. Smith
12 Micro’s reasonable apprehension that AGIS Software will pursue patent
13 infringement claims against Smith Micro has been amplified by AGIS Software’s
14 recently-filed patent lawsuit against Smith Micro’s customer, T-Mobile, and its
15 products. Accordingly, Plaintiffs seek the declaration requested herein to establish
16 their right to continue to offer and sell their its products in the United States free
17 from suit or threat of suit from AGIS Software for infringement of the Patents-in-
18 Suit.

19 JURISDICTION AND VENUE

20 20. The Court has subject matter jurisdiction over Smith Micro’s
21 declaratory judgment claims relating to patent non-infringement and invalidity
22 under 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

23 21. Smith Micro is informed and believes that AGIS Software is subject to
24 this Court’s specific jurisdiction, pursuant to due process and/or the California
25 Long Arm Statute due to: (1) the activities by AGIS Software and/or AGIS over a
26 long period of time purposefully directed at the state of California, including at
27 residents of this state; (2) AGIS Software and/or AGIS having over a long period of
28 time performed purposeful acts intended to harm residents of the state of California;

1 (3) AGIS Software and/or AGIS having engaged in business-related activities over
2 a long period of time that are directed to customers and potential customers in the
3 state of California such that AGIS Software and/or AGIS have purposefully availed
4 themselves of the privilege of doing business in this state; and (4) the claims
5 asserted herein arise out of or relate to activities by AGIS Software and/or AGIS
6 within and directed at this forum.

7 22. Smith Micro is informed and believes that AGIS Software is an agent
8 and alter ego of AGIS and AGIS Holdings. Smith Micro is further informed and
9 believes that Mr. Malcom K. Beyer, Jr., (“Mr. Beyer”), who is a named inventor on
10 each of the Patents-in Suit, is an owner, member, managing member, officer and/or
11 director of each of the AGIS Companies, including AGIS and AGIS Software.

12 23. Smith Micro is further informed and believes that Mr. Beyer has at all
13 relevant times been actively involved in directing the business activities of each of
14 the AGIS Companies.

15 24. Smith Micro is further informed and believes (based upon records of
16 the U.S. Patent & Trademark Office (“USPTO”) and PACER) that AGIS Software
17 holds itself out as the successor-in-interest with respect to ownership and
18 enforcement of the Patents-in-Suit through acquisition from AGIS Holdings and
19 AGIS.

20 25. Smith Micro is informed and believes that AGIS Software and/or
21 AGIS have taken intentional and purposeful steps to enforce the Patents-in-Suit
22 against residents of this judicial district, including by suing companies that Mr.
23 Beyer and the AGIS Companies knew had their principal places of business or
24 operations in this judicial district for infringement of the Patents-in-Suit.

25 26. Based on PACER, on June 21, 2017, AGIS Software sued Apple Inc.
26 (“Apple”), a California corporation with its principal place of business at One
27 Apple Park Way, Cupertino, California 95014, alleging infringement of patents
28 including the ’055 patent, ’251 patent, ’838 patent, and ’829 patent. *See AGIS*

1 *Software Development LLC v. Apple Inc.*, 2:17-cv-00516 (E.D. Tex.). Based on
2 USPTO records, on July 31, 2018, Apple filed a petition for *inter partes review* of
3 the '829 patent (IPR2018-01471). Based on USPTO records, on December 13,
4 2018, Apple filed a petition for *inter partes review* of the '055 patent (IPR2019-
5 00432). Based on USPTO records, on January 3, 2019, Apple filed petitions for
6 *inter partes review* of the '251 patent (IPR2019-00523, IPR2019-00524). Based on
7 USPTO records, on or around April 2, 2019, each of these *inter partes review*
8 proceedings were terminated as a result of the Apple and AGIS Software reaching a
9 settlement agreement. *See, e.g.*, "Decision Granting Joint Motion to Terminate and
10 Granting Request to Treat Settlement Document as Confidential Business
11 Information," IPR2018-01471, Paper No. 15. Based on PACER, on March 14,
12 2019, the Eastern District of Texas dismissed the district court litigation between
13 AGIS Software and Apple as a result of a settlement between the parties. Order,
14 *AGIS Software Development LLC v. Apple Inc.*, 2:17-cv-00516 (E.D. Tex. Mar. 14,
15 2019), Dkt. 87.

16 27. Based on PACER, on June 21, 2017, AGIS Software sued ZTE
17 Corporation and ZTE (TX) Inc. alleging infringement of patents, including the '055
18 patent, the '251 patent, the '838 patent, and the '829 patent. *AGIS Software*
19 *Development LLC v. ZTE Corporation*, 2:17-v-00517 (E.D. Tex.). Based on
20 PACER, on October 17, 2017, AGIS Software filed an amended complaint, adding
21 ZTE (USA) Inc. to this litigation. Smith Micro is informed and believes that ZTE
22 (USA) Inc. has an office located at 1900 McCarthy Boulevard, Milpitas, California
23 95035. Smith Micro is informed and believes that ZTE (TX) Inc. keeps its
24 principal place of business at 1900 McCarthy Boulevard, Milpitas, CA 95035.

25 28. Based on PACER, on October 9, 2018, ZTE (USA) Inc. filed a
26 declaratory judgment action against AGIS Software in the Northern District of
27 California; AGIS filed a Motion to Dismiss based upon lack of personal
28 jurisdiction, and for sanctions; on September 12, 2019, the Court denied the request

1 for sanctions, and allowed jurisdiction discovery to proceed on the Motion to
2 Dismiss (Dkt 114); and on October 30, 2019, AGIS Software and ZTE (USA) Inc.
3 filed a joint motion to stay all deadlines as a result of a settlement in principle (*ZTE*
4 *(USA) Inc. v. AGIS Software Development LLC*, No. 4:18-cv-06185-HSG (N.D.
5 Cal. Oct. 30, 2019, Dkt. 130). Based on PACER, less than a week later, on
6 November 4, 2019, AGIS Software filed an unopposed renewed motion to dismiss.
7 *Id.*, Dkt. 135; and on November 5, 2019, the Court granted the unopposed motion.
8 *Id.*, Dkt. 138.

9 29. Based on PACER, on January 29, 2021, AGIS Software sued
10 WhatsApp LLC in the United States District Court for the Eastern District of Texas,
11 accusing WhatsApp of infringing the Patents-In-Suit (Case No. 2:21-cv-00029,
12 E.D. Tex.). WhatsApp LLC is a Delaware corporation with its principal place of
13 business in Menlo Park, California.

14 30. Based on PACER, on April 27, 2021, WhatsApp LLC filed a suit for
15 declaratory judgment against AGIS Software Development LLC in the United
16 States District Court for the Northern District of California (Case No. 5:21-cv-
17 03076-BLF) seeking a judgment that WhatsApp does not infringe, under any theory
18 of infringement, any valid claim of the Patents-in-Suit.

19 31. Smith Micro is informed and believes that AGIS Software has entered
20 into agreements relating to the Patents-in-Suit with Apple and ZTE Corporation,
21 ZTE (USA) Inc., and ZTE (TX) Inc. (“ZTE”). Apple is headquartered in
22 California. Smith Micro is informed and believes that ZTE does business in the
23 state of California.

24 32. AGIS Software has also sued other companies for alleged patent
25 infringement of the Patents-in-Suit, including Waze (its U.S. office is in Menlo
26 Park, California), Uber (its headquarters are in San Francisco, California) and Lyft
27 (also headquartered in San Francisco, California).

28 33. Smith Micro is informed and believes that AGIS (and/or its alter egos)

1 have committed a number of other business-related intentional acts directed at the
2 state of California.

3 34. Smith Micro is informed and believes that AGIS has marketed and/or
4 provided downloads of its LifeRing product, which AGIS Software contends is
5 covered by one or more of the Patents-in-Suit, in California. For example, AGIS
6 has a website (<https://www.agisinc.com/>). The website is not passive and is not
7 purely informational. Rather, the website is commercially active, is for a
8 commercial purpose, and is accessible in the state of California to entities and
9 individuals residing in this state. The LifeRing software is available on the AGIS
10 website for downloading upon request, including by residents in the state of
11 California. AGIS actively does business over the Internet via this website (among
12 other ways), including to residents in the state of California. Smith Micro is
13 informed and believes that AGIS (and/or its alter egos) transact business and
14 engage in the knowing and repeated transmission of computer files over the
15 Internet, including into California.

16 35. The issue of whether AGIS is subject to specific personal jurisdiction
17 in this judicial district has been previously addressed by the district court for the
18 Northern District of California. On January 12, 2015, AGIS was sued in the
19 Northern District of California by Life360, Inc. *See Life360, Inc. v. Advanced*
20 *Ground Sys., Inc.*, 2014 WL 5612008 (ND Cal Case No. 5:15-cv-00151-BLF) (“the
21 Life360 case”), in which Life360 asserted claims against AGIS for false marking
22 (that is, that AGIS had marked products with patent numbers, including one or
23 more of the Patents-in-Suit, even though the “marked” product was not covered by
24 the patent(s)); for tortious interference with contract (that is, AGIS threatened to sue
25 The ADT Corporation (“ADT”), which was an investor in Life360, for patent
26 infringement); and for interference with economic advantage (that is, AGIS, in
27 threatening ADT with infringement, had misrepresented the scope of AGIS’s
28 patents, Life360’s potential liability, and ADT’s potential liability). Life360

1 asserted that AGIS engaged in this activity intentionally to interfere with Life360's
2 contractual relationship and prospective economic advantage with ADT, "and to
3 thereby pressure Life360 into settling a meritless lawsuit." (*Id.*, Dkt 1).

4 36. On March 18, 2015, AGIS filed a Motion to Dismiss the Life360 case
5 for lack of jurisdiction and lack of proper service of process (*id.*, Dkt. 19). Life360
6 then filed a motion for leave to conduct jurisdictional discovery of AGIS (*id.*, Dkt.
7 24), which was granted by the Court on May 5, 2015 (*id.*, Dkt. 36). After that
8 discovery, and all briefing and submission of evidence by the parties on the motion,
9 the Court denied AGIS's motion to dismiss for lack of personal jurisdiction (*id.*,
10 Dkt. 52).

11 37. In that well-reasoned Order, the Court found that AGIS had marketed
12 its LifeRing product into California, and held that "marketing LifeRing into
13 California is an act expressly aimed at the forum state itself." (*Id.* 2014 WL
14 5612008 at *10). The Court then addressed other ways in which AGIS had
15 contacts with the state of California and purposefully availed itself of the privilege
16 of doing business in California, and concluded that Life360 had made a more than
17 sufficient showing that met all prongs of the purposeful direction test for specific
18 personal jurisdiction over AGIS.

19 38. In this regard, Smith Micro is informed and believes that in 2014, Mr.
20 Beyer, acting as the CEO of both AGIS Software and AGIS, attended a U.S. Navy
21 military exercise in San Diego where he demonstrated LifeRing on PCs and
22 smartphones when asked to do so. (*Id.*, 2014 WL 5612008, at *3). Smith Micro is
23 informed and believes that during this demonstration, Mr. Beyer also discussed
24 LifeRing with companies including ADI Technology and Maven Consulting. (*Id.*).

25 39. Smith Micro is informed and believes that AGIS marketed LifeRing to
26 companies that resulted in downloads of LifeRing in California. (*Id.* at *4). Smith
27 Micro is informed and believes that AGIS marketed LifeRing to at least
28 CornerTurn LLC, Integrity Applications, and American Reliance, Inc., which AGIS

1 has stated reside in California. (*Id.*).

2 40. Smith Micro is informed and believes that AGIS has marked LifeRing
3 as covered by the Patents-in-Suit. *See, e.g.*, AGIS Website | Patents,
4 <http://agisinc.com/about/patents> (last visited May 17, 2021). Smith Micro is
5 informed and believes that AGIS Software has licensed the Patents-in-Suit to end
6 users residing in California who have downloaded the LifeRing software in this
7 state from the AGIS Website.

8 41. Smith Micro is informed and believes that AGIS also formed a
9 “strategic partnership” with Green Hills Software, Inc., a California company and
10 security software firm located in Santa Barbara, California. (*See* the Life360 case,
11 2014 WL 5612008, at *4).

12 42. As a result of the foregoing allegations, AGIS Software either
13 individually or as an alter ego of AGIS and as the current owner of the Patents-in-
14 Suit which were involved in its predecessor-in-interest’s contacts with California, is
15 subject to specific personal jurisdiction within this judicial district.

16 43. Since the Court’s Order was entered in the Life360 case, there have
17 been additional and continued intentional and purposeful activities by AGIS
18 Software, its predecessors and alter-egos that have contacted, done business, and
19 caused harm in the state of California.

20 44. Specific personal jurisdiction over AGIS Software exists in this
21 judicial district.

22 45. It is AGIS Software’s burden to set forth a compelling case as to why
23 exercise of specific personal jurisdiction of it in this matter would not be
24 reasonable. Given all of the acts by which AGIS Software, its predecessors and
25 alter-egos have intentionally and purposefully made contacts, conducted business,
26 and caused harm in the state of California, no such compelling case can be made.

27 46. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 in
28 that a substantial part of the acts giving rise to the claim occurred in this judicial

1 district, and because AGIS Software is subject to personal jurisdiction in this
2 district based upon it owns acts as alleged above, and based upon the cumulative
3 acts of the AGIS companies as alter-egos of one another, and/or pursuant to the
4 corporate succession doctrine. This venue is also a convenient forum for all parties,
5 and on balance is much more convenient than the Eastern District of Texas.

6 **COUNT I**

7 **Declaratory Relief Regarding Non-Infringement**

8 **of U.S. Patent No. 7,031,728**

9 47. Smith Micro restates and incorporates by reference each of the
10 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

11 48. Smith Micro is informed and believes that AGIS Software is the
12 current owner by assignment from another AGIS Company of all right, title, and
13 interest in the '728 patent, including the right to assert all causes of action arising
14 under that patent and the right to any remedies for infringement of it. A copy of the
15 '728 patent is attached hereto as Exhibit A.

16 49. Smith Micro has a reasonable apprehension that AGIS Software will
17 assert the '728 patent against Smith Micro or Smith Micro's current and future
18 customers in the United States for alleged infringement of the '728 patent, based on
19 AGIS Software's allegation against T-Mobile that the Accused Products infringe
20 the '728 patent.

21 50. Smith Micro does not infringe any claim of the '728 patent, directly or
22 indirectly, contributorily or otherwise through its or its users' activities in
23 conjunction with the Accused Products or any other Smith Micro product.

24 51. An actual and justiciable controversy has arisen between Smith Micro
25 and AGIS Software that is properly presented for judicial relief under the
26 Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. AGIS Software has sued
27 T-Mobile for patent infringement based on the allegation that Smith Micro's
28 Accused Products infringe the '728 patent. AGIS Software's patent infringement

1 claims establish that Smith Micro and AGIS Software have adverse legal interests
2 with respect to the sale of Smith Micro's Accused Products. AGIS Software's
3 actions have and will continue to negatively affect Smith Micro's legal relations
4 concerning its sales of the Accused Products in the United States. AGIS Software
5 has taken a position that puts Smith Micro in the position of either pursuing
6 allegedly infringing behavior or abandoning that which Smith Micro claims a right
7 to do, namely, continuing to offer and sell the Accused Products. Smith Micro thus
8 requests a judicial determination and declaration of the respective rights of the
9 parties.

10 **COUNT II**

11 **Declaratory Relief Regarding Non-Infringement** 12 **of U.S. Patent No. 7,630,724**

13 52. Smith Micro restates and incorporates by reference each of the
14 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

15 53. Smith Micro is informed and believes that AGIS Software is the
16 current owner by assignment from another AGIS Company of all right, title, and
17 interest in the '724 patent, including the right to assert all causes of action arising
18 under that patent and the right to any remedies for infringement of it. A copy of the
19 '724 patent is attached hereto as Exhibit B.

20 54. Smith Micro has a reasonable apprehension that AGIS Software will
21 assert the '724 patent against Smith Micro or Smith Micro's current and future
22 customers in the United States for alleged infringement of the '724 patent, based on
23 AGIS Software's allegation against T-Mobile that the Accused Products infringe
24 the '724 patent.

25 55. Smith Micro does not infringe any claim of the '724 patent, directly or
26 indirectly, contributorily or otherwise through its or its users' activities in
27 conjunction with the Accused Products or any other Smith Micro product.

28 56. An actual and justiciable controversy has arisen between Smith Micro

1 and AGIS Software that is properly presented for judicial relief under the
2 Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. AGIS Software has sued
3 T-Mobile for patent infringement based on the allegation that Smith Micro's
4 Accused Products infringe the '724 patent. AGIS Software's patent infringement
5 claims establish that Smith Micro and AGIS Software have adverse legal interests
6 with respect to the sale of Smith Micro's Accused Products. AGIS Software's
7 actions have and will continue to negatively affect Smith Micro's legal relations
8 concerning its sales of the Accused Products in the United States. AGIS Software
9 has taken a position that puts Smith Micro in the position of either pursuing
10 allegedly infringing behavior or abandoning that which Smith Micro claims a right
11 to do, namely, continuing to offer and sell the Accused Products. Smith Micro thus
12 requests a judicial determination and declaration of the respective rights of the
13 parties.

14 **COUNT III**

15 **Declaratory Relief Regarding Non-Infringement** 16 **of U.S. Patent No. 9,408,055**

17 57. Smith Micro restates and incorporates by reference each of the
18 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

19 58. Smith Micro is informed and believes that AGIS Software is the
20 current owner by assignment from another AGIS Company of all right, title, and
21 interest in the '055 patent, including the right to assert all causes of action arising
22 under that patent and the right to any remedies for infringement of it. A copy of the
23 '055 patent is attached hereto as Exhibit C.

24 59. Smith Micro has a reasonable apprehension that AGIS Software will
25 assert the '055 patent against Smith Micro or Smith Micro's current and future
26 customers in the United States for alleged infringement of the '055 patent, based on
27 AGIS Software's allegation against T-Mobile that the Accused Products infringe
28 the '055 patent.

1 assert the '251 patent against Smith Micro or Smith Micro's current and future
2 customers in the United States for alleged infringement of the '251 patent, based on
3 AGIS Software's allegation against T-Mobile that the Accused Products infringe
4 the '251 patent.

5 65. Smith Micro does not infringe any claim of the '251 patent, directly or
6 indirectly, contributorily or otherwise through its or its users' activities in
7 conjunction with the Accused Products or any other Smith Micro product.

8 66. An actual and justiciable controversy has arisen between Smith Micro
9 and AGIS Software that is properly presented for judicial relief under the
10 Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. AGIS Software has sued
11 T-Mobile for patent infringement based on the allegation that Smith Micro's
12 Accused Products infringe the '251 patent. AGIS Software's patent infringement
13 claims establish that Smith Micro and AGIS Software have adverse legal interests
14 with respect to the sale of Smith Micro's Accused Products. AGIS Software's
15 actions have and will continue to negatively affect Smith Micro's legal relations
16 concerning its sales of the Accused Products in the United States. AGIS Software
17 has taken a position that puts Smith Micro in the position of either pursuing
18 allegedly infringing behavior or abandoning that which Smith Micro claims a right
19 to do, namely, continuing to offer and sell the Accused Products. Smith Micro thus
20 requests a judicial determination and declaration of the respective rights of the
21 parties.

22 **COUNT V**

23 **Declaratory Relief Regarding Non-Infringement**

24 **of U.S. Patent No. 9,467,838**

25 67. Smith Micro restates and incorporates by reference each of the
26 allegations set forth in paragraphs 1 - 46, as if fully set forth herein.

27 68. Smith Micro is informed and believes that AGIS Software is the
28 current owner by assignment from another AGIS Company of all right, title, and

1 interest in the '838 patent, including the right to assert all causes of action arising
2 under that patent and the right to any remedies for infringement of it. A copy of the
3 '838 patent is attached hereto as Exhibit E.

4 69. Smith Micro has a reasonable apprehension that AGIS Software will
5 assert the '838 patent against Smith Micro or Smith Micro's current and future
6 customers in the United States for alleged infringement of the '838 patent, based on
7 AGIS Software's allegation against T-Mobile that the Accused Products infringe
8 the '838 patent.

9 70. Smith Micro does not infringe any claim of the '838 patent, directly or
10 indirectly, contributorily or otherwise through its or its users' activities in
11 conjunction with the Accused Products or any other Smith Micro product.

12 71. An actual and justiciable controversy has arisen between Smith Micro
13 and AGIS Software that is properly presented for judicial relief under the
14 Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. AGIS Software has sued
15 T-Mobile for patent infringement based on the allegation that Smith Micro's
16 Accused Products infringe the '838 patent. AGIS Software's patent infringement
17 claims establish that Smith Micro and AGIS Software have adverse legal interests
18 with respect to the sale of Smith Micro's Accused Products. AGIS Software's
19 actions have and will continue to negatively affect Smith Micro's legal relations
20 concerning its sales of the Accused Products in the United States. AGIS Software
21 has taken a position that puts Smith Micro in the position of either pursuing
22 allegedly infringing behavior or abandoning that which Smith Micro claims a right
23 to do, namely, continuing to offer and sell the Accused Products. Smith Micro thus
24 requests a judicial determination and declaration of the respective rights of the
25 parties.

26 ///

27 ///

28 ///

COUNT VI

**Declaratory Relief Regarding Non-Infringement
of U.S. Patent No. 9,749,829**

1
2
3
4 72. Smith Micro restates and incorporates by reference each of the
5 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

6 73. Smith Micro is informed and believes that AGIS Software is the
7 current owner by assignment from another AGIS Company of all right, title, and
8 interest in the '829 patent, including the right to assert all causes of action arising
9 under that patent and the right to any remedies for infringement of it. A copy of the
10 '829 patent is attached hereto as Exhibit F.

11 74. Smith Micro has a reasonable apprehension that AGIS Software will
12 assert the '829 patent against Smith Micro or Smith Micro's current and future
13 customers in the United States for alleged infringement of the '829 patent, based on
14 AGIS Software's allegation against T-Mobile that the Accused Products infringe
15 the '829 patent.

16 75. Smith Micro does not infringe any claim of the '829 patent, directly or
17 indirectly, contributorily or otherwise through its or its users' activities in
18 conjunction with the Accused Products or any other Smith Micro product.

19 76. An actual and justiciable controversy has arisen between Smith Micro
20 and AGIS Software that is properly presented for judicial relief under the
21 Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. AGIS Software has sued
22 T-Mobile for patent infringement based on the allegation that Smith Micro's
23 Accused Products infringe the '829 patent. AGIS Software's patent infringement
24 claims establish that Smith Micro and AGIS Software have adverse legal interests
25 with respect to the sale of Smith Micro's Accused Products. AGIS Software's
26 actions have and will continue to negatively affect Smith Micro's legal relations
27 concerning its sales of the Accused Products in the United States. AGIS Software
28 has taken a position that puts Smith Micro in the position of either pursuing

1 allegedly infringing behavior or abandoning that which Smith Micro claims a right
2 to do, namely, continuing to offer and sell the Accused Products. Smith Micro thus
3 requests a judicial determination and declaration of the respective rights of the
4 parties.

5 **COUNT VII**
6 **Declaratory Relief Regarding Invalidity**
7 **of U.S. Patent No. 7,031,728**

8 77. Smith Micro restates and incorporates by reference each of the
9 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

10 78. Smith Micro is informed and believes that AGIS Software is the
11 current owner by assignment from another AGIS Company of all right, title, and
12 interest in the '728 patent, including the right to assert all causes of action arising
13 under that patent and the right to any remedies for infringement of it.

14 79. Smith Micro is informed and believes that all claims of the '728 Patent
15 other than claims 1-2 and 7-9 were found to be invalid with finality in *Advanced*
16 *Ground Information Sys., Inc. v. Life360, Inc.*, 9:14-cv-80651 (S.D. Fla.)

17 80. Smith Micro has a reasonable apprehension that AGIS Software will
18 assert the '728 patent against Smith Micro or Smith Micro's current and future
19 customers in the United States for alleged infringement of the '728 patent, based on
20 AGIS Software's allegation against T-Mobile that the Accused Products infringe
21 the '728 patent.

22 81. Each of the claims of the '728 patent that has not been invalidated with
23 finality is invalid for failure to comply with at least one or more conditions for
24 patentability set forth in one or more provisions of 35 U.S.C. §§ 101, 102, 103
25 and/or 112.

26 82. AGIS Software has sued T-Mobile for patent infringement based on
27 the allegation that Smith Micro's Accused Products infringe the '728 patent.

28 83. AGIS Software's patent infringement claims establish that Smith

1 Micro and AGIS Software have adverse legal interests with respect to the sale of
2 Smith Micro's Accused Products.

3 84. AGIS Software's actions have and will continue to negatively affect
4 Smith Micro's legal relations concerning its sales of the Accused Products in the
5 United States. AGIS Software has taken a position that puts Smith Micro in the
6 position of either pursuing allegedly infringing behavior or abandoning that which
7 Smith Micro claims a right to do, namely, continuing to offer and sell the Accused
8 Products. Smith Micro thus requests a judicial determination and declaration of the
9 respective rights of the parties.

10 **COUNT VIII**

11 **Declaratory Relief Regarding Invalidity**

12 **of U.S. Patent No. 7,630,724**

13 85. Smith Micro restates and incorporates by reference each of the
14 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

15 86. Smith Micro is informed and believes that AGIS Software is the
16 current owner by assignment from another AGIS Company of all right, title, and
17 interest in the '724 patent, including the right to assert all causes of action arising
18 under that patent and the right to any remedies for infringement of it.

19 87. Smith Micro has a reasonable apprehension that AGIS Software will
20 assert the '724 patent against Smith Micro or Smith Micro's current and future
21 customers in the United States for alleged infringement of the '724 patent, based on
22 AGIS Software's allegation against T-Mobile that the Accused Products infringe
23 the "724 patent.

24 88. Each of the claims of the '724 patent that has not been invalidated with
25 finality is invalid for failure to comply with at least one or more conditions for
26 patentability set forth in one or more provisions of 35 U.S.C. §§ 101, 102, 103
27 and/or 112.

28 89. AGIS Software has sued T-Mobile for patent infringement based on

1 the allegation that Smith Micro’s Accused Products infringe the ‘724 patent.

2 90. AGIS Software’s patent infringement claims establish that Smith
3 Micro and AGIS Software have adverse legal interests with respect to the sale of
4 Smith Micro’s Accused Products.

5 91. AGIS Software’s actions have and will continue to negatively affect
6 Smith Micro’s legal relations concerning its sales of the Accused Products in the
7 United States. AGIS Software has taken a position that puts Smith Micro in the
8 position of either pursuing allegedly infringing behavior or abandoning that which
9 Smith Micro claims a right to do, namely, continuing to offer and sell the Accused
10 Products. Smith Micro thus requests a judicial determination and declaration of the
11 respective rights of the parties.

12 **COUNT IX**

13 **Declaratory Relief Regarding Invalidity**

14 **of U.S. Patent No. 9,408,055**

15 92. Smith Micro restates and incorporates by reference each of the
16 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

17 93. Smith Micro is informed and believes that AGIS Software is the
18 current owner by assignment from another AGIS Company of all right, title, and
19 interest in the ‘055 patent, including the right to assert all causes of action arising
20 under that patent and the right to any remedies for infringement of it.

21 94. Smith Micro is informed and believes that in a decision entered by the
22 Patent Trial and Appeal Board (“PTAB”) on December 2, 2019, claims 1, 2, 5–7,
23 14, 15, 17, 21–25, 27, 28, 30, 32–34, 36, 37, 40–43, 45, 49, and 54 of the ‘055
24 Patent were found to be invalid.

25 95. Smith Micro has a reasonable apprehension that AGIS Software will
26 assert the ‘055 patent against Smith Micro or Smith Micro’s current and future
27 customers in the United States for alleged infringement of the ‘055 patent, based on
28 AGIS Software’s allegation against T-Mobile that the Accused Products infringe

1 the '055 patent.

2 96. Each of the claims of the '055 patent that has not been invalidated with
3 finality is invalid for failure to comply with at least one or more conditions for
4 patentability set forth in one or more provisions of 35 U.S.C. §§ 101, 102, 103
5 and/or 112.

6 97. AGIS Software has sued T-Mobile for patent infringement based on
7 the allegation that Smith Micro's Accused Products infringe the '055 patent.

8 98. AGIS Software's patent infringement claims establish that Smith
9 Micro and AGIS Software have adverse legal interests with respect to the sale of
10 Smith Micro's Accused Products.

11 99. AGIS Software's actions have and will continue to negatively affect
12 Smith Micro's legal relations concerning its sales of the Accused Products in the
13 United States. AGIS Software has taken a position that puts Smith Micro in the
14 position of either pursuing allegedly infringing behavior or abandoning that which
15 Smith Micro claims a right to do, namely, continuing to offer and sell the Accused
16 Products. Smith Micro thus requests a judicial determination and declaration of the
17 respective rights of the parties.

18 **COUNT X**

19 **Declaratory Relief Regarding Invalidity**

20 **of U.S. Patent No. 9,445,251**

21 100. Smith Micro restates and incorporates by reference each of the
22 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

23 101. Smith Micro is informed and believes that AGIS Software is the
24 current owner by assignment from another AGIS Company of all right, title, and
25 interest in the '251 patent, including the right to assert all causes of action arising
26 under that patent and the right to any remedies for infringement of it.

27 102. Smith Micro has a reasonable apprehension that AGIS Software will
28 assert the '251 patent against Smith Micro or Smith Micro's current and future

1 customers in the United States for alleged infringement of the ‘251 patent, based on
2 AGIS Software’s allegation against T-Mobile that the Accused Products infringe
3 the ‘251 patent.

4 103. Each of the claims of the ‘251 patent that has not been invalidated with
5 finality is invalid for failure to comply with at least one or more conditions for
6 patentability set forth in one or more provisions of 35 U.S.C. §§ 101, 102, 103
7 and/or 112.

8 104. AGIS Software has sued T-Mobile for patent infringement based on
9 the allegation that Smith Micro’s Accused Products infringe the ‘251 patent.

10 105. AGIS Software’s patent infringement claims establish that Smith
11 Micro and AGIS Software have adverse legal interests with respect to the sale of
12 Smith Micro’s Accused Products.

13 106. AGIS Software’s actions have and will continue to negatively affect
14 Smith Micro’s legal relations concerning its sales of the Accused Products in the
15 United States. AGIS Software has taken a position that puts Smith Micro in the
16 position of either pursuing allegedly infringing behavior or abandoning that which
17 Smith Micro claims a right to do, namely, continuing to offer and sell the Accused
18 Products. Smith Micro thus requests a judicial determination and declaration of the
19 respective rights of the parties.

20 **COUNT XI**

21 **Declaratory Relief Regarding Invalidity**

22 **of U.S. Patent No. 9,467,838**

23 107. Smith Micro restates and incorporates by reference each of the
24 allegations set forth in paragraphs 1 - 46 above, as if fully set forth herein.

25 108. Smith Micro is informed and believes that AGIS Software is the
26 current owner by assignment from another AGIS Company of all right, title, and
27 interest in the ‘838 patent, including the right to assert all causes of action arising
28 under that patent and the right to any remedies for infringement of it.

1 interest in the '829 patent, including the right to assert all causes of action arising
2 under that patent and the right to any remedies for infringement of it.

3 116. Smith Micro has a reasonable apprehension that AGIS Software will
4 assert the '829 patent against Smith Micro or Smith Micro's current and future
5 customers in the United States for alleged infringement of the '829 patent, based on
6 AGIS Software's allegation against T-Mobile that the Accused Products infringe
7 the '829 patent.

8 117. Each of the claims of the '829 patent that has not been invalidated with
9 finality is invalid for failure to comply with at least one or more conditions for
10 patentability set forth in one or more provisions of 35 U.S.C. §§ 101, 102, 103
11 and/or 112.

12 118. AGIS Software has sued T-Mobile for patent infringement based on
13 the allegation that Smith Micro's Accused Products infringe the '829 patent.

14 119. AGIS Software's patent infringement claims establish that Smith
15 Micro and AGIS Software have adverse legal interests with respect to the sale of
16 Smith Micro's Accused Products.

17 120. AGIS Software's actions have and will continue to negatively affect
18 Smith Micro's legal relations concerning its sales of the Accused Products in the
19 United States. AGIS Software has taken a position that puts Smith Micro in the
20 position of either pursuing allegedly infringing behavior or abandoning that which
21 Smith Micro claims a right to do, namely, continuing to offer and sell the Accused
22 Products. Smith Micro thus requests a judicial determination and declaration of the
23 respective rights of the parties.

24 **PRAYER FOR RELIEF**

25 WHEREFORE, Plaintiffs respectfully pray for judgment in their favor and
26 against AGIS Software, as follows:

27 1. For a judicial determination and declaration that Smith Micro has not
28 infringed and is not infringing, directly or indirectly, any valid claim of the Patents-

1 in-Suit;

2 2. For a judicial determination and declaration that each claim of the
3 Patents-in-Suit that has not been invalidated with finality is invalid;

4 3. For injunctive relief against AGIS Software, and all entities (including
5 AGIS and AGIS Holding) and persons acting on its behalf or in concert with each
6 of them, restraining them from further prosecuting or instituting any action against
7 either Plaintiff, or any of their upstream suppliers or downstream distributors and
8 users, claiming the Patents-in-Suit are infringed, or from representing publicly or in
9 any other way whatsoever, that Smith Micro's Products or services, or that others'
10 use thereof, infringe any claim of any Patents-in-Suit;

11 4. For a declaration that this case is exceptional under 35 U.S.C. § 285
12 and for an award of attorneys' fees and costs in this action; and

13 5. For such other and further relief as this Court may deem just and
14 proper.

15 May 17, 2021

Respectfully Submitted,

BURKE, WILLIAMS & SORENSEN, LLP

18 By: /s/ Robert W. Dickerson, Jr.

Robert W. Dickerson, Jr.

19
20 Attorneys for Plaintiffs
SMITH MICRO SOFTWARE, INC. and
21 SMITH MICRO SOFTWARE, LLC
22
23
24
25
26
27
28

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

DEMAND FOR JURY

Plaintiffs Smith Micro Software, Inc. and Smith Micro Software, LLC
hereby requests a trial by jury for all issues properly submitted to a jury.

Respectfully submitted,

Dated: May 17, 2021

BURKE, WILLIAMS & SORENSEN,
LLP

By: /s/ Robert W. Dickerson, Jr.

Robert W. Dickerson, Jr.

Attorneys for Plaintiffs
SMITH MICRO SOFTWARE, INC. and
SMITH MICRO SOFTWARE, LLC