1   DARIN SNYDER (CA S.B. #136003)   STACY YAE (CA S.B. #315663)
     dsnyder@omm.com   syae@omm.com
2   LUANN L. SIMMONS (CA S.B. #203526)   **O'MELVENY & MYERS LLP**
     lsimmons@omm.com   400 South Hope Street, 18th Floor
3   MARK LIANG (CA S.B. # 278487)   Los Angeles, California 90071
     mliang@omm.com   Telephone: +1 213 430 6000
4   BILL TRAC (CA S.B. #281437)
     btrac@omm.com   CASON COLE (TX S.B. #24109741)
5   AMY LIANG (CA S.B. #291910)   ccole@omm.com
     aliang@omm.com   GRANT GIBSON (TX S.B.
6   SORIN ZAHARIA (CA S.B. #312655)   #24117859)
     szaharia@omm.com   ggibson@omm.com
7   DANIEL SILVERMAN (CA S.B. #319874)   **O'MELVENY & MYERS LLP**
     dsilverman@omm.com   2501 N. Harwood St., 17th Floor
8   **O'MELVENY & MYERS LLP**   Dallas, Texas 75201
     Two Embarcadero Center, 28th Floor   Telephone: +1 972 360 1916
9   San Francisco, California 94111-3823
     Telephone: +1 415 984 8700
10
     Attorneys for Plaintiff
11   *Google LLC*

12   **UNITED STATES DISTRICT COURT**

13   **NORTHERN DISTRICT OF CALIFORNIA**

14   **SAN JOSE DIVISION**

15

16
     GOOGLE LLC,   Case No. 5:23-cv-03624-BLF
17
                    Plaintiff,   **AMENDED COMPLAINT FOR
18   DECLARATORY JUDGMENT**
     v.
19   **DEMAND FOR JURY TRIAL**
     AGIS HOLDINGS, INC., ADVANCED
20   GROUND INFORMATION SYSTEMS,
     INC., AND AGIS SOFTWARE
21   DEVELOPMENT LLC,

22   Defendants.

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                                             PLAINTIFF'S AMENDED COMPLAINT
                                             FOR DECLARATORY JUDGMENT
                                             CASE NO. 5:23-CV-03624-BLF

1   Plaintiff Google LLC ("Google") brings this action for declaratory judgment against

2 Defendants AGIS Holdings, Inc. ("AGIS Holdings"), Advanced Ground Information Systems,

3 Inc. ("AGIS, Inc."), and AGIS Software Development LLC ("AGIS Software") (collectively

4 "AGIS" or "AGIS Entities") and alleges:

5   **NATURE OF THE ACTION**

6   1.   This is an action for declaratory judgment of non-infringement, invalidity, and

7 unenforceability of U.S. Patent No. 8,213,970 ("'970 Patent") (attached hereto as Exhibit L)

8 against AGIS pursuant to the Declaratory Judgment Act, 28 U.S.C. §§ 2201-02, and the patent

9 laws of the United States, 35 U.S.C. § 100 et seq., and for other relief the Court deems just and

10 proper.

11   2.   Google requests this relief because AGIS has asserted in multiple cases that

12 Google and others infringe the '970 Patent based on Google's Find My Device ("FMD")

13 application.

14   3.   In 2017, AGIS Software asserted infringement of the '970 Patent based on FMD in

15 cases filed in the Eastern District of Texas ("EDTX"), against Huawei, LG, ZTE, and HTC. *See*

16 *AGIS Software Development LLC v. ZTE Corp.*, 2:17-cv-00517 (E.D. Tex.); *AGIS Software*

17 *Development LLC v. LG Elecs. Inc.*, 2:17-cv-00515 (E.D. Tex.); *AGIS Software Development*

18 *LLC v. HTC Corp.*, 2:17-cv-00514 (E.D. Tex.); *AGIS Software Development LLC v. Huawei*

19 *Device USA Inc.*, 2:17-cv-00513 (E.D. Tex.). As part of those actions, AGIS Software served

20 subpoenas on Google seeking discovery relating to FMD.

21   4.   In 2018, Google filed a petition for *inter partes* review ("IPR") challenging the

22 patentability of claims 1 and 3-9 of the '970 Patent. *Google LLC v. AGIS Software Development*

23 *LLC*, IPR2018-01079 (P.T.A.B.) (the "Google IPR"). The Patent Trial and Appeal Board issued

24 a Final Written Decision determining that claims 1 and 3-9 were unpatentable. *Id.*, Paper No. 34

25 (Nov. 19, 2019). AGIS Software appealed the decision, which the Federal Circuit summarily

26 affirmed. *AGIS Software Development, LLC v. Google LLC*, No. 20-1401, Dkt. 46 (Fed. Cir.

27 Feb. 4, 2021).

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5.   Before the PTAB's Final Written decision issued, in 2019, AGIS Software filed a complaint against Google in the Eastern District of Texas ("EDTX") asserting, among other claims, the '970 Patent against FMD. *AGIS Software Development LLC v. Google LLC*, No. 2:19-CV-00361-JRG (E.D. Tex. Nov. 4, 2019) ("*AGIS I*"). On May 15, 2020, a third-party *ex parte* reexamination ("EPR") request was filed challenging the patentability of claims 2 and 10-13 of the '970 Patent. While *AGIS I* was pending, AGIS Software amended the claims of the '970 Patent to overcome the prior art asserted during the EPR. After the EPR proceedings concluded, Google filed a Rule 12(b)(1) motion to dismiss AGIS Software's claims regarding the '970 Patent for lack of subject matter jurisdiction because AGIS Software had substantively amended the patent's asserted claims to avoid prior art. Before the EDTX court resolved that motion, the Federal Circuit ordered the case transferred to the Northern District of California ("NDCA"). *In re Google LLC*, No. 2022-140-42, 2022 WL 1613192, at *1 (Fed. Cir. May 23, 2022).

6.   The *AGIS I* case was assigned to Judge Beth Labson Freeman in this District. *AGIS Software Development LLC v. Google LLC*, No. 5:22-CV-04826-BLF ("the NDCA Case"). Google then refiled in this District its motion to dismiss the '970 Patent for lack of subject matter jurisdiction. In response, AGIS Software dismissed the '970 Patent with prejudice. *See* the NDCA Case, Dkts. 437, 438. Other aspects of the NDCA Case remain pending before Judge Freeman.

7.   Before AGIS Software agreed to dismiss the '970 Patent with prejudice from the NDCA Case, it filed a duplicative action against Google in the Western District of Texas, asserting the amended claims of the '970 Patent against the same Google FMD application. *AGIS Software Development LLC v. Google LLC*, No. 6:23-CV-00160-DC-DTG ("the WDTX Case").

8.   On April 4, 2023, the WDTX court granted Google's unopposed motion to stay the WDTX Case. *See* WDTX Case, Dkt. 11. As stated in the unopposed motion to stay, AGIS Software agreed to transfer the WDTX Case to this District following the stay: "[t]he parties have agreed that if and after the requested stay has been lifted, AGIS will not oppose a motion by

1   Google to transfer this case to the Northern District of California following the stay." *See* WDTX

2   Case, Dkt. 10 at 3 n.1.

3   9.   On July 20, 2023, while the case was still stayed, AGIS Software voluntarily

4   dismissed the WDTX Case, stating that the dismissal was without prejudice pursuant to Federal

5   Rule of Civil Procedure 41(a)(1)(A)(i). *See* WDTX Case, Dkt. 12.

6   10.   Google denies that it has infringed or is infringing any claims of the '970 Patent,

7   denies that any claim of the '970 Patent is valid or enforceable, and denies that AGIS can assert

8   any claim of the '970 Patent against Google.

9   11.   An actual and justiciable controversy therefore exists under 28 U.S.C. §§ 2201-

10   2202 between Google and AGIS regarding the '970 Patent.

11   **THE PARTIES**

12   12.   Plaintiff Google LLC is a subsidiary of Alphabet Inc. with its principal place of

13   business located at 1600 Amphitheatre Parkway, Mountain View, California 94043.

14   13.   According to Florida public records, Defendant AGIS Holdings, Inc. is organized

15   and existing under the laws of the State of Florida, and maintains its principal place of business at

16   92 Lighthouse Drive, Jupiter, FL 33469.

17   14.   According to Florida public records, Defendant AGIS, Inc. is organized and

18   existing under the laws of the State of Florida, and maintains its principal place of business at 92

19   Lighthouse Drive, Jupiter, FL 33469.

20   15.   On information and belief, Defendant AGIS Software is an agent and alter ego of

21   AGIS, Inc and AGIS Holdings, Inc.. According to AGIS Software's allegations in another

22   litigation between the parties, AGIS Software is a Texas limited liability company, having its

23   principal place of business at 100 W. Houston Street, Marshall, Texas 75670. Exhibit K ¶ 1.

24   **JURISDICTION AND VENUE**

25   16.   This is a declaratory judgment action for patent non-infringement, invalidity, and

26   unenforceability arising under the patent laws of the United States, Title 35, United States Code,

27   Section 100 *et seq*. This Court has subject matter jurisdiction over this controversy pursuant to 28

28

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1   U.S.C. §§ 1331, 1338(a), 2201 and 2202.

2   **I.   AGIS Software And AGIS, Inc. Accused Google Of Infringing The '970 Patent Based On FMD**

3

4   17.   AGIS Software asserted the '970 Patent against FMD and Google in *AGIS I*,

5   which was transferred to the NDCA, in the WDTX Case, and, along with AGIS, Inc., in

6   International Trade Commission ("ITC") Investigation No. 337-TA-1347 ("ITC Action"). AGIS

7   Software dismissed its '970 Claims from the NDCA Case, voluntarily dismissed the WDTX case,

8   and, along with AGIS, Inc., voluntarily withdrew its complaint in the ITC Action.

     II.   Google Seeks Declaratory Judgments That It Does Not Infringe The '970 Patent
9   **   And That The '970 Patent Is Invalid And Unenforceable**

10   18.   Google denies that it infringes or has infringed the '970 Patent through the

11   making, using, distributing, sale, offering for sale, exportation, or importation of FMD or any

12   related services for FMD or through the making, using, distributing, sale, offering for sale,

13   exportation, or importation of devices that may be configured to run FMD.

14   19.   AGIS's infringement allegations, asserted in related actions, threaten actual and

15   imminent injury to Google that can be redressed by judicial relief and warrants the issue of a

16   declaratory judgment, under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 *et seq*.

17   20.   An actual and justiciable controversy with respect to the '970 Patent exists

18   between Google and AGIS Software, and also exists between Google and AGIS, Inc., and AGIS

19   Holdings under an alter ego theory.

20   **III.   AGIS Is Subject To The Specific Jurisdiction Of This Court**

21   21.   AGIS Software, AGIS, Inc., and AGIS Holdings are each subject to this Court's

22   specific jurisdiction, pursuant to due process and/or the California Long Arm Statute. As an

23   initial matter, the facts supporting personal jurisdiction individually over AGIS Software and

24   AGIS, Inc. also confer jurisdiction over each other AGIS entity because: (A) AGIS Software,

25   AGIS, Inc., and/or AGIS Holdings are alter egos of each other, such that contacts with the State

26   of California by any of the AGIS Entities should be considered in the personal jurisdiction

27   analysis for each AGIS Entity; and (B) AGIS Software is a sham entity created to avoid

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1   jurisdiction and its corporate structure should be ignored. Specific jurisdiction exists based on

2   (i) the activities of AGIS Software and AGIS Inc. over a long period of time purposefully directed

3   at the state of California, including at Google and other residents of this state; (ii) AGIS Software

4   and AGIS Inc. having purposefully directed its patent licensing activities at the State of

5   California, including at Google and other California companies; (iii) AGIS Software and AGIS

6   Inc. having engaged in business-related activities over a long period of time that are directed to

7   Google and other customers and potential customers in the state of California such that AGIS

8   Software and AGIS Inc. has purposefully availed itself of the privilege of doing business in this

9   state; and (iv) AGIS Software's agreement in the WDTX Case to transfer the very dispute that is

10   the subject of this declaratory judgment action to the NDCA. The claims asserted herein arise out

11   of or relate to activities by AGIS Software and AGIS Inc. within and directed at this forum.

12   Further, the assertions of personal jurisdiction are reasonable and fair.

13   **A.   AGIS Software, AGIS, Inc., And/Or AGIS Holdings Are Alter Egos Of Each
                  Other**

14

15   22.   AGIS Software, AGIS, Inc., and/or AGIS Holdings are alter egos of each other,

16   and contacts with the State of California by any of the AGIS Entities should be considered in the

17   personal jurisdiction analysis for each AGIS Entity.

18   23.   On information and belief, AGIS Software self-describes as an "inanimate entity."

19   24.   On information and belief, AGIS Software is inadequately capitalized.

20   25.   AGIS Software, AGIS Holdings, and AGIS, Inc. commingle funds and other

21   assets.

22   26.   On information and belief, AGIS Software, AGIS, Inc. and AGIS Holdings

23   transfer funds between their bank accounts to pay expenses when one does not have an adequate

24   revenue source for a particular time period.

25   27.   AGIS Software's principal source of revenue is from patent licenses.

26   28.   On information and belief, proceeds from lawsuits filed by AGIS Software

27   involving the '970 Patent and related patents, and related patent license agreements, were paid to

28

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1   AGIS, Inc. or AGIS Holdings rather than AGIS Software.

2   29.   On information and belief, AGIS, Inc. and AGIS Holdings' principal source of

3   revenue comes from proceeds from lawsuits filed by AGIS Software involving the '970 Patent

4   and related patents and related patent license agreements.

5   30.   AGIS Software and AGIS, Inc. each claim the LifeRing products to be their

6   product, and each represent that the LifeRing products practice at least one claim of the '970

7   Patent.

8   31.   On information and belief, AGIS Software, AGIS Holdings, and AGIS, Inc.

9   disregard corporate formalities and fail to maintain an arm's length relationship.

10   32.   On information and belief, AGIS, Inc. transferred patents and patent applications,

11   including the '970 Patent, to AGIS Holdings without consideration.

12   33.   On information and belief, AGIS Holdings transferred patents and patent

13   applications, including the '970 Patent, to AGIS Software without consideration.

14   34.   On information and belief, electronic inquiries submitted to AGIS Software's

15   website are transmitted to AGIS, Inc.

16   35.   AGIS Holdings and AGIS, Inc. share a business address at 92 Lighthouse Drive,

17   Jupiter, FL 33469. On information and belief, AGIS Software shares business addresses with

18   AGIS Holdings and AGIS, Inc.

19   36.   On information and belief, AGIS, Inc. pays for office expenses at the business

20   location shared between AGIS, Inc., AGIS Holdings, and AGIS Software in Jupiter, Florida.

21   37.   AGIS Software, AGIS Holdings, and AGIS, Inc. use the same employees.

22   38.   AGIS Software has no employees of its own, and employees of AGIS, Inc.

23   perform work for AGIS Software.

24   39.   On information and belief, AGIS Holdings has no employees of its own, and

25   employees of AGIS, Inc. perform work on behalf of AGIS Holdings.

26   40.   On information and belief, AGIS Software does not hold regular officer, board, or

27   other company meetings, and does not record and maintain regular minutes from officer, board,

28

- 7 -   PLAINTIFF'S AM. COMPLAINT FOR
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1   or other company meetings.

2   41.   On information and belief, AGIS, Inc. does not hold regular officer, board, or

3   other corporate meetings and does not record and maintain regular minutes from officer, board, or

4   other corporate meetings.

5   42.   AGIS Software, AGIS Holdings, and AGIS, Inc. have identical directors and/or

6   officers.

7   43.   AGIS, Inc., AGIS Software, and AGIS Holdings have overlapping officers.

8   Malcolm K. Beyer Jr. is the CEO of AGIS Software, the CEO/Director/Chairman of AGIS

9   Holdings, and the CEO/Director/Chairman of AGIS, Inc. Margaret Beyer is the Secretary of

10 AGIS Software, the Secretary/Director of AGIS Holdings, and the Secretary/Director of AGIS,

11 Inc. Ronald Wisneski is the CFO/Treasurer of AGIS Software, the CFO/Treasurer of AGIS

12 Holdings, and the CFO/Treasurer of AGIS, Inc. Sandel Blackwell is the President of AGIS

13 Software, the President/Director of AGIS Holdings, and the President of AGIS, Inc.

14   44.   Because there is a unity of interest and ownership between AGIS Software, AGIS,

15 Inc., AGIS Holdings, and/or Malcom K. Beyer, Jr. the separate personalities of the entities no

16 longer exist, and the corporate structure should be disregarded. *See, e.g. City & Cnty. of S.F. v.*

17 *Purdue Pharma L.P.*, 491 F. Supp. 3d 610, 635 (N.D. Cal. 2020).

18   45.   Because Malcom K. Beyer, Jr. and/or AGIS, Inc. controls the actions of the AGIS

19 Software and AGIS Holdings such that AGIS Software and AGIS Holdings are mere alter egos of

20 AGIS, Inc., the Court may exercise jurisdiction collectively over the AGIS entities.

21   **B.   AGIS Software Is A Sham Entity Created To Avoid Jurisdiction And Its
            Corporate Structure Should Be Ignored**

22

23   46.   On June 1, 2017, twenty days before filing a patent infringement lawsuit against

24 Apple and ZTE, AGIS Software was created as a Texas LLC to hold and manage intellectual

25 property assets previously owned by AGIS, Inc.

26   47.   On June 15, 2017, AGIS, Inc. assigned the '970 Patent to AGIS Holdings. On

27 information and belief, the assignment was without consideration.

28

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1   48.   On the same day, AGIS Holdings assigned the '970 Patent to AGIS Software. On

2 information and belief, the assignment was without consideration.

3   49.   Both AGIS, Inc. and AGIS Software are wholly owned subsidiaries of AGIS

4 Holdings.

5   50.   Malcom K. Beyer, Jr., the named inventor of the '970 Patent, is the CEO of AGIS

6 Software, AGIS Holdings, and AGIS, Inc.

7   51.   On information and belief, AGIS Software shares business addresses with AGIS

8 Holdings and AGIS, Inc. at 92 Lighthouse Drive, Jupiter, FL 33469, and all of AGIS Software's

9 board members and shareholders are employees, officers, board members, or shareholders of

10 AGIS, Inc.

11   52.   AGIS, Inc. has regular contacts with California as discussed below.

12   53.   AGIS Software and AGIS, Inc. collectively asserted the '970 Patent against FMD

13 and Google in the ITC Action.

14   54.   AGIS, Inc. cannot create AGIS Software to insulate itself from declaratory

15 jurisdiction, as it is an improper use of the corporate structure and should be disregarded for the

16 jurisdictional analysis. *See Dainippon Screen Mfg. Co., Ltd. v. CFMT, Inc.*, 142 F.3d 1266, 1271

17 (Fed. Cir. 1998); *Google Inc. v. Rockstar Consortium U.S. LP*, No. C 13-5933-CW, 2014 WL

18 1571807, at *4 (N.D. Cal. Apr. 17, 2014).

19   **C.   AGIS Software Purposefully Directed Its Patent Licensing Activities To
         California Companies Subjecting It To Specific Jurisdiction**

20

21   55.   AGIS Software is a patent licensing company that licenses its patent portfolio,

22 including the '970 Patent.

23   56.   AGIS Software has no employees.

24   57.   AGIS Software has intentionally directed activities and communications to the

25 State of California.

26   58.   AGIS Software's principal source of revenue is from patent licenses with

27 California companies and other companies operating in the State of California.

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           i.   **AGIS Entities' Negotiations, Pre-Suit Communications, And Other Pre-Suit Contacts With Google**

2

3   59.   As part of *AGIS I*, AGIS Software argued that its pre-suit communications, and

4 those of AGIS, Inc., with Google gave Google pre-suit knowledge of AGIS's patents and

5 Google's alleged infringement of those patents, including the '970 Patent. *See AGIS I*, Dkt. 297.

6 AGIS Software argued that these communications demonstrated that AGIS had provided pre-suit

7 notice of Google's alleged infringement of the '970 Patent based on FMD under 35 U.S.C. § 287,

8 and that Google had pre-suit knowledge of its alleged infringement to sustain claims by AGIS

9 Software that Google is liable for willful infringement, inducing infringement, and contributing to

10 infringement of the '970 Patent based on FMD. *Id*.

11   60.   For example, as part of *AGIS I*, AGIS Software argued that its subpoenas to

12 Google regarding FMD in 2018 gave Google pre-suit knowledge of AGIS's patents and Google's

13 alleged infringement of those patents, including the '970 Patent. *Id.*

14   61.   On June 21, 2017, AGIS Software asserted the '970 Patent, among other claims,

15 against Huawei Device Co., Ltd., Huawei Device USA, Inc., Huawei Technologies Co., Ltd.,

16 Huawei Technologies USA, Inc., HTC Corporation, LG Electronics, Inc., ZTE Corporation, ZTE

17 (TX), Inc., and ZTE (USA) Inc. based on their hardware devices' use of FMD. *AGIS Software*

18 *Development, LLC v. Huawei Device USA Inc.*, No. 2:17-cv-0513-JRG (E.D. Tex.) (lead case).

19   62.   In connection with AGIS Software's litigation asserting the '970 Patent against

20 these defendants, on August 24, 2018, AGIS Software served Google with third-party deposition

21 and document subpoenas, requesting testimony, source code, and documents about FMD.

22 Service was made on Google's Registered Agent in the Northern District of California.

23   63.   As another example, as part of *AGIS I*, AGIS Software argued that its settlement

24 licensing negotiations with Google in 2018 gave Google pre-suit knowledge of AGIS's patents

25 and Google's alleged infringement of those patents, including the '970 Patent. *See AGIS I*, Dkt.

26 297.

27   64.   On May 15, 2018, Google filed a petition for *inter partes* review ("IPR")

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challenging the patentability of claims 1 and 3-9 of the '970 Patent. *See* Google IPR, Paper No. 1. Shortly after the Google IPR was filed, but before AGIS Software filed suit asserting infringement of the '970 Patent by Google, AGIS entities including at least AGIS Software directly engaged in settlement and patent licensing negotiations with Google, pertaining to AGIS's patents. The negotiations included calls between AGIS and Google on at least June 25, 2018, and July 16, 2018.

65.   As another example, as part of *AGIS I*, AGIS Software argued that other pre-suit contacts between AGIS, Inc. and Google since 2008 (as detailed below in Section III.D) gave Google pre-suit knowledge of AGIS's patents and Google's alleged infringement of those patents, including the '970 Patent. *See AGIS I*, Dkt. 297.

66.   In connection with the NDCA Case, AGIS entities including at least AGIS Software agreed to private mediation before California-based mediator Jeff Kichaven. AGIS agreed to participate in in-person mediation with Google at the offices of O'Melveny & Myers LLP in Menlo Park, California, on July 11, 2023. AGIS booked flights to attend said mediation, electing to proceed via Zoom only after their flights were unexpectedly canceled shortly before the scheduled mediation.

ii.   AGIS Entities' Licensing Activities, Commercial Relationship, And Negotiations With Third Parties

67.   AGIS entities including at least AGIS Software have taken purposeful steps to enforce the '970 Patent and/or obtain licenses to the '970 Patent and/or related patents with companies having principal places of business and operations in this judicial district, including Lyft, Apple Inc. ("Apple"), WhatsApp LLC ("WhatsApp"), Facebook, Inc.[1] ("Facebook"), Uber Technologies, Inc. d/b/a UBER ("Uber"), and Life360, Inc. ("Life360"), and with companies or their affiliates having operations and offices in the State of California, including ZTE (USA) Inc. ("ZTE"), HTC Corporation ("HTC"), T-Mobile US, Inc. ("TMobile"), Huawei Device USA Inc. ("Huawei"), LG Electronics, Inc. ("LG"), and Samsung Electronics America, Inc ("Samsung"), and Smith Micro Software ("Smith Micro").

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[1] On information and belief, Facebook, Inc. is now Meta Platforms, Inc.

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68.   AGIS's communications, including through telephone, mail, and/or other means, with companies having principal places of business, offices, and/or operations in the State of California to enforce and to negotiate licenses the '970 Patent and/or related patents creates specific personal jurisdiction over AGIS. *See Trimble Inc. v. PerDiemCo LLC*, 997 F.3d 1147, 1155 (Fed. Cir. 2021).

69.   AGIS's non-exclusive licenses to the '970 Patent with companies having principal places of business, offices, and operations in the State of California are sufficiently related to this declaratory judgment action concerning the same patent to support a finding of specific jurisdiction. *Id.* at 1156.

iii.   AGIS Entities' Past License With Apple And Related Negotiations

70.   On June 21, 2017, AGIS Software sued Apple, a California corporation with its principal place of business in this District in Cupertino, California, alleging infringement of the '970 Patent and other patents related to the '970 Patent. *See AGIS Software Development LLC v. Apple Inc.*, Civil Action No. 2:17-cv-00516 (E.D. Tex.), Dkt. 1 ¶¶ 6-9, 18, 27, 41, 55.

71.   On information and belief, Apple currently has or previously had headquarters at 1 Apple Park Way Cupertino, California 95014.

72.   On information and belief, in or around March 2019, AGIS Software, AGIS, Inc., and/or AGIS Holdings entered into a license agreement with Apple ("Apple License") covering all patents and patent applications assigned to, owned by, or controlled by the AGIS Entities, including the '970 Patent.

73.   On information and belief, AGIS entities including at least AGIS Software negotiated, including through numerous written email and/or other communications, with Apple to obtain the Apple License.

iv.   AGIS Entities' Patent License With Huawei And Related Negotiations

74.   On June 21, 2017, AGIS Software sued Huawei Device USA Inc., Huawei Technologies USA Inc., and Huawei Technologies Co., Ltd. alleging infringement of patents, including the '970 Patent. *AGIS Software Dev. LLC v. Huawei Device USA Inc.*, Civil Action No.

2:17-cv-00513 (E.D. Tex.), Dkt. 1 ¶¶ 8-11, 20, 29, 42, 55.

75.   On information and belief, Huawei currently has or previously had an affiliate office in California.

76.   On information and belief, in or around March 2019, AGIS Software entered into a license agreement with Huawei ("Huawei License") covering all patents and patent applications owned or controlled by AGIS Software or its affiliates.

77.   On information and belief, AGIS entities including at least AGIS Software negotiated, including through numerous written email and/or other communications, with Huawei to obtain the Huawei License.

v.   AGIS Entities' Patent License With HTC And Related Negotiations

78.   On June 21, 2017, AGIS Software sued HTC Corporation alleging infringement of patents, including the '970 Patent. *AGIS Software Dev. LLC v. HTC Corp.*, Civil Action No. 2:17-cv-00514 (E.D. Tex.), Dkt. 1 ¶¶ 6-9, 18, 27, 40, 53.

79.   On information and belief, HTC currently has or previously had an affiliate office in California.

80.   On information and belief, in or around July of 2019, AGIS Software entered into a license agreement with HTC ("HTC License") covering all patents and patent applications owned or controlled by AGIS Software or its affiliates.

81.   On information and belief, AGIS entities including at least AGIS Software negotiated, including through numerous written email and/or other communications, with HTC to obtain the HTC License.

vi.   AGIS Entities' Patent License With LG And Related Negotiations

82.   On June 21, 2017, AGIS Software sued LG Electronics, Inc. alleging infringement of patents, including the '970 Patent. *AGIS Software Development LLC v. LG Electronics, Inc.*, Civil Action No. 2:17-cv-00515 (E.D. Tex.), Dkt. 1 ¶¶ 6-9, 18, 27, 40, 53.

83.   On information and belief, LG currently has or previously had an affiliate office in California.

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84.   On information and belief, in or around July 2019, AGIS Software entered into a license agreement with LG ("LG License") covering all patents and patent applications owned or controlled by AGIS Software or its affiliates.

85.   On information and belief, AGIS entities including at least AGIS Software negotiated, including through numerous written email and/or other communications, with LG to obtain the LG License.

vii.   AGIS Entities' Patent License With ZTE And Related Negotiations

86.   On June 21, 2017, AGIS Software sued ZTE Corporation and ZTE (TX) Inc. alleging infringement of patents, including the '970 Patent. *AGIS Software Dev. LLC v. ZTE Corp. et al.*, No. 2:17-cv-00517-JRG (E.D. Tex.), Dkt. 1 ¶¶ 7-10, 19, 28, 41 54.

87.   On October 17, 2017, AGIS Software filed an amended complaint, adding ZTE (USA) Inc. as a defendant to this litigation and alleging infringement of an additional related patent, the '829 patent. *AGIS Software Dev. LLC v. ZTE Corp., et al.*, No. 2:17-cv-00517-JRG (E.D. Tex.), Dkt. 32 ¶¶ 3 & 73.

88.   On information and belief, ZTE or a ZTE affiliate currently has or previously had an office located in California.

89.   On information and belief, in or around October 2019, AGIS Software entered into a license agreement with ZTE ("ZTE License") covering all patents and patent applications owned or controlled by AGIS Software or its affiliates.

90.   On information and belief, AGIS entities including at least AGIS Software negotiated, including through numerous written email and/or other communications, with ZTE to obtain the ZTE License.

viii.   AGIS Entities' Patent License With WhatsApp And Facebook And Related Negotiations

91.   On January 29, 2021, AGIS Software sued WhatsApp, a corporation having its principal place of business in this District in Menlo Park, California, alleging infringement of patents related to the '970 Patent. *See AGIS Software Dev. LLC v. WhatsApp, Inc.*, No. 2:21-cv-00029 (E.D. Tex.), Dkt. 1 ¶¶ 7-12, 21, 40, 59, 78, 97, 116.

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92.   On information and belief, WhatsApp currently has or previously had an office in California.

93.   In or around September 2021, AGIS Software entered into a license agreement with WhatsApp and Facebook ("WhatsApp/Facebook License") covering all patents and patent applications held or controlled by AGIS Software or its affiliates, including the '970 Patent.

94.   On information and belief, Facebook currently has or previously had an office in California.

95.   On information and belief, AGIS entities including at least AGIS Software negotiated, including through numerous written email and/or other communications, with WhatsApp and/or Facebook to obtain the WhatsApp/Facebook License.

     ix. AGIS Entities' Patent License With Uber And Related Negotiations

96.   On January 29, 2021, AGIS Software sued Uber alleging infringement of the '970 Patent. *AGIS* Software *Dev. LLC v. Uber Techs. Inc., d/b/a Uber*, No. 2:21-cv-00026 (E.D. Tex.), Dkt. 1 ¶¶ 18-22, 30, 46, 62, 77, 95.

97.   On information and belief, Uber currently has or previously had an office in California.

98.   On information and belief, in or around March of 2022, AGIS Software entered into a license agreement with Uber ("Uber License") covering all patents and patent applications held or controlled by AGIS Software or its affiliates, including the '970 Patent.

99.   On information and belief, AGIS entities including at least AGIS Software negotiated, including through numerous written email and/or other communications, with Uber to obtain the Uber License.

     x. AGIS Entities' Patent License With T-Mobile And Related Negotiations

100.   On March 3, 2021, AGIS Software sued T-Mobile alleging infringement of patents related to the '970 Patent. *AGIS Software Dev. LLC v. T-Mobile USA, Inc.*, No. 2:21-cv-00072 (E.D. Tex.), Dkt. 1 ¶¶ 7-12, 24, 46, 67, 98, 120, 147.

101.   On information and belief, T-Mobile or a T-Mobile affiliate currently has or

1   previously had an office in California.

2   102.   On information and belief, in or around November of 2021, AGIS Software

3   entered into a license agreement with T-Mobile ("T-Mobile License") covering all patents and

4   patent applications owned or controlled by AGIS Software or its affiliates.

5   103.   On information and belief, AGIS entities including at least AGIS Software

6   negotiated, including through numerous written email and/or other communications, with T-

7   Mobile to obtain the T-Mobile License.

8   **xi.   AGIS Entities' Patent License With Smith Micro And Related Negotiations**

9
10   104.   On May 17, 2021, Smith Micro sued AGIS Software in this District for a

11   declaratory judgment that Smith Micro did not infringe patents related to the '970 Patent, and that

12   said patents were invalid. *Smith Micro Software, Inc. v. AGIS Software Development LLC*, No.

13   5:21-cv-03677 (N.D.Cal.), Dkt. 1 ¶¶ 16, 50, 55, 60, 65, 70, 75, 81, 88, 96, 103, 110, 117.

14   105.   On information and belief, Smith Micro currently has or previously had an office

15   located in California.

16   106.   On information and belief, in or around October 2021, AGIS Software entered into

17   a license agreement with Smith Micro ("Smith Micro License") covering all patents and patent

18   applications owned or controlled by AGIS Software or its affiliates.

19   107.   On information and belief, AGIS entities including at least AGIS Software

20   negotiated, including through numerous written email and/or other communications, with Smith

21   Micro to obtain the Smith Micro License.

22   **D.   AGIS, Inc. Has Regular Contacts With California And With Google Involving The '970 Patent**

23   108.   AGIS, Inc. has intentionally directed activities and communications to the State of

24   California.

25   109.   On information and belief, AGIS, Inc. maintains or maintained a bank account in

26   California.

27   110.   AGIS, Inc. communicated with California companies, including Google,

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1 Facebook, and Life360 to pursue joint ventures, acquisition, or patent licensing agreements

2 involving the '970 Patent and/or related patents.

3   111.   On information and belief, AGIS, Inc. formed partnerships with one or more

4 California companies or individuals involving products that allegedly embody the '970 Patent

5 including the LifeRing products.

6   112.   On information and belief, AGIS, Inc. entered into non-disclosure agreements with

7 California companies and organizations to pursue business opportunities involving products

8 and/or services that embody the '970 Patent, including the LifeRing products.

9   113.   On information and belief, from 2008 to the present, AGIS, Inc. has purposefully

10 directed business, patent, and licensing efforts at Google in California about the '970 Patent,

11 patents related to the '970 Patent, and/or AGIS, Inc.'s products practicing patents in the '970

12 Patent family, including AGIS, Inc.'s LifeRing product.

13   114.   On information and belief and based on AGIS Software's own allegations in its

14 past litigations, in 2008 AGIS, Inc. purposefully attempted to contact Google regarding a possible

15 business partnership or technology license by attempting to provide information about AGIS,

16 Inc.'s LifeRing product and its patent portfolio to Mr. Eric Schmidt, Google's CEO at the time,

17 through a family relative. AGIS Software alleges that in January 2008, AGIS, Inc.'s CEO,

18 Malcolm K. Beyer, Jr, emailed a PowerPoint presentation to that relative that provided AGIS,

19 Inc.'s LifeRing product and identified U.S. Patent No. 7,031,728 (the '728 Patent). The '728

20 Patent issued on April 18, 2006. On its face, the '970 Patent claims priority to the '728 Patent

21 through a series of continuation-in-part applications. AGIS, Inc. allegedly sent additional

22 communications to the same relative in at least February 2008 and September 2008, following up

23 on AGIS, Inc.'s initial communication.

24   115.   On information and belief, from at least 2011-2012, AGIS, Inc. obtained a license

25 for Google Earth technology for use with AGIS, Inc.'s LifeRing product and communicated with

26 the Google Enterprise Geo team about integrating Google mapping technologies into AGIS,

27 Inc.'s products including its LifeRing product and about potential business partnerships between

28

1   AGIS, Inc. and Google.

2   116.   In April 2011, AGIS, Inc. and Google entered into a nondisclosure agreement in

3   connection with discussions between the parties. The nondisclosure agreement contains a venue

4   provision specifically agreeing to venue in Santa Clara County, California, for disputes arising

5   out of the nondisclosure agreement.

6   117.   In July 2011, AGIS, Inc.'s CEO, Mr. Beyer, sent emails to Google representatives

7   in Navy/Marine Corps Sales and Geo Enterprise groups about AGIS, Inc.'s LifeRing, for support

8   in AGIS, Inc.'s development efforts using Google Earth for the Marine Corps.

9   118.   In August 2011, Mr. Beyer exchanged additional email communications with

10   Google's in Navy/Marine Corps Sales group to follow up about potential partnerships between

11   AGIS, Inc. and Google.

12   119.   In December 2011 and January 2012, Mr. Beyer exchanged emails with Google's

13   representative in Navy/Marine Corps Sales group about updates to AGIS, Inc.'s LifeRing product

14   integrating a Google interface. Mr. Beyer further expressed interest in developing a close

15   working relationship with Google, offering Google to use AGIS, Inc.'s patent-protected products,

16   and stating that AGIS, Inc. had recently obtained another patent on AGIS, Inc.'s LifeRing product

17   for a total of 8 patents.

18   120.   On information and belief, in 2014, AGIS, Inc. continued its purposeful efforts to

19   establish a business partnership with Google or for Google to license AGIS, Inc.'s patents or

20   technology. AGIS Software alleges that in 2014, AGIS, Inc.'s counsel Thomas R. Makin of

21   Kenyon & Kenyon LLP sent a letter to Mr. Vivek Gundotra of Google in which AGIS, Inc.

22   invited discussion with Google about potential joint ventures, acquisition, or patent licensing.

23   121.   On information and belief, on or about May 2016 AGIS, Inc. contacted Google

24   regarding use of the Google Maps API in AGIS, Inc.'s LifeRing Product, and a Google Business

25   Solutions Strategist at Google provided information regarding numerous Google Maps API

26   offerings sent an email to Mr. Beyer with subject "Cap's Interest in Google Maps APIs."

27   122.   On information and belief, AGIS, Inc. uses Google Maps APIs in AGIS, Inc.'s

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1 products. Since as early as 2019, AGIS, Inc. publicly represented on its website that it integrated

2 Google Maps API in AGIS, Inc.'s LifeRing product. *See*

3 https://web.archive.org/web/20191204191247/https://www.agisinc.com/lifering/lifering-

4 interfaces/; https://www.agisinc.com/lifering/lifering-interfaces/; see also

5 https://www.agisinc.com/.

6   123.   AGIS Software and AGIS, Inc. have publicly represented on their website that

7 AGIS, Inc.'s LifeRing product allegedly practices the '970 Patent. *See*

8 http://www.agissoftwaredevelopmentllc.com/patents/.

9   124.   On information and belief, AGIS, Inc. sent a letter to Life360, a company

10 headquartered in San Francisco, California, on May 13, 2014 alleging infringement of AGIS's

11 patents, expressing a willingness to engage in discussions regarding "royalty bearing licensing

12 terms," and stating that "Life360 and its customers must cease and desist from further

13 infringement" in the absence of a license. *See Advanced Ground Info. Sys., Inc. v. Life360, Inc.*,

14 No. 9:14-cv-80651 (S.D. Fla.), Dkt. 181 (Transcript of Jury Trial Proceedings Day 1 held on Mar.

15 9, 2015) at 87:2-7.

16   125.   Three days later, on May 16, 2014, AGIS, Inc. sued Life360 alleging infringement

17 of patents related to the '970 Patent. *Advanced Ground Info. Sys., Inc. v. Life360, Inc.*, No. 9:14-

18 cv-80651 (S.D. Fla.), Dkt. 1 ¶¶ 2, 16, 25, 34, 43.

19   126.   On information and belief, Life360 currently has or previously had an office

20 located in California.

21   127.   On information and belief, AGIS, Inc. negotiated, including through numerous

22 written email and/or other communications, with Life360 to attempt to license AGIS's patents.

23   128.   On information and belief, AGIS, Inc. marketed LifeRing, which allegedly

24 embodies the '970 Patent, to California companies CornerTurn LLC, Integrity Applications and

25 American Reliance, Inc. *See Life360, Inc. v. Advanced Ground Info. Sys., Inc.*, No. 15-cv-00151-

26 BLF, 2015 WL 5612008, at *3 (N.D. Cal. Sept. 21, 2015).

27   129.   On information and belief, AGIS, Inc. has also marketed LifeRing, which

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1   allegedly embodies the '970 Patent to first responders, military agencies, and/or military

2   contractors, including those in the State of California.

3   130.   On information and belief, AGIS, Inc. provides or has provided downloads and

4   updates of its LifeRing product, which allegedly embodies the '970 Patent, in California.

5   131.   On information and belief, AGIS, Inc. provided downloads of its LifeRing

6   product, which allegedly embodies the '970 Patent, to United States Navy personnel and

7   contractors at the United States Navy, SPAWAR Systems Center Pacific, in San Diego,

8   California. *See Life360, Inc.*, 2015 WL 5612008, at *3.

9   132.   AGIS, Inc. allows companies and individuals, including California companies and

10   individuals, a trial of the LifeRing product, which allegedly embodies the '970 Patent.

11   133.   On information and belief, AGIS Inc. and/or AGIS Software has licensed the '970

12   Patent and/or related patents to end users residing in California who downloaded the LifeRing

13   product, which allegedly embodies the '970 Patent.

14   134.   On information and belief, AGIS, Inc. demonstrates or has demonstrated its

15   LifeRing product, which allegedly embodies the '970 Patent, in California or to individuals or

16   entities residing in or operating out of California, respectively.

17   135.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

18   allegedly embodies the '970 Patent, at a U.S. military exercise in San Diego, California. *See*

19   *Life360, Inc.*, 2015 WL 5612008, at *3.

20   136.   On information and belief, Malcolm K. Beyer, Jr. discussed the LifeRing product,

21   which allegedly embodies the '970 Patent, with California companies including ADI Technology

22   and Maven Consulting. *See Life360, Inc.*, 2015 WL 5612008, at *3.

23   137.   On information and belief, AGIS, Inc. made other efforts to market LifeRing to

24   private companies, several of which downloaded LifeRing in California at various times for

25   purposes of evaluation, including at least CornerTurn LLC, Integrity Applications, and American

26   Reliance, Inc. *Id.* at *4.

27   138.   On information and belief, AGIS, Inc. reached out to a California company, Green

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1   Hills Software, Inc., a security software firm located in Santa Barbara, California. *Id.* at *4.

2   139.   On information and belief, AGIS, Inc. contacted Green Hills because Green Hills

3   had a security product that AGIS, Inc. found "of interest." *Id.*

4   140.   On information and belief, AGIS, Inc. loaded LifeRing onto one or more of Green

5   Hills' smart phones. *Id.*

6   141.   On information and belief, Green Hills used LifeRing in its lab in California to

7   verify that the software would work. *Id.*

8   142.   On information and belief, Green Hills also demonstrated LifeRing working in

9   conjunction with Green Hills' smart phones at a trade show, the MILCOM Conference in San

10   Diego, California. *Id.*

11   143.   On information and belief, Green Hills issued a press release stating that it had a

12   "strategic partnership" with AGIS. *Id.*

13   144.   On information and belief, AGIS, Inc. took that to mean that LifeRing worked on

14   Green Hills' products and AGIS, Inc. did not object to the "strategic partnership" characterization

15   because AGIS, Inc. was "happy to have anybody say that they were working with" AGIS, Inc.

16   *Id.*

17   145.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

18   allegedly embodies the '970 Patent, at the National Incident Management System (NIMS) Test, to

19   individuals or entities residing in or operating out of California, respectively, and/or which

20   occurred in California.

21   146.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

22   allegedly embodies the '970 Patent, at a Coalition Warrior Interoperability Demonstration, to

23   individuals or entities residing in or operating out of California, respectively, and/or which

24   occurred in California.

25   147.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

26   allegedly embodies the '970 Patent, at Army Network Integration Evaluation, to individuals or

27   entities residing in or operating out of California, respectively, and/or which occurred in

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1 California.

2   148.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

3 allegedly embodies the '970 Patent, at various U.S. Joint Commission Chief of Staff exercises, to

4 individuals or entities residing in or operating out of California, respectively, and/or which

5 occurred in California.

6   149.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

7 allegedly embodies the '970 Patent, at the Defense Intelligence Agency's Plugfest, to individuals

8 or entities residing in or operating out of California, respectively, and/or which occurred in

9 California.

10   150.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

11 allegedly embodies the '970 Patent, at various SOCOM TNT exercises, to individuals or entities

12 residing in or operating out of California, respectively, and/or which occurred in California.

13   151.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

14 allegedly embodies the '970 Patent, at U.S. NATO Bold Quest, to individuals or entities residing

15 in or operating out of California, respectively, and/or which occurred in California.

16   152.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

17 allegedly embodies the '970 Patent, at Joint-Interagency Field Experimentation (JIFX) exercises,

18 to individuals or entities residing in or operating out of California, respectively, and/or which

19 occurred in California.

20   153.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

21 allegedly embodies the '970 Patent, at the Army Expeditionary Warrior Experiment, to

22 individuals or entities residing in or operating out of California, respectively, and/or which

23 occurred in California.

24   154.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

25 allegedly embodies the '970 Patent, at Jolted Tactics, to individuals or entities residing in or

26 operating out of California, respectively, and/or which occurred in California.

27   155.   On information and belief, AGIS, Inc. demonstrated its LifeRing product, which

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1   allegedly embodies the '970 Patent, to various individuals affiliated with the U.S. Navy that

2   reside in California and/or which occurred in California.

3   **E.   AGIS Inc. and AGIS Software Consented To Litigating In California**

4   156.   As noted above, as part of its negotiations with Google regarding the LifeRing

5   product and potential business and licensing partnerships, AGIS, Inc. and Google entered into a

6   nondisclosure agreement in April 2011. The nondisclosure agreement contains a venue provision

7   specifically agreeing to venue in Santa Clara County, California, for disputes arising out of the

8   nondisclosure agreement.

9   157.   In addition, AGIS Software previously agreed to have the very disputes presented

10   in this Complaint litigated in this judicial district.

11   158.   As noted above, before AGIS Software agreed to dismiss the '970 Patent with

12   prejudice from the NDCA Case, it filed the duplicative WDTX Case asserting the amended

13   claims of the '970 Patent against the same Google FMD application.

14   159.   On March 29, 2023, AGIS Software agreed to transfer the WDTX case to the

15   NDCA. See WDTX Case, Dkt. 10 at 3 n.1 ("[t]he parties have agreed that if and after the

16   requested stay has been lifted, AGIS will not oppose a motion by Google to transfer this case to

17   the Northern District of California following the stay.").

18   * * *

19   160.   As a result of the foregoing, AGIS Software, AGIS, Inc. and AGIS Holdings are

20   each subject to personal jurisdiction within this judicial district.

21   161.   Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 because a

22   substantial part of the acts giving rise to the claim occurred in this judicial district, and because

23   AGIS Software, AGIS, Inc. and AGIS Holdings are each subject to personal jurisdiction in this

24   district. This venue is also a convenient forum for all parties for the reasons discussed by the

25   Federal Circuit in *In re Google LLC*, No. 2022-140-42, 2022 WL 1613192, at *1 (Fed. Cir. May

26   23, 2022).

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INTRADISTRICT ASSIGNMENT

162.   Pursuant to Civil L.R. 3-2(c) and 3-5(b), this is an Intellectual Property Rights Action subject to assignment on a district-wide basis.

FACTUAL BACKGROUND

163.   Google's headquarters at 1600 Amphitheatre Parkway, Mountain View, California 94043 are located in this District.

164.   Google's mission is to organize the world's information and make it universally accessible and useful. Over the past two decades, in service of that mission, Google has become one of the world's most innovative technology companies.

165.   Google has also developed applications, including FMD, that can be installed on devices that run the Android operating system.

166.   FMD is a service that allows an individual to remotely trace, locate, and wipe devices, including Android powered smartphones and tablets.

167.   Starting in 2017, AGIS began its patent litigation campaign targeting Google applications. In 2017, AGIS sued ZTE, LG, HTC, and Huawei for infringement of the '970 Patent, among other patents. In particular, AGIS asserted that devices manufactured by ZTE, LG, HTC, or Huawei infringed the '970 Patent devices based on the alleged inclusion of FMD on those devices. Each of these cases settled in 2019.

168.   Later in 2019, AGIS filed a second round of lawsuits targeting FMD, this time against Google and Samsung. AGIS against alleged infringement of the '970 Patent, among other patents, against Google. AGIS alleged that FMD and devices running FMD infringed the '970 Patent. AGIS further alleged that Samsung devices running FMD infringed U.S. Patent No. 9,749,829 ("'829 Patent"), which is related to the '970 Patent. This second round of cases proceeded in the EDTX until the Federal Circuit ordered transfer to the NDCA on May 23, 2022. On April 7, 2023, AGIS and Google jointly moved pursuant to Rule 41(a)(1)(A)(ii) and (a)(1)(B) for a stipulation and order dismissing AGIS's allegations based on the '970 patent claims 2 and 10-13 with prejudice. On April 10, 2023, the Court granted the joint motion and dismissed

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1   AGIS's allegations based on the '970 patent claims 2 and 10-13 with prejudice. The remainder of

2   these cases are still pending before Judge Freeman.

3   169.   On November 16, 2022, AGIS filed an ITC action against Google, Samsung, and

4   eleven other respondents, along with parallel actions against the other eleven respondents in

5   district court cases filed in the EDTX. In both sets of actions, AGIS asserted the '970 Patent,

6   among others, and alleged that each respondents' devices running FMD infringed the '970 Patent.

7   AGIS later voluntarily moved to terminate this ITC action. But the district court cases in the

8   EDTX, which were stayed pending the ITC action, remain pending.

9   170.   On March 1, 2023, AGIS filed a new action against Google, this time in the

10   WDTX, asserting the '970 Patent against FMD. On July 20, 2023, AGIS voluntarily dismissed

11   this case, stating that it was without prejudice.

12   171.   On June 16, 2023, just one day after voluntarily moving to terminate its ITC

13   action, AGIS filed an amended complaint in a preexisting case against Samsung in EDTX. AGIS

14   initially filed this case against Samsung in July 2022, asserting the '970 Patent, but not against

15   FMD. But in its June 16, 2023 amended complaint, AGIS added allegations of infringement of

16   the '970 Patent against Samsung devices running FMD. AGIS also filed a motion for leave to

17   amend its infringement contentions to add its claims based on FMD, which Samsung opposed.

18   That motion is still pending in the EDTX.

19   172.   As this litigation history demonstrates, AGIS has engaged and continues to engage

20   in a course of conduct that shows a preparedness and a willingness to enforce the '970 Patent

21   against Google and its Android partners based on FMD. Thus, there is a substantial risk that

22   Google will face harm from further assertions of the '970 Patent against FMD.

23   173.   FMD and devices running FMD do not directly or indirectly infringe any claims of

24   the '970 Patent, either literally or under the doctrine of equivalents. Google has not caused,

25   directed, requested, or facilitated any such infringement, and has never had any specific intent to

26   do so.

27   **COUNT I**

(Declaratory Judgment of Non-Infringement of the '970 Patent by FMD)

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174.   Google hereby restates and incorporates by reference the allegations set forth in paragraphs 1 through 173 of this Complaint as if fully set forth herein.

175.   AGIS claims to own all right, title, and interest in the '970 Patent.

176.   In both the NDCA Case and the WDTX Case, AGIS alleged that Google infringed the '970 Patent based on its design, development, and distribution of FMD. *See, e.g.*, Exhibit K ¶¶ 14, 15. AGIS further alleged that Google devices running FMD infringe the '970 Patent. *Id.*

177.   FMD and Google products running FMD do not include or practice multiple claim limitations of the claims of the '970 Patent, including, but not limited to:

    a.   "a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory,"

    b.   "a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone,"

    c.   "a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message; a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone,"

    d.   "means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone,"

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e.   "means for requiring a required manual response from the response list by the recipient in order to clear recipients response list from recipients cell phone display,"

f.   "means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert,"

g.   "means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert,"

h.   "means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded,"

i.   "means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone,"

j.   "means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone,"

k.   "means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted,"

l.   "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, acknowledgment, and response to said forced message

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1   alert is forced by a forced message alert software application program,"

2   m.   "transmitting an automatic acknowledgment of receipt to the sender

3   PDA/cell phone, which triggers the forced message alert software

4   application program to take control of the recipient PDA/cell phone and

5   show the content of the text message and a required response list on the

6   display recipient PDA/cell phone or to repeat audibly the content of the

7   voice message on the speakers of the recipient PDA/cell phone and show

8   the required response list on the display recipient PD A/cell phone,"

9   n.   "transmitting a selected required response from the response list in order to

10   allow the message required response list to be cleared from the recipient's

11   cell phone display, whether said selected response is a chosen option from

12   the response list, causing the forced message alert software to release

13   control of the recipient PDA/cell phone and stop showing the content of the

14   text message and a response list on the display recipient PDA/cell phone

15   and or stop repeating the content of the voice message on the speakers of

16   the recipient PDA/cell phone," and

17   o.   "providing a list of the recipient PDA/cell phones have automatically

18   acknowledged receipt of a forced alert message and their response to the

19   forced alert message,"

20   178.   Google does not infringe literally or under the doctrine of equivalents claims 2 and

21   10-13 of the '970 Patent, directly or indirectly, contributorily or otherwise through its or its user's

22   activities in conjunction with FMD.

23   179.   As set forth above, an actual and justiciable controversy therefore exists between

24   Google and AGIS regarding whether FMD or any Google devices running FMD have infringed

25   any of the asserted claims of the '970 patent. A judicial declaration is necessary to determine the

26   parties' respective rights regarding the '970 patent.

27   180.   Google seeks a judgment declaring that Google does not directly or indirectly

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1 infringe claims 2 and 10-13 of the '970 patent, either literally or under the doctrine of equivalents.

2 **COUNT II**

3 **(Declaratory Judgment of Invalidity of the '970 Patent)**

4 181.   Google hereby restates and incorporates by reference the allegations set forth in

5 paragraphs 1 through 173 of this Complaint as if fully set forth herein.

6 182.   AGIS claims to own all right, title, and interest in the '970 Patent, including the

7 right to assert all causes of action arising under that patent and the right to any remedies for

8 infringement of it.

9 183.   The original claims 1 and 3-9 of the '970 patent were already found invalid in

10 view of prior art as part of an *inter partes* review proceeding, IPR2018-01079, and the Federal

11 Circuit affirmed that finding. See *AGIS Software Development, LLC v. Google LLC*, No. 2020-

12 1401 (Fed. Cir.). The remaining original claims 2 and 10-13 were found to be invalid in USPTO

13 Reexamination Control Number 90/017,507 in view of the same or similar prior art as that

14 presented in the *inter partes* review proceeding. In response to office actions rejecting those

15 original claims, AGIS amended claims 2 and 10-13 to overcome those references to add new

16 claim limitations, which the USPTO allowed.

17 184.   Google has a reasonable apprehension that AGIS will assert the '970 Patent's

18 amended claims 2 and 10-13 against Google in the United States for alleged infringement based

19 on FMD.

20 185.   Each of the claims 2 and 10-13 of the '970 patent that has not been invalidated is

21 invalid for failure to comply with at least one or more conditions for patentability set forth in one

22 or more provisions of 35 U.S.C. §§ 101, 102, 103 and/or 112.

23 186.   For example, claims 2 and 10-13 are invalid as obvious in view of one or more of

24 the following prior art references, either alone or in combination with each other:

25 a.   U.S. Patent No. 5,325,310 to Johnson et al. ("Johnson")

26 b.   U.S. Patent No. 5,742,905 to Pepe et al. ("Pepe")

27 c.   U.S. Patent No. 6,854,007 to Hammond ("Hammond")

28 d.   U.S. Patent Publication No. 2006/0218232 to Kubala et al. ("Kubala")

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1   e. U.S. Patent No. 7,031,728 ("Beyer '728")

2   f. U.S. Patent Publication No. 2006/0199612 ("Beyer '612")

3   g. U.S. Patent Publication No. 2006/0223518 ("Haney")

4   h. U.S. Patent Publication No. 2007/0150444 ("Chesnais")

5   i. U.S. Patent Publication No. 2007/0281689 ("Altman '689")

6   j. U.S. Patent Publication No. 2008/0070593 ("Altman '593")

7   k. U.S. Patent No. 7,330,112 ("Emigh")

8   l. U.S. Patent Publication No. 2008/0132243 ("Spalink")

9   187. An actual and justiciable controversy therefore exists between Google and AGIS

10 regarding whether FMD or any Google devices running FMD have infringed any of the asserted

11 claims of the '970 patent. A judicial declaration is necessary to determine the parties' respective

12 rights regarding the '970 patent.

13   188. Google seeks a judgment declaring that the '970 Patent is invalid and

14 unenforceable under one or more provisions of 35 U.S.C. §§ 101, 102, 103 and/or 112.

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COUNT III

(Declaratory Judgment of Claim Preclusion / Res Judicata / Preclusion Under Kessler Doctrine)

</div>

16

17

18   189. Google hereby restates and incorporates by reference the allegations set forth in

19 paragraphs 1 through 173 of this Complaint as if fully set forth herein

20   190. The doctrine of claim preclusion or res judicata bars AGIS's claims against

21 Google and FMD based on the '970 Patent in whole or in part, because AGIS twice voluntarily

22 dismissed under Federal Rule of Civil Procedure 41 prior actions asserting '970 Patent claims

23 against Google and FMD.

24   191. The first dismissal occurred in the NDCA Case, *AGIS Software Development LLC*

25 *v. Google LLC*, No. 5:22-CV-04826-BLF. On April 7, 2023, AGIS and Google jointly moved

26 pursuant to Rule 41(a)(1)(A)(ii) and (a)(1)(B) for a stipulation and order dismissing AGIS's

27 lawsuit asserting the '970 Patent's original 2 and 10-13. The NDCA Case, Dkt. 437. On April

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1   10, 2023, this Court granted the joint motion dismissing AGIS's allegations based on the original

2   claims of the '970 Patent with prejudice. *Id.*, Dkt. 438. Because that dismissal was with

3   prejudice, it operates as a dismissal on the merits and is res judicata as to all further suits based on

4   the same cause of action.

5   192.   In this case, AGIS asserts amended claims 2 and 10-13 of the '970 Patent, which

6   were amended during *ex parte* reexamination of the '970 Patent. Specifically, AGIS added

7   limitations to claims 2 and 10 to overcome prior art. For claim 2, AGIS amended the claim to

8   incorporate all limitations from original, independent claim 1, plus three additional elements. As

9   excerpted in part below, amended claim 2 includes eighteen total claim elements, only three of

10 which are the new elements added through the amendment, underlined below:

11   2.   A communication system for transmitting, receiving, confirming receipt, and
           responding to an electronic message, comprising:
12
           . . .
13
           means for displaying a geographic map with georeferenced entities on the display of the
14   sender PDA/cell phone;

15   means for obtaining location and status data associated with the recipient PDA/cell phone;
           and
16
           means for presenting a recipient symbol on the geographical map corresponding to a
17   correct geographical location of the recipient PDA/cell phone,

18   . . .

19   means for clearing the text message and a response list from the display of the recipient
           PDA/cell phone or stopping the repeating voice message and clearing the response list
20   from the display of the recipient PDA/cell phone once the manual response is transmitted .
           . . .
21

22   193.   Amended claim 10 has nine total claim elements, and AGIS added the same three

23 elements underlined above to claim 10.

24   194.   Because the amended claims of the '970 Patent merely add limitations to

25 overcome prior art, they are not "materially different" from the original claims and thus do not

26 create a new cause of action for preclusion purposes. *Senju Pharm. Co., Ltd. v. Apotex Inc.*, 746

27 F.3d 1344, 1353 (Fed. Cir. 2014) ("[I]t can be assumed that the reexamined claims will be a

28

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1   subset of the original claims and that no new cause of action will be created."); *see also Aspex*

2   *Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1341 (Fed. Cir. 2012) (rejecting

3   argument that the issuance of amended and new claims negated the res judicata effect of the prior

4   litigation under the original patent claims). Accordingly, AGIS's dismissal with prejudice of

5   claims for relief based on the '970 Patent and FMD in the NDCA Case operates as an

6   adjudication on the merits as to the amended claims of the '970 Patent asserted in this case and

7   bars AGIS's infringement claims asserting the '970 Patent against FMD in this action based on

8   claim preclusion and the *Kessler* doctrine.

9   195.   The second dismissal was AGIS's dismissal of the WDTX Case, *AGIS Software*

10   *Development LLC v. Google LLC*, No. 6:23-CV-00160-DC-DTG. In the WDTX Case, AGIS

11   asserted the amended claims 2 and 10-13 of the '970 Patent against Google's FMD. *Id.*, Dkt. 1

12   ¶¶ 1, 14, 22. On July 20, 2023, AGIS filed a notice of voluntary dismissal pursuant to Rule

13   41(a)(1)(A)(i), stating that it was without prejudice. *Id.*, Dkt. 12. Because this was AGIS's

14   second dismissal of claims for relief based on the '970 Patent and FMD, it operates as an

15   "adjudication on the merits for claim preclusion purposes" under Fed. R. Civ. P. 41(a)(1)(B).

16   Thus, AGIS's second dismissal bars AGIS's infringement claims asserting the '970 Patent against

17   FMD in this action based on claim preclusion and the *Kessler* doctrine.

18   196.   Although AGIS stated that its notice of dismissal of the WDTX Case is without

19   prejudice, its notice does not take into account the full requirements of Rule 41(a)(1)(B), which

20   states, inter alia, "if the plaintiff previously dismissed any federal- or state-court action based on

21   or including the same claim, a notice of dismissal operates as an adjudication on the merits." Fed.

22   R. Civ. P. 41(a)(1)(B). Courts have held that such a dismissal is "an adjudication on the merits"

23   and effectively operates as a dismissal with prejudice. *Realtime Adaptive Streaming LLC v.*

24   *Netflix, Inc.*, No. CV 19-6359-GW-JCX, 2020 WL 7889048, at *2 (C.D. Cal. Nov. 23, 2020); *see*

25   *also Realtime Adaptive Streaming LLC v. Netflix, Inc.*, 41 F.4th 1372, 1381 (Fed. Cir. 2022)

26   (Reyna, J., concurring in part) ("Pursuant to Rule 41(a)(1)(B), and as a matter of law, the second

27   voluntary dismissal operates as an adjudication on the merits," and "[s]uch an adjudication

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1   undeniably changes the legal relationship of the parties, even if the full scope of any resulting

2   claim preclusion is not determined until a third action is filed.").

3   197.   To the extent AGIS argues that claim preclusion does not bar its '970 Patent

4   claims that were amended by reexamination proceedings, those arguments are without merit.

5   Claims that emerge from reexamination do not create a new cause of action that did not exist

6   before. *See Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1342 (Fed. Cir. 2012)

7   (rejecting argument that the issuance of amended and new claims negated the res judicata effect

8   of the prior litigation under the original patent claims); *Senju Pharm. Co. v. Apotex Inc.*, 746 F.3d

9   1344, 1353 (Fed. Cir. 2014) ("We conclude, as the court did in Aspex, that the claims in this case

10   that emerged from reexamination do not create a new cause of action that did not exist before.

11   Senju cannot sue Apotex on the same patent twice.").

12   198.   The Ninth Circuit applies claim preclusion where: "(1) the same parties, or their

13   privies, were involved in the prior litigation, (2) the prior litigation involved the same claim or

14   cause of action as the later suit, and (3) the prior litigation was terminated by a final judgment on

15   the merits." *Acumed LLC v. Stryker Corp.*, 525 F.3d 1319, 1323 (Fed. Cir. 2008) (quoting 9th

16   Circuit law).

17   199.   With respect to the first element, AGIS Software and Google are the same parties

18   in the earlier actions, namely the NDCA Case and the WDTX Case. For the reasons above in

19   paragraphs 22-54, AGIS Holdings and AGIS, Inc. are in privity with AGIS Software because they

20   are alter egos of each other.

21   200.   With respect to the second element, this case and the prior cases (the NDCA Case

22   and the WDTX Case) include the same cause of action. All three cases include claims based on

23   the same asserted patent, the '970 Patent, and the same accused feature, FMD, that forms the

24   basis for AGIS's infringement theory in all three cases.

25   201.   With respect to the third element, "[a] dismissal with prejudice is a judgment on

26   the merits for purposes of claim preclusion." *Pactiv Corp. v. Dow Chem. Co.*, 449 F.3d 1227,

27   1230 (Fed. Cir. 2006). For the reasons above in paragraphs 190-196, AGIS dismissed each of the

28

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1   NDCA Case and the WDTX Case with prejudice, which dismissals operate as a judgment on the

2   merits for purposes of claim preclusion.

3   202.   It is immaterial that the first dismissal of the NDCA Case was only for the pre-

4   amendment original claims of the '970 Patent, while the WDTX Case and this case involve the

5   amended claims of the '970 Patent, because claims that emerge from reexamination do not create

6   a new cause of action that did not exist before as discussed above.

7   203.   Under the *Kessler* doctrine, "when an alleged infringer prevails in demonstrating

8   noninfringement, the specific accused device(s) acquires the 'status' of a noninfringing device

9   vis-à-vis the asserted patent claims." *Brain Life, LLC v. Elekta Inc.*, 746 F.3d 1045, 1057 (Fed.

10   Cir. 2014) (citing *Foster v. Hallco Mfg. Co.*, 947 F.2d 469, 479-80 (Fed. Cir. 1991)). Indeed,

11   "the status of an infringer is derived from the status imposed on the thing that is embraced by the

12   asserted patent claims," *id.*, so Google's FMD cannot infringe the '970 Patent. A dismissal with

13   prejudice of a prior complaint has a preclusive effect under the *Kessler* doctrine. *Askan v. FARO*

14   *Techs., Inc.*, No. 2022-2117, 2023 WL 4101351, at *3 (Fed. Cir. June 21, 2023).

15   204.   Accordingly, AGIS has twice dismissed its actions asserting the '970 Patent

16   against Google. AGIS's first dismissal of the '970 Patent with prejudice precludes AGIS from

17   asserting the same patent against the same party and same product FMD again in this lawsuit.

18   And under Federal Rule of Civil Procedure 41(a)(1)(B), AGIS's second dismissal "operates as an

19   adjudication on the merits" and thus precludes AGIS from asserting the '970 Patent's amended

20   claims 2 and 10-13 against Google and FMD. Each of AGIS's dismissals on the merits also

21   preclude AGIS from accusing Google's FMD under the *Kessler* doctrine, to the extent that AGIS

22   were to allege that Google has engaged in infringement after the adjudications on the merits. *See*

23   *In re PersonalWeb Technologies*, 961 F.3d 1365 (Fed. Cir. 2020).

COUNT IV
(Unenforceability of the '970 Patent Due to Inequitable Conduct)

26   205.   Google hereby restates and incorporates by reference the allegations set forth in

27   paragraphs 1 through 173 of this Complaint as if fully set forth herein.

28   206.   For example, at least the '970 patent is unenforceable because of inequitable

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1   conduct committed during reexamination of the '970 patent and in particular AGIS's withholding

2   of information regarding an earlier litigation in which a district court determined and the Federal

3   Circuit affirmed that claims of AGIS's earlier U.S. Patent No. 7,031,728 ("the '728 patent,"

4   attached hereto as Exhibit A) were invalid as indefinite because the claim term "symbol generator"

5   invoked means-plus-function claiming under 35 U.S.C. § 112, ¶ 6, but the specification of the '728

6   patent failed to disclose adequate structure corresponding to the "symbol generator" claim term.

7   Notwithstanding this determination, AGIS amended independent claim 2 of the '970 patent during

8   reexamination to incorporate a comparable means-plus-function term (i.e., "means for presenting a

9   recipient symbol on the geographical map corresponding to a correct geographical location of the

10   recipient PDA/cell phone") and cited the '728 patent as providing support for this amendment

11   because the '728 patent is incorporated by reference in the '970 patent. AGIS representatives

12   involved in the reexamination had personal knowledge of the '728 patent's litigation history as a

13   result of having entered appearances in the district court litigation and/or on appeal to the Federal

14   Circuit following the district court's determination that claims incorporating the term "symbol

15   generator" were indefinite. Had the AGIS representatives disclosed the '728 patent's litigation

16   history during reexamination of the '970 patent, the Patent Office would not have issued a

17   reexamination certificate including amended claim 2 with the phrase "means for presenting a

18   recipient symbol on the geographical map corresponding to a correct geographical location of the

19   recipient PDA/cell phone" corresponding to the "symbol generator" language previously found to

20   be indefinite for lack of supporting structure. By failing to disclose the '728 patent's litigation

21   history during reexamination of the '970 patent, the AGIS representatives breached their duty of

22   candor. The single most reasonable inference from the failure of the AGIS representatives to

23   disclose the '728 patent's litigation history—despite having identified the '728 patent as providing

24   support for the proposed amended—is that the AGIS representatives intended to deceive the Patent

25   Office into issuing a claim they knew to be unpatentable as indefinite in view of the earlier

26   determinations by the district court and the Federal Circuit that the analogous "symbol generator"

27   term was likewise indefinite for lack of supporting structure.

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207. On May 15, 2020, Google filed a reexamination request (later assigned the 90/014,507 control number) concerning claims 2 and 10-13 of the '970 patent. Google's reexamination request detailed why (1) claims 2 and 10-13 were not entitled to an effective filing date before the actual November 26, 2008 filing date of the '970 patent, such that the Kubala, Hammond, Johnson, and Pepe references all constituted prior art to the '970 patent; (2) the combination of the Kubala and Hammond prior art references presented a substantial new question of patentability as to claims 2 and 10-13; and (3) the combination of the Hammond, Johnson, and Pepe prior art references presented a second substantial new question of patentability as to those claims. Excerpts of the reexamination history are attached hereto as Exhibit B.

208. On or about July 27, 2020, the Patent Office granted Google's reexamination request. The examiners assigned to the request (including the primary examiner as well as two additional conferees) "agree[d] with the contentions and evidentiary support in [Google's] request...that none of the earlier-filed applications provide sufficient written description support for at least a forced-message alert software-application program," as all of the independent claims of the '970 patent required." Accordingly, the examiners agreed with Google's explanation that the '970 patent was only "entitled to a priority date of November 26, 2008." The examiners also agreed with Google that "a substantial new question of patentability as to claims 2 and 10-13 of the '970 patent [was] raised by Kubala and Hammond" and likewise that a separate "substantial new question of patentability as to claims 2 and 10-13 of the '970 patent [was] raised by Hammond, Johnson, and Pepe." Ex. B at pp. 1669 & 1671.

209. Subsequently, on or about March 3, 2021, the examiners issued an office action rejecting claims 2 and 10-13. The examiners again agreed with Google's explanation that the '970 patent was only "entitled to a priority date of November 26, 2008." The examiners in turn rejected claims 2 and 10-13 under pre-AIA § 103(a) as unpatentable over Kubala and Hammond, and likewise as unpatentable over Hammond, Johnson, and Pepe. Ex. B at pp. 1689, 1693-94 & 1713.

210. Following the office action, attorneys for AGIS—including Vincent Rubino, Enrique Iturralde, and Jialin Zhong—conducted an interview with the PTO examiners on or

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1   about May 17, 2021. As reflected in the reexamination interview summary included in the

2   reexamination file history, AGIS's representatives and the PTO examiners discussed but did not

3   reach agreement concerning claim 2. AGIS's representatives and the examiners also discussed

4   proposed new claims 14-16, including claims 15 and 16. Proposed claim 15 depended from

5   claim 2 while including additional limitations including "means for presenting a recipient

6   symbol on the geographical map corresponding to a correct geographical location of the

7   recipient PDA/cell phone." AGIS's representatives "indicated that the corresponding disclosure"

8   for this limitation was "found in the '728 patent, incorporated by reference into the '970 patent

9   disclosure." Ex. B at pp. 1766-68.

10   211.   Later, on or about June 3, 2021, AGIS's representatives responded to the office

11   action and traversed the obviousness rejections while also introducing dependent claim 14

12   (depending from claim 2) and dependent claim 15 (depending from claim 10). Aside from the

13   renumbering, claims 14 and 15 corresponded exactly to proposed claims 15 and 16 as discussed

14   during the above-noted interview during which AGIS's representatives "indicated that the

15   corresponding structure" for the new claims was "found in the '728 patent, incorporated by

16   reference into the '970 patent disclosure." As part of the June 2021 response, AGIS's

17   representatives asserted that "new claims 14 and 15 do not add new matter and are supported by

18   the original disclosure of the patent," which included the '728 patent incorporated by reference.

19   Ex. B at p. 1791.

20   212.   On or about August 19, 2021, the examiners issued a final office action that

21   maintained the rejections concerning original claims 2 and 10-13 of the '970 patent. The

22   examiners also concluded that AGIS's proposed claims 14 and 15 were patentable over the prior

23   art cited in Google's request, which had been directed to the original claims 2 and 10-13 rather

24   than AGIS's subsequently-proposed claims 14 and 15. In particular, as to claim 14 (depending

25   from claim 2), the examiners concluded that:

26   The prior art cited in the Request fails to teach or fairly suggest means for obtaining
            location and status data associated with the recipient PDA/cell phone (i.e., the
27   algorithm described in the '970 patent at col. 3, lines 52-67) and ***means for
            presenting a recipient symbol on the geographical map (displayed on the means***
28

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for displaying ... , i.e., on the LCD display of the sender PDA/cell phone, described in the '970 patent at col. 4, lines 12-16) corresponding to a correct geographical location of the recipient PDA/cell phone (i.e., the algorithm described in the '970 patent at col. 5, lines 28-44), in the context of parent claim 2.

Ex. B at p. 1893 (emphasis added).

213.   Following the final office action, representatives for AGIS—including Enrique Iturralde and Jialin Zhong—conducted an additional interview with the PTO examiners on or about September 13, 2021.

214.   As reflected in the reexamination interview summary included in the reexamination file history, AGIS's representatives and the PTO examiners discussed claims 14 and 15 and a proposed amendment that would include all of the features of the parent claims. Ex. B at pp. 1899-1900.

215.   On or about October 19, 2021, AGIS responded to the final office action by amending independent claims 2 and 10 "to include the patentable subject matter recited in claims 14 and 15." Claim 2 as amended therefore included the requirement of a "means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone."

216.   AGIS's response summarized the earlier examiner interview and noted that Enrique Iturralde and Jialin Zhong had discussed with the examiners "different forms of amendments to claims for taking the patentable subject matter recited in claims 14 and 15..." Ex. B at p. 1918.

217.   On or about November 15, 2021, the examiners issued a "Notice of Intent to Issue *Ex Parte* Reexamination Certificate" and noted that "[previously proposed claims 14 and 15 have been cancelled, their subject matter being incorporated into the proposed amendments to claims 2 and 10, respectively."

218.   The examiners concluded that claims 2 and 10 along with claims 11-13 (dependent on claim 10) were patentable over the prior art cited in Google's request, which had been directed to the original claims 2 and 10-13 rather than AGIS's subsequently proposed amendment. The examiners' "statement of reasons for patentability" stated that:

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The prior art cited in the Request fails to teach or fairly suggest means for obtaining location and status data associated with the recipient PDA/cell phone (i.e., the algorithm described in the '970 patent at col. 3, lines 52-67) and ***means for presenting a recipient symbol on the geographical map (displayed on the means for displaying ... , i.e., on the LCD display of the sender PDA/cell phone, described in the '970 patent at col. 4, lines 12-16) corresponding to a correct geographical location of the recipient PDA/cell phone (i.e., the algorithm described in the '970 patent at col. 5, lines 28-44), in the context of independent claim 2***.

Ex. B at p. 1928 (emphasis added).

219.   The reexamination file history does not reflect any response by AGIS to the examiners' statement of reasons for patentability.

220.   The Patent Office issued an *Ex Parte* Reexamination Certificate on December 9, 2021.

221.   Throughout the pendency of the reexamination, AGIS's representatives had a "duty of candor and good faith in dealing with the [Patent] Office, which include[d] a duty to disclose to the Office all information known to that individual to be material to patentability in [the] reexamination proceeding." 37 C.F.R. § 1.555. In particular, "information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and . . . refutes, or is inconsistent with, a position the patent owner takes in...[a]sserting an argument of patentability." Manual of Patent Examining Procedure (MPEP) § 2280. Such information material to patentability can include information from litigation proceedings. MPEP § 2001.06(c) ("Where the subject matter for which a patent is being sought is or has been involved in litigation and/or a trial proceeding, or the litigation and/or trial proceeding yields information material to currently pending applications, the existence of such litigation and any other material information arising therefrom must be brought to the attention of the examiner or other appropriate official at the U.S. Patent and Trademark Office.").

222.   The litigation history of the '728 patent was material to patentability of at least amended claim 2 of the '970 patent because the U.S. District Court for the Southern District of Florida and the U.S. Court of Appeals for the Federal Circuit made determinations adverse to AGIS concerning the '728 patent, which is incorporated by reference in the '970 patent. Those

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1   determinations refuted and were inconsistent with AGIS's position that claim 2 of the '970 patent

2   was patentable and complied with all statutory requirements, including 35 U.S.C. § 112.

3   223.   On or about May 16, 2014, AGIS sued Life360, Inc. ("Life360") in the U.S.

4   District Court for the Southern District of Florida (Case Number 14-cv-80651) and asserted that

5   Life360 infringed the '728 patent.

6   224.   In response, Life360 asserted that the term "symbol generator" in claims 3 and 10

7   of the '728 patent invoked means-plus-function treatment under pre-AIA 35 U.S.C. § 112(6), but

8   was indefinite because the '728 patent did not disclose an algorithm concerning how the required

9   symbols were generated.

10   225.   The district court agreed with Life360 and ruled in a November 21, 2014

11   Markman Order that "symbol generator" was subject to pre-AIA 35 U.S.C. § 112(6) and was

12   indefinite for lack of supporting structure. A copy of the district court's order is attached hereto as

13   Exhibit C. The district court rejected AGIS's contention that the following passage (from column

14   10, lines 44-46 of the '728 patent) sufficiently disclosed "structure" corresponding to the claimed

15   symbol generator:

16   The communication device is also given a database that includes a geographical
         display on the LCD display and software that coordinates the x and y coordinates
17   on the LCD display touch screen with the geographical display. There is also
         software that places the symbols on the geographical display that represent other
18   cellular phone users that are part of the communications net.

19

20   Ex. C at p. 11. The district court determined that while the '728 patent described in general terms

21   that the symbols were "generated based on the latitude and longitude of the participants," it failed

22   to contain an "algorithm" or description of how those symbols were actually generated. Citing the

23   Federal Circuit's decision in *Aristocrat Technologies Australia v. International Game Technology*,

24   521 F.3d 1328 (Fed. Cir. 2008), the district court explained that "[t]he mere disclosure of a general

25   purpose computing device in the '728 Patent is not structurally sufficient because such devices 'can

26   be programmed to perform very different tasks in very different ways,' and 'simply disclosing a

27   computer as the structure' [was] insufficient." Ex. C at p. 11. In particular, "the disclosure of

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1   'software that coordinates the x and y coordinates on the LCD display touch screen'" described a

2   "function, not structure." Ex. C at p. 12.

3   226.   In reaching this determination, the district court considered but found unpersuasive

4   AGIS's reference in its claim construction brief to column 7, lines 31-37; column 8, lines 45-50;

5   and column 10, lines 40-46 of the '728 patent. In its Rebuttal Claim Construction Brief filed with

6   the district court on October 2, 2014 (attached hereto as Exhibit D), AGIS had argued that these

7   passages supported the "symbol generator" term in claims 3 and 10 of the '728 patent:

8   Utilizing these steps, the symbol generator generates and displays symbols on the
         display screen that represent other participants. See Goldberg Decl., ¶ 22. These
9   algorithmic steps describe examples of how the symbol generator can generate
         symbols that represent each of the participants' cell phones in the communication
10   network on the display screen…

11

12   Ex. D at p. 5. However, these passages simply refer to the x and y coordinates discussed by the

13   district court:

         The display x, y coordinates of the touched point are known by a CPU in the PDA
14   section of the communication system that can coordinate various information
         contained in the PDA portion relative to the x, y coordinate position on the screen.
15   Inside housing 12 is contained the conventional cellular phone elements including a
         modem, a CPU for use with a PDA and associated circuitry connected to a speaker
16   24 and a microphone 38.

17

18   '728 patent (Ex. A), 7:31-38.

19   The screen display 16b, which is a touch screen, provides x and y coordinates of the
         screen 16b to the CPU's software. The software has an algorithm that relates the x
20   and y coordinates to latitude and longitude and can access a communications net
         participant's symbol or an entity's symbol as being the one closest to that point

21

22   Id., 8:45-50.

23   The communication device is also given a database that includes a geographical
         display on the LCD display and software that coordinates the x and y coordinates
24   on the LCD display touch screen with the geographical display. There is also
         software that places symbols on the geographical display that represent other
25   cellular phone users that are part of the communications net

26   Id., 10:40-46. As the district court explained, however, "[t]he disclosure of 'software that

27   coordinates the x and y coordinates on the LCD display touch screen" described a "function, not

28

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1   structure." Ex. C at p. 12.

2   227.   The Federal Circuit later affirmed the district court's determination that claims 3

3   and 10 of the '728 patent were invalid as indefinite based on the "symbol generator" term. A copy

4   of the Federal Circuit's decision is attached hereto as Exhibit E. The Federal Circuit first held that

5   "because the term 'symbol generator' does not describe anything structural, the district court was

6   correct to conclude that the asserted claims which recite the term 'symbol generator' [were]

7   subject to 35 U.S.C. § 112, ¶ 6." Ex. E at p. 11. The Federal Circuit also agreed with the district

8   court that the '728 patent failed to disclose adequate structure corresponding to the symbol

9   generator requirement:

> The specifications of the patents-in-suit do not disclose an operative algorithm for
> the claim elements reciting "symbol generator." The function of generating symbols
> must be performed by some component of the patents-in-suit; however, the patents-
> in-suit do not describe this component. Although the specification of the '728 patent
> suggests that these symbols are generated via "a map database and a database of
> geographically referenced fixed locations... with a specified latitude and
> longitude[,]... [and] [a] database with the constantly updated GPS location," '728
> patent col. 3 ll. 35-41, this only addresses the *medium* through which the symbols
> are generated. A patentee cannot claim a means for performing a specific function
> and subsequently disclose a "general purpose computer as the structure designed to
> perform that function" because this "amounts to pure functional claiming."
> *Aristocrat Techs*., 521 F.3d at 1333. Accordingly, because the specifications of the
> patents-in-suit do not disclose sufficient structure for the "symbol generator"
> function and the asserted claims include this term, the asserted claims are indefinite
> under 35 U.S.C. § 112, ¶ 2.

Id. at 13 (emphasis original).

20   228.   The district court and Federal Circuit's determinations were material to the

21 patentability of amended claim 2 in the '970 patent because they refuted and were inconsistent with

22 positions AGIS took during the reexamination concerning amended claim 2 and in particular the

23 required "means for presenting a recipient symbol on the geographical map corresponding to a

24 correct geographical location of the recipient PDA/cell phone." Had AGIS disclosed the Life360

25 litigation history—and in particular the district court and Federal Circuit's determinations that

26 "symbol generator" was indefinite for lack of supporting structure—the examiners would not have

27 found amended claim 2 of the '970 patent to be patentable and issued a reexamination certificate

28 incorporating claim 2.

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229.   By AGIS's own account in the earlier litigation, the "symbol generator" as claimed in the '728 patent is simply an alternative description for the "means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone" as recited in amended claim 2 of the '970 patent following reexamination. For example, as noted above, AGIS's Rebuttal Markman brief in the Life360 litigation explained that the "symbol generator" as claimed in the '728 patent "generates and displays symbols on the display screen that represent other participants." Ex. D at p. 5. Similarly, AGIS's expert witness testified that that "the symbol generator renders symbols on the display screen that represent other participants" (emphasis added). September 17, 2014 Declaration of Dr. Benjamin Goldberg in Support of Plaintiff's Advanced Ground Information Systems, Inc.'s Opening Claim Construction Brief (attached hereto as Exhibit F) ¶ 22. During the November 2014 Markman hearing, the expert further testified that the "symbol generator" is "the software that displays the symbols on the screen in the appropriate place." Exhibit G (November 4, 2014 Transcript of Markman Hearing) at 11:19-21. AGIS's expert later reiterated that the "symbol generator" is "software...for displaying the symbols, the images for each user on the screen." *Id*. at 50:11-16; *see also id*. at 52:19-21 ("[T]he symbol generator here is just what draws the symbols on the screen at the specified x and y coordinates."); *id*. at 57:16-17 (describing "symbol generator" as the "the software for displaying the symbols on the screen"); *id*. at 58:11-12 (describing "symbol generator" as "software provided on every machine for--exactly for displaying symbols on the screen"). AGIS reiterated this description on appeal to the Federal Circuit. AGIS's opening brief (attached hereto as Exhibit H) cited the expert's testimony that a person of ordinary skill could have utilized "standard software modules that generate symbols on a display." Ex. H at pp. 20-21.

230.   Had AGIS disclosed these materials during reexamination, the examiners would have recognized that AGIS's proposed "means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone" was simply another description for the "symbol generator" in claims 3 and 10 of the '728 patent.

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1   231.   Yet the AGIS representatives (including Vincent Rubino, Enrique Iturralde, and

2   Jialin Zhong) did not disclose these materials—nor anything else concerning the Life360

3   litigation history—even though Rubino, Iturralde, and Zhong had conducted an interview with the

4   PTO examiners on or about May 17, 2021 and "indicated that the corresponding disclosure" for

5   the "means for presenting a recipient symbol on the geographical map corresponding to a correct

6   geographical location of the recipient PDA/cell phone" was "found in the '728 patent,

7   incorporated by reference into the '970 patent disclosure." *See* above (quoting Ex. B at pp. 1766-

8   68).

9   232.   Without the benefit of the Life360 litigation materials, the '970 reexamination

10   examiners instead concluded that this term was associated with "the algorithm described in the '970

11   patent at col. 5, lines 28-44." As noted above, the examiners referred to column 5, lines 28-44 in

12   both the final office action (on or about August 19, 2021) and the notice of intent to issue a

13   reexamination certificate (on or about November 15, 2021). Yet this passage (reproduced below)

14   merely describes how "[t]he software has an algorithm that relates the x and y coordinates to latitude

15   and longitude and can access a communications net participant's symbol:"

16   Also shown on the display screen 16, specifically the geographical display 16b, is a
     pair of different looking symbols 30 and 34, a small triangle and a small square, which
17   are not labeled. These symbols 30 and 34 can represent communication net participants
     having cellular phones in the displayed geographical area that are part of the overall
18   cellular phone communications net, each participant having the same device 10 used.
     The latitude and longitude of symbol 30 is associated within a database with a specific
19   cell phone number and, if available, its IP address and E-mail address. *The screen
     display 16b, which is a touch screen, provides x and y coordinates of the screen 16b
20   to the CPU's software from a map in a geographical database. The software has an
     algorithm that relates the x and y coordinates to latitude and longitude and can
21   access a communications net participant's symbol or a fixed or movable entity's
     symbol as being the one closest to that point.*
22
23

24   '970 patent, 5:28-44 (emphasis added). This passage concerns the same disclosures the district

25   court and Federal Circuit deemed insufficient to support the corresponding "symbol generator"

26   term in the '728 patent. As the district court explained in its Markman Order, "the disclosure of

27   'software that coordinates the x and y coordinates on the LCD display touch screen'" described a

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1   "function, not structure." Ex. C at p. 12. The district court's holding—later confirmed by the

2   Federal Circuit—is material to the patentability of at least claim 2 of the '970 patent as amended

3   during reexamination given the inclusion of the "means for presenting a recipient symbol on the

4   geographical map corresponding to a correct geographical location of the recipient PDA/cell

5   phone" term.

6   233.   The examiners' citation to column 5, lines 28-44 of the '970 patent confirms the

7   materiality of the Life360 litigation materials, including the district court's Markman Order and

8   the Federal Circuit's opinion affirming the finding of indefiniteness, as well as AGIS's briefs and

9   expert witness testimony indicating the equivalence between "symbol generator" and "means for

10 presenting a recipient symbol on the geographical map corresponding to a correct geographical

11 location of the recipient PDA/cell phone" Indeed, the relevant passage (i.e., column 5, lines 28-44

12 of the '970 patent) corresponds almost exactly to column 8, lines 35-50 of the '728 patent); the

13 only differences (highlighted in yellow) are insubstantial:

Column 5, lines 28-44 of the '970 patent	Column 8, lines 35-50 of the '728 patent
Also shown on the display screen 16, specifically the geographical display 16b, is a pair of different looking symbols 30 and 34, a small triangle and a small square, which are not labeled. These symbols 30 and 34 can represent communication net participants having cellular phones in the displayed geographical area that are part of the overall cellular phone communications net, each participant having the same device 10 used. The latitude and longitude of symbol 30 is associated within a database with a specific cell phone number and, if available, its IP address and E-mail address. The screen display 16b, which is a touch screen, provides x and y coordinates of the screen 16b to the CPU's software from a map in a geographical database. The software has an algorithm that relates the x and y coordinates to latitude and longitude and can access a communications net participant's symbol or a fixed or movable entity's symbol as being the one closest to that point.	Also shown on the display screen 16, specifically the geographical display 16b, is a pair of different looking symbols 30 and 34, a small triangle and a small square, which are not labeled. These symbols 30 and 34 can represent communication net cellular phone users in the displayed geographical area that are part of the overall cellular phone communications net used in this invention wherein each of the users has a similar cellular phone to the one shown in FIG. 1. The latitude and longitude of symbol 30 is associated within a database along with a specific phone number. The screen display 16b, which is a touch screen, provides x and y coordinates of the screen 16b to the CPU's software. The software has an algorithm that relates the x and y coordinates to latitude and longitude and can access a communications net participant's symbol or an entity's symbol as being the one closest to that point.

1   Moreover, this passage includes the portion AGIS specifically cited to the district court in the Life360

2   litigation (as noted above, referencing column 8, lines 45-50 of the '728 patent) and which the district

3   court nevertheless determined to be insufficient to provide supporting structure for "symbol

4   generator." Had the Life360 litigation materials been disclosed during reexamination, claim 2 would

5   not have been allowed as amended and the reexamination certificate would not have issued. Indeed,

6   as the district court had determined, "the disclosure of 'software that coordinates the x and y

7   coordinates on the LCD display touch screen'" described a "function, not structure." Ex. C at p. 12.

8   And as the Federal Circuit held when affirming the district court's finding of indefiniteness, the

9   disclosure that symbols are generated via "'a map database and a database of geographically

10   referenced fixed locations... with a specified latitude and longitude[,]... [and] [a] database with the

11   constantly updated GPS location' . . . only addresses the *medium* through which the symbols are

12   generated" and does not disclose a sufficient supporting structure. Ex. E at p. 13 (emphasis

13   original).

14   234.   On information and belief, AGIS representatives Vincent Rubino, Enrique

15   Iturralde, Jialin Zhong, and Peter Lambrianakos each acted with intent to deceive the Patent

16   Office by failing to disclose the Life360 litigation history during the reexamination despite the

17   duty of candor each owed under 37 C.F.R. § 1.555.

18   235.   Lambrianakos and Zhong each signed submissions on behalf of AGIS during the

19   reexamination.

20   236.   Moreover, Zhong, Rubino, and Iturralde each participated in one or more examiner

21   interviews—including the interview on or about May 17, 2021 (during which Zhong, Rubino, and

22   Iturralde all attended and indicated that the proposed claim with the "means for presenting a

23   recipient symbol on the geographical map corresponding to a correct geographical location of the

24   recipient PDA/cell phone" was supported by "corresponding disclosure...in the '728 patent,

25   incorporated by reference into the '970 patent disclosure), a subsequent interview on or about

26   September 13, 2021 (during which Zhong and Iturralde attended and further discussed that claim,

27   which the examiners had "previously found allowable" without having considered the Life360

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1 litigation history), and a further interview on or about October 12, 2021 (during which Zhong and

2 Iturralde attended).

3   237.   Rubino had knowledge of the Life360 litigation history as a result of having

4 participated in both the district court and Federal Circuit proceedings.

5   238.   Rubino entered appearances in both proceedings.

6   239.   Rubino also was listed in the signature block for AGIS's district court claim

7 construction brief, district court rebuttal claim construction brief, Federal Circuit opening brief, and

8 Federal Circuit reply brief.

9   240.   Further, Rubino attended the above-discussed November 4, 2014 Markman hearing

10 during which AGIS's expert explained that the "symbol generator" term in the '728 patent was "the

11 software that displays the symbols on the screen in the appropriate place."

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 1                    UNITED STATES DISTRICT COURT
                      SOUTHERN DISTRICT OF FLORIDA
 2

 3                    Case No. 14-CV-80651-MIDDLEBROOKS

 4   ADVANCED GROUND INFORMATION )
     SYSTEMS, INC.,              )
 5                               )
                  Plaintiff,     )
 6                               )
          -V-                    )
 7                               )
     LIFE360, INC.,              )
 8                               )
                  Defendant.     )    West Palm Beach, Florida
 9                               )    November 4, 2014
                                 )    1:28 a.m.
10

11              TRANSCRIPT OF MARKMAN HEARING

12         BEFORE THE HONORABLE DONALD M. MIDDLEBROOKS

13                    U.S. DISTRICT JUDGE

14   Appearances:

15
     For the Plaintiff:          KENYON & KENYON, LLP
16                               BY:  GEORGE BADENOCH, ESQ.
                                 BY:  TOM MAKIN, ESQ.
17                               BY:  VINCENT RUBINO, ESQ.
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1   Ex G at 1, 11:19-21.

2   241.   Lambrianakos had knowledge of the Life360 litigation history as a result of having

3   entered an appearance on December 22, 2016 in related Federal Circuit proceedings (*Advanced*

4   *Ground Information v. Life360, Inc.* CAFC-16-1332) during which AGIS unsuccessfully appealed

5   the district court's determination under 35 U.S.C. § 285 that the case was exceptional and AGIS

6   was therefore obligated to pay Life360's attorneys fees.

7   242.   On information and belief, Iturralde had knowledge of the Life360 litigation history

8   as a result of having represented AGIS in over forty subsequent proceedings filed before May 17,

9   2021 (i.e., the date of the first interview with the '970 patent examiners, in which Itrurralde

10 represented AGIS along with Rubino and Lambrianakos) and in which Rubino and/or

11 Lambrianakos had also represented AGIS alongside Iturralde.

12   243.   For example, in *AGIS Software Development LLC v. T-Mobile USA, Inc. et al*, 2-

13 21-cv-00072 (EDTX), Defendants' Responsive Claim Construction Brief (served on September

14 28, 2021, while the '970 reexamination was still underway and Itrurralde continued to have a duty

15 of candor) specifically referenced the Life360 litigation and how the Federal Circuit had affirmed

16 the district court's finding of indefiniteness as to the '728 patent claims including the "symbol

17 generator" phrase.

18   244.   Itrurralde had entered an appearance in the T-Mobile case and therefore was served

19 with the brief referencing the litigation history.

20   245.   On information and belief, Zhong had knowledge of the Life360 litigation history

21 as a result of having worked with Rubino, Lambrianakos, and Iturralde during the reexamination

22 of the '970 patent and other AGIS patents.

23   246.   In response to the reexamination request, the Patent Office conducted a litigation

24 search concerning the '970 patent. This search is reflected in the reexamination file history.

25 However, there is no indication in the file history that the Patent Office conducted a litigation

26 search concerning the '728 patent. Nor is there any other reference to the Life360 litigation history

27 in the reexamination file history.

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247. Accordingly, Rubino, Iturralde, Zhong, and Lambrianakos each had a duty to disclose the Life360 litigation history (including the district court and Federal Circuit decisions attached hereto as Exhibits C and E) given its above-discussed materiality. *Cf.* MPEP § 2280 ("The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement.").

248. Rubino did not disclose the Life360 litigation history during the reexamination of the '970 patent—thereby violating Rubino's duty of candor under 37 C.F.R. § 1.555.

249. Iturralde did not disclose the Life360 litigation history during the reexamination of the '970 patent—thereby violating Iturralde's duty of candor under 37 C.F.R. § 1.555.

250. Zhong did not disclose the Life360 litigation history during the reexamination of the '970 patent—thereby violating Zhong's duty of candor under 37 C.F.R. § 1.555.

251. Lambrianakos did not disclose the Life360 litigation history during the reexamination of the '970 patent—thereby violating Lambrianakos's duty of candor under 37 C.F.R. § 1.555.

252. The single most reasonable inference from their failures to disclose the Life360 litigation history is that each of Rubino, Iturralde, Zhong, and Lambrianakos acted with intent to deceive the Patent Office and in particular to convince the Patent Office to issue a reexamination confirming the patentability of claim 2 of the '970 patent as amended (i.e., requiring a "means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone") even though the district court had ruled and the Federal Circuit had affirmed in the Life360 litigation that the corresponding "symbol generator" term (i.e., "the software that displays the symbols on the screen in the appropriate place," as AGIS's own expert in the Life360 litigation described the "symbol generator") was indefinite for lack of corresponding structure. Rubino, Iturralde, Zhong, and Lambrianakos each remained silent even after the examiners cited column 5, lines 28-44 of the '970 patent in connection with the "means for

1   presenting a recipient symbol on the geographical map corresponding to a correct geographical

2   location of the recipient PDA/cell phone" term.

3   253.   Given their knowledge of the Life360 litigation, Rubino, Iturralde, Zhong, and

4   Lambrianakos each knew that the reference in column 5, lines 28-44 to the "latitude and longitude"

5   of symbols and a "software algorithm...that relates the x and y coordinates to latitude and longitude"

6   corresponded exactly to disclosures in the '728 patent that the district court and Federal Circuit had

7   deemed insufficient to support the "symbol generator" term.

8   254.   Yet Rubino, Iturralde, Zhong, and Lambrianakos failed to inform the Patent Office

9   that the district court and Federal Circuit had concluded that such generic disclosures failed to

10   provide sufficient structure. Indeed, as the district court determined (but Rubino, Iturralde, Zhong,

11   and Lambrianakos failed to disclose to the Patent Office), the '728 patent's "disclosure of 'software

12   that coordinates the x and y coordinates on the LCD display touch screen" concerned "a function,

13   not structure."

14   255.   Similarly, as the Federal Circuit explained when affirming the district court decision

15   (but Rubino, Iturralde, Zhong, and Lambrianakos again failed to disclose to the Patent Office), the

16   '728 patent's discussion of a "map database and a database of geographically referenced fixed

17   locations . . . with a specified latitude and longitude" did not disclose adequate structure and instead

18   merely concerned the "*medium* through which the symbols are generated" (emphasis original).

19   256.   Moreover, during their interview with the Patent Office on or about May 17, 2021,

20   Rubino, Iturralde, and Zhong referred to the '728 patent as providing the "corresponding disclosure"

21   for the "means for presenting a recipient symbol on the geographical map corresponding to a correct

22   geographical location of the recipient PDA/cell phone" term. Ex. B at 1767-68. This reference to the

23   '728 patent without any corresponding acknowledgment of the '728 patent's litigation history

24   further confirms that Rubino, Iturralde, and Zhong acted with intent to deceive the Patent Office.

25   257.   As a result of this inequitable conduct committed by Rubino, Iturralde, Zhong, and

26   Lambrianakos during reexamination of the '970 patent, the '970 patent is unenforceable against

27   Google.

28

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COUNT V
(Unenforceability of the '970 Patent Due to Unclean Hands)

258.   Google hereby restates and incorporates by reference the allegations set forth in paragraphs 1 through 173 of this Complaint as if fully set forth herein.

259.   The '970 patent is unenforceable as against Find My Device, and other functionalities developed by Google, as well as any products that AGIS accuses of infringement based on functionalities developed by Google, as a result of AGIS's deceit and bad faith during reexamination of the '970 patent, when AGIS violated the protective order entered by the United States District for the Eastern District of Texas in *AGIS I*, *AGIS Software Development LLC v. Google LLC*, Case No. 2:19-cv-000361-JRG. Despite the requirements of the protective order in *AGIS I*, AGIS attorneys who had reviewed confidential documentation produced or otherwise made available by Google in *AGIS I* participated in the process of amending the claims of the '970 patent during the reexamination and prosecuting those amended claims to obtain the reexamination certificate that issued on December 9, 2021. This violation of the protective order—detailed below—is directly related to AGIS's assertion of the '970 patent against Google importing or selling products incorporating Google functionalities because all of the claims in the '970 patent that AGIS asserts either (1) were amended during reexamination (when AGIS attorneys violated the protective order in the *AGIS I*), or (2) depend from claims that were amended during reexamination. Moreover, AGIS's violation of the protective order injured Google and affects the balance of equities between Google on one hand, and AGIS on the other hand. The purpose of the protective order was to facilitate discovery in *AGIS I*—including highly confidential information concerning the operation of Google functionalities such as "Find My Device," which AGIS had accused of infringement in *AGIS I*) while ensuring that AGIS did not use such highly confidential information to obtain additional patent claims or amend existing claims that purportedly cover Google functionalities. Yet AGIS did precisely what the protective order prohibits. AGIS attorneys who signed the protective order violated it by participating in the amendment of claims 2 and 10 of the '970 patent, which AGIS contends to read on Google technologies about which the AGIS attorneys obtained detailed and highly confidential technical

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1   information pursuant to the protective order. Given the protective order violations, it would be

2   inequitable to permit AGIS to assert the remaining claims of the '970 patent following

3   reexamination against Find My Device or other Google functionalities.

4   260.   On November 4, 2019, AGIS sued Google in the Eastern District of Texas and

5   asserted claims of the '970 patent and other patents.

6   261.   AGIS and Google subsequently negotiated a protective order to govern discovery

7   in *AGIS I*. While certain aspects were disputed and submitted to the Eastern District of Texas

8   court for resolution, AGIS and Google agreed that:

> Absent written consent from the designating Party, any person associated or affiliated with a Party and permitted to receive said Party's Protected Material that is designated RESTRICTED - ATTORNEYS' EYES ONLY and/or RESTRICTED CONFIDENTIAL SOURCE CODE (collectively "HIGHLY SENSITIVE MATERIAL"), who obtains, receives, has access to, or otherwise learns, in whole or in part, said Party's HIGHLY SENSITIVE MATERIAL under this Order shall not: (i) prepare, prosecute, supervise, or assist in the preparation or prosecution of any patent application before any foreign or domestic agency, including the United States Patent and Trademark Office pertaining to the field of invention of the patents-in-suit.

15   Ex. I at pp. 12-13.

16   262.   They also agreed that while this language was "not intended to and shall not

17   preclude counsel who obtains, receives, or otherwise learns of, in whole or in part, the other

18   Party's HIGHLY SENSITIVE MATERIAL of a technical nature from participating directly or

19   indirectly in reexamination" proceedings:

> any attorney who obtains, receives, or otherwise learns, in whole or in part, the other Party's HIGHLY SENSITIVE MATERIAL of a technical nature produced by another Party ***may not, directly or indirectly, advise, consult, or participate in the drafting of amended or substitute claims in the proceeding, and will not use any of the producing Party's Protected Material in the proceeding.***

24   Ex. I at p. 13 (emphasis added). To this end, AGIS and Google also agreed that:

> [t]o ensure compliance with the purpose of this provision, ***each Party shall create an "Ethical Wall" between those persons with access to HIGHLY SENSITIVE MATERIAL of a technical nature and any individuals who, on behalf of the Party or its acquirer, successor, predecessor, or other affiliate, prepare, prosecute, supervise or assist in the preparation or prosecution of any patent application pertaining to the field of invention of the patents-in-suit.***

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1   Ex. I at p. 13 (emphasis added).

2   263.   Following the joint motion, the district court entered a protective order on April

3   22, 2020 (attached hereto as Exhibit J). Paragraph 11 of the protective order provided that:

> Absent written consent from the designating Party, any person associated or affiliated with a Party and permitted to receive said Party's Protected Material that is designated RESTRICTED - ATTORNEYS' EYES ONLY and/or RESTRICTED CONFIDENTIAL SOURCE CODE (collectively "HIGHLY SENSITIVE MATERIAL"), who obtains, receives, has access to, or otherwise learns, in whole or in part, said Party's HIGHLY SENSITIVE MATERIAL under this Order shall not: (i) prepare, prosecute, supervise, or assist in the preparation or prosecution of any patent application before any foreign or domestic agency, including the United States Patent and Trademark Office pertaining to the field of invention of the patents-in-suit on behalf of the receiving Party or its acquirer, successor, predecessor, or Affiliate during the pendency of this Action and for two years after its conclusion, including any appeals except with respect to the acquisition, licensing, or any other transaction involving the patents-in-suit and/or all patents and patent applications related thereto. Nothing in this Order shall prohibit the acquisition or patents or patent applications for any entity other than a party. The prohibitions in this Paragraph are not intended to and shall not preclude counsel who obtains, receives, or otherwise learns of, in whole or in part, the other Party's HIGHLY SENSITIVE MATERIAL of a technical nature from participating directly or indirectly in reexamination, inter partes review, interference proceedings, or covered business method review proceedings, provided that *any attorney who obtains, receives, or otherwise learns, in whole or in part, the other Party's HIGHLY SENSITIVE MATERIAL of a technical nature produced by another Party may not, directly or indirectly, advise, consult, or participate in the drafting of amended or substitute claims in the proceeding*, and will not use any of the producing Party's Protected Material in the proceeding. To ensure compliance with the purpose of this provision, each Party shall create an "Ethical Wall" between those persons with access to HIGHLY SENSITIVE MATERIAL of a technical nature and any individuals who, on behalf of the Party or its acquirer, successor, predecessor, or other affiliate, prepare, prosecute, supervise or assist in the preparation or prosecution of any patent application pertaining to the field of invention of the patents-in-suit. The provision shall not bar entire firms, rather only the individuals who actually receive and review a Party's HIGHLY SENSITIVE MATERIAL.

Ex. J at pp. 12-13 (emphasis added).

       264.   On November 22, 2019, Vincent Rubino and Enrique Iturralde entered

appearances on behalf of AGIS in *AGIS I*. Rubino and Iturralde subsequently obtained "Highly

Sensitive Material" of a technical nature from Google as defined in the April 22, 2020 protective

order and pursuant to the restrictions in that order. For example, Google produced hundreds of

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1   technical documents in *AGIS I* that qualified as "Highly Sensitive Material," including

2   engineering documents and specifications, as well as source code. On information and belief,

3   Rubino and Iturralde received and accessed such technical documents, which constitute "Highly

4   Sensitive Material" of a technical nature. For example, on December 22, 2020, Iturralde

5   defended the deposition of AGIS's technical expert witness Joseph McAlexander. McAlexander

6   had reviewed numerous Google technical materials–including source code–concerning, *inter alia*,

7   Google's Find My Device applications. During the McAlexander deposition that Itrurralde

8   defended, McAlexander was asked detailed technical questions concerning multiple exhibits that

9   qualify as "Highly Sensitive Material" of a technical nature under the protective order. The

10   deposition itself likewise constitutes "Highly Sensitive Material" of a technical nature. Likewise,

11   on November 6, 2020, Rubino took the deposition of Amanda Moore, who held the position of

12   product manager at Google. During the Moore deposition, Rubino asked detailed technical

13   questions and Moore provided testimony that qualified as "Highly Sensitive Material" of a

14   technical nature. Further, Rubino utilized multiple exhibits that qualify as "Highly Sensitive

15   Material" of a technical nature. Likewise, on October 27, 2020, Rubino took the deposition of

16   Jonathan Brunsman, who held the position of Distinguished Engineer at Google and worked on

17   the Find My Device application. During the Brunsman deposition, Rubino asked detailed

18   technical questions and Brunsman provided testimony that qualified as "Highly Sensitive

19   Material" of a technical nature. Further, Rubino utilized multiple exhibits that qualify as "Highly

20   Sensitive Material" of a technical nature.

21   265.   Despite having obtained such "Highly Sensitive Material" from Google, Rubino

22   and Iturralde participated in an examiner interview on or about May 17, 2021 during the

23   reexamination of the '970 patent that had been requested by Google and ordered by the Patent

24   Office. According to the agenda submitted by AGIS, the agenda for the interview included

25   "proposed new claims 14-16." The ex parte reexamination interview summary subsequently

26   prepared by the examiners confirmed that "Patent Owner's representatives" (i.e., including one or

27   both of Rubino and Iturralde, in addition to Jialin Zhong, who also attended the interview)

28

1   discussed proposed claims 15 and 16 in particular and "indicated that the corresponding

2   disclosure is found in the '728 patent."

3   266.   Iturralde subsequently participated in an additional examiner interview on or about

4   September 13, 2021, when the sole agenda item was "entry of proposed amendments to claims

5   14-15 and new claims 16-21."

6   267.   The single most reasonable inference from the record is that Iturralde and Rubino

7   each "advise[d], consult[ed], [and] participate[d] in the drafting of amended or substitute claims"

8   during the reexamination of the '970 patent even though paragraph 11 of the protective order

9   entered by the E.D. Texas court expressly prohibited each of those activities given that Iturralde

10 and Rubino had received "Highly Sensitive Material" of a technical nature from Google. As a

11 result, Iturralde and Rubino were able to assist Jialin Zhong in pursuing amended claims that they

12 believed would cover Google functionalities while purportedly overcoming the prior art Google

13 had identified in its reexamination request. This conduct violated the protective order and has an

14 immediate and necessary connection to AGIS's assertion of the reexamined claims of the '970

15 patent in this suit. Accordingly, the equities require that AGIS be barred from enforcing the '970

16 patent against any products that AGIS accuses of infringement based on functionalities developed

17 by Google given that Iturralde and Rubino advised, consulted, and participated in the drafting of

18 amended claims in the '970 patent despite having received highly confidential technical

19 information concerning those functionalities.

20 ### PRAYER FOR RELIEF

21 WHEREFORE, Google prays for judgment as follows:

22 A.   Declaring that FMD and Google devices running FMD do not directly or

23 indirectly infringe any asserted claims of the '970 Patent, either literally or under the doctrine of

24 equivalents;

25 B.   Declaring that each claim of the '970 Patent is invalid and unenforceable;

26 C.   Declaring that the AGIS is barred from asserting the '970 Patent against

27 Google or FMD under Claim Preclusion, Res Judicata, and the *Kessler* Doctrine;

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1   D.   Declaring that judgment be entered in favor of Google and against AGIS on

2 Google's claims;

3   E.   Finding that this is an exceptional case under 35 U.S.C. § 285;

4   F.   Awarding Google its costs and attorneys' fees in connection with this action;

5 and

6   G.   Awarding Google such other and further relief as the Court deems just and

7 proper.

8 <div align="center">**JURY DEMAND**</div>

9   Pursuant to Federal Rule of Civil Procedure 38 and Civil Local Rule 3-6, Google demands

10 a jury trial on all issues and claims so triable.

11

12   Dated: November 13, 2023   O'MELVENY & MYERS LLP

13

14   By: /s/ *Luann L. Simmons*
                                Luann L. Simmons

15

16   DARIN SNYDER
                     LUANN L. SIMMONS

17   MARK LIANG
                     BILL TRAC

18   AMY LIANG
                     SORIN ZAHARIA

19   DANIEL SILVERMAN
                     STACY YAE

20   CASON COLE
                     GRANT GIBSON

21   *Attorneys for Plaintiff Google LLC*

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