

April 3, 2024

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Re: *Headwater Research LLC v. Samsung Electronics Co., Ltd. et al., Case No. 2:23-cv-00103 (E.D. Tex.)*

Dear Counsel:

Samsung Electronics Co., Ltd. (“**Samsung**”) has filed an *inter partes* review (IPR) petition (IPR2024-00003) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1-18 of U.S. Patent No. 9,198,117 (“**the ’117 Patent**”). The tables in attached Appendix A list all grounds, challenged claims, and references asserted in IPR2024-00003.

I write to inform you that Samsung hereby stipulates that, if the PTAB institutes IPR2024-00003, Samsung agrees not to pursue any grounds raised in the IPR, any grounds raised within Samsung’s invalidity contentions that were raised or could have been raised in the IPR, or any grounds Samsung could have reasonably raised before the PTAB, in this district court litigation or any parallel proceeding. *Sotera Wireless, Inc. v. Masimo Corp.*, Case IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). Samsung reserves the right to assert in the District Court proceedings prior art that is not eligible for PTAB consideration, e.g., the system art noted in Appendix B below and the system art identified in Samsung’s invalidity contentions.¹ Samsung’s reservation is consistent with a *Sotera* stipulation because the grounds listed in Appendix B are based on prior art that is ineligible for consideration before the PTAB, and that could not have been raised before the PTAB.

¹ Samsung notes that discovery in the District Court proceedings is currently ongoing and Samsung expects Google, Apple, Blackberry, OpenWave, Nokia, and Microsoft to produce additional materials and/or testimony relating to the system art listed in Appendix B below. For the avoidance of doubt, Samsung reserves the right to rely on such forthcoming productions in the District Court proceedings.

April 3, 2024
Page 2

For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2024-00003, Samsung reserves the right to assert any grounds of invalidity in the District Court proceedings against the '117 Patent.

Sincerely,

A handwritten signature in black ink, appearing to read "Thad Kodish", written in a cursive style.

Thad Kodish

Attorney for Samsung Electronics Co., Ltd.

Appendix A – Grounds and Prior Art References Used in IPR2024-00003

Ground	Claim(s)	35 U.S.C. §103
1A	1, 3-13	Houghton-Kalibjian
1B	2, 16-18	Houghton-Kalibjian-Munson
1C	14-15	Houghton-Kalibjian-Rakic
2A	1, 3-6, 9-11, 13-15	Lee-Ellison-Anderson
2B	2, 16-18	Lee-Ellison-Anderson-Hämäläinen
3C	7-8, 12	Lee-Ellison-Anderson-Houghton

List of References

Reference Name	Details
Houghton	International Patent Publication. No. WO 2006/077283 A1
Kalibjian	U.S. Patent Publication No. 2007/0011736 A1
Munson	U.S. Patent Publication No. 2009/0240807
Rakic	U.S. Patent Publication No. 2009/0282256
Anderson	<i>Security Engineering</i> , second edition
Lee	International Patent Publication. No. WO 2008/048075 A1
Ellison	U.S. Patent No. 7,082,615 to Ellison
Hämäläinen	U.S. Patent Publication No. 2007/0214245 A1

Appendix B – System Art

Devices and/or Servers supporting Amp'd Mobile system
Devices and/or Servers supporting Apple Push Notifications
Devices and/or Servers supporting BlackBerry Mobile Data Service, App World, and/or other push services
Devices and/or Servers supporting D-BUS communication service
Android Devices and/or Servers supporting Google Messaging Delivery
Devices and/or Servers supporting MMS technology
Windows Mobile Devices and/or Servers supporting ActiveSync and/or Microsoft Direct Push technology
Devices and/or Servers supporting OpenWave push technology, including OpenWave Mobile Access Gateway
Devices and/or Servers supporting Nokia push technology
Devices and/or Servers supporting ProcessOne Push Platform
Devices and/or Servers supporting Wireless Access Protocol