IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Gregory G. Raleigh	
U.S. Patent No.:	8,406,733	Attorney Docket No.: 39843-0164IP1/2
Issue Date:	March 26, 2013	
Appl. Serial No.:	13/461,141	
Filing Date:	May 1, 2012	
Title:	AUTOMATED DEVICE PROVISIONING AND ACTIVATION	

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P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONERS' NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS AGAINST U.S. PATENT NO. 8,406,733

Petitioners Samsung Electronics Co., Ltd. ("Samsung") and Google LLC ("Google") present two concurrent petitions challenging validity of certain claims of U.S. Patent 8,406,733 ("'733 patent"): in IPR2024-00341 and in IPR2024-00342.

I. Ranking of Petitions

Although both petitions are meritorious and justified, Petitioners request that the Board consider the petitions in the following order:

Rank	Petition	Primary Reference	Claims
1	IPR2024-00341 (TS-23.140 Petition)	TS-23.140	1-17, 19, 21-27, 29, 30
2	IPR2024-00342 (Houghton Petition)	Houghton	1-24, 26-30

II. Material Differences Support Instituting Multiple Petitions

Material differences exist between the petitions because they (1) rely on different types of primary references (patent vs. non-patent references), (2) rely on different art combinations demonstrating obviousness in materially different ways, (3) challenge a large volume of asserted claims, and (4) challenge different claims.

First, each petition relies on a different type of primary reference, with each requiring a different showing to demonstrate that it qualifies as prior art. The TS-23.140 Petition relies upon a non-patent reference (TS-23.140) as the primary reference, whereas the primary reference relied upon in the Houghton Petition is a patent reference (Houghton). Houghton is a PCT publication that was published more than one year prior to the earliest possible priority date alleged in the '733 Patent. As to

TS-23.140, Petitioners believe they have provided sufficient evidence (*see* EX-1024) to demonstrate its public availability before the priority date, such that TS-23.140 would also qualify as prior art. However, the public availability of TS-23.140 is open to challenge by Patent Owner—which can be mounted before or ***after*** institution. Thus, if the Houghton-based petition is discretionarily denied, Patent Owner can raise challenges to the TS-23.140's public availability after institution. And, if such arguments are successful, Petitioners would be left with no IPR challenge against the Challenged Claims, despite having diligently challenged claims in the denied Houghton Petition where such a public-availability challenge is unlikely.

Second, the petitions challenge the claims from different perspectives, each based on the teachings of materially different primary references and arguments/combinations that apply differently to the challenged claims. TS-23.140 is a 3GPP standard for a multimedia messaging service (MMS) that discloses transmission and receipt of encrypted multimedia messages between elements of a network, including MMS-registered applications resident on end-user devices. Houghton, on the other hand, discloses push messaging in the context of client-server architectures, with a particular focus on pushing commands and messages from a push server to a push client that are then relayed to applications resident on the client device. Both petitions additionally leverage the symmetric data encryption techniques taught by Ogawa, as applied in combination with the different systems presented by TS-23.140

and Houghton respectively.

Moreover, whereas the TS-23.140 Petition leverages the teachings of TS-23.140 to render obvious the features of claims 3, 4, 6, 11, 12, 16, 17, 23, and 24, the Houghton Petition demonstrates obviousness of these claims using a combination of Houghton and Hwang, a secondary reference not used in the TS-23.140 Petition. The Houghton Petition also provides reasons to combine Houghton, Ogawa, and Hwang not presented in the TS-23.140 Petition. On this record, each petition compellingly demonstrates the unpatentability of the Challenged Claims, using non-redundant and non-duplicative grounds. Efficiencies and public policy concerns therefore warrant PTAB consideration of both petitions, which would prevent the unjust result of strong invalidity grounds being dismissed for procedural reasons.

Third, the large number of asserted claims in litigation against Petitioner Samsung makes an IPR challenge using a single petition especially challenging. (Petitioner Google is not a party to the litigation brought by Patent Owner). Specifically, of the '733 Patent's 30 claims, two are independent claims and the remaining 28 (all depending from independent claim 1) present different claimed subject matter. In litigation, Patent Owner has asserted a large majority of these claims (claims 1-14, 19, 21-24, 26, 29, and 30) against Petitioner Samsung, and has reserved its right to later assert any currently-unasserted claims against Petitioner Samsung. EX-1021, p. 2. Such a high volume of asserted claims warrants multiple petitions, consistent

with Board precedent and the Trial Practice Guide. *See* Consolidated TPG at 59 (Nov. 2019) ("…circumstances in which more than one petition may be necessary[] includ[e]… when the patent owner has asserted a large number of claims"); *Align Technology, Inc., v. 3Shape A/S*, IPR2021-01309, Paper 11 at 11-13 (PTAB Feb 9, 2022) (granting two petitions against 20 claims); *Dolby Laboratories, Inc. v. Intertrust Technologies Corp.*, IPR2020-01106, Paper 12 at 19-21 (PTAB Jan 5, 2021) (granting two petitions against 18 claims). A second petition is especially warranted given that the independent claims are "lengthy" and "complex"—which further exacerbates the difficulty of presenting all arguments in a single petition. *See Adobe Inc. v. Synkloud Technologies, LLC*, Paper 8 at 8-10 (PTAB Mar. 11, 2021).

Fourth, given that all 30 claims may be asserted in current litigation against Petitioner Samsung—and may later be asserted against Petitioner Google in potential future litigation—Petitioners diligently attempted to challenge all claims using grounds based on TS-23.140 and Houghton. And yet, given the scope and content of the prior art/combinations presented in each petition, certain dependent claims could only be challenged by either the TS-23.140-based ground or Houghton-based grounds (but not both). Specifically, claim 25 is only challenged in the TS-23.140 Petition, and claims 18, 20, and 28 are only challenged in the Houghton Petition. A denial of institution of one of the petitions will therefore leave Petitioners with no IPR remedy for challenging the dependent claims challenged in only that petition.

III. Instituting Both Petitions Would Not Impose Undue Burden

To minimize the burden of institution of two petitions, Petitioners have purposefully used the same secondary reference (Ogawa) in a similar manner in both petitions. This similarity includes similar motivations to combine these secondary references with the respective primary references. Additionally, Petitioner Samsung relied upon TS-23.140 and Houghton as primary references in IPR2024-0010, which challenges the claims of a patent (9,615,192) that shares a common specification and similar concepts as those present in the '733 claims.[1] Given these similarities between the references and the claims/specification of the '733 and '192 Patents, consideration of the challenges raised in the TS-23.140 and Houghton Petitions would not present any undue burden to the Board or to Headwater. And, unlike cases where Petitioners may use "repeated attacks" via multiple petitions to present dozens of grounds relying on myriad of different primary and secondary references, Petitioners here are presenting only two petitions, with each relying on different primary references, but the same secondary reference (Ogawa) that is applied in the presented combinations in a similar manner. *See General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential).

For these reasons, Petitioners submit that institution of both petitions is justified, and respectfully request that the Board institute trial on both.

[1] Google has no input and is not a party or real-party-in-interest in IPR2024-0010.

Respectfully submitted,

Dated 01/23/2024

/Karan Jhurani/

W. Karl Renner, Reg. No. 41,265
Jeremy J. Monaldo, Reg. No. 58,680
Karan Jhurani, Reg. No. 71,777

Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner Samsung

Gregory F. Corbett,
pending admission *pro hac vice*,
Turhan F. Sarwar,
pending admission *pro hac vice*,

Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210
T: 617-646-8000
F: 617-646-8646

Attorneys for Petitioner Google

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on January 23, 2024, a complete and entire copy of this Petitioner's Notice Ranking Petitions was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

Headwater Research LLC
Outside Firm 1
110 North College Avenue, Suite 1116
Tyler, TX 75702

/Michael Stanwyck/
Michael Stanwyck
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(202) 626-7790