

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
GOOGLE LLC,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2024-00342
Patent 8,406,733

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	PATENT OWNER DOES NOT DISPUTE THAT ALL THIRTY CLAIMS MAY BE ASSERTED AGAINST <u>BOTH</u> PETITIONERS	2
	A. Patent Owner Fails to Acknowledge Petitioner Google.....	2
	B. Patent Owner <u>Continues</u> to Reserve the Right to Assert All Thirty Claims Against Petitioner Samsung	3
III.	PETITIONERS DILIGENTLY CHALLENGED AS MANY CLAIMS AS POSSIBLE IN EACH PETITION.....	4
IV.	INSTITUTING WILL NOT IMPOSE UNDUE BURDEN.....	5

EXHIBIT LIST

EX-1001	U.S. Patent No. 8,406,733 to Raleigh (“the ’733 Patent”)
EX-1002	Excerpts from the Prosecution History of the ’733 Patent (“the Prosecution History”)
EX-1003	Declaration and Curriculum Vitae of Dr. Patrick Traynor
EX-1004	RESERVED
EX-1005	U.S. Pat. No. 8,195,961B2 (“Ogawa”)
EX-1006	PCT Pat. App. Pub. No 2006/077283A1 (“Houghton”)
EX-1007	EP Pat. App. Pub. No. 1,909,463A1 (“Hwang”)
EX-1008	PCT Pat. App. Pub. No. WO 2008/048075A1 (“Lee”)
EX-1009	U.S. Pat. No. 7,975,147B1 (“Qumei”)
EX-1010	U.S. Pat. No. 9,032,192B2 (“Frank”)
EX-1011	RESERVED
EX-1012	RESERVED
EX-1013	The Secure Sockets Layer (“SSL”) Protocol, V. 3.0, available at https://web.archive.org/web/19970614041044/http://home.netscape.com/eng/ssl3/ssl-toc.html and https://web.archive.org/web/19970617034012/http://home.netscape.com/eng/ssl3/3-SPEC.HTM#1
EX-1014	The Transport Layer Security (“TLS”) Protocol, V. 1.1, available at https://www.ietf.org/rfc/rfc4346.txt
EX-1015	US. Pat. App. Pub. No. 2003/0096625 (“Mi-Su Lee”)
EX-1016	US Pat. No. 7,844,915 B2 (“Platzer”)
EX-1017	US Pat. No. US 8,370,818 (“Osminer”)
EX-1018	RESERVED

EX-1019	RESERVED
EX-1020	USPTO Binding Interim Guidance Addressing PTAB’s Approach to Discretionary Denials, June 21, 2022, available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf
EX-1021	Plaintiff Headwater Research LLC’s Disclosure of Asserted Claims And Infringement Contentions, Headwater Research LLC v. Samsung Electronics Co., 6:23-cv-00103-JRG-RSP (WDTX)
EX-1022	Docket Control Order , 2:23-CV-00103-JRG-RSP, [63] December 1, 2023
EX-1023	Samsung Stipulation letter regarding IPR grounds in District Court Litigation
EX-1024	RESERVED
EX-1025	RESERVED
EX-1026	U.S. Patent No. 7,509,487 to Lu et al. (“Lu”)
EX-1027	U.S. Patent Pub. No. 2005/0207379 to Shen et al. (“Shen”)
EX-1028	Transporting data between wireless applications using a messaging system—MMS, Miraj E Mostafa, Wireless Communications and Mobile Computing (2007) (“Mostafa”)
EX-1029	Dictionary of Computer Science, Engineering, and Technology, CRC Press LLC, 2001
EX-1030	RESERVED
EX-1031	U.S. Patent No. 8,010,669 to Sathish
EX-1032	RESERVED
EX-1033	U.S. Patent No. 6,101,485 to Fortenberry
EX-1034	U.S. Patent Pub. No. 2009/0037270 to Patro
EX-1035	RESERVED

EX-1036	RESERVED
EX-1037	RESERVED
EX-1038	Plaintiff Headwater Research LLC's Amended Infringement Contentions, Headwater Research LLC v. Samsung Electronics Co., 6:23-cv-00103-JRG-RSP (WDTX)
EX-1039	RESERVED
EX-1040	RESERVED
EX-1041	Declaration of Turhan F. Sarwar in Support of Motion for Admission Pro Hac Vice
EX-1042	Declaration of Gregory F. Corbett in Support of Motion for Admission Pro Hac Vice
EX-1043	Email from Board dated June 21, 2024 Authorizing the Filing of an Updated Stipulation and a Pre-Institution Reply

I. INTRODUCTION

Patent Owner (“Headwater”) asks the Board to deny institution of *inter partes* review (“IPR”) in this proceeding (IPR2024-00342, “-00342 Proceeding”) if it grants institution in IPR2024-00341 (“-00341 Proceeding”). Paper 8 (“POPR”), at 1. The POPR conditionally stipulates “that if institution is denied in this proceeding, Patent Owner will not challenge the public availability of the TS-23.140 specification in the -00341 proceeding.” POPR, at 3-4. However, Headwater’s stipulation does not address the Petitioners’ (and the public’s) interest in a final determination on the patentability of all thirty claims of the ’733 Patent. The Board should thus reject Headwater’s request and institute in both proceedings.

As discussed in its Ranking Notice, Petitioners needed two petitions to challenge all thirty claims of the ’733 Patent. *See* Paper 3, at 1-4. Headwater does not dispute that each petition challenges different claims. POPR, at 3. Headwater also does not dispute that the petitions present distinct grounds with material differences that are neither redundant nor duplicative. POPR, at 4-5. Headwater also does not address the technical substance of any claim or of either petition. POPR, at 1-10. Instead, Headwater’s primary argument is that two petitions were not “necessary.” *See* POPR, at 1-3. Headwater bases this argument on two propositions—(1) Petitioners did not need to challenge thirty claims, and (2) thirty claims could have been addressed in one petition. Neither proposition is true.

II. PATENT OWNER DOES NOT DISPUTE THAT ALL THIRTY CLAIMS MAY BE ASSERTED AGAINST BOTH PETITIONERS

Headwater argues “there are twenty-one currently-asserted claims, and absent leave of court and with the requisite good cause showing, this number will not increase.” POPR, at 9-10. “Petitioners,” Headwater concludes, “therefore opted to unnecessarily challenge nine non-asserted claims[.]” *Id.* This statement is misleading because it ignores Headwater’s ongoing ability to assert all claims against both Petitioners and its reservation of rights regarding the same.

A. Patent Owner Fails to Acknowledge Petitioner Google

In its POPR, Headwater fails to mention or acknowledge Petitioner Google. As Petitioners explained in their Ranking Notice, “Petitioner Google is not a party to the litigation brought by Patent Owner,” and “all 30 claims may be... asserted against Petitioner Google in potential future litigation.” Paper 3, at 3-4. Headwater has no response. POPR, at 9-10. Instead, Headwater tries to distinguish case law (*Dolby*) that supposedly allowed two parallel petitions because the claims challenged were “all asserted in litigation.” *Id.* at 7-8. Even if that were true, Headwater’s argument fails; Petitioners here **do not know** which claims would be “asserted in litigation” against Google. Headwater’s careful omission of Google in the POPR—and the failure to even acknowledge that Headwater does not need a court’s leave or good cause to bring suit and assert **all thirty** claims against Google—is thus misleading at best. Headwater also provides no rationale for barring an as-yet un-

sued Petitioner from using IPR to challenge all claims that may be asserted in the future. This further weighs against discretionary denial of the -00342 Proceeding, which would unfairly deprive Google of Petitioners' diligent challenge to claims 18, 20, and 28.

B. Patent Owner Continues to Reserve the Right to Assert All Thirty Claims Against Petitioner Samsung

Headwater claims *here* (but not in district court) that it “has no ‘right’ to” “assert any currently-unasserted claims against Petitioner Samsung.” POPR, at 8; *cf.* EX-1021, at 1-2 (“Headwater *reserves the right to amend* this disclosure [of “the Asserted Claims”] *to the full extent permitted under the court’s rules and orders.*”).¹ Notably, the POPR is careful to avoid even approaching a stipulation that Headwater will not assert additional claims in the parallel litigation against Samsung (or in a separate litigation against Google). Instead, in the POPR, each statement regarding whether Headwater will ask the district court for leave to assert new claims is cabined in language reserving the possibility that Headwater might do so. POPR, at 8 (“*At this point in time, with the information of which it is currently aware*, Patent Owner *does not have an intention* to seek leave to add new claims in the district court proceeding.”), 9 (“*[A]bsent leave of court and with the requisite good cause showing*, this number will not increase...”). Headwater *never* stipulates

¹ All emphasis added herein unless otherwise specified.

it will not assert all thirty claims against Samsung (e.g., claims 18, 20, and 28).

III. PETITIONERS DILIGENTLY CHALLENGED AS MANY CLAIMS AS POSSIBLE IN EACH PETITION

Headwater speculates that Petitioners filed two petitions to have “backup” grounds (POPR, at 1, 4-5), and that the “mere three dependent claims” addressed in the -00342 Proceeding (claims 18, 20, 28) could have fit into the petition for the -00341 Proceeding (*id.*, at 1, 6, 9). Headwater does not explain how.

The petition in the -00341 Proceeding had 13,987 words—thirteen less than the 14,000 allowed under 37 C.F.R. § 42.24. The petition’s analysis in the -00342 Proceeding that addressed claims 20 and 28 (relying on Houghton, which was not cited in the -00341 Proceeding) required about 1,050 words *in addition to* the about 2,150 words required to explain the Houghton-Ogawa combination. The analysis addressing claim 18 (further relying on Hwang, which was not cited in the -00341 Proceeding) required about 800 words. Headwater’s repeated suggestion that Petitioners should have simply challenged the “mere three dependent claims” not addressed in the -00341 Proceeding—i.e., somehow compressing over 4000 words of analysis into thirteen—simply ignores the substance of dependent claims that, while unpatentable (as Petitioners demonstrate in this proceeding), are also “lengthy or complex, necessitating several pages of explanation.” *Adobe Inc. v. Synkloud Techs., LLC*, IPR2020-01393, Paper 8 at 9-10 (PTAB Mar. 11, 2021); *see also Dolby Labs., Inc. v. Intertrust Tech. Corp.*, IPR2021-01309, Paper 11 at 20-21 (PTAB Feb.

9, 2022) (challenging “eighteen claims across two parallel petitions” was warranted where the dependent claims and specification were complex and lengthy).

Moreover, Petitioners here were particularly diligent. Headwater’s argument and case law misleadingly suggests Petitioners failed to address twenty claims in each petition. POPR, at 7; *Apple, Inc. v. Koss Corp.*, IPR2021-00686, Paper 12 at 13 (PTAB Oct. 12, 2021) (discussing second petition challenging a patent with twenty claims); *Global Tel*Link Corp. v. HLFIP Holding, Inc.*, IPR2021-00445, Paper 14 at 18 (PTAB June 22, 2021) (seventeen claims); *Apple, Inc. v. Speir Techs. Ltd.*, IPR2023-00543, Paper 8 at 10 (PTAB Aug. 8, 2023) (nineteen claims). Headwater’s case law is inapposite. *Each* petition filed against the ’733 Patent—which has 65 drawings and 163 columns—challenged over twenty-five claims. Headwater has no legal or factual basis for suggesting Petitioners needed to challenge (or could have challenged) *thirty* claims in one petition.

IV. INSTITUTING WILL NOT IMPOSE UNDUE BURDEN

If the -00342 Proceeding is assigned to the same PTAB panel handling IPR2024-00010—which is a proceeding filed by Petitioner Samsung challenging Headwater’s U.S. Patent 9,615,192—there would be very limited burden on the Board because the panel will already be familiar with Houghton, and similar issues are presented by the claims and grounds relied upon in both proceedings. Paper 3, at 5. Petitioners raised this in its Ranking Notice, and Headwater has no response.

Date: June 26, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on June 26, 2024, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response and Exhibit 1043 were provided by email, to the Patent Owner, by serving the correspondence address of record as follows:

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