

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2024-00342
Patent 8,406,733

PATENT OWNER'S PRELIMINARY SUR-REPLY

I. Petitioners no longer dispute that three of the four reasons in the Ranking Notice for why two petitions are purportedly needed are meritless.

In their Ranking Notice (Paper 3), Petitioners give four reasons for why they allegedly need two petitions to challenge the '733 Patent. The first reason—that Patent Owner may challenge the prior art status of the primary reference in Petitioners' first-ranked proceeding ("First Petition")—is moot because Patent Owner has stipulated that it will not challenge that reference's prior art status if institution is denied in this second-ranked proceeding ("Second Petition"). Ranking Notice at 1-2; POPR at 4. And Petitioners do not further pursue their purported second reason—that the two petitions allegedly "present distinct grounds ... that are neither redundant nor duplicative" (Ranking Notice at 2-3; Reply at 1)—presumably because this argument flies in the face of the CTPG and Board precedent. POPR at 4-5. And Petitioners appear to have abandoned their third reason as well (that twenty-one asserted claims is too large a number to address in a single petition (Ranking Notice at 3-4)), and again for good reason; this argument is likewise contrary to Board precedent. *See* POPR at 7.

II. Petitioners' fourth reason—the "need" to address all thirty claims of the '733 Patent—also lacks any merit, particularly in view of Patent Owner's stipulations confirming no additional claims will be asserted against them.

Petitioners thus address only their fourth and final reason for their duplicitous petitions on reply, that they allegedly needed to address all thirty claims of the '733

Patent and that doing so was not possible in one petition. Reply at 1. Patent Owner addresses both premises of this argument in turn.

On the first point, Petitioners provide two reasons for why they purportedly needed to challenge all thirty claims of the '733 Patent—Patent Owner may sue petitioner Google in the future on all thirty claims and Patent Owner may move to amend its infringement contentions in the pending litigation against petitioner Samsung to assert more than the twenty-one currently asserted claims. *Id.* at 2-4.

Petitioners present no evidence that Patent Owner intends to instigate litigation at Google at all, let alone on all thirty claims of the '733 Patent. Petitioners likewise present no evidence that Patent Owner intends to move the Eastern District of Texas court for leave to amend its infringement contentions to assert additional claims against Samsung. *See* E.D. Tex. P.R. 3-6(b) (requiring a showing of good cause and leave of court to amend infringement contentions). Indeed, as Patent Owner has explained, with the information currently available to it in that case, it “does not have an intention to seek leave to add new claims in the district court proceeding.” POPR at 8. It is unlikely that information will surface at this late stage that would cause Patent Owner to seek leave to amend, let alone information that would provide good cause to do so, particularly given that the close of fact discovery is imminent. Ex. 1022 at 4.

But in any event, Patent Owner stipulates that if institution is denied in this proceeding, it will not file suit against petitioner Google alleging infringement of the '733 Patent, and it will likewise not assert any additional claims against petitioner Samsung in the pending parallel litigation. These stipulations entirely moot Petitioners only remaining argument as to why they needed to file two petitions challenging the '733 Patent. Institution of the Petition in this proceeding should be denied.

III. Petitioners have no need to challenge all thirty claims of the '733 Patent, but even if they did, they could have done so in a single petition.

However, even assuming that Petitioners had a need to address all thirty claims of the '733 Patent before the Board—they do not, particularly given the above stipulations, it strains credulity that they could not have done so in a single petition. This Second Petition challenges claims 1-24 and 26-30 of the '733 Patent—all of the claims of the '733 Patent except dependent claim 25. Thus, the only unique claim challenged in the First Petition is dependent claim 25, and the only unique claims challenged in the Second Petition are dependent claims 18, 20, and 28.

Petitioners claim on reply that they could not have addressed claims 18, 20, and 28 in the First Petition because they needed four thousand words to do so. Reply at 4. It is of course Petitioners' responsibility to follow Board guidance and regulations on page limits and streamline their briefing accordingly. Moreover,

Petitioners’ argument ignores the efficiencies they would have experienced during drafting, particularly since, by their own admission, in the two petitions, “similar issues are presented by the claims and grounds relied upon in both proceedings.” *Id.* at 5. This is at least in part due to the fact that “Petitioners have purposefully used the same secondary reference (Ogawa) in a similar manner in both petitions.” Ranking Notice at 5.

In addition, Petitioners offer no explanation for why they could not have challenged dependent claim 25 in this Second Petition—the sole claim that this Second Petition does not address—obviating the need for the First Petition, particularly since they included less than two pages of analysis on this claim 25 in the First Petition. Ex. 2001 at 67-68.

Petitioners’ argument that “the substance of the dependent claims ... are also lengthy or complex, necessitating several pages of explanation” misses the mark. Reply at 4 (internal quotation marks removed). Petitioners do not explain why dependent claims 18, 20, and 28 are complex, nor could they, particularly in the face of spending less than seven pages in the Second Petition discussing them. Pet. at 56-60, 68-69, 77-78. Nor can they argue that claim 25 (the only claim of the ’733 Patent not addressed in the Second Petition) is overly complex, such that they needed an entirely separate petition to address it. Claim 25 simply reads: “The end-user device recited in claim 1, wherein a transmission over the service control link is within an

ambient service.” Ex. 1001 at claim 25. The lack of complexity of this claim language is further evidenced by Petitioners spending just over a single page discussing it in the First Petition. Ex. 2002 at 67-68.

Finally, it is unclear why Petitioners argue that Patent Owner’s preliminary response suggests that “Petitioners failed to address twenty claims in each petition,” let alone how this argument is relevant to whether two petitions are necessary Reply at 5. In any event, Patent Owner makes clear that both petitions challenge the same twenty-six claims as well as one additional dependent claim (First Petition) or three additional dependent claims (Second Petition). POPR at 2-3. And Patent Owner cited at least some of the case law Petitioners refer to on page 5 of their Reply in response to one of the arguments that Petitioners appear to have abandoned—that the twenty-one claims asserted against Samsung in litigation is simply too many to challenge in a single petition. *Id.* at 7.

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Because Petitioners have not and cannot demonstrate that two petitions are needed here, particularly in view of Patent Owner’s stipulations, institution of this Second Petition should be denied.

Date: July 3, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on July 3, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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