

From: [Director_PTABDecision_Review](#)
To: [Jim Milkey](#)
Cc: [Scott.McKeown@WolfGreenfield.com](#); [Gregory F. Corbett](#); [Turhan F. Sarwar](#); [rak_headwater@raklaw.com](#); [Reza Mirzaie](#); [Marc Fenster](#); [Dale Chang](#); [Amy E. Hayden](#); [Neil Rubin](#); [Philip Wang](#); [Jeremy Monaldo](#); [Karan Jhurani](#); [ghane@fr.com](#)
Subject: RE: RE IPR2024-00342 (Samsung Electronics Co., Ltd; Google LLC & Samsung Electronics America, Inc., v. Headwater Research LLC)
Date: Tuesday, September 3, 2024 1:14:00 PM

Counsel,

Consistent with Petitioner's statement in its Request for Director Review (Paper 17, 4 n.3), Petitioner shall file the intervening email correspondence referenced in the Request as an exhibit in this proceeding. Petitioner shall file this correspondence by close of business, September 6.

Thank you.

From: Jim Milkey <jmilkey@raklaw.com>
Sent: Wednesday, August 28, 2024 3:18 PM
To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Scott.McKeown@WolfGreenfield.com; Gregory F. Corbett <Gregory.Corbett@WolfGreenfield.com>; Turhan F. Sarwar <Turhan.Sarwar@WolfGreenfield.com>; rak_headwater@raklaw.com; Reza Mirzaie <rmirzaie@raklaw.com>; Marc Fenster <mfenster@raklaw.com>; Dale Chang <dchang@raklaw.com>; Amy E. Hayden <ahayden@raklaw.com>; Neil Rubin <nrubin@raklaw.com>; Philip Wang <pwang@raklaw.com>; Jeremy Monaldo <Monaldo@fr.com>; Karan Jhurani <jhurani@fr.com>; ghane@fr.com
Subject: Re: RE IPR2024-00342 (Samsung Electronics Co., Ltd; Google LLC & Samsung Electronics America, Inc., v. Headwater Research LLC)

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Director Vidal,

Petitioners in their request for Director Review selectively quoted new evidence (email correspondence with Patent Owner that occurred between the denial of institution and the filing of the Director Review request), but declined to provide the complete correspondence due to an acknowledgement that requests for Director Review may not introduce new evidence. *See* Petitioners' Request for Director Review at 4 & n.3.

In view of Petitioners' new reliance on email correspondence with Patent Owner, Patent Owner respectfully requests authorization to submit that email correspondence as exhibits in this proceeding, which Patent Owner believes will provide helpful context regarding Petitioners' characterization of that correspondence. *See* Revised Interim Director Review Process §3.E, available at <https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process> (requiring authorization by the Director before providing a response to a Director Review request).

Respectfully submitted,

James A. Milkey
Counsel for Patent Owner Headwater

On Aug 27, 2024, at 7:10 AM, Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov> wrote:

Counsel,

Your request for Director Review has been received for the above-referenced case. The Director will determine whether review will be granted or denied and you will be notified of the result of your request.

Thank you.

From: [Scott.McKeown@WolfGreenfield.com](#) <Scott.McKeown@WolfGreenfield.com>
Sent: Monday, August 26, 2024 5:34 PM

To: Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: Gregory F. Corbett <Gregory.Corbett@WolfGreenfield.com>; Turhan F. Sarwar <Turhan.Sarwar@WolfGreenfield.com>; rak_headwater@raklaw.com; rmirzaie@raklaw.com; mfenster@raklaw.com; dchang@raklaw.com; ahayden@raklaw.com; jmilkey@raklaw.com; nrubin@raklaw.com; pwang@raklaw.com; Jeremy Monaldo <Monaldo@fr.com>; Karan Jhurani <jhurani@fr.com>; ghane@fr.com
Subject: RE IPR2024-00342 (Samsung Electronics Co., Ltd; Google LLC & Samsung Electronics America, Inc., v. Headwater Research LLC)

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Director Vidal,

Petitioners provide this notification email in accordance with the Revised Interim Director Review Process, and hereby respectfully request Director Review of the denial of institution in the above captioned IPR (concurrently uploaded to P-TACTS). The denial presents an issue of first impression that impacts important issues of agency policy in applying 35 U.S.C. § 314(a).

Petitioners filed two parallel petitions to challenge all claims of the subject patent as a consequence of petition word count limitations. While one petition was instituted on the merits, the second petition, which included challenges to different claims than the first, was denied as a matter of discretion. In denying the second petition, the panel did not dispute that parallel filings were warranted to cover all claims. Instead, it discretionarily denied the second petition solely based on a PO stipulation filed three weeks prior to the institution deadline. The stipulation represented that PO would not assert the claims unique to the second filing against petitioner Samsung and would not assert the patent against petitioner Google. But the panel misapprehended this stipulation as mooted Google's and Samsung's interests where PO is actively suing Google's partners (such as Samsung) and has the ability to implicate Samsung and Google in potential future litigation involving the use and distribution of their respective products. If left to stand, this decision will (1) result in additional needless litigation against Google's and Samsung's products and partners and (2) encourage the use of narrow, inadequate PO stipulations to attempt to avoid substantive review of a patent's claims.

Accordingly, to ensure the AIA trial proceedings remain a viable alternative to litigation, rather than foster piece-meal litigation, Petitioners respectfully request Director Review to correct these significant misapprehensions of discretionary policy under 314(a).

Respectfully submitted,

Scott McKeown
Counsel for Petitioner Google

Karan Jhurani
Counsel for Petitioner Samsung

<image001.png> **Scott McKeown (Mik-Q-En)**
Shareholder Scott.McKeown@wolfgreenfield.com
202.389.6025

Wolf, Greenfield & Sacks, P.C.
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wolfgreenfield.com <image002.png> <image003.png>

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