

Hayden, Amy. "Re: Stipulation regarding U.S. Patent No. 8,406,733."
Received by Turhan Sarwar (Counsel for Google), August 16, 2024

From: [Amy Hayden](#)
To: [Sarwar, Turhan F.](#)
Cc: [Reza Mirzaie](#); [Marc Fenster](#); [Dale Chang](#); [Jim Milkey](#); [Neil Rubin](#); [Philip Wang](#); rak_headwater@raklaw.com; [Corbett, Gregory F.](#)
Subject: Re: Stipulation regarding U.S. Patent No. 8,406,733
Date: Friday, August 16, 2024 6:55:57 PM

Hi Turhan,

Thank you for the follow up. We have already formalized our agreements by including them in our preliminary response and preliminary sur-reply. We disagree with your implications that (1) that those stipulations have not been formalized even though they were filed with the Patent Trial and Appeal Board, and (2) that Google is entitled to additional stipulations beyond the stipulations Headwater expressly made to the PTAB.

Best regards,
Amy

On Aug 16, 2024, at 11:34 AM, Turhan F. Sarwar <Turhan.Sarwar@WolfGreenfield.com> wrote:

Counsel,

We hope you are well. I'm following up on below correspondence, sent Wednesday last week.

Best,
Turhan

<image001.png>

Turhan F. Sarwar

Pronouns: he/him/his

Counsel

turhan.sarwar@wolfgreenfield.com

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From: Sarwar, Turhan F.

Sent: Wednesday, August 7, 2024 11:03 AM

To: 'rmirzaie@raklaw.com' <rmirzaie@raklaw.com>; 'mfenster@raklaw.com' <mfenster@raklaw.com>; 'dchang@raklaw.com' <dchang@raklaw.com>; 'ahayden@raklaw.com' <ahayden@raklaw.com>; 'jmilkey@raklaw.com' <jmilkey@raklaw.com>; 'nrubin@raklaw.com' <nrubin@raklaw.com>; 'pwang@raklaw.com' <pwang@raklaw.com>; 'rak_headwater@raklaw.com' <rak_headwater@raklaw.com>

Cc: Corbett, Gregory F. <Gregory.Corbett@WolfGreenfield.com>

Subject: Stipulation regarding U.S. Patent No. 8,406,733

Counsel for Headwater,

We hope you are well.

We are reaching out to formalize the stipulation Headwater provided in its Preliminary Sur-Reply submitted July 3, 2024 (in PTAB Case IPR2024-00342), which the Board relied upon to discretionarily deny institution on July 26, 2024. Below is proposed language for a covenant not to sue as to the '733 Patent which comports with Headwater's statement in its Preliminary Sur-Reply that it does not

“intend[] to instigate litigation at Google at all.” Please confirm that you agree with below covenant, and we will draw up paperwork for execution.

Headwater Research LLC covenants not to sue: (i) Google LLC ("Google") for any infringement or any other violation of U.S. Patent No. 8,406,733 (the “Patent”); and (ii) any entity for any infringement or any other violation of the Patent based in whole or in part on their activities relating to any former, current or future Google product, including but not limited to services, components, hardware, software, websites, processes, machines, manufactures, and any combinations and components thereof, of Google, or that are designed, developed, used, sold, offered for sale, licensed, imported, or made, in whole or substantial part, by or on behalf of Google.

Thank you for your attention to this matter.

Best Regards,
Turhan Sarwar

<image001.png>

Turhan F. Sarwar

Pronouns: he/him/his

Counsel

turhan.sarwar@wolfgreenfield.com

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Milkey, Jim. "Re: IPR2024-00342 - Stipulation regarding U.S. Patent No. 8,406,733 (39843-0164IP2)." Received by Karan Jhurani (Counsel for Samsung), August 23, 2024

From: Jim Milkey <jmilkey@raklaw.com>
Sent: Friday, August 23, 2024 7:13 PM
To: Karan Jhurani
Cc: rmirzaie@raklaw.com; rak_headwater@raklaw.com; mfenster@raklaw.com; Dale Chang; ahayden@raklaw.com; nrubin@raklaw.com; pwang@raklaw.com; IPR39843-0164IP2
Subject: Re: IPR2024-00342 - Stipulation regarding U.S. Patent No. 8,406,733 (39843-0164IP2)

[This email originated outside of F&R.]

Karan,

Patent Owner's stipulation is the scope that we represented it was before the Patent Trial and Appeal Board in the preliminary sur-reply and accurately quoted below in your email from yesterday. We have already expressly made that stipulation through a formal filing with the PTAB (in accordance with, e.g., pages 60-61 of the Consolidated Trial Practice Guide), and reiterate that stipulation to you in this email.

Separately, it is incorrect that "Patent Owner has refused to formalize its stipulation as it relates to co-Petitioner Google." As we previously indicated to Google, Patent Owner has formalized its stipulations (regarding both Google and Samsung) by filing them with the PTAB; they are now a matter of public record.

If you are aware of any authority that the stipulations we have filed with the PTAB are insufficient for any reason, please let us know so that we may consider it. Notably, however, the stipulation we included in our preliminary sur-reply was directly responsive to the precise arguments Samsung made in its preliminary reply. See Paper No. 11 (Petitioners' Reply to Patent Owner's Preliminary Response) at 3-4 (arguing that institution should be granted because "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)"). If Samsung really believed something more were necessary, it is not clear why Samsung would raise the issue only now, nearly two months after Samsung filed its reply brief and nearly a month after the Board denied institution.

Best regards,
Jim

James A. Milkey
Russ, August & Kabat
12424 Wilshire Boulevard, 12th Floor
Los Angeles, CA 90025
(310) 826-7474
jmilkey@raklaw.com

On Aug 23, 2024, at 1:51 PM, Karan Jhurani <jhurani@fr.com> wrote:

Counsel –

I am writing to follow up on the below email. [Please advise today.](#)

Thanks,
Karan

Karan Jhurani

Principal ■ Fish & Richardson P.C.

T: 404 724 2807

jhurani@fr.com | [Bio](#) | [LinkedIn](#) | [fr.com](#)

1180 Peachtree Street NE, 21st Floor, Atlanta, GA 30309

From: Karan Jhurani <jhurani@fr.com>

Sent: Thursday, August 22, 2024 4:29 PM

To: rmirzaie@raklaw.com; rak_headwater@raklaw.com; mfenster@raklaw.com; dchang@raklaw.com; ahayden@raklaw.com; jmilkey@raklaw.com; nrubin@raklaw.com; pwang@raklaw.com

Cc: IPR39843-0164IP2 <IPR39843-0164IP2@fr.com>

Subject: IPR2024-00342 - Stipulation regarding U.S. Patent No. 8,406,733 (39843-0164IP2)

Counsel,

I am writing on behalf of Petitioner Samsung in the above-referenced proceeding relating to US Patent No. 8,406,733 (the '733 Patent). In its preliminary sur-reply, Patent Owner stipulated that it will "not assert any additional claims against petitioner Samsung in the pending parallel litigation."

We understand Patent Owner's stipulation with respect to such claims to apply to Samsung and its Affiliates with the scope previously agreed to between the parties in settled IPR2023-01336, IPR2023-01337, IPR2023-01157, IPR2023-01226, and IPR2023-01250. *See Confidential EX-2020* (submitted in each of the aforementioned proceedings). ***Please confirm that is the case by close of business (COB) on Friday, August 23, 2024.*** Petitioner has concerns because we learned yesterday that Patent Owner has refused to formalize its stipulation as it relates to co-Petitioner Google.

Best,
Karan

Karan Jhurani

Principal ■ Fish & Richardson P.C.

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Milkey, Jim. "Re: Stipulation regarding U.S. Patent No. 8,406,733."
Received by Turhan Sarwar and Gregory Corbett (Counsel for Google),
August 23, 2024

From: [Jim Milkey](#)
To: [Sarwar, Turhan F.](#); [Corbett, Gregory F.](#)
Cc: [Amy E. Hayden](#); [Reza Mirzaie](#); [Marc Fenster](#); [Dale Chang](#); [Neil Rubin](#); [Philip Wang](#); rak_headwater@raklaw.com
Subject: Re: Stipulation regarding U.S. Patent No. 8,406,733
Date: Friday, August 23, 2024 7:24:12 PM

Counsel for Petitioner Google,

Petitioner Samsung recently informed Patent Owner that on Wednesday, August 21, Samsung “learned” (presumably from Google) “that Patent Owner has refused to formalize its stipulation as it relates to co-Petitioner Google.” As noted by Dr. Hayden’s email below (and as I informed Samsung in a separate email communication earlier today), that’s not accurate; we have already formalized our stipulation by filing it with the PTAB as encouraged by pages 60-61 of the Consolidated Trial Practice Guide.

If you are aware of any authority that the stipulations we have filed with the PTAB are insufficient for any reason, please let us know so that we may consider that authority. Notably, however, the stipulation we included in our preliminary sur-reply was directly responsive to the precise arguments Petitioners made in their preliminary reply. *See* Paper No. 11 (Petitioners’ Reply to Patent Owner’s Preliminary Response) at 2-3 (arguing institution should be granted because “all claims... may be asserted in the future” against Google); *id.* 3-4 (arguing that institution should be granted because “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)”).

Best regards,
Jim

James A. Milkey
Russ, August & Kabat
12424 Wilshire Boulevard, 12th Floor
Los Angeles, CA 90025
(310) 826-7474
jmilkey@raklaw.com

On Aug 16, 2024, at 3:55 PM, Amy Hayden <ahayden@raklaw.com> wrote:

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Best regards,
Amy

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Best,
Turhan

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Turhan F. Sarwar

Pronouns: he/him/his

Counsel

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Cc: Corbett, Gregory F. <Gregory.Corbett@WolfGreenfield.com>

Subject: Stipulation regarding U.S. Patent No. 8,406,733

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Headwater Research LLC covenants not to sue: (i) Google LLC ("Google") for any infringement or any other violation of U.S. Patent No. 8,406,733 (the "Patent"); and (ii) any entity for any infringement or any other violation of the Patent based in whole or in part on their activities relating to any former, current or future Google product, including but not limited to services, components, hardware, software, websites, processes, machines, manufactures, and any combinations and components thereof, of Google, or that are designed, developed, used, sold, offered for sale, licensed, imported, or made, in whole or substantial part, by or on behalf of Google.

Thank you for your attention to this matter.

Best Regards,

Turhan Sarwar

<image001.png>

Turhan F. Sarwar

Pronouns: he/him/his

Counsel

turhan.sarwar@wolfgreenfield.com

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