

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

HEADWATER RESEARCH LLC,

Plaintiff,

vs.

**AT&T INC., AT&T SERVICES, INC., AT&T
MOBILITY, LLC AND AT&T CORP.,**

Defendants.

Civil Action No. 2:23-cv-00397

LEAD CASE

JURY TRIAL

HEADWATER RESEARCH LLC,

Plaintiff,

vs.

**AT&T INC., AT&T SERVICES, INC., AT&T
MOBILITY, LLC AND AT&T CORP.,**

Defendants.

Civil Action No. 2:23-cv-00398

JURY TRIAL

DEFENDANTS' PRELIMINARY INVALIDITY CONTENTIONS

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Pursuant to P.R. 3-3, P.R. 3-4, and the Court’s Docket Control Order (Dkt. 41) in the above-captioned case, Defendants AT&T Services, Inc., AT&T Mobility, LLC., and AT&T Corp. (collectively, “AT&T” or “Defendants”) hereby serve their P.R. 3-3 Invalidity Contentions (“Invalidity Contentions”) with respect to the claims identified by Plaintiff Headwater Research, LLC (“Plaintiff” or “Headwater”) in its Disclosure of Asserted Claims and Infringement Contentions for AT&T (Nov. 20, 2023) (“Infringement Contentions”).

I. PRELIMINARY STATEMENT AND RESERVATION OF RIGHTS

A. The Asserted Claims

According to the Infringement Contentions, Plaintiff asserts the following patents and claims.

Asserted Patent	Asserted Claims
8,589,541 (“The ’541 Patent”)	Claims 1-174
8,924,543 (“The ’543 Patent”)	Claims 1-13, 15-16, 21-23, 28, 30-33, 35-47, 57-66, 68-72, 80, 85-93, 96, 98-99, 112-113, 120-121
9,198,042 (“The ’042 Patent”)	Claims 1-9, 12-14, 16-18
9,215,613 (“The ’613 Patent”)	Claims 1-24

The patents identified in the foregoing table are collectively referred to as the “Asserted Patents,” and the claims identified in the foregoing table are collectively referred to as the “Asserted Claims.”

Defendants contend that each of the Asserted Claims is invalid under at least one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112. Pursuant to the Local Patent Rules, Defendants do not provide any contentions regarding claims not asserted by Headwater. To the extent that the Court permits Headwater to assert additional claims against Defendants in the future, Defendants reserve all rights to amend or supplement these Invalidity Contentions or otherwise disclose new or supplemental invalidity contentions regarding such claims. Furthermore, because discovery is

ongoing,¹ Defendants reserve the right to revise, amend, and/or supplement the information provided herein, including identifying, charting, and relying on additional references, should discovery yield additional information or references.

Defendants further reserve the right to amend these contentions in response to any claim construction rulings, as permitted by the Local Patent Rules or with permission of the Court.

The Infringement Contentions are deficient in multiple respects and do not provide Defendants with sufficient information to understand the specific accused features and components and the alleged factual and evidentiary bases for Headwater's infringement allegations. Among other things, the Infringement Contentions lack the specificity required by P.R. 3-1, fail to properly identify accused instrumentalities, and fail to explain adequately Headwater's infringement theories for numerous limitations. Headwater has prejudiced Defendants' ability to understand, for purposes of preparing these Invalidity Contentions, what Headwater alleges to be the scope of the Asserted Claims. If Headwater modifies any assertion or contention in its Infringement Contentions or presents any new assertion or contention relevant to these Invalidity Contentions to the extent allowed by the Local Patent Rules or the Court, Defendants reserve the right to

¹ Defendants' ongoing efforts include but are not limited to: seeking additional information related to the references and systems disclosed in these Preliminary Invalidity Contentions, seeking additional information related to available prior art systems, seeking additional information related to Plaintiff's Infringement Contentions and the products accused of infringing therein, and seeking additional information related to the instrumentalities Plaintiff's Infringement Contentions allege may practice the claimed inventions, including those products and services developed by ItsOn Inc., and any materials and source code related to the same. No depositions have been taken as of this time, including, without limitation, depositions of any inventors, authors, or entities listed on any references or systems identified in these Preliminary Invalidity Contentions. Defendants thus reserve the right to review and supplement these Preliminary Invalidity Contentions with respect to any additional prior art that becomes apparent as discovery proceeds, including those ItsOn publications, products, and services that predate the priority dates of the Asserted Claims.

supplement or otherwise amend these initial Invalidity Contentions to the extent allowed by the Local Patent Rules or the Court.

Nothing herein shall be interpreted as an admission by AT&T that: (1) the Asserted Claims are infringed by any of AT&T's products or services; (2) any particular feature or aspect of any of the accused instrumentalities practices any limitation of the Asserted Claims, (3) there is 35 U.S.C. § 112 support for any limitation of the Asserted Claims, or (4) any of Headwater's proposed or implied constructions are supportable.

B. Priority Date Of The Asserted Patents

Plaintiff asserts the same priority date for each Asserted Patent: January 28, 2009. Throughout these Invalidity Contentions, reference to an "asserted priority date" should not be construed as an admission that AT&T agrees that any of the Asserted Claims are in fact entitled to such priority date, or that Plaintiff has provided proper notice as to its contentions for a priority date.

P.R. 3-2(b) requires Plaintiff to produce, contemporaneously with its Infringement Contentions, "[a]ll documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to P.R. 3-1(e), whichever is earlier." Plaintiff's purported production pursuant to P.R. 3-2(b) includes only the four Asserted Patents and their file histories. AT&T thus understands that Plaintiff is not asserting an invention date, or conception, reduction to practice, design, and/or development of the claimed invention, prior to January 28, 2009, AT&T reserves the right to supplement these Invalidity Contentions to address any such contention, including by identifying and/or charting additional prior art that may thereby become relevant. Likewise, to the extent Plaintiff successfully establishes an invention date before any of the prior-art

references herein included by AT&T, then those references serve as evidence of secondary considerations of obviousness, particularly contemporaneous invention by others.

To the extent Plaintiff alleges that any prior art relied on in these Invalidity Contentions does not actually qualify as prior art to the Asserted Patent, AT&T reserves the right to rebut those allegations. AT&T also reserves the right to rely on additional documents, information, and evidence to demonstrate public availability or public availability by a certain date of a prior art reference or to rebut any efforts by Plaintiff to allege any reference was not publicly available by a certain date or otherwise available as prior art.

C. Claim Construction

Because the Court has not yet construed any terms of the Asserted Claims, Defendants' Invalidity Contentions are based on (1) Defendants' present understanding of the Asserted Claims and (2) the claim constructions Headwater appears to be proposing based on the Infringement Contentions, all without regard to whether Defendants agree with Headwater's apparent or expressed claim constructions. Defendants reserve the right to supplement or otherwise amend these Invalidity Contentions in response to any proposed claim constructions or alleged supporting evidence offered by Headwater, any report from any expert witness for Headwater regarding claim construction issues, and claim construction briefing filed by Headwater, and any position taken by Headwater concerning claim construction, infringement, or invalidity.

Defendants take no position on any matter of claim construction in these Invalidity Contentions. If Defendants' apparent claim constructions herein are consistent with any explicit, apparent, or implied claim constructions in the Infringement Contentions, no inference is intended and no inference should be drawn that Defendants agree with any of Headwater's claim constructions. Any statement herein describing or tending to describe any claim element is provided solely for the purpose of understanding and/or applying the cited prior art. Defendants

expressly reserve the right (1) to propose any claim construction Defendants consider appropriate, (2) to contest any claim construction proposed by Headwater that Defendants consider inappropriate or inaccurate, and/or (3) to take positions with respect to claim construction issues that are inconsistent with, or even contradictory to, claim construction positions expressed or implied in these Invalidity Contentions.

Prior art not included in these Invalidity Contentions, whether now known to Defendants, might become relevant depending on the claim constructions proposed by Defendants and/or the Court's claim construction rulings. Defendants reserve all rights to supplement or modify the positions and information in these Invalidity Contentions, including without limitation the prior art and grounds of invalidity set forth herein, pursuant to P.R. 3-6 after the Court has construed the Asserted Claims.

D. Ongoing Discovery and Supplementation

Defendants' investigation, including their investigation of prior art and grounds for invalidity, is ongoing. Furthermore, Defendants' invalidity positions will be the subject of expert testimony. Defendants base these Invalidity Contentions on their current knowledge and understanding of the Asserted Claims, Headwater's Infringement Contentions, the prior art, systems, and other facts and information available as of the date of these contentions.

Defendants further reserve the right to rely on statements or admissions from those owing a duty of candor, such as the named inventor, prosecution counsel, and others involved in the prosecution of the patent applications or related applications, concerning the scope of the prior art relevant to the Asserted Patents found in, *inter alia*, the following: the respective prosecution histories of the Asserted Patents and related patent applications; deposition testimony of the named inventors; and the papers filed and any evidence submitted by Headwater in connection with this litigation.

Defendants reserve the right to supplement these Invalidity Contentions, including, without limitation, by adding additional prior art and grounds of invalidity in accordance with the Federal Rules of Civil Procedure, the Local Rules, the Local Patent Rules, and the Docket Control Order, any Order issued by this Court, or otherwise. Prior art not identified in this disclosure, whether known or not known to Defendants, may become relevant, including prior art concerning the state of the art at the time of invention, as well as simultaneous or near-simultaneous independent invention by others. For instance, Defendants are currently unaware of the extent, if any, to which Headwater will contend that limitations of the Asserted Claims are not disclosed in the prior art identified by Defendants. To the extent that such an issue arises, Defendants reserve the right to identify other references that would disclose, practice, or render obvious the allegedly missing limitation(s) of the disclosed subject matter.

These Invalidity Contentions address the claims identified in Headwater's Infringement Contentions. AT&T reserves the right to modify, amend, or supplement these Invalidity Contentions to the extent the Court permits Headwater to amend, supplement, or otherwise modify its Infringement Contentions, including by modifying the claims asserted, and to the full extent permitted by the Local Patent Rules.

E. Prior Art Identification and Citations Thereto

In these Invalidity Contentions, Defendants identify specific portions of prior art references that disclose the elements of the Asserted Claims. While Defendants have identified exemplary prior art reference disclosures for each element, they do not necessarily identify every disclosure of the same element in each prior art reference. A person of ordinary skill in the art would read a prior art reference as a whole and in the context of other publications, literature, and general knowledge in the field and would rely upon other information including other publications and general scientific or engineering knowledge. Defendants therefore reserve the right to rely upon

other unidentified portions of the prior art references and on other publications and prior art products and expert testimony to provide context and to aid understanding and interpretation of the identified portions of the prior art.

Defendants also reserve the right to rely upon (1) other portions of the cited prior art references, other publications, prior art products, and the testimony of experts to establish that the alleged inventions would have been obvious to a person of ordinary skill in the art, including on the basis of modifying or combining certain cited references; (2) all versions of a cited prior art publication (e.g., citations to 3GPP technical specifications and/or reports include all versions of such technical specifications and/or reports that qualify as prior art, citations to an issued patent include the published patent application, etc.); (3) admissions relating to prior art in the Asserted Patents or related patents, the prosecution history of the Asserted Patents or related patents, or other admissions obtained during discovery; and (4) foreign counterparts of any U.S. patents identified in Defendants' Invalidity Contentions.

The references discussed in the claim charts may disclose the elements of the Asserted Claims explicitly and/or inherently, and/or they may be relied upon to show the state of the art in the relevant time frame. The suggested obviousness combinations are provided in the alternative to Defendants' anticipation contentions and are not to be construed to suggest that any reference included in the combinations is not by itself anticipatory.

Where Defendants identify a particular figure in a prior art reference, the identification should be understood to encompass the caption and description of the figure as well as any text relating to the figure in the remainder of the prior art reference (e.g., for patent references, text in the specification and prosecution history). Similarly, where an identified portion of text refers to a

figure or other material, the identification of the text should be understood to include the referenced figure or other material.

All related prior art references that are themselves subparts or related documents of a broader set of documents, such as all references that form part of a single Release of an industry standard, should be considered a single prior art reference, as that is how a person of ordinary skill in the art would consider such related references.

F. Invalidity, Unenforceability, and/or Ineligibility Based On Non-Required Disclosure(s)

Defendants reserve the right to prove the invalidity, unenforceability, and/or ineligibility of one or more of the Asserted Claims on bases other than those required to be disclosed in these disclosures pursuant to P.R. 3-3.

G. No Patentable Weight

Nothing herein should be read to suggest that Defendants agree that any particular claim term is sufficiently definite, enabled or supported by the written description to meet the requirements of 35 U.S.C. § 112. Defendants reserve the right to argue that various portions of the Asserted Claims, such as an intended use or result, non-functional descriptive material, and certain preamble language, are entitled to no patentable weight. Mapping of a portion of an Asserted Claim to a prior art reference does not represent that such portion of the claim is entitled to patentable weight when comparing the claimed subject matter to the prior art.

II. INVALIDITY CONTENTIONS

As explained herein and in Exhibits A-D and Appendices A-A – D-D, Defendants contend that each of the Asserted Patents is invalid under 35 U.S.C. §§ 102, 103, and/or 112.

The obviousness combinations of references provided in AT&T's invalidity claim charts under 35 U.S.C. § 103 are not intended to be exhaustive. AT&T reserves the right to supplement

its obviousness combinations in the event that Headwater contends that limitations of the Asserted Claims are not disclosed in the art identified by AT&T as anticipatory. To the extent an issue arises from any such limitation, AT&T will identify other obviousness combinations or references that would have made obvious the addition of the allegedly missing limitation.

AT&T further reserves the right to present additional items of prior art located during discovery and other investigation. AT&T expects to issue subpoenas to third parties believed to have knowledge, documentation, and/or corroborating evidence concerning some of the prior art listed below and/or additional prior art. These third parties include without limitation the authors, inventors, or assignees of the references listed in the discloses below. Additionally, AT&T reserves the right to assert invalidity under other subsections of 35 U.S.C. § 102 in the event that discovery or other investigation yields information forming the basis for such invalidity.

A. State of the Art

The subject matter of the Asserted Claims was understood to those of skill in the art by the alleged priority dates of the Asserted Patents. In order to describe the state of the art at the alleged priority date, Defendants rely on at least the references listed below, as well as the references listed on the face of the Asserted Patents and all other references contained herein.

US Patent or Patent Publication	Publication/Issue Date
U.S. Patent No. 7,260,635	Aug. 21, 2007
U.S Patent Application Pub. No. 2002/0166117	Nov. 7, 2002
U.S Patent Application Pub. No. 2006/0039354	Feb. 23, 2006
U.S Patent Application Pub. No. 2006/0059556	Mar. 16, 2006
U.S Patent Application Pub. No. 2010/0017506	Jan. 21, 2010
U.S Patent Application Pub. No. 2011/0019557	Jan. 27, 2011

U.S. Patent No. 7,069,330	Jun. 27, 2006
U.S. Patent No. 8,397,087	Mar. 12, 2013
U.S. Patent No. 8,667,513	Mar. 4, 2014
U.S Patent Application Pub. No. 2005/0026654	Feb. 3, 2005
U.S. Patent No. 5,987,611	Nov. 16, 1999
U.S Patent Application Pub. No. 2012/0102504	Apr. 26, 2012
U.S. Patent No. 9,098,333	Aug. 4, 2015
U.S Patent Application Pub. No. 2012/0265897	Oct. 18, 2012
U.S Patent Application Pub. No. 2009/0190471	Jul. 30, 2009
U.S. Patent No. 8,320,272	Nov. 27, 2012
U.S. Patent No. 8,437,748	May 7, 2013
U.S Patent Application Pub. No. 2008/0085717	Apr. 10, 2008
U.S Patent Application Pub. No. 2010/0112955	May 6, 2010
European Patent Application EP 1 484 871	Dec. 8 2004
U.S. Patent No. 9,398,103	Jul. 19, 2016
U.S. Patent Application Pub. No. 2002/0133598	Sep. 19, 2002
U.S. Patent Application Pub. No. 2008/0282080	Nov. 13, 2008
International Publication No. WO 2008/043278	Apr. 17, 2008
U.S. Patent No. 9,008,673	Apr. 14, 2015
U.S. Patent Application Pub. No. 2009/0028127	Jan. 29, 2009
U.S. Patent No. 6,898,654	May 24, 2005
U.S. Patent Application Pub. No. 2006/0053113	Mar. 9, 2006

International Publication No. WO 2005/015379	Feb. 2, 2008
U.S. Patent No. 8,099,078	Jan. 17, 2012
U.S. Patent Application Pub. No. 2006/0229090	Oct. 12, 2006
Australian Application Pub. No. 2003255114	Aug. 13, 2003
U.S. Patent Application Pub. No. 2007/0038763	Feb. 15, 2007
U.S. Patent Application Pub. No. 2009/0207817	Aug. 20, 2009
U.S. Patent No. 6,578,077	Jun. 10, 2003
U.S. Patent Application Pub. No. 2008/0080457	Apr. 3, 2008
U.S. Patent Application Pub. No. 2008/0084977	Apr. 10, 2008
U.S. Patent Application Pub. No. 2005/0108075	May 19, 2005
U.S. Patent No. 7,290,034	Oct. 30, 2007
U.S. Patent No. 8,028,060	Sep. 27, 2011
U.S. Patent No. 8,260,253	Sep. 4, 2012
U.S. Patent No. 9,516,129	Dec. 6, 2016
U.S. Patent Application Pub. No. 2007/0162582	Jul. 12, 2007
U.S. Patent Application Pub. No. 2008/0080458	Apr. 3, 2008
U.S. Patent Application Pub. No. 2009/0217065	Aug. 27, 2009
U.S. Patent Application Pub. No. 2009/0307696	Dec. 10, 2009
U.S. Patent Application Pub. No. 2010/0077035	Mar. 25, 2010
U.S. Patent Application Pub. No. 2010/0115048	May 6, 2010
U.S. Patent Application Pub. No. 2011/0185202	Jul. 28, 2011
U.S. Patent Application Pub. No. 2012/0023236	Jan. 26, 2012

U.S. Patent Application Pub. No. 2012/0185577	Jul. 19, 2012
U.S. Patent Application Pub. No. 2012/0260118	Oct. 11, 2012
U.S. Patent Application Pub. No. 2012/0284620	Nov. 8, 2012
U.S. Patent Application Pub. No. 2011/0249668	Oct. 13, 2011
U.S. Patent Application Pub. No. 2011/0312283	Dec. 22, 2011
U.S. Patent Application Pub. No. 2012/0157038	Jun. 21, 2012
U.S. Patent No. 7,821,985	Oct. 26, 2010
U.S. Patent Application Pub. No. 2009/0119773	May 7, 2009
U.S. Patent No. 7,751,330	Jul. 6, 2010
U.S. Patent Application Pub. No. 2011/0019574	Jan. 27, 2011
U.S. Patent No. 8,135,443	Mar. 13, 2012
U.S. Patent Application Pub. No. 2011/0314151	Dec. 22, 2011
U.S. Patent No. 8,626,115	Jan. 7, 2014
U.S. Patent No. 8,589,541	Nov. 19, 2013
U.S. Patent No. 8,429,409	Apr. 23, 2013
U.S. Patent No. 6,185,576	Feb. 6, 2001
U.S. Patent No. 8,666,364	Mar. 4, 2014
U.S. Patent No. 8,634,821	Jan. 21, 2014
U.S. Patent Application Pub. No. 2013/0117382	May 9, 2013
U.S. Patent Application Pub. No. 2013/0103376	Apr. 25, 2013
U.S. Patent Application Pub. No. 2013/0149994	Jun. 13, 2013
U.S. Patent Application Pub. No. 2013/0111572	May 2, 2013
U.S. Patent Application Pub. No. 2012/0101952	Apr. 26, 2012

U.S. Patent Application Pub. No. 2013/0183937	Jul. 18, 2013
U.S. Patent Application Pub. No. 2015/0207760	Jul. 23, 2015
International Publication No. WO 2012/047275	Apr. 12, 2012
European Patent No. 0,745,961	Nov. 21, 2001
European Patent No. 1,102,157	Jan. 9, 2008
European Patent No. 1,585,004	Mar. 4, 2015
European Patent Application Pub. No. 1,978,772	Oct. 8, 2008
European Patent Application Pub. No. 2,056,629	May 6, 2009
UK Patent Pub. No. 2,366,966	Mar. 20, 2002
UK Patent Pub. No. 2,367,171	Jun. 13, 2021
UK Patent Pub. No. 2,372,368	Aug. 21, 2002
UK Patent Pub. No. 2,398,159	Aug. 11, 2004
U.S. Patent No. 5,668,876	Sep. 16, 1997
U.S. Patent No. 5,870,723	Feb. 9, 1999
U.S. Patent No. 5,878,337	Mar. 2, 1999
U.S. Patent No. 6,119,096	Sep. 12, 2000
U.S. Patent No. 6,731,731	May 4, 2004
U.S. Patent No. 6,758,394	Jul. 6, 2004
U.S. Patent No. 6,823,359	Nov. 23, 2004
U.S. Patent No. 6,934,858	Aug. 23, 2005
U.S. Patent No. 6,983,381	Jan. 3, 2006
U.S. Patent No. 7,139,917	Nov. 21, 2006

U.S. Patent No. 7,373,515	May 13, 2008
U.S. Patent No. 7,447,784	Nov. 4, 2008
U.S. Patent No. 7,463,637	Dec. 9, 2008
U.S. Patent No. 7,669,760	Mar. 2, 2010
U.S. Patent No. 7,982,595	Jul. 19, 2011
U.S. Patent No. 8,065,935	Nov. 22, 2011
U.S. Patent No. 8,161,527	Apr. 17, 2012
U.S. Patent No. 8,200,980	Jun. 12, 2012
U.S. Patent No. 8,332,627	Dec. 11, 2012
U.S. Patent No. 8,402,526	Mar. 19, 2013
U.S. Patent No. 8,444,052	May 21, 2013
U.S. Patent No. 8,495,720	Jul. 23, 2013
U.S. Patent No. 8,499,339	Jul. 30, 2013
U.S. Patent No. 8,725,652	May 13, 2014
U.S. Patent No. 8,732,839	May 20, 2014
U.S. Patent Application Pub. No. 2001/0034720	Oct. 25, 2001
U.S. Patent Application Pub. No. 2003/0126472	Jul. 3, 2003
U.S. Patent Application Pub. No. 2004/0078325	Apr. 22, 2004
U.S. Patent Application Pub. No. 2005/0218215	Oct. 6, 2005
U.S. Patent Application Pub. No. 2005/0221268	Oct. 6, 2005
U.S. Patent Application Pub. No. 2005/0268107	Dec. 1, 2005
U.S. Patent Application Pub. No. 2006/0130139	Jun. 15, 2006
U.S. Patent Application Pub. No. 2006/0237531	Oct. 26, 2006

U.S. Patent Application Pub. No. 2006/0237531	Oct. 26, 2006
U.S. Patent Application Pub. No. 2007/0136573	Jun. 15, 2007
U.S. Patent Application Pub. No. 2007/0136573	Jun. 15, 2007
U.S. Patent Application Pub. No. 2007/0199060	Aug. 23, 2007
U.S. Patent Application Pub. No. 2007/0228148	Oct. 4, 2007
U.S. Patent Application Pub. No. 2008/0035725	Feb. 15, 2008
U.S. Patent Application Pub. No. 2008/0120411	May 22, 2008
U.S. Patent Application Pub. No. 2009/0172402	Jul. 2, 2009
U.S. Patent Application Pub. No. 2009/0187986	Jul. 23, 2009
U.S. Patent Application Pub. No. 2009/0307141	Dec. 10, 2009
U.S. Patent Application Pub. No. 2010/0042954	Feb. 18, 2010
U.S. Patent Application Pub. No. 2010/0049615	Feb. 25, 2010
U.S. Patent Application Pub. No. 2010/0114740	May 6, 2010
U.S. Patent Application Pub. No. 2010/0115578	May 6, 2010
U.S. Patent Application Pub. No. 2010/0115578	May 6, 2010
U.S. Patent Application Pub. No. 2010/0121767	May 13, 2010
U.S. Patent Application Pub. No. 2010/0125737	May 20, 2010
U.S. Patent Application Pub. No. 2010/0180001	Jul. 15, 2010
U.S. Patent Application Pub. No. 2010/0216425	Aug. 26, 2010
U.S. Patent Application Pub. No. 2011/0137804	Jun. 9, 2011
U.S. Patent Application Pub. No. 2011/0138469	Jun. 9, 2011
U.S. Patent Application Pub. No. 2011/0197267	Aug. 11, 2011
U.S. Patent Application Pub. No. 2011/0202466	Aug. 18, 2011

U.S. Patent Application Pub. No. 2011/0219449	Sep. 8, 2011
U.S. Patent Application Pub. No. 2012/0191607	Jul. 26, 2012
U.S. Patent Application Pub. No. 2012/0198050	Aug. 2, 2012
U.S. Patent Application Pub. No. 2012/0216239	Aug. 23, 2012
U.S. Patent Application Pub. No. 2013/0042002	Feb. 14, 2013
U.S. Patent Application Pub. No. 2013/0110676	May 2, 2013
U.S. Patent Application Pub. No. 2013/0125226	May 16, 2013
U.S. Patent Application Pub. No. 2013/0174246	Jul. 4, 2013
U.S. Patent Application Pub. No. 2014/0047546	Feb. 13, 2014
U.S. Patent Application Pub. No. 2011/0302310	December 8, 2011
U.S. Patent Application Pub. No. 2011/0067085	Mar. 17, 2011
U.S. Patent Application Pub. No. 2007/0028120	Feb. 1, 2007
U.S. Patent Application Pub. No. 2001/0053688	Dec. 20, 2001
U.S. Patent Application Pub. No. 2008/0109868	May 8, 2008
U.S. Patent Application Pub. No. 2002/0147766	Oct. 10, 2002
U.S. Patent Application Pub. No. 2002/0160811	Oct. 31, 2002
International Publication No. WO 1998/025371	Jun. 11, 1998
International Publication No. WO 1999/014711	Mar. 25, 1999
International Publication No. WO 2000/033497	Jun. 8, 2000
International Publication No. WO 2001/017310	Mar. 8, 2001

International Publication No. WO 2001/026061	Apr. 12, 2001
International Publication No. WO 2002/077745	Oct. 3, 2002
International Publication No. WO 2002/082387	Oct. 17, 2002
International Publication No. WO 2005/091788	Oct. 6, 2005
International Publication No. WO 2005/116907	Dec. 8, 2005
International Publication No. WO 2007/072001	Jun. 28, 2007
International Publication No. WO 2008/052592	May 8, 2008
International Publication No. WO 2008/043722	Apr. 22, 2010
International Publication No. WO 2012/010585	Jan. 26, 2012
International Publication No. WO 2012/025826	Mar. 1, 2012
International Publication No. WO 2009/065252	May 28, 2009
S2-087289, 3GPP TSG-SA2 Meeting #68, 23.203 Change Request	Oct. 13-17, 2008
S2-085089, 3GPP TSG-SA WG2 Meeting #66, 23.237 Change Request	Jun. 23-27, 2008
RFC 4083, 3rd-Generation Partnership Project (3GPP) Release 5 requirements on the Session Initiation Protocol (SIP)	Oct. 11, 2002
Nobile et al., <i>Agile Application-Aware Adaptation for Mobility</i> , Proceedings of the Sixteenth ACM Symposium on Operating Systems Principles, 276–287 (Oct. 1997)	Oct. 1997

Higgins et al., <i>Intentional Networking: Opportunistic Exploitation of Mobile Network Diversity</i> , Proceedings of the Sixteenth Annual International Conference on Mobile Computing and Networking, 73–84 (Sep. 20-24, 2010)	Sep. 20-24, 2010
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B. P.R. 3-3(a)-(b) – Identification Of Prior Art & Anticipation and Obviousness

Pursuant to P.R. 3-3(a), and subject to Defendants’ reservation of rights as stated herein, Defendants identify the prior art that anticipates or renders obvious the Asserted Claims in the tables set forth below. On information and belief, each listed reference qualifies as prior art to the Asserted Patents because each listed document or item became prior art at least as early as the dates specified in the corresponding exhibit.

Pursuant to P.R. 3-3(b), and subject to Defendants’ reservation of rights, Defendants attach claim charts hereto that are directed to the prior art references that anticipate each of the Asserted Claims under 35 U.S.C. §§ 102(a), (b), (e), and/or (g), either expressly or inherently, and/or the prior art references that, in the alternative, would have rendered the Asserted Claims obvious under 35 U.S.C. § 103. *See* Exhibits A-D and Appendices A-A – D-D. The combinations contained in Defendants’ claim charts are exemplary. Any prior art reference cited herein may be combined with any other reference to demonstrate the invalidity of any of the Asserted Claims, as set forth below and in Exhibits A-D and Appendices A-A – D-D hereto.

To the extent that any of the following are prior art, Defendants reserve the right to rely upon foreign counterparts of the U.S. patents identified herein; U.S. counterparts of foreign patents and foreign patent applications identified herein; and U.S. and foreign patents and patent applications corresponding to articles and publications identified herein. Defendants also reserve the right to rely upon parent or provisional patents or ancestor patents or patent applications from which any of the patents or patent applications identified herein claim priority to as continuation,

divisional, or continuation-in-part applications.² Identifications of dates of publication are made based on currently available information and Defendants reserve the right to rely upon an earlier date should such evidence supporting an earlier date be discovered.

To the extent any limitation of any of the Asserted Claims is construed to have a similar meaning, or to encompass similar feature(s) and/or function(s), with any other claim limitation, and to the extent at least one claim chart in Exhibits A-D and Appendices A-A – D-D hereto identifies any prior art reference as disclosing or teaching such similarly construed claim limitation, such identified prior art reference and Defendants’ contentions with respect to same are incorporated by reference. Priority dates identified for the prior art references are based on information currently available to Defendants, and Defendants will amend this disclosure to the extent additional information becomes available.

The primary references identified below, and as further described in Exhibits A-D hereto, each disclose, either expressly or inherently, every element of the Asserted Claims, thereby anticipating those claims. To the extent Headwater contends that any primary reference does not anticipate the Asserted Claims, it would have been obvious to combine or modify the primary references with concepts from other prior art, as explained herein and in Appendices A-A – D-D hereto.

In particular, for each limitation of the Asserted Claims that Headwater contends is not met by a particular primary reference, Defendants’ contend that the limitation (and claim as a whole) is obvious based on a combination of that particular primary reference with (1) any other primary

² For any patent that claims the benefit of a provisional application(s), Defendants may rely on the provisional application(s) for purposes of establishing invalidity. Defendants may also rely upon the date of filing of any issued patent or patent application to show the priority date of that reference.

reference disclosing that limitation, (2) any admitted prior art, as explained in the background of each patent or discussed in the file history, (3) any reference identified in Appendices A-A – D-D hereto as disclosing that limitation, and/or (4) the knowledge of a person of ordinary skill in the art and/or any of the references and concepts discussed herein regarding the relevant background and state of the art. The specific combinations of prior art that Defendants contend render the Asserted Claims obvious are readily determinable as described herein, which is the most efficient manner of identifying the combinations. Defendants’ obviousness grounds for each dependent claim incorporate the obviousness grounds for the claim(s) from which the dependent claim depends in addition to any obviousness grounds identified in the charts for the dependent claim.

Where an individual reference is cited with respect to all elements of an Asserted Claim, Defendants contend that the reference anticipates the claim under 35 U.S.C. §§ 102(a), (b), (e), and/or (g) and also renders obvious the claim under 35 U.S.C. § 103, both by itself in view of the knowledge of a person of ordinary skill in the art and in combination with the other cited references to the extent the reference is not found to disclose one or more claim elements. A single prior art reference, for example, can establish obviousness where the differences between the disclosures within the reference and the claimed invention would have been obvious to one of ordinary skill in the art. For example, “[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.” *Boston Scientific Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009). To the extent Defendants contend that an embodiment within a particular item of prior art does not fully disclose all limitations of a claim, Defendants accordingly reserve their rights to rely on other embodiments in that prior art reference, or other information, to show single reference obviousness under 35 U.S.C. § 103(a).

Where an individual reference is cited with respect to fewer than all elements of an Asserted Claim, Defendants contend that the reference renders obvious the claim under 35 U.S.C. § 103(a) in view of each other reference and combination of references that discloses the remaining claim element(s), as indicated in the claim charts submitted herewith. “Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

Exemplary motivations to combine references are discussed below and in the accompanying charts. Defendants reserve the right to rely upon any references or assertions identified herein in connection with Defendants’ contentions that each Asserted Claim is invalid under 35 U.S.C. § 103 and to rely upon expert testimony addressing such references and assertions. The fact that prior art is identified to anticipate the Asserted Claims presents no obstacle in also relying on that reference as a basis for invalidity based on obviousness. It is established that “a rejection for obviousness under § 103 can be based on a reference which happens to anticipate the claimed subject matter.” *In re Meyer*, 599 F.2d 1026, 1031 (C.C.P.A. 1979). To the extent any cited prior art item may not fully disclose a limitation of an Asserted Claim or is alleged by Headwater to lack disclosure of the limitation, such limitation is present and identified in another prior art item as shown in the attached claim charts.

Defendants do not yet have the benefit of Headwater’s positions on the prior art, including what (if any) elements it contends are missing in each prior art reference, whether Headwater agrees that a reference is in fact prior art, and whether Headwater agrees that a person of ordinary

skill in the art would be motivated to combine specific references. Defendants reserve the right to supplement these obviousness positions (including identifying additional prior art combinations and the associated reasons to combine) as discovery in the case progresses, including expert discovery.

The prior art identified below is exemplary; the claimed features are similarly described or disclosed in additional prior art. Thus, Defendants reserve the right to rely on other evidence of the prior art beyond the example references identified herein.

1. U.S. Patent No. 8,589,541

a. Prior Art Patents and Publications

- U.S. Patent Pub. 2008/0160958 (“Abichandani”)
- U.S. Patent Pub. 2009/0217065 (“Araujo”)
- U.S. Patent No. 8,347,362 (“Cai”)
- U.S. Patent Pub. 2008/0080458 (“Cole”)
- U.S. Patent No. 9,167,480 (“Erman”)
- U.S. Patent Pub. 2010/0017506 (“Fadell”)
- U.S. Patent No. 5,987,611 (“Freund”)
- U.S. Patent Pub. 2008/0146268 (“Gandhi”)
- EP Patent Publication No. 1,484,871 A1 (“Kelz”)
- U.S. Patent Pub. 2009/0207817 (“Montemurro”)
- U.S. Patent Pub. 2008/0084977 (“Nayak”)
- U.S. Patent Pub. 2007/0038763 (“Oestvall”)
- U.S. Patent Pub. 2006/0039354 (“Rao”)
- U.S. Patent Pub. 2006/0059556 (“Royer”)
- U.S. Patent Pub. 20090265752 A1 (“Sharif-Ahmadi”)
- U.S. Patent No. 8,381,127 (“Singh”)

- U.S. Patent Pub. 2010/0223096 (“Bosan”)
- U.S. Patent Pub. 2004/0073672 (“Fascenda”)
- U.S. Patent Pub. 2007/0156897 (“Lim”)
- U.S. Patent Pub. 2004/0243682 (“Markki”)
- U.S. Patent Pub. 2012/0157038 (“Menezes”)
- U.S. Patent Pub. 2011/0231890 (“Tovar”)
- U.S. Patent Pub. 2005/0105467 (“True”)
- U.S. Patent Pub. 2012/0117478 (“Vadde”)
- U.S. Patent Pub. 2010/0312892 (“Woundy”)

b. Prior Art Systems

AT&T identifies the following systems as prior art that either anticipate or render obvious the Asserted Claims of the ’541 Patent. Each system was (1) known or used in this country before the alleged invention of the claimed subject matter of the ’541 Patent, (2) was in public use or on sale in this country more than one year prior to the filing date of the application for the ’541 Patent; and/or (3) was invented and not abandoned, suppressed, or concealed prior to the alleged invention of the claimed subject matter of the ’541 Patent. Evidence of the above includes webpages and downloadable content from the time of the alleged invention. Examples of this evidence include downloadable source code, publicly available user guides, and webpages and other downloadable content. Discovery is ongoing and AT&T will supplement these productions as its investigation progresses.³

³ AT&T additionally reserves the right to argue that the Asserted Claims are invalid over additional prior art systems, including those loosely identified by Plaintiff, in its Infringement Contentions, as possibly practicing the claimed inventions, including those systems, products, and services developed by ItsOn Inc., and any related materials. Discovery is ongoing and AT&T will supplement as discovery progresses.

Exemplary Devices
Android Devices, including HTC Dream/T-Mobile G1 (released September 2008); Samsung GT-I7500 Galaxy (released June 2009); T-Mobile myTouch 3G (released July 2009); Motorola Droid (released November 2009); Nexus One (released January 2010); T-Mobile myTouch 3G Slide (released June 2010); and Motorola Droid 2 (released August 2010).

Exemplary Operating Systems
Android, including Android v. 0.9 beta (released August 2008); Android v.1.0 (released September 2008); Android v.1.0r2 (released November 2008); Android v.1.1 (released February 2009); Android Cupcake (v.1.5) (released April 2009); Android v.1.5.r2 (released May 2009); Android v.1.5r3 (released July 2009); Android Donut (v.1.6) (released September 2009); Android Eclair (v.2.0) (released October 2009); and Android Froyo (v.2.2) (released May 2010).

Exemplary Applications
Native Applications on Android v.1.0, including Browser, Dialer, Maps, Messaging, and Music (released September 2008)
Google Voice for Android (released March 2009)
Google Sky Map for Android (released May 2009)
Fring for Android (released November 2009)
JuiceDefender for Android (released January 2010)

c. Prior Invention Under § 102(g)

Each prior art patent, publication, or product identified above was either effectively filed or issued (for patents), published (for publications) or known, used, offered for sale or sold (for products) before either the earliest claimed priority date of the Asserted Patents to which it is applied for invalidity, and none appears to have been abandoned, suppressed, or concealed, so each such reference also constitutes evidence of prior invention pursuant to 35 U.S.C. § 102(g), if it is in the U.S. The persons or entities involved with each such invention include the named inventors on the above-identified patents, the authors listed on the above-identified publications, and the entities and individuals identified in connection with the above-identified products.

AT&T does not yet have the benefit of discovery from Headwater, including taking depositions of the named inventors of the Asserted Patents, reviewing Headwater's productions, and seeking discovery of prior inventions by third parties. AT&T reserves the right to argue that

the authors or inventors of the prior art herein identified invented the subject matter claimed in the '541 Patent prior to the filing date of the '541 Patent. Discovery is ongoing and AT&T will supplement as discovery progresses.

d. Obviousness and Secondary References

The primary references identified above, along with secondary references below, each discloses, either expressly or inherently, every element of the Asserted Claims, thereby anticipating those claims. To the extent Headwater contends that any primary reference does not anticipate the Asserted Claims, it would have been obvious to combine or modify the primary references with concepts from other prior art, including:

- U.S. Patent Pub. 2010/0110890 A1 (“Rainer”)
- U.S. Patent Pub. 2002/0090928 A1 (“Salzwedel”)
- U.S. Patent Pub. 2006/0223495 A1 (“Cassett”)
- EP Patent No. 2,215,873 (“Raissinia”)
- U.S. Patent Pub. 2010/0115048 (“Scahill”)
- U.S. Patent No. 6,898,654 (“Senior”)
- U.S. Patent Pub. 2011/0202646 (“Bhatia”)
- U.S. Patent Pub. 2008/0165711 (“Wyld Pub.”)

For each limitation of the Asserted Claims that Headwater contends is not met by a particular primary reference, Defendants contend that the limitation (and claim as a whole) is obvious based on a combination of that particular primary reference with (1) any other primary reference disclosing that limitation, (2) any admitted prior art, as explained in the background of each patent or discussed in the file history, (3) any reference identified in Exhibits A to F as disclosing that limitation, and/or (4) the knowledge of a person of ordinary skill in the art and/or any of the

references and concepts discussed herein regarding the relevant background and state of the art. The specific combinations of prior art that Defendants contend render the Asserted Claims obvious are readily determinable as described herein, which is the most efficient manner of identifying the combinations in light of the fact that Headwater has asserted 281 claims across 4 patents. Defendants' obviousness grounds for each dependent claim incorporate the obviousness grounds for the claim(s) from which the dependent claim depends in addition to any obviousness grounds identified in the charts for the dependent claim.⁴

2. US Patent No. 8,924,543

a. Prior Art Patents and Publications

- EP Patent No. 1,143,665 A2 ("Jain")
- International Publication No. 2008/046326A1 ("Lv")
- U.S. Patent Pub. 2005/0107087 ("Makinen")
- U.S. Patent No. 6,286,052 ("McCloghrie")
- U.S. Patent No. 9,712,331 ("Poh")
- U.S. Patent Pub. 2006/0039354 ("Rao")
- U.S. Patent Pub. 2005/0276262 ("Schuba")
- U.S. Patent No. 8,688,784 ("Zabawskyj")
- U.S. Patent Pub. 2008/0181208 ("Maes")
- U.S. Patent Pub. 2009/0180377 ("Sullivan")

⁴ Defendants note here that for more than 200 of the 281 Asserted Claims, Headwater's Infringement Contentions do nothing more than point to evidence identified for other Asserted Claims. Commensurate with Plaintiff's own analysis, Defendants' Preliminary Invalidity Contentions likewise rely on incorporation by reference and claim dependency for a significant number of the 281 Asserted Claims.

b. Prior Art Systems

AT&T reserves the right to argue that the Asserted Claims are invalid over prior art systems, including those loosely identified by Plaintiff, in its Infringement Contentions, as possibly practicing the claimed inventions, including those systems, products, and services developed by ItsOn Inc., and any related materials. Discovery is ongoing and AT&T will supplement as discovery progresses.

c. Prior Invention Under § 102(g)

Each prior art patent, publication, or product identified above was either effectively filed or issued (for patents), published (for publications) or known, used, offered for sale or sold (for products) before either the earliest claimed priority date of the Asserted Patents to which it is applied for invalidity, and none appears to have been abandoned, suppressed, or concealed, so each such reference also constitutes evidence of prior invention pursuant to 35 U.S.C. § 102(g), if it is in the U.S. The persons or entities involved with each such invention include the named inventors on the above-identified patents, the authors listed on the above-identified publications, and the entities and individuals identified in connection with the above-identified products.

AT&T does not yet have the benefit of discovery from Headwater, including taking depositions of the named inventors of the Asserted Patents, reviewing Headwater's productions, and seeking discovery of prior inventions by third parties. AT&T reserves the right to argue that the authors or inventors of the prior art herein identified invented the subject matter claimed in the '543 Patent prior to the filing date of the '543 Patent. Discovery is ongoing and AT&T will supplement as discovery progresses.

d. Obviousness and Secondary References

The primary references identified above, along with secondary references below, each discloses, either expressly or inherently, every element of the Asserted Claims, thereby

anticipating those claims. To the extent Headwater contends that any primary reference does not anticipate the Asserted Claims, it would have been obvious to combine or modify the primary references with concepts from other prior art, including:

- U.S. Patent Pub. 2002/0122422 (“Kenney”)
- U.S. Patent Pub. 2009/0100506 (“Whang”)
- U.S. Patent Pub. 2007/0061433 (“Reynolds”)
- U.S. Patent Pub. 2008/0059635 (“Seiforth”)
- European Patent Publication No. 1,617,642 A2
- International Patent Pub. No. 2011/042903 (“Pogorelik”)
- U.S. Patent No. 7,933,221 (“Pawar”)
- U.S. Patent Pub. 2007/0037731 (“Whewell”)
- Universal Mobile Telecommunications System, IP Multimedia Subsystem emergency sessions (3GPP TS 23.167 v. 7.4.0 release 7) (“UMTS”)
- U.S. Patent No. 8,331,229 (“Hu”)

For each limitation of the Asserted Claims that Headwater contends is not met by a particular primary reference, Defendants contend that the limitation (and claim as a whole) is obvious based on a combination of that particular primary reference with (1) any other primary reference disclosing that limitation, (2) any admitted prior art, as explained in the background of each patent or discussed in the file history, (3) any reference identified in Exhibits A to F as disclosing that limitation, and/or (4) the knowledge of a person of ordinary skill in the art and/or any of the references and concepts discussed herein regarding the relevant background and state of the art. The specific combinations of prior art that Defendants contend render the Asserted Claims obvious are readily determinable as described herein, which is the most efficient manner of identifying the combinations in light of the fact that Headwater has asserted 281 claims across 4 patents.

Defendants' obviousness grounds for each dependent claim incorporate the obviousness grounds for the claim(s) from which the dependent claim depends in addition to any obviousness grounds identified in the charts for the dependent claim.

3. US Patent No. 9,198,042

a. Prior Art Patents and Publications

- U.S. Patent Pub. 2007/0288989 ("Aarnos")
- U.S. Patent Pub. 2006/0223495 ("Cassett")
- U.S. Patent Pub. 2007/0021113 ("Hamasaki")
- U.S. Patent Pub. 2007/0006289 ("Limont")
- U.S. Patent Pub. 2006/0183461 ("Pearce")
- U.S. Patent Pub. 2008/0046965 ("Wright")

b. Prior Art Systems

AT&T reserves the right to argue that the Asserted Claims are invalid over prior art systems, including those loosely identified by Plaintiff, in its Infringement Contentions, as possibly practicing the claimed inventions, including those systems, products, and services developed by ItsOn Inc., and any related materials. Discovery is ongoing and AT&T will supplement as discovery progresses.

c. Prior Invention Under § 102(g)

Each prior art patent, publication, or product identified above was either effectively filed or issued (for patents), published (for publications) or known, used, offered for sale or sold (for products) before either the earliest claimed priority date of the Asserted Patents to which it is applied for invalidity, and none appears to have been abandoned, suppressed, or concealed, so each such reference also constitutes evidence of prior invention pursuant to 35 U.S.C. § 102(g), if it is in the U.S. The persons or entities involved with each such invention include the named inventors

on the above-identified patents, the authors listed on the above-identified publications, and the entities and individuals identified in connection with the above-identified products.

AT&T does not yet have the benefit of discovery from Headwater, including taking depositions of the named inventors of the Asserted Patents, reviewing Headwater's productions, and seeking discovery of prior inventions by third parties. AT&T reserves the right to argue that the authors or inventors of the prior art herein identified invented the subject matter claimed in the '042 Patent prior to the filing date of the '042 Patent. Discovery is ongoing and AT&T will supplement as discovery progresses.

d. Obviousness and Secondary References

The primary references identified above, along with secondary references below, each discloses, either expressly or inherently, every element of the Asserted Claims, thereby anticipating those claims. To the extent Headwater contends that any primary reference does not anticipate the Asserted Claims, it would have been obvious to combine or modify the primary references with concepts from other prior art, including:

- U.S. Patent Pub. 2009/0300596 ("Tyhurst")
- U.S. Patent Pub. 2010/0099405 ("Brisebois")
- U.S. Patent Pub. 2008/0163334 ("Perich")
- U.S. Patent No. 8,966,075 ("Chickering")
- U.S. Patent Pub. 2002/0144151 ("Shell")
- U.S. Patent Pub. 2005/0227682 ("Milliot")
- U.S. Patent Pub. 2006/0224742 ("Shahbazi")

For each limitation of the Asserted Claims that Headwater contends is not met by a particular primary reference, Defendants contend that the limitation (and claim as a whole) is obvious based

on a combination of that particular primary reference with (1) any other primary reference disclosing that limitation, (2) any admitted prior art, as explained in the background of each patent or discussed in the file history, (3) any reference identified in Exhibits A to F as disclosing that limitation, and/or (4) the knowledge of a person of ordinary skill in the art and/or any of the references and concepts discussed herein regarding the relevant background and state of the art. The specific combinations of prior art that Defendants contend render the Asserted Claims obvious are readily determinable as described herein, which is the most efficient manner of identifying the combinations in light of the fact that Headwater has asserted 281 claims across 4 patents. Defendants' obviousness grounds for each dependent claim incorporate the obviousness grounds for the claim(s) from which the dependent claim depends in addition to any obviousness grounds identified in the charts for the dependent claim.

4. US Patent No. 9,215,613

a. Prior Art Patents and Publications

- US Patent Pub. 2008/0160958 ("Abichandani")
- U.S. Patent No. 9,167,480 ("Erman")
- US Patent Pub. 2009/0217065 ("Araujo")
- US Patent No. 8,347,362 ("Cai")
- US Patent Pub. 2008/0080458 ("Cole")
- US Patent Pub. 2010/0017506 ("Fadell")
- US Patent No. 5,987,611 ("Freund")
- US Patent Pub. 2008/0146268 ("Gandhi")
- European Patent Publication No. 1,484,871 A1 ("Kelz")
- US Patent Pub. 2009/0207817 ("Montemurro")

- US Patent Pub. 2008/0084977 (“Nayak”)
- US Patent Pub. 2007/0038763 (“Oestvall”)
- US Patent Pub. 2006/0039354 (“Rao”)
- US Patent Pub. 2006/0059556 (“Royer”)
- US Patent Pub. 20090265752 A1 (“Sharif-Ahmadi”)
- US Patent No. 8,381,127 (“Singh”)
- US Patent No. 8,028,060 (“Wyld”)
- US Patent Pub. 2012/0157038 (“Menezes”)
- US Patent Pub. 2011/0231890 (“Tovar”)
- US Patent Pub. 2012/0117478 (“Vadde”)

b. Prior Art Systems

AT&T identifies the following systems as prior art that either anticipate or render obvious the Asserted Claims of the ’613 Patent. Each system was (1) known or used in this country before the alleged invention of the claimed subject matter of the ’613 Patent, (2) was in public use or on sale in this country more than one year prior to the filing date of the application for the ’613 Patent; and/or (3) was invented and not abandoned, suppressed, or concealed prior to the alleged invention of the claimed subject matter of the ’613 Patent. Evidence of the above includes webpages and downloadable content from the time of the alleged invention. Examples of this evidence include downloadable source code, publicly available user guides, and webpages and other downloadable content. Discovery is ongoing and AT&T will supplement these productions as its investigation progresses.⁵

⁵ AT&T additionally reserves the right to argue that the Asserted Claims are invalid over additional prior art systems, including those loosely identified by Plaintiff, in its Infringement Contentions, as possibly practicing the claimed inventions, including those systems, products, and services

Exemplary Devices
Android Devices, including HTC Dream/T-Mobile G1 (released September 2008); Samsung GT-I7500 Galaxy (released June 2009); T-Mobile myTouch 3G (released July 2009); Motorola Droid (released November 2009); Nexus One (released January 2010); T-Mobile myTouch 3G Slide (released June 2010); and Motorola Droid 2 (released August 2010).

Exemplary Operating Systems
Android, including Android v.0.9 beta (released August 2008); Android v.1.0 (released September 2008); Android v.1.0r2 (released November 2008); Android v.1.1 (released February 2009); Android Cupcake (v.1.5) (released April 2009); Android v.1.5r2 (released May 2009); Android v.1.5r3 (released July 2009); Android Donut (v.1.6) (released September 2009); Android Eclair (v.2.0) (released October 2009); and Android Froyo (v.2.2) (released May 2010).

Exemplary Applications
Native Applications on Android v.1.0, including Browser, Dialer, Maps, Messaging, and Music (released September 2008)
Google Voice for Android (released March 2009)
Google Sky Map for Android (released May 2009)
Fring for Android (released November 2009)
JuiceDefender for Android (released January 2010)

c. Prior Invention Under § 102(g)

Each prior art patent, publication, or product identified above was either effectively filed or issued (for patents), published (for publications) or known, used, offered for sale or sold (for products) before either the earliest claimed priority date of the Asserted Patents to which it is applied for invalidity, and none appears to have been abandoned, suppressed, or concealed, so each such reference also constitutes evidence of prior invention pursuant to 35 U.S.C. § 102(g), if it is in the U.S. The persons or entities involved with each such invention include the named inventors on the above-identified patents, the authors listed on the above-identified publications, and the entities and individuals identified in connection with the above-identified products.

developed by ItsOn Inc., and any related materials. Discovery is ongoing and AT&T will supplement as discovery progresses.

AT&T does not yet have the benefit of discovery from Headwater, including taking depositions of the named inventors of the Asserted Patents, reviewing Headwater's productions, and seeking discovery of prior inventions by third parties. AT&T reserves the right to argue that the authors or inventors of the prior art herein identified invented the subject matter claimed in the '613 Patent prior to the filing date of the '613 Patent. Discovery is ongoing and AT&T will supplement as discovery progresses.

d. Obviousness and Secondary References

The primary references identified above, along with secondary references below, each discloses, either expressly or inherently, every element of the Asserted Claims, thereby anticipating those claims. To the extent Headwater contends that any primary reference does not anticipate the Asserted Claims, it would have been obvious to combine or modify the primary references with concepts from other prior art, including:

- European Patent No. 2,215,873 ("Raissinia")
- U.S. Patent Pub. 2010/0115048 ("Scahill")
- U.S. Patent No. 6,898,654 ("Senior")
- International Patent Publication WO 2008/046212 A1 ("McDonald")
- U.S. Patent No. 7,069,330 ("McArdle")
- U.S. Patent Pub. 2005/0100000 ("Faulkner")
- U.S. Patent Pub. 2006/0084417 A1 ("Melpignano")
- US Patent Pub. 2008/0165711A1 ("Wyld Pub.")

For each limitation of the Asserted Claims that Headwater contends is not met by a particular primary reference, Defendants contend that the limitation (and claim as a whole) is obvious based on a combination of that particular primary reference with (1) any other primary reference

disclosing that limitation, (2) any admitted prior art, as explained in the background of each patent or discussed in the file history, (3) any reference identified in Exhibits A to F as disclosing that limitation, and/or (4) the knowledge of a person of ordinary skill in the art and/or any of the references and concepts discussed herein regarding the relevant background and state of the art. The specific combinations of prior art that Defendants contend render the Asserted Claims obvious are readily determinable as described herein, which is the most efficient manner of identifying the combinations in light of the fact that Headwater has asserted 281 claims across 4 patents. Defendants' obviousness grounds for each dependent claim incorporate the obviousness grounds for the claim(s) from which the dependent claim depends in addition to any obviousness grounds identified in the charts for the dependent claim.

C. P.R. 3-3(c) – Claim Charts

Defendants attach the following claim charts pursuant to P.R. 3-3(c):

Asserted Patent	Claim Chart Exhibits
'541 Patent	Exs. A-1 – A-26
'543 Patent	Exs. B-1 – B-10
'042 Patent	Exs. C-1 – C-6
'613 Patent	Exs. D-1 – D-21

This prior art is exemplary; the claimed features are similarly described or disclosed in other prior art.

The attached claim charts are based, in whole or in part, on Headwater's asserted theories of infringement in this case, to the extent discernible from Headwater's Infringement Contentions. As an initial matter, all portions of each prior art reference cited in each of the attached claim charts are relied upon to support the disclosure of each patent claim limitation, as all portions provide general support. Representative descriptions and supporting citations are nevertheless provided but are merely exemplary; they do not necessarily reflect every instance where a particular claim term or claim limitation may be disclosed in or taught by the prior art reference. References to figures or drawings refer to the figures/drawings themselves, as well as to any accompanying text

or text necessary to understand the figures or drawings. References to text refers to the text itself, as well as the accompanying figures or drawings that accompany the text. Defendants reserve the right to rely on additional, or different, portions of the prior art references, other publications and expert testimony to establish what these references would have taught one of ordinary skill in the art, or in what manner they would have motivated a particular combination of references. Moreover, in certain instances, representative documents for certain prior art systems are cited, but, again, they are merely exemplary; they do not necessarily reflect or include every document relating to the prior art system that exists and that discloses or teaches a particular claim term or claim limitation. Defendants reserve the right to rely on any and all documents that describe or relate to prior art systems, including relying on the system itself. Defendants also reserve the right to rely on the testimony of the authors, named inventors, or anyone else with knowledge of the prior art references and systems identified herein, as well as expert testimony regarding any such references or systems.

Where Defendants identify a particular figure in a prior art reference, the identification should be understood to encompass the caption and description of the figure as well as any text relating to the figure in the specification and prosecution history in addition to the figure itself. Similarly, where an identified portion of text refers to a figure or other material, the identification should be understood to include the referenced figure or other material as well.

D. Obviousness – Motivations to Combine Prior Art

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), recognized that patents based on new combinations of elements or components already known in a technical field may be found to have been obvious. In doing so, the Supreme Court rejected a rigid application of the “teaching, suggestion, or motivation [to combine]” test. *Id.* at 415, 419. “In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the

avowed purpose of the patentee controls. What matters is the objective reach of the claim.” *Id.* at 419. “Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420. The Supreme Court emphasized the principle that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. A key inquiry is whether the “improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 417.

The Court further held that “in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420. It is sufficient that a combination of elements was “obvious to try”—“When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *Id.* at 421. “In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.” *Id.* Finally, the Supreme Court recognized that “[g]ranting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.” *Id.* at 419.⁶

⁶ The rationale to combine or modify prior art references is significantly stronger when the references seek to solve the same problem, come from the same field, and correspond well together. See *In re Inland Steel Co.*, 265 F.3d 1354, 1362 (Fed. Cir. 2001) (allowing two references to be combined as invalidating art under similar circumstances where the art “focus[ed] on the same problem ... c[a]me from the same field of art [and] ... the identified problem found in the two references correspond[ed] well”).

In view of *KSR*, the PTO issued a set of new Examination Guidelines. See Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007). Those Guidelines identified various rationales for finding a claim obvious, including:

- a) Combining prior art elements according to known methods to yield predictable results;
- b) Simple substitution of one known element for another to obtain predictable results;
- c) Use of known technique to improve similar devices (methods, or products) in the same way;
- d) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- e) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- f) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- g) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Id. at 57,529.

For each proposed combination of references described herein and in the attached exhibits and appendices hereto, because (i) there was a reason to make each combination, (ii) each combination of art would have produced no unexpected results, and/or (iii) each combination at most would simply represent a known alternative to one of ordinary skill in the art, no showing of a specific motivation to combine prior art is required. See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 414–18 (2007) (rejecting the Federal Circuit’s “rigid” application of the teaching, suggestion, or motivation to combine test instead espousing an “expansive and flexible” approach).

In view of the above, Defendants have identified several exemplary motivations and reasons to combine the various references cited herein, and those motivations would have been supported, in part, by a reasonable expectation of success. The various teachings, suggestions, and/or reasons to modify any of the references and/or to combine any two or more of the references in Exhibits A-D, and Appendices A-A – D-D come from various sources, including the prior art (specific and as a whole), common knowledge, common sense, predictability, expectations, industry trends, design incentives or need, market demand or pressure, market forces, the nature of the problem faced, and/or the knowledge possessed by one of ordinary skill in the art. In addition, it would have been obvious to try combining the prior art references identified above.

These exemplary combinations demonstrate that there were only a finite number of predictable solutions to known problems addressed by the Asserted Patents. Furthermore, known work in one field or endeavor prompted variations based on predictable design incentives and/or market forces either in the same field or a different one. The combination of features found in the prior art references identified in these contentions would have been obvious because the claimed combinations represent the known potential options, with each such option having a reasonable expectation of success. Additionally, one of ordinary skill in the art would have been motivated to create combinations identified in these contentions using: known methods to yield predictable results; known techniques in the same way; a simple substitution of one known, equivalent element for another to obtain predictable results; and/or teaching, suggestion, or motivation in the prior art generally. Also, market forces in the industry, and the desire to improve features and performance, would motivate the addition of features to systems as they become available, become less expensive, become more commonly used, provide better performance and reliability, reduce costs, or predictably achieve other clearly desirable results.

To the extent Headwater alleges that any other claimed limitation or limitations are not disclosed in any primary reference, it would have been obvious to combine the teachings of the reference with the background knowledge of a person of ordinary skill in the art and/or it would have been obvious to incorporate the missing limitation(s), including as disclosed in Exhibits A-D, and Appendices A-A – D-D into the primary reference for the reasons disclosed herein. For example, one of ordinary skill in the art would have found substantial motivation to combine one or more of the primary references with one more of each other or the secondary references in order to disclose the alleged inventions recited in the Asserted Claims. Each of the references disclosed herein as invalidating an Asserted Patent was directed at the same or similar field of technology and the same or similar problem as that Asserted Patent. To the extent Headwater alleges that any particular claim limitation is not disclosed or inherent in the charted references, it would have been obvious to combine the charted reference with one or more of the references identified herein for the particular claim limitations.

Next, as Defendants are currently unaware of the extent, if any, to which Headwater will contend that limitations of the Asserted Claims are not disclosed in the art identified herein as anticipatory, Defendants reserves the right to identify other references and combinations that may render an allegedly missing limitation obvious. In addition, if and to the extent that Headwater challenges the relevance of any of these references with respect to particular limitations of the Asserted Claims of the Asserted Patents, Defendants reserve their right to identify further motivation to combine particular references with additional particularity.

Finally, because Headwater's Infringement Contentions include a highly burdensome and improper number of Asserted Claims—281 across four patents—and because for more than 200 of the 281 Asserted Claims, Headwater's Infringement Contentions do nothing more than point to

evidence identified for other Asserted Claims, Defendants reserve the right to identify other references, combinations, and motivations to combine that may render an allegedly missing limitation obvious.

1. US Patent No. 8,589,541

a. Exemplary Combinations of Primary References

Defendants identify below an exemplary list of anticipated combinations of the primary references identified above for the '541 Patent. Defendants offer these exemplary combinations for the purposes of illustration only and without and inference or admission that any such references are required to be combined as illustrated below to disclose any Asserted Claim of the '541 Patent. In providing these exemplary combinations, Defendants reserve all rights to assert that any primary reference, alone or in combination with any other primary reference, secondary reference, or reference disclosing the state of the art, anticipates or renders obvious the Asserted Claims of the '541 Patent (including for, but not limited to, the more than 200 Asserted Claims for which Headwater's Infringement Contentions include no independent evidence).

- Rao in combination with Nayak
- Rao in combination with Abichandani
- Rao in combination with Fadell
- Rao in combination with Montemurro
- Rao in combination with Royer
- Rao in combination with Menezes
- Rao in combination with Cole
- Rao in combination with Freund
- Rao in combination with Kelz

- Rao in combination with Sharif-Ahmadi
- Rao in combination with Nayak and Abichandani
- Rao in combination with Nayak and Fadell
- Rao in combination with Nayak and Montemurro
- Nayak in combination with Abichandani
- Nayak in combination with Fadell
- Nayak in combination with Montemurro
- Nayak in combination with Royer
- Nayak in combination with Menezes
- Nayak in combination with Cole
- Nayak in combination with Freund
- Nayak in combination with Kelz
- Nayak in combination with Sharif-Ahmadi
- Abichandani in combination with Fadell
- Abichandani in combination with Montemurro
- Abichandani in combination with Royer
- Abichandani in combination with Menezes
- Abichandani in combination with Cole
- Abichandani in combination with Freund
- Abichandani in combination with Kelz
- Abichandani in combination with Sharif-Ahmadi
- Fadell in combination with Montemurro
- Fadell in combination with Royer

- Fadell in combination with Menezes
- Fadell in combination with Cole
- Fadell in combination with Freund
- Fadell in combination with Kelz
- Fadell in combination with Sharif-Ahmadi
- Montemurro in combination with Royer
- Montemurro in combination with Menezes
- Montemurro in combination with Cole
- Montemurro in combination with Freund
- Montemurro in combination with Kelz
- Montemurro in combination with Sharif-Ahmadi
- Royer in combination with Menezes
- Royer in combination with Cole
- Royer in combination with Freund
- Royer in combination with Kelz
- Royer in combination with Sharif-Ahmadi
- Menezes in combination with Cole
- Menezes in combination with Freund
- Menezes in combination with Kelz
- Menezes in combination with Sharif-Ahmadi
- Cole in combination with Freund
- Cole in combination with Kelz
- Cole in combination with Sharif-Ahmadi

- Fruend in combination with Kelz
- Fruend in combination with Sharif-Ahmadi
- Kelz in combination with Sharif-Ahmadi

b. Exemplary Motivations to Combine

Defendants have identified several exemplary motivations and reasons to combine the various references cited herein. For any reference for which there is a claim element that does not have a corresponding citation in that reference, it would be obvious to combine with the knowledge or a person of skill and/or any other reference in the primary or secondary charts for which there is a citation for that element. These combinations would have been obvious to try given that there were a finite number of identified, predictable solutions in the prior art, and there would have been a reasonable expectation of success to simply implement one prior art solution with concepts from prior art in the same field.

It would have been obvious to combine each of the references discussed below because they are analogous art generally directed to management of data usage by wireless devices. For example:

- A person of ordinary skill would have been motivated to combine Rao with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Rao with references that disclose management of data usage by wireless devices. (*see, e.g.,* Nayak, Abichandani, Fadell, Montemurro, Royer, Menezes, Cole, Freund, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to

wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Rao discloses methods for “application-aware, client-specific prioritization of packet traffic” from a wireless device over a wireless network, and acknowledges that “[o]ne ordinarily skilled in the art will recognize and appreciate the multitude of ways to define client-side application priorities.” Rao at [0003], [0182]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Rao to provide a variety of means and methods for prioritization of application traffic over a wireless network.

- A person of ordinary skill would have been motivated to combine Nayak with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Nayak with references that disclose management of data usage by wireless devices. (*see, e.g.*, Rao, Abichandani, Fadell, Montemurro, Royer, Cole, Freund, Kelz, Menezes, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Nayak identifies the problem, in the context of receiving “contact information” from an application on a wireless device, that “[d]uring periods when the user is not interested

in receiving the contact information, the receipt of contact presence information can increase data usage on the network, which can potentially cause congestion on the network.” Nayak at [0002]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Nayak to address the issue of wireless network congestion.

- A person of ordinary skill would have been motivated to combine Abichandani with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Abichandani with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Rao, Menezes, Fadell, Montemurro, Royer, Cole, Freund, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Abichandani discloses methods for “for controlling access to mobile applications from the mobile device based on access conditions associated with a current access network” using “a policy or application access database.” Abichandani at [0004]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Abichandani given the substantial overlap in methods addressing congestion in wireless networks.
- A person of ordinary skill would have been motivated to combine Fadell with the

exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Fadell with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Freund, Montemurro, Royer, Cole, Rao, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Fadell discloses the use of a “resource utilization component” on an electronic device, such as a wireless device, “to adjust the resource consumption of the electronic device.” Fadell at [0022]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Fadell given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Cole with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Cole with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Fadell, Montemurro, Royer, Rao, Menezes, Freund, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have

been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Cole, which is directed in part to problems associated with “background applications, which typically operate without direct interaction from the user,” discloses the use of a “connection manager” to selectively permit applications to communicate over wireless networks based on classifications of the application and available networks. Cole at [0009], [0036]. Indeed, Cole acknowledges that “the various protocols required” to implement the “connection manager” would be “known to those ordinary skill in the art.” *Id.* at [0035]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Cole given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Montemurro with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Montemurro with references that disclose management of data usage by wireless devices. (*see, e.g.*, Rao, Nayak, Menezes, Abichandani, Fadell, Royer, Cole, Freund, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device

application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Montemurro discloses methods “to optimize communications using a policy-based mechanism to configure connections and routes” over a wireless network, and highlights that these “[p]olicies may be responsive to various factors.” Montemurro at [0011]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Montemurro to provide a variety of means and methods for prioritization of application traffic over a wireless network.

- A person of ordinary skill would have been motivated to combine Royer with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Royer with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Freund, Montemurro, Menezes, Cole, Rao, Fadell, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Royer discloses the use of an “activity manager and a communication processor” for “identifying activity associated with” applications and determining whether the “application is inactive.” *See* Royer at [0007]. As such, a person of ordinary skill

would have recognized that the exemplary teachings cited in Exhibit A could be combined with Royer given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Menezes with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Menezes with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Freund, Montemurro, Royer, Cole, Rao, Fadell, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Menezes discloses the use of “policies” “defining data usage for the mobile computing device” in an “application component” on a “mobile computing device” that “can determine a manner for executing network operations that involve data transmission over the network.” *See* Menezes at Abstract. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibits Exhibit A could be combined with Menezes given their relevant disclosures related to client-side management of data usage by a wireless device.
- A person of ordinary skill would have been motivated to combine Freund with the exemplary citations and commentary provided Exhibit A to yield the claimed

invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Freund with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Fadell, Montemurro, Royer, Cole, Rao, Kelz, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Freund discloses methods for “client-based monitoring and filtering of access” using a “centralized enforcement supervisor.” Freund at Abstract. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Freund given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Kelz with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Kelz with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Freund, Montemurro, Royer, Cole, Rao, Fadell, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device

application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Kelz discloses the use of a “controller module” in a mobile device to interface between the “applications that are implemented on the mobile device and the protocol stacks” and to “priorit[ize]” certain traffic from certain applications over others. Kelz at [0006]–[0007]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit A could be combined with Kelz given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Sharif-Ahmadi with the exemplary citations and commentary provided in Exhibit A to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Sharif-Ahmadi with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Freund, Montemurro, Royer, Cole, Rao, Fadell, Kelz, and Menezes). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Sharif-Ahmadi discloses the use of “network polic[ies]” that are “stored on the mobile device” that permit applications to communicate over a network “only if [they] meet[] the policy parameters as established by the network policy.” *See* Sharif-Ahmadi at Abstract. As such, a person of ordinary skill would

have recognized that the exemplary teachings cited in Exhibit A could be combined with Sharif-Ahmadi given their relevant disclosures related to client-side management of data usage by a wireless device.

2. US Patent No. 8,924,543

a. Exemplary Combinations of Primary References

Defendants identify below an exemplary list of anticipated combinations of the primary references identified above for the '543 Patent. Defendants offer these exemplary combinations for the purposes of illustration only and without and inference or admission that any such references are required to be combined as illustrated below to disclose any Asserted Claim of the '543 Patent. In providing these exemplary combinations, Defendants reserve all rights to assert that any primary reference, alone or in combination with any other primary reference, secondary reference, or reference disclosing the state of the art, anticipates or renders obvious the Asserted Claims of the '543 Patent (including for, but not limited to, the more than 200 Asserted Claims for which Headwater's Infringement Contentions include no independent evidence).

- Rao in combination with McCloghrie
- Rao in combination with Makinen
- Rao in combination with Jain
- Rao in combination with Zabawskyj
- Rao in combination with Lv
- Rao in combination with Poh
- Rao in combination with Schuba
- Rao in combination with Maes
- Rao in combination with Sullivan

- Rao in combination with Poh and Schuba
- Rao in combination with Lv, Poh, and Schuba
- McCloghrie in combination with Makinen
- McCloghrie in combination with Jain
- McCloghrie in combination with Zabawskyj
- McCloghrie in combination with Lv
- McCloghrie in combination with Poh
- McCloghrie in combination with Schuba
- McCloghrie in combination with Maes
- McCloghrie in combination with Sullivan
- McCloghrie in combination with Poh and Schuba
- McCloghrie in combination with Lv, Poh, and Schuba
- Makinen in combination with Jain
- Makinen in combination with Zabawskyj
- Makinen in combination with Lv
- Makinen in combination with Poh
- Makinen in combination with Schuba
- Makinen in combination with Maes
- Makinen in combination with Sullivan
- Makinen in combination with Poh and Schuba
- Makinen in combination with Lv, Poh, and Schuba
- Jain in combination with Zabawskyj
- Jain in combination with Lv

- Jain in combination with Poh
- Jain in combination with Schuba
- Jain in combination with Maes
- Jain in combination with Sullivan
- Jain in combination with Poh and Schuba
- Jain in combination with Lv, Poh, and Schuba
- Zabawskyj in combination with Lv
- Zabawskyj in combination with Poh
- Zabawskyj in combination with Schuba
- Zabawskyj in combination with Maes
- Zabawskyj in combination with Sullivan
- Zabawskyj in combination with Poh and Schuba
- Zabawskyj in combination with Lv, Poh, and Schuba
- Lv in combination with Poh
- Lv in combination with Schuba
- Lv in combination with Maes
- Lv in combination with Sullivan
- Lv in combination with Poh and Schuba
- Poh in combination with Schuba
- Poh in combination with Maes
- Poh in combination with Sullivan
- Schuba in combination with Maes
- Schuba in combination with Sullivan

- Maes in combination with Sullivan

b. Exemplary Motivations to Combine

Defendants have identified several exemplary motivations and reasons to combine the various references cited herein. For any reference for which there is a claim element that does not have a corresponding citation in that reference, it would be obvious to combine with the knowledge or a person of skill and/or any other reference in the primary or secondary charts for which there is a citation for that element. These combinations would have been obvious to try given that there were a finite number of identified, predictable solutions in the prior art, and there would have been a reasonable expectation of success to simply implement one prior art solution with concepts from prior art in the same field.

It would have been obvious to combine each of the references discussed below because they are analogous art generally directed to network management in a wireless communication system. For example:

- A person of ordinary skill would have been motivated to combine Rao with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Rao with references that disclose network management and policy application. (*see, e.g.,* McCloghrie, Makinen, Jain, Zabawskyj, Lv, Poh, Schuba, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed to network traffic management, and specifically methods for managing and prioritizing traffic flows based on network policies. For instance, Rao discloses

methods for network management where “network packets are communicated . . . according to the determined priorities” and acknowledges that “[o]ne ordinarily skilled in the art will recognize and appreciate that . . . the present invention will communicate the network packets from the queues in a manner according to or consistent with the determined priorities, which in turn, may be based or derived from the policies of the client.” Rao at [0194]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Rao to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

- A person of ordinary skill would have been motivated to combine McCloghrie with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from McCloghrie with references that disclose network management and policy application. (*see, e.g.*, Rao, Makinen, Jain, Zabawskyj, Lv, Poh, Schuba, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed to network management, and specifically methods for managing and prioritizing traffic flows based on network policies. For instance, McCloghrie discloses methods “for identifying specific traffic flows originating from a network entity and for applying predetermined policy or service treatments to those flows.” McCloghrie at 4:34-37. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be

combined with McCloghrie to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

- A person of ordinary skill would have been motivated to combine Makinen with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Makinen with references that disclose network management and policy application. (*see, e.g.*, Rao, McCloghrie, Jain, Zabawskyj, Lv, Poh, Schuba, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed to network traffic management, and specifically methods for managing network policies using traffic plans. For instance, Makinen discloses methods for “managing services in a telecommunication system,” where the method “may comprise providing common traffic category groups; providing for said common traffic categories information as to how the respective common traffic categories are to be treated in said network.” Makinen at [0001], [0021]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Makinen to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.
- A person of ordinary skill would have been motivated to combine Jain with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For

example, a person of ordinary skill in the art would have been motivated to combine the teachings from Jain with references that disclose network management and policy application. (*see, e.g.*, Rao, McCloghrie, Makinen, Zabawskyj, Lv, Poh, Schuba, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed to network traffic management, and specifically methods for managing network policies using traffic plans. For instance, Jain discloses methods for “efficient, integrated and scalable policy management services for . . . networks,” where the method may include “[a]n order number attribute 726 for the policy rule [that] indicates the sequence in which the policy is to be applied.” Jain at [0001], [0070]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Jain to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

- A person of ordinary skill would have been motivated to combine Zabawskyj with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Zabawskyj with references that disclose network management and policy application. (*see, e.g.*, Rao, McCloghrie, Makinen, Jain, Lv, Poh, Schuba, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed to network traffic management, and specifically methods for managing network

policies using traffic plans. For instance, Zabawskyj discloses methods for “generating a traffic plan” that “inspect[s] the packets forming the request to access service” and “obtain policy information relative to the terms of use of service” for telecommunication networks. Zabawskyj at [0008], [0089]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Zabawskyj to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

- A person of ordinary skill would have been motivated to combine Lv with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Lv with references that disclose network management and policy application. (*see, e.g.*, Rao, McCloghrie, Makenin, Jain, Zabawskyj, Poh, Schuba, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed to network traffic management, and specifically methods for managing network policies using traffic plans. For instance, Lv discloses methods for “controlling network services” through “the policy control mechanism based on service and user subscription information,” where the method may include performing “corresponding policy scheduling on the data flow according to the obtained deep packet inspection policy, such as priority marking.” Lv at 1:6, 1:14-29, 6:25-26. As such, a person of ordinary skill would have recognized that the exemplary

teachings cited in Exhibit B could be combined with Lv to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

- A person of ordinary skill would have been motivated to combine Poh with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Poh with references that disclose network management and policy application. (*see, e.g.*, Rao, McCloghrie, Makenin, Jain, Zabawskyj, Lv, Schuba, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed to network traffic management, and specifically methods for managing network policies using traffic plans. For instance, Poh discloses methods for “a policy configuration and provisioning system for a policy realization framework on a communications network,” where the method may include “resolving the policy conflict by giving precedence to the first policy over the second policy.” Poh at 3:8-9, 26:14-15. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Poh to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.
- A person of ordinary skill would have been motivated to combine Schuba with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in

doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Schuba with references that disclose network management and policy application. (*see, e.g.*, Rao, McCloghrie, Makinen, Jain, Zabawskyj, Lv, Poh, Maes, and Sullivan). A person of ordinary skill would have been motivated to combine these references because they are directed network traffic management, and specifically methods for managing network policies using traffic plans. For instance, Schuba discloses methods for “network flow policy enforcement,” where the method may include using a “flow manager” that receives “prioritized packet flow rules” to generate “a unified rule set” according to the “priority policy.” Schuba at Abstract, [0027]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Schuba to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

- A person of ordinary skill would have been motivated to combine Maes with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Maes with references that disclose network management and policy application. (*see, e.g.*, Rao, McCloghrie, Makinen, Jain, Zabawskyj, Lv, Poh, and Schuba). A person of ordinary skill would have been motivated to combine these references because they are directed network traffic management, and specifically methods for managing network policies using

traffic plans. For instance, Maes discloses methods for “processing [] network traffic using a smart router” that includes “a message inspection module operable to receive a message and determine identification information about that message and “a policy enforcement module operable to dynamically determine a policy to enforce on the message, based at least in part upon the identification information obtained by the message inspection module.” Maes at [0007]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Maes to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

- A person of ordinary skill would have been motivated to combine Sullivan with the exemplary citations and commentary provided in Exhibit B to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Sullivan with references that disclose network management and policy application. (*see, e.g.,* Rao, McCloghrie, Mäkinen, Jain, Zabawskyj, Lv, Poh, Schuba, and Maes). A person of ordinary skill would have been motivated to combine these references because they are directed network traffic management, and specifically methods for managing network policies using traffic plans. For instance, Sullivan discloses methods for “processing a network packet[s] . . . in a data processing network” including “determining a priority category of the network packet” and determining “a traffic policy . . . that is applicable to the level of traffic activity and the priority

category of the network packet.” Sullivan at Abstract. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit B could be combined with Sullivan to provide a variety of means and methods for prioritization of network traffic for policy management in a wireless network.

3. US Patent No. 9,198,042

a. Exemplary Combinations of Primary References

Defendants identify below an exemplary list of anticipated combinations of the primary references identified above for the '042 Patent. Defendants offer these exemplary combinations for the purposes of illustration only and without and inference or admission that any such references are required to be combined as illustrated below to disclose any Asserted Claim of the '042 Patent. In providing these exemplary combinations, Defendants reserve all rights to assert that any primary reference, alone or in combination with any other primary reference, secondary reference, or reference disclosing the state of the art, anticipates or renders obvious the Asserted Claims of the '042 Patent (including for, but not limited to, the more than 200 Asserted Claims for which Headwater's Infringement Contentions include no independent evidence).

- Cassett in combination with Limont
- Cassett in combination with Hamasaki
- Cassett in combination with Pearce
- Cassett in combination with Aarnos
- Limont in combination with Hamasaki
- Limont in combination with Pearce
- Limont in combination with Aarnos

- Limont in combination with Hamasaki and Cassett
- Hamasaki in combination with Pearce
- Hamasaki in combination with Aarnos
- Pearce in combination with Aarnos
- Pearce in combination with Limont and Cassett
- Aarnos in combination with Limont and Cassett

b. Exemplary Motivations to Combine

Defendants have identified several exemplary motivations and reasons to combine the various references cited herein. For any reference for which there is a claim element that does not have a corresponding citation in that reference, it would be obvious to combine with the knowledge of a person of skill and/or any other reference in the primary or secondary charts for which there is a citation for that element. These combinations would have been obvious to try given that there were a finite number of identified, predictable solutions in the prior art, and there would have been a reasonable expectation of success to simply implement one prior art solution with concepts from prior art in the same field.

It would have been obvious to combine each of the references discussed below because they are analogous art generally directed to policy management in a wireless communication system. For example:

- A person of ordinary skill would have been motivated to combine Cassett with the exemplary citations and commentary provided in Exhibit C to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Cassett with references about device

policy management. (*see, e.g.*, Limont, Hamasaki, Pearce, Aarnos). A person of ordinary skill would have been motivated to combine these references because they are directed to methods for updating end-user device network policies based on end-user device status. For instance, Cassett discloses methods “to monitor and log wireless device usage data that may be used to generate usage pattern reports,” which may be used “to make informed decisions regarding products and services to provide to the device, and/or network design relating to the usage of the device.” Cassett at [0006]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit C could be combined with Cassett to provide a variety of means and methods for updating network policies on end-user devices in a wireless network.

- A person of ordinary skill would have been motivated to combine Limont with the exemplary citations and commentary provided in Exhibit C to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Limont with references about device policy management. (*see, e.g.*, Cassett, Hamasaki, Pearce, Aarnos). A person of ordinary skill would have been motivated to combine these references because they are directed to methods for updating end-user device network policies based on end-user device status. For instance, Limont discloses methods to “enforcing device settings for mobile devices,” where the method may include “receiv[ing] a data command from a mobile device . . . representing the current policy settings” and then “send[ing] the updated policy settings . . . to the mobile device.” Limont

at [0018], [0030], [0031]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit C could be combined with Limont to provide a variety of means and methods for updating network policies on end-user devices in a wireless network.

- A person of ordinary skill would have been motivated to combine Hamasaki with the exemplary citations and commentary provided in Exhibit C to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Hamasaki with references about device policy management. (*see, e.g.,* Cassett, Limont, Pearce, Aarnos). A person of ordinary skill would have been motivated to combine these references because they are directed to methods for updating end-user device network policies based on end-user device status. For instance, Hamasaki discloses methods for “device management operations on electric devices,” particularly in the roaming context. Hamasaki at [0010]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit C could be combined with Hamasaki to provide a variety of means and methods for updating network policies on end-user devices in a wireless network.
- A person of ordinary skill would have been motivated to combine Pearce with the exemplary citations and commentary provided in Exhibit C to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Pearce with references about device

policy management. (*see, e.g.*, Cassett, Hamasaki, Limont, Aarnos). A person of ordinary skill would have been motivated to combine these references because they are directed to methods for updating end-user device network policies based on end-user device status. For instance, Pearce discloses methods “modifying policy settings in an electronic device” based on the user’s geographic region. Pearce at [0001], [0007]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit C could be combined with Pearce to provide a variety of means and methods for updating network policies on end-user devices in a wireless network.

- A person of ordinary skill would have been motivated to combine Aarnos with the exemplary citations and commentary provided in Exhibit C to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Aarnos with references about device policy management. (*see, e.g.*, Cassett, Hamasaki, Pearce, Limont). A person of ordinary skill would have been motivated to combine these references because they are directed to methods for updating end-user device network policies based on end-user device status. For instance, Aarnos discloses methods for “updating a security policy associated with an electronic device.” Aarnos at [0010]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit C could be combined with Aarnos to provide a variety of means and methods for updating network policies on end-user devices in a wireless network.

4. US Patent No. 9,215,613

a. Exemplary Combinations of Primary References

Defendants identify below an exemplary list of anticipated combinations of the primary references identified above for the '613 Patent. Defendants offer these exemplary combinations for the purposes of illustration only and without and inference or admission that any such references are required to be combined as illustrated below to disclose any Asserted Claim of the '613 Patent. In providing these exemplary combinations, Defendants reserve all rights to assert that any primary reference, alone or in combination with any other primary reference, secondary reference, or reference disclosing the state of the art, anticipates or renders obvious the Asserted Claims of the '613 Patent (including for, but not limited to, the more than 200 Asserted Claims for which Headwater's Infringement Contentions include no independent evidence).

- Rao in combination with Nayak
- Rao in combination with Abichandani
- Rao in combination with Fadell
- Rao in combination with Montemurro
- Rao in combination with Royer
- Rao in combination with Wyld
- Rao in combination with Cole
- Rao in combination with Freund
- Rao in combination with Sharif-Ahmadi
- Rao in combination with Nayak and Montemurro
- Rao in combination with Nayak and Abichandani
- Rao in combination with Nayak and Fadell

- Nayak in combination with Abichandani
- Nayak in combination with Fadell
- Nayak in combination with Montemurro
- Nayak in combination with Royer
- Nayak in combination with Wyld
- Nayak in combination with Cole
- Nayak in combination with Freund
- Nayak in combination with Sharif-Ahmadi
- Abichandani in combination with Fadell
- Abichandani in combination with Montemurro
- Abichandani in combination with Royer
- Abichandani in combination with Wyld
- Abichandani in combination with Cole
- Abichandani in combination with Freund
- Abichandani in combination with Sharif-Ahmadi
- Fadell in combination with Montemurro
- Fadell in combination with Royer
- Fadell in combination with Wyld
- Fadell in combination with Cole
- Fadell in combination with Freund
- Fadell in combination with Sharif-Ahmadi
- Montemurro in combination with Royer
- Montemurro in combination with Wyld

- Montemurro in combination with Cole
- Montemurro in combination with Freund
- Montemurro in combination with Sharif-Ahmadi
- Royer in combination with Wyld
- Royer in combination with Cole
- Royer in combination with Freund
- Royer in combination with Sharif-Ahmadi
- Wyld in combination with Cole
- Wyld in combination with Freund
- Wyld in combination with Sharif-Ahmadi
- Cole in combination with Freund
- Cole in combination with Sharif-Ahmadi
- Freund in combination with Sharif-Ahmadi

b. Exemplary Motivations to Combine

Defendants have identified several exemplary motivations and reasons to combine the various references cited herein. For any reference for which there is a claim element that does not have a corresponding citation in that reference, it would be obvious to combine with the knowledge or a person of skill and/or any other reference in the primary or secondary charts for which there is a citation for that element. These combinations would have been obvious to try given that there were a finite number of identified, predictable solutions in the prior art, and there would have been a reasonable expectation of success to simply implement one prior art solution with concepts from prior art in the same field.

It would have been obvious to combine each of the references discussed below because they are analogous art generally directed to management of data usage by wireless devices. For example:

- A person of ordinary skill would have been motivated to combine Rao with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Rao with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Fadell, Montemurro, Royer, Wyld, Cole, Freund, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Rao discloses methods for “application-aware, client-specific prioritization of packet traffic” from a wireless device over a wireless network, and acknowledges that “[o]ne ordinarily skilled in the art will recognize and appreciate the multitude of ways to define client-side application priorities.” Rao at [0003], [0182]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Rao to provide a variety of means and methods for prioritization of application traffic over a wireless network.
- A person of ordinary skill would have been motivated to combine Nayak with the exemplary citations and commentary provided in Exhibit D to yield the claimed

invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Nayak with references that disclose management of data usage by wireless devices. (*see, e.g.*, Rao, Abichandani, Fadell, Montemurro, Royer, Wyld, Cole, Freund, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Nayak identifies the problem, in the context of receiving “contact information” from an application on a wireless device, that “[d]uring periods when the user is not interested in receiving the contact information, the receipt of contact presence information can increase data usage on the network, which can potentially cause congestion on the network.” Nayak at [0002]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Nayak to address the issue of wireless network congestion.

- A person of ordinary skill would have been motivated to combine Abichandani with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Abichandani with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Rao, Fadell, Montemurro, Royer, Wyld, Cole, Freund, and Sharif-Ahmadi). A person of ordinary skill would have been

motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Abichandani discloses methods for “for controlling access to mobile applications from the mobile device based on access conditions associated with a current access network” using “a policy or application access database.” Abichandani at [0004]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Abichandani given the substantial overlap in methods addressing congestion in wireless networks.

- A person of ordinary skill would have been motivated to combine Fadell with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Fadell with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Freund, Montemurro, Royer, Wyld, Cole, Rao, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Fadell discloses the use of a “resource utilization component” on an electronic device, such as a wireless device, “to adjust the resource consumption of the electronic device.”

Fadell at [0022]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Fadell given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Montemurro with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Montemurro with references that disclose management of data usage by wireless devices. (*see, e.g.*, Rao, Nayak, Abichandani, Fadell, Royer, Wyld, Cole, Freund, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Montemurro discloses methods “to optimize communications using a policy-based mechanism to configure connections and routes” over a wireless network, and highlights that these “[p]olicies may be responsive to various factors.” Montemurro at [0011]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Montemurro to provide a variety of means and methods for prioritization of application traffic over a wireless network.
- A person of ordinary skill would have been motivated to combine Royer with the

exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Royer with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Rao, Fadell, Montemurro, Abichandani, Wyld, Cole, Freund, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Royer discloses the use of an “activity manager and a communication processor” for “identifying activity associated with” applications and determining whether the “application is inactive.” *See* Royer at [0007]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Royer given the substantial overlap in methods addressing congestion in wireless networks.

- A person of ordinary skill would have been motivated to combine Wyld with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Wyld with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Fadell, Montemurro, Royer, Cole, Rao, Freund, and Sharif-Ahmadi). A person of ordinary skill would have been

motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Wyld discloses methods for monitoring “network activity of a client device that is coupled to a data network . . . to detect network activity idle time” and to signal when “background task[s]” are to “be executed over the data network.” Wyld at Abstract. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Wyld given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Cole with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Cole with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Fadell, Montemurro, Royer, Wyld, Rao, Freund, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Cole discloses the use of a “connection manager” to selectively permit applications to communicate over wireless networks based on classifications of the application and

available networks. Cole at [0036]. Indeed, Cole acknowledges that “the various protocols required” to implement the “connection manager” would be “known to those ordinary skill in the art.” *Id.* at [0035]. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Cole given their relevant disclosures related to client-side management of data usage by a wireless device.

- A person of ordinary skill would have been motivated to combine Freund with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Freund with references that disclose management of data usage by wireless devices. (*see, e.g.*, Nayak, Abichandani, Fadell, Montemurro, Royer, Wyld, Cole, Rao, and Sharif-Ahmadi). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Freund discloses methods for “client-based monitoring and filtering of access” using a “centralized enforcement supervisor.” Freund at Abstract. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Freund given their relevant disclosures related to client-side management of data usage by a wireless device.
- A person of ordinary skill would have been motivated to combine Sharif-Ahmadi

with the exemplary citations and commentary provided in Exhibit D to yield the claimed invention, and would have had a reasonable expectation of success in doing so. For example, a person of ordinary skill in the art would have been motivated to combine the teachings from Sharif-Ahmadi with references that disclose management of data usage by wireless devices. (*see, e.g.*, Rao, Nayak, Abichandani, Fadell, Montemurro, Royer, Wyld, Cole, and Freund). A person of ordinary skill would have been motivated to combine these references because they are directed to wireless communication systems, and specifically methods for managing wireless-device application access to wireless networks based on factors such as classification of the application and classification of the available wireless networks. For instance, Sharif-Ahmadi discloses the use of “network polic[ies]” that are “stored on the mobile device” that permit applications to communicate over a network “only if [they] meet[] the policy parameters as established by the network policy.” *See* Sharif-Ahmadi at Abstract. As such, a person of ordinary skill would have recognized that the exemplary teachings cited in Exhibit D could be combined with Sharif-Ahmadi given their relevant disclosures related to client-side management of data usage by a wireless device.

E. Obviousness – Secondary Considerations

A patentee bears the burden of production with respect to evidence of secondary considerations of non-obviousness. *ZUP, LLC v. Nash Mfg., Inc.*, 896 F.3d 1365, 1373 (Fed. Cir. 2018). As of the date of these Preliminary Invalidity Contentions, Headwater has not yet identified any evidence of secondary considerations. Defendants reserve all rights to further respond to any secondary considerations of non-obviousness raised by Headwater, including by updating, modifying, and/or adding to these Preliminary Invalidity Contentions. Defendants are not aware

of any unexpected results (none is mentioned in the Asserted Patents or their file histories), long felt need, commercial success (or any nexus to any allegedly successful commercial embodiment), or awards for the alleged inventions of the Asserted Patents.

F. P.R. 3-3(d): Invalidity Under 35 U.S.C. § 112

As set forth below, Defendants contend that the Asserted Claims are invalid under 35 U.S.C. § 112 because the claims (1) are indefinite; (2) fail to satisfy the enablement requirement; and/or (3) fail to satisfy the written description requirement.

Defendants' invalidity contentions for the Asserted Claims identified in this section are made in the alternative and do not constitute, and should not be interpreted as, admissions regarding the construction or scope of the Asserted Claims identified herein or that any of the Asserted Claims identified herein would not have been anticipated and/or obvious in light of the prior art.

Headwater has not yet provided a claim construction for any of the terms or phrases that Defendants anticipate will be in dispute. Defendants, therefore, cannot provide a complete list of § 112 defenses because Defendants do not know whether Headwater will proffer a construction for certain terms and phrases that is broader than, or inconsistent with, the construction that would be supportable by the disclosure set forth in the specification. Defendants offer these contentions without prejudice to any position they may ultimately take as to any claim construction issues.

Accordingly, Defendants reserve the right to supplement, amend, and/or modify these § 112 invalidity contentions as discovery progresses.

1. Invalidity Under 35. U.S.C. § 112, ¶ 1

Defendants allege that the Asserted Claims are invalid under 35 U.S.C. § 112 for failing to satisfy the written description and enablement requirements (Section 112, ¶ 1). Defendants reserve all rights to amend their Invalidity Contentions under 35 U.S.C. § 112, including after the Asserted Claims

are ultimately construed by the Court, in response to any interpretation of the Asserted Claims embodied in Headwater's infringement positions, and/or to account for any changes in the law concerning invalidity under 35 U.S.C. § 112. Defendants also reserve the right to provide additional explanation and/or argument for its Invalidity Contentions under Section 112, including, for example, based on expert testimony. Defendants' contentions that the Asserted Claims are invalid under Section 112 are not admissions regarding the construction or scope of the claims of the Asserted Patents, or that any of the claims of the Asserted Patents are not anticipated or rendered obvious by any prior art. All of the below statements are by way of example only. Any item disclosed below with respect to any patent or claim may, as appropriate, be asserted as a defense against any other patent or claim that has a similar claim limitation and patent disclosure.

35 U.S.C. § 112, ¶ 1 requires that the specification contain a written description of the invention. "[T]he hallmark of written description is disclosure." *Boston Scientific Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1361–62 (Fed. Cir. 2011) (citation omitted). The test for whether a specification adequately describes an invention is "whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date [T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art [It] is a question of fact." *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc); *Boston Scientific*, 647 F.3d at 1362.

The enablement requirement of Section 112 demands that the patent specification enable "those skilled in the art to make and use the full scope of the claimed invention without 'undue experimentation.'" *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993)). "[T]he scope of the claims must be

less than or equal to the scope of the enablement.” *Nat’l Recovery Tech., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1196 (Fed. Cir. 1999).

Defendants contend that the following Asserted Claims are invalid under 35 U.S.C. § 112, ¶ 1. Each Asserted Claim identified below (and each Asserted Claim that depends therefrom) is invalid under ¶ 1 because the specification of the Asserted Patent fails to provide a sufficient written description, enabling disclosure, and/or fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention the meaning of the term(s) and/or phrase(s). For each listed term or phrase, Defendants believe the term or phrase is invalid under § 112, ¶ 1, as is any limitation including such terms or phrases, for the same reason(s).

Defendants further contend that Headwater’s apparent claim constructions render the Asserted Claims extremely broad in scope and well beyond the purported inventions described in the Asserted Patents. Based on a review of Headwater’s Infringement Contentions, Headwater is attempting to construe the Asserted Patents in an idiosyncratic manner that is entirely inconsistent with the written specifications and prosecution histories of the Asserted Patents as well as with the understanding of one of ordinary skill in the art at the time the applications that issued as the Asserted Patents were filed. These allegations are inconsistent with the plain language of the claims, the supporting description, and the prosecution history.

The Asserted Claims are invalid because the specifications of the Asserted Patents do not include sufficient written description of the purported inventions allegedly claimed in the Asserted Patents, and the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use any of the allegedly claimed inventions, 35 U.S.C. § 112, ¶ 1.

Moreover, the patent applications that issued as the Asserted Patents did not contain a written description of the purported invention sufficiently clear and complete to enable one of ordinary skill in the art to which the purported invention pertains to make and use the invention as claimed without undue experimentation. *Id.* To the extent any of the Asserted Claims are found to cover one or more of the accused products identified in Headwater’s Infringement Contentions, such Asserted Claims are also invalid under 35 U.S.C. § 112, ¶ 1 because their full scope is not enabled by the specifications of the relevant Asserted Patents.

a. U.S. Patent No. 8,589,541

Defendants contend that the full scope of each Asserted Claim of the ’541 Patent is not described with particularity in the specification to which priority is sought, so as not to set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed. Accordingly, each Asserted Claim of the ’541 Patent is invalid for lack of adequate written description and/or enablement under 35 U.S.C. § 112, ¶ 1, based at least on the following claim terms/phrases:

- “prospective or successful communication” (all Asserted Claims)
- “background activity” (all Asserted Claims)
- “an aspect of a policy” (all Asserted Claims)
- “information from a network element” (all Asserted Claims)
- “the policy at least for controlling the service usage activity” (all Asserted Claims)
- “operating system function identifier” (claim 8)
- “cooperation between the first software component and” (claims 9 and 16, dependents)
- “performs a proxy function” (claims 10 and 11, and dependents)

- “proxy service” (claims 13, 14, and 23, and dependents)
- “user interface foreground” (claim 45, and dependents)
- “foreground activity” (claim 49, and dependents)
- “foreground component” (claims 50 and 56, and dependents)
- “provide second information to the first software component” (claim 65, and dependents)
- “provide third information to a second software component” (claim 67, and dependents)
- “notification” (claims 77, 78, 91, 118, 149, and dependents)

Further, under at least the claim interpretations upon which Headwater apparently relies for its infringement assertions, the Asserted Claims would be invalid for failure to satisfy the written description and/or enablement requirements because they would be drawn to subject matter that exceeds or otherwise differs from that which one of ordinary skill in the art would understand the named inventors to have had in their possession. Headwater’s infringement allegations require numerous claim terms to be interpreted more broadly than the Asserted Patents disclose or enable. A person of skill in the art, upon reviewing the patents and the claims, would not consider the technology that Plaintiff seeks to cover in its infringement contentions to be in the possession of the inventors.

b. U.S. Patent No. 8,924,543

Defendants contend that the full scope of each Asserted Claim of the ’543 Patent is not described with particularity in the specification to which priority is sought, so as not to set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed. Accordingly, each Asserted Claim of the

'543 Patent is invalid for lack of adequate written description and/or enablement under 35 U.S.C.

§ 112, ¶ 1, based at least on the following claim terms/phrases:

- “network service plan provisioning system” (all Asserted Claims)
- “service plan component” (all Asserted Claims)
- “traffic classification filter” (all Asserted Claims)
- “characteristic” (all Asserted Claims)
- “network traffic inspection system” (all Asserted Claims)
- “network policy enforcement system” (all Asserted Claims)
- “network inspection provisioning instructions” (all Asserted Claims)
- “order traffic inspection comparison operations” (claim 2 and dependents)
- “determine whether the traffic event possesses the characteristic that matches the first traffic classification filter before determining whether the traffic event possesses the characteristic that matches the second traffic classification filter” (claims 2, 5, 36 and dependents)
- “determine whether the traffic event possesses the characteristic that matches the second traffic classification filter only if the traffic event does not possess the characteristic that matches the first traffic classification filter” (claim 3 and dependents)
- “determine whether the traffic event also possesses the characteristic that matches the second traffic classification filter if the traffic event possesses the characteristic that matches the first traffic classification filter” (claim 4 and dependents)
- “service buy page notification” (claim 16 and dependents)

- “the first service plan component further comprises an additional policy enforcement action to augment the first policy enforcement action, and wherein the second service plan component further comprises the additional policy enforcement action to augment the second policy enforcement action” (claim 22)
- “the first service plan component further comprises an additional policy enforcement action to over-ride the first policy enforcement action, and wherein the second service plan component further comprises the additional policy enforcement action to over-ride the second policy enforcement action” (claim 23)
- “composite-plan policy” (claims 28 and 29 and dependents)
- “to enforce the first network policy enforcement action when the traffic event possesses both the characteristic that matches the first traffic classification filter and the characteristic that matches the second traffic classification filter” (claim 30)
- “one or more second instructions directing the network policy enforcement system to enforce only the first network policy enforcement action when the traffic event possesses the characteristic that matches the first traffic classification filter” (claim 31)
- “directing the network policy enforcement system to enforce the first network policy enforcement action and the second network policy enforcement action when the traffic event possesses both the characteristic that matches the first traffic classification filter and the characteristic that matches the second traffic classification filter” (claim 32)
- “the first traffic classification filter is applied to the traffic event before the second traffic classification filter is applied to the traffic event” (claim 33)

- “one or more policy enforcement provisioning instructions so that the network policy enforcement system applies the first policy enforcement action before applying the second policy enforcement action” (claim 37)
- “when the traffic event possesses the characteristic that matches the first traffic classification filter, the network policy enforcement system applies the first policy enforcement action, and the network traffic inspection system does not determine whether the traffic event possesses the characteristic that matches the second traffic classification filter” (claim 38)
- “when the network traffic inspection system determines that the traffic event possesses the characteristic that matches the first traffic classification filter and the characteristic that matches the second traffic classification filter, the network policy enforcement system applies the first policy enforcement action but does not apply the second policy enforcement action” (claim 40)
- “when the network traffic inspection system determines that the traffic event possesses the characteristic that matches the first traffic classification filter and the characteristic that matches the second traffic classification filter, the network policy enforcement system applies the first policy enforcement action before applying the second policy enforcement action” (claim 41)
- “policy decision element (claim 42)
- “gateway” (claim 43)
- “programmable element” (claim 46)

Further, under at least the claim interpretations upon which Headwater apparently relies for its infringement assertions, the Asserted Claims would be invalid for failure to satisfy the

written description and/or enablement requirements because they would be drawn to subject matter that exceeds or otherwise differs from that which one of ordinary skill in the art would understand the named inventors to have had in their possession. Headwater's infringement allegations require numerous claim terms to be interpreted more broadly than the Asserted Patents disclose or enable. A person of skill in the art, upon reviewing the patents and the claims, would not consider the technology that Plaintiff seeks to cover in its infringement contentions to be in the possession of the inventors.

c. U.S. Patent No. 9,198,042

Defendants contend that the full scope of each Asserted Claim of the '042 Patent is not described with particularity in the specification to which priority is sought, so as not to set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed. Accordingly, each Asserted Claim of the '042 Patent is invalid for lack of adequate written description and/or enablement under 35 U.S.C. § 112, ¶ 1, based at least on the following claim terms/phrases:

- “determining, based on the report, that a particular service policy setting of the wireless end-user device needs to be modified” (all Asserted Claims)
- “service policy setting configured to assist in controlling one or more communications associated with the wireless end-user device over the wireless access network” (all Asserted Claims)
- “configuration information” (all Asserted Claims)
- “the configuration information configured to assist in modifying or allowing modifications to the particular service policy setting” (all Asserted Claims) “service usage measure” (claims 6 and 7)

- “an action” (claim 6 and dependents)
- “encryption protocol” (claim 13)

Further, under at least the claim interpretations upon which Headwater apparently relies for its infringement assertions, the Asserted Claims would be invalid for failure to satisfy the written description and/or enablement requirements because they would be drawn to subject matter that exceeds or otherwise differs from that which one of ordinary skill in the art would understand the named inventors to have had in their possession. Headwater’s infringement allegations require numerous claim terms to be interpreted more broadly than the Asserted Patents disclose or enable. A person of skill in the art, upon reviewing the patents and the claims, would not consider the technology that Plaintiff seeks to cover in its infringement contentions to be in the possession of the inventors.

d. U.S. Patent No. 9,215,613

Defendants contend that the full scope of each Asserted Claim of the ’613 Patent is not described with particularity in the specification to which priority is sought, so as not to set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed. Accordingly, each Asserted Claim of the ’613 Patent is invalid for lack of adequate written description and/or enablement under 35 U.S.C. § 112, ¶ 1, based at least on the following claim terms/phrases:

- “differential traffic control policy list” (all Asserted Claims)
- “differential traffic control policy” (all Asserted Claims)
- “an interface to allow a user to augment the differential traffic control policy for the first one or more applications but not for the second one or more applications and/or services” (all Asserted Claims)
- “classify” (all Asserted Claims)

- “classifications” (all Asserted Claims)
- “user interface foreground” (all Asserted Claims)
- “to augment the differential traffic control policy” (all Asserted Claims)
- “user augmentation” (all Asserted Claims)
- “one or more processors configured to classify a wireless network to which the device currently connects in order to communicate data for Internet service activities as at least one of a plurality of network types that the device can connect with, classify whether a particular application capable of both interacting with the user in a user interface foreground of the device, and at least some Internet service activities when not interacting with the user in the device user interface foreground, is interacting with the user in the device user interface foreground,” (all Asserted Claims)
- “directly interacting with that application or perceiving any benefit from that application” (claim 6)
- “information regarding why the differential traffic control policy is applied to the particular application” (claim 7)
- “dynamically change the application of the differential traffic control policy based on a power state of the device” (claim 15)
- “dynamically change the application of the differential traffic control policy based on a device usage state” (claim 16)
- “dynamically change the application of the differential traffic control policy based on power control state changes for one or more of the modems” (claim 17)
- “foreground services” (claim 22)

Further, under at least the claim interpretations upon which Headwater apparently relies for its infringement assertions, the Asserted Claims would be invalid for failure to satisfy the written description and/or enablement requirements because they would be drawn to subject matter that exceeds or otherwise differs from that which one of ordinary skill in the art would understand the named inventors to have had in their possession. Headwater's infringement allegations require numerous claim terms to be interpreted more broadly than the Asserted Patents disclose or enable. A person of skill in the art, upon reviewing the patents and the claims, would not consider the technology that Plaintiff seeks to cover in its infringement contentions to be in the possession of the inventors.

2. Invalidity Under 35 U.S.C. § 112, ¶ 2

Claims are indefinite under 35 U.S.C. § 112, ¶ 2 when they “fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 34 S. Ct. 2120, 2124 (2014). To the extent an asserted apparatus claim includes both apparatus and method limitations, that claim is invalid for indefiniteness under § 112, ¶ 2 because it fails to identify or notify the public of what constitutes direct infringement. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005). Similarly, a claim that uses means-plus function claiming is indefinite “[i]f the patentee fails to disclose adequate corresponding structure.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1352 (Fed. Cir. 2015). A claim can also be found indefinite if it uses terms of degree. *See Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014). As the Federal Circuit has “explained, a term of degree fails to provide sufficient notice of its scope if it depends ‘on the unpredictable vagaries of any one person’s opinion.’” *Id.* (citation omitted). In addition, “a claim term that lacks an antecedent basis may . . . render a claim indefinite.” *In re Downing*, 754 F. App’x 988, 996 (Fed. Cir. 2018).

Defendants identify the following claims terms as indefinite under 35 U.S.C. § 112, ¶ 2:

- “prospective or successful communications” (’541 Patent, all Asserted Claims)

- “to augment the differential traffic control policy” (’613 Patent, all Asserted Claims)
- “user augmentation” (’613 Patent, all Asserted Claims)
- “one or more processors configured to classify a wireless network to which the device currently connects in order to communicate data for Internet service activities as at least one of a plurality of network types that the device can connect with, classify whether a particular application capable of both interacting with the user in a user interface foreground of the device, and at least some Internet service activities when not interacting with the user in the device user interface foreground, is interacting with the user in the device user interface foreground,” (’613 Patent, all Asserted Claims)

In addition to Defendants’ reservation of rights stated above, Defendants will present arguments as to indefiniteness will be presented at that time, i.e., through the *Markman* meet and confer and briefing process. Defendants reserve the right to assert that any of the Asserted Claims of any Asserted Patent is invalid under Section 112, ¶ 2 in the event that Headwater proposes, or the Court adopts, and claim construction that would cause any claim term to fail to inform, with reasonable certainty, those skilled in the art about the scope of the claimed invention.

G. Obviousness-Type Double Patenting

As the Federal Circuit explained in *In re Hubbell*, obviousness-type double patenting has two separate and independent rationales:

There are two justifications for obviousness-type double patenting. The first is “to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about.” The second rationale is to prevent multiple infringement suits by different assignees asserting essentially the same patented invention.

In re Hubbell, 709 F.3d 1140, 1145 (Fed. Cir. 2013).

The obviousness-type double patenting analysis is a two-step process. First, the differences between the claims of the patent being used as a reference and the claims at issue are identified. *Georgia-Pacific v. US Gypsum*, 195 F.3d 1322, 1326 (Fed. Cir. 1999) (“[A]nalysis of the claims at issue is the first step in determining if the second invention is merely an obvious variation of the first Because these two claims are so similar, we must look to see if there is anything to distinguish claim 1 of the ’989 patent from claim 1 of the ’569 patent. There are two differences between these claims.”), *opinion amended on rehearing*, 204 F.3d 1359 (Fed. Cir. 2000).

Second, whether those differences raise a patentable distinction must be determined. *Georgia-Pacific*, 195 F.3d at 1328 (finding that “[t]hese differences are not sufficient to render the claims patentably distinct”). “A later patent claim ‘is not patentably distinct from an earlier claim if the later claim is obvious over, or anticipated by, the earlier claim.’” *Hubbell*, 709 F.3d at 1145 (quoting *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 968 (Fed. Cir. 2001)).

A patentee can avoid obviousness-type double patenting issues by filing a terminal disclaimer in the Patent Office. *See In re Goodman*, 11 F.3d 1046, 1052 (Fed. Cir. 1993) (“[T]he patentee may overcome the double patenting rejection by filing a terminal disclaimer.”); 37 C.F.R. § 1.321(c) (indicating that a terminal disclaimer can be filed “to obviate judicially created double patenting in a patent application or in a reexamination proceeding”); MPEP § 804.02 (“A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made.”). A terminal disclaimer filed to overcome an obviousness-type double patenting rejection is effective only where the application and conflicting patent are commonly owned. *Hubbell*, 709 F.3d at 1148–49.

Defendants contend that the Asserted Claims of the ’042 Patent are invalid due to obviousness-type double patenting over other patents filed by Headwater or its predecessors,

including U.S. Patent No. 10,694,385. U.S. Patent No. 10,694,385 were not cited during the prosecution of the '042 Patent, and no obviousness-type double patenting rejection based on U.S. Patent No. 10,694,385 was made during prosecution. Accordingly, no terminal disclaimers were filed in the Patent Office during prosecution of the '042 Patent.

U.S. Patent No. 10,694,385 was filed by the same inventive entity as the '042 Patent and the claims of the U.S. Patent No. 10,694,385 expire prior to the claims of the '042 Patent. Thus, the claims of the '042 Patent should have been rejected by the Examiner during prosecution for obviousness-type double patenting over the claims of U.S. Patent No. 10,694,385. *See* MPEP § 804.

H. Ineligibility Under 35 U.S.C. § 101

Defendants contend that the Asserted Claims do not qualify as patent-eligible subject matter and are therefore invalid under 35 U.S.C. § 101. Defendants incorporate by reference their Subject Matter Ineligibility Contentions and all exhibits served herewith.

III. ACCOMPANYING DOCUMENT PRODUCTION

Pursuant to P.R. 3-4(a), Defendants are producing documentation sufficient to show the operation of any aspects or elements of the Accused Instrumentalities identified by Headwater in its P.R. 3-1(c) charts. Defendants will promptly produce any additional such documents uncovered during discovery, including through third-party subpoenas.

Additionally, pursuant to P.R. 3-4(b), Defendants are producing herewith a copy of each prior art reference identified above pursuant to P.R. 3-3(a) which does not appear in the file histories of the Asserted Patents, as well as additional prior art references. To the extent any such prior art reference is not in English, Defendants have produced to Plaintiff or will produce to Plaintiff an English translation of the portion(s) of the non-English prior art reference(s) relied.

Dated: February 2, 2024.

McKool Smith, P.C.

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**ATTORNEY FOR AT&T SERVICES
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing document has been served on all counsel of record via email on February 2, 2024.

/s/ Nicholas Mathews

Nicholas Mathews