

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
VERIZON CORPORATE SERVICES GROUP INC.,
T-MOBILE USA, INC., AT&T SERVICES, INC.,
AT&T MOBILITY LLC, AND AT&T CORP.,
Petitioner,

v.

HEADWATER PARTNERS I LLC,
Patent Owner.

Case IPR2024-00809
Patent 9,198,042 B2

PATENT OWNER'S PRELIMINARY SUR-REPLY

PATENT OWNER'S EXHIBIT LIST

No.	Description
Ex. 2001	Declaration of Erik de la Iglesia in Support of Patent Owner's Preliminary Response
Ex. 2002	<i>Curriculum Vitae</i> of Erik de la Iglesia
Ex. 2003	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00397 (lead case), No. 2:23-cv-00398 (member case), Docket Control Order, Dkt. No. 41 (E.D. Tex. Dec. 27, 2023)
Ex. 2004	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00398, Consolidation Order, Dkt. No. 25 (E.D. Tex. Nov. 2, 2023)
Ex. 2005	<i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00379 (lead case), Docket Control Order, Dkt. No. 42 (E.D. Tex. Dec. 27, 2023)
Ex. 2006	Federal Court Management Statistics, Eastern District of Texas, 2018-2023
Ex. 2007	<i>Headwater Research LLC v. Cellco Partnership d/b/a Verizon Wireless et al.</i> , No. 2:23-cv-00352, Complaint for Patent Infringement, Dkt. No. 1 (E.D. Tex. July 28, 2023)
Ex. 2008	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00398, Complaint for Patent Infringement, Dkt. No. 1 (E.D. Tex. Sept. 1, 2023)
Ex. 2009	<i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00379, Complaint for Patent Infringement, Dkt. No. 1 (E.D. Tex. Aug. 23, 2023)
Ex. 2010	<i>Headwater Research LLC v. Cellco Partnership d/b/a Verizon Wireless et al.</i> , No. 2:23-cv-00352, Cellco Partnership d/b/a Verizon Wireless Proof of Service, Dkt. No. 7 (E.D. Tex. Aug. 3, 2023)
Ex. 2011	<i>Headwater Research LLC v. Cellco Partnership d/b/a Verizon Wireless et al.</i> , No. 2:23-cv-00352, Verizon Corporate Services Group Inc. Proof of Service, Dkt. No. 8 (E.D. Tex. Aug. 7, 2023)
Ex. 2012	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00398, AT&T Services, Inc. Proof of Service, Dkt. No. 18 (E.D. Tex. Sept. 14, 2023)

No.	Description
Ex. 2013	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00398, AT&T Corp. Proof of Service, Dkt. No. 19 (E.D. Tex. Sept. 14, 2023)
Ex. 2014	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00398, AT&T Mobility LLC Proof of Service, Dkt. No. 20 (E.D. Tex. Sept. 22, 2023)
Ex. 2015	<i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00379 (lead case), T-Mobile USA, Inc. Proof of Service, Dkt. No. 7 (E.D. Tex. Sept. 1, 2023)
Ex. 2016	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00397 (lead case), No. 2:23-cv-00398 (member case), Plaintiff Headwater Research LLC's Disclosure of Asserted Claims and Infringement Contentions (E.D. Tex. served Nov. 20, 2023)
Ex. 2017	<i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00379 (lead case), Plaintiff Headwater Research LLC's Disclosure of Asserted Claims and Infringement Contentions (E.D. Tex. served Nov. 20, 2023)
Ex. 2018	<i>Headwater Research LLC v. Cellco Partnership d/b/a Verizon Wireless et al.</i> , No. 2:23-cv-00352, Defendants' P.R. 3-3 Invalidity Contentions (E.D. Tex. served Dec. 21, 2023)
Ex. 2019	<i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00397 (lead case), No. 2:23-cv-00398 (member case), Defendants' Preliminary Invalidity Contentions (E.D. Tex. served Feb. 2, 2024)
Ex. 2020	<i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00379 (lead case), Defendants' P.R. 3-3 Invalidity Contentions (E.D. Tex. served Jan. 16, 2024)
Ex. 2021	Prince McLean, <i>AT&T Defends Its Data Network from Verizon Ad Attacks</i> , AppleInsider.com, Nov. 10, 2009, https://appleinsider.com/articles/09/11/10/att_defends_its_data_network_from_verizon_ad_attacks
Ex. 2022	Johnny Casey, <i>Alexander Residents Challenge Verizon's Proposed Plans to Build Cell Tower</i> , Citizen Times, June 29, 2021, https://www.citizen-times.com/story/news/madison/2021/06/28/

No.	Description
	alexander-residents-raise-concerns-proposed-verizon-cell-tower/5330311001/
Ex. 2023	AT&T 3G Data Plans for Apple iPad, <i>available at</i> https://www.att.com/Common/about_us/files/pdf/emerging_devices/iPad_fact_sheet_081210.pdf
Ex. 2024	Network Management Practices, T-Mobile, https://www.t-mobile.com/home-internet/policies/internet-service/network-management-practices (last visited July 25, 2024)
Ex. 2025	Add or Remove AT&T Turbo, AT&T, https://www.att.com/support/article/wireless/000100296/ (last visited July 25, 2024)
Ex. 2026	Headwater Preliminary Infringement Contentions '042 Patent Claim Chart, served on Petitioner Verizon on Jan. 12, 2024
Ex. 2027	Headwater Preliminary Infringement Contentions '042 Patent Claim Chart, served on Petitioner T-Mobile on Mar. 19, 2024
Ex. 2028	Headwater Preliminary Infringement Contentions '042 Patent Claim Chart, served on Petitioner AT&T on Nov. 20, 2023
Ex. 2029	Email from Amy Wann (Judge Gilstrap's law clerk), dated Sept. 17, 2024
Ex. 2030	<i>Headwater Research LLC v. Samsung Electronics Co. et al.</i> , No. 2:22-cv-00422, Samsung's Opposed Motion for Continuance, Dkt. No. 372 (E.D. Tex. July 17, 2024)
Ex. 2031	<i>Headwater Research LLC v. Samsung Electronics Co. et al.</i> , No. 2:22-cv-00422, Order Granting Samsung's Opposed Motion for Continuance, Dkt. No. 406 (E.D. Tex. Aug. 8, 2024)

It is undisputed neither party has requested a stay of any parallel litigation or indicated an intent to do so (Factor 1); the district court trials are scheduled to occur approximately five months after the final written decision in this proceeding (Factor 2); claim construction will be nearing completion and significant discovery will have occurred by the time of an institution decision, and Petitioners filed the Petition over eight months after being served with the first district court complaint (Factor 3); all claims asserted in the district court litigations are challenged in the Petition, and Petitioners do not offer a *Sotera* stipulation (Factor 4); and Petitioners are defendants in the parallel litigations (Factor 5). *See* POPR at 11-21.

In the wake of those facts, Petitioners now advance a weak stipulation that does not quell concerns of overlap with parallel litigation (Reply at 1), present the unremarkable fact there are additional claims challenged in the Petition as compared with those asserted in district court (*id.* at 1-2), and offer rank speculation about trial dates unsupported by any evidence (*id.* at 2-3). Each of these arguments should be rejected and the Board should exercise its discretion to deny institution.

First, despite offering only a *Sand Revolution* stipulation in the Petition, Petitioners now “stipulate[e] that they will not pursue invalidity challenges in this district court litigation on the ground or the prior art references asserted in the Petition.” Reply at 1. They are agreeing to far less than the natural consequences of this IPR proceeding to a final written decision. *See, e.g., Cal. Inst. of Tech. v.*

Broadcom Ltd., 25 F.4th 976, 991 (Fed. Cir. 2022) (“overrul[ing] *Shaw* and clarifying that estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition”). Moreover, further weakening the impact of the stipulation, Petitioners admit in invalidity contentions that art they do intend to rely on such as Hamasaki, Pearce, Aarnos, and Cassett has similar disclosures as their IPR primary reference, Limont. *See* Ex. 2018 at 43-46; Ex. 2019 at 67-70; Ex. 2020 at 55-58.

Second, it is immaterial that additional claims are challenged here as compared with the district court proceeding in part due to the parties streamlining the case for trial. It is of course commonplace and necessary that the parties do so. Moreover, the additional challenged claims are merely dependent claims against which the Petition applies the same prior references as it does against those claims that are asserted in the parallel litigation; the additional challenged claims thus do not present entirely different issues than those that will be decided by the district court. Thus, “although the challenged claims asserted in this proceeding may not be identical to those the parties elect to pursue at trial in the underlying litigation, the differences do not appear to be meaningful in this case.” *Google LLC v. Agis Software Dev.*, IPR2020-00871, Paper 16 at 14-16 (PTAB Nov. 25, 2020), *reh’g denied*, Paper 27 (PTAB Jan. 26, 2022); *see* POPR at 18-19.

Third, the Board routinely declines to engage in speculation about whether a set trial date will move without any evidence that is the case. *See, e.g., Nine Energy Serv. Inc. v. NCS Multistage Inc.*, IPR2020-01615, Paper 18 at 9 (PTAB Mar. 24, 2011) (“[B]ased on the evidence of record, there is no evidence to suggest trial will be delayed.”); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 17 at 9 (PTAB May 2, 2022) (“We generally take courts’ trial schedules at face value absent some strong evidence to the contrary.”); POPR at 15-16.

Petitioners present no such evidence here, let alone strong evidence, but rather engage in rank speculation about what may happen in the parallel litigations based on a trial date needing to be changed in an entirely unrelated case, *Headwater Research LLC v. Samsung Electronics Co. et. al.*, No. 2:22-cv-00422-JRG-RSP (E.D. Tex.). And even if that unrelated case were relevant here, Petitioners are simply incorrect that trial in that case has been “indefinitely delayed.” Reply at 2. Rather, the district court has indicated that it is anticipated that case will be set for trial in December of this year. Ex. 2022 at 1. And in that case, Samsung moved to continue the August 16, 2024 trial, alleging their counsel and experts had conflicts with that date and all possible dates prior to October 28, 2024. Ex. 2023. The district court granted the continuance due to those conflicts, and is in the process of resetting this case for a near-term trial date. Ex. 2024. Petitioners present no similar facts or evidence of conflicts or any reason the trial date should move here.

Date: October 15, 2024

Respectfully submitted,

/Amy E. Hayden/

Reza Mirzaie, Reg. No. 69,138

Marc A. Fenster, *pro hac vice* forthcoming

Dale Chang, Reg. No. 61,476

Amy E. Hayden, Reg. No. 64,817

Neil A. Rubin, Reg. No. 67,030

Philip X. Wang, Reg. No. 74,621

James A. Milkey, Reg. No. 79,503

RUSS, AUGUST & KABAT

12424 Wilshire Blvd., 12th Floor

Los Angeles, CA 90025

Counsel for Patent Owner

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

The undersigned hereby certifies that the above document was served on October 15, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

Patrick D. McPherson (Reg. No. 46,255)
Kevin P. Anderson (Reg. No. 43,471)
DUANE MORRIS LLP
901 New York Avenue N.W., Suite 700 East
Washington, DC 20001
PDMcPherson@duanemorris.com
kpanderson@duanemorris.com

Date: October 15, 2024

/Amy E. Hayden/
Reza Mirzaie, Reg. No. 69,138
Marc A. Fenster, *pro hac vice* forthcoming
Dale Chang, Reg. No. 61,476
Amy E. Hayden, Reg. No. 64,817
Neil A. Rubin, Reg. No. 67,030
Philip X. Wang, Reg. No. 74,621
James A. Milkey, Reg. No. 79,503
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025

Counsel for Patent Owner