UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
VERIZON CORPORATE SERVICES GROUP INC.,
T-MOBILE USA, INC., SPRINT LLC F/K/A SPRINT CORP.,
AND AT&T SERVICES, INC.,

Petitioners,

v.

Headwater Research LLC,

Patent Owner.

Case: IPR2024-00944

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

PETITIONERS' NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR U.S. PATENT NO. 8,589,541

Petitioners are filing three concurrent Petitions challenging the validity of all 174 claims of U.S. Patent 8,589,541 ("the '541 Patent"). Patent Owner's continued assertion, over the Defendant-Petitioners'[1] objections, of *all 174 claims* in parallel district court proceedings necessitates these multiple filings. Those 174 claims include a single independent claim 1. All other claims depend from claim 1, and the claims total 8,059 words. Petitioners have therefore challenged an average of 58 claims (and 2,686 words) per Petition and have made every effort to minimize the burden upon the Board and parties by confining their analysis to three Petitions. The grounds raised have never been before the Office; all 174 claims were allowed without substantive action. Petitioners submit that institution of all three Petitions is warranted in this exceptional case.

Nonetheless, and pursuant to the November 2019 Trial Practice Guide Update, Petitioners provide: "(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions." PTAB Consolidated Trial Practice Guide, 59-61 (Nov. 2019) ("Consolidated TPG").

[1] Petitioner Google LLC is not a named defendant in the district court proceedings.

I. Ranking of Petitions

All three Petitions are meritorious and justified, especially because they are necessary to adequately address Patent Owner's 174 asserted claims. EX-1020; EX-1021; EX-1022. With the sole exception of independent claim 1, Petitioners address each claim only once across all three petitions. To the extent required by the Consolidated TPG, Petitioners request that the Board consider the Petitions in the following order:

Rank	Case No.	Applied References	Challenged Claims
1	IPR2024-00942 ("First Petition")	Rao, Fadell, Freund	1-23, 26, 41-60, 63, 64, 155-157, 160-171
2	IPR2024-00943 ("Second Petition")	Rao, Fadell, Freund	1, 91-152, 158, 159
3	IPR2024-00944 ("Third Petition")	Rao, Fadell, Freund	1, 24, 25, 27-40, 61, 62, 65-90, 153, 154, 172-174

II. Material Differences that Compel Permitting Multiple Petitions

The '541 patent and the circumstances of this case make multiple petitions particularly appropriate here. The Consolidated TPG recognizes that multiple petitions are appropriate where "the patent owner has asserted a large number of claims." Consolidated TPG at 59. Here, Patent Owner asserts all 174 claims in the co-pending litigations, despite Defendant-Petitioners' objections and related motion practice in the district court. *See* Defendants' Motion to Focus Patent Claims, *Headwater Research LLC v AT&T Inc.*, No. 2:23-cv-00397 (E.D. Tex. Apr. 11, 2024), ECF No. 53 (EX-1020); Defendants' Motion to Focus Patent Claims,

Headwater Research LLC v. T-Mobile USA, Inc., No. 2:23-cv-00379 (E.D. Tex Apr. 30, 2024), ECF No. 58 (EX-1021); Defendants' Motion to Focus Patent Claims, *Headwater Research LLC v Verizon Commc'ns. Inc.*, No. 2:23-cv-00352 (E.D. Tex. May 1, 2024), ECF No. 63 (EX-1022). In two cases, the Court has required some narrowing, but in both, that narrowing will begin only with claim construction briefing in October, after the bar imposed by § 315(b) has passed. Order, *Headwater Research LLC v AT&T Inc.*, No. 2:23-cv-00397 (E.D. Tex. June 6, 2024), ECF No. 61; Order, *Headwater Research LLC v Verizon Commc'ns. Inc.*, No. 2:23-cv-00352 (E.D. Tex. May 29, 2024), ECF No. 68; 35 U.S.C. § 315(b).[2] Given Patent Owner's enormous number of asserted claims, Petitioners cannot fit all challenges into one 14,000 word petition (again, the claims themselves exceed 8,000 words). Indeed, Petitioners have expended considerable resources to fit their challenge into three-petitions.

The Board has instituted review based on multiple petitions where even fewer claims were challenged and asserted in co-pending litigation. *See, e.g.*, *Samsung Elecs. Am., Inc. v. Snik LLC*, IPR2020-01429, Paper 10 at 12-13 (PTAB Mar. 9, 2021) (granting three petitions filed against 55 claims where 52 claims were asserted

[2] Defendant-Petitioners T-Mobile USA, Inc.'s and Sprint LLC f/k/a Sprint Corp.'s motion remains pending. *See* EX-1021.

in the related district court litigation); *Align Tech., Inc., v. 3Shape A/S*, IPR2021-01309, Paper 11 at 11-13 (PTAB Feb 9, 2022) (granting two petitions filed against 17 claims where 9 claims were asserted in the related district court litigation). Patent Owner has asserted far more claims here, warranting three petitions.

Further, each Petition is materially distinguishable from the others because it challenges a unique claim set. The First Petition challenges claims 1-23, 26, 41-60, 63, 64, 155-157, and 160-171. The Second Petition challenges claims 1, 91-152, 158, and 159. The Third Petition challenges claims 1, 24, 25, 27-40, 61, 62, 65-90, 153, 154, and 172-174. The only overlapping challenged claim (independent claim 1) is required in each Petition to establish the necessary foundation for challenging the remaining dependent claims. Moreover, claim 1 is briefed in a substantively identical manner across all three petitions, and thus the overlap of claim 1 does not create any additional burden on the Board or parties. Beyond that, all other challenged claims are addressed in only one of the three petitions. *See, e.g.*, *Align Tech., Inc.*, Paper 11 at 11-13 (granting two petitions filed against a common independent claim and different respective subsets of 19 dependent claims). Thus, this is *not* a case where a Petitioner files multiple petitions to assert alternative grounds against the challenged claims. Instead, Petitioners challenge each dependent claim only once, and Petitioners' multiple petitions are necessitated solely by the number and length of the asserted claims.

The Board should exercise its discretion to institute all three Petitions because they are necessary to analyze all 174 asserted claims in enough detail to afford the Board a meaningful opportunity to assess the grounds presented. The Petitions are not redundant or duplicative because each Petition challenges different claims. Instituting less than all three Petitions would give Patent Owner an unfair advantage and unduly reward its burdensome assertion of a large number of claims in the parallel litigations. This would further incentivize future patent owners to assert unreasonably large numbers of claims in future litigations, with the hopes of avoiding IPR. Moreover, because the Petitions are filed simultaneously, the Board and Patent Owner will be able to track the same schedule post-institution, maximizing the efficiency of depositions, briefing, and oral argument. In addition, Petitioners use the same expert witness (and a single declaration) to support all three Petitions, meaning a single deposition should be sufficient.

For each of these reasons, Petitioners respectfully request institution of all three of their concurrently filed IPR petitions against the ’541 patent.

Dated: June 7, 2024

By: /Erika H. Arner/
Erika H. Arner (Reg. No. 57,540)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on June 7, 2024, a copy of the foregoing **Petitioners' Notice Ranking Petitions and Explaining Material Differences Between Petitions for U.S. Patent No. 8,589,541** was served by FedEx Priority Overnight on the correspondence address of record indicated in the Patent Office's public Patent Center system for U.S. Patent No. 8,589,541:

Dr. Greg Raleigh
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Dated: June 7, 2024

By: /William Esper/
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