

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.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2024-00944
Patent 8,589,541 B2

Before HYUN J. JUNG, SCOTT B. HOWARD, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On October 31, 2024, a conference call was held among counsel for the parties and Judges Jung, Howard, and Belisle. Petitioner arranged for a court reporter and a transcript of the call has been entered into the record as Exhibit 1023 (“Tr.”).

Petitioner requested leave to file a Reply to the Patent Owner Preliminary Response. Under 37 C.F.R. § 42.108(c), such a request “must make a showing of good cause.” 37 C.F.R. § 42.108(c) (2023).

Specifically, Petitioner requests a four-page reply to the Preliminary Response to address Patent Owner’s arguments presented in its Preliminary Response regarding: (1) discretionary denial of institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) in light of the parallel litigations (“the *Fintiv* issues”); and (2) Petitioner’s challenge to claims 79 and 83.

Patent Owner does not oppose Petitioner’s request for a reply with respect to the *Fintiv* issues. Tr. 7:7–20.

With regard to claims 79 and 83, Petitioner argues that although the challenged ’541 patent has 174 claims, Patent Owner did not limit its asserted claims in the underlying district court litigation until after the deadline for filing a petition for *inter partes* review. Tr. 8:13–9:11. Petitioner further argues that in its Preliminary Response, Patent Owner statutorily disclaimed all of the claims challenged¹ in this proceeding except for claims 79 and 83, which allowed Patent Owner to focus only on two

¹ In this proceeding, Petitioner challenged claims 1, 24, 25, 27–40, 61, 62, 65–90, 153, 154, and 172–174. Paper 1, 1 (Petition). The remaining claims of the ’541 patent are challenged in other proceedings and have not been statutorily disclaimed. See IPR2024-00942 and IPR2024-00943.

claims and have 12 pages of argument in the Preliminary Response. Tr. 9:12–10:1, 19:4–11; *see also* Paper 10, 4–15² (Preliminary Response). Petitioner also argues that the Preliminary Response mischaracterized the ground set forth in the Petition. Tr. 10:8–11:5.

Patent Owner argues that “the petition actually spent just under a page on Claim 79 analysis” and that Petitioner is “actually seeking to expand the argument set forth in the petition” and “seeking to more than double” the amount of pages that the Petition spent on claim 79. Ex. 1023, 17:13–21; *see also* Paper 1, 22–23.

Having considered the arguments advanced during the teleconference, given the unusual posture of this case and the need for fundamental fairness, we determine that good cause exists supporting Petitioner’s request for a reply to address Patent Owner’s arguments regarding both the *Fintiv* issues and Petitioner’s challenge to claims 79 and 83.

Petitioner’s reply is limited to no more than four pages, and is due by November 7, 2024. The reply is limited to responding to Patent Owner’s arguments presented in the Preliminary Response regarding (1) the *Fintiv* issues; and (2) Petitioner’s challenge to claims 79 and 83. The reply shall not present any new arguments that go beyond the scope of what is reflected in the Petition. *See* 37 C.F.R. § 42.23(b); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 21, 2019),³ 74 (“Generally, a reply or sur-reply may only respond to arguments raised in the preceding brief.

² We note that Patent Owner re-numbers the page numbers for Section IV of the Preliminary Response, which contains the discussion of Petitioner’s challenge to claims 79 and 83. We have cited to the actual page numbers.

³ *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>

37 C.F.R. § 42.23, except as noted above. ‘Respond,’ in the context of 37 C.F.R. § 42.23(b), does not mean proceed in a new direction with a new approach as compared to the positions taken in a prior filing. While replies and sur-replies can help crystalize issues for decision, a reply or sur-reply that raises a new issue or belatedly presents evidence may not be considered.”). Patent Owner may file a sur-reply, limited to responding to Petitioner’s reply discussed above, due by November 14, 2024. The sur-reply is also limited to no more than four pages. No new evidence is authorized to be submitted with the reply or sur-reply.

ORDER

Accordingly, it is:

ORDERED that Petitioner’s request for leave to file a reply to the Patent Owner Preliminary Response is *granted*, and Petitioner may file a reply, limited to responding to Patent Owner’s arguments presented in the Preliminary Response regarding (1) the *Fintiv* issues; and (2) Petitioner’s challenge to claims 79 and 83;

FURTHER ORDERED that the reply shall not present any new arguments that go beyond the scope of what is reflected in the Petition;

FURTHER ORDERED that Patent Owner may file a sur-reply to Petitioner’s reply, limited to responding to Petitioner’s reply;

FURTHER ORDERED that the reply shall be filed by November 7, 2024, the sur-reply shall be filed by November 14, 2024, and neither the reply nor the sur-reply shall exceed four (4) pages; and

FURTHER ORDERED that no new evidence is authorized to be submitted.

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