

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

Issue Date: Nov. 19, 2013

Title: Device-Assisted Services for Protecting Network Capacity

**PRE-INSTITUTION REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE¹**

¹ The Board authorized this four-page Reply to address Patent Owner's POPR
(Paper 13). Paper 12; *see also* EX-1023, 20:10-21:12.

I. Claims 79 and 83 Should Be Instituted

Claims 79 and 83 depend from claim 1 and add limitations related to intercepting API requests and messages. Patent Owner's arguments against institution rely on mischaracterizations of the Petition and unsupported conjecture.

As a threshold issue, Petitioners do not rest solely on inherency. POPR 4-6. Rather, the Petition asserts Rao "anticipates and/or renders obvious" claims 1, 79, and 83. Pet. 1. The Petition analyzes Rao's disclosure of communicating priority (a part of applying Rao's policy) from its agent to its filter via an API, *see, e.g.*, Pet. 22-23 (citing Rao ¶¶190, 106); *id.* at 25, and relies on Dr. Wolfe's explanation of what a POSITA would have understood from Rao's disclosure. As the Petition and Dr. Wolfe explain, Rao's disclosure of communicating the priorities via an API would inform a POSITA that Rao's filter would request the priorities from the agent and the agent would assist in intercepting as claimed, because that is how APIs work. *See* Pet. 22-23 (citing EX-1015 ¶¶ 252-57), Pet. 25 (citing EX-1015 ¶270). Rao therefore discloses or renders obvious intercepting a stack API level request by its filter requesting priorities from the agent. In response, Patent Owner dodges, arguing that Rao *need not* operate that way. POPR 6-9. Patent Owner mischaracterizes the Petition, but further, its assertion that Rao's filter need not send a request to Rao's agent to retrieve priorities, POPR 6-7, is unsupported and contrary to Rao.

Patent Owner's argument is premised on the contention that having the agent

automatically send priorities to the filter would be a more “sensible” implementation of Rao. *See* POPR at 4-13 (claim 79), 14-15 (claim 83); Ex. 2001 ¶¶33-48. But Patent Owner’s more “sensible” implementation ignores Rao’s API altogether. *See* Rao ¶¶190, 106. Its declarant offers an (unsupported)² opinion regarding other, more efficient systems, but these proffered examples omit Rao’s API. EX-2001 ¶¶34-36. Thus, not only does Patent Owner’s declarant avoid Rao’s API disclosure (and Petitioner’s and Dr. Wolfe’s reliance on it, Pet. 22-23; EX-1015 ¶¶255-256), he also does not dispute that an API would ordinarily require a request and response, as Dr. Wolfe explained. *See* EX-1015 ¶257; *see also* EX-2001 ¶¶38, 44. Instead, in the one hypothetical he poses that *does* use an API, he admits that “API requests and responses would need to be transmitted,” even if he laments that they must be done “at very high frequency.” *Id.* ¶38. The point remains that Rao expressly discloses using an API, Pet. 22-23 (citing Rao ¶¶190, 106), which a POSITA would have understood teaches a request and response, thus anticipating or rendering obvious claims 79 and 83. *See, e.g.,* EX-1015 ¶257 (providing specific APIs, their callback functions and properties, and noting other contemporaneous patents).

² Mr. de la Iglesia cites only to one paragraph of Rao, *see* EX-2001 ¶35, and the cited disclosure relates to what information may be communicated from the agent; it does not suggest that the agent sends that information without a request, *id.*

II. The Board Should Decline to Exercise Its Discretion Under *Fintiv*

The Board should not deny institution under *Fintiv* as explained below and in the Petition. Pet. 71-72. Petitioners have removed any risk of duplicating the pending litigations through stipulations. EX-1024. If the IPR is instituted, the “same prior art” will not be considered in the pending litigations. *See* POPR at 24-27.

And while Patent Owner argues that “the challenged and asserted claims are identical,” POPR at 25, that is only because Patent Owner disclaimed 46 of the challenged claims. Until early October, Patent Owner asserted all 174 claims of the ’541 patent in the pending litigations. *See* EX-1020 at 2-3; EX-1025. The three petitions still collectively address 118 more claims than will be tried in district court, even ignoring the further narrowing required before trial. *See* EX-1026 ¶3 (5 claims/patent); EX-1027 ¶3 (same); EX-1028 ¶3 (same).

Under Factor 5, Patent Owner has not sued Petitioner Google LLC, despite accusing Google products. Google only challenges the ’541 patent here, which weighs against denial. Google should not be punished for acting efficiently and presenting a common challenge to the patent with defendant-petitioners.

On trial timing, POPR at 18-22, the date of trial in district court is fluid compared to the Board’s statutorily prescribed deadline, which is twelve months from an anticipated December 2024 institution. Indeed, in one of Patent Owner’s litigations asserting related patents, the district court continued trial from August to

December 2024, where it is one of several trials scheduled. Patent Owner's assertions regarding trial are speculative. *Id.* Indeed, motions to stay the litigations are before the district court now. *See* EX-1029-1031.

Additionally, Petitioners did not "delay," POPR at 23-24, 28-29, by filing the Petition within six months of receiving infringement contentions, which asserted over two hundred claims. Patent Owner asserted all 174 claims of the '541 patent and opposed motions to focus those claims. EX-1032. Preparing petitions challenging all 174 claims was a monumental effort; any delay results from Patent Owner's litigation gamesmanship. Patent Owner is also wrong that the Petition "recycles prior art." *See* POPR at 16. Rao was not before the examiner and Fadell was one of over 700 references cited during prosecution. Pet. 72.

Finally, the Petition's compelling grounds of unpatentability are evidenced by Patent Owner disclaiming *forty-six* of the *forty-eight* claims challenged in this Petition, which "alone demonstrates that the PTAB should not discretionarily deny institution." *Fintiv* Memorandum at 4, 5. Notably, every claim of the '541 patent depends from (now disclaimed) claim 1. Patent Owner did not seek discretionary denial of the two other '541 patent petitions filed by Petitioners, meaning the Board will analyze claim 1 irrespective of the outcome here. The incremental effort required to address claims 79 and 83 does not present efficiencies that justify discretionary denial.

Dated: November 7, 2024

By: /Daniel C. Tucker/

Daniel C. Tucker (Reg. No. 62,781)

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **PRE-INSTITUTION
REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served electronically via email on November 7, 2024, in its entirety on the following:

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Patent Owner has consented to electronic service by email.

Dated: November 7, 2024

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