

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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.

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IPR2024-00944  
Patent 8,589,541

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**PATENT OWNER'S PRELIMINARY SUR-REPLY**

**PATENT OWNER'S EXHIBIT LIST**

| <b>No.</b> | <b>Description</b>                                                                                                                                                                                     |
|------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 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&amp;T Services, Inc. et al.</i> , No. 2:23-cv-00397 (lead case), Docket Control Order, Dkt. No. 41 (E.D. Tex. Dec. 27, 2023)                                           |
| Ex. 2004   | <i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00377, 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), No. 2:23-cv-00377 (member 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&amp;T Services, Inc. et al.</i> , No. 2:23-cv-00397, 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-00377, 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)     |

| No.      | Description                                                                                                                                                                                                                                                             |
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| Ex. 2012 | <i>Headwater Research LLC v. AT&amp;T Services, Inc. et al.</i> , No. 2:23-cv-00397, AT&T Services, Inc. Proof of Service, Dkt. No. 18 (E.D. Tex. Sept. 14, 2023)                                                                                                       |
| Ex. 2013 | <i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00377, Sprint Corp. Proof of Service, Dkt. No. 21 (E.D. Tex. Sept. 7, 2023)                                                                                                                    |
| Ex. 2014 | <i>Headwater Research LLC v. Cellco Partnership d/b/a Verizon Wireless et al.</i> , No. 2:23-cv-00352, Plaintiff Headwater Research LLC’s Amended Disclosure of Asserted Claims and Infringement Contentions (excerpted) (E.D. Tex. served Jan. 12, 2024)               |
| Ex. 2015 | <i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , No. 2:23-cv-00377, T-Mobile USA, Inc. Proof of Service, Dkt. No. 17 (E.D. Tex. Sept. 1, 2023)                                                                                                              |
| Ex. 2016 | <i>Headwater Research LLC v. AT&amp;T Services, Inc. et al.</i> , No. 2:23-cv-00397 (lead 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), No. 2:23-cv-00377 (member case), Plaintiff Headwater Research LLC’s Disclosure of Asserted Claims and Infringement Contentions (excerpted) (E.D. Tex. served Mar. 19, 2024) |
| Ex. 2018 | <i>Headwater Research LLC v. Cellco Partnership d/b/a Verizon Wireless et al.</i> , No. 2:23-cv-00352, Defendants’ Corrected P.R. 3-3 Invalidity Contentions (E.D. Tex. served Jan. 8, 2024)                                                                            |
| Ex. 2019 | <i>Headwater Research LLC v. AT&amp;T Services, Inc. et al.</i> , No. 2:23-cv-00397 (lead 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), No. 2:23-cv-00377 (member case), Defendants’ P.R. 3-3 Invalidity Contentions (E.D. Tex. served Jan. 16, 2024)                                                               |
| Ex. 2021 | <i>Google LLC et al. v. Headwater Research LLC</i> , IPR2024-00942, Paper 1, IPR Petition (PTAB June 7, 2024)                                                                                                                                                           |

| No.      | Description                                                                                                                                                           |
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| Ex. 2022 | <i>Google LLC et al. v. Headwater Research LLC</i> , IPR2024-00943, Paper 1, IPR Petition (PTAB June 7, 2024)                                                         |
| Ex. 2023 | <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. 2024 | <i>Headwater Research LLC v. Samsung Electronics Co. et al.</i> , No. 2:22-cv-00422, Docket Notice Setting Trial Date (E.D. Tex. Nov. 4, 2024)                        |

**I. Rao’s agent’s API usage does not render obvious API requests from Rao’s filter.**

As Headwater explained in its POPR, Petitioners provided no support for the assertion that for Rao’s agent to communicate “priorities to the filter via an API” “*requires* the filter to send a [request] to the agent through the API to transmit the priorities,” a critical premise to the Petition’s claim 47 theory. POPR, 2-3.

Instead, of providing any evidence for their assertion, Petitioners conclusorily allege, without elaboration, that “that is how APIs work.” Prelim Reply, 1. But Petitioners *again* present no evidence that in order for Rao’s agent to use an API to *transmit* priorities to Rao’s filter, those priorities must first be *requested* by the filter. Petitioners’ failure to provide any evidence for this assertion is unsurprising, because APIs such as those discussed in Rao simply do not require data to be *requested* before data can be *transmitted*. As Mr. de la Iglesia (“DLI”) explained, whether Rao’s “agent 326 may communicate the priority of network packets to the filter... via an... API... is irrelevant to whether the *filter* would need to send a request to the *agent* before the agent communicates the priorities” via the API, and a “POSITA would have interpreted [Rao’s] disclosure [of priorities being communicated via API] as suggesting that the agent would send the priorities to the filter *without* previously receiving a request from the filter, because that is the logical way to design a system such as Rao’s.” Ex. 2001, ¶47 (emphases in original).

Petitioners do not even **address** this testimony from DLI. Nor do Petitioners dispute that it would have been undesirable for Rao's filter to first **request** priority updates before Rao's agent **sent** the priorities via an API. *See* Ex. 2001, ¶¶37-47.

Petitioners instead argue that this inefficient API request / API transmission procedure is "what a POSITA would have understood from Rao's disclosure." Prelim Reply, 1. Setting aside that this is not a theory found in the Petition, Petitioners present no **reason** that a POSITA would have understood Rao to disclose this inefficient process, absent the conclusory assertion that "that is how APIs work." Prelim Reply 1. Petitioners present no evidence that Rao explicitly discloses that inefficient configuration, no evidence that such a configuration would have been inherent, and no evidence that a POSITA would have found it obvious.

Finally, Petitioners seek to undermine DLI's testimony as purportedly "ignor[ing] Rao's API altogether." Prelim. Reply, 2. That characterization, however, ignores the fact that DLI was directly rebutting Dr. Wolfe's theory that "for determined priorities to be communicated from the agent 326 to the filter [via an API] so that they can be applied, the filter 322 would need to send a call to (i.e., request) to the agent 326 through the API requesting that the agent 326 send the priorities." Ex 2001 ¶31 (quoting Ex. 1015, ¶256). Petitioners' argument also ignores (and does not even attempt to rebut) DLI's testimony that whether Rao's agent communicates priorities to the filter "via an... API... is irrelevant to whether the

filter would need to send a request to the agent” (*id.* ¶47), which testimony establishes that DLI *did* consider the impact of Rao’s API disclosure in his analysis.

## **II. The Board Should Exercise its Discretion and Deny Institution.**

The following is undisputed: trials are set about 7 months before any FWD; *Markman* will be complete and fact discovery will either be complete or nearing completion at institution; Petitioners filed the Petition over 10 months after service of the first complaint; the challenged and asserted claims are identical; Petitioners do not offer a *Sotera* stipulation; 5 of 6 Petitioners are defendants in the litigations.

In the wake of those facts, Petitioners (1) advance a weak stipulation, (2) comment on Patent Owner’s disclaimer of certain claims alleged impact on the *Fintiv* analysis, (3) point out Petitioner Google is not a defendant, and (4) offer rank speculation about trial dates. These arguments should be rejected, and the Board should exercise its discretion to deny institution.

First, despite offering no stipulation in the Petition, Petitioners now state they “will not pursue invalidity challenges in th[e] litigation against the challenged claims ... on the grounds or the prior art references asserted in th[e] petition.” Ex. 1024. They are agreeing to far less than the natural consequences of proceeding to a FWD. *Cal. Tech. v. Broadcom*, 25 F.4th 976, 991 (Fed. Cir. 2022) (“estoppel applies not just to claims and grounds asserted in the petition ..., but to all grounds not stated in the petition but which reasonably could have been asserted”). And Petitioners admit

that art they do intend to rely on has similar disclosures as their IPR primary reference, Rao. Ex. 2018, 52-57; Ex. 2019, 75-81; Ex. 2020, 60-66.

Second, the two claims challenged here (claims 79 and 83) are the same and only two claims asserted in the district court. That this is so because Patent Owner disclaimed the other challenged and asserted claims is no event in the Factor 4 analysis, which considers the overlap in the IPR and district court proceedings. Petitioners cite no authority to the contrary. And as discussed above, the Petition fails to present a compelling meritorious challenge as to claims 79 and 83. *See* § I.

Third, although Google is not a district court defendant, “if the issues are the same as, or substantially similar to, those already or about to be litigated ..., the Board may ... exercise the authority to *deny institution*.” *Google v. Personalized Media*, IPR2020-00724, Paper 19, 8 (PTAB 2020). Because the issues in this IPR and the parallel litigations substantially overlap, Factor 5 weighs against institution.

Fourth, the Board routinely declines to speculate about whether a trial date will move without supporting evidence. *Nine Energy v. NCS Multistage*, IPR2020-01615, Paper 18, 9 (PTAB 2011). Petitioners present no such evidence here, but only rank speculation rooted in a trial date needing to be changed in an unrelated case. There, Samsung moved to continue an August 16 trial, alleging counsel and experts had conflicts with anything prior to October 28. Ex. 2023. That case has been reset for trial on December 6, 2024. Ex. 2024. In any event, no similar facts exist here.

Date: November 14, 2024

Respectfully submitted,

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

The undersigned hereby certifies that the above document was served on November 14, 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:

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