

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: IPR2024-00945

U.S. Patent No. 9,215,613

Issue Date: Dec. 15, 2015

Title: Wireless End-User Device with Differential Traffic Control Policy List
Having Limited User Control

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

¹ The Board authorized this two-page Reply to address Patent Owner's arguments under 35 U.S.C. § 314(a) in an email dated October 24, 2024. *See* EX-1022.

Petitioners have eliminated any risk of duplicating the pending litigations through stipulations. EX-1032. The Board should not deny institution under *Fintiv* as explained below and in the Petition (Pet. 65-66).

Petitioners' stipulations address the concern that "the same prior art" will be considered in Patent Owner's pending litigations. Paper 9 ("POPR") at 39. There will be no overlap in art between this proceeding, if instituted, and the pending litigations; the asserted references and grounds will be considered only here.

Further, Patent Owner's recent reduction of the number of asserted '613 patent claims from twenty-four to *seven* in the pending litigations also favors institution under Factor 4. EX-1023 ("claims 1, 8, 12, 15, 16, 18, 23"). While Patent Owner argues "the Petition challenges all of the claims that are currently asserted in the litigation," POPR at 38, this is not the proper inquiry. Instead, the relevant fact is that Petitioners currently challenge seventeen more claims than will be adjudicated in these litigations, and the district court has required further narrowing for trial. *See* EX-1024 ¶3 (5 claims/patent); EX-1025 ¶3 (6 claims/patent); EX-1026 ¶3 (same).

Moreover, Patent Owner has not brought suit against Petitioner Google LLC, despite alleging infringement based on Google products. This IPR is the only forum in which Google challenges the '613 patent claims, which weighs against a discretionary denial of institution. Google should not be punished for acting efficiently and presenting a Petition in concert with the defendant-petitioners.

On timing of trial (POPR 31-34), 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. As evidence, in another one of Patent Owner's litigations on patents related to the '613 patent, the district court continued trial in August 2024 and a new trial date has yet to be set. *See* EX-1028. Patent Owner's assertion that the district court trial will occur "six to seven months" earlier is therefore speculative, at best, and its argument that there is "no evidence" trial could move is incorrect. *See* POPR at 31-34. Indeed, motions to stay the litigations pending IPR are before the district court now. *See* EX-1029; EX-1030; EX-1031.

Finally, Petitioners did not "delay" by filing the Petition within six months of receiving Patent Owner's infringement contentions, which asserted over two hundred claims (POPR at 37, 41-42). *See CoolIT Sys., Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11-14 (P.T.A.B. Dec. 28, 2021) (finding that a similar five-month period showed diligence where "[t]he litigation involve[d] numerous other patents"). While Patent Owner identifies "Rao-WO" and the issued version of Montemurro from a sea of over 1,200 prior art references on the face of the patent, none of the prior art in the Petition was asserted during examination, nor were the asserted combinations. This includes Fruend and Araujo. Petitioner therefore does not "recycle[] prior art" in the Petition. *See* POPR at 29. Petitioner instead presents compelling new grounds of unpatentability that should be instituted.

Respectfully submitted,

Dated: October 31, 2024

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Lead 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 October 31, 2024, in its entirety on the following:

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Patent Owner has consented to electronic service by email.

Dated: October 31, 2024

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