IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS, VERIZON CORPORATE SERVICES GROUP INC.,
T-MOBILE USA, INC.,
AND AT&T SERVICES, INC.,
Petitioners,

v.

HEADWATER RESEARCH LLC
Patent Owner.

U.S. Patent No. 8,924,543
Issue Date: December 30, 2014
Title: SERVICE DESIGN CENTER FOR DEVICE ASSISTED SERVICE

Inter Partes Review No.: IPR2024-01041

PETITIONERS' JUSTIFICATION FOR FILING PARALLEL PETITIONS CHALLENGING U.S. PAT NO. 8,924,543

***Mail Stop* "*PATENT BOARD*"**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioners' Exhibit List

Exhibit #	*Description*
1001	U.S. Patent No. 8,924,543 ("the '543 Patent")
1002	Select portions of prosecution history of the '543 Patent ("File History")
1003	Declaration of Petitioners' Expert ("Houh Declaration")
1004	U.S. Pat. No. 9,712,331 ("Poh")
1005	U.S. Pat. Pub. No. 2008/0181208 ("Maes")
1006	Boutaba and Polyrakis, "Toward Extensible Policy Enforcement Points", in M. Sloman, J. Lobo, and E. Lupu (Eds.): POLICY 2001, LNCS 1995, pp. 247-261 (© Springer-Verlag Berlin Heidelbergm 2001)
1007	Beigi et al., "Policy Transformation Techniques in Policy-based Systems Management", Proceedings Fifth IEEE International Workshop on Policies for Distributed Systems and Networks (2004)
1008	Chaouchi et al., "Policy Based Networking in Integration Effort of 4G Networks and Services", 2004 IEEE 59th Vehicular Technology Conference, VTC 2004-Spring, pp. 2977-2981 Vol. 5.
1009	Verma et al., "Simplifying Network Administration Using Policy-Based Management", IEEE Network, pp. 20-26 (March/April 20).
1010	3GPP TS 23.203 (v8.4.0 (2008-12) (3rd Generation Partnership Project; Technical Specification Group Services and System Aspects; Policy and charging control architecture (Release 8))
1011	U.S. Pat. No. 8,032,920 ("Maes II")
1012	U.S. Pat. No. 9,691,082 ("Burnett")
1013	List of related patents
1014	Plaintiff Headwater Research LLC's Disclosure of Asserted Claims and Infringement Contentions, case no. 2:23-cv-00398, -397.

I. INTRODUCTION

Cellco Partnership d/b/a Verizon Wireless, Verizon Corporate Services Group Inc., T-Mobile USA, Inc., and AT&T Services, Inc., (collectively, "Petitioners") filed concurrent Petitions for an *inter partes* review ("IPR") of U.S. Patent No. 8,924,543 ("the '543 Patent") in IPR2024-01041 and IPR2024-01042. The sole reason for separate Petitions is the excessive number of claims that were allowed for the '543 Patent, the large number of claims being asserted in the underlying litigation, and the large number of words in those claims. The '543 Patent has 1 independent claim and 120 dependent claims, of which the Patent Owner has asserted 68 claims in the underlying litigation. Petitioners challenge the 68 asserted claims between the two Petitions.

In IPR2024-01041, Petitioners presented the following ground:

Ground	Claims	Basis	Reference
1	1-7, 11-13, 22-23, 30-33, 35-41, 90-93, and 112-113	§ 103	Poh, alone, or in view of Maes

In IPR2024-01042, Petitioners presented the following grounds:

Ground	Claims	Basis	Reference
1	1, 8-10, 15, 21, 28, 42, 43, 45, 46, 87-89, 96, 98-99, 120-121	§ 103	Poh, alone, or in view of Maes
2	16, 44, 47, 57-66, 68-72, 80 and 85-86	§ 103	Poh, alone, or in view of Maes, in further view of Burnett

The only overlap in the Challenged Claims between Petitions is claim 1, and the analysis for claim 1 is identical for both Petitions. Petitioners were forced to

include claim 1 in each Petition because of the abnormal structure of the claim set with only a single independent claim. In order to minimize the burden on the Board for reviewing two petitions, the description of the State of the Art and the description of the prior art relied on for Ground 1 is substantially the same between Petitions, and Ground 2 of the 1042 IPR includes one additional reference. Further, dependent claims directed to common features have been grouped together in one of the Petitions. Thus, the difference between the Petitions is essentially limited to the analysis of the dependent claims.

To the extent that the Board exercises its discretion to only institute one Petition, Petitioners respectfully select IPR2024-01042 as the preferred Petition merely on the basis that Petition challenges more dependent claims (39) than are challenged in IPR2024-01041 (28 dependent claims).

Respectfully submitted,

BY: /Kevin P. Anderson/
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USPTO Reg. No. 43,471
Duane Morris LLP

Dated:

June 20, 2024

CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. §§ 42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on the 20th of June, 2024, a complete and entire copy of this Petition for *Inter Partes* Review of U.S. Patent No. 8,924,543 and all supporting exhibits were served by electronic means by agreement with Patent Owner to:

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