

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.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2024-01041
Patent 8,924,543

PATENT OWNER'S PRELIMINARY RESPONSE

PATENT OWNER'S EXHIBIT LIST

No.	Description
Ex. 2001	<i>Cellco Partnership d/b/a/ Verizon Wireless et al. v. Headwater Research LLC</i> , IPR2024-01042, Paper 5 (IPR Petition) (PTAB June 20, 2024)
Ex. 2002	Email from counsel for Headwater Kristopher Davis to counsel for Verizon and T-Mobile re Preliminary Election of Asserted Claims
Ex. 2003	Email from counsel for Headwater Kristopher Davis to counsel for AT&T re Preliminary Election of Asserted Claims

The sole justification Petitioners give for filing two petitions is that it could not challenge all **68 claims** asserted in the parallel district court litigation in a single petition. Paper 3 (“Ranking Paper”). However, even assuming that were so, since the instant Petition and the parallel petition (Ex. 2001, “-01042 Petition”) were filed, Patent Owner has narrowed each of the parallel cases such that it now only asserts the same **8 claims** against each Petitioner. Ex. 2002 (asserting only claims 1, 8, 44, 47, 61, 88, 98, and 120 against Verizon and T-Mobile); Ex. 2003 (same as to AT&T).

All eight still-asserted claims are challenged in the -01042 Petition. Ranking Paper at 1; Ex. 2001. The only still-asserted claim challenged in the instant Petition is independent claim 1. Ranking Paper at 1; Pet. But as Petitioners admit, not only is same prior art combination used against claim 1 in both petitions, but “the analysis for claim 1 is identical for both Petitions.” Ranking Paper at 1. Moreover, to the extent the Board is inclined to institute either petition, Petitioners rank the -01042 Petition, not the instant Petition, as their “preferred Petition.” *Id.* at 2.

At bottom, because the instant Petition does not contain any unique challenge to any claim asserted in the district court litigations, and otherwise only challenges non-asserted claims, it should be denied as an unnecessary parallel petition. *See, e.g., Apple, Inc. v. Spier Techs. Ltd.*, IPR2023-00543, Paper 8 at 10 (PTAB Aug. 8, 2023) (denying institution of a second petition because it addressed only claims not asserted in the co-pending litigation).

Date: October 16, 2024

Respectfully submitted,

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner certifies that there are 264 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

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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 October 16, 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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