

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

HEADWATER PARTNERS I LLC,
Patent Owner.

Case IPR2024-01051
Patent 8,639,811

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

- SAMSUNG-1001 U.S. Patent No. 8,639,811 to Raleigh (“the ’811 Patent”)
- SAMSUNG-1002 Excerpts from the Prosecution History of the ’811 Patent (“the Prosecution History”)
- SAMSUNG-1003 Declaration and Curriculum Vitae of Dr. Patrick McDaniel
- SAMSUNG-1004 Complaint for Patent Infringement in *Headwater Research LLC v. Samsung Electronics Co., Ltd. et al.*, 2-23-cv-00641 (EDTX), Dec. 29, 2023)
- SAMSUNG-1005 U.S. Pat. App. Pub. No. 2006/0039354 (“Rao”)
- SAMSUNG-1006 U.S. Pat. No. 8,285,850 (“Jones”)
- SAMSUNG-1007 U.S. Pat. No. 8,400,491 (“Panpaliya”)
- SAMSUNG-1008 U.S. Pat. App. Pub. No. 2009/0207817 (“Montemurro”)
- SAMSUNG-1009 U.S. Pat. App. Pub. No. 2009/0185527 (“Akhtar”)
- SAMSUNG-1010 U.S. Pat. App. Pub. No. 2008/0162981 (“Jajoo”)
- SAMSUNG-1011 U.S. Pat. App. Pub. No. 2009/0228951 (“Ramesh”)
- SAMSUNG-1012 U.S. Pat. App. Pub. No 2007/0032230 (“Pregont”)
- SAMSUNG-1013 U.S. Pat. No. 5,987,611 (“Freund”)
- SAMSUNG-1014 RESERVED
- SAMSUNG-1015 Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Director’s Guidance”)
- SAMSUNG-1016 Samsung Stipulation Letter
- SAMSUNG-1017 Federal Court Management Statistics (December 31, 2023)

SAMSUNG-1018 RESERVED

SAMSUNG-1019 van Beek, et. al., 2004, January. Adaptive streaming of high-quality video over wireless LANs. In Visual Communications and Image Processing 2004 (Vol. 5308, pp. 647-660). SPIE. (“van Beek”)

SAMSUNG-1020 IETF RFC 791, Internet Protocol, September 1981, downloaded from the internet at <https://www.ietf.org/rfc/rfc791.txt> on July 28, 2023

SAMSUNG-1021 IETF RFC 5246, The Transport Layer Security (TLS) Protocol, version 1.2, August 2008, downloaded from the internet at <https://datatracker.ietf.org/doc/html/rfc5246> on May 9, 2024

SAMSUNG-1022 Internet connection speed recommendations, downloaded from the Internet at <https://help.netflix.com/en/node/306> on April 29, 2024. (“Netflix”)

SAMSUNG-1023 Apostolopoulos, et al., 2002. Video streaming: Concepts, algorithms, and systems. HP Laboratories, report HPL-2002-260, pp.2641-8770. (“Apostolopoulos”)

SAMSUNG-1024 U.S. Pat. App. Pub. No. 2006/0282566 (“Virdi”)

SAMSUNG-1025 U.S. Pat. App. Pub. No. 2005/0080904 (“Green”)

SAMSUNG-1026 IETF RFC 793, TRANSMISSION CONTROL PROTOCOL, September 1981, downloaded from the internet at <https://datatracker.ietf.org/doc/html/rfc793> on April 24, 2024. (“TCP”)

SAMSUNG-1027 U.S. Pat. App. Pub. No. 20070121615 (“Weill”)

SAMSUNG-1028 RESERVED

SAMSUNG-1029 U.S. Pat. App. Pub. No. 2008/0080458 (“Cole”)

SAMSUNG-1030 U.S. Pat. App. Pub. No. 2010/0281154 (“Bedi”)

SAMSUNG-1031 Lobo, et. al., (1999). A policy description language. AAAI/IAAI, 1999, 291-298. (“Lobo”)

- SAMSUNG-1032 Verma, et. al., (2002). Policy-based management of content distribution networks. IEEE network, 16(2), 34-39. (“Verma”)
- SAMSUNG-1033 RESERVED
- SAMSUNG-1034 Banchs, et. al., Distributed weighted fair queuing in 802.11 wireless LAN, 2002 IEEE International Conference on Communications, Conference Proceedings. ICC 2002 pp. 3121-3127), 2002 (“Banchs”)
- SAMSUNG-1035 Wu, et. al., 2001. Scalable video coding and transport over broadband wireless networks. Proceedings of the IEEE, 89(1), pp.6-20.
- SAMSUNG-1036 IETF RFC 2205, Resource ReSerVation Protocol (RSVP), version 1 Functional Specification, September 1997, downloaded from the internet at <https://datatracker.ietf.org/doc/html/rfc2205> on May 16, 2024
- SAMSUNG-1037 Excerpts, Computer Networks, Fourth Edition, by Andrew Tanenbaum, Prentice Hall, 2003
- SAMSUNG-1038 U.S. Pat. App. Pub. No. 2007/0258459 (“Smith”)
- SAMSUNG-1039 Agrawal, et. al., 2005. Policy-based management of networked computing systems. IEEE Communications Magazine, 43(10), pp.69-75 (“Agrawal”)
- SAMSUNG-1040 RESERVED
- SAMSUNG-1041 Blake, et al., IETF RFC 2475, “An Architecture for Differentiated Services,” December 1998, downloaded from the internet at <https://datatracker.ietf.org/doc/html/rfc2475> on July 29, 2023
- SAMSUNG-1042 Reeder, et. al., 2007. Usability challenges in security and privacy policy-authoring interfaces. In Human-Computer Interaction–INTERACT 2007: 11th IFIP TC 13 International Conference, Rio de Janeiro, Brazil, September 10-14, 2007, Proceedings, Part II 11 (pp. 141-155). Springer Berlin Heidelberg.

- SAMSUNG-1043 Mansour, et al., 2001. Jitter control in QoS networks. IEEE/ACM Transactions On Networking, 9(4), pp.492-502.
- SAMSUNG-1044 Westerinen, et al., IETF RFC 3198, Terminology for Policy-Based Management, November 2001, downloaded from the Internet on May 27, 2024.
- SAMSUNG-1045 Damianou, et al., 2001. The ponder policy specification language. In Policies for Distributed Systems and Networks: International Workshop, POLICY 2001 Bristol, UK, January 29–31, 2001 Proceedings (pp. 18-38). Springer Berlin Heidelberg. (“Damianou”)
- SAMSUNG-1046 Stone, G.N., Lundy, B. and Xie, G.G., 2001. Network policy languages: a survey and a new approach. IEEE network, 15(1), pp.10-21. (“Stone”)
- SAMSUNG-1047 Agrawal, et. al., 2007, May. Issues in designing a policy language for distributed management of IT infrastructures. In 2007 10th IFIP/IEEE International Symposium on Integrated Network Management (pp. 30-39). IEEE. (“Agrawal-2”)
- SAMSUNG-1048 Simplified Policy Language (CIM-SPL). Document Number DSP0231, version, 1. (“CIM-SPL”)
- SAMSUNG-1049 Ponnappan, et al., 2002, June. A policy based QoS management system for the IntServ/DiffServ based Internet. In Proceedings Third International Workshop on Policies for Distributed Systems and Networks (pp. 159-168). IEEE. (“Ponnappan”)
- SAMSUNG-1050 Gonçalves, et al., 2009, October. A graphical user interface for policy composition in CIM-SPL. In 2009 International Conference on Ultra Modern Telecommunications & Workshops (pp. 1-7). IEEE. (“Gonçalves”)
- SAMSUNG-1051 U.S. Pat. App. Pub. No. 2008/0122796 (“Jobs”)
- SAMSUNG-1052 Grossman, Invention of the year: The iPhone. Time Magazine Online, 1, downloaded from the internet at https://content.time.com/time/specials/2007/article/0,28804,1677329_1678542_1677891,00.html on May 28, 2024.

SAMSUNG-1053 Excerpts, Telcom Dictionary, Althos Publishing, 2007.

SAMSUNG-1054 U.S. Pat. App. Pub. No. 2008/0002652. (“Gupta”)

SAMSUNG-1055 U.S. Pat. No. 8,019,868 (“Rao-2”)

SAMSUNG-1056 Confidential Settlement Agreement

Petitioner Samsung Electronics Co. Ltd. (“Samsung” or “Petitioner”) and Patent Owner Headwater Research LLC (“Headwater” or “Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Samsung and Headwater move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

Samsung and Headwater (collectively, the “Settling Parties”) have reached an agreement (the “Settlement Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1056. The Settlement Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Settling Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate

after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Settling Parties jointly request, for the following reasons.

First, Samsung and Headwater have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, Samsung and Headwater have reached a settlement as to all the disputes in this proceeding and as to the ’811 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 1056. Samsung and Headwater request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Settling Parties.

Third, termination would save significant further expenditure of resources by the Settling Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient

and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, Samsung and Headwater respectfully request termination of this *inter partes* review.

Respectfully submitted,

Date: June 3, 2025

/Jennifer J. Huang/
W. Karl Renner, Reg. No. 41,265
Jeremy J. Monaldo, Reg. No. 58,680
Jennifer J. Huang, Reg. No. 64,297
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner Samsung

Respectfully submitted,

Date: June 3, 2025

/Reza Mirzaie/
Reza Mirzaie, Reg. No. 69,138
Russ, August & Kabat
12424 Wilshire Blvd., 12th Fl.
Los Angeles, CA 90025
Tel.: 310-826-7474
Fax: 310-826-6991

Attorneys for Patent Owner Headwater

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on June 3, 2025, a complete and entire copy of this Joint Motion to Terminate and Exhibit 1056 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

Reza Mirzaie
Marc A. Fenster
Dale Chang
James A. Milkey
Neil Rubin
Philip X. Wang
Russ, August & Kabat
12424 Wilshire Blvd. 12th Floor
Los Angeles, CA 90025

Email: rak_headwater@raklaw.com
rmirzaie@raklaw.com
mfenster@raklaw.com
dchang@raklaw.com
jmilkey@raklaw.com
nrubin@raklaw.com
pwang@raklaw.com

_____/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
bradley@fr.com