

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC., AT&T SERVICES, INC., CELLCO
PARTNERSHIP D/B/A VERIZON WIRELESS, ERICSSON INC.,
NOKIA OF AMERICA CORPORATION, and
SAMSUNG ELECTRONICS CO. LTD.,
Petitioner,
v.
HEADWATER PARTNERS II LLC,
Patent Owner.

IPR2024-01468¹
Patent 9,094,868 B2

**JOINT REQUEST TO KEEP SEPARATE PURSUANT TO
35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)**

¹ IPR2025-00426 has been joined with this proceeding.

Patent Owner has entered into a release agreement with Petitioners Cellco Partnership d/b/a Verizon Wireless, Verizon Corporate Services Group Inc. (“Verizon”), T-Mobile USA, Inc. (“T-Mobile”), and AT&T Services, Inc. (“AT&T”), and Samsung Electronics Co., Ltd. (“Samsung”), and has additionally entered into a covenant not to sue with Petitioners Ericsson Inc. (“Ericsson”), Nokia of America Corporation (“Nokia”), Verizon, T-Mobile, and AT&T, which release agreements and covenant not to sue resolve the disputes in the above-captioned *inter partes* review relating to U.S. Patent No. 9,094,868 (“Patent-in-Suit”). The parties jointly request that the Board treat the release agreements and covenant not to sue as business confidential information and keep them separate from the files of this proceeding and the files of the Patent-in-Suit. As set forth in an e-mail dated January 14, 2025, the Board authorized the filing of the requested Joint Motion to Terminate this *inter partes* review and the instant request to treat the related agreements as business confidential information under 37 C.F.R. § 42.74(c).

I. STATEMENT OF PRECISE RELIEF REQUESTED

The parties jointly request that the Board treat the release agreements and covenant not to sue as business confidential information and keep them separate from the files of this proceeding and the files of the Patent-in-Suit. The parties request that these agreements “be made available only to Federal Government

agencies on written request, or to any person on a showing of good cause” in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

II. REASONS WHY RELIEF IS APPROPRIATE

The terms of the release agreements and covenant not to sue require the parties to treat those agreements as confidential information and limit their ability to share the agreements or disclose their contents with third parties. The parties have filed a copy of the agreements with the Board as exhibits 2016-2021, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. The confidential agreements were filed in the PTACTS system to provide availability only to the Board and the filing party.

Dated: February 3, 2026

/James A. Milkey/

James A. Milkey (Reg. No. 79,503)
Russ, August & Kabat
12424 Wilshire Blvd., 12th Floor
Los Angeles, CA 90025
Counsel for Patent Owner

/Jacob K. Baron/

Jacob K. Baron (Reg. No. 48,961)
jacob.baron@hkclaw.com
HOLLAND & KNIGHT LLP
10 Saint James Avenue; 11th Floor
Boston, MA 02116
Telephone: (617)523-2700
Facsimile: (617)523-6850
*Counsel for T-Mobile USA, Inc., AT&T
Services, Inc., Cellco Partnership d/b/a
Verizon Wireless, Ericsson Inc. and Nokia of
America Corporation*

/Jeremy J. Monaldo/

W. Karl Renner, Reg. No. 41,265
Jeremy J. Monaldo, Reg. No. 58,680
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
Electronics Co., Ltd.*

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

The undersigned hereby certifies that the above document was served on February 3, 2026, by filing this document through the PTACTS system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

Jacob K. Baron (Reg. No. 48,961)
Jacob W. S. Schneider (*pro hac vice* forthcoming)
HOLLAND & KNIGHT LLP
10 St. James Ave., 11th Floor
Boston, MA 02116
Jacob.Baron@hklaw.com
Jacob.Schneider@hklaw.com
ClientTeamHeadwaterLitigation@hklaw.com
*Counsel for T-Mobile USA, Inc., AT&T Services, Inc., Cellco Partnership
d/b/a Verizon Wireless, Ericsson Inc. and Nokia of America Corporation*

W. Karl Renner, Reg. No. 41,265
Jeremy J. Monaldo, Reg. No. 58,680
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
IPR39843-0192IP1@fr.com
PTABInbound@fr.com
Attorneys for Petitioner Samsung Electronics Co., Ltd.

Dated: February 3, 2026

/ James A. Milkey /

James A. Milkey (Reg. No. 79,503)
Russ August & Kabat
12424 Wilshire Blvd., 12th Fl.
Los Angeles, CA 90025
Phone: (310) 826-7474
Fax: (310) 826-6991
jmilkey@raklaw.com
Counsel for Patent Owner