

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM SERVICES LLC and AMAZON WEB SERVICES, INC.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2026-00106
Patent 10,321,320 B2

Before HYUN J. JUNG and STEPHEN E. BELISLE,
Administrative Patent Judges.

JUNG, *Administrative Patent Judge.*

ORDER
Staying Reexamination
35 U.S.C. § 315(d); 37 C.F.R. §§ 42.122(a), 42.3(a)

With our authorization, Headwater Research LLC (“Patent Owner”) filed a Motion to Stay *Ex Parte* Reexamination No. 90/016,185 (“the Reexamination”). Paper 19 (“Motion” or “Mot.”). “Patent Owner has met and conferred with Petitioner regarding this request, and notes that Petitioner does not oppose this authorized Motion.” Mot. 1.

On November 10, 2025, Amazon.com Services LLC and Amazon Web Services, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–18 of U.S. Patent No. 10,321,320 B2 (Ex. 1001, “’320 patent”). Institution was granted in this proceeding. Paper 12.

On April 15, 2026, Walmart Inc. (“Walmart”) filed a request for *ex parte* reexamination of claims 1–18 of the ’320 patent. Ex. 2017. On July 14, 2026, the request was granted and assigned control number 90/016,185. Ex. 2018.

The Board may enter an order staying a reexamination proceeding where good cause exists. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a). “[T]he Board ordinarily will stay a [reexamination] where good cause exists.” Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16654, 16656 (Apr. 22, 2019) (“Notice”). The Notice outlines factors the Board considers in AIA trials in deciding whether to stay a parallel reexamination involving the same patent. Notice, 16657. The factors include:

- (1) “Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding,”
- (2) “Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings,”

- (3) “Whether the concurrent parallel Office proceeding will duplicate efforts within the Office,”
- (4) “Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding),”
- (5) “Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding,”
- (6) “The respective timeline and stage of each proceeding,”
- (7) “The statutory deadlines of the respective proceedings,” and
- (8) “Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.”

Id.

We discuss each of the factors below.

1. *Whether the claims challenged in this proceeding are the same as or depend directly or indirectly from claims at issue in the Reexamination*

Patent Owner argues that all claims challenged in this proceeding are the same as the claims at issue in the Reexamination. Mot. 5.

We agree. Petitioner challenges claims 1–18 of the ’320 patent (Pet. 1), and reexamination of claims 1–18 of the same patent was granted (Ex. 2018, 8–9).

Thus, factor 1 favors a stay. *Id.*

2. *Whether the same grounds of unpatentability or the same prior art are at issue in both this proceeding and the Reexamination*

Petitioner challenges claims 1–18 as unpatentable over combinations including TS-23.140,¹ Adamczyk,² Herzog,³ Shen,⁴ Pazhyannur,⁵ Ellison,⁶ and Fok.⁷ Pet. 3. Petitioner also challenges the same claims as unpatentable over combinations including Houghton,⁸ Munson,⁹ TS-23.140, Adamczyk, Shen, Pazhyannur, Ellison, and Fok. *Id.*

In the Reexamination, Walmart challenges claims 1–3, 5–7, 10, 12, 13, and 15–18 as anticipated by Rittmaster¹⁰ and challenges claims 1–18 as obvious over combinations of Rittmaster and ten other references that include Ellison and Fok. Ex. 2017, 17.

Patent Owner argues with citations to other Board proceedings that, because of the overlap in applying Ellison and Fok, this factor favors a stay or, at the very least, is neutral. Mot. 5–7.

In this proceeding, Petitioner combines Fok and Ellison with TS-23.140 or Houghton and Munson with or without TS-23.140 against dependent claims 14 and 17. Pet. 3 (Grounds 1F, 1G, 2F, 2G). In the Reexamination, Walmart combines Ellison with Rittmaster against claim 14

¹ 3GPP TS 23.140 v6.9.0 (2005-03); 3rd Generation Partnership Project; Technical Specification Group Terminals; Multimedia Messaging Service (MMS); Functional Description; Stage 2 (Release 6) (Ex. 1004).

² US 2008/0162637 A1, published July 3, 2008 (Ex. 1021).

³ US 2009/0158397 A1, published June 18, 2009 (Ex. 1008).

⁴ US 2005/0207379 A1, published Sept. 22, 2005 (Ex. 1014).

⁵ US 2008/0243999 A1, published Oct. 2, 2008 (Ex. 1037).

⁶ US 7,082,615 B1, issued July 25, 2006 (Ex. 1019).

⁷ US 2008/0215883 A1, published Sept. 4, 2008 (Ex. 1038).

⁸ WO 2006/077283 A1, published July 27, 2006 (Ex. 1007).

⁹ US 2009/0240807 A1, published Sept. 24, 2009 (Ex. 1017).

¹⁰ US 2002/0023010 A1, published Feb. 21, 2002.

and combines Fok and/or Ellison with Rittmaster against claim 17. Ex. 2018, 7 (SNQ 7, SNQ 8). Ellison and Fok, thus, appear to be used in the same manner in both this proceeding and the Reexamination.

Because substantially different grounds are at issue with only two prior art references in common in this proceeding and the Reexamination, factor 2 is neutral.

3. *Whether conducting the Reexamination and this proceeding will duplicate efforts within the Office*

Patent Owner argues that, because the same claims are at issue in this proceeding and the Reexamination and because Fok and Ellison are applied against the same dependent claims, the risk of duplication is very high, and, thus, this factor favors a stay. Mot. 8. Patent Owner also argues that the fact Petitioner has no role or involvement in the Reexamination further weighs in favor of a stay, because its position would be unchanged if the Reexamination is stayed. *Id.* We agree that the overlap in the claims challenged and the issues involving Fok and Ellison would involve a duplication of efforts.

Factor 3, thus, weighs in favor of a stay.

4. *Whether the Reexamination could result in inconsistent results between proceedings*

Patent Owner argues that the Reexamination and this proceeding present substantial risk of inconsistent results, because both may rule on the scope of the claims and likely determine whether substantially similar disclosures would have rendered obvious the same claims. Mot. 8–9. We agree with Patent Owner that the Reexamination and this proceeding may rule differently on the scope of the claims and, in turn, affect whether any

substantially similar disclosure would have rendered obvious the same claims.

Factor 4, thus, weighs in favor of a stay.

5. Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding

Patent Owner argues that “the Order granting reexamination expressly provides that Patent Owner may use its optional Patent Owner Statement to introduce amendments.” Mot. 9 (citing Ex. 2018, 11). Patent Owner also argues that a stay would “alleviate the risk that amendments or new claims” in the Reexamination would affect the claims in this proceeding. *Id.* at 9–10. We agree with Patent Owner that the claims may be amended in the Reexamination and that such an amendment would affect this proceeding.

Factor 5, thus, weighs in favor of a stay.

6. The respective timeline and stage of each proceeding

Patent Owner argues that this proceeding was instituted on April 28, 2026, and that no Office action or rejection of any claim has been issued in the Reexamination. Mot. 10.

This proceeding is subject to a statutory deadline that requires a final decision within one year of institution, absent a good cause extension. 35 U.S.C. § 316(a)(11). That deadline is April 28, 2027. The Reexamination is required to be “conducted with special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305.

Factor 6, thus, weighs in favor of a stay.

7. The statutory deadlines of the respective proceedings

Patent Owner provides the same arguments as summarized above for factor 6. As discussed above, this proceeding is subject to a statutory deadline.

Factor 7, thus, weighs in favor of a stay.

8. *Whether a decision in one proceeding would likely simplify issues in the Reexamination or render it moot*

Patent Owner argues that this proceeding “may simplify or moot the issues in the [Reexamination], which has overlapping claims and art.”

Mot. 10. We determine that a final determination in this proceeding regarding the patentability of the only independent claim of the '320 patent could resolve or simplify certain issues in the Reexamination.

Factor 8, thus, favors a stay.

9. *Conclusion*

Factors 1 and 3–8 weigh in favor of a stay, and factor 2 is neutral. After considering all the factors, for the foregoing reasons, we find good cause exists for staying the Reexamination pending resolution of this proceeding. *See* Notice at 16656 (“Good cause for staying a case may exist if, for example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.”).

We note for the parties that the Notice specifies considerations for lifting a stay, both generally (Notice, 16657) and specifically with respect to an *ex parte* reexamination (Notice, 16658). Should a party wish to move for the lifting of a stay, it should request authorization to file a motion and request a conference with the Board.

ORDER

Accordingly, it is:

ORDERED that Patent Owner's Motion to Stay *Ex Parte* Reexamination No. 90/016,185 is *granted*;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 315(d), Reexamination Control No. 90/016,185 is *stayed* pending the termination or completion of IPR2026-00106;

FURTHER ORDERED that this stay tolls all time periods for filing further papers in Reexamination Control No. 90/016,185, and, absent specific authorization, no further papers shall be filed in the reexamination while this stay remains in place; and

FURTHER ORDERED that, when the stay is lifted, a paper will be sent resetting the time periods for responding to any outstanding papers in Reexamination Control No. 90/016,185.

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