Trials@uspto.gov
571-272-7822

Paper 13
Date: April 1, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2024-01397
Patent 9,647,918 B2

Before GARTH D. BAER, SCOTT B. HOWARD, and STEPHEN E. BELISLE, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

GOOGLE EXHIBIT 1086
GOOGLE v. HEADWATER
IPR2026-00137

I. INTRODUCTION

Petitioner, Samsung Electronics Co., Ltd., filed a Petition requesting an *inter partes* review of claims 1–19 of U.S. Patent No 9,647,918 B2 (Ex. 1001, "the '918 patent"). Paper 2 ("Pet."). Patent Owner, Headwater Research LLC, filed a Preliminary Response. Paper 7 ("Prelim. Resp."). With permission of the Board, Petitioner filed a Preliminary Reply ("Reply") (Paper 9) and Patent Owner filed a Pre-Institution Sur-reply ("Sur-reply") (Paper 10). Based on the authority delegated to us by the Director under 37 C.F.R. § 42.4(a), we decline to institute this *inter partes* for the reasons below.

A. Related Matters

The parties indicate that the '918 patent is at issue in *Headwater Research LLC v. Samsung Electronics Co., Ltd.*, 2-23-cv-00641 (EDTX). Pet. 101; Paper 4, 1. The '918 patent is also the challenged patent in IPR2024-01396.

B. The '918 Patent

The '918 patent is directed to "[a] wireless end-user device has a wireless modem, a network stack configurable to receive and transmit data via the modem and a wireless network, and two Application Programming Interfaces (APIs) available to device applications." Ex. 1001, code (57). According to the '918 patent, "[t]he first API allows applications to open and use data flows via the network stack" while "[t]he second API allows applications to make data transfer requests for media objects" through "a media service manager." *Id.* Figure 32 of the '918 patent is reproduced below.

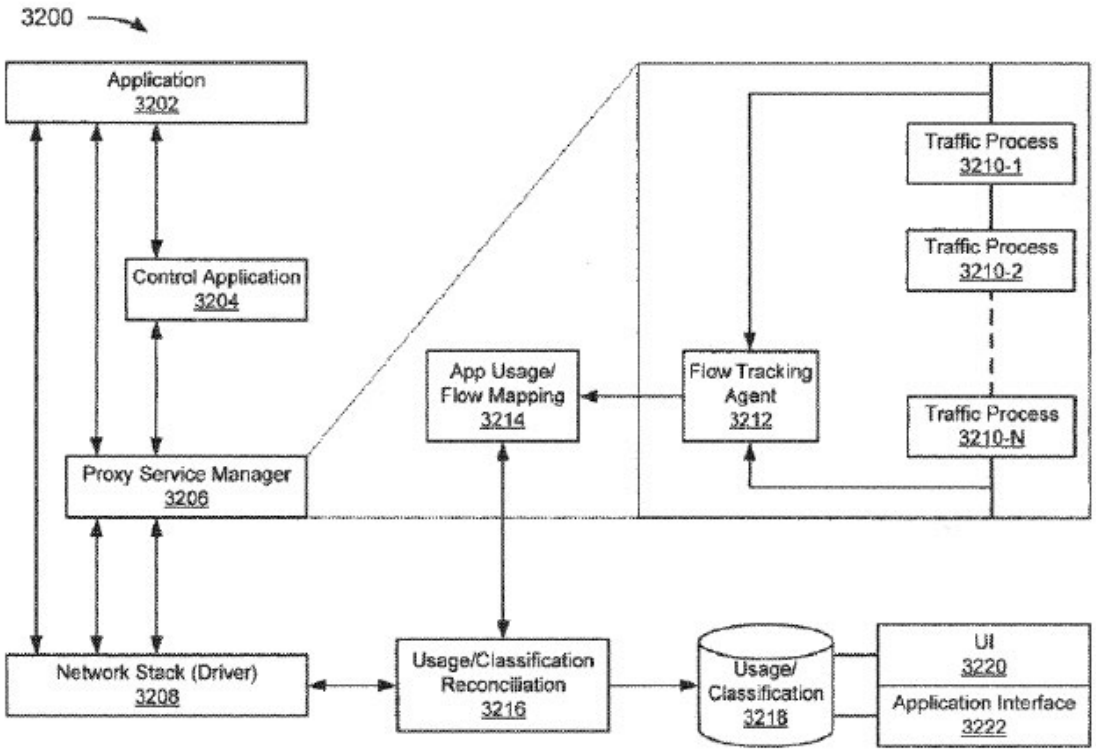

FIG. 32

Figure 32 depicts a system "for classification mapping using virtual tagging." *Id.* at 116:39–40. "The system 3200 includes an application 3202, a control application 3204, a proxy service manager 3206, [and] a network stack (driver) 3208." *Id.* at 116:40–42.

C. Challenged Claims

Of the challenged claims, claims 1, 14, 15, and 19 are independent. Independent claim 1 is illustrative of the challenged claims and is reproduced below.

> 1. A wireless end-user device, comprising:
>
> a wireless modem configurable to connect to a wireless network;
>
> a network stack configurable to receive and transmit data via the wireless modem and the wireless network;

> a first network stack Application Programming Interface (API), containing at least one first call accessible to each of a plurality of device applications, the first network stack API callable by each of the plurality of device applications to open and use data packet flows via the network stack, the wireless modem, and the at least one wireless network;
>
> a second API containing at least one second call accessible to each of the plurality of device applications, the second API callable by each of the plurality of device applications to make a data transfer request for a media object associated with a network resource identifier supplied by the calling device application;
>
> a media service manager prompted by the second call, to manage network data transfers for the media object by interfacing with the network stack to retrieve the media object associated with the network resource identifier via the wireless modem and the wireless network; and
>
> one or more service classification and measurement agents to associate wireless network data usage for the media object network data transfers with the device application that requests the data transfer for the media object, to associate wireless network data usage for respective data packet flows opened and used via the first network stack API with the device application opening such respective data packet flow, and to reconcile wireless network data usage for each of the plurality of device applications to track an aggregate wireless network data usage attributable to each of the plurality of device applications via both the first network stack API and the second API.

Id. at 104:28–64.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–19 on the following grounds of unpatentability. Pet. 1–2.

Claims Challenged	35 U.S.C. §	References/Basis
1, 9, 13, 14	103	Bennett[1], Rakoshitz[2], Rybak[3]
2–6, 8, 11, 15–17, 19	103	Bennett, Rakoshitz, Rybak, Riggs[4]
7, 12, 18	103	Bennett, Rakoshitz, Rybak, Riggs, Hendrickson[5]
10	103	Bennett, Rakoshitz, Rybak, Riggs, Srikantan[6]

II. DISCRETIONARY DENIAL BASED ON MULTIPLE PETITIONS

Patent Owner asserts we should deny the Petition because this is one of two petitions challenging the same claims of the '918 patent. *See* Prelim. Resp. 22–25. As our Consolidated Trial Practice Guide explains, "one petition should be sufficient to challenge the claims of a patent in most situations." PTAB Consolidated Trial Practice Guide (Nov. 2019) at 59. However, the Trial Practice Guide recognizes that "there may be circumstances in which more than one petition may be necessary," including "when there is a dispute about priority date requiring arguments under multiple prior art references." *Id*.

Here, Petitioner explains it filed a second Petition to address a potential priority date dispute. Paper 3, 3–5. Specifically, in related IPR2024-01396, Petitioner included a reference that would not qualify as prior art if Patent Owner is entitled to the '918 patent's earliest listed priority claim, which Petitioner contests. Paper 3, 4. Petitioner asserts two

---

[1] U.S. 2006/0149811 A1, Pub. July 6, 2006 (Ex. 1041, "Bennett").
[2] U.S. 6,578,077 B1, June 10, 2003 (Ex. 1046, "Rakoshitz").
[3] EP 1850575 A1, Oct. 31, 2007 (Ex. 1044, "Rybak").
[4] U.S. 8,429,516 B1, Apr. 23, 2013 (Ex. 1043, "Riggs").
[5] U.S. 6,754,470 B2, June 22, 2004 (Ex. 1054, "Hendrickson").
[6] U.S. 2002/0056126, Pub. May 9, 2002 (Ex. 1055, "Srikantan").

alternative references in this IPR that qualify as prior art even if Patent Owner is entitled to '918 patent's the earliest listed priority claim. *Id.*

In its Preliminary Response, however, Patent Owner stipulates that it will not assert a priority claim that would disqualify the potentially vulnerable reference in IPR2024-01396. Prelim. Resp. 24–25. Thus, there is no longer a priority-date dispute to justify two Petitions. Because Petitioner ranks the petition in IPR2024-01396 higher in preference than its Petition here, we exercise our discretion not to institute review in this proceeding under 35 U.S.C. § 314(a).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied, and no *inter partes* review is instituted in this case.

For PETITIONER:

W. Karl Renner
Axf-ptab@fr.com

Jeremy Monaldo
jjm@fr.com

Jennifer Huang
jjh@fr.com

For PATENT OWNER:

Reza Mirzaie
rmirzaie@raklaw.com

Dale Chang
dchang@raklaw.com

Amy Hayden
ahayden@raklaw.com

James Milkey
jmilkey@raklaw.com

Neil Rubin
nrubin@raklaw.com

Philip Wang
pwang@raklaw.com