UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.

Petitioner,

v.

HEADWATER PARTNERS II LLC,

Patent Owner.

IPR2025-00426

Patent 9,094,868 B2

PATENT OWNER'S PRELIMINARY RESPONSE

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I. INTRODUCTION

The Board should deny institution of *inter partes* review ("IPR") of U.S. Patent No. 9,094,868 ("the '868 patent") due to a clear failure of the merits of the Petition.

Patent Owner has disclaimed all challenged of the '359 patent except for claims 11-15 (i.e., Patent Owner has disclaimed claims 1-10 and 16-34), leaving claims 11-15 as the only remaining claims challenged by this Petition.[1] Because the Board may not institute an *inter partes* review based on disclaimed claims,[2] institution of this proceeding is appropriate only if the Petition can demonstrate a reasonable likelihood of prevailing with respect to claim 11-15. And because claims 12-15 each depend from claim 11, the Petition must demonstrate a reasonable likelihood of prevailing with respect to claim 11, which requires *inter alia* "determining a UE environment information."

The Petition, however, does not make any plausible showing that the prior art discloses "determining a UE environment information." Instead, the Petition presents only a single conclusory sentence that this limitation is satisfied, and quotes disclosures from Jarvinen (the only prior art reference relied on for this limitation)

[1] Patent Owner does not concede the merits of the Petition's challenges as to any claims; disclaimer of the referenced claims is merely to simplify proceedings.
[2] 37 C.F.R. § 42.107(e) ("No inter partes review will be instituted based on disclaimed claims.").

as teaching that a database is "updated constantly with new data" which will "***adapt the database*** to changes in" the alleged UE environment, such as changes in "newly constructed buildings," "season of the year, weather, traffic, etc." Pet. 54.[3] The Petition makes no showing that any of this alleged "UE environment information" is ***determined*** as required by the claims. For example, the Petition does not even allege, much less show, that Jarvinen discloses determining whether any buildings have been newly constructed, determining whether the seasons have changed, or determining traffic conditions, as would be required under the Petition's theory.

Accordingly, the Petition fails to present any cognizable theory under which claim 11 (and claims 12-15, which depend from claim 11) are disclosed by the prior art.

II. LEVEL OF ORDINARY SKILL IN THE ART

The Petition proposes that a POSITA in the field of the '868 patent "would have been someone with at least (1) a bachelor's degree in electrical engineering, computer engineering/science, or a related scientific field, and (2) either (a) a master's degree in electrical engineering, computer engineering/science, or a related fi[el]d, or (b) two or more years of work or research experience in wireless networking and/or computing." *See* Pet. at 9 (citing Ex. 1012 ¶20). For purposes of this Preliminary Response, Patent Owner does not challenge that definition.

[3] All emphases added unless otherwise noted.

III. CLAIM CONSTRUCTION

The Petition states that "all claim terms should be given their plain and ordinary meaning as would be understood in the context of the '868 Patent's disclosure." *Id.* at 9-10. For purposes of this Preliminary Response, Patent Owner agrees.

IV. THE PETITION FAILS TO SHOW A REASONABLE LIKELIHOOD OF UNPATENTABILITY FOR ANY CHALLENGED CLAIM.

As noted above, all challenged claims are disclaimed other than claims 11-15, and each of claims 12-15 depend from claim 11. Accordingly, institution should be denied unless the Petition demonstrates a reasonable likelihood of prevailing with respect to claim 11, which requires *inter alia* "determining a UE environment information."

The Petition's treatment of claim 11 consists entirely of a conclusory allegation that "Jarvinen also discloses [the claim language]," with no supporting evidence or analysis other than a string citation to Jarvinen, as well as a citation to an expert declaration that provides the same conclusory allegation (modified only to specify that the conclusory allegation is the expert's "opinion"). The ***entirety*** of the Petition's treatment of claim 11 is reproduced below.

> **19. Claim 11: The method of claim 7, further comprising determining a UE environment information, wherein at least a portion of the link quality positioning information is based on the UE environment information.**
>
> Jarvinen also discloses determining UE environment information, wherein at least a portion of the link quality positioning information is based on the UE environment information. (Jarvinen, ¶¶0039 ("The database may be updated constantly with new data to adapt the database to ***changes in the radio environments*** related to different geographical locations. . . . The ***radio environment*** may have changed due to newly constructed buildings[.]"), 0062 ("Several factors may affect the actual transmission properties with given transmission conditions. Such factors include ***season of the year***, ***weather, traffic***, etc."); McClellan, ¶96. *See also* Jarvinen at ¶¶0058-59.)

Pet. 50.

As shown above, the Petition points to "radio environments" including "newly constructed buildings," "season of the year, weather, traffic, etc." as being the alleged "UE environment information." However, the Petition makes no showing whatsoever that Jarvinen discloses ***determining*** this UE environment information, as opposed to merely "constantly" updating its database "with new data" which will "adapt the database to changes" in the alleged UE environment information. Pet. 50. For instance, the Petition makes no showing at all that Jarvinen discloses determining any "radio environments" such as "newly constructed buildings,"

"season of the year," "weather, or "traffic." Of course, as Jarvinen discloses, the information in the constantly-updated database may be influenced in some respect by environmental factors such as newly-constructed buildings or changing weather, but that is different than Jarvinen's method ***determining*** that the weather has changed or any buildings have been constructed.

In short, ***none*** of the few citations to Jarvinen disclose anything about "determining" the alleged UE environment information under the Petition's claim mapping, and the Petition thus fails to demonstrate a reasonable likelihood of prevailing as to this limitation.

Finally, the Petition's citation to the McClellan declaration (Ex. 1012) at paragraph 96 does nothing to remedy the Petition's deficiency. The entirety of the Dr. McClellan's analysis of claim 11 is reproduced below:

> **9.19 Claim 11: The method of claim 7, further comprising determining a UE environment information, wherein at least a portion of the link quality positioning information is based on the UE environment information.**
>
> 96. Claim 11 is dependent upon Claim 7, all limitations of which are disclosed in Jarvinen, in my opinion, as discussed in Sections 9.1-9.9 and 9.15. In addition, it is my opinion that Jarvinen also discloses determining UE environment information, wherein at least a portion of the link quality positioning information is based on the UE environment information. (Jarvinen, ¶¶0039 ("The database may be updated constantly with new data to adapt the database to ***changes in the radio environments*** related to different geographical locations. . . . The ***radio environment*** may have changed due to newly constructed buildings[.]"), 0062 ("Several factors may affect the actual transmission properties with given transmission conditions. Such factors include ***season of the year***, ***weather, traffic***, etc."). *See also* Jarvinen at ¶¶0058-59.) In my opinion, this limitation is met.

Ex. 1012 ¶96.

As shown above, Dr. McClellan provides only the same conclusory allegation as in the Petition (with the additional caveat that the allegation is in his words "my opinion"). His declaration should be afforded little if any weight, and cannot support a showing that the Petition is reasonably likely to prevail as to claim 11. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper No. 9 at 15 (Aug 24, 2022) (precedential) (giving "little weight" to "cited declaration testimony [that] is conclusory and

unsupported" and "adds little to the conclusory assertion for which it is offered to support").

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that institution be denied.

Date: May 2, 2025

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 954 words in the paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

Date: May 2, 2025

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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 May 2, 2025, 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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