

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Gregory G. Raleigh et al. Attorney Docket No.: 39843-0183IP1
U.S. Patent No.: 9,609,510
Issue Date: March 28, 2017
Appl. Serial No.: 14/208,236
Filing Date: March 13, 2014
Title: AUTOMATED CREDENTIAL PORTING FOR MOBILE
DEVICES

Mail Stop Patent Board

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF UNITED STATES PATENT NO. 9,609,510

Based on the significant number of claims (**48**) of U.S. Patent No. 9,609,510 (the “510 Patent”) that Headwater Research LLC (“Patent Owner”) has asserted against Samsung Electronics Co., Ltd. (“Petitioner”) in co-pending district court litigation, Petitioner is filing herewith two IPR petitions that collectively address all 48 asserted claims based on a single set of obviousness grounds anchored by the same primary reference U.S. Pub. 2009/0217364 (EX1004, “Salmela”).

I. Ranking of Petitions

As discussed below in § II, multiple petitions are necessary to explain the various relevant aspects of the applied prior art that render all 48 asserted claims of the ’510 patent unpatentable. Still, given the juxtaposition of a 14,000 word limit for each petition and recitation by Patent Owner of non-overlapping subject matter between various Challenged Claims, two petitions were needed to address the full complement of claims and claim limitations recited by them (and those they depend from). Both petitions are meritorious and justified, and yet, Petitioner below provides the requirement for ranking:

<u>Rank</u>	<u>Petition</u>	<u>Asserted Obviousness Grounds</u>
1	IPR2025-00483	<ul style="list-style-type: none">• Claims 1-3, 6-7, 11, 14-25, 28-33, 35-39, 41-43, 45-48: Salmela, Rishy-Maharaj
2	IPR2025-00484	<ul style="list-style-type: none">• Claims 21, 23, 25: Salmela, Rishy-Maharaj, Bennett• Claims 26-27: Salmela, Rishy-Maharaj, Bennett, FCCReg

<u>Rank</u>	<u>Petition</u>	<u>Asserted Obviousness Grounds</u>
		<ul style="list-style-type: none">• Claims 12-13: Salmela, Rishy-Maharaj, Ionescu• Claims 4-5, 8-10: Salmela, Rishy-Maharaj, Sigmund• Claims 40: Salmela, Rishy-Maharaj, Johansson• Claims 34: Salmela, Rishy-Maharaj, Slavov• Claims 44: Salmela, Rishy-Maharaj, Gupta

II. Material Differences Compelling Permitting Multiple Petitions

The Board has routinely recognized that multiple petitions are justified and “necessary” “when the patent owner has asserted a large number of claims in litigation.” Consolidated Trial Practice Guide (November 2019), 59. That is squarely the case here. Patent Owner is asserting all 48 claims of the ’510 Patent against Petitioner in co-pending litigation in the Eastern District of Texas, including many dependent claims (46) that add to the independent claims a wide range of additional features with little overlap between different ones of the dependent claims. *See* EX1001, claims 1-48; EX1103, 1-2. Put simply, the need for multiple petitions is a direct result of Patent Owner’s decision to draft 48 claims and to assert all 48 of these claims in co-pending litigation. Indeed, the 48 claims of the ’510 Patent are more than double the base number of 20 claims for a single petition.

Because Patent Owner has asserted all 48 claims of the ’510 Patent, the IPR petition word limit effectively limits Petitioner to a single ground with respect to

nearly all of the claims – even though Petitioner has filed two petitions. Indeed, between them, the two petitions collectively challenge 45 of the 48 claims of the '510 Patent using just one obviousness ground per claim. This is not a situation where the two petitions present redundant challenges to the claims under multiple grounds. On the contrary, Petitioner is challenging only three of the 48 asserted claims—i.e., claims 21, 23, and 25—under multiple grounds (i.e., based on Salmela/Rishy-Maharaj in the first petition and based on Salmela/Rishy-Maharaj/Bennett in the second petition), which is necessary to address two possible interpretations of the claim term “phone number.” The first petition demonstrates that claims 21, 23, and 25 are obvious by mapping Salmela’s IMSI to the claimed “phone number[s].” The second petition then shows that these claims are obvious based on Bennett’s teaching of other types of phone numbers to the extent Patent Owner argues or the Board determines that Salmela’s IMSI is not a phone number.

Noticeably, however, and even if Petitioner had not separately challenged claims 21, 23, and 25 in the second petition, the challenges to the remaining claims in the second petition (i.e., claims 4-5, 8-10, 12-13, 26-27, 34, 40, and 44) that are not challenged in the first petition still require ~4,900 additional words. The challenges to claims 4-5, 8-10, 12-13, 26-27, 34, 40, and 44 thus could not reasonably be raised in a single petition alongside the other 36 claims challenged in

the first petition, especially as the challenges to the 36 claims addressed in the first petition have already been concisely drafted and edited to fit just within the 14,000 word count limit for a single petition.

Petitioner has also endeavored to minimize any burden on the Board and the parties in addressing the patentability challenges implicated by the two petitions. For example, the first petition challenges independent claims 1 and 47 in a single ground based on the combination of Salmela and Rishy-Maharaj. The remaining 46 dependent claims are all likewise challenged using combinations based on Salmela and Rishy-Maharaj, along with certain tertiary references that address additional features recited in the dependent claims. As a consequence, a substantial amount of analysis in the second petition overlaps that of the first petition in addressing the base limitations from claim 1, which is necessary to address the dependent claims challenged in the second petition. The overviews of Salmela, Rishy-Maharaj, and the combination of Salmela and Rishy-Maharaj, and the mapping of this combination to the limitations of claim 1 are thus substantially identical between the two petitions.

Moreover, the merits of the petitions justify institution of all petitions. The prior art combinations presented in the petitions are strong and straightforward. Where possible, the petitions present substantially overlapping material. Differences and additional prior art references in the second petition are

necessitated by Patent Owner's assertion of 48 claims that cover various sets of distinct features throughout. Efficiencies and public policy concerns warrant PTAB consideration of both petitions.

Finally, Petitioner's filings are not abusive. Rather, Petitioner merely requests an opportunity to present its invalidity arguments and two petitions are necessary to challenge the '510 Patent's 48 claims. Given the number of claims Patent Owner is asserting in the co-pending litigation, instituting multiple petitions is warranted. To ensure Petitioner is afforded a fair and complete opportunity to challenge Patent Owner's asserted claims, Petitioner respectfully requests institution of both petitions to prevent the unjust result of otherwise strong invalidity grounds being dismissed for procedural reasons. The goals of discretionary denial are not served by denial here.

For at least these reasons, Petitioner requests that the Board institute trial on both petitions.

Respectfully submitted,

Dated 02/10/2025

/Nicholas W. Stephens/

W. Karl Renner, Reg. No. 41,265
Jeremy J. Monaldo, Reg. No. 58,680
Nicholas Stephens, Reg. No. 74,320
Cameron A. Ubel, Reg. No. 77,081
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner