

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

HEADWATER RESEARCH LLC,

Patent Owner

IPR2026-00088
U.S. Patent No. 9,615,192

**PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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EXHIBIT LIST

No.	Description
1001	U.S. Patent No. 9,615,192 (“’192 patent” or “’192Pat”)
1002	File History of the ’192 patent (“’192FH”)
1003	Declaration and Curriculum Vitae of Dr. Patrick Traynor (“Traynor”)
1004	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 (“TS-23.140”)
1005	U.S. Patent Pub. No. 2006/0190720 to Ozaki et al. (“Ozaki”)
1006	WO 2008/048075 to Lee et al. (“Lee”)
1007	WO 2006/077283 to Houghton et al. (“Houghton”)
1008	U.S. Patent Pub. No. 2009/0158397 to Herzog et al. (“Herzog”)
1009	U.S. Patent No. 7,925,717 to Chou et al. (“Chou”)
1010	Open Mobile Alliance; Multimedia Messaging Service Architecture Overview (MMSARCH) specification, July 15, 2004, <i>available at</i> https://www.openmobilealliance.org/release/MMS/V1_1-20040715-A/OMA-WAP-MMS-ARCH-V1_1-20040715-A.pdf
1011	Open Mobile Alliance; OMA-ERELD-MMS-v1_2-20030923-C, Enabler Release Definition for MMS Version 1.2, Sept. 23, 2003, <i>available at</i> https://www.openmobilealliance.org/release/MMS/V1_2-20030923-C/OMA-ERELD-MMS-V1_2-20030923-C.pdf
1012	U.S. Patent No. 7,509,487 to Lu et al. (“Lu”)
1013	Technical Specification Group Services and System Aspects Meeting #19, TSGS#19(03)0167, European Telecommunications Standards Institute February 2003, Mar. 12, 2003, <i>available at</i> https://www.3gpp.org/ftp/tsg_sa/TSG_SA/TSGS_19/Docs/PDF/SP-030167.pdf
1014	U.S. Patent Pub. No. 2005/0207379 to Shen et al. (“Shen”)
1015	U.S. Patent Pub. No. 2009/0282256 to Rakic et al. (“Rakic”)
1016	Declaration of Friedhelm Rodermund
1017	U.S. Patent Pub. No. 2009/0240807 to Munson et al. (“Munson”)
1018	EP Patent Application EP1853044 to Shenfield (“Shenfield”)
1019	U.S. Patent No. 7,082,615 to Ellison et al. (“Ellison”)
1020	U.S. Patent Pub. No. 2005/0144294 to Gellens et al. (“Gellens”)
1021	U.S. Patent Pub. No. 2008/0162637 to Adamczyk et al. (“Adamczyk”)
1022	Dismissal with Prejudice, <i>Headwater Research LLC v. Samsung Electronics Co.</i> , Case No. 2:23-cv-00103 (E.D. Tex. May 1, 2025), ECF No. 438

No.	Description
1023	Claim Construction Order, <i>Headwater Research LLC v. Samsung Electronics Co.</i> , Case No. 2:23-cv-00103 (E.D. Tex. Aug. 22, 2024), ECF No. 118
1024	Gang Lu, et al., <i>Heading for Multimedia Message Service in 3G</i> , 6th IEE International Conference on 3G and Beyond, Washington, D.C., USA, Nov. 7-9, 2005
1025	RFC 4355, IANA Registration for Enumservices Email, Fax, MMS, EMS, and SMS (Jan. 2006)
1026	Friedhelm Rodermund, <i>A Picture Speaks a Thousand Words – From SMS to MMS, in Business Briefing: Wireless Technology</i> (2003)
1027	IETF RFC 793, Transmission Control Protocol (Sept. 1981), available at https://www.ietf.org/rfc/rfc793.txt
1028	The TLS Protocol Version v 1.0 (Jan. 1999), available at https://datatracker.ietf.org/doc/html/rfc2246
1029	Complaint for Patent Infringement, <i>Headwater Research LLC v. Samsung Electronics Co.</i> , Case No. 2:23-cv-00103 (E.D. Tex. Mar. 10, 2023), ECF No. 1
1030	Roger M. Needham & Michael D. Schroeder, <i>Using Encryption for Authentication in Large Networks of Computers</i> , ACM, Vol. 21, No. 12 (Dec. 1978) (“Needham”)
1031	Michael D. Schroeder & Jerome H. Saltzer, <i>A Hardware Architecture for Implementing Protection Rings</i> ACM, Vol. 15, No. 3 (Mar. 1972) (“Schroeder”)
1032	Jerome H. Saltzer & Michael D. Shroeder, <i>The Protection of Information in Computer Systems</i> IEEE Proceedings, Vol. 63, No. 9 (Sept. 1975) (“Saltzer”)
1033	Bo Li et al., <i>Symbian OS platform security model</i> , in <i>Login Magazine</i> (Aug. 2010) available at https://www.usenix.org/system/files/login/articles/73507-li.pdf (“Li”)
1034	Philip Zimmermann, <i>Pretty Good Privacy: RSA Public Key Cryptography for the Masses, PGP User’s Guide, Version 1.0</i> , (June 1991), available at https://www.techinsider.org/freesoftware/research/acrobat/910605.pdf (“Zimmerman”)
1035	B. Ramsdell, <i>S/MIME Version 3 Message Specification</i> , IETF RFC 2633 (June 1999), available at https://datatracker.ietf.org/doc/html/rfc2633 (“Ramsdell”)

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1036	Miraj E. Mostafa, <i>Transporting data between wireless applications using a messaging system—MMS</i> (Wireless Comms. and Mobile Computing (July 7, 2006) (“Mostafa”))
1037	RESERVED
1038	RESERVED
1039	U.S. Patent Pub. No. 2003/0126282 to Sarkar et al. (“Sarkar”)
1040	U.S. Patent Pub. No. 2007/0037610 to Logan (“Logan”)
1041	RESERVED
1042	RESERVED
1043	U.S. Patent Pub. No. 2004/0085894 to Wang et al. (“Wang”)
1044	RESERVED
1045	Simon Higginson, Platform Security Concepts, in SYMBIAN OS PLATFORM SECURITY: SOFTWARE DEVELOPMENT USING THE SYMBIAN OS SECURITY ARCHITECTURE, 17-41 (Craig Heath ed., 2006) (“Higginson”)
1046	Stipulation Letter
1047	RESERVED
1048	RESERVED
1049	RESERVED
1050	U.S. Patent No. 10,321,320 (“’320 patent” or “’320Pat”)
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1057	<i>Samsung v. Headwater</i> , IPR2024-00010, Paper 24 (transcript of hearing held Mar. 5, 2025)
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1059	<i>Samsung v. Headwater</i> , Paper 27, Termination Order (May 13, 2025)
1060	<i>Samsung v. Headwater</i> , IPR2024-00341, Paper 4, Petition for Inter Partes Review (Jan. 23, 2024)
1061	<i>Samsung v. Headwater</i> , IPR2024-00341, Paper 12, Institution Decision (July 26, 2024)

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1062	<i>Samsung v. Headwater</i> , IPR2024-00341, Paper 28, Final Written Decision (July 23, 2025)
1063	<i>Google v. Headwater</i> , IPR2024-00942, -943, Paper 20, Final Written Decision (Oct. 1, 2025)
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1065	<i>Headwater v. Samsung</i> , No. 2:23-cv-00103, Dkt. 434 (E.D. Tex. Apr. 29, 2025) (joint motion to dismiss '192 patent)
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1071	File History of U.S. 9,615,192
1072	cpc-definition-H04W, https://www.uspto.gov/web/patents/classification/cpc/pdf/cpc-definition-H04W.pdf
1073	MMS Architecture - Wikipedia, the free encyclopedia (Wayback Machine 9-9-2016)
1074	PTAB Institutions Search
1075	<i>Samsung v. Headwater</i> , IPR2024-00341, Paper 33 (Nov. 20, 2025) (Notice of Appeal)
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I. INTRODUCTION

The Board should reach the merits of this IPR challenging U.S. Patent No. 9,615,192 (“’192 patent,” EX1001). Discretionary denial is inappropriate here because this IPR is an appropriate use of Office resources, Amazon’s expectations outweigh those of Headwater Research LLC (“PO” or “Headwater”), and this IPR promotes efficiency. Further, as explained below, the *Fintiv* factors weigh against denial.

First, this IPR is an appropriate use of Office resources because it will allow the Office to correct the Examiner’s material error in failing to locate and apply TS-23.140, which is a primary reference presented in this Petition that the Board previously determined in an institution decision in IPR2024-00010 (“Samsung ’192 IPR”) demonstrated a reasonable likelihood that claim 1—and several other claims—were unpatentable.

Second, Amazon’s expectations outweigh any settled expectations PO claims to have. Starting in 2022 and for nearly three years and over twenty suits, PO’s litigation campaign asserted patents against wireless carriers and one of the world’s largest electronic device manufacturers (Samsung). The first time PO asserted any of its patents against Amazon was in 2025. But Amazon is predominantly a web-based services company, and Amazon could not have reasonably expected that PO would extend its litigation campaign outside these other core industries and target

Amazon on the theory that its patents generically cover push messaging technology. Further undermining PO's expectations as to the '192 patent, PO previously asserted it against Samsung, dropped the patent just before trial, and—after the Board determined there was a reasonable likelihood of unpatentability in the Samsung '192 IPR—PO sought and obtained termination on the eve of the final written decision (“FWD”). PO then immediately asserted the '192 patent against new defendants despite the Board's determination that there was a reasonable likelihood of unpatentability. Moreover, shortly after PO started its new litigation campaign, the Board issued FWDs determining claims of three related patents were unpatentable between July and October 2025, further undermining PO's settled expectations. These facts undermine PO's settled expectations and instead led Amazon to expect that (1) the '192 patent would not be asserted against it; and (2) even if the '192 patent was asserted, Amazon would be able to challenge it based on the same primary reference(s) asserted in the Samsung '192 IPR (as Amazon does here).

Third, this IPR promotes efficiency, both for the Office and the district courts/parties. The Office previously evaluated the same patent and the same primary references in the Samsung '192 IPR—and can leverage that work here. The Office can also leverage its work in IPR2024-00341 (“Samsung '733 IPR”), which involved one of the same primary references asserted here—TS-23.140—and resulted in a FWD of unpatentability. Moreover, reaching the merits of this IPR and

Amazon's co-pending IPR challenging a related patent (IPR2026-00106 challenging U.S. 10,321,320 ("320 patent")) at the same time promotes efficiency. The related '192 and '320 patents have claims with similar limitations, and the petitions present the same primary references. This IPR is also more efficient for the district courts/parties, as a FWD could avoid duplicative efforts in seven litigations involving the '192 patent split across three districts. And more generally, PO's complex litigation campaign—over thirty active cases collectively asserting more than twenty patents in three districts—indicates the Office is the most appropriate forum for evaluating the unpatentability of the eight patents¹ currently challenged at the Office both efficiently and consistently.²

II. BACKGROUND

PO or its affiliate is the assignee of hundreds of issued U.S. patents (EX1051), many of which appear to claim priority to U.S. App. 12/380,780 ("780 application") (EX1052). Patents claiming priority to the '780 application began issuing in 2012 (EX1053), with the '192 patent issuing in 2017 (EX1001). Yet, PO waited nearly a

¹ The Director discretionarily denied Amazon's petition in IPR2025-01571. The time for requesting rehearing or Director review has not expired.

² This IPR also promotes efficiency because an unpatentability determination would estop PO from obtaining patentably indistinct claims in related applications.

decade after its first patent issued to begin asserting its patents. In October 2022, and for the first two and a half years, PO or its affiliate filed over twenty suits against Samsung or cell phone carriers in E.D. Tex.³ EX1054. PO's litigation campaign has consisted of serial attacks against accused infringers, including six E.D. Tex. suits against Samsung from Oct. 2022-Aug. 2024. *Id.* None of PO's early cases involved Amazon. PO first asserted the '192 patent in 2023 in a case against Samsung in E.D. Tex. *Id.* PO did not assert the related '320 patent, which PO currently asserts against Amazon and others. Amazon has challenged the '320 patent in co-pending IPR2026-00106. The limitations of '320 patent claim 1 (directed to both a network and the devices the network communicates with) are materially similar, collectively, to the limitations of the '192 patent claim 1 (network) and the '733 patent claim 1 (device).

In November 2023, Samsung filed its '192 IPR challenging independent claims 1 and 15 and all but two dependent claims. EX1055. The Board instituted in May 2024 and held an oral hearing in March 2025. EX1056-57. The FWD would have been due 5/23/2025. However, the parties filed a joint motion to terminate in early May 2025, which the Board granted ten days before the FWD deadline. EX1058-59.

³ PO also filed suit against Motorola Mobility and Lenovo in N.D. Cal. (EX1054), which was stayed pending IPRs and then dismissed with prejudice.

In January 2024, Samsung filed another IPR (IPR2024-00341) challenging a patent with claims that include device-side limitations that are materially similar to those of the '320 patent—U.S. 8,406,733 (“’733 patent”). EX1060. The Board instituted in July 2024 and issued a FWD determining all challenged claims were unpatentable in July 2025. EX1061-62. Two FWDs also issued in October 2025 determining that all challenged claims of related patents⁴ were unpatentable. EX1063 (U.S. 8,589,541 (“’541 patent”)); EX1064 (US 9,198,042 (“’042 patent”)).

In April 2025, the Samsung litigation proceeded to trial—but not on the '192 patent. Instead, “[PO] elected not to pursue its claims under the '192 patent.” EX1065; EX1022.

Days after the Board terminated the Samsung '192 IPR, on May 16, 2025, PO started a new campaign—asserting the '192/'320 patents against Google in W.D. Tex. EX1054, 4. This was the first time PO asserted the '320 patent. The Google case was just recently transferred to N.D. Cal. EX1066.

The first time PO asserted any of its patents against Amazon was in June 2025, when it sued Amazon on the '192/'320 patents in W.D. Tex. EX1054, 4.

⁴ The '541, '042, '733, '192, and '320 patents are related because they all claim priority to the '780 application. EX1001, Cover; EX1067-69, Cover; EX1050, Cover.

Complicating the litigations further, between Sept. and Nov. 2025, PO asserted those patents against multiple defendants in E.D. Tex. In total, seven litigations involving the '192 and '320 patents are currently pending—one in W.D. Tex. (Amazon), one in N.D. Cal. (Google), and five in E.D. Tex. (against Walmart, Target, Uber, Supercell, and Tencent). EX1054, 4, 11; EX1066.

Despite first suing Amazon in W.D. Tex., PO inexplicably sued Amazon in E.D. Tex. in August 2025, asserting U.S. 8,667,571 and 9,198,117 and alleging infringement by many of the same products. EX1054, 6. The Amazon, Target, and Uber E.D. Tex. cases have been consolidated with the Walmart case for pre-trial purposes. EX1070. The Supercell and Tencent cases have not been consolidated with the Walmart case.

III. THIS IPR IS AN APPROPRIATE AND EFFICIENT USE OF OFFICE RESOURCES

A. This IPR Will Allow the Office to Correct a Material Error During Prosecution, Overriding Any PO Settled Expectations

The prosecution history of the '192 patent strongly suggests that the Office committed a material error in allowing the challenged claims. Specifically, during prosecution, the Examiner failed to locate and apply TS-23.140⁵—a primary reference asserted in this Petition that is a functional description of the Multimedia

⁵ The Examiner also should have located the Houghton/Munson references.

Messaging Service (“MMS”) published by 3GPP. This error was material because, based on the Board’s institution of the Samsung ’192 IPR,⁶ there is a reasonable likelihood that TS-23.140 teaches the limitations of ’192 patent claim 1 that the Examiner believed were inventive.

Although the Applicant submitted over one thousand references during prosecution, Applicant did not submit TS-23.140. EX1071, 377-470, 473-519, 770-80. The Examiner also did not independently locate TS-23.140. This is likely because the Examiner’s search strategy focused on narrow keyword-based searching for claim terms—e.g., “trigger,” “buffer,” “secure link,” and “message link server.” *Id.*, 579-649, 1039-49, 1055-71. There is no evidence the Examiner searched for 3GPP specifications. Thus, it is not surprising that the Examiner did not locate TS-23.140, because cellular standards do not necessarily use patentee-coined claim terms.

⁶ The Board’s determinations in the IPR regarding the ’733 patent are also relevant because they address TS-23.140 and its disclosure of device-side limitations, which are complementary to the network-side limitations of the ’192 patent. Petitioner focuses on the Samsung ’192 IPR because the Board’s determinations were regarding the same patent challenged here.

A reasonable search would have covered 3GPP publications⁷ describing conventional wireless messaging systems and located TS-23.140. The '192 patent is classified in CPC H04W (wireless communication networks) (EX1072), its specification discusses 3G/GSM cellular networks (among others) (EX1001, 12:50-13:15), and the claims are generally directed to a server that buffers and transmits messages to mobile end-user devices based on delivery triggers. Standardized cellular messaging services are squarely related to this subject matter, and 3GPP specifications should have been considered because they are published by the “world’s leading organization for developing and maintaining cellular telecommunications standards.” EX1016, ¶27. Further, the 3GPP 23-series relates to 3G/GSM systems described in the '192 patent (*see, e.g.*, EX1001, 12:50-13:15), and TS-23.140 provides a functional description of MMS—a message storage/delivery service that, as explained below, the Office has determined to be directly relevant to the unpatentability of the challenged claims. MMS was a well-known messaging service, and the TS-23.140 specification describing it was publicly accessible and would not have been difficult to find either on the 3GPP website or through internet searches. Thus, a reasonable Examiner search should

⁷ Even if the Examiner was not aware of 3GPP before, PO submitted two 3GPP specifications in an IDS. EX1071, 408.

have located TS-23.140. EX1016, ¶33, ¶¶44-70; EX1073, 2 (2016 “MMS Architecture” Wikipedia page mentioning TS-23.140).

During prosecution, the Examiner issued a single Office Action rejecting the then-pending claims. EX1071, 529-42. Specifically, the Examiner rejected independent claims 2 and 16 (corresponding to issued claims 1 and 15) based on the combination of Heinonen et al. (U.S. 7,151,764) in view of Zhou et al. (U.S. 2006/0182137). *Id.*, 534-36. In response, the Applicant argued that neither Heinonen nor the combination of Heinonen and Zhou taught, among other things, the following limitations that are materially similar to limitations of issued claim 1: a “message link server” (*see* issued limitation 1[pre]); a “transport services stack...,” (*see* issued limitation 1[a]); “wireless end-user devices comprising multiple software components authorized to receive messages via the device link agent on that device” (*see* issued limitation 1[b]); an “interface...” (*see* issued limitation 1[c1]); and a “message buffering system...” (*see* issued limitation 1[d1]). *Id.*, 762-63.

The Examiner subsequently allowed issued claim 1 with amendments that “clarif[ied] the claimed invention” (*id.*, 1038) but did not materially alter these limitations’ scope. *Id.*, 1032-33. The Examiner stated that the claims were allowable “for the reasons put forth in” Applicant’s remarks and “after further search and consideration.” *Id.*, 1036.

In the Samsung ’192 IPR, however, Samsung challenged claim 1 of the ’192

patent based on the same TS-23.140 presented in this Petition, and the Board determined there was a reasonable likelihood that TS-23.140 teaches the limitations that the Examiner believed were not taught in the prior art (including Heinonen and Zhou).⁸ EX1056, 11-27. This shows that the Examiner’s failure to locate and apply TS-23.140⁹ was a material error that this Petition—challenging claim 1 based on TS-

⁸ The Samsung ’192 IPR presented grounds based on the same primary references asserted in this Petition: TS-23.140 and Houghton-Munson. *Compare* EX1055, 1 with Paper 1, 3. In addition to claim 1, Samsung’s petition challenged independent claim 15 and all but two dependent claims. The Board also determined the remaining grounds demonstrated a reasonable likelihood of unpatentability. EX1056, 27-28.

⁹ The Office’s material error decisions typically focus on art before the Examiner, but here the Examiner’s material error was failing to locate and apply TS-23.140. Moreover, neither *Yealink* nor *Microsoft v. Partec* are limited to considered art. The Office should assess material error based on the obviousness legal standard—i.e., whether the claims would have been obvious to a POSITA presumed aware of all pertinent prior art. *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (obviousness is “determined entirely with reference” to a hypothetical POSITA); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986) (a POSITA “is presumed to be aware of all the pertinent prior art.”).

23.140—will permit the Office to correct. Even if PO had settled expectations based on the '192 patent's age, the Office's material error in failing to locate and apply TS-23.140 during prosecution overcomes them. *See, e.g., Anthony Inc. v. Controltec, LLC*, IPR2025-00559, Paper 12, 2 (July 16, 2025) (referring petitions based on a material error even though challenged patents were in force several years); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9, 2 (July 31, 2025) (referring petition based on material error despite “settled expectations”); *Yealink (USA) Network Tech. Co. v. Barco N.V.*, IPR2025-00491, Paper 18, 2-3 (June 25, 2025) (referring petition where Examiner failed to appreciate that claim referred to services “well known in the art”); *Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 2-3 (June 12, 2025) (referring petition and determining it was material error to overlook teachings of cited references and combined teachings with references not previously presented).

B. Amazon's Expectations Resulting From PO's Litigation and IPR Conduct Outweigh Any PO Settled Expectations

Even if the Office does not determine there was a material error during prosecution, Amazon's expectations here outweigh any PO settled expectations. Specifically, Amazon had the expectation that (1) the '192 patent would not be asserted against it; and (2) even if it was, Amazon would be able to challenge it based on the primary references in the Samsung '192 IPR.

As discussed in §II, PO has a history of complicated, multi-patent litigation,

often serially filing multiple suits against the same defendant. PO waited nearly six years after the '192 patent issued (in 2017) to ever assert it (for the first time in 2023). Further, for nearly three years and over twenty suits, PO's initial litigation campaign targeted wireless carriers and one of the world's largest electronic device manufacturers (Samsung). The first time PO asserted any of its patents against Amazon was in 2025. But Amazon is predominantly a web-based services company, and Amazon could not have reasonably expected that PO would extend its litigation campaign outside these other core industries and target Amazon on the theory that its patents generically cover push messaging technology. *See Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11, 2-3 (Sept. 4, 2025) (informative) (determining that fact that Patent Owner previously targeted “smartphones, tablets, and watches” and Petitioner—a hardware store proprietor—“did not have reason to anticipate assertion” of the patent “weigh[ed] against Patent Owner’s settled expectations and weigh[ed] in favor of Petitioner’s expectations”).

The Office's determination in *Home Depot* that the petitioner's expectations weighed against denial applies with even more force here because additional facts undermine PO's settled expectations. PO cannot plausibly assert that it had settled expectations in the '192 patent when: (1) the Board determined in the Samsung '192 IPR, well before PO sued Amazon, there was a reasonable likelihood the '192 claims

were unpatentable based on the same primary references asserted in this Petition¹⁰; (2) PO's actions in May 2025 resulted in the Board terminating the Samsung '192 IPR without issuing a FWD; and (3) PO immediately afterwards began a brand new litigation campaign asserting the '192 and '320 patents against Amazon and others, despite the Board's determination in the Samsung '192 IPR.

Moreover, before PO sued Amazon on the '192 patent, the Board had instituted at least twenty petitions challenging a Headwater patent (and considered many others). EX1074. And shortly afterwards, the Board issued three separate FWDs determining claims of three related patents were unpatentable. EX1062-64.¹¹ The institution decisions as to PO's patents—and three FWDs issuing shortly after PO sued Amazon determining that related patents' claims were unpatentable—further demonstrate PO did not have settled expectations. *See, e.g., Mercedes-Benz Grp. AG v. The Phelan Grp., LLC*, IPR2025-00413, Paper 13, 2 (June 25, 2025) (referring petition where “claims of a related patent were recently found unpatentable”).

¹⁰ The Samsung '192 IPR institution decision also determined there was a reasonable likelihood of unpatentability based on Houghton-Munson (also asserted here).

¹¹ PO appealed the FWD in the '733 patent IPR. EX1075.

C. This IPR Promotes Efficiency

1. The Office's Previous Investment and the Scale of PO's Litigations Demonstrate This IPR Promotes Efficiency

This IPR is an efficient use of Office resources. The Office previously evaluated the all but two of the same claims and the same primary references in the Samsung '192 IPR (and further, evaluated TS-23.140 in the '733 IPR FWD). §§II, III.B. Thus, the Office can leverage work it has already done. Moreover, considering the merits of this IPR and the co-pending '320 IPR at the same time would be efficient, as the related patents have similar claims and the Petitions present the same primary references. *See, e.g., Embody, Inc. v. Lifenet Health*, IPR2025-00248-249, Paper 13, 3 (June 26, 2025) (determining it was efficient to refer a second patent related to a first patent for which discretionary denial was inappropriate).

This IPR is also more efficient for the district courts and the parties. Specifically, evaluating unpatentability in this IPR (and the '320 IPR) and reaching a FWD could avoid duplicative efforts in seven litigations involving the '192/'320 patents split across three districts. EX1054, 4, 11; EX1066. More generally, the complexity of PO's litigation campaign indicates that the Office, rather than the district courts, is the most appropriate forum for evaluating unpatentability. PO currently asserts twenty-seven patents across thirty active cases. EX1054. There are IPRs challenging eight patents that PO currently asserts, including this IPR and Amazon's '320 IPR. EX1076. The Office is better positioned than the district courts

to address unpatentability of these patents consistently—and doing so would be efficient given the Office’s prior investment. *See* §III.B. This also favors reaching this IPR’s merits. *See, e.g., Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217 et al., Paper 9, 2-3 (June 13, 2025) (informative) (“The large number and vast scope of the patents asserted in the district court litigation...weighs against discretionary denial”).

2. A FWD of Unpatentability Would Estop PO From Obtaining Patentably Indistinct Claims in Dozens of Pending Applications

PO has filed hundreds of applications claiming priority to the ’780 application, with about thirty pending. EX1052. If the challenged claims are held unpatentable, PO would be estopped from obtaining patentably indistinct claims, thus avoiding the need to relitigate invalidity (before the Office or elsewhere). 37 C.F.R. §42.73(d)(3)(i); *SoftView LLC v. Apple Inc.*, 108 F.4th 1366 (Fed. Cir. 2024).

IV. THE *FINTIV* FACTORS WEIGH HEAVILY AGAINST DENIAL

A. Factor 1: The Likelihood of a Stay Is Neutral

This factor is neutral, and PO agrees.¹² DD Request, 4-5. Amazon has filed a motion to stay, which remains pending. EX1077. “In the absence of specific

¹² Despite statistics (DD Request, 4-5), the court may determine a stay is warranted here. *ParkerVision, Inc. v. NXP Semiconductors N.V.*, No. 6:23-cv-00389, Dkt. 110, 8 (W.D. Tex. May 27, 2025) (granting stay where FWDs were due before trial).

evidence,” the Board “will not attempt to predict” how the parallel litigation will proceed, and this factor is neutral. *Sand Revolution II, LLC v. Cont’l Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24, 7 (June 16, 2020) (informative).

B. Factor 2: The Trial Date Weighs Against Denial Because Trial Will Occur After the Expected FWD

PO effectively concedes this factor does not favor denial. DD Request, 5. Trial is scheduled to begin June 14, 2027 (EX1078, 5), which is nearly a month after the expected FWD on May 20, 2027. Statistics project trial in Nov./Dec. 2027. EX1079, 37. This factor thus weighs against denial. *See, e.g., Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, -00407, Paper 14, 2 (May 16, 2025) (discretionary denial inappropriate where FWD and scheduled trial were in same month, but statistics projected trial months after FWD).

C. Factor 3: The Investment in the Parallel Litigation Weighs Against Denial Because the Litigation Is in Its Early Stages

PO concedes this factor does not favor denial. DD Request, 5 (“the case is still in its relatively early stages”). Amazon diligently filed this Petition, and investment in the parallel litigation is minimal. The parties have exchanged preliminary infringement/invalidity contentions and are engaging in claim construction briefing. The *Markman* hearing is scheduled in April 2026. EX1078, 3. Fact discovery does not open until April 2026. *Id.* The deadlines for fact discovery close/opening expert reports are months away (Nov./Dec. 2026). *Id.* Accordingly, this factor weighs

against denial. *See, e.g., Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23, 2-3 (July 2, 2025).

D. Factor 4: The Lack of Overlap Between Issues Raised in the Petition and the Parallel Litigation Weighs Heavily Against Denial

Lack of overlap between proceedings weighs heavily against denial. Amazon has submitted a *Sotera* stipulation, agreeing to be “bound by the full scope of estoppel under 35 U.S.C. § 315(e)(2).” EX1046. Amazon’s stipulation covers the full breadth of statutory estoppel (*see* 35 U.S.C. §§311(b) and 315(e)(2)) and weighs strongly against denial. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (Dec. 1, 2020) (precedential as to §II.A); *see also, e.g., Apple Inc. v. Vampire Labs, LLC*, IPR2025-01215, Paper 8, 8-9 (Oct. 17, 2025) (referencing *Sotera* stipulation); *Apple Inc.*, IPR2025-01215, Paper 10, 2 (Dec. 1, 2025) (granting institution); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00969, Paper 8, 2 (Sept. 18, 2025) (referencing *Sotera* stipulation); *Google LLC*, IPR2025-00969, Paper 13, 2 (Oct. 10, 2025) (referring petition); *Google LLC*, IPR2025-00969, Paper 19, 2 (Jan. 12, 2026) (denying Director Review).

In support of its argument that this factor strongly favors denial, PO contends that Amazon’s stipulation is “not sufficient” because it would allow Amazon to rely on Petition art in combination with system art. DD Request, 5-7. However, as Amazon explained in the parallel litigation, Amazon’s *Sotera* stipulation would greatly simplify the parallel litigation because—if IPR is instituted—it precludes

Amazon from raising the vast majority of prior art arguments presented in its invalidity contentions. EX1080, 4 (stating stipulation would apply to 21 out of 23 references asserted in preliminary invalidity contentions).

PO also argues this factor favors denial based on a hypothetical argument suggesting that Amazon may also file an *ex parte* reexamination (“EPR”). DD Request, 7-8. Contrary to PO’s suggestion, the Director has never required a stipulation agreeing to forgo EPR for an IPR to be instituted. Regardless, Amazon stipulates it will not file an EPR while this IPR is pending.

E. Factor 5: The Parties Factor Weighs Against Denial Because the FWD Is Likely to Precede the Trial

PO contends this factor (same parties) favors denial (DD Request, 8), but the Board has held otherwise in these circumstances. Specifically, when the FWD “is likely to issue before the district court trial,” the Board has “weigh[ed] this factor against exercising discretion.” *BMW of N. Am., LLC v. Mich. Motor Techs. LLC*, IPR2023-01234, Paper 11, 14-15 (Jan. 26, 2024) (collecting cases).

F. Factor 6: Other Circumstances Weigh Heavily Against Denial

There are compelling reasons to reach this IPR’s merits. §§III-IV.E. Indeed, the Office has already determined in the Samsung ’192 IPR that there is a reasonable likelihood of unpatentability based on the same primary references. Thus, this factor

weighs heavily against denial, and PO's arguments to the contrary are meritless.¹³

1. Amazon's Expectations Outweigh Any PO Settled Expectations

PO argues the patent's age and licensing support settled expectations. DD Request, 2-3, 8-9. Amazon's expectations, however, outweigh any expectations PO claims. §III.B. Further, regarding licensing, PO's cited evidence is dated in September 2025 or later and does not support settled expectations for multiple reasons. *See* EX2001-2005. First, the alleged licensing evidence is dated after PO sued Amazon on June 20, 2025¹⁴ and thus does not indicate that, when PO sued Amazon, it expected Amazon would not challenge the '192 patent. Second, three of four documents are dated after the Petition's 11/10/25 filing date. *See* Paper 1; EX2001-2002; EX2004-2005. PO's single alleged license as of the Petition filing date does not demonstrate that PO engaged in "significant licensing activity" (DD Request, 2) or that PO expected Amazon would not challenge the '192 patent. Third, PO's licensing evidence is dated after the Samsung '192 IPR and other related other IPRs were instituted and after the '733 FWD issued. It would be unreasonable for

¹³ PO also contends there have been no changes in law. DD Request, 3. This neither weighs against nor in favor of discretionary denial.

¹⁴ PO does not cite an agreement relating to settlement of the Samsung '192 patent IPR. Regardless, this would not demonstrate "significant licensing activity."

PO to expect the '192 patent's claims would not be challenged when the '192 patent and other related patents were already subject to significant IPR activity.

2. The Petition Appropriately Relies on Obviousness Grounds

PO argues that the Petition does not present “compelling merits” because it does not assert anticipatory art. DD Request, 9. However, the Board determined that Samsung's '192 IPR presenting obviousness grounds based on the same primary references demonstrated a reasonable likelihood of unpatentability. Moreover, the Office has routinely determined that obviousness grounds support institution. *See, e.g., Apple Inc.*, IPR2025-01215, Paper 2, 9 (June 27, 2025) (presenting obviousness grounds); *id.*, Paper 10, 2 (granting institution).

V. CONCLUSION

There are persuasive reasons to reach the merits of this IPR, and PO's request for discretionary denial should be denied.

Dated: February 20, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of Petitioner's Brief Opposing Discretionary Denial and EXHIBITS 1050 – 1080 were served upon the below listed counsel by electronic mail:

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