

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

IPR2026-00106
U.S. Patent No. 10,321,320

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

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No.	Description
1001	U.S. Patent No. 10,321,320 (“’320 patent” or “’320Pat”)
1002	File History of the ’320 patent (“’320FH”)
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-ERELED-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-ERELED-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

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1014	U.S. Patent Pub. No. 2005/0207379 to Shen et al. (“Shen”)
1015	RESERVED
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	RESERVED
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
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), <i>available at</i> https://www.ietf.org/rfc/rfc793.txt
1028	The TLS Protocol Version v 1.0 (Jan. 1999), <i>available at</i> https://datatracker.ietf.org/doc/html/rfc2246

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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
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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”)
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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”)
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	U.S. Patent Pub. No. 2008/0243999 to Pazhyannur et al. (“Pazhyannur”)
1038	U.S. Patent Pub. No. 2008/0215883 to Fok et al. (“Fok”)
1039	U.S. Patent Pub. No. 2003/0126282 to Sarkar et al. (“Sarkar”)

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1041	U.S. Patent Pub. No. 2005/0091380 to Gonen et al. (“Gonen”)
1042	U.S. Patent Pub. No. 2004/0258063 to Raith et al. (“Raith”)
1043	U.S. Patent Pub. No. 2004/0085894 to Wang et al. (“Wang”)
1044	U.S. Patent No. 6,094,424 to Kalmanek et al. (“Kalmanek”)
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	U.S. Patent Pub. No. 2003/0193967 to Fenton et al. (“Fenton”)
1047	U.S. Patent Pub. No. 2004/0111476 to Trossen et al. (“Trossen”)
1048	U.S. Patent Pub. No. 2005/0282531 to Andreasson et al. (“Andreasson”)
1049	U.S. Patent No. 9,615,192 to Raleigh (“’192 patent” or “’192Pat”)
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1069	U.S. 8,406,733
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1071	File History of U.S. 10,321,320

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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. 10,321,320 (“’320 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 determined in IPRs challenging related patents—IPR2024-00010 (“Samsung ’192 IPR”) (in an institution decision) and IPR2024-00341 (“Samsung ’733 IPR”) (in a final written decision (“FWD”))—collectively taught limitations that are materially similar limitations to each limitation of ’320 patent claim 1.

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 '320 patent, PO did not assert it against anyone until May 2025 and did not assert it against Amazon until June 2025. When PO sued Amazon: (1) the Board had determined in the Samsung '192 IPR and '733 IPR that there was a reasonable likelihood that the challenged claims—which collectively include materially similar limitations to '320 patent claim 1—were unpatentable; (2) PO had just sought and obtained termination of the Samsung '192 IPR on the eve of the FWD; and (3) a FWD in the '733 IPR was imminent—and indeed issued in July 2025, determining all challenged claims were unpatentable. Moreover, in October 2025, the Board issued two additional FWDs determining all challenged claims of two additional related patents were unpatentable. These facts undermine PO's settled expectations and instead led Amazon to expect that (1) the '320 patent would not be asserted against it; and (2) even if the '320 patent was asserted, Amazon would be able to challenge it based on the same primary reference(s) asserted in the Samsung '192/'733 IPRs (as Amazon does here).

Third, this IPR promotes efficiency, both for the Office and the district courts/parties. The Office previously evaluated the same primary prior art references and claim that collectively include substantially similar limitations in the Samsung '192 and '733 IPRs—and can leverage that work here. Moreover, reaching the merits

of both this IPR and Amazon’s co-pending IPR challenging a related patent (IPR2026-00088 challenging U.S. 9,615,192 (“’192 patent”)) at the same time promotes efficiency. The related ’320 and ’192 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 ’320 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 ’320 patent issuing in 2019 (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 or the '320 patent. PO first asserted the '192 patent—but not the '320 patent—in 2023 against Samsung in E.D. Tex. *Id.* Amazon's co-pending IPR2026-00088 challenges the '192 patent. 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 '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 approximately in June 2025, when it sued Amazon on the '192/'320 patents in W.D. Tex. EX1054, 4. Complicating the litigations further, between Sept. and Nov. 2025,

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; EX1049, Cover.

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 '320 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 Messaging Service (“MMS”) published by 3GPP. This error was material because

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

the Board's determinations in the Samsung '192 and '733 IPRs indicate that TS-23.140 teaches the limitations of 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, 392-538, 619-25, 627-30, 819-25, 876-82. The Examiner also did not independently locate TS-23.140. There is no evidence the Examiner searched for 3GPP specifications (or any non-patent literature at all). *Id.*, 918-19 (searching patent classification categories).

A reasonable search would have covered 3GPP publications⁶ describing conventional wireless messaging systems and located TS-23.140. The '320 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 (and the agents on the devices). 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

⁶ Even if the Examiner was not aware of 3GPP before, PO submitted two 3GPP specifications in an IDS. EX1071, 460.

relates to 3G/GSM systems described in the '320 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 have located TS-23.140. EX1016, ¶¶33, ¶¶44-70; EX1073, 2 (2016 “MMS Architecture” Wikipedia page mentioning TS-23.140).

During prosecution, the Examiner allowed claim 1 and the remaining challenged claims without issuing any rejections, stating that the cited prior art did not “disclose Applicant’s inventive claim language.” EX1071, 909. But the Board’s determinations in the Samsung '192 and '733 IPRs indicate that TS-23.140 in fact taught the limitations of '320 patent claim 1. As context, independent claim 1 of the '320 patent is directed to both the network and device side of a system for transmitting messages. Claim 1’s limitations are materially similar, collectively, to the limitations of claim 1 of the '192 patent (network) and claim 1 of the '733 patent (device):

- '320 patent, claim 1: a “networked system” (1[pre]) including: (i) a “network server system” and associated components that buffer and securely

transmit messages to wireless end-user devices upon detection of triggers (1[a]-1[d4]); and (ii) “device link agents” on respective end-user devices that securely receive those messages and deliver them to identified applications. EX1001, cl.1.

- '192 patent, claim 1: “message link server” with components performing materially similar functions as the '320 patent’s “network server system”: i.e., buffering messages and securely delivering them upon detection of triggers. EX1049, cl.1.

- '733 patent, claim 1: “end-user device” with a “service control device link agent” performing materially similar functions as the '320 patent’s “device link agents”: i.e., securely receiving messages and routing them to application-level “device agents.” EX1069, cl.1.

In the Samsung '192 IPR, Samsung challenged claim 1 based on the same TS-23.140 reference presented in this Petition, and the Board determined there was a reasonable likelihood that petitioner would prevail. EX1056, 11-27. That is, the Board determined there was a reasonable likelihood that TS-23.140 taught limitations materially similar to the “network server system” limitations of '320 patent claim 1. Further, in the Samsung '733 IPR, the Board’s FWD determined that TS-23.140⁷ taught the core functions of the “service control device link agent”

⁷ The Board relied on another reference for encryption key storage and decryption

described above. EX1062, 36-49. The Board thus determined that TS-23.140 also taught limitations materially similar to the “device link agents” limitations of ’320 patent claim 1. Taken together, the Board’s determinations in the Samsung ’192 and ’733 IPRs indicate that TS-23.140 teaches the limitations of ’320 patent claim 1 (i.e., both the “network server system” and “device link agents” limitations) that the Examiner believed were not taught in the prior art. This shows that the Examiner’s failure to locate and apply TS-23.140⁸ was a material error that this Petition—challenging claim 1 based on TS-23.140—will allow the Office to correct. Even if PO had settled expectations based on the ’320 patent’s age, the Office’s material

claimed in the ’733 patent. These are not limitations of ’320 patent claim 1.

⁸ 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.”).

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 ’320 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/’733 IPRs.

As discussed in §IV.C, 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 ’320 patent issued (in 2019) to ever assert it (for the first

time in 2025). 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. Nor could Amazon have expected that PO would pluck a never-before-asserted, six-plus-year-old patent from its portfolio of hundreds to assert against Amazon. *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. Claim 1 of the '192 and '733 patent claims are, collectively, materially similar to claim 1 of the '320 patent claims, and PO cannot plausibly assert that it had settled expectations in the '320 patent when: (1) the Board determined in the Samsung '192/'733 IPRs, well before PO sued Amazon, there was

a reasonable likelihood the challenged claims were unpatentable based on the TS-23.140 reference asserted in this Petition⁹; (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 previous determinations in the Samsung '192/'733 IPRs.

Moreover, before PO sued Amazon on the '320 patent, the Board had instituted at least twenty petitions challenging a Headwater patent (and considered many others). EX1074. And shortly afterwards, the Board issued the '733 FWD and two other FWDs determining claims of related patents were unpatentable. EX1062-64.¹⁰ 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”).

⁹ The Samsung '192 IPR institution decision also determined there was a reasonable likelihood of unpatentability based on Houghton-Munson (also asserted here).

¹⁰ 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 same primary references and claims that collectively include materially similar limitations to '320 patent claim 1 in the Samsung '192 (both TS-23.140 and Houghton-Munson) and '733 IPRs (TS-23.140). §§III.A, III.B. Thus, the Office can leverage work it has already done. Moreover, considering the merits of this IPR and the co-pending '192 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 '192 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 ’192 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.¹¹ DD Request, 4-5. Amazon has filed a

¹¹ 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).

motion to stay, which remains pending. EX1077. “In the absence of specific 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).” EX1050. 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 ’192 and ’733 IPRs that there is a reasonable likelihood of unpatentability based on TS-23.140 as to claims that collectively include materially similar limitations as ’320 patent claim 1. Further, as to the ’733

IPR, the Office determined in a FWD that TS-23.140 taught the materially similar device-side limitations. Thus, this factor weighs heavily against denial, and PO's arguments to the contrary are meritless.¹²

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, 2025¹³ and thus does not indicate that, when PO sued Amazon, it expected that Amazon would not challenge the '320 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 '320 patent. Third,

¹² PO also contends there have been no changes in law. DD Request, 3. This neither weighs against nor in favor of discretionary denial.

¹³ PO does not cite an agreement relating to settlement of the Samsung '192 patent IPR. Regardless, this would not demonstrate "significant licensing activity."

PO's licensing evidence is dated after the Samsung '192 IPR and multiple related IPRs were instituted and after the '733 FWD issued. It would be unreasonable for PO to expect the '320 patent's claims would not be challenged when 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, 8-9. However, the Board determined that Samsung's '192 IPR presenting obviousness grounds based on the same primary references demonstrated a reasonable likelihood of unpatentability, and the Board's '733 FWD further supports that the additional limitations of '320 patent claim 1 are obvious based at least on TS-23.140. 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 1051 – 1080 were served upon the below listed counsel by electronic mail:

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