

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2024-00010
Patent 9,615,192

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

SAMSUNG-1001	U.S. Patent No. 9,615,192 to Raleigh (“the ’192 Patent”)
SAMSUNG-1002	Excerpts from the Prosecution History of the ’192 Patent (“the Prosecution History”)
SAMSUNG-1003	Declaration and Curriculum Vitae of Dr. Patrick Traynor
SAMSUNG-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”)
SAMSUNG-1005	U.S. Patent Pub. No. 2006/0190720 to Ozaki et al. (“Ozaki”)
SAMSUNG-1006	WO 2008/048075 A1 to Lee et al. (“Lee”)
SAMSUNG-1007	WO 2006/077283 A1 to Houghton et al (“Houghton”)
SAMSUNG-1008	RESERVED
SAMSUNG-1009	U.S. Patent No. 7,925,717 to Chou et al. (“Chou”)
SAMSUNG-1010	Open Mobile Alliance; Multimedia Messaging Service Architecture Overview (MMSARCH) specification, <i>available at</i> https://www.openmobilealliance.org/release/MMS/V1_1-20040715-A/OMA-WAP-MMS-ARCH-V1_1-20040715-A.pdf
SAMSUNG-1011	Open Mobile Alliance; OMA-ERELED-MMS-v1_2-20030923-C, Enabler Release Definition for MMS Version 1.2,” <i>available at</i> https://www.openmobilealliance.org/release/MMS/V1_2-20030923-C/OMA-ERELED-MMS-V1_2-20030923-C.pdf

SAMSUNG-1012	U.S. Patent No. 7,509,487 to Lu et al. (“Lu”)
SAMSUNG-1013	Technical Specification Group Services and System Aspects Meeting #19, TSGS#19(03)0167, European Telecommunications Standards Institute February 2003 (available at https://www.3gpp.org/ftp/tsg_sa/TSG_SA/TSGS_19/Docs/PDF/SP-030167.pdf)
SAMSUNG-1014	U.S. Patent Pub. No. 2005/0207379 to Shen et al. (“Shen”)
SAMSUNG-1015	U.S. Patent Pub. No. 2009/0282256 to Rakic et al. (“Rakic”)
SAMSUNG-1016	Declaration of Friedhelm Rodermund
SAMSUNG-1017	U.S. Patent Pub. No. 2009/0240807 A1 (“Munson”)
SAMSUNG-1018	EP Patent Application EP1853044B1 to Shenfield (“Shenfield”)
SAMSUNG-1019	U.S. Patent No. 7,082,615 B1 (“Ellison”)
SAMSUNG-1020	Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings, June 21, 2022, available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf
SAMSUNG-1021	Docket Control Order, <i>Headwater Research LLC v. Samsung Electronics Co.</i> , 2:23-cv-00103-JRG-RSP (EDTX), filed October 27, 2023

SAMSUNG-1022	RESERVED
SAMSUNG-1023	Samsung Stipulation letter regarding IPR grounds in District Court Litigation
SAMSUNG-1024	RESERVED
SAMSUNG-1025	RESERVED
SAMSUNG-1026	RESERVED
SAMSUNG-1027	IETF RFC 793, Transmission Control Protocol (Sept. 1981) (available at https://www.ietf.org/rfc/rfc793.txt)
SAMSUNG-1028	The TLS Protocol Version v 1.0 (Jan. 1999) (available at https://datatracker.ietf.org/doc/html/rfc2246)
SAMSUNG-1029	Complaint for Patent Infringement, <i>Headwater Research LLC v. Samsung Electronics Co.</i> , Case No. 2:23-cv-00103 (Dkt. 1, Mar. 10, 2023)
SAMSUNG-1030	Needham et al., “Using Encryption for Authentication in Large Networks of Computers” (ACM, Vol. 21, No. 12, Dec. 1978) (“Needham”)
SAMSUNG-1031	Schroeder et al., “A Hardware Architecture for Implementing Protection Rings” (ACM, Vol. 15, No. 3, Mar. 1972) (“Schroeder”)
SAMSUNG-1032	Saltzer et al., “The Protection of Information in Computer Systems” (IEEE Proceedings, Vol. 63, No. 9, Sept. 1975) (“Saltzer”)
SAMSUNG-1033	Li et al., “Symbian OS platform security model,” available at

<https://www.usenix.org/system/files/login/articles/73507-li.pdf> (Login Magazine, Aug. 2010)

- SAMSUNG-1034 Philip Zimmermann, “Pretty Good Privacy: RSA Public Key Cryptography for the Masses” PGP User’s Guide. Version 1.0, June 1991), available at <https://www.tech-insider.org/free-software/research/acrobat/910605.pdf> (“Zimmerman”)
- SAMSUNG-1035 B. Ramsdell, S/MIME Version 3 Message Specification, IETF RFC 2633, June 1999, available at <https://datatracker.ietf.org/doc/html/rfc2633> (“Ramsdell”)
- SAMSUNG-1036 Mostafa, “Transporting data between wireless applications using a messaging system—MMS” (Wireless Comms. and Mobile Computing, July 7, 2006) (“Mostafa”)
- SAMSUNG-1037 Proof of Service, *Headwater Research LLC v. Samsung Electronics Co.*, Case No. 2:23-cv-00103 (Dkt. No. 6, Mar. 15, 2023)
- SAMSUNG-1038 Stipulation
- SAMSUNG-1039 Supplemental Declaration of Dr. Patrick Traynor
- SAMSUNG-1040 *Wiley Electrical And Electronics Engineering Dictionary* by IEEE Press (2004) (excerpted)
- SAMSUNG-1041 *Shorter Oxford English Dictionary* (6th Ed 2007) (excerpted)
- SAMSUNG-1042 *Dictionary of Computer Science, Engineering, and Technology* (2001) (excerpted)

SAMSUNG-1043	IPR Petition for U.S. Patent 9,198,117 in IPR2024-00003
SAMSUNG-1044	Deposition Transcript of Dr. Michael C. Brogioli
SAMSUNG-1045	U.S. Patent Pub. No. 2004/0148237 to Bittmann et al. ("Bittmann")
SAMSUNG-1046	Petitioner's Demonstratives
SAMSUNG-1047	Confidential Settlement Agreement

Petitioner Samsung Electronics Co. Ltd. (“Samsung” or “Petitioner”) and Patent Owner Headwater Research Llc (“Headwater” or “Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Samsung and Headwater move to terminate the present *inter partes* review proceeding with respect to Samsung.

I. STATEMENT OF FACTS

Samsung and Headwater (collectively, the “Settling Parties”) have reached an agreement (the “Settlement Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1047. The Settlement Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Settling Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial

Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Settling Parties jointly request, for the following reasons.

First, Samsung and Headwater have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, Samsung and Headwater have reached a settlement as to all the disputes in this proceeding and as to the ’192 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 1047. Samsung and Headwater request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Settling Parties.

Third, termination would save significant further expenditure of resources by the Settling Parties. Termination upon settlement, as requested, would also further

the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, Samsung and Headwater respectfully request termination of this *inter partes* review with respect to Samsung.

Respectfully submitted,

Date: May 8, 2025

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