



July 1, 2024

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Re: *Headwater Research LLC v. Samsung Electronics Co., Ltd. et al., Case No. 2:23-cv-00103 (E.D. Tex.)*

Dear Counsel:

Samsung Electronics Co., Ltd. (“**Samsung**”) has filed petition for *inter partes* review (IPR) petition (IPR2024-00341) with the Patent Trial and Appeal Board (PTAB) to address the validity of claims 1-17, 19, 21-27, 29, and 30 of U.S. Patent No. 8,406,733 (“**the ’733 Patent**”). The tables in attached Appendix A list all grounds, challenged claims, and references asserted in IPR2024-00341.

I write to inform you that Samsung hereby stipulates that, if the PTAB institutes IPR2024-00341, Samsung agrees not to pursue any grounds raised in the IPR, any grounds raised within Samsung’s invalidity contentions that were raised or could have been raised in the IPR, or any grounds Samsung could have reasonably raised before the PTAB, in this district court litigation, or any parallel proceeding. *Sotera Wireless, Inc. v. Masimo Corp.*, Case IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020). Samsung reserves the right to assert in the District Court proceedings prior art that is not eligible for PTAB consideration, e.g., the system art noted in Appendix B below and the system art identified in Samsung’s invalidity contentions.¹ Samsung’s reservation is consistent with a *Sotera* stipulation because the grounds listed in Appendix B are based on prior art that is ineligible for consideration before the PTAB, and that could not have been raised before the PTAB.

¹ Samsung notes that discovery in the District Court proceedings is currently ongoing and Samsung expects Google, Apple, Blackberry, OpenWave, Nokia, and Microsoft to produce additional materials and/or testimony relating to the system art listed in Appendix B below. For the avoidance of doubt, Samsung reserves the right to rely on such forthcoming productions in the District Court proceedings.

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For the sake of clarity and to avoid any doubt, if the PTAB declines to institute IPR2024-00341, Samsung reserves the right to assert any grounds of invalidity in the District Court proceedings against the '733 Patent.

Sincerely,

A handwritten signature in black ink, appearing to read "Thad Kodish". The signature is written in a cursive, slightly slanted style.

Thad Kodish

Attorney for Samsung Electronics Co., Ltd.

Appendix A – Grounds and Prior Art References Used in IPR2024-00341

Ground	Claim(s)	35 U.S.C. §103
1	1-17, 19, 21-27, 29, 30	TS-23.140 and Ogawa

List of References

Reference Name	Details
TS-23.140	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
Ogawa	U.S. Pat. No. 8,195,961B2

Appendix B – System Art

Devices and/or Servers supporting Amp'd Mobile system
Devices and/or Servers supporting Apple Push Notifications and/or the App Store
Devices and/or Servers supporting BlackBerry Mobile Data Service, App World, and/or other push services
Devices and/or Servers supporting D-BUS communication service
Android Devices and/or Servers supporting Google Messaging Delivery
Devices and/or Servers supporting MMS technology
Windows Mobile Devices and/or Servers supporting ActiveSync and/or Microsoft Direct Push technology
Devices and/or Servers supporting OpenWave push technology, including OpenWave Mobile Access Gateway
Devices and/or Servers supporting Nokia push technology
Devices and/or Servers supporting ProcessOne Push Platform
Devices and/or Servers supporting Wireless Access Protocol