

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., GOOGLE LLC,
and SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2024-00341
Patent 8,406,733 B2

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

Patent Owner respectfully requests that the Director vacate or reverse the Board's Final Written Decision as contrary to the Board's regulations and Federal Circuit precedent. This request presents an important issue of law or policy: namely, whether a decision of unpatentability can be based on a ground where Petitioner *acknowledges* that the prior art forming the basis for that ground does not disclose the claim requirements, particularly where Petitioner has already attempted (and failed) to invalidate the challenged patent before a district court, and the challenged patent has been in force for over a dozen years.

The Board's regulations require that the Petition sets forth "where *each* element of the claim is found *in the prior art patents or printed publications relied upon.*" 37 CFR 42.104(b)(4) (emphasis added). Non-prior-art, such as expert testimony or the general knowledge of a POSITA, cannot supply any missing claim limitations. See July 31, 2025 Memorandum of Acting Director Coke Morgan Stewart ("Memorandum"), *available at* https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf ("As a practical matter, enforcement of Rule 104(b)(4) means that... expert testimony, common sense, and other evidence that is not 'prior art consisting of patents or printed publications' (collectively 'general knowledge') may not be used to supply a missing claim limitation.").

Here, the Board’s Final Written Decision found all challenged claims unpatentable. But the Petition did not identify where *the prior art relied upon* disclosed “a plurality of device agents communicatively coupled to the service control device link agent *through an agent communication bus*,” as all challenged claims of U.S. Patent No. 8,406,733 require. *See generally* Pet. 28–31.

The “TS-23.140” reference (Ex. 1004) is the only reference the Petition relied upon as allegedly relating to the “agent communication bus” limitation (*see id.*), and the Petition *admitted* that TS-23.140 “does not describe ‘[d]etails of [] applications or how an MMS User Agent would interface with them’” (Pet. 30), such that it cannot describe an interface entailing “an agent communication bus.” Rather than contend that this element was disclosed in TS-23.140 (or any other prior art forming the basis for the Petitioner’s challenge), the Petition alleged, in a single sentence, that a “POSITA would have *understood* that the MMS User Agent and other applications would interface ‘through an agent communication bus’ as that term is used in the ’733 patent.” Pet. 30. But this is exactly the type of reliance on expert testimony that fails to “provide certainty to the parties, the Board, and the public” regarding the basis for the theory set forth in the Petition. *See* Memorandum at 3.

Given that the Petition itself admitted that the prior art relied upon does *not* disclose the claimed “agent communication bus” (because it does not disclose *any*

details of the communication interface), Petitioner’s expert testimony or alleged knowledge of a POSITA improperly forms the basis of the Petition’s challenge.

The Board’s decision was inconsistent, not only with the Board’s regulations, but also with the statutory requirements and Federal Circuit precedent. Specifically, 35 U.S.C. §311 states:

A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and *only on the basis of prior art* consisting of patents or printed publications.

35 U.S.C. §311 (b) (emphasis added). In other words, when the *basis* of the invalidity theory explicitly goes beyond the prior art (such as when there are “express statements by [Petitioner] that” something other than prior art is “part of the basis of” any particular ground, there is “a violation of § 311 (b).” *See Qualcomm Inc. v. Apple Inc.*, 134 F.4th 1355, 1367 (Fed. Cir. 2025).

Here, the Petition is *explicit* that the prior art does not disclose the “agent communication bus” limitation, in acknowledging that the prior art reference relied upon “does not describe [d]etails of [] applications or how an MMS User Agent would interface with them” (Pet. 30), and instead relies on general assertions regarding what a “POSITA would have understood” would be present in the proposed combination. This is insufficient. *See Qualcomm*, 134 F.4th at 1367

(noting that an express statement showing that prior art alone is not the basis for a challenge violates §311 (b)). While Patent Owner acknowledges that expert testimony may *support* a theory presented on the basis of prior art references, it cannot fill *Petitioner-admitted* deficiencies in the prior art as the Board's Final Written Decision here allowed.

The prejudice of Samsung's reliance on non-prior art to bridge deficiencies in its invalidity case is especially strong here, where Samsung already presented an invalidity case to a jury, and the jury rejected Samsung's invalidity arguments. *See* <https://www.ketk.com/news/local-news/tyler-research-firm-awarded-278-million-in-samsung-patent-lawsuit/> (discussing the jury verdict on the '733 Patent in *Headwater Research LLC v. Samsung Electronics Co., Ltd.*, 2:23-cv-00103, (E.D. Tex.)). Petitioner should not be allowed to overturn a considered jury verdict of infringement and no invalidity based on an improperly-submitted IPR ground, particularly on a patent that has been in effect for over *twelve years*. *See* Ex. 1001 ("Date of Patent: Mar. 26, 2013").

Accordingly, Patent Owner respectfully requests that the Board vacate the Board's Final Written Decision and terminate the IPR as having been improperly instituted, or in the alternative find that the Petition's theory failed to meet the statutory grounds for an IPR and find all challenged claims not unpatentable.

Date: August 22, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on August 22, 2025, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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