

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

HEADWATER RESEARCH LLC,

Patent Owner.

Case No. IPR2026-00137

U.S. Patent No. 9,647,918

**PETITIONER'S PRELIMINARY REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Patent Owner’s Disclaimer Argument Fails Because the Board Rejected Patent Owner’s Arguments in IPR2024-01396	1

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>CUPP Computing AS v. Trend Micro Inc.</i> , 53 F.4th 1376 (Fed. Cir. 2022)	2
<i>Galderma Lab 'ys, L.P. v. Amneal Pharms. LLC</i> , 806 F. App'x 1007 (Fed. Cir. 2020)	1, 2
<i>Image Processing Techs. LLC v. LG Elecs. Inc.</i> , No. 2023-2136, 2025 WL 323779 (Fed. Cir. Jan. 29, 2025)	2
<i>Nikon Corp. v. Optimum Imaging Techs., LLC</i> , IPR2024-01373, Paper 17 (PTAB Apr. 23, 2025)	3
<i>Olympus Corp. v. Optimum Imaging Techs., LLC</i> , IPR2024-01220, Paper 13 (PTAB Feb. 24, 2025)	3
<i>Power Integrations, Inc. v. ON Semiconductor Corp.</i> , 396 F. Supp. 3d 851, 866 (N.D. Cal. 2019)	2, 3
<i>Puradigm, LLC v. DBG Grp. Investments, LLC</i> , No. 24-2299, 2026 WL 890566 (Fed. Cir. Apr. 1, 2026)	3

I. Introduction

Patent Owner’s prosecution disclaimer argument (POPR, 21-25) fails as a matter of law. The Federal Circuit, district courts, and the Board have all held that disclaimer does not apply where—as here—a Patent Owner relies on arguments advanced in a previous IPR *that the Board rejected*. “While clear and limiting statements by the patent owner can give rise to disclaimer, *they do not* in this case *where those statements were clearly and expressly rejected by the Patent Office*.” *Galderma Lab’ys, L.P. v. Amneal Pharms. LLC*, 806 F. App’x 1007, 1010-11 (Fed. Cir. 2020) (emphases added). The Board rejected Patent Owner’s previous arguments in IPR2024-01396, instituting review based on the same art and grounds involved in this Petition. EX1060, 14; Pet., 8. It should do the same here.

II. Patent Owner’s Disclaimer Argument Fails Because the Board Rejected Patent Owner’s Arguments in IPR2024-01396

Patent Owner’s arguments in IPR2024-01396 do not constitute a disclaimer because the Board rejected them. It found that “the claims neither recite applications ‘directly’ accessing/calling APIs, nor expressly preclude indirect access/calls through an intermediary.” EX1068, 14. And it determined that Bennett teaches 1[c] for institution purposes. *Id.* Patent Owner’s arguments remain rejected to this day because IPR2024-01396’s institution was vacated based on *Fintiv*, not the merits. EX1070, 3. Under these facts, there can be no disclaimer: “[b]ecause the record makes clear to a skilled artisan that Patent Owner’s arguments were rejected, those

arguments do not impact claim scope.” *Galderma*, 806 F. App’x at 1010-11.

The Federal Circuit has also rejected other attempts to narrow claims based on prior IPR statements where patentees presented “positions it believed would aid its effort to survive invalidity challenges.” *Image Processing Techs. LLC v. LG Elecs. Inc.*, No. 2023-2136, 2025 WL 323779, at *5 (Fed. Cir. Jan. 29, 2025). That is precisely what Patent Owner was trying to accomplish with its prior arguments for “callable” and “accessible.” POPR, 19-25; EX2017, 12-18; EX1068, 12-14. As the Federal Circuit held, allowing argument-based disclaimer in this circumstance is inappropriate because it would undermine the Board’s established amendment procedures. *Image Processing*, 2025 WL 323779, at *5 (citing *CUPP Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1383 (Fed. Cir. 2022)). Patent Owner’s positions are even more suspect here because it never presented this construction in the litigation associated with IPR2024-01396 or its pending litigation against Google.

District courts have also refused to find disclaimer for similar reasons where the Office “*expressly rejected*” the patentee’s arguments: “When the scope is rejected, the adjudicative body’s final decision rejecting the claim scope provides notice to the public that the claim scope is different than what the patentee argued—*i.e.*, that the patentee’s claim scope is wrong. It would be an odd outcome indeed if the patentee was required to maintain an argument in a later adjudication when everyone, including the alleged infringer, is on notice that the argument is incorrect.” *Power*

Integrations, Inc. v. ON Semiconductor Corp., 396 F. Supp. 3d 851, 866 (N.D. Cal. 2019). This same reasoning applies to this case and precludes disclaimer.

The Board has likewise refused to find disclaimer based on indistinguishable facts. In *Nikon*, the Board refused to find disclaimer based on a prior proceeding where it *did not* (a) adopt patent owner's arguments at institution, (b) issue a final decision adopting the construction, or (c) determine the claims were patentable based on the arguments. *Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01373, Paper 17, at 34-35 (PTAB Apr. 23, 2025); *see also Olympus Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01220, Paper 13, at 12-13 (PTAB Feb. 24, 2025). All three are true here too, so the Board should reach the same conclusion.

Patent Owner addresses none of these cases. It instead cites *Puradigm, LLC v. DBG Grp. Investments, LLC* and claims that "disclaimer applies even if the PTO disagreed" with its arguments. POPR, 22 (citing No. 24-2299, 2026 WL 890566 (Fed. Cir. Apr. 1, 2026)). *Puradigm* is inapposite. There, the examiner allowed the claims based, in part, on applicant's arguments. *Id.* ("the examiner's basis for allowance of the claims was not completely independent from the applicant's earlier argument"). Here, the Board rejected Patent Owner's argument and never confirmed the claim's patentability. That aligns this case with the decisions cited herein and distinguishes it from *Puradigm*. Petitioner therefore requests that the Director institute this Petition, consistent with the Board's prior institution decision in IPR2024-01396.

Date: May 19, 2026

Respectfully submitted,

/Erika H. Arner/

Erika H. Arner
Lead Counsel
Reg. No. 57,540

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Preliminary Reply to Patent Owner's Preliminary Response** was served on May 19, 2026, via email on counsel of record for Patent Owner at the following:

Reza Mirzaie
rmirzaie@raklaw.com
rak_headwater@raklaw.com

Marc A. Fenster
mfenster@raklaw.com

Dale Chang
dchang@raklaw.com

James A. Milkey
jmilkey@raklaw.com

Neil Rubin
nrubin@raklaw.com

Philip X. Wang
pwang@raklaw.com

Dated: May 19, 2026

By: /Lisa C. Hines/
Lisa C. Hines
Case Manager

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.