

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

HEADWATER RESEARCH LLC,

Patent Owner

IPR2026-00137

Patent No. 9,647,918

**PATENT OWNER'S AUTHORIZED¹ SUR-REPLY
TO PETITIONER'S PRELIMINARY REPLY**

¹ Ex. 3001.

TABLE OF AUTHORITIES

Cases

<i>Aylus Networks, Inc. v. Apple Inc.</i> , 856 F.3d 1353 (Fed. Cir. 2017).....	1
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<i>Power Integrations, Inc. v. ON Semiconductor Corp.</i> , 396 F. Supp. 3d 851 (N.D. Cal. 2019)	1, 2
<i>Puradigm, LLC v. DBG Grp. Investments, LLC</i> , No. 2024-2299, 2026 WL 890566 (Fed. Cir. Apr. 1, 2026)	1, 2, 3

Disclaimer arises from a patentee's statements made in "concluded IPR proceedings." *Nikon Corp. v. Optimum Imaging Techs. LLC*, IPR2024-01373, Paper 17 at 34 (PTAB Apr. 23, 2025) (noting that *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1360 (Fed. Cir. 2017) extends "prosecution history disclaimer doctrine to statements made in *concluded* IPR proceedings") (emphasis in original). With extremely limited exceptions, disclaimer evaluates only the patentee's statements, not the USPTO's acquiescence. *Puradigm, LLC v. DBG Grp. Investments, LLC*, No. 2024-2299, 2026 WL 890566, at *3–*4 (Fed. Cir. Apr. 1, 2026) ("It is well settled that it is the applicant, not the examiner, who must give up or disclaim subject matter that would otherwise fall within the scope of the claims.") (cleaned up).

Relevant to Google's arguments, disclaimer may be nullified only under the specific circumstances where the USPTO (1) "*clearly and expressly*" disagrees with the patentee's arguments regarding claim scope (2) in a "final decision." Paper 12 at 1 (quoting *Galderma Lab'ys, L.P. v. Amneal Pharms. LLC*, 806 F. App'x 1007, 1010–11 (Fed. Cir. 2020)) (emphasis in original); *Id.* at 2 ("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....") (quoting *Power Integrations, Inc. v. ON Semiconductor Corp.*, 396 F. Supp. 3d 851, 866 (N.D. Cal. 2019) (emphasis added)).

In contrast, the Federal Circuit has recently reiterated that ***non-final***

disagreements with the patentee's claim scope do not nullify disclaimer. *See Puradigm*, 2026 WL 890566, at *3–*4 (applying disclaimer even though “the examiner rejected the applicant’s urging for a narrower construction”); *id.* at *1 (noting that “[t]he examiner was unconvinced” by patentee’s view of claim scope in issuing a non-final rejection); *id.* at *4 (because the final action did not expressly take a position regarding claim scope, “[w]e cannot be sure... that the applicant’s disclaimer statements... had no effect”).

Each of Google’s cases are distinguishable because (1) disclaimer was not clear, (2) there was no *concluded* IPR proceeding, or (3) there was a *final* decision disagreeing with the disclaimer. *See, e.g., Galderma*, 806 F. App’x at 1009–10 (discussing the Board’s final written decision rejecting the disclaimer—what “[t]he Board ultimately found” *after* institution); *Image Processing Techs. LLC v. LG Elecs. Inc.*, No. 2023-2136, 2025 WL 323779, at *5 (Fed. Cir. Jan. 29, 2025) (hereinafter “*IPT*”) (“IPT... never clearly and unmistakably stated it was disclaiming” the relevant claim scope); *Power Integrations*, 396 F. Supp. 3d at 866 (final decision rejected claim scope); *Nikon*, IPR2024-01373, Paper 17 at 34 (finding no disclaimer from the “Sony IPR”—IPR2024-00924—which had not been “concluded”); *Olympus Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01220, Paper 13, at 12 (PTAB Feb. 24, 2025) (same) .

Here, Google does not dispute: (1) that Headwater clearly and unmistakably

disclaimed the relevant claim scope in IPR2024-01396, (2) that IPR2024-01396 was concluded before Google filed the instant petition, and (3) there is no final decision in IPR2024-01396 clearly and expressly disagreeing with Headwater’s disclaimer. Even the *institution decision* “invite[d]” additional argument regarding claim scope (see Ex. 1068 at 14), and the *final decision* terminating that IPR expressed no opinion rejecting Headwater’s claim scope. See generally Ex. 1084. And because that decision applied “*Fintiv’s* holistic assessment” (*id. at 3*)—including Factor 6 which involves merits—like in *Puradigm* the final decision “was not completely independent from [Headwater’s] earlier argument” such that the public “cannot be sure” the “disclaimer statements... had no effect.” 2026 WL 890566, at *3.

Google argues disclaimer is “suspect... because [Headwater] never presented this construction” in district court (Paper 12 at 2), but no authority supports that argument; Headwater’s view of claim scope is also not a formal “construction.” Ex. 2017 at 8 (proposing no constructions); Ex. 1068 (“Neither party has proposed a construction....”).² Google also implies that *IPT* precludes disclaimer whenever it “would aid” a patent’s validity (Paper 12 at 2), which is clearly wrong and if true would eliminate disclaimer altogether (and *IPT* is distinguishable as noted above).

² One heading in the POPR mentions a “construction”—this was in error and later clarified that **Google** “characterized [it] as a ‘construction.’” POPR at 21, 24.

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Respectfully submitted,

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

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