

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

HEADWATER RESEARCH LLC,

Patent Owner.

Case No. IPR2026-00138

U.S. Patent No. 9,609,544

**PETITIONER'S SUPPLEMENTAL BRIEF IN OPPOSITION
TO PATENT OWNER'S REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	Patent Owner’s Contingent Disclaimer Favors Referral.....	1
	A. A Contingent Disclaimer Confirms Lack of Settled Expectations	1
	B. Review Would Be an Efficient Use of the Board’s Resources	3
	C. <i>Fintiv</i> Factor 6 Still Favors Referral	3
III.	Conclusion	3

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC</i> , IPR2025-00478, Paper 10 (P.T.A.B. July 31, 2025)	3
<i>Guinn v. Kopf</i> , 96 F.3d 1419 (Fed. Cir. 1996).....	2

I. Introduction

Patent Owner's intention to disclaim all but claim 2 should the Petition be referred strongly favors referral. *See* POPR, 1. This contingent disclaimer confirms the parties' expectations: the challenged claims are likely unpatentable. The IPR, if instituted, would also streamline the dispute between the parties and be an efficient use of the Board's resources. Finally, the merits of the Petition are strong for claim 2 under *Fintiv* factor 6. Petitioner thus requests referral and institution of the Petition.

II. Patent Owner's Contingent Disclaimer Favors Referral

A. A Contingent Disclaimer Confirms Lack of Settled Expectations

Patent Owner's intention to disclaim all but one dependent claim confirms the current expectations of the parties—that the challenged claims are likely unpatentable. As detailed in the Opposition, the Board has already determined there is a reasonable likelihood that *all* challenged claims, including claim 2, are unpatentable based on the same prior art and grounds. EX1032, 5, 8-27; Pet., 1. Patent Owner has not disputed the merits of the Board's prior institution decision. In fact, none of Patent Owner's pre-institution briefing addresses Ground 1 of the Petition based on Rao and Araujo, which the Board's previous institution decision focused on. EX1032, 5, 8-27; DD Req. 16-17; POPR, 2-11. Accordingly, Patent Owner's (1) failure to refute the Board's prior determination and (2) willingness to enter a disclaimer confirms the parties' (and the public's) understanding that there is a reasonable likelihood that *all* of the challenged claims are unpatentable.

The contingent nature of Patent Owner’s disclaimer further demonstrates that Patent Owner lacks any purported expectations in the ’544 patent. Statutory disclaimers have “the effect of canceling the claims from the patent[,] and the patent is viewed as though the disclaimed claims had never existed in the patent.” *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996). Patent Owner’s willingness to make such a disclaimer thus establishes that it is willing to accept that the claims never existed. This confirms Patent Owner’s ambivalence to the claims and its lack of any expectations in them. Moreover, the contingent disclaimer also weighs against discretionary denial because a contrary finding would establish precedent that invites gamesmanship, no actual disclaimer, and uncertainty for the public. Referral eliminates this uncertainty and ensures that the public has reliable, consistent, and proper notice of Patent Owner’s claims.

To the extent Patent Owner enters its disclaimer prior to referral, the disclaimer makes this case just like IPR2026-00049, which the Director recently referred and instituted. EX1044; EX1045. There too, Patent Owner disclaimed all but one claim of the ’359 patent. EX1045. Thus, consistent with IPR2026-00049, the Director should reach the same conclusion here: patentees that disavow claims do not have settled expectations in the patent—especially when the Board has previously determined that the claims are likely to be unpatentable.

B. Review Would Be an Efficient Use of the Board's Resources

Patent Owner's disclaimer supports referral because it streamlines the issues and represents an efficient use of the Board's resources. The Director has also referred and instituted IPR2026-00049 and IPR2026-00050, which involve related patents. "[U]nder these circumstances, it is an efficient use of Board resources to address the challenged patent [in this case] as well." *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00478, Paper 10, 3 (P.T.A.B. July 31, 2025).

C. *Fintiv* Factor 6 Still Favors Referral

Under *Fintiv* factor 6, Patent Owner still has not addressed Ground 1 of the Petition, which challenges claim 2 and asserts the same combination the Board previously found sufficient for institution. EX1032, 26. Patent Owner instead disputes the rationale to combine Rao and Freund in Ground 2 based on the Board's prior treatment of these references in IPR2024-00945. POPR, 1-2. This argument cherry-picks decisions and ignores yet another Board decision *endorsing* the combination of Rao and Freund. *See* IPR2024-00942, Paper 20 (FWD). There, the Board held claims very similar to claim 2 of the '544 patent unpatentable, which Patent Owner never appealed. *Id.* Patent Owner's reliance on IPR2024-00945 is therefore not controlling. Consistent with the Board's previous decision involving the patent *in this case*, the merits warrant referral.

III. Conclusion

Petitioner respectfully requests referral and institution of the Petition.

Date: May 5, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Supplemental Brief in Opposition to Patent Owner's Request for Discretionary Denial of Institution** was served on May 5, 2026, via email on counsel of record for Patent Owner at the following:

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