

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,

Petitioner,

v.

CLEAR IMAGING RESEARCH LLC,

Patent Owner.

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Case IPR2026-00181  
U.S. Patent No. 9,860,450

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**PATENT OWNER'S REQUEST FOR  
DISCRETIONARY DENIAL OF INSTITUTION**

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Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                                                                                                                                                                                                                                                                     |
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| 2001               | Order Granting Motion to Dismiss, Dkt. 55, <i>Clear Imaging Research LLC v. Google LLC</i> , No. 3:25-cv-00221-GPC-BLM (S.D. Cal. Jan. 30, 2026)                                                                                                                                                                                                                                       |
| 2002               | Complaint, Dkt. 1, <i>Clear Imaging Research LLC v. Google LLC</i> , No. 3:25-cv-00221-GPC-AHG (S.D. Cal. Jan. 30, 2025)                                                                                                                                                                                                                                                               |
| 2003               | Reuters Article, <i>Google to develop, manufacture high-end smartphones in Vietnam, Nikkei Asia says</i> , <a href="https://www.reuters.com/world/asia-pacific/google-develop-manufacture-smartphones-vietnam-nikkei-asia-says-2026-01-13/">https://www.reuters.com/world/asia-pacific/google-develop-manufacture-smartphones-vietnam-nikkei-asia-says-2026-01-13/</a> (Jan. 13, 2026) |

## I. INTRODUCTION

The Director should exercise discretion to deny institution. The most important fact is the present posture of the only litigation between Patent Owner and Petitioner Google LLC on the '450 patent: Patent Owner's infringement claim against Google on U.S. Patent No. 9,860,450 was dismissed with prejudice, while Google's declaratory-judgment counterclaims for non-infringement and invalidity were dismissed without prejudice. EX2001 at 1 (*Clear Imaging Research LLC v. Google LLC*, No. 3:25-cv-00221-GPC-BLM, Order Granting Joint Motion to Dismiss (S.D. Cal. Jan. 30, 2026)). Under the current interim discretionary-denial framework, that matters because the Board and Director may consider any fact bearing on efficiency, integrity of the patent system, and the appropriate use of Office resources. *See* Memorandum, Interim Processes for PTAB Workload Management at 2-3 (Mar. 26, 2025); USPTO, Interim Director Discretionary Process, <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (updated Oct. 3, 2025).

That posture is accompanied by several additional facts that reinforce denial. Google waited until the last day permitted by 35 U.S.C.

§ 315(b) to file its petition even though the Google complaint itself alleges that Google had notice of the '450 patent since at least February 22, 2021 and had been provided claim charts and licensing presentations years before suit. EX2002 at ¶¶ 11-18, 37-42 (*Clear Imaging Research LLC v. Google LLC*, No. 3:25-cv-00221-GPC-AHG (S.D. Cal. Jan. 30, 2025)). The '450 patent issued on January 2, 2018 and therefore had been in force for just over six years when Google finally filed this petition. *See id.* ¶ 34; EX1001 at 1. And although Petitioner attempts to package its petition as a fresh challenge, three of its four references—Akifumi, Creative Camcorder, and Balmer—were already the basis of a prior petition for *inter partes* review of the '450 patent by Samsung in IPR2020-01394. *Samsung Elecs. Co., Ltd. v. Clear Imaging Research, LLC*, IPR2020-01394, Paper 1 at 1-2 (July 31, 2020). In addition, the fourth reference on which the present Petition is based, Dutta, was already materially in the prosecution history and is expressly discussed in the present Petition as the basis for the examiner's prior rejection. Pet. at 1-2, 5-8, 75-82; EX1002 at 146-150, 183-189, 193.

These circumstances present exactly the type of case in which discretionary denial is warranted: the parties' district-court dispute over

the '450 patent has been dismissed with prejudice; Petitioner waited until the close of the statutory period despite years of notice; settled expectations now weigh in Patent Owner's favor; and the Petition substantially reuses prior art and arguments that were already available from prosecution and from Samsung's earlier petition. The Petition should be denied under 35 U.S.C. § 314(a), and the overlapping art-and-argument history also supports denial under 35 U.S.C. § 325(d).

## **II. DISCRETIONARY DENIAL IS APPROPRIATE**

### **A. The parallel district court litigation involving the same parties has ended, and institution would be an inefficient use of Board resources**

The parallel district court dismissed the '450 patent from the case, so there is no longer a live infringement dispute on the '450 patent in that matter. On January 28, 2026, the parties jointly moved to dismiss Clear Imaging's '450 infringement claim against Google with prejudice and to dismiss Google's counterclaims for non-infringement and invalidity without prejudice. The district court granted that motion on January 30, 2026. EX2001 at 1.

That procedural posture strongly favors denial. In *Ericsson Inc. v. Procomm International Pte. Ltd.*, the Director denied institution where

the challenged patent had been dismissed with prejudice from the parallel litigation, explaining that Patent Owner's inefficiency and settled-expectations arguments tipped the balance toward discretionary denial. *Ericsson Inc. v. Procomm Int'l Pte. Ltd.*, IPR2024-01453, Paper 16 at 2-3 (June 25, 2025). The Director emphasized both that the patent had been dismissed with prejudice and that reviewing it would be an inefficient use of Board resources. *Id.* The same logic applies here. Patent Owner's claim against Google on the '450 patent is dismissed with prejudice. Google's remaining interest is, at most, a free-standing invalidity challenge untethered to a live infringement claim by Patent Owner against Google.

Institution now would spend Office resources on a dispute that Petitioner itself no longer faces as an infringement claim. The current process expressly permits denial based on the holistic question whether institution would serve efficiency and integrity. *See* Memorandum, Interim Processes for PTAB Workload Management at 2-3 (Mar. 26, 2025); USPTO, Interim Director Discretionary Process, <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (updated Oct. 3, 2025).

**B. Petitioner waited until the last possible day to file despite years of actual notice.**

Petitioner did not act promptly. The Petition states that it was filed within one year of service of the complaint against Google on January 31, 2025. Pet. at 1. That means Petitioner waited until the outer limit of § 315(b). That delay is significant, especially because Petitioner had actual notice of the '450 patent long before the complaint. The district court complaint alleges that on February 22, 2021, Clear Imaging sent Google a notice letter identifying additional infringing Google products and infringed patents, including the '450 patent. EX2002 at ¶ 11. The complaint further alleges that Clear Imaging and Google then held a call on November 15, 2021; that Clear Imaging sent five exemplary claim charts on November 17, 2021, including claim charts for the '450 patent; that the parties held additional calls in November 2021, March 2022, May 2022, and thereafter; and that Google requested and received re-sent claim charts on the '450 patent as late as 2024. *Id.* ¶¶ 11-18.

So this is not a case in which Petitioner learned of the patent only upon being served with the complaint and then promptly sought PTAB review. Petitioner had years of actual notice, including notice directed

specifically to the '450 patent and to accused Pixel products. Yet Petitioner did not file the Petition until the very end of the statutory period.

**C. Settled expectations favor denial**

The '450 patent issued on January 2, 2018. EX1001 at 1. The Petition was not filed until January 29, 2026. Pet. at 1. By then, the patent had been in force for more than six years.

Recent Director decisions treat that timing as significant. In *Dabico Airport Solutions Inc. v. AXA Power ApS*, the Acting Director granted discretionary denial where the challenged patent had been in force less than eight years, explaining that this created settled expectations. IPR2025-00408, Paper 21 at 2-3 (June 18, 2025). The Acting Director further explained that actual notice of a patent or of possible infringement is not necessary to create settled expectations because patents and published applications are publicly available and interested parties may search for them. *Id.* at 3. Similarly, in *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, the Acting Director also granted discretionary denial based on settled expectations, holding that the petitioner's awareness of the patent owner's applications and failure to seek early

review favored denial and outweighed countervailing considerations, including a likely final written decision before trial, little district-court investment, and a high likelihood of a stay. IPR2025-00363, Paper 10 at 2-3 (June 6, 2025).

The '450 patent had been in force for over six years when the Petition was filed, and Petitioner had actual notice of the patent since at least 2021. EX2002 at ¶ 37. Under *iRhythm* and *Dabico*, those facts materially strengthen Patent Owner's settled expectations. Indeed, they strengthen them more than in cases resting only on public availability, because Petitioner had direct notice, detailed licensing communications, and claim charts, yet still chose not to seek review until the last permissible day.

**D. The Petition repackages are and arguments already raised in prosecution and in a prior IPR petition, making denial appropriate under § 314(a) and supporting denial under § 325(d).**

The Petition is based on art that the Office has already considered. The Petition asserts four references: Dutta, Akifumi, Creative Camcorder, and Balmer. Pet. at 1-2, 75-82. Three of those references—Akifumi (EX1009), Creative Camcorder (EX1008), and Balmer

(EX1010)—were previously used as the basis for a 2020 petition filed by Samsung challenging the same patent. IPR2020-01394, Paper 1 at 1-2 (July 31, 2020) at 1-3, 45-50.

Thus, by the time Google filed the present Petition, Patent Owner, the Board, and prior petitioners had already invested resources in framing how this patent might be attacked, which references map to which claim groups, and which dependent claims supposedly call for Creative Camcorder or Balmer. That overlap is relevant both to the holistic § 314(a) analysis and to whether the petition presents substantially the same art or arguments previously presented to the Office.

The Samsung petition itself underscored that its challenge would be useful to future defendants. Samsung argued that its petition was potentially helpful to future defendants and would enable invalidity of claims that Patent Owner might later reassert. IPR2020-01394, Paper 1 at 87 (July 31, 2020). That is precisely the kind of roadmap concern implicated here. Google filed years later, after Samsung had already assembled and briefed the same recurring reference combinations against the same patent.

Google's reliance on Dutta does not cure that overlap. Dutta was already materially present in the prosecution history. EX1002 at 146-150, 183-189, 193. The Petition itself explains that the examiner rejected claims over Dutta during prosecution, that the applicant amended the claims to incorporate limitations the examiner viewed as allowable, and that Petitioner now contends the examiner committed material error by overlooking Dutta's teachings concerning synchronous storage and video compression. Pet. 5-8. So even Petitioner's purportedly distinguishing reference is not newly surfaced art outside the Office's prior consideration; it is the very reference Google concedes the examiner previously considered during prosecution.

Under *Advanced Bionics* and *Becton, Dickinson*, that history matters. When the Office has already seen materially similar art or argument pathways, a later petition must do more than restyle the same basic challenge and label the prior outcome examiner error. See *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8-10 (PTAB Feb. 13, 2020) (precedential); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential).

Here, several *Becton, Dickinson* factors favor denial. There is substantial similarity between the art and argument structure of the present Petition and Samsung's earlier petition, particularly as to Akifumi, Creative Camcorder, Balmer, and the claim groupings to which those references are directed. There is also significant prior Office exposure to Dutta itself. And Petitioner's material-error theory is not strong enough to overcome that overlap. Thus, the Petition merely repackages a known prosecution-history reference with the same secondary references already deployed in Samsung's earlier petition.

At minimum, this history strongly supports denial under the Director's holistic § 314(a) discretion. And if the Director concludes the overlap is sufficiently substantial, it also supports denial under § 325(d).

**E. The March 11, 2026 manufacturing considerations provide additional support for denial**

The March 11, 2026 Squires memorandum directs the Office to consider, among other things, the extent to which products accused of infringement in a parallel proceeding are manufactured in the United States or are related to investments in American manufacturing operations. Memorandum, Additional Discretionary Institution Considerations—U.S. Manufacturing and Small Business Use of AIA

Proceedings at 2-3 (Mar. 11, 2026). The memorandum further explains that, for method claims, the relevant products are the devices used to carry out the method. *Id.* at 3.

On the present record, this consideration does not favor institution. The accused products in the district court case are Pixel phones and related devices. EX2002 ¶¶ 35-40. Current public reporting indicates that Google's Pixel smartphone manufacturing is centered in Vietnam, not in the United States. *See* EX2003 (Reuters, *Google to develop, manufacture high-end smartphones in Vietnam, Nikkei Asia says*, <https://www.reuters.com/world/asia-pacific/google-develop-manufacture-smartphones-vietnam-nikkei-asia-says-2026-01-13/> (Jan. 13, 2026)).

### III. CONCLUSION

For all of these reasons, the Director should exercise discretion to deny institution. The parallel district court dispute between the parties involving the '450 patent has ended with prejudice as to Patent Owner's infringement claim, making institution an inefficient use of Board resources; Petitioner waited until the last allowable day despite years of actual notice; settled expectations weigh in Patent Owner's favor; the Petition substantially reuses art and arguments already considered by

the Office; and the current record does not show that the accused Google products are manufactured in the United States. On this record, efficiency, fairness, and integrity of the patent system are best served by discretionary denial under 35 U.S.C. § 314(a), and the overlap in art and arguments also supports denial under 35 U.S.C. § 325(d).

Date: April 9, 2026

Respectfully submitted,

/Brett Cooper/

Brett Cooper, Reg. No. 55,085  
Lead counsel for Patent Owner

## **CERTIFICATION REGARDING WORD COUNT**

Pursuant to 37 C.F.R. § 42.24(d), Patent Owner certifies that there are no more than 2,069 words in the paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1).

Dated: April 9, 2026

/Brett Cooper/

Brett Cooper, Reg. No. 55,085

BC Law Group, P.C.

200 Madison Avenue, 24th Floor

New York, NY 10016

Phone: (212) 951-0100

bcooper@bc-lawgroup.com

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

The undersigned hereby certifies that the above document was served on April 9, 2026, 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 Petitioners:

Jessica Kaiser (Reg. No. 58,937)  
[kaiser-ptab@perkinscoie.com](mailto:kaiser-ptab@perkinscoie.com)  
PERKINS COIE LLP  
1900 Sixteenth Street, Suite 1400  
Denver, CO 80202-5255  
Telephone: (303) 291-2300

Christopher Marando (Reg. No. 67,898)  
[Marando-ptab@perkinscoie.com](mailto:Marando-ptab@perkinscoie.com)  
PERKINS COIE LLP  
700 Thirteenth Street N.W., Suite 800  
Washington, DC 20005-3960  
Telephone: (202) 654-6200

[Google-Clear-IPR@perkinscoie.com](mailto:Google-Clear-IPR@perkinscoie.com)

Date: April 9, 2026

/Brett Cooper/

BC Law Group, P.C.  
200 Madison Avenue, 24th Floor  
New York, NY 10016  
(212) 951-0100

Brett Cooper  
Reg. No. 55,085  
Attorney for Patent Owner