

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

ACCUSEARCH TECHNOLOGIES LLC,
Patent Owner.

Case No. IPR2026-00289
Patent No. 11,971,937

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S DISCRETIONARY DENIAL BRIEF**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT	3
	A. Google Is Not Seeking To Multiply Litigation Expenses	3
	B. The Office Committed Material Error.....	4
	C. Settled Expectations Do Not Merit Discretionary Denial.....	6
	D. Google Is Not Pressing Inconsistent Claim-Construction Positions.....	8
	E. Speculative Need for Discovery Does Not Favor Denial	11
	F. The <i>Fintiv</i> Factors Favor Institution.....	13
	1. Factor 1: A Stay Is Likely	13
	2. Factor 2: The District Court Trial Is After the FWD	14
	3. Factor 3: Much Work Remains in the District Court.....	15
	4. Factor 4: Given the Distant Trial Date and High Likelihood of a Stay, Overlap Between the Proceedings Is Largely Immaterial	15
	5. Factor 5: Whether the Parties Are the Same Is Neutral	16
	6. Factor 6: Other Considerations Weigh Against Denial	16
	G. The Petition Is Not Overly Reliant on Expert Testimony	18
III.	CONCLUSION.....	20

TABLE OF AUTHORITIES

CASES

<i>Apple Inc. v. Ferid Allani</i> , IPR2025-00856, Paper 11 (Dir. Sept. 5, 2025)	7
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	1, 13, 15
<i>Apple Inc. v. PanSys Techs.</i> , IPR2025-00911, Paper 10 (Dir. Sept. 3, 2025)	14
<i>Bio-Rad Labs. v. Cal. Inst. of Tech.</i> , IPR2024-01451, Paper 11 (PTAB Mar. 27, 2025).....	15, 16
<i>Corteva Agriscience v. Monsanto Co.</i> , 1:22-cv-01046-GBW, ECF 212 (D. Del. Jan. 9, 2024).....	14
<i>DISH Techs., LLC v. fuboTV Media, Inc.</i> , 1:23-cv-0098-GBW, ECF 56 (D. Del. Aug. 13, 2024)	14
<i>DISH Techs., LLC v. Yanka Indus., Inc.</i> , 1:23-cv-01305-GBW, ECF 27 (D. Del. Jan. 24, 2025).....	14
<i>Freightcar Am., Inc. v. Nat’l Steel Car, Ltd.</i> , IPR2025-01046, Paper 20 (Dir. Oct. 10, 2025)	15
<i>Int’l Bus. Mach. v. Rakuten, Inc.</i> , 680 F. Supp. 3d 531 (D. Del. 2023)	13
<i>In re Kao</i> , 639 F.3d 1057 (Fed. Cir. 2011)	11, 13
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	17
<i>Newell Cos., Inc. v. Kenney Mfg. Co.</i> , 864 F.2d 757 (Fed. Cir. 1988)	12
<i>Ormco Corp. v. Align Tech., Inc.</i> , 463 F.3d 1299 (Fed. Cir. 2006)	3, 11, 13

<i>Padagis US LLC v. Neurelis, Inc.</i> , IPR2025-00464, Paper 12 (Dir. July 16, 2025).....	6
<i>PPC Broadband. v. Charles Indus.</i> , 1:22-cv-01517-GBW, ECF 63 (D. Del. March 26, 2024)	14
<i>Realtime Data LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019)	10
<i>ResMed Corp. v. Cleveland Med. Devices, Inc.</i> , IPR2025-00246, -00247, Paper 10 (Dir. June 12, 2025)	8
<i>Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.</i> , IPR2025-00632, Paper 20 (Dir. Nov. 3, 2025)	8, 10
<i>Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.</i> , IPR2024-01296, Paper 9 (PTAB Feb. 25, 2025)	16
<i>Tesla, Inc. v. Charge Fusion Techs. LLC</i> , IPR2025-00032, Paper 11 (PTAB May 19, 2025)	19
<i>Torchlight Techs. v. Daimler AG</i> , 1:22-cv-00751-GBW, ECF 163 (D. Del. March 6, 2024)	14
<i>Zimmer Biomet Holdings, Inc. v. LifeNet Health, Inc.</i> , IPR2025-00248, Paper 13 (Dir. June 26, 2025)	18

REGULATIONS

37 C.F.R. § 42.65(a).....	19
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OTHER AUTHORITIES

Fed. R. Civ. Pro. 12(a)(1)(A)(i)	4
Stewart, C.M. <i>Interim Processes for PTAB Workload Management Memorandum</i> (Mar. 26, 2025)	7
U.S. Congress, Senate, Committee on the Judiciary, <i>The Patent Reform Act of 2007</i> S.Rep. No. 110-259 (2008)	4
U.S. Congress. House Committee on the Judiciary. <i>America Invents Act</i> H.R.Rep. No. 112-98, pt. 1 (2011)	2

LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 11,971,937
1002	Prosecution History of U.S. Patent No. 11,971,937
1003	Declaration of Benjamin B. Bederson, Ph.D. (“Bederson-Decl.”)
1004	Curriculum Vitae of Benjamin B. Bederson, Ph.D.
1005	U.S. Patent Application Publication No. 20100145923A1 (“Wang”)
1006	U.S. Patent No. 8,880,547 (“Mills”)
1007	U.S. Patent Application Publication No. 20070168344A1 (“Brinson”)
1008	U.S. Patent Application Publication No. 20090248511A1 (“Mehta”)
1009	U.S. Patent Application Publication No. 20060059126A1 (“Naick”)
1010	U.S. Patent Application Publication No. 20020174118A1 (“Bates”)
1011	U.S. Patent No. 9,098,569 (“Bhagat”)
1012	U.S. Patent Application Publication No. 20090287676A1
1013	U.S. Patent Application Publication No. 20080091834A1 (“Norton”)
1014	U.S. Patent Application Publication No. 20160012050A1 (“Bursey”)
1015	U.S. Patent Application Publication No. 20120191531A1
1016	U.S. Patent Application Publication No. 20090292595A1
1017	U.S. Patent Application Publication No. 20110054998A1
1018	U.S. Patent No. 8,473,492
1019	U.S. Patent Application Publication No. 20070273708A1
1020	U.S. Patent Application Publication No. 20100138293A1
1021	U.S. Patent Application Publication No. 20080150901A1
1022	U.S. Patent Application Publication No. 20110246921A1
1023	U.S. Patent Application Publication No. 20080147638A1
1024	U.S. Patent Application Publication No. 20020057298A1
1025	U.S. Patent No. 7,152,064
1026	U.S. Patent No. 8,095,876
1027	U.S. Patent Application Publication No. 20080071738A1
1028	U.S. Patent No. 5,826,260
1029	U.S. Patent No. 7,200,820
1030	U.S. Patent No. 8,407,217
1031	U.S. Patent Application Publication No. 20080208819A1
1032	U.S. Patent Application Publication No. 20060253431A1
1033	U.S. Patent Application Publication No. 20030105744A1
1034	U.S. Patent No. 7,296,021
1035	U.S. Patent Application Publication No. 20030055810A1
1036	U.S. Patent Application Publication No. 20040162814A1

Exhibit	Description
1037	U.S. Patent No. 7,555,476
1038	U.S. Patent No. 7,693,833
1039	U.S. Patent No. 8,402,032
1040	U.S. Patent No. 8,938,463
1041	U.S. Patent No. 6,718,363
1042	International Application Publication No. WO2011035426A1
1043	U.S. Patent No. 6,012,053
1044	U.S. Patent Application Publication No. 20070112761A1
1045	U.S. Patent Application Publication No. 20080071739A1
1046	U.S. Patent Application Publication No. 20040177064A1
1047	U.S. Patent Application Publication No. 20090187554A1
1048	U.S. Patent No. 5,946,678
1049	U.S. Patent Application Publication No. 20060004734A1
1050	U.S. Patent Application Publication No. 20090276418A1
1051	U.S. Patent Application Publication No. 20080155411A1
1052	U.S. Patent Application Publication No. 20050021512A1
1053	U.S. Patent Application Publication No. 20050120016A1
1054	U.S. Patent Application Publication No. 20080010269A1
1055	U.S. Patent Application Publication No. 20070239662A1
1056	U.S. Patent Application Publication No. 20050177555A1
1057	U.S. Patent Application Publication No. 20080140712A1
1058	U.S. Patent Application Publication No. 20060136400A1
1059	U.S. Patent Application Publication No. 20080208835A1
1060	U.S. Patent Application Publication No. 20080155399A1
1061	U.S. Patent Application Publication No. 20170060856A1
1062	U.S. Patent Application Publication No. 20100262568A1
1063	U.S. Patent No. 5,659,732
1064	Plaintiff's Disclosure of Initial Infringement Contentions, in AccuSearch Techs. LLC v. Google LLC, 25-514-GBW (D. Del. Dec. 17, 2025)
1065	U.S. Patent Application Publication No. 2007/0100804A1
1066	Shneiderman, Designing the User Interface: Strategies for Effective Human-Computer Interaction (3d ed. 1998)
1067	U.S. Patent Application Publication No. 20080221887A1
1068	U.S. Patent Application Publication No. 20040111467A1
1069	U.S. Patent Application Publication No. 20040162814A1
1070	Declaration of Robert Osann, Jr., in AccuSearch Techs. LLC v. Google LLC, 25-514-GBW (D. Del. July 11, 2025)
1071	U.S. Patent Application Publication No. 20020156917A1

Exhibit	Description
1072	U.S. Patent Application Publication No. 20110119243A1
1073	U.S. Patent Application Publication No. 20100198821A1
1074	U.S. Patent No. 8,515,731
1075	U.S. Patent Application Publication No. 20090210404A1
1076	U.S. Patent Application Publication No. 20110035401A1
1077	U.S. Patent No. 8,165,972
1078	U.S. Patent No. 8,055,669
1079	U.S. Patent No. 6,999,959
1080	Chang, et al., “Search Engines’ Help Systems,” Fifth International Conference on Information Technology: New Generations (IEEE 2008)
1081	U.S. Patent Application Publication No. 20020194166A1 (“Fowler”)
1082	U.S. Patent Application Publication No. 20070239676A1 (“Stonehocker”)
1083	Chi, Ed H., et al. “Using information scent to model user information needs and actions and the Web,” Proceedings of the SIGCHI conference on Human factors in computing systems (2001)
1084	Declaration of Nathan R. Speed in Support of Admission <i>Pro Hac Vice</i>
1085	Search Results from USPTO’s Patent Public Search (June 2026)
1086	AccuSearch’s First Amended Complaint for Patent Infringement, in AccuSearch Techs. LLC v. Google LLC, 25-514-GBW (D. Del. Jul. 11, 17, 2025)
1087	Opening Brief in Support of Defendant’s Motion to Stay Proceeding Pending Inter Partes Review, in AccuSearch Techs. LLC v. Google LLC, 25-514-GBW (D. Del. Mar. 25, 2026)

I. INTRODUCTION

The Director should not discretionarily deny Google’s Petition. The Board is best positioned to address material errors the Office committed during original prosecution of the ’937 patent, and the high likelihood that the district court case will be stayed ensures this trial will serve as an alternative to district court litigation.

During prosecution, the examiner allowed the challenged claims because he concluded the prior art did not annotate search results to indicate which search terms are missing in each search result. In reaching that conclusion, the examiner committed a material error—he failed to search for references whose disclosures include obvious variants of the word “missing” like “absent.” Had he searched for references that share the patent’s classification codes and used such variants, he would have found at least the prior-art Bates reference that headlines the Petition’s Grounds 1A-1D and discloses a system with annotations indicating whether each search term “is present or *absent* in each” search result. EX1010, [0024].¹

Separately, the district court trial is scheduled to occur eight months *after* the FWD is due in this case, and the district court is highly likely to stay its case pending resolution of this IPR. Accordingly, the *Fintiv* factors and the Office’s concern with inefficiencies weigh heavily *against* discretionary denial.

¹ Emphasis added throughout unless otherwise indicated.

AccuSearch’s arguments in favor of discretionary denial are weak. AccuSearch’s claim that Google is seeking to multiply litigation expense is unfounded. Google filed a motion to stay the district court case precisely to avoid further expense and to allow this “cost effective alternativ[e] to litigation” to proceed. H.R.Rep. No. 112-98, pt. 1, p. 48 (2011). In opposing a stay, it is AccuSearch—not Google—that imposes unnecessary expenses on the parties.

AccuSearch says Google is taking claim-construction positions in its Petition that contradict positions Google is taking in district court, but Google’s positions in the two forums are the same. Indeed, Google’s Petition mapped the claims to the prior art using the same language Google is using in district court—there is no inconsistency. And AccuSearch’s claim that Google is pursuing indefiniteness theories in district court focuses on Google’s *preliminary* contentions and ignores that Google has not advanced such theories in more recent *Markman* filings submitted *after* the Petition’s filing.

As for settled expectations, AccuSearch focuses on an unsolicited 2017 offer to sell Google two *other* patents with *different* claims and which patents AccuSearch has *never* alleged Google infringes. That the unsolicited offer occurred *years* before AccuSearch even applied for the ’937 patent highlights the specious nature of AccuSearch’s argument. And as for the patent’s age, the ’937 patent did not issue until April 2024—*less than two years before* Google filed its Petition.

AccuSearch also claims it might need district-court-type discovery to substantiate a secondary-considerations argument it might raise. But the evidence AccuSearch speculates it might need is *legally irrelevant* to the question of obviousness because that evidence relates to claim elements that were known in the art. *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006) (“[I]f the feature that creates the commercial success was known in the prior art, the success is not pertinent.”).

Finally, AccuSearch says Google’s Petition is overly reliant on Google’s technical expert because Dr. Bederson’s declaration is purportedly long and cites many exhibits. But the declaration is thorough because Dr. Bederson supports his opinions with objective evidence and explanation rather than mere say-so. Such thoroughness is applauded by the Board, as it should be.

II. ARGUMENT

A. Google Is Not Seeking To Multiply Litigation Expenses

AccuSearch says Google filed its Petition to “multiply” costs “by forcing the parties to litigate” in two forums. Paper 8 (“DD-Br.”), 3-4. But Google filed a motion to *stay* the district court litigation precisely to “prevent the parties and the [district court] from expending substantial resources on...matters that may be rendered unnecessary by the PTAB’s review.” EX1087, 1. Google is not trying to multiply costs; rather Google is pursuing “a quick, inexpensive, and reliable

alternative to district court litigation.” S.Rep. No. 110-259, p. 20 (2008). By opposing Google’s motion, AccuSearch is the one forcing the parties to litigate in two forums.

Separately, AccuSearch says Google waited “as long as possible” to file its Petition (DD-Br., 3), but Google filed the Petition (and three others) a month before the deadline. AccuSearch’s speculation that Google delayed filing so the district court could rule on Google’s motion to dismiss is unfounded. Google had to file its motion to dismiss first as a practical matter because of Rule 12’s timing requirements. Fed. R. Civ. Pro. 12(a)(1)(A)(i).

B. The Office Committed Material Error

The challenged claims were allowed after a single office action in which those claims were rejected solely based on obviousness-type double patenting. EX1002, 123-30. That rejection was overcome via a terminal disclaimer. *Id.*, 211-14. The examiner materially erred in allowing the challenged claims because his prior-art searches were unreasonably narrow, both failing to include highly relevant terms and requiring overly narrow terms in unnecessarily restrictive combinations.

The ’937 patent’s claims are directed to identifying search terms that are “*missing*” from a search result. *E.g.*, EX1001, 14:49-52. While the examiner’s searches *did* include “miss\$3” (*e.g.*, EX1002, 117-18) the searches did not include *any* obvious synonyms of that term even though earlier applications in the family

had used synonyms like “[a]bsent” to describe the same functionality. EX1001, 1:18-22 (“Internet Search Results Annotation for Search Term Elements Present or *Absent* in Referenced Webpages and Descendant Webpages”). The examiner’s searches also never used the term “keyword,” despite it too being an obvious variant of phrases like “search term” or “query word” that the examiner did consider. EX1002, 117-18 (searching for “(search OR query) near3 (term\$1 OR string\$1 OR character\$1 OR word\$1)”). The examiner’s failure to include an obvious variant of his search terms (“keyword”) was unreasonable and caused him to miss key prior art.

For example, if the examiner had conducted a priority-date-restricted search of “(miss\$3 OR **absen\$3**) NEAR3 ((search OR query) NEAR3 (term\$1 OR string\$1 or character\$1 or word\$1) OR **keyword**)” in the patent’s classification code G06F16/338 (“Presentation of query results”), the resulting search would have yielded only 13 patent families, one of which included Bates (*see* EX1085, 1), which uses the terms “absent” (not “missing”) and “keywords” (not, *e.g.*, “search term”) (*see* EX1010, [0011]). A similar priority-date-restricted search of “((missing OR absent) NEAR (term OR keyword))” in classification code G06F16/338 would have yielded only three references—two of which are Bates and its issued patent—out of the more than 4,000 references in that classification. *See* EX1085, 2.

The examiner’s search was manifestly unreasonable and caused substantial error in the Office’s examination. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 3 (Dir. July 16, 2025) (informative) (institution is “an appropriate use of Office resources” to address “concerns of material error”).

C. Settled Expectations Do Not Merit Discretionary Denial

Recognizing that its patent is *less than two years old*, AccuSearch focuses its settled-expectations argument primarily on the fact that a patent broker sent Google an unsolicited patent-acquisition proposal in 2017 that identified two patents distantly related to the ’937 patent—*i.e.*, seven and eight generations removed—as well as an application that would become the patent’s great-great-great-great-grandparent. DD-Br., 6-8. According to AccuSearch, because Google knew about those patents and application in 2017 and never challenged them, AccuSearch “has very strong settled expectations that the patents in the family are patentable.” *Id.*, 8. AccuSearch’s position is meritless.

As an initial matter, AccuSearch does not (and could not) allege that it made Google aware of the ’937 patent in that offer—the patentee did not even file the application that would become the ’937 patent until *six years after* that reach-out and the ’937 patent did not issue until April of 2024.

Significantly, although AccuSearch’s broker offered to sell two patents and an application to Google, the broker conspicuously never even suggested that Google was infringing the patents. EX2004. And after Google declined to buy the assets, AccuSearch subsequently did not sue Google on those patents, even though AccuSearch alleges that Google has annotated search results to indicate missing search terms since 2012. EX1086, ¶¶123-124. Even today, AccuSearch has not alleged that Google infringes the two offered-for-sale patents or the patent that resulted from the offered-for-sale application. As AccuSearch’s inaction highlights, Google had no need to challenge the validity of the AccuSearch patents because their claims were simply not necessary or beneficial to Google’s technology. That Google did not challenge these earlier patents thus could not plausibly cause AccuSearch to expect that Google would not challenge a later-issued patent with different claims, whose application was not even filed until *six years after* the 2017 solicitation.

The Office has made clear that it is the “length of time *the claims* [*i.e.*, those challenged] have been in force” that is relevant to the “settled expectations of the *parties*.” PTAB March 26, 2025, Guidance, 2. Other patents in the same family that have been in existence longer have no relevance, especially where the patentee’s own actions confirmed that those prior patents were not relevant to the petitioner’s technology. *See, e.g., Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11, 2-3 (Dir. Sept. 5, 2025) (finding discretionary denial “not appropriate” for 13-year-old patent

where the petitioner “did not expect enforcement”). For similar reasons, AccuSearch’s argument that *an examiner* (not Google) cited in a Notice of References Cited a different, *unasserted* AccuSearch patent application during prosecution of a Google patent is also immaterial. DD-Br., 8-9.

Turning to the claims of the ’937 patent themselves, they have been in force for *two years*.² AccuSearch has no settled expectations that such a recently issued patent would not be challenged; indeed, the patent’s young age weighs against discretionary denial. *ResMed Corp. v. Cleveland Med. Devices, Inc.*, IPR2025-00246, -00247, Paper 10, 2 (Dir. June 12, 2025) (“The challenged patents were issued recently, in 2024. Early challenges favor robust, predictable patent rights and weigh against discretionary denial.”).

D. Google Is Not Pressing Inconsistent Claim-Construction Positions

The Director’s *Revvo* decision cautions petitioners against “arguing *different* claim construction positions before a district court and the Board” without explaining “why the *different* positions are warranted.” *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 3-4 (Dir. Nov. 3, 2025).

² Notwithstanding, the Director lacks the statutory authority to deny institution based on the age of the challenged patent. See *Petition for a Writ of Certiorari, Google LLC v. VirtaMove Corp.*, No. 25-1230 (S. Ct. Apr. 27, 2026).

Revvo is inapplicable because Google is not taking ***different*** positions.

AccuSearch points to two terms for which Google has proposed express constructions in the district court. DD-Br., 4-6. The first is the “*selectable-filtering function*” term discussed in Google’s Petition at page 55. As its Petition makes clear, Google mapped that limitation to the prior art in a manner that is entirely consistent with its district-court position—indeed, Google used the ***same exact language***. *Compare* Petition, 27 (arguing the proposed combination would “caus[e] the system to display an updated set of search results by removing, from the already-identified search results, references to webpages that are missing one or more terms from the user’s query”) *with* EX2002, 5. Google’s positions in the two forums as to the scope of the “*selectable-filtering function*” limitation are ***exactly the same***.

The second term is “*descendant webpage*.” Again, Google’s Petition mapped the prior art to this term using language substantively identical to that used in Google’s district court construction. *Compare* Pet., 59 (“A ‘*descendant webpage*’ is a webpage to which a search-result webpage links; for example, if www.uspto.gov is the search-result webpage, then www.uspto.gov/patent is a ‘*descendant webpage*’ because a link to this webpage is found at www.uspto.gov”) *and* EX1003, ¶60 (“accessible via a link within the referenced webpage”) *with* EX2002, 6. As the Petition highlights, the Naick reference (EX1009) is explicit that it determines whether webpages within ***the same domain*** as a search-result webpage contain a

search term. Pet., 65-67 (citing, *e.g.*, FIG. 5A & 5B). There is no inconsistency.

That Google explicitly defined the plain meaning of “*descendant webpage*” and “*selectable-filtering function*” in district court but did not do so here does not mean that Google is taking different positions. Google’s proposed constructions in the district court ***are*** the two terms’ plain meaning—Google simply articulated what the meaning is to aid a lay jury’s understanding of the claims. Google had no need to provide such explicit guidance to the Board because the prior art meets the challenged claims under any reasonable understanding of their plain meaning and the Board thus has no need to expressly construe the terms to evaluate Google’s Petition. *Realtime Data LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (only those terms “necessary to resolve the controversy” need be construed).

At bottom, there is no difference (let alone inconsistency) between Google’s claim-construction positions in the two forums, and Google’s Petition demonstrates that the district-court constructions are met by the prior art. *Revvo* is inapplicable.

Separately, AccuSearch notes that Google’s ***preliminary*** invalidity contentions identified certain terms as potentially being indefinite. DD-Br., 5-6 (citing EX2011). But Google did not, in fact, identify any terms as being indefinite in its more recent claim-constructions filings. *See* EX2002 (dated Apr. 23, 2026); EX2011 (dated Feb. 18, 2025). Again, Google is not taking inconsistent positions.

E. Speculative Need for Discovery Does Not Favor Denial

AccuSearch argues it *might* need discovery from Google (and others) to try to establish certain objective indicia of non-obviousness, and that such discovery is more easily obtained in district court. DD-Br., 14-15. This is pure speculation as AccuSearch has not even identified what specific discovery it seeks nor explained why it could not obtain such discovery over the course of this IPR trial. AccuSearch also ignores that the parties have already agreed that at least some documents from the litigation (EX2004, EX2013) can be used in this proceeding.

In essence, AccuSearch is contending that if a patentee says it *might* advance a secondary-consideration argument, then only a district court should evaluate that argument. But the Board often evaluates allegations of secondary considerations, and thus the mere existence of such a *potential* argument does not weigh in favor of discretionary denial.

Regardless, for AccuSearch's speculative evidence of secondary considerations to be afforded weight "there must be a nexus" between that evidence and "some aspect of the claim not already in the prior art." *In re Kao*, 639 F.3d 1057, 1069 (Fed. Cir. 2011). If a patentee's evidence of alleged commercial success relates to a feature that "was known in the art," then the evidence—as a matter of law—"is not pertinent." *Ormco Corp.*, 463 F.3d at 1312.

AccuSearch suggests the evidence it *may* seek will show a long-felt need for

a system that could “annotate results to show when some, or all, of the search terms entered by a user are missing from the webpage located at a URL returned by [the Internet search results page].” DD-Br., 13. The Bates reference, however, discloses such a system and did so nearly a decade before the patent’s earliest possible priority date. EX1010, [0010]-[0016]. The “correlation indicators” in Bates are annotations added to a search-results webpage and those annotations indicate “whether each keyword is present or absent in each” search result. *Id.*, [0011]. Thus, even if at some point in time there was a need for a system that annotated search results to indicate the presence or absence of search terms, Bates satisfied that need *years* before AccuSearch—“there was no long-felt need.” *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988).

AccuSearch also suggests that allowing search engines to refine a user’s search “by removing search terms” from the initial query “led to unprecedented commercial success.” DD-Br., 13-14. But this too was in the prior art. The prior-art Wang reference discloses “relaxed searching” where a search engine identifies search results “that include only a subset of the keywords submitted by a user.” EX1005, [0014], [0031]. Mills and Bhagat both do too. EX1006, 4:39-53 (describing “altered” search queries); EX1011, 1:58-2:4 (describing “suggested queries”). Search engines that could refine a user’s query by removing search terms were already known, and AccuSearch’s speculative evidence that such systems were

commercially successful is legally irrelevant. *Ormco*, 463 F.3d at 1312.

“Where the offered secondary consideration actually results from something other than what is both claimed and *novel* in the claim, there is no nexus to the merits of the claimed invention.” *Kao*, 639 F.3d at 1068 (emphasis original). AccuSearch’s alleged need for legally irrelevant evidence does not merit discretionary denial.

F. The *Fintiv* Factors Favor Institution

The *Fintiv* factors are designed to address situations where the Board’s FWD is due *after* a co-pending district court trial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 3 (PTAB Mar. 20, 2020) (precedential). Here, the district court trial is not scheduled to occur until April 2028, meaning that the FWD is due a full eight months *before* the trial. The efficiency concerns driving *Fintiv*—that the district court would resolve validity before the Board—simply do not exist here. Unsurprisingly, the *Fintiv* factors weigh against discretionary denial.

1. Factor 1: A Stay Is Likely

Google has moved to stay the district court litigation. EX1087. AccuSearch says a pre-institution “stay is almost never” granted (DD-Br., 8), but this is immaterial because *Fintiv* examines whether a stay is likely “if a proceeding *is instituted*.” *Fintiv*, 6. On that question, the presiding judge has said that “it has become fairly *routine* to stay cases after IPR have been instituted.” *Int’l Bus. Mach. v. Rakuten, Inc.*, 680 F. Supp. 3d 531, 536 n.2 (D. Del. 2023) (quotation omitted); *Consumeron, LLC v. MapleBear, Inc.*, 1:21-cv-01447-GBW, 2023 WL 3434002,

*1-3 (D. Del. May 12, 2023) (granting post-institution stay).

Indeed, given the “routine” nature of post-institution stays before the presiding judge, many patentees simply stipulate to such stays. *See, e.g., DISH Techs., LLC v. fuboTV Media, Inc.*, 1:23-cv-0098-GBW, ECF 56 (D. Del. Aug. 13, 2024); *PPC Broadband. v. Charles Indus.*, 1:22-cv-01517-GBW, ECF 63 (D. Del. March 26, 2024); *Torchlight Techs. v. Daimler AG*, 1:22-cv-00751-GBW, ECF 163 (D. Del. March 6, 2024); *Corteva Agriscience v. Monsanto Co.*, 1:22-cv-01046-GBW, ECF 212 (D. Del. Jan. 9, 2024); *DISH Techs., LLC v. Yanka Indus., Inc.*, 1:23-cv-01305-GBW, ECF 27 (D. Del. Jan. 24, 2025).

Accordingly, if the Director institutes IPR, then the district court litigation will likely be stayed, only this IPR will move forward, and it will function as an alternative to the district court trial. Factor 1 weighs against discretionary denial.

2. Factor 2: The District Court Trial Is After the FWD

The district court trial is scheduled for April 2028—a full eight months after the FWD would be due. Where, as here, the FWD is due *before* the trial date, “the concern of inconsistent outcomes or significant duplication of efforts” is “reduce[d].” *Apple Inc. v. PanSys Techs.*, IPR2025-00911, Paper 10, 2 (Dir. Sept. 3, 2025). Indeed, when combined with a high likelihood of a stay, an FWD-deadline before trial “weigh[s] against discretionary denial.” *Freightcar Am., Inc. v. Nat’l Steel Car, Ltd.*, IPR2025-01046, Paper 20, 2 (Dir. Oct. 10, 2025).

3. Factor 3: Much Work Remains in the District Court

By institution, the parties will have made only modest investments in the district court case. The parties have exchanged initial disclosures and contentions and will soon engage in claim-construction briefing, but the *Markman* hearing itself is not scheduled to occur until after institution. EX2001, 13; *Fintiv*, 10 (“If, [by institution], the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.”).

Moreover, more significant investments are not scheduled to occur until late spring (*e.g.*, final contentions, expert discovery) and fall (*e.g.*, dispositive motions) of *next year*—long after the institution decision is due. EX2001, 6, 13-14; *Bio-Rad Labs. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, 9-10 (PTAB Mar. 27, 2025) (factor 3 weighs against denial where “much more work remains”). Given the high likelihood of a post-institution stay, the parties would likely *avoid* these significant investments if institution is granted. Those investments would be avoided entirely if Google prevails—and if AccuSearch prevails, statutory estoppel would streamline the case and reduce the cost of those potential future activities.

4. Factor 4: Given the Distant Trial Date and High Likelihood of a Stay, Overlap Between the Proceedings Is Largely Immaterial

Where, as here, there is “no persuasive evidence that the court’s trial date would be expected to be significantly before” the FWD, then “less weight” is

assigned “to the existence of an overlap in asserted claims and prior art.” *Bio-Rad Labs.*, 13. This reasoning makes even more sense in this case where the likelihood of a post-institution stay is high—if such a stay is granted, there would be no overlap in issues as statutory estoppel would ensure that only the Board decides the patentability issues overlapping the two proceedings.

Even without a stay, this proceeding would end eight months before the current district court trial, triggering statutory estoppel, and ensuring no overlapping issues would be presented to the jury. Indeed, the FWD deadline is so early (September 2027) that estoppel would trigger before the district court would even consider dispositive motions under the current schedule. EX2001, 13-14.

5. Factor 5: Whether the Parties Are the Same Is Neutral

The parties are the same. This factor is thus “neutral.” *Shenzhen Root Tech. Co. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9, 19-20 (PTAB Feb. 25, 2025).

6. Factor 6: Other Considerations Weigh Against Denial

Google’s Petition explains in detail why the challenged claims are unpatentable. As the Petition establishes (and unbeknownst to the examiner due to his erroneous search methodology), systems that annotated search results to allow a user to easily know whether a search term was missing from the returned search results were well-known and so too were techniques for formatting such annotations. The Petition’s strong merits should weigh in favor of institution.

As expected, AccuSearch says the Petition is weak, but identifies no glaring

deficiency and simply advances fact-based arguments as to what the prior art taught and what a POSA would have been motivated to do in view of those teachings. DD-Br., 19-20. For example, AccuSearch concedes that Bhagat and Mills annotate search results by displaying the text of search terms next to search results but argues that a POSA would not have applied those teachings to Bates or Wang because Bhagat and Mills use suggested queries generated after an initial query whereas Bates and Wang are focused on an initial query. *Id.* Yet, even if AccuSearch were right that there is some relevant distinction between the two searches (there is none), the use of a known technique to improve *similar* systems is obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). At minimum, such a run-of-the-mill fact dispute is one the Board routinely resolves and does not merit discretionary denial.

AccuSearch's claim that the Petition's Bates-alone ground relies on general knowledge to supply a limitation (DD-Br., 19) ignores Bates' teaching that its color-code map (which its color indicators, *i.e.*, annotations, mirror) can take the form of the search terms themselves. *See* Pet., 9-11, 17-22. And AccuSearch's claim that the Petition is weak because some of its obviousness grounds rely on more than two references is meritless. DD-Br., 18-19. AccuSearch's dependent claims merely add well-known design elements—like a click-able icon for filtering results—to the system of the independent claims. Such design elements were well known in the art (and the patent never suggests otherwise). That several different references disclose

these known design elements, rather than only one single reference, reinforces their routine nature and does not suggest any weakness in the Petition.

Apart from its merits, Google's Petition is also one of four petitions Google has filed against related AccuSearch patents that share a common specification and are directed to similar technologies. Given the overlap in technologies, it would be more efficient for the Board to consider all four challenges. *See, e.g., Zimmer Biomet Holdings, Inc. v. LifeNet Health, Inc.*, IPR2025-00248, Paper 13, 3 (Dir. June 26, 2025) (finding it is "an efficient use of Board resources to address [related patents]").

G. The Petition Is Not Overly Reliant on Expert Testimony

AccuSearch argues discretionary denial is appropriate because the Petition is overly reliant on expert testimony. DD-Br., 17-18. AccuSearch fails, however, to identify any aspect where the Petition, in fact, improperly relies on Dr. Bederson's testimony to fill gaps in the prior art, or relies on any arguments in Dr. Bederson's declaration that are not otherwise set forth in the Petition.

AccuSearch's principal complaint is that Dr. Bederson's declaration is allegedly long and cites many corroborating exhibits. AccuSearch's focus on page length and number of exhibits exalts form over substance. The length of Dr. Bederson's declaration and the number of exhibits he discusses therein are a byproduct of his thoroughness in providing corroboration for his testimony instead of simply relying on his own say-so. Rather than parrot the Petition's arguments,

Dr. Bederson provides detailed testimony explaining his opinions and the evidentiary support that corroborates those opinions. This is exactly what the Board expects an expert to do. 37 C.F.R. § 42.65(a) (testimony lacking “facts or data” is “entitled to little or no weight”); *Tesla, Inc. v. Charge Fusion Techs. LLC*, IPR2025-00032, Paper 11, 39 (PTAB May 19, 2025) (“applaud[ing]” expert that “leave[s] virtually none of the substance of his testimony unsupported by objective evidence”).

The examples of alleged overreliance that AccuSearch cites only serve to highlight how Google properly relies on Dr. Bederson to substantiate the Petition’s arguments. For example, AccuSearch faults the Petition for defining the POSA in a single sentence, while citing five paragraphs from Dr. Bederson to support that definition. DD-Br., 17. Three of those paragraphs summarize Dr. Bederson’s understanding of the law and the patent’s technical field (§§33-35), the fourth identifies a POSA’s qualifications consistent with the Petition’s POSA definition (§36), and the last confirms he has those qualifications (§37). The Petition does not, as AccuSearch alleges, incorporate by reference any argument from those paragraphs—the Petition simply cites Dr. Bederson’s complete testimony on the seemingly non-controversial issue of a POSA’s skill level.

AccuSearch also correctly observes that Google cited Dr. Bederson to describe the background knowledge a POSA would have had brought to bear when

interpreting the Petition’s prior-art references, but AccuSearch then incorrectly argues Google’s Petition does not provide “explanation of the contents of Dr. Bederson’s opinions[.]” DD-Br., 18. The Petition does precisely that. It says a POSA would have known a particular fact—*e.g.*, that there were known benefits to making user interfaces easy to use (*e.g.*, Pet., 20)—and then cites Dr. Bederson’s declaration (and additional evidence) as corroboration. The relevance of Dr. Bederson’s testimony is clear from the Petition.

AccuSearch concludes by arguing that Dr. Bederson’s testimony is unfocused and fails to provide “helpful context.” DD-Br., 18. But as shown above, the very testimony AccuSearch highlights demonstrates that focused and helpful context regarding the state of the art is *exactly* what Dr. Bederson provided.

III. CONCLUSION

Discretionary denial is not warranted in this case. The ’937 patent is very young, has no settled expectations, and only issued because the examiner erred by employing overly narrow and incomplete search strings. Moreover, institution in this case is highly likely to result in a stay of the district-court case which will ensure that this IPR operates as a true substitute for costly district court litigation.

Date: June 16, 2026

Respectfully submitted,
/ Nathan R. Speed /

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on June 16, 2026, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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