UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM SERVICES LLC,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case No. IPR2026-00361

Patent No. 9,491,564

PETITIONER'S CONDITIONAL MOTION FOR JOINDER UNDER 35 U.S.C. § 315(C) AND 37 C.F.R. §§ 42.22 AND 42.122(B)

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner, Amazon.com Services LLC ("Petitioner" or "Amazon") conditionally moves for joinder with the *inter partes* review challenging U.S. Patent No. 9,491,564 ("the '564 Patent") in *Google LLC v. Headwater Research LLC*, IPR2026-00271 ("the Google IPR"), filed March 27, 2026. The Board's institution decision is due no later than October 1, 2026. This motion is timely filed because it is filed before the institution decision in the Google IPR. 37 C.F.R. § 42.122(b) ("no later than one month after the institution date of any inter partes review for which joinder is requested."). **Amazon's motion for joinder is conditioned on Google's IPR being instituted and still pending at the time of institution of this IPR.**[1]

Petitioner has conferred with Google, and Google does not oppose this Motion for Joinder. The instant Petition is substantially the same as the Google IPR petition: it involves the same patent, same claims, same grounds of unpatentability, and the same evidence (including the same prior art combinations supported by the same expert declaration) as the Google IPR. Further, Petitioner has retained the expert

[1] For example, if the Google IPR were terminated due to settlement either before or after an institution decision and prior to this motion (and institution of this IPR) being ruled upon by the Board, the Petition in this IPR should be addressed without joinder.

from the Google IPR. If joined, Petitioner will assume a "silent understudy" role and will not take an active role in the *inter partes* review proceeding unless the Google Petitioner ceases to participate in the instituted IPR. Thus, the proposed joinder will neither unduly complicate the Google IPR nor delay its schedule. Moreover, **Petitioner is not time-barred or estopped in any manner from filing its own separate petition**, but is requesting joinder with the Google IPR in the interest of judicial efficiency, to timely resolve the issue of patentability of the '564 Patent, and to avoid potential inconsistencies between distinct IPR proceedings. As such, joinder will promote judicial efficiency in determining patentability in the Google IPR without prejudice to Patent Owner.

II. BACKGROUND

Headwater Research LLC ("Headwater") is the purported owner of the '564 Patent. Headwater asserted the '564 patent against Petitioner and Google LLC in two separate actions: *Headwater Research LLC v. Amazon.com Services LLC*, No. 2:26-cv-00304 (E.D. Tex. Apr. 16, 2026) and *Headwater Research LLC v. Google LLC*, No. 7:25-cv-00231 (W.D. Tex. May 16, 2025), transferred to N.D. Cal. and assigned No. 3:26-cv-01460. Petitioner was served with the complaint for Case No. 2:26-cv-00304 on April 20, 2026, and therefore, Petitioner is not time-barred under 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b).

I. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (IPR) proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

> (c) JOINDER. – If the Director institutes an inter partes review, the Director, in his discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

The AIA's legislative history makes clear that joinder is to be liberally granted. 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl).

A motion for joinder should "(1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified." *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17, at 4 (July 29, 2013); *Hyundai Motor Co. v. Am. Vehicular Scis. LLC*, IPR2014-01543, Paper 11, at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion LLC*, IPR2014-00898, Paper 15, at 4 (Aug. 13, 2014) (quoting *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, at 4 (April 24, 2013)).

B. Amazon's Motion for Joinder is Timely

A motion for joinder is timely if the moving party files no later than one month of institution of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). Because Petitioner files this motion before a decision on the institution in the Google IPR (which is no later than one month after such a decision), this motion is timely.

C. Joinder is Appropriate

Petitioner respectfully submits that joinder with the Google IPR would be appropriate. Amazon's Petition does not raise any new grounds of unpatentability and does "not present new issues that might complicate or delay" the Google IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19, at 6 (July 9, 2014). Amazon's Petition is substantially identical to the petition in the Google IPR, challenging the same claims of the '564 Patent on the same grounds and relying on the same expert testimony. The only differences between Amazon's Petition and the petition filed in the Google IPR are the appropriate updates to the Mandatory Notices. Further, Petitioner has retained the same expert as in the Google IPR.

By joinder, a single Board decision may dispose of the issues raised in the Google IPR for all interested parties. **Petitioner Amazon will not file a separate IPR petition on the '564 Patent if the instant joinder request is granted.**

Joinder would have little, if any, impact on the Google IPR: the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on any party or the PTAB, as detailed below. In fact, joinder will help efficiently resolve the disputes among the parties.

1. Petitioner Will Not File a Separate IPR Petition if Its Copycat Petition is Granted

Although Petitioner is not time-barred or otherwise estopped from filing its own IPR petition, Petitioner will not file another IPR petition challenging the '564 Patent if its copy-cat IPR Petition (IPR2026-00361) is granted and the proceeding is joined with the Google IPR. This will not only enhance judicial efficiency, but also reduce burden on the Patent Owner by determining the patentability of the challenged claims in a single proceeding.

2. No New Grounds of Unpatentability in the Petition

Amazon's Petition does not assert any new grounds of unpatentability. It challenges the same claims (1-14) of the '564 Patent based on the same arguments and analysis, prior art, evidence (including expert declaration), and the same grounds of unpatentability as the Google IPR. *See, e.g., Hyundai*, IPR2014-01543, Paper 11, at 2-4; *Dell*, IPR2013-00385, Paper 17, at 6-10.

3. No Impact on the Schedule for the Existing IPR Proceeding

Because Amazon's Petition raises no new grounds of unpatentability, and because an institution decision for the Google IPR has not been issued yet, joinder

should have no impact on the schedule of the Google IPR. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11, at 6 (Oct. 15, 2015) (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). If joinder is granted, Petitioner will adhere to all applicable deadlines set in the Scheduling Order for the Google IPR.

As discussed further below, Petitioner is willing to limit its participation in this proceeding to a "silent understudy." In the event that the Google IPR is terminated with respect to the Google Petitioner, only then does Petitioner intend to "step into the shoes" of the dismissed petitioner and materially participate in the joined proceedings. Accordingly, for the reasons stated above, joinder of Petitioner to the Google IPR will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

4. Briefing and Discovery Will Be Simplified

As a "silent understudy," Petitioner agrees that, if joined, the following conditions will apply so long as Google remains an active party, as previously approved by the Board in other joinder circumstances:

(a) All filings by Petitioner in the joined proceeding be consolidated with the filings of Google, unless a filing solely concerns issues that do not involve Google;

(b) Petitioner shall not be permitted to raise any new grounds not instituted by the Board in the Google IPR, or introduce any argument not already introduced by Google;

(c) With regard to taking of testimony, Petitioner will abide by 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Google. *See Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17, at 5-6 (Apr. 10, 2015) (finding the same proposed limitations "are consistent with the 'understudy' role that Petitioner agrees to assume, as well as Petitioner's assertion that its presence would not require introducing any additional arguments, briefing or discovery"). Petitioner also is willing to abide by any additional conditions the Board deems appropriate.

5. No Prejudice to Patent Owner

Joinder of Petitioner to the Google IPR will not create any additional burden on Patent Owner. Patent Owner need not expend any additional resources above and beyond those required in the current Google IPR.

II. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that **if, and only if,** Google's IPR has been instituted and is still pending at the time of institution of this IPR, then Amazon's Petition for *inter partes* review of the '564 Patent (IPR2026-00361) be joined with the Google IPR (IPR2026-00271).

Respectfully submitted,

/ *Jessica Kaiser* /

Jessica Kaiser
Reg. No. 58,937
Attorney for Petitioner

Dated: May 26, 2026

CERTIFICATE OF SERVICE

I hereby certify that on May 26, 2026 true and correct copies of the foregoing **PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(C) AND 37 C.F.R. §§42.22 AND 42.122(B),** I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by FedEx on the following counsel:

Headwater Research LLC
C/O Farjami & Farjami LLP
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A courtesy copy was also sent via electronic mail to Patent Owner's litigation counsel listed below:

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Respectfully submitted,

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Dated: May 26, 2026