

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

NOBOTS LLC,
Patent Owner

Case IPR2026-00429
U.S. Patent 11,810,014

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

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EXHIBIT LIST

No.	Description
2001	U.S. Patent No. 11,810,014 (“the ’014 Patent”) (color annotated)
2002	U.S. Patent No. 9,595,008 (“the ’008 Patent”)
2003	U.S. Patent No. 10,423,885 (“the ’885 Patent”)
2004	<i>Google LLC v. Nobots LLC</i> , IPR2022-00940, Paper 1 (filed April 29, 2022)
2005	<i>Google LLC v. Nobots LLC</i> , IPR2022-00941, Paper 1 (filed April 29, 2022)
2006	Order Granting Second Motion to Stay, <i>Nobots LLC v. Google LLC</i> , Case No. 1:22-cv-585 (W.D. Tex.) (Aug. 25, 2026)
2007	U.S. Patent App. Pub. No. 2022/0398476 (“the ‘476 Publication”)
2008	Nobots’ Motion to Amend Complaint, <i>Nobots LLC v. Google LLC</i> , Case No. 1:22-cv-585 (W.D. Tex.) (March 4, 2026)
2009	Fox Business, “Google plans to move all Pixel manufacturing out of China by 2027: report,” <i>available at</i> https://www.foxbusiness.com/markets/google-plans-move-all-pixel-manufacturing-out-china-2027 (last accessed Sept. 28, 2026)
2010	Sept. 28, 2026 Docket Report, <i>Nobots LLC v. Google LLC</i> , Case No. 1:22-cv-585 (W.D. Tex.)
2011	USPTO Reexaminations – FY 2026, Quarter ending 6/30/2026, <i>available at</i> https://www.uspto.gov/sites/default/files/documents/reexamination-op-stats.pdf (last accessed Sept. 28, 2026)
2012	Yahoo! Finance, Sept. 28, 2026 Alphabet Inc. (GOOG) Stock Information, <i>available at</i> https://finance.yahoo.com/quote/GOOG/ (last accessed Sept. 28, 2026)

No.	Description
2013	Yahoo! Finance, “Alphabet Q4 2025 net income increases by 30% to \$34.5bn,” <i>available at</i> https://finance.yahoo.com/news/alphabet-q4-2025-net-income-101711104.html (last accessed Oct. 3, 2026)
2014	March 26, 2025 USPTO Memorandum on “Interim Processes for PTAB Workload Management,” <i>available at</i> https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf (“Process Memorandum”)
2015	March 11, 2026 Squires Memorandum on “Additional Discretionary Institution Considerations – U.S. Manufacturing and Small Business Use of AIA Proceedings,” <i>available at</i> https://www.uspto.gov/subscription-center/2026/uspto-issues-additional-discretionary-institution-facts (“Small Business Memorandum”)
2016	Nobots’ First Amended Infringement Contentions, <i>Nobots LLC v. Google LLC</i> , Case No. 1:22-cv-585 (W.D. Tex.) (Feb. 18, 2026)
2017	[RESERVED]
2018	[RESERVED]
2019	[RESERVED]
2020	[RESERVED]
2021	<i>Google LLC v. Nobots LLC</i> , IPR2022-00940, Paper 38 (PTAB Nov. 29, 2023)
2022	<i>Google LLC v. Nobots LLC</i> , IPR2022-00941, Paper 34 (PTAB Nov. 29, 2023)
2023	<i>Google LLC v. Nobots LLC</i> , No. 24-1432, Dkt. 5 (Fed. Cir.) (Feb. 14, 2024)
2024	<i>Google LLC v. Nobots LLC</i> , No. 24-1432, Dkt. 13 (Fed. Cir.) (July 1, 2024)

No.	Description
2025	<i>Google LLC v. Nobots LLC</i> , No. 24-1432, Dkt. 34 (Fed. Cir.) (Nov. 20, 2025)
2026	Google’s Second Preliminary Invalidity and Subject Matter Ineligibility Contentions, <i>Nobots LLC v. Google LLC</i> , Case No. 1:22-cv-585 (W.D. Tex.) (April 15, 2026)
2027	Google’s First Amended Invalidity and Subject-Matter Ineligibility Contentions, <i>Nobots LLC v. Google LLC</i> , Case No. 1:22-cv-585 (W.D. Tex.) (May 13, 2026)
2028	Google’s Redline Comparison of Second Preliminary Invalidity Contentions to First Amended Invalidity Contentions
2029	<i>Google LLC v. Nobots LLC</i> , IPR2022-00940, Paper 13 (PTAB Dec. 1, 2022)
2030	<i>Google LLC v. Nobots LLC</i> , IPR2022-00941, Paper 11 (PTAB Dec. 1, 2022)

I. INTRODUCTION

Discretionary denial is warranted here for numerous reasons.

First, Google asserts “indefiniteness” in the litigation as to the same claim terms it *expressly construes* and applies “plain and ordinary meaning” to in the Petition—facts more egregious than those in prior Director decisions denying institution for inconsistent constructions. *See Revvo Techs. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3–5 (Dir. Nov. 3, 2025) (precedential); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Dir. Nov. 5, 2025) (informative). Google failed to disclose or explain these inconsistent positions, and any attempted withdrawal would be futile. *Infra* Section III.A.

Second, Google relies on the same prior art presented during examination of the '014 Patent. *Infra* Section III.B.1. To avoid denial under § 325(d), Google must show material error—but instead argues the Examiner *must have* erred because he did not apply Board findings from two prior IPRs involving U.S. Patent Nos. 9,595,008 (“the '008 Patent”) and 10,423,885 (“the '885 Patent”) directed to *different claimed inventions* and challenged based on *different prior art combinations*. Moreover, Nobots disclosed the IPR petitions, prior art, and Google’s invalidity contentions to the Examiner, who found that it would not have been obvious to combine the prior art as claimed “*without the benefit of hindsight.*” Google’s disagreement with that reasoned determination is not material error. *Infra*

Section III.B.2.

Third, Nobots' settled expectations favor denial. *Infra* Section III.C.1. Google delayed seeking review despite early knowledge of the '014 Patent and has used the IPR process to stay the litigation for *nearly four years*. Institution would reward both Google's inconsistent claim construction positions and its serial delay strategy.

Fourth, instituting would be inefficient because the district court case will continue *even if Google invalidates all challenged claims here*. Indeed, Google failed to invalidate all asserted claims of the '008 Patent in its prior IPR. The jury will still decide invalidity and infringement of the '008 Patent, even if the '014 Patent claims are invalidated here. *Infra* Section III.C.7. The jury should decide infringement and invalidity for both patents.

Fifth, additional factors favor denial: the Petition's weakness (*infra* Section III.C.2), Google's inadequate *Sotera* stipulation (*infra* Section III.C.3), excessive expert reliance (*infra* Section III.C.4), Google's foreign manufacturing (*infra* Section III.C.5), and Google's word count circumvention (*infra* Section III.C.6).

II. FACTUAL BACKGROUND

Patent Owner filed suit against Google in December 2021 asserting the '008 and '885 Patents. Ex. 2010, Dkt. 1.

In April 2022, Google filed *inter partes* review petitions challenging both patents. Ex. 2004; Ex. 2005. The claims of the '008 and '885 Patents are

fundamentally different. *Compare* Ex. 1001, claim 1 *with* Ex. 2002, claim 1 and Ex. 2003, claim 1. Thus, all petitions relied on different prior art combinations:

'008 IPR Grounds/Art		'885 IPR Grounds/Art	'014 IPR Grounds/Art
1	<u>Willner</u>	<u>O'Sullivan</u> , Willner	<u>Willner</u> , Kitts, Broder
2	<u>Willner</u> , Kitts	<u>O'Sullivan</u> , Willner, Broder	<u>Willner</u> , Kitts, Broder, Tanzer
3	<u>O'Connell</u>	<u>O'Sullivan</u> , Willner, Tanzer	<u>Willner</u> , Kitts, Broder, Meek
4	<u>O'Connell</u> , Kitts	<u>Meek</u>	<u>Willner</u> , Kitts, Broder, Farahat
5	<u>Kitts</u>	<u>Meek</u> , Willner	
6		<u>Meek</u> , Kroll	
7		<u>Meek</u> , Willner, Broder	
8		<u>Meek</u> , Kroll, Broder	
9		<u>Meek</u> , Willner, Tanzer	
10		<u>Meek</u> , Kroll, Tanzer	
11		<u>Meek</u> , Kitts	
12		<u>Meek</u> , O'Connell	
13		<u>Meek</u> , Kitts, Broder	
14		<u>Meek</u> , O'Connell, Broder	

Ex. 2004, 13; Ex. 2005, 14; Pet., 1.

In July 2022, the district court granted Google's motion to stay pending the outcome of the IPRs, Ex. 2010, Dkts. 43, 47, 53, and in December 2022 the Board instituted trial in both proceedings. Ex. 2029; Ex. 2030.

In November 2023, the Board found: (1) '008 claims 1–17 and 20

unpatentable but claims 18 and 19 not unpatentable (Ex. 2021, 50–51) and (2) all challenged (non-disclaimed) '885 claims 3–9, 11, and 13–20 unpatentable (Ex. 2022, 54–55). The district court denied Nobots' subsequent opposed motion to lift the stay. Ex. 2010, Dkts. 59, 62, 64.

In February 2024, Google appealed the Board's decision on claims 18 and 19 of the '008 Patent, but later dropped its appeal on claim 18. Exs. 2023, 2024. In November 2025, the Federal Circuit found claim 19 unpatentable. Ex. 2025.

The stay was lifted February 17, 2026 by joint stipulation. Ex. 2010, Dkts. 70, 84. The next day, Nobots served amended infringement contentions asserting claims 1–30 of the '014 Patent, which issued in November 2023 but was unassertable while the stay was in place. Ex. 2016, 2. Nobots maintained assertion of '008 claim 18. *Id.* On March 4, Nobots amended its complaint to add the '014 Patent. Ex. 2010, Dkt. 91. Trial was set for August 9, 2027. *Id.*, Dkt. 92.

In April 2026, the court vacated all settings due to the judge's intended judicial retirement. *Id.*, Dkt. 99.

By July, claim construction briefing was complete and a hearing was set for August 26. *Id.*, Dkt. 92, 106. On July 30 (the day after filing the Petition), Google moved to stay the case again pending this IPR and Nobots opposed; the court granted the stay in August 2026. *Id.*, Dkts. 108, 111, 115; Ex. 2006.

Thus, the lawsuit has been stayed in the aggregate for over **3 years and 8**

months (1,347 days) and will remain so at least until institution is decided.

On April 15, 2026, during the brief window when the stay was lifted, Google served its second invalidity contentions asserting *seven terms spanning all independent claims* are indefinite—despite proposing “ordinary and customary meaning” for all terms except “model data,” “monitored data,” “active data,” and “passive data,” for which Google proposes express constructions. Ex. 2026, 119–120; Pet., 9. Google also asserts multiple terms in claim 18 of the ’008 Patent are indefinite—though in its IPR it asserted ordinary and customary meaning. Ex. 2026, 118–119; Ex. 2004, 17. Google served amended invalidity contentions on May 13, 2026 maintaining those same indefiniteness theories. Ex. 2027, 119–121; Ex. 2028 (redline comparison). Additionally, in both contentions Google explicitly states: “Google reserves the right to assert indefiniteness as to these or other terms *following the claim construction process.*” Ex. 2026, 120; Ex. 2027, 121.

III. ARGUMENT

A. Google’s Inconsistent Claim Construction Positions Warrant Denial.

Discretionary denial is warranted when a petitioner—without sufficient explanation—asserts indefiniteness in district court while maintaining in the IPR that the claims can be construed. The Director has repeatedly denied or vacated institution on this basis. *See Revvo*, IPR2025-00632, Paper 20 at 3–5; *Tesla*, IPR2025-00340, Paper 18 at 3–4; *Ford Motor Co. v. AutoConnect Holdings LLC*,

IPR2025-01342, Paper 27 at 3–4 (Dir. May 12, 2026) (informative); *Terumo BCT, Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20 at 3–5 (Dir. May 12, 2026) (informative); *Generac Power Sys., Inc. v. Champion Power Equip., Inc.*, IPR2025-00805, Paper 40 at 4–6 (Dir. Feb. 3, 2026).¹

The *Tesla* decision is directly on point; indeed, the facts here present an even stronger case for discretionary denial. Tesla had argued only one term was indefinite in district court while telling the Board the claims should receive plain and ordinary meaning (that is, no express constructions were required). *Tesla*, IPR2025-00340, Paper 18 at 2. Here, Google contends *seven* terms—appearing in the independent claims, such that every claim depends on at least some of them—are indefinite in the litigation (Ex. 2027, 120), while in the Petition applying **express constructions** of “active data,” “passive data,” “model data,” and “monitored data,” and “ordinary and customary meaning” for all other claim terms (Pet., 9). Google even contends that several terms it proposes express constructions for in the IPR (e.g., “active data” and “passive data”) are indefinite. Ex. 2027, 120. Google also explicitly “reserves the right *to assert indefiniteness as to these or other terms following the claim construction process.*” Ex. 2027, 121. While Google’s invalidity contentions

¹ Section III of the Preliminary Response will further expound on why denial is warranted under *Revvo*. See <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (Section I.F) (listing “non-discretionary” considerations”).

asserting indefiniteness were served almost four months before filing the Petition, Google failed to inform the Office of those positions, nor explained the inconsistencies as required by *Revvo*. Allowing Google “to advance a claim construction before the Board when [it] has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Tesla*, Paper 18 at 4 (citing *Revvo*, IPR2025-00632, Paper 20 at 4–5).

Moreover, in the ’008 IPR, Google represented all terms should have “ordinary and customary meaning” except for five expressly construed terms. Ex. 2004, 17. Now—***after invalidating all but one ’008 claim under those constructions***—Google argues claim 18 is “indefinite” based on seven terms. Ex. 2027, 119. Google’s gamesmanship as to the ’008 Patent justifies denial here.

Further, any effort by Google to withdraw its inconsistent positions would be futile. In *Ford Motor*, the petitioner proposed “plain and ordinary meaning” in the IPR but served post-institution invalidity contentions alleging indefiniteness. IPR2025-01342, Paper 27 at 2. The Director denied institution, holding that the withdrawal was “insufficient” because it was made “***only after*** Petitioner’s actions ran afoul of *Revvo* and *Tesla* and ***only after*** Patent Owner” brought “those actions to the Office’s attention.” *Id.* at 3–4. Any attempt by Google to withdraw its indefiniteness assertions would necessarily come ***only after*** it had violated *Revvo*

and *Tesla*, and only after Nobots informed the Office of those inconsistencies. *See also TikTok, Inc. v. Shopsee, Inc.*, IPR2025-01485, Paper 13 (Dir. Jan. 16, 2026). Indeed, even if Google had withdrawn its inconsistent positions (it has not), it would not change the fact that it took inconsistent positions in the litigation, never informed the Office of those positions, nor explained why they were advanced by Google.

Additionally, crediting an *ex post facto* withdrawal of inconsistent positions made prior to an institution decision would effectively punish Nobots for promptly bringing the inconsistencies to the Office’s attention. It would also encourage patent owners to withhold such information from the Office until after institution, so that patent owners could seek a second bite at the apple via rehearing.

B. Denial is Warranted Under § 325(d)

The Director may deny institution because “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). When the same art was previously presented, the petitioner must show “that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 9 (PTAB Feb. 13, 2020) (precedential). Here, although the asserted art was presented during examination, Google fails to demonstrate material error. Google improperly conflates different IPR proceedings—involving different art, grounds, and claims—and treats the ’014 Patent’s claims as if they were the same as

the ones in those proceedings. The Examiner had the same six references and Google’s IPR petitions, specifically addressed the unique ’014 claim limitations and found them non-obvious. Google’s disagreement does not constitute material error.

1. Google Relies on the “Same Prior Art” Previously Presented to the Office.

The Petition alleges invalidity based on Willner (Ex. 1005), Kitts (Ex. 1009), Broder (Ex. 1011), Meek (Ex. 1008), Tanzer (Ex. 1012), and Farahat (Ex. 1022). All six references were presented during examination. Ex. 2001, 2 (“References Cited” in green). Farahat was applied in rejecting then-pending claim 6 (issued claim 13). Ex. 1002, 121. Google likewise uses Farahat to challenge claim 13. Pet., 73–74. Moreover, Nobots disclosed: (1) Google’s invalidity charts mapping those references to the ’008 and ’885 claims (blue); and (2) Google’s IPR petitions and exhibits (red). Ex. 2001, 2. While Google complains Nobots “never bothered to inform the Examiner” the Board had instituted those IPRs (Pet., 3), Nobots disclosed both IPRs, and the Examiner was clearly aware of them. They addressed fundamentally different claimed inventions based on different prior art combinations—it is unsurprising he did not mechanically apply them to the ’014 Patent. *Infra* Section III.B.2. Because the same art was presented, the burden shifts to Google to show material error. Google cannot.

2. Google Fails to Show the Examiner Materially Erred.

“If reasonable minds can disagree regarding the purported treatment of the art

or arguments,” there is no material error. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9. Google argues error because: (1) the Examiner did not apply Willner, Kitts, or Broder; (2) Nobots did not explicitly inform the Examiner that the Board had instituted IPRs; and (3) the “reasons for allowance are directly at odds with the Board’s findings in the IPRs.” Pet., 3, 7–8. This all rests on a flawed premise: that Board findings from IPRs involving *different* prior art combinations against *different* inventions should have been mechanically applied to distinct ’014 claims. Obviousness is claim-specific and combination-specific. Disagreement with the Examiner’s reasoned non-obviousness determination is not material error.

a) The Prior Art Combinations Are Different.

Google relies on disparate determinations from *different* IPR proceedings to argue error. But those determinations arose from fundamentally different prior art combinations. In the ’008 IPR, Google applied Willner, Kitts, and O’Connell as primary references; in the ’885 IPR, Google applied O’Sullivan and Meek. Ex. 2004, 13; Ex. 2005, 14. Google illogically treats these separate IPRs as a single proceeding.

The ’014 IPR presents yet another set of combinations: (1) Willner-Kitts-Broder; (2) Willner-Kitts-Broder-Tanzer; (3) Willner-Kitts-Broder-Meek; and (4) Willner-Kitts-Broder-Farahat. Pet., 3-4. Every ground requires a three- or four-reference combination—unlike both prior IPRs, where several grounds relied on single references. And every ground in the Petition applies Broder—not included in

any '008 IPR ground and added only as a tertiary reference in certain '885 IPR grounds. *None of the combinations asserted in the Petition were evaluated in either prior proceeding.*

Obviousness is combination-specific. Finding References A+B renders Claim X obvious does not establish that References A+B+C+D renders Claim Y obvious. Each combination requires its own motivation-to-combine, reasonable-expectation-of-success analyses, and element-by-element mapping. The Board's findings in the prior IPRs were limited to the combinations and claims before it; they do not mechanically translate to different combinations asserted against the '014 claims.

b) The Claimed Inventions Are Different.

Patentability is determined by a claim's specific limitations; the Board's findings as to one claim do not automatically apply to another with different limitations. Here, the claims at issue in each proceeding have different limitations.

For example, the '008 Patent's claim 1 recites a method for "assessing a confidence level" that an operator of a device is human comprising requesting data, presenting data, monitoring responses, comparing to model data, and generating a confidence value. Ex. 2002, claim 1. And the '885 Patent's claim 1 recites "testing for a presence of biometric data" and "controlling access" based on whether such data "is" or "is not present." Ex. 2003, claim 1.

The '014 claims recite different limitations. Claim 1 requires: (1) analyzing

both active and passive data “in conjunction with model data based on human interactions from *a prior session with the same website*”; (2) allowing access *without requiring a CAPTCHA if the first analysis value meets* predetermined criteria; and (3) if the first analysis fails, *providing a CAPTCHA test, performing a second analysis* assessing response accuracy, and *generating a second analysis value*. Ex. 1001, claim 1. Neither the ’008 nor ’885 claims recite this combination.

The Board did not determine: (1) that adding a ***CAPTCHA*** to a system already performing ***both*** active and passive data analysis would have been obvious (Claims 1, 21, 22); (2) whether the prior art taught “data collection data ***requesting*** active and passive data” (Claim 16); or (3) whether it would have been obvious to rely on “model data based on human interactions from a prior session *with the same website*” (Claims 1, 16, 22). Further, while the Board made certain findings regarding the prior art asserted in the ’014 IPR, the Board did not adjudicate the: (1) the three-reference Willner-Kitts-Broder combination, ***which was never asserted***; or (2) the integrated sequence of a first active-and-passive analysis against same-website prior-session model data, then a CAPTCHA, then second analysis generating a second analysis value. Other ’014 limitations—such as data collection being “***only*** active while the client computer is visiting a web page enabled with data collection data” (Claim 6), “mouse movement over a CAPTCHA test prompt” (Claim 13), and passive data comprising “at least one browser cookie and at least

one [IP] address” (Claim 11)—were also never before the Board.

The Board’s ’008 IPR finding that Willner/Kitts rendered certain claims anticipated or obvious does not establish that Willner-Kitts-Broder renders obvious claims reciting a multi-stage CAPTCHA protocol with specific active/passive data requirements. Likewise, the Board’s ’885 IPR findings about biometric-based binary access do not translate to the ’014 Patent’s more detailed analytical framework. Each claim must be evaluated against the specific combination asserted against it.

Google’s strategy of treating the ’008 and ’885 IPRs as a single proceeding—and the ’014 claims as identical to claims from that hypothetical amalgamation—is improper. Obviousness requires comparing claims to the prior art asserted against *those specific claims*, with appropriate motivation-to-combine and reasonable-expectation-of-success analyses. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Google cannot cherry-pick findings from different proceedings against different claims and fault the Examiner for not doing the same.

Google may argue that individual references’ teachings—e.g., Willner’s cursor movement analysis—are applicable. But the question is whether a POSA would have been motivated to combine those references *in the specific manner claimed*, with a reasonable expectation of success. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The Board never addressed combining Willner, Kitts, *and* Broder because Google never asserted that combination in either prior IPR. Google

cannot bootstrap a finding it never obtained from the Board.

c) Google’s Speculation Does Not Constitute Material Error.

Google argues the Examiner “failed to apply Willner, Kitts, or Broder” and “[n]or did he explain why.” Pet., 3. Google further argues that “had the Examiner reviewed the Board’s institution decision”—in two *different* IPRs against two *different* claimed inventions—he “should have” rejected the claims. *Id.* This is speculation, not evidence of error. Indeed, the Examiner’s notice of allowance directly addresses and contradicts Google’s complaint:

[T]he examiner agrees that the combination of the cited prior art would ***not make it obvious*** for one of ordinary skill in the art, prior to the instant effective filing date, to “perform a first analysis comprising analyzing at least some of the received active data ***and*** at least some of the received passive data in conjunction with model data based on human interactions ***from a prior session with the same website***”, and then ***afterwards challenge the user with a CAPTCHA without the benefit of hindsight.***

Ex. 1002, 412. The ’014 claims require a first analysis involving ***both*** active and passive data with model data from a prior session with “***the same*** website” and—if inconclusive—a second CAPTCHA-based analysis. This ***combination*** was not in any invalidated ’008 or ’885 claim. The Examiner did not err by declining to cherry-pick isolated Board determinations involving different claims and art combinations.

Google acknowledges no single reference teaches the claimed invention—it

must combine three or four references never combined in either prior IPR. This underscores that reasonable minds can disagree, not material error. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9. The Examiner found that adding a CAPTCHA to a system already performing both active and passive data analysis required *hindsight bias*—a considered judgment, not error. The Preliminary Response will also explain in detail why the specific combination of elements in the ’014 claims are not obvious based on the asserted prior art.

In short, denial is warranted because: (1) all six prior art references and Google’s invalidity analyses were before the Examiner; (2) the Examiner found the unique limitations—combined active/passive data analysis with subsequent CAPTCHA testing—*non-obvious absent hindsight*; (3) importing findings from different IPRs is improper; and (4) Google raises disagreement, not material error.

C. Denial is Warranted Under § 314(a)

The Director has broad discretion regarding IPR institution. 35 U.S.C. § 314(a); *In re Motorola Sols., Inc.*, 159 F.4th 30, 36 (Fed. Cir. 2025). That discretion focuses on the public interest, not “broad adjudication of private disputes.” *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 7 (PTAB May 14, 2026) (precedential). The Director’s Process Memorandum (Ex. 2014) and Small Business Memorandum (Ex. 2015) identify relevant factors—most favor denial.

1. Nobots Has Settled Expectations.

The '014 Patent application was filed August 5, 2022, published as US 2022/0398476 (Ex. 2007) on December 15, 2022, and issued November 7, 2023. Ex. 1001, at 1. The published claims are virtually identical to the issued claims. *Compare* Ex. 1001 *with* Ex. 2007. Although settled expectations typically attach to patents six-plus years old, they attach here under these unique circumstances.

First, Google knew of the '476 Publication when it published as an indirect continuation of the '008 and '885 Patents. Ex. 1001, 1; *Google LLC v. SoundClear Techs., LLC*, IPR2025-00344, Paper 15 at 2–3 (Dir. Aug. 4, 2025); *iRhythm Techs. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Dir. June 6, 2025).

Second, despite early knowledge, Google waited until July 29, 2026 (more than 3.5 years) to seek IPR. *Murata Mfg. Co. v. Georgia Tech Research Corp.*, IPR2025-00383, Paper 14 at 2–3 (Dir. July 29, 2025) (“failure to seek early review of the patent favors denial”). Google cannot blame Nobots for any delay in adding the '014 Patent to the lawsuit—it was Google’s opposed stay that prevented Nobots from doing so. Within weeks of the stay lifting, Nobots added it to the lawsuit.

Third, Google learned the '014 Patent would be added on February 18, 2026, when Nobots served amended infringement contentions. Ex. 2008, 2; Ex. 2016. Still, Google delayed until July 29, 2026—over five months—despite now repeatedly alleging invalidity for the same reasons and based on the same art from the '008 and '885 IPRs. If that were true, the Petition could have been filed promptly.

Fourth, if Google believed the prior institution decisions so significant, it should have submitted a third-party pre-issuance submission after the '476 Publication published with identical claims. *See* 35 U.S.C. § 122. Google could also have sought *ex parte* reexam during the stay. Instead, Google waited until after the stay lifted to file this IPR—seeking yet another stay to further delay Nobots' Seventh Amendment right to a jury trial.

2. Google Cannot Invalidate All Asserted Claims.

Nobots may “direct attention to an anticipated POPR and evidence for a discussion of the merits” but “should not repeat its merits arguments verbatim.”² While the Petition is weak overall, Nobots directs the Director to the exceptionally weak challenges to independent claim 16 (and thus dependents 17–21) under Ground 1 and dependent claim 13 under Ground 4. As to claim 16, Petitioner fails to demonstrate any “data collection data *requesting* active *and* passive data.” As to claim 13, the motivation to combine is illogical and the references fail to teach all limitations. The best outcome for Google is that claims 13 and 16–21 survive—just as claim 18 of the '008 Patent did—and all of those claims will be decided by a jury.

3. Google's *Sotera* Stipulation Is Inadequate.

Google's *Sotera* stipulation preserves its right to pursue any invalidity ground

² <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (“Interim Director Discretionary Process”) at § II.c.i. (accessed Aug. 22, 2026).

in district court if the Board denies institution. Ex. 1024. Even if the IPR is granted, the stipulation allows Google to rely on *any* IPR prior art combined with system art. If Google was confident in its material error argument, it would not need this gaping loophole. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (Dir. Mar. 28, 2025) (finding this factor favors denial because the stipulation “does not ensure that these IPR proceedings would be a true alternative to the district court proceeding”). Indeed, Google offered a stipulation as to the ’008 patent (Ex. 2004, 77)—which was subject to a Final Written Decision and Federal Circuit appeal—but Google is *still* asserting IPR art and system art in the litigation. Ex. 2027, 53.

4. The Petition Relies Heavily on Expert Testimony.

The Office has explained that “extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.”³ The Petition relies heavily on Dr. Lopresti’s 209-paragraph, 120-page declaration, citing him 75 times for key obviousness rationales. *See generally* Pet.; Ex. 1003. Dr. Lopresti’s declaration mirrors the Petition’s language. *Compare* Pet. 11–65 (Ground 1), *with* Ex. 1003 ¶¶ 72–181 (same prior art, motivation, and claim analysis); Pet. 64–67 (Ground 2), *with*

³ FAQs for Interim Processes for PTAB Workload Management (“Interim FAQs”), at #22, <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last accessed on Aug. 22, 2026) (superseded).

Ex. 1003 ¶¶ 183–193; Pet. 67–73 (Ground 3), *with* Ex. 1003 ¶¶ 194–204; Pet. 73–75 (Ground 4), *with* Ex. 1003 ¶¶ 205–209. Where petition arguments are repeated verbatim by a purported expert, skepticism is warranted. *Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2014-00529, Paper 8 at 14–17 (PTAB Sept. 23, 2014) (denying institution); *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15, 19 (PTAB Aug. 24, 2022) (precedential) (same). This reliance is particularly problematic here, because Google contends the ’014 Patent is unpatentable for the same reasons as the ’008 and ’885 Patents—if true, extensive expert testimony would be unnecessary. Additionally, Nobots will rely on the expert testimony of Dr. Samuel Russ to rebut the assertions of Dr. Lopresti, and such “reasonable disputes between experts on dispositive issues ... are better resolved in an Article III court.”

5. Petitioner Size and Manufacturing Do Not Favor Institution.

Google has market capitalization over \$4 trillion (Ex. 2012) and fiscal 2025 revenues of \$402 billion (Ex. 2013), qualifying it as a “market dominant company.” *Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 5. Google almost exclusively manufactures overseas—primarily in China, Vietnam, and India. Ex. 2009. Given Google’s extensive reliance on foreign manufacturing and status as a market dominant company, this factor favors denial.

6. Google Attempts to Circumvent the Office’s Word Count Limits.

Google’s Certificate of Word Count represents the Petition “contains 13,999

words.” But Google undercounts by omitting spaces and paragraph symbols (e.g., “EX1003 [0042]-[0044]”), which the Board treats as improper “effort to circumvent [the Board’s] word count limits.” *See Life Spine, Inc. v. Globus Medical, Inc.*, IPR2022-01434, Paper 12 at 2 n.1 (PTAB Mar. 24, 2023). That Google could not show invalidity of 30 claims within the 14,000-word limit—despite alleging invalidity for the same reasons as prior IPRs—underscores the Petition’s weakness.

7. Institution Would Be an Inefficient Use of Board Resources.

Google failed to invalidate claim 18 in the ’008 IPR, after years of IPR and appeal proceedings. Ex. 2021, 50-51. That will not change even if Google invalidates all challenged claims here. A jury will still be tasked with deciding infringement and invalidity of the ’008 Patent; that same jury should decide those issues for the ’014 Patent for efficiency. The Office’s resources are better spent: (1) on IPR petitions that, unlike Google’s, do not advance inconsistent claim construction positions; and (2) on reexamination appeals given the recent surge in reexam filings. Ex. 2011.

IV. CONCLUSION

For the reasons above, Nobots requests that the Director deny institution.

Dated: October 3, 2026

Respectfully submitted,

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on October 3, 2026, the foregoing document and all exhibits were served via electronic mail at the following e-mail addresses, where Petitioner has previously consented to electronic service:

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