

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2026-00464

Patent No. 8,023,425

**PETITIONER GOOGLE LLC'S RANKING OF PARALLEL PETITIONS
AND EXPLANATION OF MATERIAL DIFFERENCES**

I. INTRODUCTION

Petitioner Google LLC has concurrently filed two petitions for inter partes review challenging U.S. Patent No. 8,023,425 (“the ’425 patent”). Consistent with the Consolidated Trial Practice Guide (Nov. 2019) (“TPG”), Petitioner submits this paper (1) ranking the two petitions and (2) explaining the material differences between them and why two petitions are warranted. This paper is filed identically in both proceedings, is limited to this issue, and does not exceed five pages. *See* TPG 60 n.3.

II. RANKING OF THE PETITIONS

Petitioner ranks the two petitions as follows and requests that, if the Board institutes, it consider them in this order:

- **First**: Petition challenging claims 1-23 and 51 of the ’425 patent (IPR2026-00464) (“Petition 1”).
- **Second**: Petition challenging claims 24-50 of the ’425 patent (IPR2026-00465) (“Petition 2”).

Because the two petitions challenge different, non-overlapping sets of claims, both are necessary to reach all asserted claims in the corresponding litigation. The ranking above reflects only the order of consideration and not any suggestion that the second petition is less meritorious.

III. TWO PETITIONS ARE NECESSARY BECAUSE OF THE LARGE NUMBER OF ASSERTED CLAIMS

A. *The number and structure of the challenged claims require a claim-divided approach.*

The '425 patent contains a large number of claims, and Headwater is asserting all of them against Google in the co-pending district court litigation (No. 3:26-cv-6230 (N.D. Cal.), formerly 7:25-cv-00376 (W.D. Tex.)). Together the two petitions challenge all of claims 1-51. Petition 1 addresses claims 1-23 and 51, and Petition 2 addresses claims 24-50. The TPG expressly recognizes that more than one petition may be necessary “when the patent owner has asserted a large number of claims in litigation.” TPG 59. A single 14,000-word petition (37 C.F.R. § 42.24(a)) cannot adequately address the numerous independent and dependent claims, the multiple prior-art grounds, and the claim-by-claim mapping required for all challenged claims. Dividing the claims between two petitions is the efficient way to give each claim the analysis it requires and does not burden the Board or Patent Owner unnecessarily. *See* 35 U.S.C. § 316(b); *Juniper Networks, Inc. v. Portsmouth Network Corp.*, IPR2024-00913, Paper 8 at 1 (PTAB Jan. 15, 2025) (granting institution of parallel petitions with a total of 14 claims).

B. *The petitions are not redundant and do not raise the concerns underlying discretionary denial of parallel petitions.*

The two petitions challenge entirely non-overlapping claim sets—this is not a case of duplicative, competing challenges to the same claims. This distinguishes

recent precedential Director Review decision in *PacifiCorp v. Birchtech Corp.*, IPR2025-00687, Paper 40 (PTAB Jan. 12, 2026), where the Board vacated institution of two parallel petitions that each challenged the same claims under competing priority-date theories and directed institution of at most one petition per patent. Here, by contrast, each petition is the sole vehicle for a distinct group of claims, and instituting both is the only way to reach all claims Patent Owner asserts in litigation. *See, e.g., Samsung Elecs. Co. Ltd. v. Mojo Mobility Inc.*, IPR2023-01090, Paper 11 at 25-26 (PTAB Jan. 11, 2024) (granting institution and declining to deny a parallel petition where, “[i]n effect, the two petitions were filed instead of one merely because [PTAB] Rules have page limit restrictions”).

C. *The General Plastic and Valve factors do not counsel denial.*

These are simultaneously filed parallel petitions, not serial or “follow-on” petitions. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential); *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential). Petitioner has not previously challenged the ’425 patent, did not stagger the filings to gain a tactical “roadmap” advantage from a prior preliminary response or institution decision, and files both petitions at the same time. The concerns animating *General Plastic* and *Valve* are therefore not present.

IV. MATERIAL DIFFERENCES BETWEEN THE PETITIONS

The petitions differ in ways that are material and in dispute. First, they challenge different claims: Petition 1 challenges claims 1-23 and 51; Petition 2 challenges claims 24-50. There is no overlap. Second, although both petitions share a *Thomas–Buddhikot* obviousness base, they rely on different combinations of tertiary references tailored to the varied dependent claims each addresses. Petition 1 uniquely relies on *Sewall*, and the petitions apply *Haller*, *Polson*, and *Weintraub* to different dependent claims. The comparison table below summarizes the similarities and differences. *See* TPG 60.

Category	Petition 1 (Rank 1) — IPR2026-00464	Petition 2 (Rank 2) — IPR2026-00465
Challenged claims	Claims 1-23 and 51	Claims 24-50
Claim overlap	None — non-overlapping claim sets	None — non-overlapping claim sets
Primary combination	<i>Thomas + Buddhikot</i> (§ 103)	<i>Thomas + Buddhikot</i> (§ 103)
Additional grounds/references	+ <i>Sewall</i> (claim 2); + <i>Haller</i> (claims 3, 8); + <i>Polson</i> (claims 10, 18, 19, 22); + <i>Weintraub</i> (claims 11-14)	+ <i>Haller</i> (claim 33); + <i>Polson</i> (claims 39, 43, 45); + <i>Weintraub</i> (claims 35, 37, 38, 46, 47, 48)
Reference unique to this petition	<i>Sewall</i>	None; does not rely on <i>Sewall</i>
Statutory basis	Pre-AIA 35 U.S.C. § 103 (obviousness)	Pre-AIA 35 U.S.C. § 103 (obviousness)

Priority date treatment	Earliest possible priority date January 28, 2009; all references qualify as prior art even at that date; Petitioner reserves right to challenge priority	Same
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V. CLAIM CONSTRUCTION AND CONSISTENCY WITH THE DISTRICT COURT

Neither petition requires any express claim construction because the challenged claims are unpatentable under any reasonable construction. Petitioner's position is consistent with the parties' litigation posture reflected in the Joint Claim Construction Statement (EX1025). Accordingly, the concern in *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (PTAB Nov. 3, 2025) (precedential)—requiring a petitioner to explain divergent claim-construction positions across venues—is not implicated. Petitioner reserves the right to respond to any construction the Board or Patent Owner later raises.

VI. CONCLUSION

For the foregoing reasons, Petitioner respectfully submits that both petitions should be instituted. Should the Board decline to institute both, Petitioner requests that the Board consider the petitions in the ranked order above.

Date: August 28, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PETITIONER GOOGLE LLC'S RANKING OF PARALLEL PETITIONS AND EXPLANATION OF MATERIAL DIFFERENCES** was served on August 28, 2026, via FedEx Priority Overnight on the correspondence address of record indicated in the Patent Office's Patent Center system for U.S. Patent No. 8,023,425.

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Date: August 28, 2026

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