

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM SERVICES LLC
and AMAZON WEB SERVICES, INC.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2026-00088
Patent No. 9,615,192

PATENT OWNER'S UNOPPOSED MOTION TO STAY
EX PARTE REEXAMINATION NO. 90/015,831
PURSUANT TO 35 U.S.C. § 315(d) AND 84 FED. REG. 16654

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via PTAB E2E

TABLE OF CONTENTS

	<u>Page</u>
Table of Contents	i
Table of Authorities	ii
I. PROCEDURAL HISTORY	1
A. The Present IPR.....	1
B. The Parallel EPR Of The Very Same Patent And Claims.....	2
C. Other Office Proceedings Involving The Patent And Claims	2
II. THE BOARD SHOULD STAY THE PARALLEL '831 EPR OF THE VERY SAME PATENT AND CLAIMS THAT ARE UNDER IPR IN THIS CASE.....	3
III. CONCLUSION	10

TABLE OF AUTHORITIES

Page(s)

Agency Decisions

<i>Avaya Inc. v. Network-1 Sec. Sols.</i> , IPR2013-00071, Paper 9 (PTAB Dec. 21, 2012)	3, 4, 6, 7
<i>BMW of N. Am., LLC v. Foras Techs. Ltd.</i> , IPR2023-01373, Paper 15 (PTAB June 21, 2024)	3, 8
<i>Facebook, Inc. v. Express Mobile, Inc.</i> , IPR2021-01226, Paper 61 (PTAB Feb. 17, 2026).	4
<i>Goertek, Inc. v. Knowles Elecs.</i> , IPR2013-00614, Paper 11 (PTAB May 13, 2013)	7
<i>Google Inc. v. Summit 6 LLC</i> , IPR2015-00806, Paper 26 (PTAB Oct. 7, 2015).....	8
<i>Google LLC v. EcoFactor, Inc.</i> , IPR2021-00054, Paper 12 (PTAB June 28, 2021)	3, 5, 6, 7
<i>Hewlett Packard Enter. Co. v. Cobblestone Wireless, LLC</i> , IPR2024-00707, Paper 23 (PTAB Jan. 7, 2025)	5, 6
<i>Hulu, LLC v. Piranha Media Distribution, LLC</i> , IPR2024-01252, Paper 24 (PTAB Apr. 9, 2025)	4, 8
<i>Juniper Networks, Inc. v. Monarch Networking Sols. LLC</i> , IPR2024-00175, Paper 19 (PTAB Sept. 11, 2024)	3
<i>Lab. Corp. of Am. Holdings v. Ravgen, Inc.</i> , IPR2021-00902, Paper 24 (PTAB Feb. 1, 2022)	5, 7, 9
<i>Lab. Corp. of Am. Holdings v. Ravgen, Inc.</i> , IPR2021-01026, Paper 17 (PTAB Feb. 1, 2022)	6
<i>Lumondi Inc. v. Lennon Image Tech.</i> , IPR2013-00432, Paper 7 (PTAB Aug. 6, 2013).....	3, 4, 6, 7

<i>Mueller Sys., LLC v. Rein Tech, Inc.,</i> IPR2020-00098, Paper 13 (PTAB May 15, 2020)	3, 5, 7, 9
<i>Mueller Sys., LLC v. Rein Tech., Inc.,</i> IPR2020-00100, Paper 11 (PTAB May 14, 2020)	8
<i>Quest Diagnostics v. Ravgen, Inc.,</i> IPR2021-00791, Paper 25 (PTAB Dec. 15, 2021)	6
<i>Sienna Biopharmaceuticals, Inc. v. W.M. Rice Univ.,</i> IPR2017-00045, Paper 22 (PTAB June 23, 2017)	6
<i>Tesla, Inc. v. Graphite Charging Co., LLC,</i> IPR2024-00388, Paper 22 (PTAB Oct. 7, 2024)	3

Regulations

37 C.F.R. § 42.122(a)	3
-----------------------------	---

Other Authorities

84 Fed. Reg. 16,654, 16,657	3
-----------------------------------	---

EXHIBIT LIST

Ex. 2001	Notice of Partial Settlement in <i>Headwater Research LLC v. Amazon.com Services LLC et al.</i> , No. 7:25-cv-00286-ADA (W.D. Tex. Nov. 10, 2025)
Ex. 2002	Joint Motion to Dismiss in <i>Headwater Research, LLC v. Apple, Inc.</i> , No. 7:25-cv-00379-ADA (W.D. Tex.)
Ex. 2003	Joint Motion to Dismiss in <i>Headwater Research LLC v. Samsung Electronics Co., Ltd. et al.</i> , No. 2:23-cv-103-JRG-RSP (E.D. Tex. Sept. 11, 2025)
Ex. 2004	Order Granting Joint Motion to Dismiss in <i>Headwater Research LLC v. T-Mobile USA, Inc. et al.</i> , Nos. 2:23-cv-379-JRG-RSP and 2:23-cv377-JRG-RSP (E.D. Tex. Nov. 13, 2025)
Ex. 2005	Order Granting Joint Motion to Dismiss in <i>Headwater Research LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00397-JRG-RSP (E.D. Tex. Nov. 13, 2025)
Ex. 2006	DocketNavigator statistics for contested motions to stay pending IPR before Judge Alan Albright
Ex. 2007	Exhibit C-7 to Amazon’s December 12, 2025 invalidity contentions in <i>Headwater Research LLC v. Amazon.com Services LLC et al.</i> , No. 7:25-cv-00286-ADA (W.D. Tex.)
Ex. 2008 [NEW]	<i>Request for Ex Parte Reexamination of U.S. Patent No. 9,615,192</i> , EPR No. 90/015,831 (Dec. 24, 2025)
Ex. 2009 [NEW]	<i>Order Granting Request for Ex Parte Reexamination</i> , EPR No. 90/015,831 (Feb. 18, 2026)

Pursuant to the Board’s emailed authorization on May 4, 2026, Patent Owner requests a stay of *ex parte* reexamination (“EPR”) control no. 90/015,831 which involves the same claims and patent as the present *inter partes* review (“IPR”).

The Board routinely grants patent owners’ motions to stay EPRs concurrent with IPRs, as discussed in greater detail in the sections below.

Patent Owner submits that the multifactor test that governs this Motion overwhelmingly favors a stay, and accordingly requests that the panel so order.

Patent Owner has met and conferred with Petitioner regarding this request, and notes that Petitioner does not oppose this authorized Motion.

Because resources are committed to the EPR and further action in it may occur at any time, expedited consideration of this Motion is requested. 37 C.F.R. §42.1(b).

I. PROCEDURAL HISTORY

A. The Present IPR

In the present case, the Petition for IPR was filed on November 10, 2025, challenging claims 1–15 of the ’192 patent. Pet., 2-3.

Patent Owner filed a request for discretionary denial of institution of this IPR on January 20, 2026. Paper 7. On March 10, 2026, the Director issued an order declining to discretionarily deny institution. Paper 10. The IPR proceeded for review on the merits and non-discretionary considerations. On April 6, 2026, the Director granted institution of the present IPR. Paper 11.

The due date for a final written decision in this IPR is therefore April 6, 2027.

B. The Parallel EPR Of The Very Same Patent And Claims

On December 24, 2025, six weeks after the petition for the present IPR was filed, Walmart Inc. (“Walmart”) filed a request for EPR of the same claims of the same patent as this IPR. *See* Ex. 2008 [Request]. The Request sought an order for reexamination of claims 1–15 as anticipated over Rittmaster (U.S. Pat. Pub. 2002/0023010) and/or obvious over Rittmaster and/or Shenfield (Australian Pat. Pub. AU 2007200530), in combination with other art, including Ellison (U.S. Pat. No. 7,082,615) Rakic (U.S. Pat. Pub. 2009/0282256) and Gellens (U.S. Pat. Pub. 2005/014429). Ex. 2008 [Request], 14 (summarizing reexamination grounds). The Request was filed with exhibits and a technical declaration.

On February 18, 2026, the Office ordered reexamination of the challenged claims of the ’192 patent pursuant to Walmart’s request (the “’831 EPR”). Ex. 2009 [Decision Granting EPR].

C. Other Office Proceedings Involving The Patent And Claims

All of the claims of the ’192 patent involved in the present IPR and parallel ’831 EPR were challenged in IPR2026-00154 by Target Corporation (“Target”), which was discretionarily denied institution on March 23, 2026.

Almost all (thirteen out of the fifteen) of the claims of the ’192 patent involved in the present IPR and the concurrent ’831 EPR also were previously challenged in

IPR2024-00010 (the “Samsung IPR”). The Samsung IPR challenged claims 1–9, 11–13, and 15. After the Samsung IPR was instituted, it was terminated prior to a final written decision pursuant to a joint motion by Samsung and Patent Owner.

II. THE BOARD SHOULD STAY THE PARALLEL ’831 EPR OF THE VERY SAME PATENT AND CLAIMS THAT ARE UNDER IPR IN THIS CASE.

Under the AIA and the Office’s implementing rules, the Board may stay EPR of a patent pending the completion of an IPR involving the same patent. 35 U.S.C. § 315(d); 37 C.F.R. § 42.122(a). As the Office has explained in official guidance concerning these rules, “[t]he Board ordinarily will stay a parallel reexamination where good cause exists.” *Hulu, LLC v. Piranha Media Dist., LLC*, IPR2024-01252, Paper 24, 2 (PTAB Apr. 9, 2025) (“*Piranha*”) (quoting *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexam. During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16,654, 16,656 (Apr. 22, 2019) (“2019 Notice”)). “Good cause . . . may exist if, for example, an on-going AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue” 2019 Notice, *supra*, at 16,657. The 2019 Notice is routinely treated by panels as governing whether EPRs of claims in IPR should be stayed, and motions like this one to stay such EPRs are routinely granted.

The 2019 Notice (at 10) lists eight factors bearing on good cause, which the Board has routinely considered when granting a stay of EPR. *E.g., Tesla, Inc. v. Graphite Charging Co. LLC*, IPR2024-00388, Paper 22, 3–12 (PTAB Oct. 7, 2024);

BMW of N. Am. v. Foras Techs, IPR2023-01373, Paper 15, 4–7 (PTAB June 21, 2024) (“*Foras*”); *Juniper Networks v. Monarch Networking Sols.*, IPR2024-00175, Paper 19, 3–7 (PTAB Sep. 11, 2024).

The Board routinely grants a stay under this test even when not every factor favors a stay. *E.g.*, *Google LLC v. EcoFactor, Inc.*, IPR2021-00054, Paper 12, 4 (PTAB June 28, 2021) (“*EcoFactor*”) (staying notwithstanding Factor 2); *Mueller Sys., LLC v. Rein Tech, Inc.*, IPR2020-00098, Paper 13, 4–5 (PTAB May 15, 2020) (“*Rein-00098*”) (similar, Factor 2 neutral). *Lumondi Inc. v. Lennon Image Tech.*, IPR2013-00432, Paper 7, 3 (PTAB Aug. 6, 2013) (“*Lennon Image*”) (similar); *Avaya Inc. v. Network-1 Sec. Sols.*, IPR2013-00071, Paper 9, 2–3 (PTAB Dec. 21, 2012) (“*Network-1*”) (same). This is unsurprising: since long before the 2019 Notice, the Board has routinely stayed parallel EPRs when an EPR and an IPR challenge overlapping claims based on overlapping art, even if they involve different parties and the EPR is at an advanced stage. *See, e.g.*, *Lennon Image, supra*, 2–3 (“*Lennon Image*”) (*sua sponte* staying EPR “filed by a different party” and “based on different prior art” that had already reached a non-final rejection); *Network-1, supra*, 2–3 (*sua sponte* staying EPR “filed by a different party” and “based on different prior art”).

In the instant IPR, the factors collectively show good cause to stay the ’831 EPR, as further described below with respect to the various factors.

Factor 1—“Whether the claims challenged in the [IPR] are the same as or depend directly or indirectly from claims at issue in the concurrent parallel [EPR]”: Factor 1’s express criterion is squarely satisfied. “[T]he claims challenged in the present AIA proceeding” (claims 1–15) “are the same” “claims at issue in the parallel [EPR]” (claim 1). The present IPR and the ’831 EPR both challenge all claims of the ’192 patent. *Accord, e.g., Piranha, supra*, 3 (satisfaction of Factor 1 favors stay); *Facebook, Inc. v. Express Mobile, Inc.*, IPR2021-01226, Paper 61, 2 (PTAB Feb. 17, 2026) (same).¹ Accordingly, factor 1 favors a stay.

Factor 2—“Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings”: This factor is of limited significance, because where the facts are similar to those in the present case, they may “present an archetypal pattern warranting a stay” even if “[t]here is *no* overlap between the prior art in [the IPR] proceeding and the [r]eexamination.” *EcoFactor, supra*, 4–5 (emphasis added); *see also, e.g., Rein-00098, supra*, 3–6 (finding Factor 2 “neutral” but Factor 8 “perhaps most importan[t]” and granting stay). Here, however, this IPR

¹ Moreover, as the Board has often held, a stay would be favored even if there were only “partial overlap” or merely “a single overlapping claim” between the EPR and IPR. *See, e.g., Hewlett-Packard Enter. Co. v. Cobblestone Wireless, LLC*, IPR2024-00707, Paper 23, 3–4 (PTAB Jan. 7, 2025) (collecting cases) (granting stay).

and the '831 EPR have overlapping prior art in grounds challenging multiple claims, including at least claims 4, 8, and 14. Both the Petition and the Request assert Ellison in their grounds challenging claim 4, Rakic in their grounds challenging claim 8, and Gellens in their grounds challenging claim 14. Since there is some overlap in prior art, this is by itself sufficient for Factor 2 to favor a stay of the '831 EPR, or at the very least be neutral. *See, e.g., Lab. Corp. of Am. Holdings v. Ravgen, Inc.* IPR2021-00902, Paper 24, 7 (PTAB Feb. 1, 2022) (“*Ravgen-902*”) (“we find that there is some overlap in the asserted references and theories of unpatentability, and that this factor favors a stay.); *Sienna Biopharmaceuticals, Inc. v. W.M. Rice Univ.*, IPR2017-00045, Paper 22, 2–3 (PTAB June 23, 2017) (granting opposed motion to stay EPR where the EPR and IPR grounds only shared one art reference); *see id.*, Paper 16, 2 (noting “the ground in the [EPR] only share[d] one reference with the grounds set forth in the '045 IPR”) (cited by *id.*, Paper 22 at 2); *Hewlett-Packard Enter. Co. v. Cobblestone Wireless, LLC*, IPR2024-00707, Paper 23, 4–5 (Jan. 7, 2025) (factor 2 “favor[ed] a stay” where IPR and EPR “include[d] similar reasoning and similar disclosures in [two] references” with respect to” element of one independent claim).

Furthermore, as noted above, the Board routinely grants stays of concurrent EPRs even when it is found that there is little or “no” art overlap and that this factor “disfavors” a stay. *Lab. Corp. of Am. Holdings v. Ravgen, Inc.*, IPR2021-01026, Paper 17, 3–7 (PTAB Feb. 1, 2022) (granting stay of multiple concurrent EPRs

despite there being “little overlap in the asserted references and theories of unpatentability” with the IPR); *EcoFactor*, 45 (discussed above); *see also, e.g., Lennon Image, supra*, 2–3 (“different prior art”); *Network-1, supra*, 2–3 (same). Moreover, the Board has found support for a stay under Factor 2 even when the IPR art merely “included passages that were substantially similar to passages” in the EPR art. *Quest Diagnostics v. Ravgen, Inc.*, IPR2021-00791, Paper 25, 6 (PTAB Dec. 15, 2021); *see also Goertek, Inc. v. Knowles Elecs.*, IPR2013-00614, Paper 11 (PTAB May 13, 2013) (“some of the prior art” different); *Rein-00098, supra*, 3–4. Moreover, as already noted, the Board will stay even if Factor 2 considerations do not favor it. *E.g., EcoFactor, supra*, 4 (“no overlap”); *see also Lennon Image, supra*, 2–3 (“different prior art”); *Network-1, supra*, 2–3 (same). In sum, factor 2 supports a stay or at worst is neutral.

Factor 3—“Whether the concurrent parallel Office proceeding will duplicate efforts within the Office”: Since the same claims are at issue in this IPR and the ’831 EPR, and there is some overlap in the prior art, duplication risk is very high. *See, e.g., EcoFactor, supra*, 4; *see also Network-1, supra*, 2–3 (finding duplication risk as to claims “challenged in both” proceedings despite “different prior art”); *Lennon Image, supra*, 2–3 (same); *Ravgen-902, supra*, 7 (“[b]ased on the material overlap in claims at issue...and some degree of overlap in the prior art and unpatentability theories, we find that efforts will be duplicated within the Office absent a stay.”) On

this record, this factor favors a stay of the '831 EPR pending completion of the present IPR. And assuming that this IPR's "Petitioner has no role or involvement in the Reexamination," that fact weighs in favor of a stay because Petitioner "chose to, and continues to choose to" challenge these claims in this proceeding, and its position in that respect will be unchanged if the EPR is stayed. *See Google Inc. v. Summit 6 LLC*, IPR2015-00806, Paper 26, 5 (PTAB Oct. 7, 2015) (granting opposed motion to stay parallel EPR). Accordingly, factor 3 favors a stay.

Factor 4—"Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings": The IPR and EPR risk inconsistent results. Both may, *e.g.*, rule on the scope of the same claims (and of prior art references Ellison, Rakic, and Gellens) and likely must determine whether substantially similar disclosure renders the same claims obvious. In such circumstances this factor favors a stay. *See, e.g., Piranha*, 4; *Mueller Sys., LLC v. Rein Tech., Inc.*, IPR2020-00100, Paper 11, 4 (PTAB May 14, 2020) (that IPR and EPR have "the same claims and the same prior art . . . raises the possibility of inconsistent results. This factor favors a stay."). Accordingly, factor 4 favors a stay.

Factor 5—"Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding": The Board has found that this factor favors a stay of a concurrent parallel reexamination when the patent owner can amend claims of the patent in the reexamination. *Foras, supra*, 5 ("The claims in

the '245 Reexamination Proceeding that are before us in this trial have been rejected, and Patent Owner may respond with an amendment that would affect their scope. . . . This factor favors a stay.”); *Celltrion, Inc. v. Regeneron Pharms., Inc.*, IPR2023-00462, Paper 17, 4 (PTAB Sep. 8, 2023) (“The '448 Reexamination Proceeding is considering the same claims as we are considering in this trial, and Patent Owner may respond with an amendment that would affect their scope. This factor favors a stay.”). Since granting a stay will alleviate the risk that amendments or new claims presented in the '831 EPR will have an effect in the IPR, factor 5 favors a stay.

Factors 6–7—“The statutory deadlines” and “respective timeline and stage of each proceeding”: This IPR was filed prior to the '831 EPR and has already been instituted. No office action has issued in the EPR. When, as here, an IPR is instituted and, *e.g.*, no EPR office action has been issued, the Board has found these factors to favor a stay. *E.g.*, *Ravgen-902*, *supra*, 9–10. Accordingly, factors 6–7 favor a stay.

Factor 8—“Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot”: This IPR may simplify or moot the issues in the EPR, which has overlapping claims and art. The Board has found that this factor favors a stay on similar facts. *E.g.*, *Rein-0098*, *supra*, 6 (relying on this factor as “perhaps most importan[t]” to grant stay of EPR). Here, Factor 8 favors a stay.

III. CONCLUSION

Office and Board practice strongly favors staying overlapping concurrent EPRs in like circumstances, and the Board routinely grants such stays regardless whether they are opposed and even if less than all factors favor a stay.² Here, all factors favor a stay. This unopposed Motion to stay the '831 EPR should be granted.

Date: May 7, 2026

Respectfully submitted,

/James A. Milkey/
James A. Milkey, Reg. No. 79,503
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Fl.
Los Angeles, CA 90025

Counsel for Patent Owner

² Moreover, Patent Owner respectfully notes that it is aware of no basis on which either the original petitioner or any potential joined petitioner entities in this case would have standing or rights to oppose a stay of the EPR, unless they are privies or real parties-in-interest to requester Walmart. The mere fact that it is the Office's practice for such motions to stay EPRs concurrent with IPRs to be filed and decided in the IPR proceeding, rather than in the EPR proceeding, should not, as an artifact of which forum is the locus of the filed motion, create any standing for IPR petitioners to oppose a stay in such EPR proceedings. Since Petitioner has stated that will not oppose this Motion, Patent Owner does not further brief this issue here.

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of

**PATENT OWNER’S UNOPPOSED MOTION TO STAY
EX PARTE REEXAMINATION NO. 90/015,831
PURSUANT TO 35 U.S.C. § 315(d) AND 84 FED. REG. 16654**

EXHIBITS 2008–2009

is being served electronically on the date below, to the names and email addresses below:

Petitioner AMAZON.COM SERVICES LLC and AMAZON WEB SERVICES, INC., through its counsel:

Jessica Kaiser	Kaiser-ptab@perkinscoie.com
Christopher Marando	Marando-ptab@perkinscoie.com
Matthew A. Lembo	Lembo-ptab@perkinscoie.com
	Amazon-HeadwaterIPR@perkinscoie.com

Date: May 7, 2026

Respectfully submitted,

/James A. Milkey/
James A. Milkey, Reg. No. 79,503
RUSS, AUGUST & KABAT
12424 Wilshire Blvd., 12th Fl.
Los Angeles, CA 90025

Counsel for Patent Owner