

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

Case IPR2025-00806
Patent No. 8,645,517

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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I. Introduction

This case should be referred to the Board for evaluation of the Petition on the merits. The Office committed a “material error during patent examination” when it failed to find, consider, and evaluate highly pertinent prior art showing the unpatentability of the challenged claims. *See, e.g., Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9 at 3 (P.T.A.B. June 12, 2025); *Ecto World, LLC v. Rai Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (P.T.A.B. May 19, 2025) (precedential). As the Director has reasoned, “it is an appropriate use of Office resources to review [such] potential error.” *Microsoft*, IPR2025-00318, Paper 9 at 3. The same result is appropriate here.

Indeed, the Petition asserts a number of challenges against the claims of the ’517 patent. *See, e.g.,* Paper 1 (Petition) at 1. The first ground relies on a nearly anticipatory reference, Ben-Shaul, that the Examiner had previously used to reject similar claims in related patents. The Examiner materially erred by failing to reevaluate that reference during prosecution of the application leading to the ’517 patent. And the Examiner also materially erred by failing to identify and evaluate the Beaumont and Hasan references asserted in the Petition. This material error should not go uncorrected. Google respectfully asks the Director to refer this case to the Board.

Instead of addressing such material error, Patent Owner cites the purported talisman of “settled expectations” to suggest denial is more appropriate. But as the Director has advised, any such “[s]ettled expectations” (to the extent they existed) cannot not outweigh other factors, such as a material error committed by the Examiner during prosecution or a lack of commercialization by patent owner, as present here. *See Anthony Inc. v. ControlTec, Inc.*, IPR2025-00559, Paper 12 at 2 (P.T.A.B. July 16, 2025) (finding material error outweighed settled expectations); *see also Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00531, Paper 10 at 3 (P.T.A.B. July 17, 2025) (finding that a lack of commercialization or assertion outweighed settled expectations). Patent Owner has not shown that denial is the appropriate remedy here.

Patent Owner’s remaining arguments regarding *Fintiv*, the Petition’s merits, the Petition’s prototypical reliance on expert testimony, and economic and public interest factors are likewise unavailing. The Director should decline to exercise her discretion and refer the Petition to the Board.

II. The Office’s “Material Error” During Prosecution Favors Referral

The Office committed a “material error” during prosecution when it failed to find, consider, and evaluate pertinent prior art showing the unpatentability of the challenged claims. *See, e.g., Microsoft*, IPR2025-00318, Paper 9 at 3; *Ecto World*, IPR2024-01280, Paper 13 at 5; *Xencor, Inc. v. Merus N.V.*, IPR2024-00604, Paper

12 at 3 (P.T.A.B. July 17, 2025). The Director has consistently found that such an error by the Office can outweigh other factors that may otherwise favor denial.

Microsoft, IPR2025-00318, Paper 9 at 3 (finding “it is an appropriate use of Office resources to review the potential error,” and reasoning this error required review, even though the parties had a trial date “preced[ing] the date projected for a Board final written decision”); *Eunsung Glob. Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 2-3 (P.T.A.B. July 10, 2025) (finding “Petitioner provides persuasive reasoning” that denial is not appropriate “due to a material error in examination,” even though the challenged patent “issued in 2017, and this would ordinarily favor denying institution”); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 2 (P.T.A.B. June 12, 2025) (referring and finding the “[p]etitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [a prosecution reference]”); *Anthony*, IPR2025-00559, Paper 12 at 2 (referring and finding showing of material error favored referring to panel for both 17- and 18-year-old patents). The same result is appropriate here.

First, the Examiner materially erred by failing to consider Ben-Shaul when examining the claims of the '517 patent. As Patent Owner identifies, Ben-Shaul¹ was previously applied in two related '497 and '162 applications. Paper 6 at 8-9, 35-37. Contrary to Patent Owner's contentions, the Examiner's treatment of Ben-Shaul (or lack thereof rather) favors institution. EX-2002, 362-67; EX-2003, 1326-32; *see Yita, LLC v. MacNeil IP LLC*, IPR2023-00172, Paper 12 at 46-47 (P.T.A.B. June 13, 2023) (finding the Office materially erred by not reconsidering reference applied during prosecution of prior applications); *see also Microsoft*, IPR2025-00318, Paper 9 at 3.

As an initial matter, the reasons the claims of the predecessor applications were allowed over Ben-Shaul were related to limitations not at issue in the '517 patent. For example, during prosecution of the '497 application, the Examiner rejected most of the pending claims as being anticipated by Ben-Shaul. EX-2002, 159-71. In response, Applicant amended the independent claims to recite "monitored" and "managed server[s]" (*id.* at 259), a "subscriber server network includ[ing] . . . a server hierarchy" (*id.* at 265-66, 270-71, 277), or "receiving,"

¹ The Examiner cited U.S. Patent No. 6,976,090 during prosecution, which is the patent that issued from the published application cited as Ben-Shaul in the Petition. EX-2002, 159; EX-2003, 694, 738.

“consolidating,” and “processing” “events sent from at least one monitoring mechanism of the at least one domain name server” (*id.* at 281). The Examiner withdrew the rejection based on Ben-Shaul in the next action. *Id.* at 296-99. But none of these added limitations are recited in the claims of the ’517 patent. EX-1001, 31:24-34:29.

Similarly, for the ’162 application, the Examiner rejected most of the pending claims as being anticipated by Ben-Shaul. EX-2003, 738-45. Applicant later amended the independent claims to recite “retrieving policies from a policy database of a name server” responsive to receipt of a client request. *Id.* at 1309, 1311; *see id.* at 1312-13 (similar amendments). Applicant distinguished Ben-Shaul, arguing that it fails to disclose a “dependent relationship between the receipt of a client request for a domain name resolution, on one hand, and the retrieval of policies from a name server’s policy database and the selection of a network based on those retrieved policies, on the other.” *Id.* at 1316. The Examiner allowed the application in the next action. *Id.* at 1326-32. But the claims of the ’517 patent do not require these features either. EX-1001, 31:24-34:29.

It was a material error for the Examiner to not reconsider Ben-Shaul during prosecution of the ’517 patent, particularly given (1) its near-anticipatory nature as to the claims of the ’517 patent, and (2) the reason the predecessor applications were allowed over Ben-Shaul *has nothing to do with* limitations in the ’517 claims.

Moreover, as discussed in the Petition, Ben-Shaul discloses the claim limitations the Examiner believed were purportedly missing from the prior art when allowing the '517 patent, including having “one or more resource nodes specify one or more answers to be provided in response to a Domain Name Service (DNS) request.” *See, e.g.*, Paper 6 at 8 (discussing limitation argued as missing during the prosecution of the '517 patent); Paper 1 at 52-55 (showing how Ben-Shaul teaches the purportedly missing limitation).

Instead of addressing Ben-Shaul head on (as it was cited on an IDS), the Examiner merely initialed Ben-Shaul in bulk (EX-1002, 74) along with *hundreds* of other references (*id.* at 3-6, 81-116, 118). And the Examiner made no reference to Ben-Shaul in the Notice of Allowance. *Id.* at 34-40. As Patent Owner concedes, the claims of the '517 patent include many of the same limitations the Examiner found were disclosed in Ben-Shaul. Paper 6 at 39-40. The Examiner's failure to consider a rejection based on Ben-Shaul constitutes material error favoring referral. *Yita*, IPR2023-00172, Paper 12 at 47; *see also Microsoft*, IPR2025-00318, Paper 9 at 3.

This case is indistinguishable from *Yita*. In *Yita*, the Examiner of a patent challenged in an IPR had previously rejected similar claims in other applications based on Stanesic—the primary reference in the Petition. IPR2023-00172, Paper 12 at 46. The Board found that the Examiner's failure to reconsider Stanesic during

prosecution of the challenged patent was material error. *See id.* at 46-47. Although Stanesic was cited on an IDS during prosecution, it “was one of a large number of cited references,” and “the Examiner [did not] comment on [Stanesic] in the Notice of Allowance.” *Id.* at 45-46. The Examiner’s failure to reconsider Stanesic thus weighed in favor of institution. *Id.* The same result is appropriate here.

Second, the Examiner materially erred by not identifying Beaumont or Hasan during prosecution. *See Microsoft*, IPR2025-00318, Paper 9 at 3 (finding the Office materially erred by failing to identify and “overlooking the teachings” of two prior art references that were not before the Examiner during prosecution and by failing to consider those references in combination with those that were before the Office). Beaumont, for example, was publicly available to the Examiner during prosecution of the ’517 patent and is in the same international patent classification. *See, e.g.*, EX-1007, Cover (publishing Nov. 14, 2002, listing international classification G06F 15/16); EX-1001 (application maturing as the ’517 patent filed in 2010 and issuing in February 2014, also listing international classification G06F 15/16). A diligent prior art search by the Examiner in the same international patent classification as the ’517 patent, with search terms like “content delivery server” or “DNS,” would have revealed Beaumont. Hasan likewise was publicly available and shares its U.S. patent classification with the ’517 patent. *See, e.g.*, EX-1006, Cover (publishing July 25, 2006, listing U.S. classification 709/223); EX-1001 (application maturing

as the '517 patent filed in 2010 and issuing in February 2014, also listing U.S. classification 709/223). The Examiner erred by failing to find and consider Beaumont and Hasan. Indeed, as explained in detail in the Petition, Beaumont in view of Hasan discloses the claimed hierarchical GUI for setting DNS policies the Applicant asserted were missing in the prior art. Paper 1 at 18-21. Beaumont and Hasan are therefore highly relevant to the claims, and it was material error for the Examiner not to find, and thus overlook, Beaumont's and Hasan's disclosures. *See, e.g., Microsoft*, IPR2025-00318, Paper 9 at 3. In view of such "material error," referral to the Board for review is appropriate.

III. Settled Expectations Also Favor Referral

Ignoring the material errors by the Office during prosecution, Patent Owner instead contends that purported "settled expectations" favor denial in this case. *See, e.g.,* Paper 6 at 14-16. Not so. If anything, Google had a settled expectation that its Cloud CDN product, which was publicly known and launched nearly a decade ago, would not be accused of infringing a patent that the patent owner sat on for years, including after that patent expired. Any settled expectations favor referral.²

² The Director's application of "settled expectations" is improper. For example, retroactively applying "settled expectations" as a basis to deny Google's already-

A. Patent Owner Cannot Reasonably Contend the Age of Its Patent Should Immunize That Patent from Review

Patent Owner contends “settled expectations” weigh in its favor because the ’517 patent has purportedly been “in force for many years.” *See id.* at 14. But Patent Owner’s argument runs afoul of governing IPR statutes. When Congress wanted to immunize patents of a certain age from post-issuance challenges, it did so expressly. When designing the regime for *inter partes* reexamination, for example, Congress expressly immunized (carved out) “patents issued before 1999” from review. *See* H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011). Congress similarly

filed petition violates both the APA and Due Process. *See, e.g., Tafas v. Dudas*, 511 F. Supp. 2d 652, 666 (E.D. Va. 2007) (“[R]etroactivity is not favored in the law”); *Kirwa v. U.S. Dep’t of Def.*, 285 F. Supp. 3d 21, 41 (D.D.C. 2017) (“Any retroactive policy must have “sufficiently significant statutory interests” to counterbalance any “resulting inequities” from the retroactive agency action.” (citations omitted)). The Director’s application of “settled expectations” also exceeds her authority under the law and is barred by judicial estoppel based on the Office repeatedly advancing the position that a patentee lacked an expectation that its patents would not be challenged. *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-62 (Fed. Cir. 2019); *see also* 5 U.S.C. § 706(2)(A).

immunized patents of a certain age when it created the PGR procedure, restricting those challenges to patents with post-AIA effective filing dates, in turn foreclosing this avenue of review for older patents. *See, e.g.,* AIA §§ 3(n)(1), 6(f)(2)(A).³

Yet for IPRs, Congress took the opposite approach. Congress “eliminated” the *inter partes* reexamination date-based carveout so that, instead, “*all patents can be challenged in inter partes review,*”⁴ regardless of age. *See* H.R. Rep. No. 112-98, at 46-48. And rather than restrict *inter partes* review based on a patent’s age or priority date, Congress only required a petitioner to wait for the nine-month PGR window to expire (to the extent applicable) (35 U.S.C. § 311(c)) and file within one year of being served with a complaint (*id.* § 315(b)). “Congress’s choice to depart from the model of a closely related statute is a choice neither we nor the agency may disregard.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 364 (2018).

Patent Owner’s settled-expectations argument also runs afoul of Board precedent. In *NHK Spring*, for example, the Board held that a ten-year delay in challenging a patent *was not enough to preclude an otherwise timely challenge* to the patent in the absence of evidence the petitioner received a “tactical advantage”

³ Congress also enacted a sunset provision for challenging covered business method (CBM) patents. *See, e.g.,* AIA § 18(a)(3).

⁴ All emphasis added unless otherwise indicated.

because it waited to file its petition. *See NHK Spring Co. v. Intri-Plex Tech., Inc.*, IPR2018-00752, Paper 8 at 19-20 (P.T.A.B. Sept. 12, 2018) (precedential). Here, there is no allegation that the timing of Google’s Petition filing provided Google with any tactical advantage. The only party receiving a tactical advantage here is Patent Owner, who has asserted a patent that was not asserted by its predecessors for years, while Google spent years developing and bringing products to market. Patent Owner cannot now cry foul because Google is challenging its patent.

But even if Patent Owner could rely on the age of its patent, the Director’s March 26, 2025, Memo suggests that settled expectations are only decided based on “the length of time the claims have been in force.” *See* EX-2013, 2. Here, the ’517 patent issued in 2014, *and expired in 2023*, making the “length of time the claims have been in force” nine years. *See* EX-1001, cover. The Director has referred to the Board for further evaluation challenges for patents that have been in force for similar durations. *See Mercedes-Benz Grp. AG v. Phelan Grp., LLC*, IPR2025-00413, Paper 13 at 2 (P.T.A.B. June 25, 2025) (referring to panel where patent in force over 8 years). And regardless, the duration that a patent is in force is

routinely outweighed by other factors present here.⁵ *See Shenzhen*, IPR2025-00531, Paper 10 at 3 (referring although patent had “been in force for approximately 10 years” when patent was never “commercialized, asserted, marked, licensed, or otherwise applied”); *Xencor*, IPR2024-00604, Paper 12 at 3 (referring although “patent ha[d] been in force for approximately nine years” when “Office materially erred during prosecution”). The same result is appropriate here.

B. That the ’517 Patent Has Expired Does Not Change the Calculus

Patent Owner also contends that settled expectations weigh in its favor, because it would be a waste of judicial resources for the Board to examine an expired patent. Paper 6 at 1, 12-16. On the contrary, the Director has referred petitions that have challenged an expired patent in similar circumstances. *See Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00226, Paper 8 at 2 (P.T.A.B. June 12, 2025) (referring to panel where “patent expired almost four years ago . . . and, accordingly, [petitioner] expected nonenforcement of the challenged patent”). As in *Globus*, while Patent Owner presents no evidence that Google was aware of

⁵ In this way, this case is distinguishable from the cases cited in Patent Owner’s brief: *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025), and *Intel Corp. v. Proxense LLC*, IPR2025-00317, Paper 12 (P.T.A.B. June 26, 2025). *See, e.g.*, Paper 6 at 14.

the '517 patent before it was asserted against Google in 2024, a reasonable party would not expect a patent that expired in 2023 to be highly likely to be asserted in a litigation to preclude Google's challenge here.

Moreover, it is unreasonable to expect would-be petitioners to file post-grant review challenges against any known patent regardless of whether the patentee has threatened litigation or asserted the patent against others. At a minimum, this runs contrary to the statutory scheme, which contemplates petitioners filing challenges within one year of being served with a complaint that alleges infringement, regardless of how long the patent has been in force. *See, e.g.*, 35 U.S.C. § 315(b). It also runs contrary to the realities and actual expectations of patent owners and petitioners over the past decade, where the vast majority of post-grant challenges have come *only after* patent owners have alleged infringement in a co-pending district court litigation.⁶ It also runs contrary to the well-established practice that defendants could challenge patent validity in district court or in reexamination proceedings. Given this history, Patent Owner cannot reasonably contend (nor does it try to contend) that it did not expect the '517 patent to be challenged in an IPR

⁶ As the Board's statistics show, over 80% of patents involved in post-grant challenges are involved in co-pending litigation. *See, e.g.*, EX-1024, 3; EX-1025, 10.

within one year of it serving its complaint, because that is precisely how these disputes have proceeded since the AIA took effect.

The Board has also expressly rejected Patent Owner’s “waste of resources” argument in similar circumstances. In *Inari Agriculture*, for example, the patent owner sought denial of institution of an expired patent to “preserve administrative efficiency.” *Inari Agric., Inc. v. Corteva Agrisci. LLC*, IPR2024-01014, Paper 15 at 24 (P.T.A.B. Dec. 16, 2024). The Board correctly recognized there was “no good reason” to discretionarily deny “a second look at an earlier administrative grant of a patent” merely because the patent expired, and instituted. *Id.* (citing *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 336 (2018)). The Board explained that “[t]he statutes and our Rules governing *inter partes* review do not exclude expired patents or those not subject to civil actions.” *Id.* (citing 35 U.S.C. §§ 311, 315; 37 C.F.R. § 42.100(b)).

The Board in *Apple* similarly held that it has authority to review expired patents. *See Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00922, Paper 10 at 17-19 (P.T.A.B. Nov. 29, 2021). Like *Inari*, the Board in *Apple* found that the Supreme Court has endorsed a second look at granted patents, and found that (1) the PTAB rules make clear that IPRs cover expired patents, and (2) statutes governing IPR proceedings *do not limit IPRs to non-expired patents*, even though

they impose other limitations. *Id.* (citing 37 C.F.R. § 42.100(b) (2012); 83 Fed. Reg. 51341 (Oct. 11, 2018); 35 U.S.C. § 311(b), (c); 35 U.S.C. § 315).⁷

Patent Owner’s argument that “[t]he subject matter of this patent is already available to the public” is also misplaced. Paper 6 at 15. If this were true, Patent Owner would have no rights to sue Google. But this is not the case—Patent Owner is currently asserting the ’517 patent in district court. *See Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011). The fact that a patent expired does not automatically convert that patent to the public when retroactive damages are still available. *See* 35 U.S.C. § 286.

The Federal Circuit has confirmed as much. *See Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 369 (Fed. Cir. 2025). The Federal Circuit explained, “although a patentee has fewer rights when its patent has expired, *it nevertheless maintains some rights, such as bringing an action for past damages.*” *Id.* (cleaned up). As such, the Federal Circuit stated that the Board’s interest in “protect[ing] the public’s paramount interest in seeing that patent monopolies are kept within their

⁷ Patent Owner cites a pending certiorari petition questioning the propriety of having the Board review expired patents. Paper 6 at 14 n.1. But until the Supreme Court suggests such a practice is improper (or a “waste of resources”), review of expired patents remains the status quo.

legitimate scope” extends beyond the patent’s expiration date. *Id.* (cleaned up).

And that includes allowing *inter partes* review of expired patents. Patent Owner’s arguments do not support discretionary denial in this case. *See* Paper 6 at 1, 12-16.

C. Any “Settled Expectations” in This Case Favor Google

If anything, purported “settled expectations” favor Google and weigh against discretionary denial. Patent Owner accuses Google’s Cloud CDN of infringing. EX-1030, 4. Cloud CDN launched in 2015, becoming known and available to the public at that time. Instead of taking any action, the prior owner of the ’517 patent never asserted it against Google or any other party, while the current Patent Owner acquired the patent after it expired and filed suit in 2024. This “weighs against Patent Owner’s claim of strong settled expectations.” *See Shenzhen*, IPR2025-00531, Paper 10 at 3 (that the “challenged patent[] ha[s] never been “asserted, marked, licensed, or otherwise applied” in petitioner’s “particular technology space” weighs against discretionary denial).⁸ The delay of the ’517 patent owners

⁸ There is also no evidence Patent Owner commercialized a product. *See Shenzhen*, IPR2025-00531, Paper 10 at 3. At most, Patent Owner identifies the activity of its predecessors, before Patent Owner came to own the patent in April 2024. *See* Paper 6 at 2-5. Patent Owner otherwise identifies individuals associated with these

created settled expectations for Google. Indeed, it is reasonable for a defendant to think that any dispute regarding its products would be brought soon after a patent issued or after the accused products launched, rather than almost a decade later.⁹

IV. The *Fintiv* Factors Favor Referral

A. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Factor 1 weighs in favor of institution. Patent Owner incorrectly contends that “[t]here is no stay of proceedings in the parallel district court case.” *See* Paper 6 at 17. The district court granted a stay in the parties’ parallel litigation pending the issuance of the Board’s discretionary denial decisions (a “pause”) except for the completion of claim construction discovery, which concluded July 18, 2025. EX-2006, 2-5. All aspects of the case have been paused, with the exception of the scheduled date of trial. *Id.* Consistent with standard practice in the Central District of California, the district court also agreed to stay the case *in its entirety* if the Board institutes the pending IPRs, in large part because Patent Owner indicated

predecessors (Andrew Swart and David Farber), who are not named inventors of the ’517 patent. *See, e.g., id.*

⁹ Regardless, Patent Owner only came into possession of the ’517 patent in 2024. *See* EX-1029. Patent Owner cannot assert it had any settled expectation before its ownership. *See* Paper 6 at 1, 12.

that it “will agree” to such a stay if all IPRs are instituted. *Id.* Supporting a full stay, the district court found the parties “generally agree that *no undue prejudice would arise* from a post-institution stay.” *Id.* at 4.

Unlike other cases that present a binary choice between a stay being granted and not being granted, this case presents a unique scenario where the district court issued a partial stay, limiting the court’s schedule in deference to the Board. *Id.* (“After the close of claim construction discovery, which will be useful to both this case and any hypothetical PTAB proceedings, the Court orders a pause on claim construction and discovery work until the PTAB issues its discretionary denial decisions.”); *id.* at 3 (explaining “Google’s IPR petitions address all asserted claims, so if the PTAB institutes proceedings, *such proceedings could simplify the issues in this case. This is true even if all claims survive the IPRs* because the parties’ . . . positions before the PTAB *could streamline claim construction proceedings before this Court, the Court will have the benefit of the PTAB’s expert review, and Google will be estopped from raising certain invalidity grounds . . . , narrowing the issues before the Court.*”). This weighs in favor of referral.

Patent Owner's remaining arguments¹⁰ related to settled expectations do not relate to *Fintiv* Factor 1 and are without merit for the reasons discussed above. *See* Paper 6 at 17-18. Indeed, Patent Owner assumes it is a foregone conclusion that the proceedings in this IPR (IPR2025-00826), IPR2025-00806, and IPR2005-00969 will be denied because they involve expired patents that have purportedly been in force for over a decade, and as such, a stay will never occur because not all patents will be addressed by the Board in an *inter partes* review proceeding. *Id.* at 17. But as discussed above, the fact that the '517 patent was in force for only nine years before expiring does not compel the PTAB to deny institution. *See* Section III. The same is true for the other asserted patents that have expired. Paper 6 at 17. Patent Owner's citation to *Dabico*, IPR2025-00408, Paper 21, does not require a different outcome because *Dabico* did not address expired patents. *See* Paper 6 at 17. Patent Owner's reference to the patents at issue in IPR2025-00846 and IPR2025-00952 being found ineligible under 35 U.S.C. § 101 also has no bearing in this case. *See id.* at 17-18. Nor does it disturb the existing pause or subsequent stay should the Board grant institution on the other patents because those two patents are no longer at issue in the litigation. *See* EX-2006, 2.

¹⁰ Patent Owner's arguments on the merits are addressed below in Section V. *See* Paper 6 at 18.

B. Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

Factor 2 is neutral. Trial in the litigation is set for September 28, 2026—two months before the anticipated Final Written Decision. However, because fact discovery has already been paused for at least three months, the trial date will likely be delayed to allow sufficient time for the parties to complete fact and expert discovery if the stay is lifted. *See id.* at 3, 5.

Patent Owner's statistics also fail to reflect the district court's estimated time-to-trial in *patent* cases. *See* Paper 6 at 18-19. For example, while the median time to trial might be 27.8 months for civil cases generally, the median time to trial in patent cases is 887 days, or approximately between 28.6 months ($887/31=28.6$) to 29.6 months ($887/30=29.6$). *See* EX-1017, 3. As such, the expected median trial dates for patent cases in the district court are *within a matter of a few weeks* of the expected Final Written Decision here.

The PTAB cases Patent Owner relies on are not dispositive. *See* Paper 6 at 19. For example, the Director has determined that the complexity of the parallel litigation may outweigh the proximity of a trial date. *See Tesla v. United States of Am. as represented by the Sec'y of the Navy*, IPR2025-00341, Paper 12 (P.T.A.B. June 13, 2025). That is the case here. Not including the patents already found ineligible under § 101, the parties' litigation involves at least five distinct patent

families, creating a labyrinth that would be simplified by the Board’s review of the asserted patents. *See* EX-2004, 9-14 (describing priority claims of asserted patents).

C. Factor 3: investment in the parallel proceeding by the court and the parties

Factor 3 weighs in favor of institution. Patent Owner contends that “[s]ignificant work has already been done in the parallel district court litigation,” and as such, Factor 3 should weigh in favor of institution. Paper 6 at 19-20. But this contradicts Patent Owner’s earlier admission that “the parallel district court case *is in its early stages*” (*id.* at 13), and that, in district court, the parties “generally agree[d]” that the case is in the “relatively early stages” (EX-2006, 3) (“*parties generally agree that, although some work has been done, this case remains in the relatively early stages with more work ahead of the parties and the Court than behind*” (citing *Realtime Data LLC v. Teradata Operations, Inc.*, No. 2:16-cv-02743, 2017 WL 3453295, at *2 (C.D. Cal. Feb. 27, 2017)))).

Regardless, a significant amount of work remains. To accommodate the IPRs, the district court’s partial stay has delayed the case. EX-2006, 5. Fact and expert discovery are stayed pending resolution of the IPRs. *Id.* Opening claim construction briefs are not due until after the institution deadline for the ’112 and ’517 patents (*see id.*), while responsive briefs are not due until after the institution

decisions for the '573 and '903 patents are expected, and roughly around the time an institution decision is expected for the '332 patent. *Id.* The *Markman* hearing is delayed until after the last institution decision is expected. *See id.* While the district court permitted the parties to complete claim construction discovery, that phase concluded on July 18, 2025, and the case is now fully stayed pending the Board's discretionary denial decisions. *Id.* at 4 ("After the close of claim construction discovery, which will be useful to both this case and any hypothetical PTAB proceedings, the Court orders a pause on claim construction and discovery work until the PTAB issues its discretionary denial decisions."). The district court's partial stay has minimized investment by the parties.

Patent Owner also contends that the district court has "become well-versed with the underlying patented technology (per *Alice* step one), and the general state of the art and specific disclosures of the pertinent prior art (per *Alice* step two)" because of motions briefing for two unrelated patents found patent ineligible. Paper 6 at 20; EX-2007. But Patent Owner declines to mention that the § 101 motions were heard and decided by Judge Philip S. Gutierrez (EX-2007, 1), and the case has since been *reassigned* to Judge André Birotte Jr. when Judge Gutierrez retired (EX-1018, 1). Thus, there is little "judicial economy" in denying institution, as Patent Owner contends, because the court will need to be brought up

to speed, just as the Board will, in the underlying patented technology, the general state of the art, and the specific disclosures of the pertinent prior art.

D. Factor 4: overlap between issues raised in the petition and in the parallel proceeding

Factor 4 weighs in favor of institution. As an initial matter, the district court found that “Google’s IPR petitions address all asserted claims, so if the PTAB institutes proceedings, such proceedings could simplify the issues in this case.” EX-2006, 3. There will be tangible benefits for the district court if the PTAB institutes this proceeding, realizing the underlying goals of the IPR regime to simplify issues. *See id.*

Moreover, Google timely entered a *Sotera* stipulation with its Petition, stating that it “stipulates that, if the PTAB institutes an IPR proceeding on the grounds presented in Google’s petition challenging the claims of the ’517 patent, Google will not pursue in this district court litigation the same grounds in the petition or any grounds that reasonably could have been raised during the IPR with respect to the patent claims subjected to the instituted IPR (i.e., any ground that reasonably could have been raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications).” EX-1016.

Patent Owner’s assertion that this stipulation is “nominal[]” (*see* Paper 6 at 20) is incorrect because it diminishes the scope of estoppel expressly provided

for by statute. 35 U.S.C. § 315(e). To require Google (and in effect all petitioners) to accept more than the full scope of estoppel at institution penalizes all petitioners beyond what was contemplated by Congress. *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1360 (Fed. Cir. 2025) (noting that Congress’s “stated intent . . . was to allow the PTO to evaluate patents and printed materials, matters which are normally handled by patent examiners, while excluding challenges to validity on other grounds (e.g., public uses or sales), which would remain the province of the courts” (quoting *Lynk Labs, Inc. v. Samsung Elecs. Co.*, 125 F.4th 1120, 1128 (Fed. Cir. 2025))).

To that end, this case is distinguishable from *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025), cited by Patent Owner. Paper 6 at 21. There, the Director found that the investment in litigation that is not present here, including the parties serving expert reports, conducting “several depositions,” and the court holding a *Markman* hearing and construing several claims, “strongly” favored discretionary denial. *See, e.g., Motorola*, IPR2024-01205, Paper 19 at 3-4. In contrast, here, the case is stayed pending the discretionary denial decision and little investment has been made in the case so far. *See* Sections IV.A-IV.C. Nonetheless, *Motorola* does not establish, as a matter of course, that *Sotera* stipulations are insufficient to make IPR proceedings a “true alternative” to district court litigation. *See* Paper 6 at 21.

E. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party

Factor 5 favors institution or is at most neutral. Although the parties are involved in a litigation, Patent Owner is involved in litigation against other parties, including at least Comcast and Microsoft. EX-1026, 18-25; EX-1027, 14-22. There is no indication that Patent Owner will not assert the '517 patent against future defendants. Instituting review in this case would benefit not only the district court proceeding involving Google, but also potential future litigations with other defendants. *See Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2-3 (P.T.A.B. July 2, 2025) (stating “[b]ecause the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient”).

F. Factor 6: other circumstances that impact the Board’s exercise of discretion, including the merits.

Factor 6 weighs in favor of institution. As described below in Section V, the Petition presents compelling merits based on prior art the Examiner should have identified and used to reject the claims of the '517 patent. This warrants institution. *See Microsoft*, IPR2025-00318, Paper 9 at 3 (examiner error outweighed *Fintiv*); *cf. Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9 at 2 (P.T.A.B. July 31, 2025) (finding a material error during examination weighed in favor of institution as part of *Fintiv* Factor 6 analysis).

V. Patent Owner’s Merits-Based Arguments Should Be Rejected

As discussed, Ben-Shaul is a near anticipatory prior art reference, and Beaumont and Hasan also separately disclose each of the claimed elements. The Petition’s merits are strong, and Patent Owner’s arguments mischaracterize the prior art. *See, e.g.*, Paper 6 at 25-46.

A. The Petition Demonstrated Obviousness Under Grounds 1 and 2

1. Beaumont in View of Hasan Teaches the Claimed “Policy” Features

With respect to Grounds 1 and 2, Patent Owner argues that the ’517 patent claims “unique policy limitations” that are missing from the cited prior art, thus “preclud[ing] any likelihood of success.” *See id.* at 26. Not so. Indeed, the Beaumont-Hasan combination would have provided these policy features in the same manner as described in the ’517 patent.

To support these contentions, Patent Owner asserts that a “‘policy’ or a ‘policy-based’ feature generally refers to a course, rule, or principle of action.” *Id.* at 27. To the extent Patent Owner is proposing a construction with its argument, Google disagrees that its construction is required or correct. *See* Paper 1 at 9. For example, Patent Owner ignores that the claims require a GUI that supports the setting of the claimed policy using a decision tree. *See, e.g.*, EX-1001, 31:32-46. Regardless, even under Patent Owner’s flawed construction, Beaumont and Hasan disclose the claimed policy elements.

The thrust of Patent Owner’s argument is that “[a] preference table is not a policy.” *See* Paper 6 at 30. Patent Owner attempts to illustrate its point using an example of a “geographic policy” described in the ’517 patent in which “decisions are based on the location of the end-user . . . using the IP address of an end-user’s resolver.” *Id.* at 28 (quoting EX-1001, 7:13-21). In this example, Patent Owner envisions a policy that provides: “[I]f the IP address is within the U.S., the request may be directed to a domestic group of servers in the subscriber server network[;] otherwise[,] it may be directed to international servers in the network.” *Id.*

According to Patent Owner, “what is missing from Beaumont is any disclosure of how the information in the table could be used to direct network traffic.” *Id.*

To the contrary, Beaumont discloses this same form of policy. The Petition explains that, in Beaumont, “content delivery servers are selected based on sharing a high-level domain (and thus location) with the requesting client.” Paper 1 at 19. Beaumont’s “content provider DNS uses the IP address of a client, finds the corresponding geographical area according to the IP address space mapping, and selects a content delivery server in the same geographical area.” EX-1006, [0024]. Thus, like Patent Owner’s example from the ’517 patent, so too in Beaumont: “if the IP address is within the U.S., the request may be directed to a domestic group of servers in the subscriber server network[;] otherwise, the request may be directed to international servers in the network.” *See* EX-1001, 7:13-21.

While the values underlying this policy are stored in a table, Beaumont nonetheless applies a policy used to select a server. EX-1007, [0030] (describing “assigning rules”). Patent Owner concedes that “the information recorded in Beaumont’s preference table could be used to inform a policy.” Paper 6 at 30. Indeed, it does.

2. Beaumont in View of Hasan Teaches “One or More Branch Nodes Specify[ing] One or More Decision Criteria to Be Applied”

Patent Owner similarly argues that Beaumont and Hasan do not disclose or suggest “the one or more branch nodes specify one or more decision criteria to be applied” because a “table does not have any criteria.” *Id.* at 31. Thus, Patent Owner again improperly focuses on the format of the data underlying the decision criteria and ignores the disclosure in Beaumont.

Patent Owner urges that this element requires two things: (1) decision criteria to be applied, and (2) one or more branch nodes to specify the criteria. *Id.* at 31-32. Returning to the “geographic policy” example, Patent Owner explains its view that “the recited ‘decision criteria’ [are] interpreted as ‘SPLITS ON COUNTRY CODE,’” and that these decision criteria are “specified in the branch node of the decision tree in Figure 10(b).” *Id.* at 32.

Beaumont teaches these same criteria. Much like in the “geographic policy” example, Beaumont uses the locations or domains of the servers as “selection

criteria.” EX-1006, [0028]. The system identifies a set of working servers sharing the same location of the client using the preference table. *Id.* at [0024] (“A content provider DNS uses the IP address of a client, finds the corresponding geographical area according to the IP address space mapping, and selects a content delivery server in the same geographical area.”). The system thus splits on location, similar to the ’517 patent’s country codes. *Id.* And Beaumont uses other values from this table, such as preference numbers, to make further decisions. *Id.* at [0031]. Thus, Beaumont teaches more than “listing[] . . . the locations, capabilities, or statuses of a server.” *See* Paper 6 at 31. Beaumont teaches the same form of decision criteria as the ’517 patent. EX-1006, [0028].

When combined with Hasan, Beaumont’s “selection criteria” are also specified by one or more branch nodes. Paper 1 at 19. While Beaumont describes a table, it acknowledges “other data structures such as a tree can be used.” *Id.* at 17 (quoting EX-1007, [0023]). Hasan’s GUI includes this “tree structure,” providing a “hierarchical layout of the data center, its facilities, subscriber, devices and/or log servers.” EX-1006, 8:19-29. The claims of the ’517 patent require a “*GUI* [that] supports the setting of said at least one policy using a decision tree.” EX-1001, 31:32-35. Thus, when presented in this format, Beaumont’s selection criteria would be represented in the GUI as branch nodes. Paper 1 at 19. Patent Owner’s arguments should be rejected.

B. The Petition Demonstrated Obviousness Under Grounds 3A and 3B

1. Ben-Shaul Teaches the Claimed “Policy” Features

Patent Owner contends that “the Office already considered [Ben-Shaul’s teaching of policy features] and ultimately allowed the claims of both the ’517 patent’s predecessor patents based on similar distinguishing claimed subject matter.” Paper 6 at 38. Not so. Rather, the Examiner maintained that these policy features were disclosed in Ben-Shaul and only allowed the applications based on other limitations. *See* Section II.

As explained, during prosecution of the ’497 application, the Applicant overcame rejections based on Ben-Shaul by significantly narrowing the claims to recite either “monitored” and “managed server[s]” (EX-2002, 259), a “subscriber server network includ[ing] . . . a server hierarchy” (*id.* at 265-66, 270-71, 277), or consolidating “events sent from at least one monitoring mechanism of the at least one domain name server” (*id.* at 281), none of which are present in the claims of the ’517 patent. *See* Section II. During prosecution of the ’162 application, the Examiner maintained on appeal that Ben-Shaul recited these policy-based features. EX-2003, 1245 (rejecting argument that “Ben-Shaul does not implement policy based DNS resolution”). In response to the Examiner’s Answer, Applicant dropped these arguments, amending the claims to recite subject matter not present in the ’517 claims. *Id.* at 1308, 1309, 1311. And it was the lack of this subject matter the

Applicant argued to reach an allowance. *Id.* at 1316; *see* Section II. The prosecution history of these applications thus supports finding that Ben-Shaul discloses policy-related features. The Examiner never wavered from this position. EX-2002, 296-99; EX-2003, 1316.

Patent Owner further argues that “Ben-Shaul does not teach or suggest . . . that the claimed policy is implemented for ‘direction of network traffic.’” Paper 6 at 40. Specifically, Patent Owner contends that because Ben-Shaul’s EdgeDNS is implemented as a “first step,” it does not perform the recited “direction of network traffic.” *Id.* at 41. Not so.

Patent Owner’s interpretation of this “first step request direction” is mistaken. For example, Patent Owner asserts that Ben-Shaul’s EdgeDNS server directs requests “prior to interactions between origin servers and edge servers, and . . . merely forwards these requests to certain resource zones.” *Id.* Ben-Shaul says the opposite: requests for certain zones are “*forward[ed]* . . . to a special local DNS entity termed the EdgeDNS.” EX-1005, [0041]. Then, EdgeDNS is “responsible to return the IP address of either the edge server or another server for resources whose URL resides in these domains.” *Id.* The EdgeDNS server thus performs the same form of traffic direction as the “geographic policy” example in the ’517 patent. *Id.* at [0044] (“[A] DNS request is . . . directed to an edge server based on

that server’s association with the group.”), [0048] (“[A]n edge server group includes . . . geographical region.”); *see* Paper 6 at 28 (citing EX-1001, 7:13-21).

Patent Owner’s argument that the claimed “traffic direction” requires “load balancing” similarly fails, as it improperly reads limitations from the specification into the claims. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1326 (Fed. Cir. 2002). Nevertheless, Ben-Shaul confirms that the EdgeDNS redirection services provide the same form of load share balancing discussed in the ’517 patent. *See, e.g.*, EX-1005, [0044] (“the same resource may have different priorities in different edge servers, permitting optimized use of resources”). Patent Owner’s other arguments regarding Hasan are misplaced, as Google does not rely on Hasan for this “traffic direction” element. *See* Paper 1 at 43, 47.

2. Ben-Shaul Teaches the Claimed “One or More Branch Nodes Specify[ing] One or More Decision Criteria to Be Applied”

Patent Owner incorrectly argues that Ben-Shaul does not teach “one or more branch nodes specify[ing] one or more decision criteria to be applied,” because “the group characteristics of Ben-Shaul’s edge servers . . . are entirely not the recited ‘decision criteria.’” Paper 6 at 43-46. Rather, according to Patent Owner, “[t]hese group characteristics may, at most, be interpreted as server attributes, which are entirely different from the recited ‘decision criteria.’” *Id.* at 45. Patent

Owner again improperly focuses on the format of the data underlying the decision criteria and ignores the disclosure in Ben-Shaul.

Returning to the “geographic policy” example, Patent Owner contends that “the recited ‘decision criteria’ [are] interpreted as ‘SPLITS ON COUNTRY CODE’” and that these decision criteria are “specified in the branch node of the decision tree in Figure 10(b).” *Id.* at 32. Ben-Shaul describes this same form of policy. As Google highlighted, Ben-Shaul’s “[r]egional and group differentiation . . . allow[s] one to differentiate delivery based on the location or the organization membership of the edge server.” EX-1005, [0044]; Paper 1 at 55.

Patent Owner’s argument that “Ben-Shaul’s group characteristics [do not] group the edge servers with a group” is also incorrect. Paper 6 at 45. Ben-Shaul’s system explicitly “supports the capability to predefine meaningful grouping of edge servers, in order to simplify the application of policies applicable to a set of related edge servers.” EX-1005, [0309]; Paper 1 at 47.

Patent Owner’s further contention that “the criteria for selecting the different servers in Ben-Shaul are not explicitly specified in Ben-Shaul’s internal nodes” should likewise be rejected. *See* Paper 6 at 45. The claims require a “*GUI* [that] supports the setting of said at least one policy using a decision tree.” EX-1001, 31:32-35. Ben-Shaul’s front edge tool teaches this functionality, allowing “[a]dministrators . . . [to] construct hierarchies of edge servers” and to “defin[e]

service profiles for any internal node in the hierarchy.” EX-1005, [0309]. The combined Ben-Shaul-Hasan GUI also discloses this element, enabling users to define groups of edge servers, thus affecting which policies apply to which servers. Paper 1 at 51 (citing EX-1006, 17:11-13). Patent Owner’s merits-based arguments should be rejected. The strong merits of the Petition weigh in favor of referral here.

VI. Google’s Reliance on Expert Testimony Is Not Excessive or Improper

A. The Petition Does Not Rely On Expert Testimony to Fill Gaps

Contrary to Patent Owner’s arguments, Google does not overly rely on expert testimony or use it to “fill in the gaps of the prior art.” Paper 6 at 23. That Patent Owner takes exception to Google’s explanation of what a POSITA would have understood or recognized in the prior art does not amount to gap filling. *See id.* Indeed, explaining how a POSITA would have understood the asserted art, and how and why a POSITA would have combined references, is required to establish obviousness. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401 (2007); *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337 (Fed. Cir. 2020) (“[I]nquiry into whether any ‘differences’ between the invention and the prior art would have rendered the invention obvious to a skilled artisan *necessarily depends* on such artisan’s knowledge.”).

Patent Owner’s specific examples do not support its contentions. Paper 6 at 24-25. Regarding element [1.e.i], for example, Patent Owner asserts “[there is no

reason provided why the ‘answers’ (servers selected for handling a request) would be in the prior-art GUI,” and “[t]he Petition merely declares that doing so ‘would [be] enable[d]’ in a single conclusory sentence.” *Id.* at 24. Not so. The Petition explains that, “[b]ecause [Beaumont’s] preferences define which server address is returned . . . , and the GUI supports the specification of the preferences, the GUI supports specification of one or more answers.” Paper 1 at 20. And the Petition relies on Dr. Lin’s explanation of how a POSITA would have understood the combined GUI to operate: Hasan’s GUI allows administrators to “configure individual devices via the interface,” and thus would allow setting preferences defining which server address is returned in the combination. *Id.*; EX-1003, ¶85 (quoting EX-1006, 6:28-31). This is entirely proper. *See Philips*, 948 F.3d at 1337.

As to Patent Owner’s further example discussing element 1.b (*see, e.g.*, Paper 6 at 24), the Petition properly relies on Dr. Lin’s testimony to establish how a POSITA would have understood the “various management capabilities” recited in Hasan. Paper 1 at 17. For example, Dr. Lin explains that, “[i]n [his] opinion, a POSITA would have understood that these management capabilities include defining policy information.” EX-1003, ¶76 (citing EX-1006, 7:14-21 (“Using the GUI, an administrator can configure . . . policy information.”)). And with respect to Patent Owner’s remaining example (Paper 6 at 24), the Petition properly relies on Dr. Lin’s testimony to explain why a POSITA would understand a destination

domain to act as a decision criterion in the combination. Paper 1 at 20. Here, Dr. Lin explains that, in Beaumont, “content delivery servers are selected based on sharing a high-level domain (and thus location),” and that, in Hasan’s hierarchical layout, “devices (i.e., servers) [are] grouped by locations.” EX-1003, ¶81. This is not gap filling.

B. Patent Owner Has Not Presented Competing Expert Testimony

Patent Owner contends that it “will present competing expert testimony,” and further that it will be so extensive that resolution is purportedly better suited for district court litigation. *See* Paper 6 at 25. But Patent Owner’s assertion that it will file competing expert testimony does not substitute for actually presenting such testimony here. Patent Owner’s arguments related to the teachings of Beaumont and Ben-Shaul and what a POSITA would have understood rely solely on attorney argument, which is not evidence. *See Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017).

Moreover, the Board is well suited to make factual findings, including what the prior art discloses and whether there is sufficient motivation to combine. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015) (“Board members, because of expertise, may more often find it easier to understand and soundly explain the teachings and suggestions of prior art”); *Brand v. Miller*, 487 F.3d 862, 869 (Fed. Cir. 2007) (“PTAB’s expertise appropriately plays a role

in interpreting record evidence.” (internal quotations omitted)). The Board is also capable of making determinations about expert testimony, including weighing the credibility of opposing experts. *Trs. of Columbia Univ. in City of N.Y. v. Illumina, Inc.*, 620 F. App’x 916, 922 (Fed. Cir. 2015) (explaining the Board is “entitled to weigh the credibility of the witnesses in light of their qualifications and evaluate their assertions accordingly”); *see also Inwood Lab ’ys, Inc. v. Ives Lab ’ys, Inc.*, 456 U.S. 844, 856 (1982) (“Determining the weight and credibility of the evidence is the special province of the trier of fact.”); *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir. 2010) (“We defer to the Board’s findings concerning the credibility of expert witnesses.”). Patent Owner does not explain how or why a dispute between experts (if there is one) is better suited for resolution in district court.

C. Criticizing Reliance on Expert Testimony Contradicts the AIA’s Particularity Requirements and Ignores That Testimony’s Role in Providing Substantial Evidence

Patent Owner faults Google for citing to the expert “over 230 times, rather than providing a focused expert declaration addressing the limitations for which expert testimony is necessary.” Paper 6 at 23. This argument should be rejected.

As an initial matter, Google’s citations are expected given the obviousness grounds in the Petition and the technical analysis needed to support those grounds. Indeed, the IPR statute requires that grounds be identified with particularity, and specifically contemplates petitioners using “evidence that supports the grounds for

the challenge to each claim, including . . . affidavits or declarations.” *See* 35 U.S.C. § 312(a)(3)(B). Google’s citations—to its expert and objective evidence—comport with this clear statutory direction and simply underscore the ample factual support provided in the Petition. Suggesting that Google curb its citations contradicts the requirement that substantial evidence support any obviousness positions. *Compare* Paper 6 at 22-25, with *Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.*, 24 F.4th 1406, 1413 (Fed. Cir. 2022); *Shoes by Firebug LLC v. Stride Rite Children’s Grp., LLC*, 962 F.3d 1362, 1372 (Fed. Cir. 2020) (affirming the Board’s findings based on weight of expert testimony).

VII. The Petition’s Grounds Are Not Needlessly Complicated

Patent Owner contends that the Petition is “needlessly complicated” because it “presents a priority date challenge, and then presents every single prior-art reference as alternatively prior art under 35 U.S.C. § 102(b) or § 102(e) based on the success of that priority challenge.” Paper 6 at 25. This argument should be rejected.

The Petition explains that the claimed concept of “one or more resource nodes [being] . . . mail exchange (MX) records” is not supported in the priority chain. Paper 1 at 7. Thus, the earliest possible priority date for the ’517 patent is October 26, 2007. *Id.* Accordingly, each reference is prior at under § 102(b). *Id.* This ends the inquiry.

But even if Patent Owner disputes this priority date, the asserted references are *still* prior art under 35 U.S.C. § 102(e). This too ends the inquiry. The Petition’s grounds are not “needlessly complicated.” The asserted references are prior art to the challenged claims regardless of which priority date Patent Owner asserts. There is nothing improper (or needlessly complicated) about explaining this situation. *See, e.g., nuOnosys, Inc. v. RRT Holdings, LLC*, IPR2020-01706, Paper 7 at 4 (P.T.A.B. Apr. 14, 2021) (granting institution and declining to resolve priority dispute when references qualify as prior art under either date); *Halliburton Energy Servs., Inc. v. U.S. Well Servs., LLC*, IPR2021-01065, Paper 27 at 11 (P.T.A.B. Feb. 6, 2023) (finding challenged claims unpatentable without resolving priority dispute because references are prior art under either date).

VIII. Compelling Economic and Public Interest Concerns Favor Institution

A. Google’s Size Should Not Factor into the Analysis

Aside from stating that Google is a large company and purportedly “one of the most prolific patent-infringement defendants in history” (a statement made without any support), Patent Owner provides no explanation as to why economic or public interests favor denial in this case. *See* Paper 6 at 46-47. Restricting PTAB access by foreclosing a means for large companies to challenge patents, as Patent Owner proposes, is contrary to the AIA, which allows *broad access* to any member of the public, stating that “*a person who is not the owner of a patent* may file with

the Office a petition to institute an inter partes review of the patent.” *E.g.*, 35 U.S.C. § 311(a). Denying petitions based on the size of a petitioner is at least a failure to engage in proper rulemaking, and at worst, an unlawful decision that would exceed the Office’s authority to prescribe regulations related to IPRs. *See, e.g.*, 35 U.S.C. § 316(a).

Patent Owner also argues that “the AIA was also a reaction to the financial hardship on many smaller defendants faced with complex commercial litigation.” Paper 6 at 46. But the legislative history Patent Owner cites does not support this broad proposition. While the AIA was designed to “reduce[] unwarranted litigation costs,” this was not limited to savings for only some parties or courts. EX-1028, 39-40. Indeed, it is Google here that is faced with costly litigation, and utilization of an IPR would help reduce those costs for both parties, as it would simplify the issues in district court.

Patent Owner likewise ignores that the other motivation behind the AIA was “improving patent quality and providing a more efficient system for challenging patents that should not have issued.” *Id.* The strong merits in the Petition (*see* Section V) suggest instituting would accomplish the AIA’s goals of streamlining the litigation and reducing litigation costs.

B. Compelling Economic Interests Favor Institution

Compelling economic interests also favor institution because Google’s strong economic presence in the United States has contributed to American innovation for almost 30 years. EX-1019; *see also* EX-1020 (Google investments have facilitated innovation, supporting goals of the USPTO, including by investing in research and development to power American technological leadership, and create leaps in AI and quantum computing that advance national security). Google employs over 100,000 people. EX-1021.

On the other hand, Patent Owner is a holding company formed within the last two years. *See* EX-1023. It describes itself as a “spin off” and purports to own and manage “Sandpiper’s CDN technology, software, and intellectual property.” *Id.* But Patent Owner does not practice the claimed invention or sell any products related to the claimed technology. In other words, it does not contribute to or otherwise use its intellectual property for the advancement of economic interests in the United States. This favors institution in this case.

C. Compelling Public Interests Favor Institution

Compelling public interest factors favor institution. Here, neither Patent Owner nor any prior owner asserted the ’517 patent against Google during the patent’s term. The patent laws are intended to promote innovation—not to penalize it through retroactive litigation brought only after the patent has expired.

Moreover, instituting would not only streamline the instant dispute between Patent Owner and Google, but also disputes involving other parties.¹¹ Although the '517 patent is not presently asserted against other litigants, institution and a finding of unpatentability would prevent the Patent Owner from unjustifiably asserting the '517 patent against others in the future.

IX. Conclusion

For the foregoing reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution and let the panel decide whether to institute based on the merits of the Petition.

Dated: August 14, 2025

Respectfully submitted,

/Erika H. Arner/

Erika H. Arner, Lead Counsel
Reg. No. 57,540

¹¹In addition to Google, Patent Owner has asserted patents that relate to CDN servers (e.g., the '903 patent, the '322 patent, and more) against Comcast Cable Communications, LLC in 2:24-cv-00886 (E.D. Tex.).

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24 and the Memorandum on Interim Processes for PTAB Workload Management, dated March 26, 2025, Petitioners certify that the word count of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution** as measured by Microsoft Word is 9,642 words, excluding those portions identified in 37 C.F.R. § 42.24(a).

/Erika H. Arner/

Erika H. Arner, Lead Counsel
Reg. No. 57,540

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution** was served electronically via email on August 14 2025, in its entirety on the following:

Jason D. Eisenberg
jasone-PTAB@sternekessler.com

Daniel S. Block
dblock-PTAB@sternekessler.com

Kristina Caggiano Kelly
kckelly-PTAB@sternekessler.com

Xinxiang Zhang
xzhang-PTAB@sternekessler.com

PTAB@sternekessler.com

Dated: August 14, 2025

/Daniel E. Doku/

Daniel E. Doku
Senior Litigation Paralegal
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP