Filed: November 20, 2025

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 GOOGLE LLC'S AUTHORIZED RESPONSE TO PATENT OWNER'S DIRECTOR REVIEW REQUEST

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Patent Owner's Request for Director Review contends that the Acting Director's decision to refer this petition to the Board contradicts other decisions and the Office's policies. Patent Owner is wrong. None of the decisions Patent Owner cites address the same set of underlying facts that here counsel against discretionary denial, including: (1) the stay of the parallel district court proceeding; (2) the fact that the challenged patent is expired; and (3) Patent Owner's post-expiration acquisition and assertion of the challenged patent. Paper 13 at 2. Nor has Patent Owner identified any contradictory Office policy. The decision should be confirmed.

I. The Combination of Factors Present Here Counsel Against Discretionary Denial, Consistent with Other Office Decisions

Patent Owner first argues that the Acting Director erred in her consideration of "settled expectations." In doing so, it cherry-picks facts from other proceedings with different outcomes to suggest two findings are required here: (1) a patent's expiration results in settled expectations mandating discretionary denial, and (2) a patent owner's purported expectations outweigh factors related to *Fintiv*, including a stay in a parallel district court case. *See* Paper 16 ("DR Req.") at 1-7. The cases Patent Owner cites do not support these assertions, and their facts bear little resemblance to the instant matter.

A. The ’517 Patent’s Expired Status Weighs Against Discretionary Denial

Patent Owner first contends that settled expectations must favor discretionary denial whenever a patent has expired—including here, where the accused product (Google’s Cloud CDN) was publicly available years before the patent expired and was later acquired and asserted by Patent Owner, and where the parallel district court action is stayed. *Id.* at 1. Not so.

The compelling facts here favor referral and institution. As explained in Google’s Opposition to Patent Owner’s Request for Discretionary Denial, Paper 9, Google’s petition corrects a material error made by the Office during prosecution of the ’517 patent. *See* Paper 9 at 2-8. And Patent Owner does not allege that the prior owner of the ’517 patent ever alerted Google to the patent, much less accused Google’s well-publicized Cloud CDN of infringing it. *See id.* at 16-17. Only after the expiration of the patent did the current Patent Owner acquire and assert it. *See id*. Each of these facts favor referral. *See generally id.*

The decisions Patent Owner cites do not require a different result. In *Omnivision*, for example, the Acting Director found it unlikely that the district court would stay the proceedings as a *Markman* hearing had been conducted and fact discovery had closed. *Omnivision v. RE Secured Networks*, IPR2025-01019, Paper 14 at 2-3 (P.T.A.B. Oct. 10, 2025). And she found that the petitioner’s filing

of a declaratory judgment action undermined the petitioner's settled expectations. *Id*. at 2. Neither factor exists here. The district court litigation has been paused nearly six months. *See infra* Section I.B. And Patent Owner, not Google, initiated the district court case.

SAP America and *Google LLC v. Mullen Industries LLC* are similarly distinguishable. In each of these decisions, the Acting Director found that the related cases were likely to be tried prior to final decisions (unlike the district court case here, due to the present stay), and that certain of the challenged patents had been dismissed from the related litigation, leading the Acting Director to find it "an inefficient use of Board resources to review these challenged patents." *See e.g.*, *SAP America, Inc. v. Valtrus Innovations Ltd.*, IPR2025-00417, Paper 9 at 2-3 (P.T.A.B. July 10, 2025); *Google LLC v. Mullen Industries LLC*, IPR2025-00227, Paper 13 at 3-4 (P.T.A.B. June 25, 2025). In contrast, the '517 patent challenged here is still asserted by Patent Owner in the parallel proceeding, and Google has stipulated that it will not pursue invalidity grounds in the district court that have been raised (or reasonably could have been raised) in this IPR. *See* EX-1016. Thus, neither case supports discretionary denial here.

Patent Owner's laundry list of other cases does not support its claim that an expired patent compels discretionary denial based on settled expectations. *See* DR Req. at 2-4. As with the cases discussed above, each of the proceedings Patent Owner

cites involved factors absent here. And indeed, *none* of the listed decisions even found the challenged patent's expiration to be a factor favoring discretionary denial. Often, a parallel district court proceeding had not been stayed and the Acting Director found it unlikely that a final written decision would be issued before a decision in the parallel proceeding.[1] In other cases, the Acting Director recognized

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[1] *See, e.g.*, *Samsung Elecs. Co. Ltd. v. Mobile Data Techs., LLC*, IPR2025-00535, (Paper 16 at 2), IPR2025-00536 (Paper 13 at 2) (P.T.A.B. July 10, 2025); *Samsung Elecs. Co., Ltd. v. Keyless Licensing LLC*, IPR2025-00528 (Paper 13 at 2), IPR2025-00529 (Paper 13 at 2) (P.T.A.B. July 17, 2025); *T-Mobile USA, Inc. v. Smart RF Inc.*, IPR2025-00727, Paper 13 at 2 (P.T.A.B. July 29, 2025); *Vertiv Corp. v. Valtrus Innovations Ltd.*, IPR2025-00667 (Paper 11 at 2), IPR2025-00668 (Paper 10 at 2), IPR2025-00669 (Paper 11 at 2) (P.T.A.B. July 31, 2025); *Samsung Elecs. Co. Ltd. v. Mobile Data Techs., LLC*, IPR2025-00537 (Paper 15 at 2), IPR2025-00538 (Paper 15 at 2), IPR2025-00539 (Paper 15 at 2), IPR2025-00540 (Paper 15 at 2), IPR2025-00541 (Paper 15 at 2), IPR2025-00542 (Paper 15 at 2), IPR2025-00543 (Paper 15 at 2), IPR2025-00544 (Paper 15 at 2) (P.T.A.B. August 14, 2025); *Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00642 (Paper 11 at 2), IPR2025-00643 (Paper 11 at 2) (P.T.A.B. August 14, 2025); *Microsoft Corp. v. Dialect, LLC*, IPR2025-00657, Paper 12 at 3 (P.T.A.B. August 14, 2025).

overlap between the proposed IPRs and prior challenges.[2] And in others, the Acting Director found evidence of specific prior conversations between the parties and she suggested that the petitioner should have sought an earlier review.[3] None of these circumstances are present here.

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[2] *See, e.g.*, *Carvana, LLC v. Int'l Business Machines Corp.*, IPR2025-00564, Paper 11 at 2 (P.T.A.B. July 10, 2025) (petition raising challenges "substantially similar" to ones found unpersuasive in district court); *Dentsply Sirona Inc. v. Osseo Imaging, LLC*, IPR2025-00771 (Paper 8 at 2) (Federal Circuit affirming the district court's finding that the challenged patents were not invalid), IPR2025-00772 (Paper 8 at 2) (same), IPR2025-00787 (Paper 8 at 2) (same) (P.T.A.B. July 31, 2025).

[3] *See, e.g.*, *Murata Mfg. Co., Ltd. v. Georgia Tech. Rsch. Corp.*, IPR2025-00383 (Paper 14 at 2-3) (noting parties previously discussed the technology space involving the challenged patent decades prior and citing five pages of related briefing regarding same), IPR2025-00384 (Paper 13 at 2-3) (same) (P.T.A.B. July 29, 2025); *Datadome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 at 2 (P.T.A.B. Aug. 14, 2025) (noting prior correspondence between petitioner and patent owner identifying the specific challenged patents).

Patent Owner relatedly claims that "a petitioner cannot defeat settled expectations based on an argument that the patent was not previously asserted," stating "it is not clear what a petitioner's alleged subjective expectation about enforcement has to do with a patent owner's settled expectation of validity," DR Req. at 5-6. Patent Owner is again wrong.

The sole case Patent Owner cites in support, *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 (P.T.A.B. July 31, 2025), does not even address petitioners' expectations and does not establish any bright-line rule. DR Req. at 6. In *Kahoot!* the petitioner argued that "*Patent Owner does not have settled expectations* because Patent Owner did not previously assert the challenged patent." IPR2025-00696, Paper 12 at 2. The Acting Director determined that in the "absence of sufficient explanation" for this argument, the Patent Owner's expectations in its issued patents favored denial. *Id.* Here, Google raised a different argument—it reasonably expected that a product launched in 2015 would not be accused in 2024 of infringing a patent that expired in 2021 by an entity that acquired the patent only after its expiration. *See, e.g.*, Paper 9 at 16-17. These facts weigh against discretionary denial. *See, e.g.*, *Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 (P.T.A.B. June 12, 2025); *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 (P.T.A.B. Sept. 5, 2025).

While Patent Owner attempts to distinguish *Globus* and *Apple*—both cited in the Acting Director's referral decision—these cases present facts that far more closely align with this case than those cited by Patent Owner. DR Req. at 6-7.

In *Globus*, the Acting Director found that the patent "expired almost four years ago . . . and, accordingly, [petitioner] expected nonenforcement of the challenged patent." *Globus*, IPR2025-00225, Paper 8 at 2. Similarly, in *Apple*, as here, "Patent Owner did not assert the challenged patents against Petitioner until after they expired." *Apple*, IPR2025-00856, Paper 11 at 3. While the patent's expiration in *Globus* was due to nonpayment of maintenance fees and *Apple* involved prior assurances by the patent owner, these decisions demonstrate that petitioners can (and do) have settled expectations that expired patents will not be asserted.

Patent Owner challenges Google's settled expectations based on its new assertion that "approximately 22% of patent infringement litigation asserts patents that are expired." DR Req. at 6. Google has been unable to reproduce that statistic from the information provided in Patent Owner's brief. Even accepting Patent Owner's figure, however, nearly 80% of cases—the overwhelming majority—do not involve expired patents. And Patent Owner does not contend that the minority of cases involving expired patents are regularly brought by entities that acquired the patents only after expiration, as occurred here.

B. The District Court Stay Also Weighs Against Discretionary Denial

According to Patent Owner, the Office's decisions present "clear and consistent analysis" requiring that "settled expectations" outweigh the *Fintiv* factors, including district court stays. *See* DR Req. at 8-9. That is incorrect.

As a threshold matter, the Acting Director correctly found that the district court case is stayed. All proceedings have been on hold since July 2025, and Patent Owner recently stipulated to extend that hold through mid-December 2025, when the last institution decision on the IPRs challenging the asserted patents is due. *See, e.g.*, *Sandpiper CDN, LLC vs. Google LLC*, No. 2:24-cv-03951 (C.D. Cal. Oct. 21, 2015) (Dkt. 87); *see also* EX-2006, 2-5. Patent Owner has also agreed to stay the district court case in its entirety if all IPRs against the asserted patents are instituted. EX-2006, 4. In the meantime, the original claim construction deadlines have now passed and much of the original fact discovery period has run, such that the case schedule will need to be adjusted once the stay is lifted. Patent Owner's suggestion that the case is merely "paused," rather than stayed, does not alter that procedural reality.

Further, contrary to Patent Owner's argument, the cases it cites do not require the Acting Director to weigh "settled expectations" more heavily than other factors. *See* DR Req. at 8. Rather, the Acting Director has routinely found that other factors outweigh such expectations. *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); *Shenzhen Tuozhu Tech. Co. Ltd. v. Stratasys, 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); *Volkswagen Grp. of Am., Inc. v. Longhorn Auto. Grp. LLC*, IPR2025-01064, Paper 9 at 2 (P.T.A.B. Oct. 10, 2025) (explaining "Patent Owner's settled expectations do not outweigh [other] considerations" including material error); *Azurity Pharm., Inc. v. Helsinn Healthcare SA*, IPR2025-00948, Paper 11 at 2-3 (P.T.A.B. Sept. 19, 2025) (finding lack of parallel district court proceeding and potential material error to outweigh settled expectations); *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 at 2-3 (P.T.A.B. Sept. 4, 2025) (finding settled expectations outweighed where "challenged patent has not been commercialized, asserted, marked, licensed, or otherwise applied in [petitioner's] technology space"); *Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (P.T.A.B Sept. 3, 2025) (finding material error outweighs settled expectations); *Am. Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-00786, Paper 12 at 2-3 (P.T.A.B. Aug. 29, 2025) (finding number and scope of challenged patents outweighs settled expectations).

The cases Patent Owner relies on, *see* DR Req. at 9-10, do not require a different result. Though the Acting Director has sometimes found settled

expectations warrant denial of institution, those decisions do not announce a *per se* rule, and none addressed the same combination of underlying facts here.[4]

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[4] *See iRhythm Techs., Inc. v Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025); *Amgen Inc. v. Bristol-Meyers Squibb Co.*, IPR2025-00601, Paper 9 (P.T.A.B. July 24, 2025); *Oneplus Tech. Co., Ltd. v. Pantech Corp.*, IPR2025-00783, Paper 12 (P.T.A.B. Sept. 12, 2025); *Belden Inc. v. CommScope, Inc.*, IPR2025-00833, Paper 13 (P.T.A.B. Sept. 12, 2025); *Samsung Elecs. Co. Ltd. v. VB Assets, LLC*, IPR2025-00868 (Paper 13), IPR2025-00866 (Paper 13), IPR2025-00867 (Paper 13), IPR2025-00869 (Paper 13) (P.T.A.B. Sept. 12, 2025); *Volkswagen Grp. of Am., Inc. v. Longhorn Auto. Grp. LLC*, IPR2025-00925, Paper 9 (P.T.A.B. Sept. 12, 2025); *Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC*, IPR2025-00515 (Paper 15), IPR2025-00516 (Paper 15); IPR2025-00517 (Paper 15) (P.T.A.B. July 16, 2025); *Kangxi Commc'ns. Techs. v. Skyworks Sols. Canada, Inc.*, IPR2025-00912, Paper 9 (P.T.A.B. Sept. 12, 2025); *Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025); *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 (P.T.A.B. June 26, 2025); *Kahoot!*, IPR2025-00696, Paper 12.

II. The Institution Decision Does Not "Conflict[]" with Any Office Policies

In addition to its claims that the outcome here contradicts other decisions, Patent Owner urges that the Acting Director ignored Office policy. *See* DR Req. at 11. Patent Owner is again wrong.

The only purported policies that Patent Owner identifies are to treat patent owners fairly and focus resources on "the best" cases. *Id.*[5] Even assuming Patent Owner has accurately summarized Office policy, Patent Owner's critique is merely that *it* does not believe this case is a good and fair use of the Office's resources. *See id.* That is irrelevant. The specific facts here—including the merits of Google's case, Google's long-settled expectations, and the stay of the parallel district court proceeding—support instituting review. *See generally* Paper 9.

Patent Owner's argument that "[t]he subject matter of this patent is already available to the public" is misplaced. *See* DR Req. at 11. Patent Owner is currently asserting the '517 patent in district court. As the Federal Circuit has recognized,

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[5] Patent Owner appears to extrapolate these "policies" from selective quotations from the Director's September 16, 2025, memorandum regarding "PTAB consideration of prior findings of fact and conclusions of law," which deals with diverging Board and District Court findings and the "Acting Director's Remarks at IPBC Global Conference." *Compare* DR Req. at 11, *with id.* at 11 n.3.

patentees may still seek past damages after a patent's expiration, and the public accordingly has an "interest in seeing that patent monopolies are kept within their legitimate scope" even in cases involving expired patents. *Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 369 (Fed. Cir. 2025).

The Office has similarly rejected arguments like Patent Owner's. 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 Agriscience LLC*, IPR2024-01014, Paper 15 at 24 (P.T.A.B. Dec. 16, 2024). The Board found "no good reason" to discretionarily deny "a second look at an earlier administrative grant of a patent" merely because the patent expired. *Id.* (citing *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325, 336 (2018)). It noted, "[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)); *accord Apple, Inc. v. Gesture Tech. Partners LLC*, IPR2021-00922, Paper 10 at 17-19 (P.T.A.B. Nov. 29, 2021).

Kimble v. Marvel Entertainment, LLC is not contrary. It addressed whether claims for post-expiration royalties were anti-competitive. 576 U.S. 446, 461-62 (2015); DR Req. at 12. *Kimble* says nothing about challenges to expired patents or royalties for damages incurred during the patent term. Nor are *Oil States*, *Cuozzo*, or *Hunting Titan* contrary. *See* DR Req. at 12. In all three, the Board instituted review

and the reviewing court did not disturb that decision. *Oil States*, 584 U.S. at 345*;* *Cuozzo*, 579 U.S. at 283; *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, 28 F.4th 1371, 1382 (Fed. Cir. 2022).

III. Conclusion

The Director should decline Patent Owner's request to revoke institution and instead allow the case to proceed to a final written decision on a full record.

Dated: November 20, 2025

Respectfully submitted,

/Erika H. Arner/
Erika H. Arner, Lead Counsel
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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Authorized Response to Patent Owner's Director Review Request** was served electronically via email on November 20, 2025, in its entirety on the following:

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