Paper No. 9
Filed: August 14, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

Case IPR2025-00826
Patent No. 9,021,112

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

TABLE OF CONTENTS

I. Introduction 1

II. The Office's "Material Error" During Prosecution Favors Referral 3

III. Settled Expectations Also Favor Referral 6

A. Patent Owner Fails to Demonstrate Google Purportedly Knew of the '112 Patent for "Nearly a Decade" 7

B. Patent Owner Cannot Reasonably Contend the Age of Its Patent Should Immunize That Patent from Review 11

C. That the '112 Patent Has Expired Does Not Change the Calculus 14

D. Any "Settled Expectations" in This Case Favor Google 17

IV. The *Fintiv* Factors Favor Referral 18

A. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted 18

B. Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision 21

C. Factor 3: investment in the parallel proceeding by the court and the parties 22

D. Factor 4: overlap between issues raised in the petition and in the parallel proceeding 24

E. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party 26

F. Factor 6: other circumstances that impact the Board's exercise of discretion, including the merits. 26

V. Patent Owner's Merits-Based Arguments Should Be Rejected 27

A. Glines and Gupta Disclose the Claimed ISP DNS Server 27

B. The Petition Demonstrated Obviousness of the Claimed "Plurality of Content Providers" and "Switch" 33

C. The Petition Sufficiently Explained Why It Would Have Been Obvious to Combine Glines and Gupta 37

VI. Google's Reliance on Expert Testimony Is Not Excessive or Improper 38

A. The Petition Does Not Rely On Expert Testimony to Fill Gaps 38

B. Patent Owner Has Not Presented Competing Expert Testimony 40

C. Criticizing Reliance on Expert Testimony Contradicts the AIA's Particularity Requirements and Ignores That Testimony's Role in Providing Substantial Evidence 42

VII. The Petition's Grounds Are Not Voluminous, Excessive, or Based on "Indeterminate Prior Art" 43

VIII. Compelling Economic and Public Interest Concerns Favor Institution 47

A. Google's Size Should Not Factor into the Analysis 47

B. Compelling Economic Interests Favor Institution 48

C. Compelling Public Interests Favor Institution 49

IX. Conclusion 50

TABLE OF AUTHORITIES

Page(s)

Federal Cases

Apple Inc. v. Gesture Tech. Partners, LLC,
127 F.4th 364 (Fed. Cir. 2025) 15, 16

Argentum Pharms. LLC v. Novartis Pharms. Corp.,
956 F.3d 1374 (Fed. Cir. 2020) 10

B/E Aerospace, Inc. v. C&D Zodiac, Inc.,
962 F.3d 1373 (Fed. Cir. 2020) 33

Belden Inc. v. Berk-Tek LLC,
805 F.3d 1064 (Fed. Cir. 2015) 41

Brand v. Miller,
487 F.3d 862 (Fed. Cir. 2007) 41

Celgene Corp. v. Peter,
931 F.3d 1342 (Fed. Cir. 2019) 3, 7

Fleming v. Cirrus Design Corp.,
28 F.4th 1214 (Fed. Cir. 2022) 46

Genetics Inst., LLC v. Novartis Vaccines & Diagnostics, Inc.,
655 F.3d 1291 (Fed. Cir. 2011) 16

Icon Health & Fitness, Inc. v. Strava, Inc.,
849 F.3d 1034 (Fed. Cir. 2017) 41

Ingenico Inc. v. IOENGINE, LLC,
136 F.4th 1354 (Fed. Cir. 2025) 25

Inwood Lab'ys, Inc. v. Ives Lab'ys, Inc.,
456 U.S. 844 (1982).....41

Kirwa v. U.S. Dep't of Def.,
285 F. Supp. 3d 21 (D.D.C. 2017).....7

Koninklijke Philips N.V. v. Google LLC,
948 F.3d 1330 (Fed. Cir. 2020) 39, 40, 46

KSR Int'l Co. v. Teleflex, Inc.,
550 U.S. 398 (2007).....39

Lynk Labs, Inc. v. Samsung Elecs. Co.,
125 F.4th 1120 (Fed. Cir. 2025) 25

Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC,
584 U.S. 325 (2018).....15

Palo Alto Networks, Inc. v. Centripetal Networks, LLC,
122 F.4th 1378 (Fed. Cir. 2024) 32

Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.,
24 F.4th 1406 (Fed. Cir. 2022) 42

Realtime Data LLC v. Teradata Operations, Inc.,
No. 2:16-cv-02743, 2017 WL 3453295 (C.D. Cal. Feb. 27, 2017).....22

SAS Inst., Inc. v. Iancu,
584 U.S. 357 (2018).....12, 33

Shoes by Firebug LLC v. Stride Rite Children's Grp., LLC,
962 F.3d 1362 (Fed. Cir. 2020) 42

Software Rsch., Inc. v. Dynatrace LLC,
316 F. Supp. 3d 1112 (N.D. Cal. 2018).....8

Tafas v. Dudas,
511 F. Supp. 2d 652 (E.D. Va. 2007) 7

Trs. of Columbia Univ. in City of N.Y. v. Illumina, Inc.,
620 F. App'x 916 (Fed. Cir. 2015) 41

Virtek Vision International ULC v. Assembly Guidance Systems, Inc.,
97 F.4th 882 (Fed. Cir. 2024) 38

Yorkey v. Diab,
601 F.3d 1279 (Fed. Cir. 2010) 41

P.T.A.B. Cases

Adaptics Ltd. v. Perfect Co.,
IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019) 44, 45

Anthony Inc. v. ControlTec, Inc.,
IPR2025-00559, Paper 12 (P.T.A.B. July 16, 2025) 4

Apple, Inc. v. Gesture Tech. Partners, LLC,
IPR2021-00922, Paper 10 (P.T.A.B. Nov. 29, 2021) 15, 16

Berkshire Hathaway Energy Co. v. Birchtech Corp.,
IPR2025-00280, Paper 23 (P.T.A.B. July 2, 2025) 2, 14

Dabico Airport Sols. Inc. v. AXA Power ApS,
IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025) 13, 20

Ecto World, LLC v. Rai Strategic Holdings Inc.,
IPR2024-01280, Paper 13 (P.T.A.B. May 19, 2025) 1, 3

Eunsung Glob. Corp. v. HydraFacial LLC,
IPR2025-00445, Paper 14 (P.T.A.B. July 10, 2025) 4

Globus Med., Inc. v. Spinelogik, Inc.,
IPR2025-00226, Paper 8 (P.T.A.B. June 12, 2025) 14

Hathaway Energy Co. v. Birchtech Corp.,
IPR2025-00274, Paper 23 (P.T.A.B. July 2, 2025) 26

Inari Agric., Inc. v. Corteva Agrisci. LLC,
IPR2024-01014, Paper 15 (P.T.A.B. Dec. 16, 2024) 14, 15

Intel Corp. v. Proxense LLC,
IPR2025-00317, Paper 12 (P.T.A.B. June 26, 2025) 13-14

iRhythm Techs., Inc. v. Welch Allyn, Inc.,
IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) 14

Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH,
IPR2025-00318, Paper 9 (P.T.A.B. June 12, 2025) .....*passim*

Motorola Solutions, Inc. v. Stellar, LLC,
IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025) 25

NHK Spring Co. v. Intri-Plex Tech., Inc.,
IPR2018-00752, Paper 8 (P.T.A.B. Sept. 12, 2018).....12, 13

Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.,
IPR2025-00531, Paper 10 (P.T.A.B. July 17, 2025).....17

Skullcandy, Inc. v. Earin AB,
IPR2025-00690, Paper 9 (P.T.A.B. July 31, 2025).....26

Tesla, Inc. v. Charge Fusion Techs., LLC,
IPR2025-00152, Paper 11 (P.T.A.B. June 12, 2025).....4, 6

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).....21

Xencor, Inc. v. Merus N.V.,
IPR2025-00604, Paper 12 (P.T.A.B. July 17, 2025).....3

Yealink (USA) Network Tech. Co. v. Barco, N.V.,
IPR2025-00491, Paper 18 (P.T.A.B. June 25, 2025).....6

Statutes

5 U.S.C. § 706(2)(A).....7

35 U.S.C. § 101.....21, 23

35 U.S.C. § 286.....16

35 U.S.C. § 311.....15

35 U.S.C. § 311(a).....47

35 U.S.C. § 311(b).....15, 46

35 U.S.C. § 311(c).....12, 16

35 U.S.C. § 312(a)(3).....43

35 U.S.C. § 312(a)(3)(B).....42

35 U.S.C. § 314(a).....33

35 U.S.C. § 315.....3, 15, 16

35 U.S.C. § 315(b) 10, 12

35 U.S.C. § 315(e) 24

35 U.S.C. § 316(a) 47

AIA § 3(n)(1) 12

AIA § 6(f)(2)(A) 12

AIA § 18(a)(3) 12

Regulations

37 C.F.R. § 42.100(b) 15

Legislative Materials

H.R. Rep. No. 112-98, pt. 1 (2011)..... 12-13

Other Authorities

83 Fed. Reg. 51341 (Oct. 11, 2018).....15

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 '112 patent. *See, e.g.*, Paper 1 (Petition) at 1. The first ground relies on a nearly anticipatory reference, Glines, while alternative grounds include references the Examiner had during prosecution of the '112 patent (e.g., Gupta and Colby). The Examiner materially erred by failing to identify and evaluate Glines during examination. The Examiner also erred by overlooking the teachings of Gupta and Colby that were already of record, particularly because these references disclose the very claim limitations the Examiner relied upon to allow the claims. Such a material error should not go uncorrected.

Instead of addressing this material error, Patent Owner cites the purported talisman of settled expectations to suggest denial is more appropriate. But these arguments do not carry the weight Patent Owner places upon them. As the Director has explained, "[s]ettled expectations" are based on "the length of time the claims have been in force." EX-2012, 2. The Director has referred petitions to the Board for patents like that '112 patent that have been "in force" for only six years. *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00280, Paper 23 at 2-3 (P.T.A.B. July 2, 2025) (referring petitions where patent in force for six years). The '112 patent issued in 2015 and expired in 2021 and thus was in force for six years. Referral is therefore appropriate.

Patent Owner further contends that Google has been aware of the '112 patent for over a decade, and that too counsels in favor of discretionary denial. But Patent Owner provides *no evidence* showing Google's purported knowledge of the '112 patent. Instead, Patent Owner relies on related patent applications were cited during the prosecution of Google patents, including the patent application leading to the '112 patent—which courts time and again have held cannot establish knowledge of the patent at issue—and the application for the parent for the '112 patent that was abandoned during prosecution. These applications do not establish that Google had knowledge of the '112 patent before it was asserted in 2024. Google timely filed the Petition challenging the claims of the '112 patent within

one year of service, as it was statutorily authorized to do. Patent Owner was aware of this possibility when it filed its complaint against Google. *See* 35 U.S.C. § 315; *Celgene Corp. v. Peter*, 931 F.3d 1342, 1361-62 (Fed. Cir. 2019) ("[T]he expectation that patent owners have had for nearly four decades [is] that patents are open to PTO reconsideration and possible cancelation if it is determined . . . the patents should not have issued in the first place."). There are no settled expectations that favor Patent Owner, nor any that justify denial of institution in this case.

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.*, IPR2025-00604, Paper 12 at 3 (P.T.A.B. July 17, 2025). The Director has consistently found that such 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," 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" denial is inappropriate "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 Inc. v. ControlTec, Inc.*, IPR2025-00559, Paper 12 at 2 (P.T.A.B. July 16, 2025) (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 identify Glines during prosecution. *See Microsoft*, IPR2025-00318, Paper 9 at 3. Glines was publicly available to the Examiner during prosecution of the '112 patent and is in the same international patent classification as the '112 patent . *See, e.g.*, EX-1002, Cover (publishing May 13, 2001, listing international classification H04L 29/06); EX-1001 (application maturing as the '112 patent filed in 2008 and issuing in April

2015, also listing international classification H04L 29/06). A diligent prior art search in the same international patent classification as the ’112 patent, even with the most cursory of search terms like “anycast address,” would have revealed Glines. The Examiner erred by failing to find and consider its disclosure.

Indeed, as explained in the Petition, Glines is a nearly anticipatory reference that discloses the two DNS resolutions the Applicant asserted were missing in the prior art (*e.g.*, EX-1002, 13:21-16:8, 6:16-17, 7:1-13, 9:9-15, 11:1-12, 11:24-28; EX-1007, 86-90, 25-49, 36-37), including the use of an “anycast” address to serve content from a content server nearby a user (Paper 1 at 20-23, 25-26). Even if Patent Owner contends Glines does not disclose “each” of its DNS servers 53 having an associated “plurality” of content servers 51, or its local DNS resolver 18 being a “server,” *compare* Paper 1 at 11-14, 19-23, Glines renders these features obvious, *see id.* Glines is highly relevant to the claims and it was material error for the Examiner not to find and thus overlook its disclosure. *See, e.g.*, *Microsoft*, IPR2025-00318, Paper 9 at 3.

Second, it was also a material error not to assert the teachings of Gupta and Colby, which the applicant disclosed in an Information Disclosure Statement to the Examiner during prosecution. Patent Owner acknowledges both were before the Office. *See, e.g.*, Paper 6 (Discretionary Denial Brief) at 8; *see also* EX-1007, 5, 393-394. Yet, it fails to address the error the Examiner committed by failing to

consider Gupta's or Colby's disclosures. For example, as explained in the Petition, Gupta teaches a "client DNS server 170" that performs the same functions as a DNS resolver. *See* Paper 1 at 23-25. And Colby teaches the claimed "switch." *Id.* at 68-69.

It was material error for the Examiner to allow the claims over the Applicant's amendment modifying the limitation "by a DNS server-associated with an Internet Service Provider (ISP)" to require resolution "by an Internet Service Provider (ISP) DNS server" (*see* EX-1007, 130-145), when Gupta teaches that very feature (*see, e.g.*, EX-1003, 6:1-9, 4:45-51, 5:65-6:9; EX-1007, 132; Paper 1 at 23-25). *See, e.g.*, *Tesla,* IPR2025-00152, Paper 11 at 2; *Yealink (USA) Network Tech. Co. v. Barco, N.V.*, IPR2025-00491, Paper 18, at 2-3 (P.T.A.B. June 25, 2025) (finding examiner erred when they did not consider that a claimed term was "well known in the art"); *Microsoft*, IPR2025-00318, Paper 9 at 3. In view of such "material error" during prosecution, referral to the Board for review is required.

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 13-19. 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 it expired. Any settled expectations favor referral.[1]

A. Patent Owner Fails to Demonstrate Google Purportedly Knew of the '112 Patent for "Nearly a Decade"

Patent Owner first contends it has a "settled expectation" because Google has purportedly "known about the '112 patent" for "nearly a decade." *See, e.g.*, Paper 6 at 14-17. But Patent Owner presents no evidence that Google was aware of

[1] The Director's application of "settled expectations" is improper. For example, retroactively applying "settled expectations" as a basis to deny Google's already-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 patentees lack an expectation that their patents will not be challenged. *See Celgene*, 931 F.3d at 1361-62; *see also* 5 U.S.C. § 706(2)(A).

the ’112 patent. *See id.* Patent Owner only identifies an application that would later become the ’112 patent and a parent application to the ’112 patent. *See id.* at 15-16 (citing U.S. Patent Appl. Publ. No. 2008/0235400 and No. 09/982,721). Citation of these applications during prosecution of Google applications does not put Google on notice of the ’112 patent.[2] Indeed, pending applications do not include a final set of claims with a right to exclude, much less a claim set that can be challenged in an *inter partes* review proceeding. Nor do all pending applications even result in issued patents, as the parent application to the ’112 patent shows: this application went abandoned and never issued. Patent Owner fails to establish that Google had any knowledge of the ’112 patent.

To suggest, as Patent Owner does, that knowledge of an issued patent flows from purported knowledge of related applications contradicts what district courts regularly find sufficient to establish knowledge of a patent-at-issue in the indirect infringement context in litigation. *See, e.g.*, *Software Rsch., Inc. v. Dynatrace LLC*, 316 F. Supp. 3d 1112, 1133 (N.D. Cal. 2018) (knowledge of “application does not provide notice of the resulting patent for indirect . . . infringement”). Patent Owner

[2] Nor would citation of the ’112 patent itself during prosecution meaningfully put a party on notice of the patent for indirect or willful infringement such that such a party reasonably would consider challenging the patent via *inter partes* review.

appears to concede this by not asserting pre-suit knowledge of the ’112 patent for any pre-suit allegations of indirect or willful infringement in the parties’ litigation. *See* EX-1040. Only now, to avoid an unpatentability challenge, does Patent Owner assert Google purportedly had knowledge of the ’112 patent before it was asserted in 2024.

Moreover, Patent Owner’s theory places an unreasonable expectation on all would-be petitioners. It is unreasonable to suggest that every potential petitioner must track all references (issued patents and pending applications) cited during prosecution of its own patents, when those patents and pending applications may not be relevant to a petitioner’s products, may never be asserted, and may never result in any issued rights. Yet that is precisely what Patent Owner’s theory wants to set as the standard. Such a requirement would be unworkable. For example, Google maintains an extensive and active patent prosecution docket, including roughly 26,800 issued U.S. utility patents and 6,200 pending U.S. utility applications. It is untenable to expect Google to investigate all references cited during its prosecution matters, analyze their claims (and potential claims), and the claims in any related family members that may not even be cited, and file pre-emptive challenges at the PTAB to preserve a right to the IPR process.

It is similarly 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.[3] It also runs contrary to the well-established practice that defendants may 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 '112 patent to be challenged in an IPR within one year of it serving its complaint, because that is precisely how these disputes have proceeded since the AIA took effect.

Requiring challenges prematurely also risks stripping would-be petitioners of standing for appeal following an IPR. Petitioners must have Article III standing to appeal adverse determinations. *See Argentum Pharms. LLC v. Novartis Pharms.*

---

[3] 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-1035, 3; EX-1036, 10.

Corp., 956 F.3d 1374, 1376-77 (Fed. Cir. 2020) (holding that petitioners must prove Article III standing to bring an appeal). Absent a litigation or an imminent threat of litigation between the parties, petitioners would be forced to forego any right to appeal and, in most instances, be saddled with the heavy consequences of estoppel should a patent owner decide to sue at some later point. *See id.* at 1378.

Finally, adopting Patent Owner's framework would result in an *increase* in PTAB workload—not Patent Owner's purported efficient regime (*see, e.g.*, Paper 6 at 14-17)—contrary to the Director's memorandum on discretionary denial. *See* EX-2012, 3. Forcing petitioners to seek review simply based on knowledge of a patent or application would balloon the number of challenges filed at the PTAB, including those without counterpart litigations, in turn increasing the number of disputes for the PTAB to resolve. This would result in wasted resources for both the PTAB and the parties, particularly for patents that may never be asserted by a patent owner.

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

Patent Owner's settled-expectations arguments also run afoul of governing IPR statutes. When Congress wanted to immunize patents of a certain age from any post-issuance challenges, it did so expressly. When designing the regime for *inter partes* reexamination, for example, Congress expressly immunized (that is,

carved out) "patents issued before 1999" from review. *See* H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011). Congress similarly 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).[4]

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,"[5] 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 (§ 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 arguments also run afoul of Board precedent. In *NHK Spring*, for example, the Board held that a ten-year delay in

---

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

[5] All emphasis added unless otherwise indicated.

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" 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-2012, 2. Here, the '112 patent was in force for no more than six years, as it issued in 2015 and *expired in 2021*. *See* EX-1001, cover. Patent Owner's assertion that the '112 patent "came into force more than a decade ago" is irrelevant. *See* Paper 6 at 13-17. The Director has referred challenges for patents that have been in force for six years.[6]

---

[6] 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

Berkshire Hathaway, IPR2025-00280, Paper 23, at 2-3 (referring petitions where patent was in force for six years). The same result is appropriate here.

C. That the '112 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, 13-15, 17-19. 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 the '112 patent before it was asserted against Google in 2024, a reasonable party would not expect a patent that expired in 2021 to be highly likely to be asserted in a litigation to preclude Google's challenge here.

The Board has also expressly rejected Patent Owner's "waste of resources" argument in similar circumstances. In *Inari Agriculture*, for example, the patent

---

(P.T.A.B. June 18, 2025); *Intel Corp. v. Proxense LLC*, IPR2025-00317, Paper 12 (P.T.A.B. June 26, 2025); *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025). *See, e.g.*, Paper 6 at 14, 16.

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 reasoned that 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 18. 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 '112 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 17, 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, 13-15, 17-19.

D. 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-1021, 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 '112 patent never asserted it against Google or any other party. The current Patent Owner acquired the patent only after it expired and filed suit in 2024. This "weighs against Patent Owner's claim of strong settled expectations." *See Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00531, Paper 10 at 3 (P.T.A.B. July 17, 2025) (that the challenged patent has never been "asserted, marked, licensed, or otherwise applied" in petitioner's "particular technology space" weighs against discretionary denial).[8] The delay of the '112 patent owners created settled expectations for

[8] There is also no evidence Patent Owner commercialized a product. *See Shenzen,* IPR2025-00531, Paper 10 at 3. At most, Patent Owner identifies the activity of its

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 20. 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 other aspects of the case have been paused, with the exception of the scheduled trial date. *Id.* Consistent with standard practice in the Central

---

predecessors, before Patent Owner came to own the patent in April 2024. *See* Paper 6 at 3-6. Patent Owner otherwise identifies individuals associated with these predecessors (Andrew Swart and David Farber), who are not named inventors of the '112 patent. *See, e.g.*, *id.*

[9] Regardless, Patent Owner only came into possession of the '112 patent in 2024. *See* EX-1041. Patent Owner cannot assert it had any settled expectation before its ownership. *See* Paper 6 at 1, 13, 17.

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 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 arguments[10] related to settled expectations do not relate to *Fintiv* Factor 1 and are without merit for the reasons discussed above. *See* Paper 6 at 20-21. 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 20. But as discussed above, the fact that the '112 patent was in force for only six 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 20. 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 20. 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 20-21. 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 21.

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* EX-2006, 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 21-22. 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-1028, 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 22. 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 "[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 22-23. But this contradicts Patent Owner's earlier admission that "the parallel district court case *is in its early stages*" (*id.* at 14), 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.* at 5. 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 23; 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-1029, 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 '112 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-1027.

Patent Owner's assertion that this stipulation is "nominal[]" (*see* Paper 6 at 23) 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 24. 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 24.

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. *See* EX-1037 at 18-25; EX-1038 at 14-22. There is no indication that Patent Owner will not assert the ’112 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 ’112 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, Glines is a near anticipatory prior art reference and the merits of the Petition are strong. Patent Owner's contrary arguments mischaracterize the prior art and ignore secondary references, such as Gupta, for features Patent Owner contends are purportedly missing in Glines. *See, e.g.*, Paper 6 at 25-38.

A. Glines and Gupta Disclose the Claimed ISP DNS Server

Patent Owner contends that "Petitioner . . . does not allege that Glines's 'local DNS resolver 18' performs any resolution" to satisfy the claimed "causing said hostname to be resolved to said common anycast address by an Internet Service Provider (ISP) DNS server." *See* Paper 6 at 26-28. Not so. That is precisely what Google alleged. *See, e.g.*, Paper 1 at 19-22.

Indeed, the Petition explained that Glines's "local *DNS resolver* 18"—which, by its own name, *resolves hostnames*—sends a request to a root DNS server 38 "programmed to . . . return the anycast address 50.100.20.1" of servers 53-1, 53-2, 53-3 "designated as being the authoritative name servers for 'example.com.'" Paper 1 at 21 (citing EX-1002, 14:4-15:4; *see also, e.g.*, *id.* at 7:1-7, 9:9-15). "The browser or local resolver can then 'send[] out a DNS request as a UDP datagram to [the] anycast message" to resolve content. *Id.* (citing EX-1002, 7:9-13, 6:16-17). Glines offers an example: a user, via a browser,

> makes a request to a DNS service to resolve the IP address of the domain name (e.g., "example.com") specified by the URL. This request is typically formulated as a message sent to a local address resolver. If the "example.com" domain is not located in a local domain, *the local resolver will then proceed to consult public name servers that have been defined as being authoritative for the "example.com" domain*. The root domain name servers defined, for example, by the Intenic, may be programmed to return the common address of the group of name server/content server peers that share a common anycast address.
>
> *Having now resolved an IP address* for an authoritative name server (e.g., the previously defined server group address returned) for the "example.com" domain, the browser or local resolver *then sends out a DNS request as a UDP datagram to an anycast message to the group*. This will now resolve the IP address of www.example.com.

EX-1002, 7:1-13.

As the Petition explains, this discussion discloses that Glines's local DNS resolver 18 "caus[es] said hostname to be resolved to said common anycast address by an Internet Service Provider (ISP) DNS server." *See* Paper 1 at 19-22. The local DNS resolver 18 does this by: (1) checking if the content is local, and if not local, consulting public name servers for where to retrieve the content, which satisfies the claims; or alternatively (2) sending a DNS request to an anycast message, which also satisfies the claims. Paper 1 at 19-23 (citing EX-1002, 6:16-17, 7:1-13, 9:9-15, 11:24-28, 13:21-15:4; EX-1008, ¶¶141-156).

To the extent Patent Owner asserts that Glines's local DNS resolver 18 must perform the functions disclosed by Glines's public name servers, this is wrong. *See* Paper 6 at 27-28. Glines's local DNS resolver 18 resolves content by consulting with public name servers, which discloses "resolving" a hostname, as claimed. *See* Paper 1 at 20-22 (citing EX-1002, 11:24-28, 13:24-15:4). Glines's local DNS resolver 18 sending out a DNS request as a UDP datagram as an anycast message to the group also satisfies this claim element. *See, e.g.*, EX-1002, 7:1-13, 6:16-17.

Even assuming Patent Owner's arguments that Glines's local DNS resolver 18 does not perform any resolving (it does) (*see, e.g.*, Paper 6 at 27-28), the claims *do not require* Glines's local DNS resolver to identify the common anycast address by itself. EX-1001, 8:63-9:17. The claims instead recite "*causing* said hostname to be resolved to said common anycast address" (*id.*), which is what Glines's local DNS resolver 18 does by "consult[ing] public name servers that have been defined as being authoritative for the 'example.com' domain" in response to a DNS request from a user. EX-1002, 7:1-13. Glines discloses this claim limitation when it causes resolution by consulting the public name servers and sending out a DNS request to the anycast address. *Id.*

Patent Owner next argues that "Petitioner does not explain how [modifying Glines's local DNS resolver 18 to be an 'ISP DNS server'] would satisfy the claim language." *See* Paper 6 at 27. In doing so, Patent Owner misunderstands Google's

analysis. Google explained that it would have been obvious to "implement and/or modify Glines's local resolver 18 to be an ISP DNS server," to the extent Glines does not expressly disclose that its local DNS resolver 18 is a server. Paper 1 at 22-23. Google explained, with support from Dr. Mowry and with other objective evidence, that "ISP-provided DNS servers are typically located in close proximity to a user's physical location, making them faster and more efficient than more distant DNS servers." *Id.* at 22 (citing EX-1008 ¶¶157-163; EX-1011, 128; EX-1013, 5:35-54). Patent Owner does not dispute Google's analysis on this point but instead repeats its argument that Glines's local DNS resolver 18 does not perform the claimed resolution. *See* Paper 6 at 27-28. As explained, Glines's local DNS resolver 18 performs the claimed resolution and renders obvious an ISP DNS server. *See* Paper 1 at 22-23.

Patent Owner similarly misunderstands Google's combination of Glines and Gupta on this point. *Id.* at 27-28 (arguing that the combination of Glines and Gupta "does not satisfy the claim language"). Google asserted "Gupta further discloses that 'client DNS server 170 is typically provided within ISP 60,'" and "Gupta further discloses that 'client DNS server 170 is typically used to resolve a host name into an IP address.'" Paper 1 at 23 (citing EX-1003, 6:1-9, Fig. 1). That "Petitioner does not rely on Glines's 'local DNS resolver 18' for performing the

resolution recited in element [1d]" is irrelevant (Paper 6 at 27-28)—again, Google relies on Gupta for its disclosure of an ISP DNS *server*.

Patent Owner's argument that "Glines relies on a fundamentally different architecture than Gupta" because Glines purportedly "functions as a cache" is incorrect. *See* Paper 6 at 28. Glines expressly discloses its local resolver 18 is a "local ***DNS*** resolver 18." *See* EX-1002, 11:24-28, 13:9-14:3, 15:11-19. So does Gupta. EX-1003, 5:65-6:9 ("ISP 60 is illustrated including users 150-160, and a client ***DNS*** server 170."). That Glines's local DNS resolver 18 may perform *additional steps*, such as first checking for local copies of requested content, does not undermine Glines' disclosure of causing resolution of a user's request to the common anycast address if no local copy is available. *See, e.g.*, EX-1002, 13:21-15:4. Nor does it disturb a combination of Glines and Gupta where Glines's local DNS resolver 18 is implemented as a server, as disclosed by Glines ISP 60. Paper 1 at 23-25; *see also* EX-1008, ¶¶164-169.

On this point, Google explained that "Gupta's ISP 60 . . . performs the same functions as Glines's local DNS resolver 18 (e.g., resolving a host name into an IP address)." Paper 1 at 24. Google further explained that, "[i]n view of Glines's teaching that local DNS resolver 18 is used 'where the user is associated with an Internet Service Provider (ISP),' a POSITA would have understood Gupta's ISP 60 to be an obvious substitute for Glines's local resolver 18." *Id.* (citing EX-1002,

13:24-27; EX-1008 ¶¶164-169). As such, the combination would have "ensure[d] compatibility with 'typical' Internet service architecture, and . . . achieve[d] the speed and efficiency associated with ISP-provided DNS servers." *Id.* (citing EX-1003, 4:45-51, 5:65-6:9; EX-1011, 128; EX-1013, 5:35-54; EX-1008 ¶¶164-169). There is nothing in Glines's or Gupta's architectures that prevents their combination as presented in the Petition.

Patent Owner provides no contrary testimony supporting its incompatibility contention, nor does it challenge the fact that checking for locally-stored content before consulting public name servers was common practice to improve efficiency in ISP DNS systems. Paper 6 at 28-29. Google provides such supporting evidence, including expert testimony. *See, e.g.*, Paper 1 at 19-25 (citing EX-1008 ¶¶141-169; EX-1011, 3-4, 128, 307; EX-1012, 229-230; EX-1013, 4:65-5:53; EX-1014, 128-129, 338-339). At bottom, Patent Owner's arguments amount to an improper attack on the references individually. *Palo Alto Networks, Inc. v. Centripetal Networks, LLC*, 122 F.4th 1378, 1386 (Fed. Cir. 2024) (individual attacks on prior art in insolation "lack merit" as "the Board must consider whether the particular combination argued by the Petitioner—modifying [Glines] by adding [Gupta's ISP server]—would meet the claim limitations at issue.").

B. The Petition Demonstrated Obviousness of the Claimed "Plurality of Content Providers" and "Switch"

Patent Owner incorrectly asserts that Google failed to demonstrate obviousness of a "plurality of content providers" in claims 13, 18, 22, and 23, and a "switch" in claims 13, 18, 19, 21, and 22. *See* Paper 6 at 29-35. The Director and Board need not reach these arguments to satisfy the threshold for institution, as the Petition demonstrates that claim 1 is unpatentable and these arguments relate to other claims. *See* 35 U.S.C. § 314(a); *SAS Inst., Inc. v. Iancu*, 584 U.S. at 365, 370-71 ("Director need not even consider any other claim before instituting review").

Regardless, Patent Owner asserts that Google "presents no theory as to how Glines's system is configured to serve a 'plurality of content providers.'" Paper 6 at 30. Not so. Google explained that a POSITA would have understood from Glines's disclosure that "providing content from an origin source *would have included* supporting more than one origin source (e.g., more than one website or content provider)." Paper 1 at 40 (citing EX-1002, 12:11-22, 13:21-14:3; EX-1008 ¶262) (emphasis added). Google also explained that adding origin servers and content providers to Glines's system "would have been nothing more than replicating Glines's teaching of storing and providing content associated with one origin server, with expected results." *Id.* (citing EX-1008 ¶263; *B/E Aerospace, Inc. v. C&D Zodiac, Inc.*, 962 F.3d 1373, 1380 (Fed. Cir. 2020)). Google therefore

addressed "a plurality of content providers," as claimed, and demonstrated the obviousness of claims 13, 18, 22, and 23. *See* Paper 1 at 39-46, 48-49, 52-58.

According to Patent Owner, however, Glines's disclosure of multiple "providers" refers to "network providers," not "content providers." *See* Paper 6 at 31-32. First, Glines's disclosure does not state its "providers" are "network providers." *See* EX-1002, 17:8-9. Second, Patent Owner fails to explain the distinction or cite supporting evidence (including expert testimony) demonstrating that a "network provider" cannot also be a "content provider." *See* Paper 6 at 31-32. Glines's disclosure of "multiple providers" discloses or renders obvious "a plurality of content providers," as Google asserted. *See* Paper 1 at 39-41.

Indeed, the Petition cited the testimony of Dr. Mowry, who explained what a POSITA would have understood from Glines's disclosures. *See id.* at 40 (citing EX-1002, 12:11-22, 13:21-14:3; EX-1008 ¶262). For example, Glines provides Internet content to users and a POSITA would have understood that Glines's system would have supported content from "more than one origin source (e.g., more than one website or content provider)." *Id.* (citing EX-1002, 12:11-22, 13:21-14:3; EX-1008 ¶262). The Petition also explained that it would have been obvious to implement or modify Glines to do so to the extent not already expressly disclosed: "[a]dding origin servers and content providers to Glines's system, as expressly contemplated in Glines, would have been nothing more than replicating

Glines's teaching of storing and providing content associated with one origin server, with expected results." *Id.*; EX-1008 ¶263. A POSITA would have been motivated to do so because it "would have enabled Glines's system to support more (and different) content to fulfill user requests." Paper 1 at 40; EX-1008 ¶263. This establishes obviousness based on Glines.

Separate from Glines, Google also cited Gupta's express disclosure of multiple content providers and asserted that it would have been obvious to apply these teachings to Glines's system. *See* Paper 1 at 40-41. Patent Owner does not address these teachings or provide reasons why the combination does not satisfy claims 13, 18, 22, and 23. Paper 6 at 29-34. The claims would have alternatively been obvious based upon Glines and Gupta. Paper 1 at 40-41.

For the claimed "switch" in claims 13, 18, 19, 21, and 22, Patent Owner isolates Glines's teachings without reaching the disclosure of a "switch" in Colby (e.g., Grounds 4A, 4B, 5A, 5B). *See id.* at 34-35. Patent Owner therefore does not dispute that Colby teaches a "switch" for claims 11, 13, 18, 19, 21, and 22, and this claim feature would have been obvious based upon the combination of Glines and Colby. *See, e.g.*, *id.* Regardless, Glines likewise discloses a switch by disclosing a "Layer 4 switch," which a POSITA would have understood to be the claimed "switch" to select a content server from which to serve requested content. *See* Paper 1 at 38-39 (claims 10 and 11), 41-42 (claim 13 referring to analysis of claim

11), 48-49 (claim 18 referring to analysis of claim 11), 50 (same for claim 19), 51-52 (same for claim 21), 53-54 (same for claim 22).

Patent Owner mischaracterizes Glines by asserting that its disclosure of load-balancing techniques using a Layer 4 switch is accomplished by "returning multiple local IP addresses to a name lookup." *See* Paper 6 at 35. What Glines discloses is load balancing *and* replication, not just replication: "within the service group [of content servers], standard load balancing *and* replication techniques can also apply, such as multiple content servers . . . , *layer 4 switches*, etc." EX-1002, 19:13-22. This discloses selecting the content server by at least one switch: "Glines's switch is used for the load balancing that determines which content server should be selected." Paper 1 at 38-39 (citing EX-1008 ¶¶247-253). Dr. Mowry further explained that "Glines's applying 'standard load balancing' techniques within a service group, including use of 'layer 4 switches,' discloses or at least renders obvious using a Layer 4 switch to load balance across the content servers in the service group." EX-1008 ¶252; Paper 1 at 38-39. Google accordingly demonstrated the obviousness of the claimed "switch" based on Glines's disclosure or based on the combination of Glines and Colby.

C. The Petition Sufficiently Explained Why It Would Have Been Obvious to Combine Glines and Gupta

Patent Owner additionally argues that the Petition fails to explain why a POSITA would have combined Glines with Gupta. Paper 6 at 35-38. In doing so, Patent Owner focuses on one section of the Petition in isolation and not on the rationales for combining Glines and Gupta provided in the element-by-element analysis. *Compare id.*, *with* Paper 1 at 14-16 (explaining why it would have been obvious to combine Gupta's "multiple WebCache servers" with Glines to arrive at a "plurality" of content servers), 23-25 (explaining why it would have been obvious to combine Gupta's ISP 60 with Glines to arrive at an "(ISP) DNS server").

The Petition first explained that Glines and Gupta were compatible and analogous art by identifying similarities between the two and explaining what the combined system would have been. *See* Paper 1 at 7-8 (citing EX-1008 ¶¶68-74). Then, when describing the combination of Gupta's teachings with Glines in the element-by-element mappings, Google provided reasons why a POSITA would have been motivated to combine Glines and Gupta to arrive at those claim features. *See id.* at 14-16 (explaining why a POSITA would have modified Glines in view of Gupta to arrive at "a plurality" of content servers), 23-25 (explaining why a POSITA would have modified Glines in view of Gupta to arrive at an "ISP DNS

server"); *id.* at 24-25 (explaining "[a] POSITA would have been motivated to make the modification to ensure compatibility with 'typical' Internet service architecture, and to achieve the speed and efficiency associated with ISP-provided DNS servers" (citing EX-1003, 4:45-51, 5:65-6:9; EX-1011, 128; EX-1013, 5:35-54; EX-1008 ¶¶164-169)).

Google adequately explained why a POSITA would have combined Glines and Gupta, and not just that a POSITA "could" have, as Patent Owner contends. *See* Paper 6 at 35-38. Patent Owner ignores these proffered reasons and its citation to *Virtek Vision International ULC v. Assembly Guidance Systems, Inc.*, 97 F.4th 882 (Fed. Cir. 2024) is therefore inapposite. *See* Paper 6 at 36-37.

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 39. For example, Petitioner does not rely "solely on its expert to support 'substitut[ing] an ISP DNS server for Glines's local resolver 18,'" as Patent Owner contends. *Id.* at 39-40. Rather, the Petition submits that Glines renders this feature obvious based on its own disclosures, and that Gupta alternatively teaches this feature expressly. *See* Section V.A. There is nothing improper about this mapping. 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* Paper 6 at 39-40. 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.").

With respect to Glines's local DNS resolver 18 (*see* Paper 6 at 39-40), the Petition cites to Dr. Mowry's declaration to explain how a POSITA would have understood Glines's teachings:

> A POSITA would have understood that residential users' Internet access is usually provided by an Internet service provider (ISP). With an ISP, users typically access the internet through an ISP's DNS server. A POSITA would have accordingly understood that when Glines describes the browser of a 'user associated with an Internet Service Provider' interacting with local DNS resolver 18, local DNS resolver 18 is an ISP DNS server, as claimed.

Paper 1 at 19-23 (citing EX-1008 ¶¶147-156; EX-1011, 3-4, 128, 307; EX-1012, 229-230; EX-1013, 4:65-5:53; EX-1014, 128-129, 338-339). The Petition then explains this understanding is consistent with the '112 patent, "which describes a

"local DNS server 70a," or an "end user DNS 70a" but does not discuss a separate "ISP DNS server." *Id.* (citing EX-1001, 4:56-5:31, 6:65-7:32, Fig. 5). The Petition alternatively explains that it would have been obvious to modify Glines's local DNS resolver 18 to be an ISP DNS server, to the extent Glines does not expressly teach that its local DNS resolver 18 is a "server." *See id.* at 22-23 (citing EX-1008 ¶¶157-163; EX-1011, 128; EX-1013, 5:35-54; EX-1014, 128-129); *see* Section V.A. This is entirely proper. *See Philips*, 948 F.3d at 1337.

Separate from Glines—and ignored by Patent Owner—Google also asserted that it would have been obvious to implement Glines's local resolver as Gupta's Internet Service Provider (ISP) cluster 60, which includes a client DNS server 170. Paper 1 at 23-25. This expressly discloses an ISP DNS server, and there is no allegation of any purported "gap-filling" with respect to this parallel ground covering the same claims as Glines alone. *See* Paper 6 at 39-40. Patent Owner's reference to "similar statements" in other parts of the Petition to purportedly fill gaps is undeveloped. *See id.* at 40. Google does not rely on expert testimony to fill gaps in the Petition.

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 40. 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 Glines 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 "*more than 200 times*, rather than providing a focused expert declaration addressing the limitations for which expert testimony is necessary." Paper 6 at 39 (emphasis in original). 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 38-40, *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 Voluminous, Excessive, or Based on "Indeterminate Prior Art"

Patent Owner argues that the Petition presents "excessive alternative grounds" by virtue of reciting "and/or" and "with or without" in its analysis of the prior art. *See* Paper 6 at 40-46. Not so. The Petition identifies the proposed grounds with particularity, as required by 35 U.S.C. § 312(a)(3). Specifically, Google presents the following grounds in its Petition:

III. RELIEF REQUESTED

Ground	Art	Basis	Claims
1A	Glines	§103	1-8, 10-23
1B	Glines-Gupta	§103	1-8, 10-23
2A	Glines-Chung	§103	4
2B	Glines-Gupta-Chung	§103	4
3A	Glines-Chiou	§103	7-9, 19-20
3B	Glines-Gupta-Chiou	§103	7-9, 19-20
4A	Glines-Colby	§103	10-22
4B	Glines-Gupta-Colby	§103	10-22
5A	Glines-Chiou-Colby	§103	19-20
5B	Glines-Gupta-Chiou-Colby	§103	19-20

Paper 1 at 1.

Where the Petition includes "and/or" and "with or without" in its mappings for those grounds (i.e., in its analysis sections), that language references the above grounds and addresses them in one place for the convenience of the Board, given the overlap of the issues. *See, e.g.*, *id.* at 64 (stating "Glines, alone or combined with Gupta and/or Chiou, discloses claim 7" when referring to Grounds 1A, 1B, 3A, 3B), 67 (stating that "Glines, alone or combined with Gupta and/or Chiou, discloses claim 19" when referring to Grounds 1A, 1B, 3A, 3B). Patent Owner's criticism of Google's analysis goes to the merits, not to any purported confusion as to which grounds are asserted in the Petition.

To that end, Patent Owner's reliance on *Adaptics* is misplaced. *See* Paper 6 at 41 (citing *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019)). There, the petitioner presented the following grounds:

Reference(s)	Statutory Basis
Bendel	35 U.S.C. § 102
Sartorius	35 U.S.C. § 102
Williams in view of Bendel, Sartorius, Mettler, Digi-Star, Yuyama and/or Wright[6]	35 U.S.C. § 103
Turnage in view of Bendel, Sartorius, Williams, Digi-Star, Yuyama, Mettler, and/or Wright	35 U.S.C. § 103
Bendel or Sartorius in view of Williams, Turnage, Abrams, or Bordin, and in further view of each other, Mettler, Digi-Star, Yuyama and/or Wright[7]	35 U.S.C. § 103

Adaptics, IPR2018-01596, Paper 20, at 8-9 (annotated). The Board found that the alternative "and/or" in the listed grounds resulted in "voluminous and excessive grounds." *Id.* at 20-21. For example, the ground "Williams in view of Bendel, Sartorius, Mettler, Digi-Star, Yuyama, and/or Wright" could comprise Williams and Bendel; Williams and Sartorius; Williams and Mettler; Williams and Digi-Star, Yuyama; Williams and Wright; Williams, Bendel, and Sartorius; among others. *See id.* at 18-19. The discrete grounds presented here, in contrast—which are broken out separately in the Petition's "Relief Requested" section without conjunctions—do not present the same concern. Paper 1 at 1.

Patent Owner separately contends that Google improperly relied upon "additional documents" for claim 23 that are purportedly "outside of its specified grounds." *See* Paper 6 at 44-46. This argument should also be rejected. As an initial matter, Patent Owner's assertion only applies to claim 23. Even if Patent Owner's argument carries any weight (it does not), it does not warrant denying institution of the Petition.

Nevertheless, claim 23 specifies particular "content" to be resolved and Google properly identified evidence supporting Dr. Mowry's testimony that Glines and alternatively Glines and Gupta renders this feature obvious "based on Internet content as of the priority date." Paper 1 at 54; EX-1008 ¶¶446-448. The systems in Glines and Glines and Gupta—mapped for claims 1 and 13—apply with equal

force to claim 23, but for specific "content." Google explained in detail that claim 23 would have been obvious to a POSITA at the time in view of these references and known content available over the Internet at the time. *See* Paper 1 at 54-55. As the Petition explains, applying Glines and Glines and Gupta in this manner "would have been nothing more than applying the art in understood ways to resolve particular content and combining known prior art techniques with predictable results." *See id.* at 55 (citing EX-1008 ¶¶451-453). The materials Dr. Mowry cites support that; they are not "documents not included in Petitioner's specified ground." *See* Paper 6 at 44.

Google's reliance on a POSITA's knowledge is proper. *Fleming v. Cirrus Design Corp.*, 28 F.4th 1214, 1223 (Fed. Cir. 2022) (affirming the Board's obviousness conclusion where, although the two asserted references did not teach certain "autopilot operations," "it was well known that aircraft autopilots are programmable to perform certain actions," and stating "it is appropriate to consider the knowledge . . . of a skilled artisan in an obviousness determination"); *see also Philips*, 948 F.3d at 1337 (disagreeing with the patent owner's assertion that § 311(b) "prohibits use of general knowledge to supply a missing claim limitation in an inter partes review," and stating that "[r]egardless of the tribunal, the inquiry 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 contrary argument should be rejected.

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 "*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 46-47. 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-1039, 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." EX-1039, 39-40. 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-1030; *see also* EX-1031 (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-1032.

On the other hand, Patent Owner is a holding company formed within the last two years. *See* EX-1034. 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 ’112 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 ’112 patent is not presently asserted against other litigants, institution and a finding of unpatentability would prevent the Patent Owner from unjustifiably asserting the ’112 patent against others in the future.

[11] In 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 No. 2:24-cv-00886 (E.D. Tex.).

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

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 **Petitioners' Opposition to Patent Owner's Request for Discretionary Denial of Institution** as measured by Microsoft Word is 11,250 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 **Petitioners' 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

Steven M. Pappas
spappas-PTAB@sternekessler.com

Ethan Goldschen
egoldschen-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