

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
U.S. Patent No. 9,021,112

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S BRIEF ON DISCRETIONARY DENIAL**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Owner submits this Reply pursuant to the Board's authorization email sent August 22, 2025. EX3101.

I. PETITIONER'S OPPOSITION IDENTIFIES DISAGREEMENT WITH—NOT MATERIAL ERROR IN—THE OFFICE'S THOROUGH EXAMINATION OF THE '112 PATENT CLAIMS.

Petitioner alleges that the Examiner committed material error during prosecution because the Examiner did not apply the references that Petitioner presents in any rejection. Opp. at 4-6. That Petitioner would have examined the application differently and applied different rejections, however, does not establish material error in the examination of the '112 patent. *See Regeneron Pharms., Inc. v. Kymab Ltd.*, IPR2020-00389, Paper 7 at 14-15 (P.T.A.B. May 26, 2020) (petitioner only offered “a different interpretation” of prior art, which is not material error); *Sony Interactive Ent. LLC v. Terminal Realty, Inc.*, IPR2020-00711, Paper 15 at 11 (P.T.A.B. Oct. 13, 2020) (finding that Petitioner's argument that the asserted references were not evaluated by the Examiner failed to sufficiently identify Examiner error). Even if it did, Petitioner's assertion that “referral to the Board for review is required,” Opp. at 6, is misplaced.

It is always the case that a Petition offers a different interpretation of the prior art or finds a reference that was not expressly considered during prosecution. If that were sufficient to preclude discretionary denial under 35 U.S.C. § 325(d), then the statute and the Board's precedent would be meaningless. If an alleged

material error in prosecution were sufficient to preclude discretionary denial entirely, e.g., as a gating function—as Petitioner asserts here—it would first invert the *Advanced Bionics* framework (requiring Patent Owner to show no material error) and then elevate material error to a dispositive gating function for denial, rather than treating material error as *one* equal factor among many to consider for denial. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).

Moreover, unlike the cases cited by Petitioner, Opp. at 3-4, PO never raised § 325(d) arguments in its briefing. The Board’s precedent establishes that material error may combat discretionary denial under § 325(d) based on art or arguments previously presented to the office—it does not provide that material error acts as an affirmative reason to institute review despite other discretionary factors, especially where § 325(d) was not raised in the first place. *Advanced Bionics*, Paper 6 at 8-9.

Nevertheless, Petitioner fails to show any material error in the Office’s previous examination. Petitioner asserts that “Glines is a nearly anticipatory reference that discloses the two DNS resolutions the Applicant asserted were missing in the prior art.” Opp. at 5. But, as PO explained, Glines fails to disclose *multiple* limitations of the independent claims. DD Br. at 25-35; POPR at 16-28. As one example, Petitioner’s mapping of Glines’s “local DNS resolver” to the claimed “Internet Service Provider (ISP) DNS server” fails to meet the language of

claim 1. DD Br. at 26-27. In response, Petitioner mischaracterizes the claim language, alleging that the claims merely “recite ‘*causing* said hostname to be resolved to said common anycast address’ ..., which is what Glines’s local DNS resolver 18 does by ‘consult[ing] public name servers...’.” Opp. at 29 (citing EX1002, 7:1-13). But claim 1 requires “causing said hostname *to be resolved* to said common anycast address *by an Internet Service Provider (ISP) DNS server*”—which Petitioner conveniently omits and fails to show in Glines. EX1001, 9:11-13 (emphasis added); DD Br. at 26-27. Accordingly, even had the Examiner thoroughly considered Glines, the Examiner would have found multiple claim limitations missing. DD Br. at 25-35; POPR at 16-28.

Further, the Examiner did not materially err by choosing not to apply Gupta or Colby in a rejection. Neither reference is even alleged to render obvious any claim without being combined with Glines, Pet. at 1, which a skilled artisan would not have done based on Glines’s fundamentally different architecture. DD Br. at 27-29, 35-38; POPR at 20-21, 28-33. Petitioner’s argument is a mere disagreement, not a material error. *Advanced Bionics*, Paper 6 at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, *it cannot be said that the Office erred in a manner material to patentability.*”).

At bottom, Petitioner contends that the Office materially erred by failing to issue rejections of the claims that mirror the Grounds in the Petition, and that

alleged failure necessarily outweighs *all* other reasons the Patent Owner and the Office have argued showing that discretionarily denial is appropriate here.

Unsurprisingly, the Office has repeatedly rejected that sentiment in discretionarily denying Petitions. *Regeneron*, Paper 7 at 14-15; *Sony*, Paper 15 at 11. It should do so here as well.

II. PETITIONER MISCHARACTERIZES THE BOARD'S TREATMENT OF SETTLED EXPECTATIONS IN DENYING INSTITUTION.

The Acting Director's treatment of "settled expectations" favors discretionary denial here. *See* DD Br. at 14-19. Petitioner cites *Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00226, Paper 8 at 2 (P.T.A.B. June 12, 2025) for the proposition that a petitioner reasonably expects non-enforcement of an expired patent. Opp. at 14. That is a mischaracterization of the facts and holding of *Globus*. The key fact in *Globus* is that the patent expired early due to Patent Owner's active-step of failing to pay the maintenance fee. *Globus*, IPR2025-00226, Paper 8 at 2. It was the Patent Owner's public notice of failure to pay the maintenance fee that gave rise to the settled expectation that the patent would not be enforced, as Petitioner reasonably believed that Patent Owner no longer had interest in the patent it abandoned four years prior. *Id.*

Here, the patent expired after having been in force for its full life. That is the same situation as *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408,

Paper 21 (P.T.A.B. June 18, 2025), and *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 (P.T.A.B. June 26, 2025). Accordingly, the settled expectations at issue in *Globus* are *not* more analogous to the present case than those in *Dabico* and *Intel*. *Contra* Opp. at 13-14 n.6. Petitioner states in a footnote that *Dabico* and *Intel* are distinguishable but provides no explanation for how or why. *See* Opp. at 13-14 n.6. They are not.

Petitioner's other arguments against settled expectations appear to take issue with the Acting Director's consideration of settled expectations generally, rather than presenting any particular reason that those expectations here are different than in other cases where the challenged patent has been in force for many years. *See* Opp. at 9-10 (calling it "unreasonable" to deny *inter partes* review of patents asserted in litigation based on how long the patent has been in force—despite the Acting Director having done so multiple times now); *see also Caihong Display Devices Co. Ltd. v. Corning, Inc.*, IPR2025-00439, Paper 18 (P.T.A.B. July 10, 2025) (denying institution based on the timeline of a co-pending litigation and the age of the patent).

In the end, the facts were different in *Globus* than here because of a purposely unpaid maintenance fee. The facts here are the same as in every other instance where institution was denied based on the age and expiration of the patent. Settled expectations therefore favors discretionary denial here.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason Eisenberg, Reg. No. 43,447
Daniel S. Block (Reg. No. 68,395)
Kristina Caggiano Kelly (Reg. No. 58,164)
Steven M. Pappas (Reg. No. 73,904)
Counsel for Patent Owner

Date: August 26, 2025

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S REPLY TO
PETITIONER'S OPPOSITION TO PATENT OWNER'S BRIEF ON
DISCRETIONARY DENIAL** was served in its entirety on August 26, 2025,
upon the following parties via electronic mail:

Erika H. Arner (Lead Counsel)	erika.arner@finnegan.com
Kara A. Specht (Back-Up Counsel)	kara.specht@finnegan.com
Cara E. Regan (Back-Up Counsel)	cara.regan@finnegan.com
Sydney R. Kestle (Back-Up Counsel)	sydney.kestle@finnegan.com
William C. Neer (Back-up Counsel)	william.neer@finnegan.com
Daniel C. Tucker (Back-Up Counsel)	daniel.tucker@finnegan.com
Alexander M. Boyer (Back-Up Counsel)	alexander.boyer@finnegan.com
	Google-Sandpiper-IPRs@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP	

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg
Registration No. 43,447
Counsel for Patent Owner

Date: August 26, 2025

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600