

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

REQUEST FOR DIRECTOR REVIEW

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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The Discretionary Denial decision found that settled expectations weighed in favor of referral to merits panel review because the challenged patents were expired. Paper 14 at 2. The decision is a clear outlier among discretionary denial decisions and expressly contradicts the Office’s otherwise consistent decision-making regarding settled expectations and how they inform referral or denial decisions. As such, the decision calls into question the integrity and credibility of the discretionary denial process and the Patent Office as a whole. For an institution decision—even a discretionary one—to find that indistinguishable facts (patent expiration) lead to a polar-opposite result (declining discretionary denial) based on the same purported criterion (settled expectations) as other cases is the definition of an arbitrary and capricious opinion. It should not stand. Director Review is required.

I. The Office has consistently found that settled expectations favor denial of institution where the patent is expired.

The Office has explained that when a patent has been in force for a long time, the settled expectations of the parties and the public favor discretionarily denying institution of *inter partes* review. *See, e.g., Omnivision v. RE Secured Networks*, IPR2025-01019, Paper 14 (PTAB Oct. 10, 2025) (“In particular, the challenged patent has been in force for approximately twenty years and is now expired, creating strong settled expectations for Patent Owner.”); *see also SAP America, Inc. v. Valtrus Innovations Ltd.*, IPR2025-00415 (Paper 10), IPR2025-

00417 (Paper 9), IPR2025-00418 (Paper 10), IPR2025-00420 (Paper 11) at 3 (PTAB July 10, 2025) (“*SAP America*”) (“[T]he challenged patents . . . have been in force for approximately 20 years, creating strong settled expectations, and Petitioner does not provide any persuasive reasoning why an inter partes review is an appropriate use of Board resources.”) (citing *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2-3 (PTAB June 18, 2025)). The patents at issue in *SAP America* expired in 2021 and 2022. Nonetheless, the Office made clear that the passage of the 20-year life of the patents favored discretionary denial, and review would not be an efficient use of the Board’s resources. *Id.*

Since *SAP America*, the Office has consistently found that the “settled expectations” of the parties favors discretionary denial due to the age of the patent ***where the patent is expired***. See, e.g., *Samsung Elecs. Co. Ltd. v. Mobile Data Techs., LLC*, IPR2025-00535 (Paper 16), IPR2025-00536 (Paper 13) (denying review of U.S. Patent No. 9,032,039, which expired June 18, 2023, based on settled expectations) (PTAB July 10, 2025); *Carvana, LLC v. Int’l Business Machines Corp.*, IPR2025-00564, Paper 11 (PTAB July 10, 2025) (denying review of U.S. Patent No. 7,702,719, which expired July 10, 2022, based on settled expectations); *Samsung Elecs. Co., Ltd. v. Keyless Licensing LLC*, IPR2025-00528 (Paper 13), IPR2025-00529 (Paper 13) (denying review of U.S. Patent No. 11,503,144, which expired May 19, 2025, based on settled expectations) (PTAB

July 17, 2025); *Murata Manufacturing Co., Ltd. v. Georgia Tech Research Corp.*, IPR2025-00383 (Paper 14), IPR2025-00384 (Paper 13) (denying review of U.S. Patent No. 7,489,914, which expired July 27, 2024, based on settled expectations) (PTAB July 29, 2025); *T-Mobile USA, Inc. v. Smart RF Inc.*, IPR2025-00727, Paper 13 (denying review of U.S. Patent No. 7,035,345, which expired August 14, 2023, based on settled expectations) (PTAB July 29, 2025); *Vertiv Corp. v. Valtrus Innovations Ltd.*, IPR2025-00667 (Paper 11) (denying review of U.S. Patent No. 6,854,287, which expired August 2, 2022, based on settled expectations), IPR2025-00668 (Paper 10) (denying review of U.S. Patent No. 6,718,277, which expired April 17, 2022, based on settled expectations), IPR2025-00669 (Paper 11) (denying review of U.S. Patent No. 6,862,179, which expired April 15, 2023, based on settled expectations) (PTAB July 31, 2025); *Dentsply Sirona Inc. v. Osseo Imaging, LLC*, IPR2025-00771 (Paper 8) (denying review of U.S. Patent No. 6,381,301, which expired 2019, based on settled expectations), IPR2025-00772 (Paper 8) (denying review of U.S. Patent No. 6,944,262, which expired August 9, 2020, based on settled expectations), IPR2025-00787 (Paper 8) (denying review of U.S. Patent No. 8,498,374, which expired December 1, 2019, based on settled expectations) (PTAB July 31, 2025); *Samsung Elecs. Co., Ltd. v. Mobile Data Techs., LLC*, IPR2025-00537 (Paper 15) (PTAB August 14, 2025), IPR2025-00538 (Paper 15) (PTAB August 14, 2025) (denying review of U.S. Patent No.

8,825,801, which expired June 18, 2023, based on settled expectations), IPR2025-00539 (Paper 15) (PTAB August 14, 2025), IPR2025-00540 (Paper 15) (PTAB August 14, 2025) (denying review of U.S. Patent No. 8,793,336, which expired August 12, 2024, based on settled expectations), IPR2025-00541 (Paper 15) (PTAB August 14, 2025), IPR2025-00542 (Paper 15) (PTAB August 14, 2025) (denying review of U.S. Patent No. 9,922,348, which expired August 12, 2024, based on settled expectations), IPR2025-00543 (Paper 15) (PTAB August 14, 2025), IPR2025-00544 (Paper 15) (PTAB August 14, 2025) (denying review of U.S. Patent No. 9,619,578, which expired April 28, 2024, based on settled expectations); *Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00642, Paper 11 (PTAB August 14, 2025) (denying review of U.S. Patent No. 8,403,219, which expired February 22, 2025, based on settled expectations); *Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00643, Paper 11 (PTAB August 14, 2025) (denying review of U.S. Patent No. 9,202,156, which expired February 22, 2025, based on settled expectations); *Microsoft Corp. v. Dialect, LLC*, IPR2025-00657, Paper 12 (PTAB August 14, 2025) (denying review of U.S. Patent No. 9,263,039, which expired August 5, 2025, based on settled expectations); *Datadome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 (PTAB August 14, 2025) (denying review of U.S. Patent No. 7,373,510, which expired September 23, 2024, based on settled expectations).

The directly contradictory decision here is a clear outlier from this otherwise uniform treatment. Specifically, the referral decision here expressly found the expiration of the challenged patents as creating settled expectations in favor of Petitioner. Even worse, the Office's consistent finding that settled expectations favors discretionary denial of expired patents includes IPRs where Google—Petitioner here—was a party. *See Google LLC v. Mullen Industries LLC*, IPR2025-00227, Paper 13 (PTAB June 25, 2025) (denying review of U.S. Patent No. 9,635,540, which expired March 25, 2023, based on settled expectations). Accordingly, even apart from the general settled expectations that all parties have where a patent has been in force for 20 years, the Petitioner here has been found to have a settled expectation concerning an expired patent that counseled in favor of discretionary denial. *Id.* There is no basis to allege that Petitioner Google had a different settled expectation regarding Sandpiper's expired patents than it did regarding Mullen's expired patent.

In its opposition to Patent Owner's discretionary denial brief, Petitioner suggested that the expiration of the challenged patents gave rise to the expectation that the patents would not be enforced. *See* Paper 14 at 2. The Office appeared to accept that argument, *id.*, which was a clear error in view of *SAP America, Google v. Mullen*, and countless decisions that have found otherwise. Furthermore, 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. The Office has even specifically stated that a petitioner cannot defeat settled expectations based on an argument that the patent was not previously asserted. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (PTAB July 31, 2025). Moreover, Petitioner's alleged subjective expectation is baseless, considering approximately 22% of patent infringement litigation asserts patents that are expired at the time the Complaint is filed. *See Docket Navigator*¹, in view of *Derwent Innovation* (search of complaints filed between 2020 and 2025 showing that 4,692 of 21,528 patent cases asserted at least one expired patent). The assertion of expired patents in suits for past damages is common and therefore reasonably expected.

The Decision cites two seeming exceptions to the Office's otherwise consistent treatment of settled expectations: *Globus Medical, Inc. v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 (PTAB June 12, 2025) and *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3 (Director Sept. 5, 2025). *See* Paper 14 at 2 n.3. Those decisions are not informative here. *Globus* found that Petitioner's "settled expectations" favored referral to the merits panel because the challenged patent expired early for failure to pay maintenance fees. *See Globus*, IPR2025-00225, Paper 8. That affirmative act on the part of the patent owner is a fact that does not apply here. Similarly, *Apple* noted that "Patent Owner did not assert the

¹ Available at <https://search.docketnavigator.com/patent/analytics>.

challenged patents against Petitioner until after they expired,” in the context of finding that the patent owner previously assured the petitioner that it would not assert the challenged patent 11 years prior to finally doing so. *Apple*, IPR2025-00856, Paper 11 at 3. Once again, the dispositive fact was an affirmative act by the patent owner not applicable here.²

Settled expectations therefore favors discretionary denial in this case, just as it has every other time the Office has considered discretionary denial of an expired patent under the current bifurcated framework. The Director should reverse the Decision and decline institution.

II. Settled expectations outweigh Fintiv and other considerations, including a district court stay.

The Decision not to discretionarily deny the Petition here emphasized the *Fintiv* factors, and Petitioner’s perceived likelihood of a stay in the co-pending district court litigation. *See* Paper 14 at 2. As a preliminary matter, the Decision

² The Decision also footnotes that Patent Owner did not acquire the challenged patents until after they expired. *See* Paper 14 at 2 n.3. It is not clear whether the Decision considered this fact probative. Either way, the fact that the patents were recently acquired should give rise to the expectation that they would be asserted, because the purchase of an intellectual property asset implies that the purchaser intends to receive a return on investment through enforcement.

mischaracterized the record regarding the placement of a stay. The district court has *not* granted a stay of this proceeding; rather, it merely issued a short “pause” to allow the PTAB to conduct its discretionary analysis “while at the same time preserve the trial date in [the district court] case.” EX2006, 4-5. The Court specifically stated it “does not want to put a thumb on the scale” of the PTAB’s decision. *Id.* As the district court order makes clear, all deadlines in the three months leading up to trial remain unchanged and the close of expert discovery is only delayed by a month. EX2006, 5. Accordingly, not only does the decision use the “short pause” order to put far more than a mere thumb on the scale (against the district court’s intentions), it does so based on a misapprehension of the actual district court timeline.

Moreover, even if there were a stay in place, the decision to weigh that fact over the settled expectations arising from the age of the patents directly conflicts with the clear and consistent analysis that has otherwise characterized discretionary denial decisions since the advent of the bifurcated process. *See* Section I, *supra* (listing cases). Director Review is required to correct this arbitrary departure.

Not only has the Office’s other discretionary decisions clearly and consistently found settled expectations to favor discretionary denial of an expired patent, but it has found those settled expectations to be one of the most heavily weighed factors against institution, outweighing other factors that favor referral to

a merits panel. *See iRhythm Techs., Inc. v Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025) (denying institution based on “settled expectations” despite other factors weighing in favor of institution); *Amgen Inc. v. Bristol-Meyers Squibb Co.*, IPR2025-00601, Paper 9 (PTAB July 24, 2025) (denying institution based on “settled expectations” for patent in force six years without parallel litigation); *Oneplus Tech. Co., Ltd. v. Pantech Corp.*, IPR2025-00783, Paper 12 (PTAB Sept. 12, 2025) (finding that the lack of a trial date in co-pending litigation was outweighed by settled expectations for a nine-year-old patent); *Belden Inc. v. Commscope, Inc.*, IPR2025-00833, Paper 13 (PTAB Sept. 12, 2025) (finding that settled expectations for a nine-year-old patent outweighed *Fintiv* where the Final Written Decision was projected six months before the scheduled trial date); *Samsung Elecs. Co. Ltd. v. VB Assets, LLC*, IPR2025-00866, Paper 13; IPR2025-00867 (Paper 13), IPR2025-00868 (Paper 13), IPR2025-00869 (Paper 13) (PTAB Sept. 12, 2025) (finding settled expectations for a ten-year-old patent justified denial where *Fintiv* factors were neutral); *Volkswagon Group of America, Inc. v. Longhorn Automotive Group LLC*, IPR2025-00925, Paper 9 (PTAB Sept. 12, 2025) (finding settled expectations for a 13-year-old patent outweighed neutral *Fintiv* factors and allegations of examiner error).

Even more on-point for this Petition, the Office’s decisions have repeatedly and specifically held that settled expectations for an old patent outweigh the *Fintiv*

factors in the event of a district court stay. *See OnePlus Tech. Co., Ltd. v. Pantech Corp.*, IPR2025-00720, Paper 11 (PTAB Oct. 3, 2025) (denying review because settled expectations outweighed a district court stay); *Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC*, IPR2025-00515, Paper 15 (PTAB July 16, 2025) (denying based on settled expectations when district court case stayed); *Kangxi Commc'ns. Techs. v. Skyworks Sols. Canada, Inc.*, IPR2025-00912, Paper 9 (PTAB Sept. 12, 2025) (finding settled expectations for a 17-year-old patent outweighed *Fintiv* even with a stay in district court); *Dabico*, IPR2025-00408, Paper 21; *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 (PTAB June 26, 2025); *Kahoot*, IPR2025-00696, Paper 12 (finding settled expectations for a six-year-old patent outweighed *Fintiv* where the district court action was stayed); *Sandisk*, IPR2025-00515 (Paper 15), IPR2025-00516 (Paper 15); IPR2025-00517 (Paper 15) (PTAB July 16, 2025) (finding that settled expectations for 9-, 12-, and 15-year old patents outweighed *Fintiv* where the district court action was stayed). The Decision declining discretionary denial here therefore is an outlier in this additional respect. Settled expectations for this 20-year-old (expired) patent counsels in favor of discretionary denial and outweighs the *Fintiv* factors—including the possibility of a district court stay (which has not yet been ordered). Director review is required.

III. The Decision to institute review conflicts with the Office’s publicly stated policies.

The interim discretionary denial procedure should not reflect the whims of an individual. It should promote a rational policy. The stated policy behind the discretionary denial process is to “create fairness ... for Patent Owners” and return the IPR process to its original intent. *See* Acting Director’s Remarks at IPBC Global Conference (September 16, 2025)³. Once the Office has publicly announced the policy and applied it in countless decisions, the Office should maintain consistency. As the Office has stated, IPRs were not intended to be an “on-demand review” of IP rights, and are instead reserved for “the best kinds of cases” that the Office should be looking at. *Id.* There is no credible argument that reviewing an expired patent simply because it is in litigation between private parties is “the best kind” of use for the Office’s limited resources.

There is also little potential benefit to the industry or the public at large in the PTAB canceling a patent that has already expired. The subject matter of this patent is already available to the public. Instituting review of this Petition is therefore unlikely to expand the industry’s freedom to operate in this space, and

³ Available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=.

therefore does not promote the original intent of IPR proceedings. *See* Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48680-01 (Aug. 14, 2012); *see also* *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, 28 F.4th 1371, 1381 (Fed. Cir. 2022) (observing that the “basic purpose of IPR proceedings” is to reexamine an earlier agency decision to “[keep] patent monopolies ... within their legitimate scope”).

Expired patents do not implicate the right to exclude or the public’s interest in policing a patentee’s exercise of that right. *See Kimble v. Marvel Ent., LLC*, 576 U.S. 446, 451 (2015) (“[W]hen the patent expires, the patentee’s prerogatives expire too, and the right to make or use the article, free from all restriction, passes to the public.”) (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 230 (1964)). The end of the patent owner’s exclusive monopoly likewise ends the need for an administrative process to protect the public interest by maintaining that monopoly within its legitimate scope. *See Oil States Energy Services, LLC v. Greene’s Energy Group, LLC*, 584 U.S. 325, 336–37 (2018); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 279–80 (2016).

That is a further reason why every discretionary denial decision issued pursuant to the bifurcated procedure has denied review of old and expired patents, even where there is parallel district court litigation that is stayed or would

otherwise be streamlined by a Final Written Decision. There is no reason for this case to be treated the opposite way. Director review is required and the institution decision should be overturned.

IV. The Institution Decision found that fewer than half of the challenges presented showed a likelihood of success on the merits.

Adding to the inefficiency of proceeding with trial is the panel’s finding that fewer than half of the challenged claims and grounds meet the statutory threshold for review. *See generally* Paper 15. Specifically, the panel found that there was no reasonable likelihood of showing unpatentability for claims 1-12 and 23 (out of 23 total challenged claims) for any Ground. *Id.*, 19. For Grounds based on Glines (all “A” Grounds), the panel found a reasonable likelihood of success for only a single claim—claim 21. *Id.* For Grounds based on Glines and Gupta (all “B” Grounds), the panel found a reasonable likelihood of success for only claims 13-22. *Id.*, 26.

The Board has long made clear that reviewing Petitions in which only a few of many total challenges have merit is not a good use of Board resources. *See, e.g., Chevron Oronite Co., LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018); *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019). That alone has been cited as justification to deny review. *Id.*; *see also* PTAB Trial Practice Guide § II.D.2 (If fewer than all challenged claims meet the institution standard, the Board will evaluate whether “in the interests of efficient administration of the Office and integrity of the patent system, the entire petition

should be denied.”). It likewise provides a reason to deny review here, where the panel found fewer than half of the challenges presented have merit.

Indeed, the Interim Director Discretionary Process (“Interim Process”) makes clear that, after referral, the “merits” considerations include “whether a petition presents a sufficient number of grounds/challenges that meet the reasonable likelihood standard.” Interim Process, § I.F⁴. Here, the petition fails this consideration. The Director should revoke the institution decision and discretionarily deny review to promote efficiency, consistent with the Director’s other decisions in similar cases.

Respectfully submitted,

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⁴ Available at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

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

I certify that the above-captioned **REQUEST FOR DIRECTOR REVIEW**
was served in its entirety on November 13, 2025, upon the following parties via
electronic mail:

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