

Filed: September 11, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

Case IPR2025-00860
Patent No. 10,924,573

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

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I. Introduction

The Petition should be referred to the Board for evaluation 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 multiple challenges against the claims of the ’573 patent. *See, e.g.,* Paper 1 (Petition) at 1. The first ground relies on a single reference—Newton-471—that anticipates every claim of the ’573 patent. *Id.* The Examiner materially erred by failing to properly determine the ’573 patent’s priority date and, therefore, overlooking and not considering Newton-471 as an anticipatory reference. The Examiner also materially erred by failing to consider the Dilley reference in combination with the Pai and Wang references asserted in the Petition. These material errors should not go uncorrected. Google respectfully asks the Director to refer this case to the Board.

Instead of addressing these material errors, Patent Owner cites purported “settled expectations” as a talisman to suggest denial is more appropriate. But as the Director has advised, any such “[s]ettled expectations” (to the extent they existed) cannot outweigh other factors, such as a material error committed by the Examiner during prosecution or a lack of commercialization by patent owner, as present here. *See Anthony Inc. v. ControlTec, Inc.*, IPR2025-00559, Paper 12 at 2 (P.T.A.B. July 16, 2025) (finding material error outweighed settled expectations); *see also Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00531, Paper 10 at 3 (P.T.A.B. July 17, 2025) (finding that a lack of commercialization or assertion outweighed settled expectations). Patent Owner has not shown that denial is the appropriate remedy here, especially when the ’573 patent issued only recently, in 2021. It is not a long-standing patent, and years remain before the patent’s expiration.

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

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

The Office committed a “material error” during prosecution when it failed to find, consider, and evaluate pertinent prior art showing the unpatentability of the

challenged claims. *See, e.g., Microsoft*, IPR2025-00318, Paper 9 at 3; *Ecto World*, IPR2024-01280, Paper 13 at 5; *Xencor, Inc. v. Merus N.V.*, IPR2024-00604, Paper 12 at 3 (P.T.A.B. July 17, 2025). The Director has consistently found that such an error by the Office can outweigh other factors that may otherwise favor denial. *Microsoft*, IPR2025-00318, Paper 9 at 3 (finding “it is an appropriate use of Office resources to review the potential error,” and reasoning this error required review, even though the parties had a trial date “preced[ing] the date projected for a Board final written decision”); *Eunsung Glob. Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 2-3 (P.T.A.B. July 10, 2025) (finding “Petitioner provides persuasive reasoning” that denial is not appropriate “due to a material error in examination,” even though the challenged patent “issued in 2017, and this would ordinarily favor denying institution”); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 2 (P.T.A.B. June 12, 2025) (referring and finding the “[p]etitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [a prosecution reference]”); *Anthony*, IPR2025-00559, Paper 12 at 2 (referring and finding showing of material error favored referring to panel for both 17- and 18-year-old patents). The same result is appropriate here.

First, the Examiner materially erred by failing to determine the correct priority date of the '573 patent and, therefore, failing to properly consider Newton-471.

As demonstrated by the Petition, during prosecution the applicant introduced new matter into the application that issued as the '573 patent. Paper 1 at 8-11. While the application (and its priority documents) discussed circumstances under which a system would or would not cache particular content, no prior disclosure described the use of an express instruction *not* to cache content. *Id.* The applicant added this new limitation on February 25, 2019, making that the earliest possible priority date for the '573 patent's claims.

Notably, the Examiner recognized that an instruction not to cache is not merely "determining whether to cache." EX-1007, 17. Rather, the Examiner expressed that the claims required an explicit instruction not to cache, not merely the existence of circumstances under which caching would not occur. *Id.* The Examiner explicitly based his allowance of the '573 patent on his understanding that this affirmative instruction was absent from the prior art. *Id.*

During prosecution, the Examiner recognized the substantial overlap between Newton-471 and the '573 patent, but because the Examiner failed to appreciate the proper priority date of the '573 patent's claims, the Examiner merely issued a nonstatutory double patenting rejection over claims issuing from the Newton-471

publication. EX-1007, 59-78. The Examiner failed to recognize that Newton-471 is an anticipatory reference.

Patent Owner seeks to minimize this material error by arguing that the provisional application to which the '573 patent claims priority (“the '412 provisional application”) provides adequate support for the “instruction to not cache” limitation. Paper 6 at 20. Not so. As Dr. Mowry confirmed, the '412 provisional application merely describes use of a “follow me” flag and the consequences of setting or not setting the flag; it does not describe the affirmative instruction not to cache required by the Examiner to overcome the prior art. EX-1006, ¶60. Patent Owner’s contrary arguments, supported only by bare attorney argument, are inconsistent with the Examiner’s reasoning and undercut by Dr. Mowry’s opinion. *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (requiring that the specification “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter”).

Second, the Examiner materially erred by overlooking and not considering the Dilley, Pai, and Wang combination.

Wang was not discovered or considered during prosecution, but it expressly discloses the use of instructions not to cache. EX-1005, ¶[0123]. The Examiner allowed the claims based on the mistaken belief that such instructions were not

known. EX-1007, 17 (stating that the “prior art of record fails to teach or suggest ‘receiving an instruction to not cache the resource at the first server’”). It was material error for the Examiner to allow the claims on that basis in view of Wang’s clear disclosure. Indeed, Patent Owner does not dispute that Wang discloses the limitation, that Wang was not considered, or that Wang is not cumulative of any reference that was before the Examiner. Paper 6 at 29-33.

Similarly, Pai was also not discovered or considered during prosecution, and it specifically teaches the claimed “popularity service . . . to determine a popularity designation associated with the requested resource.” Pai’s disclosures are accordingly pertinent to the claims, and it was material error for the Examiner to overlook Pai. Though Patent Owner argues that Pai is cumulative of another reference, Swildens, Paper 6 at 32-34, Pai in fact presents materially different disclosures that more closely align with the disclosures of the ’573 patent. Pai’s central teaching is the use of popularity to dynamically organize media across a multi-tiered system. *See, e.g.*, EX-1004, ¶¶[0013]-[0016], [0026], [0039]-[0047]. Though Swildens references popularity, Swildens does not describe the use of multiple popularity thresholds or the multi-tiered architecture disclosed in Pai and recited in the ’573 patent. *See, e.g.*, EX-1007, 75 (noting Swildens lacks a second tier of servers); EX-1004, ¶¶[0013] (describing tiered architecture and use of multiple popularity thresholds); *see also id.*, ¶[0003], [0016]; EX-1001, claim 1.

And while another Dilley reference was cited during prosecution of a parent application of the '573 patent, that Dilley reference was considered nearly a decade earlier, in 2011, by a different examiner, reviewing a different application and claim set. EX-1021, 2252-2258. Neither the Dilley reference discussed in the Petition nor the earlier-cited Dilley reference was applied during prosecution of the instant claims, much less considered in combination with Pai and Wang. Paper 1 at 88-89.

Patent Owner claims that the Examiner's failure to discover and consider Dilley and Pai is irrelevant because the Dilley-Pai combination is cumulative of Seed, a reference cited during prosecution. Paper 6 at 29-32. It is not. Seed addresses replicating and delivering media content across a distributed network system. EX-1013, Abstract. It states that the servers will determine that a requested object is popular "by some measure of popularity" and can replicate it at the edge servers. EX-1013, ¶[0032]. But it lacks the detailed implementation found in Pai. Pai, unlike Seed, explains that popularity is monitored and updated such that content can be redistributed to different levels based on popularity. EX-1004, ¶¶[0026], [0039], [0047]. Pai also explains that its techniques store content efficiently and effectively. *See, e.g.*, EX-1004, ¶[0013].

Moreover, the Petition rests not just on Dilley-Pai but on a novel and non-cumulative combination in Dilley, Pai, and Wang that was never considered during prosecution. Dilley provides the tiered CDN infrastructure and suggests popularity-

based caching. EX-1003, 2:26-31, 2:57-3:2, 9:57-65. Pai supplies the implementation details of a popularity service with thresholds that determine content placement. EX-1004, ¶[0013]. And Wang contributes mechanisms for issuing instructions to not cache, a feature the Examiner incorrectly believed to be absent from the art. EX-1005, ¶[0123]. The Examiner's failure to consider the complete combination, which directly addresses the "instruction to not cache" limitation that the Examiner found allowable, as well as the popularity-based caching behavior that is central to the '573 patent's disclosure, was a material error that warrants referral.

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 12-13. Not so.

The '573 patent only issued in 2021; its claims are only recently in force and years remain in the life of the '573 patent, which will not expire until 2029.¹ Patent Owner claims that only past damages are at stake, Paper 6 at 11, but the '573 patent will actually survive any trial by several years.

¹ While Patent Owner acknowledges the '573 patent's 2029 expiration date in its brief (Paper 6 at 1, 12), Patent Owner elsewhere incorrectly argues that the '573 patent "will expire two months from now." Paper 6 at 1.

Further, Patent Owner only recently acquired and began asserting the '573 patent. Thus, if anything, Google had a settled expectation that its Cloud CDN product, which was publicly known and launched nearly a decade ago, and its Media CDN, which launched in 2021, would not be accused of infringing a patent that the patent owner sat on for years. Any settled expectations favor referral.²

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

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

Patent Owner contends “settled expectations” weigh in its favor because the ’573 patent has purportedly been “in force for many years.” *See* Paper 6 at 1, 14. But Patent Owner’s argument runs afoul of governing IPR statutes. When Congress wanted to immunize patents of a certain age from post-issuance challenges, it did so expressly. When designing the regime for *inter partes* reexamination, for example, Congress expressly immunized (carved out) “patents issued before 1999” from review. *See* H.R. Rep. No. 112-98, pt. 1, at 46-48 (2011). Congress similarly immunized patents of a certain age when it created the PGR procedure, restricting those challenges to patents with post-AIA effective filing dates, in turn foreclosing this avenue of review for older patents. *See, e.g.*, AIA §§ 3(n)(1), 6(f)(2)(A).³

Yet for IPRs, Congress took the opposite approach. Congress “eliminated” the *inter partes* reexamination date-based carveout so that, instead, “*all patents can be challenged in inter partes review*,”⁴ regardless of age. *See* H.R. Rep. No. 112-98, at 46-48. And rather than restrict *inter partes* review based on a patent’s age or priority date, Congress only required a petitioner to wait for the nine-month PGR window to

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

⁴ All emphasis added unless otherwise indicated.

expire (to the extent applicable) (35 U.S.C. § 311(c)), and file within one year of being served with a complaint (*id.* § 315(b)). “Congress’s choice to depart from the model of a closely related statute is a choice neither we nor the agency may disregard.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 364 (2018).

Patent Owner’s settled-expectations argument also runs afoul of Board precedent. In *NHK Spring*, for example, the Board held that a ten-year delay in challenging a patent *was not enough to preclude an otherwise timely challenge* absent evidence the petitioner received a “tactical advantage” because it waited to file its petition. *NHK Spring Co. v. Intri-Plex Tech., Inc.*, IPR2018-00752, Paper 8 at 19-20 (P.T.A.B. Sept. 12, 2018) (precedential).⁵ 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

⁵ Likewise, the Director has referred cases with patents in force longer than the ’573 patent, given the complexities of the case. *See, e.g., Tesla, Inc. v. United States of Am. as represented by the Secretary of the Navy*, IPR2025-00341, Paper 12 (P.T.A.B. June 13, 2025) (no discretionary denial despite 18-year-old patent); *Tesla v. Intel. Ventures II*, IPR2025-00217, Paper 9 (P.T.A.B. June 13, 2025) (no discretionary denial despite 14-year-old patent).

developing and bringing products to market. Patent Owner cannot now cry foul because Google is challenging its patent after Patent Owner sued Google for infringement.

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 decided based on "the length of time the claims have been in force." *See* EX-2013, 2. Here, the '573 patent issued in 2021, and will expire in 2029, making the "length of time the claims have been in force" prior to the Petition's filing less than four and a half years. *See* EX-1001, cover. The Director has referred challenges for patents that have been in force for longer periods.⁶ *See, e.g., Berkshire Hathaway Energy Co. v. Midwest Energy Emissions Corp.*, IPR2025-00280, Paper 23, at 2-3 (P.T.A.B. Jul. 2, 2025) (referring petitions where patent was in force for six years). The same result is appropriate here.

⁶ Both the patent's age and the merits of Google's arguments distinguish this case from *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025) (explaining that "the Office is disinclined to disturb the settled expectations" of a patent in force for eight years when "Petitioner does not provide any persuasive reasoning" regarding referral), which is cited in Patent Owner's brief. Paper 6 at 14.

B. 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 and Media CDN of infringing. EX-1023, 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 ’573 patent never asserted it against Google or any other party, while the current Patent Owner filed suit in 2024. This “weighs against Patent Owner’s claim of strong settled expectations.” *See Shenzhen*, IPR2025-00531, Paper 10 at 3 (that the “challenged patent[] ha[s] never been “asserted, marked, licensed, or otherwise applied” in petitioner’s “particular technology space” weighs against discretionary denial).⁷ The delay of the ’573 patent owners created settled expectations for Google. Indeed, it is reasonable for a defendant to think that any dispute regarding its

⁷ There is also no evidence Patent Owner commercialized a product. *See Shenzhen*, IPR2025-00531, Paper 10 at 3. At most, Patent Owner identifies the activity of its predecessors, before Patent Owner came to own the patent. *See* Paper 6 at 2-5. Patent Owner otherwise identifies individuals associated with these predecessors (Andrew Swart and David Farber), who are not named inventors of the ’573 patent. *See, e.g., id.*

products would be brought soon (if ever) after a patent issued or after the accused products launched, rather than almost a decade later.⁸

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 referral. Patent Owner incorrectly contends that “[t]here is no stay of proceedings in the parallel district court case.” *See* Paper 6 at 13-14. 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. Consistent with standard practice in the Central District of California, the district court also agreed to stay the case *in its entirety* if the Board institutes the pending IPRs, in large part because Patent Owner indicated 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.

⁸ Regardless, Patent Owner only came into possession of the ’573 patent in 2024. *See* EX-1034. Patent Owner cannot assert it had any settled expectation before its ownership. *See* Paper 6 at 1, 12.

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.* at 5 (“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 posits that at least one of Google’s petitions will be denied institution and thus asks the Board to discount the likelihood of a stay. It urges that IPR Nos. IPR2025-00826, IPR2025-00806, and IPR2005-00969, involve expired patents, and suggests that the Board must accordingly deny referral based on *Dabico*, Paper 6 at 14, but *Dabico* does not address expired patents. It also claims that the Board must deny institution in IPR2025-00846 and IPR2025-00952, because the patents have been invalidated under 35 U.S.C. § 101. But the Board’s decision in

those IPRs will have no bearing on the District Court's decision to stay; the patents are no longer at issue in the district court case. *See* EX-2006, 1-2. More importantly Patent Owner falsely presumes that the District Court will *only* continue the stay if *all* patents are subject to IPR. The District Court has made no such pronouncement. Rather, it has affirmatively ruled that it will issue a stay if review is instituted on all patents. The Court has indicated openness to consider staying all or part of the case if only a subset of asserted patents were subject to IPR; given the flexible stay imposed by the Court to date, Patent Owner's suggestion that a continued stay is unlikely is implausible.

In short, Patent Owner asks the Board to disregard the compelling merits of this Petition because it (incorrectly) believes a continued stay is unlikely. The Board should decline this invitation.

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, at 3, 5.

Patent Owner also fails to reflect the district court's estimated time-to-trial in *patent* cases. *See* Paper 6 at 15-16. 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-1024, 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 15-16. 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-1025, 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 referral. Patent Owner contends that “[s]ignificant work has already been done in the parallel district court litigation,” and as such, Factor 3 should weigh in favor of institution. Paper 6 at 16-17. But this contradicts

the parties' earlier agreement in district court 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 at least the PTAB's discretionary denial decisions. *Id.* And even without any further stay (which, as discussed above, cannot be assumed), opening claim construction briefs would not be due until after the institution deadline for the '112 and '517 patents (*see id.*), while responsive briefs would not be 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 at least 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 5 ("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 16-17; EX-2007. While the ’573 patent describes the distribution of media across tiered servers, these other patents dealt with the distinct (and abstract) ideas “of using a subscription database to determine whether a user is authorized to receive content” and “modifying delivery of a video stream using trigger signals.” EX-2007, 6, 12. The Patent Owner also accused different products of infringing these patents than are accused of infringing the ’573 patent. Regardless, 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-1026, 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 referral. 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 ’573 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-1018.

Patent Owner’s assertion that this stipulation is “nominal[]” (*see* Paper 6 at 17) 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 17-18. 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 17-18.

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

Factor 5 favors referral or is at most neutral. Although the parties are involved in parallel litigation, Patent Owner is involved in litigation against other parties, including at least Comcast and Microsoft. EX-1027, 18-25; EX-1028, 14-22. There is no indication that Patent Owner will not assert the '573 patent against future defendants, and it has already asserted a priority patent of the '573 patent against both Comcast and Microsoft. *See Sandpiper CDN, LLC v. Comcast Cable Communications, LLC*, No. 2:24-CV-00886 (E.D. Tex. Nov. 1, 2024) (asserting U.S. Patent No. 9,762,692); *Sandpiper CDN, LLC v. Microsoft Corp.*, No. 2:25-CV-00664 (E.D. Tex. Jun. 26, 2025) (same). 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 referral. 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 '573 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, Newton-471 is an anticipatory prior art reference that should have been considered but-for the examiner's failure to properly determine the priority date of the '573 patent, and the Dilley, Pai, and Wang combination also separately discloses each of the claimed elements. The Petition's merits are strong, and Patent Owner's arguments mischaracterize the prior art. *See, e.g.*, Paper 6 at 19-25.

A. The Petition Demonstrates Anticipation Under Ground 1

Under the correct priority date, Newton-471 is anticipatory prior art. *See* Section II. It discloses each limitation of the challenged claims, including the "instruction to not cache."

Patent Owner contends that Newton-471 is not prior art under the claimed priority date. To support this contention, Patent Owner argues that the "instruction to not cache" limitation has written description support in the '412 provisional application to which the '573 patent claims priority. Paper 6 at 19-20. The thrust of

Patent Owner's argument is that the simple absence of a tag that would cause caching "is an instruction to not cache." Paper 6 at 20. This is incorrect. As explained in Section II and detailed by Dr. Mowry, the cited passages of the '412 provisional application describe at most circumstances "when [the system] will 'obtain and cache[] the resource,'" not sending or receiving an affirmative instruction not to cache, as recited by the claims. *See* EX-1006, ¶¶60-62; *see also supra* Section II.

Indeed, during prosecution, the Examiner specifically distinguished merely determining whether to cache a content item (*e.g.*, the absence of a follow me flag) from actually "sending an instruction to not cache the content item" as recited in the claims. EX-1007, 17. Patent Owner ignores this discussion, which was central to the Examiner's determination of patentability. *See, e.g.*, Paper 6 at 20. But as evidenced by the Examiner's statements and Dr. Mowry's testimony, a mere policy for managing content caching, as provided in the '412 provisional application, is not enough to support the "instruction to not cache" limitation. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*).

Accordingly, the '573 patent is not entitled to its claimed April 4, 2008, priority date, and Newton-471 qualifies as prior art.

B. The Petition Demonstrates Obviousness Under Ground 2

1. Dilley in View of Pai and Wang Teaches the Claimed “Determining Popularity” Features

With respect to Ground 2, Patent Owner argues that “determining a popularity designation associated with the requested resource,” as recited in independent claims 1, 11, and 19, is missing from the cited prior art, thus “preclud[ing] any likelihood of success.” Paper 6 at 21-22. Not so.

Pai teaches a popularity service that tracks user requests for particular content to determine the popularity of that content. *See, e.g.*, EX-1004, ¶¶[0020], [0039], [0047], Fig. 6. Pai explains, for example, that the popularity of particular content may be calculated “based on a number of times that the media item has been requested within a particular time period.” *Id.*, ¶[0039]. Pai teaches distributing content based on how popular content is (as compared to “popularity thresholds”) and explains that content is “dynamically re-distribute[d] . . . based on updated popularity values associated with the media content.” *Id.*, ¶¶[0029], [0039]-[0045]. Pai thus discloses the same type of popularity tracking as the ’573 patent, which states that “popularity of an object/resource is measured based on the number of times that object/resource is requested in various time periods,” and which uses this popularity determination to distribute media. EX-1001, 6:53-64, 8:58-60.

Despite these clear similarities, Patent Owner attempts to distinguish Pai by arguing that Pai determines the popularity not of a “requested resource” but only of

“currently maintained media content.” Paper 6 at 22. This argument is nonsensical. For a user to request and be served a resource in the Pai system, that resource (media content) must be maintained in the system.

Patent Owner further claims that the ’573 patent requires (1) determining a “popularity designation” that is then (2) “compared with different thresholds to determine where to serve the requested resource” from. Paper 6 at 22. In contrast, Patent Owner claims, Pai merely describes “identifying the current storage location for retrieving the content.” Paper 6 at 23.

But Pai expressly discloses determining (and dynamically updating) “current popularity values” for maintained media content based on the number of requests received over a particular time period. *See, e.g.*, EX-1004, ¶¶[0039]. Pai teaches that these values are then compared to “popularity thresholds” in order to distribute content across “media source[s]” according to its popularity, and that content is redistributed “dynamically” as popularity changes. *See, e.g., id.*, ¶¶[0029], [0039]-[0045]. Pai further explains that each media source is associated with a specific popularity level, such that the system “may use the popularity value associated with the received media item to determine whether the media item should be maintained *and served* by a media source associated with level one . . . or level (N).” *Id.*, ¶[0036].

Thus, contrary to Patent Owner’s arguments, Pai’s disclosure maps onto the claimed functionality of the ’573 patent. Pai describes a system that dynamically

tracks popularity, compares it to thresholds, and redistributes content accordingly in order to use a requested content's popularity to determine where to serve that content from. *See, e.g., id.*, ¶¶[0020], [0033]-[0045].

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 26. That Patent Owner takes exception to Google's explanation of what a POSITA would have understood or recognized in the prior art does not amount to gap filling. *See id.* To the contrary, explaining how a POSITA would have understood the asserted art, and how and why a POSITA would have combined references, is required to establish obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401 (2007); *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337 (Fed. Cir. 2020) ("[I]nquiry into whether any 'differences' between the invention and the prior art would have rendered the invention obvious to a skilled artisan *necessarily depends* on such artisan's knowledge.").

Patent Owner provides only conclusory statements to support its contentions, asserting that for Ground 2, the Petition relies "relatively heavily" on expert testimony "for motivation to combine and the satisfaction of claim elements 1(c), 1(d), 1(e), and dependent claims 2, 3, 4, 5, 7, and 18-19." Paper 6 at 26-27. Review

of the Petition belies this vague critique. The Petition identifies the specific teachings of each reference that support combination and that show how the proposed combination satisfies each claim element. Paper 1 at 36-41. It then, properly, relies on Dr. Mowry's testimony to establish how a POSITA would have understood the prior art, and his explanation of how a POSITA would have understood the combined CDN to operate. *See, e.g.*, Paper 1 at 36-41; EX-1006, ¶¶195-219. This is entirely proper and not gap filling. *Philips*, 948 F.3d at 1337.

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 27. 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 Newton-471, the teachings of Dilley, Pai, and Wang, 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 “for every cited claim limitation and every ground, rather than providing a focused expert declaration addressing the limitations for which expert testimony is necessary.” Paper 6 at 26. This argument should be rejected.

As an initial matter, Google’s citations are expected given the priority date challenge and 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 25-27, 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. Compelling Economic and Public Interest Concerns Favor Referral

A. Compelling Economic Interests Favor Referral

Compelling economic interests also favor referral. 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, many in the United States and contributing to continued economic growth. EX-1032.

Patent Owner suggests Google's size favors denial here, but provides no explanation as to why that is the case. *See* Paper 6 at 27-28. Restricting PTAB access by foreclosing a means for certain companies to challenge patents, as Patent Owner proposes, is contrary to the AIA, which allows *broad access* to any member of the public, stating that "*a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.*" *E.g.*, 35 U.S.C. § 311(a). Denying petitions based on the size of a petitioner is at least a failure to engage in proper rulemaking, and at worst, an unlawful decision that would exceed the Office's authority to prescribe regulations related to IPRs. *See, e.g.*, 35 U.S.C. § 316(a).

On the other hand, Patent Owner is a holding company formed within the last two years. *See* EX-1033. 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 referral in this case.

While Patent Owner argues that “the AIA was also a reaction to the financial hardship many smaller defendants faced with complex commercial litigation,” Paper 6 at 27-28, the legislative history it cites does not support this broad proposition. The AIA was certainly designed to “reduce[] unwarranted litigation costs,” but this was not limited to savings for only some parties or courts. Ex. 1029, 39-40. Indeed, it is Google 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. Economic interests thus favor referral.

B. Compelling Public Interests Favor Referral

Compelling public interest factors favor referral. One motivation behind the AIA was “improving patent quality and providing a more efficient system for challenging patents that should not have issued.” Ex. 1029, 39-40. The strong merits in the petition suggest instituting would accomplish the AIA’s goals of streamlining the litigation and reducing litigation costs.

Moreover, referral would not only streamline the instant dispute between Patent Owner and Google, but also disputes involving other parties, including

disputes involving related patents in the same family.⁹ Although the '573 patent is not presently asserted against other litigants, referral, institution and a finding of unpatentability would prevent the Patent Owner from unjustifiably asserting the '573 patent against others in the future.

As discussed further *supra*, there are compelling economic and efficiency reasons to have the Board assess the patentability of all claims under §§ 102 and 103. Conversely, there are substantial negative economic consequences to all Parties and the public if the claims must be adjudicated in more expensive and time-consuming litigation.

⁹In addition to Google, Patent Owner has asserted patents that relate to CDN servers (including, e.g., the '903 patent, the '322 patent, the '573 patent's grandparent patent (the '692 patent) and more) against other parties. *See Sandpiper CDN, LLC v. Comcast Cable Communications, LLC*, No. 2:24-CV-00886 (E.D. Tex. Nov. 1, 2024); *Sandpiper CDN, LLC v. Microsoft Corp.*, No. 2:25-CV-00664 (E.D. Tex. Jun. 26, 2025).

VIII. 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: September 11, 2025

Respectfully submitted,

/Erika H. Arner/

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24 and the Memorandum on Interim Processes for PTAB Workload Management, dated March 26, 2025, Petitioners certify that the word count of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution** as measured by Microsoft Word is 7,538 words, excluding those portions identified in 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution** was served electronically via email on September 11, 2025, in its entirety on the following:

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