UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

SANDPIPER CDN, LLC,
Patent Owner

Case IPR2025-00969
U.S. Patent No. 8,478,903

REQUEST FOR DIRECTOR REVIEW

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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 13 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 arbitrary and capricious. 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. Pat. 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. Pat. 7,702,719, which expired July 10, 2022, based on settled expectations); *Samsung Elecs. Co., Ltd. v. Keyless Licsensing LLC*, IPR2025-00528 (Paper 13), IPR2025-00529 (Paper 13) (denying review of U.S. Pat. 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. Pat. 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. Pat. 7,035,345, which expired Aug. 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. Pat. 6,854,287, which expired Aug. 2, 2022, based on settled expectations), IPR2025-00668 (Paper 10) (denying review of U.S. Pat. 6,718,277, which expired Apr. 17, 2022, based on settled expectations), IPR2025-00669 (Paper 11) (denying review of U.S. Pat. 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. Pat. 6,381,301, which expired Dec. 1, 2019, based on settled expectations, IPR2025-00772 (Paper 8) (denying review of U.S. Pat. 6,944,262, which expired Aug. 9, 2020, based on settled expectations), IPR2025-00787 (Paper 8) (denying review of U.S. Pat. 8,498,374, which expired Dec. 1, 2019, based on settled expectations) (PTAB July 31, 2025); *Samsung Elecs. Co., Ltd. v. Mobile Data Techs., LLC*, IPR2025-00537 (Paper 15) (PTAB Aug. 14, 2025), IPR2025-00538 (Paper 15) (PTAB Aug. 14, 2025) (denying review of U.S. Pat. 8,825,801, which expired June 18, 2023, based on settled expectations), IPR2025-00539 (Paper 15) (PTAB Aug. 14, 2025), IPR2025-00540 (Paper 15)

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The directly contradictory decision here is a clear outlier from this otherwise uniform treatment. 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. Pat. 9,635,540, which expired Mar. 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 8 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 13 at 2 (incorporating IPR2025-00806 Paper 14, at 2-3 citing these cases). 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 does not apply here. Similarly, *Apple* noted 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. That dispositive fact is not applicable here.

The Decision also footnotes that Patent Owner did not acquire the challenged patents until after they expired. *See* Paper 13 at 2 (incorporating

[1] Available at https://search.docketnavigator.com/patent/analytics.

IPR2025-00806 Paper 14). 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. Settled expectations therefore favors discretionary denial here, just as it has every other time the Office has considered an expired patent under the current bifurcated framework. The Director should reverse the errant 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 mischaracterized the record. 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. As the district court order makes clear, all deadlines leading up to trial remain unchanged and the close of expert discovery is only delayed by a month. EX2006, 5. Accordingly, the decision uses the "short pause" to put thumb on the scale against the district court's express intentions, EX2006, 4-5, and does so based on a misapprehension of the actual timeline.

Moreover, the challenged patent is also asserted in *Sandpiper CDN, LLC v. Comcast Cable Communications, LLC*, No. 2:24-cv-00886 (E.D. Tex. Feb. 6, 2025), which is set for trial July 20, 2026, with no prospective stay. *See* Docket Control Order, Dkt. No. 31. The Office has considered the *Fintiv* implications of other litigations to weigh against institution. *See Comcast Cable Comms. LLC v. Entropic Comms, LLC*, IPR2025-00183 Paper 11, (PTAB June 25, 2025) (denying institution in view of other litigation); *MSN Pharma v. Breckenridge Pharma, Inc.*, IPR2025-01107, Paper 11 (PTAB Oct. 17, 2025) (same). They do here as well.

Even if there were a stay in Petitioner's litigation here (which there is not) and even if the patent were not asserted in other litigations where a court will reach a decision on the merits of validity first (which it is), the decision to weigh other factors over the age of the patents directly conflicts with the consistent analysis that has otherwise characterized discretionary denial decisions since the advent of the bifurcated process. *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); *Volkswagen 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 alleged examiner error).

Moreover, the Office's decisions have repeatedly and specifically held that settled expectations for an old patent outweigh the *Fintiv* factors even where there is 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 institution decision here is therefore an outlier in this additional respect. 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)[2]. Once the Office has publicly announced the policy and applied it in countless decisions, the Office should

[2] 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=.

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 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).

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 decision issued pursuant to the bifurcated procedure has denied review of old-expired patents, even where there is parallel litigation that is stayed or would otherwise be streamlined by a FWD. There is no reason for this case to be treated the opposite way. The Director should overturn the institution.

IV. The Institution Decision was based on multiple misapprehensions of fact.

The Petition relies on a single reference—Kenner. Kenner fails to disclose multiple claim elements, including: (1) associating a *first alias name* and a *second alias name* with *a first resource* and *a second resource*, respectively, and *at least one shared repeater server* ([1.c]-[1.f]); and (2) *the at least one shared repeater server is further constructed and adapted to analyze, using the table, an alias name received with a client request for a particular resource to determine a content provider associated with the particular resource* ([1.g]). The Examiner recognized the novelty of these features during original prosecution. *See* EX1002, 249.

The institution decision relies on Kenner's video ID to teach an *alias name* and Kenner's index manager ("IM") for a *shared repeater server*. *See* Paper 14 ("Institution Decision"). In doing so, the Board improperly conflated Kenner's

various components and selectively read around Kenner's disclosure. Kenner's video ID is not *an alias name* associated with a *resource* and *at least one shared repeater server* used to direct requests from a client machine to a repeater server. Nor is Kenner's video ID stored in a table that is used to analyze *an alias name received with a client request for a particular resource to determine a content provider associated with the particular resource*. Furthermore, in discussing limitations [1.c]-[1.f], the Board erroneously determined that Kenner's video ID is associated with both a *resource associated with a content provider* and *at least one shared repeater server*. Paper 14 at 10-13.

Specifically, the Board erred by determining that Kenner's "clip database" teaches an association between video ID (*alias name*) and PIM (*at least one repeater server*). *Id.* at 11 ("Petitioner does not assert that Kenner's ID identifies a repeater server, relying instead on Kenner's clip database."). Kenner's "clip database" does not identify a repeater server or otherwise associate the video ID with an IM. Instead, "the clip database" indicates which "extended SRUs 66" store videos, not which IMs store the videos. EX1005, 34:3-6, 34:10-11. These "extended SRUs" are not IMs (the purported *repeater server*) and instead are "Storage and Retrieval Unit[s]" that "store audio-visual data in a plurality of audio-visual storage." *See id.*, 17:29-32. Recognizing that the "clip database" alone does not teach an association between the video ID and an IM, the Board also identified

a different database that stores "all other IMs connected to the system" and can include "information on the types of files stored by the IM's SRU's." Institution Decision, 11 (*citing* EX1005, 41:1-6). This second database and video ID can indicate the category of content with "content coordinate data"—e.g., a content area may be "news:sports:baseball." *See* EX1005, 36:28-31, 38:6-8, 41:3-4.

The Board stated that "Kenner's video ID includes content coordinate data that may 'match with the regional IMs [repeater servers] that have subscribed to that type of file.'" Institution Decision, 12 (*citing* EX1005, 36:20-30). But such a match only identifies a subset of IMs from which the PIM can retrieve content on behalf of a user. Kenner's "content coordinate data" does not identify a particular repeater server to which user requests may be *directed.* Nor does the video ID itself (i.e., the *alias name*) specify a repeater server.

As the Board noted, Kenner's video ID includes only "'a multidimensional set of content-characterization coordinates plus a unique file name' as well as 'the content provider's account number, . . . a time stamp, and a time period over which the file is relevant.'" Institution Decision, 13 (*citing* EX1005, 36:28-29, 36:32-37:5). This differs from the '903 patent where the alias name itself identifies both the resource and the repeater server. EX1001, 9:44-55 ("[I]f www.example.com is the origin server, names for three repeaters might be created: wr1.example.com[,] wr2.example.com[, and] wr3.example.com.").

For limitation [1.g], the Board erroneously determined that Kenner's "clip database" teaches *the table* used to *analyze . . . an alias name received with a client request for a particular resource to determine a content provider associated with the particular resource*. But Kenner's use of the "clip database" does not teach any actual analysis of an *alias name* (i.e., the video ID) with respect to the *table* (i.e. the clip database). Instead, Kenner describes a scenario in which, when neighboring IMs do not have the desired clip, a PIM "will then contact the source IM 90, where the content provider first uploaded the file." EX1005, 41:13-15, 41:15-16 ("The Internet address of the source IM 90 is provided in the clip database of the PIM 64."). Presumably, this would involve looking up the address of the source IM in the clip database using the video ID. But such a lookup does not teach any analysis of the video ID, let alone analyzing the video ID using the table. This function differs from the '903 patent where a repeater can (1) use the table of alias names to identify the origin server for the resource within the *alias name received with a client request* and (2) assess whether a corresponding content provider is authorized to use that particular repeater. EX1001, 9:56-59.

Accordingly, the Board misapprehended the facts of what Kenner teaches and consequently erred in instituting the Petition. The Director should revoke the institution decision.

Respectfully submitted,

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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 December 5, 2025, upon the following parties via electronic mail:

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