

Filed: December 15, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

Case IPR2025-00969

Patent No. 8,478,903

**PETITIONER GOOGLE LLC'S AUTHORIZED RESPONSE TO
PATENT OWNER'S DIRECTOR REVIEW REQUEST**

TABLE OF CONTENTS

I.	The Combination of Factors Present Here Counsels Against Discretionary Denial, Consistent with Other Office Decisions	1
A.	The '903 Patent's Expired Status Weighs Against Discretionary Denial	2
B.	The District Court Stay Also Weighs Against Discretionary Denial	7
II.	The Institution Decision Does Not "Conflict[]" with Any Office Policies.....	10
III.	The Board Properly Evaluated the Merits and Found They Warrant Institution	13
IV.	Conclusion	15

Patent Owner's Request for Director Review contends that the Acting Director's decision to refer this petition to the Board contradicts other decisions and the Office's policies. Patent Owner is wrong. None of the decisions Patent Owner cites address the same set of underlying facts that here counsel against discretionary denial, including: (1) the stay of the parallel district court proceeding; (2) the fact that the challenged patent is expired; and (3) Patent Owner's post-expiration acquisition and assertion of the challenged patent. Paper 13 at 2. Nor has Patent Owner identified any contradictory Office policy. The decision should be confirmed.

I. The Combination of Factors Present Here Counsels Against Discretionary Denial, Consistent with Other Office Decisions

Patent Owner first argues that the Acting Director erred in her consideration of "settled expectations." In doing so, it cherry-picks facts from other proceedings with different outcomes to suggest two findings are required here: (1) a patent's expiration results in settled expectations mandating discretionary denial, and (2) a patent owner's purported expectations outweigh factors related to *Fintiv*, including a stay in a parallel district court case. *See* Paper 17 ("DR Req.") at 1-7. The cases Patent Owner cites do not support these assertions, and their facts bear little resemblance to the instant matter.

A. The '903 Patent's Expired Status Weighs Against Discretionary Denial

Patent Owner first contends that settled expectations must favor discretionary denial whenever a patent has expired—including here, where the accused products (Google's Cloud CDN and Media CDN) were publicly available years before the patent expired and was later acquired and asserted by Patent Owner, and where the parallel district court action is stayed. *Id.* at 1. Not so.

The compelling facts here favor referral and institution. As explained in Google's Opposition to Patent Owner's Request for Discretionary Denial, Paper 8, Google's petition corrects a material error made by the Office during prosecution of the '903 patent. *See* Paper 8 at 3-5. And Patent Owner does not allege that the prior owner of the '903 patent ever alerted Google to the patent, much less accused Google's well-publicized Cloud CDN and Media CDN of infringing it. *See id.* at 15-16. Only after the expiration of the patent did the current Patent Owner acquire and assert it. *See id.* Each of these facts favors referral. *See generally id.*

The decisions Patent Owner cites do not require a different result. In *Omnivision*, for example, the Acting Director found it unlikely that the district court would stay the proceedings as a *Markman* hearing had been conducted and fact discovery had closed. *Omnivision v. RE Secured Networks*, IPR2025-01019, Paper 14 at 2-3 (P.T.A.B. Oct. 10, 2025). And she found that the petitioner's filing

of a declaratory judgment action undermined the petitioner's settled expectations. *Id.* at 2. Neither factor exists here. The district court litigation has been paused nearly six months. *See infra* Section I.B. And Patent Owner, not Google, initiated the district court case.

SAP America and *Google LLC v. Mullen Industries LLC* are similarly distinguishable. In each of these decisions, the Acting Director found that the related cases were likely to be tried prior to final decisions (unlike the district court case here, due to the present stay), and that certain of the challenged patents had been dismissed from the related litigation, leading the Acting Director to find it "an inefficient use of Board resources to review these challenged patents." *See e.g., SAP America, Inc. v. Valtrus Innovations Ltd.*, IPR2025-00417, Paper 9 at 2-3 (P.T.A.B. July 10, 2025); *Google LLC v. Mullen Industries LLC*, IPR2025-00227, Paper 13 at 3-4 (P.T.A.B. June 25, 2025). In contrast, the '903 patent challenged here is still asserted by Patent Owner in the parallel proceeding, and Google has stipulated that it will not pursue invalidity grounds in the district court that have been raised (or reasonably could have been raised) in this IPR. *See* EX-1016. Thus, neither case supports discretionary denial here.

Patent Owner's laundry list of other cases does not support its claim that an expired patent compels discretionary denial based on settled expectations. *See* DR Req. at 2-4. As with the cases discussed above, each of the proceedings Patent Owner

cites involved factors absent here. And indeed, *none* of the listed decisions even found the challenged patent's expiration to be a factor favoring discretionary denial. Often, a parallel district court proceeding had not been stayed and the Acting Director found it unlikely that a final written decision would be issued before a decision in the parallel proceeding.¹ In other cases, the Acting Director recognized

¹ See, e.g., *Samsung Elecs. Co. Ltd. v. Mobile Data Techs., LLC*, IPR2025-00535, (Paper 16 at 2), IPR2025-00536 (Paper 13 at 2) (P.T.A.B. July 10, 2025); *Samsung Elecs. Co., Ltd. v. Keyless Licensing LLC*, IPR2025-00528 (Paper 13 at 2), IPR2025-00529 (Paper 13 at 2) (P.T.A.B. July 17, 2025); *T-Mobile USA, Inc. v. Smart RF Inc.*, IPR2025-00727, Paper 13 at 2 (P.T.A.B. July 29, 2025); *Vertiv Corp. v. Valtrus Innovations Ltd.*, IPR2025-00667 (Paper 11 at 2), IPR2025-00668 (Paper 10 at 2), IPR2025-00669 (Paper 11 at 2) (P.T.A.B. July 31, 2025); *Samsung Elecs. Co. Ltd. v. Mobile Data Techs., LLC*, IPR2025-00537 (Paper 15 at 2), IPR2025-00538 (Paper 15 at 2), IPR2025-00539 (Paper 15 at 2), IPR2025-00540 (Paper 15 at 2), IPR2025-00541 (Paper 15 at 2), IPR2025-00542 (Paper 15 at 2), IPR2025-00543 (Paper 15 at 2), IPR2025-00544 (Paper 15 at 2) (P.T.A.B. Aug. 14, 2025); *Samsung Elecs. Co., Ltd. v. iCashe, Inc.*, IPR2025-00642 (Paper 11 at 2), IPR2025-00643 (Paper 11 at 2) (P.T.A.B. Aug. 14, 2025); *Microsoft Corp. v. Dialect, LLC*, IPR2025-00657, Paper 12 at 3 (P.T.A.B. Aug. 14, 2025).

overlap between the proposed IPRs and prior challenges.² And in others, the Acting Director found evidence of specific prior conversations between the parties and she suggested that the petitioner should have sought an earlier review.³ None of these circumstances are present here.

Patent Owner relatedly claims that “a petitioner cannot defeat settled expectations based on an argument that the patent was not previously asserted,”

² See, e.g., *Carvana, LLC v. Int’l Business Machines Corp.*, IPR2025-00564, Paper 11 at 2 (P.T.A.B. July 10, 2025) (petition challenges “substantially similar” to ones found unpersuasive in district court); *Dentsply Sirona Inc. v. Osseo Imaging, LLC*, IPR2025-00771 (Paper 8 at 2) (Federal Circuit affirming the district court’s finding that the challenged patents were not invalid), IPR2025-00772 (Paper 8 at 2) (same), IPR2025-00787 (Paper 8 at 2) (same) (P.T.A.B. July 31, 2025).

³ See, e.g., *Murata Mfg. Co., Ltd. v. Georgia Tech. Rsch. Corp.*, IPR2025-00383 (Paper 14 at 2-3) (noting parties previously discussed the technology space involving the challenged patent decades prior and citing five pages of related briefing regarding same), IPR2025-00384 (Paper 13 at 2-3) (same) (P.T.A.B. July 29, 2025); *Datadome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 at 2 (P.T.A.B. Aug. 14, 2025) (noting prior correspondence between petitioner and patent owner identifying the specific challenged patents).

stating “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,” DR Req. at 5. Patent Owner is again wrong.

The sole case Patent Owner cites in support, *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 (P.T.A.B. July 31, 2025), does not even address petitioners’ expectations and does not establish any bright-line rule. DR Req. at 6. In *Kahoot!* the petitioner argued that “*Patent Owner does not have settled expectations* because Patent Owner did not previously assert the challenged patent.” IPR2025-00696, Paper 12 at 2. The Acting Director determined that in the “absence of sufficient explanation” for this argument, the Patent Owner’s expectations in its issued patents favored denial. *Id.* Here, Google raised a different argument—it reasonably expected that products launched in 2016 (Cloud CDN) and 2021 (Media CDN) would not be accused in 2024 of infringing a patent that expired in 2023 by an entity that acquired the patent only after its expiration. *See, e.g.*, Paper 8 at 15-16. These facts weigh against discretionary denial. *See, e.g., Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 (P.T.A.B. Sept. 5, 2025); *Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 (P.T.A.B. June 12, 2025).

While Patent Owner attempts to distinguish *Apple* and *Globus*—both cited in the Acting Director’s referral decision—these cases present facts that far more closely align with this case than those cited by Patent Owner. DR Req. at 6.

In *Apple*, as here, “Patent Owner did not assert the challenged patents against Petitioner until after they expired.” *Apple*, IPR2025-00856, Paper 11 at 3. Similarly, in *Globus*, the Acting Director found that the patent “expired almost four years ago . . . and, accordingly, [petitioner] expected nonenforcement of the challenged patent.” *Globus*, IPR2025-00225, Paper 8 at 2. While *Apple* involved prior assurances by the patent owner and the patent’s expiration in *Globus* was due to maintenance fee nonpayment, these decisions demonstrate that petitioners can (and do) have settled expectations that expired patents will not be asserted.

Patent Owner challenges Google’s settled expectations based on its new assertion that “approximately 22% of patent infringement litigation asserts patents that are expired.” DR Req. at 5-6. Google has been unable to reproduce that statistic from the information provided in Patent Owner’s brief. Even accepting Patent Owner’s figure, however, nearly 80% of cases—the overwhelming majority—do not involve expired patents. And Patent Owner does not contend that the minority of cases involving expired patents are regularly brought by entities that acquired the patents only after expiration, as occurred here.

B. The District Court Stay Also Weighs Against Discretionary Denial

According to Patent Owner, the Office’s decisions present “consistent analysis” requiring that “settled expectations” outweigh the *Fintiv* factors, including district court stays. *See* DR Req. at 8-9. That is incorrect.

As a threshold matter, the Acting Director correctly found that the district court case is stayed. All proceedings have been on hold since July 2025 and will remain on hold at least through the resolution of this and related Director Review requests. *See, e.g., Sandpiper CDN, LLC vs. Google LLC*, No. 2:24-cv-03951 (C.D. Cal. Oct. 21, 2015) (Dkts. 87 and 90); EX-2006, 2-5. Patent Owner has also agreed to stay the district court case entirely if all IPRs against the asserted patents are instituted. EX-2006, 4. In the meantime, the original claim construction deadlines have now passed and much of the original fact discovery period has run, such that the case schedule will need to be adjusted once the stay is lifted. Patent Owner's suggestion that the case is merely "paused," rather than stayed, does not alter that procedural reality.

Further, contrary to Patent Owner's argument, the Acting Director is not required to weigh "settled expectations" over other factors. *See* DR Req. at 8-9. Rather, the Acting Director has routinely found that other factors outweigh such expectations. *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); *Shenzhen Tuozhu Tech. Co. Ltd. v. Stratasys, 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); *Volkswagen Grp. of Am., Inc. v. Longhorn Auto. Grp. LLC*, IPR2025-01064, Paper 9 at 2 (P.T.A.B. Oct. 10, 2025) (explaining

“Patent Owner’s settled expectations do not outweigh [other] considerations” including material error); *Azurity Pharm., Inc. v. Helsinn Healthcare SA*, IPR2025-00948, Paper 11 at 2-3 (P.T.A.B. Sept. 19, 2025) (finding lack of parallel proceeding and potential material error to outweigh settled expectations); *Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 at 2-3 (P.T.A.B. Sept. 4, 2025) (finding settled expectations outweighed where “challenged patent has not been commercialized, asserted, marked, licensed, or otherwise applied in [petitioner’s] technology space”); *Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11 at 3-4 (P.T.A.B. Sept. 3, 2025) (finding material error outweighs settled expectations); *Am. Airlines, Inc. v. Intellectual Ventures I LLC*, IPR2025-00786, Paper 12 at 2-3 (P.T.A.B. Aug. 29, 2025) (finding number and scope of challenged patents outweighed settled expectations).

The cases Patent Owner relies on, *see* DR Req. at 8-10, do not require a different result. Though the Acting Director has sometimes found settled expectations warrant denial of institution, those decisions do not announce a *per se* rule, and none addressed the same combination of underlying facts here. DR Req. at 8-10.

That the challenged patent is also asserted in a separate district court case involving a different defendant (Comcast Cable Communications, LLC) does not require a different result. That case is in its early stages—claim construction is

underway—and Patent Owner asserts five patents, not just the '903 patent at issue here. *See Sandpiper CDN, LLC v. Comcast Cable Commc'ns, LLC*, No. 2:24-cv-00886 (E.D. Tex. Feb. 6, 2025). Resolving the validity of the '903 patent at the Board is efficient, particularly since the Board has already invested time at the institution stage. *See, e.g., Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2-3 (P.T.A.B. July 2, 2025) (“Because the litigation between the parties would proceed to several district court trials . . . , resolving the dispute between the parties at the Office would be more efficient.”).

Though Patent Owner suggests that the existence of its Comcast case weighs against institution, the cases it cites to support that argument differ from the instant case. In *Comcast Cable Commc'ns LLC v. Entropic Commc'ns, LLC*, there had been multiple prior petitions challenging the same patent. IPR2025-00183, Paper 11 at 2, (P.T.A.B. June 25, 2025). And in *MSN Pharm. v. Breckenridge Pharm., Inc.*, there was no district court case involving the patent challenger. IPR2025-01107, Paper 11 at 2 (P.T.A.B. Oct. 17, 2025). Here, Google is the first party to challenge the '903 patent after its grant, and it has been separately sued.

II. The Institution Decision Does Not “Conflict[]” with Any Office Policies

In addition to its claims that the outcome here contradicts other decisions, Patent Owner urges that the Acting Director ignored Office policy. *See* DR Req. at 10. Patent Owner is again wrong.

The only purported policies that Patent Owner identifies are to treat patent owners fairly and focus resources on “the best” cases. *Id.*⁴ Even assuming Patent Owner has accurately summarized Office policy, Patent Owner’s critique is merely that *it* does not believe this case is a good and fair use of the Office’s resources. *See id.* at 11. That is irrelevant. The specific facts here—including the merits of Google’s case, Google’s long-settled expectations, and the stay of the parallel district court proceeding—support instituting review. *See generally* Paper 8.

Patent Owner’s argument that “[t]he subject matter of this patent is already available to the public” is misplaced. *See* DR Req. at 11. Patent Owner is currently asserting the ’903 patent in district court. As the Federal Circuit has recognized, patentees may still seek past damages after a patent’s expiration, and the public accordingly has an “interest in seeing that patent monopolies are kept within their legitimate scope” even in cases involving expired patents. *Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 369 (Fed. Cir. 2025).

⁴ Patent Owner appears to extrapolate these “policies” from selective quotations from the Acting Director’s September 16, 2025, memorandum regarding “PTAB consideration of prior findings of fact and conclusions of law,” which deals with diverging Board and District Court findings and the “Acting Director’s Remarks at IPBC Global Conference.” *Compare* DR Req. at 10, *with id.* at 10 n.2.

The Office has similarly rejected arguments like Patent Owner's. In *Inari Agriculture*, for example, the patent owner sought denial of institution of an expired patent to "preserve administrative efficiency." *Inari Agric., Inc. v. Corteva Agriscience LLC*, IPR2024-01014, Paper 15 at 24 (P.T.A.B. Dec. 16, 2024). The Board found "no good reason" to discretionarily deny "a second look at an earlier administrative grant of a patent" merely because the patent expired. *Id.* (citing *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 584 U.S. 325, 336 (2018)). It noted, "[t]he statutes and our Rules governing *inter partes* review do not exclude expired patents or those not subject to civil actions." *Id.* (citing 35 U.S.C. §§ 311, 315; 37 C.F.R. § 42.100(b)); accord *Apple, Inc. v. Gesture Tech. Partners LLC*, IPR2021-00922, Paper 10 at 17-19 (P.T.A.B. Nov. 29, 2021).

Kimble v. Marvel Entertainment, LLC is not contrary. It addressed whether claims for post-expiration royalties were anti-competitive. 576 U.S. 446, 461-62 (2015); DR Req. at 11. *Kimble* says nothing about challenges to expired patents or royalties for damages incurred during the patent term. Nor are *Oil States*, *Cuozzo*, or *Hunting Titan* contrary. See DR Req. at 11-12. In all three, the Board instituted review and the reviewing court did not disturb that decision. *Oil States*, 584 U.S. at 345; *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 283 (2016); *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, 28 F.4th 1371, 1382 (Fed. Cir. 2022).

III. The Board Properly Evaluated the Merits and Found They Warrant Institution

Finally, Patent Owner incorrectly asserts that the Board misapprehended Kenner’s teachings by finding that Kenner discloses (1) an *alias name* associated with *at least one shared repeater server*; and (2) a *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*. See DR Req. at 12-15.

First, as the Board properly found, Kenner teaches a video ID and a primary index manager (PIM) corresponding to the claimed *alias name* and *shared repeater server*, respectively. Paper 1 at 17-20. And Kenner discloses the claimed *association* through the PIM (*shared repeater server*) recording in a clip database the video ID (*alias name*) for a clip stored in its extended SRUs. *Id.* at 21.

Patent Owner now argues—for the first time—that Kenner’s clip database does not associate the video ID (alias name) and repeater server, because the clip database identifies which “‘extended SRUs 66’ store videos, not which IMs store the videos,” and, per Patent Owner, extended SRUs are not IMs. DR Req. at 13. But, as Kenner explains, these SRUs 66 are local to and are managed by the PIM. EX-1005, 45:15-18 (PIM 64 “invokes its storage management logic to copy the clip to one of its extended SRUs 66”), 44:30-32 (describing “SRUs belonging to

the IM”). Accordingly, the Board properly found that an association with a PIM’s SRUs reflects an association with the PIM. *See* Paper 1 at 21.⁵

Notably, as the Board recognized, Kenner also separately teaches the claimed “association” through a database of other IMs in the system recording the “Internet address of the IM and the content coordinates of all audio-video files that it maintains.” Paper 1 at 32 (citing EX-1005, 38:3-8). Patent Owner argues this content coordinate data only enables a PIM to “identif[y] a subset of IMs from which the PIM can retrieve content” and not “a particular repeater server to which user requests may be *directed*.” DR Req. at 14. Not so. This database records “the Internet address of the IM” and thus identifies a particular IM (*repeater server*) to which requests may be directed. EX-1005, 38:3-8, 40:29-41:6 (explaining “[t]he query can be directed to those IMs which are likely to have the clip”). Contrary to Patent Owner’s suggestion, DR Req. at 14, the Board correctly found that the database includes all information needed to associate the alias and the repeater server.

Second, the Board also properly found that Kenner’s clip database is a *table* used to *analyze . . . an alias name . . . to determine a content provider associated*

⁵ Patent Owner incorrectly asserts the Board “[r]ecogniz[ed] that the ‘clip database’ alone does not teach an association.” DR Req. at 13-14. It instead summarized the parties’ positions and deemed Patent Owner’s “unavailing.” Paper 14 at 11-12.

with [a] particular resource. When the PIM 64 is “unable to locate the desired clip . . . , the PIM 64 will then contact the source IM 90” using the clip database. EX-1005 at 41:13-15. Patent Owner argues that contacting this source IM 90 “would involve looking up the address of the source IM in the clip database using the video ID” which “differs from the ’903 patent.” DR Req. at 15. But the ’903 patent explains that the repeater uses an alias name “along with a table that associates repeater alias names with origin server names[] to determine which origin server is being addressed.” EX-1001, 9:56-59. In much the same way, Kenner’s PIM contacts the source IM 90 using the clip database, which includes the video ID (*alias name*) (EX-1005, 34:9) along with “[t]he Internet address of the source IM 90” (corresponding to the *content provider*) (*id.*, 41:15-16). Patent Owner has not identified any misapprehension by the Board and institution should be confirmed.

IV. Conclusion

The Director should decline Patent Owner’s request to revoke institution and instead allow the case to proceed to a final written decision on a full record.

Dated: December 15, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's
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