

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

IPR2026-00095
Patent 8,478,903 B2

Before JEFFREY S. SMITH, SHEILA F. McSHANE, and
MICHAEL T. CYGAN *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

DECISION
Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

A party to inter partes review may be joined to another inter partes review, subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

A request for joinder must be filed as a motion for joinder no later than one month after the institution date of any *inter partes* review for which joinder is requested, and the time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder. 37 C.F.R. § 42.122(b). Petitioner Microsoft filed a motion for joinder with an earlier-filed *inter partes* review challenging the same patent, U.S. Patent 8,478,903 B2. Paper 3 (“Motion” or “Mot.”). The Motion accompanied the Petition in this proceeding, which was accorded a filing date of November 3, 2025. Papers 3, 5. The earlier-filed *inter partes* review, IPR2025-00969 (“the ’969 IPR”), was filed on May 9, 2025 by Petitioner Google, and instituted on November 28, 2025. IPR2025-00969, Paper 14. Patent Owner filed an Opposition to the Motion. Paper 6 (“Opposition” or “Opp.”). Petitioner filed a Reply. Paper 8, “Reply.”

Petitioner asserts that the Motion is timely filed because it is filed no later than one month after the institution date of the earlier proceeding. Mot. 1. Patent Owner does not contest the timeliness of this Motion. *See Opp.* Based on the above-mentioned facts, we determine that the Motion is timely filed.

Petitioner contends that joinder is appropriate for a number of reasons. Petitioner asserts that the Petitioner in the '969 IPR does not oppose this Motion. Mot. 1. Petitioner asserts that the Petition is substantially the same as the '969 IPR Petition and presents no new grounds of unpatentability that were not present in that Petition. *Id.* at 1–4. Petitioner asserts that, if joined, Petitioner will “assume a ‘silent understudy’ role and will not take an active role in the *inter partes* review proceeding unless the Google Petitioner ceases to participate in the instituted IPR.” *Id.* at 2, 7. Petitioner asserts that such a role will not impact the existing schedule for the '969 IPR. *Id.* at 6. Petitioner asserts that it is neither time-barred nor estopped from filing its own petition, but seeks joinder in the interests of judicial efficiency and conservation of Patent Owner’s resources. *Id.* at 2, 4, 7 (stating that Petitioner received a complaint from Patent Owner concerning the '903 patent on July 1, 2025). Petitioner states that the '969 IPR is the only prior post-grant proceeding that has been filed challenging claims of the '903 patent. *Id.* at 3. Petitioner states that if joinder is granted, Petitioner will not file any further petition concerning the '903 patent. *Id.* at 5.

Patent Owner opposes joinder, providing three reasons. First, Patent Owner argues that Petitioner Microsoft relies entirely on Dr. Mowry’s declaration from the '969 IPR without indicating that it has actually retained Dr. Mowry or could produce him for cross-examination. Opp. 1, 3–4. Patent Owner states that “[t]he proceedings cannot properly be joined absent any evidence of how Microsoft would produce Dr. Mowry for cross-examination” should Google withdraw from its IPR challenge. *Id.* at 4–5.

However, Dr. Mowry has already been deposed by Patent Owner Sandpiper in the '969 IPR. IPR2025-00969, Ex. 2017. Therefore, Patent Owner’s cross-examination concern is no longer an obstacle to joinder.

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Further, Petitioner has been advised that, if it became lead petitioner, Dr. Mowry is able to represent Petitioner in the joined proceeding. Reply 2; Ex. 1019.

Patent Owner's other two reasons are based on arguments that the '095 Petition should not have been instituted because of discretionary denial considerations and merits considerations. Opp. 2, 5–15. However, the decisions to institute in both IPR2025-00969 and IPR2026-00095 have been evaluated by the Director on both discretionary and merits considerations. IPR2025-00969, Papers 13 (Director's Discretionary Decision to refer to the panel), 19 (Director's Order denying Director Review of the Decision granting institution); IPR2025-00095, Papers 13 (Director's Discretionary Decision to further review the Petition on its merits), 14 (Director's Decision to grant institution). This panel lacks authority to reconsider an institution decision. Memorandum, Director Institution of AIA Trial Proceedings, October 17, 2025, https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AIA_Trial_Proceedings.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=. Consequently, we do not consider joinder inappropriate based on Patent Owner's assertions of improper institution.

Joinder is a matter within the Board's discretion based on the particular circumstances of each proceeding. For the reasons given above, we are persuaded that Petitioner has demonstrated that permitting Petitioner to join the '969 IPR would avoid duplication and promote the efficient resolution of both proceedings and is therefore in the interests of justice.

Based on the record before us, grant Petitioner's Joinder Motion, joining Petitioner as a party to the '969 IPR.

ORDER

In consideration of the foregoing, it is:

ORDERED that Petitioner's Joinder Motion is granted, and Petitioner is joined as a party in IPR2025-00969;

FURTHER ORDERED that the Scheduling Order entered in IPR2025-00969 (Paper 15) is not modified and shall continue to govern the schedule in that proceeding;

FURTHER ORDERED that, as long as '969 IPR petitioner Google remains a party to the '969 IPR, Petitioners Google and Microsoft (i) will file papers (except for motions that do not involve another party) as a single filing identified as a Consolidated Filing, and (ii) will conduct coordinated (not separate) discovery;

FURTHER ORDERED that, as long as '969 IPR petitioner Google remains a party to the '969 IPR, Petitioner shall not introduce any argument or discovery not already introduced by those petitioners;

FURTHER ORDERED that Petitioner shall be bound by any agreements between Patent Owner and petitioner Google in the '969 IPR, including agreements regarding discovery or depositions;

FURTHER ORDERED that the Scheduling Order in IPR2026-00095 is superseded, and all further filings are to be made in IPR2025-00969;

FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2025-00969; and

FURTHER ORDERED that the case caption in IPR2025-00969 shall be changed to reflect joinder of Petitioner.

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