Paper No. 7
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

Case IPR2025-01010
Patent No. 10,057,322

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

TABLE OF CONTENTS

I. Introduction....1

II. The *Fintiv* Factors Favor Referral....2

A. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted....2

B. Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision....5

C. Factor 3: investment in the parallel proceeding by the court and the parties....7

D. Factor 4: overlap between issues raised in the Petition and in the parallel proceeding....10

E. Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party....12

F. Factor 6: other circumstances that impact the Board's exercise of discretion, including the merits....12

III. Patent Owner's Merits-Based Arguments Should Be Rejected....13

A. Verma Discloses the Claimed "API"....13

1. Patent Owner's Proposed Construction of "API" Is Wrong....14

2. Verma's "Broker" Discloses an "API"....17

B. The Combination of Verma and Lewin Discloses the Claimed "Tag"....18

1. Patent Owner's Construction of "Tag" Is Wrong....19

2. The Combination of Verma and Lewin Teaches the "Tag" Limitations....22

3. The Petition Provides a Sufficient Motivation to Combine....24

IV. Google's Reliance on Expert Testimony Is Not Excessive or Improper 26

A. The Petition Does Not Rely on Expert Testimony to Fill Gaps 26

B. Patent Owner Does Not Present Competing Expert Testimony with Its Request 28

C. Criticizing Reliance on Expert Testimony Contradicts the AIA's Particularity Requirements and Ignores That Testimony's Role in Providing Substantial Evidence.....30

V. Institution Would Be an Efficient Use of the Board's Resources.....31

VI. Compelling Economic and Public Interest Concerns Favor Institution.....31

A. Compelling Economic Interests Favor Institution 31

B. Compelling Public Interests Favor Institution 33

VII. Settled Expectations Also Favor Referral 34

VIII. Conclusion 36

TABLE OF AUTHORITIES

Page(s)

Federal Cases

ADASA Inc. v. Avery Dennison Corp.,
55 F.4th 900 (Fed. Cir. 2022) 28

Apple v. Fintiv,
IPR2020-00019, Paper 11 (P.T.A.B. March 20, 2020) 7

Belden Inc. v. Berk-Tek LLC,
805 F.3d 1064 (Fed. Cir. 2015) 29

Berkshire Hathaway Energy Co. v. Birchtech Corp.,
IPR2025-00274, Paper 23 (P.T.A.B. July 2, 2025) 12, 36

Brand v. Miller,
487 F.3d 862 (Fed. Cir. 2007) 29

Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.,
IPR2025-00434, Paper 10 (P.T.A.B. June 26, 2025) 35

Celgene Corp. v. Peter,
931 F.3d 1342 (Fed. Cir. 2019) 35

Dabico Airport Sols. Inc. v. AXA Power APS,
IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025) 4, 5

Google LLC v. Sandpiper CDN, LLC,
IPR2025-00806, Paper 13 (P.T.A.B. Sept. 12, 2025).....1, 2, 4

Google LLC v. Sandpiper CDN, LLC,
IPR2025-00806, Paper 6 (P.T.A.B. July 14, 2025) 8

Google LLC v. Sandpiper CDN, LLC,
IPR2025-00826, Paper 14 (P.T.A.B. Sept. 12, 2025).....1, 2, 4

Icon Health & Fitness, Inc. v. Strava, Inc.,
849 F.3d 1034 (Fed. Cir. 2017) 29

Illumina, Inc. v. Natera, Inc.,
IPR2019-01201, Paper 19 (P.T.A.B. Dec. 18, 2019) 7

Ingenico Inc. v. IOENGINE, LLC,
136 F.4th 1354 (Fed. Cir. 2025) 11

Inwood Lab'ys, Inc. v. Ives Lab'ys, Inc.,
456 U.S. 844 (1982).....29

iRhythym Techs. Inc. v. Welch Allyn, Inc.,
IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) 26, 27

Kirwa v. U.S. Dep't of Def.,
285 F. Supp. 3d 21 (D.D.C. 2017).....35

Koninklijke Philips N.V. v. Google LLC,
948 F.3d 1330 (Fed. Cir. 2020) 26

KSR Int'l Co. v. Teleflex, Inc.,
550 U.S. 398 (2007).....26

Lynk Labs, Inc. v. Samsung Elecs. Co.,
125 F.4th 1120 (Fed. Cir. 2025) 11

Motorola Solutions, Inc. v. Stellar, LLC,
IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025).....11

Oatey Co. v. IPS Corp.,
514 F.3d 1271 (Fed. Cir. 2008) 15, 16, 20, 21

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) 16

Profectus Tech. LLC v. Huawei Techs. Co., Ltd.,
823 F.3d 1375 (Fed. Cir. 2016) 16

Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.,
24 F.4th 1406 (Fed. Cir. 2022) 30

Realtime Data LLC v. Teradata Operations, Inc.,
No. 2:16-cv-02743, 2017 WL 3453295 (C.D. Cal. Feb. 27, 2017).....8

Sandpiper CDN, LLC v. Comcast Cable Commc'ns, LLC,
No. 2:24-cv-00886 (E.D. Tex.).....34

Sandpiper CDN, LLC v. Microsoft Corp.,
No. 2:25-00664 (E.D. Tex.).....34

Savant Techs. LLC v. Feit Elec. Co., Inc.,
IPR2025-00260, Paper 16 (P.T.A.B. June 12, 2025) 7

Shoes by Firebug LLC v. Stride Rite Children's Grp., LLC,
962 F.3d 1362 (Fed. Cir. 2020) 30

Tafas v. Dudas,
511 F. Supp. 2d 652 (E.D. Va. 2007) 35

Teleflex, Inc. v. Ficosa N. Am. Corp.,
299 F.3d 1313 (Fed. Cir. 2002) 16, 21

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) 6

Trs. of Columbia Univ. in City of N.Y. v. Illumina, Inc.,
620 F. App'x 916 (Fed. Cir. 2015) 29

Unification Techs. LLC v. Micron Tech. Inc.,
No. 2023-1348, 2024 WL 3738401 (Fed. Cir. Aug. 9, 2024).....28

Verizon Servs. Corp. v. Vonage Holdings Corp.,
503 F.3d 1295 (Fed. Cir. 2007) 15, 20

Yorkey v. Diab,
601 F.3d 1279 (Fed. Cir. 2010) 29

Federal Statutes

5 U.S.C. § 706(2)(A).....35

35 U.S.C. § 101 .....5, 6, 9

35 U.S.C. § 102 .....10, 33

35 U.S.C. § 103 .....10, 33

35 U.S.C. § 286 ..... 12, 34

35 U.S.C. § 311(a) 32

35 U.S.C. § 312(a)(3)(B) 30

35 U.S.C. § 315(e) 10

35 U.S.C. § 316(a) 32

I. Introduction

This case should be referred to the Board for evaluation of the Petition on the merits. Patent Owner first asserted the '322 patent against Google a little over six years post-issuance, by adding it to an already pending litigation involving six other patents. Google filed its IPR Petition approximately four months later. That Petition demonstrates the unpatentability of four of the '322 patent claims based on a single primary reference, Verma, alone, and unpatentability of the remaining 11 claims based on Verma in combination with other references. Google's diligence favors referral.

The *Fintiv* factors also favor referral. As the Office recently recognized in proceedings involving other patents from the same litigation, "the parallel district court proceeding . . . has been stayed," and thus "it is likely that a final written decision will issue before the district court trial occurs, reducing the concern of inconsistent outcomes or significant duplication of efforts." *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13 at 2 (P.T.A.B. Sept. 12, 2025); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00826, Paper 14 at 2 (P.T.A.B. Sept. 12, 2025). Like it did in the other proceedings, "[t]his counsels against discretionary denial." *Id.*

The Petition's strong merits also favor referral. Patent Owner disputes two claim limitations—the "API" and the "tag"—but the Petition details how Verma's

broker discloses an API and all of its functionality and how Lewin's "tag" corresponds to the claimed "tag." Patent Owner's meritless arguments to the contrary rely on faulty claim constructions that both read in limitations from the specification and exclude other disclosed embodiments.

Patent Owner's remaining arguments regarding the Petition's prototypical reliance on expert testimony, efficiency, and economic and public interest factors are likewise unavailing. Moreover, Patent Owner does not argue that settled expectations support denial. Nor can it because, as discussed in the final section, Patent Owner has none. Instead, any settled expectations favor Google and referral. The Director should therefore decline to exercise her discretion and should refer the Petition to the Board.

II. 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 because, as the Office has already recognized, "the parallel district court proceeding involving the parties has been stayed pending a decision whether to institute review of Petitioner's *inter partes* review" requests. *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13 at 2 (P.T.A.B. Sept. 12, 2025); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00826, Paper 14 at 2 (P.T.A.B. Sept. 12, 2025).

Patent Owner incorrectly contends that "[t]here is no stay of proceedings in the parallel district court case." *See* Paper 5 at 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. All aspects of the case have been paused, with the exception of the scheduled date of trial. *Id.* 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.[1]

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 already 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,

[1] All emphases added unless otherwise indicated.

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's remaining arguments do not relate to *Fintiv* Factor 1 and are without merit for the reasons discussed herein.[2] *See* Paper 5 at 14-15. Indeed, Patent Owner assumed it was a foregone conclusion that the proceedings in IPR2025-00806, IPR2025-00826, and IPR2005-00969 would be denied because they involve expired patents that have purportedly been in force for over a decade, and as such, a stay will never occur because not all patents will be addressed by the Board in an *inter partes* review proceeding. *Id*. But the Director has rejected this reasoning for IPR2025-00806 and IPR2025-00826, referring both to the Board. *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 13 at 2-3 (P.T.A.B. Sept. 12, 2025); *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00826, Paper 14 at 2-3 (P.T.A.B. Sept. 12, 2025). Patent Owner's citation to *Dabico*, IPR2025-00408, Paper 21, is

[2] Patent Owner's arguments on the merits are addressed below in Section III. *See* Paper 5 at 15.

inapposite because *Dabico* did not address expired patents. *See* Paper 5 at 15; *Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 2-3 (P.T.A.B. June 18, 2025).

Patent Owner's reference to the patents at issue in IPR2025-00846 and IPR2025-00952, which were found ineligible under 35 U.S.C. § 101 also is irrelevant and does not shift the current stay or the likelihood or a subsequent stay in the event of institution. *See id*.

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. Instead, it 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. Factor 1 therefore favors referral.

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—less than two months before the anticipated Final Written Decision (December 16, 2026). EX-2006 at 5. 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 id.* at 3, 5. And

Patent Owner has agreed to a stay in district court if all IPRs are instituted. *Id.* at 3-4.

Patent Owner's statistics also fail to reflect the district court's estimated time-to-trial in *patent* cases. *See* Paper 5 at 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-1021, 3. As such, the expected median trial dates for patent cases in the district court are *within only a few weeks* of the expected Final Written Decision here.

The PTAB cases Patent Owner relies on are unhelpful. *See* Paper 5 at 16-17. 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-1022, 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 because minimal investment has been made in the '322 patent at the district court. Petitioner diligently filed the Petition approximately four months after Patent Owner added the '322 patent to the district court litigation. *Compare* Paper 4 at 1 (Petition accorded filing date of May 23, 2025); EX-1034 at ¶¶ 66-67 (Dkt. 45-1, First Amended Complaint asserting the '322 patent, filed January 13, 2025).

Factor 3 counsels that "[i]f the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution …." *Apple v. Fintiv*, IPR2020-00019, Paper 11 at 11-12 (P.T.A.B. March 20, 2020) (explaining that *Illumina* found "petitioner was diligent in filing the petition several months before the statutory deadline and in response to the patent being added to the litigation in an amended complaint") (citing *Illumina, Inc. v. Natera, Inc.*, IPR2019-01201, Paper 19 at 8 (P.T.A.B. Dec. 18, 2019)). The Director recently referred a petition where "Petitioners acted diligently in filing th[e] Petition less than three months after Patent Owner asserted claims 11 and 12 in district court." *Savant Techs. LLC v. Feit Elec. Co., Inc.*, IPR2025-00260, Paper 16 at 3 (P.T.A.B. June 12, 2025). The Director should find the same here.

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 5 at 17. But this contradicts Patent Owner's own admissions. In related briefing, Patent Owner admits that "the parallel district court case *is in its early stages*." *Google LLC v. Sandpiper CDN, LLC*, IPR2025-00806, Paper 6 at 13 (P.T.A.B. July 14, 2025) (Patent Owner's Discretionary Denial Brief for the '517 patent). Moreover, the District Court explained that the parties "generally agree[d]" 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 resolution of the IPRs. *Id.* Opening claim construction briefs are not due until after the expected institution decisions for the '112 and '517 patents (*see id.*), while responsive briefs are not due until after the expected institution decisions for the '573 and '903 patents, and roughly around the time an institution decision is expected for the '332 patent. *Id.* The *Markman* hearing is delayed until after the institution decision is expected in this proceeding. *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 4 ("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 5 at 17-18; EX-2007. But 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-1024, 1). Thus, there is little "judicial economy" in denying institution, as Patent Owner contends, because the court, like the Board, will need to be brought up to speed on 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 '322 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-1020.

Patent Owner's assertion that this stipulation is "nominal[]" (*see* Paper 5 at 18) 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, 1365 (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 5 at 18-19. 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 II.A-II.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 5 at 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-1025; EX-1026. Moreover, Patent Owner can assert the '322 patent against future defendants for the next seventeen years, considering its eleven years of term remaining and the availability of retroactive damages. *See* EX-1001, Cover; 35 U.S.C. § 286; *infra* Sections V, VI.B. Instituting review benefits not only the district court proceeding involving Google, but also potential future litigations with other defendants. *See 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 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 Sections III and IV, the Petition presents compelling merits based on the prior art and makes an entirely appropriate use of expert testimony. Patent Owner's arguments to the contrary are meritless. *Infra* Sections III-IV.

III. Patent Owner's Merits-Based Arguments Should Be Rejected

The Petition's merits are strong, and Patent Owner's substantive arguments rely entirely on incorrect claim constructions that contradict the '322 patent specification. *See* Paper 5 at 19-30.

A. Verma Discloses the Claimed "API"

Patent Owner first argues that Verma's "broker" does not disclose the claimed "API." Paper 5 at 20-21. This is incorrect. Notably, Patent Owner does not dispute that Verma's broker serves as an interface with a content provider. *See, e.g.*, Paper 5 at 23 ("As Verma explains, 'Movies-Inc.Com content provider 22 sends a request 34 for information to a content delivery network broker 25 ….'") (quoting EX-1005, [0025]). Patent Owner even acknowledges that Verma's "broker" discloses the same functionality as the API disclosed in the '322 patent.

Instead, Patent Owner's argument is premised on a construction that "an API acts as an interface that allows the client to communicate with an application executing on the server—it is not the application itself." *Id.* at 21-22. But this construction contradicts the specification, which explains that "***the API may include the functionality of the engine*** and ***not necessarily be a discrete mechanism from the computing engine*** functions." EX-1001, 7:22-25. This is fatal to Patent Owner's argument.

1. Patent Owner's Proposed Construction of "API" Is Wrong

Patent Owner contends that "an API acts as an interface that allows the client to communicate with an application executing on the server—*it is not the application itself*." Paper 5 at 21-22; *see also id.* at 22 (arguing that "[i]n the context of the '322 patent, the 'API' acts as a bridge between the origin server and the compute engine"). This interpretation is improper because it reads out disclosed embodiments where the API is the compute engine or also includes the compute routine.

The '322 patent specification expressly states that the "API" and the "computing engine" may be one and the same: "*the API may include the functionality of the engine* and *not necessarily be a discrete mechanism from the computing engine* functions." EX-1001, 7:22-25. It then repeatedly refers to the "API/compute engine" or "API/compute node" as one component. *Id.* at 7:51-52, 7:56, 9:3. It confirms this understanding elsewhere, explaining that "[t]he *API or other computing engine* associated therewith generates a target or list of targets (nodes capable of serving the content from the CDN), and provides one or more locations from which the content (or embedded content) may be served." EX-1001, 3:19-30. In these descriptions, the "computing engine" is the "API" itself, and the "API" "generates" the list of target nodes. *Id.*; *see also id.* at 4:67-5:4 ("the *API/compute* engine may instead cause the creation of an embedded resource 24B").

As another example, the specification explains that "[i]n some instances, *only an API is referenced* but it should be recognized that *such reference includes not only the interface but also the associated compute routine*, function, and the like for processing inputs to the API and generating a modified embedded resource." *Id.* at 4:67-5:15. Thus, the "API" reference can also include both the "interface" and "compute routine." *Id*.

Patent Owner's proposed construction cannot be correct because it reads out these embodiments. "We normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification." *Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1276 (Fed. Cir. 2008) (citing *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1305 (Fed. Cir. 2007) (rejecting proposed claim interpretation that would exclude disclosed examples in the specification)).

Patent Owner ignores these disclosures and instead cites other portions of the '322 patent specification referring to "API 26" and "computing engine 30." *See* Paper 5 at 22 (citing EX-1001 at 4:32-34, 4:49-52, 6:24-30). These elements are shown in Figure 1, which the specification describes merely as "*one example* network configuration for practicing aspects of the present disclosure." *Id.*, 3:43-45; *see also id.* at Fig. 1, 2:45-49. Thus, Patent Owner's proposed construction is doubly flawed because it reads limitations into the claim from an exemplary embodiment, while simultaneously ignoring the specification's other embodiments that describe

the API as part of the compute engine itself. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1326 (Fed. Cir. 2002) ("limitations from the specification are not to be read into the claims."); *Oatey*, 514 F.3d at 1276. This limiting construction should therefore be rejected, and once it is, Patent Owner's argument falls apart.

Patent Owner also relies on extrinsic evidence which it failed to submit as an exhibit (cited as EX-2013). *See* Paper 5 at 21. Even without the benefit of this exhibit, Patent Owner's argument is unpersuasive. Patent Owner contends the extrinsic evidence shows that an API is "a set of rules or protocols that enables software applications to communicate with each other to exchange data, features and functionality." *Id*. (citing EX-2013 at 1). But enabling data exchange is exactly what Verma's broker does, as explained below. *Infra* Section III.A.2.

Regardless, extrinsic evidence is not necessary or proper here because the specification makes clear that the API can serve as the computing engine. "Extrinsic evidence may not be used 'to contradict claim meaning that is unambiguous in light of the intrinsic evidence.'" *Profectus Tech. LLC v. Huawei Techs. Co., Ltd.*, 823 F.3d 1375, 1380-81 (Fed. Cir. 2016) (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1324 (Fed. Cir. 2005)). As discussed above, the specification discloses embodiments where the API and the computing engine are the same component. *E.g.*, EX-1001, 7:22-25, 7:51-52, 7:56, 9:3. This ends the inquiry and demonstrates the error in Patent Owner's proposal. *Profectus*, 823 F.3d at 1380-81.

2. Verma's "Broker" Discloses an "API"

Verma discloses an "API" even under Patent Owner's incorrect understanding of this term because the broker is an interface between the content servers and the CDN, as even Patent Owner acknowledges. As explained in the Petition, Verma's broker sends and receives data to and from the content server, at least disclosing an API interface. *See* Paper 1, 11-12 (explaining "Verma's broker is an API, application programming interface, because it 'communicate[s] with the content server(s)' and *provides an interface between content server(s) and CDN*") (quoting and citing EX-1005, [0015], [0022], [0025]-[0026]; EX-1003 ¶87).

Patent Owner does not dispute that Verma's broker serves as an interface, and Patent Owner even acknowledges this several times. *See* Paper 5 at 22-23. For example, Patent Owner acknowledges that "[a]s Verma explains, 'Movies-Inc.Com content provider 22 *sends a request 34* for information *to a content delivery network broker* 25 …,'" admitting that Verma's "broker" is an interface to communicate with the "content provider 22" (e.g., receive a "request 34"). *Id*. (quoting EX-1005, [0025]). In another instance, Patent Owner states that "Verma[] describes 'a content *broker which receives information* from the cache servers in a content delivery network as to traffic, availability of particular files and various locations, *and then returns the re-written URL to the content server* ….'" *Id*. (quoting EX-1005, [0012]). Here too, Patent Owner acknowledges that the "broker" "receives information" from

cache servers and "returns" information to the content server, thus serving as an interface. *Id*.

This is all consistent with Patent Owner's understanding of an API being "an interface that allows the client to communicate with an application executing on the server." Paper 5 at 21-22. Absent its incorrect requirement that the "API" must be discrete from the computing engine, *see supra* Section III.A.1, Patent Owner has no other argument on the merits for the "API" term, the only disputed limitation of claims 11-15. Paper 5 at 24. Thus, the Petition's merits are strong. *See* EX-1001, claims 11-15. Thus, the Petition establishes a reasonably likelihood of prevailing on the merits.

B. The Combination of Verma and Lewin Discloses the Claimed "Tag"

Patent Owner's second merits-based argument applies only to a subset of claims and grounds (Grounds 3-5) and does not affect independent claims 11 and 15. Moreover, Patent Owner's argument (Paper 5 at 25-28) lacks merit because the Petition clearly sets forth how the prior art discloses the "tag" limitations and provides a sufficient motivation to combine the prior art references, as explained below.

Patent Owner complicates what is otherwise a straightforward combination. Patent Owner agrees that Verma disclosed a "markup scheme" with "standard

HTML tags." Paper 5 at 28-29. Petitioner added Lewin to Verma in Grounds 3-5 because it expressly discloses markup language "tags" (like Verma's) that are "parse[d]" and identified to fetch additional content. *See, e.g.*, Paper 1 at 55. Lewin simply provides a more express disclosure and additional implementation details. These commonalities between Verma and Lewin support—rather than detract from—the motivation to combine the teachings.

Lewin discloses "tags," which correspond to the "tag" of claim 1 because Lewin's "tags" are "parse[d]" to identify where content should be incorporated, as discussed below. *Infra* Section III.B.2. Patent Owner reads limitations into the claim from an exemplary embodiment in response. But this is an incorrectly narrow reading of the recited "a tag" and "upon identification of the tag," which connote only a causal relationship. EX-1001, claim 1.

1. Patent Owner's Construction of "Tag" Is Wrong

Patent Owner contends that the generally recited "tag" of claim 1 is "a tag indicating that a resource address compute engine 30 should be contacted via a call to an API 26." Paper 5 at 26-27 (quoting EX1001, 4:32-34). Like its "API" construction, Patent Owner's interpretation here also reads out disclosed embodiments where the tag merely causes the embedded resource to be fetched, without adding Patent Owner's extraneous "indicating" limitation.

The specification confirms that some "embodiments … includ[e] *a tag that causes* the embedded resource to [be] *analyzed* to construct a modified embedded resource …" *Id.*, 2:7-18; *see also id.*, 1:57-63. Likewise, Figures 2 and 5 are described as "illustrating a method of identifying a tagged resource and thereafter providing a modified embedded resource by passing various parameters to an API …." *Id.*, 2:50-54, 2:63-67, FIGS. 2, 5. In step 220 of Figure 2, all that is required is "upon identification of a tagged embedded resource, pass[ing] parameters to API … for modified resource generation by way of a resource compute engine." *Id.*, FIG. 2 (capitalization altered). Claim 1 similarly only requires that the tag play some causal role in obtaining a modified embedded resource, i.e., "upon identification of the tag," not the more specific indicative role that Patent Owner suggests. *Compare id.*, claim 1, *with* Paper 5, 26-27.

Patent Owner's proposed construction cannot be correct because it reads out these embodiments. *Oatey*, 514 F.3d at 1276; *Verizon*, 503 F.3d at 1305. Moreover, the specification does not provide lexicography for the claimed "tag" and "upon identification of the tag." *See generally* EX-1001.

Patent Owner again ignores these disclosures and instead argues that "[f]igure 1 of the '322 patent illustrates the claimed 'embedded resource with a tag.'" *See* Paper 5 at 25-26. But as explained above, Figure 1, and its corresponding description, are merely "*one example* network configuration." EX-1001, 3:43-45;

supra Section III.A.1. In this exemplary embodiment, "the tag is '$' which causes the origin server 18 to call the API 26" and the tag is "a tag indicating that a resource address compute engine 30 should be contacted via a call to an API 26." Paper 5 at 26-27 (citing and quoting EX-1001, 4:22-48). But Applicant did not limit its invention to this exemplary embodiment which even on its face describes the process permissively: "[t]he embedded resource *may include a tag* indicating that a resource address compute engine 30 should be contacted via a call to an API 26" and "*[f]or instance*, the HTML document *may include* an embedded resource of the form" shown including the "$" tag example. *Id.*, 4:28-39.

Thus, Patent Owner's proposed construction is again doubly flawed because it reads limitations into the claim from an exemplary embodiment, while simultaneously ignoring the specification's other embodiments that describe the tag as merely playing some causal role in obtaining the modified embedded resource. *Id.* at 2:7-18 (explaining that in some embodiments the "tag" merely plays some causal relationship to "cause[] the embedded resource to [be] analyzed to construct a modified embedded resource …"); *Teleflex*, 299 F.3d at 1326 ("limitations from the specification are not to be read into the claims."); *Oatey*, 514 F.3d at 1276. This limiting construction should therefore be rejected.

2. The Combination of Verma and Lewin Teaches the "Tag" Limitations

Patent Owner's argument that Lewin's "tag" does not disclose the recited "tag" is premised on its incorrect construction of that term. *Supra* Section III.B.1. Absent this failed argument, Patent Owner cannot reasonably contend that the combination of Verma and Lewin do not render obvious the claimed "tag" and "upon identification of the tag, using at least one delivery parameter to obtain, by the origin system, a modified embedded resource from a content delivery network that is separate from the origin system." (EX-1001, claim 1).

The Petition explains in detail how the prior art discloses these limitations. Specifically, the Petition explains how Lewin's tags are parsed and identified to incorporate content chunks into the final page, which causes modified embedded resources to be fetched in combination with Verma. Paper 1, 52-56; *id.* at 55 (explaining "Lewin discloses a server 'parses the HTML page looking for tags that specify dynamic assembly instructions including, without limitation, URLs for HTML chunks to be incorporated in[to] the final HTML page'" and that "[p]arsing a page 'looking for tags' is identifying the tag") (quoting and citing EX-1007, [0049]; EX-1003 ¶234); *id.* (explaining "[b]ecause Lewin parses an HTML page looking for tags specifying instructions, and evaluates directives (tags) placed into HTML pages, the POSITA would have understood that the identification of the tag

initiated dynamic assembly, like incorporation of content 'into the final HTML page' and obtaining a modified embedded resource, like URLs on the HTML page.") (citing and quoting EX-1007, [0049]-[0050]; EX-1003 ¶234). Claim 1 requires no more than this causal relationship explained in the Petition such that upon identification of Lewin's tags, a modified embedded resource is obtained. *Supra* Section III.B.1.

The Petition also illustrates examples of URLs that are "'specif[ied]' by 'tags,' like a '<esi:include> tag,'" below. *See* Paper 1 at 47-48 (citing and quoting EX-1007, [0028], [0030], [0049]; EX-1003 ¶198).



FIG. 6

EX-1007, FIG. 6 (annotated, URLs in purple, tags in blue); Paper 1 at 47-48. Thus, the Petition explains in detail how Lewin's "tag" corresponds to the claimed "tag," and Patent Owner's contrary arguments fail.

3. The Petition Provides a Sufficient Motivation to Combine

Patent Owner also challenges the motivation "to modify Verma's existing markup scheme." Paper 5 at 28-29. But Patent Owner admits that Verma alone discloses tags in a markup language. *See id.* (discussing "Verma's standard HTML tags"). This only highlights that Verma and Lewin are analogous art, strengthening both the Petition's motivation to combine and the expectation of success. Indeed, Lewin and Verma both disclose markup languages, and Petitioner included Lewin in Ground 3 because it expressly discloses "tags" that are "parse[d]." *See, e.g.*, Paper 1 at 55.

The Petition sets forth a straightforward motivation to combine Lewin's teachings: tags identify embedded content to fetch and incorporate into a page, which would have been central to webpage development. *See, e.g.*, Paper 1 at 49-50 ("It would have been obvious for Verma's 'URL 28' to be embedded in an HTML page, and specified by a 'tag[],' for Lewin teaches a 'central' webpage development feature 'is the ability to fetch and include files that comprise a web page,' and 'tag[s]' 'may be used for this purpose.'") (citing and quoting EX-1003 ¶212; § II.D; EX-1005, [0025]; EX-1007, [0028], [0030], [0049]). To achieve this central feature

taught by Lewin, "[t]he POSITA would have understood Lewin's tags allow for identification of URLs, and would have wanted to incorporate tags in Verma to have a uniform and efficient way to identify URLs, like 'URL 28.'" Paper 1 at 50 (citing and quoting EX-1007, [0049]; EX-1005, [0025]; EX-1003 ¶¶213-217). Patent Owner's argument that Verma already discloses using a markup language is not a rebuttal to motivation to combine; it is merely an acknowledgement that Verma is analogous to Lewin. Paper 5 at 28-29.

Patent Owner finally attacks the "expectation of success of using Lewin's '<esi:include>' tags to replace Verma's standard HTML tags." Paper 5 at 29. This argument reads complexity into the combination where none exists. Petitioner discusses Verma's disclosure of tags in markup language to demonstrate the strong expectation of success in the combination. *See, e.g.*, Paper 1 at 50-52. Indeed, as explained in the Petition, "[u]sing tags was well-known, routine, and conventional by 2014." *Id.* at 5-7. As such, the Petition explains that "[m]arkup language tags were known to identify URLs in webpage design, as discussed, and it would have required no more than the application of conventional technology to designate an original URL (embedded resource) with a tag in a webpage (resource)." *Id.* at 51-52. Because Verma also discloses a "markup scheme," as Patent Owner admits (Paper 5 at 28-29), it would have been trivial to combine other markup language teachings, such as Lewin's teaching of tags that are parsed. Paper 1 at 49-52.

Thus, the Petition establishes a reasonable likelihood of prevailing on the merits.

IV. Google's Reliance on Expert Testimony Is Not Excessive or Improper

A. The Petition Does Not Rely on Expert Testimony to Fill Gaps

Google's expert testimony does not "fill in the gaps." Paper 5 at 30. Rather, the Petition submits that Verma anticipates or renders obvious four claims based on its own disclosures, and the remaining eleven claims in combination with Lewin, Raciborski, and/or Drai. Paper 1 at 34-82.

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* Paper 5 at 30. Indeed, 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, 418 (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's citation to *iRhythym* is inapposite. Patent Owner asserts that *iRhythym* "suggest[s] that identifying portions of expert testimony to fill gaps in the prior art weighs in favor of denial." Paper 5 at 30 (citing *iRhythym Techs. Inc. v.*

Welch Allyn, Inc., IPR2025-00363, Paper 10 at 2-3 (P.T.A.B. June 6, 2025)). But in *iRhythym*, the Director found that "Petitioner appears to rely on its expert to explain the background knowledge of a person of ordinary skill in the art, and the expert provides citations to evidence in support of his statements in the required manner," which "weighs against discretionary denial." *iRhythym*, IPR2025-00363, Paper 10 at 2-3. The same is true here.

Patent Owner's specific examples do not support its contentions. Paper 5 at 30-31. Regarding the "API," Patent Owner asserts that "Petitioner relies solely on its expert to fill the gaps" because the Petition states "[a] POSITA would have understood Verma's 'broker' is an API …." Paper 5 at 31 (quoting Paper 1 at 12). This is simply wrong because both the Petition and Dr. Mowry provide a detailed explanation as to *why* Verma's "broker" discloses the claimed "API"—"because it performs the same logical functions as the API in the '322 patent." Paper 1 at 11-12; EX-1003 at ¶ 87. In doing so, both the Petition and Dr. Mowry draw express comparisons between the '322 patent's disclosures and Verma. *See* EX-1003 at ¶ 87 (describing, with citations, the functionality of Verma's broker and the '322 patent's API, and explaining that "[a]s the API in the '322 patent provides an interface for communication between a content provider and content delivery network, so too does the 'broker' in Verma."); Paper 1 at 11-12 (similar). This is not gap filling. It is an explanation of how Verma discloses the same API as the '322 patent, even if it

uses different words. This is proper, and indeed, "the reference need not disclose the elements in the very same terms used by the patent" to anticipate the claim. *ADASA Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 910 (Fed. Cir. 2022); *see supra* Sections III.A.1-III.A-2 (explaining why Patent Owner's merits arguments regarding the "API" are incorrect).

Patent Owner also generally alleges that any reliance on an expert to explain how "[a] POSITA would have understood," "known," "considered it obvious," or "been motivated" amounts to gap filling in the prior art for Grounds 1A/1B, 2 3, 4, and 5. Paper 5 at 30-31. This is plainly incorrect. The Director's July 31, 2025, Memorandum affirmed that "general knowledge may still be used in an IPR to support a motivation to combine or to demonstrate the knowledge of a person having ordinary skill in the art." EX-1027 at 1 (citing *Unification Techs. LLC v. Micron Tech. Inc.*, No. 2023-1348, 2024 WL 3738401, at *7 (Fed. Cir. Aug. 9, 2024)).

B. Patent Owner Does Not Present Competing Expert Testimony with Its Request

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 5 at 31. But Patent Owner's assertion that it will file competing expert testimony does not substitute for actually presenting such testimony with its request. Patent Owner's arguments related to the teachings of the

prior art 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 "approximately 300 times, rather than providing a focused expert declaration addressing the limitations for which expert testimony is necessary." Paper 5 at 30. This argument should be rejected.

As an initial matter, Google's citations are expected given the 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 5 at 30-31, *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).

V. Institution Would Be an Efficient Use of the Board's Resources

Contrary to Patent Owner's argument (Paper 5 at 31-33), instituting review of the Petition's five grounds would be an efficient use of the Board's resources. Across fifteen claims and five grounds, Patent Owner only substantively disputes two claim elements. *Supra* Sections III, IV.B; Paper 5 at 19-30 (disputing the Petition's mappings of the "API" and "tag" elements). And as discussed above, even these positions lack merit. *Supra* Section III. Thus, the disputes for the Board to resolve are actually quite narrow. Given the lengthy patent term remaining for the '322 patent (*infra* Section VI.B; *supra* Section II.E), and the narrow nature of the disputes, instituting this Petition would be a highly efficient use of Board resources.

VI. Compelling Economic and Public Interest Concerns Favor Institution

A. Compelling Economic Interests Favor Institution

Compelling economic interests favor referral. Google's strong economic presence in the United States has contributed to American innovation for almost 30 years. EX-1029; *see also* EX-1030 (Google investments have facilitated innovation, supporting the 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-1031.

Patent Owner suggests Google's size favors denial here, but provides no explanation as to why that is the case. *See* Paper 5 at 33-34. 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-1023. 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 institution 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 5 at 33, 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-1028, 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 Institution

Compelling public interest factors also 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-1028, 39-40. The strong merits of the Petition suggest instituting would accomplish the AIA's goals of streamlining the litigation and reducing litigation costs.

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. *Supra* Sections V, VI.A. Conversely, there are substantial negative economic consequences to all parties and the public if the claims must be adjudicated again in more expensive and time-consuming litigation. Instituting would not only streamline the instant dispute between Patent Owner and Google, but also disputes involving

other parties.[3] Although the '322 patent is not presently asserted against other litigants, institution and a finding of unpatentability would prevent the Patent Owner from unjustifiably asserting the '322 patent against others in the future. As explained above, the '322 patent still has over eleven years of patent term remaining and could be asserted through 2042 considering retroactive damages. *Supra* Sections II.E, V; 35 U.S.C. § 286. Institution will streamline a substantial number of future disputes. *Id*.

VII. Settled Expectations Also Favor Referral

Patent Owner does not argue that it had settled expectations in the '322 patent, which was approximately six years old when Google filed its Petition.[4] *See generally* Paper 5. Patent Owner's silence regarding any settled expectations—despite having made this argument for its other six patents—is a tacit admission that it had none.

[3] In addition to Google, Patent Owner has asserted patents that relate to CDN servers (e.g., the '903 patent, and more) against Comcast Cable Communications, LLC in *Sandpiper CDN, LLC v. Comcast Cable Commc'ns, LLC*, No. 2:24-cv-00886 (E.D. Tex.) and against Microsoft in *Sandpiper CDN, LLC v. Microsoft Corp.*, No. 2:25-00664 (E.D. Tex.). EX-1025; EX-1026.

[4] Moreover, Patent Owner came into possession of the '322 patent in May 2024. *See* EX-1033 at 1, 4. It cannot assert it had settled expectations before its ownership.

This favors referral.[5] *See, e.g.*, *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 10 at 2-3 (P.T.A.B. June 26, 2025) (referring petition under a wholistic analysis and noting for a patent issued in 2019 that the patent had "not been in force for a significant period of time … and, accordingly, Patent Owner has not developed strong settled expectations").

On the other hand, Google had settled expectations that its Media CDN product, which launched in 2021, would not be accused of infringing the '322 patent

[5] The Director's application of "settled expectations" to deny institution 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).

after the original patent owner sat on it for years. Google's expectations were solidified when the current Patent Owner sued Google on six *other* CDN related patents in May 2024, but did not assert the '322 patent. EX-1022. Then, after waiting eight months, Patent Owner amended its complaint to add the '322 patent. EX-1034 ¶¶ 66-67. Google acted quickly and filed its Petition four months later. These facts favor referral. *See Berkshire*, IPR2025-00274, Paper 23 at 2-3 (referring petition where "Petitioners were diligent in filing the Petitions" and noting for a patent issued in 2019 "that Patent Owner has not developed strong settled expectations").

Patent Owner did not argue settled expectations because it had none in a six-year-old patent it acquired last year, and because its own delay (and that of its predecessor) gave Google the expectation that the patent would not be asserted. Settled expectations therefore favor referral.

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 18, 2025

Respectfully submitted,

/Erika H. Arner/
Erika H. Arner, Lead Counsel
Reg. No. 57,540

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 8,120 words, excluding those portions identified in 37 C.F.R. § 42.24(a).

/Erika H. Arner/
Erika H. Arner, Lead Counsel
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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 18, 2025, in its entirety on the following:

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