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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.

IPR2025-01010
Patent 10,057,322 B2

Before MITCHELL G. WEATHERLY, SHEILA F. McSHANE, and MICHAEL T. CYGAN, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Google, LLC ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–15 in U.S. Patent No. 10,057,322 B2 (Ex. 1001, "the '322 patent") under 35 U.S.C. §§ 311–319. Paper 1 ("Pet."). Sandpiper CDN, LLC ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). The parties jointly requested a conference with the Board to discuss a request from Petitioner for further briefing on claim construction, which was opposed by Patent Owner. Ex. 3103. The Board and parties held a conference on October 3, 2025, to discuss that request

Petitioner requests authorization to file a six-page Reply to the Preliminary Response to address Patent Owner's implicit claim constructions for the "modified embedded resource," "application programming interface (API)," and "tag" limitations that were unforeseeable because they improperly incorporate limitations from the specification and overly rely on new extrinsic evidence. Petitioner cites to the Preliminary Response at 18 ("Petitioner fails to show … a 'modified embedded resource' as claimed—e.g., as a modified resource embedded within the client's HTML page"), 19 ("[A]s the '322 patent describes and claims, the 'modified embedded resource' is a resource embedded within another resource, such as an HTML document."), 22 (citing extrinsic evidence to argue "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") ("In the context of the '322 patent, the 'API' acts as a bridge between the origin server and the compute engine"); 28 ("The '322 patent further explains that '[t]he embedded resource may include a tag indicating that a resource address computing engine should be contacted….'").

Patent Owner opposes Petitioner's request as there were no "implicit claim constructions" in the Preliminary Response. Patent Owner contends that the arguments presented in the Preliminary Response address the express language of the claims under their plain and ordinary meaning. Patent Owner further contends that it was not unforeseeable that Patent Owner would argue that the prior art does not teach the limitations of the challenged claims based on their ordinary meanings, including the "modified embedded resource," "application programming interface (API)," and "tag" limitations. *See, e.g., Micron Tech., Inc. v. Yangtze Memory Techs. Company, LTD.*, IPR2024-00792, Paper 12 at 2 (PTAB Sep. 11, 2024). Patent Owner contends that the Board is capable of evaluating Petitioner's and Patent Owner's arguments for purposes of an institution decision based on the Petition and POPR, and Petitioner's disagreement with Patent Owner's arguments does not amount to good cause for allowing additional briefing on the merits.

During the October 3, 2025, conference, Petitioner argued that Patent Owner provided a construction of the aforementioned terms in its Preliminary Response that was unforeseeable at the time the Petition was filed because that construction violated core construction principles. Patent Owner argued that it did not provide any construction of the aforementioned terms but admitted that it did refer to the '322 Specification for interpreting those terms under their plain and ordinary meaning. Petitioner indicated that it desires to provide further citations to areas of the '322 Specification that support a broader interpretation of the aforementioned terms. Petitioner further indicated that such further citations are important to the issue of

institution because each of Patent Owner's arguments in the Preliminary Response rests on the contested constructions.

Having considered these arguments and reviewing the issues presented in the Preliminary Response, we determine that limited briefing on the support in the '322 patent for the aforementioned terms is appropriate.

For institution, Petitioner has the burden of persuasion, and in particular, the burden to explain how the challenged claims are to be construed. *See* 37 C.F.R. § 42.104(b)(3). During the October 3, 2025, conference, Petitioner stated that its Petition provided an explanation of the plain and ordinary meaning of each of the aforementioned terms, and that such a plain and ordinary meaning suffices for purposes of its contentions in the Petition. Patent Owner's argument that Petitioner should not be allowed additional briefing merely due to a disagreement with Patent Owner's positions has some merit because it reflects both the Petitioner's burden and the turn-based approach of pre-institution briefing in *inter partes* review.

Where the parties raise an actual dispute regarding the proper scope of claims, the Board must resolve that dispute, including, where necessary, construction of disputed terms. *Homeland Housewares, LLC v. Whirlpool Corp.*, 865 F.3d 1372, 1375 (Fed. Cir. 2017)*; see also Bayer Pharma Aktiengesellschaft v. Mylan Pharms. Inc*., No. 2023-2434, 2025 WL 2698408, at *3–4 (Fed. Cir. Sept. 23, 2025) (remanding a Final Written Decision to the Board "for further consideration of [Petitioner's] obviousness arguments under the correct construction"). To perform such a claim construction analysis, it is "proper to treat the ultimate question of the proper construction of the patent as a question of law," and where "a written instrument uses 'technical words or phrases not commonly understood,' . . .

those words may give rise to a factual dispute." *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 325–26 (2015). *Inter partes* review does not limit claim construction arguments to those made in the Petition, but permits construction to be based on arguments by a Petitioner responsive to constructions proposed by a patent owner or by the Board. *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1381 (Fed. Cir. 2023).

It is apparent from the discussion in the conference that a factual dispute has been raised in the Preliminary Response concerning the scope of the aforementioned terms. In particular, that dispute centers on whether the citations to the Specification provided by Patent Owner accurately reflect the full scope of the plain meaning of the aforementioned terms. Because the scope of the aforementioned terms is in dispute, some measure of claim construction may be required to determine whether Petitioner has met its burden for institution.

As Patent Owner notes, the Board is often capable of evaluating the parties' arguments without need for additional briefing. However, review of the use of the aforementioned terms in the '322 patent claims and the '322 patent Specification indicates that additional briefing by the parties will assist in evaluating the Petitioner's unpatentability assertions.

Accordingly, the Board determines that limited claim construction briefing on the three terms identified by Petitioner is the proper course of conduct in this proceeding, and we authorize such briefing pursuant to our authority under 37 C.F.R. § 42.5(a) as construed by § 42.1(b) "to secure the just, speedy, and inexpensive resolution" of this proceeding. Petitioner is therefore permitted to file a Reply to Patent Owner's Preliminary Response, limited to addressing Patent Owner's scope of the aforementioned terms

through reference to portions of the ’322 Specification. Additionally, we grant Patent Owner’s request to file a responsive Sur-reply of the same length, limited to the issues addressed in Petitioner’s Reply.

ORDER

Accordingly, it is

ORDERED that no later than five business days after the date of this order, Petitioner may file a Preliminary Reply no longer than six pages limited to the construction of the terms “modified embedded resource,” “application programming interface (API),” and “tag” through arguments based upon the use of those terms in the ’322 Patent claims and specification;

FURTHER ORDERED that no later than five business days after the filing of the Preliminary Reply, Patent Owner may file a Preliminary Sur-reply no longer than six pages that responds to the Preliminary Reply; and

FURTHER ORDERED that Petitioner may not file any new evidence with the Preliminary Reply and Patent Owner may not file any new evidence with the Preliminary Sur-reply.

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