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Paper 13
Date: September 12, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

GOOGLE LLC,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

IPR2025-00806 (Patent 8,645,517 B2)
IPR2025-00826 (Patent 9,021,112 B2)

Before KALYAN K. DESHPANDE,[1] *Acting Chief Administrative Patent Judge*.

DECISION
Referring the Petitions to the Board

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[1] Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office, is recused and took no part in this decision. The Acting Director has delegated her authority in a Notice of Delegation. *See* https://www.uspto.gov/sites/default/files/documents/deshpande-delegation-letter.pdf.

Sandpiper CDN, LLC ("Patent Owner") filed a request for discretionary denial (Paper 6, "DD Req.") in the above-captioned cases, and Google LLC ("Petitioner") filed an opposition (Paper 9, "DD Opp.").[2] With authorization, Patent Owner filed a Reply (Paper 12).

After considering the parties' arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the parallel district court proceeding involving the parties has been stayed pending a decision whether to institute review of Petitioner's *inter partes* review (IPR) requests. Ex. 2006. As such, 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 resulting from two proceedings operating in parallel. This counsels against discretionary denial.

Further, Patent Owner argues it has settled expectations because the challenged patents "have been in force for many years." DD Req. 14. Petitioner, on the other hand, persuasively argues that the challenged patent in IPR2025-00806 expired in 2023, and the challenged patent in IPR2025-00826 expired in 2021, and, accordingly, it expected non-enforcement of the challenged patents.[3] DD Opp. 12–13; *see Globus Med., Inc. v. Spinelogik,*

[2] Citations are to papers in IPR2025-00806. The parties filed similar papers in IPR2025-00826.

[3] Patent Owner did not acquire the challenged patents until after they expired. DD Opp. 8–12, 16–17; *see Apple Inc. v. Ferid Allani,* IPR2025-00856, Paper 11, 3 (Director Sept. 5, 2025) (noting that "Patent Owner did not assert the challenged patents against Petitioner until after they expired.").

Inc., IPR2025-00226, Paper 8 at 2 (Director June 12, 2025). As such, based on Petitioner's arguments, discretionary denial is not appropriate.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are referred to the Board to handle the cases in the normal course, including by issuing decisions on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's requests for discretionary denial are *denied*;

FURTHER ORDERED that the Petitions are referred to the board; and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

IPR2025-00806 (Patent 8,645,517 B2)
IPR2025-00826 (Patent 9,021,112 B2)

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