

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner

v.

SANDPIPER CDN, LLC,
Patent Owner

Case IPR2026-00174
U.S. Patent No. 9,762,692

**PATENT OWNER'S
PRELIMINARY SUR-REPLY**

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I. INTRODUCTION

At bottom, the Petition asks the Director to revisit the original Examiner's correct decision to allow the '692 patent over the same art presented in Petitioner's challenges (Seed and Swildens). Contrary to Petitioner's misleading argument, the Board's new rejection after appeal was considered when the application was returned to the Examiner who determined the amended claims were allowable over the art of record, including Seed and Swildens. *See* EX1002, 2361-2369. Further, Sandpiper's Preliminary Response (Paper 9; "POPR") demonstrates that neither Seed nor Swildens teaches the claimed "distinct" portions. POPR, 19-22. In the POPR, Sandpiper also demonstrates that Seed and Swildens do not teach additional claimed features. POPR, 22-38. Petitioner is wrong when it states these arguments cause a "dispute that is best addressed with a full record." *Contra* Paper 12 ("Reply"), 2-3. Rather, the POPR presents clear reasoning, supported by an expert and evidence, that demonstrates Petitioner fails to meet its burden for institution.

II. ARGUMENT

A. The Examiner properly allowed the '692 patent.

Petitioner's allegation that the '692 patent issued over an unaddressed rejection by the Board is unfounded. The Examiner was required to consider the Board's new ground of rejection (M.P.E.P. § 1213.02) and there is no evidence the Examiner failed to follow proper procedure here. Upon return of the application to the Examiner, the Patent Owner was given an opportunity to address the rejection,

an interview was conducted, and the Examiner entered amendments that put the application in condition for allowance. EX1002, 2361-2369. Specifically, the Examiner found “the claimed invention requires ‘separate’ and ‘distinct’ portions of a content library,” and this feature is not disclosed in the prior art of record (including Seed and Swildens). EX1002, 2368. Thus, despite Petitioner’s argument that the “distinct” portions are an optional part of claim 15, the Office has already determined otherwise. To be sure, the Examiner’s findings were reasonable because claim 15 recites “[a] method of content delivery in a content delivery network comprising a plurality of tiers of servers, including at least a first tier of servers and a second tier of servers ... wherein [the] second tier server comprises a second portion of the content provider’s library distinct from the first portion.” That Petitioner disagrees with the Examiner’s reasonable interpretation is not reason to institute this IPR. *Accord Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 9 (PTAB Feb. 13, 2020) (precedential).

B. Petitioner fails to show numerous claimed features are obvious.

The POPR explains why neither combination using Seed and Swildens teaches at least the “first portion of the content provider’s library is distinct from the second portion” (“distinct portions”), as recited in claim 1 and similarly recited in claims 10 and 15. POPR, 19-22. As pointed out by Sandpiper, the Petition does

not cite to any express disclosure of Seed that discloses this feature, but rather relies on expert testimony to fill the gap. Pet., 25. Indeed, the Petition's deficiency is consistent with both the Examiner and the Board's prior determination that Seed does not disclose the claimed distinct portions. POPR, 19. Sandpiper explains in detail why Swildens also fails to disclose this feature and supports its analysis with Dr. Shenoy's testimony. POPR, 20-22. Petitioner's attorney argument that the servers do not have "common storage," Reply, 2, falls far short of creating a genuine dispute with Sandpiper's analysis and Dr. Shenoy's testimony.

Petitioner's arguments on the other limitations, Reply 2-3, fail for the same reason. Again, Sandpiper's analysis is detailed, based on the claim language, and supported by the evidence of record and expert testimony. POPR, 22-37.

Petitioner's complaint that the Seed arguments were not made before the Board is entirely irrelevant because Patent Owner was not required to present all possible arguments and there was no concession that Seed teaches these claim elements (which it does not). Moreover, Petitioner has the burden here, which it fails to meet. And Petitioner does not address, much less rebut, the identified instances where the Petition improperly relies on expert testimony. POPR, 38.

III. CONCLUSION

Petitioner does not meet its burden to show the challenged claims are unpatentable. Thus, the Director should deny institution.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg
Registration No. 43,447
Attorney for Patent Owner Sandpiper CDN, LLC

Date: April 24, 2026

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S PRELIMINARY SUR-REPLY** was served in their entirety on April 24, 2026, upon the following parties via electronic mail:

Jessica Kaiser (Lead Counsel) kaiser-ptab@perkinscoie.com
Christopher Marando (Back-Up Counsel) marando-ptab@perkinscoie.com
Matthew Lembo (Back-Up Counsel) lembo-ptab@perkinscoie.com
Steven Beigelmacher (Back-Up Counsel) beigelmacher-ptab@perkinscoie.com
Sarah Fowler (Back-Up Counsel) stahnke-ptab@perkinscoie.com
Microsoft-Sandpiper-IPR@perkinscoie.com
PERKINS COIE LLP

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg
Registration No. 43,447
Attorney for Patent Owner Sandpiper CDN, LLC

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