From:	Director_Discretionary_Decision
To:	Jason Eisenberg; Trials; Director_Discretionary_Decision
Cc:	Marando, Christopher (WDC); PTAB Account; kaiser-ptab@perkinscoie.com; lembo-ptab@perkinscoie.com; Beigelmacher-ptab@perkinscoie.com; Fowler-ptab@perkinscoie.com; Microsoft-Sandpiper-IPR@perkinscoie.com; Daniel Block; Kristina Caggiano Kelly; Daniel Block; stahnke-ptab@perkinscoie.com; beigelmacher-ptab@perkinscoie.com; Kristina Caggiano Kelly; lembo-ptab@perkinscoie.com; marando-ptab@perkinscoie.com
Subject:	RE: IPR2026-00180: Document(s) Filed - Microsoft Corporation v. Sandpiper CDN, LLC
Date:	Friday, March 20, 2026 10:10:53 AM
Attachments:	image001.png image002.png

Patent Owner may file the corrected brief and should do so by COB today.

Paper 6 has been expunged.

From: Jason Eisenberg <jasone@sternekessler.com>
Sent: Thursday, March 19, 2026 12:06 PM
To: Trials <Trials@USPTO.GOV>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Marando, Christopher (WDC) <CMarando@perkinscoie.com>; PTAB Account <PTAB@sternekessler.com>; kaiser-ptab@perkinscoie.com; lembo-ptab@perkinscoie.com; Beigelmacher-ptab@perkinscoie.com; Fowler-ptab@perkinscoie.com; Microsoft-Sandpiper-IPR@perkinscoie.com; Daniel Block <DBLOCK@sternekessler.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Daniel Block <DBLOCK@sternekessler.com>; stahnke-ptab@perkinscoie.com; beigelmacher-ptab@perkinscoie.com; Kristina Caggiano Kelly <kckelly@sternekessler.com>; lembo-ptab@perkinscoie.com; marando-ptab@perkinscoie.com
Subject: RE: IPR2026-00180: Document(s) Filed - Microsoft Corporation v. Sandpiper CDN, LLC

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Director,

Patent Owner respectfully requests authorization to file a corrected version of its Patent Owner's Brief on Discretionary Denial to correct a clerical error. After meet-and-confers between the parties from March 13th until today, Petitioner indicated that it does not oppose this request. Further information regarding Patent Owner's and Petitioner's respective positions is provided below.

Patent Owner's Position

Patent Owner respectfully requests authorization to file a corrected version of its Patent Owner's Brief on Discretionary Denial to correct a clerical error. The filed Brief inadvertently and incorrectly stated that the '173 Patent is asserted in a district court case against Comcast.

Sandpiper has multiple different law firms working on its related matters who all have limited ability to communicate due to ethical walls at the time of the filing of the Brief, and this clerical error just resulted from a miscommunication or misunderstanding about which patents were asserted in other forums.

The correct overlap in the Office between the Microsoft and Comcast cases is

8,478,903 IPR2026-00095
9,762,692 IPR2026-00174

And the overlap in the Office between the Google, Comcast, and Microsoft cases is

8,478,903 IPR2026-00095
8,478,903 IPR2005-00969

The corrections noted below remove all references to the Comcast litigation and do not affect the substance of the Brief in any other respect.

Page	Change
1	Delete: ~~The '173 patent is also asserted against Comcast—who is also litigating validity—with trial set for nearly a *year* before the Final Written Decision date for this Petition.~~
6-7	Change: ~~either of two pending~~ <u>The</u> district court <u>case</u> ~~cases~~ (*Sandpiper v. Microsoft*, Case No. 2:25-cv-00664 (EDTX) ~~or *Sandpiper v. Comcast*, Case No. 2-24-cv-00886 (EDTX)~~) presents a more efficient and faster forum to resolve the parties' dispute
7-8	Delete: ~~Additionally, there is no stay in the co-pending *Sandpiper v. Comcast* case, which will also adjudicate the validity of the '173 patent, and is scheduled for trial a year before the anticipated Final Written Decision here. *See Sandpiper CDN, LLC v. Comcast Cable Communications, LLC d/b/a Xfinity*, No. 2:24-cv-00886-JRG-RSP, Dkt. 31 (E.D. Tex. Feb. 6, 2025).~~
8	Delete: ~~It is also nearly a year after trial will be completed in the *Sandpiper v. Comcast* district court litigation, in which the validity of the challenged patent is also being litigated. *See Sandpiper v. Comcast*, No. 2:24-cv-00886-JRG-RSP, Dkt. 31.~~

Patent Owner is prepared to file the corrected Brief immediately upon authorization.

<u>Petitioner's Position</u>

Petitioner does not oppose Patent Owner's request to file a corrected version of its discretionary denial brief. However, Petitioner notes that it brought this issue to Patent

Owner's attention. Petitioner also notes that Patent Owner's discretionary denial brief in this IPR includes a new argument based on the Comcast case that was not included in earlier-filed briefs. Patent Owner argued here that the Comcast case supports denial under *Fintiv* factor 1 (Paper 6, 7-8, reproduced above), but Patent Owner did not argue in either IPR2026-00095 or IPR2026-00174 that the Comcast case supported denial under that factor. *See* IPR2026-00095, Paper 9, 7 ("*Fintiv* Factor 1 favors denial. There is no stay of proceedings in the parallel district court case, and no evidence that a stay would be likely. Trial is set for April 5, 2027. Factor 1 therefore favors denial."); IPR2026-00174, Paper 7, 10 ("Factor 1 strongly favors denial because there is no stay of the proceedings in the parallel district court case and there is a high probability that the district court will not stay its proceedings pending conclusion of an IPR. Indeed, Judge Gilstrap (the assigned district court judge in the EDTX) has denied close to 85% of all stay requests. EX2004. There is no indication that Judge Gilstrap would depart from his usual practice and grant a stay here."). Petitioner's decision not to oppose does not signal agreement with Patent Owner's claim that the incorrect statements about the '173 patent were inadvertent. Patent Owner's claim of inadvertence is undermined by the inclusion of a new argument, and Patent Owner—as the party litigating the Comcast case—was in the position to know that the '173 patent was not asserted.

Petitioner reserves the right to request additional time to respond to Patent Owner's corrected discretionary denial brief.

+++

Thank you
Best regards,
Jason Eisenberg, Counsel for Patent Owner

Sterne Kessler
STERNE KESSLER GOLDSTEIN & FOX

Jason Eisenberg (He/Him/His)
Director, Chair Reissue, Reexamination and Supplemental Examination Practice
Sterne, Kessler, Goldstein & Fox P.L.L.C.
1101 K Street, NW, 10th Floor,, Washington, DC 20005

Email: jasone@sternekessler.com
Direct: 202.772.8645;
Mobile: 301.448.9871

Director. Chair Reissue, Reexamination and Supplemental Examination Practice
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: jasone@sternekessler.com
Mobile: 301.448.9871 **Office Direct:** 202.772.8645

From: PTACTS_System@uspto.gov <PTACTS_System@uspto.gov>
Sent: Thursday, March 5, 2026 4:24 PM
To: Jason Eisenberg <jasone@sternekessler.com>; kaiser-ptab@perkinscoie.com
Cc: Daniel Block <DBLOCK@sternekessler.com>; stahnke-ptab@perkinscoie.com; beigelmacher-ptab@perkinscoie.com; Kristina Caggiano Kelly <kckelly@sternekessler.com>; lembo-ptab@perkinscoie.com; marando-ptab@perkinscoie.com
Subject: IPR2026-00180: Document(s) Filed - Microsoft Corporation v. Sandpiper CDN, LLC

EXTERNAL EMAIL: Use caution before clicking links or attachments.

UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT TRIAL AND APPEAL BOARD

Document Filing Notice

AIA Review No.: IPR2026-00180
Petitioner: Microsoft Corporation of , WA
Patent Owner: Sandpiper CDN, LLC of , DE
Patent No.: 10701173
Submitted Date: 03/05/2026
Submitted By: Jason Eisenberg, jasone-ptab@sternekessler.com

The following document(s) has/have been filed.

Document(s) List

No.	Document No.	Document Type	Document Name	Filing Party	Availability
		PO	Patent Owner's	Patent	Available

1	6	Discretionary Denial Brief	Discretionary Denial Brief	owner	for everyone.
2	2001	Exhibit	EX2001 - First Amended Docket Control Order 2_25-cv-00664-32	Patent owner	Available for everyone.
3	2002	Exhibit	EX2002 - Subject Matter Ineligibility Contentions	Patent owner	Available for everyone.
4	2003	Exhibit	EX2003 - Interim Memo	Patent owner	Available for everyone.
5	2004	Exhibit	EX2004 - Gilstrap Motion to Stay	Patent owner	Available for everyone.
6	2005	Exhibit	EX2005 - Complaint EDTX-2-25-cv-00664-1	Patent owner	Available for everyone.
7	2006	Exhibit	EX2006 - MSFT Invalidity Cont Cover Pleading	Patent owner	Available for everyone.
8	2007	Exhibit	EX2007 - U.S. Publication No. 2006/0095532 (O'Rourke)	Patent owner	Available for everyone.
9	7	Notice: Updated Mandatory Notice	Patent Owner's Updated Mandatory Notices	Patent owner	Available for everyone.

Questions regarding this receipt should be directed to the Patent Trial and Appeal Board at 571-272-7822 or e-mail to Trials@uspto.gov.

This e-mail is computer-generated. Do not reply to this e-mail because the e-mail box is not monitored.