

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner

v.

SANDPIPER CDN, LLC,
Patent Owner

Case IPR2026-00180
U.S. Patent No. 10,701,173

**PATENT OWNER'S CORRECTED BRIEF ON
DISCRETIONARY DENIAL**

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	First Amended Docket Control Order, <i>Sandpiper CDN, LLC v. Microsoft Corporation</i> , Case No. 2:25-cv-00664-JRG-RSP (E.D. Tex.), October 17, 2025
2002	Exhibit E101 to Microsoft's Invalidity Contentions (Subject Matter Ineligibility Contentions for U.S. Patent No. 9,762,692), <i>Sandpiper CDN, LLC v. Microsoft Corporation</i> , Case No. 2:25-cv-00664-JRG-RSP (E.D. Tex.), December 5, 2025
2003	"Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in <i>Inter Partes</i> Reviews," United States Patent and Trademark Memorandum, July 31, 2025
2004	Success Rate of Motions to Stay Pending <i>Inter Partes</i> Review before Judge Rodney Gilstrap, Docket Navigator Report generated February 4, 2026
2005	Complaint for Patent Infringement, <i>Sandpiper CDN, LLC v. Microsoft Corporation</i> , Case No. 2:25-cv-00664-JRG-RSP (E.D. Tex.), June 26, 2025
2006	Microsoft's Invalidity Contentions, <i>Sandpiper CDN, LLC v. Microsoft Corporation</i> , Case No. 2:25-cv-00664-JRG-RSP (E.D. Tex.), December 5, 2025
2007	U.S. Patent Publication No. 2006/0095532 ("pub-O'Rourke")

TABLE OF AUTHORITIES

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<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).....	13, 14, 16, 17
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	1, 7, 9, 10
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I. INTRODUCTION

The Director should deny institution of *inter partes* review of U.S. Patent No. 10,701,173 (“the ’173 patent”) for multiple reasons that make clear it would not be a good use of the Board’s resources to reconsider the patentability of the challenged claims. *First*, the *Fintiv* factors strongly favor denial. Trial in the parallel litigation is scheduled for over two months *before* the projected Final Written Decision date for this Petition. *Second*, Sandpiper has settled expectations in the ’173 patent. It has been in force for 5 years, which is close to the time for which settled expectations tends to be dispositive. Moreover, Petitioner Microsoft has known about the patent for years.

Additionally, the Office already expended substantial resources on this patent during initial prosecution when the same art and arguments used in Microsoft’s challenges were considered by the Examiner and over which the claims were determined to be allowable. Accordingly, the Petition also warrants denial under 35 U.S.C. § 325(d).

The Petition also suffers from numerous weaknesses on the merits, failing to identify disclosure of multiple claim elements in the cited art. These failures are discussed in detail in the Patent Owner’s Preliminary Response. This lack of disclosure, in turn, causes the Petition to rely heavily on expert testimony to supply missing elements in the cited art, contravening Petitioner’s requirement to specify

where each element of the claim is found in the prior art patents or printed publications relied upon under 37 C.F.R. § 42.104(b)(4). These flaws further favor discretionary denial.

II. BACKGROUND

The challenged patent arises from pioneering technology directed to delivering content across a network. Content delivery networks (CDNs) provide critical services that enable content providers to quickly deliver online content to millions of consumers simultaneously over the Internet. The technology underlying these CDNs was made possible through a series of inventions developed by a California start-up called Sandpiper Software Consulting, LLC, a predecessor of Patent Owner Sandpiper CDN, LLC.

In the early 1990s, the internet became a household staple. This mass adoption led to data congestion issues from the ever-growing number of users seeking to simultaneously access Internet content. Sandpiper's solution was to deploy CDN servers around the world, replicate appropriate content from origin servers to appropriate CDN servers, and transparently rendezvous end users requesting that content to the "best" CDN server to deliver that content, all while providing their customers with control over their content and user experience. This architecture was quickly imitated by many others in the industry.

Distributing content across a network of servers alleviated data congestion issues, allowing consumers to connect to edge servers located near them, which reduced latency. The inventors developed and built systems and methods for propagating data from origin servers to edge servers based on network demand and for seamlessly routing users to the optimal edge server with the correct content.

Recognizing that the groundbreaking inventions of Sandpiper Networks (and its successor companies) could revolutionize content delivery worldwide, Level 3 Communications (“Level 3”) acquired the Sandpiper Networks CDN and patent assets in 2006, while onboarding several of the founders and inventors on the original Sandpiper Networks patents. Thereafter, Level 3 continued to file numerous patent applications directed to this foundational CDN technology, including the patent challenged in the Petition.

Petitioner Microsoft was well aware of the Sandpiper Networks patents at this time. In fact, Petitioner Microsoft Corp. competed with Level 3 in a bidding war to acquire Sandpiper’s patent portfolio. But Level 3 won the bid, at which point Microsoft became a CDN customer of Level 3 for several years before choosing to build its own CDN network without owning or obtaining a license to the Sandpiper patents.

Other businesses also entered the market by misappropriating Sandpiper’s innovations and directly competing with Sandpiper for market share. Ultimately,

Level 3 sold its CDN patents, including the patent challenged in this Petition, to Patent Owner, Sandpiper CDN, LLC.

III. OVERVIEW OF THE '173 PATENT AND COMPREHENSIVE PROSECUTION HISTORY

The '173 patent is entitled “Caching in a Content Delivery Framework,” and was filed as U.S. Application No. 15/588,935 on May 8, 2017. It is a continuation of U.S. Patent No. 9,648,127 filed on December 15, 2014. The '173 patent is directed to improvements in CDN technology, specifically addressing how CDNs manage caching policies, prevent stale content from being served, and handle subscriber-specific caching controls. CDN caches store copies of subscriber content so that end-user requests can be served by CDN nodes.

Embodiments of the '173 patent address technical issues with handling requests and timely providing content. The '173 patent describes enhancing this process by dynamically determining the appropriate caching policy at the time a request for content is received, enabling the CDN to honor up-to-date rules while improving efficiency and flexibility. The inventors pioneered the described unconventional technical solutions for maintaining content freshness and enforcing subscriber-specific caching directives in a scalable, low-overhead manner to address problems associated with stale content, inconsistent policy application, and the operational burden of widespread invalidations.

The '173 patent was given a thorough examination and included consideration of a reference used in Microsoft's challenges here (O'Rourke). Via Information Disclosure Statements, Patent Owner cited O'Rourke, the published application of O'Rourke ("pub-O'Rourke"), and an International Preliminary Report on Patentability (IPRP) that applied pub-O'Rourke to Patent Owner's then-pending claims (on anticipatory grounds). EX1002, 278-284, 304. Along with issuance of the first Office Action, the Examiner indicated they considered O'Rourke, pub-O'Rourke, and the IPRP. EX1002, 272, 277. The Examiner, after being presented with the IPRP containing anticipatory arguments based on pub-O'Rourke, chose to issue a different anticipation rejection using a different reference (US 9,984,166). EX1002, 262-270. A nonstatutory double patenting (NDP) rejection with respect to the issued parent was also issued. *Id.* Patent Owner responded with rebuttal arguments. EX1002, 250-258.

Thereafter, a series of Office Actions and responses ensued, involving an obviousness rejection (relying on a combination of US 9,984,166 and US 2015/0347248), an Examiner interview, Request for Continued Examination, Patent Owner's submission of a terminal disclaimer, and amendments to the claims. EX1002, 104, 128-136, 139, 142-155, 160-168, 171-182, 186-192, 208-220, 232, 238-247. Amendments included the addition of "(B)(l) determining, by the node, a current cache policy associated with the content, wherein determining

the current cache policy comprises determining a time period for expiration of content in the cache” to the independent claims. EX1002, 112-114. After these amendments, the Examiner entered a Notice of Allowance. EX1002, 18-25.

Patent Owner then paid the issue fee and the patent issued. The Office has therefore already expended extensive resources and attention on confirming the patentability of the challenged claims—including over O’Rourke that is a basis for Microsoft’s challenges here.

IV. LEGAL STANDARDS

It is Petitioner’s burden to demonstrate unpatentability by a preponderance of the evidence. The Petition must establish, with particularity, the grounds and evidence that support invalidating the patented claims. 35 U.S.C. § 312(a)(3). Petitioner “must ‘specify where each element of the claim is found in the [relied upon] prior art patents.’” *In-Depth Geophysical, Inc. v. ConocoPhillips Co.*, IPR2019-00850, Paper 56 at 27 (P.T.A.B. Sept. 3, 2020) (quoting 37 C.F.R. § 42.104(b)(4)).

V. THE PETITION WARRANTS DISCRETIONARY DENIAL FOR MULTIPLE REASONS.

The Director should exercise discretion to deny institution under 35 U.S.C. § 314(a) for multiple independent reasons, including: (A) pending district court case (*Sandpiper v. Microsoft*, Case No. 2:25-cv-00664 (EDTX)) presents a more efficient and faster forum to resolve the parties’ dispute; (B) Sandpiper has settled

expectations in the challenged patent; (C) the Office has already considered similar art and arguments during prosecution; and (D) the Petition improperly ignores Board regulation and guidance by relying on expert testimony to fill gaps in the prior art.

A. The *Fintiv* Factors weigh in favor of denial.

All the *Fintiv* factors favor or strongly favor denying institution. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (articulating six non-exclusive factors for determining whether to institute an AIA post-grant proceeding where there is parallel litigation).

1. Factor 1 favors denial because the EDTX district court case is not likely to grant a stay.

Factor 1 strongly favors denial because there is no stay of the proceedings in the parallel district court case (*Sandpiper v. Microsoft*) 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.

2. Factor 2 strongly favors denial because the district court trial date will occur months before the projected Final Written Decision.

Factor 2 strongly favors denial. The projected statutory deadline for a Final Written Decision (FWD) in this IPR is July 2, 2027.¹ This is more than *three months* after the April 5, 2027 trial date in the EDTX. EX2001, 1. Institution of an IPR under these circumstances—when the parallel district court trials will occur much faster than the issuance of a decision by the Board—would not be consistent with the AIA’s objective to provide an effective and efficient alternative to litigation. *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (P.T.A.B. Sept. 12, 2018) (precedential).

3. Factor 3 favors denial because there has been significant investment in the district court.

Factor 3 favors denial. The relevant consideration is the “amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv*, 9 (emphasis added). The deadline for issuing a Decision on Institution (DI) in this IPR is approximately July 3, 2026. By this date, significant work will have been done in the parallel district court litigation, including the exchange of invalidity and infringement contentions,

¹ This date assumes the Board will issue an institution decision on July 3, 2026.

extensive fact discovery, and the exchange of claim construction positions.

EX2001.

4. Factor 4 favors denial because Microsoft’s *Sotera* stipulation does little to mitigate concerns of inefficiency and duplication of effort.

Factor 4 considers the overlap between the issues raised in the IPR petition and in the parallel proceeding in order to evaluate “concerns of inefficiency and the possibility of conflicting decisions.” *Fintiv*, 12. This factor also strongly favors denial.

In the parallel district court proceeding, Microsoft submitted invalidity contentions that completely overlap with its IPR challenges. *Compare* EX2006, 191, 212-213 (asserting the claims are obvious over O’Rourke and Middleton) *with* Pet., 2 (challenging the claims based on O’Rourke and Middleton). In district court, Microsoft further challenges the claims on numerous additional anticipation and obviousness grounds. EX2006, 191-245.

Further, Microsoft’s *Sotera* stipulation (Exhibit 1022) does little to mitigate concerns of inefficiency or duplication of effort such that “th[is] IPR proceeding[] would be a ‘true alternative’ to the district court proceeding.” *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025) (on Director Review vacating panel’s institution decision and denying under *Fintiv*). Microsoft’s stipulation does not preclude the use of O’Rourke and Middleton in

combination with system art. *See* EX1023. Indeed, Petitioner’s invalidity contentions specifically include contentions that combine O’Rourke and Middleton with system art, such as Windows Media Services 9, Squid, HTTP/1.1 and Akami EdgeSuite. *See* EX2006, 45, 191-192, 212, 215-217, 222-223, 237-240, 243-244.

Thus, even if this IPR is instituted, it will not be a “true alternative” to the parallel proceeding because the district court judge and jury will still have to decide complex invalidity issues based on the same art used in this IPR in combination with system art. *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. March 28, 2025) (finding that a *Sotera* stipulation was unlikely to moot the petitioner’s combination of IPR art with unpublished system prior art in district court proceedings, and therefore could not outweigh other factors favoring denial). Petitioner’s stipulation also does not prevent it from pursuing its contentions that all of the claims challenged in the Petition are invalid under §§ 101 and 112 (EX2006, 250; EX2002), which further exacerbates the inefficiencies and potential for inconsistent results (e.g., different claim constructions) that would result from allowing Petitioner to proceed in both forums. Accordingly, factor 4 strongly favors denial.

5. Factors 5 and 6 favor denial because the parties in the IPR overlap with the parties in the district court and the merits are weak.

Factor 5 favors denial because the parties are the same in both proceedings. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 (P.T.A.B. May 13, 2020) (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

Factor 6 also favors denial because, as will be explained further in the Patent Owner Preliminary Response (“POPR”), the Petition fails to establish that the challenged claims are invalid over the asserted Grounds. Patent Owner asks the Director to consider the briefing presented in its POPR. *See* Interim Process, § II.C.i (patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits). Further, as discussed in Section V.D below, the Petition improperly relies on expert testimony to fill gaps in its challenges.

B. Settled expectations favor denial because the ’173 patent has been in force for over five years and Microsoft had longstanding knowledge of the patent.

Settled expectations weigh in favor of denying institution of this IPR due to both the age of the patent and Microsoft’s awareness of the challenged patent and its relevance to its products.

Patents that have been in force for over six years create strong settled expectations for patent owners. *See, e.g., iRhythm Techs., Inc. v. Welch Allyn, Inc.*,

IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025); *Dabico Airport Solutions Inc.*

v. AXA Power ApS, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025)

(informative); *Samsung Elecs. Co., Ltd. v. Headwater Research LLC*, IPR2025-

00932, Paper 8 (P.T.A.B. Sept. 26, 2025). The '173 patent claims priority to an

application filed December 15, 2014, and issued on June 30, 2020. It has been in

force for over five years, as part of a family of patents in force over ten years.

These facts establish settled expectations for Sandpiper.

Moreover, Microsoft has known for years about Sandpiper's patent portfolio, including the '173 patent, and its relevance to Microsoft's business. *See* EX2005, ¶¶44-63. Microsoft was a customer of the company that acquired the Sandpiper CDN intellectual property—Level 3—before Microsoft chose to build its own CDN network, and was are of Sandpiper's relevant technology. *See, e.g.,* EX2005, ¶¶47-49. Microsoft's longstanding knowledge of the challenged patent enhances Sandpiper's settled expectations. *See Murata Mfg. Co. Ltd. v. Georgia Tech. Research Corp.*, IPR2025-00383, Paper 14 (P.T.A.B. July 29, 2025) (finding Petitioner's knowledge of challenged patent created settled expectations weighing in favor of denial); *Google LLC v. SoundClear Techs., LLC*, IPR2025-00344, Paper 15 (P.T.A.B. Aug. 4, 2025) (same).

C. Institution should be denied under 35 U.S.C. § 325(d) because the same art and substantially same argument was previously before the Office and the Board.

This IPR should be denied because the Office has already thoroughly considered O'Rourke during prosecution of the '173 patent. *See* Section III. It is not an efficient use of the Board's resources to consider patentability based on the same reference and previously considered arguments.

Microsoft's challenges to the '173 patent rely on *the same art and analysis* that the Office previously considered. Under the two-part framework used by the Board to decide whether to deny institution under 35 U.S.C. § 325(d), both parts are met. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-8 (P.T.A.B. Feb. 13, 2020) (precedential). Thus, this IPR also warrants denial under § 325(d).

Under part one of the framework, the threshold is whether the same substance of Petitioner's arguments was previously considered by the Office—not whether the reference was applied by the Office. *See Advanced Bionics*, 8 (“same or substantially the same prior art or arguments previously were presented to the Office”). Part one of the framework is met by Petitioner's application of O'Rourke.

Petitioner's first obviousness ground applies O'Rourke. Pet., 8-13. Patent Owner agrees that “the Examiner was aware of (and considered) the Written Opinion of the International Searching Authority from the '173Pat.'s PCT

counterpart.” Pet., 7 (citing EX1002, 277-284). However, Petitioner’s theory that “the Examiner never applied it” is not enough to avoid the part-one threshold. Pet., 7. Petitioner’s application of O’Rourke substantially parallels the IPRP that was considered by the Office. *See* Section III. The IPRP cites to paragraphs of pub-O’Rourke, which has an identical or substantially identical description as O’Rourke. EX1002, 283. The chart below illustrates the overlap in Petitioner’s O’Rourke arguments and the IPRP considered by the Examiner, specifically for elements of challenged claims 1 and 8.

’173 Patent—Claim 1/8 Elements	O’Rourke Portions Cited by Petitioner	Pub-O’Rourke Portions Cited in IPRP
(A) in response to a request for content, determining, by a node in the CDN, if the content is cached locally at the node,	Block 502, block 505; EX1005, 6:1-12, 6:14-15; Pet., 15-18.	EX2007, ¶[0039] (covers blocks 502 and EX1005, 6:1-15); EX1002, 283.
(B) when it is determined by the node that said content is cached locally, then, after determining that the content is cached locally:	Block 504; EX1005, 6:28-31, 6:31-34; Pet., 18-20.	EX2007, ¶[0041] (covers EX1005, 6:28-54, which implicate policies at block 504); EX1002, 283.
(B)(i) determining, by the node, a current cache policy associated with the content, wherein determining the current cache policy comprises determining a time	Block 504; EX1005, 6:1-10, 6:12-15; Pet., 26-28.	EX2007, ¶[0039] (covers block 504 and EX1005, 6:1-15); EX1002, 283.

'173 Patent—Claim 1/8 Elements	O'Rourke Portions Cited by Petitioner	Pub-O'Rourke Portions Cited in IPRP
period for expiration of content in the cache; and		
then (B)(2) determining, by the node and based on said current cache policy associated with the content, whether it is acceptable to serve the content that is cached locally	EX1005, 6:31-34, 6:37-40; Pet., 29.	EX2007, ¶[0041] (covers EX1005, 6:28-54); EX1002, 283.

As illustrated above, the claim elements mapped in the IPRP using pub-O'Rourke are substantially reprised by Petitioner. Furthermore, Petitioner's mappings of claim 1/8 elements (B)(3), (B)(3)(i), and (B)(3)(ii) implicate O'Rourke's blocks 510 and 514 and associated text, which trace back to the IPRP relying on pub-O'Rourke at paragraph [0041], describing blocks 510 and 514. Pet., 29-35; EX1002, 283. The above demonstrates that Petitioner uses "substantially the same prior art or arguments previously presented to the Office." Therefore, part one of the framework is met; Petitioner is undisputably asking the Board to rehash the Office's previous consideration of substantially similar arguments.

Under part two of the framework, Petitioner has not "demonstrated that the Office erred in a manner material to the patentability of [the] challenged claims." *Advanced Bionics*, 8. Nor can it. Petitioner acknowledges the IPRP was presented to, and considered by, the Examiner. Pet., 7. Yet Petitioner does not offer the

requisite evidence that shows the Examiner erred in their consideration of the IPRP before allowing the claims. Contrary to Petitioner’s bare allegation, the ’173 patent’s file history unambiguously demonstrates that the Examiner had substantially identical arguments squarely before them and expressly marked those arguments as “considered.” *See* EX1002, 272, 277 (IDSs citing O’Rourke, pub-O’Rourke, the Written Opinion of the International Searching Authority, and the IPRP; “all references considered” by the Examiner).

Furthermore, Petitioner does not articulate a “material error” by the Examiner (e.g., a misread claim term, an overlooked passage in O’Rourke, or a factual mistake). Instead, Petitioner emphasizes that O’Rourke and the IPRP were in the file yet “never applied,” and leans on a slightly modified interpretation of O’Rourke’s flow to fit the “after determining that ... a current cache policy” sequence in the claims. That is, Petitioner implies the Office got it wrong by omission, but it does not identify a concrete misapprehension of law or fact.

Because Petitioner does not allege—let alone demonstrate—a specific material error by the Office, and instead reprises the same O’Rourke-based mapping the Examiner viewed in the IPRP, the Petition at most reflects disagreement with the Office’s allowance decision. That Petitioner disagrees with the Examiner’s treatment of O’Rourke is not reason to revisit the Office’s determination. *See Advanced Bionics*, 9 (“If reasonable minds can disagree

regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”).

Petitioner’s solution to bypass § 325(d) rests on the Examiner’s non-application of the IPRP’s O’Rourke-based analysis. However, the IPRP is not binding on the USPTO. In part two of the framework, “never applied it” is not a material error without pinpointing a misinterpretation or overlooked disclosure tied to a claim element. Petitioner advances a hindsight modification of the IPRP to align with the claim’s “after determining that ... determining a current cache policy” feature. Pet., 12 (“a different order without altering the functionality of O’Rourke’s procedure”). That is an argumentative gloss, not a newly uncovered teaching or Examiner mistake.

Petitioner should have a high burden to show material error when the IDS citing the IPRP demonstrates the Examiner considered substantially similar arguments (as evidenced by the IDS submission of the IPRP and the Examiner’s subsequent stamp of consideration). But even without a high burden, Petitioner cannot show any error when the Petition only points to conclusory, and faulty, expert testimony to support its allegation that O’Rourke meets claims 1 and 8. *See* Section V.D (discussing the improper reliance on expert testimony and deficiency of the Petition for this claim element).

Accordingly, the Director should reject Microsoft's improper attempt to challenge the '173 patent over the same art previously considered by the Office and deny institution under § 325(d).

D. The Petition's improper reliance on expert testimony and fundamental flaws on the merits warrants denial.

The Petition improperly uses alleged knowledge of a POSA and state of the art to fill missing limitations in the Grounds. The statutory basis for *inter partes* review limits invalidity grounds to prior art "consisting of patents or printed publications." 35 U.S.C. § 311(b). The corresponding regulation requires a petition to "specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4); *see also* 35 U.S.C. § 312(a)(3); EX2003 (Office guidance on the proper application of Rule 104(b)(4); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1331-32 (Fed. Cir. 2019). The Petition here fails to do this. Compounding this error, the expert testimony on which the Petition relies to fill these gaps is conclusory, and provides no analysis, evidence, or explanation.

For example, in its analysis of limitation 1[b][i], Microsoft relies not on the disclosure of O'Rourke, but on the understanding of a POSITA and a purported obviousness modification to O'Rourke that is supported only by expert testimony, rather than the prior art asserted in the challenge. *See* Pet., 24 (relying only on expert testimony to support the allegation that a POSITA would have understood

that O'Rourke suggests "to determine whether content is too stale, the cache policy must be able to determine when the change from acceptably stale ... to too stale ... occurs" and that it "would have been obvious to a POSITA that this change, from acceptably stale to too stale, is a time period for expiration."). Additional examples of improper reliance on expert testimony will be provided in the POPR, which Sandpiper requests the Director consider when making the determination whether to discretionarily deny this IPR. *See* Interim Process, § II.C.i.

The Petition's cursory and conclusory analysis falls well short of Petitioner's obligation to perform reasoned analysis—based on the references asserted in its challenges—and runs afoul of the Office guidance that compliance with Rule 104(b)(4) precludes reliance on expert testimony for claim limitations. EX2003. Accordingly, this is an additional reason the Director should deny institution.

VI. CONCLUSION

For the foregoing reasons, the Director should exercise discretion to deny institution of this IPR.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jason D. Eisenberg/

Jason D. Eisenberg (Reg. No. 43,447)

Daniel S. Block (Reg. No. 68,395)

Kristina Caggiano Kelly (Reg. No. 58,164)

Chris Kim (Reg. No. 79,393)

Attorneys for Patent Owner Sandpiper CDN, LLC

Date: March 20, 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 CORRECTED BRIEF ON DISCRETIONARY DENIAL** was served in its entirety on March 20, 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

Date: March 20, 2026

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