

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

MICROSOFT CORPORATION,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

IPR2026-00190
Patent 9,456,053 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

Sandpiper CDN, LLC (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned case, and Microsoft Corporation (“Petitioner”) filed an opposition (Paper 9, “DD Opp.”). With authorization, Patent Owner filed a Reply (Paper 10, “PO Reply”) and Petitioner filed a Sur-reply (Paper 11, “Pet. Sur-reply”). On April 28, 2026, after considering the parties’ arguments and the record, and in view of all relevant considerations, I issued a Notice indicating that institution is denied in this proceeding. Paper 12.

Patent Owner argues in its discretionary denial request that the challenged patent has been in “force for *over nine* years.” DD Req. 10. Patent Owner argues that, over that time period, it developed settled expectations that the patent is valid and enforceable. *See Dabico Airport Sols. Inc. v. Axa Power Aps*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025). Patent Owner’s settled expectations favor discretionary denial.

Patent Owner also argues that 35 U.S.C. § 325(d) warrants denial because Petitioner’s challenges “rely on the same art and analysis that the Office previously considered.” DD Req. 16 (citing *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7–8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”)).

As to § 325(d), Patent Owner first argues that one of Petitioner’s challenges is based on Lewin,¹ which the patent examiner relied on in rejecting the challenged claims—requiring claim amendment prior to issuance. DD Req. 16 (citing Ex. 1002, 630–635). Petitioner responds that the Office erred in considering Lewin. DD Opp. 6. Specifically, Petitioner asserts that “the Office materially erred by mis-mapping Lewin’s teachings

¹ US 7,010,578 B1, issued Mar. 7, 2006 (Ex. 1005).

to the claims,” enabling “Applicant to make a trivial change to the claims . . . to overcome the rejection.” *Id.*

“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.” *Advanced Bionics*, Paper 6 at 9; *see Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 6 (Director May 19, 2025) (precedential) (“*Ecto World*”). Petitioner’s argument is a general disagreement with the patent examiner’s position and does not set forth an error material to the patentability of the challenged claims.

Second, Patent Owner argues that Petitioner’s other challenges are based on the combination of Liu² and Devanneaux,³ both of which were provided to the Office on Information Disclosure Statements (IDS). DD Req. 16 (citing Ex. 1002, 565, 719). Petitioner responds that Liu and Devanneaux were submitted among “twenty-four separate Information Disclosure Statements collectively listing hundreds of patents, applications, office actions, and search reports.” DD Opp. 5, 8. Petitioner further argues that the Office erred by failing to advance a rejection based on Liu and Devanneaux. *Id.* at 7–8.

Liu and Devanneaux were provided to the Office in separate IDS filings. Paper 8, 13–14 (citing Ex. 1002, 163, 657). Although the application included twenty-four IDS filings in total, the applicant’s IDS filings are not tantamount to a voluminous IDS that may have impaired the examiner’s ability to consider the listed references. *See Ecto World*, Paper

² US 2010/0257258 A1, published May 25, 2010 (Ex. 1007).

³ US 2007/0156845 A1, published Dec. 29, 2006 (Ex. 1008).

13 at 7. Rather, the IDS filings, although potentially voluminous, appear to be the applicant's good faith effort to meet its duty of disclosure under 37 C.F.R. § 1.56 within the time periods set forth in 37 C.F.R. § 1.97 by providing the examiner with information cited in related applications. *See, e.g.,* 37 C.F.R. 1.56(a) ("Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. . . . The Office encourages applicants to carefully examine: (1) Prior art cited in search reports of a foreign patent office in a counterpart application.")

Accordingly, Petitioner does not show that the applicant's IDS filing impaired the examiner's ability to consider the listed references. Although demonstrating error is one of the strongest considerations weighing against discretionary denial, here Petitioner's material error argument is insufficient.

While certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on the complete record and a holistic assessment of all of the evidence in light of the arguments presented.

It is:

ORDERED that the Petition is *denied*, and no trial is instituted.

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