UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

SANDPIPER CDN, LLC,
Patent Owner

Case IPR2025-01010
U.S. Patent No. 10,057,322

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Alexandria, VA 22313-1450

TABLE OF CONTENTS

I. Consistent application of settled expectations compels discretionary denial.....3

II. The Decision to institute review conflicts with the Office's publicly stated policies.....7

TABLE OF AUTHORITIES

Pages

Cases

Amgen Inc. v. Bristol-Meyers Squibb Co.,
IPR2025-00601, Paper 9 (P.T.A.B. July 24, 2025) 2, 3, 4, 5

Belden Inc. v. Commscope, Inc.,
IPR2025-00833, Paper 13 (P.T.A.B. Sept. 12, 2025).....5

Cambridge Indus. USA, INC. v. Applied Optoelectronics, Inc.,
Nos. IPR2025-00433, IPR2025-00435, Paper 11 (P.T.A.B. June 27, 2025) 2, 3

Dabico Airport Solutions Inc. v. AXA Powers APS,
No. IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025) 2, 3

iRhythm Techs., Inc. v Welch Allyn, Inc.,
IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) 5

Kahoot! AS v. Interstellar Inc.,
IPR2025-00696, Paper 12 (P.T.A.B. July 31, 2025).....6

Kangxi Commc'ns. Techs. v. Skyworks Sols. Canada, Inc.,
IPR2025-00912, Paper 9 (P.T.A.B. Sept. 12, 2025).....6

OnePlus Tech. Co., LTD. v. Pantech Corp.,
IPR2025-00720, Paper 11 (P.T.A.B. Oct. 3, 2025).....6

Oneplus Tech. Co., Ltd. v. Pantech Corp.,
IPR2025-00783, Paper 12 (P.T.A.B. Sept. 12, 2025).....5

Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC,
IPR2025-00515, Paper 15 (P.T.A.B. July 16, 2025).....6, 7, 8

SAS Inst. Inc. v. Iancu,
138 S. Ct. 1348 (2018).....3, 8

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	"Cloud CDN: content delivery network," *Google Cloud*, accessed at https://cloud.google.com/cdn (last accessed July 2, 2025)
2002	Interim Processes for PTAB Workload Management Memorandum (March 26, 2025)
2003	National Judicial Caseload Profile – United States District Courts (March 2025)
2004	*Intentionally Left Blank*
2005	*Sandpiper CDN, LLC v. Google LLC*, No. 2:24-cv-03951, Invalidity Contentions (April 22, 2025)
2006	*Sandpiper CDN, LLC v. Google LLC*, No. 2:24-cv-03951, ECF No. 82 (C.D. Cal. June 24, 2025)
2007	*Sandpiper*, No. 2:24-cv-03951, ECF No. 28 (C.D. Cal. Sept. 16, 2024)
2008	FAQs for Interim Processes for PTAB Workload Management, accessed at https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management
2009	Interim Director Discretionary Process, accessed at https://www.uspto.gov/patents/ptab/interim-director-discretionary-process
2010	Declaration of Samuel H. Russ, Ph.D.
2011	*Curriculum Vitae* of Samuel H. Russ, Ph.D.
2012	Goodwin, M., "What is an API (application programming interface)?" accessed at https://www.ibm.com/think/topics/api (last accessed August 5, 2025)

Exhibit No.	Description
2013	"CDN Stands For Content Delivery Network: History and Evolution," *BlazingCDN*, accessed at https://blog.blazingcdn.com/en-us/cdn-stands-for-content-delivery-network-history-and-evolution (last accessed August 1, 2025)
2014	"What is a CDN (Content Delivery Network)?" *Amazon Web Services*, accessed at https://aws.amazon.com/what-is/cdn/ (last accessed August 1, 2025)

The Office declined discretionary denial of the Petition challenging the ’322 patent in a decision that collectively referred three Petitions to a decision on the merits, despite the patents being differently situated with respect to the rationale articulated in the decision. Paper 14 at 2. The decision with respect to the ’322 patent was erroneous in several egregious respects.

First, the decision declining discretionary denial observed that the ’903 patent challenged in IPR2025-00969 was expired, and therefore implicated the same discretionary considerations as those presented in IPR2025-00806 and IPR2025-00826. *Id.* The decision incorporated the reasoning of those decisions by reference. *Id.* As discussed in Patent Owner’s Requests for Director Review filed in those proceedings, the settled-expectations analysis in those decisions is wrong, and contradicts every other case the Office has decided since introducing settled expectations as a discretionary-denial consideration. *See, e.g.*, IPR2025-00826 Paper 18 at 1-10. Regardless, the ’322 patent is not expired. To the extent the Board conflated considerations relevant to the ’322 patent (old but not expired) with the patents challenged in IPR2025-00969, IPR2025-00806, and IPR2025-00826 (old and expired), the decision compounds those errors and should be reversed. *Id.*

The Board next observed that the ’573 patent challenged in IPR2025-00860 issued in 2021 and has not been in force for a significant period of time. Paper 14

at 2. The Board concluded that Patent Owner has not developed strong settled expectations for that patent. The ’322 patent issued earlier. It has been in force for almost eight years—which the Office has expressly found to be a significant period of time that gives rise to settled expectations that favor discretionary denial. *See Dabico Airport Solutions Inc. v. AXA Powers APS*, No. IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025) (“the challenged patent has been in force almost eight years, creating settled expectations”); *Cambridge Indus. USA, INC. v. Applied Optoelectronics, Inc*., Nos. IPR2025-00433, IPR2025-00435, Paper 11 (P.T.A.B. June 27, 2025) (denying institution due to settled expectations where patents had been in force for seven and nine years, respectively); *Amgen Inc. v. Bristol-Meyers Squibb Co.*, IPR2025-00601, Paper 9 (P.T.A.B. July 24, 2025) (denying institution based on “settled expectations” for patent in force six years). The logical implication of the analysis for the ’573 patent is, therefore, that Patent Owner has developed settled expectations that favor denying institution of the ’322 patent. But the decision says nothing about the settled expectations for the ’322 patent.

Indeed, the decision says nothing about the ’322 patent or IPR2025-01010 at all. It provides no rationale for declining discretionary denial of IPR2025-01010. Paper 14 at 2-3. It is a glaring omission that the sole basis for declining discretionary denial of the ’903 and ’573 patents—settled expectations—does not apply to the ’322 patent. Indeed, under every other decision issued by this Office,

settled expectations would have provided an overriding reason to deny institution of the ’322 patent. The Office cannot—and did not attempt to—explain this internal inconsistency or the departure from its own consistent practice. Director Review is required to remedy the arbitrary and capricious nature of this opinion.

Finally, upon referral to a panel for an institution on the merits, the panel instituted review based on analysis of only one challenged claim. Paper 17 at 16, 19. It then found that review of the entire Petition was therefore consistent with *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). Paper 17 at 21-22. While the statute permits institution wherever a likelihood is found that at least one challenged claim is unpatentable, the Office has recently found that institution where the Board does not determine that all grounds have a likelihood of prevailing is not an efficient use of the Board’s resources. The Board has discretionarily denied institution on that basis, and should do so here as well.

I. Consistent application of settled expectations compels discretionary denial.

The ’322 patent has been in force for almost eight years—which the Office has expressly found to be a significant period of time that gives rise to settled expectations that favor discretionary denial. *See Dabico*, IPR2025-00408, Paper 21 (“the challenged patent has been in force almost eight years, creating settled expectations”); *Cambridge*, IPR2025-00433, Paper 11 (denying institution due to settled expectations where patents had been in force for seven years); *Amgen*,

IPR2025-00601, Paper 9 (denying institution based on "settled expectations" for patent in force six years). Patent Owner has therefore developed settled expectations sufficient to deny institution of the '322 patent.

The decision declining discretionary denial, however, says *nothing* about the settled expectations for the '322 patent. Paper 14 at 2-3. It says nothing about the '322 patent or IPR2025-01010 at all. It provides no rationale for declining discretionary denial of IPR2025-01010. The stated bases for declining discretionary denial of the '903 and '573 patents do not apply to the '322 patent. *Id.* Indeed, under every other decision issued by this Office, settled expectations would have provided an overriding reason to deny institution of the '322 patent.

Furthermore, the Decision not to discretionarily deny the Petitions in IPR2025-00806 and IPR2025-00826 (incorporated by reference into the decision here) emphasized the *Fintiv* factors, and Petitioner's perceived likelihood of a stay in the co-pending district court litigation. *See* IPR2025-00806 Paper 14 at 2. While the decision here did not discuss *Fintiv*, to the extent the possibility of a district court stay influenced the "holistic assessment" to decline discretionary denial for the '322 patent, that is another source of error. Paper 14 at 3.

The IPR2025-00806 decision mischaracterized the record regarding the placement of a stay. The district court has *not* granted a stay of this proceeding; rather, it merely issued a short "pause" to allow the PTAB to conduct its

discretionary analysis "while at the same time preserve the trial date in [the district court] case." IPR2025-00806, EX2006, 4-5. The Court specifically stated it "does not want to put a thumb on the scale" of the PTAB's decision. *Id*. As the district court order makes clear, all deadlines in the three months leading up to trial remain unchanged and the close of expert discovery is only delayed by a month. *Id.*, 5. Accordingly, not only does the decision use the "short pause" order to put far more than a mere thumb on the scale (against the district court's intentions), it does so based on a misapprehension of the actual district court timeline.

Regardless of the district court timeline, the Office has consistently found settled expectations to be one of the most heavily weighed factors against institution, outweighing other factors that favor referral to a merits panel for Petitions indistinguishable from the one challenging the '322 patent here. *See iRhythm Techs., Inc. v Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) (denying institution based on "settled expectations" despite other factors weighing in favor of institution); *Amgen*, IPR2025-00601, Paper 9 (P.T.A.B. July 24, 2025) (denying institution based on "settled expectations" for patent in force six years despite several factors weighing in favor of institution); *Oneplus Tech. Co., Ltd. v. Pantech Corp.*, IPR2025-00783, Paper 12 (P.T.A.B. Sept. 12, 2025) (denying institution based on settled expectations for a nine-year-old patent); *Belden Inc. v. Commscope, Inc.*, IPR2025-00833, Paper 13 (P.T.A.B. Sept. 12,

2025) (finding that settled expectations for a nine-year-old patent outweighed *Fintiv* considerations favoring institution).

Even more on-point for this Petition, the Office's decisions have repeatedly and specifically held that settled expectations for a patent more than six years old to outweigh the *Fintiv* factors in the event of a district court stay. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (P.T.A.B. July 31, 2025) (finding settled expectations for a six-year-old patent outweighed *Fintiv* where the district court action was stayed); *see also OnePlus Tech. Co., LTD. v. Pantech Corp.*, IPR2025-00720, Paper 11 (P.T.A.B. Oct. 3, 2025) (denying review because settled expectations outweighed a district court stay); *Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC*, IPR2025-00515, Paper 15 (P.T.A.B. July 16, 2025) (denying based on settled expectations when district court case stayed); *Kangxi Commc'ns. Techs. v. Skyworks Sols. Canada, Inc.*, IPR2025-00912, Paper 9 (P.T.A.B. Sept. 12, 2025) (finding settled expectations outweighed *Fintiv* even with a stay in district court); *Sandisk/Western Digital v. Polaris*, IPR2025-00515, Paper 15; IPR2025-00516, Paper 15; IPR2025-00515, Paper 15 (P.T.A.B. July 16, 2025) (finding that settled expectations for 9-, 12-, and 15-year old patents outweighed *Fintiv* where the district court action was stayed). Settled expectations therefore favors discretionary denial in this case, just as it has every other time the Office has considered discretionary denial of a patent of comparable age under the

current bifurcated framework. The Director should reverse the Decision and decline institution.

II. The Decision to institute review conflicts with the Office's publicly stated policies.

The interim discretionary denial procedure should not reflect the whims of an individual. It should promote a rational policy. The stated policy behind the discretionary denial process is to "create fairness … for Patent Owners" and return the IPR process to its original intent. *See* Acting Director's Remarks at IPBC Global Conference (Sept. 16, 2025).[1] Once the Office has publicly announced the policy and applied it in countless decisions, the Office should maintain consistency. As the Office has stated, IPRs were not intended to be an "on-demand review" of IP rights, and are instead reserved for "the best kinds of cases" that the Office should be looking at. *Id.* There is no credible argument that reviewing the '322 patent despite its age is "the best kind" of use for the Office's limited resources.

Every discretionary denial decision issued pursuant to the bifurcated procedure has denied review of patents that have been in force an amount of time

[1] Available at https://www.uspto.gov/sites/default/files/documents/Memo_re_prior_findings_of_fact_and_conclusions_of_law_9_16_25.pdf?utm_campaign=subscriptioncenter&utm_content=&utm_medium=email&utm_name=&utm_source=govdelivery&utm_term=.

comparable to the ’322 patent, even where there is parallel district court litigation that is stayed or would otherwise be streamlined by a Final Written Decision. There is no reason for this case to be treated the opposite way. Indeed, the panel’s institution decision on the merits did not present a compelling case of examiner error or indicate that all of the grounds and challenged claims were likely to succeed in showing unpatentability. Paper 17, 20-22. On the contrary, the panel indicated that it was basing its institution decision on its analysis for one independent claim, and instituting review of the entire petition due to the requirements of *SAS*, rather than the merits of those challenges. *Id.* Director review is required and the institution decision should be overturned.

Respectfully submitted,

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

I certify that the above-captioned **PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW** was served in its entirety on December 15, 2025, upon the following parties via electronic mail:

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