

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

SANDPIPER CDN, LLC,
Patent Owner.

IPR2026-00095

Patent No. 8,478,903

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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EXHIBIT LIST

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1001	U.S. Patent No. 8,478,903 to Farber et al. (“’903 Patent”)
1002	Prosecution History of U.S. Application No. 11/065,412
1003	Declaration of Dr. Todd Mowry (“Mowry”)
1004	Curriculum Vitae of Dr. Todd Mowry
1005	PCT International Patent Pub. No. WO 1996041285 to Kenner et al. (“Kenner”) ¹
1006	Ronald J. Vetter et. al, Mosaic and the World-Wide Web, Computer, vol. 27, no. 10, pp. 49-57, Oct. 1994 (“Vetter”)
1007	European Patent Pub. No. EP 0753836 to Rekimoto et al. (“Rekimoto”)
1008	U.S. Patent No. 5,511,208 to Boyles et al. (“Boyles”)
1009	Andrew Tanenbaum, Computer Networks (3rd ed. 1996) (“Tanenbaum”)
1010	Tim Berners-Lee, The World-Wide Web, Communications of the ACM, Vol. 37, No. 8, August 1994 (“Berners-Lee”)
1011	Radhika Malpani, Making World Wide Web Caching Servers Cooperate, WWW4: Proceedings of the Fourth International Conference on World Wide Web, Pages 107-117, December 11, 1995 (“Malpani”)
1012	Fielding et al., Hypertext Transfer Protocol – HTTP/1.1, RFC 2068, Jan. 1997, https://www.rfc-editor.org/rfc/rfc2068 (“HTTP/1.1”)
1013	Barbara Tockey Zivkov et al., Disk Caching in Large Databases and Timeshared Systems, Proceedings Fifth International Symposium on Modeling, Analysis, and Simulation of Computer and Telecommunication Systems (MASCOTS 97), Haifa, Israel, 184–95, January 1997 (“Zivkov”)
1014	Declaration of Lauren Gluckman Regarding EX-1006
1015	Scheduling Order, <i>Sandpiper CDN, LLC v. Google LLC</i> , 2:24-cv-03951, Dkt. 62 (C.D. Cal. Dec. 6, 2024)

¹ Because pages 31-54 of Kenner do not include line numbers or paragraph numbers, Petitioner has added line numbering for these pages to facilitate review.

Exhibit	Description
1016	Letter to Robert H. Reckers re Sandpiper CDN LLC v. Google LLC, No. 2:24-3951-AB-RAO (C.D. Cal.) (May 6, 2025)
1017	<i>Sandpiper CDN, LLC v. Microsoft Corp.</i> , No. 2-25-cv-00664 (E.D. Tex.), Docket
1018	Stipulation Letter, dated December 12, 2025
1019	Email from Google's counsel to Microsoft's counsel, dated November 3, 2025
1020	Sandpiper CDN, LLC, Division of Corporations - Filing
1021	Assignment from Level 3 Communications to Sandpiper CDN, LLC
1022	<i>Sandpiper CDN, LLC v. Google LLC</i> , No. 2:24-cv-03951, Dkt. 1 (C.D. Cal.)
1023	<i>Sandpiper CDN, LLC v. Google LLC</i> , No. 2:24-cv-03951, Dkt. 28 (C.D. Cal.)
1024	<i>Sandpiper CDN, LLC v. Google LLC</i> , No. 2:24-cv-03951, Dkt. 45-1 (C.D. Cal.)
1025	<i>Sandpiper CDN, LLC v. Google LLC</i> , No. 2:24-cv-03951, Dkt. 93 (C.D. Cal.)
1026	<i>Sandpiper CDN, LLC v. Comcast Cable Commc 'ns LLC</i> , No. 2:24-cv-00886, Dkt. 1 (E.D. Tex.)
1027	<i>Sandpiper CDN, LLC v. Comcast Cable Commc 'ns LLC</i> , No. 2:24-cv-00886, Dkt. 62 (E.D. Tex.)
1028	<i>Sandpiper CDN, LLC v. Microsoft Corp.</i> , No. 2:25-cv-00664, Dkt. 1 (E.D. Tex.)
1029	<i>Sandpiper CDN, LLC v. Microsoft Corp.</i> , No. 2:25-cv-00664, Dkt. 41 (E.D. Tex.)
1030	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00806, -00826, Paper 13 (Sep. 12, 2025) (referring petitions)
1031	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00860, -00969, -01010, Paper 14 (Oct. 10, 2025) (referring petitions)
1032	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00826, Paper 15 (Nov. 7, 2025) (Institution Decision)
1033	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00806, Paper 14 (Nov. 10, 2025) (Institution Decision)
1034	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00860, Paper 15 (Nov. 25, 2025) (Institution Decision)
1035	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00969, Paper 14 (Nov. 28, 2025) (Institution Decision)

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1036	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-01010, Paper 17 (Dec. 1, 2025) (Institution Decision)
1037	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00969, Paper 17 (Dec. 5, 2025) (Director Review request)
1038	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00806, -00826, -00969, -01010, Paper 20 (Jan. 12, 2026) (denying Director Review)
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1040	Docket Navigator, Sandpiper CDN Cases Search
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1044	<i>Google LLC v. Sandpiper CDN, LLC</i> , IPR2025-00969, Paper 8 (Sep. 18, 2025)
1045	<i>Sandpiper CDN, LLC v. Microsoft Corp.</i> , No. 2:25-cv-00664, Dkt. 57 (E.D. Tex.)

I. INTRODUCTION

This petition is a copycat IPR presenting the same grounds and evidence as Google’s IPR petition in IPR2025-00969 (“Google ’903 IPR”) challenging U.S. Patent No. 8,478,903 (“’903 patent,” EX1001). The Office already rejected Sandpiper CDN, LLC’s (“PO”) discretionary denial arguments in the Google ’903 IPR and granted institution. The Office should likewise conclude here that Microsoft Corporation’s (“Microsoft” or “Petitioner”) petition challenging the expired ’903 patent is an appropriate and efficient use of Office resources for several reasons. First, Microsoft commits to an understudy role that avoids additional burden on the Office and PO while allowing the Office to correct a potential material error in issuing the challenged claims should the Google ’903 IPR settle. Second, it is appropriate for Microsoft to file this IPR because Microsoft reasonably expected non-enforcement of the ’903 patent, which expired in 2023 before PO acquired it and more than twenty-one months before PO accused Microsoft of infringing it. Third, this IPR appropriately utilizes Office resources because the Board is best positioned to review the eight patents on which either Google or Microsoft has requested IPR. Fourth, as explained below, the balance of the *Fintiv* factors weighs against denial, with or without joinder.²

² Notwithstanding *Elong Int’l USA Inc. v. Feit Elec. Co.*, IPR2025-00258, Paper 16

PO's discretionary denial request (Paper 9, "DD Request") fails to undermine these points—instead recycling its rejected arguments from the Google '903 IPR while adding a few arguments that fare no better. Accordingly, the Office should reject PO's discretionary denial request and, at the same time, determine that the merits analysis in the Google '903 IPR still applies and grant institution and joinder.

II. BACKGROUND

A. Sandpiper CDN, LLC

PO is a Delaware entity incorporated in 2024 for the apparent purpose of acquiring the '903 and other patents from Level 3 Communications, LLC. EX1020 (incorporation in March 2024); EX1021 (April 2024 assignments from Level 3 Communications, LLC to PO). Notably, the '903 patent expired on September 24, 2023—months before PO was even formed. EX1001 (claiming priority to an application filed February 10, 1998, and receiving 2,052 days of patent term adjustment).³

(June 25, 2025) (precedential), Petitioner respectfully submits that, in determining whether to grant joinder of a copycat IPR, the Office should analyze *Fintiv* assuming the IPR proceeds on the schedule in the IPR to be joined under 35 U.S.C. §315(c) rather than a hypothetical non-joined schedule.

³ PO alleges that a "predecessor" developed the content-delivery network technology

B. The Google, Comcast, and Microsoft Litigations

Shortly after acquiring a patent portfolio from Level 3 Communications, PO began a litigation campaign. On May 10, 2024, PO sued Google in the Central District of California (“Google litigation”). EX1022. In the Google litigation, PO currently alleges infringement of five patents, including the ’903 patent.⁴ The Google litigation is currently stayed pending instituted IPRs (discussed below). EX1025.

On November 1, 2024, nearly six months after PO filed the Google litigation, PO sued Comcast in the Eastern District of Texas (“Comcast litigation”). EX1026. PO alleges infringement of four patents, one of which overlaps with the Google litigation (the ’903 patent).⁵

On June 26, 2025, nearly eight months after filing the Comcast litigation and

described in the ’903 patent. DD Request, 2. Given that PO was formed in 2024, its claimed connection to this decades-old technology is tenuous at best.

⁴ PO’s complaint alleged infringement of six patents. EX1022. The district court determined two of those patents—U.S. 8,595,778 (“’778 patent”) and 8,719,886 (“’886 patent”)—are invalid under § 101. EX1023, 11, 15-16. PO subsequently amended its complaint to assert one additional patent. EX1024.

⁵ PO asserted five patents and subsequently dropped one patent. EX1026-1027.

more than a year after filing the Google litigation, PO sued Microsoft in the Eastern District of Texas (“Microsoft litigation”). EX1028. Complicating the litigations further, PO alleges infringement of six patents, only two of which overlap with the earlier-filed litigations (the ’903 patent asserted in both the Google and Comcast litigations and U.S. 9,762,692 (“’692 patent”) asserted in the Comcast litigation). EX1028-1029.

C. Google and Microsoft IPRs

Google has filed IPRs challenging all five patents currently asserted against it: IPR2025-00806 (U.S. 8,645,517 (“’517 patent”)); IPR2025-00826 (U.S. 9,021,112 (“’112 patent”)); IPR2025-00860 (U.S. 10,924,573 (“’573 patent”)); IPR2025-00969 (’903 patent); and IPR2025-01010 (U.S. 10,057,322 (“’322 patent”). In September and October 2025, the Office referred the petitions in all five IPRs to the Board. EX1030-1031. The Board subsequently instituted all five IPRs in November through December 2025. EX1032-1036. The Director rejected PO’s request for Director Review in four of those IPRs. EX1038. PO did not request Director Review in the other IPR.

Microsoft also filed IPRs challenging four patents asserted against it in November through December 2025, including this IPR challenging the ’903 patent: IPR2026-00095 (’903 patent); IPR2026-00174 (’692 patent); IPR2026-00180 (U.S. 10,701,173 (“’173 patent”)); and IPR2026-00190 (U.S. 9,456,053 (“’053 patent”).

The institution decisions in these IPRs are due in May through July 2026.

III. THE OFFICE SHOULD REJECT PO'S DISCRETIONARY REQUEST AND GRANT INSTITUTION AND JOINDER AT THE SAME TIME

For the reasons explained below, the Office should reject PO's discretionary denial request and grant institution and joinder.

A. Instituting and Granting Joinder Is An Efficient Use of Office Resources and Will Avoid a Potential Material Error Going Unreviewed Should Google Settle

Microsoft has committed to “assume a ‘silent understudy’ role” and not to “take an active role in the inter partes review proceeding unless the Google Petitioner ceases to participate in the instituted IPR.” Paper 3, 2. Microsoft's request to join the Google '903 IPR thus does not place additional burden on the Office or the parties. However, should Google settle, joinder would allow the IPR to proceed so that the record regarding a potential material error during prosecution can continue to develop. Specifically, the Examiner stated in a notice of allowability during prosecution⁶ that the independent claims were distinguishable from the prior art Armbruster reference (U.S. 6,243,760) for the following reason (relevant to limitation 1[g]): “though Armbruster teaches the a [sic] table listing aliases

⁶ PO's argument that the '903 patent had an “extensive” prosecution history (DD Request, 3-6) is irrelevant given that the Office has determined there is a reasonable likelihood the challenged claims are unpatentable as obvious.

associated with content providers, Ambruster does not teach the final amended limitation of [issued claim 1] because the cache servers in Ambruster do not perform the claimed analysis using the table.” EX1002, 94.⁷ “In other words, the data in the cache is [sic] Ambruster is pre-cached and therefore the cache servers do not perform any analysis about the origin of the data.” *Id.*⁸

The institution decision in the Google ’903 IPR, however, suggests—on a preliminary basis—that this was known in the prior art. Specifically, the Board was “persuaded that Petitioner has shown Kenner teaches [limitation 1[g]] for purposes of institution.” EX1035, 14; *see also id.*, 15-16 (“[A]t this juncture, we agree that Kenner describes a method of consulting its clip database to determine the content provider; i.e., its Internet location, that would be performed even where the account number itself may identify the content provider”). The Director declined to revisit that decision. EX1038, 2.

⁷ Limitation 1[g] recites: “wherein the at least one shared repeater server is further constructed and adapted to analyze, using the table, an alias name received with a client request for a particular resource to determine a content provider associated with the particular resource.” Paper 1, 68.

⁸ The Examiner issued a subsequent notice of allowability, but claim 29 (issued claim 1) remained unchanged. *Compare* EX1002, 23-24 *with id.*, 82-83.

Thus, there is a reasonable likelihood that the prior art⁹ taught the limitation of claim 1 that the Examiner determined distinguished it from Armbruster. Granting joinder would therefore further the error correction purpose of IPRs because it would permit arguments regarding this potential material error to develop even if the Google '903 IPR settles. *See, e.g., Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464-00466, Paper 12, 2-3 (July 16, 2025) (informative) (declining to discretionarily deny petition where there was an apparent material error by the Office during examination); *Yealink (USA) Network Tech. Co. v. Barco N.V.*, IPR2025-00491, Paper 18, 2-3 (June 25, 2025) (“Patent Owner asserts that the patent examiner

⁹ The Office’s material error decisions have typically focused on art before the Examiner, but neither *Yealink* nor *Microsoft v. Partec* is so limited. Determining whether the Office erred should be tied to the legal standard—here, whether the claims should not have issued because they would have been obvious to a person of ordinary skill who is presumed to be aware of all pertinent prior art. *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985) (“The issue of obviousness is determined entirely with reference to a hypothetical ‘person having ordinary skill in the art.’”); *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986) (“The person of ordinary skill is a hypothetical person who is presumed to be aware of all the pertinent prior art.”).

allowed the claims because the prior art the examiner relied on failed to disclose ‘hosting a unified communication’ as claimed. However, Petitioner persuasively asserts that ‘the Examiner never discussed any unified communication software,’ and the patent examiner appears to have failed to appreciate that ‘[u]nified communication is a term of art’ referring to services such as Skype that are well known in the art.”) (emphasis added; citations omitted); *Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 2-3 (June 12, 2025) (determining that the Office materially erred “by overlooking the teachings of” two references presented to the Office during prosecution, “the combined teachings of” a reference not presented to the Office during prosecution and a previously presented reference, or the two references not presented to the Office with the reference previously presented to the Office); *Taiwan Semiconductor Mfg. Co. v. Marvin Semiconductor Ltd.*, IPR2025-00847 et al., Paper 11, 4 (Sep. 3, 2025) (“Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.”).

B. Microsoft’s Expectation That the Expired ’903 Patent Would Not Be Enforced Against It Weighs Against Denial

As discussed below, Microsoft—not PO—had “settled expectations” that PO would not enforce the expired ’903 patent against it. The Office should find this too weighs strongly against discretionary denial.

The ’903 patent expired in September 2023 (EX1001)—before PO acquired

the patent in 2024 and more than twenty-one months before PO asserted the patent against Microsoft. EX1021; EX1028. Further, PO presents no evidence that the '903 patent was ever “commercialized, asserted, marked, licensed, or otherwise applied” in either Google’s or Microsoft’s technology space during its term. *Shenzen Tuozhu Tech. Co. v. Stratasy, Inc.*, IPR2025-00438 et al., Paper 10, 3 (July 17, 2025) (internal quotations omitted).

In view of these facts, the Office correctly concluded in the Google '903 IPR that Google reasonably expected non-enforcement of the expired '903 patent and determined discretionary denial was not appropriate:

The ['903] patent challenged in IPR2025-00969 is expired, and the parties present similar arguments to those raised in IPR2025-00806 and IPR2025-00826. Because the proceeding in IPR2025-00969 presents essentially the same discretionary considerations as those presented in IPR2025-00806 and IPR2025-00826, that analysis is incorporated here.

EX1031, 2 (emphasis added; internal citations omitted).

Patent Owner argues it has settled expectations because the challenged patents “have been in force for many years.” Petitioner, on the other hand, persuasively argues that the challenged patent in IPR2025-00806 expired in 2023, and the challenged patent in IPR2025-00826

expired in 2021, and, accordingly, it expected non-enforcement of the challenged patents.

EX1030, 2 (emphasis added; internal citation omitted); *see also id.*, 2 n.3 (“Patent Owner did not acquire the challenged patents until after they expired.”); *id.* (citing *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11, 3 (Sep. 5, 2025), where the Office noted that “Patent Owner did not assert the challenged patents against Petitioner until after they expired”).

The same reasoning applies here. Indeed, Microsoft’s expectation of non-enforcement is even stronger, as PO did not sue Microsoft until more than a year after PO sued Google. Microsoft’s expectation of non-enforcement weighs heavily against denial. *See, e.g., Apple Inc.*, IPR2025-00856, Paper 11, 3 (“Patent Owner did not assert the challenged patents against Petitioner until after they expired. Under these circumstances, discretionary denial is not appropriate.”); *Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00225-226, Paper 8, 2 (June 12, 2025) (“Petitioner...persuasively argues that the challenged patent expired almost four years ago due to non-payment of maintenance fees, and, accordingly, it expected non-enforcement of the challenged patent.”).

PO devotes nearly five pages to arguing that it has “settled expectations” and that IPR regarding an expired patent is not a good use of Office resources. DD Request, 12-17. With one exception (discussed below), PO repeats its rejected

arguments in the Google '903 IPR. For example, after the Office's referral decision rejected PO's "settled expectations" argument, PO filed a request for Director Review in the Google '903 IPR and made the same arguments it asserts now. *Compare* DD Request, 13-14 (arguing that "when a patent has been in force for a long time, the settled expectations of the parties and the public favor discretionarily denying institution of *inter partes review*") with EX1037, 1-2 (making the same argument); DD Request, 14-16 (arguing "the Office has consistently found that the 'settled expectations' of the parties favors discretionary denial due to the age of the patent *where the patent is expired*" and including a two-page string cite) with EX1037, 2-4 (making same argument and citing same decisions).

As noted, the Director rejected PO's Director Review request. EX1038, 2. PO's recycled arguments should be rejected again.

PO's only new "settled expectations" argument is the conclusory assertion that Microsoft knew about the '903 patent "since it was a pending application over 20 years ago" and "attempted to acquire Sandpiper's patent portfolio, but was outbid by a competitor." DD Request, 12 (citing *Sandpiper CDN, LLC v. Microsoft Corp.*, No. 2:25-cv-00664, Dkt. 1 (Complaint), ¶¶44-63 (E.D. Tex. Jun. 26, 2025)).

To start, PO fails to acknowledge that it could not have developed any "settled expectations" based on events alleged to have occurred before the '903 patent expired in 2023 because PO did not exist before 2024 and has no relationship with

the original “Sandpiper” or any prior owner. PO also fails to acknowledge that, even if it could plausibly allege that Microsoft was aware of the ’903 patent before PO filed the Microsoft litigation (it cannot), no prior owner alleged infringement despite alleged prior business relationships, reinforcing Microsoft’s expectation that the ’903 patent would not be asserted against it.

But even setting these issues aside, PO’s allegations fail because PO relies solely on its complaint. Complaint allegations are just that—allegations, not evidence—and PO’s failure to cite evidence is reason alone to reject PO’s argument. If the Office still considers it, the allegations are facially deficient because they do not identify facts demonstrating Microsoft was aware of the ’903 patent before PO’s 2025 complaint, let alone that PO (or a prior owner) ever discussed the ’903 patent with Microsoft before it expired. EX1039, 3 (Microsoft explaining that the complaint “does not allege that Microsoft was ever specifically informed of or otherwise knew of [PO’s] patents, let alone that the Original Sandpiper, Level 3 Communications, or [PO] ever told Microsoft that its products infringed any Sandpiper patent”); EX1045, 2-4 (Microsoft explaining that discussions about acquiring or obtaining services from a business are not evidence of licensing a specific patent, and further, that the complaint’s questionable allegations regarding employee hires and receipt of industry publications do not establish knowledge). Thus, PO’s cited authorities—addressing specific discussions or evidence of

knowledge—do not apply. *See Murata Mfg. Co. v. Georgia Tech. Rsch. Corp.*, IPR2025-00383-384, Paper 14, 2 (July 29, 2025) (stating “Petitioner and Patent Owner had discussions in 2007 regarding the technology space involving the challenged patent”); *Google LLC v. SoundClear Techs. LLC*, IPR2025-00344-345, Paper 15, 2-3 (Aug. 4, 2025) (addressing unexpired patents and explaining that “Petitioner had knowledge of the challenged patents as early as 2019”).

C. The Office’s Experience With PO’s Patents Together With the Large Number of Patents at Issue Makes the Office a More Efficient Forum to Address Unpatentability

The large number of patents at issue in litigation further demonstrates that IPR is an appropriate use of Office resources. In total, PO currently asserts twelve unique patents across the three litigations. *See* EX1040. To date, Google and Microsoft have filed nine IPRs (including this one) challenging eight of those patents. *Id.* Five of those IPRs have received a decision regarding both discretionary denial and the merits, and the Office has rejected all five discretionary denial requests¹⁰ and instituted all five IPRs. EX1030-1036. Four discretionary denial/institution decisions remain pending, including in this IPR (summarized below):

¹⁰ The Office discretionarily denied Google’s IPRs challenging the ’778 and ’886 patents that were determined to be invalid under § 101. *Google LLC v. Sandpiper CDN*, IPR2025-00846, -00952, Paper 10 (Oct. 10, 2025).

Patent	District Court	IPR	IPR Status
'903 patent	Google Microsoft Comcast	Google, IPR2025-00969 Microsoft, IPR2026-00095	Instituted Pending (Requesting Joinder)
'322 patent	Google	Google, IPR2025-01010	Instituted
'573 patent	Google	Google, IPR2025-00860	Instituted
'112 patent	Google	Google, IPR2025-00826	Instituted
'517 patent	Google	Google, IPR2025-00806	Instituted
'053 patent	Microsoft	Microsoft, IPR2026-00190	Pending
'173 patent	Microsoft	Microsoft, IPR2026-00180	Pending
'692 patent	Microsoft Comcast	Microsoft, IPR2026-00174	Pending

Given that the Board has already invested resources addressing the '903 patent and four other PO patents, this IPR—along with Microsoft’s three other IPRs challenging PO’s patents—is an appropriate use of Office resources. Indeed, this prior experience and expertise places the Board in a better position than the district court to address the unpatentability of this large number of patents both consistently and efficiently. *See, e.g., Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217 et al., Paper 9, 2-3 (June 13, 2025) (informative) (noting “[t]he large number and

vast scope of the patents asserted in the district court litigation...weighs against discretionary denial”); *Shenzen Tuozhu*, IPR2025-00438 et al., Paper 10, 3.

D. The *Fintiv* Factors Weigh Heavily Against Denial

As discussed, granting institution and joinder here is an appropriate use of Office resources for several reasons. The balance of the *Fintiv* factors also weighs against denial, both without and with joinder.

As a threshold matter, the Office should reject PO’s reliance on the July 2026 Comcast trial date. DD Request, 7-8. Tellingly, PO mentions the Comcast litigation under *Fintiv* factor 2 (trial date) and otherwise ignores it. PO’s failure to conduct a complete analysis is reason alone to reject PO’s argument. But even if the Office considers it, it should conclude that the Comcast trial does not support denial just as it did not in the Google ’903 IPR. EX1037, 8 (Director Review request arguing the Comcast trial supports denial); EX1038, 2 (denying Director Review). Indeed, had PO conducted a complete analysis, it would have been forced to concede that *Fintiv* factor 5 (the parties) would weigh against discretionary denial. *See, e.g., Multi-Color Corp. v. Brook & Whittle Ltd.*, PGR2025-00025, Paper 10, 2 (July 16, 2025) (determining factor 5 counsels against denial when trial date preceding final written decision was in a litigation involving a different party); *POSCO Co. v. ArcelorMittal*, IPR2025-00370-371, Paper 10, 2 (June 25, 2025).

1. Factor 1 (Stay): The Likelihood of a Stay is Neutral

Microsoft has not yet filed a motion to stay the parallel litigation, and the district court has not indicated whether a stay would be granted. Thus, this factor is neutral. *Sand Revolution II, LLC v. Cont'l Intermodal Grp.-Trucking LLC*, IPR2019-01393, Paper 24, 7 (June 16, 2020) (informative). PO's argument that this factor favors denial cites no authority and should be rejected accordingly.

2. Factor 2 (Trial Date): The Trial Date Weighs Against Denial (Without or With Joinder)

Without joinder, the final written decision ("FWD") would be due by May 13, 2027. The scheduled trial in the Microsoft litigation is in April 2027 (EX1041, 1), but the projected trial based on statistics is at the end of June 2027. EX1042, 35 (median-time-to-trial for the twelve month period ending 12/31/2025 is 24 months after complaint). This factor thus weighs against denial. *See, e.g., Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, -00407, Paper 14, 2 (May 16, 2025) (determining discretionary denial inappropriate where FWD and scheduled trial were in same month, but statistics projected trial months after FWD). With joinder, the scheduled April 2027 trial is more than four months after the expected Google '903 IPR FWD on November 30, 2026. Thus, this factor weighs even more heavily against denial.

PO incorrectly argues this factor strongly favors denial.¹¹ DD Request, 7-8. Without joinder, PO ignores that statistics place trial after the FWD. *Id.* With joinder, PO apparently acknowledges trial date does not favor denial but argues dispositive motions are due the same month as the November 2026 FWD. *Id.*, 8. That is irrelevant (this factor concerns trial date; not investment) and wrong. Dispositive motions are due December 28, 2026 (EX1041, 3), which is approximately one month after the expected FWD.

3. Factor 3 (Investment): Investment in the Parallel Litigation Weighs Against Denial Without or With Joinder Because the Litigation Is in Its Early Stages

Either without or with joinder, the parties have invested minimal resources, and the bulk of the work remains to be done. The *Markman* hearing is not scheduled until October 2026, the deadlines for close of fact discovery/opening expert reports are not until November 2026, and dispositive motions are not due until December 2026. EX1041, 3-4. Accordingly, this factor weighs against denial. *See, e.g., All. Laundry Sys., LLC v. Payrange LLC*, PGR2025-00027, Paper 11, 2 (July 17, 2025)

¹¹ The Comcast trial date should not be considered. *See* §III.D. If the Office considers it, statistics project trial in November 2026 (*see* EX1042, 35)—i.e., around when the Google '903 IPR FWD is due. The Office should find *Fintiv* does not support denial for the same reasons the Office did not discretionarily deny the Google '903 IPR.

(referring petitions and noting “there has been relatively little investment”).

PO argues there has been “[s]ignificant work” (DD Request, 8), but PO only identifies exchange of infringement/invalidity contentions and written discovery. *Id.* The vast majority of work remains to be done.

4. Factor 4 (Overlap): The Lack of Overlap Between Issues Raised in the Petition and the Parallel Litigation Weighs Against Denial

Either without or with joinder, this factor weighs against denial. Microsoft submitted a *Sotera* stipulation, agreeing to be “bound by the full scope of estoppel under 35 U.S.C. §315(e)(2).” EX1018. Microsoft’s stipulation effectively eliminates the risk of any overlap, and there is no basis for requiring a broader stipulation. *See* 35 U.S.C. §§311(b) and 315(e)(2). PO argues the effect of Microsoft’s stipulation is “mitigated” because it is not a *Sotera* plus stipulation. DD Request, 8-9. But as in the Google ’903 IPR, the Office should reject that argument and find a *Sotera* stipulation is sufficient. EX1043 (Google’s *Sotera* stipulation); EX1044, 22 (Google explaining it timely entered a *Sotera* stipulation); EX1031, 2 (referring petition); EX1038, 2 (denying Director Review).

5. Factor 5 (Parties): The Parties Factor Weighs Against Denial Because the FWD Is Likely to Precede the Trial

Because the FWD—either without or with joinder—is likely to precede either the scheduled or projected trial, this factor weighs against denial. *BMW of N. Am.*,

LLC v. Mich. Motor Techs. LLC, IPR2023-01234, Paper 11, 14-15 (Jan. 26, 2024).¹²

6. Factor 6 (Other Circumstances): Other Circumstances Weigh Heavily Against Denial Because There Are Compelling Reasons to Institute and Grant Joinder

As explained in §§III.A-III.D.5, there are compelling reasons for the Office to decline to discretionarily deny this IPR and, at the same time, grant institution/joinder. This factor thus strongly weighs against denial.

PO argues that the petition suffers from “flaws, and the merits of the arguments presented are weak for the reasons discussed in Sections V.C. and V.D.” DD Request, 9. Neither argument has merit. Section V.C discusses PO’s baseless argument that PO had “settled expectations” in the expired ’903 patent. DD Request, 12-17. Microsoft expected non-enforcement of the expired ’903 patent, and PO has no settled expectations. *See* §III.B. Section V.D discusses PO’s recycled merits arguments. DD Request, 17-20. The Office considered and rejected the same arguments in the Google ’903 IPR. *Compare* DD Request, 17-20 *with* EX1037, 12-15 (substantially similar merits arguments in PO’s request for Director Review); EX1038, 2 (denying Director Review). The analysis should be no different here.

Section V.B of PO’s request further argues that the Petition’s reliance on

¹² If the Office considers the Comcast litigation, this factor weighs against denial because it involves an unrelated defendant. *See* §III.D.

Google’s expert Dr. Mowry supports denial. DD Request, 10-12. This argument is baseless. On January 5, 2026, Microsoft’s reply in support of joinder explained that Microsoft confirmed before filing that Dr. Mowry was willing and available to be retained by Microsoft if the Google ’903 IPR is terminated. Paper 8, 1-3 (citing EX1019); EX1019 (Google’s counsel stating that “[s]hould Microsoft become lead petitioner upon Google’s settlement, Google will not oppose Microsoft retaining Dr. Mowry, the expert of record who has confirmed he is free to represent Microsoft”).

Inexplicably, PO filed its discretionary denial request eight days later and argued that “Microsoft provides no indication that it has retained Dr. Mowry or that Dr. Mowry would testify on Microsoft’s behalf should the Google ’903 IPR be terminated.” DD Request, 10; *see also id.*, 11 n.1 (“Microsoft has failed to provide evidence that Dr. Mowry would be a willing participant to this proceeding.”)

PO is simply wrong. As Microsoft has now explained twice, Dr. Mowry is available to be retained by Microsoft and Microsoft would be able to produce Dr. Mowry for cross examination. Thus, the *OpenSky* decision PO relies on—involving an exclusive expert engagement—does not apply. DD Request, 10 (citing *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01056, Paper 18 (Dec. 23, 2021)).

IV. CONCLUSION

The Office should reject PO’s discretionary denial request, determine that the merits analysis in the Google ’903 IPR still applies, and grant institution and joinder.

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U.S. Patent No. 8,478,903

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and EXHIBITS 1020 – 1045 were served upon the below listed counsel by electronic mail:

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