

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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MICROSOFT CORPORATION,  
Petitioner,

v.

SANDPIPER CDN, LLC,  
Patent Owner.

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IPR2026-00095

Patent No. 8,478,903

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**PETITIONER'S CONDITIONAL REPLY IN SUPPORT OF MOTION FOR  
JOINER UNDER 35 U.S.C. § 315(C) AND 37 C.F.R. §§42.22 AND 42.122(B)**

<u>Exhibit</u>	<u>Description</u>
1001	U.S. Patent No. 8,478,903 to Farber et al. (“’903 Patent”) <sup>11</sup>
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. (“ <i>Kenner</i> ”)
1006	Ronald J. Vetter et. al, Mosaic and the World-Wide Web, Computer, vol. 27, no. 10, pp. 49-57, Oct. 1994 (“ <i>Vetter</i> ”)
1007	European Patent Pub. No. EP 0753836 to Rekimoto et al. (“ <i>Rekimoto</i> ”)
1008	U.S. Patent No. 5,511,208 to Boyles et al. (“ <i>Boyles</i> ”)
1009	Andrew Tanenbaum, Computer Networks (3rd ed. 1996) (“ <i>Tanenbaum</i> ”)
1010	Tim Berners-Lee, The World-Wide Web, Communications of the ACM, Vol. 37, No. 8, August 1994 (“ <i>Berners-Lee</i> ”)
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 (“ <i>Malpani</i> ”)
1012	Fielding et al., Hypertext Transfer Protocol – HTTP/1.1, RFC 2068, Jan. 1997, <a href="https://www.rfc-editor.org/rfc/rfc2068">https://www.rfc-editor.org/rfc/rfc2068</a> (“ <i>HTTP/1.1</i> ”)

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<sup>1</sup> 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.

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)
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

Microsoft Corporation (“Microsoft”) respectfully submits this Reply to Patent Owner Sandpiper CDN, LLC’s (“Sandpiper”) Opposition to Petitioner’s Motion for Joinder (Paper 6, “Opp.”). As discussed below, under the circumstances here, joinder should be granted.

## **I. THE GOOGLE IPR**

Microsoft moved for joinder with the *inter partes* review challenging U.S. Patent No. 8,478,903 in *Google LLC v. Sandpiper CDN LLC*, IPR2025-00969 (“the Google IPR”), filed May 9, 2025. See Petitioner’s Motion for Joinder (Paper 3, “Mot.”). In the Google IPR, on October 10, 2025, the Director’s designee denied Sandpiper’s request for discretionary denial and referred the Petition to the Board. See Google IPR, Paper 13. On November 28, 2025, the Board instituted the Google IPR on the merits. See *id.*, Paper 14.

## **II. MICROSOFT CAN MOVE FORWARD WITH GOOGLE’S EXPERT**

Microsoft moved to join Google’s petition in a “silent understudy” role. Mot. at 1-2. As is typical in such scenarios, Microsoft relied on the same evidence (including the same prior art combinations supported by the same expert declaration) as the Google IPR. *Id.* By relying on Google’s expert declaration, Microsoft aimed to reduce the burden on Sandpiper and Board, for example, by minimizing the number of expert depositions and by streamlining the issues. Indeed, the Board has often noted that it is preferable for an understudy like

Microsoft to rely on an existing expert rather than retain its own. *See, e.g., Sun Pharm. Indus. Ltd. v. Merck Sharp & Dohme Corp.*, IPR2020-01060, Paper 15, at 9 (Sept. 1, 2020) (understudy’s “agreement to withdraw the declaration of their own expert will also help streamline discovery here”); *Comcast Cable Commc’ns, LLC v. Realtime Adaptive Streaming, LLC*, IPR2019-01109, Paper 7, at 4 (Nov. 18, 2019) (“Because Petitioner relies on the same declaration as does Netflix, no additional depositions will be required”); *Neumodx Molecular, Inc. v. Handylab, Inc.*, IPR2019-01494, Paper 8, at 4 (Dec. 23, 2019) (“Because the present Petition relies on the same expert declaration as the petition in IPR2019-0490, no additional deposition is needed.”).

Sandpiper suggests, with no factual support, that Microsoft would be unable to produce Google’s expert, Dr. Mowry, for deposition if Google were terminated. *Opp.* at 4-5. This is factually incorrect. Before filing its copycat petition, Microsoft took steps to ensure that Dr. Mowry would remain available if Google were terminated. EX1019. Microsoft received assurances from Google’s counsel that Dr. Mowry was willing and able to represent Microsoft in this case. *Id.* (“Should 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.”).

The *OpenSky* case, which Sandpiper relies on heavily (*see* Opp. at 2-4), deals with a different factual scenario. In *OpenSky*, the expert had signed an *exclusive* engagement agreement that precluded him from being retained by the understudy. *OpenSky Industries, LLC v. VLSI Tech. LLC*, IPR2021-01056, Paper 18, at 7 (Dec. 23, 2021). Moreover, the understudy apparently made no effort to reach out to the expert to determine whether he would be available if needed. *Id.* at 8; *see also id.*, Paper 22, at 2, 5 (March 28, 2022) (“Petitioner relied on the testimony of an expert (Dr. Singh) that Petitioner likely cannot produce for cross-examination and would likely be excluded....Petitioner created its own difficulty by relying on a prior declaration without securing Dr. Singh’s testimony in this proceeding.”). That is not the scenario here, and nothing in *OpenSky* suggests that joinder should be denied where the expert has indicated he is willing and able to be retained by the understudy.

### **III. SANDPIPER’S DISCRETIONARY DENIAL AND MERITS ARGUMENTS HAVE NO PLACE IN THE JOINDER ANALYSIS**

Sandpiper devotes the majority of its Opposition to arguing its discretionary denial position (Opp. at 5-11) and arguing the merits (*id.* at 11-15). Those arguments have no place here. Sandpiper has already argued that the Google IPR should be discretionarily denied, and the Board rejected those arguments. *See* Opp. at 5-6. As Sandpiper freely admits, it intends to petition for

Director Review of the Google IPR discretionary denial decision. Opp. at 6. And Sandpiper intends to make those same arguments in its Discretionary Denial brief in this case. Opp. at 11. Sandpiper’s discretionary denial arguments are properly considered by the Director through the discretionary denial briefing (and Director Review), not through opposing a joinder motion.

Sandpiper cites no authority supporting its position that a supposedly incorrect discretionary denial decision is an independent basis to deny joinder, and Microsoft is aware of none. To the contrary, Sandpiper’s own cases make clear that the discretionary denial and joinder decisions are *separate* inquiries. *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (“the joinder decision is a separate and subsequent decision to the institution decision.”); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, at 5 (Oct. 28, 2020) (citing 35 U.S.C. § 315(c) and *Facebook* in support of the proposition that institution and joinder are “two different decisions,” with joinder “premised on the Director’s determination that the petition warrants institution”); *see also SportRadar AG v. SportsCastr Inc.*, IPR2025-00265, Paper 19, at 2 (June 25, 2025) (discretionary denial decision). Sandpiper’s discretionary denial arguments will be considered separately and do not, in and of themselves, provide a basis to deny joinder.

Sandpiper’s merits arguments (Opp. at 11-15) suffer from the same flaw. Sandpiper rehashes the failed arguments it made in the Google IPR, and concludes that “the Board wrongly instituted the Google IPR on the merits.” Opp. at 12. But as Sandpiper admits, the appropriate place to raise the merits is in the Preliminary Response. *Id.* at 15 (“Patent Owner will further explain why the Microsoft IPR does not warrant institution in the Preliminary Response.”). Sandpiper’s merits arguments have already been rejected once, and regardless, are not an independent reason to deny joinder.

#### IV. CONCLUSION

Microsoft has sought to join existing proceedings at no added burden to the Board or Sandpiper. Before filing its Petition, Microsoft confirmed that it could retain Google’s expert if Google withdrew from the case.

For the foregoing reasons, Petitioner respectfully requests that **if, and only if**, Google’s IPR is still pending at the time of institution of this IPR, then Microsoft’s Petition for *inter partes* review of the ’903 Patent (IPR2026-00095) be joined with the Google IPR (IPR2025-00969).

Respectfully submitted,

/ Jessica Kaiser /

Jessica Kaiser  
Reg. No. 58,937  
Attorney for Petitioner

Dated: January 5, 2026

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), I certify that on January 5, 2026 a copy of **PETITIONER’S CONDITIONAL REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 35 U.S.C. § 315(C) AND 37 C.F.R. §§42.22 AND 42.122(B) and EXHIBIT 1019** was served upon the below-listed counsel by electronic mail:

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Respectfully submitted,  
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Dated: January 5, 2026